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Good Fences Make Good Neighboring Rights: The German Federal Supreme Court Rules on the Digital Sampling of Sound Recordings in Metall auf Metall

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Good Fences Make Good Neighboring Rights: The German Federal Supreme Court Rules on the Digital Sampling of Sound Recordings in *Metall auf Metall*

Tracy Reilly*

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* Associate Professor of Law, University of Dayton School of Law, Program in Law & Technology. I dedicate this article to my husband, best friend, and mentor, Mark Budka. Special thanks to Simon Apel and David A. Simon for their insightful comments and to my research assistant Andrew Jack for his ongoing work with me in the area of digital sampling.

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*I see him there,
 Bringing a stone grasped firmly by the top
 In each hand, like an old-stone savage armed.
 He moves in darkness as it seems to me,
 Not of woods only and the shade of trees.
 He will not go behind his father's saying,
 And he likes having thought of it so well
 He says again, "Good fences make good neighbors."¹*

INTRODUCTION

Robert Frost's famous poem *Mending Wall* has been interpreted by one contemporary copyright scholar to mean that a "hard-headed notion" of "protecting property rights would not necessarily make a community awash with vibrancy, exuberance and coherence" and that "those who are zealous in building good fences would sadly 'mov[e] in darkness,'" as admonished by the poet.² A different, perhaps more neutral reading of the work, is offered by theologian Caroline A. Westerhoff, who writes rather fondly of fences or boundaries as follows:

A boundary is a line drawn; it is a line that defines and establishes identity. All that is within the circumscription of that line makes up a whole—an "entity." Neither "good" nor "bad" in its own right, a boundary determines something that can be pointed to and named A boundary provides essential limit, for what is not limited—bounded—blends into its context and ceases to exist in its own particular way.³

Westerhoff speaks of the importance of drawing lines around boundaries—a lesson that is learned early in life

1. ROBERT FROST, *Mending Wall*, in THE POETRY OF ROBERT FROST 33, 34 (Edward Connery Lathem ed., 1969).

2. See, Haochen Sun, *Overcoming the Achilles Heel of Copyright Law*, 5 NW. J. TECH. & INTELL. PROP. 265, 329 (2007) (quoting FROST, *supra* note 1, at 34).

3. CAROLINE A. WESTERHOFF, GOOD FENCES: THE BOUNDARIES OF HOSPITALITY 13–14 (2004).

through the games we play in childhood.⁴ Games such as hopscotch or football utilize lines and borders to teach “indelible lessons of ordering and limit, of consequence and decorum; lessons of success and failure” where succeeding “meant jumping through those lines without landing in forbidden territory.”⁵ One can argue that the necessity of delineating boundaries around intellectual property rights is even more exigent than for real property rights, because people generally have less familiarity with the concept of intellectual property ownership than they do with the concept of private ownership of land.⁶ “By drawing lines around protected and unprotected [intellectual property] subject matter, the law ensures the continued accessibility of areas for others to use and build upon.”⁷

When viewed in the context of sound recording infringement and digital sampling, two recent high court rulings—one in the United States and the other in Germany—have determined that good fences do, indeed, make for sensible legal boundaries with respect to the copyrights held by the owners of sound recordings.⁸ While the legal doctrines employed by the courts in each of these cases are different in letter and theory, both courts concluded that owners of rights held in sound recordings should reasonably expect the law to protect the valid

4. *Id.* at 1.

5. *Id.*

6. EDUARDO MOISÉS PEÑALVER & SONIA K. KATYAL, PROPERTY OUTLAWS: HOW SQUATTERS, PIRATES, AND PROTESTERS IMPROVE THE LAW OF OWNERSHIP 40–41 (2010).

7. *Id.* at 41 (noting how important it is that non-owners of intellectual property “understand precisely what constitutes the [intellectual] good itself” so they know what actions they should take to avoid trespassing on the rights of the owner); *see also* TERRY L. ANDERSON & PETER J. HILL, THE NOT SO WILD, WILD WEST: PROPERTY RIGHTS ON THE FRONTIER 206 (2004) (asserting that “[w]ell-defined and secure property rights for intellectual property are a key to economic growth in the modern world”). For discussion of an interesting analogy of providing fences or proper metes and bounds in the area of patent law, *see* John Cordani, Note, *Patent at Your Own Risk: Linguistic Fences and Abbott Laboratories v. Sandoz, Inc.*, 95 CORNELL L. REV. 1221, 1222 (2010) which discusses the “linguistic fence” or the language used by patent applicants to describe the metes and bounds of their inventions in order to provide meaningful knowledge regarding what exact “intellectual ‘land’” owned by the patentee is off bounds for use by the public.

8. *See* *Bridgeport Music, Inc. v. Dimension Films LLC*, 410 F.3d 792 (6th Cir. 2005); Neil Conley & Tom Braegelmann, *Metall auf Metall: The Importance of the Kraftwerk Decision for the Sampling of Music in Germany*, 56 J. COPYRIGHT SOC’Y U.S.A. 1017, 1018–19 (2008) (providing the English translation for the German Federal Supreme Court decision in *Kraftwerk v. Pelham*).

boundaries of those rights when third parties engage in the practice of unauthorized digital sampling.⁹ However, both courts also ultimately fall short in setting and defining parameters that will provide reasonable guidelines for uses that should be considered fair or free for musicians who wish to sample.¹⁰

This article contains five sections. Section I explores the historical, technical, and cultural development and progression of the practice of digital music sampling, revealing how musicians in today's modern recording studio (or even at home on their computer) are truly creating sounds that have no legal bounds. Section II discusses the overarching philosophies that have influenced the creation of laws enacted by both the United States and German legislatures to protect sound recordings, focusing on the differences between the property, economic, moral, and entrepreneurial rights components of intellectual property created by musicians and their producers. Section III is a comparative law observation of the differences between how United States copyright law doctrines and German-neighboring-rights law principles support the intellectual property that is contained in the sound recording (the medium in which digital samples are created). The section examines the historical treatment of digital sampling cases in both countries, focusing on the similarities and differences in the U.S. Sixth Circuit ruling in *Bridgeport Music, Inc. v. Dimension Films* and the German Federal Supreme Court ruling in *Kraftwerk v. Moses Pelham*, officially titled *Metall auf Metall* by the *Bundesgerichtshof* or "BGH," which is the highest court for most private law cases in Germany.¹¹ Section IV provides a diagnosis of each holding, specifically challenging the analyses and application of the defenses available to third-party samplers. Finally, the article concludes in Section V by proposing that the current laws protecting sound recordings in both the United States and Germany are in need of a serious overhaul in light of the continuing and constant technological develop-

9. *Bridgeport Music*, 410 F.3d. at 800–01; Conley & Braegelmann, *supra* note 8, at 1018.

10. *Bridgeport Music*, 410 F.3d.at 805; Conley & Braegelmann *supra* note 8, at 1018.

11. Simon Apel, *Bridgeport Music, Inc. v. Dimension Films (USA), Metall auf Metall (Germany) and Digital Sound Sampling—"Bright Line Rules"?*, 2 ZEITSCHRIFT FÜR GEISTIGES EIGENTUM [INTELL. PROP. J.] 331, 341 n.75 (2010).

ment of music sampling techniques.

I. SOUNDS WITH NO BOUNDS: THE HISTORY OF DIGITAL SAMPLING

Technically speaking, digital sampling is the electronic process employed by musicians “in which physical sound waves are converted into binary digital units and used to recycle sound fragments originally recorded by other musicians.”¹² In modern practice, when a musician “samples” another musician’s pre-recorded music, he or she uses digital equipment to literally integrate the prior sounds into a new recording.¹³ The manual and analog sampling processes employed by musicians in the past, which eventually led to the development and use of digital sampling technology, have woven an interesting and eclectic tale in the pages of music history.¹⁴ In the 1950s, artists “used analog tape machines to cut and loop pre-recorded sounds from melodies to water droplets, changing their tempo, direction, and applying various other manipulations.”¹⁵ Later, during the 1960s in Jamaica, disc jockeys would perform live music in clubs by combining different songs with the use of turntables, mixers, and microphones.¹⁶ In New York during the 1970s, similar technology was employed at block parties where MCs would use microphones to “hype-up a dancing crowd” while “DJs would mix records creating seamless transitions between songs to ensure that there was never a dull moment in the party.”¹⁷

12. LAURA LEE STAPLETON, E-COPYRIGHT LAW HANDBOOK §3.07, at 3-38.4 (Supp. 2003).

13. M. Leah Somoano, Comment, *Bridgeport Music, Inc. v. Dimension Films: Has Unlicensed Digital Sampling of Copyrighted Sounds Come to an End?*, 21 BERKELEY TECH. L.J. 289, 295–96 (2006).

14. *See id.* at 296.

15. Reuven Ashtar, *Theft, Transformation, and the Need of the Immaterial: A Proposal for a Fair Use Digital Sampling Regime*, 19 ALB. L.J. SCI. & TECH. 261, 283 (2009).

16. *See id.*; *see also* MICHAEL ERIC DYSON, THE MICHAEL ERIC DYSON READER 426 (2004) (“[T]he Jamaican dance hall was the site of a mixture of older and newer forms of Caribbean music, including calypso, soca, salsa, Afro-Cuban, ska, and reggae.”).

17. Shervin Rezaie, *Play Your Part: Girl Talk’s Indefinite Role in the Digital Sampling Saga*, 26 TOURO L. REV. 175, 179 (2010). The author provides an interesting discussion of the origins of “break dancing,” where dancers performed moves in synchronization with breaks in “part[s] of a song where the percussion section takes over and jams for thirty to fifty seconds.” *Id.* For a lively discussion of the progression of sampled music from disco, to house, to

The creation of the MIDI synthesizer in the 1980s allowed artists and producers to digitally sample snippets of songs previously recorded by other musicians by merely pushing a key on an electronic keyboard that would trigger any type of recorded sound from a trumpet to a bass drum and anything in between.¹⁸ Indeed, “[a] sample can be a recording of something quite brief, like a snapped finger, or something many measures long, like a sustained grand piano note.”¹⁹ Thus, the antiquated practice of manual or analog sampling that was prevalent in the ‘60s and ‘70s was quickly replaced by cheap and easily accessible digital sampling equipment that enabled the production of a “perfect reproduction that can be manipulated and inserted into a new song.”²⁰ This modern sampling technology arms musicians with the ability to copy and alter the original sounds by changing their pitch and other elements.²¹ However,

rave, to “neo-gothic,” see SUSAN BROADHURST, *LIMINAL ACTS: A CRITICAL OVERVIEW OF CONTEMPORARY PERFORMANCE AND THEORY* 149–52 (1999).

18. See Neela Kartha, Note, *Digital Sampling and Copyright Law in a Social Context: No More Colorblindness!!*, 14 U. MIAMI ENT. & SPORTS L. REV. 218, 224 (1997).

19. RICHARD MANSFIELD, *THE SAVVY GUIDE TO DIGITAL MUSIC* 141 (2005).

20. Somoano, *supra* note 13, at 296. The difference between analog and digital sound recording technology has been described as follows:

Until recently, sound recordings were made only in waveform or “analog” form, where sound was captured through a microphone and recorded directly into the recording medium. In contrast, digital recording translates the analog sound into evenly spaced intervals or samples, which are given a binary code and recorded directly into a sampling keyboard or digital sampler. Once recorded on digital tape, the binary code can be exactly reproduced in whole or in part through the use of a digital-to-analog converter. As there is virtually no distinction to the human ear between the original and the digitally sampled copy, sampling has been deemed “exact copying.” The digitally recorded sound can also be altered by rearranging the binary code in order to change the pitch, duration or sequence of the sound, or combining the sample with other recorded sounds. It is this process of alteration of previously recorded music that has been the focus of the majority of digital sampling disputes.

Margaret E. Watson, *Unauthorized Digital Sampling in Musical Parody: A Haven in the Fair Use Doctrine?*, 21 W. NEW ENG. L. REV. 469, 473 (1999).

21. Mike Suppapola, *Confusion in the Digital Age: Why the De Minimis Use Test Should be Applied to Digital Samples of Copyrighted Sound Recordings*, 14 TEX. INTELL. PROP. L.J. 93, 101 (2006); see also Somoano, *supra* note 13, at 296 (explaining that “digital sampling, unlike analog sampling, allows artists to easily sample from commercially available digital media, such as compact discs, while gaining a greater ability to alter the speed, pitch, and other characteristics of a sample”).

because sampling cannot manipulate the distinctive tonal quality of the underlying sounds, such sounds “invariably retain their unique qualities” when sampled.²²

Musicians using the limited-memory-chip musical technology that was available in the 1970s were considered programmers *and* players, and in the music manufacturing industry “it was generally believed that they created their own, original sounds to meet their specific musical needs.”²³ However, by the late 1970s, at least eighty percent of musicians utilizing computerized musical technology were not actually programming any of their own music but were instead “relying almost exclusively” on the preset sounds contained in the memory of the musical equipment they were buying.²⁴ At “the end of the decade, marketing departments were estimating that as few as [ten] percent of users programmed their own sounds.”²⁵ Not surprisingly, “[t]his practice of digitally sampling sound recordings led to an increase in litigation in the 1990s, and remains a hotly contested issue today.”²⁶

II. THE CONTINUED DEBATE OVER UNAUTHORIZED USE OF DIGITAL SAMPLES

The overarching issue regarding digital sampling continues to pose a challenge to determining the proper legal fences to construct around the ownership rights in musical sound recordings.²⁷ While most legal scholars seem to concur that copyright owners should reasonably expect *some* form of protection for unauthorized sampling of their sound recordings (i.e., they agree that the taking and use of others’ recordings is not a *per se* entitlement)²⁸ the battle lines appear to be drawn regarding

22. Michael L. Baroni, *A Pirate’s Palette: The Dilemmas of Digital Sound Sampling and a Proposed Compulsory License Solution*, 11 U. MIAMI ENT. & SPORTS L. REV. 65, 70 (1993).

23. PAUL THÉBERGE, ANY SOUND YOU CAN IMAGINE: MAKING MUSIC/CONSUMING TECHNOLOGY 75 (1997).

24. *Id.*

25. *Id.*

26. Somoano, *supra* note 13, at 296.

27. *See generally* Baroni, *supra* note 22, at 65–67 (providing an overview of concerns surrounding digital sampling and the uncertainty as to whether digital sampling is ever legal).

28. *See, e.g.*, Ashtar *supra* note 15; Baroni, *supra* note 22; Suppapola, *supra* note 21. In fact, this attitude comports with how most Americans generally regard copyright ownership of songs. In a recent poll conducted by performing rights organization Broadcast Music Incorporated, an overwhelming

the age-old, global debate over whether the “essence” of intellectual property ownership is different from the rights imbued to the owners of tangible or real property.²⁹ This disputation becomes even more pronounced in the specific area of digital music sampling.³⁰

Music, like real and personal property, provides value to its owner.³¹ While determining the fair market value of Blackacre or a diamond ring may be economically discernible, “[m]usic is a hedonic product whose evaluation is based primarily on the experience it provides to a consumer rather than on specific product attributes.”³² Indeed, music “presents us with something special that stimulates and soothes the very essence of the human spirit” and “draws out the most dynamic of human emotion,” even more so than other forms of copyright.³³ Some

percentage of Americans—eighty-five percent to be exact—claimed a belief that songwriters deserve to be paid for their contributions. The question asked in the poll was, “If there was a party that wasn’t compensating songwriters, do you think that would be wrong?” And the answer to the question was, “Yes!” John Bowe, *The Copyright Enforcers*, N.Y. TIMES, Aug. 8, 2010 (Magazine), at 40.

29. Ian McClure, Note, *Be Careful What You Wish For: Copyright’s Campaign For Property Rights And An Eminent Consequence Of Intellectual Monopoly*, 10 CHAP. L. REV. 789, 790 (2007).

30. See, e.g., Joseph P. Liu, *Regulatory Copyright*, 83 N.C. L. REV. 87, 152 (2004) (arguing that the continued application of traditional fair use principles to complex sampling issues is inadequate, and proposing that a “flexible regulatory regime” should be created by Congress to enact and oversee specific industry exemptions to copyright in the area of sampling that would only be imposed when there exists “a threshold level of economic significance” with respect to defendant’s taking); Lauren Fontein Brandes, Comment, *From Mozart to Hip-Hop: The Impact of Bridgeport v. Dimension Films on Musical Creativity*, 14 UCLA ENT. L. REV. 93, 127 (2007) (arguing that those who sample music created and owned by others should be afforded a *de minimis* defense if found liable for copyright infringement); A. Dean Johnson, Note, *Music Copyrights: The Need for an Appropriate Fair Use Analysis in Digital Sampling Infringement Suits*, 21 FLA. ST. U. L. REV. 135, 164 (1993) (arguing that fair use should remain a legitimate defense when sampling an original sound recording).

31. See *Herbert v. Shanley Co.*, 242 U.S. 591, 594–95 (1917) (holding that the unauthorized performance of a copyrighted musical composition in a restaurant or hotel infringes the owner’s exclusive right to perform the work publicly for profit). Justice Holmes famously wrote, “If music did not pay, it would be given up.” *Id.* at 595.

32. H. RAGHAV RAO & SHAMBHU UPADHYAYA, INFORMATION ASSURANCE, SECURITY, AND PRIVACY SERVICES 548 (2009).

33. James H. Napper, III, *Life as Art: How Technology and the Infusion of Music Into Daily Life Spurred the Sound Recordings Act of 1971*, 12 TUL. J. TECH. & INTELL. PROP. 161, 165–66 (2009) (acknowledging that “music has

would argue that the value of music “relies solely on the ability of the listener to recognize the music.”³⁴ This philosophy is evident in fair use cases involving music, such as *Campbell v. Acuff-Rose Music, Inc.*, because in order to create an effective parody of a song, “the artist must take the most identifiable pieces of the song.”³⁵

Unfortunately, it has become customary—and even modish—for copyright scholars to describe sampling as mere borrowing or referencing of previous music, akin to the age-old practice of imitating uncopyrightable musical ideas, patterns, and performance styles.³⁶ Some even go so far as to claim that because “the reservoir of [musical] artistic ingenuity has been expended, a digital sampler has *no choice* but to ‘borrow’ from the past.”³⁷ While most legal scholars re-echo this popular ‘sampling equals borrowing’ mantra and “warn that the enclosure of the public domain represents a major crisis facing both the law of ideas and American culture,”³⁸ there are some—

become totally enmeshed in the daily lives of Americans” and undoubtedly affects how people behave, relate to one another societally, and respond to one another on an extremely personal level); see also David Munkittrick, Note, *Music As Speech: A First Amendment Category Unto Itself?*, 62 FED. COMM. L. J. 665, 668–69 (2010) (discussing the unique function of music in society and claiming that “[a]s a protected mode of expression, music must be understood on its own terms”).

34. William Henslee, *You Can't Always Get What You Want, But If You Try Sometimes You Can Steal It And Call It Fair Use: A Proposal To Abolish The Fair Use Defense For Music*, 58 CATH. U. L. REV. 663, 686 (2009).

35. *Id.* at 686.

36. See, e.g., Ashtar, *supra* note 15, at 285 (“Samplers’ corpora have expanded wildly as artists borrow from sources as diverse as aboriginal music, foreign film, industrial sounds, and even press conferences.”); Brandes, *supra* note 30, at 100 (comparing the acts of modern musicians who borrow digital samples to classical composers who borrow themes, musical phrases, and ideas); Jennifer R.R. Mueller, Comment, *All Mixed Up: Bridgeport Music v. Dimension Films and De Minimis Digital Sampling*, 81 IND. L.J. 435, 457 (2006) (“Sample-based recording artists, like writers, visual artists, and filmmakers, necessarily borrow from others in order to create their works”); Matthew G. Passmore, Note, *A Brief Return to the Digital Sampling Debate*, 20 HASTINGS COMM. & ENT L.J. 833, 843 (1998) (maintaining that an artist who samples “borrows sources from the artist’s experience of the surrounding world and incorporates these sources in the generation of a novel and critical artistic expression”).

37. Brandon G. Williams, *James Brown v. In-Frin-Jr.: How Moral Rights Can Steal the Groove*, 17 ARIZ. J. INT’L & COMP. L. 651, 653 (2000) (emphasis added).

38. David Fagundes, *Crystals in the Public Domain*, 50 B.C. L. REV. 139, 140 (2009) (“Every great story has a villain, and in the story told by enthusiasts of the public domain [in copyright law], that villain is property.”).

albeit, a vast minority—who embrace the axiom that “[u]sing someone else’s music without paying for it should almost never be a fair use.”³⁹ In a refreshing departure from the common sampling repertoire, Michael Allyn Pote is one of the few scholars who have recently challenged the notion that sampling is mere borrowing of ideas, as opposed to a taking of the copyrightable expression of such ideas.⁴⁰ Responding to a copyright author who claims, in the words of Pote, that music “has a long history of borrowing from previous musical works,” Pote opines that the author “fails to recognize that the extent of the borrowing is limited to the *ideas* of the works since more extensive borrowing, such as borrowing the actual *expression*, would disrupt the incentive provided to artists.”⁴¹ Indeed—as Pote conveys—it is well documented that modern digital technology makes “cloning,” and not just mere copying, borrowing, or referencing of past music possible because the quality of the original recording is entirely preserved and, in the case of sampling, duplicated exactly into the new recording.⁴²

While it is true that third-party non-owners of both real property and music undoubtedly find value in these commodities owned by others, the law protects that value much more

39. Henslee, *supra* note 34, at 692–93; see also Lea Shaver & Caterina Sganga, *The Right to Take Part in Cultural Life: On Copyright and Human Rights*, 27 WIS. INT’L L.J. 637, 637 (2010). The authors state that “for over a decade, legal scholars and public interest advocates have endeavored to defend creative and communicative liberty against efforts at excessive control through copyright.” *Id.* The authors also maintain that states wishing to ensure that all of their citizens have the fundamental “right to take part in cultural life” have “a legal obligation to ensure that their intellectual property frameworks do not provide excessive protections at the expense of cultural participation.” *Id.* at 640.

40. See Michael Allyn Pote, Comment, *Mashed-Up in Between: The Delicate Balance of Artists’ Interests Lost Amidst the War on Copyright*, 88 N.C. L. REV. 639, 668 (2010).

41. *Id.* at 667–68 (emphasis added).

42. See STEVEN BROWN & ULRİK VOLGSTEN, MUSIC AND MANIPULATION: ON THE SOCIAL USES AND SOCIAL CONTROLS OF MUSIC 340 (2006); Pote, *supra* note 40, at 668 (explaining that a digital sample copies the “exact expression” as fixed in the original sound recording); see also JOANNA DEMERS, STEAL THIS MUSIC: HOW INTELLECTUAL PROPERTY LAW AFFECTS MUSICAL CREATIVITY 41 (2006) (explaining the difference between musical “allusion,” which “occurs when any musician refers to another work, knowingly or otherwise,” including “arrangements, sound-alike recordings, and cover songs” and reproduction of sound, which “can be mechanically duplicated in only one way, by playing it back after it has already been fixed onto a recording medium”).

narrowly than that derived by the owners/creators.⁴³ When the owner of a piece of real property purchases title in a tract of land, he justifiably expects that he will be provided with legal rights that allow him to exclude all others from that land with few exceptions, such as necessity or eminent domain.⁴⁴ Similarly, when the author of a song creates a copyrightable work, he operates under the premise that the law will protect him from unauthorized third-party use of that song with few exceptions, such as fair use.⁴⁵ The challenge faced by courts in interpreting digital sampling cases is to create parameters around the specific uses of sound recordings, which owners of such works should reasonably expect to be exclusive to them versus when owners should bow to the unlicensed, unremunerated uses by third parties who are not authors of such works.⁴⁶

An understanding of the complexities of this task begins here with an analysis of the legal protections of sound recordings offered in the United States and Germany, as well as the exceptions to such rights. In recognition that sampling can neither be dismissed as merely an innocent practice of imitation nor authorized without legal scrutiny as a tool of entitlement for new musicians or genres of music, cases like *Bridgeport Music* and *Kraftwerk* continue to scrutinize closely the practice of unauthorized sampling.⁴⁷

III. THE LAWS PROTECTING SAMPLES AS SOUND RECORDINGS

Sound recordings are not recognized by the same legal doctrines in the United States and Germany.⁴⁸ The fundamental

43. See Pote, *supra* note 40, at 658–59 (explaining that artists have an overarching, exclusive right to work, limited by various exceptions).

44. See McClure, *supra* note 29, at 811–12.

45. See *id.* at 791 (“[Some individuals] equate such exclusivity [in copyrights] to that which is afforded by property laws to owners of real and personal private property.”).

46. See Pote, *supra* note 40, at 669–70.

47. *Bridgeport Music, Inc. v. Dimension Films LLC*, 230 F. Supp. 2d 830, (M.D. Tenn. 2002), rev’d 383 F.3d 390 (6th Cir. 2004), rev’d 401 F.3d 647 (6th Cir. 2004), aff’d and amended on reh’g 410 F.3d 792 (6th Cir. 2005); Bundesgerichtshof [BGH][Federal Court of Justice] I ZR 112/06 Nov. 20, 2008, Systematische Sammlung der Entscheidungen des Bundesgerichtshofes [BGHR] (Ger.).

48. Laura A. Pitta, *Economic and Moral Rights Under U.S. Copyright Law: Protecting Authors and Producers in the Motion Picture Industry*, 12 ENT. & SPORTS LAW, Winter 1995, at 3, 3 (1995).

differences between the legal regimes that protect copyright in the United States (the common law system) and Germany (the civil law system) can be understood by studying the philosophical backdrop that existed in the seventeenth-century, when the protection of creative works shifted “from a sovereign privilege to a statutory right.”⁴⁹ The first school of thought that emerged during this period in the civil law countries—especially France and Germany—was centered on natural law theory.⁵⁰ Natural law theory advanced the notion that, because authors invested creativity in their works, the works should belong to them, and rights in the works should extend to their economic interest as well as their *personal* interest.⁵¹

In natural law theory, also known as the artists’ rights or *droit d’auteur* copyright system, “the artist’s personality is of foremost importance and is the essence of the relationship between the artist and his work. The relationship is not based on the end result—i.e., the work of art—but on the materialization of the artist’s personality in his creation.”⁵² Some have described these rights as “moral rights” or “human rights” because they protect the individual traits found in an author’s work, as well as a dimension of that creation that reflects something over and above the artist’s desire to earn an income from the pecuniary exploitation of his or her work.⁵³ Artists’ moral rights include (1) attribution, the right to either claim or disclaim credit for creating a work; (2) integrity, “the right to ensure that the work is not changed” absent consent of the artist; (3) publication, the right to conceal the work from the public until the artist determines it to be satisfactory; and (4) retraction, the right to renounce authorship of a work and prevent its public display or dissemination.⁵⁴

As the artists’ rights rationale was forming mainly on the European continent, the common law was developing in a different way in other countries.⁵⁵ In common law countries—like

49. *Id.*

50. *Id.*

51. *Id.*

52. W.W. Kowalski, *A Comparative Law Analysis of the Retained Rights of Artists*, 8 VAND. J. TRANSNAT’L L. 1141, 1146–47 (2005).

53. Aurele Danoff, *The Moral Rights Act of 2007: Finding the Melody in the Music*, 1 J. BUS. ENTREPRENEURSHIP & L. 181, 183 (2007).

54. *Id.*

55. Pitta, *supra* note 48, at 3.

the United States and the United Kingdom—when legislators codified rights, they replaced natural law and provided authors with only limited economic protection in the form of an exclusive reproduction right for a limited time.⁵⁶ The purpose of this right “was to protect the economic rights held by creators or publishers who purchased the original creator’s rights. Thus, creators relinquished all rights in a work (unless otherwise contractually agreed) in exchange for pecuniary recompense.”⁵⁷ Copyright law was codified pursuant to this theory, and thus recognizes “the creation of the work mainly as an aspect of property” or an “enrichment of the artist as a result of his work.”⁵⁸ As discussed in more detail below, these philosophies shaped the ways in which differing legal protection of sound recordings have developed, and continue to develop, in the United States and Germany.⁵⁹

A. THE UNITED STATES: COPYRIGHT PROTECTION FOR SOUND RECORDINGS

Copyright protection for owners of musical works, including sound recordings, is derived from the United States Constitution, which provides Congress with the enumerated power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”⁶⁰ Congress appears to recognize that copyright rights are best structured by providing exclusive and well-delineated privileges to authors of original works.⁶¹ Each version of the Copyright Act throughout history has been drafted with the assumption that authors will be incentivized to create works for the enjoyment of the public only when the law “provide[s] copyright owners with a clear baseline right to exclude non-paying members of society from using the work in ways that the Copyright Act specifically sets out” in order to “facilitate consensual transfers of clearly defined entitlements in literary and artistic works for payment.”⁶² In other words, copyright law in the United States has

56. *Id.*

57. *Id.*

58. Kowalski, *supra* note 52, at 1147.

59. See Pitta, *supra* note 48, at 3.

60. U.S. Const. art. I, § 8, cl. 8.

61. Alina Ng, *When Users Are Authors: Authorship in the Age of Digital Media*, 12 VAND. J. ENT. & TECH. L. 853, 857 (2010).

62. *Id.*

historically been concerned with setting delineated boundaries (or “good fences”) around the rights of creators of original works.⁶³ As such, the Copyright Act protects original works as property of the copyright owner as:

[A] Coasean bargain, to allow market transactions to occur. The idea behind statutorily-recognized property rights in literary and artistic works is a manifestation of classical law and economic thought on cost-benefit forms of legal analysis—in order to encourage authorship and increase public welfare, authors must be paid with exclusive rights for their work. This payment encourages authors to create and commercialize their works on the market. The assumption behind a law and economics approach to the copyright system is that an author will only decide to create a work when the author is assured that the expected market revenue from sale of the work exceeds his cost of expression.⁶⁴

The first Copyright Act enacted by Congress to implement the constitutional mandate did not protect music at all; the intellectual products that qualified for protection included only books, maps, and charts.⁶⁵ For the first time in history, musical works were granted copyright protection under the first revision of copyright in 1831.⁶⁶ In its current version, the Copyright Act of 1976 protects various categories of works, including mu-

63. See, e.g., *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 517–18 (1994) (“Because copyright law ultimately serves the purpose of enriching the general public through access to creative works, it is peculiarly important that the law’s boundaries be demarcated as clearly as possible.”); *Lotus Development Corp. v. Borland Intern., Inc.*, 140 F.3d 70, 75 (1st Cir. 1998) (“When close infringement cases are litigated, copyright law benefits from the resulting clarification of the doctrine’s boundaries.”).

64. Ng, *supra* note 61, at 857–58; see also Tom Braegelmann, *Copyright Law in and Under the Constitution: The Constitutional Scope and Limits to Copyright Law in the United States in Comparison With the Scope and Limits Imposed by Constitutional and European Law on Copyright Law in Germany*, 27 CARDOZO ARTS & ENT. L.J. 99, 104 (2009) (“Statements made by George Washington and other Framers [of the constitution] . . . indicate that the Copyright Clause was intended to engender a marketplace in writings.”); Jeffrey F. Kersting, Comment, *Singing a Different Tune: Was the Sixth Circuit Justified in Changing the Protection of Sound Recordings in Bridgeport Music, Inc. v. Dimension Films?*, 74 U. CINCINNATI L. REV. 663, 667 (2005) (“The natural rights view treats an individual’s intellectual creations with the same protections and rights as tangible, physical property.”).

65. Napper, *supra* note 33, at 166. For an informative discussion of the expansion of the coverage of copyright law in both the United Kingdom and the United States from the Statute of Anne to the present century, see Lionel Bently, *The Author: From Death Penalty to Community Service*, 20th Annual Horace S. Menges Lecture, 32 COLUM. J.L. & ARTS 1, 6–8 (2008).

66. Napper, *supra* note 33, at 166.

sical compositions and sound recordings.⁶⁷

It is essential to comprehend the fundamental differences between musical compositions and sound recordings in order to understand the evolution of sampling jurisprudence in the United States.⁶⁸ The difficult problem for samplers is that any time they reproduce and distribute copies of a musical work they create, and such work contains a sampled portion neither initially created nor owned by them, multiple clearances will be necessary because two separate copyrights are implicated: the first in the sound recording itself and the second in the composition.⁶⁹ One author has described the difference between the two copyrights as follows:

The copyright in a sound recording is distinct from the copyright in the musical composition that may be embodied in the sound recording. The musical composition is what most of us think of as the song. The song exists independent of any particular recording of the song; consequently, there can be a number of different sound recordings of the same song by different recording artists. In most cases, a recorded CD therefore involves two copyrights, one covering the musical composition and one covering the sound recording.⁷⁰

Moreover, when a copyright is extended to a sound recording it is thought to encompass both the contributions of the particular artist(s) performing the composition whose creativity is captured in the resultant recording, as well as the contributions of those responsible for capturing, processing, mixing, and engineering the final recording (e.g., the producers and music engineers who work with the artists in the recording studio and

67. 17 U.S.C. § 102(a)(1)–(8) (2006). Works of authorship protected by copyright include the following categories: “(1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works.” *Id.* For a discussion of the protection of sound recordings, specifically, see H.R. Rep. No. 1476, at 56 (1976).

68. See Eric Charles Osterberg, *Should Sound Recordings Really Be Treated Differently Than Other Copyrighted Works? The Illogic of Bridgeport v. Dimension Films*, 53 J. COPYRIGHT SOC’Y U.S.A. 619, 620 (2006).

69. 17 U.S.C. § 102(a)(1), (7). The Copyright Act distinguishes between “musical works, including any accompanying words” and “sound recordings” for purposes of copyrightable subject matter. 17 U.S.C. § 102(a)(1)–(8). Therefore, “[w]hen a copyrighted song is recorded on a phonorecord, there are two separate copyrights: one on the musical composition and the other in the sound recording.” *T.B. Harms Co. v. Jem Records, Inc.*, 655 F. Supp. 1575, 1576 n.1 (D.N.J. 1987).

70. Osterberg, *supra* note 68, at 620.

make creative choices during the recording process).⁷¹ Because “the level of creativity required for copyright protection may result from the way a piece of music is performed or from the way a [natural] sound is recorded by the producer of the record, or both,” it has been routinely held in music cases that even short parts of music consisting of only a few notes played in a characteristic style will be determined to possess the requisite originality required by copyright law.⁷²

Ironically, most consumers who ultimately purchase commercial copies of the recording will “deem the designated artist the sole creator, and some recording artists would happily agree.”⁷³ However, because producers and engineers often control the recording session, those who play such roles in the creation of the recording also have colorable claims to copyright authorship.⁷⁴

To complicate matters even further for the sampling artist, the musician who is the original author of the sampled song has the ability to assign, transfer, or convey any of the rights associated with copyright ownership.⁷⁵ In fact, the standard modern recording agreement will include an assignment of all the recording musician’s original sound recording copyright rights in exchange for the capital investment made by the record company and the many creative and economic contributions the record company invariably makes to the finished product.⁷⁶

71. Kersting, *supra* note 64, at 668.

72. Apel, *supra* note 11, at 334.

73. Mark H. Jaffe, *Defusing the Time Bomb Once Again—Determining Authorship in a Sound Recording*, 53 J. COPYRIGHT SOC’Y U.S.A. 139, 142 (2006).

74. *See id.* The author notes the fact that a host of other contributors who participate in the recording process, such as session musicians and back-up singers, are not considered “authors” for purposes of copyright, since as a condition to their participation, they usually are required to sign written contracts declaring that they have no rights as such. *See id.* at 140–42 (noting that there has been litigation because of a lack of such contracts and that not every related issue has been completely litigated).

75. 17 U.S.C. § 201(d) (2006) (“The ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law . . .”). These assignments create problems for downstream users of copyrighted material. *See* PETER K. YU, *INTELLECTUAL PROPERTY AND INFORMATION WEALTH: COPYRIGHT AND RELATED RIGHTS* 173 (2007) (“The music industry is characterized by dual layers of copyright owners, and each of those copyright owners is granted multiple rights.”).

76. David Dante Troutt, *I Own, Therefore I Am: Copyright, Personality, and Soul Music in the Digital Commons*, 20 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 373, 423 (2010) (citing AL KOHN & BOB KOHN, *KOHN ON MUSIC*

The irony that results from this phenomenon is that, while the primary responsibility to clear and pay for samples is placed on the artist pursuant to the recording agreement, “the artist does not even collect when her song is sampled because the owner of the copyright in the sound recording is usually the record company, and the owner of the musical composition is usually the publishing company.”⁷⁷

Regardless of the form taken by a creative work, musical or otherwise, “[c]opyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”⁷⁸ As such, upon the creation of every sound recording, the artist and the producer are acknowledged as having made “authorial contributions” which qualify for protection under the Act.⁷⁹ Once a work is created, the copyright in such work will vest initially in the author of the work.⁸⁰ If there are many authors of a work—which is often the case when musical works are created—the copyright will vest in all of the authors, making them joint owners of the work with co-ownership rights.⁸¹ Such rights include the “exclusive” ability of the copyright owner to use and to authorize the use of his work in various ways.⁸² Section 106 of the Act provides

LICENSING 105–06 (2d ed. 1996)). For a discussion of the economic realities that exist in the music business, particularly that a substantial percentage of music products invested in by record companies never turn a profit, see Michael P. Ryan, *Knowledge-Economy Elites, the International Law of Intellectual Property and Trade, and Economic Development*, 10 CARDOZO J. INTL & COMP. L. 271, 288–90 (2002), “Recording a music CD most often fails to bring a respectable return on investment even under an effective copyright system.”

77. Kartha, *supra* note 18, at 234–35. The author goes on to note the expensive, time consuming, and often ad hoc processes employed by record companies to clear samples, including the fact that most record companies go out of their way to get permission from sampled artists who do not even own the copyrights to their songs “because if the resulting usage is offensive to the sampled artist, it may cause a rift in their relationship [that] record companies want to avoid . . .” *Id.* at 235.

78. 17 U.S.C. § 102(a).

79. See Bently, *supra* note 65, at 93 (contrasting the inclusive nature of authorship within the American copyright system with the historically less generous definition in Europe).

80. 17 U.S.C. § 201(a).

81. *Id.*

82. H.R. Rep. No. 94–1476, at 121 (1976) reprinted in 1976 U.S.C.C.A.N. 5659, 5736 (“[C]o-owners of a copyright [are] treated generally as tenants in common, with each co-owner having an independent right to use or license the

owners of copyrights in most works the exclusive right “(1) to reproduce the copyrighted work in copies or phonorecords; (2) to prepare derivative works based upon the copyrighted work; (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending . . . ;”⁸³ (4) to perform the work publicly; and (5) to display the work publicly.⁸⁴ On the other hand, with respect to copyrights in sound recordings—which the Act defines as “works that result from the fixation of a series of musical, spoken, or other sounds”⁸⁵—the Act only confers the limited rights of reproduction, preparation of derivative works, and distribution of copies; a performance right is provided for sound recordings only to the extent performance is accomplished by means of digital audio transmission.⁸⁶

In order to comprehend why sound recordings have more limited rights than those granted to other types of works protected by copyright, it is essential to trace the congressional history of such protection. Until 1972, sound recordings were not protected under federal copyright law, even though the underlying musical compositions that were invariably “embedded” in recordings *were* subject to copyright.⁸⁷ This resulted in the anomaly that songwriters would receive all the benefits of federal copyright protection for their songs. Neither the recording artists, producers, nor the record company would obtain such benefits for the recording and instead would be forced to rely on state copyright protection.⁸⁸

use of a work, subject to a duty of accounting to the other coowners for any profits.”).

83. 17 U.S.C. § 106. The Copyright Act defines a derivative work as “a work based upon one or more preexisting works” *Id.* §101. The definition of derivative works is expansive and examples of derivative works include, *inter alia*, a translation of a poem, a movie based on a novel, and most relevant for the purposes of this article, a sound recording that samples another song. *See* 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 2.10[A] n.8 (Matthew Bender, Rev. Ed. 2011) (“A sound recording is a derivative work in relation to the musical work recorded therein . . .”).

84. 17 U.S.C. § 106. The act also allows for sound recording to be performed publicly by means of digital audio transmission. *Id.*

85. *Id.* § 101.

86. 17 U.S.C. § 106(6).

87. Jaffe, *supra* note 73, at 144 & n.50.

88. *See id.*; *see also* Meredith L. Schantz, Note, *Mixed Signals: How Mixtapes Have Blurred the Changing Legal Landscape in the Music Industry*, 17 U. MIAMI BUS. L. REV. 293, 305–07 (2009) (discussing generally the unau-

Due to the growing concern in the music industry over rampant acts of record piracy and unauthorized duplication of musical works in the wake of the invention of the audio tape recorder, Congress enacted the Sound Recording Act of 1971, (now codified in the existing Copyright Act in §114), which extended copyright rights to sound recordings.⁸⁹ The pertinent provisions of § 114 are as follows:

- (a) The exclusive rights of the owner of copyright in a sound recording are limited to the rights specified by clauses (1), (2), (3) and (6) of section 106, and do not include any right of performance under section 106(4).
- (b) The exclusive right of the owner of copyright in a sound recording under clause (1) of section 106 is limited to the right to duplicate the sound recording in the form of phonorecords or copies that directly or indirectly recapture the actual sounds fixed in the recording. The exclusive right of the owner of copyright in a sound recording under clause (2) of section 106 is limited to the right to prepare a derivative work in which the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality. The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording.⁹⁰

In the event someone other than the copyright owner engages in one or more of the exclusive rights provided by § 106, the owner can sue such party for copyright infringement if he can show possession of a valid copyright in the work and that the defendant copied legally protected elements of the copyrighted work.⁹¹ Since direct evidence of copying is rarely if ever available, most copyright infringement cases turn on the issue of whether illegal copying can be inferred.⁹² An inference of

thorized duplication laws passed by most states in order to protect against the unlawful duplication, distribution, and sale of sound recordings).

89. Sound Recording Act of 1971, Pub. L. No. 92-140, § 1(a), 85 Stat. 391, 391 (1974) (amending the Copyright Act to provide for the creation of a limited copyright in sound recordings for various purposes, including protection against unauthorized duplication and piracy of sound recordings); Andrew B. Peterson, Note, *To Bootleg or Not to Bootleg? Confusion Surrounding the Constitutionality of the Anti-Bootlegging Act Continues*, 58 OKLA. L. REV. 723, 726 (2005); see also 17 U.S.C. § 102(a)(7) (including sound recordings as a category of works protected by copyright).

90. 17 U.S.C. § 114.

91. Valeria M. Castanaro, Note, *"It's the Same Old Song": The Failure of the Originality Requirement in Musical Copyright*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L. J. 1271, 1278 (2008).

92. *Smith v. Jackson*, 84 F.3d 1213, 1218 (9th Cir. 1996).

copying may be established by showing that a defendant had access to the copyrighted work and that there is a substantial similarity between the copyrighted work and the defendant's work.⁹³ Whereas a typical copyright infringement action will focus on an inference of copying, "the use of samples of preexisting, copyrighted sound recordings is obviously direct copying."⁹⁴ Accordingly, once the plaintiff in a sampling suit has proven that the defendant used a sample of his original recording, he has met his *prima facie* case for infringement.⁹⁵

Whereas direct proof of infringement may be easier to prove in sampling cases, the defendant still can assert a viable defense of his copying. In addition to protecting the rights provided to authors of original works, copyright law also recognizes that these rights should not be protected to such an extent that they stifle the creation of new works by subsequent authors.⁹⁶ One way that U.S. courts ensure that a proper balance exists between copyright owners and potential new authors in a copyright infringement suit is by analyzing the requisite originality of the work in question.⁹⁷ When the work is a musical creation, if the defendant can convince the court that the part or parts of the plaintiff's song used in the defendant's song are not sufficiently original—or that they belong in the public domain as musical building blocks that should be available for use by all musicians—then the plaintiff's case will be dismissed.⁹⁸

93. *E.g.*, *Art Attacks Ink, LLC v. MGA Entm't Inc.*, 581 F.3d 1138, 1143 (9th Cir. 2009) ("[A] plaintiff must show a reasonable possibility, not merely a bare possibility, that an alleged infringer had the chance to view the protected work."); *Ellis v. Diffie*, 177 F.3d 503, 506 (6th Cir. 1999) ("[A] plaintiff may establish an inference of copying by showing . . . a substantial similarity between the two works at issue.").

94. *See Pote*, *supra* note 40, at 663.

95. *See generally id.* (explaining that not every case of copying amounts to copyright infringement).

96. *Castanaro*, *supra* note 91, at 1275.

97. *Arnstein v. Porter*, 154 F.2d 464, 468 ("The trier of the facts must determine whether the similarities are sufficient to prove copying. On this issue, analysis (dissection) is relevant, and the testimony of experts may be received.").

98. *See, e.g.*, *Tisi v. Patrick*, 97 F. Supp. 2d 539, 548–49 (S.D.N.Y. 2000) (finding that the plaintiff's claim of copyright infringement was entirely based on non-protectable elements of his song: key, tempo, and chord structure/harmonic progression, the last being common to the rock music genre); *Intersong—USA v. CBS, Inc.*, 757 F. Supp. 274, 282 (S.D.N.Y. 1991) (finding that elements of the plaintiffs' song that were found in the defendants' song

Another way courts ensure that the exclusivity rights given to copyright owners are kept in check is by applying the *de minimis* doctrine to infringement cases.⁹⁹ The *de minimis* doctrine has been employed by courts in holding that the defendant's technical violation of copyright is so trivial that the law will not impose legal consequences on the defendant or that the defendant's copying has been so insignificant that it fails to meet the requirements of substantial similarity, thus despoiling the plaintiff's *prima facie* case for copyright infringement.¹⁰⁰ Many commenters baldly assert that a *de minimis* defense should be available to sampling defendants as a matter of right by making unsupported and emotionally charged statements about the doctrine as it pertains to sampling,¹⁰¹ such as claiming that "one of the underpinnings of the *de minimis* principle [is that] rational people who are neither greedy nor litigious are not troubled by *de minimis* copying."¹⁰² These scholars are terribly bothered by the fact that some very successful bands, such as Pink Floyd have decided not to license any of their protected music to would-be samplers.¹⁰³

After the court has determined that the minimum threshold for copyright infringement has been met and the plaintiff has persuaded the court that the defendant's taking was more than *de minimis*, the defendant may still avoid liability by as-

were not copyrightable because the descending scale step motive is a common compositional device found in many other well-known songs, such as "Twinkle, Twinkle Little Star," and therefore, constitutes "'scenes a faire,' or ordinary, unprotectible [sic] expression").

99. Rezaie, *supra* note 17, at 185–86. *De minimis* is a truncated version of "de minimis non curat lex (sometimes rendered, "The law does not concern itself with trifles')." Ringgold v. Black Entm't Telev., Inc., 126 F.3d 70, 74 (2d Cir. 1997).

100. See Ringgold, 126 F.3d at 74; e.g., Amsinck v. Columbia Pictures Indus., Inc., 862 F. Supp. 1044, 1049 (S.D.N.Y. 1994) (granting summary judgment against an infringement claim over use of plaintiff's artwork in the background of a movie in part because the plaintiff could not demonstrate pecuniary harm, which amounted to a *de minimis* claim).

101. See, e.g., Osterberg, *supra* note 68, at 640–41 ("[A sampler claiming a *de minimis* defense] might legitimately think, 'I don't mind if someone takes a few sounds I made, therefore the author of the work I am sampling is unlikely to mind if I use a few sounds of his, especially if I change them so that they are unrecognizable").

102. *Id.* at 641 (italics added).

103. Steven D. Kim, Case Note, *Taking De Minimis Out of the Mix: The Sixth Circuit Threatens to Pull the Plug on Digital Sampling in Bridgeport Music, Inc. v. Dimension Films*, 13 VILL. SPORTS & ENT. L.J. 103, 126–27, 127 n.158 (2006).

serting a number of affirmative defenses, the most prominent of which is fair use.¹⁰⁴ The current Copyright Act acknowledges that works “for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research” can be argued as uses that are fair, and thus, not an infringement of the owner’s copyright.¹⁰⁵ Section 107 of the Copyright Act sets forth the following factors for a court to balance in determining whether the defendant’s fair use claim is legitimate:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market . . . of the copyrighted work.¹⁰⁶

Most courts that have considered the fair use doctrine in the context of digital sampling, however, have been hesitant to find that such an argument will rescue the defendant’s behavior from being deemed infringement.¹⁰⁷ This is largely because the defendant is usually hard-pressed to argue that his new recording is not a commercial use¹⁰⁸ but also because “[sampling] can diminish the value of the original material, especially when the copied portion lies at the heart of what has been taken.”¹⁰⁹

104. Kersting, *supra* note 64, at 671–72.

105. 17 U.S.C. §107 (2006).

106. *Id.* § 107(1)–(4).

107. Nicholas B. Lewis, Comment, *Shades of Grey: Can the Copyright Fair Use Defense Adapt to New Re-Contextualized Forms of Music and Art?*, 55 AM. U. L. REV. 267, 286 (2005).

108. *See generally id.* at 290–91 (explaining that the commercial nature of the work is only one factor for a court to consider and that it must be considered in relation to the transformative nature of the infringing work). There is no consensus about what makes a transformative work, though many courts have adopted a parody-satire distinction which requires the infringing work to carry a transformative message about the original work. *Id.* at 288–89 (“[T]he more transformative the work is, the less likely that any commercial intent or other factor will weigh against it.”).

109. *Id.* at 286; *see also* Pamela Samuelson, *Unbundling Fair Uses*, 77 Fordham L. Rev. 2537, 2578 (2009) (“Except in cases involving digital sampling of sound recordings, courts have become more receptive to ‘quoting’ from songs, pictures, and videos . . .”).

1. The Early U.S. Cases: *Grand Upright, Jarvis, and Newton*

Judicial interpretation of digital sampling began with the well-known biblical admonition, “Thou shalt not steal.”¹¹⁰ In *Grand Upright Music Ltd. v. Warner Brothers Records, Inc.*, Raymond “Gilbert” O’Sullivan sued rapper Biz Markie for using three words and accompanying music from the melody of O’Sullivan’s “Alone Again (Naturally)” in Biz Markie’s “Alone Again.”¹¹¹ Once Biz Markie admitted to sampling without obtaining the proper licenses or clearances, the Southern District of New York granted O’Sullivan’s preliminary injunction and referred the matter to the United States Attorney for potential criminal prosecution.¹¹² Although the music industry cried foul and most commentators scrutinized the court’s holding as a cursory reading of copyright law and an unfairly lopsided victory for owners of musical works,¹¹³ there were arguably valid reasons why the court felt so justified in its holding.¹¹⁴ The defendants and, more specifically, their attorneys, made the mistake that all copyright lawyers know is cardinal rule number one: do not use the copyrighted material of another when you have asked that person for a license and they have refused to give one.¹¹⁵ While it was unfortunate for Biz Markie that he was essentially deprived from launching a potential fair use defense for his actions because of ineffective counsel, the *Grand*

110. *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182, 183 (S.D.N.Y. 1991). These four words begin the court’s decision, which suggests an attitude by the court that digital sampling amounts to theft—an action that, as Judge Duffy points out, “violates not only the Seventh Commandment, but also the copyright laws of this country.” *Id.*

111. *Id.*

112. *Id.* at 184–85 (noting that the defendants wrote O’Sullivan asking for permission to use the sample).

113. See KEMBREW MCLEOD & PETER DICOLA WITH HENNY TOOMEY & KRISTIN THOMSON, *CREATIVE LICENSE: THE LAW AND CULTURE OF DIGITAL SAMPLING* 133 (2011) (“Judge Duffy overstated the degree of certainty that existed in the record industry in 1991 about whether and when sample clearances were obligatory. He also erred by not conducting a substantial similarity analysis.”) The opinion also failed to address whether Biz Markie’s acts were protected by fair use. *Id.*

114. *Grand Upright Music Ltd.*, 780 F. Supp. at 184 (rejecting the defense’s key assertion that O’Sullivan did not have valid copyright for the sampled music because the certificates were originally held by a corporation that had since been dissolved).

115. *Id.* at 185. Biz Markie’s lawyers sent a letter to his label that attempted to shift the blame for his unauthorized use of the sample in the song to the label, because they released the album before all the licenses could be obtained. *Id.*

Upright court, in the one of the first holdings on unauthorized sampling—while an admittedly over-the-top and one-sided opinion—was attempting to lay some groundwork in setting boundaries for copyright ownership in songs, as well as guidelines it believed sampling defendants should follow.¹¹⁶

Two years later, the District Court of New Jersey was faced with a copyright infringement claim when defendants digitally sampled portions of plaintiff's song "The Music's Got Me" in their song "Get Dumb! (Free Your Body)."¹¹⁷ In *Jarvis v. A & M Records*, the defendants copied two parts of the plaintiff's composition: (1) the bridge section containing the words "ooh . . . move . . . free your body" and (2) a "distinctive keyboard riff."¹¹⁸ Because the plaintiff had a registered copyright in the musical composition and the defendants admitted to copying without authorization, the court focused on "whether the copying amounted to an unlawful appropriation."¹¹⁹ In determining whether unlawful appropriation occurred, the court applied the "substantial similarity" test.¹²⁰ Although the defendants argued that substantial similarity could occur "only if the two songs are similar in their entirety," the court rejected this argument¹²¹ and denied the defendants' motion for summary

116. See Joshua Crum, Comment, *The Day the (Digital) Music Died: Bridgeport, Sampling Infringement, and a Proposed Middle Ground*, 2008 BYU L. REV. 943, 951–52 (2008) ("In the shadow of [Biz Markie's case], digital sampling is still characterized by courts as the most 'brazen stealing of music' possible."). Many subsequent sampling cases have settled instead of face the possibility of stiff financial penalties. *Id.* at 952.

117. *Jarvis v. A & M Records*, 827 F. Supp. 282, 286 (D.N.J. 1993).

118. *Id.* at 289.

119. *Id.*

120. *Id.* at 290. The court recognized that "the test for substantial similarity is difficult to define and vague to apply." *Id.* The two-step test analyzes extrinsic similarity, focusing on the objective commonalities in the two works and intrinsic similarity, relying on the conclusions of a reasonable person. *Hartman v. Hallmark Cards, Inc.*, 833 F.2d 117, 120 (8th Cir. 1987). The defendants challenged how much of a song needed to be copied for a reasonable person to find infringement. *Jarvis*, 827 F. Supp. at 290.

121. *Jarvis*, 827 F. Supp. at 290–91. The court provided three reasons for rejecting the defendants' argument that an ordinary, reasonable listener must confuse one work for the other for substantial similarity to exist. First, if a listener must confuse one work for another, "a work could be immune from infringement so long as the infringing work reaches a substantially different audience than the infringed work." *Id.* at 290. Second, an infringing party may escape liability even when appropriating a large or important portion of another's work, thus "eviscerat[ing] the qualitative/quantitative analysis." *Id.* Finally, such an argument ignores the general principle that substantial simi-

judgment because original elements of the plaintiff's work were literally copied.¹²² From the court's perspective, this literal appropriation of "the exact arrangement of plaintiff's composition [said] more than what can be captured in abstract legal analysis."¹²³

Several years later in *Newton v. Diamond*, the Central District Court of California had the opportunity to refine the analysis of when sampling infringes composition rights held by plaintiffs.¹²⁴ Recognizing that original artists were becoming more aware of their rights when third parties use digital samples of their music without authorization, the Beastie Boys' attorneys affirmatively negotiated a license in 1992 to sample a copyrighted sound recording of "Choir," a musical composition created and performed by Newton, a flautist and composer.¹²⁵ As with most songs, the copyright ownership was split: Newton's record company, ECM Records, owned the sound recording via a 1981 licensing agreement between Newton and ECM; yet, Newton had retained ownership of the underlying composition in the same work.¹²⁶ Throughout the Beastie Boys' song "Pass the Mic," a three-note sequence and one background note from "Choir" were continuously looped.¹²⁷

Although the Beastie Boys' sampling of the sound recording was undisputedly lawful, Newton sued, arguing that the Beastie Boys were also required to obtain a separate license from him to use the musical composition of "Choir."¹²⁸ The court, however, refused to grant summary judgment to Newton because the three-note sequence and one background note, when separated from the musical composition as a whole, was not original as a matter of law.¹²⁹ The court rejected Newton's

larity focuses on what constitutes a substantial portion of the plaintiff's work rather than the defendant's work. *Id.* (emphasis added).

122. *Id.* at 292.

123. *Id.*

124. *See Newton v. Diamond*, 204 F. Supp. 2d 1244, 1248–56 (C.D. Cal. 2002).

125. *See id.* at 1246.

126. *Id.*

127. *Id.* The three-note sequence and background note lasted approximately six seconds while "Choir" itself ran for almost four and a half minutes. *Id.*

128. *Id.* at 1247. Neither party contested that the license allowed the Beastie Boys to sample the recording of "Choir." *Id.*

129. *Id.* at 1253. Only original works of authorship can gain copyright protection. 15 U.S.C. § 102(a) (2006). The United States Supreme Court has stated that "[t]he sine qua non of copyright is originality." *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). In order for a work of art to

attempt to overextend the rights he owned in the composition by maintaining that his own techniques in performing the composition in the studio, by overblowing the “C” note and using breath control to emphasize the note, contributed to only one part of the originality element.¹³⁰ Noting that Newton was confusing the originality of sound recordings with the originality of compositions, the court rightly held that “Newton’s practice of overblowing the ‘C’ note to create a multiphonic sound, and his unique ability to modify the harmonic tone color—do not appear in the musical composition, they are protected only by the copyright of the sound recording of Plaintiff’s performance of ‘Choir,’ which Defendants licensed.”¹³¹

The court went on to hold that, even if the note sequences were copyrightable, the Beastie Boys’ alleged infringement was *de minimis* because only two percent of “Choir” was appropriated, the three-note sequence only appeared once in “Choir,” and the note sequences were not distinctive or at the heart of “Choir.”¹³² Thus, the court held that the defendants took neither quantitative nor qualitative portions of Newton’s composition.¹³³ The court hung its hat on the fact that, because both the note sequence in the composition and vocalization technique used by the plaintiff in the performance of the song are common, “any analysis of distinctiveness must necessarily come from the performance elements [contained in the sound recording copyright], not the musical composition.”¹³⁴

At this point in U.S. sampling jurisprudence, most scholars, including myself, concluded that the *Newton* court not only understood the difference between composition and sound re-

qualify as “original,” it must meet a relatively low threshold: the work must be “independently created by the author . . . and . . . possess[] at least some minimal degree of creativity.” *Id.* While the court did not find Newton’s three-note sequence to be original, it noted that sequences of less than six notes could be copyrightable when the sequences have accompanying lyrics, comprise the heart of the musical composition, or are repetitive. *Newton*, 204 F. Supp. 2d at 1254.

130. *Newton*, 204 F. Supp. 2d at 1251.

131. *Id.*

132. *Id.* at 1258–59. The sample could not be at the heart of “Choir,” in part, because nobody would recognize “from a performance of the notes and notated vocalization alone” that the source of the defendants’ song was, in fact, the plaintiff’s underlying musical composition. *Id.* at 1259.

133. *Id.* at 1258–59 (using the quantitative and qualitative analysis necessary to find *de minimis*).

134. *Id.* at 1258.

ording copyrights but also struck the proper balance in determining when the defendant's use of a composition did not trigger infringement in an original work or, at most, implicated only *de minimis* sampling that ultimately did not rise to actionable infringement. Now that the law on sampling copyrighted *compositions* seemed to be settled, it remained to be seen whether and how the rationale of the *Newton* court's determination would be applied to the very different nature of sampling *sound recordings*. That is the issue that the *Bridgeport Music* court was left to face.¹³⁵

2. *Bridgeport Music*: A Victory for Sampled Owners

In 1998, defendants No Limit Films, LLC and related entities released the film "I Got the Hook Up," which included a recording of the song "100 Miles and Runnin'" ("100 Miles") on its soundtrack.¹³⁶ Plaintiffs, owners of the musical composition and sound recording rights in "Get Off Your Ass and Jam" ("Get Off") brought suit for copyright infringement, as it was undisputed that "100 Miles" included a digital sample from the sound recording "Get Off."¹³⁷

A "three-note combination solo guitar 'riff' that lasts four seconds" opens the recording "Get Off."¹³⁸ From this guitar solo, defendants copied, lowered the pitch, looped, and extended a two-second sample, which appears five times throughout "100 Miles" for approximately seven seconds each time.¹³⁹ Rather than focusing on the copyrightability and originality of the solo guitar "riff,"¹⁴⁰ the district court concluded that the defendants' sampling was *de minimis* and did not "rise to the level of legally cognizable appropriation" under the "fragmented literal simi-

135. *Bridgeport Music, Inc. v. Dimension Films LLC*, 230 F. Supp. 2d 830, 832 (M.D. Tenn. 2002), rev'd 383 F.3d 390 (6th Cir. 2004), *rev'd*, 401 F.3d 647 (6th Cir. 2004), *aff'd* and amended on *reh'g*, 410 F.3d 792 (6th Cir. 2005).

136. *Id.* at 833.

137. *Id.* at 833. "Get Off Your Ass and Jam" originally by George Clinton, Jr. and the Funkadelics; see *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 796 (6th Cir. 2005).

138. *Bridgeport Music*, 410 F.3d at 796.

139. *Id.*

140. After listening to the recording "Get Off," the district court concluded that the guitar riff was entitled to copyright protection because "a jury could reasonably conclude that the way the arpeggiated chord is used and memorialized . . . is original and creative and therefore entitled to copyright protection." *Bridgeport Music*, 230 F. Supp. 2d at 839.

larity” test;¹⁴¹ therefore, the court granted the defendants’ motion for summary judgment.¹⁴²

On appeal to the Sixth Circuit, the plaintiffs argued that a *de minimis* inquiry is inappropriate when an undisputed and unlawful digital sample of a sound recording is involved.¹⁴³ The Sixth Circuit agreed with the plaintiffs, reversing the district court,¹⁴⁴ and developed a bright-line rule: “Get a license or do not sample.”¹⁴⁵ The court explained that, while the *de minimis* doctrine may be applicable in cases where infringement of the music composition is at issue, the infringement analysis for sound recordings necessitates a different approach.¹⁴⁶ The most controversial aspect of the case is the court’s self-proclaimed literal reading of § 114(b) of the Copyright Act which led to its holding that if the defendant cannot pirate the whole sound recording, he or she also cannot sample something less than the

141. *Id.* at 841. A typical cause of action for copyright infringement requires a plaintiff to prove that a defendant’s work of art is “substantially similar” to the plaintiff’s copyrighted work. *Steinberg v. Columbia Pictures Indus., Inc.*, 663 F. Supp. 706, 711 (1987). Substantial similarity depends on “whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.” *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966). On the other hand, the “fragmented literal similarity” test for copyright infringement arises when there is literal but not comprehensive similarity between the plaintiff’s and defendant’s works of art. 4 NIMMER & NIMMER, *supra* note 83, § 13.03[A][2] (“[T]he fundamental substance, or skeleton or overall scheme, of the plaintiff’s work has not been copied . . .”). Although literal similarity exists between the two works of art, a plaintiff will not prevail on a copyright infringement cause of action unless the amount that is literally copied constitutes a substantial quantitative or qualitative portion of the plaintiff’s work. *Id.* at § 13.03[A][2][a]. Thus, use of a snippet of a plaintiff’s song throughout a defendant’s song will not establish liability if that snippet only constitutes an insubstantial amount and nonessential portion of the plaintiff’s song. *Id.*

142. *Bridgeport Music*, 230 F. Supp. 2d at 842. Qualitatively, “no reasonable jury, even one familiar with the works of George Clinton (the author of ‘Get Off’), would recognize the source of the sample without having been told of its source.” *Id.* Quantitatively, the small amount sampled was a more significant portion of the later work which it was copied into, this could be significant, but quantitative analysis is only one factor of the substantial similarity analysis. *Id.* at 841.

143. *Bridgeport Music*, 410 F.3d at 798.

144. *Id.*

145. *Id.* at 801. The court did not believe that such a rule would stifle creativity because the free market would adequately control the price of sampled music. *Id.*

146. *Id.* at 798.

whole.¹⁴⁷

The court was convinced that, by enacting § 114(b) of the Act, Congress intended to provide *broader* rights to sound recording owners than it did to composition owners, as evidenced by its inclusion of the word “entirely” in the following phrase of § 114(b) regarding so-called limitations of sound recording copyright owners: The exclusive right of the owner of copyright in a sound recording . . . [does] not extend to the making or duplication of another sound recording that consists *entirely* of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording.”¹⁴⁸

The *Bridgeport Music* court read this provision not as a limitation on sound recording owners (as most scholars do), but as an affirmation that the sound recording *itself* is an independently viable, creative product that should be treated separately from the composition copyright, and thus, analyzed separately and distinctively.¹⁴⁹ As the court noted, “[f]or the sound recording copyright holder, it is not the ‘song’ but the sounds that are fixed in the medium of his choice. When those sounds are sampled they are taken directly from that fixed medium. It is a physical taking rather than an intellectual one.”¹⁵⁰

In support of this bright-line principle, the court advanced several important policy rationales in order to protect artists’ work from third-party digital sampling, even if only a *de minimis* amount was taken, while also ensuring that the constitutional purpose of copyright law was served.¹⁵¹ First, future third-party samplers are able to incorporate “riffs” from other works into their own recordings without sampling by either (a) independently creating the sound in the studio or (b) obtaining a license.¹⁵² Moreover, “the world at large is free to *imitate or simulate* the creative work fixed in the recording so long as an

147. *Id.* at 800.

148. 17 U.S.C. § 114(b) (2006) (emphasis added).

149. *Bridgeport Music*, 410 F.3d at 800.

150. *Id.* at 802.

151. *Id.* at 801 (“We do not see this [bright-line rule] as stifling creativity in any significant way.”); *see also* U.S. Const. art. I, § 8, cl. 8 (“The Congress shall have the power . . . [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . .”).

152. *Bridgeport Music*, 410 F.3d at 801.

actual copy of the sound recording itself is not made.”¹⁵³ Additionally, the market can control the prices of licensing fees.¹⁵⁴

Second, although the amount sampled from a recording may be *de minimis*, every time one musician samples another musician’s recording, “the part taken is something of value” to the copyright holder who fixes particular sounds “in the medium of his choice.”¹⁵⁵ Further strengthening this rationale is the conclusion that sampling is always intentional on the part of the third party sampler in order to save costs¹⁵⁶ and/or add something to the third-party’s recording.¹⁵⁷

Finally, the predictability of a bright-line rule led the Sixth Circuit to reverse the district court’s decision and place emphasis on a *de minimis* inquiry.¹⁵⁸ A *de minimis* or substantial similarity analysis is not ideal in cases of digital sampling, as it would require “mental, musicological, and technological gymnastics” to determine the requisite threshold of what does or does not constitute infringement.¹⁵⁹ While it may be possible for

153. *Id.* at 800 (emphasis added). In fact, when owners of sound recordings refuse to license their music to sampling musicians for re-use, or agree to do so for such exorbitantly high fees that the sampling musician cannot afford it, another option is to hire a “sample recreation” company that will re-record new versions of the original song, “and can do so to such a high standard that the original version and the new one are practically indistinguishable.” Richard Salmon, *Sample Clearance: The SOS Guide to Copyright Law on Sampling*, Sound on Sound (March 2008), http://www.soundonsound.com/sos/mar08/articles/sampleclearance_0308.htm.

154. *Bridgeport Music*, 410 F.3d at 801.

155. *Id.* at 802.

156. For an interesting viewpoint regarding the dangers of sampled music replacing real session musicians, see Christopher D. Abramson, *Digital Sampling and the Recording Musician: A Proposal for Legislative Protection*, 74 N.Y.U. L. REV. 1660, 1662 (1999),

Digital sampling may be the greatest threat facing instrumental musicians today. The production of music using samples taken from preexisting recordings in lieu of hiring live musicians is a unique problem. Unlike a synthesizer, a sample does not sound like a musician playing an instrument, it is a recording of a musician playing an instrument. Unlike a phonograph record, a sample allows a musician’s performance to be reused in a completely different piece of music. The *reuse* of the musician’s work distinguishes his or her plight from that of the factory worker who is replaced by machines. Unlike factory workers, musicians *created* the product that replaces them.

Id.

157. *Bridgeport Music*, 410 F.3d at 801–02 (“When you sample a sound recording you know you are taking another’s work product.”).

158. *Id.* at 802.

159. *Id.*

courts to conclude that any digital sample resulting in a “modifi[ca]tion] to the point of being completely unrecognizable or impossible to associate with the copied recording” constitutes infringement,¹⁶⁰ a bright-line rule is more desirable as it substantially reduces uncertainty in the music industry.¹⁶¹ After all, the Sixth Circuit’s opinion was focused on the impact of a new bright-line rule on the music industry rather than being driven by any considerations of judicial economy.¹⁶²

Although the court was adamant in articulating its reasons for a bright-line rule on sampling, it proceeded to hold that, while the defendants’ actions amounted to infringement, they were nonetheless entitled to a fair use analysis of their conduct and that “[o]n remand, the trial judge is free to consider this defense and we express no opinion on its applicability to these facts.”¹⁶³

3. Criticism of the *Bridgeport* Holding

The Sixth Circuit holding in *Bridgeport Music* has continued to be met with severe criticism by musicians and copyright scholars.¹⁶⁴ Subsequent courts hearing sampling-infringement cases have similarly been reluctant to follow its rationale. For example, in 2009, the Southern District of Florida had the opportunity to rule on the issue of digital sampling in *Saregama India, Ltd. v. Mosley*.¹⁶⁵ In *Saregama*, the plaintiff recording

160. *Id.* at 803 n.18. While the court’s ruling technically makes any unauthorized sample an infringement, “in practice it is likely that only commercially successful remixes will be prosecuted by the record industry.” Fredrich N. Lim, Note, *Grey Tuesday Leads to Blue Monday? Digital Sampling of Sound Recordings After The Grey Album*, 2004 U. ILL. J.L. TECH. & POL’Y 369, 379 (2004).

161. AL KOHN & BOB KOHN, KOHN ON MUSIC LICENSING 1486–87 (3d ed. 2002).

162. *Bridgeport Music*, 410 F.3d at 803.

163. *Id.* at 805.

164. See Matthew S. Garnett, Note, *The Downhill Battle to Copyright Sonic Ideas in Bridgeport Music*, 7 VAND. J. ENT. L. & PRAC. 509, 516 (2005) (after publication of the *Bridgeport* ruling, “commentary and criticism . . . erupted across the Internet, in the ‘blogosphere,’ and in other publications”); see also, Lim, *supra* note 160, at 377 (admonishing the court’s opinion by claiming that it results in a situation where “the spirit of copyright law does not seem to apply when faceless corporations use the law to dissuade other artists from using works within the corporations’ control”); Ben Sheffner, “Gurl” Trouble: Examining the Merits of Rondor Music’s Complaint About the Katy Perry Hit,” *BILLBOARD*, Aug. 21, 2010, at 11 (referring to the court’s holding as “a decision that sampling proponents have harshly criticized”).

165. *Saregama India Ltd. v. Mosley*, 687 F.Supp.2d 1325 (S.D. Fla. 2009).

company sued producer Tim Mosley and other defendants for their use of a sample of an Indian sound recording entitled *Bagor* “Mein Bahar Hai” (BMBH) in Mosley’s song “Put You on the Game” (PYOG) which was subsequently featured on “The Documentary,” a 2005 album by Jayceon Taylor.¹⁶⁶ Although the sample was a “one-second snippet”¹⁶⁷ of BMBH that consisted of three notes (D, B-flat and G), the notes together formed a descending chord known as a G-minor *arpeggio* that was looped four times in PYOG to create a two-second long “vocal unit”¹⁶⁸ that was found in 109 of the 254 second duration of PYOG.¹⁶⁹ The defendants admitted to sampling BMBH and the parties cross moved for summary judgment on the issues of ownership of the copyright and infringement.¹⁷⁰

Regarding the issue of ownership, the district court held that a 1967 agreement executed between Saregama India’s predecessor in interest and a third-party film producer conferred to Saregama India, at most, a two-year exclusive license to the sound recording which became nonexclusive after the expiration of the two-year term.¹⁷¹ On the issue of originality, the court found that while the sampled portion of Saregama India’s song was a “common vocal exercise,” it would nonetheless be reasonable for a jury to conclude “that the female vocal performance of the G minor chord is a distinct expression capable of copyright protection.”¹⁷² The court next analyzed whether “PYOG” infringed the plaintiff’s work, focusing on whether the songs taken as a whole demonstrated that they were substantially similar, and if so, whether the defendants’ use of “BMBH” was merely *de minimis*, and thus, not actionable.¹⁷³ The court found no substantial similarity as a matter of law because the average lay observer would not mistake “PYOG” for “BMBH” or be able to discern the source of the sample “without prior warning,” since “[o]ther than the one-second snippet, the songs bear

166. *Id.* at 1326.

167. *Id.* at 1330.

168. *Id.*

169. Brief for Appellant at 8 *Saregama India Ltd. v. Mosley*, 687 F.Supp.2d 1325 (S.D. Fla. 2009) (No. 10-10626-F), 2010 WL 4411103.

170. *Saregama India*, 687 F.Supp.2d, at 1326.

171. *Id.* at 1326–27.

172. *Id.* at 1337.

173. *Id.* at 1337–38.

no similarities.”¹⁷⁴

It is noteworthy that the court went on to address Saregama India’s contention, in direct reliance on *Bridgeport Music*, that sound recordings should be analyzed differently than musical compositions, specifically, that any sampling of a sound recording constitutes infringement without application of a *de minimis* analysis.¹⁷⁵ Citing several copyright infringement cases that deal with subject matter other than sound recordings, the court refused to carve out a separate test for sound recordings, instead insisting that the *Bridgeport Music* holding is a departure from Eleventh Circuit precedent, which requires the performance of a substantial similarity test for all claims of copyright infringement.¹⁷⁶ Additionally, the *Saregama India* court opined that the Sixth Circuit’s reading of § 114(b) in *Bridgeport Music* does not support its rendition of a *per se* taking rule for copying of digital samples because it “is more expansive than its text and legislative history suggest.”¹⁷⁷

After the plaintiffs appealed the lower court decision, everyone in the music industry anxiously waited to see whether the Eleventh Circuit would overturn the decision and apply the same *per se* taking analysis to digital sampling as the Sixth Circuit did in *Bridgeport Music*. In an anticlimactic holding on March 25, 2011, the Eleventh Circuit in *Saregama Music* affirmed the district court’s ruling, holding that since the plaintiff did not own a valid copyright in the song recording at issue, the court “need not face the question of whether this copyright has been infringed.”¹⁷⁸ As such, the *Bridgeport Music* court’s ruling stands as the only appellate court precedent regarding the issue of whether a *de minimis* analysis of a sampling defendant’s acts should be applied to the infringement of a sound recording.

174. *Id.* at 1338.

175. *Id.* at 1338–41.

176. *Id.* at 1338–39. The court relied primarily on *Leigh v. Warner Bros., Inc.* for this assertion, quoting the court in that case as stating that “[e]ven in the rare case of a plaintiff with direct evidence that a defendant attempted to appropriate his original expression, there is no infringement unless the defendant succeeded to a meaningful degree.” *Leigh v. Warner Bros., Inc.*, 212 F.3d 210, 212 (11th Cir. 2000). The *Leigh* case, however, involved a photograph taken by the defendants which, although similar to Leigh’s original photograph, did not directly use or copy any portion of it. *Id.* at 1214.

177. *Saregama India*, 687 F.Supp.2d at 1340.

178. *Saregama India Ltd. v. Timothy Mosley*, 635 F.3d 1284, 1290 (11th Cir. 2011).

4. Endorsement of the *Bridgeport* Holding

Despite widespread industry contempt for the *Bridgeport Music* holding, the U.S. District Court for the Eastern District of Michigan issued an opinion three years later that unequivocally endorsed the reasoning of the Sixth Circuit regarding the proper legal analysis that courts should follow in copyright suits alleging infringement of a sampled recording.¹⁷⁹ In *Pharmacy Records v. Nassar*, the court was tasked with determining whether the defendants' use of the plaintiffs' recording constitutes unlawful sampling under 17 U.S.C. § 114(b).¹⁸⁰ The court held that the defendants were entitled to judgment as a matter of law because a reasonable jury would not be able to conclude from the evidence presented that the defendants, in fact, sampled the plaintiffs' song.¹⁸¹ Regardless of the facts in this particular case, the court opined that, had the plaintiffs established that the defendants did sample their music, their claim "might survive" by "[a]pplying the proper test" for infringement of sound recordings as set forth in the *Bridgeport Music* holding.¹⁸²

In a copyright infringement action against a distributor for acts of re-recording popular songs, another district court in the Sixth Circuit recently reaffirmed the rationale of its upper court's holding in *Bridgeport Music* when it reiterated the "new standard for analyzing copyright infringement of sound recordings."¹⁸³ The court also unequivocally stated that "the Sixth

179. *Pharmacy Records v. Nassar*, 248 F.R.D. 507, 509 (E.D. Mich. 2008); see David M. Morrison, *Bridgeport Redux: Digital Sampling and Audience Recording*, 19 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 75, 81 (2008).

180. *Pharmacy Records*, 248 F.R.D. at 509.

181. *Id.* at 528.

182. *Id.* The Pharmacy Records Court held that:

The protection afforded sound recordings in a digital sampling case such as the one now before the Court, therefore, does not extend to the "generic sound"; it only protects the recorded sound—the stored electronic data digitally preserved by the composer. The substantial similarity test thus has no place in determining whether infringement occurred. As the Sixth Circuit [in *Bridgeport Music*] explained, "[i]n most copyright actions, the issue is whether the infringing work is substantially similar to the original work The scope of inquiry is much narrower when the work in question is a sound recording. The only issue is whether the actual sound recording has been used without authorization. Substantial similarity is not an issue."

Id. at 527 (quoting *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 798 n.6).

183. *King Records, Inc. v. Bennett*, 438 F.Supp.2d 812, 850 (M.D. Tenn.

Circuit held that any sampling of a sound recording constitutes copyright infringement *per se*, regardless of whether the defendant's work is substantially similar to the plaintiff's work, and regardless of whether the relevant audience can identify the copied material."¹⁸⁴

The Tenth Circuit also favorably cited the *Bridgeport Music* holding when it ruled in a case where the owner of copyrights in karaoke music sound recordings sued a manufacturer of retail karaoke products for infringement.¹⁸⁵

The concept is simple. In order for a party in Palladium's position to lawfully use preexisting, copyrighted musical works to create and sell its sound recordings, it must first secure the appropriate licensing from the copyright owners of those musical works.¹⁸⁶ By failing to comply with Section 115, Palladium has illegally used the preexisting material.¹⁸⁷ As a result, Palladium's copyrights in the sound recordings at issue are invalid and unenforceable.¹⁸⁸

At least one scholar other than myself has embraced the *Bridgeport Music* court's willingness to distinguish that there is a difference between the taking of basic melodies from a composition, which rightly belong in the public domain should it be proved that such use is *de minimis*, and the taking of those same melodies as captured in a sound recording. Michael Allyn Pote has stated:

In a musical composition, the ideas may consist of rather basic elements of a song, such as arranging a song to end on a chorus, using a guitar, or singing. Or, the ideas may be much more complex, such as using a double-thumbing technique for guitar. The actual expression of a musical composition would include, for example, the specific arrangement of notes that comprise the melody, the specific words used to constitute the lyrics, and the combinations of all of the instruments that create the rhythm and harmony of the song during a specific portion. The distinction for sound recordings is much clearer since the

2006).

184. *Id.* at 850 (specifically noting the rejection by the Sixth Circuit of the substantial similarity test and the *de minimis* doctrine when analyzing sound recording infringement claims).

185. *Palladium Music, Inc. v. EatSleepMusic, Inc.*, 398 F.3d 1193, 1199 (10th Cir. 2005).

186. *See Bridgeport Music, Inc. v. Dimension Films*, 383 F.3d 390, 398 n. 7 (6th Cir. 2004) ("Needless to say, in the case of a [sound] recording of a musical composition the imitator would have to clear with the holder of the composition copyright.")

187. *See* 17 U.S.C. § 103(a).

188. *Id.*

expression is essentially the fixation of sounds. Thus, a digital sample, or really any sample, would copy the exact expression. The ideas of the sound recording include such elements as the selection of reverb on the vocal or instruments, the spatial placement of the instruments in the mix, the style of compression applied to the overall mix, and so on.¹⁸⁹

From the above review of *Bridgeport Music* and the few sampling cases that have followed, it is evident that the issue of sampling sound recordings is far from resolved in the United States. Concurrently, courts in Germany have been struggling with the same point in question.

B. GERMANY: NEIGHBORING RIGHTS PROTECTION FOR SOUND RECORDINGS

The German Constitution is similar to the U.S. Constitution in that it contains a specific provision—Article 14—which authorizes the legislature in Germany to enact laws that will provide for copyright protection.¹⁹⁰ Article 14 contains both a copyright protection clause for creators, as well as a duty to balance that property interest with the public interest.¹⁹¹ The German Copyright Act or *Urheberrechtsgesetz* (UrhG) was enacted pursuant to this constitutional authority in 1965, providing copyright protection for the life of the author plus seventy years.¹⁹² In creating subject matter protection for copyright

189. Pote, *supra* note 40, at 668.

190. Christopher Geiger, *Promoting Creativity Through Copyright Limitations: Reflections on the Concept of Exclusivity in Copyright Law*, 12 VAND. J. ENT. & TECH. L. 515, 539 (2010).

191. Braegelmann, *supra* note 64, at 126. Because the property clause of the German Constitution is qualified by a ‘public good’ /‘general welfare’ /‘common weal’ provision (*Allgemeinwohlbindung*), the legislature has to make sure that it strikes a just and appropriate balance between the individual interests of authors to profit from their creations on the one hand, and those of the public (and publishers and so forth) to exploit the works on the other hand, taking into account the nature and social importance of the right in question. *Id.*

192. *Id.* at 126–27. The German word “*Urheber*” means “creator of the work” and generally covers all types of copyrights, including musical compositions and sound recordings. Jan Timothy Williams, Note, *The Pre-Amended Google Books Settlement, International Orphan Works, and German Copyright Law: An Analysis*, 19 U. MIAMI BUS. L. REV. 51, 57 (2011). The pervasive use of the term *Urheber* in German copyright law provides further insight to the underlying natural rights philosophy which focuses on the creator as having a special connection to the work, as opposed to the American view of copyrights as primarily economic commodities that focus on the holder of the copyright. *Id.* at 56–57.

law, the state is required “to bring the different interests [of the copyright owners] and the competing fundamental rights [of the public welfare] in a proportional balance” by assuring that the public has access to “cultural assets.”¹⁹³

Although German copyright law does not recognize the defense of fair use in the same manner in which it is applied in U.S. law *per se*,¹⁹⁴ the concept of public access or “free use” of cultural assets is generally analogous to fair use, and is promulgated with the following policy goals in mind:

One of the policy reasons for . . . UrhG’s time limit is that the general public can demand the free use of intellectual goods for the improvement of cultural life (*Kulturleben*). Another is the fact that every creative person is not creating in a vacuum and without history but is rather building upon the work of his or her predecessors. Yet another is that every cultural expression, if it is not forgotten, becomes some kind of public good or intellectual/creative commons (*geistiges Gemeingut*) and the cultural possession (*Kulturbesitz*) of everybody.¹⁹⁵

In order to promulgate this policy, the German legislature has enacted section 24 of the UrhG, commonly referred to as the *Freie Benutzung* or “free use” provision, which allows third-party use of an author’s protected work without prior consent, provided that the second work amounts to an “independent” new work.¹⁹⁶ Although the provision does not contain a clear-cut definition of an independent work, it is “commonly recognised as such in German law if the elements of the older work used ‘fade’ in comparison to the individuality of the new work.”¹⁹⁷ Like the U.S. doctrine of fair use, free use is an exception or defense to copyright infringement that is determined on an *ad hoc*, case-by-case basis for the purpose of “find[ing] equitable and just solutions” when balancing the delicate rights of owners and subsequent creators.¹⁹⁸ However, the German free use exception is an even narrower doctrine than fair use because it only allows for transformative uses.¹⁹⁹ One German court has explained the free use defense as only being justified if the secondary work ceases to be “deferential” to the original

193. Geiger, *supra* note 190, at 540–41.

194. See Edward Lee, *Technological Fair Use*, 83 S. CAL. L. REV. 797, 872–73 (2010).

195. Braegelmann, *supra* note 64, at 127.

196. Apel, *supra* note 11, at 344–45.

197. *Id.* at 344.

198. Paul Edward Geller, Hiroshige vs. Van Gogh: *Resolving the Dilemma of Copyright Scope in Remediating Infringement*, 46 J. COPYRIGHT SOC’Y U.S.A. 39, 43–44 (1998).

199. *Id.* at 43.

work or adopts a “probing” approach to the original work, further clarifying its analysis as follows:

The question whether a new independent work has been created by the free use of a protected earlier work depends on the distance which the new work keeps from the borrowed personal features of the used work In other words, as a rule the personal features borrowed from the protected earlier work recede in such a way that the new work no longer makes significant use of the earlier, so that the latter appears only to have suggested the creation of a new independent work.²⁰⁰

In addition to the distinctions between fair use and free use, where the philosophical differences between copyright law in Germany and the United States differ significantly (as previously discussed), is that the justification for copyright predominantly accepted in Germany is the fundamental qualification of the copyright as being based on a personality right, or “moral right” known as *Urheberpersönlichkeitsrecht*, meaning that “[i]n Germany, the copyright is intrinsically and inseparably tied to the personality of the author.”²⁰¹ Just as with other categories of creative authorship, German law offers legal protection to musical works pursuant to an “authors’ rights system,” which protects not only the creative endeavors of the person(s) who perform the work, but also the economic or entrepreneurial efforts of the *Tonträgerhersteller*, or producer, of the sound recording.²⁰²

Unlike the United States, in Germany there is no copyright protection in the sound recording itself because sound recordings are simply not considered to be “intellectual creation[s],” or creations that contain originality and creativity.²⁰³ Sound recordings are instead protected under the UrhG by “neighboring rights,” or “related rights,”²⁰⁴ which “are granted to performers, producers, and broadcasters, not for their original, creative input in making a sound recording/phonogram, but for the finan-

200. See Ian Eagles, *Dr Zhivago’s Children: Some Lessons from German Copyright Law’s Encounter with the Sequel*, 10 NEW ZEALAND BUS. L. Q. 109, 111 (2004) (quoting BGH I ZR 65/96, 29 April 1999, reported in English at [2000] ECC 355).

201. Braegelmann, *supra* note 64 at 127–28.

202. Apel, *supra* note 11, at 337.

203. Conley & Braegelmann, *supra* note 8, at 1018–19.

204. *Id.* at 1019. Neighboring rights are also referred to as “related rights” in order to distinguish them from author’s rights in the copyright. JOHN SHEPHERD, CONTINUUM ENCYCLOPEDIA OF POPULAR MUSIC OF THE WORLD, VOL. 1 at 491 (2003).

cial, organizational, and technical effort these persons expend to make a sound recording/phonogram.”²⁰⁵ While the UrhG does not specifically define “producer of a phonogram,” the term has commonly come to mean “the natural or legal person in charge of the organization for the whole process of recording.”²⁰⁶ While this legal entity *may* be the creative producer in the recording studio, it may also be the owner of the record company that manufactures and sells copies of the recording *after* the recording has been made.²⁰⁷

One author has appropriately labeled neighboring rights as “quasi-artistic rights allied to copyright law” and describes them as:

[L]aws that protect performers’ renditions, broadcasts, and producers’ sound recordings. New communications technologies have redefined this role between artists and intermediaries by making the old concert hall portable and bringing it into the homes of individual viewers and listeners, along with the performers’ renditions. In so doing, performers, phonogram producers, and broadcast organizations often add an important artistic dimension to the authors’ own contributions. In effect, the neighboring rights laws enable impresarios, producers, and performers to collect a reward for their services even under these changed conditions, and this in turn further ensures that authors covered by copyright law will also receive compensation.²⁰⁸

The policy reasons for the creation of a neighboring rights in sound recordings in Germany stem from those that led to the enactment of § 114 in the United States: “[t]he easy availability in the market of increasingly efficient recording devices created the growing problem of record piracy, which by now has become a worldwide problem.”²⁰⁹ Other initiatives were taken in Germany to protect sound recordings, including ratification of the 1961 Rome Convention, formally known as the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, which is the only international treaty governing performers’ rights in sound recordings.²¹⁰ The Rome Convention requires signatory members “to

205. Conley & Braegelmann, *supra* note 8, at 1021.

206. Apel, *supra* note 11, at 338.

207. *Id.*

208. See J.H. Reichman, *Legal Hybrids Between Patent and Copyright Paradigms*, 94 COLUM. L. REV. 2432, 2498–99 (1994).

209. See WORLD INTELLECTUAL PROPERTY ORGANIZATION, INTRODUCTION TO INTELLECTUAL PROPERTY: THEORY AND PRACTICE 6 (1997).

210. INTERNATIONAL CONVENTION FOR THE PROTECTION OF PERFORMERS, PRODUCERS OF PHONOGRAMS AND BROADCASTING ORGANISATIONS, Oct. 26, 1961, 496 U.N.T.S. 43.

grant equitable remuneration to either performers or producers of sound recordings, or both”²¹¹ by providing them with “the right to authorize or prohibit the direct or indirect reproduction of their phonograms.”²¹² Specifically, Article 12 of the Rome Convention provides,

If a phonogram published for commercial purposes, or a reproduction of such phonogram, is used directly for broadcasting or for any communication to the public, a single equitable remuneration shall be paid by the user to the performers, or to the producers of the phonograms, or to both. Domestic law may, in the absence of agreement between these parties, lay down the conditions as to the sharing of this remuneration.²¹³

Neighboring rights, which almost always vest in a corporate entity, are also different from moral rights because they do not stem from the personality of the artist or creator. Because “it is considered inappropriate to accord corporations moral rights,” the Rome Convention protects only the reproduction right of the owner of the neighboring right, and not the right of distortion, mutilation, or attribution.²¹⁴ While a sampling defendant’s acts may result in an infringement of the artist’s moral rights in the *performance* of the musical work at issue, the *Kraftwerk* decision did not involve this separate right, which is thus outside of the scope of this article.²¹⁵

While neighboring rights, or *verwandte Schutzrechte*, are generally comparable to the sound-recording right granted by U.S. copyright law, in that the owner is provided with the exclusive right to copy the recording (yet receives no moral right in the work), German neighboring rights exist in each and every sound recording that is produced without having to overcome the originality requirement that exists under the U.S. Copy-

211. Matthew S. DelNero, *Long Overdue? An Exploration of the Status and Merit of a General Public Performance Right in Sound Recordings*, 6 VAND. J. ENT L. & PRAC. 181, 190 (2004).

212. INTERNATIONAL CONVENTION FOR THE PROTECTION OF PERFORMERS, PRODUCERS OF PHONOGRAMS AND BROADCASTING ORGANISATIONS, art 10, Oct. 26, 1961, 496 U.N.T.S. 43. The “producer of phonograms” is defined in the Rome Convention as “the person who, or the legal entity which, first fixes the sounds of a performance or of other sounds.” *Id.* art. 3(c).

213. *Id.* art. 12.

214. Rebecca F. Martin, *The WIPO Performances and Phonograms Treaty: Will the U.S. Whistle a New Tune?*, 44 J. COPYRIGHT SOC’Y U.S.A. 157, 167 (1997).

215. See Apel, *supra* note 11, at 338.

right Act.²¹⁶ Specifically, Section 85 of the URGH provides the producer with rights to reproduce the phonogram, to distribute the phonogram, and to make the phonogram available to the public, that expire fifty years after publication of the work at issue.²¹⁷

1. *Kraftwerk*: The German Court Rules on Sampling

In the 1970s, the band Kraftwerk emerged from Dusseldorf, Germany to defy the then-popular forms of disco and punk music by becoming pioneers in a new genre of electronica (also known as synchronized or “synch”) music that fused analog synthesized bleeps, blips, and vocals “into a stark, precision product . . . mostly with hand-built instruments.”²¹⁸ Early bands like Kraftwerk that created electronically generated music started by imitating traditional musical instruments, but would later evolve to incorporate sampling techniques and other computer-generated or recorded media to the point where the resulting work product contained “only a tenuous mimetic relationship to live performance.”²¹⁹

As Kraftwerk grew in popularity among its fans worldwide, so did third-party use of sampled portions of its recordings.²²⁰

216. *Id.* at 8, at 337–38. The German equivalent to the low level of originality demanded by the United States is known as *kleine Münze* which translates to “small change,” evidencing that “almost every creative expression is copy-rightable in Germany.” See Braegelmann, *supra* note 64, at 111 n.59.

217. Apel, *supra* note 11, at 338.

218. GREG RULE, ELECTRO SHOCK!: GROUNDBREAKERS OF SYNTH MUSIC V (1999). The founding members of the band were drawn to experimental music and free jazz. They experimented with tape recorders, echo machines, and drum machines. “Kraftwerk’s members were among the first pop musicians to abandon traditional rock instrumentation for what was then still-new synthesizer/electronic technology.” Richard Harrington, *These Days, Kraftwerk is Packing Light*, WASH. POST, May 27, 2005, at 8; *see also*, Richard T. Ford, *Save the Robots: Cyber Profiling and Your So-Called Life*, 52 STAN. L. REV. 1573, 1581 (2000) (commenting that when Kraftwerk’s album “We are the Robots” was released in 1980, “it sounded like the soundtrack to a stylized form of science fiction.”).

219. Ford, *supra* note 218, at 1581.

220. *See, e.g.*, PASCAL BUSSY, KRAFTWERK: MAN, MACHINE AND MUSIC 128 (2004) (“To list the number of samples that have been taken from Kraftwerk records would be an arduous and difficult task, but suffice to say that after James Brown their records are amongst the most sampled . . .”); Stephen Dalton, *Some of His Best Friends are Robots; Kraftwerk are the Elusive Kings of Digital Pop*, TIMES (London), Sep. 25, 2009, at T2 (noting that the band’s “music has been sampled everywhere, from Fatboy Slim to the Chemical Brothers, Missy Elliott to Jay-Z”). An Internet site created by fans of Kraftwerk has listed nearly one hundred songs claimed to contain samples of

In 1982, the band was furious after musician Afrika Bambaataa made a record called “Planet Rock,” in which he sampled a melody from Kraftwerk’s “Trans-Europe Express” as well as a rhythm track from “Numbers” without asking permission or providing credit to Kraftwerk.²²¹ After a legal battle with Bambaataa, his song was renamed “Planet Rock/Trans-Europe Express” and Kraftwerk received royalties for sales of Bambaataa’s records containing the samples.²²²

In 1977, Kraftwerk released an album that contained the song “Metall auf Metall”, which is the subject of the band’s current sampling controversy.²²³ Twenty years later, two versions of the song “Nur mir” by singer Sabrina Setlur were released on two different albums²²⁴ and Kraftwerk sued,²²⁵ claiming that the defendants, Setlur and her producers, unlawfully sampled the “core” of “Metall auf Metall”—“a distinct rhythm-texture of several percussion instruments,” which lasts approximately two seconds and is repeated throughout the defendants’ song.²²⁶ More specifically, Kraftwerk argued that the composers of “Nur mir” infringed Kraftwerk’s copyright, in addition to its rights as performing artists and producers of phonograms.²²⁷

Kraftwerk prevailed at both the regional court and appeals court based on the rationale that the composers of “Nur mir” infringed Kraftwerk’s rights as producers of phonograms pursuant to neighboring rights law in Germany under Section 85 of the UrhG.²²⁸ Notably, the lower court did not rule on the issue of whether use of the sample by the defendants also consti-

the band’s recorded music. The Followers, KRAFTWERK SAMPLED, <http://www.cheebadesign.com/perfect/kraftwerk/sample.htm> (last visited Aug. 6, 2010).

221. BUSSY, *supra* note 220, at 128.

222. *Id.*

223. Conley & Braegelmann, *supra* note 8, at 1025.

224. *Id.*

225. Bundesgerichtshof [BGH] [Federal Court of Justice] I ZR 112/06 Nov. 20, 2008, Systematische Sammlung der Entscheidungen des Bundesgerichtshofes [BGHR] (Ger.) (for an English translation, see Conley & Braegelmann, *supra* note 8); see Apel, *supra* note 8, at 333 n.14.

226. Conley & Braegelmann, *supra* note 8, at 1026.

227. *Id.*

228. *Id.* at 1025–1026. According to copyright law in Germany, “[t]he producer of an audio recording shall have the exclusive right to reproduce and distribute the recording.” Urheberrechtsgesetz [UrhG] [Copyright Act], Sept 9, 1965, Bundesgesetzblatt, Teil I [BGBl. I] at art. 83(1), last amended by Gesetz, Dec. 7, 2008, BGBl. I at 2349, § 2(1) (Ger.).

tutes copyright infringement of the underlying musical composition; the case is, thus, based solely on whether Kraftwerk's neighboring right in the sound recording was infringed.²²⁹

The appeals court held that "even the unauthorized *partial* reproduction and distribution of phonograms infringes, in principle, the rights of phonogram producers."²³⁰ Rather than determining whether the amount sampled by the composers of "Nur mir" was *de minimis*, the appeals court viewed the drum-beat rhythm-texture from bars nineteen and twenty of "Metall auf Metall" as the "core" of Kraftwerk's song as well as clearly recognizable in the song "Nur mir."²³¹ Therefore, "by appropriating this particular element in its entirety, and continuously underl[aying] it in the song *Nur mir*, the . . . [composers of *Nur mir*] appropriated, in essence, the entire song [*Metall auf Metall*], which consists of the continuous repetition of this formative part, thereby saving themselves effort and expense."²³²

The supreme court held that even if the core of Kraftwerk's song had not been taken, "the partial unauthorized reproduction or distribution of the audio recording that is fixed on a phonogram interferes with the rights of the producer of the phonogram."²³³ The court reasoned that, to hold otherwise would be inconsistent with policies set forth in the Geneva Phonograms Convention, which "require that producers of phonograms receive protection against the reproduction and distribution of *substantial* parts of the sounds that are fixed on the phonogram."²³⁴ In its holding, the court reasoned, "[i]f only the unauthorized reproduction and distribution of the entire phonogram were prohibited, the protection afforded the producer of phonograms would be largely ineffective, as the Plaintiffs' reply to the appeal correctly points out, especially in light of modern digital recording, reproduction, and rendition technologies."²³⁵

Recognizing that neighboring rights are designed to protect the producer's economic and organizational efforts in the creation of the phonogram, which are separate from the infringement of the author's rights or the personal intellectual creation

229. Conley & Braegelmann, *supra* note 8, at 1018.

230. *Id.* at 1026 (emphasis added).

231. *Id.*

232. *Id.*

233. *Id.* at 1027.

234. *Id.* at 1027 (emphasis added).

235. *Id.*

of the composer, the court held that the length of the phonogram copied by the sampler is irrelevant to the determination of infringement “because every single bit of sound on such a record owes its origin to the efforts of the producer.”²³⁶ Similarly, the supreme court admonished the appellate court’s reliance on the significance of whether the quality or quantity of the sounds taken were proper criteria in determining neighboring rights infringement, pointing out that such a test in sampling cases would lead “to difficulties of delimitations, and therefore, to legal uncertainty.”²³⁷ In fact, even if short samples from original songs are not ultimately recognizable or discernible when used in the defendants’ songs, such uses are nonetheless actionable even if they are proven not to have an effect on the economic exploitation of the owner’s original song.²³⁸ This is demonstrated by virtue of the fact that a market exists for even the smallest sample of certain recordings, resulting in the phenomenon that, at the very least, the producer will suffer from an economic disadvantage from lost royalties of sounds used by others without prior consent of the producer.²³⁹

At this point in the *Kraftwerk* opinion, it appears that the court is borrowing (pun intended) similar, if not the same, analyses of sampling that the *Bridgeport Music* court employed, including notions of fairness, free riding, ease of infringement, legal certainty, judicial economy, and the importance in creating the proper boundaries of infringement for those who choose to sample without obtaining a license.²⁴⁰ The bottom line for both courts, as well as the message to potential samplers, is that infringement of the sound recording in the United States and the neighboring right in Germany will be determined if *any* portion of the recording is taken without authorization because taking any part is taking something of value to its owner.

236. Apel, *supra* note 11, at 343.

237. Conley & Braegelmann, *supra* note 8, at 1029. The court explained that neighboring rights protect all sounds that are recorded on a phonogram, from a work as complex as multiple movements in a symphony to one that contains merely a “short bird chirp.” *Id.*

238. *Id.* at 1030.

239. *Id.* at 1030–31.

240. *Id.* at 1018; *see also* Apel, *supra* note 11, at 342 (noting that the *Kraftwerk* court’s opinion not only referred to the holding in *Bridgeport Music*, but that its reasoning on these issues are “in line with the prevailing opinion in German legal literature”).

The second part of the *Kraftwerk* opinion, however, is a significant departure from this line of reasoning, and as such, has been widely criticized by German commentators.²⁴¹ Although the court unabashedly ruled that any taking from a sound recording was an infringement of the producer's neighboring rights, it went on to opine—as did the *Bridgeport Music* court—that the defendants were, nonetheless, entitled to wage a free use argument in an attempt to excuse their infringing conduct.²⁴² Unlike the *Bridgeport Music* court, however, when the *Kraftwerk* court remanded the case back to the appeals court to determine *inter alia* whether the defendants in the case at hand can rely on free use, it provided guidance and a specific test for the lower court to employ.²⁴³

First, the court observed that the free use exception set forth in Section 24 of the UrhG cannot be directly applied to neighboring rights of phonograms because the provision is set forth in Section 85, paragraph 4 of the act, which contains the limitations and exceptions to the use of the separate copyrighted “work,” or intellectual creation of the song, whereas neighboring rights are “only protected because of the entrepreneurial effort that is embodied in it.”²⁴⁴ Nonetheless, the court went on to hold that the defenses to copyright are “applicable by analogy to the exploitation rights of the producer of phonograms,” providing the following public policy reasons for its position on the matter:

[I]t would run counter to the spirit and purpose of section 24, paragraph 1, of the UrhG, which is to bring about cultural progress, if in actuality only the creator [author] was obligated to accept the free use of a work, while the producer of phonograms could prevent the free use of the phonogram that contains the work. If the creator [author] is obligated to accept a limitation to his copyright, then the producer of phonograms must correspondingly accept a limitation to his neighboring right.²⁴⁵

While the court made it clear that the free use exception in copyright applies *mutatis mutandis* to neighboring rights, it provided two exceptions in which Section 24 would not provide refuge to sampling defendants: first, in cases where the defendant is able to reproduce the sound copied in the phonogram by

241. See Apel, *supra* note 11, at 345–47.

242. *Id.* at 344.

243. Conley & Braegelmann, *supra* note 8, at 1037.

244. *Id.* at 1033. Chapter 6, part 1 of the UrhG contains most of the exemptions to authors' rights. Apel, *supra* note 11, at 346.

245. Conley & Braegelmann, *supra* note 8, at 1033–34.

his or herself; and second, when the part of the sound copied by the defendant is a recognizable melody.²⁴⁶ Because the court ascertained that there were insufficient findings by the appeals court on these two issues, it remanded the case to the lower court for further consideration in reliance on its opinion.²⁴⁷

On August 17, 2011, the court on remand first clarified that the *Freie Benutzung* or “free use” provision of Section 24 of the UrhG does, indeed, apply to “Nur mir” because the song is a “complex construct” and the two-second-sample of “Metall auf Metall” is only used as a part of the rhythm-sequence of the newer track.²⁴⁸

The court proceeded to assess whether it would have been reasonably possible for the defendants to produce the sound of “Metall auf Metall” by themselves without resorting to use of the actual Kraftwerk sample.²⁴⁹ After finding that the supreme court did not provide criteria in which to determine this issue, the lower court held that an identical reproduction was not necessary; rather, the test is whether: (1) the average listener would detect a difference between the defendants’ self-created sound and the plaintiff’s sampled sound; and (2) the average professional sound producer or engineer would reasonably have been able to create such a sound back in the time when the infringing work was created.²⁵⁰ The court then asked two sound engineers to rebuild the “Metall auf Metall” sample with equipment that would have been available to professional sound producers back in 1997 (the year when “Nur mir” was created using the actual “Metall auf Metall” sample) who subsequently reported that it took between one and two working days to create the sound that could have been used by defendants instead of the Kraftwerk sample.²⁵¹ While the lower court

246. See Apel, *supra* note 11, at 345; Conley & Braegelmann, *supra* note 8, at 1034.

247. Conley & Braegelmann, *supra* note 8, at 1037.

248. Metall auf Metall II, Hanseatisches Oberlandesgericht Hamburg [OLG] [Higher Regional Court of Hamburg] Aug. 17, 2011, no. 5 U 48/05, 2011 ZUM 748, 749 (Ger.), available at <http://justiz.hamburg.de/oberlandesgericht/> (search for “Metall auf Metall”; then click first link) [hereinafter *Metall auf Metall II*]; See Simon Apel, *Anmerkung zu OLG Hamburg, Urteil vom 17. August 2011*, 5 U 48/05, 2011 ZUM 754, 755.

249. *Metall auf Metall II*, *supra* note 248, at 752.

250. *Metall auf Metall II*, *supra* note 248, at 750. See also, Apel, *supra* note 248, at 755.

251. Apel, *supra* note 248, at 751–53.

held that such an effort would not have been unreasonable for the defendants to accomplish in the studio, it nonetheless granted the defendants yet another appeal to the BGH in order to clarify the type of efforts that can be considered as reasonable.²⁵²

IV. THE DEVIL IS IN THE DEFENSES: WHERE BRIDGEPORT MUSIC AND KRAFTWERK WENT AWRY

The crux of both the *Bridgeport Music* and *Kraftwerk* opinions is a two-fold message to samplers: *de minimis* is out, but fair use and free use are in. In other words, when samplers take any amount from somebody else's sound recording absent prior license, they will not be able to wage an argument that such use is not copyright infringement (in the United States) or neighboring rights infringement (in Germany), because both courts essentially agree that any taking of a sound recording is a *per se* taking.²⁵³ On the other hand, based on both countries' constitutional policies requiring a balance of intellectual property rights provided to their owners with the eventual public access to such works for the purpose of future production, defendants will nonetheless be entitled to a legal assessment of the defenses of fair use or free use as applied to their conduct.²⁵⁴ It can be posited that such a rationale is, indeed, a proper balance of the two-fold policy goals of intellectual property jurisprudence in building the proper fences around the rights of original songs while allowing use of such songs by second-comers in order to foster the creation of new works. As will be demonstrated, however, while these defenses may be workable in the context of more traditional musical works, they cannot feasibly be utilized in the complex arena of digital sampling of sound recordings without fashioning a test that is specific to the practice.

While the Sixth Circuit has stated that fair use is appropriate in sampling cases, it has failed to provide any guidance whatsoever in assessing the issue in the context of sampling.²⁵⁵ Further, the *Kraftwerk* court applies the same rationale with respect to free use, but provides a test that is meaningless, at

252. *Id.* at 754, 756.

253. *See* *Bridgeport Music, Inc. v. Dimension Films LLC*, 410 F.3d 792, 801 (6th Cir. 2005); Conley & Braegelmann, *supra* note 8, at 1028.

254. *See* U.S. Const. art. I, § 8, cl. 8; Geiger, *supra* note 190, at 539.

255. *See* *Bridgeport Music*, 410 F.3d at 805.

worst, or, at best, impossible to apply.²⁵⁶ The most frustrating facet of the *Kraftwerk* court's decision is its determination that free use cannot apply when the defendant has the ability to produce the sampled music in question, particularly since the court provides no instruction to the lower court on remand regarding exactly how to assess this matter.²⁵⁷ This oversight indeed proved to be a burden for the lower court on remand since "[t]he question of whether an artist could have produced a sample himself is a particularly difficult one to answer when it comes to the music scene."²⁵⁸ In fact, some would allege that duplicating a prior sound is extremely difficult and expensive, if not impossible, and in most instances can only be "achieved through some combination of luck and Herculean effort."²⁵⁹ This is true for several reasons, such as the fact that the recording "gear needs to correspond to the particular sound for faithful renditions, such as period microphones, outboards, amplifiers, and instruments," and that "the acoustics of the physical recording space are often difficult to recreate."²⁶⁰

On remand, the lower court in *Kraftwerk* was obviously unsure how to answer such questions since it allowed the defendants yet another appeal to the BGH for further assistance in clarifying the circumstances in which defendants could have reasonably created the sample on their own. One can only surmise how such a question will ultimately be answered and what type of assistance will be provided by the BGH in its next opinion. Will the court consider the musical capability or talent of the particular defendant, the number of years the performers have been playing, the formal or informal training of the musicians, the creativity and/or technological capacity of the producer in the studio, the financial ability of the defendant to fund the recreation of the desired sound, the uniqueness of the original sound, or a combination of some or all of these and other unforeseen and extremely subjective factors? Ironically, if these standards are employed, then the more unique, original,

256. Conley & Braegelmann, *supra* note 8, at 1033–34.

257. Apel, *supra* note 11, at 345–46.

258. See Dario Radišić, *Music Sampling and Copyright—Metal on Metal is not Automatically “Metal on Metal,”* GOETHE INSTITUTE (Oct. 2010), <http://www.goethe.de/kue/mus/pan/en6649772.htm>.

259. Ashtar, *supra* note 15, at 307.

260. *Id.* (providing the example of a record company whose practice it was to record sessions in a converted abandoned movie theater).

and obscure the original sound is, the less the owner of the sound recording is protected from non-compensated third-party use. Such an anomaly, thus, provides samplers with an incentive to only use the highest quality sounds, or those they are not able to recreate independently. It is difficult to fathom how such an outcome will comport with the letter and spirit of the UrhG or the German Constitution, especially in light of the mandates required by the Geneva Phonograms Convention. In any event, courts “should not just be dealing with the question whether in any individual case it was possible to reproduce a sample—they should as a matter of principle be concerned with establishing which aesthetic standards should—and must—be permitted in the production of music.”²⁶¹

Similarly, with respect to the second free use exception, it is still not clear from the succession of *Kraftwerk* opinions exactly what parts of a sound recording will be defined as “recognizable” melodies, and thus, immune from the defense. Will it be relevant whether a general audience can recognize the plaintiff’s melody as contained in the defendant’s work, or will the same question have to be determined by expert musicologists? If a drum beat is particularly distinctive, is it nonetheless non-protectable simply because it is considered only a rhythmic element and not part of the melody of the song?²⁶² More complicated than that, what definition of recognizability should the court apply when resolving this issue? Unfortunately, the *Kraftwerk* court’s original opinion provided many more questions than answers to this important issue.

V. THE SOLUTION FOR THE UNITED STATES: A MODIFICATION TO THE FAIR USE DEFENSE FOR SAMPLES OF SOUND RECORDINGS

The main problem with the legal analyses of digital sampling is that the pundits representing either side of the issue swing too broadly. The *Bridgeport Music* court’s analysis con-

261. Radišić, *supra* note 258.

262. See Demers, *supra* note 42, at 36. Joanna Demers, assistant professor of music history and literature at the University of Southern California, takes issue with the fact that copyright generally protects the melody and lyrics of a song more than it does the secondary elements such as timbre, ornamentation, and instrumentation. *Id.* at 32. Professor Demers notes that the “narrow description” of what constitutes a song in Western theory, which has influenced copyright law, should be reformulated since “music resists classification as an idea or expression because there is so little agreement as to the precise nature of music.” *Id.*

tains a strained reading of §114 to encompass the act of sampling when the legislative history is clear that the main purpose of the provision was to prevent unauthorized bootlegging, which was determined by Congress in 1971 to have been depriving legitimate record and tape manufacturers of significant income, as well as delimiting performers from substantial and deserved royalties.²⁶³ Specifically, from an examination of the legislative history of §114(b), it is likely that Congress only intended to resolve unauthorized copying of entire sound recordings as opposed to copying of only a sample of a recording.²⁶⁴ This was not an oversight of Congress; since the practice of sampling did not exist, it simply was not considered in the drafting of §114(b).²⁶⁵ Many correctly argue, therefore, that the section simply does not apply to digital sampling if the original work and the new work are not market substitutes—or bootlegs.²⁶⁶

On the other hand, those who criticize the *Bridgeport Music* court on this very point also miss the mark, when they insist that:

The distinction made in Section 114 between sound recordings and other copyrighted works is that sound recording copyright owners' rights are more *limited* than those of other copyright owners; the statute does not state that the rights of sound recording owners are in any way expanded beyond those of other copyright owners.²⁶⁷

Could it instead be the case, as intimated by both the *Bridgeport Music* and *Kraftwerk* courts, that because sound recording owners do not generally enjoy rights of performance that is precisely the reason why their rights to reproduce, dis-

263. H.R. Rep. No. 92-487, at 2 (1971), reprinted in 1971 U.S.C.C.A.N. 1567 (“The attention of the Committee has been directed to the widespread unauthorized reproduction of phonograph records and tapes. While it is difficult to establish the exact volume or dollar value of current piracy activity, it is estimated by reliable trade sources that the annual volume of such piracy is now in excess of \$100 million.”); see also Mary Ann Lane, Note, “Interactive Services” and the Future of Internet Radio Broadcasts, 62 ALA. L. REV. 459, 461 (2011) (the primary purpose of the 1971 amendments “was to guard against the unauthorized duplication of sound recordings”).

264. H.R. Rep. No. 92-487, at 4.

265. See Bryan Bergman, Note, *Into the Grey: The Unclear Laws of Digital Sampling*, 27 HASTINGS COMM. & ENT. L.J. 619, 644 (2005) (“Since sampling was not a common practice when the Congress created the 1976 version of the Copyright Act, no legislative guidance has been set and thus the music industry still faces this dilemma today.”).

266. E.g., Watson, *supra* note 20, at 480.

267. Osterberg, *supra* note 68, at 638.

tribute, and make derivative works of the sounds they own should be even *more* protected by not being subject to a *de minimis* use defense.²⁶⁸

Because the answer to this question largely depends on information that can be provided only by musicians and other music industry professionals, it is imperative that congressional hearings be scheduled to address this major gap in the laws of both countries. Since a constitutional mandate has been provided to the legislatures of both the United States and Germany to define the scope of copyright protection for musical works,²⁶⁹ it is incumbent upon both bodies of government to restructure the Copyright Act and the UrhG, respectively, in accordance with the modern principles of sampling law that continue to evade traditional doctrine. The only way to achieve this goal is for the legislatures to consult musical experts “with particularly high standards” before determining the precise and proper legal fences for samples.²⁷⁰ If the legislatures of both countries can agree with the basic premise articulated by both the courts in *Bridgeport Music* and *Kraftwerk*—as even many samplers do—that taking even a small sample of a prior recording is taking something of value,²⁷¹ some standard must be set

268. See *Bridgeport Music, Inc. v. Dimension Films LLC*, 410 F.3d 792, 800 (6th Cir. 2005) (holding that the balance struck in creating rights for sound recordings under §114(b) “was to give sound recording copyright holders the exclusive right ‘to duplicate the sound recording in the form of phonorecords or copies that directly or indirectly recapture the actual sounds fixed in the recording’”) (emphasis added) (*quoting* 17 U.S.C. § 114(b) (2006)); Conley & Braegelmann, *supra* note 8, at 1027 (discussing the *Kraftwerk* court’s analysis, writing “[i]f only the unauthorized reproduction and distribution of the entire phonogram were prohibited, the protection afforded the producer of phonograms would be largely ineffective. . . especially in light of modern digital recording, reproduction, and rendition technologies”).

269. See Geiger, *supra* note 190, at 539–40 (discussing the broad powers granted to legislators in protecting copyrights under Article 14 of the German Constitution); Amanda Webber, Note, *Digital Sampling and the Legal Implications of its Use After Bridgeport*, 22 ST. JOHN’S J. LEGAL COMMENT. 373, 386 (2007) (“As the Constitution firmly demonstrates, copyright law is a ‘creature of statute’ and ‘it is Congress that has been assigned the task of defining the scope of the limited monopoly that should be granted.’”) (quoting *Sony Corp. v. Universal City Studios, Inc.* 464 U.S. 417, 429 (1984)).

270. See Radišić, *supra* note 258.

271. JOSEPH GLENN SCHLOSS, MAKING BEATS: THE ART OF SAMPLE-BASED HIP-HOP 73 (2004). It appears that many samplers would agree. When asked why one would go about the trouble of sampling, one sampler responded that there is something in the sampling process itself that cannot be duplicated by live instrumentation and that “[t]he reason why people sample is that you get an instant vibe, and an instant sound” *Id.* at 3–4; see also, Kim, *supra*

in order to assess exactly what that value is and how it can be quantified.

Such an assessment is muddled by additional—and extremely contradictory—rules that have been set forth by samplers themselves, particularly in the hip-hop industry. Interestingly, among many hip-hop artists who claim that their artistry will be hindered by having to pay for samples and who wish to sample older artists' material freely, there is a “self-evident” rule that “[o]ne shouldn't sample from another hip-hop record because one would be exploiting the effort of the original producer who dug up the sound.”²⁷² Producer King Otto explained the rule, saying that “[i]t doesn't take any work to sample from a rap record, basically. Because it's already there for you, it can be sampled.”²⁷³ One copyright scholar has explained the phenomenon as follows:

Sampling from another hip hop record would also be exploiting that previous effort. Hip hop producers also believe that building from another producer's efforts is not sufficiently challenging, as they are not doing the proper “digging” for the beat. The rule against “biting” demonstrates the value of hard work and creativity among those in the hip hop community. An artist who samples from a hip hop record does not demonstrate either of these qualities because the record has already been discovered and optimized for its “hip hop aesthetic.” This is an interesting example of how the hip hop community's own set of ethics runs parallel to a common legal concept, and yet is based on a different set of concerns.²⁷⁴

Another producer explains, “I would never sample something that was already sampled from somebody else. That just seems like some weird type of incest or something. Just kind of strange. I would definitely say that was a rule.”²⁷⁵ Ironically, the rationale for this rule is basically the same reason why the older artists object to sampling: it allows newcomers to readily and easily take creations from previous musicians and producers who have uniquely achieved a distinctively recognizable

note 103 at 126 (“What is of value to the sampler is the unique nature of the original recorded sounds and the creative choices that were made in the actual fixation of the composition.”); John Schietinger, Comment, *Bridgeport Music, Inc. v. Dimension Films: How the Sixth Circuit Missed a Beat on Digital Music Sampling*, 55 DEPAUL L. REV. 209, 236 (2005) (noting that “re-recording cannot capture the same sound as the original recording”).

272. Schloss, *supra* note 271, at 114.

273. *Id.*

274. Webber, *supra* note 269, at 380–81.

275. Schloss, *supra* note 271, at 116.

and desired sound in the first place. It is particularly interesting to point out that the *Bridgeport Music* court seemed to foresee such an entangled dilemma, which it astutely surmised would haunt the music industry when it noted that “where one stands [on the issue of sampling] depends on where one sits . . . since in many instances, today’s sampler is tomorrow’s samplee.”²⁷⁶

It is thus apparent that not only the courts, but also sampled and sampling musicians as well, are struggling with an attempt to put some fences around the ownership of sounds in order to temper subsequent uses of those sounds which inherently seem to be fair or free. The problem lies in figuring out the right type of fence. Many scholars fundamentally disagree with the approach taken by the *Bridgeport Music* court by arguing that a *de minimis* defense is, in fact, appropriate in the context of a digital sampling case.²⁷⁷ Some scholars maintain

276. *Bridgeport Music, Inc. v. Dimension Films LLC*, 410 F.3d 792, 804 (6th Cir. 2005). Indeed, the court was not off the mark in this observation since such a phenomenon had already arisen in 2001 when Marly Marl sued Snoop Dogg for sampling his song in which he actually used samples of a different previous recording! *Williams v. Broadus*, No. 99 Civ. 10957 MBM, 2001 WL 984714 (S.D.N.Y. Aug. 27, 2001).

277. See, e.g., Morrison, *supra* note 179, at 138 (“Where a substantial portion of the original work is taken it is more likely that the sample represents an ‘organizing feature’ of the new work, or one which will immediately call the original to the mind of the ordinary listener. From this perspective, samples that contain a substantial portion of the original, under a quantitative analysis, are more likely to implicate the individual and social costs associated with the derivative works paradigm. On the other hand, quantitatively insignificant samples are more likely to be countenanced under traditional substantial similarity principles and the common law of *de minimis* use. Because these samples are less likely to constitute an ‘organizing feature’ of the original work and/or immediately call the original work to the mind of the ordinary listener, they are less likely to implicate the individual and social costs of increased freedom to recode sound recordings, and allowing their use would make room for the social benefits of increased freedom to recode copyrighted sound recordings.”); see also Brandes, *supra* note 30, at 127 (suggesting that *Bridgeport Music*’s prohibition of *de minimis* sampling contradicts the purpose of copyright law and overlooks the creative value in sampling rap music, and stating that “[w]here listeners, even those familiar with the original work, cannot ascertain that a particular work has been sampled, it makes little sense to grant absolute copyright protection to the copyright holders.”); Schietinger, *supra* note 271, at 243 (positing that the Sixth Circuit should have followed the district court’s *de minimis* analysis and proposing the following three-part test from an “ordinary observer perspective”: “(1) whether the sample constitutes a trivial portion of the original song, (2) whether the sample is quantitatively recognizable in the alleged infringing song, and (3) whether the two songs are qualitatively similar.”).

that it is time for the United States to expand its moral rights protection in the Copyright Act to the realm of digital samples, noting that a sampling defendant is engaged in a taking of the original producer's "authorial personality,"²⁷⁸ while others believe that some form of a compulsory license should be devised for the secondary use of sound recordings and compositions.²⁷⁹ Still others go so far as claiming that copyright owners of sound recordings performed by bands such as Led Zeppelin or Pink Floyd, who routinely deny sampling licenses, must be required by the law to produce "a compelling reason as a threshold requirement for denying the right."²⁸⁰

The proper fence or parameter of sound recording ownership should ultimately be determined by assessing whether the first recording is substantially recognizable to the average listener as it appears in the second recording. A valid critique of the *Bridgeport Music* case is that the portions of the plaintiff's song that were sampled and appeared in the defendants' song were barely recognizable and likely would not have been detected even by the copyright owners of the sound recording but for the fact that the defendants sought a license for the composition.²⁸¹ A similar objection can be made in the *Newton v. Diamond* case in which the plaintiff sued on the composition rights after the Beastie Boys had diligently sought a license for use of the sound recording. In fact, the media have referred to

278. Troutt, *supra* note 76, at 386. Another author maintains that "creative individuals" should be able to enforce their moral rights of attribution and integrity through copyright dilution and proposes the adaptation of the provisions of the Trademark Dilution Revision Act to the area of copyright law by creating a standard of copyright blurring, or "an association arising from copying by a junior creative work of a senior creative work that impairs the distinctiveness of the senior creative work." Lucille M. Ponte, *Preserving Creativity from Endless Digital Exploitation: Has the Time Come for the New Concept of Copyright Dilution?*, 15 B.U. J. SCI. & TECH. L. 34, 94 (2009).

279. Ashtar, *supra* note 15, at 313; Webber, *supra* note 269, at 410 (advocating the application of "a combination compulsory licensing and fair use scheme in digital sampling" cases).

280. Carl A. Falstrom, Comment, *Thou Shalt Not Steal: Grand Upright Music LTD. v. Warner Bros. Music, Inc. and the Future of Digital Sound Sampling in Popular Music*, 45 HASTINGS L.J. 359, 376 (1994). The author provides no opinion regarding what may be properly considered a "compelling" reason for the denial of a sampling license. *See id.*

281. Brandes, *supra* note 30, at 127 ("Where listeners, even those familiar with the original work, cannot ascertain that a particular work has been sampled, it makes little sense to grant absolute copyright protection to the copyright holders.").

Bridgeport Music, Inc. as a sample “troll” (akin to a patent troll) that acquired the rights to several copyrights and subsequently “dug up” every single sample used by others “and sued them all—filing hundreds of lawsuits.”²⁸² While criticizing a legal entity for purchasing copyrights that are legally assignable and transferable commodities in the United States and subsequently exercising its exclusive rights under the Copyright Act is far from rational, a plausible argument does exist that, when a sampler’s use of a prior sound recording is both transformative and substantially non-recognizable to the ordinary listener, then a fair use exception to such use can be maintained.²⁸³

Other scholars and courts have argued that recognizability of the plaintiff’s sounds in the song of the defendant should be a factor that is taken into consideration in sampling cases; however, they have insisted that this issue be assessed as part of the test of infringement or as a *de minimis* argument.²⁸⁴ Because sampling is a *per se* taking that is always intentional, and since it evades the traditional qualitative/quantitative analyses that can be applied to other categories of copyrighted works, non-recognizability should be a defense to infringement available to the defendant once the plaintiff has proved the front door issue of whether a portion of his work was, in fact, sampled by the defendant. As such, in drafting a modified version of §107 as applied to sampling cases, Congress should modify the third fair use factor—the amount and substantiality of the portion used in relation to the copyrighted work as a whole—when specifically applied to sampling cases. This third fair use factor currently considers both the quality and quantity of the portions sampled by the defendant.²⁸⁵ However, since analyses of the portion used by the defendant are not appropriate in sampling cases, because samplers who use even a small amount of the original song loop the sample many times continuously throughout the new song, the language should be changed to “the substantial recognizability of the portion used

282. *George Clinton Takes on Sample Troll Bridgeport Music Again: The DNA of Hip Hop Has Been Hijacked*, TECHDIRT (June 13, 2011), <http://www.techdirt.com/articles/20110613/01234014665/george-clinton-takes-sample-troll-bridgeport-music-again-dna-hip-hop-has-been-hijacked.shtml>.

283. Webber, *supra* note 269, at 407 (“If a sample is altered to the point that the underlying work is no longer recognizable, then the sampled artist is not injured.”).

284. *See, e.g., Saregama India Ltd. v. Mosley*, 635 F.3d 1284, 1338–39 (11th Cir. 2011); Morrison, *supra* note 179 at 138.

285. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 586 (1994).

in defendant's work to the ordinary listener." In this way, new musicians are able to use prior generic, i.e., nonrecognizable, sounds as building blocks for the foundation of their new works, while older artists are able to maintain the integrity, cache, and market effect of their popular songs that are well-known by audiences and associated with them.

CONCLUSION

We live in an exciting and eclectic musical era in which new technology continues to enable the production of more and different songs created by a more diverse group of people. While intellectual property laws should continue to encourage the development and use of such technology, they also must ensure the proper protection and fences that allow an adequate amount of control by the original author. Whether or not "good fences make good neighbors"²⁸⁶ in intellectual property jurisprudence involving third-party use of digital samples remains to be seen. It appears from the *Kraftwerk* decision that—at least according to Germany's highest court—good fences do, indeed, make good neighboring rights. Similarly, in *Bridgeport Music*, the only appellate court decision in the United States to fully consider the legal boundaries of sound recordings in the context of sampling, the court has attempted to advocate strict parameters for such rights.

While both the *Bridgeport Music* and *Kraftwerk* courts arrived at clear and definable solutions regarding the question of sound recording ownership and infringement, they ultimately failed to delineate the proper scope of fair or free use to determine when such boundaries can be broken by sampling defendants in order to achieve the proper balance of protecting old works and creating new ones. Since "there certainly are many factors indeed that go into the making of a sound,"²⁸⁷ finding a suitable compromise remains a challenge for both countries and, until it is achieved, both owners and samplers of music will remain subject to the perplexingly incomplete directives as set forth in these opinions. A proper balance of the objectives of both sampled and sampling musicians can best be achieved in the United States by modifying the fair use defense to eliminate the quantitative/qualitative analysis and replace it with a

286. Frost *supra* note 1, at 33.

287. See Radišić, *supra* note 258.

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test regarding whether the plaintiff's sound recording is substantially recognizable to the average listener as it appears in the defendant's song.