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## Comment

### ***Bridgeport Music, Inc. v. Dimension Films: The Death of the Substantial Similarity Test in Digital Sampling Copyright Infringement Claims – The Sixth Circuit’s Flawed Attempt at a Bright-Line Rule***

**Matthew R. Brodin**\*

*In truth, in literature, in science and in art, there are, and can be, few, if any, things which, in an abstract sense, are strictly new and original throughout. Every book in literature, science and art, borrows and must necessarily borrow, and use much which was well known and used before . . . . If no book could be the subject of copy-right which was not new and original in the elements of which it is composed, there could be no ground for any copy-right in modern times, and we would be obliged to ascend very high, even in antiquity, to find a work entitled to such eminence. Virgil borrowed much from Homer; Bacon drew from earlier as well as contemporary minds; Coke exhausted all the known learning of his profession; and even Shakespeare and Milton . . . would be found to have gathered much from the abundant stores of current knowledge and classical studies in their days.*

*-Justice Story*<sup>1</sup>

#### INTRODUCTION

In *Bridgeport Music, Inc. v. Dimension Films*,<sup>2</sup> the Sixth Circuit Court of Appeals announced a new bright-line rule for sound recording copyright infringement that will have

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1. *Emerson v. Davies*, 8 F. Cas. 615, 619 (D. Mass. 1845) (No. 4,436) (Story, J.).

2. 383 F.3d 390 (6th Cir. 2004).

significant effects on the hip-hop music industry.<sup>3</sup> In this case the rap group NWA sampled a single chord from George Clinton's "Get Off Your Ass and Jam," altered the pitch and tempo, and used it in their song "100 Miles and Runnin'."<sup>4</sup> The owners of the sound recording copyright to Clinton's song sued Dimension Films for infringement after the song was included in the soundtrack to the Dimension movie "I Got the Hookup."<sup>5</sup> The district court held that the amount copied from "Get Off" was so small that it was not legally cognizable, or in other words, the use was *de minimis*.<sup>6</sup> The Sixth Circuit Court of Appeals reversed, announcing a new rule that made the sampling of a copyright protected sound recording a *per se* infringement regardless of the amount copied.<sup>7</sup> The hip-hop industry is worried that this decision will negatively impact creativity by significantly limiting the amount of music that artists can legally sample.<sup>8</sup>

The Sixth Circuit Court of Appeals reversed the district court opinion and announced the new bright-line rule based upon its interpretation of the Copyright Act of 1976.<sup>9</sup> Although the academic and business publications on the subject offer support for both the court of appeals opinion and the district court opinion, the Sixth Circuit's interpretation is not supported by any judicial precedent and is contrary to the existing persuasive decisions from other districts.

This comment examines the language and the purpose of the Copyright Act, the applicable case law, and the legal and professional articles on copyright law as applied to digital sampling to determine the proper test for establishing the infringement of a sound recording copyright. Part I outlines the history of hip-hop music and digital sampling, summarizes the relevant sections of the Copyright Act, and reviews the

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3. *Bridgeport Music, Inc. v. Dimension Films* ("Bridgeport II"), 383 F.3d 390, 393 (6th Cir. 2004).

4. *Id.*

5. *Id.*

6. *Bridgeport Music, Inc. v. Dimension Films* ("Bridgeport I"), 230 F. Supp. 2d 830 (M.D. Tenn. 2002), *rev'd*, 383 F.3d 390 (6th Cir. 2004).

7. *Bridgeport II*, 383 F.3d at 393.

8. See, e.g., Eric Olsen, 3 Notes and Runnin': Sample Ruling Protest (Sept. 15, 2004) (calling the ruling a "disaster"), at <http://blogcritics.org/archives/2004/09/15/200145.php> (last visited Apr. 8, 2005); Chris Reynolds, *Sampling the Future*, TECHNICIAN (Sept. 16, 2004), at <http://www.technicianonline.com/story.php?id=010041> (last visited Mar. 24, 2005).

9. See *Bridgeport II*, 383 F.3d at 396-401.

applicable case law. Part II analyzes the decisions of both the district court and the Sixth Circuit Court of Appeals in *Bridgeport Music, Inc. v. Dimension Films*<sup>10</sup> with respect to that background. Part III concludes that the Sixth Circuit's decision is inconsistent with the language and purpose of the Copyright Act, and that the correct decision is the one outlined in the opinion by the district court.

## I. BACKGROUND

### A. DIGITAL SAMPLING AND THE BIRTH OF HIP-HOP MUSIC

Digital music sampling is the practice of digitally recording existing sound recordings and adding them to other sampled or original sound recordings to create new music.<sup>11</sup> The process involves three main steps: digital recording, computer analysis and alteration, and playback.<sup>12</sup> Modern digital sampling equipment allows the user to isolate vocal and instrumental sounds and alter their pitch, tempo, and timbre.<sup>13</sup> This provides the sampler with the ability to record and playback an entire sound recording exactly as it sounded in the original, or to take smaller samples of the recording and manipulate them into completely new and unrecognizable sounds.<sup>14</sup> The technological advancements provided by digital sampling create a wide range of copyright questions that have not been consistently analyzed or answered by either the courts or Congress.

The origins of hip-hop music and the modern practice of digital sampling have been traced to the innovative disc jockeys (DJs) or "selectors" in Jamaica in the late 1950's and early 1960's.<sup>15</sup> During this period DJs traveled around the island performing in small makeshift discos.<sup>16</sup> To attract larger

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10. 383 F.3d 390 (6th Cir. 2004).

11. David S. Blessing, *Who Speaks Latin Anymore?: Translating De Minimis Use for Application to Music Copyright Infringement and Sampling*, 45 WM. & MARY L. REV. 2399, 2403 (2004).

12. Jeffrey R. Houle, *Digital Audio Sampling, Copyright Law and the American Music Industry: Piracy or Just a Bad "Rap"?*, 37 LOY. L. REV. 879, 880 (1992).

13. Blessing, *supra* note 11, at 2403.

14. See Houle, *supra* note 12, at 880-82.

15. Susan J. Latham, *Newton v. Diamond: Measuring the Legitimacy of Unauthorized Compositional Sampling – A Clue Illuminated and Obscured*, 26 HASTINGS COMM. & ENT. L.J. 119, 122 (2003).

16. Eric Shimanoff, *The Odd Couple: Postmodern Culture and Copyright Law*, 11 MEDIA L. & POL'Y 12, 24 (2002).

audiences, local DJs began modifying the music they played using turntables and a stereo mixer while talking-over the music in a chant-like manner.<sup>17</sup>

In 1974, Jamaican DJ Clive Campbell, a.k.a. “Kool Herc,” moved to the South Bronx of New York and introduced his country’s innovative style of music to the United States.<sup>18</sup> Kool Herc became a neighborhood sensation and word of his unique style and popularity spread quickly.<sup>19</sup> Local DJs began to emulate the methods used by Kool Herc, sampling and rapping over the break beats from popular Latin, R&B and disco music.<sup>20</sup>

As the popularity of this new form of music became widespread, competition became fierce and DJs began to look for new ways to extract and mix beats.<sup>21</sup> In the early 1980s, the musical instrumental digital interface (MIDI) synthesizer came to the market, allowing hip-hop producers to easily sample recordings in the studio and recreate the music that DJs were performing live in the clubs.<sup>22</sup> As the price of this technology fell, hip-hop artists were given affordable access to the unique and almost endless possibilities provided by digital sampling.<sup>23</sup>

In 1979, the commercial release and mainstream success of Sugar Hill Gang’s “Rapper’s Delight,” which contained music appropriated from Chic’s popular disco hit “Good Times,” created questions of the applicability of copyright law to this new form of music.<sup>24</sup> Unfortunately, the Copyright Act of 1976 (the “Act”) provided little if any clarity for musicians and those in the music recording industry.

## B. COPYRIGHT LAW

The U.S. Constitution grants Congress the authority “[t]o promote the Progress of Science and useful Arts, by securing

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17. *Id.*; Latham, *supra* note 15, at 122; *see also* Stephen R. Wilson, *Music Sampling Lawsuits: Does Looping Music Samples Defeat the De Minimis Defense?*, 1 J. HIGH TECH. L. 179, 182 (2002).

18. Latham, *supra* note 15, at 122.

19. Shimanoff, *supra* note 16, at 25.

20. *Id.*

21. *Id.* at 25-26.

22. Latham, *supra* note 15, at 123.

23. *See* Blessing, *supra* note 11, at 2403-04.

24. Jason H. Marcus, *Don’t Stop That Funky Beat: The Essentiality of Digital Sampling to Rap Music*, 13 HASTINGS COMM. & ENT. L.J. 767, 770 (1991).

for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>25</sup> Congress first utilized this authority in 1790 by adopting a federal Copyright Act, amending it several times since.<sup>26</sup> The most recent version is the Copyright Act of 1976.<sup>27</sup>

The Act protects “original works of authorship fixed in any tangible medium of expression.”<sup>28</sup> “Originality in the copyright sense means only that the work owes its origin to the author, i.e., is independently created, and not copied from other works.”<sup>29</sup> In addition, to command copyright protection a work must contain a minimal amount of creativity.<sup>30</sup>

A copyright owner has the exclusive right to reproduce the work, prepare derivative works, distribute copies of the work publicly, perform the work publicly, display the work publicly, and perform the work publicly by means of a digital audio transmission.<sup>31</sup> Under section 102(a) of the Act, both “musical works, including any accompanying words” and “sound recordings” are included as works of authorship.<sup>32</sup> This complicates matters for musicians attempting to obtain a license to sample a song, as they must negotiate a license for both the sound recording copyright and the underlying composition copyright, which are often owned by two separate parties.

#### 1. Purpose of Copyright Law

As the Constitution states, the purpose of music copyright protection is to promote the progress of a useful art.<sup>33</sup> In other words, copyright protection is intended to promote artistic creativity and innovation that will be a benefit to the public.<sup>34</sup>

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25. U.S. CONST. art. 1, § 8, cl. 8.

26. Blessing, *supra* note 11, at 2405.

27. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-1332 (2000)).

28. *Id.* § 101.

29. 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.01 (2004).

30. *Id.* (“Illustrative of the requirement of minimal creativity are those cases that deny copyright protection to fragmentary words or phrases, noncreative variations of musical compositions, numbers generated sequentially or randomly, and to forms of expression dictated solely by functional considerations.”).

31. 17 U.S.C. § 106.

32. *Id.* § 102(a).

33. See U.S. CONST. art. 1, § 8, cl. 8.

34. Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975)

To achieve these ends, the Copyright Act grants copyright holders a limited monopoly over their work.<sup>35</sup> This provides an incentive for creation by providing a financial benefit, for example, the exclusive right to the revenue from licensing fees, sales, royalties, and performance fees.<sup>36</sup>

However, “the financial reward guaranteed to the copyright holder is but an incident of this general objective, rather than an end in itself.”<sup>37</sup> As the Supreme Court stated, “The sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labors of authors.”<sup>38</sup> Thus, the benefits of copyright protection are intended to promote maximization of public benefit. Any private benefit experienced by creators is incidental to this purpose.

The economic philosophy behind the clause empowering Congress to grant copyright protection is the belief that the economic benefit provided by the limited monopoly is the best way to advance public welfare.<sup>39</sup> However, “courts in passing upon particular claims of infringement must occasionally subordinate the copyright holder’s interest in a maximum financial return to the greater public interest in the development of art, science, and industry.”<sup>40</sup>

Congress recognized that the economic interests of copyright holders must give way to the “public interest” in development of the arts and sciences when limiting the monopoly power granted in the Act.<sup>41</sup> For example: copyrights are subject to a limited duration of exclusivity;<sup>42</sup> sound recording copyrights are limited to the actual sound recording, and do not apply against those that imitate or simulate the copyrighted work;<sup>43</sup> and the doctrine of fair use protects the public interest by granting exemptions for certain educational

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(“The immediate effects of our copyright law is to secure a fair return for an ‘author’s’ creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.”).

35. See Shimanoff, *supra* note 16, at 18.

36. See *id.*

37. Berlin v. E.C. Publ’n, Inc., 329 F.2d 541, 543-44 (2d Cir. 1964).

38. Fox Film Corp. v. Doyal, 286 U.S. 123, 127 (1932).

39. See Mazer v. Stein, 347 U.S. 201, 219 (1954).

40. See Berlin, 329 F.2d at 544.

41. See *id.*

42. 17 U.S.C. § 302 (2000).

43. *Id.* § 114(b).

uses, news reporting, and criticism.<sup>44</sup> The Supreme Court acknowledged this when stating that the fair use doctrine requires “courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which the law is designed to foster.”<sup>45</sup> Thus, in determining what constitutes copyright infringement, courts must balance the incentives to create provided by the monopoly powers of copyright with the public’s interest in promoting the development of art, science and industry.

## 2. What is Copyright Infringement?

The Supreme Court has held that the fundamental elements of a prima facie case of copyright infringement are: “(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.”<sup>46</sup> This comment will not address all of the intricacies of establishing the ownership and validity of a copyright, but will instead focus on the question plaguing the digital sampling music industries today: what amount of copying is necessary to establish copyright infringement?

Two distinct components exist within the copying element. First, a plaintiff must prove that the defendant actually used the copyrighted work as a “model, template, or even inspiration” when creating the disputed work.<sup>47</sup> However, even if copying is proven, the plaintiff must also show that it rose to a legally cognizable level.<sup>48</sup> Recently, some courts and legal scholars have reformulated the prima facie case of infringement to add “unlawful appropriation” as a required element in an effort to emphasize the need to show both actual and actionable copying.<sup>49</sup>

If actual copying cannot be proven with direct evidence, a

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44. *Id.* § 107.

45. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994).

46. *NIMMER*, *supra* note 29, § 13.01 (quoting *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991)).

47. *Id.* at § 13.01[B]. *See also* *Castle Rock Entm’t v. Carol Publ’g Group, Inc.*, 955 F. Supp. 260, 264 (S.D.N.Y. 1997), *aff’d*, 150 F.3d 132 (2d Cir. 1998) (quoting *NIMMER*, *supra* note 29, § 13.01[B]).

48. *See id.*

49. *See, e.g.*, *Newton v. Diamond* (“Newton II”), 349 F.3d 591, 594 (9th Cir. 2003), *aff’g* *Newton v. Diamond* (“Newton I”), 204 F. Supp. 2d 1244, 1256-59 (C.D. Cal. 2002); *Ringgold v. Black Entm’t Television, Inc.*, 126 F.3d 70, 74 (2d Cir. 1997); *NIMMER*, *supra* note 29, § 13.01 n. 26.3; *Wilson*, *supra* note 17, at 185.

plaintiff may prove copying by introducing circumstantial evidence demonstrating that the defendant had access to the copyrighted work and that the disputed work is “substantially similar” to the copyrighted work.<sup>50</sup> However, some legal commentators and recent cases have found the term “substantially similar” is “more properly used . . . after the fact of copying has been established, as the threshold for determining that the degree of similarity suffices to demonstrate actionable infringement.”<sup>51</sup> In an attempt to clarify this double use of the term “substantially similar,” the Second Circuit and the Nimmer treatise on copyrights, among others, have adopted Professor Alan Latman’s suggestion that the term “probative similarity” should be used for the determination of copying, and the term “substantial similarity” should be used for the determination of whether the copying rises to a legally cognizable level.<sup>52</sup> For purposes of clarity, these definitions will be used throughout the rest of the commentary.

As noted previously, the factual determination of copying relies upon a showing of access and probative similarity. Probative similarities are “similarities that, in the normal course of events, would not be expected to arise independently in the two works” and “are probative of defendant’s having copied as a factual matter from plaintiff’s work.”<sup>53</sup> Probative similarity is a question of fact.<sup>54</sup> Once the fact finder has determined that the defendant has actually copied from the copyright protected material, they must then determine whether the copying rose to a legally cognizable level.

To demonstrate that copying has risen to a legally cognizable level, a plaintiff must prove that the copyrighted and disputed works are substantially similar.<sup>55</sup> The question of what constitutes substantial similarity is one of the most difficult questions in copyright law due to the seemingly ambiguous and subjective tests for infringement used by the

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50. See *Ringgold*, 126 F.3d at 74; NIMMER, *supra* note 29, § 13.01[B].

51. *Ringgold*, 126 F.3d at 74; see also NIMMER, *supra* note 29, §§ 13.02-.03.

52. *Ringgold*, 126 F.3d at 74-75; NIMMER, *supra* note 29, at § 13.03[A]; Alan Latman, “Probative Similarity” as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement, 90 COLUM. L. REV. 1187, 1204 (1990).

53. See NIMMER, *supra* note 29, § 13.03[B].

54. See *id.*

55. *Ringgold*, 126 F.3d at 74-75; NIMMER, *supra* note 29, § 13.03[A].

courts.<sup>56</sup> On one extreme there is virtually no similarity, on the other exact similarity, and substantial similarity lies somewhere in between. Judge Learned Hand addressed this issue when he stated “[t]he test for infringement of a copyright is of necessity vague,” and the line will seem arbitrary wherever it is drawn.<sup>57</sup>

A few law review authors have commented that the language of section 114(b) of the Copyright Act<sup>58</sup> granting the copyright holder the exclusive right to create derivative works from the “actual sounds” of the recording precludes the use of the substantial similarity test altogether.<sup>59</sup> However, many other scholars, and most recent court decisions, have not adopted this strict reading of the Act and have included substantial similarity as a necessary element of a sound recording infringement action.<sup>60</sup>

A derivative work is defined by the Copyright Act as:

a work based upon one or more preexisting works, such as a . . . musical arrangement, . . . sound recording, . . . abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a “derivative work”.<sup>61</sup>

However, a work is considered derivative only if it “has *substantially* copied from a prior work.”<sup>62</sup> A work that contains only negligible amounts of previously registered or published material will be considered a new work, not a derivative work.<sup>63</sup> “To be an infringement the derivative work must be *based upon* the copyrighted work.”<sup>64</sup> Consequently, if an artist samples an insubstantial amount of a prior work and

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56. See NIMMER, *supra* note 29, § 13.03[A].

57. Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960).

58. 17 U.S.C. § 114(b) (2000).

59. See, e.g., Latham, *supra* note 15 at 125; Marcus, *supra* note 24, at 776.

60. See, e.g., Jarvis v. A & M Records, 827 F. Supp. 282, 288 (D.N.J. 1993); Newton v. Diamond, (“Newton P”), 204 F. Supp. 2d 1244 (C.D. Cal. 2002); Tuff 'N' Rumble Mgmt., Inc. v. Profile Records, Inc., 1997 WL 158364 at \*5 (S.D.N.Y. Apr. 2, 1997); J. Michael Keyes, *Musical Musings: The Case for Rethinking Music Copyright Protection*, 10 MICH. TELECOMM. & TECH. L. REV. 407, 416 (2004); Wilson, *supra* note 17, at 183.

61. 17 U.S.C. § 101.

62. NIMMER, *supra* note 29, § 3.01.

63. JOHN W. HAZARD, JR., COPYRIGHT LAW IN BUSINESS AND PRACTICE, § 2:22 (rev. ed. Oct. 2004).

64. H.R. REP. No. 94-1476, at 62 (1976), *reprinted in* U.S.C.C.A.N. 5659, 5675 (emphasis added).

incorporates it into a new work, they have not violated section 114(b) of the Copyright Act because they have not infringed upon the right of the copyright owner to create derivative works.<sup>65</sup> As Nimmer summarizes, “[t]he practice of digitally sampling prior music to use in a new composition should not be subject to any special analysis: to the extent that the resulting product is substantially similar to the sampled original, liability should result.”<sup>66</sup>

### 3. Defenses to Copyright Infringement Claims

The principles of substantial similarity and *de minimis* use have been used interchangeably by many courts and scholars.<sup>67</sup> To the contrary, these are two distinct principles, each with different legal implications on copyright issues. By definition, the *de minimis* test satisfies the quantitative analysis of substantial similarity, but not the qualitative. In practice, however, the term “*de minimis*” has been used to describe the defendant’s defense that the plaintiff has failed to demonstrate substantial similarity.

#### a. De Minimis Use

The principle of *de minimis* use is directly related to, but not a substitute for, the substantial similarity doctrine. The legal maxim *de minimis non curat lex* or “the law does not concern itself with trifles” has been applied throughout many areas of the law, including copyright.<sup>68</sup> To establish that copying is *de minimis*, the defendant must show that it was so trivial “as to fall below the quantitative threshold of substantial similarity, which is always a required element of actionable copying.”<sup>69</sup> In other words, if the amount taken from the copyrighted work is so small that it could not be considered a legally cognizable infringement, the copying is considered *de minimis* and the substantial similarity requirement has not

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65. See HAZARD, *supra* note 63, § 2:22.

66. NIMMER, *supra* note 29, § 13.03[A][2].

67. See, e.g., *Newton v. Diamond* (“Newton II”), 349 F.3d 591, 593-95 (9th Cir. 2003), *aff’g* *Newton v. Diamond* (“Newton I”), 204 F. Supp. 2d 1244 (C.D. Cal. 2002); *Newton v. Diamond*, (“Newton I”), 204 F. Supp. 2d 1244, 1258 (C.D. Cal. 2002); *Jarvis v. A & M Records*, 827 F. Supp. 282, 289-91 (D.N.J. 1993).

68. See Wilson, *supra* note 17, at 185.

69. *Ringgold v. Black Entm’t Television, Inc.*, 126 F.3d 70, 74 (2d Cir. 1997); see also *Gordon v. Nextel Comm. and Mullen Adver., Inc.*, 345 F.3d 922, 924 (6th Cir. 2003).

been met.

The application of this rule, however, has been far from uniform. Courts have been inconsistent in the determination of whether or not copying a few notes is *de minimis*.<sup>70</sup> Additionally, there is some confusion as to whether the sampled portion should be viewed in relation to the original work, the new work, or both.<sup>71</sup>

Ultimately, courts have consistently stated that quantitative analysis alone will rarely determine whether a particular copying is substantially similar because small sections can be sufficiently original or important to be considered a substantial portion of the original work.<sup>72</sup> Instead, a copied section of a work must be looked at for both its quantitative and qualitative importance.<sup>73</sup>

#### b. Qualitative Threshold of Substantial Similarity

The *de minimis* test may be used to determine the quantitative threshold of substantial similarity, but the doctrine also calls for examination of a qualitative threshold.<sup>74</sup> Even if the amount copied is quantitatively small, the fact finder may find substantial similarity if it is qualitatively important.<sup>75</sup> Due to the fact that very few digital sampling cases make it to court, there are very few applications of the substantial similarity test in this context.

One test that seems to have emerged in a few circuits is the ordinary observer/listener/audience test.<sup>76</sup> The threshold

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70. See, e.g., *Newton v. Diamond* (“Newton II”), 349 F.3d 591, 593-95 (9th Cir. 2003), *aff’d* *Newton v. Diamond* (“Newton I”), 204 F. Supp. 2d 1244 (C.D. Cal. 2002); *Baxter v. MCA, Inc.*, 812 F.2d 421 (9th Cir. 1987); *Newton v. Diamond*, (“Newton I”), 204 F. Supp. 2d 1244, 1258 (C.D. Cal. 2002).

71. See *Newton II*, 349 F.3d 591 (holding that the analysis should only focus on the original work and not on the defendants when determining whether the copying was *de minimis*); *Ringgold*, 126 F.3d 70 (applying the *de minimis* use test by analyzing both the original and the new work).

72. See *Baxter*, 812 F.2d at 425 (holding that six notes is a small amount, but that qualitative analysis is also necessary to determine the sampled portions importance in the song or originality); *Newton I*, 204 F. Supp. 2d at 1258 (holding that copying three notes that are not independently original was *de minimis*).

73. See *Baxter*, 812 F.2d at 425; *Newton I*, 204 F. Supp. 2d at 1258.

74. See *Latham*, *supra* note 15, at 132-33; *NIMMER*, *supra* note 29, § 13.03.

75. See *NIMMER*, *supra* note 29, § 13.03[B][2].

76. See, e.g., *Stromback v. New Line Cinema*, 384 F.3d 283, 293 (6th Cir. 2004) (recognizing the “ordinary observer” test); *Dawson v. Hinshaw Music Inc.*, 905 F.2d 731, 736 (4th Cir. 1990); *Baxter*, 812 F.2d at 425; *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946).

for substantial similarity in this test has been characterized by the courts in several different ways, including whether the defendant copied: “the whole meritorious part of the song;”<sup>77</sup> “that portion of the plaintiff’s work upon which its popular appeal, and hence, its commercial success, depends;”<sup>78</sup> “what is pleasing to the ears of lay listeners;”<sup>79</sup> “so much . . . that the value of the original is sensibly diminished, or the labors of the original author are substantially to an injurious extent appropriated by another;”<sup>80</sup> or, “constituent elements of the work that are original . . . [and] the value of the original work is substantially diminished by the copying.”<sup>81</sup> Another recent decision adopted the view that substantial similarity would not exist unless the defendant had copied enough of the copyrighted work where “the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard [the] aesthetic appeal [of the two works] as the same.”<sup>82</sup> Any similarities detected by the ordinary observer should be “without any aid or suggestion or critical analysis by others . . . [and] should be spontaneous and immediate.”<sup>83</sup> As demonstrated, each test is far from clear or even consistent with any other test.

Although some courts and commentators have stated that the question of substantial similarity should only focus on the relationship to the plaintiff’s work,<sup>84</sup> the reasonable listener test almost certainly allows the fact finder to be influenced by the frequency and the ability to observe the copied material within the new work.

The reasonable listener test has been highly criticized because it attempts to force the oft used reasonable person standard into an area of law that does not contain widely

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77. Northern Music Corp. v. King Record Distrib. Co., 105 F. Supp. 393, 397 (S.D.N.Y. 1952).

78. Robertson v. Batten, Barton, Durstine & Osborn, Inc., 146 F. Supp. 795, 798 (S.D. Cal. 1956).

79. *Arnstein*, 154 F.2d at 473.

80. Folsom v. Marsh, 9 F. Cas. 348 (C.C. Mass. 1841) (No. 4,901) (giving the guiding principle written by Justice Story).

81. Jarvis v. A & M Records, 827 F. Supp. 282, 291 (D.N.J. 1993) (internal citations omitted).

82. See *Newton v. Diamond* (“Newton II”), 349 F.3d 591, 594-95 (9th Cir. 2003), *aff’g* *Newton v. Diamond* (“Newton I”), 204 F. Supp. 2d 1244, 1256-59 (C.D. Cal. 2002) (internal citations omitted).

83. NIMMER, *supra* note 29, § 13.03[E][1][a] (quoting *Harold Lloyd Corp. v. Witwer*, 65 F.2d 1 (9th Cir. 1933)).

84. See *Newton II*, 349 F.3d at 597; NIMMER, *supra* note 29, § 13.03[A][2].

recognized social norms.<sup>85</sup> Additionally, whereas the reasonable person is assumed to have the same values and traits as the ordinary fact finder, it can not be assumed that the fact finder has the same musical taste or knowledge as a reasonable listener or audience member.<sup>86</sup> Although the test proves to be extremely inconsistent in its application, it is still used in many of the recent digital sampling decisions.<sup>87</sup>

c. Section Copied Not Protected by Copyright

A copyright only protects the portions of a work that are considered copyrightable.<sup>88</sup> According to the Supreme Court, “[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess more than a de minimis quantum of creativity.”<sup>89</sup> Following this reasoning, only original elements of a sound recording or musical composition are protected by a copyright.<sup>90</sup> Therefore, it is unlikely that a single note or beat, unless accompanied by an additional creative element, would be protected by copyright.<sup>91</sup>

There are many similarities in the analysis of the copyrightability of a particular segment of a work and whether substantial similarity exists between the two works. Very small portions of a musical work are most likely not protected by the copyright unless they are sufficiently original.<sup>92</sup> If the portion copied is not original, it would follow that the two works are not substantially similar due to a lack of any unlawful appropriation of a qualitatively important part of the copyrighted work. However, there is evidence that even if a copied portion is copyrightable, it may still be deemed to be de minimis.<sup>93</sup> Therefore, each of these defenses should be argued and analyzed separately.

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85. See NIMMER, *supra* note 29, § 13.03 [E][2]; Keyes, *supra* note 60, at 431-32.

86. Keyes, *supra* note 60, at 431-32.

87. See *Newton II*, 349 F.3d at 592-93; *Newton v. Diamond*, (“Newton I”), 204 F. Supp. 2d 1244, 1257 (C.D. Cal. 2002); *Jarvis v. A & M Records*, 827 F. Supp. 282, 288 (D.N.J. 1993).

88. See *Newton I*, 204 F. Supp. 2d at 1252-54; *Jarvis*, 827 F. Supp. at 291.

89. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 364 (1991).

90. See, e.g., *id.*; *Newton I*, 204 F. Supp. at 1252-54; *Jarvis*, 827 F. Supp. at 291, NIMMER, *supra* note 29, § 13.03[A][2].

91. See NIMMER, *supra* note 29, § 13.03[A][2].

92. See *id.*

93. See *Newton I*, 204 F. Supp. 2d at 1252-54.

## d. Fair Use

Section 107 of the Copyright Act provides a fair use exception to copyright infringement “for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research.”<sup>94</sup> The fair use doctrine allows “courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity that the law was designed to foster.”<sup>95</sup> The factors to be used when determining whether a work constitutes fair use include:

- (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 for or value of the copyrighted work.<sup>96</sup>

These factors operate as a balancing test, none alone being positive or dispositive of fair use.<sup>97</sup>

The first factor requires the determination of whether the new work is commercial or non-commercial in nature. Creating a new work for a commercial purpose is not fatal to a fair use defense, but it does weigh against it.<sup>98</sup> In *Campbell v. Acuff-Rose Music*<sup>99</sup> the Supreme Court stated that the more transformative a work is (transformative meaning whether the work “adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message”), the more likely it will be deemed fair use.<sup>100</sup> The Court further stated the more transformative the work, the less significance should be given to the other factors.<sup>101</sup>

The second factor, the nature of the copyrighted work, analyzes the overall originality and creativity of the work. The greater the creativity involved in creation of the copyrighted work, the greater the copyright protection, making it less likely that the defense of fair use will be accepted.<sup>102</sup>

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94. 17 U.S.C. § 107 (2000).

95. Marcus, *supra* note 24, at 783 (quoting *Iowa State Univ. Research Found. v. Am. Broad. Corp.*, 621 F.2d 57, 60 (2d Cir. 1980)).

96. 17 U.S.C. § 107.

97. *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 (1994); NIMMER, *supra* note 29, § 13.05[A].

98. *See NIMMER, supra* note 29, § 13.05[A][1].

99. 510 U.S.569 (1994).

100. *Campbell*, 510 U.S. at 579.

101. *Id.*

102. *See NIMMER, supra* note 29, at § 13.05[A][2].

The third factor is often confused with the determination of substantial similarity.<sup>103</sup> While substantial similarity is a required element of a copyright infringement action, its presence does not negate a fair use defense.<sup>104</sup> In fact, certain fair uses, such as a parody, by nature will incorporate a significant portion of the original work.<sup>105</sup> Although the amount of acceptable similarity in fair use differs with the substantial similarity determination, the method of analyzing both the qualitative and quantitative factors of the original work is the same.<sup>106</sup> Ultimately, the amount of copying permissible will vary with the purpose and character of the new work.<sup>107</sup>

The fourth and final factor—the effect on the market or value of the copyrighted work—requires that the court consider both the effect of the current actions as well as “whether unrestricted and widespread conduct of the sort engaged in by the defendant . . . would result in a substantially adverse impact on the potential market for the original”<sup>108</sup> or derivative works.<sup>109</sup> However, only the adverse effects of infringing actions should be considered, while the adverse effects of non-infringing actions, such as copying of non-copyrightable material or fair use criticism, should be ignored.<sup>110</sup>

Interestingly, the original market for a song often benefits once the song has been sampled and used in a new work.<sup>111</sup> However, lack of damages does not negate a finding of copyright infringement.<sup>112</sup> Ultimately, this factor is used to gather evidence of what actual damages, if any, the copyright holder has suffered.<sup>113</sup>

In *Campbell*, the Supreme Court stated that a parody can

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103. *Id.* § 13.05[A][3].

104. *See Campbell*, 510 U.S. at 578.

105. *See, e.g., id.*

106. *See NIMMER*, *supra* note 29, § 13.05[A][3].

107. *Campbell*, 510 U.S. at 586-87.

108. *Id.* at 590 (quoting *NIMMER*, *supra* note 29, § 13.05[A][4]).

109. *Id.* at 594.

110. *See NIMMER*, *supra* note 29, § 13.05[A][4].

111. *See Shimanoff*, *supra* note 16, at 38-39 (giving examples of artists that have benefited from having their songs sampled in a rap song).

112. *See NIMMER*, *supra* note 29, § 13.05[A][4] n.221.

113. *See id.* (“This factor, rather, poses the issue of whether unrestricted and widespread conduct of the sort engaged in by the defendant (whether in fact engaged in by the defendant or others) would result in a substantially adverse impact on the potential market for, or value of, the plaintiff’s present work.”).

be considered fair use even if it is created for commercial purposes.<sup>114</sup> However, there are many more transformative uses that could be considered fair use that have not been considered by the courts. For example, rapper Jay-Z's use of the Broadway musical "Annie" song "Hard Knock Life" in his song of the same name was transformative in that it took the original message of the difficulty of life in an orphanage and altered it to help demonstrate the urban struggle of living in the ghetto.<sup>115</sup> The original chorus and melody from the musical's theme was sampled and mixed with percussive beats and rap lyrics resulting in an extremely successful run at the top of the single charts both nationally and internationally.<sup>116</sup> Although Jay-Z paid for a license to sample from "Annie," his use of the song to transform an old message regarding a group of underprivileged and exploited orphans to describe the current state of children in the ghetto could have been deemed fair use.<sup>117</sup> Ultimately, the lack of precedent and resulting uncertainty in this area have caused most musicians wishing to sample for transformative purposes to obtain a license or settle outside of court.<sup>118</sup>

### C. COPYRIGHT VIOLATIONS AND DIGITAL SAMPLING

Copyright violation lawsuits involving digital sampling have been relatively sparse. In the past, many hip-hop artists employed a "catch me if you can" mentality, releasing records full of unlicensed appropriations.<sup>119</sup> After the courts began holding against digital samplers, however, the artists began to question what types of digital sampling constituted copyright infringement.<sup>120</sup> Unfortunately, the application of the Copyright Act in cases of digital music sampling has left a confusing and convoluted history that leaves almost no certainty as to what constitutes infringement, which party has the burden of proof, and what tests are to be applied.

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114. See *Campbell*, 510 U.S. at 586-88.

115. Shimanoff, *supra* note 16, at 33-35.

116. Johnny Black, *The Greatest Song Ever! Hard Knock Life*, BLENDER, Nov. 2002, at <http://www.blender.com/guide/articles.aspx?id=827> (last visited Apr. 21, 2005).

117. See *id.*

118. See Wilson, *supra* note 17, at 179.

119. See Latham, *supra* note 15, at 123.

120. See *id.* at 124 n.28 (noting that the boundaries for lawful digital sampling have not been clearly delineated).

1. *Grand Upright Music, Ltd. v. Warner Bros. Records, Inc.*

*Grand Upright Music, Ltd. v. Warner Bros. Records, Inc.*<sup>121</sup> was the first major case holding that digital sampling is a copyright violation.<sup>122</sup> At issue was the unlicensed use of instrumental and lyrical portions of Gilbert O'Sullivan's "Alone Again (Naturally)" in hip-hop artist Biz Markie's "I Need a Haircut."<sup>123</sup> Biz Markie and his record company had attempted to obtain a license from O'Sullivan, who rejected them outright.<sup>124</sup> The record company went ahead and released the record without the license and this lawsuit resulted.<sup>125</sup>

District Judge Kevin Thomas Duffy started his opinion with the Biblical commandment "Thou shalt not steal," and ultimately held that the use of three words and a portion of the music from the original song was a per se copyright violation.<sup>126</sup> The court granted the preliminary injunction requested by the plaintiffs and further suggested that the case be referred for criminal prosecution.<sup>127</sup> Although Judge Duffy did not explicitly cite to the Copyright Act and state that all digital sampling is a per se copyright violation, his opinion was consistent with this proposition.<sup>128</sup>

*Grand Upright* was a major blow to the hip-hop community.<sup>129</sup> Judge Duffy, by ignoring possible defenses of lack of substantial similarity or fair use, had created a per se copyright violation for digital sampling. The number of unlicensed samples used in commercial releases fell significantly after the decision.<sup>130</sup> However, this also led to fewer samples being used in hip-hop music.<sup>131</sup> Many artists refused to license songs because of their distaste for hip-hop.<sup>132</sup>

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121. 780 F. Supp 182 (S.D.N.Y. 1991).

122. See Latham, *supra* note 15, at 123.

123. *Grand Upright Music, Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182, 183 (S.D.N.Y. 1991).

124. *Id.* at 184.

125. *Id.* at 185.

126. *Id.* at 183.

127. *Id.* at 185.

128. See *id.* at 183 ("[T]he defendants in this action for copyright infringement would have this court believe that stealing is rampant in the music business and, for that reason, their conduct here should be excused. The conduct of the defendants herein, however, violates not only the Seventh Commandment, but also the copyright laws of this country.").

129. See Latham, *supra* note 15, at 123-24.

130. See Shimanoff, *supra* note 16, at 30.

131. See *id.* at 31.

132. See *id.* at 30-31.

Additionally, many artists who wished to sample were not financially capable of paying for licenses in advance.<sup>133</sup> Ultimately, the decision completely protected copyright owners while limiting the resources available for hip-hop artists to use in creation of new music.

## 2. *Ringgold v. Black Entertainment Television*

In *Ringgold v. Black Entertainment Television*,<sup>134</sup> the Second Circuit Court of Appeals set forth an oft cited test for substantial similarity. In this case, Ringgold claimed copyright infringement for the unlicensed use of her artwork entitled “Church Picnic Story Quilt” in the background of an episode of the sitcom “ROC.”<sup>135</sup> Although this case did not involve music copyright infringement, the test applied by the court can be easily adapted to the intricacies of digital sampling. In addition, the fact that the actual artwork was used for a short period of time along with many other props and decorations is similar to a digital sample appearing for a limited amount of time in a new work among many other sounds.

The court in *Ringgold* held that the substantial similarity test required analysis of both the quantitative and qualitative components of the copying.<sup>136</sup> The de minimis test was used to determine the quantitative component, looking solely at the amount of the copyrighted work that was copied, “a consideration that is especially pertinent to exact copying.”<sup>137</sup> For the qualitative component the court examined the “observability of the copied work—the length of time the copied work is observable in the allegedly infringing work and such factors as focus, lighting, camera angles, and prominence.”<sup>138</sup> Ultimately, the court ruled in this case that the artwork was clearly visible for a significant amount of time and therefore substantial similarity existed.<sup>139</sup>

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133. *See id.*

134. 126 F.3d 70 (2d Cir. 1997).

135. *Ringgold v. Black Entm't Television*, 126 F.3d 70, 72-73 (2d Cir. 1997).

136. *Id.* at 75.

137. *Id.*

138. *Id.*

139. *Id.* at 76-77.

### 3. *Tuff 'N' Rumble Management v. Profile Records*

In *Tuff 'N' Rumble Management v. Profile Records*,<sup>140</sup> the plaintiff claimed that the defendants illegally copied “certain drum tracks” from their song “Impeach the President” and used them in the songs “Back from Hell” and “Dana Dane with Fame.”<sup>141</sup> The Southern District of New York first stated that to establish unlawful copying a plaintiff “must show (1) actual copying, and (2) unlawful appropriation.”<sup>142</sup> The court further stated that the test for unlawful appropriation is whether the works are substantially similar, which ultimately turns on “whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.”<sup>143</sup> Additionally, “in assessing substantial similarity, courts look at the works as a whole, as opposed to dissecting a work into its constituent elements or features.”<sup>144</sup> Essentially, the court found that the test for substantial similarity is if a person would be able to identify the misappropriation by listening to both recordings.<sup>145</sup>

The court ultimately granted summary judgment for the defendant on several alternate theories. First, the plaintiff could not prove ownership of the copyright for the original works.<sup>146</sup> Second, the plaintiff failed to demonstrate the elements of access and probative similarity that establish actual copying.<sup>147</sup> And finally, the plaintiff failed to demonstrate substantial similarity between the songs in question.<sup>148</sup> Thus, summary judgment was appropriate in this case because the plaintiff could not “make out the essential elements of the claim.”<sup>149</sup>

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140. 1997 WL 158364 (S.D.N.Y. Apr. 2, 1997).

141. *Tuff 'N' Rumble Mgmt. v. Profile Records*, 1997 WL 158364, at \*1 (S.D.N.Y. Apr. 2, 1997).

142. *Id.* at \*3.

143. *Id.* at \*5 (quoting *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966)).

144. *Id.* at \*5.

145. *See id.* at \*4.

146. *Id.* at \*2-3.

147. *Tuff 'N' Rumble Mgmt.*, 1997 WL 158364 at \*3-4.

148. *Id.* at \*4-5.

149. *Id.* at \*2.

#### 4. *Jarvis v. A & M Records*

In *Jarvis v. A & M Records*,<sup>150</sup> the District Court of New Jersey addressed the issue of substantial similarity in the context of digital sampling. In its analysis, the court adopted the fragmented literal similarity test for substantial similarity from Nimmer's treatise.<sup>151</sup> This test is based upon the premise that the value of the copyrighted work can be "substantially diminished even when only a part of it is copied, if the part that is copied is of great qualitative importance to the work as a whole."<sup>152</sup> The court stated that "[t]he proper question to ask is whether the defendant appropriated, either quantitatively or qualitatively, constituent elements of the work that are original."<sup>153</sup> Therefore, if only a small portion of a copyrighted work is taken, it can still be substantially similar if the portion is unique enough to be recognized as an important part of the original song. However, "[e]asily arrived at phrases and chord progressions are usually non copyrightable."<sup>154</sup>

Applying this test to the case at hand, the court held that the "ooh," "move," and "free your body" vocals and the unique keyboard line that were sampled, though each alone was not sufficiently distinctive, were sufficiently original and unique in their particular arrangement to be considered substantially similar to the copyrighted work.<sup>155</sup> Therefore, the defendant's motion for summary judgment was denied.<sup>156</sup>

#### 5. *Newton v. Diamond*

In a recent Ninth Circuit case, the music group the Beastie Boys was sued for the unlicensed sampling of accomplished jazz flutist James W. Newton's performance of "Choir" in their song "Pass the Mic."<sup>157</sup> The Beastie Boys had obtained a license for the sound recording from ECM Records, but never approached Newton for a license for the underlying musical composition.<sup>158</sup>

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150. 827 F. Supp. 282 (D.N.J. 1993).

151. *Jarvis v. A & M Records*, 827 F. Supp. 282, 290-91 (D.N.J. 1993).

152. *Id.* at 291 (quoting *Werlin v. Readers Digest Ass'n*, 528 F. Supp. 451, 463 (S.D.N.Y. 1981)).

153. *Id.* (internal citations omitted).

154. *Id.*

155. *Id.* at 292.

156. *Id.*

157. *Newton v. Diamond* ("Newton II"), 349 F.3d 591, 594 (9th Cir. 2003), *aff'g* *Newton v. Diamond* ("Newton I"), 204 F. Supp. 2d 1244 (C.D. Cal. 2002); *Newton v. Diamond* ("Newton I"), 204 F. Supp. 2d 1244, 1258 (C.D. Cal. 2002).

158. *Newton II*, 349 F.3d at 593.

The Beastie Boys copied a three note sequence of “C”—“D-flat”—“C” that lasts for approximately six seconds at the beginning of “Choir.”<sup>159</sup> The sound was made distinctive by Newton’s vocalization technique, singing while simultaneously playing each flute note.<sup>160</sup> The sample was looped and is heard in the background of much of “Pass the Mic.”<sup>161</sup>

The Beastie Boys moved for summary judgment on Newton’s claim of copyright infringement based on two arguments: that the portion of “Choir” that they sampled cannot be protected by copyright as a matter of law; or in the alternative, any misappropriation was *de minimis*, and therefore not actionable.<sup>162</sup>

a. The District Court Decision – *Newton I*

The district court began with analysis of the copyrightability of the three note sequence, noting that the only copyright at issue was for the musical composition because the Beastie Boys had properly licensed the rights to the sound recording.<sup>163</sup>

The court found that neither the three note sequence nor the vocalization technique were sufficiently unique to justify copyright protection, as both are commonly used musical techniques and occur only once in the recording of “Choir.”<sup>164</sup> The court noted that Newton’s performance technique, which expert testimony showed was quite distinctive, could be considered sufficiently unique to justify copyright protection for the sound recording, but not for the underlying composition.<sup>165</sup>

In the alternative, the court found that the Beastie Boys copying of “Choir” was *de minimis*.<sup>166</sup> The court stated that a taking is *de minimis* “if the average audience would not recognize the misappropriation.”<sup>167</sup> Additionally, the court stated that

[i]n such cases, “where there unquestionably is copying, albeit of only a portion of [a] plaintiff’s song . . . [t]he proper question to ask is whether the defendant appropriated, either quantitatively or

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159. *Newton I*, 204 F. Supp. 2d at 1246.

160. *Id.* at 1246-47.

161. *Id.* at 1246.

162. *Id.* at 1247.

163. *Id.* at 1248-50.

164. *Id.* at 1253.

165. *Newton I*, 204 F. Supp. 2d at 1252.

166. *Id.* at 1259.

167. *Id.* at 1257.

qualitatively, 'constituent elements of the work that are original' such that the copyright rises to the level of an unlawful appropriation."<sup>168</sup>

In assessing the qualitative and quantitative importance of the copied segment, the court looked only at its relation to the original work and ignored its use in the new work.<sup>169</sup>

Quantitatively, the segment copied represented only two percent of the entire "Choir" recording, which the court held insufficient to overcome a de minimis finding.<sup>170</sup> Similar to its analysis of the copyrightability of the copied segment, the court found that the copying of three commonly used notes from a musical composition could not satisfy the substantial similarity test.<sup>171</sup> Integral to this finding was the court's determination that Newton's actual sound recording should be ignored in the qualitative analysis.<sup>172</sup> Instead, the question the court addressed was "whether someone might recognize—from a performance of the notes and notated vocalization alone—the source as the underlying musical composition."<sup>173</sup>

Thus, due to the fact that the segment copied was quantitatively small and the underlying musical composition contained no qualitatively unique or distinctive elements, the court found that the use was de minimis and not actionable as a matter of law.<sup>174</sup> In the language of the court, "no substantial similarity [will] be found if only a small, common phrase appears in both the accused and complaining songs . . . unless the reappearing phrase is especially unique or qualitatively important."<sup>175</sup>

#### b. The Court of Appeals Decision – *Newton II*

The court of appeals upheld the decision of the district court based solely on the argument that the use of the three notes was de minimis and therefore not substantially similar, choosing not to address the other argument.<sup>176</sup>

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168. *Id.* (alteration in original) (quoting *Jarvis v. A & M Records*, 827 F. Supp. 282, 289-91 (D.N.J. 1993)).

169. *Id.*

170. *Id.* at 1258.

171. *Newton I*, 204 F.Supp.2d at 1258-59.

172. *Id.*

173. *Id.* at 1258.

174. *Id.* at 1259.

175. *Id.* at 1256-57 (alteration in original) (citing *Jean v. Bug Music, Inc.*, 2002 WL 287786 at \*6 (S.D.N.Y. Feb. 27, 2002)).

176. *Newton v. Diamond* ("Newton II"), 349 F.3d 591, 592-93 (9th Cir. 2003), *aff'g* *Newton v. Diamond* ("Newton I"), 204 F. Supp. 2d 1244 (C.D. Cal.

The court adopted the *Ringgold* requirement that “[f]or an unauthorized use of a copyrighted work to be actionable, there must be substantial similarity between the plaintiff’s and the defendant’s works.”<sup>177</sup> However, the court looked to *Fisher v. Dees*,<sup>178</sup> the leading de minimis case in the Ninth Circuit, for the applicable quantitative and qualitative tests for substantial similarity.<sup>179</sup> The court observed in *Fisher* that “a use is de minimis only if the average audience would not recognize the appropriation.”<sup>180</sup> The court further adopted Nimmer’s fragmented literal similarity analysis, explaining that “the dispositive question is whether the similarity goes to trivial or substantial elements. The substantiality of the similarity is measured by considering the qualitative and quantitative significance of the copied portion in relation to the plaintiff’s work as a whole.”<sup>181</sup> The court intentionally did not look at the use of the sampled portion in the defendant’s work, stating that if this were analyzed the sample could be intentionally buried or distorted by the defendant to escape liability.<sup>182</sup> In the present case, however, the Beastie Boys had looped the sample throughout almost the entire song.<sup>183</sup>

The court held that the sampled portion was neither quantitatively nor qualitatively significant to the plaintiff’s work.<sup>184</sup> The segment was only three notes played over six seconds, or roughly two percent of the entire work, and was not repeated.<sup>185</sup> Newton argued that his technique of overblowing the notes was a distinctive feature of the segment.<sup>186</sup> However, this ultimately worked to his disadvantage because no such technique was noted on his written composition, and the Beastie Boys had obtained a proper license for the recording.<sup>187</sup>

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2002).

177. *Newton II*, 349 F.3d at 594.

178. 794 F.2d 432 (9th Cir. 1986).

179. *Newton II*, 349 F.3d at 594-95 (citing *Fisher v. Dees*, 794 F.2d 432 (9th Cir. 1986)).

180. *Id.*

181. *Id.* at 596.

182. *Id.* at 597.

183. *Newton II*, 349 F.3d at 597.

184. *Id.*

185. *Id.*

186. *See Id.* at 598.

187. *Id.*

## II. BRIDGEPORT MUSIC, INC. V. DIMENSION FILMS LLC

*Bridgeport Music, Inc. v. Dimension Films LLC*<sup>188</sup> was one of 476 cases severed by the court from the plaintiff's original complaint, which included approximately 500 causes of action and 800 defendants.<sup>189</sup> This case brings forward the questions of the copyrightability of short segments of an original work, as well as the relevance of the substantial similarity defense in the context of digital sampling.

## A. BACKGROUND

In May 1998, the defendant released the film "I Got the Hook Up," which included a recording of the NWA song "100 Miles and Runnin'" ("100 Miles") on its soundtrack.<sup>190</sup> Originally, the musical composition copyright to "100 Miles" was co-owned by Dollarz N Sense Music ("DNSM"), Ruthless Attack Muzick ("RAM"), Stone Agate Music, and Hancock Music.<sup>191</sup> The defendant claimed that in the summer of 1998 the original owners of the musical composition of "100 Miles" granted it an oral license to use their composition in the film, and in June 2002 executed synchronization licenses retroactive to the film's release date.<sup>192</sup>

In December 1998, as compensation for the use of a sample from the George Clinton song "Get Off Your Ass and Jam" ("Get Off"), Bridgeport (the owner of the "Get Off" musical composition copyright) acquired a twenty-five percent interest in the musical composition for "100 Miles."<sup>193</sup> Bridgeport argued that the oral licenses and synchronization licenses "authorize[d] the use of each of the original owner's interest, not the work in its entirety."<sup>194</sup> Therefore, Bridgeport argued, the defendant was not authorized to use Bridgeport's twenty-five percent interest in the "100 Miles" musical composition and was not authorized to use the sample from the "Get Off" musical composition.<sup>195</sup>

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188. 230 F. Supp. 2d 830 (M.D. Tenn. 2002), *rev'd*, *Bridgeport Music, Inc. v. Dimension Films LLC* ("Bridgeport II"), 383 F.3d 390 (6th Cir. 2004)

189. *Bridgeport Music, Inc. v. Dimension Films LLC* ("Bridgeport I"), 230 F. Supp. 2d 830 (M.D. Tenn. 2002), *rev'd*, *Bridgeport Music, Inc. v. Dimension Films LLC* ("Bridgeport II"), 383 F.3d 390 (6th Cir. 2004)

190. *Bridgeport I*, 230 F. Supp. 2d at 833.

191. *Id.*

192. *Id.*

193. *Id.*

194. *Id.*

195. *Id.*

Westbound Records, Inc. (“Westbound”) owned the copyright to the “Get Off” sound recording.<sup>196</sup> Westbound brought a copyright infringement claim against the defendants alleging unauthorized sampling of the “Get Off” sound recording.<sup>197</sup>

The segment of “Get Off” that was sampled is described as:

an arpeggiated chord—that is, three notes that, if struck together, comprise a chord but instead are played one at a time in very quick succession—that is repeated several times at the opening of “Get Off.” The arpeggiated chord is played on an unaccompanied electric guitar. The rapidity of the notes and the way they are played produce a high-pitched, whirling sound that captures the listener’s attention and creates anticipation of what is to follow.<sup>198</sup>

The sample comprised of a two second portion of the chord that was looped fourteen to sixteen times, appearing as a seven to eight second long segment in five different parts of “100 Miles.”<sup>199</sup> The sampled chord, which was used to evoke the sound of a police siren in the background of the new work, was slowed and the pitch was lowered to match the tempo of “100 Miles.”<sup>200</sup>

“Get Off” is a celebratory song about dancing with a “strong dance beat and a display of intricate electric guitar playing” accompanied by the lyrics of two expletives followed by “get off your ass and jam” repeated throughout the song.<sup>201</sup> By comparison, “100 Miles” is a hip-hop song “about four black men on the run from the F.B.I. who appear to be wrongfully pursued for some unmentioned crime.”<sup>202</sup>

#### B. THE DISTRICT COURT DECISION – *BRIDGEPORT I*

The district court’s decision in *Bridgeport* was in response to the defendant’s motion for summary judgment. The defendant asserted that it could not be found liable for copyright infringement for several reasons:

- (1) it possessed a valid license from at least one of Bridgeport’s co-owners of the allegedly infringed work “100 Miles and Runnin” . . . (2) Bridgeport executed a release related to “100 Miles”; (3) the portion of Bridgeport’s composition “Get Off Your Ass and Jam” . . . that was sampled by “100 Miles” is de minimis and therefore not subject to the

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196. *Bridgeport I*, 230 F. Supp. 2d at 833.

197. *Id.* at 838.

198. *Id.* at 839.

199. *Id.* at 841.

200. *Id.*

201. *Id.* at 842.

202. *Bridgeport I*, 230 F. Supp. 2d at. at 841.

protection of the copyright laws; and (4) the portion of Westbound's sound recording of "Get Off Your Ass and Jam" that was sampled by "100 Miles" is de minimis and therefore not subject to the protection of the copyright laws.<sup>203</sup>

The first issue the district court addressed was whether the oral or synchronization licenses granted by the original owners gave the defendant the right to copy from the composition.<sup>204</sup> The court held that the defendant provided sufficient evidence to prove that the oral licenses existed and that the synchronization licenses simply recorded the agreement.<sup>205</sup> Further, the court noted that each copyright owner has the right to license the use of the musical composition as long as the proceeds are appropriately divided and the other owners' use and exploitation of their interest is not encumbered.<sup>206</sup> Therefore, the court granted summary judgment for the defendants on all claims pertaining to the musical composition.<sup>207</sup>

The only remaining claim was whether the defendant infringed upon plaintiff Westbound's copyright for the sound recording of "Get Off," which was not licensed by the defendant.<sup>208</sup> The defendant offered two reasons why this claim should fail: "(1) the portion of "Get Off" that was copied was not original and therefore not protected by copyright law; (2) the sample of "Get Off" was legally insubstantial and therefore the sample did not amount to actionable copying under copyright law."<sup>209</sup> For the purpose of the summary judgment motion, the court assumed that the sample was digitally copied from the sound recording of "Get Off."<sup>210</sup>

#### 1. Originality of the Copied Portion

The defendant asserted that the chord that was sampled from "Get Off" was a "commonly used collection of notes that, standing alone, is not entitled to copyright protection."<sup>211</sup> The court held that although a valid copyright raises a rebuttable presumption of originality for the entire song, a defendant may

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203. *Id.* at 832.

204. *See id.* at 833-38.

205. *Id.*

206. *Id.*

207. *Id.* at 838.

208. *Bridgeport I*, 230 F. Supp. 2d at 838.

209. *Id.* at 838.

210. *Id.*

211. *Id.* at 838-39.

still prove that the particular element sampled is unoriginal and not entitled to copyright protection.<sup>212</sup>

Examining the copied chord, the court stated that “the question does not turn on the originality of the chord, but in the use of and the aural effect produced by the way the notes in the chord are played, especially here where copying of the sound recording is at issue.”<sup>213</sup> After listening to the arpeggiated chord in “Get Off,” the court found that a reasonable jury could conclude that it is original and creative and consequently protected by copyright.<sup>214</sup> Thus, summary judgment on the theory of lack of originality was denied.<sup>215</sup>

## 2. Copied Portion Not Substantially Similar

The defendant also asserted that even if the segment copied was protected by copyright, it “is neither quantitatively nor qualitatively significant to the plaintiffs’ copyright interests in “Get Off” and therefore any copying of the chord is not actionable as a matter of law.”<sup>216</sup>

The court began its analysis by noting that the Sixth Circuit has recognized that the de minimis principle “can be applied as a defense to copyright infringement if it can be shown that a substantial amount of the copyrighted work was not taken.”<sup>217</sup> Ultimately, the court stated, it was asked to “balance the interests protected by the copyright laws against the stifling effect that overly rigid enforcement of these laws may have on the artistic development of new works.”<sup>218</sup> Additionally, the court noted that the lack of case law addressing digital sampling or clear road maps of how to apply the de minimis test from circuit courts or the Supreme Court would complicate the process.<sup>219</sup>

According to the court, de minimis analysis falls under the quantitative element of the substantial similarity element that is necessary to prove actionable copying.<sup>220</sup> In general, the court felt that the test for substantial similarity was “whether

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212. *Id.* at 839.

213. *Id.*

214. *Bridgeport I*, 230 F. Supp. 2d at 839.

215. *Id.*

216. *Id.*

217. *Id.* at 839-40.

218. *Id.* at 840.

219. *Id.*

220. *Bridgeport I*, 230 F. Supp. 2d at 840.

an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.”<sup>221</sup> The court then adopted the language from *Newton I* and *Jarvis*, stating that the question is “whether the defendant appropriated, either quantitatively or qualitatively, ‘constituent elements of the work that are original.’”<sup>222</sup> The court also acknowledged Nimmer’s fragmented literal similarity test.<sup>223</sup>

The court found that the two second guitar chord was quantitatively small in comparison to the plaintiff’s work, but noted that it played a significant role in the defendant’s song.<sup>224</sup> In analyzing the qualitative element, the court began by noting that the two songs were very different in nature with virtually no similarities in tone or mood.<sup>225</sup> Additionally, the copied chord had been altered to such an extent that it would not be “recognizable to a lay observer as being appropriated from the plaintiffs’ work,” even “one familiar with the works of George Clinton.”<sup>226</sup>

The court summarized its reasoning as follows:

The Court recognizes that the fact of blatant copying is not challenged by the defendant for the purposes of this motion, and that the purposes of the copyright laws is to deter wholesale plagiarism of prior works. However, a balance must be struck between protecting an artist’s interests, and depriving other artists of the building blocks of future works. Since the advent of Western music, musicians have freely borrowed themes and ideas from other musicians. If even an aficionado of George Clinton’s music might not readily ascertain that his music has been borrowed, the purposes of copyright law would not be served by punishing the borrower for his creative use.<sup>227</sup>

Ultimately, the court held that the copied chord was so small in size and unrecognizable as a misappropriation that the two songs could not be considered substantially similar. Thus, the court granted summary judgment for the defendants on the sound recording copyright claim.<sup>228</sup>

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221. *Id.* at 840 (quoting *Tuff 'N' Rumble Mgmt., Inc. v. Profile Records, Inc.*, 1997 WL 158364 (S.D.N.Y. Apr. 2, 1997)).

222. *Id.* at 841 (quoting *Newton v. Diamond* (“*Newton I*”), 204 F. Supp. 2d 1244, 1257 (C.D. Cal. 2002) (quoting *Jarvis v. A&M Records*, 827 F. Supp. 282, 291 (D.N.J. 1993)).

223. *Id.* at 841.

224. *Id.*

225. *Id.* at 841-42.

226. *Bridgeport I*, 230 F. Supp. 2d at 842.

227. *Bridgeport I*, 230 F. Supp. 2d at 842 (internal citations omitted).

228. *Id.* at 843.

C. SIXTH CIRCUIT COURT OF APPEALS – *BRIDGEPORT II*

Westbound appealed from the district court's determination that the defendant's copying was de minimis and therefore not actionable.<sup>229</sup> Westbound challenged the district court's "articulation of the applicable standards and its determination that there was no genuine issue of fact precluding summary judgment on this issue."<sup>230</sup> At "[t]he heart of Westbound's arguments [was] the claim that no substantial similarity or de minimis inquiry should be undertaken at all when the defendant has not disputed that it digitally sampled a copyrighted sound recording."<sup>231</sup> The Sixth Circuit Court of Appeals noted the defendant's objection that this argument was made for the first time upon appeal, but in the exercise of discretion decided to examine this argument due to its importance to the resolution of the issue.<sup>232</sup>

Before directly addressing Westbound's argument, the court of appeals laid out several general observations about the nature and scope of its holding. First, the court of appeals stated the analysis for determining copyright infringement for a musical composition is not the same as the analysis that should be applied for a sound recording.<sup>233</sup> The court of appeals agreed with the district court's analysis as it would apply to a musical composition, but, because this case involved a sound recording, the court of appeals departed from this reasoning.<sup>234</sup> The decision in this case was limited to the specific realm of digital sampling due to the Sixth Circuit's self-recognized limited technological knowledge.<sup>235</sup> Finally, the court of appeals noted that the "music industry, as well as the courts, are best served if something approximating a bright-line test can be established. Not necessarily a 'one size fits all' test, but one that, at least, adds clarity to what constitutes actionable infringement with regard to the digital sampling of copyrighted sound recordings."<sup>236</sup>

The court of appeals began its analysis with a review of the

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229. *Bridgeport Music, Inc. v. Dimension Films* ("Bridgeport II"), 383 F.3d 390, 393 (6th Cir. 2004).

230. *Id.* at 395.

231. *Id.*

232. *Id.* at 396 n.4.

233. *Id.* at 396.

234. *Id.*

235. *Bridgeport II*, 383 F.3d at 396.

236. *Id.* at 397.

applicable language from the Copyright Act. Specifically, the court of appeals focused on the language of sections 114(a) and 106(2) that give the owner of a sound recording copyright the exclusive right “to prepare derivative works based upon the copyrighted work.”<sup>237</sup> Section 114(b) of the Act further specifies that the exclusive right “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,” but 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.”<sup>238</sup>

According to the court of appeals, “copyright laws attempt to strike a balance between protecting original works and stifling further creativity.”<sup>239</sup> The balance applicable to copyright protection of sound recordings, as interpreted by the court of appeals, is that the owner has the exclusive right to duplicate the recording, while “the world at large is free to imitate or simulate the creative work fixed in the recording.”<sup>240</sup> Ultimately, the court believed that the seminal question in the case of digital sampling was “[i]f you cannot pirate the whole sound recording, can you ‘lift’ or ‘sample’ something less than the whole.” The court’s answer “to that question [was] in the negative . . . . In other words, a sound recording owner has the exclusive right to ‘sample’ his own recording.”<sup>241</sup>

The court of appeals offered several reasons to support its interpretation of the Copyright Act. First, “there is ease of enforcement. Get a license or do not sample.”<sup>242</sup> The court of appeals did not view this as “stifling creativity in any significant way,” because an artist could hire a musician to duplicate the song in the studio.<sup>243</sup> Second, the market will keep the license price within bounds because it will have to be less than the cost to duplicate the sample with musicians in the studio.<sup>244</sup> Third, “sampling is never accidental . . . you know

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237. *Id.* (quoting 17 U.S.C. § 106(2)(2000)).

238. *Id.* (quoting 17 U.S.C. § 114(b)).

239. *Id.* at 398.

240. *Bridgeport II*, 383 F.3d at 398.

241. *Id.*

242. *Id.*

243. *Id.*

244. *Id.* at 398-99.

you are taking another's work product."<sup>245</sup>

The court of appeals then addressed the specific question of why the de minimis and substantial similarity principles apply to the musical composition, but not to the sound recording.<sup>246</sup> As discussed previously, the court of appeals believed its interpretation was supported by the text of the Copyright Act.<sup>247</sup> Additionally, the court of appeals stated that "even when a small part of a sound recording is sampled, the part taken is something of value."<sup>248</sup> As proof, the court of appeals offered the fact that producers sample to add something new to the record, save costs, or both.<sup>249</sup>

The court of appeals then explained that although the district court did an excellent job of applying the de minimis and substantial similarity analysis, the case illustrated "the kind of mental, musicological, and technological gymnastics that would have to be employed" if this were the test adopted by the courts.<sup>250</sup> The value of the bright-line rule proposed becomes apparent, the court of appeals explained, when considering that the district court has 800 other cases involving digital sampling.<sup>251</sup> However, the court of appeals also emphasized that "considerations of judicial economy" were not what drove its opinion.<sup>252</sup>

The court of appeals further acknowledged the fact that its decision followed no existing judicial precedent.<sup>253</sup> However, it did note that "[s]everal law review and text writers, some of whom have been referenced in [the] opinion, have suggested that this is the proper interpretation of the copyright statute as it pertains to sound recordings."<sup>254</sup> Though there were many opposing scholarly works, the court of appeals noted "where one stands depends on where one sits."<sup>255</sup>

In response to the assertion that its holding would stifle creativity, the court of appeals stated that "many artists and record companies have sought licenses as a matter of

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245. *Id.* at 399.

246. *Bridgeport II*, 383 F.3d at 399.

247. *Id.*

248. *Id.*

249. *Id.*

250. *Id.*

251. *Id.*

252. *Bridgeport II*, 383 F.3d at 399-400.

253. *Id.* at 400.

254. *Id.*

255. *Id.* at 401.

course.”<sup>256</sup> Additionally, the recordings created before 1971 are not protected by the Copyright Act.<sup>257</sup> Ultimately, the court of appeals believed that licensing costs would not affect the ability of artists to sample, and that older works not protected by copyright would provide a cheap alternative. Notably, the court of appeals concluded that “the record industry, including the recording artists, has the ability and know-how to work out guidelines, including a fixed schedule of license fees, if they so choose.”<sup>258</sup>

Finally, the court of appeals stated that its analysis was consistent with a “literal reading” of the Copyright Act.<sup>259</sup> The court of appeals did not find much assistance from the legislative history of the Act because digital sampling was not an issue when the laws were created.<sup>260</sup> The court of appeals stressed that if the record industry wants clarification of or changes made to the Copyright Act, it has the ability to go back to Congress:

This is the best place for the change to be made, rather than in the courts, because as this case demonstrates, the court is never aware of much more than the tip of the iceberg. To properly sort out this type of problem with its complex technical and business overtones, one needs the type of investigative resources as well as the ability to hold hearings that is possessed by Congress.<sup>261</sup>

Based on its new formulation of the copyright protection of sound recordings, the court of appeals reversed the entry of summary judgment on Westbound’s claims.<sup>262</sup>

### III. ANALYSIS

In *Bridgeport II*, the Sixth Circuit Court of Appeals lost sight of the purpose of copyright protection and misinterpreted the language of the Copyright Act. Although the bright-line rule established by the court of appeals will make judicial determination of infringement of a sound recording copyright much easier, the rule is not supported by judicial precedent, a “literal reading” of the Copyright Act, or the overall purpose of copyright protection.

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256. *Id.*

257. *Id.*

258. *Bridgeport II*, 383 F.3d at 401.

259. *Id.*

260. *Id.*

261. *Id.* at 402.

262. *Id.*

## A. IGNORING PERSUASIVE JUDICIAL DECISIONS

The Sixth Circuit Court of Appeals decided to ignore all persuasive decisions from other circuits in favor of a few academic and business articles supporting the strict rule announced by the court of appeals. Specifically, the court of appeals ignored the language in the holdings and dicta of *Tuff 'N' Rumble*, *Newton I*, and *Newton II* that supported the use of the substantial similarity test in sound recording copyright infringement claims.

The court of appeals simply overlooked these cases, stating “[w]e have not addressed in detail any of the cases frequently cited in these music copyright cases because in the main they involved infringement of the composition copyright and not the sound recording copyright.”<sup>263</sup> However, the Second Circuit in *Tuff 'N' Rumble* applied the substantial similarity test to determine if there was actionable copying in a claim involving *both* the composition and the sound recording copyrights. Further, although *Newton I* and *II* dealt only with the copyright to the musical composition, both courts explained in dicta how Newton’s unique performance style would apply to a substantial similarity determination for the sound recording, but not for the underlying composition.

Although these decisions were not binding on the Sixth Circuit, they were the only judicial decisions previously discussing the sampling of a sound recording. The district court recognized these decisions and the court of appeals should not have dismissed them so easily. Had the court of appeals followed the tests laid out in the other circuits, it is likely that summary judgment would have been granted due to a lack of substantial similarity.

1. Applying the *Tuff 'N' Rumble* Analysis

The *Tuff 'N' Rumble* court’s test for substantial similarity was whether, in looking at the two works as a whole, “an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.”<sup>264</sup> In *Bridgeport I*, the district court stated that even a George Clinton aficionado—much less an average lay observer—would

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263. *Id.* at 400 n.13.

264. *Tuff 'N' Rumble Mgmt., Inc. v. Profile Records, Inc.*, 1997 WL 158364 at \*4 (S.D.N.Y. Apr. 2, 1997)(quoting *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966)).

not recognize the use of the sampled chord in “100 Miles.”<sup>265</sup> The chord has been slowed and the pitch lowered so that it is unrecognizable from its original form. Consequently, the threshold for substantial similarity—recognized appropriation by an average lay observer—was not met in *Bridgeport I*. Therefore, the application of the *Tuff ‘N’ Rumble* test in *Bridgeport I* supported summary judgment for the defendant due to lack of substantial similarity.

## 2. Applying the *Jarvis* Analysis

The *Jarvis* court stated that “[t]he proper question to ask is whether the defendant appropriated, either quantitatively or qualitatively, constituent elements of the work that are original.”<sup>266</sup> The district court in *Bridgeport I* found that the sampled chord was quantitatively small in comparison to the plaintiff’s work, although it played a more significant role in the defendant’s work.<sup>267</sup> According to the *Jarvis* court, if only a small portion of a copyrighted work is taken, it can still be substantially similar if the portion is unique enough to be recognized as an important part of the original song. However, the chord in *Bridgeport I* from “Get Off” is altered to such an extent that the qualitatively unique elements of the chord are unrecognizable to the lay observer. Therefore, the sample used in “100 Miles” cannot be recognized as an important part of the original song and did not satisfy the elements of the *Jarvis* substantial similarity test. Thus, in the absence of quantitatively significant or qualitatively recognizable copying, summary judgment for the defendant in *Bridgeport I* would have been appropriate.

## 3. Applying the *Newton I* and *II* Analysis

The courts in *Newton I* and *II*, much like the court in *Jarvis*, stated that there is not substantial similarity “if the average audience would not recognize the misappropriation.”<sup>268</sup>

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265. *Bridgeport Music, Inc. v. Dimension Films* (“*Bridgeport I*”), 230 F. Supp. 2d 830, 842 (M.D. Tenn. 2002), *rev’d*, *Bridgeport Music, Inc. v. Dimension Films* (“*Bridgeport II*”), 383 F.3d 390 (6th Cir. 2004).

266. *Jarvis v. A&M Records*, 827 F. Supp. 282, 291 (D.N.J. 1993) (internal citations omitted).

267. *Bridgeport I*, 230 F. Supp. 2d at 841.

268. *Newton v. Diamond* (“*Newton II*”), 349 F.3d 591, 594-95 (9th Cir. 2003), *aff’g* *Newton v. Diamond* (“*Newton I*”), 204 F. Supp. 2d 1244 (C.D. Cal. 2002); *Newton v. Diamond* (“*Newton I*”), 204 F. Supp. 2d 1244, 1257 (C.D. Cal. 2002).

In *Newton I* and *II* the courts held that an average audience would not recognize the misappropriation of three notes in respect to the musical composition. Both courts noted, however, that the sample would probably violate the sound recording copyright, which the Beastie Boys had properly licensed, due to Newton's unique style. As discussed previously, however, the chord sampled from "Get Off" is altered so significantly that an average audience would not be able to recognize the misappropriation. Thus, although the chord is unique within Clinton's song, it was still not recognizable as a misappropriation within "100 Miles."

#### 4. Applying the *Ringgold* Analysis

The *Ringgold* court held that substantial similarity depended upon the "observability of the copied work—the length of time the copied work is observable in the allegedly infringing work and such factors as focus, lighting, camera angles, and prominence."<sup>269</sup> Applying this to the *Bridgeport I* digital sampling context, the question becomes the amount of time the sample is used in the infringing work and its recognizability in respect to the other sounds. The sampled chord from "Get Off" can be heard in a little less than forty seconds of "100 Miles," which is far from insignificant.<sup>270</sup> However, due to the manipulation of the sound of the chord and its use within a completely different style of music, the sample is virtually unrecognizable when compared to the original. If the sample is unrecognizable, then it cannot be observable for any amount of time in the new work. Ultimately, if the copyrighted work cannot even be identified within the infringing work, it is unlikely that substantial similarity should be found.

#### 5. Conclusion

It is highly likely that the application of any of the tests laid out in previous cases would result in summary judgment for the defendant in *Bridgeport I* due to lack of substantial similarity. However, the Sixth Circuit Court of Appeals chose not to address these persuasive holdings, but instead focused its analysis upon its reading of the Copyright Act.

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<sup>269.</sup> *Ringgold v. Black Entm't Television, Inc.*, 126 F.3d 70, 75 (2d Cir. 1997).

<sup>270.</sup> *Bridgeport II*, 383 F.3d at 394.

B. A “LITERAL READING” OF THE COPYRIGHT ACT DOES NOT SUPPORT THE HOLDING OF THE COURT OF APPEALS

In its decision, the Sixth Circuit Court of Appeals relies upon the language of sections 106 and 114 of the Copyright Act that grants the copyright owner the exclusive right to make derivative works. However, the Sixth Circuit’s interpretation of the statutory language does not take into account the purpose of each of the clauses in context to the whole and ignores the meaning of the term “derivative works.”

Section 106 of the Copyright Act is intended to establish the rights exclusive to the owner of the musical composition copyright.<sup>271</sup> Section 114(a) extends many of these rights to sound recording copyrights, including the right to create derivative works.<sup>272</sup> Section 114(b), however, actually limits the right to create derivative works to the actual sounds from the sound recordings, clearing the way for imitation.<sup>273</sup>

Under the Sixth Circuit’s reading of 114(b), the use of the words “actual sounds” creates an absolute right in the copyright holder to sample from the sound recording.<sup>274</sup> A better reading of this section indicates that the words “actual sounds” are words of limitation intended to show that the copyright protection of a sound recording does not extend to the ideas of the sounds, but only to the actual sounds themselves.<sup>275</sup> It does not follow that because copyright protection of a sound recording is limited to the actual sounds that the right to sample those sounds is absolute. If Congress intended for the right to be absolute, the language required to convey the idea could be extremely clear and unambiguous. Ultimately, the court of appeals took words of limitation and created an unconvincing and strained argument that they were intended to give the owner of a sound recording copyright the absolute right to sample from the recording.

The better interpretation of section 114(b) is that the exclusive right to create derivative works provided to the owner of a sound recording copyright is the same as the right provided to the owner of a musical composition copyright, but limited to the actual sounds on the recording. Thus, the creator of a new work is subject to a composition infringement claim only if

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271. See 17 U.S.C. § 106 (2000).

272. *Id.* § 114(a).

273. *Id.* § 114(b).

274. *Bridgeport II*, 383 F.3d at 394.

275. See Nimmer, *supra* note 29, § 8.05.

there has been an illegal appropriation of the original work, which is ultimately determined using the substantial similarity test.

Additionally, the Sixth Circuit generally ignored the definition of “derivative work” within the context of section 114(b). As defined in section 101, a work must be “based upon” a preexisting work to be considered “derivative.”<sup>276</sup> This indicates that there must be some minimal level of similarity between the two works for the new work to be considered derivative. As Nimmer states, a work is only derivative if it “has *substantially* copied from a prior work.”<sup>277</sup> Consequently, both 114(b) and 101 require “substantial similarity” between the copyrighted work and the new work to prove that there has been an illegal appropriation.

It would be a far stretch to say that “100 Miles” is based on or is substantially similar to “Get Off.” One chord lasting two seconds was copied from “Get Off,” and it is so significantly altered that, in the words of the district court, “even an aficionado of George Clinton’s music might not readily ascertain that his music has been borrowed.”<sup>278</sup> Additionally, “100 Miles” cannot seriously be considered a musical arrangement, condensation, adaptation, or any of the other examples of derivative works listed in section 101. Ultimately, Westbound cannot establish a copyright violation because “100 Miles” is neither substantially similar to, nor a derivative work of “Get Off.” Therefore, the court of appeals erred in reversing the district court’s summary judgment decision.

#### C. THE HOLDING BY THE COURT OF APPEALS IS CONTRARY TO THE PURPOSE OF COPYRIGHT PROTECTION

The purpose of copyright protection, as stated in the Constitution, is to promote the progress of a useful art.<sup>279</sup> As the Sixth Circuit Court of Appeals put it, “[t]he copyright laws attempt to strike a balance between protecting original works and stifling further creativity.”<sup>280</sup> However, the decision announced by the court of appeals in *Bridgeport II* did

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276. 17 U.S.C. § 101.

277. NIMMER, *supra* note 29, § 3.01 (emphasis in original).

278. *Bridgeport Music, Inc. v. Dimension Films* (“*Bridgeport I*”), 230 F. Supp. 2d 830, 842 (M.D. Tenn. 2002), *rev’d*, *Bridgeport Music, Inc. v. Dimension Films* (“*Bridgeport II*”), 383 F.3d 390 (6th Cir. 2004).

279. U.S. CONST. art. 1, § 8, cl. 8.

280. *Bridgeport II*, 383 F.3d at 398.

everything possible to protect original works while backhandedly dismissing all evidence that its new rule would significantly stifle creativity.

#### 1. Ease of Application Does Not Excuse Inconsistency with the Law

The first argument offered by the court of appeals in support of its bright-line rule was ease of enforcement.<sup>281</sup> It is apparent that the court of appeals believed that the existing tests for substantial similarity and de minimis use were confusing and unpredictable, causing trouble for both the judicial system and for the music industry.

In concluding its analysis, the court of appeals admitted that there is no “Rosetta stone” for interpretation of the Copyright Act.<sup>282</sup> Technological and musical advances have progressed much further than the drafters of the statute could have imagined, and the laws as written are difficult to apply today. However, the fact that the language is difficult to apply does not give a court a license to find additional rights in words of limitation, especially rights that ultimately violate the purpose of the Copyright Act itself. Instead, a court is bound by a duty to apply generally accepted existing tests or to create new tests that remain consistent with the law. Congress alone has the right to expand or constrict the rights of copyright holders.

Although ease of application is a valid concern, the test must be consistent with the textual meaning and purpose of the law itself, regardless of whether it is difficult to apply or predict. The holding of the court of appeals is easy to apply; however, it is not consistent with the Copyright Act.<sup>283</sup>

#### 2. The Act Was Not Intended to Protect the Livelihood of Studio Musicians

Next, the court of appeals argued that copying even a small portion of a sound recording is taking something of value.<sup>284</sup> As proof, the court of appeals stated that artists’ main reason for sampling was to save money by avoiding hiring studio musicians to simulate the sounds, a problem it characterized as particularly dangerous to the music profession because “the

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281. *Id.*

282. *Id.* at 401.

283. *See supra* Part III.B.

284. *Bridgeport II*, 383 F.3d at 399.

musician is being replaced with himself.”<sup>285</sup> The court of appeals seems to lament the fact that the old ways of creating music are, in some modern music genres, being replaced with new technology that eliminates much of the need for live musicians.

However, it is the purpose of the Copyright Act to promote the creation of new art, not to ensure that studio musicians continue to get paid for simulating old sounds. The rationale of the court of appeals has nothing to do with this purpose. Hiring a studio musician to simulate a sound from an existing work, as the court of appeals would have artists do, is not the creation of new art; nor does it promote creation by rewarding the original author.

In any case, it seems highly unlikely and uneconomical that NWA would hire a studio musician to come in and play one chord so that they could record it and digitally alter it for their song. Additionally, many artists are not signed by a record company and cannot afford studio time, much less studio musicians. Consequently, artists will be discouraged from using small segments, which would not in themselves qualify for copyright protection, to create new and unique songs. Ultimately, the argument of the court of appeals does not protect the original creator and actually discourages future creative musical works.

### 3. Requiring Licensing of All Samples Will Diminish Creativity

The court of appeals further defended its position by noting that many artists receive licenses for samples as a matter of course, and that there is a large body of music that is not protected by copyright.<sup>286</sup> The court of appeals once again, however, missed the point. Many artists sample enough of a pre-existing work so that it is substantially similar to their new work. Licensing is always necessary in these circumstances. The fact that some artists do pay for licenses to sample a single chord does not demonstrate that it will not stifle creativity. Artists that have the money may wish to avoid the uncertainty of litigation and pay for a license for everything they sample. However, the creativity of those artists that cannot afford to license every beat and note they sample will be significantly

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<sup>285.</sup> *Id.* at 399, n.11 (quoting Christopher D. Abrahamson, *Digital Sampling and the Recording Musician: A Proposal for Legislative Protection*, 74 N.Y.U. L. REV. 1660, 1668 (1999)).

<sup>286.</sup> *Id.* at 401.

curtailed by this decision.

Similarly, the fact that there is a body of music that is not protected by a sound recording copyright does not absolve the court of appeals of the fact that the holding eliminates access to all music recorded for more than the last thirty years. The ruling of the court of appeals effectively limits the pool of available resources for modern artists that sample small pieces of existing works to create something new and original, thus hindering creativity.

The court of appeals also failed to adequately acknowledge the practical result of its decision. In reality, creativity will be significantly affected as a considerable amount of music will become too expensive or impossible to license. The court of appeals gave absolute monopoly power to the copyright owners over the sounds that they record. This will give them a significant bargaining advantage over the potential sampler. In addition, the lack of a mandatory licensing system will make it possible for artists that do not consider hip-hop a valid art form to deny a sampling license, ultimately stifling the very creativity that the copyright act was intended to promote.

Additionally, many hip-hop artists will be forced to abandon sampling or reduce the number of samples used in a new song. Chuck D and Shocklee from the group Public Enemy believed that the decision in *Grand Upright Music, Ltd. v. Warner Bros. Records, Inc.*<sup>287</sup> significantly hurt hip-hop because the samples became too expensive, and incorporating multiple samples into a song was almost impossible.<sup>288</sup> They opined that this eliminated an artist's ability to take many unrecognizable samples and create a collage.<sup>289</sup> Indeed, Public Enemy was forced to change their entire sound because of the overwhelming cost of sampling after *Grand Upright*.<sup>290</sup> The decision in *Bridgeport II* marks a return to the extremely strict per se infringement rule first handed down in *Grand Upright*, and will ultimately lead to reduced creativity and creation.

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287. 780 F. Supp 182 (S.D.N.Y. 1991).

288. See Kembrew McLeod, *How Copyright Law Changed Hip Hop: An Interview With Public Enemy's Chuck D and Hank Shocklee*, STAY FREE!, Fall 2002, available at [http://www.stayfreemagazine.org/archives/20/public\\_enemy.html](http://www.stayfreemagazine.org/archives/20/public_enemy.html) (last visited Apr. 8, 2005).

289. See *id.*

290. *Id.*

#### 4. It Is Outside the Authority of the Court to Pressure the Music Industry into a Mandatory Licensing System

The court of appeals further rationalized its decision by stating that the music industry has the ability and the know-how to create a mandatory licensing system for digital samples.<sup>291</sup> The decision will likely put pressure on the industry to create pricing guidelines for digital sampling; but the ends do not justify the means. It is not within the authority of a court to encourage a mandatory licensing scheme for a practice that is not in itself a violation of the copyright law. Any licensing scheme must be consistent with the laws contained in the Copyright Act, as must any decision by the judiciary. This decision, as well as any licensing scheme that results from it, is not consistent with the Copyright Act.

Additionally, there is still a significant amount of sampling that will satisfy the substantial similarity test and put significant pressure on the music industry and on Congress to create a mandatory licensing system that is consistent with the purposes of copyright protection.

#### 5. There Is No Intent Element In the Copyright Act

The final argument the court of appeals gave for its holding was that digital sampling is never an unintentional copying.<sup>292</sup> However, the elements necessary to demonstrate a prima facie case of copyright infringement do not include the showing of a particular state of mind. This protects the copyright holder by allowing the copyright holder to prove infringement without having to show that a defendant knowingly copied from the copyrighted work. An artist that subconsciously copies a significant amount of another artist's work has infringed upon the copyright as much as a person who intentionally samples a significant amount of another's work. The same is true for de minimis copying: an artist who copies a de minimis amount of another's work has not infringed upon the copyright regardless of whether it was intentional or unintentional.

#### 6. Conclusion

Any private benefit experienced by creators is incidental to the purpose of maximization of public benefit from the arts.

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291. *Bridgeport II*, 383 F.3d at 401.

292. *Id.* at 399.

The reason that copyright owners have limited rights over the musical composition and sound recording is so that they are encouraged to create new works. However, it is highly unlikely that artists will decide not to create because a few seconds of their sound recording could be copied, altered into a very different sound, and incorporated into a new work that is very different from the original. The bright line test laid out by the Sixth Circuit Court of Appeals in *Bridgeport II* will significantly reduce the pool of sounds that can be sampled to create new and original works, ultimately working against the purpose of the Copyright Act.

#### D. THE DISTRICT COURT OPINION IS THE PROPER DECISION

As the court of appeals noted, the district court did a very good job of navigating the applicable *de minimis* and substantial similarity tests based upon the statutes and the available digital sampling case law. The fundamental difference between the two decisions was the Sixth Circuit's interpretation of section 114(b) of the Copyright Act, which it believed granted the copyright holder the exclusive and absolute right to sample from the sound recording. However, as discussed previously, the correct interpretation is that the language in this section actually limits, not enhances, the rights of the copyright owner. Thus, had the court of appeals correctly interpreted the Copyright Act, it most likely would have applied the substantial similarity test and arrived at the same conclusion as the district court.

The district court's analysis demonstrates how difficult it is to apply the substantial similarity test. However, it also clearly illustrates that the courts can apply the test to achieve an outcome consistent with the purpose of the copyright laws. The district court did an excellent job of navigating the relevant case law and statutes. As the district court concluded, the elements necessary to prove infringement of a sound recording copyright are: (1) valid ownership of the copyright; (2) copying of the work by the defendant; and, (3) substantial similarity between the copyrighted work and the allegedly infringing work.<sup>293</sup>

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293. See *Bridgeport Music, Inc. v. Dimension Films* ("Bridgeport I"), 230 F. Supp. 2d 830, 840 (M.D. Tenn. 2002) ("The plaintiff must show, in addition to proof of copying, that the copied work and the allegedly infringing work are substantially similar."), *rev'd*, *Bridgeport Music, Inc. v. Dimension Films* ("Bridgeport II"), 383 F.3d 390 (6th Cir. 2004).

The substantial similarity test consists of a quantitative analysis—the de minimis determination—and a qualitative analysis. Copying is de minimis when the amount taken is so insignificant that the law will not consider it actionable. However, even small segments can have significant value to a work, so the qualitative analysis will almost always be necessary. As the district court stated, substantial similarity exists when “an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.”<sup>294</sup> This ultimately requires both a qualitative and quantitative analysis of the copied segment both in the original work and the new work. The district court, similar to the court in *Ringgold v. Black Entertainment Television*,<sup>295</sup> examined the quantitative and qualitative importance of the copied segment in relation to the original work, as well as the recognizability and prominence of the segment within the new work.

Although this test will require a rigorous analysis by judges and juries, it is more reflective of the language and purpose of the Copyright Act than the bright line rule announced by the Sixth Circuit Court of Appeals. As with most laws, the Copyright Act needs to be updated by Congress to reflect the technological and musical advancements of the past thirty years. Nevertheless, until this occurs the courts must apply the law that exists in the way that it was intended. The district court decision in *Bridgeport I* remained true to the language and purpose of the Copyright Act and should not have been reversed.

#### CONCLUSION

The Copyright Act of 1976 was not written with digital sampling in mind. Consequently, the courts have had much difficulty creating tests that are consistent with the language and purpose of the Act and are predictable and easy to apply. In an attempt to clarify this area of the law, the Sixth Circuit Court of Appeals created a bright-line rule making any sampling of a sound recording a per se infringement. Although this rule is predictable and easy to apply, it is inconsistent with the language and purpose of the Copyright Act. Ultimately, the district court decision, which required the owner of a sound recording copyright to prove unlawful appropriation by

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294. *Id.* at 840 (quoting *Tuff 'N' Rumble Mgmt., Inc. v. Profile Records, Inc.*, 1997 WL 158364 at \*4 (S.D.N.Y. Apr. 2, 1997)).

295. 126 F.3d 70 (2d Cir. 1997).

demonstrating substantial similarity, is the correct interpretation of the law as it is written. The substantial similarity test provides protection against the copying of significant portions of a copyrighted work while allowing insignificant copying that will ultimately benefit the general public in the form of new original works.