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### A Global Perspective on Digital Sampling

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## A GLOBAL PERSPECTIVE ON DIGITAL SAMPLING

*Loren E. Mulraine\**

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### ABSTRACT

*The state of the law in the United States is complicated by the fact that the de minimis doctrine is, and has been a muddled doctrine. Copyright law and patent law allow future authors and inventors to build upon the works of previous rights holders. In the patent world, the new work must be a non-obvious improvement on the original patent. In copyright, the key is that the secondary user cannot take a substantial portion of the prior author's copyrightable expression. There is no infringement without substantial similarity. By definition, a de minimis*

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*taking is the polar opposite of substantial similarity. Nonetheless, the courts do not provide a clear guideline as to when a taking advances beyond de minimis to a substantial taking. This creates a significant challenge for those who are in the creative industries and may have opportunity to use copyrighted works in the process of creating new works. For example, filmmakers and documentary producers are often unsure of what they can and cannot use in an incidental manner in the background of their films. When courts look at the de minimis question, they focus on whether the alleged taking was too much of the existing work as well as whether the taking was of protected or unprotected elements of the existing work.*

*As to the question of how much is too much, it is a matter of degree. As we see in copyright law, there are times that the application of the statute will be affected by the actual classification of the work that is allegedly being infringed. Of course, the digital sampling issue specifically revolves around sound recordings. Two major cases in different circuits have undertaken the question of whether a quantitatively insignificant digital sample of a sound recording could avoid copyright infringement liability by claiming a de minimis defense. The sixth and ninth circuits have come to divergent conclusions on this question. But this is much more than an issue of a circuit split – digital sampling, and more specifically the legal treatment it receives is a global issue.*

*Over the years, digital samples have been used in a myriad of ways. Some examples include the rapid fire multiple-sample collages that were popularized by the likes of Public Enemy producer Hank Shocklee; the short distinctive samples used as musical punctuation by Teddy Riley; the extensive samples used as the loop for entire songs by producers like Sean Combs; and the use of short sampled segments manipulated by pitch and key to create musical soundscapes for popular songs. In some cases, it is clear that the underlying work is a significant element in the new song. However, in other cases, the amount used is extremely short, or the sample has been transformed in such a significant way as to be unrecognizable. This article looks at the development of the law, in the United States and around the globe as it responds to the increased use of digital samples in recorded music. Ultimately, the suggested approach is one where the use of sound recordings is treated similarly to the use of musical motifs in songs, i.e., if the use is de minimis, it should be classified as an exception to copyright infringement or considered a fair use. On the other hand, if the use is one that is recognizable by the lay observer, one that would negatively affect the market of the original, and one that does not survive the scrutiny of fair use analysis, then the use should require a license from*

*the copyright owners.*

The Merriam-Webster Dictionary defines *de minimis* as lacking significance or importance: so minor as to merit disregard.<sup>1</sup>

*De minimis non curat lex*—the law does not concern itself with trifles.

## I. INTRODUCTION

On any given hot summer weekend in the mid-1970s in the Bronx, New York, teenagers and young adults would gather in city parks for the ultimate street party. The same parks which served as cathedrals for playground basketball were seamlessly transformed into inner city dancefloors, landscaped by chained-net basketball rims and graffiti decorated walls, that vibrated with the funk, soul, and dance hits of the era. The hits were spun on dual turntables (the *ones and twos*) by the maestros of the street parties, known as dee jays (DJs) and emcees (MCs). Like orchestral conductors waiving batons to cue philharmonic orchestras, these dee jays and emcees knew how to rock the party, i.e., keep the music pumping and the crowds jumping song, after song, after song. Their skills in mixing songs from turntable to turntable included the ability to manipulate dual copies of the same record so as to create longer dance breaks, i.e., instrumental sections of the records. These *breaks* eventually evolved to serve as the beat over which the emcees created freestyle rhymes, and a musical genre, hip-hop<sup>2</sup> was born. The dee jays became legendary, led by pioneers such as Kool Herc,<sup>3</sup> who is credited with being the first to mix records in this manner in a park in the Bronx in August 1973; Grandmaster Flash,<sup>4</sup> who mastered the technique of

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1. *De minimis*, MERRIAM WEBSTER, [https://www.merriamwebster.com/dictionary/de%20minimis?utm\\_campaign=sd&utm\\_medium=serp&utm\\_source=jsonld](https://www.merriamwebster.com/dictionary/de%20minimis?utm_campaign=sd&utm_medium=serp&utm_source=jsonld) [https://perma.cc/F3VB-F7TK].

2. While the terms *hip-hop* and *rap* are not always completely synonymous, for the purposes of this article, the author will use these terms interchangeably.

3. Clive Campbell, a.k.a DJ Kool Herc, was born on April 16, 1955 in Jamaica and was raised in the Bronx, New York. Campbell is credited with helping originate hip-hop music in the early 1970s in the Bronx, New York. He isolated the instrumental portion of the records, emphasizing the drum beat or *the break* and switched from one break to another on his turntables. Kool Herc is recognized as the first to use this method at an outdoor party in the Bronx on August 11, 1973.

4. Born in Barbados in 1958, Joseph Saddler, a.k.a Grandmaster Flash was raised in the Bronx, New York. Saddler started DJing as a teen and earned the nickname *Flash* for his quick hands. In the early 1980s, his band Grandmaster Flash and the Furious Five, which included iconic MC Melle Mel (Melvin Glover), Keef Cowboy (Robert Keith Wiggins), The Kidd Creole (Nathaniel Glover, Jr., Melle Mel's brother), Mr. Ness/Scorpio (Eddie Morris), and Rahiem (Guy Todd Williams) released several groundbreaking rap records which included songs such as *The Message*. In 2007, they became

manipulating the records by hand, seamlessly keeping the beat moving without interruption, who was also the inventor of the *wafer* or slipmat;<sup>5</sup> and Afrika Bambaataa,<sup>6</sup> founder of the Zulu Nation and generally regarded as the third pioneer in this revolutionary movement. While this list is not exhaustive, other DJs who are universally recognized as leading this transformative musical movement included Grand Wizzard Theodore,<sup>7</sup> Coke La Rock,<sup>8</sup> Grandmaster Caz,<sup>9</sup> and DJ Kool.<sup>10</sup> The

the first rap group inducted into the Rock and Roll Hall of Fame.

5. Grandmaster Flash knew he had to remove the rubber matting that came with commercial turntables because it caused too much friction when he tried to move the vinyl records back and forth on the turntable. Since beneath the rubber mat was a metal surface, he could not put the records on that surface without risking damage to the records. Ultimately, he experimented by cutting out a circular piece of fabric the size of the 12-inch vinyl records from the collection his seamstress mother used. He then took the fabric, doused it with spray starch and ironed it at a very high temperature, ultimately creating a thick, slick piece of material that would sit on the turntable between the vinyl record and the metal surface. Flash called this a “wafer” because it reminded him of the wafer that was given out in church communion services. This slick piece of material later became known as the slipmat. Flash, along with DJ Kool Herc and Afrika Bambaataa, pioneered the art of break-beat deejaying—the process of remixing and thereby creating a new piece of music by playing vinyl records and turntables as if they were musical instruments.

6. Born on April 17, 1957, in the Bronx, New York, to Jamaican and Barbadian immigrants, Lance Taylor, a.k.a Afrika Bambaataa, was inspired by DJ Kool Herc and Kool DJ Dee. Bambaataa began hosting hip-hop parties beginning in 1976. A former member of the Black Spades gang, Bambaataa had a transformation after winning an essay contest that provided him with a trip to Africa. He returned with a desire to create a cultural organization that would be a positive influence on the community and formed the Bronx River Organization as an alternate to the Black Spades. His organization morphed into the Zulu Nation, which was a group of socially and politically aware rappers, B-boys, graffiti artists, and other hip-hop artists. Bambaataa released a series of genre-defining electro tracks in the 1980s that influenced the development of hip-hop culture. His breakthrough commercial hit was 1982’s *Planet Rock*.

7. Theodore Livingston, a.k.a Grand Wizzard Theodore, was born March 5, 1963, in the Bronx, New York. He is widely credited as the inventor of the scratching technique. In addition to scratching, he achieved renown status for his mastery of needle drops and other techniques which he invented or perfected. He apprenticed under Grandmaster Flash. His phrase “Say tum it up” from his track *Fantastic Freaks at the Dixie* was sampled by hip-hop and rap acts, such as Public Enemy on their track *Bring the Noise*.

8. Coke La Rock, a.k.a Coco La Rock, was born April 25, 1955, in the Bronx, New York, and is often credited as being the first MC in the history of hip-hop. He partnered with DJ Kool Herc and was an original member of Herc’s MC crew, the Herculoids.

9. Curtis Fisher was born April 18, 1961, in the Bronx, New York, and he is known by both Grandmaster Caz and Cassanova Fly. After first being exposed to rap in 1974 at a Kool Herc block party, he teamed with DJ Disco Wiz under the name Cassanova Fly to form one of the first DJ Crews, Mighty Force. Caz was also the first rapper to perform both DJ and MC duties. In the late 1970s, he joined The Cold Crush Brothers. He is cited as an influence by the likes of Will Smith, Rakim, Big Daddy Kane, Jay-Z, and Cory Gunz.

10. John W. Bowman, Jr., born in 1958 in Washington, DC, is an early pioneer of the hip-hop and go-go genres. His biggest hit, *Let Me Clear My Throat* is a quintessential example of the reach of sampling. The song begins with a sample of Kool and the Gang’s *Hollywood Swinging* and prominently features a sample of *The 900 Number* by The 45 King, a song that featured a sample from Marva Whitney’s *Unwind Yourself*.

emcees, also known as rappers, became stars in their own rights. When the Sugar Hill Gang recorded and released *Rapper's Delight*<sup>11</sup> in 1979, utilizing Chic's number one hit *Good Times*<sup>12</sup> as the beat, a new commercial reality dawned in recorded music. It took years for the established record industry to recognize this musical genre as a legitimate commercial artform. Most gatekeepers and music critics were thoroughly convinced that hip-hop and rap music would quickly go the way of all mortal flesh and become a footnote in musical history. With major labels refusing to recognize the viability of this new artform, entrepreneurs such as Russell Simmons<sup>13</sup> were able to seize the day and build musical empires that relied entirely on this new cultural phenomenon. Eventually, after breakthrough hits by Kurtis Blow,<sup>14</sup> Grandmaster Flash and the Furious Five,<sup>15</sup> Kool Moe Dee,<sup>16</sup> the Beastie Boys,<sup>17</sup> and Run DMC<sup>18</sup>—

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11. *Rapper's Delight* by the Sugar Hill Gang was one of the first commercial rap songs to experience crossover success. The song peaked at number 4 on the U.S. Hot Soul Singles in December 1979 and number 36 on the Billboard Hot 100 chart in January 1980.

12. *Good Times* was written and produced by Nile Rodgers and Bernard Edwards and performed by their band, CHIC. The song hit number one on the Billboard pop and R&B charts in August 1979 and became the band's second number one pop hit after *Le Freak*.

13. Russell Simmons founded Rush Productions in the early 1980s and managed Run D.M.C. and Kurtis Blow. In 1984, Simmons met Rick Rubin, a student at NYU who was a rap and rock producer. Together they launched Def Jam Records. The label's first single was *I Need a Beat* by LL Cool J, followed by *Rock Hard* by the Beastie Boys. The success of these two singles earned Def Jam a distribution deal with CBS Records, and the rest is history.

14. Kurtis Blow signed Rap's first record deal when he was just 20 years old. Among his list of firsts, Blow was the first rapper to sign to a major label; earned the first Gold record for rap for his hit *The Breaks*; first rapper to tour U.S. and Europe (with the Commodores in 1980); first rapper to record a national commercial (Sprite); first rapper to use the drum machine, sample, and sample loop; first rap music video ("Basketball"); first rap producer (Rap's producer of the year in 1983–85); first rapper featured in a soap opera ("One Life to Live"); and first rap millionaire.

15. Formed in the South Bronx, Grandmaster Flash and the Furious Five were one of the first rap posses, responsible for such masterpieces as *The Message*, *Grandmaster Flash on the Wheels of Steel*, *New York, New York*, and *White Lies*. The combination of Grandmaster Flash's turntable mastery and the Furious Five's raps, which ranged from socially conscious to frivolously fun, made for a series of 12-inch records that forever altered the musical landscape.

16. A member of one of the original hip-hop crews, Treacherous Three, Kool Moe Dee later became a solo star in his own right in 1986 by teaming with a teenaged Teddy Riley (later famed as the king of new jack swing) on the crossover hit *Go See the Doctor*. He later signed with Jive Records and recorded three successful late '80s albums. His biggest commercial hit was 1987's *How Ya Like Me Now*. He also worked on the *Self-Destruction* record with KRS-One's Stop the Violence Movement, as well as Quincy Jones's all-star project *Back on the Block*, which united hip-hop stars with their musical forebears.

17. The Beastie Boys were a rap/rock band from New York City, formed in 1979. Their original lineup consisted of Michael "Mike D" Diamond (vocals, drums), Adam "MCA" Yauch (vocals, bass), and Adam "Ad-Rock" Horovitz (vocals, guitar). After releasing a couple of experimental hip-hop singles, they toured with Madonna in 1985 and released their debut album *Licensed to Ill* in 1986. The Beastie Boys have sold 26 million records in the United States and 50 million records worldwide.

18. Bursting onto the scene from Hollis Queens, New York, Run D.M.C.—Darryl "DMC"

the first artists to commercially merge rap with the rock genre,<sup>19</sup>—the true impact of the genre could not be denied. Hip-hop and rap music were here to stay. The genre exploded throughout the 1980s with the emergence of hit-making artists such as Public Enemy,<sup>20</sup> Melle Mel,<sup>21</sup> Big Daddy

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McDaniels, Jason “Jam Master Jay” Mizell, and Joseph “Rev Run” Simmons—changed the sound of rap music, street fashion, and popular culture in general. Run D.M.C. was a group of firsts. Among their accolades: first rappers on MTV; first rappers on Saturday Night Live; first rappers on the cover of Rolling Stone; and first rappers to win a Grammy Lifetime Achievement Award. They broke down barriers for future rap acts, crossed boundaries between rap and rock, and dispelled old notions of what rap could be. Their approach was stripped-down and spare, and they innovated by rapping over rock beats, even incorporating hard-rock guitar samples on occasion. Their first release, the 12-inch single *It’s Like That/Sucker MCs* was produced by Kurtis Blow and was the first rap single with a hard beat and stripped-down, no-nonsense delivery. Their hits included *My Adidas*, *You Be Illin’*, *It’s Tricky*, *Walk This Way* with Aerosmith, and *Rock Box*.

19. Run D.M.C. collaborated with Aerosmith to rework the band’s hit *Walk This Way* as a combination rap/rock duet. The song was originally released by Aerosmith on their *Toys in the Attic* album in 1975 and peaked at number 10 on the Billboard Hot 100 in early 1977. The remake by Run D.M.C. and Aerosmith became an international hit and won both groups a Soul Train Music Award for Best Rap Single in 1987.

20. Public Enemy was revolutionary. Their blend of politics, philosophy, and rap changed the game for the better. Public Enemy brought an explosion of sonic invention, rhyming virtuosity, and social awareness to hip-hop in the 1980s and 1990s. The group’s high points—1988’s *It Takes a Nation of Millions to Hold Us Back* and 1990’s *Fear of a Black Planet*, stand among the greatest politically charged albums of all time. Public Enemy—Chuck D. (Carlton Ridenhour), Flavor Flav (William Drayton), Terminator X (Norman Lee Rogers), and Professor Griff (Richard Griffin)—came together in 1986 at Adelphi University on Long Island. Among their most successful hit singles was *Fight the Power*, which was the theme song for Spike Lee’s film *Do the Right Thing* (1989).

21. Melle Mel was one of the pioneers of rap as the lead rapper and main songwriter for Grandmaster Flash and the Furious Five. In addition to his hits with Flash, Melle Mel was a hitmaker in his own right and was also featured on the Chaka Khan remake of Prince’s *I Feel for You*, which rose to number 3 on the Billboard Hot 100 and number 1 on the Cash Box singles charts.

Kane,<sup>22</sup> Heavy D & the Boyz,<sup>23</sup> LL Cool J,<sup>24</sup> Doug E. Fresh,<sup>25</sup> Slick Rick,<sup>26</sup> Fab Five Freddy,<sup>27</sup> The Treacherous Three,<sup>28</sup> Boogie Down Productions,<sup>29</sup> KRS-One,<sup>30</sup> Whodini,<sup>31</sup> and others. The major labels

22. Antonio Hardy, born September 10, 1968, better known by his stage name Big Daddy Kane, is a Grammy Award-winning rapper and actor who started his career in 1986 as a member of the rap collective the Juice Crew. He is widely considered one of the most influential and skilled MCs in hip hop. Rolling Stone magazine ranked his song *Ain't No Half-Steppin'* number 25 on its list of the 50 Greatest Hip-Hop Songs of All Time, calling him "a master wordsmith of rap's late-golden age and a huge influence on a generation of MCs."

23. Heavy D, Dwight Errington Myers (May 24, 1967 – November 8, 2011), was a Jamaican-born American rapper, record producer, singer, and actor, as well as the former leader of Heavy D & the Boyz, a hip-hop group which included dancers/backup vocalists G-Whiz (Glen Parrish), "Trouble" T-Roy (Troy Dixon), and Eddie F (Edward Ferrell). The five albums the group released were produced by Teddy Riley, Marley Marl, DJ Premier, Pete Rock, and Eddie F. Heavy D & The Boyz was the first group signed to Upton Records, and they were responsible for diversifying the genre stylistically. Among the group's biggest hits were *Now That We Found Love*, *Nuttin' But Love*, as well as his features on Janet Jackson's hit single *Alright*, and Michael Jackson's hit *Jam*.

24. LL Cool J (Ladies Love Cool James) was born James Todd Smith on January 14, 1968. At the age of sixteen, he was the first rapper signed to Def Jam Records. His hits included *Going Back to Cali*, *I'm Bad*, *The Boomin' System*, *Rock the Bells*, *Mama Said Knock You Out*, *Doin' It*, *I Need Love*, *All I Have*, *Around the Way Girl*, and *Hey Lover*. In recent years, LL Cool J has had great success as an actor including a starring role in NCIS: Los Angeles.

25. Douglas Davis, a.k.a Doug E. Fresh, was born on September 17, 1966, and is known as the Human Beat Box and the pioneer of 20<sup>th</sup> century American beatboxing. Fresh is able to accurately imitate drum machines and various special effects using only his mouth, lips, gums, throat, tongue, and a microphone. He began his career as a solo artist but gained most of his early success as a member of the Get Fresh Crew, which included Barry Bee, Chill Will, and a newcomer named MC Ricky D who would later achieve fame as Slick Rick. Their hits *The Show* and *La Di Da Di* are both considered hip hop classics.

26. Slick Rick, born in London as Richard Martin Lloyd Walters, is a hip-hop icon who has become one of the most sampled hip-hop artists in history. About.com ranked him number 12 on their list of the Top 50 MCs of Our Time. The Source ranked him number 15 on their list of the Top 50 Lyricists of All Time.

27. Fred Brathwaite, born August 31, 1959, a.k.a Fab 5 Freddy, is a visual artist, filmmaker, rapper, and hip-hop pioneer. In the late 1980s, Fab 5 Freddy became the first host of the groundbreaking and first internationally telecast hip-hop music video show, *Yo! MTV Raps*.

28. The Treacherous Three was a pioneering hip-hop group that was formed in 1978 and consisted of DJ Easy Lee, Kool Moe Dee, L.A. Sunshine, Special K, and Spoonie Gee, with occasional contributions from DJ Dano B, DJ Reggie Reg, and DJ Crazy Eddie. Their hit *Body Rock* was one of the first records to mix hip-hop and rock. They also had hits with *At the Party*, *Put the Boogie in Your Body*, and *Feel the Heartbeat*.

29. Boogie Down Productions was a hip-hop group originally composed of KRS-One, D-Nice, and DJ Scott La Rock. The group took its name from a nickname for the Bronx and pioneered the fusion of dancehall reggae and hip-hop music.

30. KRS-One, born Lawrence "Kris" Parker on August 20, 1965, is known by both KRS-One and Teacha. He rose to prominence as part of the hip-hop music group Boogie Down Productions, which he formed with DJ Scott La Rock in the mid-1980s. KRS-One is politically active, having started the Stop the Violence Movement, after the murder of his bandmate Scott La Rock. His hit albums as a solo artist include *Return of the Boom Bap*, *KRS-One*, *I Got Next*, *The Sneak Attack* and others.

31. Whodini is a Brooklyn, New York-based hip-hop group that was formed in 1981. The trio



could no longer deny the viability of this new artform. Hip-hop and rap had arrived, but more importantly, as the genre gained influence in the musical culture, the production techniques that were pioneered by hip-hop and rap producers, including the use of digital samples, began to influence other musical genres.<sup>32</sup> The artists and producers using digital samples, as well as the artists whose recordings were sampled and their respective record companies, had absolutely no idea how to handle the business and legal aspects of this new artistic phenomenon. As the artform has developed over the past thirty-plus years, we have made significant progress with the business issues revolving around sample clearance. However, there is still no consensus on how to treat the legal aspects of digital sampling in the United States or abroad.<sup>33</sup>

Over the years, digital samples have been used in a myriad of ways. Some examples include the rapid fire multiple-sample collages that were popularized by the likes of Public Enemy producer Hank Shocklee;<sup>34</sup> the short distinctive samples used as musical punctuation by Teddy Riley;<sup>35</sup> the extensive samples used as the loop for entire songs by producers like Sean Combs;<sup>36</sup> and the use of short sampled segments manipulated by pitch and key to create musical soundscapes for popular songs.<sup>37</sup> In some

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consisted of vocalist and main lyricist Jalil Hutchins, co-vocalist John Fletcher, a.k.a. Ecstasy, and turntable artist DJ Drew Carter, a.k.a. Grandmaster Dee. Whodini was among the first hip-hop groups to cultivate a high-profile national following for hip-hop music and made significant inroads on urban radio. The group was managed by Russell Simmons. Their many hits included *The Freaks Come Out at Night*, and *Friends*.

32. See August Brown, *Pop Music Study Proves Hip-Hop's Influence; Fans Totally Not Surprised*, LOS ANGELES TIMES (2015), <https://www.latimes.com/entertainment/music/posts/la-et-ms-pop-music-study-hiphop-influence-20150506-story.html> [<https://perma.cc/84W7-VN6N>].

33. See Chris Robley, *Licensing Music: Cover Songs, Samples, and Public Domain*, CMSI (2010), <https://diymusician.cdbaby.com/music-rights/licensing-cover-songs/> [<https://perma.cc/AS6A-V65C>].

34. Hank Shocklee, along with Keith Shocklee, Chuck D, Eric "Vietnam" Sadler, Gary G-Wiz, and Bill Stephney made up the production team known as The Bomb Squad, which rose to prominence with their productions for Public Enemy. The Bomb Squad is noted for its dense, distinct, innovative production style, often utilizing dozens of samples on just one track. They are also known for their unique ability to incorporate harsh, atonal, industrial sounds and samples into their productions. About.com ranked the Bomb Squad number 12 on its Top-50 Hip-Hop Producers list.

35. E.g., The song *No Diggity* by Teddy Riley's group, Blackstreet, featuring Dr. Dre and Queen Pen, prominently features a digital sample of Bill Withers humming on the Withers' hit song *Grandma's Hands*. The song reached number one on the Billboard Hot 100 in 1996 and was ranked at number 91 on Rolling Stone and MTV: 100 Greatest Pop Songs.

36. E.g., *I'll Be Missing You* by Puff Daddy and Faith Evans, featuring 112, was a tribute song recorded in memory of Christopher "The Notorious B.I.G." Wallace after he was murdered on March 9, 1997. The song samples the hit song *Every Breath You Take*, a number one hit from 1983 by The Police. *I'll Be Missing You* spent 11 weeks atop the Billboard Hot 100 during the summer of 1997 and won the Grammy Award for Best Rap Performance by a Duo or Group.

37. E.g., the NWA sample of a guitar lick from Funkadelic's *Get Off Your Ass and Jam* in the

cases, it is clear that the underlying work is a significant element in the new song. However, in other cases, the amount used is extremely short, or the sample has been transformed in such a significant way as to be unrecognizable. This article looks at the development of the law in the United States and around the globe as it responds to the increased use of digital samples in recorded music.<sup>38</sup> Ultimately, the suggested legal approach in this article treats the use of sound recordings similarly to the use of musical motifs in songs, i.e., if the use is *de minimis*, it should be classified as an exception to copyright infringement or considered a fair use. On the other hand, if the use is one that is recognizable by the lay observer, one that would negatively affect the market of the original, and one that does not survive the scrutiny of fair use analysis, then the use should require a license from the copyright owners.<sup>39</sup>

## II. ANATOMY OF A SOUND RECORDING

Sound recording [is] a transcription of vibrations in air that are perceptible as sound onto a storage medium, such as a phonograph disc. In sound reproduction the process is reversed so that the variations stored on the medium are converted back into sound waves. The three principal media that have been developed for sound recording and reproduction are the mechanical (phonographic disc), magnet (audiotape), and optical (digital compact disc) systems.<sup>40</sup>

A more simplified definition: a sound recording is any media on which sound has been recorded and may be played back. The potential for commercial exploitation of the sound recording will rely heavily upon the viability of the underlying collection of sounds that are being recorded. In other words, some sound recordings are inherently more likely to attract a large commercial demand than others. This leads to the inescapable reality that some sound recordings are more valuable than others. This inevitability ties back neatly into the realm of copyright law, where the value of a sound recording is determined by how great the commercial demand may be for the recording.<sup>41</sup> A sound recording may consist of the recording of any type or any combination of sounds or audio signals.

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NWA song *100 Miles and Runnin'* that led to the Bridgeport case.

38. See generally, Adam Behr, Keith Negus & John Street, *The Sampling Continuum: Musical Aesthetics and Ethics in the Age of Digital Production*, J. CULTURAL RES. 21:3, 223–40 (2017).

39. See generally 17 U.S.C. § 107 (2018).

40. Richard E. Berg, *Sound recording*, ENCYCLOPEDIA BRITANNICA <https://www.britannica.com/technology/sound-recording>, [<https://perma.cc/T2M4-XZ39>].

41. See generally *Fair Use and Sound Recordings: Lessons from Community Practice*, CMSI, <http://cmsimpact.org/code/fair-use-sound-recordings/> [<https://perma.cc/XE75-H4V4>].

Sound recordings that consist of sounds in nature may create wide-ranging commercial value based on a number of variables including the quality of the sound, the rarity of the sound, or the unique arrangement of the sounds. For example, a sound recording of a single dog barking may have limited value. That same recording, when digitally manipulated to create the full spectrum of musical pitches, or a recording of varied dogs who bark at different musical pitches may have greater value if those barking sounds are edited into a sound recording where the dogs are performing *Jingle Bells*.<sup>42</sup> What is described here can be considered the precursor to our modern-day proliferation of digital sampling. While a sound recording may or may not be musical in nature, the analysis presented in this article will focus on sound recordings that consist of musical works.

One thing is clear, musical sound recordings cannot exist without songs. With this in mind, a general understanding of the songwriting process and how it has evolved over the years would be useful. Of course, this process has changed dramatically from Beethoven to the Beatles<sup>43</sup>, from Handel's *Messiah* to Pharrell's *Happy*,<sup>44</sup> and logically, the way we view the process *vis-a-vis* the legal framework should also evolve. Musical eras are generally categorized as follows: the Renaissance era (circa 1400 – circa 1600); Baroque (circa 1600 – circa 1750); Classical (circa 1750 – circa 1830); Early Romantic (circa 1830 – circa 1860); Late Romantic (circa 1860 – circa 1920); and the Post *Great War* Years or twentieth and twenty-first century (circa 1920 – present).<sup>45</sup>

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42. The Singing Dogs was the creation of a Danish ornithologist named Carl Weismann, a pioneer in bird song recording. He was often chased by dogs from private property as he was completing his recording of bird sounds. One day as Weismann was editing out the dog barks from his tape, he decided to splice them together and tweak the speed of the tape to create the full scale of musical notes. Ultimately, Weismann arranged the barks in tune, pitch, and time to create a sound recording of the dogs barking or “singing” *Jingle Bells*. The Singing Dogs hit number 22 on the Billboard chart in 1955 and was re-released in 1971 when it hit the charts again. It has been a Christmas radio staple ever since.

43. Ludwig van Beethoven (1770–1827) composed during the transition from classicism to romanticism. The Beatles, formed in Liverpool in 1960 and consisting of John Lennon, Paul McCartney, George Harrison, and Ringo Starr, are largely recognized as one of the most influential rock bands of the 20th century. The Beatles were international stars and key players in the “British Invasion” of bands who made a mark on the U.S. music industry in the mid-1960s.

44. Georg Friedrich Handel (1685–1759) was one of the most influential composers of the Baroque era. His most famous work, Handel's *Messiah* is still among the most popular choral and symphonic works performed today. Pharrell Williams is a songwriter, musician, producer, and recording artist who has earned 11 Grammy Awards (including Producer of the Year non-classical in the 2019 Grammy Awards), an Academy Award nomination, and numerous other critical and commercial accolades over the past 25 years.

45. *History of Classical Music*, NAXOS RECORDS, [https://www.naxos.com/education/brief\\_history.asp](https://www.naxos.com/education/brief_history.asp) [<https://perma.cc/U6XP-MZRM>].

There are vast differences between the manner in which music was composed hundreds of years ago as compared with modern composition. Ludwig van Beethoven<sup>46</sup> straddled the Classical and Romantic eras in Classical music and is among the most influential composers and pianists in musical history. Beethoven described his creative process in this way:

I carry my thoughts about with me for a long time, sometimes a very long time, before I set them down. At the same time my memory is so faithful to me that I am sure not to forget a theme which I have once conceived, even after many years have passed. I make many changes, reject and reattempt until I am satisfied. Then the working-out in breadth, length, height, and depth begins in my head, and since I am conscious of what I want, the basic idea never leaves me. It rises, grows upward, and I hear and see the picture as a whole take shape and stand forth before me as though cast in a single piece, so that all that is left is the work of writing it down. This goes quickly, according as I have the time, for sometimes I have several compositions in labor at once, though I am sure never to confuse one with the other. You will ask me whence I take my ideas; That I cannot say with any degree of certainty; they come to me uninvited, directly or indirectly. I could almost grasp them in my hands, out in Nature's open, in the woods, during my promenades, in the silence of the night, at earliest dawn. They are roused by moods which in the poet's case are transmuted into words, and in mine into tones, that sound, roar and storm until at last they take shape for me as notes.<sup>47</sup>

Beethoven began to lose his hearing at the age of twenty-eight<sup>48</sup> but continued to compose. In fact, his works gained additional complexity as his hearing diminished. Beethoven relied on sketches and drafts of his musical works in progress, often generating hundreds of pages of sketches. He was known to make late corrections and improvements to scores that were presumably complete. This entire process was a painstaking one that relied on the musical expression being captured and memorialized on musical staff paper to exacting and precise specifications.

By contrast, modern day pop songwriters are much more likely to be driven by the groove, the vibe, the emotional response that inevitably

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46. Beethoven was born in 1770 and died in 1827.

47. Meredith William, *Beethoven's Creativity: His Views on the Creative Process*, QUESTIA (1987), <https://www.questia.com/library/journal/1P3-1533062421/beethoven-s-creativity-his-views-on-the-creative> [<https://perma.cc/T2EL-F86F>].

48. Mack Hicks, *Ledwig van Beethoven's Biograraphy*, LVBEETHOVEN, <http://www.lvbeethoven.com/Bio/BiographyDeafness.html> [<https://perma.cc/TF5U-8ZU6>].

accompanies the choices of sounds or instruments. For example, Pharrell Williams<sup>49</sup> says of his songwriting process

There are different ways of doing it. For me, I want to chase after a feeling, something that just feels good. And from there, lyrically, the music just sort of sets the template for the words. The feeling directs all creativity. The beat comes first. My job is just to listen to it, and let it tell me what should be fed lyrically, where the drums should go, where the melodies should go. It's all by feel.<sup>50</sup>

By the mid-twentieth century, we had transitioned from classical music being the dominant genre, and live orchestra and big band performances being the primary source of sharing music, to a period where show tunes were popular, blues and jazz styles were introduced, and the delivery method of music began evolving from the live stage to the broadcast airwaves.<sup>51</sup> This transition was made possible by the development of the sound recording. Alongside the advancement of the sound recording, technology led to the development of electronic instruments, the most important of which was the electric guitar,<sup>52</sup> and later electronic keyboards and synthesizers.<sup>53</sup> Originally developed as a means to amplify guitars in the big band setting, electric guitars eventually spawned the most significant musical transition in hundreds of years as

49. Pharrell Williams is a multi-instrumentalist, singer, and producer who has written and produced for the likes of Daft Punk, Gwen Stefani, Jay-Z, Justin Timberlake, Kelis, Kendrick Lamar, Pusha T, Robin Thicke, Snoop Dogg, T.I., Teddy Riley, Usher, and many others.

50. Ben Sin, *Pharrell Williams interview*, TIME OUT, <https://www.timeout.com/kuala-lumpur/music/pharrell-williams-interview> [<https://perma.cc/9R2N-4M4L>].

51. See generally *History of the Record Industry, 1920-1950's Part Two: Independent labels, Radio, and the Battle of the Speeds*, MEDIUM (2014), <https://medium.com/@Vinylmint/history-of-the-record-industry-1920-1950s-6d491d7cb606> [<https://perma.cc/Y5CK-VYGU>].

52. Patents as early as the 1910s show telephone transmitters were adapted and placed inside violins and banjos to amplify the sound. With many hobbyists and inventors experimenting with electrical instruments in the 1920s and early 1930s, there are many claimants to have been the first to invent an electric guitar. All these initial instruments were originally designed by acoustic guitar makers. The first electrically amplified guitar was designed in 1931 by George Beauchamp, the general manager of the National Guitar Corporation, and Paul Barth, the company's vice president. Beauchamp and Barth partnered with Adolph Rickenbacker to launch commercial production of the instrument in the summer of 1932. The company was eventually renamed from their initial Electro-Patent-Instrument Company to Rickenbacker. Les Paul is among the inventors credited with creating and popularizing the first solid body electric guitar, his first model was called "the log" reflecting its solid body construction. His eponymous guitar, the Les Paul, remains one of the most popular instruments in music history and is a cornerstone of the Gibson Guitar company.

53. Robert Moog is considered the father of the modern synthesizer. Moog was an electrical engineer who dabbled in building electronic instruments. In the early 1960s, he developed the first commercially available synthesizer, the Moog 900 Series Modular Systems, which resembled towering mainframe computers with a spider web of cables that patched the various modules together to create a complete sound, which could be sequenced or played in real time.

musical styles adapted to birth what we now call *the rock era*.<sup>54</sup> This transition also had a major impact on how musicians learned songs and created new music. While many rock era musicians were classically schooled or formally trained in reading music and music theory, the process of learning rock songs often is one that is achieved through studious listening and practicing with popular recorded songs until the musicians can reproduce the chords, progressions, and solos.<sup>55</sup> This is not to say that many of these rock musicians did not receive formal training from other musicians and teachers. However, as a general modus operandi, these modern musicians typically moved away from the classical approach of composition and gravitated to the manner in which blues, jazz and country, or bluegrass musicians often created their musical works, i.e., by jamming with other band members and capturing the basic song progression either on tape or by writing down basic chord charts, as opposed to specific notes and rests as earlier classical musicians had done with traditional musical transcription.<sup>56</sup>

Fast-forward to the late twentieth and early twenty-first century and we see electronic music production and songwriting becoming the predominant method of creating songs in pop, R&B, dance (or EDM), and hip-hop music, as well as gaining increased prominence in rock and country music as producers use the editing functions of digital audio workstations<sup>57</sup> to create songs and sound recordings. In addition to the proliferation of keyboard synthesizers, digital samplers were introduced, providing an easy method for capturing sounds and integrating them into musical compositions and productions. Digital samplers allow users to

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54. The Rock Era is generally regarded as beginning in the mid-1950s with the first big “rock n’ roll” hit being Bill Haley & His Comets version of the song *Rock Around the Clock* written by Max C. Freedman and James E. Myers. *Rock Around the Clock* hit number one on both the United States and United Kingdom charts.

55. See generally Billy Cadden, *Four Apps That Will Help You Learn To Play Music*, POPULAR SCIENCE (2018), <https://www.popsi.com/best-apps-music-learning> [<https://perma.cc/CS6Y-UG9X>].

56. An example of this process is found in the notes of the case *Selle v. Gibb*, 741 F.2d 896 (7th Cir. 1984), where the BeeGees were sued for copyright infringement for the song *How Deep Is Your Love*. The Brothers Gibb were able to demonstrate the method in which they created their songs by producing working tapes from the recording studio where they sketched out musical ideas and settled on progressions and melodies that they liked and later added lyrics to the compositions. Like many popular artists of the day, the brothers did not read music, but created by ear and captured their creations on tape as they worked on their songs. In spite of the fact that the two songs in question were substantially similar, the Brothers Gibb were able to avoid liability for infringement due to the fact that they proved independent creation, and there was no access to the plaintiff’s song.

57. Digital audio workstations, or DAWs, are electronic devices and software used for recording, editing, and producing audio files. The most popular of these DAWs include ProTools, Logic Pro, Presonus, Ableton Live, ACID Pro, Cubase, Nuendo, Reason, and Reaper, just to name a few. DAWs are the predominant means of creating sound recordings in the twenty-first century.

make a digital recording or copy of a sound, be it a glass shattering, a bird chirping, or a clip from an existing sound recording, and then manipulate and utilize that sound in a new, perhaps transformative, manner. Today it is exceedingly rare to see songwriters creating musical works by writing note for note, and rest for rest, on staff paper. Virtually all modern popular music is memorialized on tape and or a digital file.<sup>58</sup> The digital recording of these musical pieces gives the creators great flexibility with regard to making edits, changing keys, tempos, adding and subtracting song sections, and moving sections from one place to another within the musical piece. In this regard, digital music production is similar to writing a literary document, presentation, or spreadsheet using Word, PowerPoint, or Excel. The use of digital musical samples in a sound recording is analogous to utilizing a passage from an existing publication in a new literary work, inserting data from an existing chart into a new Excel spreadsheet, or inserting a copyrighted picture or graphic into a PowerPoint presentation. While a literary author, for example the creator of a 20-page children's book, would have a cause of action if another literary author were to utilize significant portions of their work to create a competing work, the original author would not have a cause of action if *de minimis* portions of the work were used and the use had no deleterious effect on the original works. Perhaps when we look back at this era that has been spawned by these new tools and methods for creation, we will say "it was the best of times, it was the worst of times."<sup>59</sup>

### III. DE MINIMIS AND FAIR USE AS DEFENSES TO COPYRIGHT INFRINGEMENT

Constitutional support for granting exclusive rights to authors is found in the language of Article I, Section 8, Clause 8 of the U.S.

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58. See Justin Williams & Katherine Williams, *Composing with the Digital Audio Workstation*, in THE SINGER-SONGWRITER HANDBOOK, 77 (2017).

59. Charles Dickens, *A Tale of Two Cities*, originally published in 1859 is obviously in the public domain now, but were it still protected by copyright, there would be certain limitations on how it could be used. This opening line from the Charles Dickens novel *A Tale of Two Cities* is an example of one of the most popular introductions in modern literature. I have used only a miniscule portion of the book, and a very small portion of the opening paragraph of the book, I have used it in a non-commercial manner, and its use has no deleterious effect upon the underlying work. It would be legally problematic if, on the other hand, I was authoring a novel and I chose to use the entire paragraph to start my novel, i.e., "It was the best of times, it was the worst of times, it was the age of wisdom, it was the age of foolishness, it was the epoch of belief, it was the epoch of incredulity, it was the season of Light, it was the season of Darkness, it was the spring of hope, it was the winter of despair, we had everything before us, we had nothing before us, we were all going direct to Heaven, we were all going direct the other way."

Constitution, which grants Congress the right “To promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors, the exclusive Right of their respective Writings and Discoveries.”<sup>60</sup>

In the context of copyright law, the *de minimis* concept can be applied in three respects: the first application involves a technical violation so trivial that the law will not impose legal consequences.<sup>61</sup> The second involves a copying which has occurred to such a trivial extent that it does not constitute actionable copying.<sup>62</sup> The third application occurs in an analysis of “the amount and substantiality of the portion used in relation to the copyrighted work as a whole” as the third of four considerations in a fair use determination.<sup>63</sup> Among these three options, the second application, a copying which has occurred to such a trivial extent that it does not constitute actionable copying, is a seamless fit for digital sampling cases where the use is qualitatively and quantitatively miniscule.

In *Ringgold v. Black Entertainment Television*,<sup>64</sup> the Second Circuit Court of Appeals, during its analysis of *de minimis* copying, stated that the proper inquiry is whether the copying is qualitatively as well as quantitatively sufficient to support a legal conclusion that actionable copying has occurred; in other words, that there has been infringement. In copyright law, *de minimis* copying occurs when one party copies a portion of copyrighted work owned by another, but the significance of the copying is so trivial that there is no remedy at law.<sup>65</sup> If the copying is *de minimis* and thus so trivial as to fall below the quantitative threshold of substantial similarity, the copying is not actionable, i.e., it is not an unlawful copying.<sup>66</sup> In determining whether a copying is *de minimis*, the courts look at the amount of copyrighted work that is copied and how prominent a role it plays in the defendant’s work. This article explores whether a *de minimis* classification should be available for the legally defined insignificant uses of sampled sound recordings. Two federal courts, the sixth circuit and the ninth circuit, have arrived at divergent conclusions

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60. U.S. CONST. art. I, § 8, cl. 8.

61. DONALD S. CHISUM, TYLER T. OCHOA, SHUBHA GOSH & MARY LA FRANCE, UNDERSTANDING INTELLECTUAL PROPERTY LAW 395 (2d ed. 2015).

62. *Id.*

63. *Id.*

64. *Ringgold v. Black Entm’t Television, Inc.*, 126 F.3d 70 (2d Cir. 1997).

65. Andrew Inest, *A Theory of De Minimis and a Proposal for Its Application in Copyright*, 21:2 Berkeley Tech. L.J. 957 (2006).

66. ROBERT BRAUNEIS & ROGER E. SCHECHTER, COPYRIGHT: A CONTEMPORARY APPROACH 260 (2012).



with regard to this question.<sup>67</sup> Internationally, the courts appear to be more progressive in addressing this matter. It is important for us to look beyond our borders and to establish a global perspective on the issue of sampling, as well as address the circuit split. Ultimately, this article should provide the reader with a solid understanding as to whether a quantitatively insignificant sample of a copyrighted sound recording may be treated as a *de minimis* copying free from copyright ramifications, or whether regardless of its quantitative insignificance the sample should be treated as an unlawful copying and an infringement of copyright.

Historically, the law of intellectual property has forever been in hot pursuit of technological advances which give birth to new categories of creative works. The initial statute governing copyright in the United States, the Copyright Act of 1790,<sup>68</sup> protected only maps, charts, and books.<sup>69</sup> As technology advanced, the Act was subsequently amended to include prints,<sup>70</sup> musical compositions (not including public performance until 1897),<sup>71</sup> dramatic compositions (with public performance rights),<sup>72</sup> photographs,<sup>73</sup> and finally paintings, drawings, sculpture, models, and designs.<sup>74</sup> The legal ownership in these works enured to the creator of the works immediately upon the satisfaction of the statutory formalities of registration, recordation, publication, and deposit.<sup>75</sup>

While songs have been protected by federal statute since 1831,<sup>76</sup> sound recordings did not enjoy federal protection until February 15, 1972, when the Sound Recording Act of 1971<sup>77</sup> granted federal copyright protection to sound recordings.<sup>78</sup> This statute expressly made the federal

67. *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792 (6th Cir. 2005); *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871 (9th Cir. 2016).

68. Copyright Act of 1790, 1 Stat. 124, 1 Cong. Ch. 15.

69. *Id.*

70. Prints were added in 1802. 1802 Amendment (1802), *Primary Sources on Copyright (1450-1900)*, COPYRIGHTHISTORY, www.copyrighthistory.org [https://perma.cc/VQH8-QXH5].

71. Musical compositions were added in 1831. 4 Stat. 436, 21 Cong. Ch. 16.

72. Dramatic compositions were added in 1856. Copyright Act Amendment, Washington D.C. (1856), *Primary Sources on Copyright (1450-1900)*, eds L. Bently & M. Kretschmer, www.copyrighthistory.org [https://perma.cc/3TES-EZ2L].

73. Photographs were added to the Act in 1865. *See id.*

74. Paintings, drawings, sculpture, models, and designs were added in 1870. 16 Stat. 198, 41 Cong. Ch. 230.

75. Specific formalities for registration under the 1790 Act included recording title prior to publication in a district court; publishing copy of record in a newspaper for 4 weeks; and depositing a copy with the Secretary of State within 6 months.

76. 4 Stat. 436, 21 Cong. Ch. 16.

77. Pub. L. No. 92-140, § 3, 85 Stat. 391, 392 (1971).

78. As early as 1909, record labels sought relief from Congress in the form of legislation amending the copyright law to allow federal protection of sound recordings. A series of bills introduced in 1912, 1925, 1926, 1928, and 1930 all contained provisions for copyright of sound recordings.

protection of sound recordings applicable only to sound recordings fixed on or after February 15, 1972, while preserving the existing state-law protection for sound recordings fixed before that date.<sup>79</sup> Sound recordings created prior to February 15, 1972 continue to be protected by the common law of the applicable states.

Phonorecords have been around in some form or another since before the turn of the twentieth century.<sup>80</sup> One of the most significant changes in twentieth century copyright law occurred with the mechanical licensing provision of the Copyright Act of 1909.<sup>81</sup> The impetus of this provision was the introduction and growing proliferation of player pianos. Also known as pianolas,<sup>82</sup> these self-playing pianos included pre-programmed recordings of popular songs that were recorded on perforated paper<sup>83</sup> or a

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In each case, Congress failed to pass the bill. Starting in 1932, the National Association of Broadcasters, in an effort to protect the bottom lines of their members, began their forceful opposition of any legislation advocating for federal protection of sound recordings. The corporate interests and strong lobbying efforts of the NAB have unfortunately carried a level of sway that disproportionately affects copyright owners in a negative manner. Subsequently, sound recording copyright owners have found themselves in the untenable situation of not being paid for the use of their works while other artists enjoy protection and receive an economic benefit for essentially identical uses. To observe the imbalance of the current state of the law, we need only consider any artist who released recordings in both 1971 and 1972. Marvin Gaye, for example, released his classic recording *What's Going On* on May 21, 1971. *What's Going On* was his first foray into using music for social commentary and social justice and included the timeless hits *What's Going On*, *Mercy, Mercy Me*, and *Inner City Blues* among others. This project was one of the early concept albums consisting of songs that segue into each other and tell a story from the point of view of a Vietnam veteran returning home to find his home reflecting hatred, suffering, and injustice. *What's Going On* is regarded as one of the landmark recordings in pop music history and was ranked number six on Rolling Stone magazine's 2003 list (and subsequent updated list in 2012) of the 500 Greatest Albums of All Time. The album reached number 1 on the Billboard R&B Albums chart and number 6 on the Billboard Hot 200 pop albums chart. His follow-up album, *Trouble Man* was released on December 8, 1972. The Gaye estate currently does not receive sound recording royalties for the digital audio transmission of the songs from *What's Going On*, while they would receive royalties for *Trouble Man*, released a mere 19 months later. While the incongruity of pre-1972 sound recordings having their protection determined by a hodgepodge of state law is worthy of greater discussion, it is beyond the scope of this particular article. It should be noted, however, that the Copyright Office has recommended that Congress extend federal protection to pre-1972 sound recordings. The proposed legislation would give these works copyright protection for 95 years from the date of publication, or 120 years from the date of fixation if the work is not published before the legislation's effective date.

79. ROBERT BRAUNEIS & ROGER E. SCHECHTER, COPYRIGHT: A CONTEMPORARY APPROACH, 987 (2d ed. 2018). See also, Sound Recording Act of 1971 § 3, 92 Pub. L. 140, 85 Stat. 391, 392 (1971).

80. GEOFFREY P. HULL, THE RECORDING INDUSTRY, 45 (2d ed. 2004).

81. 60 P.L. 349, 35 Stat. 1075, 60 Cong. Ch. 320.

82. In 1863, the Frenchman Henri Fourneaux invented the player piano and called it "Pianista."

83. The perforated or punched paper rolls for the first Pianola were made by a technician perforating the paper after it was marked up in pencil using the original music score. The music sounded lifeless due to the lack of expression. Later, roll recording pianists used a special recording piano that marked the paper as the music was played. This allowed some expression such as tempo and phrasing

metallic roll installed into the console of these upright pianos.<sup>84</sup> Congress agreed that the copyright owners of the songs should be paid a statutory license fee each time their compositions were mechanically reproduced on these piano rolls. The mechanical license and the required statutory mechanical license fee<sup>85</sup> have endured throughout the recording industry's journey from player piano rolls, to shellac discs,<sup>86</sup> vinyl recordings (33 1/3 rpm and 45 rpm records),<sup>87</sup> 8-track tapes,<sup>88</sup> audio cassettes,<sup>89</sup> compact discs,<sup>90</sup> and today's digital delivery formats.<sup>91</sup>

It is important to note that there are two separate copyrights invoked in the use of a modern-day sound recording. Specifically, there is the copyright in the underlying song,<sup>92</sup> as well as a separate copyright in each

to be built-in.

84. The heyday of the player piano lasted from 1900 to the Depression in the late 1930s when they were eclipsed by affordable radios.

85. The statutory rate was originally 2 cents per copy and remained at that rate from 1909–1976. When the 1976 Act was passed, Congress established the Copyright Royalty Tribunal, a group which determined that rates should be raised to 2.75 cents/0.5 cents per minute beginning on January 1, 1978. From 1988 to 2006, the rate increased every two years based on the cost of living. The rate was 5.25 cents/1 cent per minute beginning January 1, 1988. The last increase, taking the rate to 9.1 cents/1.75 cents per minute, occurred in 2006.

86. Shellac records were the first commercially distributed record discs. These discs were made between 1898 and the late 1950s and played at a speed of 78 revolutions per minute (rpm). They are commonly referred to as “78’s” by collectors. During and after World War II when shellac supplies were extremely limited, some 78 rpm records were pressed in vinyl instead of shellac.

87. Introduced by Columbia in 1948, the vinyl record format was soon adopted as a new standard by the entire record industry. With the exception of a few relatively minor refinements and the important later addition of stereophonic sound, it has remained the standard format for vinyl albums.

88. The 8-track tape is a magnetic tape sound-recording technology that was popular in the United States from the mid-1960s to the early 1980s, when the Compact Cassette format took over.

89. Originally released by Philips in 1963, the compact audio cassette was developed in Hasselt, Belgium. The compact cassette is an analog magnetic tape-recording format for audio recording and playback. This format was extremely popular because it could be portable (unlike vinyl records) and could be used to record or play back, while 8-tracks were playback only. The cassette retained its popularity throughout the 1970s and 1980s until the introduction of the compact disc.

90. The compact disc (CD) is a digital optical disc data storage format that was co-developed by Philips and Sony and released in 1982. By the late 1980s, compact discs had become the dominant format for distribution of sound recordings, displacing both the vinyl record and the compact cassette.

91. By the early 2000s, CDs were increasingly being replaced by other forms of digital storage and distribution with the result that by 2010 the number of audio CDs being sold in the U.S. had dropped about 50% from their peak. However, they remained one of the primary distribution methods for the music industry. In 2014, revenues from digital music services matched those from physical format sales for the first time. Since 2017, streaming of recordings on platforms such as Spotify, Tidal, Pandora, and Apple Music has generated more income for the record labels than traditional sales of physical product.

92. Often referred to as the “PA” copyright because of the copyright registration form in the Copyright Office that covers performing arts, such as songs. The copyright in a song generally covers the original music and lyrics that combine to make up the elements of a song.

sound recording of the song.<sup>93</sup> It is these sound recordings that have become source material for modern popular music, beginning with the birth of the rap and hip-hop genres and expanding to other popular music formats, including urban pop and electronic dance music. Some of the most popular recordings of the past thirty-five years have included *samples* of previous sound recordings. Sampling by way of making a digital copy of a portion of a sound recording, e.g., a groove, a guitar or bass line, or a string or horn stab, and repurposing it as a part of a new song is therefore a production and songwriting tool that must be accounted for and recognized. The manner in which these samples are used varies widely, from a short musical motif or chord lasting less than three seconds, to a lengthy instrumental section of the recording being sampled and looped<sup>94</sup> repeatedly to create the accompanying music (the beat) for a new composition. Early on, artists, songwriters, and labels were unsure of how to handle these samples. Ultimately, the industry standard evolved into a case-by-case negotiated sample license and the process became known as sample clearance. The industry could certainly benefit from a uniform and streamlined process of sample clearance and licensing, and later in this article I will propose some possible solutions to that end.

In order for a copyright owner to present a legitimate case for copyright infringement, the plaintiff must show ownership of a valid copyright, copying of original elements, and substantial similarity between the infringing work and the copyrighted work.<sup>95</sup> Copyright registration is *prima facie* evidence of a valid copyright if registered before first publication of the work or within five years after the first publication of the work.<sup>96</sup> Copying of original elements is established by showing that the alleged infringer copied original elements of the work. This copying does not need to be literal and may be found when an alleged infringer paraphrases or copies the underlying elements of a work. Copying may be proven through either direct evidence of copying, i.e., direct access, or where there is no direct evidence, i.e., proof that the

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93. The “SR” or sound recording copyright protects the specific collection of sounds that make up the actual sound recording. Whereas there is typically only one copyright in a particular song, there can be an unlimited number of sound recording copyrights springing from that same original piece of music.

94. A loop is a repeating section of sound material that can be created using a wide range of music technologies including turntables, digital samplers, synthesizers, sequencers, drum machines, tape machines, delay units, or programmed using computer music software or digital audio workstations (DAWs).

95. *Price v. Fox Entm’t Grp., Inc.*, 499 F. Supp. 2d 382, 385–86 (S.D.N.Y. 2007).

96. 17 U.S.C. § 410(c); *Boisson v. Banian, Ltd.*, 273 F.3d 262, 267 (2d Cir. 2001).

alleged infringer had access to the copyrighted work and probative similarities exist between the works.<sup>97</sup> Wide dissemination of the copyrighted work or proof that the alleged infringer may have gained access to the copyrighted work will satisfy the access requirement.<sup>98</sup> Probative similarities must be sufficient to raise an inference of copying,<sup>99</sup> which is a lower standard than the one required for proving substantial similarity. If the factual circumstances warrant, courts have also allowed copyright owners to prove copying solely through *striking similarities*. In order for striking similarities to be present, the works must be so similar as to preclude the possibility that the infringing work was created independent of the copyrighted work.<sup>100</sup> This is a rebuttable presumption, as a defendant may rebut the inference of copying by presenting evidence of independent creation. Regardless of whether a plaintiff can establish valid copyright ownership and copying, there can be no recovery for infringement without satisfying the requirement for substantial similarity. Substantial similarity between the infringing work and the copyrighted work is limited to the protectable elements of the work. Unprotectable elements include facts, ideas, concepts, processes, systems, methods, stock characters, character names, undeveloped characters described in words, and *scenes a faire*.<sup>101</sup> Courts will often ask whether “the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them and regard their aesthetic appeal as the same. . . .”<sup>102</sup> The requirement for substantial similarity refers only to the copyrightable elements of the work.

#### A. *The De Minimis Defense under Copyright Law*

The *de minimis* defense for copyright infringement is a well-established strategy. In *Knickerbocker Toy Co., Inc., v. Azrak-Hamway International, Inc.*,<sup>103</sup> the Second Circuit Court of Appeals held that a copyright claim based on a sample display card, which was used only internally with no intention of being used for production or sales, fell squarely within the principle of *de minimis non curat lex*. The court held

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97. This is typically shown through proof of wide dissemination of the copyrighted work. *See id.*

98. *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 482 (9th Cir. 2000).

99. *Green v. Lindsey*, 885 F. Supp. 469, 479 (S.D.N.Y. 1992), *aff'd*, 9 F.3d 1537 (2d Cir. 1993).

100. *Arnstein v. Porter*, 154 F.2d 464, 469 (2d Cir. 1946).

101. *Brauneis*, *supra* note 79, at n.4.

102. *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 765 (2d Cir. 1991) (citing *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960)).

103. *Knickerbocker Toy Co. v. Azrak-Hamway Int'l, Inc.*, 668 F.2d 699 (2d Cir. 1982).

that such a use did not constitute infringement because it was *completely trivial*. The same court found the use of copyrighted photographs in the film *Seven* to be *de minimis*. In *Sandoval v. New Line Cinema Corp.*,<sup>104</sup> the plaintiff's photographs only appeared briefly in a total of 11 shots. In these shots, the photographs were either obstructed by an actor or stage props, out of focus, or seen from a distance and in poor lighting such that they could not be distinguished. Thus, since the defendant's use of the copyrighted works was such that the works were virtually unidentifiable, the appellate court found that use to be *de minimis*.<sup>105</sup> In *Hoeling v. Universal City Studios, Inc.*,<sup>106</sup> the district court held that three relatively minor similarities between the plaintiff's book and the defendant's movie constituted *de minimis* similarity.

In determining whether copyright infringement is *de minimis*, the courts look to the amount of work that was copied as well as its observability, i.e., length of time it appears in the allegedly infringing work, and its prominence in that work as revealed by its lighting and positioning.<sup>107</sup> To be actionable, copying must be more than *de minimis*, i.e., must involve copying of more than small and insignificant portion of copyrighted work.<sup>108</sup> The district court in *Amsinck v. Columbia Pictures Industries, Inc.*<sup>109</sup> held that a movie's use of a crib mobile painted with the plaintiff's copyrighted artwork, where the artwork was visible for a total of less than 96 seconds and the mobile was seen only for a few seconds at a time, was *de minimis*, and thus did not constitute copyright infringement.

The pattern has been clearly established—a taking is *de minimis* if the use is so insignificant as to be trivial or if the taking is not recognizable by the ordinary observer as having originated in the allegedly infringed work. So why should this approach not apply to sound recordings? Moreover, in all of the cases cited above, there is no question as to whether the copyrighted works were actually being used without any transformational purpose. In the vast majority of sampling cases, there is either a strong argument for transformative use or the work itself has been altered to the extent that it is unrecognizable by the ordinary observer.

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104. *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215 (2d Cir. 1998).

105. *Id.*

106. *Hoehling v. Universal City Studios, Inc.*, 1979 U.S. Dist. LEXIS 10636 (S.D.N.Y. Aug. 2, 1979), *judgment aff'd*, *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2d Cir. 1980).

107. *Gordon v. Nextel Communications and Mullen Advertising, Inc.*, 345 F.3d 922 (6th Cir. 2003).

108. *Neal Publications v. F & W Publ'ns, Inc.*, 307 F. Supp. 2d 928, 931 (N.D. Ohio 2004).

109. *Amsinck v. Columbia Pictures Indus., Inc.*, 862 F. Supp. 1044 (S.D.N.Y. 1994).

### B. *Fair Use as a Defense to Copyright Infringement*

The fair use doctrine was first articulated by the United States Supreme Court in the 1841 case *Folsom v. Marsh*,<sup>110</sup> where Justice Story found infringement for the defendant's use of 353 pages of the plaintiff's multivolume publication on George Washington in producing his own biography of Washington. Justice Story articulated the following as factors that must be considered in a fair use analysis: ". . . the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work."<sup>111</sup>

Although *Folsom v. Marsh*<sup>112</sup> is considered to have birthed the fair use doctrine in American jurisprudence, the phrase "fair use" was never used in Justice Story's opinion. The term "fair use" first appeared in the 1869 case *Lawrence v. Dana*.<sup>113</sup> While courts continued to rely on the factors identified by Justice Story in resolving fair use cases, the doctrine remained a common law, judge-made principle until it was codified in the 1976 Act when Congress determined that codification of the fair use doctrine was necessary.<sup>114</sup>

Even before *Folsom*, the precursor to fair use had appeared as the *fair abridgement* doctrine in England. The British doctrine permitted certain abridgements of the copyrighted works of others without liability for infringement.<sup>115</sup> The court in *Cary v. Kearsley*,<sup>116</sup> in recognizing a right to "fairly adopt part of the work of another," noted that the court must not "put manacles upon science."<sup>117</sup> Courts have always been sensitive to the balancing act of protecting original copyrighted works while stimulating, or at least not stifling, technological advances, including the Internet and creative new means of distributing content to the public. Over the past 20–30 years, technological advances have been swift and significant. These changes have led to a new era in fair use jurisprudence and substantial developments in copyright law, including the Digital Millennium Copyright Act.<sup>118</sup>

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110. *Folsom v. Marsh*, 9 F. Cas. 342 (C.C.D. Mass. 1841).

111. *Id.* at 348.

112. *Id.*

113. *Lawrence v. Dana*, 15 F. Cas. 26, 60 (C.C.D. Mass. 1869).

114. JULIE E. COHEN, LYDIA PALLAS LOREN, RUTH L. OKEDIJI & MAUREEN A. O'ROURKE, COPYRIGHT IN A GLOBAL INFORMATION ECONOMY, 564 (Wolters Kluwer, 4th ed. 2015).

115. *Cary v. Kearsley*, 170 Eng. Rep. 679, 680 (K.B. 1803).

116. *Id.*

117. Cohen, *supra* note 114, at 563.

118. Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998).

Although the fair use doctrine was first codified in the Copyright Act of 1976,<sup>119</sup> its standards are virtually identical to the original test enunciated by Justice Story almost a decade before the U.S. Civil War.<sup>120</sup> Precious few societal standards have remained the same in the past 180 years, so one might wonder whether the standards for fair use are also worth updating. We have seen massive changes in American society due to new media and technologies which weren't even in the conception stages in 1841 when the lone means of transmitting information, other than verbal communication from person to person, was via the printed word.

In a case where the defendant claims fair use, once the copyright owner has made a *prima facie* case for copyright infringement by showing copying of the original work and substantial similarity, the defendant has the burden to show that the infringing use of the work was privileged as fair use.<sup>121</sup> A great deal of consideration is given to whether the new work is transformative, i.e., does the new work alter the original with new expression, meaning, and message. Typically, a fair use is one that has transformed the original. Under the 1976 Act, there are four considerations that are made in each fair use case:

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>122</sup>

In a digital sampling context, the use may or may not be transformative depending on the way it is used. Sampling a vocalist holding out a note, then distorting that note so severely that it sounds as though it is a guitar, violin, or even a trumpet certainly seems to satisfy the statutory requirements of transformative use. Likewise, sampling a two or three second guitar lick, transposing the key, changing the speed, distorting the sound, and placing it in a context where it sounds like the industrial sounds

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119. 17 U.S.C. § 107 (1976).

120. *See Folsom v. Marsh*, 9 F. Cas. 342, 345 (C.C.D. Mass. 1841).

121. *American Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 918 (2d Cir. 1994).

122. 17 U.S.C. § 107 (1976).



of a busy city street would seem to satisfy the statutory requirements as well.

Transformative use is typically found when the alleged infringing work adds something new to the underlying work or when the new work has a different function, purpose, or character than the original work. The more transformative the work is, the stronger the argument is for transformation and fair use. The second, ninth, and fourth circuits have found a use to be transformative where it has a different function, character, or purpose than the original.<sup>123</sup> For a use to be held as transformative, it must also not supersede the marketplace for the original work. The ninth circuit has held that where a secondary work serves an informational function or has an aesthetic purpose, it does not compete with the original, and thus falls within the fair use exception.<sup>124</sup>

In *Blanch v. Koons*,<sup>125</sup> the defendant Koons recreated a photographer's black and white photograph as a sculpture. The second circuit held that transformation into a three-dimensional medium was not a fair use. The court here suggested that where a copyrighted work is used as raw material for a new work, the new work must have new information, aesthetics, or understandings for the use to be deemed transformative. The second circuit has held that it is not necessary for the new work to comment on the work that it uses in order to be transformative,<sup>126</sup> a holding that is shared by the ninth circuit.<sup>127</sup> In *Bill Graham Archives v. Dorling Kindersley Ltd.*,<sup>128</sup> the second circuit held that reproducing copyrighted Grateful Dead concert posters in a book about the band was transformative because the new use showed the posters in the context of a historical timeline and had a purpose that was plainly different from the posters' original purposes, i.e., advertising a show. The fourth circuit addressed a similar issue and held that the use of an old Baltimore Ravens logo in videos recounting franchise history was transformative because documenting franchise history has a different purpose than the logo's original function as a source identifier.<sup>129</sup>

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123. Authors Guild, Inc. v. Hathi Trust, 755 F.3d 87, 97 (2d Cir. 2014); Kelly v. Arriba Soft Corp., 336 F.3d 811, 818–19 (9th Cir. 2003); and A.V. ex rel. Vanderhye v. iParadigms, LLC, 562 F.3d 630, 639 (4th Cir. 2009).

124. Perfect 10, Inc. v. Amazon.com, Inc., 508 F.3d 1146 at 1166; Kelly v. Arriba Soft Corp., 336 F.3d 811, 820 (9th Cir. 2003).

125. Blanch v. Koons, 467 F.3d 244, 253 (2d Cir. 2006).

126. Cariou v. Prince, 714 F.3d 694, 706 (2d Cir. 2013).

127. Seltzer v. Green Day, Inc., 725 F.3d 1170 at 1177 (9th Cir. 2013).

128. Bill Graham Archives v. Dorling Kindersley Ltd., 448 F.3d 605, 609 (2d Cir. 2006).

129. Bouchat v. Baltimore Ravens Ltd. P'ship, 737 F.3d 932, 940 (4th Cir. 2013), as amended (Jan. 14, 2014).

Under the first factor, courts pay great attention to whether the use is transformative and there is a distinction between commercial and nonprofit educational use. Generally, if a challenged use of a copyrighted work is for commercial gain, the first fair use factor weighs against fair use.<sup>130</sup> Overwhelmingly, digital samples are used in commercial productions. However, a commercial purpose will not conclusively negate fair use.<sup>131</sup> Bad faith use may weigh against fair use, but is not dispositive if there are other factors favoring fair use.<sup>132</sup> In *Campbell v. Acuff-Rose Music, Inc.*,<sup>133</sup> the defendant 2 Live Crew, a popular rap group, created a parody of the Roy Orbison song *O Pretty Woman*. After unsuccessfully seeking a license from the publisher, 2 Live Crew released the song without a license with the understanding that under copyright law, parodies do not require permission of the underlying copyright owner, provided that they actually satisfy the requirements of being a parody.<sup>134</sup> The plaintiffs brought suit for copyright infringement and the district court granted summary judgment for 2 Live Crew, concluding that they made fair use of Roy Orbison's original work. The court of appeals reversed and remanded, holding that every commercial use is presumptively unfair and the blatantly commercial purpose of 2 Live Crew's version prevented it constituting fair use. The U.S. Supreme Court granted certiorari to determine whether, for fair use purposes, the commercial purpose of a work is the dispositive element of the inquiry into the purpose and character of the work. The Supreme Court reversed the appellate court and held that for fair use purposes, the commercial purpose of a work is only *one* element of the inquiry into the purpose and character of the work.<sup>135</sup>

A use's commercial nature does not create a presumption that it is unfair. Rather, the Supreme Court observed that Congress intended only that commercialism be one factor in the examination of a use's purpose and character.<sup>136</sup> A finding that there may be a public benefit may also

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130. *Elvis Presley Enters. Inc. v. Passport Video*, 349 F.3d 622, 627 (9th Cir. 2003); *overruled on other grounds by Seltzer*, 725 F.3d at 1178.

131. *Elvis Presley Enters. Inc.*, 349 F.3d at 627; *See Seltzer*, 725 F.3d at 1178.

132. *Rogers v. Koons*, 960 F.2d 301, 309 (2d Cir. 1992); *MCA, Inc. v. Wilson*, 677 F.2d 180, 183 (2d Cir. 1981).

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

134. The legal standard for parodies is that the parodist may appropriate no greater amount of the original work than is necessary to "recall or conjure up" the object of his satire. *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978).

135. *Campbell*, 510 U.S. 569 (1994); *Elvis Presley Enters.*, 349 F.3d at 627; *See Seltzer*, 725 F.3d at 1178.

136. *Id.*

weigh in favor of fair use under this factor.<sup>137</sup> The Supreme Court held that Google's unauthorized digitation of books, allowing books to be searched electronically, was fair use.<sup>138</sup> In subsequent cases, the Supreme Court has held that commercial use may cut against a finding of fair use, but not all commercial uses are equal in that regard. If the user does not exploit the work itself, but instead uses it incidentally as part of a larger commercial enterprise, the commercial use is less significant.<sup>139</sup> Google's search and snippet view functions were found to contribute substantial benefits to public knowledge by allowing the public, for the first time, to conduct instantaneous full-text searches of more than twenty million books.<sup>140</sup>

Under the second factor, fair use privilege is more extensive for scientific, biographical, and historical works than for works of entertainment. If a work is out of print, the permissible scope of fair use is broader while fair use privilege is narrower for unpublished works.<sup>141</sup> In *Harper & Row Publishers, Inc. v. Nation Enterprises*,<sup>142</sup> former President Gerald Ford had contracted with Harper & Row Publishers, Inc. to publish his memoirs. Harper & Row in turn contracted with Time Magazine giving Time the exclusive right to excerpt 7,500 words from the portion of Ford's book where Ford discussed the pardon that he granted to former President Richard Nixon. Time agreed to pay \$25,000 for this exclusive right—\$12,500 up front and the remaining \$12,500 at the time of publication. Before Time released its article, The Nation Magazine gained access to the unpublished manuscript without permission of the copyright holder or Time Magazine and scooped Time by publishing approximately 300 words from the manuscript. Harper & Row brought suit against The Nation, alleging copyright infringement. The district court held that The Nation was liable for copyright infringement, but the court of appeals held that The Nation's use of the material was fair use. The U.S. Supreme Court held that The Nation's use of verbatim excerpts from the unpublished manuscript was not a fair use.<sup>143</sup> However, the Court held that the unpublished nature of the work was not determinative. Justice O'Connor in her opinion wrote, "Under ordinary circumstances, the author's right to control the first public

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137. *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1166 (9<sup>th</sup> Cir. 2007).

138. *The Authors Guild, Inc. v. Google, Inc.*, 804 F.3d 202 (2d Cir. 2015).

139. *Elvis Presley Enters.*, 349 F.3d at 627 ;Seltzer, 725 F.3d at 1178.

140. *Id.*

141. *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 564 (1985); *New Era Publications Int'l, ApS v. Henry Holt & Co.*, 873 F.2d 576 (2d Cir. 1989).

142. *Id.*

143. *Id.*

appearance of his undisseminated expression will outweigh a claim of fair use.”

As for the third factor, courts will consider whether the defendant has taken more than is necessary to satisfy the specific fair use purpose. In parody, a defendant can only use as much of the copyrighted work as is necessary to conjure up the image of the original.<sup>144</sup> This is a qualitative and quantitative analysis. In *Disney v. Air Pirates*,<sup>145</sup> the defendants were the creators of adult themed comic books that attempted to make parodic use of Disney’s characters, including Mickey Mouse. The Disney characters were depicted in bawdy, promiscuous and drug-ingesting behavior. Rejecting the defendants claim of fair use, the district court held that the cartoon characters were copyrightable; the defense of fair use was not available where the copying had been more than was necessary to conjure up the image of the original work; and the First Amendment did not bar imposition of liability on parodists.

Finally, as to the fourth factor, the key is potential harm to the market, as opposed to actual harm shown. While this factor has often been regarded as the most important of the four factors, that approach is not consistent. For example, in *Kienitz v. Sconni Nation LLC*,<sup>146</sup> the seventh circuit held that of the four fair use factors, the most important is usually the fourth (market effect). However, in *Cariou v. Prince*,<sup>147</sup> the second circuit held that the first fair use factor, whether a use is *transformative* is the most important. Copying that is complementary to, rather than a substitute for the copyrighted work, generally does not harm the market and is more easily regarded as fair use.<sup>148</sup>

A look at the legislative history shows that the four factors represent a codification of fair use.<sup>149</sup> But does this codification accurately represent the current state of the law, taking into consideration the significant advances we have made in technology, methods of delivery for entertainment and media, modern methods of distribution, and even the contemporary approaches to creation? Take the changes that have occurred with regard to the creation of music, for example. The musical greats of the eighteenth, nineteenth, and much of the twentieth century, painstakingly created musical compositions one note at a time, their

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144. *Walt Disney Productions v. Air Pirates*, 345 F. Supp. 108 (N.D. Cal. 1972), *aff’d in part, rev’d in part*, 581 F.2d 751 (9th Cir. 1978).

145. *Id.*

146. *Kienitz v. Sconni Nation LLC*, 786 F.3d 756 (7th Cir. 2014).

147. *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013).

148. *Id.*

149. H.R. REP. NO. 94-1476, at 66 (1976).

exacting attention to detail being executed with a writing implement, sheets of musical staff paper, and perhaps even a candle to guide them as their assiduous efforts carried them well past the setting sun. Musical pieces that were composed with singers in mind often included the chordal accompaniment memorialized on the bass and treble clefs of the staff paper, along with a melodic lead line that captured the melody that accompanied the lyric. Any changes to the music during the period of composition required great circumspection so as not to set off a catastrophic chain of events. Music created using this method is easily compared, one piece to another, simply by juxtaposing the sheet music of the pieces in question. Discovering whether one piece infringed upon another could be simply determined by whether the original elements, especially the melodic elements, were substantially similar. Modern music composition, however, is not typically created in this manner. The vast majority of modern tunesmiths create their music with the aid of technological devices that include computers and digital audio workstations.<sup>150</sup> The musical elements are manipulated on these digital audio workstations in a *cut and paste* manner. Single notes, musical phrases, or entire sections of songs are routinely added, deleted, or moved as the modern music composer arranges a song. Likewise, digitized sounds, industrial or natural sounds, and samples of other recordings often serve as source material for new compositions. How do we treat these samples when the use is too small to be detected by an ordinary observer, or if the use is truly transformative?

Fair use, historically known and treated as a defense to copyright infringement, has been defined as a “privilege in others than the owner of a copyright to use the copyrighted material in a reasonable manner without his consent, notwithstanding the monopoly granted to the owner.”<sup>151</sup>

Fair use is a mixed question of law and fact. If a reasonable trier of fact could reach only one conclusion, a court may conclude as a matter of law that the challenged use of the copyrighted work qualifies as a fair use.<sup>152</sup>

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150. Digital Audio Workstations (also referred to as DAWs) such as ProTools, Logic, Ableton, Presonus, Cakewalk Sonar, and Reason, are the primary means of creating and producing modern music. These DAWs serve the function that reel-to-reel tape machines served during much of the twentieth century.

151. *Rosemont Enters., Inc. v. Random House, Inc.* 366 F. 2d 303, 306 (2d Cir. 1966).

152. *See Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985); *Hustler Magazine, Inc. v. Moral Majority, Inc.*, 796 F.2d 1148, 1150 (9th Cir. 1986).

Copyright law must also take account of First Amendment principles.<sup>153</sup> It need not do so overtly; there are ample tools available within the framework of copyright law itself so that the words “First Amendment” need not be mentioned at all. But First Amendment values should matter, even in copyright cases.<sup>154</sup>

Read literally, the First Amendment would invalidate the Copyright Act. On the other hand, since the Copyright Clause of the Constitution<sup>155</sup> vests in Congress the power to enact copyright laws, it might be argued that this creates a built-in immunity from the First Amendment for copyright. Both of these extreme positions are obviously untenable. But if copyright is neither immune from nor invalidated by the First Amendment, then some constitutional accommodation must be found between these two competing interests.<sup>156</sup>

Any interpretation of copyright law sensitive to First Amendment values must give sufficient room to the principle of fair use to accommodate the public interest in being informed. At the same time, we must protect the private interest—of enormous public benefit—of authors to be assured that they, and not others, will be compensated for their creative efforts.<sup>157</sup>

Modern copyright jurisprudence focuses on the protection of creative works of authorship, be they books, films, songs, recordings, paintings, sculptures, etc., but these were not always the primary elements captured by the net of copyright law. The first framers of copyright laws sought primarily to encourage the creation of and investment in the production of works furthering national social goals.<sup>158</sup> Early U.S. copyright law particularly sought to foster the development of works that would help educate the public.<sup>159</sup> In fact, the title of the first federal copyright law in 1790 indicates the focus of the framers of the original copyright laws—“An act for the encouragement of learning.”<sup>160</sup>

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153. See U.S. CONST. amend. I; See generally BRAUNEIS, *supra* note 79, at 4.

154. FLOYD ABRAMS, *FRIEND OF THE COURT: ON THE FRONT LINES WITH THE FIRST AMENDMENT*, 253 (Yale University Press eds., 2013).

155. U.S. CONST. art. I, §8, cl. 8.

156. Brief of Amici Curiae, Professor Melvin Nimmer et al., Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539 (1985).

157. ABRAMS, *supra* note 155, at 254.

158. Jane C. Ginsburg, *A Tale of Two Copyrights: Literary Property in Revolutionary France and America*, 64 TUL. L. REV. 991, 996 (1990).

159. *Id.* at 1001.

160. R. Anthony Reese, *The Story of Folsom v. Marsh: Distinguishing Between Infringing and Legitimate Uses*, 259, in *Intellectual Property Stories*, (Jane C. Ginsburg, Rochelle Cooper Dreyfuss, eds., Foundation Press, 2006).

C. *Fair Use and De Minimis Application in Other Areas of Intellectual Property*

There are some similarities, as well as some major differences, between viable defenses to copyrights as opposed to the other areas of intellectual property. What are the parallels to fair use and *de minimis* use in the areas of trade secrets, patents, and trademarks? The answer is straight forward as it applies to patent law—there is no fair use equivalent. How does the law treat these or similar defenses in areas such as right of publicity and fashion law? The exploration of these questions deserves more than a glancing review. Subsequently, I will explore these questions in an upcoming article.

IV. STATE OF THE LAW IN THE U.S.

The state of the law in the United States is complicated by the fact that the *de minimis* doctrine is, and has been, a muddled doctrine. Copyright law and patent law allow future authors and inventors to build upon the works of previous rights holders. In the patent world, the new work must be a non-obvious improvement on the original patent. In copyright, the key is that the secondary user cannot take a substantial portion of the prior author's copyrightable expression.<sup>161</sup> There is no infringement without substantial similarity. By definition, a *de minimis* taking is the polar opposite of substantial similarity. Nonetheless, the courts do not provide a clear guideline as to when a taking advances beyond *de minimis* to a substantial taking. This creates a significant challenge for those who are in creative industries and may have opportunity to use copyrighted works in the process of creating new works. For example, filmmakers and documentary producers are often unsure of what they can and cannot use in an incidental manner in the background of their films. When courts look at the *de minimis* question, they focus on whether the alleged taking was too much of the existing work as well as whether the taking was of protected or unprotected elements of the existing work.

In *On Davis v. The Gap, Inc.*,<sup>162</sup> a second circuit case, Judge Leval explains the *de minimis* doctrine as follows:

Trivial copying is a significant part of modern life. Most honest citizens

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161. *Gottlieb Dev. LLC v. Paramount Pictures Corp.*, 590 F. Supp. 2d 625, 631 (S.D.N.Y. 2008).

162. *On Davis v. The GAP, Inc.*, 246 F.3d 152, 173 (2d Cir. 2001), as amended (May 15, 2001).

in the modern world frequently engage, without hesitation, in trivial copying that, but for the *de minimis* doctrine, would technically constitute a violation of law. We do not hesitate to make a photocopy of a letter from a friend to show to another friend, or of a favorite cartoon to post on the refrigerator. Parents in Central Park photograph their children perched on Jose de Creeft's Alice in Wonderland sculpture. We record television programs aired while we are out so as to watch them at a more convenient hour. Waiters at a restaurant sing "Happy Birthday"<sup>163</sup> at a patron's table. When we do such things, it is not that we are breaking the law but unlikely to be sued given the high cost of litigation. Because of the *de minimis* doctrine, in trivial instances of copying, we are in fact not breaking the law.

The fact that Judge Leval's opinion actually includes several examples that are considered fair use as opposed to *de minimis* copying shows how unclear the *de minimis* doctrine actually is.

As to the question of how much is too much, it is a matter of degree. As we see in copyright law, there are times that the application of the statute will be affected by the actual classification of the work that is allegedly being infringed. The digital sampling issue, of course, specifically revolves around sound recordings. Two major cases in different circuits have undertaken the question of whether a quantitatively insignificant digital sample of a sound recording could avoid copyright infringement liability by claiming a *de minimis* defense. The sixth and ninth circuits have come to divergent conclusions on this question.<sup>164</sup>

#### A. *Sixth Circuit*—Bridgeport Music

In *Bridgeport Music, Inc. v. Dimension Films*,<sup>165</sup> the plaintiff was the owner of a musical composition *Get Off Your Ass and Jam*, which was sampled and used in the song *100 Miles and Runnin'* and appeared on the soundtrack of the movie *I Got The Hook Up*. The use in question was a two second clip from a guitar solo, which was sampled, manipulated digitally to lower the pitch, and looped to recur several times in the new sound recording. The resulting sample was not identifiable by the ordinary observer. The defendant did not deny the use of the sample, instead their defense was that the use of two seconds of a guitar solo was a quantitatively insignificant use, and was therefore *de minimis*. The district

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163. *Happy Birthday* has since been ruled to be in the public domain. See *Marya v. Warner/Chappell Music, Inc.*, 131 F. Supp. 3d 975 (C.D.Cal. 2015).

164. *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871 (9th Cir. 2016); *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792 (6th Cir. 2005).

165. *Bridgeport Music, Inc.*, 410 F.3d 792.



court granted summary judgment for the defendant on the grounds that the alleged infringement was *de minimis* and therefore not actionable. On appeal, the United States Court of Appeals for the Sixth Circuit reversed for the plaintiff and held that there was no *de minimis* defense available for sampling of sound recordings. There are significant problems with this bright line rule. First, it provides no opportunity for the trier of fact to examine the use under traditional copyright infringement analysis. Second, and perhaps more troubling, sound recordings are based upon songs, and there is long established case law holding that the *de minimis* defense applies to songs. There are no musical sound recordings without the underlying songs. How then can we justify having no *de minimis* defense for a work that is based upon songs?

Historically, courts in copyright infringement cases have eschewed a bright line test for determining the line between infringing and non-infringing copying.<sup>166</sup> In *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, Judge Learned Hand observed, “The test for infringement of a copyright is of necessity vague. . . . Decisions must therefore inevitably be ad hoc.”<sup>167</sup>

As discussed above, in order to establish the elements of copyright infringement, a plaintiff must not only identify commonalities between the two works, but must also show that the defendant actually copied material from the plaintiff’s copyrighted work, and that the defendant copied a sufficiently significant amount of copyrighted material from the plaintiff’s work so that the parties’ works can be said to be substantially similar. The substantial similarity analysis includes three key considerations: how much of the plaintiff’s original material the defendant copied; how important the copied material is to the plaintiff’s (not the defendant’s) work; and whether copyright law protects the copied material. Copying that satisfies the substantial similarity requirement may be classified as verbatim copying, total concept and feel, or both.<sup>168</sup> In *Hoehling v. Universal City Studios, Inc.*,<sup>169</sup> the court held that infringement is likely if the defendant copied significant portions of the original material in the plaintiff’s work verbatim. However, infringement

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166. Eric Osterberg, *Copyright Litigation: Analyzing Substantial Similarity*, Osterberg, LLC, with Practical Law Intellectual Property and Technology (2019), [https://1.next.westlaw.com/Document/I2929e508642311e38578f7ccc38dcbec/View/FullText.html?transitionType=SearchItem&contextData=\(sc.Search\)&firstPage=true](https://1.next.westlaw.com/Document/I2929e508642311e38578f7ccc38dcbec/View/FullText.html?transitionType=SearchItem&contextData=(sc.Search)&firstPage=true) [http://perma.cc/5B8G-DHU7].

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

168. Osterberg, *supra* note 167.

169. *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 980 (2d Cir. 1980).

of a literary or audiovisual work can also occur if the infringer copies the entire backdrop, characters, inter-relationships, genre, and plot design.<sup>170</sup>

The question in all cases is whether the material the defendant copied is a significant portion of the plaintiff's work.<sup>171</sup> The sixth circuit is the only circuit to hold that all sampling constitutes infringement per se, regardless of the amount taken. This radical holding contradicts the most elementary requirement for copyright infringement, i.e., that the plaintiff must prove substantial similarity to prove copyright infringement based on sampling.

### B. Ninth Circuit—VMG Salsoul

The ninth circuit was faced with a similar case in *VMG Salsoul, LLC v. Ciccone*,<sup>172</sup> which involved defendant Madonna and her producer being sued for copyright infringement for making use of a horn stab of less than one second and using it in her hit song *Vogue*. The district court applied the rule that *de minimis* copying does not constitute infringement, thus even if the plaintiff were able to prove actual copying the claim fails because the copying was trivial.<sup>173</sup> The district court granted summary judgment to the defendants on the grounds that neither the composition nor sound recording of the horn hit was *original* for purposes of copyright law, and even if it was, the sampling of it was trivial. The plaintiffs appealed and presented evidence of actual copying. The issues on appeal included whether the alleged copying of the composition and sound recording were *de minimis*, and whether the *de minimis* exception applies to the alleged infringement of sound recordings. The court held that the *de minimis* exception does apply to infringements of copyrighted sound recordings.<sup>174</sup> Congress intended to maintain the *de minimis* exception for claims alleging copyright infringement of sound recordings when it enacted the copyright provision stating that exclusive rights of the owner of a copyright in sound recording did not extend to making or duplication of another sound recording; sound recordings were treated identically to all other types of protected works under the Copyright Act, and Congress intended to limit, not expand, rights of copyright holders as noted in a passage from the house reports, which articulated the principle that

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170. *TMTV, Corp. v. Mass Prods., Inc.*, 645 F.3d 464, 470 (1st Cir. 2011).

171. *Newton v. Diamond*, 388 F.3d 1189, 1195 (9th Cir. 2004).

172. *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871 (9th Cir. 2016).

173. *Id.*

174. *Id.*

infringement only took place whenever all or any substantial portion of actual sounds were reproduced.<sup>175</sup>

#### V. TREATMENT IN SELECTED INTERNATIONAL JURISDICTIONS

An increasing number of international copyright scholars have concluded that copyright protection is more than merely utilitarian, but should instead be considered a human right.<sup>176</sup> In fact, some international treaties enunciate this viewpoint with specificity. For example, the Universal Declaration on Human Rights states as follows: “Everyone has the right to protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.”<sup>177</sup> Some constitutions support this view as well, for example, the Swedish Constitution states that “authors, artists and photographers shall own the rights to their works in accordance with provisions laid down in law.”<sup>178</sup> The Charter of Fundamental Rights of the European Union simply states that “intellectual property shall be protected.”<sup>179</sup> The Federal German Constitution (*Grundgesetz*) does not mention copyright, however, the nation’s case law is well developed. The German Constitution states that “[e]verybody has the right to self-fulfillment in so far as they do not violate the rights of others or offend against the constitutional order or morality.”<sup>180</sup> However, German law also indicates that the copyright monopoly should be limited: “Property entails obligations. Its use should

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175. *Id.*

176. *See, e.g.*, Francois Dessemontet, *Copyright and Human Rights*, in *INTELLECTUAL PROPERTY AND INFORMATION LAW: ESSAYS IN HONOUR OF HERMAN COHEN JEHOAM* 113 (Jan J.C. Kabel & Gerard J.H.M. Mom, eds., 1998); Michel Vivant, *Le droit d’auteur, un droit de l’homme*, 174 *REVUE INTERNATIONALE DU DROIT D’AUTEUR* [R.I.D.A.] 60 (1997); Andre Kerever, *Authors’ Rights are Human Rights*, 32 *COPYRIGHT BULLETIN* 18 (1999); extensively TORREMANS 2008.

177. UNIVERSAL DECLARATION ON HUMAN RIGHTS ART. 27(2); *See, e.g.*, France, Huston v. La Cinq, District Court of Paris, November 23, 1988, 139 R.I.D.A. 205 (1989); Anne Bragance v. Olivier Orban et.al., Court of Appeal of Paris, 142 R.I.D.A. 301 (1989). UNIVERSAL DECLARATION ON HUMAN RIGHTS ART. 27 § 2. [http://www.claiminghumanrights.org/udhr\\_article\\_2.html#at3](http://www.claiminghumanrights.org/udhr_article_2.html#at3) [<http://perma.cc/6F6Y-4ZWK>]; *See, e.g.*, France, Huston v. La Cinq, District Court of Paris, November 23, 1988, 139 *REVUE INTERNATIONALE DU DROIT D’AUTEUR* [R.I.D.A.] 205 (1989); Anne Bragance v. Olivier Orban et.al., Court of Appeal of Paris, 142 *REVUE INTERNATIONALE DU DROIT D’AUTEUR* [R.I.D.A.] 301 (1989). *See* PAUL GOLDSTEIN AND P. BERT HUGENHOLTZ, *INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE* 23 (Oxford University Press, eds., 3rd ed. 2013).

178. REGERINGSFORMEN [RF] [CONSTITUTION] 2016, 21:9. (Swed.).

179. CHARTER OF FUNDAMENTAL RIGHTS OF THE EUROPEAN UNION ART. (17)(2), OJ EC C 364/1 of 18 December 2000.

180. DEUTSCHER BUNDESTAG [Constitution] GRUNDGESETZ [GG] [Basic Law] Last Amended July 13, 2017, art. 2 § 1 (Ger.).

also serve the public interest.”<sup>181</sup> French law does not provide explicitly for the constitutional protection of copyrights, however, these rights in France emanate from Article 17 of the Declaration of Human Rights and Civil Rights of 1789, which identifies property rights generally as an “inviolable and sacred right.”<sup>182</sup> The application of a human rights approach to copyright, while providing protection against legal challenges, also provides logical limitations on the monopoly of copyright. Meanwhile, the law in the U.S. has been straightforward in its foundation that copyright is not an authorial conception but is a utilitarian concept, as noted by the rationale for copyright protection being “progress of science.”<sup>183</sup> Nonetheless, whether there is a lean toward the human rights or the utilitarian concept, either approach carries with it the necessity of providing reasonable limitations and the authorization to make samples of sound recordings, specifically where there is no adverse effect on the commercial marketplace of the underlying work, or where the reasonable or lay observer would be unable to recognize the sample as being derived from the specific underlying work.

While the international treatment of whether quantitatively insubstantial copying of a sound recording may be considered *de minimis* has been a mixed bag, many jurisdictions have made it clear that *de minimis* copying is a viable defense. In Australia, infringement occurs when a substantial portion of a work is reproduced.<sup>184</sup> Australian courts take a look at whether the substantial portion taken is qualitative, i.e., whether the part taken is essential, vital, or material in relation to the work as a whole.<sup>185</sup> In the case *EMI Songs Australia Pty. Ltd. v. Larrikin Music Publishing Pty. Ltd.*,<sup>186</sup> the band Men At Work incorporated a part of Mr. Larrikin’s song *Kookaburra* in their song *Down Under*.<sup>187</sup> Larrikin sued

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181. *Id.* at art. 14 §2.

182. See Adolf Dietz, *Transformation of Authors Rights: Change of Paradigm*, 138 REVUE INTERNATIONALE DU DROIT D’AUTEUR [R.I.D.A.] 22, 58 (1988).

183. U.S. CONST. art I, § 8, cl. 8. See also CONST. (1987), art. XIV, §. 13 (Phil.) stating “The State shall protect and secure the exclusive rights of scientists, inventors, artists, and other gifted citizens to their intellectual property and creations, particularly when beneficial to the people, for such period as may be provided by law.”

184. *Short Guide to Copyright*, COMMUNICATIONS (2019), <https://www.communications.gov.au/documents/short-guide-copyright> [<https://perma.cc/E6QW-DBBX>].

185. *Quotation and Copyright Law*, ALRC, <https://www.alrc.gov.au/publications/9-quotation/quotation-and-copyright-law> [<https://perma.cc/F3HQ-4M9P>].

186. Aaron Yates, *Full Court decides on appeal that a substantial part of “Kookaburra” was copied in Men at Work’s “Do*, DCC (2011), <http://www.davies.com.au/ip-news/full-court-decides-on-appeal-that-a-substantial-part-of-kookaburra-was> [<https://perma.cc/GTK6-EDGG>].

187. The song *Down Under* by Australian band Men at Work hit number one on the Billboard Hot 100 in January 1983 and remained at the top of the charts for four non-consecutive weeks. The song also reached number one in Australia, Canada, Ireland, New Zealand, Switzerland, and the

for copyright infringement in federal court against EMI companies. The court held the flute riff in *Down Under* was objectively similar to bars from *Kookaburra*. In their book chapter, *Copyright, Fair Use and the Australian Constitution*, Kylie Pappalardo and Brian Fitzgerald use the historical record to argue that the incorporation of the term *copyrights* in the Australian Constitution is accompanied by a notion of balance and fair use in Australian law and that this should be considered when interpreting the Australian Copyright Act of 1968.<sup>188</sup> This approach was birthed in the English case law of the 18<sup>th</sup> and 19<sup>th</sup> century which provided for fair use of a work where the defendant had made a productive use that did more than alter the original work for the purpose of evading liability, and where the defendant had made an original contribution to the resulting work.<sup>189</sup> Fair use was also shown where the use did not supersede or prejudice the market for the original work.<sup>190</sup> Under Australian law, while fair use is not included in the statute, professors Pappalardo and Fitzgerald point to the foundation upon which Australia's laws were built—the English laws of the 18<sup>th</sup> and 19<sup>th</sup> centuries—and that law's recognition that non-infringing copying includes the copying of insubstantial parts of copyrighted works and copying to make a fair use of the work.<sup>191</sup> While the Australian courts have yet to rule on a case involving a *de minimis* defense for a short digital sample, it appears that based on the statutory language in Australia, a case where a short digital sample was used and was not identifiable would not classify as a “substantial portion of a work” being reproduced.

German courts in recent years have created a positive environment for sampling. Germany's Constitutional Court in 2014 held that a hip-hop artist that sampled a two-second beat from a Kraftwerk song was not liable for copyright infringement.<sup>192</sup> Producer Moses Pelham used the sample from Kraftwerk's *Metall auf Metall*<sup>193</sup> in the song *Nur Mir*,<sup>194</sup> performed by rapper Sabrina Setlur. The court said the sequences were only seconds

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United Kingdom.

188. Kylie Pappalardo, Brian Fitzgerald, *Copyright, Fair Use and the Australian Constitution*, in BRIAN FITZGERALD, JOHN GILCHRIST, *COPYRIGHT PERSPECTIVES: PAST, PRESENT AND PROSPECT*. SPRINGER, CHAM, SWITZERLAND, 125–64 (Springer, Cham, Switzerland, eds., 2015).

189. See Joseph R. Re, *The Stage of Publication as a 'Fair Use' Factor: Harper & Row, Publishers Inc. v. Nation Enterprises*, 58 ST. JOHN'S L. REV. 597, 598 n.4 (1984).

190. Pappalardo, *supra* note 189, at 125–164.

191. Pappalardo, *supra* note 189, at 125–164.

192. Madaline Chambers, *German Court Allows Music Sampling for Hip-Hop Producer*, NEWS (2016), [http://www.reuters.com/article/us-germany-music-sampling/german-court-allows-music-sampling-for-hip-hop-producer-idUSKCN0YM1JQ\\_1https://perma.cc/MXW6-DK3Q](http://www.reuters.com/article/us-germany-music-sampling/german-court-allows-music-sampling-for-hip-hop-producer-idUSKCN0YM1JQ_1https://perma.cc/MXW6-DK3Q)].

193. *Metall auf Metall* is German for “Metal on Metal.”

194. *Nur Mir* is German for “Only for Me.”

long and “led to the creation of a totally new and independent piece of work.”<sup>195</sup> The German court held that the economic value of the original sound was not diminished, and that banning sampling would in effect spell the end of some music styles.<sup>196</sup> This progressive approach would be an economically viable approach in the United States as it would protect against any unactionable substantial copying while providing an opportunity for composers and producers to use small samples that would be too insignificant to negatively affect the commercial market of the original work.

The framework for U.K. copyright law is found in the Copyright, Designs and Patents Act of 1988, with the provision of the Act being heavily influenced by both E.U. directives and international treaties.<sup>197</sup> In the United Kingdom, “Fair Dealing” is a legal term used to establish whether a use of a copyrighted work is lawful or unlawful. The concept of fair dealing was introduced in the 1911 U.K. Copyright Act and then more fully enunciated in the 1956 Copyright Act.<sup>198</sup> While there is no statutory definition of fair dealing, the courts endeavor to determine how a fair-minded and honest person would have dealt with the work. The factors that have been identified by the courts as relevant in determining fair dealing include:

1. Does using the work affect the market for the original work?  
If a use of a work acts as a substitute for it, causing the owner to lose revenue, then it is not likely to be fair.
2. Is the amount of the work taken reasonable and appropriate?  
Was it necessary to use the amount that was taken? Usually only part of a work may be used.

The relative importance of any one factor will vary according to the facts of the case and the type of dealing in question.<sup>199</sup>

English courts are still wrestling with how to treat sampling. In *Morrison Leahy Ltd. v. Lightbond Ltd.*,<sup>200</sup> the defendant created a project

195. Chambers, *supra* note 192.

196. Chambers, *supra* note 192.

197. Ben Hitchens, *Copyright in the United Kingdom*, LEXOLOGY (2019), [https://www.lexology.com/library/detail.aspx?g=502708f2-9dc3-4155-aa1e-c0ba878b86bb&utm\\_source=lexology+daily+newsfeed&utm\\_medium=html+email&utm\\_campaign=lexology+subscriber+daily+feed&utm\\_content=lexology+daily+newsfeed+2018-07-02&utm\\_term=https://perma.cc/2PST-EVVA](https://www.lexology.com/library/detail.aspx?g=502708f2-9dc3-4155-aa1e-c0ba878b86bb&utm_source=lexology+daily+newsfeed&utm_medium=html+email&utm_campaign=lexology+subscriber+daily+feed&utm_content=lexology+daily+newsfeed+2018-07-02&utm_term=https://perma.cc/2PST-EVVA)].

198. Lynette Owen, *Fair dealing: A Concept in UK Copyright Law*, ONLINELIBRARY (2015), <https://onlinelibrary.wiley.com/doi/pdf/10.1087/20150309> [https://perma.cc/T573-YZKG].

199. INTELLECTUAL PROPERTY OFFICE, *Exceptions to Copyright: An Overview*, Crown Copyright, (2014) <https://assets.publishing.service.gov.uk> [http://perma.cc/Y8M7-NFS9].

200. *Morrison Leahy Music Ltd. v. Lightbond Ltd.* (1993) ENTERTAINMENT & MEDIA LAW REPORTS UK EMLR 144.

entitled *Bad Boys Megamix*. George Michael and Morrison Leahy Music Limited sued the defendant to prohibit releasing samples on the project. The U.K. court assessed whether the sampling altered the character of the work, whether the authenticity of the originals were preserved, and whether the lyrics had been modified or changed context.<sup>201</sup> The judge ultimately found that the remix amounted to derogatory treatment and granted an injunction against the defendant.<sup>202</sup> In their article, *UK Copyright and the Limits of Music Sampling*, Julie Ewald and Paul G. Oliver make the case that the current copyright laws in the United Kingdom do not reflect the technological changes that have affected the new methods of music production, and they suggest that both the current law and their interpretation in courts require a more relaxed interpretation in order to avoid damaging creative expression.<sup>203</sup> It should also be noted that “the incidental inclusion of a copyrighted work in an artistic work, sound recording, film or broadcast” is included among the defenses to copyright infringement under U.K. law. Although there have been no cases that used this defense in a digital sampling context, a digital sampling defendant could certainly utilize this statutory language as a defense where the sampling was so insignificant to be a *de minimis* taking.

Canadian law, like the U.S. statute, provides for exclusive rights under copyright that belong to the owner of sound recordings.<sup>204</sup> A *sound recording* means any transmission of signs, signals, writings, images, sounds, or intelligence of any nature by wire, radio, visual, optical, or other electromagnetic system. The Canadian Copyright Act states that “it is an infringement of copyright for any person to do, without the consent of the owner of the copyright, anything that by this Act only the owner of the copyright has the right to do.”<sup>205</sup> Under Canadian law, a sample that uses a substantial part of copyrightable material infringes on that copyright.<sup>206</sup> This begs the question—how do we determine *substantial part*? To determine whether the use of the sample infringes the copyright in a work, the court must determine whether the material used was a

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201. *Id.*

202. *Id.*

203. Julie Ewald, Paul G. Oliver, *UK Copyright and the Limits of UK Music Sampling*, PAPERS.SSRN (January 13, 2017), <https://ssrn.com/abstract=2898820> [<https://perma.cc/2LEN-ATJA>].

204. Alandis Kyle Brassel, *Confused, Frustrated, and Exhausted: Solving the U.S. Digital First Sale Doctrine Problem Through the International Lens*, 48 VAND. J. TRANSNAT’L L. 245, 264 (2015).

205. CANADIAN COPYRIGHT ACT, § 3(1)/1985 (Can.), reprinted in (R.S.C. 1985, c C-42) (consolidated version, status as at December 31, 2012).

206. Andrea R. Bergman, *Toronto Copyright Lawyer: The Legality of Music Sampling*, ZVULONY (2010), <https://zvulony.ca/2010/articles/intellectual-property-law/copyright-law/music-sampling/> [<https://perma.cc/269Q-ZS79>].

substantial part of the plaintiff's material, and whether the material is capable of copyright protection.<sup>207</sup> *Canadian Performing Right Society Ltd. v. Canadian National Exhibition Association*,<sup>208</sup> clarified what was meant by *substantial*, and the definition included whether the work was recognizable by the average lay observer.

In determining whether a substantial part of a musical work has been played, a decision should not be reached merely by comparing the respective lengths of the whole work and of the part played. The fact that a person who heard the part played and who was familiar with the work could identify the work is very important if not conclusive.<sup>209</sup>

The Federal Court of Canada, Trial Division, took a different approach in holding that where the defendant has taken the distinct traits of the original work, a substantial part of the plaintiff's work will have been used.<sup>210</sup> The British Columbia Court of Appeal looked at the qualitative importance of the piece of work used, in relation to the plaintiff's work as a whole.<sup>211</sup> If the piece of music sampled is recognizable to the average listener, or if it is distinctive or qualitatively important to the plaintiff's work, it will likely form a substantial part of the plaintiff's material. In determining whether a substantial part of a musical work has been played, the analysis must go beyond comparing the respective lengths of the alleged infringing portion and the underlying work. The fact that a person who heard the part and who was familiar with the work could identify the work is very important, if not conclusive.<sup>212</sup> Canadian courts also require an inquiry into the originality of the portion of the work that has allegedly been copied. In order for a work to be capable of copyright protection, it must be original. In *Delrina Corp. v. Triolet Systems Inc.*, the Ontario Court of Appeal held that if the piece of music being sampled is not in itself original, there will be no copyright infringement.<sup>213</sup> The natural progression of this approach could arguably include consideration of whether the sampled portion of a sound recording consisted of a sufficiently original expression to render it worthy of

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207. *Id.*

208. *Canadian Performing Right Society Ltd. v. Canadian National Exhibition Association*, (1934) O.R. 610 (Can.).

209. *Id.*

210. *Cie Générale des établissements Michelin - Michelin & Cie v. CAW Canada* (1997 2 FC 306) (Can.).

211. *British Columbia Jockey Club v. Standen (c.o.b. Winbar Publications)* (1985), 8 C.P.R. (3d) 283 British Columbia Court of Appeals [B.C.C.A.].

212. *Canadian Performing Right Society Ltd. v. Canadian National Exhibition Association*, [1934] O.R. 610.

213. *Delrina Corp. v. Triolet Systems, Inc.*, 2002 CanLII 11389, 58 OR (3d) 339.



copyright protection. Sampling could, of course, include portions that are sufficiently original or portions which do not rise to that level. The ratio of originality would certainly inform whether the sampled piece is protectable by copyright.<sup>214</sup> It should be noted that Canadian copyright law makes provisions for moral rights as well. These moral rights belong to the author of a copyrighted work and include the right to the integrity of the work, and the right of association.<sup>215</sup> However, it is likely that these moral rights would only extend to the underlying song due to the fact that in most commercial circumstances, the sound recordings are owned by the record company and moral rights typically only belong to the author of the copyrighted work, i.e., the song.

## VI. CONCLUSION

*“If nature has made any one thing less susceptible than all others of exclusive property, it is the action of the thinking power called an idea. False He who receives an idea from me, receives instruction himself without lessening mine; as he who lights his taper at mine, receives light without darkening me. That ideas should freely spread from one to another over the globe, for the moral and mutual instruction of man, and improvement of his condition, seems to have been peculiarly and benevolently designed by nature.”<sup>216</sup>*

Intellectual property is now the most valuable asset class on the planet.<sup>217</sup> In fact it is likely that the exploitation and development of intellectual property will ultimately transform economies in a manner similar to the transformation caused by the Industrial Revolution.<sup>218</sup> Historically, copyright law has always been applied in a manner that simultaneously encourages creation while enriching the public. The need to encourage creation by providing a limited monopoly is widely regarded as a worthy objective. The enrichment of the public using this

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214. Andrea R. Bergman, *Toronto Copyright Lawyer: The Legality of Music Sampling*, ZVULONY, <https://zvulony.ca/2010/articles/intellectual-property-law/copyright-law/music-sampling/> [https://perma.cc/269Q-ZS79].

215. CANADIAN COPYRIGHT ACT, §§ 17.1, 17.2; *See also* §§ 14.1, 14.2; § 34.2 (1985) (outlining the penalties for infringement of moral rights).

216. Letter from Thomas Jefferson to Isaac MacPherson (Aug. 13, 1813), reprinted in 6 WRITINGS OF THOMAS JEFFERSON, 1790–1826, at 180–81 (H.A. Washington ed., 1854).

217. John P. Ogier, *Intellectual Property, Finance and Economic Development*, WIPO Magazine, February 2016.

218. Scholars view the Industrial Revolution as the most important single development in human history over the past three centuries. PETER N. STEARNS, *THE INDUSTRIAL REVOLUTION IN WORLD HISTORY*, (Taylor & Francis eds., 4th ed. 2013).

methodology relies on greater creative activity being spurred by the reward of limited monopoly, and the greater creative activity providing for greater intellectual and cultural enrichment of those who have access to these copyrighted works. Such access typically includes use of some method of licensing or purchase. However, rewarding creators is only one tactic and must be limited to protect the larger goal of encouraging creation of culture.<sup>219</sup> It is this goal which provides public enrichment by means of having access to public domain works. The same policy rationale that allows unfettered access to public domain works should also provide access to copyrighted works when the access is such that it either (1) does not have a negative impact on the commercial market of the original work; (2) transforms the original work in a significant way; or (3) is quantitatively or qualitatively insignificant, i.e., *de minimis*. The ability of a recording artist or producer to utilize a digital sample that is insignificant on a qualitative or quantitative level, i.e., a use that is *de minimis* using a quantitative analysis, allows for an increased flow of information, ideas, and culture from one creator to another. This increased flow allows for a deeper and more culturally rich society. This is particularly true where the use of the work does not negatively affect the marketplace of original works, and where the underlying work is not recognized in the new work by the ordinary observer. Every creator makes work on the basis of, and in reference and relationship to, existing work.<sup>220</sup> In order to facilitate the continued growth of IP in modern society, U.S. Copyright law should ensure that the modern music creators are not hamstrung by antiquated laws that unreasonably limit digital sampling. Hamstrung is exactly what music creators would be if courts domestically or abroad were to follow the sixth circuit's ill-conceived ruling in *Bridgeport*. The ruling of the ninth circuit in *VMG Salsoul v. Ciccone*<sup>221</sup> and the language of the German Courts in *Metall auf Metall* adequately

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219. PATRICIA AUFDERHEIDE & PETER JASZI, RECLAIMING FAIR USE, HOW TO PUT BALANCE BACK IN COPYRIGHT, 16 (The University of Chicago Press, eds., 2011) (Spanning from approximately 1760 to 1840, the Industrial Revolution was marked by rapidly changing manufacturing processes and fortunes built as economies transitioned from hand production methods, including artisanry and unskilled agrarian labor, to the machine-driven manufacturing, new chemical and iron production processes, and the rise of the factory system. Steel, oil production, transportation (led by railroads), and printing were among the pace-setters in this transition which began in the English textile industries before spreading to other industries and other European countries and eventually north America—primarily in the northeast regions. I would suggest that the information economy is similar in effect to the Industrial Revolution and the rise in importance of intellectual property over the past quarter century will shape the fortunes of corporations and individuals for the foreseeable future, triggering massive changes in the way we live, work, and develop our economic markets.).

220. *Id.* at 21.

221. *VMG Salsoul, LLC, v. Ciccone*, 824 F.3d 871 (9th Cir. 2016).

address this very important policy issue in a manner that is beneficial to creators, copyright owners, and the public.