H. Check Your Head, Get Off Your Ass, and Move to the Music

H.1. Lead-in

Next up! A triple shot of music-industry infringement cases: *Newton v. Diamond* (9th Cir. 2004), *Bridgeport Music v. Dimension Films* (6th Cir. 2005), and *VMG Salsoul v. Ciccone* (9th Cir. 2016).

This trio sings in perfect harmony not at all. It's a caselaw cacophony. From L.A. to Nashville and back to L.A. again, these three cases all concern similar facts, yet they are all over the place analytically. For anyone trying to better understand how infringement claims work in the courts, it's a master class mash-up of arguments, doctrines, tactics, statute provisions, statutory interpretations, and policy approaches. And if the music industry is a particular interest of yours, you'll find this sampling of cases is a perfect playlist for getting a handle on music copyright in the contemporary era.

We said that was a "*sampling*" of cases ;-) Get it? Well, you will!

Don't touch that dial! The Beastie Boys, Funkadelic, N.W.A., and Madonna are all about to share the stage – along with some envelope-pushing flautists and a funk junkie kid guitarist no one can find.

H.2. Newton v. Diamond (9th Cir. 2004)

Pre-reading note

In 1992, hip-hop trio the Beastie Boys – Mike D., MCA, and Ad-Rock – released their third studio album, *Check Your Head*. Track 3 was "Pass the Mic," in which the bandmates take turns passing the mic to one another.

The track starts with a spooky reverberating sound. It's weirdly dissonantly musical. Like a colossal glowing big-rig truck, just emerged from an interdimensional timehole, is throwing on the brakes.

Then wiggy-wiggy-wiggy scratching vinyl and the beat come on.

MCA starts with the mic ("If you can feel what I'm feeling, then it's a musical masterpiece."), passes the mic to Mike D. ("So, what you sayin'? I explode on site! I'm like Jimmy Walker, [*Walker*:] 'I'm dyn-o-mite!'"), who passes the mic to Ad-Rock ("I can't stop, y'all. Tock-tick, y'all. And if you think that you're slick, you'll catch a brick, y'all.").

Underneath the rhymes is a recurring flute riff with an intimidating air. It's three descending notes followed by that same spooky cosmic brake squeal from the start. With the bass and drums, the looped flute creates a mood of menace. Even doom. The sense of it all is: You should be fearful. Yet the Beastie Boys fear not.

When the mic comes back around to MCA, the Brooklynite discloses: "I've been comin' to where I am from the get-go! Find that I can groove with the beat when I let go. So put your worries on hold."

Maybe MCA was able to let go and put his worries on hold because of the assurance that the samples had been cleared. That flute sample came from a 1978 recording of "Choir" by jazz flautist James Newton. But the Beastie Boys had gotten a license from ECM Records for a one-time flat fee of $1,000.

Yet James Newton had not been asked for permission. Nor had he been paid any money. And after the record dropped, Newton sued the Beastie Boys. (The "Diamond" in the case's caption is Michael Diamond – aka "Mike D.")

Newton lost.

The Ninth Circuit Court of Appeals observes that the record label, ECM, owns the copyright in the sound recording, and Newton, who is the songwriter, owns the copyright in the composition. According to the court, the copying of the sound recording was one thing. To the extent the composition was copied, the court says, there was not enough copying to constitute infringement.

Opinion

Edited opinion by JAMES GRIMMELMANN. *Credit and licensing notes:* This edited version of the following judicial opinion, not including the text preceding the judge's words, is by James Grimmelmann, obtained from JAMES GRIMMELMANN, PATTERNS OF INFORMATION LAW: INTELLECTUAL PROPERTY DONE RIGHT (version 1.1, August 2017). I understand the correct copyright notice to be: © 2017 James Grimmelmann. The book is licensed under the Creative Commons Attribution International License 4.0 (CC-BY 4.0) license, available at https://creativecommons.org/licenses/by/4.0/. That license contains a disclaimer of warranties and a statement of limitation of liability. The original work is available at https://james.grimmelmann.net/ipbook/. I made formatting changes, including to typography, pagination, paragraph styling, etc. Italicization may differ. I appended the court's appendices.

Newton v. Diamond

U.S. Court of Appeals for the Ninth Circuit
388 F.3d 1189 (9th Cir. 2004)

JAMES W. NEWTON, JR., dba Janew Music, Plaintiff-Appellant, v. MICHAEL DIAMOND; ADAM HOROWITZ; ADAM YAUCH, dba Beastie Boys; CAPITOL RECORDS, INC., a Delaware Corporation; et al., Defendants-Appellees. Appealed from the U.S. District Court for the Central District of California. D.C. No. CV-00-04909-NM. District Judge Nora M. Manella, presiding. Affirmed. As amended November 9, 2004. Before Chief Judge Mary M. Schroeder and Circuit Judges David R. Thompson and Susan P. Graber. Graber dissented. Opinion by Schroeder.

SCHROEDER, Chief Judge:

The plaintiff and appellant in this case, James W. Newton, is an accomplished avant-garde jazz flutist and composer. In 1978, he composed the song "Choir," a piece for flute and voice intended to incorporate elements of African-American gospel music, Japanese ceremonial court music, traditional African music, and classical music, among others. According to Newton, the song was inspired by his earliest memory of music, watching four women singing in a church in rural Arkansas. In 1981, Newton performed and recorded "Choir" and licensed all rights in the sound recording to ECM Records for $5,000. The license covered only the sound recording, and it is undisputed that Newton retained all rights to the composition of "Choir." Sound recordings and their underlying compositions are separate works with their own distinct copyrights.

The defendants and appellees include the members of the rap and hip-hop group Beastie Boys, and their business associates. In 1992, Beastie Boys obtained a license from ECM Records to use portions of the sound recording of "Choir" in various renditions of their song "Pass the Mic" in exchange for a one-time fee of $1,000. Beastie Boys did not obtain a license from Newton to use the underlying composition. Pursuant to their license from ECM Records, Beastie Boys digitally sampled the opening six seconds of Newton's sound recording of "Choir." Beastie Boys repeated or "looped" this six-second sample as a background element throughout "Pass the Mic," so that it appears over forty times in various renditions of the song.

The portion of the composition at issue consists of three notes, C—D flat—C, sung over a background C note played on the flute. The score to "Choir" also indicates that the entire song should be played in a "largo/senza-misura" tempo, meaning "slowly/without-measure."

Because the defendants were authorized to use the sound recording, our inquiry is confined to whether the unauthorized use of the composition itself was substantial enough to sustain an infringement claim. Therefore, we may consider only Beastie Boys' appropriation of the song's compositional elements and must remove from consideration all the elements unique to Newton's performance. Stated another way, we must "filter out" the licensed elements of the sound recording to get down to the unlicensed elements of the composition, as the composition is the sole basis for Newton's infringement claim. In filtering out the unique performance elements from consideration, and separating them from those found in the composition, we find substantial assistance in the testimony of Newton's own experts, [who] reveal the extent to which the sound recording of "Choir" is the product of Newton's highly developed performance techniques, rather than the result of a generic rendition of the composition. As a general matter, according to Newton's expert Dr. Christopher Dobrian, "the contribution of the performer is often so great that s/he in fact provides as much musical content as the composer." This is particularly true with works like "Choir," given the improvisational nature of jazz performance and the minimal scoring of the composition. Indeed, as Newton's expert Dr. Oliver Wilson explained:

The copyrighted score of "Choir", as is the custom in scores written in the jazz tradition, does not contain indications for all of the musical subtleties that it is assumed the performer-composer of the work will make in the work's performance. The function of the score is more mnemonic in intention than prescriptive.

And it is clear that Newton goes beyond the score in his performance. For example, Dr. Dobrian declared that "Mr. Newton blows and sings in such a way as to emphasize the upper partials of the flute's complex harmonic tone, although such a modification of tone color is not explicitly requested in the score." Dr. Dobrian also concludes that Newton "uses breath control to modify the timbre of the sustained flute note rather extremely" and "uses

portamento to glide expressively from one pitch to another in the vocal part." Dr. Dobrian concedes that these elements do not appear in the score, and that they are part of Newton's performance of the piece.

A crucial problem with the testimony of Newton's experts is that they continually refer to the "sound" produced by the "Newton technique." A sound is protected by copyright law only when it is "fixed in a tangible medium." 17 U.S.C. § 102(a). Here, the only time any sound was fixed in a tangible medium was when a particular performance was recorded. Newton's copyright extends only to the elements that he fixed in a tangible medium – those that he wrote on the score. Thus, regardless of whether the average audience might recognize the "Newton technique" at work in the sampled sound recording, those performance elements are beyond consideration in Newton's claim for infringement of his copyright in the underlying composition.

On the undisputed facts of this record, no reasonable juror could find the sampled portion of the composition to be a quantitatively or qualitatively significant portion of the composition as a whole. Quantitatively, the three-note sequence appears only once in Newton's composition. When played, the segment lasts six seconds and is roughly two percent of the four-and-a-half-minute "Choir" sound recording licensed by Beastie Boys. Qualitatively, this section of the composition is no more significant than any other section. Indeed, with the exception of two notes, the entirety of the scored portions of "Choir" consist of notes separated by whole and half-steps from their neighbors and is played with the same technique of singing and playing the flute simultaneously; the remainder of the composition calls for sections of improvisation that range between 90 and 180 seconds in length.

On the undisputed facts of this case, we conclude that an average audience would not discern Newton's hand as a composer, apart from his talent as a performer, from Beastie Boys' use of the sample. The copying was not significant enough to constitute infringement.

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Commentary from Prof. Grimmelmann:

{Credit and licensing: See the text preceding the Newton v. Diamond opinion.}

The court seems to be either assuming or asserting that Newton's *musical work* copyright is coextensive with what is in the *written score*. Is that right? Note that musical works can be fixed in sheet music, in phonorecords, or as part of an audiovisual work (e.g. a movie), and the Copyright Office will allow any of these to be used as a deposit copy.˜ Would Newton have been better off never writing out sheet music for "Choir" at all?

Post-reading notes

Once bitten, twice jazz flute samplers

The need to fend off a lawsuit was no deterrent to the Beastie Boys' continued obsession with jazz flute from the 1970s. The group's next studio album, 1994's *Ill Communication*, contained the hit single "Sure Shot," hailed by Billboard magazine as "a frantic masterpiece of twisted flutes, barking dogs, and juvenile lyrics."

Indeed, "Sure Shot" would go on to become *the* flute song in the Beastie Boys discography. To everyone outside of legal circles, at least.

This time around the pipe playing was pulled from "Howlin' for Judy" by jazz flautist Jeremy Steig.

The 1970 track is worth checking out. Steig absolutely goes to town on that flute. It's not only a blazing whirlwind of virtuoso instrumental mastery, it is also a marvel of human respiratory ability. One listen will leave you not only gasping but dying to ask Steig: "So what's the story with you and *Judy*?!"

A profile piece about this "pioneer in jazz rock" in *All About Jazz* noted that "Steig began on recorder at age 6," which, if you think about it, is not all that surprising, since literally everyone in America starts on recorder at age 6. But in fairness, not all of us are playing woodwind professionally in Greenwich Village just nine years later.

The write-up by Celeste Sunderland reports Steig was chuffed with the Beastie's borrowing, enjoying his flute work coming back to him through the television when the Beastie Boys performed on *Saturday Night Live*. And while there's no details about the licensing arrangements, Steig apparently got a good deal he didn't have to sue for.

"I made more money from that sample than from any of my records. It saved my life at the time," Steig said, according to the story.

H.3. Bridgeport Music v. Dimension Films (6th Cir. 2005)

Pre-reading notes

"Shit! Goddamn! Get off your ass and jam!"

So begins the lyrics of "Get Off Your Ass and Jam," the 1975 Funkadelic track at the root of *Bridgeport Music v. Dimension Films.*

And, so continues the lyrics, because – and this is potentially *legally important* – those are the only lyrics to the song. Those eight words are repeated 17 times.

Hopefully the reader appreciates the great risk this casebook is taking in reproducing those lyrics here. As the reader may appreciate, this casebook has the sturdy ground of the government edicts doctrine and 17 U.S.C. § 105 for taking as much as it wants from judicial opinions. But for quoting lyrics? This casebook only has arguments regarding substantial appropriation and fair use.

Since a fair-use determination involves considering "the amount and substantiality of the portion used in relation to the copyrighted work as a whole," and since in this case taking eight words means having reproduced *literally all the lyrics to the song*, this casebook can only hope that, if it is sued, the venue will be somewhere other than the plaintiff-friendly confines of the Sixth Circuit.

At any rate, it wasn't the lyrics that were copied in the facts of this case. *{Great. There goes this casebook's argument on "the purpose and character of the use." –Ed.}* What was copied in *Bridgeport* was a portion of the sound recording – a bit of the guitar from the song.

The guitar is a big deal, because at just 2 minutes and 27 seconds, "Get Off Your Ass and Jam" isn't much more than its eight-word vocals (delivered with relaxed enthusiasm sprechgesang-style by a handful of funksters) and its guitar. And the guitar, which starts up periodically when the vocalists need a rest, is AMAZING.

Given how incredible the guitar soloing is and how the work of this guitarist is central to this case, you no doubt would lik to know the identity of the musician.

So would Funkadelic's leader, George Clinton.

The singer/songwriter/producer, honored by critics as "The Prime Minister of Funk," doesn't have the guitarist's name. But Clinton did have a description: "a white kid had wandered into the studio, a smack addict," who was hoping "he could play with us and pick up a little cash in the process."

Clinton says he set the kid up in the studio, ran the track, and then the kid "just started to play like he was possessed. … Even when the song ended, he didn't stop. All of us were up there goggle-eyed, saying, 'Damn.'"

The mystery guitarist received $50 in return. ($25 had been agreed in advance, but Clinton doubled the fee after seeing him play.)

When Clinton tried to find him to have him play on more tracks, the kid wasn't findable.

Fast forward to the 1990s. Compton-bred hip hop group N.W.A. sampled two seconds of the guitar for their 1990 single, and title track on their platinum-selling EP, "100 Miles and Runnin'." Then in 1998, the N.W.A. song was featured in the 1998 Dimension Films' release *I Got the Hook-Up* and it's chart-topping soundtrack album on No Limit Records.

Bridgeport Music, as claimed copyright owner of the composition "Get Off Your Ass and Jam," and Westbound Records, as the asserted owner of the sound recording copyright, went in together on a massive, sampling-focused litigation offensive. Dimension Films and No Limit Records found themselves in the infringement-allegation dragnet.

In an extremely controversial decision – reproduced below – the Sixth Circuit Court of Appeals decided on a bright-line rule for how much copying was required in sound recording cases to meet the threshold for substantial appropriation. The bright-line rule the Sixth Circuit decided on was *any.* As in anything more than zero. As in there is no such thing as "de minimis" when it comes to copyright infringement claims for sound recordings.

If the reactions of legal scholars to the Sixth Circuit's opinion had to be summed up in just one word, that word could well be the first one in the lyrics to the Funkadelic track.

And don't assume George Clinton is on Bridgeport's side in all this. The history of the dealings between Dr. Funkenstein and the Michigan-based music catalog company is somewhat unclear, but Clinton has been scornful and accusatory toward the copyright-claiming entity.

The case of *Bridgeport Music v. Dimension Films* was a monumental one, which has had wide-ranging and long-lasting effects on the music industry.

One can only surmise that having to deal with copyright infringement lawsuits was one factor in propelling N.W.A. member Dr. Dre to look for a change of pace by going into a different line of business.

In 2006, he founded upmarket headphones-maker Beats – enabling Dre to experience getting sued for patent infringement. See *Bose Corporation v. Beats Electronics LLC*, 1:14cv980 (D. Del., complaint filed July 25, 2014).

Opinion

{Edit by EEJ. There's the usual use of the tilde, hash mark, pilcrow and curly brackets to indicate edits. In addition to footnotes and portions of citations being removed without notation, I also removed some paragraph numbering and headers from this case without notation.}

Bridgeport Music, Inc. v. Dimension Films

U.S. Court of Appeals for the Sixth Circuit
410 F.3d 792 (6th Cir. 2005)

Bridgeport Music, Inc.; Westbound Records, Inc., Plaintiffs-Appellants, v. No Limit Films LLC, Defendant-Appellee. Additional plaintiffs being: Southfield Music, Inc.; Nine Records, Inc. Additional defendants being Dimension Films; Miramax Film Corp. Appealed from the U.S. District Court for the Middle District of Tennessee at Nashville. No. 01-00412. Judge Thomas A. Higgins, presiding. Argued March 28, 2005. Argued for appellants: Richard S. Busch, King & Ballow, Nashville, with D'Lesli M. Davis on brief. Argued for appellees: Robert L. Sullivan, Loeb & Loeb, Nashville, with John C. Beiter on brief. For Amici Curiae: Marjorie Heins, Brennan Center for Justice at NYU School of Law; Paul M. Smith, Jenner & Block, Washington, D.C.; Fred von Lohmann, Electronic Frontier Foundation, San Francisco; Todd M. Gascon, San Francisco. Before Circuit Judges GUY and GILMAN; and Judge Judith M. BARZILAY, U.S. Court of International Trade, sitting by designation. Decided June 3, 2005.

RALPH B. GUY, JR., Circuit Judge.

˜This action arises out of the use of a sample from the composition and sound recording "Get Off Your Ass and Jam" ("Get Off") in the rap song "100 Miles and Runnin'" ("100 Miles"), which was included in the sound track of the movie *I Got the Hook Up (Hook Up*). ˜Westbound appeals from the district court's decision to grant summary judgment to defendant on the grounds that the alleged infringement was *de minimis*˜. For the reasons that follow, we reverse˜.

The claims at issue in this appeal were originally asserted in an action filed on May 4, 2001, by the related entities Bridgeport Music, Southfield Music, Westbound Records, and Nine Records, alleging nearly 500 counts against approximately 800 defendants for copyright infringement and various state law claims relating to the use of samples without permission in new rap recordings. In August 2001, the district court severed that original complaint into 476 separate actions, this being one of them, based on the allegedly infringing work and ordered that amended complaints be filed.[2~]

> [2] These are two of eleven appeals arising out of six related lawsuits that have been assigned to this panel for hearing and decision (Nos. 02-6521, 03-5002, 03-5003, 03-5004, 03-5005, 03-5738, 03-5739, 03-5741, 03-5742, 03-5744, 03-5656).

Bridgeport and Westbound claim to own the musical composition and sound recording copyrights{, respectively,} in "Get Off Your Ass and Jam" by George Clinton, Jr. and the Funkadelics. We assume, as did the district court, that plaintiffs would be able to establish ownership in the copyrights they claim. There seems to be no dispute either that "Get Off" was digitally sampled or that the recording "100 Miles" was included on the sound track of *I Got the Hook Up*. Defendant No Limit Films~ released the movie to theaters on May 27, 1998.[~]

Fatal to Bridgeport's claims of infringement{, which concerns the copyright in the composition,} was the Release and Agreement it entered into with two of the original owners of the composition "100 Miles," Ruthless Attack Muzick (RAM) and Dollarz N Sense Music (DNSM), in December 1998, granting a sample use license to RAM, DNSM, and their licensees. Finding that No Limit Films had previously been granted an oral synchronization license to use the composition "100 Miles" in the sound track of *Hook Up*, the district court concluded Bridgeport's claims against No Limit Films were barred by the unambiguous terms of the Release and Agreement.[~]

Westbound's claims are for infringement of the sound recording "Get Off." Because defendant does not deny it, we assume that the sound track of *Hook Up* used portions of "100 Miles" that included the allegedly infringing sample from "Get Off."[¶]

The recording "Get Off" opens with a three-note combination solo guitar "riff" that lasts four seconds. According to one of plaintiffs' experts, Randy Kling, the recording "100 Miles" contains a sample from that guitar solo. Specifically, a two-second sample from the guitar solo was copied, the pitch was lowered, and the copied piece was "looped" and extended to 16 beats. Kling states that this sample appears in the sound recording "100 Miles" in five places; specifically, at 0:49, 1:52, 2:29, 3:20 and 3:46. By the district court's estimation, each looped segment lasted approximately 7 seconds. As for the segment copied from "Get Off," the district court described it as follows:

> The portion of the song at issue here is an arpeggiated chord – that is, three notes that, if struck together, comprise a chord but instead are played one at a time in very quick succession – that is repeated several times at the opening of "Get Off." The arpeggiated chord is played on an unaccompanied electric guitar. The rapidity of the notes and the way they are played produce a high-pitched, whirling sound that captures the listener's attention and creates anticipation of what is to follow.

Bridgeport, 230 F. Supp. 2d at 839. No Limit Films moved for summary judgment, arguing (1) that the sample was not protected by copyright law because it was not "original"; and (2) that the sample was legally insubstantial and therefore does not amount to actionable copying under copyright law.

Mindful of the limited number of notes and chords available to composers, the district court explained that the question turned not on the originality of the chord but, rather, on "the use of and the aural effect produced by the way the notes and the chord are played, especially here where copying of the sound recording is at issue." *Id.* (citations omitted). The district court found, after carefully listening to the recording of "Get Off," "that a jury could reasonably conclude that the way the arpeggiated chord is used and memorialized in the 'Get Off' sound recording is original and creative and therefore entitled to copyright protection." *Id.* (citing *Newton v. Diamond*, 204 F. Supp. 2d 1244, 1249-59 (C.D. Cal. 2002)) (later affirmed on other grounds at 349 F.3d 591 (9th Cir. 2003)). No Limit Films does not appeal from this determination.˜

The district court's decision granting summary judgment is reviewed *de novo*.˜

The heart of Westbound's arguments is the claim that no substantial similarity or *de minimis* inquiry should be undertaken at all when the defendant has not disputed that it digitally sampled a copyrighted sound recording. We agree and accordingly must reverse the grant of summary judgment.˜

The analysis that is appropriate for determining infringement of a musical composition copyright, is not the analysis that is to be applied to determine infringement of a sound recording. We address this issue only as it pertains to sound recording copyrights.˜

Since the district court decision essentially tracked the analysis that is made if a musical composition copyright were at issue, we depart from that analysis.˜

Because of the court's limited technological knowledge in this specialized field, our opinion is limited to an instance of digital sampling of a sound recording protected by a valid copyright. If by analogy it is possible to extend our analysis to other forms of sampling, we leave it to others to do so.

Advances in technology coupled with the advent of the popularity of hip hop or rap music have made instances of digital sampling extremely common and have spawned a plethora of copyright disputes and litigation.

The music industry, as well as the courts, are best served if something approximating a bright-line test can be established. Not necessarily a "one size fits all" test, but one that, at least, adds clarity to what constitutes actionable infringement with regard to the digital sampling of copyrighted sound recordings.

Our analysis begins and largely ends with the applicable statute. Section 114(a) of Title 17 of the United States Code provides: The exclusive rights of the owner of copyright in a sound recording are limited to˜ the following:

> (1) to reproduce the copyrighted work in copies or phonorecords;

> (2) to prepare derivative works based upon the copyrighted work;
>
> (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;˜
>
> (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

Section 114(b) states:

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

Before discussing what we believe to be the import of the above quoted provisions of the statute, a little history is necessary.¶

The copyright laws attempt to strike a balance between protecting original works and stifling further creativity. The provisions, for example, for compulsory licensing make it possible for "creators" to enjoy the fruits of their creations, but not to fence them off from the world at large. 17 U.S.C. § 115.¶

Although musical compositions have always enjoyed copyright protection, it was not until 1971 that sound recordings were subject to a separate copyright. If one were to analogize to a book, it is not the book, *i.e.*, the paper and binding, that is copyrightable, but its contents. There are probably any number of

reasons why the decision was made by Congress to treat a sound recording differently from a book even though both are the medium in which an original work is fixed rather than the creation itself. None the least of them certainly were advances in technology which made the "pirating" of sound recordings an easy task.¶

The balance that was struck was to give sound recording copyright holders the exclusive right "to duplicate the sound recording in the form of phonorecords or copies that directly or indirectly recapture the actual sounds fixed in the recording." 17 U.S.C. § 114(b). This means that the world at large is free to imitate or simulate the creative work fixed in the recording so long as an actual copy of the sound recording itself is not made.¶

That leads us directly to the issue in this case. If you cannot pirate the whole sound recording, can you "lift" or "sample" something less than the whole. Our answer to that question is in the negative. Section 114(b) provides that˜ the rights of sound recording copyright holders under clauses (1) and (2) of section 106 "do not extend to the making or duplication of another sound recording that consists *entirely* of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording." 17 U.S.C. § 114(b) (emphasis added).˜ In other words, a sound recording owner has the exclusive right to "sample" his own recording. We find much to recommend this interpretation.

To begin with, there is ease of enforcement. Get a license or do not sample. We do not see this as stifling creativity in any significant way. It must be remembered that if an artist wants to incorporate a "riff" from another work in his or her recording, he is free to duplicate the sound of that "riff" in the studio. Second, the market will control the license price and keep it within bounds. The sound recording copyright holder cannot exact a license fee greater than what it would cost the person seeking the license to just duplicate the sample in the course of making the new recording. Third, sampling is never accidental. It is not like the case of a composer who has a melody in his head, perhaps not even realizing that the reason he hears this melody is that it is the work of another which he had heard before. When you sample a sound recording you know you are taking another's work product. [12]

[12] The opinion in *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182 (S.D.N.Y. 1991), one of the first cases to deal with digital sampling, begins with the phrase, "'Thou shalt not steal.'" *Id*. at 183 (quoting *Exodus* 20:15).

This analysis admittedly raises the question of why one should, without infringing, be able to take three notes from a musical composition, for example, but not three notes by way of sampling from a sound recording. Why is there no *de minimis* taking or why should substantial similarity not enter the equation. Our first answer to this question is what we have earlier indicated. We think this result is dictated by the applicable statute. Second, even when a small part of a sound recording is sampled, the part taken is something of value. No further proof of that is necessary than the fact that the producer of the record or the artist on the record intentionally sampled because it would (1) save costs, or (2) add something to the new recording, or (3) both. For the sound recording copyright holder, it is not the "song" but the sounds that are fixed in the medium of his choice. When those sounds are sampled they are taken directly from that fixed medium. It is a physical taking rather than an intellectual one.

This case also illustrates the kind of mental, musicological, and technological gymnastics that would have to be employed if one were to adopt a *de minimis* or substantial similarity analysis. The district judge did an excellent job of navigating these troubled waters, but not without dint of great effort. When one considers that he has hundreds of other cases all involving different samples from different songs, the value of a principled bright-line rule becomes apparent.¶

We would want to emphasize, however, that considerations of judicial economy are not what drives this opinion. If any consideration of economy is involved it is that of the music industry. As this case and other companion cases make clear, it would appear to be cheaper to license than to litigate.

These conclusions require us to reverse the entry of summary judgment˜. Since the district judge found no infringement, there was no necessity to consider˜ "fair use." On remand, the trial judge is free to consider this defense and we express no opinion on its applicability to these facts.

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H.4. VMG Salsoul v. Ciccone (9th Cir. 2016)

Pre-reading notes

Did the 1970s even exist for any reason other than to be sampled?

Here we go again.

In this case, Madonna is sued over the brass horn blast whose recurrent appearance is one of the signatures of her 1990 megahit "Vogue."

VMG Salsoul brought the litigation as the owner of the sound recording copyright in a song the opinion refers to as Salsoul Orchestra's "Love Break."

You may want to listen to the song and want to know the full title. Hmmm. Well, Salsoul Orchestra was a house band of Salsoul Records. comprising as many as four dozen members (some of which played brass horns, of course). Flipping through Salsoul Orchestra vinyl, you can see that there's a lot of remixed – or *recycled* – (pick what word you like) content. Listening to a bit here and a bit there of Salsoul Orchestra, you get the sense that the endeavor was mostly about continuing to churn out music for roller rinks. It's a lot of extended instrumental tracks formed around a consistent groove but with an aimlessly wandering arrangement. (Meaning there's always another song to sew together from the same swatches of polyester fabric.)

The song/variant with horn hits sounding the most like the brass blasts from "Vogue" may be the one titled "Ooh, I Love It (Love Break)." Many sources date the song to the 1980s, but do not for a minute think this is an 80s track. Whatever its merits, there's no denying it is the most disco and the most stuck-in-the-70s song that has ever been recorded.

The original district court complaint actually refers to the song as "Chicago Bust Stop (Ooh, I Love It)" and alleges that the song was released "in or about 1977."

That's funny, because music maven website Discogs.com has a picture of a single with that title and artist with a clearly readable "℗ 1975" for a copyright date. One wonders how the plaintiff couldn't figure out any better allegation than "in or about 1977." But they may have been writing the complaint while roller skating and had only the light of a mirror ball to see by.

Meanwhile, "Vogue" made a clear mark on the year 1990 and was hailed as that year's summer anthem. The infectiously danceable track has Madonna doing a séance-like incantation of golden Hollywood celebrity names and

making repeated exhortations insisting that you, the listener, must "strike a pose" and "move to the music."

Hailing from Bay City, Michigan, Madonna is Sixth Circuit born and bred. But she must have been happy with her adopted home appellate jurisdiction, because the Ninth Circuit dealt the Sixth Circuit's *Bridgeport* opinion a serious drubbing here. The "Queen of Pop" won her case, putting legal precedential muscle behind her teaching in "Vogue" to "[G]o with the flow: You know you can do it."

Opinion

Edited opinion by James Grimmelmann. *Credit and licensing notes:* This edited version of the following judicial opinion, not including the text preceding the judge's words, is by James Grimmelmann, obtained from James Grimmelmann, Patterns of Information Law: Intellectual Property Done Right (version 1.1, August 2017). I understand the correct copyright notice to be: © 2017 James Grimmelmann. The book is licensed under the Creative Commons Attribution International License 4.0 (CC-BY 4.0) license, available at https://creativecommons.org/licenses/by/4.0/. That license contains a disclaimer of warranties and a statement of limitation of liability. The original work is available at https://james.grimmelmann.net/ipbook/. I made formatting changes, including to typography, pagination, paragraph styling, etc. Italicization may differ. I appended the court's appendices.

VMG Salsoul, LLC v. Madonna Louise Ciccone

U.S. Court of Appeals for the Ninth Circuit
824 F.3d 871 (9th Cir. 2016)

VMG SALSOUL, LLC, Plaintiff-Appellant, v. MADONNA LOUISE CICCONE, professionally known as Madonna; SHEP PETTIBONE; WB MUSIC CORPORATION; WEBO GIRL PUBLISHING, INC.; LEXOR MUSIC, INC.; WARNER MUSIC GROUP; WARNER BROS. RECORDS, INC., Defendants-Appellees. Nos. 13-57104 14-55837. Appealed from the U.S. District Court for the Central District of California, 2:12-cv-05967-BRO-CW, District Judge Beverly Reid O'Connell presiding. Argued April 5, 2016 in Pasadena. Counsel for Plaintiff-Appellant: Robert S. Besser (argued) and Christopher Chapin, Santa Monica. Counsel for Defendants-Appellees: Alexander Kaplan (argued), Sandra A. Crawshaw-Sparks, and Susan L. Gutierrez, Proskauer Rose LLP, New York, N.Y. and Los Angeles; Richard S. Busch (argued) and Paul H. Duvall, King & Ballow, San Diego. Filed June 2, 2016. Summary judgment for defendants affirmed, an award vacated. Before Circuit Judges Barry G. Silverman and Susan P. Graber and District Judge David A. Ezra, sitting by designation. Opinion by Graber. Dissent by Silverman.

GRABER, Circuit Judge:

In the early 1990s, pop star Madonna Louise Ciccone, commonly known by her first name only, released the song Vogue to great commercial success. In this copyright infringement action, Plaintiff VMG Salsoul, LLC, alleges that the producer of Vogue, Shep Pettibone, copied a 0.23-second segment of horns from an earlier song, known as Love Break, and used a modified version of that snippet when recording Vogue. Plaintiff asserts that Defendants Madonna, Pettibone, and others thereby violated Plaintiff's copyrights to Love Break.

Plaintiff has submitted evidence of actual copying. In particular, Tony Shimkin has sworn that he, as Pettibone's personal assistant, helped with the creation of Vogue and that, in Shimkin's presence, Pettibone directed an engineer to introduce sounds from Love Break into the recording of Vogue. Additionally, Plaintiff submitted reports from music experts who concluded that the horn hits in Vogue were sampled from Love Break.

Plaintiff argues that even if the copying here is trivial, that fact is irrelevant because the de minimis exception does not apply to infringements of copyrighted sound recordings. Plaintiff urges us to follow the Sixth Circuit's decision in *Bridgeport*, which adopted a bright-line rule: For copyrighted sound recordings, any unauthorized copying—no matter how trivial—constitutes infringement.

We squarely held in *Newton* that the de minimis exception applies to claims of infringement of a copyrighted composition. But it is an open question in this circuit whether the exception applies to claims of infringement of a copyrighted sound recording.

A straightforward reading of the third sentence in § 114(b) reveals Congress' intended limitation on the rights of a sound recording copyright holder: A new recording that mimics the copyrighted recording is not an infringement, even if the mimicking is very well done, so long as there was no actual copying. That is, if a band played and recorded its own version of Love Break in a way that sounded very similar to the copyrighted recording of Love Break, then there would be no infringement so long as there was no actual copying of the recorded Love Break. But the quoted passage does not speak to the question that we face: whether Congress intended to eliminate

the longstanding de minimis exception for sound recordings in all circumstances even where, as here, the new sound recording as a whole sounds nothing like the original.

We disagree [with *Bridgeport*'s "physical taking" analysis] for three reasons. First, the possibility of a "physical taking" exists with respect to other kinds of artistic works as well, such as photographs, as to which the usual de minimis rule applies. *See*, *e.g.*, *Sandoval v. New Line Cinema Corp*. (affirming summary judgment to the defendant because the defendant's use of the plaintiff's photographs in a movie was de minimis). A computer program can, for instance, "sample" a piece of one photograph and insert it into another photograph or work of art. We are aware of no copyright case carving out an exception to the de minimis requirement in that context, and we can think of no principled reason to differentiate one kind of "physical taking" from another. Second, even accepting the premise that sound recordings differ qualitatively from other copyrighted works and therefore could warrant a different infringement rule, that theoretical difference does not mean that Congress actually adopted a different rule. Third, the distinction between a "physical taking" and an "intellectual one," premised in part on "saving costs" by not having to hire musicians, does not advance the Sixth Circuit's view. The Supreme Court has held unequivocally that the Copyright Act protects only the expressive aspects of a copyrighted work, and not the "fruit of the [author's] labor." *Feist*. Indeed, the Supreme Court in *Feist* explained at length why, though that result may seem unfair, protecting only the expressive aspects of a copyrighted work is actually a key part of the design of the copyright laws. Accordingly, all that remains of *Bridgeport*'s argument is that the second artist has taken some expressive content from the original artist. But that is always true, regardless of the nature of the work, and the de minimis test nevertheless applies.

We hold that the "de minimis" exception applies to actions alleging infringement of a copyright to sound recordings.

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{END OF PART SIX ("Story Arc 6")}