



TOURO UNIVERSITY
JACOB D. FUCHSBERG LAW CENTER
Where Knowledge and Values Meet

Touro Law Review

Volume 34
Number 4 *Dedicated to Professor Ilene Barshay*

Article 13

2018

The De Minimis Defense in Sound Recordings: How a Trivial Claim Leads to a Big Question

Elvin Canario

Follow this and additional works at: <https://digitalcommons.tourolaw.edu/lawreview>



Part of the [Intellectual Property Law Commons](#)

Recommended Citation

Canario, Elvin (2018) "The De Minimis Defense in Sound Recordings: How a Trivial Claim Leads to a Big Question," *Touro Law Review*. Vol. 34: No. 4, Article 13.

Available at: <https://digitalcommons.tourolaw.edu/lawreview/vol34/iss4/13>

This Article is brought to you for free and open access by Digital Commons @ Touro Law Center. It has been accepted for inclusion in Touro Law Review by an authorized editor of Digital Commons @ Touro Law Center. For more information, please contact lross@tourolaw.edu.

THE *DE MINIMIS* DEFENSE IN SOUND RECORDINGS: HOW A TRIVIAL CLAIM LEADS TO A BIG QUESTION

*Elvin Canario**

I. INTRODUCTION

With regard to copyright, James Madison said in 1788 “[t]he utility of this power will scarcely be questioned.”¹ If here today, it is safe to say, Madison would be shocked at the number of controversies and questions surrounding this “power.” With the emergence of technology, these controversies have only become more convoluted.² For example, courts have conflicting viewpoints on what rights are protected by copyright.³ It was not until the 1970s that sound recordings were brought into the ambit of copyright protections.⁴ Since then, there has been, and continues to be, much debate in this area of law.⁵ Copyright law surrounding sound recordings has become more relevant because of advancements and progressions in musical technology. This musical technology now permits sounds to be copied

* J.D. Candidate 2020, Touro College Jacob D. Fuchsberg Law Center; B.A. in Political Science, *Cum Laude*, Stony Brook University, 2016. First and foremost, I would like to thank God. I would also like to thank my wonderful family who give me my motivation to keep trying my hardest every day. Finally, I would like to thank the remarkable personnel of Touro Law, from our professors to our Law Review staff, to just speaking with friends before class; everyone here has, in some way, helped to contribute to the accomplishment of this Note.

¹ James Madison, *Federalist*, No. 43, 288, FOUNDERS CONST., Jan. 23, 1788, http://press-pubs.uchicago.edu/founders/documents/a1_8_8s7.html.

² Nicole Lieberman, *Un-Blurring Substantial Similarity: Aesthetic Judgments and Romantic Authorship in Music Copyright Law*, 6 N.Y.U. J. INTELL. PROP. & ENT. L. 91, 125 (2016).

³ 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).

⁴ Lieberman, *supra* note 2, at 99.

⁵ See generally Marsha A. Willis, *Unauthorized Digital Sound Sampling, the Taking of a Constitutional Right*, 17 S.U. L. REV. 309 (1990).

and replayed at the push of a button, allowing for many songs and other sounds that musicians or producers have created to easily be pirated.⁶

Regarding copyright protection of sound recordings, questions remain as to the defenses that are available to alleged infringers when “sampling” technology is used.⁷ The sound recording industry defines sampling as, “taking a snippet of a song and repurposing it.”⁸ After a plaintiff establishes the initial burden of proving an actual copying of his work,⁹ the applicable defenses differ depending on the federal district court in which the suit is brought.¹⁰ If a court was in a district that adopts the bright-line rule, which says that any form of conceded-to copying of a sound recording requires a license, then fair use will arguably be the only viable defense.¹¹ However, if the suit is brought in a district which has considered certain types of sampling trivial, then the *de minimis* defense will be available.¹²

This Note explores the idea that courts should apply the bright-line rule,¹³ allowing for fair use¹⁴ as the only reasonable defense for conceded-to sampling of sound recordings, until Congress takes an alternative approach. Section II provides definitions and history of key terms and laws that will be used throughout this Note. Section III explains the position of the Sixth Circuit, which generally finds that samplers of sound recordings should not be allowed to use the *de minimis* defense. Contrarily, Section IV discusses the Ninth Circuit’s analysis in favor of such a defense. Section V discusses possible unforeseen complications that a *de minimis* exception for sampling

⁶ See Bruce J. McGiverin, *Digital Sound Sampling, Copyright and Publicity: Protecting Against the Electronic Appropriation of Sounds*, 87 COLUM. L. REV. 1723, 1723 (1987) (“digital sound sampling[’s] . . . current use in the music industry poses a threat both to the value of musicians’ recorded work and to their professional identities.”).

⁷ See *Bridgeport*, 410 F.3d at 792; see also *VMG Salsoul*, 824 F.3d at 871.

⁸ *Digital Music Sampling: Creativity or Criminality?*, NAT’L PUB. RADIO, INC., (Jan. 28, 2011, 1:00 PM), <http://www.npr.org/2011/01/28/133306353/Digital-Music-Sampling-Creativity-Or-Criminality>.

⁹ See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

¹⁰ See *Bridgeport*, 410 F.3d at 792; see also *VMG Salsoul*, 824 F.3d at 871.

¹¹ See *Bridgeport*, 410 F.3d at 805 (“These conclusions require us to reverse the entry of summary judgment entered . . . Since the district judge found no infringement, there was no necessity to consider the affirmative defense of ‘fair use.’ On remand, the trial judge is free to consider this defense and we express no opinion on its applicability to these facts.”).

¹² See *VMG Salsoul*, 824 F.3d at 871 (allowing the *de minimis* defense in sound recording infringement cases).

¹³ See *Bridgeport*, 410 F.3d at 792.

¹⁴ 17 U.S.C. § 107 (2018).

could bring about. Section V finishes with some possible resolutions that courts could use until the circuit split is resolved.

II. HISTORY OF COPYRIGHT AND RELEVANT DEFINITIONS

Copyright protections are derived directly from the United States Constitution.¹⁵ As indicated in Article 1, Section 8, Clause 8 of the Constitution, the purpose of copyright law is “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”¹⁶ Accordingly, it is clear that Congress takes into account two factors when legislating copyright law: (1) protecting original works and (2) avoiding the stifling of creativity.¹⁷ The Founding Fathers believed that creating laws that would punish people for the unauthorized copying of another’s work would serve as a deterrent and allow a creator to have assurances that his works would not be stolen, which provides him with a limited monopoly to his work.¹⁸ However, under narrow circumstances, unauthorized users of the copyrighted work can use the work without legal implications by arguing that such use was fair, which stems back to the common law and is now codified.¹⁹ The purpose of this fair use defense was and continues to be to prevent overprotection of copyrights, encompassing the idea that not allowing anyone to use any work for any purpose goes against the very reason why Congress created the copyright laws with its legislative power granted by the Constitution.²⁰

¹⁵ U.S. CONST. art. 1, § 8, cl. 8.

¹⁶ *Id.*

¹⁷ See *Bridgeport*, 410 F.3d at 800.

¹⁸ See *Copyright Timeline: A History of Copyright in the United States*, ASS’N RES. LIBR., <http://www.arl.org/focus-areas/copyright-ip/2486-copyright-timeline#.WsFFpojwbIU> (last visited Nov. 14, 2018) (“The law was meant to provide an incentive to authors, artists, and scientists to create original works by providing creators with a monopoly.”).

¹⁹ See Martine Courant Rife, *The Fair Use Doctrine: History, Application, and Implications for (New Media) Writing Teachers*, 24 *COMPUTERS & COMPOSITIONS* 154, 158 (2007), https://msu.edu/~mcgrat71/Writing/Fair_Use_Rife.pdf (“Section 107, as part of the 1976 Copyright Act, defines fair use and sets forth what is commonly known as the four-factor test. Previous to this legislation, fair use was not clearly defined in any code—but was defined through extrapolating holdings and discussions in U.S. Case Law”); see also *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994); *Authors Guild v. Google, Inc.*, 804 F.3d 202 (2d Cir. 2015).

²⁰ Cf. *Fair Use*, STAN. U. LIBR., <https://fairuse.stanford.edu/overview/fair-use/> (last visited Nov. 14, 2018) (“Fair use is a copyright principle based on the belief that the public is entitled to freely use portions of copyrighted materials for purposes of commentary and criticism. For

The United States Supreme Court has established a two-part test to determine whether copyright infringement has occurred. The test includes: (1) establishment of ownership of a valid copyright, and (2) the copying of constituent elements of the work that are considered to be original to the copyright holder.²¹ If there is no direct evidence of copying, the plaintiff can prove the second element through circumstantial evidence by a showing of substantial similarity between the two works at issue.²²

The copyright law for sound recordings is a relatively new area in the field of copyright, the protections of such sound recordings becoming codified in the 1970s.²³ 17 U.S.C. § 114 specifically provides for copyright protections of sound recordings. 17 U.S.C. § 114(b) provides for the exclusive rights and limitations given to copyright holders of sound recordings.²⁴ The disagreements between

example, if you wish to criticize a novelist, you should have the freedom to quote a portion of the novelist's work without asking permission. Absent this freedom, copyright owners could stifle any negative comments about their work."); *see also* ALAN LATMAN, 12 NIMMER ON COPYRIGHT I (1958).

²¹ Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991).

²² Unicolors, Inc. v. Urban Outfitters, Inc., 853 F.3d 980, 984 (9th Cir. 2017).

²³ Lieberman, *supra* note 2, at 99. For background on why sound recordings were not protected until this time, *see infra* text accompanying notes 86-94.

²⁴ 17 U.S.C. § 114 provides:

(a) The exclusive rights of the owner of copyright in a sound recording are limited to the rights specified by clauses (1), (2), (3) and (6) of section 106, and do not include any right of performance under section 106(4).

(b) The exclusive right of the owner of copyright in a sound recording under clause (1) of section 106 is limited to the right to duplicate the sound recording in the form of phonorecords or copies that directly or indirectly recapture the actual sounds fixed in the recording. The exclusive right of the owner of copyright in a sound recording under clause (2) of section 106 is limited to the right to prepare a derivative work in which the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality. The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording. The exclusive rights of the owner of copyright in a sound recording under clauses (1), (2), and (3) of section 106 do not apply to sound recordings included in educational television and radio programs (as defined in section 397 of title 47) distributed or transmitted by or through public broadcasting entities (as defined by section 118(f)): *Provided*, That copies or phonorecords of said programs are not commercially distributed by or through public broadcasting entities to the general public.

17 U.S.C. § 114 (2018) (emphasis in original).

the Sixth and Ninth Circuits mainly revolve around this portion of the statute and its interpretations, particularly regarding the protections it affords artists using the sampling technique.

Black's Law Dictionary defines sampling as "[t]he process of taking a small portion of a sound recording and digitally manipulating it as part of a new recording."²⁵ Others have defined the technique a bit more passionately, as one author describes:

To sample is to cut up: mine the archive; *steal to subvert*; recycle footage; assist a readymade; appropriate invention; elevate the fragment; drift through sequences of signs . . . question the act of watching . . . raise the dead . . . become a curator; open up the cultural database . . . *eviscerate the author*; materialize associative actions.²⁶

A person who engages in the process of sampling can achieve sampling through a variety of means;²⁷ a common method used to sample is through a synthesizer.²⁸ This process requires just the touch of a button to incorporate the sampled sound into the new work,²⁹ saving the sampler time and money of having to re-record a piece of music he wants to use.³⁰

Technological innovations eventually prompted Congress to make amendments to existing copyright law to give these new forms of intellectual property their own distinct protections.³¹ However, there are currently only two circuits courts that have addressed the issue of whether a sampler can use the *de minimis* doctrine as an

²⁵ *Sampling*, BLACK'S LAW DICTIONARY (10th ed. 2014).

²⁶ READINGS IN LAW AND POPULAR CULTURE 277 (Steve Greenfield & Guy Osborn eds., 2006) (alteration in original) (emphasis added).

²⁷ Francesco Di Cosmo, *Return of the De Minimis Exception in Digital Music Sampling: The 9th Circuit's Recent Holding in VMG Salsoul Improves Upon the 6th Circuit's Holding in Bridgeport, But Raises Questions of its Own*, 95 WASH. U. L. REV. 227 (2017).

²⁸ McGiverin, *supra* note 6.

²⁹ McGiverin, *supra* note 6, at 1725.

³⁰ *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 802 n.14 (6th Cir. 2005) ("Thus sampling of records . . . allows a producer of music to save money (by not hiring a musician) without sacrificing the sound and phrasing of a live musician in the song."); *see also id.* at 802 n.7.

³¹ *See* H.R. REP. NO. 94-1476, at 51 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5660; *see also* Willis, *supra* note 5, at 323.

affirmative defense against infringement claims for sampled sound recordings.³²

De minimis is short for the Latin phrase *de minimis non curat lex*, which translates to “[t]he law does not concern itself with trifles.”³³ This doctrine holds that if a defendant can prove that the allegations or harms alleged by the plaintiff are trivial, this fact alone stands as an affirmative defense to the charge.³⁴ Since the Supreme Court’s introduction of the *de minimis* standard in 1796,³⁵ there are now many fields of law that apply this doctrine, such as taxation, labor unions, and voter disenfranchisement.³⁶ The term *de minimis* was used in copyright disputes as early as 1847.³⁷ In analyzing the *de minimis* standard in copyright law, the courts tend to focus on whether the copied portion was “substantial” enough to constitute actual copying of a protected work.³⁸ Accordingly, the courts have found that the *de minimis* standard applied in cases involving the copying of

³² *Bridgeport*, 410 F.3d at 792; *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871 (9th Cir. 2016). Although no other circuit court has decided on this exact issue, there are courts that have made rulings on digital sampling, namely courts in the First, Second, Fourth, and Fifth Circuits. See, e.g., *Arista Records, LLC v. Does 1-27*, No. 07-162-B-W, 2008 WL 222283, at *1 (D. Me. Jan. 25, 2008), *aff’d*, 584 F. Supp. 2d 240 (D. Me. 2008); *Poindexter v. EMI Record Grp. Inc.*, No. 11 CIV. 559(LTS)(JLC), 2012 WL 1027639 (S.D.N.Y. Mar. 27, 2012); *Curlington v. UMG Recordings, Inc.*, No. 1:10-CV-890, 2011 WL 3568278 (M.D.N.C. Aug. 12, 2011), *aff’d*, 468 F. App’x 304 (4th Cir. 2012); *Batiste v. Island Records Inc.*, 179 F.3d 217 (5th Cir. 1999).

³³ *De Minimis Non Curat Lex*, BLACK’S LAW DICTIONARY (10th ed. 2014).

³⁴ *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215, 217 (2d Cir. 1998) (“To establish that the infringement of a copyright is *de minimis*, and therefore not actionable, the alleged infringer must demonstrate that the copying of the protected material is so trivial as to fall below the quantitative threshold of substantial similarity, which is always a required element of actionable copying.” (emphasis in original) (internal quotation marks omitted)).

³⁵ Jeffrey Brown, *How Much Is Too Much? The Application of the De Minimis Doctrine to the Fourth Amendment*, 82 Miss. L.J. 1097, 1099 (2013).

³⁶ *Id.* at 1100-02.

³⁷ *Webb v. Powers*, 29 F. Cas. 511, 520 (C.C.D. Mass. 1847) (No. 17,323) (“A novelty in arrangement, especially so trifling as this, without any new material connected with it, seemed to him, and still seems to him to be, of questionable sufficiency to be protected by a copyright. The master seemed to be of the same opinion, on the ground ‘De minimis non curat lex.’ Slight changes, like the use of chapters and verses, where none existed before, as some hundreds of years ago in the Bible, or the introduction of punctuation, which is said not now to exist generally in acts of parliament, or the use of sections instead of pages, which in modern times is reviving only an ancient practice, would all have higher claims to novelty and usefulness, than merely transferring the same material from one page at the end to another in the central part of a book, as here.”).

³⁸ See *Sandoval*, 147 F.3d at 215; see also *Gottlieb Dev. LLC v. Paramount Pictures Corp.*, 590 F. Supp. 2d 625 (S.D.N.Y. 2008); *Ringgold v. Black Entm’t Television, Inc.*, 126 F.3d 70 (2d Cir. 1997); *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp., Inc.*, 150 F.3d 132 (2d Cir. 1998).

photographs,³⁹ pinball machines⁴⁰ in the background of movies, television programs⁴¹ and books; in each of these cases, the *de minimis* defense prevailed and, consequently, prevented recovery.⁴²

III. SAMPLING AND COPYRIGHT AS INTERPRETED BY THE SIXTH CIRCUIT

The most prominent case stemming from the Sixth Circuit regarding sampling is *Bridgeport Music, Inc. v. Dimension Films*.⁴³ In this case, the issue before the court was whether a three-note combination from a solo guitar, sampled from the sound recording “Get Off Your Ass and Jam,” constituted copyright infringement.⁴⁴ The sample was first inserted in the song “100 Miles and Runnin’,” which was subsequently included on the sound track of the defendant’s movie “I Got The Hook Up.”⁴⁵ The district court undertook the *de minimis* analysis and determined that, although the defendant did not deny using the plaintiff’s sampled work, the portion was relatively unsubstantial and not enough to constitute infringement.⁴⁶ However, the Sixth Circuit reversed the decision of the district court, determining that the district court’s analysis was erroneous.⁴⁷ The Sixth Circuit held that, under its interpretation of 17 U.S.C. § 114, a copyright holder is the only person that can legally sample from his work. Thus, the *de minimis* inquiry is not necessary when a defendant has sampled a copyrighted sound recording because no amount of the work could legally be sampled without the copyright holder’s authorization.⁴⁸ With this holding, the Sixth Circuit created a bright-line rule by eliminating the *de minimis* inquiry⁴⁹ for digital sampling of copyright protected sound recordings; if anyone wanted to sample any amount of a protected sound recording, he would need to get a license.⁵⁰ The

³⁹ *Sandoval*, 147 F.3d at 215.

⁴⁰ *Gottlieb*, 590 F. Supp. 2d at 625.

⁴¹ *Ringgold*, 126 F.3d at 70.

⁴² *Castle Rock*, 150 F.3d at 132.

⁴³ *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792 (6th Cir. 2005).

⁴⁴ *Id.* at 795.

⁴⁵ *Id.*

⁴⁶ *Id.* at 797.

⁴⁷ *Id.* at 798.

⁴⁸ *Bridgeport*, 410 F.3d at 801-02.

⁴⁹ And, thus, the *de minimis* defense.

⁵⁰ *Bridgeport*, 410 F.3d at 801.

Sixth Circuit believed this new bright-line rule would clarify the judicial approach to cases involving sampling infringement.⁵¹

A. The Sixth Circuit's Statutory Interpretation of 17 U.S.C. § 114(b)

The Sixth Circuit did not analyze the statute's legislative history because digital sampling had not yet been created when Congress enacted 17 U.S.C. § 114(b).⁵² Instead, the court did a "literal reading"⁵³ of the statute and discussed why sound recordings needed their own copyright protections.⁵⁴ The court first mentioned that Congress expressed a need to amend the statute because it wanted to prevent the pirating of sound recordings, which was increasing with technological advancements.⁵⁵ The court then looked at the plain meaning of 17 U.S.C. § 114 (b) and determined 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."⁵⁶ From this understanding, the court boiled down the question of sampling a sound recording to, "[i]f you cannot pirate the whole sound recording, can you 'lift' or 'sample' something less than the whole?"⁵⁷ The court held in the negative.⁵⁸

1. The Sixth Circuit's Plain Meaning Interpretation of 17 U.S.C § 114(b)

The Sixth Circuit in *Bridgeport* began its plain meaning analysis focusing on 17 U.S.C. § 114(b).⁵⁹ It determined that the language of the statute gave the owner of a copyright the exclusive right to sample his own recording.⁶⁰ The court held that sampling constituted a version of a derivative work⁶¹ and, because section 114(b)

⁵¹ *Id.* at 799.

⁵² *See id.* at 805.

⁵³ *Id.*

⁵⁴ *Id.* at 800.

⁵⁵ *Bridgeport*, 410 F.3d at 800.

⁵⁶ *Id.*

⁵⁷ *Id.*

⁵⁸ *Id.*

⁵⁹ *Id.*

⁶⁰ *Bridgeport*, 410 F.3d at 801.

⁶¹ 17 U.S.C. § 101 (2018) ("A 'derivative work' is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization,

granted the exclusive right to prepare a derivative work, copyright holders had that same exclusive right in sampling their own work.⁶² The Sixth Circuit based its decision on the fact that, prior to the amendments, the word “entirely” was not included in the language of the statute.⁶³ An author creates a derivative work if the new work contains a sample from one of his original works, and because this new derivative work does not consist “*entirely* of independent fixation of *other* sounds,” his exclusive right to prepare such derivative works applies.⁶⁴

The Sixth Circuit reasoned that, because Congress explicitly inserted the word “entirely” into section 114(b), its intent was for future techniques, like sampling, to satisfy the requirement.⁶⁵ Any amount of an author’s protected work that is incorporated into another work constitutes a derivative of the protected work and only the copyright holder is authorized to make such a work because he has the exclusive right to prepare derivative works of his sound recordings in accordance with the statute.⁶⁶ Moreover, the Sixth Circuit reasoned that the reverse also holds true in which a copyright holder cannot extend his rights in a particular sound recording to a new work if the new work consisted “entirely” of other independent sounds.⁶⁷ Without encompassing *any* of the actual fixed sounds from his original sound recording, the new work could not be considered a derivative and, thus, would not be protected.⁶⁸ Further, the exclusive right to prepare derivative works applies to sampling because sampling is considered a derivative work when incorporating actual sounds from a protected work into a new work, and this new derivative work is not entirely

motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a ‘derivative work.’”); *Id.* § 106(2) (2018) (“Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights . . . to prepare derivative works based upon the copyrighted work.”).

⁶² See *Bridgeport*, 410 F.3d at 800-01 n.10.

⁶³ *Id.* at 800-01 (“The significance of this provision is amplified by the fact that the Copyright Act of 1976 added the word ‘entirely’ to this language. Compare Sound Recording Act of 1971, Pub. L. 92-140, 85 Stat. 391 (Oct. 15, 1971)”).

⁶⁴ See *id.* at 800-01 n.10 (first emphasis in original).

⁶⁵ See *id.* at 800-01.

⁶⁶ See *id.*

⁶⁷ See *Bridgeport*, 410 F.3d at 800.

⁶⁸ See *id.* at 800-01.

independent of actual protected sounds.⁶⁹ Thus, the court held that “a sound recording owner has the exclusive right to ‘sample’ his *own* recoding.”⁷⁰

The Sixth Circuit’s determination that sampling constitutes an instance where sounds from a sound recording are either “rearranged, remixed or otherwise altered,”⁷¹ thus allowing for their protection under 17 U.S.C. § 114(b) as a derivative work,⁷² is supportable. Tunecore.com is a prominent website that deals with the licensing and the selling of music.⁷³ In an article posted on its website, professor and former president of Rykodisc record label, George Howard, said:

[B]ecause a sample is a derivative work, you cannot sample someone else’s copyrighted work without permission.

Note that there are actually often two copyrights that must be addressed when a work is sampled (and thus two copyright holders you must get permission from in order to avoid infringing):

The copyright to the song itself [and] the copyright to the version of the song (i.e. the master)

...

Should they not reject the request outright, they will negotiate with you to attempt to come to terms allowing your creation of a derivative work. Unlike mechanicals there’s no statutory maximum rate for samples, so publishers and master holders will get everything they can—including the rights to the copyright of the song that is using their sample—in the negotiations.

A lesser-known approach to sampling is often referred to as a “replay.” This is where a derivative work is

⁶⁹ See *id.* at 800-01 n.10.

⁷⁰ *Id.* at 800-01 (emphasis added).

⁷¹ See *id.* at 800-01 n.10; 17 U.S.C. § 114 (2018).

⁷² See *Bridgeport*, 410 F.3d at 800-01 n.10; 17 U.S.C. § 114.

⁷³ Ogden Payne, *What Tunecore’s \$1B In Revenue Means For Independent Musicians Worldwide*, FORBES (June 29, 2017, 10:00 AM), <https://www.forbes.com/sites/ogdenpayne/2017/06/29/what-tunecores-1b-in-revenue-means-for-independent-musicians-worldwide/#5b445e1460b0> (“TuneCore is nearing \$1 billion in revenue for its artists. As of May 31, artists and bands around the world have earned over \$920 million collectively. To reach their goal ahead of their projected date in October, the company has launched the Billion Dollar Club, a campaign that allows users to upload a single for worldwide distribution to over 160 digital stores (Spotify, Apple Music, Tidal and the like) for free, for a limited time.”).

created and used as part of another work via a re-performance/re-recording of a piece of the original work.

...

It cuts both ways, of course, should someone want to sample your copyrighted work, he or she will have to negotiate a deal with you in order to do so, or risk you suing them for infringing upon your exclusive right to create derivative works.⁷⁴

The author then gives a warning against *de minimis* sampling stating, “[t]here is no clear standard for what is considered *de minimis* usage, and thus [a creator] is at risk if [he] misappropriate[s] any copyrighted material and create[s] a derivative work in the form of a sample in [his] own composition.”⁷⁵ This determination by an influential voice in the industry supports the same finding by the Sixth Circuit in *Bridgeport*: sampling a sound recording creates a derivative work. Therefore, creating a work that uses samples constitutes the making of a derivative work, which is a right that is only afforded to the copyright holder of the sound recording as per 17 U.S.C. § 114(b).⁷⁶

Lastly, in the legislative history of the Copyright Act of 1976, the House Judiciary Committee said that, “to constitute a violation of section 106(2),⁷⁷ the infringing work must incorporate a *portion* of the copyrighted work *in some form*.”⁷⁸ This language suggests that sampling would be a violation of the exclusive right to prepare a derivative work because the very meaning of sampling is to incorporate a portion of a copyrighted work, in some form, into a new work. Perhaps the legislative history also supports the Sixth Circuit’s and music industries’ finding that sampling can and should be

⁷⁴ George Howard, *Understanding Sampling, Cover Sounds & Derivative Work*, TUNECORE (Oct. 7, 2010), <https://ca.tunecore.com/blog/2010/10/understanding-sampling-cover-songs-derivative-work.html> (emphasis added).

⁷⁵ *Id.* (emphasis added) (“Don’t be confused with respect to misinformation regarding the right to use small amounts of another’s copyrighted work in your composition—i.e. a ‘short’ sample—without legal risk.”).

⁷⁶ See *Bridgeport*, 410 F.3d at 792; see also 17 U.S.C. § 114(b).

⁷⁷ 17 U.S.C. § 106(2) (2010) (stating “to prepare derivative works based upon the copyrighted work”).

⁷⁸ See H.R. REP. NO. 94-1476, at 62 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5675 (emphasis added).

considered a derivative work and, as such, is worthy of the protections given to sound recording copyright holders under 17 U.S.C § 114 (b).⁷⁹

2. *Piracy of Sound Recordings and How “de minimis” Sampling Could Contribute*

The Sixth Circuit in *Bridgeport* wrote:

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). . . . If you cannot *pirate* the whole sound recording, can you “lift” or “sample” something less than the whole.⁸⁰

The Sixth Circuit reasoned that Congress enacted 17 U.S.C. § 114(b) to curtail pirating, or copying, of small portions of a whole sound recordings.⁸¹

Black’s Law Dictionary defines piracy as “[t]he unauthorized and illegal reproduction or distribution of materials protected by copyright.”⁸² It was argued in an article,⁸³ relied upon by the court in *Bridgeport*, that unauthorized sampling falls under piracy law.⁸⁴ The author cited to testimony of a representative of the Recording Industry

⁷⁹ *Bridgeport*, 410 F.3d at 792; Howard, *supra* note 74; but see Jennifer R. R. Mueller, *All Mixed Up: Bridgeport Music v. Dimension Films and De Minimis Digital Sampling*, 81 IND. L.J. 435, 451 (2006) (“Thus, ‘sampling’ could almost never create a derivative work.”).

⁸⁰ See *Bridgeport*, 410 F.3d at 800 (emphasis added).

⁸¹ See *id.*

⁸² *Piracy*, BLACK’S LAW DICTIONARY (10th ed. 2014).

⁸³ Jeffrey R. Houle, *Digital Audio Sampling, Copyright Law and the American Music Industry: Piracy or Just A Bad “Rap”?*, 37 LOY. L. REV. 879 (1992).

⁸⁴ *Id.* at 896-97; *Bridgeport*, 410 F.3d at 801 n.13; see also *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 889 (9th Cir. 2016) (Silverman, J., dissenting) (“[T]he very nature of digital sampling makes a de minimis analysis inapplicable, since *sampling or pirating* necessarily involves copying a fixed performance.” (emphasis added)).

Association of America, given before a Senate committee, in which the representative explained how digital sampling was cutting into sales, employees were not paid, and investments and jobs would be at risk.⁸⁵ Piracy in sound recordings has been, and is still, an acute problem in this country. The author of this Note argues that use of the *de minimis* defense in digital sampling cases can actually contribute to the problem of sound recording piracy.

Piracy has long been a problem in copyright, but it was not until the 1970s that Congress codified protection for sound recordings.⁸⁶ In the legislative history for Public Law 92-140, which created the limited copyright in sound recording,⁸⁷ Congress explicitly reported on the need for reform because pirates were exploiting a loophole in the current law.⁸⁸ The pre-1971 law only protected the owners of copyright in musical works and not sound recordings, “as a result, [if record pirates could] satisfy the claim of the owner of the musical copyright,” they would then be able to pirate the sound recordings of musical compositions or other protected sounds, without violating federal copyright law.⁸⁹ Congress went on to say that copying of sounding recordings was becoming widespread and intolerable, further indicating that the piracy activity in this area was at an annual volume in excess of \$100 million.⁹⁰ Moreover, Congress indicated that sound recording piracy was negatively affecting the incomes of three groups⁹¹ by: (1) “depriving legitimate *manufacturers* of substantial income;”⁹² (2) “denying performing *artists and musicians* of royalties and contributions to pension and welfare funds;”⁹³ which had the effect of causing (3) “*Federal and State governments* [to lose] tax revenues.”⁹⁴

Looking at more contemporary numbers of the economic damage caused by sound recording, one can better understand why

⁸⁵ *Bridgeport*, 410 F.3d at 801 n.13; Houle, *supra* note 83, at 896-97.

⁸⁶ Sound Recording Amendment of 1971, Pub. L. No. 92-140, 85 Stat. 391 (“To amend title 17 of the United States Code to provide for the creation of a limited copyright in sound recordings for the purpose of protecting against unauthorized duplication and piracy of sound recording, and for other purposes.”).

⁸⁷ *Id.*

⁸⁸ See H.R. REP. NO. 92-487 (1971), as reprinted in 1971 U.S.C.C.A.N. 1566, 1567.

⁸⁹ See *id.*

⁹⁰ *Id.*

⁹¹ *Id.*

⁹² *Id.* (emphasis added).

⁹³ H.R. REP. NO. 92-487 (emphasis added).

⁹⁴ *Id.*

Congress passed the law in 1971. Even today, Congress's intuition about the need to prevent sound recording piracy as much as possible continues to be warranted. In 2007, a published report presented the horrific problem of sound recording piracy.⁹⁵ The report stated:

The true cost of sound recording piracy far exceeds its impact on U.S. producers and distributors of sound recordings. Piracy harms not only the owners of intellectual property but also U.S. consumers and taxpayers.

Specifically, the analysis demonstrates that:

- (a) As a consequence of global and U.S.-based piracy of sound recordings, the U.S. economy loses \$12.5 billion in total output annually. Output includes revenue and related measures of economic performance.
- (b) As a result of sound recording piracy, the U.S. economy loses 71,060 jobs. Of this amount, 26,860 jobs would have been added in the sound recording industry or in downstream retail industries, while 44,200 jobs would have been added in other U.S. industries.
- (c) Because of sound recording piracy, U.S. workers lose \$2.7 billion in earnings annually. Of this total, \$1.1 billion would have been earned by workers in the sound recording industry or in downstream retail industries while \$1.6 billion would have been earned by workers in other U.S. industries.
- (d) As a consequence of piracy, U.S. federal, state and local governments lose a minimum of \$422 million in tax revenues annually. Of this amount, \$291 million represents lost personal income taxes while \$131 million is lost corporate income and production taxes.

⁹⁵ Stephen E. Siwek, *The True Cost of Sound Recording Piracy to the U.S. Economy*, INST. FOR POL'Y INNOVATION, at i, Aug. 2007, http://www.ipi.org/docLib/20120515_SoundRecordingPiracy.pdf.

As policy makers turn their attention to the viability of the U.S. economy in the global marketplace, it seems obvious that the problem of music piracy should be afforded a high place on the policy agenda in coming years.⁹⁶

These numbers suggest that the current laws are still unable to fully handle the piracy issue. Consequently, the Sixth Circuit's ruling against *de minimis* sampling suggests that it did not want to exacerbate these economic losses. As the court later noted, "[t]o properly sort out this type of problem with its complex technical and business overtones, one needs the type of investigative resources as well as the ability to hold hearings that is possessed by Congress."⁹⁷ Thus, with the current state of the law, if courts have difficulty deciding whether a sample is truly an infringement because of the complexities involved in making such a determination, then courts should not allow small or *de minimis* amounts of conceded-to sampling. The statistics above show that piracy of sound recordings imposes significant costs on the United States economy and provides a strong reason for stricter laws for sound recordings.⁹⁸

Finally, the author of this Note does not oppose the use of sampling but rather advocates for uniform, applicable laws. In fact, it has been the opinion of experts in the field that "the industry can potentially *reverse the effects* of online audio piracy by providing *more legal* and efficient sampling techniques that consumers could use."⁹⁹ Therefore, if courts give copyright holders more protections, and provide legal clarity to creators seeking to sample by the implementation of such bright-line rules, such as the one created in *Bridgeport*,¹⁰⁰ courts may be able to prevent and reverse the effects of sound recording/sampling piracy, which comports with Congress's goal of battling piracy in sound recordings.¹⁰¹

⁹⁶ *Id.*

⁹⁷ *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 805 (6th Cir. 2005).

⁹⁸ See Siwek, *supra* note 95, at 7 ("The physical piracy loss estimate begins with the U.S. losses from physical piracy that occur within the United States. As shown in Table 3, this value is \$335 million as per IFPI.").

⁹⁹ Rebuttal Expert Report of Dr. Stan J. Liebowitz, *Arista Records, LLC v. Lime Wire, LLC*, 2010 WL 8510302 (S.D.N.Y. Feb.14, 2010) (No. 106CV05936) (first emphasis in original).

¹⁰⁰ *Bridgeport*, 410 F.3d at 802.

¹⁰¹ H.R. REP. NO. 92-487 (1971), *as reprinted in* 1971 U.S.C.C.A.N. 1566, 1567.

The Sixth Circuit, after its legislative intent and plain meaning analysis of 17 U.S.C. § 114, next analyzed the substantial similarity inquiry and its application to the sampling of sound recordings. It explained why this was the wrong test to apply to an infringement case dealing with the sampling of a sound recording, notwithstanding the occurrence of a substantial similarity finding for other certain types of copyright cases, such as musical compositions.¹⁰²

B. The Substantial Similarity or *de minimis* Inquiry: Not the Proper Test

In cases where a defendant admits to the copying of the protected work but claims what was taken is so trivial that it should not be actionable, the courts will engage in a *de minimis* inquiry, by using the substantial similarity test, to determine if infringement has occurred.¹⁰³ The ordinary observer, or average audience, version¹⁰⁴ of

¹⁰² *Bridgeport*, 410 F.3d at 801-02.

¹⁰³ See *Newton v. Diamond*, 388 F.3d 1189, 1193 (9th Cir. 2004) (“[A] taking is considered *de minimis* only if it is so meager and fragmentary that the average audience would not recognize the appropriation.” This observation reflects the relationship between the *de minimis* maxim and the general test for substantial similarity, which also looks to the response of the *average audience, or ordinary observer*, to determine whether a use is infringing” (citations omitted)). Courts will also use the substantial similarity test to inquiry if a purported infringement is *de minimis* even if there has been no admission to infringement. See *infra* text accompanying notes 191-94.

¹⁰⁴ The substantial similarity inquiry has long been established in copyright and scholars have identified at least three different versions of the test. See Gabriel Godoy-Dalmau, *Substantial Similarity: Kohus Got it Right*, 6 MICH. BUS. & ENTREPRENEURIAL L. REV. 231, 243 (2017) (“Scholars have identified three discrete tests for substantial similarity in the U.S.: the ordinary observer test, the extrinsic/intrinsic test, and the abstraction-filtration-comparison test.”); see also *Matthews v. Freedman*, 157 F.3d 25, 27 (1st Cir. 1998) (“Courts have used various formulas to isolate the protectible expression in the copyrighted work to determine whether the alleged infringing work is ‘substantially similar’ to that protectible expression”). Because the average audience test is the crux of the versions utilized by both the Sixth and Ninth Circuits, the use of term “*de minimis* inquiry” or “substantial similarity test” throughout this Note refers to this version of the substantial similarity test. See *Bridgeport*, 410 F.3d at 801 n.10; see also *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 878 (9th Cir. 2016); Mueller, *supra* note 79, at 442 (“As the term ‘substantial similarity’ implies, the two works at issue need not be identical. The most commonly articulated test looks at each work as a whole, and considers ‘whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.’”); Mueller, *supra* note 79, at 442 n.62 (“The D.C., First, Second, Eighth, Ninth, Tenth, and Eleventh Circuits all apply the “average audience” test in all cases. . . . The Third, Fourth, and Sixth Circuits use a “specialized audience” test in cases regarding complex and technical works.”); Lieberman, *supra* note 2, at 114 (“Much like the Second Circuit’s ordinary observer test, the [Ninth Circuit’s] intrinsic test is entirely subjective and based on the ‘response of the ordinary reasonable person’ to the ‘total concept and feel’ of a work, excluding expert testimony and dissection.” (footnote omitted)).

the test asks “whether a [reasonable] lay observer would consider the works as a whole substantially similar to one another.”¹⁰⁵ Under this version, in cases involving music, this is accomplished by listening to both works in contention, and then asking if the factfinder could definitively hear or notice the alleged appropriation.¹⁰⁶ If the appropriation cannot be recognized as originating from its alleged source, then the copying element has not been satisfied, and the case will not move forward.¹⁰⁷

The court in *Bridgeport* determined, “[t]he 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.”¹⁰⁸ The Sixth Circuit rejected the lower court’s application of the substantial similarity test to a sound recording because it was based on case law that used this test for musical compositions.¹⁰⁹ The Sixth Circuit provided two reasons why a substantial similarity or *de minimis* inquiry should not “enter the equation”¹¹⁰ in cases of sampling a sound recording. The first was based on its interpretation of the statute’s plain meaning.¹¹¹ The court determined that this test had no application because determining if the sampling was similar or substantial was irrelevant.¹¹² This is because

¹⁰⁵ *Bridgeport Music, Inc. v. UMG Recordings, Inc.*, 585 F.3d 267, 275 (6th Cir. 2009) (“However, as have several of our sister circuits, we have also noted that it is appropriate to modify this inquiry for situations in which a smaller fragment of a work has been copied literally, but not the overall theme or concept—an approach referred to in the literature as ‘fragmented literal similarity.’ See 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A][2] (rev. ed. 2009); see also *Bridgeport, Inc. v. Dimension Films*, 410 F.3d 792, 797-98 (6th Cir. 2005) (recognizing the ‘fragmented literal similarity’ standard but declining to apply it in cases of digital sampling).”).

¹⁰⁶ See *VMG Salsoul, LLC v. Ciccone*, No. CV 12-05967 BRO (CWx), 2013 WL 8600435, at *12 (C.D. Cal. Nov. 18, 2013), *judgment entered* No. CV 12-05967 BRO (CWx), 2013 WL 6983384 (C.D. Cal. Dec. 2, 2013), *aff’d in part, vacated in part*, 824 F.3d 871 (9th Cir. 2016); see also *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 792 (6th Cir. 2005); *Newton v. Diamond*, 388 F.3d 1189, 1193 (9th Cir. 2004); Godoy-Dalmau, *supra* note 104, at 243 (“The question is whether the defendant took enough of the plaintiff’s work such that an ordinary observer’s response to the work is to recognize that the defendant ‘appropriated something which belongs to the plaintiff.’”).

¹⁰⁷ See *Bridgeport*, 410 F.3d at 792; see also *Newton*, 388 F.3d at 1193; Godoy-Dalmau, *supra* note 104, at 243.

¹⁰⁸ *Bridgeport*, 410 F.3d at 798.

¹⁰⁹ *Id.* (“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.”).

¹¹⁰ *Id.* at 801-02.

¹¹¹ See *id.* at 801.

¹¹² See *id.*

the only person that is authorized to make a sample or derivative work of a sound recording was the copyright holder, and, thus, only a determination of whether the copying was intentional needs to be explored—not whether an average audience could distinguish between what was copied.¹¹³ Second, courts relying on case law dealing with musical composition *de minimis* copying for analysis of sound recordings are mistaken because of the inherent differences between sound recordings and musical compositions.¹¹⁴

The court ended with noting that a bright-line rule would help the courts, as well as the music industry as a whole, by reducing the unpredictability in piracy law for issues of undisputed, unauthorized sampling of sound recordings.¹¹⁵ Moreover, courts, copyright holders, and creators would all benefit from a bright-line rule because of the difficulties and complexity with having to apply the “lay observer” test.¹¹⁶

1. *Sound Recordings Versus Musical Compositions*

The Sixth Circuit determined that, although the substantial similarity test is used for musical compositions, this same test should not also be applied to sound recordings.¹¹⁷ The court held that sound recording copyright holders seek protection of the *actual sounds* fixed in their given medium, not the song or underlying musical composition.¹¹⁸ The copyright holders of each work have distinct interests, notwithstanding a musical composition’s overlap with a sound recording in the same piece of work.¹¹⁹

¹¹³ See *Bridgeport*, 410 F.3d at 801.

¹¹⁴ See *id.* at 801-02.

¹¹⁵ *Id.* at 802 n.15.

¹¹⁶ See *id.* (“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.” (emphasis in original)).

¹¹⁷ See *id.* at 798.

¹¹⁸ See *Bridgeport*, 410 F.3d at 802 (“For the sound recording copyright holder, it is not the ‘song’ but the sounds that are fixed in the medium of his choice.”).

¹¹⁹ See *id.*

Sound recordings are unique because they capture the musical composition with all the nuances. An artist adds his own style and variations, or “performance elements,” while creating a sound recording from a musical composition.¹²⁰ As a result, these performance elements are captured and are copyrighted in the sound recording.¹²¹ The United States Copyright Office explains the difference as:

Sound recordings often contain other separate copyrightable creative works, such as songs, plays, lectures, or readings. The copyright in a sound recording covers the recording itself. It does not cover the music, lyrics, words, or other underlying content embodied in that recording. . . . The underlying music and lyrics are a “musical work,” and a recording of an artist performing that song is a “sound recording.”¹²²

Moreover, the court in *T.B. Harms Co. v. Jem Records, Inc.*¹²³ further distinguished the two types of works, saying that “[a] sound recording as copyrightable subject matter must be distinguished from the copyrighted literary, musical or dramatic work The sound recording is the *aggregation of sounds* captured in the recording while the song or tangible medium of expression embodied in the recording is the musical composition.”¹²⁴ Also, the Southern District of New York, in *Poindexter v. EMI*,¹²⁵ mentioned that the unique elements in a sound recording must be distinguished from the underlying compositional elements.¹²⁶

¹²⁰ See *BTE v. Bonneze*, 43 F. Supp. 2d 619, 627-28 (E.D. La. 1999) (citing *T.B. Harms Co. v. Jem Records, Inc.*, 655 F. Supp. 1575, 1577 n.1 (D.N.J. 1987)); see also *Newton v. Diamond*, 388 F.3d 1189, 1194 (9th Cir. 2004) (“[R]egardless 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.”).

¹²¹ See *BTE*, 43 F. Supp. 2d at 627 (citing *T.B. Harms Co.*, 655 F. Supp. at 1576 n.1) (“The sound recording is the aggregation of sounds captured in the recording while the song or tangible medium of expression embodied in the recording is the musical composition.”).

¹²² *Copyright Registration for Sound Recordings*, U.S. COPYRIGHT OFF., at 2, Sept. 2017, <https://www.copyright.gov/circs/circ56.pdf>.

¹²³ *T.B. Harms Co.*, 655 F. Supp. at 1575.

¹²⁴ *Id.* at 1576 n.1. See also H.R. REP. NO. 94-1476, at 56 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5669. (emphasis added).

¹²⁵ No. 11 CIV. 559 LTS JLC, 2012 WL 1027639, at *4 (S.D.N.Y. Mar. 27, 2012).

¹²⁶ See *id.* (“[A] Court must filter out the elements unique to the sound recording and consider only the . . . compositional elements.”).

Because of this interest in the *actual fixed sounds*, as opposed to notes from a musical composition, the Sixth Circuit reasoned that “even when a small part of a sound recording is sampled, the part [or sound] taken is something of value.”¹²⁷ Thus, sampling any portion of a sound recording would constitute a “physical taking” of the interest in the copyright holder, versus an intellectual taking, as would be for musical composition copyright holders.¹²⁸ The court found that no matter the amount, if a creator of a sound recording sampled a portion of another protected sound recording, to either “save cost or . . . add something new to the new recording, or . . . both,”¹²⁹ something of value was lifted from the copyright holder’s interest. Therefore, only an inquiry as to whether such sampling had, in fact, occurred needs to be undertaken to establish infringement.¹³⁰

Thus, the Sixth Circuit concluded that the *de minimis* inquiry is not appropriate to use in cases of sampling sound recordings based on its interpretation of the 17 U.S.C. § 114(b), and, therefore, the court determined that sound recording copyright holders and musical composition copyright holders require different protections.¹³¹ This decision governed the Sixth Circuit and remained unchallenged by any

¹²⁷ See *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 801-02 (6th Cir. 2005) (“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”).

¹²⁸ See *id.* at 802.

¹²⁹ *Id.*

¹³⁰ See *id.*

¹³¹ *Id.* at 801-02.

other appellate circuit court for 10 years,¹³² until the Ninth Circuit decided to take a different approach when faced with the same issue.¹³³

IV. THE NINTH CIRCUIT RULING IN *VGM* AND ITS CONSIDERATIONS

In *VGM Salsoul, LLC v. Ciccone*,¹³⁴ the Ninth Circuit determined whether an alleged infringer who sampled from a copyright protected sound recording could use a *de minimis* defense.¹³⁵

¹³² Although unchallenged by another circuit court, the *Bridgeport* decision was strongly criticized by many commenters. See, e.g., 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[2][b] (rev. ed. 2009) (“Indeed, had *Bridgeport Music* consulted Section 114’s legislative history instead of dismissing that history as irrelevant, it would have discovered . . . [t]hat [an] excerpt [of legislative history] debunks the court’s imputation that Congress, when adopting Section 114, intended to dispense with traditional notions of substantial similarity. . . . Moreover, the very process by which *Bridgeport Music* expands the rights of copyright owners through construing Section 114 rests on a misapprehension of the statutory structure.”); 3 WILLIAM F. PATRY, PARTY ON COPYRIGHT § 9:61 (Sept. ed. 2018) (“A disturbing, inexplicable departure from the *de minimis non curat lex* doctrine occurred in the Sixth Circuit’s 2005 opinion in *Bridgeport Music, Inc. v. Dimension Films*. . . . Other than *Bridgeport* and the district courts following that decision, we are aware of no case that the *de minimis* doctrine does not apply in a copyright infringement case.”); Jeffrey F. Kersting, *Singing A Different Tune: Was the Sixth Circuit Justified in Changing the Protection of Sound Recordings in Bridgeport Music, Inc. v. Dimension Films?*, 74 U. CIN. L. REV. 663, 684-85 (2005) (“Finally, when statutory terms appear ambiguous, courts can generally turn to the legislative history for some assistance. The Sixth Circuit did not address the legislative history of the Sound Recording Act of 1971 or the Copyright Act of 1976 at all The arbitrary nature of the substantial similarity and *de minimis* tests make them difficult to apply in virtually any context, but this difficulty does not justify absolute abandonment of the tests in this sub-group of [sound recording] cases.” (footnotes omitted)); Courtney Bartlett, *Bridgeport Music’s Two-Second Sample Rule Puts the Big Chill on the Music Industry*, 15 DEPAUL-LCA J. ART & ENT. L. 301, 324-26 (2005) (“While the Sixth Circuit’s decision provides increased protection for copyright holders, its effect on the music industry could be damaging because the creativity of musicians and producers might become increasingly discouraged The Sixth Circuit’s decision in *Bridgeport Music* has created another opportunity for a chilling effect in rap music.”); John Schietinger, *Bridgeport Music, Inc. v. Dimension Films: How the Sixth Circuit Missed A Beat on Digital Music Sampling*, 55 DEPAUL L. REV. 209, 230 (2005) (“The Sixth Circuit erred by crafting its bright-line rule and not permitting a *de minimis* analysis. Three specific legal arguments illustrate why this was an error in the court’s opinion. First, a *de minimis* analysis applies to copyright infringement cases in general. Second, neither sampling case law nor the Copyright Act eliminates the *de minimis* analysis for infringement cases involving the sound recording copyright. Third, failing to conduct the *de minimis* analysis runs counter to the purposes of copyright law.” (footnotes omitted)).

¹³³ *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 888 (9th Cir. 2016) (Silverman, J., dissenting) (“[A]n on-point decision of the Sixth Circuit, a decision that has governed the music industry in Nashville—‘Music City’—and elsewhere for over a decade without causing either the sky to fall in, or Congress to step in.”).

¹³⁴ 824 F.3d 871 (9th Cir. 2016).

¹³⁵ *Id.* at 878.

In the early 1980s, music producer, Shep Pettibone, one of the defendants in the suit, recorded the song *Ooh I love it (Love Break)*.¹³⁶ The musical composition and sound recording licenses of *Love Break* were subsequently acquired by the Plaintiff VGM Salsoul, LLC.¹³⁷ Then, in the early 1990s, well-known pop star and co-defendant, Madonna Loise Ciccone (commonly known as Madonna), released the song *Vogue* that achieved great commercial success.¹³⁸ The plaintiff in the suit alleged that the producer of *Vogue* copied a 0.23 second “segment of horns,” or what became known as a “horn hit” by the court,¹³⁹ from the *Love Break* song he had produced.¹⁴⁰ However, the plaintiff claimed that this appropriation of the horn hit from *Love Break* into *Vogue* violated VGM’s copyright in *Love Break* because VGM was the owner of the copyright to the sound recording.¹⁴¹ The district court applied the *de minimis* analysis and concluded that even if the defendants conceded the copying,¹⁴² “no reasonable audience would find the sampled portions qualitatively or quantitatively significant in relation to the infringing work, nor would they recognize the appropriation.”¹⁴³ From this finding, the district court concluded that the appropriation of the horn hit was not actionable and, thus, granted summary judgement for the defendant.¹⁴⁴

On appeal, the Ninth Circuit held that the *de minimis* inquiry was correctly applied in determining infringement for both copying of a musical composition and sampling of a sound recording.¹⁴⁵ As a result, the Ninth Circuit affirmed the holding of the lower court, finding that the sampling of the horn hit was *de minimis* and not

¹³⁶ *Id.* at 875.

¹³⁷ *Id.*

¹³⁸ *Id.* at 874.

¹³⁹ *VMG Salsoul*, 824 F.3d at 874-76.

¹⁴⁰ *Id.*

¹⁴¹ *Id.*

¹⁴² See *VMG Salsoul, LLC v. Ciccone*, No. CV 12-05967 BRO (CWx), 2013 WL 8600435, at *12 (C.D. Cal. Nov. 18, 2013), *judgment entered* No. CV 12-05967 BRO (CWx), 2013 WL 6983384 (C.D. Cal. Dec. 2, 2013), *aff’d in part, vacated in part*, 824 F.3d 871 (9th Cir. 2016); see also *VMG Salsoul*, 824 F.3d at 877 (“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 has demonstrated actual copying.”).

¹⁴³ *VMG Salsoul*, 2013 WL 8600435, at *12.

¹⁴⁴ *Id.*

¹⁴⁵ See generally *VMG Salsoul*, 824 F.3d at 871.

copyright infringement.¹⁴⁶ Interpreting 17 U.S.C. § 114, the court concluded that Congress intended to maintain the *de minimis* exception for claims of infringement of sound recordings and found that the copyright owner's exclusive rights in a sound recording did not necessarily extend to the making of another sound recording that used the protected work in its creation.¹⁴⁷ With this holding, the Ninth Circuit took the "unusual step"¹⁴⁸ of explicitly breaking with the only other circuit that had made an on-point ruling of this very question, the Sixth Circuit in *Bridgeport*.¹⁴⁹

A. The Ninth Circuit's Rationale for the Application of the Substantial Similarity Inquiry to Sound Recordings

The concept of a substantial similarity inquiry for determining copyright infringement was developed through common law.¹⁵⁰ Congress and the Supreme Court have been silent as to how this inquiry should be conducted,¹⁵¹ which has likely led to the different versions.¹⁵² As stated by an author on the subject:

[T]he Copyright Act does not expressly reference the substantial similarity inquiry, Congress is aware that courts engage in the inquiry. Much of the legislative discussion, however, is limited to just that—recognizing that there is such a thing as the substantial similarity inquiry. Congress has expressly deferred to courts to continue developing the substantial similarity inquiry.¹⁵³

¹⁴⁶ *Id.*

¹⁴⁷ *See id.* at 884-85 ("Accordingly, even though it is true that, 'if the recording consists entirely of independent sounds, then the copyright does not extend to it,' that statement does not necessarily mean that 'if the recording does not consist entirely of independent sounds, then the copyright does extend to it.'").

¹⁴⁸ *Id.* at 886.

¹⁴⁹ *Id.*; *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792 (6th Cir. 2005).

¹⁵⁰ *Godoy-Dalmau, supra* note 104, at 241-43 ("Congress and the Supreme Court have been silent on the matter, lower courts have largely been alone in developing tests to determine exactly when a work is sufficiently quantitatively or qualitatively similar.").

¹⁵¹ *See Godoy-Dalmau, supra* note 104, at 241-43.

¹⁵² *See generally* *Godoy-Dalmau, supra* note 104, at 241-43.

¹⁵³ *See Godoy-Dalmau, supra* note 104, at 241-42.

The Ninth Circuit in *VGM* used the ordinary observer, or average audience, version of the substantial similarity test for its inquiry, just as the district court had done.¹⁵⁴ This Note does not take issue with this longstanding inquiry¹⁵⁵ but raises some questions about the Ninth Circuit's rationale.

The Ninth Circuit's rationale for applying this test to sound recordings is problematic. First, the Ninth Circuit said that only the performer's contributions in a sound recording are used for determining copyright infringement, making no mention about the producer's contributions.¹⁵⁶ Second, the precedent used by the Ninth Circuit dealt with the *de minimis* doctrine regarding musical compositions, not sound recordings.¹⁵⁷ Last, the Ninth Circuit reasoned that the average audience test was the correct test because it is the average audience or lay public that ultimately determines the financial gains creators earn from their sound recordings.¹⁵⁸

1. *Producer/Recorder Contributions*

When determining a claim of infringement for a copyrighted sound recording as part of the *de minimis* inquiry, the Ninth Circuit said all that matters is "how the musicians *played* the notes."¹⁵⁹ This statement is arguably erroneous because it ignores the *recorder's* performance. This distinction should not be taken lightly. As indicated in the legislative history of the Copyright Act of 1976, the elements of sound recordings can be very different from those of a musical composition.¹⁶⁰ As noted by Congress, it is not only the way in which the underlying composition was performed that constitutes the protectable parts of the sound recording, but also the contribution

¹⁵⁴ *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 878 (9th Cir. 2016).

¹⁵⁵ See *Jones v. Blige*, 558 F.3d 485, 490-91 (6th Cir. 2009) ("Where there is no direct evidence of copying, a plaintiff may establish an inference of copying by showing (1) access to the allegedly-infringed work by the defendant(s) and (2) a substantial similarity between the two works at issue." (internal quotation marks omitted)); see also *Nova Design Build, Inc. v. Grace Hotels, LLC*, 652 F.3d 814, 817 (7th Cir. 2011); *Elements of Copyright Infringement Claim—Substantial Similarity*, 6A FED. PROC. FORMS § 17:71 (June ed. 2018).

¹⁵⁶ *VMG Salsoul*, 824 F.3d at 879.

¹⁵⁷ *Id.* at 877.

¹⁵⁸ *Id.* at 881.

¹⁵⁹ *Id.* at 879 (emphasis in original).

¹⁶⁰ See H.R. REP. NO. 94-1476, at 56 (1976), as reprinted in 1976 U.S.C.A.N. 5659, 5669.

by the producer responsible for setting up the recording session.¹⁶¹ The House Judiciary Committee went as far to say that

the copyrightable elements in a sound recording will usually . . . involve “authorship” both on the part of the performers . . . and on the part of the *record producer* . . . there may be cases (for example, recording of birdcalls, sounds of racing cars, et cetera) where *only* the record producer’s contribution is copyrightable.¹⁶²

Music producers can add a multitude of additional elements to a sound recording that accompany the musician’s performance.¹⁶³ It should be noted that this very case came to the Ninth Circuit, not because of how Madonna “played her notes,” but because of an idea from her producer that the song needed something more.¹⁶⁴ Thus, this analysis is suspect because the Ninth Circuit began its inquiry without

¹⁶¹ *See id.*

¹⁶² *See id.* (emphasis added).

¹⁶³ Rick Camp, *What Does A Music Producer Do?*, RECORDING CONNECTION, <https://www.recordingconnection.com/reference-library/recording-entrepreneurs/what-does-a-music-producer-do/> (last visited Nov. 14, 2018) (“The music producer is in charge of either writing the material or if he didn’t write it, he’s in charge of organizing it and making it sound like a cohesive song. He calls all the shots on what’s played, and when it’s played, and how it’s played, and the *sounds* that are used, or the vocals that are recorded if they’re correct or not. The producer is in charge of everything.” (emphasis added)); *see also* New Old Music Grp., Inc. v. Gottwald, 122 F. Supp. 3d 78, 94 (S.D.N.Y. 2015) (“For this ‘improper appropriation’ prong, ‘it is essential that the similarity relate to copyrightable material. . . . When similar works resemble each other only in unprotected aspects . . . defendant prevails.’ Muller, 794 F.Supp.2d at 440 (quoting Bill Diodato Photography, LLC v. Kate Spade, LLC, 388 F.Supp.2d 382, 389-90 (S.D.N.Y.2005).”). Whether material is copyrightable depends on whether the work is “original to the author.” Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991). Originality, as the term is used in copyright, “means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.” *Id.* The “requisite level of creativity is extremely low; even a slight amount will suffice.” *Id.* “Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying.” *Id.* As the Supreme Court has explained, if two poets, “each ignorant of the other,” composed identical poems, each would be copyrightable since they are both original, though neither is novel. *Id.* at 345-46.

¹⁶⁴ VMG Salsoul, LLC v. Ciccone, 824 F.3d 871, 877 (9th Cir. 2016) (“Pettibone directed an engineer to introduce sounds from *Love Break* into the recording of *Vogue*.”); *Id.* at 879-80 (“Pettibone copied one quarter-note of a four-note chord, lasting 0.23 seconds; he isolated the horns by filtering out the other instruments playing at the same time; he transposed it to a different key; he truncated it; and he added effects and other sounds to the chord itself.”); *Id.* at 889 (Silverman, J., dissenting) (“The defendants wanted horns to punctuate their song, so they took the plaintiff’s copyrighted recording of horns. The horn hit is brief, but clearly perceptible and does its job.”).

mentioning the copyrightable elements contributed by, not just the performer, but the producer as well.

2. *Precedent Based on Musical Compositions*

The Ninth Circuit in *VGM*, and the district court in *Bridgeport*, relied on the Ninth Circuit case, *Newton v. Diamond*,¹⁶⁵ which involved the *de minimis* doctrine's applicability in musical sampling copyright disputes.¹⁶⁶ The court in *Newton* decided whether the *de minimis* doctrine could be used as a defense against a claim of alleged infringement of a musical composition after legally sampling a portion from a sound recording.¹⁶⁷ The plaintiff, James Newton, was a jazz flutist and composer who composed the song "Choir" in 1978.¹⁶⁸ In 1981, he subsequently preformed and recorded "Choir" and licensed all rights in the sound recording to EMC records.¹⁶⁹ The license only covered the sound recording and Newton still retained all rights in the musical composition. In 1992, the Beastie Boys, the defendants in the suit, licensed from EMC records the rights to use portions of the sound recording "Choir" in their song "Pass the Mic."¹⁷⁰ Newton filed suit, arguing that the incorporation of the six-second, three-note segment infringed his copyright in the composition because of the unique performance elements used in conjunction with the composition.¹⁷¹ The court held that the performance elements were captured in the sound recording but not the composition.¹⁷² However, because the Beastie Boys *had* rights to the sound recording, its analysis could only focus on the *de minimis* nature of the sampling as it pertained to the musical composition.¹⁷³

The district court granted summary judgment to the Beastie Boys, holding that the three notes lacked sufficient originality to merit

¹⁶⁵ 388 F.3d 1189 (9th Cir. 2004).

¹⁶⁶ *VMG Salsoul*, 824 F.3d at 877; see *Bridgeport Music, Inc. v. Dimension Films*, 230 F. Supp. 2d 830, 841 (M.D. Tenn. 2002), *rev'd*, 383 F.3d 390 (6th Cir. 2004), *republished as modified on reh'g*, 401 F.3d 647 (6th Cir. 2004), *amended on reh'g*, 410 F.3d 792 (6th Cir. 2005).

¹⁶⁷ *Newton*, 388 F.3d at 1193-94.

¹⁶⁸ *Id.* at 1190-91.

¹⁶⁹ *Id.* at 1191.

¹⁷⁰ *Id.*

¹⁷¹ *Id.* ("First, Newton argues that the score contains an instruction that requires overblowing the background C note that is played on the flute.").

¹⁷² *Newton*, 388 F.3d at 1194.

¹⁷³ *Id.*

copyright protection and its use was *de minimis*.¹⁷⁴ The Ninth Circuit affirmed, finding the Beastie Boys' use of the three-note segment was *de minimis* because the issue had to be determined solely on the musical composition and not on the unique performance elements; "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."¹⁷⁵

Because *Newton* dealt with sampling of a musical composition versus a sound recording, the Sixth Circuit chose not to follow it in its ruling in *Bridgeport*.¹⁷⁶ The Sixth Circuit's decision to depart from the Ninth Circuit's and other courts' application of the *de minimis* inquiry regarding musical compositions may have merit. In *Newton*, the Beastie Boys legally acquired the license to sample the sound recording.¹⁷⁷ This fact stands in complete contrast to the issue presented in *Bridgeport*, which dealt with the determination of whether the sampling of a *sound recording* was considered infringement.¹⁷⁸ The court in *Newton* made clear that the need to "filter out" the licensed elements of sound recordings for its inquiry was paramount because the sound recording was sampled legally.¹⁷⁹ Thus, the Ninth Circuit's use of the *Newton* case is questionable as a basis for determining infringement for the sampling of a sound recording because infringement of a sound recording was not the issue argued. Thus, because of the stark differences between the elements and interest of musical compositions and sound recordings, the Sixth Circuit was

¹⁷⁴ *Id.* at 1190.

¹⁷⁵ *Id.* at 1194-97.

¹⁷⁶ *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 802-03 n. 17 (6th Cir. 2005) ("We have not addressed several of the cases frequently cited in music copyright cases because in the main they involve infringement of the composition copyright and not the sound recording copyright or were decided on other grounds. . . . We note that in *Newton*, the matter at issue was infringement of the composition copyright. The alleged infringer had secured a license for use of the sound recording.").

¹⁷⁷ *Newton*, 388 F.3d at 1190.

¹⁷⁸ *See Bridgeport Music*, 410 F.3d at 792.

¹⁷⁹ *Newton*, 388 F.3d at 1193-94 ("This case involves not only use of a composition, as was the case in *Fisher*, but also use of a sound recording of a particular performance of that composition. 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.").

justified in departing from these types of precedents that dealt with musical composition sampling alone.

3. *The Lay Public Control*

The Ninth Circuit said that, because an average audience or lay public is the targeted audience for the potential financial returns for creators of sound recordings, then an average audience is also the appropriate audience to determine if copyright infringement has occurred.¹⁸⁰ Therefore, if an average audience cannot recognize the appropriation, then there is no infringement because the copier has “not benefitted from the original artist’s expressive content.”¹⁸¹ This rationale is problematic because it does not take into account the audience of the lucrative market selling and buying samples,¹⁸² an oversight that could potentially have negative impacts on those engaged in this market.¹⁸³ The Ninth Circuit’s proclamation that the only people in the market for sound recordings are the “lay public”¹⁸⁴ reflects an error by the Ninth Circuit for failure to factor in the “high-tech economy”¹⁸⁵ of the sampling market, where the intended audience

¹⁸⁰ VMG Salsoul, LLC v. Ciccone, 824 F.3d 871, 881 (9th Cir. 2016) (mentioning the long history of the test used in the general area of copyright law.).

¹⁸¹ *Id.*

¹⁸² Grant Rinder, *The Drum Kit Market: How Producers Are Selling Sounds to Supplement Income*, PIGEONS & PLANES (Sept. 7, 2017), <http://pigeonsandplanes.com/in-depth/2017/09/producers-supplementing-income-selling-drum-kits/> (“I kind of caught the tail end of the transition out of beat machines and into software. Back when I was coming up in hip-hop production, there was this culture of sampling records, getting your drum sounds from the crates, breaking up drum breaks, and all that stuff,” says Illmind, who has worked with Kanye West, Drake, and 50 Cent. ‘So one day I decide to compile a folder. I think it had 120 of my own drum sounds. In my mind I’m like, “What would I pay for this? I should charge a couple hundred bucks but I want it to be affordable and accessible,” so I set a price point of \$20.’”).

¹⁸³ See Di Cosmo, *supra* note 27, at 242 (“Yet another criticism of the substantial similarity test is that its focus on similarity rather than harm is inconsistent with the purposes of copyright law. The substantial similarity test, by focusing analysis entirely on the characteristics of the defendant’s work, does not include any consideration of the *harm* that a defendant’s work may do to the *plaintiff*.” (emphasis added)); see also Molly McGraw, *Sound Sampling Protection and Infringement in Today’s Music Industry*, 4 HIGH TECH. L.J. 147, 164 (1989) (“In the typical case, the trier of fact is instructed not to inquire into the value of the allegedly appropriated portion standing alone, but rather into its importance to the effect of the complaining song. The oft-quoted rule is ‘no plagiarist can excuse the wrong by showing how much of his work he did not pirate.’ Whether this rule will be imported into cases where the ‘complaining song’ is little more than a phrasing remains to be seen.” (footnotes omitted)).

¹⁸⁴ VMG Salsoul, 824 F.3d at 881.

¹⁸⁵ Jacob Goldstein, *The Producer Who Created ‘Beat Kits’ Behind Today’s Pop Music*, NAT’L PUB. RADIO, INC. (Sept. 26, 2017, 4:29 PM), <https://www.npr.org/2017/09/26/553799>

is not the “lay public” but artists and music producers alike.¹⁸⁶ As an article on the subject noted, “[m]usic producers buy and sell musical snippets to each other. They text each other half-finished beats. There’s even a market for the sound of a single tap of a snare drum or a single perfect yell.”¹⁸⁷

Even though the lay audience does not pay for sampling per se, defendants typically pay license fees or royalties to use sampling in their sound recording, so plaintiffs are economically harmed when not compensated for the sounds used without their authorization.¹⁸⁸ Had the Ninth Circuit taken this market into account, it may have determined that producers and artists in the field versus an average audience may have been the more appropriate audience for inquiry into the sampling of sound recordings.¹⁸⁹

Lastly, many scholars and other circuits have taken issue with the substantial similarity or *de minimis* test beyond its application to sound recordings.¹⁹⁰ The substantial similarity inquiry is typically used by courts to determine if there has been actual copying, absent direct evidence of such.¹⁹¹ To infer that copying occurred, a plaintiff

207/the-producer-who-created-beat-kits-behind-todays-pop-music.

¹⁸⁶ See *id.*; see also *Lyons P’ship, L.P. v. Morris Costumes, Inc.*, 243 F.3d 789, 801 (4th Cir. 2001) (referring to the substantial similarity test, stating “[i]n most cases, when a copyrighted work will be directed at the public in general, the court need only apply a general public formulation to the intended audience test. But when it is clear that the work is intended for a more particular audience, the court’s inquiry must be focused upon the perspectives of the persons who comprise that group” (citations omitted)).

¹⁸⁷ Goldstein, *supra* note 185.

¹⁸⁸ See *Di Cosmo*, *supra* note 27, at 242; see also *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 804 (6th Cir. 2005).

¹⁸⁹ Cf. Jamie Lund, *Fixing Music Copyright*, 79 BROOK. L. REV. 61, 93 (2013) (“Both computer code and musical compositions are in some way ‘blueprints’ for future expression. Neither a computer code nor a musical composition is immediately accessible or marketed to the layperson. This similarity would suggest that the layperson is not the intended audience for a computer program or a musical composition. The best way to determine the value of computer code and musical compositions, then, would be to ask the programmers and musicians directly.”).

¹⁹⁰ Godoy-Dalmau, *supra* note 104, at 249 (“Some scholars have argued for significant procedural overhauls while others have argued for more focused substantive fixes.”).

¹⁹¹ See *Jones v. Blige*, 558 F.3d 485, 490-91 (6th Cir. 2009). (“Where there is no direct evidence of copying, a plaintiff may establish an inference of copying by showing (1) access to the allegedly-infringed work by the defendant(s) and (2) a substantial similarity between the two works at issue.” (internal quotations omitted)); see also *Nova Design Build, Inc. v. Grace Hotels, LLC*, 652 F.3d 814, 817 (7th Cir. 2011); *Elements of Copyright Infringement Claim—Substantial Similarity*, 6A FED. PROC. FORMS § 17:71 (June ed. 2018); Amy B. Cohen, *Masking Copyright Decisionmaking: The Meaninglessness of Substantial Similarity*, 20 U.C. DAVIS L. REV. 719, 735 (1987).

must prove the defendant had access to the material and that the alleged infringed work is substantially similar, as determined by an ordinary observer.¹⁹² The Ninth Circuit in *VGM* did not use the test to determine whether there was actually copying,¹⁹³ but it used the same average audience inquiry to determine whether the conceded appropriation was recognizable to a lay audience; if not, then the copying could be considered *de minimis* and not actionable.¹⁹⁴ The Ninth Circuit may have misapplied this test by using it for misappropriation instead of actual copying. The former determining if the appropriated work rises to the level of an infringement, the latter determining if in fact the work was copied at all, notwithstanding the amount appropriated.¹⁹⁵ As noted by one author writing about the substantial similarity test and its current use by the courts:

By relying on the concept of “substantial similarity” as determined by an ordinary observer, [courts are] confus[ing] the issue of copying with that of misappropriation. The confusion of these two issues had many undesirable consequences, as is shown by examining the way more recent courts have used “substantial similarity” in determining infringement.¹⁹⁶

Based on this understanding, the Ninth Circuit may have fallen victim to confusing *copying* and *misappropriation*.¹⁹⁷ This confusion

¹⁹² *Unicolors, Inc. v. Urban Outfitters, Inc.*, 853 F.3d 980, 984-85 (9th Cir. 2017) (“A plaintiff must show ‘copying’ of a protected work to prove copyright infringement. *If there is no direct evidence of copying*, a plaintiff may prove this element through circumstantial evidence that (1) the defendant had access to the copyrighted work prior to the creation of defendant’s work and (2) there is substantial similarity of the general ideas and expression between the copyrighted work and the defendant’s work.”). For information on the further uses/versions of this test, see *supra* notes 103-07 and accompanying text.

¹⁹³ *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 877 (9th Cir. 2016) (“[F]or purposes of summary judgment, Plaintiff has introduced sufficient evidence (including direct evidence) to create a genuine issue of material fact as to whether copying in fact occurred. Taking the facts in the light most favorable to Plaintiff, Plaintiff has demonstrated actual copying.”).

¹⁹⁴ *Id.* at 878-80.

¹⁹⁵ See *infra* notes 196-200 and accompanying text.

¹⁹⁶ Cohen, *supra* note 191.

¹⁹⁷ See Cohen, *supra* note 191; see also Di Cosmo, *supra* note 27, at 239-40 (“One of the primary criticisms of the substantial similarity test is that it fails to properly account for the basic concept of copying. Copying occurs where the defendant has used the plaintiff’s work rather than creating a similar work independently or by using common public domain sources. Traditionally, misappropriation has been defined as occurring where copying goes far enough to constitute improper appropriation. The substantial similarity test essentially only considers whether a work is similar to the copyrighted one—not whether it has actually been copied—

may have led to an inquiry that is not the most appropriate test for the sampling of sound recordings. In sampling cases where the appropriation is already conceded by both parties, or must be, for summary judgment,¹⁹⁸ determining the substantial similarity between two works is irrelevant. First, as argued, sampling creates a derivative work and is the exclusive right of the copyright holder.¹⁹⁹ Second, this test is typically used for determining copying and not necessarily misappropriation.²⁰⁰

Lastly, the First Circuit held, “de minimis copying is best viewed not as a separate defense to copyright infringement but rather as a statement regarding the strength of the plaintiff’s proof of substantial similarity.”²⁰¹ Thus, the reflexive application by the Ninth Circuit may lead to works being labeled *de minimis* when, in fact, infringement is occurring.

B. The Ninth Circuit’s Interpretation of 17 U.S.C. § 114

After the Ninth Circuit’s *de minimis* inquiry, the court further addressed statutory arguments made by VGM, premised on the Sixth Circuit’s decision in *Bridgeport*.²⁰² Based on the *Bridgeport* ruling, the plaintiff argued that, even if the copied sample was found to be trivial, it is irrelevant because the *de minimis* exception does not apply to the infringement of copyrighted sound recordings.²⁰³ The court rephrased the plaintiff’s argument, stating that the plaintiff asserted that, “Congress *intended to create a special rule* for copyright sound recordings, [by] eliminating the *de minimis* exception,”²⁰⁴ which the

and then finds misappropriation (and thus infringement) where the similarity is great enough to arrive at some arbitrary level deemed by the court to be substantial.” (footnotes omitted)).

¹⁹⁸ *VMG Salsoul*, 824 F.3d at 877.

¹⁹⁹ See *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 800-01 (6th Cir. 2005); Howard, *supra* note 74.

²⁰⁰ See *Jones v. Blige*, 558 F.3d 485, 490-91 (6th Cir. 2009). (“Where there is no direct evidence of copying, a plaintiff may establish an inference of copying by showing (1) access to the allegedly-infringed work by the defendant(s) and (2) a substantial similarity between the two works at issue.” (internal quotations omitted)); see also *Nova Design Build, Inc. v. Grace Hotels, LLC*, 652 F.3d 814, 817 (7th Cir. 2011); *Elements of Copyright Infringement Claim—Substantial Similarity*, 6A FED. PROC. FORMS § 17:71 (June ed. 2018); Cohen, *supra* note 191.

²⁰¹ *Situation Mgmt. Sys., Inc. v. ASP. Consulting LLC*, 560 F.3d 53, 59 (1st Cir. 2009).

²⁰² *VMG Salsoul*, 824 F.3d at 880.

²⁰³ *Id.*

²⁰⁴ *Id.* at 881 (emphasis added).

court later equated to an “implicit expansion”²⁰⁵ of the rights of sound recording copyright holders. The court refuted this argument based on three major points. First, from a plain reading of the copyright statute, Congress did not create a *special rule* for sound recordings as opposed to the other works included in the statute.²⁰⁶ Second, the legislative history of the statute does not create a *special rule* or exception for the *de minimis* inquiry of sound recordings.²⁰⁷ Lastly, the court ultimately rejected the Sixth Circuit’s interpretation of the copyright statute that the plaintiff relied upon.²⁰⁸

1. *The Ninth Circuit’s Plain Meaning Analysis*

The court started with a plain reading of 17 U.S.C. § 102²⁰⁹ and explained why sound recordings were not treated differently than all other types of protected works.²¹⁰ The court determined that nothing in the text suggested any differential treatment between a sound recording and any of the other works listed.²¹¹ The Ninth Circuit referred to 17 U.S.C. § 106²¹² and found that a plain reading of this

²⁰⁵ See *id.* at 881-83.

²⁰⁶ *Id.*

²⁰⁷ *VMG Salsoul*, 824 F.3d at 883.

²⁰⁸ *Id.* at 884.

²⁰⁹ See 17 U.S.C. § 102 (2018), which provides:

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

²¹⁰ *VMG Salsoul*, 824 F.3d at 881-82.

²¹¹ *Id.*

²¹² See 17 U.S.C. § 106 (2018), which provides:

section did not “suggest[] differential treatment of *de minimis* copying of sound recordings,” as compared to other works.²¹³

The Ninth Circuit then interpreted the plain meaning of 17 U.S.C. § 114(b). This section states:

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.²¹⁴

The Ninth Circuit concluded that a straightforward reading of this quoted sentence from § 114 revealed that Congress intended to limit the rights of sound recording copyright holders because the statute contained the words “*do not extend*” when speaking about the exclusive rights given to copyright holders of sound recordings.²¹⁵ However, the Ninth Circuit was particular in how it interpreted this part of the statute. The court’s plain meaning reading of § 114(b) was phrased as: “The exclusive rights of the owner of a copyright in a sound recording . . . *do not extend* to the making or duplication of another

Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of 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;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
- (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

²¹³ *VMG Salsoul*, 824 F.3d at 882 (9th Cir. 2016) (emphasis added); *but cf.* *Griffin v. J-Records*, 398 F. Supp. 2d 1137, 1142-43 (E.D. Wash. 2005) (“Copyright in a sound recording does not give the same scope of exclusive rights as for other types of copyrighted works.”).

²¹⁴ 17 U.S.C. § 114(b).

²¹⁵ *VMG Salsoul*, 824 F.3d at 883.

sound recording [with certain qualities].”²¹⁶ This articulation suppresses and replaces words that are relevant to the Sixth Circuit’s interpretation of the same section.

In its plain meaning analysis, the Ninth Circuit left out “clauses (1) and (2) of § 106,” the latter dealing with derivative works.²¹⁷ Additionally, the Ninth Circuit replaced the language after “sound recording” from, “consists entirely of an independent fixation of other sounds,” to “with certain qualities.”²¹⁸ The court’s exclusion of language that mentions the exclusive right to prepare derivative works, and entirely of an independent fixation of other sounds, raises questions because that missing language is heavily relied upon by the Sixth Circuit²¹⁹ in its interpretation of the same section of the statute.

Instead of critiquing the Sixth Circuit’s interpretation head on, the Ninth Circuit left out the language that supported the Sixth Circuit’s position. As noted by the dissent, “it is the majority that tortures the natural reading of these provisions. Bear in mind that § 114(b) simply explains the scope of exclusive rights already granted to copyright holders under § 106. These *two provisions must be read together, as the Sixth Circuit did.*”²²⁰ It is unknown why the Ninth Circuit decided to frame the language of the statute in this manner. When compared to the statute itself, these omissions and additions of language critical to the Sixth Circuit’s interpretation raise serious questions as to the Ninth Circuit’s plain meaning analysis of 17 U.S.C. § 114(b).

i. Limits on the Rights of Sound Recordings

The Ninth Circuit finished its plain meaning analysis by discussing each instance of implied limiting language in the statute as a basis to refute the Sixth Circuit’s *Bridgeport* ruling that, according to the Ninth Circuit, implicitly expanded the rights of copyright

²¹⁶ *Id.* (emphasis in original). See the language of 17 U.S.C. § 114(b) above; this important language is left out, and “certain qualities” are nowhere to be found in the statute.

²¹⁷ 17 U.S.C. § 114.

²¹⁸ *VMG Salsoul*, 824 F.3d at 883. It should be noted that the court never explained what the certain qualities are.

²¹⁹ See *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 800-01 n.10 (6th Cir. 2005).

²²⁰ *VMG Salsoul*, 824 F.3d at 889-90 (Silverman, J., dissenting) (emphasis added).

holders in sound recordings.²²¹ The court said, “first sentence: ‘exclusive rights . . . do not extend’ to certain circumstances; second sentence: ‘exclusive rights . . . do not extend’ to certain circumstances; fourth sentence: ‘exclusive rights . . . do not apply’ in certain circumstances.”²²² After this enumeration, the Ninth Circuit concluded that it is hard to find an “implicit expansion” of the rights provided by this section when Congress has so many mentions of an “express limitation” on the rights.²²³

First, uncertainty exists among the courts as to the scope of “limits” envisioned by Congress. In *Griffin v. J-Records*,²²⁴ the Eastern District of Washington described the limits of the exclusive right on sound recordings much like the Sixth Circuit:

the exclusive right of reproduction is *limited* to the right to duplicate the sounds in a form “that directly or indirectly recaptures the actual sounds fixed in the recording.” A sound recording copyright does not give a right to prevent others from making an independent fixation of sounds that “imitate or simulate” those in the copyrighted sound recording. Thus, the remedy of the owner of a sound recording copyright is largely *limited* to proceeding against the tape or record “pirate” who without permission makes a reproduction of the actual sounds in a protected recording.²²⁵

This finding, that the copyright holder is limited to duplicate its own actual sounds and limited to seek remedies from unlicensed persons who reproduce the actual sounds, articulates an interpretation of the extent of the restrictions on the exclusive rights of sound recordings. This understanding by the Eastern District of Washington supports the Sixth Circuit’s holding, that found that the statute limits the protections of copyright holders of sound recordings to only the actual sounds fixed. Which in turn, effectively limits copyright holders protections and an ability to claim infringement against imitations of the sound recording that are entirely independent of actual fixed sounds.²²⁶

²²¹ See *id.* at 883.

²²² *Id.*

²²³ See *id.*

²²⁴ *Griffin v. J-Records*, 398 F. Supp. 2d 1137 (E.D. Wash. 2005).

²²⁵ *Id.* at 1142-43 (emphasis added) (footnotes omitted).

²²⁶ In 2014 the District of New Jersey also discussed the “limits” of sound recordings and found the *Bridgeport* interpretation to be correct. *Zany Toys, LLC v. Pearl Enters., LLC*, No.

Further, the court's interpretation disagrees with the Ninth Circuit's interpretation, which indicated that the limits to the copyright holder's protections in sound recordings might reach into the actual sounds themselves.²²⁷ Thus, because ambiguity exists for what Congress envisioned the "limit" in sound recording copyright would be, the Ninth Circuit's conclusion based merely in finding language in the statute that indicates a limit on the right, without further context or support as to what that the limit is, arguably makes the court's conclusion incomplete.

Second, the Ninth Circuit's basis for believing that Congress intended to limit protections for holders is grounded in the court's failure to find affirmative language supporting an expansion of rights.²²⁸ This determination was premised on the conclusion that the Sixth Circuit's holding in *Bridgeport*, in effect, expanded the copyright holders' rights. The Ninth Circuit's majority did not take account of the fact that the Sixth Circuit merely explained what the right entails, and not "expanding" a right, as discussed in the dissent.²²⁹ Thus, to base its conclusion on a debatable premise aids an idea that the Ninth Circuit's reasoning is incomplete and unpersuasive. Nevertheless, the Ninth Circuit said that congressional intent can be found through the legislative history, even if there is some ambiguity regarding the plain meaning analysis of § 114(b).²³⁰

CIV.A. 13-5262 (JAP)(TJB), 2014 WL 2168415, at *11-12 (D.N.J. May 23, 2014) ("[T]he Copyright Act confers more *limited* rights than to other types of copyrighted work. See 17 U.S.C. §§ 106, 114. . . . [T]he reproduction right 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 rights of the owner of a copyright in a sound recording . . . 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. . . . Therefore, courts have found that copyright protection for sound recordings extends only to duplications of such recordings, not to imitations. See, e.g., *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d at 800." (first alteration added) (emphasis added)).

²²⁷ See *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871 (9th Cir. 2016).

²²⁸ See *id.* at 883.

²²⁹ See *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792 (6th Cir. 2005); *VMG Salsoul*, 824 F.3d at 889 (Silverman, J., dissenting) ("That right was not invented by the Sixth Circuit: it already exists in the statutes. And these statutes say nothing about the *de minimis* exception." (emphasis added)).

²³⁰ *VMG Salsoul*, 824 F.3d at 883.

2. *The Ninth Circuit's Legislative History Analysis of 17 U.S.C. § 114*

The Ninth Circuit's legislative history scrutiny is based on two quotes from H.R. Rep. No. 94-1476.²³¹ The court largely used the same methods for this analysis as it used for its plain meaning analysis. The first passage of legislative history deals with its statutory structure argument and says, "[t]he approach of the bill is to set forth the copyright owner's exclusive rights in broad terms in section 106, and then to provide various limitations, qualifications, or exemptions in the 12 sections that follow. Thus, everything in section 106 . . . must be read in conjunction with those provisions."²³² The court reasoned that the language from the passage proved that Congress intended section 114 to limit the rights of copyright holders rather than "expand[] their rights."²³³ Still, under this presumption that the holding in *Bridgeport* "expanded a right," the Ninth Circuit came to its first legislative history determination by scanning a congressional document that indicated proof of Congress's intent to limit a copyright holder's protection.²³⁴ Again, there are competing versions of what Congress meant when it used the word "limit" in the creation of the statute;²³⁵ the Ninth Circuit merely finding the word "limit" used in the statute, absent any context that supports limited protections on actual sounds, is again unpersuasive.²³⁶

Moreover, in the report cited by the Ninth Circuit, the House Judiciary Committee mentioned the limits envisioned for § 114(b):

Section 114(b) provides that 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 . . . *actual sounds* fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality."²³⁷

²³¹ *Id.* at 883-84.

²³² *Id.* at 883 (quoting H.R. REP. NO. 94-1476, at 61 (1976)).

²³³ *See id.* at 883-84.

²³⁴ *See id.*

²³⁵ *See supra* text accompanying notes 224-27.

²³⁶ *See VMG Salsoul*, 824 F.3d at 883-84.

²³⁷ H.R. REP. NO. 94-1476, at 106 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5721 (emphasis added).

This section of the same congressional history comports with the Sixth Circuit's and Washington district court's findings; the intent was to limit claims against imitations or simulations of protected works.²³⁸ Thus, the passage quoted by the Ninth Circuit showed that Congress intended to limit the rights of copyright holders in sound recordings; however, it is still arguable that the limit was on the exclusive right to prepare derivatives from the sound recordings that were not merely imitations or simulations.²³⁹ Because uncertainty exists, this may suggest that finding the word "limit" in the legislative history, alone, is simply not enough to support the Ninth Circuit's finding.

The second passage from H.R. Rep. No. 94-1476 stated:

Subsection (b) of section 114 makes clear that statutory protection for sound recordings extends only to the particular sounds of which the recording consists and would not prevent a separate recording of another performance in which those sounds are imitated. Thus, infringement takes place whenever all *or any substantial portion* of the actual sounds that go to make up a copyrighted sound recording are reproduced in phonorecords by repressing, transcribing, recapturing off the air, or any other method, or by reproducing them in the soundtrack or audio portion of a motion picture or other audiovisual work. Mere imitation of a recorded performance would not constitute a copyright infringement even where one performer deliberately sets out to simulate another's performance as exactly as possible.²⁴⁰

The court explained that the phrase "any substantial portion" was dispositive language that proved that "Congress intended to maintain the *de minimis* exception for copyrighted sound recordings."²⁴¹ Although, on its face, this reasoning sounded logical,

²³⁸ See *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 800 (6th Cir. 2005); see also *Griffin v. J-Records*, 398 F. Supp. 2d 1137, 1142-43 (E.D. Wash. 2005); *Zany Toys, LLC v. Pearl Enterprises, LLC*, No. CIV.A. 13-5262 (JAP)(TJB), 2014 WL 2168415, at *11-12 (D.N.J. May 23, 2014).

²³⁹ See *Bridgeport*, 410 F.3d at 800; see also *Griffin*, 398 F. Supp. 2d at 1142-43; *Zany Toys*, 2014 WL 2168415, at *11.

²⁴⁰ *VMG Salsoul*, 824 F.3d at 883 (emphasis in original) (quoting H.R. REP. NO. 94-1476, at 106 (1976)).

²⁴¹ *Id.* at 884.

it could be argued that the legislature intended to discuss the fair use defense versus the *de minimis* exception. This is because the phrase “any substantial portion,” relied upon by the Ninth Circuit for rationalizing Congress’s intent to keep the *de minimis* exception is found, almost verbatim, directly in the language of the statute creating the fair use doctrine: “[i]n determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include . . . (3) the amount and *substantiality of the portion* used in relation to the copyrighted work as a whole”²⁴²

Fair use was codified at the same time as copyright protections for sound recordings. As a House Judiciary Committee member stated in the same report cited above: “[t]he judicial doctrine of fair use, one of the most important and well established *limitations on the exclusive right of copyright owners*, would be given express statutory recognition for the first time in section 107.”²⁴³ Thus, the Ninth Circuit’s analysis appears less convincing because Congress may have been signaling fair use, instead of a *de minimis* exception, when it mentioned the word “substantial” in its report. Therefore, courts deciding which approach to follow for these types of cases should keep in mind that the Sixth Circuit’s ruling leaves the possibility of the fair use defense,²⁴⁴ which, as argued, may have been Congress’s intention all along.

3. *The Ninth Circuit’s Critique of the Bridgeport Holding*

The Ninth Circuit continued its analysis of 17 U.S.C. § 114 with a critique of the Sixth Circuit’s interpretation of the same statute in *Bridgeport*.²⁴⁵ The Ninth Circuit first reasoned that the Sixth Circuit’s interpretation of § 114(b) must be rejected because it did not consider the statutory structure and it ignored the “expressed limitations.”²⁴⁶ However, as discussed above, the Ninth Circuit’s

²⁴² 17 U.S.C. § 107 (2018) (emphasis added).

²⁴³ H.R. REP. NO. 94-1476, at 65 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5678 (emphasis added.).

²⁴⁴ *Bridgeport*, 410 F.3d at 805 (“Since the district judge found no infringement, there was no necessity to consider the affirmative defense of ‘fair use.’ On remand, the trial judge is free to consider this defense and we express no opinion on its applicability to these facts.”).

²⁴⁵ *VMG Salsoul*, 824 F.3d at 884.

²⁴⁶ *Id.*

statutory structure “limit” theory raises issues of its own.²⁴⁷ The Ninth Circuit’s methods, and the rationale for those methods, in both its plain meaning and legislative history analysis, are arguably unsupported. Thus, rejecting the Sixth Circuit’s claim solely because it did not take the Ninth Circuit’s questionable approach is unpersuasive.

The Ninth Circuit then reasoned that the Sixth Circuit’s analysis should be rejected because it did not take into account the legislative history.²⁴⁸ The Sixth Circuit did not engage in a legislative history analysis of sampling because digital sampling was not yet created when Congress enacted the statute.²⁴⁹ Yet, the Sixth Circuit did recount the history of the Copyright Act regarding its enactment to combat piracy of sound recordings.²⁵⁰

The Ninth Circuit then explained that the Sixth Circuit’s conclusion about the word “entirely” in the statute, and its legal effect, should be rejected because it was based on a logical fallacy.²⁵¹ The court stated, “[a] statement that rights do not extend to a particular circumstance does not automatically mean that the rights extend to all other circumstances. In logical terms, it is a fallacy to infer the inverse of a conditional from the conditional.”²⁵² Just because one circuit concludes that an argument may be a fallacy does not explicitly mean that the argument is, in fact, incorrect; this assumption, itself, is

²⁴⁷ See *supra* notes 221-36 and accompanying text.

²⁴⁸ *VMG Salsoul*, 824 F.3d at 884 (“We reject that interpretation of § 114(b). *Bridgeport* ignored the statutory structure and § 114(b)’s express *limitation* on the rights of a copyright holder. *Bridgeport* also declined to consider legislative history on the ground that ‘digital sampling wasn’t being done in 1971.’” (citation omitted)).

²⁴⁹ *Bridgeport*, 410 F.3d at 805.

²⁵⁰ *Id.* at 800.

²⁵¹ *VMG Salsoul*, 824 F.3d at 884; see also *Bridgeport*, 410 F.3d at 800-01 (“The significance of this provision is amplified by the fact that the Copyright Act of 1976 added the word ‘entirely’ to this language. Compare Sound Recording Act of 1971, Pub. L. 92-140, 85 Stat. 391 (Oct. 15, 1971).”).

²⁵² *VMG Salsoul*, 824 F.3d at 884.

actually a fallacy.²⁵³ Thus, as the dissent in *VGM* also concluded, this argument should not be given too much weight.²⁵⁴

It must be reiterated that the Ninth Circuit, for reasons unknown, during its interpretation of 17 U.S.C. § 114(b), made no mention of the Sixth Circuit's analysis of the section on the exclusive right to prepare a derivative work.²⁵⁵ If the Ninth Circuit had mentioned this, then its ruling allowing for some forms of sampling-without-permission, may have been difficult to reach. When a person applies for a license of a sound recording, he must fill out a Form SR.²⁵⁶ If the sound recording he seeks to license contains a sample, thus, a derivative work,²⁵⁷ the Form SR requires that he disclose "any preexisting work or works that this work is based on or *incorporates* . . . [and/or] a brief, general statement of the material that has been *added* to this work and in which copyright is claimed."²⁵⁸

Further, because the creator of this new work would have to disclose any sampled portion he incorporated into his work, he would either have to lie on the Form SR, thereby committing fraud, or advise

²⁵³ *Fallacist's Fallacy*, LOGICAL FALLACIES, <http://www.logicalfallacies.info/relevance/fallacists/> (last visited Nov. 14, 2018) ("The fallacist's fallacy involves rejecting an idea as false simply because the argument offered for it is fallacious. Having examined the case for a particular point of view, and found it wanting, it can be tempting to conclude that the point of view is false. This, however, would be to go beyond the evidence."); *Fallacy Fallacy*, FALLACY FILES, <http://www.fallacyfiles.org/fallfall.html> (last visited Nov. 14, 2018) ("[T]he Fallacy Fallacy is committed only when a conclusion is rejected as false because an argument for it is fallacious, that is, commits a logical fallacy. Since a logical fallacy is a mistake in reasoning that is common enough to be named, not just any bad argument will do.").

²⁵⁴ See *VMG Salsoul*, 824 F.3d at 888 (Silverman, J., dissenting) ("The majority chooses to follow the views [i.e. the fallacy argument] of a popular treatise instead of an on-point decision of the Sixth Circuit, a decision that has governed the music industry in Nashville—"Music City."").

²⁵⁵ See generally *id.*

²⁵⁶ *Form SR*, U.S. COPYRIGHT OFF., Dec. 2016, https://www.copyright.gov/forms/form_sr.pdf ("Use Form SR for registration of published or unpublished sound recordings.").

²⁵⁷ See *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 800-01 (6th Cir. 2005); Howard, *supra* note 74; *Digital Sampling Law and Legal Definition*, USLEGAL, <https://definitions.uslegal.com/d/digital-sampling/> (last visited Nov. 14, 2018) ("Digital sampling refers to a technique of taking a recorded passage from an already existing or recorded musical, spoken or other work and then adding it into a new recording. It is referred as a sample and is regularly used in a repetitive manner or backwards or in combination with other sounds or samples. *Even though the sample may be no longer recognizable*, the new use is an infringement of a right treating it as a *derivative work*. Permission is to be obtained for use of the sample. The U.S. Copyright Act prohibits a person from copying the original artistic work of another, without consent. If a person use [sic] a part of another's work, *even a very small part*, without the copyright owner's consent, s/he is infringing the owner's rights." (emphasis added)).

²⁵⁸ *Form SR*, *supra* note 256 (emphasis added).

the copyright holder of what he sampled; if the holder believes he should be compensated for such an appropriation, the creator of the derivative work may be liable for infringement.²⁵⁹ Similar to the Sixth Circuit's holding, this reasoning implies that there can be no *de minimis* inquiry for the sampling of sound recordings when the sampling has been conceded to because any amount of a sampled sound recording must be disclosed. Moreover, these required disclosures could lend support to the idea that if a work is sampled, regardless of the amount, something of value²⁶⁰ was lifted.

The Ninth Circuit then attacked the Sixth Circuit's finding that the sampling of a sound recording is a physical taking rather than an intellectual one. First, the court compared its sampling case to a case about a photograph used in a movie.²⁶¹ It determined that, because the possibility of a physical taking existed in the photograph case and a *de minimis* inquiry applied, then it should also apply to its sampling case.²⁶² Second, the court stated that even if a different standard should apply to sound recordings versus other works, "that theoretical difference does not mean that Congress *actually adopted* a different rule."²⁶³ This argument does not take into account that the ruling in *Bridgeport* was not the creation of a "new rule" or standard per se, but rather the articulation of the right that was already created by Congress.²⁶⁴

Lastly, the Ninth Circuit disagreed with the Sixth Circuit's analysis because copyright protection did not extend to the "fruit of the [author's] labor" because it premised its understanding of the harm caused by physical takings of sound recordings on "merely saving

²⁵⁹ Willis, *supra* note 5, at 321 ("In *Zacchini*, the Court announced that publishing an artist's entire act constituted an act of infringement. However, the Court did not address the question of partial publicity by another. Copyright owners of sound recordings are guaranteed the right to publicity by section 114 of the Copyright Act of 1976. Any unauthorized public display of a sound recording or musical composition should be considered an infringement. *The display of a de minimis taking is nonetheless a public offering of another person's labor. Such an offering is an act of infringement.*" (emphasis added)).

²⁶⁰ Cf. *Bridgeport*, 410 F.3d at 802.

²⁶¹ *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 885 (9th Cir. 2016); see also *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215, 218 (2d Cir. 1998) ("Because Sandoval's photographs appear fleetingly and are obscured, severely out of focus, and virtually unidentifiable, we find the use of those photographs to be *de minimis*.").

²⁶² *VMG Salsoul*, 824 F.3d at 885; see also *Sandoval*, 147 F.3d at 218.

²⁶³ *VMG Salsoul*, 824 F.3d at 885.

²⁶⁴ *Id.* at 889 (Silverman, J., dissenting) ("That right was not invented by the Sixth Circuit: it already exists in the statutes. And these statutes say nothing about the *de minimis* exception.").

cost” to the creator by not having to hire musicians.²⁶⁵ This analysis fails to take into account, again, that the value of a sound recording sample is not based on the financial savings to a creator for not having to hire musicians to make a new recording. Sound recording samples are “a valuable property right, the stock-in-trade of artists who make their living recoding music and selling records,”²⁶⁶ i.e., licensing and royalty fees. This point was articulated in *VGM*’s dissent, when Judge Silverman stated, “once the sound is fixed, it is tangible property belonging to the copyright holder.”²⁶⁷ Thus, for the reasons discussed, the Ninth Circuit’s critique of the Sixth Circuit’s approach to sampling not only had problems of its own, it also failed to further its determination as to why the *Bridgeport* finding should be rejected. Lastly, another reason exists for rejecting the Ninth Circuit’s approach besides its analysis. Adoption of the court’s approach to this issue could also lead down a path to unanticipated complications for sound recording copyright law.

V. THE SLIPPERY SLOPE OF *DE MINIMIS* SAMPLINGS

In regard to a slippery slope of the *de minimis* exception, the court in *Holmes v. Board of Review*²⁶⁸ held that, “[r]uling that an item is of such low value to be per se trivial would send the wrong message which could be seen as an authorization to [steal] below that amount . . . [C]reat[ing] a *de minimis* [sic] exception . . . could similarly encourage . . . theft of low-value items over extended periods of time.”²⁶⁹ The courts may be “encouraging similar acts”²⁷⁰ by allowing for the taking of low value or trivial parts from a sound recording if it follows the Ninth Circuit holding, which could have unforeseen negative implications for the music industry.

²⁶⁵ *Id.* at 885 (alteration in original).

²⁶⁶ *See id.* at 888 (Silverman, J., dissenting).

²⁶⁷ *Id.* at 890 (Silverman, J., dissenting).

²⁶⁸ No. A-1420-15T1, 2017 WL 1056398 (N.J. Super. Ct. App. Div. Mar. 21, 2017). This case was brought to the Superior court of New Jersey appellate division after an appeal by Holmes who was denied unemployment benefits after his discharge. *Id.* at *1 “Holmes was discharged for taking ten bottles of water over a period of approximately three years, resulting in a loss of \$16.90 for the retail store.” *Id.* The court affirmed the finding of the Board of Review and denied the unemployment benefits because although the left was low in value, the court did not want to create a *de minimis* exception for Holmes’ thievery, as it would potentially set a bad precedent. *Id.*

²⁶⁹ *Id.* at *3.

²⁷⁰ *Holmes*, 2017 WL 1056398, at *3.

After the *VGM* ruling, anyone could arguably sample Madonna's or *VGM*'s horn hit by incorporating it into his song without fear of a lawsuit, as long as his jurisdiction allows for the *de minimis* defense. Because those horn hits have already been considered *de minimis* in the eyes of the Ninth Circuit, no infringement would occur if re-sampled. Accordingly, once a sample has been labeled *de minimis* by law, that sound recording would not be afforded protections for either the original artist nor the sampler because this appropriation would not be actionable. This trivial-sample is considered to be in the public domain because anyone could sample that horn hit, and neither Madonna nor *VGM* would have any right to compensation.

Thus, the "encouragement"²⁷¹ that could possibly come for courts creating *de minimis* exceptions for what they determine to be trivial may, in fact, perpetuate a mentality for would-be infringers to just roll the proverbial dice when deciding to sample another's sound recording because he could assert the *de minimis* defense. Samplers could take their chances at unlicensed sampling and, if caught, claim as a threshold matter that the appropriation is *de minimis*, fostering the cliché: "it's easier to ask forgiveness than it is to get permission."

Moreover, if the *de minimis* exception is allowed for sampling, and there is no limiting principle in place, what is to stop an artist from creating an album on the premise that every song in the album has some small insignificant or trivial piece of another copyrighted song in it? Could an artist do so without concern of litigation because the parts taken may be considered *de minimis* by law? A real-life example shows that this fear has become a reality:

While some artists are still producing heavily-sampled albums, it seems only those with the most obvious fair use defense are confident enough to do so without a license, perhaps recognizing the strength of their defense and realizing record companies would rather not risk setting bad precedent. The D.J. Gregg Gillis, better known as Girl Talk, is perhaps the most notorious sampler; *he uses hundreds of small samples on a single album, never licenses anything, generates tons of publicity, and is never sued.* As Gillis put it, with so many samples, "[i]t would take you hundreds of hours of work and hundreds of thousands of dollars to clear

²⁷¹ See *id.*

the rights to this album even if you *wanted to*.” Yet, Girl Talk’s business is not without harm. Both iTunes and a CD distributor refused to carry his most recent album, *Night Ripper*, because of legal concerns.²⁷²

Here the excerpt explains that only an artist confident in a fair use defense would dare sample without a license. Thus, if the courts allow for another defense in addition to the fair use test, courts may run the risk of encouraging more “Girl Talks” by labeling certain samples *de minimis*, harping back to the principle established in *Holmes*.²⁷³

A. Possible Solutions

The obvious solution to cure the circuit split is to follow the ruling of the Sixth Circuit, which would not bar fair use²⁷⁴ in sampling of sound recording disputes.²⁷⁵ If courts allowed only the fair use defense in sampling cases, samplers would become more creative in order to satisfy the fair use balancing test, which in turn would mean that their work would differ more significantly than that of a plaintiff. This could foster a robust environment for both copyright holders making new works without fear of being sampled and samplers working harder to ensure that their creation is a unique contribution to

²⁷² Lieberman, *supra* note 2, at 128-29 (footnotes omitted).

²⁷³ *Cf. Holmes*, 2017 WL 1056398, at *3.

²⁷⁴ See 17 U.S.C. § 107 (2018) (emphasis added) on fair use, which provides:

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and *substantiality of the portion* used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work. The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

²⁷⁵ *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 805 (6th Cir. 2005) (“Since the district judge found no infringement, there was no necessity to consider the affirmative defense of ‘fair use.’ On remand, the trial judge is free to consider this defense and we express no opinion on its applicability to these facts.”).

society, which comports with Congress's overall intent for creating the copyright system in the United States.²⁷⁶

If Congress or the courts believe that a *de minimis* defense should remain for sampling cases, they should use a new test, "the removal test,"²⁷⁷ to better determine the substantiality of a sampling, abandoning the current average audience test. The removal test would still determine substantial similarity by way of an average audience but with a significant change. The average audience would not be asked to determine if it could tell the similarities between two works or parts of a work but rather if it could discern an appropriation *at all*.²⁷⁸ Instead of trying to listen for the appropriation between the original work and new work, the new work would have the alleged appropriation removed, and then the factfinder would determine if she hears a difference from the new work with the appropriation versus the new work without it. If a person could easily discern the difference, then the appropriation obviously added something of value to the work, and, thus, is substantial and should be protected.

If this test had been applied in *VGM*, the court would have listened to Madonna's song first with the horn hits, and then without, making the determination if the horn hits removal was "significant" enough to be noticed. If the difference was noticeable, the appropriation was substantial; if not, the appropriation would be considered *de minimis*.²⁷⁹

Thus, if the courts do not follow the ruling of the Sixth Circuit by adhering to a fair use defense, the courts that choose to apply the *de minimis* analysis to sampling cases should consider implementing the removal test.²⁸⁰ A determination of which option is best could only be determined if courts begin using the test.

²⁷⁶ See U.S. CONST. art I, § 8, cl. 8.

²⁷⁷ The name for this test was conceived by the author of this Note.

²⁷⁸ See McGiverin, *supra* note 6, at 1736 n.77 ("As such, a line between substantial and *de minimis* taking might be drawn by imagining what a given song would sound like without the instrument in question. While the bass line of a reggae song, for instance, is only one of several instruments, it is hard to imagine such a song without it. Its inclusion would then be considered to constitute a substantial part of the recording of that song.").

²⁷⁹ See McGiverin, *supra* note 6, at 1736 n.77.

²⁸⁰ The removal test could be used even if courts choose not to engage in a *de minimis* inquiry, as it could serve as an alternative determination of infringement. Moreover, these courts could also apply the fair use defense because not all samples will be considered *de minimis* as a threshold matter.

VI. CONCLUSION

The Sixth Circuit's discussion of the congressional intent from the 1970s as background for its interpretation of 17 U.S.C. § 114(b)²⁸¹ was well reasoned because the need to curtail piracy in sound recordings was prevalent at the time Congress amended the Copyright Act. Additionally, the statistics provided have shown²⁸² that this problem seems only to be worsening. Using this history as additional fodder for the Sixth Circuit's conclusion, that even "small" sampling should not be allowed because it allows for "small" infringements or piracy,²⁸³ provides a rationale for this interpretation.

Moreover, the Sixth Circuit's interpretation of the statute is logically sound. Through its robust reading of the statute, it was able to determine that Congress's insertion of the word "entirely" into the statute meant that it was trying to *further* define the exclusive right of sound recordings by limiting copyright holders' exclusive right to derivative works that were not entirely independent of sounds used from the holder's sound recording. This reasoning led the court to determine that a work containing a sample is a derivative work and is not *entirely* independent of the copyright holder's sounds, and as such, a would-be sampler would need to get a license to create such a work.²⁸⁴ Further, the Sixth Circuit found that the substantial similarity test or inquiry was the wrong test to apply to cases involving the sampling of sound recordings.²⁸⁵

On the other hand, the Ninth Circuit's ruling is full of rationales and methods of analysis that raise many questions. First, the Ninth Circuit's reflexive approach to apply the same analysis to sound recordings as it does with musical compositions is questionable²⁸⁶ without more considerations, such as the different interest in both types of works and that sampling is the act of creating a derivative work. Second, the Ninth Circuit's plain meaning and legislative history analysis of 17 U.S.C. § 114 used debatable rationales and methods.

²⁸¹ *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 800 (6th Cir. 2005).

²⁸² See *supra* text accompanying notes 95-98.

²⁸³ See *Bridgeport*, 410 F.3d at 800 ("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.").

²⁸⁴ See generally *id.*

²⁸⁵ See generally *id.*

²⁸⁶ See *VMG Salsoul*, 824 F.3d at 878.

Lastly, its rationale to reject on-point precedent²⁸⁷ was based on the finding of a “fallacy” and an arguably questionable critique of the Sixth Circuit’s findings. Thus, these reasons diminish *VGM*’s credibility as a case that should be relied upon by other courts facing the same issue.

The possible effects that the Ninth Circuit’s ruling could have on the music industry, such as the potential massive losses in revenue for persons that buy and sell samples, and the advent of more infringers such as “Girl Talk” emerging, must not be forgotten. By using a solution mentioned in this Note, these situations may be curtailed. Thus, the *de minimis* defense should be barred in cases that deal with sampling copyrighted sound recordings or the removal test should be adopted.

²⁸⁷ Cf. *Planned Parenthood of Se. Penn. v. Casey*, 505 U.S. 833, 854 (1992) (“The obligation to follow precedent begins with necessity, and a contrary necessity marks its outer limit. With Cardozo, we recognize that no judicial system could do society’s work if it eyed each issue afresh in every case that raised it.”).