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**GOOD FENCES MAKE GOOD NEIGHBORING RIGHTS:
THE GERMAN FEDERAL COURT RULES ON THE DIGITAL
SAMPLING OF SOUND RECORDINGS IN *METALL AUF METALL***

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ABSTRACT

This article analyzes *Kraftwerk, et al. v. Moses Pelham, et al.*, the recent Federal Court ruling in Germany commonly referred to as the *Metall auf Metall* case regarding whether the taking of two notes of a digital music sample constitutes infringement of German intellectual property laws. The article will compare the German court holding with the most recent U.S. 6th Circuit case on digital sampling, *Bridgeport Music, Inc. v. Dimension Films*. The article will begin with an explanation and history of the technique of digital sampling as used by contemporary musicians. It will then explore the similarities and differences between U.S. Copyright law, which protects copyrightable expression in sound recordings and *verwandte Schutzrechte* or "neighboring rights," a doctrine that protects the economic components of sound recordings for recording artists and music producers in Germany. The article will compare the history of digital music sampling jurisprudence in the two countries, explaining the ways in which both jurisdictions treat the protection of sound recordings, particularly exploring the personal and economic consequences to music artists and producers who contribute to the creation of sound recordings, as well as new musicians who want to sample from previous artists without first obtaining a license from the owner of the intellectual property rights in the recording. The article will offer a critique of both court opinions with respect to their treatment of the proper defenses available to sampling defendants, focusing on the *de minimis* and "fair use" exceptions available to defendants in the United States and the similar *Freie Benutzung* or "free use" provision in Germany. Finally, the article will conclude with a plea to the legislative bodies in both countries to amend their respective statutes governing the boundaries of intellectual property protection offered to owners and users of sound recordings by proposing new laws that will recognize the unique and continuously developing technological innovations that are used today to create music.

* Associate Professor of Law, University of Dayton School of Law, Program in Law & Technology. Unpublished work in progress—Copyright © 2011—Tracy Reilly. I dedicate this article to my husband Mark Budka.

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

--Robert Frost, *Mending Wall*¹

Introduction

Robert Frost's famous poem *Mending Wall* has been interpreted by one contemporary copyright scholar to mean that a "hard-headed notion" of "protecting property rights would not necessarily make a community awash with vibrancy, exuberance and coherence" and that "those who are zealous in building good fences

¹ ROBERT FROST, *MENDING WALL*, in *THE POETRY OF ROBERT FROST* 33 (Edward Connery Lathem ed., 1979).

would sadly ‘mov[e] in darkness,’ as admonished by the poet.² A different, perhaps more neutral reading of the work, is offered by theologian Caroline A. Westerhoff, who writes rather fondly of fences or boundaries, as follows:

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

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

² See, Haochen Sun, *Overcoming the Achilles Heel of Copyright Law*, 5 NW. J. TECH. & INTELL. PROP. 265, 329 (2007).

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

⁴ *Id.* at 1.

⁵ EDUARDO MOISÉS PEÑALVER & SONIA K. KATYAL, PROPERTY OUTLAWS: HOW SQUATTERS, PIRATES, AND PROTESTERS IMPROVE THE LAW OF OWNERSHIP 40-41 (2010).

⁶ *Id.* at 41 (noting how important it is that non-owners of intellectual property “understand precisely what constitutes the [intellectual] good itself” so they know what actions they should take to avoid trespassing on the rights of the owner). See also TERRY L. ANDERSON & PETER J. HILL, THE NOT SO WILD, WILD WEST 206 (2004) (asserting that “[w]ell-defined and secure property rights for intellectual property are a key to economic growth in the modern world”). For discussion of an interesting analogy of providing fences or proper metes and bounds in the area of patent law, see John Cordani, *Patent at Your Own Risk*:

When viewed in the context of copyright infringement and digital sampling, two recent high court rulings—one in the United States and the other in Germany—have ruled that good fences do, indeed, make for sensible legal boundaries with respect to the copyrights held by the owners of sound recordings. While the legal doctrines employed by the courts in each of these cases are different in letter and theory, both courts conclude that owners of rights held in sound recordings should reasonably expect the law to protect the valid boundaries of those rights when third parties engage in the practice of unauthorized digital sampling;⁷ however, both courts also ultimately fall short in setting and defining parameters that will also provide reasonable guidelines for uses that should be considered fair or free for musicians who wish to sample.

This article contains five sections. Section I explores the historical, technical, and cultural development and progression of the practice of digital music sampling, revealing how musicians in today’s modern recording studio (or even at home on their computer) are truly creating sounds that have no legal bounds. Section II discusses the overarching philosophies that have influenced the creation of laws enacted by both the United States and German legislatures to protect sound recordings, focusing on the differences between the property, economic, moral, and entrepreneurial rights components of intellectual property created by musicians and their producers. The third section is a comparative law observation of the differences between how United States copyright law doctrines and German neighboring rights law principles support the intellectual property that is

Linguistic Fences and Abbott Laboratories v. Sandoz, Inc., 95 CORNELL L. REV. 1221 1222 (2010) (discussing the “linguistic fence” or the language used by patent applicants to describe the metes and bounds of their inventions in order to provide meaningful knowledge regarding what exact “intellectual ‘land’” owned by the patentee is off bounds for use by the public).

⁷ See Neil Conley & Tom Braegelmann, *Metall auf Metall: The Importance of the Kraftwerk Decision for the Sampling of Music in Germany*, 56 J. COPYRIGHT SOC’Y U.S.A. 1017, 1018 (2009) (providing the English translation for the German Federal Supreme Court decision in *Kraftwerk v. Pelham*).

contained in the sound recording, the medium in which digital samples are created. It will examine the historical treatment of digital sampling cases in both countries, focusing on the similarities and differences in the U.S. Sixth Circuit ruling in *Bridgeport Music, Inc. v. Dimension Films* and the German court ruling in *Kraftwerk, et al. v. Moses Pelham, et al.*, officially titled *Metall auf Metall* by the *Bundesgerichtshof* or "BGH," which is the highest court for most private law cases in Germany.⁸ Section IV provides a diagnosis of each holding, specifically challenging the analyses and application of the defenses available to third-party samplers. Finally, the article will conclude in Section V by proposing that the current statutes protecting sound recordings in both the United States and Germany are in need of a serious overhaul in light of the continuing and constant technological development of music sampling techniques.

I. Sounds With No Bounds: The History of Digital Sampling

Technically speaking, digital sampling is the electronic process employed by musicians “in which physical sound waves are converted into binary digital units and used to recycle sound fragments originally recorded by other musicians.”⁹ In modern practice, when a musician “samples” another musician’s pre-recorded music, he or she uses digital equipment that literally integrates the prior sounds into a new recording.¹⁰ The manual and analog sampling processes employed by musicians in the past which eventually led to the development and use of digital sampling technology weave an interesting and eclectic tale in the pages of music history. In the 1950s, artists “used

⁸ Simon Apel, *Bridgeport Music, Inc. v. Dimension Films (USA), Metall auf Metall (Germany) and Digital Sound Sampling – “Bright Line Rules”?*, 2 ZEITSCHRIFT FÜR GEISTIGES EIGENTUM/INTELLECTUAL PROPERTY JOURNAL (ZGE/IPJ) 331, 341-42 (2010).

⁹ LAURA LEE STAPLETON, E-COPYRIGHT LAW HANDBOOK §3.07 at 3-38 (2002).

¹⁰ M. Leah Somoano, *Bridgeport Music, Inc. v. Dimension Films: Has Unlicensed Digital Sampling of Copyrighted Sounds Come to an End?*, 21 BERKELEY TECH. L.J. 289, 295-96 (2006).

analog tape machines to cut and loop pre-recorded sounds from melodies to water droplets, changing their tempo, direction, and applying various other manipulations.”¹¹ Later in the 1960s in Jamaica, disc jockeys would perform live music in clubs by combining different songs with the use of turntables, mixers, and microphones.¹² In New York in the 1970s, similar analog technology was employed at block parties where MCs would use microphones to “hype-up a dancing crowd” while “DJs would mix records creating seamless transitions between songs to ensure that there was never a dull moment in the party.”¹³

The creation of the MIDI synthesizer in the 1980s allowed artists and producers to digitally sample snippets of songs previously recorded by other musicians by merely pushing a key on an electronic keyboard to trigger any type of recorded sound from a trumpet to a bass drum and anything in between.¹⁴ Indeed, “[a] sample can be a recording of something quite brief, like a snapped finger, or something many measures long, like a sustained grand piano note.”¹⁵ Thus, the antiquated practice of manual or analog sampling that was prevalent in the 60s and 70s quickly became replaced by cheap and easily accessible digital sampling equipment which enabled the production of a “perfect

¹¹ Reuven Ashtar, *Theft, Transformation, and the Need of the Immaterial: A Proposal for a Fair Use Digital Sampling Regime*, 19 ALB. L.J. SCI. & TECH. 261, 283 (2009).

¹² *Id.* “[T]he Jamaican dance hall was the site of a mixture of older and newer forms of Caribbean music, including calypso, soca, salsa, Afro-Cuban, ska, and reggae.” See MICHAEL ERIC DYSON, THE MICHAEL ERIC DYSON READER 426 (2004).

¹³ Shervin Rezaie, *Play Your Part: Girl Talk’s Indefinite Role in the Digital Sampling Saga*, 26 TOURO L. REV. 175, 179-80 (2010). The author provides an interesting discussion of the origins of “break dancing,” where dancers performed moves in synchronization with breaks in parts of the song “where the percussion section takes over and jams for thirty to fifty seconds.” *Id.* at 179.

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

¹⁵ RICHARD MANSFIELD, THE SAVVY GUIDE TO DIGITAL MUSIC 141 (2005).

reproduction that can be manipulated and inserted into a new song.”¹⁶ This modern sampling technology arms musicians with the ability to copy and alter the original sounds by changing their pitch and other elements;¹⁷ however, because sampling cannot manipulate timbre, or the distinctive tonal quality of the underlying sounds, such sounds “invariably retain their unique qualities” when sampled.¹⁸ Not surprisingly, “[t]his practice of digitally sampling sound recordings led to an increase in litigation in the 1990s, and remains a hotly contested issue today.”¹⁹

II. Is it Legal?: Continued Debate Over the Unauthorized Use of Digital Samples

The overarching question regarding digital sampling continues to be the difficulty in determining the proper legal fences to construct around the ownership rights in musical sound recordings. While most legal scholars seem to concur that copyright owners should reasonably expect *some form* of protection for unauthorized sampling of their

¹⁶ Somoano, *supra* note 10, at 296-97. The difference between analog and digital sound recording technology has been described as follows:

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

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

¹⁷ Mike Suppappola, *Confusion in the Digital Age: Why the De Minimis Use Test Should be Applied to Digital Samples of Copyrighted Sound Recordings*, 14 TEX. INTELL. PROP. L.J. 93, 101 (2006). See also, Somoano, *supra* note 10, at 296 (explaining that “digital sampling, unlike analog sampling, allows artists to easily sample from commercially available digital media, such as compact discs, while gaining a greater ability to alter the speed, pitch, and other characteristics of a sample”).

¹⁸ Michael L. Baroni, *A Pirate's Palette: The Dilemmas of Digital Sound Sampling and a Proposed Compulsory License Solution*, 11 U. MIAMI ENT. & SPORTS L. REV. 65, 70 (1993).

¹⁹ Somoano, *supra* note 10, at 296.

sound recordings, *i.e.*, they agree that the taking and use of others' recordings is not a *per se* entitlement,²⁰ the battle lines appear to be drawn regarding the age-old, global debate over whether the “essence” of intellectual property ownership is different from the rights that imbue to the owners of tangible or real property,²¹ which disputation becomes even more pronounced in the specific area of digital music sampling.²²

Music, like real and personal property, derives value to its owner.²³ While determining the fair market value of Blackacre or a diamond ring may be economically discernable, “[m]usic is a hedonic product whose evaluation is based primarily on the experience it provides to a consumer rather than specific product attributes.”²⁴ Indeed, “music presents us with something special that stimulates and soothes the very essence of the human spirit” and “draws out the most dynamic of human emotion,” even more than

²⁰ In fact, this attitude comports with how most Americans generally regard copyright ownership of songs. In a recent poll conducted by performing rights organization Broadcast Music Incorporated, an overwhelming percentage of Americans—85% to be exact—claimed a belief that songwriters deserved to be paid for their contributions. The question asked in the poll was, ‘If there was a party that wasn’t compensating songwriters, do you think that would be wrong?’ And the common answer to the question was, ‘Yes!’ See John Bowe, *The Music-Copyright Enforcers*, N.Y. TIMES, Aug. 6, 2010, *avail.at* http://www.nytimes.com/2010/08/08/magazine/08music-t.html?pagewanted=1&_r=1.

²¹ Ian McClure, *Be Careful What You Wish For: Copyright’s Campaign For Property Rights And An Eminent Consequence Of Intellectual Monopoly*, 10 CHAP. L. REV. 789, 791-97 (2007).

²² See, e.g., A. Dean Johnson, *Music Copyrights: The Need for an Appropriate Fair Use Analysis in Digital Sampling Infringement Suits*, 21 FLA. ST. U. L. REV. 135, 164 (1993) and Lauren Fontein Brandes, *From Mozart to Hip-Hop: The Impact of Bridgeport v. Dimension Films on Musical Creativity*, 14 UCLA ENT. L. REV. 93, 127 (2007) (both authors claiming that those who sample music created and owned by others should be afforded a *de minimis* defense if found liable for copyright infringement); and Joseph P. Liu, *Regulatory Copyright*, 83 N.C. L. REV. 87, 152 (2004) (arguing that the continued application of traditional fair use principles to complex sampling issues is inadequate and proposing a “flexible regulatory regime” created by Congress to enact and oversee specific industry exemptions to copyright in the area of sampling that would only be imposed when there exists “a threshold level of economic significance” with respect to defendant’s taking).

²³ In a Supreme Court case holding that the unauthorized performance of a copyrighted musical composition in a restaurant or hotel infringes the owner’s exclusive right to perform the work publicly for profit, Justice Holmes famously wrote, “If music did not pay, it would be given up.” See *Herbert v. Shanley Co.*, 242 U.S. 591, 595, 37 S.Ct. 232, 61 L.Ed. 511 (1917).

²⁴ H. RAGHAV RAO & SHAMBHU UPADHYAYA, *INFORMATION ASSURANCE, SECURITY, AND PRIVACY SERVICES* 548 (2009).

other forms of copyright.²⁵ Some would argue that the value in music “relies solely on the ability of the listener to recognize the music,”²⁶ which philosophy is evident in fair use cases involving music such as *Campbell v. Acuff-Rose Music, Inc.* because in order to create an effective parody of a song, “the artist must take the most identifiable pieces of the song.”²⁷

Unfortunately, it has become customary—and even modish—for copyright scholars to describe sampling as mere borrowing or referencing of previous music, akin to the age-old practice of imitating uncopyrightable musical ideas, patterns, and performance styles.²⁸ Some even go so far as to claim that because “the reservoir of [musical] artistic ingenuity has been expended, a digital sampler has *no choice* but to ‘borrow’ from the past.”²⁹ While most legal scholars re-echo this popular “sampling equals borrowing” mantra and “warn that the enclosure of the public domain represents a major crisis facing both the law of ideas and American culture,”³⁰ there are some—albeit,

²⁵ See Napper, *supra* note 14, at 165-66 (acknowledging that “music has become totally enmeshed in the daily lives of Americans” and undoubtedly affects how people behave, relate to one another societally, and respond to one another on an extremely personal level); and David Munkittrick, *Music As Speech: A First Amendment Category Unto Itself?*, 62 FED. COMM. L. J. 665, 668-69 (2010) (discussing the unique function of music in society and claiming that “[a]s a protected mode of expression, music must be understood on its own terms”).

²⁶ Henslee, *supra* note 21, at 686.

²⁷ *Id.*

²⁸ See e.g., Jennifer R.R. Mueller, *All Mixed Up: Bridgeport Music v. Dimension Films and De Minimis Digital Sampling*, 81 IND. L.J. 435, 457 (2006) (“Sample-based recording artists, like writers, visual artists, and filmmakers, necessarily borrow from others in order to create their works”); Lauren Fontein Brandes, *From Mozart to Hip-Hop: The Impact of Bridgeport v. Dimension Films on Musical Creativity*, 14 UCLA ENT. L. REV. 93, 100 (2007) (comparing the acts of modern musicians who borrow digital samples to classical composers who borrow themes, musical phrases, and ideas); Ashtar, *supra* note 9, at 285 (“Samplers’ corpora have expanded wildly as artists borrow from sources as diverse as aboriginal music, foreign film, industrial sounds, and even press conferences”); and Matthew G. Passmore, *A Brief Return to the Digital Sampling Debate*, 20 HASTINGS COMM/ENT L.J. 833, 843 (1998) (maintaining that an artist who samples “borrows sources from the artist’s experience of the surrounding world and incorporates these sources in the generation of a novel and critical artistic expression”).

²⁹ Brandon G. Williams, *James Brown v. In-Frin-Jr.: How Moral Rights Can Steal the Groove*, 17 ARIZ. J. INT’L & COMP. L. 651, 653 (2000) (emphasis added).

³⁰ David Fagundes, *Crystals in the Public Domain*, 50 B.C. L. REV. 139, 140 (2009) (maintaining that “[e]very great story has a villain, and in the story told by enthusiasts of the public domain [in copyright

a vast minority—of those who embrace the axiom that “[u]sing someone else’s music without paying for it should almost never be a fair use.”³¹ In a refreshing departure from the common sampling repertoire, Michael Allyn Pote is one of the few scholars who have recently challenged the notion that sampling is mere borrowing of ideas as opposed to taking of the copyrightable expression of such ideas.³² Responding to a copyright author who claims that music “has a long history of borrowing from previous works,” Pote opines that the author “fails to recognize that the extent of the borrowing is limited to the ideas of the works since more extensive borrowing, such as borrowing the actual expression, would disrupt the incentive provided to artists.”³³ Indeed—as Pote conveys—it is well documented that modern digital technology makes “cloning,” and not just mere copying, borrowing, or referencing of past music possible because the quality of the original recording is entirely preserved³⁴ and, in the case of sampling, duplicated exactly into the new recording.³⁵

While it is true that third-party non-owners of both real property and music undoubtedly find value in these commodities owned by others, the law protects that value much more narrowly than that derived by the owners/creators. When the owner of a

law], that villain is property”). See also Lea Shaver & Catarina Spanga, *The Right to Take Part in Cultural Life: On Copyright and Human Rights*, 27 WIS. INT’L L.J. 637, 637, 640 (2010). The authors state that “[f]or over a decade, legal scholars and public interest advocates have endeavored to defend creative and communicative liberty against efforts at excessive control through copyright.” They also maintain that states wishing to ensure that all of their citizens have the fundamental “right to take part in cultural life” have “a legal obligation to ensure that their intellectual property frameworks do not provide excessive protections at the expense of cultural participation”).

³¹ William Henslee, *You Can’t Always Get What You Want, But If You Try Sometimes You Can Steal It And Call It Fair Use: A Proposal To Abolish The Fair Use Defense For Music*, 58 CATH. U. L. REV. 663, 692-93(2009).

³² See Michael Allyn Pote, *Mashed-Up in Between: The Delicate Balance of Artists’ Interests Lost Amidst the War on Copyright*, 88 N.C. L. REV. 639, 667-69 (2010).

³³ *Id.*

³⁴ See STEVEN BROWN & ULRİK VOLGSTEN, *MUSIC AND MANIPULATION: ON THE SOCIAL USES AND SOCIAL CONTROLS OF MUSIC* 340 (2006).

³⁵ Pote, *supra* note 32, at 668 (a digital sample copies the “exact expression” as fixed in the original sound recording).

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

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

III. The State of the Law Protecting Samples as Sound Recordings

Sound recordings are not recognized by the same legal doctrines in the United States and Germany. The fundamental differences between the legal regimes that protect copyright in the United States (the “common law” system) and Germany (the “civil law” system) can be understood by studying the philosophical backdrop that existed in the seventeenth century when protection of creative works was shifting “from a sovereign privilege to a statutory right.”³⁶ The first school of thought that emerged during this

³⁶ Laura A. Pitta, *Economic and Moral Rights Under U.S. Copyright Law: Protecting Authors and Producers in the Motion Picture Industry*, 12-WTR ENT. & SPORTS LAW 3, 3 (1995).

period in the civil law countries—especially France and Germany—was centered around natural law theory, which advanced the notion that because authors invested creativity in their works, the works should belong to them, and rights in the works should extend to their economic interest as well as their *personal* interest.³⁷

Also known as the artists' rights or *droit d'auteur* copyright system, "the artist's personality is of foremost importance and is the essence of the relationship between the artist and his work. The relationship is not based on the end result--i.e., the work of art--but on the materialization of the artist's personality in his creation."³⁸ Some have described these rights as "moral" rights or "human rights" because they protect the individual traits found in an author's work as well as a dimension of that creation that reflects something over and above the artist's desire to earn an income from the pecuniary exploitation of his or her work.³⁹ Artists' moral rights include (1) attribution, or the right to either claim or disclaim credit for creating a work; (2) integrity, or the right to ensure that the work is not changed absent consent of the artist; (3) publication, or the right to conceal the work from the public until the artist determines it to be satisfactory; and (4) retraction, or the right to renounce authorship of a work and withdraw its public display or dissemination.⁴⁰

As the artists' rights rationale was forming mainly on the European continent, the common law was developing in a different way in other countries. When codifying rights to authors, common law countries like the United States and the United Kingdom

³⁷ *Id.* (Emphasis added.)

³⁸ W.W. Kowalski, *A Comparative Law Analysis of the Retained Rights of Artists*, 8 VAND. J. TRANSNAT'L L. 1141, 1146-47 (2005).

³⁹ Aurele Danoff, *The Moral Rights Act of 2007: Finding the Melody in the Music*, 1 J. BUS. ENTREPRENEURSHIP & L. 181, 183 (2007).

⁴⁰ *Id.*

replaced natural law by providing authors with only limited economic protection in the form of an exclusive reproduction right for a limited time, the purpose of which “was to protect the economic rights held by creators or publishers who purchased the original creator's rights. Thus, creators relinquished all rights in a work (unless otherwise contractually agreed) in exchange for pecuniary recompense.”⁴¹ Copyright law codified pursuant to this theory, thus, recognizes the creation of the work mainly as an aspect of property or an “enrichment of the artist as a result of his work.”⁴² As discussed in more detail below, these philosophies shaped the ways in which differing legal protection of sound recordings have developed, and continue to develop, in the United States and Germany.

A. The United States: Copyright Protection for Sound Recordings

Copyright protection for owners of musical works, including sound recordings, is derived from the United States Constitution, which provides Congress with the enumerated power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”⁴³ In apparent recognition that copyright rights are best structured by providing exclusive and well-delineated privileges to authors of original works, each version of the Copyright Act enacted by Congress throughout history has been drafted with the assumption that authors will be incentivized to create works for the enjoyment of the public only when the law “provide[s] copyright owners with a clear baseline right to exclude non-paying members of society from using the work in ways that the Copyright Act specifically sets out” in order to “facilitate consensual transfers of clearly defined

⁴¹ Pitta, *supra* note 33, at 3.

⁴² Kowalski, *supra* note 35, at 1147.

⁴³ U.S. Const. art. I, § 8, cl. 8.

entitlements in literary and artistic works for payment.”⁴⁴ In other words, copyright law in the United States has historically been concerned with setting delineated boundaries (or "good fences") around the rights of creators of original works.⁴⁵ As such, the Copyright Act protects original works as property of the copyright owner

“...in the form of a Coasean bargain, to allow market transactions to occur. The idea behind statutorily-recognized property rights in literary and artistic works is a manifestation of classical law and economic thought on cost-benefit forms of legal analysis--in order to encourage authorship and increase public welfare, authors must be paid with exclusive rights for their work. This payment encourages authors to create and commercialize their works on the market. The assumption behind a law and economics approach to the copyright system is that an author will only decide to create a work when the author is assured that the expected market revenue from sale of the work exceeds his cost of expression.”⁴⁶

The first Copyright Act enacted by Congress to implement the constitutional mandate did not protect music at all; the intellectual products that qualified for protection, instead, included only books, maps, and charts.⁴⁷ For the first time in history, musical

⁴⁴ Alina Ng, *When Users Are Authors: Authorship in the Age of Digital Media*, 12 VAND. J. ENT. & TECH. L. 853, 855 (2010).

⁴⁵ See, e.g., *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 517-18 (1994) ("Because copyright law ultimately serves the purpose of enriching the general public through access to creative works, it is peculiarly important that the law's boundaries be demarcated as clearly as possible"); and *Lotus Development Corp. v. Borland Intern., Inc.*, 140 F.3d 70, 75 (Mass. 1998) ("When close infringement cases are litigated, copyright law benefits from the resulting clarification of the doctrine's boundaries").

⁴⁶ *Id.* See also, Tom Braegelmann, *Copyright Law in and Under the Constitution: The Constitutional Scope and Limits to Copyright Law in the United States in Comparison With the Scope and Limits Imposed by Constitutional and European Law on Copyright Law in Germany*, 27 CARDOZO ARTS & ENT. L.J. 99, 104 (2009) (maintaining that statements made by George Washington and other framers of the constitution "indicate that the Copyright Clause was intended to engender a marketplace in writings"); and 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. OF CINCINNATI L. REV. 663, 667 (2005) ("The natural rights view treats an individual's intellectual creations with the same protections and rights as tangible, physical property").

⁴⁷ James H. Napper, III, *Life as Art: How Technology and the Infusion of Music Into Daily Life Spurred the Sound Recordings Act of 1971*, 12 TUL. J. TECH. & INTELL. PROP. 161, 166 (2009). For an informative discussion of the expansion of the coverage of copyright law in both the U.K. and the U.S. from the Statute of Anne to the present century, see Lionel Bently, *The Author: From Death Penalty to Community Service*, 20th Annual Horace S. Menges Lecture, 32 COLUM. J.L. & ARTS 1, 6-8 (2008).

works were granted copyright protection under the first revision of copyright in 1831.⁴⁸ In its current version, the Copyright Act of 1976 protects various categories of works, including musical compositions and sound recordings.⁴⁹

It is essential to comprehend the fundamental differences between these two types of copyright protection granted to musical works in order to understand the evolution of sampling jurisprudence in the United States. The difficult problem for samplers is that any time they reproduce and/or distribute copies of a musical work they create that contains a sampled portion neither initially created nor owned by them, multiple clearances will be necessary because two separate copyrights are implicated: the first in the sound recording itself, and the second in the composition.⁵⁰ One author has described the difference between the two copyrights as follows:

"The copyright in a sound recording is distinct from the copyright in the musical composition that may be embodied in the sound recording. The musical composition is what most of us think of as the song. The song exists independent of any particular recording of the song; consequently, there can be a number of different sound recordings of the same song by different recording artists. In most cases, a recorded CD therefore involves two copyrights, one covering the musical composition and one covering the sound recording."⁵¹

⁴⁸ Napper, *supra* note 39, at 166.

⁴⁹ Works of authorship protected by copyright include the following categories: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works. *See* 17 U.S.C. §102(a)(1)-(8) (2006). For a discussion of the protection of sound recordings, specifically, *see also* H.R. Rep. No. 1476, at 56 (1976).

⁵⁰ The Copyright Act distinguishes between "musical works, including any accompanying words" and "sound recordings" for purposes of copyrightable subject matter. 17 U.S.C. § 102(a)(1), (7) (2006). Therefore, "[w]hen a copyrighted song is recorded on a phonorecord, there are two separate copyrights: one in the musical composition and the other in the sound recording." *T.B. Harms Co. v. Jem Records, Inc.*, 655 F. Supp. 1575, 1576 n.1 (D.N.J. 1987).

⁵¹ Eric Charles Osterberg, *Should Sound Recordings Really be Treated Differently Than Other Copyrighted Works? The Illogic of Bridgeport v. Dimension Films*, 53 J. Copyright Soc'y U.S.A. 619, 620 (2006).

Moreover, when a copyright is extended to a sound recording, it is thought to encompass both the contributions of the particular artist(s) performing the composition whose creativity is captured in the resultant recording, as well as the contributions of those responsible for capturing, processing, mixing, and engineering the final recording, *e.g.*, the producers and music engineers who work with the artists in the recording studio and make creative choices during the recording process.⁵² Because "the level of creativity required for copyright protection may result from the way a piece of music is performed or from the way a (natural) sound is recorded by the producer of the record, or both," it has been routinely held in music cases that even short parts of music consisting of only a few notes played in a characteristic style will be determined to possess the requisite originality required by copyright law.⁵³ Ironically, most consumers who ultimately purchase commercial copies of the recording will "deem the designated artist the sole creator, and some recording artists would happily agree"; however, because producers and engineers often control the recording session, those who play such roles in the creation of the recording also have colorable claims of copyright authorship.⁵⁴

To complicate matters even further for the sampling artist, the musician who is the original author of the sampled song has the ability to assign, transfer, or convey any of the rights associated with copyright ownership.⁵⁵ In fact, the standard modern

⁵² Kersting, *supra* note 46, at 668.

⁵³ Apel, *supra* note 8, at 334.

⁵⁴ Mark H. Jaffe, *Defusing the Time Bomb Once Again--Determining Authorship in a Sound Recording*, 53 COPYR. SOC'Y U.S.A. 139, 142 (2006). The author notes the fact that a host of other contributors who participate in the recording process, such as session musicians and back-up singers, are not considered "authors" for purposes of copyright since as a condition to their participation they usually are required to sign written contracts declaring that they have no rights as such. *Id.* at 140-42.

⁵⁵ 17 U.S.C. §201(d). (The law allows a copyright holder to transfer ownership "in whole or in part by any means of conveyance or by operation of law"). See PETER K. YU, *INTELLECTUAL PROPERTY AND INFORMATION WEALTH: COPYRIGHT AND RELATED RIGHTS* 173 (2007) (observing that "[t]he music

recording agreement will include an assignment of all the recording musician's original copyright rights in exchange for the capital investment made by the record company and the many creative and economic contributions it invariably makes to the finished product.⁵⁶ The irony that results from this phenomenon is that, while the primary responsibility to clear and pay for samples is placed on the artist pursuant to the recording agreement, "the artist does not even collect when her song is sampled because the owner of the copyright in the sound recording is usually the record company, and the owner of the musical composition is usually the publishing company."⁵⁷

Regardless of the form taken by a creative work, musical or otherwise, copyright protection will subsist 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."⁵⁸ As such, upon the creation of every sound recording, the artist and the producer are acknowledged as having made "authorial contributions" which qualify for protection under the Act.⁵⁹ Once a work is created, the copyright in such work will vest initially in the author of the work."⁶⁰ If there are many authors to a work—which is often

industry is characterized by dual layers of copyright owners, and each of those copyright owners is granted multiple rights").

⁵⁶ David Dante Troutt, *I Own, Therefore I Am: Copyright, Personality, and Soul Music in the Digital Commons*, 20 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 373, 423 (2010). See also, Michael P. Ryan, 10 CARDOZO J. INT'L & COMP. L. 271, 289-90 (2002) (noting the economic realities that exist in the music business, particularly that a substantial percentage of music products invested in by record companies never turn a profit and that "recording a music CD most often fails to bring a respectable return on investment even under an effective copyright system").

⁵⁷ Kartha, *supra* note 14, at 234-35. The author goes on to note the expensive, time consuming, and often *ad hoc* processes employed by record companies to clear samples, including the fact that most record companies go out of their way to get permission from the sampled artists who do not even own copyrights in the song "because if the resulting usage is offensive to the sampled artist, it may cause a rift in their relationship, and record companies want to avoid this." *Id.*

⁵⁸ 17 U.S.C. §102(a).

⁵⁹ See Bently, *supra* note 25, at 93.

⁶⁰ *Id.* §201(a).

the case when musical works are created—the copyright will vest in all of the authors, making them joint owners of the work with co-ownership rights.⁶¹ Such rights include the "exclusive" ability of the copyright owner to use and to authorize the use of his work in various ways. Section 106 of the Act provides owners of copyrights in most works the exclusive right to reproduce the copyrighted work in copies or phonorecords, to prepare derivative works based upon the copyrighted work,⁶² 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, to perform the work publicly, and to display the work publicly.⁶³ On the other hand, with respect to copyrights in sound recordings, which the Act defines as “works that result from the fixation of a series of musical, spoken, or other sounds,”⁶⁴ the Act only confers the limited rights of reproduction, preparation of derivative works, and

⁶¹ *Id.*

⁶² The Copyright Act defines a derivative work as “a work based upon one or more preexisting works.” See 17 U.S.C. §101. Examples of derivative works include, *inter alia*, a “translation,” a “musical arrangement,” and most relevant for the purposes of this article, a “sound recording.” See Melville Nimmer, NIMMER ON COPYRIGHT § 2.10[A] n.8 (“A sound recording is a derivative work in relation to the musical work recorded therein, just as a motion picture is a derivative work in relation to the novel or screenplay upon which it is based”).

⁶³ “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.”

See 17 U.S.C. § 106.

⁶⁴ 17 U.S.C. §101.

distribution of copies; a performance right is explicitly not provided to sound recordings.⁶⁵

In order to comprehend why sound recordings have more limited rights than those granted to other types of works protected by copyright, it is essential to trace the congressional history of such protection. Until 1972, sound recordings were not protected under federal copyright law, even though the underlying musical compositions that were invariably "embedded" in recordings recording *were* subject to copyright.⁶⁶ This resulted in the anomaly that songwriters would receive all the benefits of federal copyright protection for their songs; however, neither the recording artists, producers, nor the record company would obtain such benefits, and instead would be forced to rely on state copyright protection.⁶⁷

Due to the growing concern in the music industry over rampant acts of record piracy and unauthorized duplication of musical works in the wake of the invention of the audio tape recorder, Congress enacted the Sound Recording Act of 1971, which extended copyright rights to sound recordings, now codified in the existing Copyright Act in Section 114.⁶⁸ The pertinent provisions of Section 114 are as follows:

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

⁶⁵ 17 U.S.C. §114(a).

⁶⁶ Jaffe, *supra* note 56, at 144.

⁶⁷ *Id.* [ADD BLURB ABOUT DIFFERENCES B/T FED CR AND STATE CR PROTECTION]

⁶⁸ Andrew W. Peterson, *To Bootleg or Not to Bootleg? Confusion Surrounding the Constitutionality of the Anti-Bootlegging Act Continues*, 58 OKLA. L. REV. 723, 727 (2005). *See also*, 17 U.S.C. §102(a)(7) (adding sound recordings as a category of works protected by copyright); Sound Recording Act of 1971, Pub. L. No. 92-140, 85 Stat. 391 (1974) (amending the Copyright Act to provide for the creation of a limited copyright in sound recordings for various purposes, including protection against unauthorized duplication and piracy of sound recordings).

(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.⁶⁹

In the event someone other than the copyright owner engages in one or more of the exclusive rights provided by Section 106, the owner can sue such party for copyright infringement if it can show that it possesses a valid copyright in the work and that the defendant copied legally protected elements of the work.⁷⁰ Since direct evidence of copying is “rarely if ever available,” most copyright infringement cases turn on the issue of indirect copying.⁷¹ Indirect copying may be proved by establishing that a defendant had access to the copyrighted work and that there is a substantial similarity between the copyrighted work and the defendant's work.⁷² Whereas the typical copyright infringement action will focus on indirect proof of copying, “the use of samples of preexisting, copyrighted sound recordings is obviously direct copying.”⁷³ Accordingly, once the plaintiff in a sampling suit has proved that the defendant used a sample of his original recording, he has met his *prima facie* case for infringement.

⁶⁹ 17 U.S.C. §114.

⁷⁰ Valeria M. Castanaro, “It’s the Same Old Song”: *The Failure of the Originality Requirement in Musical Copyright*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. LJ. 1271, 1275 (2008).

⁷¹ Smith v. Jackson, 84 F.3d 1213, 1218 (9th Cir. 1996).

⁷² See, e.g., Art Attacks Ink, LLC v. MGA Entertainment Inc., 581 F.3d 1138 (9th Cir. 2009); and Jones v. Blige et al., 558 F.3d 485 (6th Cir. 2009).

⁷³ See Pote, *supra* note 32, at 663.

Whereas direct proof of infringement may be easier to prove in sampling cases, the defendant has options in launching a viable defense of his actions. In addition to protecting the rights provided to authors of original works, copyright law also recognizes that these rights should not be protected to such a great extent that they stifle the creation of new works by subsequent authors.⁷⁴ One way that U.S. courts ensure that a proper balance exists between copyright owners and potential new authors in a copyright infringement suit is by analyzing the requisite originality of the work in question. When the work is a musical creation, if the defendant can convince the court that the part or parts of the plaintiff's song used in the defendant's song are not sufficiently original—or that they belong in the public domain as musical building blocks that should be available for use by all musicians to create—then the plaintiff's case will be dismissed.⁷⁵

Another way courts ensure that the exclusivity rights given to copyright owners are kept in check is by applying the *de minimis* doctrine to infringement cases.⁷⁶ The *de minimis* doctrine has been employed by courts in holding that the defendant's "technical violation" of copyright is so trivial that the law will not impose legal consequences to the acts of the defendant or, similarly, that the defendant's copying has been so insignificant

⁷⁴ Castanaro, *supra* note 52, at 1275.

⁷⁵ *See, e.g., Intersong-USA v. CBS, Inc.*, 757 F.Supp. 274, 282 (S.D.N.Y. 1991) (finding that elements of the plaintiffs' song that were found in the defendants' song were not copyrightable because the "descending scale step motive" employed by the defendants is a "commonly used compositional device" found in many other well-known songs such as "Twinkle, Twinkle Little Star" and, therefore, constitutes "ordinary, unprotectible expression"); and *Tisi v. Patrick*, 97 F.Supp.2d 539 (S.D.N.Y.2000) (finding that the plaintiff's claim of copyright infringement was entirely based on non-protectable elements of his song, such as various keys, tempos, and chord structures that are entirely common to the rock music genre).

⁷⁶ Rezaie, *supra* note 13, at 185-86. *De minimis* is a truncated version of *de minimis non curat lex*, translated from the Latin to mean "the law does not concern itself with trifles." *See Ringgold v. Black Entertainment Television, Inc.*, 126 F.3d 70, 74 (2d Cir. 1997).

that it fails to meet the requirements of substantial similarity, thus despoiling the plaintiff's *prima facie* case for copyright infringement.⁷⁷

After the court has determined that the minimum threshold for copyright infringement has been met and the plaintiff has persuaded the court that the defendant's taking was more than *de minimis*, the defendant may still avoid liability by asserting a number of affirmative defenses, the most prominent of which is fair use.⁷⁸ The current Copyright Act acknowledges that works “for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research” can be argued as uses that are fair and, thus, not subject to the exclusive control of the copyright owner.⁷⁹ Section 107 of the Copyright Act sets forth the following factors a court should balance in determining whether the defendant's fair use claim is legitimate: (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the new work on the market potential of the original copyrighted work.⁸⁰ Most courts that have considered the fair use doctrine in the context of digital sampling; however, have been hesitant to find that such an argument will rescue the defendant's behavior from being deemed infringement, specifically because the defendant is usually hard-pressed to argue that his new recording is not a commercial use, and also because “[sampling] can diminish the value of the

⁷⁷ Ringgold, 126 F.3d at 74. *See e.g.*, *Amsinck v. Columbia Pictures Indus., Inc.*, 862 F. Supp. 1044, 1046 (S.D.N.Y. 1994) (the defendants' film contained scenes in which the plaintiff's artwork was visible in the background but the court held that even if the plaintiff had established a *prima facie* case for copyright infringement, the *de minimis* doctrine requires a finding of no liability for infringement).

⁷⁸ Kersting, *supra* note 46, at 671-72.

⁷⁹ 17 U.S.C. §107.

⁸⁰ 17 U.S.C. §107(1)-(4).

original material, especially when the copied portion lies at the heart of what has been taken."⁸¹

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

Judicial interpretation of digital sampling began with the well-known biblical admonition, “Thou shalt not steal.”⁸² In *Grand Upright Music v. Warner Brothers Records*, Raymond “Gilbert” O’Sullivan sued rapper Biz Markie for using three words and accompanying music from the melody of O’Sullivan’s “Alone Again (Naturally)” in Biz Markie’s album.⁸³ Once Biz Markie admitted to sampling without obtaining the proper licenses or clearances, the Southern District of New York granted O’Sullivan’s preliminary injunction and referred the matter to the United States Attorney for potential criminal prosecution.⁸⁴ Although the music industry cried foul and most commentators scrutinized the court’s holding as a cursory reading of copyright law and an unfairly lopsided victory for owners of musical works,⁸⁵ there were arguably valid reasons why the court felt so justified in its holding.⁸⁶ The defendants and, more specifically, their attorneys made the mistake that all copyright lawyers know is cardinal rule number one:

⁸¹ Nicholas B. Lewis, *Shades of Grey: Can the Copyright Fair Use Defense Adapt to New Re-Contextualized Forms of Music and Art?*, 55 AM. U. L. REV. 267, 286 (2005). See also, Pamela Samuelson, *Unbundling Fair Uses*, 77 FORDHAM L. REV. 2537, 2578 (2009) (“Except in cases involving digital sampling of sound recordings, courts have become more receptive to “quoting” from songs, pictures, and videos...”).

⁸² *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182, 183 (S.D.N.Y. 1991). These four words begin the court’s decision, which suggests an attitude by the court that digital sampling amounts to theft—an action that, as Judge Duffy points out, “violates not only the Seventh Commandment, but also the copyright laws of this country.” *Id.*

⁸³ *Id.*

⁸⁴ *Id.* at 184-85.

⁸⁵ See, e.g., KEMBREW MCLEOD & PETER DICOLA, *CREATIVE LICENSE: THE LAW AND CULTURE OF DIGITAL SAMPLING* 132-33 (2011) (maintaining that the *Grand Upright* court “overstated the degree of certainty that existed in the record industry in 1991 about whether and when sample clearances were obligatory” and that it “erred by not conducting a substantial similarity analysis” or engaging the issue of whether the defendants’ acts were protected by fair use).

⁸⁶ *Grand Upright*, 780 F. Supp. 182, at 184 (holding that “the most persuasive evidence that the copyrights are valid and owned by the plaintiff comes from the actions and admissions of the defendants”).

do not use the copyrighted material of another when you have asked that person for a license and they have refused to give one.⁸⁷ While it was unfortunate for Biz that he was essentially deprived from launching a potential fair use defense for his actions because of ineffective counseling, the *Grand Upright* court in the fledgling holding on unauthorized sampling—while an admittedly over-the-top opinion—was attempting to lay some groundwork in setting boundaries for copyright ownership in songs, as well as guidelines it believed sampling defendants should follow.⁸⁸

Two years later, the District of New Jersey was faced with a copyright infringement claim when defendants digitally sampled portions of plaintiff’s song “The Music’s Got Me” in their song “Get Dumb! (Free Your Body).”⁸⁹ In *Jarvis v. A&M Records*, the defendants copied two parts of the plaintiff’s composition: (1) the bridge section containing the words “ooh...move...free your body” and (2) a “distinctive keyboard riff.”⁹⁰ Because the plaintiff had a registered copyright in the musical composition and the defendants admitted to copying without authorization, the court focused on “whether the copying amounted to an unlawful appropriation.”⁹¹ In determining whether unlawful appropriation occurred, the court applied the “substantial similarity” test.⁹² Although the defendants argued that substantial similarity could occur

⁸⁷ *Id.* at 185.

⁸⁸ See Joshua Crum, *The Day the (Digital) Music Died: Bridgeport, Sampling Infringement, and a Proposed Middle Ground*, 2008 BRIGHAM YOUNG U. L. REV. 943, 951-52 (2008) (maintaining that *Grand Upright* was “shockingly poorly argued case” and lamenting that “[u]nfortunately for future sampling defendants, one of the cases of first impression involved a blatant intellectual theft and continues to cast a preemptive shadow across judicial opinions regarding sampling”).

⁸⁹ *Jarvis v. A&M Records*, 827 F. Supp. 282, 286 (D.N.J. 1993).

⁹⁰ *Id.* at 289.

⁹¹ *Id.*

⁹² *Id.* at 290. The court recognized that “the test for substantial similarity is difficult to define and vague to apply.” *Id.* However, the test requires asking “whether the ordinary, reasonable observer would find the works, taken as a whole, to be substantially similar.” *Taylor v. Four Seasons Greetings, LLC*, 403 F.3d 958, 966 (8th Cir. 2005).

“only if the two songs are similar in their entirety,” the court rejected this argument⁹³ and denied the defendants’ motion for summary judgment because original elements of the plaintiff’s work were literally copied.⁹⁴ From the court’s perspective, this literal appropriation of “the exact arrangement of plaintiff’s composition [said] more than what can be captured in abstract legal analysis.”⁹⁵

Several years later in *Newton v. Diamond*, the Central District of California had the opportunity to refine the analysis of when sampling infringes composition rights held by plaintiffs.⁹⁶ Recognizing that original artists were becoming more aware of their rights when third parties use digital samples of their music without authorization, the Beastie Boys’ attorneys affirmatively negotiated a license in 1992 to sample a copyrighted sound recording of “Choir,” a musical composition created and performed by Newton, a flautist and composer.⁹⁷ As with most songs, the copyright ownership was split; Newton’s record company, ECM Records, owned the sound recording via a 1981 licensing agreement between Newton and ECM, yet Newton had retained ownership of the underlying composition in the same work.⁹⁸ Throughout the Beastie Boys’ song

⁹³ The court provided three reasons for rejecting the defendants’ argument that an ordinary, reasonable listener must confuse one work for the other for substantial similarity to exist. *Jarvis*, 827 F. Supp. at 290. First, if a listener must confuse one work for another, “a work could be immune from infringement so long as the infringing work reaches a substantially different audience than the infringed work.” *Id.* Second, an infringing party may escape liability when he appropriates a large or important portion of another’s work, thus “eviscerat[ing] the qualitative/quantitative analysis.” *Id.* Finally, the defendants’ argument ignores the general principle that substantial similarity focuses on what constitutes a substantial portion of the *plaintiff’s* work rather than the *defendant’s* work. *Id.*

⁹⁴ *Id.* at 292.

⁹⁵ *Id.*

⁹⁶ *See Newton v. Diamond*, 204 F. Supp. 2d 1244, 1246 (C.D. Cal. 2002).

⁹⁷ *Id.* at 1246.

⁹⁸ *Id.* at 1246.

“Pass the Mic,” a three-note sequence and one background note from “Choir” were continuously looped.⁹⁹

Although the Beastie Boys’ sampling of the sound recording was undisputedly lawful, Newton sued, arguing that the Beastie Boys were also required to obtain a separate license from him to use the musical composition of “Choir.”¹⁰⁰ The court, however, refused to grant summary judgment to Newton because the three-note sequence and one background note, when separated from the musical composition as a whole, was not original as a matter of law.¹⁰¹ The court basically held that Newton was attempting to overextend the rights he owned in the composition by maintaining that his own techniques in performing the composition in the studio by “overblowing the C note” (or using breath control to emphasize the note) contributed to the originality elements.¹⁰² Noting that Newton was confusing the originality of sound recordings with the originality of compositions, the court rightly held that since “the sound recording [protects] the sound produced by the performer's rendition of the musical work,” the copyrighted score of “Choir” encompassed by the composition “does not delineate the techniques necessary to reproduce Plaintiff's ‘unique sound’” and is, therefore, not actionable.¹⁰³

The court went on to hold that, even if the note sequences were copyrightable, the Beastie Boys’ alleged infringement was *de minimis* because only two percent of

⁹⁹ *Id.* The three-note sequence and background note lasted approximately six seconds. *Id.*

¹⁰⁰ *Id.* at 1247.

¹⁰¹ Newton, 204 F. Supp. 2d at 1253. Only original works of authorship can gain copyright protection. See 15 U.S.C. § 102(a). The United States Supreme Court has stated that “[t]he sine qua non of copyright is originality” and in order for a work of art to qualify as “original,” it must meet a relatively low threshold: the work must be independently created by the author at possess “at least some minimal degree of creativity.” *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345 (1991). While the court did not find Newton’s three-note sequence to be original, it noted that sequences of less than six notes could be copyrightable when the sequences have accompanying lyrics, comprise “the heart” of the musical composition, or are repetitive. *Newton*, 204 F. Supp. 2d at 1254.

¹⁰² *Id.* at 1251.

¹⁰³ *Id.* at 1249-51.

“Choir” was appropriated, the three-note sequence only appeared once in “Choir”, and the note sequences were not distinctive or “the heart” of “Choir.”¹⁰⁴ Thus, the court opined that the defendants took neither quantitative nor qualitative portions of Newton’s composition because nobody would recognize “from a performance of the notes and notated vocalization alone” that the source of the defendants’ song was, in fact, the plaintiff’s underlying musical composition.¹⁰⁵ The court hung its hat on the fact that because both the note sequence in the composition and vocalization technique used by the plaintiff in the performance of the song are common, “any analysis of distinctiveness must necessarily come from the performance elements [as contained in the sound recording copyright], not the musical composition.”¹⁰⁶

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

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

In 1998, defendants No Limit Films, LLC and related entities released the film *I Got the Hook Up*, which included a recording of the song “100 Miles and Runnin” (“100

¹⁰⁴ *Id.* at 1256.

¹⁰⁵ *Id.* at 1259.

¹⁰⁶ *Id.* at 1258.

Miles”) on its soundtrack.¹⁰⁷ Plaintiffs, owners of the musical composition and sound recording rights in “Get Off Your Ass and Jam” (“Get Off”) by George Clinton, Jr. and the Funkadelics, brought suit for copyright infringement because it was undisputed that “100 Miles” included a digital sample from the sound recording “Get Off.”¹⁰⁸

A “three-note combination solo guitar ‘riff’ that lasts four seconds” opens the recording “Get Off.”¹⁰⁹ From this guitar solo, defendants copied, lowered the pitch, and looped and extended a two-second sample, which appears five times throughout “100 Miles” for approximately seven seconds each occurrence.¹¹⁰ Rather than focusing on the copyrightability and originality of the solo guitar “riff,”¹¹¹ the district court concluded that the defendants’ sampling was *de minimis* and did not “rise to the level of legally cognizable appropriation” under the “fragmented literal similarity” test;¹¹² therefore, the court granted the defendants’ motion for summary judgment.¹¹³

¹⁰⁷ *Bridgeport Music, Inc. v. Dimension Films*, 230 F. Supp. 2d 830, 833 (M.D. Tenn. 2002), *rev’d*, 383 F.3d 390 (6th Cir. 2004), *aff’d and amended on reh’g*, 410 F.3d 792 (6th Cir. 2005).

¹⁰⁸ *Bridgeport Music*, 410 F.3d at 795-96.

¹⁰⁹ *Id.* at 796.

¹¹⁰ *Id.*

¹¹¹ After listening to the recording “Get Off,” the district court concluded that the guitar “riff” was entitled to copyright protection because “a jury could reasonably conclude that the way the arpeggiated chord is used and memorialized . . . is original and creative.” *Id.* at 797.

¹¹² A typical cause of action for copyright infringement requires a plaintiff to prove that a defendant’s work of art is “substantially similar” to the plaintiff’s work of art. “Substantial similarity” is defined as “whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.” *Steinberg v. Columbia Pictures Indus., Inc.*, 663 F. Supp 706, 711 (1987). On the other hand, the “fragmented literal similarity” test for copyright infringement arises when there is literal similarity between the plaintiff’s and defendant’s works of art. 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03(A)(2) (Matthew Bender & Company, Inc. 2010). Although literal similarity exists between the two works of art, a plaintiff will not prevail on a copyright infringement cause of action unless the amount that is literally copied “constitutes a substantial portion of [the] plaintiff’s work.” *Id.* at § 13.03(A)(2)(a). Thus, use of a snippet of a plaintiff’s song throughout a defendant’s song will not establish liability if that snippet only constitutes an insubstantial and nonessential portion of the plaintiff’s song. *Id.*

¹¹³ *Bridgeport Music*, 410 F.3d at 797. The district court was guided by the notion that “no reasonable juror, even one familiar with the works of George Clinton, would recognize the source of the sample without having been told of its source.” *Id.* at 798. Additionally, the qualitative differences between the “Get Off” and “100 Miles” recordings and the quantitatively small amount sampled led the district court to believe that plaintiffs would not prevail on a claim for copyright infringement. *Id.*

On appeal to the Sixth Circuit, the plaintiffs argued that a *de minimis* inquiry is inappropriate when an undisputed and unlawful digital sample of a sound recording is involved.¹¹⁴ The Sixth Circuit agreed with the plaintiffs, reversed the district court, and developed a bright-line rule: “Get a license or do not sample.”¹¹⁵ Several important rationales were advanced by the court in support of this bright-line principle in order to protect artists’ boundaries from third-party digital sampling, even if only a *de minimis* amount is taken, while also ensuring that the constitutional purpose of copyright law is served.¹¹⁶

First, future third-party samplers are able to incorporate “riffs” from other works into their own recordings without sampling by either (a) independently creating the sound in the studio or (b) obtaining a license.¹¹⁷ Moreover, “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.”¹¹⁸ Additionally, the prices of licensing fees will be controlled by the music industry.¹¹⁹

Second, although the amount sampled from a recording may be *de minimis*, every time one musician samples another musician’s recording “the part taken is something of

¹¹⁴ *Id.*

¹¹⁵ *Id.* at 798, 801.

¹¹⁶ *Id.* at 801 (“We do not see this [bright-line rule] as stifling creativity in any significant way.”); *see also* U.S. CONST. art. I, § 8, cl. 8 (“Congress shall have the power . . . [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . .”).

¹¹⁷ *Bridgeport Music*, 410 F.3d at 801.

¹¹⁸ *Id.* at 800 (emphasis added). In fact, when owners of sound recordings refuse to license their music to sampling musicians for re-use or agree to do so for exorbitantly high fees that the sampling musician cannot afford, another option is to hire a “sample recreation” company that will re-record new versions of the original song, “and can do so to such a high standard that the original version and the new one are practically indistinguishable.” *See* Richard Salmon, *Sample Clearance: The SOS Guide to Copyright Law on Sampling*, http://www.soundonsound.com/sos/mar08/articles/sampleclearance_0308.htm (last visited on Apr. 19, 2011).

¹¹⁹ *Id.* at 801.

value” from the copyright holder who fixes particular sounds “in the medium of his choice.”¹²⁰ Further strengthening this rationale is the conclusion that sampling is always intentional on the part of the third-party sampler in order to save costs and/or add something to the third-party’s recording.¹²¹

Finally, the predictability of a bright-line rule led the Sixth Circuit to reverse the district court’s decision and emphasis on a *de minimis* inquiry.¹²² A *de minimis* or substantial similarity analysis is not ideal in cases of digital sampling, as it would require “mental, musicological, and technological gymnastics” to determine the requisite threshold of what does or does not constitute infringement.¹²³ While it may be possible for courts to conclude that any digital sample resulting in a “modifi[cation] to the point of being completely unrecognizable or impossible to associate with the copied recording” constitutes infringement,¹²⁴ a bright-line rule is more desirable as it substantially reduces uncertainty in the music industry.¹²⁵ After all, the Sixth Circuit’s opinion was focused on the impact of a new bright-line rule on the music industry rather than being driven by any considerations of judicial economy.¹²⁶

Although the court was adamant in articulating its reasons for a bright-line rule on sampling, it proceeded to hold that while the defendants’ actions amounted to infringement, they were nonetheless entitled to a fair use analysis of their conduct and

¹²⁰ *Id.* at 802.

¹²¹ *Id.* at 801-02 (“When you sample a sound recording you know you are taking another’s work product.”).

¹²² *Id.* at 802.

¹²³ *Id.* at 802.

¹²⁴ While the court’s ruling technically makes any unauthorized sample an infringement, “in practice it is likely that only commercially successful remixes will be prosecuted by the record industry.” See Fredrich N. Lim, *Grey Tuesday Leads to Blue Monday? Digital Sampling of Sound Recordings After the Grey Album*, 2004 U. ILL. J.L. TECH. & POL’Y 369, 379 (2004).

¹²⁵ AL KOHN & BOB KOHN, KOHN ON MUSIC LICENSING 1486-86 (3d ed. 2002).

¹²⁶ Bridgeport Music, 410 F.3d at 803.

that “[o]n remand, the trial judge is free to consider this defense and we express no opinion on its applicability to these facts.”¹²⁷

(a) Criticism of the *Bridgeport* Holding

The Sixth Circuit holding in *Bridgeport Music* has continued to meet with severe criticism by musicians and copyright scholars.¹²⁸ Subsequent courts hearing sampling infringement cases have similarly been reluctant to follow its rationale. For example, in 2009, the Southern District of Florida had the opportunity to rule on the issue of digital sampling in *Saregama India, Ltd. v. Mosley*.¹²⁹ In *Saregama*, plaintiff recording company sued producer Tim Mosley and other defendants for their use of a sample of an Indian sound recording entitled *Bagor Mein Bahar Hai* ("BMBH") in Mosley's song *Put You on the Game* ("PYOG") which was subsequently featured on *The Documentary*, a 2005 album by Jayceon Taylor.¹³⁰ Although the sample was a "one-second snippet" of BMBH that consisted of three notes (D, B flat and G), the notes together formed a descending chord known as a G minor arpeggio that was looped four times in PYOG to create a two-second long "vocal unit"¹³¹ that was found in 109 of the 254 second duration

¹²⁷ *Id.* At 805.

¹²⁸ Matthew S. Garnett, *The Downhill Battle to Copyright Sonic Ideas in Bridgeport Music*, 7 VAND. J. ENT. L. & PRAC. 509, 516 (2005) (after publication of the *Bridgeport* ruling, "commentary and criticism...erupted across the Internet, in the 'blogosphere,' and in other publications"). See also, Ben Sheffner, "Gurl" Trouble: Examining the Merits of Rondor Music's Complaint About the Katy Perry Hit," *BILLBOARD*, Aug. 21, 2010 (referring to the court's holding as "a decision that sampling proponents have harshly criticized."); and Lim, *supra* note 26, at 377 (admonishing the court's opinion by claiming that it results in a situation where "the spirit of copyright law does not seem to apply when faceless corporations use the law to dissuade other artists from using works within the corporations' control").

¹²⁹ *Saregama India Ltd. v. Mosley*, 687 F.Supp.2d 1325 (S.D. Fla. 2009).

¹³⁰ *Id.* at 1326.

¹³¹ *Id.* at 1330.

of PYOG.¹³² The defendants admitted to sampling BMBH and the parties cross moved for summary judgment on the issues of ownership of the copyright and infringement.¹³³

Regarding the issue of ownership, the district court held that a 1967 agreement executed between Saregama India's predecessor in interest and a third-party film producer conferred to Saregama India, at most, a two-year exclusive license to the sound recording which became non-exclusive after the expiration of the two-year term.¹³⁴ On the issue of originality, the court found that while the sampled portion of Saregama India's song was a "common vocal exercise," it would nonetheless be reasonable for a jury to conclude "that the female vocal performance of the G minor chord is a distinct expression capable of copyright protection."¹³⁵ The court next analyzed whether PYOG infringed the plaintiff's work, focusing on whether the songs taken as a whole demonstrated that they were substantially similar and, if so, whether the defendants' use of BMBH was merely *de minimis* and, thus, not actionable.¹³⁶ The court found no substantial similarity as a matter of law because the average lay observer would not mistake PYOG for BMBH or be able to discern the source of the sample "without prior warning" since "[o]ther than the one-second snippet, the songs bear no similarities."¹³⁷

It is noteworthy that the court went on to address Saregama India's contention in direct reliance on *Bridgeport Music* that sound recordings should be analyzed differently than musical compositions, specifically, that any sampling of a sound

¹³² Appellant's brief at 8. [GET PROPER CITE]

¹³³ Saregama, 687 F.Supp.2d, at 1326.

¹³⁴ *Id.* at 1326-27.

¹³⁵ *Id.* at 1337.

¹³⁶ *Id.* at 1337-38.

¹³⁷ *Id.* at 1338.

recording constitutes infringement without application of a *de minimis* analysis.¹³⁸ Citing several copyright infringement cases that deal with subject matter other than sound recordings, the court refused to carve out a separate test for sound recordings, instead insisting that the *Bridgeport Music* holding is a departure from Eleventh Circuit precedent which requires the performance of a substantial similarity test for all claims of copyright infringement.¹³⁹ Additionally, the *Saregama India* court opined that the Sixth Circuit's reading of §114(b) in *Bridgeport Music* does not support its rendition of a *per se* taking rule for copying of digital samples because "it is more expansive than its text and legislative history suggest."¹⁴⁰

After the plaintiffs appealed the lower court decision, everyone in the music industry anxiously waited to see whether the Eleventh Circuit would overturn the decision and apply the same *per se* taking analysis to digital sampling as the Sixth Circuit did in *Bridgeport Music*. In an anticlimactic holding on March 25, 2011, the Eleventh Circuit in *Saregama Music* affirmed the district court's ruling, holding that since the plaintiff did not own a valid copyright in the song recording at issue, the court "need not face the question of whether this copyright has been infringed."¹⁴¹ As such, the *Bridgeport Music* court's ruling stands as the only appellate court precedent regarding the issue of whether a *de minimis* analysis of a sampling defendant's acts should be applied to the infringement of a sound recording.

¹³⁸ *Id.*

¹³⁹ *Id.* at 1338-39. The court relied primarily on *Leigh v. Warner Bros., Inc.*, 212 F.3d 1210 (11th Cir. 2000) for this assertion, quoting the court in that case as stating that "[e]ven in the rare case of a plaintiff with direct evidence that a defendant attempted to appropriate his original expression, there is no infringement unless the defendant succeeded to a meaningful degree." The *Leigh* case, however, involved a photograph taken by the defendants which, although similar to *Leigh's* original photograph, did not directly use or copy any portion of it.

¹⁴⁰ *Saregama India*, at 1340-41.

¹⁴¹ *Saregama India Ltd. v. Timothy Mosley, et al.*, 2011 U.S. App. LEXIS 6211 *14 (11th Cir. 2011).

(b) Endorsement of the *Bridgeport* Holding

Despite the widespread industry contempt for the *Bridgeport Music* holding, the U.S. District Court for the Eastern District of Michigan issued an opinion three years later that unequivocally endorsed the reasoning of the Sixth Circuit regarding the proper legal analysis that courts should follow in copyright suits alleging infringement of a sampled recording.¹⁴² In *Pharmacy Records v. Nassar*, the court was tasked with determining whether the defendants' use of the plaintiffs' recording constitutes unlawful sampling under 17 U.S.C. §114(b).¹⁴³ The court held that the defendants were entitled to judgment as a matter of law because a reasonable jury would not be able to conclude from the evidence presented that the defendants, in fact, sampled the plaintiffs' song.¹⁴⁴ Regardless of the facts in this particular case, the court opined that had the plaintiffs established that the defendants did sample their music, their claim "might survive" by "[a]pplying the proper test" for infringement of sound recordings as set forth in the *Bridgeport Music* holding.¹⁴⁵

¹⁴² David M. Morrison, *Bridgeport Redux: Digital Sampling and Audience Recoding*, 19 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 75, 81 (2008).

¹⁴³ *Pharmacy Records v. Nassar*, 248 F.R.D. 507, 509 (E.D. Mich. 2008).

¹⁴⁴ *Id.* at 528.

¹⁴⁵ *Id.* The Pharmacy Records court held that:

"The protection afforded sound recordings in a digital sampling case such as the one now before the Court, therefore, does not extend to the "generic sound"; it only protects the recorded sound—the stored electronic data digitally preserved by the composer. The substantial similarity test thus has no place in determining whether infringement occurred. As the Sixth Circuit [in *Bridgeport Music*] explained, "[i]n most copyright actions, the issue is whether the infringing work is substantially similar to the original work.... The scope of inquiry is much narrower when the work in question is a sound recording. The only issue is whether the actual sound recording has been used without authorization. Substantial similarity is not an issue." *Dimension Films*, 410 F.3d at 798 n. 6 (quoting Bradley C. Rosen, Esq., 22 CAUSES OF ACTION § 12 (2d ed.2003))." *Id.* at 527.

The Tenth Circuit also favorably cited the *Bridgeport Music* ruling when it ruled in a case where the owner of copyrights in karaoke music sound recordings sued a manufacturer of retail karaoke products for infringement.¹⁴⁶

"The concept is simple. In order for a party in Palladium's position to lawfully use preexisting, copyrighted musical works to create and sell its sound recordings, it must first secure the appropriate licensing from the copyright owners of those musical works. *See* *Bridgeport Music, Inc. v. Dimension Films*, 383 F.3d 390, 398 n. 7 (6th Cir.2004) ("Needless to say, in the case of a [sound] recording of a musical composition the imitator would have to clear with the holder of the composition copyright."). By failing to comply with Section 115, Palladium has illegally used the preexisting material. *See* 17 U.S.C. § 103(a). As a result, Palladium's copyrights in the sound recordings at issue are invalid and unenforceable."

In a copyright infringement action against a distributor for acts of re-recording popular songs, a district court in the Sixth Circuit recently reaffirmed the rationale of its upper court's holding in *Bridgeport Music* when it reiterated the "new standard for analyzing copyright infringement of sound recordings" and unequivocally stated that "the Sixth Circuit held that any sampling of a sound recording constitutes copyright infringement *per se*, regardless of whether the defendant's work is substantially similar to the plaintiff's work, and regardless of whether the relevant audience can identify the copied material."¹⁴⁷

At least one scholar other than myself has embraced the *Bridgeport Music* court's willingness to distinguish that there is a difference between the taking of basic melodies from a composition, which rightly belong in the public domain should it be

¹⁴⁶ *Palladium Music, Inc. v. EatSleepMusic, Inc.*, 398 F.3d 1193 (10th Cir. 2005).

¹⁴⁷ *King Records, Inc. v. Bennett*, 438 F.Supp.2d 812, 849-50 (M.D. Tenn. 2006) (specifically noting the rejection by the Sixth Circuit of the substantial similarity test and the *de minimis* doctrine when analyzing sound recording infringement claims).

proved that such use is *de minimis*, and the taking of those same melodies as captured in a sound recording. Michael Allyn Pote has stated:

"In a musical composition, the ideas may consist of rather basic elements of a song, such as arranging a song to end on a chorus, using a guitar, or singing. Or, the ideas may be much more complex, such as using a double-thumbing technique for guitar. The actual expression of a musical composition would include, for example, the specific arrangement of notes that comprise the melody, the specific words used to constitute the lyrics, and the combinations of all of the instruments that create the rhythm and harmony of the song during a specific portion. The distinction for sound recordings is much clearer since the expression is essentially the fixation of sounds. Thus, a digital sample, or really any sample, would copy the exact expression. The ideas of the sound recording include such elements as the selection of reverb on the vocal or instruments, the spatial placement of the instruments in the mix, the style of compression applied to the overall mix, and so on."¹⁴⁸

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

B. Germany: Neighboring Rights Protection for Sound Recordings

The German Constitution is similar to the U.S. Constitution since it contains a specific provision—Article 14—which authorizes the legislature in Germany to enact laws that will provide for copyright protection.¹⁴⁹ Article 14 contains both a copyright protection clause for creators, as well as a duty to balance that property interest with the public interest.¹⁵⁰ The German Copyright Act or *Urheberrechtsgesetz* (“UrhG”) was

¹⁴⁸ Pote, *supra* note 32, at 668.

¹⁴⁹ Christopher Geiger, *Promoting Creativity Through Copyright Limitations: Reflections on the Concept of Exclusivity in Copyright Law*, 12 VAND. J. ENT. & TECH. L. 515, 539 (2010).

¹⁵⁰ Braegelmann, *supra* note 46, at 126. Because “the property clause of the German Constitution is qualified by a “public good” / “general welfare” / “common weal” provision (“Allgemeinwohlbindung”), the legislature has to make sure that it strikes a just and appropriate balance between the individual interests of authors to profit from their creations on the one hand, and those of the public (and publishers and so forth)

enacted pursuant to this constitutional authority in 1965, providing copyright protection for the life of the author plus seventy years.¹⁵¹ In creating subject matter protection for copyright law, the state is required “to bring the different interests [of the copyright owners] and the competing fundamental rights [of the public welfare] in a proportional balance” by assuring that the public has access to “cultural assets.”¹⁵²

Although German copyright law does not recognize the defense of fair use in the same manner that it is applied in U.S. law *per se*,¹⁵³ the concept of public access or “free use” of cultural assets is generally analogous to fair use, and is promulgated with the following policy goals in mind:

One of the policy reasons for [the] UrhG's time limit is that the general public can demand the free use of intellectual goods for the improvement of cultural life (“Kulturleben”). Another is the fact that every creative person is not creating in a vacuum and without history but is rather building upon the work of his or her predecessors. Yet another is that every cultural expression, if it is not forgotten, becomes some kind of public good or intellectual/creative commons (“geistiges Gemeingut”) and the cultural possession (“Kulturbesitz”) of everybody.¹⁵⁴

In order to promulgate this policy, the German legislature has enacted Section 24 of the UrhG, commonly referred to as the *Freie Benutzung* or “free use” provision, which allows third-party use of an author’s protected work without prior consent, provided that the second work amounts to an “independent” new work.¹⁵⁵ Although the provision does not contain a clear-cut definition of an independent work, it is “commonly recognized as such in German law if the elements of the older work used ‘fade’ in

to exploit the works on the other hand, taking into account the nature and social importance of the right in question.” *Id.*

¹⁵¹ *Id.* at 126-27.

¹⁵² Geiger, *supra* note 78, at 540-41.

¹⁵³ See Edward Lee, *Technological Fair Use*, 83 S. CAL. L. REV. 797, 873 (2010).

¹⁵⁴ Braegelmann, *supra* note 46, at 127.

¹⁵⁵ Apel, *supra* note 8, at 344-45.

comparison to the individuality of the new work.”¹⁵⁶ Like the U.S. doctrine of fair use, free use is an exception or defense to copyright infringement that is determined on an *ad hoc*, case-by-case basis for the purpose of “finding equitable and just solutions” when balancing the delicate rights of owners and subsequent creators; however, the German free use exception is an even narrower doctrine than fair use because it only allows for transformative uses.¹⁵⁷ One German court has explained the free use defense as only being justified if the secondary work ceases to be “deferential” to the original work or adopts a “probing” approach to the original work, further clarifying its analysis as follows:

“The question whether a new independent work has been created by the free use of a protected earlier work depends on the distance which the new work keeps from the borrowed personal features of the used work. ... In other words, as a rule the personal features borrowed from the protected earlier work recede in such a way that the new work no longer makes significant use of the earlier, so that the latter appears only to have suggested the creation of a new independent work.”¹⁵⁸

In addition to the distinctions between fair use and free use, where the philosophical differences between copyright law in Germany and the U.S. differ significantly (as previously discussed) is that the justification for copyright predominantly accepted in Germany is the fundamental qualification of the copyright as being based on a personality right, or “moral right” known as *Urheberpersönlichkeitsrecht*, which means that “in Germany, the copyright is intrinsically and inseparably tied to the personality of the author.”¹⁵⁹ Just as with other

¹⁵⁶ *Id.* at 344.

¹⁵⁷ Paul Edward Geller, *Hiroshige vs. Van Gogh: Resolving the Dilemma of Copyright Scope in Remediating Infringement*, 46, J. COPYRIGHT SOC'Y U.S.A. 39, 43-44 (1998).

¹⁵⁸ See Ian Eagles, *Dr Zhivago's Children: Some Lessons from German Copyright Law's Encounter with the Sequel*, 10 NEW ZEALAND BUS. L. QUARTERLY 109 (2004).

¹⁵⁹ *Id.* at 127-28.

categories of creative authorship, German law offers legal protection to musical works pursuant to an “authors’ rights system” which protects not only the creative endeavors of the person(s) who perform the work, but also the economic or entrepreneurial efforts of the *Tonträgerhersteller* or producer of the sound recording.¹⁶⁰

Unlike in the United States, in Germany there is no copyright protection in the sound recording itself because sound recordings are simply not considered to be “intellectual creations,” or creations that contain originality and creativity.¹⁶¹ Sound recordings are instead protected under the UrhG by “neighboring rights,” or “related rights,”¹⁶² which “are granted to performers, producers, and broadcasters, not for their original, creative input in making a sound recording/phonogram, but for the financial, organizational, and technical effort those persons expend to make a sound recording/phonogram.”¹⁶³ While the UrhG does not specifically define “producer of a phonogram,” the term has commonly come to mean “the natural or legal person in charge of the organization for the whole process of recording.”¹⁶⁴ While this legal entity *may* be the creative producer in the recording studio, it may also be the owner of the record company that manufactures and sells copies of the recording *after* the recording has been made.¹⁶⁵

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

¹⁶⁰ Lewis, *supra* note 77, at 337.

¹⁶¹ Conley & Braegelmann, *supra* note 7, at 1018-19.

¹⁶² Neighboring rights are also referred to as “related rights” in order to distinguish them from author’s rights in the copyright. See JOHN SHEPHERD, CONTINUUM ENCYCLOPEDIA OF POPULAR MUSIC OF THE WORLD, VOL. 1, 491 (2003).

¹⁶³ Conley & Braegelmann, *supra* note 7, at 1020.

¹⁶⁴ Apel, *supra* note 8, at 338.

¹⁶⁵ *Id.*

“...laws that protect performers' renditions, broadcasts, and producers' sound recordings. New communications technologies have redefined this role between artists and intermediaries by making the old concert hall portable and bringing it into the homes of individual viewers and listeners, along with the performers' renditions. In so doing, performers, phonogram producers, and broadcast organizations often add an important artistic dimension to the authors' own contributions. In effect, the neighboring rights laws enable impresarios, producers, and performers to collect a reward for their services even under these changed conditions, and this in turn further ensures that authors covered by copyright law will also receive compensation.”¹⁶⁶

The policy reasons for the creation of a neighboring right in sound recordings in Germany stem from those that led to the enactment of Section 114 in the United States: “[t]he easy availability in the market of increasingly efficient recording devices created the growing problem of record piracy which, by now has become a worldwide problem.”¹⁶⁷ Other initiatives were taken in Germany to protect sound recordings, including ratification of the 1961 Rome Convention, formally known as the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, which is the only international treaty governing performers' rights in sound recordings. The Rome Convention requires signatory members “to grant equitable remuneration to either performers or producers of sound recordings, or both”¹⁶⁸ by providing them with “the right to authorize or prohibit the direct or indirect reproduction of their phonograms.”¹⁶⁹ Specifically, Article 12 of the Rome Convention provides,

¹⁶⁶ See J.H. Reichman, *Legal Hybrids Between Patent and Copyright Paradigms*, 94 COLUM. L. REV. 2432, 2498-99 (1994).

¹⁶⁷ See WORLD INTELLECTUAL PROPERTY ORGANIZATION, INTRODUCTION TO INTELLECTUAL PROPERTY, THEORY AND PRACTICE 6 (1997).

¹⁶⁸ Matthew S. DelNero, *Long Overdue? An Exploration of the Status and Merit of a General Public Performance Right in Sound Recordings*, 51 J. COPYRIGHT SOC'Y U.S.A. 473, 475 (2004).

¹⁶⁹ See, Rome International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations, Oct. 26, 1961, pmbl., 496 U.N.T.S. 43, art. 10. The “producer of phonograms” is defined in the Rome Convention as “the person who, or the legal entity which, first fixes the sounds of a performance or of other sounds.” *Id.* art. 3(c).

“If a phonogram, published for commercial purposes, or a reproduction of such phonogram, is used directly for broadcasting or for any communication to the public, a single equitable remuneration shall be paid by the user to the performers, or to the producers of the phonograms, or to both. Domestic law may, in the absence of agreement by parties, lay down the conditions as to the sharing of this remuneration.”¹⁷⁰

Neighboring rights, which almost always vest in a corporate entity, are also different from moral rights because they do not stem from the personality of the artist or creator. Because “it is considered inappropriate to accord corporations moral rights,” the Rome Convention protects only the reproduction right of the owner of the neighboring right, and not the right of distortion, mutilation, or attribution.¹⁷¹ While a sampling defendant’s acts may result in an infringement of the artist’s moral rights in the *performance* of the musical work at issue, the *Kraftwerk* decision did not involve this separate right, which is, thus, outside of the scope of this article.¹⁷²

While neighboring rights, or *verwandte Schutzrechte*, are generally comparable to the sound recording right granted by U.S. copyright law in that the owner is provided with the exclusive right to copy the recording (yet receives no moral right in the work), German neighboring rights exist in each and every sound recording that is produced without having to overcome the originality requirement that exists under the U.S. Copyright Act.¹⁷³ Specifically, section 85 of the UrGH provides the producer with the right to reproduce the phonogram, to distribute the phonogram, and to make the

¹⁷⁰ *Id.* art. 12.

¹⁷¹ Rebecca F. Martin, *The WIPO Performances and Phonograms Treaty: Will the U.S. Whistle a New Tune?*, 44 J. COPYRIGHT SOC'Y U.S.A. 157, 167 (1997).

¹⁷² See Apel, *supra* note 8, at 338.

¹⁷³ *Id.* at 8, at 337-38. The German equivalent to the low level of originality demanded by the United States is known as *kleine Münze* which translates to “small change,” evidencing that “almost every creative expression is copyrightable in Germany.” See Braegelmann, *supra* note 46, at n.59.

phonogram available to the public, which rights expire fifty years after publication of the work at issue.¹⁷⁴

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

In the 1970s, the band Kraftwerk emerged from Dusseldorf, Germany to defy the then-popular forms of disco and punk music by becoming pioneers in a new genre of electronica (also known as synchronized or “synch”) music that fused analog synthesized bleeps, blips and vocals “into a stark, precision product... mostly with hand-built instruments.”¹⁷⁵ Early bands like Kraftwerk that created electronically generated music started by imitating traditional musical instruments, but would later evolve to incorporate sampling techniques and other computer generated or recorded media to the point where the resulting work product contained “only a tenuous mimetic relationship to live performance.”¹⁷⁶

As Kraftwerk grew in popularity among its fans worldwide, so did third-party use of sampled portions of its recordings.¹⁷⁷ In 1982, the band was furious after musician Afrika Bambaataa made a record called “Planet Rock,” in which he sampled a melody

¹⁷⁴ Apel, *supra* note 8, at 338.

¹⁷⁵ GREG RULE, ELECTRO SHOCK!: GROUNDBREAKERS OF SYNTH MUSIC v (1999). The founding members of the band were drawn to experimental music and free jazz. They experimented with tape recorders, echo machines, and drum machines. “Kraftwerk’s members were among the first pop musicians to abandon traditional rock instrumentation for what was then still-new synthesizer/electronic technology.” See Richard Harrington, *These Days, Kraftwerk is Packing Light*, WASH. POST, May 27, 2005, available at <http://www.washingtonpost.com/wp-dyn/content/article/2005/05/26/AR2005052600677.html>. See also, Richard T. Ford, *Save the Robots: Cyber Profiling and Your So-Called Life*, 52 STAN. L. REV. 1573, 1581 (2000) (commenting that when Kraftwerk’s album “We are the Robots” was released in 1980, “it sounded like the soundtrack to a stylized form of science fiction”).

¹⁷⁶ Ford, *supra* note 28, at 1581.

¹⁷⁷ See, e.g., PASCAL BUSSY, KRAFTWERK: MAN, MACHINE AND MUSIC 128 (2004) (“To list the number of samples that have been taken from Kraftwerk records would be an arduous and difficult task, but suffice to say that after James Brown their records are amongst the most sampled”); and Stephen Dalton, *Kraftwerk: The Elusive Kings of Digital Pop*, THE SUNDAY TIMES, Sep. 25, 2009, available at http://entertainment.timesonline.co.uk/tol/arts_and_entertainment/music/article6847768.ece (noting that the band’s “music has been sampled everywhere, from Fatboy Slim to the Chemical Brothers, Missy Elliott to Jay-Z”). An Internet site created by fans of Kraftwerk has listed nearly one hundred songs claimed to contain samples of the band’s recorded music. See KRAFTWERK SAMPLED, <http://www.cheebadesign.com/perfect/kraftwerk/sample.htm> (last visited on August 6, 2010).

from Kraftwerk's "Trans-Europe Express" as well as a rhythm track from "Numbers" without asking permission or providing credit to Kraftwerk.¹⁷⁸ After a legal battle with Bombaataa, his song was renamed "Planet Rock/Trans-Europe Express" and Kraftwerk received royalties for sales of Bombaataa's records containing the samples.¹⁷⁹

In 1977, Kraftwerk released an album that contained the song *Metall auf Metall*, which is the subject of the band's current sampling controversy.¹⁸⁰ Twenty years later, two versions of the song *Nur mir* by singer Sabrina Setlur were released on two different albums¹⁸¹ and Kraftwerk sued,¹⁸² claiming that the defendants, Setlur and her producers, unlawfully sampled the "core" of *Metall auf Metall*, "a distinct rhythm-texture of several percussion instruments," which lasts approximately two seconds and is repeated throughout the defendants' song.¹⁸³ More specifically, Kraftwerk argued that the composers of *Nur mir* infringed its copyright, in addition to their rights as performing artists and producers of phonograms.¹⁸⁴

Kraftwerk prevailed at both the Regional Court and appeals court based on the rationale that the composers of *Nur mir* infringed Kraftwerk's rights as producers of phonograms pursuant to neighboring rights law in Germany under Section 85 of the UrhG.¹⁸⁵ Notably, the lower court did not rule on the issue of whether use of the sample by the defendants also constitutes copyright infringement of the underlying musical

¹⁷⁸ Pascal, *supra* note 32, at 125-26.

¹⁷⁹ *Id.* at 128.

¹⁸⁰ Conley & Braegelmann, *supra* note 7, at 1025.

¹⁸¹ *Id.*

¹⁸² BGH, no. 1 ZR 112/06, decision dated November 20, 2008, 2009 MMR 253 ("Metall auf Metall"). See Apel, *supra* note 8, at 333 n. 14.

¹⁸³ Conley & Braegelmann, *supra* note 7, at 1025.

¹⁸⁴ *Id.*

¹⁸⁵ *Id.* at 1026. According to copyright law in Germany, "[t]he producer of an audio recording shall have the exclusive right to reproduce and distribute the recording." Gesetz über Urheberrecht und verwandte Schutzrechte [UrhG] [Copyright Law] July 16, 1998, as amended, § 85, ¶ 1.

composition; the case is, thus, based solely on whether Kraftwerk’s neighboring right in the sound recording was infringed.¹⁸⁶

The appeals court held that “even the unauthorized *partial* reproduction and distribution of phonograms infringes, in principle, the rights of phonogram producers.”¹⁸⁷ Rather than determining whether the amount sampled by the composers of *Nur mir* was *de minimis*, the appeals court viewed the drum-beat rhythm-texture from bars nineteen and twenty of *Metall auf Metall* as the “core” of Kraftwerk’s song as well as clearly recognizable in the song *Nur mir*.¹⁸⁸ Therefore, “by appropriating this particular element in its entirety, and continuously underlaying it in the song *Nur mir*, the [composers of *Nur mir*] appropriated, in essence, the entire[ty of *Metall auf Metall*], which consists of the continuous repetition of this formative part, thereby saving themselves effort and expense.”¹⁸⁹

The supreme court held that even if the core of Kraftwerk’s song had not been taken, “even the partial unauthorized reproduction or distribution of the audio recording that is fixed on a phonogram interferes with the rights of the producer of the phonogram,” reasoning that, to hold otherwise would be inconsistent with the Geneva Phonograms Convention, which require “that producers of phonograms receive protection against the reproduction and distribution of *substantial* parts of the sounds that are fixed on the phonogram.”¹⁹⁰ The court rationalized its holding as follows:

“If only the unauthorized reproduction and distribution of the entire phonogram were prohibited, the protection afforded the producer of phonograms would be largely ineffective, as the Plaintiffs’ reply to the

¹⁸⁶ *Id.* at 1018.

¹⁸⁷ Conley & Braegelmann, *supra* note 7, at 1026 (emphasis added).

¹⁸⁸ *See id.*

¹⁸⁹ *Id.*

¹⁹⁰ *Id.* at 1027 (emphasis added).

appeal correctly points out, especially in light of modern digital recording, reproduction, and rendition technologies.”¹⁹¹

Recognizing that neighboring rights are designed to protect the producer’s economic and organizational efforts in the creation of the phonogram, which are separate from the infringement of the author’s rights or the personal intellectual creation of the composer, the court held that the length of the phonogram copied by the sampler is irrelevant to the determination of infringement “because every single bit of sound on such a record owes its origin to the efforts of the producer.”¹⁹² Similarly, the supreme court admonished the appellate court’s reliance on the significance of whether the quality or quantity of the sounds taken were proper criteria in determining neighboring rights infringement, pointing out that such a test in sampling cases would lead “to difficulties of delimitations and, therefore, to legal uncertainty.”¹⁹³ In fact, even if short samples from original songs are not ultimately recognizable or discernable when used in defendants’ songs, such uses are nonetheless actionable even if they are proven to not have an effect on the economic exploitation of the owner’s original song.¹⁹⁴ This is demonstrated by virtue of the fact that a market exists for even the smallest sample of certain recordings, resulting in the phenomenon that, at the very least, the producer will suffer from an economic disadvantage from lost royalties of sounds used by others without prior consent of the producer.¹⁹⁵

¹⁹¹ *Id.*

¹⁹² Apel, *supra* note 8, at 343.

¹⁹³ Conley & Braegelmann, *supra* note 7, at 1029. The court explained that neighboring rights protect all sounds that are recorded on a phonogram, from a work as complex as multiple movements in a symphony to one that contains merely a “short bird chirp.” *Id.*

¹⁹⁴ *Id.* at 1030.

¹⁹⁵ Apel, *supra* note 8, at 343.

At this point in the *Kraftwerk* opinion, it appears that the court is borrowing (pun intended) similar, if not the same, analyses of sampling as the *Bridgeport Music* court employed, including notions of fairness, free riding, ease of infringement, legal certainty, judicial economy, and the importance in creating the proper boundaries of infringement for those who choose to sample without obtaining a license.¹⁹⁶ The bottom line for both courts, as well as the message to potential samplers, is that infringement of the sound recording in the United States and the neighboring right in Germany will be achieved if *any* portion of the recording is taken without authorization because taking any part is taking something of value to its owner.

The second part of the *Kraftwerk* opinion, however, is a significant departure from this line of reasoning and, as such, has been widely criticized by German commentators.¹⁹⁷ Although the court unabashedly ruled that any taking from a sound recording was an infringement of the producer's neighboring rights, it went on to opine, as did the *Bridgeport Music* court, that the defendants were, nonetheless, entitled to wage a free use argument in an attempt to excuse their infringing conduct.¹⁹⁸ Unlike the *Bridgeport Music* court, however, when the *Kraftwerk* court remanded the case back to the appeals court to determine *inter alia* whether the defendants in the case at hand can rely on free use, it provided guidance and a specific test for the lower court to employ.¹⁹⁹

The court first observed that the free use exception set forth in Section 24 of the UrhG cannot be directly applied to neighboring rights of phonograms because the

¹⁹⁶ Conley & Braegelmann, *supra* note 7, at 1018. See also, Apel, *supra* note 8, at 342 (noting that the *Kraftwerk* court's opinion not only made reference to the holding in *Bridgeport Music*, but that its reasoning on these issues are "in line with the prevailing opinion in German legal literature").

¹⁹⁷ Apel, *supra* note 8, at 343.

¹⁹⁸ *Id.* At 344.

¹⁹⁹ Conley & Braegelmann, *supra* note 7, at 1037.

provision is set forth in Section 85, paragraph 4 of the act which contains the limitations and exceptions to the use of the separate copyrighted “work,” or intellectual creation of the song, whereas neighboring rights are “only protected because of the entrepreneurial effort that is embodied in it.”²⁰⁰ Nonetheless, the court went on to hold that the defenses to copyright are “applicable by analogy to the exploitation rights of the producer of phonograms,” providing the following public policy reasons for its position on the matter:

“[I]t would run counter to the spirit and purpose of section 24, paragraph 1, of the UrhG, which is to bring about cultural progress, if in actuality only the creator [author] was obligated to accept the free use of a work, while the producer of phonograms could prevent the free use of the phonogram that contains the work. If the creator [author] is obligated to accept a limitation to his copyright, then the producer of phonograms must correspondingly accept a limitation to his neighboring right.”²⁰¹

While the court made it clear that the free use exception in copyright applies *mutatis mutandis* to neighboring rights, it provided two exceptions in which Section 24 would not provide refuge to sampling defendants: first, in cases where the defendant is able to reproduce the sound copied in the phonogram by his or herself; and second, when the part of the sound copied by the defendant is a recognizable melody.²⁰² Because the court ascertained that there were insufficient findings by the appeals court on these two issues, it remanded the case to the lower court for further consideration in reliance on its opinion.²⁰³

²⁰⁰ *Id.* at 1033. Chapter 6, part 1 of the UrhG contains most of the exemptions to authors’ rights. See Apel, *supra* note 8, at 346.

²⁰¹ *Id.* at 1033-34.

²⁰² See Apel, *supra* note 8, at 345; and Conley & Braegelmann, *supra* note 7, at 1034.

²⁰³ Conley & Braegelmann, *supra* note 7, at 1034.

IV. The Devil is in the Defenses: Where Bridgeport Music and Kraftwerk Went Awry

The crux of both the *Bridgeport Music* and *Kraftwerk* courts is a two-fold message to samplers: *de minimis* is out, but fair use and free use are in. In other words, when samplers take any amount from somebody else's sound recording absent prior license, they will not be able to wage an argument that such use is not copyright infringement (in the United States) or neighboring right's infringement (in Germany), because both courts essentially agree that any taking of a sound recording is a *per se* taking. On the other hand, defendants will nonetheless be entitled to a legal assessment of the defenses of fair use or free use as applied to their conduct.

It can be posited that such a rationale is a proper balance of the two-fold policy goals of intellectual property jurisprudence in building the proper fences around the rights of original songs while allowing use of such songs by second comers in the creation of new works. As will be demonstrated, however, while these defenses may be workable in the context of more traditional musical works, they cannot feasibly be utilized in the complex arena of digital sampling. While the Sixth Circuit has stated that fair use is appropriate in sampling cases, it has failed to provide any guidance whatsoever in assessing the issue in the context of sampling.

Further, the *Kraftwerk* court applies the same rationale with respect to free use, but provides a test that is meaningless at worst or, at best, impossible to apply. The most frustrating facet of the *Kraftwerk* court's decision is its determination that free use cannot apply when the defendant has the ability to produce the sampled music in question, particularly since the court provides no amount of instruction to the lower court

on remand regarding exactly how to assess this matter.²⁰⁴ This oversight will invariably be an insurmountable burden for the lower court since “[t]he question of whether an artist could have produced a sample himself is a particularly difficult one to answer when it comes to the music scene.”²⁰⁵ In fact, some would allege that duplicating a prior sound is extremely difficult and expensive, if not impossible, and in most instances can only be “achieved through some combination of luck and Herculean effort.”²⁰⁶ This is true for several reasons, such as the fact that the recording “gear needs to correspond to the particular sound for faithful renditions, such as period microphones, outboards, amplifiers, and instruments. Beyond these crucial components, the acoustics of the physical recording space are often difficult to recreate.”²⁰⁷

One can only surmise how such a question will ultimately be answered. Will the court consider the musical capability or talent of the particular defendant, the creativity and/or technological capacity of the producer in the studio, the financial ability of the defendant to fund the recreation of the desired sound, the uniqueness of the original sound, or a combination of some or all of these and other unforeseen factors? Ironically, if these standards are employed, then the more unique and obscure the original sound is, the less the owner of the sound recording is protected from non-compensated third-party use. Such an anomaly, thus, provides samplers with an incentive to only use the highest quality sounds, or those they are not able to recreate independently. It is difficult to fathom how such an outcome will comport with the letter and spirit of the UrhG.

²⁰⁴ Apel, *supra* note 346.

²⁰⁵ See Dario Radišić, *Music Sampling and Copyright – Metal on Metal is not automatically “Metal on Metal,”* GOETHE INSTITUT, Oct. 2010, avail. at <http://www.goethe.de/kue/mus/pan/en6649772.htm> (last visited on Apr. 28, 2011).

²⁰⁶ Ashtar, *supra* note 11, at 307.

²⁰⁷ *Id.* (providing the example of a record company whose practice it was to record sessions in a converted abandoned movie theater).

Similarly, with respect to the second free use exception, it is not clear from the *Kraftwerk* court's opinion exactly what parts of a sound recording will be deemed to be defined as "recognizable" melodies and, thus, immune from the defense. Will the court consider whether a general audience can recognize the plaintiff's melody as contained in the defendant's work, or will the same question have to be determined by expert musicologists? More complicated than that, what definition of recognizability should the court apply when resolving this issue? Unfortunately, the *Kraftwerk* court's opinion provided many more questions than answers to this important issue.

V. *The Solution:*

Since a constitutional mandate has been provided to the legislatures of both the United States and Germany to define the scope of copyright protection for musical works,²⁰⁸ it is incumbent upon both bodies of government to restructure the Copyright Act and the UrhG, respectively, in accordance with the modern principles of sampling law that continue to evade traditional doctrine. Some scholars argue that it is time for the United States to expand its moral rights protection in the Copyright Act to the realm of digital samples, noting that a sampling defendant is engaged in a taking of the original producer's "authorial personality."²⁰⁹ Still others believe that a compulsory license should be devised for the secondary use of sound recordings and compositions.²¹⁰ From an examination of the legislative history of §114(b), it is likely that Congress only intended to resolve unauthorized copying of entire sound recordings, as opposed to copying of only a sample of a recording; therefore, many argue that the section does not

²⁰⁸ Ashtar, *supra* note 11, at 313.

²⁰⁹ Troutt, *supra* note 22, at 386.

²¹⁰ Ashtar, *supra* note 11, at 313.

apply to digital sampling if the original work and the new work are not market substitutes.²¹¹

In any event, courts “should not just be dealing with the question whether in any individual case it was possible to reproduce a sample – they should as a matter of principle be concerned with establishing which aesthetic standards should – and must - be permitted in the production of music.”²¹² The only way to achieve this goal is for the legislatures to consult musical experts “with particularly high standards” before determining the precise and proper legal fences for samples.²¹³

Conclusion

Whether or not “good fences make good neighbors” in intellectual property jurisprudence involving third-party use of digital samples remains to be seen. It appears from the *Kraftwerk* decision that—at least according to Germany’s highest court—good fences do, indeed, make good neighboring rights. Similarly, in *Bridgeport Music*, the only circuit court decision in the United States to fully consider the legal boundaries of sound recordings in the context of sampling, the court attempted to advocate strict parameters for such rights.

While both courts arrived at a definable solution to the question of ownership, they ultimately failed to delineate the proper scope of fair or free use to determine when such boundaries can be broken by sampling defendants in order to achieve the proper balance of protecting old works and creating new ones. Since “there are many factors indeed that go into the making of a sound,”²¹⁴ finding a suitable compromise remains a

²¹¹ Watson, *supra* note 15, at 480.

²¹² See Radišić, *supra* note 205.

²¹³ *Id.*

²¹⁴ *Id.*

challenge for both countries and, until it is achieved, both owners and samplers of music will remain subject to the yet complete directives as set forth in these opinions.