SOMETIMES BORROWING ISN'T STEALING: DE MINIMIS SAMPLING OF MUSIC SOUND RECORDINGS ISN'T COPYRIGHT INFRINGEMENT, SAY TWO KEY COURTS IN THE UNITED STATES AND GERMANY

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Intellectual Property Alert

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Setting music sampling up for a potential U.S. Supreme Court battle, the Ninth Circuit sided with Madonna Louise Veronica Ciccone and her producer (Shep Pettibone) in emphatically rejecting the Sixth Circuit's bright-line rule that all unlicensed sampling constitutes copyright infringement.[1] Just days earlier, Germany's highest court ruled against seminal electronic band Kraftwerk in a similar dispute.[2] While the reasoning in both cases overlapped in some respects, the German court went further by expressly protecting the artistic freedom of samplers and rejecting the requirement — which the Ninth Circuit embraced — that the sample not be recognizable as coming from the plaintiff's song.[3]

Music sampling, which is common in some musical genres, is the use of snippets from a sound recording — often altered or enhanced in some manner — in a new sound recording. In *Ciccone*, the Ninth Circuit affirmed the district court's grant of summary judgment in favor of defendants Madonna, Pettibone and their associated record labels, music publishers and distributors on the grounds that — contrary to the Sixth Circuit rule set forth in *Bridgeport* — the *de minimis* exception to copyright infringement applies to sound recordings just as it does to other types of copyrighted works.[4] The samples in question were “horn hits” (punctuation-like snippets of horn section chords) that lasted, respectively, less than a second and less than a quarter-second, and the court found that the average listener was unlikely to recognize their source. In the Kraftwerk case, which involved a two-second drum loop, Germany's Federal Constitutional Court overturned a finding that electropop producer Moses Pelham had infringed, reasoning that the lower court had not sufficiently considered whether the impact of the sample on Kraftwerk might be negligible.[5]

While the sampled horn hits in *Ciccone* were very short and not central to the allegedly infringing song, that was not dispositive. Rather, under U.S. law a “use is *de minimis* only if the average audience would not recognize the appropriation” — in other words, only if “ordinary observations would cause [the sample] to be recognized as having been taken from the work of another.”[6] This is because “the plaintiff's legally protected interest” is “the potential financial return… which derive[s] from the lay public's approbation of his efforts.” [7]

The Ninth Circuit noted that Madonna had taken the samples from only one track (the horns) rather than taking an “entire… temporal segment” of the original song and emphasized the ways in which the producer had digitally altered the sound of the horns (among other changes, the horn hits were transposed into a different key,

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truncated to make them “punchier,” and combined with other sounds and effects).[8] A defendant's digital alteration of the sample is likely to be relevant in many future U.S. sampling cases because, as one musicologist who has served as an expert in such cases has observed, “samples are rarely used unaltered…. [an] important ethic for many producers is to 'flip' or transform the sample in some way in order to show their own creativity.”[9]

The Ninth Circuit also supported its finding that the sample was unrecognizable as to source by discussing the fact that “Plaintiff's primary expert originally *misidentified* the source of” one of the two horn hits, opining that it came from a different part of plaintiff's song and later corrected his opinion after obtaining masters of the accused Madonna song and listening to the horn track separately. Because the standard is whether the average listener can recognize the sample, such a mistake by “a highly qualified and trained musician listening… with the express aim of discerning which parts of the song had been copied” permitted a finding of no infringement as a matter of law.[10]

The Ninth Circuit broadly attacked the Sixth Circuit's reasoning in *Bridgeport*. First, the court explained that the Sixth Circuit's approach to statutory analysis was a “logical fallacy.”[11] Second, the court rejected *Bridgeport*'s reasoning that sampling involves a “physical taking rather than an intellectual one” and thus even trivial takings have value.[12] Finally, the court recognized that “a deep split among the federal courts *already exists*” because “almost every court not bound by [*Bridgeport*] has declined to apply” its bright-line rule.[13]

The Ninth Circuit's ruling in *Ciccone* not only tees up a potential Supreme Court case, but also puts two of the centers of the American music industry at odds with each other: Nashville, where the *Bridgeport* case arose, and Los Angeles (and the West Coast generally) in *Ciccone*. As for the third industry center, the Second Circuit has yet to declare what rule applies in New York but *Ciccone* cites a New York state case that “expressly reject[ed]” the *Bridgeport* rule.[14] And at least one prior Southern District of New York decision reached the same conclusion as the Ninth Circuit with respect to de minimis sampling, rejecting the *Bridgeport* rule.[15]

In the Kraftwerk case, in contrast, the short sample was recognizable and served as a key motif in the accused song. Specifically, “a two-second rhythm sequence” from a 1977 Kraftwerk song “was sampled from the original and embedded, with minor changes only… as a continuously repeated… loop” in the accused song.[16] While the lower court “had introduced the additional criterion that [in order to escape infringement by invoking the “free use” doctrine] the [sampled] sequence could not be reproduced so as to sound like the original,” Germany's highest court rejected that requirement as “not suitable for establishing a proportionate balance between the artistic interest in creativity and the property interests of the [allegedly infringing] producer.”[17]

The German court found that requiring samplers to obtain permission before sampling would conflict “with the interest of other artists to induce a creative process by an artistic dialogue with existing works without being subject to financial risks or restrictions in terms of content.”[18] The fact that the sampler could “obtain a license does not provide an equivalent degree of protection of the freedom of artistic activity” because the copyright holder is under no obligation to grant a license.[19]

A sampler's right to reproduce the original music, rather than sampling it, also fails to protect artistic freedom under German law because the “use of samples is a typical style element of hip-hop” and the “necessary consideration of specific artistic criteria requires that such aspects defining this music genre not be ignored.”[20] The court noted that the German legislature could require samplers to pay royalties to copyright holders in exchange for the right to freely sample, although it had not yet done so.[21] As the press release summarizing the decision stated, “If the artist's freedom of creative expression is measure against an interference

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with the right of phonogram producers that only slightly limits the possibilities of exploitation, the exploitation interests of the phonogram producer may have to cede in favour of the artistic dialogue."[22]

So in Germany, the right to use a brief sample in another creative music recording is now settled law. In the United States, despite the broad geographic reach of the Ninth Circuit, liability for music sampling remains unsettled. Because of the national (if not international) nature of almost all music licensing and distribution, potential plaintiffs in music sampling cases likely will be able to file suit in the Sixth Circuit. Let the forum shopping for music sampling copyright infringement claims and declaratory judgment actions begin! Unless and until a quartet of the current octet led by Chief Justice Roberts and the Notorious RBG grant the inevitable (barring settlement) petition for certiorari in the *Ciccone* case, the United States will remain but a confederacy with respect to the copyright rules governing music sampling.

Notes:

[1] *VMG Salsoul, LLC v. Ciccone*, Nos. 13-57104 & 14-55837, 2016 WL 3090780 (9th Cir. June 2, 2016) (affirming the district court's rejection of the rule set forth in *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792 (6th Cir. 2005)).

[2] *See*, *e.g.*, BBC News, "*Kraftwerk loses German hip-hop copyright case in top court*", BBC News (May 31, 2016), http://www.bbc.com/news/world-europe-36415880.

[3] Press Release No. 29/2016, German Federal Constitutional Court, "*The Use of Samples for Artistic Purposes May Justify an Interference with Copyrights and Related Rights*", (May 31, 2016), http://www.bundesverfassungsgericht.de/SharedDocs/Pressemitteilungen/EN/2016/bvg16-029.html.

[4] *Ciccone*, 2016 WL 3090780 at *1. The court also recognized that under prior precedent, the *de minimis* exception precluded a finding that the sampling infringed the underlying musical composition. *Id.* at *4 (citing *Newton v. Diamond*, 388 F.3d 1189, 1192 (9th Cir. 2004)).

[5] *See*, *e.g.*, Jennifer Baker, "*Kraftwerk loses hip-hop music-sampling copyright case*", Ars Technica (May 31, 2016), http://arstechnica.com/tech-policy/2016/05/kraftwerk-loses-hip-hop-music-sampling-copyright-case-at-german-supreme-court/;

[6] *Ciccone*, 2016 WL 3090780 at *4 (citing cases).

[7] *Id.* at *7 (citing *Sid & Marty Krofft TV Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977)). Thus, the samples' length was relevant to the analysis only in that it made listeners more or less likely to recognize the original source, although the court found it instructive that the earlier *Newton* case held there to be no infringement of a music composition even though the sample was six seconds long. *Id.* at *5 (the samples "that were (as we must assume) taken here are much smaller than the sample at issue in *Newton*").

[8] *Ciccone*, 2016 WL 3090780 at *5–6.

[9] Alexander Stewart, "*Been Caught Stealing: A Musicologist's Perspective on Unlicensed Sampling Disputes*", 83 UMKC L. Rev. 339, 342 (2014).

[10] *Id.* at *6.

[11] *Id.* at *7-–10 (stating, *inter alia*, that "*Bridgeport* ignored the statutory structure and § 114(b)'s express *limitation* on the rights of a copyright holder").

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[12] *Id.* at *11 (“the possibility of a 'physical taking' exists with respect to other kinds of artistic works,” such as photographs, “to which the de minimis rule applies”).

[13] *Id.* at *12 (emphasis in original) (citing cases). The Ninth Circuit vacated an award of attorney's fees to defendants because the plaintiff's claim was premised on a legal theory “adopted [in *Bridgeport*] by the only circuit court to have addressed the issue” and thus was “objectively reasonable.” *Id.* at *2.

[14] *Id.* at *12 (citing *EMI Records Ltd. v. Premise Media Corp.*, No. 601209, 2008 WL 5027245 (N.Y. Sup. Ct. Aug. 8, 2008) (denying a record company's request for a preliminary injunction against filmmakers who had used fifteen seconds of a song, citing 4 Nimmer on Copyright § 13.03[2][b] for its rejection of the *Bridgeport* rule).

[15] *See TufAmerica, Inc. v. Diamond*, Memorandum and Order, Case No. 12-Civ-3529 (AJN) (S.D.N.Y. Sept. 2013 Order re Motion to Dismiss).

[16] *See* German Federal Constitutional Court Press Release No. 29/2016, *supra* note 3, “Facts of the Case” section.

[17] *Id.* at first paragraph.

[18] *Id.* at “Key Considerations of the [Court] Senate,” paragraph 2(b).

[19] *Id*. at paragraph 2(c).

[20] *Id.*

[21] *Id.* at “Key Considerations of the [Court] Senate,” paragraph 1.

[22] *Id.* at first paragraph.

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