

So What'cha Want? The Need for Clarity in Copyright Infringement Cases Based on Digital Sampling

By Robert Potter, Andrew Gerber, and Olivia Harris

I. Introduction

With rather unfortunate timing, hip-hop and R&B label TufAmerica sued the rap group the Beastie Boys (as well as the band's record label, among other music publishing entities) on May 3, 2012,¹ the day before Adam "MCA" Yauch, one of the group's three members, died of cancer at age 47.

In its complaint, TufAmerica—the exclusive licensee of the copyrights in the recordings of "Say What" and "Drop the Bomb" by funk band Trouble Funk—claims that at least four Beastie Boys recordings incorporate unauthorized samples from these two Trouble Funk recordings. Notably, in all four instances, TufAmerica admits that "[the Beastie Boys recording] effectively concealed to the casual listener the fact that the [Trouble Funk] sample was part of [the recording]" and that "[o]nly after conducting a careful audio analysis... was TufAmerica able to determine that [the Beastie Boys recording] incorporates the [Trouble Funk] [s]ample."²

Assuming these allegations are true, and while the Beastie Boys have not filed an answer as this goes to press, the band may well argue that because the samples are "concealed to the casual listener," the parties' works, as a whole, are not substantially similar and that the Trouble Funk samples are, in any event, *de minimis*. If either of these defenses is raised, this case will present a much-anticipated opportunity for the courts to address whether these defenses are availing—or even available—in the context of digital sampling.

II. Substantial Similarity and the *De Minimis* Use Defense

Under U.S. copyright law, in order for the copying of a copyrighted work to be actionable, the copyrighted work and the allegedly infringing work must be substantially similar.³ There is no bright-line test for substantial similarity. Over time, courts have developed varying tests for determining whether two works are substantially similar.⁴

The *de minimis* defense is commonly asserted against alleged substantial similarity in this context. The defense "insulates from liability those who cause insignificant violations of the rights of others."⁵ As with substantial similarity, there is no bright-line test for determining a *de minimis* use, but the Second Circuit, in *Ringgold v. Black Entertainment Television, Inc.*,⁶ articulated three ways in which the defense can be applied:

1. "First, *de minimis* in the copyright context can mean what it means in most legal contexts: a tech-

nical violation of a right so trivial that the law will not impose legal consequences."⁷

2. "Second, *de minimis* can mean that copying has occurred to such a trivial extent as to fall below the quantitative threshold of substantial similarity, which is always a required element of actionable copying."⁸
3. "Third, *de minimis* might be considered relevant to the defense of fair use."⁹

Courts in copyright cases often make a threshold analysis of substantial similarity and potential *de minimis* use in order to determine *prima facie* infringement liability. Once infringement has been established, courts then assess any affirmative defenses, including fair use, within which, as noted in *Ringgold*, *de minimis* use also can be a relevant factor.

In cases involving alleged digital sampling, however, the Sixth Circuit held in *Bridgeport Music, Inc., et al. v. Dimension Films, et al.*,¹⁰ that the court need not engage in a substantial similarity or *de minimis* analysis to decide whether copyright infringement has occurred. Rather, the Sixth Circuit found, digital sampling is infringement *per se*.¹¹ Although *Bridgeport* has been heavily criticized,¹² it remains an unavoidable precedent for artists seeking to use digital samples—even very short ones, and even if the resulting work is not substantially similar to the sampled work—and thus merits close analysis.

III. *Bridgeport Music, Inc. v. Dimension Films*

In *Bridgeport*, a two-second digital sample of three musical notes from George Clinton and the Funkadelics' recording of "Get Off Your Ass and Jam" were used in the song "100 Miles and Runnin'" by rap group NWA. The sample was a very short snippet of a guitar track that NWA had cut and looped in such a way that, according to the district court, it was no longer recognizable as originating from the underlying sound recording. The district court found that "no reasonable juror, even one familiar with the works of George Clinton, would recognize the source of the sampling without having been told of its source," and it held that the use was *de minimis* because it did not "rise to the level of a legally cognizable appropriation."¹³ Accordingly, the court granted summary judgment to NWA.

The Sixth Circuit reversed, finding that *any* sampling of a sound recording, however small, constitutes copyright infringement *per se*. The court rejected categorically the application of a *de minimis* defense or even a substan-

tial-similarity analysis in the digital sampling context.¹⁴ Instead, the court found that “even when a small part of a sound recording is sampled, the part taken is something of value.”¹⁵ Accordingly, one must “[g]et a license or do not sample.”¹⁶

In reaching this conclusion, the Sixth Circuit relied upon section 114 of the Copyright Act, which states, in part, that the exclusive rights granted to copyright holders under section 106 of the Act “do not extend to the making or duplication of another sound recording that consists *entirely* of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording.”¹⁷ According to the *Bridgeport* court, “[t]his means that the world at large is free to imitate or simulate the creative work fixed in the recording so long as an actual copy of the recording itself is not made.”¹⁸ From this noncontroversial conclusion the court then made the questionable leap of logic that because “you cannot pirate the whole sound recording,” you therefore cannot “‘lift’ or ‘sample’ something less than the whole.”¹⁹

In other words, the court concluded, because “a sound recording owner has the exclusive right to ‘sample’ his own recording,”²⁰ sampling by anyone else is essentially *per se* infringement.²¹ The court thereby abdicated its responsibility to assess substantial similarity and effectively rejected even the possibility of a successful *de minimis* defense in connection with digital sampling.

IV. Questioning *Bridgeport*

Bridgeport’s holding, and its apparent blanket prohibition against unlicensed sampling, has been questioned in two subsequent decisions.

In *Saregama India Ltd. v. Mosley, et al.*,²² defendants Timothy Mosley, producer of the sound recording “Put You on the Game,” and others involved with the sound recording and with the album on which it appears, argued that regardless of whether they actually sampled the plaintiff’s sound recording, the defendants’ sound recording was not substantially similar. The court found that “the only portion of [the plaintiff’s sound recording] found in [the defendants’ sound recording] is an approximately one-second snippet of a female vocal performance” and that it was “highly unlikely that the average lay observer could discern the source of the one-second snippet without prior warning.”²³ Because the court found no substantial similarity, it granted summary judgment to the defendants.

The *Saregama* court explicitly rejected the Sixth Circuit’s holding in *Bridgeport* that “any sampling of a sound recording constitutes infringement, no matter how small the sampled snippet,” stating that “the Sixth Circuit’s decision to carve out an exception for sound recordings has not been followed in this Circuit.”²⁴ The court went on to explain that “[the] Eleventh Circuit imposes a ‘substan-

tial similarity’ requirement as a constituent element of *all* infringement claims.”²⁵

In *EMI Records Ltd. v. Premise Media Corp. L.P.*,²⁶ a New York state court case dealing with common-law copyright infringement, the plaintiffs relied on *Bridgeport* in arguing against the defendants’ *de minimis* use defense. The trial court expressly rejected *Bridgeport*’s holding that a *de minimis* exception is not available for sampling sound recordings, and it ultimately found that the defendants’ use of the plaintiffs’ sound recording was fair use because, among other reasons, the use involved criticism of the plaintiffs’ work, and it entailed using only a small portion.

Both the *Saregama* and *EMI Records* court cited David Nimmer’s criticism of *Bridgeport* in *Nimmer on Copyright*. In Nimmer’s view, “the practice of digitally sampling prior music to use in a new composition should not be subject to any special analysis: to the extent that the resulting product is substantially similar to the sampled original, liability should result. Yet against that conclusion comes an unprecedented [opinion] in *Bridgeport* [...]. The Sixth Circuit adopted a bright-line rule at odds with the balance of jurisprudence...by adopting [the] argument that ‘no substantial similarity or *de minimis* inquiry should be undertaken at all when the defendant has not disputed that it digitally sampled a copyrighted sound recording.’”²⁷ Nimmer opines that *Bridgeport*’s interpretation of section 114 is fundamentally incorrect and does not comport with Congressional intent:

[The] sentence [from Section 114 quoted in *Bridgeport*] immunizes the maker of a sound-alike recording; if *no* sounds are recaptured, the newcomer is categorically exempt from liability to the owner of the sound recording. From that proposition, the [*Bridgeport*] panel summarily reasons that if *some* sounds are recaptured, the newcomer’s liability is complete. But it is submitted that that conclusion rests on a logical fallacy. By validating entire sound-alike recordings, the quoted sentence contains no implication that partial sound duplications are to be treated any differently from what is required by the traditional standards of copyright law—which, for decades prior to adoption of the 1976 Act and unceasingly in the decades since, has included the requirement of substantial similarity.... Indeed, had *Bridgeport* [] consulted Section 114’s legislative history instead of dismissing that history as irrelevant, it would have discovered that Congress explicitly noted in that context that “infringement takes place whenever all or any *substantial por-*

tion of the actual sounds that go to make up a copyrighted sound recording are reproduced in phonorecords by repressing, transcribing, recapturing off the air, or any other method....” That excerpt debunks the [*Bridgeport*] court’s imputation that Congress, when adopting Section 114, intended to dispense with traditional notions of substantial similarity.²⁸

V. Conclusion

As digital sampling has become standard not just among hip-hop artists but across the music industry generally, there is a critical need for greater clarity as to what does or does not constitute infringement. The *TufAmerica* case presents an opportunity for some needed judicial guidance to artists and music publishers, at least in the Second Circuit. In the meantime, *Bridgeport* remains good law within the Sixth Circuit. Whether the other circuits move toward or away from *Bridgeport*, and whether there will ever be a uniform approach to digital sampling cases, remains to be seen.

Endnotes

1. *TufAmerica, Inc. v. Diamond, et al.*, 12 CV 3529 (AJN) (S.D.N.Y. 2012).
2. *TufAmerica*, May 3, 2012 Complaint (Docket No. 1), ¶¶ 24-25, 38-39, 51-52, 63-64.
3. See, e.g., *Newton v. Diamond*, 388 F.3d 1189, 1193 (9th Cir. 2004) (“[E]ven where the fact of copying is conceded, no legal consequences will follow from that fact unless the copying is substantial.”) (internal citations omitted); *Ringgold v. Black Entertainment Television, Inc.*, 126 F.3d 70, 74 (2d Cir. 1997) (“[S]ubstantial similarity...is always a required element of actionable copying.”); David Nimmer, *Nimmer on Copyright*, § 13.03 (“[S]ubstantial similarity between the plaintiff’s and defendant’s works is an essential element of actionable copying.”) (internal quotation omitted).
4. See, e.g., Nimmer, *supra* note 3, § 13.03 (identifying, among others, the “abstractions test,” the “total concept and feel” test, and the “iterative test” for assessing substantial similarity).
5. *Ringgold*, 126 F.3d at 74.
6. 126 F.3d 70, 74 (2d Cir. 1997).
7. *Id.* at 74.
8. *Id.*
9. *Id.* at 75.
10. 410 F.3d 792 (6th Cir. 2005).
11. *Bridgeport Music, Inc., et al. v. Dimension Films, et al.*, 410 F.3d 792, 801 (6th Cir. 2005) (“Get a license or do not sample.”).
12. See Nimmer, *supra* note 3, § 13.03 (arguing that the holding in *Bridgeport* “rests on a logical fallacy”).
13. *Bridgeport*, 410 F.3d at 797-98 (internal quotation and citation omitted).

14. *Id.* at 798 (finding that “no substantial similarity or *de minimis* inquiry should be undertaken at all when the defendant has not disputed that it digitally sampled a copyrighted sound recording”).
15. *Id.* at 801-02.
16. *Id.* at 801.
17. 17 U.S.C. § 114(b) (emphasis added).
18. *Bridgeport*, 410 F.3d at 800.
19. *Id.*
20. *Id.* at 801.
21. Notably, while the Sixth Circuit in *Bridgeport* court did not engage in a fair use analysis, it expressly noted that the district court was free to engage in such an analysis on remand. 410 F.3d at 805. This is at odds with its holding that the *de minimis* use doctrine does not apply in cases of digital sampling, as *de minimis* usage may in fact be relevant to a fair use defense. See, e.g., *Ringgold*, 126 F.3d at 75. As *Bridgeport* appears ultimately to have settled, the district court never had a chance to engage in a fair use analysis or to otherwise address this point.
22. 687 F. Supp. 2d 1325 (S.D. Fla. 2009).
23. *Id.* at 1338.
24. *Id.*
25. *Id.* at 1338-39.
26. 2008 WL 5027245, 89 U.S.P.Q.2d 1593 (N.Y. Sup. Aug. 08, 2008).
27. Nimmer, *supra* note 3, § 13.03.
28. *Id.*

Robert N. Potter, Andrew Gerber, and Olivia Harris are associates in the Trademark and Copyright Group in the New York office of Kilpatrick Townsend & Stockton LLP.

NEW YORK STATE BAR ASSOCIATION



Celebrating
20 Years

**Intellectual Property Law Section
20th Anniversary Gala**

September 14, 2012

Gotham Hall | New York, NY
www.nysba.org/IPCelebrates20

