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SAMPLING

In 2005, the Sixth Circuit ruled that there is no de minimis exception to sampling a sound recording. Most other federal circuits have not spoken explicitly on this question, until a recent Ninth Circuit ruling in a case involving Madonna's hit record ''Vogue.''

Sound Recordings and the De Minimus Exception: A Circuit-by-Circuit Analysis

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Is Sampling a Song Without a License ''In Vogue'' Where You Live?

Music sampling is the taking of a portion of one song—a ''sample'' of it—and using it in a new song.

Kanye West sampled Ray Charles's sound recording of ''I Got a Woman'' in his hit song ''Gold Digger.'' Rapper Vanilla Ice sampled the bass line of the 1981 song ''Under Pressure'' by Queen and David Bowie in his hit song ''Ice Ice Baby.''

In these examples, an average person would easily recognize the underlying song, and thus the sampler must pay royalties to the original copyright holder (a lesson all too familiar to Vanilla Ice, who initially failed to give songwriting credit or remit royalties to Queen and Bowie; the issue was later settled out of court for an undisclosed sum of money).

However, what are the sampler's obligations to the copyright holder when the underlying song is not so recognizable?

Federal copyright law provides recourse for copyright holders whose artistic works (including musical compositions and sound recordings) have been used without permission.

However, in most cases, insubstantial, or de minimus, use of a copyrighted work does not trigger liability. The de minimis exception to copyright infringement

stands for the proposition that even where actual copying is conceded, no legal consequences will follow unless that copying is substantial.

As stated by the Ninth Circuit in *Newton v. Diamond*, 388 F.3d 1189, 1192-3 (9th Cir. 2004), ''the law does not concern itself with trifles.''

In the context of visual works, in *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215 (2d Cir. 1998), a photographer sued the producers and distributors of the motion picture ''Seven'' for copyright infringement after discovering that they had displayed 10 of his copyrighted photographs in the movie without permission.

The photographs appeared in the background of one scene of the movie, on a large light-box with a number of photographic transparencies attached to it. Defendants conceded that 10 of the transparencies affixed to the light box were reproductions of Sandoval's images.

Nevertheless, the court found that the use was de minimis (and therefore not actionable), as the photographs ''appear[ed] fleetingly and [were] obscured, severely out of focus, and virtually unidentifiable.''

In the context of musical compositions, federal courts agree that the de minimis exception is applicable, meaning minimal infringement is not actionable infringement. *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 795 (6th Cir. 2005); see also *Newton v. Diamond* (supra) (holding that that the Beastie Boys unauthorized use of a copyrighted musical composition was de minimis and therefore not actionable).

However, a split has recently arisen among the federal circuits as to whether the de minimis exception applies to the sampling of sound recordings. (For ease of reference, a musical composition consists of music, including any accompanying words. A sound recording, on the other hand, is the result of the fixation of a series of music, words, or other sounds. For more information, please visit the United States Copyright Office webpage.)

In the 2005 ruling in *Bridgeport Music, Inc. v. Dimension Films*, the Sixth Circuit was the first United States appellate court to consider the issue, ultimately holding that the de minimus exception does not apply to sampling of sound recordings.

The court reasoned that the music industry was ''best served'' by establishing a bright line test to determine what constituted actionable infringement and what did not.

In essence, ''[g]et a license or do not sample'' is the state of the law in the Sixth Circuit, making any use of a sound recording without a license, no matter how small, actionable.

For more than 10 years, the Sixth Circuit stood alone with no other federal appellate court taking a contrary position, until recently.

On June 2, in *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871 (9th Cir. 2016), the Ninth Circuit rejected the Sixth Circuit's test, instead holding that the de minimus exception to copyright infringement ''applies to infringement actions concerning copyrighted sound recordings, just as it applies to all other copyright infringement actions.''

The court acknowledged that it was taking ''the unusual step of creating a circuit split by disagreeing with the Sixth Circuit's contrary holding in *Bridgeport*.''

The Sixth and Ninth Circuits are the only two federal appellate courts to have directly addressed this issue.

The case is now ripe for Supreme Court review, but until the high court takes up the issue and decides whether unauthorized, de minimis use of sound recordings constitutes actionable infringement, district courts must look the laws of its district courts (or to other circuits), for guidance.

Below is a circuit-by-circuit breakdown of where the law stands on de minimis infringement of sound recordings.

District of Columbia

The District of Columbia has yet to address whether the de minimis exception applies to infringement of sound recordings.

First Circuit (Maine, Massachusetts, New Hampshire, Puerto Rico, Rhode Island)

The First Circuit has yet to address whether the de minimis exception applies to infringement of sound recordings.

Second Circuit (Connecticut, New York, Vermont)

The Second Circuit has yet to decide the issue of whether the de minimis exception applies to infringement of sound recordings.

However, district and state court decisions within the Second Circuit have tended to agree with the Ninth Circuit's reasoning and applied the de minimis exception in the context of sound recordings, with one New York state court expressly declining to follow the Sixth Circuit's reasoning in Bridgeport.

In *TufAmerica, Inc. v. Diamond*, 968 F. Supp. 2d 588, 598 (S.D.N.Y. 2013), the U.S. District Court for the Southern District of New York acknowledged that under its substantial similarity analysis, ''the concept of de minimis is relevant to a defendant's contention that an indisputably copied work has not been infringed.''

There, the plaintiffs had claimed that the hip-hop group the Beastie Boys had unlawfully sampled both the musical compositions and sound recordings of a number of funk/R&B group Trouble Funk's songs.

Because the defendants had taken exact samples of Trouble Funk's songs and incorporated them into Beastie Boys' songs, the court applied the ''fragmented literal similarity'' test, whereby courts consider both the qualitative and quantitative significance of the copied portion in relation to the plaintiff's works as a whole.

The court noted that if the quantitative significance of the use is de minimis, then the alleged infringement is not actionable.

The court applied this standard to each sampled portion of the music plaintiff claimed to have been infringed, and ultimately granted in part and denied in part defendants' motion to dismiss.

At least one New York state court has similarly held that the de minimis exception applies to infringement of sound recordings.

EMI Records Ltd v. Premise Media Corp., No. 601209 (N.Y. Sup. Ct. Aug. 8, 2008), expressly rejected the Sixth Circuit's analysis in *Bridgeport*, and affirmed that New York common law recognizes the de minimis exception to infringement of sound recordings.

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Nonetheless, the court found that though plaintiffs had failed to demonstrate that New York common law does not recognize a de minimis exception, the claim could survive a motion to dismiss as plaintiffs had sufficiently demonstrated valid copyright ownership and unauthorized reproduction of the plaintiffs' copyrighted work.

Third Circuit (Delaware, New Jersey, Pennsylvania, Virgin Islands)

The Third Circuit has yet to address whether the de minimis exception applies to infringement of sound recordings.

Fourth Circuit (Maryland, North Carolina, South Carolina, Virginia, West Virginia)

The Fourth Circuit has yet to address whether the de minimis exception applies to infringement of sound recordings.

Fifth Circuit (Louisiana, Mississippi, Texas)

The Fifth Circuit has yet to address whether the de minimis exception applies to infringement of sound recordings.

However, in *Batiste v. Najm*, 28 F. Supp. 3d 595, 625 (E.D. La. 2014), the U.S. District Court for the Eastern District of Louisiana said that it was ''far from clear'' that the substantial similarity test did not apply to the sampling of sound recordings, acknowledging that the court did not automatically apply the Sixth Circuit's *Bridgeport* standard.

Sixth Circuit (Kentucky, Michigan, Ohio, Tennessee)

In the Sixth Circuit, the de minimis exception does not apply in the context of infringement of sound recordings.

In *Bridgeport*, plaintiffs sued the rap group N.W.A. and others for sampling a two-second guitar solo from the song ''Get Off Your Ass and Jam'' by George Clinton's 1970s group Funkadelic in the N.W.A. song ''100 Miles and Runnin.''

The plaintiffs, owners of the sound recordings and musical compositions to ''Get Off Your Ass and Jam,'' sued for copyright infringement of both the musical compositions and the sound recordings.

On a motion for summary judgment, the district court found that the defendants' use of the song was de minimis and did not ''rise to the level of a legally cognizable appropriation''; the plaintiffs appealed.

The Sixth Circuit overturned the district court's finding of infringement as it applied to the sound recording, establishing a ''new rule'' that the de minimis exception does not apply in the context of sound recordings.

In establishing a ''[g]et a license or do not sample'' bright-line test, the Sixth Circuit considered the ''plethora of copyright disputes'' resulting from the rise of digital sampling, and wrote:

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

The Sixth Circuit adopted this interpretation for several reasons: (1) it read the applicable statute—Section 114(b) of Title 17 of the United States Code—to grant the holder of a copyright to a sound recording the exclusive right to sample his own work; (2) ''ease of enforcement''; and (3) the act of sampling a sound recording is a ''physical taking rather than an intellectual one'' in that the junior user is taking a recorded song, rather than the composition to song.

In the Sixth Circuit, courts do not apply a substantial similarity (or de minimis) analysis with respect to sampling sound recordings; ''a sound recording owner has the exclusive right to 'sample' his own recording.'' Id. at 805 (The Sixth Circuit remanded to the district court, suggesting that the court instead consider the ''fair use'' affirmative defense.)

Seventh Circuit (Illinois, Indiana, Wisconsin)

The Seventh Circuit has yet to address whether the de minimis exception applies to infringement of sound recordings.

Eighth Circuit (Arkansas, Iowa, Minnesota, Missouri, Nebraska, North Dakota, South Dakota)

The Eighth Circuit has yet to address whether the de minimis exception applies to infringement of sound recordings.

Ninth Circuit (Alaska, Arizona, California, Idaho, Montana, Nevada, Oregon, Washington, Guam, Hawaii)

In the Ninth Circuit, the de minimis exception applies to infringement actions concerning sound recordings.

In *VMG Salsoul*, the owner of copyrights to the composition and sound recording of ''Ooh I Love It (Love Break)'' brought a copyright infringement action against famed singer Madonna and others, alleging they had violated his copyrights by sampling a ''horn hit''—a 0.23-second segment of horns—from his song and used it throughout Madonna's song ''Vogue,'' while many other instruments were playing at the same time.

The district court granted summary judgment in favor of Madonna on two grounds: (1) neither the composition nor the sound recording of the horn hit was ''original'' for purposes of copyright law; and (2) even if the horn hit was original, any sampling of the horn hit was ''de minimis or trivial.''

On appeal, plaintiff argued that even if the copying was trivial, that fact was irrelevant because the de minimis exception does not apply to infringements of copyrighted sound recordings.

The Ninth Circuit rejected that argument, calling Sixth Circuit's reading of 17 U.S.C. § 114(b) in *Bridgeport* ''illogic[al],'' and holding that ''the 'de minimis' exception applies to actions alleging infringement of a copyright to sound recordings.''

Prior to the Ninth Circuit's holding in *VMG Salsoul*, the Ninth Circuit had stated in dicta in *Newton v. Dia-*

mond that the de minimis exception ''applies throughout the law of copyright, including cases of music sampling.''

Tenth Circuit (Colorado, Kansas, New Mexico, Oklahoma, Utah, Wyoming)

The Tenth Circuit has yet to address whether the de minimis exception applies to infringement of sound recordings.

Eleventh Circuit (Alabama, Florida, Georgia)

Although the Eleventh Circuit has yet to directly address whether the de minimis exception applies to infringement of sound recordings, one district court in the Eleventh Circuit has held that the de minimis exception applies to all infringement actions, expressly declining to follow the Sixth Circuit's holding in *Bridgeport*.

In *Saregama India Ltd. v. Mosley*, 687 F. Supp. 2d 1325, 1339 (S.D. Fla. 2009), aff'd, 635 F.3d 1284 (11th Cir. 2011), the plaintiff sued defendants for digitally sampling a portion of its Indian song, ''Baghor Mein Bahar Hai,'' in defendants' hip-hop song, ''Put You on the Game.''

Moving for summary judgment, the plaintiff claimed that because defendants admitted that they copied a snippet of the sound recording, they were liable as a matter of law. The defendants claimed that the use was de minimis and therefore not actionable.

Relying on the Sixth Circuit's *Bridgeport* decision, plaintiff argued that sound recordings must be treated differently from other forms of copyrighted works in that any sampling constitutes infringement, no matter how small the sample.

The court rejected this reasoning, writing that the ''Eleventh Circuit imposes a 'substantial similarity' requirement as a constituent element of all infringement claims.''

The court also wrote that it was not persuaded that the Eleventh Circuit might follow the reasoning of the Sixth Circuit in *Bridgeport* in the future, as ''Section 114(b) does not seem to support the distinction between sound recordings and all other forms of copyrightable work that the Bridgeport court imposes.''

The court granted defendant's motion for summary judgment after finding that no reasonable jury could find that the two songs were similar.

Conclusion

In *VMG Salsoul*, the Ninth Circuit acknowledged the ''deep split'' among federal courts, but stated that ''almost every district court not bound by that decision has declined to apply *Bridgeport*'s [''bright line''] rule.''

Although this is true, because a split still exists, and many courts have yet to address the issue, musicians must be wary of the laws of their states (or lack thereof) when sampling sound recordings.

Even where the de minimis exception to infringement applies, whether a use is de minimis is not a cut-and-dry analysis. Many artists may err on the side of getting a license whenever possible.

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