

4-1-1989

# Digital Sampling and Signature Sound: Protection Under Copyright and Non-Copyright Law

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Thomas Arn, *Digital Sampling and Signature Sound: Protection Under Copyright and Non-Copyright Law*, 6 U. Miami Ent. & Sports L. Rev. 61 (1989)

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## COMMENTS

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Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright unless there is a restriction in the words of the act.

Oliver Wendell Holmes<sup>1</sup>

#### I. INTRODUCTION

Popular musicians frequently are recognized by the distinctive characteristics of their sound. The unique timbre of a voice or an instrument often immediately suggests a performer's identity.<sup>2</sup> In-

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1. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1902).

2. Musical sound best can be understood as being comprised of four factors: Pitch (note), duration (length), volume (loudness), and timbre (distinctive tonal qualities). See generally G. JONES, *MUSIC THEORY* 3 (1974). To illustrate, a note played on an acoustic violin has a different timbre than that played on an electric violin. Even though the sound played by the violins may be identical in other regards—specifically, note, duration, and loudness—the electric violin's sound is smooth, while, in contrast, that of its acoustic counterpart has a rough texture.

deed, most have experienced an occasion where they were able to identify the performer of a new recording the first time they heard it played. Traditionally, copyright law has not protected these distinctive musical sounds of musicians, opting instead to protect only the underlying musical compositions and, to a more limited extent, recordings of those compositions.<sup>3</sup> Recently, a technology, which allows others to use a musician's sounds, has mandated reexamination of the law's traditional approach to protecting a musician's distinctive sound. This technology, commonly known as digital sampling, is best defined as a technology which "allows any sound to be recorded, recreated, and manipulated by computer."<sup>4</sup> Once borrowed, the sample is played frequently over the musical range of a keyboard and ultimately used in new musical compositions.

The use of digital sampling to create new musical works presents difficult intellectual property questions and necessitates an analysis of the existing statutory and non-statutory protection available to performers with distinct musical sounds. Part II of this Comment examines the ability, *vel non*, of the Copyright Act of 1976 to provide musicians with protection for their sounds. Although the use of another's unique sounds, sometimes called "signature" sounds,<sup>5</sup> might strike some as an inequitable practice, Part II concludes that the current Copyright Act is insufficient to protect performers from the unauthorized use of their sounds. Part III then assesses the potential for the common law remedy of unfair competition to protect a musician's sounds from the sampler. This Comment ultimately suggests that musicians seeking protection from sampling potentially may find refuge in the broader shadow of unfair competition.

## II. COPYRIGHT LAW AND PROTECTION FROM SAMPLING: A STATUTORY MISMATCH

Over the years, copyright law has been inextricably linked to technological innovation. The scientific advancements of the nine-

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3. See, e.g., 17 U.S.C. § 106 (1982) (granting copyright owners of musical compositions the rights to reproduce, prepare derivative works from, distribute copies, publicly perform, and publicly display their copyrighted works); 17 U.S.C. § 114 (1982) (limiting the rights of a copyright owner in a sound recording to the right to reproduce the copyrighted work in copies or phonorecords; to prepare derivative works based upon the work; and to distribute copies or phonorecords of the work to the public). For a discussion of the rationale behind this limited protection of sound recordings, see *infra* note 41 and accompanying text.

4. Pareles, *Digital Technology Changing Music*, N.Y. Times, Oct. 18, 1986, at C23, col. 4. The process of digital sampling has been likened to the cloning of a new musical work. *Id.*

5. Dupler, *Digital Sampling: Is It Theft?*, BILLBOARD, Aug. 2, 1986, at 1.

teenth and early twentieth centuries challenged the ability of copyright law to protect the rights of the individual in original works of authorship and inspired extensive judicial and statutory modifications of the law.<sup>6</sup> Most recently, the copyright regime has been confronted with sophisticated methods of reproducing copyrighted works, sometimes called "second order" technologies.<sup>7</sup>

"Second order" technologies have brought more than difficulty in applying current copyright law; in addition, they carry the potential to change fundamentally the way in which the law approaches intellectual property issues. For example, a commentator once prophesied that future scientific advances themselves eventually would become part of the creative process which copyright law seeks to protect.<sup>8</sup> Today, this prediction appears to be on the verge of realization. While computers are not used to independently "create" works of authorship,<sup>9</sup> they are used increasingly by musicians in the creation of musical works.<sup>10</sup> However, the thought of symbiosis between man and machine in an endeavor to create or author seems incompatible with the conventional copyright concept of originality; in fact, this concept traditionally has considered creations which are entirely the product of a mechanical process to be insufficiently original to merit protection.<sup>11</sup> The concepts of originality and authorship protect works whose origin lies in the mind of their creator.<sup>12</sup> Mere mechanical reproduction of another's work does not satisfy the originality requirement, no matter how

6. Note, *Toward A Unified Theory of Copyright Infringement For An Advanced Technological Era*, 96 HARV. L. REV. 450, 450-51 (1982).

7. "Second order" technologies include photocopying, audio and video tape recording, and computer-based information storage and retrieval systems. For a discussion of the impact of such technologies on copyright law, see generally Note, *supra* note 6.

8. B. KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 117-18 (1967).

9. Computer generated works are not creative in the technical copyright sense. See *infra* text accompanying notes 11-13.

10. See Holden, *Technology Steals the Thunder*, N.Y. Times, March 29, 1987 at 22 (claiming that a small number of musicians, such as Stevie Wonder and Laurie Anderson, have used digital sampling to make music which transcends formulaic uses of the technology).

11. See, e.g., *Durham Indus. v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980) (holding that copyright originality requires a work to be the product of artistic skill rather than manufacturing skill); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884) (holding that plaintiff's photograph of Oscar Wilde was sufficiently original through the photographer's use of lighting and setting to merit protection; but, noting that an ordinary photograph, which merely mechanically captures a scene with no other contribution by the photographer, would not be original in a copyright sense).

12. For Justice Holmes, the slightest emanation of personality merited protection. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1902). There is, however, a de minimis threshold for satisfying the authorship requirement. See B. KAPLAN, *supra* note 8, at 45-48. See also *supra* notes 10-11 and accompanying text.

novel the reproducing process.<sup>13</sup> For example, an exact copy of a classic painting may exhibit tremendous technical skill on the part of the reproducing artist yet may not be original or creative in the eyes of the copyright law since the completed work does not owe its inspiration to an artist.<sup>14</sup> Nonetheless, new technology, including digital sampling, has the potential to function as a catalyst in the creation of copyrightable work.

### A. *Digital Sampling: The Process*

Digital sampling makes it possible to record a voice or an instrument, either live or from a previous recording, and to manipulate it with a computer so that it can be played back at any pitch over the range of a keyboard.<sup>15</sup> The technology allows a recording artist to put the sound of any other artist into a song which the latter may never have played, sung, or even heard. Hence, it is now possible to hear the voice of Enrico Caruso singing a song written years after his death or even to hear Jimi Hendrix's guitar backing up a group with which he never recorded.<sup>16</sup>

Digital sampling devices take conventional analog sound waves, as captured on an analog source—for example, a tape recording—and convert them, through a device called an analog/digital converter (ADC), into numbers (digits) on a scale which then can be stored on a disc and read by a computer.<sup>17</sup> Subsequently,

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13. Novel means of reproduction are themselves, of course, protected under patent law.

14. 1 M. NIMMER, *NIMMER ON COPYRIGHT*, § 2.01[A] (1989).

15. See Pareles, *supra* note 4. See also Dupler, *supra* note 5, at 1; DeCurtis, *Who Owns A Sound?*, *ROLLING STONE*, Dec. 4, 1986, at 13.

16. Placing the sounds of other instruments under the control of a keyboard is not, however, an idea of recent origin. Medieval church organs with their trumpet and bassoon stops were the first attempts at such musical versatility. Aikin, *Digital Sampling Keyboards*, *KEYBOARD*, Dec. 1985, at 32. Later, the cinema organs of the 1920's were used to create various sound effects. *Id.* These and other attempts to put the sounds of other instruments at the fingertips of the keyboardist all suffered from mechanical limitations. Digital sampling, in contrast, offers unparalleled flexibility in the sounds available to today's musician.

17. Natural or acoustic sound waves are created by fluctuations in air pressure. Through the use of a microphone sound waves can be reduced to analogous fluctuations in electrical voltage—hence, the term “analog sound.” Both sound waves and fluctuating voltage are smooth and continuous in nature. When an analog sound source is digitalized, however, the amount of voltage is represented by numbers at discrete intervals along the wavelength. Therefore, a gap exists between any two digits on a digital recording which would not exist on a smooth and continuous analog source. Hence, a digitalized recording is not an exact duplicate of the underlying analog recording but merely a sample of the sounds represented along the fluctuating voltage waves—hence the term “sampling.” The gap, or amount of time, between samples along the wavelength is known as the sampling interval, while the

the numbers can be manipulated by the computer through the use of a keyboard and ultimately reconverted back to analog sound by a digital/analog converter (DAC).

The digital sample itself is a short recording of a sound, varying from less than a second to one half of a minute in length, which forms the basis of the sound the computer manipulates.<sup>18</sup> Conceptually, sampling can be understood as the breaking down of sound into its component parts and digitalizing each element, thus enabling a computer to separately analyze, reproduce, and manipulate that sound. Once an analog sound has been digitally stored in a computer, the computer can, through the use of a keyboard, alter the pitch of the sample while preserving the underlying tonal qualities. This process creates a "synthetic instrument" capable of placing the sample's tonal qualities in an infinite variety of new musical contexts.<sup>19</sup>

In light of the foregoing description, sounds produced from digital samples are entirely different than those traditionally produced by synthesizers. Musicians who work with conventional synthesizers create their own sound from scratch, and, consequently, their product will be unique and unlike any sound found outside the studio.<sup>20</sup> The sounds produced through digital sampling, however, are dependent largely upon the underlying recording since sampling apparently is unable to manipulate the timbre of sampled sounds.<sup>21</sup> Therefore, the sound a sampling musician will produce is determined by the underlying sound.<sup>22</sup> This phenomena re-

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converse, the frequency with which samples are represented along the wave length, is known as the sampling rate. For a discussion of digital sampling technology see C. DODGE & T. JERSE, *COMPUTER MUSIC: SYNTHESIS COMPOSITION AND PERFORMANCE* 25-31 (1985); Aikin, *supra* note 16.

18. Pareles, *supra* note 4.

19. C. DODGE & T. JERSE, *supra* note 17, at 63. One observer has pointed out that "[t]hanks to [digital sampling] you can now take any sound—a falling tree, somebody's complete guitar strum on a CD—and make a virtual instrument out of it, reproducing that sound at any pitch, in any combination, any tempo, on a standard electronic key board." S. BRAND, *THE MEDIA LAB* 202-03 (1987).

20. Synthesizers produce mathematically pure sound waves through oscillators. In contrast, natural sound waves have imperfections which give them a rough quality. This, in part, explains the appeal of sampling since many musicians prefer a more realistic sound than that produced by synthesizers. Aikin, *supra* note 16.

21. *See id.* Even if samplers could manipulate a sound's tonal qualities, it is sampling's ability to capture the underlying analog sound's timbre that has made the technology so popular.

22. Apart from its previously mentioned ability to change a sound's pitch over the range of the keyboard, sampling also can shorten or lengthen a sound, play it backwards, and even eliminate some undesired noises such as tape hiss and record scratches. However, these changes are relatively minor, especially when compared with the creative possibilities

sults because computers are not yet capable of the same level of sophistication as the human ear and, consequently, the computer alone cannot distinguish between the timbre of differing sounds.<sup>23</sup> In other words, since computers are not yet capable of generating the subtle differences in sound which provide the foundation for the variety of distinct sounds audible to the ear, the sounds which digital sampling allows a musician to produce are tied to, and dependent upon, the intricacies of sound captured on the underlying analog recording.<sup>24</sup>

### B. Widespread Sampling: A Conundrum for the Law

The use of sampling raises difficult intellectual property issues, especially for performers with signature sounds, the most typical sources for samples.<sup>25</sup> One highly publicized use of sampling, poignantly illustrating the potential impact of the technology, is evidenced in the musical theme for the popular television show "Miami Vice." The show's theme, composed and produced by Jan Hammer, features the sound of percussionist David Earl Johnson.<sup>26</sup> Johnson has never played the "Miami Vice" theme; instead, Johnson allowed Hammer to sample his playing of some unique, eighty year-old African congas.<sup>27</sup> Johnson's distinctive sound is clearly recognizable in Hammer's recording; Johnson, however, has received no recognition or compensation for the "Miami Vice" music.<sup>28</sup>

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synthesizers provide. The parameters of the tonal qualities a sampling device can produce essentially are limited by the sample itself. Aikin, *supra* note 16.

23. For example, when listening to a musical group's performance of a song, the ear can distinguish between the notes played by an instrument. It also can distinguish with relative ease the timbre of the guitar from that of the piano. Computers, while able to distinguish differing notes, are not sophisticated enough to distinguish the fine differences in sound waves which register in the ear as particular instruments. Aikin, *supra* note 16.

24. This is not to suggest that sampling reproduces the exact sonic sound pattern of the underlying recording. Most sampling devices are incapable of such precision. See Dupler, *supra* note 5. See also *supra* note 17 and accompanying text (discussing the differences between analog and sampled sounds). Nevertheless, although there is a range of potential manipulation, the sound that goes in is usually the sound that comes out.

25. See Dupler, *supra* note 5. For another discussion of the legal issues raised by digital sampling technology see Note, *Protecting Distinctive Sounds: The Challenge of Digital Sampling*, 2 J. L. & TECH. 273 (1987).

26. See Pareles, *supra* note 4.

27. *Id.*

28. Johnson hired an attorney to negotiate with the musician's union for the establishment of a payment standard for use of sampled performances on recordings. DeCurtis, *supra* note 15. The Union, however, declined to take up the matter, primarily because Johnson voluntarily laid down the track for Hammer. Telephone interview with William Krasilovsky, attorney representing David Earl Johnson, (October 12, 1987). Other popular

The "Miami Vice" dispute was only the beginning. Over the last few years, several disputes concerning the ethics and legality of sampling have arisen. In 1987, Island Records sued Next Plateau Records alleging copyright infringement for, *inter alia*, digitally sampling some language off of an Island recording artist's record and then using the sample on an album released by Next Plateau.<sup>29</sup> Suits for copyright infringement also have been filed against the rap music group the Beastie Boys for their alleged sampling of drum beats of the 1977 hit titled "The Return of Leroy (Part I)" and the words "Yo, Leroy!" for use on their "Licenced to Ill" album.<sup>30</sup>

These cases have heightened the debate over sampling. Artists using sampled material, as well as authors whose materials are being sampled, continue to struggle in an effort to determine who owns a sound. The problem is not likely to disappear anytime soon.<sup>31</sup>

Sampling technology offers musicians unparalleled flexibility in producing music. Rather than having to learn to play various instruments themselves or having to pay session musicians for their time, today's electronic musicians have access to a symphony of sound on a single computer disc. Additionally, sampling is relatively easy. All a musician need do is to record into the sampling device an appealing isolated sound off of an analog source and then to reproduce that sound on his own recording.<sup>32</sup> Furthermore,

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musicians also have been sampled. For example, samplers have taken the voice of Chris Squire and the drums of Alan White, both of the progressive rock group "Yes," as well as Phil Collins' distinctive drum sounds. Pareles, *supra* note 4.

29. *Island Records, Inc. v. Next Plateau Records, Inc.*, No. 87 Civ. 8165 (S.D.N.Y. filed Nov. 17, 1985) cited in Goldberg & Bernstein, *Music Copyright and the New Technologies*, 7 ENT. & SPORTS LAW. 3, n.5 (Summer/Fall 1988). The case settled as Next Plateau agreed to stop distribution of the record and to recall those already distributed. See Goldberg & Bernstein, *supra*, at 6 n.5.

30. *Castor v. Rubin*, No. 87 Civ. 6159 (S.D.N.Y. filed in 1987) cited in Soocher, *License to Sample*, Nat'l L. J., Feb. 13, 1989, at 26. The Beastie Boys are the subject of a second suit involving sampling, which, in addition to claims of copyright infringement, alleges a violation of § 43 (a) of the Lanham Act, Pub. L. No. 79-489, tit. VIII, 60 Stat. 427, 441 (1946) (codified as amended at 15 U.S.C. § 1125(a) (1982)), for false designation of origin and false description. *Thomas v. Diamond*, No. 87 Civ. 7048 (S.D.N.Y. filed in 1987) cited in Soocher, *supra* at 26.

31. Ad hoc solutions have included attempts to obtain consent to use the sound for free or for a fee. See Soocher, *supra* note 30, at 26. Early attempts by a New York Musician's Union to devise a payment scheme for sampling were not successful. DeCurtis, *supra* note 15, at 13. Given the intensity of acoustic musicians' claims that sampling is little better than theft, as well as the irresistible ease and flexibility sampling offers, compromise appears a remote possibility.

32. Alvaro, *What is Musical Property? The Ethics of Sampling*, Keyboard, Oct. 1986, at 10. This is perhaps a slight oversimplification. Some instruments sound very different in



steady decreases in the price of sampling equipment has made sampling affordable to an increasing number of musicians.<sup>33</sup> As a result, and not surprisingly, the popularity of samples, particularly samples of artists with distinctive sounds, has skyrocketed.<sup>34</sup>

The ease with which musicians may use sampling does not, however, imply a lack of creativity in producing music which includes the use of sampling. While several widely publicized disputes involving digital sampling suggest mere gimmickry,<sup>35</sup> sampling enables artists who adapt to the technology an unparalleled musical flexibility because of a resulting wide selection of sound. For the first time in music history, artists have an unlimited "aural palette" at their fingertips.<sup>36</sup>

Many artists rightfully are concerned by the increasing use of sampling. Developing a distinctive musical sound can take a musician years of dedicated practice; more importantly, professional reputations often are built on the distinctiveness of one's sound.<sup>37</sup>

different registers; moreover, one sample may not be enough to play over a five octave range. Therefore, the dedicated sampling musician often must take more than one sample of a sound and match them to the appropriate ranges of the keyboard. Aikin, *supra* note 16.

33. Dupler, *supra* note 5, at 74.

34. Demand for samples is so high that a "black market" for samples of popular musicians has emerged in recording studios. *Id.*

35. See, e.g., *supra* notes 29-30 and accompanying text. It is not difficult to understand why the very limited use of sampled materials in these instances has not inspired praise for the creative value of sampling. Though such minor use may not strike the mature listener as particularly artistic, legal commentators would nevertheless do well to remember Justice Holmes' famous caveat: "[i]t would be a dangerous undertaking for persons trained to the law to constitute themselves judges of the worth of pictorial illustrations outside the narrowest and most obvious limits." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1902).

36. Holden, *supra* note 10. The diversity of sound offered by sampling offers to make the technology a staple of the music industry of the 90's. See Bernstein, *Sampling Challenges Copyright Theories*, BILLBOARD, Dec. 19, 1987, at 77. While some uses of sampling appear trivial in artistic value, original creative opportunities are not foreclosed. See Vandeknyff, *Team Uses Synthesizer for Video*, L.A. Times, Aug. 23, 1986, at 23, col. 1 (recounting the efforts of two California electronic musicians whose use of a library of digital sampling discs allowed inexpensive experimentation with sounds, thereby facilitating composition); Spurrier, *Ancient Rock Paintings and New Age Music*, L.A. Times, Feb 28, 1988, at 5 (describing New Age musician Steve Roach's use of digitally sampled natural sounds of Australia's Cape York Peninsula to evoke images of aboriginal mysticism and culture in a musical sound work). In a broader sense, digital sampling may serve to express the pervasive ambiguity of the relationship between modern man and machine, underscoring Marshall McLuan's famous statement that, "the message is the medium." See Holden, *supra* note 10. In fact, at least one modern music group has made digital sampling the mainstay of its sound. See Pareles, *Rock: The Art of Noise*, N.Y. Times, July 14, 1986 at C15, col. 1 (noting that the group The Art of Noise, instead of merely using sampling as a novelty, consistently has placed sampling in the forefront of their music).

37. For a discussion of the significance of distinctiveness of sound in music and the impact of sampling, see Alvaro *supra* note 32. See also *Lahr v. Adell Chemical Co.*, 300 F.2d

Unfortunately, digital sampling places that sound at the fingertips of even the most inexperienced musician.

### C. *The Limits of the Statutory Scheme*

A copyright owner's interest in a sound recording theoretically embodies three distinct sets of rights: Reproduction rights, including rights to produce derivative works; performance rights, including the right to control the broadcast of recordings over the radio; and rights to preclude imitation of a recording by others.<sup>38</sup> Under current copyright law, protection is extended to all "original works of authorship fixed in any tangible medium of expression, now known or later developed from which they can be perceived or otherwise communicated, either directly or with a machine or device."<sup>39</sup> The Copyright Act of 1976 specifically includes sound recordings as protected works.<sup>40</sup> However, due to the derivative nature of sound recordings,<sup>41</sup> the Copyright Act extends less protection to recorded sound than it does to other forms of authorship.

Section 114 of the Copyright Act denies copyright owners any performance rights in a sound recording.<sup>42</sup> Hence, while the copyright owner of a musical composition has exclusive performance rights for that composition, a musician recording that musical composition has no control over the performance of the sound recording and receives no compensation beyond the original fee for the recording.<sup>43</sup> Section 114 does protect a copyright owner's right

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256 (1962) (noting that well-known comic Bert Lahr's success was predicated mainly on the uniqueness of his voice and speech pattern).

38. R. BROWN & R. DENICOLA, *COPYRIGHT, UNFAIR COMPETITION, AND OTHER TOPICS BEARING ON THE PROTECTION OF LITERARY, MUSICAL, AND ARTISTIC WORKS* 512 (4th Ed. 1985) (noting that the first right currently is recognized, the second right is under study, and the third right is of questionable validity).

39. 17 U.S.C. § 102 (1982).

40. See 17 U.S.C. § 114 (1982).

41. See 2 M. NIMMER, *NIMMER ON COPYRIGHT*, § 8.10[A] (1989) (suggesting that sound recordings are themselves copies of the underlying musical composition).

42. 17 U.S.C. § 114 (1982). The law historically has denied recording artists performance rights despite the courts' usually recognizing that a performer's contribution to a sound recording is sufficient to meet the authorship and originality requirements of copyright protection. See, e.g., *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 664 (2d Cir. 1955) (Hand, J., dissenting) (stating that "[t]he performer has a wide choice, depending upon his gifts, and this makes [his performance] quite as original a 'composition' as an 'arrangement' or 'adaptation' of the score itself . . .").

43. 1 M. NIMMER, *supra* note 14, at § 2.10[A]. For a discussion of the economic significance of a performance right to a recording artist see *Performance Rights In Sound Recordings*, 43 Fed. Reg. 12,763, 12,765 (1978) (statement of Barbara Ringer, Register of Copyrights) (concluding that the free airplay of performers' records does not increase record sales

to control the reproduction of the recording and the development of derivative works based on it. However, the right to control reproduction of sound recordings is truncated vis-a-vis other works of authorship.<sup>44</sup> In fact, the Act specifically excludes any right to control the production of imitative recordings:

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 recordings are rearranged, remixed, or otherwise altered in sequence or quality. The exclusive rights of the owner of a copyright in a sound recording under clauses (1) and (2) of section 106 do not extend to the making or the 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.<sup>45</sup>

No matter how similar in sound a recording may be to another, if the imitative recording is an independent fixation of sounds, no infringement has occurred. Congress' exclusion from the Act of any protection against independent imitation implies that a signature sound or style per se is not protected by copyright law.<sup>46</sup> Instead, the copyright owner is protected only against actual

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significantly enough to offset the royalties lost as a result of non-recognition of performance rights).

44. For example, owners of copyrights in literary works are given exclusive rights to produce derivative works. These rights include protection from other literary works which have a comprehensive, non-literal similarity or, alternatively put, those works which imitate the copyrighted work without duplicating the actual wording. 3 M. NIMMER, NIMMER ON COPYRIGHT, § 13.03[A] (1989). Currently, copyright law fails to extend such protection to sound recordings.

45. 17 U.S.C. § 114(b) (1982). Section 114(d) commands the Register of Copyrights, after meeting with representatives of the recording, entertainment, and other pertinent industries, to submit to Congress by January 3, 1978 further recommendations regarding performance rights in copyrighted sound recordings. The Report of the Register of Performance Rights in Sound Recordings was submitted to Congress on the required date. Performance Rights In Sound Recordings, 43 Fed. Reg. 12,763, 12,764 (1978) (statement of Barbara Ringer, Register of Copyrights). However, Congress has yet to recognize such rights.

Prior to the 1976 Act, a long line of federal and state cases held that mere imitation of a performer's sound as embodied in a recording was not an infringement of any of a performer's property rights. *See, e.g.,* Sinatra v. Goodyear Tire and Rubber Co., 435 F.2d 711 (9th Cir. 1970), cert. denied, 402 U.S. 906 (1971); Booth v. Colgate-Palmolive, Inc., 362 F. Supp. 343 (S.D.N.Y. 1973); Davis v. T.W.A., 297 F. Supp 1145 (C.D. Cal. 1969); Shaw v. Time-Life Records, 38 N.Y.2d 201, 341 N.E.2d 817, 379 N.Y.S.2d 390 (1975). The current Act appears to codify the old rule. *See* 17 U.S.C. § 114 (1982).

46. The lack of protection against imitators has spawned an industry devoted to sound-alike versions of popular recordings. *See, e.g.,* Fantastik Fakes, Inc. v. Pickwick Int'l, Inc., 661 F.2d 479 (5th Cir. Unit B Nov. 1981).

rerecording.<sup>47</sup> Therefore, recording artists have no exclusive rights to any stylistic aspect of the sound fixed in a recording and only have the right to preclude the rerecording of the actual sounds contained on a recording.

In light of the foregoing, the determination of whether sampling is better identified as imitation or rerecording is relevant to deciding whether the Act may be interpreted to preclude digital sampling. If sampling more closely resembles the former, then section 114 is inapplicable by its own terms and sampling would not constitute an infringement upon a copyright. In contrast, characterizing a sample as a rerecording could render sampling an infringement of the artist's recording.<sup>48</sup> An analysis of the purposes behind the protection extended to sound recordings under copyright law demonstrates how ill-suited the existing Act is for resolving the sampling issue.

### 1. Imitation Versus Rerecording

At first blush, the question of whether sampling falls within the Act's rerecording protection appears to be a simple one. After all, sampling, like rerecording, involves little more than the use of machines. Under the traditional view<sup>49</sup> of copyright authorship, creativity is something independent of a mechanized process. If digital sampling is described merely as the feeding of information into a device which results in the ability to play it back at the

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47. "The exclusive right of the owner of copyright in a sound recording . . . is limited to the right to duplicate the sound recording in the form of phonorecords . . . that directly or indirectly recapture the actual sounds . . ." 17 U.S.C. § 114(b)(1982).

48. Even if sampling did constitute rerecording, the work resulting from the sampling must be substantially similar in order to infringe another person's copyright. See *infra* notes 64-81 and accompanying text. Questions of whether sampling generally constitutes a rerecording of underlying sound recording under the Act, and whether any particular sampling use is substantially similar to an underlying sound recording, are distinct and separate inquiries; the latter inquiry becomes relevant only upon a determination that sampling generally comes within the requirement of actual sound recapture embodied in section 114. The legal literature on digital sampling is not lacking in claims that sampling is more akin to rerecording. See, e.g., Note, *Digital Sound Sampling, Copyright and Publicity: Protecting Against the Electronic Appropriations of Sounds*, 87 COLUM. L. REV. 1723, 1732-33 (1987) (arguing that sampling resembles rerecording or "dubbing" since it constitutes changing the sequences of and the playing back of another recording's notes, altered by changes in frequency); Comment, *Digital Sampling: Old Fashioned Piracy Dressed Up in a Sleek New Technology*, 8 LOY. ENT. L.J. 297, 311 (1988) (arguing that digital sampling lends credence to the claim that "[t]he ingenuity of the thief increases with technology."). However, the authors of these notes fail to address the creative implications of sampling. See, e.g., Note, *supra*, at 1726 (referring to the sampling musician as a "technician" who "exploits" the sounds of acoustic musicians, who thereby become "victims of technological advance.").

49. See *supra* notes 11-13 and accompanying text.

touch of a key, then sampling resembles the unoriginal and infringing act of music piracy.<sup>50</sup> This view, however, overlooks the technology's creative potential and stretches the application of the terms "recapture" of "actual sounds" under the Act.

The distinction in section 114 between imitative recordings and rerecording reflects a supposition that the originality of a recording artist, captured in a sound recording, is something which merits copyright protection.<sup>51</sup> Independent imitative recording, however, does not infringe on the artist's creative contribution to a recording since the mimicry is based upon personal, artistic skills of imitation and may itself demonstrate a level of originality which meets copyright standards.<sup>52</sup>

Originality in copyright does not require absolute novelty;<sup>53</sup> instead, originality requires nothing more than independent, creative efforts by an author.<sup>54</sup> Such independent efforts do not, however, establish originality where the efforts merely reflect technical skill at producing works which are not significantly different from those of another.<sup>55</sup> Consequently, it is clear that digital sampling more closely resembles imitation than it does duplication. Sampled sounds are noticeably different from the original sound. A sampled sound, if similar to the original, is manipulated in a way which changes it from the original, thereby making the use of the sample something other than reproduction of the original recording. In effect, sampling not only adds and subtracts sounds from the underlying recording but also changes the components of the original

50. See, e.g., *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir. 1976), cert. denied, 429 U.S. 857 (1976) (holding copyright originality requires more than a trivial variation, such as might occur when translating a work from one medium into another); *Durham v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980) (skill used in manufacturing plastic wind-up toy figures of Walt Disney characters held not sufficiently original). Record piracy refers to the unauthorized duplication of musical works by literal rerecording. Prior to the enactment of statutory protection in the early 1970's, record piracy was an unchecked, multi-million dollar, black market industry. See Note, *Sound Recording Act of 1971: An End to Piracy on the High C's*, 40 GEO. WASH. L. REV. 964, 964-65, n.8 (1972). See also *infra* notes 57-61 and accompanying text (discussing how the sound recording provisions of the Copyright Act were the product of a Congressional response to the rampant record piracy that was occurring at the time of their enactment).

51. This is at least true with respect to the rights to reproduce and to create derivative works, especially since duplicitous works add no creative value to the original.

52. See, e.g., *Booth v. Colgate-Palmolive, Inc.*, 362 F. Supp 343 (S.D.N.Y. 1973) (noting that a monopoly on voice and style of speaking actually may impede progress in the arts); Comment, *The Twilight Zone: Meandering in the Area of Performer's Rights*, 9 UCLA L. REV. 819, 821 (1962).

53. 1 M. NIMMER, *supra* note 14, at § 2.01[A].

54. *Id.*

55. *Id.*

sound, albeit in a limited way. Realizing that a musician using sampling typically will mold the sound to fit his tastes by altering the pitch, the filtering, as well as other attributes, it is clear that the sampling musician has made a contribution of originality which distinguishes the sampled sound from the underlying sound.<sup>56</sup> Nevertheless, an examination of the circumstances surrounding the legislative intent of Congress in enacting the Act is necessary when assessing whether the scope of section 114 is broad enough to proscribe sampling.

Congress enacted the sound recording provisions of the 1976 Copyright Act to protect performers and the record industry from the deleterious effects of record piracy.<sup>57</sup> Congress granted the producers of recordings the exclusive, but narrow, right to make literal reproductions of their recordings. Primarily, the legislation sought to protect the commercial and artistic loss resulting from black market sales of actual duplicates of another's recordings.<sup>58</sup> Such rerecording did not contain one iota of creative input beyond that contained in the original. However, mimicry, unlike piracy, contains elements of originality and creativity, and, consequently, Congress expressly sought to preserve this form of artistry. By not proscribing imitation, Congress expressly limited copyrights to sound recordings. Given Congress' concern over piracy, and in light of its adopting the "recapture" of "actual sounds" as its touchstone, it is obvious that Congress was referring to the most banal of duplications such as pirating.

This interpretation is supported by the legislative history of section 114, which indicates that the technical producer of a sound

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56. The Copyright Act of 1976 specifically provides that producers of sound recordings can be considered co-authors of the work through editing and electronically processing the sounds. 17 U.S.C. § 114 (1982). Nevertheless, at least one commentator has argued that section 114 of the Act should be read broadly to afford owners of copyrighted sound recordings protection from digital sampling. See Note, *supra* note 48, at 1733-34.

57. Section 114 of the current Act has its genesis in the Sound Recording Act of 1971, Pub. L. No. 92-140, 85 Stat. 391 (1971). See H.R. REP. NO. 1476, 94th Cong., 2d Sess. 55, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659 [hereinafter H.R. REP. NO. 1476].

58. The legislative history of the 1971 legislation evidences Congress' concern about the record companies' and the artists' annual loss of millions of dollars because of the sale of pirated records and tapes. H.R. REP. NO. 487, 92d Cong., 1st Sess. reprinted in 1971 U.S. CODE CONG. & ADMIN. NEWS 1566, 1567 [hereinafter H.R. REP. NO. 487]. "[The 1971 amendment to the Copyright Act] . . . provide[s] for the creation of a limited copyright in sound recordings for the purpose of protecting against unauthorized duplication and piracy of sound recording . . ." *Id.* at 1566. In enacting the 1971 legislation, Congress made clear that artistic originality, threatened economically by piracy, was the value it sought to protect. See *id.* at 1569-70 (noting that only recordings which express copyright originality merit protection).

recording—the individual who compiles, edits, and processes the sounds—may himself be an author of a copyrightable element of the recording.<sup>59</sup> As such, it is arguable that electronic manipulation now can rise to the level of creativity.<sup>60</sup> Additionally, the Act defines infringement of protected recorded sounds as the duplication of all, or a substantial portion of, a recording,<sup>61</sup> further demonstrating a Congressional intent to limit protection to the piracy context, where whole works were being stolen. Interpreting the statute to proscribe digital sampling would produce results contrary to Congress' intent.

Digital sampling clearly differs from pirating in that it offers creative flexibility to artists. Analogizing the technology to pirating fails to appreciate the creative tool sampling already has become.<sup>62</sup> Characterizing sampling as a rerecording is akin to claiming a photograph is merely a literal duplication of the object photographed.<sup>63</sup> However, the photographer and the sampler both demonstrate personality in their finished product; the photographer arranges physical subjects and exposure while the sampling artist arranges sound qualities. Simply put, the process of sampling is substantially different from mere rerecording. The process offers the modern musician a valuable tool for artistic expression and, accordingly, sampling is not proscribed under the Copyright Act.

59. H.R. REP. NO. 1476, *supra* note 57, at 5669.

60. *Id.* However, there may "be cases where the record producer's contribution is so minimal that the performance is the only copyrightable element in the work, and there may be cases . . . where only the record producer's contribution is copyrightable." *Id.*

61. "Subsection (b) of section 114 makes clear that statutory protection for sound recordings extends only to the particular sounds of which the recording consists . . . . Thus, infringement takes place whenever *all or any substantial portion* of the actual sounds that go to make up a copyrighted sound recording are reproduced in phonorecords repressing, transcribing, recapturing off the air, or any other method . . ." *Id.* at 5721 (emphasis added).

62. See *supra* notes 35-36 and accompanying text (noting the potential for creativity inherent in sampling).

63. In *Burrows-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884), the Court held that "[t]he Constitution is broad enough to cover an act authorizing copyrights of photographs, so far as they are representatives of original intellectual conceptions of the author." The petitioners in *Burrows-Giles* contended that the photograph in question involved no authorship since it was merely the result of chemical and mechanical processes. *Id.* at 59. The Court rejected the argument, noting that the photograph was an original work of art, the type intended to be protected by Congress in the Constitution. *Id.* at 60. However, the Court clarified that it was not deciding whether a photograph, which was the mere result of mechanical reproduction of the physical features or outlines of some object, and which did not involve any originality, thought, or novelty, was copyrightable. *Id.* at 59. The petitioners' argument is illustrative of a failure to grasp the creative potential of a tool because it was a mechanical apparatus.

## 2. Substantial Similarity

Assuming *arguendo* that digital sampling constitutes rerecording, it still may not infringe upon a copyright since the copying also must be substantial.<sup>64</sup> Determining whether one work is substantially similar to another has been one of copyright law's more slippery questions. Despite numerous attempts to develop precise formulas,<sup>65</sup> workable standards in determining the degree of similarity have been elusive. Any line used to gauge the degree of similarity between works necessary to constitute infringement will necessarily be arbitrary.<sup>66</sup> This being the case, the matter should be treated as an issue of fact.

Similarity between two works will be determined either by their comprehensive nonliteral similarity,<sup>67</sup> or by their fragmented literal similarity.<sup>68</sup> The fragmented literal similarity approach, which searches for the use of literal or nearly literal pieces of a copyrighted work in another, is most applicable in the digital sampling context.<sup>69</sup> This approach typically focuses on the significance of the alleged infringing portions *to the plaintiff's work*;<sup>70</sup> usually, the defendant's copying must constitute a substantial portion of the copied work. The critical notion of substantiality can be defined either in a quantitative<sup>71</sup> or qualitative sense.<sup>72</sup>

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64. See 3 M. NIMMER, *supra* note 44, at § 13.03[A]. Of course, a plaintiff must first prove that a portion of defendant's recording is a sample of plaintiff's sound. However, expert analysis of a sound wave's "fingerprint" can determine if defendant's sample was taken from plaintiff. GOLDBERG & BERNSTEIN, *supra* note 29, at 4.

65. The test most frequently implemented is the ordinary observer test, which requires that the ordinary, reasonable man should be able to detect the copying without aid or suggestion from others. See, e.g., *Harold Lloyd Corp. v. Witwer*, 65 F.2d 1 (9th Cir. 1933), *cert. dismissed*, 54 S. Ct. 94 (1934). Permutations of the ordinary observer test have been numerous. See, e.g., *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946) (breaking the substantial similarity test into two separate elements; copying is first established by comparing the two works in their entirety, followed by a jury determination of whether defendant's copying took so much from the plaintiff's work that an unlawful appropriation occurred); *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977) (using a two prong similarity test which inquired into 1) whether the two works were similar in their general ideas and then 2) whether those ideas were expressed similarly in the eyes of a jury). See generally 3 M. NIMMER, *supra* note 44, at § 13.03[E].

66. See *Nichols v. Universal Pictures Co.*, 45 F.2d 119, 122 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931).

67. See 3 M. NIMMER, *supra* note 44, at § 13.03[A].

68. See *id.*

69. Comprehensive nonliteral similarity is applicable because it concerns similarity in which the "fundamental essence" of one work pervades another. *Id.* at § 13.03[A][1].

70. See, e.g., *Atari, Inc. v. North American Phillips Consumer Electronics Corp.*, 672 F.2d 607 (7th Cir.), *cert. denied*, 459 U.S. 880 (1982). See generally 3 M. NIMMER, *supra* note 44, at § 13.03[A][2] (discussing the fragmented literal similarity approach).

71. The quantum of copying permitted varies from case to case. See, e.g., *Marks v.*



The Ninth Circuit had occasion to apply the substantial similarity test to sound recordings in *United States v. Taxe*.<sup>73</sup> In *Taxe*, the court considered, *inter alia*, whether a rerecording of copyrighted recordings of musical performances infringed on the copyright owner's reproduction rights when one or more of the following changes were made in the original recording: The addition of echoes and reverberations; increased and decreased speed; elimination and reduction of volume of certain sounds; and the addition of new sounds through a synthesizer.<sup>74</sup> The court held that the determination of whether the rerecording constituted an infringing reproduction of the original work was a jury question as it turned upon a finding of substantial similarity.<sup>75</sup>

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Leo Feist, Inc., 290 F. 959 (2d Cir. 1923) (copying of six bars from musical composition held not actionable); *Robertson v. Batten, Barten and Osborn, Inc.*, 146 F. Supp. 795 (S.D. Cal. 1956) (copying of two bars from musical composition held to be an infringement).

72. See, e.g., *Higgins v. Baker*, 309 F. Supp. 635 (S.D.N.Y. 1969) (holding copying of only 0.8% of plaintiff's work could be an infringement if qualitatively important to the work).

73. 540 F.2d 961 (9th Cir. 1976), *cert. denied*, 429 U.S. 1040, *reh'g denied*, 429 U.S. 1124 (1977).

74. *Id.* at 961. One commentator has argued that since the court in *Taxe* found defendant's rerecording could infringe upon plaintiff's copyright despite the addition of sound effects, the decision implicitly supports the view that changing the sounds contained on another recording, and by analogy digital sampling, constitutes rerecording and not imitation. Note, *supra* note 48, at 1732. However, in *Taxe*, neither the court of appeals nor the district court ever confronted the threshold inquiry of whether the defendant's acts were independent fixations or rerecording; instead, both courts assumed that the defendant's work was a rerecording and, consequently, they directed their efforts toward deciding whether a rerecording alone could constitute infringement or whether, instead, substantial similarity was required. *United States v. Taxe*, 380 F. Supp. 1010 (C.D. Cal. 1974); *Taxe*, 540 F.2d at 964. The district court framed the issue as being "what effect, if any, do changes made by the *re-recorder* . . . have on the offense of infringement." 380 F. Supp. at 1012 (emphasis added). The district court concluded that any rerecording constituted an infringement. *Id.* at 1014. However, the court of appeals vacated the portion of the district court's decision holding all rerecording to be infringements. *Taxe*, 540 F.2d at 961. The court of appeals determined that the proper analysis was one of substantial similarity, but found that the district court's jury instruction, which provided for a comparison of the two works, cured any error. *Id.* at 965. The Ninth Circuit, however, never doubted that it was dealing with an instance of rerecording: "[The district court's] instruction went beyond the law insofar as it purported to characterize any and all re-recordings as infringements, but the subsequent inclusion of a comparison test permitted the jury to consider 'substantial similarity', and cured any error . . ." *Id.* at 965. This assumption apparently was predicated upon expert trial testimony that defendant's work was a rerecording. 380 F. Supp. at 1014. Additionally, given that the defendant's acts clearly constituted piracy, it is understandable that neither court felt a need to inquire whether the defendant's works were "imitations," and therefore that the only relevant infringement question was whether the works were substantially similar.

75. 540 F.2d at 965. The district court itself assumed that if substantial similarity were a prerequisite to proving infringement, the plaintiff would have to show fragmented literal similarity. 380 F. Supp. at 1014.

The *Taxe* decision demonstrates the uncertain nature of substantial similarity inquiries. Even under the egregious circumstances of that case—the defendant had rerecorded the entire work of another—the issue of substantial similarity was still a question of fact, the ultimate resolution of which depended upon the average lay person's ability to recognize the two works as significantly alike, despite the defendant's changes. Therefore, it is conceivable that a rerecording may alter a sound recording substantially enough that a reasonable juror would be unable to recognize any significant resemblance between the two works. Moreover, if the alteration in sound is accompanied by the use of only a very small portion of the original recording, the likelihood of a jury finding substantial similarity becomes even more remote. Although generalizations in this area are ill-advised, it is clear beyond cavil that a plaintiff who attempts to convince a jury that a defendant's use of a few seconds of the plaintiff's sound recording constitutes substantial similarity, faces a difficult task. This is especially so where those few seconds of sound have been altered materially in pitch, duration, and intensity. In sum, given the inconsistent results of substantial similarity findings in other contexts,<sup>76</sup> a musician who seeks protection from digital sampling through traditional infringement doctrines, hangs his hat on a very uncertain peg.

Although *Taxe* predated the enactment of the 1976 Copyright Act, the decision is consistent with the legislative history of section 114.<sup>77</sup> In enacting the Act, Congress sought to address the rerecording problem without unduly restricting other creative endeavors.<sup>78</sup> Therefore, Congress limited the duplication rights of copyright owners in sound recordings to the right to make copies of a copyrighted work.<sup>79</sup> Moreover, Congress clearly manifested its intention to provide protection only against the rerecording of all or significant portions of a copyrighted sound recording:

Subsection (b) of section 114 makes clear that statutory protection for sound recordings extends only to the particular sound of which the recording consists, and would not prevent a separate recording of another performance in which those sounds are imitated. Thus, infringement takes place whenever *all or any sub-*

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76. See *supra* note 77.

77. See *supra* notes 59-61 and accompanying text.

78. See *supra* notes 59-61 and accompanying text.

79. Section 114 of the Copyright Act limits the rights of copyright owners in sound recordings to those granted under 17 U.S.C. §§ 106(1)-(3) (1982). Section 106(1) refers to the reproduction of copyrighted "works" in copies or phonorecords. 17 U.S.C. § 106(1) (1982).

*stantial portion* of the actual sounds that go to make up a copyrighted sound recording are reproduced . . . .<sup>80</sup>

A sample typically constitutes only a minuscule portion of the underlying work. Since Congress apparently sought to prevent only the copying of large chunks of a work, it would be difficult to argue that a short digital sample, constituting three, two, or even one note, is "substantial" in any quantitative sense. While it might be tempting to argue that the sample, however short, is qualitatively substantial, the legislative history and the clear language of section 114 suggest qualitative substantiality is not sufficient to constitute infringement. The phrase "all or a substantial portion," given its natural meaning, implies a quantitative limitation.<sup>81</sup> In light of the foregoing, even if one assumed that digital sampling constituted rerecording, a short digital sample of a copyrighted recording would not constitute infringement within the meaning of the Act because the copy would not be quantitatively substantial.

### 3. Protected Expressions

To demonstrate the statutory and doctrinal inadequacies of current copyright law as applied to digital sampling, the foregoing discussion of substantial similarity was undertaken with the assumption that digital sampling takes something from underlying recordings, which if taken in a substantial fashion constitutes infringement. Indeed, any analysis of the issue which characterizes sampling as an infringing use must assume that sampling copies a component of a sound recording which the law protects. Digital sampling, however, reaches beyond the scope of copyright law by taking something which the Act never contemplated protecting—style.<sup>82</sup>

The goal of the sampling artist is not to recapture the actual sounds of another musician. Unlike the defendant in *Taxe*, a sampling artist does not take exact sonic reproductions of sound recordings, add some high tech fluff, and call it his own. Digital sampling's main appeal is that it can do more.<sup>83</sup> In actuality, the

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80. H.R. REP. NO. 1476, *supra* note 57, at 5721 (emphasis added).

81. This meaning of the phrase is clarified when one considers it in light of the pervasive record piracy which was occurring in the years prior to the sections enactment. See *supra* note 57 and accompanying text.

82. It is axiomatic that copyright law does not protect the abstract; instead, it protects only concrete expressions. For example, see 17 U.S.C. § 102(b) (1982), which provides that copyright protection does not extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery regardless of how expressed.

83. See C. DODGE & T. JERSE, *supra* note 17; S. BRAND, *supra* note 19.

sampler changes certain components of the sound while retaining the original timbre.<sup>84</sup> In this way sampling captures the unique aspect of a performer's sound—his vocal or instrumental style.<sup>85</sup>

The idea of providing copyright protection to a portion of a work as small and intangible as a single note or tone is quite foreign to the current copyright framework. Only when groups of sounds are taken together do they form an expression meriting copyright protection. Section 101 defines sound recordings as works which result in the fixation of a "series of musical, spoken, or other sounds . . ."<sup>86</sup> While digital samples are sometimes produced from more than a single note, multi-note samples are typically unnecessary.<sup>87</sup> Under the Act's definition of sound recordings,<sup>88</sup> use of a single note from a copyrighted recording seemingly would not be prohibited. The regulations for application for copyright, formulated by the Copyright Office, support this interpretation.<sup>89</sup> In its regulations, the Copyright Office gives examples of things not subject to copyright under the Act.<sup>90</sup> One such example is a single word.<sup>91</sup> Analogizing words within literary works to notes within musical works, it is clear that that an individual musical note as a sound recording is not protected from conventional rerecording. As a corollary of the foregoing, a musical note should not be protected against use in digital sampling.<sup>92</sup>

To summarize, second order technologies present a challenge which necessitates innovative interpretation of the Copyright Act of 1976. Although the Act extends some protection to recorded sound, the protection is limited when compared to the protection the Act affords other forms of authorship. Specifically, Congress did not provide a right to control the production of imitative sound recordings; instead, the Act only proscribes rerecording. Since sampling is significantly different from mere rerecording, the Act does

84. See *supra* note 21 and accompanying text.

85. A performer's style permeates the smallest unit of a performance—viz., a single note or tone.

86. 17 U.S.C. § 101 (1982).

87. Pareles, *supra* note 4.

88. Section 101 defines sound recordings as "works that result from the fixation of a series of musical, spoken, or other sounds . . ." 17 U.S.C. § 101 (1982) (emphasis added).

89. 37 C.F.R. § 202.1 (1987).

90. *Id.*

91. *Id.*

92. As one commentator concluded, "[c]opyright . . . doesn't protect ideas or information or methods, but the concrete *expression* of those ideas. It protects works and not words and not a tone." Kidder, *Copyrighting Intellectual Property*, *Christian Science Monitor*, Dec. 7, 1987, at 21 (quoting Mihaly Fiscor, Director, Copyright Division, World Intellectual Property Organization) (emphasis in original).

not apply to protect performers' sounds from the sampler. Moreover, even if one assumes that digital sampling does constitute rerecording, a short sample extracted from a copyrighted recording would not be infringing within the meaning of the Act because the copy would not be quantitatively substantial. Finally, the Act falls short because digital sampling, insofar as it borrows *style* from the sampled artist, takes something which Congress never sought to protect in enacting the copyright framework.

### III. PROTECTION UNDER COMMON LAW ACTION FOR UNFAIR COMPETITION

#### A. *The Tort of Passing Off*

Despite federal copyright law's inability to protect musicians from digital sampling, performers' interests in their signature sounds may receive protection from imitation under various common law causes of action.<sup>93</sup> Particularly well suited may be the tort of unfair competition.<sup>94</sup> The doctrine of unfair competition is com-

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93. Several authors have suggested that the right of publicity, a cause of action based upon a wrongful appropriation of a plaintiff's identity, may be a means of protecting performer's unique stylistic qualities. *See, e.g.*, Note, *Commercial Sound-Alikes: An Argument For A Performer's Cause of Action*, 62 ST. JOHN'S L. REV. 647 (1988); Note, *supra* note 48. A broad right of publicity action, however, may preclude otherwise permissible forms of mimicry since publicity rights turn on the right to control the use of a personae regardless of whether or not confusion is caused. *See* Note, *The Right of Publicity As A Means of Protecting Performer's Style*, 14 LOY. L.A.L. REV. 129, 151 (1980) (arguing that recognition of a broad right of publicity would preclude imitation and that the right must therefore be limited to actions against advertisers who imitate for commercial gain).

94. Unfair competition has been described as the "vigorous and sometimes unconfined companion of copyright law." R. BROWN & R. DENICOLA, *supra* note 38, at 439. While a discussion of federal preemption of common law actions is beyond the scope of this article, it is fair to note that the effect of the current Copyright Act is highly uncertain. *Id.* at 483-93. In one recent case the Ninth Circuit held that a professional singer's cause of action, arising out of a sound-alike's performance in a commercial, was not preempted by the federal copyright regime since the plaintiff did not seek to preclude the use of a copyrighted composition but only the imitation of her voice. *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988). Since an action for unfair competition would seek to preclude use of certain sounds and not the use of a copyrighted composition, such action would not logically be preempted. *See generally* W. PROSSER & W. KEETON, *PROSSER AND KEETON ON TORTS* 1005-31 (5th ed. 1984) (discussing tort liability for interference with prospective advantage) [hereinafter PROSSER]. Similar in application to common law unfair competition actions is section 43(a) of the Lanham Act, which provides for a cause of action for damages caused by the use of a false description or designation of origin in connection with goods or services. 15 U.S.C. § 1125(a) (1982). Section 43(a) has been used in cases of unfair competition involving public confusion. *See, e.g.*, *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985). Section 43(a) also has been used to allege a cause of action against the use of sampling. *See, e.g.*, *Thomas v. Diamond*, No. 87 Civ. 7048 (S.D.N.Y. filed Oct. 1, 1987) *cited in* Soicher, *supra* note 30, at 26.

posed of various, related tort causes of action which seek to discourage competition that unfairly interferes with the prospective economic advantage of another.<sup>95</sup> It is conceivable that the courts could expand the doctrine of unfair competition to accomodate recording artists seeking protection from sampling. The two aspects of unfair competition which most directly bear on the issues raised by digital sampling are the torts of "passing off" and misappropriation.<sup>96</sup>

The mere imitation of a performance never has been precluded by statute or common law.<sup>97</sup> Many have feared that granting performers exclusive rights against imitation would function as a monopoly on gestures, voices, and sounds and would impede progress in the arts.<sup>98</sup> However, performers, by virtue of the judicial recognition of the tort of passing off, have received limited rights to prevent imitations of their performance where the imitations are similar enough to confuse the public as to the author's identity.<sup>99</sup> Passing off occurs when the producer of a product or a work makes a false representation which tends to induce buyers to believe that the producer's product is that of another.<sup>100</sup> Indispensable to an action for passing off is the plaintiff's showing that the defendant's product caused or was likely to cause confusion with the plaintiff's product.<sup>101</sup>

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95. PROSSER, *supra* note 94, at 1013.

96. Appropriately enough, the differences between these torts parallel the copyright law's distinction between imitation and duplication. However, the potential applicability of unfair competition notwithstanding, the absence of a uniform doctrine of unfair competition makes generalizations about the ambit of its protection difficult.

97. *See supra* text accompanying note 52.

98. Comment, *supra* note 52, at 821.

99. *Id.* at 822. Some courts additionally have required that plaintiff and defendant be in competition before an unfair competition claim would lie. *See, e.g.,* *Midler v. Ford Motor Co.* 849 F.2d 460, 462-63 (9th Cir. 1988) (declining to find unfair competition where singer and advertising agency were not in competition). However, other courts have not required that the plaintiff and the defendant lie in direct competition. *See, e.g.,* *Metropolitan Opera Ass'n Inc. v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 101 N.Y.S.2d 483, 491-92 (Sup. Ct. 1950), *aff'd*, 279 A.D. 632, 107 N.Y.S.2d 795 (N.Y. App. Div. 1951) (claiming that the existence of actual competition between the parties is no longer a prerequisite to an unfair competition action). To the extent that sampled musicians are in direct competition with sampling musicians, the requirement would not preclude an action arising out of digital sampling.

100. PROSSER, *supra* note 94, at 1015. A paradigmatic example of passing off occurs when a manufacturer purposely designs a product to resemble a better known brand of the same product. *See, e.g.,* *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670 (S.D.N.Y. 1963).

101. PROSSER, *supra* note 94, at 1015-17. Some courts have required that plaintiff's product must have acquired a "secondary meaning"—an identification between a product and a manufacturer so clear that supply from any other source must be calculated to

The tort of passing off has served as the basis for actions by numerous performing artists against imitators of their voices or styles of performing.<sup>102</sup> A leading example is *Lahr v. Adel*.<sup>103</sup> In *Lahr*, comedian Bert Lahr sought an injunction and damages against the defendant for its production of a television commercial which featured a talking cartoon duck whose voice was an imitation of Lahr's. The court granted relief based on the claim that the defendant's imitation caused confusion as to the source of the duck's voice and, as such, constituted a basic example of passing off.<sup>104</sup> The court noted that a performer's distinctive sound, though not protected by copyright law or the common law against mere imitation, still is entitled to some level of protection against imitators where the confusion the imitation engenders is injurious to the plaintiff's ability to earn a living through professional performances.<sup>105</sup>

Most recently, the Ninth Circuit held that Ford Motor Company's use of Bette Midler's rendition of "Do you Want to Dance?" in one of its commercials was actionable under California tort law as an appropriation of her identity.<sup>106</sup> While noting the similarity between Midler's action and that in *Lahr*, the *Midler* court declined to find unfair competition because, since Midler did

deceive the public. See, e.g., *Kirkland v. National Broadcasting Co., Inc.*, 425 F. Supp. 1111 (E.D. Pa. 1976), *aff'd*, 565 F.2d 152 (3d Cir. 1977). Secondary meaning, however, has been interpreted by other courts as the equivalent of the likelihood of confusion. See, e.g., *Jackson v. Universal International Pictures*, 36 Cal.2d 116, 222 P.2d 433 (1950) (en banc) (rejecting the view that secondary meaning requires an imitation product to conjure up the name of the producer of the original product). Underlying the tort of passing off is a policy judgment that confusion between products works to the ultimate disadvantage of the public, as well as the plaintiff; the plaintiff, suffering from lost profits because of the confusion caused by the defendant's marketing of a similar but cheaper product, has less incentive to produce, and, if the plaintiff does scale back production, the public suffers from the decreased availability of quality products. Comment, *supra* note 52, at 822.

102. See *supra* note 99.

103. 300 F.2d 256 (1st Cir. 1962).

104. *Id.* at 259.

105. *Id.* See also *Shaw v. Time-Life Records*, 38 N.Y.2d 201, 341 N.E.2d 817, 379 N.Y.S.2d 390 (1975) (holding that big-band leader Artie Shaw had no property right in his sound which could preclude defendant from producing imitative records, but noting that if the defendant's recordings caused confusion between Shaw's original recordings and defendant's imitations, an action for passing off would lie).

106. *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988). The court distinguished Midler's action, which was based upon the uniqueness of her singing voice, from the failed suit of Nancy Sinatra against Goodyear Tire, where Goodyear had used a Sinatra sound-alike's rendition of a song made popular by Sinatra in one of its commercials. *Id.* at 462. Sinatra failed, the *Midler* court noted, because she sought damages from a defendant who had bought a license to use the song and, as such, her claim was preempted under federal copyright law. *Id.*

not do commercials, the parties were not in competition.<sup>107</sup> The court nevertheless emphasized that Ford's commercial created confusion among the listening public, leaving listeners with the impression that Midler had done the Ford commercial.<sup>108</sup>

In recognizing the confusion created by Ford's commercial, the *Midler* court strengthened the legal position of musicians who seek to protect their unique sounds from being used by sampling musicians. Sampling may create confusion among listeners; in addition, sampled and sampling musicians may be in direct competition. Consequently, a sampled musician may have a cause of action against a sampler for unfair competition, even under the *Midler* court's restrictive view.

### B. Misappropriation

Unlike passing off, the tort of misappropriation recognizes a quasi-property right in ideas and products which is not recognized by copyright law.<sup>109</sup> Misappropriation, rather than focusing on the degree of confusion a defendant's product causes, looks to factors probative of pecuniary loss—for example, the amount of expertise and labor exerted by a plaintiff in producing his product and the presence of a competitive relationship between the parties.<sup>110</sup> The leading case dealing with misappropriation is *International News Service v. Associated Press*,<sup>111</sup> in which the Supreme Court considered the property rights held by a newspaper in the news reports it produced. The case concerned the defendant newspaper's pirating of the plaintiff newspaper's news reports, through a telegraph, for use in the defendant's later editions. The news reports clearly were not copyrightable as the underlying information was not the creation of the writer; however, the court held that the defendant's use of its competitor's news was unfair competition.<sup>112</sup> Central to the courts holding was the its recognition of the great expense and skill necessary to collect the news, as well as the existence of a competitive relationship between the parties.<sup>113</sup> The Court found that, al-

107. *Id.* at 462-63.

108. The court's emphasis on the confusion created by Ford's commercial is particularly interesting because publicity actions do not require confusion for recovery. Note, *The Right of Publicity As A Means of Protecting Performer's Style*, *supra* note 93, at 158 (publicity rights may be usurped even without passing off).

109. PROSSER, *supra* note 94, at 1020.

110. Comment, *supra* note 52, at 842-43.

111. 248 U.S. 215 (1918) [hereinafter INS].

112. *Id.* at 241.

113. *Id.* at 236-38.



though the plaintiff may not be able to enforce property rights in its news against the general population, against its competitors a limited property right did exist, and, therefore, the defendant's actions constituted misappropriation.<sup>114</sup>

The development of the misappropriation doctrine was a judicial response to the growth of advanced technologies which could reproduce non-copyrighted works instead of merely imitating another's product.<sup>115</sup> As *INS* demonstrates, the ability to precisely reproduce non-copyrighted works, such as news reports, poses problems beyond the traditional scope of passing off. In the misappropriation context the defendant does not pass off his own work as that of the plaintiff; instead, he takes something from the plaintiff which he seeks to represent as his own. Hence, the traditional remedy of passing off is not applicable. For this reason, the Court in *INS* adopted a misappropriation standard.<sup>116</sup>

In the area of performances, the tort of passing off was intended to protect the plaintiff from confusing imitations, regardless of whether the imitation contained a measure of originality. The easy duplication of non-copyrighted works, the phenomenon which the remedy of misappropriation attempts to prevent, entails little, if any, originality on the part of the duplicating party.

A paradigm of misappropriation is exemplified by the phenomenon of record piracy.<sup>117</sup> A recording artist might spend much time and energy producing a record only to have unauthorized duplications marketed. Little would be gained artistically since the pirate's duplication would add nothing of value to the recording. However, because the pirates made no fraudulent representations causing public confusion as to who was the author of the works, a traditional action for passing off could not be maintained. As a result, the courts developed the tort of misappropriation to deal with

114. *Id.* at 242.

115. Simon, *Right of Publicity Reified: Fame As Business Asset*, 30 N.Y.L. Sch. L. Rev. 699, 726 (1985); Comment, *supra* note 52, at 822.

116. *INS* at 241-42. This is not to suggest, however, that passing off never can be applied in a misappropriation context. As Justice Holmes suggested in his concurrence in *INS*, the primary requirement of passing off is a misrepresentation which gives the defendant an advantage over the plaintiff which the law considers undesirable. *Id.* at 247 (Holmes, J., concurring). Rather than recognizing a separate misappropriation tort as the majority did, Holmes found the defendant's use of its rival's news reports actionable as passing off, even though it occurred in reverse form. *Id.*

117. For examples of misappropriation actions brought in the context of record piracy, see *A&M Records, Inc. v. M.V.C. Distributing Corp.*, 574 F.2d 312 (6th Cir. 1978) and *Mercury Record Productions, Inc. v. Economic Consultants, Inc.*, 64 Wis.2d 163, 218 N.W.2d 705 (1974), *cert. denied*, 420 U.S. 914 (1975).

such situations.

As the preceding discussion suggests, claims for misappropriation primarily are limited to circumstances involving actual duplication of the work of a competitor. Misappropriation never has been used successfully to preclude imitations of a performer.<sup>118</sup> For example, in *Booth v. Colgate-Palmolive, Inc.*,<sup>119</sup> the plaintiff argued that the defendant's imitation of the plaintiff's distinctive vocal representation of a popular television show character in a commercial constituted unfair competition under New York law. However, the plaintiff did not allege that any confusion resulted as to the source of the voice. The court reaffirmed the view that mere imitations do not constitute unfair competition and held for the defendant.<sup>120</sup> More importantly, however, the Court distinguished imitations from misappropriation, stating that a showing of the latter would require actual duplication of the plaintiff's voice by the defendant.<sup>121</sup>

As with federal copyright law, the question of whether the remedy of unfair competition is available to recording artists against users of digital sampling is, in large measure, answered by determining whether sampled sounds are sufficiently original to merit protection. If samples could be analogized to a rerecording of the original artist's work, a rerecording devoid of any meaningful artistic contribution by the sampling artist, it seems clear that an action for misappropriation would lie. The parties are, after all, clearly in competition for a share of the music purchasing market and the development of a distinctive musical sound is often an arduous task. If, however, as the preceding analysis suggests, digital samples do represent an original contribution on the part of the sampling musician, then unfair competition would protect the sampled musician only if the use of sampling confuses the public as to the author of the work. In this case, sampled musicians would be protected irrespective of the amount of originality present in their finished product.

A situation in which a recording artist's distinctive sound was used in the recording of another through digital sampling would not be a typical case of passing off. In fact, since the sampling musician does not present the sound produced as that of the sampled musician but rather presents it as his own, the traditional passing

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118. PROSSER, *supra* note 94, at 1020 n.53.

119. 362 F. Supp. 343 (S.D.N.Y. 1973).

120. *Id.* at 346.

121. *Id.*

off scenario would be reversed. Now, the sound of the sampled musician is presented as that of the sampling musician. However, as Holmes' *INS* concurrence suggests, the inapplicability of passing off to situations where the defendant represents the plaintiff's work as his own is more form than substance.<sup>122</sup> The gravamen of a passing off claim is a representation which tends to confuse the buyer as to the producer's or the author's identity. Beyond the purely traditional requirement that the defendant's product be confused with the plaintiff's, there appears to be no reason not to extend the tort to reverse situations.<sup>123</sup> Digital sampling clearly can fit this mold. When a recording contains a sample of a well-known musician's signature sound it is not unrealistic to suppose that confusion might result as to the identity of the sound's author.

#### IV. Conclusion

The Copyright Act, as currently written, is insufficient to protect performers and their sounds from sampling. However, the doctrine of unfair competition appears to succeed where copyright law fails. The tort of passing off, due to its malleability, seems to have some applicability to the problems raised by digital sampling. Because the concept of passing off is not predicated upon property rights but, instead, upon a need to prevent certain kinds of undesirable competition, a sampled performer who brings an action for passing off need not be concerned with the degree of originality, merely the degree of confusion. Simply put, the degree of originality added by a sampling musician is irrelevant to an action for passing off. Consequently, the doctrine of unfair competition presently is better suited than copyright law to provide protection to performers against tortious injury at the hands of second order technologies such as digital sampling.

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122. *International News Service v. Associated Press*, 248 U.S. 215, 246-48 (1918) (Holmes, J., concurring).

123. A somewhat analogous situation called "reverse confusion," where confusion between plaintiff's relatively unknown goods and those of a well-known defendant occurs, has been recognized as actionable passing off. See *Big O Tire Dealers v. Goodyear Tire & Rubber Co.*, 561 F.2d 1365 (10th Cir. 1977), *cert. dismissed*, 434 U.S. 1052 (1978).

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