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VMG Salsoul, LLC v. Ciccone, 824 F.3d 871 (9th Cir. 2016)

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VMG SALSOUL, LLC v. CICCONE, 824 F.3d 871 (9th Cir. 2016).

I. INTRODUCTION

If the lay listener cannot recognize that a portion of a song has been sampled, should the sampler be liable for copyright infringement? Instinctively, one might assume that liability ensues any time a copyright infringer misappropriates copyrighted materials.[1] However, traditional copyright law allows infringers to raise affirmative defenses. Of the available defenses, a copyright infringer may argue that their use was so minimal that an "average audience would not recognize the appropriation."[2] This defense is referred to as *de minimis* use.[3] While the *de minimis* use defense is often asserted in copyright cases, the real question is whether *de minimis* use is a viable defense to claims arising from the appropriation of sound recordings.

The Ninth Circuit was recently faced with this question in *VMG Salsoul, LLC v. Ciccone* (hereinafter "*VMG Salsoul*")[4] In a surprising split from the Sixth Circuit's finding in *Bridgeport Music, Inc. v. Dimension Films*, the Ninth Circuit held that the *de minimis* use exception *does* apply to infringement actions regarding copyrighted sound recordings.[5] The Ninth Circuit's holding in *VMG Salsoul* has created a split between two influential circuits representing the music industry.[6] The divide between

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[1] The Copyright Act of 1976, 17 U.S.C. § 501(a) (1978).

[2] *Newton v. Diamond*, 388 F.3d 1189, 1192 (9th Cir. 2004).

[3] "Copying has occurred to such a trivial extent as to fall below the quantitative threshold of substantial similarity." 4 Nimmer on Copyright § 13.03(A) 13-27 (2017).

[4] *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871 (9th Cir. 2016).

[5] *Id.*

[6] Nashville, Tennessee, has the highest concentration of music industry jobs in the nation. The second highest concentration is in Los Angeles, California. Nashville is located within the United States' Sixth Circuit and Los Angeles is in the Ninth Circuit. GLENN PEOPLES, *Want a Job in the Music Business? These Are the Cities You Should Live In*, BILLBOARD, Aug. 13, 2013,

these two circuits creates ambiguity in the music industry with regards to the validity of the regular practice of music sampling.

This article will present a discussion of whether the Ninth Circuit's application of the *de minimis* use exception to sound recordings in *VMG Salsoul* is consistent with the application of *de minimis* use in copyright law. The background section will address the concept of copyright infringement and the application of the *de minimis* use exception's application to copyright law in general.[7] Part III summarizes the Ninth Circuit's decision in *VMG Salsoul*.[8] Part IV discusses the broader legal implications of the circuit split between two influential circuits in the music industry.[9]

II. BACKGROUND

A. Copyright Infringement

The dispute in *VMG Salsoul* arises from the plaintiff's assertion that the defendants infringed the copyrights to the composition and sound recording of the song *Love Break*.[10] It is a firmly rooted principle in copyright law that copyright protection only extends to the expression of an idea and not the idea itself.[11] Under § 106 of the Copyright Act, Congress delineates the specific rights exclusive to a copyright holder.[12] Copyright infringement is

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http://www.billboard.com/biz/articles/5650624/want-a-job-in-the-music-business-these-are-the-cities-you-should-live-in-from.

[7] *Infra* notes 10–48.

[8] *Infra* notes 49–137.

[9] *Infra* notes 138–172.

[10] *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 875 (9th Cir. 2016).

[11] *Mazer v. Stein*, 347 U.S. 201, 217-18 (1954).

[12] Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

(1) to reproduce the copyrighted work in copies or phonorecords;

(2) to prepare derivative works based upon the copyrighted work;

defined in § 501(a) as any person who violates the exclusive rights of a copyright holder.[13] The Section specifically states:

> Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 122 or of the author as provided in 106A(a), . . . is an infringer of the copyright or right of the author, as the case may be. For purposes of this chapter, any reference to copyright shall be deemed to include the rights conferred by section 106A(a).[14]

To establish copyright infringement, the plaintiff must prove its ownership of a valid copyright and that the defendant copied the protected material.[15] A valid copyright is an original work that was independently created, possesses a "modicum of creativity,"[16]

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(3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
(4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
(6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

The Copyright Act of 1976, 17 U.S.C. §106 (1978).

[13] The Copyright Act of 1976, 17 U.S.C. §501(a) (1978).

[14] *Id.*

[15] *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

[16] *Id.* at 346.

and is fixed in a tangible medium of expression.[17] If the evidence provided to prove originality shows minimal effort was applied then there must be a more substantial showing of creativity before copyright protection will attach.[18] In order to establish the second prong of the infringement test, the plaintiff must show that defendant copied the original work, with either direct or circumstantial evidence, and that the two works are substantially similar.[19]

i. Access

Proof of copying is essential to a claim of copyright infringement because without copying there can be no finding of infringement.[20] However, because direct evidence of copying is rare, a plaintiff may use circumstantial evidence to prove the defendant replicated the plaintiff's original work.[21] Use of circumstantial evidence requires a fact-based showing that the defendant had access to the infringed work and that the two works are substantially similar.[22] In order to prove the defendant had access to the copyrighted work it must be shown that the defendant had "an opportunity to view or to copy plaintiff's work."[23] However, access requires more than mere speculation, it must be reasonably possible that the defendant viewed or heard the copyrighted material.[24] When direct evidence of access is unavailable to the plaintiff, the copying can be proven by a showing of striking similarity between the two works sufficient to

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[17] *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1139 (9th Cir. 2006).
[18] 2 M. NIMMER, NIMMER ON COPYRIGHT § 901(A), at 2-13 (1987).
[19] *Krofft Television Prods. v. McDonald's Corp.*, 562 F.2d 1157, 1162 (9th Cir. 1977).
[20] *Arnstein v. Edward B. Marks Music Corp.*, 82 F.2d 275 (2d Cir. 1946).
[21] *Selle v. Gibb*, 741 F.2d 896, 900 (7th Cir. 1984).
[22] *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 481 (9th Cir. 2000).
[23] *Id.* at 482 (quoting *Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1172 (9th Cir. 1977)).
[24] *Bolton*, 212 F.3d at 482.

"raise an inference of access."[25] A striking similarity sufficient to infer access, without direct proof, requires the similarities between the two works be "so striking as to preclude the possibility that the defendant independently arrived at the same result."[26] In other words, while striking similarities can permit an inference of access, the plaintiff's proof must establish that the inference of access is reasonable.[27]

ii. Substantial Similarity: Intrinsic/Extrinsic Test

Once access has been established, the next question in the analysis is whether the copied version is substantially similar to the plaintiff's original work.[28] In order to determine substantial similarity the Ninth Circuit[29] follows an intrinsic/extrinsic analysis.[30] To have improper appropriation there must be both substantial similarities of the general ideas as well as substantial similarities of the expression of the ideas.[31] The extrinsic test is the determination of whether the ideas are substantially similar.[32] This test is an objective comparison of specific expressive

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[25] *Gibb*, 741 F.2d at 901.
[26] Nimmer, *Copyright* § 13.02 at 13-9 (1983).
[27] *Gibb*, 741 F.2d at 902.
[28] *Krofft*, 562 F.2d at 1164.
[29] When determining substantial similarity, the Sixth Circuit first determines which parts of the original work are protectable. If there are any protectable elements in the original work, then the court assesses whether defendant's allegedly infringing work rises to the level of substantial similarity when compared with the original copyrighted work. While similar to the Ninth Circuit's extrinsic/intrinsic test, the Sixth Circuit follows a stricter standard for determining when to allow expert testimony. Additionally, the first step of the Sixth Circuit's test functions to filter out unoriginal elements from the very start. Overall, while there are similarities between the Sixth and the Ninth Circuits tests for substantial similarity, they are not identical. *Murray Hill Publ'ns., Inc. v. Twentieth Century Fox Film Corp.*, 361 F.3d 312, 318 (6th Cir. 2004) (citing *Kohus v. Mariol*, 328 F.3d 848, 855 (6th Cir. 2003)).
[30] *Krofft Television Prods. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977).
[31] *Id.* at 1164.
[32] *Id.*

elements that can be listed and analyzed.[33] Both analytic dissection and expert testimony may be used at this phase of the analysis because this is a question of fact.[34] If similarities are revealed during the extrinsic test then the court proceeds to an intrinsic evaluation.[35] The intrinsic test analyzes the two works to determine if there is a substantial similarity in the forms of expression.[36] This is a subjective analysis that requires the trier of fact to determine if an ordinary reasonable person would find the two works to be substantially similar.[37] At this stage of the analysis, analytic dissection and expert testimony are not allowed.[38] Ultimately, if an average audience would fail to recognize the appropriation from the original work then there is no evidence of substantial similarity.[39]

B. De Minimis Use Defense

The primary purpose of Copyright law is to create incentives for individuals who exert creative efforts.[40] The defense of "*de minimis non curat lex*"[41] insulates individuals from liability when their violation of another person's rights are so minimal so as to be insignificant.[42] Specifically, the *de minimis* use exception helps limit unnecessary restrictions on a person's fair use of language, symbols and figures.[43] Within the context of copyright law, *de minimis* can mean: a technical violation of another person's right

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[33] *Id.*
[34] *Id.*
[35] *Id.*
[36] *Krofft*, 562 F.2d at 1164.
[37] *Id.*
[38] *Id.*
[39] *Newton v. Diamond*, 204 F. Supp. 2d 1244, 1257 (C.D. Cal. 2002).
[40] U.S. CONST. art. I, Article I, § 8, cl. 8.
[41] The law does not concern itself with trifles.
[42] *Ringgold v. Black Entm't Television, Inc.*, 126 F.3d 70, 74 (2d Cir. 1997).
[43] E. Scott Johnson, *Protecting Distinctive Sounds: The Challenge of Digital Sampling*, 2 J.L. & TECH. 273, 277 (1987).

that is so trivial that the law will not impose any significant consequences, the copying is too trivial to constitute any kind of substantial similarity between the works, or in context with the defense of fair use.[44] Therefore, *de minimis* copying is best viewed as a determination of plaintiff's proof of substantial similarity instead of as a separate defense to copyright infringement.[45]

In *VMG Salsoul*, the *de minimis* defense is implemented to establish that if copying is established, it is such an insignificant amount of copying that no level of substantial similarity can be established between the two works.[46] In other words, the use should be considered *de minimis* because an average audience would be unable to recognize the appropriation.[47] This analysis of the *de minimis* defense hinges on the test for substantial similarity and the need for an ordinary observer to be able to determine whether the use was either innocent copying or a significant misappropriation.[48]

III. VMG SALSOUL, LLC V. CICCONE

A. Factual Background

VMG Salsoul, LLC ("Salsoul")[49] is a New York based record company now owned by Bertelsmann Music Group (BMG).[50] In the early 1980's Shep Pettibone[51] recorded the song

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[44] *Ringgold*, 126 F.3d at 74-75.
[45] *Situation Mgmt. Sys. v. ASP Consulting LLC*, 560 F.3d 53, 59 (1st Cir. 2009).
[46] *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 877 (9th Cir. 2016).
[47] *Diamond*, 388 F.3d at 1193.
[48] *Id.*
[49] Plaintiff in the initial action.
[50] *VMG Salsoul, LLC v. Ciccone*, 2013 U.S. Dist. LEXIS 184127, at *3 (C.D. Cal. Nov. 18, 2013).; Ed Christmas, *BMG Acquires Catalog of Verse Music, Includes Songs of Nina Simone, J. Lo,* BILLBOARD, June 29, 2015, http://www.billboard.com/articles/business/6612981/bmg-acquiresverse-music-nina-simone-j-lo-salsoul-west-end-bethlehem-golden-records

Ooh I Love It ("Love Break") for Salsoul.[52] *Love Break* features a "single" and a "double" horn hit that are at issue in this case.[53] The "single" horn hit is a quarter-note chord comprised of the notes, E-flat, A, D, and F, played in the key of B-flat.[54] The "double" horn hit is an eighth-note chord consisting of the same notes as the "single" horn hit, immediately followed by the same notes played in a quarter-note chord.[55] Both the single and double horn hits were played predominately by trombones and trumpets.[56] During the course of the instrumental version of *Love* Break, which lasts seven minutes and forty-six seconds, the single horn hit is played twenty-seven times and the double horn hit is played twenty-three times.[57] The general pattern of the horn hits in the instrumental version were identified as, "single-double repeated, double-single repeated, single-single-double repeated, and double-single repeated."[58] VMG Salsoul owns both the copyright to the sound recording and to the composition of *Love Break.*[59]

In 1990, Pettibone and Ciccone[60] recorded the hit single *Vogue.*[61] Like in *Love Break*, Ciccone's top 100 dance song also features a "single" and a "double" horn hit.[62] The single horn hit

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[51] One of the defendants.
[52] *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 875 (9th Cir. 2016).
[53] *Id.*
[54] *Id.*
[55] *Id.*
[56] As determined by the plaintiff's experts. *Id.*
[57] *Id.*
[58] *VMG Salsoul*, 824 F.3d at 875.
[59] *Id.*
[60] Defendant Madonna Louise Ciccone is an American singer/songwriter commonly referred to as "Madonna." Famous works by the singer/songwriter include "Like a Virgin," "Crazy for You," "Take a Bow," "Like a Prayer," "Material Girl," "Express Yourself," and the contested song in this case, "Vogue." Keith Caulfield, *Madonna's 40 Biggest Billboard Hits*, BILLBOARD, Aug. 16, 2015, http://www.billboard.com/articles/list/499398/madonnas-40-biggest-billboard-hits.
[61] VMG Salsoul, LLC v. Ciccone, 824 F.3d 871, 875 (9th Cir. 2016).
[62] *Id.*

in *Vogue* is also a quarter-note chord, but it is comprised of the notes E, A-sharp, D-sharp, and F-sharp, played in the key of B-natural.[63] The double horn hit consists of the same notes in an eighth-note chord, immediately followed by a quarter-note chord consisting of all the same notes.[64] It was later determine that the double horn hit was not an independent sample.[65] The single horn hit was sampled and then used to create the double horn hit.[66]

Salsoul asserted that Pettibone sampled material from *Love Break* while creating *Vogue*[67] and therefore infringed its copyrights to the composition and the sound recording of *Love Break*.[68] Specifically, Salsoul focused its assertions on the "radio edit" and "compilation" versions of *Vogue*.[69] During the course of the radio edit version,[70] the single horn hit happens once, the double horn hit happens three times, with a "breakdown" version of the horn hit also occurs once.[71] The pattern of the horn hits in this version is "single-double-double-double-breakdown."[72] In the compilation version,[73] the single horn hit is played once, and the double horn hit is played five times.[74] The recognized pattern of the horn hits in this version is "single-double-double-double-

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[63] *Id.*
[64] *Id.*
[65] *Id.* at 879.
[66] *Id.*
[67] *VMG Salsoul,* 824 F.3d at 875.
[68] On appeal Plaintiff asserted a sole theory of infringement. However, in the initial complaint Plaintiff asserted improper sampling of strings, vocals, congas, "vibraslap," and horns from *Love Break. Id.*
[69] *Id.* at 876.
[70] The radio edit version is four minutes and fifty-three seconds long. *Id.*
[71] No definition of a "breakdown" version of the horn hit is provided in the record. The court deems it to be of minimal significance because neither party asserted any significance to this type of horn hit in their briefings. *Id.*
[72] *Id.*
[73] The compilation version is five minutes and seventeen seconds long. *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 876 (9th Cir. 2016).
[74] *Id.*

double."[75]

On July 18, 2011, and February 16, 2012, Salsoul provided the defendants in this action with notice of Copyright infringement.[76] Salsoul filed a complaint against the defendants on July 11, 2012, after defendants continued to distribute and publicly perform the recording of *Vogue* despite notice of copyright infringement.[77] The complaint alleged that defendants were deliberately using the sound recording and composition copyrights of *Love Break* without authorized permission.[78] Pettibone filed an answer on behalf of all the defendants on September 6, 2012, asserting that plaintiff failed to state a claim.[79] The trial court dismissed the motion,[80] prompting defendants to file motions for summary judgment[81] on May 6, 2013.[82]

B. District Court Decision

In determining whether to grant summary judgment on the issue of copyright infringement the trial court determined that the appropriation plaintiff sought protection against did not warrant

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[75] *Id.*

[76] Defendants include Ciccone, Pettibone, WB Music Corporation, Blue Disque Music Company Inc., WEBO Girl Publishing Inc., and Lexonr Music Inc. *VMG Salsoul, LLC v. Ciccone*, 2013 U.S. Dist. LEXIS 1814127, *8 (C.D. Cal. Nov. 18, 2013).

[77] *VMG Salsoul, LLC v. Ciccone*, 2013 U.S. Dist. LEXIS 1814127 *9

[78] *VMG Salsoul, LLC v. Ciccone*, 2013 U.S. Dist. LEXIS 1814127 *9

[79] Failure to state a claim. FED. R. CIV. P. 12(b)(6). *VMG Salsoul, LLC v. Ciccone*, 2013 U.S. Dist. LEXIS 1814127, at *9 (C.D. Cal. Nov. 18, 2013).

[80] *VMG Salsoul, LLC v. Ciccone*, 2013 U.S. Dist. LEXIS 1814127, at *9 (C.D. Cal. Nov. 18, 2013).

[81] Two separate motions for summary judgment were filed by the defendants on the same day. Together Ciccone, WB Music Corporation, and WEBO Girl Publishing filed one motion while Pettibone and Lexore Music, Inc. filed a separate motion. *VMG Salsoul, LLC v. Ciccone*, 2013 U.S. Dist. LEXIS 1814127, at *9 (C.D. Cal. Nov. 18, 2013).

[82] *VMG Salsoul, LLC v. Ciccone*, 2013 U.S. Dist. LEXIS 1814127, at *9 (C.D. Cal. Nov. 18, 2013).

copyright protection because it lacked originality.[83] The trial court further elaborated that even if the horn hits were eligible for copyright protection, the appropriation by defendants was *de minimis*.[84] In determining the issue of originality of the horn hits, the trial court considered both the copyrightability of the horn hits in the composition as well as the sound recording.[85]

C. *Ninth Circuit Opinion*

On review, the Ninth Circuit found that for purposes of determining summary judgment, plaintiff had presented sufficient evidence the defendants had actually copied *Love Break*.[86] However, the Ninth Circuit used *Newton v. Diamond*[87] as the authority on actual copying, and determined that actual copying is not sufficient to find copyright infringement per se.[88] The court determined that in order for the copying to rise to the level of infringement it must be more than a *de minimis* use.[89] However, the Ninth Circuit's decision in *Newton* only applied the *de minimis* exception to copyrighted compositions.[90] Here, the Ninth Circuit was tasked with determining: (1) whether defendant's alleged

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[83] *VMG Salsoul, LLC v. Ciccone*, 2013 U.S. Dist. LEXIS 1814127, at *16 (C.D. Cal. Nov. 18, 2013).
[84] *VMG Salsoul, LLC v. Ciccone*, 2013 U.S. Dist. LEXIS 1814127, at *16 (C.D. Cal. Nov. 18, 2013).
[85] *VMG Salsoul, LLC v. Ciccone*, 2013 U.S. Dist. LEXIS 1814127, at *20-29 (C.D. Cal. Nov. 18, 2013).
[86] Plaintiff's evidence included a sworn statement from Pettibone's personal assistant, Tony Shimkin, that he heard Pettibone tell a sound engineer to incorporate sounds from *Love Break* into the *Vogue* recording. Additionally, the plaintiff's presented reports from musical experts who had listened to both pieces of music and determined that the horn hits used in *Vogue* had been sampled from *Love Break*. *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 877 (9th Cir. 2016).
[87] 288 F.3d 1189 (9th Cir. 2004).
[88] *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 877 (9th Cir. 2016).
[89] *Id.*
[90] *Newton v. Diamond*, 288 F.3d 1189, 1193 (9th Cir. 2004).

copying of plaintiff's musical composition for *Love Break* was *de minimis*, (2) whether the *de minimis* exception can apply in cases of alleged infringement of copyrighted sound recordings, and (3) whether it was an abuse of the district court's discretion to award attorney's fees to defendants.[91]

i. Application of the De Minimis *Exception*

In order to determine whether the defendants in *VMG Salsoul* had infringed the composition copyright of *Love Break*, the Ninth Circuit could only compare the written compositions.[92] Stylistic elements of the musician's performance of the composition were excluded from consideration.[93] When the Ninth Circuit compared the structure of the two musical compositions it determined the defendants had copied two specific excerpts of the horn portion of *Love Break*'s musical composition.[94] The first copied portion was a single quarter-note horn hit,[95] and the second copied passage was a full measure that consisted only of rests and the double horn hit.[96] The court proceeded by distinguishing *VMG Salsoul* from *Newton v. Diamond*[97] before determining that defendant's use in this case was *de minimis*.[98] In *VMG Salsoul*, the sampled portion was much smaller than the sampled portion that was contested in *Newton*.[99] The sampled horn hits used in *Vogue* appear only five or six times and the single horn hit only lasted a quarter of a second while the double horn hit measure, including the rests, lasted less than a second.[100] Additionally, the

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[91] *VMG Salsoul*, 824 F.3d at 878.
[92] *Id.*
[93] *Id.*
[94] *Id.*
[95] *Id.*
[96] *Id.* at 878-79.
[97] 288 F.3d 1189 (9th Cir. 2004).
[98] *VMG Salsoul*, 824 F.3d at 879.
[99] *Id.*
[100] *Id.*

Ninth Circuit found the defendants only sampled one instrument from the *Love Break* musical composition and not the entire composition.[101] Therefore, based on the above considerations, the Ninth Circuit ultimately held that a reasonable jury would not be able to conclude that "an average audience would recognize the appropriation of the composition."[102]

Moving to the analysis of whether the defendants infringed the copyrighted sound recording of *Love Break*, the Ninth Circuit shifted focus from the actual notes that were being played to how the musicians played the notes.[103] Relying on plaintiff's expert testimony[104] the appellate court found the defendant, Pettibone, had copied a single quarter-note of a four-note chord, isolated the sound of the horns, transposed the horn hit into a new key before truncating the recording and then adding effects.[105] Before inserting the horn hit into *Vogue*, Pettibone overlaid the altered horn hit with sounds from additional instruments.[106] Due to the identifiable alterations of the horn hit by Pettibone, the Ninth Circuit found the horn hits used in *Vogue* did not sound identical to the horn hits from *Love Break.*[107] Additionally, because the horn hits do not sound the same they are easy to miss when listening to *Vogue* if the listener is not playing close attention.[108] Thus, the Ninth Circuit concluded that "a reasonable juror could not conclude that an average audience would recognize the appropriation of the horn hit."[109]

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[101] *Id.*
[102] *Id.*
[103] *Id.*
[104] "The chord 'was modified by transposing it upward, cleaning up the attack slightly in order to make it punchier [by truncating the horn hit] and overlaying it with other sounds and effects. On such effect mimicked the reverse cymbal crash. . . . The reverb/delay 'tail' . . . was prolonged and heightened." *VMG Salsoul*, 824 F.3d at 879.
[105] *Id.* at 879-80.
[106] *Id.* at 880.
[107] *Id.*
[108] *Id.*
[109] *Id.*

The Ninth Circuit's final consideration in reaching the determination that a reasonable juror could not conclude that an average audience would recognize the horn hit appropriation came from the fact that plaintiff's own expert, a highly trained musician, initially mistook *Vogue* to have misappropriated two horn hits instead of just the one horn hit.[110] The Court reasoned that if a musical expert set out with the intent of determining which portions of the song had been misappropriated could not discern the portions of the song that had been copied, then it is unreasonable to expect that an average audience member would be able to discern the copying.[111] Therefore, the Ninth Circuit affirmed the district court's grant of summary judgment for the defendants finding the defendant's appropriation of *Love Break* was *de minimis*.[112]

ii. The De Minimis *Exception and Sound Recordings*

The primary issue that the Ninth Circuit faced in *VMG Salsoul* was the question of whether the *de minimis* use exception applies to copyrighted sound recordings, as it does to all other copyrighted materials.[113] The Ninth Circuit ultimately held that the legislative history of the Copyright Act of 1976 and Congress' legislative history in enacting the statute established that Congress intended for the *de minimis* exception to apply to copyrighted sound recordings.[114] The holding in *VMG Salsoul* has created a circuit split with the Sixth Circuit. In *Bridgeport Music, Inc. v. Dimension Films,*[115] the Sixth Circuit held that sampling of copyrighted sound recordings is per se infringement and that Congress did not intend for the *de minimis* exception to apply to

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[110] *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 880 (9th Cir. 2016).
[111] *Id.*
[112] *Id.*
[113] *Id.* at 883.
[114] *Id.* at 884.
[115] 410 F.3d 792 (6th Cir. 2005).

copyrighted sound recordings.[116]

Before coming to a differing conclusion with the Sixth Circuit, the Ninth Circuit first analyzed the statutory text of Sections 101,[117] 102,[118] and 106,[119] of the Copyright Act of 1976. The Ninth Circuit found nothing in the wording of these statutory sections to suggest that Congress had intended to provide differential treatment to the copyrights of sound recordings.[120] Furthermore, the Ninth Circuit held that Congress had not intended to eliminate the ability of individuals to take advantage of *de minimis* copying with regard to sound recordings.[121] Plaintiff asserts a statutory argument, similar to the Sixth Circuit's finding, that Congress intended to eliminate the *de minimis* exception with regards to copyrighted sound recordings.[122] This assertion is founded on the third sentence of § 114(b) of the Copyright Act of 1976.[123] This section states:

> The exclusive rights of the owner of copyright in a sound recording under

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[116] *VMG Salsoul*, 824 F.3d at 886.

[117] "Sound recordings" are works that result from the fixation of a series of musical, spoke, or other sounds, but not including the sounds accompanying a motion picture or other audiovisual work, regardless of the nature of the material objects, such as disks, tapes, or other phonorecords, in which they are embodied.
The Copyright Act of 1976, 17 U.S.C. § 101 (1978).

[118] Subject matter of copyright: In general
(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, no known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories: (6) sound recordings. . . .
The Copyright Act of 1976, 17 U.S.C. § 102(a)(6) (1978).

[119] *See supra* note 16.

[120] *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 882 (9th Cir. 2016).

[121] *Id.*

[122] *Id.* at 881.

[123] *Id.* at 881-82.

> clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording.[124]

However, the Ninth Circuit was not persuaded by the plaintiff's, and the Sixth Circuit's, argument that § 114(b) is to be read as granting copyright owners of sound recordings the exclusive right to "sample" their own musical recordings.[125] Conversely, the Ninth Circuit understood this section of the Copyright Act to limit the rights of sound recording copyright holders.[126] In the view of the Ninth Circuit, § 114(b) of the Copyright Act restricts copyright holders from asserting infringement claims against musicians who mimic the copyrighted material, even if the sound is identical, because it is not actual copying.[127] Therefore, in the opinion of the Ninth Circuit, § 114(b) does not address the issue of whether Congress intended to eliminate the *de minimis* copying with regard to copyrighted sound recordings.[128]

After analyzing the statutory text of the Copyright Act, the Ninth Circuit next looked to the legislative history of the statute to determine that Congress intended for § 114(b) of the Copyright Act[129] to limit, not expand, copyright holder's rights.[130] Specifically, the Ninth Circuit's findings were supported by a

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[124] The Copyright Act of 1976, 17 U.S.C. § 114(b) (1978).
[125] *VMG Salsoul*, 824 F.3d at 884.
[126] *Id.* at 883.
[127] *Id.*
[128] *Id.*
[129] The Copyright Act of 1976, 17 U.S.C. §114 (1978).
[130] *VMG Salsoul*, 824 F.3d at 883.

House Report[131] which stated, "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 by repressing, transcribing, recapturing off the air, or any other method, or by reproducing them in the soundtrack or audio portion of a motion picture or other audiovisual work."[132] The support provided by the legislative history and statutory text of the Copyright Act concretized the Ninth Circuit's conclusion that Congress intended the *de minimis* exception to apply to copyrighted sound recordings the same way *de minimis* copying applies to any other copyrighted work.[133]

iii. Attorney's Fees

The Ninth Circuit vacated the district court's award of attorney's fees to the defendants.[134] The district court had reasoned that plaintiff's claim was objectively unreasonable because plaintiff should have known that the *Bridgeport*[135] decision was controversial and because the claim dealt with issues that relied on "disputed facts and credibility determinations."[136] The Ninth Circuit found that the district court erred as a matter of law and remanded the issue of attorney's fees to the district court for reconsideration.[137]

IV. ANALYSIS

Circuit splits create uncertainty and ambiguity in the law that

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[131] H.R. REP. NO. 94-1476, at 61 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5674.
[132] *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 883 (9th Cir. 2016) (emphasis added).
[133] *Id.* at 883-84.
[134] *Id.* at 887.
[135] *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792 (6th Cir. 2005).
[136] *VMG Salsoul*, 824 F.3d at 877.
[137] *Id.*

can only be resolved by the United States Supreme Court. However, there is no guarantee that the Supreme Court will grant *certiorari*, so circuit courts should be cautious when establishing device precedent.[138] In this particular case, the Ninth Circuit was right to split from the decision of the Sixth Circuit. As the Ninth Circuit observed, a deep split already exists among the federal courts regarding the issue of whether or not to apply the *de minimis* use exception to copyrighted sound recordings.[139] A multitude of courts not bound by the Sixth Circuit's precedent in *Bridgeport* have continuously rejected the idea of following *Bridgeport's* per se infringement analysis.[140]

A. VMG Salsoul v. Bridgeport: Statutory Interpretation

The Ninth Circuit's decision to diverge from the Sixth Circuit's holding is not arbitrary. Before concluding that the *de minimis* exception should apply to alleged infringement of copyrighted sound recordings, the Court first took into consideration the Sixth Circuit's analysis in *Bridgeport Music, Inc. v. Dimension Films*.[141] In *Bridgeport*, the Sixth Circuit found that by adding the word "entirely" to Section 114(b)[142] of the Copyright Act, Congress granted sound recording owners the exclusive right to "sample" their own recordings.[143] In analyzing this conclusion, the Ninth Circuit determined that the Sixth Circuit

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[138] Deborah Beim & Kelly Rader, EVOLUTION OF CONFLICT IN THE FEDERAL CIRCUIT COURTS, 3

[139] *Id.*

[140] *Id.*

[141] 410 F.3d 792 (6th Cir. 2005); *Id.* at 883.

[142] "The rights of sound recording copyright holders under clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists *entirely* of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording." *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 800-01 (6th Cir. 2005) (emphasis in original).

[143] *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 884 (9th Cir. 2016).

ignored the statutory structure and legislative history of the statute which clearly indicated Congress was expressly attempting to limit the rights of Copyright owners through § 114, not expand their rights.[144]

Additionally, the Ninth Circuit addressed the inverse logic raised in *Bridgeport*. In *Bridgeport* the Sixth Circuit found that if exclusive rights "*do not extend* to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds,"[145] then exclusive rights "*do extend* to the making of another sound recording that does not consist entirely of an independent fixation of other sounds."[146] As the Ninth Circuit emphasizes in its opinion,[147] this thought process is illogical. This inference creates rights for copyright owners from a statute that was clearly set up by Congress to limit the exclusive rights of copyright holders.[148]

B. Sampling as a Physical Taking

Finally, the Ninth Circuit also addressed the Sixth Circuit's contention that because "sampling" is equivalent to a physical taking, then the *de minimis* use exception should therefore not apply.[149] First, the Ninth Circuit points out that physical takings can occur with other forms of copyrightable material but that has not prompted Congress to eliminate the *de minimis* exception from

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[144] *Id.*
[145] The Copyright Act of 1976m 17 U.S.C. § 114(b) (emphasis added).
[146] *VMG Salsoul*, 824 F.3d at 884 (emphasis added).
[147] *Id.*
[148] "The text itself is silent as to the rights of a copyright owner of a sound recording when it comes to works that are *not* entirely independently fixed, including where the work makes de minimis uses, as the use in *Bridgeport* arguably is." Leah Somoano, *Bridgeport Music, inc. v. Dimension Films: Has Unlicensed Digital Sampling of Copyrighted Sound Recordings Come to an End?*, 21 BERKELEY TECH. L.J. 289, 303 (2006).
[149] *Bridgeport*, 410 F.3d at 801-02.

being applied to such copyrighted works.[150] For example, the Second Circuit has previously held that the physical taking of copyrighted photographs for placement in a movie, without the owner's permission, was *de minimis* and didn't warrant further action.[151]

Second, plaintiffs argue that sound recordings are of such a different nature than other copyrightable works that it would make sense for Congress to treat them differently with regards to infringement.[152] However, simply because they are of a "different nature" does not mean that Congress has chosen to adopt a different rule to handle infringement in such cases.[153] All copyrights should be presumed to be treated equally unless otherwise stated, regardless of their "nature."

Lastly, copyright law's main purpose is to protect the expressive elements of an individual's copyrighted work not the economic rewards for that expression.[154] Therefore, without the monetary consideration of the taking, all that remains is the concept that the secondary user has taken expressive elements of the primary user's work.[155] However, that is the case for all types of copyright infringement;[156] the secondary user is appropriating the expressive elements of the primary user without their permission. Nothing about the "physical takings" argument with regards to sound recordings distinguishes this category of copyright from the other type of copyrighted material. Therefore, the Ninth Circuit was correct to find that the *de minimis* excuse should apply to sound recordings the same as it would to any other allegedly infringed copyrighted work.[157]

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[150] *VMG Salsoul*, 824 F.3d at 885.
[151] *See Sandoval v. New Line Cinema Corp.*, 147 F.3d 215, 215-16 (2d Cir. 1998).
[152] *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 885 (9th Cir. 2016).
[153] *Id.*
[154] *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991).
[155] *VMG Salsoul*, 824 F.3d at 885.
[156] *See* Somoano, *supra* note 149 at 303.
[157] *VMG Salsoul,* 824 F.3d at 884.

C. *Bridgeport's Bright-Line Rule*

The *Bridgeport* decision created a bright-line rule that states, "[g]et a license or do not sample."[158] While this rule does not foreclose sampling entirely, it does stifle creativity.[159] The alternatives to sampling provided by the Sixth Circuit are to obtain a license or to duplicate the sound without using the original recording.[160] However, the Sixth Circuit is presuming that sampling and duplicating a sound are equivalent.[161] What the court does not address is that sampling is an artistic choice and by prohibiting samples, per se, they are suppressing artistic expression. The federal courts have a history of avoiding passing judgment on artistic value,[162] but by instilling a per se infringement rule for all *de minimis* samples, the Sixth Circuit is ultimately judging artistic expression and creating a monopoly for copyright holders of sound recordings. By discouraging *de minimis* copying the Sixth Circuit is allowing copyright notice to signal not only that a work is protected, but that any kind of reproduction without a license is prohibited.[163]

The Sixth Circuit's bright-line rule in *Bridgeport*[164] goes against the intentions of Congress and ultimately serves no productive purpose other than to stifle creativity.[165] Copyright law

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[158] *Bridgeport*, 410 F.3d at 801.
[159] Olufunmilayo B. Arewa, *From J.C. Bach to Hip Hop: Musical Borrowing, Copyright and Cultural Context*, 84 N.C.L. REV. 547, 575 (2006).
[160] *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 801 (6th Cir. 2005).
[161] *See* Arewa, *supra* note 160.
[162] *Bleisteing v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).
[163] Jason Mazzone, *Copyfraud*, 81 N.Y.U.L. Rev. 1026, 1052 (2006).
[164] 410 F.3d 792 (6th Cir. 2005).
[165] Eriq Gardner, *Madonna Gets Victory Over 'Vogue' Sample at Appeals Court,* HOLLYWOOD REPORTER, June 2, 2016, http://www.hollywoodreporter.com/thr-esq/madonna-gets-victory-vogue-sample-898944.; Colin Stutz, *Justin Bieber & Skillrex Sued Over 'Sorry': Report*, BILLBOARD, May 26, 2016, http://www.billboard.com/articles/columns/pop/7385928/justin-bieber-skrillex-

exists to "promote the progress of useful arts,"[166] but by misconstruing the statutory text of the Copyright Act and eliminating the use of *de minimis* copying with regard to sound recordings, the Sixth Circuit failed to promote the progress of useful arts. Fortunately, after a decade of stifled creativity, the Ninth Circuit is finally protecting artists and allowing musicians to invoke the *de minimis* defense with regards to sound recordings. In the eleven years since *Bridgeport* was decided, numerous artist have had suits brought against them for unlicensed sampling in the Sixth Circuit.[167] However, now the Ninth Circuit will likely provide a safe harbor for artist who sample minute portions of songs without a license.[168] Unfortunately, if that is the case, it is likely that more musicians will flock to the Ninth Circuit to work on projects in order to ensure their ability to bring a *de minimis* use defense if litigation ensues.

D. Future Implications

De minimis use is important to the copyright realm because it allows copyright owners to protect the elements of their works that need to be protected.[169] If the courts continue to allow copyright holder to maintain a monopoly over even the most minute elements of their work, there will eventually come a time when there is nothing left for new artists to draw inspiration from. "In other words, enforcing copyright for *de minimis* sampling is like requiring a painter to obtain a license for the canvas upon which he paints. The sample is simply used as the starting point for creative

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sued-sorry-white-hinterland-dance (The suit against Justin Bieber was brought in the Sixth Circuit.)

[166] U.S. CONST. art. I, Article I, § 8, cl. 8.

[167] Althea Legaspi, *Madonna Wins 'Vogue' Lawsuit in Appeals Court,* ROLLING STONE, June 2, 2016, http://www.rollingstone.com/music/news/madonna-wins-vogue-lawsuit-in-appeals-court-20160602.

[168] *See* Legaspi *supra* note 168.

[169] *Ringgold v. Black Entertainment Television, Inc.*, 126 F.3d 70, 74 (2d Cir. 1997).

work; although it provides an important foundation for the work, it is not identifiable with the final product and the creativity of the work stands on its own."[170] If the appropriation is so minute that the average lay listener is unable to discern that there has been an appropriation, then the copier has not actually benefited from the original artist's expressive content.[171] However, it is unlikely that the Supreme Court will let the circuits remain split on this issue forever. Due to the uncertainties that a circuit split creates, it is likely that the Supreme Court will grant *certiorari* on this issue in due time.

V. CONCLUSION

In conclusion, it is important for artists to be able to draw inspiration from one another in order to further advance and progress musical art in our culture. It was clearly erroneous for the Sixth Circuit to have held that applying the *de minimis* use exception to sound recordings interferes with meaningful copyright ownership of sound recordings. The Ninth Circuit's thoughtful consideration of the statutory text and legislative intent in *VMG Salsoul*[172] provides a more logical approach to applying copyright law to various mediums. While the consistency that accompanies a bright-line rule always seems tempting, the per se infringement rule laid out by the Sixth Circuit causes further confusion. By attempting to carve out an exception to the application of *de minimis* use, the Sixth Circuit established an inconsistent standard that cannot be supported by copyright law. The Sixth Circuit's approach creates ambiguity in the music industry and ultimately frustrates creative expression.

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[170] John Schietinger, *Bridgeport Music, Inc. v. Dimension Films: How the Sixth Circuit Missed a Beat on Digital Music Sampling*, 55 DePaul L. Rev. 209, 234 (2005).
[171] *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 882 (9th Cir. 2016).
[172] *Id.* at 871.

Fortunately, the Ninth Circuit's decision in *VMG Salsoul*[173] provides a great service to the music industry. The Ninth Circuit sets a standard for *de minimis* use that comports with copyright law. Additionally, this holding has firmly established a deep divide between the circuits on an issue that is highly controversial in the music industry. As a result, the ambiguity that is created from this divisive circuit split will ultimately bring clarity to the application of *de minimis* use. A circuit split this disruptive will require action by the Supreme Court in order to finally determine the applicability of *de minimis* copying in regards to sound recordings. Therefore, while circuit splits can cause uncertainty in the law, federal circuit courts should not let the fear of creating conflict impede their duty to properly interpret congressional intent.[174] The Ninth Circuit did not allow conflict to prevent them for exercising their judicial duty, and as a result the music industry will be better served because of it.

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[173] *Id.*
[174] *Id.* at 886.

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