Newton v. Diamond: Measuring the Legitimacy of Unauthorized Compositional Sampling—A Clue Illuminated and Obscured

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by

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* LL.M. in Intellectual Property, Benjamin N. Cardozo School of Law, expected June 2004; J.D., Florida State University College of Law, May 2003. The author expresses her gratitude to Prof. Justin Hughes of the Benjamin N. Cardozo School of Law, Prof. Frederick Abbott of Florida State University College of Law, Mr. Alvin Deutsch, Esq. of McLaughlin & Stern, LLP, and Mr. Robert McNeely, Esq. for the knowledge, guidance, and insight each generously shared through their teaching and consultations.
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I. Introduction

It seems to be a widely accepted truism that the wealth of creative works amassed throughout our cultural history serves as a foundation for each generation of new works. For most of our copyright history, and despite the occasional overreaching by some authors of new works, this truism was fairly palatable to most because it expressed the norms of subtle inspiration and creative transformation rather than wholesale lifting of original creative expression. However, with the emergence of the musical genre called “hip-hop,” a new generation of authors elevated this foundational concept from a subtle truism to a conspicuous mantra through the practice of unlicensed digital sampling. And suddenly, many within the music industry and judicial branch found this modern incarnation of a previously palatable truism hard to swallow.

This article will discuss the ramifications of that sudden distaste and the current outlook for the future of digital sampling. Part Two will begin the discussion with a brief history of digital sampling and its initial legal challenge. Part Three will lay out the statutory framework underlying musical works as a necessary precursor to an understanding of the rights involved. Part Four will then delve into a thorough examination of the district court opinion in *Newton v. Diamond* (Newton I), which had the potential to cleanse palates and help delineate where the buffet line for unlicensed samples may begin. Thereafter, part Five will review the subsequent Ninth Circuit opinion in *Newton v. Diamond* (Newton II). Part Six will compare the *Newton I* and *II* decisions and evaluate the current state of *de minimis* use analysis. Finally, part Seven will conclude this article with a discussion of the implications the *Newton v. Diamond* decisions have for the future practice of digital sampling.

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5. *Newton v. Diamond*, 349 F.3d 591 (9th Cir. 2003).
II. A Brief History

A. What is Digital Sampling, How Did it Start, and Why is it Done?

Digital sampling is the electronic extraction of a portion of an existing musical work and its subsequent insertion into a new sound recording, while its corollary, looping, is the repetitive re-playing of the sample within the new work. The roots of hip-hop music and the practice of digital sampling have been attributed to the innovation occurring among disc jockeys (D.J.s) or “selectors” on the island of Jamaica between the late 1950s and 1960s. The innovation began as a bold change from simply announcing selections in between the music to “talking-over” the records as they played in a chant-like manner that blended Black American slang with the distinctive West Indian dialect of Patois. As the practice became popular with live audiences, D.J.s competed for the respect of fledgling fan bases and many began commissioning Jamaican-styled instrumentals that mimicked American “soul” hits. The D.J.s were no longer inconspicuously serving up music from the background; they had become part of a blended musical performance and their “talk-overs” were just as great of a draw as the music itself.

In 1974, a transplanted Jamaican D.J. named Clive Campbell, a.k.a. “Kool Herc,” introduced the “talk-over” technique in New York and adapted it to the “break dancing” movement rising from the clubs of the South Bronx. As dancers displayed their dexterity and flexibility on the dance floor, “Kool Herc” exhibited his dexterity and flexibility on the turntable by isolating and manipulating the crucial instrumental breakdowns of various funk records. And, just

9. Self, supra note 2, at 348.
10. Id.
11. Id. at 349.
12. Id. at 349-50.
13. Id.
as had occurred in Jamaica, imitation and innovation among D.J.s catapulted the genre to widespread popularity.\textsuperscript{14}

Sampling became digital and ubiquitous in the mid-1980s with the commercial availability of the musical instrumental digital interface (MIDI) device.\textsuperscript{15} This electronic device allowed hip-hop producers to easily recreate in the studio what the D.J.s had been doing by extreme manual dexterity in the clubs.\textsuperscript{16} Consequently, the hip-hop artist was able to gain the use of a distinctive sound with little expenditure of physical or financial capital and take advantage of any public appeal the sampled sound had already garnered.\textsuperscript{17}

B. \textit{Grand Upright Music Ltd. v. Warner Bros. Records, Inc.}:\textsuperscript{18} An End to the Feast

In the nascent stages of sampling, as artists were feeding off samples of the distinctive sounds of prior works, the prevalent attitude was “catch me if you can” and many hip-hop recordings were being released without any attempt to license either the sound recording or the musical composition from which the sample was derived.\textsuperscript{19} However, in the same district where the practice began, the digital gluttony transpiring in hip-hop was brought to an end in 1991 via the terse opinion by District Judge Kevin Thomas Duffy in \textit{Grand Upright Music Ltd. v. Warner Bros. Records, Inc.},\textsuperscript{20} the first case to confront unlicensed digital sampling.

In \textit{Grand Upright Music}, the rap artist Biz Markie sampled three words and a short keyboard riff from the Gilbert O’Sullivan composition and recording of “Alone Again (Naturally).” However, the opinion neither addressed the protectability of these elements nor the substantial similarity of defendant’s use of them.\textsuperscript{21} Instead, the court began and ended its analysis with the first prong of an infringement claim: ownership of the copyrighted work.\textsuperscript{22} Further, by opening its opinion with the biblical admonishment “thou shalt not

\textsuperscript{14} See id.
\textsuperscript{15} Warshavsky & Berger, \textit{supra} note 6; Kaplicer, \textit{supra} note 2, at 228.
\textsuperscript{16} See Self, \textit{supra} note 2, at 350.
\textsuperscript{17} Kaplicer, \textit{supra} note 2, at 228.
\textsuperscript{19} Passman, \textit{supra} note 2, at 306-307; see Warshavsky & Berger, \textit{supra} note 6.
\textsuperscript{22} \textit{Grand Upright Music Ltd.}, 780 F. Supp. at 183.
steal and closing it with a referral of the matter to the U.S. Attorney for consideration of criminal charges (noting the defendants’ “callous disregard for the law”), the court struck fear into the music industry and left behind the impression of a per se bar to unlicensed digital sampling. Consequently, the pendulum swung in the direction of extreme caution, or paranoia, and the licensing of digital samples skyrocketed.

Since *Grand Upright Music*, two phenomena have coalesced to keep the pendulum stuck on the side of extreme caution. First, most sampling cases continue to be disposed of via settlements between the parties. Second, despite an evolution of the legal reasoning employed in digital sampling cases to include the more sophisticated analyses common among other subjects of civil copyright infringement actions, the courts have not elucidated guideposts for lawful digital sampling. Consequently, digital sampling has been trapped in a discordant culture of social popularity and legal uncertainty from which artists and record companies have had only two unsatisfactory means of egress: one, the path of improvidence—doling out steady streams of preventative payments; the other, the path of imprudence—daring the copyright holders of sampled works to “catch me if you can.” What has been missing and sorely needed is a third path, a path of reasonable determination—via which the risk of infringement may be reasonably estimated and prudent (rather than paranoid or careless) decisions regarding the need for a sample license may be made. In 2002, District Judge Nora M. Manella of the Central District of California may have finally blazed that trail in *Newton v. Diamond (Newton I)*.

### III. Statutory Framework: Two Separate Copyrighted Works

Before delving into *Newton I*, it is important to understand the statutory framework underlying musical works. For every embodiment of a musical work in a phonorecord since February 15, 1972, there are two copyrights involved: one protecting the...

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23. *Id.*
24. *Id.* at 185.
27. Soocher, *supra* note 21, at 18.
28. *Id.* at 18-19. The judicial tools employed by courts in the analysis of digital sampling cases may have matured. However, a premise of this article is that despite the use of these tools of legal reasoning, the courts have not yet applied those tools in a manner that clearly delineates boundaries for lawful digital sampling.
composition, and the other protecting the sound recording. Notably, it is generally accepted that nothing in the law requires the copyright owner of either to allow others to use a digital sample of his or her work. Section 114(b) of the Copyright Act precludes such a requirement for sound recordings and Section 115(a)(2) excludes it from the requirement for musical compositions.

First, by clarifying the rights of a sound recording copyright owner in regard to derivative works, Section 114(b) makes it clear that the digital sampling of a copyrighted sound recording must typically be licensed to avoid an infringement. Section 114(b) states that:

The exclusive right of the owner of copyright in a sound recording under [the Section 106 right to prepare derivative works] is limited to the right to prepare a derivative work in which the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality.

The import of this language is that it does not matter how much a digital sampler alters the actual sounds or whether the ordinary lay observer can or cannot recognize the song or the artist’s performance of it. Since the exclusive right encompasses rearranging, remixing, or otherwise altering the actual sounds, the statute by its own terms precludes the use of a substantial similarity test. Thus, the defenses available to a defendant are significantly limited.

Second, the compulsory mechanical license provisions of Section 115 do not provide for the compulsory licensing of digital samples. Specifically, Section 115(a)(2) states that:

A compulsory license includes the privilege of making a musical arrangement of the work to the extent necessary to conform it to the style or manner of interpretation of the performance involved, but the arrangement shall not change the basic melody or fundamental character of the work, and shall not be subject to

30. See PASSMAN, supra note 2, at 307.
32. Id. at § 114(b) (emphasis added).
34. Forensic proof will likely be adequate for “unrecognizable” uses. See id.
35. There may be the possibility of a de minimis use defense, depending on how strictly the court interprets the “actual sounds” language in the statute. However, a fair use defense also seems to be limited by § 114(b) to use within noncommercially distributed educational television and radio programming. See id.
This language dictates that those seeking to benefit from the compulsory licensing of a copyrighted composition for the manufacture and distribution of phonorecords must abide by three parameters. They must: (1) use the entire work; (2) not alter the basic melody or fundamental character of the work in the new performance; and (3) not seek copyright protection for the derivative work without the express permission of the composition’s copyright owner. By nature, however, digital sampling will generally run afoul of all three parameters by: (a) extracting only select elements of work rather than using the work as a whole; (b) altering the fundamental character of the work by rearranging and looping those select elements (often combining them with still more samples from other works) into an entirely new work possessing an entirely different meaning or significance; and finally, (c) making derivative use of the extracted elements within a new composition and sound recording for which copyright protection is sought without express permission from the copyright holder.

Notably, in contrast to the sound recording copyright owner’s right to prepare derivative works, there has been no tailoring of the derivative works right available to the copyright owner of a musical composition to expressly preclude second-comers from rearranging, remixing, or otherwise altering the composition. Sound recordings are different animals. While their copyright owners generally have fewer exclusive rights than copyright owners of other subject matter—such as musical compositions—when it comes to digital sampling, the sound recording copyright operates more resolutely. Consequently, this distinction between sound recordings and musical compositions places the centrifugal force of the legal uncertainty surrounding digital sampling squarely within the copyright in the musical composition.

37. For example, the composer of a religious spiritual may argue that recording a techno dance version of his or her song violates Section 115(a)(2) by altering the song’s fundamental character. Justin Hughes, Copyright Lecture Notes (Oct. 15, 2003).
IV. Newton v. Diamond: The District Court Illuminates a Clue

A. The Facts and Claims

The copyrighted work at the center of the Newton v. Diamond digital sampling controversy is a composition for flute and voice entitled “Choir.” The work was composed and registered with the United States Copyright Office in 1978 by James W. Newton, a composer and accomplished flutist. However, in 1981, Mr. Newton recorded his performance of “Choir” and licensed all his rights in the sound recording to ECM Records for the sum of $5,000. Thus, ECM Records became the copyright owner of the sound recording of “Choir.”

In February of 1992, while preparing their album “Check Your Head,” a hip-hop group called the Beastie Boys paid ECM Records a flat, one-time fee of $1,000 in exchange for an irrevocable sample license. The license granted the Beastie Boys the nonexclusive right to use portions of the “Choir” sound recording in all versions of their song “Pass the Mic.” Thus, pursuant to this license, the Beastie Boys digitally sampled and looped the opening six seconds of the “Choir” sound recording, so that it actually appears over forty times throughout various renditions of “Pass the Mic.” The Beastie Boys, however, did not obtain a license from Mr. Newton.

The sampled six-seconds of the approximately four-and-a-half-minute “Choir” sound recording consists of a three-note sequence whereby Mr. Newton fingers a C-note while simultaneously singing into the flute a C, vocally ascending to a D-flat, then descending back to a C. This particular sequence appears only once in the musical composition. Notably, the only elaboration of the musical score for this sequence are the notations “senza misura” (without measure) and “largo” (slowly), along with the footnote: “This piece requires singing into the flute [and] fingering simultaneously.”

Mr. Newton alleged that the Beastie Boys were legally obligated to obtain a separate license from him for their derivative use of his musical composition. Thus, because of their failure to do so, Mr. Newton asserted four separate claims against the Beastie Boys: (1) copyright infringement; (2) international copyright infringement; (3) reverse passing off; and (4) misappropriation of identity. Although the third and fourth claims were dismissed, the claims for copyright

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38. A copy of the musical score for the sampled sequence has been included in the Appendix, infra.
infringement survived and became the focus of this opinion on the parties’ cross-motions for summary judgment.

In defense of the action, the Beastie Boys argued that the sample was not protectable as a matter of law and that, even if it was protectable, their use of it was merely *de minimis* and, thus, not actionable. Further, they argued that since the domestic copyright infringement claim could not be proved, the international claim must also fail. Finally, they asserted that since there is a three-year statute of limitations per 17 U.S.C. § 507(b), any damages would be limited to only those accruing after April 9, 1998—the date three years prior to the filing of Mr. Newton’s claim.

B. The Judgment and Analyses

So, were the Beastie Boys obligated to obtain a separate sample license from the copyright owner of the musical composition “Choir”? The court did not believe so and granted the Beastie Boys’ motion for summary judgment while denying Mr. Newton’s.  

Since Mr. Newton was not the owner of the sound recording and the Beastie Boys had properly licensed the sound recording, the court’s decision depended upon the resolution of two key issues underlying Mr. Newton’s general allegation. First, whether the three-note sequence as embodied in the musical composition, absent the distinctive sound elements created by Mr. Newton’s performance techniques, is protectable under copyright law. Second, if the composed sequence is protectable by copyright, whether the Beastie Boys’ unauthorized use of it infringed Mr. Newton’s exclusive rights in the composition.

1. Protectability of the Portion Sampled

a. Analytic Dissection

As a fundamental matter, the district court held that the portion of the musical composition sampled by the Beastie Boys is not protectable as a matter of law. To arrive at this finding, the court began with an analytic dissection of “Choir” to filter out the elements

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40. *Id.* at 1249.
41. *Id.* at 1256.
42. To aid the reader in more clearly following the district court’s analysis of the sample’s eligibility for protection, a flow chart of the court’s analysis is presented in Diagrams #2 and #3 in the Appendix, *infra.*
43. Newton, 204 F. Supp. 2d at 1253, 1256.
that are unique to the sound recording and determine the scope of protection available to the musical composition.\textsuperscript{44} The court noted that a musical composition consists of rhythm, harmony, and melody expressed in written form.\textsuperscript{45} Thus, to the extent those compositional elements are elaborated within the score, the sounds that would necessarily result from anyone’s performance of them are protected.\textsuperscript{46} In other words, the generic performance of the written composition is protected. However, to the extent a performer further elaborates upon the musical composition during his recorded performance, those unique elements of the sound recording are beyond the scope of protection for the composition and must be filtered out of the court’s analysis.\textsuperscript{47}

Here, the sampled sequence consists of a musical technique called “vocalization.”\textsuperscript{48} However, unfortunately for Mr. Newton, his experts focused so intently upon convincing the court of the uniqueness of Mr. Newton’s mastery of this technique that they failed to appreciate the distinction between the composition and the sound recording.\textsuperscript{49} The plaintiff’s experts testified that Mr. Newton’s unique approach to vocalization—dubbed the “Newton Technique”—uses a combination of refined breath control and overblowing to produce multiple pitches or “multiphonics.” However, none of the characteristics that the plaintiff’s experts explained as comprising the Newton Technique were written into the musical score. Consequently, those specific techniques, unique as they may be, are protected only by the copyright in the sound recording—not the copyright in the musical composition.\textsuperscript{50}

b. Originality

Despite the plaintiff’s argument to the contrary, the court affirmed that the presumption that attaches to a work upon federal registration is one of validity of the copyright, not of the originality of all its individual elements.\textsuperscript{51} Instead, the originality of a work’s individual elements is a matter of law to be decided by the judge.\textsuperscript{52} In

\begin{itemize}
\item \textsuperscript{44} Id. at 1249-52.
\item \textsuperscript{45} Id. at 1249.
\item \textsuperscript{46} Id.
\item \textsuperscript{47} See id. at 1251.
\item \textsuperscript{48} Newton, 204 F. Supp. 2d at 1250.
\item \textsuperscript{49} Id. at 1250-52.
\item \textsuperscript{50} Id. at 1251.
\item \textsuperscript{51} Id. at 1252.
\item \textsuperscript{52} Id. at 1253.
\end{itemize}
making that determination, the court stated it must be cognizant of the limited amount of raw material (notes and chords) available to composers and the consequent recurrence of common themes among various compositions, especially in popular music.\footnote{\textsuperscript{53}} Keeping this in mind, the district court’s analysis explained the divide between common and original compositional elements.

The court revealed two basic routes to a finding of commonality, or an absence of non-trivial creative contribution. First, the court highlighted a line of cases in which the copied portion of the composition consisted of three notes or less.\footnote{\textsuperscript{54}} Along this route, the court found the facts of Jean v. Bug Music, Inc.\footnote{\textsuperscript{55}} “strikingly similar.”\footnote{\textsuperscript{56}} There, the court held that a three-note sequence (C, B-flat, C) with an accompanying lyric (“clap your hands”) was not eligible for protection because it appeared commonly in music, rendering it unoriginal.\footnote{\textsuperscript{57}} Additionally, the lyric standing alone was too common a phrase to render the otherwise unoriginal three-note sequence original.\footnote{\textsuperscript{58}} Looking to McDonald v. Multimedia Entertainment, Inc.,\footnote{\textsuperscript{59}} the court observed that a claim of originality in a three-note sequence taken from a television jingle was found “absurd.”\footnote{\textsuperscript{60}} The McDonald court held that the sequence was too common in traditional western music to be original; thus, it was unprotected.\footnote{\textsuperscript{61}}

The second route to commonality that the court explained was paved with generic compositional techniques. The court pointed to Intersong-USA v. CBS, Inc.,\footnote{\textsuperscript{62}} in which the song’s descending step motive, like the one in “Twinkle, Twinkle Little Star,” was deemed too commonly used as a compositional device to be original; thus, it was unprotectable.\footnote{\textsuperscript{63}} Still, the district court noted that there have been some findings of protectability for short sequences of notes.\footnote{\textsuperscript{64}}

The court explained that findings of originality for short compositional sequences also generally occur along two routes: samples involving greater than three notes and samples involving
unusual words and/or sounds. Following the first route, the court pointed to the finding of protectability in *Baxter v. MCA, Inc.* There, the defendant had used the opening six notes of the plaintiff’s composition to create the theme to the movie “E.T.” Yet, the court observed that where sequences of less than six notes have been found to be protectable, qualitative factors, such as: accompanying lyrics; the heart of the composition; repetitive sequences or lyrics; and/or common characteristics to both the composition and sound recording have also been present.

Along the second route to originality, the court refuted the plaintiff’s reliance on *Tin Pan Apple, Inc. v. Miller Brewing Co.* as supporting protectability for a few words or sounds. Noting that the defendant in *Tin Pan Apple* copied the words “hugga-hugga” and “brrr,” the court did not find blanket support but, instead, a distinguishing factor. The words used in *Tin Pan Apple* were unusual and, by nature, unusual words and sounds are more distinctive than a few generic notes.

After running the three-note “Choir” sequence through this dual analysis looking for characteristics of either commonality or originality, the court held that sample taken by the Beastie Boys is unprotectable. Here, the evidence showed that the three-note sequence—C, D-flat, C—was a simple and common building block extensively employed in twentieth century music by major composers, especially in the decades preceding Mr. Newton’s use. Moreover, the generic vocalization device had been recognized in academic literature before the plaintiff adopted it for his composition, and it had also been used in several compositions pre-dating the plaintiff’s song. Consequently, as a matter of law, the court found neither the three-note sequence nor the vocalization technique, or their combination, sufficiently original to warrant protection.

65. *Id.*

66. 812 F.2d 421 (9th Cir. 1987).


69. See *Newton*, 204 F.Supp.2d at 1254.

70. *Id.*

71. *Id.* at 1254-55.

72. *Id.* at 1255.
2. Doctrine of De Minimis Use

Although the district court could have been content with extinguishing the action based on its preliminary determination that the sampled portion of plaintiff's composition was not protectable as a matter of law, it provided an alternate ground for granting the defendant's motion for summary judgment. The court determined that even if the three-note segment of Mr. Newton’s composition had been found to be protectable, the doctrine of de minimis use would apply to make the Beastie Boys' sampling of it non-actionable as a matter of law; thus, they would not be liable for copyright infringement.

The court’s analysis explained that de minimis use operates to prevent a finding of substantial similarity, a requirement for actionable copying. To explain the standard for de minimis use, the court made reference to three cases: Sandoval v. New Line Cinema Corp.; Jean v. Bug Music, Inc.; and Fisher v. Dees. First, the court referred to Sandoval for the rule that to establish de minimis use, “the alleged infringer must demonstrate that the copying of the protected material is so trivial ‘as to fall below the quantitative threshold of substantial similarity.’” Referring to Jean, the court noted that substantial similarity will not be found if only a small, common phrase is copied, unless the copied portion is especially unique or qualitatively important. Finally, citing Fisher, the court stated that copying is de minimis “if the average audience would not recognize the misappropriation.”

Identifying the practice of digital sampling as involving fragmented literal similarity, the court stated that the general approach among courts in analyzing de minimis use is to consider both quantitative and qualitative factors. Consequently, even if the

73. To more clearly follow the district court’s analysis throughout this section, it may be helpful to refer to Diagram #4 in the Appendix, infra.
74. Newton, 204 F. Supp. 2d at 1256, 1260.
75. Id. at 1256-57.
76. 147 F.3d 215 (2d Cir. 1998).
78. 794 F.2d 432 (9th Cir. 1986).
79. Newton, 204 F.Supp.2d at 1256.
80. Id. at 1256-57.
81. Id. at 1257.
82. Id. (citing NIMMER ON COPYRIGHT § 13.03 [A][2]).
83. Id. (citing NIMMER ON COPYRIGHT § 13.05[A][2]). Notably, the Court does not cite to any particular cases for this proposition. Further, it is also important to note that
amount copied is quantitatively trivial, the threshold of substantial similarity may still be crossed if the portion used by the defendant is especially unique or important.\textsuperscript{83} The court explained that quantitative and qualitative analyses focus solely upon the segment’s significance to the plaintiff’s work, not the defendant’s use of it.\textsuperscript{85} Therefore, the court stated that the quantitative or qualitative importance the portion sampled possesses in the defendant’s new song is irrelevant.\textsuperscript{86}

Here, the portion sampled by the Beastie Boys was only 2-percent of “Choir.” Moreover, the three-note sequence appears only once within “Choir.” Upon finding this to be quantitatively trivial in relation to “Choir” as a whole, the court announced that the plaintiff’s only chance for the sample to cross the threshold of substantial similarity was via qualitative factors.\textsuperscript{87}

Although the court recognized that some segments of music may be qualitatively important even standing alone, it reminded the parties that—similar to the protectability analysis—what is at issue in the \textit{de minimis} use analysis is not whether the average listener might recognize the segment as taken from the sound recording. Instead, it is whether the average listener might recognize—from a performance of the composition as written—the plaintiff’s musical composition as the underlying source.\textsuperscript{88} Here, even though the defendants conceded they took “the best bit of ‘Choir,’” the court found that testimony referred to the distinctiveness of the performance, not the composition.\textsuperscript{89} Further, the court again noted that in regards to \textit{de minimis} use, just as in the analysis of originality, the short compositional sequences that have survived summary judgment have involved: more than three notes; accompanying lyrics; the heart of musical compositions; repetitive sequences; and/or sequences that appear in both the composition and sound recording.\textsuperscript{90} Finding none of these factors present, the court stated that neither the notes nor the generic vocalization technique—or their combination—imparted any distinctiveness to the six-second portion sampled by the Beastie

\textsuperscript{84} Newton, 204 F. Supp. 2d at 1257.
\textsuperscript{85} Id.
\textsuperscript{86} Id.
\textsuperscript{87} Id. at 1258.
\textsuperscript{88} Id.
\textsuperscript{89} See Newton, 204 F. Supp. 2d at 1258-59.
\textsuperscript{90} Id. at 1259.
Boys. Thus, the court held that the plaintiff failed to identify any factors separate from those attributable to his unique performance that rendered the three-note sequence qualitatively important to “Choir.” Consequently, as a matter of law, the digital sampling of “Choir” by the Beastie Boys was non-infringing due to its quantitatively and qualitatively trivial nature.

3. International Copyright Infringement and Limitation of Damages

As a result of its determination on the claim under U.S. law, the court made short shrift of the international copyright infringement claim. That claim failed as a matter of law because it depended upon successfully proving that the defendants were liable for at least one completed act of infringement within the United States.

Additionally, the court held that even if the plaintiff’s copyright claims had not failed, Mr. Newton would have only been entitled to damages accruing after April 9, 1998. The court’s reasoning is three-fold. First, beginning with the statute, 17 U.S.C. § 507(b) mandates that the civil action commence within three years after the claim accrues. Second, a claim accrues when the act of infringement actually occurs, not when consequent damages are suffered. Finally, the plaintiff’s right to damages is limited to those suffered during the statutory period of limitations regardless of when they may have been incurred. Thus, since Mr. Newton did not file suit until April 9, 2001, any damages incurred between 1992 and April 9, 1998, were not eligible for consideration.

V. Newton v. Diamond: The Court of Appeals Obscures a Clue

A. The Judgment

On April 7, 2003, Mr. Newton’s appeal of the district court’s decision was argued and submitted to the Ninth Circuit Court of Appeals. Seven months later, on November 4, 2003, Chief Judge Mary M. Schroeder issued the majority opinion affirming the grant of

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91. Id.
92. Id.
93. Id.
95. Id.
96. Id.
97. Id.
98. Id.
summary judgment to the Beastie Boys. However, the opinion was not merely an echo of the decision below.

The court began its opinion by acknowledging the difficulty and importance of the sampling issue. Yet, despite its recognition of the district court’s “scholarly opinion,” it announced that—since it was not required to address each decisional ground relied upon by the lower court—it was basing its decision solely on the ground of de minimis use. Consequently, the Ninth Circuit ignored the district court’s primary ground of decision—that as a matter of law, the sampled sequence of “Choir” lacked sufficient originality to merit copyright protection. Rather than undertake a review of that threshold issue, the Ninth Circuit made an implied reversal of the district court’s protectability holding by assuming the sampled sequence of the composition is sufficiently original to merit copyright protection.

B. Analysis of the Court—The Doctrine of De Minimis Use

Just as the district court had done, the Ninth Circuit began its de minimis use analysis by showing a relationship between de minimis use and substantial similarity centered upon the determination of actionable copying. The court explained that although substantial similarity between the plaintiff’s and defendants’ works must exist for unauthorized copying to be actionable, the legal maxim de minimis non curat lex (“the law does not concern itself with trifles”) recognizes the coordinate principle that trivial copying will not constitute actionable infringement.

However, differing from the district court, the Ninth Circuit relied solely upon a footnote in its 1986 opinion in Fisher v. Dees to establish the standard for de minimis use. There, the court stated

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100. Id. at 592.
101. Id. at 592, 594.
102. See id. at 594.
103. See id.
104. See id.
105. Id. Although the standard built by the district court also has flaws, the district court relied on a broader array of cases, Sandoval being primary among them with Fisher being referred to last—arguably as an elaboration. Notably, while the district court began on track with the Second Circuit’s Ringgold standard—as expressed via Sandoval—ultimately, it suffers from the same flaws as the analysis of de minimis use in Newton II. Therefore, since de minimis use was merely a secondary ground of decision in Newton I, the flaws within its de minimis use analysis are reserved for discussion via the Ninth Circuit’s sole ground for decision.
that a taking is considered *de minimis* only if it is so meager and fragmentary that the average audience would not recognize the appropriation.\(^{106}\) Acknowledging that *de minimis* use was rejected as a *defense*\(^{107}\) in *Fisher*, the court explained that, in *Fisher*, it found that the defendant’s successful fair use defense—grounded in parody—precluded finding the use insubstantial or unrecognizable since a parodist must “appropriately a *substantial enough* portion . . . to evoke recognition.”\(^{108}\)

Building from the *Fisher* standard, the *Newton II* court enunciated a further link between the tests for substantial similarity and *de minimis* use by pointing to their common usage of the average audience, or ordinary observer, to determine infringement.\(^{109}\) The court then concluded that, “to say that a use is *de minimis* because no audience would recognize the appropriation is thus to say that the works are not substantially similar.”\(^{110}\) Consequently, after performing a brief filtering exercise, the Court arrived at what it deemed to be “the nub” of the *de minimis* use inquiry: “whether the Beastie Boys’ unauthorized use of the composition . . . was *substantial enough* to sustain an infringement action.”\(^{111}\)

Thereafter, similar to the district court, the Ninth Circuit identified digital sampling as a problem of fragmented literal similarity and stated that its substantiality is determined by considering the qualitative and quantitative importance of the copied segment in relation to the plaintiff’s work as a whole.\(^{112}\) Here, the evidence showed that, quantitatively, the sample comprised only 2-percent of Mr. Newton’s composition and appeared only once within “Choir.” From the qualitative perspective, the court held that the sample was no more significant than any other section of the composition because, with the exception of two notes, the entire composition was made up of notes separated merely by whole and

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106. *Fisher*, 794 F.2d at 434 n.2.
107. Whether the doctrine of *de minimis* use constitutes a defense or an element of the plaintiff’s prima facie case is an open question, which will be discussed in Part VI. B, *infra*.
108. *Newton*, 349 F.3d at 595 (citing *Fisher*, 794 F.2d at 434 n.2) (emphasis added).
109. *Id.* at 594.
110. *Id.*
111. *Id.* at 596 (emphasis added).
112. *Id.* (citing 4 NIMMER ON COPYRIGHT § 13.03 [A][2], at 13-47, 48, n. 97). Once again, as mentioned in note 83, it is important to realize that this section of the Nimmer treatise is a discussion of substantial similarity and not specifically *de minimis* use, a hurdle within its quantitative component.
Moreover, the plaintiff’s expert had described the sample as a simple neighboring tone figure.

Notably, agreeing with the district court that the particulars of a defendant’s use are irrelevant, the Ninth Circuit never analyzed the Beastie Boys’ use of the sample. The court declined to consider the defendants’ use, stating that a rule requiring it to do so would allow unscrupulous defendants to copy large or qualitatively significant portions of a work and escape liability by burying them under non-infringing material—“even where an average audience might recognize the appropriation.” In this regard, the court seemed to forget (or discard) the premise with which it began its analysis, its own Fisher standard.

Similar to Newton I, the Newton II court placed the burden of clearing the hurdle of de minimis use upon the plaintiff. Thereafter, finding the evidence insufficient, the court similarly held that the plaintiff failed to demonstrate the sample’s quantitative or qualitative significance. Consequently, the court deemed that Mr. Newton was in a weak position to argue the presence of substantial similarity between the works, or that an average audience would recognize the appropriation. Ultimately, the court’s de minimis use analysis led it to conclude that the Beastie Boys’ use of the sample was insufficient to sustain a claim for copyright infringement of the “Choir” composition.

VI. Reality Check

A. Which is the Path to Reasonable Determination?

Just as the shortest distance between two points is a straight line, the surest path to reasonable predictability in the law is a straightforward, non-circuitous legal analysis. As mentioned earlier, what has been sorely needed is a path of reasonable determination by which to escape the persistent legal uncertainty surrounding the practice of digital sampling. So, did the Newton courts finally blaze that trail—the district court in Newton I with its protectability

113. Id. at 597.
114. Id.
115. Id.
116. Id. at 597-98.
117. Id. at 598.
118. Id. (emphasis added).
Although the factual distinctions it made may initially appear to be an ad hoc consolidation of previous judicial pronouncements, the Newton I court seems to have blazed the most straightforward trail of legal analysis. Thus, this author believes, the Newton I approach could have provided the music industry a path of reasonable determination. At its most basic level, the Newton I approach can be described as entailing two steps: filtration and an originality determination. Notably, no matter what approach one pursues, filtration must be performed to separate the unique performance elements of the sound recording from an analysis of the composition. Thus, the core of the Newton I approach is that, once distilled, the sample from the composition can be run through a protectability analysis via a series of relatively straightforward questions, such as: (1) is the sample comprised of three notes or less and/or a generic compositional technique; (2) does the sample contain either six notes or more, or unusual words or sounds; and (3) if the sample is comprised of less than six notes or generic compositional techniques, does it also contain (a) accompanying lyrics, (b) the heart of the composition, (c) a sequence or lyric that is repetitive within the composition, and/or (d) a sequence that is identically expressed in both the sound recording and the composition? While not hitching posts, these questions could be viewed as guideposts to lawful sampling, which had not been previously elucidated. Consequently, as a threshold determination, the Newton I approach has the potential advantage of extinguishing claims before the need to undertake more elaborate analyses arises.

On the other hand, those following Newton II may get lost along its circuitous route. To illustrate its confusing twists and turns, picture the following: as you begin to travel down the Newton II path, you see a road sign marking the path as “de minimis: use too meager and fragmentary to evoke recognition.” A short distance away, you come upon another sign marking the path as “substantial similarity: use not substantial enough to sustain an infringement action.” Thus, you begin to wonder what test you are to apply and what are its components. Just then, you arrive at a three-pronged fork in the road. The first path is marked “significance to the plaintiff’s work.”

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119. For a graphic depiction of the Newton I court’s performance of this exercise, see Diagram # 2 in the Appendix, infra.
120. For a graphic depiction of the protectability (originality) analysis, see Diagram # 3 in the Appendix, infra.
second path is marked “defendant’s use of the work,” and the third path is marked “comparison between the plaintiff’s and defendant’s work.” However, upon glancing down each path, you notice that the second and third paths are immediate dead-ends. Thus, the only path for you to walk is the first. Setting out, you turn left to examine the quantity of the use. Along here, the Newton II court has planted a marker stating, “Please note: under Fisher, a successful fair use defense will prevent you from finding insubstantial or unrecognizable use.” Next, you turn to the right to examine the qualitative significance of the copied segment. Once again you are met with dual markers; side-by-side they instruct, “Watch out for recognizability” and “Watch out for a sustainable infringement action.” Yet, upon reaching the end of the path, a final sign blocking egress from the summary judgment proceeding states: “Proceed to full trial of this matter only upon finding a sustainable infringement action.”

So, was there any consideration of the enunciated Fisher “recognizability” factor or was it impliedly subsumed within the substantial similarity analysis? Moreover, was this a path for analyzing de minimis use or for performing a full substantial similarity test? It seems that rather than blaze a trail of reasonable determination, the Newton II court has created a conundrum of de minimis use analysis.

B. The Conundrum of De Minimis Use Analysis

Newton II highlights the problem that a clear standard for de minimis use has not yet been settled upon in the courts. While there may have already been a few lingering questions surrounding the concept, Newton II surely added to the list. Currently, it seems the riddle must be solved by answering the following questions: (1) what is the de minimis standard; (2) which party has the burden of proof; (3) where does the fair use defense fit into the analysis; (4) what is the proper consideration to be given to the qualitative nature of the copied portion; (5) does the de minimis use analysis merely provide the means by which to bypass the factfinder on the issue of substantial similarity; and finally, (6) which works should be considered: solely the plaintiff’s, solely the defendant’s, or both?

121. Recently, however, the Sixth Circuit issued an opinion in Gordon v. Nextel Comms., 345 F.3d 922 (6th Cir. 2003), which seems to closely follow the Ringgold analysis of de minimis use. The Gordon court’s analysis focused on the quantitative measure including consideration of the observability of the copied work within the defendant’s new work. Notably, the Gordon court makes absolutely no mention of a qualitative factor within its de minimis use analysis.
First, what is the *de minimis* use standard? In *Fisher*, the Ninth Circuit defined it as use “so meager and fragmentary that the average audience would not recognize the appropriation.”

However, subsequent to *Fisher*, the Second Circuit’s 1997 decision in *Ringgold v. Black Entertainment Television, Inc.* became the polestar of *de minimis* use analysis. *Ringgold* formulated *de minimis* use as a threshold determination on the way to a substantial similarity analysis.

The *Ringgold* court explained that while substantial similarity has both quantitative and qualitative components, the *de minimis* concept is relevant to the quantitative component. In this regard the court stated, “since ‘substantial similarity,’ properly understood, includes a quantitative component, it becomes apparent why the concept of *de minimis* is relevant.”

Additionally, *Ringgold* established an observability test within the *de minimis* use analysis. Under the facts presented in *Ringgold*, that observability test was applied to visual works. There, observability was measured via characteristics of the defendant’s work, such as: the length of time the copied portion is observable, the focus, lighting, camera angles, and prominence. Yet, these characteristics seem to measure not only observability but also recognizability. Thus, the observability test within *Ringgold* appears to echo *Fisher*’s recognizability requirement. Indeed, the *Ringgold* court found:

> [In some circumstances a visual work . . . might ultimately be filmed at such a distance and so out of focus that a typical program viewer would not discern [the] effect that the work of art contributes to the [new work]. But that is not this case. The painting component is recognizable as a painting . . . .]

Consequently, after *Fisher* and *Ringgold*, the *de minimis* use standard could reasonably be understood as being comprised of two

122. 794 F.2d at 434 n.2.
123. 126 F.3d 70 (2d Cir. 1997).
124. See id. at 74.
125. Id.
126. Id. at 75.
127. Id.
128. Id.
129. Although, this would not be a direct echo since *Ringgold* never mentions or cites to *Fisher*.
130. 126 F.3d at 77.
considerations: (1) quantitatively trivial portions of the plaintiff’s work, or (2) unrecognizable use within the defendant’s work.

Second, which party has the burden of proof? Although the defendants in both Fisher and Ringgold made the express assertion that their use of the copyrighted work was de minimis, neither court explicitly addressed the burden of proof on the matter. However, in 1998 the Second Circuit concisely reiterated the Ringgold standard in Sandoval v. New Line Cinema Corp. and, while doing so, placed the burden of proof upon the defendant. The Sandoval court declared, “the alleged infringer must demonstrate that the copying of the protected material is so trivial ‘as to fall below the quantitative threshold of substantial similarity’.” Yet, in Newton I and II the burden of proof was clearly placed upon the plaintiff.

Although the Nimmer treatise refers to de minimis use as a defense in a few instances, it does not discuss the burden of proof on this issue. Yet, its nature as a threshold determination to be made before the factfinder is bothered to undertake a full substantial similarity analysis would intimate that it should be characterized as part of the plaintiff’s prima facie case, thus, burdening the plaintiff. Further, even if de minimis use is properly characterized as an affirmative defense, the question still might arise as to whether de minimis use can be considered an equitable rule of reason, allowing the court discretion to shift the burden back to the plaintiff, as occurred under the analysis of the fourth fair use factor in Sony Corp. of America v. Universal City Studios, Inc.

Third, where (if anywhere) does the fair use defense fit into the de minimis use analysis? Ringgold established that the de minimis use analysis is inappropriate to the issue of fair use; thus, implicitly, fair use is also inappropriate to the de minimis use analysis. Indeed, the Ringgold court advised that where the allegedly infringing work makes a quantitatively trivial use of a copyrighted work, “it makes more sense to reject the claim on that basis and find no infringement,

131. 147 F.3d 215 (2d Cir. 1998).
132. Id. at 217.
133. Id.
136. Remember, “the law does not concern itself with trifles” (de minimis non curat lex). Arguably, this could be translated into more blunt phrasing, such as: “don’t bother the court to exert its resources in putting trivial concerns through elaborate legal analysis.”
138. 126 F.3d at 75-76.
rather than undertake an elaborate fair use analysis in order to uphold a defense.\textsuperscript{139} The Sandoval court echoed this advice by holding that it was error for the lower court to have resolved the fair use claim without first determining whether the alleged infringement was \textit{de minimis}.\textsuperscript{140} So, although a defendant will often present claims of \textit{de minimis} use and fair use as tandem defenses, a court will not properly reach the fair use defense until it has resolved the \textit{de minimis} use question. Consequently, Newton II's resurrection of Fisher's consideration of fair use as precluding a finding of \textit{de minimis} use appears to be a red herring.

Fourth, what is the proper consideration to be given to the qualitative nature of the copied portion? When refuting substantial similarity is made the thrust of the \textit{de minimis} use analysis, it presents the danger that substantial similarity's quantitative and qualitative factors will dominate the process. Moreover, making qualitative significance a primary factor alongside the quantitative measure creates the risk that \textit{de minimis} use analysis will, mistakenly, be equated with the third factor of fair use—the amount and substantiality of the use in relation to the copyrighted work as a whole. As mentioned earlier, this would be inappropriate, especially since Ringgold noted the distinction that the third fair use factor operates along a continuum for which there is no precise threshold.\textsuperscript{141}

However, a qualitative factor may have value to \textit{de minimis} use analysis as a sort of “safety-valve” feature—a “double-check.”\textsuperscript{142} Judge Graber in his dissent to Newton II validly reminds us that, “even passages with relatively few notes may be qualitatively significant. The opening melody of Beethoven’s Fifth Symphony is relatively simple and features only four notes, but it certainly is compositionally distinctive and recognizable.”\textsuperscript{143} A qualitative consideration also seems compatible with the observability (or recognizability) test, especially since the heart of a copyrighted work will be inherently more recognizable even if quantitatively smaller than other parts of the copyrighted work.

Although, a question looms over a \textit{de minimis} use qualitative factor, which is: if a three-note sequence has already been found sufficiently original to be protected by copyright law—how much

\textsuperscript{139} Id. at 76.
\textsuperscript{140} 147 F.3d at 217.
\textsuperscript{141} 126 F.3d at 76.
\textsuperscript{142} This proposition finds support in the Nimmer treatise. See \textsc{Nimmer}, supra note 135, § 13.03[A][2] at 13-47.
\textsuperscript{143} \textit{Newton v. Diamond}, 349 F.3d 591, 598-99 (9th Cir. 2003) (Graber, J., dissenting).
more original, or distinctive, does it need to be to clear the hurdle of *de minimis* use? *Newton I* suggests that for quantitatively trivial sequences to survive summary judgment on *de minimis* use, they must be somewhat larger than Newton’s three notes and involve either: (a) accompanying lyrics, (b) the heart of the composition, (c) notes or lyrics that repeat within the copyrighted work, and/or (d) sequences that are identically expressed in both the composition and the sound recording. Newton II suggests that the plaintiff needs to show that the copied segment is more significant than any of the other segments in the copyrighted work.

In regards to “Choir,” the Newton II court found: “Qualitatively, this section of the composition is no more significant than any other section. Indeed, with the exception of two notes, the entirety of the scored portions of “Choir” consists of notes separated by whole- and half-steps from their neighbors.” Here, it may be appropriate to recall the warning given by Justice Holmes in *Bleistein v. Donaldson Lithographing Co.*: “It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [expressive works], outside of the narrowest and most obvious limits.” Notably, both Newton courts failed to consider the fact that the sampled sequence is the opening of “Choir” and unique within the composition rather than repetitive, which may actually enhance its distinctiveness rather than diminish it. Thus, even though a qualitative factor may hold value for *de minimis* use analysis, a court must exercise caution in its application.

Fifth, does the *de minimis* use analysis simply provide the means by which to bypass the factfinder on the issue of substantial similarity? In other words, when considering *de minimis non curat lex* during a summary judgment proceeding, should courts be making a black and white choice between trivial, non-recognizable use (a matter of law) and substantial similarity (a question for the factfinder)? Or should they, instead, decide whether the use of a copied segment rises above a trivial, non-recognizable use to cross

144. 204 F. Supp. 2d at 1259.
145. *Newton*, 349 F.3d at 597.
146. *Id.*
147. 188 U.S. 239, 251 (1903).
148. *Id.*
149. Could this be substantial similarity analysis in the proverbial “sheep’s clothing?”
150. The relationship between substantial similarity and *de minimis* use seems to have caused semantic confusion, which in turn has led to legal confusion in regards to its analysis.
into a gray area where reasonable minds may differ, presenting a genuine issue of material fact regarding substantial similarity reserved for the factfinder. This author believes it should be the latter, for although there is a relationship between trivial use and substantial similarity, if it is formulated as simply a black and white distinction—with trivial use merely being the negative of substantial similarity—courts run the risk of inadvertently eliminating the factfinder from the determination of substantial similarity. Judge Graber’s dissent in Newton II demonstrates this possibility when he states:

[T]he composition, standing alone, is distinctive enough for a jury reasonably to conclude that an average audience would recognize the appropriation of the sampled segment . . . Because Newton has presented evidence establishing that reasonable ears differ over the qualitative significance of the composition of the sampled material, summary judgment is inappropriate in this case. 151

Sixth, and finally, which work should be considered—solely the plaintiff’s, solely the defendant’s, or both? In general, the answer is both. However, as seems typical of de minimis use analysis, that answer is not as straightforward as it appears on the surface. Quantitatively, Newton I and II appear at first glance to correctly state that the significance of the copied sequence in relation to the defendants’ work is irrelevant and only the plaintiff’s copyrighted work should be considered. Yet, this is likely the result of the aforementioned ease with which the de minimis use analysis may be confused with the third factor of fair use.

Indeed, Ringgold directs us to consider not only the quantitative significance of the copied portion in relation to the plaintiff’s work, but also the quantitative significance of the copied portion in relation to the defendants’ work. To notice this directive, one need only look to Ringgold’s observability test. Although “observability” may seem to connote some sort of qualitative consideration, Ringgold deems it a quantitative consideration.152 In this regard, Ringgold states, “the quantitative component of substantial similarity also concerns the observability of the copied work [including] the length of time the copied work is observable in the allegedly infringing work.”153

In Ringgold, the court examined evidence regarding the durational aspects of the defendant’s use, noting that all nine

151. Newton, 349 F.3d at 598, 600 (Graber, J., dissenting).
152. 126 F.3d at 75.
153. Id.
instances in which the copyrighted work appeared to any degree amounted to an aggregate duration of 26.75 seconds.154 Further, the court found that the repetitive effect of such use reinforced the effect of its initial appearance. Thus, the court held:

From the standpoint of a quantitative assessment of the segments, the principal four-to-five-second segment in which almost all of the poster is clearly visible, albeit in less than perfect focus, reinforced [sic] by the briefer segments in which smaller portions are visible, all totaling 26 to 27 seconds, are not de minimis copying.155

Notably, in discussing fragmented literal similarity, the Nimmer treatise states; “The practice of digitally sampling prior music to use in a new composition should not be subject to any special analysis: to the extent that the resulting product is substantially similar to the sampled original, liability should result.”156 Therefore, given the symbiotic relationship between the concepts of substantial similarity and de minimis use, it is doubtful that—given Ringgold’s focus on visual works—a different quantitative approach should pertain to other types of works, such as compositions and sound recordings.

Qualitatively, Newton I and II also deem the defendants’ work to be irrelevant. Additionally, in performing their de minimis use analyses, neither Ringgold nor Sandoval ever discuss qualitative factors per se—arguably preferring to maintain clarity in the thrust of the de minimis use analysis as a quantitative consideration. However, as mentioned above, a qualitative factor may have value to the de minimis use analysis. And, if we again look closely at the Ringgold observability test, a qualitative feel is perceptible in some of the so-called quantitative considerations, such as the focus, lighting, camera angles, and prominence of the copyrighted work. Yet, noticeably, the Ringgold court was looking only to the defendant’s work in this regard. Neither the Ringgold nor Sandoval courts discussed the qualitative significance of the plaintiff’s copyrighted work. However, because the facts of those cases involved copying of the entire copyrighted work, they may have merely considered such discussion unnecessary. Arguably, the qualitative significance of both the plaintiff’s work and the defendant’s use should be considered—the defendant’s in the primary sense under the observability test, and the

154. Id. at 76.
155. Id. at 77.
plaintiff’s in the secondary sense as a safety-valve to a pure quantitative evaluation.

VII. Conclusion

For the time being, the grafting of creative expression performed via digital sampling will remain trapped in its discordant culture of social popularity and legal uncertainty. Unfortunately, Newton II has left the music industry with only the same unsatisfactory means of egress from that morass: the path of improvidence—doling out steady streams of preventative payments—and the path of imprudence—daring the copyright holders of sampled works to “catch me if you can.” While the path of improvidence (the “sample for pay” model) may be efficient and economical in some instances, it is generally accepted that nothing in the law requires the copyright owner of either the sound recording or the composition to license a digital sample of his or her work. So, supposing your client has successfully obtained a sample license for the sound recording: if negotiations with the copyright holder of the composition are refused for artistic reasons, break down for financial reasons, or your client is inclined to daringly hop on the path of imprudence, what legal guideposts can you look to for assistance in measuring the legitimacy of your client’s impending act of unauthorized compositional sampling?

Whether or not its guideposts were ideal, Newton I blazed a sorely needed trail of reasonable determination grounded in the threshold issue of originality. At its core, Newton I established an efficient method whereby a distilled compositional sequence could be run along a series of guideposts to make the threshold determination as to eligibility for protection. Consequently, the Newton I approach presented the potential advantage of being able to extinguish a claim before escalation to more elaborate analyses became necessary.

However, Newton II obscured the Newton I path under a muddy analysis of de minimis use. Building its standard for de minimis use analysis around a footnote in Fisher, rather than adapting Ringgold, Newton II demonstrates that a clear standard for de minimis use analysis still has not been settled upon in the courts. Therefore, those who engage in digital sampling and may make a de minimis use assertion—or those who may attempt to refute such—will be faced with a more elaborate analysis than appears on its surface. De minimis use analysis would be a less circuitous path if, despite the symbiotic relationship between de minimis use and substantial similarity, de minimis use was not considered an exact antithesis of substantial similarity. Newton II’s formulation of it as such presents
the dual dangers of inadvertently bypassing the factfinder on the issue of substantial similarity and inappropriately equating the analysis with the third factor of fair use.

To be clear, the concept of *de minimis* use does possess the potential to assist those engaged in digital sampling measure the legitimacy of their actions. However, until the courts settle upon and elucidate consistent standards for *de minimis* use analysis, that potential will remain unfulfilled. *Newton II* did not fulfill this potential, although it had the opportunity to do so by adopting and consistently adapting the *Ringgold* analysis to digital sampling. Still, it is important to realize that even if the potential of *de minimis* use analysis is fulfilled via further clarification and adoption of the *Ringgold* standard, its application may not hold an answer digital samplers want to face, given *Ringgold*’s consideration of the aggregate duration of a defendant’s use.

Ultimately, however, reasonable predictability in the law is ensured through non-circuitous legal analysis. *Ringgold* recognized this principle when it warned that it makes more sense to reject a claim on the basis of *de minimis* use rather than try to navigate the elaborate paths of a fair use defense. In turn, *Newton I* inherently applied this same principle at the threshold of an infringement claim. *Newton I* should have been affirmed on its primary ground of decision—that the sampled sequence was not sufficiently original to merit copyright protection. In that way, the Ninth Circuit could have at least preserved one path of reasonable determination. If members of the music industry are to be able to reasonably predict the consequences of their digital sampling activity, courts in the future must first undertake the *Newton I* approach, because it makes more sense to reject a claim on the basis of ineligibility for protection rather than tread the current muddy and circuitous path of a *de minimis* use analysis.

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157. *I.e.*, gauge their risk of infringement.
158. 126 F.3d at 76.
Appendix

Figure 1: Choir: The Musical Score for the Sampled Sequence

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159. Newton, 349 F.3d at ___ [Appendix].
Diagram #1: *Newton v. Diamond*’s Two Separate Copyrighted Works

1. **Sound Recording: “Choir”**
   - Length = approx. 4½ minutes
   - Rightsholder: *ECM Records*, a 3rd party
     - Acquired by license from plaintiff in 1981

2. **Musical Composition: “Choir”**
   - Rightsholder: plaintiff, *James Newton*

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**Feb. 26, 1992:**

- Irrevocable & non-exclusive license to “sample” issued to the Beastie Boys.

**Sample Used by Beastie Boys:**

- 6 seconds, 3 notes:
  - C ↑ D-flat ↓ C
  - w/ simultaneous vocalization

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**Claims:**

1. Copyright infringement
2. Int’l copyright infringement
3. Reverse Passing Off (dismissed per F.R. 12(b)(6) – failure to state a claim)
4. Misappropriation of Identity (dismissed per F.R. 12(b)(6))

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**Issue at Heart of Claims:**

- Were defendants legally obligated to obtain a separate license for the derivative use of the musical composition?
Diagram #2: Newton I on Analytic Dissection of the Musical Composition vs. Sound Recording

Musical Composition: “Choir”

**Definition:** Rhythm, harmony, and melody expressed in written form

**Protects:** The generic sound that would necessarily result from any performance of the work as written

**Plaintiff’s Score:**
- No time or key signatures
- No further orchestration
- Calls for improvisation
- Sequence at issue appears only once
- Footnote indicates performer must sing into flute & finger the C note simultaneously (i.e., “vocalization”)

Sound Recording: “Choir”

The aggregation of sounds captured by recording onto a phonorecord a performer’s rendition of a musical composition.

Analytic Dissection: Why? → filtering

(a) Plaintiff does not own both copyrights; would be unnecessary if he did
(b) Plaintiff can’t base his claim on elements that are unique to the sound recording
(c) Must determine the scope of protection available for the musical composition

Plaintiff bases claim on originality of vocalization & overblowing.

Here, this results in a “Battle of the Experts”:

**Generic Vocalization (G/V):**
- Predates & is not unique to Plaintiff’s musical composition
- Has been used in Africa & was prevalent throughout 20th Century, e.g., “Voice of the Whale,” 1971 composition by G. Crumb
- Academic literature recognized G/V before Newton wrote “Choir”
- This is noted in the musical composition, “Choir”

**Newton Technique (N/T):**
- His unique approach: using breath control to emphasize certain notes
- Overblowing the C-note to produce multiple pitches
- Neither N/T nor overblowing are noted within “Choir” composition
- Plaintiff concedes that NOT all the elements of his performance of “Choir” are reflected within the musical composition

Result: Plaintiff’s specific techniques of performing “Choir” are protected only by the copyright in the sound recording of his performance of “Choir,” which defendants licensed.
Diagram #3: *Newton I* on the Protectability of a Particular Segment of a Copyrighted Musical Composition

(a) Registration with Copyright Office in 1978
   Prima facie evidence of:

   - **Validity** of the overall copyright in the work
   - **Originality** of all elements within the copyrighted work

   Yes   No

*Diagram continued on next page*
(b) Protectability of Elements within a copyrighted work

Original
incl. creatively non-trivial ~ *Feist*

Yes  No

**distinction:**

Where sample involves < 6 notes:

Generally also involves:
- Accompanying lyrics
- Heart of composition
- Repetitive seq. & lyrics, and/or
- Seqs. expressed in both comp. & sound recording

*E.g. Baxter v. MCA*
- Use of 1st six notes to create theme song for movie “E.T.”

**Here:**
- No lyrics;
- Not heart;
- Not repetitive;
- Only analyzing composition

Where sample involves words / sounds:

Generally involve unusual words or sounds:

*E.g. Tin Pan Apple v. Miller Brewing* ~ “hugga-hugga” & “brrr”

*E.g. Jean v. Bug Music, Inc.*:
- C ↓ B flat ↑ C + clap your hands: not protectable

*McDonald v. Multimedia Ent.*:
- 3 notes common to trad’l western music not protectable

**Here:**
- No unusual words or sounds noted within comp.

Common
& lacking nontrivial creative contribution

Takes into consideration the limited raw material (notes & chords) composers have to work with

Two ways to find “commonality”:

- 3 notes or less

*E.g. Tin Pan Apple v. Miller Brewing* ~ “hugga-hugga” & “brrr”

*E.g. Jean v. Bug Music, Inc.*:
- C ↓ B flat ↑ C + clap your hands: not protectable

*McDonald v. Multimedia Ent.*:
- 3 notes common to trad’l western music not protectable

**Here:**
- C ↑ D flat ↓ C
- Is a common building block in 20th Century music

Strikingly similar to facts of *Jean*

**Generic compositional technique**

*E.g. Intersong-USA v. CBS*:
- Descending scale step: not protectable

**Here:**
- Common device of generic vocalization cannot be protected
Diagram #4: Newton I’s De Minimis Use Analysis

**Doctrine of De Minimis Use**
Operates to prevent a finding of substantial similarity
(a requirement for actionable copying)
*Standard:* average audience would not recognize the misappropriation.

**Is the use quantitatively trivial?**
*Court focused on:* whether portion taken constituted a substantial portion of the copyrighted work.
*Court considered irrelevant:* whether portion taken constituted a substantial portion of Defendant’s work. Here, the fact that the sequence was “looped” throughout entire “Pass the Mic” song is of no consequence.

- **Yes**
- **No**

**Here:**
only 2% of “Choir” composition was taken, and it appeared only once in the “Choir” composition

**Is the use qualitatively trivial?**
*Court focused on:* Whether portion taken is important to Plaintiff’s entire song.
*Court considered irrelevant:* Whether portion taken is important to Defendant’s song.

- **No**
- **Yes**

**Defense will fail**

Cases where de minimis use defense failed involved:
- larger portions of music, AND:
- accompanying lyrics
- heart of comp.
- repetitive seq. & lyrics, and/or
- seqs expressed in both comp. & sound recording

**Note:** The issue is not whether the average listener might recognize the portion taken as coming from Plaintiff’s sound recording!
*Instead:* The issue is whether the average listener might recognize Plaintiff’s musical composition as the underlying source.

**Here:** Neither the notes nor the G/V technique noted in the composition—nor their combination—imparts any distinctiveness to the 6-second portion. Also, Plaintiff fails to identify any factors separate from those attributable to his unique performance techniques that would render the 3-note sequence qualitatively important.

**Result:** Defense Succeeds for the Beastie Boys!