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Thou Shalt Not Steal: *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.* and the Future of Digital Sound Sampling in Popular Music

by
CARL A. FALSTROM*

Introduction

Digital sound sampling,¹ the borrowing² of parts of sound recordings and the subsequent incorporations of those parts into a new recording,³ continues to be a source of controversy in the law.⁴ Part of

* J.D. Candidate, 1994; B.A. University of Chicago, 1990. The people whom I wish to thank may be divided into four groups: (1) My family, for reasons that go unstated; (2) My friends and cohorts at WHPK-FM, Chicago, from 1986 to 1990, with whom I had more fun and learned more things about music and life than a person has a right to; (3) Those who edited and shaped this Note, without whom it would have looked a whole lot worse in print; and (4) Especially special persons—Robert Adam Smith, who, among other things, introduced me to rap music and inspired and nurtured my appreciation of it; and Leah Goldberg, who not only put up with a whole ton of stuff for my three years of law school, but who also managed to radiate love, understanding, and support during that trying time.

1. Digital sound sampling has been described by one musicologist as “the conversion of analog sound waves into a digital code. . . . [This code] can then be reused, manipulated or combined with other digitalized or recorded sounds using a machine . . . [like a] computerized synthesizer.” Judith Greenberg Finell, *How a Musicologist Views Digital Sampling Issues*, N.Y. L.J., May 22, 1992, at 5, 7 n.3.

2. “Borrowed” is a loaded term. Many are more apt to equate sampling with theft than with borrowing. Nevertheless, “borrowing” seems to have caught on as a convenient, easily conceptualized shorthand reference to the idea that samplers take sound from a source and put it into their own recordings. Furthermore, “borrowing” connotes the commonly acknowledged reality that, in a sense, every music composition “borrows” from every composition that preceded it, without pejorative references to the subsequent composition as “theft” or “piracy.” I therefore use the term to convey both asportation and homage.

3. See Bruce J. McGiverin, Note, *Digital Sound Sampling, Copyright and Publicity: Protecting Against the Electronic Appropriation of Sounds*, 87 COLUM. L. REV. 1723, 1724 (1987). For discussions of the creation of a digital sound sample that are beyond the scope of this Note, see James P. Allen, Jr., *Look What They’ve Done to My Song Ma—Digital Sampling in the 90’s: A Legal Challenge for the Music Industry*, 9 U. MIAMI ENT. &

the controversy stems from a lack of legal standards against which to assess its legitimacy. Because music sampling is such a recent phenomenon,⁵ Congress did not address the practice in the Copyright Act of 1976 and has not addressed it in amendments to the Act.⁶ Thus far,

SPORTS L. REV. 179, 181-82 (1992); Jeffrey R. Houle, *Digital Audio Sampling, Copyright Law and the American Music Industry: Piracy or Just a Bad "Rap"?*, 37 LOY. L. REV. 879, 880-82 (1992); Molly McGraw, *Sound Sampling Protection and Infringement in Today's Music Industry*, 4 HIGH TECH. L.J. 147, 148-51 (1989); Mark G. Quail, *Digital Samplers: Can Copyright Protect Music from the Numbers Game?*, 7 INTELL. PROP. J. 39, 42-43 (1993); Thomas D. Arn, Comment, *Digital Sampling and Signature Sound: Protection Under Copyright and Non-Copyright Law*, 6 U. MIAMI ENT. & SPORTS L. REV. 61, 64-66 (1989); Tamara J. Byram, Note, *Digital Sound Sampling and a Federal Right of Publicity: Is It Live or Is It Macintosh?*, 10 COMPUTER/L.J. 365, 370-71 (1990); Maura Giannini, Note, *The Substantial Similarity Test and Its Use in Determining Copyright Infringement Through Digital Sampling*, 16 RUTGERS COMPUTER & TECH. L.J. 509, 510-12 (1990); Thomas C. Moglovkin, Note, *Original Digital: No More Free Samples*, 64 S. CAL. L. REV. 135, 137-40 (1990); David Small, Comment, *To Catch a Thief: Unauthorized Digital Sampling of Copyrighted Musical Works*, 17 T. MARSHALL L. REV. 83, 85-87 (1991); Ronald Mark Wells, Comment, *You Can't Always Get What You Want But Digital Sampling Can Get What You Need!*, 22 AKRON L. REV. 691, 699-700 (1989).

4. By 1986 digital sampling had been around long enough to "[begin] to change the way music is made." Jon Pareles, *Digital Technology Changing Music*, N.Y. TIMES, Oct. 16, 1986, at C23. Numerous hit recordings had used the new technology, including Yes's "Owner of a Lonely Heart" and Stevie Wonder's "Part-Time Lover," and sampled artists could already be heard to complain—including (somewhat ironically) Yes's lead singer, Chris Squire. *Id.*

5. One of the first music sampling machines to become widely available was the Fairlight C.M.I., introduced in 1979 with a price of \$28,000. Gregory Albright, *Digital Sound Sampling and the Copyright Act of 1976: Are Isolated Sounds Protected?*, 38 COPYRIGHT L. SYMP. (ASCAP) 47, 52 (1992). The first relatively inexpensive sampler (priced under \$1,700) appeared in 1985. McGraw, *supra* note 3, at 149.

6. Federal statutory copyright law is codified at 17 U.S.C. §§ 101-1010 (1988 & Supp. V 1993). Major amendments to the 1976 Copyright Act include the Computer Software Copyright Act of 1980, Pub. L. No. 96-517, §§ 10, 101, 117, 94 Stat. 3015, 3028 (1980); the Record Rental Amendment of 1984, Pub. L. No. 98-450, 98 Stat. 1727 (1984); the Semiconductor Chip Protection Act of 1984, Pub. L. No. 98-620, 98 Stat. 3347 (1984); the Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (1988); the Satellite Home Viewer Act of 1988, Pub. L. No. 100-667, 102 Stat. 3949 (1988); the Visual Artists Rights Act of 1990, Pub. L. No. 101-650, 104 Stat. 5128 (1990); the Architectural Works Copyright Protection Act, Pub. L. No. 101-650, 104 Stat. 5133 (1990); the Computer Software Rental Amendments Act of 1990, Pub. L. No. 101-650, 104 Stat. 5134 (1990); and the Audio Home Recording Act of 1992, Pub. L. No. 102-563, 106 Stat. 4237 (1992).

An interesting argument has been advanced that when a sampler makes an intermediate copy—that is, copies from a source, manipulates the sample, then incorporates the sample into her own work—the sampler per se violates the Copyright Act. See William Sloan Coats & David Harrison Kramer, *Not As Clean As They Wanna Be: Intermediate Copying in Acuff-Rose v. Campbell*, 16 HASTINGS COMM. & ENT. L.J. (forthcoming 1994). According to Coats and Kramer, when a sample is made, one can presume that an intermediate copy is the means by which the source is transformed into the final, manipulated product. This intermediate copy, the authors argue, is *itself* an infringement of rights. See 17 U.S.C. § 114 (1988). Whether this argument would be accepted by a court, however, remains to be seen.

there are no legislative criteria governing sampling. Furthermore, disputes involving music samplers have largely remained out of the courts;⁷ as a result, no judicial standards have been established.

On December 17, 1991, the United States District Court for the Southern District of New York decided the first music sampling case to proceed through trial, *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*⁸ In *Grand Upright Music*, plaintiff was the copyright owner of the song "Alone Again (Naturally)," made famous in a 1972 recording by singer-songwriter Raymond "Gilbert" O'Sullivan. Plaintiff brought suit to enjoin the "improper and unlicensed" use of the song by rap artist Biz Markie in "Alone Again," a track appearing on the artist's album *I Need a Haircut*.⁹ In the song, Biz used a digital sample of ten seconds of music from "Alone Again (Naturally)."¹⁰ In a terse four-page opinion, United States District Court Judge Kevin Thomas Duffy granted the injunction and referred the defendants—Biz, his publisher, his producers, and his record label, among other entities—to the United States Attorney for possible criminal prosecution.¹¹

7. In the absence of guidelines, two ways of dealing with the legal ramifications of using samples are available to the sampler. First, the sampler may compile a list of all sampled works, determine the owner of the copyright for each work, and negotiate permission to use it. See Note, *A New Spin on Music Sampling: A Case for Fair Pay*, 105 HARV. L. REV. 726, 727-28 (1992). This method has become standard operating procedure at many record companies. *Id.* Because this process is often slow and expensive, the record sometimes spends months before release in a legal limbo which has been dubbed "sample hell." Havelock Nelson, *Dissed by Pirates, Dogged by "Sample Hell," a Maturing Art Form Fights for Respect*, BILLBOARD, Nov. 28, 1992, at R3, R24.

Second, the sampler may be able to get away with releasing an album with uncleared samples, gambling either that the owner of the copyright of the sampled work will find it too bothersome or unprofitable to sue, or that the uncleared samples will not come to the attention of the copyright owner. Richard Harrington, *The Groove Robbers' Judgment: Order on "Sampling" Songs May Be Rap Landmark*, WASH. POST, Dec. 25, 1991, at D1, D7. One expert opined that this route might be chosen in as many as 50% of the cases. *Id.* at D7. If the sampler chooses the second option and a suit follows, the sampler may settle with the copyright owner, in effect admitting guilt. See Jason H. Marcus, Note, *Don't Stop That Funky Beat: The Essentiality of Digital Sampling to Rap Music*, 13 HASTINGS COMM. & ENT. L.J. 767, 782-83 (1991) (discussing two of the more well-known suits and noting the rapidity of settlement).

While many of the well-known suits involve the sampled artists themselves, see *id.*, the threat of a lawsuit comes not just from sampled artists. For example, one publishing house, EMI Music Publishing, employs six people solely to listen to newly-released records, in an attempt to find unauthorized samples of its copyrighted songs so that it can pressure the artists and record companies to pay for their use. John Leland, *The Moper vs. The Rapper*, NEWSWEEK, Jan. 6, 1992, at 55.

8. 780 F. Supp. 182 (S.D.N.Y. 1991).

9. *Id.* at 183.

10. *Id.*

11. *Id.* at 185.

Both the legal and the performing arts communities eagerly awaited the outcome of this case.¹² Much was at stake. On one side, sampled artists stood ready to assert their rights to protect their works; the vitality of rap music would be threatened by an adverse decision. On the other, samplers looked forward to practicing their craft without being haunted by the specter of litigation; they anticipated "open season" on artists' back catalogs. Even if neither of these extremes was a likely result, at least the court had an opportunity to provide much-needed guidance to samplers and the lawyers who represent them. Unfortunately, the comparatively unique facts of the case, combined with the court's apparent disinclination to discuss applicable standards of law or to provide guidance for parties in future lawsuits, rendered the potentially landmark decision of little value either as precedent or advice.

Part I of this Note discusses the facts of *Grand Upright Music*. Part II critiques the text of the case itself and discusses some of the ruling's aftereffects. Part III argues that the court failed to realize the significance of the issues at hand and, in doing so, missed an opportunity to provide sorely needed legal guidance in the area of digital sampling. Finally, Part IV proposes a possible solution to the issues presented by digital sampling, with an eye toward protecting the rights of both the sampled artists and the samplers.

I. The Case

Biz Markie recorded "Alone Again" in March 1991.¹³ The musical portion of the song consists of a digital sample of the first eight bars of Gilbert O'Sullivan's "Alone Again (Naturally)," comprising about ten seconds of music.¹⁴ This sample is continually looped so that the same ten seconds of music are heard over and over for the length of the song.¹⁵ Biz raps over this background, repeating variations of the titular phrase as a chorus.¹⁶ Completing the track is a simple drum beat.¹⁷

In July 1991, after the recording of the song but before its release, Biz's attorney forwarded a cassette recording of "Alone Again" to Terry O'Sullivan, Gilbert's brother and representative of Gilbert's American interests, seeking permission to use the sample.¹⁸ On Au-

12. See Robert G. Sugarman & Joseph P. Salvo, *Sampling Litigation in the Limelight*, N.Y. L.J., Mar. 16, 1992, at 1, 5.

13. *Id.* at 1.

14. Harrington, *supra* note 7, at D7.

15. *Id.*

16. Sugarman & Salvo, *supra* note 12, at 5.

17. Harrington, *supra* note 7, at D7.

18. *Id.*

gust 27, 1991, however, before Terry could respond, Warner Brothers Records released *I Need a Haircut*.¹⁹

Terry O'Sullivan then wrote a letter to Biz's attorney, Theodore Weis, demanding that "Alone Again" be deleted from the album or, in the alternative, that the album itself be withdrawn from distribution.²⁰ According to Terry, Weis called him after receiving the letter to explain that Biz had made the decision to release the album against Weis's advice.²¹ Weis subsequently sent Terry a letter, dated October 27, 1991,²² that expressed his client's "[sincere] regrets that the new composition was released" without permission." The letter asserted, however, that Terry had "implied that consent 'would be obtained for an agreed price,'" and "[i]f he would have told [Biz] to refrain from using samples of the original composition . . . he would have heeded [the] request."²³ Following unsuccessful attempts to have the album removed from the market, Terry brought suit.²⁴

Each side saw the case in equally stark terms. "At the end of this case . . . O'Sullivan will be singing that song all over again," averred attorney Robert W. Cinque, retained to represent Biz and his fellow defendants at trial.²⁵ Cinque indicated that the defense would be based on an incomplete chain of title argument regarding the copyright.²⁶

On the other side, Terry O'Sullivan "warned [Biz] that he should not be optimistic."²⁷ Joseph D. "Jody" Pope, representing Terry and Gilbert O'Sullivan, noted that a dispute over the rights to the song had arisen before and had been resolved in Gilbert's favor, when a British court ordered Gilbert's former manager to give the publishing and master recording rights back to him.²⁸ This made the infringe-

19. See Larry Flick, *Seger, Metallica, Williams Offer More Heat in August*, BILLBOARD, Aug. 3, 1991, at 5. Critical appraisals of the record were often unforgiving: "tame, low-impact . . . rhythmically slack and mush-mouthed," *Album Reviews*, BILLBOARD, Sept. 14, 1991, at 86; "[contains] nothing really as catchy . . . [as anything] from his last album," Gil Griffin, *The Latest Moves From Rap's Lightest*, WASH. POST, Aug. 23, 1991, Weekend, at N16, N19; "after a while his one-dimensional thumping-as-music and five-minute listing of friends becomes dull," James Muretich, *Recent Releases*, CALGARY HERALD, Sept. 8, 1991, at B7. Despite its naysayers, however, the album reached Number 51 on *Billboard* magazine's Top Rhythm and Blues Albums chart. *Top R&B Albums*, BILLBOARD, Sept. 28, 1991, at 32.

20. James Barron, *Composer, Who Knows He's Heard That Song Before*, SUES, N.Y. TIMES, Nov. 29, 1991, at B3; Sugarman & Salvo, *supra* note 12, at 1.

21. Barron, *supra* note 20, at B3.

22. Sugarman & Salvo, *supra* note 12, at 5.

23. Barron, *supra* note 20, at B3.

24. Sugarman & Salvo, *supra* note 12, at 5.

25. Barron, *supra* note 20, at B3.

26. *Id.*

27. Harrington, *supra* note 7, at D7.

28. *Id.*

ment by Biz particularly galling to the O'Sullivans.²⁹ According to Pope, "[The issue is] dirt simple. . . . You can't use somebody else's property without their consent. . . . [Sampling] is a euphemism . . . for what anybody else would call pickpocketing."³⁰

III. The Court's Decision

A. Itself

Michael F. Sukin, co-counsel for the O'Sullivans, correctly characterized the court's resolution of the dispute as "a rout of the defendants and a complete vindication of O'Sullivan's position."³¹ The court appeared to accept every argument the plaintiffs made and reject every defense the defendants submitted. A close look at the opinion reveals how the court arrived at the decision.

Its first four words—"Thou shalt not steal"—contain the opinion's first and only reference to any authority or precedent.³² To the court, sampling equaled theft. Since Biz had already admitted to using the sample, the only issue remaining was who owned the copyright to the composition and the master recording.³³ Three categories of evidence satisfied the court that plaintiff's claim of ownership was valid: certificates of copyright and deeds that transferred its title to plaintiff; testimony from Gilbert O'Sullivan himself regarding his authorship and performance; and letters from defendants to the O'Sullivans requesting permission to use the sample.³⁴

Defendants challenged the admission of the first category of evidence. A challenge to the admission of the certificate of copyright, on the grounds that it had not been "authenticated,"³⁵ was rejected by the court. In rejecting the challenge, the court strongly hinted that it was frivolous.³⁶ Efforts to contest the introduction of the transfer of title documents were also fruitless.³⁷

29. *Id.*

30. *Id.*

31. Michael F. Sukin, *Rappers Shouldn't Bash Victor in Sampling Suit: O'Sullivan Was Only Defending His Rights*, BILLBOARD, June 6, 1992, at 6.

32. *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182, 183 & 183 n.1 (S.D.N.Y. 1991) (quoting *Exodus* 20:15, the Seventh of the Ten Commandments).

33. *Id.* at 183.

34. *Id.* at 183-84.

35. *See* FED. R. EVID. 902.

36. The court opined that defendants' counsel never really "[believed] that the certificate was anything less than a true and complete copy of the public record." *Grand Upright Music*, 780 F. Supp. at 184.

37. The court characterized one ground of the defendants' challenge as surprise based on inadequate (and inexcusable) preparation, and another as reliance on an incorrect interpretation of the law. *Id.*

Regarding the second category of evidence, the court relied on Gilbert O'Sullivan's testimony that Grand Upright Music owned the copyright. The court noted that "[t]here can be no one more interested in the . . . copyright than a person in Gilbert O'Sullivan's position,"³⁸ and as such he was "thoroughly credible and believable."³⁹ In addition, not only did defendants' counsel fail to dispute Gilbert's testimony, but he also evidently concentrated his cross-examination on the legally irrelevant issue of Gilbert's motive for refusing to license the use of his song.⁴⁰

The court found the third category of evidence most dispositive. The very act of requesting permission to use the sample, the court stated, evidenced defendants' belief that plaintiff held the copyright: "One would not agree to pay to use the material of another unless there was a valid copyright! What more persuasive evidence can there be!"⁴¹ The court said that obtaining the license was "necessary" and an "obligation" and inferred from defendants' conduct that they were knowingly breaking the law and trampling other people's rights in an effort "to sell thousands upon thousands of records."⁴² It was this "callous disregard for the law"⁴³ that moved the court to refer the matter to the United States Attorney for possible criminal prosecution.⁴⁴

In response to defendants' argument that digital sampling was a widespread practice in rap music, the court said that attempts to excuse lawlessness by noting a common disregard for the law are always destined for abject failure—the argument was "totally specious . . . [Its] mere statement . . . [was] its own refutation."⁴⁵ Thus, the court granted the injunction.⁴⁶

Counsel for Biz vowed to appeal the decision,⁴⁷ but two weeks later a settlement was announced.⁴⁸ Although its terms were confidential,⁴⁹ the settlement reportedly included a "substantial" cash pay-

38. *Id.* Presumably, this was because O'Sullivan wrote the lyrics and melody of the song and was the first to perform it.

39. *Id.*

40. *Id.*

41. *Id.*

42. *Id.* at 185.

43. See *supra* text accompanying notes 5-7 (regarding the lack of legislation or judicial sampling "law").

44. *Grand Upright Music*, 780 F. Supp. at 185.

45. *Id.* at 185 n.2.

46. *Id.* at 185.

47. Ronald Sullivan, *Judge Rules Against Rapper in "Sampling" Case*, N.Y. TIMES, Dec. 17, 1991, at B2.

48. Barry Layne, *Warner Bros. Settles Biz Copyright Case*, BPI Entertainment News Wire, Dec. 31, 1991, available in LEXIS, Nexis Library, BPI File.

49. *Id.*

ment.⁵⁰ Warner Brothers Records took out an "unprecedented" ad in *Billboard* magazine, urging retailers to return any and all of some 200,000 shipped copies of *I Need a Haircut* that had not yet been sold.⁵¹ Subsequent pressings of the album, reportedly according to the terms of the settlement, have had the track "Alone Again" deleted.⁵² In short, the result was a total victory for Gilbert and Terry O'Sullivan.

B. Analysis

To a certain extent both the plaintiffs' success and the vitriolic nature of the court's decision were predictable and understandable. From the sampler's perspective, the case exemplifies how not to sample.⁵³ Throughout the affair, a number of questionable moves were made by Biz, his record label, and his counsel.

First, Warner Brothers, for some unknown reason, released the album after asking for Terry's permission, but before receiving his reply. This bizarre act supported an inference that the label was interested in a quick profit and belied any claim of good faith that the label might have made.⁵⁴ Warner Brothers certainly could have avoided the entire mess by bargaining with Terry for the rights, and might have avoided a claim by not contacting the O'Sullivans at all.⁵⁵ The reasoning of the decision implies that the court might have been more forgiving—or at least more uncertain about the equities of the case and therefore more charitable—had Biz simply blindsided the O'Sullivans.

Second, Biz's counsel attempted a defense that was at best unusual and at worst indefensible. Biz's counsel likely was frustrated by the lack of precedent in the area and felt he had to fashion some unique tools to help his client. However, the lack of precedent fails to fully explain the ineffectiveness of the defense. Specifically, the court was understandably piqued by three facets of the defense: the complete lack of pretrial discovery; the peculiar reliance by counsel on two erroneous interpretations of the law; and the cross-examination

50. Chuck Philips, *Songwriter Wins Large Settlement in Rap Suit*, L.A. TIMES, Jan. 1, 1992, at F1, F12.

51. *Id.* at F12.

52. *Id.*

53. For a worthwhile examination of how one *might* sample, see Whitney C. Broussard, Comment, *Current and Suggested Business Practices for the Licensing of Digital Samples*, 11 LOY. ENT. L.J. 479, 480-502 (1991). Members of the industry were hardly charitable to Biz and his attorneys in characterizing their performance. See, e.g., Steve Hochman, *Judge Raps Practice of "Sampling"*, L.A. TIMES, Dec. 18, 1991, at F1, F2 ("Biz did a dumb thing . . ."); Fred Shuster, *Music Samplers Rethink Options After Ruling*, HOUS. CHRON., Feb. 2, 1992, at 30 ("What Markie did was dumb.").

54. See Sugarman & Salvo, *supra* note 12, at 5.

55. See *supra* note 7.

attempt to elicit Gilbert's motive for not granting the license.⁵⁶ The decision teaches attorneys an important, but self-evident lesson—do not be surprised to lose a case when you appear unprepared and behave unprofessionally.

C. Fallout

Reaction in the performing arts community to *Grand Upright Music* has taken several forms. One effect of the ruling has been a noticeably more hostile climate for samplers. This climate was manifested by a renewed round of litigation. Four days before the *Grand Upright Music* decision, perhaps in anticipation of an adverse ruling, dance music producer Jellybean Benitez filed suit over an unauthorized sample.⁵⁷ Four days after the ruling, Tuff City Records, a New York-based independent label, sued Sony Music Inc. and the Sony-distributed label Def Jam Records over a drum sample.⁵⁸ About a month later, Bridgeport Music, a publishing company, brought suit to enjoin the manufacture and sale of a hit record containing a sample of a recording to which it owned the copyright.⁵⁹ A group calling itself "The Association of Parliament/Funkadelic Members 1971-83" filed a massive suit alleging that it owns copyrights to recordings created by George Clinton that have been sampled by at least sixty-two record-

56. *Grand Upright Music*, 780 F. Supp. at 184.

57. Jellybean Prods., Inc. v. Atlantic Records Corp., No. 91-8411 (S.D.N.Y. filed Dec. 13, 1991). The complaint states causes of action for copyright infringement and conversion. Stan Soocher, *Sampling Ruling Leaves Questions; Between Rap and a Hard Place*, ENT. L. & FIN., Jan. 1992, at 7. Ironically, the same judge who adjudicated *Grand Upright Music* was assigned the case. *Id.*

58. The complaint alleged that producer Marlon "Marley Marl" Williams illegally sampled drums from a 1973 recording by the Honeydrippers called "Impeach the President," and incorporated them into two recordings by rap star LL Cool J—"Around the Way Girl" and "Six Minutes of Pleasure." Barbara Davies, *Tuff City Sues Sony, Def Jam Over Sample on Cool J Singles*, BILLBOARD, Jan. 11, 1992, at 71. The suit has since settled. See Melinda Newman & Chris Morris, *Sampling Safeguards Follow Suit: Biz Markie Ruling Prompts Labels' Action*, BILLBOARD, May 23, 1992, at 1, 80.

59. Janine McAdams, *New Sampling Suit Targets Terminator X*, BILLBOARD, Feb. 15, 1992, at 12, 89. The complaint also sought "all gains, profits, and advantages derived by the defendant from the infringing work" and asked for damages in excess of \$500,000. *Id.* at 12. The case was dismissed after Bridgeport Music's ownership of the copyright was questioned. See Janine McAdams, *Eric B. & Rakim Sued Over Funkadelic Sample*, BILLBOARD, Dec. 5, 1992, at 12 [hereinafter McAdams, *Eric B. & Rakim*].

ing acts.⁶⁰ Most recently, Bridgeport Music and label Westbound Records have sued over the use of a sample.⁶¹

Had the court in *Grand Upright Music* squarely confronted the issue, much of this subsequent litigation could have been avoided. Rather than assuming that sampling was copyright infringement from the beginning, the court should have examined what interests are at stake when a sampler samples, in order to decide when samples rise to the level of actual infringement. The decision rendered *all* unauthorized sampling legally suspect; no distinction seemingly could be made between small bites and large cuts, between instantly recognizable "trademarks" and impossibly obscure and mundane banalities. Instead the inquiry became cut and dried: Does someone else own the copyright? If so, then any unlicensed sample is an infringement.

Predictably, the court's overly broad decision in *Grand Upright Music* has made sampling a hazardous occupation. Recordings featuring samples must spend more time in limbo while every sample is cleared.⁶² In some cases, rappers have eschewed samples entirely, preferring to use live musicians rather than suffer the potential conse-

60. See Janine McAdams, *Clinton C'rights at Center of Lawsuit: Montes Takes Aim at Bridgeport, Others*, BILLBOARD, Sept. 19, 1992, at 8. The suit alleges, among other things, fraud and deceit, breach of contract, RICO violations, and 102 counts of copyright infringement. *Id.*

61. See McAdams, *Eric B. & Rakim*, *supra* note 59. A sample from the Funkadelic song "No Head, No Backstage Pass" allegedly showed up in Eric B. & Rakim's 1988 recording "Lyrics of Fury." *Id.*

62. An anonymous record company executive tells the story of a group with whom he worked who wanted to use, as he put it, "three seconds of Billie Holiday and the line 'Toto, I've got a feeling we're not in Kansas anymore . . .'" Sheila Rule, *Record Companies Are Challenging "Sampling" in Rap*, N.Y. TIMES, Apr. 21, 1992, at C13, C18 (quoting from Metro-Goldwyn-Mayer's movie *The Wizard of Oz*). The executive explains that because of *Grand Upright Music*:

[W]e had to make sure we had written clearance on everything beforehand. In every case of obvious sampling, we were able to contact people. But [in the case of the aforementioned samples], well, people probably wouldn't have noticed.

When we sent the "Oz" sample to people who own the rights, we had to point out where it was on the record and then they rejected it because they said the record was too vulgar. The Billie Holiday snippet was so obscure we had to figure out who the publisher was. It was an arcane procedure and it was impossible to get anyone to sign off on it, so we had to remove it. Now a record we were to come out with within two weeks is coming out six weeks later, after a lot of time, money and legal fees and a lot of problems. And we are like the tip of the iceberg.

Id. at C18.

Some groups, such as Big Audio Dynamite, have composed unique and valuable music by incorporating hundreds of samples from wildly diverse sources, creating a virtual aural collage. It is not hard to see how "sample hell," *see supra* note 7, could spell the end of such art.

quences of an adverse judgment.⁶³ These difficulties suggest a future in which the risks of sampling are so great that the technique will virtually perish as an art form.

On the other hand, the facts of *Grand Upright Music* are such that subsequent litigants would be hard-pressed to rely on it as precedent. Performers will rarely ask permission to use a sample and then release the album without authorization to use the sample; in so doing, Biz made it easy for the court to throw the book at him. Furthermore, "Alone Again" did not involve the use of a mere drum beat or shout lifted from an obscure recording; the sample was instantly recognizable, and it constituted the entire musical accompaniment to Biz's rap. Without use of the sample, there would have been no music at all.⁶⁴

The significance of *Grand Upright Music*, however, cannot be denied—a judge in one of the most important trial courts in the federal system has declared unauthorized sampling to be against the law. Moreover, as of this date, *Grand Upright Music* is the only source of legal standards with regard to sound sampling in existence.⁶⁵

63. LL Cool J, Hammer, and Naughty by Nature, among other acts, have started to rely heavily on live musicians. See David Landis & James T. Jones IV, *Court Fights Over Rap Music Sampling*, USA TODAY, Jan. 16, 1992, at 2D; Rule, *supra* note 62, at C18.

64. Michael Sukin maintains that Gilbert's lawsuit was a principled stand "by a solitary, artistic person who did not like the idea that somebody was using the song that *he* wrote and the recording that *he* made without his permission," not "some megacompany saying, 'This is my property. Either keep your hands off or pay a big fee.'" Sukin, *supra* note 31, at 6. Furthermore, in the past, many labels and publishers, fearful of opening a can of worms, and perhaps mindful of the prevalence of sampling, had been reluctant to bring suit. See, e.g., Marcus, *supra* note 7, at 781-83. However, even after *Grand Upright Music*, the doctrine of "unclean hands" may still be a deterrent. See McGraw, *supra* note 3, at 168.

65. The second case to confront the issue directly, *Jarvis v. A & M Records*, 827 F. Supp. 282 (D.N.J. 1993), was decided four months later. In this copyright infringement action, the court held that the issue of whether a sample was a significant portion of the song sampled was a question of fact and denied the defendants' motion for summary judgment on the claim.

In *Jarvis*, plaintiff wrote and recorded a song entitled "The Music's Got Me" in 1982. *Id.* at 286. Defendants Robert Clivilles and David Cole incorporated samples of plaintiff's recording into their song "Get Dumb! (Free Your Body)" in 1989, and plaintiff brought suit for copyright infringement in 1990. *Id.*

On the defendants' motion for summary judgment, the court ruled that a triable issue of fact existed whether defendants' sample of plaintiff's work constituted a sufficiently distinctive and original expression of an idea (and was therefore covered by plaintiff's copyright). *Id.* at 291-92. The court framed the issue in terms of "whether the defendant appropriated, either quantitatively or qualitatively, 'constituent elements of the work that are original,' such that the copying rises to the level of an unlawful appropriation . . . [which in turn depends on] the question . . . whether the value of the original work is substantially diminished by the copying." *Id.* at 291 (quoting *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991)).

III. The Rationale—Some Deconstruction

A. Sampling as Theft

The *Grand Upright Music* court's assertion that sampling is a form of theft reflects a widely held belief.⁶⁶ Most, if not all, opponents of the practice decry it on the ground that sampling constitutes an unlawful appropriation of something—be that something the sound itself or the exclusive right to its use. For the characterization of sampling as theft to prevail, however, a plaintiff must have had a property interest, and the interest must have been infringed in some way.⁶⁷

Perhaps the reason why the court pointed only to the Bible in condemning sampling as theft is because the *legal* support for such an assertion is flimsy. No matter what is asserted as the object of theft, this Subpart argues that a sampled artist is not necessarily deprived of anything to which she is legally entitled.

(1) Theft of Sound

One commentator has asserted that digital sampling is just another form of "piracy."⁶⁸ This analogy is inaccurate. The pirate generally duplicates an entire work, such as an album or a motion picture. The pirate then mass-produces copies and sells them, thereby taking

The *Jarvis* court's discussion of *Grand Upright Music* actually contains more legal groundwork than *Grand Upright Music* itself. United States District Judge Harold A. Ackerman identified the issue in *Grand Upright Music*, as well as in *Jarvis* itself, as involving "fragmented literal similarity," where the similarity between the two works is not comprehensive, but results from copying individual elements. *Id.* at 289 (citing MELVILLE B. NIMMER & DAVID NIMMER, *Nimmer on Copyright* § 13.03[A][2] (1991)). A cause of action based on fragmented literal similarity "depends on the truth of the principle that 'the value of a work may be substantially diminished even when only a part of it is copied, if the part that is copied is of great qualitative importance to the work as a whole.'" *Id.* at 291 (quoting *Werlin v. Reader's Digest Ass'n*, 528 F. Supp. 451, 463 (S.D.N.Y. 1981)).

The court rejected defendant's argument that substantial similarity requires that an average listener be prone to confuse one work for the other. *Id.* at 290. However, the court did not make clear how the value of a work might be diminished if this were not the case.

66. See, e.g., Small, *supra* note 3, at 83 (comparing samplers to thieves in title of comment); J.C. Thom, Comment, *Digital Sampling: Old-Fashioned Piracy Dressed Up in Sleek New Technology*, 8 LOY. ENT. L.J. 297, 331-36 (1988) (characterizing samplers as thieves); Wells, *supra* note 3, at 705 ("Ultimately, digital samplers are thieves.").

67. The Model Penal Code defines criminal theft as the act of "unlawfully [taking], or [exercising] unlawful control over . . . property of another with purpose to deprive" that person of the property. MODEL PENAL CODE § 223.2 (1962); cf. MARSHALL A. LEAFFER, *UNDERSTANDING COPYRIGHT LAW* § 9.2 (1989) (listing elements of a copyright infringement suit as ownership of copyright by plaintiff and copying by defendant).

68. Thom, *supra* note 66, at 309. Defined broadly, "piracy is the unauthorized duplication of the sounds on copyrighted records, tapes, cassettes, compact discs, or any other form of sound storage." *Id.*

money directly out of the artist's pocket. Samplers, on the other hand, generally copy small pieces of a work and use them, often combined with samples from many other works, to create a new cohesive whole.⁶⁹ In contrast to the pirate, the sampler does not merely duplicate the efforts of the sampled artist; the sampler, by using her creativity, has added something that makes the new song distinct from the original.⁷⁰

(2) *Theft of Personality*

Other commentators have argued that when the sampled sound is clearly recognizable as having been created by another artist, the result is an appropriation of that artist's creative persona and an infringement has occurred.⁷¹ This argument sounds both in the familiar copyright notion of substantial similarity⁷² and in the element of unfair competition law termed the right of publicity.⁷³

The doctrine of substantial similarity arose from a desire to reward original expression.⁷⁴ When a later work uses an earlier work as a referent, but adds "nothing original to the world's store of literature,

69. What truly creative samplers do is akin to what visual artists do when they create a collage. See Don Snowden, *Sampling: A Creative Tool or License to Steal?*, L.A. TIMES, Aug. 6, 1989, Calendar, at 61, 62; see also *supra* note 62.

70. See also Arn, *supra* note 3, at 74; Wells, *supra* note 3, at 699. The fact that samplers create a distinct work also defeats the argument that samplers cut into the sampled artist's market for her recording, thus depriving the sampled artist of her profit. To illustrate the fallacy of this approach, if Gilbert O'Sullivan were to argue that Biz unfairly infringed on the market of potential buyers of "Alone Again (Naturally)," then it would follow that had he reissued the single, consumers would have purchased it at the same or a similar rate as they bought Biz's album. No one could plausibly argue that buyers of Biz's album would be likely to purchase O'Sullivan's single. If anything, Biz broadened O'Sullivan's audience by introducing the song to an audience that would neither have heard it nor would care to hear it. Biz must have added something to the sample to make it attractive to consumers. This "added something" qualifies Biz's "Alone Again" as a new, distinct work. See Sherri Carl Hampel, Note, *Are Samplers Getting a Bum Rap?: Copyright Infringement or Technological Creativity?*, 1992 U. ILL. L. REV. 559, 578-79 (1992).

71. See, e.g., Byram, *supra* note 3, at 384-85.

72. When a defendant has copied a substantial and material portion of the plaintiff's work, the two works are said to be substantially similar. LEAFFER, *supra* note 67, § 9.5[A]. For a discussion of substantial similarity, see *id.* §§ 9.5-9.7. Substantial similarity has also been addressed in several treatments of digital sampling issues. See, e.g., Albright, *supra* note 5, at 82-87; Allen, *supra* note 3, at 190-92; Arn, *supra* note 3, at 75-78; Giannini, *supra* note 3, at 516-25; Small, *supra* note 3, at 95-96.

73. The right of publicity refers to the twin rights to prevent commercial use of one's identity and to grant an exclusive privilege to use one's identity to a particular firm in a defined market. J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1.7 (1989). For discussions of the right of publicity in a digital sampling context, see Allen, *supra* note 3, at 195-96; Byram, *supra* note 3, at 374-89; McGiverin, *supra* note 3, at 1738-45; Moglovkin, *supra* note 3, at 166-70; Small, *supra* note 3, at 109-11.

74. PAUL GOLDSTEIN, *COPYRIGHT: PRINCIPLES, LAW AND PRACTICE* § 2.2.1 (1989).

music or art," the two works are said to be substantially similar to each other, and the creator of the later work is deemed to have infringed on the copyright of the creator of the earlier work.⁷⁵

Substantial similarity simply does not apply to cases involving music samplers. Music sampling is fundamental to rap music, and the artistic value of rap music can scarcely be questioned.⁷⁶ To argue substantial similarity of a rap recording to the recordings from which its samples come is to argue that rap music has no independent artistic value.

Similarly, the right of publicity arises in a commercial context.⁷⁷ The right of publicity exists to prevent the improper use of another's

75. *Id.* § 7.1.2.

76. Perhaps the easiest way to demonstrate that rap music is on an artistic par with rock, country and western, and other forms of popular music is to note that Grammy Awards are given in the category of rap music as well as in each of these other genres. Moreover, in *Luke Records, Inc. v. Navarro*, 960 F.2d 134 (11th Cir. 1992), a review of a district court's declaratory judgment that the rap group 2 Live Crew's record *As Nasty As They Wanna Be* was obscene, the Eleventh Circuit noted that expert testimony from music critics and scholars validated the artistic and cultural merit of rap music and lyrics. *Id.* at 135-37.

77. The first case to recognize this right was *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2nd Cir.), *cert. denied*, 346 U.S. 816 (1953). In *Haelan Laboratories*, the plaintiff and the defendant were rivals in the manufacture of baseball cards. Plaintiff alleged in the suit that defendant lured away baseball players who had granted the exclusive right to display their likenesses to plaintiff. *Id.* at 867. Defendant argued that the only right a person has in his or her likeness is the right of privacy, which only covers hurt feelings when a publication is made without the person's consent. *Id.* at 868. The court held for plaintiff:

[A] man has a right in the publicity value of his photograph Whether it be labelled a "property" right is immaterial; for here, as often elsewhere, the tag "property" simply symbolizes the fact that courts enforce a claim which has pecuniary worth. . . .

[I]t is common knowledge that many prominent persons . . . would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways.

Id.

Judge Alex Kozinski of the Ninth Circuit Court of Appeals recently reflected on what he perceived as a rise in the assertion of rights to one's identity. In his dissenting opinion in *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512 (9th Cir. 1993) (order rejecting suggestion for rehearing en banc), he states:

Private property, including intellectual property, is essential to our way of life. It provides an incentive for investment and innovation; it stimulates the flourishing of our culture; it protects the moral entitlements of people to the fruits of their labors. But reducing too much to private property can be bad medicine. . . .
. . . Overprotecting intellectual property is as harmful as underprotecting it. Creativity is impossible without a rich public domain. Nothing today, likely nothing since we tamed fire, is genuinely new: Culture, like science and technology, grows by accretion, each new creator building on the works of those who came before. Overprotection stifles the very creative forces it's supposed to nurture.

likeness or identity for advertising or commercial purposes.⁷⁸ Thus, for example, a sample of "Alone Again (Naturally)" used in a beer commercial would be a clear infringement of Gilbert's right to publicity. However, a rap recording is neither a commercial nor an advertisement.

(3) *Theft of Money*

The argument that samplers somehow deprive the creators of the sampled sounds of the fruits of their labors has several roots, all of which sound in a judicially created affirmative defense to copyright infringement—fair use. Leaffer characterizes fair use as "an equitable rule of reason to be applied where a finding of infringement would either be unfair or undermine 'the progress of science and the useful arts.'"⁷⁹ Three root arguments that sampling deprives the original artist of something fall under the fair use concept. First, samplers get for free what others have to buy—namely, the right to copy. Second, samplers cut into the sampled artist's market by satisfying possible demand for the original recording. Third, samplers can appropriate distinctive, "signature sounds"⁸⁰ without having to pay their creators.

The court completely glossed over the first argument—that samplers get for free what others have to buy. As *Grand Upright Music* was the first sampling case to be decided and the case was decided in the absence of any statutory authority, the court created the right of an artist to control samples of her work. Arguing that sampling infringes upon a right assumes that the "samplee's" right to the sample exists to begin with. The court should have first decided whether the right of an artist to control samples of her work actually exists.

The second argument—that samplers cut into an artist's market—focuses on the (ultimately chimerical) negatives,⁸¹ while ignoring the positives. As a number of commentators have pointed out, often a sampled artist actually enjoys a renaissance of interest in her back cat-

Id. at 1513 (Kozinski, J., dissenting). These thoughts are applicable to intellectual property rights outside the realm of publicity as well.

78. See MCCARTHY, *supra* note 73, § 1.7.

79. LEAFFER, *supra* note 67, § 10.1. The four factors a court will take into account when considering a defense of fair use are: (1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used; and (4) the effect of the use upon the potential market for or value of the copyrighted work. *Id.* § 10.6. The 1976 Copyright Act codified the doctrine at 17 U.S.C. § 107 (1988 & Supp. IV 1992). For discussions of possible fair use defenses by music samplers, see Albright, *supra* note 5, at 90-92; Allen, *supra* note 3, at 197-98; Marcus, *supra* note 7, at 783-85; McGiverin, *supra* note 3, at 1736-38; Note, *supra* note 7, at 736-39; Small, *supra* note 3, at 101-03.

80. See Arn, *supra* note 3, at 61.

81. See *supra* note 70.

alog.⁸² Some artists have been rescued from obscurity by samples of their work.⁸³ Others have seen their careers improbably extended.⁸⁴ Still others have enjoyed an unexpected windfall when a sample contributes to a surprise hit.⁸⁵ These examples demonstrate that an artist's market can actually be enlarged, rather than diminished, through sampling.

In the early days of sampling, commentators focused heavily on the third argument—the appropriation of signature sounds. Some made dire predictions of the end of session musicians. After all, why should one hire a union keyboardist when a sampler can do the work for free?⁸⁶ Ultimately such fears were unfounded.⁸⁷

To illustrate the fallacy of such reasoning in the context of rap music, one need only ask whether Biz would have considered hiring a band to re-create the first eight bars of "Alone Again (Naturally)" if a sample of the work were unavailable. One reason why samplers sample—in particular, why samplers sample from recognizable sources—is that part of the fun of creating and listening to rap music is recognizing and incorporating shared musical experiences. Much of the pleasure of listening to Biz's "Alone Again" comes from recognizing Gilbert O'Sullivan's "Alone Again (Naturally)" as the inspiration for it. Biz *expected* people to make this connection. There is no better

82. See Hampel, *supra* note 70, at 579; David Sanjek, "Don't Have to DJ No More": Sampling and the "Autonomous" Creator, 10 CARDOZO ARTS & ENT. L. REV. 607, 616 (1992).

83. Bobby Byrd, a relatively obscure soul singer primarily known for his association with James Brown, had a minor hit called "I Know You Got Soul" in 1971. Following more than a decade of inactivity, he was rediscovered and his career resuscitated when Eric B. & Rakim built their identically titled song, released in 1987, around a Byrd sample. Byrd has since toured Europe. Hampel, *supra* note 70, at 579.

84. While James Brown languished in prison, interest in his music was augmented by (according to one estimate) over 2,000 songs featuring samples of various Brown recordings. Steve Garbarino, *Culture Vulture*, NEWSDAY, Apr. 26, 1992, at 3. Somewhat ironically, Brown is against the practice of sampling. See Michael W. Miller, *Creativity Furor High-Tech Alteration of Sights and Sounds Divides the Art World*, WALL ST. J., Sept. 1, 1987, at 1, 25 (quoting Brown—"[a]nything they take off my record is mine").

85. The most noteworthy example is the case of Suzanne Vega. She recorded her a cappella "Tom's Diner" in 1987. Subsequently, the group DNA recorded its own backing to the lyric. With Vega's blessing, DNA joined her vocals to its music; the result was a Top Five hit in 1990. See Hampel, *supra* note 70, at 579 n.217.

86. See, e.g., Byram, *supra* note 3, at 366-68; McGiverin, *supra* note 3, at 1726-27; McGraw, *supra* note 3, at 152; Jeffrey S. Newton, Note, *Digital Sampling: The Copyright Considerations of a New Technological Use of Musical Performance*, 11 HASTINGS COMM. & ENT. L.J. 671, 674 nn.14-15 (1989); Wells, *supra* note 3, at 700.

87. To be sure, the commentators had in mind situations where, for instance, rather than hiring a drummer, a sampler could simply sample a drumbeat and loop it, making it sound over and over again. Even so, the advent of sophisticated keyboards and "drum machines" largely renders the sampler a minor threat in the arena of machines replacing people.

way to provide the connection than by digital sampling, because sampling allows exact duplication. Unless the reference to the target is spot-on, note-for-note, the connection does not have the same impact. Having studio musicians duplicate the eight bars would diminish the impact to the point where Biz would have undoubtedly decided to abandon the effort.

B. Gilbert O'Sullivan's Motive for Denying Permission

The cross-examination of Gilbert both nonplussed and exasperated the court. To the judge, Gilbert's reasons for denying a license to use the sample were irrelevant. In a sense, he was correct—nowhere in the elements of a cause of action for copyright infringement lies the requirement that the artist have a good reason for not allowing access to her work.⁸⁸ However, in light of the overarching justification for copyright law, the case can be made that, without sufficient opportunity to experience works of the past, the art of the future may be stunted.⁸⁹ Rap illustrates this well—without samples, an important element of the genre of rap music would cease to exist.⁹⁰

The Copyright and Patent Clause of the United States Constitution provides that Congress may create copyrights in order “[t]o promote the progress of . . . [the] useful arts.”⁹¹ The Supreme Court expressed the purpose of copyright by stating that “[t]he economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors.”⁹² Rewarding the cre-

88. See LEAFFER, *supra* note 67, § 9.2.

89. It may be said in defense of copyrights that they eventually expire. Generally, in the case of works created on or after January 1, 1978, the copyright lasts for the life of the creator of the work, plus fifty years. 17 U.S.C. § 302(a) (1988 & Supp. V 1993). For a discussion of duration and renewal of copyrights, see NIMMER & NIMMER, *supra* note 64, §§ 9.01-9.07. Again, however, one may ask, does the benefit to the creator outweigh the burden to the sampler and to society as a whole?

90. For a discussion of the essentiality of samples to rap, see Marcus, *supra* note 7, at 769-73.

91. U.S. CONST. art. I, § 8, cl. 8.

92. *Mazer v. Stein*, 347 U.S. 201, 219 (1954); see also *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975). This notion is at the foundation of the dominant theory of copyright in the latter half of the twentieth century, the so-called “economic rationale” theory. See LEAFFER, *supra* note 67, § 1.6. The economic rationale of copyright law reflects a tradeoff that society makes with artists: In order to allow artists to recoup their intellectual investment in their work by compensating them for spending their otherwise profitable time creating art, society grants them a limited monopoly for the products of their efforts. See *id.*

ators of artistic works is therefore only a "secondary consideration."⁹³

When a genre will rise or fall depending on the freedom to sample, the law should require a compelling reason as a threshold requirement for denying the right. Gilbert claimed that, although "Alone Again (Naturally)" has been covered⁹⁴ hundreds of times, every cover version was "faithfully sung" according to the spirit of Gilbert's version,⁹⁵ a standard that Biz's "Alone Again" evidently did not meet. Gilbert had the legal right to withhold the license for this reason, but if all artists held such beliefs about the sacredness of their works and of particular interpretations of their works, the process of art creation would be impermissibly impeded, and society would suffer as a result.⁹⁶ The balance that copyright law tries to achieve between the artist's right and society's benefit mandates that sampled artists should be foreclosed from blocking rap music's continued existence.

C. Asking Before Sampling

In rendering the decision for plaintiff, the court was most impressed with the fact that Biz had sought clearance from Gilbert O'Sullivan before using the material on his album. To the court, this was proof that a valid copyright existed.⁹⁷ However, the real issue presented was not whether Grand Upright Music held the copyright to "Alone Again (Naturally)"; rather, the issue was whether the copyright of a song is infringed upon by a sample of that song. Moreover, the court seems to have been completely unaware of the real reason

93. *Mazer*, 347 U.S. at 219 (quoting *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948)); see also *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30, 36 (1939) (stating that using copyright law to promote artistic works is of a lasting benefit to the world).

94. To "cover" a song is to record a "cover version" of it. A "cover version" is an artist's rendition of a song previously recorded by another artist. See Note, *supra* note 7, at 732. Once a record has been distributed, artists who wish to perform cover versions of songs on the record may do so, provided only that they comply with statutory notice and royalty requirements, see 17 U.S.C. § 115(b), (c), and that the cover "not change the basic melody or fundamental character of the work," 17 U.S.C. § 115(a)(2). This compulsory license prevents an artist who originally recorded the song from blocking a subsequent artist's cover—an acknowledgement that granting truly exclusive rights to copyright holders has the potential to inhibit the growth of future art. See also Note, *supra* note 7, at 732.

95. See Sugarman & Salvo, *supra* note 12, at 5.

96. As one commentator has remarked, "The most interesting areas of intellectual property law tend to be just those places in which people are trying to hold on to their creations against those who want the creation unfettered from its master." Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 294 (1988). Hughes cites the example of a production of Samuel Beckett's *Endgame* by the Comedie-Française in 1988. Beckett was so upset by the acting company's interpretation of his work that he successfully halted the production. *Id.* at 295 n.27.

97. *Grand Upright Music*, 780 F. Supp. at 184.

why Biz sought Gilbert O'Sullivan's permission. Because of the lack of legal standards and the questionable status of sampling in general, Biz was merely following a common industry practice of being safe and cautious in the event that samples should be adjudged copyright infringements in the future.⁹⁸ By no means should the court have interpreted this practice to imply that such an arrangement is mandatory. The court's reasoning is illogical. Simply because the statement "if *P*, then *Q*" is true (e.g., if a copyright exists, then a sampler must seek clearance from the original artist), the converse statement "if *Q*, then *P*" (e.g., if a sampler seeks clearance from the original artist, then a copyright exists) does not necessarily follow. Applying such illogic to the safe-sex maxim "if you are HIV-positive, then you must use a condom," the court would reason that if a man wore a condom, then he is HIV-positive.⁹⁹

D. Selling Too Many Records

In the court's estimation, greed was Biz's primary motivation for infringing upon Gilbert O'Sullivan's copyright. Biz was not an artist attempting to create "a whimsical, plaintive piece touching on the subjects of loneliness, love and death"¹⁰⁰; rather, Biz was an opportunist trying to cash in at a *real* artist's expense. Instead of simply relying on what it considered an unauthorized use, the court gratuitously included a reference to the fact that Biz's records sell thousands of copies.¹⁰¹

There is a hint of elitism in this comment. The court implies that the more popular an artist is, the less "worthy" her art is. This directly contravenes a holding by the Supreme Court that courts are not to judge artistic merit when deciding questions of copyrightability.¹⁰²

98. See *supra* note 6; see also Broussard, *supra* note 53, at 479-80 (noting the music industry's "ad hoc approach" to clearing samples).

99. An analogy to another affirmative defense to copyright infringement, parody, is also instructive. The parodist does not need to get permission from the owner of the copyright to the object of the parody. Furthermore, an unsuccessful attempt to get permission does not prejudice the defense. See *Fisher v. Dees*, 794 F.2d 432, 437 (9th Cir. 1986). For a discussion of parody in the context of sampling cases, see Hampel, *supra* note 70, at 570-72.

The Supreme Court has recently decided to answer the question whether 17 U.S.C. § 107, which codifies common-law fair use, encompasses parody as well. *Campbell v. Acuff-Rose Music, Inc.*, 113 S. Ct. 1642 (1993) (granting certiorari).

100. This description of "Alone Again (Naturally)" appeared in plaintiff's post-hearing memorandum. *Sugarman & Salvo*, *supra* note 12, at 5.

101. *Grand Upright Music*, 780 F. Supp. at 185.

102. As Justice Holmes expressed it in 1903:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [works of art], outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author

The popularity of Biz's record should not have had any bearing on the legality of his sample. It should not have even entered into the judgment concerning Biz's motive for using the sample. After all, the goal of "popular" musicians is to appeal to as many people as possible. Why should an artist be penalized for achieving this goal?¹⁰³

IV. A Possible Exit from the Dilemma?

At its heart, the dilemma that digital sound sampling creates is the same problem that copyright law was designed to obviate. Copyright law balances the right of the artist to control access to her work in order both to profit from her time and effort and to preserve the integrity of her work, against the need for society to experience and benefit from art. In the case of sampling, two interests clash: the desire of the artist to capitalize on the market created by her works, and the vitality of an art form that thrives on appropriating as much of what preceded it as possible. Any solution to the issues that sampling raises must take into account both sides.

A. Framing the Solution

By failing to grasp the issue in *Grand Upright Music*, the court unwittingly created a bright-line rule in an area that needed standards instead. The court assumed an answer to the very question it was supposed to decide: Does a sampler need authorization to incorporate a sample into her work? The judge must have wondered what the parties were arguing about; there was not much to say once he decided that point. This explains the paucity of cited authority.

Rather than start by assuming a sample was an infringement, the judge should have posed the following questions: How extensive was the sample? How long did it last? How recognizable was it? How well was the sample incorporated into the song upon which it was based? Would a reasonable person mistake the sample, or the work incorporating the sample, for the source from which it was taken? The court, instead, effectively rendered these questions moot by deciding that *all* unauthorized samples are infringements.

spoke. . . . At the other end, copyright would be denied to [works] which appealed to a public less educated than the judge.

Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251-52 (1903). Even ninety years later, Justice Holmes' reference to "novelty" is eerily applicable. See also LEAFFER, *supra* note 67, § 2.7[C] (discussing the requirement of originality as a prerequisite to copyrightability).

103. It is worth noting that Gilbert O'Sullivan's "Alone Again (Naturally)" stayed at Number One on the *Billboard* Pop chart for six weeks in 1972, eventually selling more than five million copies worldwide. Barron, *supra* note 20. At the time of the decision in *Grand Upright Music*, Biz's *I Need a Haircut* had sold fewer than 200,000 copies. See *supra* text accompanying note 51.

Not every digital sample should constitute an infringement upon the sampled work. However, by the same token, some samples are so reminiscent of the works they sample that they cease to be samples and instead become clones. There exists a spectrum of sampling. At one end resides the solitary James Brown shout, "dropped" once into an eight-minute remix; at the other end are large-scale appropriations such as Hammer's sample of Rick James' song "Super Freak" in his song "U Can't Touch This."¹⁰⁴ The more insignificant the sample, the less obligation should be placed on the sampler to compensate the "samplee"; the more significant, the more the sampler should be faulted if she does not take Hammer's attitude.

Most of the analytical tools used in copyright law to create the necessary balance do not work well with sampling. Fair use has been suggested as a candidate for an affirmative defense, but its very nature makes its practical application difficult.¹⁰⁵ A subgenre of fair use, parody, has also been advanced; it is a poor fit, however, since there is generally no element of lampooning in sampling.¹⁰⁶

Some commentators have advocated tort remedies to deal with the profligate sampler. Unfair competition,¹⁰⁷ misappropriation,¹⁰⁸ and defamation¹⁰⁹ have all been advanced as weapons to vindicate the sampled artist's position. Where does this leave the sampler who just wants to incorporate a distinctive sound into her next single? Not all competition is unfair; not all appropriation is wrong; and not all samples defame.

104. "Right after I did the song, I said, 'Hey, I gotta pay Rick for this.' I didn't need a lawyer to tell me that . . . I'm borrowing enough of his song that he deserves to be compensated." Hammer, *quoted in* Peter Castro, *Chatter*, PEOPLE, July 30, 1990, at 86.

105. Fair use's origins are equitable. Successful uses of it come through a case-by-case basis. Furthermore, as Leaffer points out, its flexibility, while making it attractive, also creates the impossibility of coherent elucidation of its principles. *See* LEAFFER, *supra* note 67, § 10.2. For a proposal that incorporates congressional standards rather than judicial standards, *see infra* Part IV.B.

106. For an argument that sampling and parody should be treated identically, *see* Hampel, *supra* note 70, at 579-83.

107. Both common-law and federal statutory causes of action have been advanced—the latter under the Lanham Act, 15 U.S.C. § 1125(a) (1988 & Supp. IV 1992), which prohibits "the false representation of authorship." *See, e.g.,* Allen, *supra* note 3, at 193-95; E. Scott Johnson, *Protecting Distinctive Sounds: The Challenge of Digital Sampling*, 2 J.L. & TECH. 273, 296-99 (1987); Moglovkin, *supra* note 3, at 162-66; Small, *supra* note 3, at 105-09.

108. *See, e.g.,* Allen, *supra* note 3, at 195-96; Arn, *supra* note 3, at 83-86; Moglovkin, *supra* note 3, at 165-66.

109. *See* Allen, *supra* note 3, at 196-97; Johnson, *supra* note 107, at 300-02.

B. A Proposal

The following proposed statute is patterned after 17 U.S.C. § 107, which establishes the affirmative defense of fair use. Fair use combines delineated standards with flexibility and discretion, allowing principled decision making without the rigidity of bright-line rules.¹¹⁰ Similarly, this sampling statute will enable judges to rule in accordance with democratically established principles that reflect the balance between artists' rights and samplers' rights.

(a) Notwithstanding the provisions of 17 U.S.C. §§ 106-106A, the sampling of a copyrighted work for artistic purposes is not an infringement of copyright.

(b) For purposes of this section, "sampling" is defined as using a machine to convert analog sound waves into a digital code, in order to:

(1) incorporate the resulting code into an original musical composition;

(2) combine resulting codes taken from one or multiple sources to create an original musical composition; or

(3) manipulate the resulting code for the purposes of (1) or (2).¹¹¹

(c) In determining whether the use made of a work in any particular case is a sample, factors to be considered shall include the following:

(1) the purpose and character of the use, including whether such use is for purely commercial purposes or for artistic purposes;

(2) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

(3) the effect of the use upon the potential market for or value of the copyrighted work.

This statute represents a step forward from fair use. First, it clearly states that sampling is an art form, meriting legal recognition only insofar as it contributes to the creation of a work of art. Second, it codifies a definition of sampling, giving judges a reference point for discussion of this threshold issue. Third, it provides a list of things for judges to take into account when deciding the merits of particular sampling cases. Subsection (c), while taken verbatim from 17 U.S.C. § 107(1), (3), and (4), can be interpreted purely in light of sampling issues. Paragraph (1) distinguishes between purely commercial uses of samples, such as television or radio advertisements, and uses in artistic endeavors, like rap songs. Paragraph (2) allows judges to consider the "spectrum" of samples.¹¹² Paragraph (3) protects artists who fear that samples of their creation will shrink their market.

Congressional action that will enable every sampler to know where she stands in deciding whether to sample is sorely needed.

110. See *supra* Part IV.A.

111. See *supra* note 1.

112. See *supra* Part IV.A.

Clearly, the problems created by sampling are great, and the stakes are high.

Conclusion

Given an opportunity to provide judicial guidance, the court in *Grand Upright Music* failed to do so. Thus, digital sound sampling continues to cause controversy. Samplers and sampled artists alike operate in legal limbo, neither sure where they stand. In this way, copyright law acts counter to its reason for existence: to protect the creation of art for the benefit of artists and society both.

The court misapprehended the issues, but in so doing, it focused attention on them. Congress can now step in and create guidelines to accommodate the needs and wishes of samplers and the sampled. The future for samplers and "samplees" alike can be bright, a nascent genre can survive, and music lovers can be better for it.

