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# Focus

# Message in Music Copyright Disputes: Move Over, Juries

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**Issues of substantial copying are usually issues of fact or opinion to be resolved by a jury.**

When authors, musicians and artistic designers seek protection for their original works under the federal Copyright Act, they have long expected certain issues to be decided by a jury of "average audience members," should any infringement of their works occur.

After all, when defenses such as lack of originality and lack of substantial copying are made, contradictory expert witness testimony (so-called "battles of the experts") on those highly factual and opinion-based issues typically create disputes of material fact (most often decided by juries). As such, these disputes lead to denials of summary judgment motions.

However, in recent cases involving copyrighted works in the musical and artistic design contexts, the 9th U.S. Circuit Court of Appeals has upheld district court orders granting summary judgment on such defenses, despite the existence of what appear to be genuine issues of material fact. In so doing, the 9th Circuit appears to be scripting (or conscripting) judges in the roles of average audience members, requiring them to make subjective determinations in the dramatic productions of copyright litigation — positions usually reserved for fact-finding jurors.

These recent 9th Circuit decisions conflict with established precedent involving infringement of literary works.

Rap/hip-hop group the Beastie Boys was recently sued by James Newton, the composer of a musical piece titled "Choir." See *Newton v. Diamond*, 388 F.3d 1189 (2004). In creating their own original work titled "Pass the Mic," the Beastie Boys had "sampled" a six-second portion of a recording of "Choir" (in which Newton played a sustained C note into the flute while singing a C, then a D flat, then another C over the held instrumental tone to create a multi-phonic effect) and "looped" the sample throughout their song.

Although the Beastie Boys obtained a license to use the sound recording of a performance of "Choir," Newton sued the group for infringing his copyright in the unlicensed underlying composition.

In a split decision, the 9th Circuit panel affirmed the district court's order granting summary judgment. The majority declined to find infringement on the ground that the Beastie Boys' copying of Newton's work was trivial, or de minimis, and thus, did not constitute substantial copying.

The decision noted that, when determining whether one work has substantially copied another, the quantitative and qualitative significance of the copied portion must be considered in relation to the work as a whole. In other words, the length of a copied portion and its distinctive value or essentiality to the original work as a whole must be assessed.

Importantly, issues of substantial copying are usually issues of fact or opinion to be resolved by a jury (as the typical fact-finder). As the majority itself pointed out, the use of a copyrighted work is de minimis only if an average audience member (or ordinary observer) would not recognize the material was appropriated. This quintessential "reasonable person" standard is traditionally the realm of a fact-finding jury — not the judiciary.

The dissent argued that considerable expert testimony in the record demonstrated the composition itself, apart from the recording, was distinctive enough that an average audience might recognize the appropriation of music. Although the majority opined the copying was not quantitatively substantial because only three or four notes from a relatively short passage were used, the dissent pointed out that the first four notes of Beethoven's Fifth Symphony comprise one of the most recognizable and distinctive introductory musical phrases in history.

As for qualitative analysis, the dissent referenced portions of testimony of the parties' experts not quoted (or allegedly misinterpreted) by the majority. Those portions arguably created material issues of fact concerning whether the sample of the plaintiff's musical composition used by the Beastie Boys was itself a distinctive and recognizable work.

Thus, the dissent implied that a reasonable jury could indeed have found the composition itself was so distinctive that the Beastie Boys' appropriation was a recognizable infringement of a musical work to the average listener.

Bottom line: The *Newton* majority's holding that no average audience (which can be interpreted to mean no reasonable jury) could conclude the Beastie Boys' work had substantially copied Newton's

composition is an example of a judge-resolved factual determination on the quantitative prong of copyright infringement analysis, as well as a judge-resolved "battle of the experts" on the qualitative prong of the analysis.

The 9th Circuit also upheld summary judgment for a defendant in a case involving whether the artistic design of a lamp was original enough to merit copyright protection in *Lamps Plus v. Seattle Lighting Fixture Co.*, 345 F.3d 1140 (2003).

In the *Lamps Plus* case, plaintiff Lamps Plus created a new Victorian Tiffany table lamp by combining two designs, one for an existing lamp shade and another for an existing table lamp. Lamps Plus altered the four elements of the lamp shade (the finial, cap, glass light shade and metal filigree) so it could function properly with the table lamp. When another manufacturer began producing a similar lamp to compete directly with Lamps Plus' Victorian Tiffany lamp, Lamps Plus sued for copyright infringement.

The defendant raised lack of originality as a defense. Lamps Plus had to rely upon the protections afforded to "compilations" under the Copyright Act. Compilations of existing or otherwise unprotectable elements are given copyright protection only if the elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work.

Moreover, copyright protection will be given only for the new material contributed by the creator of a compilation, and any aspects that are purely functional, utilitarian or mechanical will not be given protection.

Applying those principles, the 9th Circuit ruled that Lamps Plus had simply taken existing components and altered them in a mechanical fashion to fit them together as one work. Relying heavily on the fact that only five elements (which the court considered a small number) were combined, the court concluded the combination of four existing lamp shade elements with an existing table lamp did not create an original work. It held that the modifications were purely mechanical or functional (and thus were not a protected original work for copyright purposes).

As in *Newton*, it was a district judge and a panel of appellate judges — not a jury of average, ordinary observers — who made the key determinations on summary judgment concerning whether Lamps Plus' new design was, on the one hand, functional or mechanical or, on the other hand, creative or artistic, despite the existence of fact- or opinion-based disputes among the parties as to the objective and subjective creativity of the work at issue.

By affirming summary judgment rulings on the subjective issues of substantial copying and originality in the musical and artistic compilation copyright infringement contexts, the 9th Circuit has arguably contradicted its own copyright infringement precedent in the area of literary works forbidding summary judgment on subjective issues of similarity.

In *Shaw v. Lindheim*, 919 F.2d 1353 (1990), the 9th Circuit dealt specifically with literary copyrights for works such as books, scripts, films and plays. It set up a two-part test for determining whether one work is substantially similar to another, both parts of which must be met to establish copyright infringement.

First, a plaintiff must satisfy the "extrinsic test" of similarity (an objective test of expression), in which the court compares concrete elements of works, such as plot, dialogue, mood, setting, pace, sequence and characters. Under the extrinsic test, analytic dissection and expert testimony are appropriate components of the similarity determination, and courts are expressly empowered to decide the issue on summary judgment.

Assuming the court holds the two works are extrinsically (that is, objectively) similar, a plaintiff must then also satisfy the "intrinsic test" of similarity (a subjective inquiry) in which the court analyzes whether the ordinary, reasonable person would consider the "concept and feel" of the works to be similar. Analytic dissection and expert testimony are not appropriate components of the intrinsic similarity test — the issue is solely for the trier of fact (typically a jury) to decide. *Shaw* holds that the subjective, intrinsic test involves an individualized assessment that will provoke a different response in each juror. It is not the court's role to make a summary judgment ruling that necessarily limits the interpretation of each work to that produced by the judges' own experience.

Importantly, once the extrinsic test is satisfied, it is manifestly improper for a court to find that, as a matter of law, no substantial similarity exists under the subjective intrinsic test. In other words, satisfaction of the objective extrinsic test almost always leaves a triable issue of fact to be decided by the jury. "To conclude otherwise would allow the court to base a grant of summary judgment on a purely subjective determination of similarity." *Shaw*. *Shaw,* therefore (in reversing a summary judgment in which the district court made its own intrinsic similarity determination) declared the subjective determinations of the intrinsic test to be the province of the trier of fact (typically a jury of average, ordinary observers).

It appears the *Newton* and *Lamps Plus* cases conflict with *Shaw*. The 9th Circuit was comfortable making subjective determinations of substantial copying and originality on summary judgment in the musical and artistic design contexts of *Newton* and *Lamps Plus*. However, such subjective determinations were deemed entirely inappropriate in the context of literary similarity in *Shaw*. These conflicting positions must be reconciled.

One consistent theme is the 9th Circuit's comfort with making objective determinations of infringement at the summary judgment stage, no matter what field of copyright protection is at issue. As such, objective, quantitative analysis seems to be the key leading indicator of infringement in all copyright actions.

This paradigm seems odd because, as pointed out in the *Newton* dissent, the four opening notes of Beethoven's Fifth Symphony are still, hundreds of years later, incredibly recognizable and original in the qualitative sense, despite being few in number.

Nonetheless, the 9th Circuit is creating a summary judgment standard that relies upon its own evaluations of expert testimony and places much more emphasis on quantitative, objective analysis. While this paradigm focuses on measurable data, it affords little regard for the qualitative distinctiveness of elements themselves, or for the creativity that went into their selection and arrangement.

Perhaps that emphasis is because counting elements of artistic content is the easiest means of analysis available to a court when deciding whether copyrights have been infringed.

But try telling that to Beethoven.

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