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Fragmented Literal Similarity in the Ninth Circuit: Dealing with Fragmented Takings of Jazz and Experimental Music

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> Newcomers to jazz often ask: Is it true that jazz is all improvised? Somehow the casual and romantic notion that jazz is generated in an entirely spontaneous manner has become deeply rooted in our society.[1]
>
> The notator of any jazz solo, or blues, has no chance of capturing what in effect are the most important elements of the music. . . . A printed musical example of an Armstrong solo, or of a Thelonious Monk solo, tells us almost nothing except the futility of formal musicology when dealing with jazz.[2]
>
> The difficulty of applying standard infringement measures to musical compositions in a way that will properly protect the plaintiff's original expression and the defendant's freedom to create original expression of his own may explain why courts have occasionally swerved from one pole to another and why even the most experienced judges have committed fundamental errors in these cases.[3]
>
> The testimony of an expert upon such issues, especially his cross-examination, greatly extends the trial and contributes nothing which cannot be better heard after the evidence is all submitted. It ought not to be allowed at all; and while its admission is not a ground for reversal, it cumbers the case and tends to confusion, for the more the court is led into the intricacies of dramatic craftsmanship, the less likely it is to stand upon the firmer, if more naive, ground of its considered impressions upon its own perusal. We hope that in this class of cases such evidence may in the future be entirely excluded, and the case confined to the actual issues; that is, whether the defendant copied it, so far as the supposed infringement is identical.[4]

INTRODUCTION

In the spring of 1992, the Beastie Boys released their single "Pass the Mic." The Beastie Boys, like many other hip-hop groups, stitched together the background music for their song by excerpting or "sampling" short segments of

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1. BARRY KERNFELD, WHAT TO LISTEN FOR IN JAZZ 99 (1995).
2. LEROI JONES, BLACK MUSIC 19 (Akashic Books 2010) (1968).
3. 2 PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 10.3 (3d ed. 2012).
4. Nichols v. Universal Pictures Corp., 45 F.2d 119, 123 (2d Cir. 1930).

other recordings and melding them into a new recording.[5] As part of this process, the group selected "Choir," a composition by the accomplished avant-garde jazz flutist and composer James Newton.[6] The Beastie Boys took the opening six seconds of "Choir" and looped it over forty times throughout their song, "Pass the Mic."[7] The Beastie Boys obtained a license to use the sound recording of "Choir" from ECM, the record label that owned the rights to the recording copyright, but neglected to obtain permission from James Newton, who owned the composition copyright.[8] In doing so, the Beastie Boys laid the seeds for a dispute that would create a massive controversy over the way that copyright law treats jazz, experimental and other avant-garde music.

Newton sued the Beastie Boys in the Central District of California for copyright infringement. In a summary judgment ruling, the court held that the sampled portion was neither original nor substantially similar to "Choir."[9] Newton's case, which ultimately made its way up to the Ninth Circuit,[10] brought together many important issues involving copyright and music. The copyright status of the now common practice of sampling was under review. Moreover, because the suit only involved the rights of Newton as the composer, the Court was forced to engage in the complex process of separating out the distinct elements of the composition copyright from the sound recording of "Choir" used by the Beastie Boys. The Court also had to analyze an avant-garde jazz composition, which involved the difficult task of interpreting notation in nontraditional music. Newton's jazz composition style required the Court to deal with the unique balance of improvisation and composition that pervades jazz music. This unique situation highlighted the way that copyright law has canonized the preferences of popular American music in its copyright infringement analysis.

These difficult issues called into question the traditional copyright infringement test, which looks to whether a lay listener would see the two pieces as substantially similar. Amici composers advocated that infringement actions be left to expert testimony, noting that the "difficulty of capturing the essential elements of a jazz composition on paper is widely understood."[11] Amici also questioned the use of

5. Newton v. Diamond, 388 F.3d 1189, 1191 (9th Cir. 2004).

6. *Id.* Newton began his career in the '70s recording mainly avant-garde jazz music. He has also played blues and Chinese folk songs. Beginning in the '80s Newton also toured with classical symphony orchestras, chamber groups and ballet ensembles. He has composed everything from jazz and solo flute pieces to ballets. Newton has taught at the California Institute of Arts and the University of California, Irvine. He has also published *Improvising Flute* (1989), a method book for flute players. Barry Kernfeld, *Newton, James*, *in* THE NEW GROVE DICTIONARY OF JAZZ, 2ND EDITION, GROVE MUSIC ONLINE, OXFORD MUSIC ONLINE. http://www.oxfordmusiconline.com/subscriber/article/grove/music/J327700 (last visited Oct. 22, 2013).

7. *Newton*, 388 F.3d at 1192.

8. *Id.* at 1191.

9. Newton v. Diamond, 204 F. Supp. 2d 1244 (C.D. Cal. 2002).

10. Ultimately, the Ninth Circuit affirmed the lower court's summary judgment ruling in favor of the Beastie Boys, finding that the sample did not infringe on Newton's composition copyright. *Newton*, 388 F.3d at 1196-1197.

11. Brief for Meet the Composer et al. as Amici Curiae Supporting Petitioner, Newton v. Diamond, *cert. denied* 545 U.S. 1114 (2005) (No. 04-1219), 2005 WL 1170246, at *16.

the "ordinary reasonable person" standard when evaluating works in contemporary genres like minimalism and microtonality.[12] In a decision that conflated jazz and improvisation and that strayed from the way courts typically treat copyright infringement cases, the Ninth Circuit relied on expert testimony to hold that the use of Newton's work was de minimis and not actionable.[13]

The *Newton* case dealt with a specific subset of copyright infringement cases dealing with what Melville Nimmer has termed "fragmented literal similarity."[14] In each of these cases, the defendant exactly copied the plaintiff's work, but only copied a small portion of the work as a whole.[15] In such cases, copying is obvious and the only issue is whether the copied portion is substantial in relation to the original work as a whole.[16] Where a recording infringes on a composition copyright, the courts must separate the performative from the compositional elements of the music. Courts then look to see whether the copying is quantitatively or qualitatively substantial under a test called "substantial similarity."[17] If it is not, the copying is termed de minimis and not a copyright violation. This form of infringement action is particularly important because of the prominence of sampling in modern music.

This Note will use the *Newton v. Diamond* case to illustrate a number of problems that persist in the way that the courts treat copyright infringement actions in music. In particular, it will use *Newton* to illustrate the way that copyright law has canonized the common features of popular music as virtual prerequisites for protection. It will also examine how conventional attitudes about jazz and expert testimony affected the Court's analysis of Newton's work. In response to these deficiencies, this Note will offer a more genre-neutral approach to distinguish the protections afforded a composition copyright from those afforded subsequent performances of that composition. The most important aspect of this approach is the use of multiple performances to gauge the control that a composition has over the contents of any given recording. Finally, this Note will propose one possible framework for the proper use of expert testimony.

Part I of this Note will explain the relevant aspects of jazz music, copyright law and the differences between composition and recording copyrights. Part II of this note will describe the *Newton v. Diamond* decision and offer a detailed discussion of the musical composition "Choir." Part III will critique the *Newton* decision and suggest alternative modes of analysis for jazz and experimental music in similar cases.

12. *Newton v. Diamond*, 2005 WL 1170246, at *14.

13. *Newton*, 388 F.3d at 1197.

14. 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A][2] (Matthew Bender, Rev. Ed.). A few courts, including the *Newton* court, have acknowledged this terminology. *Newton*, 388 F.3d at 1195; TufAmerica, Inc. v. Diamond, 12 CIV. 3529 AJN, 2013 WL 4830954 *5 (S.D.N.Y. Sept. 10, 2013); Jarvis v. A & M Records, 827 F. Supp. 282, 289 (D.N.J. 1993).

15. *Id*.

16. *Id*.

17. *Newton*, 388 F.3d at 1191.

I. IMPROVISATION, JAZZ AND COPYRIGHT LAW

A. A SHORT HISTORY OF IMPROVISATION AND COMPOSITION IN JAZZ AND THE POPULAR IMAGINATION

Underlying the *Newton v. Diamond* decision is an attitude toward jazz that has fixed itself in America's collective imagination. Part and parcel of the average person's evaluation of a jazz song, and thereby an average judge's decision, is the assumption that jazz is a spontaneous and instinctive art, rooted in an artist's innate skill.[18] This stands in stark contrast to the way we often think of classical music. One might call Beethoven's symphonies inspired, but no one would question that they are carefully constructed artistic creations. But while improvisation has always been an important aspect of jazz music, the longstanding role of composition in jazz has been drastically underestimated. The music of Duke Ellington, Charlie Parker and Charles Mingus is deeply in touch with ideas of improvisation and swing, but it is also harmonically sophisticated and, in some cases, just as composed as classical music.[19] With the advent of the avant-garde movement in the 1960s and 1970s, musicians experienced an almost existential crisis in trying to reconcile their identities as jazz musicians with their growing hunger for creative and exciting forms that combined the classical avant-garde with jazz.[20]

Jazz musicians have always struggled with the music's reputation as an instinctual and improvised folk art.[21] In the early days of jazz, part of the notion that jazz music was linked with improvisation may have been rooted in racist notions about black musicians.[22] Eubie Blake, an accomplished early jazz musician, reported that his band would have to memorize the scores of the music they were playing because white audiences didn't want to believe that black musicians could read music.[23] This memorization sent a clear message: jazz was the antithesis of classical music. It was not composed; it was created on the spot. One of the white performers working with Blake used to ask the audience to hum a

18. *See* KERNFELD, *supra* note 1, at 99 ("Somehow the casual and romantic notion that jazz is generated in an entirely spontaneous manner has become deeply rooted in our society.").

19. The harmonic sophistication of Charlie Parker's improvisations is widely known. For more on Duke Ellington as a composer, see DAVID SCHIFF, THE ELLINGTON CENTURY 14 (2012). For more on Mingus, see KERNFELD, *supra* note 1, at 110.

20. The struggle of avant-garde alto saxophonist Anthony Braxton with his reputation as a jazz musician is a good example of this phenomenon. ALYN SHIPTON, A NEW HISTORY OF JAZZ 598 (2001) (quoting Braxton's statement: "I used to say I was a jazz musician, and all jazz musicians said, 'No you're not.' So I thought about it and said, 'Wait a minute, if I say that I'm a classical musician, then I can do whatever I want *including*, play jazz!" (quoting JOHN LITWEILER, LINER NOTES TO ANTHONY BRAXTON, THREE COMPOSITIONS OF NEW JAZZ (1968))).

21. *See, e.g.*, JOSHUA BERRETT, LOUIS ARMSTRONG AND PAUL WHITEMAN: TWO KINGS OF JAZZ, 43 (2004).

22. *Id.* at 46 (describing such monolithic attitudes about the jazz and black musicians as serving "only to polarize the discussion of jazz, promoting the cliché that jazz 'black' and 'hot' is 'the primitive art of Negroid improvisation' and epitomizes the 'true' expression of the music, whereas 'white' jazz and its commercial band arrangement exemplifies all that is sterile and bland").

23. *Id.* at 48.

tune to the musicians, and they would start to play.[24]

Understanding the complexity of jazz composition doesn't require underestimating the role of improvisation, one of the most beloved and defining characteristics of jazz. Many of jazz's pioneering voices, including Louis Armstrong, Charlie Parker and Sonny Rollins, were infamous improvisers. The sheer excitement generated by an on-the-spot solo is part of what made jazz America's popular music in the early part of the twentieth century.[25] But improvisation is not a large part of every jazz composition, and it is not always discernable from composed portions.[26] Many of the greatest soloists in jazz would memorize a fixed solo for each song. Musicians like Duke Ellington devised hybrid modes of improvisation and composition.[27] Later musicians, such as Charles Mingus, would through-compose, or nonrepetitively notate, most of their works in the classical style.[28]

Even if not grounded in the racist beliefs of the 1920s, jazz musicians since the 1940s have been haunted by this conception of the on-the-fly instinctual performer. One of the greatest misunderstandings in music happened when the "beat generation" writers envisioned the Bebop phenomenon as a grass roots music that anyone could play, provided he had his "ax."[29] In fact, many of Bebop's founders were sophisticated musicians with a broad knowledge of traditional harmony and composition.[30] Their struggle to elevate jazz above its reputation as spontaneous and unsophisticated dance music was often met with only deeper misunderstanding.

With the late 1950s and 1960s avant-garde movement in jazz, the music became even more complex. Jazz musicians began mingling the harmonic conceptions of twentieth century classical and experimental music with the improvisation and swing of jazz.[31] Part of the movement was a less restrained version of

24. *Id.*

25. Jazz reached the apex of popularity in the period beginning in the mid 1930s and stretching to the end of the 1940s, known as the "Swing Era." For an account of this period, see GUNTHER SCHULLER, SWING ERA 4-6 (1989).

26. *See, e.g.*, Charles Mingus' composition *Fables of Faubus.* Mingus was well known for composing many of his pieces in such a way that "the composed theme is vastly more interesting than the improvised solos." KERNFELD, *supra* note 1, at 110; *see also* BRUNO NETTL et al., *Improvisation*, *in* GROVE MUSIC ONLINE, OXFORD MUSIC ONLINE, http://www.oxfordmusiconline.com/subscriber/article/grove/music/13738pg3 (last visited Feb. 16, 2013) ("It is, however, demonstrably untrue that all jazz must involve improvisation. Many pieces that are unquestionably classifiable as jazz are entirely composed before a performance, and take the form of an arrangement, either fixed in notation or thoroughly memorized by the players.").

27. SCHIFF, *supra* note 19, at 14 ("Ellington hired players with idiosyncratic and instantly recognizable playing styles, and composed pieces for specific players rather than instruments. The musicians of the band formed of spectrum of strongly characterized timbre styles.").

28. ALEX STEWART, MAKING THE SCENE: CONTEMPORARY NEW YORK CITY BIG BAND JAZZ 201 (2007).

29. *Ken Burns' Jazz: Risk* (PBS television broadcast Jan. 24, 2001).

30. *Id.*

31. Lawrence Kart, *The Avant-garde, 1947-1967*, *in* THE OXFORD COMPANION TO JAZZ 446, 451 (2000) ("Such composers as George Russell, John Carisi, Duane Tatro, Gil Melle, Teddy Charles, Jimmy Giuffre, Teo Macero, and Charles Mingus were well aware of this century's developments in modern classical composition and eager to sort out which aspects of Stravinsky, Schoenberg, Bartok, et al. might bear fruit in a jazz context.").

improvisation rooted in instrumental virtuosity. However, sophisticated avant-garde composition was equally important.[32] Musicians like Anthony Braxton, one of the first to experiment with the solo saxophone avant-garde genre (to which Newton's work bears similarity), felt marginalized by the jazz community that refused to see their work as a part of the tradition.[33] These musicians found an additional challenge in trying to mold the notational forms of popular and classical music to the very different demands of increasingly nontraditional jazz compositions.[34] Having attempted to fuse jazz and classical music together, these avant-garde musicians found themselves alienated by both groups. This in turn made it hard for the musicians to access the funding necessary to practice their art.

To this day, "[n]ewcomers to jazz often ask: Is it true that jazz is all improvised?"[35] This misconception remains despite the fact that some of the foremost musical compositions of the twentieth century were jazz or jazz-inspired. Duke Ellington's jazz compositions and George Gershwin's jazz-inspired compositions stand as two of the great cornerstones of twentieth century musical composition. As the remainder of this Note will show, this reputation for improvisation can have a negative effect on the rights of jazz composers and the music that they create. Copyright law, which has internalized the assumptions of popular music, may be failing to adequately recognize and protect this music.

B. COPYRIGHT BACKGROUND

With an understanding of jazz's struggles with its reputation as an improvised music in place, this section will begin by examining some of the difficulties inherent in assessing the originality of music within the existing legal framework for copyright infringement. It will then examine how the substantial similarity test, as applied to music, differs among the circuits, paying specific attention to the treatment of cases involving fragmented literal similarity. Finally, this section will discuss the Ninth Circuit's fragmented literal similarity test, which the court purported to apply in *Newton v. Diamond*.

In any copyright infringement case where illegal copying is alleged, "the plaintiff must prove (1) ownership of the copyright, and (2) 'copying' of protectable expression by the defendant."[36] The first element is a question of

32. *See, e.g.*, Gunther Schuller's comments on working with Ornette Coleman in SHIPTON, *supra* note 20, at 572 ("Being an atonal twelve-tone composer, I was hoping that some players would come along who could operate in such a context . . . . So I was looking for someone free enough, either aurally or in technical knowledge, to be able to operate in an atonal context, and lo and behold that is what happened with Ornette Coleman . . . . I knew that if I gave Ornette the twelve-tone row on which my piece *Abstractions* is based, and I could introduce it to him in a way that he learned it by ear, he could then improvise with this material in the sort of fragmented, pointillistic, melodic fashion that he had achieved.").

33. SHIPTON, *supra* note 20, at 598 (quoting LITWEILER, *supra* note 20).

34. JONES, *supra* note 2, at 19.

35. KERNFELD, *supra* note 1, at 99.

36. Baxter v. MCA, Inc., 812 F.2d 421, 423 (9th Cir. 1987); *see also* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991) ("To establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.").

whether the work is an original creation of the author.[37] The second element of the test requires (1) that the defendant copied from the work and (2) that the copied piece was protectable expression.[38] Copying is never in dispute in cases of fragmented literal similarity, because the copying is obvious or not contested; the protectable expression prong is the important one for our purposes. This prong is determined by the substantial similarity test.[39]

The substantial similarity test asks whether the copied material is either quantitatively or qualitatively a substantial portion of the original work such that it merits copyright protection.[40] This test was authoritatively announced in *Arnstein v. Porter*: "The question . . . is whether defendant took from plaintiff's works so much of what is pleasing to the ears of lay listeners, who comprise the audience for whom such popular music is composed, that defendant wrongfully appropriated something which belongs to the plaintiff."[41]

The *Newton* case arises under a subset of the normal copyright infringement framework known as fragmented literal similarity.[42] As mentioned previously, fragmented literal similarity exists when the copying is obvious but only a small portion of the original work is used in the new work. For example, the standard infringement suit might involve the paraphrasing of Shakespeare's *Hamlet*, while the analogous fragmented literal similarity case would involve the copying of only the "to be or not to be" soliloquy. In such cases, the courts will analyze whether the copied portion is either qualitatively or quantitatively substantial when compared to the original work.[43] If it is not, the taking is termed de minimis.[44] In the fragmented literal similarity cases, the analysis hones in on a comparison of the fragment to the whole original work, while the question in the standard case asks more generally whether the two works are substantially similar.[45]

37. Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251-52 (1903); Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884) (tying the originality requirement to the idea that an author is "he to whom anything owes its origin; originator; maker," and therefore granting copyright to a photographer); *see also* NIMMER, *supra* note 14, § 2.01[A] ("Originality in the copyright sense means only that the work owes its origin to the author, *i.e.*, is independently created, and not copied from other works.").

38. *Baxter*, 812 F.2d at 423. Copying is proven either directly or by showing that the defendant had access to the work *and* that the works are substantially similar. *Id*.

39. Normally, much of the trouble in proving infringement resides in proving copying. "Because direct evidence of copying is rarely available, a plaintiff may establish copying by circumstantial evidence of: (1) defendant's access to the copyrighted work prior to the creation of defendant's work, and (2) substantial similarity of both general ideas and expression between the copyrighted work and the defendant's work." *Id.* One should not confuse substantial similarity in the copying analysis with the substantial similarity test; the two are similar but separate inquiries. The former is used to prove that the works were copied and the latter to show that the copied expression is protectable.

40. Ringgold v. Black Entm't Television, Inc., 126 F.3d 70, 75 (2d Cir. 1997) ("[S]ubstantial similarity requires that the copying is quantitatively and qualitatively" substantial); *Jarvis*, 827 F. Supp. at 290 (noting "the premise that a party may be held liable when he or she appropriates a large section or a qualitatively important section of plaintiff's work").

41. Arnstein v. Porter, 154 F.2d 464, 473 (2d Cir. 1946).

42. *See Newton*, 388 F.3d at 1195; NIMMER, *supra* note 14, § 13.03[A][2].

43. *Ringgold*, 126 F.3d at 75.

44. *Id.*

45. To get a better sense of this difference, *see* NIMMER, *supra* note 14, § 13.03[A][1] (describing

1. Originality

The standard for judging whether a given work is copyrightable is generally very permissive. A work need only be the original creation of its author with a minimal spark of creativity.[46] In the musical copyright context, however, courts often narrowly confine their inquiry to the elements of melody, rhythm and harmony.[47] In fact, while a few courts have found the possibility of creativity in rhythm or harmony,[48] most courts look to melody alone as the main source of creativity.[49] This is at least partly grounded in the mistaken notion that "the vocabulary available for musical composition is far less rich and enables far less invention than the vocabulary of literature, drama and the visual arts."[50] This limited protection accords well with western notation, which puts those elements at

"comprehensive nonliteral similarity"); *Id.* § 13.03 [A][2] (describing "fragmented literal similarity").

46. So long as a work is the original creation of its author and contains a minimal degree of creativity it will merit copyright protection. There is no requirement of novelty. If someone were to create a Grecian urn without ever seeing an actual Grecian urn, it would be copyrightable as an original creation of its author. With that said, copyright requires "at least a minimal requirement of creativity over and above the requirement of independent effort." *Id.* § 2.01[B]. The degree of creation must be more than minimal or trivial. Thus certain short phrases have been deemed too minimal to merit protection, but "even most commonplace and banal results of independent effort may command copyright protection, provided such independent effort is quantitatively more than minimal." *Id.*; *see also* Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 250 (1903) ("Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible which is one man's alone. That something he may copyright unless there is a restriction in the words of the act.").

47. *See* NIMMER, *supra* note 14, § 2.05[D] ("It has been said that a musical work consists of rhythm, harmony and melody—and that the requisite creativity must inhere in one of these three."); Jamie Lund, *An Empirical Examination of the Lay Listener Test in Music Composition Copyright Infringement*, 11 VA. SPORTS & ENT. L.J. 137, 144 (2011) ("Despite some passing references to the contrary, the definition of Composition Copyright as including only rhythm, harmony and melody is still the dominant rule. This traditional definition is supported by the historical understanding of music copyright as whatever was included on a piece of sheet music and nothing more."); N. Music Corp. v. King Record Distrib. Co., 105 F. Supp. 393, 400 (S.D.N.Y. 1952) ("Technically analyzed, a musical composition is made up of rhythm, harmony and melody.").

48. Tempo Music, Inc. v. Famous Music Corp., 838 F. Supp. 162, 168 (S.D.N.Y. 1993) (reluctantly acknowledging that in more experimental modern music, harmony may be a source of originality, because "in contemporary music, and particularly in the jazz music genre, musicians frequently move beyond traditional rules to create a range of dissonant and innovative sounds"; but still confining the discussion to the melody, harmony and rhythm paradigm).

49. *See, e.g.*, GOLDSTEIN, *supra* note 3, § 10.3.2 ("The search for protectable subject matter in musical infringement cases usually centers on melody, both because it is melody that listeners find most memorable, and thus is most valuable, and because originality is easier to achieve in melody than in rhythm, harmony or tone color."); NIMMER, *supra* note 14, § 2.05[D] ("Melody is, of course, the usual source of protection for musical compositions.").

50. 2 WILLIAM PATRY, PATRY ON COPYRIGHT § 3:93 (2013) ("The scope of protection for music has suffered from a mistaken belief (limited to nonmusicians) that 'the vocabulary available for musical composition is far less rich and enables far less invention than the vocabulary of literature, drama and the visual arts.' This premise is no more true than the proposition that English literature is limited because there are only 26 letters in the alphabet. One can listen to the cantatas of Bach, the songs of Schubert, or Beethoven's 33 variations on Anton Diabelli's turgid waltz theme, to say nothing of John Coltrane's radically different 1957 and 1962 recordings of his own composition *Traineing In*.").

the forefront.[51]

The methodology is flawed, however, when applied to more complex musical genres such as avant-garde, electronic, classical and jazz.[52] Standard notation, with its focus on melody, rhythm and harmony, often fails to capture the original elements of nontraditional genres; for example, it does not reflect innovative timbre, microtonality, complex rhythms and creative instrumentation.[53] A conventionally notated jazz solo expresses little more than the uselessness of notating the music.[54]

A broader conception of originality does not require that courts protect all types of music. While the threshold for originality is very low, some works—such as John Cage's "4'33," which simply calls for four minutes and thirty-three seconds of silence—may not involve that requisite spark of original creation necessary for protection.[55] However, copyright has a history of embracing new forms of art as long as they contain the requisite creative spark.[56] In this spirit, copyright should take a genre-neutral approach to music.[57] If copyright law continues to canonize the preferences of popular music, jazz and other experimental music will pay the price.

51. *See* Alan Korn, *Issues Facing Legal Practitioners in Measuring Substantiality of Contemporary Musical Expression*, 6 J. MARSHALL REV. INTELL. PROP. L. 489, 492 (2007) ("While jazz and new music composers continue to use Western staff notation, this music is not always adequately expressed by traditional notational methods. Written notation may suffice at representing the melody of a jazz composition, but it is often unable to convey deviations from standard pitch, including compositional elements like vibrato, blue notes, bends, and microtonal and intonational nuances.")

52. *See, e.g.*, *id.* (describing the problems facing jazz, electronic and avant-garde works in showing substantial similarity); Alan L. Durham, *The Random Muse: Authorship and Indeterminacy*, 44 WM. & MARY L. REV. 569, 602 (2002) (assessing the issues facing John Cage's compositions, which involve many random and chance occurrences in their fixed scores). On the problems of standard notation and jazz, see JONES, *supra* note 2, at 14-15 ("The notator of any jazz solo, or blues, has no chance of capturing what in effect are the most important elements of the music . . . . A printed musical example of an Armstrong solo, or of a Thelonious Monk solo, tells us almost nothing except the futility of formal musicology when dealing with jazz.").

53. Take, for example, the compositions of Duke Ellington, which were written with particular band members and instruments in mind, the improvisations of Albert Ayler, which emphasized qualities such as timbre, and the minimalistic works of La Monte Young, which emphasized overtones created by continuous drones.

54. JONES, *supra* note 2, at 14.

55. To satisfy the originality requirement, works must involve more than trivial variation. Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 102-03 (2d Cir. 1951). It is not clear that "4'33" meets this standard.

56. *See* Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 300 (1903) (cautioning against courts making the value judgment that an advertisement is not art and thus denying it copyright). Surely, the assertion that nonmelodic music is less creative might be open to the same caution. *See also Alfred Bell & Co.*, 191 F.2d at 102-03 (All that is needed to satisfy both the Constitution and the statute is that the author contributed something more than a "merely trivial" variation, something recognizably "his own." Originality in this context "means little more than a prohibition of actual copying." No matter how poor artistically the author's addition, it is enough if it be his own.).

57. *See, e.g.*, Levine v. McDonald's Corp., 735 F. Supp. 92, 94 (S.D.N.Y. 1990) (finding that copyright protection might subsist in the "patter section" of a song "the lyrics of which recite the food and beverage items on the McDonald's menu," and extending protection to "the rapid singing of the lyrics in a constant sixteenth note pattern of one or two pitches.").

2. Substantial Similarity: The Lay Listener Test

In infringement actions, the general test for substantial similarity asks whether a lay listener would find the copied work to have either qualitatively or quantitatively substantial similarity to the original work.[58] In *Arnstein v. Porter*, which set out the majority rule for substantial similarity, the Second Circuit relied on the reaction of the lay listener to assess whether a given piece of music was substantially similar to another.[59] The Court explained:

> The plaintiff's legally protected interest is not, as such, his reputation as a musician but his interest in the potential financial returns from his compositions which derive from the lay public's approbation of his efforts. The question, therefore, is whether defendant took from plaintiff's works so much of what is pleasing to the ears of lay listeners, who comprise the audience for whom such popular music is composed, that defendant wrongfully appropriated something which belongs to the plaintiff.[60]

The lay listener test is also sometimes framed as asking whether the market for the work has been diminished or hurt by the actions of the defendant.[61] Commentators have described the substantial similarity standard, as embodied in the lay listener test, as one of the most difficult to apply and one of the least susceptible to clear distinguishing lines.[62] Courts agree that "there are no bright-line rules," leaving a fact-specific and unpredictable standard.[63] With this in mind,

58. Arnstein v. Porter, 154 F.2d 464, 468 (2d Cir. 1946). All circuits feature some form of the audience test announced in *Arnstein*, and most have interpreted the test to ask whether a lay listener would find the portion taken to be substantially similar. *See, e.g.*, Baxter v. MCA, Inc., 812 F.2d 421, 424 (9th Cir. 1987) (using the lay listener test to analyze a portion of a musical work). The Fourth Circuit uses experts to determine what the intended audience of the work would think. *See* Dawson v. Hinshaw Music Inc., 905 F.2d 731, 736 (4th Cir. 1990).

59. *Arnstein*, 154 F.2d at 468 ("If copying is established, then only does there arise the second issue, that of illicit copying (unlawful appropriation). On that issue (as noted more in detail below) the test is the response of the ordinary lay hearer.").

60. *Id.* at 473.

61. Folsom v. Marsh, 9 F. Cas. 342, No. 4901 (C.C. Mas. 1841) ("If so much is taken that the value of the original is sensibly diminished, or the labors of the original author are substantially to an injurious extent appropriated by another, that is sufficient in point of law to constitute a piracy *pro tanto*."); *see also* Newton v. Diamond, 388 F.3d 1189, 1195 (9th Cir. 2004) (quoting the same).

62. NIMMER, *supra* note 14, §§ 13.03, 13.03[A][2][a] ("The determination of the extent of similarity that will constitute a *substantial*, and hence infringing, similarity presents one of the most difficult questions in copyright law, and one that is the least susceptible of helpful generalizations . . . . No easy rule of thumb can be stated as to the quantum of fragmented literal similarity without crossing the line of substantial similarity.").

63. For example, in one case, a use of as little as two minutes of a 28-minute documentary was found substantial. Iowa State Univ. Res. Found., Inc. v. Am. Broadcasting Comp. Inc., 621 F.2d 57, 61 (2d Cir. 1980). *See also* Baxter v. MCA, Inc., 812 F.2d 421, 425 (9th Cir. 1987) ("[N]o bright line rule exists as to what quantum of similarity is permitted before crossing into the realm of substantial similarity."); Bridgeport Music, Inc. v. Dimension Films, 410 F.3d 792, 803 n.18 (6th Cir. 2005) (suggesting that the lack of a bright line rule in composition cases is a reason for unpredictability and excessive litigation costs); TufAmerica, Inc. v. Diamond, 12 CIV. 3529 AJN, 2013 WL 4830954 *11, *13-14, *16 (S.D.N.Y. Sept. 10, 2013) (holding that a nine-second portion of an 8:11 piece was not qualitatively de minimis as a matter of law, but that a six-second segment of a 5:59 piece and a three-second segment of a 6:20 song were).

the Second Circuit has called this a "classic jury question."[64] Legal expertise cannot help a judge determine what an audience member will think is substantial. On the other hand, the forces of modern jurisprudence push toward legal standards that can be decided by judges on summary judgment.[65] On motions for summary judgment, courts often substitute their own judgment for that of the lay listener.[66] While the average judge and average listener might have a lot in common, the question of substantial similarity is a factual matter for a jury to decide. While allowing judges to exercise their personal judgment minimizes the expense of litigation,[67] it seems to run against the basic policy of the rule, which sees the average listener as the arbiter of similarity.[68]

Circuit courts diverge over whether the average lay listener test should be applied in all cases that analyze substantial similarity. The majority of courts hold that a lay listener's opinion is the way to test similarity regardless of genre, and therefore do not allow expert testimony on substantial similarity.[69] The Fourth Circuit has interpreted *Arnstein* to require expert testimony to guide findings about what the intended audience would think.[70] In other words, the test is specialized and hones in on the particular genre in question. Under the Fourth Circuit's approach, *Arnstein* looked to a lay audience because that was the intended audience

64. Roy Export Co. Establishment v. Columbia Broadcasting Sys. Inc., 503 F. Supp. 1137, 1145 (S.D.N.Y. 1980), *aff'd*, 672 F.2d 1095 (2d Cir. 1982).

65. Julie J. Bisceglia, *Summary Judgment on Substantial Similarity in Copyright Actions*, 16 HASTINGS COMM. & ENT. L.J. 51, 75 (1993) ("The most obvious conclusion is that the pious intonation that frequently opens the discussion of the law in many summary judgment opinions—that summary judgment is not favored in copyright actions on the issue of substantial similarity—is flatly wrong. On the contrary, summary judgment is overwhelmingly favored on this issue, at least in the reported decisions, and especially where defendants are moving parties."); *see, e.g.*, *TufAmerica*, 2013 WL 4830954 at *7, *10-16 (granting a motion to dismiss with regard to certain samples used in a Beastie Boys song, but not to other samples).

66. *See, e.g.*, Anheuser-Busch, Inc. v. Elsmere Music, Inc., 633 F. Supp. 487 (S.D.N.Y. 1986) (holding certain similarities in rhythm and melody unactionable).

67. Bisceglia, *supra* note 65, at 73 n.142.

68. There are a number of reasons why the lay listener test, with its emphasis on the average audience, is the proper test to apply for substantial similarity in music. First, as pointed out in *Arnstein*, the purpose of the substantial similarity test is to decide whether the new work infringes upon the audience of the old work. Arnstein v. Porter, 154 F.2d 464, 468 (2d Cir. 1946). In other words, if the works are recognized as similar by the consuming audience, then the new work is taking away the value of the old work. The best judges of these questions are the general public, who will decide to purchase or not purchase the original product. A second and more practical reason is that this test is used throughout the copyright regime. To apply a different test to music would be to create two copyright regimes, when the statute applies a uniform provision to all expressive works. *See* 17 U.S.C. § 501.

69. *Arnstein*, for example, has been understood to exclude expert testimony on the question of whether the average audience would recognize the appropriation. The Ninth Circuit, in *Sid & Marty Krofft Television v. McDonald's Corp.*, has adopted this language, only allowing expert testimony to dissect the protectable from nonprotectable elements. 562 F.2d 1157 (9th Cir. 1977); *see also* Lund, *supra* note 47, at 149 (summarizing the use of expert testimony among the circuits).

70. Dawson v. Hinshaw Music, Inc., 905 F.2d 731, 735 (4th Cir. 1990) ("[O]nly a reckless indifference to common sense would lead a court to embrace a doctrine that requires a copyright case to turn on the opinion of someone who is ignorant of the relevant differences and similarities between the two works."); *see also* Korn, *supra* note 51, at 496.

of the popular music in question.[71]

Despite the insistence by some courts that a lay listener must measure substantial similarity, all courts allow the judge to exclude certain elements of the music if they deem them unprotectable as *scènes à faire*, licensed or not copied.[72] This creates an antecedent step in the substantial similarity inquiry, sometimes called the extrinsic or protected expression test.[73] This test often involves expert testimony, and filters out unprotectable elements in the music before proceeding to the lay listener aspect of the test.[74] Circuits organize this inquiry in slightly different ways, but the basic law is the same.[75]

While expert testimony is not directly relevant to the subsequent lay listener test, use of such testimony in the extrinsic test may influence judges to dismiss these cases at the summary judgment stage. Musical compositions are always less detailed than any given performance of them, which inevitably affords the opportunity for improvisation and non-notated techniques. Since a composition copyright only extends to the limits of the composition, courts are often faced with the complicated task of separating out these performative elements. Because judges are likely to be unfamiliar with even standard notation, they must resort to experts to help separate the compositional from the performative elements of the song. Once the court is faced with conflicting expert testimony, they may be more inclined to see their decision as the type of adjudication appropriate for a gatekeeper judge. This exercise in limitation often converges with the court's narrow treatment of originality in music, creating the potential for under-protection of less conventional forms of music.

The *Arnstein* lay listener test was developed in an ordinary copyright infringement case, but it is also applied—in a more focused way—to fragmented literal similarity cases. Instead of holistically examining both works, the analysis in fragmented literal similarity cases begins with the copied portion and then compares it with the original work to determine whether it is qualitatively or quantitatively substantial. The subjective nature of the qualitative and quantitative questions makes it difficult to predict the results. Moreover, because either qualitative or quantitative substantiality is enough to find infringement, there is no exact quantitative threshold beneath which an appropriator is safe.[76] For instance, in one case as little as six notes qualified for substantial similarity.[77] In another

71. *See* Arnstein v. Porter, 154 F.2d 464, 473 (2d Cir. 1946) (noting that lay listeners "comprise the audience for whom such popular music is composed.").

72. GOLDSTEIN, *supra* note 3, § 9.3.1.1 (describing the protected expression tests in the majority of circuits); *id.* § 9.3.2.1 (describing the extrinsic portion of the Ninth Circuit Test).

73. *Id.* § 9.3.1.1.

74. *Id.*

75. For example, all courts filter out unprotected elements before assessing substantial similarity. In the Sixth Circuit, this test is called the Protected Expression Test, while the Ninth Circuit deems it to be the extrinsic part of the dual extrinsic/intrinsic substantial similarity test. GOLDSTEIN, *supra* note 3, §§ 9.3.1.1, 9.3.2.1.

76. GOLDSTEIN, *supra* note 3, § 10.3.2.1 ("Courts have uniformly rejected quantitative approaches to protectable subject matter.").

77. Baxter v. MCA, Inc., 812 F.2d 421, 425 (9th Cir. 1987) (noting that even if only six notes were at issue, the jury could conclude that there was substantial similarity.).

case, a short phrase accompanied by similar music was enough for substantial similarity.[78] A recent case held that nine seconds out of an 8:11 piece was not quantitatively insubstantial as a matter of law, while six seconds out of a total 5:59 was.[79] An older case, by contrast, found the copying of six bars to be unactionable.[80]

3. The Ninth Circuit Standard

The Ninth Circuit version of the substantial similarity test as applied to cases of fragmented literal similarity features an objective extrinsic test and a subjective intrinsic test.[81] In that analysis, "[t]he extrinsic test considers whether two works share a similarity of ideas and expression as measured by external objective criteria."[82] The examination consists of "analytical dissection of a work and expert testimony" and asks, within the broader scheme of illegal copying, whether the expression copied was actionable.[83] If a portion of the copied material was in the public domain, was licensed or was otherwise unprotected, the court will exclude that portion from the subsequent intrinsic test using expert testimony.[84]

The intrinsic test is the equivalent of the lay listener test and asks whether an ordinary person would find the two works quantitatively or qualitatively substantial.[85] This part of the test does not allow expert testimony.[86] The Ninth Circuit has stated that "[f]or the purposes of summary judgment, only the extrinsic test is important because the subjective question whether works are intrinsically similar must be left to the jury."[87] In practice, however, if the court thinks no reasonable juror could find substantial similarity, it may hold that the appropriation is de minimis as a matter of law. The juxtaposition of the extrinsic and intrinsic tests in the Ninth Circuit means that judges have expert testimony fresh in their minds and are unlikely to disregard it in evaluating the intrinsic test at summary judgment.[88] During the summary judgment phase, the expert testimony will take

78. Boosey v. Empire Music Co., 224 F. 646, 647 (S.D.N.Y. 1915) (holding that a short phrase with similar music is enough to constitute substantial similarity).

79. TufAmerica, Inc. v. Diamond, 12 CIV. 3529 AJN, 2013 WL 4830954 *11, *14 (S.D.N.Y. Sept. 10, 2013).

80. Marks v. Leo Feist, Inc., 290 F. 959, 960 (2d Cir. 1923) ("The exclusive right granted to the appellant by his copyright to print, reprint, publish, copy, and vend does not exclude the appellee from the use of 6 similar bars, when used in a composition of 450 bars.").

81. Swirsky v. Carey, 376 F.3d 841, 845 (9th Cir. 2004). Note that the extrinsic test corresponds roughly with the protected expression test of other circuits.

82. *Id.*

83. Three Boys Music Corp. v. Bolton, 212 F.3d 477, 485 (9th Cir. 2000).

84. *Id.*; *Swirsky*, 376 F.3d at 845; *see also* GOLDSTEIN, *supra* note 3, § 9.3.2.1 (describing the intrinsic and extrinsic tests).

85. Pasillas v. McDonald's Corp., 927 F.2d 440, 442 (9th Cir. 1991).

86. *Swirsky*, 376 F.3d at 845.

87. *Id.*

88. It should be noted that not all Ninth Circuit decisions explicitly refer to the extrinsic and intrinsic portions of the test, but recent cases have affirmed the presence of the test in every inquiry. *See id.* at 848 ("The extrinsic test provides an awkward framework to apply to copyrighted works like music or art objects, which lack distinct elements of idea and expression. Nevertheless, the test is our law and

the form of depositions, affidavits or other evidence.

C. MUSICAL COMPOSITION COPYRIGHT AND SOUND RECORDING COPYRIGHT

The foregoing discussion has focused on the law as it applies to the copyrights of musical composition. However, a copyright may reside both in the musical composition itself and in a sound recording of that composition. This section will clarify the difference between these two types of protection and will proceed to discuss the Sixth Circuit case *Bridgeport Music, Inc. v. Dimension Films*,[89] which showcases an important difference in the way the law protects composition and recording copyrights.

The musical composition copyright can be best understood as embodying those portions of a given work that are consistently produced by any performer of that work. For instance, any performance of a given work will usually include the same melody, rhythm and harmony, but each performance may bring with it the "distinctive voice" of the performer "or the specific timbre of the guitars and drums."[90] The more specific a composition, the less differentiation there will be from one performance to another.[91] By default, the musical composition copyright is held by the composer of a given work.[92]

Traditionally, a composition copyright took the form of sheet music; until recently, this was the main way that composers wrote down their music.[93] The composition copyright could be described as including all of the elements that the sheet music specified. However, under the Copyright Act a musical work may be "fixed in *any* tangible medium of expression."[94] Thus, it is also possible to attain a composition copyright by submitting a sound recording to the Copyright Office.[95]

In such cases, the sound recording is considered to contain the definitive version of the composition, overriding even subsequent sheet music.[96] But this does not mean that everything in the sound recording is a part of the musical composition copyright.[97] Only the elements of the recording that would be repeated by every

we must apply it.").

89. Bridgeport Music, Inc. v. Dimension Films, 410 F.3d 792, 801 (6th Cir. 2005).

90. NIMMER, *supra* note 14, § 2.05[A].

91. MARK S. LEE, ENT. AND INTELL. PROP. LAWS (Thomson Reuters 2013) § 7:38 (including in the scope of a composition generally notated components like melody, rhythm and harmony, as well as "[o]ther discrete elements, including lyrics, a guitar riff, musical slurs, phrasing, tempo, or dynamic marks").

92. Lund, *supra* note 47, at 143.

93. Lund, *supra* note 47, at 141 ("Music compositions first received copyright protection at a time when sheet music sales dominated. In the absence of audio reproduction technologies, sheet music was essentially the only means of fixing a composition for purposes of registering a copyright. Although sound recordings became increasingly popular through the beginning of the twentieth century, the Composition Copyright was the only music copyright until the 1970s.").

94. 17 U.S.C. § 102 (2013) (emphasis added).

95. NIMMER, *supra* note 14, § 2.05[A].

96. Bridgeport Music, Inc. v. UMG Recordings, Inc., 585 F.3d 267, 276 (6th Cir. 2009) (holding that lyrics only found in the sound recording were nevertheless part of the musical composition copyright).

97. NIMMER, *supra* note 14, § 2.05[A] ("[I]t stretches matters too far to conclude that everything

performer of the work become a part of the composition copyright.[98] Because of the long association between sheet music and composition copyrights, some scholars have pressed the even narrower view that all composition copyrights should be confined to the melody, rhythm and harmony traditionally preserved by sheet music.[99]

The Copyright Act also recognizes a separate sound recording copyright.[100] This copyright protects the sounds of a performance embodied in digital or electronic form.[101] Sound recordings, which embody the details of a given performance, will always be more specific than a composition, which leaves room for many possible performances.[102] Essentially, the sound recording contains all of the parts of the performance not mandated by the written composition.[103]

Take, for example, the written notation of a jazz solo. It will traditionally include the notes, rhythm and general timing, but perhaps not much else. This is the general scope of the composition copyright. The sound recording of the same solo will include the instruments in question, the exact timbre and manner of playing, and all the particulars of the single performance. This is the scope of the sound recording copyright. One might compare this to the difference between a written speech and a recorded speech.

Although a single sound recording can be used to create both the musical composition copyright and the sound recording copyright, the two are not coextensive. This may result in a division of rights, where the composer of the work or the sheet music publisher owns the musical composition copyright and the record company owns the sound recording copyright. While the owner of the composition copyright and the recording copyright will generally come to an agreement over how to apportion the proceeds from the initial recording, subsequent users will need to obtain a license from both of the copyright holders (hence the suit in *Newton v. Diamond*).

At least one court has granted sound recording copyrights more protection than composition copyrights. In the landmark case, *Bridgeport Music, Inc. v. Dimension Films*, the copyright owners of a sound recording sued a film company

on the recording forms part of the musical composition.").

98. *Id.* § 2.10[A][2] (The difference is between sounds created at a given performance and the underlying musical composition.).

99. Lund, *supra* note 47 (clarifying that, despite some passing references to the contrary, the definition of "composition copyright" as including only rhythm, harmony and melody is still the dominant rule, and that this traditional definition is supported by the historical understanding of music copyright as whatever was included on a piece of sheet music and nothing more).

100. 17 U.S.C. § 114 (2013).

101. 17 U.S.C. § 114 (specifying the rights of owners of sound recording copyrights); *see also* Lund, *supra* note 47, at141 ("In order to curtail rampant unauthorized copying of sound recording in the music industry, Congress passed The Sound Recording Act of 1971.").

102. NIMMER, *supra* note 14, § 2.05[A]; Lund, *supra* note 47, at 144-45 ("The sound recording copyright covers any performance elements embodied in the sound recording, for instance phrasing, style, genre, tempo, key, timbre, and orchestration. In other words sound recordings protect those performance choices that differentiate one version of the same song from another.").

103. Lund, *supra* note 47, at 144.

for infringement.[104] They alleged that the sampling of their work in a rap song on the film's soundtrack infringed their copyright.[105] The Sixth Circuit considered whether sampled sound recordings were susceptible to de minimis challenges in cases of fragmented literal similarity.[106] The court ruled, on the basis of statutory interpretation, that the de minimis rule does not exist for sound recording copyrights, but that it does exist for composition copyrights.[107] In other words, if a band were to sample even a one-second portion of a sound recording of, for example, "Someday My Prince Will Come," it would infringe sound recording copyright, but would not necessarily infringe the composition copyright. This is because the use of the composition would be subject to fragmented literal similarity analysis, which would likely render the use of the short segment de minimis, while the use of the sound recording would create strict liability. This is the case even when the composition copyright is based upon a sound recording.

II. THE *NEWTON V. DIAMOND* DECISION

The preceding Part mapped out both the legal and musical background to *Newton v. Diamond*. This Part will summarize the facts and the Ninth Circuit's decision in *Newton*. Applying the Ninth Circuit's fragmented literal similarity test, the court found the six-second sampled portion of "Choir" to be both qualitatively and quantitatively de minimis. The Court's decision relied heavily on the narrow view of copyright protection that the courts extend to music in general and to composition copyrights in particular.

A. FACTUAL AND PROCEDURAL HISTORY

James Newton is an accomplished flutist and composer in the field of avant-garde music, in which jazz, experimental and classical music overlap.[108] In 1978, as part of a larger suite, Newton registered a composition copyright using sheet music for "Choir," a piece for solo flutes that involved several composed portions, as well as longer segments calling for improvisation.[109] Newton recorded "Choir" three different times: on the 1978 album *Flutes*, on the 1982 album *Axum* and, finally, on the 1988 album *James Newton In Venice*.[110] Newton licensed the sound recording rights to the *Axum* recording of "Choir" to the record label ECM, but retained all future rights to the composition copyright.[111]

In 1992, the Beastie Boys, a popular hip-hop group, took a six-second portion of the recorded version of "Choir" from the album *Axum*, and, through a process

104. Bridgeport Music, Inc. v. Dimension Films, 410 F.3d 792, 795 (6th Cir. 2005).
105. *Id.*
106. *Id.* at 801.
107. *Id.* For a full discussion and critique, see NIMMER, *supra* note 14, § 13.03[A][2][b].
108. Newton v. Diamond, 388 F.3d 1189, 1191 (9th Cir. 2004).
109. Newton v. Diamond, 204 F. Supp. 2d 1244, 1246 (C.D. Cal. 2002).
110. JAMES NEWTON, FLUTES (Circle Records 1978); JAMES NEWTON, AXUM (ECM 1982); JAMES NEWTON, JAMES NEWTON IN VENICE (Celestial Harmonies 1988); *Newton*, 204 F. Supp. 2d 1244.
111. *Newton*, 388 F.3d at 1191.

called sampling, looped it more than forty times throughout its song, "Pass the Mic."[112] The Beastie Boys licensed the sound recording from ECM prior to sampling "Choir," but neglected to license the composition from Newton.

Newton brought suit in the Central District of California for copyright infringement, international copyright infringement and, under the Lanham Act, for misrepresentation and reverse passing off.[113] The Lanham Act claims were dismissed for failure to state a claim. Following discovery, the parties cross-motioned for summary judgment on the remaining copyright infringement claim.[114] In a carefully written opinion, the district judge ruled in favor of the Beastie Boys for two reasons. First, drawing on declarations from both the plaintiff's and defendant's experts, the Court characterized the written sequence as a common feature of the twentieth century avant-garde and African traditions and found that much of the distinct sound of the recording came from the non-notated aspects of Newton's technique. The Court held that the sampled portion of the composition did not possess the requisite originality to merit protection.[115] Second, because the filtering and originality tests concluded that so much of the piece was due to Newton's technique and the notated aspects were simple and common, it was unlikely that an audience would be able to recognize it as a part of "Choir."[116] Thus, Newton had failed to raise an issue of fact regarding whether the pieces were substantially similar.[117]

B. THE "CHOIR" COMPOSITION

Before turning to the Ninth Circuit's decision on appeal, it will be helpful to examine the composition itself. "Choir" is a piece for solo flute.[118] Solo instrumental compositions are not uncommon in jazz and were popularized in the late 1960s.[119] Newton's *Axum* is part of this tradition of avant-garde solo jazz albums, which typically include composed and improvised music showcasing extended techniques on a specific instrument.[120] Newton may also have been drawing on a tradition of avant-garde classical music composed for the solo flute.[121] In particular, the tone clusters used in the beginning of the piece draw

112. *Id.*
113. *Newton*, 204 F. Supp. 2d at 1246.
114. *Id.*
115. *Id.* at 1250.
116. *Id.* at 1252, 1256, 1260.
117. *See id.* at 1260.
118. *Newton*, 388 F.3d at app.
119. While solo saxophone recordings existed early in the jazz tradition, the idea of having a solo woodwind instrumental album became popular in the late 1960s. *See, e.g.*, ANTHONY BRAXTON, FOR ALTO (Delmark Records 1970); LEE KONITZ, LONE-LEE (Inner City 1976); EVAN PARKER, SAXOPHONE SOLOS (Incus 1976).
120. *See supra* note 119.
121. *Newton*, 388 F.3d at 1191 (acknowledging classical influence). For an idea of the sort of twentieth century classical music for solo flute that Newton may have been drawing on, see, e.g., TORU TAKEMITSU, *Voice, for Solo Flute*, *on* TORU TAKEMITSU WORKS FOR SOLO GUITAR AND FLUTE (Ondine 1995).

upon the twentieth century avant-garde classical tradition.[122]

Next, it is important to understand the structure of the composition. "Choir" is made up of a few short composed sections, which frame larger sections calling for improvisation.[123] This "sandwich" technique has been the most prevalent type of composition strategy in jazz since its inception,[124] and it is used even where compositions are borrowed from the popular repertoire (sometimes known as jazz standards).[125] Take, for example, Coleman Hawkins' famous performance of "Body and Soul."[126] Hawkins plays the melody of the popular tune for about thirty seconds. The rest of the three-minute song consists of his own improvised melody over the borrowed songs chords.[127] Since "Choir" is for solo flute, there is no underlying chord structure. Instead, the composed portions serve as an introduction and frame for the improvised portions.[128] The composed portions in the middle and at the end of the improvisations are variations on the initial composed melody. Much like the relation of the opening theme of a symphony to the rest, the improvisation is in dialogue with that melodic statement.

Finally, we turn to the content of the sampled portion of "Choir." The Beastie Boys sampled the first six seconds of the *Axum* version of "Choir."[129] The rhythm is notated as *senza misura* (without measure and largo, or stately).[130] Practically speaking, the rhythm is only notated to the extent that the call to play "stately and without measure" might consistently affect the performer. The notes are middle C, D, and middle C played normally on the flute, with a C one octave above middle C sung into the flute.[131] The score also specifies that "[t]his piece requires singing into the flute [and] fingering simultaneously."[132] Following the notated portion, there are instructions for "[a]pprox. 90 seconds of improvisation."[133] The remaining sheet music notates the repetition of slight variations on this same motif, sometimes going from C to D to E flat, then again C to D to C, with some

122. *Newton*, 388 F.3d at 1196 (Dr. Ferrara, the Beastie Boys' expert, "described the sequence as 'a common building block tool' that 'has been used over and over again by major composers in the 20th century, particularly in the '60s and '70s, just prior to James Newton's usage.").

123. Newton v. Diamond, 204 F. Supp. 2d 1244, 1250 (C.D. Cal. 2002).

124. Jazz songs most often use the American popular song or blues form in articulating this sandwich structure. The song is then divided into choruses or repetitions of the full harmonic form of the song. Usually, the first and last chorus consist of playing the melody of the song while the rest consist of improvisation. *See* KERNFELD, *supra* note 1, at 39-41.

125. *Id.* Jazz often uses songs from popular music or other genres as the basis for its own creativity. Jazz standards are a group of songs drawn from American popular music of the 1920s, '30s, '40s and '50s that form a sort of classical canon of songs that jazz musicians play.

126. For an excellent copy of this piece, see COLEMAN HAWKINS, KEN BURNS JAZZ COLLECTION: COLEMAN HAWKINS (Polygram Records 2000).

127. COLEMAN HAWKINS, *Body and Soul*, *on* KEN BURNS JAZZ COLLECTION: COLEMAN HAWKINS (Polygram Records 2000).

128. KERNFELD, *supra* note 1, at 100 ("Sometimes the melody has genuine character, and its style matches the improvisations that it frames.").

129. Newton v. Diamond, 388 F.3d 1189, 1192 (9th Cir. 2004).

130. *Id.* at app.

131. *Id.*

132. *Id.*

133. *Id.*

overblown notes.[134] This same motif is repeated with variations at the end of the piece.[135] Thus, to the extent that the composed variations interplay with the sampled portion of "Choir," and the sampled portion is mirrored in the variations on the motif, it represents more than six seconds of the piece.[136] Moreover, like the melody of a typical jazz song, it serves as a framing device to set the tone of the composition.[137] In fact, even the instrumentation, meter and time periods for improvisation can help to set the tone for the improvisation.[138]

The musical sounds mandated by the "Choir" score go beyond the mere list of notes written on the sheet music. A large part of the avant-garde instrumental music of the 1970s and 1980s is the creation of multiphonic sounds through the playing of instruments in innovative ways.[139] A close look at the sheet music reveals that it requires any performer to create a specific and innovative sound.[140] By following the directions in the score to play certain notes through fingering and others through singing, the performer necessarily creates certain multiphonic sounds over and above the specific notes on the page.[141] The best proof of this would be another musician's performance of the song, but no such recording is available, although Newton performed the song himself on several different occasions with relatively consistent results.[142]

The Court discussed the intended meaning of Newton's piece, but it did not use this information in any meaningful way. Newton said that he intended the piece "to incorporate elements of African-American gospel music, Japanese ceremonial court music, traditional African music, and classical music, among others," and that "the song was inspired by his earliest memory of music, watching four women singing in a church in rural Arkansas."[143] While it goes too far to call this articulation "vaguely sanctimonious and ultimately irrelevant," as did the commentary on the

134. Newton v. Diamond, 204 F. Supp. 2d 1244, 1250 (C.D. Cal. 2002).

135. *Id.*

136. *See* JAMES NEWTON, *Choir, on* AXUM (ECM 1982); *Newton*, 204 F. Supp. 2d at 1250. This would be clearer if we had a full version of the score rather than the piece excerpted in the published case.

137. The sample serves as both a framing device for the rest of the song and as the basis of the composed variations that follow it. Like the introduction to an essay or an opening line in a speech, it might thus be deemed more substantial than its length would indicate.

138. For an explanation of many ways that composers use arrangements in jazz, see BERLINER, THINKING IN JAZZ 291-96 (1994).

139. For a good example of this idiom and techniques, see, e.g., EVAN PARKER, SAXOPHONE SOLOS (Incus, 1976).

140. *See* Newton v. Diamond, 388 F.3d 1189, 1197-98 (9th Cir. 2004) (Graber, J., dissenting) (noting that Professor Christopher Dobrian of the University of California, Irvine had commented: "[i]f, on the other hand, one considers the special playing technique *described in the score* (holding one fingered note constant while singing the other pitches) and the resultant complex, expressive effect that results, it is clear that the 'unique expression' of this excerpt is not solely in the pitch choices, but is actually in those particular pitches performed in that particular way on that instrument").

141. *Id.*

142. Of course, this doesn't aid us much in our inquiry, since the score is not necessarily responsible for its composer's consistent manner of performing the piece. An independent performance of the composition would have been more informative.

143. *Newton*, 388 F.3d at 1191.

Music Copyright Infringement Resource,[144] such statements describe the personal feelings of Newton more than providing information helpful to an analysis of the piece's content or copyright protection.

C. THE NINTH CIRCUIT DECISION

As noted above, the Ninth Circuit determined that the six-second sampled portion of "Choir" was de minimis under the fragmented literal similarity test.[145] The Court began its analysis by establishing that "[f]or an unauthorized use of a copyrighted work to be actionable, the use must be significant enough to constitute infringement."[146] Because the Beastie Boys licensed the sound recording of "Choir," the Court's first task was to "'filter out' the licensed elements of the sound recording to get down to the unlicensed elements of the composition, as the composition is the sole basis for Newton's infringement claim."[147] This is the extrinsic prong of the Ninth Circuit's test. The Court then moved on to the intrinsic prong, applying the lay listener test to the elements of the composition copyright that remained.[148]

First, under the extrinsic test, the Ninth Circuit separated the licensed portions of "Choir" from the nonlicensed portions.[149] Since the Beastie Boys licensed the sound recording copyright from ECM, but not the musical composition copyright, this step involved distinguishing the features of the composition copyright from those of the recording.[150] This is a difficult task, since no pure sound version of a composition copyright can exist. Any recorded or performed version will necessarily include some features unique to the performance.

In attempting to delicately extract the composition features from the recording features, the court relied on expert testimony, beginning with Newton's experts.[151] The court focused particularly on Newton's expert Dr. Christopher Dobrian, who said that "[t]he contribution of the performer is often so great that s/he in fact provides as much musical content as the composer."[152] It found that Newton's experts agreed that much of the creativity in "Choir" was "the product of Newton's highly developed performance techniques," and noted that "[t]his is particularly true with works like 'Choir,' given the improvisational nature of jazz performance

144. *Newton v. Diamond 349 F.3d 591 (9th Cir. 2003): Comment*, MUSIC COPYRIGHT INFRINGEMENT RESOURCE, http://mcir.usc.edu/cases/2000-2009/Pages/newtondiamond.html.

145. *Newton*, 388 F.3d at 1197.

146. *Id.* at 1192-93.

147. *Id.* at 1194.

148. *Id.* at 1193 ("[A] use is de minimis only if the average audience would not recognize the appropriation. . . . This observation reflects the relationship between the de minimis maxim and the general test for substantial similarity, which also looks to the response of the average audience, or ordinary observer, to determine whether a use is infringing."). As an example of this test, the court quoted *Fisher v. Dees*, 794 F.2d 432 (9th Cir. 1986), in which the copying of six out of thirty-eight bars was substantial, because the six bars were easily recognizable. *Id.*

149. *Id.* at 1194.

150. *Id.*

151. *Id.*

152. *Id.*

and the minimal scoring of the composition."[153]

The court found additional support in the declaration of Newton's second expert, Dr. Oliver Wilson. Wilson testified that in a jazz composition, the score "does not contain indications for all of the musical subtleties that it is assumed the performer-composer of the work will make in the work's performance."[154] The court focused on the fact that the techniques Newton used to emphasize the upper partials of the flute's tone, and the overblowing of certain pitches to create various multiphonic effects, were not fixed in the score.[155] This left the court to conclude that those elements were not protected by the composition copyright.[156] Based largely on this testimony, the court held that "whatever copyright interest Newton obtained in this dense cluster of pitches and ambient sounds he licensed that interest to ECM Records."[157] It is worth mentioning that Newton's experts did not necessarily provide bad testimony: rather, the court focused on the particular phrases that corresponded with its narrow understanding of jazz. In fact, the dissent, as discussed below, focused on aspects of the expert testimony that correctly identified the amount of improvisation mandated by the composition copyright.[158]

The court's decision will be rigorously analyzed in Part III. However, there are a few main points to keep in mind about the court's extrinsic analysis. First, the court did not specifically quantify which parts of the recording were not notated or the effect that the omission of those sounds would have on the recording. Instead, the court resorted to vague statements about the "Newton technique" and multiphonic effects.[159] The Court treated improvisation and jazz as essentially synonymous concepts, inevitably reducing the value of the composition. Second, the Court ignored the possibility that any performance of the score may necessitate more than the specific notes written out on paper.[160] Finally, the court's analysis of the music relied heavily on a few select comments of Newton's experts that validated its view of jazz as an improvised art. As will be seen, such testimony is an imperfect tool for performing an extrinsic analysis of a musical composition, because courts may focus on the wrong aspects of the testimony.

Next, the court applied the intrinsic prong of the Ninth Circuit's test, concluding that no reasonable juror could find the sample qualitatively or quantitatively substantial.[161] The court found that, because the relation of the sample to the original work was the only relevant comparison, "the fact that Beastie Boys 'looped' the sample throughout was irrelevant in weighing the sample's qualitative

153. *Id.* ("In filtering out the unique performance elements from consideration, and separating them from those found in the composition, we find substantial assistance in the testimony of Newton's own experts.").

154. *Id.*

155. *Id.*

156. *Id.*

157. *Id.*

158. *Newton*, 388 F.3d at 1197 (Graber, J., dissenting).

159. *See, e.g.*, *id.* at 1196.

160. For instance, when Newton says to play fingered notes while singing into the flute, should a court only count the notes indicated, or the overall sound created by those instructions?

161. Newton v. Diamond, 388 F.3d 1189, 1195 (9th Cir. 2004).

and quantitative significance."[162] While this rule seems unfair in cases where a work is sampled throughout another work, it is consistent with the substantial similarity test, which compares the infringing portion to the original work and does not take into account its relation to the infringing work.[163]

The court divided its substantial similarity analysis into quantitative and qualitative substantiality. Quantitatively, the court noted:

> [T]he three-note sequence appears only once in Newton's composition. It is difficult to measure the precise relationship between this segment and the composition as a whole, because the score calls for between 180 and 270 seconds of improvisation. When played, however, the segment lasts six seconds and is roughly two percent of the four-and-a-half-minute "Choir" sound recording licensed by Beastie Boys.[164]

At first glance, this seems like a fair point. The sample is a small part of the recorded version. On the other hand, the theme introduced in the sampled portion is repeated in varied forms at different points in "Choir."[165] Moreover, because sampling generally involves taking very short portions of a composition, the court is implying that a sample can never be quantitatively substantial. It is unclear whether this analysis is consistent with Judge Friendly's formulation, which finds substantial similarity where "the value of the original is sensibly diminished."[166] One potential solution to this problem is to turn to qualitative substantiality in sampling cases. Quantitative similarity may simply not be appropriate for cases of fragmented literal similarity.

In its analysis of qualitative similarity, the *Newton* court again ruled against Newton. It conceded that the sampled portion might be representative of the latter scored portions of "Choir," which contain similar notes and instrumentation.[167] Dr. Lawrence Ferrara, one of the Beastie Boys' experts, described the sampled portion as a "common, trite, and generic note sequence, which lacks any distinct melodic, harmonic, rhythmic or structural elements."[168] He emphasized that the sampled sequence "has been used over and over again by major composers in the 20th century, particularly in the '60s and '70s, just prior to James Newton's usage."[169] By contrast, Newton presented no evidence that the sample was significant in

162. *Id.* at 1195.

163. *See* NIMMER, *supra* note 14, § 13.03[A][2][a] ("The question in each case is whether the similarity relates to matter that constitutes a substantial portion of plaintiff's work—not whether such material constitutes a substantial portion of defendant's work."); *Newton*, 388 F.3d at 1195 (citing Worth v. Selchow & Righter Co., 827 F.2d 569, 570 n.1 (9th Cir.1987)) ("[T]he relevant inquiry is whether a substantial portion of the protectable material in the *plaintiff's* work was appropriated—not whether a substantial portion of *defendant's* work was derived from plaintiff's work.").

164. *Newton*, 388 F.3d at 1195-96.

165. See the description of "Choir" *supra* Part II.B for further discussion.

166. *Newton*, 388 F.3d at 1195.

167. *See id.* at 1196 ("[W]ith the exception of two notes, the entirety of the scored portions of 'Choir' consist of notes separated by whole and half-steps from their neighbors and is played with the same technique of singing and playing the flute simultaneously; the remainder of the composition calls for sections of improvisation that range between 90 and 180 seconds in length.").

168. *Id.*

169. *Id.*

proportion to the piece as a whole. On the contrary, Newton's experts highlighted "the uniqueness of the 'Newton technique,' which is found throughout the 'Choir' composition and in Newton's other work."[170] The Court held that Newton's experts did not raise a genuine issue of material fact as to whether the sample was substantial, because they failed to distinguish between the sound recording and the composition and presented no evidence that the sampled portion was substantial.[171]

The use of expert testimony seems to have improperly distracted the court from the intrinsic analysis of the piece. As discussed in Part I, *supra*, the intrinsic prong of the test is meant to be a pure jury question, immune from expert testimony.[172] The court nevertheless allowed the experts' testimony on the extrinsic issue to influence its ruling on the intrinsic test. The court relied heavily on Dr. Ferrara's musicological assessment of the composition as "common, trite and generic."[173] By requiring Newton's experts to rebut these conclusions, the court turned the intrinsic test into a battle of the experts, as opposed to a measure of the lay listener's reaction.[174] The court's focus on the general musical significance of the sampled portion in itself, instead of its relation to "Choir," is misplaced. The court noted that "the minimal scoring of the 'Choir' composition bears emphasis, as does the relative simplicity of the relevant portion of the composition."[175] However only the sample's relation to "Choir" was at issue.

D. JUDGE GRABER'S DISSENT

Judge Graber's dissent provided a thoughtful critique of the majority's opinion.[176] She argued that the majority overestimated the role of Newton's technique in "Choir" and improperly ruled that the filtered composition was not substantial. Even when Newton's "considerable skill" is filtered out under the extrinsic analysis, "the composition, standing alone, is distinctive enough for a fact-finder reasonably to conclude that an average audience would recognize the

170. *Id.* ("The sampled section may be representative of the scored portions of the composition as Newton's experts contend. Newton has failed to offer any evidence, however, to rebut Dr. Ferrara's testimony and to create a triable issue of fact on the key question, which is whether the sampled section is a qualitatively significant portion of the 'Choir' composition as a whole.").

171. *See id.* ("On the key question of whether the sample is quantitatively or qualitatively significant in relation to the composition as a whole, [Newton's] experts are either silent or fail to distinguish between the sound recording, which was licensed, and the composition, which was not. Moreover, their testimony on the composition does not contain anything from which a reasonable jury could infer the segment's significance in relation to the composition as a whole.").

172. *See* Roy Export Co. Establishment v. Columbia Broadcasting Sys. Inc., 503 F. Supp. 1137, 1145 (S.D.N.Y. 1980), *aff'd*, 672 F.2d 1095 (2d Cir. 1982).

173. *Newton*, 388 F.3d at 1196.

174. *See id.*

175. *See id.* at 1194-96.

176. Graber began by accepting the majority's inherent assumption that Newton's work was sufficiently original to merit copyright protection. This is an important point. As we will discuss in Part III, the majority's analysis might have been better phrased as a denial of originality. *See id.* at 1197 (Graber, J., dissenting). While it was not necessary to reach this point, given the lack of substantial similarity, the Court deliberately chose not to reach it, implying that the majority thought the substantial similarity test was a better ground for deciding the case.

appropriation of the sampled segment . . . ."[177] Graber found that Newton had presented evidence that the sample is "so compositionally distinct that a reasonable listener would recognize the sampled segment even if it were performed by the featured flautist of a middle school orchestra."[178] Not only did the majority oversimplify the nature of the piece as a "3 note-sequence," but it also failed to realize that three-note sequences, like the theme of Beethoven's Sixth Symphony, can be very distinctive.[179] This raises the question of whether the judges in the majority were simply exercising their own judgment in finding Newton's avant-garde notes to be unappealing, something that they would never have done with Beethoven's work.

Graber then used Newton's expert testimony to show that the majority had usurped the role of the fact finder in deciding whether the piece was qualitatively substantial. She identified segments of Newton's expert testimony that plainly supported a finding that there was little difference between the composition and the recorded performance, and that the composition, standing alone, was substantial.[180] By quoting Professor Christopher Dobrian's entire statement regarding the distinctiveness of the portion at issue, Graber showed that the court had taken his statement that the piece was "a simple 'neighboring-tone'" out of context and that, in fact, Newton's experts did provide evidence that the filtered composition was substantial:

> Applying traditional analysis to this brief excerpt from Newton's "Choir"—i.e., focusing solely on the notated pitches—a theorist could conclude (erroneously, in my opinion) that the excerpt contains an insignificant amount of information because it *contains a simple "neighboring-tone" figure*: C to D-flat and back to C. . . . If, on the other hand, one considers the special playing technique described in the score (holding one fingered note constant while singing the other pitches) and the resultant complex, expressive effect that results, it is clear that the "unique expression" of this excerpt is not solely in the pitch choices, but is actually in those particular pitches performed in that particular way on that instrument. These components in this particular combination are not found anywhere else in the notated music literature, and they are unique and distinctive in their sonic/musical result.[181]

Importantly, Graber explained, this means that "the 'playing technique' . . . is a built-in feature of the score itself. . . . [A]ny flautist's performance of the sampled segment would be distinctive and recognizable, because the score itself is distinctive and recognizable."[182] The majority seems to have taken Dobrian's statement out of context. At the very least, a reasonable jury could have taken Dobrian's statements to mean the composition was substantial. The court went too

177. *Newton*, 388 F.3d at 1197 (Graber, J., dissenting).

178. *Id.*

179. *Id.*

180. *See id.* ("Professor Wilson concludes that the score 'clearly indicates that the performer will simultaneously sing and finger specific pitches, gives a sense of rhythm of the piece, and also provides the general structure of this section of the piece. Hence, in my opinion, the digital sample of the performance . . . is clearly a realization of the musical score filed with the copyright office.'").

181. *Id.* at 1198 (emphasis added) (original emphasis omitted).

182. *Id.*

far in stating that Newton had not presented evidence on this question.[183]

Graber's discussion of the expert opinions reveals two important points. First, as this Note will take up in Part III, the court has misinterpreted Newton's score, taking the simplicity of the written notes as the totality of the composition. Second, the wide ranging and unfocused expert testimony let into the extrinsic test allowed the majority to pick and choose which aspects of the testimony to find meaningful for the determination of substantial similarity. The court improperly excised the score and usurped the role of the jury by resolving questions of fact as set out by the experts.

III. ANALYZING THE *NEWTON V. DIAMOND* DECISION

Having discussed the majority's and dissent's arguments, we can now analyze the decision and its underlying assumptions. Improper reliance on expert testimony, unfounded attitudes about improvisation and jazz, imprecise separation of performative and compositional elements and the narrow treatment of music copyright all improperly influenced the court's decision. By analyzing each of these mistakes, we will be able to propose a more appropriate methodology for analyzing copyright infringement actions in music.

Part III.A will examine the court's extrinsic/filtering test. Through an analysis of the decision, it will propose a more genre-neutral approach to extrinsic analysis. This method will utilize multiple performances of a given composition and narrowly confined expert testimony to ascertain the level of control that a composition exercises over any given performance.

Part III.B will focus on the intrinsic test. It will attempt to pin down the standard the Ninth Circuit actually applied in *Newton* when compared with the court's theoretical standard. It will also look at the way that the expert testimony influenced the court's intrinsic analysis. Using the Fourth Circuit standard as a guide, it will propose a more appropriate way of using expert testimony to analyze "Choir" for courts intent on using expert testimony during the intrinsic test. Finally, it will discuss the policy implications of *Newton* and propose steps for courts going forward.

A. EXTRINSIC TEST

1. The Court's Filtering Process and the Difference Between Musical Composition and Musical Performance

At the core of the court's extrinsic analysis was a fundamental misunderstanding of the difference between a musical composition and a musical performance. The Beastie Boys had only licensed the sound recording copyright and not the composition copyright for "Choir," so the court needed to separate the two types of copyright. In doing so the court drew on expert testimony, which emphasized that

183. *See id.*

anything truly creative in jazz is improvised. But the court did not attempt to specifically describe which parts of "Choir" were attributable to improvisation. In failing to do so, the court discounted the artistic value of the composed portions without thorough analysis.

Crucially, the court's analysis failed to distinguish between the two types of improvisation that are present in "Choir" or in any jazz piece,[184] which we might call high and low improvisation.[185] These are not technical terms, but simply a useful way to explain how improvisation is used in music. An understanding of these two separate types of improvisation can help courts to more accurately evaluate the role of improvisation in a given composition and avoid the confusion seen in the Ninth Circuit's analysis. This section will use these concepts to propose a workable framework for courts to use in assessing the quantity and substance of the improvisation allowed in a given composition. This analysis will reveal that the sampled portion of the "Choir" composition did not allow for the level of improvisation that the Ninth Circuit attributed to it.

"High improvisation" is the type of improvisation that is called to mind when someone thinks of a jazz solo.[186] This consists of the improvisation of a melody, either over a harmonic structure or completely unaccompanied. It is important to note that this is not present just in jazz but was also prevalent in classical music until the twentieth century.[187] For example, Bach expected a great deal of melodic improvisation from his performers and often improvised himself on the organ.[188] Forms like the Piano Concerto featured cadenzas where famous improvisers could showcase their skills.[189] Mozart was also widely known for his improvisation skills.[190] In modern music, jazz is perhaps the best example of this type of improvisation.

Even high improvisation is not free from constraint. In a traditional jazz composition, one musician solos while the rest of the band continually plays the harmony of the underlying piece.[191] The opening melody, the underlying harmony

184. *See, e.g.*, *id.* at 1194 ("This is particularly true with works like 'Choir,' given the improvisational nature of jazz performance and the minimal scoring of the composition."). The Court seems to think that the general statements made by the expert apply equally to any given portion of a jazz composition.

185. This wording is my own and is used throughout the Note.

186. To get a better idea of this concept, listen to the portions of "Choir" that call for improvisation, or to the solo of any jazz recording. Coleman Hawkins' performance in "Body and Soul" is a good example. *See* HAWKINS, *supra* note 127.

187. *See* Bruno Nettl et al., *Improvisation*, GROVE MUSIC ONLINE, OXFORD MUSIC ONLINE, http://www.oxfordmusiconline.com:80/subscriber/article/grove/music/13738pg2 (last visited Feb. 16, 2013) (providing a detailed discussion of improvisation in classical music as it progressed).

188. *See* PAMELA RUITER-FEENSTRA, BACH AND THE ART OF IMPROVISATION (2011).

189. *See* Robin Moore, *The Decline of Improvisation in Western Art Music: An Interpretation of Change*, 23 INT'L REV. AESTHETICS & SOCIOLOGY OF MUSIC, 61, 63 (June 1992).

190. *See* J. RICHARD DUNSCOMB & DR. WILLIE L. HILL, JR., JAZZ PEDAGOGY: THE JAZZ EDUCATOR'S HANDBOOK AND RESOURCE GUIDE, 11 (2002); TOM PIAZZA, UNDERSTANDING JAZZ, 104-05 (2005) ("Johann Sebastian Bach was a legendary improviser on the organ, as were both Mozart and Beethoven on the piano.").

191. *See* PIAZZA, *supra* note 190, at 108 (describing a song's harmonic progression as "a mutually understood harmonic story line on top of which each musician constructs his own specific retelling of

and the rhythm played by the band all affect the content and structure of a given solo. In a solo piece, there is more room to freely improvise, but the opening and closing melody and the time indicated for soloing still provide structure for the solo.[192] In "Choir," high improvisation takes place in the large, middle portion of the piece, in which Newton plays under no direction from the score other than the portion of time to improvise and the framing of the composed portions. Note that the Beastie Boys did not sample the high improvisation portion of "Choir."

"Low improvisation" is the type of improvisation present in all fully notated music. For example, the score of Beethoven's Sixth Symphony only annotates the way that the piece should be played up to a point. The types of notes and general rhythm are specified but the piece is still susceptible to near limitless variation. As scholars have described:

> One can listen to two versions of Beethoven's Sixth Symphony, one conducted by Herbert von Karajan and one conducted by Fritz Reiner, and they will sound almost like two different pieces of music. There are always questions of interpretation in human performance of music, and sometimes these questions are settled at the time of performance.[193]

The control exercised by the composer in specifying the rhythm and notes maintains the impression that both songs are Beethoven, and, indeed, copyright would treat both performances as Beethoven's Sixth Symphony.[194]

This type of improvisation is also present in the composed melodic parts of a jazz composition. For example, if one listens to Benny Goodman, Coleman Hawkins, Charlie Parker and John Coltrane each play the composition "Body and Soul," the opening melodic line would be vastly different in style, but each performance would be immediately recognizable as "Body and Soul."[195] Low improvisation is present in every performance of a musical composition and is not

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the story").

192. This is true in both a formal and a thematic sense. Formally, the composed portions mark when the song begins and ends, and the time for improvisation tells the soloist how long to improvise. Thematically, the opening portions serve as the first lines that the soloist will take. Because the improvisation must follow these lines and end with the closing lines, it naturally must be in dialogue with them.

193. PIAZZA, *supra* note 190, at 104.

194. Interestingly, Jamie Lund, in an empirical study, argued for this type of technique to supplement what Lund found was the lay listener's questionable ability to separate performance from composition in a given version of a song. Just as listeners become acquainted with Beethoven by listening to different versions of Beethoven, a jury might come to understand the composition by listening to different versions of it. *See* Jamie Lund, *An Empirical Examination of the Lay Listener Test in Music Composition Copyright Infringement*, 11 VA. SPORTS & ENT. L.J. 137, 175 (2011) (arguing for this technique as one way to "better inform jurors as to the distinction between composition and recording by having jurors listen to several different recordings of the songs. As jurors listened to the various recordings they might be better able to determine what compositional elements are common to every recording of a particular song, and be able to discount the performance elements").

195. Another way to conceptualize this type of improvisation is to imagine a dramatic script. A comedic troupe and a drama troupe might deliver the performance in very different ways, even though they follow the script exactly. The on-the-spot subtleties of performance are not, and typically could not be, specified in the script.

completely within the control of the composer.[196] However, the more specific a composer's notation is, the less room there is for low improvisation. Components of a song that can be specified include melody, rhythm and harmony but also features as specific as instrumentation, timbre and technique.[197] This is the type of improvisation present in the sampled portion of "Choir."

Looking at the sampled portion of "Choir," there is actually a great deal of specification in the musical composition. Newton notates the instrumentation (flute), the melodic notes (C, D, C + sung C), the rhythm, at least minimally (senza misura/largo), and the technique (singing and fingering simultaneously).[198] Any performed version of "Choir" will necessarily be played on a flute, with this singing/fingering technique and with these specific notes. This is more specification than in the composed portion of the typical jazz piece and even most classical pieces. The sampled portion of "Choir" contains relatively little room for high improvisation.

In order to properly analyze the level of improvisation in any piece, a court should first ask what type of improvisation is present in the score and how much room the score leaves for improvisation. By failing to distinguish between high and low improvisation and failing to analyze the specific sounds attributable to the composition, the *Newton* court overestimated the contribution of improvisation to the recording,[199] which in turn led the court to underestimate the breadth of Newton's composition and composition copyright.[200] A large part of Newton's technique, which includes playing and singing specific notes into a flute, is a notated part of the score.[201] The only place for variation in the performance of this portion is in the exact manner and degree that the performer blows into the flute. This is not artistically meaningless, but it is not a high degree of improvisation. The majority was not willing to call the work unoriginal,[202] suggesting that there is something unique about the portion. With little room for even low improvisation, the extrinsic test should not have taken away much from the composition copyright. This underscores the court's vague, expert-driven method of separation. The decision was led astray by testimony about improvisation in jazz and Newton's technique, untempered by an understanding of the types of improvisation in music. Aspects of the testimony that did touch on these issues were overlooked by the

196. PIAZZA, *supra* note 190, at 104.

197. This follows from the basic fact that performers will try to play what the composer specifies. If the composer leaves a lot of room for interpretation, each interpreter must improvise the nonspecified portions of the composition. The more specification, the less room for improvisation.

198. *See* Newton v. Diamond, 388 F.3d 1189, app. at 1199 (9th Cir. 2004).

199. *See id.* at 1194 (noting that the "Newton Technique" could not be ascribed to the written composition, but not describing what exactly the piece would sound like without it).

200. In fact, the Court seemed to ignore or distort the aspects of Professor Dobrian's declaration, which indicated that the composition was responsible for much of the uniqueness of the piece. *See Newton*, 388 F.3d at 1198 (Graber, J., dissenting).

201. *See id.* at 1197.

202. *See id.* at 1190 (deciding to affirm the case only on substantial similarity grounds); *id.* at 1197 (Graber, J., dissenting) ("I agree with the majority's assumption that the sampled portion of 'Choir' qualifies as 'original' and therefore is copyrightable."). While it is true that the majority did not have to reach this question, the lower court did.

majority, which chose to focus on other aspects of the piece.[203]

It is tempting to blame Newton's experts for failing to adequately highlight the specificity of "Choir's" score. However, the experts' testimony is less to blame than the court's failure to properly sift through it. To that point, the dissent cites aspects of the expert testimony that directly discuss the amount of the recording that should be attributed to the composition, yet the majority denied that any relevant testimony existed and even quoted this testimony to the opposite effect.[204] This supports an argument that the expert testimony needs to be narrowly confined to the relevant issues. Still, it seems unlikely that a court could ever have the expertise to properly evaluate the technical testimony of experts in order to analytically dissect the elements of the piece. Moreover, the idea that an analytic process can accurately separate performance and composition is questionable at best.

A better method of extrinsic analysis would involve comparing multiple third party performances of the composition.[205] Courts could more effectively analyze the amount of specificity in the composition by comparing multiple performances of the piece. With each performance, the court would have a better idea of which elements are constant throughout multiple performances, i.e., those attributable to the composition, and those elements that are distinctive to each performance, i.e., those attributable to each individual sound recording. Jamie Lund has studied the ability of lay listeners to tease out the elements of a composition by listening to multiple versions of the same sheet music.[206] The study found that listening to one version of a given composition gave sample jurors almost no ability to distinguish performance from composition, but suggested that jurors exposed to multiple performances of a song "might be better able to determine what compositional elements are common to every recording of a particular song, and be able to discount the performance elements."[207] If multiple versions of the piece exist, this can be easily accomplished. If not, the court can commission performers to play the song for the court. While experts may not be completely useless in this context, multiple performances of a given composition could be an extremely useful way of quantifying the exact control that a given composition holds over a performance.[208]

203. Significantly, the Court focused on the parts of the testimony discussing jazz and improvisation and the common nature of the written notes.

204. *See Newton*, 388 F.3d at 1197-98 (Graber, J., dissenting).

205. *See* Lund, *supra* note 47, at 175 (suggesting this method as a means of aiding the substantial similarity test). This technique might work just as well for sorting out what is dictated by the score and what is added by the performer.

206. *See id.*

207. *See id.* ("As jurors listened to the various recordings, they might be better able to determine what compositional elements are common to every recording of a particular song, and be able to discount the performance elements.").

208. In this regard, it is worth noting that Newton recorded "Choir" three times. In the album *In Venice*, he recorded the song in the context of a general suite. *See* JAMES NEWTON, JAMES NEWTON IN VENICE (Celestial Harmonies 1988). Importantly, the sampled portion of the work is clearly identifiable, even though it does not sound exactly like the one in *Axum*. *See* JAMES NEWTON, AXUM (ECM 1982). The difference, however, is very small. Indeed, Newton's attorney argued that this was proof of the composition's substance. Brief for Appellant at 39, Newton v. Diamond, 388 F.3d 1189

2. Signs and Signifiers

If a composition copyright consists of all the elements necessitated by the score in a given performance, it should include more than just the notes written in the score: it should extend to all sounds consistently created by artists performing the score. The *Newton* court treated the notes written in the sheet music as the only sounds that the sampled portion of the "Choir" composition represented. As discussed above, however, following the instructions of the score creates an effect involving timbral and microtonal sounds that goes beyond the specific notes written in the score. Modern sheet music is designed for classical and popular music, which generally does not include such effects. Jazz critics have often identified the "futility of formal musicology when dealing with jazz."[209] A score is not meant to be a recording of all the sounds created by music, but rather instructions on how to create those sounds. Thus, courts should be weary of simply treating the written notes themselves as the boundaries of the composition. Multiple performances of the song serve as a better guide to the level of control that the sheet music holds over any performance.

The commentary to *Newton v. Diamond* featured in the Music Copyright Infringement Resource advances the opposite position. The commentary analogizes the score of "Choir" to an identical score written for full organ.[210] If this score were played in Riverside Church on organ X, the combination of the organ and the church would create different ambient and microtonal sounds than if it were played on organ Z in a different church.[211] The commentator explains that "performance instructions may consistently result, among various performers, in the production of many sounds and pitches besides those indicated in the score, but these instructions do not necessarily add much to the underlying musical composition."[212]

This analogy is unpersuasive for a number of reasons. First of all, the organ and flute are two very different instruments. The technique contained in the "Choir" score was developed by Newton's unique experience with the flute, and thus represents creative and original instructions.[213] By contrast, the instructions to play "full organ" are a commonplace technique that an average performer can play.[214] Moreover, the ambient sounds attributable to the "Choir" score are not analogous to

(9th Cir. 2004) (No. 02-55983). Of course, one may argue that this is due to Newton's consistent approach, not to the composition. This may have led the Court to reject this argument, and a sampling of different performers, with different sensibilities and styles, might solve this problem in future cases.

209. JONES, *supra* note 2, at 19.

210. Columbia L. Sch. & USC Gould Sch. of L, *Newton v. Diamond 349 F.3d 591 (9th Cir. 2003)*, MUSIC COPYRIGHT INFRINGEMENT RESOURCE, http://mcir.usc.edu/cases/2000-2009/Pages/newtondiamond.html (last visited Nov. 3, 2013). Full organ is a technique for playing the organ.

211. *Id.*

212. *Id.*

213. Newton v. Diamond, 388 F.3d 1189, 1197-98 (9th Cir. 2004) (Graber, J., dissenting).

214. Peter Williams & Martin Renshaw, *Full Organ*, GROVE MUSIC ONLINE, OXFORD MUSIC ONLINE, http://www.oxfordmusiconline.com/subscriber/article/grove/music/10379 (last visited Oct. 23, 2013) ("[F]ull organ in the sense of 'loud organ' has always meant the use of as few (or as many) stops as will make the maximum of impression with the minimum consumption of wind.").

the sounds that playing the Riverside Church Organ create. Unlike the church-based sounds, which seem relatively unimportant to the score, it is precisely the ambient and microtonal notes produced by Newton that the Court considered to be the important part of the "Choir" performance. If performing the score consistently produced those sounds, they should certainly be considered an important part of the score.

The Court seems to have thought that Newton's score does not require the production of these ambient sounds. In criticizing Newton's experts, the Court says that "they continually refer to the 'sound' produced by the 'Newton technique.' A sound is protected by copyright law only when it is fixed in a tangible medium."[215] But Newton did fix these sounds in a tangible medium: the instructions for producing the sounds of the "Newton Technique" in "Choir" sit right next to the notes.[216] Consider an example: Imagine painting instructions that say to mix equal parts of yellow and blue plaint. It would be impossible to follow the instructions without making green, yet under the court's analysis the instructions would only fix yellow and blue.

While more focused expert testimony might partially solve this problem, the playing of multiple versions of the song would more clearly reveal which sounds were attributable to the composition copyright. Had the Court heard other flute players' versions of "Choir," it would likely not have attributed so much of the piece's distinctive sound to Newton's performative techniques, but instead to his gifts as a composer.

3. America, Jazz and the Myth of Improvisation

The opening sections of this Note described jazz's somewhat tortured historical struggle with its reputation for being principally improvised music. This notion was shown to be not only misguided but also the cause of serious problems for jazz musicians' identities and reputations. Similarly, the *Newton* decision shows how jazz's reputation for improvisation has permeated copyright law and resulted in the diminished protection of jazz musicians' work.

The *Newton* court relied on snippets of the expert testimony that described jazz and "Choir" as improvised art, instead of looking more carefully at the score precisely because of this reputation for improvisation. Jazz musicians have struggled for years to attain the same sort of legitimacy that classical composers enjoy. We should be cautious not to characterize carefully composed music as improvisation.

In many ways, the other problems discussed in this Note all stem from that one misconception. The assumption that all jazz is improvised led to other conclusions that underlay the *Newton* court's decision. We have already seen how the court's method in *Newton* was analytically vague. By identifying "Choir" with jazz and identifying jazz with improvisation, the court was able to attribute much of the

215. *Newton*, 388 F.3d at 1194.

216. Another way to approach this Note's topic might be to explore the nature of fixation of a composition and to what extent courts treat sheet music as a record of certain sounds.

value of the piece to some vague sense of jazz improvisation. A court possessed of a mistaken understanding of jazz will always be able to find isolated statements in expert opinion that support that view.

In order to ground copyright analysis in a more genre-neutral standard and to avoid underestimating the value of nontraditional compositions, courts should engage in a more exacting separation of compositional and performative elements. The best way to do this is to focus expert testimony on explaining the level of control a composition has over any given performance, and to avoid general discussions about the improvisational nature of a given genre. Examining multiple performances of a work is indispensible to such an analysis.

4. Refined Expert Testimony

If courts continue to use expert testimony in employing the extrinsic test, this testimony should be more directly focused on understanding the differences between the composition copyright and the sound recording copyright. The experts' broad and meandering testimony seems to have greatly confused the judges.[217] Learned Hand aptly stated that expert testimony on substantial similarity "cumbers the case and tends to confusion."[218] The experts in the *Newton* case spoke generally about improvisation in jazz and very technically about microtonality and tone clusters, but this did not help the judges to separate the composition from the performance.[219]

There are a few ways in which the experts' testimony could be made more helpful and accurate. First, the court should confine the discussion of the experts to explaining the extent to which the recording is a reflection of the composition. For this purpose, experienced musicians might be more effective than professors, because they have actual experience in the relationship between composition and performance. Second, expert testimony should be used in conjunction with multiple performances of the composition in order to highlight the distinction between performance and composition distinction. The performances would serve as a frame of reference to help guide the experts. Finally, experts can better confine themselves to the composition-performance distinction by keeping in mind the high- and low-improvisation framework discussed above.

217. The testimony touched on the general musical worth of the composition, jazz and improvisation and on the extent to which the composition dictated the performance. Only the last point was directly relevant. This breadth left too much room for the judges to pick and choose on which testimony to rely. For example, as Judge Graber pointed out, the Court picked out the line describing the piece as a "simple 'neighboring tone' figure" from a paragraph explaining that the composition itself was substantial. *Newton*, 388 F.3d at 1198.

218. Nichols v. Universal Pictures Corp., 45 F.2d 119, 123 (2d Cir. 1930).

219. *See e.g. Newton*, 388 F.3d at 1194 (making general references such as "given the improvisational nature of jazz" and stating vaguely that "the sound recording of 'Choir' is the product of Newton's highly developed performance techniques, rather than the result of a generic rendition of the composition"). I concede that my analysis is based upon the aspects of the testimony that the Court chose to highlight; however, this does not change the fact that these aspects of the experts' testimony caused confusion among the judges.

5. Fixation and the Choice Between Using A Sound Recording or Sheet Music for Musical Composition Copyrights

Another way of looking at the court's extrinsic analysis is through the lens of the fixation requirement. Copyright law only protects works "fixed in a tangible medium of expression."[220] When the court separated the improvised elements from the "Choir" composition, they were effectively ruling that because improvised elements are not fixed in the sheet music, they cannot be protected.[221]

If the problem with Newton's composition was that he was not able to adequately fix the elements of his composition in the sheet music, would it be better for composers of nonconventional music to use sound recordings when registering their compositions?[222] There are two basic advantages to fixing a composition in a sound recording. First, using a sound recording removes the danger of notating less in the sheet music than the musical compositional copyright could otherwise cover. For instance, a court should not be able to argue that certain techniques were not a part of the composition if they were fixed in the recording.[223] In theory, the sound recording should be read to contain the maximum specificity possible.[224] Secondly, courts may be less likely to focus on the melody, harmony and rhythm, which conventional sheet music emphasizes, and may instead focus on all of the elements important to the piece at hand. This would theoretically ensure a more genre-neutral treatment of the composition.

Yet, in practice, using a sound recording to fix composition copyrights may create more problems than it solves. First, courts may be inclined to attribute only the standard elements of specificity to the composition when they do not have the specific written notation. For example, the *Newton* court attributed much of the sound to improvisation and focused on the standard notational elements, even though the notation was very specific as to other elements of the piece. Scholars agree that a composition copyright based on a sound recording would not encompass all features of the sound recording.[225] Because the sound recording provides no boundaries for what must be in the music, such musical composition copyrights might be more susceptible to the imprecise excising of performative elements. The real problem in Newton's case was the vague and general method of

220. 17 U.S.C. § 102 (2013).

221. *Newton*, 388 F.3d at 1194.

222. For a discussion of this theory, see LEE, *supra* note 91, § 7:38 ("One also wonders how the Newton panel would have ruled if plaintiff had registered his musical composition copyright with a sound recording rather than written score. Such a registration would necessarily have included the 'dense cluster of pitch and ambience sounds' which were found missing from the written notation, and thus given the music composition copyright owner a stronger claim to protection of those elements under the music composition copyright.").

223. *Id.*

224. However, as the *Newton* decision indicates, not all experts are willing to go that far. *See, e.g.*, NIMMER, *supra* note 14, § 205[A] (noting that the "distinctive voice or the timbre of guitars and drums" should not form a part of the composition copyright fixed through a sound recording).

225. *See* Lund, *supra* note 47, at 144 (claiming that only melody, rhythm and harmony are covered) and NIMMER, *supra* note 14, § 2.05[A] (arguing for slightly more than melody, rhythm and harmony, but not as much as is actually included in the performance).

analysis. The answer to this problem is to use multiple performances of the composition to rigorously and accurately separate the compositional and performative elements of the sound recording. Notice that if Newton had registered the composition through a sound recording copyright, this task would be even more difficult, because the court would not even have sheet music to rely on.

There are additional reasons why an artist might not prefer to use a sound recording to fix a composition copyright. When the extrinsic test is performed properly, the composer has a great deal of control over what is covered by the composition copyright if he fixes it on sheet music. At least in theory, one may, like Newton, choose to specify instrumentation, technique and other factors, or one may choose to specify the bare bones of the score, allowing licensed performers to interpret their work in any number of ways.[226] The use of sound recordings may be ideal for artists who don't read or write music but still want a copy of their composition registered. Sound recordings, therefore, are most useful when artists either are not concerned with controlling the level of specification in their composition or are unable to confidently write sheet music.

B. INTRINSIC TEST

We now turn to an analysis of the court's intrinsic test. While the extrinsic test is explicitly a matter of law performed by judges who may rely on expert testimony, the intrinsic test has been described as a paradigmatic jury question. Since *Newton* was a summary judgment case, the court had to find that no reasonable jury could find the Beastie Boys' sample to be substantially similar to "Choir." However, the practicalities of modern jurisprudence require judges to rule on motions of summary judgment. Thus, any thoughtful analysis of the court's reasoning will have to seriously consider the consequences of rulings at the summary judgment stage rather than elsewhere in the litigation process.

1. Fragmented Literal Similarity and Quantitative Substantiality

As discussed above, the *Newton* court's first step was to hold that the sample of "Choir" used by the Beastie Boys was not quantitatively substantial in relation to the work as a whole.[227] In doing so, the court placed heavy emphasis on the fact that the sample was only a few seconds long.[228] Due to the brevity of the average sample, the *Newton* standard makes it unlikely that a sample can ever pass the quantitative portion of the substantial similarity test.[229] This is especially true

226. Lund, *supra* note 47, at 144 (citing the ability to have, for example, both country and R&B performances of your copyrighted work as an advantage of confining composition copyrights to melody, rhythm and harmony).

227. Newton v. Diamond, 388 F.3d 1189, 1195-96 (9th Cir. 2004).

228. *Id.* ("When played, however, the segment lasts six seconds and is roughly two percent of the four-and-a-half-minute 'Choir' sound recording licensed by Beastie Boys.").

229. I do not address the fair use defense in any detail in this Article. I would note, however, that the use in most sampling cases is usually commercial, not a parody or any other sort of criticism, and has been held in most cases not to be fair use.

given the fact that the court refused to take account of the repeated use of the sample in "Pass the Mic."[230]

A more expansive understanding of quantitative substantiality would have put more weight on the fact that the sampled portion of "Choir" was a large part of the nonimprovised portion of the work, or that very similar variations of the sampled motif are repeated throughout "Choir." Because the sampled composition is varied through the work, it would not be inconsistent to see it as representing more than its exact recorded timing. In fact, in a recent case dealing with sampling in other Beastie Boys songs, the Southern District of New York suggested that where a sampled portion is used more than once in a song, it should count as quantitatively more of the piece.[231] Still, the court's decision is reasonable given the need for a clear standard of quantitative substantiality and the presence of the more subjective qualitative test to deal with more abstract notions of substantiality.

2. Qualitative Substantiality: Effect of the Filtration

Next, the Court focused on the qualitative substantiality of the sample. In doing so, the court used the filtering from the extrinsic test as a means of discounting the overall qualitative value of the piece. For instance, even though the Beastie Boys said that they sampled the best portion of "Choir,"[232] the court attributed the sample's quality to the sound recording.[233] The court thus began the intrinsic test with the assumption that the sampled portion was simplistic and therefore not substantial.[234]

The *Newton* Court's analysis shows three ways in which the extrinsic test can negatively affect the intrinsic test. First, an extrinsic analysis that goes too far in attributing the elements of the composition copyright to the sound recording copyright can seriously weaken and undermine the substantiality of the composition before even reaching the intrinsic test. Second, the use of experts in the extrinsic test can infect the intrinsic test. While the Ninth Circuit does not technically allow the use of expert testimony in the intrinsic test, the *Newton* court required Newton's experts to present evidence of substantiality to avoid summary judgment.[235] Once the court admitted expert testimony, it was disposed to use that testimony throughout, despite its lack of relevance to the lay listener test. Finally, the ambiguous use of experts makes it difficult to properly weigh their testimony.

230. *Id.* at 1195.

231. TufAmerica, Inc. v. Diamond, 12 CIV. 3529 AJN, 2013 WL 4830954 *14 (S.D.N.Y. Sept. 10, 2013).

232. Brief for Appellant at 18, Newton v. Diamond, 388 F.3d 1189 (9th Cir. 2004) (No. 02-99583).

233. *Newton*, 388 F.3d at 1194.

234. *Id.* ("Once we have isolated the basis of Newton's infringement action—the 'Choir' composition, devoid of the unique performance elements found only in the sound recording—we turn to the nub of our inquiry.").

235. *Newton*, 388 F.3d at 1196 ("Newton has failed to offer any evidence, however, to rebut Dr. Ferrara's testimony and to create a triable issue of fact on the key question, which is whether the sampled section is a qualitatively significant portion of the 'Choir' composition as a whole.").

The court's jurisprudence explicitly holds expert testimony to be irrelevant to the intrinsic test.[236] Thus, Newton's experts likely would not have thought to discuss substantiality. Yet, Newton seems to have been penalized for their failure to do so. If experts are to be used for the intrinsic test, this should be made clear before they testify.

3. Understanding the Standard Used in *Newton*

The preceding section shows that the intrinsic test that the Ninth Circuit employed in *Newton* was not a pure lay listener test. This section will attempt to properly characterize the court's approach. As applied in *Newton*, the court has moved toward a test that relies on the evaluations of experts to decide whether two pieces are substantially similar. This standard relies more on expert testimony than either the lay listener test or the Sixth Circuit's intended audience test.

The exact nature of the *Newton* court's decision is difficult to ascertain, because the theoretical doctrine did not match its practical methodology. At the beginning of the opinion, the Ninth Circuit explicitly adopted a pure lay listener test, which forbids expert testimony in the intrinsic analysis.[237] Moreover, amici composers urged the court to abandon the lay listener test in favor of one that used expert testimony to help the court evaluate the music through a specialized perspective, seeing this as critical to Newton's case.[238] Scholars writing before and after the *Newton* case have similarly favored expert testimony as a way to protect composers' rights.[239] Contrary to these assertions, the decision ultimately drew upon expert testimony with the opposite effect.[240]

One might be tempted to think that the court's decision represents a tacit adoption of the Fourth Circuit's intended audience test.[241] A close analysis, however, reveals that the court was not following the Fourth Circuit test. The

236. *See, e.g.*, Sid & Marty Krofft Television v. McDonald's Corp., 562 F.2d 1157 (9th Cir. 1977).

237. *Newton*, 388 F.3d at 1197 ("[A] use is de minimis only if the average audience would not recognize the appropriation.").

238. Brief for Meet the Composer, *supra* note 11, at *1, *12 ("Amici agree with Petitioner James Newton that analysis of difficult and challenging musical works should not be left to an ordinary lay audience, but rather must be evaluated by an audience that has been provided with sufficient expertise to understand the language of the work in question.").

239. *See, e.g.*, Alice J. Kim, *Expert Testimony and Substantial Similarity: Facing the Music in (Music) Copyright Infringement Cases*, 19 COLUM.-VLA J.L. & ARTS 109, 124 (1995) ("There is something in music which makes it difficult for lay observers to agree as to whether the mere possibility of substantial similarity exists."); Brief for Meet the Composer, *supra* note 11, at *14 (calling for experts to be used in a more specific audience test); Lund, *supra* note 47, at 176 (concluding that "a modified version of the Lay Listener Test in which the potential for prejudice is mitigated through the use of expert testimony, special verdict forms, or through the use of multiple recorded versions of the same songs" would better serve the ends of the law).

240. In fact, *amici* petitioned for certiorari on the grounds that *Newton* was not consistent with this approach. Newton v. Diamond, No. 04-1219, 2005 WL 1170246, at *1, (U.S. May 11, 2005).

241. For this theory, *see* Reid Miller, Newton v. Diamond*: When A Composer's Market Is Not the Average Joe: the Inadequacy of the Average-Audience Test*, 36 GOLDEN GATE U. L. REV. 1, 14 (2006) ("In its reliance on the opinion of the creator's market, the *Newton* court was not looking to the response of the average audience but was really looking to the response of the intended audience.").

Fourth Circuit test states that "if the intended audience is more narrow in that it possesses specialized expertise, relevant to the purchasing decision, that lay people would lack, the court's inquiry should focus on whether a member of the intended audience would find the two works to be substantially similar."[242] The Ninth Circuit court did not look to the experts to set the framework for what the typical audience would think, but asked them to demonstrate why the portion was musically substantial.[243] Because the experts convincingly described the sampled portion as trivial and typical in musicological terms, the court found that it was insubstantial.[244] The Fourth Circuit mandates using expert testimony to better ascertain the perspective of the intended audience, not to decide whether the works are substantially similar.[245] Complex musicological testimony is not directly relevant to this test. The Ninth Circuit used the experts as the audience, rather than as a means to explain how a specialized audience would hear the work.

If the *Newton* court had wanted to follow the Fourth Circuit's intended audience test, then its inquiry should have started with an analysis of the specific type of audience that listens to Newton's music.[246] The court would have read the experts' testimony in order to discern which parts of the song the intended audience might find relevant.[247] Expert testimony on complex musicological elements would only be used to the extent that such elements were relevant to how the intended audience would perceive the work. However, the *Newton* court made no effort to ascertain whether the experts were representative of the intended audience. It does not even seem that the experts offered any testimony on the sophistication of the intended audience of the piece. The court merely used the expert testimony about the value

242. Dawson v. Hinshaw Music Inc., 905 F.2d 731, 736 (4th Cir. 1990).

243. Newton v. Diamond, 388 F.3d 1189, 1196 (9th Cir. 2004). (quoting the Beastie Boys' experts for the proposition that the sample is "simple, minimal and insignificant" and noting that "Newton has failed to offer any evidence, however, to rebut Dr. Ferrara's testimony and to create a triable issue of fact on the key question, which is whether the sampled section is a qualitatively significant portion of the 'Choir' composition as a whole").

244. *Id.* While the Court does qualify its discussion of experts at one point by saying, "to the extent the expert testimony is relevant," the only independent evaluation of the qualitative substantiality of the work consists of a one sentence description of the piece: "Indeed, with the exception of two notes, the entirety of the scored portions of 'Choir' consist of notes separated by whole and half-steps from their neighbors and is played with the same technique of singing and playing the flute simultaneously; the remainder of the composition calls for sections of improvisation that range between 90 and 180 seconds in length." *Id.*

245. Dawson v. Hinshaw Music, Inc., 905 F.2d 731, 736-37 (4th Cir. 1990).

246. *Dawson*, 905 F.2d at 736 ("When conducting the second prong of the substantial similarity inquiry, a district court must consider the nature of the intended audience of the plaintiff's work. If, as will most often be the case, the lay public fairly represents the intended audience, the court should apply the lay observer formulation of the ordinary observer test. However, if the intended audience is more narrow in that it possesses specialized expertise, relevant to the purchasing decision, that lay people would lack, the court's inquiry should focus on whether a member of the intended audience would find the two works to be substantially similar.").

247. *Id.* ("Such an inquiry may include, and no doubt in many cases will require, admission of testimony from members of the intended audience or, possibly, from those who possess expertise with reference to the tastes and perceptions of the intended audience."). In fact, if this is what the court wants to do, it should confine expert testimony to these factors. However, since the case was on appeal, the Court had no control over the content of the expert testimony.

of the sample to decide the substantial similarity issue. The court even went so far as to fault Newton's expert for not testifying to the value of the piece.[248]

The Ninth Circuit's resulting test is ultimately more expert driven than the test used in any other circuit. The *Newton* court seemingly abandoned the audience test altogether, opting for substantiality as measured by expert opinion. Ironically, this test closely resembles the test preferred by amici composers, but it had just the opposite of the intended effect.

The reason the court relied so heavily on expert testimony was because it followed a vague analytic framework when dissecting the elements of "Choir." In other words, the testimony stood in for the dissected composition. But even submitting this testimony to a fact finder for evaluation seems antithetical to the lay listener test, which relies on the impression created by the artwork rather than on the fact finder's analysis of the impressions of others. This problem is exacerbated when the court decides the issue at summary judgment. As a practical matter, it is difficult to tell what a piece will sound like from a purely analytic dissection of that piece.[249]

The *Newton* court's use of expert testimony reveals the potential problems with an expert driven substantial similarity test. In fact, such a test may actually serve to hurt experimental composers. Not only does it ultimately subvert the audience-based approach used for all other media, but it may also lead other courts to evaluate the musicological merit of a piece rather than its relation to the original work. This may lead to the underprotection of musical works and relegates cases of musical composition infringement to a separate copyright test. While it may not be helpful to use expert testimony, if a court does so, it should ensure that it tailors the process toward facilitating an understanding of the intended audience perception as outlined in the Fourth Circuit test.

4. Originality in Disguise?

Another way to view the *Newton* decision is to argue that the court was actually analyzing the originality of the sample. In other words, the court was not using expert testimony to decide the substantiality of the sample, but to find that the work was not original enough to warrant copyright protection. The majority's focus on the general creativity of the piece in musicological terms makes more sense within the originality analysis. In fact, the lower court used much of the testimony that the Ninth Circuit employed in its substantiality analysis to argue that the work was unoriginal.[250] Yet this argument cuts both ways. The Ninth Circuit was clearly

248. *Newton*, 388 F.3d at 1196 ("Newton has failed to offer any evidence, however, to rebut Dr. Ferrara's testimony and to create a triable issue of fact on the key question, which is whether the sampled section is a qualitatively significant portion of the 'Choir' composition as a whole.").

249. While the Ninth Circuit likely listened to the sampled portion of "Choir," the Court did not attempt to capture what the composition copyright would sound like. The only way to do this would be to listen to multiple performances of the piece.

250. Newton v. Diamond, 204 F.2d 1244, 1256 (C.D.Cal. 2002) ("[A]fter filtering out the performance elements, the court is left with a six-second snippet of Plaintiff's composition consisting of a fingered 'C' note and a sung three-note sequence C-D-flat-C. Courts have held that such small and

aware of the originality issue and specifically chose not to address it.[251]

Even assuming that it was applying the standards of originality, the court would have had to have applied a very unforgiving form of the test. As noted above, the threshold for achieving originality is very low.[252] Certainly the combination of the written notes and the specific guidelines for playing the flute are the unique product of Newton's mind. A decision based on originality would have to focus on the melody, rhythm and harmony and ignore the other elements of the notation. The Court's decision would represent the proposition that originality privileges standard notation to other less traditional forms of notation.

5. "Choir" in the Jazz Tradition

We have now seen how the *Newton* court engaged in an expert driven analysis even more extreme than the Fourth Circuit's intended audience approach. Instead of using expert testimony to illuminate the perspective that the average jazz audience would have on the sample of "Choir," expert testimony was used to evaluate the worth of the sample. This section will provide an example of how an intended audience would actually have looked at the piece.

The Court should have begun by asking whether the intrinsic test is outside of the scope of the lay listener's frame of reference. If not, no expert should be used, because a true lay listener is the appropriate fact finder for the determination. If the answer is yes, an expert should be called to testify to the genre of song and its intended audience. Without such a frame of reference, it is impossible for the expert to testify about such a specialized audience's response to the music. The expert should then assist the fact finder in understanding how the intended audience would perceive the song. This should not be a detailed analysis of the musicological terms or of the personal opinion of the expert, but instead should consist of whatever is necessary to perceive the song as an intended listener would. Accordingly, an avid jazz listener or a jazz musician, rather than a professor of music, would be the ideal expert.

Newton was writing in the jazz tradition, and the court was correct in mainly identifying his work as such. "Choir" would be intelligible to a jazz audience in the most common jazz format—the jazz sandwich form. At its least creative, this form involves taking a known melody and chord structure, playing the known melody once, then improvising melodies over the chords and returning to the theme.[253] When jazz musicians compose a new song, they often follow this general

unoriginal portions of music cannot be protected by copyright.").

251. *Newton*, 388 F.3d at 1192 ("Assuming that the sampled segment of the composition was sufficiently original to merit copyright protection . . . .").

252. *See supra* note 36 and discussion of originality *supra* Part I.B.1.

253. *See* KERNFELD, *supra* note 1, at 100. For a description of ways that improvisers related the composed song to their improvisation, see also BERLINER, *supra* note 138, at 175-76 ("Some musicians routinely alternate approaches to acquaint themselves with a composition, formulating their first solo chorus around the piece's melody, their second around its chords, and their third around its chord scales.").

format.[254] Performers of the composition will play these opening and closing parts of the song in much the same way, but will usually improvise a completely new portion in the middle.[255] For example, Coleman Hawkins, Benny Goodman and John Coltrane all play the opening theme to "Body and Soul" but then move on to very different improvised sections.[256]

"Choir" is one of the more creative examples of this sandwich form, because it has an original melody at its opening and closing. The sampled portion is the initial and main statement of the composed theme. Given that "Choir" retained this standard jazz format, the opening and closing theme of Newton's piece should be extremely memorable to even a casual listener.[257] In fact, a more experienced listener might pay careful attention at that point to see if the song is an old standard or an original. If any person tried to perform "Choir," he or she would play the opening and closing themes as Newton did. The middle portion would be improvised and therefore different from any succeeding version. It is hard to imagine how, even when filtered from some of the performative elements, the average jazz listener would not recognize this portion of the song. The sampled portion of "Choir" is what makes it a song rather than a recorded improvisation. Moreover, the opening melody is one of the most distinctive parts of a jazz song. Finally, while the sampled notes might be slightly common in avant-garde classical music, they are not so common in jazz flute compositions.

This Note does not necessarily recommend the use of experts for the intrinsic analysis. As the *Newton* case shows, they can often confuse the case more than help it. A jury that listened to "Choir" might have picked up many of the details discussed above, just as someone listening to Beethoven's Fifth Symphony might realize that the opening theme is important. Moreover, the notion that a composed introduction to a piece is substantial is something that average audiences are familiar with. It is hard to believe that the Beastie Boys would have sampled the excerpt and run it through over forty times if it wasn't distinctive. For this reason, it can be argued that even the Fourth Circuit would not have needed to use the intended audience test. If experts are used, however, they should not be used as the judges of substantial similarity but, as the Fourth Circuit has advocated, as guides to how the intended audience would hear the song.

6. The Practicalities of Summary Judgment

This Note has largely assumed that the lay listener test is primarily a question

254. *See* KERNFELD, *supra* note 1, at 100.

255. *Id.*

256. *See* COLEMAN HAWKINS, *Body and Soul*, *on* KEN BURNS JAZZ: COLEMAN HAWKINS (Verve Records 2000); BENNY GOODMAN, *Body and Soul*, *on* THE COMPLETE RCA VICTOR SMALL GROUP RECORDINGS (BMG Music 1997); JOHN COLTRANE, *Body and Soul*, *on* COLTRANE'S SOUND (Atlantic 1964).

257. The recent *TufAmerica* case took this approach, allowing an infringement claim involving the sampling of a phrase recited three times in the opening of a song and two times afterward to survive a motion to dismiss. TufAmerica, Inc. v. Diamond, 12 CIV. 3529 AJN, 2013 WL 4830954 *12 (S.D.N.Y. Sept. 10, 2013).

for the jury and that summary judgment is appropriate only in cases where no reasonable jury could find a portion substantial. Under this assumption, it seems unlikely that any case should be dismissed on summary judgment so long as even a shred of original music survives the extrinsic test. But in fact, the realities of the federal court system, including a very busy docket and the settlement power associated with trials, require that judges dismiss cases more often than would ideally be the case.[258] These concerns likely motivated the court's decision in *Newton*.

The problem with the tendency to dismiss copyright infringement cases on summary judgment is that such dismissal is largely inconsistent with the fact-specific substantial similarity standard. If a court does want to dismiss such a case, it should articulate with specificity how the sampled portion is insubstantial. But there are alternative avenues for courts to rule on summary judgment without recasting the classic jury question of substantial similarity. For example, they may rule that the portion is not original enough to merit copyright protection. In *TufAmerica*, another case involving sampling in Beastie Boys songs, the court dismissed a claim of fragmented literal similarity infringement on originality grounds.[259] Such rulings are matters of law that judges are uniquely qualified to decide.

7. Sound Recordings and Compositions: Policy

The narrow approach that the *Newton* decision takes to samples of musical composition copyrights has important policy implications. As noted above, the court in *Bridgeport Music* immunized sound recordings from de minimis analysis without doing the same for composition copyrights.[260] Combining this with the restrictive de minimis analysis applied to Newton's composition copyright for "Choir" creates a national policy that is hostile to the composer and friendly to the record company.[261] For example, assume that the sound recording of "Choir" contained the same features as the composition in the *Newton* case. A court adopting both *Newton* and the *Bridgeport* de minimus standard would presumably find that the composition could not be protected but that the sound recording could be.

Pushing this conclusion further, it also seems likely that if composers manage to hold on to any sort of copyright, they will retain the composition copyright and not the sound recording copyright. The record company has a vested interest in holding onto a particular recording, and the performer or composer has an interest in holding onto the composition in order to continue to perform it. The

258. *See also* Julie J. Bisceglia, *Summary Judgment on Substantial Similarity in Copyright Actions*, 16 HASTINGS COMM. & ENT L.J. 51, 75 (1993).

259. TufAmerica, Inc. v. Diamond, 12 CIV. 3529 AJN, 2013 WL 4830954 *13 (S.D.N.Y. Sept. 10, 2013).

260. Bridgeport Music, Inc. v. Dimension Films, 410 F.3d 792, 801 (6th Cir. 2005).

261. I am not suggesting that record companies should not get their fair share of copyright credit, only that the copyright law should not promote a system unnecessarily tilted against composers.

combination of *Newton* and the *Bridgeport* standard means that, by default, the composer is in a weaker position to protect his copyright. Moreover, sampling hip hop artists will be unlikely to bother looking for a composer, but will make sure to compensate the owners of the recording copyright.

If one considers the effect that *Newton* and *Bridgeport* would have together, it seems that the Ninth Circuit should not adopt the *Bridgeport* holding.[262] On the other hand, the decision in *Bridgeport* does seem to have been well thought out. The Sixth Circuit rightly focused on legislative history to maintain that there *should* be a difference between the protections for sound recordings and for compositions.[263] But if we take *Bridgeport* as the rule, its effect is further enhanced when combined with *Newton.* If the Ninth Circuit were to end up adopting *Bridgeport*, it could avoid this problem by reconsidering the holding in *Newton.* Because of the potential problems they pose together, other circuits should avoid the confluence of the *Bridgeport* and *Newton* rules.

CONCLUSION

Perhaps the most important lesson to take away from this Note is that music is really no different than any other form of copyrightable expression. The protection of a musical composition should not be tied to the genre or emphasis of the music in question, but to whether it meets the requirements of the law. An analogy to a may be appropriate: Consider a painting. One might be able to generalize that among their main features, paintings emphasize color, perspective and form. But the fact that a given painting emphasizes texture, atypical materials or other features over color, perspective or form should not bar the protection of that expression.

Music is akin to painting a picture with sound. While the lack of court expertise in avant-garde music, as compared to its experience with popular music genres, may tempt it to confine musical composition to melody, rhythm and harmony, protectable musical compositions may emphasize many diverse components that include timbre, microtonality and extended techniques. Objective, uniform and genre-neutral evaluation methods are essential in order to guarantee all music proper protection under the law.

Fragmented literal similarity cases present an ideal lens through which to analyze these difficulties in musical infringement cases, because while the legal standard is genre-neutral, actual treatment may be biased. *Newton v. Diamond* is a useful paradigm for understanding where the analysis can go wrong. The court's extrinsic analysis relied too heavily on general testimony about improvisation in jazz, analyzed the piece through the conventions of popular music and failed to rigorously analyze which portions of the composition were composed and which were a product of performance. In the future, courts should combine attention to multiple performances of a composition with expert testimony that exclusively

262. Conversely, the Sixth Circuit would be advised to avoid the *Newton* holding.

263. *See Bridgeport Music*, 410 F.3d at 801.

addresses the relationship between composition and performance. By rigorously separating composition copyright from the recording copyright, courts can avoid instantiating the trends of popular music into the copyright law.

Beyond this, in the realm of the intrinsic test, courts face an assortment of problems. There will always be the temptation to use the expert testimony from the extrinsic test to evaluate the substantiality of the performance. This is a particular risk in jurisdictions where expert testimony is not allowed for the intrinsic test, because the experts will not necessarily have testified on this issue. But even in jurisdictions where expert testimony is allowed, courts should be careful about admitting such testimony. Experts should be admitted only where a lay jury would not be able to appreciate the music the way that the intended audience would. Moreover, experts should not testify as to the details of the composition or their substantiality, but only as to how the portion in question would be perceived by the target audience. Even under pressure to rule on summary judgment, courts should not allow their analysis to stray past the fundamentally audience-based analysis at the core of substantial similarity. This is especially true given the already harsher treatment of musical composition copyrights when compared to sound recording copyrights. By keeping to these rules, courts can insure a more genre-neutral treatment of all compositions.

The Supreme Court denied *certiorari* in the *Newton* case.[264] In doing so, the Court implicitly suggested that these issues are far from the point where a definitive, universal solution can be reached. There simply have not been enough cases involving nontraditional composition and sampling to be able to discern the best rule. On the other hand, as we have seen, these issues are extremely important to the musicians who are affected by them. A copyright regime that takes a hostile approach to certain genres can negatively affect the creation of these important types of music. This Note has shown how the difficulties that jazz artists experience regarding a prejudice towards improvisation have been exacerbated by the *Newton* decision.

Going forward, it is important that courts approach music in a genre-neutral fashion. The first step in doing so is the use of multiple performances to discern the difference between a composition and a performance. This should be combined with an attention to the workings of high and low improvisation. Next, where expert testimony is used in the extrinsic analysis, it should be utilized only to understand the level of control a composition exercises on the performance. Questions regarding the value of the composition need to be kept strictly out of depositions, declarations and affidavits, because they will only serve to muddle the court's analysis. Moreover, experts should be kept out of the intrinsic analysis. They simply cannot provide useful information for a court evaluating the reaction of a lay listener. In courts using the intrinsic analysis, experts should only help to frame the perspective of such a listener and not act as a guide to substantiality.

Finally, while the federal docket may push a court to rule at the summary judgment stage, it should respect the substantial similarity standard and only rule in

264. Newton v. Diamond, 545 U.S. 1114 (2005).

cases where the factual questions are genuinely not at issue. Other copyright principals that are the province of judicial determination, such as originality, should be employed where substantial similarity is inappropriate. These steps will help lead to an application of copyright that puts all artists on the same level and furthers copyright's policy of genre-neutral artistic promotion.