De Minimis and Artistic Freedom: Sampling on the Right Track?

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Abstract: For many years, U.S. and European case law has offered a negative and restrictive interpretation on the sampling of sound recordings. Courts have traditionally deemed sampling as an infringement on the copyrighted material (and in Europe the related rights), even if the sample lasted for less than 2 seconds. Several notable precedents have been published in the wake of the first ruling on sampling, published in 1989 in the U.S., all of which have confirmed this interpretation. However, more recently, four decisions have been published, two in the United States and two in Germany, which deviate from this line of jurisprudence. It is these decisions which will form the crux of the analysis within the present article. To outline them briefly, the TufAmerica and the VMG Salsoul rulings highlighted that the de minimis test applies to the sampling of trivial portions and thus liability is excluded in such situations. The German Goldrapper ruling of the Federal Supreme Court (BGH) and the Metall auf Metall III decision of the German Federal Constitutional Court (BVerfG) have also opened the doors for sampling in Continental European legal systems. The Goldrapper ruling focused on the length of the sample, whilst the BVerfG in Metall auf Metall III introduced a novel discourse based on fundamental rights, concluding that sampling functions as a practical example of artistic freedom. Nevertheless, it remains unclear whether the ECJ will accept such an interpretation. However, this may become clearer in the not too distant future with a preliminary ruling being initiated by the BGH in June 2017. This article will analyze these four cases, as well as offering a view on the possible outcome of the preliminary ruling.

Keywords: sampling, copyright law, de minimis, free use, fair use, United States, Germany, Metall auf Metall, Goldrapper, TufAmerica, VMG Salsoul

I. Overture

The act of taking a portion or the entirety of an extraneous sound recording, known as a sample, as well as the musical works contained in them and subsequently incorporating it into a new sound recording can directly affect the economic rights and, in Continental Europe, the moral rights of the original rights holders. Samplers may only be exempted from liability if their conduct fits into the category of free use, including the fair use test, which derives from the copyright law of the United States. In situations where there is an infringement on moral rights, instances of free use offer no ponderable grounds for exemption.

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Both U.S. and German courts have applied this potential opportunity for exemption in a restrictive way.[2] In the most prominent sampling case of all time, the *Sixth Circuit* offered a *bright line rule*, noting that the prerequisite for sampling should be the rights holder's authorization and submitted that one should either "*get a license or do not sample*".[3] Moreover, the *de minimis* rule[4] may not be relied upon in disputes involving sampling.[5]

The German Federal Supreme Court (*Bundesgerichtshof*, hereafter: *BGH*) in its most significant ruling also excluded the *de minimis* rule and the applicability of the free use clause (*freie Benutzung*) set forth in the German Copyright Act.[6] Section 24 states that the author of the secondary or derivative work does not require authorization by the original author if it merely served as an inspiration or motivation (*Anregung*) for the creation of the secondary work. The same provision applies where the sample in question cannot be recognized, either due to transformation in the derivative work or because the sample has been combined with a variety of other motifs, which collectively play a subverted or unsubstantial role in the derivative work.[7] As this provision is found in the section of the *UrhG* concerning copyrighted works and does not make any direct reference to the economic rights (and their restrictions) of the phonogram producer, it was only fair to question its applicability regarding such rights holders. In the famous *Metall auf Metall* case, the *BGH* ruled that the extension of the scope of the provision to the phonogram producers' economic rights was acceptable.[8] However, in its second ruling, the *BGH* emphasized the exclusion of this provision's applicability if and when a recognizable melody from the original work was reproduced within the derivative work.[9] The *BGH* concluded that the sample in this case could be considered as such a melody. Interestingly, if the defendant were able to reproduce the sound recording – the sample – independently, no entitlement would exist to use the works of others.[10]

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[2] Simon Apel: Bridgeport Music, Inc. v. Dimension Films (USA), Metall auf Metall (Germany) and Digital Sound Sampling - 'Bright Line Rules'?, *Zeitschrift für Geistiges Eigentum / Intellectual Property Journal*, Issue No. 3/2010: p. 331-350; Tracy Reilly: Good Fences Make Good Neighboring Rights: The German Federal Supreme Court Rules on the Digital Sampling of Sound Recordings in Metall auf Metall, *Minnesota Journal of Law, Science & Technology*, Issue 1/2012: p. 163-199.

[3] Bridgeport Music, Inc. v. Dimension Films, 410 *F.3d* 792 (2005), p. 801.

[4] In order to establish infringement, the act of use must exceed a trivial level. U.S. copyright law "does not concern itself with trifles". See Ringgold v. Black Entertainment Television Inc., 126 *F.3d* 70 (1997), p. 74. The basis for the expression can be traced back to a maxim of Roman law: "*de minimis non curat lex*". The U.S. Supreme Court held the *de minimis* rule is a "part of the established background of legal principles against which all enactments are adopted, and which all enactments (absent contrary indication) are deemed to accept". See Wisconsin Department of Revenue v. William Wrigley, Jr., Co., 505 *U.S.* 214 (1992), p. 231.

[5] Bridgeport v. Dimension Films (2005), p. 800-802. Pre-*Bridgeport* rulings followed an entirely different view. See especially James W. Newton v. Michael Diamond, 388 *F.3d* 1189 (2004), p. 1191-1192.

[6] Gesetz über Urheberrecht und verwandte Schutzrechte vom 9. September 1965, BGBl I S. 1273. (Hereafter *UrhG*.)

[7] Emil Salagean: *Sampling im deutschen, schweizerischen und US-amerikanischen Urheberrecht*, UFITA-Schriftenreihe, Band 248, Nomos, Baden-Baden, 2008: p. 104-106; Ines Duhanic: Copy this Sound! The Cultural Importance of Sampling for Hip Hop Music in Copyright Law - A Copyright Law Analysis of the Sampling Decision of the German Federal Constitutional Court, *Gewerblicher Rechtsschutz und Urheberrecht Internationaler Teil*, Issue No. 11/2016: p. 1010.

[8] BGH Urt. v. 20.11.2008 (I ZR 112/06) - Rechte des Tonträgerherstellers bei Tonfetzenentnahme - Metall auf Metall (m. Anm. Lindhorst), *Gewerblicher Rechtsschutz und Urheberrecht*, Issue No. 3-4/2009: p. 403.

[9] Compare to UrhG Section 24(2).

[10] BGH Urt. v. 13.12.2012 (I ZR 182/11) - Eingriff in das Tonträgerherstellerrecht durch „Sampling": Metall auf Metall II, *Gewerblicher Rechtsschutz und Urheberrecht*, Issue No. 6/2013: p. 614-618. On the facts of the case and the procedureal background see further Duhanic, supra note 7 at 1010-1011; Marc D. Mimler: 'Metall auf Metall' -

This restrictive approach has posed serious threats to the creative process involved in developing new music on both sides of the Atlantic. It is a fact that sampling has become an inevitable feature of the modern music industry, particularly in hip-hop and electronic music. However, the fact that the use of any sample is subject to prior authorization could potentially hinder musical self-expression and, by extension, the prevalence of one significant element of modern pop culture. As an expert witness noted in front of the German Federal Constitutional Court (*Bundesverfassungsgericht*, hereafter *BVerfG*), "the uncertainty surrounding the issue along with the threat of being sued for infringement created a climate of fear among music producers".[11] However, more recently, there have been signs that jurisprudence may potentially be softening on this issue. This paper will therefore examine these cases, beginning with two recent rulings from the United States and then followed by two decisions from Germany, in order to evaluate whether there are any credible signs of positive change.

II. Changes in United States copyright law: The TufAmerica and VMG Salsoul cases

The common path to be treaded, as set out in *Bridgeport*, was first eroded by the *TufAmerica* ruling.[12] The plaintiff in the case was the rights holder of the sound recording and musical work entitled '*Hook & Sling Part I'*, which was recorded by Eddie Bo and the Soul Finders. The defendant was a company that produced a sound recording called '*Run This Town'*, which was performed by Jay-Z, Rihanna and Kanye West. The plaintiff alleged an unauthorized sampling of the succinct exclamation "oh" of Eddie Bo by the defendant, who subsequently looped[13] it 42 times in its own sound recording. Although the trial court harbored misgivings about allowing any protection of the sampled exclamation as a musical work, it assumed the existence of the protection, in order to consider the legality of the potential act of use.[14] It is at this point that the plaintiff's complaint yielded.

The starting point of copyright litigation in the United Stated is the provisions of the *USCA* enumerating the author's exclusive rights.[15] Infringement occurs in cases where the defendant uses one or more substantial and protected portions of original works without having been authorised to do so. The plaintiff must demonstrate that they possess a copyright over the original; that the work was actually used and that the derivative work is noticeably similar to the original work. Demonstrating the existence of a copyright over the original work is generally a question of fact rather than law and thus the court's examination is usually centered on the second and third elements. One has to prove the act of copying and its unlawfulness.

According to the court in *TufAmerica*, the act of copying could hardly be disputed in that case, as the sound sample in question can be heard in the derivative work. However, the illegality of the act of copying is excluded by the fact that the used portion cannot be considered substantial in either a qualitative or a quantitative sense. Quantitatively speaking, the exclamation "oh" is shorter than a second, whereas the original song is 2 minutes and 35 seconds in length. As it was

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the German Gederal Constitutional Court discusses the permissibility of sampling music tracks, *Queen Mary Journal of Intellectual Property*, Issue No. 1/2017: p. 119-122.

[11] Ibid. at 122.

[12] TufAmerica, Inc., v. WB Music Corp., et. al., 67 *F.Supp.3d* 590 (2014).

[13] Looping means the repetition (and in various instances the production of a musical base) of a sampled portion in the derivative works by way of alteration, if any. See Amanda Webber: Digital Sampling and the Legal Implications of its Use after Bridgeport, *Saint John's Journal of Legal Commentary*, 2007: p. 380-382.

[14] TufAmerica v. WB Music (2014), p. 593-594.

[15] USCA §106.

indicated by the district court, the premise of quantitative significance would be stripped of its meaning in case of a decision to the contrary. More precisely, "were the Court to find 'oh' quantitatively significant to *Hook & Sling Part I* or to Eddie Bo's performance thereof, it in effect would read the quantitative significance element out of the substantial similarity test. This the Court will not do".[16]

The court stressed that the qualitative significance of the used portion must be examined in relation to the work itself, as opposed to the allegations of the plaintiff.[17] In this regard, the court judged the contended musical portions in the exact opposite way to the plaintiff's allegations and indicated that '*Hook & Sling Part I'* would not have lost any of its essence if the exclamation "oh" had been wholly omitted.[18] Furthermore, the *sample* was restricted to the background of the song *Run This Town* and an untrained ear would have found it difficult to detect.[19] Based on the above, the district court concluded that the sampled snippet is merely *de minimis*, therefore, any further examination would render the qualitative significance of the sample meaningless.[20]

In a separate and more recent case, the *Ninth Circuit* was confronted with the ruling in *Bridgeport* and rendered its opinion on the copyright relevance of *de minimis* sampling in the *VMG Salsoul* ruling.

In this case, the plaintiff, the VMG Salsoul, alleged that Shep Pettibone, the producer of the song '*Vogue'*, performed by Louise Ciccone a.k.a. Madonna, sampled without authorization two horn hits, totaling a sample of less than a second, from the song '*Love Break'* also produced by him. The defendant sampled the "single" horn hit once, the "double" horn hit three times and the "breakdown" version once in his own work.[21] In line with *Bridgeport*, the plaintiff contended that this infringed upon the rights of the sound recording producer if it could be proven that the act of sampling had happened without prior authorization.

The *Ninth Circuit* rejected this argument. The court took an obvious detour from what was established in *Bridgeport* and instead relied upon the case of *Newton*, leaving considerable scope for the *de minimis* rule. First, the court held that the two major categories of copyright – composition and sound recording rights – are worth pursuing separately, since both rights holders' economic rights may be infringed upon in case of sampling.

In *Newton*, a flute sample consisting of three notes, which totaled a sample of less than three seconds, was used. This sample encompassed the entirety of the given segment of the original work as it included no other musical instrument. The *Ninth Circuit* reasoned that no infringement had occurred due to the *de minimis* use. Applying this to the *VMG Salsoul* case, it seems highly unlikely that an average audience would be able to discern the part of the horn hit of '*Love Break'* in '*Vogue'*.[22] As such, the court followed the same reasoning as *Newton* and described the sample used from the original sound recording as minimal.[23]

In light of the above, the *Ninth Circuit* was left to answer whether the act of use, trivial as it might be, constituted copyright infringement. The court departed from *Bridgeport* by

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[16] TufAmerica v. WB Music (2014), p. 595-596.
[17] Ibid. at 596. The plaintiff described the already mentioned "oh" portion as being a "loudly-shouted, buoyantly exuberant 'Oh!'". See ibid.
[18] Ibid. at 597.
[19] Ibid. at 598.
[20] Ibid.
[21] For the fact of the case see VMG Salsoul, LLC, v. Madonna Louise Ciccone, et. al., 824 *F.3d* 871 (2016), p. 875-876. See also Howard B. Abrahms: *The Law of Copyrights*, Westlaw, 2016: §14:46.2.
[22] VMG Salsoul v. Madonna (2016), p. 878-879.
[23] Ibid. at 879-880.

implementing a multi-faceted argument. It first highlighted that the *de minimis* rule has its roots in decisions dating back to the mid-19th century, thus it is unassailably embedded in the system of U.S. copyright law.[24] Furthermore, the court was emphatic about rejecting views that barred applicability of the principle in copyright issues. As the *Ninth Circuit* noted "[o]ther than Bridgeport and the district courts following that decision, we are aware of no case that has held that the de minimis doctrine does not apply in a copyright infringement case. Instead, courts consistently have applied the rule in all cases alleging copyright infringement".[25] Moreover, reading together Section 102 (on the protected works) and Section 106 (on economic rights) of the *USCA*, the *Ninth Circuit* concluded that the Act does not distinguish at all between the types of works and the economic right regarding them. As a result, if the *de minimis* rule prevails in the case of a sculpture, it must also be applied in the case of sound recordings.[26]

The court, however, rejected the argument of the *Sixth Circuit* concerning Section §114(b) of the *USCA*. This Section allows for the production of a *cover version*, the U.S. term of art applied to compulsory mechanical licensing. However, *Bridgeport* unjustifiably broadened the scope of this provision[27] and practically concluded that any sound recording taking a portion or the entirety of an original sound recording and imitating by independently recording it, infringes upon the copyright of the original rights holder. However, the *Ninth Circuit* emphasized that Section 114(b) of the *USCA* is the explicit limit of the copyright holder's exclusive rights. As a consequence, extending the rule in an implicit way for the benefit of the copyright holder is rather inappropriate[28] and it is not even supported by the preparatory documents of the *USCA*.[29] In addition, the *Ninth Circuit*, upholding views of academia that criticized this part of *Bridgeport*,[30] found that the *Sixth Circuit* misinterpreted the phrase referred to in Section 114(b) of the *USCA*. In this way, the *Sixth Circuit* granted free reign for sound recording producers to sample their own sound recordings, barring anyone else from this activity even if sampling concerned a trivial portion.[31]

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[24] Ibid. at 880-881.
[25] Ibid. at 881.
[26] Ibid. at 881-882.
[27] "The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording". See the third phrase of §114(b) of the USCA.
[28] "We ordinarily would hesitate to read an *implicit expansion* of rights into Congress' statement of an *express limitation* on rights". See VMG Salsoul v. Madonna (2016), p. 883.
[29] Ibid. at 883-884.
[30] See especially Jeremy Beck: Music Composition, Sound Recordings and Digital Sampling in the 21st Century: A Legislative and Legal Framework to Balance Competing Interests, *UCLA Entertainment Law Review*, 2005: p. 1-31; Matthew R. Brodin: Bridgeport Music, Inc. v. Dimension Films: The Death of the Substantial Similarity Test in Digital Sampling Copyright Infringement Claims - The Sixth Circuit's Flawed Attempt at a Bright-line Rule, *Minnesota Journal of Law, Science & Technology*, 2005: p. 825-868; Ryan C. Grelecki: Can Law and Economics Bring the Funk… or Efficiency?: A Law and Economics Analysis of Digital Sampling, *Florida State University Law Review*, 2005: p. 297-329; Steven D. Kim: Taking De Minimis Out of the Mix: The Sixth Circuit Threatens to Pull the Plug on Digital Sampling in Bridgeport Music, Inc. v. Dimension Films, *Villanova Sports & Entertainment Law Journal*, 2006: p. 103-131; M. Leah Somoano: Bridgeport Music, Inc. v. Dimension Films: Has Unlicensed Digital Sampling of Copyrighted Sound Recordings Come to an End?, *Berkeley Technology Law Journal*, 2006: p. 289-309; Melville B. Nimmer - David Nimmer: *Nimmer on Copyright*, Matthew Bender & Company, Inc., 2013: §13.03[A][2][b] 13-61.
[31] VMG Salsoul v. Madonna (2016), p. 884.

The *Ninth Circuit* argued that the view taken by the other forum is untenable for at least three reasons. First, any work can be copied "physically". If one considers the way a sound sample can be taken from a sound recording, it is equally possible to copy any part of a photo on a material object in which it is embodied. It is, however, groundless and even discriminatory to distinguish the former case as one being outside the scope of the *de minimis* rule, whilst the latter and any other copyrighted material as being included. Second, this distinction is not supported by any legislative intention whatsoever since no provision of such content can be found in the *USCA*. Finally, the *Sixth Circuit* regarded sampling as being nothing other than a method to save time, effort and money by subsequent authors when recording their own sound recordings. Yet, in the view of the *Ninth Circuit* this argument could not have led to the final conclusion arrived at in *Bridgeport*, as the U.S. law – since the Supreme Court's ruling in *Feist*[32] – attributes a central role to creative output instead of any sweat of the brow arguments.[33]

Ultimately, the *Ninth Circuit* by recognizing the applicability of the *de minimis* rule to cases of sampling of sound recordings openly admitted its view was contrary to what was established in *Bridgeport*. The court thus created a circuit split among federal courts of appeals.[34] The current situation may serve as motivation for and present an opportunity to the Supreme Court to intervene in the future by granting grant *certiorari*[35] to an appropriate case and clarify the law. In addition, this conflict between appellate courts could "open the legislator's eyes" into amending the *USCA* to regulate sampling.

III. Changes in German copyright law: the Goldrapper and Metall auf Metall III cases

Although the application of the *de minimis* rule in copyright cases does not seem to be a revolutionary idea in U.S. copyright law; the reformatory nature of what has happened in the last two years in German copyright law concerning sampling cannot be questioned. These changes have evolved in two phases and – albeit based on a mere assumption – may result in the total disintegration of the former unwieldy approach.

In the *Goldrapper* case[36], the *BGH* partly overruled its own decision rendered in the earlier *Metall auf Metall II* case. In this case, the German rapper Bushido sampled portions totaling approximately 10 seconds of the French gothic metal group, Dark Sanctuary. He then used and looped them in 13 of his own sound recordings as background music. The *BGH* did not reach a final judgment since in certain issues it remanded the case to the trial court to conduct new proceedings. The court's remarks, however, appear to change the views concerning the issue. On

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[32] Feist Publications, Inc., v. Rural Telephone Company, 499 *U.S.* 340 (1991).

[33] VMG Salsoul v. Madonna (2016), p. 885.

[34] Ibid. at 886.

[35] Alongside its British counterpart, *certiorari* is a basic constituent of the U.S. redress system. If granted by the federal Supreme Court, it is not a matter of right, but a simple opportunity for litigants. When one of the litigants wishes to move her case before the Supreme Court of the United States, she must file a petition for a writ known as a *writ of certiorari*, against which the opposing party may submit an opposition. The Supreme Court grants certiorari only if it finds a special and significant reason to do so. For this to happen, a minimum of four justices from the Supreme Court must vote in favour of granting *certiorari* to the petition known as the *Rule of Four*. See F. A. Schubert: *Introduction to Law and the Legal System*, Seventh Edition, Houghton Mifflin Company, Boston-New York, 2000: p. 160.

[36] BGH Urt. v. 16.04.2015 (I ZR 225/12) - Goldrapper, *Gewerblicher Rechtsschutz und Urheberrecht*, Issue No. 12/2015: 1189-1198. See further Birgit Clark: Goldrapper: no copyright protection for de-lyricized samples used as looped background for a rap track?, *Journal of Intellectual Property Law and Practice*, Issue No. 11/2015: p. 816-817.

the one hand, it highlighted that the lower court erred in its examination of the sound sample based on its own hunches and its failure to use an expert in music.[37] On the other hand, and more importantly, the *BGH* went against its own holding in *Metall auf Metall II*. There the *BGH* held that sampling musical snippets („*Tonfetzen*") is subject to authorization. In *Goldrapper*, however, the *BGH* held that infringement may occur only if the music sample is the result of a creative activity and that the used portion reaches the minimum threshold relating to the protection of intellectual creations.[38]

Even more remarkable is the constitutional ruling of the *BVerfG* rendered in the *Metall auf Metall* case going back two decades.[39] There, the *BVerfG* viewed sampling from an entirely different angle and raised this activity to the level of fundamental rights.

The legal dispute arose from the unauthorised sampling of a 2-second long musical portion from the 1977 song '*Nur mir',* written by Moses Pelham and performed by Sabrina Setlur, imitating metallic clatter from a 1977 sound recording entitled '*Metall auf Metall'* and created by the group Kraftwerk, the pioneer band of West Germany's synthesizer music. As it was mentioned in the introductory part of this study, following prolonged proceedings the *BGH* took a stand against samplers. In practice, request for authorization was made obligatory even if the act of use merely encompassed a small scale. [40]

The *BVerfG* held that the case giving rise to the aforementioned judgment was about a clash between legal provisions concerning sound recording producers pursuant to the first sentence of Section 85(1) of the *UhrG* and the right for free use under Section 24 of the *UhrG*. Nevertheless, these rights are based on Article 14(1) of the German Constitution on property interests and on the first sentence of Article 5(3) on the fundamental right of artistic expression, respectively.[41] The relation between the two categories of rights is far from simple. Whilst German law acknowledges the economic rights of sound recording producers, they cannot result in the creation of monopolies. This means on the one hand, that rights holders are granted every possible means of utilization.[42] Yet, on the other hand, these rights may be restricted by the legislator at any time.[43] The question of which rights and interests take priority in an actual case is subject to a court's discretion.[44]

As for the *BVerfG*, previous judgments of the *BGH* are contrary to the fundamental right of the freedom of artistic expression. First, sampling was deemed by the *BVerfG* to be included in this fundamental right.[45]

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[37] Ibid. at 816.
[38] Ibid. at 817.
[39] BVerfG Urt. v. 31.05.2016 (1 BvR 1585/13) - Zulässige Verwendung von Samples ohne Zustimmung des Tonträgerherstellers - Metall auf Metall, *Gewerblicher Rechtsschutz und Urheberrecht*, Issue No. 7/2016: p. 690-696. (Hereafter *Metall auf Metall III*.) For a brief summary of the decision see Duhanic, supra note 7 at 1011-1012.
[40] For the detailed facts of the legal dispute and the procedural history see Matthias Leistner: Die 'Metall auf Metall-Entscheidung' des BVerfG - Oder: Warum das Urheberrecht in Karlsruhe in guten Händen ist, *Gewerblicher Rechtsschutz und Urheberrecht*, Issue No. 8/2016: p. 774-775; Alexis Von Kruedener: Die Entscheidung des Bundesverfassungsgerichts zu Metall auf Metall, *Zeitschrift für Geistiges Eigentum / Intellectual Property Journal*, Issue No. 4/2016: p. 463-465.
[41] Metall auf Metall III (2016), p. 691. See also Duhanic, supra note 7 at 1011.
[42] Fabian Böttger - Birgit Clark: German Constitutional Court decides that artistic freedom may prevail over copyright expolitation rights ('*Metall auf Metall*'), *Journal of Intellectual Property Law & Practice*, Issue No. 11/2016: p. 813; Mimler, supra note 10 at 123.
[43] Metall auf Metall III (2016), p. 691-692.
[44] Ibid. at 692.
[45] Ibid. at 693. Compare to Mimler, supra note 10 at 125.

Second, all works made available to the public may become part on the socio-cultural discourse and ultimately serve as a basis for the artistic activities of others.[46] This latter fundamental right may not be hindered or overruled by the sound recording producers' exploitation interests.[47]

Third, the *BVerfG* established that the *BGH*'s view also obstructs the effectiveness of artistic freedom when it held that sampling is unacceptable if channels of authorization are available and the samples could have been created independently.[48] As it was underscored by Duhanic, "the alternative to sampling such as obtaining a licence is not enough to serve as an equivalent alternative of protection of the freedom of artistic activity since the rightholder is at liberty to decide whether or not to grant it to a third party; a right to be granted a licence to use the sample does not exist".[49]

Fourth, the German legislator provided sound recording producers with economic rights to fight infringements of piracy on a commercial scale. According to the *BVerfG*, using *de minimis* samples cannot be considered to be such an activity, as it bears no perceivable effect on the rights holders.[50] This is reinforced by the fact that users cannot be deemed as competitors of the original rights holder in a horizontal sense. This is traditionally justified by differences in genre of the works at issue, the different audiences and the differing dates of creating the works of art.[51] Ultimately, in case of sampling – as it was demonstrated in the case giving rise to the judgment – an activity of economically negligible effect is contrasted with the sampler's freedom of artistic expression. The *BVerfG* ruled that the latter should take priority until it causes obvious economic drawbacks on the interests of the sound recording producers.[52]

IV. Closing chords

The first reactions on the *TufAmerica* and *VMG Salsoul* rulings are supportive. It is the present authors submission that the decisions follow a more balanced approach than *Bridgeport's* bright line rule and that the treatment of sampling has started to become a little clearer. Consequently, whilst excessive uses are still not tolerated (neither by the *de minimis* rule, nor the *fair use* test), the creative, transformative uses of trivial quantity or quality are permitted. *Vice versa*, excessive uses still remain unlawful.

Despite these positives, commentators do still point to the fact that the *Ninth Circuit* has created a *circuit split* that remains unresolved. As Wittow and Hall noted "[t]he Ninth Circuit's ruling in *Ciccone* not only tees up a potential Supreme Court case, but also puts two of the centers of the American music industry at odds with each other: Nashville, where the *Bridgeport* case arose, and Los Angeles (and the West Coast generally) in *Ciccone*. As for the third industry center, the Second Circuit has yet to declare what rule applies in New York but *Ciccone* cites a

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[46] See especially Duhanic, supra note 7 at 1013; Rupprecht Podszun: Postmoderne Kreativität im Konflikt mit dem Urheberrechtsgesetz und die Annäherung an „fair use", *Zeitschrift für Urheber- und Medienrecht*, Issue No. 7/2016: p. 609.

[47] Metall auf Metall III (2016), p. 693-694.

[48] Ibid. at 694-695. See further Böttger - Clark, supra note 42 at 813.

[49] Duhanic, supra note 7 at 1012.

[50] Metall auf Metall III (2016), p. 695. Compare to Mimler, supra note 10 at 125.

[51] Duhanic, supra note 7 at 1014; Podszun, supra note 46 at 2016, 610.

[52] Metall auf Metall III (2016), p. 695. See further Duhanic, supra note 7 at 1014-1015; Podszun, supra note 46 at 610; Mimler, supra note 10 at 124.

New York state case that 'expressly reject[ed]' the *Bridgeport* rule".[53] This *circuit split* seems destined for resolution by the Supreme Court.

In light of the most recent developments, it is plausible that the Supreme Court would rule against *Bridgeport* for several reasons. First, the validity and importance of the *de minimis* standard is unquestionable and it has been used by the U.S. judiciary for decades.[54] Second, the U.S. Supreme Court does not favour the application of bright line rules in intellectual property law. Daniel J. Gervais noted that "[a]t least five times in recent years, the Supreme Court has told the Federal Circuit not to adopt bright line tests. So that's probably a sign the Supreme Court would support the 9th Circuit's interpretation".[55]

Likewise, the *BVerfG* ruling enjoyed a positive reception from German academia.[56] Commentators agreed that the *BVerfG* may aid the survival of sampling[57], a specific manifestation of postmodern culture, which has become indispensable in various musical genres, and through this has promoted creativity and genre diversity, which arguably helps indirectly safeguard the jobs of numerous artists.[58] Observers also claimed that the decision may help steer the legal qualification of other manifestations of postmodern culture or pop-art (collage, appropriation of art, mash-up, fan-fiction, etc.) towards a more positive direction.[59] Others have warned that the decision cannot be evaluated as broadening the scope of free use guaranteed by the *UrhG*. Sampling and other digital acts of use, such as the lawfulness of the recombination of video content should turn on the adjustment of licensing agreements to the challenged offered by the digital environment.[60]

Similarly, many German experts correctly predicted that the BGH should refer the case to the European Court of Justice (ECJ) for a preliminary ruling. The ECJ might decide whether and to what extent Section 24 of the *UrhG* is compatible with the reproduction right, as well as the limitations and exceptions harmonized by EU law[61] and "whether due to the principle of supremacy of application of EU law, there is still leeway to apply German law".[62]

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[53] Mark H. Wittow - Eliza Hall: Sometimes Borrowing Isn't Stealing: De Minimis Sampling of Music Sound Recordings Isn't Copyright Infringement, Say Two Key Courts in the United States and Germany, *K&L Gates Intellectual Property Alert*, 16 June 2016 (http://www.klgates.com/sometimes-borrowing-isnt-stealing-de-minimis-sampling-of-music-sound-recordings-isnt-copyright-infringement-say-two-key-courts-in-the-united-states-and-germany-06-16-2016/). (Italics in original.)

[54] Andrew Inest: A Theory of De Minimis and a Proposal for Its Application in Copyright, *Berkeley Technology Law Journal*, March 2006: p. 945-995.

[55] Quoted by Steven Seidenberg: US Perspectives: US Courts Split on Legality of Music Sampling, *Intellectual Property Watch*, 28 June 2016 (https://www.ip-watch.org/2016/06/28/us-courts-split-on-legality-of-music-sampling/).

[56] Ibid. at 606-612; Leistner, supra note 40 at 772-777; Sven Schonhofen: Sechs Urteile über zwei Sekunden, und kein Ende in Sicht: Die 'Sampling'-Entscheidung des BVerfG, *Gewerblicher Rechtsschutz und Urheberrecht-Praxis*, Issue No. 13/2016: p. 277-280. 277-280; Duhanic, supra note 7 at 1013-1016.

[57] Podszun, supra note 46 at 608.

[58] Duhanic, supra note 7 at 1011.

[59] Podszun, supra note 46 at 609; Böttger - Clark, supra note 42 at 813.

[60] Karl-Heinz Ladeur: Kunstfreiheit und geistiges Eigentum in digitalen Netzwerken, *Zeitschrift für Geistiges Eigentum / Intellectual Property Journal*, Issue No. 4/2016: p. 447-461.

[61] Podszun, supra note 46 at 611-612; Leistner, supra note 40 at 776-777; Duhanic, supra note 7 at 1016.

[62] Böttger - Clark, supra note 42 at 813.

Predicting the ECJ's ruling is far from straightforward. On the one hand, the ECJ is faced with the need to balance fundamental rights in numerous cases.[63] Indeed, the need for such balance is indirectly confirmed by the Charter of Fundamental Rights of the European Union. According to Article 52 on the principle of proportionality "[a]ny limitation on the exercise of the rights and freedoms recognised by this Charter must be provided for by law and respect the essence of those rights and freedoms. Subject to the principle of proportionality, limitations may be made only if they are necessary and genuinely meet objectives of general interest recognised by the Union or the need to protect the rights and freedoms of others."

On the other hand, intellectual property rights deserve protection under Article 17(2) of the Charter of Fundamental Rights of the European Union. This form of protection is clearly codified by the *InfoSoc Directive* that speaks of the high level of protection of copyrights.[64] At the same time, intellectual property rights are not absolute and their exercise should be subject to the effective functioning of other fundamental rights. For example, in the two *SABAM* preliminary rulings the ECJ stressed that striking a balance between the different fundamental rights is a priority of EU law.[65] The ECJ concluded in both cases that SABAM's filtering injunctions would endanger the operation of the freedom to conduct a business, the protection of personal data and the freedom to receive information.[66] The ECJ's conclusion means that copyright law does not work as *primus inter pares*. It is only one of the many important fundamental rights that should be guaranteed by EU law, but that protection should not stem so far as to sacrifice other rights. As freedom of the arts is equally protected by the Charter of Fundamental Rights of the European Union, the above syllogism on the need to balance the competing interests of sound recording producers and secondary creators of samples seems to be fully applicable.

Should the ECJ decide not to dig into a fundamental rights discourse, the *InfoSoc Directive* still offers enough space to treat sampling as an acceptable practice under EU law. Undoubtedly, sampling is a form of reproduction and that right has been harmonized by the EU.[67] Further, no specific limitation or exception has been dedicated to sampling in the *InfoSoc Directive*[68] and any new limitation or exception would be solely acceptable under the "*grandfather clause*" if its significance and economic impact is negligible.[69] Finally, Article 24 of the *UrhG* is admittedly a broad norm that affects several economic rights (both reproduction and distribution type uses) of

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[63] See especially the annual reports of the European Commission on the application of the Charter of Fundamental Rights of the European Union. The reports are available via http://ec.europa.eu/justice/fundamental-rights/charter/application/index_en.htm.

[64] "Any harmonisation of copyright and related rights must take as a basis a high level of protection, since such rights are crucial to intellectual creation. Their protection helps to ensure the maintenance and development of creativity in the interests of authors, performers, producers, consumers, culture, industry and the public at large. Intellectual property has therefore been recognised as an integral part of property." See Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society, recital 9.

[65] Scarlet Extended SA v Société belge des auteurs, compositeurs et éditeurs SCRL (SABAM), Case C-70/10, ECLI:EU:C:2011:771, para. 46; Belgische Vereniging van Auteurs, Componisten en Uitgevers CVBA (SABAM) v Netlog NV, Case C-360/10, ECLI:EU:C:2012:85, para. 44.

[66] Scarlet Extended v. SABAM, para. 47-53; SABAM v. Netlog, para. 45-51. See further Trisha Meyer: *The Politics of Online Copyright Enforcement in the EU - Access and Control*, Palgrave MacMillan, Cham, 2017: p. 102.

[67] InfoSoc Directive Article 2.

[68] Compare to ibid. Article 5.

[69] "Use in certain other cases of minor importance where exceptions or limitations already exist under national law, provided that they only concern analogue uses and do not affect the free circulation of goods and services within the Community, without prejudice to the other exceptions and limitations contained in this Article." See InfoSoc Directive Article 5(3)(o).

rights holders, and allows for a relative freedom to secondary users to exploit their own independent creations without authorization and the need to remunerate rights holders.

Nevertheless, the *InfoSoc Directive* is *only* a directive and thus it leaves space for Member States to implement its provisions with a certain degree of discretion. As Article 5(2) to (4) of the *InfoSoc Directive* allows for the implementation of limitations and exceptions relating to the right of reproduction, communication to the public (including making available to the public) and distribution. It is acceptable that Member States limit or exclude the exercise of two or more of these economic rights by one single rule. As the Federal Supreme Court requested the ECJ to rule on the compatibility of Article 24 of the *UrhG* with the quotation exception of the directive,[70] this syllogism applies without doubt. Nevertheless, the quotation exception requires users to quote from preexisting materials for the purposes of criticism or review, and, if appropriate, users must designate the source of the quoted segment. If the ECJ omits the fundamental rights discourse, it is questionable whether a *simple* sample would pass the prerequisites of Article 5(3)(d) of the directive.

Duhanic's thoughts may serve as an apt conclusion to the aforementioned analysis. She noted that "[t]he historical development of the German Copyright Act has proven that were always new techniques that appeared and the Copyright Act had to keep up with the zeitgeist".[71] In the past thirty or forty years, sampling has become part of the *zeitgeist*. Thus, the four decisions discussed above may function as a means of acknowledgment for this phenomenon. Therefore, the present author recommends the U.S. Supreme Court grant a writ of certiorari, as the need for it emerges. Likewise, *vice versa*, it would be highly problematic for the freedom of the arts, if minimal uses of samples were foreclosed by the ECJ.

[70] Quotation had been harmonized by Article 5(3)(d) of the directive.
[71] Duhanic, supra note 7 at 1016.