BMS Entertainment/Heat Music LLC v. Bridges: How the Court Got It Wrong...Just Like That

Timnetra Burress

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In BMS Entertainment/Heat Music LLC v. Bridges, the United States District Court for the Southern District of New York examined whether lyrics that combine a call-and-response format, the phrase “like that” preceded by a one-syllable word (“straight” in plaintiffs’ work and “just” in defendants’ work), and a rhythmic pattern consisting of three notes—an eighth note, a quarter note, and an eighth note—were sufficiently original to warrant copyright protection. Historically, courts have viewed common phrases as uncopyrightable. In BMS Entertainment/Heat Music LLC v. Bridges (“BMS”), however, the Southern District of New York signaled a possible change in the court’s view of whether or not a phrase within the context of music is copyrightable and can

2. See e.g. Boone v. Jackson, No. 03-CV- 8661, 2005 U.S. Dist. LEXIS 13172, at *13 (S.D.N.Y. July 1, 2005) (noting that “[i]t is black letter law that common phrases such as ‘Holla Back’ are not protectable.”); see also Jean v. Bug Music, Inc., 2002 U.S. Dist. LEXIS 3176, at *14 (S.D.N.Y. Feb. 27, 2002) (noting that “[c]ommon phrases are generally not protected by copyright.”); see generally Acuff-Rose Music, Inc. v. Jostens, Inc., 988 F. Supp. 289, 295 (S.D.N.Y. 1997) (stating that “[a]s a well-worn cliche or motto, the ‘ordinary’ phrase may be freely quoted or otherwise used without fear of infringement.”); see generally Acuff-Rose Music, Inc. v. Jostens, Inc., 155 F.3d 140, 144 (2d Cir. 1998) (referring to the district court’s determination that the lines in plaintiff’s song lacked the requisite originality to warrant protection because of the widespread popular use of the phrase.); see also Stratchborneo v. Arc Music Corp., 357 F. Supp. 1395, 1405 (S.D.N.Y. 1973) (noting that “[i]n fact, common phrases are generally not susceptible to copyright protection.”).
receive copyright protection. In BMS, the district court denied defendants' motion for summary judgment.\(^3\) However, one week prior, in Boone v. Jackson, the same court, using the ordinary observer test in a copyright infringement case, determined that summary judgment for defendant was appropriate because "[t]he presence of the phrase 'holla back,' rapped in an eighth note, [an] eighth note, [and] [a] quarter note rhythmic pattern in the hook of each song[,] [wa]s too common to be protectable."\(^4\) How can these two cases, by the same court, be reconciled? Did the court in BMS reach the wrong decision?

This article examines BMS in light of the Southern District Court of New York's previous decision in Boone v. Jackson decided one week earlier. After providing some background in copyright law, the evolution of the creation of music, and cultural integration into music in Section II, this article describes the BMS case in Section III. The article then examines the district court's approach in resolving the copyright infringement issue in Section IV. Section IV (A) shows that the court's approach to resolving the issue deviated from the standard approach used when evaluating works that contain protectable and unprotectable elements. Section IV (B) then examines the approach used by the district court; and Section IV (C) shows why it was an inappropriate test in this case. The article also discusses that the court fails to reach the specific issue of BMS because the court uses the wrong approach. Because BMS deviates from the previous standards expressed by the Southern District of New York, this article also discusses the impact of the BMS decision. Section V concludes with a recommendation on which approach courts should use when analyzing works that contain protected and unprotected components.

II. BACKGROUND

A. Copyright Law

Copyright law finds its origins in the Constitution. Article I, section 8, clause 8 of the Constitution, commonly known as the Copyright Clause, "grants Congress the power 'to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their Respective Writings and Discoveries.'"\(^5\) The Copyright Clause "provides Congress with the power to grant a limited monopoly through copyrights or patents to authors or inventors for their particular writings and inventions."\(^6\) Title 17 of the United States Code ("Copyright Act") gives further guidance to the copyright law in the United States.\(^7\) In order to qualify for copyright protection, works of authorship must be of: (1) copyrightable subject matter; (2) original; and (3) fixed in a tangible medium of expression.\(^8\) Copyrightable subject matter includes derivative works, which are works that are based upon one or more preexisting works.\(^9\) However, copyright protection does not extend to any part of the

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8. Id. at §102(a); see also Olufunmilayo B. Arewa, From J.C. Bach to Hip Hop: Musical Borrowing, Copyright and Cultural Context, 84 N.C. L. REV. 547, 565-66 (2006). Stating that:
Originality thus serves as the minimum threshold for copyrightability. Although a musical work must demonstrate some originality to receive copyright protection, the required amount of originality is not defined statutorily. It is, however, discussed extensively in case law. Cases and commentary do not consistently define what constitutes an original musical work. One core element that runs across many definitions is that originality requires an independent creation, which essentially appears to rule out or significantly limit borrowing.

Id.
work that uses preexisting copyrighted material unlawfully. The copyright in derivative works extends only to the new material the author contributes.

Section 106 of the Copyright Act specifies a copyright owner's rights. A copyright owner has the exclusive right: (1) to reproduce the copyrighted work; (2) to prepare derivative works based upon the copyrighted work; (3) to distribute copies for the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending; (4) to perform the copyrighted work publicly; (5) to display the copyrighted work publicly; and (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission. However, there are limitations on the exclusive rights that the Copyright Act provides.

One such limitation is the fair use doctrine. Copyrighted works may be used and even reproduced without the copyright owner's permission if the use falls under the fair use doctrine of section 107 of the Copyright Act. In determining whether the use made of a work was fair, courts look at four main factors: (1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for the copyrighted work or the value of the copyrighted work.

Copyright protection for works created after January 1, 1978, lasts for a term of the life of the author plus seventy years after the author's death. In the case of joint works, copyright protection

10. Id. at § 103.
11. Id.
12. Id. at § 106.
13. Id.
14. Id.
16. Id. (noting that “[t]he fair use of a copyrighted work, including such use by reproduction in copies or phonorecords... for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright”).
17. Id.
18. Id. at § 302(a).
lasts for a term of seventy years after the life of the last surviving author’s death.\textsuperscript{19} Although registration is not a condition of copyright protection, registration is required in order to sue for copyright infringement.\textsuperscript{20} In order to register a copyright, an author is required to deposit the work, complete an application, and pay the requisite fee to the Copyright Office.\textsuperscript{21} Once the Register of Copyrights determines that the work is of copyrightable subject matter and all other legal and formal requirements of the Copyright Act are met, the Copyright Office issues a certificate of registration.\textsuperscript{22} The effective date of the copyright registration is the day the application, fee, and deposit are all received by the Copyright Office.\textsuperscript{23} Copyright registration is also a requirement in a copyright infringement suit if the plaintiff seeks statutory damages or attorney’s fees.\textsuperscript{24} In order to receive an award for statutory damages or attorney’s fees, the copyright owner must have registered the work: (1) prior to the act of copyright infringement; or (2) within three months of first publication; or (3) one month after the copyright owner learned of

\begin{itemize}
  \item \textsuperscript{19} \textit{Id.} at § 302(b). The Copyright Act defines a joint work as “a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.” \textit{Id.} at § 101.
  \item \textsuperscript{20} \textit{Id.} at § 408(a), 411(b).
  \item \textsuperscript{21} 17 U.S.C. § 408.
  \item \textsuperscript{22} \textit{Id.} at § 410(a).
  \item \textsuperscript{23} \textit{Id.} at § 410(d).
  \item \textsuperscript{24} \textit{Id.} at § 412. Stating that:

  an action for infringement of the copyrighted work that has been preregistered . . . before the commencement of the infringement and that has an effective date of registration not later than the earlier of 3 months after the first publication of the work or 1 month after the copyright owner has learned of the infringement . . . no award of statutory damages or of attorney’s fees . . . shall be made for- (1) any infringement of copyright in an unpublished work commenced before the effective date of its registration; or (2) any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.

\textit{Id.}

\end{itemize}
the infringement.\textsuperscript{25}

Only the legal or beneficial owner of an exclusive right under a copyright is entitled to institute an action for copyright infringement of that particular right.\textsuperscript{26} In order to establish copyright infringement, the plaintiff must prove: (1) ownership of a valid copyright and (2) unauthorized copying of a copyrighted work.\textsuperscript{27} A registration from the United States Register of Copyrights constitutes \textit{prima facie} evidence of the valid ownership of a copyright.\textsuperscript{28} In order to satisfy the second element of an infringement claim, a plaintiff must “show that his work was ‘actually copied’ and that the portion copied amounts to an improper or unlawful appropriation.”\textsuperscript{29} Copying may be established by indirect evidence because evidence of actual copying is difficult to obtain.\textsuperscript{30} Accordingly, copying will be inferred if a plaintiff can show: (1) defendant had access to the copyrighted work and (2) that there are substantial similarities between defendant’s work and the protectable elements of plaintiff’s work.\textsuperscript{31} “Proof of actual copying may also include weighing expert testimony.”\textsuperscript{32} “Expert testimony may include ‘dissecting’ the two works and discussing the works’ relationship to earlier works, for the purpose of illuminating whether similarities between the two works are more likely due to copying or independent creation.”\textsuperscript{33} Plaintiff must show that substantial similarities exist between the two works and that these substantial similarities indicate copying which amounts to an improper or unlawful appropriation.\textsuperscript{34}

\textsuperscript{25} Id.
\textsuperscript{26} Id. at § 501(b).
\textsuperscript{27} Boone v. Jackson, No. 03-CV-8661, 2005 U.S. Dist. LEXIS 13172, at *7 (S.D.N.Y. July 1, 2005).
\textsuperscript{28} Id. at *7-8; \textit{accord} 17 U.S.C. § 410(c).
\textsuperscript{29} Boone, 2005 U.S. Dist. LEXIS 13172, at *8 (quoting Castle Rock Entm’t, Inc. v. Carol Publ’g Group, Inc., 150 F.3d 132, 137 (2d Cir. 1998)).
\textsuperscript{30} Id.
\textsuperscript{31} Id. at *8-9.
\textsuperscript{32} Id. at *9.
\textsuperscript{33} Id. at *9 (quoting McDonald v. Multimedia Entm’t, Inc., No. 90-CV-6356, 1991 U.S. Dist. LEXIS 10649, at *2 (S.D.N.Y. July 19, 1991)).
\textsuperscript{34} Id.
Courts utilize the ordinary observer test, which asks “whether an ‘ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same’” to establish unlawful appropriation. Additionally, when determining ‘substantial similarity,’ the finder of fact is constrained to look at the work as a whole, without dissection as an ordinary observer would. However, an extraction method must be employed where works are compared that contain both protectable and unprotectable elements. The unprotectable elements must be extracted from consideration in order to determine if the protectable elements, standing by themselves, are substantially similar. A finding of no infringement would be appropriate if points of dissimilarity between the two works exceed the points that are similar. Also, once a plaintiff makes a successful showing of a prima facie case of copyright infringement, evidence of independent creation may be used as an affirmative defense and to rebut the claim of infringement.

37. Id. at *10.
38. Id. This is called the extraction test. It is worth noting courts also refer to this as dissection. See, e.g., Positive Black Talk, Inc. v. Cash Money Records, Inc., 2003 U.S. Dist. 6843, at *6-8 (E.D. La. April 21, 2003).
40. Id. at *10-11; see generally Vargas v. Pfizer, Inc., 2005 U.S. Dist. LEXIS 24874, at *12 (Oct. 26, 2005); see also Santryll v. Burrell, 1996 U.S. Dist. LEXIS 3538, at *6 (S.D.N.Y. March 25, 1996). See BMS, 2005 U.S. Dist. LEXIS 13491, at *5. (In BMS, defendants did not dispute that plaintiffs had a valid registered copyright and that defendants had access to plaintiffs’ composition. However, defendants would have probably made a better defense if they had argued that their composition was independently created. Defendants’ assertion of independent creation would likely have been a successful affirmative defense to rebut the claim of infringement in the BMS case. Nowhere in the case did plaintiffs prove that defendants had access to their composition. Unless defendants had actually heard plaintiffs’ composition, access could have been a material issue of fact. Defense counsel’s acquiescence of that important fact was likely a mistake that led to the denial of defendants’ motion for summary judgment.).

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B. The Evolution of the Creation of Music

The way in which music is created has drastically changed over the past thirty years. Computer technology has become a dominant tool in the music industry and quickly changed the way music is created.41 Digital sampling has become an integral part of modern popular music, especially in rap, hip-hop, electronic dance music, and rock music.42 Digital sampling computer technologies allow users to obtain short digital recordings, commonly known as samples, of any sound and reuse that sound in a new musical composition.43 Samples of vocal and/or instrumental performances can be taken from live musical performances or sound recordings.44 Digital sampling technologies also enable users to manipulate the pitch, tone, melody, and speed of the recorded sample.45

Therefore, users of digital sampling technology may take an artist’s unique vocal performance or a musician’s distinguishable instrumental delivery and re-create it exactly the way it was performed by the previous artist in a new work, or the sampling technology user may alter the sampling recording and use a manipulated version of the previous artist’s performance in the new composition.46 Because there are endless possibilities for producers to create new works based upon manipulating samples, many modern music producers are drawn to digital sampling computer technology.47 However, sampling technology is not merely appealing because of its creative utility; it is also appealing because of its cost effectiveness.48 Digital sampling allows users

43. Johnson, supra note 41, at 273.
44. Id. at 274.
45. Id. at 273-74; see also Ruiz de la Torre, supra note 42, at 401.
46. Johnson, supra note 41, at 274.
47. Id.
48. Id. at 275.
to re-create sounds with minimal cost, instead of hiring musicians and vocalists, and paying for recording studio time to reproduce the sounds.49

Digital sampling appears to be a music creator’s dream. For non-commercial music creators, it is. Because current copyright infringement tests relating to sampling are unclear, however, digital sampling users must be careful.50 The Sixth Circuit has interpreted the Copyright Act to require the users of digital sample of a copyrighted works in a derivative work to obtain a license from the sound recording copyright holder to avoid copyright infringement.51 However, “the current procedure for obtaining licenses involves considerable administrative (time) and financial costs.”52 Usually, licenses must be obtained for the sound recording and the underlying musical composition.53 This leads some digital sample users to make the decision not to seek a license.54

Generally, when an artist uses a sample without receiving a

49. Id.
50. Id. at 402; see Bridgeport Music, Inc. v. Dimension Films, 410 F.3d 792 (6th Cir. 2005) (creating a bright-line rule that precludes the use of the substantial similarity test or de minimis test in copyright infringement cases concerning the digital sampling of sound recordings because of the court’s interpretation of the language in 17 U.S.C. § 114(b)).
51. See Bridgeport, 410 F.3d at 801. While the Sixth Circuit ruled that sampling any portion of a pre-existing sound recording would constitute copyright infringement of the original work, even if the sample is digitally altered and/or brief, the Ninth Circuit has disagreed. Stan Soocher, Hot Topics in Entertainment Law: Recent Court Decisions in 826 PRACTICING LAW INSTITUTE: PATENTS, COPYRIGHTS, TRADEMARKS, AND LITERARY PROPERTY COURSE HANDBOOK SERIES 435, 444-45 (2005). In Newton v. Diamond, 349 F.3d 591 (9th Cir. 2003), the court of appeals ruled that, after separating plaintiff’s sound recording and plaintiff’s musical composition, the sample used by defendants of the plaintiff’s musical composition was de minimis and therefore not copyright infringement. Id. In that case, defendants had obtained a license to use the sound recording, however, plaintiff filed suit over the use of the underlying musical composition. Id.
52. Ruiz de la Torre, supra note 42, at 402.
53. Id.
54. Id. Flat fees for licenses range from $100 to over $10,000. Id. Royalties to recording owners can range from half a cent to three cents per copy of the track sold. Id.
license, fair use or the de minimis test may be used as an affirmative defense. 55 The *de minimis* defense embodies the proposition that trivial use of copyrighted material does not constitute infringement. 56 In determining whether a use is *de minimis*, courts look at whether an ordinary observer would find "substantial similarity" between the copyrighted work and the new work or "whether the 'quantitative or qualitative' appropriation of the elements of the original recording are significant." 57 In the fair use defense, as discussed above, courts look to four factors to determine whether the use of the copyrighted work without permission is justified in order to serve one of the desired social purposes delineated in section 107 of the Copyright Act. 58

**C. Cultural Integration into Music**

Modern music has integrated the world and the culture in which we live. All music contains some words, phrases, and colloquialisms that speak directly to its intended audience. Sometimes that audience is generational; however, many times that audience is cultural. When listening to "Reggaeton" music, which combines Latin music, Caribbean music, and hip hop, many times the lyrics are mainly in Spanish. 59 Yet non-Spanish speakers have become a part of that genre’s market due to generational appreciation, not only for Reggaeton’s cultural roots, but also for the music itself. 60 As we become a more integrated society, racial,

55. *Id.*
56. *Id.*
57. *Id.*
58. See *supra* text accompanying note 14.
60. Although *Wikipedia* is not generally an academic source, the use of *Wikipedia* is appropriate here because the subject matter is urban culture and urban culture is constantly evolving from contributions from the public. Therefore, the information found on *Wikipedia* is appropriate because that information is elicited directly from the people that comprise urban culture. See *Reggaeton*, *Wikipedia: The Free Encyclopedia* (2001) at http://en.wikipedia.org/wiki/Reggaeton (last visited Feb. 12, 2006) (containing information on Reggaeton music).
ethnic, and cultural lines become blurred.\textsuperscript{61}

Cultural integration has changed society's understanding of what it means to be a member of a given racial or ethnic group. We now share common forms of slang. For example, language that was once dubbed Ebonics and was solely attributed to African-Americans has transformed into "urban speech" used by all.\textsuperscript{62} An online dictionary of this urban speech was created to help translate communications between individuals.\textsuperscript{63} That dictionary was cited as an authority in \textit{Boone v. Jackson} to prove that "holla back" was a common urban phrase.\textsuperscript{64} However, some of these "common urban phrases" might be considered original, but how original is difficult to determine. Another question is how much use does a phrase need to have in order for it to be common enough to fall in the public domain? It is unlikely that a bright-line rule could ever be established to answer this question. Yet BMS deals not only with the way in which urban music is created, but also the components of urban music.\textsuperscript{65} How should we look at the phrase "like that," which is proceeded by a one-syllable word? Is it the same? Does it mean the same thing? Is it similar enough?

Reggaeton has allowed the Spanish Caribbean youth, specifically those of Puerto Rico and Dominican Republic, as well as the Latin American and United States Latino communities, to have a musical genre as a voice. More recently, it has become an international movement with the help of many from New York's Latino and Black hip hop community.

\textit{Id.}


\textsuperscript{62} See generally \textsc{Urban Dictionary} at http://www.urbandictionary.com (last visited Feb. 12, 2006) (defining words used in an urban context). An individual may post his or her own meanings to common phrases as well. This allows the online resource to expand to cover a wide selection of words and definitions used in urban speech. \textit{Id.}

\textsuperscript{63} \textit{Id.}

\textsuperscript{64} Boone v. Jackson, No. 03-CV-8661, 2005 U.S. Dist. LEXIS 13172, at *13 (S.D.N.Y. July 1, 2005).

Is it original enough for copyright protection? These are very difficult questions to answer.

III. STATEMENT OF BMS ENTERTAINMENT/HEAT MUSIC LLC v. BRIDGES

In *BMS Entertainment/Heat Music LLC v. Bridges*, plaintiffs, Ramid Brown, Theodore Green, Ronique Thomas, and Aldeen Wilson, are members of a rap group that performs and records under the name “It’s Only Family.”66 Plaintiffs, as well as BMS, are the copyright owners of the musical composition “Straight Like That.”67 The defendants include recording and distribution entities as well as Christopher Bridges, an artist who records and performs under the name Ludacris.68 Plaintiffs filed suit against the defendants and alleged that the defendant’s composition “Stand Up” infringed on their copyright in “Straight Like That.”69 Defendants moved for summary judgment on plaintiffs’ claims.70 Defendants argued that key sections in plaintiffs’ composition were unoriginal and, therefore, not copyrightable.71 Defendants further asserted that after the unprotected elements of Plaintiffs’ composition were removed from consideration, there was no substantial similarity between Plaintiffs’ song “Straight Like That” and the defendants’ song “Stand Up.”72

66. *Id.* at *2.
67. *Id.*
68. *Id.*
69. *Id.*
70. *Id.*
72. *Id.* at *2. The court stated that:

'[i]n a call-and-response phrase, the two parts: the call and the response, must be understood in tandem, together making one phrase or hook.' In ‘Straight Like That,’ lyrics such as, ‘You get it on and poppin,’ constitute the ‘call,’ to which the response is ‘straight like that.’ In the defendants’ song, ‘Stand Up,’ the lyrics, ‘When I move you move’ serve as the ‘call,’ to which the response is ‘just like that.’ [B]oth ‘Straight Like That’ and ‘Stand Up’ utilize a three-note rhythmic pattern comprised of an eighth note, quarter note, and eighth note
The United States District Court for the Southern District of New York denied the defendants' motion for summary judgment.\(^{73}\) The court found that it could not rule, as a matter of law, that a composition combining a call-and-response format, the phrase “like that” preceded by a one-syllable word, and a rhythmic pattern consisting of three notes – an eighth note, a quarter note, and an eighth note – lacked originality and therefore could not be protected by copyright.\(^{74}\) The court further found that it could not conclude, as a matter of law, that the portions of the parties' compositions were not substantially similar.\(^{75}\)

Defendants then moved for reconsideration of the denial of defendants' motion for summary judgment.\(^{76}\) The district court denied the motion.\(^{77}\) The court noted that central to its decision was *Knitwaves v. Lollytogs Ltd.*\(^{78}\) The district court again rejected defendants' assertion that when comparing designs for copyright infringement, the court was required to dissect the designs “into separate components, and compare only those elements which are in themselves copyrightable.”\(^{79}\) The district court reiterated its decision to follow *Knitwaves*, emphasizing that the case supports the proposition that common, uncopyrightable elements, unprotectable in isolation, may constitute a protectible work when those uncopyrightable elements are combined.\(^{80}\) The court then

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accompanying the respective lyrics 'straight like that' and 'just like that."

*Id.* at *7-8.

73. *Id.*

74. *Id.*; see also Olufunmilayo B. Arewa, Article, *From J.C. Bach to Hip Hop: Musical Borrowing, Copyright and Cultural Context*, 84 N.C.L. REV. 547, 645 n.77 (2006).


77. *Id.*

78. *Id.* at *3-4.

79. *Id.* at *4.

80. *Id.* at *5. However, in an earlier case, the same court found that while "'initial focus should be placed on music and lyrics taken together' [that] does not establish that unprotectable elements combined are per se protectible." Jean v. Bug Music, Inc., 2002 U.S. Dist. LEXIS 3176, at *20-21 (S.D.N.Y. Feb. 25, 2002) (quoting Stratchborneo v. Arc Music Corp., 357 F. Supp. 1393, 1405
addressed *Knitwaves*’ “total concept and feel” standard as it related to works with protectable and non-protectable component parts.  

IV. AN ANALYSIS OF BMS

The district court wrongly decided *BMS Entertainment/Heat Music LLC v. Bridges*. In doing so, the court ignored black letter law that phrases are not copyrightable because the court’s ruling implies that common urban phrases such as “like that,” in combination with any other word, becomes protectable. The district court also erred in its analysis on the issue of whether lyrics that combine a call-and-response format, the phrase “like that” preceded by a one-syllable word, and a rhythmic pattern consisting of three notes – an eighth note, a quarter note, and an eighth note – were sufficiently original to warrant copyright protection. Judges and juries do not have any guidelines “when they’re asked to answer substantial similarity questions in music copyright cases . . . [because] such cases force judges and juries to act as music critics and music historians to reach their decisions.”

Because rap artists often take the language of the street and turn it into songs that may be similar to the work of another performer, rap music has become the battleground for these copyright disputes. Unfortunately, the courts do not have a good formula for dealing with these types of cases.

A. The Court Failed To Apply the Extraction Test

As mentioned earlier, in order to establish copyright infringement, a plaintiff must prove two elements: “(1) ownership of a valid copyright and (2) copying of constituent elements of the

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(S.D.N.Y. 1973)).

81. *Id.*
82. *See supra* note 2 and accompanying text.
84. *Id.*
85. *Id.*
work that are original." Under the second element of the *Feist* test, ""copying []' involves two prongs: access and substantial similarity." Courts have developed two main approaches when evaluating whether two works are substantially similar. These approaches are referred to as the "extraction test" and the "ordinary observer test." The extraction test is an integral part of a copyright infringement action when the works that are compared contain protectable and unprotectable elements. The unprotectable elements must be extracted to determine if the protectable elements, standing alone, are substantially similar.


87. *Id.*


89. *Id.* The main difference between the two tests concerns the subject matter that the fact-finder looks to in determining whether or not two works are substantially similar. *Id.* Under the ordinary observer test, the court compares the works as a whole, including the unprotectable elements, and "asks whether the infringing work has captured the 'total concept and feel' of the original from the viewpoint of an 'ordinary observer.'" *Id.* While the "ordinary observer" test usually involves a lay observer's perspective, one court has held that in cases where the intended audience possesses specialized expertise, and "the specialist's perception of similarity may be different from the lay observer's, the 'ordinary observer' test should be modified to reflect the perspective of the targeted audience." *Id.*

90. Boone v. Jackson, No. 03-CV-8661, 2005 U.S. Dist. LEXIS 13172, at *10 (S.D.N.Y. July 1, 2005). The Second Circuit has tried to synthesize both the extraction and ordinary observer tests by beginning the infringement inquiry with the premise that "'total concept and overall feel' are relevant in assessing claims of inexact copying." Cunard & Keller, supra note 88, at § 11:6.2. However, first, "the court must dissect the copyrighted work into parts to determine what is original." *Id.* "Second, the court must look to whether [] defendant copied aesthetic decisions-- such as selection, coordination, and arrangement-- made even with respect to the unprotectable, such as public domain, elements." *Id.* "Finally, if there are similarities, the court must assess whether they are due to the original (that is, the public domain work) or to [] plaintiff's protected expression." *Id.* "Where [] defendant takes such expression he may be liable even if the 'total concept and feel' of his work is dissimilar." *Id.*

Under the extraction approach, substantial similarity is determined by only looking at the copyrightable elements of the works. 92 Thus, before evaluating substantial similarity, the fact-finder extracts any portion of the work that consists of uncopyrightable material. 93 In addition, some circuits have held that a court must also filter out any protectable elements that either (1) defendant can establish were independently created or (2) defendant had permission from plaintiff to use. 94 After extracting the unprotected, permissibly used, and independently created elements, the fact-finder must then determine whether an “ordinary observer” would notice substantial similarities between the two works unless he or she set out to detect them. 95 The determination of “just how ‘substantial’ the substantial similarity must be depends on the extent to which the copyrighted work is original.” 96 If a copyrighted work reflects little creativity, then “‘supersubstantial’ similarity must be shown to prove infringement.” 97

In BMS, plaintiffs conceded that if the portions of their composition “Straight Like That” that lacked originality were removed from consideration, there would be no substantial similarity between plaintiffs’ work and defendants’ composition “Stand Up.” 98 However, the court rejected the extraction test method and defendants’ contention “that, in comparing designs for copyright infringement, we are required to dissect them into their separate components, and compare only those elements which are themselves copyrightable.” 99 Instead, the court chose to base its entire analysis on a proposition established in Knitwaves that the court “should evaluate a work’s ‘total concept and feel.’” 100

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92. See supra note 86 and accompanying text.
94. Id.
95. Id.
96. Id.
97. Id.
99. Id. at *9.
100. Knitwaves, Inc. v. Lollytogs Ltd., 71 F.3d 996, 1003 (2d Cir. 1995). However, the Knitwaves court noted that when it is comparing products that contain both protectable and unprotectable elements, its inspection must be
Yet a week earlier, the same court in *Boone v. Jackson* applied the extraction test to a case very similar to *BMS*. In *Boone v. Jackson*, the plaintiff alleged copyright infringement based on the assertion that the hook in the defendant's composition contained the repetition of the lyric "holla back" which was similar in phrasing and musicality to her copyrighted work. The district court granted summary judgment for defendants on plaintiff's claim of copyright infringement. The court held that substantial similarities did not exist between the hook in plaintiff's song and the hook in defendant's song to support an inference of copying. The district court went further in explaining how it reached its decision by noting that although "holla back" was protected as a complete work, not every element of the song was protected per se. The court found that "the presence of the phrase 'holla back,' rapped in an eighth note, [an] eighth note, [and] [a] quarter note rhythmic pattern in the hook of each song was too common to be protectable."

The district court also noted that the "evidence proffered by [] defendant noting the presence of the phrase 'holla back' in numerous songs demonstrates the banal and, therefore, unprotectable nature of the phrase." The court clearly stated that "[i]t is black letter law that phrases such as 'holla back' are not "more discerning;" it must attempt to extract the unprotectable elements from its "consideration and ask whether the protectable elements, standing alone, are substantially similar." *Id.* at 1002. The *Knitwaves* court focused its "more discerning" analysis on the means in which defendant appropriated plaintiff's work, not merely on the fact that plaintiff and defendant expressed the same idea. *Id.* The court viewed the means of expression as the "artistic" aspect of the work. *Id.* However, the court, in applying the "more discerning" ordinary observer test, rejected the assertion that when comparing designs for copyright infringement, it was required to compare only those elements which were by themselves, protectable. *Id.* at 1003.

102. *Id.* at *4.
103. *Id.* at *19.
104. *Id.* at *12.
105. *Id.*
106. *Id.*
Finally, the district court left itself guidance by noting that "where a comparison of the two works at issue show that the similarities relate only to non-protectable elements, as is the case here, courts have consistently held that summary judgment in favor of [defendant] is appropriate." This shows that the court recognized that when applying the extraction test, if the plaintiff's only claim is that defendants' work is similar to the unprotectable elements of the plaintiffs' work, the defendants should not be found liable of infringement.

*BMS* and *Boone v. Jackson* are so analogous that the court should have decided them in the same manner using the same approach. In both *BMS* and *Boone*, plaintiffs' work contained protectable and unprotectable elements. Also, in both cases, plaintiffs' work and defendants' work lacked substantial similarity when the non-protectable elements of their compositions were extracted. Therefore, following the approach applied in *Boone*, summary judgment should have been granted in favor of the defendants in *BMS*.

**B. The Knitwaves Approach**

Although *Boone v. Jackson* is not binding, the court should seek to adhere to a consistent approach when deciding cases that concern the same issue within the same time period. Yet, the district court took two different approaches to the same issue in deciding these two cases within the same time frame. The district court in *BMS* relied heavily on *Knitwaves v. Lollytogs Ltd.* In *Knitwaves*, the court introduced the proposition that "when comparing works for infringement purposes — whether we employ the traditional 'ordinary observer' test or the *Folio Impressions* 'more discerning' inquiry — we examine the works' 'total concept and feel.'" *Folio Impressions* was a case involving the copying

109. *Id.* at *14.
111. *Knitwaves*, 71 F.3d at 1003; see also Sarah Brashears-Macatee, *Total Concept And Feel Or Dissection?: Approaches To The Misappropriation Test*
of a fabric design whose background was copied from a pattern in the public domain. Applying the extraction test, the court found that copyright protection only applied to the roses superimposed on top of the background and their arrangement. The court, looking only at the roses and not the background of the design, then used the ordinary observer test to find that an ordinary observer would not conclude that the pattern had been misappropriated from a copyrighted work.

In *Knitwaves*, however, the sweaters at issue were original creations in their entirety and defendants did not claim that the plaintiff utilized any unprotectable elements. Therefore, in the same manner that the *Knitwaves* court distinguished that case from *Folio Impressions* in its decision to apply the ordinary observer test as opposed to the extraction test, the court in *BMS* should have distinguished the *Knitwaves* case because *Knitwaves* was a copyright case that contained no unprotectable elements. The fact that the district court underscores "the highly fact-specific nature of the inquiry," and then chose to apply the *Knitwaves* approach to the *BMS* case when the two cases do not deal with a similar set of facts is an error by the court. The *Knitwaves* approach should be considered inapplicable to copyright infringement cases where the copyrighted work contains protectable and unprotectable elements.

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The appeal of the 'totality' infringements approach is evident. The task of the fact-finder is simplified because it can examine the work in its entirety, and decide, without much analysis, whether the subsequent author took 'the heart' of the original work. There is no need for a careful, refined separation of fact and expression. Moreover, a 'totality' approach allows a fact-finder to respond to a visceral feeling that something unfair was done.

112. *Knitwaves*, 71 F.3d at 1003.
113. *Id.*
114. *Id.*
115. *Id.* at 1004.
117. In *Yankee Candle Company Inc.*, the First Circuit noted that the Second Circuit suggested, in *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1003 (2d
In *BMS*, the district court’s hypothetical situation posed to the defendants’ counsel as affirmation of the court’s reading of *Knitwaves* does not provide further support in reaching the conclusion that the *Knitwaves* approach should be applicable to *BMS*. The court asserts that unoriginal lyrics combined with an unoriginal melody and an unoriginal reggae beat would meet the originality requirement provided that the combination of unoriginal elements was original to the author, and defendants’ counsel agreed. The district court then attempted to attribute that assertion as consistent with the court’s reading of

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Cir. 1996), “that the dissection test may not fully resolve the legal issues where the copyright holder claims that the copyrighted material is essentially a host of uncopyrightable individual elements that have been arranged in a unique way that qualifies them for copyright protection.” Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC., 259 F.3d 25, 34 (1st Cir. 2001). However, the First Circuit “has been more enthusiastic than the Second Circuit about the use of dissection analysis.” *Id.* The First Circuit has found that “[b]y dissecting the accused work and identifying those features which are protected... the court can also determine... those aspects of the work that... should be considered in the... comparative analysis under the ordinary observer test.” *Id.* In *Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, the Second Circuit attempted to further explain the “total concept and feel” approach. *Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 134 (2d Cir. 2003). The Second Circuit explained “while the infringement analysis must begin by dissecting the copyrighted work into its component parts in order to clarify precisely what is not original, infringement analysis is not simply a matter of ascertaining similarity between components viewed in isolation.” *Id.* This is because:

[] defendant may infringe on [] plaintiff’s work not only through literal copying of a portion of it, but also by parroting properties that are apparent only when numerous aesthetic decisions embodied in [] plaintiff’s work of art – the excerpting, modifying, and arranging of public domain compositions... are considered in relation to one another... The court, confronted with an allegedly infringing work, must analyze the two works closely to figure out in what respects, if any, they are similar, and then determine whether these similarities are due to protected aesthetic expressions original to the allegedly infringing work, or whether the similarity is to something in the original that is free for the taking.

*Id.*

118. *Id.* at *10.
However, one need not turn to *Knitwaves* to determine whether the combination of unprotectable elements would produce a protectable work. *Feist Publications, Inc. v. Rural Telephone Services Co.* has long stood for the proposition that the arrangement of unprotectable elements may receive copyright protection if the arrangement is sufficiently original. The arrangement in the hypothetical in *BMS* would be sufficiently original based on the specific facts of the hypothetical—*Mary Had a Little Lamb* lyrics, *Old McDonald* melody, and reggae beat—because the combination was novel and had never been done before, not just because three unprotected elements were combined. Therefore, while a work’s total concept and feel should be evaluated in general, courts have consistently held that when evaluating works that contain protectable and unprotectable elements—and where, as is the case here, a comparison of the two works at issue shows that the similarities relate only to non-protectable elements—summary judgment in favor of defendant is appropriate.

### C. The “Total Concept and Feel” Approach is Unworkable in Music Copyright Cases

When the “total concept and feel” approach was first introduced as a means to evaluating infringement, the approach was limited to graphic works. The trier of fact was able to compare the two works to determine if there was a substantial similarity. However, in music copyright cases, this approach is less effective. The court stated that:

> [t]o constitute an infringement under the Act there must be substantial similarity between the infringing work and the work copyrighted; and that similarity must have been caused by the defendant's having copied the copyright holder's creation. The protection is thus against copying -- not against any possible infringement caused when an independently created work coincidentally duplicates copyrighted material. . . . It appears to us that in total concept and feel the cards of United are the same as the copyrighted cards of Roth. With

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119. *Id.*
122. See MELVILLE B. NIMMER & DAVID NIMMER, 4 NIMMER ON COPYRIGHT § 13.03(A)(1)(c) (2005); see also Roth Greeting Cards v. United Card Co., 429 F.2d 1106, 1110 (9th Cir. 1970). The court stated that:
visual works side-by-side and determine if the alleged infringing work possessed enough of the elements of the original copyrighted work to constitute infringement. It is important to point out that the "total concept and feel" approach as applied in graphic works cases, merely required the trier of fact to evaluate the works as an "ordinary observer" with the presumption that on its face the infringement would be apparent. The "total concept and feel" approach was then extended and applied in the comparison of juvenile books. Again, the court noted the simplicity of the works being compared. Therefore, the court determined that it could properly consider the "total concept and feel" of the works in addition to its application of pattern analysis.

the possible exception of one United card... the characters depicted in the art work, the mood they portrayed, the combination of art work conveying a particular mood with a particular message, and the arrangement of the words on the greeting card are substantially the same as in Roth's cards.

Id.

123. Id. (noting that "[i]t is true, as the trial court found, that each of United's cards employed art work somewhat different from that used in the corresponding Roth cards. 'The test of infringement is whether the work is recognizable by an ordinary observer as having been taken from the copyrighted source.'"); Roth Greeting Cards, 429 F.2d at 1110; see also White-Smith Music Pub. Co. v. Apollo Company, 209 U.S. 1, 17 (1907) (noting that "[a] copy is that which comes so near to the original as to give to every person seeing it the idea created by the original."); see also Bradbury v. Columbia Broadcasting System, Inc., 287 F.2d 478, 485 (9th Cir. 1961) (noting that "[s]light differences and variations will not serve as a defense.").

124. Id. "The remarkable similarity between the Roth and United cards in issue... is apparent to even a casual observer."

125. See Reyher v. Children's Television Workshop, 533 F.2d 87, 91 (2d Cir. 1976) (stating that "[t]herefore, in addition to the essential sequence of events, we might properly consider the 'total concept and feel' of the works in question." (citing Roth Greeting Cards v. United Card Co., 429 F.2d 1106, 1110 (9th Cir. 1970)).

126. Id. (noting that "[w]e must first note that both stories, intended for children, are necessarily less complex than some other works submitted to pattern analysis.").

127. Id. The court stated that:

[t]he difficult task in an infringement action is to distill the nonprotected idea from protected expression. In Nichols v. Universal Pictures Corporation, 45 F.2d 119, 121 (2 Cir.
However, when comparing two works that are not similar on their face, the "total concept and feel" approach is unworkable and the dissection/extraction method should be used. Applying the extraction method in copyright cases where infringement is not readily apparent is the only logical method to determine whether or not infringement exists. Courts should not look to concepts when determining infringement because concepts are not protectable under the Copyright Act. Further, evaluating a works "feel" does not provide a framework for any analysis. Triers of fact are left to gauge "feel" in their own personal way; however, determinations of copyright infringement should be made within a set framework of analysis in order to adhere to the requirements of the Act.

128. See Copyright Act, 17 U.S.C. § 102(b) (2005) (stating that "[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.") (emphasis added).

129. See Reyher, 533 F.2d at 90-91. The court stated that: [i]t is an axiom of copyright law that the protection granted to a copyrightable work extends only to the particular expression of an idea and never to the idea itself. . . . This principle attempts to reconcile two competing societal interests: rewarding an individual's ingenuity and effort while at the same time permitting the nation to benefit from further improvements or progress resulting from others' use of the same subject matter. 'In the case of verbal 'works' it is well settled that although the 'proprietor's' monopoly extends beyond an exact reproduction of the words, there can be no
As noted earlier, the court in BMS rejected the proposition that the court must first extract the unprotectable elements and then compare only the protectable elements of a work.\textsuperscript{130} Instead, the district court chose to rely on the Knitwaves approach and evaluate the "total concept and feel" of the work as a whole.\textsuperscript{131} Again, Knitwaves involved graphic works.\textsuperscript{132} However, other courts evaluating copyright infringement relating to graphic works have realized that the Knitwaves approach is inadequate even as it applies to graphic works and have sought to rehabilitate the approach.\textsuperscript{133} The Second Circuit recognized that in order to apply copyright in the 'ideas' disclosed but only in their 'expression.' Obviously, no principle can be stated as to when an imitator has gone beyond copying the 'idea,' and has borrowed its 'expression.' Decisions must therefore inevitably be ad hoc.\textsuperscript{133}

\textit{Id.} (citing Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2 Cir. 1960) (L. Hand)).

\textsuperscript{130} BMS, 2005 U.S. Dist. LEXIS 13491, at *9.

\textsuperscript{131} Knitwaves, 71 F.3d at 1003.

\textsuperscript{132} \textit{Id.}

\textsuperscript{133} \textit{See Tufenkian Import/Export Ventures}, 338 F.3d at 134-35. The court stated that:

[s]ome commentators have worried that the "total concept and feel" standard may 'invite[] an abdication of analysis,' because 'feel' can seem a 'wholly amorphous referent.' . . . Likewise, one may wonder whether a copyright doctrine whose aspiration is to protect a work's 'concept' could end up erroneously protecting 'ideas.' But our caselaw is not so incautious. Where we have described possible infringement in terms of whether two designs have or do not have a substantially similar 'total concept and feel,' we generally have taken care to identify precisely the particular aesthetic decisions -- original to the plaintiff and copied by the defendant -- that might be thought to make the designs similar in the aggregate. . . . Essentially, the total-concept-and-feel locution functions as a reminder that, while the infringement analysis must begin by dissecting the copyrighted work into its component parts in order to clarify precisely what is not original, infringement analysis is not simply a matter of ascertaining similarity between components viewed in isolation. For the defendant may infringe on the plaintiff's work not only through literal copying of a portion of it, but also by parroting properties that are apparent only when
the "total concept and feel" approach, the court was still required to extract the non-protectable elements as the first step in its analysis.\(^{134}\)

In addition, "total concept and feel" is unworkable in music cases because more often than not, the two works to be compared are not literally similar; therefore, substantial similarity cannot be determined by merely listening to them.\(^{135}\) Further, "the fact that the sampled material is played throughout defendants' song cannot establish liability, if that snippet constitutes an insubstantial portion of plaintiff's composition."\(^{136}\) Therefore, in music cases, the court must often implement a more in-depth analysis when numerous aesthetic decisions embodied in the plaintiff's work of art -- the excerpting, modifying, and arranging of public domain compositions, if any, together with the development and representation of wholly new motifs and the use of texture and color, etc. -- are considered in relation to one another. The court, confronted with an allegedly infringing work, must analyze the two works closely to figure out in what respects, if any, they are similar, and then determine whether these similarities are due to protected aesthetic expressions original to the allegedly infringed work, or whether the similarity is to something in the original that is free for the taking.

\(\text{Id. (emphasis added).}\)

\(^{134}\) \(\text{Id.}\)

\(^{135}\) \(\text{See 4 NIMMER ON COPYRIGHT § 13.03(A)(2). Nimmer states that::}\\
[w]here there is literal similarity (virtually, though not necessarily, completely word for word) between plaintiff's and defendant's works . . . it is not necessary to determine the level of abstraction at which similarity ceases to consist of an 'expression of ideas,' because literal similarity by definition is always a similarity as to the expression of ideas. But suppose the similarity, although literal, is not comprehensive -- that is, the fundamental substance, or skeleton or overall scheme, of the plaintiff's work has not been copied; no more than a line, or a paragraph, or a page or chapter of the copyrighted work has been appropriated. At what point does such fragmented similarity become substantial so as to constitute the borrowing an infringement? . . . In any given case, this question cannot be answered without a consideration of the purpose for which the defendant's work will be used.\\
\(\text{Id.}\)

\(^{136}\) \(\text{Id.}\)
determining substantial similarity by comparing musical works.\textsuperscript{137} Without applying the extraction method, courts cannot competently make a determination of infringement in music cases. The court's lack of competency is directly related to the various levels of analysis that the court must utilize in order to evaluate infringement within the music context.\textsuperscript{138}

\begin{enumerate}
\item \textsuperscript{137} \textit{Id.} Nimmer states that:
\begin{quote}
[t]he quantitative relation of the similar material to the total material contained in plaintiff's work is certainly of importance. However, even if the similar material is quantitatively small, if it is qualitatively important, the trier of fact may properly find substantial similarity. . . . In general . . . the defendant may not claim immunity on the grounds that the infringement 'is such a little one.' If, however, the similarity is only as to nonessential matters, then a finding of no substantial similarity should result. That scenario could unfold to the extent that defendant copied a small amount of plaintiff's text or of entries from plaintiff's compilation, or sampled a two-second portion of plaintiff's sound recording, or to the extent that the subject reproduction is fleeting and out-of-focus. It follows, then, that the determination of substantial similarity with respect to fragmented literal similarity . . . requires a value judgment. The guiding principle was . . . '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.' But this oft-repeated principle does not tell the trier of fact when in any given instance the value of the original is sensibly diminished or injuriously appropriated. The trier must ultimately determine the importance of that material that is common to both parties' works.
\end{quote}

\item \textsuperscript{138} \textit{Id.} Nimmer states that:
\begin{quote}
the qualitative importance for a given quantity of similar material may well vary according to the type of work in question. . . . in a musical composition, ordinarily, similarity must be found in more than a brief and commonplace musical sequence, or merely in motif. However, similarity in the accompaniment, but not in the melody, has been held sufficient to constitute an infringement. . . . Although . . . similarity limited to a single note never suffices [to constitute infringement], the superstition among many musicians that the
\end{quote}

\end{enumerate}
The "total concept and feel" approach is also problematic in music cases because it requires the trier of fact to evaluate the work as an "ordinary observer," which can only be accomplished in the context of graphic works because music cannot be "observed." However, the "ordinary observer" test has become synonymous with the "audience test" in music cases and is an attempt to apply the "reasonable person doctrine" employed in other areas of the law such as torts, corporate and criminal law to copyright law. When applying the "reasonable person doctrine," "the trier [of fact] is asked to compare the defendant’s actions with what the trier’s own (presumably reasonably prudent) actions would be under the same circumstances." However, in music cases, the trier of fact is not competent enough to place his or herself into the defendant’s shoes. The trier of fact lacks competency to evaluate music infringement using the "audience test" because the trier "cannot meaningfully answer whether, if he were in the defendant’s shoes, he would have been constrained to copy from the plaintiff in order to achieve the given result." Therefore, the trier is directed to answer the only question he can answer—does the result of the defendant’s work give appearances of having been copied from the plaintiff? Conversely, merely copying of three bars from a musical work can never constitute an infringement is . . . without foundation. . . . [T]he evaluation must occur in the context of each case, both qualitatively and quantitatively. The practice of digitally sampling prior music to use in a new composition should not be subject to any special analysis: to the extent that the resulting product is substantially similar to the sampled original, liability should result.

139. See supra note 124 and accompanying text.
140. See 4 NIMMER ON COPYRIGHT § 13.03(E)(2).
141. Id. “Thus, in a negligence case, the trier puts himself into the defendant’s shoes, not the shoes of an "ordinary observer" of the accident.”
142. Id.
143. Id.
144. Id.
145. Id. “[T]his leads us back to the dead end of audience impression of
because the trier of fact does not readily perceive infringement does not mean that the infringement does not actually exist. Therefore, because the “total concept and feel” approach requires the trier of fact to base his or her analysis on the appearance of infringement rather than engaging in an analysis to determine the actual existence of infringement, the approach is unworkable in the music context.

The court has previously addressed the issue of determining the appropriate test for evaluating musical compositions where two competing approaches exist. In Bridgeport Music, Inc., v. Dimension Films, the court was called to determine whether the qualitative/quantitative de minimis test or the “fragmented literal similarity” approach should be used when determining copyright infringement in copyright cases involving sound recordings. The district court applied the de minimis test and concluded that the portion copied in defendant’s work was insignificant and, therefore, it did not constitute infringement. Plaintiff argued on

theft, not to the theft itself. Can there be literary theft without an immediate and spontaneous detection by the ordinary observer? If this question can be answered in the affirmative, then, obviously, the audience test is inadequate.”

146. 4 NIMMER ON COPYRIGHT § 13.03(E)(2) (noting that “the immediate and spontaneous observations of a person untrained in the special requirements and techniques of the play, the novel, the short story, the motion picture, and most especially, the computer, may fail to note similarities that, if analyzed and dissected, would be only too apparent.”); see also id. n.224:

Although dissection and expert testimony is not favored, the judicially created ordinary observer test should not deprive authors of this significant statutory grant merely because the technical requirements of a different medium dictate certain differences in expression. Without deciding the question, we note that in some cases it may be important to educate the trier of fact as to such considerations in order to preserve the author’s rights under the Copyright Act.


147. See Bridgeport Music Inc., 410 F.3d 792, 792 (6th Cir. 2005).

148. Id. at 797-98. The court stated that:

the district court found the de minimis analysis was a derivation of the substantial similarity element when a defendant claims that the literal copying of a small and
appeal that no substantial similarity or *de minimis* test should be used in evaluating copying infringement when defendant admits to copying or digitally sampling the sound recording. The Sixth Circuit agreed.

The court found that the substantial similarity test used to determine copyright infringement relating to musical compositions was inappropriate when relating to sound recordings because the scope of inquiry was narrower. It is important to highlight that when determining the appropriate test, the court noted its "limited technological knowledge in this specialized field, [therefore, its] opinion [was] limited to an instance of digital sampling of a sound recording protected by a valid copyright." The court also noted that "[a]dvances in technology coupled with the advent of the popularity of hip hop or rap music have made instances of digital sampling extremely common and have spawned a plethora of copyright disputes and litigation." Therefore, the court concluded that "[t]he music industry, as well as the courts, [were] best served if something approximating a bright-line test can be established." "Not necessarily a 'one size fits all' test, but one that, at least, adds clarity to what constitutes actionable infringement with regard to the digital sampling of copyrighted

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insignificant portion of the copyrighted work should be allowed. After listening to the copied segment, the sample, and both songs, the district court found that no reasonable juror, even one familiar with the works of [composer/artist], would recognize the source of the sample without having been told of its source. This finding, coupled with findings concerning the quantitatively small amount of copying involved and the lack of qualitative similarity between the works, led the district court to conclude that [plaintiff] could not prevail on its claims for copyright infringement of the sound recording.

*Id.*  
149. *Id.* at 798.  
150. *Id.*  
151. *Id.*  
152. *Id.*  
154. *Id.* at 799.
sound recordings."

The same argument used in Bridgeport Music Inc. is appropriate when comparing the extraction and "total concept and feel" approaches with regard to copyright cases relating to music. In music copyright cases, the scope of inquiry should be more narrow than in infringement cases involving graphic works. Because the court has limited knowledge in the specialized field of music, it is important for the court to utilize all of the tools available to it in order for the court to reach a sound decision. By applying the extraction method, courts will be better able to analyze the similarity of works that do not sound similar to an ordinary listener; however, when the extraction/dissection test is applied, similarities become apparent. Therefore, the extraction method is a superior approach to evaluating music copyright cases than the "total concept and feel" approach because the "total concept and feel" approach provides no set framework for analysis and, therefore, its application could result in an increase in litigation costs and a slower resolution of disputes due to the uncertainty the approach creates when applied to music copyright cases.

Applying the "total concept and feel" approach to music cases also poses the potential risk that the court may conclude infringement contrary to public policy. The purpose of the Copyright Act is clear: "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." Therefore, granting copyright protection (property rights status) to common phrases, mere ideas, or concepts would

155. Id.
156. See supra note 146 and accompanying text.
157. Contra Bridgeport Music Inc., 410 F.3d at 804. The court noted that: [i]t is believed, however, that the courts should take what appears to be a rare opportunity to follow a 'bright line' rule specifically mandated by Congress. This would result in a substantial reduction of litigation costs and uncertainty attending disputes over sampling infringement of sound recordings and would promote a faster resolution of these disputes.

Id.
158. See U.S. CONST. art. I, § 8, cl. 8.
also "permit withdrawing [them] from the stock of materials that would otherwise be open to other authors, thereby narrowing the field of thought open for development and exploitation."”159 “This effect, it is reasoned, would hinder, rather than promote, the professed purpose of the copyright laws.”160 This is particularly true as it pertains to common phrases that have developed and acquired meaning through cultural integration.161 In these cases, it is the public itself that attributed meaning to the phrases; therefore, no one should be granted property rights over its use.162

D. The District Court Failed To Address the Facts of the Case

In BMS, the issue before the court was whether lyrics that

159. See 4 NIMMER ON COPYRIGHT § 13.03(B)(2)(a).

160. Id. Nimmer states that:

[...]he Ninth Circuit warns that ‘we must be careful in copyright cases not to cheat the public domain. Only by vigorously policing the line between idea and expression can we ensure both that artists receive due reward for their original creations and that proper latitude is granted other artists to make use of ideas that properly belong to us all.’ Indeed, it has been said that copyright protection is granted for the very reason that it may persuade authors to make their ideas freely accessible to the public so that they may be used for the intellectual advancement of mankind.

Id.

161. See supra text accompanying note 62.

162. It can also further be argued that common phrases that have developed and acquired meaning through cultural integration have undergone a "merger" of idea and expression and, therefore, a common phrase is inseparably tied to a particular expression.

In such instances, rigorously protecting the expression would confer a monopoly over the idea itself, in contravention of the statutory command. To prevent that consequence, courts have invoked the merger doctrine. In other words, given the dilemma either of protecting original expression, even when that protection can be leveraged to grant an effective monopoly over the idea thus expressed, or of making the idea free to all with the concomitant result that the plaintiff loses effective copyright protection, even over the precise original expression used, copyright law chooses the latter course.

4 NIMMER ON COPYRIGHT § 13.03(A)(3).
combine a call-and-response format, the phrase "like that" preceded by a one-syllable word, and a rhythmic pattern consisting of three notes – an eighth note, a quarter note, and an eighth note – was sufficiently original to warrant copyright protection. The court, however, never addressed that issue. Instead, the court focused a large part of its analysis on defendants' attempt to distinguish BMS from the Knitwaves case by asserting that the unprotectable elements in plaintiffs' composition ("straight like that" in a call-and-response format accompanied by a rhythm substantially similar to that of plaintiffs') were similar to an earlier composition by another artist and, therefore, plaintiffs' arrangement was unoriginal and unprotectable. However, it does not seem that defendants' defense was based solely upon that one argument. The court seems to give defendants' attempt to show that the phrase "straight like that" is not only commonly used, but has been used in combination with a rhythmic pattern substantially similar to plaintiffs' use, too much attention.

The district court seemed to suggest that if defendants had shown plaintiffs' access to the prior artist's composition, defendants would have been successful in proving that the combination of unprotectable elements was not sufficiently original and, therefore, not copyrightable. The next step in the analysis would be that if plaintiffs' composition is not copyrightable, there would be no infringement. However, that issue was not before the court. By applying the Knitwaves approach improperly, and looking at the "total concept and feel" of the work, the court failed to reach the issue in this case. Had the court applied the extraction test, by plaintiffs' own admission, no substantial similarity would have been found between plaintiffs' composition and defendants' composition.

The court's failure to reach the specific issue of the case further illustrates how the Knitwaves approach is unworkable in copyright cases where the copyrighted work contains protectable and

164. Id. at *11-12.
165. Id. at *11-13.
166. Id. at *13.
167. Id. at *5.
unprotectable elements. However, the decision in BMS does not even appear to follow the *Knitwaves* approach. Both parties submitted expert testimony that attempted to compare the musicality of the two compositions. 168 Both experts agree that the only similarities between the two compositions are a three-note rhythmic pattern combined with a one-syllable word proceeding the phrase “like that” in a call-and-response format. 169

Even if the court found that the combination of three unprotectable elements constitutes enough originality for a valid copyright, under *Feist*, copyright protection only extends to a particular arrangement and others are free to use the same unprotectable elements with a new arrangement regardless of whether it is similar. 170 Copyright protection does not prevent subsequent users from copying those constituent elements that are not original, such as materials in the public domain, from a prior author’s work as long as such use does not unfairly appropriate the prior author’s original contributions. 171

In *BMS*, both parties utilized a three-note rhythmic pattern; however, only a finite number of combinations of notes are available. It would arguably be against public policy to grant the plaintiffs a monopoly on the utilization of an eighth note, a quarter note, and another eighth note combination in a hook of a song, or the call-and-response format, or the phrase “like that” by themselves. Yet the court concluded that it could not rule as a matter of law that their combination was not sufficiently original to be copyrightable. 172 However, that is not the question the court was called upon to reach.

**D. Impact**

The district court’s decision in *BMS* goes against its own decision reached one week prior in *Boone*. 173 This court attempted

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168. *Id.* at *8.
171. *Id.*
to adopt an unworkable approach in the highly fact-specific area of copyright infringement based upon a case that should be distinguished from BMS. As a result, by not addressing the issue, this decision is likely to create more confusion in the Second Circuit concerning the extension of copyright protection to the underlying unprotectable elements of a copyrighted work that contains both protectable and unprotectable elements.

As noted earlier, while the Second Circuit has sought to synthesize the extraction and "ordinary observer" tests, when evaluating substantial similarity in copyright infringement cases, this approach has proven very problematic. This is especially true when the work a court is evaluating contains protectable and non-protectable elements. While the "total concept and feel" approach may be a good gauge to compare works after all unprotectable, permissibly used, and independently created elements are extracted, the "total concept and feel" approach leaves too much discretion to the trier of fact. This discretion will lead to more inconsistent results among the courts and within the Second Circuit.

V. CONCLUSION

The decision in BMS and the denial of defendants' motion for reconsideration signal a shift in the way the courts in the Second Circuit will view copyright infringement cases concerning works that contain protectable and unprotectable elements. By adopting the Knitwaves approach, the court created confusion in how the cases should be analyzed. The "total concept and feel" approach also offers little guidance to the courts and gives a vast amount of discretion when analyzing cases. This will likely lead to more inconsistent rulings concerning these copyright infringement cases. BMS will likely be viewed as a step backwards in the area of copyright law. Although the courts should look at the "total concept and feel" as an overarching umbrella, application of the extraction approach is essential to maintaining uniformity among the courts.