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## Bits and Bytes from the Section

By Michael Gallo, 2012-2013 IT Law Section Secretary

### Welcome to Spring!

On Thursday, January 31, 2013, a meeting of the Council and Section was held at Sweet Lorraine's in Berkley. During the meeting, a motion was approved to establish a standing 'Privacy Law' committee. Privacy Law is a developing area that crosses the boundaries of various Section interests. Several other Section leaders have acknowledged this is an area of law that needs appropriate attention and support, but currently, no other Section within the State Bar of Michigan is known to have a committee that focuses on Privacy Law. Several possible goals for the Privacy Law committee were suggested, and will be further discussed by the committee. For those interested in participating in the Privacy Law committee, you are welcome to contact Bob Rothman or Keith Cheresko, who agreed to serve as Co-Chairs for the committee.

After the Council meeting, Brian Wassom, a partner and the chair of the Social, Mobile and Emerging Media Practice Group at Honigman Miller Schwartz and Cohn LLP, gave an interesting and entertaining presentation on the legal issues relating to augmented reality.

Augmented reality is a live view of a physical, real-world environment whose elements are augmented by computer-generated sensory input such as sound, video, graphics or GPS data. Brian walked the audience through the hardware that enables the technology, and discussed a number of the applications and areas that benefit from the use of augmented reality technology. For those interested in learning more, Mr. Wassom has written

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Michael Gallo  
2700 Renshaw Drive  
Troy, Michigan 48085  
e-mail: [michael@gallo.us.com](mailto:michael@gallo.us.com)



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Bits and Bytes . . .

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an e-book entitled 'Augmented Legality 1.0', which is available at <http://wassom.com/ebook.htm>. In addition, there are a number of links related to augmented reality available on Brian's web site at <http://www.wassom.com>. The web site is a forum for discussion and commentary on the law of social media and other new and emerging forms of expression, and is worth a visit!

Future meetings are tentatively scheduled for Thursday, April 18, and Thursday, June 20, 2013. More information regarding the meeting will be published through the Section email listserv, as well as the Section's LinkedIn page.

Regards,

Michael Gallo

2012-2013 Section Secretary



**INFORMATION TECHNOLOGY LAW SECTION  
Mission Statement**

The purposes of the Section are to review, comment upon, and appraise members of the State Bar of Michigan and others of developments in the law relating to information technology, including:

- (a.) the protection of intellectual and other proprietary rights;
- (b.) sale, leasing, distribution, provision, and use of, hardware, software, services, and technology, including computer and data processing equipment, computer software and services, games and gaming, information processing, programming, and computer networks;
- (c.) electronic commerce
- (d.) electronic implementation of governmental and other non-commercial functions;
- (e.) the Internet and other networks; and
- (f.) associated contract and tort liabilities, and related civil and criminal legal consequences.

*The Information Technology Law Section's bylaws can be viewed by accessing <http://www.michbar.org/it/councilinfo.cfm> and clicking the 'Bylaws' link.*

The *Michigan IT Lawyer* is pleased to present “Song Remains (Substantially) the Same: A Modest Proposal for a New Analytical Test in Music Plagiarism Cases” by James Plotkin, a winner of the 2012 Edward F. Langs Writing Award competition, and a graduate of the University of Ottawa - Faculty of Law.

The statements made and opinions expressed in this essay are strictly those of the author, and not the State Bar of Michigan or the Information Technology Law Section. Comments regarding this article can be forwarded to the *Michigan IT Lawyer*, care of [michael@gallo.us.com](mailto:michael@gallo.us.com). Enjoy!

# The Song Remains (Substantially) the Same: A Modest Proposal for a New Analytical Test in Music Plagiarism Cases

By James Plotkin

*This paper is dedicated to the memory of Dr. Robert Frederick Jones (1947-2012), music scholar, composer and beloved teacher at the Vanier College Music School. Your undeniable musical genius and virtuosity as well as your one of a kind character will be sorely missed.*



James Plotkin

## Introduction

In all of copyright law, few subjects are more elusive and controversial than music plagiarism. Music plagiarism refers to the copying of the musical elements of a composition by a composer of another composition. While it hasn't always been so, today, when an artist uses someone else's musical expression in their own work, such behaviour

is viewed as both morally and legally reprehensible. This is surely due, at least in part, to the relatively recent inclusion of music into copyright law.<sup>1</sup>

Since the first cases dealing with the subject, a number of legal tests have been crafted and applied to the question of what constitutes musical plagiarism. Part A of this paper seeks to unpack and criticise these approaches one by one. Particular emphasis will be placed on the tests applied by the two dominant courts in this area of law, the U.S. 2<sup>nd</sup> and 9<sup>th</sup> Circuits. Both of these courts have longstanding and incompatible interpretations of music plagiarism. Both- in this author's view- are flawed, primarily in that they both fail to allow the admission of expert testimony at the most crucial part of their respective analyses.

Part B will propose a new test for music plagiarism. It is the goal of this test to be both flexible and thorough so that

it may be applied equally to any comparison of musical compositions in any jurisdiction. This analytical method demands an examination of five distinct categories of musical features. Each feature is measured in three “lenses”: Small, medium and large. If successful in its stated goal, the proposed test will provide a standard for music plagiarism capable of being implemented not only by all American courts, but the courts of any common law (and potentially civil law)<sup>2</sup> jurisdiction.

## A. Existing Tests for Music Plagiarism

To date, no single test has been uniformly applied by courts on the question of music plagiarism. A number of tests have been fashioned over the years in an attempt to answer one of copyright's most thorny questions: What is the proper threshold for musical plagiarism?

This section discusses five of the tests that have been applied to music plagiarism cases over the last century. The two most prevalent tests are the ones currently established by the U.S. 2<sup>nd</sup> and 9<sup>th</sup> Circuit Courts. Before delving into those tests however, it would be pertinent to briefly discuss their antecedents.

### 1. The Substantiality Test

Originating in the 2<sup>nd</sup> Circuit, this test was first applied in *Marks v. Leo Feist, Inc.*<sup>3</sup> In that case, the Court told us that:

*“To constitute an infringement of the [Plaintiff’s] composition, it would be necessary to find a substantial copying of a substantial and material part of it.”*<sup>4</sup>

Under this test, expert testimony is allowed and the trier of fact may examine the musical scores of the two works in question. Upon examination of the evidence and hearing of witnesses, the trier of fact must first determine if there was any copying at all. If so, they must further determine whether that copying was of a “substantial part” and if the part in question is protected by copyright. If the trier of fact is satisfied that the part copied was both substantial and protected, a finding of infringement must follow.

The test is derived from the equitable doctrine of substantiality. In the courts of Equity, if the injury claimed by the plaintiff was not deemed adequately substantial, the court would deny the grant of an equitable remedy.<sup>5</sup> This test has not been widely accepted in the music plagiarism context for the simple reason that many consider it to be an equitable doctrine that should not be applied to copyright, a statutory creation. Professor Nimmer explains the historical perspective behind this view:

*Plagiarism actions [in England] usually were brought in courts of Equity, which of course, applied the equitable rule that unless substantial injury is shown relief must be had in the Law courts...when courts of Equity required substantial injury in copyright cases they usually did so because of the equitable rule, not because they were trying a copyright case.*<sup>6</sup>

It would appear from this passage that the application of the substantiality doctrine had less to do with the substance of the case (copyright) and more to do with the venue under which such claims were traditionally brought. Plainly stated, the substantiality doctrine belongs to Equity and not to copyright.<sup>7</sup>

One place where it may remain appropriate to apply the substantiality doctrine in the copyright context would be in the according of equitable remedies such as injunctions if infringement *is* found. Such is the position taken by the 7<sup>th</sup> Circuit.<sup>8</sup> In a century old decision, the Court, finding in favour of the plaintiff in a copyright action, denied the grant of an injunction reasoning that since the infringement, though existent, was so insubstantial, it would be wrong to grant the equitable remedy. The plaintiff was forced to settle for the remedies at law (in this case compensatory damages).

## 2. The Derivation Test/Comparative Method

The derivation test also finds its origins in the 2<sup>nd</sup> Circuit.

The test was first applied by Judge Learned Hand in *Haas v. Leo Feist, Inc.*<sup>9</sup> Judge Hand created this analysis in the first part of his career at the District Court level.<sup>10</sup> Under this test, infringement will be found if it is determined that the plaintiff’s composition “*Was a source of the defendant’s work*”.<sup>11</sup>

The issue with the derivation test (like all other legal tests for music plagiarism) is that it was absent a method to determine whether or not the plaintiff’s work was in fact a “source” of the allegedly infringing composition. It would be exceedingly rare for a defendant to stand up and admit that they used the plaintiff’s work as a source. Absent such an admission, how is the trier of fact to determine “derivation”?

In an effort to address this concern, Learned Hand (himself a musician) fashioned what is to date, the only “analytical” test for musical plagiarism that was both created and applied by a judge.<sup>12</sup> He referred to this analysis as the “comparative method”.

The comparative method comprises three steps: 1) Transpose the melodies into the same key; 2) Assign equal rhythmic values to each note and; 3) Analyse the melodies by examining the intervallic relations<sup>13</sup> between the notes as well as the general contour of the melody.

This test favours a focus on melody to the exclusion of all other musical factors. The reasoning behind this would be that average people without musical training identify melody more readily than other elements of a composition such as harmony or rhythm. Despite Judge Hand’s best intentions, his unsophisticated test is fraught with problems.

First, to say that melodies are the most recognizable elements of music to the untrained listener may be *generally* true on a superficial level. However, what Learned Hand curiously neglects to consider is that a melody devoid of its rhythmic values is hardly the melody people hear in context. An important truth about music is that while rhythm can exist without melody, melody cannot exist without rhythm.<sup>14</sup> In effect, Judge hand is not draining *all* rhythm out of the melody; he is draining *the* rhythm out of the melody which may often render that melody unrecognizable. He has simply assigned the sequence of notes that comprise the melody a new rhythm, one that is constant and unvaried. Doing this will often make it more difficult, not easier for a trier of fact to determine similarity.

This oversimplification can easily lead to findings of infringement when an examination in a fuller context would show sufficient difference in other important musical “identifiers”. Imagine for a moment two songs in two completely different styles with different instrumentation and arrangement.

Suppose further that 90% of the musical material used in both songs is completely different. Finally suppose that there was an identical series of 5 or 6 pitches in both compositions albeit with entirely different rhythms. Under this test, the earlier composition could potentially succeed in an infringement action despite the fact that the similarity in this case is virtually unrecognizable to the untrained ear (or perhaps even a trained ear without the benefit of having looked at the score).

Another major problem with the comparative method is that it supposes the fact that the only element of a song worth protecting is the melody (or more accurately as explained above, a series of pitches deprived of their original rhythmic context). This can create the unwanted result of a void in copyright protection for works whose other distinguishing features have been unlawfully appropriated. Indeed even Judge Hand himself found the comparative method inapplicable in certain cases where there is infringement under the derivation test. In *Fred Fisher, Inc. v. Dillingham*,<sup>15</sup> Judge Hand found infringement in the copying of an 8-note ostinato pattern in the complaining work's accompaniment.<sup>16</sup> However, as the melodies of the two pieces were markedly different, he found himself unable to apply the comparative method and was forced to base his determination on other grounds.

In addition to the above mentioned lacunae, Raphael Metzger points out that one of the likely reasons why the comparative method has never been widely adopted is due to the fact that: "...few federal judges possess Hand's musical knowledge...".<sup>17</sup>

### 3. The Audience Test

Also known as the "ordinary observer" or "average listener" test, the audience test is the standard most generally applied across most American jurisdictions in music plagiarism cases.<sup>18</sup>

Under this test, infringement is found if the trier of fact, upon hearing the two compositions in question, decides that there is substantial appropriation by the defendant of the complaining work.<sup>19</sup>

In one respect the audience test is significantly similar to the substantiality test as both require that a substantial part of the work be copied for a finding of liability. Unlike the substantiality test however, the audience test by its very nature excludes the admissibility of expert testimony. The determination of substantial similarity is based solely on the trier of facts aural perception. In addition to the inadmissibility of experts, the court will not allow for the provision of sheet music or any other visual aid for that matter.

The test is born out of the "reasonable man" doctrine and was first applied to a copyright plagiarism case in 1868.<sup>20</sup> Under this doctrine, the trier of fact must put themselves in the position of the defendant to determine if the later acted as an average person would in the same circumstances. While the subject matter of that case was infringement of a dramatic play, the audience test has- either as part of a larger test or as a standalone test- been applied to music plagiarism cases by a number of courts since then.<sup>21</sup>

This test has been fiercely criticized by a number of experts in the copyright domain.<sup>22</sup> Some of these criticisms as well as those of this author will be discussed in the next section in the context of the *Arnstein* test as the audience test is essentially the second prong of that analysis.

## 4. The Arnstein Test

In 1946 the Court of Appeals for the 2<sup>nd</sup> Circuit heard what would become a cornerstone of music plagiarism case law. In *Arnstein v. Porter*,<sup>23</sup> a composer of popular and Jewish songs, Ira Arnstein sued renowned Jazz composer Cole Porter for infringement of six of the former's musical compositions. Among the Cole Porter classics identified as infringing Arnstein's compositions were: "You'd Be So Nice To Come Home To", "Night And Day" and "What Is This Thing Called Love".

Finding in favour of the defendant, the 2-1 majority decision in the case was penned by Judge Jerome Frank. Judge Frank wrote that the test for musical plagiarism was a two-fold procedure. It must be shown: "(a) that the defendant copied from plaintiff's copyrighted work and (b) that the copying (assuming it to be proven) went so far as to constitute improper appropriation."<sup>24</sup>

### 4.1 First Prong - Copy

The plaintiff must establish that the defendant actually copied their work. The Court tells us this may be done in one of two ways: 1) By the defendant's admission that they copied or; 2) By the plaintiff showing through sufficient circumstantial evidence that the defendant had "access" to the original work.

As alluded to above, though it does happen, it is rare for a defendant to come out and admit that they copied the plaintiff's work. The only instance in which a defendant may strategically stipulate to copying would be if they intended to argue that though they copied, the material they appropriated is not protected by copyright. For example, one may write a pop song with the same basic harmonic progression as another song. Providing those songs are sufficiently different

on other grounds, even if one admits that they were inspired by the original song's chord progression, they would likely be able to argue with success that the chord progression in question is not protected by copyright and is therefore not "owned" by the plaintiff.

Under normal circumstance the plaintiff must prove that the defendant had access to the allegedly infringed work and as a result copied all or part of it. At this stage of the test, proof may be made by any means of musical analysis including expert testimony. The *Arnstein* majority determined that at this stage of the test, the testimony of experts on the allegedly copied elements of the source work may be helpful to the trier of fact's ability to decide.

One may ask why it is necessary to prove both copying and unlawful appropriation in two distinct steps. Indeed the dissenting Judge Clark of the *Arnstein* Court harshly criticized his colleagues (Judge Hand sided with Jerome Frank) for concocting such an analysis:

*I find nowhere any suggestion of two steps in the adjudication of this issue, one of finding copying which may be approached with musical intelligence and assistance of experts, and another that of illicit copying which must be approached with complete ignorance...*<sup>25</sup>

Judge Clark goes on to say that so long as copying is proven, "there are no degrees"<sup>26</sup> and that any further analysis as to whether the copying was "illicit" is a red herring. While Judge Clark's unvarnished "shoot 'em all and let God sort 'em out" approach is not without allure, it suffers from a certain lack of appreciation for the nature of copyright protection.

It is well established that a piece of music need not be entirely "original" or "unprecedented" to benefit from the protection of copyright.<sup>27</sup> Therefore, copyright may subsist in two songs that are by all accounts identical. It is thus inadvisable to base a determination of musical plagiarism solely on the resemblance of two compositions. Here in lies the logic behind Judge Frank's first prong.

However, this presents the unintended consequence of allowing unequal treatment under the law for composers (and compositions) of varying levels of popularity.

By way of example, if a major act such as the Rolling Stones or Aerosmith were to accuse a composer of plagiarism, they would have a relatively easy time proving access. The goodwill and recognition attached to these artists is beyond question. On the other hand, if a regionally known artist sought to accuse a composer (well known or otherwise) of plagiarism, he may have a difficult time proving access,

particularly if the defendant does not reside in the plaintiff's locus of popularity.

In the latter case, it is exceedingly possible that the defendant did in fact have access to the composition in question. Could they not have seen the plaintiff perform whilst traveling in the region where the plaintiff is popular? Even more likely in today's online world, could they not have happened upon a recording of a performance of the composition on the internet?

The Court in *Arnstein* and a number of other decisions<sup>28</sup> have attempted to deal with this inequality by allowing for an inference of copying when the similarity between the allegedly infringing work and the original work is so striking that it could not possibly have been the product of independent creation.

#### 4.2 Second Prong – Improper Appropriation (Illicit Copying)

We must always keep in mind that not all copying is objectionable because not all elements of a given song are protectable by copyright. It is only "illicit copying" that is actionable under the law. Generally, when we zoom in to the very small or zoom out to the very large, what we observe tends to not be protected by copyright. For instance, a single musical interval is far too small to be considered infringement. At the same time, a general song form such as "AABA" or the "12-Bar Blues" is too large and encompassing to be protected.

This part of the test is where the *Arnstein* majority makes a clear distinction between copying and illicit copying. Here, the "lay hearer" (the trier of fact) is to decide whether the portion of the work copied is significant enough to amount to an improper appropriation of material in which the plaintiff has a property right. In the Court's own words, the trier of fact must determine: "*whether defendant took from plaintiff's works so much of what is pleasing to the ears of lay listeners...*"<sup>29</sup>.

At this stage of the analysis the Court applies the audience test. As always, neither expert testimony nor written representations of the work are admissible at this point. The trier of fact is to base their judgement of illicit copying solely on their aural impression of the two works.<sup>30</sup>

The majority reasons this by explaining that what is protected by copyright is not the composer's reputation but the exploitability of his or her work. With this in mind, it seems intuitive to make the adjudicating view point that of the lay hearer as they are the potential market for these works. After all, most composers do not write music strictly for their personal benefit or the benefit of other musicians,<sup>31</sup> but for the public.

There are several criticisms to be launched against the *Arnstein* test. Most of these attacks are aimed at the second prong although the author does find more than a modicum of fault with the first prong as well.

#### 4.3. Criticisms of the *Arnstein* test

Dealing first with the “copy prong”, on first view the Court’s reasoning seems to preclude any unfairness towards a lesser known composer. It does this by allowing for the plaintiff to prove striking similarity between the two works.

Nonetheless, this approach threatens to lead us back to the original problem the test seeks to avoid- namely finding infringement based solely on musical similarity between two works however striking that similarity may be.

Though the 7<sup>th</sup> Circuit in *Selle v. Gibb*<sup>32</sup> ruled that striking similarity alone is insufficient to prove copying and that some proof of potential access is required, a number of other decisions have applied this principle without temperance.<sup>33</sup>

Though largely adequate, the first prong of the *Arnstein* test is doomed to imperfection. As we’ve seen, if we maintain strictly that access must be shown to prove similarity no matter how striking that similarity may be, less known composers will suffer a lack of recourse. On the other hand, if we allow for copying to be established by the “striking similarity” argument, we preclude the possibility of two near identical pieces being independently composed, a contingency allowed for by copyright law. The only way to maintain this prong while mitigating the instances of unfair rulings would be to amend the test to formally recognize that the “impossibly striking similarity” argument should only be applied in extreme cases (and to define those cases). Further discussion on what should constitute an extreme case will take place in Section B of this paper under the author’s new proposed test.

Turning now to the second prong, several criticisms may be launched at the majority’s importing of the audience test. Five such criticisms will now be addressed:

First, the lay hearer is only to consider copying of “what is pleasing to the ear” to be illicit. This can be read to say that the only part of a musical work that is protected by copyright is the “hook” or “catchy part”.<sup>34</sup> This seems to somewhat shortchange plaintiffs. If 90% of two songs are identical yet contain totally different “memorable parts”, should the defendant really be said not to have engaged in illicit copying? We must not forget Judge Hand’s determination in *Fred Fisher, Inc. v. Dillingham* where he found his comparative method unable to account for the copying of an ostinato pattern. Such an element may not be the most “memorable part” of a

composition while still being something original enough for a composer to lay claim to.

It is also worth mentioning that what a trier of fact may consider pleasing to the ear may be entirely outside the protection of copyright. True the first prong is supposed to distill the protected elements from the unprotected elements. However, since the audience test is completely auditory, either a performance or recording of the compositions are played for the trier of fact. It may be difficult for the lay hearer to abstract the unprotected elements from the protected ones without the aid of either expert testimony or a score modified to draw attention to the parts of the composition in issue. Though experts are allowed during the first prong of the test, the admission of expert testimony here would be useful, not to impose objective criteria, but to “refresh the memories” of triers of fact on what they must subjectively decide on.

A second criticism of the majorities reasoning is the assertion that it is only the ability of the plaintiff to profit from their work that is protected by copyright. The Court states that:

*“The plaintiff’s legally protected interest is not, as such, his reputation as a musician but his interest in the potential financial returns from his compositions which derive from the lay public’s approbation of his efforts.”*<sup>35</sup>

While it is true that in common law jurisdictions copyright has at its heart economic concerns<sup>36</sup>, the protection of a copyright is not delineated by marketability, but by subject matter (and more importantly) duration. The term for copyright in the U.S. is the life of the author plus 70 years.<sup>37</sup> Most musical compositions are not profitable for the entire duration of their copyright protection. Upon a literal reading of the Court’s words, it would be easy to suggest that once the “potential for financial returns” is gone, *none* of the work should be protected from copying. Again, while economic gain is the primary concern of copyright, it is the author’s opinion that the 2<sup>nd</sup> Circuit erred in inferring that it is the *only* concern of copyright.

Finally on this point, it is entirely possible to profit from infringing a composer’s copyright without harming their bottom line. For example, if a new pop artist appropriated a recognizable part of a Louis Armstrong song, it is doubtful that the lovers of Louis Armstrong (Jazz fans) would buy the Pop song that appropriates his material instead of recordings of the original work. Quite the contrary, it is conceivable that the exposure gained by the original song as a result of the appropriation may turn out to be financially beneficial to the original copyright holder by increasing their audience.

For these reasons, the assertion that only the economic viability of a work is protected is patently false. After all, no

copyright law protects “the exclusive right to produce or reproduce the work...as long as said activities are profitable.”

Third, the 2<sup>nd</sup> Circuit’s (and more specifically Learned Hand’s) apprehension over the admissibility of expert testimony in copyright plagiarism cases in general is a matter of some debate. In *Nichols v. Universal Pictures Corp.*<sup>38</sup> Judge Hand strongly opposes the admission of expert testimony in copyright plagiarism cases. He sees expert testimony in these matters to be an undue burden on the legal process. He writes:

“The testimony of an expert on such issues, especially his cross-examination, greatly extends the trial and contributes nothing which cannot be better heard after the evidence is all submitted. It ought not to be allowed at all...”<sup>39</sup>(Emphasis added).

The Nichols decision dealt with a dramatic work. It remains unclear to this day whether in this passage Judge Hand was referring to music plagiarism cases in general or plagiarism of dramatic works specifically. It would be reasonable to read Hand’s decision in *Nichols* strictly.

Some scholars are of the opinion (and the author agrees) that the need for expert testimony in infringement cases varies greatly depending on the type of work at issue.<sup>40</sup> In the case of a “plot based” work such as a book, play, television show or movie, expert testimony is generally considered to be unnecessary. It is believed that the average person without any exceptional knowledge of the art of story writing is capable of discerning differences and similarities between elements of these works.<sup>41</sup>

On the other hand, in the case of a more complex and less accessible works such as a computer program, the need for expert testimony is obvious. While the “reasonable man” will be able to discern differences and similarities in plot based works, in the case of computer programs, these determinations would be practically impossible for those not trained in software design. Further to this point, as per the United States *Federal Rules of Evidence*, experts are permitted to offer their own personal opinions if the elucidation of those opinions would aid the trier of fact in reaching a determination.<sup>42</sup>

It is generally held that music fits somewhere between plot based works and computer programs.<sup>43</sup> Music is a highly abstract art form. Unlike the visual arts, the abstractness lies in the intangible nature of sound.<sup>44</sup> It is precisely this quality that necessitates the guidance of experts so that average people may make an informed decision on the similarity between two musical compositions.

Thus, while applying the *Nichols* reasoning to plot based works makes sense, musical compositions, due to their in-

herent complexity and lack of accessibility should be seen to fall outside the scope of that case.

A fourth objection to the second prong (and why expert testimony should be admitted in music plagiarism cases) is the fact that the average person does not *consider* themselves “knowledgeable” about music. Music tends to carry more of an intellectual mystique than literary or cinematic works. This may be because the bare elements of music (melodies, harmonies, rhythms etc.) are considerably less accessible to a non-musician than the bare elements of a literary work (words, sentence structure, literary devices etc.) to a non-writer.

While studies done by neuroscientist and Professor Daniel J. Levitin suggest that average people are considerably more musically aware than they realize,<sup>45</sup> the mere perception of inadequacy by the trier of fact militates in favour of the admissibility of expert testimony. Otherwise put, allowing expert testimony may at the very least cut down on *perceived* uncertainty by the trier of fact.

Fifth and finally, the author fundamentally disagrees with the *Arnstein* Court on the point of reference being that of the lay hearer. It is well established that even “subconscious copying” constitutes plagiarism.<sup>46</sup> In the case of *Bright Tunes Music Corp. v. Harrisongs Music, Ltd.*<sup>47</sup> The Court found that though it believed that George Harrison did not intentionally plagiarize the Chiffon’s song “He’s So Fine” in composing “My Sweet Lord” it was nevertheless: “[an] infringement of copyright, and is no less so even though unconsciously accomplished.”<sup>48</sup>

Because there is no requirement that the defendant plagiarized consciously or with malicious intent, why then, is the point of reference that of the lay hearer? This implies that the defendant plagiarized with the goal of deceiving the public and profiting from the goodwill of the plaintiff’s composition. It is disingenuous to apply the “ordinary man” doctrine to the case of an alleged music plagiarizer because the ordinary man has no bearing on what goes through the mind of the “ordinary composer” when they write music. Put bluntly, composers are not ordinary men!

It seems as though the audience test poorly imports elements of the tort of passing off from trademark law. In an action in passing off, the point of view is that of the “average consumer”. This makes sense in the trademark context because the entire *raison d’être* of trademarks are to aid the public in associating a particular ware or service with its source.<sup>49</sup> However, the *raison d’être* of copyright law is not such.<sup>50</sup> As mentioned above, economic viability is an important objective of copyright protection. However, the intention

of copyright is not to associate a work with its creator, but to protect that creator's exclusive right to exploit the work.

If a trier of fact is to adjudicate on music plagiarism by putting themselves in the position of the defendant, then they should have some idea what the defendant's process (or the process of composing music in general) is actually like. Only then would they be able to make an informed decision, not on what the reasonable man would have done, but what the reasonable composer would have done. Since it is impractical to demand that all Federal Judges or juries be song writers or composers, the only way to effectively communicate that perspective to the trier of fact is by way of expert testimony.

## 5. The Krofft Test

Not to be outdone by New York, the 9<sup>th</sup> Circuit has fashioned its own test for music plagiarism. This test, a two-prong analysis, is similar in form to the *Arnstein* test although it differs in substance. The 9<sup>th</sup> Circuit's analysis is based on the "idea-expression dichotomy". The Court divides the test into an "extrinsic" prong and an "intrinsic" prong.

### 5.1 The "extrinsic" prong

Dealing first with the extrinsic prong, here the plaintiff must show that the "idea" of the allegedly infringing work is actually similar to his own.<sup>51</sup> This is proven by objective criteria and expert testimony is admitted to aid the trier of fact in their determination.<sup>52</sup> The court allows experts to "dissect" the compositions in an effort to find out if the defendant infringed the plaintiff's general "musical idea".

The objective criteria to be considered are not specifically laid out by the *Krofft* Court. This is because the Court correctly realized that different categories of copyright protected works require different criteria. In *Krofft*, the type of work at issue was a dramatic work. The case turned on whether or not the plaintiff's characters were "ripped off" by the defendant. Considerations such as setting, theme, and character development, while important to the analysis of a dramatic or literary work, find no application in the analysis of musical works.

The *Krofft* test was first applied to a music plagiarism case in *Baxter v. MCA, Inc.*<sup>53</sup> Unfortunately this case doesn't shed any light on what elements of a musical composition should be considered and dissected by experts to determine similarity of ideas. This is because the defendant, on motion for summary judgment admitted that the ideas of the two works were substantially similar and that the defendant had access to the plaintiff's work. They argued, however, that

there was no substantial similarity in the expression of the two musical ideas.<sup>54</sup>

In an important 2004 decision styled *Swirsky v. Carey*,<sup>55</sup> singer Mariah Carey was sued by a pair of songwriters for infringement of their composition. The Plaintiff brought in a musical expert to break down the two compositions to determine whether or not the ideas were substantially similar.

After the expert dissection (which comported an analysis of elements such as melody, harmony, rhythm, song structure, bassline etc.), the Defendant made a motion for summary judgment claiming that the Plaintiff did not satisfy the extrinsic test. This motion was granted by the District Court. The Judge found that the Plaintiff's expert's analysis was too subjective.<sup>56</sup> This criticism was based in part on the fact that the expert dissected the melody in such a way as to remove all the notes he deemed to be "ornamental".

The 9<sup>th</sup> Circuit Court overturned the District Court's ruling on summary judgment. They found the Plaintiff's expert to have been sufficiently objective in his analysis – at least to the point where a trier of fact may be disposed to find similarity of expression in an intrinsic test. The Court agreed that applying too rigid of a comparison between two melodic sequences does not serve the goal of the extrinsic test. Since at this stage we are seeking to find similarity in ideas only, it can be argued that an exact copy of the melody is not required for a plaintiff to accede to the second prong.

### 5.2 The "intrinsic" prong

At this stage of the analysis, the 9<sup>th</sup> Circuit essentially follows the prescription in *Arnstein* by applying the audience test. Once similarity between the musical ideas has been shown via the extrinsic test, we turn once again to the lay listener to tell us if there is a sufficiently high degree of similarity between the songs they hear. As this is an auditory test, the trier of fact is examining not ideas but expressions. Here in lies the 9<sup>th</sup> Circuit's novel application of the idea-expression dichotomy. As is the case in *Arnstein*, expert testimony is inadmissible during this prong.

In order to determine whether or not the similarity between the two expressions is substantial, the trier of fact must undertake a "qualitative analysis". Sometimes, as was the case in *Baxter*, the defendant will admit similarity in ideas but deny similarity in expression contending that the part of the composition accused of similarity is too small or insignificant to the overall work. In theory, the trier of fact should ignore the assertion that the part copied is too small to be protected as the analysis is *qualitative* and not *quantitative*.

By way of example, the musical phrase “C#, C#, B, A” is only four notes long. However, if one were to: a) Sing or play this phrase in 4/4 time; b) Give the value of an eight-note to each attack and; c) Begin the phrase on the 4<sup>th</sup> beat of the bar, one would find themselves playing the iconic opening (and recurring) theme from “Pretty Woman” by Roy Orbison. Considering how important this four note phrase is to this extremely well known classic, the brevity of the phrase should be immaterial under the 9<sup>th</sup> Circuit’s analysis.

It may be pointed out that this differs slightly from the 2<sup>nd</sup> Circuit’s phrasing of the second prong of the *Arnstein* test where the defendant must take “so much of the work that is pleasing to the ear...”<sup>57</sup> This passage seems to imply the consideration of quantity even if the number of notes or bars is not the determining factor.

### 5.3 Criticisms of the *Krofft* test

In addition to the worries expressed by the author particular to the *Krofft* test, it should be noted that all the criticisms of the *Arnstein* test dealing with the inadequacy of the audience test are easily transposable to the 9<sup>th</sup> Circuit’s analysis as well. This is due to what the author perceives as the fundamental flaw of disallowing expert testimony at the second stage of both the 2<sup>nd</sup> and 9<sup>th</sup> Circuit approaches.

Concerning the test as a whole, there is much difficulty with the application of the idea-expression dichotomy. Two distinct issues present themselves:

First, it is understood that in copyright law, only tangible expressions are protected.<sup>58</sup> The 1976 *Copyright Act* draws a distinction between “ideas” and “expressions”. The law is clear that the former is not protected by copyright and the latter is.<sup>59</sup>

If this is the case, the 9<sup>th</sup> Circuit analysis should be found to be in error for the sole reason that it necessitates the comparison of ideas. It is true that under the *Krofft* test, in order for infringement to be found the plaintiff must be successful in showing both extrinsic similarity (ideas) and intrinsic similarity (expressions). However, one might ask why the Court chooses to consider similarity between ideas in the first place if ideas, by definition, are not protected by copyright.

Notwithstanding the above problem, even if we considered it appropriate to examine ideas in our plagiarism analysis, would this truly be the stage at which we would admit expert testimony? It would be intuitive to think that experts would be more useful in the analysis of tangible expressions. After all, the tangible lends itself better to conclusive analysis than the intangible.

Second, the idea-expression dichotomy does not apply cleanly in the musical context. Remember that the *Krofft* case involved a dramatic work. Dramatic works are “plot based”. As discussed above in the context of Learned Hand’s decision in *Nichols*, plot based works are considered more accessible to the lay person and therefore are less likely to require expert testimony.

Though it would be a confusing use of the term in the copyright context, one may consider the plot of a work to be its “idea”. Purely musical works are not plot based. There is no easily discernible story that the composer is trying to tell. When music is set to some sort of visual performance, it may be possible to point out some sort of “idea” or “plot” to the music. An example that springs to mind is Disney’s “Fantasia”<sup>60</sup> where it seems as though the music is directly related to what is happening on the screen (or vice versa). Yet, without the accompanying visuals, the music of “Fantasia” is as abstract as any other piece.

Therefore even if it is possible to make it work with plot based works, the application of the idea-expression dichotomy to music is simply misguided. As such, it is inappropriate for the idea-expression dichotomy to be the basis of a general framework for adjudicating copyright plagiarism regardless of the nature of the work in question.

To speak of the extrinsic prong in particular, on top of everything just mentioned, the Court fails to issue objective criteria for its “objective test”. It is well and good to say that the extrinsic test is objective and therefore admits expert testimony. Nevertheless, an objective test calls for judicially prescribed criteria by which the expert analysis is to be conducted.

The point that different categories of copyright protected works require different criteria is well taken. However, this should not prevent the Court from establishing criteria for each category of work as they appear in litigation. The list of criteria need not be exhaustive. Simply having the Court recognize certain musical identifiers as being relevant would be a step in the right direction. Further, the test could potentially be modified or added to as more convincing arguments for the inclusion or exclusion of specific criteria come up in the case law.

It could be argued that by overturning the District Court’s ruling in *Swirsky*, the 9<sup>th</sup> Circuit implicitly recognized the factors considered by the Plaintiff’s expert in that case as the appropriate criteria. However the Court didn’t judge the case *de novo*. Instead they simply overturned the District Court’s decision on the motion for summary judgment made by the Defendant.

The end result is a lack of endorsement by the Court of either a “definitive” or a “non-exhaustive” list of objective criteria to be considered in the extrinsic analysis of two musical compositions.

Turning to the intrinsic prong (in addition to those arguments made against the inadmissibility of expert testimony), it has been held in another 9<sup>th</sup> Circuit decision that under the *Krofft* test: “To constitute infringement of expression, the total concept and feel of the work must be substantially similar.”<sup>61</sup> In *Baxter*, the similar musical passage was only five or six notes long.

This seems to betray an internal inconsistency with the 9<sup>th</sup> Circuit’s treatment of the intrinsic prong. The *Baxter* Court makes clear that the quantity of material is unimportant. It is the value of the portion in question to the whole work that must be considered. If this is true, it shouldn’t matter that only six notes were copied. This inconsistency in the 9<sup>th</sup> Circuit’s jurisprudence should be corrected and clarified.

## B. A Modest Proposal for a New Music Plagiarism Test

Having thoroughly criticized the most important music plagiarism tests in force today, the author wishes to propose a new test for music plagiarism. The proposed test will use the *Arnstein* analysis as a starting point. The reason for this is that unlike Judge Clark, the author doesn’t see an inherent problem with a bifurcated test for music plagiarism. Furthermore, the copy prong is largely satisfactory and would remain intact, notwithstanding a minor adjustment to the “striking similarity” doctrine.

The *Krofft* test is an unsuitable starting point due to its basis on the shaky idea-expression dichotomy. In addition, all criticisms that can be levied against the second prong of the *Arnstein* test may be levied against the second prong of the *Krofft* test (and then some).

For these reasons, the proposed test will, like *Arnstein*, be made up of two prongs: Copying and Illicit Copying.

### 1. Copying

As mentioned above, the author finds little fault with the first prong of the *Arnstein* test. Considering copyright may in theory subsist in two identical and independently created works, it is vital to prove not only that the material is the same in both songs, but that the plaintiff’s material was actually copied by the defendant.

As such, like *Arnstein*, the proposed test would allow proof of copying to be made by direct evidence or circumstantial proof of access.

The only vital difference would be the tempering of the striking similarity doctrine. In certain cases, even striking similarity should not be considered preponderant proof of copying. As mentioned in section 4.3, the application of the striking similarity doctrine should be applied only in “extreme cases”.

A useful criterion for deciding whether or not we are in the presence of an extreme case of striking similarity would be the complexity of the work in question. It is much harder to believe that two composers independently composed strikingly similar works that are highly complex or harmonically or melodically varied than ones that are simple and repetitive.

Another criterion could be the length of the compositions. It is significantly less likely for two composers to independently create near identical three movement concertos than two equally similar three and a half minute pop or rock song.

Finally, one might consider the identical usage of irregular sounds or irregular use of an instrument. Irregular sounds could include recognizable sound effects such as breaking glass or a thunderclap. This category may also include abstract effects created through the manipulation of sound sources to create new “inorganic” sounds. An irregular use of an instrument is highly contextual. Obvious examples may include a punk rock song with a prominent sitar line or a blues song with bagpipes. Unlike irregular sounds, here it is not the instrument, but its use in a given context that constitutes its irregularity thereby reducing the chances of independent creation of the defendant composition.

### 2. Illicit copying

The author’s proposed test for illicit copying draws influence from the method proposed by Raphael Metzger.<sup>62</sup> Metzger endorses the adoption of what is known as the “La Rue” test.<sup>63</sup> In a perfect world in which all experts would endorse and use this highly complex and nuanced method, the La Rue analysis would make a solid definitive test for musical plagiarism. Unfortunately, we live in reality.

Due to the brevity of this paper and the nuance and complexity of the method, it would be impossible to do even a brief explanation of the La Rue test.<sup>64</sup> In essence, the test centers on the analysis of four principle attributes: Sound, melody, harmony and rhythm. The test also demands looking at all these attributes with a small, medium and large lens. This means that in the context of melody for example, we might do an analysis of the contour and range of the entire melody (large); An analysis of the individual sections such as verse and choruses (medium) and; Analysis of smaller melodic motives applied by the composer throughout the composition.

While this author agrees in large part with the above categories and scope of analysis, the fact that the La Rue test itself is so vast and complex makes it cumbersome and therefore unappealing as a universal standard. An overly complex analysis may ultimately translate into confusion of the trier of fact, a counterproductive outcome. Instead, while retaining the spirit of La Rue's analysis, the author proposes a more flexible framework.

The test will comprise an analysis of five categories: Melody, Harmony, Rhythm, Technological Sounds/Effects and Arrangement. These factors should be examined individually and in relation to one another. Under this analysis, the first three categories are to be given a heavier weight than the fourth and fifth. Each will be discussed in turn.

### 2.1 Melody

Any honest examination of melody must avoid the abstraction of that melody from its rhythm. For the reasons mentioned earlier, to use a process similar to Judge Hand's comparative method is unappealing. We must therefore examine the melody in its rhythmic context. As a point of clarification, under the proposed test, the difference between a melodic analysis and rhythmic analysis is that the latter examines the rhythm of the accompaniment (harmony<sup>65</sup> and percussion).

The proposed test's analysis of melody is not unique or rigid. The only requirement is that the melody be examined within the large, medium and small contexts.

The large scale melodic analysis would obviously consist of an examination of the overall contour of the composition's melody throughout. The range of the piece is important as well. As the name of the song suggests, the main melody of Antonio Carlos Jobim's "One Note Samba" does not contain florid two octave runs. "Killer Queen" by Queen on the other hand, contains melodic leaps of over an octave.

A medium scale analysis would look at the melodies of each section of the composition. Like the large scale analysis, the focus here is on contour and range. At the medium level, it also becomes important to examine the melodic rhythm. Sometimes sections of a song (and by extension the song as a whole) can be easily identified by the rhythm of the melody. A classic example of this is the "A" section of the Jazz classic "Oleo" by Sonny Rollins:



The recurrence of the "oleo motive"<sup>66</sup> at different rhythmic points is one of the key elements that make this melody memorable.

The small scale analysis examines the individual melodic motives of a composition. It is at this level where much of the battle is to be fought. A melodic motive can be characterised as a short musical figure. Though not absolutely necessary, motives are generally recurring. Sometimes variations of the same motive appear. An excellent example of a recurring melodic motive is, once again, "Oleo":



As mentioned above, it is without a doubt this three note motive (appearing five times in eight bars) that makes the melody both identifiable and memorable.

Some posit that only the "structure tones" of a melody should be examined without regard to ornamentation.<sup>67</sup> In *Swirsky*, the Plaintiff's expert was criticised by the Trial Judge for distilling the melody down to its structure tones asserting that the melody should be examined as is. Under the proposed test, both approaches are valuable. An expert should analyse both the structure tones apart from the ornamentation as well as the whole melody as written. The reasoning behind this is that while the structure tones are most important to the melody from a mechanical perspective, it is often the ornamentation that is memorable. For example, the iconic opening of the Toccata and Fugue in D minor (BWV 565) by J.S. Bach would be rather dull without the fast runs leading us to each of the structure tone (marked by arrows):



In this figure, it is plainly apparent that most of the action is happening between the structure tones.

### 2.2 Harmony

Harmony is often thought of as non-proprietary. To a certain extent this is true in that no one may lay claim to a particular progression of chords. However, there is more to harmony than a simple sequence of chords. In addition to considering the harmonic progression, the proposed test

calls for the examination of at least two other factors relating to harmony: Voicing and harmonic rhythm. Again we must analyse the harmony with a large, medium and small lens.

Voicing refers to the vertical relation between the notes of a chord. All major and minor chords are composed of three different notes called a triad.<sup>68</sup> These three notes may be arranged in any number of ways to form a chord. The notes in the triad may be (and usually are) repeated to allow for chords with more than three notes in them. Below are a few ways in which one may voice a “C major” chord with four notes:



The C major triad is composed of the notes C, E and G. So long as only these notes appear in the chord (and each appears at least once), any arrangements of these notes is theoretically acceptable.

Some styles of music like Classical will dictate exactly which voicing is to be used by writing it out as in the manner above. In other styles like Rock, Blues, Jazz and most Pop, chord symbols are written and the performer is expected to improvise a voicing. In the former case, an exact note for note copy of a harmonization may militate towards plagiarism. However, if the sheet music of the song only contains chord symbols, while infringement may not be entirely ruled out, the plaintiff should be seen as having a more tenuous claim over the harmony in question and a finding of infringement should necessitate similarity in other categories to support the claim.

In the case where voicings are written out, the analysis should follow much the same procedure as the melodic analysis. If only chord symbols are specified, the voicings used by the performer in any recording of the composition are irrelevant and should not be considered by the trier of fact as the defendant did not choose them specifically. In the latter case, the harmonic progression of the work should only be considered in conjunction with a similarity found in another element like melody or rhythm.

Harmonic rhythm refers to the pace at which the harmony changes in a composition. Pieces may have a constant harmonic rhythm (for example, the chord changes every two bars), or a variable harmonic rhythm.

To clarify the distinction between harmonic rhythm and the rhythm applied to the harmony, where the former refers to the pace at which chords change, the latter refers to the rhythmic pattern being used to play those chords (like a strumming pattern on a guitar). The rhythm applied to the harmony is part of the rhythmic analysis and will be discussed in the next section.

In harmonically simple compositions which only use three or four different chords, similarity in harmonic rhythm is more acceptable and even expected. There are only so many paces at which one may change between three different chords. However, in the case of a more varied harmony, particularly in pieces that change key frequently (as in Jazz), similarity in harmonic rhythm is slightly more telling.

Thus there are three considerations with regards to harmony: Harmonic progression, voicing and harmonic rhythm. As would be expected, when similarity is found in two or all of these areas, a finding of infringement should be considered more likely than if similarity is only found in one.

### 2.3 Rhythm

The rhythmic analysis may be divided into two parts: 1) Percussion rhythm and; 2) The rhythm being applied to the harmony. Both should be analysed in a large, medium and small scope.

Naturally, percussion rhythm only applies in songs containing percussion. This makes up the majority of commercial music produced today. As a general rule, a drum pattern cannot be protected by copyright. Even patterns that are more complex should generally be considered outside the scope of copyright protection. However, sometimes the drum kit is doing more than keeping time for the rest of the instruments. In the case where the percussion is playing a composed passage it should be treated like a melody and should be considered potentially proprietary.

Ginger Baker, Rock drummer from the band Cream, claims to have “invented” the following drum pattern as played in the intro and interlude from their hit “White Room”:



While Mr. Baker undoubtedly exaggerates when he says he *invented* this rhythm, he certainly did apply it in a very memorable way to a rock and roll context in which it stood

out at unusual. An identical use of an identical pattern in a similar rock and roll context may well be considered illicit copying under the proposed test.

Turning to the rhythm as applied to the harmony, it is here that we concern ourselves with the rhythm in which chords are played. The strumming pattern of a guitar or the rhythmic pattern in which keys of a piano are struck when playing chords have more to do with rhythm than they do with pitch. In cases where the composition contains percussion, these rhythms complement it. In compositions with no percussion, the rhythm applied to the harmony becomes the “time keeper” and for all intents and purposes assumes the role of the drum kit.

Like the “White Room” drum figure shown above, only in instances where these rhythms are irregular in the context in which they are being played should they be afforded consideration on their own merits (that is to say that they are potentially proprietary). If not, similarity in these rhythms may be considered in conjunction with other similar factors to suggest a finding of infringement.

#### 2.4 Technological sounds and effects

This category refers to sounds and modifications to sounds that are common in recorded music. On first sight, one might say that these elements are not strictly speaking parts of a musical composition and should be excluded from any analysis of music plagiarism. While this may have been true at one point, the incredible technology and equipment available to musicians and record producers today forces us to reconsider this position.

The song “Where the Streets Have No Name” by U2 is marked by an iconic guitar part. The melodic pattern being played by David Evans (commonly known as “The Edge”) is quite simple and unimpressive. However, when he plays the pattern (or “riff” as guitar players call them) with his special delay<sup>69</sup> and reverb<sup>70</sup> out of his particular amplification rig, what is produced is a swelling, disorienting yet soothing guitar part that will not soon be forgotten.

The author argues that sounds and textures that are technologically produced and are not necessarily expressible in musical notation should benefit from copyright protection. After all, considering there are only twelve different notes in western music, perhaps these technological sounds and effects make up an altogether new source of musical originality not present before the advent of modern recording.

**Technological sounds.** A technological sound refers to a sound not made by a normal instrument. Synthesizers that can produce “synthetic instrument” sounds as well as

samples of sounds created by recording and manipulating audio would fit into this category.

One of the first well known instances of synthesiser use is by the late Richard Wright, keyboardist of Pink Floyd. He used a number of different pieces of equipment to achieve original and iconic sounds.<sup>71</sup> While Wright should not be seen to have a monopoly over a given tone, a shameless appropriation of his sound coupled with certain other factors outlined in this test may militate in favour of a finding of illicit copying.

Samples are simply sounds, musical or otherwise, that are pre-recorded and later used within a larger musical context. A sample could be anything from the sound of a bowling ball knocking down pins to a five second extract of a choral performance. While sampling is very common in electronic and hip-hop music, pop, rock and other styles use sampling as well. Some compositions are composed entirely of samples and contain no traditionally composed sections.

For these reasons, while not determinative, the use of samples should also be considered in any plagiarism analysis where such a consideration is applicable.

**Technological effects.** There is something about the drums in all Phil Collins songs that is inherently Phil Collins. In reality, while Phil undoubtedly has a style of playing, his signature sound is more than that. It comes down to the use of particular microphones, reverb and equalization to produce that memorable tone that instantly identifies the song as Phil Collins before he even starts singing.

Use of these technological tools is common and a person skilled in the art of recording and sound production can copy them in the same way a composer can copy a melody. For this reason, like technological sounds, use of technological effects like reverb, chorus, delay etc., while not determinative, should be considered in music plagiarism cases where such considerations are relevant.

Here again, sceptics of this view may retort that “you can’t copyright reverb or use of a microphone”. This is true. However, the nature of modern digitally recorded music dictates that the goodwill attached to a Phil Collins song has more to do with the tone of his drums than the actual rhythmic patterns he is playing on them. Not granting protection for these features under music plagiarism leaves them open to appropriation. So long as the alleged infringer does not use the actual sound recording of the original song, he is free to copy technological features without fear of incurring legal recourse for infringing a sound recording. This is especially true in cases like the above example as the raw rhythms Phil Collins plays are likely not proprietary.

It should be noted that it may take a different kind of expert to discuss these features of musical compositions. Such features generally fall outside the purview of a musicologist or expert in musical composition. Producers, recording engineers and specialists in recording equipment are the relevant sources of expert testimony for this category.

### 2.5 Arrangement

In music, the term 'arrangement' refers to a number of features. On the rudimentary level, arrangement refers to the number and types of instruments (timbre<sup>72</sup>) being used to play a particular piece. For example, a rock band may have two versions of the same song: one in which the whole band is playing and one "acoustic" version featuring only the singer and a guitarist. Both recordings are clearly different versions of the same song. In the first, the song was arranged for (shall we say) drum kit, bass guitar, rhythm guitar, lead guitar and voice. In the second, the same composition was arranged for a single rhythm guitar and voice.

On another level, arrangement may refer to different ways of interpreting a composition. In Jazz music, very often a melody or "head" is written by a composer and given to an arranger for treatment. One famous example of this was the creative collaboration of Jazz trumpeter and composer Miles Davis and arranger Gil Evans. In this situation, the composer will generally present the arranger with a head and a harmony part or "changes".<sup>73</sup> From there, the arranger will create a structure which will usually involve elements such as intros, solo breaks, codas, "shout choruses" and endings.

It is quite common in Jazz to have dozens of unique arrangements of the same song. These new arrangements, though clearly versions of an existing melody, stand on their own as musical works. In reality, they are derivative works and may therefore be independently protected by copyright. While this behaviour is typical to the world of Jazz, certain criteria discussed above can be useful in determining musical plagiarism outside the Jazz context.

Under the proposed test, the expert would be called upon to examine not only the instrumentation (the "Classical" concept of arrangement), but the song structure. Here again, the expert's analysis should comport a structural breakdown of: 1) The overall song structure (large); 2) The structure of each section (medium) and; 3) The placement or recurrence of each melodic and harmonic motive (small).

The overall song structure is the easiest and most superficial part of the analysis. An example of the overall structure of a rock song may be: Intro, verse, chorus, bridge, chorus verse chorus, fade ending (on chorus). This format is very

standard and holds low weight in the consideration of infringement. An instance where the large scope arrangement analysis may prove telling is in the case of a very strange or irregular arrangement. While this would not be determinate, exact copying of an irregular arrangement may be considered an aggravating factor for plagiarism.

The medium resolution test entails a structural assessment of the melody and harmony of each section. A common example of melodic structure in a number of musical styles is X, Y, X, Y'.<sup>74</sup> A common example of a rock or pop harmonic structure would be I, IV, V, I.<sup>75</sup>

Note that a structural analysis of a melodic motive is not quite the same as a melodic analysis. Where the melodic analysis examines the melodic rhythm, intervallic relation of the notes to one another and the contour of the melodic motive, the small scale arrangement analysis concerns itself with the placement and recurrence of those motives within the composition, not the motives themselves. The same is true for the harmonic structure. The actual harmonic progression is analysed under the harmony analysis (section 2.2 above). Here, we are interested in the placement of those chord progressions within the context of the section or composition.

Just because the defendant's work contains an identical melodic or harmonic structure to the plaintiff's work does not in itself direct us to a finding of infringement. As mentioned, the arrangement factor should be considered secondary and a finding of infringement would require some similarity in one of the three main categories.

### 2.6 Application

As mentioned from the outset, the proposed test is not terribly rigid in its application. There is no order in which the factors must be analysed. As this test is entirely fact based, the weight of the individual factors will vary from case to case.

In most cases, the first three factors (melody, harmony and rhythm) should be considered primary categories. The reason for this is because similarity in the secondary categories (technological effects/sounds and arrangement) should usually necessitate some form of similarity in the primary categories.

To draw on an earlier example, use of the Edge's guitar tone in "Where the Streets Have No Name" in an entirely different melody and rhythm may be fair game. By copying the effect, the defendant simply makes it more difficult to assert a lack of similarity. However, if the melody (or the musical context as a whole) is completely different, a finding of infringement should not follow from the copying of the technological effect alone.

The same reasoning goes for arrangement. The small scope analysis under the arrangement factor demands that we identify the occurrence of melodic and harmonic motives throughout the composition. If the defendant work's melodic or harmonic motives are entirely different from the plaintiff's from a compositional standpoint but they happen to recur at more or less the same place in their respective compositions, no finding of infringement should follow. The pattern of recurrence of those motives, while important and often influential is not as significant as the motives themselves. As in the case of technological effects, if there is undeniable similarity under the arrangement factor, the burden on the defendant to distinguish the primary factors is elevated.

There is no predetermined minimum threshold of similarity under the proposed test. Whether the level of similarity in the defendant's work amounts to plagiarism is for the trier of fact to decide on a case by case basis. Infringement may be found due to a high degree of similarity under one factor, a moderate degree of similarity under three factors or any other conclusion reached by the trier of fact. This lack of rigidity will allow for the trier of fact to make a reasonable and informed decision in all cases without the imposition of a set "similarity threshold."

With this minimal instruction and competent expert testimony, the trier of fact should feel secure in deciding on illicit copying knowing that they are basing their subjective judgement on objective criteria rather than relying solely on their untrained ears.

## Conclusion

No test to date has dominated above all others. Despite the importance of the 2<sup>nd</sup> and 9<sup>th</sup> Circuit tests from a geographical perspective, neither has successfully won over the other and other Circuits do not seem to have made a general endorsement of either test.

Both the *Arnstein* and *Krofft* tests suffer from the same fatal flaws: The application of the audience test and the disallowing of expert testimony at the most crucial moment of their respective analyses. The *Krofft* test fails on other grounds like a questionable application of the idea-expression dichotomy.

It is this author's strong opinion that music plagiarism litigation is crying out for an analytical test to replace the misguided application of the audience test. The choice of analytical test is an important one. It should not be overly simplified as in Learned Hand's comparative method; nor should it be overly nuanced and complex, like the La Rue test.

It is the author's belief that the proposed test strikes a balance in this regard. It is not too simple, taking careful consideration of five categories of criteria. At the same time, it is not too complex requiring any expert qualified to testify to have an intimate knowledge of Professor Jan La Rue's book.

The proposed test's lack of rigidity with reference to methodology is appealing in that any competent expert should be able to acquaint themselves with the test and subsequently conduct a full and conclusive analysis of the compositions in question. So long as all relevant factors are considered separately and in relation to one another in the small, medium and large context, the methodological prescriptions of the test have been met. ■

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2. *Copyright Act* (1976), 17 USC, Pub L 94-553 (Oct 19, 1976).

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2. *Baxter v. MCA, Inc.*, 812 F2d 421 (9<sup>th</sup> Cir 1987), cert. denied, 108 S Ct 346 (1987).
3. *Bright Tunes Music Corp. v. Harrisongs Music, Ltd.*, 420 F. Supp. 177, 180 (S.D.N.Y. 1976).
4. *Cholvin v. B. & F. Music Co.*, 253 F2d 102,103 (7<sup>th</sup> Cir 1958).
5. *Daly v. Palmer*, 6 F Cas 1132 (CCSDNY 1868) (No. 3552).
6. *Dun v. Lumbermen's Credit Ass'n*, 144 F 83 (7<sup>th</sup> Cir 1908).
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10. *Haas v. Leo Feist, Inc.*, 234 F 105 (SDNY 1916).
11. *Heim v. Universal Pictures Co.*, 154 F2d 480, 487-88 (2<sup>nd</sup> Cir 1946).
12. *Litchfield v. Spielberg*, 736 F2d 1352, 1357 (9<sup>th</sup> Cir 1984), cert. denied, 470 US 1052 (1985).
13. *Marks v. Leo Feist, Inc.*, 290 F 959 (2<sup>nd</sup> Cir 1923).
14. *Nichols v. Universal Pictures Corp.*, 45 F2d 119 (2<sup>nd</sup> Cir), cert denied, 282 U.S. 902 (1930).

15. *Schultz v. Holmes*, 264 F2d 942, 943 (9<sup>th</sup> Cir 1959).
16. *Selle v. Gibb*, 741 F2d 896 (7<sup>th</sup> Cir 1984).
17. *Swirsky v. Carey*, 376 F3d 841 (9<sup>th</sup> Cir 2004).
18. *Wihtol v. Wells*, 231 F2d 550, 553 (7<sup>th</sup> Cir 1956).

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12. Michelle V. Francis, *Musical Copyright Infringement: The Replacement of Arnstein v. Porter - A More Comprehensive Use of Expert Testimony and the Implementation of an "Actual Audience" Test*, 17 Pepp L Rev 493 1989-1990.
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14. Raphael Metzger, *Name That Tune: A Proposal For An Intrinsic Test Of Musical Plagiarism*, Loyola Entertainment Law Journal vol 5 p.61-109 (1985).
- 3 290 F 959 (2<sup>nd</sup> Cir 1923).
- 4 Ibid at 960.
- 5 Raphael Metzger, *Name That Tune: A Proposal For An Intrinsic Test Of Musical Plagiarism*, Loyola Entertainment Law Journal vol 5 p.61-109 (1985).
- 6 Melvin Nimmer, *Inroads on Copyright Protection*, 4 Copyright L Symp (ASCAP) 2, 8 (1952).
- 7 Supra note 5 at 72.
- 8 See *Dun v. Lumbermen's Credit Ass'n*, 144 F 83 (7<sup>th</sup> Cir 1908).
- 9 234 F 105 (SDNY 1916).
- 10 Once elevated to the 2<sup>nd</sup> Circuit Court of Appeals, it seems Learned Hand began to apply another test in favour of the derivation test. See *Metzger* at 78.
- 11 Supra note 5 at 75.
- 12 Supra note 5 at 77.
- 13 "Intervallic relations" refers to the distance from one note in the melody to the next adjacent note.
- 14 This point is easily made by examining any tonal instrument against a purely percussive instrument. When one plays a clave (Latin percussion instrument consisting of two blocks of wood) a rhythm is produced by the sheer attack. The same is the case when a saxophone begins to play. The difference is that the attacks of the saxophone are pitched and therefore create melody along with the rhythmic flow.
- 15 298 F 145 (SDNY 1924).
- 16 An "ostinato" is a pattern rhythmic or melodic that is repeated exactly, usually for the entire duration of a song. Use of ostinato is prevalent in many styles of music including Pop, Rock, Latin and Jazz.
- 17 Supra note 5 at 78.
- 18 Ibid.
- 19 Mark Avsec, "nonconventional" *Musical Analysis and "disguised" infringement: Clever Musical Tricks To Divide The Wealth Of Tin Pan Alley*, 52 Clev. St. L. Rev. 339 2004-2005 at 348.
- 20 *Daly v. Palmer*, 6 F Cas 1132 (CCSDNY 1868) (No. 3552).
- 21 See Paul Holtzmuller, *Current Tests of Similarity in Infringement Proceedings*, 10 Wm & Mary L Rev 186, 194 (1968).
- 22 In addition to American copyright experts, see Harold Fox, *Evidence of Plagiarism in the Law of Copyright*, 6 U Toronto LJ 414, 417 (1946).
- 23 154 F2d 464 (2<sup>nd</sup> Cir 1946).
- 24 Ibid at 468.
- 25 Ibid at 476.
- 26 Ibid at 476.
- 27 See *Wihtol v. Wells*, 231 F2d 550, 553 (7<sup>th</sup> Cir 1956).
- 28 See *Heim v. Universal Pictures Co.*, 154 F2d 480, 488 (2<sup>nd</sup> Cir 1946); *Schultz v. Holmes*, 264 F2d 942, 943 (9<sup>th</sup> Cir 1959); *Cholvin v. B. & F. Music Co.*, 253 F2d 102,103 (7<sup>th</sup> Cir 1958).
- 29 Supra note 23 at para 4.

## Endnotes

- 1 Though musical works have been protected by copyright for well over a century, this time frame pales in comparison with the entirety of the recorded history of music. While this is the subject of an entirely different paper, it stands to reason that the inclusion of music as intellectual property was instrumental in changing the way composers viewed their creations.
- 2 While it would require codification, there is nothing on the conceptual level preventing the principles of this test from being applied in a civil law context.

- 30 Michelle V. Francis, *Musical Copyright Infringement: The Replacement of Arnstein v. Porter - A More Comprehensive Use of Expert Testimony and the Implementation of an "Actual Audience" Test*, 17 Pepp L Rev 493 1989-1990 at 507.
- 31 And in any event, these are not the composers taking legal action over copyright infringement.
- 32 *Selle v. Gibb*, 741 F2d 896 (7<sup>th</sup> Cir 1984).
- 33 See *Ferguson v. National Broadcasting Co.*, 584 F2d 111, 113 (5<sup>th</sup> Cir 1978); *Heim v. Universal Pictures Co.*, 154 F2d 480, 487-88 (2<sup>nd</sup> Cir 1946); *Evans v. Wallace Berrie & Co.*, 681 F Supp 813 (SD Fla 1988).
- 34 Jeffrey G. Sherman, *Musical Copyright Infringement: the Requirement of Substantial Similarity*, 22 Copyright L Symp (ASCAP) 81, 83- 98 (1977)).
- 35 Supra note 23 at para 4.
- 36 See *Théberge v. Galerie d'Art du Petit Champlain Inc.* [2002] 2 SCR, 336 at para 12: "Generally speaking, Canadian copyright law has traditionally been more concerned with economic than moral rights." The Court goes on to explain that this perspective is derived from the treatment of Copyright in the UK and other common law jurisdictions.
- 37 17 USC § 302.
- 38 45 F2d 119 (2<sup>nd</sup> Cir), cert denied, 282 U.S. 902 (1930).
- 39 Supra note 38 at 123.
- 40 Miah Rosenberg, *Do You Hear What I Hear? Expert Testimony in Music Infringement Cases in the 9<sup>th</sup> Circuit*, 39 UC Davis L Rev 1671 2005-2006 at 1675.
- 41 Ibid.
- 42 *Federal Rules of Evidence* § 703.
- 43 See Christine Lepera & Michael Manuelian, *Music Plagiarism: Notes on Preparing for Trial*, 17 Ent & Sport L 10, 11 (1999).
- 44 In a music history class attended by the author, Ronald Headland (author, concert pianist, painter and music teacher at Vanier College in Montreal, Quebec, Canada) once said that "music is the most romantic of art forms because it is the farthest removed from reality".
- 45 See Daniel J. Levitin, *This is Your Brain on Music*, (New York: Penguin Group, 2006).
- 46 See Christopher Brett Jaeger, "Does That Sound Familiar?": *Creators' Liability for Unconscious Copyright Infringement*, Vand L Rev 1904 2008 at 1905.
- "On the whole, my belief is that, in composing the accompaniment to the refrain of 'Kalua,' Mr. Kern must have followed, probably unconsciously, what he had certainly often heard only a short time before."
- 47 420 F. Supp. 177, 180 (S.D.N.Y. 1976).
- 48 Ibid at 180-181.
- 49 David Vaver, *Intellectual Property Law*, (Concord: Irwin Law, 1997) at 176.
- 50 In jurisdictions like Canada that have "moral rights", the right to be associated (or not to be associated) with the copyrighted work is protected. It should be noted that this comes from the French *droit d'auteur* tradition and not common law copyright. See *Copyright Act* (RSC, 1985, c C-42) sections 14.1.
- 51 Supra note 40 at 1674.
- 52 Ibid.
- 53 812 F2d 421 (9<sup>th</sup> Cir 1987), cert. denied, 108 S Ct 346 (1987).
- 54 Aaron Keyt, *An Improved Framework for Music Plagiarism Litigation*, California L Rev, Vol. 76, No. 2 (Mar., 1988), pp. 421-464 at 442.
- 55 *Swirsky v. Carey*, 376 F3d 841 (9<sup>th</sup> Cir 2004).
- 56 Supra note 40 at 1679.
- 57 Supra note 23 at para 4.
- 58 Copyright does not protect ideas, only tangible expressions. See *Vaver* supra note 49 at 23.
- 59 17 U.S.C. § 102(b).
- 60 The title of the film is a double entendre as a fantasia (or fantasy) is a form of musical composition.
- 61 *Litchfield v. Spielberg*, 736 F2d 1352, 1357 (9<sup>th</sup> Cir 1984), cert. denied, 470 US 1052 (1985).
- 62 Supra note 5 at 97.
- 63 Ibid.
- 64 See Jan La Rue, *Guidelines for Style Analysis*, (New York: W. W. Norton, 1970).
- 65 The rhythmic attack of the harmony part should not be mistaken for the "harmonic rhythm". This distinction will be clarified in section 2.2 of this part.
- 66 Expressed as follows: 
- 67 Structure tones are the important notes in the melody that are highlighted by the accompanying harmony.
- 68 There exist a multitude of chords that consist of more than three notes. For the sake of simplicity the explanation will refer to triads but applies to voicing of all chords.
- 69 Delay refers to a common effect used by guitar players by which everything they play gets played back in a time delayed fashion. While this description may not sound creative, the massive variety in delay options and modifying parameters sometimes renders the use of this effect as an instrument in itself.
- 70 Reverb is an effect that takes a signal and simulates the reverberation of that signal in a given room or space. For example, "Chamber reverb" simulates the signal in rooms of different sizes such as halls, cathedrals or tiled rooms.

- 71 For a comprehensive guide of Richard Wrights keyboards and other instruments see: <http://sparebricks.fika.org/sbzine28/WrightGear-rev156.pdf>.
- 72 The term “timber” refers to the tone of an instrument. In other words, timber is what makes a guitar sound like a guitar and as saxophone sound like a saxophone.
- 73 The term “changes” refers to the chord changes written over the melody on jazz lead sheets marked by letters and symbols.
- 74 Each letter represents a melodic motive. In this example there are two distinct motives (X and Y) and one variation (Y’).
- 75 The roman numerals are a tool used in harmonic analysis to denote the position of a chord in a given key.



## 2013 Edward F. Langs Writing Award

### Essay Competition Rules

1. Awards will be given to up to three student essays, which in the opinion of the judges make the most significant contribution to the knowledge and understanding of information technology law. Factors to be taken into consideration include: originality; timeliness of the subject; depth of research; accuracy; readability; and the potential for impact on the law.
2. Essay must be original, deemed to be of publishing quality, and must not have been submitted to any other contest within the previous 12 months.
3. Essay must be typed, double spaced, at least ten pages in length, must contain proper citations listed as either end-notes or footnotes, and must have left, right, top, and bottom margins of one inch.
4. Essay must include the submitter’s name, email address, mailing address, telephone number, and school attended.
5. A total of \$1,500 in US dollars shall be divided between the award winning essays, and all rights to award winning essays shall become the property of the State Bar of Michigan.
6. The Information Technology Section of the State Bar of Michigan reserves the right to make editorial changes, and to publish award winning essays in the Section’s newsletter, the *Michigan IT Lawyer*.
7. Essay must be submitted as a Microsoft Word document, postmarked by June 30, 2013, and emailed to [dsyrowik@brookskushman.com](mailto:dsyrowik@brookskushman.com).



# Recent Developments in Information Technology Law

By David R. Syrowik, Brooks Kushman P.C.

## TRADEMARKS – Case Law – U.S. Supreme Court

As reported at 85 BNA's PTCJ 341, on January 9, 2013, the U.S. Supreme Court affirmed, in a unanimous ruling, that Nike Inc.'s covenant not to sue a competitor for trademark infringement, delivered after Nike has filed an infringement lawsuit against the competitor and even then only after the competitor has filed a counterclaim seeking a cancellation of Nike's mark, divested the federal district court of Article III jurisdiction. *Already LLC v. Nike Inc.*

## PATENTS – Case Law – U.S. Courts of Appeal

As reported at 85 BNA's PTCJ 36, on November 5, 2012, the U.S. Court of Appeals for the Federal Circuit ruled that automated voting machine makers do not infringe a patent that was applied for a month after the Florida paper ballots controversy in 2000. The court ruled that an article in an online journal is "publicly accessible" as qualifying prior art, even if commercial search engines are unaware of it, so long as the journal is known by persons of skill in the art and it has its own search tool. *Voter Verified Inc. v. Premier Election Solutions Inc.*

As reported at 85 BNA's PTCJ 131, on November 21, 2012, the U.S. Court of Appeals for the Federal Circuit ruled that a patent system claim is indefinite for failure to provide corresponding hardware, code, or algorithm to support a mean "for processing" limitation. *ePlus Inc. v. Lawson Software Inc.*

As reported at 85 BNA's PTCJ 409, on January 22, 2013, the U.S. Court of Appeals for the Federal Circuit ruled that a pre-internet system for computer-based shopping rendered internet e-commerce claims obvious. Reversing a lower court's validity ruling, the appeals court takes elements of the CompuServe Mall, which existed in the late 1980s, and adds updates based on World Wide Web conventions that would be obvious to a person of skill in computer science. *Soverain Software v. Newegg.*

As reported at 85 BNA's PTCJ 410, on January 16, 2013, the U.S. Court of Appeals for the Federal Circuit ruled that the owner of a website applet-delivery patent must live with its choice "to pursue a theory that allowed it to accuse a larger number of defendants," and so cannot modify its arguments based on a claim construction that defeated its infringement complaint. The court also affirms a decision not to allow an amended complaint

in light of a "hardly unanticipated" claim construction. *Parallel Networks v. Abercrombie & Fitch.*

As reported at 105 USPQ2d 1257, on November 17, 2012, the U.S. Court of Appeals in the Federal Circuit affirmed that grant of summary judgment that defendant software providers do not infringe certain claims of patent for global paging system using internet since plaintiff has not produced sufficient evidence that accused paging systems are even capable of meeting disputed limitations of claims in question; however, summary judgment of noninfringement as to remaining asserted claims is vacated and remanded, since district court based judgment on its finding that claims require multiple actors, but claims do not present issue of "joint" or "divided" infringement. *Technology Patents LLC v. T-Mobile (UK) Ltd.*

## COPYRIGHTS – Case Law – U.S. Courts of Appeal

As reported at 85 BNA's PTCJ 509, on February 7, 2013, the U.S. Court of Appeals for the Eleventh Circuit ruled that an insurance policy that excludes coverage for advertising claims based on the use of another's name or product in the insured party's email address, domain name, or metatags does not preclude coverage for a copyright infringement claim based on a website. *St. Luke's Cataract and Laser Institute v. Zurich American Insurance.*

## COPYRIGHTS/CRIMINAL – Case Law – U.S. Courts of Appeal

As reported at 85 BNA's PTCJ 99, on November 9, 2012, the U.S. Court of Appeals for the District of Columbia ruled that the district court erred when it ordered a defendant who sold pirated software on eBay to pay as restitution the defendant's profit instead of the victim's lost profits. *United States v. Fair.*

## TRADEMARKS – Case Law – U.S. Courts of Appeal

As reported at 104 USPQ2d 2029, on October 30, 2012, the U.S. Court of Appeals for the Fifth Circuit ruled that plaintiff sufficiently pleaded as-applied challenge to Tex. Lab. Code § 419.002, which prohibits parties from using, for advertising purposes, term "Texas" in combination with "workers' compensation" or "workers' comp," since Texas government has not shown that plaintiff's "texas-workerscomplaw.com" domain name is inherently misleading, and domain name is entitled to

some First Amendment protection. *Gibson v. Texas Department of Insurance*.

### TRADEMARKS/UNFAIR TRADE PRACTICES – Case Law – U.S. Courts of Appeal

As reported at 104 USPQ2d 1509, on September 4, 2012, the U.S. Court of Appeals for the First Circuit ruled that defendant's computer mouse was not "derived from" plaintiff's design in violation of parties nondisclosure agreement; "derivation" requires appropriation of some novel property of plaintiff's products. *Contour Design Inc. v. Chance Mold Steel Co.*

### COMPUTER FRAUD AND ABUSE ACT (CFAA) – Case Law – U.S. Courts of Appeal

As reported at 676 F.3d 854, on April 10, 2012, the U.S. Court of Appeals for the Ninth Circuit, in an *en banc* decision, adopted a narrow reading of the Computer Fraud and Abuse Act, finding that violating an employer computer policy or a website's terms of service is not a violation of federal law. *United States v. Nosal*.

As reported at 687 F.3d 199, on July 26, 2012, the U.S. Court of Appeals for the Fourth Circuit, sided with the Ninth Circuit in deciding that the Computer Fraud and Abuse Act does not apply to employees and former employees who were authorized to access the employer's electronic information. The decision stands in contrast to the position taken by the Seventh Circuit in *Int'l Airport Ctrs., LLC v. Citrin*, 440 F.3d 418, 420-21 (7<sup>th</sup> Cir. 2006). The Fourth Circuit rejects the interpretation of the CFAA taken by the Seventh Circuit, which interprets the CFAA much more broadly. The Seventh Circuit concludes that an employee's misappropriation of electronic information from his employer is a breach of the employee's duty of loyalty that immediately terminates his agency relationship and with it his authority to access the laptop, because the only basis of his authority had been that relationship. *WEC Carolina Energy Solutions LLC v. Miller*.

### TRADE SECRETS/MISAPPROPRIATION – Case Law – U.S. Courts of Appeal

As reported at 85 BNA's PTCJ 472, on February 4, 2013, the U.S. Court of Appeals for the Sixth Circuit ruled that evidence that two engineers secretly took pictures of some of Goodyear's equipment—which the company that employed the engineers is trying to recreate—is sufficient to sustain the engineers' criminal convictions under the Economic Espionage Act of 1996, 18 U.S.C. § 1832. The defendants, who were visiting Goodyear's

plant in order to do repair work on some machines, took the photographs using a cell phone and did so only after they had been left alone by Goodyear employees. *United States v. Howley*.

As reported at 105 USPQ2d 1500, on December 26, 2012, the U.S. Court of Appeals for the Second Circuit ruled that Connecticut's long-arm statute permits exercise of jurisdiction over former employee of plaintiff who sent, via e-mail, plaintiff's allegedly confidential and proprietary information from her business account to her personal account, even though defendant physically interacted only with computers in Canada when sending e-mail at issue. *MacDermid Inc. v. Deiter*.

### PATENTS – Case Law – U.S. District Courts

As reported at 85 BNA's PTCJ 107, on November 6, 2012, a jury in proceedings in the U.S. District Court for the Eastern District of Virginia finds Google and AOL infringe ad tracking patents 6,314,420 and 6,775,664, and awards firm \$30 million. *IP Engine Inc. v. AOL Inc.*

As reported at 85 BNA's PTCJ 348, on January 3, 2013, the U.S. District Court for the District of Columbia ruled that *Mayo v. Prometheus* had no effect on whether a computer-based medical expert system is patent eligible, rejecting a patent owner's motion for reconsideration of her earlier decision in the case. *SmartGene v. Advanced Biological Laboratories*.

As reported at 85 BNA's PTCJ 316, on December 17, 2012, the U.S. District Court for the Northern District of California ruled that new evidence proffered by Apple to justify a request for a permanent injunction against Samsung smartphones is insufficient. Following a jury verdict favoring Apple, the court denies Apple's motion for a permanent injunction and again finds lacking the company's evidence intended to show a causal nexus between Samsung's infringement and consumer demand. According to the court, prior rulings set the standard that Apple bears the burden of showing that any identified sales of infringing Samsung phones occurred as a result of Samsung's incorporation of the infringing feature. *Apple Inc. v. Samsung Electronics Co.*

As reported at 85 BNA's PTCJ 441, on January 29, 2013, the U.S. District Court for the Western District of California ruled that a jury's \$1 billion damages award against Samsung for infringing Apple Inc.'s smartphone patents is supported by the record and therefore Samsung is not entitled to either a judgment as a matter of law to overturn the verdict, or to new trial. The court does, however, grant Samsung judgment as a matter of law that its patent infringement is not willful. *Apple v. Samsung Electronics*.

### PATENTS/ANTITRUST – Case Law – U.S. District Courts

As reported at 85 BNA's PTCJ 458, on January 24, 2013, in the U.S. District Court for the Northern District of California a patent troll suffers dismissal of Sherman Act claims of android device makers' boycott. *Cascades Computer Innovation LLC v. RPX Corp.*

### COPYRIGHTS – Case Law – U.S. District Courts

As reported at 85 BNA's PTCJ 19, on October 24, 2012, the U.S. District Court for the District of Arizona ruled that a website operator that encouraged visitors to post negative reviews on a rival gripe site is not contributorily liable for those users' alleged infringement of the rival site's copyrights. *Xcentric Ventures LLC v. Medioplex Ltd.*

As reported at 85 BNA's PTCJ 189, on November 30, 2012, the U.S. District Court for the Southern District of New York ruled that pornography file-sharing defendant allowed to proceed unnamed due to privacy issues. *Malibu Media LLC v. Doe.*

As reported at 85 BNA's PTCJ 305, on December 27, 2012, the U.S. District Court for the Central District of California ruled that a service that purportedly allows subscribers to stream broadcast television content to their computers and mobile devices via mini-antennas infringes content industry copyrights. The opinion is in tension with a New York district court's ruling in July that found a similar device non-infringing. *Fox Television Stations Inc. v. BarryDriller Content Systems PLC.*

As reported at 104 USPQ2d 1709, on November 5, 2012, the U.S. District Court for the Southern District of New York granted default judgment to plaintiff alleging illegal reproduction and distribution of copyrighted "For Dummies" books over internet using "BitTorrent" file-sharing protocol against defendants who have not entered appearance in case, and is awarded \$3,000 in statutory damages from each defendant. *John Wiley & Sons, Inc. v. Williams.*

As reported at 104 USPQ2d 1697, on October 23, 2012, the U.S. District Court for the Southern District of Florida stated that plaintiff's permissive joinder of 50 Doe defendants, in action alleging illegal reproduction and distribution of copyrighted video game over internet using "BitTorrent" file-sharing protocol, is improper under Fed.R.Civ.P. 20(a)(2); defendants' decision to obtain BitTorrent software and download same copyrighted work does not, in and of itself, constitute "same transaction, occurrence, or series of transactions or occurrences." *Aerosoft GMBH v. Does 1-50.*

As reported at 104 USPQ2d 1659, on October 10, 2012, the U.S. District Court for the Southern District of New York ruled

that plaintiff domestic associational organizations do not have statutory standing to bring copyright infringement action, on behalf of their members, challenging universities' agreements with internet search engine that allow search engine to create digital copies of works in universities' libraries, since case law interpreting 17 U.S.C. § 501(b) indicates that Copyright Act does not permit copyright holders to have others sue on their behalf. *Authors Guild Inc. v. HathiTrust.*

As reported at 104 USPQ2d 1856, on October 23, 2012, the U.S. District Court for the Southern District of New York, ruled that defendant's state-law claim alleging conversion of website is preempted by federal copyright law, since conversion claims are routinely held to be not quantitatively different from copyright claims, since defendant, by alleging that she "created" website, including its "design" and "distinctive look," and that plaintiffs and third-party defendant exercised "unauthorized dominion" over work and presented it to public as their own, asserts claim that falls squarely within general ambit of federal copyright law, and since claim does not contain "extra element" that would protect conversion claim from preemption. *Ardis Health LLC v. Nankivell.*

As reported at 105 USPQ2d 1089, on November 30, 2012, the U.S. District Court for the Western District of Washington ruled that plaintiff has failed to state plausible claim that defendant online retailer is vicariously liable for copyright infringement allegedly committed by participants in defendant's "associates program" since vicarious liability requires some version of agency relationship, and plaintiff has not stated plausible claim that associates are not "solely responsible" for content of their websites, as stated in defendant's "associates agreement." *Routt v. Amazon.com Inc.*

As reported at 85 BNA's PTCJ 516, on February 7, 2013, the U.S. District Court for the Central District of California ruled that unsupported BitTorrent pleadings provoke sanctions hearing for plaintiff's counsel. *Ingenuity 13 L.L.C. v. Doe.*

As reported at 85 BNA's PTCJ 416, on January 14, 2013, the U.S. District Court for the Southern District of New York ruled that the terms of service of Twitter's microblogging service do not support the argument that posting images on Twitter grants third parties an unrestricted license to re-use those images. *Agence France-Presse v. Morel.*

As reported at 105 USPQ2d 1541, on November 7, 2012, the U.S. District Court for the Central District of California ruled that plaintiff owners of copyrights in network television programming have failed to establish likelihood of success on merits of their claims that defendant satellite television service is liable for direct, contributory, or vicarious infringement of plaintiffs' copyrights by making available to subscribers set-top boxes that can

record broadcast network programming, since evidence does not suggest that consumers use recording feature for anything other than time-shifting in their homes or on mobile devices, which has been held to be legitimate, noninfringing practice. *Fox Broadcasting Co. v. Dish Network LLC*.

As reported at 105 USPQ2d 1490, on January 7, 2013, the U.S. District Court for the Northern District of California ruled that plaintiff, in action in which prior complaints alleged only negligence against defendant, is denied leave to file second amended complaint alleging direct and contributory infringement against same defendant by means of online file sharing using “BitTorrent” transfer protocol. *AF Holdings LLC v. Doe*.

### **COPYRIGHT/CRIMINAL – Case Law – U.S. District Courts**

As reported at 85 BNA’s PTCJ 43, on October 31, 2012, the U.S. Attorney acting in the U.S. District Court for the Northern District of California said that a Northern California man is sentenced to 27 months in prison and ordered to pay \$200,000 restitution after his guilty plea to criminal copyright infringement in a case that resulted in the seizure of more than 20,000 counterfeit DVDs. *United States v. Blanco*.

As reported at 85 BNA’s PTCJ 144, on November 19, 2012, a Baltimore man pleaded guilty in U.S. District Court for the District of Maryland, to mass reproduction and distribution of popular software programs. *United States v. Sheikh*.

As reported at 85 BNA’s PTCJ 248, on December 3, 2012, the U.S. District Court for the Eastern District of Virginia sentenced a website owner/operator to 11 months for selling copies of pirated software. *United States v. Newsome*.

### **TRADEMARKS – Case Law – U.S. District Courts**

As reported at 85 BNA’s PTCJ 17, on October 25, 2012, the U.S. District Court for the Eastern District of Pennsylvania ruled that an online educational services company’s purchase of a competitor’s marks to trigger web advertisements was not infringing. *CollegeSource Inc. v. AcademyOne Inc.*

As reported at 85 BNA’s PTCJ 480, on January 31, 2013, the U.S. District Court for the Southern District of California ruled that a business that used a competitor’s mark in key word ads, indicating that the sponsored result was “related to” the user’s search terms, likely did not infringe the competitor’s mark. *AK Metals v. Norman Industrial Materials*.

As reported at 85 BNA’s PTCJ 418, on January 16, 2013, the U.S. District Court for the Northern District of Illinois ruled that the sale of counterfeit Ugg products through domain names in-

corporating the mark is likely to cause consumer confusion and irreparable harm to the brand. *Deckers Outdoor v. Doe*.

As reported at 85 BNA’s PTCJ 70, on November 6, 2012, the U.S. District Court for the Northern District of California ruled that the developer of the popular Angry Birds video game failed to meet the heightened threshold of demonstrating in its trademark and copyright infringement lawsuit to win an ex parte temporary restraining order against alleged counterfeiters of Angry Birds merchandise. *Rovio Entertainment Ltd. v. Royal Plush Toys Inc.*

As reported at 85 BNA’s PTCJ 69, on November 6, 2012, the U.S. District Court for the Southern District of Texas ruled that a complaint by the maker of Tempu-Pedic “memory foam” mattresses and pillows regarding a competitor’s use of its trademarks in its website was sufficient to adequately notify the defendant of the claims and to allow it to craft an answer. *Temper-Pedic International Inc. v. Angel Beds LLC*.

As reported at 85 BNA’s PTCJ 517, on February 5, 2013, the U.S. District Court for the Central District of Illinois ruled that a Bank’s locale in trademark dispute matters despite internet’s potential to widen market. *Prosperity Bancshares Inc. v. Town and Country Financial Corp.*

As reported at 85 BNA’s PTCJ 137, on November 21, 2012, the U.S. District Court for the Northern District of California ruled that owner of iCall mark for VoIP services fails to enjoin competitor’s use of WiCall mark. *iCall Inc. v. Tribair Inc.*

As reported at 104 USPQ2d 1480, on October 17, 2012, the U.S. District Court for the Eastern District of California granted summary judgment to defendant internet search engine provider on Lanham Act and state-law claims based on defendant’s use of plaintiff’s “Styrotrim” mark as keyword that plaintiff’s competitors may bid on to secure “sponsored link” that appears on search results page when users search for “Styrotrim,” since plaintiff has proffered no evidence demonstrating that any likelihood-of-confusion factors weigh in his favor. *Jurin v. Google Inc.*

As reported at 85 BNA’s PTCJ 521, on February 6, 2013, the U.S. District Court for the Western District of Pennsylvania ruled that a cybersquatting infringer loses twitter handle by default. *Pair Networks Inc v. Soon*.

### **TRADEMARK/CYBERSQUATTING – Case Law – U.S. District Courts**

As reported at 85 BNA’s PTCJ 290, on November 30, 2012, the U.S. District Court for the Southern District of Florida issued a preliminary injunction compelling disclosures from proxies in a mass cybersquatting case. *Louis Vuitton Malletier S.A. v. 100Wholesale.com*.

As reported at 105 USPQ2d 1304, on November 30, 2012, the U.S. District Court for the District of Nevada ruled that plaintiff claiming rights in term “isanyoneup” as trademark for its campaign to stop “bullying behavior” is likely to succeed on merits of claim that defendants’ use of term “isanyoneup,” in domain names for websites where they publish “involuntary pornography,” violates Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d), and plaintiff is granted temporary restraining order prohibiting defendants from using term in domain names for their sites. *ViaView Inc. v. Blue Mist Media*.

### TRADEMARKS/RIGHT OF PUBLICITY – Case Law – U.S. District Courts

As reported at 104 USPQ2d 1630, on August 17, 2012, the U.S. District Court for the Northern District of California denied preliminary approval to parties’ agreement to settle class action, alleging violations of California law stemming from use of names and/or likenesses of members of defendant social networking website to promote products and services through “Sponsored Stories” advertising practice, since provisions awarding \$10 million cy pres payment to organizations involved in internet privacy issues, and permitting plaintiffs to apply for up to \$10 million in attorneys’ fees without objection by defendant, raise serious concerns. *Fraleigh v. Facebook Inc.*

### LANHAM ACT/FALSE ADVERTISING – Case Law – U.S. District Courts

As reported at 85 BNA’s PTCJ 349, on January 2, 2013, the U.S. District Court for the Northern District of California, ruled that Apple Inc. cannot proceed with a false advertising claim targeting Amazon’s use of the name “appstore,” *Apple v. Amazon.com*.

As reported at 85 BNA’s PTCJ 386, on January 2, 2013, the U.S. District Court for the District of Maryland, ruled that Amazon’s designation of a rival Kindle accessories maker’s products as “unavailable” may generate false advertising liability under the Lanham Act. *M-Edge Accessories v. Amazon.com*.

### TRADE SECRETS – Case Law – U.S. District Courts

As reported at 85 BNA’s PTCJ 483, on January 31, 2013, the U.S. District Court for the Northern District of California ruled that a U.S. patent application on firewall technology contained trade secrets at least until the patent application was published. *Wang v. Palo Alto Networks Inc.*

### TRADE SECRETS/CRIMINAL – Case Law – U.S. District Courts

As reported at 84 BNA’s PTCJ 920, on September 19, 2012, in the U.S. District Court for the Northern District of Illinois, the Justice Department announced that Chunlai Yang, an ex-software engineer at CME Group Inc. pled guilty to two counts of trade secret theft based on his illicit downloading of CME trade secrets and source code relating to CME’s “Globex” trading platform, which he intended to use to develop a trading platform for the Zhangjiagang China chemical electronic trading exchange. Yang now faces a maximum of 10 years in prison and a \$250,000 fine for each count. *United States v. Yang*.

### TRADEMARK – U.S. Patent and Trademark Office

As reported at 85 BNA’s PTCJ 287, on December 11, 2012, the Trademark Trial and Appeal Board ruled that a YouTube screen shot of a trademark does not show “use in commerce” for registration purposes. *In re Rogowski*.

As reported at 85 BNA’s PTCJ 415, on January 17, 2013, the Trademark Trial and Appeal Board ruled that a sequence of “chirp” sounds that play when a cell phone is placed on or taken off a battery charging device is not inherently distinctive, and thus the sound mark is not eligible for registration. The board notes that the battery chargers in fact emit chirp sounds in their normal course of operation. *In re Powermat*.

As reported at 105 USPQ2d 1298, on December 27, 2012, the Trademark Trial and Appeal Board granted summary judgment to opposer that its involved service mark “242242” is not merely descriptive of its search engine services for obtaining specific user-requested information, even though mark identifies short message services (i.e. SMS) number, used to send messages between mobile telephones, through which customers obtain opposer’s services, since SMS number does not identify ingredient, quality, characteristic, function, feature, purpose, or use of opposer’s services simply because it provides means of accessing those services. *ChaCha Search Inc. v. Grape Technology Group Inc.*

### State Courts – Massachusetts

As reported at 85 BNA’s PTCJ 14, on October 18, 2012, the Massachusetts Appeals Court ruled that a film producer’s use of a former Tiananmen Square protestor’s trademarks in metatags on its Tiananmen Square documentary’s website was not infringing. *Jenzabar Inc. v. Long Bow Group Inc.*

### State Legislation – Michigan

On December 27, 2012, Governor Snyder signed H.B. 5523 into law as Public Act 478 which prohibits requesting or requiring an employee, student or applicant to disclose a user name or password for a personal social media account. The law applies to employers and academic institutions. ■



## Publicly Available Websites for IT Lawyers

Following are some publicly available websites relating to varying aspects of information technology law practice. Some of these websites may require payment for certain services. Neither the State Bar of Michigan nor the IT Law Section endorses these websites, the providers of the website, or the goods or services offered in connection therewith. Rather these websites are provided for information purposes only and as possible useful tools for your law practice.

Please provide any feedback or recommendations for additional websites to [michael@gallo.us.com](mailto:michael@gallo.us.com).

### Legal Sites

- <http://copyrightlitigation.blogspot.com> – Copyright Litigation Blog.
- <http://www.udrpcommentaries.com> – UDRP Commentaries. Commentaries on Uniform Domain-Name Resolution Policy decisions.
- <http://www.mttlblog.org> – Blog by the Michigan Telecommunications and Technology Law Review (MTTLR). Founded in 1994, MTTLR was one of the first law journals to use interactive media to promote informed discourse about the interrelated legal, social, business, and public policy issues raised by emerging technologies.
- <http://www.wassom.com> – Discussion and commentary on the law of social and other new and emerging forms of expression. Authored by Brian D. Wassom, a commercial litigator in Southeast Michigan, whose practice focuses on copyright, trademark, publicity rights, media law, and related subject matter. ■