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Performer's Rights and Digital Sampling under U.S. and Japanese Law

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A year or two ago, one of my copyright students called to my attention a problem that seemed to him to pose unique difficulties for the copyright statute. The problem arises because of a technology called digital sampling. Digital sampling is a new threat to performers' rights that has grown out of the combination of digital recording technology with music synthesizer technology. This threat is a very recent one. Indeed, the digital sampling problem is so new that copyright lawyers haven't yet figured out how to think about it.

Digital Sampling

Digital recording technology enables one to record a sound and encode it digitally in computer memory, which can then reproduce the sound absolutely faithfully. A digital sample is a very short digital recording, only a few seconds long, that is analyzed and stored in the memory of a computer. Older synthesizer technology enabled a computer to create music from computer-generated sound waves, although the result sounded a little metallic. If you plug a digital sample of a sound into a synthesizer, though, you can create music that sounds as if it's being played by the person who made the sound you recorded. Manufacturers have created products called sampling keyboards that combine the two technologies. And, over the last year or two, music created by using digital samples along with synthesizer technology has been showing up as backup music on many commercially released records. It's easy to see why. Using samples is less expensive and less trouble than hiring real performers. Record producers are increasingly sampling the sounds of musicians they record to build up their libraries of sounds. And music created from these samples shows up on other recordings, and in the music for television programs or commercials, often without
Performers' Rights in the United States

Performers in the United States can seek protection under a variety of federal and state legal theories. The obvious place to start exploring the protection of performers' rights is the federal copyright statute. The U.S. copyright statute defines copyrightable subject matter very broadly. Performers' performances are entitled to copyright protection as soon as they are fixed in tangible form. Sound recordings are copyrightable; and the performers' performances are part of the original authorship that entitles sound recordings to copyright protection. Audiovisual works and films are copyrightable; and the performers' performances are part of the original authorship that entitles those works to copyright protection. The copyright statute gives authors very strong economic rights, including exclusive rights of reproduction, adaptation, distribution and public performance.

As a theoretical matter, then, United States copyright law could offer performers very strong economic rights in their performances. As a practical matter, however, performers can almost never claim rights under the copyright statute. The reason for this is our "work made for hire" doctrine. The United States probably has the most expansive work made for hire doctrine in the world. It provides that any work created by an employee in the course of her employment is a work made for hire, and that the employer is the work's legal author. Copyright in that work, then, vests in the employer upon fixation. The reason that performers can never claim rights under the copyright statute is that virtually all copyrightable works that embody performances are works made for hire.

Almost all sound recordings, films, and television programs made in the United States are made under contracts that expressly provide that the performers' contributions are works made for hire. The bottom line is that although the copyright statute gives the copyright owner the exclusive right to make reproductions of all copyrighted works, and the exclusive right to make public performances of copyrighted audiovisual works, the performer whose performance is embodied in these works is not the copyright owner and cannot exercise these exclusive rights.

Rights in Unfixed Performances: State Common Law

Federal statutory copyright does not vest in a work until the moment it is fixed in tangible form. There is no federal statutory copyright in performances that have not yet been fixed. Thus, federal law does not
protect the exclusive right to record a live performance. The only source for protection for unrecorded performances is the laws of the 50 states. Indeed, the federal copyright statute expressly preserves the power of the states to protect works that have not yet been fixed in tangible form. So far, however, few states have exercised that power. Only one state, the state of California, has a statute that gives protection to works that have not been fixed in tangible form. No cases have been decided under that statute. A handful of other states can be found that offered common law protection to unfixed works of authorship before the 1976 federal Copyright Act preempted state protection of fixed works and preserved state protection of unfixed works. In theory, such protection should remain available after the effective date of the 1976 Copyright Act. But, in the nearly 10 years since the 1976 Act took effect, no case has been reported in which plaintiff recovered for infringement of common law copyright in an unfixed work or performance. So although the possibility of state law protection of unfixed performances exists in theory, the right of first fixation has not yet received protection from state courts.

The Right of Publicity

Performers have another source of rights under state law. That source is the right of publicity. In the United States, the right of publicity protects a celebrity from misappropriation of her name or likeness for commercial purposes. The right of publicity has also been used by performers to protect their performances. In states that recognize the right of publicity, performers have a tool that will allow some of them to prevent the unauthorized commercial exploitation of their unfixed performances, either by reproduction or broadcast communication. Indeed, performers have succeeded in some courts in recovering not only for unauthorized use of their performances but also for unauthorized imitation of their performances. And courts have been tending to interpret the right of publicity with increasing breadth. Nonetheless, most courts require the claimed invasion of the right of publicity to involve a recognizable appropriation of a widely recognized feature of plaintiff's "identity."

Because the right of publicity is a creature of state law, it varies from state to state. Some states interpret it very broadly; others interpret it narrowly; and still others refuse to recognize it at all. The most vexing characteristic of the right of publicity is the wide variations in the scope of the doctrine among the several states.

Can the right of publicity be invoked by performers to protect the rights that they are unable to claim under the copyright act because they are employees for hire? The answer appears to be no. Courts have considered claims by celebrities that broadcasting of their performances by their employer and without their consent violates their right to publicity. Recently, the U.S. Court of Appeals for the Seventh Circuit held that so long as the performance of the employees was fixed in tangible form, the right of publicity claim was preempted by the federal copyright statute. The court reasoned that the right of publicity being asserted was equivalent to a right of public performance in performances that had been created and fixed within the context of the employment relationship. The copyright statute vests the right of public performance in the employer, and preempts laws under which the employee could claim ownership of essentially equivalent rights.

Section 43(a) of the Lanham Act

United States law has another source for protection of performers' rights that I want to mention briefly: it has assumed increasing importance in United States intellectual property law. That source is section 43(a) of the Lanham Act, a statutory section tucked in at the end of our federal trademark statute that courts have interpreted to establish a federal statutory tort of unfair competition. The gravamen of a cause of action under section 43(a) is that defendant has confused or misled the purchasing public about the nature or source of defendant's goods or services. Section 43(a) sometimes offers performers a remedy for claims that are not otherwise actionable. For example, Woody Allen's right of publicity suit against a Woody Allen lookalike was unsuccessful, but he prevailed against the lookalike in a claim based on section 43(a). In another case, the singer Charlie Rich successfully relied on section 43(a) to enjoin the re-release of a 10 year old sound recording of his performance with a current photograph of him on the record jacket. An advantage of section 43(a) is that it is part of a federal statute rather than a creature of state law, so it is immune from federal preemption.

I have briefly described four possible sources for performers' rights under United States law: the federal copyright statute, under which performers, as em-
ployees, have no rights; state common law copyright which, in theory, gives performers a right of first fixation and, in practice, does not appear to exist; the right of publicity, which offers performers a pastiche of inconsistent rights; and section 43(a), which offers performers who can prove public confusion the possibility of parasitic recovery based on the confusion. None of these legal doctrines was designed with performers’ rights in mind. Performers who seek protection under them find that the situations they complain of fit into these doctrines very poorly. For that reason, most performers have looked to the labor unions that represent them to secure through collective bargaining the rights that the law has failed to provide. The labor unions that represent performers are relatively weak, and have not been very successful in their attempts to negotiate stronger rights for their membership.

Performers’ Neighboring Rights in Japan

The situation in Japan is very different. The copyright law of Japan follows the model of many European nations; 2 copyright vests, without any formal requirements, in works of authorship within designated subject matter categories. Performers’ performances are not so designated and, thus, are not themselves subject matter entitled to copyright protection. Sound recordings that embody performances of music are not copyrightable. Films are entitled to copyright, but the authorship embodied in a film or audiovisual work includes only the production, direction, art direction and photography, and not the performers’ performances.

Japanese law protects performers by giving them “neighboring rights” (chosaku-rinsetsuken) that are independent of and different from the copyright granted to authors. 6 The Japanese neighboring rights were modeled on the provisions of the Rome Convention of 1961, 7 and give performers very strong rights in their unfixed, live performances, including an unqualified right to authorize or forbid the recording of their live performances. 8

Performers’ rights in performances once those performances have been fixed in tangible form are much weaker. The statute gives performers a very limited reproduction right over performances that have already been recorded or filmed. 9 Performers also have a nominal right to equitable remuneration for commercial broadcasts of their fixed performances, 10 and a limited public lending right. 11

These rights are far narrower than their United States analogues. But they are essentially inalienable. Moreover, a performer’s employment status does not affect them. Japanese law does not presume that all fruits of an employee’s creative endeavor belong to her employer. Instead, the Japanese provisions for neighboring rights expressly preserve a limited set of rights in performers, whether employed or not. Nor do neighboring rights depend on a particular performer’s fame or her audience’s confusion.

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I have outlined the overall shape of United States and Japanese legal doctrine for the protection of performers. How do these doctrines apply to digital sampling?
Digital Sampling Under U.S. Law

The first instinct of American music lawyers when their clients came to them and complained that their performances were showing up on other people’s records was to think about a copyright infringement suit. They immediately ran into problems figuring out how to think about it.

Suppose, for example, that the digital sound sample was taken with the performer’s consent, but outside of the context of an employment relationship. Perhaps a fellow musician recorded it when playing around with her equipment. Using the sample in other recordings might violate the performer’s copyright rights to reproduce the work and to prepare derivative works, but only if the digital sound sample were copyrightable. And here we run into problems. First of all, a digital sound sample is itself probably too short to be copyrightable. The Copyright Office assimilates digital samples to other uncopyrightable building blocks of copyrightable expression: single words, brief phrases, discrete items of data or short dance steps. If the digital sound sample is uncopyrightable, then it is not copyright infringement to exploit it in other recordings. Even if the sample were held to be entitled to a copyright, there are further obstacles. Under the U.S. copyright statute, the copyright owner is entitled to prohibit any duplication of a sound recording, but may not prohibit imitation of it. We talk about this as a “dubbing” right: it covers record piracy and off-the-air recording, but not sound-alike records. And it is simply not clear whether a United States court would hold that creating a sound recording through the use of digital sound samples is a use that involves duplication, rather than mere imitation. A defense lawyer could argue that imitation is the essence of digital sampling: a computer analyzes the attributes of a sound wave, stores its characteristics in computer memory, and then uses synthesizer technology to imitate the sound. If courts assimilate the use of digital samples to imitation rather than duplication, then the creation of new recordings from those samples would not be copyright infringement.

Consider, instead, a situation in which the sample is taken from a copyrighted sound recording. We have some of the same problems, and some additional hurdles as well. If the sample is taken from a copyrighted sound recording, the sound recording is copyrightable, but the copyright doesn’t belong to the performer because the sound recording is a work made for hire. Assuming that there were a way over that hurdle, a copyright infringement action might fail on the ground that the accused recording was not substantially similar to the original sound recording, or that the amount taken was de minimis. After all, the sample is merely a few seconds long. The bottom line is that U.S. federal copyright law offers little protection of substance to the performer who has authorized the fixation of a digital sound sample of her performance.

What about bootlegging, or unauthorized fixation? State common law copyright might protect a performer whose live performance has been surreptitiously sampled. But there are no cases out there to look at, and it is entirely possible that states would find arguments that sound samples are mere building blocks and not protectable works of authorship to be compelling.

This brings us to the right of publicity. The right of publicity should protect performers from unauthorized commercial exploitation of their performances; so it would seem a perfect remedy. There are nonetheless significant obstacles to recovery. First, a sound recording may use music generated from a digital sample of a performer’s performance, without being widely recognizable. Most courts deny recovery for unrecognizable uses of plaintiff’s likeness or identity; those courts would surely deny recovery for unrecognizable uses of plaintiff’s performance. Secondly, most jurisdictions privilege “incidental use” of name and likeness, that is, use for purposes other than taking advantage of the celebrity’s reputation or prestige. Where the incidental use privilege is broad, the sort of appropriation involved in unauthorized use of digital sound samples would fall within it. Finally, there is the problem of preemption. If the performer has authorized the sample’s fixation in tangible form, state law causes of action for use of the sample would likely be preempted by the federal copyright statute.

This brings us to section 43(a) of the Lanham Act, and a ray of hope for the performer. Although there have as yet been no cases decided under section 43(a) on analogous facts, courts have interpreted it expansively, and used it to make otherwise unactionable wrongs actionable. So long as consumers are not confused as to the provenance of sounds on recordings or programs, section 43(a) ought not to provide a remedy. Courts, however, have been generous recently in finding the requisite likelihood of confusion, and quick to respond to impressions of misappropriation with injunctions.

No 43(a) suit has yet been filed. In the face of gloomy prognoses from their attorneys, composers aggrieved by the use of digital sound samples of their performances in commercial sound recordings have tried to persuade their union to pursue the issue. Thus far, however, the union has failed to do so.

Why is U.S. law so inhospitable to claims for this sort of injury? United States protection of intellectual
property is based on an economic incentive model rather than a natural rights model of personality. The bare fact that someone created something does not suffice to entitle that person to legal rights in her creation. Instead, U.S. law offers property rights as incentives for creation and concentrates those rights in the hands of those entities most likely to exploit them. A performer’s voice, or trumpet tone, is not something that the law envisions as more likely to be ‘created’ if incentives are available.

Digital Sampling Under Japanese Law

Japanese law embodies an approach that derives from natural rights, and expressly recognizes rights in performers. One might therefore expect it to be more favorable to performers than its U.S. counterpart. Indeed, under Japanese law, performers are in a somewhat stronger position. Their statutory neighboring rights give them a right to prohibit unauthorized fixation of their performances, and a right to prevent duplication of unauthorized fixations. If taking a digital sound sample of a performance is deemed to be a recording of that performance, an unauthorized sample should violate performers’ neighboring rights, and any reproduction of that sample should also be a violation. There are, nonetheless, significant hurdles that performers must overcome. Notwithstanding the fact that Japanese law approaches issues of performers’ rights differently from the United States, the obstacles performers face in recovering for unauthorized uses of digital samples are similar.

First of all, as in the U.S., it isn’t entirely clear that a recording as short as a digital sound sample would constitute a reproduction of a performance. Second, even if a digital sound sample were deemed a reproduction of a performance, it is not completely clear that a new recording that incorporates music created from the sound sample would also be deemed a reproduction of the performance. Finally, taking and using a digital sound sample might be exempt under the Japanese statute’s provisions permitting short, attributed quotations from performances if consistent with fair dealing.13

If the performers have consented to the sample, then in addition to these hurdles we have a problem of ownership. Under the Japanese neighboring rights provisions, the unqualified reproduction right would belong to the producers of the phonograms, which, under the statutory definition would seem to be whoever recorded the sample.14 Performers could prevent the sample’s use in other sound recordings only in very limited situations. These would be weak rights, but they would be stronger rights than are currently available to performers in the United States.

Why is Japanese law not more favorable to performers aggrieved by the unauthorized use of digital sound samples? Although Japanese law takes a natural rights approach to performers’ rights, and accords performers rights that are essentially inalienable, it defines those rights restrictively. Indeed, because the rights are inalienable and may be owned by a multiplicity of persons who may have conflicting interests, it is necessary that they be narrow in scope. Because digital sampling involves a new technology, it is difficult to predict whether it is encompassed within the restrictive language of Japan’s neighboring rights provisions.
Japanese performers face, for different reasons, many of the same obstacles as performers face under U.S. law.

Conclusion

Both the United States and Japan offer performers rights, but they are weak rights. Japan is more solicitous of performers than is the United States, but the development of new technology has outstripped the legal provisions in both nations' laws. United States law in this area has set its highest priority as facilitating the transfer and exploitation of rights by concentrating their ownership in the hands of few people: hence, our adherence to the work made for hire doctrine, which vests copyright in almost all performances in the performers' employer. Japan has been more willing to tolerate plurality of ownership, and the resulting restraints on alienation and exploitation of rights. But the development of digital sampling techniques strains the provisions made for performers' rights under both systems, because the way that performances may be exploited no longer fits comfortably within the language of either of our laws.

The Rome Convention, upon which Japan's neighboring rights provisions are based, is only a first step in protecting the rights of performers, and is already outdated. The provisions of the Rome Convention are, nonetheless, more generous to performers than current U.S. law. The United States is unlikely to join the Rome Convention and unlikely to amend its law to conform with the convention's terms. Performers' protection in the United States, then, is likely to continue to be based on a collection of diverse and sometimes inconsistent legal theories, providing a system of uneven and often unpredictable rights and remedies.

Footnotes

1. Jeffrey Newton, J.D. 1987, won first prize in the 1987 Nathan Burkan Memorial Competition with his paper on the digital sampling problem, "Digital Sampling: The Copyright Considerations of a New Technological Use of Musical Performance." I am grateful to Mr. Newton for directing my attention to this problem, and for educating me in the lore and technology of musicianship.


5. Japan is a signatory to the Berne Convention for the Protection of Literary and Artistic Works, an international copyright treaty, ratified by the overwhelming majority of nations in the world. The United States has not yet acceded to Berne. In significant respects, the copyright laws of Berne members share similarities that United States copyright law does not share.


9. If the fixed performance is embodied in an audiovisual work or a film, the performer may prevent the reproduction of that performance in a sound recording, but not in another audiovisual work. Copyright Law, art. 91. Performers may, however, enforce contractual restrictions on broadcast programs in which their performances are incorporated. Copyright Law, arts. 93, 94. If the fixed performance is, instead, embodied in a sound recording, the performer may prevent a reproduction of the sound recording for a purpose completely different from the purpose for which the performer consented to the original fixation. Although the right to reproduce phonograms belongs to the phonogram producer, at least one court has apparently enforced the reproduction right at a performer's behest. See Hama-sake v. Ishiyama Kaden K.K., Tokkyo To Kigyo, Jan. 1979, p.64 (Tokyo Dist. Ct. Nov. 8, 1978), discussed in T. Doi, supra note 15, at 242.

10. Copyright Law art. 95. In Japan, the individual performers never receive the money paid as equitable remuneration for secondary uses. Instead, broadcasters pay royalties to Geidankyo, the performers' collecting society. Geidankyo uses some of the funds for activities that benefit performers, and disburses the rest of the money to performers' organizations and unions for use in their operating budgets.

11. Copyright Law art. 95bis.


15. Notwithstanding the inadequacy of United States law on issues of performers' rights, it appears very unlikely that the United States will accede to the Rome Convention. Because broadcasting organizations and phonogram producers have strong economic rights under the copyright statute, they are unlikely to support accession to Rome. Performers alone are insufficiently powerful political players to command congressional attention. The most recent effort to expand performers' rights under the copyright statute, the proposal to establish a performance right in sound recordings, languished in Congress despite the support of the Copyright Office. See Subcomm. on Courts, Civil Liberties and the Administration of Justice, of the House Judiciary Comm., Performance Rights in Sound Recordings (Committee Print 1978).