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## Copyright and the Musical Arrangement: An Analysis of the Law and Problems Pertaining to This Specialized Form of Derivative Work

Joel L. Friedman

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# Copyright and the Musical Arrangement: An Analysis of the Law and Problems Pertaining to This Specialized Form of Derivative Work\*

*This comment defines the particular problems inherent in the application of copyright law to the musical arrangement by examining the practical realities and workings of the recording industry. The author considers such areas as compulsory licensing, imitation of artist style, and adaptation for commercial performance, concluding that further legislation is necessary to afford a level of protection that is commensurate with the importance of the musical arranger's unique role.*

## INTRODUCTION

Music today has permeated virtually every aspect of our society. It is used for listening, for dancing, and to create moods in television and the movies. Music is everywhere and, as a result, the music industry is a billion dollar business. Recent statistics indicate that the public has invested in over 400 million radio sets and 125 million television sets. In 1975 alone, 73 million stereos were purchased.<sup>1</sup>

From the time the composer first scratches out a few notes on manuscript paper to the time the public hears it, a song undergoes many transformations. When the composer first finishes his work, he probably has a simple melody that can be played in less than a minute. Before this song reaches any listener, it is orchestrated or arranged for a particular group of musicians. Even if the song is played by a single instrument, such as a piano, some type of arrangement is usually made. Without the musical arrangement, songs would lack variety and would be less adaptable to different styles of music.<sup>2</sup>

It will be the aim of this article to examine the art form known as the musical arrangement (or orchestration),<sup>3</sup> insofar as it is af-

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\* This comment received the first place award in the Nathan Burkan Memorial Competition sponsored by the American Society of Composers, Authors, and Publishers (ASCAP).

1. S. SHEMEL & W. KRASILOVSKY, *THIS BUSINESS OF MUSIC*, viii (3d ed. 1978) [hereinafter SHEMEL & KRASILOVSKY].

2. *Id.* at 207.

3. The terms arrangement and orchestration are used synonymously in this comment.

fectured by aspects of the copyright law pertaining to its originality, recording, publishing and performance. First, however, a background in general music principles will be presented to assist the reader in understanding more clearly the vital function that an arranger serves.

### THE MUSICAL ARRANGEMENT

The art of arranging or orchestrating music involves more than merely "dressing up" a song to make it more attractive. In fact, the term "arranger" is not an accurate one since the arranger also does a great deal of original composing when writing his<sup>4</sup> arrangement.

Arranging music involves a thorough knowledge of the elements of music<sup>5</sup> and of all the various musical instruments. The arranger must know an instrument's method of sound production, its range, limitations, faults, and virtues. The arranger must also possess a well-developed aural memory, that is, the ability to recall the sounds of the various instruments, both individually and in combination.<sup>6</sup> Also required is the ability to match the particular instruments with the melody, harmony, and rhythm.

The arranger is responsible for the "style" of the song's presentation, for the selection of the instruments used in the recording and, in the case of vocal recordings, for the setting behind the vocal. He generally composes a suitable introduction to the song, musical interludes, and background harmonies which complement the melody. Occasionally, the song's original composer chooses harmonies to the melody which are not as effective as other harmonies. In such an instance, it is the arranger's job to alter or add to the original harmonic structure of the song. This change in the harmony can be as important as the melody itself since harmony is largely responsible for the mood a song conveys.

The art of arranging music first came to prominence in the 1930's and 1940's during the era of the large dance orchestras.<sup>7</sup> Something was needed to help the public to distinguish one band

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4. Masculine pronouns in this comment have been used solely for the sake of convenience. Wherever appropriate the use of the masculine gender should be recognized as including feminine gender.

5. The three elements of music are melody, harmony, and rhythm. Melody is the organized succession of single tones while harmony is the simultaneous occurrence of musical tones. Rhythm is that element of musical expression that organizes successive sounds into accent determined patterns. *See generally*, M. BERNSTEIN & M. PICKER, *AN INTRODUCTION TO MUSIC* (4th ed. 1972).

6. W. RUSSO, *JAZZ COMPOSITION AND ORCHESTRATION* 8 (1968).

7. For an excellent article dealing with the large dance bands and the 1909 Copyright Act *see* Comment, *Copyright Law and the Modern Dance Arrangement*, NOTRE DAME L. REV. 481 (1947).

from another, thus contributing to its commercial success. It was here that the arranger became the key man in setting the band's style.<sup>8</sup> In the 1950's, the individual singer replaced the "big band" in popularity, and the arranger was called upon to provide musical arrangements tailored to a particular vocalist's style.

Music has always been present in the motion pictures. Here the composer or arranger is responsible for presenting music in a manner consistent with, and contributing to, the action on the screen. This music, to a large degree, sets the mood of the movie and may even be responsible for the movie's success or failure. Even today, in the era of "rock" and "disco," the arranger is still present, often arranging for the studio orchestras which assist the popular rock groups with their recordings.

A musical arrangement or orchestration may not be copyrighted unless the consent of the copyright owner is obtained. This is found in the "exclusive rights" sections of both the 1909 and the 1976 Copyright Acts. The 1909 Act, in Sec. 1, provides that the copyright owner shall have the exclusive right "to arrange or adapt it if it be a musical work." In the current Act, a musical arrangement is considered a form of "derivative work"<sup>9</sup> and it is within the copyright owner's exclusive power to prepare or authorize "derivative works based on the copyrighted work."<sup>10</sup>

Despite these provisions,<sup>11</sup> the arrangements used in popular recordings rarely qualify for copyright protection. This is because

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8. G. SIMON, *THE BIG BANDS* 40 (1967).

9. 17 U.S.C. § 101 (1976).

10. Subject to sections 107 through 118, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic and choreographic works, pantomimes, and motion pictures and other audiovisual work, to perform the copyrighted work publicly; and
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly.

17 U.S.C. § 106 (1976).

11. The following cases have held that a musical arrangement is the subject of copyright protection: *Barron v. Leo Feist, Inc.*, 173 F.2d 288, 290 (2d Cir. 1949); *Edmonds v. Stern*, 248 F. 897 (2d Cir. 1918); *Carte v. Evans*, 27 F. 861 (1st Cir. 1886); *Nom Music, Inc. v. Kaslin*, 227 F. Supp. 922 (S.D.N.Y. 1964); *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 73 F. Supp. 165 (S.D.N.Y. 1947).

the agreement normally used in the recording industry is a standard mechanical license to record,<sup>12</sup> whereby the copyright owner indicates he will not object if the arrangement is used in a recording. Thus, the copyright owner, who is usually not involved in preparing or recording the arrangement, does not consent to copyrighting the arrangement but only permits it to be recorded.<sup>13</sup>

In the area of music publishing, the situation is somewhat different. The arrangers who work for the music publishers prepare sheet music versions of the songs which usually have already been recorded. They also prepare arrangements for bands, orchestras, jazz ensembles, and vocal groups. Copyrights are obtained here. This is due simply to the fact that publishers generally own the rights to the musical compositions.<sup>14</sup>

The arrangers who work for these publishers are either salaried employees or those who work on an assignment basis. Their arrangements are considered "works made for hire,"<sup>15</sup> and, as such, leave the employee with no interest whatsoever in his work. The music publisher-employer owns all the rights in the arrangement and is considered to be the author. Consequently, the arranger is not entitled to any royalties for his creation. Conditions to this effect are generally provided for in the agreement signed by the employer and arranger, in which the arranger specifically acknowledges his employee status.<sup>16</sup>

In the area of sound recordings, arrangers may soon be entitled to a performance royalty. Legislation is currently being considered which would entitle musicians, vocalists, record companies, and music preparation people (such as arrangers) to a performance royalty. If this law is enacted, "discos," broadcasters, and

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12. See text accompanying note 60, *infra*.

13. SHEMEL & KRASILOVSKY, *supra* note 1, at 208.

14. *Id.*

15. 17 U.S.C. § 101 (1976), defines "work made for hire" as:

(1) a work prepared by an employee within the scope of his or her employment; or

(2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, and as instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire. For the purpose of the foregoing sentence, a "supplementary work" is a work prepared for publication as a secondary adjunct work by an author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work such as forewords, afterwords, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes, and an "instructional test" is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.

16. SHEMEL & KRASILOVSKY, *supra* note 1, at 529.

any others who use recorded works for profit would be required to pay royalties to the people responsible for the recording, even though these people have no ownership rights in the copyright.<sup>17</sup> Under the current law, only the copyright owners of the songs themselves are compensated. This is accomplished through licensing agreements with performing rights societies, such as ASCAP and BMI.<sup>18</sup> Considering the importance of the arranger in the success of a sound recording and the proliferation of the "disco" (which relies solely on recorded music), the arranger should certainly be compensated for the "performance" of the recording.

#### ASPECTS OF DERIVATIVE WORKS

A derivative work is defined in Sec. 101 of the current Act as "a work based upon one or more pre-existing works."<sup>19</sup> A musical arrangement is given as an example in the definition. Even if "musical arrangement" had been omitted as an example, it is quite clear that an arrangement is a form of derivative work. The arranger takes a pre-existing musical composition and produces an extensive work that is based on this prior composition. Since an arrangement is a form of derivative work, aspects of law pertaining to derivative works in general will be examined.

It should be noted here that a work which borrows from a prior work is not necessarily a derivative work. To be considered a derivative work, the subsequent work must borrow substantially from a prior work.<sup>20</sup> Professor Nimmer, in his copyright treatise, provides an interesting alternative view of a derivative work. He states that:

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17. International Musician, May, 1979, at 1, col. 3; Variety, Oct. 4, 1978, at 88, col. 6; Daily Variety, August 5, 1977, at 3, col. 5.

18. Because musical works can be performed on such an extensive basis, a copyright owner would find it impossible to adequately enforce his performing rights by himself. Consequently, ASCAP (American Society of Composers, Authors and Publishers) was founded in 1914, which enforces the composers' performance rights. Simply stated, ASCAP is the assignee of its members, and licenses the performing rights in the compositions of its members. Anyone who intends to perform an ASCAP composition for profit in a non-dramatic manner must obtain an ASCAP license. M. NIMMER, CASES AND MATERIALS ON COPYRIGHT AND OTHER ASPECTS OF LAW PERTAINING TO LITERARY, MUSICAL, AND ARTISTIC WORKS, 221-22 (1971), [*hereinafter* NIMMER].

19. 17 U.S.C. § 101 (1976).

20. M. NIMMER, NIMMER ON COPYRIGHT § 3.01 (1978) [*hereinafter* NIMMER ON COPYRIGHT].

a work will be considered a derivative work only if it would be considered an infringing work if the material which it has derived from a pre-existing work had been taken without the consent of a copyright proprietor of such pre-existing work.<sup>21</sup>

The valid derivative work does not infringe because permission has been obtained from the prior copyright owner or the pre-existing work is in the public domain.<sup>22</sup> It follows that a work, which does not qualify as a derivative work, would be separately copyrightable as an independent and completely new work if the standard of originality is met.<sup>23</sup>

Once a genuine derivative work is produced, problems arise as to who has standing to bring suit for infringement of this work. In essence, this is because we are dealing with two separate works—the pre-existing work and the contributions made to it.

It is clear that if the defendant copies the material which has been added to the prior work, the copyright in the derivative work will be infringed. This is based on Sec. 103(b), which extends copyright protection in derivative works “only to the material contributed by the author of such work, as distinguished from the pre-existing material employed in the work. . . .” Problems arise when there has been substantial copying from the derivative work of material that was originally part of the pre-existing work. For example, if an infringer copies the musical additions and alterations contributed by the arranger, the arranger clearly has standing to sue for this infringement. The confusion occurs when the infringer copies only the underlying melody on which the entire arrangement is based. The answer seems to lie in whether the arranger was an exclusive or non-exclusive licensee of the copyright owner. This stems from the current Act’s recognition of divisibility of copyright.<sup>24</sup> Since copyright is now divisible, the licensor has ceased to be the owner of such rights that are exclusively licensed to the licensee. Hence, if the plaintiff is the exclusive licensee in a particular medium, then he can sue for infringement of the underlying work if the infringer is exploiting the work in the same medium as the plaintiff-licensee. If the de-

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21. *Id.* An infringing work is one which is substantially copied from another copyrighted work. *Smith v. Little, Brown & Co.*, 245 F.Supp. 451 (S.D.N.Y. 1965).

22. “Public Domain” is generally defined as “the other side of the coin to copyright.” It is best defined in negative terms. It lacks the element of private property granted to copyright in that there is no restriction on others from making full and complete use of the public domain material. It is, literally, “free as the air.” SHEL & KRASILOVSKY, *supra* note 1, at 224.

23. See text accompanying note 27, *infra*, for discussion of originality.

24. 17 U.S.C. § 201(d)(2) (1976). Under the 1909 Act it was assumed that since the Act speaks of a single “copyright”, the rights which accrue to the copyright owner are indivisible. Hence, only the entire copyright is “assignable,” and anything less than a total transfer is a mere “license.” NIMMER, *supra* note 18, at 287-91.

defendant is infringing in a different medium, then only the owner of the underlying work or his exclusive licensee in *that* medium can bring suit. However, if the plaintiff is a non-exclusive licensee of the underlying work, then he does not have standing to sue for infringement of the underlying work. In this instance the doctrine of indivisibility of copyright remains intact.<sup>25</sup>

Applying these principles to the above example, it would seem that if the licensee has the exclusive right to prepare printed arrangements, he would not have standing to bring suit for infringement by a recording of the song itself. Only the owner of the underlying work could sue in this instance since the infringement occurred in a sufficiently different medium of expression.

Suppose that the defendant, even with a license to record the song, proceeds to record the plaintiff's copyrighted published arrangement. Although the new Act permits independent duplication of a recording<sup>26</sup> (*i.e.*, transferring the sounds of the recorded arrangement to manuscript paper and then recording the arrangement with a new group of musicians), the defendant has not duplicated recorded sounds. He has infringed the plaintiff-licensee's copyright in the arrangement and the licensee could sue for the copying of his additions or alterations to the original composition.

#### ORIGINALITY

The single most important factor in obtaining copyright protection is that the work be the original product of the copyright claimant.<sup>27</sup> "Originality" has generally been defined as "independent creation," meaning simply that the work was created independently by the author.<sup>28</sup> In this section, the quantum of

25. NIMMER ON COPYRIGHT, *supra* note 20, at § 3.05.

26. See 17 U.S.C. § 114(b) (1976); *see also*, text accompanying notes 58-87, *infra*.

27. Also necessary for protection under the federal statute, is fixation in tangible form, notice, and publication (under the 1909 Act).

28. NIMMER ON COPYRIGHT, *supra* note 20, at § 2.01. It is noteworthy that the 1909 Act nowhere expressly invoked the requirement of originality. The courts reached this conclusion by interpreting "author" from the constitutional phrase giving Congress the power to pass copyright legislation: "To promote the progress of science and useful arts, by serving for limited times to authors and inventors the exclusive right to their respective writings and discoveries." U.S. CONST. art. I, § 8, cl.8. It is reasoned that the "author" is the "creator", thus requiring originality to be an author. The 1976 Act provides in Sec. 102(a) that "copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression. . . ."



originality needed to support copyright in a musical arrangement will be examined. It will be evident that the courts are far from consistent in their approach to this particular form of derivative work. Some courts have subjected the musical arrangement to excessive scrutiny and have set extremely high originality standards, almost approaching a "novelty" standard.<sup>29</sup> Other decisions reflect a complete disdain for weighing any creative effort, resulting in copyright protection for the most minimal amount of additional material.

Since a musical arrangement is a form of derivative work, aspects of originality pertaining to derivative works in general should be examined. It is often stated that to support a copyright, there must be more than a minimal contribution to the underlying work.<sup>30</sup> Professor Nimmer appears to support the view that the applicable standard for determining the quantum of originality needed is that of a "distinguishable variation."<sup>31</sup> The dispute over "quantum" of originality may come as a surprise if one recalls the famous Holmes' opinion in *Bleistein v. Donaldson Lithographing Co.*<sup>32</sup> In this frequently cited opinion, Justice Holmes expressed his view of originality and the role of the judiciary:<sup>33</sup>

It would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. . . .

It should be noted that Justice Holmes did not say that any minimal expression of originality would be subject to copyright protection. There is "a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support copyright."<sup>34</sup> The courts, then, still retain the power to pass judgment on a work when it falls within these "narrow and most obvious limits." And, the courts have not hesitated to express themselves

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29. See Annot., 23 A.L.R. 2d 244, 283-84 (1952). This annotation discussed literary and artistic rights in connection with motion pictures, radio, and television. It provides a brief discussion of musical arrangements (and originality) under the 1909 Act.

The term "novelty" is used here to connote unusualness, as opposed to independent creation (which is the requirement for copyright protection).

30. *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir. 1976); *Gerlach-Barklow Co. v. Morris & Bendien, Inc.*, 23 F.2d 159 (2d Cir. 1927).

31. NIMMER ON COPYRIGHT, *supra* note 20, at § 3.03.

32. 188 U.S. 239 (1903).

33. *Id.* at 241.

34. NIMMER ON COPYRIGHT, *supra* note 20, at § 2.01(B).

in this area. Mechanical toy banks,<sup>35</sup> weight lifting charts,<sup>36</sup> and chord charts,<sup>37</sup> to name a few items, have been met with claims that they lacked sufficient originality to be copyrighted. As the court in *Alfred Bell v. Catalda*<sup>38</sup> stated: "All that is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'"

With the foregoing in mind, several cases dealing with originality in musical arrangements will be examined. Two of the earliest cases dealing with this aspect are *Jollie v. Jacques*<sup>39</sup> and *Wood v. Boosey*.<sup>40</sup> In *Jollie* a German musical composition, the "Roschen Polka," in the public domain, was re-arranged for piano and copyrighted as "The Serious Family Polka." It was alleged that the defendants were violating the plaintiff's copyright by the publication and sale of the plaintiff's polkas. The defendants, in turn, claimed that their composition was not a copy but was an original adaption of the same German tune, and that the plaintiff's composition was not subject to protection under the copyright law. In denying the plaintiff's request for an injunction, the court stated that an "original air requires genius for its construction; but a mere mechanic in music, it is said, can make the adaption or accompaniment."<sup>41</sup> The court espoused the view that a musical composition, to be copyrighted, must be substantially "a new and original work; and not a copy of a piece already produced, with additions and variations which a writer of music with experience and skill might readily make."<sup>42</sup>

If the view of the *Jollie* court were followed it would seem that no arrangement could ever be copyrighted. As long as the underlying work was already in existence, mere additions and variations by a skilled arranger would not meet the originality standard here. This is an incredibly strict standard because the court is requiring that the entire work must be original to be protected. Also, it appears that experience and skill is not a sufficient level of creativity to produce an original product.

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35. *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir. 1976).

36. *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904 (3d Cir. 1975).

37. *Trebonik v. Grossman Music Corp.*, 305 F. Supp. 339 (N.D. Ohio 1969).

38. 191 F.2d 99, 103 (2d Cir. 1951).

39. 13 F. Cas. 910 (C.C.N.Y. 1850) (No. 7437).

40. 3 L.R. 223 (Q.B. 1867).

41. 13 F.Cas. 910, 913 (C.C.N.Y. 1850) (No. 7437).

42. *Id.* at 914.

The English court in *Wood* recognized that an arranger is as much an artist as was the original composer. The court acknowledged the fact that "there is composition in the adaption to the particular instrument," and that this adaption is the subject of protection.<sup>43</sup>

The problem with cases subsequent to *Jollie* and *Wood* is that the courts pay lip service to the principle handed down in *Wood* (recognizing that arranging is an art form in itself) yet proceed to apply the stricter test of the *Jollie* court.

The view of the *Jollie* court was strictly followed in the case of *Cooper v. James*.<sup>44</sup> The plaintiff, who had composed alto parts to a public domain song book that utilized three-part harmony, was denied copyright protection. The court, while recognizing that the addition of the alto part would be an improvement to the song, still held that this addition was not original and capable of being protected. The court likened the arranger to a mechanic and stated that "anything which a fairly good musician can make"<sup>45</sup> would not be subject to copyright. While the addition of a fourth harmony part could probably have been performed by a "fairly good musician," a talented orchestrator could possibly compose an addition which would place the entire composition in a new light. The court here failed to examine the quality of the additional alto part or what kind of effect it had on the prior musical composition. A later case, dealing with the adaption of a Russian Hymn for choral use, resulted in a similar decision.<sup>46</sup>

More recently, Supreme Records brought suit against Decca Records for unfair competition<sup>47</sup> in allegedly copying the arrangement from the Supreme recording.<sup>48</sup> The court, in discussing whether a common law property right existed in a recorded arrangement, proceeded to examine the arrangements themselves. Although this is not a copyright case, the court's findings are certainly applicable to the issue of originality, and the case has been cited as such. Judge Yankwich stated that the arrangement "must involve creative ability of a distinct kind," before any rights in it could be recognized.<sup>49</sup> Hence, an introduction, handclapping,

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43. *Wood v. Boosey*, 3 L.R. 223, 232 (Q.B. 1967).

44. 213 F. 871 (5th Cir. 1914).

45. *Id.* at 872.

46. *Norden v. Oliver Ditson Co., Inc.*, 13 F. Supp. 415 (D.C. Mass. 1936).

47. "Unfair Competition" are those trade practices which the law has designated as beyond the boundaries of legitimate competition. One of the more common actions under the heading of unfair competition is "passing off." This entails misleading the public into believing that the goods and services of another are those of the plaintiff. W. PROSSER, *LAW OF TORTS* 954 (4th ed. 1971).

48. *Supreme Records v. Decca Records*, 90 F. Supp. 904 (S.D. Cal. 1950).

49. *Id.* at 913.

choral responses, and a musical interlude were held not sufficiently creative to be protected. In *McIntyre v. Double-A Music Corporation*,<sup>50</sup> an introduction, musical interludes, harmony, melodic and harmonic embellishments, and an ending were held de minimis contributions not qualifying for copyright.

In sharp contrast to the decisions above are *Desclee & Cie, S.A. v. Nemmers*<sup>51</sup> and *Consolidated Music v. Ashely*.<sup>52</sup> *Desclee* involved an unfair competition suit to enjoin the photographic reproduction and sale of Gregorian chants with Solesmes rhythmic annotations.<sup>53</sup> Why the plaintiff did not sue under the copyright statute is puzzling; nevertheless the court stated: "The Solesmes rhythmic annotations indicating the manner of performance of the Gregorian chants are an integral part of the musical composition which may be copyrightable under the statute."<sup>54</sup> Thus, mere rhythmic markings were considered by this court to be worthy of protection.

Similarly, in *Consolidated Music*, compilations of public domain musical compositions for piano with editorial matter were held protectable. Specifically, marks of fingering, phrasing, and expression were added to assist in understanding the mood and structure of the piece, and to help in its performance. Although the defendant argued that the fingering and phrasing marks were standard and not additions to the original work,<sup>55</sup> the court stated that originality required slightly more than a trivial variation, and this existed in the markings.<sup>56</sup>

*Consolidated Music* is particularly noteworthy inasmuch as there would have been little or no audible difference if the additional matter had been omitted altogether. The fingering and phrasing marks, while additions to the printed page, would probably not have affected the "sound" of the work.

The apparent confusion and dissimilarity in the "originality"

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50. 166 F. Supp. 681 (S.D. Cal. 1958).

51. 190 F. Supp. 381 (E.D. Wis. 1961).

52. 197 F. Supp. 17 (S.D.N.Y. 1961).

53. The Solesmes method is a particular method of singing Gregorian chants named after the monks at the Abbey of Solesmes. It is a system of markings used to make clear the ancient rhythm and to restore its manner of performance. APEL AND DANIEL, *THE HARVARD BRIEF DICTIONARY OF MUSIC* (1960).

54. 190 F. Supp. 381, 388 (E.D. Wis. 1961).

55. The author feels that the defendant is correct in this assertion inasmuch as these marks are standard in many piano compositions.

56. 197 F. Supp. 17, 18 (S.D.N.Y. 1961).

decisions result from a lack of understanding of the arranger's function.<sup>57</sup> While a simple piano introduction of four measures may not be startlingly creative, it would be perfect for setting the mood in a pensive ballad. However, it would sound totally out of character in a "hard rock" song. These are the types of decisions which an arranger makes when "packaging" a simple melody. Likewise, the abilities and style of the performer must be taken into consideration. This aspect of arranging music has been overlooked by the courts which require a high degree of creativity. At the same time, simple accent and phrasing marks are de minimis and should not be protected, lest any change in a musical composition, no matter how trivial, would be subject to copyright protection.

There appear to be three approaches which can be used to weigh the originality element in a musical arrangement. The "significant creativity test" requires an in depth analysis of the arranger's contribution. The contribution to the underlying work would have to involve "creative ability of a distinct kind."<sup>58</sup> This approach was used in *Supreme Records, Jollie, and Cooper*. A heavy burden is placed on the court using this method since the judge must weigh the actual musical contributions by the arranger and then compare them against the contributions of other arrangers.

The "audio test" involves a comparison of the basic work against the derivative work. If the arrangement, when played, leaves an impression of newness or novelty when compared to the underlying work, it will be subject to copyright. This is solely a "listening" comparison, and problems may arise inasmuch as arrangements typically involve various instruments which would, of themselves, give a different impression by themselves. These problems may be remedied by reducing the orchestration solely to piano music, and then comparing the song as played on a piano to the arrangement as played on the piano. Had this test been applied in *Consolidated Music*, it is almost certain that no infringement would have been found. It is submitted that this test is more in line with the "distinguishable variation" test suggested for derivative works by Professor Nimmer.<sup>59</sup>

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57. The standard for achieving originality in the composition of popular songs does not appear as strict as many of the "arrangement" decisions. Judge Yankwich stated in *Hirsch v. Paramount Pictures*, 17 F. Supp. 816, 817 (S.D. Cal. 1937) that "originality in the realm of popular music lies within a very narrow scope. Slight variations in the use of rhythm, or harmony—of accent and tempo—may achieve it."

58. See text accompanying note 41, *supra*.

59. NIMMER ON COPYRIGHT, *supra* note 20, at § 3.03; see also text accompanying note 31, *supra*.

Perhaps a combination of the two approaches would work best. The judge could examine the actual material contributed and weight its creativity by the "audio impression" that it leaves. This would allow the works in the *Supreme* and *McIntyre* cases to be protected, and yet would exclude from protection the works in *Consolidated Music*.

#### COMPULSORY LICENSE PROBLEMS

Given the public's familiarity and exposure to phonograph records, it would seem obvious that these products would be protected by the copyright law. This, however, was not the case until 1972, when copyright protection for sound recordings was enacted.<sup>60</sup> More basic than protection for the sounds embodied in the recording would be protection for the musical compositions which would be the subject of the recording. Prior to 1909, though, there was no protection for songs with regard to recording. Thus, it was possible for anyone to record a copyrighted song, and to market the recording, without having to pay the copyright owner for the use of his song. The passage of the Copyright Act of 1909, recognized the right to record a copyrighted musical composition as one of the exclusive rights of the copyright owner.<sup>61</sup>

The exclusive right of the copyright owner to reproduce his compositions on records is, however, limited by the compulsory license provisions. Congress, apprehensive about creating a "great music monopoly,"<sup>62</sup> provided in Section 1(e) that if the copyright owner used or permitted the use of a copyrighted composition for mechanical reproduction, all others would be able to reproduce the music on payment "of a royalty of 2 cents on each such part manufactured." This section provides for compulsory licensing of the copyrighted compositions when the appropriate provisions are met. The extent of the use which can be made of a musical composition within the scope of the compulsory license will be

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60. Protection for sound recordings was enacted on February 15, 1972, by an amendment to the Copyright Act of 1909. This applies to recordings fixed and published on or after that date.

61. Section 1(e) of the Copyright Act of 1909 stated that the copyright owner in the work shall have the exclusive right "to make any arrangement or setting of it or of the melody of it in any system of notation or any form of record in which the thought of an author may be recorded and from which it may be read or reproduced."

62. H.R. REP. NO. 2222, 60th Cong., 2d Sess. 6 (1909).

discussed in the following section.<sup>63</sup>

Section 1(e) of the 1909 Act provides that once the copyright owner has used or permitted the use of his work for mechanical reproduction "any other person may make similar use of the copyrighted work." The court, in *Standard Music Roll Co. v. F.A. Mills, Inc.*,<sup>64</sup> discussed whether "similar use" encompassed a situation where the licensee's recording used both the words and music, and the authorized recording was instrumental only. The court recognized that it was the copyright owner's decision as to how the original reproduction was to be made (*i.e.*, using the music only, the words only, or both together). After he has determined this and granted the license to one person, others can make similar use. The court held that if both words and music are used in the original, then the licensee can use both the words and music in his recording. If the original merely used the music, then the licensee was restricted to this use in his recording.<sup>65</sup> Although this decision has been criticized, it may still be applicable to the current Act.

What if the authorized recording contains both the words and the music? May the licensee produce a purely instrumental or vocal version? In other words, the question is whether the licensee has the right to produce his own arrangement of the composition using words or music as he chooses. Nothing is mentioned in Section 1(e) concerning the licensee's right to make his own musical arrangement.<sup>66</sup>

This right, although generally assumed, was expressly recognized in the case of *Edward B. Marks Music Corporation v. Foulton*.<sup>67</sup> The case involved copyright infringement of the musical composition "Malaguena" in which the plaintiff had all rights and had previously authorized recording of the song. The plaintiff's suit was based on the contention that the right to make a musical arrangement of a copyrighted composition is exclusively that of the copyright owner and that the compulsory license provisions do not include the right to make an arrangement. It was alleged that the defendants, in preparing their own arrangement and using it commercially, were infringing plaintiff's copyright.<sup>68</sup> The court looked at Section 1(e) in light of the exclusive rights stated

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63. For an excellent article on the 1909 compulsory license provision see EVANS, THE LAW OF COPYRIGHT AND THE RIGHT OF MECHANICAL REPRODUCTION OF MUSICAL COMPOSITIONS. (THIRD ASCAP COPYRIGHT L. SYMP. 1940).

64. 241 F. 360 (3d Cir. 1917).

65. *Id.* at 363.

66. NIMMER ON COPYRIGHT, *supra* note 20, at § 8.04(F).

67. 79 F. Supp. 664 (S.D.N.Y. 1948), *aff'd*, 171 F.2d 905 (2d Cir. 1949).

68. 79 F. Supp. 664, 666 (S.D.N.Y. 1948).

in Section 1(a), *i.e.*, "to print, reprint, publish, copy, and vend the copyrighted work." Section 1(e) specifically states that the right to prepare an arrangement is "for the purposes set forth in subsection (a) hereof. . . ." The court held that it was "evident that the separate and distinct right to make an arrangement and version is limited to printing, reprinting, etc. It does not cover or include the right to mechanical reproduction."<sup>69</sup> The plaintiff's contention would involve the addition of the right of mechanical reproduction to subsection (a). The right to control the arrangement used in the reproduction pursuant to the compulsory license would vest in the copyright owner and would create an opportunity for the birth of "mechanical trusts."<sup>70</sup> The court also noted that the requirement of "similar use" has been liberally construed to allow the composition to be adapted to a performer's style.<sup>71</sup>

Wide latitude has been given to compulsory licensees in preparing their own arrangements. One such case permitted the defendants to prepare and record "Latin" arrangements of such standards as "Five Foot Two Eyes of Blue," "When You're Smiling," and "Lazy River."<sup>72</sup> Additionally, several recent cases have noted that the licensee has the right to alter a copyrighted work in a manner consistent with the licensee's style or interpretation.<sup>73</sup> Certainly the extent of the alterations permitted should be justified by common sense and the rationale behind the compulsory license provision. If artists were unable to record their own versions and arrangements of songs and were restricted to the authorized recording only, numerous artists would undoubtedly avoid recording those songs, resulting in a situation analogous to a monopoly.

It has been shown that wide latitude is allowed in deviating from a authorized recording. A related question regards the ex-

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69. *Id.*

70. *Id.* The term "mechanical trusts" is referring to the monopoly which would be created by recognizing the plaintiff's claim in this case.

71. See note 29, *supra*.

72. *Leo Feist, Inc. v. Apollo Records, N.Y. Corp.*, 300 F. Supp. 32 (S.D.N.Y. 1969), *aff'd*, 418 F.2d 1249 (2d Cir. 1969).

73. *Stratchborneo v. Arc Music Corp.*, 357 F. Supp. 1393 (S.D.N.Y. 1973) "A licensee has the right so to alter a copyrighted work to suit his own style and interpretation." *Gilliam v. American Broadcasting Companies, Inc.*, 538 F.2d 14 (2d Cir. 1976) "Courts have recognized that licensees are entitled to some small degree of latitude in arranging the licensed work for presentation to the public in a manner consistent with the licensee's style or standards."



tent of similarity allowed the compulsory licensee's recording. It appears that a licensee may produce a recording identical to that of the authorized recording; in effect, transcribing the arrangement from the record and re-recording it.<sup>74</sup> This reasoning is based on the term "similar" (in "similar use") which connotes a minimum standard, with "identical" being the maximum. It is noteworthy here that at least one reported case, *Supreme Records v. Decca Records*,<sup>75</sup> considered the possibility of a literary property right in a recorded arrangement. The court seemed somewhat hesitant in reaching the conclusion that there should be no property right in such a case. The court did, however, provide clear (if not strict) guidelines as to the quantum of originality required in copyrighting an arrangement.<sup>76</sup>

Suppose a compulsory licensee, in his quest to produce a "similar" work, decides to duplicate a recorded performance by electronic means (*i.e.*, re-recording the authorized recording).<sup>77</sup> There is nothing stated in the 1909 Act that leads one to believe that the compulsory license should be withheld when a licensee duplicates a musical work from the sound recording of another. However, case of *Duchess Music Corp. v. Stern*<sup>78</sup> held that the Section 1(e) compulsory license in a musical work was not available to one who performed an identical duplication and that conduct of this nature was an infringement of the musical composition.<sup>79</sup>

The Copyright Act of 1909<sup>80</sup> did not address the question of whether a licensee who has recorded his own musical arrangement of a composition can claim copyright in the notational version underlying his record (*i.e.*, the derivative work which he has produced). This was examined in *McIntyre v. Double-A Music Corporation*,<sup>81</sup> the plaintiff recorded a composition pursuant to the compulsory licensing provisions of the 1909 Act. The defendants, who owned the copyright in the musical composition then

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74. This is assuming, of course, that no unfair competition is found. See note 47 *supra*.

75. 90 F.Supp. 904 (S.D. Cal. 1950).

76. *Id.* at 909. See note 29 *supra*.

77. This practice is commonly referred to as record "piracy." The amendment to the 1909 Act in 1972 established federal protection for sound recordings fixed on or after February 15, 1972, thus making piracy of recordings a federal offense. SHELLEY & KRASILOVSKY, *supra* note 1, at 99.

78. 458 F.2d 1305 (9th Cir. 1972).

79. This has been referred to as the "Duchess Doctrine" and has been widely criticized by commentators.

80. B. KAPLAN & R. BROWN, COPYRIGHT, UNFAIR COMPETITION, AND OTHER TOPICS BEARING ON THE PROTECTION OF LITERARY, MUSICAL AND ARTISTIC WORKS, 225 (3d ed. 1978).

81. 166 F. Supp. 681 (S.D. Cal. 1958).

released sheet music of the composition utilizing the plaintiff's recorded arrangement. The court discussed, in depth, the fact that the plaintiff had never copyrighted his arrangement under the federal statute and that all common law rights were lost with the record's general publication. Apparently, if the plaintiff had copyrighted his arrangement under the 1909 Act, he may have prevailed in the infringement action.

The 1976 Copyright Act attempted to clarify the ambiguities found in the 1909 Act. In Section 115 (the new compulsory license section) the right to arrange the musical composition and to adjust it to the performer's manner and style of performance is expressly stated. It is also recognized that this right to arrange is a limited freedom, and is not absolute. The Act provides that "the arrangement shall not change the basic melody or fundamental character of the work. . . ." <sup>82</sup> Even so, based on the decisions under the 1909 Act, there would still seem to be a wide latitude available to arrangers. In addition, it is made quite clear that the arrangement prepared by the licensee is not subject to copyright as a derivative work unless the express consent of the copyright owner is obtained. <sup>83</sup>

It may also be possible under the new Act that both the words and the music may be used when the authorized recording uses only the music. This departure from the case law <sup>84</sup> under the 1909 Act may come about due to the omission of the phrase "similar use" in the new Act. Therefore, anyone complying with Section 115 will be able to obtain a compulsory license to make and distribute phonorecords of the "work" as long as the arrangement does not change the basic character of the "work." <sup>85</sup> It would

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82. 17 U.S.C. § 115(a)(2) (1976) states:

A compulsory license includes the privilege of making a musical arrangement of the work to the extent necessary to conform it to the style or manner of interpretation of the performance involved, but the arrangement shall not change the basic melody or fundamental character of the work, and shall not be subject to protection as a derivative work under this title, except with the express consent of the copyright owner.

83. *Id.*

84. *Standard Music Roll Co. v. F.A. Mills, Inc.*, 241 F. 360 (3d Cir. 1917). See text accompanying note 62, *supra*.

85. 17 U.S.C. § 115(a)(1) (1976) states:

When phonorecords of a nondramatic musical work have been distributed to the public in the United States under the authority of the copyright owner, any other person may, by complying with the provisions of this section, obtain a compulsory license to make and distribute phonorecords of the work. A person may obtain a compulsory license only if his or her

seem that the statute is referring to the work in general and not to its particular authorized recording.

The new Act also resolves the question posed in *Supreme Records*, regarding the existence of any property right in a recorded arrangement. Section 114, which deals with sound recordings, states that the exclusive rights of the copyright owner in the sound recording do not extend to other recordings which duplicate the recorded performance through an independent fixation of other sounds.<sup>86</sup> The House Reports state that: "Mere imitation of a recorded performance would not constitute a copyright infringement even where one performer deliberately sets out to simulate another's performance as exactly as possible."<sup>87</sup> A recorded musical arrangement, then, may be transcribed from a recording and the identical arrangement recorded by other musicians. The exact rationale behind this provision is not clear but may be in response to practical considerations in the music industry (*i.e.*, the notational version underlying the recorded arrangement is not usually copyrighted).

The 1976 Copyright Act also provides that sound recordings are the subject of copyright protection<sup>88</sup> and that the compulsory license is not applicable to one who "pirates" a sound recording (duplicating a sound recording fixed by another).<sup>89</sup> This results in the pirate infringing the copyright in the sound recording by the unauthorized duplication, and the copyright in the musical work contained in the recording.

#### THE ADAPTION RIGHT

What happens when a musical performer acquires from the copyright owner the right to publicly perform the work but no other rights? Does the performer have the right to prepare his own arrangements, alter the lyrics or render any type of change in the basic work? The answer lies in an analysis of the "adaption right."

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primary purpose in making phonorecords is to distribute them to the public for private use. A person may not obtain a compulsory license for use of the work in the making of phonorecords duplicating a sound recording fixed by another, unless: (i) such sound recording was fixed lawfully; and (ii) the making of the phonorecords was authorized by the owner of copyright in the sound recording or, if the sound recording was fixed before February 15, 1972, by any person who fixed the sound recording pursuant to an express license from the owner of the copyright in the musical work or pursuant to a valid compulsory license for use of such work in sound recording.

86. 17 U.S.C. § 114(b) (1976).

87. H.R. REP. NO. 1476, 94th Cong. 2d Sess. 106 (1976).

88. 17 U.S.C. § 102(a)(7) (1976).

89. 17 U.S.C. § 115(a)(1) (1976).

The 1976 Act in Section 106 states that the copyright owner has in addition to his other rights, the exclusive right "to prepare derivative works based on the copyrighted work." The 1909 Act stated that the copyright owner had the exclusive right to "make any other version" of the work and "to arrange or adapt it if it be a musical work." These provisions and case law holding that a grant (transfer or license) of a right under the Act does not detract from the copyright owner's right to invoke rights not granted, leaves one with the proposition that a mere grant of the performance right is not a grant of the right to prepare derivative works.<sup>90</sup> It is possible then, that should the performer in the above example alter the lyrics or prepare his own arrangement of the song, his action would constitute an infringement of the adaptation right.

There are no reported cases dealing with this problem, and it is questionable whether the courts would recognize such an infringement.<sup>91</sup> After all, the performance of a musical composition by an artist would require some minimal arrangement, even if he was accompanied solely by a piano or other rhythm instrument. The courts may feel that such a situation is analogous to the right to prepare arrangements and provide for performer latitude under the compulsory license provisions of the 1909 Act.<sup>92</sup> Nevertheless, the prudent attorney should obtain from the copyright owner an express grant permitting his client the right to make any changes in the basic work necessary to its performance.

#### IMITATION OF PERFORMER'S STYLE

Analogous to the "sound-alike" recording is the imitation of a particular performer's style by others.<sup>93</sup> In many cases, this involves an imitation of the performer's musical arrangement, since this is most likely where his "style" stems from. This imitation of style and musical arrangements have been used often in the field of commercial jingles.<sup>94</sup> These are the catchy songs heard daily

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90. *Mills Music, Inc. v. Arizona*, 187 U.S.P.O. 22 (D.C. Ariz. 1975); *Schwartz v. Broadcast Music, Inc.* 187 F. Supp. 322 (S.D.N.Y. 1959).

91. NIMMER ON COPYRIGHT, *supra* note 20, at § 8.09(A).

92. See text accompanying note 7, *supra*.

93. See Kaul, *And Now, State Protection of Intellectual Property*, 60 A.B.A.J. 198 (1974).

94. SHEMEL & KRASILOVSKY, *supra* note 1, at 285.

on radio and television which extoll the virtues of manufacturer's products.

The use of a particular musical composition in an advertisement requires synchronizing the music with the film or announcement. So, in addition to a general ASCAP license<sup>95</sup> for use of the song, a synchronization license is required from the music publisher.<sup>96</sup> Once this license is obtained, the advertiser may want to imitate a particular performer's arrangement and style.

There are two well known cases where the recording artists brought suit claiming a property right in their version and arrangement of a song. In *Davis v. Trans World Airlines*,<sup>97</sup> the defendant (TWA) utilized modified lyrics of the song "Up, Up and Away" in radio and television commercials. The defendants had acquired a license to use the copyrighted music and lyrics from the music publisher. The plaintiffs, members of the singing group known as "The Fifth Dimension," claimed that TWA had imitated the plaintiff's recorded performance and brought suit for "passing off,"<sup>98</sup> that is, passing off the defendant's commercials as that of the plaintiff's. The court dismissed the suit by stating that "imitation alone does not give rise to a cause of action."<sup>99</sup>

Soon after *Davis* the Ninth Circuit decided the case of *Sinatra v. Goodyear Tire and Rubber Co.*<sup>100</sup> Plaintiff Nancy Sinatra had recorded a song entitled "These Boots Are Made for Walking" which had become a commercial success. Goodyear adopted the term "wide boots" to describe its tires, and used the music and revised lyrics from "These Boots Are Made for Walking," in its radio and television commercials. The plaintiff alleged that the defendants had simulated her singing style and musical arrangement. The copyright in the song was, at all times, owned by a music publisher who had licensed both the plaintiff and defendants to use the music and lyrics. As in *Davis* the suit was for the tort of "passing off" (a form of unfair competition). The court found no unfair competition, noting that holding for the plaintiff might result in potential licensees losing interest in the song.<sup>101</sup> If all artists who had ever performed the song could claim unfair competition, prospective licensees might be discouraged from using the song.<sup>102</sup>

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95. See NIMMER, *supra* note 18.

96. *Id.*

97. 297 F. Supp. 1145 (C.D. Cal. 1969).

98. See note 47 *supra*.

99. *Id.* at 1147.

100. 435 F.2d 711 (9th Cir. 1970).

101. *Id.* at 718.

102. *Id.*

There have also been two cases, decided by the New York Courts of Appeals, concerning the style of "swing bands" of the 1930's and 40's. *Miller v. Universal Pictures*<sup>103</sup> found that the widow of bandleader Glenn Miller did not have any property interest in the Glenn Miller "sound." The case, however, was resolved on contract principles which resulted in a decision for Miller's widow. Fourteen years later the same court stated, similarly, that bandleader Artie Shaw did not have any property interest in the Artie Shaw "sound" and that, absent unfair competition, others were free to copy and re-record the original arrangements.<sup>104</sup>

The underlying theory of these "imitation" decisions appears to be based on the reluctance of the courts to "segment" the copyright in the song. If the mere licensee of a song were permitted to bring suit, the ownership of copyright in the song would, in effect, be divided among any number of people. This would result, as the court noted in *Sinatra*, in confusion and reluctance among potential licensees to use the original song. The court, in *Supreme Records*, recognized this problem and addressed it with an analogy to the theatre:<sup>105</sup>

If recognition were given to the right of ownership in a musical arrangement . . . we would have to hold that Mr. Charles Loughton, for instance, could claim the right to forbid anyone else from imitating his creative mannerisms in his famous characterization of Henry VIII, or Sir Laurence Olivier could prohibit anyone else from adopting some of his innovations which he brought to the performance of Hamlet.

### CONCLUSION

It is evident that the arranger plays a significant role within the music industry. His expertise is necessary in the publishing, recording and performance of music. However, the reported cases have tended to show a general confusion concerning the exact function of an arranger and a lack of appreciation for his specific talents. The courts have encountered a great deal of difficulty when dealing with the originality aspect of musical arrangements. This difficulty has resulted in a lack of protection for many creative works.

The compulsory license section of the 1909 Act created a meas-

103. 11 App. Div. 2d 47, 201 N.Y.S. 2d 632 (1960), *aff'd*, 10 N.Y.2d 972, 224 N.Y.S. 2d 662, 180 N.E. 2d 248 (1961).

104. *Shaw v. Time-Life Records*, 38 N.Y.2d 201, 341 N.E.2d 817 (1975).

105. 90 F. Supp. 904, 909 (S.D. Cal. 1950).

ure of confusion which may be resolved by the 1976 Copyright Act. The new sections dealing with copyright protection for sound recordings have also helped clarify other murky areas within the 1909 Act. However, Section 114 which permits independent duplication of sound recordings should be given additional consideration to protect the arranger's product inasmuch as the current law affords no protection for musical arrangements in the field of sound recording.

Hopefully Congress will soon officially recognize the importance of the arranger's work in the field of popular music and enact legislation that will allow the arranger to realize performance royalties.

JOEL L. FRIEDMAN