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COMMENTARY

THE SOUND MARKS THE SONG: THE DILEMMAS OF DIGITAL SOUND SAMPLING AND INADEQUATE REMEDIES UNDER TRADEMARK LAW

*Michael L. Baroni**

I. INTRODUCTION¹

Digital sound sampling has revolutionized the music scene and fostered ethical controversy, legal ambiguity, ad hoc industry practices, and a plethora of litigation and rancorous settlements. It poses “excruciatingly difficult legal and moral questions.”² Sampling is a process whereby one can record, store, and manipulate a sound,³ either live or previously recorded; a process unlimited in scope: a cooing dove; a Jimi Hendrix guitar riff; the wind; the Beatles singing “She loves you, yeah, yeah, yeah;” a footstep; a brassy horn. Any sound can be isolated and become part of a new recording.⁴ For example, sampling makes it possible to arrange a single recording featuring Madonna’s voice, Eric Clapton on guitar, Phil Collins on drums, Louis Armstrong on trumpet, and James Browns’ screams as

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1. Portions of this paper have been borrowed from Michael L. Baroni, *A Pirate’s Palette: The Dilemmas of Digital Sound Sampling and a Proposed Compulsory License Solution*, 11 U. MIAMI ENT. & SPORTS L. REV. (1993).

2. Curt Suplee, *Snapshots of Sound*, WASH. POST, Oct. 25, 1987, at C3.

3. Molly McGraw, *Sound Sampling Protection and Infringement in Today’s Music Industry*, 4 HIGH TECH. L.J. 147 (1989).

4. Jon Pareles, *Digital Technology Changing Music*, N.Y. TIMES, Oct. 18, 1986, at C23.

background vocals.⁵ With sampling, one can create a symphony of sound and an infinite number of musical arrangements. The unauthorized sampling of another's musical expression from copyrighted sound recordings has developed, however, into a prolific practice in modern pop and rap music.⁶

The two competing concerns surrounding sampling are piracy and artistry; some view sampling as pure theft,⁷ while others view it as an essential vehicle for musical expression and development.⁸ The piracy-artistry controversy represents a struggle between the rights of artists to control uses of their own work, and the creative opportunities inherent in the new technology of sampling. In sum, "sampling is a pirate's dream come true and a nightmare for all the artists, musicians, engineers and record manufacturers."⁹

Currently, there are no definable criteria by which to regulate sampling use and infringement, and there is great uncertainty in the music industry concerning issues such as the legality of certain types of sampling, when to seek a license and how much to pay or demand for a given use. To date, although numerous cases have been filed, all have been settled or are still pending except one, and that case failed to address any of the issues which are most in need of definitive clarification.¹⁰ Because the "complexities of the problems

5. Incidentally, James Brown may be "the most-stolen-from artist in show business" due to sampling. Tom Moon, *Music Sampling or Stealing: Who Owns [the] Sounds of Music?*, ST. LOUIS POST DISPATCH, Jan. 24, 1988, at 3E.

6. See discussion *infra* part II.B.

7. Producer Tome Lord-Alge, whose collection of over two thousand samples includes Phil Collins playing drums and James Brown's screams, has stated, "[w]e're all blatantly stealing from everyone else. . . . That's just the way it's done in the '80s." Michael W. Miller, *Creativity Furor: High-Tech Alteration of Sights and Sounds Divides the Arts World*, N.Y. TIMES, Sept. 1, 1987, at 1. Peter Paterno, a music attorney who represents Guns N' Roses, has stated, "I think every one of those guys who samples is going to lose [in court]." John Horn, *Borrowed Performances May Get Rappers in Trouble*, DETROIT FREE PRESS, June 7, 1989, at 1B. Frank Zappa also believed that sampling is pure theft, and inserted a "no sampling" clause into the standard copyright infringement notice printed on his albums. Moon, *supra* note 5, at 3E.

8. Some, primarily those who exploit sampled material, regard sampling as a "postmodern art form," Jason H. Marcus, Note, *Don't Stop that Funky Beat: The Essentiality of Digital Sampling to Rap Music*, 13 HASTINGS COMM. & ENT. L.J. 767, 769 (1991), an "indispensable tool," Moon, *supra* note 5, at 3E, and a modern "instrument." Paul A. Harris, *Politics of Faith (No More, That Is)*, ST. LOUIS POST DISPATCH, Sept. 11, 1992, at 4F.

9. J.C. Thom, Comment, *Digital Sampling: Old-Fashioned Piracy Dressed Up in Sleek New Technology*, 8 LOY. ENT. L.J. 297, 336 (1988).

10. In *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182, 185 (S.D.N.Y. 1991), rapper Biz Markie was found to have infringed a copyright by sampling from Gilbert O'Sullivan's 1972 hit, "Alone Again (Naturally)." District Judge Kevin Duffy limited the issues in the case to the sole question of who owned the copyright to O'Sullivan's

presented by this new technology show that no easy solutions can be reached,"¹¹ people are currently searching for an adequate remedy to the dilemmas which sampling presents.¹²

Several theories have been advocated as potential remedies for the unauthorized sampling of sound recordings: the trademark theory¹³ of "sound marks"¹⁴ and section 43 of the Lanham Trademark Act of 1946 ("Lanham Act").¹⁵ My position in this commentary is, however, that neither of these theories provides adequate protection against unauthorized sampling, and that both theories fail to solve the problems that sampling presents to the music industry.

This commentary will explain the digital sound sampling process, its history and modern usage, and the effects of sampling on the music industry. It will then examine the application of trademark law to the unauthorized sampling of sound recordings and conclude that both the theory of sound marks and section 43(a) of the Lanham Act are inadequate remedies for solving the sampling quandary.

II. DIGITAL SOUND SAMPLING

A. Technical Process

To understand the sampling process, it is necessary to become somewhat familiar with the distinction between analog and digital sound. Analog music is a continuous waveform, similar to all natu-

song, because the defendants "knew they were violating . . . the rights of others." *Id.* Thus, the *Grand Upright* decision did not resolve any of the issues that "everyone's been waiting for," like fair use, parody, and indistinct or unrecognizable samples. John Leland, *The Moper v. The Rapper: A Lawsuit, Naturally*, NEWSWEEK, Jan. 6, 1992, at 55.

11. McGraw, *supra* note 3, at 169.

12. For example, the modification of industry licensing practices has been suggested. See, e.g., Sharon Colchamiro, Note, *To Clear or Not to Clear: Licensing Digital Samples*, 5 HOFSTRA PROP. L.J. 157 (1992); see also Thomas C. Moglovkin, *Original Digital: No More Free Samples*, 64 S. CAL. L. REV. 135 (1990) (discussing unfair competition, misappropriation, the right of publicity, and the right of attribution as potential causes of action against unauthorized sampling).

13. See *infra* part III.A.

14. A "sound mark" is a sound which, due to its distinctiveness, allows consumers to identify particular goods or services. See *infra* notes 102-07 and accompanying text. The theory of a sound mark as a remedy for unauthorized sampling was proposed to the author during a private discussion at the September 18, 1992 meeting of the Entertainment, Arts, and Sports Law section of the New York State Bar Association. Because this paper argues against the application of this theory, however, the identification of the proponent is withheld.

15. Lanham Trademark Act of 1946 § 43, 15 U.S.C. § 1125(a)(1) (Supp. 1992) [hereinafter Lanham Act]; see, e.g., Lori D. Fishman, *Your Sound or Mine?: The Digital Sampling Dilemma*, 4 ST. JOHN'S J. LEGAL COMMENT. 205, 218 (1989); Moglovkin, *supra* note 12, at 172-73.

rally occurring sounds. Natural or acoustic sound waves are created by fluctuations in air pressure which, through the use of a microphone, can be reduced to analogous fluctuations in electrical voltage.¹⁶ This process results in a smooth and continuous analog sound.¹⁷ Thus, analog recordings (traditional records and tapes) contain stored music that was recorded directly and fully as waveforms.

Digital music is created by recording and storing an outside sound source in a computer system.¹⁸ Whereas analog sounds are stored in the form of continuous waveforms, digital sounds are stored in the form of numbers.¹⁹ Therefore, when recording sound waves (either live or from preexisting recordings), a digital recording system must store a binary code description of the original analog waveform.²⁰ This conversion process from analog waveform to binary code is accomplished through an analog-to-digital converter, which measures the voltage of the analog signal at equally spaced intervals in time,²¹ generating a digital representation for each recorded interval.²² The resulting code for each interval is recorded on a digital master tape, and any subsequent copies *exactly* reproduce those numbers.²³ The computer, which is digitizing sound waves at intervals in time, is effectively slicing up the original analog sound into thousands of separate "samples" each second (hence the term sampling).²⁴ The original sound is now represented by numbers at intervals in time, resulting in the existence of a gap between any two digits.²⁵ The resulting computer code can then be fed into a digital-to-analog converter, or "desampler," to duplicate the original sound waves, or, the computer code can be manipulated to produce altered sounds when converted to sound waves.²⁶

16. Thomas D. Arn, Comment, *Digital Sampling and Signature Sound: Protection under Copyright and Non-Copyright Law*, 6 U. MIAMI ENT. & SPORTS L. REV. 61, 64 n.17 (1989).

17. *Id.*

18. *Id.* at 64.

19. *See id.*

20. *See* Ronald M. Wells, Comment, *You Can't Always Get What You Want But Digital Sampling Can Get What You Need!*, 22 AKRON L. REV. 691, 699 (1989).

21. *Id.* at 699.

22. *Id.* at 700.

23. Seligman, *Saved! Classic Rock Tracks Kept Forever Young on C.D.*, 482 ROLLING STONE 81, 82-83 (1986), *cited in* Thom, *supra* note 9, at 297.

24. Arn, *supra* note 16, at 65.

25. C. DODGE & T. JERSE, *COMPUTER MUSIC: SYNTHESIS, COMPOSITION AND PERFORMANCE*, 25-31 (1985), *cited in* Arn, *supra* note 16, at 64-65 n.17.

26. 1990 A.B.A. Comm. Rep. Section of Patent, Trademark and Copyright Law 158, 160 (1990).

Digital sound sampling is analogous to motion picture recording: a consecutive series of still photos are taken at small intervals, rather than the whole action being captured at one time.²⁷ The best samplers can sample at the rate of 100,000 times per second,²⁸ so there is no loss of fidelity and no aural distinction between the original sound and the sample; that is, the original sound and the sample are identical to the human ear.

Although digital samplers can manipulate any sound they record by rearranging or replacing the binary codes, the scope of manipulation is limited. "[T]he sounds which digital sampling allows a musician to produce are tied to, and dependent upon, the intricacies of sound captured on the underlying analog recording."²⁹ Thus, although there is "a range of potential manipulation, the sound that goes in is the sound that comes out."³⁰ Digital samplers can only alter the pitch, duration, or sequence of a sampled sound, give it more or less echo, repeat it in any rhythm, or combine it with other sounds.³¹ The reason that the sounds produced through sampling are dependent upon the original sounds is because sampling cannot manipulate timbre (distinctive tonal qualities).³² It is precisely this fact—that sampling clones the unique tonal qualities of a given sound—that makes it such a popular artistic tool.³³

B. *History And Modern Usage*

Digital machinery has advanced quite rapidly. The Fairlight CMI, with synthesizer capabilities and the capacity to digitally record sounds, appeared in 1975 and was the first major digital sampler.³⁴ The first sampler with keyboard control (giving it the ability to manipulate sampled sounds) appeared in 1981.³⁵ The first inex-

27. Suplee, *supra* note 2.

28. See, e.g., Jon Pareles, *Digital Technology Changing Music*, N.Y. TIMES, Oct. 16, 1986, at C23 (stating that the Synclavier digital sampler can sample up to 100,000 times per second); Matthew Smith, *The Sounds of Science: Stretching the Definition of the Term Musical Instrument*, L.A. TIMES MAG., June 28, 1987, at 27 (same). For example, in one second the musical phrase "She loves you, yeah, yeah, yeah" could be sampled roughly 33,000 times, and the entire two minute, nineteen second song would require approximately 13,900,000 separate samples.

29. Arn, *supra* note 16, at 66.

30. *Id.* at 66 n.24.

31. See Miller, *supra* note 7, at 1.

32. Arn, *supra* note 16, at 65.

33. *Id.* at n.21.

34. McGraw, *supra* note 3, at 149 (citing G. VELTON, *THE ROCK SYNTHESIZER MANUAL* 102 (1986)).

35. Pareles, *supra* note 28.

pensive sampler, at a cost of approximately \$1700, appeared in 1985.³⁶ Today, samplers with limited capabilities can be purchased for as low as \$70.³⁷ Presently, the most advanced digital sampler is the Synclavier (used by the likes of Stevie Wonder and Frank Zappa), which costs over \$300,000 and has a sampling rate of over 100,000 times per second.³⁸

The art of sampling, born out of poverty, had its birth in the Bronx, New York.³⁹ It made its debut in the early 1980's, as disc jockeys and music mixers began piecing together different recordings and using a variety of other techniques, such as "scratching"⁴⁰ and "looping,"⁴¹ to create a new dance atmosphere⁴² at parties and playgrounds.⁴³

Modern usage of samples is rampant and has become a "common practice."⁴⁴ It is central to rap music, a billion-dollar-a-year industry,⁴⁵ and has been a driving force behind the albums of pop stars such as Vanilla Ice and Janet Jackson.⁴⁶ Today, "almost every pop record contains at least one sampled sound,"⁴⁷ and many albums contain dozens.⁴⁸

Sampling has also resulted in a whole new profession of electronic music makers and mixers, commonly referred to as "programmers." Programmers are often employed by a record company or an

36. *Id.*

37. McGraw, *supra* note 3, at 149 & n.17.

38. *Id.* at 149 n.15; *see supra* note 28 and accompanying text.

39. Sheila Rule, *Record Companies are Challenging 'Sampling' in Rap*, N.Y. TIMES, Apr. 21, 1992, at C13.

40. "Scratching" is the process by which a needle is scratched over a vinyl record "creating an audible sensation." *See* Marcus, *supra* note 8, at 770 n.9.

41. "Looping" is the process "of editing a sampled sound to connect its endpoint to its beginning[;] . . . [a]n electronic version of the traditional tape loop." WAYNE WADHAMS, *DICTIONARY OF MUSIC PRODUCTION AND ENGINEERING TECHNOLOGY* 130 (1988). Thus, through "looping" the underlying beat is continually played, or "looped."

42. *Sampling: Fair Play or Foul?*, THE FIRM NEWSLETTER #9 (Jacobson & Colfin, New York, N.Y.), 1991, at 2.

43. Rule, *supra* note 39, at C13.

44. Leland, *supra* note 10.

45. *See* Rule, *supra* note 39, at C13.

46. *See* Leland, *supra* note 10, at 55. Also, one genre of music, "house music," which has sprung up from the nightclub scene, makes substantial use of samples. *See* Jeff Borden, *The New Chicago Sound: House Music Labels Spin Around the Globe*, CRAINS CHICAGO BUS., Dec. 14, 1992, at 15.

47. Moon, *supra* note 5, at 3E.

48. Leland, *supra* note 10. In the BILLBOARD magazine's album and review sections, one can find over one hundred references in the last year (11/91 - 11/92) to samples in newly released recordings. Common descriptions used include "sample laden," "sample happy," "sample ridden," a "mind blowing blitz" of samples and a "dazzling display" of samples.

album producer to contribute to the recording process.⁴⁹ Sometimes, programmers are the sole composers of a musical work.⁵⁰ Each programmer seeks "to build a library of sounds on which he can base his commercial viability. . . . [A] programmer is valued by the extent of his library and his ability to manipulate the sounds recorded therein."⁵¹ Programmers acquire their libraries from live studio sessions⁵² and preexisting recordings.⁵³ The demand for samples of popular musicians and atypical sounds has become so high that a black market has emerged in recording studios.⁵⁴ "Sound collecting has become a frenzied sport," with engineers "swapping sounds like baseball cards."⁵⁵ Some programmers view their trade as a modern art form. Arthur Baker, one of the "kings of audio cut and paste," has been quoted as saying that "[sampling] is a new form of music, just like collages. . . . [I]f you like [a] sound, you can have the sound."⁵⁶

There are enormous benefits to sampling, as opposed to the use of live musicians. Producers who use samples reap huge benefits, both financially and through increased creative reputation, at little or no personal expense of time, talent, money, or original artistic creativity.⁵⁷ Without sampling technology, a producer searching for a particular sound would have to hire musicians with the right instruments for a studio session and hope that they get the right intonation.⁵⁸ With sampling, however, one can record a string of notes and electronically manipulate the recorded, digitized sounds to closely approximate the combination that one is after, or simply lift

49. Maura Giannini, Note, *The Substantial Similarity Test and its Use in Determining Copyright Infringement Through Digital Sampling*, 16 RUTGERS COMPUTER & TECH. L.J. 509, 511 (1990).

50. See *id.* at 512.

51. *Id.* at 511.

52. *Id.*

53. Giannini, *supra* note 49, at 511, 512 (stating that "[f]requently, [samples] . . . are merely lifted from a pre-existing recording," and that "in the recording industry today, the use of sounds lifted from pre-existing recordings is widespread and growing"); e.g., note the Led Zeppelin example, *infra* note 59 and accompanying text.

54. Arn, *supra* note 16, at 68 n.34 (citing S. Dupler, *Digital Sampling: Is it Theft? Technology Raises Copyright Question*, BILLBOARD, Aug. 2, 1986).

55. Moon, *supra* note 5, at 3E.

56. McGraw, *supra* note 3, at 152 (citing Miller, *supra* note 7, at 1). Baker's allusion to collages may be considered unfortunate because previously published images used in collages "are not clearly unprotected by copyright law." *Id.* at 152 n.38. Collage artists such as Andy Warhol have been sued for the unauthorized use of copyrighted materials in their works. *Id.*

57. Cf. Moglovkin, *supra* note 12, at 141.

58. Cf. McGraw, *supra* note 3, at 152 (asserting that, with sampling, "there is less need to hire musicians on individual instruments" and that "sampling threatens the employment of studio and concert performers").

the desired sound, if it exists, from another recording. Producer/remixer Freddie Bastone has stated:

[i]n some cases, you use a sample because it's a really unique sound you want and it would be impossible to get otherwise, like [John] Bonham's kick drum . . . from the Led Zeppelin album "Houses of the Holy" . . . [Y]ou could probably, with a lot of setup and experimentation, get the sound you are after. But it is so much faster to use a sample.⁵⁹

In another high-profile case of sampling, the sounds of musician David Earl Johnson's eighty-year-old African conga drums were sampled in a studio by composer Jan Hammer and became prominently featured in the theme song of the hit television show "Miami Vice."⁶⁰ Johnson has stated, "those congas are way up front because they are so unique. I'd like to get paid for that. If your work is used, you should get paid. He's got me and my best sounds for life, and there is no compensation."⁶¹

The effects of digital sampling on music have been dichotomous. Sampling has allowed whole new genres of music to develop, yet has also been the driving force behind destruction of the artistic base. Sampling has clearly promoted new forms of music⁶²—rap, hip-hop, and house music would not have developed without it—and has played a very influential role in pop music.⁶³ Sampling has, however, adversely affected the music industry because it has diminished the importance of studio and concert musicians.⁶⁴ Furthermore, it has diminished the value of distinctive musical artistry because sounds can be readily snatched from prerecorded material and rendered commonplace. Simply put, "musicians in America are being put out in the cold."⁶⁵

59. Giannini, *supra* note 49, at 511 n.13 (citing S. Dupler, *Digital Sampling: Is It Theft? Technology Raises Copyright Question*, BILLBOARD, Aug. 2, 1986, at 74).

60. Giannini, *supra* note 49, at 511 n.10.

61. *Id.*

62. Rule, *supra* note 39.

63. It is important to note that subjective opinions of whether or not music such as rap or house is "art" are irrelevant in determining the "promotion" of the arts. *See, e.g.*, *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251-52 (1903) (holding that copyrightable "authorship" should not be judged by standards of merit).

64. *See* Jon Pareles, *Lawsuits Seek Truth in Music Labeling*, N.Y. TIMES, Dec. 6, 1990, at C17; Pareles, *supra* 28 (stating that "sampling threatens the employment of studio and concert performers").

65. Wells, *supra* note 20, at 691. "Many previously sought after musicians who have created a distinctive sound for themselves are now being undersold by samples of their own work." *Id.* at 700. Sampling has "pushed time honored instruments into the background and

Another by-product of sampling is the creation of the "modern musician." Many of today's "major artists," such as New Kids On The Block, do not play an instrument,⁶⁶ and some do not even sing (remember the Milli Vanilli scandal?).⁶⁷ Anyone who has ever attended a pop or rap concert or watched a music awards show has most likely witnessed the use of digitally prerecorded tracks. As a result, more performers have come to rely on visual presentation, as opposed to musical talent.⁶⁸ Sampling "has made it easy for no-talents to steal the creative work and sounds of their betters."⁶⁹

The future effects of sampling seem to be that pop and rap are becoming increasingly redundant. Perhaps all the computer-driven, sound-alike music which has flooded today's market will create a greater desire for authentic music. As one music critic has commented, "[i]n an era when so many acts employ digital sampling and machine-generated rhythms to make music that sounds as if it were written in an oscilloscope, it's a relief to find a band that uses the traditional lineup [of instruments]."⁷⁰

III. TRADEMARK AND DIGITAL SOUND SAMPLING

The trademark theory of sound marks has been suggested as a potential remedy for solving some of the music industry's predicaments and the rampant ambiguity inherent in the application of current copyright law to unauthorized sampling.⁷¹ Upon examination, however, it is clear that trademark law, and in particular the theory of sound marks, is inadequate to deal with the legal and practical issues surrounding sampling.

put thousands of string, brass and woodwind players out of work." Jonathan Takiff, *High Tech and Art*, ST. LOUIS POST DISPATCH, May 5, 1988, at 4F.

66. See Chuck Philips, *Read Their Lips: Are Madonna, New Kids on the Block and Milli Vanilli Singing Live or Lip Synching in Concert? Some Legislators Say it's Time for Answers*, L.A. TIMES, June 10, 1990, at 57.

67. In 1990, Milli Vanilli, a popular pop music duo, was stripped of its Grammy Award for Best New Artist when the pair admitted that they had not sung a single note on their album. See Jon Pareles, *Wages of Silence: Milli Vanilli Loses A Grammy Award*, N.Y. TIMES, Nov. 20, 1990, at C15.

68. See *id.* ("Through video clips, Mr. Morvan and Mr. Pilatus, [the duo that comprise Milli Vanilli], became pop icons with their waist-length dreadlocks and their energetic dancing.")

69. Takiff, *supra* note 65.

70. Mark Jenkins, *Gilded Eternity: Time in a Loop*, WASH. POST, Apr. 27, 1990, at N25.

71. See, e.g., Moglovkin, *supra* note 12; Colchamiro, *supra* note 12.

A. Trademark Theory

A trademark is any word, name, symbol, device or any combination thereof that is used to identify and distinguish one's goods or services from those of competitors.⁷² A trademark is used to indicate the source of those goods or services, even if that source is anonymous.⁷³ In order to function as a trademark, the mark must create a separate impression from the product itself. Trademarks serve not only to protect consumers, by enabling them to identify preferred goods, but also as an incentive for corporate investment, which allows for the development and maintenance of the company's goodwill and product improvement.⁷⁴

Service marks are like trademarks, except that they identify and distinguish services rather than products. Examples are Amtrak, McDonald's, and Delta Airlines. To function as a service mark, one must be able to distinguish between a given service and a sale of goods.⁷⁵ Services which merely promote, sell, advertise or build goodwill for a product cannot function as service marks⁷⁶ because there is no separately identifiable "service."

Ownership of trademarks is acquired through actual, bona fide use of the mark in commerce. A mere token use, to simply "reserve"⁷⁷ a trademark for potential later use, will not suffice. In *Blue*

72. See, e.g., Judy A. Willis, *The Life and Death of a Trademark*, 251 PLI/Pat 7 (PLI Order No. G4-3815) (June 13, 1988).

73. See Lanham Act § 45, 15 U.S.C. § 1127 (1988).

74. Lars H. Liebler, *Trademark, Economics and Grey-Market Policy*, 62 IND. L. J. 753, 754-55 (1986). "Trademarks protect both the consumer and the markholder. A trademark serves to: (1) identify and distinguish goods; (2) indicate the source of origin of the goods; (3) assure that all goods are of equal quality; (4) promote investments in quality and advertising by the markholder; and (5) represent goodwill." *Id.* at 755 (citing 3 RUDOLF CALLMANN, UNFAIR COMPETITION, TRADEMARKS & MONOPOLIES § 17.01-.04, at 1-20 (4th ed. 1983 & Supp.)); 1 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 3:1(B), at 104-05 (2d ed. 1984).

75. *In re Tampax*, 91 U.S.P.Q. 215 (Dec. Comm'r Pat. 1951) (stating that merely advertising one's own goods is not a service so as to qualify for a service mark).

76. See *In re Dr. Pepper Co.*, 836 F.2d 508, 511 (Fed. Cir. 1987) ("Pepper Man" was denied registration as a service mark because it was associated purely with a promotional event for the beverage, and was not a separately identifiable service from the product).

77. Some companies, for example, will obtain registration of a mark based on a minimal use and then attempt to "warehouse" or "reserve" the mark for future use by holding off on actual, bona fide use and the sizeable investment that marketing a new product entails until a decision is made whether or not to fully launch the new product (which could be never). See, e.g., *Proctor & Gamble Co. v. Johnson & Johnson, Inc.*, 485 F. Supp. 1185 (S.D.N.Y. 1979) (holding that because Proctor & Gamble was simply "warehousing" marks, and lacked a bona fide, present intent to use them, it had abandoned its claim to them).

Bell, Inc. v. Farah Manufacturing Co.,⁷⁸ for example, it was held that an internal corporate shipment of a product bearing a mark was insufficient to constitute a valid use of the mark such that trademark protection would attach.⁷⁹ Rather, sales of the product bearing the mark had to have been made to the public.⁸⁰

The first user of a mark is granted the right to prohibit others from using a similar mark for similar goods or services. Diligent policing and enforcing by users, however, is essential to preserve their rights in marks. The duration of ownership for a valid⁸¹ trademark can be perpetual, so long as the mark is not abandoned⁸² and it has not become generic.⁸³

To establish infringement of a trademark, a plaintiff need not prove actual consumer confusion as to the source of the products; only a likelihood of confusion, mistake or deception must be shown.⁸⁴

78. 508 F.2d 1260, 1263 (5th Cir. 1975).

79. *Id.* at 1265.

80. *Id.* at 1265-66.

81. See Lanham Act § 2(a)-(e), 15 U.S.C. § 1052(a)-(e) (1988) (setting out requirements for a valid trademark). For example, marks which are "immoral, deceptive, scandalous" or disparaging cannot gain status as a valid trademark. *Id.* § 1052(a). Section 14(3) of the Act, 15 U.S.C. § 1064(3) (1988), also provides that one may petition to cancel the registration of a mark which has become generic or abandoned, or if it was obtained through fraud.

82. See Lanham Act § 45, 15 U.S.C. § 1127 (1988), for the definition of abandonment, which provides that any conduct by a mark owner which causes the mark to "lose its significance" can deem that mark to be classified as "abandoned." Implicit in this definition is the failure to prevent others from using the same or a confusingly similar mark.

Additionally, a mark will be considered "abandoned" when its use has been discontinued with no intent to resume use in the foreseeable future. *Id.* Under § 45, "[n]on-use for two consecutive years shall be prima facie evidence of abandonment," and trivial interim use in an attempt to merely "reserve" the mark is insufficient to maintain ownership of the mark. *Id.* In *Silverman v. CBS Inc.*, 870 F.2d 40, 46 (2d Cir. 1989), for example, it was held that CBS had abandoned the "Amos 'n' Andy" marks on the grounds that the marks had not been used in 21 years and there were no plans within the foreseeable future to resume use.

83. A mark is generic if the public associates it with a *class* of goods and not as an identifier for a particular product. *Quality Inns Int'l, Inc. v. McDonald's Corp.*, 695 F. Supp. 198, 211 (D. Md. 1988). Examples of marks which have become generic and have thus entered the public domain are aspirin, cellophane, thermos, and escalator. *Id.*

To protect a mark from becoming generic, it should never be used as a verb or noun, but always as an adjective. For example, the following constitutes incorrect trademark usage: "I need to Xerox this page"; the correct usage would be: "I need to copy this page on the Xerox photocopier." In other words, the owner of a trademark does not want its mark to be used as an identifier for a general type of product or service because this could render the mark generic and, hence, unprotectable.

84. The "likelihood of confusion" standard is derived from Lanham Act § 32, 15 U.S.C. § 1114 (1988 & Supp. 1992), and Lanham Act § 43, 15 U.S.C. § 1125(a) (1988). "Confusion occurs when consumers make an incorrect mental association between the involved commercial products or their producers." *Jordache Enters., Inc. V. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1484 (10th Cir. 1987) (quoting *San Francisco Arts & Athletics, Inc. v. United States*

A plaintiff must show that a defendant is using a mark that is identical or confusingly similar to plaintiff's mark in order to identify goods or services of a similar class.⁸⁵

Although a trademark can be registered federally if it is utilized in interstate commerce, it can also be registered for protection in any state in which it is in use.⁸⁶ The Lanham Act is therefore not necessarily preemptive of state statutes. Federal registration, however, confers certain benefits, such as national protection, constructive notice of ownership,⁸⁷ incontestability status,⁸⁸ treble damages and attorney's fees.⁸⁹

There are six forms of trademarks: (1) Word marks: such as Tide, Crest, Honda; (2) design marks, such as the Gerber baby, Golden Arches, and Prudential rock; (3) slogans, such as United: "Fly the friendly skies," American Express: "Don't leave home without it;" and Coca Cola: "Coke is it!;" (4) initials and numbers, such as 7 Eleven, NBC, CBS, ABC, 007, VO 5; (5) shapes, such as the L'eggs stocking egg, the Pinch scotch bottle; and (6) sensory marks (sounds and smells), such as Screen Gems, The Music of Your

Olympic Comm., 483 U.S. 522 (1987)). Some factors that are considered in determining whether there is a likelihood of confusion between two marks include:

- (a) the degree of similarity between the designation and the trade-mark or trade name in
 - (i) appearance;
 - (ii) pronunciation of the words used;
 - (iii) verbal translation of the pictures or designs involved;
 - (iv) suggestion;
- (b) the intent of the actor in adopting the designation;
- (c) the relation in use and manner of marketing between the goods or services marketed by the actor and those marketed by the other;
- (d) the degree of care likely to be exercised by the purchasers.

Id. (citations omitted).

85. There have been cases, however, where the product class is the same and the mark is nearly identical, yet the use was held non-infringing, due to equitable considerations. See *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 967-68 (2d Cir. 1981) (where the defendant's mark "Bravos" for tortilla chips was held not to infringe the plaintiff's mark "Bravo's" for its round crackers. One of the grounds for the decision, *inter alia*, was that, since the products catered to different markets, there was no likelihood of confusion).

86. Interstate commerce is defined very broadly. The Stork Club, for example, located in New York, was able to enjoin use of its name in California, based merely on its interstate reputation. *Stork Restaurant, Inc. v. Sahati*, 166 F.2d 348 (9th Cir. 1948).

87. Lanham Act § 22, 15 U.S.C. § 1072 (1988).

88. See Lanham Act § 15, 15 U.S.C. § 1065 (1988) (a person that may be damaged by registration of a mark must file an opposition within a limited time before the mark is registered).

89. Lanham Act § 35, 15 U.S.C. § 1117(a), (b) (1988).

Life⁹⁰ or a floral fragrance used on yarns and embroidery threads.⁹¹

There are four categories of trademarks: (1) marks with no independent meaning, also known as "coined" marks; (2) arbitrary marks; (3) suggestive marks; and (4) descriptive marks.⁹² The strength of such marks depends on their distinctiveness. Marks may be inherently distinctive or may acquire distinctiveness through secondary meaning.⁹³ However, distinctive marks are always automatically protectable.

A coined mark has no independent meaning, such as Exxon and Kodak,⁹⁴ and is the strongest class of marks. An arbitrary mark, on the other hand, does have a common meaning although the meaning has no actual connection to the product.⁹⁵ Products with arbitrary marks include Camel cigarettes, and Mustang cars.⁹⁶ Suggestive marks are those which do not directly describe the product, but rather allude to an association between the mark and the product, requiring thought and imagination to make that association.⁹⁷ Examples of suggestive marks include Coppertone suntan lotion and Ivory dishwashing liquid.⁹⁸ Suggestive marks are presumed to be inherently distinctive and are thus automatically protectable. Finally, descriptive marks are those that directly describe the product, its ingredients or qualities, such as Pudding Pops, and Shake 'N Bake.⁹⁹

90. See Willis, *supra* note 72.

91. *In re Clarke*, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990). The Board upheld registration for a "high impact, fresh, floral fragrance, reminiscent of Plumeria blossoms" on the grounds of secondary meaning, see *infra* note 93, and because "fragrance is not an inherent attribute or natural characteristic of [the] applicant's goods but is rather a feature supplied by [the] applicant." *Id.* at 1239-40. Trademark law does not protect components which are not wholly separable from the product itself; any component which is actually an inherent part of the product, and not used merely as a mark to identify that product, is deemed "functional." See *id.* at n.4.

92. Willis, *supra* note 72.

93. Secondary meaning arises "when a mark has come to signify that an item is produced or sponsored by a particular merchant [brand of product]." BLACK'S LAW DICTIONARY 1351 (6th ed. 1990). Marks which are not inherently distinctive, but which are "capable of distinguishing applicant's goods or services . . . may be registered on the supplemental register." 15 U.S.C. § 1091(a) (1988). Thus, one may register a mark on the Supplemental Register and hope for that mark to attain distinctiveness through secondary meaning. See, e.g., *Metro Kane Imports, Ltd. v. Federated Dep't Stores, Inc.*, 625 F. Supp. 313, 316 (S.D.N.Y. 1985) (suggesting that "where secondary meaning is 'in the making' but not yet developed, a trademark or trade dress will be protected against intentional, deliberate attempts to capitalize on a distinctive product").

94. Willis, *supra* note 72.

95. *Id.*

96. *Id.*

97. See *id.*

98. *Id.*

99. *Id.*

Descriptive marks, are not inherently distinctive. As a result, they must attain secondary meaning through marketplace use before they will be protected as trademarks.

Some marks, such as generic words, are never subject to protection. For example, no one beer company can monopolize the right to use "light" (or anything similar, such as "Lite"), to describe its beer.¹⁰⁰ Permitting monopolization of common words would be unfair to competitors.

Whereas most marks consist of something optically observed, sound marks identify and distinguish products and services through aural perception.¹⁰¹ Sound marks were first granted federal registration on the Principle Register on April 4, 1950.¹⁰² It was at this point that the register realized that sound could function as an indicator of source.¹⁰³ Undoubtedly, the most recognized sound mark is NBC's three chime-like musical notes used during its television and radio station identification.¹⁰⁴ The requirements for registration of a sound mark are the same as for any other trademark; a sound may be registered as a trademark or service mark¹⁰⁵ if it identifies the source of goods or services.¹⁰⁶ Most sound marks will be registered as

100. *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 81 (7th Cir. 1977) (holding that neither "Light" nor its phonetic equivalent may be appropriated as a trademark for beer because it is a generic descriptor of a genus of beer).

101. See TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1301.01(d) (1st ed. 1986) (defining a "sound mark" as identifying and distinguishing services through audio rather than visual means).

102. Walter J. Derenberg, *The Second Year of Administration of the Lanham Trade-Mark Act of 1946*, 39 TRADEMARK REP. 651, 655 (1949); see Principle Reg. No. 523,616, issued April 4, 1950.

103. At least as early as September of 1949, however, it was recognized that sound marks could be "registerable as service marks if they function[ed] as such." Derenberg, *supra* note 102, at 655.

104. Moon-Ki Chai, *Protection of Fragrances Under the Post-Sale Confusion Doctrine*, 80 TRADEMARK REP. 368, 372 (1990). The NBC chime-like notes were registered as a service mark. See Principle Reg. No. 916,522, issued July 13, 1971. Sound mark registrations are rare. Those marks granted federal registration are: (1) the recorded sound of the Liberty Bell ringing (registered by the Bulletin Company, Reg. No. 548, 458); (2) the sound of a creaking door (registered by Himan Brown for the radio program "Inner Sanctum," Reg. No. 556,780); and (3) the musical notes E flat, B flat, G, C, F, electronically reproduced (registered by the American Broadcast Companies, Reg. No. 928,479). Canada has also granted registration for a sound mark: "a burst of eleven rapidly played musical notes," registered by Capitol Records for use in association with, among other things, phonograph records, audio and video tapes. George Gottlieb, "*In Case You Missed It . . .*," 62 TRADEMARK REP. 605, 606 (1972).

105. A sound is capable of being registered as either a trademark or service mark. 1 MCCARTHY, *supra* note 74, § 7:37, at 279.

106. A trademark or service mark functions to identify goods and services. *Id.* § 3:2, at 105.

service marks, which usually identify the entertainment services of a television or radio company because it is impractical to identify and distinguish a product by a sound. To be protectable, a sound mark must create an association between the sound and the service, either through advertisements or actual performance. A sound mark must also be distinctive, either inherently or through secondary meaning, since it:

depends upon [the] aural perception of the listener which may be as fleeting as the sound itself unless, of course, the sound is so inherently different or distinctive that it attaches to the subliminal mind of the listener to be awakened when heard and to be associated with the source or event with which it is struck.¹⁰⁷

In *In re General Electric*,¹⁰⁸ for example, the Trademark Trials and Appeals Board¹⁰⁹ held that the sound of a ship's bell clock could not function as a service mark for radio broadcast services because the sound was not inherently distinctive and secondary meaning had not been proven.¹¹⁰ The Board stated that sound is an acceptable type of "device" to identify and distinguish one's services only where that sound is associated with a specific service in the mind of the consumer.¹¹¹ The Board further specified that "unique, different, or distinctive" sounds do not need proof of secondary meaning, but that "commonplace" sounds would require evidence of secondary meaning in order to show that the sound had become a distinctive indicator of source.¹¹²

B. *Sound Marks And Digital Sound Sampling*

Given that sound marks may serve as a means of identifying and protecting distinctive sounds,¹¹³ it would seem that they offer a viable theory for protection against unauthorized sampling from sound recordings. Under this theory, sound marks could conceivably

107. *In re General Elec. Broadcasting Co.*, 199 U.S.P.Q. 560, 561 (T.T.A.B. 1978).

108. *Id.*

109. Section 17 of the Lanham Act, 15 U.S.C. § 1067 (1988), provides that the Trademark Trial and Appeal Board shall determine and decide disputes regarding the respective rights of a given registration. Beyond that, one may appeal the decisions of the Board by filing an appeal with the United States Court of Appeals for the Federal Circuit. 15 U.S.C. § 1071(a) (1988). Alternatively, a civil action is available in federal district court. *Id.* § 1071(b).

110. *See supra* note 93, for a definition of secondary meaning.

111. *In re General Electric*, 199 U.S.P.Q. at 563.

112. *Id.*

113. *See supra* text accompanying notes 103-12.

be registered as service marks for entertainment services, or as a trademark for a recorded song. The sound mark theory, however, could only apply to those sampled sounds which either are inherently distinctive or have acquired distinctiveness through secondary meaning.

Many sounds are sampled precisely because of their inherently distinctive quality, and these unique sounds are often used as the "hook" for a new song. Therefore, those seeking to apply the sound mark theory would argue that the sampler, by having taken a unique sound and used it in a new recording, has created a likelihood of confusion between the original source of that sound and the new recording.¹¹⁴ For example, those hearing the distinctive hook of the song "Ice, Ice, Baby," performed by Vanilla Ice, might credit the source of those sounds to Vanilla Ice,¹¹⁵ when in reality it was sampled from the Queen/David Bowie song "Under Pressure."¹¹⁶ As another example, on the record "The Best of the Ink Spots,"¹¹⁷ each song is preceded with the same or a highly similar string of notes.¹¹⁸ Thus, if any artists used those same notes as a prelude to their songs, the owners of the Ink Spots' sound recordings could theoretically pursue recovery under a trademark theory on the basis that the unauthorized use created a likelihood of confusion as to the source of that sound, thereby infringing the sound mark. As a further illustration, the rap group Naughty by Nature could argue for the application of sound mark protection to the inherently distinctive two-note hook of their song "O.P.P." They might thereby gain protection for sounds which would normally be unprotectable under copyright law.¹¹⁹ However, although the sound mark theory appears to offer an

114. Recall that the infringement standard for trademarks is whether or not there is a "likelihood of confusion" between two marks. See *supra* note 85 and accompanying text.

115. Even if a listener did not know that the song was being performed by Vanilla Ice, however, the point is that the listener could attribute the source of those sounds to someone other than the original source, e.g., Queen and David Bowie.

116. Note, *A New Spin on Music Sampling: A Case for Fair Pay*, 105 HARV. L. REV. 726, 728 n.10 (1992).

117. MCA Records (1980).

118. See *id.*

119. Two notes are uncopyrightable because a taking of only two notes is generally considered de minimis. *United States v. Taxe*, 380 F. Supp. 1010, 1014 (C.D. Cal. 1974), *aff'd in part, vacated in part on other grounds*, 540 F.2d 961 (9th Cir. 1976); cf. *Marks v. Leo Feist, Inc.*, 290 F. 959, 960 (2d Cir. 1923) (holding that the use of six bars from a composition out of a total of 450 bars was not substantial and, thus, not copyright infringement); *Anheuser-Busch, Inc. v. Elsmere Music, Inc.*, 633 F. Supp. 487, 495 (S.D.N.Y. 1986) (ruling that copying the four notes and their accompanying rhythm in the final bar of an advertising jingle was not copyright infringement). *But cf. Elsmere Music, Inc. v. National Broadcasting Co., Inc.*,

alternative remedy for the protection of distinctive sounds, it has theoretical and practical failings and would not solve any of the dilemmas which sampling currently presents to the music industry.

C. *Theoretical Failings of the Sound Mark Theory As Applied to Sampling*

Applying a sound mark theory to sampling is contrary to the purposes and requirements of trademark law. As stated earlier, a primary purpose of trademark law is to indicate the source of a product or service even if that source is anonymous, in order to protect both consumers and the goodwill of the manufacturer.¹²⁰ Distinctive sounds in a record,¹²¹ however, never function as indicators of the source because, when consumers purchase records, they generally make purchasing decisions on the basis of packaging information only. In other words, an artist's name, picture or likeness will indicate the source of a record. If one wants a Madonna recording, for example, one will buy a recording which is clearly labeled "Madonna." In no way does the consumer identify the record which he or she wants by the individual sounds inside because the sounds on a record are imperceivable until after the purchase.¹²²

In certain contexts, distinctive sounds can identify the source of a given product or service. For example, a song on the radio may be identified each time it is heard due to its distinctive sounds, even though the listener may not know the identity of the performer. That

482 F. Supp. 741, 744 (S.D.N.Y. 1980) (holding that the copying of four notes from advertising jingle in a parody of such jingle was not de minimis and, therefore, was capable of being copyright infringement), *aff'd per curiam*, 623 F.2d 252 (2d Cir. 1980); *Boosey v. Empire Music Co.*, 224 F. 646, 647 (S.D.N.Y. 1915) (the use of merely six notes and words from plaintiff's song was held to be an infringement). Additionally, the Copyright Act considers "the amount and substantiality of the portion used in relation to the copyrighted work as a whole" in determining whether a use may be deemed "fair." 17 U.S.C. § 107(3) (1988 & Supp. 1992). Note that although a sampling of a few notes may not infringe the composition copyright, it may infringe the sound recording copyright since copyright protects "original works of authorship" and each recorded expression of a musical composition is inherently unique. *See id.* § 102(a)(7) (1988 & Supp. 1992).

120. *See supra* notes 72-74 and accompanying text.

121. The term "records" is hereinafter used to refer to "any device, now or hereafter known, on or by which sound only may be recorded and reproduced and which is manufactured or distributed primarily for home and/or consumer and/or jukebox use and/or for use on or in means of transportation." David A. Braun, *The Phonograph Record Industry*, in ENTERTAINMENT LAW 2 (Howard Siegel ed., 1989).

122. This is becoming less true today as record stores are equipping their facilities with electronic stations that allow buyers to preview a whole CD or a part thereof before even making a purchase.

is irrelevant, however, to actually making an attempt to purchase that song in the marketplace, which is where trademark protection concerns begin.¹²³ When a consumer wishes to purchase a record containing certain appealing sounds, that consumer will first determine the source of the sounds and then purchase the record. Thus, distinctive sounds in records cannot gain sound mark protection because those sounds are incapable of identifying the product at the time that a consumer is making a purchasing decision. Identification of the source of a sound is a prerequisite for—and the very foundation of—trademark protection.

As previously discussed, the infringement standard for trademarks is whether or not a given use of a mark creates a likelihood of confusion as to the source of that product.¹²⁴ Sampled sounds, however, never create a likelihood of confusion necessary for an actionable claim under trademark law. Even if a consumer is confused as to the source of certain sounds when hearing samples in a song, the consumer is nonetheless not confused about the source of the entire recording. For example, one could hear the song "Jump Around" by the rap group House of Pain and subsequently purchase the record while thinking that the sounds in "Jump Around" were independently created during the production of the record. In reality, however, the hook sound is a sample from the song "Harlem Shuffle," performed by Bob & Earl. Although House of Pain may be exploiting the goodwill and talent embodied in the Bob & Earl song, there is no likelihood of confusion as to the source of that sound in terms of a consumer making a purchasing decision; if one wants the House of Pain record, that is what one will buy.

In trademark law, the "likelihood of confusion" standard is used to prevent a defendant from "gaining a foothold in [the] plaintiff's market"¹²⁵ through the use of a mark that is confusingly similar to the plaintiff's mark. The sounds within a record are never a cause of source confusion, however, because a consumer must determine the source of a song before purchasing the record. Actually, one could

123. Trademark law is concerned with confusion of source in the marketplace because the policy behind trademark law is consumer protection and protection of a company's goodwill. Thus, the fear that sampling will cause confusion as to the source of certain sounds is irrelevant because those sounds never confuse the consumer as to the product he or she is buying. See *infra* notes 124-26 and accompanying text.

124. See *supra* note 85 and accompanying text.

125. Doreen Costa, member of Brumbaugh, Graves, Donohue & Raymond; adjunct Professor of Law at Hofstra University School of Law, Lecture at Hofstra University School of Law (Oct. 15, 1992).

argue that sampling works to increase the market for the original recording.¹²⁶

The use of the sound mark theory to protect against sampling might also be considered to have theoretical flaws on the grounds that distinctive sounds in sound recordings are "functional." In trademark law, functional components of a product are incapable of operating independently as a trademark, and are therefore incapable of gaining trademark protection.¹²⁷ A component of a product is functional if it is superior in function, rather than using that component merely as an indicator of source.¹²⁸ In *Keene Corp. v. Paraflex Industries, Inc.*,¹²⁹ for example, the design of a light cube was found to be aesthetically functional¹³⁰ because its shape was what motivated consumers to purchase the product,¹³¹ and the granting of a monopoly for the superior design would have been unfair to competitors.¹³² In trademark law, monopolies are the exception, while freedom to copy is the rule.¹³³

126. See McGraw, *supra* note 3, at 166-67 (stating that "[a]rguably, splicing a digital sample of another performer's work into a new creation may actually generate additional demand for the 'infringed owner's' work"). This result is likely to occur because, if, for example, an individual likes the sounds in "Jump Around," he or she is more likely to react favorably to the sounds in "Harlem Shuffle."

127. See Raymond M. Polakovic, *Should the Bauhaus Be in the Copyright Doghouse?*, 64 U. COLO. L. REV. 871, 893 (1993) (stating that "the non-functional requirement of trademark law bars protection for a device or mark that embodies an inseparable functional component").

128. See *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1339-40 (C.C.P.A. 1982); see also *In re Weber-Stephen Prods. Co.*, 3 U.S.P.Q.2d 1659, 1664 (T.T.A.B. 1987) (stating that a product which is superior in design is de jure functional). However, if a design is "novel" and "nonobvious," then it may be worthy of a design patent. See, e.g., *Stormy Clime, Ltd. v. Progroup, Inc.*, 809 F.2d 971, 977 (2d Cir. 1987) (stating that "by bestowing limited periods of protection to novel, non-obvious, and useful inventions[—] . . . fourteen years for design patents, 35 U.S.C. § 173 (1988)—the patent laws encourage progress in science and the useful arts").

129. 653 F.2d 822 (3d Cir. 1981).

130. *Id.* at 826. When the product's aesthetic value largely motivates consumers to purchase the product, the product's feature may be aesthetically functional because they contribute to the product's value and aid the performance for which the goods are intended. *Id.* at 825 n.4 (quoting RESTATEMENT OF TORTS § 742, com. a (1938)); see also *Warner Bros., Inc. v. Gay Toys, Inc.*, 724 F.2d 327, 328 (2d Cir. 1983) (stating that "[f]unctional symbols (those that are essential to a product's use as opposed to those which merely identify it) are not protected under § 43(a) [of the Lanham Act]").

131. *Keene*, 653 F.2d at 826.

132. See *id.* at 827-28.

133. See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151 (1989) ("The novelty and nonobviousness requirements of patentability embody a congressional understanding, implicit in the Patent Clause itself, that free exploitation of ideas will be the rule, to which the protection of a federal patent is the exception.").

Distinctive sounds in sound recordings are clearly functional because consumers purchase records precisely for the sounds that are embodied within—the sounds are the product itself. Record consumers use product packaging, not sound, to determine the source of a product when making their purchase. In fact, sound itself, unless it is a voice, never truly indicates the source of that sound,¹³⁴ but is rather what motivates a consumer to make a purchase. Thus, distinctive sounds within an album cannot gain trademark protection through a sound mark theory because such sounds are functional.

To function as a trademark, a mark must identify the source of the product or service.¹³⁵ Distinctive sounds within the music recording and sampling context, however, identify neither a service nor a product. In order to gain sound mark protection for distinctive sounds within a song, those sounds must satisfy the criteria for being either a trademark or service mark.¹³⁶ The sounds in a performer's song cannot be a service mark for the entertainment services of the performer, however, because those sounds would not identify services, but merely a single product;¹³⁷ to wit, the recorded song from which the sounds are derived. Nor could the sound be a trademark for a product because, as previously discussed, the sound within a record does not function as an indicator of the source of that record when a consumer wants to purchase it.¹³⁸

The granting of sound mark status for sounds within a record

134. Sound itself, as embodied in a record, is not a reliable indicator of source because style *per se* is not protected by copyright. The Copyright Act, for example, allows for anyone to obtain a compulsory license to independently record their own version of a copyrighted musical composition. See 17 U.S.C. § 115(a)(1) (1988). Furthermore, note combinations which are uncopyrightable because they fail to satisfy copyright's "originality" standard, 17 U.S.C. § 102(a), may also be freely copied by all. Thus, sound itself is not always a reliable indicator of source.

135. See *supra* notes 72-74 and accompanying text.

136. Note that a trademark—or sound mark—has some protection without registration—i.e. a trademark need not be registered in order for the owner to bring an action for infringement, registration acts as *prima facie* evidence of validity and ownership of the registered mark. See 15 U.S.C. § 1115 (1988).

137. See *supra* text accompanying notes 75-76 (discussing requirements of a service mark).

138. See *supra* note 134 and accompanying text. There is one instance, however, where a performer could use a sound as a service mark: if a performer, during every performance of his or her work, whether live or recorded, used the same distinctive sound(s) before or after each song, that sound would be capable of identifying the specific entertainment services of a single source, and would also be non-functional (i.e., it would not be part of the product *per se*, but would instead serve to identify the source of each song with the specific performer), so it would therefore be capable of functioning as a sound mark. See, e.g., *supra* notes 117-18 and accompanying text.

could also cause complex ownership disputes. In trademark law, ownership rights are conferred on the controller of a mark, not the creator of a mark.¹³⁹ The issue in *Bell v. Streetwise Records, Ltd.*,¹⁴⁰ for example, was whether the entertainment services mark "New Edition" belonged to the group who founded and performed under that name, or whether it belonged to Maurice Starr, who managed and trained the group, gave it its "big break," wrote its music, provided its background vocals, and played the instruments heard on its recordings.¹⁴¹ Maurice Starr wanted to supplement new group members and continue using the name "New Edition."¹⁴² The court held, however, that the original members of the group should retain ownership of the mark because (1) the group exercised control over the mark, and (2) public perception was that the mark "New Edition" belonged to those specific members of the group, not to the entertainment services of just anyone performing under that name.¹⁴³

In the context of sound marks, then, there could be substantial arguments as to ownership. With regard to a given sound, for example, would the owner be the musical performers, the composition writer, the record producer, or the record company? Ownership of a sound mark in the recording would ultimately depend upon a legal determination of a number of factors relating to who exercised control over the mark, as well as the public's perception as to the source of the mark.¹⁴⁴

The possibility of fluctuating ownership of a sound mark is also contrary to copyright law, which confers exclusive rights in owner of the copyright.¹⁴⁵ Granting sound mark protection for sounds within

139. In *Bell v. Streetwise Records, Ltd.*, 640 F. Supp. 575, 580 (D. Mass. 1986), the court stated that priority of trademark ownership "is established not by conception, but by bona fide usage."

140. *Id.*

141. *Id.* at 578.

142. *See id.* at 579.

143. *Id.* at 580-81; *see also id.* at 581 n.18 (The court distinguished the circumstances surrounding New Edition with that of a "concert group" where independent companies also perceiving an unfilled "'niche'" in the entertainment market, hire a group to promote their "concept" or marketing idea and the record company owns the name and controls the product).

144. *See also* GAF Broadcasting Co. v. Caswell-Massey Co., 215 U.S.P.Q. 654, 655 (T.T.A.B. 1982). The court held that a radio station owned the mark "Music of the Perpetual Past" as the title of a radio program it produced and broadcast, as opposed to the advertising firm which created the concept. The Board reasoned that the radio station exercised control over the program, and therefore owned the mark. *Id.* at 655-56.

145. Copyright Act, 17 U.S.C. § 106 (1988 & Supp. 1992). The scope of rights will depend upon the nature of the work. *See id.* With exceptions, copyright ownership vests in the

records would conflict with copyright law in other ways as well. For example, the infringement standards for a sound mark would conflict with the copyright infringement standard. The trademark infringement standard is whether or not a defendant's mark creates a "likelihood of confusion" between the source of its product and that of the plaintiff.¹⁴⁶ The infringement standard for copyright, however, is whether or not there is "substantial similarity" between the two works.¹⁴⁷ Thus, sound marks for sounds within records might often confer far greater protection than is afforded under copyright law because sounds which would be uncopyrightable under the "substantial similarity" test could, nonetheless, be monopolized if another's use of those sounds might create a "likelihood of confusion." The effect of conferring sound mark protection to sounds which are uncopyrightable would be to unduly limit the musical market, a market already limited naturally by the small range of notes and the use of aurally pleasing combinations.¹⁴⁸ Similarly, in trademarks, there is what is known as the "color depletion" theory,¹⁴⁹ which holds that since there are only a limited number of colors, it would be an unwise policy to foster further limitation by allowing registrants to register colors and thus, "deplete the reservoir."¹⁵⁰ Thus, for example, if one were allowed to gain sound mark protection for merely two notes, the entire music industry would then be barred from using those same two notes in the same or substantially similar fashion. Creativity would be drastically limited, which result would conflict with the Constitutional purpose of copyright law: "To promote the [p]rogress of . . . useful [a]rts."¹⁵¹

The infringement standard for sound marks would further conflict with most standards for copyright infringement because, in

author for a duration of the author's life plus fifty years. *Id.* § 302(a) (1988).

146. See *supra* note 85 and accompanying text.

147. See, e.g., *Fisher Price, Inc., v. Well-Made Toy Mfg. Corp.*, 1994 WL 226982, *3-4 (2d Cir. 1994); *Beal v. Paramount Pictures Corp.*, 20 F.3d 454, 459-60 (11th Cir. 1994); *Wildlife Express Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502, 511 (7th Cir. 1994); *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1044-45 (9th Cir. 1994).

148. This medium is different than the written one, for example, where each language is composed of thousands of words. The musical scale, however, is comprised of only seven basic notes: A, B, C, D, E, F and G.

149. See, e.g., *Diamond Match Co. v. Saginaw Match Co.*, 142 F. 727, 729-30 (6th Cir. 1906) (holding that the plaintiff could not gain trademark protection for the red-tipped color of its matches because to allow for the monopolization of color to distinguish a product would quickly lead to the appropriation of all colors).

150. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1120 (Fed. Cir. 1985); *Edward Weck, Inc. v. IM Inc.*, 17 U.S.P.Q.2d 1142, 1145 (T.T.A.B. 1990).

151. U.S. CONST. art. 1, § 8, cl. 8.

some instances, it would fail to confer protection in areas where copyright law does. If copyrighted material is commercially exploited without authorization, it is irrelevant that the new product is aimed at a different market; copyright law prohibits an unauthorized taking.¹⁵² In trademark law, on the other hand, one could conceivably take an identical mark and use it on similar products or services, yet escape liability if the products catered to different markets, since there might not be a "likelihood of confusion" between the two uses. Different markets were a deciding factor in *Vitarroz Corp. v. Borden, Inc.*¹⁵³, for example, where it was held that the defendant's mark "Bravos" for a particular type of cracker did not infringe the plaintiff's mark "Bravo's" for its type of cracker.¹⁵⁴ The court also highlighted other distinctions between the crackers in order to substantiate its holding that there was no likelihood of confusion among consumers.¹⁵⁵ In reality, the court was simply balancing the equities, including Borden's good faith and substantial investment,¹⁵⁶ to arrive at a decision which it deemed fair considering all the circumstances. However, if one sampled, without authorization, a clearly copyrightable guitar riff from a song, it would certainly infringe upon the copyrights in both the composition and the sound recording, even if the infringing song catered to a wholly different musical market than the original. In sum, trademark law recognizes an unlimited number of equitable factors when determining an infringement,¹⁵⁷ whereas

152. In copyright law, however, the "fair use" doctrine allows for the use of copyrighted material under certain situations. The four factors which a court will consider in determining whether a use is "fair" are:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C. § 107 (1988).

153. 644 F.2d 960 (2d Cir. 1981).

154. *Id.* at 967.

155. *Id.*

156. *Id.* at 963.

157. In the landmark decision of *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), *cert. denied*, 368 U.S. 820 (1961), the court enunciated eight factors for evaluating likelihood of confusion between non-identical goods or services: (1) the strength of the plaintiff's mark; (2) the degree of similarity between the plaintiff's and the defendant's mark; (3) the proximity of the products or services; (4) the likelihood that the plaintiff will bridge the gap (meaning whether the plaintiff will enter the defendant's area of goods or services); (5) evidence of actual consumer confusion; (6) the defendant's good faith in adopting

copyright law looks solely at whether the defendant's work is substantially similar¹⁵⁸ and whether or not the defendant's use of the copyrighted material can be classified as a "fair" one.¹⁵⁹

There are also the practical problems of providing for notice of a sound mark on records.¹⁶⁰ It would be unrealistic to put the public on notice as to which sounds within a recording are being claimed as sound marks; there is no way to "mark" isolated sounds with accepted trademark notations.¹⁶¹ It would also be impossible, practically speaking, to affix the mark to the product in a way that would separately identify the mark from the product itself. In the case of recordings, a sound mark would be a part of the product, and therefore indistinguishable from it. There is no way to affix a sound mark on a recording (since the mark itself is aurally perceived), or display it with the product in a way that would enable the sound mark to identify a specific song or record.¹⁶²

Even if the sound mark theory, as applied to individual songs on records, was theoretically sound, it would still not solve any of the problems which sampling currently presents to the music industry. In fact, it would only complicate the issues, increase ambiguity and unpredictability, create hassles, and waste time and money. A sound mark theory would create another ad hoc cause of action which would prompt increased litigation, confusion, and headaches in the negotiation process for the licensing of samples. As a practical matter, the sound mark theory would not reach its objective of protect-

its mark; (7) the quality of the defendant's product or service; and (8) the sophistication of the buyers. Moreover, a court may also take additional relevant factors into account. *Id.*

158. See *supra* note 147 and accompanying text.

159. See *supra* note 152.

160. Registration on the Principle Register gives constructive notice of trademark or service mark ownership. Lanham Act § 22, 15 U.S.C. § 1072 (1988). Although notice is not required, § 29 of the Lanham Act states that failure to give notice of one's registration precludes recovery of profits and damages, unless the defendant had actual notice of the registration. 15 U.S.C. § 1111 (1988).

161. One may give notice of registration on the Principle Register by displaying with the mark the words "Registered in U.S. Patent and Trademark Office," "Reg. U.S. Pat. & Tm. Off.," or the letter "R" in a circle. Lanham Act § 29, 15 U.S.C. § 1111.

162. A sound mark could be "affixed" to a recording by visually depicting a musical scale displaying the notes of which the sound is composed. That would not, however, serve to identify the product to consumers for two reasons. First, notes on a scale are meaningless to most people. Second, even if one can read sheet music, written notes never convey the sound of a given note as embodied in a recording; the distinctive sound embodied by the playing of those notes depends on the individual performers and the instruments used.

Note that the Lanham Act does not have an explicit requirement for affixation; rather, it simply states that a mark must be used "in connection" with the goods with which it is meant to identify. See Lanham Act § 1, 15 U.S.C. § 1051 (1988).

ing portions of recorded songs from infringement. The sound mark theory would fail to protect against the use of multiple samples from a single song because as a plaintiff claims more sound marks for a single musical piece, each one of those marks becomes weaker.¹⁶³ The sound mark theory also fails to address the sampling of sounds that are not distinctive since plaintiffs could not claim that an indistinctive sound functions as a trademark.¹⁶⁴ It would neither protect samples that have been altered or disguised within the new song because unrecognizable sounds could never create a likelihood of confusion. Thus, even if the sound mark theory were conceptually sound, application of it would only add to the dilemmas of sampling.

IV. SECTION 43(A) OF THE LANHAM ACT AND DIGITAL SOUND SAMPLING

It is also clear that Section 43(a) of the Lanham Act¹⁶⁵ fails to adequately address the dilemmas of sampling, although, under certain situations, it could provide a viable cause of action against the unauthorized use of samples. Section 43(a)(1) states, in pertinent part:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any . . . device, . . . or any false designation of origin, . . . which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . .

. . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.¹⁶⁶

In basic terms, Section 43(a)(1) of the Lanham Act proscribes the inducement of public confusion for commercial gain. Thus, the Lanham Act potentially protects against any unauthorized sampling which is likely to deceive the public into thinking that a plaintiff's sounds are the defendant's. Where a defendant attempts to "pass

163. This is common sense; if a product has several trademarks on it, the distinctiveness of any one of them is necessarily diminished.

164. Recall that a mark must be distinctive, either inherently or through secondary meaning, in order to gain trademark protection. See *supra* note 93 and accompanying text.

165. Lanham Act § 43(a), 15 U.S.C. § 1125(a) (Supp. 1992).

166. *Id.*

off" another's goods as his own, as with the sampling of another's sounds, it is commonly referred to as "reverse passing off,"¹⁶⁷ or "reverse confusion."¹⁶⁸

A plaintiff seeking relief under Section 43(a) of the Lanham Act for the unauthorized sampling of her copyrighted material would argue that the defendant's use of the sample creates a likelihood of confusion as to the identity of the artist performing on the record and the origin of the sampled sound, thereby resulting in damage to the plaintiff. Another way of expressing this argument is to say that sampling violates the sampled-from artist's right of attribution. In *Smith v. Montoro*,¹⁶⁹ for example, the defendant, a film distributor, removed the plaintiff-actor's name from the movie credits and advertising material, and substituted someone else's name.¹⁷⁰ The court held that the defendant's conduct constituted a false designation of origin which amounted to "reverse passing off."¹⁷¹ The court noted the broad scope of Section 43(a) in stating that it "explicitly condemns false designations or representations in connection with 'any goods or services.'"¹⁷² The court stated that "reverse palming off" is:

wrongful because it involves an attempt to misappropriate or profit from another's talents and workmanship. Moreover, in reverse palming off cases, the originator of the misidentified product is involuntarily deprived of the advertising value of its name and of the goodwill that otherwise would stem from public knowledge of the true source of the satisfactory product.

. . . .
 . . . Since actors' fees for pictures, and indeed, their ability to get any work at all, is often based on the drawing power their name may be expected to have at the box office, being accurately credited for films in which they have played would seem to be of

167. See, e.g., *Smith v. Montoro*, 648 F.2d 602, 604-05 (9th Cir. 1981).

168. See, e.g., *Banff, Ltd. v. Federated Dep't Stores, Inc.*, 841 F.2d 486, 490 (2d Cir. 1988) (stating that "[r]everse confusion is the misimpression that the junior user is the source of the senior user's goods") (citing 2 MCCARTHY, *supra* note 74, § 23:1(E), at 48).

169. 648 F.2d 602 (9th Cir. 1981).

170. *Id.* at 603.

171. *Id.* at 605-08.

172. *Id.* at 605; see also *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 467 F. Supp. 366 (S.D.N.Y. 1979) (holding that § 43(a) of the Lanham Act condemns false designations or representations in connection with motion picture representations, and that, therefore, the use of the Dallas Cowboy cheerleader uniform in the pornographic film "Debbie Does Dallas" was a trademark infringement which allowed for injunctive relief), *aff'd*, 604 F.2d 200 (2d Cir. 1979).

critical importance in enabling actors to sell their "services," i.e., their performances.¹⁷³

It follows, then, that one whose work has been sampled could argue that the use of the work without proper credit constitutes a false designation of origin, actionable under section 43(a) of the Lanham Act.

Further, like an actor's name, a musician's name is arguably a service mark for entertainment services. [In addition], musicians' fees and their ability to get work at all are often based on their reputation, and being accurately credited for their work would seem to be of critical importance for musicians to sell their services.¹⁷⁴

Thus, section 43(a) represents a viable theory by which to protect against intangible damage to an artist's goodwill and demand for his or her services caused by unauthorized sampling. Section 43(a), however, is necessarily vague and unpredictable in its ad hoc application and fails to provide clear, predictable standards for the regulation of sampling use and infringement. Additionally, remedial damages are arbitrary, since the damages to a plaintiff caused by unauthorized sampling are primarily intangible and unquantifiable.

V. CONCLUSION

Sampling presents serious predicaments to the music industry. Current copyright law is vague as applied to sampling issues and music industry licensing practices can be both unpredictable and wasteful of an artist's time and money. Sampling can be an important, if not essential, artistic tool for the progression and development of music. However, if allowed to continue on its present course, the rights of those whose work is being appropriated are not being protected. These artists must be vindicated. Digital pirates should not be allowed to freely exploit the unique labor and talent of others.

Current legal theories, such as the sound mark theory and section 43(a) of the Lanham Act, fail to solve the problems which sampling presents to the music industry. What is needed is clarifying legislation, such as compulsory licensing,¹⁷⁵ which would set clear,

173. *Smith v. Montoro*, 648 F.2d at 607 (citations omitted).

174. *Moglovkin*, *supra* note 12, at 173.

175. A compulsory license could set bright line, definitive standards for sampling use and infringement by regulating the amount that a sampler could take and by requiring adequate compensation for the copyright owner(s) of the original sounds. See Baroni, *supra* note 1 (proposing a compulsory license framework for the music industry).

predictable standards, and recognize the realities of sampling as both a valuable artistic tool and, when unauthorized, an unfair misappropriation of another's unique labor and talent.