

## **COPYRIGHT LAW**

### ***Gray v. Hudson* Rules on Copyrightability of Musical Elements**

By Robert W. Clarida and Thomas Kjellberg

On March 10, 2022 the Ninth Circuit affirmed a District Court’s vacatur of a jury verdict in *Gray v. Hudson*, 28 F.4<sup>th</sup> 87 (9<sup>th</sup> Cir. 2022)(“*Gray*”), to rule that a repeating eight-note instrumental pattern in Katy Perry’s 2013 hit “Dark Horse” did not infringe two similar patterns in Plaintiff’s 2008 composition entitled “Joyful Noise.” The decision articulates the current state of Ninth Circuit law regarding the threshold of protectable originality in music infringement cases, and because so many music cases are brought in the Ninth Circuit the ruling will likely be significant to music litigators nationwide.

#### **Background**

In 2007 Plaintiff Chike Ojukwu composed a simple melody using a free music website, and sold it to Plaintiff Marcus Gray, who used Ojukwu’s melody as a repeating instrumental figure, or “ostinato,” in a 2008 recording of Joyful Noise. The Gray work was released on a 2008 album that drew millions of views on Myspace and YouTube, and was nominated in 2009 for a Grammy award for “Best Rock or Rap Gospel Album.” Defendants, including Katheryn Hudson p/k/a Katy Perry (collectively “Perry”), created the allegedly infringing work in 2013 after a meeting in which they reviewed “several short musical fragments to consider using in a new song.” The Perry work was extremely successful and resulted in a popular music video and a Super Bowl halftime performance for Perry.

Plaintiffs (collectively “Gray”) brought suit in November 2016 and proceeded to a bifurcated jury trial in 2019. With respect to liability, Plaintiffs lacked direct evidence that Perry had copied from the Gray work, but relied on circumstantial evidence that Perry had a reasonable opportunity to have heard the work, coupled with the alleged substantial similarity of the ostinatos

in the two songs. The latter point was addressed primarily through expert testimony, with Gray’s expert opining that “no one single ... element” of similarity was substantial in isolation, but taken together the ostinatos were substantially similar. Perry’s expert disagreed, pointing to the use of different ending notes by the parties’ respective patterns, and to the existence of similar overall patterns in several well-known songs including “Merrily We Roll Along” and “Jolly Old Saint Nicholas.”

A jury found in Plaintiffs’ favor and ultimately returned a verdict of about \$2.8 million in damages, representing 22.5% of Defendants’ net profits from “Dark Horse.” The Court, however, granted Perry’s motion for judgment as a matter of law on the grounds that “none of the individual points of similarity the [Plaintiffs’] expert identified between Dark Horse and Joyful Noise constituted original expression.” Alternatively, the Court ruled that if the overall combination of elements were protectable, such copyright would be “thin” at best, and thus Plaintiffs could only prevail by showing virtually identical copying, which the evidence did not support. Plaintiffs appealed.

### **Ninth Circuit Ruling**

Reviewing the District Court’s JMOL ruling under the same standards that apply to summary judgment, *i.e.*, drawing all reasonable inference in Plaintiffs’ favor, the Ninth Circuit agreed that “plaintiffs failed to establish copying of any original – and, consequently, protectable – elements of Joyful Noise.” Because lack of originality was dispositive, the Ninth Circuit addressed no other issues.

The Court began its originality discussion by explaining the Ninth Circuit’s distinction between “extrinsic” and “intrinsic” similarity, for purposes of determining infringement:

The extrinsic test considers whether two works share a similarity of ideas and expression as measured by external, objective criteria. The extrinsic test requires ... breaking the works

down into their constituent elements, and comparing those elements for proof of copying as measured by substantial similarity. Because the requirement is one of substantial similarity to *protected* elements of the copyrighted work, it is essential to distinguish between the protected and unprotected material in a plaintiff's work. The intrinsic test focuses on similarity of expression from the standpoint of the ordinary reasonable observer, with no expert assistance.

*Gray*, at 96 (citations omitted, emphasis added).

Plaintiffs argued that the District Court erred by failing to defer to the jury's finding of substantial similarity, but even as the Ninth Circuit recognized that the intrinsic test is "uniquely suited" for determination by lay jurors, it stressed that the extrinsic test is often resolved as a matter of law, based on expert reports, and that both extrinsic and intrinsic similarity are required to establish infringement. Therefore, "while we must refrain from usurping the jury's traditional role of evaluating witness credibility and weighing the evidence, the extrinsic test requires us as a court to ensure that whatever *objective similarities* the evidence establishes between two works are legally sufficient to serve as the basis of a copyright infringement claim regardless of the jury's views." *Id.* (emphasis added).

Accordingly, the issue for the Ninth Circuit was to determine which elements of the Joyful Noise ostinato were sufficiently original to qualify as protectable expression. Applying the very low bar for originality announced by the Supreme Court in *Feist v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991), the Ninth Circuit nonetheless observed that copyright does not protect "trite musical elements," or "commonplace elements that are firmly rooted in the genre's tradition." In this case, the elements claimed to be original included the ostinato's eight-beat length, its even rhythm, its pitch content and melodic shape (drawn from the minor scale), its "pingy" tone color and its placement within the audio texture of the Plaintiffs' recording. As the Plaintiffs' own expert testified, many of these elements were common "in the musical world," *Gray* at 98, even if not in the parties' respective genres. Such "building blocks" belong to the public domain and

cannot support an infringement claim, held the Court. The Court further concluded that elements such as texture and tone color are “far too abstract ... to be legally cognizable.” *Id.* at 99. Moreover, the Court noted that such elements “relate[ ] to the performance or recording of a musical work,” not the composition itself; it would appear that this observation might carry less weight, however, if the composer submitted an audio CD or MP3 as a deposit copy for both the composition and the sound recording, as is now extremely common.

Regarding the ostinato’s pitch sequence, about which the experts testified at length, the Court distinguished between an abstract sequence of pitches and a melody, because the latter is organized both as to pitch and rhythm, not just pitch; it cited the *Compendium* of the U.S. Copyright Office to state that “[w]hile an eight-note *melody* may be copyrightable, the abstract eight-note *pitch sequence* that is a component of the melody is not.” *Id.* at 100 (emphasis original). Given that there are over 40,000 possible sequences of eight pitches, the Court’s statement may arguably be too categorical, and certainly seems to be when the Court extends it in *dicta* to chord progressions as well, which were not at issue in the case (*e.g.*, chord progressions “may not be individually protected because they are basic musical building blocks”). *Id.*

But the pitch sequence of the Joyful Noise ostinato was held unprotectable not simply because it was an eight-note sequence, but also because that sequence and the “melodic shape” it formed were frequently-used patterns derived from a common musical scale: “while there are an enormous number of possible permutations of the musical notes of the scale, only a few are pleasing” because of “the constraints of particular musical conventions and styles.” *Id.* The pitch sequence of the Joyful Noise ostinato was therefore held to be a “standard tool” for composers, one of the relatively few pleasing patterns possible within particular musical conventions. The Court did not hold that Defendants created the pattern independently, *cf.* Granite Music Corp.

v. United Artists Corp., 532 F.2d 718, 720 (9th Cir. 1976) (“Evidence of similar musical phrases appearing in prior works ... demonstrates that the musical language was of such ordinary and common occurrence that the probability of independent, coincidental production was great”), but rather went further, to hold that even if Defendants *had* copied the sequence from Plaintiffs, the sequence is not protectable as a matter of law, so any copying – if it occurred – was not actionable.

As for the overall combination of elements, the Ninth Circuit again relied on musical convention to hold, citing *Feist*, that the combination was an “utterly conventional way[ ] of arranging” the elements of the ostinato, *id.* at 101, so the ostinato “cannot be called ‘original’ under copyright law.” Because the portion of the Joyful Noise ostinato that overlapped with Dark Horse “consists of a manifestly conventional arrangement of musical building blocks,” *id.* at 101-102, allowing a copyright over this material would “essentially amount to allowing an improper monopoly over ... the minor scale itself, especially in light of the limited number of expressive choices available when it comes to an eight-note repeated musical figure.” *Id.*

Therefore, the Ninth Circuit held that the Joyful Noise ostinato lacks “the quantum of originality needed to merit copyright protection.”

## CONCLUSION

The Ninth Circuit’s ruling in *Gray v. Hudson* is perhaps too categorical in denying protection to *any* eight-note sequence of pitches, and its remarks about the copyrightability of chord progressions are clearly *dicta*, since no chord progressions were at issue in the case, but the ruling is a useful statement of current law about copyrightability and substantial similarity in music cases, and it will no doubt provide a road map for other courts addressing such issues in the future.

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