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September 30, 1998

Re: Golf Stud Collection-GST-001
Golf Collection-GNE-009
Golf Collection-GNE-012
Copyright Office Control Number: 60-514-4828(K)

Dear Ms. Scheidt:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated November 19, 1997, appealing a refusal to register three works in the "Golf Collection." Your request was made on behalf of Strategem Inc.

The Copyright Office Board of Appeals examined the claims for the jewelry design works and considered the correspondence from your firm regarding these claims. After careful review, the Board is affirming the Examining Division's refusal to register these claims because the jewelry designs consist of common shapes and symbols which do not contain copyrightable subject matter.

Administrative Record

The Copyright Office received fees, deposits, and applications for the three above-mentioned jewelry design collections July 24, 1996. The claimant, Strategem Inc., is represented by your firm, Kenyon & Kenyon.

In a letter dated December 24, 1996, Visual Arts Examiner Geoffrey R. Henderson notified you that the works could not be registered due to lack of the minimum amount of artistic or sculptural authorship needed to support copyright claims. He also noted that copyright law does not protect familiar symbols or designs, or minor variations of basic geometric shapes.

In a letter to Mr. Henderson, dated February 20, 1997, you asserted that three-dimensional works of art such as jewelry may be copyrighted. You stated that according to the definition of "pictorial, graphic, and sculptural works" in 17 U.S.C. §101, "virtually all three-dimensional forms of fine and popular art are copyrightable." First appeal letter at 1.

You cited Bleistein v. Donaldson Lithographic Co., 188 U.S. 239 (1909) to stress that lawyers should not judge the worth of artistic effort embodied in works when evaluating copyrightability. You also cited Trifari, Krussman & Fishel, Inc. v. Charel Co., 134 F.Supp. 551 (S.D.N.Y. 1955) in support of the assertion that costume jewelry is as deserving as painting or literature of copyright protection. You cited Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951) in support of the proposition that as long as an author contributes something recognizably his own to a work, the work need not be strikingly unique or novel to afford protection.

You described GNE-012 as "a strand of 18K gold chain links fastened to a second strand of links at three points by a double gold loop to create a scalloped effect of the second strand, with a pear shaped diamond suspended from each of the three gold loops." GST-001 was described as "a pair of diamond mounted studs, attaching to a freeform base," and GNE-009* "consists of a gold link chain lariat, each end terminating in a crown-shaped cluster of gold set over a black pearl." First appeal letter at 3.

Examining Division treated your February 20, 1997 letter as a first appeal. Visual Arts Section Attorney Advisor Virginia Giroux replied to the appeal in a letter dated October 3, 1997, advising you that the Office could not register the works submitted due to lack of copyrightable authorship.

She noted that the determination of whether a work is copyrightable has nothing to do with its aesthetic or commercial value, but, instead concerns whether there is sufficient creative authorship in a work to support a claim to copyright protection.

Ms. Giroux found the works in the three Golf Collections to consist of familiar symbols and designs, including loops, diamond shapes, simple lariats and crowns, all in the public domain designs, and all unprotectable. She also found no copyrightable authorship in the combination of these basic elements in the works. She cited case law to support her conclusion, including John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986)

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* Your letter, and the subsequent correspondence, referred to "Golf Collection-GNE-001." However, it appears clear that the actual item is what was identified, on the application and deposit, as "Golf Collection-GNE-009."

(a logo consisting of four angled lines forming an arrow, with the word "arrows" in cursive script below, found uncopyrightable) and Jon Woods Fashions, Inc. v. Curran, 8 U.S.P.Q.2d 1879 (S.D.N.Y. 1988) (a design consisting of two-inch stripes with small grid squares superimposed upon the stripes found not copyrightable). Ms. Giroux agreed that the Catalda court held that works need not be unique or novel to merit copyright protection, and also agreed with the Trifari court that costume jewelry may be the subject of copyright protection. However, she noted that no category of works is automatically copyrightable and that in all cases, a work must possess copyrightable authorship to be registered.

In your second appeal letter, dated November 19, 1997, you characterized the Office's two refusals to register your client's work as "an abuse of discretion...not supported by established case law." Second appeal letter at 2.

You asserted that the level of creativity required for registration is minimal, citing Feist Publications, Inc. v. Rural Telephone Service Co., Inc., 499 U.S. 340 (1991), and other cases. You claimed that Ms. Giroux "impermissibly focused her attention on components, not on the works as a whole." Second appeal letter at 3-4. For the proposition that individual elements may not qualify for copyright protection alone, but in combination an arrangement of uncopyrightable elements may be protected, you cited Atari Games Corp. v. Oman, 888 F.2d 878 (D.C. Cir. 1989); Reader's Digest v. Conservative Digest, Inc., 821 F.2d 800 (D.C. Cir. 1987); Apple Barrel Products, Inc. v. Beard, 730 F.2d 384 (5th Cir. 1984); and Roth Greeting Cards v. United Card Co., 429 F.2d 1106 (9th Cir. 1970). You also claimed that the United States Court of Appeals for the District of Columbia. Circuit has repeatedly rejected the assertion that familiar elements in combination or alone are not copyrightable.

You denied the relevance of the cases (Muller and Woods) cited in Ms. Giroux's letter, citing Trifari to stress that although costume jewelry may be fashioned with some utilitarian purposes in mind, it also may embody expression of creative authorship.

In closing, you cited Catalda and Feist to assert that a work need not be novel in order to receive copyright protection; all that it must contain is an author's contribution of something recognizably his own, and you again requested that the Office register the works.

The Appeals Board's Decision

The Board agrees with the Trifari court that works of jewelry are copyrightable where they represent the "original, tangible expression of an idea rather than merely pleasing form dictated solely by functional considerations." 134 F. Supp. at 553. See also Boucher v. Du Boyes, Inc., 253 F.2d 948 (2d Cir.), cert. denied, 357 U.S. 936 (1958); Dan Kasoff, Inc. v. Palmer Jewelry Mfg. Co., 171 F. Supp. 603, 606 (S.D.N.Y. 1959). However, not all jewelry

designs contain sufficient creative expression to support a copyright. DBC of New York, Inc. v. Merit Diamond Corp., 768 F. Supp. 414 (S.D.N.Y. 1991).

The Board also agrees with you that the level of creativity required for copyright — and for registration — is minimal. Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991) (only a modicum of creativity is necessary for copyrightable expression). However, the Board cannot agree that the jewelry designs in the Golf Collection meet even that minimum requirement. Feist Publications confirmed that although there is a low standard for determining the copyrightability of a work, some works fail to meet that standard. The Court held that the originality required for copyright protection consists of "independent creation plus a modicum of creativity." *Id.* at 346. The Court observed that "[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity," *id.* at 363, and that there can be no copyright in works in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359. The Court also recognized that some works, such as a "garden-variety white pages directory devoid of even the slightest trace of creativity," are not copyrightable. *Id.* at 362.

Section 202.1(a) of the Copyright Office regulations, 37 C.F.R. §202.1(a), codifies a longstanding application of these principles. Section 202.1 provides:

> The following are examples of works not subject to copyright and applications for registration of such works cannot be entertained:
>
> (a) Words and short phrases such as names, titles, and slogans; *familiar symbols or designs*; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents;...

(Emphasis added).

This principle and longstanding Copyright Office practice is supported by judicial decision. In DBC of New York, the court held that DBC's jewelry designs were not copyrightable under this rule because they consisted of shapes in the public domain. The court added that the individual elements of DBC's designs were each separately well-known in the jewelry trade. 768 F. Supp. at 415. See also Jon Woods Fashions Inc. v. Curran, 1988 U.S. Dist. LEXIS 3319, 8 U.S.P.Q.2d 1870, 1871-72 (S.D.N.Y. 1988) (upholding refusal to register a fabric design, quoting §202.1 and noting that the features of the fabric — a combination of stripes and a grid — that the plaintiff sought to protect were "familiar symbols"); John Muller & Co. v. New York Arrows Soccer Team, Inc., 802 F.2d 989 (8th Cir. 1986) (upholding refusal to register logo that lacked the minimal creativity necessary to support a copyright and noting that a "work of art" or a

"pictorial, graphic or sculptural work ... must embody some creative authorship in its delineation of form").

Each of the three designs at issue in this appeal consists of simple arrangements of a very small number of familiar symbols or designs. GST-1 is, in your words, "a pair of diamond mounted studs, attaching to a freeform base." There is no original authorship in the diamond studs themselves, and the "freeform" base appears to be simply a familiar pear-shaped or teardrop-shaped base which, in and of itself or in combination with the diamond stud, exhibits *de minimis* authorship at best. GNE-009 is, in your words, "consists of a gold link chain lariat, each end terminating in a crown-shaped cluster of gold set over a black pearl." The gold link chain is commonplace, as are the two crown-shaped clusters of gold in which the black pearls are set. There is, of course, no authorship in the pearls themselves. GNE-012 is, in your words, "a strand of 18K gold chain links fastened to a second strand of links at three points by a double gold loop to create a scalloped effect of the second strand, with a pear shaped diamond suspended from each of the three gold loops." There is nothing original about the gold chain, the series of simple loops, or the suspension of the diamonds from each of the points where the loops are joined; nor is there any authorship in the diamonds themselves.

The Board does not deny that the works in question may be attractive, but even aesthetically pleasing designs may not be registered for copyright protection if the design lacks a minimum amount of original authorship. See SCOA Industries, Inc. v. Famolare, Inc., 192 U.S.P.Q. 216 (S.D.N.Y. 1976) (troughs, lines and waves on shoe sole do not constitute copyrightable work); Forstmann Woolen Co. v. J.W. Mays, Inc. 89 F. Supp. 964 (E.D.N.Y. 1950) (reproduction of standard fleur-de-lis could not support a copyright claim without additional original authorship).

You have asserted that in refusing registration on the first appeal, the attorney advisor "impermissibly focused her attention on components, not on the works as a whole," and that "simple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection." Second appeal letter at 3-4. The Board recognizes that, as stated in Roth Greeting Cards, *supra,* all elements of a work must be considered as a whole when determining whether copyrightable authorship is present. However, the simple combination of very few commonplace elements present in the three designs at issue here simply do not rise to the level of copyrightable authorship. An "aggregation of well known components [that] comprise an unoriginal whole" cannot support a claim to copyright. Florabelle Flowers, Inc. v. Joseph Markovits, Inc., 296 F. Supp. 304 (S.D.N.Y. 1968); DBC, 768 F. Supp. at 415 ("DBC's gestalt theory that the whole is greater than the sum of its parts is rejected by the great weight of evidence indicating that these two rings are, on the whole, not exceptional, original, or unique").

Conclusion

The Board of Appeals concludes that the works in the three Golf Collections consist of minor variations of familiar symbols and designs which exhibit no more than *de minimis* authorship. The Board therefore affirms the Examining Division's decision to refuse to register these claims.

This letter constitutes final agency action.

Sincerely,

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for the Appeals Board
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