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John A. Scillieri, Esq.
Seldon & Scillieri
2811 Wilshire Boulevard, Suite 640
Santa Monica, CA 90403

Re: Control No. 60-616-3613(S)
Watch (C101), Watch (C102), Watch (C103), Watch (C105), Watch (C106), Watch (F123), Watch (F124), Watch (F125), and Watch (F128).

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Dear Mr. Scillieri:

The Copyright Office Board of Appeals has reviewed your request for reconsideration of the Office's refusal to register nine works submitted by your client, Taxor, Inc. The Appeals Board reviewed WATCH (C101), WATCH (C102), WATCH (C103), WATCH (C105), WATCH (C106), WATCH (F123), WATCH (F124), WATCH (F125), and WATCH (F128).

The Board has determined that four of the nine works, WATCH (C101), WATCH (C102), WATCH (C105) and WATCH (F128), may be registered. The Office will finalize the administrative work needed to complete the registration and issue your client the appropriate registration certificates as soon as possible.

The Board has determined that five of the above-referenced works, WATCH (C103), WATCH (C106), WATCH (F123), WATCH (F124) and WATCH (F125), cannot be registered. Any of the design elements that could be conceptually separable contain de minimis amounts of originality and do not rise to the level of copyrightability.

Administrative Record

On March 23, 1998 , the Copyright Office received applications, deposits and fees for nine works by Taxor, Incorporated; the works were described as watch designs.

In a letter dated October 19, 1998, the Office notified you that registrations for WATCH (C101), WATCH (C102), WATCH (C103), WATCH (C105), WATCH (C106), WATCH (F123), WATCH (F124), WATCH (F125), and WATCH (F128) were denied because they lacked the artistic or sculptural authorship necessary to support copyright claims. Also, copyright examiner John M. Martin noted that copyright does not protect familiar symbols and designs, minor variations of geometric shapes, lettering and typography, or mere variations in coloring.

First Appeal

In a letter received February 16, 1999, addressed to the Visual Arts Section of the Copyright Office, you sought reconsideration of the refusal to register WATCH (C101), WATCH (C102), WATCH (C103), WATCH (C105), WATCH (C106), WATCH (F123), WATCH (F124), WATCH (F125), and WATCH (F128), arguing that the works contained more than a "modicum of creativity" and possessed sufficient originality to be registered under the Copyright Act. You also asserted that the watches had features that were conceptually separable from the utilitarian features, and were therefore copyrightable.

Second Refusal to Register

On July 9, 1999 Attorney-Advisor Virginia Giroux of the Examining Division responded to your request for reconsideration of the refusal to register WATCH (C101), WATCH (C102), WATCH (C103), WATCH (C105), WATCH (C106), WATCH (F123), WATCH (F124), WATCH (F125), and WATCH (F128).

Ms. Giroux explained that the watch faces are useful articles that contain no separable authorship that is copyrightable. She also explained that Section 101 of the copyright statute defines a "useful article" as "an article having an intrinsic function that is not merely to portray the appearance of an article or to convey information." She went on to point out that registration is possible for a useful article only if and to the extent that the pictorial, graphic, or sculptural features are separable from the useful article.

Ms. Giroux also explained that the Office examines a useful article to determine whether it contains any physically or conceptually separable elements that can be regarded as a copyrightable "work of art." She agreed that there are elements that are conceptually separable from the utilitarian aspects of the watch, but concluded that these elements do not rise to the level of copyrightability.

She also clarified that although there are many choices in the selection of design elements, it is not the possibility of choices that determines copyrightablity, but only whether the resulting expression contains copyrightable authorship. She concluded that the separable elements embodied in these watch face designs, individually, and collectively in their particular arrangement, do not contain sufficient original authorship to be copyrightable.

Second Appeal

You replied in a letter received November 9, 1999, requesting reconsideration of the Office's refusal to register WATCH (C101), WATCH (C102), WATCH (C103), WATCH (C105), WATCH (C106), WATCH (F123), WATCH (F124), WATCH (F125), and WATCH (F128).

You disagreed with the Attorney-Advisor's analysis of conceptual separability, and claimed that under Kieselstein-Cord v. Accessories by Pearl, Inc., jewelry is the proper subject of copyright. 632 F.2d 989 (2nd Cir. 1980). You also argued that the mere fact that a work is composed of features separately found in other works does not render the work uncopyrightable. You suggested that the original combination of these features into the new work is the creative aspect that makes the work copyrightable. In addition, you argued that the Attorney-Advisor's reliance on four cases was in error and not on point. John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986); Jon Woods Fashions, Inc. v. Curran, 8 U.S.P.Q. 2d 1870 (S.D.N.Y. 1988); DBC of New York, Inc. v. Merit Diamond Corp., 768 F. Supp. 414, 19 U.S.P.Q. 2d 1308 (S.D.N.Y. 1991); and Vacheron & Constantin-Le Coulter Watches, Inc. v. Benrus Watch Co., Inc., 260 F.2d 637, 119 U.S.P.Q. 189 (2nd Cir. 1958).

Conceptual Separability

In the previous denials of registration, the Office has consistently determined that the watches are "useful articles." Although it is true that useful articles are not necessarily prohibited from copyright registration, the works may only be registered if they contain pictorial, graphic, or sculptural features that are separable from the useful article.

The Copyright Office articulates a clear test for conceptual separability of non-useful elements in The Compendium of Copyright Office Practices, Compendium II, § 505.03 (1984).

> Conceptual separability means that the pictorial, graphic, or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper, for example, or as free-standing sculpture, as another example, independent of the shape of the useful article. For example, the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article. The artistic features and the useful article could both exist side by side and be perceived as fully realized, separate works- one an artistic work and the other a useful article.

The Office also notes the factors that should not be taken into consideration when applying the test of separability: 1) the aesthetic value of the design; 2) the fact that the shape could have been designed differently; or 3) the amount of work that went into the making of the design. *Id.* at § 505.05.

You have asserted that the designs of the watch faces and rims were configured to create certain impressions of abstract automobile themes. However, it is not possible to obtain copyright protection for the visual impression that a given work makes on one who views it. Copyright protects only the actual expression of the author, and this expression must contain a sufficient amount of copyrightable authorship. Watch faces C103, C106, F123, F124 and F125 mentioned above are useful articles that may contain separable non-functional elements, but those elements contain a *de minimis* amount of copyrightable expression. *See also* the discussion of individual works below.

De Minimis Authorship

The Board of Appeals has determined that the design elements in WATCH (C103), WATCH (C106), WATCH (F123), WATCH (F124) and WATCH (F125) do not exhibit copyrightable authorship.

The Board agrees with you that only a "modicum of creativity" is necessary for copyrightable expression. Feist Publications v. Rural Telephone Service Co., 499 U.S. 340 (1991). It is also true that under Kieselstein-Cord v. Accessories by Pearl, Inc., jewelry can be the proper subject of copyright. 632 F.2d 989 (2nd Cir. 1980). However, these conclusions do not mandate that every work submitted for registration, or every item of jewelry, is copyrightable. In Feist, the Court observed that "as a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity." 499 U.S. 363, 340.

In order for a work to qualify for copyright protection, it must be an "original work of authorship." 17 U.S.C. Section 102. Previously, the courts interpreted "original" broadly to cover any "distinguishable variation" of a prior work to constitute sufficient originality as long as it is the product of the author's independent efforts, and is more than merely trivial." Alfred Bell & Co. v. Catalada Fine Arts, Inc., 191 F. 2d 99 (2d Cir. 1951); Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 250 (1903). In fact, in Alfred Bell, the court stated originality for copyright purposes amounts to "little more than a prohibition of actual copying." *Cited in* Hoague-Sprague Corp. v. Frank C. Meyer, Inc., 31 F.2d 583, 586 (E.D.N.Y. 1929).

The Supreme Court in Feist Publications, Inc. v. Rural Tel. Serv. Co., acknowledged that "original" requires the work to possess at least some degree of creativity. 449 U.S. 340 (1991). However, Justice O'Connor's opinion stressed that there remains a narrow category of works in which the "creative spark is utterly lacking or so trivial as to be virtually nonexistent." Feist at 1295. Such works are incapable of sustaining copyright protection.

Several cases have applied the above standard for creativity and determined that the works fell into the distinct category that does not warrant copyright protection. In Vacheron & Constantin-Le Coutre Watches, Inc. v. Benrus Watch Company, Inc., 155 F. Supp. 932 (S.D.N.Y. 1957) *aff'd* 260 F. 2d 637 (2d. Cir. 1958), a watch manufacturer sold highly decorative watches that incorporated distinctive watch faces. For example, the "Galaxy" face had jeweled sticks in place of the numerals, transparent rotating discs that contain different sized jewels substituted for the hands, and inside the discs were polygonal metal heads cut with facets like a rose-cut diamond. The court agreed with the Register that when any nonutilitarian features were considered separately from the utilitarian features of the watch, they did not meet the requisite level of creativity. The court recognized a "penumbra where the object is so clearly a work of art that its utility will not preclude its registration," giving the example of an engraved glass vase. Vacheron at 934. However, in this case the court did not even find "minimal creativity" in the separable elements such as the hand and numeral designs.

In DBC of New York, Inc. v. Merit Diamond Corp., 768 F. Supp. 414 (S.D.N.Y. 1991), a jewelry manufacturer developed diamond ring designs called "marquise trillions" that contained two graduated marquise stones flanked by two triangular-cut stones ("trillions"), featured triangular indentations in the band portion, and the bands themselves were knife-edged with two inclined surfaces on the outer sides meeting in a sharp edge.. Again, the court agreed with the Register's denial based on the rule that familiar symbols or designs are not entitled to copyright protection. The court also relied on Nimmer's analysis that "insofar as a shape is in the public domain (circles, squares, triangles and ellipses) no copyright may be claimed whether or not it is integrated into a utilitarian article." Nimmer & Nimmer, 1 Nimmer on Copyright, § 2.08 [B] at n.115.2 (1999). The court used the above principles to conclude: "the individual elements of DBC's designs, such as the marquise stones, the trillions and the knife-edged shank, were each separately well-known in the jewelry trade before DBC's creation of the rings at bar." DBC at 416. Additionally, the court stated that even the combination of these elements does not change the fact that the rings are not exceptional, original or unique." *Id.*

A third case reiterated the concept that common shapes are not copyrightable. In Jon Woods Fashions, Inc. v. Donald C. Curran, 8 U.S.P.Q. 2d 1870 (S.D.N.Y. 1988), the work at issue was a fabric design called "Awning Grids" that superimposed a grid of squares over cloth with two inch stripes. The plaintiff claimed that the combination of the stripes and grids created a design that was "enough" of the author's to be both original and creative. The court responded to this argument by restating the Register's position that works lacking the minimal amount of creative authorship include those which consist of "familiar designs or symbols" or a "simple combination of two or three standard symbols such as a circle, a star, or a triangle with minor linear variations. Jon Woods at 1872. Therefore, the design elements at issue were not proper subjects for copyright protection even when they are "distinctively arranged or printed."

Finally, in another pre-Feist case, John Muller & Co. v. New York Arrows Soccer Team, Inc., 802 F. 2d 989 (8th Cir. 1986), a logo for a soccer team consisting of four angled lines which formed an arrow, and the word "Arrows" written below in cursive script, was denied copyrightability because it lacked the minimal amount of creativity necessary for copyright protection– even prior to the clear, and confirming, articulation of the principle in Feist.

While it may be correct that the courts give deference to the decisions of the Register of Copyrights, that is not the premise for which they are cited here. In each case the court applied the creativity standard to works analogous to the watches at issue here, and consistently found them to lack the required level of creativity to support copyright protection.

The Five Works Denied Registration by the Board of Appeals

In analyzing the works in question, it is useful to repeat key concepts of conceptual separability and originality articulated by the Copyright Office.

First, as mentioned above, the test in determining conceptual separability states: "The artistic features and the useful article could both exist side by side and be perceived as fully realized, separate works – one an artistic work and the other a useful article." This is the framework from which the Copyright Office has analyzed your works.

Second, the mere fact that certain features are nonfunctional or could have been designed differently is irrelevant under the statutory definition of pictorial, graphic and sculptural works. Thus, the fact that a lighting fixture might resemble abstract sculpture would not transform the lighting fixture into a copyrightable work. Compendium II at § 505.03.

Finally, the Compendium recognizes that

> registration cannot be based upon the simplicity of standard ornamentation such as chevron stripes, the attractiveness of a conventional fleer-de-L.S. design, or the religious significance of a plain, ordinary cross. Similarly, it is not possible to copyright common geometric figures or shapes such as the hexagon or the ellipse, a standard symbol such as an arrow or a five-pointed star. *Id.*.

WATCH (C103)

This work has a circular design surrounded by a metal rim, and the interior of the face contains the word "Chevrolet", a Chevrolet logo, and a cross-hatched pattern combining the colors of red, yellow, and black. You indicated that this particular design was intended to create the impression of an automobile with a front grill area and a tire. Applying the Copyright Office's test for conceptual separability, the Board did agree that certain elements of the design are conceptually separable from the utilitarian functions of the watch. However, those elements do not rise to the level of copyrightability and are *de minimis*. The insignia and trademark of the Chevrolet motor company can hardly be said to be original at this time, and the cross-hatched pattern is a common design. Even taken together, these elements do not rise to the level of copyrightability.

As in DBC of New York, Inc. v. Merit Diamond Corp., where copyright protection was sought for elements of an elaborate ring design, your argument is that the elements of your watch face are protectable expression. 786 F. Supp. 414. However, in DBC the court separated the nonfunctional elements of the ring design, such as the marquise stones, the "trillions" and the knife-edged shank, and found them to be merely "familiar shapes or designs" that were in the public domain and therefore, not sufficiently original for copyright protection. *Id* at 416. Similarly, when we separate the nonfunctional elements of WATCH (C103), the only elements remaining are a cross-hatched pattern, a common design, and the Chevrolet insignia, which is clearly not original to this work.

WATCH (C106)

This work has a rectangular shaped face, surrounded by a rectangular metal border with a set of two circular screws placed in each corner of the rim. Inside the face is the word "Chevrolet" and the Chevrolet logo which is placed in the center of a set of three horizontal lines. In your previous letters, you stated the watch conveys a modern art depiction of an automobile with the grill set in the watch face and the tires in each corner of the watch. We have mentioned before that the geometric elements and the names and logos depicted in these works are not copyrightable themselves. The four straight horizontal lines that you suggest represent a grill are *de minimis*. The combination of these elements does not contain even the modicum of creativity required to justify copyright registration. Creativity has been interpreted by the courts to mean that the authorship must constitute something more than a trivial variation of public domain elements. Moreover, it appears that the circular screws placed in the corners of the rim are most likely functional, which would eliminate them from the scope of an artistic work.

Similar to your design for WATCH (C106) was the "Arrows" logo presented in John Muller & Company v. New York Arrows Soccer Team, 802 F. 2d 989. The design in that case also consisted of horizontal lines and a single word. The court found that the combination of these geometric shapes and a name was not sufficiently creative to support copyright protection in the John Muller case, and therefore, a similar combination of four horizontal lines and the word "Chevrolet" in your watch design is not sufficiently creative to support registration.

WATCH (F123)

The watch face displays a Ford logo inside of two concentric circles, and the outside rim is recessed and has a serrated design. You stated that this design is an abstract depiction of an automobile tire; and the change in color between the inner, middle and outer portions of the design and the serrated "tread" evoke a stylized, modern art depiction of a tire. Again, the geometric shapes and colors are part of the public domain, and even when combined, do not contain sufficient authorship to sustain copyrightability. The serrated rim is simply a regularly repeated ridge, that does not itself comprise original, artistic expression. The Compendium states that a simple combination of a few standard symbols, such as a circle, a star,

and a triangle, with minor linear or spatial variations will not warrant copyright registration. Compendium II at § 503.02 (a).

A comparable "abstract" watch design was denied in Vacheron & Constantin-Le Coutre Watches, Inc. v. Benrus Watch Company, Inc., where the concentric rotating discs and jeweled numerals were found to be merely familiar symbols, and not sufficiently creative. 155 F. Supp. 932. The Board can find no appreciable difference between the separable elements in Vacheron and those found in WATCH (F123), namely, the concentric designs which are merely geometric shapes. In addition, the presence of the serrated rim in WATCH (F123) is not significantly different than the "triangular indentations in the band" of the rings in DBC.

WATCH (F124)

This design contains the Ford logo, a circular metal rim with 12 screws spaced in sets of two around the plate, and rectangular shapes located at each of the hour positions. You describe this design as an abstract depiction of an automobile engine head bolted to the engine block. This work contains simple geometric shapes, and even when considered together as a potential compilation, it does not evidence the necessary level of creativity to support registration. The Compendium reads:

> A compilation is registerable if its selection, coordination, or arrangement as a whole constitutes an original work of authorship. The greater the amount of material from which to select, coordinate, or order, the more likely it is that the compilation will be registerable. Where the compilation lacks a certain minimum amount of original authorship, registration will be refused. Any compilation consisting of less than four selections is considered to lack the requisite original authorship. *Id.*, § 307.01.

Again, the cited cases support the Board's determination that WATCH (F124) does not contain sufficiently creative separable elements. The mere presence of the Ford logo and a series of geometric shapes, namely the screws and the rectangular shapes, is analogous to the "Arrows" logo in John Muller and the rectangular jeweled numerals in Vacheron, which were denied copyright protection for lack of authorship.

WATCH (F125)

This watch design contains the Ford logo and a series of three concentric circles. The inner and outermost circles contain a series of vertical lines surrounded by a circular metal rim; engraved on the rim are a serious of 6 flute like shapes. You state that the entire design conveys the impression of a spinning automobile tire, with the outermost fluted ring depicting a stylized wheel rim. The circles and lines are merely geometric shapes, and when combined, fail to express any original authorship. Therefore, any separable elements have *de minimis* levels of originality, and are not copyrightable.

Like the creator of the watch in Vacheron, you have sought to create an abstract image in WATCH (F125), combining circles, vertical lines, and flute-like shapes, which are elements that are not original, but in the public domain. Also, you have incorporated the Ford logo with a series of geometric shapes, which is similar to the design elements that were found insufficient to support copyright protection in John Muller. Finally, the combination of these type of "standard symbols" was denied copyright protection in John Woods Fashions, Inc. v. Donald Curran, in which the plaintiff defended a fabric that merely combined lines with grid patterns. 8 U.S.P.Q. 2d 1870.

SUMMARY

The following summarizes the disposition of the nine Taxor, Inc. works you submitted for registration March 23, 1998:

Applications Initially Rejected After Correspondence:

WATCH (C101)
WATCH (C102)
WATCH (C103)
WATCH (C105)
WATCH (C106)
WATCH (F123)
WATCH (F124)
WATCH (F125)
WATCH (F128)

To be Registered Following Decision of Appeals Board:

WATCH (C101)
WATCH (C102)
WATCH (C105)
WATCH (F128)

Final Denial of Registration by Board of Appeals As of This Date:

WATCH (C103)
WATCH (C106)
WATCH (F123)
WATCH (F124)
WATCH (F125)

CONCLUSION

For the reasons stated above, the Copyright Office Board of Appeals concludes that WATCH (C101), WATCH (C102), WATCH (C105) and WATCH (F128), may be registered, but that WATCH (C103), WATCH (C106), WATCH (F123), WATCH (F124) and WATCH (F125) cannot be registered. This decision constitutes final agency action.

Sincerely,

Nanette Petruzzelli

Nanette Petruzelli
Chief, Examining Division
for the Appeals Board
United States Copyright Office