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September 13, 2001

Leonard D. DuBoff, Esq.
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Re: Whitney Boin Collection 1984/Control No. 60-615-5681(D)
Whitney Boin Collection 1996/Control No. 60-615-9387(D)
Your file #577

Dear Mr. DuBoff:

The Copyright Office Board of Appeals has completed its review of your request for reconsideration of the Office's refusal to register the works entitled Whitney Boin Collection 1984 and Whitney Boin Collection 1996. Based upon its review of the additional photographs of the rings in the 1996 Collection, which present more detail than the photographs submitted with the original application, the Board of Appeals has determined that the Whitney Boin Collection 1996 embodies sufficient original authorship, as required by Title 17, United States Code, and related case law, to support a registration. The Office will finalize the administrative work needed to complete the registration and issue a registration certificate for the 1996 Collection with an effective date of registration of February 6, 1998.

However, the Board has found that the works in the Whitney Boin Collection 1984 lack adequate notice of copyright. The reasons for the Board's decision were set forth previously in our February 4, 2000, letter to you, which is attached. Specifically, the Board determined that what had been identified on the rings in the 1984 collection as the copyright notice could not be reasonably identified as a copyright notice without the aid of a magnifying device. Since a copyright notice must be legible with the naked eye, the Board has found the notices on the rings in the 1984 Collection to be inadequate and thus fatally defective. See 37 CFR 202.2(b)(8) and Compendium of Copyright Office Practices, Compendium II, § 1016 (1984); see also Kieselstein-Cord v. Accessaries by Pearl, Inc., 489 F. Supp. 732 (S.D.N.Y. 1980), rev'd on other grounds, 632 F.2d 989 (2d Cir. 1980) (statute requires "reasonable notice," meaning legibility to the naked eye).

Administrative record

The initial applications for registration of the Whitney Boin Collection 1984 and the Whitney Boin Collection 1996 were received on February 3, 1998, and February 6, 1998, respectively. The application for the registration of the 1984

collection was rejected on June 18, 1998, and the application for the 1996 collection was rejected on June 30 that same year. In both cases, the applications were rejected on the ground that the works lacked sufficient artistic or sculptural authorship to support a copyright. The examiner also noted in the June 18 letter that the works in the 1984 collection were first published that year,1984, and that the identifying material failed to show a copyright notice for these works, as required for all works published prior to March 1, 1989 (the effective date of the Berne Convention Implementation Act).

On October 13, 1998, you filed a request for reconsideration, arguing that under Feist Publications v. Rural Tel. Serv. Co., 111 S. Ct. 1282 (1991), "the works composing the collections evidence the requisite degree of artistic expression to be afforded copyright protection." Specifically, you argued that the artist combined familiar, geometric elements to create distinctive and unique designs, which together, exhibited sufficient originality to merit copyright protection. You also stated that each of the rings had a copyright notice and that you would forward photographs of the rings to verify this point. However, in lieu of photographs, you initially sent a sample of the copyright notice and a brass plate stamped with the four copies of the notice as it appears on the interior surface of the rings.

In response to the initial request for reconsideration, Ms. Virginia Giroux expanded on the reasoning for the initial rejections. (Letter from Virginia Giroux to Leonard D. DuBoff, dated February 17, 1999). Ms. Giroux pointed out that neither the geometric shapes used in the designs nor the combination of these elements, even with the use of the textured contrasts, rise to the level of copyrightable authorship necessary to sustain a copyright registration. She also found that the works discussed in the cases you cited were more complex that the works in your client's collections, and therefore, not comparable to the works at issue here. Her letter, however, contained no discussion on the adequacy of the copyright notice.

On June 11, 1999, you filed a second appeal on behalf of your client, asserting that the works contained sufficient creativity to merit registration. Your contention was that the works contained more than familiar or common designs. First, you argued that the posts holding the diamonds are unique because they are oversized and perfectly symmetrical, unlike traditional posts used in the industry which, in contrast, are small and hidden. You also asserted that the creativity of the unique post designs and metal bands are "further enhanced by other aspects of the rings, such as creative and original combinations of gold, burnished platinum and polished platinum." In support of your position, you relied heavily on case law which found unique arrangements of common elements sufficiently original to support a copyright registration, citing, among others, Amplex Mf. Co. v. ABC Plastic Fabricators, Inc., 184 F. Supp. 285 (E.D. Pa. 1960) (finding a distinguishable arrangement and presentation of a pen-and-ink drawing of Egyptian lettering sufficiently original to

support a copyright) and Pantone, Inc. v. A.I. Friedman, Inc., 294 F. Supp. 545 (S.D.N.Y.1968) (finding more than a trivial variation in the selection and arrangement of bands of color presented in gradations moving from one basic hue to another).

After reviewing the submitted materials, the Copyright Office Board of Appeals made an initial determination that the works in the 1984 collection could not be registered because the works lacked an adequate notice of copyright. (Letter from David Carson to Leonard DuBoff, dated February 4, 2000). The Board also decided at this time not to make a final determination on whether the works in either the 1984 or the 1996 Collection were registrable, specifically, whether the 1996 Collection contained sufficient creativity to support a copyright [the photographs of the rings failed to disclose the works in sufficient detail] and whether the 1984 Collection carried copyright notices which were sufficient under the statute, applicable case law, and the Office's regulations. Instead, the Board decided to offer you an opportunity to submit additional photographs of the works and any other supplemental information which supported your position before making its final decision with respect to both Collections.

In response to the Board's request, you submitted additional photographs of the works in the Whitney Boin Collection 1984 and the Whitney Boin Collection 1996 on March 6, 2000. [As noted above, registration of the 1996 Collection will be completed.] The photographs showed the copyright notice as it appeared on the interior surface of the rings and provided a higher magnification of the details of the design. In this March 6, 2000 letter, you opined that the notice met the statutory requirements. However, you recognized that the Board may not reach the same conclusion and stated that, in which case, your client wished to rely on the statutory provision that provides that the omission of notice will not invalidate the copyright in a work when only a relatively small number of the works have been distributed to the public.

Copyright Notice

A work that contains a notice that cannot be read without the aid of a magnifying glass is treated as one that has been published without notice. Compendium of Copyright Office Practices, Compendium II, § 1016 (1984). For works published prior to the effective date of the Berne Convention Implementation Act of 1988, the Copyright Office generally does not register works published without notice or with a fatally defective notice by authority of the copyright owner, if more than five years have elapsed since publication. Compendium of Copyright Office Practices, Compendium II, § 1008.01 (1984). The Whitney Boin Collection 1984 was first published in 1984 and therefore cannot be registered under the general rule.

There are, however, two exceptions to the general rule. Registration may occur after the five year period if: 1) the notice has been omitted from "no more

than a relatively small number of copies or phonorecords distributed to the public;" or 2) the notice has been omitted in violation of a written requirement that the work contain the prescribed notice. See 17 U.S.C. 405(a)(1) and (3). In your March 6, 2000 letter you suggest that registration is appropriate "since only a 'relatively small number' of pieces were, in fact, distributed and sold," and cite section 405(b) of the copyright statute in support of your position. Section 405(b), however, concerns the effect of omission on innocent infringers. Rather, it is subsection (a) which lists the three circumstances in which omission of a copyright notice does not invalidate a copyright registration.

The first of these, and the one upon which your client wishes to rely, is where "the notice has been omitted from no more than a relatively small number of copies or phonorecords distributed to the public." 17 U.S.C. 405(a)(1). Unfortunately, reliance on this section offers no apparent relief to your client. The statutory provision addresses a situation where the omission pertains to a relatively small number of copies from among all those copies of a given work that have been distributed. *See* H.R. Rep. No, 1476, 94th Cong., 2d Sess. 147 (1976) on Congress's reference to the previous [1909] copyright statute, section 21, which forgave accidental omission of copyright notice from "a particular copy or copies" and Congress's further explanatory statement that "the phrase 'relatively small number' [in 17 U.S.C. 405(a)(1)] is intended to be less restrictive" than the 1909 language; *see also* **NIMMER 7.13[A][[1]** (1999 ed.) on the meaning of "relative": " 'Relative' to what if not to the total number of copies or phonorecords distributed to the public?"

The section 405(a)(1) situation is one in which some proportion of copies out of the entire quantity of copies of a given work do not carry a notice– and in this case, although a copyright notice is present on the rings, the notice which appears is considered fatally defective because of its microscopic size– and not, as it appears from your description of the 1984 Collection, where the unacceptably small-sized, i.e., fatally defective, copyright notice effectively appears on **every** copy of the small number of copies distributed and sold. *Compare* Original Appalachian Artworks, Inc. v. Toy Loft, Inc., 684 F.2d 821 (11th Cir. 1982) (finding that omission of notice from one percent of the total number of copies meets the "relatively few" standard of section 405(a)(1)), with Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485 (9th Cir. 1985) (finding that omission of notice from 20,000 out of 25,000 copies is more than a relatively small number).

Therefore, the Copyright Office Board of Appeals is adopting its initial determination that the Whitney Boin Collection 1984 cannot be registered because the works within the Collection lack adequate notice of copyright and the time for seeking registration of a published work without notice or with inadequate notice has expired. The Board has also determined that the Whitney Boin Collection 1984 may not be registered under the statutory exception that would allow registration where copyright

notice was omitted [here, a fatally defective, microscopic-sized notice] from no more than a relatively small number of copies distributed to the public.

This letter constitutes final agency action.

Sincerely,

Nanette Petruzzelli

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

Attachment: February 4, 2000 Copyright Office letter

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Dear Mr. DuBoff:

The Copyright Office Board of Appeals has reviewed your request for reconsideration of the Office's refusal to register the works entitled Whitney Boin Collection 1984 and Whitney Boin Collection 1996. The Board has made an initial determination that the 1984 Collection cannot be registered because the works lack an adequate notice of copyright. Since this is a threshold question, the Board did not consider further the arguments offered on whether the works contained sufficient creativity to support a copyright. However, the Board will consider this issue, if you can demonstrate in a supplemental filing that the notice on the rings in the 1984 Collection was adequate under the law at the time the works were published.

The Board has also decided not to make a final determination on whether to register the works in the Whitney Boin Collection 1996 because the photograph of the rings in the 1996 collection fails to illustrate the details of the works with sufficient clarity. Therefore, the Board requests that you submit additional photographs of the works in this collection which illustrate these works in greater detail. These photographs should display each work on a larger scale and from various angles so that the Board can perceive all aspects of authorship that you claim in each work.

Once the Board receives the supplemental information, it will resume its consideration of your request to register the Whitney Boin Collection 1984 and the Whitney Boin Collection 1996.

Copyright Notice

The application for registration of the 1984 collection notes that these works were first published in 1984. Works published before the effective date of the 1988 Berne Convention Implementation Act must bear a statutory notice of copyright or be registered within five years of publication in order to maintain copyright. *See* 17 U.S.C. § 405(a). This requirement was noted in the initial letter from the Office, dated June 18, 1998, which rejected the application for registration because the works lacked the requisite degree of creativity.

You addressed the notice issue briefly in your first appeals letter, dated October 13, 1998. In that letter, you stated that "all rings in the collection entitled Whitney Boin Collection 1984 have been stamped with the copyright notice inside at all relevant times," and that photographs of each work showing the copyright notice would be forwarded to this Office. However, no photographs of the works depicting the placement of the notices have been sent. Instead, you submitted a brass plate stamped with four copies of the notice to illustrate the appearance of the notice placed on the interior surface of each ring as a supplemental filing to your first appeals letter. (Letter with enclosure dated December 2, 1998).

Even though notice was a threshold issue on the question of whether to register the 1984 Collection, the supplemental material was never evaluated by the examiner considering the first appeals letter. Instead, the examiner based her decision to uphold the initial determination not to register either the 1984 Collection or the 1996 Collection on her independent evaluation that the works did not contain sufficient authorship to support a copyright. That determination led to the second appeal.

When the Board met to consider the appeal relating to the 1984 Collection, the Board's attention was focused on the supplemental submission and the threshold question of whether there was an adequate notice attached to the works in the 1984 Collection. Upon its examination of the impressions in the brass plate, the Board determined that the placement of such a mark on a work did not provide adequate notice of copyright under the law. A notice that is so small that it cannot be read without the aid of a magnifying device cannot give adequate notice, and therefore is fatally deficient. *See* 37 CFR 202.2(b)(8) and Compendium of Copyright Office Practices, Compendium II, § 1016 (1984). The Copyright Act does not allow registration of such a work if published before the effective date of the 1988 Berne Convention Implementation Act. *See* 17 U.S.C. § 405(a) and Compendium of Copyright Office Practices, Compendium II, § 1008.01 (1984). In this case, it appears that what you have identified as the copyright notice cannot even be identified by the naked eye as a copyright notice. For these reasons, the Board believes that the decision to deny registration of the works in the 1984 Collection should be upheld, not because they lacked sufficient creativity, but because the copyright notice as it appears on the brass plate is fatally deficient.

This is an initial determination of the Board which you may address in a supplemental filing. The Board is allowing further consideration of the question of adequate notice in this case only because it was not addressed directly during the earlier stages of the appeals process. Should you choose to pursue the question of the adequacy of the notice, and if the Board is persuaded that the notice for the 1984 Collection is not defective, it will then consider the second question of whether there is sufficient authorship to support a copyright.

All additional information with respect to the 1984 Collection and the 1996 Collection must be submitted to the Board by April 4, 2000. Any additional submissions will be considered as supplemental materials for purposes of the second appeal. No further fees are required.

Sincerely,

David O. Carson,
General Counsel
for the Appeals Board
United States Copyright Office