FILE COPY

The Register of Copyrights of the United States of America
United States Copyright Office · 101 Independence Avenue SE · Washington, DC 20559-6000 · (202) 707-8350

February 3, 2005

Theodore C. Max, Esq.
Mintz Levin Cohn Ferris
Glovsky & Popeo, P.C.
Chrysler Center
666 Third Avenue
New York, New York 10017

Re: **2119E: Pair of Dangling Diamond Earrings**
2111N: Necklace of White Rose Cut Diamond
2100E: Pair of Rose Cut Diamond Earrings
2099E: Pair of Rose Cut Diamond Earrings
2032BS: Spider Bracelet Brown Rose Cut Diamond
2001BS: Spider Bracelet Of Rose Cut Diamond
2078N: Organdie Necklace
2114E: Pair of Briolette Diamond Dangling Earrings
Copyright Office Control No. 61-209-4311 (M)

Dear Mr. Max:

I am writing on behalf of the Copyright Office Board of Appeals (now, Review Board), in response to your letter dated June 25, 2003, requesting reconsideration of the Examining Division's refusal to register the above-entitled eight jewelry designs. The Board has carefully reviewed your letter requesting reconsideration and all correspondence in this case, has examined the works represented by the identifying material submitted as deposit copies, and has thoroughly reviewed the accompanying registration materials, including the additional enlarged photographs. The Board has found that all eight jewelry designs are not copyrightable and thus affirms the denial of registration by the Examining Division.

I. ADMINISTRATIVE RECORD

A. Initial application and refusal to register

On July 16, 2002, the Copyright Office received applications, identifying materials and fees which you submitted on behalf of Dorera Limited, LLC, for these eight works. Visual Arts Examiner Joy Mansfield rejected the eight works by letter dated September 16, 2002. Examiner Mansfield confirmed that original works fixed in some physical form were potentially registrable but pointed

out that a certain minimum amount of original material is also required to have originated with the author.

In refusing to register these works, she found that the jewelry designs at issue lacked the necessary artistic or sculptural authorship. She contrasted the question of aesthetic or commercial value with the necessity for creative authorship within the meaning of *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), and other settled case law. Ms. Mansfield also contrasted the necessary creative authorship with ideas, systems, and concepts, which are not subject to copyright. Finally, she noted that a familiar shape, symbol, or design or a mere variation thereof is not subject to copyright, citing Copyright Office Regulation 37 C.F.R. 202.1. Letter from Mansfield to Max of 9/16/2002 at 1. Ms. Mansfield concluded that the necessary authorship was not present in these jewelry designs, and rejected the works for registration.

B. First request for reconsideration

On January 14, 2003, you requested reconsideration of that decision. You argued that each design satisfied the minimum standard for originality, stressing elements you described as "novel" or "unique." Letter from Max to Examining Division of 1/14/2003 at 2 - 3. You specifically urged that the works are registrable within the creativity standard enunciated in *Feist*, noting that the requisite standard is low and that the vast majority of works meets the level needed, barely more than a prohibition on actual copying, citing *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951). Letter from Max of 1/14/2003 at 1 - 2.

After describing the designs in detail, you also point out that the contribution of the designer, Ms. Michelle Ong, makes each design something recognizably her own, favorably comparing these designs with the "modest but sufficient" embellished design in repeat found protectable in *Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.*, 490 F.2d 1092 (2d Cir. 1964), stating the principle that the "minimal quantum of originality in the textile pattern field, where the design printed is itself unmistakably original, as here, is not very high." Letter from Max of 1/14/2003 at 4.

You also recalled Justice Ginsburg's opinion in *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C.Cir. 1992) that use of standard geometric symbols does not disqualify a work from consideration as a copyrightable work. Finally, in addition to commending to the Examining Division the holdings in *Atari, Bell v. Catalda,* and *Feist,* you cited, among others, the case law precedent of *Yurman Designs, Inc. v. PAJ, Inc.*, 262 F.3d 101 (2d Cir. 2001), *North Coast Industries v. Jason Maxwell, Inc.*, 972 F.2d 1031 (9th Cir. 1992); and *Weindling International Corp. v. Kobi Katz, Inc.*, 2000 WL 1458788 at *4 (S.D.N.Y. Sep. 20, 2000).

C. Examining Division's response to first request for reconsideration

Examining Division Attorney Advisor Virginia Giroux, by letter dated March 28, 2003, advised you that the Examining Division could not register the copyright claims in these jewelry designs. Letter from Giroux to Max of 3/28/2003 at 1. She pointed out that although, in general, jewelry designs may be copyrighted, not all can be, citing *Feist* and *Bell v. Catalda* as requiring more than a trivial variation of public domain elements, in contrast to attractiveness, uniqueness, and commercial success, which are not factors for determining copyrightability. Attorney Giroux stated the question as "whether there is sufficient original and creative authorship within the meaning of the copyright law and settled case law." Letter from Giroux of 3/28/2003 at 2.

Attorney Giroux's analysis of these jewelry designs led her to conclude that the designs at hand were too minimal to be registered for copyright. She noted that "Simple variations of standard designs and their simple arrangements may be aesthetically pleasing, but they do not furnish a basis upon which to support a copyright registration," citing *John Muller & Co. 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 1879 (S.D.N.Y. 1988); and *DBC of New York, Inc. v. Merit Diamond Corp.,* 768 F.Supp. 414 (S.D.N.Y. 1991). Letter from Giroux of 3/28/2003 at 3.

Ms. Giroux agreed with *Feist's* precedent but found that neither the diamond elements nor the arrangements embodied in these works met the threshold for copyrightable authorship. Letter from Giroux of 3/28/2003 at 3. She also cited the decision in *OddzOn Products, Inc. v. Oman,* 924 F.2d 346 (D.C.Cir. 1991) and noted "the court held that the Register did not abuse his discretion in refusing a "Koosh" ball, a sphere lacking enough additional creative material beyond the object and shape to warrant a copyright registration." Letter from Giroux of 3/28/2003 at 4.

Noting the Office's agreement with *Atari's* principle that a work must be reviewed in its entirety to determine whether the work's elements interrelate to make up a copyrightable work as a whole, Ms. Giroux applied *Atari's* standard to find that "the combination and arrangement of the diamonds and their supports in these particular works do not rise to the level of copyrightability necessary to sustain copyright registration." Letter from Giroux of 3/28/03 at 3. Attorney Giroux then distinguished the various cases you discussed, bringing to your attention the context in which those cases were decided by noting that the copyrighted works in those cases were more complex than the jewelry designs at issue here. *Id.* at 3 - 5.

D. Second request for reconsideration

On June 25, 2003, you appealed to this Board to reconsider the Examining Division's refusal to register these jewelry designs. You state that the Examining Division's response is in error on three grounds. You assert 1) that the Examining Division focused on individual elements

rather than the design of the works as a whole; 2) that its decision rests upon factual errors that indicate that it may not have completely and carefully examined the works; and 3) that by pointing out that the works at issue in cases which you cited are more complex than the works at issue here, the Division relies on a subjective application of the test for registrability. Letter from Max to Board of Appeals of 6/25/2003 at 1 - 2.

You recall the extremely low standard of *Feist* in the selection and arrangement of unoriginal elements and state that it is the authorship inherent in selection and arrangement that warrants registration of the jewelry designs. Letter from Max of 6/25/2003 at 2. You disagree with the Examining Division conclusion that the jewelry designs at issue here are "common and familiar shapes or designs" and disagree that the cases cited support that conclusion, distinguishing *Jon Woods* and *John Muller* as cases that predate *Atari* and *Feist.* You criticize *DBC of New York* as flawed because, you assert, it considered uniqueness in its decision on registrability. You also take issue with the Office's citation and discussion of *OddzOn Products, Inc. v. Oman,* 924 F.2d 346 (D.C.Cir. 1991) as a basis for the Examining Division's decision because, in your view, the Examining Division erroneously states the court's determination in that case. You then reassert the creative authorship in the eight jewelry designs at issue here, citing *Herbert Rosenthal Jewelry Corp. v. Grossbardt,* 164 U.S.P.Q.2d 602 (S.D.N.Y. 1970); *Behnam Jewelry Corp v. Aron Basha Corp.,* 45 U.S.P.Q. 2d 1078 (S.D.N.Y. 1997); and *Trifari, Krussman & Fishel v. Charel Co.,* 107 U.S.P.Q. 48 (S.D.N.Y. 1955). Letter from Max at 3-4.

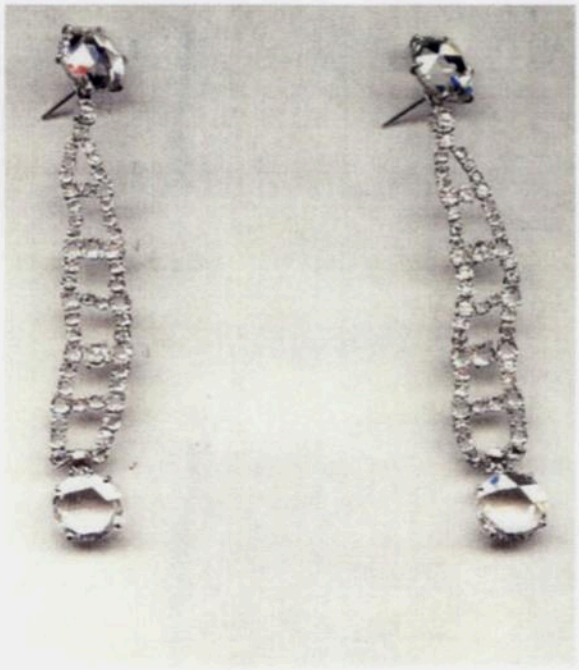
You particularly dispute Attorney Giroux's description of two jewelry items, the Pair of Dangling Diamond Earrings 2119E, and Necklace of White Rose Cut Diamonds 2111N, as having an identical design, stating that the items are much more complex than "a series of unequal strings of dangling diamonds," but allow that the "necklace is complementary in that it has diamond strands intersected by crossing strands which feature accentuations of larger diamonds." You state that the necklace's sections "flow vertically, but are not...parallel." Letter from Max of 6/25/2003 at 5. You also describe in detail the other jewelry designs at issue here, emphasizing the composition of each work to conclude its copyrightability. Finally, you deduce that Ms. Giroux erroneously engaged in subjective comparisons of these works with works from decided cases from her statement that the works in the cases which you cited to the Office were more complex than the jewelry designs at issue here. Letter from Max of 6/25/03 at 7 - 8. You conclude that "[r]egistrability is not dependent upon a given work being more or less complex than a registered work...[but upon] whether each work which is the subject of examination contains protectible authorship." *Id.* at 8.

II. DECISION

A. Description of works

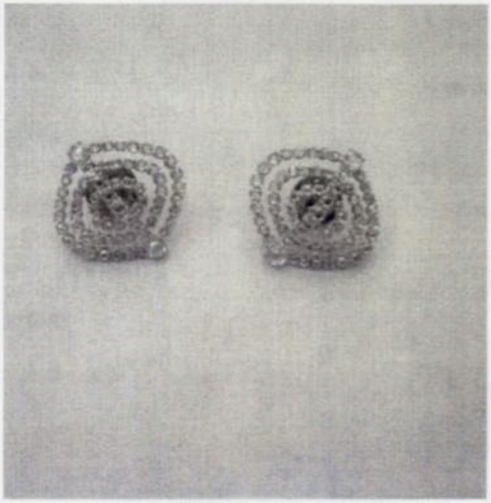
Before proceeding with our discussion of the works, we describe each of the eight jewelry designs submitted to the Office. Generally, as far as text descriptions are concerned, we acknowledge that the same work is amenable to many different descriptions, and each description may include more or less detail. We incorporate the pictorial illustration for each work herein.

1. Dangling Diamond Earrings: 2119E. This jewelry work consists of a vertical, thin loop divided by ladder-like "rungs." A large diamond is positioned at the top of the vertical loop where the earring is inserted into the ear and another almost identical large diamond is attached to the end of the loop. Smaller diamonds cover the loop itself as well as the "rungs;" the loop comes to a point directly beneath the top diamond and the end of the loop is slightly rounded at the bottom to which the second larger diamond is attached.

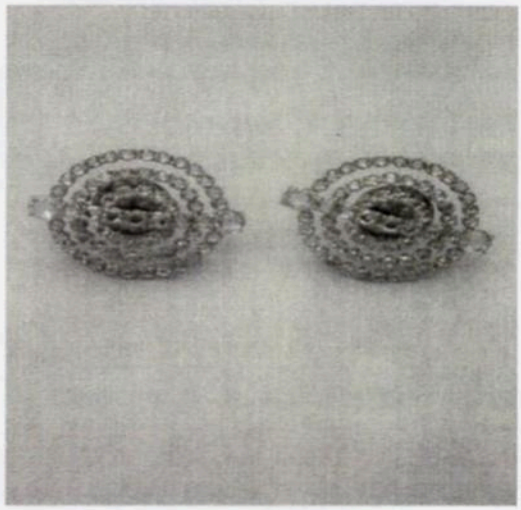


2119E

2. Rose Cut Diamond Earrings 2100E and 3. Rose Cut Diamond Earrings 2099E. The pair of earrings identified as 2099E consists of three concentric circles covered with small diamond stones. The concentric circles are bisected at the diameter by a bar of slightly larger diamond stones and the bar begins and ends outside the outermost circle with larger stones at the ending of the bar. The pair of earrings identified as 2100E is extremely similar, except that its concentric rings are slightly arched.

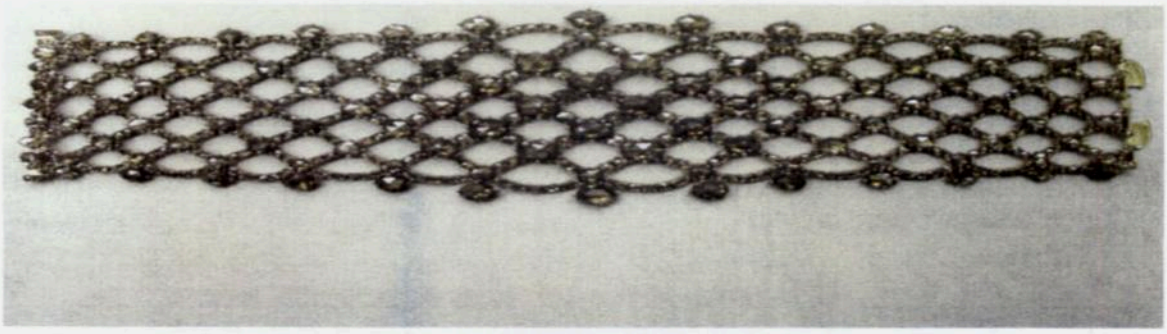


2100E



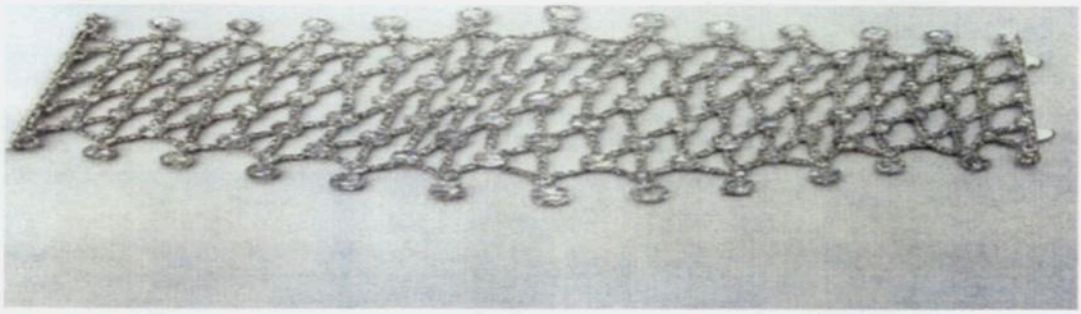
2099E

4. Spider Bracelet of Brown Rose Cut Diamonds. The bracelet identified as 2032BS, although it has been identified as resembling a spider web, has an overall shape of a long, slightly bowed-in-the-center rectangle. Within the rectangle are diagonal rows of open "X's (crisscross spaces), which form a lattice. Both larger and smaller gems delineate the points where the lines of the lattice-work cross. The long sides of the rectangle end in scalloped edges and each scallop has a diamond pendant attached.



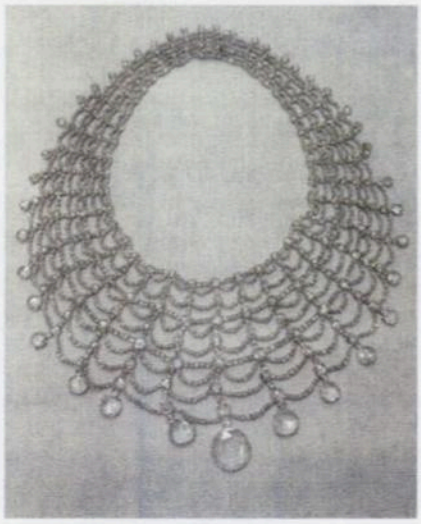
2032BS

5. Spider Bracelet of Rose Cut Diamonds. This bracelet identified as 2001BS is a similar rectangle composed, again, of open lattice work. Again, the lattice-work configuration forms diamond-shaped open spaces or triangle-shaped spaces. The triangle shapes occur at the outer longer edges of the overall rectangle shape of the bracelet. The long sides of the rectangle end in the points formed by either the diamond or the triangle shapes of the lattice-work and a diamond is attached to each of these points.



2001BS

6. Organdie Necklace: 2078N The necklace identified as 2078N, also has been described as resembling a spider web. Here, too, the basic design is latticework: ten rows of straight and scalloped strands of small gem stones joined vertically by a line of gems at each scallop. Again, larger gems define the intersection points. The base design consists of one plain row followed by two scalloped rows except that the last straight row is followed by three scalloped rows. Larger stones are attached to the bottom scalloped strand with one largest stone attached to the mid-point of this last strand.



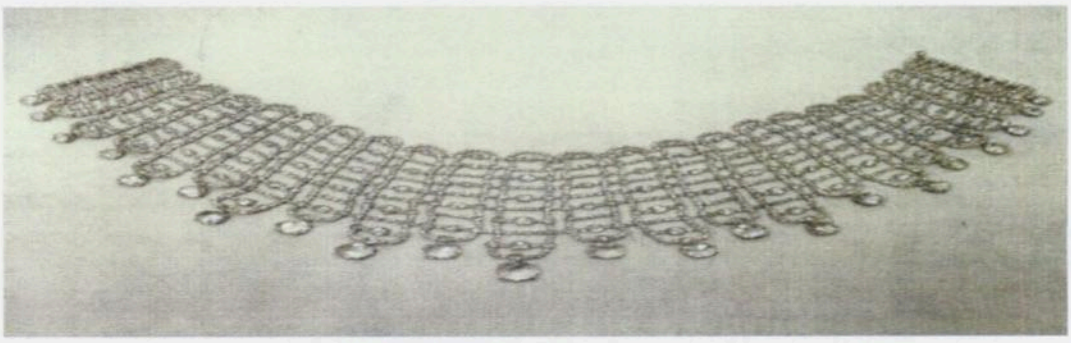
2078

7. *Briolette Diamond Dangling Earrings: 2114E.* The earrings identified as 2114E are essentially linear, beginning with a circular post, continuing with three open diamond shapes spaced along the vertical line of small stones, and ending with a teardrop shaped pendant.



2114E

8. Necklace of White Rose Cut Diamond: 2111N. This necklace identified as 2111N builds upon the design present in Dangling Diamond Earrings 2119E, described above. The necklace consists of numerous vertical loops side-by-side, alternating as one longer loop next to one shorter loop. The end of each loop within the necklace is scalloped and, again, a larger stone hangs from the bottom of each scalloped end. Smaller stones are placed at the mid-point of every other "rung" in each of the ladder-like loops.



2111N

B. The *Feist* standard

The fundamental basis of copyright protection is a work's originality. Originality has two components: independent creation and a certain minimum amount of creativity. *Feist Publications Inc. v. Rural Telephone Service Co.,* 499 U.S. 340, 347 (1991). The Copyright Office applies this standard when it considers whether a work is registrable. In the instant case, we assume the independent creation of the works by the designer, Michelle Ong, as the employee in works made for hire on behalf of the claimant, Dorera Limited, LLC. Thus, we focus on the second prong of the *Feist* standard. As both you and Ms. Giroux have already noted, the requisite quantum of creativity necessary for copyright is very low. Letter from Max of 1/14/2003 at 2-3 (citing *Feist,* 499 U.S. at 345). The Supreme Court has stated, however, that there can be no copyright in works in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Feist,* 499 U.S. at 359. And, a work that reflects an obvious arrangement fails to meet the admittedly low standard of minimum creativity required for copyrightability. *Id.* at 362 - 63. An example would be the alphabetical listings in the white pages of telephone books that the Supreme Court characterized as "garden variety...devoid of even the slightest trace of creativity." *Id.* at 362.

The Copyright Office has had in place long-standing registration practices, prior to *Feist,* which follow settled precedent in recognizing that some works of authorship contain only a *de minimis* amount of authorship, and thus, are not copyrightable. *See Compendium of Copyright Office Practices, Compendium II,* section 202.02(a) (1984): "Works that lack even a certain minimum amount of original authorship are not copyrightable." With respect to pictorial, graphic and sculptural works, the class to which the jewelry designs at issue here belong, *Compendium II* states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." *Id.,* section 503.02(a). Your descriptions of the eight jewelry works are lengthy and detailed, emphasizing the aesthetic components of the works. *Compendium II* recognizes, however, that it is not aesthetic merit, but the presence of creative expression that is determinative of copyrightability. Section 503.01 states: "The registrability of a work does not depend upon artistic merit or aesthetic value. For example, a child's drawing may exhibit a very low level of artistic merit and yet be entitled to registration as a pictorial work."

Section 503.02(a) states:

> [R]egistration cannot be based upon the simplicity of standard ornamentation such as chevron stripes, the attractiveness of a conventional fleur-de-lys 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. Likewise, mere coloration cannot support a copyright even though it may enhance the aesthetic appeal or commercial value of a work.... The

> same is true of a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations.

In response to Ms. Giroux's analysis concluding that the works do "not contain a sufficient amount of original and creative sculptural or artistic authorship to support a copyright registration" Letter from Giroux of 3/28/2003 at 5, you contest the Examining Division's decision that the eight jewelry designs consist of "common and familiar shapes or designs" or "simple variations of standard designs." Letter from Max of 6/25/2003 at 3. You have stated that the designs are "extraordinarily creative works composed of specifically selected elements of varying shape, size and dimensions." *Id.* at 2. We agree that a work need not be complex, ornate, or otherwise complicated in its authorship or composition in order for it to enjoy copyright protection. Again, *Feist* laid to rest the notion that more than a modest level of creativity is needed for copyright protection. However, the authorship present in the jewelry designs at issue here does not meet the modest *Feist* requirement. As we have noted above, *Compendium II*, section 503.02(a), speaks of the need for more than a "simple combination of a few standard symbols...with minor linear or spatial variations." And, concerning three-dimensional authorship--which is present within the sculptural lines of the jewelry works here--*Compendium II*, section 503.02(b) states in a similar vein that:

> Copyrightability is based upon the creative expression of the author, that is, the manner or way in which the material is formed or fashioned. Thus registration cannot be based upon standard designs which lack originality, such as common architecture moldings, or the volute used to decorate the capitals or Ionic and Corinthian columns. Similarly, it is not possible to copyright common geometric figures or shapes in three-dimensional form, such as the cone, cube, or sphere. The mere fact that a work of sculpture embodies uncopyrightable elements, such as standard forms of ornamentation or embellishment, will not prevent registration. However, the creative expression capable of supporting copyright must consist of something more than the mere bringing together of two or three standard forms or shapes with minor linear or spatial variations.

As we indicated above, *at 9,* this registration standard for judging copyrightability was in place before *Feist* and the decided cases and registration practices that are consistent with this standard--and, we maintain, consistent with *Feist*--are still valid. *See, e.g., Alfred Bell & Co., Ltd. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951) (although *Catalda* recognized that "no large measure of novelty is necessary" in a work, 191 F.2d at 102, the court further counseled that the distinguishable variation in a work of authorship for which copyright is sought must be "more than a 'merely trivial' variation." 191 F.2d at 102 - 103); *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir. 1976) (the court opined that "[W]hile the quantum of originality that is required may be modest indeed, citing *Herbert Rosenthal Jewelry Corp. v. Grossbardt*, 436 F.2d 315,316 (2d Cir.

1970), we are not inclined to abandon that requirement..."--the requirement being that of a "minimal element of creativity over and above the requirement of independent effort," citing 1 M. NIMMER, 10.2. 536 F.2d at 490.) The pre-Feist cases cited by Ms. Giroux in her March 28, 2003 letter are consistent with *Feist*'s principle in their analysis of authorship as requiring something more than independent effort; *Feist*, as cited above, *at 9*, acknowledged the possibility of some works failing to meet the low standard of copyrightability.

We also point out that those cases in which a court validated an Office action of refusal to register based upon an Administrative Procedure Act (APA, 5 U.S.C. 701 - 706) standard of review of abuse of discretion do not undermine the Office's analysis of the jewelry designs at issue here. *See Norris Industries, Inc. v. International Telephone and Telegraph Corporation*, 696 F.2d 918 (11th Cir. 1983), a case involving the separability issue in useful articles, in which the court noted generally that other federal circuit courts have relied upon the Office for "expertise in the interpretation of the law and its application to the facts presented by the copyright application," based upon the Office's having "been concerned with the distinction between copyrightable and noncopyrightable works of art since the Copyright Act of 1870..." 696 F.2d at 922. Although an APA-based decision may fairly be viewed as relatively weaker precedent on the issue of copyrightability, such a decision (such as those cited by Ms. Giroux in her 3/28/2003 letter) does underscore a federal court's acceptance of Office determinations of what is and is not copyrightable--the long-standing, statutory responsibility of the Office--as being reasonable and not arbitrary. In its consideration of works before it, the Board does not necessarily find persuasive criticism of case law merely because that case law was decided before *Feist* or merely because it validated the Office's refusal to register rather than deciding copyrightability *de novo.* Letter from Max of 6/25/2003 at 3.

C. The works in their entirety

We recognize that the jewelry designs at issue here are fixed expression and, as such, are eligible subject matter. 17 U.S.C. 102(a). When we examine each of the designs discussed below in its entirety, however, we find that they cannot be registered.[1]

---

[1] As evidence of your point that the Examining Division focused on individual elements, you raise "Dorera's detailed written descriptions of the Jewelry Designs' features and the creative and artistic originality involved in each Jewelry Design's creation," from which you conclude that the Examining Division's declaration that certain factors, such as aesthetic judgments, uniqueness, or symbolism, are not germane to considerations of copyrightability, Letter from Giroux of 3/28/2003 at 2 was an "apparent response" to your discussion of individual elements. Letter from Max of 6/25/2003 at 2. As your descriptions appear to emphasize aesthetic content, the Examining Division clarified the scope of examination, which excludes consideration of aesthetic factors. The Examining Division, as you partially affirmed, also reached its decision "'[b]ecause there are no artistic or sculptural elements or features in these works, either alone *or in combination,' upon which a copyright registration is possible....*" Letter from Giroux of 3/28/2003 at 5. (Emphasis added.)

With respect to the diamond earrings, 2119E, the fact that the size and number of diamonds varies along the long edges and in the crossbars does not make the design copyrightable. The fact remains that the design involves a rather simple arrangement of very few basic geometric shapes. As stated above, the basic design is an elongated loop, with crossbars, and, the addition of larger sized diamonds on alternate crossbars does not constitute registrable pictorial or sculptural authorship. These are minor variations. Because, considering all the elements in this work together, the overall effect of this design does not meet the threshold of registrability, we conclude that Attorney Giroux properly denied copyright registration for Design 2119E.

A similar analysis applies to the Briolette Dangling Earring, 2114E. As described above, this linear design consists of a gem post from which is suspended a single vertical string of small gems, with three successive open diamond shapes concluding with a teardrop-shaped pendant. The additional gems, interspersed along the line at each interval between triangles, as well, constitute a minor spatial variation. Basically this is a design of a very small number of standard shapes, a circular post, three open diamond shapes, and a teardrop shape to which nothing overall is added by the vertical line of gems connecting them.

With respect to the two Pairs of Rose Cut Diamond Earrings, 2100E and 2099E, you argue that 2100E catches the light in a manner that "creates an impression of whirling movement." Letter from Max of 6/25/2003 at 5. The impression on the viewer is not a criterion for determining copyrightability. *Compendium II,* Section 503.02(b), Example 3 (Registration cannot be made on the basis of the overall effect produced by the play of light); *Id.,* Section 503.01 (registration not dependent on aesthetic merit.) As the Board views these earrings, these two designs consist simply of concentric rings, one elliptical, the other round, with a bar bisecting the rings that begins and ends on the outside of the rings. On the whole, three concentric circles, either round or slightly arched, bisected by a straight line, even where the line begins and ends with a larger gem on the outsides of the outermost circle are lacking in creativity and could fairly be compared to a standard bull's-eye symbol with a line drawn through it, to the relatively few slanted arrows and cursive script composing the work at issue in the *John Muller* case, or to the striped cloth over which is superimposed a grid of squares in the *Jon Woods* case. *John Muller & Co. v. N.Y. Arrows Soccer Team, Inc.,* 802 F.2d 989 (8th Cir. 1986)(upholding the Register of Copyright's refusal to register team logo consisting of four angled lines forming an arrow with the word "Arrows" in script below); *Jon Woods Fashions Inc. v. Curran,* 8 U.S.P.Q.2d 1870(S.D.N.Y. 1988)(upholding Register's refusal of fabric design of 3/16" grid over 2 inch stripes).

The two Spider Bracelets, 2032BS and 2001BS, each consist of a few basic shapes. One is a simple latticework within a slightly bowed rectangle oriented squarely with the edges of the rectangle; the other is a simple latticework with a rectangle oriented at an angle to the edges of the rectangle. Following from the angled crisscross pattern, the angled latticework has a triangle at one end of each column. These works are essentially formulaic in their composition, except for the use

of brown diamonds in 2032BS. A difference in color, however, is not a copyrightable difference in itself. *Compendium II*, section 503.02(a).

Similarly, the Organdie Necklace, 2078N, consists of a lattice structure. Here too, the designs are no more than a simple arrangement of common geometric shapes: several rows of gems alternating between one plain strand and two scalloped strands, joined vertically at each scallop. This pattern continues until the last row, where one more scalloped row is added.

And, finally, the Necklace of White Rose Cut Diamond, 2111N. The composition of this necklace is derived directly from the Dangling Diamond Earrings 2119E and is merely a juxtaposition of the vertical, ladder-like loops, placed side by side. A repetition of two or three design elements does not provide the necessary combination of elements to sustain a claim in the overall jewelry piece.

In these designs, the selection and arrangement of material or the number of stones used to create a line does represent authorial choice, but overall, the authorship in each of the pieces of jewelry at issue here is too minimal to sustain registration. The few elements involved in these jewelry designs and the simple and, often, common arrangement of the constituent elements of the jewelry designs all argue for refusing registration. We point out that we recognize the principle stated in *Atari*, 979 F.2d at 245, that, given "a choice and ordering of elements that, in themselves, may not qualify for copyright protection, the author's *selection and arrangement*, however, may 'entail [the] minimal degree of creativity' needed to bring the work within the protection of the copyright laws." *Id.* (quoting *Feist*, 400 U.S. at 348). We do not, however, consider the particular way--a way that is essentially commonplace and lacking in any distinguishing sculptural or design variation from the simple and routine--in which the few elements chosen for the jewelry designs in question to be sufficiently original to sustain registration.

D. Other precedent on the standard of creativity

You cite the examples of *Herbert Rosenthal Jewelry Corp. v. Grossbardt, Trifari, Krussman & Fishel*, and *Behnam Jewelry Corp. v. Aron Basha Corp.* as support for your position that the jewelry designs you submitted possess the creative expression necessary for copyright registration. However, as courts applying the copyright requirement of creativity must look to the authorship specifics--the content of the particular works before them--to make their decision, it is easy to discern how the courts in those cases determined that the content of a detailed jeweled bee pin, half beads surrounded by graduated gold rim folding around and over parts of the cab, and a collection of baby shoe pendants, with detailed buckles and bows, all represented substantial authorship.

You state that the Examining Division, in discussing *OddzOn Products Inc v. Oman*, 924 F.2d 346 (D.C.Cir. 1991), errs in stating the principle of that case. You quote the Examining Division response:

> The Court held that the Register did not abuse his discretion in refusing a "Koosh" ball because it constituted a sphere which was a familiar shape not subject to copyright protection. It was not merely that the "Koosh" ball approximated a sphere, but also that there was not enough additional creative material beyond the object and shape to warrant a copyright registration. We believe that this principle applies in this case.

Letter from Giroux of 3/28/2003 at 4. From this statement you conclude that "The Copyright Office Response's recitation of the law and facts of this case and its application of the standard to the Jewelry Designs is in error." Letter from Max of 6/25/2003 at 4. You note that "[t]he *OddzOn* court explicitly 'emphasize[d] that we decide simply and only that the refusal of the Copyright Office...does not constitute an abuse of discretion. We do not decide on the copyrightability of the item, and we intimate no opinion on the decision we would reach if the matter came before us in an infringement action.'" 924 F. 2d at 350. After acknowledging the holding on abuse of discretion grounds in *OddzOn,* the Examining Division made its own statement of principle: a work submitted for registration that is a sphere must contain creative expression beyond public domain shape in order to warrant copyright registration. You are correct in noting that the *OddzOn* court expressed no opinion on the presence or absence of the necessary creative content beyond the sphere before it because the court did not see that determination as its task. *Id.* The Examining Division's statement about the Office's determination of the extent of creative expression present in the *OddzOn* work was, we agree, tied too closely to the correct statement that the court in *OddzOn* decided only that the Office's refusal to register the work at issue in that case was not an abuse of discretion.

Further, we agree that the question before the Office is not one of comparing the content of works, but that of whether the overall content of these jewelry designs meets the low standard of creativity. Letter from Max of 6/25/2003 at 7 - 8. We again take this opportunity to point out that the Office's examining practices incorporate the principle that the use of public domain elements, of commonly known or geometric shapes, and of familiar symbols, may result in a copyrightable work as long as the overall resulting design, taken in its entirety, constitutes more than a trivial variation of the constitutive elements.[2]

---

[2] That general principle is reflected in *Compendium II*, section 503.02, in its examples of protectible authorship: an "assemblage of diverse fragments forming a collage," "the arrangement and juxtaposition of pieces of colored stone in a mosaic portrait," the "carving, cutting, molding, casting, shaping or otherwise processing the material into a three-dimensional work of sculpture." All of these examples point to the use of individual and perhaps non-

(continued...)

We comment specifically regarding *Atari,* above, *at 13,* that, although the Office had initially refused to register the work in question, it did, upon reconsideration, register the video game at issue in recognition of the overall audiovisual authorship, composed of several individual elements--a series of related images with sound--which, taken together, were sufficient. *Atari* did not set forth a per se rule that any selection and arrangement of shapes or symbols would be sufficiently creative. In the jewelry designs at issue here, the selection and arrangement of simple geometric figures or a minor variation on those figures and shapes do not, in the opinion of the Board, represent authorship which creates a combination of individual (uncopyrightable) elements that as a whole is registrable. Further, the Board has determined that the placing together of a varying number of gemstones in a few shapes is not more than a trivial variation on the commonplace use of gemstones. Thus, these contributions, aesthetically meritorious as they may be, are simply insufficient in their entirety to merit registration.

We also take this opportunity to address several cases you cited in your request for reconsideration. The jewelry works at issue in *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101 (2d Cir. 2001), consisted of "silver, gold, cable twist, and cabochon cut colored stones." 262 F.3d at 109. In that case, the court found that the jewelry designs in question were copyrightable because of the "ways Yurman has recast and arranged those constituent elements." *Id.* at 110. The Board does not find such original recasting and arrangement, sufficient under *Feist,* to sustain registration for the jewelry designs at issue in this case. Instead, the designs essentially are minor variations on commonplace and simple jewelry configurations.

To be sure, we agree that an original combination of elements, each of which individually is unoriginal, i.e., uncopyrightable, may meet the creativity threshold if that combination meets the minimal standards of creativity, but the eight jewelry designs at issue here do not represent such a case. Again, *Compendium II,* 503.02(a), 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 is not copyrightable. Similarly, section 503.02(b) states that the mere bringing together of two or three standard forms or shapes with minor linear or spatial variations is not copyrightable. Though a work must be reviewed in its entirety (rather than judging its individual elements separately), when a combination of individual elements taken as a whole lacks sufficient creative expression, copyright registration may be denied. *Feist,* at 362; *Homer Laughlin China Co. v. Oman,* 22 U.S.P.Q.2d 1074, 1076 (D.D.C. 1991) upholding refusal to register chinaware design pattern of simple

---

[2](...continued)
copyrightable elements brought together to form an overall work of authorship that is copyrightable. We also cite the example of *Knitwaves, Inc. v. Lollytogs, Ltd.,* 71 F.3d 996 (2d Cir. 1996). The court there, although considering the appropriate infringement test for a design on clothing, articulated a copyrightability analysis in terms of the overall pattern that was infringed in that case, pointing out that "what is protectable then is 'the author's original contributions' – the original way in which the author has 'selected, coordinated and arranged' the elements of his or her work." 71 F.3d at 1004 (citing *Feist,* 499 U.S. at 350, 358). *See also Atari,* 979 F.2d 242.

variations, combinations of geometric designs and responding to plaintiff's contention that the Office failed to view the pattern in its entirety).

You also refer to a case involving designs similar to the work of Piet Mondrian. There the question before the court was one of independent creation, not creativity. In *North Coast Industries v. Jason Maxwell, Inc.*, 972 F.2d 1031 (9th Cir. 1992), the plaintiff had produced a design for a pullover top that was similar to Mondrian's use of primary colors, white and black, and rectilinear forms. The "Mondrian look" in fashion began with designs by Yves St. Laurent and the plaintiff had studied those designs. The plaintiff's works were copyrighted and the defendant was trying to prove that the plaintiff merely copied the work of Mondrian and Yves St. Laurent. *Id.* at 1034. The court's decision to remand the case for trial was influenced by an art history book discussing the work of Mondrian, noting that his "exquisite sense of nonsymmetrical balance is so specific that critics well acquainted with his work have no difficulty in distinguishing fakes from genuine pictures." *Id.* at 1035, n. 1 (citation omitted). The case did not involve the question of whether the Copyright Office found sufficient creativity in the design. Rather, the question was whether the plaintiff's work was independently created and whether the plaintiff's work exhibited sufficient difference from what might have previously existed so as to be copyrightable. The court focused on whether the plaintiff's work 'owed its origin' to the 'author' citing *Bell v. Catalda,* 101 F.2d at 102-03, or whether it was copied from another work. 972 F.2d at 1033. It remanded the question of creativity to the jury to determine whether the differences between Mondrian's pre-existing works and the plaintiff's work were "nontrivial." 972 F.2d at 1035. The Board does not see the *North Coast* case as helpful to your client.

Many of the other cases you have cited involve infringement claims on already registered works. Those cases *presume* that the plaintiff holds a valid copyright and shift the burden of proving that the work is not copyrightable to the defendant. *See, e.g., Tennessee Fabricating Co. v. Moultrie Mfg. Co.,* 421 F.2d 279 (5th Cir. 1970); *Prince Group, Inc. v. MTS Prods.,* 967 F.Supp. 121 (S.D.N.Y. 1997); *PPS, Inc. v. Jewelry Sales Representatives, Inc.,* 392 F.Supp. 375 (S.D.N.Y. 1975).

In *DBC of New York, Inc. v. Merit Diamond Corp.,* 768 F.Supp. 414 (S.D.N.Y. 1991) the plaintiff brought an infringement action on a work the Register had twice refused to register. The trial court dismissed the complaint. The court noted that it had the discretion to decide, independently of the Copyright Office, whether a work is copyrightable. *Id.* at 416. The jewelry designs in DBC were for ladies' diamond rings with marquise stones and triangular-cut stones. The court stated:

> Familiar symbols or designs are not entitled to copyright protection. Insofar as a shape is in the public domain, (circles, squares, rectangles and ellipses) no copyright may be claimed whether or not it is integrated into a utilitarian article. The individual

> elements of DBC's designs, such as the marquise stones, the trillions and the knife-edged shank, are each separately well-known in the jewelry trade before DBC's creation of the rings at bar. Furthermore, *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.

Id. at 416-17 (emphasis added). You state that this decision is flawed because it emphasizes the absence of "unique" qualities in the ring. However, as you have certainly used this term among others to describe your client's works, courts may do so to describe works before them as well. Importantly, however, in its discussion, the court applied the law regarding originality and other basic tenets of copyright law to the case at hand. ("Familiar symbols or designs are not entitled to copyright protection." "Although the rings are attractive, there is no indication that they are *original*." *Id.* (emphasis added).

Conclusion

Feist confirms that it is possible for the selection and combination of elements in a work to be copyrightable even when the individual elements, standing alone, would not be. 499 U.S. 363. The Review Board has reviewed the jewelry designs at issue here in their entirety and did not confine its review to examination of the works' individual elements as they exist separately. It is the Board's determination that the overall sculptural and artistic features of the jewelry designs at issue in this case do not represent more than a *de minimis* quantum of creativity, and thus, cannot be registered.

For the reasons stated above, the Copyright Office affirms the Examining Division's refusal to register the jewelry designs. This decision constitutes final agency action.

Sincerely,

/s/

Nanette Petruzzelli
Special Legal Advisor for Reengineering
For the Review Board
United States Copyright Office