COPYRIGHT
OFFICE

September 25, 1998

Re: Acrylic Decoration in the Form of a Diamond Icicle
Copyright Office Control Number: 60-503-5265(B)

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CONGRESS

Dear Mr. Slattery:

The Copyright Office Board of Appeals has reviewed your second appeal for registration of the ACRYLIC DECORATION IN THE FORM OF A DIAMOND ICICLE ("ICICLE"). After careful review of the application, deposit, and related correspondence, the Board concluded that the work cannot be registered because it lacks sufficient original authorship for registration.

Washington
D.C.
20559

Original Submission

On December 12, 1995, the Copyright Office received an application, deposit, and registration fee for the work ACRYLIC DECORATION IN THE FORM OF A DIAMOND ICICLE. The claimant, Luen Yau Plastic (China) Company Limited, was represented by your firm.

In a letter dated March 28, 1996, Examiner James L. Shapleigh notified you that the works could not be registered for lack of artistic or sculptural authorship necessary to support a copyright claim. He also noted that copyright law does not protect familiar symbols or designs, minor variations in colors or basic geometric shapes.

First Appeal

You responded in a letter to Mr. Shapleigh dated May 24, 1996, requesting that the Office reconsider its decision not to register the work. You noted that ICICLE was an original work fixed in a tangible medium of expression, and that the work was a nonfunctional sculptural work which should be registered. You also asserted that ICICLE was copyrightable under 17 U.S.C. § 102(a)(5) (pictorial, graphic and sculptural works are copyrightable subject matter), and claimed that the work fell within the definition of "pictorial, graphic, and sculptural works" as set forth in 17 U.S.C. § 101.

You added that the work was not matter that was excluded from registration under 37 C.F.R. § 202.1, adding that copyrightable authorship could be found in the "unique copyright subject matter," which was the "ornamentation on the surface of the article which is a work of original authorship in the form of a nonfunctional sculpture." First appeal letter at 2. You also asserted that this authorship met the minimal level necessary under the law to qualify ICICLE for copyright protection.

Second Rejection

In a letter dated October 17, 1996, Attorney Advisor David Levy responded to your request for reconsideration. He wrote that after reconsideration of the ICICLE work, the Office again determined that the work could not be registered.

He explained that "uniqueness" is not a copyrightable quality. Also, although a work is original, it must "contain a certain amount of creative authorship" to be registered. Second rejection letter at 1. Mr. Levy observed that the work consists "entirely of standard, geometric diamond shapes in a gradually tapering `icicle' shaped design," and noted that public domain shapes such as diamonds and icicles cannot be registered, according to 37 C.F.R. § 202.1. Under the same rule, the gold border on the top of the work could not be registered. None of the elements of the design, alone or in combination, constituted copyrightable authorship.

Mr. Levy cited as support Forstmann Woolen Co. v. J.W. Mays, Inc., 89 F.Supp. 964 (E.D.N.Y. 1950) (label containing the words "Forstmann 100% Virgin Wool" interwoven with three fleurs de lis held not copyrightable), and John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986).

He agreed that the work was a nonfunctional sculptural work, but repeated that there was not sufficient copyrightable sculptural authorship embodied in the work for registration.

Second Appeal

In an April 11, 1997 letter to Mr. Levy styled "Request for Reconsideration," you briefly summarized the points made in your first appeal. The Office has treated this request as a second appeal.

The Appeals Board's Decision

Decorative objects such as ICICLE are eligible for copyright protection as a sculptural work if they embody copyrightable expression. See 17 U.S.C. §102(a). However, such designs must possess a minimum degree of creativity to secure copyright protection. Not all such designs meet this standard. *See* DBC of New York, Inc. v Merit Diamond Corp., 768 F.Supp. 414 (S.D.N.Y. 1991).

There is no copyrightable authorship in the conical, or gradually tapering icicle, shape of this item. Familiar symbols and designs are not copyrightable. 37 CFR § 202.1; Compendium of Copyright Office Practices, Compendium II, § 202.02(j) (1984). This principle 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. In 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), the court upheld the 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." *See also* 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"). The Board can detect no originality in the shape of ICICLE..

Nor can the Board recognize any original authorship in the ornamentation on the surface of ICICLE. The ornamentation consists of standard, geometric diamond shapes in a regular pattern on the surface of a gradually tapering icicle-shaped design, Such diamond shapes are uncopyrightable familiar shapes, and the pattern in which they are placed on the surface does not exhibit even the modicum or *de minimis* quantum of creativity that is required to support a copyright. See Feist Publications, Inc. v. Rural Telephone Service Co., Inc., 499 U.S. 340, 362, 363 (1991). With respect to pictorial, graphic & sculptural works, the class within which ICICLE would fall, the Compendium of Copyright Office Practices, Compendium II, states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." Compendium II, §503.02(a)(1984). The Compendium recognizes that it is not aesthetic merit, but the presence of creative expression that is determinative of copyrightability, *id.*, and that "registration 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. ... 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." *Id.*

Although the ornamentation applied to the surface of this work may be unique, uniqueness is not a copyrightable quality. The Board can find no elements in the work that embody more than a "merely trivial" variation of familiar shapes sufficient to meet the admittedly low threshold of original authorship. See Chamberlin v. Uris Sales Corp., 150 F.2d 512, 513 (2d Cir. 1945). See also L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 490 (2d Cir.) (en banc), cert. denied, 429 U.S. 857 (1976), citing Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951). This requisite authorship is lacking in the ICICLE work.

For the reasons stated above, no registration can be made for this work. This letter constitutes final agency action.

Sincerely,

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

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