The Register of Copyrights
of the
United States of America

Library of Congress
Department 17
Washington, D.C. 20540

September 1, 1998

(202) 707-8350

RE: "WATCH AND BRACELET DESIGN"
Copyright Office Control Number: 60-608-4721(S)

Dear Mr. Steffin:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letters dated June 26, 1998 and August 7, 1998 on behalf of your client, Severin Montres AG, appealing a decision to cancel, due to lack of copyrightable authorship, the registration made for the work WATCH AND BRACELET DESIGN, registration # VA 804-758.

After carefully reviewing the work in question, your letter (with enclosures) of June 26, 1998, the papers and correspondence in the files of the Examining Division and the August 6 ruling of the United States District Court for the Central District of California in Gucci Timepieces of America, Inc. v. Yidah Watch Co., No. CV 97-6985 KMW, which your office forwarded to the Board on August 7, the Appeals Board affirms the Examining Division's decision.

Administrative Record

The Copyright Office received an application for registration of this work, a watch and bracelet design, on July 2, 1997. The authorship was described as "jewelry design." The examiner assigned to the case made the decision to register the claim without correspondence with the applicant. Registration VA 804-758 was issued.

Upon review of the work in question, supervisory examiners within the Examining Division determined that the watch did not contain sufficient copyrightable authorship to sustain the registration: the only separable feature of the watch was determined to be the block-type letter "G" formation surrounding the watch face. The Examining Division concluded that this block formation of the letter "G" falls within the category of "mere variations of lettering," one of the elements listed as uncopyrightable in Copyright Office regulations [37 C.F.R. 202.1 (1997)].

In a letter from Nancy Lawrence, Head of the Visual Arts Section, the Examining Division wrote to Severin Montres on January 7, 1998, stating that the Examining Division had determined that the registration should not have been made because the work did not contain copyrightable authorship. The letter concluded that as a useful article, the watch did not have any separable authorship that would constitute a copyrightable work of art. It observed that the only potentially separable aspect of the work is the shape of the watch face frame forming a block letter "G," and that lettering, including simple block letters, is in the public domain and not subject to copyright protection. The letter stated that the Office intended to cancel the registration but that pursuant to 37 C.F.R. 201.7, Severin Montres would have the opportunity to show cause in writing, within 30 days, why the Office should not cancel the registration. The letter stated that the Office would cancel the registration if no response was heard within that time period if the Office determined, taking into consideration the response of Severin Montres, that there was still no basis for registration.

Attorney Arnold Sklar of your office responded by a letter dated February 5, in which he argued in favor of copyrightability of the watch and bracelet design. Mr. Sklar advised the Office that the United States District Court for the Central District of California, in the above-referenced Gucci Timepieces litigation, had granted a preliminary injunction against infringement of the copyright in the watch, finding at the preliminary injunction stage that the copyright in the watch was valid. He provided the Examining Division with a copy of the memorandum of decision entered December 2, 1997 that had granted the preliminary injunction. Mr. Sklar asserted that the "G"-shaped feature of the watch was an artistic, sculptural element and (quoting the District Court) that the bracelet and clasp portion of the watch gave the watch its "unique appearance."

By letter dated February 27, 1998, the Chief of the Examining Division advised Mr. Sklar that the Office would proceed with the cancellation of the registration. The letter first addressed the issue of separability, concurring with Mr. Sklar that the "G" shape surrounding the face of the watch is conceptually separable from the functional aspects of the watch. However, the letter rejected Mr. Sklar's contention that the bracelet and clasp of the watch were physically or conceptually separable from its useful article aspects. Turning to copyrightability, the Chief of the Examining Division's letter concluded that the "G" design element did not meet the admittedly low standard of originality and creativity required for a work of authorship to be copyrightable. The letter observed that the "G" shape surrounding the squared watch frame is formed in a block manner, with no sculptural variations except rounded corners on the "G," and that there are no surface variations or artwork. As a mere variation of lettering with no discernable sculptural lines, configurations, or surface ornamentation apart from a simple, flat-surfaced, block formation of the letter, the "G" element was not copyrightable.

The February 27 letter from the Examining Division stated that although there is no provision for an appeal of a decision on cancellation, the Board of Appeals would consider an appeal if Severin Montres wished to seek an appeal. In a letter dated June 26, 1998, you presented Severin Montres' appeal to the Board. You advised the Board that a motion for reconsideration of the preliminary injunction in the Gucci Timepieces case was pending and that the District Court's tentative ruling was to continue in effect the preliminary injunction that was based on the watch's copyright. You also submitted an actual watch for the Board's review. [Consistent with Copyright Office regulations, the original deposit had consisted of a photograph of the watch.]

On August 7, 1998, you wrote to advise the Board that on August 6, the District Court had denied the motion for reconsideration and had found that the watch does contain copyrightable subject matter. You provided a copy of the Court's August 6 order.

The Rulings in *Gucci Timepieces of America, Inc. v. Yidah Watch Co.*

You have brought to the Board's attention the rulings in Gucci Timepieces of America, Inc. v. Yidah Watch Co. (originally Severin Montres, Ltd. v. Yidah Watch Co.), including the original memorandum of decision granting Severin Montres' motion for a preliminary injunction and the Court's recent Order denying the motion for reconsideration. Although not required to accept the views of a District Court ruling on a preliminary injunction motion, the Appeals Board does not lightly reject such views, especially when the Court has considered the Examining Division's rejection of the registration and nevertheless has concluded that the work is copyrightable. However, the Copyright Office must exercise its own judgment and rely on its own expertise in determining whether to register a work. In this case, the Board cannot agree with the reasoning of the District Court.

It appears that the District Court reviewed the January 7, 1998 letter from the Head of the Visual Arts Section. It is this letter that is quoted at page 2 of the District Court's order denying reconsideration. It is unclear whether the District Court reviewed the lengthier February 27 letter from the Chief of the Examining Division. The District Court stated, at page 3 of its order denying reconsideration, that "originality was not a basis for cancellation of the registration." Although the Examining Division's initial January 7 letter discussed originality only in passing and did not use the term "originality," the February 27 letter extensively discussed that issue in the section entitled "Copyrightability." After discussing the requirement of originality and the teachings of Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991), the letter analyzed the one element of Severin Montres' watch design that is separable from its utilitarian function — the "G" element that has been emphasized by Severin Montres and the District Court — and concluded that it was not sufficiently original to be copyrightable. The District Court's decision denying reconsideration does not appear to have expressly considered this aspect of the Examining Division's analysis and conclusions.

For the reasons stated below, the Appeals Board must respectfully disagree with the District Court and conclude, with the Examining Division, that there are no copyrightable elements in the watch design that can justify registration.

Separability

Determination of copyrightability of a useful article such as a watch almost always involves at least two steps: (1) a determination of whether there are any elements that may be "physically or conceptually ... identified as separable from the utilitarian aspects of the article," H.R. Rep. No. 1476, 94th Cong., 2d Sess. at 55 (1976), and, if there are, (2) whether those elements are sufficiently original to constitute copyrightable works of authorship.

The Appeals Board agrees with Examining Division and the District Court that there is one element of the watch design that is separable from the utilitarian aspects of the watch: the "G" design that is superimposed on the watch face. As your appeal letter states, "[s]eparability is therefore not an issue."[1]

Originality and De Minimis Authorship

The dispositive issue before the Board is whether the separable element of the watch — *i.e.*, the "G" design on the watch face — satisfies the requirement of originality that is the touchstone of copyrightability. Feist Publications, 499 U.S. at 347. In Feist Publications, the Supreme Court explained that "Original, as the term is used in copyright, means only that the work was independently created by the author ... and that it possesses at least some minimal degree of creativity." 499 U.S. at 345. Severin Montres' argument that originality "means only that the work owes its origin to its author" focuses solely on the first aspect of originality and ignores the requirement of creativity. Although the District Court in the Gucci Timepieces case quoted this passage from Feist, the Court's analysis of the originality of the watch design focused primarily on Severin Montres' independent creation of the watch and did not explicitly address whether any "creativity" was present.

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[1] Your appeal letter does not appear to argue that the bracelet and clasp of the watch constitute separable elements of the watch that constitute copyrightable authorship, although you appear to have made that argument to the Examining Division. In any event, the Board sees no merit in the argument that the bracelet and clasp are separable from the utilitarian aspects of the watch. Both elements clearly perform useful functions: the bracelet holds the watch to the wrist and the clasp closes the bracelet. Therefore, the shapes of the bracelet and the clasp are not copyrightable.

In Feist Publications, the Court stated that although there is a low standard for determining the copyrightability of a work, some works fail to meet that low standard for copyrightability. The court observed that "[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity," 499 U.S. at 363, and that there can be no copyright in works in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359. The Court held that a "garden-variety white pages directory [was] devoid of even the slightest trace of creativity" and not copyrightable. *Id.* at 362.

Even prior to Feist Publications, Copyright Office registration practices recognized that works with only a *de minimis* amount of authorship are not copyrightable. See Compendium of Copyright Office Practices, Compendium II, § 202.02(a)(1984). With respect to pictorial, graphic and sculptural works, the class within which the watch design would fall, the Compendium 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.*

By the same token, it is not possible to obtain a copyright for a simple, unembellished, three-dimensional representation of a "garden-variety" block letter "G"; nor does the fact that such a representation is affixed to the face of a watch give rise to an original work of authorship.

Copyright Office regulations forbid registration of, *inter alia,* "familiar symbols or designs; mere variations of typographic ornamentation, [or] lettering." 37 C.F.R. § 202.1(a); *see also* § 202.1(e) ("Typeface as typeface"). These proscriptions all apply to the unadorned, standard letter G appearing on the face of the watch; the letter "G" — especially as a block letter as in this case — is a very familiar symbol or design as well as a typographic ornamentation and "lettering" (albeit in three-dimensional form). The fact that "G" is three dimensional is not indicative of authorship; in fact, the choices as to its "width, shape, features and radii" (see page 12 of your June 26, 1998 letter) are clearly limited by the shape and size of the watch face.

The Board finds support for this conclusion in other case law as well. In John Muller & Co. v. New York Arrows Soccer Team, Inc., 802 F.2d 989 (8th Cir. 1986), the court upheld a refusal to register a logo consisting of four angled lines forming an arrow, with the word "arrows" in cursive script below, noting that the design lacked the minimal creativity necessary to support a copyright and that a "work of art" or a "pictorial, graphic or sculptural work ... must embody

some creative authorship in its delineation of form". *See also* Bailie v. Fisher, 258 F.2d 425 (D.C. Cir. 1958) (cardboard star with two folding flaps allowing star to stand for display not copyrightable `work of art'); DBC of New York, Inc. v. Merit Diamond Corp., 768 F. Supp. 414, 416 (S.D.N.Y. 1991) (upholding refusal to register jewelry design and noting that "[f]amiliar symbols or designs are not entitled to copyright protection," citing 37 C.F.R. § 202.1); Magic Marketing, Inc. v. Mailing Services of Pittsburgh, Inc., 634 F. Supp. 769 (W.D. Pa. 1986) (envelopes with black lines and words "gift check" or "priority message" did not contain minimal degree of creativity necessary for copyright protection); Forstmann Woolen Co., v. J. W. Mays, Inc., 89 F. Supp. 964 (E.D.N.Y. 1950) (label with words "Forstmann 100 % Virgin Wool" interwoven with three fleurs de lis held not copyrightable); The Homer Laughlin China Co. v. Oman, 1991 Copyright Law Decisions (CCH) ¶ 26,772 (D.D.C. 1991) (upholding refusal to register chinaware design pattern composed of simple variations or combinations of geometric designs due to insufficient creative authorship to merit copyright protection); Jon Woods Fashions v. Curran, 8 U.S.P.Q.2d 1870 (S.D.N.Y. 1988)(upholding refusal to register fabric design consisting of striped cloth with small grid squares superimposed on the stripes where Register concluded design did not meet minimal level of creative authorship necessary for copyright); Tompkins Graphics, Inc. v. Zipatone, Inc., 1984 Copyright Law Decisions (CCH) ¶ 25,698 (E.D. Pa. 1983) (collection of various geometric shapes not copyrightable).

Of course, the design of a watch may, if it includes original expression, be copyrightable. *See* Direct Marketing of Virginia, Inc., v. E. Mishan & Sons, Inc., 753 F. Supp. 100 (S.D.N.Y. 1990). Although, as Severin Montres argues, a watch may be considered jewelry, not all jewelry designs contain sufficient creative expression to support a copyright. DBC of New York, Inc. v. Merit Diamond Corp., 768 F. Supp. 414 (S.D.N.Y. 1991). As the court stated in Direct Marketing:

> "It is axiomatic that copyright protection extends only to the expression of an idea but not to the idea itself. See *Reyher v. Children's Television Workshop*, 533 F.2d 87, 90 (2d Cir.), *cert. denied*, 429 U.S. 980, 50 L. Ed. 2d 588, 97 S. Ct. 492, 192 U.S.P.Q. (BNA) 64 (1976). The idea of designing a watch face to show a full-bodied cat which appears to "see" a mouse as the mouse circles the cat in the manner of a second hand is an unprotectible idea. However, plaintiff's expression of that idea -- using "America's favorite cat, the Tabby" in a sitting position facing to the left with a stylized rather than realistic rendering of a mouse -- is, in this Court's view, protectible expression."

753 F. Supp. at 104. See also 17 U.S.C. § 102(b). Similarly, the idea of superimposing the letter "G" on a watch face is an unprotectible idea. The Board can detect no additional authorship

beyond Severin Montres' choice to use a very standard form of the letter "G," in block form with slightly rounded corners.

The Appeals Board finds the decision in Adobe Systems Inc. v. Southern Software, Inc., 1998 U.S. Dist. Lexis 1941 (N.D. Cal. 1998), unhelpful to a resolution of this appeal. Adobe involved a claim of software copyright infringement. The fact that the software in question generated scalable fonts does not mean that the case offers any guidance on how to judge copyrightability of a single letter superimposed on a watch face. The court did not recognize any copyright in individual letters produced by the software or in the fonts themselves, but only in the software programs that produced the fonts.

Conclusion

For the reasons stated above, the Board of Appeals affirms the cancellation of registration # VA 804-758. Because your registration has been cancelled, we ask that you destroy the certificate.

This letter constitutes final agency action.

In light of the pending litigation involving this registration and in light of the request by Marvin H. Kleinberg, Esq., counsel for Yidah Watch Company in that litigation, a copy of this letter is being sent to Mr. Kleinberg.

Sincerely,

Marybeth Peters

Marybeth Peters
Register of Copyrights

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cc: Marvin H. Kleinberg, Esq.

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September 1, 1998