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September 29, 2000

Russell E. Levine
Alexandra N. DeNeve
Kirkland & Ellis
200 East Randolph Drive
Chicago, IL 60601

Re: Control Numbers: 60-616-6269(W)
60-617-6921(W)
60-617-9974(W)
60-618-4668(W)

Dear Mr. Levine and Ms. DeNeve:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated July 7, 1999, appealing a refusal to register twenty designs for a watch face.

The Board has examined the claims and considered all correspondence from your firm concerning these applications. After carefully reviewing the claims, the Board affirms the Examining Division's decision to refuse registration because the designs lack the modicum of creativity needed to support a copyright.

Administrative Record

On April 9, 1998, Wallenstein & Wagner, Ltd., on behalf of its client, Hampden Corp., submitted 20 applications for registration. These submissions were distributed among four different examiners for their review of the materials. In each case, the examiner determined that the works lacked the artistic or sculptural authorship necessary to support a copyright, and all twenty claims were rejected.

In a letter dated November 24, 1998, Mr. Stein, an attorney with Wallenstein & Wagner, Ltd., filed an appeal with the Office, seeking reconsideration of the examiner's decision to deny registration to all twenty designs. In his letter, he argued that the Office's characterization of the works as mere ideas and concepts, and therefore not proper subject matter to support a copyright, was erroneous. Particularly, he rejected the analogy drawn between a book design layout and the works under consideration. He asserted that the Office's policy for rejecting book design layouts — namely, an author entitled to copyright for a literary

work need not seek additional protection in the design — is misapplied to the watch faces, because they are not literary works. Instead, they are works of art which are original "by virtue of the creative arrangement and selection of elements within each timepiece face."

On April 14, 1999, Melissa Dadant, Special Assistant to the Chief of the Examining Division, responded to the first request for reconsideration. Based on her independent review of the application and the submitted materials, she upheld the denials of registration because the designs were nothing more than standard arrangements or minor variations of standard arrangements. She determined that the positioning of the word "Name" at various points within the circular or rectangular shapes used to represent the watch face lacked the modicum of originality needed to support a copyright.

On July 8, 1999, you wrote to the Office seeking a second appeal of the determination not to register the twenty watch face designs. In this letter, you make three points. First, you assert that "Hampden seeks to register [] a two-dimensional graphical arrangement of a mother's name above her children's names," the design of which has been chosen "for a particular, ornamental purpose." Next, you argue that the "Mother's Watch face is sufficiently original to register the design" under the standard articulated in Feist Publications Inc. v. Rural Tel Serv. Co., 499 U.S. 340, 346 (1991). Then you conclude with a discussion of conceptual separability, arguing that "Hampden's Mother's Watch design is an original design that is conceptually separable from the watch itself; [and] thus, the design is copyrightable."

The Board has carefully considered the twenty designs and the arguments made for registering these works. However, the Board has determined that for the reasons cited herein, the designs are standard arrangements which lack sufficient creativity to support a copyright.

Conceptual Separability

The doctrine of conceptual separability applies only to a "useful article." Section 101 of title 17 defines a "useful article" as one "having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." Examples of useful articles include automobiles, boats, household appliances, furniture, work tools, and of course, watches.

The 2-dimensional graphic representations submitted for registration are clearly not "useful articles," and as such, consideration of the doctrine of conceptual separability is inapposite. Had the works submitted for registration been actual watches incorporating the submitted designs, then of course, the first step in the analysis would have been to determine whether the design elements were conceptually separable from the useful article. See,

Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 994 (2d Cir. 1980) (considering copyrightability of 3-dimensional designs of a belt buckle).

De minimis authorship

Every copyrightable work must contain at least a modicum of creativity. Feist Publications Inc. v. Rural Tel Serv. Co., 499 U.S. 340, 346 (1991). Unfortunately, the twenty graphic designs for the Mother's Watch face fall short of that admittedly modest required level of creativity.

The submitted graphic designs consist of a simple geometric figure, either a circle or a rectangular shape. Inside the large geometric shape are two additional elements: a small circular geometric shape and the word "Name" in two or more positions to indicate where the name of the Mother or the name of a child(ren) will be placed on the face of a watch. However, common geometric figures or shapes are not copyrightable, even when the design brings together two or three standard forms or shapes with minor linear or spatial variations. See U.S. Copyright Office, Compendium of Copyright Office Practices, Compendium II, § 503.02(a) (1984); see also section 202.1(a) of the Copyright Office regulations, 37 C.F.R. § 202.1(a) ("familiar symbols or designs" are "not subject to copyright and applications for registration of such works cannot be entertained"). Nor is it possible to copyright words and short phrases such as names and titles. 37 C.F.R. § 202.1(a)

Of course, some combinations of common or standard forms contain sufficient creativity to support a copyright. But in those instances, where the courts have examined this question, the courts have considered whether the layout and interplay of the common elements required the author to choose from a variety of potential options when creating the design. For example, in North Coast Indus. v. Jason Maxwell Inc., 972 F.2d 1031 (9th Cir. 1992), the court determined that a geometric design consisting of colored rectangular blocks banded in heavy lines may be copyrightable. The creativity in the design, however, lay in the interplay arising from the author's choice of color for the

rectangles, the size of the rectangles, and the size of the bands separating the rectangles, none of which was dictated by the design. Similarly, in Arica Institute, Inc. v. Palmer, 970 F.2d 1067 (2nd Cir. 1992), the court found that the attachment of labels to the various points of a nine-pointed star an original and creative way to express the relationship between the different personality types represented by each star point. Because there were a number of ways to express these relationships, the court found the use of the graphic design, together with the labels, to be a unique and creative way to convey this information.

But, "[w]here the author fails to such a degree to transcend the apparent limitations imposed by the subject and the preexisting materials, the author's work, like the

directory in Feist, falls within the 'narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.' M & D Intern. Corp. v. Chan, 901 F. Supp. 1502, 1516 (D. Hawaii 1995) (holding that crystal sculptures created from stock parts lacked degree of creativity necessary to merit copyright protection because the structural simplicity of the natural subject matter of the sculptures limited the selection and arrangement of the stock components), citing Feist, 499 U.S. at 357, 111 S.Ct. at 1294. See also, John Muller & Co. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986) (upholding Register's refusal to register a simple logo consisting of four angled lines which form an arrow and the word "Arrows" in cursive script below the arrow); Jon Woods Fashions, Inc. v. Curran, 8 U.S.P.Q. 2d 1870 (S.D.N.Y. 1988) (upholding Register's decision that fabric design consisting of striped cloth over which is superimposed a grid of 3/16" squares, even though "distinctly arranged or printed," did not contain a minimal amount of original artistic material to merit copyright protection); Homer Laughlin China Co. v. Oman, 22 U.S.P.Q. 2d 1074 (D.D.C. 1991) (upholding Register's determination that there was insufficient creative authorship in "Gothic" chinaware design pattern to merit copyright).

Such is the case with the submitted work. In contrast to the works considered in North Coast and Arica, the arrangement of the placeholder word, "Name," is standard. It uses the center top position as a focal point for the name of the Mother, then orders the remaining elements in a symmetrical pattern at the bottom of the outline in one of two patterns -- either in two columns with an equal number of elements, or alternatively, around the perimeter of the outline. In any case, the resulting arrangements of the elements are not unique. Consequently, the arrangement of elements fails to rise above the de minimis authorship needed to support registration of the work

Based on the Board affirms the Examining Divisions's decision to refuse to register this claim. This letter constitutes final agency action.

Sincerely,

David O. Carson
General Counsel

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