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March 22, 2000

Nancy E. Ownbey, Esq.
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P.O. Box 26927
Albuquerque, NM 87125-6927

Re: GRCF 921
Control No.: 60-610-7215(P)
Applicant: Kabana, Inc.

Dear Ms. Ownbey:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated June 16, 1999 on behalf of your client, Kabana, Inc., in which you sought reconsideration of the Copyright Office's refusal to register a work entitled "GRCF 921." The Copyright Office Board of Appeals affirms the Examining Division's refusal to register.

BACKGROUND

On February 27, 1998, a Form VA application was submitted to the Copyright Office to register Applicant Kabana, Inc.'s jewelry design for a ring, entitled "GRCF 921."

In a letter dated September 9, 1998 from Visual Arts Section Examiner James L. Shapleigh, the Examining Division refused to register GRCF 921 on the basis that it lacks sufficient artistic or sculptural authorship to support a claim of copyright. Registration was refused because copyright protection is not available for familiar symbols and designs, minor variations of basic geometric shapes or mere variations in coloring.

In a letter dated October 1, 1998, Applicant's attorney, Brian J. Pangrle, asked the Copyright Office to reconsider its refusal to register GRCF 921. Mr. Pangrle argued that the ring design is entitled to registration because it satisfies the minimal degree of creativity established in Feist Publications, Inc. v. Rural Tel. Service Co., 499 U.S. 340 (1991) and Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903). He asserted that the work contains an original and creative pattern formed by lines, shapes, curves and colors that "more than satisfies the *de minimus* creativity standard." He also contended that although the design is not very complex, it is not just a simple combination of geometric shapes. Mr. Pangrle stated:

> Because a work of graphic art uses as its basic structural components lines, slopes and curves arranged in various shapes and patterns, does not render the totality of the design and unity of the entire piece of art a "minor variation of basic geometric shapes." The author's original and creative combination and use of a pattern formed by lines, shapes, curves and colors more than satisfies the *de minimis* creativity standard. This is not mere geometric variation, rather it is an originally planned sculptural creation of pattern, spacing, depth and flow that is artistic as well as aesthetically pleasing.

Mr. Pangrle cited North Coast Industries v. Jason Maxwell, Inc., 972 F.2d 1031 (9th Cir. 1992) in support of the proposition that even mere geometric shapes when combined may be copyrightable.

Mr. Pangrle enclosed information about other similar works of opal inlay jewelry that have been registered by the Copyright Office. He argued that these works display a similar level of design, simplicity and artistic creativity as GRCF 921 and were not considered to be minor variations on basic geometric shapes.

In a letter dated March 17, 1999 from Attorney Advisor Virginia Giroux, the Examining Division again denied registration for Applicant's jewelry design on the basis that it lacks copyrightable authorship. The Copyright Office acknowledged that the standard of creativity is minimal as established in Feist and Bleistein. However, the jewelry design does not have a sufficient amount of original artistic or sculptural authorship necessary to support copyright registration. The letter of decision stated that:

> The design in question consists of a circular ring or band with a series of diamonds positioned vertically in the front. Each side of the ring, which is curved and elongated, contains a blue-green gold striped enamel portion shaped like a trapezoid and bordered in

> gold. Circles, stripes, curved lines, and trapezoids, as embodied in this work, are common or familiar shapes, in the public domain, and, therefore, not copyrightable as stated in Section 202.1 of the Copyright Office Regulations ... . Coloring is also not copyrightable as stated in the same regulation. Stones *per se*, such as diamonds, are also not copyrightable elements. Even the simple combination of and arrangement of the few elements embodied in this particular work, in our view, do not reflect sufficient artistic or sculptural to sustain a copyright claim.

The letter went on to explain that the work also does not satisfy the standard set forth in Atari Games Corp. v. Oman, 979 F.2d 242 (1992), that a work be viewed in its entirety with individual elements being considered in relation to the whole rather than being judged separately. The letter of denial stated that, "The elements embodied in this design, individually, and in their particular arrangement, do not contain sufficient original authorship to be copyrightable." Even taking into consideration the different textures or textured contrasts (*i.e.*, plain or contoured) within this work, it does not rise to the level of copyrightable authorship.

In response to Mr. Pangrle's reliance upon North Coast Industries v. Jason Maxwell, Inc., the, Ms. Giroux pointed out that the Ninth Circuit did not rule on the copyrightability of the simple design that was the subject of that infringement claim. Rather, the Court reversed the lower court's grant of summary judgment, ruling that the issue should have been decided by a jury. The letter stated that it is settled case law that simple variations of standard designs and their simple arrangements do not furnish a basis upon which to support a copyright claim, however aesthetically pleasing. *See* DBC of New York, Inc. v. Merit Diamond Corp., 768 F.Supp. 414 (S.D.N.Y. 1991); Jon Woods Fashions v. Curran, 8 USPQ2d 1870 (S.D.N.Y. 1988); John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986).

In a letter dated June 16, 1999, you submitted a second request for reconsideration. You pointed out that GRCF 921 is a derivative work, as was stated on the original application. GRCF 921 is based on an earlier work that was registered by the Copyright Office, in 1996. In support of that point you attached figure 2 to your letter. That work was registered as VA 823-873. You stated that GRCF 921 is a variation on the same elements that are contained in the underlying work and is equally copyrightable. You also alleged that other works very similar to GRCF 921 were registered by the Copyright Office which were found to have the requisite level of creativity. In support of that statement, you attached figures 2, 3 and 4 to your letter.

You stated that the jewelry design in GRCF 921 is entitled to registration because it possesses a greater than minimal degree of creativity. GRCF 921 maintains the overall appearance of the previously registered ring, while changing the weights, sizes and number of stones from the original design. The new work contains an artistic selection of smaller and

additional center stones. Also attached to your letter was an affidavit from the designer, in which he attests to the fact that he based GRCF 921 on the previously registered work.

You argued that to deny registration on the basis that the ring design is comprised of ordinary or common shapes is tantamount to denying registration to a book because all the words in it are familiar, thereby ignoring the overall expression contained in the particular combination of words. A design, otherwise original, may be registerable even though it incorporates uncopyrightable standard forms, such as circles and squares. Compendium of Copyright Office Practices, Compendium II, § 503 (1984).

DECISION

After reviewing the application and administrative record, the Board of Appeals has determined that GRCF 921 does not contain copyrightable authorship. This decision is not an evaluation of the quality or aesthetic value of the work. Rather, as you stated, originality for copyright purposes requires only a minimum level of creativity. Feist (only a modicum of creativity is necessary for copyrightable expression). Copyright Office examination procedures adhere to a long history of case law, beginning with Bleistein v. Donaldson Lithographing Co., which requires that copyrightability be based on a minimum level of creativity, not a subjective assessment about the artistic merits of the work. GRCF 921 does not satisfy the minimal level of creativity required by Feist or Bleistein.

GRCF 921 is a derivative work. Copyright law states that:

> The copyright in a compilation or derivative work extends only to the material contributed by the author of such works, as distinguished from the preexisting material employed in the work ... .

17 U.S.C. § 103(b). To be eligible for copyright, a derivative work must be an original work of authorship and must comply with the other provisions of law. Compendium of Copyright Office Practices, Compendium II, § 204.03 (1984). Consequently, the standard of originality for derivative works is the same as for any other work. Moreover, the statute defines a derivative work as "a work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship." 17 U.S.C. § 101 (definition of "derivative work"). In determining whether there is copyrightable authorship, the focus is not on what is original in the preexisting work, but on the original authorship, if any, that was added in the derivative work. See Matthew Bender & Co. v. West Publishing Co., 158 F.3d 674, 680 (2d Cir. 1998); Entertainment Research Group, Inc. v. Genesis Creative Group, Inc., 122 F.3d 1211, 1220 (9th Cir. 1997).

In its review of Applicant's claim, the Copyright Office Board of Appeals examined the application, as well as the deposit photographs for GRCF 921 and the original work upon which it is based, GRCF 886. At line 6(b), the application describes the new material that was added to GRCF 921. It states that the changes consist of "redesign and recombination of elements, including narrowing channel in solid band, increasing the number of diamond points and narrowing the side inlays."

In its examination, the Board noted that the changes included narrowing the channel in the solid band, adding one jewel to the center band and narrowing the side topaz inlays while increasing their number. The Board concluded that these few, minor variations do not contain the more than *de minimis* amount of authorship that is required for copyright protection. As the Court stated in Feist, "[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. Adding one stone to the center band, slightly changing the size of other components and adding one extra topaz inlay strip to each side are slight modifications on the basic shapes and patterns in the original work. Although the changes may result in an attractive design, they are minor and so obvious as to be trivial. The work as a whole is a trivial variation of basic geometric shapes.

Applicant's attorney at the first level of appeal, Mr. Brian J. Pangrle, cited North Coast Industries v. Jason Maxwell, Inc. for the proposition that even mere geometric shapes when combined may be copyrightable. However, the Board agrees with the Examining Division's reading of that case, in which the Ninth Circuit did not rule on the copyrightability of the simple design that was the subject of an infringement dispute. Rather, the court reversed a grant of summary judgment, ruling that the issue should have been decided by a jury. Moreover, in North Coast the plaintiff had obtained a certificate of registration of the copyright in the work, and the court observed that the "registration of the copyright certificate itself establishes a prima facie presumption of the validity of the copyright in a judicial proceeding." Therefore, the decision that there was a triable issue of fact is understandable in light of this Office's issuance of the certificate. Yet, the Board also agrees with Mr. Pangrle's statement that mere geometric shapes when combined may be copyrightable. The question is whether the particular combination of shapes is sufficiently original. However, the few minor changes in GRCF 921 are too trivial to satisfy the "more than *de minimis*" level of creativity that satisfies the Feist standard.

The courts have consistently held that simple variations on basic shapes or patterns are not copyrightable. *See* Jon Woods Fashions v. Curran, *supra* (upholding Copyright Office's refusal to register design consisting of striped cloth over which was superimposed a grid of 3/16" squares); John Muller & Co., Inc., v. New York Arrows Soccer Team, *supra* (logo consisting of four angled lines forming an arrow, with the word "arrows" in cursive script below, found not copyrightable); Magic Marketing v. Mailing Services of Pittsburgh, 634 F.Supp. 769 (W.D.Pa.

1986) (envelopes printed with solid black stripes and a few words such as 'priority message' or 'gift check' did not exhibit minimal level of creativity necessary for copyright registration); Forstmann Woolen Co. v. J. W. Mays, Inc., 89 F.Supp. 964 (E.D.N.Y. 1950) (reproduction of standard *fleur-de-lis* could not support a copyright claim without original authorship).

You have drawn the Board's attention to the Office's registration of copyrights in other items of jewelry, arguing that GRCF 921 is equally entitled to registration. As noted above, the fact that GRCF 921 is a derivative work narrows the scope of the claim to authorship. In any event, the Office does not compare designs in the course of examining works for registration. Homer Laughlin China v. Oman, 22 U.S.P.Q. 2d 1074 (D.D.C. 1991), citing Compendium II, §108.03. Each work submitted for registration is evaluated on its own merits, applying the principles stated above. The fact that an individual examiner might have — perhaps erroneously — accepted for registration a work that arguably is no more creative than the subject work does not require the registration of the latter work when the Board finds it wanting.

The Board is not in a position to provide you with the requested "confirmation that the prior registration VA 823-873 already covers" GRCF 921. It is up to the courts, and not the Copyright Office, to make such evaluations.

In conclusion, registration is denied because the authorship in GRCF 921 is *de minimis*. The derivative work is such a minor variation on the original, GRCF 886, that it lack the requisite level of creativity to be entitled to copyright protection.

For the reasons stated in this letter, the Copyright Office Board of Appeals affirms the refusal to register the claim. This decision constitutes final agency action on this matter.

Sincerely,

David O. Carson
General Counsel
for the Appeals Board
U.S. Copyright Office

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