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August 16, 2002

R. Bennett Ford
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RE: GEMSTONE SETTING
Control Number : 60-719-1840(R)

Dear Mr. Ford:

I am writing on behalf of the Copyright Office Board of Appeals in response to your correspondence dated October 31, 2001, on behalf of Applicant, Stuller Settings, Inc. You requested for a second time that the Copyright Office reconsider its refusal to register Applicant's work, entitled "Gemstone Setting," which is a prong setting for a gemstone on a ring. The Copyright Office Board of Appeals affirms the Examining Division's refusal to register.

ADMINISTRATIVE RECORD

On June 19, 2000, the Copyright Office received a Form VA application from Applicant, Stuller Settings, Inc., to register a prong setting for a gemstone on a ring, entitled "Gemstone Setting." In a letter dated December 20, 2000 from Visual Arts Section Examiner John M. Martin, the Examining Division refused to register Gemstone Setting. Registration was denied because the examiner determined that the work lacked the artistic or sculptural authorship necessary to support a copyright claim.

In correspondence dated April 18, 2001, you requested that the Copyright Office reconsider its refusal to register Gemstone Setting. Citing Atari Games Corp. v. Oman, 979 F.2d 242 (D.C. Cir. 1992) and Feist Publications, Inc. v. Rural Tel. Service Co., 499 U.S. 340 (1991), you stated that the level of creativity necessary for copyright is very low. You stated that Gemstone Setting satisfies the copyright requirement of independent creation, asserting that Applicant is seeking protection for its particular expression embodied in the work, not any idea associated with the work. You gave a detailed description of Gemstone Setting in which you described the work as a setting that "gracefully frames the gemstone without blocking it from view or from the light, creating a presentation for a diamond or other precious stone that is elegant and functional." [4/18/01 first appeal at 2,3] You also argued that the work is not a familiar design, stating:

> Nor does the applicant's work consist of minor variations of basic geometric shapes. The applicant's design consists of a complex

> Nor does the applicant's work consist of minor variations of basic geometric shapes. The applicant's design consists of a complex combination of surfaces which subtly interact to capture and reflect light, unobtrusively frame and support a gem stone, and simultaneously accentuate the cut and depth of the stone.
> [4/18/01 first appeal at 5]

In conclusion, you said that Gemstone Setting is sufficiently creative to qualify as a work of authorship and that the work is entirely original to the Applicant.

In a letter dated July 5, 2001 from Attorney Advisor Virginia Giroux, the Examining Division again refused to register Gemstone Settings because it does not contain sufficient original and creative sculptural authorship. Ms. Giroux stated that the standard of review for copyright registration is whether a work has sufficient creative as well as original expression. In accord with the principle stated in Feist, a very low level of original authorship will suffice. Feist at 345. This does not negate the fact that copyrightable authorship must consist of something more than a trivial variation of public domain elements. Id. at 359. Ms. Giroux stated that as a prong setting for a stone on a ring, Gemstone Setting is functional and, even if it were not functional but were purely decorative, Gemstone Setting does not exhibit sufficient original sculptural authorship to support registration. Ms. Giroux clarified that the Office uses as its standard of review the principles enunciated in 37 C.F.R. §202.1, the regulation stating that "familiar symbols or designs; mere variations of typographic ornamentation, lettering, and coloring are not copyrightable." Citing cases in support of this proposition, Ms. Giroux pointed out that while variations of standard shapes or designs may be aesthetically pleasing, they may also not provide sufficient authorship to be copyrightable.

Ms. Giroux also stated that the Copyright Office follows the registration principle that a work should be considered in its entirety and that copyrightability judgment for a given work should not be premised on a judgment of the individual elements comprising the work. Atari Games Corp. v. Oman, 979 F.2d 242 (D.C. Cir. 1992) She further explained that the impression created on a viewer of a work is not a valid consideration in determining copyrightability. Neither is the uniqueness of a work, unlike a requirement for patent protection. She said, "It is not the possibility of choices that determines copyrightability but whether the particular resulting expression contains copyrightable authorship."

In your second appeal dated October 31, 2001, you again requested that the Copyright Office reconsider its refusal to register Gemstone Setting. You argued that it is copyrightable because it is a component of jewelry which is a work of artistic craftsmanship. You argued that it is the form of Gemstone Setting that is copyrightable, not its mechanical or utilitarian aspect. You stated that the mechanical manner in which a setting holds a gemstone is not copyrightable, but its shape and appearance are. [10/31/01 second appeal at 2,3] You confirmed that Applicant is seeking protection only for the external appearance of the work.

You also argued again that Gemstone Setting satisfies the Feist level of creativity required for copyright protection which is very low. You again described the characteristics of Gemstone

Setting, concluding that work creates a whole that is greater than the sum of its parts and therefore meets the minimal standards of Feist and Atari [10/31/01 second appeal at 4,5]

On the basis that she did not compare Applicant's work to any other work, you disputed Ms. Giroux's statements that Gemstone Setting is not copyrightable because it lacks originality and creativity. [10/31/01 second appeal at 5,6] As evidence of Gemstone Setting's originality, you presented evidence that it has received a design patent. [10/31/01 second appeal at 6] You emphasized the unique nature of the work, stating that you knew of no other setting in which the V-shapes are depicted as they are in Gemstone Setting.

DECISION

After reviewing the application and arguments you presented, the Copyright Office Board of Appeals affirms the Examining Division's refusal to register Applicant's work, Gemstone Setting, because the work is a useful article, a prong setting for a gemstone on a ring, that does not have any physically or conceptually separable elements. The Board further concluded that even if Gemstone Setting were not considered a useful article, the work, nevertheless, exhibits *de minimis* authorship which does not form the basis for copyright registration.

Copyright Protection for Useful Articles

The Board has determined that the functional nature of a gemstone setting requires that Applicant's work be treated as a useful article under copyright law, regardless of its aesthetic merit. As defined by copyright law, a useful article has "an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. §101 (definition of "useful article").

In your April 18, 2001 first appeal, you explicitly stated "The work is a setting for gemstones, and especially diamonds. The setting has several distinct characteristics, deliberately selected to create a sublime presentation for gemstones." [4/18/01 first appeal at 2] You further described the work as a setting that "gracefully frames the gemstone without blocking it from view or from the light, creating a presentation for a diamond or other precious stone that is elegant and functional." [4/18/01 first appeal at 3]

We point out that gemstone settings traditionally serve the purpose of containing or positioning a gemstone within a piece of jewelry, most frequently within a ring. In general, a gemstone setting is comprised of strips or columns of metal that lift the gemstone from the surface of the band, securing the stone and allowing the facets of the gemstone to be seen more clearly. Based on the discussion contained in your written requests for reconsideration, Gemstone Setting serves that function, as its name implies. The Board considers Gemstone Setting to be, therefore, a useful article and, as such, subject to an analysis of separability in order to determine whether any particular pictorial, graphic or sculptural feature of the work may be identified separately from the useful article itself.

Separability

You have cited Mazer v. Stein, 347 U.S. 201 (1954), arguing that, notwithstanding the mechanical manner in which a setting holds a gemstone, the form of jewelry is copyrightable to the extent that it does not affect the mechanical or utilitarian function of the work. [10/31/01 second appeal at 2,3] The Board of Appeals agrees that aspects of a useful article may be entitled to copyright protection if the article contains pictorial, graphic or sculptural features that "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." (Emphasis added.) 17 U.S.C. §101 (definition of "pictorial, graphic, and sculptural works"). The legislative history of the Copyright Act of 1976 provides guidance on the separability analysis. The House Report accompanying the Act states that:

> [A]lthough the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design — that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such. (Emphasis added.)

H.R. Rep. No. 94-1476, at 55 (1976).

Based on this legislative history, as well as the statutory definition and case law decided under both the 1909 and the 1976 Act, a separability analysis was promulgated by the Copyright Office and is set forth in §505 of the ***Compendium of Copyright Office Practices, Compendium II*** (1984). Section 505.01 states that:

> Registration of claims to copyright in three-dimensional useful articles can be considered only on the basis of separately identifiable pictorial, graphic, or sculptural features which are capable of independent existence apart from the shape of the useful article. Determination of separability may be made on either a conceptual or physical basis.

Physical Separability. In its examination of the Gemstone Setting work, the Board did not identify any pictorial, graphic or sculptural features of Gemstone Setting that are physically

separable from the utilitarian aspects of the setting. Any actual physical removal of the setting components, i.e., the prongs as they are designed, is not possible without destroying the Gemstone Setting work as an entirety. Because there are no identifiable, physically separable elements, the Board then considered whether there were any conceptually separable elements in the Gemstone Setting.

Conceptual separability exists when pictorial, graphic or sculptural features are "independent of the shape of the useful article, *i.e.*, the artistic features can be imagined separately and independently from the useful article without destroying the **basic shape of the useful article.**" (emphasis added) ***Compendium II, §505.03.*** Section 505.03 of ***Compendium II*** also provides a useful example: In the case of conceptual separability, ***Compendium II, 505.03,*** states:

> Conceptual separability means that the pictorial, graphic and sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as pictorial, graphic or sculptural work which can be visualized on paper, for example, or as free-standing sculpture, an another example, independent of the shape of the useful article, i.e., the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article. The artistic features and the useful article could both exist side by side and be perceived as fully realized, separate works– one an artistic work and the other a useful article. Thus, carving on the back of a chair, or pictorial matter engraved on a glass vase, could be considered for registration.

The Board did not identify any elements of Gemstone Setting that are conceptually separable from its utilitarian function. The work is made up of prongs each of which is an integral aspect of the functioning structure of a gemstone setting because, together, they serve the purpose of holding or securing the gemstone in place.

You argued that the overall shape of Gemstone Setting is copyrightable. We again refer to the legislative history of the 1976 Act, *supra,* which explains Congress's goal of distinguishing between copyrightable works of applied art and uncopyrightable industrial design. The House Report specifically states that "... although the shape (emphasis added) of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill... The test of separability and independence from the 'utilitarian aspects of the article' does not depend upon the nature of the design– that is, even if the appearance of an article is determined by esthetic [as opposed to functional] considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable.' " H.R. Rep. No. 1476, 94th Cong., 2d Sess. 54, 55 (1976).

The "overall design ...of a utilitarian object, even if it is determined by aesthetic as well as functional considerations is not eligible for copyright." Esquire, Inc. v. Ringer, 591 F.2d 796, 804 (D.C.Cir. 1978).[1] In that quote from Esquire, the court was interpreting the House Report language just cited. Section 505.03 of ***Compendium II*** states the examining practice which confirms the Office's principle concerning the overall shape of a useful article in determining the presence or absence of conceptually separable features:

> The test of conceptual separability, however, is not met by merely analogizing the general shape of a useful article to works of modern sculpture, since the alleged "artistic features" and the useful article cannot be perceived as having separate, independent existence. The shape of the alleged "artistic features" and of the useful article are one and the same, or differ in minor ways; any differences are de minimis. The mere fact that certain features are nonfunctional or could have been designed differently is irrelevant under the statutory definition of pictorial, graphic, and sculptural works. Thus, the fact that a lighting fixture might resemble abstract sculpture would not transform the lighting fixture into a copyrightable work. (Emphasis added.)

Although you concede that you are not seeking registration for the functional aspects of the design of the Gemstone Setting, you describe the features in which you seek registration as the "external appearance of the setting" [10/31/01 second appeal at 3] and "the rotated and curved surfaces" of the prongs as they "sweep together to form a defined "V" intersection." [10/31/01 second appeal at 4] The essence of this argument focuses on the overall configuration and lines of the prongs as they exist each in itself and as they come together to form what may be described as the base or bottom portion of the setting as a whole. Essentially you have described the **shape of the setting** which is not protectible as evidenced in the explicit intention of Congress in its legislative history explanation of the 1976 Act. The Board has, therefore, determined that the overall shape of Gemstone Setting, a useful object which positions a gemstone within a piece of jewelry, is not registrable because the shape cannot be perceived as having any identifiable pictorial, graphic or sculptural features separate and apart from the useful article itself.

Originality

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[1] One of the principle cases on conceptual separability is Esquire, Inc v. Ringer, 591 F.2d 796 (D.C.Cir. 1978) cert. denied, 440 U.S. 908 (1979). Esquire held that a Copyright Office regulation that preceded the current §505.03 properly prohibited copyright registration for the overall shape or configuration of an utilitarian article, no matter how aesthetically pleasing that shape or configuration may be. Id. at 800. Section 505.03 of Compendium II is a direct successor to the Copyright Office regulation that was affirmed in Esquire as an authoritative construction of the statute as explicitly stated in legislative history. Id. at 802-03. *See also* Custom Chrome, Inc. v. Ringer, 35 USPQ2d 1714, 1718 (D.C. 1995), where the court stated that the conceptual separability test as it is currently enunciated in Compendium II "is consistent with the holding in *Esquire*, later cases decided under the present law, and the legislative history."

The Board further believes that, even if Gemstone Setting were not regarded as a useful object, registration must still be denied because the level of creativity in the work, considered as a non-useful element of jewelry, would be *de minimis*.

It is axiomatic that the requisite level of creativity required for copyright is very low. The Supreme Court has stated 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." Feist at 363. 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. A work that reflects an obvious arrangement fails to meet the low standard of minimum creativity required for copyrightability. Id. at 362-363. An example would be alphabetical listings in the white pages of telephone books which the Supreme Court characterized as "garden variety...devoid of even the slightest trace of creativity." Id. at 362.

Even prior to Feist, Copyright Office registration practices following settled precedent recognized that some works of authorship contain only a *de minimis* amount of authorship and, thus, are not copyrightable. See ***Compendium II***, §202.02(a). With respect to pictorial, graphic and sculptural works, the class to which Gemstone Setting would belong if it were considered non-useful, ***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.* at §503.02(a). ***Compendium II*** recognizes that it is not aesthetic merit, but the presence of creative expression that is determinative of copyrightability. 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 your requests for reconsideration, you provided very detailed descriptions that analyzed the design of Gemstone Setting's prongs. You have described the work as a setting that "gracefully frames the gemstone without blocking it from view or from the light, creating a presentation for a diamond or other precious stone that is elegant and functional." [4/18/01 first appeal at 3] You have also argued that the work is not a familiar design, stating:

> Nor does the applicant's work consist of minor variations of basic geometric shapes. The applicant's design consists of a complex combination of surfaces which subtly interact to capture and reflect light, unobtrusively frame and support a gem stone, and simultaneously accentuate the cut and depth of the stone.

[4/18/01 first appeal at 5]

After carefully considering your descriptions and discussion of Gemstone Setting, the Board, in its assumption *arguendo* that the work in question is a non-useful jewelry component, did not find any individual aspects of the work that would be copyrightable. Although the individual components of a given work may not copyrightable, the Copyright Office in its registration activity follows the Atari principle that works should be judged in their entirety and not judged in terms of the protectibility of individual elements within the work. Atari at 244,245 Based on that analysis, the Board has determined that the work in question is fundamentally a minor variation on the familiar design of a "V," in this case a "V" consisting of three-dimensional, curved sides.

The analysis followed in the Office's examining procedure for determining whether there is sufficient creativity for copyright protection does not involve comparing a new work to other similar works to determine whether anything new has been added by its author. ***Compendium II, §108.03***. Rather, the analysis for registrability is determined by the merits of each work without comparison to prior art or other registered works. It may be, as you argued, that Gemstone Setting varies in significant respects from other prong settings for solitaires. While those variations may be significant in the analysis required for a design patent, they do not necessarily meet the standard of creativity required for copyright protection-- a different standard premised upon the statute and decisional law of copyright.

The test for originality is based on the legal requirement that copyright protection is only available for "original works of authorship." 17 U.S.C. §102. In Feist, the Supreme Court stated that originality consists of two elements, "independent creation plus a modicum of creativity." Feist at 346. *Accord,* Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 102 (2nd Cir. 1951) ("'Original' in reference to a copyrighted work means that the particular work 'owes its origin' to the 'author.' No large measure of novelty is necessary.") Originality in the copyright sense consists of independent creation plus some modicum of creative contribution from the author. The principle is reflected in the Office's regulations which delineate broad categories of authorship not subject to copyright, one of which is the category of familiar symbols or designs. 37 C.F.R. §202.1(a).

The Board has concluded that the overall appearance of Gemstone Setting is a simple variation on a "V" shape. The shape or contour of the four prongs does not exhibit sufficient sculptural authorship to support a copyright claim. Gemstone settings typically have four or six strips of metal that surround a gemstone to secure it in a position above the band to permit more facets to be exposed to light. The design of four strips, or extensions, of metal arranged in a circular, oval or square pattern forming a border or fence surrounding the gemstone and positioning the stone, in varying heights, above the surface of the band, is a common design and, again, the prongs of the setting- considered individually as well as jointly-- lack the sculptural authorship necessary to sustain registration. The Board did not find anything in the overall appearance of Gemstone Setting that is more than a *de minimis* variation on a common design for gemstone settings. The creativity in this work is limited by the structural simplicity of the subject matter and by the limited components used in the particular expression.

The Board finds substantial support for its analysis and conclusion in case law which, although addressing two-dimensional designs as opposed to the three-dimensional sculptural lines at question here, nevertheless articulates the necessity for something more than minor variations on familiar and commonplace design elements. Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 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*, Magic Marketing v. Mailing Services of Pittsburgh, 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 fleur-de-lys held not copyrightable); Homer Laughlin China Co. v. Oman, 22 USPQ2d 1074 (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 USPQ2d 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).

In summarizing the Board's position if Gemstone Setting were not a useful article but, rather, a sculptural work to be considered in itself without need of finding physical or conceptual separability, the Board, nevertheless, would find that the sculptural configuration of Gemstone Setting fails to rise to the level of copyrightable authorship. Like the alphabetical arrangement in Feist, the arrangement of four or six metal prongs, or extensions, forming a general "V" shape as the prongs come together or converge near the band's surface, regardless of minor variations in the contour or convex shaping of the prongs, falls within the category of simple, minimal authorship which Feist has confirmed as uncopyrightable. The Board is unable to recognize in Gemstone Setting any contribution that is registrable as copyrightable authorship.

For the reasons stated in this letter, the Copyright Office Board of Appeals affirms the Examining Division's refusal to register Gemstone Setting. This decision constitutes final agency action on this matter.

Sincerely,

Nanette Petruzzelli

Nanette Petruzzelli
Chief, Examining Division
for the Appeals Board
United States Copyright Office