COPYRIGHT
OFFICE

March 18, 2004

Ms. Allison Z. Gifford
Duane, Morris & Heckscher LLP
One Liberty Place
Philadelphia, PA 19103-7396

Re: HOOD COLLEGE RING AND INDIANA UNIVERSITY RING
Control No: 60-702-3245 (D)

LIBRARY
OF
CONGRESS

Dear Ms. Gifford:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated June 30, 2000, appealing a refusal to register the designs for two college rings: Hood College ring and Indiana University ring. This request was made on behalf of your client, Milestone Traditions, exclusive licensee of Hood College and Indiana University Alumni Association. I apologize for the long delay in responding. The Board has carefully examined the applications, the deposits and all the correspondence in this case concerning these applications and affirms the denial of registration because neither of the works contains sufficient artistic or sculptural authorship to support a claim to copyright.

Washington
D.C.
20559-6000

Administrative Record

The initial applications for registration were submitted by Mr. William H. Murray of your firm as jewelry designs and were received by the Copyright Office on June 29, 1999. Both were refused registration by the original examiner because he found that the works lacked sufficient artistic or sculptural authorship to support a claim to copyright. Letter from Examiner John M. Martin to Attorney Murray of 9/8/99. The letter of rejection stated that in order to be copyrightable, artwork or sculpture must contain a minimal amount of original artistic material. In addition, the letter went on to say that "copyright does not protect familiar symbols and designs, minor variations of basic geometric shapes, lettering and typography, or mere variations in coloring." Id.

First request for reconsideration [first appeal]

On December 28, 1999, you filed a request for reconsideration of the refusal to register these works on behalf of your client, Milestone Traditions. In that request you urge that the copyrightability of the Hood College ring and the Indiana University ring is supported by case law, and that the artistic judgment, discretion and skill on the part of the author of these jewelry designs, Masters of Design, evidence the necessary creativity to

sustain registration. Letter from Gifford to Martin of 12/28/99 at 2-5. You observe that the standard for determining sufficient originality in a derivative work is "whether a work contains some substantial, not merely trivial, originality," citing Eden Toys, Inc. v. Florelee Undergarment Co., 697 F.2d 27, 34 (2d Cir. 1982). Although you state that only the Indiana University ring is a derivative work [Letter from Gifford of 12/28/99 at 4, fn. 1], you urge that the manner in which both rings were created compares to the art reproduction in Alva Studios, Inc. v. Winninger, 177 F. Supp. 265, 267 (S.D.N.Y. 1959), which reproduction the court found to contain sufficient originality. You also cite Alva for the proposition that the approval of museums was important evidence for finding that the copyrighted work at issue there was original and a skilled work of art. Letter from Gifford of 12/28/99 at 3-4. While conceding that the letter "H" in the Hood College ring is a stylized letter, you urge that the artist used his artistic judgment, skill, and originality in creating it and that the creation is "neither minor nor trivial, but is authorship with sufficient artistic originality created by many hours of artistic effort." Id. at 5. With respect to the Indiana University ring, you urge that the artist created variations between the university's seal and the ring design that are "original and substantial enough to satisfy the originality requirements for copyright registration." Id.

Examining Division response

In a letter dated March 6, 2000, Ms. Virginia Giroux, Attorney-Advisor for the Examining Division, responded to the initial request for reconsideration. Following her review of both works in light of the points raised in your letter of December 28, 1999, she upheld the refusal to register both works but expanded on the reasoning for the initial rejections. Letter from Giroux to Gifford of 3/6/00. Ms. Giroux pointed out that the design added to the surface of the Hood College ring consisted solely of a stylized letter H on a dark circular background. She stated that such a simple variation of a standard design, while perhaps aesthetically pleasing, was not copyrightable, citing John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986); Jon Woods Fashions, Inc. v. Curran, 8 U.S.P.Q. 2d 1870 (S.D.N.Y. 1988); Fortsmann Woolen Co. v. J.W. Mays, Inc., 89 F. Supp. 964 (E.D.N.Y. 1950); and DBC of New York, Inc. v. Merit Diamond Corp., 768 F. Supp 414 (S.D.N.Y. 1991). Ms. Giroux noted that the new material added to the Indiana University ring consists of a change in the outer border of the surface of the ring from a scalloped to a smooth circle, as well as the addition of a branch design in place of the star design which appeared on the pre-existing seal. She further observed that the smooth circle is a basic geometric shape which is not copyrightable, citing 37 C.F.R. 202.1, and the simple branch design is familiar and contains no adornment or distinguishing characteristic that rise to the level of copyrightable authorship. Letter from Giroux of 3/6/00 at 2. Ms. Giroux indicated that she found that the cases cited by you involved works of greater complexity and extent of authorship and pointed out that not all works are copyrightable. Finally, she pointed out that all creative works involve choices but it is not the possibility of choices which determines copyrightability; rather, it is the particular expression resulting from the choices which must evidence copyrightable authorship in order to sustain registration. Ms. Giroux

concluded that the rings at issue here did not contain artistic or sculptural features, either alone or in combination, which could form the basis for registration. Id. at 3-4.

Second request for reconsideration [second appeal]

On June 30, 2000, you filed a second request for reconsideration, arguing that both the Hood College ring design and the Indiana University ring design contain sufficient original authorship that is not trivial or insignificant and that both works contain sufficient creativity. You rely on four cases which you assert illustrate the minimum amount of originality required for a work to be copyrightable and which you assert support a finding of copyrightability : Fabrex Corp. v. Scarves by Vera, Inc., 129 U.S.P.Q. 392 (S.D.N.Y. 1961); Scarves by Vera, Inc. v. Fabrex Corp., 129 U.S.P.Q. 395 (S.D.N.Y. 1961); Eagle-Freedman-Roedelheim Co. v. Allison Mgf. Co., 204 F. Supp. 679 (E.D. Pa. 1962); and Creeks U.S.A. Corp. v. Roger Gimbel Accessories, 16 U.S.P.Q. 2d 1639 (C.D. Cal. 1989). You urge that the elements in the Hood College ring possess original authorship which is neither a trivial nor insignificant variation of a public domain element and that all of the elements when taken together are sufficient to show at least a minimum amount of originality. Letter from Gifford to Board of Appeals of 6/30/00 at 3.

For the Hood College ring, you submit that in Creeks, U.S.A. the court found that originality can be satisfied by demonstrating "a considerably higher degree of skill and true artistic skill" in reproducing a work. Letter from Gifford of 6/30/00 at 2-3, citing Creeks, U.S.A., quoting Batlin & Son, Inc. v. Snyder, 536 F.2d 486 (2d Cir. 1976). You assert that the author of the Hood College ring "is highly skilled in the detailed lost wax casting process which requires special techniques, judgment, great skill and originality when creating a class ring jewelry design work." Letter from Gifford of 6/30/00 at 3. You argue that this process, while labor intensive, is more than sweat of the brow and is original to the author, resulting in a ring design "capable of copyright protection because there is a minimum amount of originality in the ring design." Id. You liken the creator of the ring to the author of the art reproduction in Alva. Id.

You also state that there is sufficient originality in the Indiana University ring design which you have described as a derivative work which uses the preexisting college seal within the jewelry design. You cite to Eagle-Freedman-Roedelheim Co. where the Court found sufficient originality in a silkscreen design which had been adapted from an engraving. You note that while the Court did not elaborate as to why the silkscreen design was sufficiently original, "it can be assumed that there was consideration of the skill involved in the adaptation of an engraving to a silkscreen design," [Letter from Gifford of 6/30/00 at 4], and thus the silkscreen design case is therefore analogous to the facts surrounding the creation of the Indiana University ring design. In your view, the author's decision to change the stars appearing on the two-dimensional Indiana University college seal into branches with leaves on the three-dimensional ring design is evidence of an artistic choice that merits copyright

protection. In addition, you argue that the branches with leaves are not familiar or commonplace designs, but are more akin to the simple vegetables and butterflies in the designs at issue in the Scarves by Vera cases which were found to be copyrightable by the court. You acknowledge that the elements in the Scarves by Vera designs were simple yet you argue they were considered by the court to be original enough to the author to be copyrightable.

Finally, you cite Prince Group, Inc. v. MTS Products, 967 F. Supp. 121 (S.D.N.Y. 1997), stating that "as the threshold of originality was low, so was the threshold of creativity." You argue that, consistent with the decision in Prince Group, the letter "H" in the Hood ring design should be recognized as having been rendered in "almost an abstract way" and that the placement and selection of the "H" in the circle is original and creative and similar to the polka dots arranged in the fabric at issue in Prince Group. You have also stated that the Indiana ring design, an adaptation of the college seal, evidences the artist's independent skill and judgment in creating a design with the "right amount of shading, spacing and placement of letters, words and designs," including the changing of the stars in the original two-dimensional seal design to branches in the three-dimensional ring design, and that such elements result in a ring design showing "at the very least" the necessary minimal level of creativity necessary to sustain a claim to copyright. Letter from Gifford of 6/30/00 at 5.

After reviewing the applications and deposit materials submitted for registration and the arguments you have presented, the Copyright Office Board of Appeals now affirms the Examining Division's refusal to register the two ring designs at issue here because of lack of sufficient creativity needed to sustain a claim to copyright.

Decision

A. Description of works

The Hood College class ring design consists of a stylized letter "H" encrusted in a blue spinel or black onyx background stone. The appearance of the ring is one of a gold "H" inside a circle with a dark background. The sides of the ring band contain the graduation year date, with two numbers on one side– "20"– and two numbers on the other side– "00." No claim is made that this ring design was derived from an earlier work.

The Indiana University class ring design is admittedly based on a pre-existing college seal. Changes made to the ring are stated to be the following: (1) the outer border of the surface is changed from a scalloped-shaped edging to a smooth circle in order to make the wording of "Indiana University" stand out; (2) the use of a rough and darker background on

the ring is added to make the letters "IU" which are raised for emphasis stand out; and (3) the star design on the pre-existing seal is removed and replaced by "what appears to be a branch with leaves." Letter from Gifford of 12/28/99 at 5.

B. Feist's principle : originality requirement

Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991), straightforwardly articulated the principle that only a modest level of creativity is needed to sustain copyright protection. Under Feist, originality in a work of authorship means that the work was independently authored and that the work possesses at least some minimal degree of creativity. 499 U.S. at 345. We assume for purposes of this second reconsideration request that the overall jewelry designs in question, although one consists of certain pre-existing elements, were independently authored by Masters of Design, as indicated in the submission applications [with your client, Milestone Traditions, as the exclusive licensee of the claimants in the works.] We thus focus our analysis on the second Feist requirement– creativity– in order to determine copyrightability of the overall ring designs.

You have stated that the quantum of creativity necessary for a work to be copyrightable is modest. Letter from Gifford of 6/30/00 at 2. This is, indeed, Feist's principle. 499 U.S. at 345. The Feist Court observed that "as 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. We point out that pre-Feist case law recognized no demanding standard for copyrightability. You have yourself cited Alfred Bell & Co., Ltd. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951). That court stated that originality meant that authorship must constitute something more than a trivial variation of public domain elements, and that an author must have contributed something "recognizably his own." 191 F.2d at 103. We also add that Catalda, in stating that " 'original' in reference to a copyrighted work means that the particular work 'owes it origin' to the 'author,' " added that "no large measure of novelty is necessary." 191 F.2d at 102. This does not mean, however, that no standard at all existed. Although Catalda stated that "no large measure of novelty is necessary" in a work of authorship in order to enjoy copyright protection, the same Second Circuit opinion also held, as you have stated, that the distinguishable variation in a work of authorship for which copyright protection is sought, must be "more than a 'merely trivial' variation." 191 F.2d at 102-103. Forty years later, Feist again confirmed that the "standard of originality is low, but it does exist." 499 U.S. at 362. In order for a work to be subject to copyright protection, it must be an original work of authorship. The Board agrees that the quantum of originality is modest but regardless of whether the work is a work completely original to the author or is based on an earlier work, there must be evident more than a trivial variation of any public domain element[s] which may be incorporated into the work. Catalda, 191 F. 2d at 102, 103.

You urge that the two ring designs in question required great skill and originality for their creation; that the works, while being "quite labor intensive" are more than just sweat of the brow but are also original to the author– as that word is used in the copyright sense. Letter from Gifford of 6/30/00 at 3. Citing Alva Studios, Inc. v. Winninger, 177 F. Supp. 265 (S.D.N.Y. 1959), you emphasize that the ring designs at issue here are registrable because the "author created [them] by his own skill, labor and judgment, without directly copying or evasively imitating another's work." Letter from Gifford of 6/30/00 at 3, citing Alva, 177 F. Supp. at 267. You state that both rings are "capable of copyright protection because there is a minimum amount of originality" in the ring designs. Letter from Gifford of 6/30/00 at 3. (emphasis in original). While there was undoubtedly effort and skill demonstrated by the designer of the rings in creating the designs, as noted in Ms. Giroux's response to your first request for reconsideration, such industrious effort or "sweat of the brow" does not provide the basis for original authorship. Feist at 359: no copyright is recognized in works in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." After Feist, copyright protection depends on the resulting expression of authorship as opposed to the amount of effort, time or expense that was invested in the creation of the particular expression.

The Office has not claimed that the works in question did not originate with the party which created them; the question before the original examiner, then before Ms. Giroux, and lastly before the Board was whether either of the ring designs contains sufficient creative authorship. The Board upholds the finding that they do not.

1. A comment on Alva

We recognize that the decision in Alva was based on the premise that the work at issue there, a reproduction of Rodin's sculpted "Hand of God" was described by the court as "one of the most intricate pieces of sculpture ever created" with "innumerable planes, lines, and geometric patterns" which "are all interdependent in this multidimensional work. In reduction they all have to be carried over with supreme exactness into smaller scale." 177 F. Supp. at 266. Although the court in Alva found that the reproduction in question was sufficient to merit copyright, much of the opinion seems to be centered on the skill and effort required for the reduction / reproduction: "this reduction requires far more than an abridgement of a written classic; great skill and originality is called for when one seeks to produce a scale reduction of a great work with exactitude." Id. at 267. In addition to this emphasis on effort and skill in reproducing the original, the court did point out that the reproduction reflected a difference in the treatment of the base of the sculpture: "The rear side of the original base is open; that of the plaintiff's work is closed. We find that this difference when coupled with the skilled scaled sculpture is itself creative." Id.

Because Feist makes it clear that effort, or "sweat of the brow," is not a premise upon which copyright protection may be based ["(W)ithout a doubt, the 'sweat of the brow' doctrine flouted basic copyright principles," 499 U.S. at 354], your citing to Alva's skill, labor and judgment factors does not, in itself, establish the copyrightability of the ring designs in question. The result of the creator's skill, labor and judgment must result in fixed expression of the ring designs which in itself is sufficient under Feist. The Hood ring design consists solely of a dark, smooth, flat stone with the stylized– but very recognizable– letter "H" imposed on the surface. As Ms. Giroux noted in her March 6, 2000 letter [at 2], lettering per se is not copyrightable. 37 C.F.R. 202.1[a]– examples of works not subject to copyright: mere variations of typographic ornamentation, lettering or coloring. The letter "H," even though it is somewhat stylized, is nonetheless uncopyrightable lettering. Its arrangement within a circle having a dark background coloration, while perhaps aesthetically pleasing, does not furnish a basis to support a claim to copyright. *See, e.g.,* John Muller & Co., Inc. v. New York Arrows Soccer Team, Inc., 802 F.2d 989 (8th Cir. 1986). The only other element in this ring design is the graduation year added to the surface of the sides of the ring band: "20" and "00." The resulting authorship which may have been the product of much labor, effort and skill is not protectible under Feist's standard that a minimal quantum of creativity must be evident in a work. With respect to the "high level of expertise and skill of the artist" [Letter from Gifford of 6/30/00 at 5] which underlie the Indiana ring, again, we point out that the surface of the outer edge of the ring having been changed from a scalloped shape to a smooth edge, the use of a darker metal surface for the background of the ring and the addition of a small design on the outer edge of the ring of two branches with leaves– which are essentially depicted as a slightly curved straight line passing through three very small triangle-like shapes– is, in the Board's opinion, insufficient under Feist to sustain a claim to register.

2. Derivative work authorship

As noted in Ms. Giroux's letter, copyright in a derivative work covers only the additions, changes, or other new material appearing for the first time. It does not extend to any pre-existing material and does not imply a copyright in that material. Letter from Giroux of 3/6/00 at 1. You claim that only the Indiana University ring is a derivative work. The Creeks U.S.A. case which you cite in support of registration is not applicable to the ring designs at issue here. Creeks U.S.A. Corp. v. Gimbel Accessories, 16 U.S.P.Q. 2d 1639 (C.D. Cal. 1989). Creeks U.S.A. involved the design of a key chain ornament in the shape of a miniature tennis shoe and the court analyzed the miniature shoe sculpture as a derivative work. Relying on L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486 (2d Cir. 1976), which requires that derivative works must have sufficiently creative features distinguishable from the original in order to be copyrightable, the Creeks court, leaving the resolution to the trier of fact, ruled only that "if [the] mini-sneakers are merely a derivation of full size hi-top canvas sneakers with which the public has been familiar for years, then it may not hold a valid copyright for such sneakers absent a showing of an original contribution." 16 U.S.P.Q.

2d 1639, 1642. You have not identified the Hood ring design as a derivative work and, thus, the Creeks court's analysis does not apply. Even if it were a derivative work, however, the court in Creeks affirms Batlin's requirement that a mere copy of something in the public domain, e.g., the Hood ring's alphabet letter, will not support a copyright but a distinguishable variation will. Batlin, 536 F.2d at 490. The Board finds no distinguishable variation in the letter "H" which appears alone on the surface of the Hood ring design.

The design of the Indiana University ring is based upon the pre-existing school seal for Indiana University. The changes made to the seal for which copyright protection is sought are a change in the outer border of the seal from a scalloped to a smooth-edged circle, a use of a darker metal background on the surface of the ring's face, and an addition of two branch-like designs in place of three stars which had appeared in the original seal. None of these changes, either standing alone or taken together and regarded in their entirety, are sufficiently creative to warrant copyright protection. The smooth circle design at the outer edge on the ring is merely a common geometric shape which is not subject to protection. 37 C.F.R. 201[a]. The use of a darker metallic surface does not in itself indicate original authorship. Finally, the branch design– which is essentially a slightly curved, short, straight line passing through three small triangular shapes– is insufficient in expression to sustain a claim. Again, taking the Indiana design as whole still does not provide the necessary quantum of authorship for registration. Batlin states it clearly: "There is implicit in that concept [of required originality] 'a minimal element of creativity over and above the requirement of independent effort.' " Batlin, 536 F.2d at 490, citing 1 NIMMER, 10.2. As in the Hood ring design, while the combination of these elements may be aesthetically pleasing, such combination or overall arrangement of very few design elements, each *de minimis* in itself, does not furnish a basis upon which to support a copyright claim.

The Board also does not find either of the Scarves by Vera cases helpful to your position. In those cases, the court was considering whether there was substantial similarity between Vera's scarves and the competitor Fabrex's scarves, both employing designs using the same commonplace subject matter such as vegetables and butterflies/dragonflies. The Southern District of New York found evidence of copying; the court did not describe the butterfly scarves in detail [129 U.S.P.Q. 392, 394 (S.D.N.Y. 1961)]. However, in the second Scarves by Vera case, the court found the vegetable design to be an original design and did describe that design in some detail. The court, in comparing the competing designs, noted that "both designs include a showing of garden vegetables...;" that both "displayed peas in open and closed pods;" that both designs showed "tomatoes whole and sliced in cross section," etc. 129 U.S.P.Q. 395, 397 (S.D.N.Y. 1961). In other words, the designs at issue in these cases were designs which on their face were clearly copyrightable, consisting of two-dimensional drawings of various vegetables, butterflies and dragonflies which drawings did not raise any question of *de minimis* authorship and which the court easily identified as copyrightable. On the other hand, both the Hood and the Indiana ring designs before the Board cannot be analogized to the vegetable and butterfly drawings; both ring designs consist

of very few elements, most of which elements lie in the public domain [lettering] or are common geometric shapes [circles / small triangular shapes] which do not, in themselves or even in their overall arrangement, rise to the level of being copyrightable.

Your citation to Eagle-Freedman-Roedelheim also does not provide support for the registration of the two ring designs in question. In Eagle, the court held that the reproduction authorship, in this case, the silk screen reproduction of public domain engravings of Beethoven, Bach and Brahms, was "sufficiently original and changed from the engravings in the public domain to be copyrightable." 204 F. Supp. 679, 681. The court did not, however, expound on the nature of the reproduction authorship, and, because of the possibility of distribution of the artwork in question there without sufficient notice of copyright, the court declined to grant plaintiff's motion for a preliminary injunction. The case does not lend support to your argument that the particular authorship in the two ring designs, one of which is a derivative design, should sustain copyright registration. Each work must be judged on its own merits and the copyrightability of other, previously litigated, works– essentially dissimilar in authorship content– does not persuasively argue for the registration of the two ring designs currently before the Board.

Finally, you assert that both rings contain sufficient creativity and you also cite Prince Group, Inc. v. MTS Products, 967 F. Supp. 121 (S.D.N.Y. 1997). You urge that the "H" on the Hood ring design is "more than an average typed H" and that "it is rendered in almost an abstract way." [Letter from Gifford of 6/30/00 at 5]. You conclude that placement and selection of the "H" in the circle of the ring design is "indeed original and creative" and similar to the polka dot arrangement on the fabric design at issue in Prince Group. We point out that the placement of one letter, an "H," varied only from its usual configuration in that the vertical lines of the "H" are curved outward, placed in the center of the ring's circle, does not rise to the level of the placement and arrangement of the dots in Prince Group. In Prince Group, the court found that the design embodied sufficient original authorship in the design's irregularly shaped, variously colored dots, which were shaded on portions of the edges, and which were arranged in imperfect and conflicting diagonal lines at varying distances from each other giving the appearance of randomness. The Board does not consider the Hood ring design comparable to the irregular dot design in Prince Group. You also urge that the adaptation of the pre-existing two dimensional college seal to the three-dimensional Indiana ring design "shows just that 'creative spark' that is necessary for copyrightability." Letter from Gifford of 6/30/00 at 5. The Board does not agree. As we have set out [above at 5-6], authorship in a derivative work must be more than a minor variation of public domain material *or* of pre-existing authorship. The changes from scalloped edge to smooth edge, the addition of darker metallic background in order to set off the pre-existing "IU" lettering, and the addition of the simple branch design found in the Indiana University ring does not, either as individual design elements or taking the elements in their totality, rise beyond the pre-existing college seal design in a manner which is more than a minuscule variation. "A derivative work must be substantially different from the underlying work to be copyrightable.

This is the test of *L. Batlin & Son, Inc. v. Snyder*." Gracen v. The Bradford Exchange, 698 F.2d 300, 305 (7th Cir. 1983).

The Board has concluded that the Examining Division correctly found that the designs of the Hood College ring and the Indiana University ring contain insufficient copyrightable authorship to justify registration. Accordingly, registration for both rings is denied. This letter constitutes final agency action.

Sincerely,

/s/

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