The Register of Copyrights of the United States of America
United States Copyright Office · 101 Independence Avenue SE · Washington, DC 20559-6000 · (202) 707-8350

May 19, 2004

Robert S. Churchill
Eaton & Van Winkle LLP
3 Park Avenue
New York, New York 10016

Re: CLIP-ON WATCH MODEL 9360; CLIP-ON WATCH MODEL 9140
Copyright Office Control No. 61-204-9521(M)

Dear Mr. Churchill:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated December 2, 2002, on behalf of your client, Solar System International Co., Ltd., requesting reconsideration of a refusal to register works entitled "Clip-on Watch, Model 9140" and "Clip-on Watch, Model 9360." The Board has carefully examined the application, the deposit, and all correspondence in this case concerning this application and affirms the denial of registration of the two works.

ADMINISTRATIVE RECORD

Initial Submission

On February 26, 2002, the Copyright Office received two Form VA applications from Applicant, Solar System International Co., Ltd., to register two watch designs. In a letter dated March 25, 2002, Visual Arts Section Examiner Colleen Kearney refused registration of these works because she determined that they are useful articles which do not contain any separable authorship needed to sustain a claim to copyright. She explained that the works are useful articles that only can be considered as a pictorial, graphic or sculptural work for any such features that can be identified separately from and are capable of existing independently of the utilitarian aspects of the article.

She set forth the Office's tests for physical and conceptual separability. After examining the works under the requirements for each test, she determined that no physical or conceptual separability existed "[b]ecause all of the elements of the works you deposited are either related to the utilitarian aspects or function, or are subsumed within the overall shape, contour, or configuration of the article." Letter from Kearney to Chernin of 3/25/02, at 2. She concluded that no registration could be made but did note that the works may be entitled to protection under federal patent law.

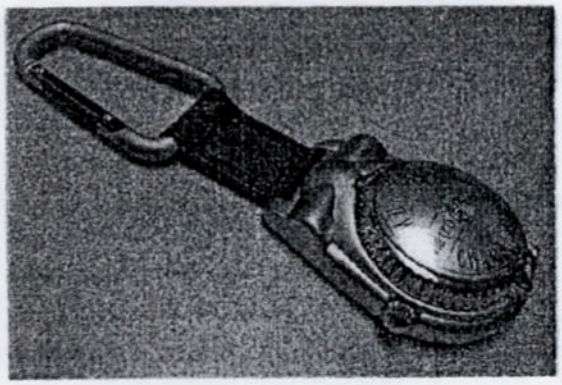
First Request for Reconsideration

On July 1, 2002, Oliver R. Chernin of your firm requested that the Office reconsider its refusal to register the two clip-on watches. To assist the Office in its reconsideration, Mr. Chernin provided physical copies of each work. He explained that copyright protection was being sought for the medallion cover which he stated was "not utilitarian in nature, and is purely decoration." Letter from Chernin to Kearney of 7/1/02, at 2. After listing the utilitarian features which he conceded were not subject to copyright protection,[1] he described the alleged copyrightable elements as follows:

In addition, each work features a medallion cover which constitutes a decorative feature. Such medallion cover is not utilitarian in nature, and is purely decoration. Copyright protection is being sought for this decorative feature. The operation of this decorative, medallion cover is as follows: when in the "closed" position, this cover is held in place by a string, located above the "12 o'clock" position on the case and a prong featuring a slit, attached to the cover, inserted in an opening located below the "6 o'clock" position on the case; when so inserted, the prong is maintained in place by a horizontal pin located in the case that connects to the slit of the prong; the cover can be opened by pressing a button, located on the case of the watch, that pushes the pin to the right thereby releasing the prong from the pin.

Letter from Chernin to Examining Division of 7/1/02, at 3.





[1]"Each of the works is a clip-on watch including the following basic elements: A case in which watch movement is placed; a bezel securing it inside the case, and protecting the moving parts from external damage; a face on which the numbers are displayed; a crystal protecting the dial and hands; a strap attached to the case and a clip attached to the strap to clip it on a belt loop, knapsack, briefcase, sportsbag or handbag." Letter from Chernin to Examining Division of 7/1/02, at 2.

He noted:

> The two works show several differences in the watch face and casing; however, these are relatively minimal. The more significant difference is in the design of the medallion cover, namely, the 9360 model features a convex cover surrounded by a circular ridged edge while the 9140 model cover is flat and inlaid within a smooth circular edge. While either cover provides a surface for displaying a company logo, as shown on the deposits and specimens submitted herewith, neither cover serves any utilitarian function in the operation of the watches.

Id.

He acknowledged that the two works fall into the statutory definition of "useful articles." He argued, however, that the designs of the two watches contain sculptural features that are both physically and conceptually separable from the watches' utilitarian functions.

He stated that the medallion covers could be physically separated from the case of the clip-on watch. In support of this assertion, he relied on Mazer v. Stein, 347 U.S. 201 (1954), and Severin Montres Ltd. v. Yidah Watch Co., 997 F. Supp. 1265 (C.D. Cal. 1997). He also stated that unlike the watch face design at issue in Vacheron & Constatin-Le Coultre Watches, Inc. v. Benrus Watch Company, 155 F. Supp. 932 (S.D.N.Y. 1957), rev'd in part on other grounds, 260 F.2d 637 (2d Cir. 1958), the medallion covers here are works of art separable from the utility of the watch. Letter from Chernin to Kearney of 7/1/02, at 5-6.

In support of his assertion that the works satisfied the test for conceptual separability, he likened t"he medallion covers to the belt buckles in Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980). He argued that like the ornamental surfaces of the buckles, which were found to be separable, the medallion covers "are not in any way required in the utilitarian function of the watch; i.e., to tell time, but rather provide a purely ornamental addition to the clip-on watches." Letter from Chernin to Kearney of 7/1/02, at 6. He also relied on the test adopted by the Second Circuit in Brandir Int'l, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987), which states that where a work's design elements reflect a merger of aesthetic and functional considerations, there is no conceptual separability; however, if the design elements reflect the designer's artistic judgment exercised independently of functional considerations, then conceptual separability exists. In closing,

he stated that since the medallion covers "have no bearing on the utilitarian features of the clip-on watches," the Brandir test is satisfied and conceptual separability exists.

In a letter dated August 5, 2002, Attorney Advisor Virginia Giroux of the Examining Division upheld the denial of registration of the two clip-on watches because they are useful articles that do not contain authorship that is both separable and copyrightable. She explained the definition of a useful article and that such works are examined to determine whether there is any pictorial, graphic or sculptural "authorship that is physically or conceptually separable from the work's utilitarian features. She noted that a work's aesthetic value, its visual effect or appearance, its uniqueness, the time and effort it took to create or its commercial success have no bearing on the examining process.

She then addressed whether the two watches here met the Office's tests for physical or conceptual separability. She disagreed with Mr. Chernin's argument that "if a work contains non-functional design elements, not dictated by utilitarian concerns, then these elements are automatically separable and as such, copyrightable." Letter from Giroux to Chernin of 8/5/02, at 2. She explained that the medallion covers provide an enclosure for the functional aspects of the watch and under the Office's test for physical separability set out in section 505.04 in Compendium II, Copyright Office Practices (1984), a cover or enclosure is not considered to be physically separable: "the test for physical separability is not met by the mere fact that the housing of a useful article is detachable from the functional or working parts of the article." Id., citing Compendium II, § 505.04.

Ms. Giroux then explained that the Office follows the test for conceptual separability set forth in section 505.03 of Compendium II, which states that conceptual separability exists when the pictorial, graphic, or sculptural features are clearly recognizable as a pictorial, graphic or sculptural work which can be visualized on paper or as a free-standing sculpture. This test differs from the one articulated in Brandir; as such, the Office does not follow it. Applying the Office's test, she explained that the medallion covers are part of the useful article that if detached would destroy the basic shape of the useful article. She did concede, however, that the logos on both covers as well as the circular ridges on the edge of Model 9360 and the smooth circular ridge on the surface on Model 9140 are conceptually separable. She explained, however, that the circles and ridges are common and familiar shapes or designs in the public domain and the logos are preexisting; thus, neither are copyrightable. Further, she noted that the simple combination of the circles and ridges on each cover's surface were insufficient to serve as a basis for a separate registration.

She then distinguished the cases Mr. Chernin relied on in his request for reconsideration. She closed by citing to the language in the legislative history of the Copyright Act that makes clear Congress's intent not to offer copyright protection to the design of a useful article.

Second Request for Reconsideration

On December 2, 2002, you made a second request for the Office to reconsider its refusal to register the two clip-on watches. You repeat the description of the works contained in Mr. Chernin's letter. You state that, contrary to Ms. Giroux's representation, the claimant did not argue that a separate design element is "automatically separable and as such copyrightable." Letter from Churchill to Board of Appeals of 12/2/02, at 3. You then state that Ms. Giroux appears to proceed "on the erroneous principal (sic) that separable design elements of a utilitarian article are presumed to be not copyrightable." Id. at 3-4. In support of this assertion, you state that the medallion covers are unique and that you are not aware of "any other clip-on watch which has a medallion cover." Id. at 4 (footnote omitted). You argue that since "the marketplace is filled with clip-on watches which do not have medallion covers," Ms. Giroux's statement that removal of the medallion cover would destroy the basic shape of the useful article is incorrect; therefore, you argue, the works here should be registered.

You then reiterate the arguments regarding physical and conceptual separability made in Mr. Chernin's July 1, 2002, letter.

DECISION

After reviewing the applications, the actual watches, and the arguments you presented, the Copyright Office Board of Appeals affirms the Examining Division's refusal to register the two clip-on watches because they are useful articles that have no elements that are both separable and copyrightable.

Useful Articles and Separability

A useful article may be entitled to copyright protection if it 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." 17 U.S.C.§ 101 (definition of pictorial, graphic or sculptural works) (emphasis added).

Description of Works

The legislative history of the Copyright Act of 1976 provides some guidance on the separability analysis. Specifically, 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.

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

The Office uses a separability test, set forth in section 505.02 of the Compendium of Copyright Office Practices, Compendium II, (1984) ("Compendium II"), which is based on the statutory definitions and legislative history. Section 505.02 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.

Section 505 of Compendium II is a direct successor to the Copyright Office regulation that was affirmed by the D.C. Circuit in Esquire, Inc. v. Ringer, 591 F.2d 796 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979). Esquire clearly enunciated the rule underlying the Office's legal analysis of whether a work is separable from the utilitarian article in which it is incorporated. Based on explicit statements in the statute's legislative history, the Court found that the Office's regulation was an authoritative construction of the copyright law. Id. at 802-803. As Esquire held, despite an original and creative shape, the overall design or configuration of a utilitarian article may not be copyrighted if it is not "capable of existing as a work of art independent of the utilitarian article into which [it is] incorporated." Id. at 803-804. In Esquire, the Court held that the Copyright Office properly refused copyright registration for a useful article, in that case a light fixture, notwithstanding how aesthetically pleasing the useful article's shape or configuration may have been. Id. at 800.

You do not dispute that the two clip-on watches are useful articles; therefore, the Board must determine whether these works contain any pictorial, graphic or sculptural

features that are either physically or conceptually separable from the works' utilitarian function.

Physical Separability. The test for physical separability is as follows:

> The physical separability test derives from the principle that a copyrightable work of sculpture which is later incorporated into a useful article retains its copyright protection. Examples of works meeting the physical separability test include a sculptural lamp base of a Balinese dancer, or a pencil sharpener shaped like an antique car. However, since the overall shape of a useful article is not copyrightable, the test of physical separability is not met by the mere fact that the housing of a useful article is detachable from the working parts of the article.

Compendium II, § 505.04 (1984).

You assert that the medallion covers are not part of the useful article but are decorative only and thus can be "physically separated from the case of the clip-on watch" without destroying the shape and operation of the works as watches, as evidenced "by the fact that the marketplace is filled with clip-on-watches which do not have medallion covers." Letter from Churchill to Board of Appeals of 12/2/02, at 4. In support of your argument, you cite Mazer v. Stein, 347 U.S. 201 (1954), and Severin Montres Ltd. v. Yidah Watch Co., 997 F. Supp. 1265 (C.D. Cal. 1997), aff'd, 165 F.3d 917 (9th Cir. 1998).

As noted above, although the housing of a useful article can be detached from the working parts of the article, that fact alone does not mean that physical separability exists under the Office's test. Compendium II, § 505.04. In your description of how the covers operate, you acknowledge that the medallion covers are part of the cases housing the operating parts of the watches. Letter from Churchill to Board of Appeals of 12/2/02, at 2. Consequently, such covers are not considered to be physically separable authorship.

In addition, the medallion covers are useful articles by definition: "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information [is a useful article]. An article that is normally a part of a useful article is considered a useful article." 17 U.S.C. § 101 (definition of "useful article") (emphasis added). Under the first part of the statutory definition, a work that serves even a single utilitarian purpose is a useful article. The covers satisfy this part of the definition because, as you acknowledge in your letter, they have a utilitarian purpose of protecting the watch crystals. See Letter from Churchill to Board of Appeal of 12/2/02, at 2 n.1. That the covers may also serve a decorative "function" does not change the fact that the covers on the clip-on watches here are useful articles.

The covers also satisfy the second part of the definition. It is common, although as you note in your letter not required, for clip-on watches to have covers of some sort. Therefore, it can be said that covers are "normally a part of" clip-on watches. Again, such covers have a utilitarian purpose of protecting the watch crystal. Since the clip-on watches at issue here have medallion covers, the covers are functional aspects of the watches. As such, removal of the covers would result in something other than the two clip-on watches, as each cover is a part of the entire article. Therefore, they cannot be considered physically separable features of the watches.

The medallion covers of the clip-on watches are also part of the overall shape of the watches , and while the overall shapes may be termed aesthetically pleasing, they are not subject to copyright protection. H.R. Rep. No. 94-1476, at 55 (1976). Thus, the Board has found no basis to conclude that either of the two clip-on watches meet the test for physical separability.

The Board's conclusion is not changed by the cases you cited in support of your argument that physical separability exists here. First, the Board takes this opportunity to note that the issue in Mazer v. Stein, 347 U.S. 201 (1954), was not separability but, rather, whether copyright protection already secured for a pictorial, graphic or sculptural work would end once that work was incorporated into a useful article. Mazer decided that such copyright protection continues. 347 U.S. at 214. As discussed above, the medallion covers are not stand-alone sculptures devoid of functional considerations. The covers have a utilitarian purpose of protecting the watch crystals. They also are part of the overall shape of the watches. As such, the Board does not find the medallion covers to be at all similar to the work in Mazer.

In Vacheron & Constantin-Le C. Watch v. Benrus Watch Co., 155 F. Supp. 932 (S.D.N.Y. 1957), rev'd on other grounds, 260 F.2d 637 (2d Cir. 1958), the court upheld the Office's refusal to register a watch design because it was a useful article and not a work of art incorporated into a useful article. The works here are similar to the work in Vacheron, in that the Board does not consider the covers to be physically separable from the useful articles here nor are they works of art incorporated into useful articles.

The Board notes that the other case you cited, Severin Montres, Ltd. v. Yidah Watch Co., discussed conceptual, not physical, separability using a test not adopted by the Office. Regardless, this case is not persuasive. In Severin Montres, the court relied on a copyright registration of the subject watch as prima facie evidence of the validity of the copyright in the watch. However, the Copyright Office subsequently cancelled the certificate of registration because the separately identifiable matter was not copyrightable. The only separable aspect of that watch design was a single letter of the alphabet, the letter "G." Lettering and typographic ornamentation are not copyrightable. 37 C.F.R. § 202.1(a), (e).

Because the medallion covers are not physically separable from the utilitarian aspects of the clip-on watches, the Board now considers whether the medallion covers are conceptually separable from the clip-on watches.

Conceptual Separability. 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." Compendium II, § 505.03. Section 505.03 provides a useful example: "Thus, the carving on the back of a chair, or pictorial matter engraved on a glass vase, would be considered for registration." The section continues:

> The test for conceptual separability, however, is not met by 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 existences. 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.

See also Esquire, 591 F.2d 796 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979), where the court upheld the Office's refusal to register an outdoor lighting fixture because copyright protection was not possible based on overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape or configuration may be; Norris Industries Inc. v. International Tel. & Tel. Corp., 696 F.2d 918 (11th Cir.), cert. denied, 464 U.S. 818 (1983), where the court held a wire-spoked wheel cover was not copyrightable because it was a useful article that did not contain any sculptural design that could be identified apart from the cover itself.

You assert that the medallion covers are conceptually separable from the watches' utilitarian aspects because they are purely decorative and are in no way required for the utilitarian function of the watches. In support of your argument, you rely on Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980); Brandir Int'l, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987); and Carol Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985).

In Kieselstein-Cord, the court upheld the Office's registration of two belt buckles because the "primary ornamental aspects" of the buckles were conceptually separable from

"their subsidiary utilitarian function." 632 F.2d at 993. You argue that like the belt buckles in Kieselstein-Cord "the present works' medallion covers are not in any way required in the utilitarian function of the watch[es]; i.e. to tell time, but rather provide a purely ornamental addition to the clip-on watches," and, therefore, are conceptually separable. Letter from Churchill to Board of Appeals of 12/2/02, at 7. The Board disagrees. In Kieselstein-Cord, the conceptually separable elements consisted of fanciful shapes that could exist independently from the overall functional design of the belt buckles. Here, however, as discussed above, the medallion covers are themselves useful articles that comprise functional aspects of the useful articles (protection of the watch crystals). They are also part of the overall shape, contour, and configuration of the watches. To remove the covers would destroy the basic shape of the useful articles. Thus, the medallion covers are not similar to the separable fanciful shapes in Kieselstein-Cord.

You then state: "Kieselstein-Cord also notes that conceptual separability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities." Id. at 7. You further argue that it is the "aesthetic attractiveness of the watches as embodied in the distinctive medallion covers, that make them unusual and distinct from other clip-on watches available in the marketplace." Id. As set forth in Compendium II, conceptual separability does not exist "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 existences." § 505.03. Similarly, the legislative history of the 1976 Copyright Act states that separability "does not depend upon the nature of the design--even if the appearance of an article is determined by esthetic (as opposed to functional) considerations." Therefore, the interpretation you offer is irrelevant to the Office's conceptual separability analysis. Also, whether people would buy these two watches even if they did not tell time is a theoretical question that is not before the Board.

Aside from the fact that your argument is inconsistent with the standard of review set forth above, the Board cannot accept your interpretation concerning aesthetic qualities and marketability of the watches in question. The Copyright Act and settled case law do not give the Copyright Office authority to investigate or to consider such matters in its determinations of registrability. The Office cannot determine what makes a useful object highly sought after or desirable. Compendium II, § 505.05. As a legal and practical matter, consideration of aesthetic appeal would greatly undermine the basis for refusing to register useful articles and threaten to render meaningless the rule that a useful article is not copyrightable unless there are separable elements. Therefore, the Board does not agree with this interpretation of conceptual separability.

Next, you cite Brandir Int'l, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987), where the Second Circuit adopted the test for determining conceptual separability proffered by Professor Denicola. That test considers whether or not a given feature or aspect of a useful article "reflects a merger of aesthetic and functional considerations;" if so, the

artistic features of the useful article cannot be said to be conceptually separable; if not, conceptual separability may exist. 834 F.2d at 1145. Professor Denicola's test encompasses a consideration of the design process involved in the useful article in question as well as the artistic choices of the creator of the article and whether the artistic aspects of the article were significantly influenced by the functionality requirements. 67 Minn. L. Rev. 707 (1983). The Board points out that the Office does not follow the Denicola test because of the possible problems which this test might engender, premised as it is, at least partly, on subjective perception. In addition, such a test might result in registration of works in conflict with the expressed congressional intent to deny copyright protection to the design of useful articles which happen to be aesthetically pleasing. Accordingly, the Copyright Office has also not adopted this test.

The Board also takes this opportunity to state that the fact that aspects of a useful article could have been designed differently is not relevant with respect to the test of conceptual separability that is used by the Copyright Office, a test frequently upheld by the courts and one not permitting protection for artistic or aesthetically influenced aspects or features of a work that constitute the shape, or part of the shape, of the useful article. "The mere fact that certain features . . . could have been designed differently is irrelevant to the statutory definition of pictorial, graphic and sculptural works." Compendium II, § 505.03.

Finally, you cite Carol Barnhart Inc. v. Economy Cover Corp., in which the court found that the aesthetic or artistic features of the mannequins of partial human torsos at issue were "inextricably intertwined with the utilitarian feature, the display of clothes" and therefore not conceptually separable. 773 F.2d at 419. You assert that unlike the torsos in Carol Barnhart, the medallion covers have "no bearing on the utilitarian features of the clip-on watches," to tell time. Letter from Churchill to Board of Appeals of 12/2/02, at 8. The Board agrees with Ms. Giroux that the medallion covers are not "inextricably intertwined" with the utilitarian aspects of the works here. However, as previously discussed, the covers are not conceptually separable because they are part of the overall shape, contour and configuration of the useful articles. Again, removal of the covers would destroy the basic shape of the clip-on watches.

However, the Board considers the logo and circular ridges on the edge of the cover on Model 9360 as well as the logo and smooth circular ridge on the surface of the cover on Model 9140 to be conceptually separable. These features could be visualized on paper and are independent of the shape of the useful article; thus, removal of these features will not destroy the basic shape of the useful article. See Compendium II, § 505.03 (1984). The Board will now consider the copyrightability of these features.

De Minimis Authorship

In determining whether a useful article is entitled to registration, the Examining Division follows a two-part analysis. First a determination is made whether or not there are any design elements that are separable from the function of the useful article. If there is any

separable work, then a determination is made as to whether such work rises to the level of authorship required by law. 17 U.S.C. § 102(a). As discussed above, the Board concludes that the logo and the smooth circular ridge on the surface of Model 9140 as well as the logo and scalloped edges on the edge of Model 9360 are conceptually separable elements. However, the Board concludes that these elements do not constitute more than de minimis authorship and therefore are not copyrightable.

In determining whether a work has a sufficient amount of original artistic authorship necessary to sustain a copyright claim, the Board adheres to the standard set forth in Feist Publications v. Rural Telephone Service Co., 499 U.S. 340, 345 (1991), where the Supreme Court held that only a modicum of creativity is necessary to support a copyright. However, the Court also ruled that some works (such as the work at issue in Feist) fail to meet the standard. The 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 a work in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." Id. at 359.

The Board also applies the principles of Compendium II that are relevant to the particular work being examined. Even prior to the Court's decision in Feist, as noted in Compendium II, the Office stated "[w]orks that lack even a certain minimum amount of original authorship are not copyrightable." Compendium II, § 202.02(a)(1984). With respect to pictorial, graphic, and sculptural works, the class within which the clip-on watches fall, see 17 U.S.C. § 102(a)(5), Compendium II 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). Compendium II recognizes that it is not the aesthetic merit or commercial appeal of a work, but the presence of creative expression that determines the copyrightability of a work, and that

> registration cannot be based upon the simplicity of standard ornamentation . . . Similarly, it is not possible to copyright common geometric figures or shapes . . . 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.

Id. See also 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.").

The case law confirms these principles. See 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); Bailie v. Fisher, 258 F.2d 425 (D.C. Cir.

1958) (cardboard star with two folding flaps allowing star to stand for retail display not copyrightable work of art); Magic Marketing, Inc. 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 protection); and Homer Laughlin China Co. v. Oman, 22 U.S.P.Q.2d 1074 (D.D.C. 1991) (upholding refusal to register chinaware design pattern composed of simple variations of geometric designs due to insufficient creative authorship to support copyright registration).

Use of public domain elements and/or commonly known shapes can, however, result in a copyrightable work as long as such use constitutes more than a trivial variation of such elements. Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 103 (1951); see Compendium II, § 503.02(a). The Board applies this standard by examining a work to determine whether it contains elements, either alone or in combination, on which a copyright can be based.

The Board finds that the circles and ridges on the covers are common and familiar shapes or designs, in the public domain, which do not exhibit original artistic authorship when examined individually. Even when examined in combination, such combination is nothing more than the mere bringing together of a few standard forms or shapes with minor linear or spatial variations. Accordingly, there is not sufficient creativity to support a registration. Compendium II, § 503.02(b). Similarly, the logos are not copyrightable because they are preexisting.

Such simple variations of standard shapes and simple arrangements, which while aesthetically pleasing and commercially successful, do not contain the minimal amount of original artistic authorship to support a copyright registration; and the courts have consistently upheld the Office's refusal to register such works. John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986)(logo consisting of four angled lines forming an arrow, with the word "Arrows" in cursive script below, found not copyrightable); Jon Woods Fashions, Inc. v. Curran, 8 U.S.P.Q.2d 1879 (S.D.N.Y. 1988)(upholding Copyright Office's refusal to register design consisting of striped cloth over which was superimposed a grid of 3/16" squares).

For the reasons stated herein, the Copyright Office Board of Appeals affirms the refusal to register Clip-on Watch, Model 9140 and Clip-on Watch, Model 9360. This decision constitutes final agency action on this matter.

Sincerely,

/S/

Marilyn J. Kretsinger
Associate General Counsel
for the Appeals Board
United States Copyright Office