FILE COPY

United States Copyright Office
Library of Congress · 101 Independence Avenue SE · Washington, DC 20559-6000 · www.copyright.gov

November 7, 2005

Amy R. Richter, Esq.
621 S.W. Morrison St.
Suite 1300
Portland, Oregon 97205

RE: CLUSTER NECKLACE and CLUSTER LARIAT
Control Number: 61-217-8546(R)

Dear Ms. Richter:

I am writing on behalf of the Copyright Office Review Board[1] in response to your second request for reconsideration dated May 17, 2004. After reviewing the applications from Julie A. Wong, the materials identifying the works at issue, and the arguments you presented, the Board affirms the Examining Division's refusal to register Ms. Wong's copyright claims for two jewelry designs, identified as Cluster (Necklace) and Cluster Lariat.

I. ADMINISTRATIVE RECORD

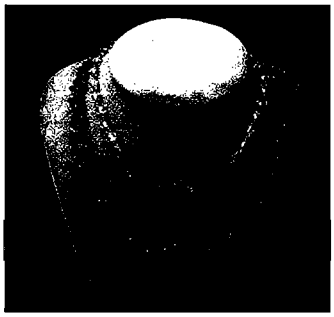
A. Initial Submission of Claims

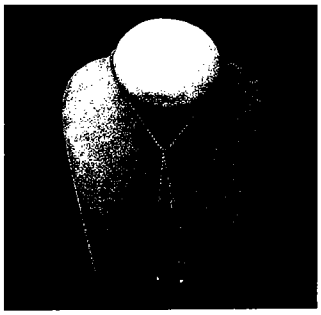
On June 11, 2003, Applicant Julie A. Wong submitted seven applications, each to register a copyright claim in a separate jewelry design. Since a second request for reconsideration has been submitted for only two of the applications, this administrative record is limited to those two, which are Cluster (Necklace) and Cluster Lariat.

By letter dated August 4, 2003, Visual Arts Examiner Colleen Kearney refused to register Ms. Wong's necklace designs because they lack the minimal level of creativity required to be entitled to copyright protection, citing Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991). Due to the fact that Ms. Kearney named only one of the necklace designs

[1] You submitted your second request for reconsideration to the Board of Appeals. However, on January 27, 2005, that body became known as the Review Board. 69 Fed. Reg. 77636 (December 28, 2004).

in the subject line of that letter, she clarified in a second letter, dated September 5, 2003, that the refusal to register applied to all seven claims for the seven works which had been submitted.





Description of works submitted:

Cluster (Necklace) is a single chain necklace, while, Cluster Lariat, is a single chain with a lariat knot hanging from the rounded portion of the necklace. The chain in Cluster (Necklace) is barely visible. Cluster Lariat's chain is only concealed at the point where the lariat is formed. Both chains are simple designs of small circle shapes connected to each other. The beads on both necklaces are attached in a manner which shows the beads in a grape-like cluster pattern, i.e., the beads do not lie flat in a linear sequence but, rather, lie clustered together at angles to each other. The beads themselves are simple, small rounded beads of various colors. The shorter of the Cluster Necklaces shows a portion of the underlying chain strand containing not the grape-clustered beads but, rather, individual, one-color beads in a flat, linear progression. Cluster Lariat shows a large, same-color bead as the last element attached to the two pending strands of the lariat.

B. First Request for Reconsideration [First Appeal] and Examining Division Response

By letter dated November 24, 2003, as Applicant's attorney, you submitted a request for reconsideration for the two necklace designs CLUSTER NECKLACE and CLUSTER LARIAT. You described the designs as:

> a complex architecture of lattice and layering so as to achieve a 3 dimensional quality while in addition allowing for the movement of the stones. This is not one bead next to another, next to another. It is this layering and latticework which contains the artistic expression.

Letter from Amy R. Richter to Examining Division of 11/24/03, at 2.

Id. You cited Bleistein v. Donaldson Lithographing Company, 188 U.S. 239 (1903) and Trifari, Krussman & Fishel, Inc. v. Charel Co., 134 F.Supp. 551 (D.C.N.Y. 1955) for the proposition that

only a modest level of authorship is required for copyright protection. Attached to your letter was a statement from the Applicant, dated November 23, 2003, in which Ms. Wong described the process, aesthetic considerations and materials used in producing the jewelry designs.

By letter dated January 20, 2004, the Examining Division's Attorney Advisor, Virginia Giroux, again refused to register the two necklace designs at issue here. Ms. Giroux stated that neither the materials used to create a work nor the process or technique by which it is created nor its commercial value or success is relevant to its copyrightability. Letter from Giroux to Richter of 1/20/04, at 1 - 2. She explained that, using Feist as the standard of whether a work of authorship meets the requirement of possessing a certain minimal amount of creativity, more than a trivial variation of public domain elements employed in a work of authorship is required. She further explained that the Copyright Office examines a work submitted for registration to determine whether the work contains design elements, *either alone or in combination*, sufficient to sustain a copyright registration. Id., at 2. (emphasis added).

Ms. Giroux then cited several cases in which courts have upheld the principles for creativity as they are applied by the Copyright Office. She agreed with you that a low level of authorship is required; however, she stated that the arrangement and configuration of the necklace designs "fail to meet even the low threshold for copyrightable authorship set forth in the Feist case." Letter from Giroux of 1/20/04, at 3. Ms. Giroux further explained that distinctiveness, the visual impression which may be created in the mind of the viewer, and aesthetic appeal are not relevant to copyrightability. In Ms. Giroux's words, "A work may be aesthetically pleasing, the result of substantial time and effort, and commercially valuable, but this does not mean that it is copyrightable." Id. She concluded that the necklace designs at issue here, analyzed as to their constituent elements of gemstones/pearls and to those elements as considered in their particular configuration, do not evidence sufficient artistic or sculptural features to sustain a claim to copyright.

C. Second Request for Reconsideration [Second Appeal]

By letter dated May 17, 2004, you requested that the Copyright Office Review Board again reconsider the Office's refusal to register the two necklace designs; you argue that the designs show sufficient creativity to be copyrightable. You also raise procedural objections.

You state that additional arguments you identified in the Office's second letter of refusal [Letter from Giroux of 1/20/04] are not proper grounds for objection because they were not raised initially by the examiner and the Copyright Office thereby waived its right to raise them later. These are the grounds of lack of originality and failure to meet the requirements which would avoid a work's being categorized as uncopyrightable under 17 U.S.C. § 102(b). Nevertheless, you have said that you will address them. You also object to Ms. Giroux's reliance on Compendium of Copyright Office Practices II (1984) as a basis for her refusal to register because you assert that Compendium II is for internal use only and is not available to the public, which you identified as a violation of 5 U.S.C. § 552 which requires that an agency's

policies and interpretations be publicly available. Letter from Richter to Board of Appeals of 5/17/04, at 1-2, 7.

You argue as further ground for appeal that the statutory provision, 17 U.S.C. § 102(b), referred to by Ms. Giroux in her January 20, 2004, letter, is not applicable here. You argue that the Applicant is seeking to register necklace designs, not a process or technique. You also argue that Applicant's jewelry designs are not barred from registration by 17 U.S.C. §102(b) because the necklace designs at issue here are "arrangement[s] of stones and metal links" which "is neither a process nor method." Letter from Richter of 5/17/04, at 3. You also argue that the necklace designs have a sufficient level of creativity to be copyrightable. Citing Melville B. Nimmer & David Nimmer, Nimmer on Copyright and Bleistein v. Donaldson you assert that the required level of creativity is only minimal. Letter from Richter of 5/17/2004, at 3. You also note that there is no dispute that Applicant's works were independently created and argue that the combination of elements in Applicant's works entitle the necklaces to registration, relying on Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 101 (2d Cir. 2001); Weindling International, Corp. v. Kobi Katz, Inc., 56 U.S.P.Q.2d 1763 (S.D. N.Y. 2000); Metcalf v. Bochco, 294 F.3d 1069 (9th Cir. 2002); Roth Greeting Cards v. United Card Company, 429 F.2d 1106 (9th Cir. 1970); Boisson v. Banian, Ltd.,[2] 273 F.3d 262 (2d Cir. 2001); Knitwaves, Inc. v. Lollytogs, Ltd., 71 F.3d 996 (2d Cir. 1995); and Odegard, Inc. v. Costikyan Classic Carpets, Inc., 963 F.Supp. 1328 (S.D.N.Y. 1997). Letter from Richter of 5/17/04, at 4.

In support of your argument that the necklaces at issue here meet the required quantum of creativity as designed by Ms. Wong, you also cite a letter from Professor Timothy Lloyd [attachment to your 5/17/04 letter]: "The originality comes from decisions she makes in placing and juxtaposition of various elements. The pieces are poetic in their use of color and their assemblage." Letter from Timothy L. Lloyd to the Appeals Board of 5/17/04. Finally, you also challenge the Office's refusal to register the jewelry designs at issue here by providing examples of other works that you allege were registered by the Copyright Office and by favorably comparing Applicant's works to them.

II. PROCEDURAL ISSUES

A. Your Objections

Before we explain the basis for the Board's decision to refuse registration for the two jewelry designs at issue here, we will address the procedural issues which you have raised. You have made the following statements in your second request for reconsideration:

---

[2] Your cite is to Boisson v. American County Quilts and Linens, Inc., 273 F.3d 3 262 (2d Cir.2002). Letter from Richter of 5/17/04, at 4. American Country Quilts and Linens, Inc. was a co-plaintiff company, wholly-owned by Boisson. We assume a mere typographical mistake in the citation.

> It is important to note that the initial rejection was based solely on the ground of lack of creativity. At no point did the examiner claim that the work was not original. The January 20 response to the First Appeal for the first time justifies the rejection on two additional grounds: lack of originality and as uncopyrightable material under 17 U.S.C. § 102(b). (Thus, as a technical legal point, only the question of creativity could be a proper ground for rejection.)
>
> Letter from Richter of 5/17/04, at 1.
>
> *****
>
> There is also now a 3rd ground of this appeal, another procedural error, namely reliance on the non-public Compendium as a part and basis of the denial. This reliance is a violation of law and thus is itself a ground for reversal.
>
> Letter from Richter of 5/17/04, at 2.
>
> *****
>
> First, as described above, the examiner listed only one ground for refusal. On review of that action, the response to the First Appeal identified several additional grounds. By failing to raise these grounds initially, they were not preserved, thus waived and cannot now be the basis for further denial of registration. Second, the January 20, 2004 [*sic*] relies heavily on Compendium II, Copyright Office Practices. However, as stated on the Copyright Office website, the Compendium is not a public document, but for internal use only. This is a clear violation of 5 U.S.C. § 552 which requires that all policies and interpretations be made public. Accordingly, on these grounds alone, the decision to deny registration must be reversed.
>
> Letter from Richter of 5/17/04, at 6 - 7.

B. The Board's Reply re the Examining Procedure at the Initial and First Reconsideration Stage

1. Meaning of Original Within Copyright Law

The Board would like to clarify that Ms. Giroux did not raise new arguments in her response to your first request for reconsideration. In her January 20, 2004, letter, Ms. Giroux expanded and elaborated on the same general principles that were the basis of Ms. Kearney's

decision. In an analysis of Ms. Kearney's [the original examiner] letter, we note the following: Ms. Kearney had refused registration on the basis that the works at issue here lack sufficient creativity "within the meaning of the copyright statute and settled case law." Letter from Kearney of 8/4/03, at 1. As an introductory paragraph, Ms. Kearney referred to the statute, 17 U.S.C. § 102(a), in stating that copyright protects **original works of authorship** that are fixed in some physical form. (emphasis added). In referring to the law, Ms. Kearney also cited the hallmark case, Feist as the Supreme Court's articulation that the term **"original"** means that a copyrightable work "was independently created by the author [as opposed to copied from other works] and that it possesses at least a minimal degree of creativity." Letter from Kearney of 8/4/03, at 1.

Feist, thus, is the highest authority for its teaching that, in the context of copyright protection, originality consists of two elements: (1) independent creation and (2) a minimal quantum of creativity. Feist, 499 U.S. at 345.[3] When a work possesses only a *de minimis* level of creativity, it is not original within the meaning Feist has set out, and, therefore, such a work is not copyrightable. A work's lacking sufficient creativity is the equivalent of the work being declared to be not original. The status of insufficient creativity, thus, provides a basis for stating that a work is not original. Ms. Kearney's judgment of the two works at issue here can fairly be said to be that the works are not original because they lack the required level of creativity; Ms. Kearney thus makes the connection between the two concepts–originality and creativity–as the reason for refusal to register.

Ms. Giroux subsequently confirmed Ms. Kearney's explanation as to the need for a "sufficient amount of original and creative authorship to be copyrightable." Letter from Giroux of 1/20/04, at 1. Throughout her January 20, 2004, letter, Ms. Giroux referred to pre-, and post-Feist case law, applying the long-existing standard within copyright law that a work need possess only a small quantum of creativity but that there are certain works which lack this necessary quantum. Id. at 3. Further, Ms. Giroux described the two jewelry works at issue here and, after analyzing the composition of the works as to their individual design components as well as the overall arrangement and combination of the design elements, determined that the works did not evidence sufficient "creative authorship to merit copyright protection." Again, Ms. Giroux, at the first reconsideration stage where a second examination of the works in question is in order and a more extensive reference to precedent is made, provided a more detailed continuation of the reason for refusal to register which Ms. Kearney had given.

---

[3] Utilizing the precedent of Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53 (1884), and The Trade-Mark Cases, 100 U.S. 82 (1879), the Supreme Court cited this case law for making it "unmistakably clear" that the terms "authors" and "writings," as found in art.1, § 8, cl. 8, of the Constitution presuppose a degree of originality; the Court also referenced scholarly commentators on copyright law and concluded explicitly that "originality is a constitutional requirement." Feist, 499 U.S. at 346.

2. Application of Section 102(b) of the Copyright Law for Registration Purposes

You have also pointed out that Ms. Giroux's January 20, 2004, letter raised for the first time the issue of 17 U.S.C. § 102(b) which prohibits protection for an "idea, procedure, process, system, method or operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied" in a work of authorship. Ms. Giroux alluded to this prohibition in the statute and to the lack of protection for associated aspects of a work, including "process or technique" as being equally not protectible [Letter from Giroux of 1/20/04, at 1]. This was in rebuttal to your statements regarding the manner in which the works were created. You stated that the designs are created by "layering and latticework which contains the artistic expression" and you provided a statement from Applicant in which she described the process or technique by which she assembles the designs. Letter from Richter of 11/24/03, at 2; attachment, statement from Julie A. Wong of 11/23/03, at 1: "This process creates a greater depth in the jewelry and also allows for movement of the hand-set gems." And, "[T]he formal elements of my jewelry fabrication, that is, the latticework, and the layering of gems/pearls, make my jewelry distinct and easily recognized." Id. at 2.

Because copyright protection is only available for the final result of authorial effort, or, fixed expression [17 U.S.C. § 101, statutory definition of "fixed"], the Copyright Office cannot take into account, as evidence of copyrightability, the arguments you provide about any aspect of the creative process or the efforts that were involved in producing a work. Ms. Giroux's comments about the statute's section102(b) explained that your previous arguments were not relevant to considering whether a work has sufficient creativity to be original. Ms. Giroux was responding to your presentations in your November 24, 2003, letter; she was not refusing registration on the basis that the Applicant seeks to register a process or technique. It is, rather, the fact that the process or technique or method used in the creation of a work is irrelevant; the critical factor is whether the particular process or technique employed results in sufficient creative expression to sustain a claim. Evidence regarding technique or procedures used in the design or production process do not bolster your argument that the works are sufficiently creative under the second prong of the two Feist requirements– 1. independent origin with the creating party (which requirement we have never questioned); and, 2. sufficient creativity. Again, Ms. Giroux did not raise any new arguments; she merely continued a detailed discussion of the lack of sufficient creativity in the two necklace designs at issue and she utilized more extensively than did Ms. Kearney relevant case law in her explanation of her judgment.

3. Copyright Office Procedure for Reconsideration of Works for Which Registration Has Been Refused

Having explained that the first reconsideration [first appeal] of the two works at issue here was, indeed, a continuation, accompanied by more detailed analysis, of the original decision regarding these claims, we, nevertheless, now wish to point out the following information concerning the Office's process of reconsideration for registration.

Serving as the administrative agency for the copyright registration process [17 U.S.C. §§ 410, 701], the Copyright Office has the right to continue a refusal of registration during the reconsideration process for the same reasons given at the lower levels of examination and reconsideration and also for additional, newly-articulated reasons not raised initially by an examiner or by the attorney for Examining. The purpose of reconsideration is to give the Office an opportunity to review for correctness its decision regarding any particular claim to copyright registration. The Copyright Office examines approximately 600,000 claims each fiscal year and this workload is initially handled by the Office's Examining Division. Request for reconsideration of refusal to register are handled by the Attorney-Advisor to the Examining Division. If the refusal to register is sustained by the Attorney-Advisor, a claimant may request a second and final reconsideration. This request is handled by the Office's Review Board [previously, the Board of Appeals] consisting of the Register of Copyrights, the General Counsel to the Copyright Office, and a staff member designated by the Register.

The Review Board, in its consideration of claims before it, applies essentially a *de novo* standard of review; the Board is not obliged to accept the determinations concerning a given claim which were made at either the initial examination or at the level of first reconsideration. The Board examines the claim[s] anew and, in so doing, applies all relevant statutory, regulatory and Office practices provisions. This review is not an adversarial proceeding but a process for evaluating whether the initial and interim decisions are correct. The review process at the Board level also permits an exchange between the Applicant and the Office, if necessary, to clarify and explain any and all Applicant and Board concerns about the claim submission as a whole before the agency decision is finally made.

The Review Board's goal is to provide a fair final review of a previous refusal to register. In doing so, the Board must re-examine the claim and all relevant documentation and deposit materials which are part of the overall submission of the claim. This careful and detailed examination, the review of the decisions of the examiner and Attorney-Advisor staff and their reasoning, and the analyzing of the work[s] at issue allow the Board to take all aspects surrounding the authorship of the work into consideration and to permit, where necessary, the Office to correct any errors made at any point along the registration and review process.

Finally, the Review Board is not bound by the same procedural rules which may govern court systems and litigation within them. The specific goal, again, of the Board is the correct assessment of a given claim to copyright and, where necessary, the correction of Office action which may have been taken at lower levels. The second reconsideration activity is the last examining action which this Office undertakes before issuing a final, agency action--either a registration or a refusal to register. As such, the Applicant is free to raise issues at the second reconsideration level which have not previously been raised, i.e., the Applicant is not barred from bringing forth arguments and positions which he may not have made at the original submission or at the first reconsideration request. In a like manner, the Board is free to ask additional questions of the Applicant, to request additional supporting materials, to apply Office practices, and to analyze unresolved issues within the statutory framework, Office regulations,

and applicable case law which may not have been previously considered with respect to the work[s] at issue.

4. Compendium of Copyright Office Practices

You also object to Ms. Giroux's reliance on the practices manual of the Office, Compendium of Copyright Office Practices II (1984), as a basis for her continued refusal to register the jewelry designs at issue here. Ms. Giroux cited Compendium II in her analysis of the composition of the necklace designs as being *de minimis* and, therefore, failing to rise to the level of the necessary creativity, the second prong of Feist. Letter from Giroux of 1/20/04, at 2. Your May 17, 2004 second request for reconsideration states that the Office's website indicates that the "Compendium is not a public document but for internal use only." This is not an accurate statement regarding the availability of the Compendium. Compendium II is the manual of principles and practices which the Copyright Office staff follow in their activities of examining claims submitted for registration and processing documents submitted for recordation. As such, it is a publicly available document. The Office's website [at www.copyright.gov] does provide only the two recently-revised chapters of Compendium II, Ch. 1600 on the Office practices governing recordation of documents pertaining to copyright and Ch. 1900 on general information concerning the availability to the public for inspection of the records, indexes and deposit materials submitted to the Office. We also point out, however, that information about where a person may obtain a complete copy of Compendium II may be found at 37 C.F.R. § 201.2 (b)(7); in that published regulation the Copyright Office provides information on obtaining copies of both manuals, Compendium I [for works governed by the 1909 statute] and Compendium II [for works governed by the 1976 statute]. Compendium I may be purchased from the National Technical Information Service and Compendium II from the Government Printing Office. The regulation at § 201.2(b)(7) also indicates that the volumes are available for public inspection and copying in the Certifications and Documents Section, Information and Reference Division of the Office. Ms. Giroux in her reference to Compendium II was legitimately citing practices which the Office does, indeed, make available to the public.

As further evidence of the Compendium's availability to the public, it is frequently relied upon by courts, often cited in their opinions. *See* Lumps Plus, Inc. v. Seattle Lighting Fixture Co., 345 F.3d 1140, 1146 (9th Cir. 2003); Batjac Productions, Inc. v. Goodtimes Home Video Corp., 160 F.3 d 1223, 1230 (9th Cir. 1998); Samara Bros., Inc. v. Wal-Mart Stores, Inc., 165 F. 3d 120, 137 (2d Cir. 1998) and Shady Records, Inc. v. Source Enterprises, Inc., 73 U.S.P.Q. 2d 1954 (S.D.N.Y. 2005).

III. DECISION

After carefully reviewing your arguments and the applications, the Review Board has determined that the design elements in Applicant's two necklaces do not exhibit copyrightable authorship.

A. Feist's Principle and Office Practices

The Board agrees with you that jewelry may be copyrighted. Jewelry falls within the statutory classes of subject matter amenable to copyright. 17 U.S.C. § 102(a)(5)– pictorial, graphic and sculptural works. We have already mentioned that Feist's articulation of originality as a constitutional requirement, *above at 5, fn. 2,* lays the groundwork for the principle that "copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity." 499 U.S. 340, 363. However, these conclusions do not mandate that every work submitted for registration, or every item of jewelry, is copyrightable.

Feist is a landmark case on the meaning of originality, particularly for compilations of public domain and commonplace elements. Consistent with Feist and other judicial precedent, Copyright Office registration practices reflect the principle that originality consists of two components: a work must have independently originated with the author and must exhibit a minimal level of creativity. *See also* Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 102 (2d 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."); Burrow-Giles, 111 U.S. at 58 (The court defined "author" to mean the originator or original maker and described copyright as being limited to the creative or "intellectual conceptions of the author.") Thus, even prior to Feist, courts interpreted the creativity prong of "original" to be very low, easily satisfied. Any "distinguishable variation" of a work constituted sufficient originality as long as it was the product of an author's independent efforts, and was "more than a 'merely trivial' variation." Catalda, at 102-103. Bleistein, 188 U.S. at 250: "... a very modest grade of art has in it something irreducible, which is one man's alone."

You, thus, naturally emphasize that only a very low level of creativity is needed to satisfy the originality requirement. Letter from Richter 5/17/04, at 3 - 6. However, the Court stressed in Feist that there are works, such as the white-pages telephone directory which the Court held not protectible, in which the "creative spark is utterly lacking or so trivial as to be virtually nonexistent." Feist, 400 U.S. at 359. The Court ruled that the white-pages listing of telephone numbers in alphabetical order by name of resident did not meet the minimum standards for copyright protection. Id. at 363. It characterized the arrangement as "typical," "an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a manner of course." Id. Such works are incapable of sustaining copyright protection. Id. at 359 (citing Nimmer on Copyright, § 2.01[B]). A work that reflects an obvious arrangement fails to meet the low standard of minimum creativity required for copyrightability. Id. at 362-363.

Written practices and guidelines for the Copyright Office incorporate the principles for originality elucidated by the Supreme Court in Feist. Compendium II, § 202.02(a), (detailed

guidelines for examination procedures[4]). With respect to pictorial, graphic and sculptural works, Compendium II states that:

> A certain minimal amount of original creative authorship is essential for registration. . . . Copyrightability depends upon the presence of creative expression in a work, and not upon aesthetic merit, commercial appeal, or symbolic value. Thus, registration 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. For example, it is not possible to copyright a new version of a textile design merely because the colors of red and blue appearing in the design have been replaced by green and yellow, respectively. 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.
>
> Compendium II, § 503.02(a)

Copyright Office regulations provide examples of works which are not the subject of copyright; these include "[w]ords and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents." 37 C.F.R. § 202.1(a). These are exceptions to copyright protection because they may be termed basic building blocks for creative works and, so, must remain in the public domain, available to all. Permitting them to be copyrighted would impede the constitutional goals that underlie congressional authority to establish copyright protection. art. I, § 8, cl. 8: "The primary objective of copyright is not to reward the labor of authors, but '[t]o promote the Progress of Science and useful Arts.'" Feist at 349.

Feist is particularly instructive in its elucidation of the appropriate standard of analysis for determining whether compilations or combinations of public domain, standard, or trivial elements satisfy the requirement for creative authorship. Under the Feist standard for

---

[4] Compendium II sets forth Copyright Office principles and practices for examining and registering works. *See* 37 C.F.R. § 201.2(b)(7). Courts generally defer to the interpretations found in Compendium II. *See, e.g.*, Batjac, 160 F.3d at 1230-31; Natkin v. Winfrey, 111 F. Supp. 2d 1003, 1010 (N.D. Ill. 2000); Compuware Corp. v. Serena Software Int'l, Inc., 77 F. Supp. 2d 816, 822 (E.D. Mich. 1999); Jon Woods Fashion, Inc. v. Curran, 8 U.S.P.Q.2d 1870, 1872 (S.D.N.Y. 1988).

compilations, works based on public domain, standard or commonplace, or trivial elements may be copyrightable if there is some distinguishable element in their selection, coordination, arrangement or overall combination that reflects choice and authorship that is not so obvious or so minor that the "creative spark is utterly lacking or so trivial as to be nonexistent" for the resulting work as a whole. Id. at 358-359. *See also* 17 U.S.C. § 101 (definitions of "compilation" and "derivative work"). In any analysis of a work of the visual arts, the Copyright Office considers the organization, arrangement, selection, or combination of elements or features *as a whole* rather than focusing on individual elements in themselves. Compendium II, § 625.02. You cited several cases for this same proposition. Letter from Richter of 5/17/04, at 4.

B. Relevant Case Law

In your second request for reconsideration, you cite as helpful to your client's cause Weindling Int'l., Corp. v. Kobi Katz, Inc., 56 U.S.P.Q.2d 1763 (S.D.N.Y. 2000). In upholding the Office's decision to register the Kobi Katz ring in question, the Weindling court looked at several factors including the design options available to the designer and whether the designer's choices were dictated by function alone or also by design considerations. The Court concluded that the diamond bridge ring there contained a sufficient amount of originality in the "unique combination and arrangement of otherwise uncopyrightable elements." Id. at 1766. You have argued that application of the Weindling court's factors to Ms. Wong's jewelry would result in a finding that, like the ring in Weindling, her necklace designs meet the minimum threshold of creativity and deserve copyright protection. You have also stated that the necklace designs in question here do not have familiar shapes or minor variations of familiar shapes, but, rather, their overall combination of elements has a distinctiveness that distinguishes her work from others. Letter from Richter of 11/24/03, at 2. Again, we agree that an original combination of elements, each of which individually is unoriginal, may be copyrightable if that combination as an entirety meets the minimal standards of creativity. However, we do not find more than *de minimis* creativity in the particular combination of elements presented here. *Cf.*, Compendium II, § 503.02(a) ("simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations" not copyrightable); § 503.02(b)("mere bringing together of two or three standard forms or shapes with minor linear or spatial variations" not copyrightable).

Moreover, while we recognize that some courts addressing copyrightability speak in terms such as the "look and feel" of a work, we can ascertain no standard by which the Office can be expected to judge originality and creativity based upon a work's "feel." *See* Nimmer on Copyright §13.03[A][1][c] (criticizing the use of "feel" as an "amorphous referent" that "invites an abdication of judicial analysis"). Invoking a work's "feel" is no substitute for articulating an objective analysis of the work's original and creative elements. Indeed, Weindling, the case you cite for the proposition that copyright may be based on "overall distinctive feel," [Letter from Richter of 5/17/04, at 5], 56 U.S.P.Q.2d at 1765, did not simply accept the proposition that the work in question was copyrightable on that basis. The court referred to "overall distinctive feel"

in its characterization of Kobi Katz's assertion of the basis for copyrightability. Id. However, the court ultimately analyzed the various aspects of the jewelry design in question as part of its analysis of copyrightability. Id. at 1765-77.

Other courts have upheld the Copyright Office's application of the creativity standard and, for reasons similar to the Board's view in this case, determined that a number of works that were based on simple arrangements of common shapes or symbols do not warrant copyright protection. In Jon Woods Fashions v. Currant, 8 U.S.P.Q. 2d 1870 (S.D.N.Y. 1988), the work at issue was a fabric design called "Awning Grids" that superimposed a grid of squares over cloth with two inch stripes. The plaintiff claimed that the combination of the stripes and grids created a design that was "enough" of the author's identity to be both original and creative. The court responded to this argument by restating the Register's position that works lacking the minimal amount of creative authorship include those which consist of "familiar designs or symbols" or a "simple combination of two or three standard symbols such as a circle, a star, or a triangle with minor linear variations." Id. at 1872. Therefore, the design elements at issue were not proper subjects for copyright protection even when they are "distinctively arranged or printed." Id. In John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986), *a* logo for a soccer team consisting of four angled lines which formed an arrow, and the word "Arrows" written below in cursive script, was denied copyrightability because it lacked the minimal amount of creativity necessary for copyright protection–even prior to the clear, and confirming, articulation of the principle in Feist.

Thus, courts have found that a few common shapes or symbols combined in a simple design failed to exhibit the level of creativity necessary to be copyrightable. Based on similar reasoning, the Board finds that Applicant's jewelry designs lack the requisite level of creativity to be copyrightable.

C. The Necklace Designs Represent *De Minimis* Authorship

Notwithstanding Ms. Wong's statement attached to your first request for reconsideration [Letter from Richter of 11/24/03], both necklace designs at issue here are minor variations of a common jewelry design, i.e., a simple chain with beads attached. *See above, at 2*, for description of works. As we have explained, *above at 11*, the Office considers a work in its entirety. Our examination of the works in question does not focus on individual design elements, each judged on its own merits. Rather, our examination of the necklaces approaches the necklaces each in its entirety. You cite Boisson v. Banian, Ltd., 273 F.3d 262 (2d Cir. 2001) among the cases referred to for the proposition that a combination or arrangement of unprotectible elements may qualify for copyright protection. Letter from Richter of 5/17/04, at 4. This principle is, indeed, among those which guides the examiner staff in its consideration of works submitted for registration: several registrations were made for the quilts as issue in Boisson with their arrangement of alphabet blocks evidencing the level of "some minimum degree of creativity" which the court found to be required by Feist. 273 F.3d at 269.

The principle does not, of course, mean that all combinations and arrangements of commonplace, simple, or unprotected-in-themselves elements will rise to the level of copyrightable authorship. In Satava v. Lowry, the Ninth Circuit held unprotectible sculptural arrangements which combined elements not copyrightable in themselves. 323 F.3d 805 (9th Cir. 2003). The court explained that not "any combination of unprotectable elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship." 323 F.3d at 811. The necklaces at issue here exhibit the standard, rounded shape of a necklace, with portions of the underlying necklace chain covered by clustered beads. On one necklace, a portion of the simple chain is covered by the clustered beads and also has only individual, sequential beads of a different color along the rest of the chain. Another necklace exhibits the underlying chain which comes to an knot from which a lariat-shape chain hangs and the hanging lariat chain portions are covered, in part, by the clustered beads, ending in one larger bead on each prong of the lariat. The Board finds that each work, consisting of very few elements, each not protectible in itself, and arranged in a commonplace manner, lacks the required minimal creativity.

D. Examples of Other Works Which Have Been Registered

You have also provided examples of other jewelry that you allege are registered with the Copyright Office. The Office's examination procedure for copyrightability does not include a comparison with other works–whether those works have been registered or have been refused registration. This differs from the other administrative areas of intellectual property law of patents and trademarks. Originality in copyright law does not include a requirement for comparison to prior works. We cite Compendium II, § 108.03, that the Office does not generally make comparisons of copyright deposits to determine whether or not particular material has already been registered. The Copyright Office does not base its decisions regarding copyrightability on comparisons with other works. Each individual work of authorship is considered on its own merits, i.e., the particular expression of authorship, viewed as a whole; this examination is made without regard to any other specific work.

In your statements concerning works which have been previously published, you point out that some of the registrations have been for well-known designers such as Paloma Picasso and Elsa Peretti. Letter from Richter of 5/17/04, at 6. If you meant to imply that the Office wrongly refused to register the necklace designs at issue here because of a subjective assessment of the Julie Wong necklaces' value or importance, that is not the case. On the contrary, Copyright Office examination procedures do not evaluate the aesthetic or the commercial merits of works. Compendium II, § 503.02(a), *above at 10 - 11*, instructs examiners that the aesthetic, commercial or symbolic merit of a work is not relevant to an examination for originality. A work may be highly valued for its aesthetic appeal or for its artistic merit and, yet, not be copyrightable, and *vice versa*.

In a motion for a new trial, the plaintiff in Paul Morelli Design, Inc. v. Tiffany and Co., 200 F. Supp. 2d 482 (E.D. Pa. 2002), argued that a jury instruction which refused to instruct the jury to take the commercial success of the jewelry in question into its considerations was erroneous. The court responded by stating that the court had "properly charged 'attractiveness, commercial success and substantial efforts are not factors to be considered in deciding whether a work is original.'" 200 F. Supp. 2d at 487. The court then cited the hallmark case Bleistein in remarking that Justice Holmes in the Bleistein case was "reminding the reader that copyright protection is available to the mundane as well as to works that would find their way into... libraries of the erudite." The district court did not interpret Justice Holmes's opinion to mean that "commercial success is an element of originality." 200 F. Supp. 2d at 488. Nor is evidence of a third party's assessment of the worth or value of a work relevant to the determination of a work's copyrightability. Further, Feist expressly rejected the "sweat of the brow" or "industrious collection" doctrine, that made copyright protection a "reward for the hard work," effort, or expertise that went into producing a work. 499 U.S. at 352. Again, Morelli, interpreting Feist, opines that neither sweat of the brow nor commercial success "has anything to do with whether an author's work is original." 200 F. Supp. 2d at 488. *See also* Homer Laughlin China Co. v. Oman, 22 U.S.P.Q.2d 1074, 1076 (rejecting commercial success as relevant).

In conclusion, registration is denied because the expression of the authorship in Applicant's necklace designs is *de minimis*. The works consist of minor variations on basic shapes and commonplace necklace design configurations and fail to exhibit the modicum of creativity required by Feist. For the reasons stated in this letter, the Copyright Office Review Board affirms the Examining Division's refusal to register the claims. This decision constitutes final agency action in this matter.

The samples and catalogs which you have sent for use by the Board during the second reconsideration stage will be separately returned to you via the FEDEX number you have supplied.

Sincerely,

/S/

Nanette Petruzzelli
Special Legal Advisor for Reengineering
for the Review Board
United States Copyright Office