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February 18, 2005

Jay H. Begler, Esq.
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140 Broadway, 35th Floor
New York, NY 10005-1101

Re: SIRENA COLLECTION SINGLE STONE RING - A1705/R5
Copyright Office Control Number: 61-214-7134(B)
Your reference number: 46214-000001

Dear Mr. Begler:

I write on behalf of the Copyright Office Board of Appeals [now, Review Board] in response to your second appeal dated January 21, 2004 requesting reconsideration of a refusal to register a jewelry design entitled "Sirena Collection Single Stone Ring - A1705/R5." The Board has carefully examined the application, the deposit and all correspondence concerning this application, and affirms the denial of registration of this work.

I. DESCRIPTION OF WORK

The subject ring is a circular gold-toned band, featuring a single, clear, round-cut stone set on top of the ring's outside plane. Two diagonal, rectangular strips of silver-toned metal flank the stone. Two arcs of silver-toned metal surround the base of the stone and appear to connect to the diagonal strips.



II. ADMINISTRATIVE RECORD

A. Initial Application and Office's Refusal to Register

On January 21, 2003, the Copyright Office received a Form VA application from Ms. Sandra L. Day of your firm on behalf of your client, Merit Diamond Corporation, to register a jewelry design for a finger ring.[1] In a letter dated April 10, 2003, Visual Arts Section Examiner Wilbur King refused registration of this work because he concluded that the ring design lacks the authorship necessary to support a copyright claim. Letter from King to Day of 4/10/2003 at 1.

Mr. King explained that the copyright law only protects works that are independently created and possess at least a minimal degree of creativity within the meaning of the Copyright Act and settled case law. He explained that copyright protection does not apply to familiar symbols or designs, basic geometric shapes, coloring or ideas. He further noted that neither the aesthetic appeal nor the amount of time and effort expended to create a work are factors to be considered in determining copyrightability. Mr. King concluded that the subject ring does not embody a sufficient amount of creative authorship to satisfy the standard for copyright registration. *Id.*

B. First Request for Reconsideration

In a letter dated July 10, 2003, you requested reconsideration of the Office's refusal to register the subject ring. You described the work as "a ring element, the second layer set on top of the ring with oval shapes at each end, to horizontal layers on top of the second layer, placed on a bias, slightly over the diamond or stone." Letter from Begler to Chief Receiving and Processing Division of 7/10/2003 at 1. Citing the relatively low threshold for creativity articulated in *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991), you argued that the creativity embodied in the ring's unique and artistic configuration fulfills the requirements set out in *Feist*. Letter from Beger of 7/10/2003 at 1 - 2. You also quoted *Weindling Int'l Corp. v. Kobi Katz, Inc.*, 56 U.S.P.Q.2d 1763 (S.D.N.Y. 2000), in which the court upheld the copyrightability of a ring composed of arguably familiar design elements. You argued that the ring at issue in the present appeal surpasses the originality standard utilized in *Kobi Katz*. Letter from Begler of 7/10/2003 at 2 - 3.

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[1] Although the application fails to state how the listed claimant Merit Diamond Corporation purportedly obtained ownership of the copyright from the listed author Gagi Kaplan, this defect does not form the basis of the Office's present rejection of this application.

In response to your request and in light of the points raised in your letter of July 10, 2003, Attorney Advisor Virginia Giroux of the Examining Division reexamined the application. She too determined that the subject jewelry design does not contain a sufficient amount of original and creative sculptural authorship upon which to support a copyright registration. Letter from Giroux to Begler of 9/12/2003 at 1. Ms. Giroux explained that in order to be copyrightable, a work must not only be original, but it must also possess more than a *de minimis* quantum of creativity. *Id.*, citing *Feist*, 499 U.S. at 345. While this threshold is very low, she explained that not all independent efforts will qualify, as in the case of the subject work. *Id.* at 2 - 3. She cited *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951) in further support of the proposition that, specifically with respect to jewelry designs, sufficient authorship must constitute more than a trivial variation of public domain elements. Ms. Giroux noted that the requisite creativity can arise from a work's constituent elements alone or from the combination thereof. Letter from Giroux of 9/12/2003 at 1.

After describing the subject ring, Ms. Giroux concluded that the type of sculptural authorship embodied in this work (rectangles, oval or arc shapes and gemstones) does not reflect sufficient originality and creativity to support a copyright registration. Even, taken as a whole, the arrangement of the metal elements coupled with the stone do not demonstrate the originality and creativity necessary to sustain a copyright registration. The resulting design is *de minimis* involving public domain elements combined and arranged in a rather simple configuration. Letter from Giroux of 9/12/2003 at 2, citing 37 C.F.R. 202.1 (2003) and *Compendium II: Compendium of Copyright Office Practices,* section 503.02(b) (1984) ("*Compendium II*"). She also cited several cases to support the proposition that although simple variations of standard designs and their simple arrangements may be aesthetically pleasing, they do not furnish a basis upon which to support a copyright registration. *Id.* at 2, citing *John Muller & Co. v. New York Arrows Soccer Team, Inc.*, 802 F.2d 989 (8th Cir. 1986), *Forstmann Woolen Co. v. J.W. Mays,* Inc., 89 F. Supp. 964 (E.D.N.Y. 1950), *Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q. 1074 (D.D.C. 1991), *Jon Woods Fashions, Inc. v. Curran*, 8 U.S.P.Q.2d 1870 (S.D.N.Y. 1988) and *DBC of New York, Inc. v. Merit Diamond Corp.*, 768 F. Supp. 414 (S.D.N.Y. 1991)). She distinguished your citation to *Kobi Katz*, since that case involved "the combination and arrangement of the components as embodied in this work [which], as a whole, contained a sufficient amount of original and creative jewelry design authorship consistent with the standards set forth in the *Feist* case to support a copyright registration." Letter from Giroux of 9/12/2003 at 3.

Ms. Giroux also explained that in determining copyrightability, the Office does not consider the materials of which a work is made (*e.g.*, white gold, yellow gold, rhodium or gemstones), the work's aesthetics, attractiveness, uniqueness, visual effect, impression or commercial success, nor the time and effort expended in creating the work or the availability of alternative design choices. *Id.* at 1, 3 - 4. She summarized her position by stating

"[b]ecause there are no artistic or sculptural elements or features in this work, either alone or in combination, upon which a copyright registration is possible, we regret that we must again refuse copyright registration for this particular work." *Id.* at 4.

C. Second Request for Reconsideration

In your present appeal dated January 21, 2004, you request the Office to reconsider for a second time its refusal to register the copyright claim in the Sirena Collection Single Stone Ring jewelry design. Letter from Begler to Board of Appeals of 1/21/04 at 1. In describing the work, you note the following: the ring has a specific width and shape; a second layer on top of the ring has an elliptical[2] shape with two vertical layers placed on a bias which abut the diamond; the manner in which the stone sits in its carriage and its dimensional relationship to the carriage and this is a tailored element; and the elements give rise to a "unique artistic configuration." *Id.* You state that the applicant seeks registration for the totality of the ring, not its individual elements or the gemstone. *Id.* You argue that the choices, tailoring and placement of the elements "required a serious creative effort," and rise to the minimum standard of creativity articulated in *Feist*. *Id.* at 1 - 2.

Citing *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), you emphasize the relatively low standard of originality necessary to sustain a copyright registration, and warn that arbiters should not weigh the artistic merits of a work. *Id.* at 2. You reiterate several arguments from your prior appeal: the facts in *Feist* differ significantly from the facts presently at issue; the designer independently created the ring in question; and the subject ring is comparable to the ring at issue in *Kobi Katz* for which the court upheld the copyright registration. *Id.* at 2 - 4. You also cite five other cases in which an arguably low level of creativity embodied in each of the subject works was sufficient to sustain a copyright registration. *Id.* at 4. Finally, you argue that the cases cited by Ms. Giroux are not dispositive because the courts considered only whether to uphold the Office's refusal to register a work under a clearly erroneous standard, as opposed to conducting a *de novo* analysis of the work's originality. *Id.*

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[2] Although you use the term "epilate" shape, the Board presumes you mean elliptical.

III. DECISION

A. The Legal Framework

1. Copyrightable Subject Matter

Jewelry designs can be copyrighted as "pictorial, graphic, and sculptural works." 17 U.S.C. 102(a)(5); *Compendium II, supra,* section 502. However, the fact that some jewelry designs can qualify for copyright protection does not mean that all jewelry designs necessarily will.

All copyrightable works, be they jewelry designs or otherwise, must also qualify as "original works of authorship." 17 U.S.C. 102(a). As used with respect to copyright, the term "original" consists of two components: independent creation and sufficient creativity. *Feist*, 499 U.S. at 345. First, the work must have been independently created by the author, *i.e.*, not copied from another work. You state, "The design under consideration was created solely by the Applicant, and not copied from a third party." Letter from Begler of 7/10/2003 at 1; *see also*, letter from Begler of 1/21/2004 at 3 ("It should be stressed that the ring in question was independently created.") The Board accepts these statements at face value, and has no reason to doubt their validity. Therefore, the first component of the term "original" is not at issue in the analysis set forth herein. The second *Feist* requirement is that a work must possess sufficient creativity. Although the Board recognizes your point that *Feist* did not specifically address the copyrightability of jewelry designs, (Letter from Begler of 7/10/2003 at 1, Letter from Begler of 1/21/2004 at 2), *Feist*'s holding regarding the statutory originality requirement applies generally to any copyrightability analysis, regardless of the form or authorship content of the work. For the reasons set forth below, the Board has determined that the subject jewelry design fails to embody the requisite amount of creativity, and therefore it is not entitled to a copyright registration.

2. The Creativity Threshold

In determining whether a work embodies a sufficient amount of creativity to sustain a copyright claim, the Board adheres to the standard set forth in *Feist*, 499 U.S. at 345, where the Supreme Court held that only a modicum of creativity is necessary to support a copyright. You properly quote the Court for the proposition that the "requisite level of creativity is extremely low; even a slight amount will suffice." Letter from Begler of 7/10/2003 at 2; Letter from Begler of 1/21/2004 at 3, quoting *Feist*, 499 U.S. at 345. You cite several other cases as further support that works containing even a small amount of creative expression can sustain a copyright registration. Letter from Begler of 1/21/2004 at 4. The Board agrees with the general legal principle you have asserted, as evidenced by the fact that

in all of those cases, the Office did indeed register the works even though the works embodied relatively low levels of copyrightable expression.[3]

However, the *Feist* Court also ruled that some works (such as the work at issue in that case) fail to meet the standard. The Court observed that "[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity," 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; *see also,* 37 C.F.R. 202.10(a) ("In order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form."); 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* 2.01(b) (2002) ("[T]here remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright.").

The Office's long-standing registration practices, in existence prior to *Feist*, recognized the modest, but existent, requisite level of creativity necessary to sustain a copyright claim. *Compendium II* states, "Works that lack even a certain minimum amount of original authorship are not copyrightable." *Compendium II*, section 202.02(a). With respect to pictorial, graphic and sculptural works, the class within which jewelry designs fall, *Compendium II* states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." *Id.,* section 503.02(a).

In implementing this threshold for creativity, the Office and courts have consistently found that standard designs, figures and geometric shapes are not sufficiently creative to sustain a copyright claim. *Compendium II*, section 503.02(a) ("[R]egistration cannot be based upon the simplicity of standard ornamentation . . . . Similarly, it is not possible to copyright common geometric figures or shapes . . . ."); *Id.* section 202.02(j) ("Familiar symbols or designs . . . or coloring, are not copyrightable."); *Id.* section 503.03(b) ("No registration is possible where the work consists solely of elements which are incapable of supporting a copyright claim. Uncopyrightable elements include common geometric figures or symbols, such as a hexagon, an arrow, or a five-pointed star . . . ."). *See also,* 37 C.F.R. 202.1(a) ("[F]amiliar symbols or designs" are "not subject to copyright and applications for registration of such works cannot be entertained."). Moreover, simply making minor alterations to these otherwise standard shapes will not inject the requisite level of creativity. *Catalda*, 191 F.2d at 102 - 03 (What "is needed to satisfy both the Constitution and the

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[3] Three of these cases specifically state that the plaintiff had obtained a copyright registration for the subject work. The same can be inferred from the other two copyright infringement cases, because 17 U.S.C. 411 requires copyright registration as a prerequisite to filing an infringement suit. Neither court addresses the limited exception to this rule, which they undoubtedly would have done if the exception had been applicable.

statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'"); again, *Compendium II*, section 503.02(a) ("[Registration cannot be based upon] a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations.").

As evidenced by both Ms. Giroux's and your own descriptions of the subject work, the ring at issue is comprised of common shapes: a circular band, a round stone and two metallic rectangles and arcs. You appropriately concede that the applicant does not seek registration of these public domain elements. Letter from Begler of 1/21/2004 at 1. Therefore, the copyrightability of the individual constituent elements is not at issue here.

3. Selection, Coordination and Arrangement

The Board agrees with your assertion that some combinations of common or standard shapes contain sufficient creativity with respect to how the common elements are combined or arranged to support a copyright. *See, Feist*, 499 U.S. at 358 (the Copyright Act "implies that some 'ways' [of compiling or arranging uncopyrightable material] will trigger copyright, but that others will not"; determination of copyright rests on creativity of coordination or arrangement); Letter from Begler of 1/21/2004 at 1.

However, merely combining non-protectible elements does not automatically establish creativity where the combination or arrangement itself is simplistic or minor in its overall configuration. For example, in *Jon Woods Fashions*, 8 U.S.P.Q. 2d at 1870, the district court upheld the Register's decision that a fabric design consisting of striped cloth over which a grid of 3/16" squares was superimposed, even though distinctly arranged and printed, did not contain the minimal amount of original artistic material to merit copyright protection. Similarly, the Eighth Circuit upheld the Register's refusal to register a simple logo consisting of four angled lines which formed an arrow and the word "Arrows" in cursive script below the arrow. *John Muller & Co.*, 802 F.2d at 990. Similar to these cases, the Board has determined that the Sirena Collection Single Stone Ring does not embody the requisite level of creativity with respect to the combination of its constituent elements, the reasoning of which is set forth below in more detail.

We note that you argue that these cases as cited by Ms. Giroux are not dispositive because the courts considered only whether to uphold the Office's refusal to register a work under a clearly erroneous standard, as opposed to conducting a *de novo* analysis of the work's originality. Letter from Begler of 1/21/2004 at 4. That these courts upheld the Office's determinations is not simply a factor of the standard of review, but demonstrates the efficacy of the Office's careful consideration of each work as part of the registration procedure. Even under this standard of review, the courts do have the power to invalidate a copyright if

appropriate. *See, e.g., Fortsmann Woolen Co.*, 89 F. Supp. at 971. However, the courts chose not to in the cited cases, demonstrating that the Office's analysis was reasonable and not arbitrary. It is also reasonable for the Office to apply the same criteria in evaluating and rejecting the present application as it did in evaluating and rejecting the applications at issue in the cited cases.

B. Analysis of the Work

The constituent elements of the subject jewelry design are standard shapes which are within the public domain and not copyrightable in and of themselves. Therefore, the only means by which the various non-protectible elements in the finger ring could possibly sustain a copyright would be if their particular combination or arrangement exhibited a sufficient level of creativity. In the Board's view, they do not.

The single stone is mounted on top of the ring's shank, where solitaire stones are traditionally set. Two identical, diagonal, rectangular strips of metal flank the stone. The two silver arcs are also symmetrically placed on the top and bottom of the stone.[4] This traditional and symmetrical placement of public domain adornments is simply not sufficiently creative within the meaning of the copyright law. The fact that the rectangles and arcs are a different color than the shank is immaterial. "[M]ere coloration cannot support a copyright even though it may enhance the aesthetic appeal or commercial value of a work." *Compendium II,* section 503.02(a). Furthermore, it is a somewhat common jewelry design to use one type of metal for a ring's shank and another metal, often matching or coordinating with any gemstones, for the gemstones' settings. The totality of this simplistic combination of public domain elements, even with the layering effect that results from such combination, is not sufficiently creative to support a copyright registration.

You make the assertion that "the tailoring of the specific design elements and the placement in relationship to each other certainly meets the minimum standard of *Feist.*" Letter from Begler of 1/21/2004 at 1. However, "[t]he creative expression capable of supporting copyright must consist of something more than the mere bringing together of two or three standard forms or shapes with minor linear or spatial variations." *Compendium II,* section 503.02(b). You also argue that the finger ring has "specific width and shape." Letter from Begler of 1/21/2004 at 1. The fact that a ring has a specific width and shape, which is of

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[4] It is unclear whether these arcs also serve the functional purpose of holding the stone onto the ring's shank. As a useful article, any functional component would be barred from copyright registration absent any separable authorship. It is unnecessary to address this concept in detail, however, both because you have not raised any functionality argument in your appeal and because the work's lack of sufficient creativity forms an independent basis for the Board's rejection of the application.

course true of any fixed object, does not mean that such width and shape embodies sufficient creativity to support a copyright registration. As *Compendium II* states, minor spacial variations do not give rise the necessary amount of creativity to support a copyright registration. Furthermore, as Ms. Giroux explained, the number of other possible design choices, *e.g.,* other widths and shapes, is not relevant to the copyrightability analysis for this specific jewelry piece. Letter from Giroux of 9/12/2003 at 4. The Office considers only those authorship elements actually present in the deposit materials submitted with the application for registration, not those that could have been selected.

You extensively quote *Kobi Katz*, 56 U.S.P.Q.2d 1763, for the proposition that copyright can protect a combination of arguably familiar design elements. Letter from Begler of 7/10/2003 at 2 - 3; Letter from Begler of 1/21/2004 at 3 - 4. Again, the Office agrees with the general proposition, as evidenced by the fact that the Office issued a copyright registration for the ring design at issue in that case. However, the Office must independently evaluate each work submitted for registration to determine if it meets the minimal, but existent, statutory requirements. With respect to the jewelry design in *Kobi Katz*, the ring's overall arrangement of public domain elements, including various shaped stones, suspended "bridge" placement and flared supports, was sufficiently creative to support a copyright. With respect to the finger ring presently at issue, though, the symmetrical placement of one stone, two rectangles and two arcs on the top, center of a ring is simply not sufficiently creative to support a copyright registration.

C. Other Considerations

Several other factors that you argue, while perhaps important on personal or commercial levels, have no bearing on the determination of whether or not copyright registration is available for this work. For example, you refer to the ring's "unique" configuration and appearance. Letter from Begler of 7/10/2003 at 1, 3; Letter from Begler of 1/21/2004 at 1 - 2. Uniqueness is material to a patent analysis, not to a copyrightability analysis. As is well-settled, two identical works may both be registered for copyright protection, provided that each was independently created and contains the requisite level of creativity. You submit that "uniqueness is reflective of originality and creativity." Letter from Begler of 1/21/2004 at 2. While uniqueness may indeed in some cases be a by-product of originality and creativity, it is neither necessary nor sufficient in itself to support a copyright registration.

You also state that the relationship of the ring's elements gives rise to a "different aesthetic appeal." Letter from Begler of 1/21/2004 at 1. Again, while this statement may well be true, aesthetic value of a work cannot be considered in determining whether a work is copyrightable. *Compendium II*, section 503.02(b) ("The requisite minimal amount of original

sculptural authorship necessary for registration in Class VA does not depend upon the aesthetic merit, commercial appeal, or symbolic value of a work.") You appropriately cite the *Bleistein* Court for this very proposition. Letter from Begler of 1/21/2004 at 2.

Finally, you argue that the ring is the result of "serious creative effort." Letter from Begler of 1/21/2004 at 2. The Board does not dispute your client's effort, but can only evaluate your client's actual *authorship expression* embodied in the ring. As you have noted, *Feist* clarified that the effort expended in creating a work (*i.e.* the "sweat of the brow") is simply not relevant to whether the work can support a copyright registration. Letter from Begler of 1/21/2004 at 2, citing 499 U.S. at 359-60.

IV. CONCLUSION

For the reasons stated herein, the Copyright Office Review Board affirms the Examining Division's refusal to register the jewelry design entitled "Sirena Collection Single Stone Ring - A1705/R5." This decision constitutes final agency action in this matter.

Sincerely,

/S/

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