FILE COPY

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

February 14, 2005

Theodore C. Max, Esq.
Mintz Levin Cohn Ferris
Glovsky and Popeo PC
Chrysler Center
666 Third Avenue
New York, New York 10017

Re: **D1728N Organdie Necklace With Diamonds**
D1480BS Renaissance Bracelet With Diamonds
D1453R Black Lace Floral Diamond Ring and
D1660R Black Lace Floral Diamond Ring
Copyright Office Control No. 61-206-5437 (M)

Dear Mr. Max:

On behalf of the Copyright Office Board of Appeals [now, Review Board], I am responding to your request for reconsideration of the Examining Division's refusal to register the jewelry designs listed above. The Review Board has carefully examined the applications, the deposits, including the supplementary photographic enlargements of the works, and all the correspondence in this case. After careful consideration of the arguments in your letter, the Board affirms the denial of registration of these jewelry designs.

I. ADMINISTRATIVE RECORD

A. Initial submissions

On March 14, 2002, the Copyright Office received from you applications, identifying material, and fees to register the four jewelry designs named above on behalf of Dorera Limited LLC. By letter dated August 20, 2002, Visual Arts Examiner Joy Mansfield refused registration for these works, stating that they lack the required artistic or sculptural authorship necessary to support a copyright claim. Ms. Mansfield noted that a certain minimum of authorship was necessary under statutory and settled case law, citing *Feist Publications v. Rural Telephone Service Co.,* 499 U.S. 340 (1991). She also noted the absence of protection for ideas, concepts and familiar symbols and shapes as well as minor variations thereof, citing 17 U.S.C. 102(b) and 37 C.F.R. 202.1. She then informed you that the applications were being filed without action. (Letter from Mansfield to Max of 8/20/2002.)

B. First request for reconsideration

By letter dated December 18, 2002, you appealed to the Examining Division Ms. Mansfield's refusal to register these works and urged their registration at the Division level. You cited *Feist* for the proposition that the standard of registration of copyright is very low, and you acknowledged the dual originality requirements of independent creation and a certain minimum level of creativity. In further support of registration, you asserted that a number of jewelry cases, including *PPS v. Jewelry Sales Representatives, Inc.* 392 F.Supp. 375 (S.D.N.Y. 1975) and *Trifari Krussman & Fishel v. Charel*, 134 F.Supp. 551 (S.D.N.Y. 1955), establish the copyrightability of these designs. You point out that *Yurman Design Inc. v. PAJ*, 262 F. 3d 101 (2d Cir. 2001) and *Weindling International Corporation v. Kobi Katz, Inc.*, 2000 WL 1458788 *4 (S.D.N.Y. Sept. 29, 2000) demonstrate that even where the constituent elements are simple and unoriginal, the way a work is recast and combined may result in original copyrightable jewelry designs. (Letter from Max to Examining Division of 12/18/2002 at 2 - 3.) You compare the originality of Ms. Ong's [employee of Dorera] design with the fabric design in *Soptra Fabrics Corp. v. Stafford Knitting Mills Inc.*, 490 F. 2d 1092 (2d Cir. 1964), and note that just because a work is composed of public domain elements, that alone will not disqualify a work for copyright protection, citing, *inter alia*, *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C. Cir. 1992).

On August 20, 2003, Ms. Virginia Giroux, for the Examining Division, responded to your first appeal for reconsideration of the Visual Arts Section's refusal to register. After reexamination of the works, Ms. Giroux again refused to register these jewelry designs on the ground that they did not contain an amount of original and creative artistic or sculptural authorship sufficient to justify copyright registration. (Letter from Giroux to Max of 8/20/2003 at 1.) She noted no dispute between you and the Office that, as a category, works of art may be registrable. However, in her view, the necessary minimal level of copyrightable content had not been met by these particular works. Ms. Giroux noted that the Examining Division applies the standard of examination that determines whether a work contains elements, either alone or in combination, on which a copyright can be based. (Letter from Giroux of 8/20/2003 at 1.) She then proceeded to describe and analyze the content of these works, coming to the conclusion that they still did not rise to the level of creativity necessary to sustain a copyright registration. She found that, according to the *Compendium of Copyright Office Practices, Compendium II*, sections 503.02(a) and (b) (1984), these designs were *de minimis* arrangements in a rather simple and repetitive configuration. (Letter from Giroux of 8/20/2003 at 2.)

Ms. Giroux pointed out the *Compendium*'s principles regarding noncopyrightability of simple geometric or other familiar designs, confirmed in numerous cases, and referred

particularly to *John Muller & Co. v. New York Arrows Soccer Team*, 802 F.2d 989 (8th Cir. 1986); *DBC of New York, Inc. v. Merit Diamond Corp,* 768 F.Supp. 414 (S.D.N.Y. 1991); *Homer Laughlin China Co., v. Oman,* 22 U.S.P.Q. 2d 1074 (D.D.C. 1991); and *Jon Woods Fashions Inc. v. Curran,* 8 U.S.P.Q. 2d 1870 (S.D.N.Y. 1988). She agreed with your assertions regarding *Feist* that the amount of creativity necessary for copyright is very low, but she also found that "neither the diamond elements nor their combination in the arrangement as embodied in these works meet even the low threshold for copyrightable authorship set forth in *Feist.*" (Letter from Giroux of 8/20/2003 at 3.) Regarding the authorship present in the *Yurman* case, Ms. Giroux further gave the opinion that the authorship described in the *Yurman* works was of greater complexity than the works at issue here. She further noted that the complexity and detail in the works described in *Soptra Fabrics* made them more than a trivial variation of a theme but a selection or arrangement in a creative manner. In comparing the creativity standard articulated by the courts with the instant works, however, Ms. Giroux concluded that the design elements chosen here did not contain – individually or in combination – enough creative authorship to be registered for copyright. (Letter from Giroux 8/20/2003 at 4 - 5.)

C. Second request for reconsideration

In a letter dated December 22, 2003, you appealed for reconsideration to this Board, again submitting that the rejection of these works for registration was erroneous. You assert that under copyright law, the designs' selected elements in combination with various other original elements make the overall works protectible. (Letter from Max to Board of Appeals of 12/22/2003 at 2.) You call attention to language in *Feist* that the requisite level of creativity is low and the vast amount of works possess the necessary creative spark for registrability. 499 U.S. at 345. Although you acknowledge that novelty is not necessary for registrability, in describing the content of the jewelry you note that the Organdie Necklace with Diamonds is a unique and novel sculptural design that may have been inspired by... "dew [on a spider web in morning sunlight," but note that the "selection, placement, spacing and size of diamonds between the linkages" merits copyright registration. (Letter from Max of 12/22/2003 at 2.) You also submit a photocopy of a previous registration granted to a comparable design – an Organdie Necklace registered on February 28, 2002, as VA 1-114-067, *Id., Exhibit C.*

You also note that the ring designs at issue here are superimposed on a lace design and that lace designs are protectible under the copyright act. You state that the design for the Renaissance Bracelet "[gives] the impression and appearance of movement." (Letter from Max of 12/22/2003 at 3.) In response to Ms. Giroux's observation that these works contain common geometric symbols, you again point to the decision in *Soptra Fabrics* as

an indication that the quantum of originality required for designs is not very high, for in that case, a fabric design was of common symbols in repeat, embellished or expanded to cover an unsightly joint. You again cite the *Atari* opinion, emphasizing that the combination, selection, arrangement and sculptural interweaving of various design elements created by the gemstones in use in the jewelry designs at issue allow for registration. (Letter from Max of 12/22/2003 at 4.) You further argue that depiction of a common symbol does not in and of itself disqualify a work for copyright protection and that the placement of geometric shapes in a style or design which is not trivial in its overall configuration also allows for copyright protection; you partly rely on the holdings in *North Coast Industries v. Jason Maxwell, Inc.*, 972 F.2d 1031 (9th Cir. 1992), and *Weindling Int'l Corp. v. Kobi Katz*, Inc., 2000 WL 1458788 at *4 (S.D.N.Y. Sept. 29, 2000) (Letter from Max of 12/22/2003 at 4.) You also point out that *Yurman* confirms that the designs at issue here are entitled to registration because they are artistic interpretations of commonplace designs, shapes, or geometric forms. (Letter from Max of 12/22/2003 at 5.)

II. DECISION

A. Description of the works

Before proceeding with our discussion of the works, we describe the jewelry designs included in your submission of March 14, 2002 to this Office. We also include below reproductions of the identifying material you submitted as deposits.

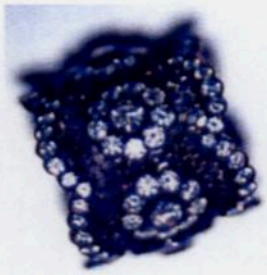
1. *D1728N Organdie Necklace with Diamonds.* This necklace consists of six rows of an open crisscross lattice-work pattern creating a series of horizontal and vertical open-diamond shapes. The top border is scalloped; larger diamonds are placed at each cross-section within the lattice, and larger diamond pendants hang from the scalloped lower border.



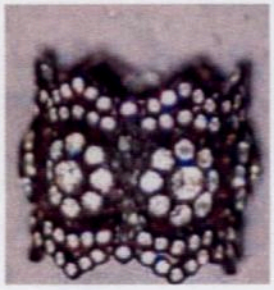
2. *D 1480 BS Renaissance Bracelet with Diamonds:* In this bracelet, seven rows of single round diamonds are connected horizontally and vertically by alternating the placement of the horizontal rows so that a diamond on a succeeding row will fall between two diamonds on the row above.



3. *D1453R Black Lace Floral Diamond Ring.* This ring contains a repeated pattern of eight smaller diamonds surrounding a larger circular diamond resembling the innermost circles of a target symbol with a semicircular curve at the top and bottom of each symbol. These figures are placed equidistantly on the ring made of black circular fishnet ("lace").



4. *D 1660R Black Lace Floral Diamond Ring.* This similar ring contains the same equidistantly repeated target pattern of eight smaller diamonds around a larger diamond on a background of black circular "lace." The semicircular curves at top and bottom are bordered by an arched edge.



B. The *Feist* standard

The Copyright Office applies the *Feist* standard when it considers whether authorship is registrable, that is, whether it is original. *Feist Publications, Inc. v. Rural Telephone Service Co.,* 499 U.S. 340, 347 (1991). The fundamental basis of copyright protection is a work's originality. Although both independent creation and a certain minimum amount of creativity are components of originality, we assume the independent creation prong has been met and focus on the second prong of the *Feist* standard. As both you and Ms. Giroux have already noted, the requisite quantum of creativity necessary is very low. (Letter from Max of 12/22/2003 at 1 - 2.) However, the Supreme Court has stated that there can be no copyright in works in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Feist,* 499 U.S. at 359. *See also Diamond Direct LLC v. Star Diamond Group, Inc.,* 116 F.Supp. 2d 525, 528 (S.D.N.Y. 2000) ("So the level of creativity necessary to support copyright is modest indeed. While no precise verbal formulation can capture it, there is some irreducible minimum beneath which a work is insufficiently original to find protection."). And, a work that reflects an obvious arrangement fails to meet the low standard of minimum creativity required for copyrightability. *Feist,* 499 U.S. at 362-63. Indeed, the work before the Court in *Feist* purported to be a copyrightable combination of elements, but failed to meet the necessary quantum of creative authorship, and was instead found to be a "garden variety" arrangement of noncopyrightable elements. The Court further 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.

We do not dispute the fact that jewelry designs, and for that matter, lace designs fall within the category of works of authorship that are the general subject matter of copyright. However, not all jewelry and lace designs are copyrightable. And, as *Feist* confirms, all works, no matter what the category, must contain a sufficient amount of original and creative authorship to be copyrightable. *Feist,* 499 U.S. at 346 (originality as a constitutional requirement).

In its long-standing registration practices–in place prior to *Feist*–, the Office has consistently recognized and applied the modest but nevertheless extant requisite level of creativity necessary to sustain a claim to copyright. *Compendium II* states that "[w]orks that lack even a certain minimum amount of original authorship are not copyrightable." *Id.*, section 202.02(a). For works of pictorial, graphic, and sculptural authorship 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 applying this standard, courts have consistently found that standard designs, figures, and geometric shapes are not sufficiently creative to meet the required

quantum threshold. M. and D. Nimmer, *Nimmer on Copyright*, 2.01[B], 2-14. *Bailie v. Fisher,* 258 F.2d 425 (D.C.Cir. 1958); *Homer Laughlin China Co., v. Oman,* 22 U.S.P.Q. 2d 1074 (D.D.C. 1991); *OddzOn Products Inc. v. Oman,* 924 F.2d 346 D.C. Cir. 1991). *Compendium II,* section 503.02(a) notes that "[R]egistration cannot be based on the simplicity of standard ornamentation.... Similarly, it is not possible to copyright common geometric figures or shapes...." Further, "familiar symbols or designs, and mere variations of typographic ornamentation, lettering, or coloring, are not copyrightable." *Compendium II,* section 202.02(j). No registration is possible where the work consists solely of elements which, individually, or collectively, 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. *Compendium II,* section 503.02(a). *See Bailie v. Fisher,* 258 F.2d at 426: ("Register [of Copyrights] may properly refuse to accept for deposit and registration 'objects not entitled to protection under the law'"). *See also* 37 CFR 202.1(a) (familiar symbols or designs "are not subject to copyright and applications for registration of such work cannot be entertained"); *DBC of New York, Inc. v. Merit Diamond Corp.,* 768 F.Supp. 414, 416 (S.D.N.Y. 1991) (upholding a refusal to register a jewelry design of graduated marquise and trillion cut diamonds on a knife-edged shank on the basis of the commonplace symbols and familiar designs).

You assert that commonplace designs, shapes and symbols, or geometrical forms are copyrightable where trivial variations may be found. (Letter from Max of 12/22/2003 at 5.) The Board disagrees. *Feist* made it clear that while the standard of originality is low, it does exist. *Feist,* 499 U.S. at 362. In agreement with *Feist*, the Ninth Circuit re-stated the principle governing the necessary quantum of originality: *see North Coast Industries v. Jason Maxwell, Inc.* 972 F.2d 1031, 1033 (9th Cir. 1992), citing *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 102-103 (2d Cir. 1951) ("No large measure of novelty is required... [A]ll that is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'") *North Coast*, 972 F.2d at 1033. *See also Compendium II,* section 503.02(a): "Registration cannot be based on a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations." Similarly, "the 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).

C. The Works In Their Entirety

Simple variations of standard designs and their minor arrangement do not support a claim to copyright. Some combinations of common or standard forms contain sufficient creativity in their selection, coordination and arrangement of those forms. *See Feist,* 499

U.S. at 358, (the Copyright Act "implies that some 'ways [of combining uncopyrightable material] will trigger copyright, but others will not," with the determination resting on the presence of creativity in selection, coordination, and arrangement of material); *Atari Games Corp. v. Oman,* 979 F. 2d 242, 245-56 (D.C.Cir. 1992) (a work viewed as a whole may be subject to copyright due to its selection and arrangement of otherwise unprotectable elements); *Diamond Direct*, 116 F. Supp. 2d at 528 ("[W]hile component parts are not entitled to copyright protection simply by virtue of their combination into large whole, copyright may protect the particular *way* in which the underlying elements are combined – if the particular method of combination is itself original." (Emphasis in original).

However, merely combining unprotectible elements does not alone establish creativity where the combination or arrangement is itself simplistic or formulaic or minor in its configuration. For example, in *Jon Woods Fashions, Inc. v. Curran,* 8 U.S.P.Q. 2d 1870 (S.D.N.Y. 1988), 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 distinctively arranged or printed, did not contain the minimal amount of original artistic material necessary 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 words "Arrows" in cursive script below the arrow. *John Muller & Co. v. New York Arrows Soccer Team,* 802 F.2d 989 (8th Cir. 1986).

D. Analysis of the works

The Review Board has examined the Dorera jewelry designs at issue here both in terms of their component elements as well as in their entirety. The copyright law states that ideas are not copyrightable. 17 U.S.C. 102(b). It is only when ideas have been expressed in such a way that demonstrates copyrightable originality that such expression can be registered. Placing diamonds together side by side in successive rows, or using smaller diamonds to encircle a larger diamond with scalloped and arched edges, or creating an open lattice of different sized diamonds–as ideas, are not protectible. Therefore, since the physical material of which a work is made does not determine copyrightability, any protectible aspects of these works would have to be found in the actual implementation of that idea, *i.e.* in the design and any sculptural authorship.

1. *D1728N Organdie Necklace*

You maintain that the subject jewelry designs satisfy the Copyright Act's test for originality, through the selection of design elements and their combination, which make the overall designs protectible under copyright law. (Letter from Max of 12/22/2003 at 2.) You state that the Organdie Necklace creates "a flexible moving web-like design created

from several different sizes and configurations of diamonds in an original formation that accentuates and emphasizes the contours of the individual wearer's neck." *Id.* A work's flexibility and movement, the visual effect, the symbolism, or subjective impression of a work in the mind of the perceiver are not factors in the examining process. *Cf.*, *OddzOn Products, Inc. v. Oman,* 924 F.2d at 348 (affirming the Register's denial of registration to "Koosh Ball," consisting of hundreds of elastomeric filaments amounting to a flexible, moving sphere). The Office's determination of registrability for a given work is based on whether the combination of design elements possesses a sufficient quantum of creativity within the meaning of the copyright law and settled case law.

The basic Organdie Necklace design has been registered before, and the differences between the earlier works and this work are not sufficient to support a new registration. As evidence of the registrability of this necklace, you submitted a photocopy of a comparable Organdie Necklace, entitled D1404N Round Rose-Cut Criss Cross Organdie Necklace that was registered February 28, 1998 as VA 1-114-067. Indeed, the underlying overall pattern of this Organdie Necklace is the same as more than one other Organdie Necklace published by Dorera and submitted for registration.[1] Your argument implies that since the earlier registered work contains a similar design to the one under consideration here, the Organdie Necklace at issue here (published January 5, 2000) with additional rows, should also be registrable. The registration of the earlier necklace, however, proves the opposite. In cases where the basic design has been previously registered, a new version must constitute a derivative work– that is, the new version must contain copyrightable differences. 37 CFR 202.3 (b) (10) (one registration per work rule). The current Organdie Necklace does not contain the necessary quantum of copyrightable authorship over and above the content of the previously registered work sufficient to sustain a second registration. The pattern of latticework is the same, as is the placement of the larger diamonds at the intersecting points as well as the drop diamonds on the bottom row. Neither the repetition of the lattice work pattern over multiple rows nor the change in the color of diamonds from "rose" to clear constitutes a copyrightable difference. *Compendium II,* section 503.02(a) ("mere coloration cannot support a copyright"). The Board is not persuaded that the substitution of a scalloped upper row instead of a straight row of diamonds rises to the level of a registrable difference, nor does the fact that the present Organdie Necklace merely adds a number of identical rows in the same pattern as that of the earlier registered work persuade the Board.[2] Therefore, the Organdie Necklace at issue here cannot be registered as a derivative work. *See*

---

[1] *See e.g.*, Organdie Necklace 2078N, published January 31, 2002, and submitted July 16, 2002.

[2] The more recently submitted Organdie Necklace bears even greater similarity to the instant work, and was also published before the Organdie Necklace in this submission.

Compendium II, section 610.04: "Registering different versions of a published work; versions containing uncopyrightable differences"–where the versions have been published separately at different times, the Office will register only one claim. We point out, however, that any claim registered must be for a work copyrightable in itself and representing the first publication of the particular copyrightable authorship appearing in the work.

2. *D1480BS Renaissance Bracelet*

The Renaissance Bracelet's elements are seven connected rows of circular diamonds, side by side. The rows of single round diamonds connected horizontally and vertically by alternating the beginning of a row so that each diamond falls between two diamonds on the row above. This combination of side-by-side successive alternating rows of diamonds, even considering the barely visible underside connection of the diamonds both vertically and diagonally, does not add up to an overall composition that rises to the necessary minimum level of creativity.

3. *D1453R Black Lace Floral Ring*

In the design for the D1453R Black Lace Floral Ring, eight smaller diamonds surround a diamond in the center resembling the innermost circles of a bull's-eye or target symbol with semicircular curves(Ð) at the top and bottom of the ring. The bottom curve turns upward. Six of these figures are placed equidistantly around the surface of the ring on black circular fishnet-patterned "lace." The circle of diamonds surrounding a diamond is a simple, basic design in itself, as is placing the elements of the given design side-by-side equidistantly around a ring– a commonplace layout of design elements on the surface of a rounded object. The addition of the curve above and below the design does not elevate this work to a copyrightable design as a whole. *See Compendium II,* section 503.02(b), 504.02.

4. *D1660R Black Lace Floral Ring*

The design for the Black Lace Floral Ring identified as D1660R is the same as that for the D1453R ring (eight diamonds surround the center diamond) with the addition of a continuous arched border or rim (^ ^ ^ ...) above and below the top and bottom semicircular curve. Neither of these arrangements– again, side-by-side bull's-eye-like symbols with minor curvilinear and rim variations– rises to the threshold quantum of creativity necessary for registration. With respect to this ring, then, the identical repeats of the circle-within-a-circle semicircular bounded figure on a fishnet circular background, with the addition of arched edges as a minor variation, do not constitute a sufficient minimum amount of authorship in selection, coordination, and arrangement to support a copyright.

Section 503 of *Compendium II* states that "If the work consists entirely of uncopyrightable elements, registration is not authorized." Even if some of the shapes have been slightly modified (e.g., an arch is added above a semicircle) minor alterations of stock features are not sufficient to sustain a claim to copyright. *See Vogue Ring Creations, Inc. v. Hardman*, 415 F.Supp. 609, 612 (D. R.I. 1976))adding rope design and changes in width and shape of ring ware 'trivial and meaningless, utterly devoid of any 'original creativity,'" and components not entitled to copyright protection. *See also DBC of New York*, 768 F.Supp. at 416-419.

E. Case law distinguished

In urging the registrability of these four designs, you note *Soptra Fabric*'s (490 F.2d 1092 (2d Cir. 1974)) holding that a design embellished or expanded in repeat to avoid showing an unsightly joint when printed on a continual basis constitutes modest but sufficient originality so as to support the copyright, pointing to its language that "the minimal quantum of originality in the textile pattern field, where the design printed is itself unmistakably original, as here, is not very high," 490 F 2d at 1094. (Letter from Max of 12/22/2003 at 4.)

The Board again agrees that the minimum standard of copyrightability is not high, but not only was the basic design in *Soptra* "unmistakably original" in the sense of possessing the necessary minimal amount of creativity, but that court also found the design embellished or expanded in a particular manner to constitute sufficient authorship. The Board cannot say that the basic designs here are unmistakably original in the creative/*Feist* sense. And, it is clear that not all particular ways of embellishment resulting from combinations of preexisting or previously published elements will necessarily make the grade. Therefore, although these designs may be "in repeat" as in the *Soptra* case, the registrability of designs, no matter what inspires their production-- the intent to hide unsightly joints or to emphasize the contours of the wearer's neck – cannot be determined by motivation. The total product must constitute something more than a trivial variation of elements. Again, *see Catalda*, 191 F.2d at 103; *Feist,* 499 U.S. at 363. Attractiveness, visual effect, symbolism, or even commercial success will not determine whether a work will be registrable. Sufficient original and creative authorship within the meaning of the copyright law and settled case law are the determining factors.

In addition to *Soptra*, you cite other fabric design cases as support for the registrability of these works-- *Tennessee Fabricating Co. v. Moultrie Mfg Co.*, 421 F. 2d 1982 (2d Cir. 1974) (room divider unit formed of an intricate filigree pattern of intercepting straight lines and arc lines); *Concord Fabric Inc. v. Marcus Brothers Textile Corp.,* 409 F.2d 1315 Cir. 1969 (designs of circles within squares with frames around

the border, figures around the outside of the circle, and designs within the circles and between the squares); *In Design v. Lynch*, 689 F.Supp. 176 (S.D.N.Y.) *aff'd without opinion* at 863 F.2d 45 (2d Cir. 1988)("relatively intricate" three level rhomboid and irregularly spaced diamond patterns); and *Prince Group, Inc. v. MTS Products, Inc.*, 967 F.Supp. 121 (S.D.N.Y. 1997)(irregularly shaped, shaded polka dots in random pattern due to conflicting diagonal lines placed at varying distances from each other). The fabric designs in the above works were more intricate designs that the ones at issue here. Moreover, no one has suggested that decisions regarding the fabric area translate in altogether comparable fashion to decisions on the protectability of jewelry. Moreover, each work submitted for registration must be judged on its own merits. *See* the general principle of registration enunciated in the statute at 17 U.S.C. 410[a]: the Register must examine a work to determine whether "the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements [of Title 17] have been met..." There is no guarantee, either in statute or in settled case law, that a work which falls within a certain subject matter category or which may be similar in composition to other registrable works is registrable in itself unless it meets all legal and formal requirements.

You refer also to *North Coast Industries* to support the registration of this work. The focus in that case was whether the design was itself too derivative of Mondrian's artistic work, giving rise to the question of whether the design owed its origin to the plaintiff. Nevertheless, the *North Coast* court ultimately remanded the question to the jury to determine whether the differences between Mondrian's work and the plaintiff's work were "nontrivial." We do not find *North Coast* helpful to your arguments in favor of registration for the jewelry works at issue here. You have further stated that *Atari Games Corp. v. Oman*, 979 F.2d 242,243 (D.C. Cir. 1992) and *Weindling Int'l Corp. v. Kobi Katz, Inc.*, 2000 WL14587888 at 4 (S.D.N.Y. Sept. 29, 2000), support the registration of these works; you urge that the works at issue here constitute variations and configurations of common geometric shapes and designs. (Letter from Max of 12/22/2003 at 4.) The Board acknowledges *Atari*'s proposition that it is possible for an original combination of elements, each element of which is unoriginal, to be copyrightable if that overall combination or arrangement meets the minimal standards of creativity. 979 F.2d at 245 - 246. We do not, however, find sufficient creativity in the particular combinations of design elements in the works at issue here. Again, we refer to *Compendium II*, section 503.02(a) (simple combination of a few standard symbols with minor linear or spatial variations and mere bringing together of two or three standard forms or shapes with linear or expanded variables are not copyrightable). Such variations and combinations may be aesthetically pleasing, but they do not furnish a basis upon which to support a copyright registration.

You also quote *OddzOn Products v. Oman*, 924 F.2d 346, 348 (D.C. Cir. 1991) in your discussion of *Atari* to reiterate that the arrangement itself may be indicative of authorship. (Letter from Max of 12/22/2003 at 4.) Justice Ginsburg's point in *Atari* was that the use of public domain symbols does not automatically *dis*qualify a work for copyrightability. As we have stated earlier, that principle should not be taken to mean that the combination of any design elements together automatically qualifies a work for copyrightability. It is clear that the arrangement of uncopyrighted elements *may be* copyrightable, but that potential is not a guarantee. The arrangement in *OddzOn* was not copyrightable and *Feist* decisively laid to rest the proposition that any arrangement of uncopyrightable elements is per se copyrightable. The elements must be arranged in such a way as to constitute a work of authorship on its own – not by sweat of the brow, or artistic merit *per se. Feist*, at 356. As the *OddzOn* court said: "[I]t is not merely that the Koosh ball approximates a sphere, it is also that there is not enough additional creative work beyond the object's basis shape to warrant the copyright." 924 F.2d at 348.

In *Weindling International Corp. v. Kobi Katz, Inc.*, 2000 WL1458788, you cite the court's language that the "creative spark" may be more like a flickering match than a bolt of lightning, and that a use of elements commonly used in jewelry does not mean that a work is not entitled to copyright protection. We do not interpret *Weindling,* however, to enunciate any new standard of registrability -- any other than the originality and creativity standard expressed in *Feist, Compendium II*, and Copyright Office regulations distilled from longstanding case law before and after *Feist. See, e.g., Bailie v. Fisher,* 258 F.2d at 426; *Vogue Ring v. Hardman* (410 F. Supp. 609, 612 (D. R.I. 1976) (addition of rope design and changes in width and shape of ring were trivial and meaningless-- utterly devoid of any original creativity); and *DBC of New York v. Merit Diamond,* 768 F. Supp. at 416-17 (design of marquise stones, trillions and other elements not original).

In arguing *Yurman*, you note that despite evidence that other companies made jewelry composed of the same elements found in the plaintiff's jewelry, the court there found originality in the way Yurman had recast and arranged the component elements, citing 262 F. 3d at 110. (Letter from Max of 12/22/2003 at 5.) Clearly, the manner of arranging and recasting elements has everything to do with whether stock elements can comprise a copyrightable work. However, even where the arrangement is original and creative, the first time the combined elements are used, they will be registered as a copyrightable arrangement. As discussed above, particularly in connection with the Organdie Necklace, when that same arrangement is subsequently used in other jewelry designs, it is unoriginal, and thus such"new versions," or "derivative works" can be registered only when the subsequent version contains some expression of additional authorship that reflects "a copyrightable difference distinguishable under the copyright law." *Compendium II*, section 610. Thus, in summary, these designs cannot be registered as

derivative or original works when measured against the quantum level of new authorship required because they do not contain sufficient creative content within the meaning of the copyright statute, copyright regulations, Copyright Office examining practices and settled case law.

III CONCLUSION

The Board has reviewed the jewelry designs in their entirety and as to their individual elements and has determined that they cannot be registered because they contain insufficient artistic or sculptural creativity to support copyright registration. Accordingly, for the reasons stated above, the Review Board affirms the Examining Division's refusal to register these jewelry designs. This decision constitutes final agency action.

Sincerely,

/s/

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