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May 26, 2005

Robert J. Schaap, Esq.
21241 Ventura Blvd., Ste 188
Woodland Hills, CA 91346

RE: Control Number: 61-223-8976(S)
Design of a Wristwatch

Dear Mr. Schaap:

I am writing on behalf of the Copyright Office Review Board [formerly, Board of Appeals] in response to your letter dated September 29, 2004. You had asked the Copyright Office to reconsider for the second time a refusal to register a design for a wristwatch. The Review Board has carefully examined the application, all deposit materials, and all correspondence in this case and now affirms the Examining Division's refusal to register this work.

I. Description of Work

The subject work is a wristwatch. The dial of the wristwatch features numerals from 1 through 12 (with the exception of 3, which is replaced by a date indicator) situated equidistantly apart along its circumference, with the numeral 12 placed just below the midpoint between the upper pair of wristband mounting brackets. You have further described the numerals on the dial as follows:

The time numerals are in roman numeral format and have a very distinctive appearance. Moreover, they are not arranged to be read by merely looking at the dial face from one orientation. Rather, the numbers are such that the number "6" is actually upside down. The number "9" is oriented 90 degrees relative to the number 12.

There is also a tachometer scale on the outer periphery of the dial face. This tachometer scale is set forth in logarithmic format and, moreover, ranges from 60 to 600. The Roman numeral time elements are also coupled with Arabic number time designations in terms of seconds or minutes. Letter from Schaap to Burns of 3/5/04 at 2-3.

The watch dial also features three smaller dials which form an arc across the left side of the dial face, with one situated just below and overlapping the numeral 12, a second situated just to the right of and overlapping the number 9, and a third situated just above and overlapping the numeral 6. The face of the chronograph situated just above the 6 has a section approximately the shape of an umbrella that shows an image of a moon during

certain portions of the day. The moon image features rays emanating from the moon similar to those that are commonly used in depictions of the sun.

You describe the shape of the wristwatch's second hand as follows:

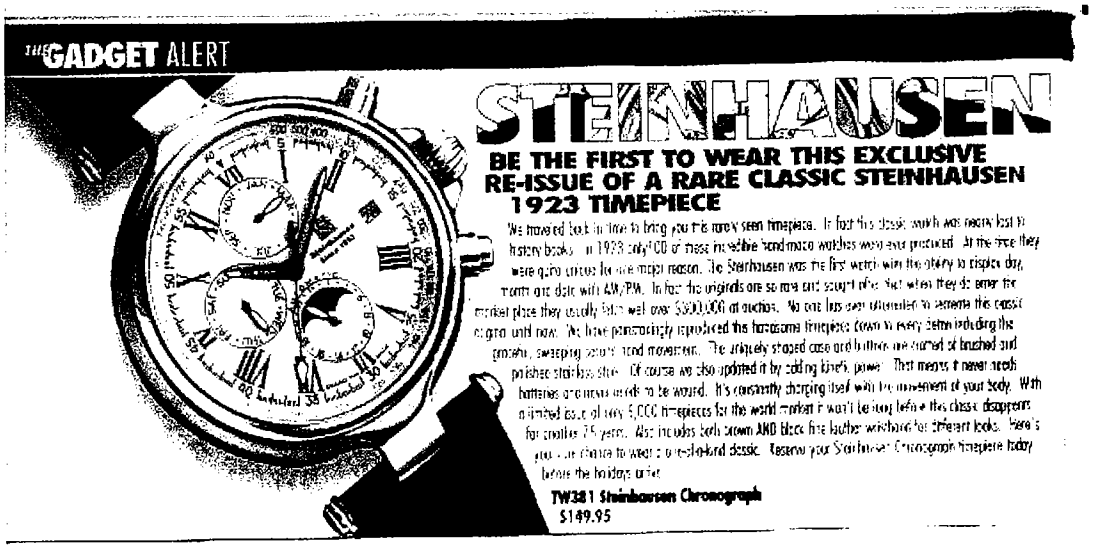
> The tip of the second hand is somewhat quadrilateral in shape in that it has two small sides extending at right angles relative to one another and two long sides which join to form the pointed tip. [...] Moreover, that same sweep hand has a slight line shape[] extending out laterally from the portion to which the tip is connected. Letter from Schaap to Giroux of 9/29/04 at 10-11.

You also describe the general appearance of the wristwatch's sweep hands as follows:

> [E]ach of the hands are relatively dark and include interior elongated lighter colored areas. [...] [T]hese lighter colored areas ... have the same gold appearance as does the face of the watch. Id.at 11.

The sweep hands of the three chronograph dials are shaped like elongated teardrops with triangular tips. Like the hour and minute hands, they are relatively dark with interior, elongated, lighter colored areas.

The following is a reproduction of the photo submitted as identifying material for the watch design at issue.



II. Administrative Record

A. Initial application and Office's refusal to register

On October 31, 2003, the Copyright Office received a Form VA application on behalf of your client, AROA Marketing, Inc. In a letter dated November 5, 2003, Visual Arts Section Examiner Joy Fisher Burns refused registration of this work because she determined that it lacked the authorship necessary to support a copyright claim. Letter from Burns to Schaap of 11/5/03 at 1.

Ms. Burns explained that copyright protects only original works and that the definition of "original" used in the copyright context includes a requirement that the work be independently created by the author and possess at least a minimal degree of creativity, citing to *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340 (1991). She further explained that, to satisfy these requirements, a work of the visual arts must contain a minimum amount of artistic or sculptural authorship and that copyright does not protect familiar shapes, symbols, and designs or minor variations thereof; words and short phrases such as names, titles, and slogans; lettering and calligraphy; coloring; or mere variations of typographic ornamentation. Ms. Burns concluded that the work consisted of various standard elements which did not contain the authorship necessary for registration and that the layout or arrangement of these elements also failed to contain the authorship necessary for registration. Letter from Burns of 11/5/03 at 1.

B. First request for reconsideration

In a letter dated March 5, 2004, you requested reconsideration of the Office's refusal to register the work. After describing the subject matter in the claim for copyright, you argued that the Office "has erred ... factually in contending that the subject matter of the claim for copyright consists only of standard elements and that these elements do not constitute copyrightable authorship" and "has also erred in contending, under the current state of the law, that a copyright application cannot be refused registration merely relying upon blanket statements that the elements of the watch design are standard, or that the layout or arrangement of the elements does not constitute copyrightable authorship." Letter from Schaap to Burns of 3/5/04 at 4.

You sought to distinguish your work from the work at issue in *Feist*, arguing that the originality standard is extremely low and that, because the wristwatch resembles no other wristwatch, it must therefore meet this threshold. Letter from Schaap of 3/5/04 at 5-7. You also cited *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), arguing that "[i]f one is allowed to try their hand at creating the same face others have attempted to copy by painting, clearly the author in the instant application should be entitled to use conventional

elements which appear and try his hand at rearrangement to obtain a different aesthetic appearance." Letter from Schaap of 3/5/04 at 7-8.

You submitted advertisements for two other wristwatches, noting that these wristwatches both contained, as did yours, three inset dials, three sweep hands, and a date display. You argued that, despite the shared use of several elements, your wristwatch differed significantly from the other two in terms of overall arrangement and appearance and that this difference therefore indicated sufficient originality for copyright protection. You also noted that, in addition to the originality present in the overall arrangement of your wristwatch, individual elements, such as the shape of the sweep hands, were different from those seen in previously existing watches and therefore contributed to the overall originality. *Id.* at 8-10.

You cited *Knickerbocker Toy Co., Inc. v. Winterbrook Corp.*, 554 F. Supp. 1309 (D.N.H. 1982) for the proposition that "[n]o matter how poor artistically the 'author's' addition, it is enough if it be his own" and *Selle v. Gibb*, 567 F. Supp. 1173 (N.D. Ill. 1983) for the proposition that "[a] work is original and may command copyright protection even if it is completely identical with a prior work providing it was not copied from such prior work but was rather the product of an independent effort of its author." Letter from Schaap of 3/5/04 at 10-11.

You argued that the Examiner's statement that a wristwatch consisting of various standard elements does not contain the authorship necessary for a copyright is "just plain wrong. The statement obviously overlooks the fact that each of these elements[,] which may be old, can have there[sic] own unique shape, their own unique appearance and their own unique arrangement in combination. It is that expression of originality provided to these elements which provides for appropriate copyright protection." *Id.* at 11-12. You contended that the Office needed to examine the features of the wristwatch in more detail rather than concluding that the wristwatch merely consists of a combination of standard elements and that the creativity in your wristwatch is so apparent that, to find that the authorship necessary for registration is not present, the Office would have to conclude that your client copied the design. *Id.* at 12. You further contended that the design of your wristwatch is unique and "does not find any counterpart in any other existing wristwatch design." *Id.* at 12-13. You argued that the overall arrangement of the elements of your client's watch constitutes copyrightable authorship because the shape and appearance chosen for different elements combine to create an "antique appearance" as opposed to a more modern look created by arranging these elements in a particular way. *Id.* at 14-15.

C. Examining Division's response to first request for reconsideration

In response to your request and in light of the points in your letter of March 5, 2004, Attorney Advisor Virginia Giroux of the Examining Division reexamined the application and

determined that the wristwatch was a useful article that did not contain any separable authorship that was also copyrightable. Ms. Giroux explained in a letter dated June 3, 2004 that, with respect to a useful article, which by definition has an intrinsic utilitarian function that is not merely to portray the appearance of the article, the design is copyrightable:

> only if and to the extent that such design incorporates pictorial, graphic, or sculptural features that can be identified separately from and are capable of existing independently of the utilitarian aspects of the article without destroying its basic shape.

Letter from Giroux to Schaap of 6/3/04 at 1.

Ms. Giroux noted that this separability could exist either physically or conceptually. She explained that conceptual separability occurs when the pictorial, graphic, or sculptural features of the work can, for example, be visualized on paper or as a free-standing sculpture, independent of the shape of the utilitarian article, without destroying the basic shape of the article, such as with respect to a carving on the back of a chair or pictorial matter engraved on a glass vase. *Id.* at 1-2, citing *Compendium of Copyright Office Practices, Compendium II,* 505.03 (1984).

She explained, however, that conceptual separability and copyrightability do not automatically exist simply because an element within a useful article is not dictated by utilitarian concerns. Even if certain features are non-functional or could be designed differently, Ms. Giroux noted that no copyright registration is possible where such features are an integral part of the overall shape or contour of the useful article. She then recounted the holding in *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), in which the D.C. Circuit upheld the Office's refusal to register the shape of a utilitarian outdoor lighting feature, even though it did contain some aesthetically pleasing features. In further support of the limits imposed on the copyrightability of useful articles, she also cited *Norris Industies, Inc. v. International Telephone & Telegraph Corp.*, 696 F.2d 918 (11th Cir. 1983), *cert. denied*, 464 U.S. 818 (1983) (holding that a wire-spoke wheel cover was not copyrightable because it did not contain any separable sculptural design). Ms. Giroux cautioned that the test for conceptual separability cannot be met merely by analogizing the general shape of an article to a work of modern sculpture, since the artistic features would not be perceived as having a separate existence. Letter from Giroux of 6/3/04 at 2.

Evaluating the subject work, Ms. Giroux determined that some elements on the face of the wristwatch could be viewed as conceptually separable from the utilitarian aspects of the work but that these elements, taken as a whole, were not copyrightable as a "work of art." She explained that, to be regarded as copyrightable, a work must not only be original but

must also "possess more than a de minimis quantum of creativity," citing *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340 (1991). She further stated that, in the case of a design, a certain minimum amount of pictorial or sculptural expression in the work must have originated with the author and that originality, as interpreted by the courts, means that the authorship must constitute more than a trivial variation of public domain elements. Letter from Giroux of 6/3/04 at 2, citing *Alfred Bell & Co., Ltd. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951).

Ms. Giroux determined that the separable elements on the face of the wristwatch, some of which were functional and therefore not copyrightable, consisted of "arabic numbers, roman numerals, names of months and days, black hand indicators with white tips, and three circular dials one of which contains an umbrella design." Letter from Giroux of 6/3/04 at 2. Ms. Giroux found that the numerals and names of months and days were uncopyrightable per se, citing 37 C.F.R. 202.1, which declares that names, titles, words, short phrases, numbering, lettering, and coloring are per se uncopyrightable. Letter from Giroux of 6/3/04 at 2-3. Ms. Giroux further determined that circles, parallel lines, the umbrella design, and any minor variation thereof are common and familiar shapes or designs in the public domain and therefore also per se uncopyrightable according to section 202.1 of the Office's regulations. From this determination, she concluded that the hand indicators and dials were also not copyrightable. Letter from Giroux of 6/3/04 at 3.

Ms. Giroux also concluded that even the combination and arrangement of the various elements combined with the choice of coloring for hand indicators did not rise to the level of copyrightable authorship necessary to support a copyright registration, finding that the overall design was "*de minimis* involving public domain elements combined and arranged in a rather simple and standard configuration." *Id.*, citing *Compendium II*, section 503.02(a). In support of her reasoning, she cited *John Muller & Co., Inc. v. New York Arrows Soccer Team, Inc.*, 802 F.2d 989 (8th Cir. 1986) (upholding refusal to register logo consisting of four angled lines forming an arrow with the word "arrows" in a cursive script below it on grounds that it lacked the minimal creativity for authorship); *Forstmann Woolen Co. v. J.W. Mays, Inc.*, 89 F. Supp. 964 (E.D.N.Y. 1950) (finding a label with words "Forstmann 100% Virgin Wool" interwoven with three fleur-de-lis not copyrightable); *Jon Woods Fashions, Inc. v. Curran*, 8 U.S.P.Q.2d 1870 (S.D.N.Y. 1988) (upholding refusal to register fabric design consisting of striped cloth with small grid squares superimposed on the stripes where Register concluded that the design did not meet minimal level of creative authorship necessary for copyright); and *Vacheron Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co., Inc.*, 260 F.2d 637 (2d Cir. 1958) (supporting Copyright Office refusal to register watch face design with no conceptually separable copyrightable authorship). Letter from Giroux of 6/3/04 at 3.

Ms. Giroux also noted that, while court cases have found that a slight amount of creativity will suffice to obtain registration, "there remains a narrow area where admittedly

independent efforts are deemed too trivial or insignificant to support a copyright" and concluded that the design of the wristwatch at issue falls within this narrow area. *Id.*, citing 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* 2.01(b) (2002) ("*Nimmer*"). While agreeing with your reference to *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903) and other cases regarding the amount of creativity necessary for copyright protection, as well as your argument that *Feist* stands for a very low requisite level of creativity, she stated that the elements on the face of the wristwatch in question, as well as the arrangement of those elements, fails to meet even this low threshold for copyrightable authorship. Letter from Giroux of 6/3/04 at 3.

In response to your argument that the overall visual appearance and "antique" look of the watch face should be considered in determining copyrightability, Ms. Giroux stated that "[t]he visual effect or impression that a work conveys suggests some aspect of mental activity that goes to the mind of the viewer rather than to the composition of the work itself" and therefore does not, in itself, demonstrate enough creativity on the author's part to justify copyright registration. Ms. Giroux stressed that merely selecting certain shapes, designs, and coloring in place of other available alternatives does not guarantee that the resulting authorship rises to the level of copyrightability. She also stated that a work which lacks sufficient authorship may not be copyrighted simply because it is unique or because considerable time, effort, and expense went into its creation. *Id.* at 4.

Based on the determination that no artistic or graphical elements on the surface of the wristwatch at issue, either alone or in combination, succeeded in being both separable and copyrightable, Ms. Giroux refused registration for the work. *Id.*

D. Second request for reconsideration

In a letter dated September 29, 2004, you requested that the Office reconsider for a second time its refusal to register the copyright claim in the subject work. Letter from Schaap to Board of Appeals of 9/29/04 at 1.

You began by reiterating that originality refers simply to the origins of a work with a particular author and that what is required for originality is not novelty but merely that the author contributed more than a trivial variation, citing to *Alfred Bell v. Catalda Fine Arts* and *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821 (11th Cir. 1982). You argued that, according to this definition, the wristwatch at issue demonstrates sufficient originality. Letter from Schaap of 9/29/04 at 1-2.

You urged the Office to reconsider its classifying the subject work as a useful article. You analogized the subject work to the lamp base at issue in *Mazer v. Stein*, 347 U.S. 201 (1954). In that case, the Supreme Court allowed registration, finding that the question was "not [...] a manufacturer's right to register a lamp base, but [...] an artist's right to copyright

a work of art intended to be reproduced for lamp bases." You argued that your case is similar in that it involves an artist's right to copyright a work of art intended to be used as a wristwatch. Letter from Schaap of 9/29/04 at 2. You noted that many individuals "pay thousands of dollars for a wristwatch when numerous watches are available for less than a few hundred dollars," arguing that such usage indicates that these individuals consider their wristwatches to be pieces of jewelry rather than simply useful articles. *Id.* at 3. You argued that the Office arbitrarily classified the subject work as a useful article rather than as a non-utilitarian piece of jewelry. You cited *Filmvideo Releasing Corp. v. Hastings*, 426 F. Supp. 690 (S.D.N.Y. 1976) for the proposition that "the list [of classes of works which may be copyrighted] is not exclusive and [...] errors in classification shall not impair copyright protection," arguing that the Office's classification scheme is intended to be an administrative convenience rather than a per se determiner of what can and cannot be copyrighted. Letter from Schaap of 9/29/04 at 4.

You noted that the Office has issued eight copyright registrations on belt buckles, arguing that the determination that "a belt buckle with a unique shape can be copyrightable, whereas a watch, not only with a unique face, but also with other unique attributes, cannot be the subject matter of a copyright" represents a "dual standard." *Id.* at 4-5. You stated that you recognize the Office's position that "the shape of an article is copyrightable only if the design incorporates features which can be identified separately from and are capable of existing independently of the utilitarian aspects of the article" and that what you are claiming is copyrightable is not "the unique shape of the article per se" but rather "the shape of the article combined with the other aesthetic features of the watch." *Id.* at 5-6.
You argued that, while commercial success may not be an element in determining copyrightability, the fact that the subject work had enjoyed an unexpectedly high degree of commercial success suggests that consumers must have found it unique and original in some way. *Id.* at 6. You also noted that the U.S. Patent and Trademark Office has granted the wristwatch at issue a design patent, which means that it necessarily determined that its design was new, useful, and non-obvious. You argued that an article found to be new and non-obvious must by definition be original and that a work held to be original by one government agency cannot be found to be non-original by another. *Id.* at 6-7.

You stated that the term "works of art" as used in the previous section 5(g) of Title 17 before its expansive amendment in 1976 is "clearly a loose term," citing *Panama Canal Co. v. Grace Line, Inc.*, 356 U.S. 309 (1958). You further state that the only case which addresses the issue of whether watches can be copyrightable is *Vacheron and Constantin-Le Coultre Watches v. Benrus Watch Co., Inc.*, 260 F.2d 637 (2d Cir. 1958), which came to a decision on other grounds, thus leaving the issue unsettled. You pointed out that *Vacheron* did indicate that the Office provided a broad interpretation of copyrightability for jewelry and other works of artistic craftsmanship. Supporting this broad interpretation, you noted that the Office has permitted registration of "articles such as statuettes, bookends, clocks, door knockers, lamps, candle sticks, ink stands, chandeliers, piggy banks, sundials, salt and

pepper shakers, fish bowls, casseroles and ashtrays," citing *id.* at 644. Letter from Schaap of 9/29/04 at 8. Further, citing *Blucher v. DuBoies, Inc.*, 253 F.2d 948 (2d Cir. 1958), you also noted that the Office has allowed and the courts have confirmed registration of ornamental jewelry. Letter from Schaap of 9/29/04 at 8.

You argued that, in light of these other registrations, refusing to register a "highly ornamental" wristwatch such as the subject work "is a departure from other decisions [the Office] has made with related articles and one which denies the applicant herein to be on the same footing as applicants for lamp bases, piggy banks, etc." You compare the wristwatch at issue with a belt buckle, arguing that the two are equivalent when it comes to determining originality and separability, stating that "[t]he fact that a belt buckle can have a design of e.g., a 'superman' on the front portion thereof or a 'batman' on the front portion thereof is really no different than a wristwatch which can have an antique styled face as opposed to a more modern looking face." *Id.* at 9.

You argued that the wristwatch at issue meets the test of separability because "there are several separable components which, in and of themselves, can function as useful articles." As an example, you described the sweep hands of the three chronometer dials, stating that they could be useful as "designs of arrows." You also contended that these sweep hands are original to you, first noting that case law supports the idea that, if something was designed by an applicant, that applicant is entitled to registration and second submitting the "unique shape"of these sweep hands as evidence of their originality. Describing the shape of the second hand, you state that it is "somewhat quadrilateral in shape in that it has two small sides extending at right angles relative to one another and two long sides which join to form the pointed tip. [...] Moreover, that same sweep hand has a slight line shape[] extending out laterally from the portion to which the tip is connected." You describe the general appearance of the sweep hands as "relatively dark and includ[ing] interior elongate lighter colored areas. [...][T]hese lighter colored areas ... have the same gold appearance as does the face of the watch." *Id.* at 10-11.

You also put forward other elements that you believe are copyrightable. You describe the dial face of the wristwatch in question as "unique in that it has a roman numeral time indicia in a circular format and surrounding that roman numeral time indicia are other indicia, such as tachometer information" and state that the chronometers on the dial face also have an unique arrangement. The moon image on the bottom chronometer dial is also unique in that it "has rays emanating outwardly therefrom, similar to graphic illustrations of a sun." You also note that the dial face could be useful in a compass, in other chronographs, or as a speedometer. *Id.* at 11-12.

You noted that "if the shape of a utilitarian article incorporates features such as artistic sculpture, carving or pictorial representation which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for

registration," citing *Ted Arnold Ltd. v. Silvercraft Co., Inc.*, 259 F. Supp. 733 (S.D.N.Y. 1966), which found that a pencil sharpener with the outer design of a telephone would be eligible for copyright because the telephone casing could exist independently as a work of art. Letter from Schaap of 9/29/04 at 12-13.

You finally note that "Copyright Law may protect a combination of elements that are unoriginal in themselves" if there is sufficient originality in their selection and arrangement. *Id.* at 14, citing *Yurman Design Inc. v. PAJ Inc.*, 262 F.3d 101 (2d Cir. 2001).

III. Decision

A. The Office will accept the assertion that the watch is not purely a reproduction of a preexisting watch

You claim at several points in your correspondence that the design for the wristwatch at issue is original to your client. Letter from Schaap of 3/5/04 at 7 ("[...][The design] was not copied from any watch."), Letter from Schaap of 9/29/04 at 2 ("[...][T]he author has provided a design which is far more than a trivial variation on any watch design previously existing."). Yet, material submitted with your original application seems to contradict this claim. The advertisement for the wristwatch included with your materials presents it as an "exclusive re-issue of a rare classic Steinhausen 1923 timepiece" and notes that "[w]e have painstakingly reproduced this handsome timepiece down to every detail...." We point out that if the subject work is, indeed, a replica or a close copy of an earlier watch design, it lacks originality because it was copied from a pre-existing work. *See, e.g., Alfred Bell & Co., Ltd. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-103 (2d Cir. 1951) (what is needed for protection of a work based on a preexisting work is that the author contributed something more than a "merely trivial" variation of the previous authorship); *The Bridgeman Art Library, Ltd. v. Corel* Corp., 25 F. Supp. 2d 421, 427 n41 (S.D.N.Y. 1998) (concerning derivative works, the originality requirement requires that there be a distinguishable variation between the work in which copyright is sought and the underlying work); and, *Feist* itself, 499 U.S. at 358 ("Originality requires only that the author make the selection or arrangement independently (i.e., **without copying that selection or arrangement from another work), and that it display some minimal level of creativity**."). (emphasis added). *See also Compendium II*, sections 202.03, 204.03.

Given the signed letters which you have submitted as your requests for reconsideration of registration for the watch design at issue here and the position put forth in those letters that the watch design contains creative and independent authorship sufficient, in your opinion, to justify registration, the Office will accept your assertion that the subject work is not purely a reproduction of a preexisting watch design and will continue with our analysis of the design.

B. Useful Articles and Separability

1. Legal framework for useful articles and separability.

Copyright does not extend to a useful article, defined as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101. However, works of artistic craftsmanship, which may be useful articles themselves or incorporated into a useful article, can receive protection as pictorial, graphic, or sculptural works pursuant to 17 U.S.C. § 102(a)(5). This protection is limited, though, in that it extends only "insofar as their form but not their mechanical or utilitarian aspects are concerned." *Id.* at § 101. The design of a useful article will be protected "only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." *Id.* This separability can be physical or conceptual. Congress has explained that:

> [A]lthough the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of . . . [an] industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from 'the utilitarian aspects of the article' does not depend upon the nature of the design — that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element and would not cover the over-all configuration of the utilitarian article as such.

H.R. Rep. No. 94-1476, at 55.

Physical separability means that the subject pictorial, graphic, or sculptural features must be able to be separated from the useful article by ordinary means. *Compendium II,* at section 505.04. Conceptual separability means that the subject features are "clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper, for example, or as a free-standing sculpture, as another example, independent of the shape of the

useful article, *i.e.*, the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article. The artistic features and the useful article could both exist side by side and be perceived as fully realized, separate works – one an artistic work and the other a useful article." *Compendium II*, section 505.03. For example, while a carving on the back of a chair cannot readily be physically separated from the chair, it can easily be conceptually separated because one could imagine the carving existing as a drawing. The chair, meanwhile, would still remain a useful article having retained its basic shape, even absent the carving. The carving would therefore qualify as conceptually separable.

We point out, however, that just because a feature is not necessary to or dictated by the utilitarian concerns of an article does not mean that the feature is automatically conceptually separable. If removing such features would destroy the useful article's basic shape, namely because the features are an integral part of the overall shape or contour of the useful article, then the features would not qualify as conceptually separable. Further, features which serve a function or usefulness within the article in question are, of course, not considered separable under the statutory definition.

We cite two cases which confirm the Office's understanding of, and position on, the congressionally-mandated prohibition of protecting any functional or utilitarian features of, as well as the overall shapes and configurations connected with, useful articles. *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), represents a seminal case regarding useful articles and separability. *Esquire* held that copyright protection is not available for the "overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape may be." In that case, the Office had refused to register an outdoor lighting fixture which arguably contained non-functional, purely aesthetic features. The court upheld the Office's refusal, noting that "Congress has repeatedly rejected proposed legislation that would make copyright protection available for consumer or industrial products." *Id.*[1] Similarly in *Norris Industries, Inc. v. International Telephone and Telegraph Corp.*, 696 F.2d 918, 924 (11th Cir. 1983), the court held that a wire-spoked wheel cover, although aesthetically designed, was not entitled to copyright protection because it was a useful article used to protect lugnuts, brakes, wheels, and axels from damage and corrosion, and it did not contain any sculptural design features that could be identified apart from the wheel cover itself.

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[1] Although *Esquire* was decided under the 1909 version of the Copyright Act, its reasoning is still applicable to cases arising under the 1976 Act. "[T]he 1976 Act and its legislative history can be taken as an expression of congressional understanding of the scope of protection for utilitarian articles under the old regulations." 591 F.2d 803. Since pre-1976 case law in part formed the basis for the 1976 Act, the reasoning of these earlier cases remains relevant to cases arising under the later Act.

After examining the subject watch and in light of the above-described legal framework, the Board has determined that the subject work is an intrinsically useful article.

2. The Watch is a useful article.

As the watch at issue is used to tell time, it "ha[s] an intrinsic utilitarian function that is not merely to portray the appearance of an article or to convey information," and is therefore a useful article according to 17 U.S.C. 101. We stress the word "an" intrinsic function. Even if a watch also has a decorative function, its timekeeping function is still enough to make it a useful article. *See also Severin Montres, Ltd. v. Yidah Watch Co.*, 997 F. Supp. 1262, 1265 (C.D. Cal. 1997) ("Plaintiffs concede, as they must, that a watch is a useful article with an intrinsic utilitarian function. Therefore, to be the proper subject matter of a copyright, the design of the watch must be separable from the utilitarian aspects of the watch.")

Even if the Copyright Office did consider the watch as a piece of jewelry, the test it would undergo as to whether there is sufficient separable authorship to sustain copyrightability would not change. No matter the label assigned to the watch, the watch has an undeniable intrinsic utilitarian function – that of telling time – a function which gives rise to the statutory need to separate aspects of function from aspects of decorativeness. In your requests for reconsideration, you appear to be suggesting that classifying this work within a group that traditionally receives copyright protection without being subjected to the separability test would grant the watch design more generous scrutiny in determining whether it qualifies for copyright protection even if it is also utilitarian. This argument is invalid. Pieces of jewelry that happen to be useful are judged by the same standard as other articles that are useful. *Cf., Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 418 (2d Cir. 1985) (holding that argument that mannequin forms designed for displaying clothing are actually sculpture and therefore did not need to undergo any separability test was without merit). You also cite a number of useful articles that have been issued copyright registration, claiming that these registrations compel a registration for the subject work. Yet, that conclusion misreads the law on determinations of sufficient authorship. All of the works you cite appear to have been issued registration based on a determination of the presence of sufficient separable authorship; physically or conceptually separable authorship is the required factor, no matter the category of works–belt buckles, candlesticks, lamps, banks, etc.

You bring up belt buckles that were copyrighted, arguing that permitting registration of these items but not of the wristwatch at issue represents a "dual standard." Letter from Schaap of 9/29/04 at 4-5. However, the descriptions of the titles of the works (seven of eight of which include animal names) suggest that these buckles conveyed the images of animals in ways that were conceptually separable from the buckles' utilitarian aspects. In other

words, these buckles were treated as useful objects, just as the wristwatch at issue is and were judged to contain separable authorship that was also copyrightable.

You also cite *Ted Arnold Ltd. v. Silvercraft Co., Inc.*, 259 F. Supp. 733 (S.D.N.Y. 1966). Letter from Schaap of 9/29/04 at 13. However, that case upheld registration of the work at issue after a determination that its outer casing was both separable from its functional aspects and also contained sufficient authorship to sustain a copyright registration. We see no contradiction between *Ted Arnold* and the Office's decision in the instant case concerning our classification of the watch design as a useful article and requiring the presence of separable authorship which also meets the standard for the minimum quantum of creativity. *Feist*, 499 U.S. at 359, 363.

3. The only separable element on the watch design is the image of the moon.

The Office has concluded that the image of the moon on the lower inset dial of the watch face is conceptually separable from the work's useful aspects.

The subject work contains no other pictorial, graphic, or sculptural features that could be separated from its utilitarian aspects without destroying its basic shape. All of the other design features of the watch contribute to its utilitarian function of providing information about the time; removal of these features would destroy the watch's ability to perform this function. The hands on the main watch face and the numbers and line markings around its edges are necessary for the watch to indicate the time of day. The inset dials and the words, numbers, and hands contained within them are necessary for the watch to indicate additional date and time information. The knob is necessary for setting the watch and the band is necessary for wearing it. Thus, the only non-functional design element lies in the image of the moon, somewhat resembling the outline shape of an open umbrella. We must, then, determine whether this particular, separable design meets the admittedly low *Feist* standard for copyrightability.

C. Original Works of Authorship

1. Legal framework for originality.

The mere fact that an artistic feature may be considered physically or conceptually separable from a utilitarian object in which it is embodied does not mean that it will necessarily merit copyright protection. All copyrightable works, be they sculptures, drawings, or otherwise, must also qualify as "original works of authorship." 17 U.S.C. § 102(a).

The term "original" consists of two components: independent creation and sufficient creativity. *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340, 345 (1991).

First, the work must have been independently created by the author, *i.e.*, not copied from another work. The Office will assume for the purpose of this portion of the analysis that your client did independently create the work.[2] Second, the work must possess sufficient creativity. 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* where the Supreme Court held that only a modicum of creativity is necessary.

Although *Feist* stated that the "requisite level of creativity is extremely low; even a slight amount will suffice," *id.*, the 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," *id.* at 363, and that there can be no copyright in 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) (2003) ("In order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form."); *Nimmer* at 2.01(b) ("[T]here remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright.").

Even prior to *Feist*, the Office 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, *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). After again examining the watch design at issue here and in light of the above-described legal framework, the Board has determined that the subject work does not contain any authorship that is both separable and copyrightable.

2. Moon image lacks sufficient originality for copyright registration.

After examining the subject work, the Office has concluded that its only separable element – the moon image – lacks sufficient originality to sustain a copyright registration. In determining when independent efforts are too trivial or insignificant to be copyrighted, the Office and courts have consistently found that such public domain elements as standard designs, figures, geometric shapes, and lettering are not sufficiently creative to support a copyright claim. *See 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

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[2] As previously discussed , additional materials submitted with this application stating that the watch is an exact replica of an earlier work make this assumption at least questionable if such materials are taken at face value.

designs, and mere variations of typographic ornamentation, lettering, 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 . . . ."); 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, minor variations or alterations or scant modifications to common shapes and symbols also do not provide the necessary new authorship to sustain a claim. *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.").

The simplified moon image falls within the limits of *de minimis* authorship. A simplified moon design such as that depicted on the face of the watch is merely a minor variation of a half- moon or of an open-umbrella, scalloped shape and is thus not copyrightable. Additionally, any aesthetic features of this image are inextricably intertwined with their utilitarian features since the moon is a conventional way for an analog watch to show whether a given time is a.m. or p.m. *See, e.g., Ellison Educational Equipment, Inc. v. Accu-Cut Systems, Inc.*, 769 F. Supp. 1090, 1102 (D. Neb. 1991) ("As there are an extremely finite number of ways to alter the shape of, for example, a dog bone and still have it readily be identifiable as a dog bone, granting Ellison copyright protection would in essence grant it a virtual monopoly.").

3. Watch design as a whole does not possess sufficient originality.

Even if, for the sake of argument, the Office conceded that every element on the watch face is conceptually separable and that, therefore, the entire watch face should be considered for the purpose of determining copyrightable authorship, none of the elements, either alone or in combination, have sufficient originality to sustain a copyright registration. As previously explained, common shapes and lines are in the public domain and thus are not afforded copyright protection. *Compendium II*, section 503.03(b). The small hash-mark lines around the edges of the watch face that indicate divisions of time are therefore uncopyrightable, as are the hands, which are common shapes such as arrowheads, teardrops, and rectangles, or scant or slight variations thereof; the umbrella shape on the chronometer dial is also not protectible in itself. And, as previously explained, numbers and simple words and phrases lie in the public domain. 37 C.F.R. 202.1. Therefore, the numbers do not constitute copyrightable authorship, either alone or in combination, and neither are the words indicating days of the week and months of the year protectible. The shape of the watch face as a whole and the smaller dials are all circles – a common shape that is also uncopyrightable in itself. *Compendium II*, section 503.03(b).

You argue that copyright law may protect a combination of elements that are unoriginal in themselves if there is sufficient originality in their selection and arrangement. Letter from Schaap of 9/29/04 at 14. Of course, some combinations of common or standard forms contain sufficient creativity with respect to how they 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). However, merely combining non-protectible graphic and text elements does not automatically establish creativity where the combination or arrangement itself is simplistic or too trivial in its overall configuration. For example, 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. v. New York Arrows Soccer Team*, 802 F.2d 989 (8th Cir. 1986). The Office finds that the moon image, even if looked at as a combination of elements rather than as one symbol, lacks sufficient originality for copyright registration. As a simple combination of a very small number of elements, its selection and arrangement do not demonstrate sufficient copyrightable authorship to sustain registration.

The Office also finds that the combination of public domain elements featured by the subject work in its entirety without reference to separability [merely for the sake of argument] does not, even then, meet the threshold level of creativity to sustain a copyright registration. The selection and arrangement of all design elements in the watch design at issue here lacks sufficient creativity: the arrangement at issue is obvious and almost inevitable because it is dictated by the purpose and conventions of watch design. The numerals are spaced evenly around the edges of the face with smaller markings spaced evenly between them to indicate smaller divisions of time. The smaller dials are inside the circle made by the numbering. Arranging the elements of a wristwatch this way is essentially an "age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course." *Feist* at 363. The elements are also very well known in the watch trade, both in themselves and as combined and arranged in a limited number of ways. *See, e.g., Florabelle Flowers, Inc. v. Joseph Markovits, Inc.*, 296 F. Supp. 304, 307 (S.D.N.Y., 1968); *Satava v. Lowry*, 323 F.3d 805, 812 n5 (9th Cir. 2003) (finding that a work that differs from others in the same category only by adding or subtracting standard elements did not show sufficient originality in its selection).

You cite *Ted Arnold Ltd. v. Silvercraft Co., Inc.*, 259 F. Supp. 733 (S.D.N.Y. 1966) and *Yurman Design Inc. v. PAJ Inc.*, 262 F.3d 101 (2d Cir. 2001) as examples of works that have been found sufficiently creative to sustain a copyright. Letter from Schaap of 9/29/04 at 12-14. However, the watch design at issue here is distinguishable from the works at issue in those cases. The work at issue in *Ted Arnold Ltd.*, a pencil-sharpener casing shaped like an antique telephone, was a "composite creation" that demonstrated artistic judgment by adapting and melding the numerous intricate details from a number of different antique

telephones into a new whole. 259 F. Supp. at 735. The subject work, by contrast, simply selects a small number of discrete elements standard for its type of work and arranges them in a way that is itself standard for that type of work.

The works at issue in *Yurman Design Inc.*, jewelry featuring gemstones and a twisted-cable motif, demonstrated sufficient originality in their combination because a comparison with other jewelry using those elements arranged in entirely different ways indicated that the plaintiffs had arranged the elements in an original way rather than one standard in the art. 262 F.3d at 101, 110. In contrast, the subject work simply combines its elements in a way common to watches and dictated by the confines of the form. A particular gemstone can appear once on a piece of twisted-cable jewelry or be repeated numerous times; that gemstone can be placed nearly anywhere on the piece of jewelry and, if repeated more than once, can be grouped or spaced in a large variety of ways. There is therefore ample room for originality in selecting a particular organization, as the plaintiff in *Yurman Design, Inc.* did. In contrast, once a creator of a watch has decided to use a particular element, such as a chronometer dial, the ways it can be arranged are very limited. Both convention and function dictate that there is only one chronometer dial and that that dial will be located in one of the very few locations that gives it enough space to make its numbering legible and minimally overlaps with either the centers of the hands or the numbering along the outside edge of the watch. Therefore, placing this chronometer dial according to this scheme, as you did in the subject work, does not demonstrate sufficient originality.

The near-exact resemblance between the subject work and the wristwatch depicted in an advertisement in a recent issue of *National Geographic* provides further evidence that the selection and arrangement of elements in the subject work lack sufficient original authorship for copyright protection. The fact that the subject work and the watch in *National Geographic* contain the same selection of elements arranged in an almost-identical manner suggests that this selection and arrangement are, indeed, near-standard in the art of watch design and therefore do not rise to the level of originality necessary for copyright protection.

D. Other Arguments.

1. Issuance of design patent does not necessarily lead to copyright registration.

You argue that the fact that the U.S. Patent and Trademark Office granted the wristwatch at issue a design patent means that the wristwatch must necessarily be found to have sufficient originality for copyright registration. Letter from Schaap of 9/29/04 at 6-7. However, this argument is invalid. Copyrights and design patents are judged by two different standards. A work that qualifies for a design patent "need not meet the copyright standard of separate identification and independent existence." See *Chisum on Patents*, § 1.04[5].

Your argument also finds no support in case law or other authority. In fact, until 1995 Copyright Office regulations established that a work that had been granted a design patent couldn't also receive copyright protection. 60 FR 15605, 15606. If it was only recently established that a work granted a design patent *can* also receive copyright protection, then it is far from establishing that that work *must* receive such protection.

2. Commercial success is irrelevant to determinations of copyrightability.

You note that many individuals "pay thousands of dollars for a wristwatch when numerous watches are available for less than a few hundred dollars," arguing that such usage indicates that these individuals consider their wristwatches to be pieces of jewelry rather than simply useful articles. Letter from Schaap of 9/29/04 at 6-7. Considerations of commercial success are irrelevant to determinations of copyrightability as a matter of law. *Compendium II*, section 505.05(a); *Paul Morelli Design, Inc. v. Tiffany & Co.*, 200 F. Supp. 2d 482, 488-89 (E.D. Pa. 2002).

IV. Conclusion

For the reasons stated above, the Copyright Office Review Board concludes that the watch design at issue here cannot be registered for copyright protection. This decision constitutes final agency action.

Sincerely,

/s/

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