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

February 17, 2006

Gene S. Winter, Esq.
St. Onge Steward Johnston & Reens LLC
986 Bedford St.
Stamford, Connecticut 06905-5619

Re: TIERED MULTIPLE STONE SETTING
Control # : 61-217-3360 [S]

Dear Mr. Winter:

I am writing on behalf of the Copyright Office Review Board[1] in response to your second request for reconsideration, dated December 1, 2004. After reviewing the application from Aaron Shum Jewelry, Ltd., and the arguments you presented on its behalf, the Board affirms the Examining Division's refusal to register Applicant's work, Tiered Multiple Stone Setting.

I. ADMINISTRATIVE RECORD

A. Initial Office refusal; first request for reconsideration; Office response to first request for reconsideration

By letter dated July 28, 2003, Examiner Joanna Corwin refused registration for the work Tiered Multiple Stone Setting because the work lacked sufficient creative authorship within the meaning of the copyright statute and settled case law. Letter from Corwin to Winter of 7/28/03, at 1. In a response letter dated October 27, 2003, you requested that the Copyright Office reconsider its refusal to register Applicant's jewelry design. You also submitted additional identifying deposit materials [which you referred to as "substitute" copies] to show the tiered stone setting more clearly. Letter from Winter to Corwin of 10/27/03, at 1. Arguing that jewelry is copyrightable, you described the copyrightable authorship in Applicant's work as the arrangement of the stones which creates "an illusion of a single, unified stone rather than an array of smaller stones when viewed from above." *Id.* In support of registration, you stated that Applicant's stone setting is different from all other jewelry designs, and you cited Paul Morelli Design, Inc. v. Tiffany and Co., 200 F.Supp. 2d 482, 487 (E.D. Pa. 2002).

In response, Attorney Advisor Virginia Giroux stated in a letter dated August 2, 2004, that, as a gemstone setting, Applicant's work is a useful article as defined in 17 U.S.C. 101. Applying the analysis for useful articles that is required by the *Compendium of Copyright Office Practices II* § 505

---

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

(1984) [hereinafter *Compendium II*], § 505, Ms. Giroux determined that Tiered Multiple Stone Setting does not exhibit any conceptually or physically separable aspects. She explained that "actual physical removal of the setting components, i.e., tiered and pronged elements as they are designed, is not possible without destroying the setting in its entirety." Letter from Giroux of 8/2/04, at 2. She also explained that the tiered shape and six prongs of the setting cannot be considered conceptually separable since these elements "serve[s] the purpose of holding and securing the gemstones in place." *Id.* Ms. Giroux added, in her analysis of the configuration of Tiered Multiple Stone Setting that, even if the Office were to concede that some components of the work at issue were separable, such elements would consist of common and familiar shapes such as circles, or minor variations thereof, and thus not be copyrightable. *Id.* at 2 - 3. Pointing out that the gemstones *per se* are not copyrightable elements, Ms. Giroux stated that the combination and arrangement of a few sculptural elements, if separable, coupled with the gemstones, if separable, would not carry a claim to copyright because of insufficient creativity. Since there are, therefore, no separable elements which are also copyrightable, Ms. Giroux upheld the examiner's refusal to register.

B. Second request for reconsideration

You submitted a second request for reconsideration, dated December 1, 2004. In addition to making the same arguments which you made in your October 27, 2003, request for reconsideration, you cited Donald Bruce & Company v. B.H. Multi Com Corp., 964 F.Supp. 265 (N.D. Ill. 1997) to support the proposition that rings, *per se*, are copyrightable because they are purely ornamental: their sole purpose is to portray their appearance. Letter from Winter to Board of Appeals of 12/1/04, at 1. You reason that, given that a ring is purely ornamental, it is "not necessary to consider whether the utilitarian elements of the setting are separable from the sculptural elements. The question is whether the jewelry consists of familiar shapes th[a]t are no [sic] copyrightable." *Id.* In order to support your position that the work at issue here, Tiered Multiple Stone Setting, is copyrightable, you have attached to your letter printouts showing some 125 different ring designs; you conclude that none of the rings shown are similar to the work in question and that the particular arrangement of the stones in the work at issue here "creates an illusion of a single unified stone" rather than a number of discrete, smaller stones; you conclude that such an "illusion effected by the array demonstrates more than enough creativity to qualify for copyright." *Id.* at 2. You cite a number of cases to support the proposition that courts have consistently determined that jewelry is copyrightable. *Id.*

II. DECISION

After reviewing the application and your arguments in favor of registering Applicant's work, the Review Board affirms the Examining Division's refusal to register Tiered Multiple Stone Setting. The Board affirms the refusal to register Applicant's work on the basis that it is functional in its nature, a setting for gemstones. The Board further concludes that, although the gemstones may arguably be said to be physically separable from the structure of the setting, in themselves and in their overall combination, they lack sufficient creativity to be copyrightable.

A. Description of Tiered Multiple Stone Setting

The work at issue here is a setting used for the placement of gemstones in a ring or in other pieces of jewelry. The work is made up of prongs and a web of metal bands that form a bed, or foundation, between the prongs to secure individual gemstones in place. We here reproduce the identifying material submitted for the work.

Image 1



Image 2



Image 3



A Supplemental Image



B. Useful articles

The Review Board agrees with you that rings may be copyrightable. The copyright statute provides that "pictorial, graphic and sculptural works include two-dimensional and three-dimensional works of fine, graphic and applied art... Such works shall include works of artistic craftsmanship

insofar as their form but not their mechanical or utilitarian aspects are concerned..." 17 U.S.C. 101 [statutory definitions]. Jewelry, long the subject of copyright protection, may fairly be called applied art. *Compendium II* § 502, in its directions for the registration of works of the visual arts, explicitly includes under the category "works of art" works of the "fine arts, such as paintings, other pictorial works, and sculpture, as well as works of artistic craftsmanship, such as jewelry, glassware, ceramic figurines..." Precedent some 50 years-old has referred to the fact that a "piece of costume jewelry is entitled to copyright protection and generally that right is not dependent upon judicial appraisal of its artistic merit." Trifari, Krussman & Fishel, Inc. v. Charel Co., Inc., 134 F. Supp. 551, 553 (S.D.N.Y. 1955). *See also* Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980); Weindling International Corp. v. Kobi Katz, Inc., 56 U.S.P.Q. 2d 1763, * 11 (S.D.N.Y. 2000) (referring to jewelry designs as "works of art, or more precisely ornamental sculpture, even if mass-produced.")

Although jewelry designs may be copyrightable, they are not automatically copyrightable merely because they are jewelry. Like all other works amenable to copyright protection, jewelry designs must meet the 1991 requirement that Feist set: the fundamental basis of copyright protection is a work's originality and originality has two components–independent creation and a modicum of creativity. Feist Publications, Inc. v. Rural Telephone Service Co., Inc., 499 U.S. 340, 345 (1991). And, although jewelry designs may fairly be classified as decorative art, a piece of jewelry may have incorporated into it a utilitarian aspect which, in itself and according to the statutory definition of works of artistic craftsmanship, *supra* at 3, is not the subject of copyright protection. Trifari states the general principle: "[S]o long as the material for which copyright is sought exhibits some degree of individuality so that the court is convinced that the author has created an original, tangible expression of an idea rather then a merely pleasing form dictated solely by functional considerations, copyright registration is available." Trifari, 134 F. Supp. at 553. Works of artistic craftsmanship are protected by copyright but not with respect to any functional or utilitarian aspect which may be embodied within them.

In the work at issue here, Tiered Multiple Stone Setting, Applicant is not seeking to register a ring. Based on your written requests for reconsideration, the Board concludes that Applicant is claiming protection for a gemstone setting.[2] You stated in your requests that Attachments 1 and 2 which you have submitted show the setting being used in either a ring or a pendant. Letter from Winter of 10/27/03, at 1. You have also invited the Board to examine drawings of the tiered setting and photographs showing the center stone removed from the setting. *Id.* These statements reasonably support a stated claim in the gemstone setting, not in the ring as a whole, an image of which appears in

---

[2] In your two requests for reconsideration, you requested that Attachments 1, 2, 3 and 4 be accepted as substitutes for the deposit material accompanying the application. However, the Copyright Office only received Attachments 1, a photocopy of Applicant's ring, and 4, photographs of other rings. An attorney for the Review Board spoke to your colleague, Andy Corea, Esq., to clarify this matter. In addition to faxing copies of the attachments, on December 3, 2005, Mr. Corea indicated that the deposit material for this application had been accidentally filed with another one of Applicant's applications and the deposit material for that application was placed with this case. Each set of deposit materials is now filed with the correct application.

Attachment 1. The title of the work given on the application form, "Tiered Multiple Stone Setting," is consistent with that interpretation. And, in your first request for reconsideration you described the functional aspect of Applicant's work by saying that it arranged the gemstones to create "an illusion of a single, unified stone rather than an array of smaller stones when viewed from above." Letter from Winter of 10/27/03, at 1.

We point out that gemstone settings traditionally serve the purpose of containing or positioning a gemstone or stones within a piece of jewelry, most frequently within a ring. In general, a gemstone setting is comprised of strips, columns, or small bars or pieces of metal that lift the gemstone from the surface of the band, securing the stone[s] and allowing the facets of the gemstone[s] to be seen more clearly. Again, based on the descriptions and explanation you have provided in your written requests for reconsideration, Tiered Multiple Stone Setting serves that function, as its name implies. The Board considers the work here–which is a part, or an aspect, of a ring or pendent [or what would ultimately become a ring or pendent] to be useful in its essence and, as such, subject to an analysis of separability in order to determine whether any particular pictorial, graphic or sculptural feature of the work, i.e., of the Setting, may be identified separately from the functional work–the Setting–itself. The Board has thus determined that the functional nature of a gemstone setting requires that Applicant's work be analyzed in terms applicable to a useful article under copyright law, regardless of its aesthetic merit. As defined by copyright law, a useful article has "an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. 101 (definition of "useful article").

The purpose of the separability analysis is to identify any pictorial, graphic or sculptural features of the work that are separate from its useful aspects. For this analysis, the feature may be either physically or conceptually separable. If the Board identifies a separable feature, the next step in its review is to determine whether the separable feature, or element, satisfies the originality requirements that are necessary for copyrightability. The Board's analysis of those two factors, separability and originality, as applied to Tiered Multiple Stone Setting, is set forth below.

C. Separability

If a useful article contains pictorial, graphic or sculptural features that "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article," those aspects may be entitled to copyright protection. 17 U.S.C. 101 (emphasis added). The legislative history of the Copyright Act of 1976 provides guidance on the analysis used to identify separable elements. The House Report accompanying the Act states that:

> [A]lthough the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects

> of that article, the design would not be copyrighted under the bill. The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design — that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such. (emphasis added)

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

Based on this legislative history, as well as the statutory definition and case law decided under both the 1909 and the 1976 Act, the Copyright Office promulgated its separability analysis. Section 505.02 of *Compendium II* (1984) states that:

> Registration of claims to copyright in three-dimensional useful articles can be considered only on the basis of separately identifiable pictorial, graphic, or sculptural features which are capable of independent existence apart from the shape of the useful article. Determination of separability may be made on either a conceptual or physical basis.

Conceptual separability exists when pictorial, graphic or sculptural features are "independent of the shape of the useful article, *i.e.,* the artistic features can be imagined separately and independently from the useful article without destroying the **basic shape of the useful article.**" (emphasis added) In the case of conceptual separability, *Compendium II* § 505.03, states:

> Conceptual separability means that the pictorial, graphic and sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic or sculptural work which can be visualized on paper, for example, or as 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. Thus, carving on the back of a chair, or pictorial matter engraved on a glass vase, could be considered for registration.

The Board has not identified any elements of Tiered Multiple Stone Setting that are conceptually separable from its utilitarian function. The work at issue here is made up of prongs and a web of metal bands that form a bed, or foundation, between the prongs to secure individual gemstones in place. Each of the elements of the setting is an integral aspect of the function of the setting because, together, they serve the purpose of holding or securing gemstones in place. As such, the overall configuration of the functional setting cannot be perceived as existing side by side with the work for which registration is sought here–the shape of the work at issue here is co-extensive with the shape of the functional/utilitarian article and, thus, no conceptual separability is present.

Physical Separability. The Board has also determined that physical removal of the setting components, *i.e.*, the prongs and bed, or foundation, as the structure as a whole is designed, is not possible without destroying the shape of the setting. However, the Board has determined that the gemstones in the setting are features that are physically separable from the utilitarian aspects of Tiered Multiple Stone Setting. A physically separable element does not have any functional aspect and can be actually removed from the useful article without destroying the work in its entirety. However, we have stated that we believe the work for which registration is sought is the structural metal setting supporting the gemstones, *supra* at 4. Nevertheless, accepting for the sake of argument that the work for which copyright registration is sought is the combined metal setting/support AND the gemstones within that setting support, we point out that the physical removal of the gemstones from their supporting structure necessarily alters the work which would be described as the combined authorship of the setting and the stones at issue here. Such alteration, under *Compendium II's* test for physical separability, would destroy the work which is arguably described as the combined setting and stones. Further, if we were to accept an assertion that the work to be registered is the combination of setting and stones, the work would be amenable to a copyrightability analysis only with respect to the arrangement of the stones: since we have previously categorized the setting as functional in its essence, the setting configuration must be filtered out when the overall work is considered for copyrightability purposes. What is left for analysis is the grouping or arrangement of stones.

D. Originality

Copyright law states that protection is only available for "original works of authorship." 17 U.S.C. 102. In Feist, the Supreme Court stated that originality consists of two elements, "independent creation plus a modicum of creativity." Feist, 499 U.S. at 345. *Accord,* Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102 (2nd Cir. 1951) ("'Original' in reference to a copyrighted work means that the particular work 'owes its origin' to the 'author.' No large measure of novelty is necessary.") Originality in the copyright sense consists of independent creation plus some modicum of creative contribution by the author.

The Board accepts that Applicant's work satisfies the first prong of the originality requirement for independent creation. It has determined, however, that Tiered Multiple Stone Setting lacks sufficient creativity to satisfy the second prong. The gemstones, individually or as a whole, are simple, minor variations on common shapes or symbols. Each is a geometric shape, one square and four elliptical, that are arranged in a commonplace manner.

It is axiomatic that the requisite level of creativity for copyright is very low. However, the Supreme Court has stated 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." Feist, 499 U.S. at 363. There can be no copyright in works in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." Id. at 359. A work that reflects an obvious arrangement fails to meet the low standard of minimum creativity required for copyrightability. Id. at 362-363. An example would be alphabetical listings in the white pages of telephone books which the Supreme Court characterized as "garden variety...devoid of even the slightest trace of creativity." Id. at 362.

Even prior to Feist, Copyright Office registration practices following settled precedent recognized that some works of authorship contain only a *de minimis* amount of authorship and, thus, are not copyrightable. *See Compendium II* § 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.* at § 503.02(a). *Compendium II* recognizes that it is not aesthetic merit, but the presence of creative expression that is determinative of copyrightability. Section 503.02(a) states:

> [R]egistration cannot be based upon the simplicity of standard ornamentation such as chevron stripes, the attractiveness of a conventional fleur-de-lys design, or the religious significance of a plain, ordinary cross. Similarly, it is not possible to copyright common geometric figures or shapes such as the hexagon or the ellipse, a standard symbol such as an arrow or a five-pointed star. Likewise, mere coloration cannot support a copyright even though it may enhance the aesthetic appeal or commercial value of a work. . . . The same is true of a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations."

The requirement for more than a *de minimis* level of creativity is also reflected in Copyright Office regulations that delineate broad categories of authorship that are not subject to copyright because they are in the public domain, such as familiar symbols or designs [37 CFR 202.1(a)]; such symbols would include common shapes such as circles, squares and triangles.

The Board finds that the combination of the gemstones does not rise to the level of copyrightable authorship. As part of our analysis, we look to case law which, although addressing two-dimensional designs as opposed to the three-dimensional sculptural lines at question here, nevertheless articulates the necessity for something more than minor variations on familiar and commonplace design elements. In John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, Inc., 802 F.2d 989 (8th Cir. 1986), the court upheld a refusal to register a logo consisting of four angled lines forming an arrow, with the word "arrows" in cursive script below, noting that the design lacked the minimal creativity necessary to support a copyright and that a "work of art" or a "pictorial, graphic or sculptural work ... must embody some creative authorship in its delineation of form." *See also*, Magic

Marketing, Inc. v. Mailing Services of Pittsburgh, Inc., 634 F. Supp. 769 (W.D. Pa. 1986) (envelopes with black lines and words "gift check" or "priority message" did not contain minimal degree of creativity necessary for copyright protection); Forstmann Woolen Co. v. J.W. Mays, Inc., 89 F. Supp. 964 (E.D.N.Y. 1950) (label with words "Forstmann 100% Virgin Wool" interwoven with three fleur-de-lys held not copyrightable); Homer Laughlin China Co. v. Oman, 22 U.S.P.Q.2d 1074 (D.D.C. 1991) (upholding refusal to register chinaware design pattern composed of simple variations or combinations of geometric designs due to insufficient creative authorship to merit copyright protection); Jon Woods Fashions 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 design did not meet minimal level of creative authorship necessary for copyright).

You submitted examples of many other rings to emphasize the novel or unique nature of the design in Tiered Multiple Stone Setting. The examination for copyrightability does not include a comparison to other works. Originality in copyright law does not include a requirement for comparison to prior works. *Compendium II* § 108.03. Each individual work submitted for registration is considered on its own merits, without regard to any other specific work[s]. As the legal principles above emphasize, a simple pattern or design that is made up of a very few elements that themselves are common shapes or designs, may not have sufficient authorship to be copyrightable.

Based on these requirements for the creativity prong of originality, the Board finds that the gemstones in Tiered Multiple Stone Setting do not have more than a *de minimis* amount of creativity. The gemstones are common shapes. One is square and the other four are elliptical. Individually, each gemstone is a minor variation on a common shape or design. As a whole, the overall arrangement or composition of four elliptical shapes around a square in the center is commonplace and typical, lacking the necessary quantum of original authorship.

For the reasons stated in this letter, the Copyright Office Review Board affirms the Examining Division's refusal to register Tiered Multiple Stone Setting. This decision constitutes final agency action on this matter.

Sincerely,

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