United States Copyright Office
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September 14, 2012

Via First Class Mail and Fax

Maxim H. Waldbaum
Eaton and Van Winkle
3 Park Avenue
New York, New York 10016

Re: GAMES
Control Number: 61-324-8851(S)

Dear Mr. Waldbaum:

I am writing on behalf of the Copyright Office Review Board in response to your letter dated February 6, 2006, on behalf of your client, Diamond Championship Co., Ltd. ("Diamond"), in which you requested the Copyright Office ("Office") to reconsider its refusal to register a copyright claim for GAMES. We apologize for the lengthy delay in responding to your request. The Board has carefully examined the application, deposit materials, and all correspondence in this case and affirms the denial of the registration for GAMES as a three-dimensional sculptural work.

I. DESCRIPTION OF THE WORKS

The work consists of a rolled-up leather pouch with stitching along the seams and a snap fastener to hold the pouch closed. When the pouch is unrolled, the inside contains two leather pockets to hold metal Tic-Tac-Toe playing pieces (stylized "X"s and "O"s) and two leather straps which can be fastened to hold four braided leather "sticks" with have silver balls attached to each end. These sticks are to be used to lay out the tic-tac-toe playing field on the unrolled leather pouch. The metal pieces are to be used to play the tic-tac-toe game on the playing field.

II. ADMINISTRATIVE RECORD

On February 28, 2005, the Copyright Office received your application for registration of the claim the work entitled "GAMES" on behalf of your client Diamond Championship Co., Ltd. (Listed as "Diamond Champion Ltd." on the application). The application listed the nature of the work as a "JEWELRY DESIGN' and listed the nature of authorship as a three-dimensional sculpture and as a jewelry design created as a work made for hire. The application does not disclose any preexisting material on which this work is based or any new material added to this work.

On May 18, 2005, Visual Arts Examiner Joy Fisher Burns denied registration on the basis of insufficient creative authorship. Letter from Burns to Waldbaum of 5/18/2005, at 1.

In a letter dated July, 19, 2005, you requested that the Copyright Office reconsider Ms. Burns' refusal to register the claim in GAMES. You maintained that the work contained sufficient creative authorship to support a claim of registration because, inter alia:

- it builds upon the familiar children's game of "*Tic-Tac-Toe*;"
- it incorporates a unique "playing field" that artistically combines silver and fabric in a textured manner;
- the sticks, "which can be arranged at the player's discretion," are made of a unique silver rope ending with an intricately designed silver ball form;
- the sticks contain some of the features of the unique jewelry designs of John Hardy, the employee of Diamond Champion Co., Ltd. who created the design at issue, that have previously been registered with the Copyright Office;
- the design of the sticks "is the same unique [braided] chain design (known as the Ceramic Inlay Station Chain) in many of Hardy's copyrighted bracelets and necklaces; and
- the lettering of the game pieces is original and artistic with "uniquely rounded edges and artistically exaggerated features."

Letter from Waldbaum to the Chief of the Receiving and Processing Division of 7/19/2005, at 2.

On November 18, 2005, Attorney-Advisor Virginia Giroux-Rollow responded to your request for reconsideration on behalf of the Examining Division and affirmed the Copyright Office's refusal to register the claim for GAMES. Ms. Giroux-Rollow pointed out that because the work consists of a "pouch" that holds the contents of the game, it meets the statutory definition of a "useful article." She explained that useful articles are only copyrightable to the extent that physically or conceptually separable elements can be regarded as a work of art apart from the shape of the useful article. Letter from Giroux-Rollow to Waldbaum of 11/18/2005, at 2.

Ms. Giroux-Rollow stated that the Examining Division agreed with you that some elements are separable, but found that these separable elements, either individually or in combination, did not contain sufficient authorship to support a claim of registration. *Id.* Finding that the work was a useful article with separable elements that did not contain sufficient creative authorship, Ms. Giroux-Rollow expressed the Examining Division's affirmance of the refusal to register GAMES.

By letter dated February 6, 2006, you requested a second reconsideration of the Copyright Office's refusal to register the claim in GAMES. Letter from Waldbaum to Copyright R&P Division of 2/6/2006, at 1. You correctly point out that the requisite level of originality has a low threshold and that originality has two components: independent creation and a sufficient degree of creative authorship. You also correctly state that

determining a sufficient quantum of creativity is not susceptible to bright line rules or broad principles. *Id.*, at 1-2.

You then argue that even if individual components of a design are familiar symbols or designs, or slight variations of basic shapes, the combination of such shapes can for a copyrightable work of art and, therefore, Hardy's use of geometric shapes in the GAMES design should not affect its copyrightability. *Id.* at 2. You note that while your client does not dispute the Examiner's characterization of the game pieces being "common and familiar," Hardy maintains that variations of common shapes can satisfy the requirement of copyrightability. In addition, your client maintains that the combination of shapes in the GAMES design satisfies the low threshold of copyrightability and that these unique designs are not found in the prior art. *Id.*

By comparing a generic *Tic-Tac-Toe* grid to the GAMES design, you maintain that the combination of silver and fabric create an artistic textured look. You also state that the sticks, "which can be arranged at the player's discretion," are comprised of a "unique silver rope that come to a stop with an intricately designed silver ball form." *Id.* at 3. You point out that the sticks use "the same unique chain design (know as the Ceramic Inlay Station Chain) in many of Hardy's copyrighted bracelets and necklaces." *Id.* You continue that this unique chain design "artistically weaves strands of silver that form Hardy's copyrighted signature rope design in a number of Hardy's registered works." *Id.* You also maintain that the lettering of the game pieces is originally and artistically designed and that the combination of all of these elements results in a design that has more than a spark of creativity. To support this argument, you cite the *Compendium of Copyright Office Practices II*, Ch. 500, §503 (1984) (hereinafter *Compendium II*) for the proposition that "a design, otherwise original, may be registerable even though it incorporates uncopyrightable standard forms, such as circles and squares." Letter from Waldbaum to Copyright R&P Division of 2/6/2006, at 3.

You then discuss the case law cited by the Examiner to highlight the low threshold of sufficient creativity required to support copyrightability and attempt to distinguish the cases that deny copyrightability on the basis that the Hardy design contain more creativity, as evidenced by the sufficient creativity already established in other Hardy jewelry designs that have been registered by the Copyright Office. *Id.* at 4. You also maintain that the "combination of otherwise familiar shapes" distinguishes this case from other cases denying copyrightability. Further, in order to overcome the precedent of Homer Laughlin China Co. v. Oman, U.S.P.Q.2d 1074 (D.D.C. 1991), you state that "[g]iven the absence of "bright line rules" in determining copyrightability, the finding there should compel a similar result here." [internal citation omitted.] Letter from Waldbaum to Copyright R&P Division of 2/6/2006, at 4. Rather, you argue that the Copyright Office should rely on its own decisions to register the Applicant's other designs that similarly relied on geometrical motifs and the combination of otherwise familiar shapes into an artistic design. *Id.*

You go on to cite a number of cases where designs objectively simpler and less "creative" than the GAMES design at issue nevertheless were accorded copyright

protection. *Id.* at 5. You also rely on Yurman Design Inc. v. PAJ, Inc., 93 F. Supp. 2d 449 (S.D.N.Y. 2000), for the proposition that viewing designs as "merely unprotectable agglomerations of basic design elements already within the public domain would be akin to accepting the position that every song is merely a collection of basic notes, every painting a derivative work of color and stroke, and every novel merely an unprotected jumble of words." Yurman, at 457. You conclude that the GAMES design is "significantly more creative and complex than certain designs that are routinely granted copyright registration" and caution the Office not to approach the analysis with a "don't bother me with the facts, my mind is made up method of decision." Letter from Waldbaum to Copyright R&P Division of 2/6/2006, at 6, *citing,* In re Khelghatian, 364 F.2d 870, 873 n.2 (C.C.P.A. 1996).

III. DISCUSSION AND DECISION

The Copyright Office Review Board agrees with you that there is a low level of creative authorship necessary to support a registration and that there are no "bright line rules" when it comes to assessing the sufficiency of creative authorship. However, there are threshold statutory requirements for copyrightability that must be considered before the issue of sufficiency. Your second request for reconsideration does not address a number of these statutory requirements, some of which were addressed by the Examining Division in response to your first request for reconsideration.

First, although your client's application claims that the nature of the work is a "jewelry design," and lists the claim of "authorship" as both three-dimensional sculptural authorship and jewelry design authorship, the Review Board finds that neither the deposit or description of the work support a claim in jewelry design. As Visual Arts Examining Practices state, the term "jewelry" includes: "any decorative article, fixed in any tangible medium of expression, which is intended to be worn as personal adornment, whether hung, pinned or clipped onto the body (such as necklace, bangle or earring) or pinned, clipped or sewn onto clothing (such as brooch, pin or beaded motif)." Visual Arts Section Examining Practices on "Jewelry Designs." There is nothing in this claim that falls within the Copyright Office's view of "jewelry."

> To the extent that the claim is for sculptural authorship, §101 of the Copyright provides a definition for "pictorial, graphic and sculptural works": "Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work 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.

17 U.S.C. §101.

This definition includes a limitation on the scope of protection for pictorial, graphic and sculptural works that contain utilitarian aspects. The GAMES design is composed, in part, of a pouch, pockets and clasps to hold game pieces and parts, and to bundle the entire game, including the "playing field." Thus, some of the features of the GAMES design serve a utilitarian purpose. Section 101 of the Copyright Act also defines "useful articles."

> A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article".

17 U.S.C. §101.

The GAMES pouch fits the definition of a useful article. It serves an intrinsic utilitarian function as a container for the individual elements, e.g., the *Tic-Tac-Toe* pieces and the sticks. While the pieces and the sticks are physically separable from the pouch, the pouch itself does not contain any other physically or conceptually separable elements.

The standard for physical separability is identified in the *Compendium of Copyright Office Practices II*:

> Separability test physical basis. The physical separability test derives from the principle that a copyrightable work of sculpture which is later incorporated into a useful article retains its copyright protection. Examples of works meeting the physical separability test include a sculptured lamp base of a Balinese dancer, or a pencil sharpener shaped like an antique car. However, since the overall shape of a useful article is not copyrightable, the test of physical separability is not met by the mere fact that the housing of a useful article is detachable from the working parts of the article.

Compendium II, § 505.04 (1984).

The pieces and the sticks are physically separable from the pouch, because removing them does not affect the function of the pouch or its ability to hold items. The pouch could very easily hold pieces for another type of game or elements unrelated to a game. There are no other parts of the pouch that are physically separable.

The next question is whether there are any elements of the pouch that are conceptually separable. The standard for conceptual separability is also identified in the *Compendium II*:

> Separability test: conceptual basis. Conceptual separability means that the pictorial, graphic, or 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 test of conceptual separability, however, is not met by merely analogizing the general shape of a useful article to works of modern sculpture, since the alleged "artistic features" and the useful article cannot be perceived as having separate, independent existences. The shape of the alleged "artistic features" and of the useful article are one and the same, or differ in minor ways; any differences are de minimis. The mere fact that certain features are nonfunctional or could have been designed differently is irrelevant under the statutory definition of pictorial, graphic, and sculptural works. Thus, the fact that a lighting fixture might resemble abstract sculpture would not transform the lighting fixture into a copyrightable work.

Compendium II., § 505.03 (1984).

There are no "artistic features" of the pouch that are clearly recognizable as a pictorial, graphic or sculptural work which can be visualized on paper, as a free-standing sculpture independent of the shape of the useful article. The stitching, pockets, ties and clasp are all parts of the useful article that serve a utilitarian purpose.

Since the pouch is a useful article, the separable elements of which are the sticks and the pieces, it is only these latter elements that may be considered for sufficient creative authorship to support a claim of copyright.

Examining these items individually, the pieces consist of stylized "X"s and "O"s. While they are aesthetically pleasing, they are no more than minor variations on common geometric shapes. Indeed, some semblance of these shapes are functional in relation to the *Tic-Tac-Toe* game. To the extent that these common geometric shapes represent "X"s and "O"s, they are not an original selection, but merely a variation on a standard theme. Further, the particular variations of these letters are trivial. The "O"s are "X"s are familiar symbols or designs and could also be considered mere variations of typographic ornamentation or lettering. Such designs are not subject to copyright. 37 CFR §202.1(a) (July 1, 2005). The *Compendium II* states:

> Minimal standards: sculptural material. The requisite minimal amount of original sculptural authorship necessary for registration in Class VA does not depend upon the aesthetic merit, commercial appeal, or symbolic value of a work. Copyrightability is based upon the creative expression of the author, that is, the manner or way in which the material is formed or fashioned. Thus, registration cannot be based upon standard designs which lack originality, such as common architecture moldings, or the volute used to decorate the capitals of Ionic and Corinthian columns. Similarly, it is not possible to copyright common geometric figures or

> shapes in three-dimensional form, such as the cone, cube, or sphere. The mere fact that a work of sculpture embodies uncopyrightable elements, such as standard forms of ornamentation or embellishment, will not prevent registration. However, 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., § 5035.02(b) (1984).

These pieces are familiar symbols entirely typical for use in *Tic-Tac-Toe*. The "O"s are symmetrical ovals with a square in the middle – the combination of two common shapes in three-dimensional form consisting of positive and negative space.[1] The "X"s are familiar variations of a symmetrical cross in three-dimensional form. These de minimis variations do not rise to the level of creative authorship necessary to sustain a claim of copyright. The inclusion of five of each of these pieces is completely devoid of creative selection, since five pieces of each shape are necessary for the traditional game of *Tic-Tac-Toe*.

The braided sticks contain more creativity, but copyright law places a limit on their copyrightability. You state that the sticks use "the same unique chain design (know as the Ceramic Inlay Station Chain) in many of Hardy's copyrighted bracelets and necklaces." Letter from Waldbaum to Copyright R&P Division of 2/6/2006, at 3. You also state that this unique chain design "artistically weaves strands of silver that form Hardy's copyrighted signature rope design in a number of Hardy's registered works." *Id.* As such, the "chain design" is derivative of your client's prior registrations. Before such a work can be copyrightable, it must incorporate new creative authorship. 17 U.S.C. §103. The "unique chain design" that is used on the sticks is a preexisting work and provides no new authorship to support a claim in that feature. Moreover, it appears that in arguing that "chain design" has a distinctive look that is unique to Hardy, you are asserting that Hardy's design share a unique, distinctive look that distinguishes it from the designs of other chains or braids. If that is your argument, it is self-defeating. While it may be that the first time Mr. Hardy incorporated this "unique" or distinctive look into a design, it demonstrated copyrightable authorship (assuming that one could describe just what that "look" consists of and ascertain whether it is, in fact, original), its subsequent use in his other designs would be incontestably *un*original. The Office's examining practices with respect to different versions of a work specifically state that registration for different versions of a work, i.e., for multiple works which contain a core of identical authorship but which also contain some variation or additional authorship element[s], each version must reflect "copyrightable differences distinguishable under the copyright law." Compendium II, Ch. 600, § 610 (1984). See also Compendium II, § 610.04

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[1] The Board notes that square hole washers virtually identical to the "O's" can easily be found on the Internet. See, *e.g.*, http://www.salesfastener.com/showpro.asp?prod_id=1173; http://www.trainz.com/p-254557-lionel-1028-5-square-hole-washer.aspx.

(1984)("Registering different versions of a published work: versions containing uncopyrightable differences").

The combination of the uncopyrightable "chain design" with identical "silver ball tips" is a trivial combination of elements and is insufficient to support a claim of authorship in the sticks. Further there is no copyrightable arrangement of the sticks in this claim. As you clearly point out, the sticks "can be arranged at the player's discretion...." Letter from Waldbaum to Copyright R&P Division of 2/6/2006, at 3. There is no fixation of the arrangement by your client. Any possible fixation of an arrangement of the sticks is purely at the discretion of the user of the game. Even if the user were to arrange the sticks in an original manner unrelated to the *Tic-Tac-Toe* grid, such an arrangement would not constitute Hardy's arrangement. Your client simply provides the sticks and leaves the arrangement to the "player's discretion."

For the foregoing reasons, the Copyright Office Review Board does not find any separable creative authorship to sustain a claim of copyright in this work. While the functional pouch contains physically separable elements, none of these elements contains sufficient new creative authorship to support a registration. The Copyright Office Review Board affirms the denial of registration.

Sincerely,

/s/

David O. Carson
General Counsel
for the Copyright Office Review Board