United States Copyright Office
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May 2, 2014

Weil, Gotshal & Manges LLP
Attn: Randi W. Singer
767 Fifth Avenue
New York, NY 10153

Re: 940226119 (Bridal Ring Design)
940226119_21 (Bridal Ring Design)
Correspondence ID: 1-FOTBS6

Dear Ms. Singer:

The Review Board of the United States Copyright Office (the "Board") is in receipt of your second request for reconsideration of the Registration Program's refusal to register the works entitled: *940226119 (Bridal Ring Design)* and *40226119_21 (Bridal Ring Design)*. You submitted this request on behalf of your client, Sterling Jewelers, Inc., on September 11, 2013.

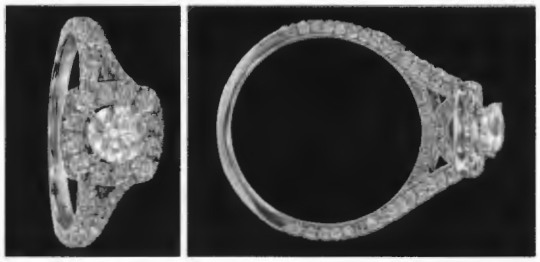
The Board has examined the application, the deposit copies, and all of the correspondence in this case. After careful consideration of the arguments in your second request for reconsideration, the Board affirms the Registration Program's decision to deny the registration of these copyright claims. The Board's reasoning is set forth below. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action on this matter.

I. DESCRIPTION OF THE WORKS

940226119 (Bridal Ring Design) and *40226119_21 (Bridal Ring Design)* (the "Works") are jewelry designs. A description of each work is set forth below.

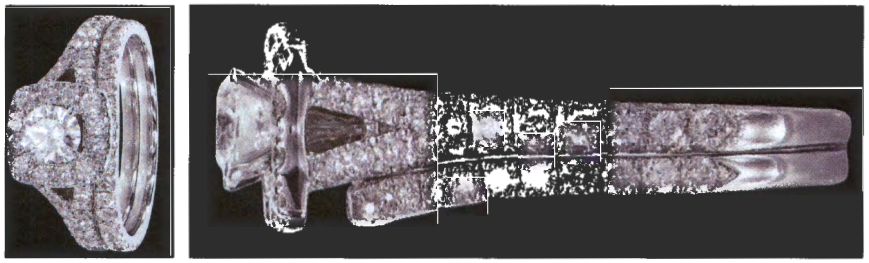
940226119 (Bridal Ring Design)

This work is an "engagement ring" design that includes a large, round-cut diamond that is framed by a border of smaller round-cut diamonds. The ring's band is pavé with diamonds, except for a small portion at its bottom. Each side of the band contains an additional channel of round cut diamonds. The channels of diamonds on the sides of the band are bordered with milgrain edging. The images below are photographic reproductions of the work from the deposit materials:



(2) 940226119_21 (Bridal Ring Design)

This work is an "engagement ring" and "wedding band" design. The engagement ring portion of the work is indistinguishable from *940226119 (Bridal Ring Design)* (described above). The wedding band portion of the work is comprised of a band set with a channel of round-cut diamonds. The wedding band is curved so that it abuts the engagement ring if worn at the same time on the same finger. The images below are photographic reproductions of the work from the deposit materials:



II. ADMINISTRATIVE RECORD

On December 11, 2012, the United States Copyright Office (the "Office") issued a letter notifying Sterling Jewelers, Inc. (the "Applicant") that it had refused registration of the Works. *Letter from Wilbur King, Registration Specialist, to Randi Singer* (Dec. 11, 2012). In its letters, the Office stated that it could not register the Works because they lack the authorship necessary to support a copyright claim. *Id.*

In a letter dated March 1, 2013, you requested that the Office reconsider its refusal to register the Works pursuant to 37 C.F.R. § 202.5(b). *Letter from Randi Singer to Copyright RAC Division* (Mar. 1, 2013) ("First Request"). The Office reviewed the Works in light of the points raised in your letter and again concluded that they "do not contain a sufficient amount of original and creative artistic or sculptural authorship in either the treatment or arrangement of their elements." *Letter from Stephanie Mason, Attorney-Advisor, to Randi Singer* (June 12, 2013).

Finally, in a letter dated September 11, 2013, you requested that the Office reconsider for a second time its refusal to register the Works pursuant to 37 C.F.R. § 202.5(c). *Letter from Randi Singer to Copyright R&P Division* (Sept. 11, 2013) ("Second Request"). In arguing that the Office improperly refused registration, you claim the Works include at least the minimum amount of creativity required to support registration under the standard for originality set forth in *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340 (1991). *Second Request passim.* In support of this argument, you claim that the author's careful selection and arrangement of the Works' constituent elements possess a sufficient amount of creative authorship to warrant registration under the Copyright Act. *Id.*

In addition to *Feist*, you cite several cases in support of the general principle that, to be sufficiently creative to warrant copyright protection, a work need only possess a "modicum of creativity." *Id.* You also cite several cases demonstrating that jewelry designs comprised of otherwise unprotectable elements are acceptable for copyright protection if the selection and arrangement of their elements satisfies the requisite level of creative authorship. *Id.*

III. DECISION

A. *The Legal Framework*

All copyrightable works must qualify as "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a). As used with respect to copyright, the term "original" consists of two components: independent creation and sufficient creativity. *See Feist*, 499 U.S. at 345. First, the work must have been independently created by the author, meaning that it must not be copied from another work. *Id.* Second, the work must possess a sufficient amount of creative expression. *Id.* While only a modicum of creativity is necessary, the Supreme Court ruled that some works (such as the telephone directory at issue in *Feist*) fail to meet the creativity requirement. *Id.* 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. It further found that there can be no copyright in a work in which "the creative spark is utterly lacking or so trivial as to be nonexistent." *Id.* at 359.

The Office's regulations implement the long-standing requirements of originality and creativity set forth in the Copyright Act and in the *Feist* decision. *See* 37 C.F.R. § 202.1(a) (prohibiting registration of "familiar symbols or designs"); *see also* 37 C.F.R. § 202.10(a) (stating "[i]n order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form").

Case law recognizes that a work of jewelry may be entitled to copyright protection for "the artistic combination and integration" of constituent elements that, considered alone, are unoriginal. *See, e.g., Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101 (2d Cir. 2001). However, the mere simplistic arrangement of non-protectable elements does not automatically demonstrate the level of creativity necessary to warrant protection. *See Feist,* 499 U.S. at 358 (finding the Copyright Act "implies that some ways [of selecting, coordinating, or arranging uncopyrightable material] will trigger copyright, but that others will not"). Ultimately, the copyrightability of a combination of standard design elements depends on whether the selection, coordination, or arrangement is done in such a way that the design as a whole constitutes a work of original authorship. *See Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989).

To be clear, common and simplistic arrangements of unprotectable elements do not satisfy this requirement. For example, in *DBC of New York v. Merit Diamond Corp.*, 768 F. Supp. 414 (S.D.N.Y. 1991) the Office refused to register a ring consisting of three elements, namely, a set of gemstones flanked by two triangular-cut gemstones with triangular indentations in the band on opposite sides of the stone setting. In a subsequent infringement action, the plaintiff contended that the ring contained sufficient originality to support a finding of copyrightability. The district court explained that familiar symbols or designs are not entitled to copyright protection (citing 37 C.F.R. § 202.1) and that no copyright may be claimed in squares, rectangles, or other shapes. *See* 768 F. Supp. 2d at 416. The court also rejected the plaintiff's "gestalt theory that the whole is greater than the sum of its parts," because "on the whole," the plaintiff's rings were "not exceptional, original, or unique." *Id.*

Finally, Copyright Office Registration Specialists and the Board do not make aesthetic judgments in evaluating the copyrightability of particular works. They are not influenced by the attractiveness of a design, the espoused intentions of the author, the design's uniqueness, its visual

effect or appearance, its symbolism, the time and effort it took to create, or its commercial success in the marketplace. *See* 17 U.S.C. § 102(b); *see also Bleistein v. Donaldson*, 188 U.S. 239 (1903). The fact that a work consists of a unique or distinctive shape or style for purposes of aesthetic appeal does not automatically mean that the work, as a whole, constitutes a copyrightable "work of art."

B. *Analysis of the Works*

After carefully examining the Works and applying the legal standards discussed above, the Board finds that they do not contain a sufficient amount of creative expression to warrant registration. Below we describe each work and explain why it does not satisfy the creativity requirement.

940226119 (Bridal Ring Design)

The Board finds that the constituent elements of this work, considered individually, are not sufficiently creative to warrant protection. The work is an engagement ring design comprised of the following elements: (1) a standard ring band; (2) round cut diamonds of various sizes in common settings; and (3) simple milgrain edging. Ordinary ring bands, settings, gemstones, and standard milgrain techniques are public domain symbols, shapes, or designs that are ineligible for copyright protection. *See* 37 C.F.R. § 202.1(a) (prohibiting the registration of "familiar symbols or designs"). Accordingly, these constituent elements do not qualify for registration under the Copyright Act.

The Board also finds that the work, considered as a whole, fails to meet the creativity threshold set forth in *Feist*. 499 U.S. at 359. The Board accepts the principle that jewelry designs comprised of combinations of unprotectable elements may be eligible for copyright registration. But in order to be registered such combinations must contain some distinguishable variation in the selection, coordination, or arrangement of their elements that is not so simple or obvious that the "creative spark is utterly lacking or so trivial as to be nonexistent." *Id.*; *see also Atari Games*, 888 F.2d at 883 (finding a work should be viewed in its entirety, with individual noncopyrightable elements judged not separately, but in their overall interrelatedness within the work as a whole).

The work consists of a simple arrangement of a large round gemstone surrounded by smaller gemstones of equivalent shape and size, and set atop an ordinary ring band. The band is covered on its face and sides with a single row of round gemstones with uniform milgrain edging. Each element is used in this ring in a predictable and customary way exhibiting, at best, a *de minimis* amount of creativity – even when the work is viewed in its entirety.

The fact that one diamond is larger than the others is a minor spatial or linear variation that does not provide the requisite amount of creativity to support a registration. Placing a single row of diamonds on the surface of a ring is a standard design arrangement, and the Board sees no creativity in the use of milgrain edging along the sides of the ring. The overall shape of the ring consists of a standard, symmetrical configuration that lacks any distinguishing sculptural variation. *Feist,* 499 U.S. at 359; *DBC of New York*, 768 F. Supp. 2d at 416. Regardless of the amount of skill involved in selecting, sorting, and placing the unprotectable diamonds on this work (*see Second Request* at 3) the resulting design, as a whole, is merely a slight deviation from an ordinary engagement ring design. Accordingly, we conclude that the work, as a whole, lacks the requisite "creative spark" necessary for registration.

940226119_21 (Bridal Ring Design)

The Board finds that the constituent elements of this work do not contain a sufficient amount of creative expression to warrant protection. The work combines (1) two standard ring bands (one slightly thicker than the other); (2) diamonds of various shapes and sizes in common settings; and (3) simple milgrain edging. Ordinary ring bands, settings, gemstones, and standard milgrain techniques are public domain symbols, shapes or designs that are ineligible for copyright protection. *See* 37 C.F.R. § 202.1(a). Thus, none of the work's constituent elements warrant registration.

The Board also finds that the work, in its entirety, fails to meet the creativity threshold set forth in *Feist*. 499 U.S. at 359. The work combines *940226119 (Bridal Ring Design)* (which is not copyrightable for the reasons discussed above) with a simple wedding band. The wedding band is accented with a single channel of uniformly shaped diamonds and milgrain edging. The simple arrangement of these elements does not meet the admittedly low threshold of creativity needed to support a registration. Likewise, there is an insufficient amount of authorship in the mere combination of a standard wedding band with a *de minimis* engagement ring design. Accordingly, we conclude that the work, as a whole, lacks the requisite "creative spark" necessary for registration.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusals to register *940226119 (Bridal Ring Design)* and *40226119_21 (Bridal Ring Design)*. This decision constitutes final agency action on this matter. 37 C.F.R. § 202.5(g).

Maria A. Pallante
Register of Copyrights

BY: _____
Erik Bertin
Copyright Office Review Board