The Register of Copyrights of the United States of America
United States Copyright Office · 101 Independence Avenue SE · Washington, DC 20559-6000 · (202) 707-8350

February 21, 2013

Davis Wright Tremaine LLP
Attention: Edward J. Davis
1633 Broadway
New York, NY 10019-6708

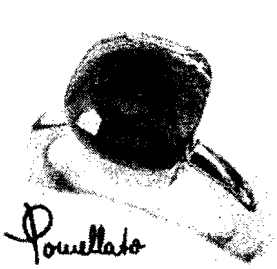
Re: NUDO (ring)
Copyright Office Control No. 61-505-5305(D)

Dear Mr. Davis:

On behalf of the Copyright Office Review Board (the "Board") I am responding to your request for reconsideration of the Examining Division's refusal to register the NUDO ring design. We apologize for the long delay in resolving this case and providing you with the determination of the Review Board. The Review Board has carefully examined the application, the identifying materials, and all the correspondence in this case. After careful consideration of the arguments in your letter and the identifying reproductions, the Board affirms the denial of registration due to lack of copyrightable authorship.

I. DESCRIPTION OF THE WORK

Before proceeding with our discussion of the copyrightability of the NUDO ring design, reproductions of identifying material are depicted below. The design consists of a large color stone in a generally square shape with rounded corners. The stone is highly faceted. The setting is a similarly square shape which is slightly smaller than the stone, so it cannot be seen when viewed directly from the top.





II. ADMINISTRATIVE RECORD

A. Initial submission

On June 5, 2007, the Copyright Office received from you an application, identifying material, and fees to register a ring design entitled NUDO on behalf of Pomellato S.p.A ("Pomellato"). By letter dated July 5, 2007, Visual Arts Examiner Robin Jones refused registration for this work because it lacked the authorship necessary to support a copyright claim. Letter from Jones to Davis (Jul. 5,

2007), at 1. She stated that copyright protects original works of authorship which are fixed in some tangible form, referencing 17 U.S.C. § 102(a). *Id.* at 1. Citing *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340, 345 (1991), Ms. Jones explained that the term "original" means that the work is independently created by the author and that it possesses at least a minimal degree of creativity. *Id.*

Ms. Jones stated that to satisfy the creativity requirements, a work of the visual arts must contain a minimum amount of pictorial, graphic, or sculptural authorship. She clarified further that copyright did not protect familiar symbols or designs; basic geometric shapes; words and short phrases, such as names, titles, and slogans, or mere variations of typographic ornamentation, lettering, or coloring. *Id.* Ms. Jones also explained that neither the aesthetic appeal or the commercial value of a work, nor the amount of time and effort expended to create a work are factors that are considered under the copyright law, citing *Bleistein v. Donaldson*, 188 U.S. 239 (1903), and *Feist*, 499 U.S. 340. The question, she asserted, was whether there was sufficient creative authorship within the meaning of the copyright statute and under settled case law. Applying those standards, Ms. Jones concluded that the design could not support a claim to copyright. *Id.*

B. First request for reconsideration

By letter dated October 4, 2007, you sought reconsideration of the refusal to register the NUDO design. Letter from Davis to Jones (Oct. 4, 2007), at 1. Included with your letter were new identifying photographs which you claimed better demonstrated the original graphic and sculptural authorship of the design.

You stated that both the Copyright Office and the courts recognized that works need only contain a minimal amount of creative expression to be copyrightable, citing *Compendium of Copyright Office Practices, Compendium II* (1984) ("*Compendium II*"), and *Feist*, 499 U.S. at 345. You asserted that the expression could be found in the shape of the jewelry, and the recasting of possibly familiar elements in original ways. You cited *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101 (2nd Cir. 2001) and *Weindling Int'l, Corp. v. Kobi Katz, Inc.*, 2000 WL 1458788 (S.D.N.Y. 2000) as supporting registration in this instance. *Id.*

While conceding that "basic geometric shapes" and "familiar designs" are not copyrightable, you contended that the NUDO design was not basic or familiar but rather a highly original arrangement of shapes recast into a distinctive new form. The stone, you argued, featured an innovative sculpted design that recasts the traditional concept of a cut stone in an original way. You further characterized the NUDO stone as "an innovative, sculpted design that recasts the traditional concept of a cut stone . . . with sharp, irregular geometric facets covering the top of a square, pillow-shaped stone with rounded corners, and smooth, unfaceted, gently puffed-out sides." You asserted that the faceting alone represented an original geometric design. Moreover, you argued that the distinctive design of the surface and the sculptural shape resulted from artistic choices, not functional needs. *Id.* at 2.

You further stated that the design may contain many individual geometric shapes, such as the small facets, and the rounded-square silhouette of the stone, but the design nonetheless resulted from

countless artistic decisions modifying and combining those shapes with other shapes in exactly selected proportions and in relationship to one another to create a new work that was original. You cited *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759 (2d Cir. 1991) as supporting registration. *Id.* at 3.

In addition, you maintained that the interplay between the gold bezel and the stone creates a "visually striking and innovative spatial arrangement" that makes the stone appear to be "floating" above the gold band. This effect is attributed to the use of a bezel that is slightly smaller to hold the stone without the use of visible brackets or prongs. In conclusion, you stated that the artistic design as expressed in the "unique layout, proportions, structure, and arrangement of all the elements" embodies more than the modicum of creativity needed to support a copyright in the work. *Id.*

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

On February 26, 2008, Ms. Virginia Giroux-Rollow, for the Examining Division, responded to your first appeal for reconsideration of the Visual Arts Section's refusal to register. It was her conclusion that the work did not contain a sufficient amount of original and creative artistic or sculptural authorship to support a copyright registration. Letter from Giroux-Rollow to Davis (Feb. 26, 2008) ("Giroux-Rollow letter"), at 1.

Ms. Giroux-Rollow began by stating that the material utilized in a work does not determine copyrightability, and therefore the fact that the work was made of plain or beveled gold and fashioned with a colored gem stone did not contribute to the copyrightability of the work. Ms. Giroux also maintained that your letter for first reconsideration sought copyright registration for "the manner or process in which the faceting and cutting had been configured." She responded that in order to be copyrightable, a work must not only be original, but it must also "possess more than a *de minimis* quantum of creativity," citing *Feist*. She elaborated that ideas, concepts, and processes which may be embodied in a work are not protectable by copyright. Moreover, she stated that under section 102(b) of the copyright law, copyright protection does not extend to "an idea, process, procedure, system, method of operation, concept, principle, or discovery . . . ." Therefore, the process or manner used to cut the stone in order to produce a faceted pattern could not be the subject of copyright protection. *Id.*

She noted further that copyright does not protect familiar geometric shapes or patterns, or minor variations thereof, citing Copyright Office regulation 37 C.F.R.§ 202.1. She then explained that it has been the practice of the Copyright Office to refuse copyright registration for faceting when it may be perceived as a combination of standard and common geometric shapes in 3-dimensional form. *Id.* at 2, citing *Compendium II*, §§ 503.02(a) and (b) (1984).

Addressing the elements of the ring design, Ms. Giroux-Rollow was of the opinion that neither the facets nor the overall arrangement of them constitutes copyrightable authorship. She also reiterated that the process of accomplishing the faceted patterns in the proper manner so as to reflect the maximum brilliance of the gemstone could not be protected. Next, she noted that a setting was a functional aspect of the jewelry design not subject to protection, but did not stop her analysis there. She continued concluding that even if the beveled setting was treated as decorative, its sculptural aspects were too simple and unadorned to be considered a copyrightable work of art. She also

considered all the elements in combination, again concluding that the design was *de minimis* composed of pre-existing or noncopyrightable elements arranged in a simple configuration. *Id.*

However, she did agree with your assertions regarding *Feist* that the amount of creativity necessary for copyright is very low, but she also found that the works in this instance failed to meet even the low threshold for copyrightable authorship set forth in *Feist.* She clarified further that neither the unique manner of cutting the gemstone, the distinctive appearance of the design, or the commercial success of the design could be considered in determining copyrightability. *Id.* at 2-3. Finally, she further distinguished the works involved in *Weindling* 65 U.S.P.Q.2d 1763 and *Yurman,* 263 F.3d 101 from the NUDO ring design involved in this instance, providing a more detailed description of the artistic elements of the Kobi Katz bridge ring and the Yurman bracelets and earrings that led to a determination that those works, unlike the KUDO design, contained a sufficient amount of creative authorship to support a copyright. *Id.* at 3.

D. Second request for reconsideration

In a letter dated May 23, 2008, you filed a second appeal for reconsideration arguing that your client was seeking protection for the design of the ring as a whole and not individual elements of the design. You also clarified that the claim for copyright was not based on the process of creating the ring, wishing to dispel any confusion the Office may have on this point. Letter from Davis to Review Board (May 23, 2008) ("Second Request"), at 1.

You then provided a description of the ring and asserted that careful study of the photographs which identify the work reveals that the ring is a creative, sculptural design, appropriately protected by copyright. *Id.* Specifically, you noted the "unique design of irregular geometric facets on the top, rounded edges and corners, and smooth, gently "pillowed-out" sides, nested in a setting that echoes the stone's shape on a smaller scale and cannot be seen from above, holding the stone apparently floating above a toroidal band." *Id.* at 2.

You argued that the faceting on the stone consists of an original design because the recognizable geometric shapes are combined in an original, irregular design which is complex and creative. In addition, you asserted protection in the setting of the ring. You claim that because the setting is smaller than the stone, and has no visible brackets or prongs, it remains invisible when viewed from above, giving a ring a "nude" appearance. *Id.*

While you have provided detailed descriptions of individual elements in the design, your claim is not reliant on any particular element, but rather the claim lies in the overall design of the stone with the other elements. In fact, you have acknowledged that it is impossible to copyright common geometric figures and simple combinations, and you have noted that it is not the mere presence of such elements that decides the question of copyrightability, but their overall arrangement, citing to *Compendium II,* § 503.02(b) ("The mere fact that a work of sculpture embodies uncopyrightable elements, such as standard forms of ornamentation or embellishment, will not prevent registration."). *Id.* at 1-2.

In support of your claim, you again cite the case of *Weindling* 65 U.S.P.Q.2d 1763. Like the ring in that case, you state the faceting, the shape of the stone, the setting and the band are combined and arranged in an entirely original, creative way. *Id.* at 2. You also cite *Yurman*, 263 F.3d 101 as protecting a work similar to your client's. You have contended that the NUDO ring, just as the ring in *Yurman*, was created by recasting and rearranging familiar constituent elements in several original ways. Specifically, you argued that "Nudo recast the familiar elements of band and faceted stone in several original ways, including irregular facets of the stone, [] the distinctive pillowy shape of the stone, the particular partially hidden setting, and the ring's general floating relationship to the bezel and the band." *Id.* at 3.

Finally, you discussed the standard for determining originality. You agreed with the Office's position that only a minimum amount of creative authorship is required. You then stated that a jewelry design will meet this requirement unless it contains only "utilitarian" design elements, or be "utterly devoid of any original creativity," citing *DBC of New York, Inc. v. Merit Diamond Corp.*, 768 F. Supp. 414, 416-17 (S.D.N.Y. 1991) and *Vogue Ring Creations, Inc. v. Hardman*, 410 F. Supp. 609, 612 (D.R.I. 1976). *Id.*

III. DECISION

A. Legal standard

1. Copyrightable Subject Matter and Originality

The Board recognizes that jewelry designs can be protected by copyright as "pictorial, graphic, and sculptural works." 17 U.S.C. § 102(a)(5) (2003). However, all copyrightable works, including jewelry designs, must be original works of authorship. 17 U.S.C. § 102(a). As used with respect to copyright, the term "original" consists of two components: independent creation and sufficient creativity. *Feist,* 499 U.S. at 345. First, the work must have been independently created by the author, *i.e.*, not copied from another work. We assume for purposes of this second request for reconsideration that the design of the ring submitted for registration was independently authored by Pomellato. Therefore, the first component of the term "original" is not at issue in the analysis set forth herein. Second, the work must possess sufficient creativity. For the reasons set forth below, the Board has determined that the NUDO ring design does not possess the requisite amount of creativity and, therefore, is not entitled to copyright protection.

2. Originality and Creativity

The fundamental basis of copyright protection is a work's originality. As both you and Ms. Giroux-Rollow have already noted, the requisite quantum of creativity necessary to sustain a copyright is quite low. Not all works meet this standard. In *Feist*, the Supreme Court stated that there can be no copyright in works in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Feist,* 499 U.S. at 359. The Court also observed that "as a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity." *Feist,* 499 U.S. at 363; *see also Diamond Direct LLC v. Star Diamond Group, Inc.,* 116 F. Supp. 2d 525, 528 (S.D.N.Y. 2000) ("So the level of creativity

necessary to support copyright is modest indeed. While no precise verbal formulation can capture it, there is some irreducible minimum beneath which a work is insufficiently original to find protection"), and 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 2.01(B) (2002) ("[T]here remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright.).

Even prior to the *Feist* decision, the Office recognized the modest, but real, requisite level of creativity necessary to sustain a copyright claim. *Compendium II* states that "works that lack even a certain minimum amount of original authorship are not copyrightable." *Compendium II* § 202.02(a). With respect to pictorial, graphic, and sculptural works – the class into which the subject design falls – *Compendium II* states that a "certain minimal amount of original creative authorship is essential for registration." *Compendium II* § 503.02(a). *Compendium II* also recognizes that it is the presence of creative expression that determines the copyrightability of a work, and that

> "[R]egistration cannot be based on the simplicity of standard ornamentation . . . . 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 may enhance the aesthetic appeal or commercial value of a work."

Compendium II § 503.02(a). *See also* 37 C.F.R. § 202.1(a) ("familiar symbols or designs" are "not subject to copyright and applications for registration of such works cannot be entertained.").

In applying this standard, courts have consistently found that standard designs, figures, and geometric shapes are not sufficiently creative to meet the required quantum threshold. *See Bailie v. Fisher,* 258 F.2d 425 (D.C. Cir. 1958) ("Register [of Copyrights] may properly refuse to accept for deposit and registration 'objects not entitled to protection under the law'"); *Homer Laughlin China Co., v. Oman,* 22 U.S.P.Q.2d 1074 (D.D.C. 1991) (upholding refusal to register "gothic" pattern composed of simple variations and combinations of geometric designs due to insufficient creative authorship to merit copyright protection); *OddzOn Prods. Inc. v. Oman,* 924 F.2d 346 (D.C. Cir. 1991) ("Koosh" ball comprising common sphere shape not registrable as sculptural work); *DBC of N.Y, Inc. v. Merit Diamond Corp.*, 768 F.Supp. 414, 416 (S.D.N.Y. 1991) (upholding a refusal to register a jewelry design of graduated marquise and trillion cut diamonds on a knife-edged shank on the basis of the commonplace symbols and familiar designs). *See also Nimmer* § 2.01[B], 2-14.

Although the Board generally agrees with the cases you cite and the arguments you make with respect to the relatively low threshold of creativity necessary to sustain a copyright, we cannot agree with your conclusion that the NUDO ring design meets this threshold, either by virtue of its constituent elements or their combination.

3. Selection, Coordination and Arrangement

The Office nevertheless recognizes that the use of public domain elements, of commonly known and/or geometric shapes, and of familiar symbols may yet result in a copyrightable jewelry

design as long as the overall resulting design, or overall pattern, taken in its entirety, constitutes more than a trivial variation of the constitutive elements. The complementary principles that a work of authorship should be considered as a unified entity in order to determine its copyrightability and that a work may be copyrightable even if it is composed of elements all of which are not copyrightable in themselves are principles established in case law and which the Copyright Office applies in its examining procedures. See *Atari Games Corp. v. Oman*, 979 F.2d 242, 245-56 (D.C.Cir. 1992) (a work viewed as a whole may be subject to copyright due to its selection and arrangement of otherwise unprotectable elements); *Diamond Direct*, 116 F. Supp. 2d at 528 ("[W]hile component parts are not entitled to copyright protection simply by virtue of their combination into a large whole, copyright may protect the particular *way* in which the underlying elements are combined – if the particular method of combination is itself original." (Emphasis in original). Indeed courts have also recognized instances in which jewelry has enjoyed copyright protection for the artistic combination and integration of constituent elements that, considered alone, are unoriginal. *See, e.g., Yurman*, 262 F.3d at 109.

However, merely combining non-protectable elements does not establish creativity where the combination or arrangement itself is simplistic or minor in its overall configuration. For example, in *Jon Woods Fashions, Inc. v. Curran*, 8 U.S.P.Q. 2d 1870 (S.D.N.Y. 1988), the district court upheld the Register's decision that a fabric design consisting of striped cloth over which a grid of 3/16" squares was superimposed, even though distinctively arranged or printed, did not contain the minimal amount of original artistic material necessary to merit copyright protection. Similarly, the Eighth Circuit upheld the Register's refusal to register a simple logo, consisting of four angled lines which formed an arrow and the words "Arrows" in cursive script below the arrow. *John Muller & Co. v. N.Y. Arrows Soccer Team*, 802 F.2d 989 (8th Cir. 1986).

Moreover, this principle was reaffirmed by the court in *Feist* which noted that a work that reflects an obvious arrangement fails to meet the low standard of minimum creativity required for copyrightability. *Feist*, 499 U.S. at 362-63. Indeed, the work before the Court in *Feist* purported to be a copyrightable combination of elements, but failed to meet the necessary quantum of creative authorship, and was instead found to be a "garden variety" arrangement of noncopyrightable elements. *See id.* at 358, (the Copyright Act "implies that some 'ways [of combining uncopyrightable material] will trigger copyright, but others will not," with the determination resting on the presence of creativity in selection, coordination, and arrangement of material.).

Nor is it the number of possible combinations that determines originality. The Board notes that in theory an author creating any work has an unlimited choice of alternatives. However, it is not the possibility of choices that determines copyrightability, but whether the resulting expression contains copyrightable authorship. The fact that an author had many choices does not necessarily mean that the choice the author made meets even the modest creativity requirement of the copyright law. As the Ninth Circuit announced:

> [I]t is not true that *any* combination of unprotectable elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectable elements is eligible for copyright protection only if those elements

> are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.

Satava v. Lowry, 323 F.3d 805, 811 (9th Cir. 2003).

B. Analysis of the work

The Review Board has examined carefully the elements you identified in your letter of second reconsideration which you claim supports copyright registration. These elements include the general shape of stone, the irregular geometric facets on the stone, the setting, the combination of these elements, and the visual affect of the design. Second Request at 1-2. In another portion of the letter, you describe the "uniquely sculpted stone with its unique design of irregular facets." *Id.* at 3.

The faceting of the stone and the generally square shape with rounded edges of the stone are, standing alone, too standard to support copyright protection. The facets are simple geometric shapes, albeit irregular, but the irregularity is only a slight variation on the common shape. Likewise, the rounded edges and corners of the otherwise fundamentally square shape of the stone are again just slight common variations on the basic shape. The Board also finds the setting to serve a functional purpose in which its general shape is dictated by the shape of the stone. Moreover, the Board agrees with Ms. Giroux-Rollow that even if the setting was considered decorative, its sculptural aspects are too simple and unadorned to be considered a copyrightable "work of art." Giroux-Rollow letter at 2. Therefore, the only means by which the various non-protectable elements in the finger ring could possibly sustain a copyright would be if their particular combination or arrangement exhibited a sufficient level of creativity. In the Board's view, they do not.

The number of elements in the NUDO design is not large. The ring design is essentially a large, multi-faceted stone in a generally square shape which is placed in a setting slightly smaller that the stone. As *Compendium II* states, "[t]he 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*, § 503.02(b). The fact that a ring has a specific width and shape, which is of course true of any fixed object, does not mean that such width and shape embodies sufficient creativity to support a copyright registration. Minor spatial variations do not give rise to the necessary amount of creativity to support a copyright registration. The Board notes that in theory an author creating any work has an unlimited choice of alternatives. However, it is not the possibility of choices that determines copyrightability, but whether the resulting expression contains copyrightable authorship. *See Satava v. Lowry*, discussed *supra* § I.A.3. *See also Florabelle Flowers, Inc. v. Joseph Markovits, Inc.*, 296 F. Supp. 304, 307 (S.D.N.Y.) (an "aggregation of well known components [that] comprise an unoriginal whole" cannot support a claim to copyright). The Office considers only those authorship elements actually present in the deposit materials submitted with the application for registration, not those that could have been selected. In this case, the combination of the faceted stone, its shape, and its setting is quite simplistic and fails to rise to the threshold of minimum creativity needed to sustain a copyright.

Your reference to the "uniquely sculpted stone" and "unique design of irregular facets" also has no bearing on the design's copyrightability. Uniqueness is material to a patent analysis, not to a

copyrightability analysis. As is well-settled, two identical works may both be registered for copyright protection, provided that each was independently created and contains the requisite level of creativity. While uniqueness may indeed in some cases be a by-product of originality and creativity, it is neither necessary nor sufficient in itself to support a copyright registration. *See* Nimmer § 7.21(A) ("After all, two parties may theoretically both compose the identical poem, each maintaining its own viable but independent copyright. The standard for copyright protection is originality, not novelty; were that latter standard applicable, as it is in patent law, then the Office would need to conduct a search of the "prior art," which it is not equipped to do.").

Likewise, the visual affect of the ring design cannot be a factor in determining copyrightability. In the case of a work of visual art, that review is limited to the actual appearance of the work, and does not extend to its commercial success or aesthetic appeal. *See Paul Morelli Design, Inc. v. Tiffany and Co.*, 200 F. Supp. 2d 482, 488 (E.D. Pa 2002) ("Works may experience commercial success even without originality and works with originally may enjoy none whatsoever. Nothing has been presented to us showing any correlation between the two."); *see also Compendium II*, § 503.02(b) ("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.").

C. Case law

You also relied on caselaw to argue that the NUDO ring design should be registered by comparing it to other works. Specifically, you cited two cases for this purpose: *Yurman,* 262 F.3d 101 and *Weindling,*56 U.S.P.Q.2d 1763, an unreported decision in which the court, in the very first paragraph of the opinion, expressed doubt as to its precedential value. You maintained that like the ring in *Weindling*, the individual elements in the Kudo ring design are "arranged in an entirely original, creative way." The Board does not agree.

The Kobi Katz bridge ring at issue in *Weindling* consisted of a single marquis diamond that was transversely mounted between two outwardly flaring pyramidal supports which have pointed upper apex ends. In addition, the pyramidal support, which was further embellished with triangular cut-outs, had sharp edges along the top of their apexes and sharp edges at the side edges of the apex about the triangular cut-outs. In upholding the copyrightability of the Kobi Katz ring, the court in *Weindling* analyzed the various aspects of the jewelry design in question as part of its analysis of copyrightability. *Weindling*, 56 U.S.P.Q.2d at 1765-77. The court found that the choices made by Kobi Katz resulted in a jewelry design that, in a number of enumerated respects, was creative. Similarly, in *Yurman*, the Second Circuit considered a collection of bracelets and earrings consisting of gold and silver twisted cable combined with cabochon-cut colored stones. The court found these designs to be copyrightable because of the way Yurman "recast and arranged those constituent elements." *Yurman*, 262 F.3d at 110. The court described the jewelry as an "artistic combination and integration of these elements," including the particular way in which the gemstones and precious metals "are placed, balanced, and harmonized." *Id.* at 109.

Such is not the case here. Unlike the courts findings in *Weindling* and *Yurman*, the Board, finds that the NUDO ring design, upon examination of its elements individually and as a whole, does

not contain a sufficient amount of original and creative authorship to sustain a copyright claim. The Board believes the NUDO design consists of basic elements and combinations that are mere trivial variations of public domain elements, and cannot support a copyright registration.

III. CONCLUSION

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

Sincerely,

Tanya Sandros
Deputy General Counsel
for the Review Board
United States Copyright Office