United States Copyright Office
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May 29, 2014

Pryor Cashman LLP
Attn: Dyan Finguerra-DuCharme
7 Times Square
New York, NY 10036-6569

Re: ***Possession Necklace***
Correspondence ID: 1-IVJTQN

Dear Ms. Finguerra-DuCharme:

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 work entitled: *Possession Necklace*. You submitted this request on behalf of your client, Richemont International S.A. and Piaget, Branch of Richemont International S.A. (the "Applicant") on April 11, 2014.

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 denial of registration of this copyright claim. 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 WORK

Possession Necklace (the "Work") is a jewelry pendant design. The design consists of two interlocking, circular bands that attach to a necklace chain via a small, round diamond that is inset in metal. The smaller of the bands is engraved with the word "POSSESSION." The larger of the bands is decorated with a channel of diamonds. The below image is a photographic reproduction of the Work from the deposit materials:



II. ADMINISTRATIVE RECORD

On August 30, 2013, the United States Copyright Office (the "Office") issued a letter notifying the Applicant that it had refused registration of the above mentioned Work. *Letter from Robin Jones, Registration Specialist, to Dyan Finguerra-DuCharme* (Aug. 30, 2013). In its letter, the Office stated that it could not register the Work because it lacks the authorship necessary to support a copyright claim. *Id.*

In a letter dated September 12, 2013, you requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusal to register the Work. *Letter from Dyan Finguerra-DuCharme to Copyright RAC Division* (Sept. 12, 2013) ("First Request"). Upon reviewing the Work in light of the points raised in your letter, the Office concluded that the Work "does not contain a sufficient amount of original and creative artistic or sculptural authorship in either the treatment or arrangement of its elements to support a copyright registration" and again refused registration. *Letter from Stephanie Mason, Attorney-Advisor, to Dyan Finguerra-DuCharme* (Jan. 13, 2014).

Finally, in a letter dated April 11, 2014, you requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Work. *Letter from Dyan Finguerra-DuCharme to Copyright R&P Division* (Apr. 11, 2014) ("Second Request"). In arguing that the Office improperly refused registration, you claim the Work includes at least the minimum amount of creativity required to support registration under the standard for originality set forth in *Feist Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). *Second Request*, passim. In support of this argument, you claim that the Applicant's selection and arrangement of the Work's constituent elements possess a sufficient amount of creative authorship to warrant registration under the Copyright Act. Specifically, you assert that the Applicant's claim of copyright is directed to the arrangement of its unprotectable elements into a "unique," "balanced," and "harmonized" pendant design arrangement. *Second Request* at 4.

In addition to *Feist*, your argument references 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* at Exhibit A. You also reference several cases that demonstrate 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 and direct the Board's attention to several examples of registered works that you assert "exhibit less creativity" than the Work at issue. *Id.* at 3-5.

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, *i.e.*, not copied from another work. *Id.* Second, the work must possess sufficient creativity. *Id.* While only a modicum of creativity is necessary to establish the requisite level, the Supreme Court has ruled that some works (such as the telephone directory at issue in *Feist*) fail to meet this threshold. *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 law and, subsequently, the *Feist* decision. *See* 37 C.F.R. § 202.1(a) (prohibiting registration of "[w]ords and short phrases such as names, titles, slogans; familiar symbols or designs; [and] mere variations of typographic ornamentation, lettering, or coloring"); *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 instances in which jewelry has enjoyed copyright protection for "the artistic combination and integration" of constituent elements that, considered alone, are unoriginal. *See Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101 (2d Cir. 2001). However, as noted, the mere simplistic arrangement of non-protectable elements does not automatically establish 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 determination of copyrightability in the combination of standard design elements rests on whether the selection, coordination, or arrangement is done in such a way as to result in copyrightable authorship. *Id.*; *see also Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989).

To be clear, the mere simplistic arrangement of unprotectable elements does not automatically establish the level of creativity necessary to warrant protection. For example, the Eighth Circuit upheld the Copyright Office's refusal to register a simple logo consisting of four angled lines which formed an arrow and the word "Arrows" in a cursive script below the arrow. *See John Muller & Co., Inc. v. NY Arrows Soccer Team, Inc.*, 802 F.2d 989 (8th Cir. 1986). Likewise, the Ninth Circuit held that a glass sculpture of a jellyfish that consisted of elements including clear glass, an oblong shroud, bright colors, proportion, vertical orientation, and the stereotypical jellyfish form did not merit copyright protection. *See Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003). The court's language in *Satava* is particularly instructional:

> [i]t is true, of course, that a combination of unprotectable elements may qualify for copyright protection. But it 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.

Id. (internal citations omitted) (emphasis in original).

Finally, Copyright Office Registration Specialists (and the Board, as well) 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 Work*

After carefully examining *Possession Necklace*, and applying the legal standards discussed above, the Board finds that the Work fails to satisfy the requirement of creative authorship.

First, the Board finds that none of the Work's constituent elements, considered individually, are sufficiently creative to warrant protection. As noted, 37 C.F.R. § 202.1(a), identifies certain elements that are not copyrightable. These elements include: "[w]ords and short phrases such as names, titles, slogans; familiar symbols or designs; [and] mere variations of typographic ornamentation, lettering, or coloring." *Id.* Here, the Work is a pendant necklace design that is comprised of the following elements: (1) two circular bands, (2) diamonds of various shapes and sizes; (3) the word "POSSESSION," and (4) a round, metal diamond inset. Pursuant to 37 C.F.R. § 202.1(a), ordinary circular bands, gemstones, and round metal insets are all public domain symbols, shapes or designs that are ineligible for copyright protection. *See id.* (prohibiting the registration of "familiar symbols or designs"). The word "POSSESSION" is also ineligible for copyright protection. *See J. Racenstein & Co., Inc. v. Wallace*, 51 U.S.P.Q. 2d 1031 (S.D.N.Y. 1999) (indicating a word or short phrase, alone, generally cannot support a copyright claim); *see also Coach, Inc. v. Peters*, 386 F. Supp 2d 495, 498-99 (indicating mere variations in typographic ornamentation or lettering cannot support a copyright claim). Accordingly, we conclude that the Work's constituent elements do not qualify for registration under the Copyright Act.

Second, the Board finds that the Work, considered as a whole, fails to meet the creativity threshold set forth in *Feist*. 499 U.S. at 359. As explained, the Board accepts the principle that jewelry designs comprised of combinations of unprotectable elements may be eligible for copyright registration. However, in order to be accepted, such combinations must contain some distinguishable variation in the selection, coordination, or arrangement of their elements that is not so obvious or minor 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). Viewed as a whole, the Work consists of two interlocking, circular bands arranged to create a hanging pendant design. One band is decorated with a channel of diamonds; the other is engraved with an unprotectable word. The bands attach to a standard necklace chain via a small, round diamond that is inset in a circular metal backing. This basic variation of a common interlocking band configuration is, at best, *de minimis*, and fails to meet the threshold for copyrightable authorship. *Feist,* 499 U.S. at 359; *see also Atari Games,* 888 F.2d at 883. Accordingly, we conclude that the Work, as a whole, lacks the requisite "creative spark" necessary for registration. *Feist,* 499 U.S. at 359; *Satava*, 323 F.3d at 811.

Your assertion that the Work employs a "unique," "balanced," and "harmonized" arrangement of unprotectable elements does not add to your claim of sufficient creativity. *Second Request* at 4. As discussed above, the Board does not assess the attractiveness of a design, the

design's uniqueness, or its visual effect or appearance in determining whether a work contains the requisite minimal amount of original authorship necessary for registration. *See* 17 U.S.C. § 102(b); *see also Bleistein*, 188 U.S. 239. Thus, even if accurate, the mere fact that the Applicant's Work consists of a unique, harmonious arrangement of familiar shapes would not qualify the Work, as a whole, as copyrightable.

Finally, regarding your argument that the Office has registered works similar to the ones in contention, the Office has a policy of not comparing works that have been previously registered or refused registration. Each claim of copyright is examined on its own merits, with the Office applying uniform standards of copyrightability throughout the examination process. Because copyrightability involves a mixed question of law and fact, differences between any two works can lead to different results. Thus, the fact that an individual examiner might have previously registered a work that is, arguably, less original than the work at issue does not require the Board to reverse the denial of a work that we find lacks sufficient creative authorship. *See Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q.2d (BNA) 1074, 1076 (D.D.C. 1991) (where the court stated that it was not aware of "any authority which provides that the Register must compare works when determining whether a submission is copyrightable."); *accord, Coach, Inc. v. Peters*, 386 F. Supp.2d 495, 499 (S.D.N.Y. 2005) (indicating the Office "does not compare works that have gone through the registration process."). While we appreciate you bringing perceived inconsistencies in the application of Office regulations to our attention, we will not compare the Work at issue with prior registrations in our review of your requested reconsideration of refusal.

In sum, the Board finds that both the individual elements that comprise the Work, as well as the selection, organization, and arrangement of those elements lack the sufficient level of creativity to make the Work eligible for registration under the Copyright Act.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the work entitled: *Possession Necklace*. This decision constitutes final agency action on this matter. 37 C.F.R. § 202.5(g).

Maria A. Pallante
Register of Copyrights

BY: _____
William J. Roberts, Jr.
Copyright Office Review Board