United States Copyright Office
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March 16, 2012

Via First Class Mail and Fax

Peacock Myers, P.C.
Attention: Marcia T. Nass, Esq.
201 Third Street NW, Suite 1340
Albuquerque, New Mexico 87125-6927

Re: GRCF452; GRIF206; GRIF145; GBRC892; GRCF244; GRCF519 GRCF878; GRIF266; GRCF476; GRCF496; GRCF746; GRCF750 GRIF113; GBRC770; GBRC754; GRCF490; GBRC734; GRIF123 GRCF499; GRCF391; GRCF184; and GRIF205 Copyright Office Control No. 61-319-6350(P)

Dear Ms. Nass:

On behalf of the Copyright Office Review Board, I am responding to your March 21, 2006 second request for reconsideration of the Examining Division's refusal to register the twenty-two jewelry designs listed above. We apologize for the long delay in responding concerning these claims.

The Review Board has carefully examined the applications, the deposits, and all correspondence in this case. For all of the twenty-two jewelry designs, you cite prior Kabana registrations which you claim to be registrations for designs similar to those now denied registration. After careful consideration of the arguments in your letters and the identifying reproductions, the Board has decided that the works GRCF184, GRCF391, GRCF490, and GRCF750 contain sufficiently creative authorship to support copyright registration. Therefore, certificates of registration will be mailed for these four works under separate cover. Regarding the remaining 18 jewelry designs, the Board affirms the denial of registration because of lack of copyrightable authorship.

I. ADMINISTRATIVE RECORD

A. Initial submissions

On December 15, 2004, the Copyright Office received from you applications, identifying material, and fees to register the twenty-two jewelry designs identified above on behalf of KABANA (also dba KBN). By letter dated March 2, 2005, Visual Arts Examiner Joy Fisher Burns refused registration for these works because they lacked the authorship necessary to support a copyright claim. (Letter from Burns to Fielding of Kabana, Inc. of 3/2/2005, at 1.) Ms. Burns stated that copyright protects original works of authorship that are fixed in some form, citing 17 U.S.C. § 102(a). *Id.* at 1. Citing Feist Publications v. Rural Telephone Service Co., 499 U.S. 340, 345 (1991), Ms. Burns clarified that the term "original" meant that the work

was independently created by the author and that it possessed at least a minimal degree of creativity. *Id.* at 1.

Ms. Burns further 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.* at 1. Citing Bleistein v. Donaldson, 188 U.S. 239 (1903), and Feist, Ms. Burns stated that neither the aesthetic appeal or commercial value of a work, nor the amounts of time and effort expended to create a work are factors that are considered under copyright. The question, she asserted, was whether there was sufficient creative authorship within the meaning to the copyright statute and settled case law. Applying those standards, Ms. Burns concluded that the designs could not support a claim to copyright. *Id.* at 1.

B. First request for reconsideration

By letter dated June 29, 2005, Attorney Deborah A. Peacock sought reconsideration of the refusal to register the 22 jewelry designs. (Letter from Peacock to Burns of 6/29/2005, at 1). Accompanying the letter was an additional deposit which not only reproduced the 22 designs in issue, but asserted that for all of the designs, the Copyright Office had registered "somewhat similar prior" Kabana designs. Letter from Peacock of 6/29/2005, at 1. For all 22 designs, at least one photograph was included of a registered Kabana design which you asserted was similar.

Attorney Peacock stated that Kabana has registered over 1,550 copyright claims with the Copyright Office, and that it employs full-time designers who create unique designs incorporating precious metals, cut precious and semi-precious stones, and inlay stones. She also cited 1 Nimmer on Copyright § 2.08[B][1] (1994), stating that creativity "may be of a most humble and minimal nature." She further quoted from Bleinstein v. Donaldson, 188 U.S. 239 (1903) that "[i]t would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the [works of art], outside of the narrowest and most obvious limits." You contended that your client's works were not merely familiar shapes, symbols and designs, but, instead, a unique combination of inlay, gem stones and precious metals in a particular arrangement. *Id.* at 1 - 2.

Describing each of the 22 [twenty-two] jewelry designs [Letter from Peacock of 6/29/2005, at 3 - 8], she argued that the works in issue possess the minimum level of creativity required by relevant case law, citing Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991). *Id.* at 8. She briefly cited four cases involving jewelry designs in which copyright was upheld on the basis of combination of minimal elements. *Id.* at 8 - 9. She concluded by asserting that your client's designs have unique combinations of elements, incorporating inlay shapes and patterns, gems and precious metals that have a combination of flat and uneven surfaces, angular and smooth contours, line width, spatial variation and repeating design patterns, which make each design distinguishable from other designs, and therefore, each design copyrightable. *Id.* at 9.

C. Office response to first request for reconsideration

On December 28, 2005, Ms. Virginia Giroux-Rollow, for the Examining Division, responded to Attorney Peacock's first request for reconsideration of the Visual Arts Section's refusal to register. Letter from Giroux-Rollow to Peacock of 12/28/2005. Ms. Giroux-Rollow began by stating that the material utilized in a work does not determine copyrightability, and, therefore, the fact that these works were made from precious metals, different cuts and types of semi-precious gem stones and different colored inlays did not contribute to the copyrightability of the works. *Id.* at 1. Ms. Giroux-Rollow stated that, while jewelry designs fall within the subject matter of copyright, not all jewelry is copyrightable. In order to support a copyright claim, there must be a sufficient amount of original and creative authorship. *Id.* at 1

Ms. Giroux-Rollow clarified that the Copyright Office did not dispute that the work was original with the author and not copied from another source. *Id.* Citing Feist Publications v. Rural Telephone Service Co., 499 U.S. 340 (1991), she stated that a work must not only be original, but must possess more than a *de minimis* quantum of creativity. *Id.* at 1. She elaborated that originality, as interpreted by the courts, meant that the authorship must constitute more than a trivial variation of public domain elements, citing Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951.) *Id.* at 1. Ms. Giroux-Rollow also stated that, in applying that standard, the Copyright Office examines a given work of authorship in order to determine whether it contains elements, either alone or in combination, on which copyright can be based. In the examining process, factors which cannot be considered are aesthetic judgments, the attractiveness of a work's design, its uniqueness, its visual effect and appearance, the time and effort it took to create, and its commercial success in the marketplace. She concluded the only relevant question is whether there is sufficient original and creative authorship within the meaning of the copyright law and settled case law. *Id.* at 1.

Ms. Giroux-Rollow further clarified that when a work contains previously registered, previously published, or public domain elements– as appears to be the case with the 22 works at issue here– the copyright in such derivative works covers only the copyrightable additions or changes made for the first time. *Id.* at 2. Copyright in such works can only be posited if the new elements or features are sufficiently original and creative to be copyrightable. Keeping these principles in mind, Ms. Giroux-Rollow concluded that all 22 works did not contain a sufficient amount of new original and creative authorship with respect to the constituent elements, either individually, or in the overall manner that the elements were arranged within a work, to support copyright registration. *Id.* at 2. She found that, according to the *Compendium of Copyright Office Practices, Compendium II*, §§ 503.02(a) and (b) (1984), these designs consisted primarily of previously registered, previously published, or public domain elements arranged in a new but rather simple and common configuration. Letter from Giroux-Rollow of 12/28/2005, at 2.

Ms. Giroux-Rollow pointed out that *Compendium II*'s principles regarding noncopyrightability of simple geometric or other familiar designs, have been confirmed in numerous cases. The cases included John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir.)(a logo consisting of four angled lines forming an arrow, with the word "arrows" in cursive script below); Jon Woods Fashions, Inc. v. Curran, 8 USPQ2d 1879 (S.D.N.Y. 1988)(a fabric design consisting of striped cloth with small grid squares superimposed

on the stripes); Forstmann Woolen Co. v. J.W. Mays, Inc., 89 F.Supp 964 (E.D.N.Y. 1950)(a label with the words "Forstmann 100% Virgin Wool" interwoven with three fleur-de-lis); Homer Laughlin China Co. v. Oman, 22 U.S.P.Q. 2d 1074(D.D.C. 1991) (a chinaware "gothic" pattern of simple variations and combinations of geometric designs); and DBC Of New York, Inc. v. Merit Diamond Corp., 768 F.Supp. 414 (S.D.N.Y. 1991)(a jewelry design consisting of familiar shapes). *Id.* at 2-3. She conceded that while it is true that even a slight amount of creativity will suffice to obtain copyright protection, the Nimmer treatise, 1 M. Nimmer & D. Nimmer, Nimmer on Copyright, §2.01(b)(1998), provided the principle that: "there remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright." She concluded the 22 jewelry works at issue here fall within this narrow area. Letter from Giroux-Rollow of 12/28/2005, at 3. She agreed 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." *Id.* at 3.

Finally, Ms. Giroux-Rollow stated that the Office accepts the principle enunciated in Atari Games Corp. v. Oman, 979 F.2d 242 (D.D.C. 1992), that a work must be viewed in its entirety. However, even under the Atari standard, the combination and arrangement of the few design elements embodied in each jewelry work at issue here did not rise to the level of copyrightability necessary to support new copyright registrations. Letter from Giroux-Rollow of 12/28/2005, at 3. She further distinguished the works involved in Weindling International Corp. v. Kobi Katz, Inc., 65 U.S.P.Q.2d 1763 (S.D.N.Y. 2000) and Yurman Design, Inc. v. Paj, Inc., 263 F.3d 101 (2d Cir 2001) from the 22 works involved in this instance. Ms. Giroux-Rollow closed by stating that the uniqueness of the designs, or the impression that the designs invoked, are not factors in determining copyrightability. *Id.* at 4.

D. Second request for reconsideration

In a letter dated March 21, 2006, you requested for a second time reconsideration of these 22 jewelry claims, again arguing that the rejection of these works for registration was erroneous. Letter from Marcia T. Nass to Review Board of 3/21/2006, at 1). You contend that the new elements or features within these 22 works of authorship are sufficiently original and creative to be copyrightable. *Id.* at 1-2. You assert that the Copyright Office registered four of the designs of a competitor, Shube Manufacturing, that were "copied" from four of the works involved in this reconsideration. You did not, however, identify the titles of the four Shube works, nor enclose copies of the designs or registrations. You state that all 22 jewelry designs at issue here contain "copyrightable additions or changes made for the first time and these changes are creative and thus make the designs copyrightable." *Id.* at 2. You further assert that while all 22 works come from the same family of designs inherent to Kabana, all involving new elements which make the designs copyrightable. *Id.*

In support of your position, you cite 1 M. Nimmer & D. Nimmer, Nimmer on Copyright, § 2.08[B][1], p.2-83, for the proposition that creativity required to constitute a work of art may be of the most humble and minimal nature. You argue the Supreme Court cases of Bleistein v. Donaldson, 188 U.S. 239 (1903); Feist Publications v. Rural Telephone Service Co., 499 U.S. 340 (1991); and Harper & Row Publishers, Inc. v. Nation Enterprises, 471 U.S. 539 (1985) to

support registration of your client's jewelry designs at issue here. *Id.* at 2-4. You also claim that your client's jewelry designs are more than "familiar symbols and designs" and that they represent a new combination which is different from prior works. *Id.* at 3. Finally, you contend that the jewelry design cases of Weindling Int'l Corp. v. Kobi Katz, Inc., 56 USPQ2d 1763(S.D.N.Y. 2000); and Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 101 (2d Cir. 2001) support registration in this instance. *Id.* at 5.

II. DECISION

Having carefully examined the 22 jewelry works and their accompanying applications and having considered the arguments for registration on first and second reconsideration, the Review Board has determined that the four [4] works GRCF 184, GRCF 391, GRCF 490, and GRCF 750 are copyrightable and will be registered with certificates being sent under separate cover.

Our analysis of the entire submission of Kabana claims follows below. Before proceeding, however, with the description of each work and an explanation of why the Review Board does or does not find the particular work copyrightable, we set forth our discussion of the 22 jewelry works at issue here accompanied by the guidelines and principles the Board has followed in its examination and judgment of the copyrightability and, thus, the registrability of the works.

A. Feist standard

The Copyright Office applies the Feist standard when it considers whether authorship is registrable, that is, whether it is original. Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 347 (1991). The fundamental basis of copyright protection is a work's originality. Although both independent creation and a certain minimum amount of creativity are components of originality, we assume for the works at issue here that the independent creation prong has been met and, thus, focus on the second prong of the Feist standard. As both you and Ms. Giroux have already noted, the requisite quantum of creativity necessary is very low. Letter from Nass of 3/21/2006, at 2,4; Letter from Giroux-Rollow of 12/28/2005, at 1,3. However, the Supreme Court has 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. *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, 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.

The Court further 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, 499 U.S. at 363. We do not dispute the fact that jewelry designs fall within the category of works of authorship that are the general subject matter of copyright. However, not all jewelry designs are

copyrightable. As Feist confirms, all works, no matter the category, must contain a sufficient amount of original and creative authorship to be copyrightable. Feist, 499 U.S. at 346 (originality as a constitutional requirement).

In its long-standing registration practices – in place prior to Feist – the Copyright Office has consistently recognized and applied the modest but nevertheless extant requisite level of creativity necessary to sustain a claim to copyright. *Compendium II* states that "[w]orks that lack even a certain minimum amount of original authorship are not copyrightable." *Id.*, § 202.02(a). For works of pictorial, graphic, and sculptural authorship within which jewelry designs fall, *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.*, § 503.02(a). In applying this yardstick, courts have consistently found that standard designs, figures, and geometric shapes in themselves are not sufficiently creative to meet the required quantum threshold. M. and D. Nimmer, Nimmer on Copyright, 2.01[B], 2-14 (2008). Bailie v. Fisher, 258 F.2d 425 (D.C.Cir. 1958); Homer Laughlin China Co., v. Oman, 22 U.S.P.Q. 2d 1074 (D.D.C. 1991); OddzOn Products, Inc. v. Oman, 924 F.2d 346 D.C. Cir. 1991). *Compendium II*, § 503.02(a), notes that "[R]egistration cannot be based on the simplicity of standard ornamentation.... Similarly, it is not possible to copyright common geometric figures or shapes...." Further, "[f]amiliar symbols or designs, and mere variations of typographic ornamentation, lettering, or coloring, are not copyrightable." *Compendium II*, § 202.02(j).

No registration is possible where the work consists solely of elements which, individually, or collectively, are incapable of supporting a copyright claim. Uncopyrightable elements include common geometric figures or symbols such as a hexagon, an arrow, or a five-pointed star. *Compendium II*, § 503.02(a). *See e.g.*, Bailie v. Fisher, 258 F.2d at 426: ("Register may properly refuse to accept for deposit and registration 'objects not entitled to protection under the law'"). *See also* 37 C.F.R § 202.1(a) (familiar symbols or designs "are not subject to copyright and applications for registration of such work cannot be entertained"); DBC of New York, 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).

B. Works in their entirety

Simple variations of standard designs and their minor arrangements do not support a claim to copyright. Some combinations of common or standard forms contain sufficient creativity in their selection, coordination and arrangement of those forms. *See* Feist, 499 U.S. 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); 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). Concerning Atari, in its (second) appellate appearance, coming a year after the 1991 *Feist* decision, the Court referred to *Feist*'s "elucida[tion] of the creativity standard" and proceeded to analyze the video game at issue in that case as a whole, rather than analyzing individual, commonplace elements within the game. 979 F.2d at 244 - 246. The Circuit Court in Atari reversed the summary judgment that

had agreed with the Register's refusal to register and also remanded the case to the lower court with emphasis that the standard for determining the copyrightability of a work of authorship must be consistent with "the unifying and clarifying instruction furnished by the Supreme Court in Feist." 979 F.2d at 247.

In your arguments for registration, you have also asserted that these 22 jewelry designs, employing "component lines, slopes and curves arranged in various shapes and patterns," should be judged in their "totality of the design and unity of the entire" jewelry piece. Letter from Nass of 3/21/2006, at 3. You add that the "complement of colors plus the geometric shapes are different in these design" than in other jewelry pieces which this applicant previously submitted and which the Copyright Office registered. *Id.* Although the Review Board agrees that each work must be evaluated in its entirety in order to determine its copyrightability, even applying such a guideline, we must still apply Feist that made it clear that, while the standard of originality is low, it does exist. Feist, 499 U.S. at 362. In agreement with Feist, the Ninth Circuit re-stated the principle governing the necessary quantum of originality: *see* North Coast Industries v. Jason Maxwell, Inc. 972 F.2d 1031, 1033 (9th Cir. 1992), citing Alfred Bell & Co. v. Catalda Fine Arts, 91 F.2d 99, 102-103 (2d Cir. 1951) ("No large measure of novelty is required... [A]ll that is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'") North Coast, 972 F.2d at 1033. Similarly, "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,* § 503.02(b).

Diamond Direct, LLC v. Star Diamond Group, Inc., 116 F. Supp. 2d at 525, 528 (S.D.N.Y. 2000) is an example of a court's application of Feist's principle that a work "that is entirely a collection of unoriginal material nevertheless may be copyrighted if the material is selected, coordinated or arranged in an original fashion. While component parts are not entitled to copyright protection simply by virtue of their combination into a larger 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), referring to Feist, 499 U.S. at 358.

We also note Satava v. Lowry, 323 F.3d 805, 811 (9th Cir.2003): "It is true, of course, that a combination of unprotectible elements may qualify for copyright protection. But it is not true that *any* combination of unprotectible elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectible 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.") (citations omitted) (emphasis in original). The Review Board accepts the general principle that an arrangement of common or geometric shapes *may* be copyrightable. Nevertheless, after reviewing the applications and deposits for these 22 works, the Board concludes that 18 of the designs at issue here consist only of simple geometric shapes and commonplace 3-dimensional jewelry elements, bordered and/or surrounded with various, albeit universally, simple trim and elements common and trivial in their configuration. Thus, with the

exception of the four works listed above, they do not contain sufficient creative authorship to support registration. *See below.*

C. Application of case law to works as considered in their overall configuration and composition as a whole

We also further note that merely combining unprotectible elements does not alone establish creativity where the combination or arrangement is itself simplistic or formulaic 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, taken together, formed an arrow with the words "Arrows" in cursive script below the arrow. John Muller & Co. v. New York Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986).

Concerning the 18 works at issue here for which registration is again being refused, we point out that these works, although manifesting jewelry piece "combinations" that are "new and different from prior works," Letter from Nass of 3/21/2006, at 3, represent combinations of individual jewelry elements not sufficient in themselves to justify registration. As we have stated, the works for which the Board is again refusing registration illustrate the principle that a combination of unprotectible elements is eligible for copyright protection only if those elements are numerous enough and if their selection and arrangement original enough that their combination constitutes an original work of authorship. This principle from the Ninth Circuit's Satava (above) can serve as a foundation for judging the protectibility of any work of authorship in any subject matter.

The Review Board takes administrative notice that rings very often contain a stone around which other elements are arranged. *Compendium II*, § 108.05(b). This is general knowledge and where a particular ring shows only a commonplace ring structure, such ring would be refused registration. The Board also notes, in considering generally the structure and appearances of rings, that a flat-top ring is not a particularly new design and that the presence of gemstones in a vertical row next to a main stone would be insufficient in quantum of elements brought together as well as in the manner of placement of the elements within a ring as a whole. The Board notes that you have also cited the Weindling Court in its noting that copyright protects works having a "unique combination and arrangement of otherwise uncopyrightable elements." Letter from Nass of 3/21/2006, at 5. In Weindling, the Court gave an analysis of copyright with respect to jewelry, stating that "design is at the heart of the jewelry business." 2000 U.S. Dist. Lexis 14255, *6. (S.D.N.Y. 2000). The opinion, citing Feist, further reminded the reader that Feist requires an "extremely low level of creativity." Id., *10, 11. In its analysis of jewelry, Weindling further notes that "so-called commercial jewelry will inevitably be designed in a manner that is in many respects obvious, so as to appeal to the great majority of purchasers whose taste are conventional." *Id.*, *11. We allude to this quotation not to imply that

the Kabana jewelry at issue here is inferior, or not deserving of copyright[1] but, rather, because of the Court's observation that the design of a jewelry piece may be "obvious." Stating again the decision of the Review Board concerning the 18 works for which registration has been refused, all 18 works fail to rise above simple and commonplace arrangements.

D. Registration principles; derivative works

The copyright law states that ideas are not copyrightable. 17 U.S.C. §102(b). It is only when ideas have been expressed in such a way that demonstrates copyrightable originality that such expression can be registered. As we have explained above, simple arrangements of a small number of elements are not protectible. Since the physical material of which a work is made does not determine copyrightability, any protectible aspects of these works would have to be found in the actual implementation of an idea, *i.e.,* in the 2-dimensional design or in any sculptural authorship.

For all of the 22 jewelry designs, you have claimed that at least one similar registered Kabana design exists. In instances where the design is considered similar, registration can only be considered on the basis of copyrightable new matter. Section 103(b) of the copyright law clearly states that: "copyright in a compilation or derivative work extends only to the material contributed by the author of such works, as distinguished from the preexisting material employed in the work." Moreover, the statute defines a derivative work as "a work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship. 17 U.S.C. §101 (definitions). In explaining the meaning of "originality" with respect to jewelry design, the Second Circuit stated that originality "inheres" in the way a jewelry designer has "recast and arranged those constituent elements" of which a piece of jewelry is composed. Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 102, 110 (2d Cir. 2001). You have yourself cited this 2001 Yurman decision for the principle that "copyright law may protect a combination of elements that are unoriginal in themselves... because of the way [the designer] has recast and arranged the constituent elements." Letter from Nass of 3/21/2006, at 5.

The jewelry pieces for which registration have been refused are indicative of the principle that a given work of authorship may be a composition or a combination of elements that are not in themselves copyrightable **and** the overall combination of such elements, when

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[1] The Eastern District of Pennsylvania in Morelli Design, Inc. v. Tiffany & Co,. 200 F. Supp. 2d 482 (2002), analyzed jewelry pieces at issue and, using the principle in the hallmark Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251 (1903) reminded the reader that "persons trained only to the law should not consider themselves "final judges of the worth" of any work of art. The Copyright Office follows this principle in its determination of copyrightability: "the registration of a work does not depend upon artistic or aesthetic value." *Compendium II*,§ 503.01. Ms. Giroux-Rollow in her December 28, 2005 response to the first request for reconsideration in this case cited to *Compendium II*, § 503.02(a),(b) in explaining why these jewelry design were not registrable: commercial appeal does not necessarily indicate copyrightability; and, it is not possible to copyright common geometric figures or shapes, standard symbols, mere coloration. Letter from Giroux-Rollow at 2 - 3. Again, in the words of Morelli, "[W]orks may experience commercial success even without originality and works with originality may enjoy none whatsoever." 200 F. Supp. 2d at 488.

examined in its entirety, still lacks sufficient originality to carry a copyright claim. Too few elements brought together in a manner that is commonplace, ordinary, or trivial fails to meet the Feist standard. Citing the examination practices of the Copyright Office, the Office will not knowingly put duplicate or overlapping registrations on record. *See generally Compendium II* §§ 610.04, 610.05. Further; *Compendium II* §108.03 states: "The Copyright Office does not generally make comparisons of copyright deposits to determine whether or not particular material has already been registered." In addition to this axiom, we point out section 410(a) of Title 17: the Register must determine whether the "material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met." Deposit materials submitted under the requirements of 17 U.S.C. § 408 allow the Copyright Office to examine the authorship for which registration is sought.

We also take the opportunity to comment on the following. As Ms. Giroux-Rollow stated in her reply to your first request for reconsideration, [Letter from Giroux-Rollow of 12/28/2005, at 2, 4], and, although you have not provided descriptions of the changes or modifications to the previously registered jewelry works on which the current works are based, the 22 works at issue here can fairly be categorized as "derivative" works in which the only the only possibly copyrightable elements or features are those new or appearing for the first time. Such features would be the extent of the authorship covered by any registration for the designs at issue here. Concerning "derivative" authorship, we again offer citation to the Atari case where the Circuit Court determined that the copyrightability of a work of authorship must be consistent with "the unifying and clarifying instruction furnished by the Supreme Court in Feist." 979 F.2d at 247.

The standard utilized by the Copyright Office in its examination of a derivative work is one that is consistent with Feist itself: in order to qualify for protection as a derivative work, the "work must be independently copyrightable." Woods v. Bourne *Co.*, 60 F.3d 978, 990 (2d Cir. 1995). Although this latter case was one concerning termination rights and the preparation of derivative works at both pre- and post-termination points in time, 17 U.S.C. § 304 (c)(6)(A), the case discussed at some length what is needed for a work to qualify as "derivative." Citing L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486 (2d Cir) (in banc), *cert. denied*, 429 U.S. 857 (1976), as well as Durham Industries, Inc. v. Tomy Corp., 630 F.2d 905 (2d Cir. 1980), it quoted Tomy in asserting that "to support a copyright, the original aspects of a derivative work must be more than trivial." 630 F.2d at 909.

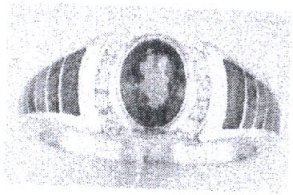
Although the Batlin and Tomy decisions are among older cases explaining the extent of creativity for derivative works of authorship, the Second Circuit explicitly stated that more recent decisions such as Weissmann v. Freeman, 868 F.2d 1313 (2d Cir.), *cert. denied* 493 U.S. 883 (1989), Gaste v. Kaiserman, 863 F.2d 1061 (2d Cir. 1988), Waldman Publishing Corp. v. Landoll, Inc., 43 F.3d 775 (2d Cir. 1994), are consistent with Batlin and Tomy. Woods, 60 F.3d at 990. Thus, the standard that derivative authorship must be more than trivial is reflected in the Feist basic rule for copyrightability of authorship: "[T]he standard of originality is low, but it does exist." Again, in order for authorship to be copyrightable, the "Constitution mandates some minimal degree of creativity" be present in a work— creativity that is more than trivial. *Feist,* 499 U.S. at 362. This is the copyrightability standard which the Copyright Office applies to **all** works– initially created works as well as works derivative in nature.

Jewelry works must meet the same registration requirement of sufficient new authorship if the work is based on previously published, previously registered or public domain works of authorship. As we have pointed out, the Feist standard of originality is low; further, ideas in themselves are not protectible under the copyright statute. 17 U.S.C. § 102 (b). For jewelry works, as with works of any other subject matter, elements that may fairly be categorized as 'scenes a faire,' *i.e.*, fixed expression that is linked to, or commonly associated with, a particular idea, are not protectible. Nimmer on Copyright, §1.05 [A][2] (2008).[2]

As we have stated, the original applications for these 22 works did contain information concerning previous or alternative titles for the works but no description of the new authorship inherent in each work[3] and because we have followed Office *Compendium II* practices that we do not compare works newly submitted for registration with works previously registered or previously submitted, we have applied the Feist standard regarding each work's copyrightability and determined that 4 of the 22 jewelry designs are copyrightable.

III. INDIVIDUAL WORKS : THEIR COMPOSITION WITH RESPECT TO REGISTRABILITY

1. GRCF452



GRCF452

GRCF452 is a ring with a large, center oval stone with small diamonds arced around the center stone on two sides of the stone. Inlay appears on the band. There are gold bands, *i.e.*, straight, parallel lines separating the inlay. The presence of the center stone, surrounded by smaller

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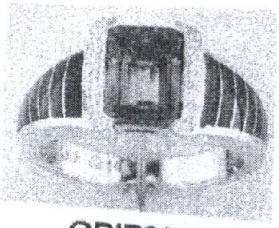
[2] Holding plaintiff's barbed-wire jewelry not copyrightable, the District Court of Colorado, applying an analysis which took into consideration the jewelry pieces as entireties and using the Yurman v. PAJ analysis asking whether the plaintiff had "recast and arranged the public domain elements of the jewelry in an original way," the Court concluded that the jewelry at issue there still corresponded to the arrangement of public domain barbed-wire appearance and shape, manifesting insufficient rearrangement, reordering, or recasting. Todd v. Montana Silversmiths, Inc., 379 F. Supp. 2d 1110, 1112-1114 (D. Col. 2005). The Review Board has examined these Kabana jewelry works as integrated, independent works and still concludes that they lack sufficient original arrangement and overall placement of the constituent elements to justify copyright registration.

3 Section 503 of *Compendium II* states that "If the work consists entirely of uncopyrightable elements, registration is not authorized." Even if some of the shapes have been slightly modified in a derivative version of the jewelry piece (*e.g.*, an arch is added above a semicircle), minor alterations of stock features are not sufficient to sustain a claim to copyright. *See e.g.*, Vogue Ring Creations, Inc. v. Hardman, 415 F.Supp. 609, 612 (D. R.I. 1976) adding rope design and changes in width and shape of ring are 'trivial and meaningless, utterly devoid of any 'original creativity,'" and components not entitled to copyright protection.

stones on both sides of a ring, and having a simple band divided by parallel lines of a contrasting color is not sufficient to sustain a copyright claim.

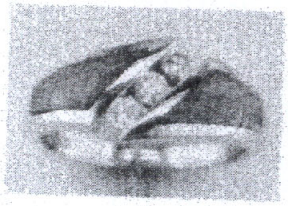
2. GRIF206



GRIF206

GRIF206 is, again, a ring with an emerald-cut center stone with a band of diamonds surrounding the two edges of the center stone, curving slightly to the top and bottom of the center stone, with inlay narrowing along the ring band, with contrasting-color parallel lines. The overall design is a simple variation of a commonly-designed ring, and, thus not copyrightable.

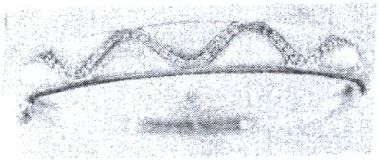
3. GRIF145



GRIF145

GRIF145 is a ring with three central diamonds slanted at a roughly 45 degree angle. A gold border outlines the edges of the ring and the three slanted diamonds as the band inlay widens towards the diamonds and narrows away from the diamonds. It is a minor variation of a center-stone ring, having the primary focal point as three smaller stones slanted at an angle. This slightly modified design, differing in a minimal manner, lacks copyrightability.

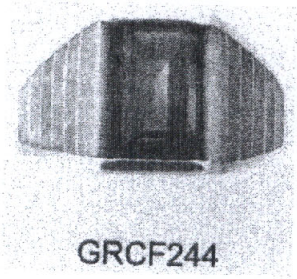
4. GBRC892



GBRC892

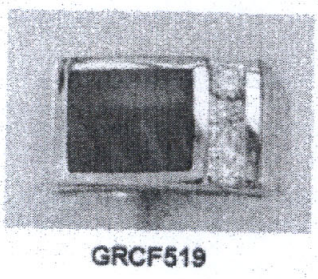
GBRC892 is a bracelet with a continuous wave of set stones against a white, pearl-like background bordered by a gold line. Its simple, rounded configuration for the arm, with a contrasting wave-like ornamentation on its surface, is too ordinary to carry a copyright claim.

5. GRCF244



GRCF244 is a ring with a large emerald-cut, purple-colored stone. The surrounding inlay and gold bands create a straight, vertical separation on the inlay surface, of a contrasting color. Again, this is an example of a ring with a center-appearing stone, having a band showing parallel, vertical lines. This is too trivial a design to sustain registration..

6. GRCF519



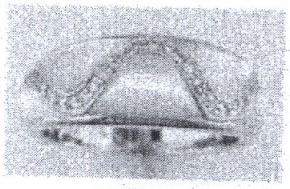
GRCF519 is a ring consisting of a rectangle bordered by a row of three diamonds along one side of the rectangle. The entire face consists of a gemstone rectangle with an offset look. The flat-appearing top portion of this ring is a common design and the side channel containing a few small stones does not raise the creativity sufficiently to carry a registration.

7. GRCF878

GRCF878 is a ring similar to GRCF519. It consists of a rectangle bordered by a channel row of three diamonds on one side. The dimensions of the rectangle appear slightly different from that of GRCF519 with the rectangle feature, in black, extending to the side of the ring. The overall

design remains a rectangular flat top, slightly extended to the ring band and bordered on the opposite side by the vertical row of diamonds in a trivial variation of # 519 and, thus, not registrable.

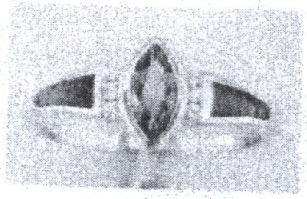
8. GRIF266



GRIF266

GRIF266 is a ring design consisting of a wave of inlaid stones, bordered by gold. See Bracelet #892, above, for a very similar design. Its simple rounded configuration for the finger, in this instance, with a contrasting wave-like ornamentation on its surface, is too simple and familiar to carry a copyright claim.

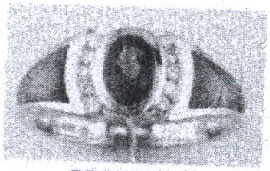
9. GRCF476



GRCF476

GRCF476 is a ring with a marquis oval center stone surrounded by a gold border. Three diamonds are located on each side of the center stone, and sit next to an inlay band where the inlay is wider towards the center stone. This ring presents a common, routine structure of a center stone, bordered on both sides by a vertical row of just three stones and a band having inlay that narrows as it gets farther from the center stone– a minor variation of the ususal center-stone ring.

10. GRCF496

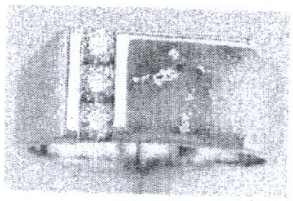


GRCF496

GRCF496 is a ring with a large oval center stone with a gold border on both sides and five diamonds on each side; an inlay band narrows as it gets farther from the center stone. This

design, again, is a trivial variation of many other center-stone configurations.

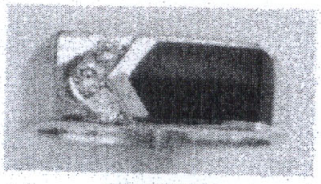
11. GRCF746



GRCF746

GRCF746 is a ring which is similar to GRCF878 except the row of three diamonds is located on the left rather than the right. The rectangle is border on three sides by a gold, similar material to the band. Again, this represents a trivial variation of flat-top rings.

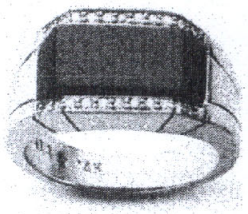
12. GRCF750



GRCF750

GRCF750 is a ring with a five sided inlay stone located at the right side of the ring. The left side of the stone is a two- sided chevron shape. Except for the right side, the inlay stone has a gold border and on the left border are three diamonds aligned with the chevron shape. The Review Board has determined that the design as a whole is sufficient to be registered.

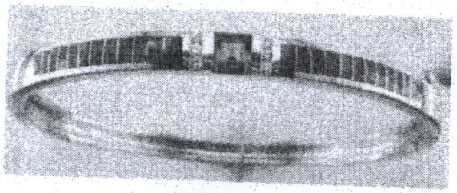
13. GRIF113



GRIF113OX

GRIF113 is a ring with a large rectangular black inlay with a flat face and slanting edges. Two rows of diamonds appear at the top and bottom of the inlay, and grooves are cut into the gold around the band. This ring does not rise above a commonplace flat-top ring; its few, commonplace elements are insufficient to register this piece.

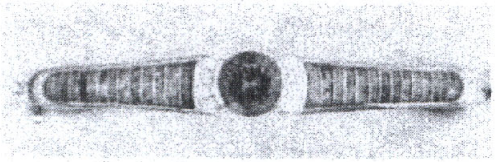
14. GBRC770



GBRC770

GBRC770 is a bracelet having a small, central square stone with diamonds bordering the stone on both sides and a thick gold stripe as a margin. An inlay band is separated by thin vertical strips of gold. This piece is a commonplace version of a bracelet showing a center stone and a few border stones. The inlay along the band does not add to its copyrightability.

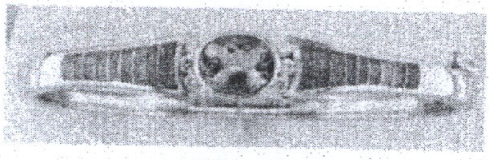
15. GBRC754



GBRC754

GBRC754 is, again, a simple bracelet having a large (round) center stone, bordered on both sides by an arc of diamonds. An inlay band, this time, separated by thin vertical strips does not add to its copyrightability.

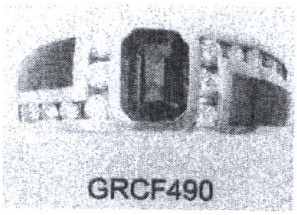
16. GBRC734



GBRC734

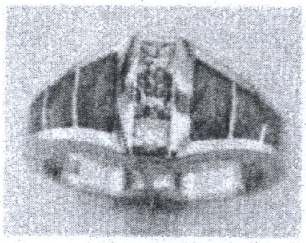
GBRC734 is a bracelet similar to GBRC754 except that the center stone is oval, bordered on both sides of the oval by three diamonds placed in an arc shape; the inlay band is, again, separated by thin vertical strips. The design of the entirety is too ordinary to sustain registration.

17. GRCF490



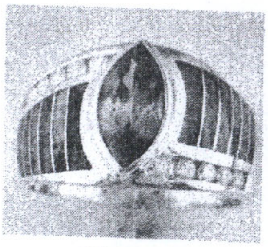
GRCF490 is a ring with a central, emerald-cut stone, bordered with a thick band of gold. An asymmetrical, angular arrangement of diamonds begins on both sides of the central stone, and run along the sides of the ring band. The diamonds are bordered by a thick strip of gold. The remaining area of the ring band has inlay portions in geometric opposition to each other. The overall design is sufficient in this instance to sustain a copyright registration.

18. GRIF123



GRIF123 is a ring with a center setting of three small stones aligned in a column. The three stones are separated from the parallel band inlay by a thick, narrowed- to- the- end- points, strip of metal on each side. The inlay is wide near the stones, and then narrows away from the stones. This design, with its somewhat different metal channel borders on both sides of the small stones, is nevertheless insufficient to carry a claim.

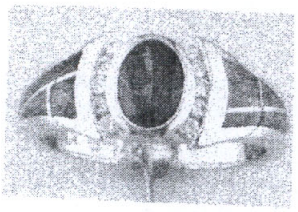
19. GRCF499



GRCF499 is a ring with a large center marquis-cut stone. Horizontal, parallel rows of inlay strips are on both sides of the center stone, along the band, with one row of stones at the top of

the ring band while the other row of stones is on the other side of the band and both rows are bordered by gold strips. Although this design would normally carry a copyright registration, it is essentially the same design as appears in RING # 184– see below. The design immediately above was first published 9/1/1996, some five years after RING # 184. Therefore, the first published manifestation of the design, RING # 184, will be registered.

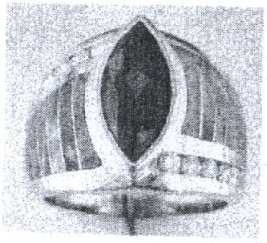
20. GRCF391



GRCF391

GRCF391 is a ring with a center oval stone surrounded by arcs of small diamonds on both sides of the center stone; inlays on the band are separated by thin strips of gold in an irregular pattern. It is this irregular band pattern that raises the overall ring design above the ordinary and that supports registration.

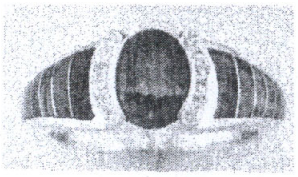
21. GRCF184



GRCF184

GRCF184 is a ring with a large center marquis-cut stone. Horizontal, parallel rows of inlay strips are on both sides of the center stone, along the band, with one row of stones at the top of the ring band while the other row of stones is on the other side of the band and both rows are bordered by gold strips. This design will be registered : it is essentially the same design as appears in RING # 499– see above. This design was first published 7/20/1989, some five years before RING # 499. Therefore, the first published manifestation of the design, RING # 184, will be registered; the subsequent publication of the same design as it appears in RING # 499 will not.

22. GRIF205



GRIF205

GRIF205 is a ring with a large center oval gemstone. Small diamonds curve in an arc around the center stone on the two sides with an inlay located on the band and separated by thin gold bands. The inlay of the band is wide at the center stone and then narrows away from the center stone. This design, again, shows a center stone flanked by smaller stones with a band that narrows as it moves from the center– a repetition of a familiar configuration.

IV. CONCLUSION

For the reasons stated above, the Copyright Office Review Board concludes that 18 [eighteen] of the jewelry designs identified in this letter cannot be registered for copyright protection but 4 [four] designs can be registered. Certificates of registration will be sent under separate cover for GRCF 184, GRCF 391, GRCF 490, and GRCF 750.

This decision constitutes final agency action.

Sincerely,

/s/

Nanette Petruzzelli
Associate Register,
Registration Program
for Review Board
United States Copyright Office