



United States Copyright Office

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April 19, 2018

Maxim H. Waldbaum
3 Park Avenue, 16th Floor
New York, NY 10016

**Re: Second Request for Reconsideration for Refusal to Register JAIPUR LINK necklace;
Correspondence ID: 1-2OW1TE; Service Request: 1-4933166111**

Dear Mr. Waldbaum:

The Review Board of the United States Copyright Office (“Board”) has considered Marco Bicego SpA’s (“Bicego”) second request for reconsideration of the Registration Program’s refusal to register a jewelry design claim in a three-dimensional work titled “JAIPUR LINK necklace” (“Work”). After reviewing the application, deposit copy, and relevant correspondence, along with the arguments in the second request for reconsideration, the Board affirms the Registration Program’s denial of registration.

I. DESCRIPTION OF THE WORK

The Work is a gold necklace consisting of slightly asymmetric circular links (or rings) which form a chain. Each ring in the chain is etched with a number of very fine grooves on its surface. The rings are arranged from smallest to largest in groups of four links, which are then linked with each other to form the chain. The Work is depicted as follows:¹

¹ While the deposit appears to show two different necklaces, the following analysis is the same for either style of necklace.



II. ADMINISTRATIVE RECORD

On April 20, 2017, Bicego filed an application to register a copyright claim in the Work. In an April 28, 2017 letter, a Copyright Office registration specialist refused to register the claim, finding that it did not “contain a minimum amount of creative, pictorial, graphic or sculptural authorship” and that “[c]opyright does not protect familiar symbols or designs [or] basic geometric shapes.” Letter from Adrienne Brown, Registration Specialist, to Maxim H. Waldbaum (April 28, 2017).

In a letter dated May 17, 2017, Bicego requested that the Office reconsider its initial refusal to register the Work. Letter from Maxim H. Waldbaum to U.S. Copyright Office (May 17, 2017) (“First Request”). Specifically, Bicego argued that the Work “went far beyond the ‘minimal degree of creativity’” necessary to qualify for copyright protection. Bicego also stated that “even if the individual components [of a design] include a familiar design or symbol, or a slight variation of a basic shape...the combination of such shapes can form a copyrightable work of art.” *Id.* at 2. Bicego also attached several exhibits, including a declaration from the designer,

describing the method of creating the Work and the artistic inspiration for the overall collection, as well as “some of the articles and publications extolling [the Work].” First Request, Ex. 1-8. After reviewing the Work in light of the points raised in the First Request, the Office re-evaluated the claims and concluded that “the elements that make up the work, minor variations of a circle, are not combined in any way that differentiates them from their basic shape and design components, and do not rise to the level of creativity necessary for copyright registration.” Letter from Stephanie Mason, Attorney-Advisor, to Maxim H. Waldbaum, at 3 (Sept. 28, 2017). The Office also noted that it “does not make aesthetic judgments; the attractiveness of a work... its visual effect or impression, its symbolic meaning, or the time, effort, and expense it takes to create are not factors during the examination process.” *Id.* at 1.

In a letter dated November 15, 2017, Bicego 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 Maxim H. Waldbaum to U.S. Copyright Office (Nov. 15, 2017) (“Second Request”). In that letter, Bicego focused on both the irregularity of the individual rings as well as their asymmetrical arrangement as more than a “merely trivial” variation on a common shape. *Id.* at 2. Bicego also stated that “any recognizable variations, no matter how small, of a common shape are copyrightable as long as such variations reflect the author’s own work.” *Id.* at 3 (citing *Alfred Bell & co. v. Catalda Fine Arts*, 191 F.2d 99, 102-03 (2d Cir. 1951)).

III. DISCUSSION

A. *The Legal Framework – Originality*

A work may be registered if it qualifies as an “original work[] of authorship fixed in any tangible medium of expression.” 17 U.S.C. § 102(a). In this context, the term “original” consists of two components: independent creation and sufficient creativity. *See Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). 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.* Only a modicum of creativity is necessary, but the Supreme Court has ruled that some works (such as the alphabetized telephone directory at issue in *Feist*) may fail to meet even this low 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 virtually nonexistent.” *Id.* at 359.

The Office’s regulations implement the longstanding requirement of originality set forth in the Copyright Act and described in the *Feist* decision. *See, e.g.*, 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”); *id.* § 202.10(a) (stating “to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form”). Some combinations of common or standard design elements may contain sufficient creativity with respect to how they are juxtaposed or arranged to support a copyright. Nevertheless, not every combination or

arrangement will be sufficient to meet this test. *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”). A determination of copyrightability in the combination of standard design elements depends 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).

A mere simplistic arrangement of non-protectable elements does not demonstrate the level of creativity necessary to warrant protection. For example, the United States District Court for the Southern District of New York upheld the Copyright Office’s refusal to register simple designs consisting of two linked letter “C” shapes “facing each other in a mirrored relationship” and two unlinked letter “C” shapes “in a mirrored relationship and positioned perpendicular to the linked elements.” *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 496 (S.D.N.Y. 2005). Likewise, the Ninth Circuit has held that a glass sculpture of a jellyfish consisting of clear glass, an oblong shroud, bright colors, 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 language in *Satava* is particularly instructive:

It 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).

Similarly, while the Office may register a work that consists of geometric shapes, for such a work to be registrable, the “author’s use of those shapes [must] result[] in a work that, as a whole, is sufficiently creative.” U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 906.1 (3d ed. 2017) (“COMPENDIUM (THIRD)”); *see also Atari Games Corp.*, 888 F.2d at 883 (“[S]imple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection both by the Register and in court.”). Thus, the Office would register, for example, a wrapping paper design that consists of circles, triangles, and stars arranged in an unusual pattern with each element portrayed in a different color, but would not register a picture consisting merely of a purple background and evenly-spaced white circles. COMPENDIUM (THIRD) § 906.1.

Finally, Copyright Office registration specialists (and the Board) do not make aesthetic judgments in evaluating the copyrightability of particular works. They are not influenced by the attractiveness of a design, the espoused intentions of the author, the design’s uniqueness, its visual effect or appearance, its symbolism, the time and effort it took to create, or its commercial success in the marketplace. *See* 17 U.S.C. § 102(b); *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 necessarily mean that the work, as a whole, constitutes a copyrightable work of art.

B. Analysis of the Work

After careful examination, the Board finds that the Work fails to satisfy the requirement of creative authorship and thus is not copyrightable.

When evaluating a jewelry design's copyrightability, the Board may take into account the shapes of various elements, decoration on the jewelry's surface (i.e., engravings), as well as the selection and arrangement of the various elements. See COMPENDIUM (THIRD) § 908.3. "Jewelry designs that contain only a trivial amount of authorship," however, are *de minimis* and uncopyrightable. See COMPENDIUM (THIRD) §§ 313.4(B); 908.2 ("The Office will not register pieces that, as a whole, do not satisfy [the] requirement [of being sufficiently creative or expressive] such as mere variations on a common or standardized design or familiar symbol, designs made up of only commonplace design elements arranged in a common or obvious manner."). Bicego asserts that both the variations to the individual rings (the fine etchings and irregular moldings) as well as the "asymmetrical arrangement" of rings of varying sizes grouped together are both original and copyrightable. Second Request at 4-5. The Board finds that the Work's individual design elements are not sufficient to render the Work original. Bicego argues that the rings do not implicate copyright's bar on common geometric shapes, see COMPENDIUM (THIRD) § 906.1, because the "unique, carving, molding, casting and shaping" of the individual rings transforms these circular links from "common geometric shapes" into copyrightable works. Second Request at 2-3. However, despite these minor irregularities, the links forming the chain remain essentially common geometric shapes.

Nor are the fine etchings and irregular moldings of the rings sufficient to support a claim of copyright. Bicego misapprehends the law when citing *Alfred Bell* to support the proposition that "any recognizable variations, no matter how small, of a common shape are copyrightable." Second Request at 3. In fact, *Alfred Bell* states that what is needed to support a copyright is "that the 'author' contributed something *more than a 'merely trivial' variation.*" *Alfred Bell & co. v. Catalda Fine Arts*, 191 F.2d 99 at 102-03 (emphasis added). Here, the Board finds that the irregular molding and etchings of the ring are merely trivial variations of a circle. More analogously, in *Jane Envy, LLC v. Infinite Classic Inc.*, the court found that a pair of gold, cross-shaped earrings which had been hammered in such a way as to give the crosses a texture similar to that of the rings at issue here, were not copyrightable. No. SA:14-CV-065-DAE, 2016 WL 797612, at *8 (W.D. Tex. Feb. 26, 2016), *aff'd*, No. SA:14-CV-065-DAE, 2016 WL 5373035 (W.D. Tex. Sept. 26, 2016). In that case, as here, the irregular molding of a common geometric shape "represents only a 'trivial amount of authorship' insufficient to meet the originality requirement." *Id.*

Additionally, the Board does not agree with Bicego's claim that the "asymmetrical arrangement of the rings" is "the antithesis to standard or commonplace arrangement." Second Request at 4. Based on the deposit material submitted, the Board finds no such asymmetrical

arrangement.² Rather, the Work is comprised of repeating groups of four rings simply arranged from largest to smallest, which is a standard or commonplace arrangement. Further, as the Ninth Circuit stated in *Satava*, “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.” 323 F.3d 805 at 811. Here, the Work is comprised of common shapes placed in a common arrangement: circular rings are linked together to form a chain. The fact that the rings are arranged “from largest to smallest”, Second Request at 3, does not negate the fact that the links merely form a chain, an undeniably common arrangement. Combining numerous unprotectable elements will not necessarily result in a copyrightable jewelry design. See *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 109–10 (2d Cir. 2001). These contributions are, at most, *de minimis* and, therefore, do not demonstrate the requisite creativity. See *Feist*, 499 U.S. at 363. Bicego’s Work is not sufficiently creative. Neither the individual rings, nor the arrangement of the chain, nor any other element of the Work demonstrates the necessary authorship, whether evaluated individually or in the aggregate.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the copyright claim in the Work. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action in this matter.



U.S. Copyright Office Review Board

Karyn A. Temple, Acting Register of Copyrights
and Director, U.S. Copyright Office

Sarang Vijay Damle, General Counsel and
Associate Register of Copyrights

Catherine Zaller Rowland, Associate Register of
Copyrights and Director, Public Information and
Education

² See COMPENDIUM (THIRD) § 504.2 (“Ordinarily, a registration for a work of authorship only covers the material that is included in the deposit copy(ies). It does not cover authorship that does not appear in the deposit copy(ies), even if the applicant expressly claims that authorship in the application.”).