



United States Copyright Office

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October 3, 2016

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**Re: Second Request for Reconsideration for Refusal to Register Naga Gold & Silver
(Season XX); Correspondence ID: 1-1EY2QAE**

Dear Ms. Moyer:

The Review Board of the United States Copyright Office (the “Board”) has considered JH Global IP Limited’s (“JH’s”)¹ second request for reconsideration of the Registration Program’s refusal to register a jewelry design claim in the work titled “Naga Gold & Silver (Season XX)” (“Naga Jewelry”). 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 NAGA JEWELRY

Naga Jewelry includes a ring, earring, and bracelets in gold, silver, and black. The outer portion of each piece has an overlapping gold scale design with a silver outline and black background. The gold coloring in these designs fades to silver in each piece. The underside of each piece has a scale design in black with a silver outline as well as the number 925 in a circle (indicating the piece is made of sterling silver) and the term 18k in a circle (indicating the piece uses 18 karat gold). Additionally, the underside of all of the pieces have the initials “J” and “H” in an interlocking logo, in a circle, and the earrings also have the name “John Hardy” printed on the underside. Naga Jewelry is depicted in Appendix A.

II. ADMINISTRATIVE RECORD

On July 23, 2014, JH filed an application to register a copyright claim in Naga Jewelry. In an October 31, 2015 letter, a Copyright Office registration specialist refused to register the claim (and five others),² finding that it “lack[s] the authorship necessary to support [a] copyright claim[.]” Letter from Ivan Proctor, Registration Specialist, to Damien Philippe Jean Demoncourt, John Hardy Limited (Oct. 21, 2015).

In a letter dated December 16, 2015, JH requested that the Office reconsider its initial refusal to register Naga Jewelry. Letter from Cynthia A. Moyer, Fredrikson & Byron, P.A., to U.S.

¹ JH Global IP Limited is the assignee of the application’s listed author, John Hardy Limited. See Letter from Cynthia A. Moyer, Fredrikson & Byron, P.A., to U.S. Copyright Office 1 (Mar. 9, 2016).

² The other works are not the subject of this appeal.

Copyright Office (Dec. 16, 2015) (“First Request”). After reviewing Naga Jewelry in light of the points raised in the First Request, the Office re-evaluated the claims and again concluded that Naga Jewelry “do[es] not contain a sufficient amount of the original and creative authorship to support copyright registration[.]” Letter from Stephanie Mason, Attorney-Advisor, to Damien Philippe Jean Demoncourt, John Hardy Limited (Jan. 28, 2016).

In a letter dated March 9, 2016, JH requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register Naga Jewelry. Letter from Cynthia A. Moyer, Fredrikson & Byron, P.A., to U.S. Copyright Office (Mar. 9, 2016) (“Second Request”). In that letter, JH asserted that Naga Jewelry contains the multiple creative elements: the Cassini-like oval cross-sectional shape of the jewelry; individual dragon scales in gold outlined in silver, linked together, on the outside surface (roughly parallel to the major axis) of oval of the jewelry; the color change of the dragon scales on the outside of the jewelry from gold to silver, (roughly parallel to the major axis) and the color scheme of the underside of the pieces in Naga Jewelry; the finished underside, with dragon scales in black outlined in silver, on the inside surface (roughly parallel to the major axis) of oval of the jewelry (the finished underside is hollow); the design on the narrower “edge” or outside surface (roughly parallel to the minor axis) of oval of the jewelry; and the concave and convex designs sharing a common circle, on inside end surfaces (roughly parallel to the major axis) of the jewelry, and another two dragon scales. *Id.* at 3-4. JH argued that “[t]hese individual elements are neither common geometric shapes nor familiar symbols and designs” and even if the designs were common geometric shapes or familiar symbols or designs, the Office must consider the design as a whole. *Id.* at 4. Further, JH criticized the Office’s January 28, 2016 letter as “list[ing] only three [creative] elements—(1) what [the Office] calls ‘overlapping half-circles,’ (2) the ‘gold or silver and coloring,’ and (3) a thin border at the bottom of the shape, delineated with a black line.” *Id.* at 4-5.

JH suggests that the court in *Weindling International Corp. v. Kobi Katz, Inc.*, No. 00-cv-2022 (JSR), 2000 WL 1458788 (S.D.N.Y. 2000), offers guidance in evaluating the creative choices made in designing jewelry. JH cites the court’s identification of design choices made in creating a ring, such as, “whether to design a ring or . . . a bracelet, what metals and stones to use, what shape and size of diamonds, what shape and size of supports, what kind of setting for the marquis diamond, and so forth.” Second Request at 2 (citing *Weindling*, 2000 WL 1458788 at *3).

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*) 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 Ninth Circuit rejected a claim of copyright in a piece of jewelry where the manner in which the parties selected and arranged the work's component parts was more "inevitable" than creative and original. See *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971). 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 merely of standardized designs or familiar symbols, or geometric shapes, for such a work to be registrable, 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 (geometric shapes), 906.2 (familiar symbols and designs) (3D ED. 2014) ("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."); COMPENDIUM (THIRD) § 908.2 ("The Office will not register pieces [of jewelry] that, as a whole, do not satisfy this requirement, 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, or any of the mechanical or utilitarian aspects of the jewelry"). 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. And the Office would not register a simple brooch design that consists only of three parallel rows of sapphires. *Id.* § 908.2.

Finally, Copyright Office registration specialists (and the Board) do not make aesthetic judgments in evaluating the copyrightability of particular works. *See* COMPENDIUM (THIRD) § 310.2. The attractiveness of a design, the espoused intentions of the author, the design's visual effect or appearance, its symbolism, the time and effort it took to create, or the design's commercial success in the marketplace are not factors in determining whether a design is copyrightable. *See, e.g., Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903); *Paul Morelli Design, Inc. v. Tiffany & Co.*, 200 F. Supp.2d 482, 488-49 (E.D. Pa. 2002) (finding that commercial success is not a factor in assessing originality in a case involving jewelry applications); COMPENDIUM (THIRD) §§ 310.2 (aesthetic value, artistic merit, and intrinsic quality), 310.3 (symbolic meaning and impression), 310.7 (time, effort, or expense), and 310.10 (commercial appeal and success).

B. Analysis of Naga Jewelry

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

The Board finds that none of the elements in Naga Jewelry are copyrightable. First, the individual dragon scales (regardless of color) are not protectable. That design—whether described as dragon or animal scales, or as overlapping half-circles—is too familiar and ordinary to qualify for copyright protection. Scales themselves are a common accessory and jewelry design, not to mention a common natural design. *See id.* § 313.4(J); § 908.2 (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, or any of the mechanical or utilitarian aspects of the jewelry are not protectable). Second, the Cassini-like oval cross-sectional shape of the jewelry does not have the creative spark necessary for copyright protection. Third, while JH recognized that color alone is not sufficient to qualify a work for registration, it does not sufficiently explain why the use of silver and gold—the most common color combination for jewelry—would qualify Naga Jewelry for copyright registration. Second Request at 4; *see also* COMPENDIUM (THIRD) § 313.4(K). Fourth, the designs consisting of the number 925 in a circle, the term 18k in a circle, the author's initials, or the name "John Hardy" do not qualify Naga Jewelry for copyright registration. Designations of metal quality are uncopyrightable as a listing of contents. *See* COMPENDIUM (THIRD) § 313.4(F). Further, the initials and name are uncopyrightable as mere lettering or as a word, respectively. *See also id.* § 913.1 (trademarks or logos consisting of mere wording or lettering will not be registered). Finally, the finished underside (including, again, the "dragon scale" design), the edge design, and the concave and convex designs on the ends of the jewelry, with engraved information, are not protectable. 37 C.F.R. § 202.1(a) ("[w]ords and short phrases . . .; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; [and] mere listing of ingredients or contents" are not protected by copyright); COMPENDIUM (THIRD) § 908.2 (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, or any of the mechanical or utilitarian aspects of the jewelry are not protectable).

Additionally, some of the design elements proposed by JH also result from unprotectable, functional considerations. The Office will not consider "[p]urely functional elements" of jewelry in analyzing copyrightability. COMPENDIUM (THIRD) § 908.3. The oval cross-sectional shapes are dictated by the function of jewelry, which is to be worn on the body. The concave and convex portions on the ends of the jewelry function as flat surfaces where identifying information can be engraved. At these points, the "dragon scale" designs simply end and turn into a flat, plain,

engrable surface. Moreover, according to JH, the underside of the jewelry is finished, not simply because of a creative choice, but because the finished underside “enhances the integrity and flexibility of the piece of jewelry” compared to “leaving the underside hollow.” Second Request at 4. These design elements cannot be physically separated from Naga Jewelry, nor can they “exist side by side and be perceived as fully realized, separate works.” COMPENDIUM (THIRD) § 924.2(B).

The question then is whether the combination of elements is protectable under the legal standards described above. The Board finds that, viewed as a whole, Naga Jewelry is not copyrightable, including in any selection, coordination, or arrangement as a compilation. While JH recites the *Compendium*’s application tips for jewelry—including that the Office will consider the shapes of design elements, the use of color, surface decoration, and selection and arrangement of the jewelry’s elements—it does not sufficiently address the issue that the Office will not register familiar designs. See *id.* §§ 908.2, 908.3. The *Compendium* makes clear that the Office “will not register pieces that, as a whole, do not satisfy [the originality] requirement, 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, or any of the mechanical or utilitarian aspects of the jewelry.” *Id.* § 908.2. As a whole, Naga Jewelry is not protectable under copyright law because its elements are “repeated in a standard geometric arrangement or a commonplace design.” *Id.* § 908.3.

JH’s reliance on *Weindling* is unpersuasive. That court discussed the creative choices made by the author of a bridge ring, and suggested that the creative choices included what metals and stones to use, what shape and size of diamonds, what shape and size of supports, what kind of setting for the marquise diamond, and so forth.” *Weindling*, 2000 WL 1458788 at *3. But in comparison to the work at issue in *Weindling*, those choices made here were too few, commonplace, or dictated by functional considerations to render Naga Jewelry copyrightable.

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 Naga Jewelry. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action in this matter.

BY:



Catherine Rowland
Copyright Office Review Board

Appendix A



NAGA GOLD & SILVER



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