



United States Copyright Office

Library of Congress · 101 Independence Avenue SE · Washington, DC 20559-6000 · www.copyright.gov

December 23, 2019

J. Kevin Grogan, Esq.
Grogan, Tuccillo & Vanderleeden, LLP
1350 Main Street 5th Floor, Suite 508
Springfield, MA 01103
docket@gtv-ip.com

Re: Second Request for Reconsideration for Refusal to Register “Cirque square stud with pave diamonds, Style # PE55”; Correspondence ID: 1-3FRDC16; SR # 1-6127581819

Dear Mr. Grogan:

The Review Board of the United States Copyright Office (“Board”) has considered Jane Taylor Jewelry LLC’s (“Jane Taylor’s”) second request for reconsideration of the Registration Program’s refusal to register a jewelry design claim in the work titled “Cirque square stud with pave diamonds, Style PE55” (“Cirque Square Stud”). 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 set of stud earrings that consist of a diamond shape white gold plate, with a vertical symmetrical arrangement of five diamonds on each side. A diamond shaped blue topaz is arranged below the array of diamonds, and in between the diamonds and the topaz gem, the white gold material is exposed. The Work is depicted as follows:



II. ADMINISTRATIVE RECORD

On December 21, 2017, Jane Taylor filed an application to register a copyright claim in the Work. In a letter dated July 12, 2018, a Copyright Office registration specialist refused to register the claim, finding that “it does not contain any design element that is both sufficiently original and creative.” Letter from LP, Registration Specialist, to James Grogan (July 12, 2018).

In a letter dated October 16, 2018, Jane Taylor requested that the Office reconsider its initial refusal to register the Work, asserting that the selection, coordination, and arrangement of the shape, size, color, cut, and orientation of gemstones, diamonds, and metal was sufficiently creative. Letter from J. Kevin Grogan, Grogan, Tuccillo & Vanderleeden, LLP, to U.S. Copyright Office at 5 (Oct. 16, 2018) (“First Request”). After reviewing the Work in light of the points raised in the First Request, the Office re-evaluated the claims and again concluded that the Work lacked sufficient copyrightable authorship, finding that “[a]ccenting a large common shape with smaller common shapes is an obvious, expected jewelry design that lacks the creativity necessary to support a claim in copyright.” Letter from Stephanie Mason, Attorney-Advisor, to J. Kevin Grogan (March 7, 2019).

In response, Jane Taylor 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 J. Kevin Grogan to U.S. Copyright Office (June 11, 2019) (“Second Request”). In that letter, Jane Taylor claimed that the Office “erroneously relies on the court’s opinion in *Satava v. Lowry*, that ‘. . . not every combination of unprotectable elements automatically qualifies for copyright protection. . . .’” *Id.* at 3. Jane Taylor argues that its earring design is “absolutely more than familiar symbols or designs or geometric shapes” by noting the “vertical arrangement of arrays of diamonds and horizontal asymmetric arrangement of London blue topaz with respect to the arrays of diamonds, as well as the exposure and emphasizing of the white gold.” *Id.* at 6.

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 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).

Finally, while the Office may register a work that consists merely 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. 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.”). 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.

B. Analysis of the Work

After carefully examining the Work and applying the legal standards discussed above, the Board finds that the Work does not contain the requisite authorship necessary to sustain a claim to copyright.

While there are many protectable jewelry designs, many of which include combinations of common shapes and other public domain elements, not all jewelry designs can surmount the low threshold of creativity established in *Feist* to warrant copyright protection. See 37 C.F.R. § 202.1(a) (“[W]orks not subject to copyright [include] familiar symbols or designs.”); see also COMPENDIUM (THIRD) § 908.2 (“The U.S. Copyright Office may register jewelry designs if they are sufficiently creative or expressive. The Office will not register pieces 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.”)

The jewelry design at issue includes a few elements featuring common gemstone cuts (round-cut diamonds and square-cut topaz) that are merely minor variations on common shapes (here, circles and squares), arranged in an unoriginal manner (a square inside of a larger square with circles outlining two of the larger square’s edges). The combination of these elements in this jewelry design is commonplace and expected in jewelry designs, and therefore, does not rise to the level of sufficient creativity for copyright protection. See COMPENDIUM (THIRD) §§ 906.1, 908.2 (“Common *de minimis* designs include solitaire rings, simple diamond stud earrings, plain bangle bracelets, simple hoop earrings, among other commonly used designs, settings, and gemstone cuts.”); see also, *DBC of New York, Inc. v. Merit Diamond Corp.*, 768 F. Supp. 414, 416 (S.D.N.Y. 1991) (holding the diamond rings at issue uncopyrightable because they are “on the whole, not exceptional, original, or unique”). As explained in *DBC of New York, Inc.*, well-known jewelry designs that consist of a combination of common elements are not “exceptional, original, or unique” enough to render a piece of jewelry sufficiently creative. *Id.* Likewise, the Work features common shapes (round cut diamonds and square cut gemstones) arranged in a way that is expected in jewelry configuration (e.g. placing smaller stones around a larger gemstone). Thus, the combination of the common elements is *de minimis* and insufficient to support copyright registration. Cf. COMPENDIUM (THIRD) § 313.4(J) (“a work consisting of a simple combination of a few familiar symbols or designs with minor linear or spatial variations” is not copyrightable).

Finally, Jane Taylor states that “for the instant jewelry design, there are numerous gemstones and diamonds of varies [sic] species, all having different sizes, colors, textures, and cuts to be selected from, [. . .] there are numerous metals of various shapes and sizes to be selected from,” and that “numerous different layouts can be formed by these various gemstones, diamond, and metals.” Second Request at 5. It is not, however, these possible choices that determine copyrightability, but rather the resulting expression of Jane Taylor’s jewelry design

itself. *See* COMPENDIUM (THIRD) §310.8. The Board finds that the Work's particular arrangement of individual design elements are not sufficient to render the Work original.

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, Register of Copyrights
and Director, U.S. Copyright Office

Regan A. Smith, General Counsel and
Associate Register of Copyrights

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