United States Copyright Office
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July 27, 2017

Ralph N. Gaboury, Esq.
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630 Third Avenue, 19th Floor
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Re: Ski Slope Ring; Request for Extension of Deadline to Submit Second Request for Reconsideration; Correspondence ID: 1-TOTS6P, SR # 1-1215156291

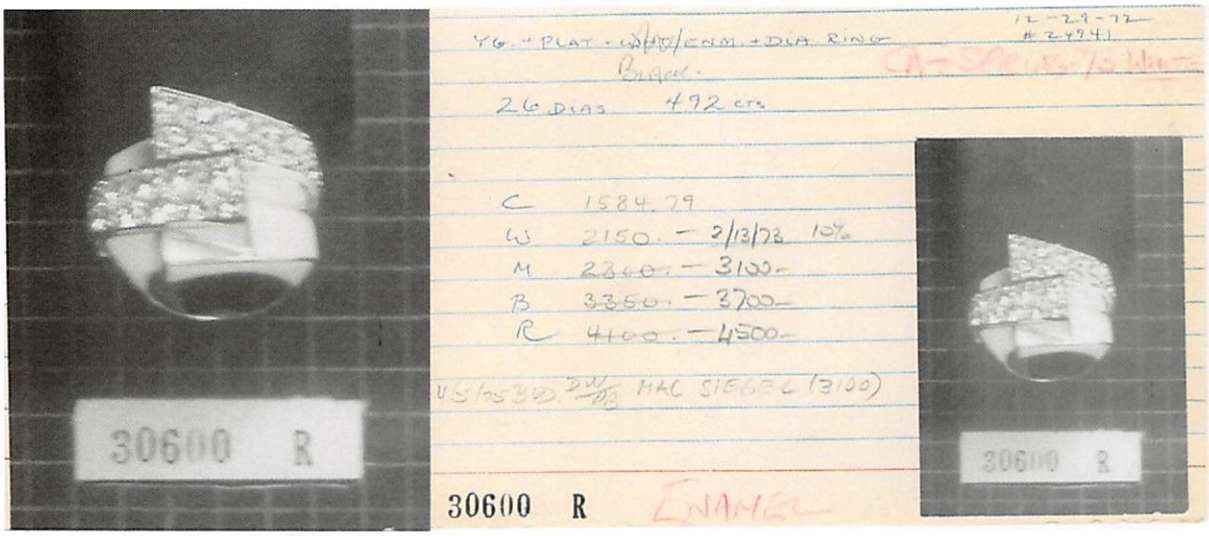
Dear Mr. Gaboury,

The Review Board of the United States Copyright Office ("Board") has considered David Webb, LLC's ("Webb") second request for reconsideration of the Registration Program's refusal to register a jewelry design claim in the Work entitled Ski Slope Ring ("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 application described the Work as a ring that was completed in 1972 and published in the United States on June 1, 1972. The deposit consisted of two photographs of a ring; neither image depicts a copyright notice on the ring:

In subsequent correspondence, Webb submitted images of the Work as first published in 1972, which also do not show a copyright notice:



II. ADMINISTRATIVE RECORD

On February 12, 2014, Webb filed an application to register a copyright claim in the Work. In correspondence with the Registration Program, Webb explained that the original deposit copies "represent exactly how the jewelry appeared when it was first released in 1972," but were not images of a ring produced in 1972. Email from Ralph Gaboury, Cox Padmore Skolnik & Shakarchy LLP, to U.S. Copyright Office (Feb. 20, 2014). The Registration Program responded, requesting "an image of the work as it was first published, showing the required copyright notice." Email from Rebecca Barker, Registration Specialist, to Ralph Gaboury (Feb. 28, 2014). Webb subsequently provided the above "photograph of the work taken immediately upon creation in 1972." Email from Ralph Gaboury to Rebecca Barker (Mar. 6, 2014). In a letter dated March 11, 2014, the Registration Program denied Webb's claim because there was "insufficient evidence . . . to show that the required copyright notice was used" on the Work. Letter from Rebecca Barker to Ralph Gaboury, (Mar. 11, 2014). As the Registration Program explained, in order to avoid falling into the public domain, works published before January 1, 1978 must have been published with proper copyright notice, including "(1) the word 'Copyright,' the abbreviation 'Copr.' or the symbol '©,' accompanied by (2) the name of the copyright owner, and (3) the year in which copyright protection was secured." *Id.*

Webb submitted a First Request for Reconsideration, dated June 10, 2014, supported by three affidavits of Webb employees. Letter from Ralph N. Gaboury to U.S. Copyright Office ("First Request") (June 10, 2014). Webb acknowledged that although it had submitted "a photograph of the Ski Slope Ring taken in 1972, the photograph was not of sufficient resolution to show the copyright notice imprinted into the shank of the ring." *Id* at 2. Webb noted that it no longer had any copies of the ring dating back to 1972, "as all such copies had been sold long ago." *Id.* Webb asked the Office to accept the submitted affidavits as evidence that the Work was first published with proper copyright notice because the affidavits were from Webb employees who had "first-hand knowledge of either having personally imprinted the Ski Slope Ring with the required copyright notice, or witnessed other employees imprinting each ring with the notice." *Id.* Webb further asserted that "throughout the 1970s and 1980s," it was Webb's policy to include notice on "every ring," and enclosed an image "of a similar [copyright notice] stamp

currently in use" by Webb, although this image was not of the Work. *Id.* The Registration Program again refused registration of the Work because it could not "verify that the [W]ork was published with an adequate copyright notice in the name of the owner as required by the 1909 Copyright Act." Letter from Stephanie Mason, Attorney-Advisor, to Ralph N. Gaboury (Oct. 3, 2014).

On January 15, 2105, Webb submitted a Request for Suspension of Deadline to Submit Second Request for Reconsideration or in the Alternative Applicant's Second Request for Reconsideration. Letter from Ralph N. Gaboury to U.S. Copyright Office ("Extension/Second Request"). In that letter, Webb noted that it was investigating sales records dating back to 1972 and asked for an extension in order to "locate an original ring with the required copyright notice." *Id.* at 2. In the alternative, Webb requested that the Office accept the affidavits submitted in the First Request as evidence of a copyright notice under the Rule of Doubt. *Id.* at 3. In light of Webb's ongoing investigation, the Board found that there was good cause to extend Webb's time to submit a second request for consideration. Letter from Erik Bertin, Copyright Office Review Board, to Ralph N. Gaboury (April 2, 2015) (citing 37 C.F.R. § 202.5(e)).

Following that initial request for an extension, Webb requested several additional extensions, including the last received on July 19, 2016. Letter from Ralph N. Gaboury to U.S. Copyright Office at 2 ("Request for Suspension of Deadline") (July 15, 2016). The various requests explained that Webb was continually monitoring sales of jewelry at auction houses and estate sales which typically sell a high volume of Webb jewelry. *See, e.g., id.* All of these requests for extensions were granted, ending with the last grant of an extension on September 13, 2106. Letter from Regan A. Smith, Copyright Office Review Board, to Ralph N. Gaboury ("Smith Letter") (Sept. 13, 2016). In that letter, the Board granted Webb 180 days to "satisfy the requirements of 37 C.F.R. § 202.17(h) by providing an original copy of the work as first published in accordance with the deposit requirements set forth in 37 C.F.R. §§ 202.20 and 202.21." *Id.* In the alternative, the Board explained that "in accordance with the Office's regulation governing waiver of the deposit requirement, Webb may provide the Board with an adequate explanation why it is either impossible or an undue hardship to provide such a copy, and instead submit, in descending order of preference, either a reproduction of the entire [W]ork as first published[;] a reprint of the work; or identifying material." *Id.* (citations omitted). The letter noted that given "the apparent lack of inventory of the original 'Ski Slope Ring' at auction houses or elsewhere, . . . the Board is concerned that the likelihood of a copy being located is diminishing," and was not inclined to grant additional requests for suspension of the deadline. *Id.* at 1-2.

As the Board calculates it, the last extension gave Webb until March 24, 2017 to reply with the deposit of the actual work, or submit alternative deposit materials in connection with a request for a waiver of the deposit requirement. To date, the Board has not received any response from Webb. This letter, accordingly, proceeds to resolve Webb's 2015 second request for reconsideration "in the alternative," including specifically, Webb's argument that the Work should be registered under the Rule of Doubt. *See* Extension/Second Request at 3.

III. DISCUSSION

After carefully examining the claim and deposit, the Board finds that the deposit submitted is insufficient to support registration of the Work and thus upholds the decision to refuse registration.

To register a copyright claim in a work that was published prior to January 1, 1978 "where no registration was made during the original term of copyright" the applicant must submit a Form RE and Form RE/Addendum, along with the proper fees and deposit "one . . . copy . . . of the work as first published (or identifying material in lieu of a copy).". 37 C.F.R. §§ 202.17(h)(1), (h)(5); COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES §§ 2112.1, 2116.5(A) (3d ed. 2014) ("COMPENDIUM (THIRD)"). In accordance with the pre-1978 law, the originally published work must have included proper copyright notice; absent such notice, the work is not entitled to copyright protection. *See* 37 C.F.R. § 202.2(a)(2) ("If before January 1, 1978, publication occurred by distribution of copies or in some other manner, without the statutory notice or with an inadequate notice, as determined by the copyright statute as it existed on the date of first publication, the right to secure copyright was lost."); *see also* COMPENDIUM (THIRD) § 2121.2 (stating that for original works of art published prior to January 1, 1978, "[t]he copyright notice should be legible and permanently affixed to the work itself and the required elements should appear together.").[1] To fulfill the deposit requirements for jewelry, applicants must submit identifying material that comports with the Office's regulations, or, in the case of jewelry cast in non-precious metal and measuring less than four inches long, they may submit a copy of the actual work. *See* 37 C.F.R. §§ 202.20(c)(2)(xi)(A)(ii), (c)(2)(xi)(B)(*5*) (stating that for "[a]ny . . . three-dimensional work . . . if published . . . only in or on jewelry" "the deposit must consist of identifying material complying with [section § 201.21 of the Office's regulations] instead of a copy or copies" except where "[a]ny three-dimensional sculptural work. . . if published, has been published only in the form of jewelry cast in base metal which does not exceed four inches in any dimension."); *see also* COMPENDIUM (THIRD) § 1509.3(B)(2). For works published prior to January 1, 1978, the identifying material must, *inter alia*, include "the notice and its position on the work . . . clearly shown." 37 C.F.R. § 202.21(e).

Here, the Work was created and first published in 1972. First Request, 1-2 ("The Ski Slope Ring was created by David Webb in 1972, with first publication through sale on December 29, 1972."). Though Webb asserts that the Work was published with proper notice, neither the original deposit material submitted with the application, nor the subsequent photos provided in correspondence with the examining specialist depict any notice of copyright on the Work. Therefore, the Board finds that Webb's original deposit is insufficient to support registration.

Nor has Webb provided sufficient materials for the Board to waive the deposit requirement under the Office's regulations. As noted, when an applicant fails to meet the deposit requirements for a work published prior to January 1, 1978, the applicant may request a waiver of these deposit requirements by "assert[ing] that it is either impossible or otherwise an undue hardship to satisfy the deposit requirements of 37 C.F.R. 202.20 and 202.21." 37 C.F.R.

[1] While notice is no longer required to obtain a registration, notice of copyright properly affixed to post-1978 works will defeat a defense of "innocent infringement" to mitigate actual or statutory damages in the case of non-willful infringement. *See* 17 U.S.C. §§ 401, 402, 504.

§ 202.17(h)(6); *see* Smith Letter at 2 (explaining standard). In such cases "the Copyright Office, at its discretion, may, upon receipt of an acceptable explanation of the inability to submit such copy or identifying material, permit the deposit . . . in descending order of preference" a reproduction of the entire work as first published, a reprint of the work such as "a later edition, a later release of a reproduction, or the like," or identifying material "including a reproduction of the greatest feasible portion of the copyrightable content of [the] work . . . as first published, and a photocopy or photograph showing the copyright notice content and location as first published." 37 C.F.R. § 202.17(h)(6)(i)-(iii). "In every case, however, proof of the copyright notice showing the content and location of the notice as it appeared on copies or phonorecords of the work as first published must be included." *Id.*

Here, despite an express invitation from the Board, Webb has not directly requested a waiver of the deposit requirement, nor contended that the affidavits submitted as part of its first request for consideration suffice under the Office's regulations. Indeed, it appears Webb is unable to provide an acceptable alternative deposit. While the regulations provide discretion for the Office to accept a qualifying reproduction or reprint of the Work under certain circumstances, none of the post-1972 images provided by Webb show the content and location of the notice on the Work as first published, as is required "[i]n every case" under 37 C.F.R. § 202.17(h)(6). Although Webb submitted an image of "a similar stamp that is used today" to provide notice on its rings, this image does not appear to be of the same ring and Webb has provided no explanation how this image might satisfy the alternative deposit requirements. Accordingly, the Board does not see a reason to disturb the Registration Program's decision that the affidavits submitted did not meet the required formalities for an exception to the deposit requirements

Additionally, the Board declines Webb's request for registration under the Rule of Doubt. *See* Extension/Second Request at 3-5. Under the Rule of Doubt, the Office may on occasion register a claim to copyright even though the Office has reasonable doubt as to whether the material submitted for registration constitutes copyrightable subject matter or other legal and formal requirements of the statute having been met. *See* COMPENDIUM (THIRD) § 607. For example, the Office may register a claim under this provision if the applicant submits an application to register a computer program with a deposit copy consisting solely of object code, rather than source code. And, in exceptional cases, the Office may invoke the Rule of Doubt when it has not taken a position on a legal issue that is directly relevant to whether the work constitutes copyrightable subject matter. *Id.* Neither of these circumstances is present in this situation. Accordingly, the Rule of Doubt provision is not applicable with respect to the Work.

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.

BY: Regan A. Smith

Regan A. Smith
Copyright Office Review Board