



United States Copyright Office

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June 28, 2017

David A. Einhorn
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**Re: Second Request for Reconsideration for Refusal to Register Ideal Cushion Design;
Correspondence ID: 1-1S5E3JG; SR # 1-1555218321**

Dear Mr. Einhorn:

The Review Board of the United States Copyright Office (“Board”) has considered your client Worldwide Diamond Trademarks Ltd.’s (“Worldwide Diamond”) second request for reconsideration of the Registration Program’s refusal to register a jewelry design claim in the work titled “Ideal Cushion Design” (“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 design of a cut diamond with four curvilinear sides and four curvilinear corners connecting the long sides. The work consists of the flat top surface (the “table”), the cone-shaped lower part of the design (the “pavilion”), and the thin band connecting the two (the “girdle”). The diamond design has seventy-seven non-girdle facets, or flat faces of the diamond (145 if the girdle facets are included). The facets are a collection of triangles, quadrilaterals, pentagons, and octagons. Reproductions of the Work are included as Appendix A.

II. ADMINISTRATIVE RECORD

On July 2, 2014, Worldwide Diamond filed an application to register a copyright claim in the Work. In a September 15, 2015 letter, a Copyright Office registration specialist refused to register the claim, because it was a useful article lacking physical or conceptual separability. Letter from Larisa Pastuchiv, Registration Specialist, to David Einhorn (September 15, 2015).

In a letter dated December 14, 2015, Worldwide Diamond requested that the Office reconsider its initial refusal to register the Work. Letter from David A. Einhorn to U.S. Copyright Office (December 14, 2015) (“First Request”). Worldwide Diamond argued in the First Request that cutting a rough diamond is analogous to sculpting a stone and noted that the Office registered a cut diamond in 2001. After reviewing the Work in light of these points raised, the Office again concluded that the Work was not copyrightable because, even though U.S.

copyright law treats jewelry designs like sculptural works, “no element of this Work, either alone or in combination, reflects a sufficient amount of creative authorship.” Letter from Jaylen S. Johnson, Attorney-Advisor, to David Einhorn, at 2–3 (August 4, 2016).¹ The letter also explained that “the Office does not compare works which have been registered with those that are the subject of a request for registration.” *Id.* at 2.

In a letter dated November 4, 2016, Worldwide Diamond requested that the Office reconsider for a second time its refusal to register the Works. Letter from David A. Einhorn, to U.S. Copyright Office (November 4, 2016) (“Second Request”). Worldwide Diamond argued that the cut diamond demonstrates at least a modicum of creativity because the selection and arrangement of the facets “represents one of a potentially infinite number of [design] decisions” and, thus, constitutes original creative expression. Second Request at 3–4. Worldwide Diamond argued that the merger doctrine does not serve as a bar to copyrightability because the design is not merely a function of reflecting a specific amount of light. *Id.* at 4 (“For any particular grade of cut, there are many different designs that would help achieve the requisite brilliance.”). Additionally, Worldwide Diamond again relied on the Office’s 2001 registration of a diamond cut.

III. DISCUSSION

A. *The Legal Framework*

1) *Distinction Between Idea and Expression*

Section 102(b) of the Copyright Act provides that copyright protection for expressive works does not extend to “any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.” 17 U.S.C. § 102(b). Section 102(b) codifies the longstanding principle, known as the idea-expression dichotomy, that copyright law protects the original expression of ideas, but not the underlying ideas themselves. The Supreme Court in 1879 held that the copyright in a book describing a bookkeeping system, with blank forms and ruled lines and headings, did not give the copyright owner the right to prevent others from using the bookkeeping system described or “the exclusive right to make, sell, and use account-books prepared upon the plan set forth in such book.” *Baker v. Selden*, 101 U.S. 99, 102-04 (1879).

Copyright’s merger doctrine, which states that idea and expression merge together when the expression cannot be separated from the idea, is a closely related principle that bars copyrightability of certain works. *See id. at 103* (explaining that if the “art” that a book “teaches cannot be used without employing the methods and diagrams used to illustrate the book, or such

¹ In responding to the First Request, the Office noted that the original refusal letter errantly classified the work as a “useful article.” *See* Letter from Jaylen S. Johnson, Attorney-Advisor, to David Einhorn, at 3 r.1 (August 4, 2016).

as are similar to them, such methods and diagrams are to be considered as necessary incidents to the art, and given therewith to the public”); *CCC Info. Servs., Inc. v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61, 68 (2d Cir. 1994) (“[W]hen the expression is essential to the statement of the idea, the expression also will be unprotected, so as to insure free public access to the discussion of the idea.”).

2) *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 *Feist* 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 that “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 that 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, Copyright Office registration specialists (and the Board) do not make aesthetic judgments in evaluating the copyrightability of particular works. *See* COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 310.2 (3d ed. 2014) (“COMPENDIUM (THIRD)”). The attractiveness of a design, the espoused intentions of the author, the design’s visual effect or 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). Neither does the Copyright Office compare works that have been registered with those that are the subject of a request for reconsideration. *Cf.* COMPENDIUM (THIRD) § 309.3 (“A decision to register a particular work has no precedential value and is not binding upon the Office when it examines any other application.”).

B. Analysis of the Work

After carefully examining the Work and applying the legal standards discussed above, the Board finds that the Work fails to satisfy the requirement of creative authorship necessary to sustain a claim to copyright.

Here, Worldwide Diamond asserts a copyright claim in a faceted gemstone with 145 facets (including seventy-seven non-girdle facets). However, “faceting of individual stones (*i.e.*, gem-cutting)” is “generally not copyrightable” or “considered in analyzing copyrightability” of works incorporating gemstones. COMPENDIUM (THIRD) § 908.3. This reflects the principle that copyright protection does not extend to any procedure, method, or process for doing, making, or building items. *See* 17 U.S.C. § 102(b). The “faceting” of a gemstone is a mechanical process that allows the stone to reflect light in particular ways. Though Worldwide Diamond asserts that “[f]or any particular grade of cut, there are many different designs that would help achieve the requisite brilliance[.]” Second Request at 4, registering the Work would provide copyright protection for at least one technique for reflecting light, which is prohibited by section 102(b) and by the merger doctrine.

Moreover, even assuming that the “arrangement of the facets in the Work is but one expression of an idea among many possible others for cushion cut diamonds” and that it is not

tethered to the reflection of light desired, Second Request at 4, the expression found in the arrangement does not rise to the modicum of creativity necessary for copyrightable expression. *See Feist*, 499 U.S. at 362 (“This is ‘selection’ of a sort, but it lacks the modicum of creativity necessary to transform mere selection into copyrightable expression.”). That is, even if section 102(b) did not serve as a bar to registration, section 102(a) would. The Work—which is the result of a particular faceting technique—does not demonstrate sufficient creativity to qualify as a copyrightable work of authorship under section 102(a).

Irrelevant to this inquiry is the claim that “[t]he Work is the product of years of design work, substantial resources, and [the diamond cutter’s] significant artistic skill and labor in designing the pavilion facets of the diamond in a unique, aesthetically pleasing fashion.” Second Request at 2. Time, resources, and skill are not part of the copyrightability calculus. *See* COMPENDIUM (THIRD) § 310.7; *see also Sophia & Chloe, Inc. v. Brighton Collectables, Inc.*, No. 12-CV-2472, 2016 WL 3211800, at *5 (S.D. Cal. Mar. 21, 2016) (noting that “devot[ing] much time and effort to designing jewelry featuring a common shape does not transform [the common shape] into copyrightable expression”). It also does not matter whether a work of authorship is “unique,” so long as it is original to the author. *Feist*, 499 U.S. at 345. And the availability of copyright protection is not based on a judgment of a work’s aesthetic value. *See Bleistein*, 188 U.S. at 251 (“It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”); COMPENDIUM (THIRD) § 310.2. The relevant question is whether the work is sufficiently creative.

Jewelry that incorporates cut gemstones may be considered copyrightable if the design is sufficiently creative. But, even then, certain jewelry designs have only *de minimis* creativity, barring copyrightability. Examples include solitaire rings, simple diamond stud earrings, and commonly used gemstone cuts. *See* COMPENDIUM (THIRD) § 908.2.

The Second Request acknowledges that each of the geometric shapes formed by the faceting, “standing alone, is not copyrightable” and notes that it instead seeks to register the selection and arrangement of these shapes. Second Request at 3. The Office, however, disagrees with Worldwide Diamond that the arrangement of these common geometric shapes results in anything more than a standard diamond design. The authorship involved in selecting, coordinating, and arranging the facets must be objectively apparent from the deposit submitted to the Copyright Office. *See* 17 U.S.C. § 410(a). From the deposited material, the Board cannot see how the arrangement of facets differs in any material way from a standard “cushion cut” diamond design. *See* <http://www.zales.com/wedding/education/diamond-buying-guide/category.jsp?categoryId=3334564>. To the eye of the Review Board, there are no differences between the top view of a “cushion cut” diamond on the Zales website and the Work that are sufficient to warrant copyright registration.

Finally, the Office acknowledges the 2001 registration for a diamond facet design. *See* First Request (attaching a copy of the November 6, 2001 Review Board letter registering the Flanders Brilliant Cut Diamond). The Office thanks Worldwide Diamond for bringing this registration to its attention. As previously stated, however, “the Office does not compare works

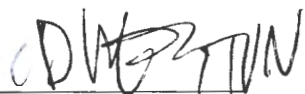
which have been registered with those that are the subject of a request for registration.” Letter from Jaylen S. Johnson, Attorney-Advisor, to David Einhorn, at 2 (August 4, 2016). This principle effectuates a rule clearly stated in the Compendium that “[a] decision to register a particular work has no precedential value and is not binding upon the Office when it examines any other application.” COMPENDIUM (THIRD) § 309.3. Nor is the Office required to compare works. *See Homer Laughlin China Co. v. Oman*, Civ. A. No. 90–3160, 1991 WL 154540 (D.D.C. July 30, 1991) (finding the Register of Copyrights did not abuse discretion by not comparing china patterns that had been registered with the plaintiff’s china pattern). Moreover, without re-analyzing the Flanders Brilliant Cut Diamond or second-guessing the 2001 registration decision made regarding that work, the Office notes that it is uncertain whether the same result would be obtained today.

Though works may be copyrightable if their selection, arrangement, or modification reflects authorial discretion that is not so minor that the “creative spark is utterly lacking or trivial, *Feist*, 499 U.S. at 359, the arrangement of the Work’s facets do not rise to that level. The Office finds that the creative authorship in this configuration of unprotectable elements is, at best, *de minimis* and, thus, too trivial to allow for copyright registration.

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:


Chris Weston
Copyright Office Review Board

APPENDIX A

