

REGISTERING YOUR RIGHTS

ALL JEWELRY MANUFACTURERS SHOULD PROTECT THEIR
DESIGNS BY REGISTERING THEIR COPYRIGHTS.
FORTUNATELY, FILLING OUT THE FEDERAL COPYRIGHT
REGISTRATION FORM IS AS EASY AS 1-2-3.

≡ by Jeffrey M. Kaden, Esq. ≡

Copying is rampant in the jewelry field, as it is in much of American industry. But manufacturers and designers do have recourse. This article sets out some of the basics of copyright protection: What jewelry designs can be protected by copyright? What is an infringing design? Can infringement be avoided? Can you file your own copyright application with the Copyright office? The copyright form, known as the form for the "Visual Arts," is constructed to be easily completed by artists, manufacturers, designers and creators. But before we get into filling out the form itself, we should answer a few basic questions.

WHAT IS A COPYRIGHT?

Copyright protects virtually all original "artwork", as applied to any form or expression, including jewelry. The designs of rings, pendants, bracelets, necklaces and watches can typically be protected by copyright.

Copyright protection is specific to the artwork, not to the "concept" and not to the media

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used. Thus, if you protect your artwork as it appears in a pendant, it is automatically protected in any jewelry piece.

Copyright protection begins at the moment of creation - that is, when the original expression or the artwork is fixed in tangible form, such as a drawing or a computer printout. As soon as you draw it, you're protected — that's the law!

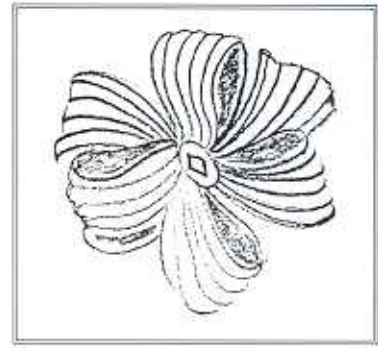
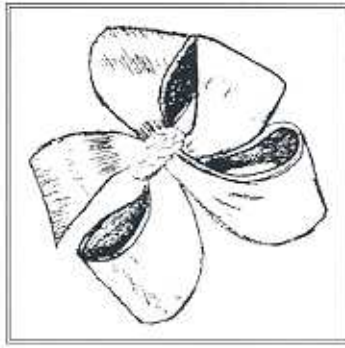
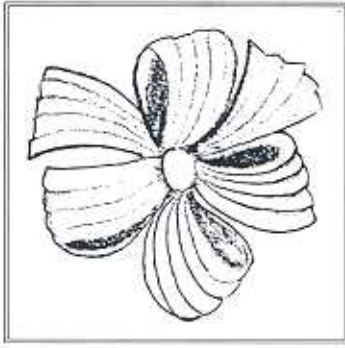
Registration of a copyright in the Copyright Office in Washington, D.C. confirms the existence of an original creation and documents your ownership. Registration is optional, but highly desirable if you want to protect your design.

WHAT IS COPYRIGHTABLE?

Virtually every "artistic creation" is copyrightable, including abstract and geometric designs, bouquets of flowers, combinations of words and figures. However, if the artwork is based on old reference material, only the change or variation is copyrightable, not the original reference material. Andy Warhol created his own version of the Mona Lisa — his version is protected by copyright, but everyone else can still go to the original and do his or her own version, as long as the Warhol version isn't copied.

Works that are not copyrightable comprise simple geometric forms and shapes, such as stripes, dots, plaids, checks, cubes, cones and spheres. Conventional shapes for jewelry stones (oval, marquise, heart) are not protectable by copyright, but a unique combination of different shapes may be.

In addition, you may be able to protect your work under design patent, trademark or trade dress even when designs are not copyrightable because they lack sufficient artistry. (See the section below, "What Other Protection Is Available...").



When Is a Copy "Substantially Similar"? (Left) An artist's original piece of jewelry in the shape of a ribbon bow with four striped loops, two ends, and a plane center stone. (Middle) A similar design, but one that would probably not be considered an infringement: The design's loops are solid and not striped, the number of loops is different (three instead of four), the ribbon ends are straight instead of fluted, and it has a multiple-stone center. (Right) This third design would most likely be considered an infringement. It has undergone only the slightest cosmetic changes: It has the same number of striped loops in the bow (stylized a little differently), has a center stone with a minimal design addition, and has the same two ribbon ends.

WHO OWNS A COPYRIGHT?

If original artwork is done in-house by a company employee - typically an employee who gets a W-2 form from his/her employer - the company owns the copyright and no paperwork is needed to make certain that the company is the copyright owner.

When original artwork is done by an outside designer or studio, the outside entity owns the copyright. Copyright can be transferred by the outside designer to the employer with a transfer form. (Payment of an invoice alone does not transfer copyright). If a written transfer form is not signed by the outside designer, the copyright stays with the outside designer.

WHY SHOULD I REGISTER MY COPYRIGHT?

There are three main reasons for registering a copyright:

- The registration is an important part of a "cease and desist" letter sent to an infringer.
- You must have a registration before filing a lawsuit.
- If the copyright registration form is filed within three months of first publication of the work, a company is entitled to recover attorneys' fees from an infringer.

AM I VIOLATING COPYRIGHT LAW IF I FOLLOW MARKETPLACE TRENDS?

Using reference materials for inspiration is acceptable and is not illegal. Substantially copying another party's copyrighted material constitutes copyright infringement and is unlawful.

The legal test for determining if a copy is an infringement is whether the copy is "substantially similar" in the eyes of the average consumer; this is the standard that will be applied by a court of law.

DO I HAVE TO USE THE COPYRIGHT NOTICE (©)?

Since the United States became a member of the Berne Copyright Convention in March 1989, the use of a copyright notice is optional. However, you should use the notice in order to warn potential infringers, as well as to obtain full damages if your copyright is violated.

All jewelry pieces (samples and finished goods), as well as print ads, catalogs and any other displays of the copyrighted work should carry a copyright notice. The notice on printed catalogs and advertisements should carry the copyright symbol (©), the copyright holder and the year of first publication (e.g., "© John Jones Inc. 1997"). On goods, the notice will take the abbreviated form ("©JJ.") molded into the product, usually on the back or underside of the piece.

WHAT ARE THE BENEFITS OF AN ACTIVE COPYRIGHT PROGRAM?

An active copyright program will:

- Prevent counterfeiters from using a company's valuable designs.
- Stop both the importation and the domestic production of infringing designs.
- Warn others in the marketplace. (Competitors will know not to copy.)

WHAT IF A CUSTOMER REQUESTS YOU TO "REPRODUCE" A DESIGN?

These requests are common. If a customer asks you to reproduce a design which is protected by copyright, your lack of knowledge about that copyright is no excuse in a court of law. You

must assume that the copyright belongs to somebody other than just your customer.

In these situations, you should strongly suggest to the customer that the design can be materially revised, but still have the same "look" and/or "feel." If the customer insists, be sure to get a "hold harmless" letter from him or her before proceeding. Depending on your relationship with the customer, you may simply want to turn the job down, since even the "hold harmless" letter is no guarantee.

WHAT OTHER PROTECTION IS AVAILABLE IF MY DESIGN IS NOT COPYRIGHTABLE?

There are two other options available to manufacturers for protecting designs that are not copyrightable. These are the design patent and the trademark.

To be patentable, a design must be new and sufficiently different from prior designs. An application for a design patent is filed with the U.S. Patent Office and can be a somewhat expensive and lengthy process. Patent applications generally require a patent attorney's help and must be filed within one year of the product's first public or commercial showing or sale. Despite the high cost and length of time, design patents are often the most available mode of protection for jewelry designs that are not sufficiently artistic to be protectable by copyright.

Trademark protection (often referred to as "trade dress" when applied to a product's design) extends to a design that is recognizable by the consuming public as coming from a single source - for example, the Coca-Cola bottle. However, in most cases it is very difficult to demonstrate distinctiveness. Voluminous advertising evidence and consumer statements are often required before trademark protection for a product is extended.

FILLING OUT THE COPYRIGHT FORM

The Copyright VA form (for Visual Arts) is attached to this reprint. The Copyright Office will accept photocopies of this form, so you may reproduce copies and use them for registering additional copyrights. The following "how to" guide is keyed to the various numbered paragraphs on the form, and the titles of the VA form paragraphs appear in bold type.

1 TITLE OF THIS WORK: Use your own unique description of the style number, name, etc.

NATURE OF THIS WORK: Use the description "jewelry design". The rest of this section can be left blank.

2a NAME OF AUTHOR: If the work was done in-house by your own employee/designer, insert the full company or corporate name, and check "Yes" for "work made for hire". If the work was purchased from an outside designer or design firm, the check "No" in the "work made for hire" and fill in the full legal name of the outside designer or firm.

AUTHOR'S NATIONALITY OR DOMICILE: If your company is the author listed under "Name of Author," list the company's state of incorporation. If an outside company did the work, list its state of incorporation.

DATES OF BIRTH AND DEATH: If the applicant is a company, leave blank; specify for an individual.

WAS THIS AUTHOR'S CONTRIBUTION TO THE WORK ANONYMOUS/PSEUDONYMOUS?

Check "No" in both boxes.

NATURE OF AUTHORSHIP: Check the most appropriate box- in this case, "jewelry design."

2b NAME OF AUTHOR, ETC. Fill in Paragraph 2b only if there is more than one author of a work.

3a YEAR IN WHICH CREATION OF THIS WORK WAS COMPLETED: Fill in the year when the final design was completed. If bought from outside, put in the year the outside designer completed the work.

3b DATE AND NATION OF FIRST PUBLICATION....

Date: The publication date is the date when a product bearing the design is first used to solicit orders, such as being published in a catalog or displayed to the trade. This date is usually prior to the actual shipment of goods to customers. If the item has not been displayed or showed, leave the space blank- it is an unpublished work.

Nation: Enter U.S.A. if the solicitation of sales or shipment occurs first in this country. If first publication happened elsewhere, fill in the correct country.

4 COPYRIGHT CLAIMANT(S): Insert the name and address of the entity, regardless of who authored the jewelry design, that is going to own the copyright. (This entry must be identical to the name in the copyright notice.)

TRANSFER: If the design was purchased from an outsider, enter the following: "By written transfer from author."

5 PREVIOUS REGISTRATION: Usually, the "No" box should be checked. "Yes" should only be checked where the design is a variation or revision of a design previously registered in the Copyright Office by your company. If "Yes" is checked, fill in the appropriate reason why another registration is being sought.

6 DERIVATIVE WORK OR COMPILATION:

Part a, Pre-existing Material: In the case of wholly original designs, this space is generally left blank. However, for designs that incorporate prior design elements of others, the "old" design portions should be identified under "pre-existing material" with appropriate language, such as "Geometric shapes and ornamentation elements selected from public domain sources of third parties" or "Pin by John Jones, Style No. 101"

Part b, Material Added to This Work: The particular claim to copyrightable subject matter should be specified here, since you are claiming artistic material added to a pre-existing work. The following would be typical: "Copyright is claimed in the compilation and organization of the artistic elements identified above."

7 DEPOSIT ACCOUNT: This section should be left blank, unless you regularly file large numbers of copyright applications.

CORRESPONDENCE: Correspondence should be sent to the attention of the individual placed in charge of the copyright filing project.

8 CERTIFICATION: If your company is the "author" in Paragraph 2 above, then the box with "author" should be checked here as well, and the application should be signed by an

officer of your company. If your company is not the author in Section 2, the box identifying "authorized agent of _____" should be checked. Enter your company's name in the blank space, and make sure the application is signed by an officer of your company.

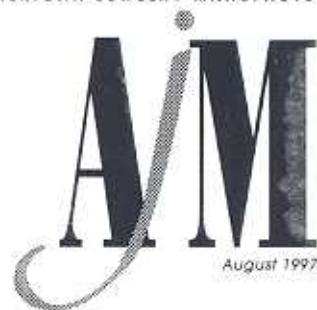
9 MAIL CERTIFICATE TO: List your company's full name and mailing address, and give the name of a specific individual.

Once you've completed the form, attach two identical specimens of work. These are normally photographs of the jewelry design or piece. Do not send in the actual jewelry piece! Enclose a check for the \$20 filing fee, payable to "Register of Copyrights" and mail the completed application to Register of Copyrights, Library of Congress, Washington, D.C. 20559-6000.

Finally, for your own records, be sure to keep in one file a complete copy of everything sent to the Copyright Office. ♦

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