

421 F.3d 199

United States Court of Appeals, Third Circuit.

KAY BERRY, INC. Appellant

v.

TAYLOR GIFTS, INC.; Bandwagon, Inc.

Aug. 30, 2005.

Before McKEE, VAN ANTWERPEN and WEIS,
Circuit Judges.

OPINION

VAN ANTWERPEN, Circuit Judge.

Before us is an appeal from an order granting summary judgment in favor of the defendant-Appellees on a copyright infringement claim. Appellant Kay Berry, Inc. (“Kay Berry”) claims that Appellees Taylor Gifts, Inc. (“Taylor”) and Bandwagon, Inc. (“Bandwagon”) infringed its copyright on its sculptural work—a garden rock cast with a poem found in the public domain. The United States District Court for the Western District of Pennsylvania granted summary judgment after determining that Kay Berry’s copyright registration was invalid and that the sculptural work was not entitled to copyright protection. We will reverse.

I. FACTUAL BACKGROUND AND PROCEDURAL HISTORY

Kay Berry designs, manufactures, markets and sells “Garden Accent Rocks,” which it describes as decorative, cement-cast, outdoor sculptures typically resembling rocks or stones, inscribed with writings. On July 7, 1997, Kay Berry applied for a copyright registration for its entire line of Garden Accent Rocks. It provided its Garden Accent Rock Catalog (the “Catalog”) as the document specimen for the registration. The Catalog identified each sculpture by number and featured a description and photograph of each individual work. The United States Copyright Office issued Kay Berry a Copyright Registration

Certificate (the “Certificate”) with an effective date of July 1, 1997. The Certificate identified the scope of the Certificate’s subject matter as simply “[s]culptural works with design and text.”

One of Kay Berry’s best-selling Garden Accent Rocks is Sculpture No. 646, a rectangular object having a stone-like appearance and a verse inscribed on the face. The verse appears in five lines, inscribed in a right-leaning font with the first letter of each word capitalized:

If Tears Could Build A
Stairway, And Memories
A Lane, I’d Walk Right Up
To Heaven And Bring
You Home Again

During 2003, Bandwagon began supplying to Taylor, and Taylor began marketing and selling, a “Memory Stone,” which was similar to Kay Berry’s Sculpture No. 646. Like Sculpture No. 646, the Memory Stone was a rectangular object with a stone-like appearance featuring the exact same verse that appears on Sculpture No. 646. The Memory Stone’s verse was also laid out in the same five-line format, each word also began with a capital letter, and the entire verse also appeared in a right-leaning font.

Kay Berry sued Taylor and Bandwagon for copyright infringement . . . [Defendants] filed an amended motion for summary judgment on the infringement claim. . . . On August 30, 2004, the District Court granted [the motion]. This timely appeal followed.

[...]

III. ANALYSIS

“To establish a claim of copyright infringement, a plaintiff must establish: (1) ownership of a valid copyright; and (2) unauthorized copying of original elements of the plaintiff’s work.” In granting summary judgment in favor of [Defendants], the District Court . . . concluded that: (1) . . . , (2) Sculpture No. 646 contained no copyrightable subject matter, and (3) Sculpture No. 646 embodied an expression

that was inseparable from an underlying idea. For the reasons set forth below, we will reverse.

[...]

B. Sculpture No. 646 is entitled to Copyright Protection

Next, the District Court concluded that Sculpture No. 646 lacked any protectible configuration or design. We disagree.

“To qualify for copyright protection, a work must be original to the author ... mean[ing] only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.” *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). A sculptural work’s creativity derives from the combination of texture, color, size, and shape, as well as the particular verse inscribed and the way the verse is presented. It means nothing that these elements may not be individually entitled to protection; “all creative works draw on the common wellspring that is the public domain. In this pool are not only elemental ‘raw materials,’ like colors, letters, descriptive facts, and the catalogue of standard geometric forms, but also earlier works of art that, due to the passage of time or for other reasons, are no longer copyright protected.” *Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 132 (2d Cir.2003). When an author combines these elements and adds his or her own imaginative spark, creation occurs, and the author is entitled to protection for the result. This is true even when the author contributes only a minimal amount of creativity.

Here, Kay Berry claims that it selected an inspirational poem from the public domain, adapted that poem to make it visually and rhythmically appealing, and then cast it on its own sculptural work. For these reasons, as well as those set forth above, we conclude that this quantum of creativity is sufficient to qualify for copyright protection.

C. Kay Berry’s Copyright Registration Does Not Extend to an Idea

We next turn our attention to the second part of the infringement inquiry—whether Appellees improperly copied Sculpture No. 646, and specifically, whether the expression Kay Berry seeks to protect has merged with an unprotectible idea. Copying refers to the act of infringing any of the exclusive rights that accrue to the owner of a valid copyright, as set forth at 17 U.S.C. § 106, “including the rights to distribute and reproduce copyrighted material.” It may be demonstrated by showing that the defendant had access to the copyrighted work and that the original and allegedly infringing works share substantial similarities.

[...]

“Not all copying, however, is copyright infringement.” [...] It is a fundamental premise of copyright law that an author can protect only the expression of an idea, but not the idea itself. *See* 17 U.S.C. § 102(b); *see also Baker v. Selden*, 101 U.S. 99, 103-04 (1880). Thus, an author may base his work on the same inspiration as that of an earlier work, but he may not “copy the copy.” When determining whether two works are substantially similar, a fact-finder must determine whether the later work is similar because it appropriates the unique expressions of the original author, or merely because it contains elements that would be expected when two works express the same idea or explore the same theme.

Nearly every work involves a blend of idea and expression. Because an author can only demonstrate substantial similarity by referencing those aspects of his work that embody his creative contribution, he will have a more difficult time proving infringement if his work contains only a minimal amount of original expression. *Universal Athletic Sales*, 511 F.2d at 908 (“[B]etween the extremes of conceded creativity and independent efforts amounting to no more than the trivial, the test of appropriation necessarily varies.”). As one court has explained:

[A] copyright on a work which bears practically a photographic likeness to the

natural article ... is likely to prove a relatively weak copyright. This is not to say that, as a matter of law, infringement of such a copyright cannot be inferred from mere similarity of appearance, but only that the plaintiff's burden will be that much more difficult to sustain because of the intrinsic similarities of the copyrighted and accused works.

First Am. Artificial Flowers, Inc. v. Joseph Markovits, Inc., 342 F.Supp. 178, 186 (S.D.N.Y.1972). The First Circuit has endorsed this view, explaining that when there is only a limited number of ways to express an idea "the burden of proof is heavy on the plaintiff who may have to show 'near identity' between the works at issue." *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 606-07 (1st Cir.1988).

In some instances, there may come a point when an author's expression becomes indistinguishable from the idea he seeks to convey, such that the two merge. In these circumstances, no protection is available for the expression; otherwise, the copyright owner could effectively acquire a monopoly on the underlying art or the idea itself. Merger is rare, however, and is generally found in works with a utilitarian function. This Court has never found an instance in which a completely aesthetic expression merged into an idea. For instance, in *Masquerade Novelty, Inc. v. Unique Indus.*, 912 F.2d 663, 666 (3d Cir.1990), this Court dealt with a case in which the plaintiff sued the defendant for infringing its copyright on humorous nose masks designed to resemble the noses, snouts, and beaks of different animals. Although the issue of substantial similarity was not before the Court, we recognized that "copyrights protect only expressions of ideas and not ideas themselves," and explained:

By holding that Masquerade's nose masks are copyrightable, we do not intimate that it has the exclusive right to make nose masks representing pig, elephant and parrot noses. On remand, it will be Masquerade's burden to show that Unique's nose masks incorporate copies,

in the copyright law sense, of Masquerade's sculptures, rather than sculptures that derive their similarity to Masquerade's sculptures merely from the commonality of the animal subjects both represent.

Masquerade Novelty, 912 F.2d at 671-72.

Here, as in *Masquerade Novelty*, the protectible originality of the allegedly infringed work is to be found, if at all, solely in its appearance. Kay Berry claims that [Defendants] infringed its copyright not by using the same public domain poem, or inscribing a rock with text, but by copying the specific combination of elements it employed to give Sculpture No. 646 its unique look. Although the evidentiary burden upon it is high, for the reasons we have discussed, we conclude that Kay Berry is entitled to the opportunity to demonstrate that the Memory Stone is neither a unique creation, nor the unavoidable expression of a common idea, but rather an impermissible copy of Sculpture No. 646. We will therefore **reverse and remand** to the District Court.