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KAY BERRY, INC. V. TAYLOR GIFTS, INC.

421 F.3D 202 (3D CIR. 2005)

I. INTRODUCTION

In *Kay Berry v. Taylor Gifts*, the plaintiff, Kay Berry, Inc. (“Kay Berry”), sued the defendants, Taylor Gifts, Inc. (“Taylor”) and Bandwagon, Inc. (“Bandwagon”), claiming that the defendants infringed its registered copyright for rock sculptures inscribed with poems.¹ In granting summary judgment in favor of the defendants, the district court held that Kay Berry’s group copyright registration was invalid because the rock sculptures were not sufficiently related to one another.² Kay Berry appealed, arguing that its copyright registration was valid under the group registration provisions, or in the alternative, valid under the single work registration provisions.³ The appellate court reversed, holding that regardless of whether the sculptures were sufficiently related, they were included in a single unit of publication, and therefore could be registered under the single work registration provisions.⁴ The appellate court also held that Kay Berry’s rock sculpture contained a sufficient “quantum of creativity” to qualify for copyright protection.⁵ Accordingly, Kay Berry was entitled to show that the alleged infringing work was an impermissible copy.⁶

1. Kay Berry, Inc. v. Taylor Gifts, Inc., 421 F.3d 202 (3d Cir. 2005).

2. *Id.* at 203-04.

3. *Id.* at 204.

4. *Id.* at 206.

5. *Id.* at 207.

6. *Id.*

II. BACKGROUND

Kay Berry designed, manufactured, marketed, and sold “Garden Accent Rocks.”⁷ Garden Accent Rocks were decorative outdoor sculptures resembling rocks, which were inscribed with poems.⁸ Kay Berry applied for copyright registration for its entire line of Garden Accent Rocks on July 7, 1997.⁹ Kay Berry provided its Garden Accent Rock catalog as the required document specimen when registering its copyright with the Copyright Office.¹⁰ Along with identifying each sculpture by number, the catalogue contained a photograph and description of each individual work.¹¹ The Copyright Office issued Kay Berry a Copyright Registration Certificate for “sculptural works with design and text” with an effective date of July 1, 1997.¹²

One of Kay Berry’s best-selling Garden Accent Rocks was Sculpture No. 646, a rectangular shaped sculpture resembling a rock, with a verse inscribed on its face.¹³ The verse contained five lines, with each word inscribed in a right-leaning font and 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*¹⁴

In 2003, Bandwagon supplied Taylor, and Taylor began to market and sell, the “Memory Stone,” a sculpture that was similar to Kay Berry’s Sculpture No. 646.¹⁵ Like Kay Berry’s Sculpture No. 646, the Memory Stone was a rectangular sculpture

7. *Kay Berry, Inc.*, 421 F.3d at 202.

8. *Id.*

9. *Id.*

10. *Id.*

11. *Id.*

12. *Id.*

13. *Kay Berry, Inc.*, 421 F.3d at 202.

14. *Id.*

15. *Id.*

resembling a rock.¹⁶ The Memory Stone was inscribed with the same verse that was inscribed on Kay Berry's Sculpture No. 646.¹⁷ The Memory Stone's verse was laid out in the same five-line format, each word beginning with a capital letter, and the entire verse was set in a right-leaning font.¹⁸

Upon discovering the Memory Stone, Kay Berry sued Taylor and Bandwagon for copyright infringement and moved for a preliminary injunction prohibiting the defendants from selling the Memory Stone.¹⁹ On December 8, 2003, a United States magistrate judge issued a report and recommendation suggesting that the district court deny Kay Berry's motion for a preliminary injunction.²⁰ On February 23, 2004, the district court adopted the magistrate's report and recommendation without change.²¹

During Kay Berry's motion for a preliminary injunction, the defendants filed an amended motion for summary judgment on the infringement claim.²² On August 2, 2004, the magistrate judge issued a report and recommendation suggesting that the district court grant the defendants' motion.²³ The magistrate's report and recommendation concluded that: 1) Kay Berry did not have a valid registration over its multiple works because they were not sufficiently related; 2) Sculpture No. 646 contained no copyrightable subject matter; and 3) Sculpture No. 646 embodied an expression that was inseparable from an underlying idea.²⁴ On August 30, 2004, the district court adopted the magistrate judge's report and recommendation as its own opinion and granted summary judgment in favor of defendants.²⁵ Kay Berry appealed.²⁶

On appeal, the appellate court disagreed with the district court's decision and held that Kay Berry's copyright registration for

16. *Id.*

17. *Id.*

18. *Id.*

19. *Kay Berry, Inc.*, 421 F.3d at 202.

20. *Id.*

21. *Id.*

22. *Id.*

23. *Id.*

24. *Id.* at 203.

25. *Kay Berry, Inc.*, 421 F.3d at 202-03.

26. *Id.* at 203.

Sculpture No. 646 was in fact valid.²⁷ The appellate court held that Sculpture No. 646 was an individually recognizable element of a single work—the copyrighted catalog of sculptures—and was therefore entitled to the benefits of copyright registration.²⁸ The appellate court also held that selecting an inspirational poem from the public domain, adapting it to make it visually and rhythmically appealing, and casting it on its own sculptural work was sufficiently creative to qualify for copyright protection.²⁹ Finally, the appellate court held that Kay Berry’s rock sculpture did not embody an expression that was inseparable from an underlying idea.³⁰ Accordingly, the appellate court reversed and remanded the case holding that Kay Berry did in fact have a valid copyright registration and was therefore entitled to show that the defendants infringed its copyright.³¹

III. LEGAL ANALYSIS

A. Validity of Kay Berry’s Copyright Registration

The appellate court began its analysis by addressing the validity of Kay Berry’s copyright registration.³² Kay Berry argued that it properly registered Sculpture No. 646 under its Certificate of Registration, which covered Garden Accent Rocks described as “sculptural works with design and text.”³³ Along with the Certificate of Registration, Kay Berry deposited its Garden Accent Rocks catalog which featured pictures and descriptions of more than one hundred sculptures, including Sculpture No. 646.³⁴ Kay Berry argued that the registration covered Sculpture No. 646 along with all of the other works featured in the catalog.³⁵ The district

27. *Id.* at 206.

28. *Id.*

29. *Id.* at 207.

30. *Id.* at 209.

31. *Kay Berry, Inc.*, 421 F.3d at 209.

32. *Id.* at 203.

33. *Id.*

34. *Id.*

35. *Id.*

court held that the individual works in the catalog were not validly registered because they were not sufficiently “related” to each other to qualify for group registration as required by 17 U.S.C. § 408(c)(1).³⁶ In reversing the ruling, the appellate court held that the district court misapplied the governing copyright registration regulations when evaluating Kay Berry’s registration.³⁷ When reconsidering the validity of Kay Berry’s copyright registration, the appellate court applied the statutory provisions for both group and single work registration.³⁸

1. Group Registration

Kay Berry argued that its Garden Accent Rocks were properly registered as a group of related works pursuant to 17 U.S.C. § 408(c)(1).³⁹ The statute states in relevant part:

The Register of Copyrights is authorized to specify by regulation the administrative classes into which works are to be placed for purposes of deposit and registration, and the nature of the copies or phonorecords to be deposited in the various classes specified. The regulations may require or permit, for particular classes . . . a single registration for a group of related works.⁴⁰

Relying on *Behnam Jewelry Corp. v. Aron Basha Corp.*,⁴¹ Kay Berry argued that when Congress enacted § 408(c), it attempted to liberalize the copyright laws allowing a group of works to be registered together under a single registration, provided they were minimally connected.⁴² Kay Berry further argued that under this permissive standard, its sculptural works were sufficiently related

36. *Id.*

37. *Kay Berry, Inc.*, 421 F.3d at 203.

38. *Id.* at 203-06.

39. *Id.* at 203-04.

40. *Id.* at 204.

41. *Behnam Jewelry Corp. v. Aron Basha Corp.*, No. 97-Civ-3841, 1997 WL 639038 (S.D.N.Y. Oct. 15, 1997).

42. *Kay Berry, Inc.*, 421 F.3d at 204.

and therefore validly registered as a group of works under § 408(c).⁴³

Although the appellate court agreed that § 408(c) represented a liberalization of the copyright laws, it stated that Congress did not define the requirements of a valid copyright registration.⁴⁴ The appellate court found that the applicable subsection only stated that “[t]he regulations *may* require or permit, for particular classes . . . a single registration for a group of related works.”⁴⁵ The appellate court held that the statute’s language does not grant to all copyright applicants a general right to register a group of works under a single registration.⁴⁶ The appellate court concluded that “the plain language of § 408(c)(1) merely allows the Register of Copyrights to determine what types of works are eligible for group registration.”⁴⁷ The appellate court stated that this conclusion was “confirmed by the more stringent language of § 408(c)(2), which *mandates* the Register of Copyrights to establish regulations permitting group registration of works appearing in periodicals.”⁴⁸

The appellate court reasoned that the Register of Copyrights had exercised the authority delegated by § 408(c)(1) by promulgating rules that allowed group registration for “automated databases,” “related serials,” “daily newspapers,” “contributions to periodicals,” “daily newsletters,” and “published photographs.”⁴⁹ However, Kay Berry described its Garden Accent Rocks as “sculptural works.”⁵⁰ Since the Register of Copyrights did not promulgate rules that included a category for “sculptural works,” the appellate court concluded that Kay Berry’s registration was not valid under the group registration provisions.⁵¹

43. *Id.*

44. *Id.*

45. *Id.* (citing 17 U.S.C. § 408(c)(1)(2005)).

46. *Id.*

47. *Id.*

48. *Kay Berry, Inc.*, 421 F.3d at 204.

49. *Id.*

50. *Id.*

51. *Id.*

2. *Single Work Registration*

Kay Berry alternatively argued that its copyright registration was valid as a “Single Work” under 37 C.F.R. § 202.3(b)(3).⁵² This provision describes a single work - in the case of published works - as “all copyrightable elements that are otherwise recognizable as self-contained works, that are included in a single unit of publication, and in which the copyright claimant is the same.”⁵³ To illustrate, the appellate court referred to a typical board game where the board, the playing pieces, and the instructions are all individually entitled to copyright protection.⁵⁴ Since those elements are “packaged as a single unit (the game itself), it is appropriate to allow the copyright owner to register the entire game, and protect the individual elements through that single registration.”⁵⁵ Kay Berry claimed that its copyright registration covered its catalog deposit, and that Sculpture No. 646 is an individually recognizable element of that single work.⁵⁶

The appellate court stated that the “Single Work” registration is separate and distinct from “Group Registration.”⁵⁷ It explained that “the group registration provisions were enacted pursuant to 17 U.S.C. § 408(c)(1), and were based on Congress’s desire to liberalize the registration process.”⁵⁸ The appellate court stated that the single work registration provision, by contrast, was promulgated pursuant to the language of 17 U.S.C. § 408(a), which states that “the owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim”⁵⁹ This provision codified the already existing Copyright Office practice of allowing copyright owners to register multiple works published together as a single work for a single fee.⁶⁰ When this provision was established, the Copyright Office had reserved for

52. *Id.*

53. *Id.* (quoting 37 C.F.R. § 202.3(b)(3)(i)(A)(2005)).

54. *Kay Berry, Inc.*, 421 F.3d at 205.

55. *Id.*

56. *Id.*

57. *Id.*

58. *Id.*

59. *Id.*

60. *Kay Berry, Inc.*, 421 F.3d at 205.

implementation in a separate proceeding the possibility of providing for “a single registration for a group of ‘related works’ under § 408(c)(1).”⁶¹

The appellate court stated that “the single work registration regulation is distinct from the group registration regulation and has different qualifying requirements.”⁶² The court explained that the single work registration regulation was silent on whether the individual, self-contained elements of the “single work” be “related” in order to be registered.⁶³ Instead, “single work registration requires, in the case of published works, that all of the self-contained works be ‘included in a single unit of publication’ and share the same copyright claimant.”⁶⁴

Referring to *Benham Jewelry*, the appellate court stated that the district court confused the requirements of single work registration and group registration.⁶⁵ The district court had erroneously concluded that the single work regulation was promulgated pursuant to 17 U.S.C. § 408(c) rather than 408(a).⁶⁶ The district court also failed to recognize the distinct regulatory requirements for single work registration and group registration.⁶⁷ The appellate court pointed out that although *Benham Jewelry* quoted the single work registration regulation - including its requirement of a single unit of publication - the district court repeatedly mentioned and discussed the requirements for “single registration for multiple related works” or group registration.⁶⁸ The *Benham Jewelry* court “improperly melded the ‘single unit of publication’ requirement of single work registration and the ‘relatedness’ requirement of group registration.”⁶⁹ As a result, the *Benham Jewelry* court concluded that “the ‘single unit of publication’ requirement was superfluous

61. *Id.* (citing Registration of Claims to Copyright, 43 Fed. Reg. 965, 966 (Jan. 5, 1978) (codified at 37 C.F.R. pt. 202)).

62. *Id.*

63. *Id.*

64. *Id.*

65. *Id.*

66. *Kay Berry, Inc.*, 421 F.3d at 205.

67. *Id.*

68. *Id.*

69. *Id.* at 206.

where the works at issue were sufficiently related.”⁷⁰ The appellate court held this conclusion to be erroneous because “relatedness” is not a requirement for single work registration.⁷¹ Accordingly, the appellate court held that the single work registration regulation arises from a different statutory provision than group work registration and therefore it was improper for the *Benham Jewelry* court to ignore the single unit of publication requirement.⁷²

In addition, the appellate court referred to *Donald Bruce & Co. v. B.N. Multi Com Corp.*,⁷³ in which the court made a similar analytical error.⁷⁴ In *Donald Bruce*, the court stated that the group registration provision for “single registration for a group of related works” was at issue rather than the provision for a single work.⁷⁵ However, during its discussion of the relatedness requirement of group registration, the court in *Donald Bruce* considered whether including otherwise unrelated works in a “single unit of publication” might satisfy the relatedness requirement for group registration.⁷⁶ The *Donald Bruce* court stated that this meant items in a single unit of publication might serve as a proxy for relatedness and therefore “improperly meld the group registration and single work registration requirements.”⁷⁷

The appellate court concluded that both the *Benham Jewelry* and *Donald Bruce* courts failed to account for the fundamental distinction between single work registration under 37 C.F.R. § 202.3(b)(3) and group registration under 37 C.F.R. § 202.3(b)(4).⁷⁸ Accordingly, the appellate court concluded that although Kay Berry’s Garden Accent Rocks may not be sufficiently “related,” they were entitled to single work registration because they were included in a single unit of publication and the copyright

70. *Id.*

71. *Id.*

72. *Kay Berry, Inc.*, 421 F.3d at 206.

73. *Donald Bruce & Co. v. B.N. Multi Com Corp.*, 964 F. Supp. 265 (N.D. Ill. 1997).

74. *Kay Berry, Inc.*, 421 F.3d at 206.

75. *Id.*

76. *Id.*

77. *Id.*

78. *Id.*

claimant of the works was the same.⁷⁹

B. Sculpture No. 646 Was Entitled to Copyright Protection

The appellate court also reversed the district court's finding that Sculpture No. 646 lacked any protectable configuration or design.⁸⁰ The appellate court stated that 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.⁸¹ It explained that it was irrelevant that these elements may not be individually entitled to protection.⁸² The court referred to elemental raw materials like colors, letters, descriptive facts, and earlier works of art that, due to the passage of time, are no longer copyright protected.⁸³ The court explained that 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."⁸⁴ The court concluded that selecting an inspirational poem from the public domain, adapting that poem to make it visually and rhythmically appealing, and then casting it on its own sculptural work, was a sufficient quantum of creativity to qualify for copyright protection.⁸⁵

C. Kay Berry's Copyright Registration Did Not Extend to an Idea

The appellate court next turned to the second part of the infringement inquiry, whether the defendants improperly copied Sculpture No. 646 and whether the expression Kay Berry sought to protect had merged with an unprotectable idea.⁸⁶ The court explained that "copying refers to the act of infringing any of the exclusive rights that accrue to the owner of a valid copyright as set

79. *Id.*

80. *Kay Berry, Inc.*, 421 F.3d at 207.

81. *Id.*

82. *Id.* (citing *Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127 (2d Cir. 2003)).

83. *Id.*

84. *Id.*

85. *Kay Berry, Inc.*, 421 F.3d at 207.

86. *Id.*

forth at 17 U.S.C. § 106.”⁸⁷ These rights included “the right to distribute and reproduce copyrighted material.”⁸⁸ The appellate court explained that two elements must be shown to prove infringement: 1) the defendant had access to the copyrighted work; and 2) the original and allegedly infringing work shared substantial similarities.⁸⁹

The appellate court explained that “substantial similarity,” in turn, is further broken down into two considerations: 1) whether the defendant copied from the plaintiff’s work; and 2) whether the copying, if proven, went so far as to constitute an improper appropriation.⁹⁰ A showing of substantial similarity, “coupled with evidence that the infringing author had access to the original work, permits a fact-finder to infer that the infringing work is not itself original, but instead an impermissible copy of the original.”⁹¹

The appellate court explained that a fundamental premise of copyright law allows an author to protect only the expression of an idea, but not the idea itself.⁹² Thus, “an author may base his work on the same inspiration as that of an earlier work, but he may not ‘copy the copy.’”⁹³ 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.”⁹⁴ “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.”⁹⁵ The appellate court

87. *Id.*

88. *Id.* (citing *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277 (3d Cir. 1991)).

89. *Id.*

90. *Id.* at 208 (citing *Atari, Inc. v. North American Philips Consumer Elecs. Corp.*, 672 F.2d 607 (7th Cir. 1982)).

91. *Kay Berry, Inc.*, 421 F.3d 208.

92. *Id.*

93. *Id.*

94. *Id.*

95. *Id.*

further stated that in some instances, there might come a point when an author's expression becomes indistinguishable from the idea he seeks to convey, thus merging the two.⁹⁶ "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."⁹⁷

However, the appellate court held that in the present case the protectable originality of the allegedly infringed work was to be found, if at all, solely in its appearance.⁹⁸ Kay Berry claimed that the 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.⁹⁹ The appellate court held that although there was a high evidentiary burden upon Kay Berry, it was in fact entitled to the opportunity to demonstrate that the Memory Stone was neither a unique creation nor the unavoidable expression of a common idea, but rather an impermissible copy.¹⁰⁰

IV. CONCLUSION

The appellate court reversed the district court's finding and stated that, regardless of whether Kay Berry's sculptures were sufficiently related; they were included in a single unit of publication.¹⁰¹ Therefore, the sculptures could be registered under the single work registration regulation.¹⁰² Furthermore, the appellate court concluded that Kay Berry's sculpture was in fact entitled to copyright protection because it was not an avoidable expression of an idea.¹⁰³ Accordingly, the appellate court remanded the case to allow Kay Berry to prove that the defendants impermissibly copied its sculpture.¹⁰⁴

96. *Id.* at 209.

97. *Kay Berry, Inc.*, 421 F.3d at 209.

98. *Id.*

99. *Id.*

100. *Id.*

101. *Id.* at 205

102. *Id.*

103. *Kay Berry, Inc.*, 421 F.3d at 207.

104. *Id.*