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GODINGER SILVER ART CO., LTD., Plaintiff, - against - INTERNATIONAL SILVER COMPANY, Defendant.

95 Civ. 9199 (LMM)

UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK

1995 U.S. Dist. LEXIS 17696; 37 U.S.P.Q.2D (BNA) 1453

November 22, 1995, Dated
November 28, 1995, FILED

CASE SUMMARY:

PROCEDURAL POSTURE: Plaintiff, a manufacturer of a line of silver-plated tableware, sought a preliminary injunction against defendant, a manufacturer of a competing line of silver-plated tableware, to enjoin the making and selling of a product infringing its copyrighted baroque pattern.

OVERVIEW: In seeking a preliminary injunction against defendant, plaintiff, a manufacturer of a line of silver-plated tableware established a prima facie case of copyright infringement against defendant by demonstrating its registration, defendant's access to plaintiff's line, and substantial similarity between their two baroque patterns. Defendant argued that the substantial similarity in their appearances arose from plaintiff's adapting defendant's baroque sterling pattern which was in the public domain, and that the remaining portion of the design which wasn't adapted contained so little material that it was not protectable under the Copyright Act. The court rejected this argument, and found that there were original elements in plaintiff's design, and they were protectable. Because irreparable injury was presumed upon plaintiff's establishment of a prima facie copyright case, the court granted the preliminary injunction.

OUTCOME: The court granted the preliminary injunction, holding that though the variations on a baroque design were small, they were entitled to protection, and

irreparable injury was presumed upon the showing of a prima facie copyright case.

CORE TERMS: variation, originality, preliminary injunction, copying, baroque, tableware, public domain, similarity, style, hire, temporary restraining order, infringement, declaration, distinguishable, prerequisite, ownership, flatware, trivial, handle, modest, medium, silverplated, manufacture, marketing, Copyright Act, causes of action, prima facie case, joint authorship, incorporating, registration

LexisNexis(R) Headnotes

Copyright Law > Civil Infringement Actions > Burdens of Proof

Copyright Law > Civil Infringement Actions > Presumptions & Requirements > Presumption of Copyright Validity

Copyright Law > Formalities > General Overview

[HN1] In order to prove infringement, a plaintiff must show ownership of a valid copyright and copying by the defendant. A plaintiff's ownership and the validity of its copyrights in its design are evidenced, prima facie, by its registrations, and a plaintiff may prove copying by showing access and substantial similarity of the two works.

Copyright Law > Ownership Interests > General Overview

Copyright Law > Restoration From Public Domain > Duration

Copyright Law > Restoration From Public Domain > Ownership

[HN2] Originality is distinguished from novelty; there must be independent creation, but it need not be invention in the sense of striking uniqueness, ingeniousness, or novelty, since the United States Constitution differentiates authors and their writings from inventors and their discoveries. Originality means that the work owes its creation to the author and this in turn means that the work must not consist of actual copying. The test of originality is that the author contributed something more than a merely trivial variation, something recognizably his own. While a copy of something in the public domain will not, if it be merely a copy, support a copyright, a distinguishable variation will.

Copyright Law > Subject Matter > Statutory Copyright & Fixation > Originality Requirements > General Overview

[HN3] The requirement of substantial, as opposed to trivial, variation and the prohibition of mechanical copying, both of which are inherent in and subsumed by the concept of originality, apply to both reproductions of works of art and to works of art. There is implicit in that concept a minimal element of creativity over and above the requirement of independent effort. The quantum of originality that is required may be modest indeed.

Copyright Law > Subject Matter > Statutory Copyright & Fixation > Originality Requirements > General Overview

[HN4] Small or modest though the variations may be upon a general style, those designs that are registered are subject to protection.

Copyright Law > Civil Infringement Actions > Standing > Copyright Act of 1976

Copyright Law > Conveyances > General Overview

[HN5] An assignment, including the right to sue for past, present, and future infringements thereof, even though subsequent to the commencement of an action, is a sufficient basis for the continued maintenance of plaintiff's claim.

Civil Procedure > Remedies > Injunctions > Preliminary & Temporary Injunctions

Copyright Law > Civil Infringement Actions > Remedies > Injunctive Relief

[HN6] In a copyright action the existence of irreparable injury is presumed upon a showing of a prima facie case of copyright infringement.

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JUDGES: LAWRENCE M. McKENNA, U.S.D.J.

OPINION BY: LAWRENCE M. McKENNA

OPINION:

MEMORANDUM AND ORDER

McKENNA, D.J.

1.

Plaintiff manufactures and sells a line of silver-plated tableware under the name "20th Century Baroque." Defendant manufactures and sells a line of silver-plated tableware under the name "Grande Antique." Plaintiff, asserting defendant's infringement of plaintiff's registered copyrights in the design of the "20th Century Antique" line, seeks a preliminary injunction. n1

n1 On October 27, 1995, the Court, after hearing both sides, granted a temporary restraining order pending an evidentiary hearing on the motion for a preliminary injunction, which hearing was held on November 3, 1995. At the conclusion of the hearing, the Court extended the temporary restraining order pending decision of the motion for a preliminary injunction.

2.

Plaintiff has certainly made a prima facie case of infringement. "In [HN1] order to prove infringement a plaintiff must show ownership of a valid copyright [*2] and copying by the defendant." Novelty Textile Mills, Inc. v. Joan Fabrics Corp., 558 F.2d 1090, 1092 (2d Cir. 1977) (citation omitted). Plaintiff's ownership of, and the validity of its copyrights in, the "20th Century Baroque" design are evidenced, prima facie, by its registrations. 17 U.S.C. § 410. See also Novelty Textile, 558 F.2d at 1092. And "a plaintiff may prove copying by showing access and 'substantial similarity' of the two works." *Id.* (citations omitted). Comparison of the works shows very substantial similarity, and there can be no doubt that defendant had access to plaintiff's line, on the market since 1992. n2

n2 The designs of "20th Century Baroque" and "Grande Antique," as well as of "Grande Baroque," discussed below, appear most conveniently for comparison in Plaintiff's Exhibit G.

3.

Defendant argues, however, that plaintiff's "20th Century Baroque" is based upon the public domain "Grand Baroque" design of Wallace International Silver-smiths, Inc. ("Wallace") (a company [*3] under common ownership with defendant) n3 and that "20th Century Baroque" does not contain sufficient original matter not taken from "Grande Baroque" to be protectible under the Copyright Act. See generally L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486 (2d Cir.), cert. denied, 429 U.S. 857, 50 L. Ed. 2d 135, 97 S. Ct. 156 (1976).

n3 See Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co., Inc., 735 F. Supp. 141 (S.D.N.Y.), aff'd, 916 F.2d 76 (2d Cir. 1990), cert. denied, 499 U.S. 976, 113 L. Ed. 2d 720, 111 S. Ct. 1622 (1991), where Wallace was denied an injunction against the sale of "20th Century Baroque" sought on the basis that the "Grand Baroque" design was protected as trade dress under 15 U.S.C. 1125(a).

That there are both similarities and differences between "20th Century Baroque" and "Grande Baroque" is clear upon examination. In Wallace (see n.3 supra), the Court of Appeals identified some of them:

Like Wallace's silverware, Godinger's pattern contains [*4] typical baroque elements including an indented root, scrolls, curls, and flowers. The arrangement of these elements approximates Wallace's design in many ways, although their dimensions are noticeably different. The most obvious difference between the two designs is that the Godinger pattern extends further down the handle than the Wallace pattern does. The Wallace pattern also tapers from the top of the handle to the stem while the Godinger pattern appears bulkier overall and maintains its bulk throughout the decorated portion of the handle.

916 F.2d at 77. This Court adds that the carved design inside the uppermost curves of "Grand Baroque" appears to be quite different from what appears in the parallel portion of "20th Century Baroque" and that the top of the design that appears immediately above the blade of the knife is circular in "20th Century Baroque" and not so in "Grande Baroque." n4 The issue is whether the differences -- whether mentioned above or not -- are copy-rightable.

n4 Comparison of the elements appearing in "20th Century Baroque" with those of "Grande Antique," however, tends to confirm a finding of copying by defendant.

[*5]

The cases most frequently cited on this issue are, no doubt, Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951), and Batlin. This Court does not read those cases as articulating different standards, n5 as the frequent citation of Catalda in Batlin seems to make clear. In Batlin, the Court of Appeals pointed out the constitutional and statutory originality prerequisite to copyright protection, 536 F.2d at 489-90, n6 and then considered the meaning of that prerequisite.

[HN2] Originality is, however, distinguished from novelty; there must be independent creation, but it need not be invention in the sense of striking uniqueness, ingeniousness, or novelty, since the Constitution differentiates "authors" and their "writings" from "inventors" and their "discoveries." Originality means that the work owes its creation to the author and this in turn means that the work must not consist of actual copying.

The test of originality is concededly one with a low threshold in that "all that is needed . . . is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'" But as this court said many years [*6] ago, " while a copy of something in the public domain will not, if it be merely a copy, support a copyright, a distinguishable variation will. . . ."

536 F.2d at 490 (quoting Catalda, 191 F.2d at 103, and Gerlach-Barklow Co. v. Morris & Bendien, Inc., 23 F.2d 159, 161 (2d Cir. 1927) (other citations omitted)). The Court then found that the originality prerequisite applied

to reproductions of works of art as well as to works of art:

[HN3] The requirement of substantial as opposed to trivial variation and the prohibition of mechanical copying, both of which are inherent in and subsumed by the concept of originality, apply to both statutory categories. There is implicit in that concept a "minimal element of creativity over and above the requirement of independent effort." While the quantum of originality that is required may be modest indeed, we are not inclined to abandon that requirement, even if in the light of the constitutional and statutory bases therefor and our precedents we could do so.

536 F.2d at 490 (quoting 1 M. Nimmer, *The Law of Copyright*, § 10.2, at 32 (1975) (other citation omitted)).

n5 Pace Judge Posner in Gracen v. Bradford Exchange, 698 F.2d 300, 305 (7th Cir. 1983). This Court, does not, however, necessarily include in the applicable standard Judge Frank's dictum in *Catalda* that: "A copyist's bad eyesight or defective musculature, or a shock caused by a clap of thunder, may yield sufficiently distinguishable variations. Having hit upon such a variation unintentionally, the 'author' may adopt it as his and copyright it." 191 F.2d at 105.

[*7]

n6 *Batlin* was decided under the 1909 Copyright Act. Here, neither side has suggested that, as to the originality requirement, there is any material distinction between the 1909 and 1976 Acts.

The originality requirement, of course, has to be applied to a specific work, or, in a case such as this -- involving a work incorporating elements of a pre-existing work -- to a comparison of two specific works. See Eden Toys, Inc. v. Florelee Undergarment Co., 697 F.2d 27, 35 (2d Cir. 1982) ("the factual question here depends entirely on visual comparison of exhibits"). So too, the facts of the relevant precedents must be examined closely. See Durham Indus., Inc. v. Tomy Corp., 630 F.2d 905, 917 (2d Cir. 1980); see also Kuddle Toy, Inc. v. Pussycat-Toy Co., 183 U.S.P.Q. 642 (E.D.N.Y. 1974), where Judge Dooling considered *Catalda* as "subdued to its facts." Id. at 658.

Looking at the works in question here, "Grande Baroque" and "20th Century Baroque," and at the facts revealed in the case law, this Court adheres to the conclusion reached by it in granting the temporary restraining [*8] order, that there are elements in "20th Century Baroque" not found in "Grande Baroque" of sufficient originality under the *Catalda/Batlin* standard to support copyright in those elements. n7

n7 It is axiomatic, of course, that such copyright inheres only in such original elements, and not in what is only taken from the public domain "Grande Baroque."

This case must, of course, be seen against its background of "baroque" tableware, marketed by the parties and others, and having generally similar features, discussed in Judge Haight's and Judge Winter's opinions in *Wallace* (see n.3, supra). In addition to those general similarities, however, there are differences in "baroque" tableware designs. Given the general style -- incorporating "typical baroque elements," Wallace, 916 F.2d at 77, -- one could not expect the differences within that style to be so major as to change the style itself. But that hardly means that there cannot be original elements of designs within the style sufficient to support [*9] a copyright, even if those original elements are modest and draw on common themes. Otherwise, no "baroque" tableware would be capable of copyright protection, a position neither party espouses and that would, in this Court's view, be incorrect if either did.

Here, visual comparison of the "20th Century Baroque" design with that of "Grande Baroque" indicates that the elements of the former not taken from the latter are not merely trivial, but substantial, or distinguishable, variations. Batlin, 536 F.2d at 490. [HN4] Small or modest though the variations may be, they are subject to protection. Looking at the variations in this case, they appear considerably more akin to the small variations between the Ivor Wood and Eden/Gibson sketches considered in Eden Toys, 697 F.2d at 34-35 (cf. Figures 2 and 3, id. at 31, 32) ("variations . . . too minor to entitle the Eden/Gibson work to claim a different aesthetic appeal . . . still original and substantial enough to deserve independent copyright protection" (id. at 34-35)), than to the variations in *Batlin* -- essentially a proportional reduction of height from approximately eleven to approximately nine inches in height, [*10] without "elements of difference that amounted to significant alteration or that had any purpose other than the functional one of making a more suitable (and probably less expensive) figure in the plastic medium." 536 F.2d at 489.

Batlin was, in essence, a case of the transfer of a work to another medium, but without the "level of input" found in Alva Studios, Inc. v. Winninger, 177 F. Supp. 265, 267 (S.D.N.Y. 1959). See Batlin, 536 F.2d at 489. And in Catalda, there was evidence that the mezzotints "were not intended to, and did not, imitate the paintings they reproduced." 191 F.2d at 104-05. Despite suggestions to the contrary by defendant, it is clear in the present case that defendant's "Grand Antique" is not merely a translation of the sterling "Grande Baroque" into a silver plate version, with only such variations as different processes of manufacture in silver and in plate might entail: comparison of "Grande Antique" with "Grande Baroque" makes that clear, and defendant has not come forward with evidence that such a mere translation is what happened here. Nor does the fact that defendant could have copied "Grand Baroque" mean that it was entitled to copy "20th [*11] Century Baroque," even if the latter incorporates elements of the public domain "Grande Baroque" design.

4.

Defendant also argues that plaintiff is not the author of the "20th Century Baroque" design. n8 The works embodying the "20th Century Baroque" design were registered by plaintiff as works made for hire. Defendant, citing Community for Creative Non-Violence v. Reid, 490 U.S. 730, 104 L. Ed. 2d 811, 109 S. Ct. 2166 (1989), and Aymes v. Bonelli, 980 F.2d 857 (2d Cir. 1992), and plaintiff's description of the facts surrounding the creation of the "20th Century Baroque" design (see Declaration of Plaintiff's Merchandising Vice President, Al Schneider, Nov. 2, 1995, PP 2-7, adopted as accurate by plaintiff's President, Arnold Godinger, in his Declaration, Nov. 2, 1995, P 2; see also testimony on cross-examination of Mr. Godinger at preliminary injunction hearing, Nov. 3, 1995, and Def. Ex. 1 [Hong Kong Certificate of Registration of Design of "a cutlery set comprising knife, short fork, long fork, short spoon and long spoon" to Beakie Lee & Co Limited ("Beakie") n9]), argues that the works in question cannot meet the test for determining that a work was made [*12] for hire.

n8 This argument was first put forward on the motion for a preliminary injunction, and was not considered on the application for a temporary restraining order.

n9 Beakie appears to be an exclusive representative of plaintiff. (Transcript, Nov. 3, 1993, at 20.)

Plaintiff disagrees with defendant's analysis of the facts relating to the question whether the "20th Century Baroque" design was made for hire, and argues that, if it was not, it is a work of joint authorship, n10 on the ground that Mr. Godinger and Mr. Schneider of plaintiff, in addition to Mr. Cheung (or Chung) of Chi-Tat Metal Cum Plastic Ind. Ltd. (referred to in some of the declarations and at the preliminary injunction hearing as "Chi-Tat Co.") ("Chi-Tat"), personally participated in the actual fixation of the "20th Century Baroque" design in its "tangible medium of expression," 17 U.S.C. § 102. (See Schneider Declaration, Nov. 2, 1995, P 4 ["changes which we wrote directly on the plaster," and "changes on the second models"]; [*13] see also Transcript, Nov. 3, 1995 [testimony of Mr. Godinger], at 18 ["our rough drawing, what we had done by hand"], 19 ["we designed it and we started the design here in New York, took it to China and put it down and worked with the manufacturer"].)

n10 Plaintiff cites, in this connection, Andrien v. Southern Ocean County Chamber of Commerce, 927 F.2d 132, 136 (3d Cir. 1991).

The record at this time and as a whole is not very well developed for purposes of decision of the authorship issues raised by the parties. It is not necessary to decide them for purposes of deciding this motion, however, for the reasons that follow.

On November 6, 1995, Chi-Tat n11 assigned to plaintiff "whatever right, title or interest [it] may have in the flatware design known as 20th Century Baroque, [HN5] including the right to sue for past, present and future infringements thereof." This assignment, even though subsequent to the commencement of this action, is a sufficient basis for the continued maintenance of plaintiff's [*14] claim. See Infodek, Inc. v. Meredith-Webb Printing Co., 830 F. Supp. 614, 619-21 (N.D. Ga. 1993); see also ABKCO Music, Inc. v. Harrisongs Music, Ltd., 944 F.2d 971, 980 (2d Cir. 1991) ("a copyright owner can assign its copyright but, if the accrued causes of action are not expressly included in the assignment, the assignee will not be able to prosecute them, implying that if, as here, accrued causes of action are expressly included in the assignment, then the assignee can prosecute them).

N11 Defendant claims that plaintiff's president "testified that the design originated with either Chi-Tat . . . or Beakie. . . ." (Def. Supp. Brief at 1.) There is no evidence, other than the above-mentioned Hong Kong Certificate of Registration

of Design, as to what role, if any Beakie played in designing "20th Century Baroque," and it is not clear what, if anything, that Registration means as to the authorship or ownership of the design. On the evidence so far brought to the Court's attention, Beakie is not a candidate for sole or joint authorship of the "20th Century Baroque" design. Nor has defendant submitted law showing that Beakie is the exclusive proprietor of copyright in that design.

[*15]

Finally, assuming plaintiff was in error in registering the "20th Century Baroque" line as works made for hire (a question the Court does not decide), that would not, on the evidence before the Court, invalidate plaintiff's copyrights. There has been no showing of "intentional or purposeful concealment of relevant information." Original Appalachian Artworks, Inc. v. Toy Loft, Inc., 684 F.2d 821, 828 (11th Cir. 1982).

5.

Plaintiff has shown both a likelihood of success on the merits and irreparable harm in the absence of a preliminary injunction. "In [HN6] a copyright action the existence of irreparable injury is presumed upon a showing of a prima facie case of copyright infringement." Video Trip Corp. v. Lightning Video, Inc., 866 F.2d 50, 51-52 (2d Cir. 1989). The Court does not concur with defendant's suggestion that the harm to plaintiff is so small in comparison to the harm that a preliminary in-

junction will work on defendant that equity should deny the injunction.

6.

Defendant, its officers, agents, servants, employees, and attorneys, and those persons in active concert or participation with them who receive actual notice of this order by personal service or [*16] otherwise, are enjoined, pending determination of this action, from making, using, selling, marketing, advertising, promoting, offering for sale, shipping, accepting orders for, importing, exporting or otherwise doing business with respect to, the silverplated flatware which defendant has been marketing under the name Grande Antique, or other silverplated products bearing the same design or pattern as the silverplated flatware which defendant has been marketing under the name Grande Antique.

The security heretofore furnished by plaintiff in the sum of \$ 250,000 shall remain as security pursuant to Fed. R. Civ. P. 65(c) in connection with this preliminary injunction.

SO ORDERED.

Dated: New York, New York

November 22, 1995

LAWRENCE M. McKENNA

U.S.D.J.