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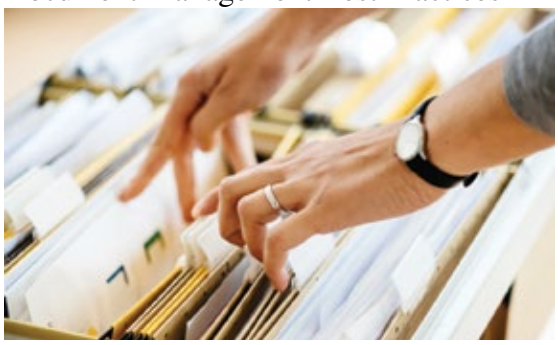

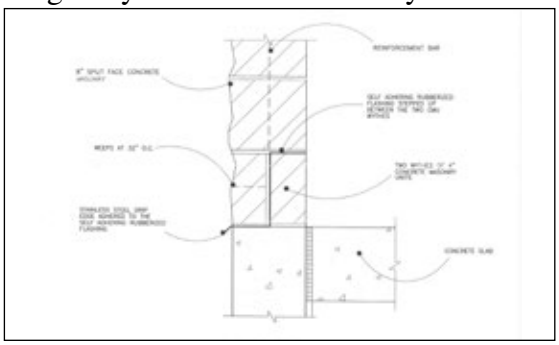

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Keeping Your Copyright: Recent Trends and Strategies

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1. INTRODUCTION

Before 1990, architects had relatively little protection for their design ideas, so the Architectural Works Copyright Protection Act (AWCPA) was intended as a significant step forward in the protection of original design work from unauthorized copying. However, despite its alignment with copyright protection established in Europe by the Berne Convention, the Act had a number of shortcomings in both its coverage and definitions that were highlighted in subsequent years following its creation that, according to some, reduced its intended effectiveness (1).

One of the major negative consequences of the AWCPA which was unforeseen both during its drafting and in the years immediately following its enactment is now apparent and has had significant repercussions in the homebuilding sector of the construction industry. This is perhaps not an area that is a primary focus for many architects, but the increase in legal action in the copyright realm has affected a number of designers across the country. For some years after the consequences of the Act became apparent, courts appeared reticent to stop ongoing legal cases and were cautious in their judgments on the issue of substantial similarity of contested models and the alleged originality of copyrighted ideas.

However, several recent rulings provide some indication that the courts are beginning to focus their attention more critically on architectural copyright infringement cases, and be more assertive in their assessment of issues such as 'originality', 'creativity' and 'substantial similarity'. This article examines the background of the AWCPA, explores its largely unforeseen consequences, and reviews several recent legal decisions that indicate a shift in attitude and a clearer approach towards the determination of substantial similarity in design. It concludes with providing some recommendations to practicing architects for effectively protecting their copyrightable work and suggesting strategies to protect them from unfair allegations of copyright violation.

2. THE DEVELOPMENT OF COPYRIGHT PROTECTION

Before 1990, architects had limited copyright protection under the prevailing 1976 Copyright Act beyond the coverage of their actual drawings. As "instruments of

service", architects' designs were regarded more of a product than a service, and the original ideas that created them were therefore vulnerable to misappropriation.

In order to conform to the 1968 Berne Convention, the United States developed the Architectural Works Copyright Protection Act (AWCPA) which came into law in 1990. Interestingly, the Act was not ultimately supported by the American Institute of Architects, which expressed some well-founded concerns about the proposed Act's impact on originality and contextualism within the built environment. While the AIA initially supported expanded copyright protection, a number of prominent architects were concerned that copyright protection might affect their ability to use elements from other architects' work, a longstanding tradition in the profession, where contextualism and 'fitting in' to an existing design vocabulary were considered acceptable.

"Our concern is that the well-accepted traditions of reference and limited borrowing of elements and details should be suppressed (United States Congress, 1990b)

However, their concerns were not heeded. Subsequent to the enactment of the AWCPA, studies of its effectiveness revealed a number of shortcomings, including a lack of clarity regarding ownership of original ideas, a wide range of interpretation in the apportionment of damages, and an inconclusive definition of 'building' covering habitable and non-habitable buildings like churches and gazebos, but

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excluding significant structures such as garages, bridges and silos (2).

However, despite these shortcomings, the Act did provide additional copyright protection for architects, and has been instrumental in the successful resolution of a number of cases, usually at a larger scale of construction than single family homes, such as condominiums or hotels (3).

3. UNINTENDED CONSEQUENCES

A less welcome outcome of the AWCPA, not predicted during its formation, has occurred primarily in the housing sector. In the past few years, countless designs of single-family homes have been registered with the United States Copyright Office. Once granted protection, these designs can be systematically compared to the designs of other homebuilders and, if the copyright owner believes they are 'substantially similar', legal action can (and has been) initiated.

Given the limited cost of a market rate single family home, it is inevitably limited in size, program (i.e. the number and type of rooms and spaces), layout and appearance, and also heavily influenced by market and consumer demand. It is hardly surprising then that the number of similarities can be considered quite high – and the consequent number of lawsuits numerous.

4. THE COURTS' RESPONSE

While some cases were resolved appropriately after careful deliberation of the substantial similarities between contested buildings, they were typically large, complex multi-unit structures with multiple design components and usually designed by licensed architects. In such situations, substantial similarity of protected elements is easier to prove or disprove. However, cases addressing design similarity between simpler, single family homes posed challenges for the judiciary which initially handled them tentatively given the subjective, loosely defined concepts such as originality, creativity and substantial similarity.

Certainly, in the assessment of pleadings to determine if there was a genuine need for trial, courts often appeared, from an expert witness's perspective, reluctant to issue summary judgment (4), deferring the judgment call on these matters to 'the ordinary reasonable person' and allowing many cases to go forward to trial. This strengthened the resolve of plaintiffs, who calculated that settlement was a less costly option for defendants and their insurers than a long, costly trial, and increased the number of complaints accordingly.

Paradoxically, while most courts found that copyright protection afforded by the AWCPA was limited, or 'thin', the degree of originality necessary to successfully claim copyright protection was really minimal, and rarely successfully challenged. A review of copyrighted homes registered in the United States Copyright Office, all of which are claimed to be original creations that are 'completely new' and not based upon previous designs (5), reveals that many of the houses are based upon pre-existing, traditional design solutions. Such solutions have been used throughout the country for many years, but have rarely been challenged either upon, or subsequent to, registration.

Finally, the question of design comparability and how to fairly determine substantial similarity raised challenging questions. Given the non-quantifiable definitions of the Act, courts were focused on the broad, 'look and feel' of designs, and had to wrestle with comparing vague, subjective elements such as 'character' and the 'flow of space' or 'overall concept and feel'. These are terms that may have meaning in the architectural profession, but do not provide lawyers and judges with much guidance in setting quantifiable standards. They are also conveniently non-specific terms for the plaintiffs to invoke to demonstrate a general similarity of compared designs without having to provide specific, quantifiable details of copying.

In consequence, the first 25 years of the AWCPA saw a great deal of unnecessary litigation particularly in the housing sector, some of which rebounded onto the architectural profession. The result was a significant amount of financial settlement by parties who, it could be argued, were never culpable of design copying but were forced to settle to prevent further nuisance and cost.

5. RECENT DEVELOPMENTS

In the past several years, there have been a few copyright cases, all in the Midwest and all concerning single family

homes, which indicate an interesting shift in the judicial approach to copyright infringement cases (6). All three cases discussed here (where the author acted as expert witness) follow a similar pattern to dozens of comparable cases across the United States. The plaintiff (not an architectural practice in this case), having registered multiple home designs with United States Copyright Office, reviewed the housing models of scores, if not hundreds, of homebuilders in search of actionable infringement of their intellectual property. Those targeted homebuilders were not necessarily direct competitors, and were often situated in other states, many hundreds of miles away from the Plaintiff's home base. If the copyright holders detected some similarity to any of their registered models in appearance and layout, they sued for copyright infringement. These are three of the 150 cases instigated by just one plaintiff in the past few years (7), which represents one in every 300 builders in the United States.

These recent cases indicate some important changes in attitude and actions concerning copyright protection (8). While it is still premature to establish these as firm principles, there do appear to be three important clarifications and shifts which, from an expert witness's perspective, strengthen the hand of defense counsels in combatting copyright infringement claims and give greater clarity on protection to the architectural profession.

A. A Closer Look

In contrast to the previous reluctance to making firm judgments on similarity, choosing instead to pass the responsibility on to the jury of 'ordinary persons', the judge in Heller affirmed her intention of 'going deep', confirming the previous opinions in Kerstiens and Lexington and taking 'a closer look' at the contested designs (6).

This contention that, at a small scale, differences however seemingly minor are relevant, indicates a willingness to take a detailed look at designs differences, reaffirming the thinking in several other cases and shows a willingness to act emphatically on clear evidence on a lack of substantial similarity. This willingness to look carefully at the evidence led to summary judgment on behalf of the defendant in all three cases.

B. Differences Rather Than Similarities

In addition to confirming that access is not proven simply by alleged substantial similarity (9) – a retreat from the universal, automatic access inferred by the Internet in prior times – the cases show a shift in attitude towards looking at differences, as opposed to similarities, which moves the assessment of substantial similarity from the vague, 'look and feel' to more specific, quantifiable and demonstrable differences of protectable elements:

"Accordingly, this Court views Lexington as requiring the Court to focus on the differences between the plans rather than the similarities. Where sufficient differences exist, the existence of superficial similarity cannot demonstrate a copyright violation" (see Footnote 6: Heller).

This reverses the approach stated in previous cases which involved buildings that were larger, more complex, custom built and had substantial budgets, a far cry from the modestly priced, minimally scaled designs of the market price home building industry. The three new cases focus more directly on simple housing models that are, by definition, largely composed of pre-existing, traditional elements to develop more specific views on substantial similarity.

C. An Analytic Tool

The judges in all three cases expressed a preference for objective, quantifiable data rather than vague, subjective claims of similarity, and relied on 'analytic tools' to inform their decision making. In each case, their opinions enumerated specific differences between the contested plans and, in two cases, relied exclusively on the defendants' expert witness reports, which painstakingly detail the differences between the models, demonstrated that in shape, program, layout, square footage, dimensions, materials and details, there were multiple differences that denied the claims of substantial similarity. The sheer number of quantifiable difference within the various categories, regardless of size, often led to 50 pages of data and provided the judges with visible, objective evidence which collectively demonstrated the lack of substantial similarity.

6. SUMMARY

Despite the best intentions of the AWCPA, it contains a number of shortcomings that became apparent after its implementation, although perhaps none as unintended or consequential as its impact upon the homebuilding sector.

Loopholes and laxities in the copyright registration process have led to countless law suits and settlements in favor of design trolls, who have cynically used the registration of their traditional, generic design solutions to profit from attacks on owners of similar traditional design without comparable copyright protection.

In the past, the courts have provided little relief for the accused homebuilders, who in many instances, settled with plaintiffs to avoid costly and time-consuming legal battles. But the three recently decided cases in the Midwest indicate more decisive court action on providing summary judgment, closely reviewing the details of the contested designs, focusing upon specific differences rather than general similarities and taking a quantifiable, objective approach in assessing substantial similarity through the use of 'analytic tools'. This more rigorous approach shows a clearer understanding of the concept of substantial similarity and a hardening of attitudes towards claims of originality for designs based upon traditional, pre-existing elements.

This new approach will better serve an original goal of copyright protection – to preserve ownership of design originality for the architectural profession, while enabling the open use of pre-existing design elements in circumstances where contextualism and 'fitting in' are appropriate design strategies.

To that end, this article concludes with four suggestions for architects to ensure their own copyright protection while maintaining an effective defense against unfair claims of copyright violation against their work:

1. Regularly and routinely file for copyright protection of all new work. It is fast and inexpensive.

2. Keep ALL design development drawings and files for every design (including images of models), no matter how modest. They provide invaluable evidence of design originality if they show a progression of ideas, even if the final product closely resembles the work of another architect.

3. If accused in writing, contact your insurance agent right away. It is required by the policy.

4. Before you talk to your attorneys, assemble and order all relevant background materials. This will save time – and money – during the preliminary discussions. Documentation should include:
   a. All files
   b. All drawings, images etc. as described above
   c. A timeline of all relevant dates in chronological order
   d. If you have access to the plaintiff's designs, carefully compare them to your own contested work and tabulate the differences. Review the designs in the following categories:

      Shape – the building profile, rooflines and overall mass of the buildings
      Program – compare the number and use of rooms and spaces
      Layout – identify any differences in spatial relationships
      Square footage – compare the overall footprint of the two models
      Dimensions – list all the different room dimensions of walls and ceiling heights
      Materials – compare exterior building materials
      Details – compare windows, doors, eaves, porches etc.

FOOTNOTES

1. For example: Michael E. Scholl, 'The Architectural Works Protection Act of 1990: A Solution or Hindrance?" 22 Mem. St U.L. Rev. 807 (1992); Andrew Pollock, "The Architectural Works Copyright Protection Act: Analysis of Possible Ramifications and Arising Issues" 70 Nebraska L. Rev. 873 (1992); Raleigh Newsam, "Architecture and Copyright: Separating the Poetic from the Prosaic," 71 Tul. L. Rev. 1073 (1997); Gregory Hancks, "Copyright Protection For Architectural Design: A Conceptual and Practical Criticism," 71 Wash. L. Rev. 177 (1996); Todd Hixon, "The Architectural Works Copyright Protection Act of 1990: At Odds With the Traditional Limitations of American Copyright Law," 37 Ariz. L. Rev. 629 (1995); Clark Thiel, "The Architectural Works Copyright Protection Gesture of 1990, or, 'Hey, That Looks Like My Building!'" 7 De Paul J. of Arts and Entertainment Law 1 (1996).
2. Greenstreet, R., and Klingaman, R. "Architectural Copyright: Recent Developments in Protecting Originality and the Architect's Right of Ownership", Architectural Research Quarterly, Cambridge University, England. Vol. 4, No. 2, 2000, pp. 177-183.
3. Humphreys & Partners Architects, L.P., v. Lessard Design, Inc., et al No. 1:13-cv-433 (2014)
4. Whereby a Judge reviews the pleadings presented by the plaintiff and the defendant prior to a court hearing and assesses the proof in order to determine if there is a genuine need for a trial.
5. "The work must be completely new in the sense that it does not contain material that has been previously published or registered or that is in the public domain" (United States Copyright Office).
6. Design Basics, LLC, et al., v. Lexington Homes, Inc. et al., No 14-CV-1102 (U.S. Court of Appeal, &th Circuit) 2017, Design Basics, LLC, et al v. Kerstiens Homes & Designs, Inc., et al. No. 1:16-cv-00726-TWP-DLP. and Design Basics LLC, v. Heller and Sons, Inc. d/b/a Heller Homes No. 1:16-cv-175-HAB.
7. See Lexington
8. Greenstreet R. 'The origins and Unforeseen Implications of the Architectural Works Copyright Protection Act and Recent Developments in its Interpretation and Implementation'. Marquette Intellectual Property and Innovation Law Review. Volume 25. Summer 2021. Number 2.
9. See T-Peg, Inc. v. Vermont Timber Works, Inc.,459 F.3d 97 (Ist Cir. 2006) and Sturdza v. United Arab Emirates, 281 F.3d 1287 (D.C. Cir. 2002).

About the Author:
Robert Greenstreet Ph.D. *is Professor and Dean Emeritus of the School of Architecture and Urban Planning at the University of Wisconsin-Milwaukee. He served in the role of Dean for 29 years and is one of the longest serving Deans of Architecture in the United States.*