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## Will architectural works law have a chilling effect?

**Designers worry that 1990 act will force them to add original elements just to avoid liability.**

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FOR ARCHITECTS AND other designers of residential buildings, originality is a constant professional challenge. Designers frequently struggle to create new and innovative designs. Clients, of course, often make demands that influence the degree of originality in a project. Client design input is further influenced by budgetary constraints, site limitations, available construction materials, zoning ordinances, building codes and design review boards. As a result, architects often use traditional and/or conventional architectural configurations that contain little or no originality.

The issue of originality also provides challenges when considered from a legal perspective. The Architectural Works Copyright Protection Act (AWCP Act) was passed in 1990 to bring U.S. copyright law into conformance with the Berne Convention, an international treaty dealing with intellectual property.<sup>1</sup> The AWCP Act has been used by architects, designers and builders to sue competitors. This article addresses a few problems associated with litigation involving

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copyright protection for architectural works.

Before the AWCP Act was enacted, most architectural works in the United States derived copyright protection, if any, from the 1976 Copyright Act. The 1976 Act gave limited protection to architectural works. Such works were usually deemed "useful articles"—which meant that virtually no buildings (beyond a few monuments and decorative elements) were given copyright protection.<sup>2</sup> Courts also distinguished between architectural drawings and the ideas they encapsulated. Hence, if only the building and not the drawings were copied, no copyright liability ensued.<sup>3</sup>

Despite resistance from the American Institute of Architects, Congress determined that the Copyright Act should be modified to align U.S. copyright law with the Berne Convention. The new legislation expands the copyright protection afforded to architectural works, defined as "the design of a building as embodied in any tangible medium of expression, including a building, architectural plans or drawings."<sup>4</sup>

Under the AWCP Act, copyrightable material must be "an original work of authorship," although aesthetic merit, ingenuity or uniqueness are not necessarily factors in its determination. Protected works must contain a minimum amount of original creative expression. Protection is not given, however, to standard designs such as common architectural features, nor to any functionally required elements, such as structural walls, doors or windows.<sup>5</sup> As a result, protection may not exist at all for smaller design projects for which the range of design elements and variables is more limited.

There are two key considerations for litigants dealing with the AWCP Act: what elements of a typical residential design are not subject to copyright protection and what copyright protection exists for derivative architectural works. Determining what constitutes a protectable architectural structure

is a variation of the familiar and troublesome question of what constitutes a "work of art." This is a major issue with regard to residential designs, which are often dictated by numerous standard, functional, conventional and/or regulated design features.

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**Determining what is a 'standard' feature or a 'functional' design element can be ad hoc and subjective.**

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The AWCP Act does not protect all architectural works.<sup>6</sup> In fact, the act specifically states that it does not protect standard configurations of spaces or individual standard features.<sup>7</sup> The act only covers the artistic (nonstandard and nonfunctional) features and/or designs of buildings. Unfortunately, determining what is a "standard" feature or a "functional" design element is an ad hoc and subjective exercise.

### **Stock features not protected**

When dealing with copyright protection for literary works, courts have adopted a *scenes à faire* approach—holding that stock literary devices are not protectable by copyright.<sup>8</sup> In the context of architecture, stock design elements, similar to stock literary devices, may not be copyrightable.

In many residential designs, bedrooms, kitchens, bathrooms, living rooms, dining rooms, deck/patios, windows, doors, stairs or gables are no more than standard architectural features. Thus, the entire layout of some small houses may be considered the architectural equivalent of *scenes à faire*—and may therefore receive copyright protection only with proof of identical copying.<sup>9</sup>

*Howard v. Sterchi* is a case in point.<sup>10</sup> In that case, the designer of a country-style log home sued a company that was in the business of manufacturing and erecting log homes, alleging

copyright infringement. On appeal, the plaintiffs asserted that the district court had erred in holding that there was no infringement. The U.S. Court of Appeals for the 11th Circuit affirmed, however, holding that the plaintiff had failed to establish copyright infringement of the floor plan. The appellate court determined that the infringement claim failed because the defendant's plans were not substantially similar to the plaintiff's.

In determining whether the plans were substantially similar, the district court evaluated points of similarity and points of dissimilarity between the two plans. Afterward, the court held that although the floor plans were visually similar and the layout was generally the same, some dissimilarities were significant, including the rooflines, the bay window and the dimensions. The trial court noted that, in country-style frame houses, similarities in the general layout of rooms can easily occur innocently. The 11th Circuit agreed:

"The variety of ways that a 2-story rectangle can be divided into three bedrooms, two baths, kitchen, great or a living room, closets, porches, etc., is finite. In architecture plans of this type, modest dissimilarities are more significant than they may be in other types of art works."<sup>11</sup>

Following this precedent, it may be difficult for a plaintiff to prevail on a claim based on the AWCP Act without proof of identical copying. In another instructive case, *J.R. Lazaro Builders Inc. v. R.E. Ripberger Builders Inc.*, the court held:

"Thus, in order for there to be infringement, the substantial similarity must be of the protectable expression and not the idea itself. The idea/expression dichotomy is very important for copyright protection of architectural works and home designs; obviously, placing a bathroom adjacent to a bedroom or a walk-in closet in a master bedroom in a house are ideas not capable of copyright protection. Substantial similarity must be evaluated, instead, 'on the basis of the original design elements that are expressive of [the designer's] creativity.'"<sup>12</sup>

The *Lazaro* court pointed out that "the instance case is illustrative of the difficulty of accessing a designer's creativity in the context

of a rather common house."<sup>13</sup> Both parties conceded that home designers regularly look to existing home designs as departure points for expressing their creativity.<sup>14</sup>

### Same for functional designs

Copyright protection does not extend to functional items in architectural works.<sup>15</sup> According to the legislative history for the AWCP Act, functionality cannot be ignored in evaluating the copyrightability or scope of protection for architectural work.<sup>16</sup> In residential buildings, the majority of elements may be deemed "functional."<sup>17</sup>

Functional design elements such as roofs, gables and windows are likely to be dictated by the structure's primary function—providing shelter and light to the building's occupants. Such features may not exist independently from their utilitarian aspects as independent works of art and therefore may not be entitled to copyright protection.

Most house designs—especially small or low-budget designs—are influenced by substantial functional considerations that may contain few nonfunctional architectural design elements. In other words, a house that incorporates turrets and other fanciful embellishments may merit copyright protection, whereas the roof of a simple, traditional, Cape Cod-style house would probably not qualify.<sup>18</sup>

Patent law, not copyright law, is designed to prevent the copying and use of utilitarian works such as architectural drawings and buildings, and courts should be mindful to avoid interpreting the AWCP Act so as to grant a patent-type claim.<sup>19</sup>

With regard to basic design ideas incorporated into residential designs, copyright protection extends only to the particular expression of an idea, never to the idea itself.<sup>20</sup> Copyright protection, unlike a patent, gives no exclusive right to the art itself.<sup>21</sup> This idea/expression distinction is necessarily subjective, and when idea and expression are indistinguishable, copyright law will protect only against identical copying.<sup>22</sup>

In other words, when the idea and its expression are inseparable, copying the expression will not be barred since protecting expression in such circumstances would confirm a monopoly of the idea on the copy-

right owner, free of the conditions and limitations imposed by patent law.<sup>23</sup> Similarity of expression, which necessarily results from the fact that the common idea is capable of expression only in more or less stereotypical forms, precludes copyright protection.<sup>24</sup>

### Issue of derivative designs

Since designers often look to existing designs for inspiration and/or ideas, the availability of copyright protection for "derivative works" may be a significant issue in litigation dealing with architectural works. In fact, most reasonably priced residential designs may be considered to be "derivative." This determination may have a significant impact on a plaintiff's claim based on the AWCP Act.

Copyright protection for derivative works is subject to two important limitations. First, the original aspects of a derivative work, if any, must contain some "substantial originality."<sup>25</sup> Second, the scope of copyright protection afforded a derivative work involves only the substantially original and nontrivial features, if any, contributed by the author to the derivative work.

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## To get copyright protection, a 'derivative' building must have some new and substantially original material.

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A derivative work must be substantially different from the underlying work to be copyrightable.<sup>26</sup> The substantial-originality rule is designed to ensure a "sufficiently gross difference" between the underlying work and the derivative work, to avoid "entangling" subsequent authors in "copyright problems."<sup>27</sup> Failure to enforce the substantial-originality rule would wrongfully inhibit the creation of any other derivative works by giving the first "creator" the power to interfere with the creation of any subsequent works from the same underlying work.

The substantial-originality rule is also designed to prevent the extension of copyright protection to minuscule variations which would put a "weapon for harassment" in the hands of plaintiffs. It is further designed to prohibit the appropriation and monopolization of work already in the public domain, so when

the only changes to the pre-existing work are minuscule, the current work is not subject to copyright protection.<sup>28</sup>

Consequently, to be subject to copyright protection, a "derivative" building must contain some new and substantially original material. If two separate works are strikingly similar to one another, it does not necessarily constitute an infringement if each can be proven to be the result of completely independent effort. This is especially true if both works are derived from common sources and materials available to all.<sup>29</sup>

### Possible effects of AWCP Act

It appears that most of the plaintiffs claiming copyright protection for architectural works are not the designers who created the original work. Instead, most of the plaintiffs are builders who obtain the right to sue their competitors by taking assignments from the original architectural designers. Furthermore, most of the cases have concerned housing units, which hardly fall into the category of cutting-edge design. Home builders have been claiming copyright protection for works that are modest in both scale and in design aspirations. These plaintiffs have sued their local competitors, alleging that the competitor's designs are copies. This raises a question as to the degree to which simple residential buildings can vary, given the limited number of variables in their composition and the necessity for all to share certain functional features.

The problem is compounded because residential building designs are often not particularly original in the first place, deriving their form and appearance from traditional styles such as "Saltbox," "Colonial" or "Williamsburg." The AWCP Act may have a chilling effect on the design process by forcing the architect to strive for new degrees of originality based not on client requirements, site considerations or personal vision, but on fear of liability. If copyright protection for residential buildings is over-rigorously enforced, each new home in a subdivision or community must be designed to consciously avoid any similarities to its neighbors—hardly a recipe for a coherent physical environment.<sup>30</sup>

From the perspective of many architects, creativity and progress are best served by making standard individual elements and configurations freely available for use by others. They believe that an architect's work should not encompass the exclusive right to use basic design elements such as skylights, courtyards, domes, columns, gables and other basic shapes.<sup>31</sup> Copyright protection for basic architectural shapes and configurations may inhibit or preclude architects from drawing on common sources, borrowing ideas and concepts, and imitating the styles of their contemporaries and predecessors.<sup>32</sup>

The AWCP Act may eventually limit the free flow of ideas and curtail the creative development of architectural works, resulting instead in a limited palate of conventional and safe designs. Several commentaries have been written that address these concerns.<sup>33</sup> There have been relatively few cases to date interpreting the AWCP Act. Future court decisions will have to be watched carefully to determine whether the act, which was intended to help the architectural designer, creates more serious problems than the ones it was supposed to solve.

(1) Architectural Works Copyright Protection Act 1990 (AWCP Act), Pub. L. No. 101-650, 104 Stat. 5089, 5133 (1990) (codified throughout Title 17 of the U.S. Code).

(2) *Demetriades v. Kaufman*, 690 F. Supp. 658, 664 (S.D.N.Y. 1988).

(3) *Imperial Home Corp. v. Lamont*, 458 F.2d 895 (5th Cir. 1972).

(4) 17 U.S.C. 101.

(5) 37 C.F.R. 202.11(d).

(6) Vanessa N. Scaglione, "Building Upon the Architectural Works Copyright Protection Act of 1990," 61 *Fordham L. Rev.* 193 (1992).

(7) 37 C.F.R. 202.11(d).

(8) *Reyher v. Children's Television Workshop*, 533 F.2d 87, 90 (2d Cir. 1976).

(9) *Coates-Freeman Assoc. Inc. v. Polaroid Corp.*, 792 F. Supp. 879 (D. Mass. 1992).

(10) 974 F.2d 1272 (11th Cir. 1992).

(11) *Id.* at 1276.

(12) *J.R. Lazaro Builders Inc. v. R.E. Ripberger Builders Inc.*, 883 F. Supp. 336, 343 (S.D. Ind. 1995), quoting Ralph Winick, "Copyright Protection for Architecture After the Architectural Works Copyright Protection Act of 1990," 41 *Duke L.J.* 1598, 1633 (1992).

(13) *Lazaro Builders*, 883 F. Supp. at 343.

(14) *Id.*

(15) H.R. Rep. No. 735, 101st Cong. 2d Sess (1990) (reprinted in 1990 U.S.C.C.A.N. 6935, 6951-52).

(16) H.R. Rep. No. 735, 101st Cong. 2d Sess (1990) (reprinted in 1990 U.S.C.C.A.N. 6935, 6951-52).

(17) Michael Huet, "Architecture and Copyright," 19 *UNESCO Copyright Bull.* 6 (1985).

(18) Leland M. Roth, *A Concise History of American Architecture* (1979).

(19) *Demetriades v. Kaufman*, 690 F. Supp. 658, 664 (S.D.N.Y. 1988); U.S. Copyright Office, *A Report of the Register of Copyrights: Copyright in Works of Architecture* (1989); James Bingham Bucher, "Reinforcing the Foundations: The Case Against Copyright Protection for Works of Architecture," 39 *Emory L.J.* 1261 (1990).

(20) *Reyher v. Children's Television Workshop*, 533 F.2d 87, 90 (2d Cir. 1976).

(21) *Mazer v. Stein*, 347 U.S. 201, 217 (1954).

(22) *Sid & Marty Krofft Television Prods. Inc. v. McDonalds Corp.*, 562 F.2d 1157, 1167-68 (9th Cir. 1977); *Peter Pan Fabrics Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

(23) *Hubert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971).

(24) 3 *Nimmer*, *Nimmer on Copyright*, 13.03(A)(1) at 13-28 (1981).

(25) *L. Batlin and Sons Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976); *Chamberlain v. Uris Sales Corp.*, 150 F.2d 512 (2d Cir. 1945).

(26) *Gracen v. Bradford Exchange*, 698 F.2d 300, 305 (7th Cir. 1983).

(27) *Id.* at 305.

(28) *Durham Indus. v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980).

(29) *Greenlee v. Noble*, 151 F. Supp. 45,65 (S.D.N.Y. 1957).

(30) See, e.g., *RPM Mgmt. v. Apple*, 943 F. Supp. 837 (S.D. Ohio 1996); *Ronald Mayotte & Assoc. v. MGS Bldg. Co.*, 36 U.S.P.Q.2d (BNA) 1793 (E.D. Mich. 1995).

(31) David E. Shipley, "Copyright Protection for Architectural Works," 37 *S.C.L. Rev.* 393, 439 (1986).

(32) Elizabeth K. Brainard, "Innovation and Imitation: Artistic Advance and Illegal Protection of Architectural Works," 70 *Corn. L. Rev.* 81, 91-94 (1984).

(33) See 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 T. 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).