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## Protecting Copyrights to Architectural Works

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Now that federal copyright law protects the creative aspects of three-dimensional structures as well as architectural plans, the courts are rewarding the creators of unusual designs and punishing those who infringe them. Damages can run into the millions of dollars. As a result, for the architect and builder it has become more important than ever to protect these designs.

The Copyright Act gives the architect or other copyright owner the ability to obtain legal recourse against an infringer. This recourse includes injunctive relief, statutory damages and even reimbursement for attorney fees.

The mere fact that a builder/architect constructs a home that is substantially sim-

ilar to one already built does not in and of itself constitute copyright infringement. To obtain relief, the complainant must copy the protected elements of that house under the 1990 amendment to the Copyright Act of 1976, known as the Architectural Works Copyright Protection Act (AWA).

Under the AWA, a copyrightable “architectural work” is “the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.”

In his presentation of the bill before the 101st Congress, Rep. Robert Kastenmeier, D-Wis., noted, “The term ‘design’ is intended to encompass not only the overall shape of a structure, but also its protectable



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individual elements.” This meant that there is only one “architectural work” per structure; the creator may seek only one

registration per structure, not one for each of the multiple elements in any given structure.

This provision recognizes that creativity in architecture frequently takes the form of a selection, coordination and arrangement of unprotectable elements into an original, protectable whole. It also addresses the reverse situation, where an architect incorporates new, protectable design elements into otherwise standard, unprotectable building features. In essence, the law will only protect the architect's original contribution.

In the copyright analysis for architectural works, one starts with something functional and then tries to find whether there are protectable elements of individual expression or, alternatively, whether the unprotectable elements have been selected, coordinated or arranged in a manner that is creative enough to be protectable. This was established in a 1991 decision in *Feist Publications Inc. v. Rural Tel. Service Co.*

The law also requires that the design be embodied in a building or other three-dimensional structure, not the design of the building as depicted in architectural plans or drawings, since these depictions are already protected and will continue to be protected as pictorial, graphic, or sculptural works.

By attempting to segregate the consideration of architectural works from that of plans and drawings, the drafters of the Copyright Protection Act of 1976 hoped to avoid entangling architectural works in the disagreement over how to apply the separability test that the courts use with difficulty when reviewing pictorial, graphic and sculptural works embodied in so-called useful articles.

One must only read the 2nd U.S. Circuit Court of Appeals' *Kieselstein-Cord v. Accessories by Pearl Inc.* case to notice the problems. Judge James Oakes found that a decorative belt buckle contained "conceptually separable sculptural elements," which made it copyrightable. Judge Jack Weinstein, in his dissent, came to the opposite conclusion that the buckles are "aesthetically pleasing examples of modern design" but were really "inseparable from the important function they serve."

But the desire to escape the briar patch of the separability test does not ensure one's escape from other thorns. The act's drafters

were forced to acknowledge that in evaluating the copyrightability or scope of protection for an architectural work, the courts and the U.S. Copyright Office could still not ignore "functionality."

First, according to the introduction to the AWA, "an architectural work should be examined to determine whether there are original, artistic elements present, including the overall shape. If so, a second step is reached to examine whether the original, artistic elements are functionally required. If the elements are not absolutely functionally required, the work is protectable."

But, there is a catch. The introduction continues, "The proper scope of protection is a different matter; functional considerations may, for example, determine only particular design elements." In such a case, protection would be denied for the functionally determined components, but would be available for the non-functionally determined design elements. The courts must be free to develop their own applications of these principles, free from the separability debate raging for pictorial, graphic, and sculptural works embodied in useful articles."

Did we escape that briar patch or just land in another one?

The drafters of the AWA felt there should be at least two limitations on the scope of exclusive rights in architectural works. The first prevents the copyright owner of a structure from preventing people from photographing it if it is ordinarily visible to the public. This provision was clearly enacted to protect the tourist who takes a photograph of his or her family in front of the Empire State Building, particularly if the purpose of the picture was to hang on the wall of their den at home. More difficult questions arise if the picture is taken, for example, from the air of a structure not ordinarily visible to the public. If that aerial shot is combined with the use of the photograph for a highly commercial purpose, like advertising one's business or selling photographs, one wonders whether this exception would apply.

Second, the drafters dealt with what to do about certain remedies like injunctions. Kastenmeier intended to include a section that would have prevented injunctions from lying "against construction of an allegedly infringing structure, if construction has substantially begun." He wanted

to prevent the seizure and destruction of infringing buildings and thought these limitations were necessary to protect the development community from potentially draconian consequences, leaving them to monetary remedies.

Interestingly enough, this section was omitted from the final bill. Accordingly, the door is left open for an aggrieved copyright owner to demand the seizure and destruction of an infringing structure.

Finally, the bill as enacted allows the owners of a building "embodying an architectural work," without the consent of the author or copyright owner of the architectural work, to alter or authorize the alteration of such a building, and destroy or authorize the destruction of such a building.

After establishing the critical element of copying, either through access or actual proof, judges determined whether the structure contained the minimal elements of creativity necessary to establish that it was copyrightable. They then looked to specific creative, non-functional elements. In *CSM Investors Inc. v. Everest Development Ltd.*, they considered such elements as "sawtooth loading doors and a parapet wall," which were common to the structures being compared. They examined the length of the buildings, the use of brick in front and back, and the similar floor elevations. They looked to the almost identical landscaping and the parking areas, along with the vehicular traffic patterns to establish actionable similarity.

A Virginia court, while noting that a colonial house was not itself protectable, found in *Richmond Homes Management Corp. v. Raintree Inc.* that the work embodied protectable expression by featuring a long double-A frame outlining the front, the different slopes to the roof both in front and in back, the double windows, the octagonal air vents, the placement of the family room in the front of the house and similar creative elements.

More recently, in *Hablinski v. Shabverdi*, the plaintiff architect hired experts who were able to examine his body of work and identify the creative elements common to his structures, relate them to the mansion he designed and show how the defendants' building copied these expressive elements.

Finally, these cases illustrate the fact that copying can be expensive. In *Richmond*

*Homes*, a developer sold 14 homes from a copied design, and the infringer had to pay the entire net profits from those sales to the plaintiff. In the *Hablinski* case, decided this April, a California jury, following a three-week trial, awarded an architectural firm \$5.9 million in damages.

The complexity of defending copyright cases can result not only in extensive litigation costs related to attorney fees and experts, but also significant damages. The AWA permits an aggrieved party to recover a variety of damages, including the value of the plans (referred to as actual damages), attorney fees (in limited circumstances) and infringer's profits.

The hammer that should deter future infringers and protect copyright owners is clearly infringer's profits, which, according to the 4th Circuit in *Bonner v. Dawson*,

include "any profits that are attributable to the infringement." For example, if a builder sells 10 homes in a development using the infringing design and makes a profit of \$100,000 per home, then the aggrieved party may be entitled to \$1 million.

However, this rule is not absolute, as the infringer has the opportunity to reduce the total of the profits by proving that some or all of the profits were "attributable to factors other than the copyrighted work." Thus, an infringer who sells commercial space in an office building will have the opportunity to argue that the profit stream was not causally related to the design of the building, but to such things as the location.

In the event that the infringer can break the causal chain, he may be spared from paying infringer's profits. This will not let

him off the hook entirely, however, because there will be an opportunity for the plaintiff to seek statutory damages (those granted by the statute and in the discretion of the judge) in lieu of actual damages.

In short, both architects and builders must be proactive. Architects should stamp their plans and drawings and file them with the Copyright Office. In a separate filing, they should register their copyrights to the three-dimensional design of the building as a whole. The rules on the timing of these filings are tricky, so consult an attorney or the Copyright Office. Builders should take great care if there is any question about the similarity of designs. Seek professional advice, get clarification, or obtain rights to a design before putting mortar to brick. •