

November 27, 2007

Copyright Infringement of Architectural Works: Trial Strategies For Defendants

by Meaghan Hemmings Kent

Copyright infringement of architectural plans is an interesting area of law with many difficult issues and grey areas. This brief article will create an overview of the architectural plan copyright infringement suit, from infringement burdens to potential defenses, will discuss some of the difficult and interesting issues that have arisen, and along the way will give some practical tips for defending such a suit.



Architectural Works

According to United States Code, the definition for an “architectural work” is “the design of a building as embodied in any tangible medium of expression, including in 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.” 17 U.S.C. § 101 (emphasis added).

Infringement

A plaintiff who asserts copyright infringement needs to prove both ownership of a valid copyright, and unauthorized copying of that copyrighted work by the defendant.

1. Ownership Of A Valid Copyright

Ownership is self explanatory and is usually a non-issue. However, it is worth requesting information regarding any licenses, assignments or other transfers of the copyright, as well as any business sales agreements that may have transferred ownership of any rights in the plans, as well as any employment or contractor agreements involving the designer.

Validity is usually a non-issue as well. A certificate of registration that was issued within five years of first publication is prima facie evidence of the validity of the copyright. 17 USC 410(c). In addition, many courts have held that a copyright registration itself, regardless of filing timeframe, is prima facie evidence of validity. Nonetheless, there are a couple of issues to consider.

If the plan was not original, it is not protectable.

Only “original” work is protected by copyright law. However, “original” does not mean novelty or uniqueness, but rather, “independent creation.” In reality, a very low degree of originality is required – essentially, to be original, the work must have been independently created by the author, as opposed to copied from another work. Courts have not required an elevated level of originality in the architectural arena.

Despite this low threshold, it is certainly worth asking the plaintiff about their creation because you never know what they might say. For instance, asking the plaintiff about his process, how he gets his ideas, whether he looked at other plans, if he goes to home shows, if he looks through plan books, etc. can be a valuable exercise. The plaintiff can either admit to looking at other plans (which almost all designers do) or they can deny it and appear disingenuous.

A plan from before December 1, 1990 was not copyrightable as a Architectural Work.

Before 1990, architectural works were protected as graphic or pictorial works, but not as buildings, and copyright protection was only afforded to drawings and specifications. This meant that there was no copyright infringement if a duplicate structure was constructed from the building as long as the drawing and specifications were not copied. This changed with the Architectural Works Copyright Protection Act (effective December 1, 1990) such that designers or architects now have two copyrights in their works – one for the design embodied in the drawings or building as “architectural work” and the other in the drawings themselves, as “graphic” or “pictorial” works. Now, copying a building from a building is a copyright infringement, even if the plans were not copied. However, the designs of buildings where the plans or drawings of the building were published before December 1, 1990 are protected only as graphic or pictorial works. Also, buildings constructed or otherwise published before December 1, 1990, are not protectable as “architectural works” under the Architectural Works Copyright Protection Act. This can potentially be a valuable defense if the plaintiff’s asserted plan was created before 1990 (the Act is not retroactive), and the plan was never copied, even if the building is substantially similar.

2. Unauthorized Copying

Plaintiff does not have to prove direct copying; indirect evidence of copying by circumstantial proof is sufficient. Indirect evidence requires a showing that the defendant had access to the copyrighted work and that the allegedly infringing work is substantially similar to the copyrighted work. Access is usually fairly easily inferred if the work has been published (often in a house plan catalog, look book, competition book, or on-line) or constructed, and can sometimes be directly shown if the defendant purchased the plan from the plaintiff (but decided not to use it). As long as there was a reasonable probability that the alleged infringer saw the prior work, that suffices as access.

The Test for Substantial Similarity Varies from Circuit to Circuit.

Substantial similarity is a somewhat vague concept that falls somewhere in between no similarity and complete similarity. Many clients will reference a 10% or 25% test – believing that they have to be 10% or 25% similar to be substantially similar. Of course, there is no such test. Indeed, substantial similarity is a fact and argument intensive exercise that will vary greatly by the circumstances and the court.

Courts have generally agreed that the standard test for comparing the plans is the “ordinary observer test” – whether a regular lay observer would conclude that the alleged copy was actually copied from the copyrighted work. See *Nihon Keizai Shimbun, Inc. v. Comline Business Data, Inc.*, 166 F.3d 65, 70 (2d Cir. 1999); However, before the evaluation of the plans, different courts (even within circuits) have articulated different standards for determining what exactly in the plans should be compared.

The test acknowledged by most circuits is a two part test that requires exclusion of non-protectable elements before comparison of the works. These courts generally hold that a substantial similarity evaluation involves a two step analysis that first requires the exclusion of elements that are not protected by copyright, and second, a comparison of the plaintiff's actual protected expression (excluding those non-protectable elements) to the allegedly infringing work. Under this test, the first step requires the exclusion of non-protectable elements, such as, "individual standard features," design elements that were functionally determined, and abstract ideas. See *Greenberg v. Town of Falmouth*, 2006 U.S. Dist. LEXIS 4792, * 5 (D. Ma. 2006)(Explaining the two step-step analysis for substantial similarity: "First, the court must engage in 'dissection' of the plaintiff's copyrighted work to determine what within it constitutes protected expression, setting aside those aspects not protected by copyright. Once 'dissection' has occurred, the plaintiff's actual protected expression is compared to the alleged infringing work to determine whether they are 'substantially similar.'"); *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 208 (3d Cir. 2005)(After finding copying, a second step must focus on "whether the substantial similarities relate to protectible material."); *Murray Hill Publs. v. Twentieth Century Fox Film Corp.*, 361 F.3d 312, 318 (6th Cir. 2004)(the first step requires identifying which aspects of the artist's work, if any, are protectible by copyright, the second involves determining whether the allegedly infringing work is substantially similar to protectible elements of the artist's work."); *David & Goliath Builders, Inc. v. Elliott Construction, Inc.*, 2006 U.S. Dist. LEXIS 34991, * 15 (W.D. WI. 2006)("Once unprotectible elements such as ideas and standard features have been excluded from consideration, the next step in an infringement inquiry is determining whether the allegedly infringing work is "substantially similar" to the protectible elements of the artist's work"); *Country Kids 'N City Slicks, Inc. v. Vicki Sheen, et al.*, 77 F.3d 1280, 1284-85 (10th Cir. 1996)(To determine substantial similarity, "we find it useful to apply the 'abstraction-filtration-comparison' test" where "At the abstraction step, we separate the ideas (and basic utilitarian functions), which are not protectable, from the particular expression of the work. Then, we filter out the nonprotectable components of the product from the original expression. Finally, we compare the remaining protected elements to the allegedly copied work to determine if the two works are substantially similar."); *Elena Sturdza v. United Arab Emirates, et al.*, 281 F.3d 1287, 1296 (D.C. Cir. 2002)("Once unprotectible elements such as ideas and scenes faire are excluded, the next step of the inquiry involves determining whether the allegedly infringing work is 'substantially similar' to protectible elements of the artist's work" which then requires consideration of the "look and feel" of the entire work.).

However, there are some courts that apply a "total concept and feel" test, which dictates that the fact finder must look at the work as a whole, without dissection of protectable versus non-protectable elements, considering the "overall look and feel" of the structure. *Axelrod & Cherveney Architects, P.C. v. Wnmar Homes*, 2007 U.S. Dist. LEXIS 15788, * 37 (2007 EDNY)("The factfinder must look at the work as a whole without dissection ... a factfinder must avoid taking a divide and conquer approach in assessing elements of the work."); *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970)(Applying "total concept and feel" test). However, even these courts will usually acknowledge that not all elements are protectable, and should consider argument that some elements are not protectable. *Nihon Keizai Shimbun, Inc. v. Comline Business Data, Inc.*, 166 F.3d 65, 70 (2d Cir. 1999) ("Where the work at issue contains both protectible and unprotectible elements, the test must be "more discerning," excluding the unprotectible elements from consideration." The court stated that it must exclude facts and only compare original elements, and holding that when "the copyrighted work contains both original and unprotected elements, a

higher quantity of copying is required to support a finding of substantial similarity than when the infringed work is wholly original.”). Thus, no matter what test is favored, it is important to distinguishing the non-protectable elements before comparing the plans.

“Individual Standard Features” are not copyrightable and should be excluded from the comparison.

The definition of an architectural work excludes “individual standard features” such as windows, doors, and other staple building components. Standard configurations of spaces are not afforded copyright protection either. Nor do common geometric shapes that are insufficiently original qualify for copyright protection. For instance, in a architectural plan copyright case in Massachusetts, the court held that forty-five degree angled walls in a hallway were basic geometric shapes that were not copyrightable. Greenberg, 2006 U.S. Dist. LEXIS 4792 at *9.

The design elements that are functionally required are not protectable and should be excluded from the comparison.

According to the legislative history, for copyrightability, a “two-step analysis is envisioned. First an architectural work should be examined to determine whether there are original design elements present, including overall shape and interior architecture. If such design elements are present, a second step is reasoned to examine whether the design elements are functionally required. If the design elements are not functionally required, the work is protectable without regard to physical or conceptual separability.” H.R. Rep. Co. 101-735, 101st Congress, 2d Session 20-21 (1990). Thus, functionally determined design elements are not protected. This includes foundations, windows and doorways, which can be designed in only one manner.

In addition, it is often functional requirements that determine the layout of a home. The argument that there are only so many ways to draw a home in a particular shape can be powerful, and has been successful. See *Howard v. Sterchi*, 974 F.2d 1272, 1276 (11th Cir. 1992)(“The variety of ways a two-story rectangle can be divided into three bedrooms, two baths, a kitchen, a great room or living room, closets, porches, etc., is finite.”) This is particularly true when lot limitations, local regulations, and customer desires are considered. For instance, the lot size and shape affects the layout. Plus, there are usually local construction rules regarding boundary requirement, thus further limiting the size and shape of the house. Further, local regulations may include requirement that all bedrooms be on exterior walls, or other such limitations. Beyond basic regulations, functional and customer need factors further limit the design. For instance, the functional element or idea of placing administrative offices near the front of the building close to the road to permit employee and public access is not protectable. Similarly, placing garages and service shops in the back is not protectable. Greenberg, 2006 U.S. Dist. LEXIS 4792. Likewise, the width of the go-kart track that accommodated the cars and the inclusion of walls to keep the cars on the track, are non-protectable functionally inspired elements. *Fun Spot of Fla., Inc. v. Magical Midway of Cent. Fla., Ltd.*, 242 F. Supp. 2d 1183, 1198 (M.D. Fla. 2002).

Demonstrating how regulations and functional aspects limit the original design of the plan is extremely valuable, and can be simply done with a rough sketch and a bubble diagram, drawn in front of the jury. Going through a rough sketch step by step will drive the point home with the trier, who will realize that the overall layout of the house is often dictated by lot size, and local building rules and regulations. In addition, an architectural expert can go through this exercise with the trier

by explaining HOW the plans are usually designed, the importance of flow to a home, and what the functional issues are that contribute to the design. For instance, he might describe how he might have designed the home – starting with the lot size, discussing the boundary requirements, discussing how a garage at the front is sought after in new homes, how entering the kitchen off the garage is popular, etc. Bubble diagrams are a simple, quick and effective way to demonstrate how a plan will be initially laid out. Of course, when selecting the expert, it is most useful to use someone that has designed in the same geographic location and can discuss what home buyers in those locations are looking for – homebuyers in different regions and neighborhoods have different needs and will look for different design elements in a home.

Concepts and ideas are not protectable and must be excluded from the comparison.

“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.” 17 U.S.C. § 102(b). Copyright does not protect against the borrowing of abstract ideas contained in the copyrighted work. Copyright protects against copying the expression of those abstract ideas. Thus, if the only similarity is the abstract idea itself, and not the expression of that idea, there is an absence of substantial similarity and there is no infringement. This is an abstract concept, but it is very helpful to a defendant’s case. Often, the plans will appear similar because they merely share similar non-protectable concepts – the concept of a split plan with secondary bedrooms separated from the master suite, the concept of a master suite, the concept of a great room that leads to the backyard, the concept of the popular open floor plan. Even the concept of an island (a peninsula-shaped bar to bisect a seating area which has booths on one side and stool seating on the other) was held not copyrightable because at that “level of generality,” it is “nothing more than a concept, as distinct from an original form of expression.” *Ale House Management, Inc. v. Raleigh Ale House, Inc.*, 205 F.3d 137, 143 (4th Cir. 2000). Further, under the merger doctrine, infringement will not be found if a particular idea can only be expressed in a very limited number of ways, including the way that the plaintiff is attempting to claim copyright protection. For instance, if setback requirements and other local regulations dictate much of the design, the plan could only be designed in a certain way, the merger doctrine dictates that those similarities should not be considered in evaluating substantial similarity.

Putting unrelated plans before the trier that share similar concepts as the plans at issue makes the point well that it is really just an idea or concept that many plans share, and that the plaintiff’s copyright protection does not extend to those ideas. Plans sharing similar concepts from before the plaintiff’s plan was designed are particularly valuable. This will help demonstrate that a lot of the plaintiff’s plan was in the public domain as a mere concept. For instance, designers have used split plans with a master suite on one side of the house and secondary bedrooms on the other, with a great room and kitchen in the middle back of the house, and front entry way flanked by a living and dining room, for many years. Plans from magazines or model homes is also valuable because members of the jury often will have looked at those magazines and now can easily relate because they have seen how many of the plans are similar. In turn, they will recall other homes they have visited or lived in that share the similar concepts or ideas. Making a point about architectural trends works well here as well. Talking to the jury about types and styles of homes that were popular in other decades (that they can related to) will help demonstrate that many of the plans drawn in the same period share common elements.

Another strong piece of evidence is if the defendant itself previously designed plans with similar flow and elements as the accused plan. This is valuable evidence that defendant did not need to copy the plaintiff when they already had plans that used similar elements and flow. Sometimes defendants will even have a series of plans that derive from each other and using them to tell the design story will demonstrate that the defendant did not copy the plaintiff's plan – they were working off their own plan.

Thin versus thick copyrights.

Another way to argue that non-protectable elements should not be considered, is the argument that the copyright is thin. Copyrights with scant creativity are considered thin, while those with significant creative effort are considered thick. Arguably, many house plans that simply incorporate basic designs that are restricted by lots, local regulations, and popular design features, are particularly thin. While not universally accepted, there are several courts that have held that for a showing of substantial similarity, more similarity is required when the copyright is thin, and that less is required when it is thick. If the plaintiff's plan is for example, a basic 3 bedroom, 2 bathroom, split plan with a kitchen and great room in the center of the house, it is arguably a fairly thin copyright, with scant creativity. In such circumstances, the argument that extensive similarity is required because it is such a thin copyright, is valuable to the defendant. Of course, for a custom, architecturally unique design, such an argument could be harmful.

Comparing the plans for substantial similarity.

Finally, after excluding the non-protectable elements, the trier must consider whether a regular lay observer would conclude that the alleged copy was actually copied from the copyrighted work. Pointing out differences between the plans can be, but is not always, valuable. If there is indeed copying of copyrightable elements, the infringer cannot excuse that wrong by showing how much of the work was not pirated. However, pointing out differences may help demonstrate that the only similarities are those elements that are not protectable. Also, if the points of dissimilarity exceed the points of similarity, and the points of similarity are of minimal importance either quantitatively or qualitatively, then there will be no infringement. Further, where a plan is of a more generic type (3/2, two story rectangle) "modest dissimilarities are more significant than they may be in other types of art works." Howard, 974 F.2d at 1276.

While an expert can be valuable for explaining how plans are designed and what consumers may be looking for, an architectural expert cannot opine on the similarity of the copyrightable elements of the plans. *Rottlund v. Pinnacle*, 452 F.3d 726, 731 (8th Cir. 2006)(Explaining that determination of substantial similarity involves a two-step analysis by which there must be substantial similarity both of ideas and of expression, and that "similarity of ideas is evaluated extrinsically, focusing on objective similarities in the details of the works" and "similarity of expression is evaluated using an intrinsic test depending on the response of the ordinary, reasonable person to the forms of expression," meaning that experts may only opine on the similarity of the ideas, but not similarity of expression.)

Defenses

Independent creation is a complete defense.

Even if the plaintiff owns a valid copyright and the copyrightable elements are identical, there is a complete defense for independent creation. While difficult, if the defendant can prove that it created the work independently, then there was no copying, and there can be no copyright infringement.

Here, it is important to distinguish independent creation from a derivative work for the defendant. Defendants are often under the incorrect impression that if they used another plan, but made changes to it to create a “new” plan, it is now their plan and it does not infringe the original plan they used to create it. Of course, this is a classic derivative work, and the defense of independent creation will not apply.

Damages

Statutory damages

At any time before final judgment is rendered, the copyright owner may elect to recover statutory damages rather than actual damages and profits. 17 U.S.C. § 504(c). Statutory damages can be awarded in the range of \$750 to \$30,000 for each instance of infringement, as the court considers just. If plaintiff shows willful infringement, this can be increased to \$150,000 for each instance of infringement. On the other hand, if the defendant can demonstrate innocent infringement – that they were not aware and had no reason to believe that their actions constituted copyright infringement – the court in its discretion may decrease the award to \$200.

Plaintiff, however, is not entitled to statutory damages unless the copyright was registered before the infringement began. 17 U.S.C. §412. This is often the case with older plans because many of the architects and designers did not have a regular registration policy until recently, and many plaintiffs only register their copyright just before filing suit.

Actual Damages

The copyright owner is entitled to recover the actual damages suffered by him or her as a result of the infringement. 17 U.S.C. §504(b). It is plaintiff’s burden to demonstrate what their actual damages were. Often this will be the license fee that they typically charge for use of the plans. In discovery, the defendant will want to request all of their license agreements or sales agreements for the plan at issue and any derivative plans. This fee is often nominal compared to what plaintiff will seek through infringer’s profits. For instance, where the plaintiff is a mass home plan designer, they often sell their plans through plan books and on-line for \$500-\$700 each, with re-use fees of only \$100-\$200. Of course, plaintiff will usually see all of the defendant’s profits from each and every allegedly infringing house – not simply a small licensing fee that they would have received. This information about small license fees, however, is helpful when arguing the actual value of the plans.

Defendant’s profits

The copyright owner is also entitled to any profits of the infringer that are attributable to the infringement and are not taken into account in computing the actual damages. 17 U.S.C. §504(b). The plaintiff must present proof only of the accused infringer’s gross revenue, and then the accused

infringer is required to prove its deductible expenses and the elements of profit attributable to factors other than the copyrighted work. 17 U.S.C. §504(b).

It is the defendant's burden to cut down its revenues to prove up profits. If a defendant fails to prove its deductible expenses, the Court can (and likely will) simply award revenues. In addition, it is also the defendant's burden to cut those profits down by showing that some are attributed to other factors – i.e. location, build quality, etc. There is virtually no case law on this attribution of profits, and it remains an unknown variable. It is definitely valuable to have an expert who is an economist with some experience in the real estate market to opine on the various factors that contribute to the sales price of a home. The jury will also recognize that “location, location, location” plays a factor in house price, and driving that old adage home with the jury is important.

Attorneys' fees

In the court's discretion it may award costs and fees to a prevailing plaintiff. 17 U.S.C. §505. However, plaintiff is not entitled to recover attorneys' fees unless the copyrighted work was registered before the act of infringement. 17 U.S.C. §421. As mentioned above, this is often the case with older plans because many of the architects and designers did not have a regular registration policy until recently.

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