

## **COPYRIGHT ON ARCHITECTURAL WORKS [na]**

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\*3 § [1]-Varieties of Copyrightable Subject Matter

The Copyright Act extends protection to certain works of original authorship which are fixed in a tangible medium of expression. [n1] Expressly included in that category are pictorial, graphic and sculptural works. [n2] It is well settled that pictorial works include architectural drawings, [n3] and that sculptural works include monuments. [n4] Apart

from monuments, however, three-dimensional architectural objects such as buildings and other fixed structures are in a different category. Until December 1, 1990 all such three-dimensional architectural objects were ineligible for copyright; [n5] and that continues to be the law even now as to all such objects except buildings. In addition, it is unsettled to what extent a copyright on architectural drawings can be asserted against one who uses infringing drawings to build such uncopyrightable objects. [n6]

#### § [1][a]-Architectural Drawings and Models

Section 101 of the Copyright Act defines copyrightable "pictorial, graphic and sculptural works" to "include two-dimensional and three-dimensional works of fine, graphic, and applied art, ... charts, diagrams, models, and technical drawings, including architectural plans." [n7] \*4 Thus, two-dimensional architectural plans and three-dimensional architectural models are expressly included. [n8]

#### § [1][b]-Buildings and Other Utilitarian Structures

Prior to December 1, 1990 it was clear that, in contrast to the situation regarding three-dimensional architectural models and two-dimensional architectural drawings, [n9] copyright protection did not extend to full-size utilitarian three-dimensional buildings and other full-sized utilitarian three-dimensional fixed structures, even if such buildings and structures were depicted in copyrighted architectural drawings or models, and even if such buildings and structures had original esthetic architectural features. This was because such structures were regarded by the copyright law as "useful articles," a categorization which (as we shall see in § [2] below) previously made them ineligible for copyright protection.

A "useful article" is defined in § 101 of the Copyright Act as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." [n10] Thus, a \*5 building which exists primarily to perform the utilitarian function of sheltering people or equipment is regarded as a useful article within the meaning of the copyright law; and so is any other type of full-sized fixed structure which primarily serves a utilitarian purpose, such as a bridge or an overpass.

On December 1, 1990, however, the Architectural Works Copyright Protection Act [n11] went into effect, making radical changes in the copyright law with respect to buildings; but not with respect to any other type of full-sized three-dimensional fixed structure which primarily serves a utilitarian purpose, such as a bridge or an overpass. [n12] Among other changes, the new act adds to § 101 of the copyright law [n13] the following new defined category of protected work: "An 'architectural work' is the design of a building [n14] 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 \*6 of spaces and elements in the design, [n15] but does

not include individual standard features." [n16] The legislative history suggests that the new act is intended to protect architecture as "a form of artistic expression...." [n17]

#### \*7 § [1][c]-Monuments

Monuments, unlike other full-scale three-dimensional fixed structures, exist primarily to present a visual spectacle, and not to shelter people or equipment. In the words of § 101 of the statute, they have a "function that is ... merely to portray the appearance of the article" (emphasis added). Therefore, monuments are primarily sculptures, rather than useful edifices, and so, even before December 1, 1990, they were considered copyrightable works. [n18]

\*8 This reasoning clearly applies to monuments which are smaller in size than buildings, such as cemetery monuments; and it probably applies even to such building-size monuments as the Statute of Liberty, Grant's Tomb, the Washington Monument, etc. Despite the fact that these structures are large enough for people to enter the interior thereof, they should be classified as monuments because their purpose is primarily to present a visual spectacle, and the ability to shelter people is merely incidental to that primary purpose.

#### § [2]-What Is Copyrightable?

Since monuments are sculptural works within the meaning of § 101, they have long been copyrightable. [n19] "Useful articles" as defined by § 101, however, are generally excluded by that section from the category of copyrightable works. Architectural plans, although they are useful, are nevertheless copyrightable because of their specific inclusion in the definition of "pictorial, graphic and sculptural works." [n20] It has been said that "Protection for architectural plans, drawings, and models as pictorial, graphic, or sculptural works under section 102(a)(5), title 17, United States Code, is unaffected by" the Architectural Works Copyright Protection Act. [n21]

\*9 Section 101 says that "the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." This means that, with one qualification, a building or other full-sized structure which is primarily utilitarian does not fit within the statutory copyrightable category of pictorial, graphic or sculptural works.

(The qualification refers to the presence of pictorial or sculptural features which are purely decorative and not utilitarian, on or in a building or other utilitarian structure. Such decorations are considered copyrightable pictorial or sculptural works, and as such were eligible for copyright [n22] even before the enactment of the Architectural Works Copyright Protection Act of 1990; [n23] but prior to the 1990 amendment such

copyrights were limited to the decorative features, and did not protect the utilitarian aspects of the structure.) [n24]

Nor does a primarily utilitarian structure fit within any of the other categories of copyrightable works of authorship which were expressly recognized in the statute prior to 1990: literary works, musical works, dramatic works, audiovisual works and sound recordings. [n25]

Moreover, it was held by the Supreme Court in the landmark case of *Baker v. Selden* [n26] that, apart from those categories of useful works \*10 which are expressly protected by the copyright statute, [n27] copyright is not intended to protect technological innovations; that is the concern of the patent laws. [n28]

\*11 In 1990, however, a new category of expressly copyrightable useful works, "architectural works," [n29] was added by amendment to § 102(a) of the copyright act. [n30] At the same time, the following definition of "architectural work" added to § 101 of the copyright statute: "the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings." [n31] Accordingly, the design of a building is now copyrightable, notwithstanding its utility. [n32]

\*12 Those statutory changes went into effect on December 1, 1990, [n33] and apply to any "architectural work" created on or after that date; which means any architectural design that, on or after that date, was embodied in any tangible medium of expression, either by being incorporated into a two- dimensional architectural plan or drawing, or into a three-dimensional architectural model, or by being actually constructed in the form of a full- sized three-dimensional building. Thus, architectural designs which are first drawn or modeled on or after the effective date are protected, whether or not they have yet been constructed in full-size form. [n34]

An amendment to § 301(b) of the Copyright Act which was adopted at the same time provides that the act does not annul or limit any right or remedy under the common law or statutes of any state with respect to state and local landmarks, historic preservation, zoning, or building codes, relating to architectural works protected by copyright. [n35]

At the same time, however, a new section 120 [n36] was also added to the Copyright Act which limits the scope of protection to be accorded to building designs under this amendment. Under subsection 120(a), the \*13 copyright in a building design will not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the building, if at least one embodiment of the building has actually been constructed and is located in, or is ordinarily visible from, a public place. [n37] In addition, if a building has actually been constructed, under subsection 120(b) copyright protection will not prevent the owners of the building from making or authorizing alterations to the building, or even destroying it or authorizing its destruction, without the consent of the copyright proprietor (who need not be the owner of the building). [n38]

## § [2][a]-Ideas vs. Expression

One of the key features of the *Baker v. Selden* rationale is the distinction between the ideas contained in a copyrighted work and the particular way in which the work expresses those ideas. In the *Baker* case the particular work involved was a copyrighted book describing a system of accounting. The defendant wrote his own book describing the same type of accounting system, but explained it in his own words. The copyright proprietor brought suit, claiming that the defendant's copying of the accounting system was in itself sufficient to constitute infringement of the copyright.

The Court disagreed. It said that an accounting system is an idea, and ideas as such are not protectible by copyright. The copyright could only be infringed by copying the way in which the copyright proprietor had expressed those ideas. Moreover, since the defendant had expressed the \*14 ideas in his own words, rather than copying the expression from the copyrighted book, there was no infringement. Accordingly, the Court concluded that the defendant could not be enjoined from copying the accounting system, but only from copying the words of the book.

The idea-expression dichotomy is a fundamental principle of copyright law that affects the nature of copyright protection for various kinds of creative works in different ways. So far as copyrighted drawings and models are concerned, the effect of this principle is to withhold copyright protection from the technological ideas [n39] contained in, and the useful articles represented by, such drawings and models; and to limit such protection to the way in which those ideas are expressed in the drawings and models themselves. The only copyright protection which is available for useful buildings as such, therefore, is that which is provided by the Architectural Works Copyright Protection Act of 1990. [n40]

## § [2][b]-Scope of Copyright Protection

The Scope of Protection for Architectural Works Not Covered by The Architectural Works Copyright Protection Act of 1990.

Under the copyright law as it existed before December 1, 1990, the date of adoption of the Architectural Works Copyright Protection Act of 1990, [n41] copyright protection extended to representations of buildings such as architectural plans, drawings and models; [n42] but it did not extend to the building designs themselves, and it still does not extend to any building designs which were created and constructed before that effective date. [n43] Moreover, even as to building designs which were created in the \*15 forms of plans, drawings or models before that date, but were not constructed before that date, copyright protection extends only through the end of the year 2002. [n44]

To the extent that such building designs do not qualify for copyright protection under the amendments to the copyright law which took effect on December 1, 1990, the degree

of copyright protection to which they are entitled is controlled by the copyright law as it existed prior to that date. Although that prior law did not protect the designs of buildings and other useful structures as such, [n45] to a limited extent the protection which the prior law accorded to representations of such buildings and other structures (i.e., plans, drawings and models) sometimes spilled over to the designs of the buildings and structures themselves. Under that prior law, [n46] therefore, the key question in any controversy relating to infringement of copyright in architectural drawings or models is the degree to which the protection of the drawing or model can be extended to the building or other useful structure. [n47] In this area, the decisions are in conflict.

#### § [2][b][i]-Earlier Cases

In *Muller v. Triborough Bridge Auth.*, [n48] the court quoted the following remark from *Baker v. Selden*:

The copyright of a work on mathematical science cannot give to the author an exclusive right to the methods of operation which he propounds, or to the diagrams which he employs to explain them, so as to prevent an engineer from using them whenever occasion requires.... And where the art it teaches \*16 cannot be used without employing the methods and diagrams used to illustrate the book, ... such methods and diagrams are to be considered as necessary incidents to the art, and given therewith to the public ... for the purpose of practical application. [n49]

The court interpreted those words so strictly that it apparently concluded that with respect to architectural works the thrust of *Baker v. Selden* was not only to permit the defendant to build the structure [n50] depicted in the copyrighted architectural plans, but also to use the plans themselves in the process of constructing it. The opinion said: "Even if it were assumed that the defendant used plaintiff's copyrighted drawing in designing and constructing the bridge approach of the Cross Bay Parkway Bridge Highway at Rockaway Beach, plaintiff would be without any remedy." [n51]

The remark was either dictum or, at most, an alternative holding in the *Muller* case, however, since the court also made it clear that it considered the defendant's design to have been independently derived rather than copied from the plaintiff's copyrighted work, [n52] which was sufficient in itself to require a conclusion that there was no infringement and thus lead to the dismissal of the complaint. [n53]

*DeSilva Constr. Corp. v. Herral*d [n54] cited the *Muller* decision and even went a step further. It not only approved *Muller's* statement that it was not a copyright infringement for the defendant to build a three-dimensional structure depicted in the plaintiff's copyrighted architectural \*17 drawings, [n55] but it also stated that it would not have been an infringement for the defendants to copy the plaintiff's copyrighted plans by preparing their own two-dimensional plans and filing them with the local building department. [n56] This is a more difficult proposition to defend, even on the *Baker v. Selden* rationale, because it would leave the defendant free to use the illegally copied

two-dimensional drawings, which even under the Baker v. Selden analysis are infringements, as well as leaving him free to construct the three-dimensional house.

This aspect of the DeSilva case, however, is dictum, because the court had already disposed of the plaintiff's claims on the merits on the ground \*18 that the plaintiff was not the owner of the copyright, [n57] and on the ground that the copyright had been invalidated by a divestive publication, [n58] and also on the ground that the copyrighted drawings had not been copied by the defendants. [n59]

Dictum or not, this aspect of the DeSilva case must be taken seriously, since it has a solid basis in the Baker v. Selden opinion. In the latter case, after making the point that "[t]he copyright of a work on mathematical science cannot give to the author an exclusive right to the methods of operation which he propounds," i.e., to the "mathematical science" itself, the Supreme Court went on to say:

The very object of publishing a book on science or the useful arts is to communicate to the world the useful knowledge which it contains. But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book. And where the art it teaches cannot be used without employing the methods and diagrams used to illustrate the book, ... such methods and diagrams are to be considered as necessary incidents to the art [i.e., to the technology], and given therewith to the public ... for the purpose of practical application. [n60]

This passage in Baker v. Selden suggests that if, in order for the defendant to use uncopyrighted technology described in a copyrighted diagram or drawing, it is also necessary for him to reproduce and use the diagram or drawing itself, then the copyright law will not prevent him from doing so. In the construction field, as a practical matter, it is nearly always necessary to use a set of plans in order to erect a building or other construction project. Thus, the possible implication of Baker v. Selden is that under the pre-1990 law the defendant could nearly always copy the copyrighted plans in order to file them with the local building department and also to use them in the construction of the building depicted therein. The right to copy the plans, as for example by photo-reproduction, seemed to go along with the pre-1990 right to construct the building. [n61]

\*19 In Scholz Homes, Inc. v. Maddox, [n62] however, the Sixth Circuit Court of Appeals took a more thoughtful view of Baker v. Selden. After quoting the above language from the Baker opinion and reviewing Muller and DeSilva, this court proposed a possible distinction between the textbook in Baker, which "had been written for the purpose of instructing others in the art of bookkeeping," and architectural plans, which are not prepared for the purpose of instructing the general public as to how the depicted structure might be built. Rather, they are often prepared so that they may be used in the building of unique structures, or at least structures limited in number. If the Copyright Statute protected merely against the vending of plans instead of against their unauthorized use, it would therefore fail to afford a form of protection architects might strongly desire. This protection would most effectively be provided by holding the unauthorized construction of a building according to a copyrighted plan to be an infringement; if Baker is followed to the extent of holding that the possession of the

copyright in the plans gives no exclusive right to construct the building, then protection could be provided by declaring the making of unauthorized copies of the plans to be an infringement. [n63]

This discussion, however, is also dictum, as the Scholz court went on to say: "We find it unnecessary in the present case either to choose one of the aforementioned alternatives or to reject them both." [n64] The case was disposed of on the ground that there was no copyright infringement because there had been no copying from the copyrighted plans, hence no infringement of the copyright.

An even more difficult question which arose in the Scholz case was similarly avoided. There was evidence that the defendants may have copied their floor plan from the plaintiff's model home, which was open to the public. The plaintiff in such a case could have argued, although it was clear at that time that the model home itself was uncopyrightable because it was a "useful article," that the model home was a copy of the plans, and if the defendant copied the model home then he indirectly \*20 copied the plans as well. The court refused, however, to infer that the defendant's floor plan had been copied from the model home. [n65]

There was also evidence in Scholz that the defendants may have copied their floor plan from a promotional booklet which was given by the plaintiff to the public, and which was itself a copyrighted work. On this issue, however, the court applied a strict interpretation of *Baker v. Selden*. It said:

While the copyrighted plans may not have been intended to place the ... home before the general public, this was the purpose of the booklet [which] was copyrighted to preserve its value as an advertising medium, and not to give Scholz the exclusive right to copy the plans depicted therein. [n66]

What the court apparently meant by that remark is that when a work is addressed to the general public, as were the accounting text in *Baker v. Selden* and the promotional booklet in the Scholz case, then if the work contains any drawings or diagrams or forms or the like, and it is necessary for the public to copy those drawings, etc. in order to use the ideas which the work conveys, then such drawings, etc., must be given to the public, notwithstanding the copyright, because they are incidental to the ideas. Only works which, like an architect's plans, are intended for the private use of the architect, his client, and the client's builder and subcontractors on behalf of the client, are eligible for the liberal interpretation of the *Baker* case which is proposed in the Scholz opinion. [n67]

In *Imperial Homes Corp. v. Lamont*, [n68] the Fifth Circuit Court of Appeals dealt with a very similar situation in which the defendants copied a floor plan from one of the plaintiff's houses and possibly also from a promotional brochure. They argued, citing the Scholz case, that since they had not copied directly from the copyrighted work itself, i.e., the plaintiff's architectural plans, they had not infringed the copyright. The court, however, rejected that defense, saying:

In terms of an architectural drawing, the *Baker v. Selden* rationale would assert that no architect who copyrights his blueprints could thereby acquire a monopoly on the right to

build a house. ... However, nothing in *Baker v. Selden* prevents such a copyright from vesting the law's grant of an exclusive \*21 right to make copies of the copyrighted plans so as to instruct a would-be builder on how to proceed to construct the dwelling pictured.

In *Scholz Homes, Inc. v. Maddox*, supra, the Sixth Circuit decided a case almost identical to the case at bar. ... Based upon its interpretation and application of *Baker v. Selden*, it held that... any copying of the floor plan from the booklet would not constitute an infringement of the booklet or plaintiff's basic copyright on architectural drawings. With deference to our bretheren of the Sixth Circuit, we simply do not read the ambit of statutory copyright protection for such a case so narrowly.

...  
... The exclusive right to copy what is copyrighted belongs to the architect, even though the plans give him no unique claim on any feature of the structure they detail. If it is determined upon remand that the Lamonts copied the floor plan set forth in the promotional booklet distributed by Imperial, then this copying would constitute an infringement of Imperial's copyright privileges.

... [W]e do not hold that the Lamonts were in anywise restricted by the existence of Imperial's copyright from reproducing a substantially identical residential dwelling. All we hold is that if copyrighted architectural drawings of the originator of such plans are imitated or transcribed in whole or in part, infringement occurs.... [n69]

Thus the Imperial case holds that copying the architectural plans indirectly, by copying a secondary document derived therefrom, is an infringement of the copyright on the plans. (And it so held even though the Imperial case differed from the Scholz case in that the promotional booklet in Scholz was a separately copyrighted document, whereas the promotional booklet in Imperial was not.) [n70] It did not, however, reach the analogous issue of whether copying of the floor plan by inspection of a building constructed from the copyrighted plans was also a forbidden type of "secondhand copying."

In *Herman Frankel Org. v. Tegman*, [n71] the Imperial decision was followed by the United States District Court for the Eastern District of Michigan despite a fact situation which was similar to Scholz in that the defendants copied, not from the full set of plans directly, but from a promotional brochure which was distributed to the public, consisting of a copyrighted abridged floor plan derived from the copyrighted full set of architectural plans. The court said:

At the outset we are faced with the principles established in *Baker v. Selden*.... In that case the Court held it was not a violation of the copyright \*22 act to use a system of bookkeeping taught by the copyrighted work. The Court, however, did not hold that copies could be made of the copyrighted book without violating the act.

... A person cannot, by copyrighting plans, prevent the building of a house similar to that taught by the copyrighted plans. One does not gain a monopoly on the ideas expressed in copyrighted material by the act of registering them for copyright. A person should, however, be able to prevent another from copying copyrighted house-plans and using them to build the house. [n72]

Thus the Tegman decision not only said that copying of a copyrighted drawing was an infringement, but it also constituted a clear holding that the *Baker v. Selden* principle did

not extend so far as to permit the defendant to use such infringing copies in constructing an uncopyrightable building. Tegman acknowledged that the Baker v. Selden principle left the defendant free to build a duplicate of the plaintiff's building, since buildings were outside the protection of the copyright law at that time, but Tegman held that the defendant must obtain the plans for the building from some source other than the plaintiff's copyrighted drawings.

Tegman is also in accord with the Imperial decision and contra to the Scholz decision in suggesting that the defendant may not escape liability for infringement of the plaintiff's architectural drawings simply because he copied those drawings indirectly, from a brochure derived from those drawings.

The Tegman opinion is also in accord with the holding in the Imperial case that copying only a part of the copyrighted architectural work, i.e., only the floor plan from a full set of architectural drawings, is nevertheless an infringement.

Tegman is only dictum on these last two points, however, since the brochure in that case, from which the direct copying actually took place, was independently copyrighted. Therefore it was not essential to that decision to relate the brochure to the full set of architectural plans to establish the infringement of a copyright. Nor was it important that the floor plan was only a part of the full set of plans, since it was the whole of another, separate copyrighted work, the brochure.

The existence of the derived floor plan drawings as the "middleman" in the chain of copying in the Tegman case is nevertheless of considerable importance. Because the direct copying in Tegman was of a brochure intended to convey information to the public, and only indirectly of a set of plans intended solely for the private use of the architect, his client and their builder and subcontractors in constructing the building, just as in the Scholz case, it follows that the Tegman decision is directly \*23 contra to the Scholz holding that a work which is designed to convey ideas to the general public, and which contains any drawings or diagrams or forms or the like which are necessary for the public to copy in order to use the ideas, must be given to the public.

This observation becomes particularly significant when it is noted that the Tegman court, the U.S. District Court for the Eastern District of Michigan, is within the Sixth Circuit, and it is the Sixth Circuit Court of Appeals which had earlier decided the Scholz case. Thus, although the Tegman case is only a lower court decision, it nevertheless has some tendency to impeach the continued validity of this particular aspect of the Scholz decision even in the Sixth Circuit. The Scholz decision was cited in the Tegman opinion, but was correctly distinguished on the ground that the basis of the Scholz holding was noninfringement, making the Scholz court's comments on the indirect copying issue merely dicta. [n73]

What conclusions, firm or tentative, can be drawn from these earlier cases? One thing that appears clear from all the cases from *Baker v. Selden* through *Tegman*, is that one who constructs a building or other useful structure without resort to the copyrighted plans of another, or to any document derived therefrom, will not have anything to fear from the pre-1990 copyright law even though someone may have a copyright on a set of architectural plans and/or floor plan drawings for an identical building. (He might, however, need to worry about patent coverage, or about trade identity law, or about trade secret law.) At the other extreme of the spectrum of possibly infringing acts, it seems equally clear that, even under the pre-1990 copyright law, one who copies the copyrighted architectural plans of another for some purpose other than building a useful structure, e.g., for the purpose of selling such plans, is infringing. [n74]

Then there are the intermediate fact situations. There seems to be a clear line of development from the early strict interpretation of *Baker v. Selden* in the *Muller* and *DeSilva* cases (suggesting that not only was the construction of a building not a copyright infringement before the 1990 change in the copyright law, but that the infringer could also copy the copyrighted drawings in order to help him accomplish the task) to the more liberal approach of the *Scholz*, *Imperial*, and *Tegman* cases \*24 (which lead this author to conclude that copying of such drawings is an infringement for any purpose, including even the construction of an uncopyrighted building). Most recently, moreover, there has been another decision, *Demetriades v. Kaufmann*, [n75] which clearly holds that unauthorized copying of copyrighted architectural drawings for the purpose of constructing an uncopyrighted building is copyright infringement. [n76]

The next question is: what constitutes copying? The *Scholz* case to the contrary notwithstanding, it now appears likely that copying from an intermediate drawing which in turn was derived from copyrighted plans qualifies as copying of the original plans, and that the existence of such an intermediate copying step does not insulate the defendant from liability, even if the intermediate drawing is not separately copyrighted, and even if the intermediate drawing is distributed to the public to inform them of the floor plan of the plaintiff's building, instead of being limited to the private use of the architect and those in privity with him in the construction of a building. Moreover, after the *Tegman* decision, this is probably true even in the Sixth Circuit.

The toughest question to answer, regarding the state of the law as it existed immediately prior to December 1, 1990, is whether infringement occurred when the intermediate "copy" from which the defendant directly derived his information was not a document at all, but the plaintiff's building. In other words, was it an infringement to copy a floor plan by measuring the dimensions of an uncopyrighted building which was built from copyrighted plans?

It can be argued with some force that it should not matter what precise form of intermediate vehicle is used by the defendant to derive information, provided the information ultimately came from the copyrighted plans of the plaintiff. Whether that intermediate vehicle is a two-dimensional document or a three-dimensional structure, the defendant \*25 is still appropriating the work-product of the defendant, and the relative

equities of the parties are therefore the same. This may simply be a logical extension of the rationale of the Tegman case with regard to "secondhand" copying.

Under the Copyright Act as it existed prior to March 1, 1989, however, there was one difference between a document and a building, which may be critical for copyright purposes. An intermediate document which was an authorized copy of a copyrighted document was required to have a copyright notice thereon for the purpose of apprising others of the fact that they would be subject to liability for copying. A building, however, prior to December, 1990 was not a copyrightable work, and therefore was not thought to require a copyright notice. [n77] Therefore, there was some potential for trapping the innocent. This issue is best explored in connection with the subject of copyright notice in the context of the discussion of divestive publication in § [3][b], *infra*.

Finally, under the pre-1990 law there was the question of whether a defendant's building itself was an infringing copy if it was made from plans obtained in violation of the copyright law. The clearest, as well as the most recent, light on this subject was shed by *Demetriades v. Kaufmann*. [n78] There, defendant home builders, acting at the request of defendant home purchasers who wanted a copy of a home built by the plaintiffs, made a tracing of the plaintiffs' copyrighted architectural plans, which they obtained improperly. By the time plaintiffs found out about the infringement and brought a motion for a preliminary injunction, the defendants had partially completed a structure built by means of the illegally copied plans. In ruling on the plaintiffs' motion, the court had no hesitation in enjoining further unauthorized copying of the plaintiffs' plans, as well as any further reliance on the infringing copies previously made. In addition, it also ordered impoundment of all such copies within the defendants' control. But the court denied the plaintiffs' request to enjoin further construction even if done with new plans not traced from the plaintiffs' copyrighted work.

The court acknowledged that the plaintiffs' position found support in the following rhetorical question posed by Professor Nimmer: "But are \*26 there some works which by their very nature may be copied only for purposes of use and not for purposes of explanation, so that to deny liability by reason of copying is in effect even if not in theory to deny copyrightability to the work?" [n79]

But the court took issue with Professor Nimmer's remark, reasoning that because the plaintiffs were entitled to an injunction against the making and using of copies in the form of two-dimensional drawings, as well as money damages for the value of their plans, they were not being denied relief entirely. In a footnote, the court even predicted that damages in the case would be substantial: in the \$40,000 to \$50,000 range. The court therefore reasoned that to permit construction of the building in that case was not equivalent to a complete denial of copyright protection on the architectural plans.

Based on that reasoning, the court ruled:

We do not enjoin construction of the Kaufmann house based on alleged infringement of the [plaintiffs'] architectural plans. Whether or not the construction originally "flowed

from" infringing copies of [plaintiffs'] plans, as plaintiffs' counsel urged at oral argument, is immaterial. Construction of a building imitating that depicted in copyrighted architectural plans does not, consistent with Baker [v. Selden], constitute infringement of those plans. Although individuals are not free to make unauthorized copies of copyrighted architectural plans, they remain free to duplicate houses depicted in those plans unless and until the designs embodied in such plans are secured by patent.

In another footnote, the court observed that its holding would merely delay completion of defendants' house: "Of course, the effect of our ruling may be to shut down construction for a certain period of time, at least until new plans can be drawn up and submitted to the Scarsdale Architectural Review Board for consideration." Thus the court impliedly made it clear that it would permit the defendants not only to use the portion of the house which had already been built at the time of the preliminary injunction hearing, but also to complete the house by means of a set of plans not copied from the plaintiffs' copyrighted work. Moreover, in a subsequent opinion in the Demetriades case, [n80] the court expressly ruled that if the defendants prepared a new set of plans by "actual measurements, inspections, and photographs of the partially constructed Kaufmann house ..." it would not be copyright infringement.

The apparent implication of the Demetriades case is that the defendants' uncopyrighted building itself was not an infringing copy, even though it was made from plans obtained in violation of the copyright \*27 law. No other theory of law can explain the court's willingness to allow the defendants to keep the existing portion of the building and to add to it in the course of further construction. [n81] But this author has difficulty subscribing to the Demetriades view.

Certainly, as a minimum, the principles of Baker v. Selden as they existed prior to the statutory amendment of 1990 required the court to allow the defendants to build a building just like the plaintiffs' uncopyrighted building if they could somehow obtain a set of plans for such a building without copying the plaintiffs' copyrighted plans. And this probably implied that the defendants must be permitted to base their own plans upon observation, or even careful inspection, or even measurement, of the plaintiffs' uncopyrighted building (if they could gain legal access thereto), even though the plaintiffs' building was derived from the copyrighted plans. It may even have been permissible for the defendants to view the plaintiffs' copyrighted plans where they are legally available for public inspection at the local municipal building department, and to derive therefrom uncopyrightable general architectural ideas (e.g., overall floor plan and general external appearance of the building), so long as the plaintiffs' detailed expression of those ideas (e.g., specific dimensions and specifications) was not copied. And in this context, memorization could be a form of copying as well as tracing or photocopying.

But this author considers it unclear that even under pre-1990 law Baker v. Selden permitted a defendant to construct or complete a building under the circumstances of the Demetriades case. [n82] There, the defendants' tracing of the copyrighted plans certainly resulted in copying of the plaintiffs' detailed architectural expression. But in addition, since the partially completed house which the defendants constructed \*28 from those

plans was, in some sense, "copied" therefrom, the incomplete building itself also partook of the protected expression. It was in effect a three-dimensional, second-generation derivative, if not an infringing "copy" in the copyright sense.

Furthermore, any subsequent set of plans which the defendants might prepare after the preliminary injunction was handed down would also be indirectly derived from the protected original. And this would be true even if the defendants had the new plans prepared by an architect who had never seen the plaintiffs' copyrighted plans in the original version.

The reason for this is that any set of new plans which would dovetail well enough with the already completed portion of the defendants' house to permit a smooth continuation of construction, would have to somehow be copied from the unfinished house itself to such an extent that those new plans would then be a two-dimensional, third-generation derivative of the plaintiffs' original plans, incorporating much of the same protected expression, i.e., dimensions and specifications. Otherwise the post-injunction portion of the building would not match the pre-injunction portion, either structurally or aesthetically.

Accordingly, it may be that in the Demetriades type of situation the best way to fulfill the protection offered by the pre-1990 copyright law, within the limits imposed by *Baker v. Selden*, would be to require the defendants to tear down what they had built illegally, and start over again with a new set of architectural plans, specifically a set of plans resembling the plaintiffs' protected work only to the extent of borrowing its general architectural ideas and not its specific dimensions and specifications. It is not at all clear that *Baker v. Selden* permits the copying of protected expression merely because such copying is spread over one or more intermediate generations, or because one or more of those generations is in three-dimensional form.

Stated another way, it is clear that the Demetriades court would have entirely enjoined even the initial stage of construction using the illegally copied plans, if the plaintiffs had been able to bring the matter to the attention of the court before construction began. Why, then, should the defendants have gotten the economic benefit of their tortious conduct merely because they were able to construct a portion of the building before the plaintiffs and the court could act?

Of course, if the plaintiffs knowingly slept on their rights during the initial period of construction, then a defense of laches [n83] might be in order.

\*29 And in some instances the court might refuse an injunction, [n84] not as a matter of substantive limits imposed upon copyright law by the principles of *Baker v. Selden*, but as a matter of the court's inherent equitable discretion to deny or limit injunctive relief. Such an exercise of discretion might be predicated on the ground that the harm resulting to the defendant from requiring it to tear down a partially completed building would exceed any corresponding benefit to the plaintiff.

This equitable approach would be especially appropriate where the court wished to avoid tearing down a large number of tract homes all built from the same infringing plans. It would also be particularly appropriate where the only active infringers are the builder and/or the architect, the purchaser of the accused building being innocent of any complicity in the infringement.

Even in the Demetriades case, where only one building was involved, and where the purchasers were the instigators of the illegal copying, it might well have been appropriate to refuse destruction of the building had the court made it clear that destruction was being denied as a matter of equitable discretion in fashioning relief, and not because the initial phase of construction of the building from infringing plans was not tortious in principle. This seems to be a better rationale for the result in Demetriades than authorizing defendants to use the fruits of their infringement whenever they can be harvested before the wheels of justice begin to roll.

#### The Scope of Protection in Works Covered by the Architectural Works Copyright Protection Act of 1990.

"Copyrights in Works of Architecture, a Report of the U.S. Register of Copyrights on Works of Architecture," [n85] was commissioned by the United States Congress at the time that the federal copyright statute was amended in view of this country's 1989 entry into the Berne Convention, an international copyright treaty. Article 2(1) of the treaty requires the member nations to extend some form of copyright protection to three-dimensional architectural works, and the Report of the Register of Copyrights concluded that the degree of copyright protection required by the treaty for such works goes beyond that which was available under United States copyright law prior to 1990. The amendments to the copyright statute which Congress enacted at that time did not deal with the issue of protection of full-sized three-dimensional architectural \*30 works, however. Accordingly, the Register's report recommended that Congress reconsider this issue in the future.

Pursuant to the recommendation of the Register of Copyrights, [n86] the Architectural Works Copyright Protection Act of 1990 [n87] has now been enacted. Under that act copyright protection is extended to the designs of full-size buildings, notwithstanding their utilitarian nature. The aspects of a building design which are protected under this act seem to include its overall shape and external decoration (i.e., the building's \*31 exterior appearance), the arrangement of interior spaces (i.e., the floor plan), and any other interior and exterior architectural features which have a visual esthetic impact. But these aspects will be protected only to the extent that they are original, and not "standard" in the industry. [n88]

#### § [3]-Acquisition and Divestiture of Copyright

## § [3][a]- The Applicable Law

Until now we have been speaking as though it were not important to determine the source of the copyright law being applied in the various cases discussed herein. So far as the issues of copyrightable subject matter and the scope of copyright protection are concerned, that is substantially true, since state copyright law (while it existed) and federal copyright law were very similar in these areas. This is also true to a considerable extent where infringement is concerned. [n89]

However, when it comes to the issues of acquisition, divestiture, ownership [n90] and duration [n91] of copyright, it is usually essential to understand whether the copyright law which is applicable in a particular case is that which exists at the present time or that which existed prior to January 1, 1978, the effective date of the current federal copyright statute; and if the latter, then it is also necessary to specify whether it is state or federal copyright law which applies.

Copyright law underwent a major change when the federal Copyright Act of 1976 [n92] went into effect on January 1, 1978. Before that time a bifurcated system of copyright law existed in the United States. Under that system, prior to publication of a copyrightable work state copyright law applied unless the copyright proprietor elected to register the work in the United States Copyright Office as an unpublished work. [n93] The applicable state law was usually referred to as "common law copyright," although sometimes it was codified by state statute. Under the 1976 Act, however, the entire subject of copyright is governed by federal statute, [n94] except for certain categories of works which are not relevant to the construction field. [n95]

### \*32 § [3][a][i]-Pre-1978 Law [n96]

#### State Law

Before the federal Copyright Act of 1976 took effect at the beginning of 1978, the states had adopted the doctrine of common law copyright, which gave the author of any unpublished work the right to prevent publication or use of the work without his permission. The remedies included injunction and damages. Common law copyright, however, was lost upon the occurrence of a divestive publication of the work, at which point one of two things happened to the work: either it became the subject of a federal statutory copyright, [n97] or it fell into the public domain, i.e., became available for anyone to copy and use without permission and without liability.

#### Federal Law

Federal statutory copyright was acquired by simply taking the precaution of making sure that upon publication of the work all copies had one of the statutorily prescribed notices

of copyright in one of the statutorily prescribed places on the page immediately following the title page. After publication with such notice, the copyright proprietor could register the copyright with the Copyright Office, but failure to do so did not invalidate the copyright.

## Publication

What could invalidate the copyright, and actually did so in numerous cases under the old law, was a divestive publication without the prescribed notice in the prescribed place on all published copies of the work.

### Limited (Nondivestive) Publication [n98]

The courts have distinguished between two kinds of "publication" for the purposes of determining whether such a divestiture of common law copyright took place under the old law. A so-called "limited publication" was held to have occurred where the copyright proprietor gave copies of the work to a limited number of people for a limited purpose. Such a limited publication did not cause a divestiture of common law copyright. Therefore, it did not matter if the technical federal statutory copyright notice requirements were not met, because protection under state law survived.

### \*33 General (Divestive) Publication [n99]

However, when copies of the work were distributed to an unrestricted number of people without any restrictions as to the purpose for which such copies could be used by those people, then that was termed a "general publication," and under the old law it resulted in the irrevocable loss of state law protection. Unless the federal notice requirements had been met at the time of publication, therefore, the work was dedicated to the public.

### § [3][a][ii]-Present Law [n100]

The federal Copyright Act of 1976 [n101] has expressly preempted state copyright law, in all its common law and statutory forms, with respect to any work which exists in documentary or other tangible form. [n102] Under current law, federal statutory copyright vests from the time of the creation of the work [n103] and exists even during the time that the work remains unpublished, unless the term of copyright expires before it is published. [n104]

## Unpublished Works

Thus, federal statutory copyright now substitutes for the protection which state "common law copyright" formerly conferred upon unpublished works; and no copyright notice is or was ever required to obtain, or preserve the validity of, the federal statutory copyright in an unpublished work. [n105] Nor is registration of an unpublished work in the \*34 Copyright Office required. Consequently, the net result, so far as such unpublished works are concerned, is little or no change in the substantive effect of copyright protection, but such copyright protection is now a federal question for jurisdictional purposes.

## Published Works

Under the federal copyright statute as it existed prior to March 1, 1989, federal copyright could be lost if the proper notice [n106] were not included on all published copies of the copyrighted work. [n107] Even though the law has now been changed in this respect, [n108] the prior law still governs all publications which occurred prior to that date. In addition, it seems clear that as of this writing most of the copyrighted architectural plans which have been distributed (and thus may have been the subject of a "general publication") underwent such distribution prior to that critical date. Thus, as to the great majority of architectural drawings presently in existence, the pre-March 1, 1989 law governs the question of divestive publication.

Under the amended law as it has existed since March 1, 1989, however, copyright notice is now entirely optional; but a significant procedural \*35 advantage still accrues to those who publish with proper copyright notice. [n109]

Under both the former and current versions of the copyright law, therefore, there are still consequences which attend the general publication of a set of copyrighted plans which lacks a proper copyright notice. Accordingly, it is still sometimes important to know whether distribution of architectural plans constitutes a limited, and therefore non-divestive, publication, or a general, and therefore divestive, publication. [n110]

## § [3][b]-Divestive Publication

### § [3][b][i]-What Law Applies

Under pre-1978 law, it was up to each state to determine the circumstances under which it would extend copyright protection to a work. Thus, a state could decide that as a matter of state law it considered \*36 a particular work to have been published, with the result that it would no longer extend state copyright protection to that work. Consequently, many of the decisions relating to divestive publication appear to apply state law.

Even under pre-1978 law, however, the federal copyright act determined the circumstances under which the right to federal statutory copyright had been lost by publication. Therefore some of the earlier decisions apply federal law. Under the law which existed between January 1, 1978 and March 1, 1989, moreover, the question of when a divestive publication occurred is entirely one of interpretation of the federal copyright statute, since under the 1976 federal copyright act which went into effect on January 1, 1978 copyright protection is entirely governed by federal law whether a work is published or unpublished. Accordingly, the only decisions which are controlling at this point are those which apply federal law.

Nevertheless, the earlier decisions applying state law to the question of divestive publication are relevant, not because they are controlling under present law, but because they may be persuasive. Therefore, in order to explore this issue we will examine the cases which arose both before and since the effective date of the 1976 Copyright Act, and which have been decided by both state and federal courts applying both state and federal law.

### § [3][b][ii]-Acts Which Can Result in a Divestive Publication

The problem of divestive publication comes about because of the environment in which architects must operate. To begin with, an architect must normally show or deliver a set of plans to the client for whom a building is to be constructed. Then, in order to construct the building, it is necessary to put copies of the plans in the hands of not only the general contractor and subcontractors who are actually hired to do the construction, but also those who bid unsuccessfully for the job. It is also usually necessary to file a copy of the plans with the local building department to demonstrate compliance with the building code. Finally, builders often invite the public to inspect their buildings or even the plans themselves, or they publish various advertisements and brochures, as a means of promoting their wares. All of these acts, and even the very act of constructing a building itself, have the potential of being held a publication which invalidates the copyright in the plans.

### Cases Finding a Divestive Publication.

Thus, there are cases holding or suggesting that the mere construction of a building having external architectural features which are \*37 visible to passers-by divests any copyright in drawings depicting that feature; [n111] and even that the mere construction of a building is a divestive publication of the entire contents of the plans relating thereto although the public is not invited in. [n112] Other cases, however, have reached a comparable result only where large numbers of people have been admitted to the building for advertising or promotional purposes and no restrictions have been placed on the taking of measurements by the invitees, [n113] and/or where large numbers of such buildings have been constructed. [n114]

There are also cases holding or suggesting that the filing of architectural plans with a local government body is a divesting publication unless the plans have a copyright notice. [n115] In one of these cases the court supported its opinion with the following reasoning:

[T]he proprietor of the set of the copyrighted plans can protect himself by inserting the required copyright notice on the plans prior to filing said set of plans with the building department. It is no hardship to require architects to comply with the notice requirements of the copyright statute, and there is no excuse for the failure to have a copyright notice on said plans. Public policy further supports this view because the copyright notice serves as a warning to the public that the plans are protected by copyright, and such notice prevents innocent persons from being guilty of copying .... [n116]

\*38 Whether that reasoning is right or wrong, it can do no harm [n117] for the owners of architectural plans to heed it by putting a copyright notice on the plans before filing them with the local authorities, even if they do not concede that such filing constitutes a publication.

Some cases hold or suggest that it is a divestive publication to distribute copies of the plans to bidders, contractors and/or subcontractors. [n118] There are also cases which find a divestive publication in the distribution of some extract of the architectural plans in an advertising or promotional publication of some kind. [n119] Finally, it can cause problems if the copyright proprietor exhibits the plans themselves to the public. [n120]

\*39 Cases Refusing To Find a Divestive Publication.

On the other hand, there are also numerous cases refusing to find a divestive publication on facts very similar to those referred to above. Thus it has been held or suggested that the filing of architectural plans with local officials is a limited distribution for a limited purpose, done only to comply with local ordinances, and therefore is not a divestive publication. [n121]

It has also been held or suggested that the construction of a building is not a publication of all the details contained in the architectural plans for that building, [n122] nor is permitting visitors to inspect a building a divestive publication of the plans. [n123]

Some cases have also held or suggested that copyright is not divested by distribution of copies of the plans to contractors or subcontractors \*40 for bidding or construction purposes, [n124] and some have held that the distribution of documents containing extracts from the plans is not a divestive publication. [n125]

In addition, it has been held that the burden of showing that there has been a divestive publication falls on the party who is attacking the validity of the copyright. [n126]

Conclusion. It does not seem possible to extract any synthesis of the pre- 1989 law, or an emerging trend, or even to discern a majority rule from this profusion of contrasting decisions.

### § [3][c]-Post-Berne Publications

In view of the changes [n127] effected by the Berne Convention Implementation Act of 1988, [n128] however, the question of publication without copyright notice discussed in this section is now relevant only to works published before March 1, 1989, except for one limited purpose. As to works published on or after that date, the absence of notice does not affect the validity of copyright at all. [n129] It only affects the amount of actual or statutory damages which can be awarded for infringement of such works, [n130] and only in one specific situation:

\*41 A copyright notice is necessary on a work published after March 1, 1989 only in order to preclude the assertion of an "innocent user" defense in mitigation of actual or statutory damages, other than an award of statutory damages in situations involving a reasonable (but unsuccessful) assertion of the "fair use" defense by certain designated non-profit institutions or their employees or agents. [n131]

In view of the uncertainty as to when a copyright notice is required, [n132] preclusion of the innocent user defense can best be assured by the simple expedient of assuming that every distribution of copies or derivative publications, no matter to whom, is a general publication, and therefore putting a statutorily acceptable copyright notice [n133] on each such copy distributed. If that is done, then there may or may not be a general publication, but there will be no loss of the right to preclude the innocent user defense. [n134]

### § [4]-Ownership of Copyright

The legislative history of the Architectural Works Copyright Protection Act [n135] indicates that: "The general provisions of the Copyright Act governing ownership and transfer of copyrighted works shall apply equally to architectural works." [n136]

Copyright vests initially in the author of a work, and if there are joint authors it vests in them jointly. [n137]

#### § [4][a]-Joint Authorship

In some instances controversy has arisen because an architect's client, after having suggested some of the aspects of the architectural design executed by the architect for that client, has claimed that his own contribution made him a joint author, and therefore a joint owner of the \*42 copyright, with the architect. [n138] In the past the copyrights involved in such cases have related to architectural plans, but it seems clear that under the 1990 amendment to the copyright act [n139] the same sort of controversy can now arise concerning copyrights on the designs of buildings.

In *Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co.* [n140] the client "contributed ideas, directed certain changes be made, and exercised approval power at the completion of each stage of development of the plans." Yet the court did not consider these contributions to amount to joint authorship. It said:

Such involvement by a client in the preparation of architectural plans is normally expected. ... Such involvement, however, does not ordinarily render the client an "author" of the architectural plans. In this case [the client] directed that certain architectural features be incorporated into the architectural plans, but the [architect] controlled how those ideas were incorporated.

As to one particular feature of the design, the attachment of balconies to an exterior wall of an apartment building, the client had drawn sketches illustrating the bolt attachment, and the architect's employees went out to inspect apartment buildings previously constructed by the client. Nevertheless, because the architect and his employees had actually prepared the final design drawings, the court ruled that the client was not a joint author even as to that feature.

Moreover, said the court, even if it could be said that the client made an authorship contribution with respect to that particular feature, its relationship to the design as a whole was de minimis and therefore the client was not entitled to joint ownership of the copyright in the plans.

The *Aitken* case, *supra*, was followed in this respect by *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, [n141] where the court said:

[The client builder] reviewed the drawings in progress, made suggestions and corrections, and had final approval authority over the work of [the outside architectural draftsman firm].

...

\*43 The situation of [joint authorship leading to] co-ownership is not presented by the facts of this case. [The client builder]'s contribution to the final drawings produced by [the outside architectural draftsman firm] was a thumbnail sketch of the floor plan he desired for the [house] and approval authority thereafter. ... There is no evidence that it was the intent of either [the client builder] or [the outside architectural draftsman firm] that this concept (the sketch) become part of the finished expression (the architectural plans and drawings). In fact, the sketch did not form an 'inseparable or interdependent' part of the final house drawings.

It is clear that [the client builder] was not a 'creator' of the copyrighted work at issue here. His ideas, conveyed to the author of the copyrighted work, [the outside architectural draftsman firm], were not copyrightable.... [n142]

The *Aitken* and *M.G.B.* cases, however, should be compared to *Cardinal Indus., Inc. v. Anderson Parrish Assocs., Inc.*, [n143] where one Meyer, a sales manager for Cardinal Industries, a manufacturer of modular housing, urged King and Patterson, officials of a university, to adopt, for the university's housing project, designs embodied in the modular housing manufacturer's copyrighted architectural plans. After the university adopted plans which had some similarities to the Cardinal designs, but did not purchase Cardinal's

manufactured housing modules, Cardinal sued the university's architects for infringement of Cardinal's copyrighted architectural plans. But the court found that the plan adopted by the university was "a product of the joint efforts of King, Patterson and Meyer , ... a product of the same consultations between King, Patterson and Meyer and is therefore not owned by Cardinal the modular housing manufacturer and not properly copyrightable to it ." [n144]

Joint authorship affects the duration of copyright. [n145]

#### § [4][b]-Work for Hire

Normally the "author" of a copyrighted work is the particular individual who personally created it. In the case of a work made for hire, \*44 however, the employer or other person for whom the work was prepared is considered the author, and thus the copyright vests in that person initially and without the need for an assignment, unless otherwise agreed by the parties in a signed writing. [n146] It should be noted that the duration of a copyright in a work for hire is computed differently from the duration of copyrights in other works. [n147]

"Work for hire," however, is very narrowly defined in the Copyright Act. [n148] One situation in which the work-for-hire doctrine always applies is the preparation of a copyrighted work by an employee within the scope of the employment. [n149] Thus, when an individual architect is employed by an architecture firm, or as an in-house employee of a "client," the copyright on the employee's work product done in the scope of the employment should belong to the employer firm or the employer client.

Only a few cases are known to have specifically considered the question of whether an independent architecture firm was an independent contractor or an employee of its client for the purposes of determining authorship of an architectural work.

One such case [n150] ruled that the independent architecture firm was not an employee, and therefore its plans were not a work for hire, and so the copyright therein belonged to the firm and not to the client. The court suggested two tests for determining whether there is an employment as opposed to an independent contractor relationship, but under the facts of that case it did not have to decide, nor did it even discuss, the question of whether these two tests are alternative or cumulative.

The first test was the control test: the client or employer always determines the ultimate objective of an architectural project, of course; but who has "the right to control and direct the detail and means by which \*45 that result was accomplished"? [n151] The court decided that the independent architecture firm was an independent contractor according to the control test, because "it was the plaintiff's obligation, as a professional architectural and engineering firm, to use its independent professional knowledge and experience in designing the architectural plans in question." [n152]

The second test was the relationship test: who "furnished the employees, drawing tools, and place to work"? Was the architect "continuously or exclusively engaged by" the one employer, or "engaged simultaneously by many clients according to time priorities"? Who had "control over when the plaintiff worked on its commissioned project or the means utilized when such work was performed"? [n153] Once again, the court decided that the independent architecture firm was an independent contractor according to the relationship test.

On the facts of that case, both tests gave the same answer. But which test prevails if they give different answers? The trouble with the control test is that it fails to distinguish between employed architects and independent architects. Both have an "obligation, as a professional architect ... to use [their] independent professional knowledge and experience in designing ... architectural plans" and consequently both have "the right to control and direct the detail and means by which [the \*46 desired] result [is] accomplished." It would be unthinkable for an employed professional architect, any more than an in-house lawyer, to allow such matters to be dictated by his employer if the employer's instructions were in conflict with professional standards of quality or ethics.

Therefore it appears that the real test is the relationship test. Under the control test an employed architect retains the right "to control and direct the detail and means by which [the desired architectural] result [is] accomplished," and thereby lives up to his "obligation, as a professional architect ... to use [his] independent professional knowledge and experience in designing ... architectural plans." Under the relationship test, however, he does not furnish his "own employees, drawing tools [apart perhaps from minor personal items], and place to work," and he is "continuously or exclusively engaged by" his employer rather than "simultaneously by many clients." Accordingly, he does not "schedule work on projects ... according to time priorities" as between competing projects of different clients, but only as between competing projects of his employer, and he has relatively little "control over when [he] work[s] on such projects or the means utilized when such work [is] performed."

This is precisely the result which was reached in *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, [n154] where the court said:

Although [the client builder] exercised control and direction over the finished product that [the outside architectural drafting firm] produced, all the other circumstances militate against finding the drawings [architectural renderings] were done as a work for hire. [The outside architectural drafting firm] provided skilled drafting services. It provided its own office space, tools and supplies. [The outside architectural drafting firm] was retained for a comparatively short period of time—a few weeks. [The client builder] did not have the ability to assign new projects to [the outside architectural drafting firm] during that time (other than by entering a new contract). [The outside architectural drafting firm] was free to determine the days and hours on which its employees worked. [The outside architectural drafting firm] had total discretion in hiring and firing its own employees without interference by [the client builder]. [The outside architectural drafting firm] paid its own taxes and withholding for its employees. Drafting was not a part of the regular business of [the client builder] which always used an outside drafting firm. In

short, [the outside architectural drafting firm] was an independent contractor, not an employee.

The above-quoted passage is the first known judicial application to the relationship of client and architect of the U.S. Supreme Court's controlling opinion in *Community for Creative Non-Violence v. Reid*, [n155] \*47 which ruled that the employee work-for-hire provision of the copyright act applies only to those who qualify as employees under the traditional common-law agency test, and not to those who are independent contractors under that test.

The *Creative Non-Violence* case itself involved sculpture rather than architectural subject matter, but it seems logical that the same principle which applies to sculptors also applies to architects and architectural draftsmen.

The *Creative Non-Violence* case also related to an individual rather than a firm or corporation which was retained to create a copyrightable work. Accordingly, *Creative Non-Violence* makes it clear that ownership of the copyright in the work of an architect who is employed or retained directly by the client should be judged by the relationship test rather than the control test, just as in the case of an architect who is employed by an architecture firm to work on projects of the firm's clients.

Under this test, the copyrightable work product of either type of individual architect will be a work for hire under the Copyright Act of 1976, and therefore will be the property of the client or the architecture firm, if and only if the latter has an "employment" relationship with the individual architect in the traditional sense of that word. If an individual who has an independent contractor relationship is not an "employee" in that sense, as held by the *Creative Non-Violence* case, then a fortiori neither is an architecture firm or corporation which has an independent contractor relationship.

It is possible for the work-for-hire doctrine to apply to independent contractors if they create certain kinds of specially ordered or commissioned copyrighted works, but the narrowly circumscribed list of the types of works which are eligible for such treatment under the statute [n156] clearly excludes architectural works. [n157] Therefore, an independent contractor \*48 architect or architecture firm will always be considered the author of his or its architectural works, and consequently copyright will vest initially in him or it.

#### § [4][c]-Assignment

An independent contractor architect or architecture firm is free, however, to assign or license the copyright which it owns in any architectural work. [n158] Unlike the work-for-hire doctrine, an assignment does not affect the duration of copyright. [n159]

A transfer of copyright ownership is not valid unless in writing and signed by the copyright proprietor or his authorized agent. [n160] An assignment may be recorded in

the Copyright Office, and will constitute constructive notice of the assignment if the copyright is adequately identified and is registered. [n161]

It has been held that there was no assignment of an architect's copyright in architectural plans where, in order to obtain financing for a construction project, the owner of the building was required by the mortgagee bank to execute an assignment to the bank of the copyright in the architect's plans, and the architect was required to execute a consent to that assignment. [n162]

The court in that case reasoned that the assignment conveyed only such interest in the plans as the building owner might have had, and that similarly the architect's consent operated only to the extent of approving an assignment of such an interest. Since the building owner \*49 had no interest at all in the copyright, said the court, no interest whatever passed from the architect to the bank by virtue of either the building owner's assignment or the architect's consent.

The end result in that case was that the court concluded that the architect still had sufficient ownership interest in the copyright to sue an infringer. The decision is clearly correct insofar as it holds that the architect retained his standing to sue. In view of the evident purpose of the transaction, the bank got, at most, a mere security interest in the copyright and not full equitable title. It would be naive in some other context, however, to take literally the court's flat assertion that the bank got no rights at all.

If we imagine a situation in which the building owner had defaulted on the bank's loan while construction was still in progress, and instead of standing to sue for infringement the issue was whether the bank could recoup its loss by taking over the realty and finishing the building according to the architect's plans, then the architect's consent might well have been regarded as a form of guarantee of the loan. The court might have concluded that the consent operated to give the bank an implied license under the copyright to use the plans for the limited purpose of completing only that one building, subject to the bank's paying the architect any balance of the fee which he had been promised.

This arrangement would satisfy any legitimate expectations which the bank might have, and fulfill any representations which the architect might be said to have made to induce the bank to make the loan, while at the same time completing the obligations the architect and the building owner had undertaken to each other, except for the fact that the bank would be substituted for the building owner as one of the contracting parties.

#### § [4][d]-The AIA Agreement

In view of what was said in the preceding section about assignments, it is clear that an architect may agree to assign his copyright to the client. The usual custom, however, is for the architect to retain such rights. Article 6 of B141 (1987), "Standard Form of Agreement Between Owner and Architect," developed by the American Institute of

Architects, provides that the drawings and specifications shall remain the property of the architect, although the owner is permitted to retain copies for information and reference in connection with the owner's use and occupancy of the building. The agreement provides that these documents, however, shall not be used by the owner on other projects, for additions to the current project, or for completion of the current project unless the architect is in default.

\*50 These provisions are consistent with the section of the Copyright Act [n163] which distinguishes between ownership of a copyright (which is what the architect retains under the AIA agreement), and ownership of a material object, i.e., a particular copy of the plans, which is all that the client is entitled to under that agreement. The copyright includes the right to reproduce and use the drawings, while ownership of a particular copy includes only the right to use that particular copy for its intended purpose.

The aforementioned article of the AIA agreement also contains a provision negating any intent to make a divesting publication when the drawings are filed with the authorities in order to meet regulatory requirements. [n164]

Now that copyright is no longer limited to drawings and models, but covers building designs as well, [n165] it would be desirable for the AIA Agreement to provide expressly that copyright on the building design also shall remain the property of the architect, subject to the right of use and occupancy by the building owner, and of course subject also to the building owner's statutory right to alter or destroy the building. [n166]

#### § [5]-Duration of Copyright

Except as noted below, the copyright in any work (other than a work for hire) created no earlier than January 1, 1978, endures for the life of the author plus fifty years thereafter, [n167] and in the case of a work having joint authors the term is measured by the life of the last surviving author. [n168] In the case of a work for hire, the duration is seventy-five years from the year of first publication or 100 years from the year of creation of the work, whichever is shorter. [n169]

As to works created before January 1, 1978 (the effective date of the \*51 1976 Act), the duration of copyright is covered by a complicated set of special provisions. [n170]

The duration of copyright protection for building designs under the Architectural Works Copyright Protection Act [n171] is the same as for other copyrights, with the following exception. If an architectural design was first drawn or modeled or otherwise committed to some two- or three-dimensional tangible medium of expression before the effective date of that Act, [n172] but the design was unpublished and no building embodying the design was constructed in full-size form until after that effective date, the term of copyright on the full-size architectural work will terminate on December 31 of the year 2002 unless the building is constructed in full-size form by that date. [n173] Such termination, however, will not affect \*52 the duration of conventional copyright (of the

kind which could have existed before the enactment of the Architectural Works Copyright Protection Act) on any two- dimensional plans or three-dimensional model of the building. The duration of copyright protection on two-dimensional plans drawings or a three-dimensional model representing a copyrighted building is the same as for copyrights in any other drawings and models, \*53 and does not appear to be tied to the term of protection for the design of the corresponding full-sized building. [n174]

#### § [6]-Termination of Grant

In the event that a copyright is assigned or licensed, the Copyright Act contains provisions [n175] which permit the assignment or license to be terminated at the option of the grantor or his heirs, and upon such termination the copyright reverts to the terminator(s). [n176] If those having the right of termination do not exercise it, the grant continues in effect until they do. [n177]

No termination is possible, however, in the case of a work made for hire, [n178] which is consistent with the notion, discussed above, [n179] that in a work-for-hire situation the employer is considered the author rather an assignee. Thus, an architecture firm which employs architects, or the client-employer of an employee architect, need not concern itself with the possibility of termination of its copyright in the architectural work product of its employees created in the course of their employment.

A termination of transfer may not take place until thirty-five years from the date of the execution of the grant at the earliest, and in some cases even later. [n180] In the architectural field it is probable that the right to terminate will be of little commercial value after the passage of that much time.

Moreover, the Copyright Act expressly provides that any derivative work prepared under the authority of the grant before its termination may continue to be utilized under the terms of the grant after termination thereof. [n181] Accordingly, if an uncopyrighted building were constructed according to copyrighted plans under the terms of a grant (i.e., an assignment or license) of the copyright, and that grant were later terminated, then even in the unlikely event that the building were \*54 regarded as a "derivative work," and thus an infringement [n182] of the plans but for the rights conferred on the owner of the building by the grant, [n183] the subsequent termination of that grant would not affect the right of the building owner to continue to own and use the building. He undoubtedly could also continue to own and use copies of the plans for normal building maintenance and repair purposes.

The owner of the building would be forbidden, however, to use the plans to build another building after the termination of the grant, assuming that (contrary to the provisions of the AIA standard contract, discussed above) [n184] he had that right prior to the termination.

Similarly, if a building copyrighted under the Architectural Works Copyright Protection Act of 1990 [n185] were constructed under the terms of such a grant and the grant were later terminated, such termination would not affect the right of the building owner to continue to own and use the building. The owner of the building would be forbidden, however, to build a copy of the building after the termination of the grant.

## § [7]-Registration of Copyright

Copyright is obtained by the mere creation of the work, without any necessity for registration or any other legal formalities. [n186] Registration is not a precondition of copyright protection. [n187] So long as the copyright has not been infringed, therefore, it is not essential that it be registered. Registration is essential, however, when the copyright has been infringed and the copyright proprietor wishes to bring suit, since registration is a prerequisite to infringement litigation, whether the work is published or unpublished. [n188]

The copyright owner may choose to register a published or unpublished \*55 work at any time, however. [n189] Registration is a simple, quick and inexpensive procedure which, unlike the filing of a patent application, requires only the filing in of the blanks in a preprinted application form, [n190] the payment of a fee, [n191] and transmittal of the application and fee, along with copies of the work, [n192] to the Copyright Office.

Since the great majority of architectural copyrights are never infringed, it probably makes sense to forego registration unless and until an infringement controversy is foreseen, [n193] at which time the necessary registration can be obtained relatively expeditiously. In order to avoid \*56 delay in qualifying for a preliminary injunction or temporary restraining order, however, the registration should be applied for at the first hint of controversy. [n194]

There are some risks, however, in postponing registration. An award of statutory damages or attorney's fees is unavailable in two instances: in the case of an infringement of copyright in an unpublished work which begins before the effective date of its registration; [n195] and in the case of an infringement of copyright which begins after publication of the copyrighted work and before the effective date of the registration, unless the registration is made within a three-month grace period. [n196]

If no infringement occurs, so that registration remains unnecessary, and the work remains unpublished or clearly has been given only a "limited publication," [n197] then no communication with the Copyright Office or other legal formalities are required. If the work is published "generally," however, the statute makes the deposit of two copies of the work mandatory. [n198] If the publication of the work is of a kind which involves a fairly narrow distribution of copies, such as the filing of architectural plans in the local building office, distribution of copies of such plans to selected bidders, contractors and subcontractors, delivery of a copy of such plans to the architect's client, and the like, [n199] then it seems unlikely that the Copyright Office will have any interest in taking

the position that a general publication has occurred or will demand such a deposit, and there is at least a fair chance, in the current state of the law, that a court will ultimately rule that the distribution was only a limited publication. Therefore, it may be reasonable to take the position that there has been no general publication and on that basis to forego the deposit of copies. [n200] Deposit, moreover, is not a condition of copyright protection. [n201]

\*57 If, however, the publication is of the kind which involves a considerably wider distribution of copies, such as the printing and circulation of promotional brochures or newspaper advertisements containing floor plans, exhibition of detailed plans to large numbers of prospects, or the like, [n202] then it is more likely that the publication will be regarded as general. In that case, it is more likely that the copyright proprietor might ultimately be required to deposit copies in accordance with the requirements of the statute.

If the Copyright Office decides that there has been a general publication and makes a demand for deposit of copies, the copyright proprietor may comply with such demand within three months without penalty. [n203] In that event, application for registration might as well be made, since the formalities of deposit are substantially similar to the formalities of a registration application; in particular, the same deposit copies suffice for both purposes. [n204]

## § [8]-Infringement of Copyright

### § [8][a]-Standing To Sue

To bring suit for infringement, the plaintiff must have a sufficient proprietary interest in the copyright. [n205] For example, it has been held that an assignee of a copyright does not have the right to sue for an infringement which occurred prior to the date of the assignment unless the assignment contained a provision expressly conveying the right to sue for past infringement. [n206] The Copyright Act makes it clear, however, that all that is required to confer standing to sue for an ongoing infringement is that the plaintiff be the holder of the particular exclusive right under the copyright which is being infringed. [n207] Thus, the assignee or exclusive licensee of the right to use an architectural work in a particular geographical area or in a particular commercial field would probably have standing to sue for an infringement occurring within that particular area or field.

### \*58 § [8][b]-Copying

#### § [8][b][i]-Architectural Works Not Covered by The Architectural Works Copyright Protection Act of 1990

Under § 106 of the Copyright Act infringement of an architectural work can only take the form of unauthorized reproduction [n208] of copies of the copyrighted work, unauthorized preparation of a new work which is derivative [n209] from the copyrighted work, or unauthorized distribution [n210] of copies of the copyrighted work. The construction of an uncopyrighted building based on another's copyrighted plans is probably not the preparation of an infringing "derivative work," since under the law which existed prior to the Architectural Works Copyright Protection Act a building was probably not itself a "work" in the sense of the copyright law. [n211] Unauthorized distribution of a copyrighted drawing is fairly rare. [n212] Most cases of infringement of architectural works under the pre-1990 law therefore had to come under the heading of "reproducing" or "copying." [n213] Thus, in infringement cases arising under pre-1990 law, the key question usually is: what constitutes impermissible copying for the purposes of the copyright law?

It has been said that it is permissible for a defendant to duplicate exterior features of plaintiff's uncopyrighted building which he was able to copy merely by observation of the building, even if the plans for that \*59 building were protected by copyright. [n214] It has also been said that a defendant may prepare his own architectural plans by observation and measurement of the interior of an uncopyrighted building which was constructed from the plaintiff's copyrighted plans. [n215]

However, even if under prior law there was a privilege to copy whatever exterior or interior architectural features of an uncopyrighted building are visible to the public, either by casual observation or deliberate measurement, that doctrine might not extend to structural features which are hidden from view and available only by privileged access to the plaintiff's plans. Thus, it has been said that the fact that the exterior of a building is visible to passers-by is no reason to allow the defendant to use the much greater wealth of structural detail available from the plaintiff's plans. [n216]

Where the plaintiff's plans have only been shown to a limited group, it has been held that the defendant's preparation of architectural plans by copying from the plaintiff's copyrighted plans is infringement, [n217] and that defendant's preparation of a floor plan by copying from a promotional brochure is also infringement. [n218]

Copying may be inferred from proof that the defendant had access to the plaintiff's copyrighted drawings plus a showing of substantial \*60 similarity between those drawings and the defendant's drawings. [n219] Even in the absence of proof that the defendant had access to the plaintiff's drawings, copying may be inferred from similarity alone, provided the similarity is so striking that an independent creation is virtually precluded. [n220]

On the other hand, if the defendant has independently conceived his design or derived it from some source other than the plaintiff's work, then there is no infringement of the plaintiff's copyright, regardless of any resemblance between the defendant's building and the building represented by the plaintiff's copyrighted plans. [n221] Moreover, the defendant is clearly not guilty of infringement, despite access to the plaintiff's

copyrighted work, when he has taken little or nothing therefrom. [n222] It has also been held that there is no infringement when defendant takes no more from the plaintiff's copyrighted plans than the general design approach, and does not use specific details thereof. [n223]

If the defendant uses the plaintiff's work as a source, but adds some contribution of his own, the question then becomes how much he may vary from the plaintiff's plans and still be held to have copied therefrom. For example, rearrangement of the kitchen layout and the addition of \*61 a family room have been held not to avoid infringement. [n224]

Where some parts of the plaintiff's plans were copied, however, the mere fact that other parts were substantially changed does not constitute a defense to infringement. [n225] It does not matter that defendant takes less than all of what is shown in plaintiff's plans; he is an infringer to the extent of whatever he has taken and cannot use as a defense the fact that he did not take the rest; it is not even necessary that the material taken constitute a large part of the plaintiff's work. [n226]

It has been held that it was not an infringement for the defendant to use the plaintiff's copyrighted plans, which were lawfully in his possession, merely to avoid the necessity of remeasuring a structure during renovation, where the defendant made no further use of the plans because the plans were for renovating the structure for use as a restaurant and nightclub, and the defendant renovated the structure in an entirely different way for use as offices. [n227]

#### § [8][b][ii]-Architectural Works Covered by The Architectural Works Copyright Protection Act of 1990

In contrast to the pre-1990 law, building designs covered by the Architectural Works Copyright Protection Act [n228] can be infringed not only by copying the design in the form of two-dimensional plans or drawings or a three-dimensional model, but also by the construction of a full-sized building [n229] which embodies the protected design; and it seems clear that such a building is now to be considered a protected work under the copyright law. Consequently, infringement of the copyright on such a work can now consist of copying from the building itself, as well as copying from a two-dimensional plan or drawing or a three-dimensional \*62 model which represents the protected design. [n230] Therefore we can expect that it will no longer be permissible to copy either exterior or interior protected features of such a building by observation and/or measurement, and there will no longer be a privilege to copy such features merely because they are readily observable by the public.

If the copied features are "standard," however, then they are not protected by the copyright on the building design. [n231] Under newly added § 120 of the copyright act, moreover, it will not be an infringement of the copyright in a protected architectural design merely to make, distribute, or publicly display pictures, paintings, photographs, or other pictorial representations of the design if an embodiment of the building has actually been constructed and is located in, or is ordinarily visible from, a public place. [n232]

Presumably, however, if a pictorial representation \*63 which is otherwise exempted from infringement liability under § 120 is used as an aid in the construction of a full-sized copy or even a two-dimensional model of the protected building design, then such construction would be infringement. [n233] In addition, it is questionable whether architectural plans or other technical drawings of a copyrighted building would qualify as "pictures" or "pictorial representations" for the purposes of this § 120 infringement exemption, since that section appears to be directed to images which convey visual information concerning the appearance of the copyrighted building design rather than technological information useful for the purpose of unauthorized duplication of the building.

#### § [8][c]-Defenses

Even if the defendant has copied the copyrighted work, there are some defenses which may be raised.

#### § [8][c][i]-Fair Use

The fair use defense in copyright law is sometimes used to relieve the defendant of liability for what would otherwise be an act of infringement. It applies only in special situations where there are substantial \*64 public policy reasons for weighing the equities of the defendant more heavily than those of the plaintiff. [n234] Only two cases have been found involving architectural subject matter in which the defendants raised this defense, and they were unsuccessful in both instances.

In one case [n235] the court dismissed the fair use defense on the grounds that the defendant's use of the plaintiff's plans was "solely for commercial purposes. No educational, scientific, or historical purposes were served" thereby. Since "there was no ready market for custom designed architectural plans for apartment complexes and defendant, which had commissioned the plans in the first place, was the plaintiff's only potential market source" for selling such plans, the court concluded that defendant's misappropriation of the plans for a second apartment complex of similar design had "destroyed the plaintiff's potential market. This was not a fair use of the plans under copyright law." [n236] The reasoning in the other case [n237] was quite similar.

#### § [8][c][ii]-First Sale Doctrine

Under § 109(a) of the Copyright Act, [n238] if a copy of a copyrighted work has been sold by the copyright proprietor or by someone else acting under his authority, the owner of the copy is free to use and to resell that particular copy (but not to make or sell additional copies). Thus a part of the protection which the copyright law accords to a particular copy of a work is exhausted after the first authorized sale of that copy.

This defense, however, does not extend to copies which neither the plaintiff nor those authorized by him have sold. [n239] Therefore, it has been held that copies of copyrighted plans and engineering specifications, which were merely lent to the defendant architect and the defendant engineer for informational purposes by a client of the plaintiff architect and plaintiff engineer, could not be sold by the defendants without liability for copyright infringement. [n240]

\*65 It should also be noted that under newly added § 120(b) [n241] of the copyright act, even though a building embodies a design which is protected under the Architectural Works Copyright Protection Act, [n242] if that building is owned by an entity other than the copyright proprietor the copyright will not prevent the owner of the building from making or authorizing alterations to the building, or even destroying it or authorizing its destruction, without the consent of the copyright proprietor. [n243]

#### § [8][c][iii]-Abandonment

In some cases defendants have raised a defense of "abandonment" which apparently is distinct from divestive publication. [n244] It is not clear precisely what this defense consists of, since it does not appear to have been upheld in any architectural cases. There are decisions in architectural cases, however, which tell us what it does not consist of. Thus, it has been decided that this defense requires that the copyright proprietor intended to dedicate his rights to the public. [n245]

#### § [8][c][iv]-Laches

It has been held that the defense of laches applied where the plaintiff copyright proprietor knew of the infringement, yet failed to assert his rights until after it was too late in the progress of the defendant's construction project for the defendant to avoid copyright infringement by reworking his plans and specifications to avoid copying of the plaintiff's plans and specifications. [n246]

Consequently, the court suggested, the plaintiff's recovery should be limited to a lesser amount of damages (i.e., an architectural drawing fee) which it could have collected if it had asserted its rights at the time it first became aware of the infringement (i.e., prior to the beginning of the defendant's construction), rather than a greater amount (a percentage of the construction costs) to which it might have been entitled if it had not discovered the infringement until the time when it actually \*66 did assert its rights (which was after defendant's construction was completed). In other words, the court suggested that the plaintiff should not be allowed to increase his recovery at the defendant's expense by intentionally delaying the assertion of his rights until the defendant had obtained a greater benefit from its infringement. [n247]

### § [8][c][v]-Estoppel

This defense has been held to preclude copyright infringement liability where a mutual client asked the plaintiff architectural firm to review the work of the defendant architectural firm, and as a result of the review, the defendant's plans were required to conform to the copyrighted plans which had been prepared earlier by the plaintiff. The estoppel defense, however, protected only those aspects of the defendant's plans which the plaintiff had required the defendant to include as a result of the review. Other features of the defendant's plans which were also copied from the plaintiff's copyrighted plans, but had not been required by the plaintiff to be included, remained a basis for infringement liability. [n248]

### § [8][c][vi]-Innocent Intent

Intent to infringe is not an element of the tort of copyright infringement, although it can affect the amount of the liability. [n249] Therefore, it has been held that a defendant which did not realize that the plaintiff's plans were copyrighted, and did not intend to break the law, is nevertheless liable. [n250]

### \*67 § [8][c][vii]-Unclean Hands

In one case [n251] the defendants claimed that the plaintiffs were equitably barred from recovery because they had failed to inform the Copyright Office, in their copyright registration application, that their architectural plans incorporated pre-existing material. (The plans involved in that case were for a building which was intended to be somewhat similar to an earlier building.) The defendant claimed that this omission misrepresented the scope of copyright protection to which the resulting registration was entitled, and was therefore a fraud on the Copyright Office and the public. The court, however, held that the defendant had failed to sustain the burden of proving that the plaintiff had derived the copyrighted plans from the plans of the earlier building, and therefore rejected the unclean hands defense. [n252]

### § [8][d]-Relief

Most of the prevailing plaintiffs in architectural copyright infringement cases were able to obtain only monetary relief. A few, however, have obtained injunctions.

### § [8][d][i]-Damages

Under the federal Copyright Act (and since 1978 all copyright infringement suits must be brought under the Act) [n253] the plaintiff is entitled to damages and also to an award of defendant's profits attributable to the infringement; [n254] but only to the extent that

the defendant's profits \*68 are not included in the calculation of the plaintiff's damages, otherwise there would be an impermissible double recovery. [n255] Alternatively, the plaintiff may elect to receive, instead of actual damages, an award of statutory damages [n256] in the amount of not less than \$500 nor more than \$20,000 per work, [n257] "as the court considers just." [n258] If the plaintiff can sustain the burden of showing willful infringement, the statutory \*69 damages can be increased to as much as \$100,000. [n259] Where the infringer sustains the burden of showing that the infringement was innocent, however, the statutory damage award can be reduced to as little as \$200. Moreover, in the case of certain classes of non-profit defendants and their employees and agents, the statutory damages can be remitted entirely [n260] if the defendant reasonably believed that the infringement was fair use. [n261]

Statutory damages may not be awarded, however, for infringement of an unpublished work which began before the date of registration of the copyright; [n262] or for any infringement which began after the publication of the copyrighted work and before the effective date of registration, unless the registration was made within a three-month grace period. [n263]

With respect to actual damages, some cases have held that the prevailing plaintiff is entitled to the market value of misappropriated plans. [n264] Another case calculated the damages as the value of the plans less the cost which the plaintiff would have had to incur to revise them for the construction project on which the defendant used them. [n265] Still another stated the measure of damages as the value of the plans to the defendant. [n266]

The plaintiff is not entitled to an amount equal to the sales price of the defendant's home constructed from infringing plans. [n267] Where the plaintiff and defendant were competing builders, however, compensatory \*70 damages were held equal to the gross selling price of the plaintiff's home less direct costs of 61% and indirect costs of 23% (for a total deduction of 84% and a net profit margin of 16%), multiplied by the number of homes built from the infringing plans by the defendant in 1983 (based on the assumption that each sale by the defendant deprived the plaintiff of a sale). For 1984 the figures were 65% direct costs and 21% indirect costs, for a total deduction of 86% and a net profit margin of 14%. In its award, the court averaged the two years together and used a net profit margin figure of 15% overall. [n268] Where the defendant was a potential home buyer, however, instead of a competitor of the plaintiff builder, the court refused to infer that plaintiff's actual damages equaled his average profit on the home represented in the copyrighted plans, because the defendant built his own home and would not have bought a home from the plaintiff even if he had not infringed the copyright. [n269]

Still another case awarded a reasonable architect's fee for the infringement of copyrighted plans. [n270] It has been held, however, that if the plans were not utilized by the defendant, the value of the architect's supervision services cannot be included in the measure of damages. [n271] In another case the court awarded damages to compensate the plaintiff architect for his loss of productive time, presumably resulting from the prosecution of the copyright infringement suit. [n272]

\*71 Extra damages for willfulness were awarded in one federal copyright case, [n273] but have been denied in several state copyright cases. [n274]

The Copyright Act, unlike the Patent Act, does not expressly provide for awards of prejudgment interest. In one case it was held that the decision whether or not to award such interest in the absence of express statutory authorization depends on whether it would further the legislative purposes of the Copyright Act, but "the measure of damages applied in this case is clearly sufficient to promote innovation in architectural design and deter unauthorized exploitation of someone else's creative expressions." [n275]

#### § [8][d][ii]-Injunction

Permanent injunctive relief has not been awarded to halt a construction project which is in progress or has been completed. [n276] A preliminary injunction, however, has been issued halting construction until the defendant obtained noninfringing plans. [n277] And in another case the court issued a preliminary injunction, but it was limited to construction of any additional unstarted buildings using the infringing plans. [n278] The \*72 defendant can be ordered to destroy or to deliver up [n279] any infringing copies of copyrighted plans. In one case the court ordered infringing plans to be delivered up to the plaintiff, but allowed each innocent client of the defendants to keep one infringing set of plans for use in any future renovation of the building. [n280] If construction is already completed, the plaintiff should be granted an injunction against any further use of the infringing plans. [n281]

#### § [8][d][iii]-Attorney Fees

Under the federal Copyright Act [n282] the judge has discretion to award attorney fees to the prevailing party. [n283] Such fees, however, may not be awarded for infringement of an unpublished work which began before the date of registration of the copyright; [n284] or for any infringement which began after the publication of the copyrighted work and before the effective date of registration, unless the registration was made within a three-month grace period. [n285]

#### \*73 § [8][d][iv]-Innocent Infringement

Under § 505 of the present federal Copyright Act [n286] the omission of copyright notice from a work published before March 1, 1989, permits an innocent infringer to escape liability for damages for infringing acts committed before receiving actual notice that registration has been made, provided the absence of the copyright notice actually misled the infringer. In addition, under such circumstances the court has discretion to disallow a recovery of the innocent infringer's profits. It has been held, however, that, for the purposes of this provision, one who knowingly appropriated the plans which an

architect had prepared for an earlier construction project, and re-used them for a second project without the architect's permission, was not misled by the absence of such notice. [n287]

There is no similar innocent infringement defense available in the case of works published without copyright notice on or after March 1, 1989; this is so because on that date such notice became optional under the Berne amendment to the copyright statute, as explained in § [3][a][ii], supra.

#### § [8][e]-Joint Tortfeasors

One who directs another to infringe a set of copyrighted plans is himself an infringer. [n288] The clients of a builder who innocently received the benefit of the builder's infringement of copyrighted plans were jointly liable with the builder for compensatory damages, despite their innocence, because they were unjustly enriched; but only the builder was \*74 held liable for extra damages and attorney fees. [n289]

However, a lumber supplier and an architect who aided a builder, by supplying him with the necessary lumber required according to a set of plans, and by granting architectural approval to those plans, without any knowledge that the plans were infringing, were not liable. [n290] Similarly, a client who showed copyrighted plans to the defendants purely for informational purposes was not a joint or contributory infringer where he did not direct the defendants to copy the plans and had no knowledge of the copying until after the building was completed. [n291]

It has also been held that real estate brokers, whose only involvement in the infringement of a copyright on architectural plans is to act as brokers in the sale of unimproved land to the infringer, are not liable for the copyright infringement either on a theory of vicarious liability or a theory of contributory infringement, although the brokers benefited from the transaction to the extent of earning a commission, and even though the brokers may have known that the transaction was contingent upon the construction of a building using infringing plans. [n292]

#### § [8][f]-Alternative Legal Theories

Some cases involving the misuse of architectural plans have given relief on the basis of common law conversion as well as on the basis of copyright infringement. [n293] It has also been suggested that common law \*75 unjust enrichment (quantum meruit) is a basis for recovery in such cases, provided the defendants actually were enriched by their malfeasance; but not if they lost money on the infringing project after deduction of direct costs and overhead expenses. [n294] Nor is such a state-law unjust enrichment claim preempted by the federal Copyright Act of 1976. [n295] In addition, a state-law claim for trade identity confusion caused by the similarity between defendant's and plaintiff's houses was not preempted by federal copyright protection of plaintiff's architectural

plans, even though defendant infringed the copyright by using unauthorized copies of the plans to build the accused house. [n296]

However, a state-law claim for misappropriation [n297] of copyrighted plans has been held preempted by that Act, [n298] as have state-law claims for conversion and tortious interference with contract, to the extent that they are based on the plaintiff's loss of the exclusive right to use his architectural plans, which is the basic right secured by the copyright \*76 statute. [n299] In addition, it has been held that a common-law cause of action for unfair competition was preempted by the federal copyright act in the absence of a finding that defendant attempted to pass off plaintiff's architectural plans as its own. [n300] The Berne Convention Implementation Act of 1988, by its terms, does not affect the scope of federal copyright preemption. [n301]

### § [9]-Moral Rights

Recently added § 106A of the copyright statute [n302] provides for protection of artists' "moral" rights, i.e. the rights of attribution, anti-attribution, and integrity, in works of visual art. Under this section the right of attribution is the right of artists to claim authorship of their works, [n303] and the right of anti-attribution is the right to prevent the use of artists' names in connection with works which they did not create. [n304] The right of integrity includes the right to prevent the use of artists' names in connection with works which they originally created but which have since been distorted, mutilated or modified in a way which is prejudicial to the artists' honor or reputation, [n305] and to prevent any such distortion, mutilation or modification which is intentional. [n306] The right of integrity also includes the right to prevent any intentional or grossly negligent destruction of a work of visual art "of recognized stature." [n307] Under this section, artists have these rights whether or not they are the owners of the copyright in the works covered thereby. [n308] With respect to works created on or after the effective date of this section, these rights \*77 last for the lives of the artists. [n309] These rights are non-transferrable, but they are waivable. [n310]

For this purpose, a work of visual art is defined in § 101 of the copyright act [n311] as a painting, drawing, print, sculpture or photograph existing in a single copy or a limited edition of no more than 200 copies and which meets certain specified criteria as to signature and numbering. It does not include any work made for hire, which (under the definition of "work \*78 for hire" in § 101) would exclude any work prepared by an employed artist within the scope of the employment.

If a work of visual art is a mural or other drawing or painting which is affixed to one or more walls of a building, the building owner may find that removing the work will cause destruction, distortion, mutilation or modification of the work of the kind proscribed in § 106A. Section 113(d) of the copyright act [n312] therefore provides that, if the artist consented to the installation of the work either before the effective date of § 106A or in a written instrument which was executed on or after that date and signed by the owner of the building and the artist, and which specifies that installation of the work may subject it

to destruction, distortion, mutilation, or other modification by reason of its removal, then the rights provided by § 106A shall not apply to any destruction, distortion, mutilation, or other modification of the work. [n313]

If a work of visual art is a part of a building and can be removed from the building without such destruction, distortion, mutilation, or other modification, however, then the rights provided by § 106A shall apply [n314] unless the building owner makes a diligent, good faith attempt without success to notify the artist of the building owner's intent to remove the work, [n315] or the building owner provides such notice to the artist and the artist fails to remove the work at the artist's expense within 90 days after receiving such notice. [n316] If the work is removed from the building \*79 at the expense of the artist, the artist shall then own title to the physical copy of the work so removed. [n317]

The requirement of diligence and good faith referred to above is presumed to have been met if the building owner sends the notice by registered mail to the artist's most recent address that was recorded with the Register of Copyrights, [n318] who is required [n319] to establish a system of records whereby any artist who creates a work of art that has been incorporated into or made part of a building may record his or her identity and address and subsequently update the information so recorded, and also to set up procedures under which owners of buildings may record with the Copyright Office evidence of their efforts to comply with § 113(d).

There are also some state enactments protecting artists' moral rights. [n320] Newly enacted § 301(f)(1) of the federal copyright statute [n321] provides that on or after the effective date [n322] of the federal moral rights provisions discussed above, all legal or equitable rights that are \*80 equivalent thereto, with respect to works of visual arts to which those rights apply, are to be governed exclusively by those federal moral rights provisions, to the exclusion of any such right or equivalent right in any work of visual art under the common law or statutes of any state.

But this language leaves considerable room for the operation of state law in connection with works of visual art, including those in the nature of accessions to realty, and § 301(f)(2) of the federal copyright statute [n323] expressly confirms that nothing in § 301(f)(1) thereof, supra, annuls or limits any rights or remedies under the common law or statutes of any state with respect to: (A) any cause of action arising from undertakings commenced before the effective date mentioned above, (B) activities violating legal or equitable rights that are not equivalent to any of the rights conferred by the above-mentioned federal provisions, or (C) activities violating legal or equitable rights which extend beyond the life of the author.

Indeed, as the leading copyright treatise has noted, [n324] " a host of questions arises in response to the foregoing provisions." With respect to works of visual art in the nature of accessions to realty, these questions include the following: Do the preemption provisions of § 301(f) of the copyright law exclude relief on a moral rights theory under other federal statutes, such as § 43(a) of the federal Lanham Act? [n325] What artists' rights of attribution or integrity provided by state or other federal laws are not equivalent to those

provided by the federal copyright statute? Can protection for such rights, which is preempted during the life of the artist, spring into existence at the artist's death? These questions, which are unresolved at this writing, can arise to trouble both the artists who affix artworks to buildings and the owners of those buildings.

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[naa]. Laff, Whitesel, Conte & Saret, Chicago, Illinois.

[n1] 17 U.S.C. § 102(a).

Architectural works can be original, notwithstanding the fact they are designed for architectural similarity to a previous building, and notwithstanding the fact that they consist of modifications of a standard design stored on a computer. *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170, 173, 178 (W.D. Tex. 1983).

[n2] 17 U.S.C. § 102(a)(5).

A simulated stained-glass window design is copyrightable. *Designer's View, Inc. v. Publix Super Markets, Inc.*, 764 F. Supp. 1473, 1991 U.S. Dist. LEXIS 6862, 20 U.S.P.Q.2d 1223, 1226 (S.D. Fla. 1991).

[n3] See § [1][a], *infra*.

[n4] See § [1][c], *infra*.

[n5] See § § [1][b] and [2], *infra*.

[n6] See § [2][b] *infra*.

[n7] 17 U.S.C. § 101. This language was added by the Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2855 (1988), effective March 1, 1989, to expressly include architectural plans. Architectural plans were covered previously, but they had been included only under the more general language: "two-dimensional... works of fine, graphic, and applied art,... charts, technical drawings, diagrams"

[n8] Under the previous version of § 101, see *Wickham v. Knoxville Int'l Energy Exposition, Inc.*, 555 F. Supp. 154 (E.D. Tenn. 1983) (architectural drawings covered by the current federal Copyright Act, but insufficient similarity in that case to constitute infringement); *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170, 177 (W.D. Tex. 1983) ("the legislative history of the Copyright Act [of 1976] leaves no doubt that Congress intended copyright protection to extend to architectural drawings and plans"). See 1 Nimmer on Copyright § 2.08[D][2].

[n9] See § [1][a] above.

The House Report on the 1976 Copyright Act had the following to say on the subject of architectural works:

A special situation is presented by architectural works. An architect's plans and drawings would, of course, be protected by copyright, but the extent to which the protection would extend to the structure depicted would depend on the circumstances. Purely non-functional or monumental structures would be subject to full copyright protection under the bill [which later become the Copyright Act], and the same would be true of artistic sculpture or decorative ornamentation or embellishment added to a structure. On the other hand, where the only elements of shape in an architectural design are conceptually inseparable from the utilitarian aspects of the structure, copyright protection for the design would not be available.

H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. 55, reprinted in 1976 U.S. Code Cong. & Admin. News 5659, 5668.

See also *DeSilva Constr. Corp. v. Herral*, 213 F. Supp. 184 (M.D. Fla. 1962) (dictum) (under the 1909 Copyright Act).

[n10] 17 U.S.C. § 101.

Section 101 also says that: "An article that is normally a part of a useful article is considered a "useful article."

[n11] The Architectural Works Copyright Protection Act is Title VII of The Judicial Improvements Act of 1990, Pub. Law 101-650, 104 Stat. 5089 (effective Dec. 1, 1990).

The full text of the Architectural Works Copyright Protection Act is set forth in an Appendix to this article.

[n12] According to the House legislative report concerning predecessor bill H.R. 5498, this legislation was intended to exclude bridges, highway overpasses, pedestrian walkways, canals, dams and the like. H.R. Rep. No. 101- 735 at 19-20, and especially the following statement:

... copyright protection is not necessary to stimulate creativity or prohibit unauthorized reproduction [of interstate highway bridges, cloverleaves, canals, dams, and pedestrian walkways].

The sole purpose of legislating at this time is to place the United States unequivocally in compliance with its Berne Convention obligations. Protection for bridges and related nonhabitable three-dimensional structures is not required by the Berne Convention. Accordingly, the question of copyright protection for these works can be deferred to another day....

Relevant portions of this legislative report are set out in an Appendix to this article.

[n13] 17 U.S.C. § 101.

[n14] As to the meaning of the term "building," the legislative report says that this term encompasses not only housing, office buildings and institutions, but also other structures used by humans such as gazebos, pergolas and garden pavilions. See the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 19-20.

[n15] See the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 18:

The phrase "arrangement and composition of spaces and elements" recognizes that: (1) creativity in architecture frequently takes the form of a selection, coordination, or arrangement of unprotectable elements into an original, protectable whole; (2) an architect may incorporate new, protectable design elements into otherwise standard, unprotectable building features; and (3) interior architecture may be protected.

[n16] See the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 18:

... the definition makes clear that protection does not extend to individual standard features, such as common windows, doors, and other staple building components. A grant of exclusive rights in such features would impede, rather than promote, the progress of architectural innovation. The provision is not, however, intended to ex[c]lude from the copyright in the architectural work any individual features that reflect the [a]rchitect's creativity. [Footnote omitted.]

[n17] See the remarks of Rep. Kastenmeier regarding H.R. 5316, the bill which became The Judicial Improvements Act of 1990, published in Cong. Rec. Oct. 27, 1990, page H13314.

See also the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 12-13:

...

Architecture plays a central role in our daily lives, not only as a form of shelter or as an investment, but also as a work of art. It is an art form that performs a very public, social purpose. As Winston Churchill is reputed to have once remarked: "We shape our buildings and our buildings shape us." ...

...Architecture is not unlike poetry, a point made by renowned critic Ada Louise Huxtable, who wrote that architects can make "poetry out of visual devices, as a writer uses literary or aural devices. As words become symbols, so do objects; the architectural world is an endless source of symbols with unique ramifications in time and space."

In short, the Committee concluded that the design of a work of architecture is a "writing" under the Constitution and fully deserves protection under the Copyright Act. Protection for works of architecture should stimulate excellence in design, thereby enriching our public environment in keeping with the constitutional goal.

[Footnote 25: A. Rossi, "Memory and Metaphor in Architecture Anyone?" at 45-46 (1986). See also Architectural Design Hearings, *supra* note 4, at 136 (statement of Frank Lloyd Wright Foundation): "Architectural art is no less art than its counterparts in the world of sculpture and painting \*\*\*"; *id.* at 49 (statement of Register of Copyrights Ralph Oman): "[Architecture is] one of the oldest and most revered forms of Art."]

See also *id.* at 18-19:

Critic Ada Louise Huxtable once provided the following comment that may be helpful as an expression of the policy behind the legislation:

[T]echnology is not art, and form only follows function as a starting point, or life and art would be much simpler than they are. The key to the art of architecture is the conviction and sensitivity with which technology and function are interpreted aesthetically, in solutions of a practical social purpose.

Architect Michael Graves, a witness before the Subcommittee, provided further guidance in an essay entitled "A Case for Figurative Architecture." Mr. Graves 86 explained his design efforts by describing two types of architectural language, "internal" and "poetic." Internal language is "intrinsic to building in its most basic form- - determined by pragmatic, constructional, and technical requirements." Poetic language is "responsive to issues external to the building, and incorporates the three- dimensional expression of the myths and rituals of society." The intent of the legislation is to protect only what Mr. Graves calls "poetic language." [Footnotes omitted.]

But cf. *id.* at 21:

The proposed legislation incorporates the general standards of originality applicable for all other copyrightable subject matter. This standard "does not include requirements of novelty, ingenuity, or [a]esthetic merit." Subjective determinations of artistic or aesthetic merit are inappropriate and contrary to fundamental principles of copyright law.

As a result of the incorporation of the general standard of originality for architectural works, determinations of infringement of architectural works are to be made according to the same standard applicable to all other forms of protected subject matter. The references in the definition of "architectural work" to "overall form," and to the nonprotectability of "individual standard features" are not intended to indicate that a higher standard of similarity is required to prove infringement of an architectural work, or that the scope of protection of architectural works is limited to verbatim or near-verbatim copying. These definitional provisions are intended merely to give the courts some guidance regarding the nature of the protected matter. The extent of protection is to be made on an ad hoc basis. [Footnotes omitted.]

[n18] *Jones Bros. Co. v. Underkoffler*, 16 F. Supp. 729 (M.D. Pa. 1936).

See also *Letter Edged in Black Press, Inc. v. Public Building Comm'n of Chicago*, 320 F. Supp. 1303 (N.D. Ill. 1970) (copyright on scale model of large sculpture would have protected the latter but for divestive publication).

[n19] See § [1][c] above.

[n20] See § [1][a] above.

[n21] See the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 19. The text continues:

... The bill's intention is to keep these two forms of protection separate. An individual creating an architectural work by depicting that work in plans or drawing will have two separate copyrights, one in the architectural work (section 102(a)(8)), the other in the plans or drawings (section 102(a)(5)). Either or both of these copyrights may be infringed and eligible separately for damages. [I]n cases where it is found that both the architectural work and the plans have been infringed, courts or juries may reduce an award of damages as necessary to avoid double remuneration, but the basic concept of election of protection is important and must be preserved.

[Footnote 41: The Subcommittee was aware that certain works of authorship which may separately qualify for protection as pictorial, graphic, or sculptural works may be permanently embodied in architectural works. Stained glass windows are one such example. Election is inappropriate in any case where the copyright owner of a pictorial, graphic, or sculptural work embodied in an architectural work is different from the copyright owner of the architectural work.]

See also *id.* at 20, note 43:

Monumental, nonfunctional works of architecture are currently protected under section 102(a)(5) of title 17 as sculptural works. These works are, nevertheless, architectural works, and as such, will not be protected exclusively under section 102(a)(8).

[n22] A simulated stained-glass window design is copyrightable. *Designer's View, Inc. v. Publix Super Markets, Inc.*, 764 F. Supp. 1473, 1991 U.S. Dist. LEXIS 6862, 20 U.S.P.Q.2d 1223, 1226 (S.D. Fla. 1991).

A mirrored acrylic sculpture for use as a beauty parlor furnishing is copyrightable. *Store Decor Div. of Jas Int'l, Inc. v. Stylex Worldwide Industries, Ltd.*, 767 F. Supp. 181, 1991 U.S. Dist. LEXIS 8385, 20 U.S.P.Q.2d 1536, 1539 (N.D. Ill. 1991).

[n23] Title VII of The Judicial Improvements Act of 1990, Pub. Law 101-650, 104 Stat. 5089 (effective Dec. 1, 1990).

[n24] See the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 11:

... The current U.S. Copyright Act expressly includes "diagrams, models, and technical drawings, including architectural plans" as a species of protected "pictorial, graphic, and sculptural work." It does not, however, expressly protect "works of architecture," although this Committee's Report accompanying the 1976 Copyright Act contemplated that at least selected works of architecture-those containing elements physically or conceptually separable from their utilitarian function-would be protected to the extent of their separability. [Footnotes omitted.]

[n25] 17 U.S.C. § § 102(1)-(7).

[n26] 101 U.S. 99, 25 L. Ed. 841 (1879).

[n27] Before December 1, 1990 the only such works were computer programs, and architectural and other technical drawings.

[n28] The Court said:

To give to the author of the book an exclusive property in the art [i.e., technology] described therein, when no examination of its novelty has ever been officially made, would be a surprise and a fraud upon the public. That is the province of letters-patent, not of copyright. The claim to an invention or discovery of an art or manufacture must be subjected to the examination of the Patent Office before an exclusive right can be obtained; and it can only be secured by a patent from the government.  
101 U.S. at 102.

But there is an area of overlap between the copyright laws and the design patent statute. A cemetery monument, for example, is eligible for either type of protection. *Jones Bros. Co. v. Underkoffler*, 16 F. Supp. 729 (M.D. Pa. 1936). See 1 Nimmer on Copyright § 2.19.

See also Patent-Copyright Laws Overlap Study, prepared for the House Subcommittee on Intellectual Property and the Administration of Justice by the United States Patent and Trademark Office and the United States Copyright Office (1991) (the Copyright Office requires an election between these two forms of protection, but since 1974 the Patent and Trademark Office has not required such an election).

The coverage now available for three-dimensional architectural works under the amendments to the copyright laws which went into effect on December 1, 1990, discussed *infra*, appears to present another one of those areas where such an overlap exists. Therefore architects and their attorneys may now be required (at least by the Copyright Office) to choose between design patent and copyright to protect the same esthetic building design features.

Patents are much more expensive, much more difficult, and take a much longer time, to obtain, and if obtained are much shorter-lived, and subject to much greater doubts as to

validity, than copyrights. Therefore the question arises as to why anyone would want to choose patent protection over copyright protection if an election is required.

The main reason to choose patent protection over copyright protection is the fact that a patent protects the invention itself, whereas a copyright can only protect a particular expression. This reason, however, is only meaningful when the invention is a technological one, and the choice is between a utility patent and a copyright, as in the case of a computer program which is eligible for both types of protection. But in the case of inventions relating to the visual arts, where the choice is between design patent and copyright, this reason is illusory because the scope of protection accorded a design patent is measured not by technologically oriented claim verbiage, but by the visual appearance of the invention, which is the same measure employed under the copyright laws.

The only other reason to choose patent protection is the fact that a patent may be asserted against one who independently re-created the invention, whereas copyright protection may only be asserted one who copied from the copyright proprietor. In some instances this consideration may be decisive; but in general it would seem that coincidental convergence of independent designs is statistically improbable, and that most architectural designs which are of sufficient commercial importance that an infringer would want to imitate them will be so widely known (by virtue of public access to the copyrighted building and photographs thereof published in the popular press) that the required copying would not be difficult to infer. See § 8[b] regarding the inference of copying which arises from access plus similarity.

[n29] See the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 18, note 36:

Protection is not limited to architects. Any individual creating an architectural work is entitled to exercise the exclusive rights, granted under the bill, without regard to professional training or state licensing requirements.

[n30] See 17 U.S.C. § 102(a)(8), added by § 703(3) of the Architectural Works Copyright Protection Act, Title VII of The Judicial Improvements Act of 1990, Pub. Law 101-650, 104 Stat. 5089 (effective Dec. 1, 1990).

[n31] See 17 U.S.C. § 101, the definition of "architectural work," added by § 702(a) of the Architectural Works Copyright Protection Act, Title VII of The Judicial Improvements Act of 1990, Pub. Law 101-650, 104 Stat. 5089 (effective Dec. 1, 1990).

[n32] See the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 20-21:

... By creating a new category of protectible subject matter in new section 102(a)(8), and, therefore, by deliberately not encompassing architectural works as pictorial, graphic, or sculptural works in existing section 102(a)(5), the copyrightability of architectural works shall not be evaluated under the separability test applicable to pictorial, graphic, or

sculptural works embodied in useful articles. There is considerable scholarly and judicial disagreement over how to apply the separability test, and the principal reason for not treating architectural works as pictorial, graphic, or sculptural works is to avoid entangling architectural works in this disagreement.

The Committee does not suggest, though, that in evaluating the copyrightability or scope of protection for architectural works, the Copyright Office or the courts should ignore functionality. 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 reached to examine whether the design elements are functionally required. If the design elements are not functionally required, the work is protectible without regard to physical or conceptual separability. As a consequence, contrary to the Committee's report accompanying the 1976 Copyright Act with respect to industrial products, the aesthetically pleasing overall shape of an architectural work could be protected under this bill.

The proper scope of protection for architectural works is distinct from registrability. Functional considerations may, for example, determine only particular design elements. Protection would be denied for the functionally determined elements, but would be available for the nonfunctional[ly] determined elements. Under such circumstances, the Copyright Office should issue a certificate of registration, letting the courts determine the scope of protection. In each case, the courts must be free to decide the issue upon the facts presented, free of the separability conundrum presented by the useful articles doctrine applicable for pictorial, graphic, and sculptural works. Evidence that there is more than one method of obtaining a given functional result may be considered in evaluating registrability or the scope of protection. [Footnotes omitted.]

[n33] The amendment was signed by the President on December 1, 1990; and there is no provision postponing its effective date to any subsequent time.

[n34] § 706 of the amending act, the Architectural Works Copyright Protection Act, Title VII of The Judicial Improvements Act of 1990, Pub. Law 101-650, 104 Stat. 5089 (effective Dec. 1, 1990), provides that:

The amendments made by this title apply to-

- (1) any architectural work created on or after the date of the enactment of this Act...

[n35] See 17 U.S.C. § 301(b)(4), added by § 705 of the amending act, the Architectural Works Copyright Protection Act, Title VII of The Judicial Improvements Act of 1990, Pub. Law 101-650, 104 Stat. 5089 (effective Dec. 1, 1990).

[n36] 17 U.S.C. § 120, added by § 704 of the amending act, the Architectural Works Copyright Protection Act, Title VII of The Judicial Improvements Act of 1990, Pub. Law 101-650, 104 Stat. 5089 (effective Dec. 1, 1990).

[n37] Presumably this exemption would not apply to interior architectural features if the building is not open to the public, even though its exterior architectural features are visible to passers-by.

[n38] The House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 23, note 52, discusses the limitations on the exclusive rights of the owner of copyright in an architectural work, specifically noting that he:

... is not given a right to publicly perform or publicly display the architectural work. The right of public performance has no applicability to architectural works. While the right to publicly display an architectural work would have some benefit to copyright owners, the right would conflict with section 120(a), and, further, is not required by the Berne Convention.

The Committee considered the question of moral rights for architectural works. None of the witness at the Subcommittee's March 14, 1990 hearing testified in favor of an express statutory grant of such rights. Accordingly, the bill does not contain an express or implied statutory grant of moral rights. Architects' moral rights will, therefore, be governed by the law as currently exists. See Berne Convention Implementation Act of 1988, Public Law 100-568, sec. 3(b), 102 Stat. 2853.

[n39] *Cardinal Indus., Inc. v. Anderson Parrish Assocs., Inc.*, 230 U.S.P.Q. 678, 680 (M.D. Fla. 1986) ("the mere fact that the ... plans utilized a 12' x 24' dimension or a 2/12 roof pitch does not, in and of itself, constitute copyright infringement"), *aff'd without opinion*, 811 F.2d 609 (11th Cir.), *cert. denied*, 108 S. Ct. 88 (1987).

*East/West Venture v. Wurmfeld Associates, P.C.*, 722 F. Supp. 1064, 1068, 1989 U.S. Dist. LEXIS 12008, 13 U.S.P.Q.2d 1908, 1910 (S.D.N.Y. 1989): "If a property is of such a unique nature that its plans relating to development scheme and basic design features must be substantially identical, has the first architect to design plans a right to prevent the use [by competitors] of plans incorporating such scheme and features? The Court concludes that to demonstrate [copyright] infringement something unique in the plans not demanded by the uniqueness of the site must be copied."

[n40] Title VII of The Judicial Improvements Act of 1990, Pub. Law 101-650, 104 Stat. 5089 (effective Dec. 1, 1990).

[n41] Title VII of The Judicial Improvements Act of 1990, Pub. Law 101-650, 104 Stat. 5089 (effective Dec. 1, 1990).

[n42] See § [1][a] *supra*.

[n43] See the introductory portion of § [2], supra.

[n44] See § [1][b] and the introductory portion of § [2], supra.

[n45] See § [1][b], supra.

[n46] It is to be expected that controversies arising under the pre-existing law will continue to be litigated for some time to come.

[n47] "The doctrine enunciated in *Baker v. Selden* is particularly problematic where architectural plans are the copyrighted items because the principal value of such creative works lies in their use in constructing a building. If *Baker* is applied strictly, and the Copyright Act is interpreted as merely prohibiting others from selling copyrighted plans and not from using the plans to construct other buildings, then the statute may not afford the kind of protection necessary to give architects adequate incentive to create new architectural designs. Conversely, giving the owner of a copyright in architectural plans the right to prevent others from constructing buildings substantially similar to the one depicted in the copyrighted plans, without requiring the architect to show that the design is novel [in the sense of the patent statute] as opposed to merely original [in the sense of the copyright act], would give architects unwarranted monopoly powers ...." *Jones Assocs., Inc. v. Nino Homes*, 858 F.2d 274, 8 U.S.P.Q.2d 1224, 1228 (6th Cir. 1988).

[n48] 43 F. Supp. 298 (S.D.N.Y. 1942) (dictum or alternative holding).

[n49] 43 F. Supp. at 299, quoting *Baker v. Selden*, 101 U.S. 99, 25 L. Ed. 841 (1879).

[n50] "[P]laintiff's copyright of a drawing, showing a novel bridge approach to unsnarl traffic congestion, does not prevent any one from using and applying the system of traffic separation therein set forth." 43 F. Supp. at 300.

[n51] 43 F. Supp. at 299.

See also *Acorn Structures, Inc. v. Swantz*, 657 F. Supp. 70, 2 U.S.P.Q.2d 1632 (W.D. Va. 1987) (use of copyrighted plans for erecting a building is not copyright infringement, nor is preparation of derivative plan, nor filing with local building department, since these are necessary incidents of construction, citing *Baker v. Selden*) (dictum), rev'd on other grounds, 6 U.S.P.Q.2d 1810 (4th Cir. 1988).

[n52] "[T]here was no actual appropriation by defendant of any part of plaintiff's copyrighted work, and ... the design for the bridge approach was independently conceived and executed by the engineers of the [defendant] ...." 43 F. Supp. at 299.

[n53] Cf. *Jones Assocs., Inc. v. Nino Homes*, 858 F.2d 274, 8 U.S.P.Q.2d 1224, 1229 n.4 (6th Cir. 1988) ("it was unclear in *Muller* whether the defendants had made infringing copies or had merely used the copyrighted original to construct the approach").

[n54] 213 F. Supp. 184 (M.D. Fla. 1962).

[n55] The court said:

[E]ven the plaintiff concedes that the model house was not protected by any copyright; consequently the defendants could imitate or reproduce said model house without incurring any liability for so doing. ... The underlying rationale of the *Triborough Bridge* case [*supra*] seems to be that a non- artistic object of utility does not preclude others from making the three- dimensional object portrayed in the drawing or picture .....  
213 F. Supp. at 197-98.

[n56] 213 F. Supp. at 198 (dictum). The court said:

Another contention of the plaintiff is that an infringement took place when the defendants filed their competing plans with the City ... and that it is immaterial ... [when] the actual mechanical copying took place. ... [But] it is clear that the filing of their respective building plans by defendants ... was not an act of infringement even ... [if] the architectural plans of the plaintiff were copyrightable and valid.

While the thrust of these remarks is unclear, even in context, they do serve to demonstrate that the court believed that copying the plaintiff's plans for the purpose of preparing the defendant's plans and filing them with the local building department would not have been an infringement of a valid copyright of the plaintiff!

It should be noted, however, that the present author's interpretation of this aspect of the *DeSilva* case, *supra*, differs significantly from that offered in *Scholz Homes, Inc. v. Maddox*, 379 F.2d 84, 85 (6th Cir. 1967) (discussed in § [2][b], *infra*), where the court said that *DeSilva* "involved no allegations that copyrighted plans had been infringed by making additional sets of plans. Instead, these two cases [*DeSilva* and *Muller v. Triborough Bridge Auth.*, *supra*] considered and rejected the contention that copyrighted plans were infringed merely by constructing buildings according to those plans. It might therefore be argued that the instant situation presents a stronger case for infringement than either of the earlier architectural cases, since *Scholz* alleged not only that *Maddox* constructed a house according to the *Scholz Southern Shore* plan but also made copies of that plan." (Emphasis added.)

Accord *Acorn Structures, Inc. v. Swantz*, 657 F. Supp. 70, 2 U.S.P.Q.2d 1632 (W.D. Va. 1987) (use of copyrighted plans for erecting a building is not copyright infringement,

nor is preparation of derivative plans and filing with local building department, since these are necessary incidents of construction, citing *Baker v. Selden*) (dictum), rev'd on other grounds, 6 U.S.P.Q.2d 1810 (4th Cir. 1988).

[n57] 213 F. Supp. at 193.

[n58] 213 F. Supp. at 195. With respect to divestive publication, see § [3][b], *infra*.

[n59] 213 F. Supp. at 197.

[n60] *Baker v. Selden*, 101 U.S. 99, 103, 25 L. Ed. 841 (1879) (emphasis added).

[n61] *Acorn Structures, Inc. v. Swantz*, 657 F. Supp. 70, 2 U.S.P.Q.2d 1632 (W.D. Va. 1987) (use of copyrighted plans for erecting a building is not copyright infringement, nor is preparation of derivative plans nor filing with local building department, since these are necessary incidents of construction, citing *Baker v. Selden*) (dictum), rev'd on other grounds, 6 U.S.P.Q.2d 1810 (4th Cir. 1988).

See also *Intown Enterprises, Inc. v. Barnes*, 721 F. Supp. 1263, 1266, 1989 U.S. Dist. LEXIS 11393, 11 U.S.P.Q.2d 1364 (N.D. Ga. 1989): "A literal application of *Baker* to architectural plans would merely prohibit unauthorized copying of the plans themselves, but would not prohibit the infringer from using the copied plans to construct other buildings."

It is assumed, for the purposes of this discussion of copyright law, that the building is not protected by a patent, by trade identity law, or by trade secret law.

[n62] 379 F.2d 84 (6th Cir. 1967).

[n63] *Scholz Homes v. Maddox*, 379 F.2d at 85-86. Accord 1 *Nimmer on Copyright* § 2.18[C][2].

[n64] 379 F.2d at 86.

[n65] *Id.*

[n66] *Id.* at 86-87.

[n67] But cf. *Kent v. Revere*, 229 U.S.P.Q. 828 (M.D.Fla. 1985) (copying from a promotional brochure which has a copyright notice and contains an extract of the copyrighted plans is copyright infringement); *Herman Frankel Org. v. Tegman*, 367 F. Supp. 1051, 184 U.S.P.Q. 819 (E.D. Mich. 1973), discussed *infra* this section.

[n68] 458 F.2d 895 (5th Cir. 1972).

[n69] *Imperial Homes Corp. v. Lamont*, 458 F.2d at 899.

[n70] Accord *Donald Frederick Evans & Assocs. v. Continental Homes, Inc.*, 785 F.2d 897, 229 U.S.P.Q. 321, 325 (11th Cir. 1986).

See also *Kent v. Revere*, 229 U.S.P.Q. 828 (M.D. Fla. 1985) (infringement found where copying was from promotional brochure which had its own copyright notice).

[n71] 367 F. Supp. 1051 (E.D. Mich. 1973).

[n72] *Herman Frankel Org. v. Tegman*, 367 F. Supp. at 1053 (emphasis added).

[n73] *Herman Frankel Org. v. Tegman*, 367 F. Supp. at 1054.

[n74] 17 U.S.C. § 106(3).

In *May v. Bray*, 30 Copyright Office Bulletin 435 (S.D. Cal. 1955), such sale was expressly enjoined in a consent decree.

[n75] 680 F. Supp. 658, 6 U.S.P.Q.2d 1737 (S.D.N.Y. 1988) (preliminary injunction granted), subsequent proceedings, 8 U.S.P.Q.2d 1130 (S.D.N.Y. 1988) (permanent injunction granted), subsequent proceedings, 8 U.S.P.Q.2d 1917 (S.D.N.Y. 1988). This important case is fully discussed below in this section.

[n76] But cf. the other recent case of *Acorn Structures, Inc. v. Swantz*, 657 F. Supp. 70, 2 U.S.P.Q.2d 1632 (W.D. Va. 1987) (use of copyrighted plans for erecting a building is not copyright infringement, nor is preparation of derivative plans nor filing with local building department, since these are necessary incidents of construction, citing *Baker v. Selden* (dictum), *rev'd* on other grounds, 6 U.S.P.Q.2d 1810 (4th Cir. 1988). The cited dictum, however, is lacking in analysis; and it fails to deal with the contrary rulings in the earlier cases of *Scholz*, *Imperial* and *Tegman*. Moreover, it was subsequently reversed

without any mention of the substantive copyright infringement issue by the appellate court.

[n77] But cf. *Jones Assocs., Inc. v. Nino Homes*, 686 F. Supp. 160, 4 U.S.P.Q.2d 1391, 1392 (E.D. Mich. 1987) (owner of copyright on architectural plans posted a notice in model home warning visitors that floor plan was copyrighted), *aff'd* in this respect, 858 F.2d 274, 8 U.S.P.Q.2d 1224 (6th Cir. 1988).

[n78] 680 F. Supp. 658, 6 U.S.P.Q.2d 1737 (S.D.N.Y. 1988), subsequent proceedings, 8 U.S.P.Q.2d 1130 (S.D.N.Y. 1988), subsequent proceedings, 8 U.S.P.Q.2d 1917 (S.D.N.Y. 1988).

[n79] 1 *Nimmer on Copyright* § 2.18[C][1], at 2-200 (1989).

[n80] 8 U.S.P.Q.2d 1917, 1919 (S.D.N.Y. 1988).

[n81] Cf. *Jones Assocs., Inc. v. Nino Homes*, 858 F.2d 274, 8 U.S.P.Q.2d 1224, 1230 (6th Cir. 1988), where the court ruled that, since under the principle of *Baker v. Selden* as it applied prior to the statutory amendment of December 1, 1990, the infringing act was the copying of copyrighted plans, not the construction of uncopyrighted homes from those plans, no attorney fees could be awarded where the defendant's illegal copying of the plaintiff's plans occurred outside the statutory time window for attorney fees, even though the defendant's construction of at least some of its homes from the copied plans was started within that time window.

[n82] Cf. *Jones Assocs., Inc. v. Nino Homes*, 858 F.2d 274, 8 U.S.P.Q.2d 1224 (6th Cir. 1988), awarding damages for the defendant's use of infringing copies of plaintiff's architectural drawings to build a house, on the ground that: "The rule which emerges from these cases [*Baker v. Selden*, *Scholz*, *Imperial*, *Tegman*, *Demetriades* and *Muller*] is that one may construct a house which is identical to a house depicted in copyrighted architectural plans, but one may not directly copy those plans and then use the infringing copy to construct the house."

[n83] See § [9][c][iv], *infra*.

[n84] See § [9][d][ii], *infra*.

[n85] Published by the U.S. Copyright Office on June 19, 1989.

[n86] See the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 6:

In the wake of Berne adherence, Chairman Robert W. Kastenmeier (Chairman of the Subcommittee on Courts, Intellectual Property, and the Administration of Justice) asked the Copyright Office to conduct a study of the architectural works protection issue. In response, Register of Copyrights, Ralph Oman, presented a report of the Copyright Office study to Chairman Kastenmeier at a June 19, 1989, press conference in the Madison Building of the Library of Congress. The report concluded that while architectural blueprints, plans, drawings, and models relating to works of architecture are adequately protected by U.S. copyright law, the adequacy of protection under Berne Convention standards for the constructed design of architectural structures remains in doubt.

During the 101st Congress, two bills were introduced by Chairman Kastenmeier to address the Register's concerns: H.R. 3990 (the "Architectural Works Copyright Protection Act of 1990"); and H.R. 3991 (the "Unique Architectural Structures Copyright Act of 1990").

On March 14, 1990, the Subcommittee held a legislative hearing during which testimony was received from the following witnesses: a well-known American architect (Michael Graves, FAIA); the Register of Copyrights (Ralph Oman); an Administration witness (Honorable Jeffrey M. Samuels); the American Institute of Architects (David A. Daileida, AIA); and The Frank Lloyd Wright Foundation (Richard Carney, Managing Trustee, Chief Executive Officer). Written statements were received from the American Consulting Engineers Council and the American Society of Magazine Photographers.

Following this hearing, on August 3, 1990, Mr. Kastenmeier, joined by Mr. Synar and Mr. Moorhead, introduced revised provisions protecting architectural works as Title III of H.R. 5498, the omnibus copyright reform measure referred to above. In this form, the proposal was marked up by the Subcommittee on September 14, 1990, and a quorum of Members being present, ordered the bill favorably reported to the full Committee by voice with no objections being heard. [Footnotes omitted.]

See also *id.* at 10:

"The Architectural Works Protection Act of 1990 is [the] result of United States adherence to the Berne Convention for the Protection of Literary and Artistic Works."

[n87] Title VII of The Judicial Improvements Act of 1990, Pub. Law 101-650, 104 Stat. 5089 (effective Dec. 1, 1990).

[n88] See § [1][b], *supra*.

[n89] See § [8], *infra*.

[n90] See § [4], *infra*.

[n91] See § [5], *infra*.

[n92] 17 U.S.C. § 101 *et seq.*

[n93] See 1 Nimmer on Copyright § 2.02.

[n94] 17 U.S.C. § 301(a).

[n95] 17 U.S.C. § 301(b).

[n96] See 1 Nimmer on Copyright § 2.02.

[n97] Former Title 17 of U.S. Code.

[n98] See generally 1 Nimmer on Copyright § 4.13.

[n99] See generally 1 Nimmer on Copyright § 4.13.

[n100] See 1 Nimmer on Copyright § 2.02.

The applicable federal copyright statute is the one which was in effect on the date when the defendant's allegedly infringing architectural plans were created. *Meltzer v. Zoller*, 520 F. Supp. 847, 854 (D.N.J. 1981).

[n101] 17 U.S.C. § 101 *et seq.*

[n102] 17 U.S.C. § 301.

[n103] 17 U.S.C. § 302.

[n104] 17 U.S.C. § 303.

[n105] 17 U.S.C. § 401(a); *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170, 181 (W.D. Tex. 1983).

But it did no harm to put a copyright notice on an unpublished work, since such notice did not constitute a representation that the work had been published and did not estop the copyright proprietor from maintaining that it had not been published. *Technicon Medical Information Sys. Corp. v. Green Bay Packaging, Inc.*, 215 U.S.P.Q. 1001 (7th Cir. 1982). Cf. *Management Science Am., Inc. v. Cyborg Sys., Inc.*, 6 Computer Law Service Reporter 921 (N.D. Ill. 1978) (copyright notice does not bar trade secret protection).

In the event that there is some doubt as to whether a contemplated distribution is a general publication, it may be a prudent precaution to employ such a notice in case that question should later be decided in the affirmative.

[n106] The proper form and placement of notice is prescribed by 17 U.S.C. § 401.

[n107] 17 U.S.C. § 401; *Bell v. Combined Registry Co.*, 397 F. Supp. 1241, 1248 (N.D. Ill. 1975), *aff'd*, 536 F.2d 164 (7th Cir.), *cert. denied*, 97 S. Ct. 530 (1976).

The 1976 Act does include remedial provisions, 17 U.S.C. § 405(a), which make it possible to cure the omission of copyright notice from published copies. *Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co.*, 542 F. Supp. 252, 260 n.4 (D. Neb. 1982) (dictum, because there was no publication in that case). For example, some courts have held that it is only necessary to attach notice to copies distributed after discovery of lack of notice. *Innovative Concepts in Entertainment, Inc. v. Entertainment Enters., Ltd.*, 576 F. Supp. 457, 221 U.S.P.Q. 376 (E.D.N.Y. 1983); *O'Neill Devs., Inc. v. Galen Kilburn, Inc.*, 524 F. Supp. 710, 216 U.S.P.Q. 1123 (N.D. Ga. 1981); *Sherry Mfg. Co. v. Towel King of Fla., Inc.*, 220 U.S.P.Q. 855 (S.D. Fla. 1983). But § 405(a)'s remedial provisions are not guaranteed to work. See, e.g., *Donald Frederick Evans & Assocs. v. Continental Homes, Inc.*, 785 F.2d 897, 229 U.S.P.Q. 321 (11th Cir. 1986) (the remedial efforts in this case were held inadequate to repair the effects of publication of architectural drawings without copyright notice); *Beacon Looms, Inc. v. S. Lichtenberg & Co., Inc.*, 552 F. Supp. 1305 (S.D.N.Y. 1982); *Shapiro & Son Bedspread Corp. v. Royal Mills Assocs.*, 568 F. Supp. 972 (S.D.N.Y. 1983), *aff'd in part, rev'd in part*, 764 F.2d 69 (2d Cir. 1985) (dismissal of plaintiff's claim for copyright infringement was reversed and remanded for further proceedings on the question of the reasonableness of plaintiff's efforts to cure defective copyright notice packaged with its goods).

[n108] See Berne Convention Implementation Act of 1988, Pub. L. No. 100- 568, 102 Stat. 2853 (1988).

[n109] See 17 U.S.C. § 401(d), denying the defendant mitigation of damages on the basis of the innocent infringer defense, where the plaintiff's work was published with proper copyright notice.

In this connection, an interesting question is raised by the Architectural Works Copyright Protection Act of 1990, which provides for copyright protection on building designs (see § [1][b], supra): Should a building which embodies a copyrighted design have a copyright notice in order to qualify under § 401(d)? If so, where should the notice be placed? On the exterior of the building where it is visible to passers-by? Or if the floor plan and/or other interior features are protected, should the copyright notice be placed in the lobby? Perhaps, to be safe, a copyright notice should be affixed at least to the exterior of the building, and to the lobby as well if interior features are covered by copyright.

As to buildings which were constructed without a copyright notice prior to the effective date of the new act, the lack of a copyright notice on such buildings does not matter because the architectural designs which they embody are not covered by the Architectural Works Copyright Protection Act of 1990 (see § [2], supra). As to architectural plans or drawings or models which are covered by copyright, but which represent older buildings not covered by the Architectural Works Copyright Protection Act, no copyright notice was required on the building itself, in order to preserve the copyright in a two-dimensional or scale model representation, because under the previous law the full-size building was not considered a copy of the copyrighted work (see § [8], infra).

As to whether the pre-1990 construction of a full-sized three-dimensional building was a publication of the plans or drawings or a scale model representing that building, which would divest copyright in the plans, drawings or model under the law which existed prior to March 1, 1989, when copyright notice was compulsory, see cases going both ways in § [3][b][ii] infra.

[n110] In addition, publication determines eligibility for statutory damages, see § [8][d][i] infra, and attorney fees, see § [8][d][iii] infra, under the federal Copyright Act.  
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[n111] *Smith v. Paul*, 174 Cal. App. 2d 744, 345 P.2d 546, 77 A.L.R.2d 1036 (1959); *Weinstock, Lubin & Co. v. Marks*, 109 Cal. 529, 42 P. 142, 30 L.R.A. 182 (1895); *Gendell v. Orr*, 13 Phila. 191 (Pa. Common Pleas 1879).

Contra *Donald Frederick Evans & Assocs. v. Continental Homes, Inc.*, 785 F.2d 897, 229 U.S.P.Q. 321, 323 n.7 (11th Cir. 1986).

[n112] *Wright v. Eisle*, 86 A.D. 356, 83 N.Y.S. 887 (1903), overruled, *Shaw v. Williamsville Manor, Inc.*, 38 A.D.2d 442, 174 U.S.P.Q. 277 (1972).

Contra *DeSilva Constr. Corp. v. Herrald*, 213 F. Supp. 184 (M.D. Fla. 1962).

[n113] DeSilva Constr. Corp. v. Herral, 213 F. Supp. 184 (M.D. Fla. 1962); Read v. Turner, 239 Cal. App. 2d 504, 48 Cal. Rptr. 919 (1966); Shanahan v. Macco Constr. Co., 224 Cal. App. 2d 327, 36 Cal. Rptr. 584 (1964); Kurfiss v. Cowherd, 121 S.W.2d 282 (Mo. Ct. App. 1938).

[n114] Shanahan v. Macco Constr. Co., Inc., 224 Cal. App. 2d 327, 36 Cal. Rptr. 584 (1964).

[n115] DeSilva Constr. Corp. v. Herral, 213 F. Supp. 184 (M.D. Fla. 1962); Wright v. Eisle, 86 A.D. 356, 83 N.Y.S. 887 (1903), overruled, Shaw v. Williamsville Manor, Inc., 38 A.D.2d 442, 174 U.S.P.Q. 277 (1972); Ballard H.T. Kirk & Assocs. v. Poston, 33 Ohio App. 2d 117, 293 N.E.2d 102 (1972).

[n116] DeSilva Constr. Corp. v. Herral, 213 F. Supp. 184, 195 (M.D. Fla. 1962).

[n117] In Technicon Medical Information Sys. Corp. v. Green Bay Packaging, Inc., 215 U.S.P.Q. 1001 (7th Cir. 1982), it was held that putting a copyright notice on an unpublished work does not constitute a representation that the work has been published and does not estop the copyright proprietor from maintaining that it has not been published.

See also Management Science Am., Inc. v. Cyborg Sys., Inc., 6 Computer Law Service Reporter 921 (N.D. Ill. 1978) (copyright notice does not bar trade secret protection).

[n118] DeSilva Constr. Corp. v. Herral, 213 F. Supp. 184 (M.D. Fla. 1962); Shanahan v. Macco Constr. Co., 224 Cal. App. 2d 327, 36 Cal. Rptr. 584 (1964); Ballard H.T. Kirk & Assocs. v. Poston, 33 Ohio App. 2d 117, 293 N.E.2d 102 (1972).

[n119] Donald Frederick Evans & Assocs. v. Continental Homes, Inc., 785 F.2d 897, 229 U.S.P.Q. 321 (11th Cir. 1986); DeSilva Constr. Corp. v. Herral, 213 F. Supp. 184 (M.D. Fla. 1962) (newspaper advertisement); Shanahan v. Macco Constr. Co., Inc., 224 Cal. App. 2d 327, 36 Cal. Rptr. 584 (1964) (sales brochures and magazine articles).

A work published as part of a larger work, such as a magazine or newspaper, is generally protected by the magazine or newspaper publisher's copyright notice. 17 U.S.C. § 404(b). Donald Frederick Evans & Assocs. v. Continental Homes, Inc., 785 F.2d 897, 229 U.S.P.Q. 321, 328 (11th Cir. 1986) (magazine feature article about architectural award protected by magazine publisher's copyright notice). But advertisements are an exception to that rule. 17 U.S.C. § 404(a). Therefore, an excerpt from a set of architectural plans published in a newspaper advertisement must have its own copyright notice, or it will be a divestive publication. Donald Frederick Evans & Assocs. v. Continental Homes, Inc., 785 F.2d 897, 229 U.S.P.Q. 321, 327 (11th Cir.

1986) (contents of paid real estate supplement not protected by newspaper publisher's copyright notice).

If the publication is unauthorized by the copyright proprietor, there is no divestiture. 17 U.S.C. § 401(a). But if the copyright proprietor knows about the publication and does nothing to halt it, it is implicitly authorized. *Donald Frederick Evans & Assocs. v. Continental Homes, Inc.*, 785 F.2d 897, 229 U.S.P.Q. 321, 329 (11th Cir. 1986).

Cf. 17 U.S.C. § 405(a)(3): an express written requirement that publication must be with notice will prevent divestiture.

[n120] *Read v. Turner*, 239 Cal. App. 2d 504, 48 Cal. Rptr. 919 (1966); *Shanahan v. Macco Constr. Co.*, 224 Cal. App. 2d 327, 36 Cal. Rptr. 584 (1964).

But cf. *Kisling v. Rothschild*, 212 U.S.P.Q. 717 (Fla. Dist. Ct. App. 1980) (not a general publication where plans were lent to prospective purchaser of house for personal viewing by purchaser and his wife).

[n121] *Demetriades v. Kaufmann*, 680 F. Supp. 658, 6 U.S.P.Q.2d 1737 (S.D.N.Y. 1988), subsequent proceedings, 8 U.S.P.Q.2d 1130 (S.D.N.Y. 1988), subsequent proceedings, 8 U.S.P.Q.2d 1917 (S.D.N.Y. 1988); *Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co.*, 542 F. Supp. 252 (D. Neb. 1982); *Masterson v. McCroskie*, 573 P.2d 547 (Colo. 1978) (submitting plans to local officials and also to private developer for approval is not publication); *Krahmer v. Luing*, 127 NJ Super 270, 317 A2d 96, 182 U.S.P.Q. 494 (1974); *Shaw v. Williamsville Manor, Inc.*, 38 A.D.2d 442, 174 U.S.P.Q. 277 (1972); *Ashworth v. Glover*, 20 Utah 2d 85, 433 P.2d 315, 156 U.S.P.Q. 219 (1967); *Edgar H. Wood Assoc., Inc. v. Skene*, 197 N.E.2d 886 (1964); *Smith v. Paul*, 174 Cal. App. 2d 744, 345 P.2d 546, 77 A.L.R.2d 1036 (1959); *Kisling v. Rothschild*, 212 U.S.P.Q. 717 (Fla. Dist. Ct. App. 1980); *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170 (W.D. Tex. 1983); *Intown Enterprises, Inc. v. Barnes*, 721 F. Supp. 1263, 1266, 1989 U.S. Dist. LEXIS 11393, 11 U.S.P.Q.2d 1364 (N.D. Ga. 1989); *East/West Venture v. Wurmfeld Associates, P.C.*, 722 F. Supp. 1064, 1989 U.S. Dist. LEXIS 12008, 13 U.S.P.Q.2d 1908, 1909 (S.D.N.Y. 1989).

*Accord MacMillan Co. v. I.V.O.W. Corp.*, 495 F. Supp. 1134 (D. Vt. 1980) (showing plans to banker to obtain financing, and to present tenants to obtain their approval, is not publication).

[n122] *Smith v. Paul*, 174 Cal. App. 2d 744, 345 P.2d 546, 77 A.L.R.2d 1036 (1959) ("[T]he fact that a building is... open to the gaze of the public... may be a publication of the general design or idea of the building but not a publication of the exact plans whereby another may without effort... duplicate the [architect's work]."); *Aitken, Hazen, Hoffman, Miller P.C. v. Empire Constr. Co.*, 542 F. Supp. 252 (D. Neb. 1982); *Masterson v. McCroskie*, 573 P.2d 547 (Colo. 1978) (construction of a building is not even a publication of exterior features); *Seay v. Vialpando*, 567 P.2d 285 (Wyo. 1977) (dictum); *Krahmer v. Luing*, 127 NJ Super 270, 317 A2d 96, 182 U.S.P.Q. 494 (1974); *Wallace v. Helm*, 161 U.S.P.Q. 121 (Cal. Ct. App. 1969); *Edgar H. Wood Assoc., Inc. v. Skene*, 197

N.E.2d 886 (Mass. 1964); *Intown Enterprises, Inc. v. Barnes*, 721 F. Supp. 1263, 1266, 1989 U.S. Dist. LEXIS 11393, 11 U.S.P.Q.2d 1364 (N.D. Ga. 1989).

[n123] *Donald Frederick Evans & Assocs. v. Continental Homes, Inc.*, 785 F.2d 897, 229 U.S.P.Q. 321, 323 n.7 (11th Cir. 1986); *Nucor Corp. v. Tennessee Forging Steel Serv., Inc.*, 476 F.2d 386 (8th Cir. 1973).

[n124] *Nucor Corp. v. Tennessee Forging Steel Serv., Inc.*, 476 F.2d 386 (8th Cir. 1973); *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170 (W.D. Tex. 1983); *Masterson v. McCroskie*, 573 P.2d 547 (Colo. 1978); *Seay v. Vialpando*, 567 P.2d 285 (Wyo. 1977); *Intown Enterprises, Inc. v. Barnes*, 721 F.Supp. 1263, 1266, 1989 U.S. Dist. LEXIS 11393, 11 U.S.P.Q.2d 1364 (N.D. Ga. 1989).

See *Ashworth v. Glover*, 20 Utah 2d 85, 433 P.2d 315, 156 U.S.P.Q. 219 (1967). In this case the copyright proprietor charged a refundable \$25 deposit to encourage return of the plans. The defendant argued that, since the contractors were free to keep the drawings if they were willing to give up their \$25, this constituted an outright sale of the drawings and a divestive publication. The court rejected that argument. The result seems sound, since the contractors would have been even freer to keep the drawings in the absence of the deposit arrangement.

[n125] *Nucor Corp. v. Tennessee Forging Steel Serv., Inc.*, 476 F.2d 386 (8th Cir. 1973); *Herman Frankel Org. v. Wolfe*, 367 F. Supp. 1067, 184 U.S.P.Q. 819 (E.D. Mich. 1974); *Ga-on Homes, Inc. v. Spitzer Homes, Inc.*, 178 U.S.P.Q. 183 (M.D. Fla. 1973); *Herman Frankel Org. v. Tegman*, 367 F. Supp. 1051 (E.D. Mich. 1973).

[n126] *Kisling v. Rothschild*, 212 U.S.P.Q. 717 (Fla. Dist. Ct. App. 1980); *Krahmer v. Luig*, 127 NJ Super 270, 317 A2d 96, 182 U.S.P.Q. 494 (1974).

[n127] See § [3][a][ii], *supra*, the subsection entitled "Published Works".

[n128] Pub. L. No. 100-568, 102 Stat. 2853 (1988), effective March 1, 1989.

[n129] Under 17 U.S.C. § 401(a) as amended, notice is no longer mandatory; it provides that "a notice of copyright ... may be placed on publicly distributed copies..." (emphasis supplied). 17 U.S.C. § 405(a) as amended applies only to works published before the effective date of the Berne amendments.

[n130] 17 U.S.C. § 405(b) as amended applies only to works published before the effective date of the Berne amendments.

[n131] 17 U.S.C. § 401(d), cross-referencing the last sentence of 17 U.S.C. § 504(c)(2), subsections (i) and (ii).

[n132] See § [3][b][ii], supra.

[n133] The proper form and placement of notice is prescribed by 17 U.S.C. § 401.

[n134] Cf. *Kent v. Revere*, 229 U.S.P.Q. 828, 829 (M.D. Fla. 1985), where the proprietor of a copyright on architectural drawings took the precaution of putting copyright notice on all of his plans and all of his promotional brochures which contained extracts from the plans (renderings and floor plans). He successfully sued for infringement of the copyright on the drawings.

[n135] The Architectural Works Copyright Protection Act is Title VII of The Judicial Improvements Act of 1990, Pub. Law 101-650, 104 Stat. 5089 (effective Dec. 1, 1990).

[n136] See the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 18, note 36.

[n137] 17 U.S.C. § 201(a).

[n138] See *Krahmer v. Luig*, 127 N.J. Super. 270, 317 A2d 96, 182 U.S.P.Q. 494 (1974). But there the architect did not contest the client's claim of joint ownership.

See also *Johnstone v. Fox*, 4 U.S.P.Q.2d 1229, 1232 (N.D. Ill. 1987) (recognizing the possibility that a client who participated in the design may be a joint author, but declining to decide the issue on the client's motion for summary judgment).

[n139] See § [1][b] and the introductory portion of § [2], supra.

[n140] 542 F. Supp. 252, 259 (D. Neb. 1982) (applying the federal Copyright Act of 1976); accord *MacMillan Co. v. I.V.O.W. Corp.*, 495 F. Supp. 1134, 1144 n. 11 (D. Vt. 1980) (applying Vermont common law).

[n141] 903 F.2d 1486, 1493, 1990 U.S. App. LEXIS 10077, 15 U.S.P.Q.2d 1282, 1287-88, 16 F.R. Serv. 3d 1441 (11th Cir. 1990).

[n142] This last paragraph of the quotation from the M.G.B. Homes case, *supra*, accords with *Ashton-Tate Corp. v. Ross*, 916 F.2d 516, 1990 U.S. App. LEXIS 17435 (9th Cir. 1990) (a joint work requires that each joint author's contribution be independently copyrightable) (not an architectural case).

Accord, *Designer's View, Inc. v. Publix Super Markets, Inc.*, 764 F. Supp. 1473, 1991 U.S. Dist. LEXIS 6862, 20 U.S.P.Q.2d 1223, 1224-26 (S.D. Fla. 1991) (client of designer held not a joint author of simulated stained-glass window merely because client suggested use of cornucopia of fruits and vegetables and bakery products as thematic material which was included in design for supermarket window).

[n143] 230 U.S.P.Q. 678 (M.D. Fla. 1986), *aff'd* without opinion, 811 F.2d 609 (11th Cir.), *cert. denied*, 108 S. Ct. 88 (1987).

[n144] *Id.*, 230 U.S.P.Q. at 680.

[n145] See § [5], *infra*.

[n146] 17 U.S.C. § 201(b).

[n147] See § [5], *infra*.

[n148] 17 U.S.C. § 101.

[n149] 17 U.S.C. § 101; see paragraph (1) of the definition of "work for hire."

[n150] *Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co.*, 542 F. Supp. 252, 257-58 (D. Neb. 1982). The reasoning of the *Aitken* case, but not its result, was criticized in Hardy, *Copyright Law's Concept of Employment- What Congress Really Intended*, 35 J. Copyright Soc'y 210, 253-55 (1988).

See also *May v. Morganelli-Heumann & Assocs.*, 618 F.2d 1363, 1368 n.4, 207 U.S.P.Q. 476, 480 n.4 (9th Cir. 1980) (*dictum*).

See also *Meltzer v. Zoller*, 520 F. Supp. 847, 854 (D.N.J. 1981), where the relationship was simply assumed to be that of an independent contractor and not that of an employee.

[n151] Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co., supra, 542 F. Supp. 252, 258 (D. Neb. 1982).

Accord *Joseph J. Legat Architects, P.C. v. U.S. Dev. Corp.*, 229 U.S.P.Q. 132, 135-36 (N.D. Ill. 1985) (the pivotal question in determining whether the architect is an employee is whether the client had the right to direct and supervise the manner in which the work is performed; the client's contractual right to prescribe features of the design and to approve or veto the plans does not render him an employer). The reasoning of the Legat case, but not its result, was criticized in Hardy, *Copyright Law's Concept of Employment-What Congress Really Intended*, 35 J. Copyright Soc'y 210, 254-55 (1988).

[n152] Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co., 542 F. Supp. 252, 258 (D. Neb. 1982).

But cf. *Johnstone v. Fox*, 4 U.S.P.Q.2d 1229, 1232-33 (N.D. Ill. 1987) (an independent contractor architectural draftsman is an employee of an architectural designer for the purposes of the copyright work for hire doctrine, thus making the designer the author of the draftsman's work, if the draftsman was controlled and supervised by the designer). The court held that the designer had made a sufficient showing of control to avoid summary judgment.

[n153] Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co., 542 F. Supp. 252, 258 (D. Neb. 1982).

The Aitken case, supra this note, was followed in this respect by *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1990 U.S. App. LEXIS 10077, 15 U.S.P.Q.2d 1282, 1287, 16 F.R. Serv. 3d 1441 (11th Cir. 1990).

[n154] 903 F.2d 1486, 1492, 1990 U.S. App. LEXIS 10077, 15 U.S.P.Q.2d 1282, 1287, 16 F.R. Serv. 3d 1441 (11th Cir. 1990).

[n155] 490 U.S. 730, 109 S. Ct. 2166, 104 L. Ed. 2d 811, 10 U.S.P.Q.2d 1985 (1989).

[n156] 17 U.S.C. § 101; see paragraph (2) of the definition of "work for hire."

[n157] Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co., 542 F. Supp. 252, 257 (D. Neb. 1982):

[T]he architectural plans in question are not a commissioned work as defined by § 101, because they do not fall within any of the listed categories and because there was no written agreement between the parties that the plans should be considered a work made for hire. Thus, in order for the defendant [client] to prevail on its claim that the... plans

were a work made for hire with copyright ownership vesting in [the client], it is necessary that the relationship between [the client] and the [architect] be an employer-employee relationship, as opposed to an employer-independent contractor relationship. If it is the former, copyright ownership will vest in [the client]; if it is the latter, copyright ownership will vest in the [architect].

*Meltzer v. Zoller*, 520 F. Supp. 847, 855 (D.N.J. 1981) ("architectural plans do not fall within one of the statutorily prescribed categories of work. Nor does there exist the requisite express written agreement between plaintiff and the architect designating the architectural plans as a work for hire.").

*M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1492, 1990 U.S. App. LEXIS 10077, 15 U.S.P.Q.2d 1282, 1287, 16 F.R. Serv. 3d 1441 (11th Cir. 1990): "architectural drafting does not fall within the nine enumerated categories of activities which may be done by independent contractors 'for hire'"

Cf. *Wright v. Eisle*, 86 A.D. 356, 83 N.Y.S. 887, 889 (1903) ("[A]ll the property rights in these plans... belonged to [the client], rather than to the [architect]..." (under prior law)), overruled on other grounds, *Shaw v. Williamsville Manor, Inc.*, 38 A.D.2d 442, 174 U.S.P.Q. 277 (1972).

[n158] 17 U.S.C. § 201(d).

[n159] See § [5], *infra*.

[n160] 17 U.S.C. § 204(a).

[n161] 17 U.S.C. § 205(c).

[n162] *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170, 178-79 (W.D. Tex. 1983).

[n163] 17 U.S.C. § 202.

Even though the standard AIA contract gives the client the right to copy and use the plans as necessary to construct the building, it is an infringement of the architect's copyright for the client to file the plans with the local building authorities under the name of another architect. *Joseph J. Legat Architects, P.C. v. U.S. Dev. Corp.*, 229 U.S.P.Q. 132, 134-35, 140 and n.14 (N.D. Ill. 1985). This case also held that such conduct may be a violation of the law of trade identity confusion.

[n164] See § [3][b][ii], *supra*.

[n165] See § [1][b] and the introductory portion of § [2].

[n166] See the introductory portion of § [2].

[n167] 17 U.S.C. § 302(a).

[n168] 17 U.S.C. § 302(b).

[n169] 17 U.S.C. § 302(c).

[n170] 17 U.S.C. § 303, 304.

[n171] See § [1][b] above.

[n172] For which see the introductory portion of § [2].

[n173] § 706(2) of the Architectural Works Copyright Protection Act provides that:

The amendments made by this title apply to-

(2) any architectural work that, on the date of the enactment of this Act, is unconstructed and embodied in unpublished plans or drawings, except that protection for such architectural work under title 17, United States Code, by virtue of the amendments made by this title, shall terminate on December 31, 2002, unless the work is constructed by that date.

See the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 24-25:

This provision does, however, raise the question of term of protection. To aid copyright owners, the public, and the courts, the Committee believes it would be helpful to explain in some detail the various terms of protection that will vest under the bill.

Architectural Works created on or after the date of enactment

These works will be governed by section 302 of title 17, United States Code: that is, works created by individuals will have a copyright measured by the life of the author plus 50 years; works created under a work-made-for-hire arrangement, anonymously, or under a pseudonym will have a copyright measured from 100 years from creation or 75 years from publication, whichever occurs first. The Committee considered, but rejected, amending the Copyright Act to provide a special definition of publication of an architectural work. Instead, the general definition in section 101, title 17, United States Code, will apply.

### Architectural Works unconstructed on the date of enactment

The term of protection for architectural works unconstructed on the date of enactment and embodied in unpublished plans or drawings will be governed by sections 302 and 303 of title 17, United States Code. In order to encourage authors of architectural works to construct their unpublished creations, a provisional cut-off date of December 31, 2002, has been provided: works that would ordinarily be eligible for a term of protection continuing past that date will lose protection on that date if the architectural work has not been constructed. The actual term will vary depending upon a number of factors, including whether the work was created by an individual, or under a work-made-for-hire arrangement, or whether the work is published before December 31, 2002, but two basic categories may be identified. Within each category, two examples are given, illustrating the relevant principle governing the calculation of term.

1. Works created by individuals.-These works will be governed in the first instance by the life plus 50 years post mortem auctoris term in section 302 of title 17, United States Code:

A. Author dies in 1990. Term will expire in 2040 under section 302; however, under the bill the term will expire on December 31, 2002 unless the architectural work is constructed by that date.

B. Author died in 1940. Under section 303, the term will expire on December 31, 2002, unless the architectural work is constructed and published before that date, in which case protection will expire on December 31, 2027.

2. Works created under work-made-for-hire.-These works will be governed in the first instance by the term set forth in section 302 of title 17, United States Code: 100 years from the date of creation; the 75 year term for published works made-for-hire will not apply, since the provisions of section 6 of the proposed legislation are limited to architectural works that are unconstructed on the date of enactment.

A. Work is created in 1902. Term will expire on December 31, 2002, unless the work is constructed and published before that date, in which case the term will expire on December 31, 2027.

B. Work is created in 1950. Term will expire 2050, unless the work is not constructed by December 31, 2002, in which case protection will expire on that date.

According to the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 24, note 56, "The definition of 'publication' in the 1976 Copyright Act is to be used in making these determinations." This definition says that "Publication' is the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or photorecords for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication." Id. at 24, note 54. According to id. at 24, note 56: "Since architectural plans and drawings represent a separate category of authorship from architectural works, publication of plans and drawings is not publication o[f] an architectural work."

[n174] See the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 24, note 56:

... The term of protection for the plans and drawings embodying the architectural work is unaffected by this bill....

[n175] 17 U.S.C. § 203. For pre-1978 copyrights, see 17 U.S.C. § 304(c).

[n176] The grantor cannot divest himself of his right to terminate the grant; 17 U.S.C. § 203(a)(5).

[n177] 17 U.S.C. § 203(b)(6).

[n178] 17 U.S.C. § 203(a).

[n179] See § [4][b], *supra*.

[n180] 17 U.S.C. § 203(a)(3). But the termination is effected by a notice served within a prescribed time period prior to the effective date of the termination; 17 U.S.C. § 203(a)(4).

[n181] 317 U.S.C. § 203(b)(1).

[n182] 17 U.S.C. § 106(2).

[n183] Cf. § [2], *supra*, to understand why such a ruling is considered unlikely.

[n184] § [4][d], *supra*.

[n185] Title VII of The Judicial Improvements Act of 1990, Pub. Law 101- 650, 104 Stat. 5089 (effective Dec. 1, 1990).

[n186] § [3], *supra*.

[n187] See § [3][b], *supra*.

[n188] 17 U.S.C. § 411(a). Under an amendment to this section which took effect March 1, 1989, however, certain foreign-originated copyrighted works are exempted from this requirement.

But cf. *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1990 U.S. App. LEXIS 10077, 15 U.S.P.Q.2d 1282, 1284-85, 16 F.R. Serv. 3d 1441 (11th Cir. 1990) (refusing to dismiss for lack of jurisdiction, where suit was filed while application for copyright registration was pending, and the registration did later issue).

[n189] 17 U.S.C. § 408(a).

[n190] 17 U.S.C. § 409.

When an author copies a substantial amount of the subject matter of a work from a previously created work, either his own or someone else's, the copyright on the later work must be limited to whatever subject matter the later work does not have in common with the earlier work; otherwise the subject matter derived from the earlier work does not have the originality required for copyright. 17 U.S.C. § 102(a). Therefore, when applying for copyright registration, a deliberate failure to notify the Copyright Office of the relationship between the earlier work and the work for which registration is being sought could constitute fraud, and may invalidate the copyright. For this reason, it is advisable to pass such information along to the Copyright Office by filling in the appropriate place on the application form. This principle applies to architectural works. Cf. *Donald Frederick Evans & Assocs. v. Continental Homes, Inc.*, 785 F.2d 897, 229 U.S.P.Q. 321, 325 (11th Cir. 1986), where this problem was avoided because the defendant failed to prove that the omission of that information was intentional or purposeful.

[n191] 17 U.S.C. § 708(a)(1).

[n192] 17 U.S.C. § 408(b).

In the case of bulky architectural models, discussed in § [1][a], *supra*, an optional deposit of photographs or drawings will probably be acceptable instead of three-dimensional copies, pursuant to 17 U.S.C. § 407(c) and § 408(c)(1).

In the case of building designs, discussed in § [1][b] and the introductory portion of § [2], *supra*, drawings or photographs will undoubtedly be acceptable in view of the practicalities. Moreover, under § 101 of the copyright statute as now amended "the design of a building" can be "embodied in any tangible medium of expression, including a building, architectural plans, or drawings." (Emphasis supplied.) 17 U.S.C. § 101, the definition of "architectural work," added by § 702(a) of the Architectural Works Copyright Protection Act, Title VII of The Judicial Improvements Act of 1990, Pub. Law 101-650, 104 Stat. 5089 (effective Dec. 1, 1990). This language suggests that architectural plans or drawings showing a copyrighted building design qualify in their own right as tangible embodiments of the copyrighted design, along with the building

itself. Therefore they should not even be considered "optional deposits" under the provisions of 17 U.S.C. § 407(c) and § 408(c)(1).

[n193] But it would be advisable to put the statutorily acceptable form of copyright notice on all copies of the work which are distributed, in case such distribution should later be ruled a "general publication." See § [3], supra.

[n194] The Rules of the Copyright Office contain provisions for rapid registration in such situations.

[n195] 17 U.S.C. § 412(1).

[n196] 17 U.S.C. § 412(2).

[n197] See § [3], supra.

[n198] 17 U.S.C. § 407.

[n199] See § [3][b][ii], supra.

[n200] Even if it should ultimately be decided by a court that there was a general publication, if the precaution has been taken of putting a statutorily acceptable copyright notice on all copies distributed, then there is no risk of a divestive publication which would result in loss of the right to preclude the innocent user defense. See § [3][c], supra.

[n201] 17 U.S.C. § 407(a)(2).

[n202] See § [3][b][ii], supra.

[n203] 17 U.S.C. § 407(d).

[n204] 17 U.S.C. § 408(b).

[n205] But it seems that a copyright proprietor does not lose standing to sue for infringement by conveying a security interest in the copyright. *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170, 178-79 (W.D. Tex. 1983).

[n206] *DeSilva Constr. Corp. v. Herrald*, 213 F. Supp. 184, 193 (M.D. Fla. 1962). 115

[n207] 17 U.S.C. § 201(d)(2).

[n208] 17 U.S.C. § 106(1).

[n209] 17 U.S.C. § 106(2).

If an architect, in making a set of architectural drawings, copies a substantial amount of the subject matter thereof from a previously created architectural work, either his own or someone else's, and if the copyright on the earlier work has not expired and is owned by someone else, the architect who prepares the subsequent drawings must obtain permission from the proprietor of the copyright on the earlier work to reuse the borrowed subject matter. If he does not, not only will the subsequent drawings be an infringing derivative work, 17 U.S.C. § 106(2), but in addition no valid copyright can be obtained on such a work, 17 U.S.C. § 103(a), even as to the original portion of the subject matter. Cf. *Donald Frederick Evans & Assocs. v. Continental Homes, Inc.*, 785 F.2d 897, 229 U.S.P.Q. 321, 325 (11th Cir. 1986), where this problem was avoided because the defendant failed to prove that the plaintiff was not the owner of the copyright on the earlier architectural work from which the later one was partly derived.

[n210] 17 U.S.C. § 106(3).

[n211] See § [2], *supra*.

[n212] But see *May v. Bray*, 30 Copyright Office Bulletin 435 (S.D. Cal. 1955) (such conduct was expressly enjoined in a consent decree).

[n213] But cf. § [2][b], *supra*.

[n214] *Weinstock, Lubin & Co. v. Marks*, 109 Cal. 529, 42 P. 142, 30 L.R.A. 182 (1895); -§ accord *Smith v. Paul*, 174 Cal. App. 2d 744, 345 P.2d 546, 77 A.L.R.2d 1036 (1959) (dictum).

[n215] *Edgar H. Wood Assoc., Inc. v. Skene*, 197 N.E.2d 886 (Mass. 1964) (dictum).

[n216] *Smith v. Paul*, 174 Cal. App. 2d 744, 345 P.2d 546, 77 A.L.R.2d 1036 (1959); *Seay v. Vialpando*, 567 P.2d 285 (Wyo. 1977).

An intermediate question is presented where the detailed plans themselves have been allowed to be inspected by the general public. See *Shanahan v. Macco Constr. Co.*, 224 Cal. App. 2d 327, 36 Cal. Rptr. 584 (1964), holding that exhibition of the detailed plans to the public was part of an overall pattern of behavior which constituted a divestive publication, but not deciding whether such exhibition alone constituted such a publication, nor whether in the absence of such a publication the copying of the plans under such circumstances could be the basis of a finding of infringement.

[n217] *Demetriades v. Kaufmann*, 680 F. Supp. 658, 6 U.S.P.Q.2d 1737 (S.D.N.Y. 1988), subsequent proceedings, 8 U.S.P.Q.2d 1130 (S.D.N.Y. 1988), subsequent proceedings, 8 U.S.P.Q.2d 1917 (S.D.N.Y. 1988); *Associated Hosts of Cal., Inc. v. Moss*, 207 U.S.P.Q. 973 (W.D.N.C. 1979); *Jones v. Spindel*, 113 Ga. App. 191, 147 S.E.2d 615 (1966), subsequent proceedings, 122 Ga. App. 390, 177 S.E.2d 187 (1970).

[n218] *Kent v. Revere*, 229 U.S.P.Q. 828 (M.D. Fla. 1985) (infringement found where copying was from promotional brochure which had its own copyright notice); *Herman Frankel Org. v. Tegman*, 367 F. Supp. 1051 (E.D. Mich. 1973) (the brochure was copyrighted). *Accord Imperial Homes Corp. v. Lamont*, 458 F.2d 895 (5th Cir. 1972) (uncopyrighted promotional brochure); *contra Scholz Homes, Inc. v. Maddox*, 379 F.2d 84 (6th Cir. 1967) (copyrighted promotional brochure).

[n219] *Jones Assocs., Inc. v. Nino Homes*, 858 F.2d 274, 8 U.S.P.Q.2d 1224, 1226-27 (6th Cir. 1988).

But cf. *Designer's View, Inc. v. Publix Super Markets, Inc.*, 764 F. Supp. 1473, 1991 U.S. Dist. LEXIS 6862, 20 U.S.P.Q.2d 1223, 1226-27 (S.D. Fla. 1991) (no infringement of copyright on simulated stained-glass window, despite access and thematic similarity, where there is no substantial similarity of expression).

[n220] In *Kent v. Revere*, 229 U.S.P.Q. 828, 832 (M.D. Fla. 1985), copying was shown by access and substantial similarity or alternatively by striking similarity. In the latter connection, the court said, "feature-for-feature identity of both major and minor elements in these plans simply cannot be explained by coincidence, independent creation or a prior common source."

Jones Assocs., Inc. v. Nino Homes, 686 F. Supp. 160, 4 U.S.P.Q.2d 1391, 1392 (E.D. Mich. 1987) (alternative holding), aff'd in this respect, 858 F.2d 274, 8 U.S.P.Q.2d 1224 (6th Cir. 1988).

[n221] Muller v. Triborough Bridge Auth., 43 F. Supp. 298 (S.D.N.Y. 1942).

[n222] Cardinal Indus., Inc. v. Anderson Parrish Assocs., Inc., 230 U.S.P.Q. 678, 681 (M.D. Fla. 1986) (no inference of copying where "the differences... so outweigh the similarities that there is no substantial similarity"), aff'd without opinion, 811 F.2d 609 (11th Cir.), cert. denied, 108 S. Ct. 88 (1987); Ketcham v. New York World's Fair 1939, Inc., 34 F. Supp. 657 (E.D.N.Y. 1940) (only minimal similarities between plaintiff's color chart and defendant's choice of color scheme for World's Fair).

[n223] Larkin v. Pennsylvania R.R. Co., 125 Misc. 238, 210 N.Y.S. 374 (Sup. Ct. 1925). Cf. § [2], supra, as to the idea-expression dichotomy and its impact upon the scope of copyright protection in the architectural field.

[n224] Ga-On Homes, Inc. v. Spitzer Homes, Inc., 178 U.S.P.Q. (M.D. Fla. 1973).

[n225] Nucor Corp. v. Tennessee Forging Steel Serv., Inc., 476 F.2d 386 (8th Cir. 1973).

[n226] MacMillan Co. v. I.V.O.W. Corp., 495 F. Supp. 1134 (D. Vt. 1980).

[n227] Oakes v. Suelynn Corp., 24 Cal. App. 3d 271, 100 Cal. Rptr. 838 (1972).

[n228] Title VII of The Judicial Improvements Act of 1990, Pub. Law 101- 650, 104 Stat. 5089 (effective Dec. 1, 1990).

[n229] See the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 23, note 52:

... the owner of copyright in an architectural work is granted a right of reproduction, a right to prepare derivative works (limited, however, by section 120(b)), and a right to distribute the architectural work ... (emphasis supplied)

[n230] See the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 19:

During the Subcommittee's 1990 hearing, testimony was received that a potential gap in protection may exist where an architectural work has been depicted in plans or drawings, but has not yet been constructed. Since the original definition of architectural work in H.R. 3990 referred only to architectural works "as embodied in" buildings, there was concern that a defendant with access to the plans or drawings could construct an identical building but escape liability so long as the plans or drawings were not copied.

The Register of Copyrights disagrees that liability could be avoided in such circumstances, arguing that the witnesses misconstrued the access prong of infringement analysis. The Register's position, based on general principles of copyright law, is that where a three-dimensional work meets the standard for protection, infringement may lie regardless of whether access to the three-dimensional work is obtained from a two-dimensional or three-dimensional depiction thereof.

In order to resolve this debate, subsection 202(a) of title II of H.R. 5498 modifies the definition of architectural work so that a work of architecture may be embodied in the built design-the constructed three-dimensional building-or in plans, drawings, or in "any tangible medium of expression," such as a blueprint or computer disk.... [Footnotes omitted.]

[n231] See § [1][b] above.

[n232] See the introductory portion of § [2] above.

For the rationale behind this provision, see the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 22:

Subsection (a) of new section 120 permits the unauthorized making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place." Similar exceptions are found in many Berne member countries, and serve to balance the interests of authors and the public. Architecture is a public art form and is enjoyed as such. Millions of people visit our cities every year and take back home photographs, posters, and other pictorial representations of prominent works of architecture as a memory of their trip. Additionally, numerous scholarly books on architecture are based on the ability to use photographs of architectural works.

These uses do not interfere with the normal exploitation of architectural works. Given the important public purpose served by these uses and the lack of harm to the copyright owner's market, the Committee chose to provide an exemption, rather than rely on the doctrine of fair use, which requires ad hoc determinations. After a careful examination of the provisions of the Berne Convention, the laws of other Berne member countries, and expert opinion, the Committee concluded that this exemption is consistent with our obligations under the Convention. [Footnotes omitted.]

[n233] See the House legislative report concerning predecessor bill H.R. 5498, H.R. Rep. No. 101-735 at 22, note 50:

The American Institute of Architects (AIA) proposed an amendment to section 120(a) prohibiting pictorial representations made in order to further the unauthorized design and construction of a substantially similar architectural work. The Subcommittee believed such an amendment was unnecessary. If an unauthorized substantially similar architectural work is constructed, it is irrelevant how the design of the infringing building is achieved so long as the design is not independently created.

The proposed AIA amendment might also interfere with scholarly and noncompetitive analysis of architectural works, and with the ability of photographers to pursue their livelihood. The American Society of Magazine Photographers wrote to the Subcommittee opposing the AIA amendment on this ground.

[n234] 3 Nimmer on Copyright § 13.05.

[n235] Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co., 542 F. Supp. 252, 260 (D. Neb. 1982).

[n236] Id. at 260.

[n237] Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp., 220 U.S.P.Q. 170, 181-82 (W.D. Tex. 1983).

[n238] 17 U.S.C. § 109(a).

[n239] 17 U.S.C. § 109(d).

[n240] Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp., 220 U.S.P.Q. 170, 182-83 (W.D. Tex. 1983).

[n241] 17 U.S.C. § 120(b), added by § 704 of the Architectural Works Copyright Protection Act, Pub. Law 101-650, 104 Stat. 5089 (effective Dec. 1, 1990). 120

[n242] Title VII of The Judicial Improvements Act of 1990, Pub. Law 101- 650, 104 Stat. 5089 (effective Dec. 1, 1990).

[n243] See § [2] above.

[n244] Cf. § [3][b], supra.

[n245] *Imperial Homes Corp. v. Lamont*, 458 F.2d 895 (5th Cir. 1972); *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170, 183 (W.D. Tex. 1983).

[n246] *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170, 183-84 (W.D. Tex. 1983).

[n247] But the court's calculation of damages in this case bore no resemblance to its remarks relative to the laches aspect of the case.

[n248] *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170, 184 (W.D. Tex. 1983).

See also *Cardinal Indus., Inc. v. Anderson Parrish Assocs., Inc.*, 230 U.S.P.Q. 678, 681 (M.D. Fla. 1986) (plaintiff modular housing manufacturer which insisted that characteristics of its design be incorporated into defendant's construction project so that plaintiff would be able to bid on the project, was estopped from charging defendant with resulting infringement of its copyrighted plans), *aff'd without opinion*, 811 F.2d 609 (11th Cir.), *cert. denied*, 108 S. Ct. 88 (1987).

[n249] See § § [8][d][i] and [iv], *infra*.

[n250] *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170, 184 (W.D. Tex. 1983) (the court also did not seem to believe the defendants' protestations of ignorance).

3 Nimmer on Copyright § 13.08.

[n251] *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170 (W.D. Tex. 1983).

[n252] *Id.* at 184-85.

[n253] 17 U.S.C. § 301(a).

Prior law may only apply to a "cause of action arising from undertakings commenced before January 1, 1978." See 17 U.S.C. § 301(b)(2).

[n254] 17 U.S.C. § 504(a)(1), (b).

Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co., 542 F. Supp. 252 (D. Neb. 1982) (see this case for an example of how the profits of a construction contractor are calculated); Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp., 220 U.S.P.Q. 170, 185-86 (W.D. Tex. 1983) (see this case for an example of how the profits of architectural and construction engineering firms are calculated); Kent v. Revere, 229 U.S.P.Q. 828, 833 (M.D. Fla. 1985) ("actual damages and any profits of the infringer that are attributable to the infringement and are not taken into account in computing actual damages") (dictum); Intown Enterprises, Inc. v. Barnes, 721 F. Supp. 1263, 1989 U.S. Dist. LEXIS 11393, 11 U.S.P.Q.2d 1364 (N.D. Ga. 1989) (the copyright proprietor is entitled to an award of the profits which it would have made on houses it would have sold but for infringer's unauthorized duplication of the copyrighted plans and its use of those infringing copies to build houses, plus and of the infringer's profits which are attributable to such infringement and are not taken into account in computing the copyright proprietor's loss of profits).

17 U.S.C. § 405(b) provides that:

Any person who innocently infringes a copyright, in reliance upon an authorized copy ... from which the copyright notice has been omitted and which was publicly distributed by authority of the copyright owner before the effective date of the Berne Convention Implementation Act of 1988, incurs no liability for actual or statutory damages ... for any infringing acts committed before receiving actual notice that registration for the work has been made ..., if such person proves that he or she was misled by the omission of notice

....

The Berne Convention Implementation Act of 1988 is Pub. L. No. 100-568, 102 Stat. 2853 (1988), and its effective date was March 1, 1989. It has been held that, where copyrighted drawings have not been published, this innocent infringer defense is not available to an infringer even though the drawings were prepared before the effective date of the Berne Convention Implementation Act, and even though there was no notice of copyright on the drawings. Intown Enterprises, Inc. v. Barnes, 721 F.Supp. 1263, 1265-66, 1989 U.S. Dist. LEXIS 11393, 11 U.S.P.Q.2d 1364 (N.D. Ga. 1989).

[n255] 17 U.S.C. § 504(b).

In Jones Assocs., Inc. v. Nino Homes, 858 F.2d 274, 281, 8 U.S.P.Q.2d 1224, 1230 (6th Cir. 1988) (affirming \$212,550 in compensatory damages, but reversing \$86,320 in defendant's profits as duplicative), the court ruled that "where the infringer's profit per house is less than the copyright owner's profit margin, and where ... all of the infringer's profits attributable to the infringement were already taken into account in the actual damages awarded to the copyright owner [because "the measure of damages in this case is the profits" which plaintiff "would have made on houses it would have sold but for" defendant's "unauthorized duplication of the" copyrighted "plans and" defendant's "use of its infringing copies to build its ... houses"]..., the district court's decision to add [defendant's] profits of \$86,320 to the award of [plaintiff's \$212,550 in] lost profits constitutes the kind of double recovery clearly precluded by the [copyright] statute."

Intown Enterprises, Inc. v. Barnes, 721 F. Supp. 1263, 1267, 1989 U.S. Dist. LEXIS 11393, 11 U.S.P.Q.2d 1364 (N.D. Ga. 1989).

[n256] 17 U.S.C. § 504(a)(2), (c).

[n257] That is, per copyrighted work, no matter how many infringing copies thereof are made. But where the suit involves infringement of more than one separate and independent work, an additional award of minimum statutory damages for each work must be made. 17 U.S.C. § 504, Historical Note.

[n258] 17 U.S.C. § 504(c)(1). See *Kent v. Revere*, 229 U.S.P.Q. 828, 833 (M.D. Fla. 1985) (statutory damages of \$750).

[n259] 17 U.S.C. § 504(c)(2).

[n260] The last sentence of 17 U.S.C. § 504(c)(2), subsections (i) and (ii).

[n261] See § [8][c][i], *supra*.

[n262] *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170, 185 (W.D. Tex. 1983); *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1990 U.S. App. LEXIS 10077, 15 U.S.P.Q.2d 1282, 1288, 16 F.R. Serv. 3d 1441 (11th Cir. 1990); 17 U.S.C. § 412(1).

[n263] 17 U.S.C. § 412(2).

[n264] *Ashworth v. Glover*, 20 Utah 2d 85, 433 P.2d 315, 156 U.S.P.Q. 219 (1967); *Wallace v. Helm*, 161 U.S.P.Q. 121 (Cal. Ct. App. 1969); *Edgar H. Wood Assoc., Inc. v. Skene*, 197 N.E.2d 886 (Mass. 1964); accord *Masterson v. McCroskie*, 573 P.2d 547 (Colo. 1978). Contra *Jones Assocs., Inc. v. Nino Homes*, 858 F.2d 274, 8 U.S.P.Q.2d 1224, 1227 (6th Cir. 1988).

[n265] *Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co.*, 542 F. Supp. 252 (D. Neb. 1982). The court also said that the fact that the plans had been used before may reduce their value.

[n266] MacMillan Co. v. I.V.O.W. Corp., 495 F. Supp. 1134 (D. Vt. 1980).

[n267] Ga-On Homes, Inc. v. Spitzer Homes, Inc., 178 U.S.P.Q. (M.D. Fla. 1973).

[n268] Jones Assocs., Inc. v. Nino Homes, 686 F. Supp. 160, 4 U.S.P.Q.2d 1391, 1394 (E.D. Mich. 1987), aff'd in this respect, 858 F.2d 274, 8 U.S.P.Q.2d 1224, 1230 (6th Cir. 1988).

[n269] Kent v. Revere, 229 U.S.P.Q. 828, 833 (M.D. Fla. 1985).

[n270] Herman Frankel Org. v. Wolfe, 367 F. Supp. 1067, 184 U.S.P.Q. 819 (E.D. Mich. 1974).

See also Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp., 220 U.S.P.Q. 170, 183 (W.D. Tex. 1983), which suggests that the plaintiff might be entitled to an architect's or engineer's fee prior to defendant's construction, or a percentage of the construction costs thereafter. But after making that suggestion, the court appeared to calculate the damages in that case entirely differently. 220 U.S.P.Q. at 185-86, 190.

[n271] Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co., 542 F. Supp 252 (D. Neb. 1982); Masterson v. McCroskie, 573 F.2d 547 (Colo. 1978); Edgar H. Wood Assoc., Inc. v. Skene, 197 N.E.2d 886 (Mass. 1964).

[n272] Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp., 220 U.S.P.Q. 170, 186 (W.D. Tex. 1983).

Contra Kent v. Revere, 229 U.S.P.Q. 828, 833 (M.D. Fla. 1985) (denying that "plaintiff's personal losses in the investigation and prosecution of this suit are compensable as actual damages").

[n273] Herman Frankel Org. v. Wolfe, 367 F. Supp. 1067, 184 U.S.P.Q. 819 (E.D. Mich. 1974).

[n274] Ashworth v. Glover, 20 Utah 2d 85, 433 P.2d 315, 156 U.S.P.Q. 219 (1967); Wallace v. Helm, 161 U.S.P.Q. 121 (Cal. Ct. App. 1969); MacMillan Co. v. I.V.O.W. Corp., 495 F. Supp. 1134 (D. Vt. 1980).

[n275] *Jones Assocs., Inc. v. Nino Homes*, 858 F.2d 274, 8 U.S.P.Q.2d 1224, 1231 (6th Cir. 1988). Cf. 35 U.S.C. § 284 (the patent statute).

[n276] *Edgar H. Wood Assoc., Inc. v. Skene*, 197 N.E.2d 886 (Mass. 1964); *Demetriades v. Kaufmann*, 680 F. Supp. 658, 6 U.S.P.Q.2d 1737 (S.D.N.Y. 1988), subsequent proceedings, 8 U.S.P.Q.2d 1130 (S.D.N.Y. 1988), subsequent proceedings, 8 U.S.P.Q.2d 1917 (S.D.N.Y. 1988).

In *Joseph J. Legat Architects, P.C. v. U.S. Dev. Corp.*, 229 U.S.P.Q. 132, 138-41 (N.D. Ill. 1985), the court refused to interfere with the client's use of the plans for which it had contracted but not fully paid because of a contract dispute, despite its holding that it is an infringement of the architect's copyright for the client to file the plans with the local building authorities under the name of another architect.

[n277] *Herman Frankel Org. v. Wolfe*, 367 F. Supp. 1067, 184 U.S.P.Q. 819 (E.D. Mich. 1974); *Demetriades v. Kaufmann*, 680 F. Supp. 658, 6 U.S.P.Q.2d 1737 (S.D.N.Y. 1988), subsequent proceedings, 8 U.S.P.Q.2d 1130 (S.D.N.Y. 1988), subsequent proceedings, 8 U.S.P.Q.2d 1917 (S.D.N.Y. 1988).

[n278] *Associated Hosts of Cal., Inc. v. Moss*, 207 U.S.P.Q. 973 (W.D.N.C. 1979).

See also *Jones Assocs., Inc. v. Nino Homes*, 686 F. Supp. 160, 4 U.S.P.Q.2d 1391, 1395 (E.D. Mich. 1987) (permanent injunction) (semble), aff'd in part, rev'd in part on other grounds, 858 F.2d 274, 8 U.S.P.Q.2d 1224 (6th Cir. 1988).

[n279] 17 U.S.C. § 503(b).

*Jones Assocs., Inc. v. Nino Homes*, 686 F. Supp. 160, 4 U.S.P.Q.2d 1391, 1395 (E.D. Mich. 1987), aff'd in part, rev'd in part on other grounds, 858 F.2d 274, 8 U.S.P.Q.2d 1224 (6th Cir. 1988); *Demetriades v. Kaufmann*, 680 F. Supp. 658, 6 U.S.P.Q.2d 1737 (S.D.N.Y. 1988) (all copies in the defendants' possession), subsequent proceedings, 8 U.S.P.Q.2d 1130, 1135 (S.D.N.Y. 1988) (recognizing that copies which defendants had filed with the local building authorities might not be recoverable by defendants), subsequent proceedings, 8 U.S.P.Q.2d 1917, 1920-21 n.2 (S.D.N.Y. 1988) (local building authorities voluntarily yielded remaining copies of plans for impoundment, with minor exceptions).

[n280] *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170, 186 (W.D. Tex. 1983).

[n281] *Kent v. Revere*, 229 U.S.P.Q. 828, 833 (M.D. Fla. 1985).

[n282] 17 U.S.C. § 505.

[n283] *Kent v. Revere*, 229 U.S.P.Q. 828, 834 (M.D. Fla. 1985); *Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co.*, 542 F. Supp. 252 (D. Neb. 1982).

With respect to the prior copyright act, see *Herman Frankel Org. v. Wolfe*, 367 F. Supp. 1067, 184 U.S.P.Q. 819 (E.D. Mich. 1974).

[n284] 17 U.S.C. § 412(1); *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170, 185 (W.D. Tex. 1983); *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1990 U.S. App. LEXIS 10077, 15 U.S.P.Q.2d 1282, 1288, 16 F.R. Serv. 3d 1441 (11th Cir. 1990).

[n285] 17 U.S.C. § 412(2).

*Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co.*, 542 F. Supp. 252 (D. Neb. 1982).

In *Jones Assocs., Inc. v. Nino Homes*, 858 F.2d 274, 8 U.S.P.Q.2d 1224, 1230 (6th Cir. 1988), the court ruled that, since under the pre-1990 copyright statute and the principle of *Baker v. Selden* the infringing act was the making of infringing plans, not the construction of homes from those plans, no attorney fees could be awarded where the defendant's illegal copying of the plaintiff's plans occurred outside the statutory time window, even though the defendant's construction of at least some of its homes from the copied plans was started within that time window. But the number of houses constructed by means of the infringing plans did multiply the damages attributable to the infringement.

[n286] 17 U.S.C. § 405(b).

[n287] *Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co.*, 542 F. Supp. 260 (D. Neb. 1982).

See also *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170, 181 (W.D. Tex. 1983) (dictum).

[n288] *Johnstone v. Fox*, 4 U.S.P.Q.2d 1229, 1233 (N.D. Ill. 1987); *MacMillan Co. v. I.V.O.W. Corp.*, 495 F. Supp. 1134 (D. Vt. 1980).

[n289] *Herman Frankel Org. v. Wolfe*, 367 F. Supp. 1067, 184 U.S.P.Q. 819 (E.D. Mich. 1974).

But cf. *Herman Frankel Org. v. Tegman*, 367 F. Supp. 1051 (E.D. Mich. 1973), and *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 220 U.S.P.Q. 170

(W.D. Tex. 1983), where on similar facts the innocent clients were held not liable at all, even though they too had received the benefit of their architects' infringements.

[n290] Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co., 542 F. Supp. 252 (D. Neb. 1982).

[n291] Herman Frankel Org. v. Tegman, 367 F. Supp. 1051 (E.D. Mich. 1973); Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp., 220 U.S.P.Q. 170 (W.D. Tex. 1983).

These cases, however, are inconsistent with Herman Frankel Org. v. Wolfe, 367 F. Supp. 1067, 184 U.S.P.Q. 819 (E.D. Mich. 1974), where the innocent clients were held liable on an unjust enrichment theory in view of their having received the benefit of the infringement committed by their architect.

[n292] Demetriades v. Kaufmann, 8 U.S.P.Q.2d 1130, 1131-34 (S.D.N.Y. 1988), subsequent proceedings, 8 U.S.P.Q.2d 1917, 1921, 1924-25 (S.D.N.Y. 1988) (real estate brokers not liable for trade identity infringement or "commercial immorality" either).

[n293] MacMillan Co. v. I.V.O.W. Corp., 495 F. Supp. 1134 (D. Vt. 1980); Seay v. Vialpando, 567 P.2d 285 (Wyo. 1977). But cf. Acorn Structures, Inc. v. Swantz, 657 F. Supp. 70, 2 U.S.P.Q.2d 1632 (W.D. Va. 1987) (action for common law conversion does not lie where defendant had lawful possession of plaintiff's architectural plans).

[n294] Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp., 220 U.S.P.Q. 170, 188-89 (W.D. Tex. 1983). This case also holds that a federal court has pendent jurisdiction over a state-law claim for unjust enrichment when appended to a related claim for federal copyright infringement, where the two claims share a common nucleus of operative fact, even though unjust enrichment may fall outside the scope of 28 U.S.C. § 1338(b) on the ground that it is not "unfair competition."

But cf. Acorn Structures, Inc. v. Swantz, 657 F. Supp. 70, 2 U.S.P.Q.2d 1632 (W.D. Va. 1987) (no recovery for unjust enrichment where an express contract exists between proprietor of architectural plans and defendant accused of misappropriating such plans).

[n295] Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp., 217 U.S.P.Q. 1227, 1240 (W.D. Tex. 1982), subsequent proceedings, 220 U.S.P.Q. 170, 188-89 (W.D. Tex. 1983).

[n296] Intown Enterprises, Inc. v. Barnes, 721 F. Supp. 1263, 1267, 1989 U.S. Dist. LEXIS 11393, 11 U.S.P.Q.2d 1364, 1367 (N.D. Ga. 1989).

[n297] *International News Serv. v. Associated Press*, 248 U.S. 215, 39 S. Ct. 68, 63 L. Ed. 211 (1918).

[n298] *Demetriades v. Kaufmann*, 8 U.S.P.Q.2d 1917 (S.D.N.Y. 1988); *Schuchart & Assocs., Professional Eng'rs, Inc. v. Solo Serve Corp.*, 217 U.S.P.Q. 1227, 1239 (W.D. Tex. 1982), subsequent proceedings, 220 U.S.P.Q. 170, 188-89 (W.D. Tex. 1983); 17 U.S.C. § 301.

Accord, *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1494, 1990 U.S. App. LEXIS 10077, 15 U.S.P.Q.2d 1282, 1288-89, 16 F.R. Serv. 3d 1441 (11th Cir. 1990) (state-law claim for "unfair competition" based on "intentional plan and actions thereunder to deprive plaintiff of a valuable business opportunity by offering to make either an identical or substantially similar home ... where defendants knew full well that they would copy from plaintiff's [copyrighted] brochure to make that home" is preempted by federal copyright act): "A claim for unfair competition based upon allegations of copying, and in the absence of proof of any element of unfair competition other than copying, is clearly pre-empted by the Act."

[n299] *Gemcraft Homes, Inc. v. Sumurdy*, 8 U.S.P.Q.2d 1514 (E.D. Tex. 1988).

[n300] *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1990 U.S. App. LEXIS 10077, 15 U.S.P.Q.2d 1282, 1288, 16 F.R. Serv. 3d 1441 (11th Cir. 1990).

[n301] 17 U.S.C. § 301(e).

[n302] 17 U.S.C. § 106A.

[n303] 17 U.S.C. § 106A(a)(1)(A).

See also 2 Nimmer on Copyright, § 8.21[B][2][b] (1991).

[n304] 17 U.S.C. § 106A(a)(1)(B).

See also 2 Nimmer on Copyright, § 8.21[B][2][b] (1991)

[n305] 17 U.S.C. § 106A(a)(2).

See also 2 Nimmer on Copyright, § 8.21[B][2][b] (1991).

[n306] 17 U.S.C. § 106A(a)(3)(A).

See also 2 Nimmer on Copyright, § 8.21[B][2][c] (1991).

[n307] 17 U.S.C. § 106A(a)(3)(B).

See also 2 Nimmer on Copyright, § 8.21[B][2][c] (1991).

[n308] 17 U.S.C. § 106A(b).

[n309] 17 U.S.C. § 106A(d)(1).

In the case of a joint work, these rights endure for the life of the last surviving joint artist. *Id.*

The effective date of § 106A is June 1, 1991, i.e., six months after the effective date set forth in § 610(a) of the Visual Artists Rights Act of 1990, Title VI of Public Law 101-650, 104 Stat. 5132, enacted Dec. 1, 1990. See note to 17 U.S.C. § 106A. Sec. 610(b)(1) of that act provides that the rights created thereby shall apply to works created before the effective date, but title to which had not, as of such effective date, been transferred from the artist.

Sec. 106A(d)(2), 17 U.S.C. § 106A(d)(2), provides that, with respect to works created before that date, title to which had not been transferred prior to that date, these rights have the same duration as copyright in a work of visual art (for which see § [6] *supra*). This means that the moral right in a work created before June 1, 1991, unlike those created afterward, will survive the artists' death (i.e. by at least 50 years and quite likely some months longer). The legislative history originally indicated that the post-mortem right passes by will or intestacy under applicable state law. H.R. Rep. No. 101-514, 101st Cong., 2d Sess. 3, 19 (1990). But there is some question whether this indication is still applicable, in light of subsequent changes to the wording of the statute. See 2 Nimmer on Copyright, § 8.21[B][2][e], note 239 (1991), and also that author's suggestion that "[i]t would seem best to continue the previous construction, notwithstanding the Congressional sloppiness in deleting [certain clarifying language from the statute]."

Sec. 610(b)(2) of the Visual Artists Rights Act of 1990, *supra*, provides that the rights created by § 106A, *supra*, do apply to works created on or after that date, but not to any destruction, distortion, mutilation, or other modification of such a work which occurred before that date. The question of whether the act applies to prior attribution violations, however, is not addressed, leaving the question unresolved; see 2 Nimmer on Copyright, § 8.21 [B] [2][e] (1991).

[n310] 17 U.S.C. § 106A(e)(1). This section further provides that such waiver must be express, and must be contained in a written instrument signed by the artist specifically identifying the work and the uses of the work to which the waiver applies.

This section also provides that one joint artist may waive the rights of all of them. But cf. 2 Nimmer on Copyright, § 8.21[B][2][d] (1991), which questions whether it makes much sense to permit one joint author to waive another joint author's right of attribution

(as opposed to the right of integrity). The fact that one joint author does not wish to be associated with the work does not necessarily mean that another joint author feels the same way.

[n311] 17 U.S.C. § 101.

[n312] 17 U.S.C. § 113(d).

[n313] 17 U.S.C. § 113(d)(1).

In 2 Nimmer on Copyright, § 8.21[B][2][c][iii] (1991), note 171, that author points out that, if literally interpreted, this exemption applies not only to the building owner's removal of the artwork, but also to his mutilation of the work in a manner prejudicial to the artist's reputation and the building owner's thereafter keeping it on display in order to humiliate the artist. But Nimmer speculates that this exemption was probably intended to apply only to removal and not to mutilation; and then expresses the hope that the courts will interpret the statute in a manner consistent with the presumed legislative intent. Such is the stature of the Nimmer treatise that, if there are any building owners who may contemplate the humiliation of artists in this manner, they would be well advised to rely on that author's view of the issue rather than on the literal language of the statute.

The legislative history indicates that this consent inures to the benefit of subsequent owners of the building. H.R. Rep. No. 101-514, 101st Cong., 2d Sess. 20 (1990).

[n314] 17 U.S.C. § 113(d)(2).

[n315] 17 U.S.C. § 113(d)(2)(A).

[n316] 17 U.S.C. § 113(d)(2)(B).

See also 2 Nimmer on Copyright, § 8.21[B][2][c][iii] (1991). That treatise notes that: "This provision is drawn from the similar provisions of California law." It cites, in support of that observation, the legislative history of the federal enactment: H.R. Rep. No. 101-514, 101st Cong., 2d Sess. 19 (1990). The California moral rights statute, Cal. Civ. Code § 987, provides that if a work of "fine art" cannot be removed from a building without damage to either the work or the building, the artist is deemed to have waived his or her rights under the state statute unless there is an express reservation of the artist's rights in a written, recorded instrument; but if the work can be removed without such damage the building owner must attempt to give advance notification to the artist, who then has 90 days to remove the art at his or her own expense, failing which the owner may destroy it without liability.

[n317] 17 U.S.C. § 113(d)(2), last sentence.

[n318] 17 U.S.C. § 113(d)(2), next-to-last sentence.

[n319] By 17 U.S.C. § 113(d)(3).

[n320] California Civ. Code § 987; Louisiana Rev. Stat. Ann § § 51:2151- 56; Maine Rev. Stat. Title 27, § 303(2); Annotated Laws of Massachusetts, ch. 231, § 85S(c) (caveat: the first of two provisions similarly designated); New Jersey Laws, Title 2A, § 2A:24A-4; Title C, Articles 11 through 14 of the New York Arts and Cultural Affairs Law; Rhode Island Stat. ch. 62, § 5-62-3.

For the difficulties and ambiguities in the citations of some of these statutes, and also for the sometimes tortuous history of their amendment, repeal and re-enactment, see 2 Nimmer on Copyright, § 8.21[B][3], note 287, § 8.21[B][4], note 328, and § 8.21[B][5], notes 354 and 355, (1991).

For state statute texts, see 2 Nimmer on Copyright, § 8.21[G] (1991).

A mural painted on the exterior wall of a service station is covered by the California act, *supra* this note. *Botello v. Shell Oil Co.*, 229 Cal. App. 3d 1130, 280 Cal. Rptr. 535, 1991 Cal App LEXIS 438, 19 USPQ2d 1674 (1991).

[n321] 17 U.S.C. § 301(f)(1).

This provision calls into question the continued compliance of the United States with the Berne Convention (discussed in § § [4][a][ii] and [4][c], *supra*). See 2 Nimmer on Copyright, § 8.21[B][f], note 249 (1991).

[n322] The effective date of § 301(f) is June 1, 1991, i.e., six months after the effective date set forth in § 610(a) of the Visual Artists Rights Act of 1990, Public Law 101-650, 104 Stat. 5132, enacted Dec. 1, 1990. See note to 17 U.S.C. § 106A.

[n323] 17 U.S.C. § 301(f)(2).

[n324] 2 Nimmer on Copyright, § 8.21[B][f] (1991). See also Nimmer's discussion of what those questions are and how some of them might be resolved. *Id.*

[n325] Before the enactment of the moral rights provisions of the copyright act, *supra* this subsection, relief for certain kinds of moral rights violations had been granted on a trade identity confusion theory under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), which is

the federal trademark statute. See, e.g., *Gilliam v. American Broadcasting Cos.*, 538 F.2d 14 (2d Cir. 1976).

See also 2 *Nimmer on Copyright*, § 8.21[C] (1991), dealing generally with the courts' treatment of artist's moral rights under theories other than those discussed herein.

So far, no moral rights cases of the kinds discussed in this footnote have involved artworks in the nature of accessions to realty.

## \*81 APPENDIX I

The Judicial Improvements Act of 1990 Public Law 101-650, Dec. 1, 1990, 104 Stat 5089

...

### TITLE VII - ARCHITECTURAL WORKS

#### SEC. 701. SHORT TITLE.

This title may be cited as the "Architectural Works Copyright Protection Act".

#### SEC. 702. DEFINITIONS.

(a) ARCHITECTURAL WORKS. - Section 101 of title 17, United States Code, is amended by inserting after the definition of "anonymous work" the following:

"An '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."

(b) BERNE CONVENTION WORK. - Section 101 of title 17, United States Code, is amended in the definition of "Berne Convention work" -

- (1) in paragraph (3)(B) by striking "or" after the semicolon;
- (2) in paragraph (4) by striking the period and inserting ";or"; and
- (3) by inserting after paragraph (4) the following:

"(5) in the case of an architectural work embodied in a building, such building is erected in a country adhering to the Berne Convention."

#### SEC. 703. SUBJECT MATTER OF COPYRIGHT.

Section 102(a) of title 17, United States Code, is amended -

- (1) in paragraph (6) by striking "and" after the semicolon;
- (2) in paragraph (7) by striking the period and inserting ";and"; and
- (3) by adding after paragraph (7) the following: "(8) architectural works."

#### SEC. 704. SCOPE OF EXCLUSIVE RIGHTS IN ARCHITECTURAL WORKS

(a) IN GENERAL. - Chapter 1 of title 17, United States Code, is amended by adding at the end the following:

"§ 120. Scope of exclusive rights in architectural works

\*82 "(a) PICTORIAL REPRESENTATIONS PERMITTED. - The copyright in an architectural work that has been constructed does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.

"(b) ALTERATIONS TO AND DESTRUCTION OF BUILDINGS. - Notwithstanding the provisions of section 106(2), the owners of a building embodying an architectural work may, without the consent of the author or copyright owner of the architectural work, make or authorize the making of alterations to such building, and destroy or authorize the destruction of such building."

(b) CONFORMING AMENDMENTS. -

(1) The table of sections at the beginning of chapter 1 of title 17, United States Code, is amended by adding at the end [there]of the following:

"120. Scope of exclusive rights in architectural works."

(2) Section 106 of title 17, United States Code, is amended by striking "119" and inserting "120".

SEC. 705. PREEMPTION

Section 301(b) of title 17, United States Code, is amended -

- (1) in paragraph (2) by striking "or" after the semicolon;
- (2) in paragraph (3) by striking the period and inserting "; or"; and
- (3) by adding after paragraph (3) the following:

"(4) State and local landmarks, historic preservation, zoning, or building codes, relating to architectural works protected under section 102(a)(8)."

SEC. 706. EFFECTIVE DATE.

The amendments made by this title apply to -

- (1) any architectural work created on or after the date of the enactment of this Act; and
- (2) any architectural work that, on the date of the enactment of this Act, is unconstructed and embodied in unpublished plans or drawings, except that protection for such architectural work under title 17, United States Code, by virtue of the amendments made by this title, shall terminate on December 31, 2002, unless the work is constructed by that date.

...

\*83 APPENDIX II

HOUSE OF REPRESENTATIVES 101ST CONGRESS 2d Session

Report 101-735

COPYRIGHT AMENDMENTS ACT OF 1990

SEPTEMBER 21, 1990.-Committed to the Committee of the Whole House on the State of the Union and ordered to be printed

Mr. BROOKS, from the Committee on the Judiciary, submitted the following

## R E P O R T

[To accompany H.R. 5498]

[Including cost estimate of the Congressional Budget Office]

The Committee on the Judiciary, to whom was referred the bill (H.R. 5498) to amend title 17, United States Code, relating to computer software, fair use, and architectural works, having considered the same, report favorably thereon with an amendment and recommend that the bill as amended do pass.

The amendment is as follows:

Strike out all after the enacting clause and insert in lieu thereof the following:

### SECTION 1. SHORT TITLE.

This Act may be cited as the "Copyright Amendments Act of 1990".

### TITLE I - COMPUTER SOFTWARE

...

### TITLE II-ARCHITECTURAL WORKS

#### SEC. 201. SHORT TITLE.

This title may be cited as the "Architectural Works Copyright Protection Act".

#### SEC. 202. DEFINITIONS.

(a) ARCHITECTURAL WORKS. - Section 101 of title 17, United States Code, is amended by inserting after the definition of "anonymous work" the following:

\*84 "An '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 comosition of spaces and elements in the design, but does not include individual standard features."

(b) BERNE CONVENTION WORK. - Section 101 of title 17, United States Code, is amended in the definition of "Berne Convention work" -

(1) in paragraph (3)(B) by striking "or" after the semicolon;

(2) in paragraph (4) by striking the period and inserting"; or"; and

(3) by inserting after paragraph (4) the following:

"(5) in the case of an architectural work embodied in a building, such building is erected in a country adhering to the Berne Convention."

#### SEC. 203. SUBJECT MATTER OF COPYRIGHT.

Section 102(a) of title 17, United States Code, is amended -

(1) in paragraph (6) by striking "and" after the semicolon;

(2) in paragraph (7) by striking the period and inserting"; and"; and

(3) by adding after paragraph (7) the following: "(8) architectural works."

#### SEC. 204. SCOPE OF EXCLUSIVE RIGHTS IN ARCHITECTURAL WORKS.

(a) IN GENERAL. - Chapter I of title 17, United States Code, is amended by adding at the end the following:

"§ 120. Scope of exclusive rights in architectural works

"(a) PICTORIAL REPRESENTATIONS PERMITTED. - The copyright in an architectural work that has been constructed does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.

"(b) ALTERATIONS TO AND DESTRUCTION OF BUILDINGS. - Notwithstanding the provisions of section 106(2), the owners of a building embodying an architectural work may, without the consent of the author or copyright owner of the architectural work, make or authorize the making of alterations to such building, and destroy or authorize the destruction of such building."

(b) CONFORMING AMENDMENTS. - (1) The table of sections at the beginning of chapter 1 of title 17, United States Code, is amended by adding at the end [there]of the following:

"120. Scope of exclusive right, in architectural works."

\*85 (2) Section 106 of title 17, United States Code is amended by striking "119" and inserting "120".

#### SEC. 205. PREEMPTION.

Section 301(b) of title 17, United States Code, is amended -

- (1) in paragraph (2) by striking "or" after the semicolon;
- (2) in paragraph (3) by striking the period and inserting"; or"; and
- (3) by adding after paragraph (3) the following:

"(4) State and local landmarks, historic preservation, zoning, or building codes, relating to architectural works protected under section 102(a)(8)."

#### SEC. 206. EFFECTIVE DATE.

[T]he amendments made by this title apply to -

- (1) any architectural work created on or after the date of the enactment of this Act; and
- (2) any architectural work that, on the date of the enactment of this Act, is unconstructed and embodied in unpublished plans or drawings, except that protection for such architectural work under title 17, United States Code, by virtue of the amendments made by this title, shall terminate on December 31, 2002, unless the work is constructed by that date.

#### EXPLANATION OF AMENDMENT

Inasmuch as H.R. 5498 was ord[e]red reported with a single amendment in the nature of a substitute, the contents of this report constitute an explanation of that amendment.

#### SUMMARY AND PURPOSE

H.R. 5498 manifests two distinct purposes in its amendments to the Copyright Act.

First, Title I represents a narrowly drafted exception to the first sale doctrine of copyright law by prohibiting direct or indirect commercial rental of computer software. Provisions have been included to permit lending by nonprofit libraries and education institutions, rental of machines or products embodying computer programs, and rental of electronic audiovisual games used in connection with limited purpose computers. Title I expires on October 1, 1997.

Second, Title II places the United States in full compliance with its multilateral treaty obligations as specified in the Berne Convention for the Protection of Literary and Artistic Works with respect to works of architecture, by creating a new category of copyright subject matter for the constructed design of buildings.

## \*86 STATEMENT OF LEGISLATIVE HISTORY

### TITLE I. - COMPUTER SOFTWARE RENTAL

...

### TITLE II. - ARCHITECTURAL WORKS

Architecture is a form of artistic expression that performs a significant societal purpose, domestically and internationally.

The 100th Congress passed legislation (Public Law 100-568), enabling the U.S. to meet the requirements of the Berne Convention for the Protection of Literary and Artistic Works. As a result of this legislation and Senate ratification of the Berne Treaty, on March 1, 1989, the U.S. became a signatory to the world's most important copyright convention. As part of the effort to make U.S. law compatible with Berne standards, Congress noted that the protectible subject matter enumerated in Article 2(1) of the treaty includes "works of architecture."

In the wake of Berne adherence, Chairman Robert W. Kastenmeier (Chairman of the Subcommittee on Courts, Intellectual Property, and the Administration of Justice) asked the Copyright Office to conduct a study of the architectural works protection issue. In response, Register of Copyrights, Ralph Oman, presented a report of the Copyright Office study to Chairman Kastenmeier at a June 19, 1989, press conference in the Madison Building of the Library of Congress. The report concluded that while architectural blueprints, plans, drawings, and models relating to works of architecture are adequately protected by U.S. copyright law, the adequacy of protection under Berne Convention standards for the constructed design of architectural structures remains in doubt.

During the 101st Congress, two bills were introduced by Chairman Kastenmeier to address the Register's concerns: H.R. 3990 (the "Architectural Works Copyright Protection Act of 1990"); and H.R. 3991 (the "Unique Architectural Structures Copyright Act of 1990").

On March 14, 1990, the Subcommittee held a legislative hearing during which testimony was received from the following witnesses: a well-known American architect (Michael Graves, FAIA); the Register of Copyrights (Ralph Oman); an Administration

witness (Honorable Jeffrey M. Samuels); the American Institute of Architects (David A. Daileida, AIA); and The Frank Lloyd Wright Foundation (Richard Carney, Managing Trustee, Chief Executive Officer). Written statements were received from the American Consulting Engineers Council and the American Society of Magazine Photographers. [n4]

\*87 Following this hearing, on August 3, 1990, Mr. Kastenmeier, joined by Mr. Synar and Mr. Moorhead, introduced revised provisions protecting architectural works as Title III of H.R. 5498, the omnibus copyright reform measure referred to above. In this form, the proposal was marked up by the Subcommittee on September 14, 1990, and a quorum of Members being present, ordered the bill favorably reported to the full Committee by voice with no objections being heard. [n5]

## COMMITTEE ACTION AND VOTE

On September 18, 1990, the full Committee considered H.R. 5498. An amendment was offered (by Mr. Hyde) to delete section 103 relating to the public display of electronic video games. After debate, the amendment was defeated by voice vote. After adoption of the Subcommittee substitute amendment, the Committee ordered the bill favorably reported by voice vote with a quorum present.

## DISCUSSION

### TITLE I. - COMPUTER SOFTWARE RENTAL

...

### TITLE II. - ARCHITECTURAL WORKS

The Architectural Works Protection Act of 1990 is [the] result of United States adherence to the Berne Convention for the Protection of Literary and Artistic Works. [n17] The Convention is the world's most important copyright treaty. Adherence of the United States to the Berne Union was a two- step process. First, implementing legislation had to be drafted, refined, and enacted. The implementing legislation had one simple, but important objective: to make only those changes in domestic U.S. law required to place the United States in compliance with our treaty obligations. The second step, reached only after the first was completed, required the Senate to give its advice and consent to the treaty. Both steps reached fruition on October 31, 1988, when President, Reagan signed into law H.R. 4262 [n18] (the Berne Implementation Act of 1988) and the treaty. Both were effective on March 1, 1989, when the United States became a full-fledged member of the Berne Union.

\*88 Article 2(1) of the Berne Convention requires member countries to provide copyright for "works of architecture"-the constructed design of buildings. This category of subject matter is distinct from "illustrations, plans, sketches and three-dimensional works relative to architecture," which are also required to be protected under Article 2(1). The current U.S. Copyright Act expressly includes "diagrams, models, and technical drawings, including architectural plans" as a species of protected "pictorial, graphic, and sculptural work." [n19] It does not, however, expressly protect "works of architecture," although this Committee's Report accompanying the 1976 Copyright Act contemplated that at least selected works of architecture-those containing elements physically or conceptually separable from their utilitarian function-would be protected to the extent of their separability. [n20]

Due to the lack of express statutory protection for works of architecture in the 1976 Copyright Act, the original Berne implementing bills included provisions according such protection, limited by exemptions and restrictions on remedies necessary to protect the public as well as the interests of the real estate industry. [n21]

During the initial deliberations on Berne adherence in 1986 and 1987, the issue of protection for works of architecture failed to draw much response. Then, in 1988, near the end of the hearing process, two respected copyright scholars testified that creation of a separate statutory provision for works of architecture might not be required for compliance with our obligations under the Berne Convention. This testimony was based on language in this Committee's Report accompanying \*89 the 1976 Copyright Act. [n22] These experts suggested that the issue be studied further before undertaking legislative action.

Relying on this testimony, the provisions on works of architecture were dropped from the Berne implementing legislation. Agreeing with the experts' suggestions for further study, Chairman Robert W. Kastenmeier of the Subcommittee on Courts, Intellectual Property, and the Administration of Justice, by letter of April 27, 1988, to Register of Copyrights Ralph Oman, requested that the Copyright Office undertake a full review of the subject and report to him the results of the study, including any recommendations for amending the Copyright Act.

On June 19, 1989, Mr. Oman delivered his report to Chairman Kastenmeier. [n23] While the Register noted the strong professional disagreement within the Copyright Office over the existence of copyright for the design of works of architecture under the 1976 Act, he concluded, and the entire staff concurred, that the Berne Convention required such protection. Accordingly, on February 7, 1990, Chairman Kastenmeier introduced H.R. 3990, to place the United States unequivocally in compliance with its Berne obligations. For purposes of discussion, Chairman Kastenmeier also introduced H.R. 3991, the "Unique Architectural Structures Copyright Act of 1990." H.R. 3991 sought to protect only works possessing a "unique artistic character." Following a legislative hearing before the Subcommittee on March 14, 1990, revised provisions

protecting architectural works, based on H.R. 3990, were introduced as part of H.R. 5498. These provisions now form Title II of H.R. 5498.

The importance of H.R. 3990 (and Title II of H.R. 5498) should not be measured solely by the purpose of placing the United States unequivocally in compliance with its Berne Convention obligations. All copyright legislation is premised on Article I, section 8, clause 8 of the Constitution, which grants Congress the power to protect the "writings" of authors in order to "promote the progress of science." The proposed legislation must (and the Committee believes does) further this constitutional goal. Architecture plays a central role in our daily lives, not only as a form of shelter or as an investment, but also as a work of art. It<sup>\*90</sup> is an art form that performs a very public, social purpose. As Winston Churchill is reputed to have once remarked: "We shape our buildings and our buildings shape us." We rarely appreciate works of architecture alone, but instead typically view them in conjunction with other structures and the environment at large, where, at their best, they serve to express the goals and aspirations of the entire community. Frank Lloyd Wright aptly observed: "Buildings will always remain the most valuable aspect in a people's environment, the one most capable of cultural reaction." [n24]

The truth of this observation is borne out every day in the Capitol, which serves as a strong symbol of our country's dedication to democracy. The sheer number of visitors to the Capitol speaks eloquently to the success of that symbol. Indeed, the important relationship between democracy and architecture was well understood by our Founding Fathers. The design of the Capitol was strongly influenced by Thomas Jefferson, whose love of architecture is well known and visible today in his own works of architecture at Monticello and the University of Virginia.

Architecture is not unlike poetry, a point made renowned critic Ada Louise Huxtable, who wrote that architects can make "poetry out of visual devices, as a writer uses literary or aural devices. As words become symbols, so do objects; the architectural world is an endless source of symbols with unique ramifications in time and space." [n25]

In short, the Committee concluded that the design of a work of architecture is a "writing" under the Constitution and fully deserves protection under the Copyright Act. Protection for works of architecture should stimulate excellence in design, thereby enriching our public environment in keeping with the constitutional goal.

The Committee has carefully considered whether injunctive relief should be available for infringement of architectural works, and if so, under what conditions. Section 4 of H.R. 3990 contained a provision limiting injunctive relief against allegedly infringing buildings to circumstances where construction has not "substantially begun." Michael Graves, in his written statement to the Subcommittee argued:

<sup>\*91</sup> Categorically denying the copyright holder an injunction after construction has substantially begun does not lessen the resulting loss to the owner [of the building]. For example, approximately eighty percent of the architect's fees has normally been earned before construction begins. In addition, before the commencement of construction, an

owner typically spends large sums of money for land, surveys, engineering fees, carrying costs, fees in connection with zoning approvals, and legal fees. [n26]

The American Institute of Architects similarly argued:

Generally, we are not in favor of the destruction of useful buildings, and we fully expect a court would require a strong showing from a copyright owner before ordering such drastic action. On the other hand, it is not at all inconceivable that a situation could arise where the very existence of an infringing structure is an irreparable injury to the copyright owner. In that case, the courts should not be precluded from ordering a halt to construction, [or] a substantial alteration so as to make the building not infringing, or even to tear the building down if the evidence properly supports that conclusion. We are confident that the courts will appropriately weigh the public policy concerns about economic waste against the interests of the copyright owner. [n27]

H.R. 3990 proceeded on the assumption that injunctions against allegedly infringing buildings embodying protected architectural works may present issues different than other forms of authorship. Architectural works are the only form of copyrightable subject matter that is habitable. Large scale architectural projects involve an almost bewildering number of state and local permit processes that must be navigated, and typically involve a considerable number of interests in addition to the architect and client, including lending institutions, contractors, subcontractors, unions, and suppliers.

Nevertheless, it ultimately was concluded that these differences were not substantial enough to justify the limitations found in H.R. 3990 as introduced. [n28] As a practical matter, buildings embodying protected architectural works must be expressed in plans deposited with and approved by local planning commissions before construction can begin. \*92 A copyright owner who is unsure whether a completed structure will infringe his or her protected architectural work can review these plans and gain valuable information in making such a judgment. Thus, in many cases costly delays necessitated by uncertainties over the ultimate design may be avoided.

Title II therefore does not contain the limitation on injunctive relief contained in H.R. 3990, as introduced. Injunctive relief for alleged infringement of architectural works will be governed by the general principles applicable to all categories of subject matter, [n29] taking into account the complexities and different affected interests described above.

Those general principles are expressed first in Rule 65, Federal Rules of Civil Procedure (the provisions of which are applicable to copyright infringement actions), and second in the standards for injunctive relief developed by the Federal judiciary. The Committee is aware that various courts have developed different standards for injunctive relief, or at least enunciated the general principles for injunctive relief in different ways. Nevertheless, all would agree, and the Committee believes, that "equitable considerations, in this as in all fields of law, are pertinent to the appropriateness of injunctive relief. The public interest is always a relevant consideration for a court in deciding whether to issue an injunction." [n30]

One equitable doctrine that may have particular relevance in suits to enjoin allegedly infringing architectural works is laches. The AIA noted in its statement that copyright owners may have to make a strong showing of entitlement to remedial relief in cases where an allegedly infringing structure has been substantially begun or completed. [n31] The Committee agrees and therefore expects that injunctions will be sparingly used in such cases, but does not wish to preclude such relief in appropriate circumstances.

As a counterbalance to the injunctive relief authority of copyright holders, the owners of buildings are granted the flexibility to alter or modify the structures they own, or even to demolish them. [n32] H.R. 3990, as introduced, contained a limitation on the right to alter a building containing a protected architectural work.

### \*93 SECTION-BY-SECTION ANALYSIS

#### Section 1. - Short Title

Section 1 provides that the bill may be referred to as the "Copyright Amendments Act of 1990."

#### TITLE I. - COMPUTER SOFTWARE

...

#### TITLE II. - ARCHITECTURAL WORKS

##### Section 201. - Short Title

This section provides that this title may be cited as the "Architectural Works Copyright Protection Act of 1990."

##### Section 202. - Definitions

Section 202 adds a new definition ("architectural work") to the Copyright Act and amends an existing definition ("Berne Convention work").

Subsection (a) amends section 101 of title 17, United States Code, to provide a definition of the subject matter protected by the bill, "architectural works." An "architectural work" is defined as "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."

The definition has two components. First, it states what is protected. Second, it specifies the material objects in which the architectural work may be embodied. The protected work is the design of a building. The term "design" includes the overall form as well as the arrangement and composition of spaces and elements in the design. The phrase "arrangement and composition of spaces and elements" recognizes that: (1) creativity in architecture frequently takes the form of a selection, coordination, or arrangement of unprotectable elements into an original, protectable whole; (2) an architect may incorporate new, protectable design elements into otherwise standard, unprotectable building features; and (3) interior architecture may be protected.

Consistent with other provisions of the Copyright Act and Copyright Office regulations, [n35] the definition makes clear that protection does not extend to individual standard features, such as common windows, doors, \*94 and other staple building components. A grant of exclusive rights in such features would impede, rather than promote, the progress of architectural innovation. The provision is not, however, intended to exclude from the copyright in the architectural work any individual features that reflect the architect's [n36] creativity.

Critic Ada Louise Huxtable once provided the following comment that may be helpful as an expression of the policy behind the legislation:

[T]echnology is not art, and form only follows function as a starting point, or life and art would be much simpler than they are. The key to the art of architecture is the conviction and sensitivity with which technology and function are interpreted aesthetically, in solutions of a practical social purpose. [n37]

Architect Michael Graves, a witness before the Subcommittee, provided further guidance in an essay entitled "A Case for Figurative Architecture." Mr. Graves explained his design efforts by describing two types of architectural language, "internal" and "poetic." Internal language is "intrinsic to building in its most basic form-determined by pragmatic, constructional, and technical requirements." Poetic language is "responsive to issues external to the building, and incorporates the three-dimensional expression of the myths and rituals of society." [n38] The intent of the legislation is to protect only what Mr. Graves calls "poetic language."

During the Subcommittee's 1990 hearing, testimony was received that a potential gap in protection may exist where an architectural work has been depicted in plans or drawings, but has not yet been constructed. [n39] Since the original definition of architectural work in H.R. 3990 referred only to architectural works "as embodied in" buildings, there was concern that a defendant with access to the plans or drawings could construct an identical building but escape liability so long as the plans or drawings were not copied.

The Register of Copyrights disagrees that liability could be avoided in such circumstances, arguing that the witnesses misconstrued the \*95 access prong of infringement analysis. The Register's position, based on general principles of copyright law, is that where a three-dimensional work meets the standard for protection,

infringement may lie regardless of whether access to the three-dimensional work is obtained from a two-dimensional or three-dimensional depiction thereof. [n40]

In order to resolve this debate, subsection 202(a) of title II of H.R. 5498 modifies the definition of architectural work so that a work of architecture may be embodied in the built design—the constructed three-dimensional building— or in plans, drawings, or in "any tangible medium of expression," such as a blueprint or computer disk. Protection for architectural plans, drawings, and models as pictorial, graphic, or sculptural works under section 102(a)(5), title 17, United States Code, is unaffected by this bill.

This change does, however, raise questions regarding the relationship between copyright in the architectural work and copyright in plans and drawings. The bill's intention is to keep these two forms of protection separate. An individual creating an architectural work by depicting that work in plans or drawing will have two separate copyrights, one in the architectural work (section 102(a)(8)), the other in the plans or drawings (section 102(a)(5)). Either or both of these copyrights may be infringed and eligible separately for damages. [I]n cases where it is found that both the architectural work and the plans have been infringed, courts or juries may reduce an award of damages as necessary to avoid double remuneration, but the basic concept of election of protection [n41] is important and must be preserved.

The Subcommittee made a second amendment in the definition of architectural work: the deletion of the phrase "or three-dimensional structure." This phrase was included in H.R. 3990 to cover cases where architectural works embodied in innovative structures that defy easy classification. Unfortunately, the phrase also could be interpreted as covering interstate highway bridges, cloverleaves, canals, dams, and pedestrian walkways. The Subcommittee examined protection for these works, some of which form important elements of this nation's transportation system, and determined that copyright protection is not necessary to stimulate creativity or prohibit unauthorized reproduction.

\*96 The sole purpose of legislating at this time is to place the United States unequivocally in compliance with its Berne Convention obligations. Protection for bridges and related nonhabitable three-dimensional structures is not required by the Berne Convention. Accordingly, the question of copyright protection for these works can be deferred to another day. As a consequence, the phrase "or other three-dimensional structures" was deleted from the definition of architectural work and from all other places in the bill.

This deletion, though, raises more sharply the question of what is meant by the term "building." Obviously, the term encompassed habitable structures such as houses and office buildings. It also covers structures that are used, but not inhabited, by human beings, such as churches, pergolas, gazebos, and garden pavilions.

Subsection (b) amends the definitions of "Berne Convention work" in section 101, title 17, United States Code, to provide a point of attachment for national eligibility purposes. An architectural work is a "Berne Convention work" if the building in which the

architectural work is embodied "is erected in a country adhering to the Berne Convention." This amendment is necessitated by United States membership in the Berne Union.

### Section 203. - Subject Matter of Copyright

This provision amends section 102, title 17, United States Code, to create a new category of protected subject matter: "architectural works." By creating a new category of protectible subject matter in new section 102(a)(8), and, therefore, by deliberately not encompassing architectural works as pictorial, graphic, or sculptural works in existing section 102(a)(5), the copyrightability of architectural works shall not be evaluated under the separability test applicable to pictorial, graphic, or sculptural works embodied in useful articles. There is considerable scholarly and judicial disagreement over how to apply the separability test, [n42] and the principal reason for not treating architectural works as pictorial, graphic, or sculptural works is to avoid entangling architectural works in this disagreement. [n43]

The Committee does not suggest, though, that in evaluating the \*97 copyrightability or scope of protection for architectural works, the Copyright Office or the courts should ignore functionality. 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 reached to examine whether the design elements are functionally required. If the design elements are not functionally required, the work is protectible without regard to physical or conceptual separability. As a consequence, contrary to the Committee's report accompanying the 1976 Copyright Act with respect to industrial products, [n44] the aesthetically pleasing overall shape of an architectural work could be protected under this bill. [n45]

The proper scope of protection for architectural works is distinct from registrability. Functional considerations may, for example, determine only particular design elements. Protection would be denied for the functionally determined elements, but would be available for the nonfunctional determined elements. Under such circumstances, the Copyright Office should issue a certificate of registration, letting the courts determine the scope of protection. In each case, the courts must be free to decide the issue upon the facts presented, free of the separability conundrum presented by the useful articles doctrine applicable for pictorial, graphic, and sculptural works. Evidence that there is more than one method of obtaining a given functional result may be considered in evaluating registrability or the scope of protection.

The proposed legislation incorporates the general standards of originality applicable for all other copyrightable subject matter. This standard "does not include requirements of novelty, ingenuity, or [a]esthetic merit." [n46] Subjective determinations of artistic or aesthetic merit are inappropriate and contrary to fundamental principles of copyright law. [n47]

As a result of the incorporation of the general standard of originality for architectural works, determinations of infringement of architectural works are to be made according to the same standard applicable to all other forms of protected subject matter. The references in the definition of "architectural work" to "overall form," and to the nonprotectability \*98 of "individual standard features" are not intended to indicate that a higher standard of similarity is required to prove infringement of an architectural work, or that the scope of protection of architectural works is limited to verbatim or near-verbatim copying. These definitional provisions are intended merely to give the courts some guidance regarding the nature of the protected matter. The extent of protection is to be made on an ad hoc basis.

#### Section 204. - Scope of Exclusive Rights on Architectural Works

Section 204 creates a new section 120 of title 17, United States Code, limiting the exclusive rights in architectural works.

Subsection (a) of new section 120 permits the unauthorized making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place." [n48] Similar exceptions are found in many Berne member countries, and serve to balance the interests of authors and the public. [n49] Architecture is a public art form and is enjoyed as such. Millions of people visit our cities every year and take back home photographs, posters, and other pictorial representations of prominent works of architecture as a memory of their trip. Additionally, numerous scholarly books on architecture are based on the ability to use photographs of architectural works.

\*99 These uses do not interfere with the normal exploitation of architectural works. Given the important public purpose served by these uses and the lack of harm to the copyright owner's market, the Committee chose to provide an exemption, rather than rely on the doctrine of fair use, which requires ad hoc determinations. After a careful examination of the provisions of the Berne Convention, the laws of other Berne member countries, and expert opinion, the Committee concluded that this exemption is consistent with our obligations under the Convention. [n50]

Subsection (b) provides a limitation on the copyright owner's right-under section 106(2) of title 17, United States Code-to prepare derivative works. Subsection (b) permits the owner of a building embodying a protected architectural work to "make or authorize the making of alterations to such building, and to destroy or authorize the destruction of such building" without the copyright owner's consent. [n51] With respect to the right to destroy a building embodying a protected architectural work, the provision is consistent with existing section 109(a) of title 17, United States Code. Section 109(a) permits the owner of a particular copy or phonorecord lawfully made to "sell or otherwise dispose of the possession of that copy or phonorecord." While the provisions of section 109(a)

apply to architectural works, in light of the fact that architectural works represent a new category of protected subject matter, and unlike other forms of subject matter are habitable, the Committee believed it advisable to spell out expressly the limitations contained in section 120(b). [n52]

#### \*100 Section 205. - Preemption

Section 205 amends section 301(b) of title 17, United States Code, by adding a new paragraph (4). The new provision provides that state and local landmark, historic preservation, zoning, or building codes relating to architectural works protected under section 102(a)(8) are not preempted by the Copyright Act. These codes will, accordingly, not be affected by passage of the bill.

#### Section 206. - Effective Date

The bill is prospective, protecting: (1) "architectural works created on or after the date of enactment"; and, (2) "architectural works that on the date of enactment are unconstructed and embodied in unpublished plans or drawings." This latter form of protection is subject to possible termination on December 31, 2002 depending on whether the work has been constructed by that date, and is derived from the bill's definition of architectural work. Under the definition, an architectural work can be embodied in any tangible medium of expression, including architectural plans or drawings. An architectural work that has not been constructed before the date of enactment, but which has been embodied in plans or drawings which themselves are unpublished on the date of enactment, is protected under the bill against unauthorized construction that occurs on or after the date of enactment. [n53] The result does not violate prohibitions against retroactivity since the activity giving rise to liability-construction of a substantially similar architectural work-can only occur on or after the date of enactment, and since the architectural work is embodie[d] in subject matter that is itself already protected under the Copyright Act, namely, unpublished plans or drawings.

This provision does, however, raise the question of term of protection. To aid copyright owners, the public, and the courts, the Committee \*101 believes it would be helpful to explain in some detail the various terms of protection that will vest under the bill.

#### Architectural Works created on or after the date of enactment

These works will be governed by section 302 of title 17, United States Code: that is, works created by individuals will have a copyright measured by the life of the author plus 50 years; works created under a work-made-for-hire arrangement, anonymously, or under a pseudonym will have a copyright measured from 100 years from creation or 75 years from publication, whichever occurs first. The Committee considered, but rejected, amending the Copyright Act to provide a special definition of publication of an

architectural work. Instead, the general definition in section 101, title 17, United States Code, will apply. [n54]

#### Architectural Works unconstructed on the date of enactment

The term of protection for architectural works unconstructed on the date of enactment and embodied in unpublished plans or drawings will be governed by sections 302 and 303 of title 17, United States Code. In order to encourage authors of architectural works to construct their unpublished creations, a provisional cut-off date of December 31, 2002, has been provided: works that would ordinarily be eligible for a term of protection continuing past that date will lose protection on that date if the architectural work has not been constructed. [n55] The actual term will vary depending upon a number of factors, including whether the work was created by an individual, or under a work-made-for-hire arrangement, or whether the work is published before December 31, 2002, [n56] but two basic categories may be identified. Within each category, two examples are given, illustrating the relevant principle governing the calculation of term.

1. Works created by individuals. - These works will be governed in the first instance by the life plus 50 years post mortem auctoris term in section 302 of title 17, United States Code:

\*102 A. Author dies in 1990. Term will expire in 2040 under section 302; however, under the bill the term will expire on December 31, 2002 unless the architectural work is constructed by that date.

B. Author died in 1940. Under section 303, the term will expire on December 31, 2002, unless the architectural work is constructed and published before that date, in which case protection will expire on December 31, 2027.

2. Works created under work-made-for-hire.- These works will be governed in the first instance by the term set forth in section 302 of title 17, United States Code: 100 years from the date of creation; the 75 year term for published works made-for-hire will not apply, since the provisions of section 6 of the proposed legislation are limited to architectural works that are unconstructed on the date of enactment.

A. Work is created in 1902. Term will expire on December 31, 2002, unless the work is constructed and published before that date, in which case the term will expire on December 31, 2027.

B. Work is created in 1950. Term will expire 2050, unless the work is not constructed by December 31, 2002, in which case protection will expire on that date.

#### COMMITTEE OVERSIGHT FINDINGS

In compliance with clause 2(1)(3)(A) of rule XI of the Rules of the House of Representatives, the Committee reports that the findings and recommendations of the Committee, based on oversight activities under clause 2(b)(1) of rule X of the Rules of

the House of Representatives, are incorporated in the descriptive portions of this report. The Committee has oversight over the functioning of the Copyright Act, including the administrative responsibilities of the Copyright Office, and conformity of American law to our treaty (bilateral and multilateral) responsibilities.

#### COMMITTEE ON GOVERNMENT OPERATIONS OVERSIGHT FINDINGS

No findings or recommendations of the Committee on Government Operations were received as referred to in clause 2(1)(3)(D) of rule XI of the Rules of the House of Representatives.

#### NEW BUDGET AUTHORITY AND TAX EXPENDITURES

Clause 2(1)(3)(B) of House Rule XI is inapplicable because this legislation does not provide new budgetary authority or increased tax expenditures.

#### \*103 CONGRESSIONAL BUDGET OFFICE COST ESTIMATE

In compliance with clause 2(1)(C)(3) of rule XI of the Rules of the House of Representatives the Committee sets forth, with respect to the bill H.R. 5498, the following estimate and comparison prepared by the Director of the Congressional Budget Office under section 403 of the Congressional Budget Act of 1974:

U.S. CONGRESS, CONGRESSIONAL BUDGET OFFICE, Washington, DC,  
September 21, 1990.

Hon. JACK BROOKS,  
Chairman, Committee on the Judiciary,  
U.S. House of Representatives, Washington, DC.  
DEAR MR. CHAIRMAN:

The Congressional Budget Office has reviewed H.R. 5498, the Copyrights Amendments Act of 1990, as ordered reported by the House Committee on the Judiciary, September 18, 1990. We estimate that the bill would result in additional annual costs to the Copyright Office of about \$100,000. These costs would be at least partially offset by receipts collected for the registration of copyrighted material or recordation of certain computer software.

Title I would prohibit the rental, lease, or loan of computer software programs for purposes of commercial advantage, with certain exceptions. This title would require the Register of Copyrights to establish regulations to administer this provision and to report

within three years on the effects of the bill. In addition, the Register of copyrights would be required to record and maintain documents regarding computer shareware. Based on information from the Copyright Office, these provisions would not result in significant costs or additional receipts.

Title II would expand existing copyright protections to architectural works. Under this title, the Copyright Office would be charged with preparing new forms, reviewing copyright applications, and cataloging registrations. CBO estimates that these duties would result in annual costs of about \$100,000. These costs would be offset to a significant extent by filing fees paid by persons who wish to register copyrights for architectural works. Based on information from the Copyright Office, these fees could total up to \$100,000 each year. However, the actual collections would depend on the number of applications, which is very uncertain. If you wish further details on this estimate, we will be pleased to provide them. The staff contact is Laura Carter, who can be reached at 226-2860.

Sincerely,

ROBERT D. REISCHAUER,

Director.

#### \*104 INFLATIONARY IMPACT STATEMENT

Pursuant to clause 2(1)(4) of rule XI of the Rules of the House of Representatives, the Committee estimates that H.R. 5498 will have no significant inflationary impact on prices and costs in the national economy.

#### CHANGES IN EXISTING LAW MADE BY THE BILL, AS REPORTED

In compliance with clause 3 of rule XIII of the Rules of the House of Representatives, changes in existing law made by the bill, as reported, are shown as follows (existing law proposed to be omitted is enclosed in black brackets, new matter is printed in italic, existing law in which no change is proposed is shown in roman):

#### TITLE 17, UNITED STATES CODE

...

#### CHAPTER I - SUBJECT MATTER AND SCOPE OF COPYRIGHT

Sec.

101. Definitions.

102. Subject matter of copyright: In general.

...

119. Limitations on exclusive rights: Secondary transmissions of superstations and network stations for private home viewing.

120. Scope of exclusive rights in architectural works.

§ 101. Definitions As used in this title, the following terms and their variant forms mean the following:

An "anonymous work" is a work on the copies or phonorecords of which no natural person is identified as author.

An "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.

...

A work is a "Berne Convention work" if-

(1) ...

...

(3) in the case of an audiovisual work -

(A) ...

(B) if one or more of the authors is an individual, that author is domiciled, or has his or her habitual residence in, a nation adhering to the Berne Convention; [or]

\*105 (4) in the case of a pictorial, graphic, or sculptural work that is incorporated in a building or other structure, the building or structure is located in a nation adhering to the Berne Convention[.]; or

(5) in the case of an architectural work embodied in a building, such building is erected in a country adhering to the Berne Convention.

§ 102. Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in an intangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) ...

...

(6) motion pictures and other audiovisual works; [and]

(7) sound recordings[.]; and

(8) architectural works.

...

§ 106. Exclusive rights in copyrighted works

Subject to sections 107 through [119] 120, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

(1) ...

...

§ 109. Limitations on exclusive rights: Effect of transfer of particular copy or phonorecord

(a) ...

[(b)(1) Notwithstanding the provisions of subsection (a), unless authorized by the owners of copyright in the sound recording and in the musical works embodied therein, the owner of a particular phonorecord may not, for purposes of direct or indirect commercial advantage, dispose of, or authorize the disposal of, the possession of that phonorecord by rental, lease, or lending, or by any other act or practice in the nature of rental, lease, or lending. Nothing in the preceding sentence shall apply to the rental, lease, or lending of a phonorecord for nonprofit purposes by a nonprofit library or nonprofit educational institution.]

(b)(1)(A) Notwithstanding the provisions of subsection (a), unless authorized by the owners of copyright in the sound recording or the owner of copyright in a computer program (including any tape, disk, or other medium embodying such program), and in the case of a sound recording in the musical works embodied therein, neither the owner of a particular \*106 phonorecord nor any person in possession of a particular copy of a computer program (including any tape, disk, or other medium embodying such program), may, for the purposes of direct or indirect commercial advantage, dispose of, or authorize the disposal of, the possession of that phonorecord or computer program (including any tape disk, or other medium embodying such program) by rental, lease or lending, or by any other act or practice in the nature of rental, lease, or lending. Nothing in the preceding sentence shall apply to the rental, lease, or lending of a phonorecord for nonprofit purposes by a nonprofit library or nonprofit educational institution. The transfer of possession of a lawfully made copy of a computer program by a nonprofit educational institution to another nonprofit educational institution or to a faculty, staff, and students does not constitute rental, lease, or lending for direct or indirect commercial purposes under this subsection.

(B) This subsection does not apply to-

- (i) a computer program which is embodied in a machine or product and which cannot be copied during the ordinary operation or use of the machine or product, or
- (ii) a computer program embodied in or used in conjunction with a limited purpose computer that is designed for playing video games and may be designed for other purposes.

(C) Nothing in this subsection affects any provision of chapter 9 of this title.

(2)(A) Nothing in this subsection shall apply to the lending of a computer program for nonprofit purposes by a nonprofit library, if each copy of a computer program which is lent by such library has affixed to the packaging containing the program warning of copyright in accordance with requirements that the Register of Copyrights shall prescribe by regulation.

(B) Not later than three years after the date of the enactment of the Computer Software Rental Amendments Act of 1990, and at such times thereafter as the Register of Copyright considers appropriate, the Register of Copyrights, after consultation with representatives of copyright owners and librarians, shall submit to the Congress a report stating whether this paragraph has achieved its intended purpose of maintaining the

integrity of the copyright system while providing nonprofit libraries the capability to fulfill their function. Such report shall advise the Congress as to any information or recommendations that the Register of Copyrights considers necessary to carry out the purposes of this subsection.

[(2)] (3) Nothing in this subsection shall affect any provision of the antitrust laws. For purposes of the preceding sentence, "antitrust laws" has the meaning given that term in the first section of the Clayton Act and \*107 includes section 5 of the Federal Trade Commission Act to the extent that section relates to unfair methods of competition.

[(3) Any person who distributes a phonorecord in violation of clause (1) is an infringer of copyright under section 501 of this title and is subject to the remedies set forth in sections 502, 503, 504, 505, and 509. Such violation shall not be a criminal offense under section 506 or cause such person to be subject to the criminal penalties set forth in section 2319 of title 18.]

(4) Any person who distributes a phonorecord or a copy of a computer program (including any tape, disk, or other medium embodying such program) in violation of paragraph (1) is an infringer of copyright under section 501 of this title and is subject to the remedies set forth in sections 502, 503, 504, 505, and 509. Such violation shall not be a criminal offense under section 506 or cause such person to be subject to the criminal penalties set forth in section 2319 of title 18.

...

(e) Notwithstanding the provision of sections 106(4) and 106(5), in the case of an electronic audiovisual game intended for use in coin-operated equipment, the owner of a particular copy of such a game lawfully made under this title, is entitled, without the authority of the copyright owner of the game, to publicly perform or display that game in coin-operated equipment, except that this subsection shall not apply to any work of authorship embodied in the audiovisual game if the copyright owner of the electronic audiovisual game is not also the copyright owner of the work of authorship.

...

#### § 120. Scope of exclusive rights in architectural works

(a) PICTORIAL REPRESENTATIONS PERMITTED. - The copyright in an architectural work that has been constructed does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.

(b) ALTERATIONS TO AND DESTRUCTION OF BUILDINGS. - Notwithstanding the provisions of section 106(2), the owners of a building embodying an architectural work may, without the consent of the author or copyright owner of the architectural work, make or authorize the making of alterations to such building, and destroy or authorize the destruction of such building.

...

\*108 CHAPTER 3-DURATION OF COPYRIGHT

...

§ 301. Preemption with respect to other laws

(a) ...

(b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to-

(1) ...

(2) any cause of action arising from undertakings commenced before January 1, 1978; [or]

(3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 [.]; or

(4) State and local landmarks, historic preservation, zoning, or building codes, relating to architectural works protected under section 102(a)(8).

...

[n4] See Hearing on Architectural Design Protection Before the Subcomm. on Courts, Intellectual Property, and the Administration of Justice of the House Comm. on the Judiciary, 101st Cong. 2d Sess. (1990) [hereinafter referred to as "Architectural Design Hearings").

[n5] With the deletion of fair use reform from H.R. 5498, architectural works protection, formerly Title III, became Title II.

[n17] For further background about the proposed legislation, see 136 Cong. Rec. E259 (daily ed. Feb. 7, 1990) (introductory remarks of Robert W. Kastenmeier); Architectural Design Hearings, *supra* note 4.

[n18] Public Law 100-568, 102 Stat. 2853.

[n19] The reference to "architectural plans" was added by the Berne Convention Implementation Act of 1988. *Id.* Committee reports accompanying the 1976 Copyright Act indicated that such works were protected under that Act. Indeed, the Copyright Office registered architectural plans and drawings under the 1909 Copyright Act. See generally, "Copyright in Works of Architecture: A Report of the Register of Copyrights" (June 1989), Chapter 4.

[n20] H. Rept. No. 94-1476, 94th Cong., 2d ses. 55 (1976).

[n21] H.R. 1623, 100th Cong., 1st Seas. (1987) (Kastenmeier); H.R. 2962, 100th Cong., 1st Sess. (1987) (Moorhead, on behalf of the Administration). See also S. 2904, 99th Cong., 2d Sess. (1986) (Mathias); S. 1301, 100th Cong., 1st Sess. (1987) (Leahy); S. 1971, 100th Cong., 1st Sess. (1987) (Hatch, on behalf of the Administration). H.R. 1623 and S. 1301 would have limited protection to architectural works having "an original artistic character." The other bills did not contain this limitation.

[n22] Berne Convention Implementation Act of 1987: Hearings on H.R. 1623 Before the Subcomm. on Courts, Civil Liberties and the Administration of Justice of the House Comm. on the Judiciary, 100th Cong., 1st & 2d Sess. 679- 680 (statement of Prof. Paul Goldstein); 689 (statement of former Register of Copyrights Barbara Ringer) (1987 & 1988) (citing H. Rept. No. 94- 1476, 94th Cong., 2d sess. 55 (1976)).

[n23] "Copyright in Works of Architecture: A Report of the Register of Copyrights" (June 1989).

[n24] "F.W. [sic] Wright, on Architecture" (1941).

[n25] A. Rossi, "Memory and Metaphor in Architecture Anyone?" at 45-46 (1986). See also Architectural Design Hearings, *supra* note 4, at 136 (statement of Frank Lloyd Wright Foundation): "Architectural art is no less art than its counterparts in the world of sculpture and painting .."; *id.* at 49 (statement of Register of Copyrights Ralph Oman): "[Architecture is] one of the oldest and most revered forms of Art."

[n26] Architectural Design Hearings, *supra* note 4, at 18-19.

[n27] *Id.* at 117.

[n28] For example, the production of motion pictures also involves many of the complications discussed above with respect to architectural works. The Committee is unaware of any complaints from the motion picture industry over injunctions.

[n29] See 17 U.S.C. section 502.

[n30] *New Era Pubs. Aps. Int'l v. Henry Holt & Co.*, 884 F.2d 659, 663 (2d Cir. 1989) (denying pet. for reh'g en banc), cert. denied, 58 U.S.L.W. 3528 (U.S. Feb. 20, 1990) (Newman, J., dissenting). See also *id.* at 661: "All now agree that injunction is not the automatic consequence of infringement and that equitable considerations always are germane to the determination of whether an injunction is appropriate." (Miner, J., concurring.)

[n31] *Id.*

[n32] *Id.* (statement of Jeffrey M. Samuels).

[n35] See 17 U.S.C. SS 102(b) (1978); 37 CFR 202.1.

[n36] Protection is not limited to architects. Any individual creating an architectural work is entitled to exercise the exclusive rights, granted under the bill, without regard to professional training or state licensing requirements. The general provisions of the Copyright Act governing ownership and transfer of copyrighted works shall apply equally to architectural works.

[n37] A.L. Huxtable, "Architecture Anyone?" (1986).

[n38] Graves, "Buildings and Projects 1966-1981" at 11 ([19]82).

[n39] This point was eloquently made by Professor Jane C. Ginsburg in a statement submitted to the Subcommittee. See Architectural Design Hearings, *supra* note 4, at 184-187.

[n40] *Id.* at 67-68.

[n41] The Subcommittee was aware that certain works of authorship which may separately qualify for protection as pictorial, graphic, or sculptural works may be permanently embodied in architectural works. Stained glass windows are one such example. Election is inappropriate in any case where the copyright owner of a pictorial, graphic, or sculptural work embodied in an architectural work is different from the copyright owner of the architectural work.

[n42] See Perlutter, "Conceptual Separability and Copyright in the Design of Useful Articles," 37 J. Copr. Soc'y 339 (1990) for a helpful review of this issue.

[n43] Monumental, nonfunctional works of architecture are currently protected under section 102(a)(5) of title 17 as sculptural works. These works are, nevertheless, architectural works, and as such, will not be protected exclusively under section 102(a)(8).

[n44] H. Rep. No. 94-1476, 94th Cong., 2d sess. 55 (1976).

[n45] Chairman Kastenmeier forcefully made these points in his introductory statement on the House floor, 136 Cong. Rec. E259-60 (daily ed. Feb. 7, 1990).

[n46] H. Rept. No. 94-1476, 94th Cong., 2d mu. 51 (1976).

[n47] *Bleistein v. Donaldson Lithographic Co.*, 188 U.S. 239 (1903).

[n48] As introduced, Section 4 of H.R. 3990 limited the exemption in section 102(a) to instances where the architectural work was "located in a public place." The Subcommittee added the phrase "or ordinarily visible from" after the works "located in" to broaden the exemption to include buildings located on private property but visible from a public place. Nothing in this amendment permits or condones trespassing in order to make such pictorial representations.

[n49] These include the Central African Republic (Article 15); Chile (Articles 43, 44); Colombia (Article 44); Congo (Article 7); Costa Rica (Article 71); Czechoslovakia (Article 32); Denmark (Article 25); Finland (Article 25); Federal Republic of Germany (Article 59(1)); India (Articles 52(s), (x)); Ireland (Article 12(3)(b)); Israel (Article 2); Luxembourg (Article 21); Mexico (Article 18(c)); Morocco (Article 20); New Zealand (Articles 20(3)-(5)); Norway (Article 23); Pakistan (Articles 57(1)(s) & (t)); Peru (Article 72); Poland (Articles 20(5) & (6)); Rwanda (Article 18(4)); Senegal (Article 14); South Africa (Articles 10(2) & (4)); Sweden (Article 25); Switzerland (Article 30(g)(3)); Tunisia (Article 14); United Kingdom (Articles 59 (1) & (2), 62); Uruguay (Article 44 (cX2)); Venezuela (Articles 44(3)); Yugoslavia (Articles 48(4) & (5); 49(5)). Cf. Belgium Article 21bis (reproduction permissible only where necessary for reporting current events; Iceland (Article 16; where the architectural work forms the chief motif of the two-dimensional reproduction, the author is entitled to remuneration); Japan (Article 46; "imitative reproductions" are not permitted, nor reproductions whose purpose is exclusively the selling of copies of the work); Netherlands (Article 18; similar to Iceland). French case law makes distinctions similar to those found in the Icelandic statute. See Huet, "Architecture and Copyright," 19 UNESCO Copyright Bulletin 18 (1985).

[n50] The American Institute of Architects (AIA) proposed an amendment to section 120(a) prohibiting pictorial representations made in order to further the unauthorized design and construction of a substantially similar architectural work. The Subcommittee believed such an amendment was unnecessary. If an unauthorized substantially similar architectural work is constructed, it is irrelevant how the design of the infringing building is achieved so long as the design is not independently created.

The proposed AIA amendment might also interfere with scholarly and noncompetitive analysis of architectural works, and with the ability of photographers to pursue their livelihood. The American Society of Magazine Photographers wrote to the Subcommittee opposing the AIA amendment on this ground.

[n51] This provision was supported by all witnesses at the Subcommittee's hearing. See Architectural Design Hearings, *supra* note 4.

[n52] The proposed legislation does not amend section 106 of title 17, United States Code, regarding "Exclusive rights in copyrighted works". Accordingly, the owner of copyright in an architectural work is granted a right of reproduction, a right to prepare derivative works (limited, however, by section 120(b)), and a right to distribute the architectural work, but it is not given a right to publicly perform or publicly display the architectural work. The right of public performance has no applicability to architectural works. While the right to publicly display an architectural work would have some benefit to copyright owners, the right would conflict with section 120(a), and, further, is not required by the Berne Convention.

The Committee considered the question of moral rights for architectural works. None of the witness at the Subcommittee's March 14, 1990 hearing testified in favor of an express statutory grant of such rights. Accordingly, the bill does not contain an express or implied statutory grant of moral rights. Architects' moral rights will, therefore, be governed by the law as currently exists. See Berne Convention Implementation Act of 1988, Public Law 100-568, sec. 3(b), 102 Stat. 2853.

[n53] The Subcommittee deliberately limited this provision to architectural works embodied in unpublished plans or drawings, rather than using the broader term "any tangible medium of expression" contained in the definition of "architectural work." The purpose of the exception is to encourage architects who have kept drawings and plans private to disclose them free of fear that disclosure will result in lack of protection against a substantially similar constructed architectural work.

[n54] "Publication" is the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or photorecords for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication."

[n55] This date is derived from 303, title 17, United States Code.

[n56] The definition of "publication" in the 1976 Copyright Act is to be used in making these determinations. The term of protection for the plans and drawings embodying the architectural work is unaffected by this bill. Since architectural plans and drawings represent a separate category of authorship from architectural works, publication of plans and drawings is not publication o[f] an architectural work.

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