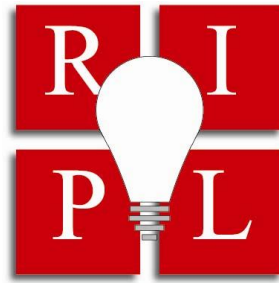


THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



THE BUILDING BLOCKS OF COPYRIGHT PROTECTION FOR ARCHITECTURAL WORKS: ROADBLOCK OR MASTERPIECE?

VAUGHN DROZD

ABSTRACT

The current test for determining substantial similarity for architectural works is detrimental to the utility of the United States as well as architects' creativity. The "total concept and feel" test is ill-equipped to determine whether architectural copyright infringement has occurred, as it does take into account the value that many architectural works provide to society. Further, the "ordinary observer" is an artificial concept that cannot be used to determine whether copyright infringement has occurred with such a highly technical field as architecture. This comment breaks down the current system used to analyze copyright infringement for architectural works. Then, this comment proposes a new, hybrid test courts can use to evaluate copyright infringement and determine whether two architectural works are substantially similar.

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VAUGHN DROZD

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VAUGHN DROZD*

I. INTRODUCTION

Imagine an architect has been hired by a large corporate hotel chain to create a design plan for one of its newest hotels.¹ The architect meets with hotel executives to understand their functionality needs and to get some sense of any overall corporate look or feel they would like incorporated into the work.² He then quickly begins working on the design.³ After countless days of measurements and calculations, the proud architect finishes the design and presents the finished product to the corporation.

Two years later, the architect checks into a hotel while in Europe on an unrelated project. Much to his surprise (and horror) it greatly resembles, if not duplicates, the design for his hotel client two years prior. Can the architect take action against the hotel corporation for reproducing his work without his consent?⁴

Alternatively, imagine now that the architect has been engaged to design a hospital. He incorporates new concepts of solar and wind power and in doing so, permits the hospital to be operated much more efficiently and cheaply than before. This is because the material needed is much easier to obtain. Does this make a difference?

Finally, assume that a client reproduces the architecture's designs for the building but attempts to make a number of changes in order to escape infringement.⁵ How far

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¹ The architect does not fall under 17 U.S.C. §201(b) "work made for hire" because he is an independent contractor. The architect does not fit the doctrine of "work made for hire" according to *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 751 (1989). The court used factors to determine whether a project was or was not "work made for hire." Some of the factors included whether the sculptor received employee benefits, used his own tools, had a deadline, and had complete control over of the design of the project.)

² The architect hereinafter will be referred to as 'he' or 'his' when referring to the architects possession. 'He' means 'him or 'her'.

³ For the purposes of this comment readers are to assume that the ownership rights of the design or work is not spelled out in the contract terms. Although the AIA forms specify that the rights to the works are exclusively the architects, these forms are not always used.

⁴ This hypothetical is loosely based on *Oravec v. Sunny Isles Luxury Ventures L.C.*, 469 F. Supp. 2d 1148 (S.D. Fla. 2006) (The defendant developed and build condominiums based on the copyrighted architectural plans of the plaintiff).

⁵ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 364 (1991) (explaining that the elements for infringement are the ownership of a valid copyright and a copying of "constituent elements" of the work that are original); *Johnson v. Gordon*, 409 F.3d 12, 18 (1st Cir. Mass. 2005) (stating that the

does copyright protection go to protect the architect's original expression? How different does the new building have to be?

These scenarios present numerous questions of ownership and liability. This comment will examine these scenarios at different times during the development process. Part I will look at the purpose of a copyright and discuss a brief history of copyright protection for architectural works both in the United States and in Europe. Part II will examine the different approaches states, circuit courts, and countries have taken to address the architectural copyright protection dispute. Part III proposes a balancing factor test that will attempt to solve the ownership and liability dilemma.

II. BACKGROUND

Copyright legislation was enacted to protect and encourage the creation of artistic works.⁶ Over time, legislators began to stress the importance of protecting additional subject matter such as architectural works.⁷ But this protection is far from absolute since the public has an interest in both expanding and limiting the protection for architectural works.⁸ This section will discuss copyright protection for architectural works on a historical timeline. It is important to understand the United States' stance on copyright protection for architectural works and how it has evolved over time in order to predict what the future may hold. It is also relevant to know how foreign countries have addressed the architectural works protection in order to understand different perspectives on a solution.

A. What Is A Copyright?

Modern copyright is a codified federal protection for the creator of an original work that grants the creator the right to prevent others from exploiting that work.⁹ Copyrights do not protect the process or method of creating the work.¹⁰ Problems arise, however, when the owner thinks that a building design is part of their "brand" or

portions of the original plans that were copied must be enough to render the copy "substantially similar").

⁶ Lisa A. Zakolski, 18 Am. Jur. 2d Copyright an Literary Property §2(2014)(Explaining that the immediate effect of copyright law is to protect the economic interests of architects, the real purpose is to foster the public interest in stimulating more creative works); *See also* Video Pipeline, Inc. v. Buena Vista Home Entertainment, Inc., 342 F.3d 191 (3d Cir. 2003, as amended, (Sept. 19,2003)

⁷ *See* Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124 (1790 Act); Act of Feb. 3, 1831, ch. 16, §§ 1, 16, 4 Stat. 436, 439 (1831 Act); Act of Mar. 4, 1909, ch. 320, §§ 23-24, 35 Stat. 1080-1081 (1909 Act); 17 U.S.C. § 101 (1976)(demonstrating a gradual change to protect for a more broad category of works including architectural works).

⁸ *Gates Robber Co. v. Bando Chemical Industries, Ltd.* 9 F.3d 823, 839(10th Cir. 1993) The court described the need to weigh the protection for works and the importance of allowing reasonable use when it said:

Copyright policy is meant to balance protection, which seeks to ensure a fair return to authors and inventors and thereby to establish incentives for development, with dissemination, which seeks to foster learning, progress and development.

Id.

⁹ 17 U.S.C § 102 (2006).

¹⁰ *Id.*

“image” and that they own the rights to reproduce these plans by virtue of having paid the architect.¹¹

Copyright law exists to encourage creators to continue creating new works without having to worry about their original ideas being manipulated for a third party’s gain without the creator’s consent.¹² This benefits the public by incentivizing the creation of bigger and better things.¹³ Although not the primary purpose, copyright laws also allow creators to make a living by selling the work product and limiting those who may use it.¹⁴

Artistic protection finds its roots in the United States Constitution, which empowers Congress to enact laws to protect artistic original works.¹⁵ Although Congress was granted the power to provide protection for “artistic creations,” architectural works did not enjoy the same amount of protection until much later.¹⁶

B. Changing Times

Copyright protection for architectural works has not always been prevalent in the United States.¹⁷ The first copyright laws protected only literary and some artistic works including “maps, charts, and books.”¹⁸ Hardly any development in copyright protection for architectural works occurred after the Copyright Act of 1790, until the copyright act of 1909¹⁹ (the “1909 act”).

Architectural works were not explicitly included in the copyright protections after the Copyright Act of 1909 act, but were still considered copyrightable works in some instances.²⁰ The 1909 Act included a “catch all” provision specifying that all works of

¹¹ Emanuel B. Halper, *Negotiating Architectural Contracts*, 18 Real Est. Rev. 50, (1988). (suggesting that businesses might insist on using an architecture’s designs to build identical buildings in all of their different locations).

¹² 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.03[A] (2014) [hereinafter NIMMER]

¹³ See *Id.* (suggesting that the primary purpose is for public benefit and not to protect the beneficial gains that the creators might experience as a result of these works).

¹⁴ *SOFA Entm’t, Inc. v. Dodger Prods., Inc.*, 709 F.3d 1273, 1277-78(9th Cir. 2013)(Explaining that the doctrine of fair use was created because copyrights granted creators “limited monopolies” over their works); See also *On Davis v. The Gap, Inc.*, 246 F.3d 152,165(2nd Cir.2001)(Stating that a “principle objective” of copyright law is to grant creators the rights to grant licenses to others to use their works or sell their works outright).

¹⁵ U.S. Const. art. 1 § 8, cl. 8. (granting Congress the power “to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective writings and Discoveries”).

¹⁶ U.S. Comp. St. 1901. p. 3406. (There is a strong suggestion that copyright protection at this time applied only to artistic and literary works).

¹⁷ William F. Patry, 2 Patry on Copyright § 3:60 (2014)(showing that architectural works were not expressly protected until 1990).

¹⁸ William F. Patry, 1 COPYRIGHT LAW & PRACTICE 28, 30(1994); See also Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124 (1790 Act);

¹⁹ *Id.* at 36-56. (Providing list of amendments from the copyright act of 1790 to the copyright act of 1909. Most of the amendments included prints and notice, jurisdictional, deposit, or artistic and literary changes)

²⁰ *DeSilva Const. Corp. v. Herrald*, 213 F. Supp. 184, 193 (M.D. Fla. 1962). The court in *DeSilva* explained that although not explicitly mentioned in the copyright act, architectural works were still protected. The court said:

the author would be protected.²¹ As a result, many courts during this time relied on this provision in holding that architectural blueprints were protected by the 1909 Act.²² Although there were numerous amendments to the 1909 act, it was not until the Copyright Act of 1976 that congress expressly protected architectural works.²³

C. The Copyright Act of 1976: Utilitarian vs. Artistic

In 1976, Congress passed The Copyright Act of 1976 (the “1976 Act”) that afforded architectural works a broad range of protections under “pictorial, graphic, and sculptural works.”²⁴ The act provides creators and design professionals exclusive rights with regard to their works.²⁵ But this protection was not absolute since the fair use doctrine allows for reproduction of the work if certain criteria are met.²⁶ Courts use these criteria to determine whether the subsequent creation resembled the original work enough to constitute an infringement.²⁷ Courts have held that if a work is reproduced for a commercial purpose and affects the potential market for the original work, it is not a fair use and hence not permitted.²⁸

The 1976 Act does not however protect the procedure or process of building the architectural work according to the blueprint or drawing.²⁹ Nor does the 1976 Act deal

Although not mentioned expressly in a separate category in the statutes, architectural plans (including drawings and models) are clearly copyrightable under the present copyright laws under the specified class of drawings or plastic works of scientific or technical nature.

Id.

²¹ PATRY, *supra* note 17, at 58.

²² Imperial Homes Corp. v. Lamont, 458 F.2d 895 (5th Cir. 1972); Herman Frankel Organization v. Tegman, 367 F.Supp. 1051(E.D. Mich. 1973) (both courts recognizing that architectural floor plans were protected as “drawings or plastic works of a scientific or technical nature” under the Copyright act of 1909).

²³ Patry, *supra* note 17, at 61.

²⁴ 17 U.S.C § 102 (a)(5)(1976); *see also id.* at § 101 (The copyright act of 1976 defines architectural work as “the design of a building as embodied in any tangible medium of expression.” It continues to explain that the work includes the overall arrangement and composition of the design but excludes any standard features of the drawing); *see also* Ginsburg, *Copyright in the 101st Congress: Commentary on the Visual Artists Rights Act and the Architectural Works Copyright Protection Act of 1990*, 14 Colum.-VLA J.L. & Arts 477, 490 (1990)(explaining that architectural structures did not receive explicit protection under the Copyright Act of 1976. The artistic craftsmanship of the architectural was protected but not the mechanical or utilitarian aspects were not).

²⁵ 17 U.S.C. §§ 106, 107(factors to consider when determining whether a *fair use* of the work is present are: the purpose and character of the use, including whether the use is commercial or for nonprofit educational use; the nature of the copyrighted work; the amount of original work that is used in the reproduced work; and the market value effect on the original work); Ginsburg, *supra*, at 491(specifying that useful architectural works were only protected as pictorial, graphic, or sculptural works if their artistic features could be separated and stand independently of their useful aspects).

²⁶ *Id.*

²⁷ Aitken, Hazen, Hoffman, Miller, P. C. v. Empire Constr. Co., 542 F. Supp. 252, 260(D. Neb.1982)

²⁸ *Id.* (holding that there was no fair use because the defendant used the plaintiff’s architectural works for the same purpose that the plaintiff would have used them and essentially “destroyed the plaintiff’s potential market”).

²⁹ 17 U.S.C § 102.

with the construction or reproduction of architectural works after they are finished.³⁰ After the 1976 Act, many courts engaged in a balancing test often holding that utilitarian interests embedded in any design professional's work outweighed the interest of the professional in protecting that works from reproduction.³¹ The court's reasoning in *Brandir International, Inc.* represented the way of thinking at the time.³² Another consistent issue is whether there has been a copyright violation when there has been no reproduction of the physical design work (i.e. the architectural drawing or blueprint), but end product (the building) has been reproduced based on the visualization of the physical structure.³³

As a result, after the 1976 Act, courts repeatedly held that copyright protection did not extend to a solely utilitarian article.³⁴ The utilitarian idea of "useful articles" denied copyright protection to works that could not be separated from their utilitarian aspects.³⁵ The courts could not easily separate the artistic aspects of a given architectural work from its overwhelming utilitarian function and therefore denied protection for those works.³⁶

D. The Berne Convention

The Berne Convention of 1886, with its final amendment in 1979, originated in Europe.³⁷ The purpose of the convention was to extend copyright protection to all literary and artistic works of creators from countries that were members of Berne.³⁸ Creators from member countries enjoyed automatic protection even if their works were

³⁰ 17 U.S.C § 120 (the section does not specifically state the scope of the exclusive protection but only implies that the finished products are protected. The inference is drawn from the sentence: "the copyright in an architectural work that has been constructed does not include..." This allows us to assume that finished works enjoy the same protection that the architectural plans do).

³¹ See *Scholz Homes, Inc. v. Maddox*, 379 F.2d 84 (6th Cir. 1967) (citing *Baker v. Selden*, 101 U.S. 99, 102 (1880)) (Standing for the proposition that copyright only applied to the architectural designs themselves and not to the subsequent construction and reproduction of the finished building);

³² *Brandir International, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987) (stating that utilitarian concepts are highly relevant to considering whether a work is copyrightable and that the decision should hinge on whether the artistic expression is independent of the utilitarian concepts).

³³ *Scholz Homes, Inc.*, 379 F.2d at 85.

³⁴ *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 418 (2d Cir. 1985); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 912 (2nd Cir. 1980) (holding that copyright protection extended to the artistic portion of the work, but did not extend to the mechanical or utilitarian concepts. Therefore, because the artistic aspects of the work could not be separated according to the "separability doctrine" and could not stand independently of their utilitarian counterparts, the entire work was not protected").

³⁵ *Gay Toys, Inc. v. Buddy L. Corp.*, 703 F.2d 970, 974 (6th Cir. 1983) (applying the separability doctrine to see if the utilitarian aspects of an article could be independent from its artistic aspects. Copyright law would only protect the artistic portions of the article if they could exist independently of the utilitarian aspects).

³⁶ *Id.*

³⁷ Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, as revised at Paris on July 24, 1971 and amended in 1979, S. Treaty Doc. No. 99-27 828 U.N.T.S 221 [hereinafter *The Berne Convention*].

³⁸ The Berne Convention, art. 2 § 6 (Stating that the works explained in the article shall be protected in all member countries for the benefit of the author).

not published.³⁹ The convention also provided protection for creators who were not citizens of a member country, but had their works first published in a member country.⁴⁰ This means that architectural works published in a Berne member country receive more protection than if the works were used in the United States.⁴¹

The Berne Convention specifically protects architectural works, including both building and other structures located in a member country.⁴² Although the Berne Convention offered protection for literary or artistic works, it also allows the government to permit reproduction of a work without the creators consent.⁴³ This is an important exception because it provides for a way to circumvent protection for highly useful works as long as legislation is passed to approve the reproduction.⁴⁴ The Berne Convention also required that its members extend copyright protection to completed works.⁴⁵

The United States joined the Berne Convention when it enacted the Berne Convention Implementation Act of 1988.⁴⁶ In doing so, it narrowly adopted the Berne Convention policies that were not recognized in the United States prior to its adoption.⁴⁷ Specifically, the United States wanted to adopt some of the moral rights policies and copyright formalities that were introduced by the Berne Convention.⁴⁸ This offered creators the heightened protection afforded architectural works overseas.

Legislators explained that one of the main objectives for joining the Berne Convention was to cover American products, protected by American copyright, from being exploited when exported to foreign countries.⁴⁹ In adopting the Berne Intervention Implementation act, the United States attempted to implement the ideas

³⁹ The Berne Convention, art. 3 §(1)(a)(stressing the significance of providing protection for works even if they are never made public or for architectural plans used to construct a building).

⁴⁰ *Id.*

⁴¹ *Id.*

⁴² The Berne Convention, art. 4 (b)(The view of Article 4 differs from the copyright law specifically in the United States, which does not offer copyright protection for non livable structures).

⁴³ The Berne Convention, art. 9(2). (The legislation to circumvent the lack of creator's consent for reproduction of the artistic work is subject to the requirement that the "reproduction does not conflict with normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author")

⁴⁴ *Id.*

⁴⁵ *Id.* at art. 6bis.

⁴⁶ The Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (1988)

⁴⁷ William Belanger, U.S. COMPLIANCE WITH THE BERNE CONVENTION, 3 Geo. Mason Ind. L. Rev. 373, 375 (1995)(stating that the reason for different policies between the United States copyright and copyright under the Berne Convention was because of the Utilitarian concepts followed in the United States, which is a common law state. Members of the Berne Convention were civil law states, which focused more on rights of individuals or "authors" in protecting their creations. This is why the United States initially adopted the Berne Convention in a very narrow and limited sense.)

⁴⁸ *Id.*(Stemming from the same idea; that the United States was attempting to move from a more Utilitarian ideology to a more moralistic attitude geared toward protecting the rights of authors or creators).

⁴⁹ S.REP. No. 352, 100th Cong., 2d Sess. (1988), *reprinted in* 1988 U.S.C.C.A.N 3706, 3707, 1988 WL169894. [hereinafter SENATE REPORT] See senate stating "At a time when the United States is suffering a large overall trade deficit, works protected by copyright-such as books, sound recordings, motion pictures, and computer software- routinely generated a trade surplus"

of the Berne Convention, while hoping to reconcile them with the doctrine of “Fair Use”⁵⁰ present in the 1976 Copyright act.⁵¹

*E. The Architectural Works Copyright Protection Act*⁵²

In 1990, in response to the narrow adoption of the Berne Convention, Congress amended the Copyright act of 1976 by enacting the Architectural Works Copyright Protection Act (the “AWCPA”).⁵³ The AWCPA granted architects the exclusive right to alter or reproduce their works.⁵⁴ This was the first time that legislators in the United States codified a law to explicitly recognize copyright protection for architecture works.⁵⁵

The AWCPA not only protects the professional from reproduction of its architectural designs, but it also explicitly protects him or her from reproduction of the buildings (if completed after the date specified in the Act) based on that design.⁵⁶ As a result, architects in the United States now enjoy some copyright protection for both plans and finished products.⁵⁷

But that protection is limited.⁵⁸ The AWCPA does not protect individual standard features used in constructing the overall design.⁵⁹ For example, common windows are used in the plan are not protected.⁶⁰ The Act also permits pictorial representations of buildings visible in a public place.⁶¹

⁵⁰ 17 U.S.C. § 107. (The factors discussed to determine whether there is a fair use are: “The purpose and character of the use; the nature of the copyrighted work; the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and the effect of the use upon the potential market for value of the copyrighted work.”)

⁵¹ *Chicago Bd. Of Educ. v. Substance, Inc.*, 354 F.3d 624 (7th Cir. 2003). (stating that while fair use is an important doctrine for the protection of public interest, the copier must not copy any more than is reasonably necessary).

⁵² Act Dec. 1, 1990, Pub. L. No 101-650, 701, 104 Stat., 5133(1990). [Hereinafter AWCPA].

⁵³ H.R. REP. NO. 735, 101st Cong., 2d Sess. (1990), *reprinted in* 1990 U.S.C.C.A.N. 6935,6935 1990 WL 200440 [hereinafter THE HOUSE REPORT](explaining that the overall purpose of the act is to bring the United states to “full compliance with its multilateral treaty obligation as specific in the Berne Convention for the Protection of Literary and Artistic Works.”)

⁵⁴ 17 U.S.C § 102 (8)(the new section granting creators protection for their architectural works was added as a result of the Architectural Works Copyright Protection Act).

⁵⁵ AWCPA, *Supra* note 52, at 703. (stating that “architectural works” will be added to the list of “works of authorship” enumerated in section 102 of the Copyright act of 1976).

⁵⁶ *Id.* at 706; *See also*, THE HOUSE REPORT (specifying that protection for architectural works now applies to completed projects that came from the original works).

⁵⁷ *Id.* at 702; 17 U.S.C § 101 (defining “architectural work” as the design of a building as embodies in any tangible medium of expression, including a building, architectural plans, or drawings.”)

⁵⁸ AWCPA §§ 702-704.

⁵⁹ AWCPA at 702(a); *See also* THE HOUSE REPORT, *supra* note 53, at 19-20(specifying that copyright protection is not to include protection for standard features such as common windows, doors and other components because granting copyright protection over those basic materials would hold contrary to the innovation of an architect).

⁶⁰ *Id.*

⁶¹ *Leicester v. Warner Bros.*, 232 F.3d 1212, 1219 (9th Cir. Cal. 2000) (holding that a building was considered an architectural work, not a sculptural work. In so holding, the court applied the exception to copyright protection for architectural works under the Architectural Works Copyright Protection Act of 1990. The exception that the court applied was for pictorial representations of buildings);

The owners of a building are allowed to make alterations to the buildings or even destroy them if they so choose.⁶² If the architect chooses to use a buildings structure as a form of expression, he or she loses the right to create “derivative works”.⁶³ The architect then loses the right to transform or modify the work according to the original design.⁶⁴ The AWCPA vests some interest in the building design and its protection in the current owner of the building.⁶⁵

F. Establishing Infringement with Feist

With the AWCPA, Congress ensured that architectural works now enjoy protection without reference to the “separability doctrine”.⁶⁶ The separability doctrine was used to determine whether a architectural work was artistic or utilitarian by examining its individual parts.⁶⁷ After the AWCPA, the Supreme Court in *Feist* addressed what is actually protected⁶⁸, what constitutes infringement⁶⁹, and whether the work was original.⁷⁰

Landrau v. Betancourt., 554 F.Supp 2d, 102 (D.P.R.2007);Tiffany Design v. Reno-Tahoe Specialty, Inc., 55 F.Supp. 2d, 113(D.Nev.1999).

⁶² 17 U.S.C. § 120(b)(demonstrating the right that the owner will have to destruct or alter the building regardless of the architect’s exclusive right to his works according to 17 U.S.C §106(2))

⁶³ Dream Custom Homes, Inc. v. Modern Day Constr., Inc.,773 F. Supp. 2d 1288, 1300(M.D. Fla.2011)(stating that the copyright protection only extends to the building plans themselves, and that copying of a building after it has already been constructed is not violative of copyright law even if the plans are copyrighted).

⁶⁴ Javelin Invs., LLC v. McGinnis, 2007 U.S. Dist. LEXIS 21472 (S.D. Tex.2007)(reasoning that the application of 17 U.S.C §120 should be broad because if it were narrowly interpreted, it would essentially nullify what the statute attempted to accomplish).

⁶⁵ *Id.* at 26. (reiterating the fact that building owners should have an interest in modifying their buildings irrespective of the architects approval because it would run contrary to common sense to force a developer to start a building project and then not be able to finish the project if the architect changes his mind in approving the project. In that case, the builder would be left with no reasonable options to continue construction).

⁶⁶ See THE HOUSE REPORT at 6951 (specifying that finished architectural works enjoy copyright protection irrespective of their utilitarian aspects and whether they are separate from their artistic aspects).

⁶⁷ *Infra* note 87.

⁶⁸ *Feist Publ’ns, Inc.*, 499 U.S. at 345(1991)(citing *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 556 (1985))(explaining that the only portions of a work that are copyrightable are those that are original, or work that is independently created by the author as opposed to copied different works.)

⁶⁹ *Id.* at 361 (stating that ownership of a valid copyright and the copied elements must have been the unique and original to the creator in order for an infringement to occur).

⁷⁰ *Id.* (describing an “original” work as one that has not been copied from another and one that has a minimal amount of creativity);

Other courts have analyzed whether copying occurred on a substantial basis.⁷¹ Measuring the degree of similarity calls for an objective analysis.⁷² The overwhelming consensus in the courts is in favor of the subsequent creator.⁷³ Although this outcome is the consensus, the circuits have stated different reasoning for their decisions ranging from adding elements to the test or narrowing the protection for works.⁷⁴ Copyright protection for complete architectural works has essentially moved from non-existent to unattainable in light of the court's decisions after the AWCPA.

III. ANALYSIS

While it appears that there have been recent landmark advancements in copyright protection for architectural works, protection is in fact still very limited.⁷⁵ Recently courts have held that architectural works are still not protected, or if they were, the copies that were made of them were not so substantially similar to infringe on the copyright.⁷⁶

Part I of this section will look at utilitarian concepts and the justifications for denying copyright protections for architectural works after the 1976 Act and before the United States joined *Berne*.⁷⁷ Part II will discuss the rationale behind protecting architectural works despite their utilitarian aspects. Part III will analyze how the courts' reasons for denying copyright protection differ today from those used prior to the 1976 Act. Finally, Part IV will discuss how the courts' use of the substantial similarity test to deny copyright protection for architectural works defeats the goals the AWCPA seeks to accomplish.

⁷¹ *T-Peg, Inc. v. Vt. Timber Works, Inc.*, 459 F.3d 97, 108 (1st Cir. 2006)(establishing the test for the court to decide whether copying has actually occurred. The elements or copying are: "The defendant must have actually copied the work as a factual matter, either through direct evidence or indirect means, and the defendant's copying of the copyrighted material was so extensive that it rendered the infringing and copyrighted works 'substantially similar'").

⁷² *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 f.2d 821,829 (11th Cir. 1982)(describing the objective test for substantial similarity as "whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work").

⁷³ *Zalewski v. Cicero Builder Dev. Inc.*, 754 F.3d 95 (2d Cir. 2014); *Miller's Ale House, Inc. v. Boynton Carolina Ale House, LLC*, 702 F.3d 1312 (11th Cir. 2012).

⁷⁴ *Zalewski*, 754 F.3d at 100-101(requiring that the copying be "wrongful"); *Miller's Ale House, Inc.*, 702 F.3d at 1326(classifying the copyright protection for architectural works as "thin" and using the lay observer test to determine whether the copying was substantially similar).

⁷⁵ Raphael Winnick, *Copyright Portection for Architecture After the Architectural Works Copyright Protection Act of 1990.*, 41 Duke L.J. 1598, 1598 (1992)(maintaining that the AWCPA is very broad in subject matter but extremely limited in its actual protection).

⁷⁶ *Charles W. Ross Builder, Inc. v. Olsen Fine Home Bldg., LLC*, 977 F. Supp. 2d 567, 598(E.D. Va.2013); *Sieger Suarez Architectural P'ship, Inc. v. Arquitectonica Int'l Corp.*, 998 F. Supp. 2d 1340, 1352(S.D. Fla.2014)

⁷⁷ The Berne Convention, *supra* note 37.

A. The Importance of Utilitarian Ideology

After the 1976 Act⁷⁸ and before the AWCPA⁷⁹ courts and legislators were reluctant to conceive architectural works as “pictorial, graphical, or sculptural works”⁸⁰ because they contained useful or utilitarian concepts.⁸¹ These concepts were thought to be “useful articles.”⁸² “Useful articles” do not receive copyright protection because the public’s interest in having access to them outweighs the architect’s interest in protecting its works.⁸³ Further, courts feared that copyright protection for building methods might help create a monopoly that would ultimately be detrimental to overall productivity and efficiency.⁸⁴

In a Copyright Office of the United States report to the House Subcommittee of Intellectual Property, Ralph Oman, chief counsel to the Senate Subcommittee on Patent, Copyrights, and Trademarks,⁸⁵ addressed the reasons that Congress omitted protection for architectural works under the Copyright Act of 1976.⁸⁶ In his report, Oman explained that Congress focused on the “separability doctrine”⁸⁷ and required that a relatively high or relatively clear degree of separability between the utilitarian function of an article and its pictorial, graphic, or sculptural elements.⁸⁸

The report interpreted the language of the 1976 Act regarding architecture to mean that purely nonfunctional structures are protected without separability analysis and that artistic sculptures were also generally protected.⁸⁹ However, courts have had difficulty determining when and how to apply the separability test.⁹⁰ The difficulty, most

⁷⁸ 17 U.S.C. § 101.

⁷⁹ See AWCPA, *Supra* note 52.

⁸⁰ See 17 U.S.C. § 102(a)(5)(1976); See also COPYRIGHT OFFICE REPORT, *infra*, at iv.

⁸¹ See U.S. COPYRIGHT OFFICE, THE REPORT OF THE REGISTER OF COPYRIGHT ON WORKS OF ARCHITECTURE, ii- Appendix A, at ii (1989)[hereinafter COPYRIGHT OFFICE REPORT](outlining the reasons why congress did not explicitly protect architectural works in the Copyright Act of 1976).

⁸² 17 U.S.C. § 101 (1976) (defining “useful article” as: “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”).

⁸³ *Norris Industries, Inc. v. International Tel. & Tel. Corp.*, 696 F.2d 918, 923 (11th Cir. 1983)(holding wire wheel covers did not qualify as fine or applied artwork and were not separable artistic aspects that would overcome their utilitarian aspects); *Donald Frederick Evans & Assocs., Inc. v. Cont'l Homes, Inc.*, 785 F.2d 897,901 (11th Cir. 1986).

⁸⁴ See NIMMER, *supra* note 12, at § 2.18 [C][2] (criticizing the court in *Baker v. Selden*, 101 U.S. 99 (1879), declaring: “It is this dichotomy that permits the copying of a system or method *per se*, as long as the copier steers clear of the particular expression employed by the copyright claimant.”).

⁸⁵ U.S. Copyright Office, *Ralph Oman 1985-1993*, (Oct. 26, 2014, 11:43 AM).

⁸⁶ See generally, COPYRIGHT OFFICE REPORT.

⁸⁷ *Carol Barnhart Inc.*, 773 F.2d at 418(explaining the concept of the separability doctrine and how the courts applied it).

⁸⁸ See COPYRIGHT OFFICE REPORT, *Supra* note 81, at iii (opining that the regular application the separability doctrine made it harder for architectural works to obtain protection regardless of whether their main focus was utility or not. Essentially, it required that the work be solely a work of art in order for it to receive protection).

⁸⁹ *Id.* at xvii-xviii.

⁹⁰ See *Carol Barnhart, Inc.*, 773 F.2d at 411(distinguishing between physical and conceptual separability (*Newman, O. John, dissenting*)); *Norris Indus. v. Int'l Tel. & Tel. Corp.*, 696 F.2d 918, 923(11th Cir. 1983); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993(2d Cir. 1980).

notably, stems from the importance that utilitarian aspects play in society.⁹¹ Society values utility not only for efficiency and production value, but also for its preservation of the copyright system.⁹²

Utilitarian ideology has long been considered an important element of an effective and profitable economy.⁹³ The benefits of fostering utility in the United States are numerous.⁹⁴ Granting a subsequent professional the right to use the common articles in creating new works would foster creativity and efficiency in the world of architecture.⁹⁵

B. The Other Side of the Coin: Protection Rationale

The time after the 1976 Act presented a clear insufficiency in copyright protection for architectural works.⁹⁶ While architectural plans were now protected under “pictorial, graphical, or sculptural works,” architects did not enjoy the exclusive right to build or transfer that right to someone else.⁹⁷ Also, building designs enjoyed essentially no copyright protection.⁹⁸ This prompted legislatures and architects alike to push for more protection for completed architectural works.⁹⁹

The design professional would advance at least two reasons for supporting copyright protection for architectural works and design. First, vesting strict ownership of the works in the design professional helps limit its liability for injury, which could occur when building designs are copied or plans are used to construct a building.¹⁰⁰ This could happen when the building is constructed or copied in an area unsuitable for the original design and not taken into consideration by the architect.¹⁰¹ Second, the architect has an economic incentive to prevent their works and design from being

⁹¹ Sara K. Stadler, *Forging a Truly Utilitarian Copyright*, 91 Iowa L. Rev. 609, 670 (2006)(suggesting that copyright protection in the United States is not a natural right, but is actually limited because of our interest in utility).

⁹² *Id.* (noting that denying copyright to protection to certain architectural works because of their inherently utilitarian aspects preserves the notion of creativity by weighing the creator’s contribution to society. In doing so, it would encourage people to be more creative and use more of their own, original work in order to obtain copyright protection).

⁹³ Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 Colum. L. Rev. 1865, 1867-68 (1990)(clarifying that artistic works do not enjoy absolute protection).

⁹⁴ *Feist*, 499 U.S. at 349(claiming that exempting useful articles from copyright protection will give subsequent creators the ability to use those useful articles in their works as well, which in turn would benefit society as a whole).

⁹⁵ *Id.*

⁹⁶ THE HOUSE REPORT, *supra* note 53, at 6942.

⁹⁷ See NIMMER, *Supra* note 12, at § 2.08 [C][1][2].

⁹⁸ *Id.*

⁹⁹ THE HOUSE REPORT, *supra* note 53, at 6942-43.

¹⁰⁰ See COPYRIGHT OFFICE REPORT, *Supra* note 81, at 9 (exemplifying a situation where an architect would create building plans for a flat and dry environment being use to construct a building in a hurricane zone).

¹⁰¹ *Id.*

copied.¹⁰² The architect priced its job accordingly and does not anticipate, or should not be forced to anticipate, that the client can make unlimited use of the drawings.¹⁰³

The public's interest in protecting architectural works is two-fold.¹⁰⁴ First, the architect should be rewarded for the aesthetic and artistic work that they put into the works.¹⁰⁵ Second, which ties into the first, the public benefits because extending copyright protection to design works will incentivize professionals to produce them.¹⁰⁶

After joining the Berne Convention and enacting the Berne Convention Implementation Act of 1988, Congress attempted to satisfy the architect's interest and public's interest in encouraging creative and unique architectural works through enacting the AWCPA.¹⁰⁷ However, although architectural works now received explicit protection under the Copyright Act, courts did not see this protection as absolute.

C. Jurisprudence Before and After Berne

Before the Berne Implementation Act, courts offered little protection for architectural works.¹⁰⁸ The courts routinely denied such protection either because they were solely useful articles, or because they were not "separable" from their useful counterparts.¹⁰⁹ The court's reasoning in *Brandir International* is representative of the way that the court thought of solely useful articles before *Berne*.¹¹⁰

More importantly, the court's reasoning in *Carol Barnhart Inc.* exemplifies the concept of separability at that time.¹¹¹ *Carol Barnhart Inc.* is a landmark decision because it showcased the inherent problems of the separability doctrine.¹¹² The difference between physical and conceptual separability proved to be a hurdle that

¹⁰² *Id.* at 10(explaining an architect's economic interest in protecting his works because an architect presumably has the expectation of compensation for the work that he does, including the subsequent copies of those works).

¹⁰³ *Id.*

¹⁰⁴ John B. Fowles, *The Utility of a Bright-Line Rule in Copyright Law: Freeing Judges From Aesthetic Controversy and Conceptual Separability in Leicester v. Warner Bros.*, 12 UCLA Ent. L. Rev. 301, 305 (2005) (citing *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975)).

¹⁰⁵ *Id.*

¹⁰⁶ *Id.*

¹⁰⁷ THE COPYRIGHT OFFICE REPORT, *supra* note 81, at Appendix A. (letter from Robert. W. Kastenmeier requesting that the report include the effect increased copyright protection would have on economic competition and the public interest).

¹⁰⁸ *Scholz Homes, Inc.*, 379 F.2d at 84; *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905 (2nd Cir. 1980)

¹⁰⁹ See *Norris Indust.* 696 F.2d 918; *Durham Indus.*, 630 F.2d 905.

¹¹⁰ *Brandir International*, 834 F.2d at 1145 (holding that solely utilitarian articles were afforded no protection under the copyright act).

¹¹¹ *Carol Barnhart Inc.*, 773 F.2d at 418.

¹¹² *Id.* at 419-20 (Newman, O. John *dissenting*)(accusing the court of misunderstanding the separability doctrine. The dissent distinguishes the idea of physical separability and conceptual separability and suggests that the utilitarian and artistic the design feature of a work is easily distinguishable, or "conceptually separable").

most courts struggled surmount.¹¹³ Further, many different separability tests complicated the adjudication process.¹¹⁴

After addressing the “separability” problem¹¹⁵ in the House Report and subsequently adding explicit protection for architectural works under the AWCPA,¹¹⁶ courts heeded the task of figuring out what would constitute infringement.¹¹⁷ Using the second prong of the two-part test laid out in *Feist*,¹¹⁸ courts were forced to determine whether the copied elements were original.¹¹⁹ Courts analyzing the “original elements” prong of the *Feist* test must apply a two-part analysis: (1) whether there was evidence of direct or indirect copying,¹²⁰ and (2) whether the copying was so substantially similar to qualify as infringement.¹²¹

The courts apply these tests on a case by case basis.¹²² This is counterproductive because not only does it prevent architects from tailoring their actions to avoid

¹¹³ THE COPYRIGHT OFFICE REPORT, *supra* note 81, at xviii. The Copyright Office explains conceptual separability:

Conceptual separability means that the pictorial, graphic, or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper, for example, or as a free-standing sculpture, as another example, independent of the shape of the useful article, i.e., the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article. The artistic features and the useful article could both exist side by side and be perceived as fully realized, separate works- one an artistic work, and the other a useful article.

Id.

¹¹⁴ *Id.* at xix-xx (describing the numerous separability tests, including the “temporal displacement” test, the “ordinary observer” test, and the “two questions” approach).

¹¹⁵ Daniel Su, *Substantial Similarity and Architectural Works: Filtering Out “Total Concept and Fee”*, 101 Nw. U. L. Rev. 1851, 1865 (2007) (arguing that the AWCPA did not address the separability problem at all. Su argues, “Separability has merely been articulated in different terms. Rather than having to separate the artistic from the utilitarian aspects of a useful article, courts must now separate “original design” from “functionally required design.”).

¹¹⁶ THE HOUSE REPORT, *Supra* note 53, at 6950. (plainly stating that architectural works that do not contain functionally required design elements shall be protected irrespective of their physical or conceptual separability).

¹¹⁷ This was the result of the HOUSE REPORT, *Supra* note 53, suggesting that the courts move away from using the separability test in making determinations on whether an architectural work would be protected. Now that architectural works received protection irrespective of their utilitarian aspects, the court would not be able to analyze copyright protection for architectural works under the separability test. Therefore, its task was to determine what would constitute infringement after the AWCPA.

¹¹⁸ *Feist Pub’ns, Inc.*, 499 U.S. at 361 (the two part test for infringement includes: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original); *see also* *Johnson v. Gordon*, 409 F.3d 12, 18 (1st Cir. 2005).

¹¹⁹ *T-Peg, Inc.*, 459 F.3d at 108.

¹²⁰ *Feist Pub’ns, Inc.*, 499 U.S. at 361.

¹²¹ *Johnson*, 409 F.3d at 17-18 (emphasizing that copying is not automatically subject to infringement of copyright without proof that it was “wrongful.”); *see also* *Lotus Dev. Corp. v. Borland Int’l*, 49 F.3d 807, 813 (1st Cir. 1995) (stating “plaintiff must prove that the copying of copyrighted material was so extensive that it rendered the offending and copyrighted works substantially similar.”).

¹²² *Peter Pan Fabrics, Inc.*, 274 F.2d at 489 (L. Hand, J.) (explaining that any attempt to distinguish between copying of an idea, which does not receive protection, and artistic expression, which does, is very difficult and calls for an ad hoc basis for reviewing each claim for infringement).

infringement but it is also detrimental to efficiency and productivity.¹²³ So far, courts have not established a concrete “substantially similar” test.

D. Substantial Similarity Tests

The substantial similarity rule has long been established in the world of copyright protection.¹²⁴ Substantial similarity problems arise particularly when artistic expression is present.¹²⁵ Minor similarities are not enough to constitute infringement of an architectural work.¹²⁶ On the other hand, infringement does not require identical duplication.¹²⁷ Also, minor variations will not necessarily disprove an allegation of substantial similarity to another work.¹²⁸ Herein lies the difficulty that the circuits face when attempting to determine whether a work is substantially similar for purposes of infringement.¹²⁹ Different tests used for the substantially similar determination have evolved.¹³⁰

1. The Pattern Test

The pattern test focuses on the totality of two works.¹³¹ It looks at the two works side by side and considers a number of elements and whether they occur in similar succession.¹³² Other factors that are considered are character similarities and interaction between the characters.¹³³ The court then compares those elements to determine whether there is substantial similarity between the works albeit no literal similarity.¹³⁴

However, not all courts have accepted this test because it either shows too close a resemblance to the copying of an idea or because of little evidence of substantial

¹²³ *Id.*

¹²⁴ The idea of substantial similarity can be traced back to the United States Supreme Court in 1879 when it decided the case of *Baker v. Selden*, 101 U.S. at 104 (standing for the proposition that not only elements within a work enjoy copyright protection but the way in which those elements are arranged is also afforded copyright protection. However, the court found that infringement was still apparent because the copy was substantially similar to the original).

¹²⁵ See 4 NIMMER, *Supra* note 12, at § 13.03 (even when copying is present, infringement does not occur unless the copying is substantial).

¹²⁶ 4 NIMMER, *supra* note 12, at § 13.03.

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (L. Hand, J) (describing the attempt to draw a line between requiring absolute similarity and only minimal similarity as “arbitrary” and that any line drawn will be “vague”).

¹³⁰ 4 NIMMER, *supra* note 12, at § 13.03 [A][1] (reiterating that the tests only apply when there is no literal duplication of a work, but “comprehensive similarity” is clear).

¹³¹ *Id.* at § 13.03 [A][2]

¹³² Z. Chafee, *Reflections on the law of Copyright*, 45 Col. L. Rev. 503, 513 (1945).

¹³³ *Id.*

¹³⁴ 4 NIMMER, *supra* note 12, at § 13.03 [A][1][b] 29.1 (citing *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 929 (7th Cir. 2003)).

similarity.¹³⁵ This test is unhelpful in our regard because architectural works are often designed and built according to state regulation for safety or structural integrity.¹³⁶ Therefore, this test is ill equipped to answer the substantial similarity questions on architectural works.

2. The “Total Concept and Feel” Test

In the 1970’s, courts developed the “total concept and feel” test.¹³⁷ Under this test, the court will analyze two works using both an “extrinsic test” to identify similar ideas, and an “intrinsic test” to identify similar expression.¹³⁸ This test was regularly applied to simple works such as commercials, greeting cards, children’s books, and games.¹³⁹ The reason being is that this test calls for the “ordinary observer” to determine whether there is substantial similarity of expression between the two works.¹⁴⁰ The ordinary observer analysis in this test renders it detrimental to both artistic expression¹⁴¹ and utilitarian concepts.¹⁴²

The court cannot continue to use the “total concept and feel” test to circumvent its inability to deny copyright protection for architectural works based on separability.¹⁴³ As stated, an ordinary observer was used to determine whether useful articles were separable from its artistic articles.¹⁴⁴ Under the “total concept and feel” test, the same ordinary observer standard is used to determine whether a work is substantially similar.¹⁴⁵

The separability doctrine has failed and the “total concept and feel” test must fail for similar reasons. Therefore, we must attempt to construct a new substantially similar test that will help preserve essential utilitarian concepts, while adhering to *Berne* and the AWCPA.

¹³⁵ *Musto v. Meyer*, 434 F. Supp. 32 (S.D.N.Y. 1977); *Green v. Lindsey*, 885 F.Supp. 469 (S.D.N.Y. 1992)

¹³⁶ Thomas J. Stipanowich, *Reconstructing Construction Law: Reality and Reform in a Transactional System*, Wis. L. Rev. 463, 513-14 (1998).

¹³⁷ *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106 (9th Cir. 1970); *Reyher v. Children’s Television Workshop*, 522 F.2d 87 (2d Cir. 1976);

¹³⁸ *Sid & Marty Krofft Television Productions v. McDonald’s Corp.* 562 F.2d 1157, 1161(9th Cir. 1977).

¹³⁹ See NIMMER, *supra* note 12, at § 13.03 [A][1][c]

¹⁴⁰ *Sid & Marty Krofft Television Productions*, 562 F.2d at 1164.

¹⁴¹ See NIMMER, *supra* note 12, at § 13.03 [A][1][c](the ordinary observer test is destructive to our system of copyright because it would find no infringement even if there is nearly identical copying but no similar artistic expression in the eyes of a reasonable person).

¹⁴² In the event the court finds that an “ordinary observer” would see the works as substantially similar on account of unique expression, they would be protected even if they served a highly useful purpose, thus creating the problem in our second scenario with the hospital, *supra*, page 1.

¹⁴³ There is a striking similarity between the court’s use of the ordinary observer for the separability doctrine and its use of the ordinary observer for the “total concept and feel” similarity test.

¹⁴⁴ THE COPYRIGHT OFFICE REPORT, *supra* note 81(listing the different tests for separability).

¹⁴⁵ *Sid & Marty Krofft Television Productions*, 562 F.2d at 1164.

IV. PROPOSAL

The best way to solve the struggle between utilitarian ideology and protecting artistic expression in architectural works is to eliminate the “total concept and feel” test and the “ordinary observer” standard in favor of a hybrid approach. The problem lies where the courts have used the ordinary observer test to circumvent the explicit copyright protection for architectural works.¹⁴⁶

These decisions will likely be a slippery slope, diminishing protection for designs both artistic and useful.¹⁴⁷ The courts must address the real concern in protecting artistic works despite their highly useful nature. This section will propose a new “hybrid” approach that respects legislative policy while observing utilitarian principles.

A. Abandoning the “Total Concept and Feel” Test.

Widespread criticism of the total concept and feel analysis has gained traction over the years.¹⁴⁸ This criticism stems from two facts. First, the thought of implementing copyright protection for “concepts” may resemble protection of ideas, which has been explicitly denied.¹⁴⁹ Second, the “total concept and feel” analysis uses an “ordinary observer” standard to determine whether substantial similarity exists between two works in their entirety without separating their elements.¹⁵⁰

The total “concept and feel” analysis can cut both ways. Analyzing two architectural works under the “total concept and feel” test sometimes lead to a finding of substantial similarity even if the works appear similar because of common unprotectable items, thus harming the second architect and running contrary to legislative policy.¹⁵¹

Secondly, the “total concept and feel” analysis can be harmful to the first architect. The test permits the ordinary observer to conclude that the two aesthetically different works are not substantially similar even if majority of the original elements were replicated.¹⁵²

¹⁴⁶ *Id.*

¹⁴⁷ See *Stromback v. New Line Cinema*, 384 F.3d 283, 295 (6th Cir. 2004) (listing and explaining situations where expert testimony is required as part of the “total concept and feel” test. The suggestion contradicts the very nature of the ordinary observer standard used to determine whether two works are substantially similar according to the “total concept and feel” test).

¹⁴⁸ Edward Samuels, *The Idea-expression Dichotomy in Copyright Law*, 56 Tenn. L. Rev. 321, 426 (1989); See also 4 NIMMER, *supra* note 12, at § 13.03 [A][1][c]

¹⁴⁹ 4 NIMMER, *Supra* note 12, at § 13.03 [A][1][c].

¹⁵⁰ *Id.* (identifying this as a problem because the total concept and feel test was really meant for simple works and it would lead to an “abdication of analysis”).

¹⁵¹ See THE HOUSE REPORT, *supra* note 53, at 19-20 (stating that common elements such as doors and windows are not copyrightable unless arranged in a unique way).

¹⁵² *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 765 (2d Cir. 1991) (suggesting that if the ordinary observer is disposed to overlook the differences between two works without explicitly setting out to find them, the works would be substantially similar. To the contrary, if the building appears different and the ordinary observer would overlook the similarities, there would be no infringement).

Lastly, the “total concept and feel” analysis does not account for utilitarian aspects of architectural works.¹⁵³ This test does not allow courts to take into account the repercussions of offering architects absolute protection over their works regardless of how beneficial they are to society.¹⁵⁴ In an effort to reconcile modern copyright law with *Berne* and the *AWCPA*, courts have taken a lax view on the importance of utilitarian ideology.¹⁵⁵ In order to maintain its protection for architectural works while also remaining competitive amongst foreign countries in production and architecture, the United States should adopt a “hybrid” approach for determining substantial similarity.

B. The Hybrid Approach

Copyright protection for architectural works is extremely important from a “fostering creativity” standpoint.¹⁵⁶ However, retaining the ability to reproduce useful architectural works is also essential for a productive economy and society.¹⁵⁷ The proposed hybrid approach will allow reproduction of predominately useful architectural works while offering more protection for primarily artistic works.

1. Protection for Primarily Artistic Works

When examining two works, consideration of the creator’s intent and the work’s overall effect is appropriate. The bar for determining substantial similarity between two works is set low if the primary purpose and overriding effect of the work is artistic. The bar is set low because any useful aspects of the work are merely incident to its artistic expression.¹⁵⁸

A version of the “total concept and feel” test is appropriate for mainly artistic works because a reasonable observer could find substantial similarity when reproduction would serve no utilitarian purpose.¹⁵⁹ Under this standard, “adequate” or similarity is more of an appropriate standard.¹⁶⁰ This standard allows architects to

¹⁵³ 4 NIMMER, *supra* note 12, at § 13.03 [A][1][c] (opining that the “total concept and fee” analysis has no place in the world of computer programs because it was developed for simplistic works that require only “intrinsic” evaluation and that it serves no purpose in analyzing complex, multi-use, works that require expert analysis).

¹⁵⁴ See Stadler, *supra* note 91, at 670; See also Ginsburg, *supra* note 93, at 1876.

¹⁵⁵ *Brandir International*, 834 F.2d at 1145.

¹⁵⁶ See COPYRIGHT OFFICE REPORT, *Supra* note 81, at 9; See also, Fowles, *supra* note 104, at 305.

¹⁵⁷ See Stadler, *supra* note 91, at 670 (stating that copyright protection for utilitarian works is limited because of their benefit to society).

¹⁵⁸ See THE HOUSE REPORT, *supra* note 53, at 6936 (defining architecture as “artistic expression that performs a significant societal purpose, domestically and internationally.” This suggests that societal purpose is merely incident to the artistic expression of architecture in some instances.).

¹⁵⁹ See *Shine v. Childs*, 382 F. Supp 2d 602, 616 (S.D.N.Y 2005)(denying defendant’s summary judgment regarding defendant’s infringement claim. The court found that the architects copied designs were detailed and artistic enough that their usefulness was discounted and an ordinary observer could disagree as to whether they were substantially similar).

¹⁶⁰ 4 NIMMER, *supra* Note 12, at § 13.03 [A][1] (explaining that infringement is found if “the fundamental essence or structure of one work is duplicated in another.” In other words, under this

protect their artistic expression without having to worry about subsequent creators making minimal changes to escape infringement.¹⁶¹ Under this test, infringement results if the second work is “adequately” similar to the original that has minimal utilitarian purpose.

2. Protection for Predominately Useful Works

Alternatively, the court should apply the highest bar for substantial similarity when the work has a predominately useful purpose and effect.¹⁶² This standard would also apply when an architect’s intent is artistic creation but the work is extremely useful to society.¹⁶³

Under this test, the standard for determining similarity is more appropriately “definite” or “literal” similarity.¹⁶⁴ However, freedom from infringement under this analysis is not absolute.¹⁶⁵ The scope of this test will allow reproduction of highly useful architectural works up to a point not including outright duplication.¹⁶⁶ Using the “literal similarity” test for architectural works that have a useful effect would benefit the economy and society alike.¹⁶⁷ Also, a finding of literal similarity infringement reserves an architect’s interest in protecting their expression.¹⁶⁸

standard, no literal copying required for a finding of infringement under substantial similarity. Stating further, “The mere fact that the defendant has paraphrased rather than literally copied will not preclude a finding of substantial similarity.”

¹⁶¹ *Id.*

¹⁶² This situation is represented in the hospital hypothetical, *supra*, page 1-2. Here, the creator’s intent may have been partially artistic, but it would run contrary to public policy to offer absolute protection for this architectural work that is undeniably beneficial to society.

¹⁶³ *Id.*

¹⁶⁴ 4 NIMMER, *supra* Note 12, at § 13.03 [A][2](citing *Best Cellars Inc. v. Grape Finds at Dupont, Inc.*, 90 F. Supp. 2d 431,443,460 (S.D.N.Y. 2000)(explaining literal similarity as “virtually, though not necessarily, completely word for word between plaintiffs and defendant’s works).

¹⁶⁵ *Id.*

¹⁶⁶ See *id.* at §13.01 [B](outright duplication or copying in fact is prohibited but generally “not possible to establish copying as a factual matter by direct evidence, as it is rare that the plaintiff has available a witness to the physical act of copying.”; *Shine*, 382 F. Supp 2d at 611(describing the determination of copying in fact as a “rare situation,” which is why the analysis then reverts to substantial similarity).

¹⁶⁷ Allowing reproduction of useful works allows the courts to avoid the confusing analysis represented in *T-Peg, Inc.*, 459 F.3d at 112-113:

If the points of dissimilarity not only exceed the points of similarity, but indicate that the remaining points of similarity are, within the context of plaintiffs work, of minimal importance, either quantitatively or qualitatively, then no infringement results.

NIMMER, *supra* note 12, at §13.03 [B][1][a].

¹⁶⁸ *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1238 (3d Cir. Pa. 1986)(denying the argument a commentators argument that giving computer programs too much copyright protection would be detrimental to progress in the field).

3. The “Grey Area” Between Artistic and Useful Works.

The difficulty in applying these tests lies admittedly where many of the architectural works fall.¹⁶⁹ Often times it is not clear whether a creator intended the work as predominately artistic or useful. Additionally, many architectural works serve a dual purpose, both artistic and useful.¹⁷⁰ The question here is how courts should draw the line between useful and artistic architectural works for determining substantial similarity.¹⁷¹

Where a work serves both an artistic and useful purpose, the court should engage in “element separation” test.¹⁷² The “element separation test” allows the court to compare two works by breaking them down and looking at all of the individual elements to determine if the copied elements are protectable and unique to the original work.¹⁷³

First, the elemental breakdown of the original work is essential to determine which elements are protectable.¹⁷⁴ Next, since the arrangement of otherwise unprotectable elements is protectable,¹⁷⁵ the court will separate the unprotectable elements and determine if they are similarly arranged in the second work.¹⁷⁶ Lastly, the court must take into account utilitarian effects of the work as a whole.¹⁷⁷ The court will then make a decision after it’s analysis of these factors.¹⁷⁸ The hybrid test will fill the void between utilitarian concepts and artistic protection.

¹⁶⁹ See THE HOUSE REPORT, *supra* note 53, at 6951 (describing the judicial disagreement regarding the separability test for distinguishing useful aspects from artistic aspects of architectural works and how many architectural works fall into the category where both aspects are present).

¹⁷⁰ *Id.*

¹⁷¹ THE HOUSE REPORT, *supra* note 53, at 6952 (suggesting that the courts must be able to determine the protection issue without having to address the separability doctrine by which pictorial, graphic, and sculptural works are analyzed, and the decisions must be made on a case-by-case basis).

¹⁷² 4 NIMMER, *supra* note 12, at §13.03 [B][2][a] This test is similar to what Nimmer refers to as the “fragmented literal similarity” test, which charges the trier of fact with determining the significance of the common aspects between the two works.

¹⁷³ *Id.*

¹⁷⁴ This step is not to be confused with the “separability doctrine” used to distinguish useful aspects with artistic aspects according to 17 U.S.C. § 102(a)(5). During this step, all of the elements of the work will be “separated” from each other and then compared with second work, achieving a true comparison of each and every similar element between the works.

¹⁷⁵ 17 U.S.C. § 101 (a)

¹⁷⁶ 17 U.S.C. § 101 (a) Feist Publ'ns, Inc., 499 U.S. at 349 (stating that facts or common elements are protectable in a work is if they contain original selection and are arranged in a way that is indicative of expression).

¹⁷⁷ See THE HOUSE REPORT, *supra* note 53, at 6951. Taking the overall usefulness of an architectural work into account as a factor as opposed to separating the individual useful articles from the artistic articles according to 17 U.S.C. § 101(a) comports with legislative policy.

¹⁷⁸ *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 579(1994)(specifying that not all of the factors used to determine fair use are required for a fair use finding). The proposed test is similar to the “fair use” test because not all factors are required for infringement. A weighing of the factors is appropriate here.

V. CONCLUSION

The current system for determining substantial similarity is detrimental for original and subsequent architects. The “total concept and feel” test is ill equipped to analyze architectural works with predominately different purposes and effects.¹⁷⁹ We must persist in utilitarian productivity and efficiency while complying with *Berne* and the AWCPA by developing a test that is more differential to reproduction in certain situations.¹⁸⁰

The circumstances in which architectural works are created are too disparate for one level of analysis. The “hybrid” approach will reconcile the legislative policy of copyright protection and the public’s interest in productivity and efficiency.

¹⁷⁹ THE HOUSE REPORT, *supra* note 53, at 6951 (“subjective determinations of artistic or aesthetic merit are inappropriate and contrary to the fundamental principles of copyright law.”).