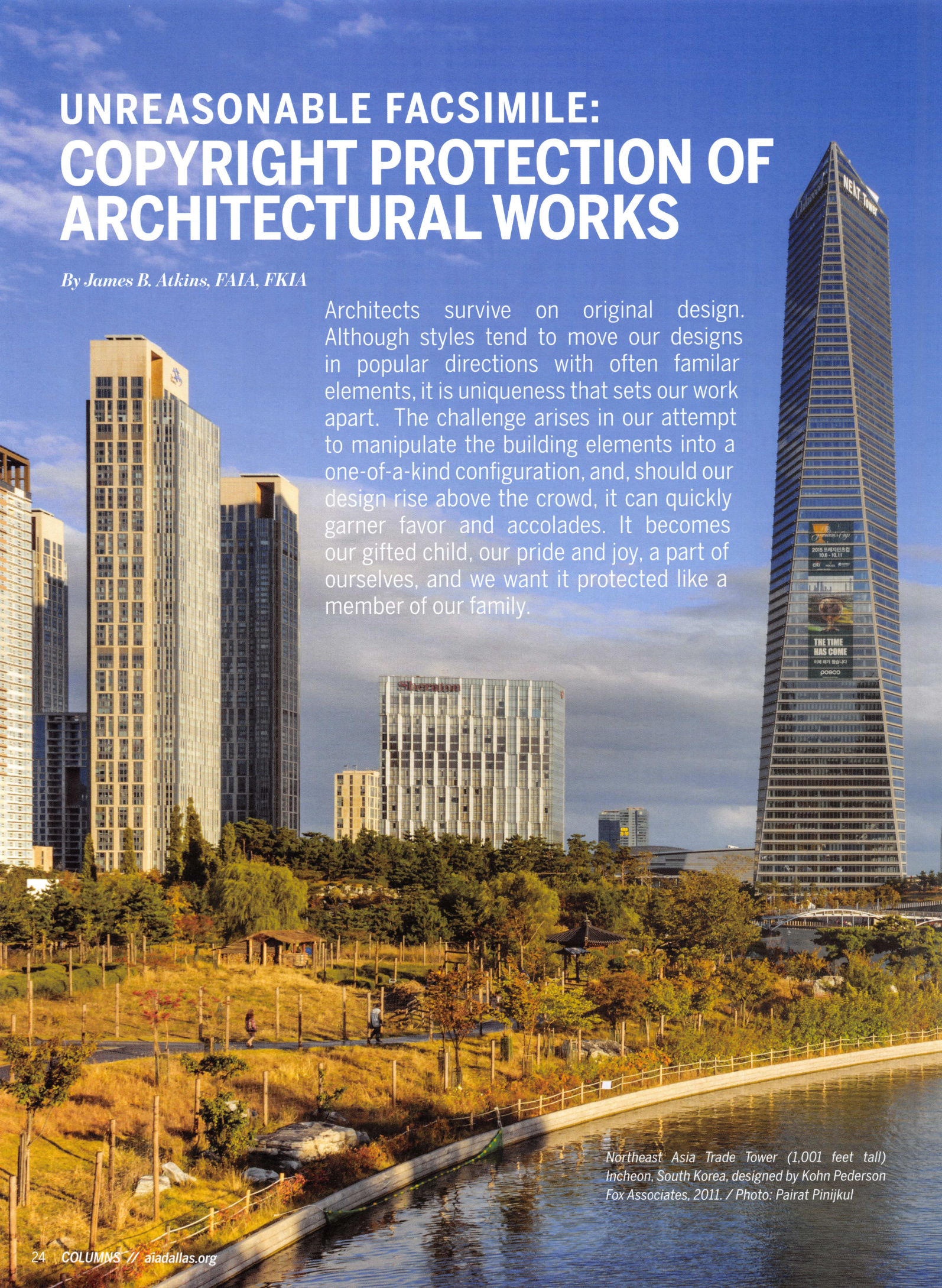
UNREASONABLE FACSIMILE: COPYRIGHT PROTECTION OF ARCHITECTURAL WORKS

By James B. Atkins, FAIA, FKIA

Architects survive on original design. Although styles tend to move our designs in popular directions with often familar elements, it is uniqueness that sets our work apart. The challenge arises in our attempt to manipulate the building elements into a one-of-a-kind configuration, and, should our design rise above the crowd, it can quickly garner favor and accolades. It becomes our gifted child, our pride and joy, a part of ourselves, and we want it protected like a member of our family.



Northeast Asia Trade Tower (1,001 feet tall) Incheon, South Korea, designed by Kohn Pederson Fox Associates, 2011. / Photo: Pairat Pinijkul

Then we discover a similar version of our creation has been introduced by another architect. Our idea has been stolen and presented as original. Thus was the belief of Thomas Shine, who in 1999 as a Yale architecture student designed an office tower with a "textured" curtainwall design, only to see it presented by SOM's David Childs for his Freedom Tower submittal at Ground Zero in 2003. Childs had served on Shine's final review jury. Shine registered the copyright on his design in 2004, and he filed a lawsuit in 2005, *Shine vs. Childs*.

The case survived a motion for dismissal since it potentially met the two required statutory elements: ownership of a valid copyright and copying of original elements of the work. The case was settled out of court, and Childs abandoned his proposed design. SOM went on to provide the design for Freedom Tower, only to have its originality challenged again in the lawsuit *Park vs. SOM*, filed in 2017 and currently pending before the courts. In 1999, Jeehoon Park created a design titled Cityfront 99 as a master's student at the Illinois Institute of Technology. One of his thesis advisers would later become an SOM associate partner. This disputed design is now Freedom Tower.

Most of us may not have been as imaginative as Shine or Park in architecture school, and we may not be involved with projects at the scale of Freedom Tower, but we value and guard our creations every bit as much. This article will address the legal protections afforded architectural design under the 1990 Architectural Works Copyright Protection Act (AWCPA) and the complex, often confounding standard for infringement known as "substantial similarity."

HISTORY OF COPYRIGHT PROTECTION IN THE U.S.

Architecture was not always protected by copyright law. The first copyright laws were passed in the late 1700s, and they covered only charts, maps and books. Certain writings were added in 1909, with coverage for drawings "of a scientific or technical character." Blueprints were considered covered, but "architect's plans and drawings" were not specifically included until 1976, and this did not include structures built from the drawings. After the United States joined the Berne Convention for Artistic and Literary Works in 1988, Congress passed the AWCPA, which specifically included, "architectural works."

Copyright protection is extended to the documents typically produced by architects, including models and computer-generated images. Buildings constructed from the architect's design are also included. However, the designs are not required to be constructible to be protected. Protection of an "architectural work" under the law requires the work to include the design of a building. Buildings are defined as *humanly habitable structures that are intended to be both permanent and stationary, such as houses and office buildings, and other permanent and stationary structures designed for human occupancy, including but not limited to churches, museums, gazebos, and garden pavilions*.

"Architectural works," under the copyright law, are only protected if they were created on or after Dec. 1, 1990. Protection is extended to "pictorial, graphic, or sculptural" works if they were created after 1976.

COPYRIGHT PROTECTION

The architect's design is protected immediately beginning at the time of its creation, and it does not have to be registered to have copyright protection. However, registration is beneficial for the following reasons: 1. Registration is required before an infringement lawsuit can be brought in court; 2. Registration within three months of publication or prior to the act of infringement will allow statutory damages and attorney's fees to be collected upon a finding of infringement. Otherwise, only actual damages and profits can be collected; and 3. If registration is made within five years of publication, it will provide prima facie evidence of copyright validity and of the stated facts in the certificate.

The Pyramid of Khafre, the tallest pyramid in the world at 448 feet, and the Sphinx in Giza, Egypt. / Photo: milehightraveler / iStock by Getty Images

A copyright notice is not required to be placed on the work, but it is beneficial for the following reasons: It places the user on notice of the copyright status, and it avoids the argument by the infringer of innocent infringement that could allow a reduced damage award. A proper copyright notice includes the symbol ©, the word Copyright, or the abbreviation Copr. and the year of first publication followed by the copyright owner's name.

Copyright essentially provides an architect with the exclusive right to reproduce, distribute, display and prepare a work based on the design. Unless the work is created as a work-made-for-hire, as is typically the case for architects employed by a firm, the protection lasts for the life of the author plus 70 years. In the case of a work-made-for-hire, the employer is considered the author although the work may have been solely created by an employee. An employer can be an organization, a firm or an individual.

There are limitations to copyright protection. If a building is visible from a public location, as most projects are, protection of an "architectural work" does not prevent the creation and public distribution of pictorial images of the building. The architect also cannot prevent an owner from altering or destroying the building, and, in the case of partially completed buildings, the owner can complete the building with the architect's copyrighted documents.

There are two categories of works not protected by the AWCPA but considered by some to be architecture-related. The first consists of structures whose form is dictated by engineering considerations, such as bridges, dams, canals, walkways, and

similar works. The second consists of organizations of space, such as gardens, parks, and golf courses. It is also important to add that the rights afforded by the AWCPA can be contractually extended for greater protection if the parties agree. An architectural work does not have to be constructed to be protected. Claims of infringement can be brought regardless of whether the plans were copied or the completed work was copied.

ORIGINAL VS. FUNCTIONAL DESIGNS

Protection of a building under the AWCPA requires that it must qualify as a building, and then it must pass a two-part test to establish that, first, the design is original, and, second, not wholly functional.

The lawmakers stated: *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.*

ORIGINAL DESIGN

The AWCPA provides protection of: *the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.* Standard features include common windows, doors, roof designs, and other staple building components. An architect likely can never produce a totally original design given the extensive past use of virtually all forms and configurations. However, the AWCPA acknowledges: *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 unprotectible elements into an original, protectible whole; (2) an architect may incorporate new, protectible design elements into otherwise standard, unprotectible building features; and (3) interior architecture may be protected.*

This means that windows, doors and standard roof configurations can be designed into an original form by placing them in a different context or by reconfiguring them with other building components. Since a majority of design elements in a building serve some function, this tends to prevent large portions of a building from being protected.

FUNCTIONAL DESIGN

Copyright law does not protect functionality. Therefore, it is necessary to determine when a design element is ornamental, and potentially copyrightable, and when it is functional to the operation of the design and therefore not copyrightable. The standard used by the court to decide this issue involves an analysis to determine whether the ornamental elements can be conceptualized as existing independently of the utilitarian functions. The test is referred to as the "separability" test. It requires a finding that the ornamental elements exist solely as a result of artistry and are independent of the building function. This can be difficult to determine since a great percentage of all buildings are functional. However, in some cases, the original elements are more obvious.

For example, the First International Building in Dallas, designed by HOK and completed in 1974, had a glass curtainwall devoid of ornament. It was renovated in 1986 by SOM, and broadcast towers were added to the top of the building. The transmission portion of the towers are functional, but the added framework and decor is artistic and nonessential to the broadcast operations.

It would seem that the original First International "glass box" would not be copyrightable. How long has a box been around? And the polychrome window wall treatment of Renaissance Tower may have similar difficulties. But the decorative framework incorporating the broadcast towers is unique. Herein lies the essence of the argument for what may or may not be copyrightable.

One World Trade Center ("Freedom Tower," 1,776 feet), New York City; designed by David Childs of SOM, 2014. / Photo: Lady-Photo / iStock by Getty Images

STUDY IN ORIGINALITY: GIZA PYRAMIDS VS. LUXOR HOTEL, LAS VEGAS

In 2007 Egypt's Supreme Council of Antiquities set out to pass a law that would exact royalty payments from anyone who made copies of the country's ancient monuments. The law would apply anywhere in the world, and since the United States had become a member of the Berne Convention for the Protection of Literary and Artistic Works, Egypt's new law could be an issue.

The pyramid-shaped Luxor hotel in Las Vegas stands 350 feet high with 4,400 keys. When the facility opened, it advertised that it had a King Tut Museum with reproductions of King Tut's sarcophagus as well as other antiquities.

When an Egyptian newspaper pointed out that there were more tourists visiting the Luxor hotel in Las Vegas each year than the number that visited Luxor, Egypt, Zahi Hawass, then head of Egypt's Supreme Council, was asked if MGM's Luxor would be subject to the royalties. Hawass replied that he did not regard the Luxor hotel as a copy of an Egyptian pyramid because the hotel's interior and an Egyptian pyramid's interior were in no way related. He did not regard the pyramid shape as unique, but what about the Sphinx?

Soon after his interview, the Luxor hotel underwent a massive renovation to achieve what it referred to as a "non-Egyptian" look. However, the exterior remained unchanged.

THE STATUTORY ELEMENTS OF A CLAIM FOR INFRINGEMENT

A copyright claim must satisfy two elements: proof of ownership of a valid copyright and proof of copying and reuse of portions of the work that are original. Authorship of the work can easily establish copyright ownership, but determining that the work was copied can prove more difficult. Courts attempt to determine if the defendant had access to the copyrighted work and if the infringing work was "substantially similar" to the original. Both of these conditions are required to establish infringement.

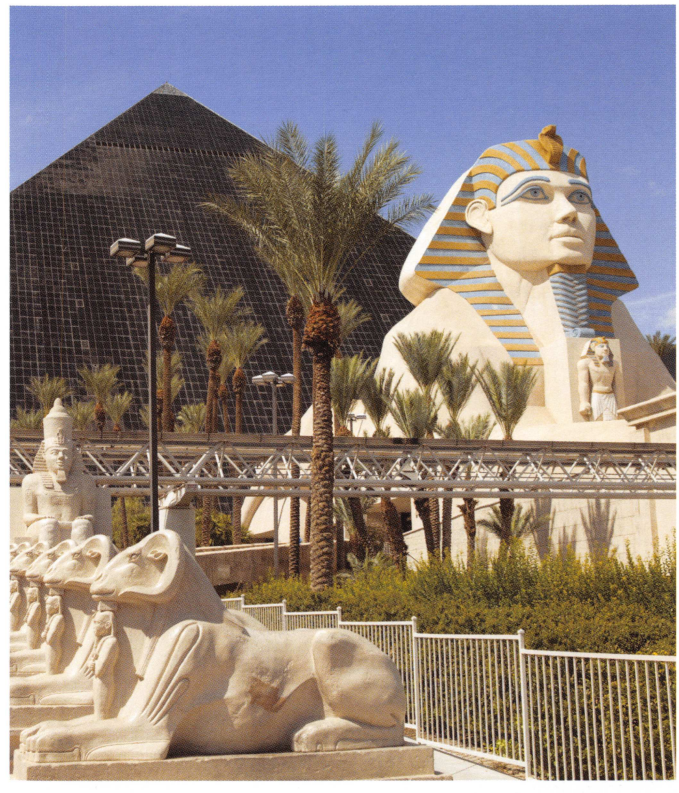
Thus, the standard for infringement is substantial similarity, which is perhaps the most troublesome issue in copyright litigation. The challenge arises because in copyrightable works, some measure of similarity must be allowed. The practice of architecture would be much more daunting if some amount of copying was not permitted. Is this not how architectural styles are developed and perpetuated? The task then becomes determining whether the comparative similarity is minor and thus permissible or if it is substantial and worthy of action.

The practice of architecture involves the reuse of existing forms and materials, and the copying of existing elements and patterns and even spatial configurations is accepted and commonplace. Thus the task of determining substantial similarity becomes more difficult unless the entire design and all its detailed minutiae were replicated.

INSPIRATION VS. IMITATION

Copyright protection for architects is relatively new. Barely three decades have passed since the United States joined the Berne Convention and legislated protection for architectural works. However, copyright protection has its limitations. Building elements are mostly functional and thus not subject to copyright.

The greatest challenge in preserving our rights in building design lies with the issue of substantial similarity. At what point in design development does inspiration cross the line and become imitation? This challenge is made more evident by the fact that Park's Cityfront 99 design and Childs' Freedom Tower design do not stand alone.



Third tallest pyramid in the World. Luxor Hotel & Casino (350 ft) and the "Great" Sphinx (stucco), Las Vegas, Nevada, USA, c. 1993 AD

The Northeast Asia Trade Tower in Songdo International City, located near Inchon, South Korea, was completed in 2011 with Kohn Pederson Fox as the design architect. It too is strikingly reminiscent of Park's 1999 tower design, and it predates SOM's Freedom Tower. Therefore, one must ask, who is the infringer? Did infringement actually occur? Or was this just another iteration of a functional and common high-rise configuration? How many others like this exist?

With substantial similarity to a copyright work as a measure for infringement, these three buildings demonstrate the challenging task of separating inspiration from illegal imitation. But one must also ask: Once Jeehoon Park created his design, was it reasonable to prohibit any building built afterward from being similar in appearance? If this were so, our built environment as we know it would have stagnated long ago.

So as you file your latest design safely away and click on www.copyright.gov to register its copyright, please remember to be careful out there.

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Learn how to register copyright and explore more resources online at www.aiadallas.org/copyrightindesign.