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Trademarks or Copyrights: Which Intellectual Property Right Affords Its Owner the Greatest Protection of Architectural Ingenuity?

Rashida Y.V. MacMurray*

I. INTRODUCTION

¶1 Imagine you are a design professional who has been commissioned to design “the” signature architectural masterpiece that will define your career and legacy. You have an unlimited budget and have the most renowned engineering consultants at your disposal. You have prepared flawless architectural plans and technical specifications. The construction of the building was completed under budget and ahead of schedule. You deposited your architectural plans with the U.S. Copyright Office and obtained a certificate of copyright. Simultaneously through trademark counsel, you filed an application for trademark registration of the building structure. Subsequently, to your surprise, you discover that not only has a copycat building been erected across the street, but your architectural drawings have been copied without your permission and your signature title block has been removed and replaced with the name of a third party unaffiliated with the project.¹

¶2 What do you do? What are your remedies? Could you enjoin the construction of the “copycat” structure? Most importantly, how would you decide whether to enforce your copyright or trademark rights against the alleged infringer? The scenario above describes an extreme fact pattern and illustrates the dynamic intersection of architectural ingenuity and intellectual property law. Many architects and other design professionals remain unaware that their building designs, engineering drawings, specifications, and construction drawings can be protected subject to the intellectual property policy principles under the trademark and copyright laws of the United States.

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¹ This situation is hypothetical but the facts are similar to the facts written in the following article about Truett Miely. Betsy Schiffman, *Copycats Architectural Copycats*, FORBES.COM, at http://www.forbes.com/2003/10/03/cx_bs_1003home.html (last visited April 11, 2005) (Mr. Miley, a construction contractor, spent three years and nearly one million dollars to build his dream house in Baton Rouge, Louisiana. He designed most of the structure himself. When the walls of a new home were constructed approximately two hundred feet away from his own house, he was disappointed to discover that the neighboring property looked very familiar.).

¶3 In most major cities, there is usually at least one famous building that not only identifies the geographic area, but also characterizes the respective city's skyline. For example, in New York City, such buildings include the Empire State Building, the Solomon R. Guggenheim Museum, and 5 Times Square.² In Chicago, the list includes the Sears Tower and the Wrigley Building.³ These buildings are recognized not only for their aesthetic appeal but also as landmarks. Does the diligent architect seek copyright or trademark protection? Is it possible to use both simultaneously?

¶4 This article offers a commentary on the current state of intellectual property protection, specifically with regard to copyright and trademark law, of architectural designs and building structures. Part II provides an overview and background of general copyright principles as well as copyright legislation designed to protect architectural works. Part III provides an overview and background of general trademark and trade dress protection as well as a discussion of trademark policy under the Lanham Act. Part IV of this note examines various circuit court opinions addressing infringement of architectural plans and building designs under both copyright and trademark laws. Finally, this note concludes with a recommendation of which intellectual property right affords its owner the greatest protection for architectural ingenuity.

II. A BRIEF OVERVIEW OF COPYRIGHT LAW

¶5 A copyright is not a trademark and a trademark is not a copyright. Although both trademarks and copyrights concern intangible property rights and overlap in some aspects, there are also significant differences between copyrights and trademarks.⁴

¶6 Copyright law has its roots in the U.S. Constitution.⁵ Copyrightable works include: literary, musical, and dramatic works; pictorial, graphic, and sculptural works (including the non-utilitarian design features of useful articles); as well as compilations of works and derivative works.⁶ In essence, a copyright affords the owner of an original work of authorship fixed in a tangible medium the right to control the display, publication, reproduction and creation of derivative works.⁷ In addition, the protectible work must be an "original" and not copied from another source.⁸ Copyrights only protect particular expressions of ideas and not the ideas themselves.⁹

¶7 In the early 1900s, Congress began to develop the parameters of federal copyright law while simultaneously seeking to develop a balance between the individual owner and the general public.¹⁰ The Copyright Act of 1909 (the "1909 Act") was a comprehensive

² See U.S. Trademark No. 2,753,356 (issued Aug. 19, 2003); U.S. Trademark No. 1,962,821 (issued Mar. 19, 1996); U.S. Trademark No. 2,411,972 (issued Dec. 12, 2000).

³ See U.S. Trademark No. 1,622,845 (issued Nov. 13, 1990); U.S. Trademark No. 1,746,564 (issued Jan. 12, 1993); U.S. Trademark No. 2,037,110 (issued Feb. 11, 1997).

⁴ For purposes of clarity, Part II will be devoted to the historical development and the present condition of U.S. copyright law. Part III will address only trademark law using a similar format.

⁵ U.S. CONST. art. I, § 8, cl. 8 (Patent and Copyright Clause) ("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.").

⁶ 17 U.S.C. § 101 (2000).

⁷ *Id.* at § 106.

⁸ *Id.* at § 103.

⁹ *Id.* at § 102.

¹⁰ See generally 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.05[D] (2005)

codification of federal copyright law. For example, the 1909 Act provided a list of definitions of works that could be protected by copyright law, including: “drawings or plastic works of a scientific or technical nature.”¹¹

¶18 Congress enacted the Copyright Act of 1976 (the “1976 Act”) to keep pace with advancing technological and multimedia changes as well as to address deficiencies of copyright law under the 1909 Act.¹² In the 1976 Act, architectural drawings and specifications were included for the first time under the definition of valid copyrightable subject matter.¹³ The 1976 Act, did not, however, include protection of three dimensional structures derived from technical drawings.¹⁴ Specifically, the 1976 Act did not prohibit a person from taking the measurements of a building and preparing sketches to replicate the building without obtaining consent from the original architect or design professional.

A. *The Birth of the Copyright*

¶19 A copyright is automatically created when the copyrightable work is memorialized in a tangible form, such as writing or sound recording, regardless of whether the work has been published or registered with the U.S. Copyright Office.¹⁵ Furthermore, a copyright notice is not required for an unpublished work.¹⁶ The copyright owner is not precluded from affixing a copyright notice on publicly distributed copies of the work.¹⁷

¶10 To register the work, the author must deposit in the Copyright Office two complete copies of the work, an executed copyright application, and an application fee.¹⁸ A copyright registration is a prerequisite to suing an infringer.¹⁹ More importantly, the copyright owner can not recover statutory damages or attorney’s fees for copyright infringement unless the work is registered.²⁰ A certificate of copyright is prima facie

[hereinafter NIMMER].

¹¹ For an historical overview of the 1909 Copyright Act, *see generally* Emily Ayers, Comment, *Case Closed: Federal Courts Resolve the Question of an Exclusive Licensee’s Ability to Sublicense a Copyright*, 24 LOY. LA. ENT. L. REV. 185, 188 (2004).

¹² 17 U.S.C. § 101-1332 (Fixation in a tangible medium is a prerequisite to federal protection. If the creation and fixation of the work occurred after January 1, 1978, the 1976 Act applies.).

¹³ *Id.* at § 101 (Architectural drawings are protectible as “pictorial, graphic, and sculptural works. Specifications are protectible as “literary works.” The building structures built from these drawings are not copyrightable subject matter under the 1976 Act.).

¹⁴ *Id.* at § 101-1332.

¹⁵ *Id.* at § 201(a).

¹⁶ *Id.* at § 405(a).

¹⁷ *Id.* at § 401(a) (A valid copyright notices includes: 1) the symbol ©, or the word “copyright” or the abbreviation “corp.”; 2) the year of the first publication; and 3) the name of the owner of the copyright. After March 1, 1989, the use of a copyright notice is not longer mandatory. The absence of a copyright notice may exonerate an alleged “innocent” infringer liable for actual or statutory damages. After March 1, 1989, as a result of the United States adhering to the Berne Convention, the requirement of a copyright notice on a published work was eliminated. Although there are numerous benefits to using a copyright notice, it is no longer essential for copyright protection. The Berne Convention recognizes copyright protection across international boundaries. The Berne Convention was signed in 1886 but was not adopted by the United States until 1989.) *Id.*

¹⁸ *Id.* at § 408. *See also* www.loc.gov (for instructions in registering a copyright) (last visited March 31, 2005).

¹⁹ *Id.* at § 412.

²⁰ *Id.*

evidence of validity.²¹ A person who uses the work without consent infringes the copyright owner's exclusive rights to control the work.²² Therefore, an alleged infringer bears the burden of proving that the work is not valid.²³

¶11 The lifespan of a copyright varies by the date when the work was first published. For works created on or after January 1, 1978, the term lasts the author's lifetime plus seventy years after the author's death.²⁴ If the copyright is a "work for hire,"²⁵ the term is ninety-five years from publication or 120 years from creation, whichever period is shorter.²⁶

¶12 The individual or joint authors of a work initially own the copyright.²⁷ Each author is granted a "bundle of exclusive rights."²⁸ A copyright is divisible, so the recipient of any exclusive grant or license becomes the owner of the copyright of those rights.²⁹ Any transfer of these exclusive rights must be in writing.³⁰

¶13 Prior to enactment of specific legislation directed to protecting architectural works, building structures were immune from copyright protection and thus could be duplicated as long as the original technical drawings were not reproduced.³¹ In fact, courts were reluctant to afford copyright protection to architects for building structures in the absence of a specific mandate by Congress.³²

B. Copyright Protection of Architectural Works

¶14 On December 1, 1990, President George H. W. Bush signed into law the Architectural Works Copyright Protection Act ("AWCPA").³³ The AWCPA resolved an important dispute in U.S. intellectual property law, extending copyright protection to architectural designs embodied in three dimensional building structures.³⁴

¶15 The AWCPA expanded the definition of copyrightable subject matter to include architectural works.³⁵ 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

²¹ *Id.* at § 410(c).

²² *Id.* at § 501(a).

²³ See *CSM Investors, Inc. v. Everest Dev., Ltd.*, 840 F. Supp. 1304, 1309 (D. Minn. 1994).

²⁴ 17 U.S.C. § 302(a).

²⁵ *Id.* at §101 (If an employer or third-party commissions a work, the copyright is automatically considered the "author" for purposes of copyright law. A work for hire is created if either 1) the work was prepared by an employee within the scope of employment or 2) the work was commissioned expressly agreed in a written document signed by both parties.).

²⁶ *Id.* at § 302(c).

²⁷ *Id.* at § 201(a).

²⁸ *Id.* at § 106 (The bundle of exclusive rights includes: the right to copy; the right to make derivative works, and the right to sell, distribute, and display the works.).

²⁹ 17 U.S.C. § 201(d).

³⁰ *Id.* at § 204.

³¹ *DeSilva Constr. Corp. v. Herral*d, 213 F. Supp. 184, 196 (M.D. Fla. 1962).

³² *Id.*

³³ The Architectural Works Copyright Protection Act of 1990, Pub. L. No. 101-650, 701-706, 104 Stat. 5133 (1990) (codified at scattered sections of 17 U.S.C.) [hereinafter AWCPA].

³⁴ See generally 17 U.S.C. § 102.

³⁵ *Id.*

standard features.”³⁶ Under the AWCPA, “buildings” are “structures that are habitable and intended to be both permanent and stationary, such as residential houses and office buildings, and other permanent and stationary structures which are used but not inhabited by human beings, such as churches, gazebos, museums, and garden pavilions.”³⁷ Consequently, the AWCPA distinguishes between “the design of buildings” and “building structures” as physical objects consistent with the fundamental principles of copyright law.³⁸

¶16 The AWCPA further acknowledges an appreciation of ideas and the expression of those ideas.³⁹ Architectural works are inherently a compilation of ideas and expressions which contradicts the purpose of copyright law’s exclusion of “any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”⁴⁰

¶17 A copyright automatically springs to life when the architectural drawings and specifications are created.⁴¹ An alleged infringer is prohibited from not only copying the architectural plans but also re-creating the building design even if the original architectural plans are not used.⁴² Standard design details, “such as windows, doors, and other staple building components, as well as functional elements whose design or placement is dictated by utilitarian concerns” do not qualify for copyright protection because there is no independent originality.⁴³

¶18 The Patent and Copyright Clause’s articulated objective of “promoting the progress of science and the useful arts” may appear to be inconsistent with copyright laws directed to architectural works which essentially allow an architect to control the copying of a building structure existing in the public domain.⁴⁴ Furthermore, controlling the copying or unauthorized distribution of architectural plans or other technical drawings presents a unique issue between the architect and the client who commissioned the work because there is an inherent conflict regarding ownership of the work. A client who has paid for design services feels entitled to distribute or use the drawings, but if the client has not received permission or license from the architect, the client will be unable to proceed using those particular copyrighted works.⁴⁵

¶19 Under the AWCPA, a design professional has a remedy for the construction of a copycat building and also for other unauthorized uses of the protected design.⁴⁶ Although

³⁶ *Id.* at 17 U.S.C. §102(a)(8).

³⁷ 37 C.F.R. §202.11 (b)(2) (2000).

³⁸ *See generally* AWCPA, *supra* note 33.

³⁹ *See generally id.*

⁴⁰ 17 U.S.C. § 102(b).

⁴¹ *See generally id.* at § 102.

⁴² *Id.* at § 501(a). Additionally, the owners of a building, embodying an architectural work, however, may without the consent of the author of the copyright owner of the architectural work make or authorize alterations or destruction of the building. *Id.* at § 120(b).

⁴³ United States Copyright Office, *Copyright Claims in Architectural Works* (August 2003), available at <http://www.copyright.gov/circs/circ41.html> (last visited April 7, 2005).

⁴⁴ U.S. CONST. Art. 1, § 8, cl. 8.

⁴⁵ For further discussion, *see generally* Thomas M. Brownell, *Architectural Plans Can Be Protected by Copyright*, available at <http://www.viennapat.com/newsletter/vol2iss7/architect.htm> (last visited Apr. 7, 2005).

⁴⁶ For example, in agreeing to provide architectural services, including the preparation of construction drawings for a client, a design professional can contract to transfer to the client the right to construct the building (i.e. the derivative work). *See* 17 U.S.C. § 201(d).

it may not have been originally intended, the AWCPA was perfectly timed to address the unauthorized use of the architectural designs in light of the technological advances of digital media. Additionally, with regard to electronic copies, the AWCPA provides the design professional a remedy in situations where a digital image of the building has been taken and drawings are prepared using the digital image.⁴⁷

¶20 The act of copying architectural drawings or the building design can occur with unprecedented speed and accuracy.⁴⁸ The American Institute of Architects (“AIA”) warns design professionals of the urgency in diligently protecting the ownership, use, and transfer of design drawings.⁴⁹ A client or other third party who attempts to construct a building using unauthorized architectural plans and construction drawings engages in infringement for which the design professional may obtain an injunction.⁵⁰ This remedy did not exist under the 1976 Act because architectural works were not considered copyrightable subject matter.

¶21 Without the protections of the AWCPA, an architect would not have any remedies if his or her building design was created using a digital photo. Although, the AWCPA specifically carves out an exception to copyright infringement by the mere photographing of the work, it does not grant an individual unlimited ability to use the image to create a copycat building without the copyright owner’s (i.e. the architect or the owner) permission. The 1976 Act recognized three-dimensional sculptures, but not three dimensional building structures, as copyrightable subject matter. Was the distinction that the 1976 Act valued artistic works as being more valuable than architectural works? Would it not be as offensive to allow a competitor to duplicate an architectural work simply because it also has a functional purpose? Regardless of the reason, the 1976 Copyright Act *only* afforded an architect or design professional the right to protect against the direct copying of the architectural plans.⁵¹ Common sense would dictate that by the time the architect discovered that his or her plans had been copied, the copycat building structure would have already been erected. Architects and other design professionals invest significant time, energy, and financing in preparing design drawings and “it would be a grave injustice to permit a competitor to profit from another competitor’s hard work and injure that competitor simultaneously.”⁵²

¶22 The inclusion of “architectural works” under the AWCPA addresses the inadequacies and unintended consequences of the application of traditional copyright law principles to architectural plans.⁵³ Although, there was some debate for several decades regarding whether an architect should be entitled to copyright protection of the building

⁴⁷ For example, with the advancement of digital media, a third party can take a digital picture and reproduce architectural drawings using images of different perspectives of the building structure. Without the benefits of copyright law, an architect would be vulnerable to unauthorized distribution or alterations to his or her architectural drawings or building structures.

⁴⁸ See David A. Roberts, *There Goes My Baby: Buildings as Intellectual Property Under the Architectural Works Copyright Protection Act*, CONSTRUCTION LAWYER, at 23 (Spring 2001). Mr. Roberts identifies examples of some of the recent changes in intellectual property law and the impact on construction practice.

⁴⁹ http://www.aia.org/print_template.cfm?pagename=pm_a_transferdocs (last visited Apr. 7, 2005).

⁵⁰ 17 U.S.C. § 502.

⁵¹ See generally ACWPA, *supra* note 33.

⁵² See *Value Group, Inc. v. Mendam Lake Estates, L.P.*, 800 F. Supp. 1228, 1234 (D.N.J. 1992).

⁵³ See AWCPA, *supra* note 33.

itself, this problem was not remedied until the AWCPA was enacted.⁵⁴ The exclusion of “architectural works” under the 1976 Act was definitely a fatal flaw and inconsistent with international law.⁵⁵

¶23 Prior to the passage of the AWCPA, courts refused to enjoin the construction of a building made from infringing copyrighted plans.⁵⁶ Courts were unwilling to extend copyright law to grant architects copyright protection for the building designs constructed from these drawings.⁵⁷ In fact, there was some debate regarding whether the Copyright Act would ever be amended to address the exclusion of the building structure erected from the infringing plans.⁵⁸

¶24 However, with the enactment of the AWCPA, an injunction prohibiting the continued construction of a building derived from infringing architectural plans became a viable remedy.⁵⁹ Now, architects have an immediate remedy for infringement of the building structures erected from their architectural and construction drawings.⁶⁰ A preliminary or permanent injunction is a powerful remedy because it requires the alleged offender to cease all infringing activity immediately.⁶¹ In determining whether an injunction is an appropriate remedy, courts are required to examine the merits of the plaintiff’s claim, especially in light of the fact that a preliminary injunction is an extraordinary remedy.⁶²

¶25 Shortly after the AWCPA became law, this principle of enjoining construction of a copyrighted architectural work was tested in *Value Group, Inc. v. Mendham Lake Estates*.⁶³ In this case, the district court granted the plaintiffs, a real estate development company and its architect, a preliminary injunction against the defendant, the plaintiff’s sole competitor in the geographic area, from using and constructing a housing design created by the plaintiff-architect⁶⁴ after the defendant filed for a building permit using

⁵⁴ See *DeSilva*, 213 F. Supp. at 195-196

⁵⁵ See AWCPA, *supra* note 33.

⁵⁶ See generally *DeSilva*, 213 F. Supp. at 184. Plaintiff, a construction company, filed a copyright infringement suit his architectural plan. *Id.* at 187. In this case, the issue was whether architectural plans filed in a public office, as required by local ordinance, is tantamount to publication of said drawings thereby terminating the author’s common law copyright in said plans. *Id.* at 194. The defendant argued that the plaintiff’s copyright interest was terminated when the plans were submitted as part of the building permit application. *Id.* The court disagreed but was unwilling to allow the plaintiff’s claim in light of an established legal principle that the building of a structure from a copyrighted architectural plan is not infringement of the architectural plans. *Id.* at 196.

⁵⁷ *Id.* at 198.

⁵⁸ *Id.* at 196.

⁵⁹ 17 U.S.C. § 502.

⁶⁰ *Id.*

⁶¹ *Id.*

⁶² *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 532-33 (6th Cir. 2004) (“Four factors govern whether a district court should enter a preliminary injunction: (1) the plaintiff’s likelihood of success on the merits; (2) the possibility of irreparable harm to the plaintiff in the absence of an injunction; (3) public interest considerations; and (4) potential harm to third parties.”). *Id.* at 532; see also *In re Microsoft Antitrust Litigation*, 333 F.3d 517, 526 (4th Cir. 2003); *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1265 (11th Cir. 2001); *Fisher-Price, Inc. v. Well-Made Toy Mfg. Corp.*, 25 F.3d 119, 122 (2d Cir. 1994); *Nitro Leisure Products, LLC v. Acushnet Co.*, 341 F.3d 1356, 1359 (Fed. Cir. 2003) (To succeed on the merits of a trademark infringement claim, a plaintiff must show that the defendant used the mark in commerce without its consent and “that the unauthorized use was likely to deceive, cause confusion, or result in mistake.”). *Id.* at 1359; 17 U.S.C. §§ 120 and 502(a).

⁶³ 800 F. Supp. at 1228.

⁶⁴ *Id.* at 1230-31.

architectural plans that were identical to the plaintiff's.⁶⁵ In determining whether to grant equitable relief, the court engaged in a four-part balancing test and concluded that all of the factors weighed in favor of the plaintiff.⁶⁶ The court concluded that the architectural plans were "substantially similar" and that the plaintiff demonstrated a high probability of success with respect to its copyright claim.⁶⁷ The passage of the AWCPA and the result in *Value Group* signified a new era in intellectual property protection of architectural works.

¶26 To prevail on a copyright infringement claim of an architectural work, a copyright owner must prove: (1) ownership of a valid copyright and (2) copying or infringement of protected portions of its copyrighted work.⁶⁸ Additionally, to receive copyright protection of architectural plans and specifications, the plaintiff must also comply with the requirements of "originality," despite the fact that the fundamental elements of architectural designs exist in the public domain.⁶⁹ As stated above, an "architectural work" is a design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings.⁷⁰ Furthermore, 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."⁷¹

¶27 In determining whether copyright infringement has occurred, the district court will engage in a two-part test.⁷² First, the court must evaluate the validity of the copyright at issue.⁷³ A certificate of copyright registration is prima facie evidence of the validity of a copyright.⁷⁴ But, even if a valid copyright certificate exists, architectural works must also exhibit some creativity before they are eligible for protection.⁷⁵ However, the threshold of originality is not a high standard.⁷⁶

¶28 The second part of the copyright infringement analysis is evaluated under a "substantial similarity" analysis comparing the two works at issue and establishing that the alleged infringer had access to the plaintiff's work.⁷⁷ Copyright infringement can be

⁶⁵ *Id.* at 1230.

⁶⁶ *Id.* at 1231 (citations omitted) (stating that "The standard for preliminary injunction requires a court to balance the following four factors: 1) the likelihood of success on the merits after a full hearing; (2) whether the movant will be irreparably injured without the restraint; (3) whether the party to be enjoined will be irreparably injured if the preliminary relief is granted; and (4) whether the public interest will be served by the preliminary relief.").

⁶⁷ *Id.* at 1234.

⁶⁸ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348, 361 (1991).

⁶⁹ The "originality" requirements are independent creation and minimal degree of creativity. NIMMER, *supra* note 10, at § 2.01.

⁷⁰ *See CSM Investors, Inc.*, 840 F. Supp. at 1309 (citations omitted).

⁷¹ A real estate developer and architectural firm filed a motion for summary judgment alleging copyright infringement of the architectural plans and building design. The district court granted the plaintiff's motion and held that the plaintiff's and defendant's plans were substantially similar and that the defendant infringed the copyrighted work. *Id.*

⁷² *Id.*

⁷³ *Id.*

⁷⁴ *Id.*

⁷⁵ *See Gemel Precision Tool, Co. Inc. v. Pharma Tool Corp.*, 1995 WL 71243 (E.D. Pa. 1995). The "level of originality and creativity that must be shown is minimal, only an unmistakable dash of originality need be demonstrated, high standards of uniqueness in creativity are dispensed with." *Folio Impressions Inc. v. Byer California*, 937 F.2d 759,764-65 (2d Cir. 1991) (internal quotations and citations omitted).

⁷⁶ *See Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 358-59 (1991).

⁷⁷ *See generally* 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.01; *see also*

established using direct or circumstantial evidence.⁷⁸ Evidence of direct copying is often not available, therefore, in most cases infringement must be established using circumstantial evidence by showing that: 1) the accused infringer had access to the plaintiff's plans and specifications; and 2) the two works are substantially similar in idea and expression.⁷⁹ A substantially similar analysis involves focusing on the extrinsic similarity of ideas, specifically the objective similarity of the details in the works.⁸⁰ Consequently, if there exists a similarity of ideas, then a "similarity of expression is evaluated using an intrinsic test depending on the response of the ordinary, reasonable person to the forms of expression."⁸¹ The presence of substantial similarities, and not the differences between the works, determines whether infringement has occurred. Circumstantial evidence is usually introduced to show that the defendant had "access" and the defendant's use of the plaintiff's work was unauthorized.⁸² A unique feature of the infringement analysis with respect to architectural works is that there are inherent features included in all buildings that must be copied for practical purposes. In some ways, this is both an advantage and disadvantage, because the architect has to be able to articulate which design features are ornamental and original as well as protectible without minimizing the overall look and feel of the building structure.

Nevertheless, an architect may not be convinced that a federally registered copyright of his or her architectural plan would be a prudent investment. There are at least two reasons why architects should seek copyright protection for their work: 1) to resolve ownership conflicts and 2) to preclude takings by clients who have not paid for the finished product.⁸³ The AWCPA, however, did not resolve all issues involving the scope of protection afforded to "architectural works." Since its enactment in 1990, the scope of AWCPA has been tested with respect to whether the act applies to architectural works that were substantially constructed as of the December 1, 1990,⁸⁴ whether a sculpted work attached to a building exterior was copyrightable subject matter,⁸⁵ whether

CSM Investors, 840 F. Supp. at 1309.

⁷⁸ *CSM Investors*, 840 F. Supp. at 1311.

⁷⁹ *Id.*

⁸⁰ *Rottlund Co., Inc. v. Pinnacle Corp.*, No. Civ.01-1980 DSD/SRN, 2004 WL 1879983, at 25 (D. Minn. 2004).

⁸¹ *Id.*

⁸² *Id.*

⁸³ See Thomas M. Brownell, *supra* note 45; see also Mary Cullen Yeager & Katherine Golden, *Owner v. Architect: Who Owns the Design?*, at http://www.faegre.com/articles/article_print.aspx?id=508 (last visited Apr. 7, 2005); Werner Sabo and James K. Zahn, *Copyright Act - Effect on Construction Practice*, at <http://www.sabozahn.com/articles.htm> (last visited Apr. 7, 2005).

⁸⁴ See *Richard J. Zitz, Inc. v. Dos Santos Pereira*, 232 F.3d 290 (2d Cir. 2000). Plaintiff, a residential building contractor, with one employee, Richard Zitz sued builders of an allegedly infringing structure. Mr. Zitz prepared a floor plan and drawings for the windows, ceiling, and roof of the structure. Mr. Zitz obtained a building permit and commenced construction in 1990. Subsequently, Mr. Zitz filed four copyright applications for the architectural drawings he prepared and two of the architectural works constructed as well as the unconstructed architectural works. The district court concluded that plaintiff's copyright applications were invalid. Specifically, the court stated that plaintiff's works were excluded from copyright protection under the AWCPA because the works were constructed prior to enactment date of the legislation. *Id.* at 292 (citations omitted).

⁸⁵ See *Leicester v. Warner Bros. Corp.*, 232 F.3d 1212 (9th Cir. 2000). Plaintiff, an artist who designed a streetwall and courtyard space registered as a "sculptural work" as a copyright, filed a copyright infringement action against a movie studio alleging depiction of a portion of design in movie entitled "Batman Forever." *Id.* at 1212-14. The court acknowledged that the "streetwall" included artistic elements but declined to characterize the "streetwall" as a sculpted work for purposes of the AWCPA. A portion of

engineering drawings are protected under the AWCPA,⁸⁶ and whether the AWCPA applies in various ownership issues of architectural drawings.⁸⁷

¶130

Most recently, in *William Hablinski Architecture v. Amir Construction*,⁸⁸ one of the dispositive issues related to the scope of the “substantially similar” analysis used to evaluate the validity of copyrighted design. Recognizing the uniqueness of the architectural profession in duplicating design elements for not only aesthetic reasons but also for purely functional ones as well, it is important that courts be able to distinguish between insubstantial modifications and protectible design elements for purposes of analyzing whether copyright infringement has occurred.⁸⁹ Further, it is undisputed that the architect retains ownership and control of his or her designs until such time as an appropriate transfer to a third-party takes place by license or express grant.⁹⁰ Therefore, the issue of “substantially similar” should be evaluated with the principles described above in mind.

the structure included functional lights and other symbolic and aesthetic elements, extracted from the building façade. The court concluded that the streetwall and associated towers were not separate elements that qualified as copyrightable subject matter. Consequently, the movie studio’s pictorial representation was not infringement because pictorial representations of buildings are expressly excluded by AWCPA. *Id.* at 1213.

⁸⁶ See *Guillot-Vogt Associates, Inc. v. Holly & Smith*, 848 F. Supp. 682 (E.D. La. 1994). Plaintiff, a subcontractor, prepared engineering design drawings for the mechanical and electrical portions of a state project. During the course of the Project, the architect became sick and was unable to continue the Project. In response the State hired the defendant to replace the plaintiff. Subsequently, the defendant contacted the plaintiff to complete the drawings but the plaintiff declined due to the fact that he had not paid for the previous work. Consequently, the State instructed the defendant to remove the logo and stamps bearing the plaintiff’s name and replace it with the defendant’s name and title block. During the interim, the plaintiff filed for a copyright registration. The State argued that “engineering drawings” fell outside of the scope of copyrightable subject matter. The court disagreed holding that copyright protection for engineering drawings fell within the scope of the AWCPA and that engineering drawings had enjoyed a long-standing relationship of copyright protection. In fact, the court interpreted the AWCPA to provide a previously lacking copyright protection to physical architectural works. *Id.* at 686. The court further included a list of citations supporting the proposition that architectural, engineering and technical drawings are all valid copyrightable subject matter. *Id.* at 687.

⁸⁷ See *Curtis v. Benson, Jr.*, 959 F. Supp. 348 (E.D. La. 1997). Plaintiff, an architect, filed a copyright infringement and unfair competition action under § 43(a) of the Lanham Act against other architects and owners of the New Orleans Saints football stadium—the Superdome. *Id.* The defendants unsuccessfully argued that the plaintiff had lost his copyright rights when the technical drawings he prepared in 1967 were published without a copyright notice and transferred to Tulane University. *Id.* at 350. The plaintiff countered that no publication occurred with his permission and the court agreed but declined to grant summary judgment on the issue. *Id.* at 353. The court concluded that summary judgment was inappropriate because the issue of whether the defendants were liable for contributing or aiding in the copying and false designation of the plaintiff’s plans was an issue for trier of fact. *Id.* at 352.

⁸⁸ See No. CV03-6365 CAS (PJWx) (C.D. Cal. filed Sept. 4, 2003).

⁸⁹ See Adam T. Mow, *Building With Style: Testing the Boundaries of the Architectural Works Copyright Protection Act*, UTAH L. REV. 853, 862 (2004). The author presents a very interesting argument regarding the copyright infringement of an aesthetic design. The author proposes that “architecture is a profession that has largely accepted an architect’s general borrowing or imitation of another’s ideas.” *Id.* at 868. Consequently, this borrowing principle exists because “architecture is evolving and fluid field, where architects never stop learning from, observing, and innovating upon the works of their mentors. *Id.* at 870. Finally, the author proposes that “exposure to contemporary works of others is bound to leave an impression.” *Id.* The author distinguishes between stylistic elements such as structural and aesthetic elements and historical styles such as elements or materials used in Greek temples. *Id.* at 874. The author concludes that stylistic elements and historical systems should be excluded when courts engage in substantially similar analysis under the AWCPA. *Id.* at 876.

⁹⁰ See generally 17 U.S.C. § 106.

III. A BRIEF OVERVIEW OF TRADEMARK LAW

¶31 A trademark affords its owner the right to use a specific mark to identify the source of the goods.⁹¹ Trademark law, unlike copyright law, is not derived from the Patent and Copyright Clause but rather has its roots in the Commerce Clause of the U.S. Constitution.⁹² A trademark is defined as “any word, name, symbol, or device or any combination thereof” used by a person “to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”⁹³

¶32 A party does not need to register the mark prior to use in commerce.⁹⁴ Additionally, the mark does not automatically become a trademark upon creation; instead the user must use the mark on or in connection with goods, or by displaying the mark in the sale or advertising of services.⁹⁵ The mark owner, however, automatically acquires trademark rights in the geographic area of use or the mark owner can federally register the mark to preclude an alleged infringer from using the mark nationwide.⁹⁶

¶33 To obtain a trademark, the owner must file an application establishing one of the following: 1) actual use of the mark in commerce; 2) a bona fide intention to use the mark in commerce (i.e. an intent to use); or 3) a foreign owner’s country of origin application filed with a statement of a bona fide intent to use the mark in U.S. commerce.⁹⁷ The applicant is required to file a specimen showing the mark in commerce at the time the application is filed or before registration.⁹⁸ The mark can be opposed by anyone alleging that the registration should not be granted because the mark is likely to cause confusion or is likely to dilute the distinctiveness of a famous mark.⁹⁹

¶34 Once federal registration is obtained, the owner can use a statutory trademark notice to reasonably notify the public of the ownership.¹⁰⁰ Trademark protection extends indefinitely as long as the mark is not abandoned and does not become a generic term.¹⁰¹ The owner must maintain federal registration by (1) filing a declaration during the sixth and tenth year after issuance stating that the mark has been in use in commerce and (2) renewing the registration every ten years.¹⁰² The first entity to use a mark is considered

⁹¹ Trademarks include brand names, trade dress, service marks, certifications marks and collective marks. The legal principles apply to all of the above reference terms and are commonly referred as “marks.” For purposes of this paper, the discussion of trademark has been simple.

⁹² U.S. CONST. Art. I, § 8, cl 3. (“The Commerce Clause”)

⁹³ The Trademark Act of 1996 is codified in 15 U.S.C. § 1127 et seq. (2004). The short cite reference of this act is the Lanham Act. The Lanham Act is a marriage of state law and registration provisions that would provide a mark owner with protection in each of the fifty states and territories. The owner of the mark is not restricted to federal registration and is permitted to use both federal and state law to protect the mark.

⁹⁴ See 15 U.S.C. § 1051.

⁹⁵ See *id.*

⁹⁶ *Id.*

⁹⁷ *Id.*

⁹⁸ *Id.*

⁹⁹ *Id.* at § 1063.

¹⁰⁰ *Id.* at § 1111. Trademark notice can be used in the following forms: 1) the symbol ®; 2) the phrase “Registered U.S. Patent & Trademark Office,” or 3) or the abbreviation “Reg. U.S. Pat. & Tm. Off.”

¹⁰¹ *Id.* at § 1058.

¹⁰² *Id.* at §§ 1058 and 1059. Non-use of a mark for three continuously years is sufficient to prove an intent to abandon the mark and permit another party to obtain exclusive use of the mark.

the owner of the trademark regardless of whether another party obtains federal registration.

¶35 To determine whether a mark should be afforded trademark protection, the court must evaluate the mark in terms of the trademark classification: 1) generic; 2) descriptive 3) suggestive; 4) arbitrary; or 5) fanciful.¹⁰³ Trademark protection has a sliding scale of protection.¹⁰⁴ On one end of the spectrum is generic marks which do not qualify for trademark protection, and at the other end of the spectrum is fanciful marks which enjoy the greatest trademark protection because they are “inherently distinctive.”¹⁰⁵

¶36 Infringement of the trademark occurs when someone else uses the same or a confusingly similar term, on the same or closely related goods or services, in the same geographic areas of the registered or unregistered mark.¹⁰⁶ In the event of trademark infringement, the owner is afforded certain civil remedies and statutory damages.¹⁰⁷

¶37 It is well settled that a trademark protects more than just words and does so even when there is no likelihood of confusion.¹⁰⁸ Current trademark protection includes: words, numbers, slogans, pictures, symbols, characters, sounds, graphic designs, and color.¹⁰⁹ The expansive definition of trademarks affords a merchant or the mark owner the ability to distinguish its goods from its competitors’ goods.. The exclusivity of trademark law is founded on the principle of appropriation.¹¹⁰

¶38 Trademark law is a subset of the broader common law of unfair competition.¹¹¹ Consequently, trademark protection is assigned to the first user of the mark in commerce and not the first person to adopt the mark.¹¹²

A. Trade Dress Protection

¶39 As the principles of trademark policy have evolved, courts have recognized that the “trade dress” of a product is also protectible.¹¹³ Trade dress protection extends beyond

¹⁰³ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-11 (2d Cir. 1976).

¹⁰⁴ *Id.*

¹⁰⁵ *Id.*

¹⁰⁶ *See* 15 U.S.C. § 1114.

¹⁰⁷ *See id.* Civil Remedies include: 1) an injunction against future infringement; 2) disgorgement of the defendant’s profits; 3) treble damages for past infringement suffered by the owner of the mark; 3) destruction of all materials bearing the infringe mark an recall of infringing goods; and 4) reasonable attorney fees. The alleged infringer must have notice before a trademark owner can receive monetary damages.

¹⁰⁸ *Id.*

¹⁰⁹ *See generally* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9, 13 (1995). [hereinafter RESTATEMENT].

¹¹⁰ *Id.* *See also* JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE § 1.02(1)(b) (1999). The distinction is an important factor in determining whether a party is entitled to trademark protection of a mark that has been used in commerce. For purposes of this article, an extensive discussion of the history of trademark law has been excluded but the reader can refer to the following documents for a comprehensive overview of trademark law: Andrew T. Spence, *When A Landmark Cannot Serve as a Trademark: Trademark Protection for Building Designs in Light of Rock And Roll Hall of Fame And Museum, Inc. v. Famous Productions*, 2 WASH. U.J.L & POL’Y 517 (2000); Lee B. Burgunder, *Commercial Photographs of Famous Buildings: The Sixth Circuit Fails to Make the Hall of Fame*, 89 TRADEMARK REP. 791 (1999).

¹¹¹ *See generally* RESTATEMENT, *supra* note 109, §9.

¹¹² *See* 15 U.S.C. § 1051.

¹¹³ *See* *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 162 (1995); *see also* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 775 (1992) *affirming* *Taco Cabana International, Inc. v. Two Pesos, Inc.*, 932 F.2d 113 (5th Cir. 1991).

just the packaging of the product (i.e. the label, box, display or similar packaging elements) to include the product's total image (i.e. the size, shape, color, textures, or graphics).¹¹⁴ Consequently, extending trade dress protection to a three-dimensional object is consistent with the spirit and intent of trademark protection regardless of whether the design is viewed as packaging or the product itself.¹¹⁵

¶40 The expansion of trademark law to cover trade dress and product configurations did not develop without significant growing pains. In fact, an owner seeking trademark protection of a product feature should anticipate that courts will use heightened scrutiny in determining the validity of the mark to ensure that the mark does not run afoul of the true intent of trademark protection by stifling competition.¹¹⁶

¶41 In response, courts have developed the “functionality” test to determine whether a product design is more “useful” or “aesthetic.”¹¹⁷ Even if a mark has a function or purpose, the mark is not precluded from being a valid mark, especially if other aspects of the mark are non-functional.¹¹⁸ Consequently, the same underlying principles that provide for trademark protection of aesthetically functional marks generally apply to using trademark laws to protect architectural features such as building designs.¹¹⁹

¶42 Trade dress protection is also subject to the general principles of trademark law distinguishing between a generic and a fanciful mark. Trade dress is generic if “well known,” or “common,” “a mere refinement of a commonly adopted and well known form of ornamentation,” or a “common basic shape of design,” even if it has “not before been refined in precisely the same way.”¹²⁰ Imploring this same logic, at the other end of the spectrum, trade dress is “inherently distinctive” if it inherently identifies a specific source or owner of the product.¹²¹ Even if the trade dress is not inherently distinctive, it may still be protected if it has acquired secondary meaning.¹²²

¶43 In determining whether trade dress protection is warranted, a court must first decide whether the trade dress of the architectural work is a product design or a product package. The Supreme Court has not addressed how trade dress protection would apply to architectural works. Thus, one could make an argument that the design features of the

¹¹⁴ John H. Harland Co. v. Clark Checks, Inc., 711 F.2d 960, 980 (11th Cir. 1983); *see also* Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd., 40 F.3d 1431, 1439 (3rd Cir. 1994); Burgunder, *supra* note 110, at 796.

¹¹⁵ An example of a widely recognized three-dimensional shape that has been afforded trade-dress protection is the Coca-Cola bottle. *See* Coca-Cola, Co. v. Alma-Leo, U.S.A., Inc., 719 F. Supp. 725 (N.D. Ill. 1989). Specifically, a Coca-Cola bottle enjoys multiple intellectual property protection including trade-secret (e.g. the Coca-Cola formula in the bottle), trademark (e.g. the Coca-Cola name), and trade-dress protection (e.g. the bottle itself).

¹¹⁶ Burgunder, *supra* note 110, at 797.

¹¹⁷ *Qualitex*, 514 U.S. at 169-70.

¹¹⁸ Ferrari S.P.A. Esercizio Fabriche Automobile Corse v. Roberts, 944 F.2d 1235 (6th Cir. 1991). The plaintiff designed and manufactured upscale sports cars. The defendant manufactured another vehicle that replicated the external shape of the plaintiff's car designs for a significantly reduced price. *Id.* at 1238. The court held, consistent with long standing trademark law principles, that aesthetic functionality does preclude a finding of non-functionality for trademark purposes where the design suggests the origin of the product. *Id.* at 1247.

¹¹⁹ GILSON, *supra* note 112, § 7.02(7)(h)(i); *see also* Spence, *supra* note 110, at 527-28.

¹²⁰ Ale House Management, Inc. v. Raleigh Ale House, Inc., 205 F.3d 137, 142 (4th Cir. 2000).

¹²¹ *Two Pesos*, 505 U.S. at 769.

¹²² *Id.* at 769 (“Section 2 of the Lanham Act provides that a descriptive mark that could not be registered under that Act may be registered if it ‘has become distinctive of the applicant’s goods in commerce.’ This acquired distinctiveness is generally called ‘secondary meaning.’”) (citations omitted).

architectural work are the product design. In the alternative, one could argue that the overall structure of the architectural work is the product packaging. The important distinction is that trade dress protection of a product design does not require any secondary meaning because it is inherently distinctive. In contrast, trade dress protection of a product's packaging is not inherently distinctive and thus requires acquired secondary meaning to be protectible.¹²³ Therefore, the availability of trade dress protection is dependent on the characterization of the elements to be protected.

B. Trademark Protection of Architectural Works

¶44 As stated above, trademark law protects more than just words. If the applicant satisfies the requirements provided under the Lanham Act, then the first user of the mark is entitled to register the mark with the United States Patent & Trademark Office ("PTO").¹²⁴ In the PTO's Trademark Manual of Examining Procedure, "the three-dimensional configuration of a building is able to be registered only if it is used in such a way that it is or could be perceived as a mark."¹²⁵ Additionally, the Lanham Act provides that a person is liable for infringement if he or she, "without consent of the registrant" uses the mark "in commerce, any reproduction, counterfeit, copy or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising."¹²⁶

¶45 To prevail on a claim of trademark infringement of an architectural trademark, the plaintiff must establish that the defendant used 1) a "reproduction, counterfeit, copy or colorable imitation" of the plaintiff's mark; 2) without consent; 3) in interstate commerce; 4) in connection with a sale or offer for sale; and 5) "where such use is likely to cause confusion."¹²⁷ Consequently, it is well established that "a plaintiff must show that it has actually used the designation at issue *as a trademark*, and that the defendant has also used the same or a similar designation *as a trademark*."¹²⁸ For a valid trademark, the designation must create "a separate and distinct commercial impression, which . . . performs the trademark function of identifying the source of the merchandise to the customers."¹²⁹ The plaintiff must also establish likelihood that the defendant's designation will be confused with the plaintiff's trademark, such that consumers are mistakenly led to believe that the defendant's goods are produced or sponsored by the plaintiff.¹³⁰ In other words, infringement of an architectural trademark requires the existence of a likelihood of confusion which courts evaluate on a case-by-case basis.

¹²³ See *id.* at 768 (holding that trade dress which is inherently distinctive is protectible without a showing that it has acquired secondary meaning); *cf.* *Wal-mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000) (holding that product design is entitled to protection as unregistered trade dress only if it has acquired secondary meaning).

¹²⁴ 15 U.S.C. § 1051.

¹²⁵ See United States Patent and Trademark Office, Trademark Manual of Examining Procedure § 1301.02 (c), available at <http://www.uspto.gov/web/offices/tac/tmep/> (last visited Apr. 7, 2005).

¹²⁶ 15 U.S.C. § 1114.

¹²⁷ Annette Lesieutre Honan, *The Skyscraping Reach of the Lanham Act: How Far Should the Protection of Famous Building Design Trademarks Be Extended?*, 94 NW. U.L.REV. 1509, 1513-14 (2000).

¹²⁸ See *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prod.*, 134 F.3d 749, 753 (6th Cir. 1998) (citing *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 86 F.3d 619, 622-23 (6th Cir. 1996)).

¹²⁹ *Rock & Roll Hall of Fame*, 134 F.3d at 752.

¹³⁰ *Id.* at 753-54. (The Sixth Circuit was unconvinced that the building design for the Rock and Roll

¶46 An owner of a famous building who owns a federally registered trademark can assert a claim of infringement under § 1114 of the Lanham Act.¹³¹ In the absence of federal registration, the owner may assert a claim of false designation of origin under § 1125(a) of the Lanham Act.¹³² Unlike copyright law, federal registration is not a prerequisite to seeking a remedy for trademark infringement.¹³³ In fact, many architects successfully prevail on trademark infringement claims under § 1125(a).

IV. CIRCUIT COURT OPINIONS

¶47 In the absence of a Supreme Court or Federal Circuit case on point, the Circuit Courts of Appeals have recently addressed both copyright and trademark protection of famous and not so famous building designs. Even though the term “architectural works” was recently defined as copyrightable subject matter, architectural works have enjoyed long-standing intellectual property protection, specifically as registered trademarks.¹³⁴ As discussed above, copyrights and trademarks provide different but overlapping scopes of protection, the key distinction being when the requisite intellectual property attaches. For copyrights it is when the work is created, and for trademarks it is when the mark has been published in the public domain.¹³⁵

¶48 The Sixth Circuit has provided some guidance in analyzing the scope of intellectual property protection of building designs. First, in *Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Products*,¹³⁶ the court concluded that the plaintiff did not possess a valid trademark registration and thus could not prevail for trademark infringement against the defendant.¹³⁷ At the other end of the spectrum, in *Johnson v. Jones*,¹³⁸ the court was more sympathetic in granting relief to the architect for the copying of the architect’s drawings.

¶49 The *Rock and Roll Hall of Fame* case sparked significant legal discussion regarding the accuracy of the court’s opinion and the affect of the court’s decision in this area of the law.¹³⁹ The long-standing principles of copyright protection of architectural drawings coupled with the AWCPA amendment incorporating architectural works should have

Hall of Fame and Museum, Inc. could serve as a valid trademark because the plaintiff had not used the design consistently and continuously in the sale of goods.).

¹³¹ See 15 U.S.C. § 1114.

¹³² Federal registration does not preclude an owner of a famous building from filing a claim under § 1125(a) of the Lanham Act. See generally *id.* § 1125(a).

¹³³ See *id.*

¹³⁴ See 17 U.S.C. § 101.

¹³⁵ See 15 U.S.C. § 1051; 17 U.S.C. § 101.

¹³⁶ 134 F.3d 749 (6th Cir. 1998).

¹³⁷ Even if the owner had asserted a copyright infringement claim, the claim would most likely have been rejected because photographs taken of architectural works are not considered infringement of the owner’s copyright in the architectural work. See 17 U.S.C. § 120.

¹³⁸ 149 F.3d 494 (6th Cir. 1998). Even though, the facts presented a classic case of willful copyright infringement, the plaintiff was unable to recover statutory damages and attorney fees under the Copyright Act because the alleged infringement occurred prior to the registration of the plaintiff’s architectural plans. *Id.* at 504-505. Due to the egregiousness of the parties’ behavior, the Court granted summary judgment on Plaintiff’s unfair competition claims under § 1125 (a) of the Lanham Act. *Id.* at 496.

¹³⁹ Subsequent to the Sixth Circuit’s decision in this case, several law review articles criticize the conflicting positions of the majority and the design with respect to the use of trademark law to protect building designs. See Spence, *supra* note 110, at 517.

precluded the Sixth Circuit from simply ignoring the museum's rights to control derivative works of the building design. Under the AWCPA, pictorial representations of building structures are specifically excluded.¹⁴⁰ Furthermore, under the Lanham Act, trademark protection of photographs or other depictions of an architectural work is unavailable unless the architectural work has enjoyed inherent distinctiveness.¹⁴¹ Using a copyright substantial similarity analysis under these circumstances probably would not have yielded a different result. Hence, this is an area where trademark and copyright law are consistent in their treatment of architectural works.

¶150 In *Johnson*, the Sixth Circuit was presented with a slightly different issue regarding the protection of the plaintiff's architectural plans.¹⁴² Rather than giving relief for copyright infringement, the court used a likelihood of confusion analysis under the Lanham Act, even though the dispute between the parties involved the unauthorized copying and use of the plaintiff's architectural plans.¹⁴³ Fortunately for the plaintiff in this case, he asserted both a copyright infringement claim as well as an unfair competition claim under the Lanham Act, and he was granted at least one form of relief.¹⁴⁴ This is a good strategy but one that is not always successful as evidenced in the following case decided by the Second Circuit.

¶151 In affirming the district court's decision, the Second Circuit's decision in *Attia v. Society of the New York Hospital*¹⁴⁵ concluded that the plaintiff's drawings were not infringed under either trademark or copyright laws. The *Attia* case presented an interesting set of facts involving an individual architect and joint venture of two well known architecture firms with respect to the scope of intellectual property protection of preliminary architectural. The plaintiff, Eli Attia, was retained by the New York Hospital ("NYH") to develop a design concept for a new building to be constructed over the F.D.R.¹⁴⁶ Attia prepared a series of architectural drawings and sketches that NYH regarded as its "preferred" approach.¹⁴⁷ Subsequently, Attia was engaged to work as a co-consultant with one of the defendants, Taylor Clark Architects, but unfortunately, the relationship between the parties soured.¹⁴⁸ Eventually, NYH initiated a competition to

¹⁴⁰ 17 U.S.C. § 120(a). Congress explicitly declined to grant authors of architectural works the right "to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations." *Id.*

¹⁴¹ See *Rock & Roll Hall of Fame*, 134 F.3d at 753.

¹⁴² *Johnson*, 149 F.3d 494. Johnson, a licensed architect, was retained to build the defendant, Theresa Jones' dream house. *Id.* at 497. The parties could not agree on the terms of a contract but Johnson continued to work on the project. *Id.* at 498. Johnson prepared demolition drawings, addition drawings and a site plan, which were all submitted to the local building department for approval. *Id.* Eventually, the parties were unable to agree on a contract and Johnson was terminated. *Id.* at 499. Jones retained another architect, who used Johnson's drawings to create new drawing to submit to the building department, literally tracing Johnson's designs and removing Johnson's name and seal and replacing it with his name. *Id.* Johnson, after a site visit, discovered that his drawings had been duplicated without his permission and that his name and seal had been removed. Consequently, Johnson filed suit under 17 U.S.C. §§ 102(a)(5) and 8 of the Copyright Act and § 1125(a) of the Lanham Act. *Id.*

¹⁴³ *Johnson*, 184 F.3d at 502-503; see generally *Shakespeare Co. v. Silstar Corp. of America, Inc.*, 906 F. Supp. 997, 1007-1008 (D.S.C. 1996); *Pizzeria Uno Corp. v. Perni Constr. Inc.*, F.2d 121, 127 (4th Cir. 1990); *Quality Inns Int'l, Inc. v. McDonald's Corp.*, 695 F. Supp. 198, 209 (D. Md. 1988).

¹⁴⁴ *Johnson*, 149 F.3d. at 494.

¹⁴⁵ 201 F.3d 50 (2d Cir. 1999).

¹⁴⁶ *Id.* at 52.

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

select a design team to prepare the final architectural plans and elected to use an alternate firm, which included the architectural firm initially retained to work with Attia.¹⁴⁹

¶152 Neither the Second Circuit nor the District Court believed that there was a genuine issue of fact regarding whether the plaintiff's and the defendant's drawings were substantially similar.¹⁵⁰ The Second Circuit noted that "not all copying from copyrighted material is necessarily an infringement of copyright."¹⁵¹ There are elements of a copyrighted work that are not protected even against intentional copying.¹⁵² Ultimately, the court concluded that Attia's drawings were "preliminary and conceptual," and therefore, just mere ideas.¹⁵³ Hence, he was not entitled to copyright protection of his ideas. This case blurs the line between the idea/expression dichotomy. Determining whether there is "substantial similarity" requires the court to analyze not only the similar features, but all the differences.¹⁵⁴ Nevertheless, the Second Circuit incorrectly concluded that there were significant differences between Attia's schematic drawings and the defendant's final design and thus was unwilling to conclude that copyright infringement had occurred.¹⁵⁵

¶153 In a factually similar case, *Sturdza v. United Arab Emirates*,¹⁵⁶ the District of Columbia Circuit Court focused on the "substantial similarity" of the parties' architectural works and reached a different outcome for the plaintiff. In evaluating the merits of the plaintiff's copyright infringement claim of his architectural design, the D.C. Circuit's analysis focused on whether the defendant's architectural design was substantially similar to the protectible elements of the plaintiff's design.¹⁵⁷ Unlike the Second Circuit, the D.C. Circuit does not favor summary judgment in copyright litigation, especially if the issue of substantial similarity is a reasonably close question of fact.¹⁵⁸ Consequently, the court's analysis included an evaluation of the "overall look and feel" of the two designs.¹⁵⁹ Perhaps if the Second Circuit had compared the overall look and feel of the two designs, Attia would have at least been afforded his day in court.

¹⁴⁹ *Id.*

¹⁵⁰ *Id.* at 53-54.

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ *Id.* at 57.

¹⁵⁴ *Id.* at 58.

¹⁵⁵ *Id.* at 60.

¹⁵⁶ 281 F.3d 1287 (D.C. Cir. 2002). Plaintiff Elena Sturdza, an architect, filed a copyright infringement action involving an architectural design for the United Arab Emirates' ("UAE") new embassy against the UAE and Angelos Demetriou, the architect who subsequently was awarded the project. *Id.* at 1292. The UAE initiated a competition for the architectural design of a new embassy in Washington, D.C. *Id.* Both architects submitted a design but the plaintiff was selected as the winner. *Id.* After a series of unsuccessful negotiations between UAE and the plaintiff, UAE eventually hired the defendant architect sparking the plaintiff to file suit against both parties. *Id.*

¹⁵⁷ *Id.* at 1295 (citations omitted).

¹⁵⁸ *Id.* at 1296 (citations omitted). Summary judgment is appropriate if the protectible elements of the architectural designs are so dissimilar that no reasonable jury could find for the plaintiff on the question of substantial similarity. *Id.* at 1297. The Second Circuit approved of the district court's analysis in filtering the elements of the plaintiff's design that were unprotectible such as domes, wind-towers, parapets, arches and Islamic patterns. *Id.*

¹⁵⁹ *Id.* The court's 'substantially similar' analysis was very comprehensive. The court commenced its analysis in identifying the ways that Demetriou's expression of architectural concepts mirrored Sturdza's architectural design. The court concluded that Demetriou's design, although different in some aspects, was sufficiently similar with respect to the individual elements and the overall look and feel of the design.

¶154 More recently, in *Rottlund Co, Inc. v. Pinnacle Corp.*,¹⁶⁰ the Magistrate judge declined to award summary judgment to either the plaintiff or the defendant on the issue of “substantial similarity.”¹⁶¹ Relying not only on Eight Circuit case precedent, the judge stated that, for purposes of determining whether summary judgment is appropriate, the “substantial similarity” analysis involves both an extrinsic and intrinsic examination.¹⁶² In fact, the Magistrate judge went beyond the Eighth Circuit case precedent by evaluating the opinions discussed above by the Second and the D.C. Circuits.¹⁶³ The substantially similar analysis requires a court to first focus on the objective similarities in the details of the work, and if substantial similarity of ideas exists, then the court must further engage in an “intrinsic test depending on the response of the ordinary reasonable person to the forms of expression.”¹⁶⁴

¶155 The judge concluded that a comparison of the plans revealed a similarity of ideas because the expression (i.e. the architectural drawings) and the subject matter (i.e. residential back-to-back townhouses) were similar.¹⁶⁵ Consequently, it is the “total concept and feel of the work” that is critical for determining whether copyright infringement has occurred.¹⁶⁶ The flaw of the substantial similarity doctrine with respect to determining infringement of an architectural work is that, for practical purposes, it involves comparing the architectural drawings of the parties and not the building structures. Thus, the total concept and the feel of the work as required in copyright infringement action may be significantly diminished by using a two dimensional illustration of the three-dimensional structure. It would be beneficial if copyright law could borrow some of the policy principles of trademark law and unfair competition in establishing parameters for evaluating whether the two works are similar.¹⁶⁷

¶156 As discussed above, trade-dress protection is also a viable alternative for the diligent architect to protect the overall look and configuration of the building structure. Perhaps, architects can pursue trade-dress protection of architectural works in lieu of copyright registration or in conjunction with copyright registration. Consequently, asserting trade dress protection of an architectural work may provide additional remedies for architects. A likelihood of confusion analysis as required under the Lanham Act would favor a more comprehensive analysis than the substantial similarity test under the Copyright Act. Instead of having courts pick and choose elements to compare, the likelihood of confusion test requires an examination of several factors.¹⁶⁸

Consequently, the court reversed the grant of summary judgment to the defendants.

¹⁶⁰ 2004 WL 1879983 at 24 (D. Minn. 2004). In this case, the plaintiff filed a lawsuit alleging infringement of technical drawings and architectural works as-built structures under §§ 102(a)(5) and (a)(8) under the Copyright Act.

¹⁶¹ *Id.* at 22.

¹⁶² *Id.*

¹⁶³ *Id.* at 23.

¹⁶⁴ *Id.*

¹⁶⁵ *Id.*

¹⁶⁶ *Id.* at 14. The court “filtered” the use of “gabled entries, lofts, or fireplaces” from Rottlund’s design because they represent mere ideas and not protected expression.

¹⁶⁷ Trademarks have a more stringent examination than copyrights. It should also be noted that in most cases, the client or the building owner would be seeking trademark registration protection and not the individual architect. Thus, many architects may be without any legal remedies if the selection, arrangement, and combination of elements in the technical drawings were sufficiently original to be afforded copyright protection. *Id.*

¹⁶⁸ *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Va., Inc.*, 43 F.3d 922, 930 (4th Cir. 1995); *see also*

¶57 An illustration of this discussion can be found in the Fourth Circuit’s opinion in *Ale House Management, Inc. v. Raleigh Ale House, Inc.*¹⁶⁹ In this case, the plaintiff was an operator of a small chain of facilities selling food and beer in Florida.¹⁷⁰ The defendant owned and operated a similar structure in Raleigh, North Carolina.¹⁷¹ The plaintiff alleged that the defendant violated its trade dress with respect to its exterior and interior appearance.¹⁷² In evaluating the evidence, the court concluded that the plaintiff’s trade dress was generic because there was no evidence of a unique or unusual configuration.¹⁷³ Unfortunately, the Fourth Circuit found insufficient evidence to recognize valid trade dress protection to the interior of an ale house, but this holding should not deter an architect or copyright owner from seeking trade dress protection of his or her architectural work.¹⁷⁴

V. CONCLUSION

¶58 Over the past fifteen years, the amount of litigation involving both copyright infringement of the architectural plans and building designs as well as trademark infringement claims relating to the building itself has increased. As discussed above, the diligent architect should not be handicapped by a discrete facet of intellectual property law to protect his or her architectural ingenuity. In determining which intellectual property protection is appropriate, an architect should evaluate the scope of protection, the duration of the protection, and the costs for obtaining the protection.

¶59 In most cases, trademarks provide broader protection than copyrights, but trademark protection of architectural works may be more difficult to obtain. Trademark protection lasts indefinitely, whereas copyright protection has term limitations which outlast the life span of the author. Finally, the cost of a copyright application is relatively inexpensive and subject to limited review compared to the application process for a federally registered trademark. The best protection should be determined on a case by case basis, but failure to take minimal steps to secure some form of intellectual property protection in the event an exact copy or duplicate of the architectural drawings or building design can have detrimental consequences and leave the architect with no legal remedies to adjudicate his or her claim.

Pizzeria Uno Corp. v. Temple, 747 F.2d 1522, 1527 (4th Cir. 1984) (articulating a seven-factor likelihood of confusion analysis).

¹⁶⁹ 205 F.3d 137 (4th Cir. 2000). The owner of several ale houses filed a trademark infringement, trade-dress infringement and copyright infringement against a potential competitor. *Id.* at 139.

¹⁷⁰ *Id.* at 138.

¹⁷¹ *Id.*

¹⁷² *Id.* at 141. Subsequent to the filing of this case, the plaintiff dropped its claim of trade dress infringement with respect to the exterior structure of the building.

¹⁷³ *Id.* at 142. As discussed in regards to generic trademarks, trade mark law does not provide protection of a generic trade dress. *Id.* (citing *Two Pesos, Inc.*, 505 U.S. at 768-70).

¹⁷⁴ *Id.*