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Legal Protection of Design Work

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In a recent case out of Arizona, the federal appellate circuit governing the western third of the nation confirmed the protection afforded architectural works under the Copyright Act and corrected a misleading error it had made in an earlier case.

Most people know that creative work is protected against unlicensed appropriation by others through the federal Copyright Act, Title 17 of the United States Code. More precisely, the *original expression* of ideas contained in a work are protected; the ideas themselves are not. A copyright automatically arises when the work is "fixed in a tangible medium." Enforcement of the right is greatly enhanced by registering the work with the Copyright Office.<

But what about architectural works? How can one protect the creative expression inherent in a work that is to be built, a work that is or will be visible to anyone who cares to examine it? Can the architect prevent others from copying the original elements of his structure? The answer is yes, and even more emphatically so after the case of *Hunt v. Pasternak* in the Ninth Circuit Court of Appeals.

Before 1990 a designer's chief protection was to copyright his plans and drawings as pictorial or graphic works. To the extent these documents contained original expressive elements, they could not be copied without the copyright owner's permission. This served well for certain kinds of risks. If someone copied or made use of the plans without authorization, the designer could sue for infringement. But what if the building has already been constructed and the copier need not rely on the plans but simply stroll through the building and take notes or pictures? The 1990 amendment of the Act sought to address this problem.

The Architectural Works Copyright Protection Act of 1990 added "architectural works" to the list of works that can be copyrighted. With this legislative stroke, the original expression in the design itself, as opposed to the rendering in the plans, now remains the property of the designer, to be licensed or not as he or she sees fit. (A reminder may be appropriate here concerning the idea/expression dichotomy: the notion of constructing a fireplace of brick cannot be copyrighted, while a particular mix and arrangement of brick in an unusual configuration may be copyrightable.)

The 1990 Act defined an architectural work as "the design of a building as embodied in any tangible medium of expression." To bring the reasoning full circle, if the purpose of the Act was to prevent copying of designs from the constructed versions of those designs, does the Act by this language also extend protection to the expressive elements of buildings that have not yet been constructed? This was the issue in the *Hunt* case.

The Ninth Circuit had touched on the issue earlier in a case that was decided after, but involved a design created before, the 1990 Act took effect (*Eales v. Environmental Lifestyles, Inc.)*. In explaining why the 1990 Act did not apply to the case before it, the court in *Eales* had stated that the amended Act protected only copyrighted "structures." In *Hunt*, the plaintiff was an architect whose plans were

rejected by the owner but were later given to another architect, who allegedly borrowed original elements from Hunt's design for a building that was then constructed. Hunt sued for infringement of the architectural work itself as embodied in the plans (as distinct from an action based on the copying of the plans), even though Hunt's building had not been built.

The lower court, following the directive from the Ninth Circuit in *Eales*, ruled that Hunt could not protect his unconstructed design under the Act. The Court of Appeals, however, acknowledged the error of its statement in *Eales* and reversed, holding that Congress clearly intended to protect architectural works embodied in any medium of expression, regardless of whether they have been actually constructed. Comments in the legislative history of the 1990 amendment indicated congressional concern with exactly this potential loophole, through which works that had been designed but not constructed could be infringed as long as the infringer did not actually rely on copyrighted plans. This concern led to the wording of the statute to cover such works.

To review the available protection, then: a designer may copyright both the plans depicting the design and the design itself as embodied in the plans or in any other tangible medium, including the constructed edifice.

The role of specifications raises an interesting question of protection. As an expressive work, specifications may fall short of warranting copyright protection, containing too little original content to qualify as expression rather than underlying idea. Specifications typically instruct the contractor in building the design, and much of this instruction is generic. But depending upon how much of the actual design is mirrored in the specifications, how much of the originality is captured in them, the specifications may "embody" the design and may therefore support copyright of the "architectural work" even though the specifications themselves are not copyrightable.

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