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The Origins and Unforeseen Implications of the Architectural Works Copyright Protection Act and Recent Developments In Its Interpretation and Implementation

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THE ORIGINS AND UNFORESEEN IMPLICATIONS OF THE ARCHITECTURAL WORKS COPYRIGHT PROTECTION ACT AND RECENT DEVELOPMENTS IN ITS INTERPRETATION AND IMPLEMENTATION

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I. INTRODUCTION

The enactment of the Architectural Works Copyright Protection Act (AWCPA) in 1990 was heralded as a significant step in the protection of original design work from unauthorized copying and as such, a benefit to members of the design professions. However, despite its alignment with copyright protection established in Europe by the Berne Convention, the AWCPA had several alleged shortcomings in both its coverage and definitions that were highlighted in subsequent years following its creation that, according to some, reduced its overall effectiveness.¹

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1. For example: Michael E. Scholl, *The Architectural Works Protection Act of 1990: A Solution or Hindrance?*, 22 MEM. ST U.L. REV. 807 (1992); Andrew S. Pollock, *The Architectural Works Copyright Protection Act: Analysis of Possible Ramifications and Arising Issues*, 70 NEB. L. REV. 873 (1992); Raleigh W. II Newsam, *Architecture and Copyright: Separating the Poetic from the Prosaic*, 71 TUL. L. REV. 1073 (1997); Gregory B. Hancks, *Copyright Protection For Architectural Design: A Conceptual and Practical Criticism*, 71 WASH. L. REV. 177 (1996); Todd Hixon, *The Architectural Works Copyright Protection Act of 1990: At Odds With the Traditional Limitations of American Copyright Law*, 37 ARIZ. L. REV. 629 (1995); Clark T. Thiel, *The Architectural Works Copyright*

While some of the shortcomings of the AWCPA including apportionment of damages, ownership of ideas, and confusing definitions of ‘building’ are now well known, a significant negative consequence of the AWCPA, which was unforeseen both during its drafting and in the years immediately following its enactment, has now become apparent. This has had significant repercussions in the single-family home industry, an area of construction that typically does not affect the majority of architects² but has led to significant legal action focused on copyright protection. While there are indeed cases that indicate that some architects have been better served legally when they believe their ideas have been used without their knowledge and permission, an unexpected surge in litigation involving the single-family home industry has evolved from circumstances where housing companies have registered for copyright protection for their model designs and have then systematically sued other homebuilders with similar designs for copyright infringement. The majority of the copyrighted homes are (from the perspective of an architect experienced in expert witness work) based upon traditional, preexisting housing solutions, which are common throughout the United States and conform in layout and appearance to market and consumer expectations. These homes display little—if nothing—in the way of originality, the very characteristic the AWCPA intended to protect. Inevitably, many of the homebuilders facing claims had house designs conforming to generic designs seen across the country for many years; possibly similar to the plaintiff’s models, but equally similar to countless other traditional models also on the market. Considering the limited number of design variables involved in single-family houses, many of which are not covered by the AWCPA (standard architectural features, functionally required elements, and standard configurations of space), it is often difficult to see what is left to compare within the remaining simple elements.

For some years after the consequences of the AWCPA became apparent, courts appeared reticent to stop ongoing proceedings by declaring summary judgment and were cautious in their judgments on the issues of substantial similarity of contested models and the alleged originality of copyrighted ideas “because substantial similarity is customarily an extremely close question of

Protection Gesture of 1990, or, Hey, That Looks Like My Building! 7 DEPAUL-LCA J. ART & ENT. L. 1 (1996).

2. Suzanne LaBarre, *Truth in Numbers* Metropolis Magazine (Oct. 1, 2008), <https://metropolismag.com/uncategorized/truth-in-numbers/>. Depending how the question is framed, the percentage of architects involved in housing design varies from 2% to 28%, although most estimates are found at the lower end of that scale.

fact, summary judgment has traditionally been frowned upon in copyright litigation.”³

Given the perceived subjectivity of concepts such as ‘creativity’ and ‘originality,’ caution is not surprising. However, the outcome of this hesitant approach has resulted in the encouragement of more aggressive copyright reinforcement action or ‘troll’ activity:

What Plaintiff did in response was either an ‘intellectual property shakedown’ and copyright trolling (3)⁴, or the vigorous protection of its copyrighted works (EC F No 73-1 at 10), depending on your point of view.⁵

Plaintiffs recognized that they could secure substantial settlements at mediation or in negotiation from defendants looking to avoid costly and time-consuming legal action where the outcome would be far from certain:

In recent years, opportunistic holders of copyright, patents, and other intellectual property have developed unsavory reputations for “trolling,” bringing strategic infringement claims of dubious merit in the hope of arranging prompt settlements with defendants who would prefer to pay modest or nuisance settlements rather than be tied up in expensive litigation.⁶

However, several recent rulings indicate that courts are beginning to focus more critically on architectural copyright infringement cases where judges are becoming more assertive in their assessment of substantial similarity and more inclined to grant summary judgment. This paper examines the background of the AWCPA, explores its largely unforeseen consequences within the homebuilding industry, and reviews several recent legal decisions that indicate a shift in attitude towards trolling, a clearer approach towards the determination of substantial similarity in design and more assertive use of summary judgment to terminate legal proceedings.

3. *Sturza v. United Arab Emirates*, 281 F.3d 1287, 1296 (D.C. Cir. 2002) (quoting *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 977 (2d. Cir. 1980).

4. *Design Basics, LLC, v. Lexington Homes, Inc.*, 858 F.3d 1093, 1096 (7th Cir. 2017).

5. *Design Basics, LLC v. Heller & Sons, Inc.*, No. 1:16-CV-175-HAB, 2019 WL 2602861, at *2 (N.D. Ind. June 24, 2019).

6. *Lexington*, 858 F.3d at 1097.

II. THE DEVELOPMENT OF COPYRIGHT PROTECTION

Prior to 1990, architects were afforded minimal copyright protection under the prevailing 1976 Copyright Act beyond the coverage of their actual drawings. As instruments of service, architects' designs were regarded more as a product rather than a service, and their original ideas were therefore vulnerable to misappropriation.

To conform to the 1968 Berne Convention, the United States developed the AWCPA, which came into law in 1990. Interestingly, the AWCPA was not ultimately supported by the American Institute of Architects (AIA), which expressed concerns about the AWCPA's impact on originality and contextualism within the built environment. (4)⁷ The AIA's concerns were not heeded. Subsequent to the enactment of the AWCPA, studies of its effectiveness revealed a number of shortcomings, including a lack of clarity regarding ownership of original ideas, a wide range of interpretation in the apportionment of damages, and an inconclusive definition of 'building' covering habitable and non-habitable buildings like churches and gazebos but excluding significant structures such as garages, bridges, and silos.⁸ (5)

Despite these shortcomings, the AWCPA did provide additional copyright protection for architects and has been instrumental in the resolution of a number of cases, usually at a larger scale of construction than single-family homes, such as condominiums or hotels.⁹ (6)

III. UNINTENDED CONSEQUENCES

A further outcome of the AWCPA, unpredicted during its formation and associated less with the architectural profession than the home building industry (where reliance on traditional, preexisting designs often precludes the role of the architect), has now become more apparent. For example, in some states, single-family housing is not legally defined as 'architecture' if it does not exceed 50,000 square feet. It, therefore, does not require an architect's involvement and stamp of approval. In the past few years, single-family home

7. While the AIA initially supported expanded copyright protection, the organization later dropped its support for the provision during the 1988 Berne Convention hearings. The hearings held by the U.S. House of Representatives indicate that a number of prominent architects were concerned that copyright protection might affect their ability to use elements from other architects' work, a long-standing tradition in the profession where contextualism and 'fitting in' to an existing design vocabulary are considered acceptable. "Our concern is that the well-accepted traditions of reference and limited borrowing of elements and details should be suppressed (United States Congress, 1990b)..

8. See Robert Greenstreet and Russell Klingaman, *Architectural Copyright: Recent Developments in Protecting Originality and the Architect's Right of Ownership*, 4 *Architectural Rsch.* Q. 177 (2000).

9. *Humphreys & Partners Architects, L.P., v. Lessard Design, Inc.*, 43 F.Supp.3d 644, 677-79 (E.D. Va. 2014).

designs, mostly at the modestly priced end of the spectrum, have been registered with the United States Copyright Office. Once granted protection, the designs can be systematically compared to the designs of other homebuilders. If the copyright owner decides they are ‘substantially similar,’ legal action can and has frequently been initiated.

Given the limited cost, a market-rate single-family home is inevitably limited in size, program (i.e. the number and type of rooms and spaces), layout, and appearance. Such homes are also heavily influenced by market and consumer demand. It is hardly surprising that the number of apparently similar solutions may be considered high—and the consequent number of lawsuits numerous.

Ironically, the expansion of legal action by design trolls was likely exacerbated by the expansion of the Internet, which provides almost unlimited access to design work. One of the tenets of proving copyright violation is, of course, a demonstration that the defendant had access to the copyrighted material. In the age of the Internet, it is easier now to claim their awareness without proving that materials such as books or brochures were sent or seen by the defendant prior to the creation of the alleged copies.

IV. THE COURTS’ RESPONSE

While some cases resolved appropriately after careful deliberation of the substantial similarities between contested buildings¹⁰ (6), they were typically large, complex (and expensive) structures with multiple components and designed by licensed architects. In such situations, substantial similarity of protected elements is easier to prove or disprove. Cases addressing design similarity between traditional, generic, single-family homes posed challenges for the judiciary, which initially handled them tentatively in response to the subjective, loosely defined concepts such as originality, creativity, and substantial similarity evoked in the complaints.

Certainly, in the assessment of pleadings to determine if there was a genuine need for a trial, courts often appeared, from an expert witness’s perspective, reluctant to issue summary judgment¹¹ (7), deferring the judgment call on these matters to ‘the ordinary reasonable person’ and allowing many cases to go forward to trial. This strengthened the Plaintiff’s resolve, who calculated that settlement was more likely a less onerous option for defendants to avoid a long, costly trial and increased the number of complaints accordingly.

Paradoxically, while most courts found that copyright protection afforded by the AWCPA was ‘thin,’ the degree of originality necessary to successfully

10. *Id.*

11. *Matsushita Elec. Indust. Co., Ltd., v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986).

claim copyright protection was minimal and rarely challenged successfully¹² (8). A review of copyrighted homes registered in the United States Copyright Office, all of which are claimed to be original creations that are ‘completely new’ and not based upon previous designs, is instructive.¹³ (9) Such solutions are often based upon preexisting, traditional design elements seen throughout the country for many years but have been rarely challenged either upon or subsequent to registration. In short, almost any design is protectable under the AWCPA with little proof of originality required, unlike the stringent process required to obtain a patent, a comparable form of intellectual property protection.

Similarly, access—a fundamental prerequisite for claiming copyright violation—became almost automatically assumed. Prior to the universal reach of the Internet, some proof of direct contact, such as mailed promotional materials, books, or sales meetings, would have been important to establish direct access to allegedly copyrighted materials. However, when the plaintiff’s materials are conveniently posted on the Internet, they are available to all, including potential defendants. Ironically widening the potential audience for design purchase increases the potential for misappropriation, leading to a drop in sales¹⁴ (10) and (it would seem) a shift in some business models from the building of homes to the aggressive pursuit of other homebuilders for alleged copyright infringement.

Finally, the question of design comparability and how to fairly determine substantial similarity raised challenging questions. Given the non-quantifiable definitions of the AWCPA, Courts were focused on the broad ‘look and feel’ of designs and had to wrestle with comparing subjective elements such as ‘character’ and the ‘overall flow of space’ or ‘overall concept and feel’ as they tried to determine originality and creativity. These are conveniently non-specific terms for the plaintiffs to invoke to demonstrate a general similarity without providing specific, quantifiable details of copying.

Consequently, the first 25 years of the AWCPA saw a great deal of unnecessary litigation in an area of design protection for which it was never directly intended. The result was a significant amount of legal settlement by

12. See *Zalewski v. Cicero Builder Dev. Inc.*, 754 F.3d 95 (2d. Cir. 2014).

13. United States Copyright Office, *Available Short Forms*, Document SL-7 REV (July 1997). (“The work must be completely new in the sense that it does not contain material that has been previously published or registered or that is in the public domain.”).

14. *Design Basics, LLC, v. Kerstiens Homes & Designs, Inc.*, 2019 WL 4749916 (S.D. Ind. 2019). In the initial Complaint registered against Kerstiens Homes, the Plaintiff claims that, subsequent to posting their designs on the Internet, their annual revenue dropped from over 4 million dollars from licensing revenues to 1 million dollars in 2009.

parties who, it could be argued, were never culpable of design copying but were forced to settle to prevent further nuisance and cost.

V. RECENT DEVELOPMENTS

In the past several years, there have been three copyright cases, all in the Midwest and all concerning single-family homes, that indicate an interesting shift in the judicial approach to copyright infringement cases¹⁵ (12). All three cases discussed here follow a similar pattern to dozens of comparable cases across the United States. Having registered multiple home designs with United States Copyright Office, the Plaintiff reviewed the housing models of scores, if not hundreds, of homebuilders in search of actionable infringement of their intellectual property.¹⁶ These targeted homebuilders were not necessarily direct competitors and were often situated in other states, many hundreds of miles away from the plaintiff's home base. If the copyright holders detected some similarity to any of their registered models in appearance and layout, they sued for copyright infringement. Here are three of the 150 cases instigated by just one plaintiff in the past few years, which according to Judge Griesbach in *Lexington*¹⁷ (3), represents one in every 300 builders in the United States. In these cases, unlike many preceding ones, all three were resolved by granting summary judgment against the plaintiff.

Both *Kerstiens* and *Heller* reaffirm the legal thinking exhibited in *Lexington* and indicate some important changes in attitude and actions concerning copyright protection. While it is still premature to establish these as a firm direction, there appear to be three important clarifications and shifts that, from an expert witness's perspective, strengthen counsels' hand in defending copyright infringement claims.

A. A Closer Look

In *Heller*, Judge Brady, in contrast to the earlier reluctance shown by the courts to make firm judgments on similarity and choosing instead to pass the responsibility on to the jury, stated that "even if the court found the plans to be similar on their faces, it would still be required to take a more detailed look to

15. See *Lexington Homes, Inc.*, 858 F.3d 1093 (2017); *Design Basics, LLC, v. Kerstiens Homes & Designs, Inc.*, 2019 WL 4749916 (S.D. Ind. 2019); *Design Basics LLC, v. Heller and Sons, Inc.*, 2019 WL 4200614 (N.D. Ind. 2019).

16. *Lexington Homes, Inc.*, 858 F.3d at 1096. ("Design Basics, LLC . . . and their affiliates claim rights to some 2700 home designs.").

17. *Id.* at 1097.

determine whether differences existed at a more detailed level,”¹⁸ (12) confirming the previous opinions in *Kerstiens* and *Lexington*: “The District Court would have erred if it had surveyed the plans from 30,000 feet, or even 5,000 feet. The Court had to take a closer look.”¹⁹

This contention that at a small scale, differences (however seemingly minor) are relevant indicates a willingness to take a detailed look at the contested designs, thus reaffirming the thinking in several other cases²⁰ (12) and showing a willingness to act emphatically on clear evidence on a lack of substantial similarity. This willingness to look carefully at the evidence led to summary judgments in all three cases.

B. Differences Rather Than Similarities

In addition to confirming that access is not proven simply by alleged substantial similarity²¹ (13)—a retreat from the universal, automatic access inferred by the Internet in prior times—the cases show a shift in attitude toward looking at differences in contested designs (as opposed to similarities) which moves the assessment of substantial similarity from the vague, ‘look and feel’ to more specific, quantifiable, and demonstrable differences of protectable elements: this reverses the approach stated in two previous cases,²² (13) which stated that “summary judgment has traditionally been frowned upon in copyright litigation.”²³ Thus, under the *Sturdza* analysis, a court is to focus on the similarities rather than the differences.

Sturdza, though, was not precisely a comparable case. Like *T Peg*, the cases involved buildings that were large, complex, and custom-built.²⁴ *Sturdza* involved the design of a large embassy building,²⁵ while *T Peg* was focused on customized, one-off timber frame house. Both designs involved architectural expertise and had substantial budgets, a far cry from the modestly-priced, minimally-scaled designs of the market price home building industry. The three new cases developed more specific views on substantial similarity in

18. See *Lexington Homes, Inc.*, 858 F.3d 1093 (2017); *Design Basics, LLC, v. Kerstiens Homes & Designs, Inc.*, 2019 WL 4749916 (S.D. Ind. 2019); and *Design Basics LLC, v. Heller and Sons, Inc.*, 2019 WL 4200614 (N.D. Ind. 2019).

19. *Lexington Homes, Inc.*, 858 F.3d at 1105.

20. *Supra* note 18.

21. See *T-Peg, Inc. v. Vermont Timber Works, Inc.*, 459 F.3d 97 (1st Cir. 2006); *Sturdza*, 281 F.3d at 1297-1300 (D.C. Cir. 2002).

22. *Sturdza*, 281 F.3d at 1296.

23. *Id.*

24. *T-Peg, Inc.*, 459 F.3d at 102.

25. *Sturdza*, 281 F.3d at 1291-92.

simple housing models that are, by definition, largely composed of preexisting, traditional building elements.

C. An Analytic Tool

The judges in all three cases expressed a preference for objective, quantifiable data rather than vague, subjective claims of similarity and relied on ‘analytic tools’ to inform their decision-making. In each case, their opinions enumerated specific differences between the contested plans and, in two cases, relied exclusively on the defendants’ expert witness reports: “The [C]ourt had to take a close look, and it did so using [the Defendant’s expert witness] report as an analytic tool.”²⁶

The expert witness reports, which thoroughly detailed the differences between the models, demonstrated that in shape, program, layout, square footage, dimensions, materials, and design details, multiple differences refuted the claims of substantial similarity. The sheer number of quantifiable differences within the various categories, regardless of size, often led to 50 pages of data for each compared sets of designs, providing the judges with measurable, objective evidence which collectively demonstrated the lack of substantial similarity: “Despite many of these differences being small and subtle, their review was considered appropriate: “where copyrights are ‘thin’, it is the details that matter.”²⁷

VI. SUMMARY

Despite the best intentions of the AWCPA, it has been shown to contain a number of shortcomings after its implementation, although perhaps none as unintended or consequential as its impact upon the homebuilding industry.

Loopholes and laxities in the copyright registration process have led to countless lawsuits and settlements in favor of design trolls, who have cynically used the registration of their traditional, generic design solutions to profit from attacks on owners of similar traditional design without comparable copyright protection.

In the past, the courts have provided little relief for the accused homebuilders, who, in many instances, settled with plaintiffs to avoid costly and time-consuming legal battles. However, the three recently decided cases in the Midwest discussed above indicate that more decisive court action on providing summary judgment, closely reviewing the details of the contested designs, focusing upon specific differences rather than general similarities, and

26. Lexington, 858 F.3d at 1103.

27. Design Basics LLC, v. Heller and Sons, Inc., 2019 WL 4200614 (N.D. Ind. 2019).

taking a quantifiable, objective approach in assessing substantial similarity through the use of ‘analytic tools.’ This more rigorous approach shows a clearer understanding of the concept of substantial similarity and a hardening of attitudes toward claims of originality for designs based upon traditional, preexisting elements: “We wonder where there is any blueprint for a single-family home anywhere in the country that [the Plaintiff] could not match to one of its own designs by applying the loose standard of similarity it relies upon here.”²⁸

This new approach will better serve an original goal of copyright protection—to preserve ownership of design originality while allowing traditional, preexisting designs to meet consumer needs and demands without unfair redress.

28. Lexington, 858 F.3d at 1103.