ANNOUNCEMENT

from the Copyright Office, Library of Congress, Washington, D.C. 20559

NOTICE OF INQUIRY

NOTICE OF INQUIRY: WORKS OF ARCHITECTURE

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LIBRARY OF CONGRESS

Copyright Office

[Docket No. RM 88-4]

Notice of Inquiry; Works of Architecture

AGENCY: Library of Congress, Copyright Office.

ACTION: Notice of inquiry; Works of architecture.

SUMMARY: The Copyright Office of the Library of Congress issues this notice of inquiry to advise the public that it is examining the scope of copyright and other forms of legal protection currently accorded works of architecture and the need, if any, for protection beyond that now available.

The Office invites comments from architects, builders of and contractors for commercial and residential structures, government agencies, academics, and interested members of the public.

DATE: Initial comments should be received by September 16, 1988. Reply comments should be received by November 18, 1988.

ADDRESS: Interested persons should submit ten copies of their written comments as follows:

If sent by mail: Library of Congress, Department 100, Washington, DC 20540.

If delivered by hand: Office of the Register of Copyrights, Copyright Office, James Madison Memorial Building, Room 403, First and Independence Avenue SE., Washington, DC 20559.

FOR FURTHER INFORMATION CONTACT: William Patry, Policy Planning Advisor to the Register of Copyrights, Copyright Office, Library of Congress, Washington, DC 20559. Telephone: (202) 287-8350.

SUPPLEMENTARY INFORMATION: At the request of the Subcommittee on Courts, Civil Liberties and the Administration of Justice of the House Committee on the Judiciary and the Subcommittee on Patents, Copyrights, and Trademarks of the Senate Committee on the Judiciary, the Copyright Office is examining the scope of copyright and other forms of legal protection (e.g., contractual, trade dress, and unfair competition) currently accorded works of architecture as well as two- and three-dimensional works related to architecture. The Office is also examining whether there is a need for protection beyond that currently available, including whether perceived deficiencies are capable of resolution through contractual agreements, what form increased protection, if any, should take, and the impact such enhanced protection would have on competition and the public.

The Berne Adherence Bills

H.R. 1623, the original bill introduced by Representative Kastenmeier on March 16, 1987 to implement the provisions of the Berne Convention for the Protection of Literary and Artistic Property, proposed to amend the Copyright Act to provide explicitly for protection of certain buildings and structures, subject, however, to certain exceptions and limitations. See also H.R. 2962 (Moorhead, introduced on behalf of the Administration).

Section 5 of H.R. 1623 would have amended 17 U.S.C. 102(a) by including "architectural works" as a protected form of subject matter. Section 4(a) defined "architectural works" as: "Buildings and other three-dimensional structures of an original artistic character, and works relative to architecture, such as building plans, blueprints, designs, and models." Section 9 of the bill would have provided a new 17 U.S.C. 120(a) containing limitations on works of architecture, including protection for only the "artistic character and design" and not the "processes or methods of construction;" an exemption for the making, distribution or public display of pictures, paintings, and photographs of works of architecture located in publicly accessible locations; a statutory right of owners of a building embodying an architectural work to have minor alterations made in order to enhance its utility; a prohibition against the seizure or destruction of infringing buildings; and finally, a limitation on the copyright owner's ability to obtain an injunction restraining the construction of an infringing building to only those situations where construction of the building has not been substantially completed.

During the extensive hearings held by the Subcommittee on Courts, Civil Liberties and the Administration of Justice on Berne adherence, there was little reference to whether the requirements of Article 2(1) of the Paris text of Berne [1] mandated the explicit treatment of architectural works in the manner contemplated by H.R. 1623. Two witnesses testified that Berne may not require such treatment. The American Institute of Architects submitted a written statement to the Subcommittee

[1] Article 2(1) provides in relevant part that the expression "literary and artistic works" protected under the Convention includes "works of architecture" and "illustrations, maps, plans, sketches and three-dimensional works relevant to architecture."

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stating a preference for a prevision of[2] the Copyright Act making it an act of infringement to construct a building based on reproduction of copyright[3] architectural plans. The AIA stated, however, that it was not then seeking protection for the buildings themselves.

In light of the minimalist approach taken to Berne adherence and the lack of a consensus that U.S. law needed revision in order to comply with Article 2(1) of Berne, the clean bill version of H.R. 1623—H.R. 4262—as introduced on March 28, 1988 and passed by the House of Representatives on May 10, 1988, deleted the above-mentioned provisions of H.R. 1623 concerning architectural works, and instead amended the definition of "pictorial, graphic, and sculptural works," in 17 U.S.C. 101 to encompass, in relevant part, "diagrams, models, and technical drawings, including architectural plans."

The Committee Report accompanying the bill explained:

> The Committee concluded that existing United States law is compatiable with the requirements of Berne. In addition to a degree of protection under copyright against copying of plans and separable artistic works, additional causes of action for misappropriation may be available under state contract and unfair competition theories.
>
> The bill leaves, untouched, two fundamental principles of copyright law: (1) That the design of a useful article is copyrightable only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from and are capable of existing independently of the utilitarian aspects of the useful article; and, (2) that copyright in a pictorial, graphic, or sculptural work, portraying a useful article as such does not extend to the reproduction of the useful article itself.
>
> Specifically, this means that even though the shape of a useful article, such as a building, may be aesthetically satisfying and valuable, the copyright law does not protect the shape. This test of separability and independence from the utilitarian aspects of the useful article does not depend upon the nature of the design—that is, even if the appearance of the useful article is determined by aesthetic, as opposed to functional considerations, only those pictorial, sculptural or graphic elements, if any, that can be identified separately from the shape of the useful article are copyrightable. Even if the three-dimensional design contains a separate and independent artistic feature (for example, a floral relief design on flatware or a gargoyle on a building), copyright protection would not cover the over-all configuration of the useful article as such.
>
> In the case of architectural works, in addition to protection for separable, artistic sculpture or decorative ornamentation, purely non-functional or monumental structures may be subject to copyright.
>
> The Committee has not amended section 113 of the Copyright Act and intends no change in the settled principle that copyright in a pictorial, graphic, or sculptural work, portraying a useful article as such, does not extend to the reproduction or manufacture of the useful article itself.

H.R. Rep. No. 100-609, 100th Cong., 2d Sess. 50–51 (1988).

The Senate, in its original Berne adherence legislation, proposed provisions on architectural works identical to those found in H.R. 1623. See S. 1301 (introduced May 29, 1987) by Senator Leahy, *see also S. 1971* (Hatch, on behalf of the Administration). Similarly, in reporting S. 1301 out of the Committee on the Judiciary, the Senate deleted these earlier provisions, replacing them instead with a revision to the definition of pictorial, graphic and sculptural works to expressly include architectural plans. This approach was also based on the minimalist theory of Berne adherence and the Committee's conclusion that: "U.S. Copyright Law, as modified by this Act, and other state and federal remedies, protect architectural works to the extent required by the Berne Convention." S. Rep. No. 100–352, 100th Cong., 2d Sess. 9 (1988). At the same time, the Committee noted that it "deliberately leaves in place the final sentence" of the definition of "pictorial, graphic, and sculptural works," which states that the design of a useful article (as also defined in Section 101) such as a building or structure will be considered a protected pictorial, graphic, or sculptural work.

Only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of the utilitarian aspects of the article.

S. Rep. No. 100–352 at 9.

Case Law

The case law has, on the whole, made a distinction between copyright in architectural plans and protection for the architectural structure. See *Demetriades v. Kaufman*, 88 Civ. 0848 (S.D.N.Y. filed March 8, 1988). But Cf. *Herman Frankel Org. v. Wolfe*, 184 U.S.P.Q. 819 (E.D. Mich. 1974). Some courts have awarded damages based on the profits derived by the defendant from sales of the houses. See *Robert R. Jones Associates v. Nino Homes*, CCH Copr. L. Rep. ¶26,165 (E.D. Mich. 1987); *Arthur Ruttenberg Corp. v. Dawney*, 647 F. Supp. 1214 (M.D. Fla. 1986); *Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Construction Co.*, 542 F. Supp. 252 (D. Neb. 1982).

Issues have also arisen over who is the copyright owner of architectural drawings: the commissioning party or the architect. See *Aitken, Hazen, Hoffman & Miller, supra.; Meltzer v. Zoller*, 520 F. Supp. 847 (D.N.J. 1981). Cf. generally, *Aldon Accessories Ltd. v. Spiegel, Inc.*, 738 F.2d 548 (2d Cir.), *cert. denied*, 469 U.S. 982 (1984) with *Easter Seal Society for Crippled Children and Adults of Louisiana, Inc. v. Playboy Enterprises*, 815 F.2d 323 (5th Cir. 1987), *cert. denied*, 56 U.S.L.W. 3661 (U.S. March 28, 1988) (No. 87–482) and *Community for Creative Non-Violence v. Reid*, No. 87–7051 (D.C. Cir. filed May 20, 1988).

Other forms of protection have also been sought for design aspects of buildings. *Associated Hostworks of California v. Moss*, 207 U.S.P.Q. 973 (W.D.N.C.) (trade dress); *White Tower System, Inc. v. White Castle System of Eating Houses Corp.*, 90 F.2d 87 (6th Cir.), *cert. denied*, 302 U.S. 1937 (id.); *Fotomat Corp. v. Cochran*, 437 F. Supp. 1231 (D. Kan. 1977) design of building found to operate as service mark). But cf. *Demetriades v. Kaufman, supra.* (denying preliminary injunction under Lanham Act section 43(a) and finding that plaintiff was unlikely to prove, on the merits, that a residential house had acquired secondary meaning, and stating conclusion that "extending section 43(a) protection to individual, residential designs would work a profound mischief in both the law and the home-building industry.")

Design patent protection has been found applicable to architectural components, although these decisions are sparse and relatively old. *Riter-Conley Mfg. Co.* v. *Aiken*, 203 F. Supp. 669, 702 (3d Cir. 1913); Ex Parte Foshay, 7 U.S.P.Q. 121 (Pat. Off. Bd. App. 1930).

Although unfair competition may provide remedies in some circumstances, courts in specific cases have held unfair competition claims to be preempted by section 301 of the Copyright Act. *Demetriades* v. *Kaufman, supra.*; *Schuchart & Associates* v. *Solo Serve Corp.*, 540 F. Supp. 928, 943–945 (W.D. Tex. 1982).

Contractual arrangements, to the extent enforceable under state law, of course, provide another avenue of protection.

Nature of the Inquiry: The Office's examination touches on three broad areas: (1) The type of copyright and other forms of protection (i.e., contractual, trade dress, unfair

[2] Error; line should read:
"stating a preference for a revision of"

[3] Error; line should read:
"based on reproduction of copyrighted"

competition, etc.) currently accorded works of architecture and works related to architecture; (2) the need, if any, for protection beyond that now available including whether perceived deficiencies are capable of resolution through private consensual arrangements; and (3) the laws and actual practices of foreign countries in protecting works of architecture and works related to architecture.

Specific Questions: The Office seeks comments in the following specific areas:

Subject Matter and Scope of Protection

1. What forms of legal protection are presently available to protect works of architecture and works related to architecture?

2. Is that protection sufficient to foster the economic and aesthetic interests of those involved in the creation and exploitation of such works?

3. If not, should the creators of works of architecture and works related to architecture have the exclusive right under the Copyright Act or other forms of protection to authorize the reproduction of their works? Should copyright or other forms of protection be extended to buildings or structures provided they contain externally or internally conceptually separable elements as to form or design, and if so, what test should be used to determine whether conceptual separability exists? Cf. *Esquire* v. *Ringer*, 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 1979); *Kieselstein-Cord* v. *Accessories*[4] *by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980); *Carol Barnhart, Inc.* v. *Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985); *Brandir International, Inc.* v. *Cascade Pacific Lumber Co.*, 5 U.S.P.Q. 2d 1089 (2d Cir. 1987).

If copyright of other forms of protection should not be extended to the buildings or structures themselves, should it be extended to prevent the construction of buildings or structures based on infringing architectural plans, drawings, elevations, or three-dimensional models; and, if so, would such a right, in practice, nevertheless result in protection of buildings or structures?

What is the effect of 17 U.S.C. 102(b) and *Baker* v. *Selden*, 101 U.S. 99 (1879) on such protection? Can a building or structure be a "copy" of architectural plans it is derived from, and if so, does it make a difference whether the building or structure itself constitutes a copyrightable work?

4. What is the effect of architects' use of classical or other public domain elements such as designs that are staple, commonplace, or familiar in the industry?

5. If protection should be granted to buildings or structures, what should the scope of that protection be? Should the standard for infringement of buildings or structures be the same as for traditional copyrighted works of the arts, i.e., substantial similarity? How would recent decisions on the total concept and feel test apply to infringement of works of architecture?

6. Should the owner of the intellectual property rights in a protected work of architecture have the right to prohibit others from constructing an otherwise infringing work if those others have created their work without the aid of the original plans, drawings, elevations, or three-dimensional models, such as by viewing the protected work or by taking its measurements? Should the owner of the intellectual property rights in a protected building have the right to require destruction of completed or uncompleted buildings or structures? What would the appropriate monetary remedies be for infringement of a protected work of architecture or work related to architecture?

7. If the owner of the intellectual property rights in a work of architecture conveys those rights, should he or she still have the right to prohibit alterations to the work, and if so, what kind of alterations, all or only those that are not of a practical or technical nature necessary for maintenance or repair? If he or she should have the right to prohibit alterations (or at least those of a non-utilitarian purpose or effect), and the owner of the material embodiment of the work makes unauthorized alterations, what should the the available remedies be?

Should the owner of the intellectual property rights in a work of architecture ever have the right to require or demand the destruction of infringing buildings or structures or to prohibit their removal from a specific site?

8. Should the owner of the intellectual property rights in a protected work of architecture that has been altered without consent have the right to prohibit his or her association or authorship with the work?

9. Assuming rights should be granted to works of architecture, how long should the term of protection be, and if federal rights are involved, including copyright, what should the extent of preemption of state law be?

10. If rights were granted to works of architecture, should there be an exemption for the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations if the work is located in a place accessible to the public, and if so, should the exemption be limited to noncommercial uses? What role would the fair use doctrine play if protection were granted?

11. Who should the initial owner of intellectual property rights in a protected work of architecture be, and how would the work for hire doctrine in the Copyright Act affect ownership questions? How are questions of ownership of intellectual property rights in works related to architecture presently resolved? Does that system work effectively? How would the copyright concept of joint ownership operate if protection were extended to works of architecture?

Contractual Practices

12. Can private, consensual agreements resolve any perceived deficiencies with the current state of protection for works of architecture and works related to architecture?

Foreign Law and Practices

13. What is the nature and extent of protection granted in foreign countries to works of architecture and works related to architecture and how is that protection actually accorded in practice? Are foreign practices relevant or applicable to practices in the United States?

Copies of all comments received will be available for public inspection and copying between the hours of 8:30 a.m. and 4:00 p.m. Monday through Friday, in Room 401, James Madison Memorial Building, Library of Congress, First and Independence Avenue SE., Washington, DC 20559.

Dated: May 26, 1988.

Ralph Oman,

Register of Copyrights.

William J. Welsh,

Deputy Librarian of Congress.

[FR Doc. 88-12872 Filed 6-7-88; 8:45 am]

BILLING CODE 1410-07-M

[4] Error; line should read:
"(1979); Kieselstein-Cord v. Accessories"

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