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Joseph M. Cahn

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THE PROTECTION OF ARCHITECTURAL PLANS AS INTELLECTUAL PROPERTY

The architect, no less than the author, composer, or inventor, applies creative intellect to bring into existence new ideas and to formulate new combinations of existing ideas. The architect, however, does not enjoy the same breadth of protection against appropriation of his product available to certain other producers of original work. This seeming inconsistency is unfortunate because very often the architect has both economic and professional interests in seeing that his unique designs are not appropriated by others without some form of compensation and/or regulation.

At present, there appear to be five remedies of potential utilization for the protection of architectural designs from misappropriation. These include: (1) contractual provisions inserted in the architect-client agreement defining the rights of the parties to the contract; (2) the doctrine of common law copyright; (3) the federal Copyright Act;¹ (4) the Patent Act;² and (5) the doctrine of unfair competition. The purpose of this Comment will be to highlight the various interests which the architect may seek to protect and to discuss the above-mentioned potential remedies, noting their practical as well as legal limitations.

INTERESTS TO BE PROTECTED

Despite the multitude of business situations involving transactions with respect to the acquisition and use of architectural plans and designs, it is possible to categorize any given situation within one of three general categories: (1) the monumental project; (2) the client-related project; and (3) the merchant-builder situation. While in each of these categories the architect is interested in protecting himself against the unregulated and/or uncompensated appropriation of his product, the ultimate focal points of that interest will differ depending upon the project category involved.

The monumental project normally involves a major undertaking, understood by the parties involved to be "one of a kind" in nature. This may encompass such works as major public buildings, government of-

1. 17 U.S.C. § 1 *et. seq.* (1970).

2. 35 U.S.C. § 1 *et. seq.* (1970).

fices, museums, concert halls, etc. Typically, as between the architect and the client, such a situation involves no problem of multiple use of the plans since the architectural design *per se* will be used only once. The architect is nevertheless likely to have certain other interests he may wish to protect. He naturally has an interest in being compensated for the initial use of his plans and design. He may have a continuing interest in maintaining the integrity of that design and preventing others from corrupting it. Even after the project has been completed, there may exist valuable property rights in such things as the publication of descriptive pamphlets, models and other such "residuals" which carry the possibility of commercial exploitation. Finally, it is very possible that the architect (as well as the client) may have an interest in preventing the commercial exploitation of the popularity of the original through a proliferation of "cheap copies."

The client-related project typically involves situations in which the architect is retained to design and draft plans for a client's home or place of business. The architect doing work in this area is apt to feel that his main "stock in trade" lies in his unique design approach. He will want to protect the uniqueness of that approach by insuring that neither the client nor a third party reproduces its unique essentials in the construction of other buildings without first compensating its creator.

In the merchant-builder situation, it is known in advance that the design will be repeated many times. Often in such situations, the architect himself will retain the rights to the design and want to assure himself that it cannot be used by his client or a third party without payment of a royalty. In such a case, the merchant-builder assumes the position of an exclusive licensee having no property right in the design itself. In some instances, however, the merchant-builder may actually acquire the rights to the design. In either event, whether he is a mere licensee or owns the actual rights in the design itself, the merchant-builder's interests are much the same as those of the architect who himself retains the rights to his design. Namely, he desires the right to prevent others from copying the design and constructing and selling products based thereon in competition with him.

The remedies discussed in this Comment would likely find their principal application in business situations involving projects of either the client-related or merchant-builder types. In the area of the monumental project, it is, of course, clear that the architect has a right to be compensated for the acceptance and use of submitted plans unless

he has expressly contracted otherwise.³ Aside from this, however, there exists little law dealing with questions concerning rights which arise and interests sought to be protected in the monumental project situation. The lack of judicial declarations in this area results primarily from the comparative lack of such projects and the fact that the architects involved have apparently reconciled themselves to accepting an agreed upon fee and a right to supervise construction for the purpose of preserving the artistic integrity of their design⁴ as sole consideration for their efforts. Thus, while the remedies suggested in this paper are theoretically of equal applicability to each of the three categories described, it is unlikely that they would find substantial actual application in the monumental project area due mainly to the lack of judicial opportunity for such application.

POTENTIAL REMEDIES FOR MISAPPROPRIATION

1. Contractual Provisions

In the absence of contractual provisions to the contrary, an architect's client acquires all rights in and title to the architectural plans and specifications themselves, as well as the design embodied therein.⁵ While

3. See especially, *Ketcham v. New York World's Fair 1939, Inc.*, 34 F. Supp. 657, 659 (E.D.N.Y. 1940), *aff'd*, 119 F.2d 422 (2d Cir. 1940) recognizing that:

[I]t is the law that one who has worked out an embodiment of a design for a work of art or plans for a large building program possesses a property right in his original production.

But see *Bristol v. Equitable Life Assurance Soc'y*, 132 N.Y. 264, 267-68, 30 N.E. 506, 507 (1892), for the proposition that it is up to the originator of such a design to himself protect it from disclosure, and that if it is revealed to another in the course of negotiation, the originator has no cause of action for its value.

4. The right to protect the artistic integrity of one's design falls within the "moral rights" doctrine as recognized in Europe and recently achieving recognition in the United States. For a discussion of the history and development of the "doctrine," see M. NIMMER, *NIMMER ON COPYRIGHT* § 110 (M. Bender ed. 1963, Supp. 1972) [hereinafter cited as NIMMER]. In essence, the doctrine provides that the author should have the right, during his lifetime, to claim authorship of the work and to object to any distortion, mutilation or other alteration thereof, or any other action in relation to his work which would be prejudicial to his honor or reputation. International Union For the Protection of Literary and Artistic Works, signed at Berne, Switzerland, September 9, 1886, as revised at Brussels, June 26, 1948 (customarily referred to as the Berne Convention) at Article 6bis, contained in NIMMER, *supra*, at Appendix O. See also NIMMER, *supra*, § 110.3. The doctrine is not fully accepted in all American jurisdictions. NIMMER, *supra*, § 110.2. It should nevertheless be argued in a case involving "cheap copies" of a monumental project. See generally Katz, *The Doctrine of Moral Right and American Copyright Law—A Proposal*, 24 S. CAL. L. REV. 375 (1951).

5. 6 C.J.S. *Architects* § 10 (1958); *J.J. Henry Co. v. United States*, 411 F.2d 1246 (U.S. Ct. Cl. 1969).

most architectural contracts include provisions whereby the architect retains ownership in the plans and specifications,⁶ such provisions only partially avoid the above result. This mere partial avoidance stems from the fact that the standard provisions do not extend beyond ownership of the plans and specifications to encompass rights in the design itself.⁷ The plans and the design constitute two distinct entities each of which must be protected separately. The design is the creative concept manifested in the completed structure, while the plans are merely one method of describing that design. It is thus possible to reproduce a design by copying the completed building without any assistance from the original plans themselves. Under the standard clause, therefore, a client charged with a breach of contract through misappropriation and second use could defend by asserting he copied the building only and not the specific plans.

While all of the reasons for the above described limitation in the standard contractual provisions are not completely clear, two may be readily suggested. First, the draftsmen may have wished to avoid the drafting difficulties inherent in attempting to delineate and define the exact features of an architectural design and to circumscribe the limits of possible ownership therein. Second, such contracts are normally subject to hard bargaining between knowledgeable parties and any vagueness resulting from an attempted extension of such provisions to encompass the architectural design could be considered unacceptable by clients fearful of overreaching on the part of the architect, as well as possible subsequent exposure to costly and technical litigation.

Of course, the most severe limitation on the use of contractual provisions to provide a basis for remedies for misappropriation of the architect's product is that their applicability, and therefore their effectiveness, is limited to the parties to the contract.⁸ Since the architect and

6. See, e.g., the provision excerpted from the American Institute of Architects Standard Form Contract in note 7 *infra*. Architects who are members of the American Institute of Architects will ordinarily use one of the standard A.I.A. contracts or suitably adapt one to suit the special needs of their practice.

7. The American Institute of Architects publishes three standard form contracts entitled "Standard Form of Agreement Between Owner and Architect" differing only in the form of remuneration specified. See, e.g., A.I.A. Documents B131, B231, and B331, all April, 1970 Editions. All three contain the following clause:

Article 9—Ownership of Documents

Drawings and Specifications as instruments of service are and shall remain the property of the Architect whether the Project for which they are made is executed or not. They are not to be used by the Owner on other projects or extensions to this project except by agreement in writing and with appropriate compensation to the Architect.

8. See generally, 17 AM. JUR. 2d *Contracts* § 294 (1965): "As a general thing, the obligation of contracts is limited to the parties making them, and, ordinarily, only those

his client cannot by agreement bind third parties, such protection as is afforded by virtue of the instrument is completely ineffectual against third parties who misappropriate the plans and specifications, the design, or both.

2. Common Law Copyright

Even prior to the adoption of a federal copyright statute,⁹ there existed the English common law concept that the creator of a literary or artistic work had, *prior to publication*, certain rights in his product.¹⁰ These rights continue to exist today and, although now guaranteed by statute in many jurisdictions,¹¹ they are still generally referred to as "common law copyright."

In general, the author of an unpublished work has the exclusive right to its initial publication as well as the right to prevent anyone else from using or profiting from it prior to publication.¹² To qualify for this protection afforded by the common law copyright concept, it is essential that an idea be reduced to a tangible form since there is no protection afforded mere ideas, either before or after publication.¹³ In addition, the tangible form must be original.¹⁴ Originality, in this context, merely requires that the creator not have copied the work.¹⁵ Thus, a creation can be identical to someone else's prior work and the creator still obtain protection as long as he arrived at his creation independently.¹⁶

The protection of common law copyright, however, vanishes upon publication.¹⁷ Any rights the creator may have will then terminate un-

who are parties to contracts are liable for their breach"; 17A C.J.S. *Contracts* § 520 (1963).

9. The first federal copyright statute was enacted in 1790. Act of May 31, 1790, ch. 15, 1 Stat. 124. The current statute is the federal Copyright Act, 17 U.S.C. § 1 *et. seq.* (1970).

10. See NIMMER, *supra* note 4, at §§ 1, 11.

11. See, e.g., CAL. CIV. CODE §§ 980-983 (West 1971).

12. CAL. CIV. CODE § 980 (West 1971); Estate of Hemingway v. Random House, Inc., 23 N.Y.2d 341, 296 N.Y.S.2d 771, 244 N.E.2d 250 (1968).

13. See NIMMER, *supra* note 4, at § 11.1; White-Smith Music Publishing Co. v. Apollo Co., 209 U.S. 1 (1908); Palmer v. DeWitt, 47 N.Y. 532 (1872). The advent of easily made tape recordings has caused reconsideration of this rule regarding ideas expressed orally. See, e.g., Estate of Hemingway v. Random House, Inc., 23 N.Y.2d 341, 296 N.Y.S.2d 771, 244 N.E.2d 250 (1968).

14. Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53 (1884).

15. See Amsterdam v. Triangle Publications, Inc., 189 F.2d 104 (3d Cir. 1951).

16. *Id.*

17. CAL. CIV. CODE § 983 (West 1971); NIMMER, *supra* note 4, at § 46; Wheaton v. Peters, 33 U.S. (8 Pet.) 591 (1834).

less replaced with the statutory rights granted by the federal Copyright Act.¹⁸ Such rights normally arise only upon publication.¹⁹ The concept of publication is thus crucial to both common law and federal statutory copyright. That concept, however, under common law copyright is vastly different from the concept of publication under the federal Copyright Act. In the common law copyright context, any act which evidences the proprietor's intention to dedicate the work to general use by the public constitutes its publication.²⁰ In contrast, publication as contemplated in the federal Copyright Act is a formalistic event necessary to obtain the statutory protections and is rigorously defined by the statute itself.²¹ Clearly, it is possible to have one kind of publication without the other.

Since the rights guaranteed by common law copyright are based on the common law or, in some jurisdictions, a state statute, they are generally enforced in state rather than federal courts.²² In the literary and artistic fields, the courts have generally preferred to adopt a construction of the concept of publication which favors the creator over those who would exploit his work without authorization.²³ Under such judicial interpretation, it is recognized, for example, that performance of a dramatic production is not a publication of the script or stage direction.²⁴ Therefore, the author of a play may cause it to be performed again and again without a publication taking place and his common law copyright may thus be of perpetual duration. Of

18. See text accompanying notes 77-83 *infra*.

19. 17 U.S.C. § 10 (1970).

20. See NIMMER, *supra* note 4, at § 46; *White v. Kimmell*, 193 F.2d 744 (9th Cir. 1952).

21. See text accompanying notes 78-83 *infra*. See generally, *Uneeda Doll Co. v. Goldfarb Novelty Co.*, 373 F.2d 851 (2d Cir. 1967), *cert. dismissed*, 389 U.S. 801 (1967); *Sieff v. Continental Auto Supply*, 39 F. Supp. 683 (D. Minn. 1941).

22. Rights granted under statutory copyright are enforced according to 28 U.S.C. § 1338(a) (1970) which provides:

The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents . . . [and] copyrights. Such jurisdiction shall be exclusive of the courts of the states in patent and copyright cases.

Common law copyright, not being granted by Act of Congress, does not come within this clause and therefore can be enforced in state courts.

23. See, e.g., *American Visuals Corp. v. Holland*, 239 F.2d 740 (2nd Cir. 1956). Courts adopt this construction because the penalty for publications which do not qualify for federal statutory copyright is the irrevocable "dedication" of the work to the public. NIMMER, *supra* note 4, at § 82. See also, *National Comics Publications v. Fawcett Publications*, 191 F.2d 594 (2d Cir. 1951); *Irving J. Dorfman Co. v. Borlan Industries, Inc.*, 309 F. Supp. 21 (S.D.N.Y. 1969); *Klasmer v. Baltimore Football, Inc.*, 200 F. Supp. 255 (D. Md. 1961).

24. *Ferris v. Frohman*, 223 U.S. 424 (1912).

course, he must publish the script to enable the actors in the play to learn their parts and to enable the play itself to be produced. This, however, is considered a "limited" publication, limited both as to the persons to whom and the purposes for which it is made. Such a limited publication is held not to divest the author of his common law rights as would a "general" publication.²⁵

If the courts were to hold construction of a building to be analogous to the performance of a play, the architect would be protected in perpetuity. Use of the plans in the construction would merely constitute a limited publication. However, the law has traditionally taken a harsher view with respect to architectural plans and, until recently, virtually all authority held that various ordinary activities basic to the utilization of such plans resulted in publication. For example, in *Kurfiss v. Cowherd*²⁶ and *Gendell v. Orr*²⁷ it was held that publication of the plans occurred whenever a building was constructed from them and placed on public view.²⁸ An early New York case took a still harsher view. In *Wright v. Eisle*,²⁹ plans for the construction of a house were held to be published upon their being filed with the local building department,³⁰ notwithstanding the fact that such filing was a prerequisite to the attainment of a building permit.³¹

If the above views uniformly prevailed today,³² common law copyright would be virtually non-existent as a remedy for the protection of architectural plans, because publication would always be deemed to occur prior to the time when protection would be most needed, namely, subsequent to any initial use of the plans. Fortunately for architects and builders, however, there have been recent and substantial departures from these views in a number of significant cases. In the leading case of *Smith v. Paul*³³ a California court of appeal reviewed a suit by an architect against a builder who had constructed

25. *White v. Kimmell*, 193 F.2d 744, 746-47 (9th Cir. 1952); *Werckmeister v. American Lithographic Co.*, 134 F. 321, 324 (2d Cir. 1904).

26. 121 S.W.2d 282 (Mo. Ct. App. 1938).

27. 13 Phila. 191 (Pa. Common Pleas 1879).

28. *Kurfiss v. Cowherd*, 121 S.W.2d 282, 288 (Mo. Ct. App. 1938); *Gendell v. Orr*, 13 Phila. 191, 192 (Pa. Common Pleas 1879).

29. 83 N.Y.S. 887 (App. Div. 1903).

30. *Id.* at 889.

31. *Id.*

32. For recent cases upholding the *Kurfiss* and *Gendell* views see *Tumey v. Little*, 186 N.Y.S.2d 94 (Sup. Ct. 1959) and *DeSilva Construction Corp. v. Herral*, 213 F. Supp. 184 (M.D. Fla. 1962); see *contra* *Shaw v. Williamsville Manor, Inc.*, 330 N.Y.S.2d 623 (App. Div. 1972).

33. 174 Cal. App. 2d 744, 345 P.2d 546 (1959).

an unauthorized house from plans prepared by the architect. The court considered the *Kurfiss*, *Gendell* and *Wright* cases and concluded that they had been erroneously decided.³⁴ With respect to the holding in *Wright*, the court stated that the filing of plans with a municipal building department should be at most a "limited publication",³⁵ because the municipality ought to make such plans available only for purposes relevant to the intent of the filing requirement, namely, to assure compliance with the housing and building codes.³⁶ The court noted that the Los Angeles ordinance which provided for the filing of such plans expressly excluded them from the category of public records and from unlimited public examination.³⁷ With respect to the *Kurfiss* and *Gendell* holdings, the *Smith* court concluded that a completed structure is no more a *copy* of the plans than the exhibition of an uncopyrighted motion picture is a copy of the film or the performance of an uncopyrighted radio script a copy of the script.³⁸ Noting that neither of these types of performances are held to constitute publications of the underlying material,³⁹ the court held that construction of the house did not constitute a general publication of the plans.⁴⁰

The factual circumstances in *Smith* were singularly well-suited to engender this result. The plans were for a custom home for a single client, there was no promotional effort associated with the construction and sale, and, by express provision in the architect-client contract, the architect retained all rights in the plans except for the limited use necessary for construction of the house.⁴¹ In short, aside from the filing of the plans with the municipal building department and the actual construction of the house itself, there was nothing which could be said to evidence an intent on the part of the architect to "dedicate the work to general use by the public"⁴² and to thereby constitute publication.

Smith was the principal authority relied upon by a Massachusetts court in the case of *Edgar H. Wood Associates, Inc. v. Skene*.⁴³ The

34. *Id.* at 758, 345 P.2d at 555.

35. See text accompanying note 25 *supra*.

36. 174 Cal. App. 2d at 751-752, 345 P.2d at 551.

37. LOS ANGELES CAL. CITY BUILDING CODE § 91.0211(f) (1952). 174 Cal. App. 2d at 752, 345 P.2d at 551.

38. 174 Cal. App. 2d at 755-56, 345 P.2d at 553.

39. *Id.*; cf. *Ferris v. Frohman*, 223 U.S. 424 (1912).

40. 174 Cal. App. 2d at 758, 345 P.2d at 555.

41. *Id.* at 756, 345 P.2d at 554.

42. See text accompanying note 20 *supra*.

43. 197 N.E.2d 886 (Mass. 1964).

Wood court not only affirmed the reasoning of *Smith* but extended it to encompass a fact situation involving the plans and design of an apartment building, notwithstanding the fact that buildings of this type are ordinarily put on display and thus exposed to inspection by a substantial segment of the general public, namely, the general class of potential tenants.⁴⁴ In *Wood*, as in *Smith*, the architect retained all rights in his plans, merely licensing the client to use the plans in the construction of the particular building.⁴⁵ In finding a cause of action against another builder who had obtained a set of plans from a subcontractor of the architect's client and who then proceeded to erect a nearly identical building in an adjacent town, the court held neither the filing of the plans with the municipal building department nor the construction and display of the building constituted a general publication.⁴⁶ The court further stated that the structure itself did not constitute a copy of the plans, but was only a result of their use.⁴⁷ Therefore, no matter how widespread the exposure to public view, there could be no publication of the plans from the construction of the building itself.⁴⁸ Such a conclusion, however, raised a logical problem. If the building itself is not a copy of the plans but has its own independent existence, then the building itself is not protected by the common law copyright. It thus follows, and the court so noted, that there is no infringement of a common law copyright by a person who makes a new set of plans by copying the structure itself through the observation and measurement of its interior and exterior.⁴⁹ Thus, it is only the use of the plans themselves which constitutes an infringement. This may be considered analogous to the interpretation that there is no copyright in the performance of a copyrighted work such as the musical performance of a copyrighted score.⁵⁰

44. *Id.* at 888-89.

45. *Id.* at 888.

46. *Id.* at 893, 895.

47. *Id.* at 895, quoting Katz, *Copyright Protection of Architectural Plans, Drawings, and Designs*, 19 LAW & CONTEMP. PROB. 224, 236 (1954).

48. *Id.* at 893, quoting *Smith v. Paul*, 174 Cal. App. 2d 744, 345 P.2d 546 (1959).

49. *Id.* at 895.

50. Although Chapter 1, § 1 of the Copyright Act, 17 U.S.C. §§ 1(d)-(e) (1970), gives the copyright proprietor the *exclusive* right to perform a copyrighted drama or a copyrighted musical composition, this right is limited to a performance based upon the copyrighted embodiment, *i.e.*, the script or score. If the actors in a play memorize the copyrighted script, there is authority that they may then perform the play without authority from the owner of the copyright; see *Shook v. Rankin*, 21 F. Cas. 1337 (No. 12,805) (C.C.D. Minn. 1875). Closer to home are holdings that the copyright owner does not have an exclusive right to mechanical reproduction (*i.e.*, recording) of the performance of his play or music even though a royalty of 2¢ per copy is due

In 1964, the California courts had the opportunity to reassess the scope of the holding in *Smith*. The case in which this opportunity arose, however, presented a fact situation involving conduct on the part of the creating architect so diametrically opposed to that of his counterpart in *Smith* that a finding of publication seemed almost compelled. In *Shanahan v. Macco Construction Co.*,⁵¹ the plaintiff, relying on *Smith*, attempted to recover damages from the defendant for use of his floor plans in defendant's tract home developments.⁵² The court refused to apply the reasoning of *Smith*, distinguishing that case and limiting the holding narrowly to its facts.⁵³ In *Shanahan* both parties to the suit were major merchant-builders in Southern California. The plaintiff had used the plans in question to build 1,435 homes, almost all of which had been sold at the time of trial. Further, he had distributed 30,000 brochures containing the floor plans and elevations, invited the general public to visit his model homes—an invitation which was accepted by 60,000 persons, entered the plans in a contest and allowed them to be included in an issue of a magazine with a circulation in excess of 100,000, made available in his tract offices detailed plans with no supervision or restriction on use for persons to examine in detail and copy dimensions from, given permission to another builder, not a party, to build from his plans, and, lastly, had 250 sets of detailed plans made of which only three could be accounted for at the time of trial.⁵⁴ The court held that these actions on the part of the builder evidenced an intent to surrender all common law copy-right to the plans and thus constituted a voluntary publication.⁵⁵ More-

him under 17 U.S.C. § 1(e). *Edward B. Marks Music Corp. v. Foulton*, 79 F. Supp. 664, 666 (S.D.N.Y. 1948), *aff'd*, 171 F.2d 905 (1949). *See also*, *Metropolitan Opera Ass'n v. Wagner-Nichols Recording Co.*, 101 N.Y.S.2d 483 (Sup. Ct. 1950), *aff'd*, 107 N.Y.S.2d 795 (App. Div. 1951) (no copyright protection in the broadcast performances so plaintiff compelled to turn to state unfair competition remedies for the unauthorized recording for profit of his broadcasts). Only in 1971 was the federal Copyright Act amended to give copyright protection to sound recordings. Act of October 15, 1971, Pub. L. No. 92-140, § 1(a), 85 Stat. 391, *amending* 17 U.S.C. § 1(f).

51. 224 Cal. App. 2d 327, 36 Cal. Rptr. 584 (1964).

52. *Id.* at 329, 335, 36 Cal. Rptr. at 584-85, 588.

53. *Id.* at 336-38, 36 Cal. Rptr. at 589-90.

54. *Id.* at 330-32, 36 Cal. Rptr. at 585-86.

55. *Id.* at 339, 36 Cal. Rptr. at 590. *Compare* *NUCOR Corporation v. Tennessee Forging Steel Service, Inc.*, 339 F. Supp. 1305, 1308-09 (W.D. Ark. 1972), wherein it was held that the totality of the evidence taken as a whole compelled the conclusion that plaintiff had no intention of claiming any copyright, common-law or statutory, prior to the suit and that a general publication of the plan was made by (1) the unrestricted distribution of 30 sets of plans to bidders on the construction of the building, (2) permitting all interested persons to see, visit and inspect the building during construction and while in operation after completion, (3) the publishing of

over, with respect to the exteriors of the homes, the court erroneously interpreted *Smith* as having approved the view⁵⁶ that plans of exteriors are published upon construction because of the attendant exposure to passersby.⁵⁷

It appears that *Smith* was further limited by the 1966 case of *Read v. Turner*.⁵⁸ In *Read*, the plaintiff builder had conceived the plans himself and constructed a home originally intended for his private use. The defendant, Read's cement contractor, who had not been expressly forbidden to copy the plans, did in fact do so and later constructed ten homes based upon them.⁵⁹ Two of these homes were constructed on the same block as plaintiff's. Plaintiff, however, subsequently placed his home for sale with a broker who was one of seven hundred and fifty broker-members of a multiple listing service. This resulted in substantial public showings of the house.⁶⁰ Further, the plaintiff gave the ultimate purchaser an "unrestricted" set of plans.⁶¹ These acts were held to constitute a general publication of the plans.⁶² As a result, plaintiff was allowed to recover only those damages suffered prior to the acts deemed to constitute the publication. *Smith* was expressly distinguished on three grounds. First, it was concluded that *Smith* involved a "total architectural design" as opposed to a mere floor plan as in *Read*, the court taking the position that the former is not so evident upon inspection of the completed structure as the latter.⁶³ Second, the court noted that in *Smith* the creator of the design had expressly retained its ownership whereas in *Read* it appeared that he gave the plans and all rights therein to the buyer of the house.⁶⁴

photographs of the new building in the corporation's annual report, and (4) failing to mark the plans "confidential" or to take measures to assure their return.

56. See text accompanying notes 27-28 *supra*.

57. 224 Cal. App. 2d at 337, 36 Cal. Rptr. at 589. A careful reading of the *Smith* opinion clearly demonstrates the erroneous nature of such an interpretation. Although the *Smith* court did in fact discuss the view described in the text (174 Cal. App. 2d at 756, 345 P.2d at 533), it expressly stated its disapproval thereof holding that:

When an architect builds a structure, it is somewhat similar to the author publishing a book. The structure is present for the public to see. . . . [T]he exterior is copyable by anyone with sufficient draftsmanship qualities. But . . . *it is not a general publication of the detailed plans themselves*. 174 Cal. App. 2d at 758, 345 P.2d at 555 (emphasis added).

58. 239 Cal. App. 2d 504, 48 Cal. Rptr. 919 (1966).

59. *Id.* at 507-08, 48 Cal. Rptr. at 921-22.

60. *Id.* at 508, 48 Cal. Rptr. at 922.

61. *Id.*

62. *Id.* at 512, 48 Cal. Rptr. at 924.

63. *Id.* at 512, 48 Cal. Rptr. at 924-25.

64. *Id.* at 512, 48 Cal. Rptr. at 925.

Finally, the court pointed out that *Smith* involved no public showing of the house prior to sale.⁶⁵ *Read* is not as clearly a merchant-builder case as *Shanahan*,⁶⁶ but it is apparent that the critical fact which they share in common is the public display for sale of the completed house. While the dichotomy between *Smith* and *Shanahan* was extreme, the difference between *Read* and *Smith* appears to lie only in the bare display for sale. The *Read* court, in justifying its position, stated that:

. . . [A] design may be expressed by incorporating it in a structure as well as by incorporating it in a drawing. . . . [T]he floor plan . . . readily was observable by those to whom the exhibition was made. Such an exhibition constituted a publication of the plan.⁶⁷

This appears to be diametrically opposed to the analytical principal, enunciated in *Smith*, that construction of the structure does not publish the plans,⁶⁸ as well as to that enunciated in *Wood*, that the structure only publishes itself—*i.e.*, a copy of the structure is permitted so long as the plans themselves are not copied.⁶⁹

The effect of the above cases has been to limit the holding in *Smith* to the precise facts of that case: the granting of a license of narrow scope by one who retains all rights in the plans and design for the building of an individual home for a particular client wherein interior viewing is restricted to a very limited number of persons. With the relatively minor exception of this particular fact situation, the results in *Shanahan* and *Read* come very close to returning California to the early traditional view of the *Kurfiss* and *Gendell* cases.⁷⁰

Some jurisdictions have continued to follow the more liberal approach of *Smith* and *Wood*. In *Ashworth v. Glover*,⁷¹ for example, the architect-plaintiff had designed a drive-in restaurant for his client under a contract which provided that the plans and copies thereof were to remain the property of the architect and were not to be used on any other but the completed project.⁷² An employee of the client permitted the

65. *Id.*

66. Shanahan constructed 1,435 homes in five subdivisions from his plans during 1957-1960. 224 Cal. App. 2d at 329, 36 Cal. Rptr. at 584-585. Read built only one house and Turner and his controlled companies constructed only ten houses from Read's plans. 239 Cal. App. 2d at 507-08, 48 Cal. Rptr. at 921-22.

67. 239 Cal. App. 2d at 513, 48 Cal. Rptr. at 925.

68. See text accompanying notes 38-40 *supra*.

69. See text accompanying notes 43-50 *supra*.

70. See text accompanying notes 26-28 *supra*.

71. 433 P.2d 315 (Utah 1967).

72. *Id.* at 317.

defendant to copy the plans, from which copy the defendant proceeded to erect a similar building on the same highway seventeen miles away.⁷³ Photographs of both buildings are included in the appellate reports,⁷⁴ and it is clear from the photographs that one is a copy of the other. There are, however, enough minor dissimilarities to support an inference that only the building was copied and not necessarily the plans. The court permitted a recovery by the plaintiff, however, without expressly making that distinction.⁷⁵ No publication was found in the filing of the plans, in their being put out for bids, or in the actual construction of the building.⁷⁶

It is clear that the law concerning common-law copyright of architectural plans is in a state of flux. While it is probable that no state would today concur with the holding that the filing of plans with a building department for the purpose of obtaining a permit constitutes their publication, California and other jurisdictions following the rationale of *Read* would, however, find publication in the construction of a building with its subsequent exposure to the public. These same jurisdictions would similarly hold that after construction any person could observe, measure and copy the completed building itself without incurring liability for infringement. In sum then, common law copyright, while potentially a most effective remedy for the misappropriation of architectural plans and designs, could only be of real value in those jurisdictions which adopt and follow the reasoning of cases like *Smith*, *Wood* and *Ashworth*. Unfortunately for the architect, these three cases represent a distinctly minority view.

3. *The Federal Copyright Act*

The remedy presently afforded persons protected under the statutory federal Copyright Act⁷⁷ is more clearly defined than that afforded

73. *Id.*

74. *Id.* at 318.

75. *Id.* at 319; *cf.* *Vic Alexander & Assoc. v. Cheyenne Neon Sign Co.*, 417 P.2d 921 (Wyo. 1966), wherein the court was faced with this same general problem but appears to have considered it immaterial. A sign company that had designed and constructed a large, ornate, illuminated sign for a merchant was able to recover damages on a common law copyright theory when the merchant contracted for another party to copy the sign for his branch store in another city. The second sign was admittedly of such different size and proportions that it certainly was not constructed from the plans prepared for the first sign. The court did not find it necessary to consider whether the plans for the second sign were based on the plans for the first sign or on the first sign itself, and held defendant liable.

76. 433 P.2d at 319.

77. 17 U.S.C. § 1 *et. seq.* (1970).

under common law copyright, although the obstacles to effective protection are substantially greater under the Act. In order to obtain the benefits and protection provided by the Copyright Act, it is necessary to observe certain formalities in connection with the initial publication of the work.⁷⁸ Adherence to the statute requires that a notice of copyright must be placed on each plan or drawing prior to any act that might be construed as a publication of the plans,⁷⁹ preferably before the vellum leaves the drafting table. The notice must consist of either the word "Copyright", the abbreviation "Copr.," or the symbol "©", accompanied by the name of the copyright proprietor and the year in which the copyright was secured.⁸⁰ Copyright is secured by publication with notice; however, promptly thereafter two complete copies of the work should be sent to the Register of Copyrights together with an affidavit of application for copyright registration.⁸¹ Should publication occur absent compliance with these notice requirements, the work will be deemed to have been dedicated by the publication and no curative act can thereafter recover the statutory rights lost.⁸² More-

78. See 17 U.S.C. §§ 10, 19-21 (1970).

79. 17 U.S.C. § 10 (1970); *Dejonge & Co. v. Breuker & Kessler Co.*, 235 U.S. 33, 36 (1914); *Mifflin v. Dutton*, 190 U.S. 265, 266 (1903). See also *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 740-41 (9th Cir. 1971). 17 U.S.C. § 10 is to be construed both liberally and realistically to be consonant with ordinary business practices. See *Irving J. Dorfman Co. v. Borlan Industries, Inc.*, 309 F. Supp. 21, 24 (S.D.N.Y. 1969); *Peter Pan Fabrics, Inc. v. Acadia Co.*, 173 F. Supp. 292, 305 (S.D.N.Y. 1959), *aff'd sub nom. Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960).

80. 17 U.S.C. § 19 (1970). This section is to be liberally construed. *Uneeda Doll Co. v. Goldfarb Novelty Co.*, 373 F.2d 851, 854 (2d Cir. 1967), *cert. dismissed*, 389 U.S. 801 (1967). The purpose of the notice required by §§ 10 and 19 is to afford to those who might innocently infringe notice that copyright is claimed and by whom. *Glenco Refrigeration Corp. v. Raetone Commercial Refrigerator Corp.*, 149 F. Supp. 691 (E.D. Pa. 1957). However, there must be substantial compliance with the notice requirements if a copyright is to be preserved. *Davis v. DuPont de Nemours & Co.*, 240 F. Supp. 612, 625 (S.D.N.Y. 1965); *Inter-City Press, Inc. v. Siegfried*, 172 F. Supp. 37, 40 (W.D. Mo. 1958). See also *American Code Co. v. Bensinger*, 282 F. 829, 836 (2d Cir. 1922). *But see Group Publishers v. Winchell*, 86 F. Supp. 573, 576 (S.D.N.Y. 1949).

81. 17 U.S.C. §§ 11, 13, 14, 15 (1970); *G.P. Putnam's Sons v. Lancer Books, Inc.*, 251 F. Supp. 210 (S.D.N.Y. 1966); *Fader v. Twentieth Century Fox Film Corp.*, 169 F. Supp. 880 (S.D.N.Y. 1959). Delay, however, is not necessarily fatal, *Frederick Chusid & Co. v. Marshall Leeman & Co.*, 326 F. Supp. 1043, 1063-1064 (S.D.N.Y. 1971), although it does bar any recovery for infringement occurring prior to filing. *Dan Kasoff, Inc. v. Palmer Jewelry Mfg. Co.*, 171 F. Supp. 603, 606 (S.D.N.Y. 1959); *Silvers v. Russell*, 113 F. Supp. 119, 121 (S.D. Cal. 1953).

82. *American Code Co. v. Bensinger*, 282 F. 829, 833 (2d Cir. 1922); *Davis v. DuPont de Nemours & Co.*, 240 F. Supp. 612, 625 (S.D.N.Y. 1965); *Inter-City Press Co. v. Siegfried*, 172 F. Supp. 37, 40 (W.D. Mo. 1958); *Group Publishers v. Winchell*, 86 F. Supp. 573, 577 (S.D.N.Y. 1949). The Act does, however, provide for

over, the publication made in the attempt to qualify the endeavor for the statutory protection will normally constitute a sufficient publication to destroy the common law copyright theretofore enjoyed by the creator.⁸³

It would appear from the wording of the statute that architectural plans could, for copyright purposes, conceivably be classified under section 5 of the Act, which affords protection to "models or designs for works of art"⁸⁴ and "[d]rawings or plastic works of a scientific or technical character."⁸⁵ As a practical matter, however, it would matter little which classification is considered applicable since the rights guaranteed by the Act cannot be sufficiently broadened to insure adequate protection for the architect.

Section 1 of the Copyright Act lists the rights protected under the statute:

Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right: (a) To print, publish, copy, and vend the copyrighted work; (b) . . . to complete, execute, and finish it if it be a model or design for a work of art⁸⁶

The protection afforded by section 1(a) ostensibly prevents anyone from directly copying the plans. In order to prove copying, a party must ordinarily show (1) actual or implied access to the thing alleged to have been copied, (2) similarity and (3) appropriation of something of value.⁸⁷ Since there is no protection afforded the building itself

registering a limited class of unpublished works not reproduced for sale such as a lecture or dramatic script. 17 U.S.C. § 12 (1970); *King v. Mister Maestro, Inc.*, 224 F. Supp. 101 (S.D.N.Y. 1963). Unless and until the doctrine of *Smith v. Paul* (see text accompanying notes 33-40 *supra*) is accepted, however, this provision is of no value to the architect.

83. NIMMER, *supra* note 4, at § 82.

84. 17 U.S.C. § 5(g) (1970). Section 5 requires that the application for copyright registration specify to which of several enumerated classes the work belongs, but goes on to state, "The above specifications shall not be held to limit the subject matter of copyright . . . nor shall any error in classification invalidate or impair the copyright protection secured under this title."

85. 17 U.S.C. § 5(i) (1970). The regulations of the Copyright Office expressly include "an architect's blueprint as a work registerable within this class." 37 C.F.R. § 202.12(a) (1972).

86. 17 U.S.C. §§ 1(a)-(b) (1970).

87. Access: *Williams v. Kaag Mfrs., Inc.*, 338 F.2d 949, 951 (9th Cir. 1964); *Blumcraft of Pittsburgh v. Newman Bros., Inc.*, 373 F.2d 905, 907 (6th Cir. 1967); *Bevan v. Columbia Broadcasting System, Inc.*, 329 F. Supp. 601, 604 (S.D.N.Y. 1971). Similarity: *Williams v. Kaag Mfrs., Inc.*, *supra*, at 951; *Heim v. Universal Pictures Co.*, 154 F.2d 480, 487 (2nd Cir. 1946). Appropriation of something of value: *Bradbury v. Columbia Broadcasting System, Inc.*, 287 F.2d 478, 485 (9th Cir. 1961), *cert. dismissed*, 368 U.S. 801 (1962); *Columbia Pictures Corp. v. Nat'l Broadcasting Co.*,

under the Act,⁸⁸ the infringer need only allege in defense that he did not copy the plans but rather drafted his own plans from observations and measurements of the completed building. This would establish a prima facie defense on the issues of access and similarity in cases in which the building was open to public view. In fact, it is common trade practice for merchant-builders to intensively comparison shop each other's projects and to copy every innovation of note. Thus, although the protection of section 1(a) might be applicable to a monumental project which, by its very nature, is likely to be built only once, it is of little value to a client-related project in which the building will be open to public view and of no utility whatsoever to the merchant-builder because his volume and promotional efforts are likely to assure access by large numbers of people, including his competitors. With respect to the protection afforded under section 1(b) (which grants the exclusive right to execute a design for a work of art), even assuming such protection could be said to extend to and encompass architectural plans,⁸⁹ it would appear at best to guarantee merely the right to make a first construction from such plans.⁹⁰ Since copying and appropriation do not usually take place until the merits of the design are clearly evident to third parties who have observed the completed building, such protection would be illusory.

In light of the above, it would thus appear that the only possible recovery under the Copyright Act would be for the convenience value to the infringer of being able to copy the plans as opposed to having to measure the building and draft his own plans.⁹¹ However, even

137 F. Supp. 348, 353 (S.D. Cal. 1955); *Markham v. A.E. Borden Co.*, 108 F. Supp. 695, 707 (D. Mass. 1952), *rev'd on other grounds*, 206 F.2d 199 (1st Cir. 1953).

88. This must be inferred from the text of 17 U.S.C. § 1 (1970) and the filing and registration requirements. See *DeSilva Constr. Corp. v. Herrald*, 213 F. Supp. 184, 195 (M.D. Fla. 1962). The author is unaware of any attempt to copyright a building, but there is a policy of excluding items which are primarily utilitarian and not works of art or models or designs thereof; see, e.g., *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958) (wrist watch); *Kemp & Beatley, Inc. v. Hirsch*, 34 F.2d 291 (E.D.N.Y. 1929) (dress patterns); cf. *Stein v. Mazer*, 204 F.2d 472 (4th Cir. 1953), *aff'd*, 347 U.S. 201 (1954) (approving copyright of ceramic lamp bases sculpted in the form of dancing figures as works of art).

89. See note 88 *supra*.

90. Cf. *Green v. Luby*, 177 F. 287 (C.C.S.D.N.Y. 1909); *Underhill v. Schenck*, 187 N.Y.S. 589 (Sup. Ct. 1921).

91. Cf. *Oakes v. Suelynn Corp.*, 24 Cal. App. 3d 271, 100 Cal. Rptr. 838 (1972). The holding in *Oakes* is probably of general significance even though the rights asserted therein were based on common law rather than statutory copyright. Plaintiff-architect had drawn plans for the conversion of a ferryboat into a restaurant. After

this rather limited form of recovery may, in practice, prove to be unobtainable; for the plaintiff is unlikely to have direct evidence of copying, and proof based upon similarity is likely to be virtually impossible, given the availability of the building itself.

It should be readily apparent from the foregoing that the Copyright Act, in its present form, is of little or no value with respect to the protection of architectural design. It would appear that effective protection could be achieved, however, by amending the Act to enhance the existing protection against the actual copying of copyrighted plans by expressly (1) reposing in the proprietor of such plans the exclusive right to erect structures from them; and (2) legislatively overruling the approach taken in *Wood, supra*, that a copy made from a structure itself is permissible even where this results in the attainment of plans identical to the originals.⁹² The result of such an amendment would be to afford architectural plans protection analogous to that furnished dramatic works under section 1(d) which affords the exclusive right "[t]o perform . . . the copyrighted work publicly if it be a drama. . . ."⁹³ The author of a dramatic work, prior to a general publication, retains his common law rights indefinitely since performance of the play and any incidental publications are deemed only "limited" publications.⁹⁴ Section 1(d) of the Copyright Act continues this protection even after a general publication.⁹⁵ Thus, when a printed script and stage directions are sold at a book store, for example, the sale does not carry with it the right to use that script to perform the play.⁹⁶ Furthermore,

the client's bankruptcy, the ferryboat was sold to defendant who converted it into an office building. He admitted using the plaintiff's plans to determine the internal dimensions and structure of the ferryboat. The court denied the architect any recovery, holding that he had no protectable interest in the measurements of the existing structure, that there was no conversion of the plans, and no appropriation of his creative design.

92. An express prohibition of this interpretation would have to be included to prevent the district courts from following this holding of *Wood* and thereby negating the effect of the first portion of the proposed amendment. The amendment would prevent the recurrence of such holdings as that of *DeSilva Constr. Corp. v. Herralld*, 213 F. Supp. 184 (M.D. Fla. 1962), in which a district court not only followed *Wood* but went further holding that statutory copyright does not prevent copying the building but only forbids copying the plans, that statutory copyright does not prevent *use* of the plans in the construction of a building, and that there are no "performance rights" in the architect under the Copyright Act to build exclusively from the plans. *Id.* at 195.

93. 17 U.S.C. § 1(d) (1970).

94. See text accompanying notes 24-25 *supra*.

95. 17 U.S.C. § 10 (1970); see *Hirshon v. United Artists Corp.*, 243 F.2d 640 (D.C. Cir. 1957); *Ross Products, Inc. v. New York Merchandise Co.*, 233 F. Supp. 260 (S.D.N.Y. 1964).

96. *Green v. Luby*, 177 F. 287 (C.C.S.D.N.Y. 1909); 17 U.S.C. § 1(d) (1970).

it is settled that in an infringement suit the trier of fact may find that an adaptation from a dramatic performance is a copy even though it differs from the original script in many important details.⁹⁷

The enactment of such an amendment, while conceivable, could well face a serious impediment in the form of a well established concept which has traditionally limited the scope of protection afforded under the Copyright Act. This is the concept that the copyright of a book, magazine article, play, etc., does not encompass the ideas contained therein but only that particular expression of those ideas.⁹⁸ In the leading case involving this concept, *Baker v. Selden*,⁹⁹ plaintiff had written and caused to be published a copyrighted book in which he described a novel and unique accounting system which he had invented.¹⁰⁰ The defendant had written another book expounding precisely the same system and nearly duplicating the special forms published in plaintiff's book which were requisite to the use of that system.¹⁰¹ The United States Supreme Court held this to constitute no infringement of the copyright on the ground that only the plaintiff's particular mode of expression was protected under the Copyright Act, not the concepts or ideas contained therein.¹⁰² The Court found that since the use of the nearly identical forms was *required* for execution of the concept by defendant, he was entitled to *actually copy them, if need be*, because to hold otherwise would effectively prevent him from presenting his own mode of expression of the unprotected concept.¹⁰³ The applicability of

97. This would have to be true to support actions based on similarity such as *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930), and *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49 (2d Cir. 1936).

98. *See, e.g.*, *Baker v. Selden*, 101 U.S. 99, 100-01 (1880) (discussed in text accompanying notes 100-04 *infra*); *Scott v. WKJG Inc.*, 376 F.2d 467, 469 (7th Cir. 1967), *cert. denied*, 389 U.S. 832 (1967) ("[C]opyright protection does not extend to ideas, plots, dramatic situations and events. Rather, it is limited to the arrangement of words an author uses to express his ideas."); *Uneeda Doll Co. v. P & M Doll Co.*, 353 F.2d 788, 789 (2d Cir. 1965) ("[T]here can be no copyright on an 'idea' itself but only of the tangible 'expression' of the idea.").

99. 101 U.S. 99 (1880).

100. *Id.* at 100.

101. *Id.*

102. *Id.* at 104. *See also* *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741 (9th Cir. 1971); *Eichel v. Marcin*, 241 F. 404, 408-409 (S.D.N.Y. 1913), and cases cited in note 98 *supra*.

103. *Id.* at 101. *See also* *Becker v. Loew's, Inc.*, 133 F.2d 889 (7th Cir. 1943), *cert. denied*, 319 U.S. 772 (1943):

The object of copyright is to promote science and the useful arts. If an author, by originating a new arrangement and form of expression of certain ideas or conceptions, could withdraw these ideas or conceptions from the stock of materials to be used by other authors, each copyright would narrow the field of thought open for development and exploitation. . . . *Id.* at 891, quoting *Eichel v. Marcin*, 241 F. 404, 408 (S.D.N.Y. 1913).

the *Baker v. Selden* concept to copyrighted architectural plans is, at present, uncertain. This uncertainty stems from a disagreement among the circuits regarding the proper resolution of this precise issue.

The Sixth Circuit decision in *Scholz Homes, Inc. v. Maddox*¹⁰⁴ presents a striking demonstration of the effects of application of the concept to copyrighted architectural plans. The plaintiff in *Scholz* was a manufacturer and seller of prefabricated homes, which he sold to merchant-builders for resale after erection at their own job-sites.¹⁰⁵ Plaintiff operated over a multi-state area and thus desired to circulate the floor plan portion of the plans widely enough to establish an effective consumer-targeted promotional campaign. Aware that this course of conduct gave rise to serious vulnerability to unauthorized use of his plans by both competitors in the prefabricated home business and conventional job-site builders, plaintiff copyrighted both the plans themselves and the promotional literature in which the floor plan portion of plans was contained.¹⁰⁶ Notwithstanding these precautions, the district court's summary judgment for the defendant-infringer was upheld on two grounds. First, it was held that the promotional publication dedicated the *use* of the plans to the public since the copyright served only to protect the arrangement and configuration of the advertising brochure as such.¹⁰⁷ This holding, while not too clearly reasoned in the court opinion, is apparently bottomed on *Baker v. Selden*.¹⁰⁸ Second, *Baker v. Selden* was cited as direct authority for the court's justification of defendant's preparation of new plans, from either the brochure or sketches made from the completed house, on the ground that the copyright of the plans protects only that particular configuration of lines and marks and not the underlying concept, *i.e.*, the house itself.¹⁰⁹ Under this approach, the plans might be said to constitute a kind of "how to do it" guide, analogous to the book in *Baker v. Selden*, the house described in the plans being the concept analogous to the accounting system described in the book.

In the only other federal appellate court case in which this issue has

104. 379 F.2d 84 (6th Cir. 1967).

105. *Id.* at 85. The report of the case states only that the homes were offered for sale at builders' conventions. The facts regarding the operating procedures set forth in the text accompanying notes 105-07 *infra* are based on the personal knowledge of the author.

106. *Id.* at 85.

107. *Id.* at 87.

108. See text accompanying notes 99-103 *supra*.

109. 379 F.2d at 86-87.

been decided, *Imperial Homes Corp. v. Lamont*,¹¹⁰ the Fifth Circuit reached precisely the opposite result on facts nearly identical to those of *Scholz*.¹¹¹ In *Imperial*, it was held, first, that plaintiff did not, by reproduction (in his advertising brochure) of the floor plan from the copyrighted set of architectural drawings, waive or abandon the copyright right; and, second, that copying this reproduction would constitute an infringement of such copyright right.¹¹² With respect to the Supreme Court's decision in *Baker v. Selden*, the court stated:

[T]he court [in *Baker*] was concerned that copyright privileges might result in vesting exclusive use rights which only a patent could confer. We therefore interpret this decision as holding that a descriptive copyright may not extend an exclusive right to the use of the described art itself lest originality of description should preempt non-novel invention. Thus, no copyrighted architectural plans under § 5(i) may clothe their author with the exclusive right to reproduce the dwelling pictured. However, nothing in *Baker v. Selden* prevents such a copyright from vesting the law's grant of an exclusive right to make copies of the copyrighted plans so as to instruct a would be builder on how to proceed to construct the dwelling pictured.¹¹³

110. 458 F.2d 895 (5th Cir. 1972).

111. In *Imperial*, plaintiff, a merchant-builder as in *Scholz*, developed and copyrighted architectural plans for a specific style of residence. 458 F.2d at 896. Subsequently, model homes were constructed according to the design and opened to the public. *Id.* In addition, plaintiff prepared and distributed an advertising brochure containing only the floor plan from the complete set of architectural drawings. *Id.* The brochure itself was not copyrighted; however, it did state that plaintiff claimed a copyright on the floor plan exhibited therein. *Id.* Defendants visited plaintiff's model homes, obtained a copy of the brochure, and proceeded to develop a set of drawings illustrating the manner of constructing a residential dwelling intended to be substantially similar to that designed by the plaintiff. *Id.* at 897. The trial court found as a fact that defendants had not copied the full set of plaintiff's copyrighted plans in developing their own drawings; however, no finding was made as to whether defendants copied the floor plan exhibited in the brochure. *Id.*

112. 458 F.2d 895 at 897. The case was remanded for a finding on the issue of whether defendants in fact copied the floor plan exhibited in the brochure, or based their drawings only on observations and measurements of the model homes.

113. *Id.* at 899. The Fifth Circuit did not discuss the relevancy, if any, of the Supreme Court's holding in *Baker v. Selden* that, since the use of forms nearly identical to those used by plaintiff was required for execution of the concept by the defendant, he was entitled to actually copy them, if need be, because to hold otherwise would effectively prevent him from presenting his own mode of expression of the unprotected concept. 101 U.S. at 101. It would seem, however, that the actual copying of the original plans would not be necessary for another to put forth his own expression of the underlying concept (i.e., the design) embodied in such plans. This lack of necessity is due to the fact that one wishing to reproduce a completed structure in the architectural area is free to observe, measure and make his own plans from the structure itself. See text accompanying note 49 *supra* and note 115 *infra*.

Thus, in the Fifth Circuit's view, the *Baker v. Selden* concept has no applicability to copyrighted architectural plans. Under this view, while the plans might still be said to constitute a kind of "how to do it" (i.e., how to create the architectural concept embodied within them) guide, they do not constitute the only such guide and are on this ground clearly distinguishable from the book in *Baker*.¹¹⁴

It is clear from the above that while the circuits agree that the copyrighting of architectural plans does not prevent anyone from reproducing the concept (design) embodied therein,¹¹⁵ the existing decisions are in direct conflict as to the effect of a copyright on future reproduction of the plans themselves. Thus, any legislative expansion, along the lines suggested above, of the protection presently afforded under the Copyright Act will depend to a very great extent upon the view which Congress ultimately adopts with respect to the applicability of the *Baker v. Selden* concept to architectural plans.

4. *The Patent Act*

In light of the denial of effective protection under the Copyright Act, the architect might logically seek refuge under the provisions of the Patent Act.¹¹⁶ However, as will be demonstrated immediately below, there exists constraints which similarly hinder effective use of that statute for the protection of the architect's product.

Section 101 of the Patent Act provides that:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor¹¹⁷

While it is clear that a device used in the construction of a house can be patented and its unlicensed use prevented,¹¹⁸ it is equally clear that an entire house itself would probably not be considered sufficiently novel to qualify for the issuance of a patent under this section since

114. See text accompanying notes 109-110 *supra*.

115. See text accompanying notes 107-09, 113 *supra*.

116. 35 U.S.C. § 1 *et. seq.* (1970).

117. 35 U.S.C. § 101 (1970); *see, e.g.,* *United States v. Univis Lens Co.*, 316 U.S. 241, 250 (1942).

118. ". . . Congress meant to be comprehensive and inclusive in patent coverage and liberal in patent protection, provided 'any person' either *invent* or *discover* a *new* and *useful art, machine, manufacture, or composition of matter*. It meant to cover all inventions and discoveries which were new and useful." *Dennis v. Pitner*, 106 F.2d 142, 146 (7th Cir. 1939), *cert. denied*, 308 U.S. 606 (1939). 35 U.S.C. § 283 (1970) provides that a patent proprietor may obtain an injunction to prevent the violation of his patent rights. 35 U.S.C. § 284 (1970) provides for damages for patent infringement.

nearly all houses have many features in common, even if designed by an exceptional architect.¹¹⁹ The question remains, however, whether the architect might avail himself of the protection of those provisions of the Act creating a special category of patent, the design patent. Section 171 provides:

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.¹²⁰

Thus a dress designer can patent a given dress design under a design patent without having to patent the idea of the dress itself as a garment. Design patents may be issued for periods of up to fourteen years;¹²¹ however, the general patent requirements of novelty, non-obviousness, originality and ornamentality must still be complied with.¹²²

Generally, the test applied to determine novelty in design patents has been that the design must, in the eyes of the average observer, appear to be new and not a modification of an already existing design.¹²³ Under this test, if another design, already part of the public domain, includes the applicant's design, he is not entitled to a patent on the ground that the "device" was already in public use prior to his "invention" of it.¹²⁴ Even when an applicant's design satisfies the requirement of novelty, it may still be rejected for obviousness.¹²⁵ The test here is whether the design would have been obvious at the time of

119. 35 U.S.C. § 103 (1970) provides: "A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of the invention to a person having ordinary skill in the art to which said subject matter pertains. . . ." See *R.M. Palmer Co. v. Luden's, Inc.*, 128 F. Supp. 672 (E.D. Pa. 1955), *modified*, 236 F.2d 496 (3d Cir. 1956); *cf. Vulcan Corp. v. Slipper City Wood Heel Co.*, 89 F.2d 109 (6th Cir. 1937); *Weidhaas v. Loew's Inc.*, 125 F.2d 544 (2nd Cir. 1942), *cert. denied*, 316 U.S. 684 (1942), *rehearing denied*, 317 U.S. 705 (1942).

120. 35 U.S.C. § 171 (1970); see *Application of Krueger*, 208 F.2d 482 (C.C.P.A. 1953); *Philco Corp. v. Admiral Corp.*, 199 F. Supp. 797 (D. Del. 1961).

121. 35 U.S.C. § 173 (1970).

122. As provided in 35 U.S.C. §§ 102 (1970) (novelty), 103 (non-obviousness), and 171 (originality, ornamentality). See *Rains v. Cascade Industries, Inc.*, 402 F.2d 241 (3d Cir. 1968); *Barofsky v. General Elec. Corp.*, 396 F.2d 340 (9th Cir. 1968), *cert. denied*, 393 U.S. 1031.

123. *Application of Johnson*, 175 F.2d 791, 792 (C.C.P.A. 1949); *cf. Patriarca Mfg., Inc. v. Sosnick*, 278 F.2d 389 (9th Cir. 1960).

124. 35 U.S.C. § 102(a) (1970); see *Carboline Co. v. Mobil Oil Corp.*, 301 F. Supp. 141 (N.D. Ill. 1969).

125. 35 U.S.C. § 103 (1970); see *R.M. Palmer Co. v. Luden's Inc.*, 128 F. Supp. 672 (E.D. Pa. 1955), *modified*, 236 F.2d 496 (3d Cir. 1956).

invention to one having "ordinary skill" in the art.¹²⁶ In addition to its being novel and non-obvious, the design must be original.¹²⁷ Here the term is used much more narrowly than under copyright law,¹²⁸ and generally requires that the inventor-designer have exercised inventive genius.¹²⁹ Finally, it is required that the design be ornamental; that is, it must have a pleasing aesthetic appearance¹³⁰ and its principal purpose cannot be mechanical or utilitarian.¹³¹

The procedure involved in obtaining a design patent is far more complex and is likely to be much more costly than that involved in obtaining a copyright.¹³² The application must include drawings of the design claimed, a specification describing the drawings, and a claim of the design,¹³³ all of which are necessary for the Patent Office to evaluate the design against the requirements of the Act. In addition, there will usually be extensive correspondence, advocacy and negotiation between the applicant and the Patent Office¹³⁴ for which the services of a patent attorney will normally be required.¹³⁵

126. *Id.* "Ordinary skill" is a question of fact. In order for a new combination of elements to be patentable it is necessary that a person skilled in the art would not have been able to arrive at the new combination without the exercise of "inventive faculty." Application of Carter, 212 F.2d 189, 192 (C.C.P.A. 1954). In *Abbott v. Coe*, 109 F.2d 449, 450 (D.C. Cir. 1939) the court stated that "useful innovation is not patentable, and that innovation is not invention unless it required some *uncommon talent*." (emphasis added).

127. 35 U.S.C. § 102 (1970). The statute does not use the word "original" per se but by its provisions clearly sets forth a narrow and precise definition thereof.

128. See text accompanying notes 14-16 *supra*.

129. *R.M. Palmer Co. v. Luden's, Inc.*, 128 F. Supp. 672 (E.D. Pa. 1955), *modified*, 236 F.2d 496 (3d Cir. 1956); *Avery v. Ever Ready Label Corp.*, 104 F. Supp. 913 (D. N.J. 1952).

130. 35 U.S.C. § 171 (1970); *Rains v. Cascade Industries, Inc.*, 402 F.2d 241, 247 (3d Cir. 1968). See also *Design, Inc. v. Emerson Co.*, 319 F. Supp. 8, 9 (S.D. Tex. 1970).

131. See, e.g., Application of Weil, 201 F.2d 946 (C.C.P.A. 1953) (a design patent cannot be granted for the protection of mere utilitarian advantages over the prior art); *Weisgerber v. Clowney*, 131 F. 477 (D.N.J. 1904) (while an item may be useful as well as ornamental, a design patent cannot cover mere mechanical function or construction).

132. 35 U.S.C. §§ 1-99 (1970) cover the operation of the patent office. 35 U.S.C. §§ 100-104 cover patentability. 35 U.S.C. §§ 111-46 (1970) cover application for patents, examination of applications, and the procedure for review of patent office decisions. For the procedures for obtaining a copyright see text accompanying notes 77-81 *supra*.

133. 37 C.F.R. §§ 1.151, 1.152, 1.71-1.77, 1.81-1.88 (1972).

134. 37 C.F.R. §§ 1.2, 1.104, 1.111, 1.112 (1972).

135. See 37 C.F.R. §§ 1.341-1.348 (1972) for rules pertaining to recognition of patent attorneys and patent agents permitted to represent applicants for patents. A "patent agent" need not be a member of the bar and an applicant may represent himself. 37 C.F.R. §§ 1.31, 1.33 (1972).

A design patent grants broader exclusive rights to the patent holder than do the copyright statutes to the copyright holder. Initially, these rights are free from the *Baker v. Selden* restrictions.¹³⁶ Further, the holder of a design patent has the exclusive right to make, use or sell his design.¹³⁷ The protection is thus in the design itself and therefore extends to the appearance of the structure as opposed to merely the plans or drawings from which it was created.¹³⁸ As pointed out above, this is the precise protection which the architect desires. Apparently, however, not many builders or architects have elected to seek design patents for their product, a fact attested to by the dearth of reported cases on the patenting of architectural designs. The lack of attempted utilization of this potential and seemingly well-suited remedy is probably explainable on two grounds. First, it may not be possible in a given case to obtain a design patent covering certain of the features for which protection is desired due to the stringency of the novelty, originality, ornamentality and non-obviousness requirements. Second, any patent which ultimately does issue will come only after the expenditure of considerable time, effort and expense. Thus, while use of the design patent is not totally prevented and the protection afforded thereunder, if achieved, would provide the architect or builder with substantially the type of protection he desires, the practical impediments to the achievement of such protection seriously hinder effective use of the Act for protection against the appropriation of architectural design.

5. *Unfair Competition*

Although it has been rarely utilized in the context here under consideration, the common-law tort action of unfair competition would appear to constitute the most promising potential remedy for misappropriation of architectural design. The remedy is based on equitable principles, would require little or no preparation by the architect prior to an infringement, and has been enormously expanded into an extremely effective tool in recent years.¹³⁹

136. See text accompanying notes 99-103 *supra*.

137. See 35 U.S.C. § 271 (1970) (listing prohibited actions constituting patent infringement).

138. 35 U.S.C. § 271(a) (1970). See also *Baker v. Selden*, 101 U.S. 99, 103 (1879); *Hadco Products, Inc. v. Lighting Corp. of America*, 312 F. Supp. 1173, 1185 (E.D. Pa. 1970) (general appearance rather than minute detail constitutes substance of design patent, and its limitation, the infringement).

139. See *Green, Protection of Trade Relations Under Tort Law*, 47 VA. L. REV. 559 (1961) [hereinafter cited as *Green*].

Society has elected to regard certain business practices as beyond the permitted scope of competitive spirit and to designate these practices tortious acts. Such practices include "palming off,"¹⁴⁰ plagiarism,¹⁴¹ and misappropriation.¹⁴² While both "palming off" and plagiarism could readily occur with respect to the use of architectural design, the particular manifestation of unfair competition which is most important in connection with the topic presently under discussion is, of course, misappropriation.

The leading case in this area is *International News Service v. Associated Press*,¹⁴³ wherein Associated Press, [hereinafter A.P.] which gathered news and transmitted it by telegraph and messenger to newspapers throughout the United States,¹⁴⁴ sought to enjoin International News Service [hereinafter I.N.S.] from placing agents at major east coast newspaper offices for the purpose of copying news as it was written upon bulletin boards placed in the ground floor show windows of each newspaper's offices and from the published papers themselves.¹⁴⁵ It was alleged that this material, some rewritten and some taken verbatim, was transmitted by telegraph to newspapers in the more westerly time zones, in time for its use in preparation of their own editions.¹⁴⁶ As a result, I.N.S. was able to offer its service at a discount price.¹⁴⁷ Since the material in question was news which, apart from being a special and extraordinary means of expression, cannot normally be the subject of copyright,¹⁴⁸ and because A.P. did not in any event attempt to copyright its dispatches, the question of copyright was in no way an issue in the case.¹⁴⁹ The Supreme Court, in enjoining I.N.S. from using any material acquired in the described manner "until its commercial value as news to the complainant and all of its members [subscrib-

140. "Palming off" is an attempt by one person to induce customers to believe his products are of a certain type or manufacturer which they are not. See *Pic Design Corp. v. Bearings Specialty Co.*, 436 F.2d 804, 807 (1st Cir. 1971); Green, *supra* note 139, at 566.

141. "Plagiarism" is the appropriation of a literary composition of another and a subsequent attempt to induce others to believe it is one's own creation. *Tamas v. Twentieth Century Fox Film Corp.*, 25 N.Y.S.2d 899, 900 (Sup. Ct. 1941). See also Green, *supra* note 139, at 566.

142. The balance of this section of the Comment will involve discussion of the practice of misappropriation.

143. 248 U.S. 215 (1918).

144. *Id.* at 229.

145. *Id.* at 231-32.

146. *Id.* at 238.

147. *Id.* at 240.

148. *Id.* at 233-34.

149. *Id.* at 234-35.

ers] has passed away,"¹⁵⁰ reasoned that:

[T]he case must turn upon the question of unfair competition in business. And, in our opinion, this does not depend upon any general right of property analogous to the common-law right of the proprietor of an unpublished work to prevent its publication without his consent; nor is it foreclosed by showing that the benefits of the copyright act have been waived. . . .¹⁵¹

The Court continued:

In [following the described course of conduct] defendant . . . admits that it is taking material that has been acquired by complainant as the result of . . . the expenditure of labor, skill, and money, and . . . that defendant is . . . endeavoring to reap where it has not sown, and . . . is appropriating to itself the harvest of those who have sown.¹⁵²

The foundation laid by this opinion proceeded to flourish and mature into a readily accessible and effective remedy for misappropriation.

In 1964, however, effective use of the doctrine appeared to come to an abrupt end with the Supreme Court's decisions in *Sears, Roebuck & Co. v. Stiffel*¹⁵³ and *Compco Corp. v. Day Bright Lighting, Inc.*¹⁵⁴ These were companion cases in which the Court held in favor of the defendants, alleged infringers of design patents.¹⁵⁵ In each case a design patent was found to have been invalid; however, the trial courts each permitted plaintiffs a remedy under the cloak of unfair competition.¹⁵⁶ The Supreme Court held this to be prohibited state action in an area of exclusive federal jurisdiction.¹⁵⁷ The Court stated its precise holding as follows:

Today we have held . . . that when an article is unprotected by a patent or a copyright, state law may not forbid others to *copy* that article. To forbid *copying* would interfere with the federal policy, found in Article I, Sec. 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to *copy* whatever the federal patent and copyright laws leave in the public domain.¹⁵⁸

The Court reasoned that were it to hold otherwise:

States could allow perpetual protection to articles too lacking in novelty

150. *Id.* at 245.

151. *Id.* at 235.

152. *Id.* at 239.

153. 376 U.S. 225 (1964).

154. 376 U.S. 234 (1964).

155. *Id.* at 232-33, 238-39.

156. *Id.* at 226, 235.

157. *Id.* at 232-33, 237.

158. *Id.* at 237 (emphasis added).

to merit any patent at all under federal . . . standards.¹⁵⁹

At first blush, it would appear that these cases in effect overruled *International News Service v. Associated Press* and indeed there exist cases so holding.¹⁶⁰ The conclusion of such cases is that the states are precluded from application of either common law or statutory unfair competition remedies to copying *or* misappropriation of subject matter which is neither patented nor copyrighted.¹⁶¹ However, strong authority also exists for the view that *Sears* and *Compco* merely ban state action against actual copying, which is permitted under federal law absent a valid patent or copyright.¹⁶² Under this view, those cases do not touch on the question of appropriation (*i.e.*, reaping where one has not sown), and therefore in no way affect the legality of state action with respect to that question.

The cases upholding the legality of state unfair competition remedies, in effect, continue to draw a distinction relied upon by courts even before the *Sears* and *Compco* decisions. This is the distinction between mere copying of an unprotected work, conduct which was held not actionable, and copying which permits the copier to take advantage of a competitor's prior expenditure of time, money or effort and turn it to his own competitive advantage to the detriment of his competitor, conduct which was held actionable. The application of this distinction is best illustrated by the decision of the New York Court of Appeals in *Hebrew Publishing Co. v. Scharfstein*,¹⁶³ a case decided long before *Sears* and *Compco*. In *Scharfstein*, plaintiff printed and marketed a Jewish prayerbook. Defendant, a bookseller who retailed copies of the book, had offset plates made from photographs of its pages and thereafter printed and sold his own edition.¹⁶⁴ The content of the prayer-

159. *Id.* at 232.

160. *See, e.g.*, *C.B.S. v. DeCosta*, 377 F.2d 315 (1st Cir. 1967), *cert. denied*, 389 U.S. 1007 (1967).

161. *Id.*

162. *See, e.g.*, *Tape Industries Ass'n of America v. Younger*, 316 F. Supp. 340 (C.D. Cal. 1970), *dismissed*, 401 U.S. 902 (1971), wherein state laws against the unauthorized manufacture for sale of tape recordings from the original publisher's disc records or tape were upheld even though the material copied could not then be copyrighted. The court relied on *Water Services, Inc. v. Tesco Chemicals, Inc.*, 410 F.2d 163 (5th Cir. 1969), and *Grove Press v. Collectors Publication, Inc.*, 264 F. Supp. 603 (C.D. Cal. 1967) (discussed in note 167 *infra*). *See also* *Liberty/United Artists, Inc. v. Eastern Tape Corp.*, 180 S.E.2d 414 (N.C. App. 1971); *Capital Records, Inc. v. Spies*, 264 N.E.2d 874 (Ill. 1970); *Capital Records, Inc. v. Erickson*, 2 Cal. App. 3d 526, 82 Cal. Rptr. 798 (1969); *Capital Records, Inc. v. Greatest Records, Inc.*, 252 N.Y.S.2d 553 (Sup. Ct. 1964).

163. 288 N.Y. 374, 43 N.E.2d 449 (1942).

164. *Id.* at —, 43 N.E.2d at 450.

book being clearly in the public domain, the suit was brought on the grounds of unfair competition.¹⁶⁵ It appeared, however, that plaintiff had acquired his plates in a manner similar to defendant by photographing the pages of older prayerbooks printed in Europe.¹⁶⁶ Defendant prevailed, the court in effect reasoning that plaintiff had not "sown," therefore defendant was not "harvesting another's crop," although he was certainly copying.¹⁶⁷

It is the opinion of this author that the better reasoned cases are those upholding the legality of state remedies for unfair competition. The language used by the Supreme Court itself in describing its holdings in the *Sears* and *Compco* decisions clearly appears to be directed expressly towards the act of copying: "[W]hen an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article."¹⁶⁸ This language says nothing whatsoever about the right of state law to forbid later use of the copied material to the competitive advantage of the copier and competitive disadvantage of the original creator or proprietor. Further, the allowance of state court actions for misappropriation as distinguished from mere copying would in no way

. . . interfere with the federal policy, found in Article I, Sec. 8, Cl. 8, of the Constitution and in the implementing federal statutes, of allowing

165. *Id.*

166. *Id.*

167. *Id.* For examples of post *Sears* and *Compco* decisions which continue to draw this distinction and apply *International News Service v. Associated Press*, see cases cited in note 162 *supra* and especially *Grove Press, Inc. v. Collectors Publication, Inc.*, 264 F. Supp. 603 (C.D. Cal. 1967), which expressly distinguishes *Sears* and *Compco*, clearly underscoring the line of demarcation between those fact situations to which *International News Service* should be held to apply and those to which it should not. In *Grove Press*, plaintiff had taken a manuscript that was in the public domain but long out of print, edited it, and proceeded to publish it. The defendant later published the same work by photolithography, copying the Grove Press edition. Later, defendant sent its own experts to research the original manuscript and annotate its first edition, in effect reversing the changes made by Grove's editors. In so doing, it was defendant's intention to re-edit the recreated original, thereby coming up with their own "modernized" version. This was ultimately published as defendant's second edition. The court held that defendant's first edition constituted a misappropriation of plaintiff's efforts because it took advantage of Grove's editorial work, at no expense to defendant, for the purpose of competing with Grove. With respect to the second edition, however, the court found no misappropriation because, although it too originally stemmed from a copy of plaintiff's edition, defendant was not taking any advantage of plaintiff's efforts as it had in its first edition because it was here utilizing its own editorial efforts. Accordingly, the court issued an injunction against defendant's first edition only, distinguishing *Sears* and *Compco* by noting that the first edition involved not a mere copying but a misappropriation and concluding that the Supreme Court had not intended to deprive the states of their jurisdiction over unfair competition.

168. 376 U.S. at 237 (emphasis added).

free access to copy whatever the federal patent and copyright laws leave in the domain.¹⁶⁹

For, again, such actions do not militate against copying *per se* but only against subsequent use of the copied material and then only in those instances in which such use is both to the competitive advantage of the copier and competitive disadvantage of the originator.

It seems clear that in those jurisdictions which continue to allow state court actions for misappropriation, the availability of such a cause of action could be of great value to the architect or builder as both a preventative of and remedy for the misappropriation of architectural design. The architect or builder has, of course, expended time, money and effort in the creation and development of the design itself or the legal acquisition of rights therein. In the merchant-builder situation, the competitor who takes advantage of such expenditure and, by copying either the plans or completed structure, obtains the use of this design without a like expenditure in order to compete to the detriment of the creator or proprietor should be liable for his misappropriation just like the misappropriating book publisher¹⁷⁰ or recording tape "pirate."¹⁷¹ This reasoning is similarly applicable to situations in which another architect or building designer misappropriates a design made for a client-related project.

The same reasoning would not apply, however, when the appropriator is one not in competition with the originator or proprietor of the design, as where an architect designs a restaurant for client A which is copied and used by restaurateur B. In such a situation, client A can seek relief under the "unfair competition" theory on the ground that for the price of his meals he is also selling the amenity of the architect-designed environment and that restaurateur B has misappropriated the design of this environment from A without cost and to A's competitive detriment.¹⁷² The architect in such a situation could not sue under the above reasoning because the appropriator would gain no *competitive advantage vis-a-vis* the *architect*. The architect does, nonetheless, suf-

169. *Id.* (emphasis added).

170. *See, e.g.,* Grove Press, Inc. v. Collectors Publication, Inc., 264 F. Supp. 603 (C.D. Cal. 1967), discussed in note 167 *supra*.

171. *See, e.g.,* Tape Industries Ass'n of America v. Younger, 316 F. Supp. 340 (C.D. Cal. 1970); Liberty/United Artists, Inc. v. Eastern Tape Corp., 180 S.E.2d 414 (N.C. App. 1971). *See also* Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp., 101 N.Y.S.2d 483 (Sup. Ct. 1950), *aff'd*, 107 N.Y.S.2d 795 (App. Div. 1951).

172. *See* text accompanying notes 144-152 *supra*.

fer injury by the conduct of restaurateur B. If the architect cannot prevent B from copying the design, he loses the valuable right of being able to offer an exclusive design. Recognition and protection of such a right has been afforded in at least one case. In *Metropolitan Opera Association v. Wagner-Nichols Recording Co.*,¹⁷³ plaintiff broadcast live operatic performances and sold an exclusive license to Capitol Records to make and sell records of the broadcast performance.¹⁷⁴ Defendant was unfairly competing with plaintiff's licensee by making unauthorized recordings for sale.¹⁷⁵ Plaintiff's right to recovery was upheld on the theory that the infringement reduced the value of plaintiff's right to name an exclusive licensee.¹⁷⁶

CONCLUSION

This comment has shown the following with respect to the protection of architectural design and the availability of potential remedies for the misappropriation thereof:

1. The architect can most easily protect himself from the unauthorized use of his work, both plans and design, by his client by express provision in the architect-client contract. Such contractual provisions, however, provide no effective protection for either the architect or his client against misappropriating third parties.
2. The architect (and perhaps a builder as his assignee) has a common law right to the exclusive use of his plans prior to publication and may sue an appropriator for infringement, at least in those jurisdictions which, when no other facts exist which might be said to evidence an intent to dedicate to the public, will not find publication in either the required filing of plans with the appropriate authorities, the construction of the building, or its display for use or sale. This remedy will tend to be most available with respect to the custom home, less so with respect to a custom commercial building, and least available in the merchant-builder situation. This remedy is also subject to the defense, in many jurisdictions, that it was the building itself which the appropriator copied, not the plans.
3. There would appear to be little, if any, protection afforded architectural design under the present provisions of the Copyright

173. 101 N.Y.S.2d 483 (Sup. Ct. 1950), *aff'd*, 107 N.Y.S.2d 795 (App. Div. 1951).

174. *Id.* at 486-87.

175. *Id.* at 487-88.

176. *Id.* at 499.

Act. Further, amendment of the Act to provide effective protection will likely depend upon the view which Congress ultimately adopts with respect to the applicability to architectural plans of the concept that the copyright of a given entity does not encompass the concept or ideas contained therein but only that particular expression or manifestation of those ideas.

4. The conceptual difficulties involved in satisfying the requirements of the Patent Act to obtain a design patent of a building plan seriously hinder the acquisition of this form of protection except in the extreme case of a very unusual or distinctive design. In addition, serious practical impediments to the acquisition of such protection exist, as the patenting process itself tends to be time consuming and expensive.
5. Assuming the view which upholds the continuing legality of state remedies for the misappropriation aspect of unfair competition ultimately prevails, such remedies should provide effective and readily available protection for (a) the architect against the appropriation of his design by another architect, and (b) the client against the use of a custom commercial design by a competitor. The protection afforded by this remedy could be even more effective if more jurisdictions would follow the view, apparently adopted by the New York courts,¹⁷⁷ which recognizes the architect's interest in being able to prevent third parties from appropriating his design, thereby depriving him of any value to be derived from the right to offer an exclusive design.

It is thus clear that, at present, the only potentially useful remedies of those discussed above are the doctrines of common law copyright and unfair competition, both of which are creatures of state common or statutory law. At present, however, the effectiveness of even these remedies depends to a great extent on the jurisdiction in which protection is sought and the continued forbearance of the Supreme Court to grant certiorari in such cases. The architect may take heart, however, in the fact that the trend of decisions in these areas appears, with the exception of recent California decisions, to be towards increased protection of the architect's work product. Nonetheless, the architect continues to occupy a much less favored position than that of his creative counterparts, the author, artist, composer, or playwright.

Joseph M. Cahn

177. See text accompanying notes 173-176 *supra*.