May 8, 2006
IP
SUPPLEMENT TO *LEGAL TIMES*

A Tale of TWO TOWERS

New York case raises copyright on buildings.

By Matthew W. Clanton

Since a twisting, tapering model was unveiled in late 2003, the design for the tallest building on the World Trade Center site has turned heads and raised voices. Critics have objected on substantive, political, and symbolic grounds to the proposed Freedom Tower.

But no American debate is really complete without some legal controversy. A young architect and a venerable architectural firm have obliged.

In *Shine v. Childs,* the architect Thomas Shine has alleged that the original design for the Freedom Tower, produced by David Childs of Skidmore, Owings & Merrill, was copied from a series of designs that Shine created while pursuing his master's degree.

In a move unexpected by many in architectural circles, the U.S. District Court for the Southern District of New York refused to dismiss the case this past August. That means that even as the plans for the final building have been altered, Shine and Childs are heading to trial over the first design.

For the rest of us, the court's decision offers rare judicial guidance on the scope of protection afforded by the Architectural Works Copyright Protection Act of 1990 (AWCPA).

New Legal Grounds

Before 1990, the Copyright Act did not expressly mention architecture as a category of works that could be protected. The only clearly recognized, architecturally relevant copyright applied to technical drawings, plans, blueprints, and three-dimensional models, which could (and still can) be protected as pictorial, graphic, and sculptural (PGS) works.

However, protecting architecture this way carries distinct restrictions. The PGS copyright extends only to those aspects of individual drawings, plans, models, etc., that can be identified separately from, and are capable of existing independently from, the utilitarian aspects of the work. The underlying architectural design is generally not protectable because it cannot be separated from its utilitarian purpose. While the unauthorized reproduction of the PGS work itself may be stopped, the PGS copyright owner cannot prevent anyone else from constructing a building from those plans.

The AWCPA, passed in 1990 after the United States became a party to the Berne Convention for the Protection of Literary and Artistic Works, shifted the legal landscape. The new statute amended the Copyright Act to specifically add "architectural works" as a new category of copyrightable material. It also extended protection to both unconstructed plans and constructed designs, allowing designs embodied within architectural works to be protected despite their overall utilitarian purpose.

The salient requirement is that an architectural work must constitute a "design of a building." It must (a) relate to the design of a stationary structure intended for human occupancy, and (b) be embodied in a tangible medium of expression such as a constructed building, architectural plans, or drawings. Protection extends to the overall form of the design as well as the arrangement and composition of spaces and elements within the design.

Cracks in the Facade

The AWCPA is not without its own limitations. Standard configurations of spaces and standard features, such as windows and doors, are not protectable. Elements that are functionally required to support the design itself (from an engineering or physics perspective) are not protectable. And because the work must relate to a "permanent" building, designs for mobile homes and houseboats do not qualify.

Further, the exclusive rights normally accorded to a copyright owner—such as the right to adapt, modify, or control the public display of a work—yield to the practical realities and public nature of buildings. After construction, a building owner need not seek the copyright owner's approval to make changes or to destroy the building entirely. The copyright owner also cannot prevent others from taking, making, distributing, or displaying photos, paintings, or other pictorial representations if the building is located in or is ordinarily visible from a public place.

In other ways, the AWCPA can be difficult to apply. The fact that copyright only extends to the expression of an idea, rather than the idea itself, does not comport well with the art of architecture. The highly collaborative process for designing buildings produces multiple variations on the work. The design invariably becomes more complete as it progresses from concept to schematic, to design development, and then to the final documents used to construct a building. It is difficult to determine at what point a concept is complete enough to qualify as the actual expression of a building design.

Moreover, architectural designs are often inspired by preexisting works. Except for cases involving the overt stealing of plans, copying has been somewhat of an accepted practice—at least prior to *Shine v. Childs*. This, perhaps, explains why there is little case law construing the AWCPA.

The court's decision in *Shine v. Childs* touches on many of these issues.

The Two Towers

The facts of the case are relatively straightforward. Thomas Shine claims that David Childs and his architectural firm, Skidmore, Owings & Merrill, copied Shine's work without permission or authorization when they produced their Freedom Tower design to replace the World Trade Center.

In the late 1990s, Shine, who was then pursuing a master's degree, created two designs for a course at the Yale School of Architecture. The object of the course was to design a hypothetical New York City skyscraper to be built for the 2012 Olympic Games.

Shine's first design, dubbed Shine '99, was a three-dimensional cardboard model that consisted of (1) two sides that tapered straight toward the top, creating a roughly triangular shape; (2) two other sides that twisted as they rose, and one of which featured four graded setbacks; and (3) a top that formed a parallelogram. The work did not include any information on the number of floors, the floor-to-floor height, the overall height, or the mode of entering the building at ground level. There was no information as to underlying construction. Apart from the single model, no schematic drawings or other documents existed.

Shine's second design, dubbed Olympic Tower, was much more detailed. The building twisted on all four sides; its internal diamond-shaped grid was reflected in its external "skin." The design materials included (1) two models of the tower, one of the internal supports and one of the external view; (2) elevation sketches displaying the building's core at different levels; (3) a photomontage of what the building might look like against a New York City backdrop; and (4) a sketch of the exterior design, similar to Shine '99.

In December 1999, Shine formally presented both designs to a panel of experts for evaluation and criticism. Childs, himself a graduate of the Yale School of Architecture, served on the panel. Shine alleges that Childs offered glowing praise. Indeed, Childs was allegedly so impressed that he invited Shine to visit Skidmore, Owings after graduation.

About three years later, Childs began work on the design for Freedom Tower. His design was shown to the public in December 2003. Shine federally registered the copyrights on his designs in the spring and summer of 2004, and sued for infringement that November.

Deconstructing the Case

Shine contended there are substantial similarities between each of his designs and Child's design. Specifically, he claimed that both Shine '99 and Freedom Tower had two straight, roughly triangular, opposing facades, with two twisting facades joining them, all tapering to the top. He also claimed that Freedom Tower had an identical internal grid and a "strikingly similar" facade to Olympic Tower.

The defendants presented three primary arguments for dismissing the suit. They argued that neither Shine '99 nor Olympic Tower qualified as an architectural work under the AWCPA because both designs were still too preliminary. They argued that both designs were unoriginal and those aspects that arguably were original were functionally required. And they insisted that they did not copy Shine '99 or Olympic Tower and that Freedom Tower was not substantially similar to either.

The court rejected nearly all of these arguments. The defendants did score a victory on Shine '99 when the court held that it qualified for protection under the AWCPA but was not "substantially similar" to Freedom Tower. But, more important, the court held there were genuine issues of material fact as to whether Freedom Tower infringed on Olympic

Tower. And the court made four key observations on the scope of copyright in architectural works.

First, in perhaps the most surprising aspect of the ruling, the court held that AWCPA protection may potentially extend to those works that fall within the conceptual phase of the architectural process. While acknowledging the traditional requirement that copyright protects only expressions of ideas, the court nonetheless held that a design need not be especially detailed or complete in its expression. The defense had argued that an architectural design could only qualify if it was sufficiently detailed that a building could be constructed from it. The court rejected that argument, holding that even the "rough" nature of Shine '99 constituted the "design of a building" for AWCPA purposes.

Second, the court determined that an architectural work can be "original" even if certain underlying elements have been used in prior works. The mere fact that certain aspects of a design have been built before need not render the entire design unprotectable. The originality test can be satisfied if the particular combinations of design elements are original. The court noted that copyright registration can serve as prima facie evidence not only of the validity of a copyright but also of the work's originality.

Third, the court said that a "total concept and feel" standard should be used in assessing whether two architectural works are substantially similar. This test is the 2nd Circuit's dominant standard for evaluating substantial similarity in non-architectural works, the court noted.

The defense argued that the "total concept and feel" test was too subjective and that a "filtration" standard—breaking up each composite design, filtering out those elements that are unoriginal or functional, and comparing the remaining original elements with those of the alleged infringing design—was more appropriate. But the court rejected the latter standard.

Finally, the court held that the similarity between two architectural works should be judged by ordinary observers, not trained experts. Two works should be considered substantially similar if an ordinary observer would be likely to overlook differences and regard their aesthetic appeal as the same.

Building Blocks

The court's decision in *Shine v. Childs* provides much-needed judicial guidance for those trying to protect architectural works.

The most important lesson is one the opinion only briefly mentions, but it may prove to be crucial to the success of Shine's case. Shine failed to register copyrights in his works before the allegedly infringing Freedom Tower design was created. Without that prior copyright registration, his potential relief is limited by statute to his actual damages (e.g., the amount that he would have made on the design but for the alleged infringement), plus any nonduplicative profits made by Skidmore, Owings off the design.

Unfortunately for Shine, the suspect Freedom Tower design has been scrapped due to security concerns and replaced with another Child design that, by all accounts, is not implicated in the suit. Shine's damages thus appear to be nominal or, at least, very speculative.

Had Shine registered his designs, he would have been eligible for more substantial relief in the form of statutory damages (which range from $750 to $30,000, and can rise to $150,000 on a finding of willfulness) and attorney fees. As it is, the case may ultimately prove to be an important but costly moral victory.

To avoid a similar result, copyright holders should register their architectural works with the U.S. Copyright Office within three months of the works' publication. Further, all architectural works should bear a standard copyright notice, consisting of the copyright symbol, the year of publication, and the name of the copyright holder. (While notice is no longer technically required, it is still advisable.)

Shine v. Childs also highlights the importance of treating even rough designs as potentially copyrightable. It is tempting to brush off preliminary designs or models as mere concepts. But architectural designs and models created even before the "preschematic" phase may be protectable. Whether a building can actually be built from the architectural work, or whether the work reflects the very early stages of design formulation, is irrelevant to the analysis. Architectural firms should make appropriate work-for-hire and other agreements with contributors before design creation begins.

Finally, as is readily apparent from *Shine v. Childs,* the AWCPA has made it much more likely that architects and architectural firms may find themselves infringing, albeit unintentionally, on pre-existing works. Additional care should be taken to follow strict clearance practices for considering other people's designs. The fact that someone else's design lacks a high degree of specificity or that some of its elements have been used in many other buildings will not bar an infringement suit.

Buildings still fit a bit awkwardly into the copyright scheme, and creators of architectural works still don't have all the rights granted to creators of other art forms. But this preliminary decision in *Shine v. Childs* has laid the floor for better protection of building designs.

MATTHEW W. CLANTON is an associate in the D.C. office of Sheppard, Mullin, Richter & Hampton, working in the firm's intellectual property group and on its entertainment, media, and communications team. He can be reached at mclanton@sheppardmullin.com. *He would like to thank partner Edwin Komen for his invaluable comments and suggestions.*

LegalTimes ALM