

PROTECTING ARCHITECTURAL PLANS AND STRUCTURES WITH DESIGN PATENTS AND COPYRIGHTS*

INTRODUCTION

The purpose of this note is to compare the protection available by copyright for architectural plans and structures with that available by design patent. First there will be a discussion of how the architectural designs and structures qualify as being the subject matter of common-law copyright, statutory copyright and design patents. Next will follow a discussion and comparison of the procedures followed for obtaining these various rights. One problem which will confront a lawyer seeking protection for an architect's work product is whether or not it is possible to obtain copyright and patent coverage simultaneously for the same design. Therefore an analysis will be made of the cases relating to this problem. No comparison of the copyright and patent protection for architectural plans and structures would be complete without a comparison of the infringement proceedings under both types of protection. This topic constitutes the fourth division of this note, and it is followed by the final division which discusses the remedies available in a successful infringement proceeding.

I. SUBJECT MATTER

A. Copyright

There are two distinct areas of copyright law: common-law and statutory copyright. Common-law copyright applies to unpublished works and statutory copyright applies to published works.¹ There are three other differences between common-law and statutory copyright: (1) the common-law right protects *all* unpublished works, but statutory copyright only comes into being through compliance with the statute; (2) common-law copyright is in-terminable (so long as there is no publication), but statutory copyright is for a specified time; and (3) the states regulate common-law copyright while the federal government regulates statutory copyright.²

* This is a substantially revised version of a paper which was entered in the 1967 Nathan Burkan Memorial Competition sponsored by the American Society of Composers, Authors, and Publishers.

¹ *Donaldson v. Becket*, 4 Burr. 2408, 98 Eng. Rep. 257 (1774) and *Miller v. Taylor*, 4 Burr. 2303, 98 Eng. Rep. 201 (1769) were the landmark cases making this distinction. The *Miller* case held that the first English copyright statute, Copyright Act of 1709, 8 Anne 3, c. 19, did not divest the author of his common-law rights in his property whether published or unpublished. The *Donaldson* case modified this decision, holding that common-law copyright applied to unpublished works and statutory copyright applied to published works. The United States Supreme Court adopted the holding of the *Donaldson* case in *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834).

² *Bobbs-Merrill Co. v. Straus*, 210 U.S. 859 (1908); L. AMDUR, COPYRIGHT LAW AND

Because registration with the copyright office with a view towards obtaining a statutory copyright constitutes publication,³ it is not possible to have both a common-law and a statutory copyright simultaneously in one work.

The two rights do not co-exist in the same composition; when the statutory right begins, the common-law right ends. Both may be defeated by publication. Thus when a work is published in print, the owner's common-law rights are lost; and unless the publication be in accordance with the requirements of the statute, the statutory right is not secured.⁴

1. *Common-law Copyright*

In order for an architect's work to qualify for common-law protection it must be original and concrete.⁵ "Originality" in copyright law means a result coming from the independent labor of the one seeking protection.⁶ Thus, an architect who produces a design through his own efforts and independent labor can meet the originality requirement. Even if there is a substantially similar or identical design in the public domain, the architect is entitled to common-law protection as long as his own design came from his independent labor.⁷ For example, if one architect were to design a building and someone else had previously designed an identical building, the architect's design would still be original as long as he had produced it through his own efforts without gaining the ideas for his design from the previous design.

The second requisite is that a work be of a concrete or tangible nature. There is no protection available for an undeveloped idea.⁸ For example, the concept of constructing a dome by the use of steel in suspension rather than compression is not amenable to protection. However, the instant this idea is embodied in a drawing or model, the tangibility requirement is met. The work need only take a tangible enough form as would permit the impression of a mark of ownership.⁹

Since common-law copyright applies only to unpublished works, the question then arises as to what constitutes publication. The courts have generally referred to two types of publication—limited and general. Limited publication is communication of the work to others which would not divest the author of his common-law rights, while general publication would divest him of those rights.¹⁰ The United States Supreme Court has established that the test is one of intention. That is, if the author disseminates copies of his

PRACTICE § 35 (1936); Katz, *Copyright Protection of Architectural Plans, Drawings, and Designs*, 19 LAW & CONTEMP. PROB. 224, 227 (1954).

³ Werckmeister v. American Lithographic Co., 134 F. 321 (2d Cir. 1904).

⁴ E. DRONE, COPYRIGHT § 100 (1879).

⁵ White v. Kimmel, 94 F. Supp. 502 (S.D. Cal. 1950); E. DRONE, COPYRIGHT § 208 (1879); Comment, 24 So. CAL. L. REV. 65 (1950).

⁶ Edgar H. Wood Associates, Inc. v. Skene, 347 Mass. 351, 197 N.E.2d 886 (1964). See Ketcham v. New York World's Fair, 1939, Inc., 34 F. Supp. 657 (E.D.N.Y. 1940).

⁷ Fisher v. Dillingham, 298 F. 145, 150 (S.D.N.Y. 1924).

⁸ O'Brien v. R.K.O. Pictures, Inc., 68 F. Supp. 13 (S.D.N.Y. 1946).

⁹ Pamone, *Property Rights in an Idea and the Requirement of Concreteness*, 33 B.U.L. REV. 396 (1953).

¹⁰ Werckmeister v. American Lithographic Co., 134 F. 321 (2d Cir. 1904).

work so as to justify the belief that he intends to make that work public property, then there has been a general publication. If not, then there was only a limited publication and the architect has not lost his common-law rights.¹¹ However, the trend has been toward treating the slightest publications of architectural plans as general publications, thereby divesting common-law rights in them. The architect runs the risk of losing his common-law rights the instant he tries to use them to reap benefit for himself and others. For example, in *Kurfiss v. Cowherd*¹² the court ruled that the architect, by building a structure from his plans, made a general publication and therefore lost his common-law rights in them. Some courts have even gone so far as to hold that filing of unpublished plans with a municipal building department before construction constituted general publication.¹³

By using his common-law copyright as consideration for a contract, the architect may be able to create rights which are similar to his common-law rights and which will continue after the divestment of the copyright by general publication. A trade secret was valid consideration for such a contract and the similarity between a trade secret and common-law copyright would indicate that the latter would also be valid consideration.¹⁴ For instance, if an architect had house plans which might be reproduced on a large scale, he could enter into a contract with a builder whereby the builder would pay a certain fee for each house built. Then, even if the common-law copyright were lost through publication, the architect could reap his benefit from the terms of the contract.

2. Statutory Copyright

Congress derived its source of power to enact copyright statutes from the Constitution:

The Congress shall have the Power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; . . .¹⁵

The purpose of the copyright statutes then is to promote the progress of the useful arts. There are two theories underlying the reasons for granting

¹¹ *American Tobacco Co. v. Werckmeister*, 207 U.S. 284, 299 (1907).

¹² 233 Mo. App. 397, 121 S.W.2d 282 (1938).

¹³ *Wright v. Eisle*, 86 App. Div. 356, 83 N.Y.S. 887 (1905).

¹⁴ Common-law copyright closely resembles a trade secret. An architect who has a house plan which is the result of his independent labor has met the requirement of originality for common-law copyright. This is almost identical to the trade secret requirement that the information or knowledge represent in some considerable degree the independent efforts of its claimant. The analogy between the two becomes even more apparent due to the fact that a trade secret may be lost by its publication just as may common-law copyright. *Smith v. Dravo Corp.*, 203 F.2d 369 (7th Cir. 1953). If the holder of a trade secret gives that secret in consideration for contractual rights, the contractual rights extend as long as the contract provides, even if the trade secret rights are lost to the public domain. For example, in *Warner-Lambert Pharmaceutical Co. v. John J. Reynolds, Inc.*, 178 F. Supp. 655 (S.D.N.Y. 1959), the court held that even though the plaintiff had lost his trade secret rights through public knowledge, a contract providing for royalties was valid because the trade secret (a formula for mouthwash) was a valid consideration for the contract.

¹⁵ U.S. Const. art. I, § 8, cl. 8.

exclusive rights to authors.¹⁶ The first and most well known is the reward theory. That is, the statutory rights are bestowed upon the author as a reward for his work, and as an encouragement to his creativity. Probably more sound is the contract theory wherein an author has a natural right to keep his work hidden from the public, but the public has the natural right to appropriate his works to its use when the works become publicly known. Under this theory the grant of statutory rights is considered to be a contract between the author and the public. The public grants exclusive rights to the author for a limited time in consideration for the immediate disclosure of the writing.

The subject matter for statutory copyright includes all writings of an author.¹⁷ The architect is as much a writer as the author of a book. He expresses his ideas by such means as technical signs, symbols and drawings. The architect is quite similar to a musical composer in that his drawings are to the building contractor what the composer's sheet music is to a musician.¹⁸

Section 5 of the copyright act sets forth thirteen classifications under which the author must register his work.¹⁹ One classification includes works of art.²⁰ Registration of an architect's design as a work of art may prove difficult because, in addition to the general requirements of originality and concreteness, the architect must show his work is "creative."²¹ This restriction stems from the definition of the word "art."²² Thus the work must have what could be described as "artistic" or "aesthetic" value. The standard for determining whether there was sufficient creativity for a work to qualify as a work of art was stated in *Bailie v. Fisher*: "A thing is a work of art if it appears to be within the historical and ordinary conception of the term art."²³

It appears an architectural structure will qualify as a work of art only if it has some aesthetic or creative attributes. The Washington Monument and the Statute of Liberty may qualify. Both of these structures were erected solely for their aesthetic appearance and for that reason they would come within the historical and ordinary conception of the term "art." In *Jones Bros. Co. v. Underkoffler*²⁴ the court held that cemetery monuments or memorial stones would qualify as works of art because they had a primary function of ornamentation and beautification.

But what about a building design which incorporates *both* a functional

¹⁶ W. ROBINSON, PATENTS §§ 12, 13, 20, 24, 25 (1890).

¹⁷ "The works for which copyright may be secured under this title shall include all the writings of an author." 17 U.S.C. § 4 (1966).

¹⁸ Katz, *Copyright Protection of Architectural Plans, Drawings, and Designs*, 19 LAW & CONTEMP. PROB. 224 (1954).

¹⁹ "The application for registration shall specify to which of the following classes the work in which copyright is claimed belongs." 17 U.S.C. § 5 (1966).

²⁰ "Works of art; models or designs for works of art." 17 U.S.C. § 5(g) (1966).

²¹ "In order to be acceptable as a work of art, the work must embody some creative authorship in its delineation or form." 37 C.F.R. § 202.10(b) (1967).

²² "Art: (4a) Application of skill and taste to production according to aesthetic principles." WEBSTER, NEW INTERNATIONAL DICTIONARY (3d ed. 1961).

²³ *Rosenthal v. Stein*, 205 F.2d 633, 635 (9th Cir. 1953).

²⁴ 16 F. Supp. 729 (M.D. Pa. 1936).

and an ornamental purpose? The copyright office regulations now include under section 5(g), "Works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries."²⁵ In *Mazer v. Stein*²⁶ the Supreme Court upheld the copyright in a statuette used as a lamp base and expressly adopted the above quoted regulation. A more recent copyright office regulation provides:

If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.²⁷

There have been no cases deciding the question of when an article is incapable of copyright protection as a work of art because its sole intrinsic function is its utility. The regulations are the only indication.

In most situations it would be to the architect's advantage to register the design under section 5(g) of the copyright act if at all possible. This is for the reason that one of the exclusive rights granted to the owner of a copyrighted work is the right "to complete, execute, and finish it if it be a model or a design for a work of art."²⁸ An architect who has registered his design under section 5(g) has the exclusive statutory right to build the structures from his plans. However, the statute seems to indicate that once he has completed his work of art he no longer has the right to prevent others from copying that work of art. Thus, if the architect has a design for a building which he desires to construct only once, the protection afforded under section 5(g) is sufficient. But if he has a design for a building which is likely to be reproduced more than once, his protection under section 5(g) would be inadequate.

If the copyright office does not allow registration under section 5(g) the architect should register the design under section 5(i) which includes "[d]rawings or plastic works of a scientific or technical nature."²⁹ There should be no difficulty in qualifying architectural plans under this section because the requirement of creativity is not applicable. However, as mentioned above, an architect may acquire the exclusive right to finish his work only if he classified it as a work of art under section 5(g), and thereby qualified for the rights granted in section 1(b). Section 1(a) grants the rights to print, reprint, publish, copy and vend the copyrighted work. These are the only rights granted to owners of copyrighted works registered under section 5(i). The architect who has registered his plans as technical writings has only the right not to have his plans copied. In many cases this right will protect against the building of

²⁵ 37 C.F.R. § 202.10(a) (1967).

²⁶ 347 U.S. 201 (1954).

²⁷ 37 C.F.R. § 202.10(c) (1967).

²⁸ 17 U.S.C. § 1(b) (1966).

²⁹ 17 U.S.C. § 5(i) (1966). See also 37 C.F.R. § 202.12 (1967).

the structure itself because construction would probably involve copying the plans. The case of *DeSilva Constr. Corp. v. Herrald*³⁰ suggested, though, that copying plans from a structure, rather than from the plans upon which the structure is based, may not constitute an infringing copy. The court held that the copyright protection under section 5(i) was limited to the plans only, and the building was not a copy of the plans. Therefore, neither the copying by the defendant from a structure nor from his building of a structure from one of the plaintiff's plans (without copying them) were an infringement of the plaintiff's copyright.

An architect should try to register his design under section 5(g) as a design for a work of art, but if he cannot do so he should still register it under section 5(i) as a technical writing. Even if the copyright office will accept registration only under section 5(i) this does not foreclose the copyright owner from claiming in a subsequent infringement action that the proper classification should have been under section 5(g).³¹

B. Design Patents

Congress has provided for patent protection for designs as follows:

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefore, 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.³²

The statute limits patent protection only to designs for an article of manufacture. This restriction, while somewhat different than the requirement of concreteness for copyrightable works, does not create problems for an architect who has a design for a structure because a structure is an article which must be manufactured or built.³³

In order to qualify for a design patent a design must be for an article of manufacture which is novel, unobvious, original, and ornamental. First, the design must be new.³⁴ If another design which is part of the public domain

³⁰ 213 F. Supp. 184 (M.D. Fla. 1962); *but see* *Muller v. Triborough Bridge Authority*, 43 F. Supp. 298 (S.D.N.Y. 1942).

³¹ "[N]or shall any error in classification invalidate or impair the copyright protection secured under this title." 17 U.S.C. § 5 (1966).

³² 35 U.S.C. § 171 (1966).

³³ *Ex parte Foshay & Magney*, 7 U.S.P.Q. 121 (P.O. Bd. App. 1907).

³⁴ 35 U.S.C. § 102 (1966), which provides:

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the

shows the applicant's design, he is not entitled to a patent. Generally the test applied to 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.³⁵ The enumerated criteria in section 102 create many possibilities that the design may not be patentable for lack of novelty. Under this section, many issues are involved concerning prior dates of invention, public use or sale, foreign knowledge of the invention, and priority of invention between two applicants. For the purposes of this article, it is sufficient to note that the requirements of novelty under section 102 provide many problems for one who is seeking patent protection.³⁶

When the applicant's design cannot be shown identically in any one prior design, it may still be rejected for obviousness. The rule of obviousness is found in 35 *United States Code*, section 103, which states that if it would have been obvious at the time of invention for one having ordinary skill in the art to produce the applicant's design, it is not patentable.³⁷ For example, assume that an application includes a design for a doorknob combined with a telephone dial combination lock. If there were no other doorknobs with such a combination lock, the design would pass the test of novelty. However, assume that in the prior art there were doorknobs having an appearance like applicant's doorknob, and there were also combination locks having telephone dial appearance. Patent protection may be denied in this situation on the grounds that it would be obvious to one skilled in the art to combine the individual doorknobs with the telephone dial locks to produce applicant's design.

In addition to meeting the requirements of novelty and nonobviousness, the design must be original. The test generally applied to originality is whether or not the inventor exercised inventive genius. The court in *R. M.*

application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice from a time prior to conception by the other.

³⁵ In *Application of Johnson*, 175 F.2d 791 (C.C.P.A. 1949), the court held that applicant's design for a pair of pliers was not novel because the average observer would consider their appearance to be the same as certain pliers already in existence on the market.

³⁶ For further study of the problem of novelty, see A. SMITH, *PATENT LAW* 301-400 (1964).

³⁷ 35 U.S.C. § 103 (1966), which provides:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, 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 the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Palmer Co. v. Luden's, Inc.,³⁸ for example, applied this test to a design patent for chocolate figurines. In holding the patent valid the court said that originality was to be determined by viewing the appearance of the design as a whole to determine if there was inventive genius involved in creating the design. The standard of "inventive genius" is somewhat undesirable because it is such an ambiguous term. Probably the best test for inventive genius is the standard used to determine novelty. That is, if the design appears, in the eyes of the average observer, to be new, and not a modification of an existing design or designs, then it is original.

The final requirement for a design patent is that it be ornamental. In determining the ornamentality of a design, one must consider its overall aesthetic effect and its artistic appeal.³⁹ There must be a pleasing aesthetic appearance in the design before it can be patented. It has been said there are some "articles of manufacture incapable of being the subjects of design patents, for want of reason to suppose that their appearance can ever really matter to anybody."⁴⁰ For example, in *North British Rubber Co. v. Racine Rubber Tire Co.*,⁴¹ the plaintiff had a patent on a design for a tire tread. The court held that while it was not fatal for a design to be exhibited upon a mechanical product devoted to utilitarian purposes as long as the design per se was the result of invention, this design for a tire tread was definitely an effort to secure, under the guise of a design, a monopoly on the mechanical value of the tread and was therefore invalid. Thus a design is not ornamental if its principal purpose is mechanical or utilitarian.

A design for a building may be the subject matter of a design patent.⁴² First it must meet the novelty requirement. If another architectural design can be found which in the eyes of the ordinary observer shows the applicant's architectural design, there will be a rejection for lack of novelty. Second, if it would be obvious to one skilled in the art of architecture to combine two or more designs to produce the applicant's design, there will be a rejection for obviousness or lack of originality. Even if the architect overcomes these obstacles to patent protection, he will undoubtedly encounter resistance under the ornamentality requirement due to the utilitarian aspect of his plans for a structure. However, as the *North British Rubber* case explained in its decision: "[I]t is not necessarily a fatal objection to a patent of this class that the design itself is exhibited upon a mechanical product devoted to utilitarian purposes, provided that the design per se is (inter alia) the result of invention."⁴³ If an architect has a design of truly aesthetic merits, he should stress in his communications with the patent office that he is attempting to obtain protection in the pleasing appearance rather than in the utilitarian aspects of the structure.

³⁸ 236 F.2d 496 (3d Cir. 1956).

³⁹ *Burgess Vibrocrafters, Inc. v. Atkins Indus., Inc.*, 204 F.2d 811 (7th Cir. 1953).

⁴⁰ *Theodore Foster & Bros. Co. v. Tilden-Thurber Co.*, 200 F. 54 (1st Cir. 1912).

⁴¹ 271 F. 936 (2d Cir. 1921).

⁴² *Ex parte Foshey & Magney*, 7 U.S.P.Q. 121 (P.O. Bd. App. 1907).

⁴³ 271 F. 936, 938 (2d Cir. 1921).

A design patent grants somewhat broader exclusive rights to the patentee than do the copyright statutes. The holder of a design patent has the exclusive right to make, use, or sell his design for the term of his patent.⁴⁴ This statutory protection is in the architect's *design* and therefore goes to the appearance of the structure he has designed rather than being limited to his drawings as is the copyright protection. Therefore the design patent protection is much more desirable to the architect because it protects the very basis of his work product—the appearance of the structure.

II. OBTAINING PROTECTION

The process for obtaining copyright protection is relatively simple and inexpensive. As explained in Division I, common-law copyright attaches at the moment the architect creates his work. If an architect wishes to obtain the advantages of statutory protection, all he need do is affix a notice of copyright to each copy published or offered for sale, complete a form provided by the copyright office, and send the form and two complete copies of the work to the register of copyrights. The form of notice should be "copyright," "copr.," or "c" in a circle followed by the name of the author and year of the first publication. The cost of registration is a minimal \$4.00. The period of protection is twenty-eight years, and at the end of this time the author may extend his protection for one additional twenty-eight year term.⁴⁵

Application for a design patent is a much more complicated process. The application must include drawings of the design claimed, a specification describing the drawings, and a claim of the design.⁴⁶ The term for a design patent may be 3½, 7, or 14 years, any one of which the applicant may select. The fees for those terms are \$10, \$20, and \$30 respectively, plus a general filing fee of \$20.⁴⁷ There are no provisions in the patent statutes for renewal. It is generally not a good idea to apply for a design patent without first running a patent search to see what the chances of issuance will be. Therefore, it can be seen that the services of a patent lawyer are probably necessary to properly prosecute the application. This is particularly true because of the fact that communications between the applicant and the patent office relating to the patentability of the design will most likely ensue.⁴⁸ There is no doubt that from the viewpoint of cost, ease, and simplicity of obtaining protection, the design patent is less desirable than the copyright.

III. COVERAGE BY BOTH COPYRIGHT AND DESIGN PATENT

Originally, when anyone had a work which could be protected under either the design patent or copyright statutes, he had to make an election as

⁴⁴ 35 U.S.C. § 271(a) (1966).

⁴⁵ The portions of the copyright act outlining the procedures for registering a copyright are 17 U.S.C. §§ 10, 17, 19, 24, 215 (1966).

⁴⁶ 37 C.F.R. §§ 1.152-154 (1967).

⁴⁷ See 35 U.S.C. §§ 41, 173 (1966).

⁴⁸ 37 C.F.R. § 1.104(a) (1967).

to one type of protection or the other.⁴⁹ This rule was seriously questioned as a result of the series of four *Stein* cases.⁵⁰ In all these cases the plaintiff had acquired copyright registration under section 5(g) of the copyright act for statuettes of dancers. The plaintiff was using the statuettes in lamps which he was successfully marketing. The only issue raised was whether the utilitarian purpose of the statuettes precluded their registration as works of art. Two of the cases held that the lamps were not registerable,⁵¹ and two held that they were validly registered and infringed.⁵² The two holding the statuettes not registerable employed an intention test—that is, if the subject matter is intended to be put to a practical use, it is not registerable. The other two cases rejected this test.

The Supreme Court resolved this conflict in *Mazer v. Stein*,⁵³ rejecting the intention test and holding that works of art such as the statuettes were registerable under the copyright statute even though they were being used as articles of manufacture. It further held that patentability of the statuettes did not preclude their registration under the copyright laws. The Court did not hold, but hinted, that the old election doctrine was incorrect and that the protection under one statute would not preclude protection under the other.⁵⁴ The question of whether or not design patent protection precludes copyright protection or vice versa has never been expressly decided by the courts. In one case,⁵⁵ the plaintiff brought action for both design patent and copyright infringement, but since the copyright office had rejected registration, the court only granted protection under the design patent. The court expressed the belief that while the cases were unsettled as to whether or not a plaintiff could successfully prosecute for infringement of both a design patent and a copyright, reliance upon both claims was not a reprehensible practice.⁵⁶

IV. INFRINGEMENT

A. Copyright

For the purpose of discussing infringement, common-law and statutory copyright will be treated together because the rights which arise under each

⁴⁹ *Korzybski v. Underwood & Underwood, Inc.*, 36 F.2d 727 (2d Cir. 1929).

⁵⁰ *Rosenthal v. Stein*, 205 F.2d 633 (9th Cir. 1953); *Stein v. Mazer*, 204 F.2d 472 (4th Cir. 1953); *Stein v. Expert Lamp Co.*, 188 F.2d 611 (7th Cir. 1951); *Stein v. Benaderet*, 109 F. Supp. 364 (E.D. Mich. 1952).

⁵¹ *Stein v. Expert Lamp Co.*, 188 F.2d 611 (7th Cir. 1951); *Stein v. Benaderet*, 109 F. Supp. 364 (E.D. Mich. 1952).

⁵² *Rosenthal v. Stein*, 205 F.2d 633 (9th Cir. 1953); *Stein v. Mazer*, 204 F.2d 472 (4th Cir. 1953).

⁵³ 347 U.S. 201 (1954).

⁵⁴ Solum, *Design Patents and Copyrights; The Present Inadequate State of the Law*, 32 So. CAL. L. REV. 188 (1959); Michaelson, *The Nature of the Protection of Artistic and Industrial Designs*, 9 MIAMI L.Q. 148 (1954); Pogue, *Borderland—Where Copyright and Design Patent Meet*, 52 MICH. L. REV. 33 (1953).

⁵⁵ *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 155 F. Supp. 932 (S.D.N.Y. 1957).

⁵⁶ *Id.* at 936.

are the same except statutory rights may be exercised after, as well as prior, to publication.⁵⁷

The essence of copyright infringement is the copying of a substantial portion of the work by the infringer.⁵⁸ The elements which a plaintiff must prove are plaintiff's ownership in the copyright and copying by the defendant.⁵⁹

The element of ownership involves proving the originality of the author and the copyrightability of the subject matter. It is seldom difficult to show ownership of a statutory copyright because a registration certificate constitutes prima facie evidence that plaintiff is the owner.⁶⁰ To show ownership of a common-law copyright it is necessary to prove that the plaintiff created his work through his own independent effort.

Copying is the more difficult element to prove because, unless there is a witness to the copying, it must be proven by indirect evidence. This consists of showing that the defendant had access to plaintiff's work and that there is substantial similarity between his work and the plaintiff's.⁶¹ There is great difficulty in establishing what constitutes substantial similarity and the test is somewhat arbitrary and vague.⁶² Some courts have said that actual viewing of plaintiff's work by the defendant is necessary to show access, and others have held a showing of opportunity to view is sufficient to show access.⁶³

Thus the defendant in a copyright infringement suit has a good chance of defending his case merely by attacking the plaintiff's proof of the necessary elements. In addition, the defendant has several affirmative defenses: fair use; abandonment; and independent creation. The basis of the fair use defense is that if the defendant's use of the plaintiff's work does not diminish or prejudice the potential sale of plaintiff's work, the defendant is not liable for infringement. For example, a man who had a copyright on speeches he had made publicly could not preclude a publisher from publishing a book with some of his speeches in it if the book in no way competed with the speaker's use of his copyright. Such a use by the publisher was a "fair use."⁶⁴

Abandonment occurs when there is an intent by the owner of a copyright to surrender the rights in his work to the public. In the case of *DeSilva Constr. Corp. v. Herral*⁶⁵ the court found that an architect had abandoned his copy-

⁵⁷ *Echevarria v. Warner Bros. Pictures, Inc.*, 12 F. Supp. 632 (S.D. Calif. 1935).

⁵⁸ *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354 (9th Cir. 1947).

⁵⁹ There are conflicting views as to which element a court should consider first. In *Tralins v. Kaiser Aluminum & Chem. Corp.*, 160 F. Supp. 511 (D.C. Md. 1958), the court held that it made no difference in which order they were considered.

⁶⁰ 17 U.S.C. § 209 (1966).

⁶¹ *Whitney v. Ross Jungnickel, Inc.*, 179 F. Supp. 751 (S.D.N.Y. 1960); *Alexander v. Irving Trust Co.*, 132 F. Supp. 364 (S.D.N.Y. 1955).

⁶² For cases discussing the test of substantial similarity see *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930).

⁶³ A case requiring actual viewing is *Malkin v. Dubinsky*, 203 N.Y.S.2d 501 (Sup. Ct. 1960). A case requiring only an opportunity to view is *De Acosta v. Brown*, 146 F.2d 408 (2d Cir. 1944).

⁶⁴ *Public Affairs Associates, Inc. v. Rickover*, 284 F.2d 262 (D.C. Cir. 1960).

⁶⁵ 213 F. Supp. 184 (M.D. Fla. 1962); see also *National Comics Pub., Inc. v. Fawcett Pub., Inc.*, 191 F.2d 594 (2d Cir. 1951).

right protection in his plans by exhibiting them to a limited group without copyright notice affixed to them and by unrestricted exhibition of the resulting structure.

The defendant may also raise the defense of independent creation. This defense attacks the plaintiff's evidence that there was a copying. For example, a defendant who wrote a play which was substantially similar to the plaintiff's play was not an infringer because he had created the play through his own creative skills and had not copied the plaintiff's work.⁶⁶

It may be observed from the above discussion of copyright infringement that the most critical issue in a suit will be the question of whether or not the defendant copied the plaintiff's work. Because of the necessity for indirect proof, the plaintiff will quite often have difficulty proving copying. An architect will be particularly susceptible to the defense of abandonment since he must necessarily exhibit his work if he is to follow it through to completion. Also, it should be noted that the architect cannot support an action against another designer who has produced the architect's design through his own independent creative skill. In such a situation there has been no copying of the plaintiff's design.

B. *Design Patent*

A design patent is a grant of a monopoly in the design. The patentee who has a design patent has the right to bring an action for infringement against anyone who makes, uses, or sells his patented invention.⁶⁷ This is a much broader protection than that of a copyright. For example, the question of access, so important in a copyright suit, is not material to patent infringement. The fact that the defendant may have produced the design entirely through use of his own inventive skill is no defense to a patent infringement suit. The nature of a patent monopoly was aptly described by Robinson in his 19th century treatise on patents: "Every new patent thus closes up another avenue of research against all the world, thwarts the endeavors of the human mind in that direction, and to benefit one individual deprives all others of the right to profit in the same way by their own inventive powers."⁶⁸

The general test for infringement is whether the two designs have substantially the same effect on the eye of the ordinary observer, giving such attention as the purchaser usually gives, so as to deceive and induce him to purchase in the belief that one is the other.⁶⁹ This is somewhat broader than the requirement of substantial similarity in copyright infringement because imitation of the plaintiff's design is not required.⁷⁰ Apparently the test is the

⁶⁶ *Rosen v. Loew's Inc.*, 162 F.2d 785 (2d Cir. 1947).

⁶⁷ 35 U.S.C. § 271 (1966); *George Close Co. v. Ideal Wrapping Mach. Co.*, 29 F.2d 533 (1st Cir. 1928); W. ROBINSON, PATENTS § 13 (1890).

⁶⁸ W. ROBINSON, PATENTS § 28 (1890).

⁶⁹ *Sears, Roebuck & Co. v. Talge*, 140 F.2d 395 (8th Cir. 1944).

⁷⁰ *Edison Elec. Appliance Co. v. Fitzgerald Mfg. Co.*, 32 F.2d 705 (2d Cir. 1929).

reciprocal of the novelty test applied to an applicant for a patent. That is, if plaintiff's patent would be such as to render defendant's design not novel, then the defendant's use of his design is infringement.

The major and most successful defense raised in a patent infringement suit is that the patent is invalid. A patent must be valid to support a claim of infringement.⁷¹ The issuance of a patent affords prima facie evidence of validity, which must be considered in a patent infringement suit.⁷² This rule is one of the biggest anomalies in the field of patent law. A survey of the various circuits in the United States reveals that courts give little more than "lip service" to this presumption.⁷³ Further, it appears that a patent stands a poorer chance of survival in some circuits than in others.⁷⁴ Thus it can be seen that while a design patent provides a wider scope of protection to the architect, there is a high probability that the court will overrule the patent examiner's decision that the patent is valid.

V. REMEDIES AVAILABLE

A. Copyright

Again, because common-law and statutory copyright are co-extensive in respect to the remedies available, there is no need to distinguish between the two in this respect.⁷⁵ An architect who has won a copyright infringement suit may receive an injunction to restrain further infringement, damages and profits, destruction of infringing copies, court costs, and sometimes attorney's fees.⁷⁶ Section 101(b) of the copyright act sets out an express method for determining profits and damages. First, in proving profits the plaintiff need only prove sales, and the burden is then on the defendant to prove costs. Next, in lieu of actual damages or profits, the court may, in the case of no proof of profits or damages, or in the case of proof of profits and damages less than \$250, set damages between \$250 and \$5,000 according to its discretion. However, the plaintiff is always entitled to no less damages than he actually proves.

Section 116 provides that attorney's fees "may" be awarded by the court. Generally the allowance and amount of attorney's fees are within the discretion of the court and are to be awarded only where dictated by equity and good conscience.⁷⁷

⁷¹ 35 U.S.C. § 282 (1966); *Reynolds v. Whitin Mach. Works*, 167 F.2d 78 (4th Cir. 1948).

⁷² *Avery v. Ever Ready Label Corp.*, 104 F. Supp. 913 (D.C.N.J. 1952).

⁷³ Walter, *A Ten Year Survey of Design Patent Litigation*, 35 J. PAT. OFF. Soc'y 389, 390 (1953).

⁷⁴ For example, the author found that in the years 1956-1966 approximately 10% of the patents litigated in the 8th circuit were ruled valid, 40% were valid in the 6th circuit, and 60% were valid in the 5th circuit.

⁷⁵ *Echevarria v. Warner Bros. Pictures, Inc.*, 12 F. Supp. 632 (S.D. Calif. 1935).

⁷⁶ 17 U.S.C. §§ 101, 116 (1966).

⁷⁷ *National Brass Co. v. Michigan Hardware Co.*, 75 F. Supp. 140 (W.D. Mich. 1948).

B. Design Patent

If the architect is successful in a design patent infringement case, he may receive almost the same remedies as for copyright infringement. He may receive an injunction on such terms as the court deems reasonable,⁷⁸ damages which are to be no less than a reasonable royalty, and possibly treble damages.⁷⁹ Generally the court will only grant treble damages if the infringement is deliberate and intentional or wanton and persistent.⁸⁰ In exceptional cases, when unjustified and vexatious litigation is clearly shown, the court may award reasonable attorney's fees.⁸¹ These remedies are common to all patent infringement suits. In addition, a special statute⁸² provides that, in the case of infringement of a design patent, the plaintiff may recover total profits or two hundred fifty dollars, whichever is greater.

CONCLUSION

This note has dealt with some of the problems relative to obtaining and enforcing protection for architectural plans and structures. The architect faces a dilemma in trying to decide which type of protection best suits his interests. Common-law copyright provides protection for his drawings only, and even these common-law rights may possibly be lost through publication. However, he can obtain a limited protection through an agreement between the client and himself. In such a case, the terms of the contract will prevail in spite of the fact that common-law copyright is lost through publication.

If the architect desires a broader protection, he must obtain either statutory copyright or design patent protection. Most architectural drawings are the proper subject matter for copyright protection as technical writings under section 5(i) of the copyright act. However, such protection is limited to the drawings only and does not extend to the structure itself. Certain architectural works qualify as works of art under section 5(g). However, the design must pass the severe test applied to works of art before this section will grant protection. If the work qualifies as a work of art, the architect has the exclusive statutory right to build one structure. After building this single structure his rights are probably limited to the drawings only.

Obtaining copyright protection is a relatively simple and inexpensive matter. Also, in an infringement action there is small likelihood that the validity of the copyright will be questioned. The big disadvantage of copyright protection is that the scope of protection is limited to the drawings which are not a final manifestation of the architect's work product. Also, because of the requirement of showing copying to prove infringement, it is often difficult to successfully prosecute infringers.

⁷⁸ 35 U.S.C. § 288 (1966).

⁷⁹ 35 U.S.C. § 286 (1966).

⁸⁰ *Coleman Co., Inc., v. Holly Mfg. Co.*, 269 F.2d 660 (9th Cir. 1959).

⁸¹ 36 U.S.C. § 285 (1966); *Phillips Petroleum Co. v. Esso Standard Oil Co.*, 91 F. Supp. 215 (D.C. Md. 1950).

⁸² 35 U.S.C. § 289 (1966).

A design patent, on the other hand, directly covers the work product of the architect—the design and appearance of the building. If its validity could be counted upon, the design patent would provide ideal coverage for the architect. However, the fact that the validity of the design patent is always questioned in an infringement suit, and the frequency with which courts rule patents invalid leaves the architect in a very insecure position. His dilemma becomes increasingly frustrating with the knowledge that he may expend much time, money and effort in obtaining a design patent, only to have the court strike it down.

Perhaps the answer is to obtain both types of protection. The *Stein* and *Vacheron* cases, while not expressly holding so, indicated that the law will allow double coverage. Another course which architects may pursue is to seek legislation which will grant a type of protection under either the copyright or patent laws which is particularly adapted to the architect's needs.

MICHAEL G. VOORHEES

TAX, TURPITUDE, AND A TECHNICAL TEST FOR DISBARMENT

In infrequent cases when an attorney runs afoul of the law it is not unusual that his offense is failure to pay personal income taxes. The manner in which he is treated by the Bar after his tax problems have been settled has brought widely diverging results, ranging from a mere reprimand to permanent disbarment. A critical look at this area of the law reveals that certain corrections may be long overdue, and the question remains whether or not the course charted in decisions of the last decade have supplied a basis for a fair and uniform solution to the problem. It is conceded that an attorney's tax infractions must be viewed in the historical perspective of general disbarment procedures.

Almost from its inception the profession of the law has been subject to regulation to protect the public interest.¹ It was soon recognized that requirements for admission to practice were alone inadequate to maintain consistently high ethical standards.² A continuing supervision was indicated because the profession occupied a unique position of trust and confidence, the breach of which could result in irreparable harm.³ While early legislatures championed the rights of citizens in this area, with the rise of bar associations there has been a gradual shifting of responsibility from the former to the latter, with the end of the transition not yet completed.

In Iowa there are five express grounds for revocation or suspension of a license to practice law.⁴ Significantly, conviction of a felony or a misdemeanor

¹ In 1292 the King of England placed control of the bar in the hands of the justices. 2 HOLDSWORTH, *HISTORY OF ENGLISH LAW* 311-319 (4th ed. 1936). See also 3 BLACKSTONE *COMMENTARIES* *25.

² Parliament reasoned a statute would remedy the situation. Note the enactment asserts that attorneys are part of the judiciary and their admission and disbarment is a court function.

Item, For sundry Damages and Mischiefs that have ensued before this Time to divers Persons of the Realm by a great Number of Attornies, ignorant and not learned in the Law, as they were wont to be before this time; (2) it is ordained and established, That all the Attornies shall be examined by the Justices, and by their Discretions their Names put in the Roll, and they that be good and vertuous, and of good Fame, shall be received and sworn well and truly to serve in their Offices, and especially that they make no Suit in a foreign Country; and the other Attornies shall be put out by the Discretion of the said Justices; (3) and that their Masters, for whom they were Attornies, be warned to take others in their Places so that in the mean Time no Damage nor Prejudice come to their said Masters. (4) And if any of the said Attornies do die, or do cease, the Justices for the time being by their Discretion shall make another in his Place, which is a vertuous Man and learned, and sworn in the same Manner as afore is said; (5) and if any such Attorney be hereafter notoriously found in any Default of Record, or otherwise, he shall forswear the Court, and never after be received to make any Suit in any Court of the King.

⁴ Hen. IV. c. 18 (1402). The statute is cited in *State v. Cannon*, 206 Wis. 374, 240 N.W. 441 (1932).

³ During the reign of Elizabeth I, a special jury was empaneled to investigate the profession and during the Cromwell regime both King's Bench and Common Pleas formed juries every third year to put an end to unethical practices.

⁴ IOWA CODE § 610.24 (1966) lists the following as sufficient cause for revocation or suspension:

1. When he has been convicted of a felony, or of a misdemeanor involving moral