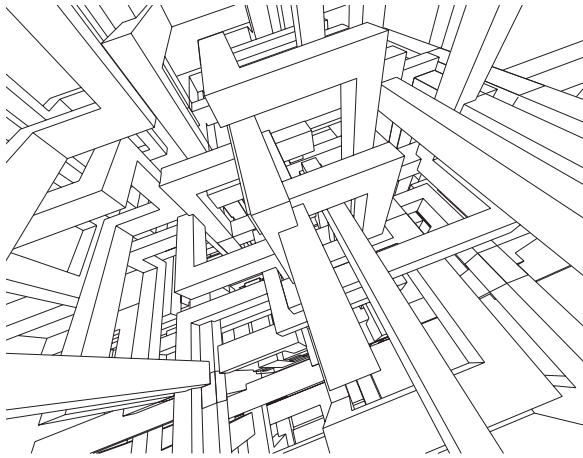


Legal Perspective

PROFESSIONAL DESIGN IMITATION: FLATTERY OR ACTIONABLE?

By Robert Blumling

In Ayn Rand's paradigm novel about self-principled commitment, *The Fountainhead*, the manipulation of the design of protagonist architect Howard Roark results in a disastrous, shattering consequence for the subject edifice, as well as the most famous literary legal trial involving an architect. Yet, if imitation is the sincerest form of flattery, where is the line drawn between design plagiarism, use of accepted design concepts and principles, or manipulation of intent? Is the replication of professional design concepts and documents merely flattering; or, does it become actionable in a way that exposes the admiring mimic to significant direct, consequential and punitive damages?



The issues of ownership of professional design have several components found in common law, statutory law and contract law. There exist both historical distinctions and connections between utilitarian purposes and design concept, as well as between ideas and design documents.

Since 1990, the Architecture Works Copyright Protection Act ("Act") has provided a statutory guideline for issues that were previously left to general intellectual property and copyright statutes, as well as contractual negotiations. Prior to the adoption of the Act, litigation abounded over whether architects' and engineers' ("A/E") professional designs were protected by general copyright laws, and to what extent.

The Act has been interpreted and applied in numerous court cases since its enactment. These cases have ranged from projects involving the Freedom Tower (the replacement for the predecessor World Trade Center Towers), as well as local Pennsylvania cases. One local case, *Morgan v. Hawthorne Homes, Inc.*, in the United States District Court for the Western District of Pennsylvania, provides a roadmap to protecting a party's professional design rights.

The case discusses the importance of valid registration of the plans and specifications before one can maintain a copyright infringement claim; a discussion of copyright owner's infringement claims; and distinguishes between direct, vicarious and contributory infringement.

There are many nuances to both compliance with the Act and enforcement of rights under the Act. The Act requires dual registration by architects/engineers ("A/E") in order to protect their design professional copyrights. The plans/specifications and the work itself must be registered separately with the Register of Copyrights at the Copyrights Office in the Library of Congress. The Act can only protect the design if it incorporates pictorial, graphic or sculptural features that can be identified separately from the utilitarian aspects of the

work. A fundamental premise is that the design inspiration is something capable of being protected separate and apart from the design documents (e.g., drawings, specifications, etc.) themselves. There also is the issue as to whether the work performed by the A/E is "work for hire," and thus arguably the property of the project owner.

Whether an A/E's work is merely an idea, or whether it is an expression of an idea that is subject to being protected by the Act, has been discussed in numerous federal court cases. Violations of the Act can expose the design replicator to damages that include the A/E's lost profits on the original project design; lost profits that the A/E would have earned on the project design that was utilized with a different design professional; and punitive damages.

In addition to the statutory protections afforded A/E design professionals, the issue of design concept and design document ownership, use and replication are interests that need to be addressed in a contractual context. Rather than leaving matters to statutory and judicial interpretation, design professionals, contractors and project owners should all agree in their various contract documents as to the use and ownership of all design intellectual property, utilitarian aspects, design expression and design documents. Obviously, the resolution of these issues should be consistent and comprehensive throughout all project documents notwithstanding the identity of the parties to any particular contract.

In addressing the issue of design ownership, the standard AIA documents all contain provisions indicating that the ownership of the design contract and documents remains with the author. This approach continues in the latest AIA documents for project delivery, including the E201-2008 Building Information Modeling Protocol Exhibit.

However, there are times when parties involved in a project need to consider departures from the standard document terms. For example, in the traditional Part I and Part II design/build or guaranteed maximum price ("GMP") project delivery schemes, the contracts may need to be revised to address possible alternative project deliveries.

On any given design/build project, or even GMP projects that contain pre-construction services involving design, but provide for separate, alternative approaches to project construction and administration (e.g., if a GMP is not

documents for that project. It is imperative that ownership rights extend to both concepts and documents.

Conversely, the A/E design professional may want to negotiate the right to limit the use of the design to a single particular instance. Further, the original designer might also want to negotiate a fee to be paid for the use of the project design if the work is to be completed by someone else, as well as for possible contractual indemnifications from future liabilities that might be claimed to arise from the design.

The single largest advantage in addressing all of these in contract terms (and not just relying upon the standard template language in contract forms) is that it eliminates much of the guessing game in favor of certainty in all regards. For example, whether something is similar in a "substantial" sense to a previous design can be a question that is ultimately submitted to a jury.

... EXPRESS CONTRACTUAL TERMS (AS OPPOSED TO PROTRACTED LITIGATION).


agreed upon between the initial contracting parties), then the owner needs to make certain that they will be able to use the design documents, concepts and purposes if the project constructor and/or administrator is different than the original author of the documents. That is a situation that can happen quite frequently in design/build or GMP projects.

Contracts should also include provisions for continued rights in the intellectual design property and project design documents following any termination of any contract – whether for cause or for convenience – as well as during any disputes, litigation or arbitration involving payment for the same.

The joint ownership of copyright protected materials is a legal tool that allows multiple parties to the agreements to have ownership and use rights that may or may not be limited in time or geography and may or may not be subject to future compensation on subsequent, unrelated projects. Exclusive and non-exclusive rights in intellectual property design are adaptable to a structure of joint ownership. As with most contract-drafting, the full intent and desires of the parties should be explored; but, the objectives of the parties can be met in a contractual context that addresses anything they might imagine or wish for long after the initial project is completed. The use of express contract terms also eliminates the prospect that a party subsequently raises the more amorphous issues of alleged verbal assignments or licenses by implication with respect to design work.

Obviously, the preferred way to resolve any of these issues is through express contractual terms (as opposed to protracted litigation). In the event that the original design professional and their documents are not retained through the project completion, then the owner needs to make certain they have the right to permit others to use those

In one instance, this author was involved in a case between two manufacturing companies that arise from an alleged contractual copyright violation of engineered equipment design drawings. One of the parties claimed that the alleged infringing drawings were simply the result of "reverse engineering" that was readily available to anyone who understood the function of the machinery. In that case (which was settled), as well as in reported cases, courts will look at whether the alleged infringement is really "reverse engineering". In doing so, a court most certainly will look at matters such as the case in point that I referenced where the alleged "reverse engineering" was so identical to the patented design that it actually incorporated typographical errors from the original design documents. That fact alone eliminated any argument of "reverse engineering" as opposed to outright patent infringement.

Brancusi said that architecture is sculpture that we inhabit. In order for parties in any given construction project to avoid the consequences of *The Fountainhead*, then this author recommends that they sculpt an architectural framework within their project contractual documents, which recognizes the statutory rights as well as addresses the contractually negotiated rights and obligations of all parties as to the ownership, use and replication of design. In that manner, the project contracts themselves become an architectural framework in which all parties and their ideas can cohabit in harmony. 

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