

Intellectual Property: Trademark, Patent, and Copyright Basics

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August 2006

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The information herein should not be regarded as a substitute for legal advice. Readers are strongly advised to consult an attorney for advice regarding any matter related to intellectual property infringement.

SUMMARY

Intellectual property (IP) law distinguishes overlapping principles of established laws. The three aspects of IP law most relevant to the architecture profession are copyrights, trademarks, and patents. Readers will glean a basic understanding of these three areas of IP protection.

INTELLECTUAL PROPERTY AND THE DESIGNER

Design professionals should be aware of IP claims as a source of risk. The client is often the source of claims. From 1995 through 2004, however, other design professionals initiated 40.3 percent of IP claims. In those same years, residential projects represented 44.3 percent of all claims. Each claim incurred average costs of \$40,000, but the top 10 percent of the claims incurred an average of \$175,000.

TRADEMARK

A trademark law protects words or symbols that a commercial entity uses to indicate the source of goods. In short, it is a mark to help the consumers identify the source of goods or services. A trademark can become synonymous with a particular product or service if distinctive and properly used. Consider the Nike swoosh, for example. The simple logo is not obviously representative of anything, but it is now one of the most recognized symbols in sportswear.

Any mark can qualify as a trademark if they are not

- Immoral, deceptive, or scandalous
- An insignia of the United States or any state or local municipality
- A name, portrait, or signature of a living individual except by consent

- A resemblance of a registered mark so as to confuse, mistake, or deceive
- Merely descriptive or primarily geographically descriptive

Use a mark to help identify your products and services from those of another. Use caution in how you use and protect your trademark. Companies have lost their trademarks because they became so synonymous with particular products that they lost their distinctiveness. Examples include "linoleum" and "escalator," both of which were once protected trademarks.

What is required to obtain a trademark? Secure a trademark by submitting an application, filing fee, and drawing of the mark; in renewing a trademark, a picture of the mark is required. Trademarks initially last for 10 years and can be renewed. The patent commissioner can cancel or refuse to renew a trademark at any time. A valid trademark must carry the trademark symbol, TM, or the registration symbol, ®.

What is trade dress? Trade dress is a legal theory of recovery that considers the "total appearance and image of a product, including features such as size, texture, shape, color combinations, and graphics." It is not a mark that is registered. Elements of trade dress may be protectable under copyright law as well.

In a case that involved the interior design of two restaurants (*Fuddruckers Inc. v. Doc's B.R. Others Inc.*), the court held that "a restaurant's décor, layout, and style of service could constitute protectable trade dress entitling a plaintiff protection against a restaurant simulating its protected ambience." So, not only can a mark help identify a particular company, but the interior ambience as well.

PATENT

Patent law protects inventions. The patent gives the patent holder the right to exclude others from making, using, offering for sale, or importing the invention into the United States. A patent can be granted for “any new and useful process, machine, manufacture, or composition matter or any new and useful improvements.”

Categories of patents include utility and design patents. A patent must be useful, which is broadly interpreted, and it must be new or novel in nature. “Novel” means unknown or not used by others in this country and not patented or described in a printed publication.

What is needed to obtain a patent? To secure a patent, you must file an application with the U.S. Patent and Trademark Office (USPTO) along with the required fee and supporting documents, usually consisting of a drawing of how the invention should work. Patents are granted for 20 years from the date the patent was filed. The item must also be marked with the word “patent” and the patent number issued by the patent office. Patents, like trademarks, can be transferred or licensed to others.

What is a design patent? Most patents are granted as a utility patent, protecting how an article is used and works. A design patent protects how an article *looks*. It is granted to anyone who has invented a new, original, and ornamental design for an article of manufacture and protects only the article’s appearance, not its structural or utilitarian function. In this situation, design consists “of the visual ornamental characteristics embodied in or applied to an article of manufacture.”

Let’s assume no one ever invented the belt buckle. A belt buckle would be useful, and since it has never been invented, it meets the “novel” requirement to qualify for a utility patent. If it contains ornamentation that enhances its appearance but remains separate from its utilitarian features, the inventor can also obtain a design patent. Design patents may also qualify for protection as copyrighted works.

COPYRIGHT

The U.S. Copyright Act protects “original works of authorship fixed in any tangible medium of expression.” Copyright laws give the author of an original work the exclusive right to reproduce or display that work. Protection is not extended to procedures, processes, or systems; a copyright is given to an idea that has been developed enough to be fixed in a tangible medium of expression, but

procedures and processes are usually matters for patent law.

Should I be concerned about my copyright?

According to statistics from 1995 to 2004, 95.2 percent of IP claims against architects and engineers involved allegations of copyright infringement.

What is required to obtain a copyright?

Registration is not required for a valid copyright, but it does constitute prima facie evidence of a valid copyright and shifts the burden to the defendant to prove invalidity. Registration is required before a claim of copyright infringement can be filed and can factor into an award of damages and attorneys’ fees. Register by filing the appropriate documentation and fee with the U.S. Copyright Office. Affix the copyright symbol (©), year of publication, and name of the copyright holder as notice that the item is copyrighted.

Who owns the copyright? Ownership is vested with the work’s author, except in the case of works made for hire. Under U.S. law, “works made for hire” include work prepared by an employee in the scope of employment as well as works specifically ordered or commissioned. Architectural works, however, are not generally considered works made for hire unless an agreement between the parties specifically says so.

Ownership is not the same as copyright. If you buy a book, you own it and can sell it, burn it, or give it as a gift, but you do not own its copyright. The same is true of a design professional’s instruments of service. Clients often believe that because they paid the design professional and possess a set of drawings, they own the copyright. This is not true. An actual transfer of copyright is required for the client to obtain the copyright to the design professional’s instruments of service.

What are the categories of copyright protection?

Categories of copyright protection cover numerous forms of creative expression:

- Literary works
- Musical works
- Dramatic works
- Pantomimes and choreographic works
- Motion pictures and other audiovisual works
- Sound recordings
- Pictorial, graphic, and sculptural works
- Architectural works

The “architectural works” and “pictorial, graphic, and sculptural works” categories protect design professionals for their instruments of service. Pictorial, graphic, and sculptural works—or “visual works”—include two- and three-dimensional works of fine, graphic, and applied art. Examples include technical drawings, architectural plans, diagrams, and models.

In 1990, the Architectural Works Copyright Protection Act (AWCPA) became effective. Before passage of the AWCPA, the U.S. Copyright Act protected only instruments of service (identified as “pictorial and graphic” works). The AWCPA specifically added architectural works as a protected category of original expression—defining an architectural work as “the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings.” This includes the overall form as well as the arrangement and composition of spaces and elements in the design, but it does not include individual standard features.

The AWCPA does not define the word “building.” However, an informational circular of the U.S. Copyright Office states that the AWCPA protects “structures that are habitable by humans and intended to be both permanent and stationary, such as houses and office buildings and other permanent and stationary structures designed for human occupancy, including but not limited to churches, museums, gazebos, and garden pavilions.”

Equally important are the items that the AWCPA does *not* protect, including “structures other than buildings, such as bridges, cloverleaves, dams, walkways, tents, recreational vehicles, mobile homes, and boats.”

How much copying is considered copying? The answer is not simple. Certain elements are required, however, for a claim of copyright infringement to succeed. First, a plaintiff must prove ownership of a valid copyright and subsequent infringement (copying) of a protected work.

As previously noted, access to the instruments of service by the defendant is another required element of a copyright infringement claim. Once ownership of a valid copyright has been established and access has been demonstrated, the next step requires proof that copying has occurred. To determine copying, courts look for “substantial similarity.”

A finding of “substantial similarity” requires first identifying which aspects of the author’s work are protected and then identifying which infringing elements are substantially similar to the protected

work. Some courts have found that substantial similarity exist when “the accused work is so similar to the plaintiff’s work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff’s protectable expression by taking material of substance and value.”

Substantial similarity requires a comparison of the two works’ individual elements in isolation and the works’ overall look and feel, even if the individual elements do not qualify for individual copyright protection.

Do I need to know anything else about copyright infringement? Of recent copyright infringement claims, 44.3 percent involved residential projects. Given the recent boom in the residential market, design professionals need to be careful that they do not violate someone else’s copyrights.

MANAGING IP RISK

Maintain your rights. Clients are increasingly asking design professionals to transfer patents and copyrights. You need to know that once you transfer these rights to any other party, that party has the exclusive right to reproduce the original expression embodied in the documents or to manufacture patentable ideas. If you choose to license or transfer your IP rights, be sure you receive indemnity for any claims that may arise from the client’s future use of the documents.

Obtain proof of transfer of licenses. You may be asked to provide services based on another design professional’s efforts or to complete that design professional’s services. In such instances, ask the client to provide proof of a valid transfer of patent and copyrights or proof that the client has been granted a license to use the documents for the intended purpose. Proof of patent or copyright transfer of an existing license can reduce the likelihood of IP infringement claims from other professionals.

Read agreements carefully. Look for language that may transfer IP rights to another party. The creator of an original work owns that work’s copyright from the moment of creation. Provisions stating that the services are works made for hire, however, automatically grant the copyright to the entity engaging the design professional’s services.

Use proper notice. Whether it is trademarked, patented, or copyrighted, it is important to properly mark your intellectual property. Although copyright notices are no longer required for drawings to be protected, they serve as a warning that the expression has been copyrighted, thus preventing

infringers from claiming they were unaware the work was a protected expression. In addition to affixing the notice to your work, you must register before an infringement claim can be filed.

Gain knowledge and use available resources.

Knowledge and understanding of the issues is one of the best ways to manage risks. The Web sites below can give you more detailed information.

SECURING YOUR RIGHTS

Trademark Filing—www.uspto.gov. An application to the USPTO must include the following:

- The name of the applicant
- A name and address for correspondence
- A clear drawing of the mark
- A listing of the goods or services
- The filing fee for at least one class of goods or services

File at www.uspto.gov/teas/index.html or mail to

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Patent Filing—www.uspto.gov. Submit a nonprovisional application for a patent to the USPTO director, including the following:

- A written document that comprises a specification (description and claims) and an oath or declaration
- A drawing if necessary
- Filing, search, and examination fees. The fee schedule is posted at www.uspto.gov

File at www.uspto.gov/ebs/efs/index.html or mail to

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Copyright Registration—www.copyright.gov. To register a work, send the following in one envelope or package:

- A properly completed application form
- A nonrefundable \$30 filing fee for each application
- A nonreturnable deposit of the work being registered. Deposit requirements vary across

situations; visit www.copyright.gov for more information.

If the work was first published in the United States, two complete copies of the work must be submitted to

Library of Congress
Copyright Office
1010 Independence Avenue, SE
Washington, DC 20559-6000

LESSONS LEARNED

It is important to understand the risk and rights involved with copyrights and understand how intellectual property relates to the architect. It is best to be one step ahead of competitors and clients and when the situations deem necessary apply for a copyright.

RESOURCES

More Best Practices

The following AIA Best Practices provide additional information related to this topic

- 09.01.02 Antitrust Compliance Guidelines
- 09.01.03 Warning Signs of Potential Claims
- 17.01.07 Copyright in Architectural Works

For More Information on This Topic

See also "Intellectual Property and the Architect" by Dale R. Ellickson, Esq, FAIA, *The Architect's Handbook of Professional Practice*, 13th edition, Chapter 11, page 316.

See also the 14th edition of the *Handbook*, which can be ordered from the AIA Bookstore by calling 800-242-3837 (option 4) or by email at bookstore@aia.org.



Keywords

- Leadership
- Legal issues
- Intellectual property



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