

CASE COMMENT: THE “STURDZA TEST” AND ITS IMPLICATIONS ON ARCHITECTURAL WORKS

V. K. Unni*

Introduction

The new embassy building of the UAE in Washington has been the subject matter of a copyright dispute between 2 architects. The ruling in *STURDZA ELENA v. UNITED ARAB EMIRATES*¹, by the United States Court of Appeals for the District Of Columbia Circuit, clearly analyses and clarifies many of the provisions of the U.S Copyright Act. Obviously this decision will have much significance in other jurisdictions also and the courts in such jurisdictions are very much likely to follow the test developed in this landmark case. Needless to state, this judgement will guide many courts throughout the globe to evaluate infringements regarding architectural works. It is interesting to note that in the US, courts have begun to accept the standards laid down by *Sturdza* in subsequent copyright infringement cases², the latest such affirmation being in May 2003.

To be simple the core of the case involves a dispute between two architects Elena Sturdza and Angelos Demetriou. Sturdza alleges that, Demetriou, has stolen her design for the United Arab Emirates’ new embassy. More than merely suing Demetriou and the UAE for copyright infringement, Sturdza also alleges that the UAE has committed breach of contract, and has also conspired to commit sex discrimination in violation of 42 U.S.C. § 1985. Further more, Demetriou has been charged with several torts: conspiracy to commit fraud, tortuous interference with contract, and intentional infliction of emotional distress.

The trial court³ held that the impugned design was not substantially similar” to Sturdza’s, and thereby granted summary judgment for Demetriou and the UAE on the copyright infringement claim. The district court also dismissed her breach of contract claim, concluding that District of Columbia law bars such claims by architects who have no D.C. architecture license; her tort claims, finding them pre-empted by the federal Copyright Act; and her

* Assistant Professor, NALSAR University of Law, Hyderabad.

1 *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 62 U.S.P.Q. 2d 1071 (DCC 2002). Judgement dated the 8th of March 2002

2 *Louis M. Kohus v. Mariol; James F. Mariol; JVM Innovation & Design*, 2003 FED App. 0150P (6th Cir.) decided on 20th May 2003, this case involved infringement of copyright regarding drawings of a latch that would lock the upper rails in place for use. This latch (“the 11-KMI86 latch”) was different from others in the sense that it had two flippers, or hinges, instead of one, and this gave it a two-step function that could make it safer than comparable latches. Full text of the decision is available at <http://pacer.ca6.uscourts.gov/opinions.pdf/03a0150p-06.pdf> visited on 23/1/2004

3 United States District Court for the District of Columbia

section 1985 claim, emphasizing that foreign governments are not “persons” within the meaning of the statute. Sturdza in the United States Court of Appeals has challenged the said decision of the trial court in appeal for the District Of Columbia Circuit. This decision rendered by Court of Appeals in the U.S is also significant to jurisdictions outside that country because it addresses some pertinent questions regarding copyright infringement especially with regard to architectural designs.

Brief facts

In 1993, the United Arab Emirates organised a competition for the architectural design of a new embassy and chancery building that it was planning to construct in Washington, D.C. They also provided a “Program Manual” which specified the requirements for various aspects of the design to the participants. As per the manual UAE’s intention was to build a “modern sophisticated multi-use facility expressing the richness and variety of traditional Arab motifs”. Both Sturdza and Demetriou⁴ submitted their respective designs that were judged by a very eminent jury comprising of architects and civil engineers. Ultimately UAE informed Sturdza that her design was selected.

After that Sturdza and the UAE started negotiations to finalize a contract. Atleast eight contract proposals were exchanged during the next two years. In late 1994, Sturdza was asked to make some minor amendments to the design and provide multiple, bound copies for UAE officials. Sturdza readily complied with both demands. After that UAE asked Sturdza to perform certain “geotechnical” engineering services needed to commence construction. For complying with this demand she even hired an engineer and assisted him in addressing various technical issues. In early 1996, the UAE sent Sturdza a final draft of the contract incorporating all the changes mandated by the Ambassador of UAE. Sturdza immediately informed the UAE authorities that she consented to these changes. But since then UAE has ceased communicating with her and has neither signed the contract nor replied to her repeated endeavours to establish contact.

In late 1997, Sturdza realized that UAE had presented an embassy design to the National Capital Planning Commission. To her astonishment she discovered that the design so submitted belonged to Demetriou and more interestingly it differed from his 1993 competition entry. She also noted that the said design of Demetriou has copied and appropriated many of the design features that had been the distinctive features of her design. There after UAE finalized the contract with Demetriou to use his revised design and began building its embassy.

4 Through his firm Demetriou & Associates

Sturdza sued UAE and Demetriou in the United States District Court for the District of Columbia. The district court granted summary judgment against Sturdza on her copyright infringement, breach of contract, and quantum merit claims and dismissed under Federal Rule of Civil Procedure 12(b)(6) her conspiracy to commit fraud, tortious interference with contract, intentional infliction of emotional distress, and section 1985 claims. This order of the District Court has been challenged in appeal before the United States Court of Appeals for the District Of Columbia Circuit.

The US Law on Copyright Infringement

The U.S. Copyright Act of 1976, as amended, protects “original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced or otherwise communicated, either directly or with the aid of a machine or device.”⁵ The Constitutional Provision on Copyright states that “*The Congress shall have 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*”⁶

The law here recognizes three specific opportunities for holding a party liable for copyright infringement they are direct, contributory, and vicarious liability⁷. Direct infringement shall take place when one party makes a copy of the copyrighted work, i.e., make use of one of the copyright owner’s exclusive rights without permission⁸. A simple example of direct infringement will be making unauthorized copies of a video CD for business purposes. More often than not the courts have very little difficulty in finding out direct infringement. It envisages strict liability: neither knowledge nor intent is required to find a party liable under this doctrine⁹.

Although the statute is silent on the concept of secondary liability, courts have accepted two types of secondary liability for copyright infringement – contributory and vicarious liability. According to the US Supreme Court¹⁰ the lack of specific reference to secondary liability within the Copyright Act does not preclude the imposition of liability on third parties.

5 See § 102 US Copyright Act

6 United States Constitution, Article I, Section 8

7 Unni V.K., *Internet Service Provider’s Liability for Copyright Infringement - How to Clear the Misty Indian Perspective*, 8 RICH. J.L. & TECH. 13 (Fall 2001) Full text at <http://law.richmond.edu/jolt/v8i2/article1.html> visited on 23/1/2004

8 See 17 U.S.C. § 106 (enumerating the exclusive rights of copyright owners); 17 U.S.C. § 501 (infringement occurs when alleged infringer violates at least one exclusive rights granted to copyright holders).

9 See 3-13 NIMMER ON COPYRIGHT § 13.08 (2000) (good-faith mistakes and ignorance do not constitute a defence to a finding of direct infringement, though they might affect damages).

10 See *Sony Corp. v. Universal City Studios Inc.*, 464 U.S. 417, 435 (1984).

To establish contributory liability, two conditions must be satisfied: the said party causes or contributes to the infringing activity¹¹ and (ii) the said party should know about the infringing conduct of the primary wrongdoer¹². For e.g. The act of distribution by individual A of unauthorized copies made by individual B would come under purview of contributory liability¹³.

Establishing vicarious liability consists of a two-pronged test:

- (1) Whether the defendant had the right and ability to supervise the misappropriation of the copyrighted work And
- (2) Whether the defendant had a direct financial interest in the exploitation of the copyrighted material¹⁴. Vicarious liability for copyright infringement extends beyond employer/employee relationship, and is much wider than those in torts. Moreover, whereas contributory infringement requires defendants to be aware of the infringement, here there is no such requirement¹⁵.

To understand the scope of direct liability is really easy but it is not that easy to distinguish between vicarious and contributory liability. The distinction is of significant practical importance due to the difference in the level of knowledge about the infringing activity required by each category. Whereas contributory liability requires some degree of awareness of primary infringement, vicarious liability is imposed regardless of the third party's state of mind concerning the primary infringement.

The Analysis

Coming to the present case, although many allegations were levelled against UAE and Demetriou, for the purpose of brevity this write-up would

-
- 11 See *Gershwin Publ'g Group v. Columbia Artists Management Inc.*, 443 F.2d 1159, 1162 (2d. Cir. 1971) (defining the contributing party as "one who... induces, causes or materially contributes to the infringing conduct of another"). See also *Matthew Bender & Co. v. West Publishing Co.*, 158 F.3d 693, 706 (2d Cir. 1998) (contributory liability exists if the defendant engages in "personal conduct that encourages or assists the infringement.")
 - 12 Several decisions have determined that it is sufficient, for establishing contributory liability, that the third party should have known about the infringing conduct. See *Cable/Home Communication Corp. Network Prods. Inc.*, 902 F.2d 829, 845 & 846 n.29 (11 th Cir. 1990) (requiring that the secondary infringer "know or have reason to know" of the infringement); *Religious Tech Center v. Netcom On-Line Communication*, 907 F. Supp. 1361, 1373-4 (N.D. Cal. 1995) (framing issue as "whether Netcom knew or should have known" of infringing activities.)
 - 13 *Prather v. Camerarts Publishing Co.*, 176 U.S.P.Q. 68 (N.D. Ill. 1972) (distribution).
 - 14 See *Shapiro, Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304, 307 (2d Cir. 1963) ("When the right and ability to supervise combine with an obvious and direct financial interest in the exploitation of copyrighted materials – even in the absence of actual knowledge that the copyright monopoly is being impaired – the purposes of copyright law be given effect by the imposition of liability upon the beneficiary of that exploitation.")
 - 15 See 3-12 NIMMER ON COPYRIGHT § 12.04 (2000) (noting that lack of knowledge that the primary actor is actually engaged in infringing conduct is not a defence under the doctrine of vicarious infringement.)

only focus on the aspect of copyright infringement, which came before the appeal court. In any copyright claim, the plaintiff has to prove the ownership of a valid copyright and that the defendant copied original or “protectable” aspects of the copyrighted work. This cardinal principle was also reiterated in the landmark case of *Feist*¹⁶. To succeed in such a case the plaintiff has to show that the defendant actually copied the plaintiff’s work and apart from that he has to prove that the defendant’s work is “substantially similar” to protectable elements of the plaintiff’s work. These two conditions are paramount in proving any allegation of copyright violation. While considering the aspect of substantial similarity the crux of the issue is to find out whether actual copying is legally actionable. Interestingly UAE and Demetriou never disputed Sturdza’s ownership of a valid copyright and Demetriou’s actual copying of Sturdza’s design. Their only argument is that Sturdza cannot prove substantial similarity.

Not all “copying” is actionable, however: it is a constitutional requirement that a plaintiff bringing an infringement claim must prove “copying of constituent elements of the work *that are original*.”¹⁷ Throughout the globe *originality* remains the main ingredient of copyright; accordingly, copyright protection may extend only to those components of a work that are original to the author. “Original here only means that the work was independently created by the author and not merely copied from other works and it has the minimum degree of creativity.

The Court noted that the question of substantial similarity involves two steps. The first involves the identification of the “protectable elements” of the artist’s work. This is in consonance with the well-known principle that “No author may copyright facts or ideas”. The copyright is limited to those aspects of the work—termed ‘expression’—that display the stamp of the author’s originality.”¹⁸ It further observed that copyright protection does not extend to what are known as “incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic, or elements that are “dictated by external factors such as particular business practices. This observation was made by relying on the decisions in *Computer Mgmt. Assistance Co. v. Robert F. DeCastro, Inc*¹⁹ and *Atari, Inc. v. North Am. Philips Consumer Elecs. Corp.*²⁰

After removing the unprotectable elements, the next stage is to find out whether the allegedly infringing work is “substantially similar” to protectable

16 *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 348, 361 (1991)

17 *Ibid.* at 340, 361

18 *Ibid.* at 350

19 220 F.3d 396, 401 (5th Cir. 2000)

20 672 F.2d 607, 616 (7th Cir. 1982)

elements of the artist's work. "Substantial similarity" is found to exist where "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 value²¹. More importantly substantial similarity must be determined by giving due importance to their "overall look and feel". This should be done in addition to the comparison of the two works' individual elements in isolation²².

Coming to the present case the Court of Appeals noted that the District Court rightly filtered out from Sturdza's design "domes, wind-towers, parapets, arches, and Islamic patterns" as they were unprotectable ideas. The Court observed that if an opposite view were taken it would only result in a denying the basic architectural elements to architects and would clearly make a mockery of the idea/expression distinction, which provides ample incentives for authors to produce original work while safeguarding society's interest in the free flow of ideas.

The Court of Appeals makes it crystal-clear that "Islamic" patterns are not protectable and classifies them as incidents, characters or settings that are as a practical matter indispensable, or at least standard, in the treatment of a given topic²³. The Court of Appeals while concurring with the District Court's view that Demetriou's design differs from Sturdza's also makes it clear that the District Court had overlooked several important aspects in which Demetriou's design expresses particular architectural concepts in a manner which is quite similar to Sturdza's. The Court finds certain important similarities in the "overall look and feel" of the two designs.

Examining the two designs, the Court of Appeals is convinced that, to a great extent Demetriou's design resembles Sturdza's. The size, shape, and placement of Demetriou's wind-towers, parapets, and pointed domes, when observed from the front portion, give his building an outline almost identical to Sturdza's. It also became very clear that both the buildings have in them a pyramid-like clustering of pointed arches around the front entrances, prominent horizontal bands and vertical columns demarcating the windows, slightly protruding midsections, diamond grids, and similar latticework patterning inside the arches. With the aim of giving an Islamic effect to the embassy building Demetriou expresses and combines his wind-towers, arches, dome, parapet, and decorative patterning in ways quite identical to Sturdza's expression and combination of these elements. These are all relevant facts to be considered, the Court added²⁴.

21 Case of Country Kids, 77 F.3d at 1288

22 See Sturdza supra fn 1

23 Ibid.

24 Ibid.

The Court of Appeals also commented a few words regarding the two expert declarations adduced by Sturdza during the trial stage. The first expert declaration was from a professor of Islamic art and architecture and another from a practising architect. Although the trial court had disregarded the declarations as irrelevant, the Court of Appeals emphasized that the use of expert testimony in copyright cases is a matter that is getting widespread judicial consideration. Earlier, expert evidence was allowed only to assist the juries to determine whether alleged infringer used the copyrighted work in making his own, i.e. actual copying²⁵. But this trend is currently witnessing a sea change as the courts have begun to permit expert testimony to find out substantial similarity in cases involving computer programs²⁶. This is mainly because of the fact that such evidence is inevitable because of the “complexity and unfamiliarity of computer programs to a vast majority of population. But the Court of Appeals found that no court has considered the question of accepting expert evidence to show substantial similarity of architectural works, and the Court for the time being declines to permit expert evidence in the arena of architectural works to show substantial similarity.

Decision

As such the Appeal is allowed. The grant of summary judgment for Demetriou and the UAE on Sturdza’s copyright claim is reversed and the case is remanded for trial. The Court of Appeals also reversed the dismissal of Counts Five, Six, and Seven (the tort claims) as to Demetriou. The question whether Sturdza’s contract and quantum merit claims are barred by the D.C. Law has been certified to the D.C. Court of Appeals. However the decision of the District Court to dismiss of Sturdza’s section 1985 claim is affirmed by the Court of Appeals²⁷.

Conclusion

Sturdza clearly demonstrates an important aspect of how courts are going to approach alleged copying of “buildings”. The court in *Sturdza* also noted that when determining whether a building is a copy of another protected building, the analysis should include the comparison between the overall “look and feel of the two buildings apart from the routine comparison of individual elements such as doors, windows or decorative elements.

This judgement will go a long way in framing certain guidelines for protecting architectural works. Obviously this decision can be of immense help to countries in other jurisdictions also when they have to deal with such cases.

25 Case of *Whelan Assocs. v. Jaslow Dental Lab. Inc.*, 797 F.2d 1222, 1232 (3d Cir. 1986)

26 Case of *Computer Assocs, Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 713-14 (2d Cir. 1992)

27 See *Sturdza* supra fn 1

The “*overall look and feel test*” which the appeals court had adopted taken will help a long way in promoting and protecting creativity with respect to such architectural works at the same time the court took adequate care to ensure that common elements like “domes, wind-towers, parapets, arches, Islamic patterns” are all unprotectable concepts which forms part of the public domain. This balanced approach of the court is very helpful in protecting original creative works and will help a lot to mould the emerging jurisprudence with regard to copyright infringement of architectural works.