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ARTICLE**WHO OWNS THE PLANS? OWNERS, ARCHITECTS AND
ENGINEERS, AND THE FEDERAL LAW OF COPYRIGHT**

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Bob has been saving up for his dream home his entire life. While not an architect himself, he follows architecture trends and visits buildings designed by Frank Lloyd Wright and I.M. Pei. After purchasing a plot of land on a hillside with a view of one of California's fertile wine-growing regions, he contacts an architect to convert his crude sketches and ideas into usable blueprints. They execute the standard, unaltered form contract for architectural services provided by the American Institute of Architects. The architect then completes the plans and the house is built. Bob is now living in a beautiful and unique house that reflects his personal style. Several years later, someone purchases the lot next door. Because Bob's house is so impressive, the neighbor also buys the blueprints from Bob's architect and announces his intention to erect an identical home. Has Bob's one-of-a-kind dream home become a model home nightmare, or does he have the right to claim ownership of the design and stop the copycat neighbor?¹

In another locale, Fran purchases land to construct a commercial development and, with a handshake agreement to cover the expenses, hires her cousin to draw up the engineering plans. Unfortunately, because of the economic downturn, Fran defaults on her loan and her bank forecloses on the property. After the foreclosure sale, the new owner contacts

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Fran's cousin and obtains the rights to the plans that Fran paid to produce. Is Fran's investment going into someone else's pocket, or can she prevent the lender from using the plans?²

Both Bob and Fran feel they should have the right to control the plans they purchased. The problem is, the plans may not be their property. But what *did* they pay for?

Although the Federal Copyright Act was passed in 1976 and preempted state law, many misconceptions based on prior state copyright law remain, not least of which is that a person who commissions architectural or other design services automatically owns the work product by virtue of payment.³ Under the Copyright Act, mere payment for architectural or other construction plans or designs does not confer exclusive rights to a landowner absent an express written license or transfer of ownership.⁴ The end result is that landowners who do not properly negotiate for rights under a contract for design documents could end up, at best, with only non-exclusive rights to use the documents, and thus, the documents might be sold out from under them without their consent.

This Article provides basic information about the position of parties negotiating for architectural, engineering, or other design services. It begins with an overview of the Copyright Act, including the rights and protections it provides and the materials subject to it. The next section explores ownership of copyrighted materials. The subsequent discussion presents the ramifications of failing to account, in writing, for copyright ownership and exclusivity when entering an agreement for design services, specifically the probable implication of a non-exclusive license in the design documents. Finally, the Article ends with an examination of the relatively simple process by which the parties, by contract, can transfer rights to copyrightable material.

THE COPYRIGHT ACT

Any discussion of intellectual property reduced to a tangible medium of expression must focus on the Federal Copyright Act of 1976 and its subsequent revisions. The Copyright Act was intended to eliminate the prior dual system under which state common law regulated unpublished works and federal statute governed published works.⁵ While "publication" still plays a vital role in copyright law, it no longer has jurisdictional implications.⁶ Federal law governs rights in all copyrightable materials. Furthermore, any suit enforcing a copyright must be brought in federal court, because federal courts have exclusive jurisdiction of all claims for copyright infringement.⁷ Such claims cannot be pursued in state court.

The Copyright Act protects "original works of authorship fixed in any tangible medium of expression," including "literary works," "pictorial, graphic, and sculptural works," and "architectural works."⁸ In the con-

struction document context, engineering drawings and subdivision maps are copyrightable as “pictorial, graphic, and sculptural works,” while written plans and CC&Rs are regulated as “literary works.”⁹ Copyright in these types of documents protects only the documents themselves; no protection is given to *construction* based on such documents.¹⁰

In contrast, “architectural works” are treated differently under the Copyright Act. Like engineering designs, architectural plans are also protected as “pictorial, graphic, and sculptural works,” but the 1990 amendments to the Copyright Act provide additional protection for “the overall form” of a constructed “building.”¹¹ Thus, a person cannot copy the design of a building from its constructed form any more than he or she can copy the plans from which it was constructed, without running afoul of the Copyright Act. “Buildings” are defined as “humanly habitable structures that are 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.”¹² Federal regulations, however, explicitly exclude “bridges, cloverleaves, dams, walkways, tents, recreational vehicles, mobile homes, and boats” from the definition of “building.”¹³

While architectural and engineering drawings are within the purview of the Copyright Act, mere ideas, concepts, or other designs that are not fixed into concrete media are not governed by the Copyright Act and may be regulated by state law.¹⁴ For example, the California Civil Code provides a claim of ownership to the author of ideas or concepts that have not yet been “fixed into any tangible medium of expression.”¹⁵

A copyright owner holds the exclusive right to reproduce the copyrighted work, prepare derivative works, and distribute copies by sale or other transfer of ownership.¹⁶ Should anyone but the copyright owner exercise any of these exclusive rights without permission, a cause of action for infringement may lie.¹⁷ Such infringement may entitle the copyright owner to an award of actual and statutory damages, as well as possible attorney’s fees.¹⁸ Additionally, the copyright owner may be entitled to enjoin further exercise of exclusive rights. In the case of architectural and engineering plans, the copyright owner may enjoin another’s use of the plans exceeding the scope of any licensing agreement.¹⁹

As mentioned above, state copyright law is preempted by federal law. State causes of action seeking to enforce “equivalent rights” as those provided under the Copyright Act are similarly preempted.²⁰ However, under the “equivalent rights” test, the Copyright Act does not preempt any state cause of action that requires proof of an additional element beyond a claim of federal copyright infringement.²¹ Thus, a party that does not own or hold an exclusive license to a copyrighted work may be preempted

from bringing certain state claims that provide “equivalent rights” to those imparted by the Copyright Act. For example, the Copyright Act may preempt claims for unfair competition and unjust enrichment based on alleged misappropriation of a copyrighted work.²² However, claims of fraud are not preempted, because a successful claim of fraud requires proof of misrepresentation, which is not required for an infringement suit.²³

COPYRIGHT AUTHORSHIP AND INITIAL OWNERSHIP

As discussed above, only a copyright owner or party with an exclusive license may enforce a copyright. Ownership initially vests in the “author” of a copyrighted work.²⁴ Though registering a work with the United States Copyright Office is *prima facie* evidence of ownership, it does not actually affect ownership.²⁵ However, a work must be registered before a copyright may be enforced in a suit for infringement.²⁶ Additionally, copyright notice has no bearing on ownership of a work and is no longer required for copyright protection.²⁷ Thus, a copyrightable work is automatically owned by its author at the time it is fixed in permanent and tangible form.²⁸ As the initial owner, an author has all of the exclusive rights under the Copyright Act, including the rights to reproduce, adapt, distribute, sell, transfer, or perform the work.²⁹

In the case of architectural or engineering services, the “author” is generally the individual architect or engineer who produced the design documents. However, the Copyright Act provides for other methods of authorship, which may confer ownership to parties other than the solitary design professional who prepared the plans. Two such vehicles for authorship are “works made for hire” and “joint works.”

Prior to the Copyright Act of 1976, copyright ownership of architectural plans vested in the party who paid for design services under the common law “work-for-hire” doctrine.³⁰ The Copyright Act abrogated this doctrine. Now, a work made for hire may only occur in two specific situations—either when a work is created by an employee within the scope of her employment or when a copyrighted work has specially been ordered with an express agreement that it constitutes a work made for hire.³¹ Generally speaking, however, works made for hire most often arise within an employment situation.

In this context, ownership in a work made for hire vests in the employer, unless there is an agreement otherwise.³² However, work completed by an independent contractor is not considered work made for hire and does not vest ownership in the paying party.³³ In that case, the independent contractor is the author and owner of the copyrighted work. Courts have turned to the Restatement (Second) of Agency to determine whether a design professional is an employee or independent contractor, looking to factors such as extent of the employer’s control over the details of the work, the party pro-

viding supplies to complete the work, the length of employment, whether the work is part of the employer's regular business, and whether the parties believe they have entered into an employment relationship.³⁴ Usually, copyright in architectural and engineering documents produced by in-house design professionals is owned by the employer.

Another method of conferring ownership to multiple parties is through joint authorship. When two or more authors create a copyrightable work, ownership in the copyright vests in all authors as a joint work.³⁵ Each author must contribute in a material way to the development of the ideas and concepts represented in the copyrighted work.³⁶ However, initial ideas and design concepts provided by the commissioning party or conversations and approvals between that party and an independent contractor do not create joint authorship.³⁷

To summarize, in the case of construction documents, the owner of the copyright is almost always the architect or engineer who prepared the plans. The landowner who commissions the plans has limited ability to prevent reuse or adaptation of the plans for another project if such use is permitted by the copyright owner. In cases like Bob's dream house or Fran's foreclosed project, the landowner has no standing to pursue a claim for copyright infringement, unless a design professional transfers ownership or provides an express, written license to use the copyrighted work, including the right to control the transfer or re-use of the plans.

ABSENCE OF A WRITTEN AGREEMENT AND NON-EXCLUSIVE LICENSES

If there is no signed writing regarding transfer of copyright, the best that a purchaser of design services can hope for is an implied non-exclusive license in the documents.³⁸ Even when a purchaser signs a contract for such services, he or she might only be buying a non-exclusive license to use the copyrighted work. This may occur when an architectural design contract is executed on form documents written by the American Institute of Architects, which only provide the purchaser with a non-exclusive license.³⁹

A non-exclusive license permits the purchasing party to complete construction based on the copyrighted designs without further permission from or compensation to the architect.⁴⁰ If such a license is implied, it is generally presumed that the license grants a continued right to use the plans in connection with the project for which they were commissioned.⁴¹ Practically speaking, a non-exclusive license merely operates as an affirmative defense against a claim of infringement brought by the copyright owner.⁴²

As the name suggests, an implied non-exclusive license is implied from the relationship of the parties contracting for design documents or any other copyrighted work. The courts have established a test to determine whether an implied non-exclusive license has been created.⁴³ Under this

test, an implied non-exclusive license exists when (1) the licensee requests the creation of a work, (2) the licensor creates the work and delivers it to the licensee, and (3) the licensor intends that the licensee copy and distribute the work.⁴⁴ The dispositive element is usually intent, as the first two elements of the test are generally clear.⁴⁵

In ascertaining the intent of the licensor, courts will look at the totality of the circumstances. Some of the factors considered are whether the parties were engaged in short-term and discreet transactions, whether the author utilized written contracts, and whether the author's conduct indicated that use of the copyrighted work without his or her further involvement or consent was permissible.⁴⁶ In one case involving an oral contract for architectural services, a non-exclusive license was not implied for lack of intent when an architect submitted a written contract to the owner, which restricted use of plans, but the parties never executed it.⁴⁷ If an author does not intend to grant an implied non-exclusive license, a purchaser of design services does not have rights to use the plans and is liable for infringement if the plans are copied or used in construction of another building.⁴⁸ Persons who have committed copyright infringement are subject to damages and injunction, as well as disgorgement of profits, dispossession of the copyrighted work, and criminal penalties.⁴⁹ There are examples in the case of law of landowners who commissioned architectural plans but were enjoined from constructing the building after infringing upon the copyright.⁵⁰ Such a result is potentially disastrous for a purchaser of design services.

TRANSFERS OF COPYRIGHT OWNERSHIP AND LICENSES TO USE

An architect, engineer, or any other author of a copyrighted work may transfer ownership or other exclusive rights to use the work, but may only do so according to the provisions of the Copyright Act.⁵¹ Transfer of copyright is defined as “an assignment, mortgage, exclusive license or any other conveyance, alienation or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright whether or not it is limited in time or place of effect, but not including a *non-exclusive license*.”⁵² After an author of a copyrighted work transfers ownership or grants an *exclusive* license to the copyrighted work, the new owner or exclusive licensee may exclude all others—including the author—from using the transferred rights.⁵³ Copyright can only be transferred in two ways. The first is by operation of law, such as in a bankruptcy or probate proceeding; the second is in a writing signed by the owner of the copyright, which is the focus here.⁵⁴ As discussed above, in the absence of a written contract transferring ownership or exclusive right to use, the person commissioning a work acquires, at most, only a non-exclusive license to use the plans.

In the case of an express transfer or license, the scope of the rights granted by the author is governed by the terms of the signed writing.⁵⁵

When a contract is used to convey ownership or exclusive license, the terms of that contract are governed by state law.⁵⁶ This may lead to some inconsistent results from jurisdiction to jurisdiction. For example, California has a more permissive parol evidence rule than some other states, meaning that extrinsic evidence is more likely to determine the terms and scope of a transfer of copyright in California than in other jurisdictions.⁵⁷

The requirements for a written transfer of copyright are very minimal. As explained by one court:

The rule is really quite simple: If the copyright holder agrees to transfer ownership to another party, that party must get the copyright holder to sign a piece of paper saying so. It doesn't have to be the Magna Charta; a one-line proforma statement will do.⁵⁸

As simple as it is to transfer ownership or grant an exclusive license, the case law is rife with situations in which a signed writing was not utilized.⁵⁹

While a simple statement transferring ownership of a copyright will suffice, architects and engineers usually are reluctant to relinquish full ownership of their work product. Instead, a license is often granted as to one of the exclusive rights, and the license is usually subject to various limitations on the owner's and the design professional's rights as specified in the contract. These issues should be considered carefully when negotiating a contract for architectural, engineering, or other design services.

In the case of copyright, like other forms of property, any one of the sticks in the bundle of exclusive rights may be transferred by license agreement. Essentially, an exclusive license permits a licensee to utilize copyrighted works for a specific use and for a price; in return, the licensor promises that the same permission will not be given to anyone else.⁶⁰ In the case of design services, the scope of the license is generally limited to the specific project for which it was commissioned. The licensee is liable for infringement if the scope of the license is exceeded.⁶¹

Most licensing provisions in agreements for design services involve reproduction rights, distribution rights, and possibly the right to create a derivative work based on the copyrighted design documents.⁶² Because architectural works are embodied in the building itself, the right to reproduce is not merely the reproduction of plans but any reproduction of the physical building.⁶³ Additionally, all rights may be subdivided. For example, the right to reproduce architectural plans may be limited to reproduction for construction purposes (i.e. providing plans to contractors and government permit authorities), prohibiting reproduction for marketing purposes (i.e. reproducing the plans on a model home brochure or a developer's press kit),⁶⁴ or prohibiting re-use of the plans in other projects.

An exclusive license right may be limited in duration, geographic territory, quantity of reproductions, third-parties involvement, and recipients to whom the licensee may distribute the copyrighted work.⁶⁵ A licensor will often make an explicit reservation of all other rights.⁶⁶ The parties should determine whether the licensee has the right to assign the license.⁶⁷ Additionally, the licensor may want to add a clause providing the right to terminate the license upon the licensee's default, such as failure to pay for the continued services of the licensor.⁶⁸ A developer or builder should consider whether and to what extent a lender or purchaser may require an interest in the plans and a license to use them. A purchaser/developer who is retaining design professionals while in an option or purchase contract may wish to restrict or limit the property owner's interest in the plans in the event the purchase does not go forward. All of these matters could be the subject of express provisions in the license agreement, although often they are not mentioned or are only partially addressed.

STANDARD FORM AIA AGREEMENT

As mentioned above, form licensing agreements are published by the American Institute of Architects. Though these standard agreements purport to be fair to both parties,⁶⁹ the actual language appears to favor the architect and should therefore be used with caution. Indeed, under an American Institute of Architects standard agreement, a landowner could be left with fewer rights that she would receive under an implied non-exclusive license.

Article 3 of AIA Document B-102 - 2007, the standard form agreement between landowner and architect without a predefined scope of architect's services, provides that the architect shall retain ownership of the copyrighted work, and grants the landowner a mere non-exclusive license to use the copyrighted work to complete the project contemplated in the contract.⁷⁰ However, the agreement also grants additional power to the architect, which would not be implied by law. For example, section 3.3 of AIA Document B-102 - 2007 grants the landowner a non-exclusive license only if prompt payment is made to the architect.⁷¹ If such payment is not made, the landowner is in default and the architect may terminate the license.⁷² In contrast, a court generally will not require prompt payment as a condition of an implied non-exclusive license.⁷³ Thus, a landowner could end up with fewer rights under an unmodified America Institute of Architects form than if no written agreement is used at all. Therefore, if such a standard form is used at all, it should serve as a starting point for negotiation but should be modified to reflect the intentions of the design professional and the landowner.

CONCLUSION

It is important for practitioners to bear in mind the position of the parties as to copyright when negotiating for architectural, engineering, or other design services. Unlike prior law which granted ownership to the party who paid for the creation of design documents, the Copyright Act vests ownership in the author absent an agreement to the contrary. Mere payment for design services and the normal back and forth communications between purchaser and design professional will not qualify the purchaser as an author, even under the theories of work made for hire or joint authorship. In the absence of a concise written contract to control the architect's or engineer's use or transfer of rights to others, a purchaser of design services could end up without any exclusive rights and, worse still, could be liable to the design professional if the copyrighted work is used by others. Moreover, the purchased designs could potentially be transferred to another party who has not invested any time, money, or effort into the creation of the design documents. Furthermore, only a party with exclusive rights may bring suit for infringement. Worse yet, any cause of action providing "equivalent rights" to a suit for infringement is preempted by the Copyright Act, thus leaving an unfortunate purchaser without remedy.

Such problems can easily be averted by an appropriate written transfer of rights signed by the architect or design professional. With an adequate understanding of how the Copyright Act affects the rights of the parties in the absence of an express agreement, the parties can effectively negotiate for contractual rights in copyrighted work that will have predictable and fair consequences for both parties.

NOTES

1. For a congruent fact pattern, see *Johnson v. Jones*, 149 F.3d 494, 501-502, 47 U.S.P.Q.2d 1481 (6th Cir. 1998).
2. For a congruent fact pattern, see *Del Madera Properties v. Rhoades and Gardner, Inc.*, 820 F.2d 973, 977, 3 U.S.P.Q.2d 1283 (9th Cir. 1987).
3. See *Shanaban v. Macco Const. Co.*, 224 Cal. App. 2d 327, 333, 36 Cal. Rptr. 584, 144, 144 U.S.P.Q. 154 (2d Dist. 1964); *Smith v. Paul*, 174 Cal. App. 2d 744, 757, 345 P.2d 546, 123 U.S.P.Q. 463, 77 A.L.R.2d 1036 (1st Dist. 1959).
4. 17 U.S.C.A. §§201(d), 501.
5. See *Robert H. Jacobs, Inc. v. Westoaks Realtors, Inc.*, 159 Cal. App. 3d 637, 642, 205 Cal. Rptr. 620 (2d Dist. 1984).
6. While one of the more important concepts in copyright law, publication is not particularly relevant in the architectural and design context. It is worth noting that publication without a copyright notice limits the copyright owner's claim for infringement. See 17 U.S.C.A. §412(2). Additionally, in the case of architectural and other construction drawings, submission of such drawings to a public authority to receive public approvals or review is not considered publication resulting in any loss or abrogation of a copyright interest. See *John G. Danielson, Inc. v. Winchester-Conant Properties, Inc.*, 322 F.3d 26, 36, 66 U.S.P.Q.2d 1065 (1st Cir. 2003). See also 10 Miller & Starr, *California Real Estate 3d.*, §27:111, Construction Law and Contracting (Thomson-West 2010).
7. *Robert H. Jacobs, Inc. v. Westoaks Realtors, Inc.*, 159 Cal. App. 3d 637, 643, 205 Cal. Rptr. 620 (2d Dist. 1984).
8. 17 U.S.C.A. §102(a).

9. 17 U.S.C.A. §102; *Del Madera Properties v. Rhodes and Gardner, Inc.*, 820 F.2d 973, 976, 3 U.S.P.Q.2d 1283 (9th Cir. 1987).
10. See *T-Peg, Inc. v. Vermont Timber Works, Inc.*, 459 F.3d 97, 109-110, 79 U.S.P.Q.2d 1919 (1st Cir. 2006).
11. 17 U.S.C.A. §101.
12. 17 U.S.C.A. §§101, 102(a)(8). See, e.g., *Nelson-Salabes, Inc. v. Morningside Development, LLC*, 284 F.3d 505, 515-516 (4th Cir. 2002).
13. 37 C.F.R. §202.11(d)(1).
14. *Foad Consulting Group, Inc. v. Azzalino*, 270 F.3d 821, 837-838, 60 U.S.P.Q.2d 1656 (9th Cir. 2001).
15. See Civ. Code, §980, subd. (a).
16. 17 U.S.C.A. §106(1)-(3).
17. 17 U.S.C.A. §301.
18. 17 U.S.C.A. §412(1).
19. 17 U.S.C.A. §502(a); *LGS Architects, Inc. v. Concordia Homes of Nevada*, 434 F.3d 1150, 77 U.S.P.Q.2d 1560 (9th Cir. 2006).
20. *Del Madera Properties v. Rhodes and Gardner, Inc.*, 820 F.2d 973, 977, 3 U.S.P.Q.2d 1283 (9th Cir. 1987).
21. *Del Madera Properties v. Rhodes and Gardner, Inc.*, 820 F.2d 973, 977, 3 U.S.P.Q.2d 1283 (9th Cir. 1987).
22. *Del Madera Properties v. Rhodes and Gardner, Inc.*, 820 F.2d 973, 977, 3 U.S.P.Q.2d 1283 (9th Cir. 1987).
23. See *Valente-Kritzer Video v. Pinckney*, 881 F.2d 772, 776, 11 U.S.P.Q.2d 1727 (9th Cir. 1989); *Firoozye v. Earthblink Network*, 153 F. Supp. 2d 1115, 1128 (N.D. Cal. 2001).
24. 17 U.S.C.A. §201(a).
25. 17 U.S.C.A. §410(c); *Schmidt v. Holy Cross Cemetery, Inc.*, 840 F. Supp. 829, 833-834 (D. Kan. 1993). In the case of architectural plans, both the plans and the building itself may be registered. See 17 U.S.C.A. §411(a); *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1488-1489, 15 U.S.P.Q.2d 1282, 16 Fed. R. Serv. 3d 1441 (11th Cir. 1990).
26. 17 U.S.C.A. §§411, 412.
27. 17 U.S.C.A. §401.
28. 17 U.S.C.A. §101. ("A work is 'fixed' in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.")
29. 17 U.S.C.A. §106.
30. See *May v. Morganelli-Heumann & Associates*, 618 F.2d 1363, 1368, 207 U.S.P.Q. 476 (9th Cir. 1980); *Meltzer v. Zoller*, 520 F. Supp. 847, 854, 216 U.S.P.Q. 776 (D.N.J. 1981).
31. 17 U.S.C.A. §§101, 201(b). See also *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 738, 109 S. Ct. 2166, 104 L. Ed. 2d 811, 16 Media L. Rep. (BNA) 1769, 10 U.S.P.Q.2d 1985 (1989).
32. 17 U.S.C.A. §§101, 201(b).
33. *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1493, 15 U.S.P.Q.2d 1282, 16 Fed. R. Serv. 3d 1441 (11th Cir. 1990), citing *Aitken, Hazen, Hoffman, Miller, P. C. v. Empire Const. Co.*, 542 F. Supp. 252, 259, 218 U.S.P.Q. 409 (D. Neb. 1982) (disapproved of on other grounds by, *Easter Seal Soc. for Crippled Children and Adults of Louisiana, Inc. v. Playboy Enterprises*, 815 F.2d 323, 2 U.S.P.Q.2d 1585 (5th Cir. 1987)); *Meltzer v. Zoller*, 520 F. Supp. 847, 857, 216 U.S.P.Q. 776 (D.N.J. 1981).
34. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 751-752, 109 S. Ct. 2166, 104 L. Ed. 2d 811, 16 Media L. Rep. (BNA) 1769, 10 U.S.P.Q.2d 1985 (1989).
35. 17 U.S.C.A. §§101, 201(a).
36. 17 U.S.C.A. §§101, 201(a).
37. *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1493, 15 U.S.P.Q.2d 1282, 16 Fed. R. Serv. 3d 1441 (11th Cir. 1990); *Aitken, Hazen, Hoffman, Miller, P. C. v. Empire Const. Co.*, 542 F. Supp. 252, 254, 218 U.S.P.Q. 409 (D. Neb. 1982) (disapproved of on other grounds by, *Easter Seal Soc. for Crippled Children and Adults of Louisiana, Inc. v.*

- Playboy Enterprises, 815 F.2d 323, 2 U.S.P.Q.2d 1585 (5th Cir. 1987)); *Meltzer v. Zoller*, 520 F. Supp. 847, 855-857, 216 U.S.P.Q. 776 (D.N.J. 1981).
38. See *Johnson v. Jones*, 149 F.3d 494, 500, 47 U.S.P.Q.2d 1481, 1998 FED App. 0221P (6th Cir. 1998); *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775, 37 U.S.P.Q.2d 1436 (7th Cir. 1996).
39. AIA, Document B102 – 2007.
40. *Estate of Hevia v. Portrio Corp.*, 602 F.3d 34, 39-40, 94 U.S.P.Q.2d 1501 (1st Cir. 2010); *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775, 37 U.S.P.Q.2d 1436 (7th Cir. 1996).
41. *Estate of Hevia v. Portrio Corp.*, 602 F.3d 34, 41-42, 94 U.S.P.Q.2d 1501 (1st Cir. 2010).
42. *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775, 37 U.S.P.Q.2d 1436 (7th Cir. 1996).
43. *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 776, 37 U.S.P.Q.2d 1436 (7th Cir. 1996), citing *Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 558, 559, 15 U.S.P.Q.2d 1559 (9th Cir. 1990).
44. *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 776, 37 U.S.P.Q.2d 1436 (7th Cir. 1996), citing *Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 558, 559, 15 U.S.P.Q.2d 1559 (9th Cir. 1990).
45. *John G. Danielson, Inc. v. Winchester-Conant Properties, Inc.*, 322 F.3d 26, 40-41, 66 U.S.P.Q.2d 1065 (1st Cir. 2003).
46. *Estate of Hevia v. Portrio Corp.*, 602 F.3d 34, 41-43, 94 U.S.P.Q.2d 1501 (1st Cir. 2010); *Nelson-Salabes, Inc. v. Morningside Development, LLC*, 284 F.3d 505, 516 (4th Cir. 2002).
47. *Johnson v. Jones*, 149 F.3d 494, 501-502, 47 U.S.P.Q.2d 1481, 1998 FED App. 0221P (6th Cir. 1998).
48. See *Johnson v. Jones*, 149 F.3d 494, 501-502, 47 U.S.P.Q.2d 1481, 1998 FED App. 0221P (6th Cir. 1998).
49. See 17 U.S.C.A. §§502 et seq.
50. See, e.g., *Thomas M. Gilbert Architects, P.C. v. Accent Builders And Developers, LLC*, 377 Fed. Appx. 303 (4th Cir. 2010); *LGS Architects, Inc. v. Concordia Homes of Nevada*, 434 F.3d 1150, 1158, 77 U.S.P.Q.2d 1560 (9th Cir. 2006).
51. 17 U.S.C.A. §§201(d), 204(a), 204(b).
52. 17 U.S.C.A. §101, emphasis added.
53. See, e.g., *LGS Architects, Inc. v. Concordia Homes of Nevada*, 434 F.3d 1150, 1155-1157, 77 U.S.P.Q.2d 1560 (9th Cir. 2006).
54. 17 U.S.C.A. §204; *Estate of Hevia v. Portrio Corp.*, 602 F.3d 34, 40, 94 U.S.P.Q.2d 1501 (1st Cir. 2010).
55. *Foad Consulting Group, Inc. v. Azzalino*, 270 F.3d 821, 828-831, 60 U.S.P.Q.2d 1656 (9th Cir. 2001); *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 777-778, 37 U.S.P.Q.2d 1436 (7th Cir. 1996).
56. *Foad Consulting Group, Inc. v. Azzalino*, 270 F.3d 821, 825-826, 831-832, 60 U.S.P.Q.2d 1656 (9th Cir. 2001).
57. *Foad Consulting Group, Inc. v. Azzalino*, 270 F.3d 821, 828, 60 U.S.P.Q.2d 1656 (9th Cir. 2001).
58. *Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 557, 15 U.S.P.Q.2d 1559 (9th Cir. 1990).
59. See, e.g., *John G. Danielson, Inc. v. Winchester-Conant Properties, Inc.*, 322 F.3d 26, 40, 66 U.S.P.Q.2d 1065 (1st Cir. 2003); *Nelson-Salabes, Inc. v. Morningside Development, LLC*, 284 F.3d 505, 513 (4th Cir. 2002); *Walthal v. Rusk*, 172 F.3d 481, 484, 50 U.S.P.Q.2d 1311 (7th Cir. 1999); *Johnson v. Jones*, 149 F.3d 494, 500, 47 U.S.P.Q.2d 1481, 1998 FED App. 0221P (6th Cir. 1998); *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775, 37 U.S.P.Q.2d 1436 (7th Cir. 1996); *Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 558, 559, 15 U.S.P.Q.2d 1559 (9th Cir. 1990); *Meisner Brem Corp. v. Mitchell*, 313 F. Supp. 2d 13, 17-18, 2004 DNH 67 (D.N.H. 2004); *Landsted Homes, Inc. v. Sherman*, 305 F. Supp. 2d 976, 983 (W.D. Wis. 2002).
60. *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775, 37 U.S.P.Q.2d 1436 (7th Cir. 1996).
61. *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775, 37 U.S.P.Q.2d 1436 (7th Cir. 1996).
62. For example, “The license ... permits the Owner to authorize the Contractor, Subcontractor, [etc.] to reproduce applicable portions of the Instruments of Service solely and exclusively for performing services for the project.” AIA Document B-102 – 2007, p. 3, §3.4.
63. See 17 U.S.C.A. §101.
64. See, e.g., *John G. Danielson, Inc. v. Winchester-Conant Properties, Inc.*, 322 F.3d 26, 32, 66 U.S.P.Q.2d 1065 (1st Cir. 2003); *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1488-1489, 15 U.S.P.Q.2d 1282, 16 Fed. R. Serv. 3d 1441 (11th Cir. 1990).
65. See 1 Intellectual Property in Business Transactions (Cont.Ed.Bar 2008) chap. 5.

66. See AIA Document B-102 – 2007, p. 3, §3.4.
67. “The Owner shall not assign, delegate, sublicense, pledge or otherwise transfer any license granted herein to another party without prior written agreement of the Architect.” AIA Document B-102 – 2007, p. 3, §3.4.
68. AIA Document B-102 – 2007, p. 5-6, art. 5.
69. AIA Document B-102 – 2007 Instructions, p. 1.
70. AIA Document B-102 – 2007, p. 3, §§3.2-3.3.
71. “The Architect grants to the Owner a nonexclusive license to use the Architect’s Instruments of Service solely and exclusively for the Project, provided that the Owner substantially performs its obligations, including prompt payment of all sums when due, under this Agreement.” AIA Document B-102 – 2007, p. 3, §3.3.
72. AIA Document B-102 – 2007 Instructions, p. 2.
73. See *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 778, 37 U.S.P.Q.2d 1436 (7th Cir. 1996), citing *Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 559, fn. 7, 15 U.S.P.Q.2d 1559 (9th Cir. 1990).

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