

No. 21A\_\_\_\_

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IN THE  
**Supreme Court of the United States**

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DESIGNWORKS HOMES, INC. & CHARLES LAWRENCE JAMES,

*Petitioners,*

v.

THOMSON SAILORS HOMES, L.L.C., THOMSON HOMES, L.L.C., DONALD SAILORS,  
EDWARD B. THOMSON, III, TEAM 3 ARCHITECTS, INC., BRUCE H. BEATTY, BOBBY  
SAILORS, ERIC BRADLEY THOMSON, ELSWOOD SMITH CARLSON, P.A.

*Respondents.*

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APPLICATION TO EXTEND THE TIME TO FILE A PETITION FOR A  
WRIT OF CERTIORARI FROM JANUARY 17, 2022, TO MARCH 18, 2022

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To the Honorable Brett M. Kavanaugh, Circuit Justice for the Eighth Circuit:

Pursuant to 28 U.S.C. § 2101(c) and Supreme Court Rules 13.5, 22, and 30.3, Petitioners Designworks Homes, Inc.,<sup>1</sup> and Charles L. James respectfully request that the time to file a Petition for a Writ of Certiorari be extended 60 days from January 17, 2022, up to and including March 18, 2022.

The U.S. Court of Appeals for the Eighth Circuit denied a timely filed petition for rehearing on October 19, 2021, App. D, *infra*, after issuing its opinion on August 19, 2021, App. A, *infra*.

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<sup>1</sup> Pursuant to this Court's Rule 29.6, Petitioners declare as follows: (i) Designworks Homes, Inc., is a corporate entity; and (ii) no publicly held corporation owns 10 percent or more interest in Designworks Homes, Inc., and Designworks Homes, Inc., does not have a parent corporation.

Without an extension, a petition would be due on Monday, January 17, 2022. This application is being filed at least 10 days before that date. See Sup. Ct. R. 13.5. The jurisdiction of this Court would be invoked under 28 U.S.C. § 1254 to review this case.

### **Background**

1. Petitioner Charles L. James has devoted much of his life to the creation of unique and innovative home designs, most recently under the auspices of his home design-and-build company, Petitioner Designworks Homes, Inc. App. B at 2. In the late 1990s, Mr. James created an innovative and award-winning home design that featured a prominent triangular-atrium feature quite unlike any feature he had ever witnessed in a home design beforehand. App. A at 6 (floor plan). Seen directly upon entering the house, his triangular-atrium feature captures a viewer's attention from the get-go. Not many homes have *any* triangular design—let alone a design centered around a triangular atrium.

2. This triangular-atrium feature became the centerpiece of many houses that Mr. James built and sold (for above-market prices) in and around Columbia, Missouri. In 2004, Mr. James registered the triangular-atrium design with the U.S. Copyright Office. App. B at 2. He considers this award-winning design to be his life's greatest accomplishment. Around 2017, he came across houses designed and built by Respondents in and around Kansas City, Missouri, that used a highly similar triangular-atrium feature—a feature that he had never seen in any other homes except the ones he himself had designed and built.

3. To date and as far as Mr. James can tell, no home in the State of Missouri—other than the ones Mr. James built and those built by Respondents—has such a triangular-atrium feature. Mr. James was especially concerned about infringement of his home designs here because construction of Respondents’ houses had begun shortly after Mr. James’ unique triangular-atrium design became publicly accessible.

4. After pre-suit discussions were unavailing, Mr. James went to court, suing for copyright infringement of his home designs in the U.S. District Court for the Western District of Missouri.

5. Copyright infringement is traditionally decided by application of a substantial-similarity analysis that, as its name suggests, is conducted by “focusing on objective *similarities* in the details of the works.” E.g., Rottlund Co. v. Pinnacle Corp., 452 F.3d 726, 731 (8th Cir. 2006) (emphasis added). Under a copyright similarity analysis, even if an infringer doesn’t copy the entirety of a work, the infringer still has to compensate the original creator for the portion of the work that they did take.

6. This makes sense. By analogy, a pickpocket is punished for what he took, not excused for what he didn’t. The same is true in copyright: a similarity analysis focuses on what *was* taken, not what *wasn’t*. See Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49, 56 (2d Cir. 1936) (Hand, J.) (“[N]o plagiarist can excuse the wrong by showing how much of his work he did not pirate.”).

7. At summary judgment, the District Court did not focus on similarities. Instead, it focused on “objective *differences*” between Petitioners’ and Respondents’ designs. App. B at 7 (emphasis added). It did so by applying Eleventh Circuit law for the proposition that a different legal test of copyright infringement applies in the context of architectural designs. App. B. at 7 (citing Howard v. Sterchi, 974 F.2d 1272, 1276 (11th Cir. 1992)).

8. Accordingly, even though Petitioners’ designs and Respondents’ designs share an extraordinarily rare and prominent feature, the District Court granted summary judgment to Respondents on the grounds that the designs had a number of differences.

9. After summary judgment, Respondents asked for fee-shifting against Mr. James. Pertinently, this Court has spoken on copyright fees-shifting twice. First, in Fogerty v. Fantasy, Inc., this Court “reject[ed]” the argument that the prevailing party “should be awarded attorney’s fees as a matter of course[.]” 510 U.S. 517, 533 (1994). Second, in Kirtsaeng v. John Wiley & Sons, Inc., this Court provided “additional guidance” regarding copyright fees. 579 U.S. 197, 203 (2016). It emphasized the “objective reasonableness” of the losing party’s positions as an “important factor” weighing on whether to award copyright fees. Id. at 208. In responding to concerns about the objective-reasonableness factor, this Court cautioned lower courts against “conflat[ing] two different questions”—against conflating the merits outcome with whether “serious arguments” were made by the losing party. Id.

10. This Court did not mince words on what should happen if a lower court did conflate those two questions: “if some court confuses the issue of liability with that of reasonableness, its fee award should be reversed for abuse of discretion.” Id. (emphasis added).

11. Mr. James did not get the benefit of this Court’s central holdings from Fogerty and Kirtsaeng. The District Court held that copyright fees are the “rule rather than the exception and should be awarded routinely.” App. C at 2 (emphasis added).<sup>2</sup> Given that it thought the governing legal standard says fees “should” be awarded, the District Court understandably devoted a mere four sentences to applying the Fogerty-Kirtsaeng factors. App. C at 3 (last paragraph). It then awarded over \$400,000 in fees and costs against Mr. James. App. C. at 4. In those four sentences, the District Court ran afoul of Kirtsaeng’s admonition: it decided the objective-reasonableness factor by mere reference back to its own “order on summary judgment[,]” App. C at 3—conflating the merits issue of liability with the fees issue of reasonableness.

12. Petitioners appealed.

13. On the merits, the Eighth Circuit acknowledged that “one feature of both designs is a triangular atrium” but chose to focus on what it viewed as “plenty of *differences*” in the designs instead. App. A at 4 (emphasis added). Thus, the Eighth Circuit too conducted a *differences* analysis.

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<sup>2</sup> But see 17 U.S.C. § 505 (“[T]he court may also award a reasonable attorney’s fee[.]”) (emphasis added); Kirtsaeng, 579 U.S. at 210 n.1 (seeming to disapprove of rule-rather-than-exception language in Hogan Sys. v. Cybresource Int’l., Inc., 158 F.3d 319, 325 (5th Cir. 1998) for “presuming that a prevailing party receives fees”).

14. Furthermore, the Eighth Circuit suggested that similarity as to an extremely rare design feature was insufficient because the “total concept and feel” of the overall design was not similar in its view. App. A at 4. Thus, it affirmed on the merits.

15. On fees, the Eighth Circuit acknowledged that the District Court adopted the wrong legal standard for deciding copyright fees. App. A at 5 (“To be sure, the district court was wrong to say that attorney fees ‘are the rule rather than the exception and *should* be awarded routinely’ in cases like this one.” (emphasis from Eighth Circuit)). It even quoted this Court’s point that the application of the wrong standard could “pretermitt the exercise of that discretion” on copyright fees. App. A at 5 (quoting Fogerty, 510 U.S. at 533).

16. Nonetheless, the Eighth Circuit affirmed. It did so without acknowledging or addressing Petitioners’ point, articulated at length in their briefs, that the District Court had done what this Court has instructed courts not to do: the District Court had conflated the merits issue of liability with the fees issue of reasonableness. See Kirtsaeng, 579 U.S. at 208 (“[I]f some court confuses the issue of liability with that of reasonableness, its fee award should be reversed for abuse of discretion.”).<sup>3</sup>

17. Petitioners timely petitioned for rehearing, which was denied on October 19, 2021.

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<sup>3</sup> Because the District Court was operating under an approach where it thought fees “should” be awarded, it is far from clear that the District Court would have awarded fees had it known the proper standard and the full extent of its discretion to *deny* \$400,000 in fees against an individual copyright holder.

## Reasons for Granting an Extension of Time

18. The 90-day period leading up to the deadline to file a Petition for a Writ of Certiorari has been very busy for Petitioners' nonprofit counsel. The heavier than usual press of business has included, *inter alia*, work in courts of appeals, including a factually and legally complex cross-appeal; and work in various district courts, including a flurry of time-sensitive filings in a highly complex wrongful-death case relating to the estates of many children. A Petition for a Writ of Certiorari is a substantial undertaking and Petitioners' counsel request the 60-day extension of time to give a petition all the time and attention it deserves.<sup>4</sup>

19. Whether or not an extension is granted, the Petition will be considered during this Term—and, if the petition were granted, it would be argued in the next Term. Thus, an extension is unlikely to substantially delay the resolution of this case or prejudice any party.

20. Finally, there's a fair prospect that this Court would grant a Petition for a Writ of Certiorari in this case. There's a Circuit split on the merits question of how to conduct a similarity analysis, both generally and specifically in the context of architectural designs.

21. Below, despite both Petitioners' designs and Respondents' designs having an extraordinarily rare feature in common, the Eighth Circuit held that it was the differences that mattered. App. A at 5.

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<sup>4</sup> Petitioners also intend to petition this Court *in forma pauperis*. They do not have the funds to pay for professional printers to produce the booklet format. Although Petitioners' nonprofit counsel have petitioned this Court in the past on paid petitions, counsel need additional time to learn the rules and procedures for *in forma pauperis* petitions.

22. Most courts, however, conduct a similarity analysis by crediting similarities—not discounting them due to differences. E.g., L.A. Printex Indus. v. Aeropostale, Inc., 676 F.3d 841, 851 (9th Cir. 2012) (It is “entirely immaterial that, in many respects, plaintiff’s and defendant’s works are dissimilar, if in other respects, similarity as to a substantial element of plaintiff’s work can be shown.”); Sheldon, 81 F.2d at 56 (Hand, J.) (“[N]o plagiarist can excuse the wrong by showing how much of his work he did not pirate.”).

23. Also, there’s an acknowledged Circuit split on the more focused question of whether to treat architectural designs differently than every other category of artistic works protected by the Copyright Act. Like the Eighth Circuit below, the Eleventh Circuit focuses on “dissimilarities” in the case of architectural designs. Howard v. Sterchi, 974 F.2d 1272, 1276 (11th Cir. 1992). By contrast, the Second Circuit puts architectural designs on an equal footing with other types of works. Zalewski v. Cicero Builder Development, Inc., 754 F.3d 95, 104 (2d Cir. 2014) (“Courts should treat architectural copyrights no differently than other copyrights. This is what Congress envisioned[.]”); Attia v. Society of the N.Y. Hosp., 201 F.3d 50, 53 n.3 (2d. Cir. 1999) (“In general, architectural works are subject to the same standards that apply to other copyrightable works.” (quoting NIMMER ON COPYRIGHT)).<sup>5</sup>

24. Moreover, there’s a fair prospect that this Court may want to hear Petitioners on the copyright-fees issue.

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<sup>5</sup> Notably, one Eleventh Circuit Judge agrees with the Second Circuit on this question. Home Design Servs. v. Turner Heritage Homes, Inc., 825 F.3d 1314, 1330-1331 (11th Cir. 2016) (Rosenbaum, J., concurring) (calling Eleventh Circuit’s approach “troubling” and noting that “the Second Circuit aptly summed up the problems with our approach”).



25. Petitioners’ counsel believe that a perhaps surprising number of opinions in the lower courts simply don’t appear to be following this Court’s guidance from Fogerty and Kirtsaeng. Instead, they appear to have either have continued with pre-Forgerty presumptions in favor of fees or purported to refine Forgerty’s analysis into a presumption approach.

26. For example, the Seventh Circuit went “so far as to suggest, by way of refinement of the Fogerty standard, that the prevailing party in a copyright case in which the monetary stakes are small should have a *presumptive entitlement* to an award of attorneys’ fees.” Gonzales v. Transfer Techs., Inc., 301 F.3d 608, 610 (7th Cir. 2002) (emphasis added). Then, the Seventh Circuit further refined this holding in a defense-side presumption in favor of fees that is “very strong.” Assessment Techs. of WI, LLC v. Wire Data, Inc., 361 F.3d 434, 437 (7th Cir. 2004) (“When the prevailing party is the defendant, who by definition receives not a small award but no award, the presumption in favor of awarding fees is very strong.”).

27. Yet, Fogerty refused a presumption to fees in part to protect against the ruinous consequences and chilling effect that would come from presumptions in favor of fees in copyright. Fogerty, 510 U.S. at 524 (“[E]ntities which sue for copyright infringement as plaintiffs can run the gamut from corporate behemoths to starving artists[.]”). In the view of Petitioners’ counsel, the lower courts have been disregarding or eroding Fogerty’s central holding, either by “refining” Fogerty into a presumption-to-fees approach or purporting to harmonize Fogerty with presumptions in favor of fees.

28. Petitioners’ counsel request more time to carefully catalog and present the application of copyright fee-shifting presumptions in the lower courts—presumptions that have continued after Fogerty and even after Kirtsaeng. These presumptions have ruinous consequences for the smallest of copyright holders, who also often have the least access to counsel—especially counsel who are willing to bring such matters to this Court.

### **Conclusion**

For the foregoing reasons, the time to file a Petition for a Writ of Certiorari in this matter should be extend for 60 days up to and including March 18, 2022.

Respectfully submitted,

/s/ Andrew Grimm

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