

# **COPYRIGHT NORTH OF THE BORDER**

AN EVALUATION OF CANADIAN COPYRIGHT LAW AND ITS IMPACT ON UNITED STATES'

PHOTOGRAPHERS

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## WHO OWNS THE PHOTOGRAPH?

Due to the growing importance of photography in modern communications, the parties who are involved in producing and in publishing photography find themselves locked in a seemingly intractable contest. On the one hand, photographers must protect their sole business asset — images. At the same time, clients<sup>1</sup> who commission new photography or who depend upon “stock”<sup>2</sup> photography seek the greatest number of rights for the most economical cost.

One of the most vexatious issues faced by photographers is that of the ownership of their images, not only the physical entity but equally important the right to control reproduction of the image. These concerns become magnified when dealing with a foreign publisher or client. Differences in language, custom, and law combine to make the licensing agreement a much less reliable process and often implicate complex and sometimes conflicting case, statutory, and treaty law.

If photography is commissioned by a foreign client—who owns the copyright? To what extent is a photographer’s work unprotected when published in a foreign country? Who retains possession of the physical entity (*e.g.*, the photographic print or more often the photographic transparency) after the work has been published by the client? Which nations’ law prevails in the event of an infringement—photographer or publisher? Do matters change if the work is produced in Canada? in the U.S.? in a third country but published in Canada? What remedies are available in the event of an infringement? All of these questions and more will be of concern to a photographer

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<sup>1</sup> For ease of reading, the words “publishers” and “clients” will often be used to describe the multitude of users who publish photography (*i.e.*, publishers, advertisers, corporations, and others including Internet Web site operators)

<sup>2</sup> *Stock photographs* are existing images used by clients who, for a number of reasons, do not wish to assign the creation of new photography. Some of the reasons for using stock images over commissioning new work are a lack of time before publication, unsureness about what it is wanted or needed in an image, and the risk attendant with assignments. Stock photography libraries often house millions of images and may represent one or hundreds of photographers who place their photography with these libraries that act as agents for the photographers in licensing the work.

when dealing with foreign publishers who are usually unknown and usually unseen clients.

This paper principally analyzes the narrower topic of Canadian copyright law to discover its impact on United States' (U.S.) publication photographers whose work<sup>3</sup> is commissioned by and appears north of the border. Ultimately, this review and analysis will be presented to the ASMP–American Society of Media Photographers to be used as an initial resource for members or their counsel who need to explore Canadian copyright law. To assist in this effort, this paper relies on numerous citations to offer the reader a starting point in her legal research.

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<sup>3</sup> *Work*: generally considered to be a photographic print or transparency but for copyright law a work is historically considered to be the original negative (from which prints (copies) are made) or original transparency

## COPYRIGHT BASICS

“Copyright” as it affects photographers in Canada means the “sole right to produce or reproduce the work or any substantial part thereof in any material form... or, if the work is unpublished, to publish the work or any substantial part thereof, and includes the sole right”<sup>4</sup> “to produce, reproduce... or publish any translation of the work,”<sup>5</sup> and “in the case of ... artistic work, to communicate the work to the public by telecommunication,”<sup>6</sup> “to present at a public exhibition...,”<sup>7</sup> “and to authorize any such acts.”<sup>8</sup> In short, the exclusive rights provided by the Canadian Copyright Act that apply to photographers are the rights of reproduction, publication, adaptation, and translation.

Copyright in Canada arises upon creation of the work. If a work fits within one of the categories of work protected by copyright (*e.g.*, “artistic work”), and the work meets the general basis for protection (*i.e.*, originality, fixation, nationality, and place of first publication), the work may be protected by copyright and registered under the Act.

Photography falls under the category of “artistic work(s)” and is thus protectable under the Canadian Act.<sup>9</sup> The definition of “photograph” in the Act now focuses more on the end product than the processes involved in creating the photograph. By exchanging Berne Convention language regarding “works *expressed* by process[es] analogous to photography,”<sup>10</sup> rather than the previous language used from 1924 on, “work *produced* by processes analogous to photography,”<sup>11</sup> it is no longer necessary to have a close technical relationship between traditional and more modern photographic processes.” As a result, the formerly required negative or other traditional photographic

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<sup>4</sup> Copyright Act R.S.C. 1985, c. C-42 § 3(1).

<sup>5</sup> See *id.* at § 3(1)(a).

<sup>6</sup> See *id.* at § 3(1)(f).

<sup>7</sup> See *id.* at § 3(1)(g).

<sup>8</sup> See *id.* at § 3(1) in fine.

<sup>9</sup> R.S.C. 1985, c. C-42 § 2 “definition of “artistic work”.

<sup>10</sup> R.S.C. 1985, ch. C-42, § 2, definition of “photograph;” [emphasis added] modified by NAFTA Implementation Act, S.C. 1993, ch. 44, § 53(2); Berne Art 2(1).

<sup>11</sup> R.S.C. 1985, ch. C-42, § 2.

entity or process is not now required for a photograph to be protectable.<sup>12</sup> Therefore, photographic (*e.g.*, Polaroid or other similar processes not dependent upon negatives or traditional darkroom development) and photographic-like images resulting from new technology (*i.e.*, digital) processes should now be equally protectable with traditional photographs. It must also be noted in this regard that only one case defines “processes analogous to photography” and it was heard at a time when negative-less works were statutorily not considered to be photographs.<sup>13</sup> It is possible, therefore, that the language change defining “photograph” may not retroactively protect pre-1994 photographs that lack negatives.<sup>14</sup>

In claims of infringement, the copyrightability of a work may be at issue and, therefore, claims of proper authorship and fixation may be challenged. Additionally, in a formal application for copyright registration or where one holds a copyright registration, first publication and national origin may become controversial.

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<sup>12</sup> See *Can. Admiral Corp., Ltd. v. Rediffusion, Inc.* (1954) Ex. C.R. 382, 20 C.P.R. 75.

<sup>13</sup> *Id.*

<sup>14</sup> See *id.*

# OWNERSHIP

## AUTHORSHIP

The copyright acts of both Canada and the U.S. stipulate that ownership in copyright initially vests in the author(s) of the work, although neither statute defines the word “author.”<sup>15</sup> In the U.S., an author is considered to be a person who creates a work by translating an idea into a fixed, tangible expression, embodied in a copy that is entitled to copyright protection. Somewhat similarly, Canada recognizes an author to be the creator — the person originally bringing the work<sup>16</sup> into existence — as the first owner of copyright in the work.<sup>17</sup>

### Originality

Both countries recognize that a copyrightable work must be original with the author and possess some minimal degree of creativity.<sup>18</sup> *Originality*, as the term is used in the U.S., means only that the work was independently created by the author, as opposed to copied from other works.<sup>19</sup> The requisite level of creativity is low,<sup>20</sup> and the

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<sup>15</sup> Copyright Act of 1976, 17 U.S.C.A. § 201; R.S.C. 1985, c. C-42 § 13(1) (1985) (Can.) .

<sup>16</sup> *Work*: generally considered to be the original negative (from which prints (copies) are made) or original transparency

<sup>17</sup> See R.S.C. 1985, c. C-42 § 13(1). *Les Amusements Wiltron Inc. v. Mainville*, [1990] R.J.Q. 1930 (S.C.); *Planet Earth Productions Inc. v. Rowlands* (1990), 30 C.P.R. (3d) 129 (Ont. H.C.) see also .

<sup>18</sup> See *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*, 111 S.Ct. 1282 (1991), also see *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 4 S.Ct. 279 (1884) (applying a similar analysis to photographs); *Breen v. Hancock House Publishers Ltd.* (1985), 6 C.I.P.R. 129 (Fed.T.D.), *John Maryon International Ltd. v. New Brunswick Telephone Co.* (1982), 141 D.L.R. (3d) 193 (N.B. C.A.).

<sup>19</sup> *Feist*, supra.

<sup>20</sup> *Id.*

courts do not “constitute themselves final judges of the worth of pictorial illustrations....”<sup>21</sup>

The originality requirement in Canadian law echoes that of the U.S.: protectable work originates with the author and is not copied<sup>22</sup> — the work must be the original expression of the author’s thoughts.<sup>23</sup> While Canadian copyright law also recognizes that photography is an art, there is no proof required of the “artistic” character of a work in order to achieve copyright protection.<sup>24</sup>

### Fixation

Copyright in Canada cannot be extended to ideas — it is only the fixed expression of ideas that are protectable.<sup>25</sup> Ideas are considered to be in the public domain, usable by all.<sup>26</sup> Notably, the examples of “artistic work(s)” in the Act are all fixed in nature.<sup>27</sup> In this regard the Canadian Act is very much like that in the U.S.

Still, the two acts are not entirely parallel — it is worth noting that the Canadian definition of “every original literary, dramatic, musical, and artistic work” in the Act allows expression in any “mode or form.”<sup>28</sup> This may allow some rather ephemeral forms of modern art that may fall under the meaning of “artistic work” to not be able to meet the fixation requirement. This may not affect photographers but future technologies may prove to be problematic where images might exist in ephemeral form. For example, holographic presentations without the use of screens or other physical media.

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<sup>21</sup> *Bleistein v. Donalson Lithographing Co.*, 188 U.S. 239, 23 S.Ct. 298 (1903).

<sup>22</sup> See *Donoghue v. Allied Newspapers, Ltd.* (1938) 1 Ch. 106.

<sup>23</sup> See *DRG Inc. v. Datafile Ltd.* (1987) 15 F.T.R. 174, 186 C.P.R. (3d) 538, 550 (Fed. Ct.).

<sup>24</sup> See *Pro Arts Inc. v. Campus Crafts Holdings Ltd.* (1980), 50 C.P.R. (2d) 230 (Ont. H.C.).

<sup>25</sup> See *Cuisenaire v. South West Imports, Ltd.*, (1969) S.C.R. 208.

<sup>26</sup> See *Moreau v. St. Vincent*, (1950) Ex. C.R. 198.

<sup>27</sup> R.S.C. 1985, c. C-42 § 2 definition of “artistic works”

<sup>28</sup> R.S.C. 1985, c. C-42 § 2 definition of “Every original literary, dramatic, musical and artistic work”

## National Origin

Canadian copyright extends to published or unpublished photography if the author was, when the work was created, a citizen or subject of, or resident in a treaty country.<sup>29</sup> A treaty country is a country that, like Canada, adheres to the Berne Convention, Universal Copyright Convention (UCC), or is a member of the World Trade Organization (WTO).<sup>30</sup> For example, works first published in Egypt (a Berne adherent along with Canada and the U.S.), are subject to copyright protection in Canada.<sup>31</sup> As of January 1, 1996, retroactive copyright protection is extended to works originating from a Berne or WTO, but not a U.C.C., country, under § 5(1.01). Importantly, the Berne Convention specifies that the works covered by the act, including photographic works,<sup>32</sup> “shall enjoy protection in all countries of the Union.”<sup>33</sup> The Union consists of those countries that apply to the Convention.<sup>34</sup> Authors of protected work under Berne enjoy in countries of the Union other than the country of origin the rights extended now or in the future to their nationals or citizens.<sup>35</sup> Read together, the copyright law and Berne Convention extend copyright protection to U.S. or Canadian photographers that is the equal of the rights extended to nationals of the other country, although, importantly, it may not be the equal of the laws where the photographers is a resident or citizen.

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<sup>29</sup> R.S.C. 1985, c. C-42 § 5(1)(c).

<sup>30</sup> See *Id.* § 2 (Interpretation “treaty country”).

<sup>31</sup> The 1997 Annotated Copyright Act, Normand Tamaro, LL.D., 219 (1996).

<sup>32</sup> Berne Convention for the Protection of Literary and Artistic Works, Art. 2(1)

<sup>33</sup> See *id.*

<sup>34</sup> *Id.* at Art. 1.

<sup>35</sup> Berne Convention, *supra*, Art. 5 (reciprocity often termed “national treatment”)

## First Publication

In regard to published work, first publication must be in “a quantity as to satisfy the reasonable demands of the public,” having occurred in a treaty country.<sup>36</sup>

Publication means more than merely producing copies, it also requires that copies be made available to the public. Publication also means more than the mere issuance of photography.<sup>37</sup> Actions not meeting the definition of “publication” include “communication by telecommunication,”<sup>38</sup> “exhibition in public of an artistic work,”<sup>39</sup> or the issue of photographs of works of sculpture or architecture.<sup>40</sup>

## JOINT WORKS

### Collective / Collaborative Works

Where a work is produced by (1) the collaboration of more than one author, and (2) where the contribution of any author is not distinct from the contribution(s) of other author(s), it can be claimed to be a work of joint authorship.<sup>41</sup> Joint authors are co-authors and thus co-owners, and no one may claim exclusive title to the work.<sup>42</sup> All co-authors must also meet the definition of “author” under the Act.<sup>43</sup> To be considered a co-author, one must do more than simply consult with the author or even inspire the work.<sup>44</sup> Merely suggesting ideas is also not enough without contributing to the

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<sup>36</sup> *Id.*

<sup>37</sup> See R.S.C. 1985, c. C-42 § 2.2(1) (as substituted by NAFTA Implementation Act, S.C. 1993, ch. 44, § 56, and amended by Copyright Amendment Act, R.S. 1997, ch C-24, § 2).

<sup>38</sup> See R.S.C. 1985, c. C-42 § 4(1)(f)

<sup>39</sup> See R.S.C. 1985, c. C-42 § 4(1)(g)

<sup>40</sup> See R.S.C. 1985, c. C-42 § 4(1)

<sup>41</sup> See R.S.C. 1985, c. C-42 § 2 “work of joint authorship”

<sup>42</sup> See *Thibault v. Turcot* (1926), 34 R.L. n.s. 415 (Que. S.C.).

<sup>43</sup> See *Kantel v. Frank E. Grant, Nisbet & Auld Ltd.*, (1933) Ex. C.R. 84.

<sup>44</sup> See *Ecole de Conduite Technic Aube Inc. v. 1509 8858 Quebec Inc.* (1986), 12 C.I.P.R. 284 (Que.S.C.).

expression of the work.<sup>45</sup> The parties to a joint work are not required to contribute simultaneously,<sup>46</sup> so long as the parties retain the mutual desire to collaborate.<sup>47</sup>

Qualifying works include (1) encyclopedias, newspapers, magazines and other similar periodicals, as well as (2) works in which the works or parts of works of different authors are incorporated.<sup>48</sup> Publications in section (1) above are collective by their very nature in that each requires the works of a number of authors working toward a common goal, while those compilations in (2) require the works of different authors who may take no part in the production of the effort.<sup>49</sup>

The copyright in a collective work itself is accorded to the author or authors.<sup>50</sup> The separate components of the work may be, but need not be, subject to copyright.<sup>51</sup> Because the collective work is produced by one or a number of authors, the work of each must be original under the Act<sup>52</sup> and adhere to the other requirements for copyright. A joint owner of copyright cannot license the work without the permission of the other authors<sup>53</sup> and may sue persons licensed by another joint owner without her consent.<sup>54</sup> A joint owner may also sue for infringement without the permission of other authors.<sup>55</sup>

That there must be some level of joint purpose is illustrated in *Levy v. Rutley*. Levy engaged writer Wilks to write a series of plays. As the play was being produced, Levy asked Wilks to make some changes which Wilks promised to do but he passed away before entering the changes. Levy and others made the desired changes and proceeded with the production. Some time later, defendant Rutley mounted an independent production of the play and Levy sued, claiming to be a joint author of the

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<sup>45</sup> See *Kantel v. Grant* (1933) Ex. C.R. 84

<sup>46</sup> See *Bradale Distribution Enterprises Inc. v. Safety First Inc.* (1987), 18 C.I.P.R. 71 (Que. S.C.).

<sup>47</sup> See *Thibault v. Turcot* (1926), 34 R.L. n.s. 415 (Que. S.C.).

<sup>48</sup> See R.S.C. 1985, c. C-42 § 2 "collective work" definition

<sup>49</sup> See *id.*

<sup>50</sup> See *ATV Music Publishing of Canada Ltd v. Rogers Radio Broadcasting Ltd.* (1982), 35 O.R. (2d) 417 (H.C.).

<sup>51</sup> See *id.*

<sup>52</sup> See *Chappel ^ Co v. Redwood Music Ltd*, (1980) 2 All E.R. 817 (H.L.).

<sup>53</sup> See *Powell v. Head* (1879) 12 Cfh. D. 686, 690.

<sup>54</sup> See *Massie & Renwick, Ltd. v. Underwriters' Survey Bureau, Ltd.* (1940) S.C.R. 218, 243. 11

play. It was held that Wilks and Levy had not worked with “one common design for a dramatic piece” and therefore a joint work of authorship had not been created.

Three important factors were enumerated in Levy. First, joint authorship is not based on the parties’ intentions but by the facts and the law.<sup>56</sup> Second, each party need not contribute equally although each must furnish a substantial amount.<sup>57</sup> Third, there must be a joint effort in carrying out a common design (even if one contribution is qualitatively or quantitatively inferior to the other(s)).<sup>58</sup>

### Compilations

Canada, in response to the North American Free Trade Accord, now provides for protection of compilations by copyright. A *compilation* is “a work resulting from the selection or arrangement of literary, dramatic, musical or artistic works or of parts thereof...”<sup>59</sup> and is protected by copyright if it demonstrates originality.<sup>60</sup>

Unlike collective works which are the result of the efforts of multiple authors, a compilation is the result of one or more persons who gather material, possibly from different original authors such as photographers, writers, or artists, and publish the assembled works under one title. The person(s) responsible for the assembling of material — the compilation authors — usually hold the copyright in the compilation,<sup>61</sup> if the production of the compilation has required intellectual labor of the compilation author.<sup>62</sup> Additionally, if a part of the compilation expresses the author’s own thoughts,

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<sup>55</sup> See *id.*

<sup>56</sup> See *id.*

<sup>57</sup> See *id.*

<sup>58</sup> See *id.*

<sup>59</sup> See R.S.C. 1985, c. C-42 § 2 “compilation”

<sup>60</sup> See *National Film Board v. Bier* (1970), 63 C.P.R. 164 (Ex. Ct.).

<sup>61</sup> See *Slumber-Magic*, *supra*,

<sup>62</sup> See *Beauchemin v. Cadieux* (1901), 31 S.C.R. 370; *Garland v. Gemmil* (1887), 14 S.C.R. 321.

she may hold copyright in that part of the overall work.<sup>63</sup> Importantly, for authors of the original works making up the compilation, the original copyrights or moral rights in the constituent works is not affected.<sup>64</sup> If the copyright in a single part of the work is no longer valid, the classification of the overall work as a compilation does not revive the lost copyright in the single part.<sup>65</sup>

Section 2.1(2), as inserted by NAFTA, recognizes the possibility that a compilation may include works of different categories: “A compilation containing two or more of the categories of literary, dramatic, musical or artistic works shall be deemed to be a compilation of the category making up the most substantial part of the compilation.”<sup>66</sup> This raises two problems. First, how does one establish what a compilation is “substantially” made up of? For example, is it determined by the number of pages devoted to text over photographs, or by a percentage of space, or just how is it resolved? Second, does the phrase “categories ... artistic works”<sup>67</sup> include the types of works found within the larger categories? For example, would a book of photographs be designated an “artistic work” or “photograph(s)”?

## TRANSFERS

The copyright in a work may be wholly or partially assigned only if the assignment is in writing and signed by the owner of the work.<sup>68</sup> The rights in a copyrightable work are divisible in many ways: duration (existing for the whole or a limited term of copyright); territorial (a specific or general location of geography); factors of copyright (a single right, for example, one-time use, or the entire list of rights

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<sup>63</sup> See *Pasickniak v. Dojacek*, (1928) 2 D.L.R. 545 (Man. C.A.).

<sup>64</sup> See R.S.C. 1985, c. C-42 § 2.1(1)

<sup>65</sup> See *Slumber-Magic*, *supra*.

<sup>66</sup> See R.S.C. 1985, c. C-42 § 2.1(1)

<sup>67</sup> See R.S.C. 1985, c. C-42 § 5(1)

<sup>68</sup> See R.S.C. 1985, c. C-42 § 13(4) “Assignment of right by owner”

in the work); and percentage (e.g., 50% of publishing rights in North America, or 100% of Commonwealth distribution).<sup>69</sup>

In general, contracting parties enjoy broad freedom to arrange any agreement concerning licenses and assignments. However, contracts of assignment, by which the author relinquishes her rights, are not to be afforded too wide a scope of interpretation.<sup>70</sup> The acquirer is to be afforded only what has been assigned in the terms—within the four corners—of the agreement.<sup>71</sup> Assignment of a work not yet created remains unenforceable until the work has been fully completed.<sup>72</sup>

Case law has determined that where there is an assignment of rights in a work, the author's obligations are fully performed upon delivery of the finished work; the publisher must either publish the work or return it.<sup>73</sup> The publisher, in exchange for an assignment of some of the author's rights in a work, must therefore take the necessary steps to publish.<sup>74</sup>

The Canadian Act deals with assignment of copyright in a work but not the sale of the object which fixes the work.<sup>75</sup> Accordingly, the copyright owner may transfer the physical object embodying the image without assigning copyright in the work.<sup>76</sup> A mere transfer of the physical “vehicle” does not implicitly grant the right to publish a work.<sup>77</sup> For example, the owner of a film must distinguish between the author's rights to the work on the film and the rights of the owner or possessor of the film itself.<sup>78</sup> The authors of a painting, an architect's plans, or a videotape do not relinquish their copyright interests simply because there has been a transfer in possession or ownership

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<sup>69</sup> See *id.*

<sup>70</sup> See *Films Rachel Inc. v. Druker & Associates Inc.* (1995), Doc. No. C.S. Montreal 500–11–001622–931 (Que. S.C.), Julien J. at 43.

<sup>71</sup> See *id.*

<sup>72</sup> See *Katz v. Cytrynbaum* (1983), 76 C.P.R. (2d) 276 (B.C. C.A.).

<sup>73</sup> *Le Sueur v. Morang & Co.* (1911), 45 S.C.R. 95 at 99–100 (Fitzpatrick C.J.) and 115–116, 118–119 (Duff J.).

<sup>74</sup> *Baouchet v. Kyriacopoulos* (1964), 45 C.P.R. 265 at 277 (Ex. Ct.).

<sup>75</sup> See *id.*; See also *Les Amusements Wiltron Inc. v. Mainville*, (1991) R.J.Q. 1930 (S.C.) (for unofficial translation see: 40 C.P.R. (3d) 521).; *Hussey v. Baxter Publications Inc.* (1995), Doc. No. T4298/94 (Ont. Gen. Div.).

<sup>76</sup> *Massie & Renwick Ltd. v. Underwriters' Survey Bureau Ltd.*, (1940) S.C.R. 218.

<sup>77</sup> See *Films Rachel Inc. supra* at 45.

<sup>78</sup> See *id.* at 47.

of the media in which their works are fixed.<sup>79</sup> Authors are well advised to ensure that carefully drafted contracts of assignment be consistently used to conserve their rights in the copyright.<sup>80</sup> It can't be stressed enough that they should note with specificity the rights transferred and retained in the object which fixes the copyrighted work.<sup>81</sup> For photographers this will generally mean the photographer retains title to the photographic print, negative, or transparency and requires their immediate return after publication.

## MORAL RIGHTS

Unlike the U.S., which fails to expressly provide for moral rights, the Canadian Act acknowledges the moral rights of integrity and of attribution.<sup>82</sup> The doctrine of moral rights recognizes that although an author may assign ownership of a work to another party, the author enjoys a continuing interest in protecting her reputation as represented by the work.<sup>83</sup> The right of integrity can be infringed when the work is distorted, mutilated, or otherwise modified or used in association with a product, service, or cause.<sup>84</sup> The copyright holder is granted the authority to enjoin infringing use of her works where such use would directly or indirectly degrade her reputation. The right of integrity is often illusory because it is usually reserved to cases of egregious infringement. The right of attribution, on the other hand, is the right of the author to be

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<sup>79</sup> See *Bouchet v. Kyriacopoulos* (1964), 45 C.P.R. 265 (Ex. Ct.); *Webb & Knapp v. Edmonton (City)* (1970), 44 Fox Pat. C. 141 (S.C.C.); *Tom Hopkins International Inc. v. Wall & Redekop Realty Ltd.* (1985), D.L.R. (4d) 407 at 410–411 (Anderson J.A.) (B.C. C.A.).

<sup>80</sup> See *Arcon Canada Inc. v. Arcobec Aluminum Inc.* (1984), 7 C.P.R. (3d) 382 at 395 (Que. S.C.).

<sup>81</sup> *Planet Earth Productions Inc. v. Rowlands* (1990), 30 C.P.R. (3d) 129 (Ont. H.C.) (regarding the distinction between the photographic print and the copyright attached to the image "fixed" on the print).

<sup>82</sup> See R.S.C. 1985, c. C-42 § 14.1(1) "Moral rights"

<sup>83</sup> See *Peter Gnass v. La Cite d'Alma et Alma Festival Inc.* (1977) Quebec No. 09-000032-745, Rinfret, Crete et Bernier J.J.A. (Que. C.A.).

<sup>84</sup> See R.S.C. 1985, c. C-42 § 28.2(1)

associated with the work either by name, under a pseudonym, or the right to remain anonymous.<sup>85</sup>

Moral rights may not be assigned, although they may be waived.<sup>86</sup> Because moral rights are considered to be rights of the author's personality, they cannot be assigned to another; these are rights too personal to be assigned to another personality. However, an author may waive those moral rights in whole or in part.<sup>87</sup> Moreover, an assignment of copyright does not constitute a waiver of any moral rights.<sup>88</sup>

## IMPORTATION

Like the U.S., Canadian copyright law holds that an owner of copyrighted items may injunctively prohibit importation of copies of those items.<sup>89</sup> There are a few exceptions, but they are narrowly drawn. Generally, this particular statute shouldn't be an issue for U.S. photographers.

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<sup>85</sup> See § 14.1(1) "Moral rights"

<sup>86</sup> See R.S.C. 1985, c. C-42 § 14.1(2) "No assignment of moral rights"

<sup>87</sup> See *id.*

<sup>88</sup> See R.S.C. 1985, c. C-42 § 14.1(3) "No waiver by assignment"

<sup>89</sup> See R.S.C. 1985, c. C-42 § 44 "Importation of certain copyright works prohibited"

# LIMITATIONS ON THE BASIC OWNERSHIP DOCTRINE

## OWNERSHIP OF PHOTOGRAPHIC MATERIALS

There are two limiting provision in Canadian copyright law that pose particular threat to unwary photographers: that concerning ownership of negatives or plates<sup>90</sup> and the commissioning of work. Canadian law provides that the person or corporate body that owns the “negative or other plate” at the time it is made is deemed to be the author of the photograph that results from it.<sup>91</sup> Since most photographers, especially independent contractor authors, buy their own film, this provision shouldn’t generally become an issue. Unanswered is the question—if the photographer buys the film, pays for its processing, and is later reimbursed for purchase and processing, can it be said that the client then owns the copyright? Absent any agreement to the contrary, payment for the costs of film and processing in the U.S. creates something of a presumption of ownership of the film, but doesn’t imply interest or title in the copyright. The prudent photographer should contractually ensure that it is the photographer who retains both copyright and title to the physical entity when work is commissioned by Canadian (or any) clients.

In the case of a photograph, or portrait, where the plate or other original was ordered by another for valuable consideration, the one who ordered the work is the first owner of copyright, in the absence of a contrary agreement.<sup>92</sup> “Valuable consideration” has been held to be not only currency and can consist of services rendered.<sup>93</sup>

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<sup>90</sup> R.S.C. 1985, c. C-42 § 2 “Plate,” a rather broad term that includes any plate, stone, block “transfer or negative used or intended to be used for printing or reproducing copies of any work....”

<sup>91</sup> R.S.C. 1985, c. C-42 § 10(2)(a).

<sup>92</sup> *Id.* at § 13(2): “Engraving, photograph or portrait;” also see *Planet Earth Productions Inc. v. Rowlands* (1990), 30 C.P.R. (3d) 129 (Ont. H.C.).

<sup>93</sup> See *Paul Couvrette Photographs v. The Ottawa Citizen* (1985), 7 C.P.R. (3d) 552 (Ont. Prov.Ct.) (“consideration in the form of waiver of the model’s normal fee....”)

Despite these two problem areas there may still exist a subtle sanctuary for photographers who are reticent to preserve their rights contractually (the near universal reluctance of artists to use paperwork). An established custom of granting rights back to a photographer (or, viewed differently, the retention of basic ownership rights), can constitute a rule of agreement thereby superseding § 13(2).<sup>94</sup> Further, it is well established that custom can prevail even in the absence of an agreement regarding ownership rights.<sup>95</sup> For example, an independent photographer remains the owner of copyright as well as owner of the physical article when, for valuable consideration, a newspaper commissions a photograph with or without a formal agreement.<sup>96</sup> Custom may dictate similar treatment when dealing with other clients as well (*e.g.*, advertising agencies, corporations, or other publications than newspapers, although this is unknown by this writer).

These provisions do not encompass photographs taken on “speculation,” that is, self-assigned “stock” photographs taken with the thought of later sales or licensing to other parties.<sup>97</sup> There appear to be no similar exceptions to the principal rule of author ownership that similarly affects ownership of pre-existing photography.

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<sup>94</sup> See *Allen v. Toronto Star Newspapers Ltd.* (1995), 63 C.P.R. (3d) 517 (Ont. Gen. Div.).

<sup>95</sup> See *Id.*

<sup>96</sup> See *Id.*

<sup>97</sup> See *Planet Earth Productions*, 30 C.P.R. (3d) 129.

## WORKS MADE IN THE COURSE OF EMPLOYMENT

Under Canadian copyright law, authors may be commissioned under two forms of agreement: contracts of service and contracts for service. Essentially, these forms of employment distinguish employer – employee relationships from independent contractors.

### Contract Of Service — The Author As Employee...

Canadian copyright law creates an exception to the general principal of copyright—whereby ownership vests in the actual creator—that is similar to the U.S. work for hire doctrine. Photographers own the photograph and copyright in Canada so long as they own the original negative (or film, presumably) at the time the work was created. However, contracts of service create a master–servant relationship.<sup>98</sup> Where a person is employed by another under a contract of service or apprenticeship, and the work was made in the course of his employment, the employer shall be the first owner of copyright in the work, unless there is an agreement to the contrary.<sup>99</sup> In deciding whether this relationship exists, the courts weigh the degree of control by the employer or, conversely, the amount of independence the person rendering services has over the work itself and how and when it will be produced.<sup>100</sup>

Apparently, the courts have not fully defined the scope of clause § 13(3) regarding authorship of a work while in the employment of another. The applicability of § 13(3) is sometimes difficult to discern and is more or less strictly applied.<sup>101</sup> There

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<sup>98</sup> Chromecek, Milan and Stuart C. McCormack, *Canada: World Intellectual Property Guidebook*, § 4E Ownership of Copyright (2)(a) at 4–19.

<sup>99</sup> R.S.C. 1985, c. C–42 § 13(3) “Work made in the course of employment”; also see *Schauenburd Industries Ltd. v. Borowski* (1979), 25 O.R. (2d) 737 (H.C.).

<sup>100</sup> Harris, Lesley Ellen, *Canadian Copyright Law*, p 76 (1992) (factors similar to those in CCNV–*Community for Creative Non–Violence*, supra).

<sup>101</sup> See *Rucker Co. v. Gavel’s Vulcanizing Ltd.* (1985), 7 C.P.R. (3d) 294 at 298 (Fed. T.D.). 19

must be a contract of service, thus allowing the employer a certain degree of control over the author's work.<sup>102</sup> Also, the work must have been created within the course of the contract with the creator – employee.<sup>103</sup> Where these requirements are not met, the employer is considered to be the first owner of copyright.<sup>104</sup>

In *Massie & Renwick Ltd. v. Underwriters' Survey Bureau Ltd.*, the court addressed initial vesting of copyright where work was created by employees; work remained that of the firm where it was integral to the firm and was ordered and supervised by the employer.<sup>105</sup> But, in *Hussey*, a company provided an office for the author in exchange for access to company production services.<sup>106</sup> Under such circumstances, the copyright was deemed to be owned by the creator because a proper employer – employee relationship had not been established.<sup>107</sup>

#### Contract For Services—Author As Independent Contractor...

Where an independent contractor is employed under a contract for services, the copyright in a work vests not in the commissioning party but in the independent worker.<sup>108</sup> In analyzing the factors distinguishing contracts *of* service and contracts *for* services, see *Lee Ting Sang*, and *CCNV v. Reid*.<sup>109</sup> In both Canada and the U.S., the independent creator of a work is considered to be the author and the initial owner of copyright.

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<sup>102</sup> See *id.*

<sup>103</sup> See *id.*

<sup>104</sup> See *Les Amusements Wiltron Inc. v. Mainvaill*, (1991) R.J.Q. 1930 (S.C.).

<sup>105</sup> See *Massie & Renwick Ltd. v. Underwriters' Survey Bureau Ltd.*, (1940) S.C.R. 218.

<sup>106</sup> See *Hussey v. Baxter Publications Inc.* (1995), Doc. No. T4298/94 (Ont. Gen. Div.).

<sup>107</sup> See *id.*

<sup>108</sup> *Goldner v. C.B.C.* (1971) 7 C.P.R. (2d) 158, 161–62 (Fed. Ct.). See also *Lee Ting Sang v. Chung Chi-Keung* (1990) 2 A.C. 374, 2 W.L.R. 1173 (P.C.) (discussing factors distinguishing contract for services from a contract of service; factors similar to those in *CCNV–Community for Creative Non–Violence v. Reid*, 109 S.Ct. 2166 (1989) determining qualification of “employee” under U.S. Copyright Act § 101 “Work for Hire”).

<sup>109</sup> *Lee Ting Sang*, *supra*; *CCNV v. Reid*, *supra*

## OWNERSHIP SUMMARY

Under Canadian copyright law, §§ 10(2),<sup>110</sup> 13(2),<sup>111</sup> and 13(3),<sup>112</sup> read together, establish the presumption that the owner of the negative, transparency, or photograph (if there is no negative) when made is deemed to be the author of the photograph (*i.e.*, in most cases it will be the photographer), unless —

- it was ordered by another for valuable consideration, or
- it was produced within the author's course of employment.

Importantly, either written agreements or industry custom recognizing retention by the real author / photographer of her copyright in the work can overcome § 10 or § 13 exceptions.<sup>113</sup>

It is as imperative under Canadian copyright law as it is under U.S. law that a photographer put in writing only those rights that are being licensed and that all other rights are retained by the author.

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<sup>110</sup> Negative owner also owns the copyright

<sup>111</sup> Ordering photography with valuable consideration

<sup>112</sup> Work made in the course of employment

<sup>113</sup> Although it is established custom that independent photographers retain their copyright rights when doing work for Canadian newspapers, it is not established by this writer that similar custom exists when doing work for other publications (*e.g.*, magazines), corporations, advertising agencies, audio visual firms, graphic designers, or other users of photography; it would be valuable to ascertain industry custom in these other areas of publishing].

# TERMS OF COPYRIGHT

## CANADIAN NATIONALS

Prior to 1998, when the 1997 Amendment Act became effective, the term of Canadian copyright on photographs extended from the date of making either the initial negative from which the photograph was derived, or when the initial photograph was created when there was no negative (*e.g.*, Polaroid photographs), through the remainder of the calendar year and for a period of fifty years thereafter.<sup>114</sup>

Beginning in 1998, copyright subsists in photographs for the life of the author plus fifty years.<sup>115</sup> If the author is a corporation the term of duration is then fifty years after the end of the calendar year in which the work was created.<sup>116</sup> An exception exists when the majority of voting shares in the corporation are owned by the human author of the photograph(s). In that case, the copyright term of author life plus fifty-years applies.<sup>117</sup>

For the transitional period running from 1994 until 1998, a fifty-year term of copyright in photographs runs from the end of the year in which either of the following takes place: the making of the initial negative from which the photograph is derived or the making of the initial photograph when there is no initial negative.<sup>118</sup>

## FOREIGN WORKS

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<sup>114</sup> R.S.C. 1985, c. C-42 § 10(1) "Term of copyright in photographs."

<sup>115</sup> See Copyright Amendment Act, S.C. 1997, ch. C-24, Secs. 7 (introducing new Sec. 10(1) into the Act) and 54.1(a) (transitional provision; Copyright Act, S.C. 1985, ch. C-42, Sec. 6 (the term of copyright in the U.S. is now author's life plus 70 years).

<sup>116</sup> *See id.*

<sup>117</sup> *See id.*

Under the Canadian Act, copyright is recognized for qualifying foreign, U.S., works as if the work was that of a Canadian national.<sup>119</sup> There are two exceptions:

- Works of joint authorship survive for fifty years after the death of the last surviving joint author,<sup>120</sup> but authors who are nationals of any country (but not those party to NAFTA) granting a shorter term of copyright cannot claim a longer term in Canada.<sup>121</sup>
- Work first made or published in a Berne Convention or WTO member state, or by a national of such a state, are protected under Canadian copyright<sup>122</sup> for the full term beginning at the date of creation or first publication. However, if the copyright in a work has expired before the country joins Berne or WTO, then this protection does not apply.<sup>123</sup>

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<sup>118</sup> Copyright Act, R.S.C. 1985, ch. C-42, Sec 10(1), inserted by NAFTA Implementation Act, S.C. 1993, ch. 44, Sec. 60(1) [likely not applying to works not qualifying as photographs under pre-1994 definition of “photograph.”]

<sup>119</sup> R.S.C. 1985, ch. C-42, Sec 9(2) “Nationals of other countries” ( “national treatment” doctrine),

<sup>120</sup> R.S.C. 1985, c. C-42 § 9(1) “Cases of joint authorship”

<sup>121</sup> R.S.C. 1985, c. C-42 § 9(2) “Nationals of other countries”

<sup>122</sup> WTO Implementation Act, S.C. 1994, ch. 57 (beginning January 1, 1996).

<sup>123</sup> Copyright Act, R.S.C. 1985, ch. C-42, §§ 5(1.02) and (7), inserted by WTO Implementation Act, S.C. 1994, ch 57, § 57(1), and § 5(1.03), inserted by Copyright Amendment Act, S.C. 1997, ch. C-24, § 4(2).

## LIMITATIONS ON EXCLUSIVE RIGHTS—FAIR USE

There are some uses of another's work not considered to be infringing of an author's copyright. In Canada, § 27(2), and in the U.S., §§ 107 through 112, enumerate exceptions to the exclusive rights provided to authors in the respective copyright statutes. In the U.S., these limitations are often grouped together under the broad rubric of "fair use";<sup>124</sup> the comparable Canadian term seems to be *fair dealing*.

In Canada, the explicit nature of the statutory limitations to a copyright holder's exclusive rights are considered to preclude the possibility of implied exceptions.<sup>125</sup> The courts have additionally held that these exceptions are to be narrowly interpreted.<sup>126</sup>

The following acts are codified in the Act and do not constitute actionable infringement:<sup>127</sup>

Fair dealing consists of acts that make up "any work for the purposes of" "(a) private study or research";<sup>128</sup> or "(a.1) criticism, review or newspaper summary, if (i) the source, and (ii) the author's name, if given in the source, are mentioned."<sup>129</sup>

Unfortunately, the limits of fair dealing with a work are not clearly established, but it is known that dealing that is "fair" does not constitute usurping another's work.<sup>130</sup> The limits of private study or research also lack precise definition. Because Canadian courts have held that the concept of fair dealing is to be sparingly offered, fair dealing does not include, for example, labeling as literary criticism the use of a complete text with the addition of some commentary<sup>131</sup> or reproduction of a magazine cover in which a single photograph predominates.<sup>132</sup> Canadian law, unlike American law, appears to lack

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<sup>124</sup> Only § 107 is entitled "Fair Use"

<sup>125</sup> See *Bishop v. Stevens*, (1990) 2 S.C.R. 467.

<sup>126</sup> See *id.*

<sup>127</sup> See R.S.C. 1985, c. C-42 § 27(2) "Acts not constituting infringement of copyright"

<sup>128</sup> See R.S.C. 1985, c. C-42 § 27(2)(a) "Any fair dealing with any work..."

<sup>129</sup> See R.S.C. 1985, c. C-42 § 27(2)(a.1) "Any fair dealing with any work..."

<sup>130</sup> See *Breen v. Hancock House Publishers Ltd.* (1985), 6 C.I.P.R. 129 at 133 (Fed. T.D.).

<sup>131</sup> See *Zamacois*, *supra*.

<sup>132</sup> See *Allen v. Toronto Star Newspaper Ltd.* (1995), 63 C.P.R. (3d) 517 (Ont. Gen. Div.).

criteria establishing whether the use of borrowed material for criticism is legitimate fair use.<sup>133</sup>

There are some acts that appear to copy another's work but actually don't. These are often confused with infringing acts of copying and are sometimes improperly defended under the Canadian "fair dealing" defense. The author of a work who is not the copyright owner may reuse the same creative processes so long as the "main design" of the copyright owner's work is not imitated or repeated.<sup>134</sup> Otherwise, an author would be foreclosed from doing similar but not infringing work and from building upon earlier efforts; all vital elements of the creative process. Similarly, authors are not precluded from documenting by way of photography works made of "sculpture or artistic craftsmanship, if permanently situated in a public place or building...."<sup>135</sup>

In addition to fair dealing, non-profit educational institutions, libraries, archives, and museums are not held liable for wrongful duplicating on their photocopying machines if a notice of warning of possible copyright infringement is affixed to the machine.<sup>136</sup> This exemption applies only if the institution has a photocopy agreement with a collective society,<sup>137</sup> but this provision hasn't yet been tested in the courts.<sup>138</sup>

A work may be incidentally included in another's work without infringement of copyright.<sup>139</sup> For example, a photograph displayed on a background wall of a film set. Also, paintings, photographs, or cinematographic works may be made of other works that are publicly displayed.<sup>140</sup>

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<sup>133</sup> See 17 U.S.C.A. § 107 (recognizing elements to determine the legitimacy of borrowing work: purpose and nature of the copyrighted work, particularly whether the work borrowed is for commercial purposes; nature of the work borrowed; amount and nature of the borrowed work compared to the original work as a whole; and, what effect, if any, borrowing has on the potential market for and value of the original work).

<sup>134</sup> See R.S.C. 1985, c. C-42 § 27(2)(b)

<sup>135</sup> R.S.C. 1985, c. C-42 § 27(2)(c) (the photographer must use care to clearly indicate that it is only the photograph that is her own work product to avoid infringing another's right of attribution or creating a likelihood of confusion that could possibly expose the photographer to trademark infringement claims).

<sup>136</sup> See R.S.C. 1985, c. C-42 new § 30.3

<sup>137</sup> See *id.*

<sup>138</sup> See R.S.C. 1985, c. C-42 § 8(1)(a)(i) "authorization of infringement"

<sup>139</sup> See R.S.C. 1985, c. C-42 new § 30.7

<sup>140</sup> See R.S.C. 1985, c. C-42 § 8(2)(a)

Finally, the federal Charter of Rights and Freedoms, § 2(b), protects “freedom of thought, belief, opinion, and expression” and freedom of the press. Section 1 of the Charter restricts those freedoms to “reasonable limits.” For example, a trial court denied the use of a corporation logo by a labor union during attempts to organize a factory. It was held that free expression could not supersede the property right in copyright.<sup>141</sup> The “reasonable limits” approach appears to be settled on a case-by-case basis.

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<sup>141</sup> *Cie Generaie des Etates dissements Michelin, C.A.W.–Canada* (1996) 71 L.P.R. (3d) 848 (Fed. Ct.); see also R.S.C. 1985, c. C-42 new § 32.2(1)(b)

# INFRINGEMENT

In a perfect world, photographers would be able to pursue the remedies afforded by copyright law when their work was infringed. But the realities of the situation are such that even if the photographer did discover an infringement, the effort and financial outlay required to enforce the photographer's rights would often prove too costly for the potential remedy. Even fewer photographers possess the resources to sustain a prosecution especially internationally.

The more common acts of infringement plaguing photographers are those where publishers use photographers' works without prior authorization; use work with permission but then wrongly assume that a limited license offers greater or even infinite future usage; use work with permission but then fail or refuse to pay the agreed upon fee (this may actually be more of a collections problem, but many photographers condition rights transfer only upon payment); and refusal to return the physical entity embodying the licensed image after production and publication are completed.

An infringement in copyright occurs when "any person who, without the consent of the owners of the copyright, does anything that, by this Act, only the owner of the copyright has the right to do."<sup>142</sup> Infringement does not require intent or knowledge of wrongdoing; the mere unauthorized commission of a copyright protected act constitutes infringement.<sup>143</sup> As a result, the consent of the copyright holder must be obtained prior to reproducing a protected work, for example.<sup>144</sup>

Good faith is not a defense to infringement of a literary work for the editor who authorizes the printing or copying of the work.<sup>145</sup> It is widely held that ignorance of the copyright law is no excuse!<sup>146</sup> One must assume that a work is protected, whether or not

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<sup>142</sup> See R.S.C. 1985, c. C-42 § 27(1) "Infringement of copyright"

<sup>143</sup> See *Vigneux v. Canadian Performing Right Society* (1943), 3 Fox. Pat. C. 77 (S.C.C.); also see *R. V. James Lorimer & Co.* (1984) 1 F.C. 1065 at 1073 (Mahoney J.A.) C.A.).

<sup>144</sup> See *De Montigny v. Cousineau*, (1950) S.C.R. 297.

<sup>145</sup> See *91439 Canada Ltee v. Editions JCL Inc.* (1992), 41 C.P.R. (3d) 245 (Fed. T.D.), rev'd in part, (1995) 1 F.C. 380 (C.A.).

<sup>146</sup> See *Zamacois v. Douvill* (1943), 3 Fox Pat. C. 44 at 74 (Ex. Ct.).

there is an indication of protection on a copy of the work.<sup>147</sup> Permission to reproduce a work must come from the person(s) authorized to extend such permission; mere belief that one has authorization is insufficient.<sup>148</sup> For example, a television station adhered to the mistaken belief that its federal transmission license conferred the right to exploit without the authors' permission various works to be broadcast.<sup>149</sup>

The courts narrowly construe limitations on copyrights in the belief that the legislature, if dispossessing a person of her rights, will state their intention to do so either explicitly or impliedly.<sup>150</sup> In the case of the television station, nothing in the law of either copyright or station licensing stated that a broadcast license exempted the station from the provisions of copyright law. Merely requesting authorization to reproduce a work and not receiving a reply is insufficient authorization, no matter the financial loss involved.<sup>151</sup>

Where works are almost identical it is obvious infringement.<sup>152</sup> Where the similarity of works is not one of coincidence, infringement will be found.<sup>153</sup> A work need not be entirely copied to be infringed.<sup>154</sup> Infringement is committed even where the wrongdoer adds or subtracts elements from the protected work or disguises the reproduction.<sup>155</sup> The use of digital imaging equipment makes it far more easy to take parts of existing photographs and combine them into "new" but infringing works.

U.S. photographers will most likely be concerned about the acts of Canadian photographers where it appears a client has engaged the services of the latter to essentially duplicate a photograph originally created by a U.S. photographer so that the

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<sup>147</sup> See *Jacques v. La Nouvelle de Sherbrooke*, J.E. 91–619 (S.C.); see also *MCA Canada Ltd v. Gillberry & Hawke Advertising Avengy Ltd.* (1976), 28 C.P.R. (2d) 52 at 54 (Fed. T.D.); *T.J. Moore Co. Ltd. v. Accessoires De Bureau De Quebec Inc.* (1973), 14 C.P.R. (2d) 113 at 125 (Fed. T.D.).

<sup>148</sup> See *De Montigny v. Cousineau*, (1950) S.C.R. 297.

<sup>149</sup> See *Warner Brothers–Seven Arts Inc. v. CESM–TV Ltd.* (1971), 65 C.P.R. 215 (Ex. Ct.).

<sup>150</sup> See *id.*

<sup>151</sup> See *Breen v. Hancock House Publishers Ltd.* (1985), 6 C.I.P.R. 129 (Fed. T.D.).

<sup>152</sup> See *Collins v. Rosenthal* (1974), 14 C.P.R. (2d) 143 (Fed. T.D.).

<sup>153</sup> See *Beauchemin v. Cadieux* (1900), 10 Que. K.B. 255 at 287 (Blanchet J.A.), affirmed (1901), 31 S.C.R. 370; *Formules municipales Ltee v. Pineault* (1975), 19 C.P.R. (2d) 139 (Fed. T.D.).

<sup>154</sup> See *Editions Hurtubise H M H Ltee v. Cegep Andre–Laurendeau*, (1989) R.J.Q. 1003 (Que. S.C.).

client doesn't have to license the use of the U.S. photographer's stock image or engage her to create something similar on assignment. This kind of infringement occurs too often with advertising agencies and audio visual producers who, for a multitude of excuses, see photographs they like and they simply copy them or find another to reproduce them. If the original U.S. photographer is ever lucky enough to discover such infringing use, she may take action under either Canadian or possibly U.S. copyright law.

## IDEA USE

The theory behind the copyright laws of both countries is quite similar: the use of an idea does not itself constitute infringement.<sup>155</sup> Copyright does not exist in ideas, only in the expression of ideas—there is not a monopoly in ideas.<sup>157</sup>

Noting that a photographer received inspiration from several sources, one court wrote that an author could not prevent competitors from using the same resources to make up their own publicity. That didn't mean, however, that someone could use his work without authorization.<sup>158</sup> Despite the presence of a number of similarities, there is no infringement if similarities are based on common knowledge.<sup>159</sup> This is why real-life events cannot be claimed as the exclusive domain of any one photographer.<sup>160</sup> But, if the similarities are based on copying the expression of another author, copyright is infringed<sup>161</sup> unless an idea cannot be expressed in another way.<sup>162</sup> Still, although an

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<sup>155</sup> See *National Breweries Ltd. v. Paradis*, (1925) S.C.R. 666 at 668 (Anglin C.J.).

<sup>156</sup> See *Cuisenaire v. South West Imports Ltd.*, (1969) S.C.R. 208 at 211 (Ritchie J.).

<sup>157</sup> See *Stevenson v. Crook*, (1938) Ex. C.R. 299; See also *Moreau v. St-Vincent*, (1950) Ex. C.R. 198 at 204–05.

<sup>158</sup> *Centre de location Ravary (Laval) Ltee v. Tele-Direct (Publications) Inc.*, (1995) R.J.Q. 1245 at 1252 (S.C.).

<sup>159</sup> See *Preston v. 20th Century-Fox Canada Ltd.* (1990), 33 C.P.R. (3d) 242 (Fed. T.D.).

<sup>160</sup> See *Bonis-Charancle v. De Gouriadec* (1923), 62 Que. S.C. 22.

<sup>161</sup> See *id.*

<sup>162</sup> See *Belanger v. At&T Canada Inc.* (1994), Doc. No. C94-2481 (B.C. Prov. Ct.).

infringer may rearrange information in a different way, his efforts to do so may remain irrelevant and remain infringing.<sup>163</sup>

## SUBSTANTIAL PART

Infringement may be relatively easily established when there is a direct copy made of protected work,<sup>164</sup> or even when there are only minor changes.<sup>165</sup> Any work may consist of a number of ideas or elements that may be used by others.<sup>166</sup> It is where the collection of those ideas lead to a similar global concept that an infringement takes place.<sup>167</sup> The elements of a work should not be evaluated separately; infringement must be analyzed from the perspective of the spectator who looks at the work as a whole.<sup>168</sup>

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<sup>163</sup> See *British Columbia Jockey Club v. Standen (Winbar Publication)*, (1985), 8 C.P.R. (3d) 283 at 285 (Macdonald J.A.) (B.C. C.A.).

<sup>164</sup> See *Ecole de Conduite Tecnic Aube Inc. v. 1509 8858 Quebec Inc.* (1986), 12 C.I.P.R. 284 at 302 (Que. S.C.).

<sup>165</sup> See *U&R Tax Services Ltd. v. H & R Block Canada Inc.* (1995), 62 C.P.R. (3d) 257 (Fed. T.D.) (factors considered by the courts include: (1) quality and quantity of material taken; (2) extent to which defendant's use adversely affects plaintiff's activities and diminishes value of plaintiff's copyright; (3) whether material taken is the proper subject-matter of copyright; (4) whether defendant intentionally appropriated plaintiff's work to save time and effort; and (5) whether material taken is used in the same or similar fashion as the plaintiff's).

<sup>166</sup> See *2426-7536 Quebec Inc. v. Provigo Distribution Inc.*, 50 C.P.R. (3d) 539 (Que. S.C.).

<sup>167</sup> See *id.*

<sup>168</sup> See *Humeur Design, Inc. v. Ohayon* (1994), Doc. No. C.S. Montreal 500-05014926-933 (Que. S.C.).

# REMEDIES

## JURISDICTION—WHOSE LAW GOVERNS?

It does not always follow that an author under U.S. copyright doctrine will be recognized as the initial owner of Canadian copyright, although Canadian principles may govern initial vesting of copyright, whatever the country of origin of the work.<sup>169</sup> Canadian law governs assignments of copyright under Canadian contracts.<sup>170</sup> For example, an assignment of world rights by a Canadian contract, but under 1909 U.S. copyright law, effectively transferred those interests in U.S. copyright.<sup>171</sup>

Jurisdiction in the case of an infringement is determined by the copyright laws of the nation in which the offense occurred. In the case of U.S. photographers who have had their work infringed in Canada, relief must be sought in the Canadian courts. But if a Canadian publisher distributes the infringing work in the U.S., then the U.S. photographer might well be able to bring the case into U.S. federal courts under U.S. copyright law.<sup>172</sup>

The effect of multinational treaties is that of “national treatment,” whereby the work of a U.S. national author receives the same protection in a foreign, treaty member, nation as would a national of that country.<sup>173</sup> It is commonly acknowledged that the doctrine of national treatment implicates a rule of territoriality.<sup>174</sup> In that case, the law that applies is that of the jurisdiction where the infringement occurred, not where the

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<sup>169</sup> See *e.g.*, *Frank Brunckhorst Co v. Gainers, Inc.* (1993) 47 C.P.R. (3d) 222 (Fed. Ct.) (unsuccessful attempt to rely on U.S. work for hire doctrine, as to work of U.S. origin, to bypass Canadian requirement of a written assignment).

<sup>170</sup> See *Bishop v. Stevens* (1987) 80 N.R. 302, 18 C.P.R. (3d) 257, 260, 16 C.I.P.R. 243 (Fed. C.A.), affirmed, (1990) 72 D.L.R. (4th) 97, 31 C.P.R. (3d) 394 (S.C.C.).

<sup>171</sup> See *Campbell, Connelly & Co., Ltd. v. Noble* (1963) 1 All E.R. 237 (Ch.).

<sup>172</sup> See *Allarcom Pay Television Ltd. v. General Instrument Corp.*, 69 F.3d 381, 387 (9th Cir. (1995)).

<sup>173</sup> See Universal Copyright Convention (UCC) Art. II; Berne, *supra*, Art. V.

<sup>174</sup> See *Subafilms, Ltd. v. MGM Pathe Communications Co.*, 24 F.3d 1088, 1097 (9th Cir. 1994).

author resides, or is a national, or where the work was first published.<sup>175</sup> But that is not necessarily all bad. Although Canadian courts regularly cite United Kingdom and British Commonwealth law, there also is a tendency to cite U.S. law that can benefit an infringed U.S. photographer.<sup>176</sup>

In general, U.S. copyright laws lack extraterritorial effect.<sup>177</sup> Therefore, infringing actions that take place entirely outside the United States are not actionable.<sup>178</sup> The Supreme Court has held that it is a long-standing principle of American law that the legislation of Congress is intended to apply only within the territorial jurisdiction of the U.S.;<sup>179</sup> the copyright laws of one country lack extraterritorial effect, unless otherwise provided for.<sup>180</sup> There is nothing in the 1976 Act or other relevant documents hinting at congressional intent to alter the existing extraterritoriality doctrine.<sup>181</sup>

The Federal Court in Canada has concurrent jurisdiction with provincial courts to hear and determine actions under the Canadian copyright act.<sup>182</sup> The advantage of depending upon the federal courts is their greater expertise with matters involving intellectual property, the ability to be heard sooner than in lower courts, and because federal court decisions are considered to have binding nationwide authority.<sup>183</sup>

In summary, the U.S. photographer faced with enforcing an infringement claim in Canada generally must resort to the courts in that country, unless there is also a simultaneous infringement that occurs in the U.S..

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<sup>175</sup> See *id.*; also see 1 International Copyright Law and Practice, Intr. § 6, at 182 (Paul E. Geller & Melville B. Nimmer eds., 1993).

<sup>176</sup> See *Garland v. Gemmill* (1886) 2 C.C.L.R. 292, 296 (Canadian registration modeled on U.S. Copyright Act); *Prism Hospital Software, Inc. v. Hospital Medical Records Institute* (199) C.P.R. (3d) 129, 271 (B.C. (U.S. decisions regarding software should be considered).

<sup>177</sup> See *Peter Starr Prod. Co. v. Twin Continental Films, Inc.*, 783 F.2d 1440 (9th Cir. 1986); *Robert Stidwood Group, Ltd. v. O'Reilly*, 530 F.2d 1096, 1101 (2d Cir.), cert. denied, 429 U.S. 848, 50 L. Ed. 2d 121, 97 S.Ct. 135 (1976).

<sup>178</sup> See *id.*

<sup>179</sup> See *EEOC v. Arabian American Oil Co. (Aramco)*, 499 U.S. 244, 111 S. Ct. 1227, 1230, (1991).

<sup>180</sup> See *United Dictionary Co. v. G. & C. Merriam Co.*, 208 U.S. 260, 264–66, 28 S. Ct. 290 (1908) (predating 1909 U.S. Copyright Act); *Ferris v. Frohman*, 223 U.S. 424, 32 S. Ct. 263 (1912).

<sup>181</sup> See *Peter Starr, supra*, at 1442.

<sup>182</sup> See R.S.C. 1985, c. C-42 § 37 "Concurrent jurisdiction of federal court"

<sup>183</sup> Harris, *supra*, at p. 157.

## CIVIL REMEDIES

### Injunctive Relief

An owner of copyright that has suffered an infringement may sue civilly for an injunction, damages, accounts, “or other remedies that are or may be conferred by law for the infringement of a right.”<sup>184</sup> The burden is on the plaintiff to prove infringement, but once *prima facie* evidence of infringement has been proven the burden shifts to the defendant to show that he has not infringed the work.<sup>185</sup>

Once a *prima facie* case of infringement has been shown and if a victim can further show that irreparable harm will result without an injunction, an interlocutory injunction may be granted.<sup>186</sup> Some courts have held that in matters of copyright a showing of only infringement may be sufficient,<sup>187</sup> some have held that the mere existence of infringement causes irreparable harm,<sup>188</sup> and even without proof of actual damages an interlocutory injunction has been granted.<sup>189</sup>

When it is proved that a defendant is intruding on an exclusive right, the copyright holder has a *prima facie* right to a permanent injunction to prevent future violation or to effect return of the plaintiff’s work or the defendant’s infringing work.<sup>190</sup> The injunction may be entered even if the victim has neither proven nor suffered

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<sup>184</sup> See R.S.C. 1985, c. C-42 § 34(1) “Civil remedies”

<sup>185</sup> See *Beauchemin v. Cadieux* (1900), 10 Que. S.C. 255.

<sup>186</sup> See *Federal Liberal Agency of Canada v. CTV Television Network Ltd.* (1988), 24 C.P.R. (3d) 470 (Fed. C.A.).

<sup>187</sup> See *Benjamin Distribution Ltd. v. Editions Flammarion Ltee* (1982), 68 C.P.R. (2d) 251 (Que. C.A.).

<sup>188</sup> See *Habitations Signature Inc. v. Habitations Logetrie Inc.*, Que. S.C., Montreal No. 500-05-019021-920, 1993.

<sup>189</sup> See *Underwriters Survey Bureau Ltd. v. American Home Fire Assurance Co.*, (1939) Ex. C.R. 296.

<sup>190</sup> See *Centre de location Ravary (Laval) Ltee v. Tele-Direct (Publications) Inc.*, (1995) R.J.Q. 1245 at 1254 (S.C.).

damages,<sup>191</sup> and even if the infringer was unaware of the copyright holder's rights.<sup>192</sup> As of 1997, a copyright owner may request delivery of any infringing works as if they were her property, subject to final disposition of the case.<sup>193</sup> The court may also order destruction of offending material.<sup>194</sup>

### Monetary Relief

Monetary awards offered by the Act include (1) compensatory damages and / or an accounting of profits; or (2) alternatively, statutory damages; as well as (3) exemplary damages; (4) reasonable attorneys' fees, interest, and costs. The courts recognize that damages may be difficult to assess and that fact is not ground for not awarding damages.<sup>195</sup> Damages are estimated approximately, using common sense,<sup>196</sup> and may account for injury to the copyright holder's reputation.<sup>197</sup> For greater detail, a principal case dealing with damage assessment is *Chaplin v. Hicks*, (1911) 2 K.B. 786.

Reimbursement for lost profits has taken the form of damages assessed as the cost of a license to use the work,<sup>198</sup> the royalties obtained by the infringer,<sup>199</sup> and the loss of profits in the numerous and varied commercial markets at which the work was aimed.<sup>200</sup> In proving profits a plaintiff is required to prove only receipts or revenues derived from the publication, sale, or other disposition of an infringing work.<sup>201</sup> The

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<sup>191</sup> See *R. v. James Lorimer & Co.*, (1984) 1 F.C. 1065 (C.A.).

<sup>192</sup> See *Garland v. Gemmil* (1887), 14 S.C.R. 321.

<sup>193</sup> See R.S.C. 1985, c. C-42 § 38 as inserted by Copyright Amendment Act S.C., 1997, ch. C-24, § 20(1)

<sup>194</sup> See *id.*

<sup>195</sup> See *Webb & Knapp v. Edmonton (City)* (1970), 44 Fox Pat.C. 141 (S.C.C.).

<sup>196</sup> *Slumber-Magic Adjustable Bed Co. supra.*

<sup>197</sup> See *Groller v. Wolofsky* (1934), 72 Que. S.C. 419.

<sup>198</sup> See *Kaffka v. Mountain Side Developments Ltd.* (1982), 62 C.P.R. (2d) 157 at 162-63 (B.C. S.C.).

<sup>199</sup> See *R. v. James Lorimer & Co.*, (1984) 1 F.C. 1065 at 1073 (C.A.).

<sup>200</sup> See *Ecole de Conduite Tecnic Aube Inc. v. 1509 8858 Quebec Inc.* (1986), 12 C.I.P.R. 284 (Que. S.C.).

<sup>201</sup> See R.S.C. 1985, c. C-42 § 35(2) "Proof of profits"

defendant has the burden of proving any costs that will lessen the amount of profits shown.<sup>202</sup> This part of the Act is similar to U.S. law.

Exemplary damages may be assessed where the court feels that, to protect rights, it must levy damages of a size that will compel an infringer's future compliance with the law.<sup>203</sup> Bad faith is a possible element, and some courts recognize that infringing another's copyright is the equivalent to theft and stronger punishment is called for.<sup>204</sup>

The recent inclusion of statutory damages in the Act will offset the difficulty encountered in assessing actual damages or accounting of profits. In this way, the infringed copyright holder who would not litigate because of the level of actual loss will still find motivation to pursue a remedy designed to deter potential infringers. Modeled on U.S. law, the infringed owners may elect, at any time prior to final judgment, to recover statutory damages in lieu of actual damages and profits. The court, as it believes just, may then award a sum of between \$500 and \$20,000 (Canadian).<sup>205</sup> The infringer's good or bad faith, the conduct of the parties, and the need to deter future infringements are questions that the court may consider in determining damages.<sup>206</sup> The court may reduce the damages award floor to no lower than \$200 (Canadian) in two situations: where the defendant was unaware and had no reason to know his acts were infringing;<sup>207</sup> and where multiple copyright-protected items are part of a single medium,<sup>208</sup> and the total damages award would become "grossly" incommensurate to the infringement. Statutory awards are generally awarded only in special circumstances against educational institutions, libraries, archives, or museums.<sup>209</sup>

If an infringer can prove that he was not aware of the existence of copyright in a work and had no reasonable ground for believing otherwise, the plaintiff is entitled to

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<sup>202</sup> See *id.*

<sup>203</sup> See *James Lorimer & Co., supra*

<sup>204</sup> See *Osmont v. Petit Journal Inc.* (1934), 73 Que. S.C. 465 at 473.

<sup>205</sup> See R.S.C. 1985, c. C-42 new § 38.1(1)

<sup>206</sup> See R.S.C. 1985, c. C-42 new § 38.1(5)

<sup>207</sup> See R.S.C. 1985, c. C-42 new § 38.1(2)

<sup>208</sup> See R.S.C. 1985, c. C-42 new § 38.1(3)

<sup>209</sup> See R.S.C. 1985, c. C-42 new § 38.1(6)(a) and (b)

only an injunction.<sup>210</sup> But when a work is duly registered under the Act at the time of infringement, the defendant shall be deemed to have had reasonable ground for believing that the work was copyrighted.<sup>211</sup> A presumption exists that the infringer suspected that a work was subject to copyright,<sup>212</sup> and more is needed to overcome the presumption than mere testimony by a defendant pleading ignorance of the copyright in a work.<sup>213</sup> It must be noted that the presumption exists in the fact of copyright by someone and not in the identity of the copyright owner.<sup>214</sup>

Costs of litigation of the parties “shall be in the absolute discretion of the court.”<sup>215</sup> However, an infringer may be required to pay the plaintiff’s costs, including those of expert witnesses, where there is an issue of bad faith on the defendant’s part.<sup>216</sup>

Finally, a three year statute of limitations applies following the act of infringement.<sup>217</sup> This applies to past acts, especially in regards to damages, but does not bind a victim from requesting an injunction to stop persisting acts.<sup>218</sup>

## CRIMINAL REMEDIES

The Canadian Act thoughtfully provides criminal penalties that are separate from the criminal code.<sup>219</sup> These criminal proceedings do not preclude civil litigation by the copyright holder for injunctive or monetary relief.<sup>220</sup>

The Act<sup>221</sup> provides that any person who knowingly makes for sale or hire,<sup>222</sup> sells or lets for hire,<sup>223</sup> distributes,<sup>224</sup> exhibits in public,<sup>225</sup> or imports for sale or hire into

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<sup>210</sup> See R.S.C. 1985, c. C-42 § 39

<sup>211</sup> See *id.*

<sup>212</sup> See *Canadian Performing Right Society v. Ford Hotel* (1935), 73 Que. S.C. 18 at 28; *Morton v. Echo Glass Installations Ltd.* (1991), 36 C.P.R. (3d) 355 at 359 (B.C. S.C.).

<sup>213</sup> See *Dentre de location Ravary (Laval) Ltee v. Tele-Direct (Publications) Inc.*, (1995) R.J.Q. 1245 (S.C.).

<sup>214</sup> See *Dobran v. Bier*, (1959) Que. K.B. 154 at 156 (Montgomery J.A.); *Breen v. Hancock House Publishers Ltd.* (1985), 6 C.I.P.R. 129 at 135 (Fed. T.D.).

<sup>215</sup> See R.S.C. 1985, c. C-42 § 34(2) “Costs”

<sup>216</sup> See *Jacques v. Nouvelle de La Sherbrooke*, J.E. 91-619 (S.C.).

<sup>217</sup> See R.S.C. 1985, c. C-42 § 41 “Limitation period”

<sup>218</sup> See *Warner Brothers-Seven Arts Inc. v. CESM-TV Ltd.* (1971), 65 C.P.R. 215 (Ex. Ct.).

<sup>219</sup> See *R. v. Steward*, (1988) J.S.C.R. 963.

<sup>220</sup> See *Dictionnaires Robert Canada SCC v. Librairie du Nomade Inc.* (1987), 16 C.P.R. (3d) 319 (Fed. T.D.).

<sup>221</sup> See R.S.C. 1985, c. C-42 § 42(1) “Offenses generally”

Canada any infringing copy of any work in which copyright subsists is guilty of an offense.<sup>226</sup> Such an infringer is liable on summary conviction to a fine of up to twenty-five thousand dollars, imprisonment not exceeding six months, or both;<sup>227</sup> or on conviction on indictment, to a fine not exceeding one million dollars, imprisonment not in excess of five years, or both.<sup>228</sup>

In criminal matters, the Crown must establish a chain of title and that the infringer lacked authority to commit the acts he is accused of.<sup>229</sup> The prosecution must also show that the alleged infringing acts did not come under a copyright exemption.<sup>230</sup>

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<sup>222</sup> See R.S.C. 1985, c. C-42 § 42(1)(a)

<sup>223</sup> See R.S.C. 1985, c. C-42 § 42(1)(b)

<sup>224</sup> See R.S.C. 1985, c. C-42 § 42(1)(c)

<sup>225</sup> See R.S.C. 1985, c. C-42 § 42(1)(d)

<sup>226</sup> See R.S.C. 1985, c. C-42 § 42(1)(e)

<sup>227</sup> See R.S.C. 1985, c. C-42 § 42(1)(f) (“summary conviction” is likely the equivalent of “summary judgment” in the U.S.)

<sup>228</sup> See R.S.C. 1985, c. C-42 § 42(1)(g)

<sup>229</sup> See *R. v. Laurier Office Mart Inc.* (1994), 58 C.P.R. (3d) 403, at 404-05 (Ont. Prov. Div.), aff'd (1995), 63 C.P.R. (3d) 229 (Ont. Gen. Div.).

<sup>230</sup> See *id.*

## CONCLUSION

Although a foreign document, the Canadian Copyright Act is not extremely dissimilar to the U.S. Act. The textual language may be different but the end results are largely the same. It appears that the areas posing the greatest potential pitfall to U.S. photographers are limitations upon copyright ownership of photographs. Specifically, when accepting commissioned work from Canadian clients, photographers must carefully ensure that they preserve their rights to copyright as well as the physical entity holding the image by contractually providing for their ownership in the negatives (*i.e.*, film) both at the time of exposure and thereafter and that the photographer is working as an independent contractor and not as an employee or under a contract of service.