

1993

Shifting the Balance of Copyright Control for Photographic Works in Canada

Margaret Ann Wilkinson
Western University, mawilk@uwo.ca

Charles Painter

Follow this and additional works at: <https://ir.lib.uwo.ca/lawpub>

 Part of the [Intellectual Property Law Commons](#)

Citation of this paper:

Wilkinson, Margaret Ann and Painter, Charles, "Shifting the Balance of Copyright Control for Photographic Works in Canada" (1993).
Law Publications. 62.
<https://ir.lib.uwo.ca/lawpub/62>

INTELLECTUAL PROPERTY JOURNAL

Revue de propriété intellectuelle

CARSWELL

Shifting the Balance of Copyright Control for Photographic Works in Canada

Margaret Ann Wilkinson and Charles A. Painter¹

This case comments upon the recent Ontario Divisional Court decision in Allen v. Toronto Star Newspapers Ltd. (1997), 36 O.R. (3d) 201 (Ont. Div. Ct.), focusing upon the issue of ownership of copyright in photographic works in Canada, and the negative effects that this decision will have, if followed in other cases and jurisdictions, upon creators' ability to control their works and to derive full economic benefit therefrom as envisioned under Canada's Copyright Act, R.S.C. 1985 c. C-42.

Ce commentaire jurisprudentiel portant sur la décision de la Cour Supérieure de l'Ontario dans l'affaire Allen c. Toronto Star Newspapers Ltd. (1997), 36 O.R. (3d) 201 (Ont. Div. Ct.), porte sur la propriété de droits d'auteur sur des ouvrages photographiques au Canada. Plus particulièrement, nous analyserons les effets négatifs que la décision Allen aura sur l'habileté des créateurs de contrôler leurs ouvrages et par le fait même leurs profits comme le prévoit la Loi sur les droits d'auteurs Canadienne, L.R.C. 1985, c. C-42.

¹ M.A. Wilkinson, LL.B., B.A., M.L.S. (Toronto), Ph.D.(U.W.O.), called to the bar of Ontario in 1980, is jointly appointed at the University of Western Ontario to the Faculty of Law where she teaches and researhes in the areas of Intellectual Property Law and Information Law and the Faculty of Information and Media studies, where she teaches Management and Information Policy in the masters and doctoral programs. C. Painter has just completed his LL.B. at The University of Western Ontario. He holds a B.A.A. in Journalism from Ryerson Polytechnical University in Toronto. In the past he has worked as a consultant for the Alberta government on environmental policy, and for the private sector creating electronic legal databases. The authors are grateful for the assistance of Marianne Welch, a law librarian at the University of Western Ontario.

1. INTRODUCTION

In 1985, James Allen, a professional photographer on commission from *Saturday Night* magazine,² took a photograph of Canadian federal politician Sheila Copps. A dozen years later, the Ontario Divisional Court rendered a judgment which determined the consequences of that job for Mr. Allen.³ The decision, if followed, would appear to have restricted the economic rights of photographers. Moreover, as will be further discussed, this restriction in the intellectual property arena of copyright has occurred just as other recent judicial pronouncements have narrowed the ambit of the photographer's activity in other contexts. The *Allen* case also demonstrates the power of our domestic courts in determining economic rights within our jurisdiction despite the growing importance of policy-making through international trade arrangements.

In the *Allen* case, *Saturday Night* duly used the photograph it had commissioned for the cover of one of its issues. In 1990, the *Toronto Star* newspaper reprinted the *Saturday Night* magazine cover, dominated by Allen's photograph of Sheila Copps, as an inset illustrating an article about her. The *Toronto Star* did this without the permission of Allen, the photographer. Allen sued and Lissaman, J., at trial, upheld Allen's claim to compensation from the *Star*.⁴ The Ontario Divisional Court, on the other hand, found that Allen had no claim upon the *Star*.⁵

2. RIGHTS AND PROPERTY

Section 3(1) of the *Copyright Act*⁶ sets out unequivocally that the right of "copyright", in relation to a work, means the sole right to produce or reproduce the work. . . in any material form whatever. . . This right originated in the seventeenth century and was designed to protect the interests of the new printers class which had appeared between the writer and the audience with the advent of the printing

2 The authors have italicized the titles of journals throughout, including standardizing quotations.

3 (1997), 36 O.R. (3d) 201 (Ont. Div. Ct.). Judgment rendered November 3, 1997; [1997] O.J. No. 4363.

4 (1995), 26 O.R. (3d) 308 (Ont. Gen. Div.).

5 *Supra* note 3 (O'Driscoll, Flinn, Sedgwick, JJ.).

6 R.S.C. 1985, c. C-42.

press.⁷ Having been discovered only in the 1830s, photography is a technology which considerably postdates the development of the intellectual property protection of copyright. Whether this "new" technology, which enjoyed widespread and rapid adoption, should enjoy the protection of copyright was still debated at the turn of the 20th century.⁸ For Canada, the question was settled in principle by 1921, when our current *Copyright Act* was created, to come into force on January 1, 1924.⁹ The photograph was included in the definition of "artistic work."¹⁰

Despite this inclusion, photographers have not, in point of fact, always been treated equally with the creators of other copyrighted works, either in Canada or elsewhere.¹¹ For example, the period of copyright protection has been shorter for photographs than other copyrighted artistic works: almost all other works are given copyright protection for the life of the creator and then for 50 years afterward — photographs have enjoyed protection only for the 50 years after creation.¹² Moreover, the Canadian *Copyright Act* provides that the copyright in a commissioned photograph, absent a contract to the contrary, belongs to the commissioning party,¹³ an ownership only bestowed

7 See L.R. Patterson, *Copyright in Historical Perspective* (Nashville: Vanderbilt University Press, 1968), at 3.

8 *Tremblay v. La Cie d'imprimerie de Quebec* (1900), 6 R.J. 312 (Que. S.C.).

9 It had actually been settled by 1911, see Ysolde Gendreau "Copyright Ownership of Photographs in Anglo-American Law," [1993] 6 E.I.P.R. 207.

10 "Artistic work" includes works of painting, drawing, sculpture and artistic craftsmanship, and architectural works of art and engravings and photographs." S.C. 1921, c. 24, s. 2(b). The present section reads as follows: "artistic work" includes paintings, drawings, maps, charts, plans, photographs, engravings, sculptures, works of artistic craftsmanship, architectural works, and compilations of artistic works;" re-en. S.C. 1993, c. 44, s. 53(2).

11 See Ysolde Gendreau, *supra*, note 9 at 207.

12 *Supra* note 6, s. 10. This section was amended by S.C. 1993, c. 44, s. 60(1) so that the period of protection ran 50 years from the end of the year in which the negative (or photograph, where there was no negative) was created. This unequal treatment of the photographic work disappeared for individual creators on January 1, 1999 — but continues for the corporate owners of photographic works — as s. 10 was amended again by the coming into force of S.C. 1997, c. 24, s. 7. This continues the anomalous situation that the statute has created for photographs — the only works in the statute for which corporate authorship is recognized. See Gendreau, *supra* note 9 at 208. See also the discussion of Canada's international obligations in this regard, below.

13 *Supra* note 6, s. 13(2) stated:

Where, in the case of an engraving, photograph or portrait, the plate or

upon the commissioners of photographs, not those who commission other copyrighted works.

What one hand gives. . .

In the *Allen* case, literal application of this statutory provision about ownership would have made *Saturday Night* magazine the owner of the photograph of Sheila Copps, since it commissioned the photograph.¹⁴ However both the trial judge¹⁵ and the appellate court¹⁶ accepted the photographer Allen's submission that it is the custom in the magazine trade that copyright in such photographs be treated as falling within the statutory exception from the presumption of copyright in the commissioning party which exists for contractual arrangements even though no such contract in writing was made between the parties. Therefore the copyright in the original photograph of Sheila Copps was found to have been owned by Allen as creator.

Both levels of court in this case made this finding even though the *Copyright Act* clearly states that transfers are to be in writing.¹⁷ In thus ignoring the statutory requirement for writing, these decisions parallel an earlier Ontario Court (General Division) decision¹⁸ where the "custom of the trade" was also found to be effective in establishing an assignment of copyright ownership, although the statutory requirement of writing was not met.

other original was ordered by some other person and was made for valuable consideration in pursuance of that order, in the absence of any agreement to the contrary, the person by whom the plate or other original was ordered shall be the first owner of the copyright.

This section has now been amended by S.C. 1997, c. 24, s. 10(1) to add the phrase "and the consideration was paid" after "valuable consideration".

14 See this finding of fact at trial at *supra* note 4 at 309 and reiterated by the Divisional Court at *supra* note 3 at 203.

15 "In finding for the plaintiff I am accepting the evidence given by the plaintiff's witnesses and others as to the custom in the trade unless agreement to the contrary which was not made in this case." *supra* note 4 at 316.

16 "We agree that the terms of Allen's engagement by *Saturday Night* constitute an 'agreement to the contrary' within the meaning of s. 13(2) of the *Copyright Act* and that Allen is the owner of copyright in the photograph." *supra* note 3 at 207.

17 *Supra* note 6, s. 13(4).

18 *Cselko Associates Inc. v. Zellers Inc.* (1992), 44 C.P.R. (3d) 56 (Ont. Gen. Div.). The *Cselko* case was mentioned in the *Allen* trial decision as having been cited to the court by Counsel for the *Toronto Star* (see *supra* note 4 at 315), but Lissaman, J., does not further discuss it. The Divisional Court does not refer to it.

The assignability of the rights created under the statute has been, over the centuries, one of the most important features of the scheme of copyright protection. The function of provisions such as the Canadian s. 13(4) is to allow creators of copyrighted works to maximize the economic revenue which their works can generate by sub-dividing their copyright into smaller packages.¹⁹ This is a "pro-creators" section of the Act, then, and represents one side of the balance which the whole scheme of the Act seeks to create between users (or the public) and creators: it tends more to reward creators than to enhance dissemination — or, at least, to reward creators for dissemination. Section 10(2), which *prima facie* switches the initial ownership of copyright from photographer to commissioning party, does not address the balance between creator and user but rather re-allocates the reward for creativity in the case of the commissioned photograph.²⁰

In the earlier *Cselko* decision, the Court's use of the notion of an implied licence derived from the custom of the trade had allowed the Court to limit the control exercised by a creator over an artistic work (other than a photograph) which had been prepared for a client.²¹ That is, the Court's finding limited the creator's copyright. There was no question that Ernie Cselko, as creator, held copyright in the work in

19 Section 13(4), when this case arose, stated that "the owner of the copyright in any work may assign the right, either wholly or partially, and either generally or subject to territorial limitations, and either for the whole term of the copyright or for any other part thereof." The section has subsequently been amended to read as follows: "the owner of copyright in any work may assign the right, either wholly or partially, and either generally or *subject to limitations relating to territory, medium or sector of the market or other limitations relating to the scope of the assignment*, and either for the whole term of the copyright or for any other part thereof. . ." (changes indicated in italics) S.C. 1997, c. 24, s. 10.

20 Gendreau, *supra* note 9, argues that it has in fact been acting as a substitute for privacy legislation. See p. 211 ff. More will be said about this theory below.

21 The plaintiff Cselko had been hired to prepare drawings of the "Zeddy Bear" for Zellers and had been paid for them. Zellers used the drawings for both advertising and packaging. Cselko tried to bring an action against Zellers for using "Zeddy" in packaging, arguing that the licence he had sold extended only to advertising. Based on affidavit evidence filed on a motion brought by the defendant Zellers to dismiss the action, Hawkins, J., dismissed the action. The decision has subsequently been mentioned by Prothonotary Hargrave of the Federal Court Trial Division in *BMG Music Canada Inc. v. Vogiatzakis* (1996), 67 C.P.R. (3d) 27 (Fed. T.D.). It has also been distinguished in the Ontario Court of Justice (General Division) *Toronto Small Claims Court* by Thomson, J., in *Hussey v. Baxter Publications Inc.*, [1995] O.J. No. 1787 (Ont. Small Cl. Ct.).

question initially. The question revolved around the extent of the licence to use the copyrighted work which he had sold to Zellers when it had hired him. The *Allen* decisions, both at trial and on appeal, go beyond the *Cselko* decision by denying *Saturday Night* magazine (the commissioning party vested by the statute with copyright ownership in the absence of a written agreement to the contrary) copyright in the commissioned work altogether and declaring that the custom of the trade constituted "an agreement to the contrary" which caused copyright ownership to vest in the creator, the photographer Allen. In the *Allen* decisions, the notion of custom of the trade was used by the Courts to extend the rights of the creator photographer, giving the photographer rights which creators of other kinds of works would already have under the statute (since there is no statutory provision providing particularly for the case of a commissioned work for any other kind of work.).

The courts should be cautious about altering explicit policy decision enshrined in legislation. Strayer, J., was explicit on this point in his decision in *Bishop v. Stevens*²² when he discussed an earlier case, *Rochat c. Société Radio-Canada*:²³

Archambault J. [in the *Rochat* case] seems to have concluded that the scope of 'performing rights' should be defined, not in terms of the *Copyright Act*, but rather in terms of the agreement by which the owners of the copyright assigned their performing rights to CAPAC. . . . The learned judge then apparently found ambiguity in [the wording of the agreement] and proceeded to apply art. 1006 of the *Civil Code* which states that where there is ambiguity in a contract one can interpret it by reference to usage. He then relied on the evidence that in the television industry most broadcasts are pre-recorded. . . .

I do not think the resort to custom or convenience in the industry is helpful. It certainly cannot be resorted to through the rules for the interpretation of contracts. While it might be appropriate in the field of statutory interpretation, where the statute is ambiguous, to examine the alternative interpretations to see which one would cause less hardship or inconvenience, be more reasonable, or most consistent with the object of the Act, there is not in my view an ambiguity in the Act which would justify such an exercise.

It may be that with modern technology the Act as it now stands leads to results inconvenient to some. But in my view the Act distinguishes between mere performing rights and recording rights and it is not open to the court to say that the former includes the latter but only in certain cases. . . . It seems to me that this is a qualification or distinction which, if it is to be drawn at all, should be made by Parliament and not by the courts. . . . These are arbitrary limitations

22 [1985] 1 F.C. 755, 4 C.P.R. (3d) 349 (Fed. T.D.), reversed (1987), 16 C.I.P.R. 243 (Fed. C.A.), affirmed [1990] 2 S.C.R. 467 (S.C.C.).

23 C.S. [1974] 638 (C.S. Qué.).

which however sound they may be in terms of public policy, are not susceptible to judicial definition. Failing legislative intervention in Canada, the owners and users of mechanical rights can govern such arrangements by contract in a manner which adequately recognizes their respective interests.²⁴

Counsel for Zellers in the *Cselko* case was quoted in the press as saying:

Section [13(4)] is troublesome because it flies in the face of the custom of the marketplace. The section suggests that even where you have two parties that agree orally to an assignment and the artist is paid on that basis, it is still not an assignment that the law recognizes. On its face, that is wrong. It almost amounts to a drafting error.²⁵

The trial and appellate courts in *Allen* were prepared to remedy that "drafting error" judicially and accepted that Mr. Allen owned copyright in the photograph of Copps. At trial, Lissaman, J., stated:

I conclude that by reproducing the *Saturday Night* magazine cover of November 1985 the defendant infringed the copyright in the photograph owned by Allen. . . . In finding for the plaintiff I am accepting the evidence given by the plaintiff's witnesses and others as to the custom in the trade unless agreement to the contrary which was not made in this case.²⁶

It is no doubt significant that the commissioning party, *Saturday Night* magazine, was not a party to the action. In beginning the discussion of copyright ownership, Mr. Justice Sedgwick states "The *Toronto Star* acknowledges that Allen owns the copyright in the 1985 photograph of Ms. Copps."²⁷ Later in the judgment, the Court acknowledges "In the case before us, the terms were oral of Allen's engagement by *Saturday Night* to shoot the cover photo of Ms. Copps."²⁸ The Court does not explicitly discuss the requirements of s. 13(4) but nevertheless concludes "We agree that the terms of Allen's engagement by *Saturday Night* constitute an 'agreement to the contrary' within the meaning of s. 13(2) of the *Copyright Act* and that Allen is the owner of copyright in the photograph."²⁹

24 [1985] 1 F.C. 755, 4 C.P.R. (3d) 349 (Fed. T.D.) at 363-365 [C.P.R.].

25 Ed Hore quoted by Uda Hodder, "Copyright assignment need not be in writing, judge says," *Lawyers Weekly*, September 11, 1992 at 24.

26 *Supra* note 4 at 315.

27 *Supra* note 3 at 204.

28 *Ibid* at 206.

29 *Ibid* at 207.

James Allen was probably fortunate to appear before an appellate bench whose backgrounds might be expected to render them sympathetic to this "business approach." Mr. Justice Sedgwick has had a very distinguished career practising and teaching business law before coming to the bench in 1993 although he had previously rendered only one judgment in the intellectual property law area, on a patent injunction motion just a few months earlier in 1997, the same year he wrote the judgment of the Court in *Allen*.³⁰ Mr. Justice Flynn had also decided only one previous motion in the intellectual property arena, a confidential information case, in 1996.³¹ Mr. Justice O'Driscoll had previously been involved in about a half a dozen intellectual property decisions, ranging from confidential information to industrial design. In *Three Hats Productions Inc. v. RCA Inc.*,³² in 1998, he was asked to decide on questions of contracts involving copyrighted music. In the same year, he decided a procedural motion involving the recovery of property which *inter alia* included copyrights in computer programs.³³

The Court's approach to the question of the ownership of copyright in the photograph may also have been influenced by the fact that counsel for the *Toronto Star*, Paul Schabas, had previously appeared in numerous civil cases involving information rights³⁴ and may not have been unsympathetic to the rights of the photographer.³⁵

30 *Allen & Hanburys Ltd. v. Torpharm Inc.* (1997), 75 C.P.R. (3d) 417 (Ont. Gen. Div.).

31 *SLM Software Inc. v. Dimitri* (1996), 65 C.P.R. (3d) 330 (Ont. Gen. Div.).

32 *Three Hats Productions Inc. v. RCA Inc.*, [1988] O.J. No. 68 (Ont. H.C.).

33 *AbellNoser Corp. v. C.P.M.S. Computerized Portfolio Management Services Inc.*, [1987] O.J. No. 701 (Ont. Assess. O.).

34 The previous civil cases in which he has been involved have included *Nash v. CIBC Trust Corp.*, (1996), 7 C.P.C. (4th) 260, 18 O.T.C. 161 (Ont. Gen. Div.), affirmed [1997] O.J. No. 1001 (Ont. C.A.), leave to appeal refused (1997), 109 O.A.C. 200 (note) (S.C.C.) (1996), 6 O.T.C. 368 (Ont. Gen. Div.) and (both with Bonnie Tough), *Slaby v. Godzisz*, [1996] O.J. No. 3174 (Ont. C.A.) (a procedural matter involving information dissemination), *Gallagher v. Southam Inc.* [1994] O.J. No. 537 (Ont. C.A.) (procedural appeal) *Ontario (Solicitor General) v. Ontario (Assistant Information & Privacy Commissioner)* (1993), 107 D.L.R. (4th) 454, (sub nom. *Ontario (Solicitor General) v. Mitchinson*) 68 O.A.C. 317 (Ont. C.A.) (involving issues of access to government held information and the right to a fair trial, assisted by Andrew Diamond, acting for a newspaper reporter), *Latif v. Ontario (Human Rights Commission)* 4 Admin. L.R. (2d) 227 (Ont. Div. Ct.) (with Russell G. Juriansz). Criminal cases have included *R. v. M. Ed.* [1992] O.J. No. 3662 (Ont. C.A.), *R. v. Duncan*, [1995] O.J. No. 389 (Ont. C.A.), *Canada v. Aquarius Computer & Peripherals Ltd.* (1992), (sub nom. *Aquarius Computer & Peripherals Ltd. v. Canada*) 8 T.T.R. 346, (sub nom. *R. v. Aquarius Computer &*

In any event, both the trial and appellate courts held that Allen had properly assigned an interest in the photograph to *Saturday Night* in 1985 and subsequently had properly also assigned rights to others to publish the same photograph in other venues.³⁶ If the Courts in *Allen* had not found that he held copyright in the photograph despite its having been commissioned, the plaintiff Allen would have found his action dismissed.

... the other hand takes away!

While both levels of Court agreed that the photograph of Sheila Copps was a work protected under copyright, held by the photographer Allen, and that Allen consequently controlled the assignment of the right to publish the photograph, the Trial Court and Appeal Court

Peripherals Ltd.) 5 T.C.T. 4150 (Ont. H.C.) (involving remedies for a quashed search warrant), *R. v. Seran*, [1987] O.J. No. 1155 (Ont. C.A.), *R. v. Whitmore* (1987), 41 C.C.C. (3d) 555 (Ont. H.C.), affirmed (1989), 51 C.C.C. (3d) 294, 35 O.A.C. 373 (Ont. C.A.) (latter two with Morris Manning, Q.C.) and *R. v. Trimarchi* (1987), 63 O.R. (2d) 515 (Ont. C.A.), leave to appeal refused (1988), 63 O.R. (2d) x (S.C.C.).

35 *Ontario (Solicitor General) v. Ontario (Assistant Information & Privacy Commissioner)*, supra, where he acted for a reporter, Peter Edwards, who was trying to get information from the Ministry of Correctional Services, *Gallagher v. Southam Inc.*, supra, where he acted for the plaintiff respondent against the *Hamilton Spectator*, and *Slaby v. Godzisz*, supra, where he acted for the Polish Alliance of Canada, represented by John Kaminski, Danuta Warszawski and Zenon Lew Aniak, respondent third parties on the appeal, in a question involving confidentiality.

Jerry Levitan, who together with Aleem Bharmal, appeared on appeal for the respondent Allen had been involved in the past with at least one information industry client but the case did not turn on intellectual property law issues. *C To C Publishing Inc. v. LFZ Ltd.*, [1996] O.J. No. 4267 (Ont. Gen. Div.), in which Jerry Levitan acted for Larry Flynn, publisher of *Hustler* magazine, in a contract dispute.

36 At trial, Allen's evidence, as recounted by Lissaman, J., was that Allen "sold the use of "the photograph" to the *Montreal Gazette* (one occasion) and to Macleans (two occasions). . . "supra note 4 at 311. In his decision, Lissaman, J., writes "The defendant [Toronto Star] by publishing the photograph prevented Allen from being able to negotiate a fee for the use of . . . [the] photograph." supra note 4 at 316. The Divisional Court held "As to the owner of copyright in the photograph, Allen retained the right to use or permit others to use the photo after its first use by *Saturday Night*. His consent would be required to any subsequent use of the photo. In fact, he received payments from several newspapers and periodicals for subsequent uses of the photo." supra note 3 at 207.

differed over the characterization of the *Saturday Night* cover — and this determined the Divisional Court's reversal of the trial decision.

At trial, when the *Toronto Star* defended itself against the claims of the photographer Allen, Lissaman, J., dismissed the defence commenting: "The defendant submits that Allen's copyright. . . is not infringed when the *Toronto Star* reproduced not "the photograph" as such but merely the cover of the *Saturday Night* magazine of November 1985 which happened to feature "the photograph." For me to accept this submission I would be indulging in hair splitting of a somewhat advanced nature. . ."³⁷ In rejecting the submission, he found for the plaintiff photographer, against the *Toronto Star*. The Divisional Court, on the other hand, was prepared to engage in just such a "hair-splitting" exercise.

The reasoning of Mr. Justice Sedgwick, speaking for the Court, centered on the interpretation of the protection given in the *Copyright Act* to a "compilation."

This was a particularly problematic area of the legislation at the time the *Saturday Night* cover was created and later reproduced by the *Toronto Star*: the subject of "compilations" was only mentioned once in the statute, as part of the definition of "literary work."³⁸

At trial in *Allen*, Michael Smith, counsel for the defendant *Toronto Star*, argued that the *Saturday Night* cover was an artistic work³⁹; apparently there was no argument that the cover constituted a compilation protected by copyright. In any event, as discussed above, the trial

37 *Supra* note 4 at 316.

38 *Supra* note 6, s. 2. The protection of compilations in the *Act* has been clarified since the facts in *Allen* arose. The 1993 amendments to the *Copyright Act* implemented our NAFTA obligations (*North American Free Trade Agreement*, (October 7, 1992), 32 I.L.M. 298, by specifically broadening the categories of works which could comprise compilations beyond the literary works category mentioned in the *Act*, as it appeared when the *Saturday Night* cover was created and later reproduced by the *Toronto Star*. Thus, since 1993, an "artistic work" has included "compilations of artistic works" and the definition of "every original literary, dramatic, musical and artistic work" has included the phrase "such as compilations" *supra* note 6, s. 2 as amended by S.C. 1993, c. 44, s. 53(2)). These amendments also articulated a two part definition of a compilation: "(a) a work resulting from the selection or arrangement of literary, dramatic, musical or artistic works or of parts thereof, or (b) a work resulting from the selection or arrangement of data." These provisions were not before the Divisional Court in this case.

39 *Supra* note 4 at 315.

judge held that the reproduction of the cover "infringed the copyright in the photograph owned by Allen."⁴⁰

Mr. Justice Sedgwick, writing for the Divisional Court, introduces the subject of copyright in a compilation in the appeal judgment in the section on "Copyright Ownership" where he says:

Copyright may subsist in original literary, dramatic, musical or artistic works and may subsist in collective works, in which works or parts of works of different authors or contributors are incorporated.

Copyright may subsist separately in a compilation of elements which may themselves individually be the subject of copyright. [italics added]⁴¹

Mr. Justice Sedgwick thus elided the concept of the collective work, which was then defined in the Act, with that of a compilation, which was not.⁴² Indeed, Mr. Justice Sedgwick has included part of the definition of a collective work verbatim in the portion of the judgment just quoted (see the italicized passage). The definition of a "collective work" is:

"collective work" means

- (a) an encyclopedia, dictionary, yearbook or similar work,
- (b) a newspaper, review, magazine or similar periodical, and
- (c) any work written in distinct parts by different authors, or in which works or parts of works of different authors are incorporated;⁴³

The term "collective work" appears only once in the Act, other than in the definitions, in a subsection which restricts the application of a section causing a reversion of copyright under certain conditions.⁴⁴

Although not defined in the statute prior to 1993, compilations were mentioned in the statute, but in the statutory definition of a "literary work."⁴⁵

40 *Supra* note 4 at 316.

41 *supra* note 3 at 204-205.

42 The definition of compilation was added in 1993, as set out above.

43 *Supra* note 6, s. 2. This definition remains unchanged by subsequent amendments to the Act.

44 *Ibid.*, s. 2 and s. 14(2). This is the case both pre- and post- the facts of the *Allen* case.

45 "Literary work" includes maps, charts, plans, tables and compilations. *Ibid.*, s. 2. This definition has now been amended to read "Literary work" includes tables, computer programs, and compilations of literary works" S.C. 1993, c. 44, s. 53(2). The definitions of dramatic, musical and artistic works were amended at the same time to include compilations: "dramatic work" includes. . . (c) any compilation of dramatic works"; "musical work" . . . includes any compilation thereof"; "artistic work" includes. . . compilations of artistic works." S.C. 1993, c. 44, s. 53(2).

In his reasons, Mr. Justice Sedgwick went on to identify the *Saturday Night* cover as "a separate and distinct artistic work from the photograph in this case."⁴⁶ In holding that the cover was "entitled to be recognized as an original artistic work [emphasis ours] created and produced by the work, skill and judgment of Saturday Night",⁴⁷ the Divisional Court was extending the notion of compilation beyond the Canadian statute with which it was dealing. The American legislation at this time, however, contained a precise definition of compilation:

A "compilation" is a work formed by the collection and assembling of pre-existing materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term compilation includes collective works.⁴⁸

It makes perfect sense then, that the magazine cover cases that Mr. Justice Sedgwick cites in the judgment in *Allen* are American, not Canadian.⁴⁹

The Canadian case which is cited by Mr. Justice Sedgwick in support of the notion of a separate copyright for a compilation is *Slumber Magic*.⁵⁰ The case involved a brochure, which may be argued to be more clearly related to the category of "literary works" where compilations were part of the statutory definition, whereas *Allen* was,

46 *Supra* note 3 at 208.

47 *Ibid.*

48 17 U.S.C. 101. The American definition of a collective work "is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole." 17 U.S.C. 101. The American statute also defines the concept of a "derivative work":

a work based upon one or more pre-existing works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship, is a "derivative" work. 17 U.S.C. 101

There is no such concept in the Canadian statute.

49 *Supra* note 3 at 206, citing *Conde Nast Publications Inc. v. Vogue School of Fashion Modelling*, 94 U.S.P.Q. 101 (U.S. Fed. Dist. Ct., 1952) at pp. 106-107; *Readers Digest Association Inc. v. Conservative Digest Inc.*, 3 U.S.P.Q. 1276 at p. 1280 (U.S.C.A., D.C. Cir., 1987).

50 *Slumber-Magic Adjustable Bed Co. v. Sleep-King Adjustable Bed Co.* (1984), 3 C.P.R. (3d) 81, [1985] 1 W.W.R. 112 (B.C. S.C.). The case was not cited in the trial judgment in *Allen*.

by Divisional Court's own characterization, a case involving an artistic compilation.

Indeed, the Canadian Federal Court of Appeal in 1991, in a case not referred to in the *Allen* decisions, had appeared restrictive in its interpretation of the concept of compilation under the pre-1993 version of the Act. In *Canadian Cable Television Association - Assoc. canadienne de télévision par câble v. American College Sports Collective of Canada Inc.*,⁵¹ the Federal Court upheld a decision of the Copyright Board that a schedule of broadcasts fell outside the ambit of a compilation.⁵² The Federal Court of Appeal would later hold that prior to the 1993 amendments, compilations were only protected in so far as they could be characterized as "literary works."⁵³

Despite the limitations of the legislation on compilation which applied, the Ontario Divisional Court in *Allen* concluded that the cover itself possessed the originality necessary to be a copyrighted work, as an artistic compilation, based upon skill and judgment factors more

51 *Canadian Cable Television Assn. - Assoc. canadienne de télévision par câble v. American College Sports Collective of Canada Inc.* (sub nom. Canadian Cable Television Assn. v. American College Sports Collective of Canada Inc.) [1991] 3 F.C. 626, 36 C.P.R. (3d) 455, 81 D.L.R. (4th) 376 (Fed. C.A.).

52 [1991] 81 D.L.R. (4th) 376 (Fed. C.A.). See quotation from "Dissent of member Latraverse" at 389. The Federal Court of Appeal declined to set aside the Board's decision on procedural grounds, holding that the applicant to them had "failed to establish that the Board committed an error of law or jurisdiction." (at 404). The reasons do not specifically discuss the question of the definition of compilation.

53 The *Tele-Direct (Publications) Inc. v. American Business Information Inc.* case was wending its way through the courts as the appeal in the *Allen* case was being heard. The trial decision, reported at (1996), 113 F.T.R. 123, 27 B.L.R. (2d) 1 (Fed. T.D.), affirmed (1997), [1998] 2 F.C. 22, 37 B.L.R. (2d) 101 (Fed. C.A.), leave to appeal refused (1998), 228 N.R. 200 (note) (S.C.C.), was not referred to by the Divisional Court in the *Allen* decision. As the annotation by Richard Potter in the *Business Law Reports* mentions, however, "It is puzzling that in its reasons the Court [in *Tele-Direct*] frequently alluded to the term 'compilation' without noting that this definition was inserted into the Copyright Act in 1993 [footnote omitted]. . . It would have been useful [] for the Court to have considered what impact this legislative change should have on the concept of originality and the subsistence of copyright in compilations, especially in terms of the weight to be given to older case law." (at 5). The subsequent Federal Court of Appeal decision in the *Tele-Direct* case was released virtually simultaneously with the decision of the Ontario Divisional Court in *Allen*. *Tele-Direct* was rendered October 27, 1997 and *Allen* on November 3, 1997. See paragraph 10 [1997] F.C.J. No. 1430, subsequently reported at (1997), [1998] 2 F.C. 22, 37 B.L.R. (2d) 101, 76 C.P.R. (3d) 296, 154 D.L.R. (4th) 328, 221 N.R. 113.

than labour: the photo "was selected by the art director of *Saturday Night*. . . in consultation with the editor of *Saturday Night*. The cover, including its layout and type sizes, styles and positioning, as well as the cover text, was the work of the art director in consultation with the editor."⁵⁴

Whether or not the Divisional Court was correct in holding that the cover was a compilation under the applicable legislation, that is, pre-1993, it seems clear that the cover would be considered a compilation if the facts of the *Allen* case arose today. The Court made the finding of fact that the photograph, an artistic work, dominated the cover, and therefore, since 1993, such a work would be considered an artistic compilation if found to be a compilation.⁵⁵ It is important to note also that the Act now further states explicitly that:

The mere fact that a work is included in a compilation does not increase, decrease or otherwise affect the protection conferred by this Act in respect of the copyright in the work or the moral rights in respect of the work. (s. 2.1(2))⁵⁶

However, this latter section does not seem to represent a change in the law. Cases had already accepted that there could be copyright in a compilation even as separate copyrights continued to exist in various parts of the compilation.⁵⁷ Similarly, the American statute specifically provides:

The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.⁵⁸

54 *Supra* note 3 at 206. The Court's reasoning in this respect is in line with the reasoning of the eventual outcome of Court in the *Tele-Direct* decision of the Federal Court of Appeal, see (1997), [1998] 2 F.C. 22, 37 B.L.R. (2d) 101, 76 C.P.R. (3d) 296, 154 D.L.R. (4th) 328, 221 N.R. 113 (Fed. C.A.).

55 See s. 2.1(1): "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." S.C. 1993, c. 44, s. 54.

56 *Ibid.*

57 *FWS Joint Sport Claimants v. Canada (Copyright Board)* (1991), 36 C.P.R. (3d) 483, [1992] 1 F.C. 487 (Fed. C.A.), leave to appeal refused (1992), 88 D.L.R. (4th) vi (S.C.C.).

58 17 U.S.C. 103 (b).

The Divisional Court in *Allen*, however, failed to recognize the implications of the fact that copyrights subsisted in the underlying works (the photograph — and the text and layout) of which the compilation (the cover) was composed. This "layering" of copyrights in one work is conceptually natural for those who work regularly with the complete assignability of copyrights and parts of copyrights (as discussed above) and the co-existence of separated moral and economic rights in virtually all published works. However, the Divisional Court said:

The photo tells part of the story, but by itself is not meaningful without the linkage of words and imagery associating Ms. Copps with her role in Parliament. . . . *Saturday Night* bargained with Allen for the taking of the photo it ultimately chose for the cover of its November 1985 issue and used the photo in the way it was authorized to do by Allen, according to his own evidence. Allen's copyright in the photograph is not infringed by the reproduction of the entire cover. . . and, in our view, Allen does not own or have a legal interest in the copyright in the magazine cover.⁵⁹

In his fairly brief trial judgment, Lissaman, J., had referred to the "custom of the trade," using that concept to justify accepting the evidence of an agreement contrary to the statutory presumption of copyright in commissioned photographs arising in the commissioning party (as discussed above). The Divisional Court, however, as introduced in the discussion above, enlarged upon this notion of "custom of the trade", extending it to "custom of the industry," and giving it far wider consideration.⁶⁰ The Divisional Court discussed the opinions of the witnesses at trial in the context of the very question which was before the court — what copyright lies in magazine covers?:

Witnesses who testified at trial were divided in their views as to the custom of the industry in matters of copyright in magazine covers.

59 *Supra* note 3 at 208.

60 The Court does agree, (1997), 36 O.R. (3d) 201 (Ont. Div. Ct.) at 207, "that the terms of Allen's engagement by *Saturday Night* constitute an 'agreement to the contrary' within the meaning of s. 13(2) of the *Copyright Act* and that Allen is the owner of the copyright in the photograph." Indeed, it would appear from the judgment that the *Toronto Star* did not put the question of Allen's ownership of the copyright in the original photograph in contention on the appeal ((1997), 36 O.R. (3d) 201 (Ont. Div. Ct.) at 204). On this point, the appeal court does not mention the "custom of the trade". However, the Court actually deals with "the custom of the industry" beginning at 207, in relation to a separate issue before the court, as discussed herein.

Some stated that the cover belongs to the publisher. . . . Once a magazine cover is published, some witnesses considered it to be in the public domain as part of an historical record, so that no one's consent is sought or required to reproduce the cover for any purpose. . . .

In evidence, Allen stated . . . that the consent of the cover photographer is required. . . . Another photographer . . . agreed, a third . . . said no one owned the cover, although another . . . acknowledged that the magazine owns the cover, and . . . a publisher and art director, agreed that if he wanted to use a magazine cover, he would contact only the magazine, letting them get necessary clearances for the cover.⁶¹

This review of the evidence with respect to "custom" seems to be used to reinforce the Court's treatment of the compilation (cover) as a distinct, discrete, singular work which supersedes and replaces the interest of the owners of copyright in the component works. Certainly the Court cites no legal authority for the proposition implicit in its subsequent reasoning: that the creation of the compilation copyright had the effect of extinguishing the copyright interests of the creators of the elements in that compiled work except where they continued outside that compiled work. It is this implicit proposition which allows the Divisional Court both to declare that Allen's "consent would be required to any subsequent use of the photo"⁶² and at the same time that "Allen's copyright in the photograph is not infringed by the reproduction of the entire magazine cover in the March 11, 1990 edition of the *Toronto Star* and, in our view, Allen does not own or have a legal interest in the copyright in the magazine cover."⁶³

The result of the Divisional Court's decision is that two parallel avenues of permission to use the same image of Sheila Copps are created once that image is included (with permission of the original copyright owner for the original inclusion) in a compilation. Following through on the reasoning of the Divisional Court, if a subsequent user takes that image from the original photograph, permission must presumably be sought of the original owner or his assignees; but if the image is taken from the compilation cover, permission must be obtained only from the compilation owner. What would the position be if the image is taken from the cover, as a substantial taking, and permission is duly sought and received from the cover owner, and then the cover

is cropped to reduce it to just the image of Sheila Copps? How would subsequent users ever discover which chain of title they should be following in order to secure permission for further uses? Since *Saturday Night* was not before the Court, the Divisional Court may not have directed its mind to the difficulties of the competing claims of the "cover" holder and the "photograph" holder.

Administratively, the Court may have seen the "dual" lines of title as simplifying the ownership, and therefore permissions, situation in a "combined" product, while preserving the "right" of the artist to be compensated for his creativity by allowing him to continue to exploit the original work in other contexts. However, "simplification" is properly done in copyright transactions by contract and attempting it by limiting the rights of the copyright holder as this court has done is to upset the historic balance between creators and users — and introduce uncertainty into the bargain.

While it could be argued that this decision on the effect of compilations on the underlying works should be limited to the pre-1993 context because the new s. 2.1(2) quoted above is not consistent with it, Mr. Justice Sedgwick is clear in the judgment that the protection conferred by the Act on Allen's original photograph is not diminished — the photographer just has no further claims on the compilation — and this might be argued to be consistent with the new s. 2.1(2).

3. AN ANACHRONISM?

The policy process

Is it the fact that this case involved a photograph, the technological "younger child" in the copyright context, which helped this Court come to this treatment of the underlying work. Would the Court also have found that a poet loses all control over a poem quoted within a novel, where the subsequent uses derive from the novel rather than the original poem?

If the decision is limited to the photographic compilation only, it would seem to set the treatment of photographs apart in a way which runs counter to recent international trends — but not Canada's own continuing domestic treatment of the photograph.

When the Divisional Court was considering *Allen*, Canada had signed only the 1928 version of the *Berne Convention on Copyright* and the lesser period of copyright for accorded photographs by the Canadian statute was in full compliance with our then international

61 *Supra* note 3 at 207.

62 *Ibid.*

63 *Ibid.* at 208.

obligations.⁶⁴ On June 26, 1998, Canada signed the *1971 Paris Convention* on copyright.⁶⁵ That article of the *Berne Convention* (Paris Text 1971) states: "It shall be a matter for legislation in the countries of the Union to determine the term of protection of photographic works and that of works of applied art in so far as they are protected as artistic works; however this term shall last at least until the end of a period of 25 years from the making of such a work." This subsection gives Berne states the option of protecting photographs otherwise than for the period specified in Article 7(1) — life of the author and 50 years after his death. Our legislation does give a period other than life plus 50 years, but meets the minimum requirement of 25 years protection and thus, Canada is in compliance with the provisions of the *Paris Treaty*. In 1996, Canada became signatory to the *World Intellectual Property Organization Copyright Treaty* which provides in Article 9 that "In respect of photographic works, the Contracting Parties shall not apply Article 7(4) of Berne." If Article 7 (4) is not applied, then it leaves article 7(1) as the operative article governing photographs: "The term of protection granted by this Convention shall be the life of the author and fifty years after his death." The effect of the *WIPO* clause, therefore, is to require members to give photographs a term of protection consistent with other works. There is a real question whether Canada's recent amendment to the period of protection for photographs, which came into effect in January of 1999, has made Canada fully compliant with the *WIPO Copyright Treaty*. It would appear that the provisions for a separate, shorter period of copyright for photographs in corporate ownership may be problematic.⁶⁶ Canada will not be in breach of its international obligations in this regard immediately because although, as mentioned, Canada is signatory to the *WIPO Copyright Treaty*, it has not yet ratified or acceded to it, and the Treaty itself remains not yet in force.

64 *Berne Convention for the Protection of Literary and Artistic Works*, 9 September 1886; revised at Paris 1896, at Berlin in 1908, completed at Berne in 1914 and revised at Rome in 1928, Article 7(3).

65 *Berne Convention for the Protection of Literary and Artistic Works*, 9 September 1886; revised at Paris 1896, at Berlin in 1908, completed at Berne in 1914, revised at Rome in 1928, at Brussels in 1948, at Stockholm in 1967 and at Paris in 1971 and 1979. See "Contracting Parties of Treaties Administered by WIPO" at <http://www.wipo.org/eng/tratific/berne.htm>.

66 See the discussion above about s. 10.

In any event, Canada is now distinguished as one of the few countries maintaining a term of copyright for photographs which is different from that provided for other artistic works.⁶⁷

Whether or not the decision is limited to compilations involving photographic works, the reduced control of the copyright holder of the original work after the compilation copyright owner takes control of the work in the compiled context which this decision creates may hamper Canada's efforts in the future to conform to international commitments with respect to the protection of compilations. Article 5 of the 1996 *WIPO Copyright Treaty* says:

Compilations of data, or other material, in any form, which by reason of the selection or arrangement of their contents constitute intellectual creations, are protected as such. This protection does not extend to the data or the material itself and is without prejudice to any copyright subsisting in the data or material contained in the compilation.

Judicial Trends

Canadian legislators continue to view the medium of the photograph as requiring a different balance between the rights of subjects and the creators of works involving those subjects than is required for works in other media. This view seems to have been mirrored by the Supreme Court of Canada in the recent *Aubry*⁶⁸ decision which has created a prior restraint (at least in Quebec⁶⁹) upon the freedom of the

67 Gendreau, *supra*, at 209.

68 *Aubry c. Éditions Vice Versa Inc.*, (sub nom. *Aubry v. Éditions Vice-Versa inc.*) [1998] 1 S.C.R. 591, 157 D.L.R. (4th) 577, 224 N.R. 321, 78 C.P.R. (3d) 289 (C.S.C.). In a 5/4 split, the majority upheld the original trial decision, [1991] R.R.A. 421, (Court of Quebec) *aff'd* [1996] R.J.Q., 2137, 141 D.L.R. (4th) 683, 71 C.P.R. (3d) 59 (C.A. Qué.) which had ruled that the non-consensual publication of a photograph of a 17 year old girl sitting on the steps of a public building was a violation of her right to privacy, under s. 5 of the Quebec *Charter of Human Rights and Freedoms*, R.S.Q., c. C-12. The trial court then awarded the young woman \$2,000.00 in damages, for injury suffered from teasing by friends that her picture had appeared in a "prestigious, large circulation magazine". In their joint reasons, L'Hereux-Dubé and Bastarache, J.J., for the majority, held that the right to one's image is included in the right to respect for one's private life and that under s. 49, para. 1 of the Quebec *Charter*, the infringement of such a right gives rise to an action for moral and material prejudice, and that as a result, the traditional elements of civil liability must be, and were, established.

69 The case does not appear to have been discussed in judgments outside Quebec to date, nor has there been any discussion of its impact beyond Quebec in the legal literature to date.

photographer to create certain copyrightable works.⁷⁰ This limit does not seem to apply to creators in any other medium. Although the case revolves around the photographer's right to publish a photograph in a magazine, copyright is not mentioned at all in the decision.⁷¹

The majority of the Court felt that the case called upon the Court to balance the right to freedom of expression, as protected under the *Quebec Charter*,⁷² with the right to respect for one's private life,⁷³ also respected under the *Quebec Charter*.⁷⁴ The Court held that the right to artistic expression is included in the right of expression.⁷⁵ The Court then discussed the "public's right to information, supported by freedom of expression."⁷⁶ In turn, the concept becomes "public interest" and the judgment discusses "cases where a previously unknown individual is called on to play a high-profile role in a matter within the public domain. . . ."⁷⁷ This exception of the person whose right to privacy must give way to the "public interest" includes, according to the Court, a person in a crowd at a sporting event.⁷⁸ However, the Court holds that, the public's right to information must give way to the individual's right to privacy in other cases and, although it might well be difficult, a photographer must obtain consent of all those he or she photographs in public places before publishing their photographs.⁷⁹ In addition to the person fulfilling a high-profile role (including a person at a sporting

70 The majority stated "our analysis will be limited to the sole issue before this Court, namely publication of a photograph taken without permission." Para. 50, L'Heureux-Dube and Bastarache, writing for themselves and for Gonthier, Cory and Iacobucci., in the majority.

71 As the owner of such a non-commissioned photograph, has the right to publish a photograph as part of the rights conferred by copyright, *supra* note 6, s. 3(1). The trial decision in the *Gould* case is also not mentioned, although it was very much focused on a discussion of the appropriation of the tort of personality (the appellate decision was rendered after the decision). Neither the *Michelin* decision nor the *Allen* decisions were mentioned, which is not surprising since the intellectual property aspects of the case were not canvassed.

72 *Québec Charter of Human Rights and Freedoms*, R.S.Q., c. C-12, s. 3.

73 *Québec Charter of Human Rights and Freedoms*, R.S.Q., c. C-12, s. 3.

74 [1998] S.C.J. No. 30, para. 55 and 56.

75 *Ibid.*, para. 55.

76 *Ibid.*, para. 57.

77 *Ibid.*, para. 58. This term "public domain" in this context must be different from the intellectual property concept of works not in copyright since the implications for copyright do not appear to have been in the minds of the Court.

78 *Ibid.*, para. 58.

79 *Ibid.*, para. 65.

event), the only other exceptions the Court provides for are instances where the person appears in an incidental manner in a photograph of a public place or is photographed in a group in a public place.⁸⁰ The concept of a "public place" is not clearly defined by the Court,⁸¹ although the exception of photographing in a public place will be lost if the people "constitute the true subject of the photograph."⁸² It is clear from the examples that "public place" does not merely include property owned by the various Canadian governments. It must also include private property onto which is occupied by members of the public for whatever reason.⁸³

The majority also held that publishing the photograph in a magazine was commercial, as well as artistic, because it was used to sell the magazine⁸⁴ (although not apparently the cover photo). This finding was made in connection with establishing that the appropriate quantum of damages should have included an amount for the subject of the photograph in exchange for the use of her image.⁸⁵

The Chief Justice, in dissent, agreed with the majority of the Supreme Court that the right to privacy includes a person's right to his or her image, although he did "not rule out the possibility that a person's commercial interest in his or her image does not derive uniquely from his or her right to privacy."⁸⁶ He held that "to appropriate another person's image without his or her consent to include it in a publication constitutes a fault. I am of the view that a reasonable person would have been more diligent and would at least have tried to obtain the respondent's consent to the publication of her photograph."⁸⁷ However, he adds ". . . I do not think it appropriate to specify, in the context of the present case, the circumstances in which the public interest prevails

80 *Ibid.*, para. 59.

81 The parties agreed that the location of the photograph, on the steps in front of a building on Ste.-Catherine Street in Montreal, was a public place (*ibid.*, para. 40).

82 *Ibid.*, para. 59.

83 The Court mentions both sporting events, to which members of the public are invited, and demonstrations, where the individuals involved are generally present without invitation of the property owners (*ibid.*, para. 59).

84 *Ibid.*, para. 74.

85 *Ibid.*

86 *Ibid.*, para. 21. Lamer, C.J., dissenting in the result. Major, J., agreed with the Chief Justice's judgment that there were no damages demonstrated.

87 *Ibid.*, para. 23, Lamer, C.J., dissenting in the result, agreeing on this point with the majority.

over a person's right to his or her image."⁸⁸ Having concluded, however, that he could "not rule out the possibility that the dissemination of a person's image without consent might result in damage for which he or she can be compensated," he and Major, J., nevertheless differ from the majority of the Court because they find "the instant case quite simply does not come within this category of affairs."⁸⁹

Ysolde Gendreau argues in the context of statutory reform that copyright issues with respect to photographs are often confounded with privacy interests.⁹⁰ The *Aubry* decision seems to demonstrate the same tendency amongst the judiciary, despite (and even, because of) the fact that intellectual property is not even discussed in the judgments of the Supreme Court. Courts sitting in the common law context, on the other hand, seem more anxious to separate the property concepts of intellectual property from rights based concepts such as privacy.

In the *Gould* case, arising in the common law context where the right to privacy is not enshrined in a statute such as the *Quebec Charter*, copyright interests in photographs were held to prevail over other claims.⁹¹ Glen Gould, the late celebrated pianist, consented to photographs, along with interviews, by Jock Carroll, also deceased at the time of the action, in 1956 for an article to be submitted to a magazine. Later, Carroll re-used the material and it was published in a book in 1995. The Estate of Glen Gould sued the book publisher, in Ontario, for breach of copyright, breach of contract and misappropriation of personality. The Divisional Court concentrated its decision on the fact that Carroll owned the copyright in the photographs. The Court emphasized that the *Copyright Act* in Canada, itself, gives control over commissioned photographs to the commissioning party. Gould did not commission these photographs and so the Act gives control of the photographs to the photographer. The Court concludes, "Once it is established that Carroll owned the unrestricted copyright in the photographs and the written material in the book, there is nothing else to

decide." And then later, "The subject of the photographs. . . has no proprietary interest whatsoever unless he or she had obtained an interest by express contract or implied agreement with the author. Looked at in this light, the concept of appropriation of personality has no application. . . there is no necessity to explore any balance between privacy rights and the public's interest in a prominent Canadian." Whereas copyright can sometimes be used as an instrument of censorship,⁹² when the copyright owner exercises the right to control dissemination in order to block certain dissemination, in this case it was the Estate of Glen Gould which wanted to block further distribution of the photographs. The Divisional Court in *Gould* concludes, "In protecting Carroll's artistic creation, the law [meaning, in the case, apparently, the *Copyright Act*] permits the public to benefit from an insight into Gould's early years to which it would otherwise be denied."⁹³

In another recent case, Teitelbaum, J., in the Federal Court Trial Division considered the relationship between copyright and trademark and the right to freedom of expression in the context of a labour dispute.⁹⁴ In this case, striking union members used the "Bibendum" character owned by Michelin in protest against the company during a labour action. The union argued that any interpretation of the intellectual property rights of the company which denied the union use of the character in the context of the labour dispute would be unconstitutional as infringing the union's freedom of expression as guaranteed under the *Canadian Charter of Rights and Freedoms*. Teitelbaum, J., held that "The *Charter* does not confer the right to use private property — the Plaintiff's copyright — in the service of freedom of expression."⁹⁵ He cautions that "just because the right is intangible, it should not be any less worthy of protection as a full property right" and further "we should guard against our instincts in this instance since they might lead us to undervalue the nature of the Plaintiff's copyright and overestimate the breadth of the Defendants' freedom of expression."

88 *Ibid.*, para. 27.

89 *Ibid.*, para. 36.

90 Gendreau, *supra*, at 211.

91 *Gould Estate v. Stoddart Publishing Co.* (1998), 39 O.R. (3d) 545, (sub nom. *Succession Gould c. Stoddart Publishing Co.*) 39 O.R. (3d) 555 (Fr.), 161 D.L.R. (4th) 321, 114 O.A.C. 178, 43 C.C.L.T. (2d) 1, 80 C.P.R. (3d) 161 (Ont. C.A.) reversing the judgment of Lederman J. (1996), 30 O.R. (3d) 520, 14 O.T.C. 136, 31 C.C.L.T. (2d) 224, 74 C.P.R. (3d) 206, 15 E.T.R. (2d) 167 (Ont. Gen. Div.), leave to appeal to S.C.C. refused (1999), 236 N.R. 396 (note) (S.C.C.).

92 See in particular David Vaver, "Some agnostic observations on intellectual property," (1991) 6 *Intellectual Property Journal* 125.

93 Finlayson, speaking for himself and Krever and Weiler. (1998), 39 O.R. (31) 545 (Ont. C.A.), para. 27.

94 *Cie Générale des Établissements Michelin-Michelin & Cie v. C.A.W. - Canada* (1996), 71 C.P.R. (3d) 348, [1997] 2 F.C. 306, 124 F.T.R. 192 (Fed. T.D.).

95 *Cie Générale des Établissements Michelin-Michelin & Cie v. C.A.W. - Canada* (1996), 71 C.P.R. (3d) 348 at 388 (Fed. T.D.).

"A person using the *private* property of another like a copyright, must demonstrate that his or her use of the property is compatible with the function of the property before the Court can deem the use a protected form of expression under the *Charter*. In the present case, subjecting the Plaintiff's Bibendum to ridicule as the object of parody is *not* compatible with the function of the copyright. A Bibendum about to stomp hapless workers into submission does not present the original author's intent of a favourable corporate image or provide an incentive for compensating artists for the integrity of their vision." Finally Teitelbaum, J., concluded that the right to freedom of expression did not permit the union to use the company's private property: the right to reproduce the copyrighted artistic works.

Would the Supreme Court of Canada have agreed with this reasoning and allowed the publication of caricatures drawn of Aubry, rather than a photograph? Would the Supreme Court accept the approach to the question used by Teitelbaum, J., and therefore can the Supreme Court in the *Aubry* case be taken to have concluded, paraphrasing from the *Michelin* case, that the value of avoiding embarrassment to a subject is compatible with the function of the photographer's right to control publication of his work in copyright as a means of providing an incentive for compensating him for the integrity of his vision? The Supreme Court of Canada in *Aubry* did not consider the role of copyright in protecting the freedom of expression of the artist or photographer. They considered freedom of expression only from the perspective of the public's right to be informed, not from the individual creator's right to freedom of artistic (and, therefore, photographic) expression. Did the Supreme Court's characterization of the issues before it depend on the unique nature of photographic images of people?

Taken together, the *Allen* and *Aubry* decisions represent judicial curtailments on the reward for creativity allocated to photographers in Canada which have not been imposed to date on the creators of other works. At least in Quebec, photographers must now have consent of identifiable people in their works in order to be permitted to reproduce or publish those works, unless those persons are persons of great public interest.⁹⁶ If the *Allen* decision is accepted in other Canadian provinces, then once a photographic work has been created, if the photographer permits the work to be incorporated into compiled works, she or he will

lose exclusive control of the work, since the compiler will exercise exclusive control over the work in the compilation and the photographer will only control its use where the use is taken from a source other than the compilation. These limitations appear to be inconsistent with the respect accorded the copyright in the *Gould* and *Michelin* cases.

4. THE FAIR DEALING EXCEPTION

The decision about Allen's lack of copyright title in the cover, because it was a compilation, should have entirely disposed of the case. However, the Divisional Court, with no indication that this is to be considered *obiter*, moves on to consider the issue of fair dealing. This issue should have arisen only as a possible defence had it been found that *Saturday Night* infringed Allen's copyright.

Indeed, it was originally necessary for Lissaman, J., to consider the concept of fair dealing at trial because he had found that Allen did have a copyright interest in the cover. His conclusion was "The fair dealing defence raised by the defendant is an interesting issue which in my view has no application to the case at bar as I accept the Plaintiff's submission with respect to it."⁹⁷ That submission, as recounted by the judge, was "Ms. Suter relies on the *ejusdem generis* rule of construction and submits that publishing the whole photograph even in its *Saturday Night* magazine form does not fit within the fair dealing defence."⁹⁸

On the other hand, as mentioned, the Divisional Court's consideration of the concept of fair dealing is surprising because the Court had already decided that Allen had no interest in the cover which had been reproduced. Also surprising is the Divisional Court's focus on the question of the use of the entire cover by the *Toronto Star* and whether that use could be defended as fair dealing. *Saturday Night*, the owner of the compilation copyright in the cover, was not before the Court. Even if this section of the judgment were relevant in deciding the case between the parties before the Court, Allen and the *Toronto Star*, the Court should surely have been focused on whether the use of the whole of the photograph, rather than the cover, could be considered fair dealing. The Appellate Court seems to have misapprehended the trial judge on this point, thinking that the trial judge had considered the use of the cover in connection with the fair dealing issue, rather than just the photograph.

⁹⁶ But if they are such persons, see the discussion of the fair dealing exception as interpreted in the Divisional Court in *Allen*, *infra*!

⁹⁷ *Supra* note 4 at 316.

⁹⁸ *Ibid.* at 314-15.

In considering fair dealing, the Court considered the newspaper summary exception (now news reporting).⁹⁹ The court satisfied itself that in 1990 Sheila Copps was news: "The use by the *Toronto Star*. . . was related to the then current news, the leadership aspirations of Ms. Copps."¹⁰⁰ This, the Court felt, placed the photograph or cover in the realm of the news summary exception.

This approach limits the rights of photographers in cases involving photographs of people, but for reasons exactly opposite to those given by the Supreme Court of Canada as it limited the photographer in the recent decision in *Aubry*. Indeed, following *Aubry*, Sheila Copps is probably such a public figure (as expressly found by the Court in *Allen*) that she would not be able to exercise her right to privacy in Quebec in the face of the public's right to be informed.¹⁰¹ But in the *Allen* appellate decision, it was not Sheila Copps, the subject, whose rights limited those of the photographer Allen. Rather, she, as a newsworthy person, created rights in another party, the *Toronto Star* newspaper — the right to be exempted from the requirement to seek permission of the copyright holder to do something which otherwise only the copyright holder would have the right to do.

The decision of the Divisional Court in *Allen* is also consistent with the Ontario Court of Appeal's decision in *Gould*, discussed above, because Sheila Copps's notoriety in *Allen* allowed the *Toronto Star* to avail itself of the fair dealing exception to the rights of the copyright holder. In *Gould*, the Estate of Glen Gould was not arguing that it was somehow claiming the protection of the fair dealing defence against the book publisher, where the fame of the pianist would have been relevant in the same way as the fame of Sheila Copps was relevant in *Allen*. The Estate was arguing that it had acquired copyright in the

photographs.¹⁰² As discussed above, the Ontario Court of Appeal found that it had not.

As the Divisional Court constructed its analysis in *Allen*, once it had found that the use of Ms. Copps' image was fair-dealing within the exception to the rights of the copyright holder, it was necessary to address the problem that the *Toronto Star* had used the whole work, whether photograph or cover. In finding the whole taking fair in the newspaper context, the court had to explicitly disapprove the older 1942 Exchequer case of *Zamacois v. Douville*.¹⁰³ To bolster this decision, Sedgwick cited the more recent 1972 English Court of Appeal decision in *Hubbard v. Vosper*.¹⁰⁴ While it is true that Megaw, J. in *Hubbard* allowed the possibility of an entire taking being fair in that case, the example given of a tombstone inscription is itself problematic: such a brief piece of text might arguably not constitute a "literary work" enough to attract copyright protection in the first place (slogans are more likely to attract trademark protection, for example). And the judgment of Lord Denning, which Mr. Justice Sedgwick is apparently using to support his decision that the whole taking is fair, is clearly to the opposite effect: "To take long extracts and attach short comments may be unfair. But, short extracts and long comments may be fair."¹⁰⁵

In *Hubbard*, Lord Denning introduced a purpose analysis into his consideration of fairness: "if they [the quotations and extracts] are used as a basis for comment, criticism or review, that may be a fair dealing. If they are used to convey the same information as the author, for a rival purpose, that may be unfair."¹⁰⁶ Even if the notion of a purposive analysis is accepted, despite the reasons for rejecting it just discussed, the use by the *Toronto Star* of the *Saturday Night* cover featuring Allen's Sheila Copps photograph was precisely a rival purpose to that of Allen's continuing desire to reap full economic value from his

99 *Copyright Act*, s. 29.2. Prior cases had generally considered the form of publication in considering this concept. See, *Hubbard v. Vosper*, [1972] 2 Q.B. 84, [1972] 1 All E.R. 1023 (Eng. C.A.) at 1027 [All E.R.]. This court looked at content (perhaps influenced by the information law background of Paul Schabas?).

100 (1997), 36 O.R. (3d) 201 (Ont. Div. Ct.) at 209.

101 See *Aubry* [1998] S.C.J. No. 30 at para. 58, where in the majority decision delivered by L'Heureux-Dubé and Bastarache JJ., state, "The balancing of the rights in question depends both on the nature of the information and on the situation of those concerned. This is a question that depends on the context. Thus, it is generally recognized that certain aspects of the private life of a person who is engaged in a public activity or has acquired a certain notoriety can become matters of public interest. This is true, in particular, of artists and politicians, but also, more generally, of all those whose professional success depends on public opinion."

102 As the Court says: "the onus is upon Gould and those who now represent him to show that the copyright in all the photographs, tape recordings and notes was retained by Gould or, at the very least, that Carroll's copyrights expired once the article in question was published in *Weekend Magazine*." (1998), 39 O.R. (3d) 545 (Ont. C.A.) at 551.

103 *Zamacois v. Douville*, [1943] 2 D.L.R. 257 [1944] Ex. C.R. 208 (Can. Ex. Ct.).

104 *Supra* note 99.

105 (1997), 36 O.R. (3d) 201 (Ont. Div. Ct.) at 210 citing from Lord Denning, M.R. in *Hubbard v. Vosper*, [1972] 1 All E.R. 1023 [1972] 2 Q.B. (Eng. C.A.) at p. 1027 [All E.R.].

106 *Ibid.*

work. The Ontario Divisional Court is therefore not persuasive in its disapproval of the *Zamacois* decision and thus, even if the taking of Ms. Copps' image was fair dealing, this instance should not have been held to fall within the statutory exception to the rights of the copyright holder Allen, because the *Toronto Star* took the whole work.

However, Mr. Justice Sedgwick in the *Allen* appeal decision rests his decision that this taking was fair dealing on another ground altogether and recites a series of findings about the *Toronto Star's* use: "The cover was not reproduced in colour as was the original. The cover was reproduced in reduced form. The news story and accompanying photos received no special prominence in the newspaper. They appeared on an inside page of an inside section. These factors are indications that the purpose of its reproduction of the cover was to aid in the presentation of a news story and not to gain unfair commercial or competitive advantage over Allen or *Saturday Night*."¹⁰⁷ The Court seems to be establishing that the use made by the *Toronto Star* was not "unfair" — which is not a necessary logical equivalent to establishing what is "fair". Not intending unfair commercial or competitive advantage made the *Toronto Star's* use of the cover fair in the eyes of this Divisional Court. This may be contrasted with the view of the majority of the Supreme Court of Canada in the *Aubry* decision who felt that publication of a photograph in a magazine was a commercial use for which the subject should be compensated, as discussed above.

As a result of the Ontario Divisional Court's decision in *Allen*, a photographer is precluded from successfully suing for his copyright in any situation where the subject of the photograph is a public figure and, at least in Quebec, the photographer, as a result of *Aubry*, is not able to exercise his copyright in a photograph of a individual subject other than a public figure. Moreover, if *Allen* is followed, a photographer whose work on any subject is included in a compilation will lose control over the exclusive copyright in the work, as discussed above.

5. CONCLUSION

Copyright was created to encourage dissemination and reward creativity. The *Allen* decision, even if it is limited to the context of photography, disturbs the balance enshrined within the terms of the *Copyright Act*, and limits the rewards that photographers are able to derive from their works. This result would seem to run counter to the

recent trend in the international context to begin to treat photographs in the same way in copyright as are works created through older technologies. The Divisional Court of Ontario decision in *Allen*, taken together with the Supreme Court of Canada decision in *Aubry*, shifts a significant proportion of control away from creators of photographic works to other players in the information dissemination process in affected jurisdictions. Both decisions illustrate the role of the courts in policy making, either deliberately or inadvertently, and the difficulties which can be created for Canada in honouring its international obligations if the courts are not aligned with the legislators in seeking to fulfill those obligations.

¹⁰⁷ *Supra* note 3 at 209.