



FEDERAL COURT RULES ON CANADIAN TEST FOR JOINT AUTHORSHIP

ALEXANDRA STEELE^{*}
LEGER ROBIC RICHARD, L.L.P.
LAWYERS, PATENT AND TRADE-MARK AGENTS

The Federal Court of Canada recently dismissed an application to expunge a copyright certificate of registration on the basis that, contrary to the Applicant's assertion, the owners and authors named in such registration were accurately identified [*Neugebauer v. Labieniec*, 2009 FC. 666, June 25, 2009, Simpson J.]

The Facts

The Applicant is a Polish Holocaust survivor. The Respondent is a writer and journalist who claims to have jointly authored with the Applicant a book on the Applicant's life.

There were two agreements between the parties. The first agreement was entered into in writing indicated that the Respondent's duties were to "[t]ransfer from tape recording to written media (Polish)" the recollections of the Applicant and to "[e]dit and shape the materials to literary form". The Respondent was given the right to use these materials in her future works. The first agreement made no mention of royalties or copyrights, and it was later held that the first agreement did not deal with a book.

The second agreement was oral. According to the Respondent, it provided that the parties would be joint authors of a book. The second agreement also provided that the Applicant would pay for the first printed edition and receive the whole income from that edition; profits from future editions, and any translations, would thereafter be divided between the parties.

A book was published in May 2006. The front of the jacket displayed the names of both parties, with the Applicant's name above and in slightly larger font than the

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^{*} Lawyer, Alexandra Steele is a member of LEGER ROBIC RICHARD, L.L.P., a multidisciplinary firm of lawyers, and patent and trade-mark agents. Published in the October 2009 Issue of *World Intellectual Property Report*. Publication 142.228

Respondent's. The publishing information also referred to copyright for both parties. On the jacket was a mention that the Applicant had told his story to the Respondent.

The Applicant participated in all decisions relating to the publishing and printing of the book and approved the work throughout each stage of the process. The Court therefore found that the Applicant's was unaware of the copyright and authorship information appearing in the book before it was printed.

The first promotional event surrounding the book took place in a bookstore and the Applicant had introduced himself as a co-author of the book written by the Respondent. The Respondent had also received an autographed copy of the book from the Applicant, which had a dedication thanking her for "writing" the book. The Applicant acknowledged during trial that the Respondent had written every word in the book.

The Respondent registered the literary work with the Canadian Intellectual Property Office in July 2006: she identified herself and the Applicant as owners and authors of the book. The Applicant submitted an independent application for a copyright registration which was registered in November 2007, and identified himself as the sole owner and author of the book.

The Applicant sought to have the first copyright registration of July 2006 expunged from the register.

The Federal Court Judgement

In order to decide whether to order the July 2006 copyright registration expunged from the Register, the Federal Court was seized of two issues:

- a. Was the Respondent's contribution to the book sufficient to constitute authorship under the *Copyright Act*? and
- b. Did the parties' respective contributions to the book constitute joint authorship?

On the first issue of authorship, the Applicant and the Respondent disagreed on the creative contribution of the Respondent to the book. As the word "author" is not defined in the Canadian *Copyright Act*, case law has indicated that it comprises a sense of creativity and ingenuity. An author is usually the person who expresses an idea in an original, novel, form.

The evidence showed that the Respondent had contributed sufficient originality and expression to claim authorship over the book: there was much more to her contribution than simply a transcription of the Applicant's narrative, or minor

improvements to flow, editing of vocabulary and drafting. Over a dozen scenes in the book were based on the Respondent's imagination and research

Copyright law does not protect ideas, concepts or facts, but rather the expression of these ideas, concepts or facts in an original form. The Applicant admitted that the Respondent had created a story and events loosely based on the Applicant's life. Referring to the case of *Gould Estate v. Stoddart Publishing Co.* (1996), 30 O.R. (3d) 520 (Gen. Div), affirmed (1998), 80 C.P.R. (3d) 161 (Ont. C.A.), the Court stated that a person does not have copyright in a work simply because he or she responds to questions in interviews. The Court held that it is the person who reduces oral statements to a fixed form that acquires copyright.

On the second issue of joint authorship, the Court referred to the definition found in Section 2 of the *Copyright Act*, R.S.C. 1985, c. C-42, where "joint authorship" means a work produced by the collaboration of two or more authors in which the contribution of one author is not distinct from the contribution of the other author or authors.

The Court found that under the second agreement, there was such a collaboration which contributed to unitary whole; in other words, the parties intended that their contributions be joined in furtherance of a common design. The Court accepted the Respondent's evidence that the parties agreed they would be joint authors.

The Court also analysed the application of the conventional test for joint authorship vs. the expanded test introduced by the British Columbia Supreme Court. The conventional test is three-pronged and is set out in the case of *Levy v. Rutley* (1871) 6 L.R. 976 (CP):

- (a) joint authorship is established by facts and law not on the parties' intentions;
- (b) the contribution of each of the parties need not be equal, although they must be substantial;
- (c) there must be a joint labour in carrying out a common design even if one contribution may be qualitatively and quantitatively inferior to the other.

The expanded test adopted by the British Columbia Courts relies on the case of *Neudorf v., NettwerkProductions Ltd.* (1999), 3 C.P.R. (4th) 129 (B.C.S.C.) where the Court adopted the U.S. test that requires that collaborators intend to regard each other as joint authors.

The Court preferred to apply the conventional test of *Levy v. Rutley*, the learned judge deemed that the *Neudorf* had doubtful application under Canadian law, especially since it has not yet been tested at the appellate level.

On the basis of application of the conventional test for joint authorship, and in light of the evidence, the Court ruled that the Applicant and the Respondent were joint

authors of the book and it dismissed the application to expunge the Respondent's copyright registration. The Court further ordered that the Applicant pay the Respondent's costs for her time, reasonable disbursements and party and party costs associated with the work of any counsel retained to assist her with the application, as the Respondent had been self-represented.

Conclusion

Researching, creating and writing a book is a long and arduous process that finds ultimate reward when the book is finally published and successfully finds its readership. When authors collaborate, the process of writing the work should be well documented, preferably in writing, to avoid the unnecessary difficulties and costs of uncertain copyright authorship and ownership. In this case, the final determination of authorship was made in just over 18 months, but as all counsel know, litigation can turn into a saga where no one can predict a happy ending.



