THE KICK THAT GOT THE BALL ROLLING: COPYRIGHT IN ARCHITECTURAL WORKS IS GAINING TRACTION IN CANADA

Posted on January 30, 2018

Categories: Insights, Publications

There are few cases in which a plaintiff has succeeded in a claim that its copyright in an architectural work has been infringed. Those plaintiffs that did succeed rarely recovered significant damages. However, in *Lainco inc. c. Commission scolaire des Bois-Francs*,[1] the Federal Court awarded an unprecedented quantum of damages ($722,996) against a school board, its architectural firm, engineering firm and general contractor for copying the structural design of a neighbouring soccer complex. The court held that a building structure resulting from the simple arrangement of components can be copyrighted in and of itself, despite the author holding no copyright over the individual components of the design. This decision may signal an important change in the otherwise dormant field of architectural works in copyright law.

To understand the key points of the *Lainco* case, this article will review the history of architectural works in Canadian copyright law. In a sister article, What You Don't Know About Copyright in Buildings Could Cost You So Here's What You Need To Know, recommendations as to how parties in the building sphere can take proactive steps to protect themselves from engaging in intellectual property infringing activities, or in the alternative, set up the appropriate safeguards to guarantee the protection of valuable intellectual property assets.

The History of Canadian Copyright Protection of Architectural Works

At its core, copyright is the right of an author to make copies of her original work. An author of a copyrighted work is empowered to license use of her work, or commence an action for unauthorized use. Originality is the keystone of copyright, and the originality of the author's work must be proved, along with evidence of the fixation of the original idea, in order to establish a right.

Architectural works are defined as including any building or structure or any model of a building or structure.[2] The definition of "artistic work" includes not only architectural works, but also the plans and drawings prepared by the architect used to construct the building or structure. For an architectural work to be original it is not necessary that the design elements be novel; what is necessary is that the way those elements are arranged to create the design must be the product of skill and judgment. Ordinarily, it is the architect, and

not the builder, who has a primary claim to ownership of the copyright given that the copyright vests in the person who creates the drawings giving rise to the three-dimensional object.[3]

Prior to 1988, the definition of "architectural work" in the *Copyright Act* required such a work to possess an identifiable "artistic quality or character" before copyright protection would be granted. Further, protection in architectural works of art expressly did not extend to processes or methods of construction (the appropriate field being patents). Since the 1988 amendments, it is no longer necessary to demonstrate an artistic character or design. Notwithstanding this lowered burden, however, only a handful of infringement cases have gone to court, and damages have often been far lower than the amount claimed.

***Lainco* case: Bend it like LeBlanc may have kick-started a new trend**

Enter Lainco, shaker of the *status quo.* Here, the plaintiff, Lainco Inc., claimed copyright in the design, manufacture and erection of an indoor soccer stadium. The defendants, a school board, its architectural firm, engineering firm, and general contractor were found to have infringed copyright through copying of the structural design itself, by supervising the actual construction of the complex, and by authorizing the work. Notably, prior to the construction of the building, Lainco had alerted the defendants of the potential infringement and had offered to enter a licensing agreement, but the defendants refused the offer and continued in their activities, thus leading to this action.

In his lengthy 150 page decision (available in French only) Justice LeBlanc made the following core points:

1. Copyright requires striking a balance between the protection of the copyrighted work with allowing the free flow of ideas in the public domain. It is essential that one be able to draw inspiration from the public domain without necessarily being found guilty of infringing copyright.
2. Copyright only exists in original works. As originality is not defined in the Act, it is determined by the exercise of judicial discretion. The Supreme Court in *CCH Canadian Ltd v. Law Society of Upper Canada*[4] clearly stated that it must be more than the result of a "mechanical" act, and it is essential that there be evidence of skill, know-how, knowledge and the use of practical experience that allows one to evaluate or compare various possibilities to make a choice.
3. Since the 1988 amendments that removed the artistic character requirement for architectural works, courts should be more open to recognising copyright in this realm.
4. Based on the facts before the court (which included evidence of a site visit to the Lainco soccer complex where photos were taken), while the building was the simple product of well-known structural elements (such as Gerber beams, triangular trusses, X-Braces, and steel columns on the periphery of the building), it was the *assembling* of these elements to form the whole structure to meet the complex needs of the users that made the work "original". The intellectual contribution to the product was not purely

mechanical, as it required discretion and judgement to make it both visually appealing and economical.

5. If arranging judicial decisions in a compilation meets the originality test under the *Copyright Act* (as was the case in *CCH*), it would be difficult to see how the combination of structural features to make an architectural work would not, even if the components chosen and put together are, hypothetically, without any particular artistic value, ordinary, or result in something that could be qualified as lacking in aesthetic value or contrary to the fashion of the day. Further, while utilitarian features of a copyrighted work are not typically actionable for infringement (pursuant to s.64.1(1)(a) of the *Copyright Act*), this exception cannot apply to architectural works which always incorporate core structural requirements (being security, performance, and durability). Otherwise, few architectural works, especially for building structures, would be afforded protection.
6. Having concluded copyright had been infringed, the court turned to the attribution of liability amongst the defendants. Justice LeBlanc concluded that all defendants were liable, for either having directly reproduced an important part of the complex or the construction plans, or for simply having approved the construction of the building. Of note, the court underlined that a lack of intent to engage in copyright infringement is not a defence.
7. The court also concluded that despite the architect's claim of limited involvement in the project, it was nevertheless liable. The architect was unable to refute liability despite its limited involvement in the project because the court held that it was the only one of the defendants able to understand, gather and coordinate all of the activities necessary for the realization of the project including the erection of the building and management of the construction site. Therefore, despite its absence of direct input, its role as a coordinator was sufficient to ground its liability.
8. Turning to damages, in applying s.35(1) of the *Copyright Act*, Justice LeBlanc awarded Lainco nearly three quarters of a million dollars for copyright infringement. Intriguingly, Lainco sought damages for the profits it would have earned had it been hired to create and erect the structure (less the profit it had gained from the projects it had been able to complete during that period). It also sought $50,000 in punitive and exemplary damages (which were not granted). In awarding this amount, the court noted that the goal of restitution in this context is not to indemnify the plaintiff but rather to prevent the unjust enrichment of the defendant.

Closing Remarks

This case is notable for three reasons:

First, that the Federal Court is increasingly willing to grant copyright in building structures means that key players will need to revisit their agreements to better understand who owns the copyright, what restrictions exist on the copyright, and consider creating a framework as to how the copyright will be managed (for tips,

click here).

Second, that this decision comes from a Federal Court judge in Québec, and largely cites Québec jurisprudence, reinforces that the Canadian judicial landscape requires a close understanding of geographic tendencies, despite the case being heard at the Federal level.

Lastly, this case showcases that although the amendments to the architectural works portion of the *Copyright Act* occurred in 1988, it is only in the past few years that we have seen a movement towards enforcing greater protection. This underscores the importance of staying abreast of current jurisprudence, and not simply relying on past practice and tried and true precedents.

As a footnote, it is worth noting that there is a school of thought that suggests a difference in the way that common law lawyers and civil law lawyers think about the foundations of copyright law, which is perhaps reflected in the respective titles of the Act in English and French. While it is the *Copyright Act* in English (that is, the right to control the making of copies), in French it is the *Loi sur le droit d'auteur* (or the law on the rights of the author). There is a sense in the reasons of Justice LeBlanc that the manner in which the defendants copied the design was an affront to Lainco's rights as owner of the copyright.

by Christie Bates

[1] *Lainco inc. c. Commission scolaire des Bois-Francs*, 2017 CF 825.[ps2id id='1' target=''/]
[2] *Copyright Act*, R.S.C., 1985, c. C-42, s. 2.[ps2id id='2' target=''/]
[3] *Hay v. Sloan*, [1957] O.W.N. 445, at para 7; *Meikle v. Maufe,* [1941] 3 All E.R. 144 at 148.[ps2id id='3' target=''/]
[4] *CCH Canadian Ltd v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339.[ps2id id='4' target=''/]

A Cautionary Note

The foregoing provides only an overview and does not constitute legal advice. Readers are cautioned against making any decisions based on this material alone. Rather, specific legal advice should be obtained.

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