



Canadian Internet Policy and Public Interest Clinic
Clinique d'intérêt public et de politique d'internet du Canada

SUBMISSION TO
THE
STANDING COMMITTEE ON CANADIAN
HERITAGE
REGARDING
COPYRIGHT REFORM
AND
SUBSECTION 13(2) OF THE COPYRIGHT ACT

April 14, 2004

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Submission of the Canadian Internet Policy and Public Interest Clinic (CIPPIC)
regarding subsection 13(2) of the *Copyright Act*

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TABLE OF CONTENTS

The Issue.....	1
CIPPIC.....	1
Summary of CIPPIC Submission.....	1
The Rationale behind subs.13(2).....	2
Appropriate amendments to subs.13(2).....	4
Other Consumer Interests affected by subs.13(2).....	5
Conclusion.....	6
Recommendations.....	6
APPENDIX: Excerpts from other countries' copyright legislation.....	7

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The Issue

1. Photographers have been lobbying for some time to obtain rights under the *Copyright Act*¹ similar to those of other artists. In particular, they would like subs.13(2) of the *Act* to be repealed, so that they have first ownership of copyright in commissioned photographs. While photographers make a compelling case in the context of commissions by large commercial entities, their position fails to take into account important interests of ordinary consumers and portrait subjects.
2. The repeal of subs.13(2) is now the subject of Bill S-16, and is also being considered as part of the Parliamentary review of the *Act*. This submission is directed to those Parliamentary Committees considering amendments to subs.13(2) of the *Copyright Act*, whether via Bill S-16 or a more comprehensive review of the *Act*.

CIPPIC

3. The Canadian Internet Policy and Public Interest Clinic (CIPPIC) is a legal clinic at the University of Ottawa, Faculty of Law. CIPPIC seeks to ensure balance in policy and law-making processes on issues that arise as a result of new technologies. Among its many activities, CIPPIC was recently granted intervener status to argue privacy and copyright law issues in the highly-publicized music file-sharing litigation before the Federal Court. CIPPIC maintains a website at www.cippic.ca containing information about its numerous activities.

Summary of CIPPIC Submission

4. While changes to subs.13(2) are warranted in order to grant photographers similar rights to other creators, the simple repeal of subs.13(2) would be unfair to consumers. The current default rule in subs.13(2) of the *Act* was based on important consumer interests that continue to apply.
5. A fair and balanced solution to this problem is to amend subs.13(2) so as provide default copyright ownership to those who commission photographs and other works *for personal and domestic purposes*. Under this approach, creators of all specified works are treated equally, and the default rule favours consumers only where appropriate. In particular,

¹ R.S.C. 1985, c.C-42 [the *Act*].

- **Those who, for personal or domestic purposes, commission and pay valuable consideration for photographic or other works² should have first ownership of copyright in such works, subject to an agreement to the contrary.**
6. This rule reflects the reasonable expectations of consumers, and puts the onus on the stronger party – the photographer – to obtain the consumer’s agreement to a different allocation of copyright. For the same reason that photographers should have the default copyright in works commissioned by commercial entities for purposes other than personal or domestic, individual consumers should have default copyright in works they commission. In both cases, the default rule favours the weaker party to the bargain, but allows for an agreement to the contrary.
7. In addition,
- **Regardless of who owns copyright, those who commission photographic and other works for personal or domestic purposes should have statutory rights to restrain uses and communication to the public of the works they commission.**
8. Finally,
- **Regardless of who owns copyright, portrait subjects should have the right to restrain reproduction or communication to the public of their portraits.**

The Rationale behind subsection 13(2)

The customer who sits for the negative thus puts the power of reproducing the object in the hands of the photographer; and in my opinion the photographer who uses the negative to produce other copies for his own use, without authority, is abusing the power confidentially placed in his hands merely for the purpose of supplying the customer;...

Pollard v. Photographic Co. (1888) 40 Ch. Div. 345

9. Subsection 13(2) has been present in the *Act* since it first came into force in 1924.³ Except for a minor amendment in 1997,⁴ the provision has remained unchanged since 1924.⁵ The modern provision reads as follows:

² The scope of “works” in this section should be broader than photographs, portraits and engravings. Consideration should be given to extending this right to cover all works.

³ S.C. 1921, c.24, s. 11(1)(a). See also the *Imperial Copyright Act* (1911) 1 & 2 Geo. 5, c.46, s.5(1)(a). The *Copyright Act of 1868* 31 Vic. C.54, s.15 provided that copyright in all works made to order or sold was transferred to the purchaser.

⁴ S.C. 1997, c.24, s.10(1).

⁵ Harry Chartrand, *The Compleat Canadian Copyright Act: Current, Past & Proposed Provisions of the Act 1921 to 1997* (Saskatoon: Compiler Press, 1997) at 66.

13(2) Where, in the case of an engraving, photograph or portrait, the plate or other original was ordered by some other person and was made for valuable consideration, and the consideration was paid, 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.

10. There is good reason why this section has been a part of the *Act* from the outset and why it has never been repealed: *subs.13(2) protects the reasonable expectations of consumers who order and pay for engravings, photographs and portraits*, without limiting the ability of photographers and other artists to obtain copyright in the work by contract.
11. For example, subs.13(2) dictates that young couples who hire and pay a photographer to take pictures of their wedding retain copyright in those photographs⁶, unless they have agreed otherwise by contract. In this example, the newlyweds have the default right to, *inter alia*, make copies of their wedding photographs, as well as to restrain any other person, including the photographer, from using the wedding photographs in a way that would infringe the newlyweds' copyright in them. Other relevant examples include hiring a photographer to take a family portrait, photographs of a baby or a photograph of a family dog.
12. In these and all other examples of commissioned photographs, the parties are free to come to an agreement about ownership of copyright under subs.13(2). For example, the photographer might agree to a reduced fee or to take extra photographs in exchange for obtaining copyright in photographs that the photographer wishes to use for marketing purposes.
13. **Subsection 13(2) merely creates a default rule which can be superceded by an agreement to the contrary.** The provision ensures that the photographer obtains the customer's consent to any different allocation of copyright. It places the onus on photographers, rather than consumers, to obtain copyright by agreement.
14. This is a fair and appropriate default position in the case of individual consumers given the disparity in information and bargaining power between photographers and individual consumers. The former are repeat players, with the opportunity and incentive to understand their rights and to use standard form contracts with their customers. The latter are one-time purchasers, with little - if any - understanding of their rights under copyright law. Even if they knew that they should negotiate ownership of rights, they would likely not know what rights to negotiate for, without being prompted by a clause in a contract they are being asked to sign.

⁶ In much of this submission, we will refer to photographs only. However, it should be noted that our submission applies equally in the case of engravings and portraits. Further, we will also suggest that the exception regarding commissioned works might be expanded to other categories of works. In other words, a couple who orders, for example, a video made of their wedding or a poem about it should arguably have the same rights as a couple who merely orders photographs.

15. Similar concerns have been expressed in copyright reports in both Canada⁷ and the United Kingdom.⁸
16. In our submission, if restricted to works commissioned for personal and domestic purposes, subs.13(2) provides an equitable default copyright rule in light of the inequality of bargaining power between the two parties, and is consistent with the reasonable expectations and assumptions held by consumers who commission photographs. The onus should be on photographers, not consumers, to raise and negotiate their rights to copyright in this circumstance.

Appropriate amendments to subs.13(2)

Subs.13(2) should be limited to “personal or domestic” commissionings

17. Photographers are frequently hired by companies to take pictures for publication in a catalogue, on a website or in a brochure. In such commercial transactions, photographers do not have the same bargaining power that they do in transactions with consumers. Rather, photographers in such cases are more likely to be “contract takers” *vis-à-vis* the large commercial customer, in the same way that individual consumers are “contract takers” *vis-à-vis* photographers. For this reason, it is reasonable and equitable that the default position regarding copyright ownership *in the case of works commissioned for purposes other than personal or domestic* should rest with the photographer, as it would for other creators, subject to an agreement to the contrary.

Subs.13(2) should apply to other works as well as photographs, portraits and engravings

18. Subs.13(2) in its current form refers only to “an engraving, photograph or portrait”, and to “the plate or other original” of such works. This language reflects the state of technology at the time that the section was drafted. Since then, digital cameras – for which no tangible “original” exists, other than in digital form - have become increasingly popular. Digital artwork is also being created online. The scope of subs.13(2) should therefore be broadened to cover all relevant works – that is, works for which the same rationale regarding first ownership of copyright applies.
19. New Zealand provides a precedent in this regard, applying first ownership of copyright to consumers in respect of commissioned photographs, computer programs, paintings, drawings, diagrams, maps, charts, plans, engravings, models, sculptures, films and sound recordings.⁹

⁷ The *Royal Commission on Patents, Copyright, Trade Marks and Industrial Design: Report on Copyright*, (Ottawa, 1957) at 46-49 (known as the *Ilseley Commission Report*).

⁸ *Copyright and Designs Law: Report of the Committee to Consider the Law on Copyright and Designs* (H.M.S.O., 1976) (known as the *Whitford Committee Report*).

⁹ *Copyright Act*, 1994, No.143.

Other Consumer Interests affected by subs.13(2)

20. If subs.13(2) is simply repealed, consumers who commission personal photographs or films may find their private and personal images published on websites, in shop windows, in brochures, or elsewhere without their consent. Without further amendments to the *Act*, such consumers will in most cases have no right to restrain such publication.
21. Privacy law in Canada provides inadequate protection for consumers and subjects of photographic or other visual works. The federal *Personal Information Protection and Electronic Documents Act*¹⁰ (“PIPED Act”) only protects “information about an identifiable individual”¹¹ and does not apply to the use or disclosure of personal information for journalistic, literary or artistic purposes.¹² Common law and statutory torts of privacy invasion or appropriation of personality will not protect consumers in most situations involving the unauthorized display, publication or distribution of commissioned photographs. In Quebec, under s.5 of the Quebec Charter of Human Rights and Freedoms and ss.35 and 36 of the Quebec Civil Code, consumers are protected to some degree against the appropriation or use of their image or voice without consent.¹³
22. Other jurisdictions¹⁴ have seen fit to provide limited rights in copyright legislation to consumers and/or subjects of certain types of photographs (*e.g.*, portraits); Canada should do likewise. In particular:

Regardless of copyright ownership, those who commission photographs or films for private and domestic purposes should have the right to restrain use

23. Where consumers who commission photographs or films for personal and domestic purposes do not retain copyright (either because they have transferred copyright to the photographer or filmmaker by contract, or because the law does not grant them copyright), they should at least have statutory rights not to have the work made publicly available. Such a rule would recognize the personal and private nature of many commissioned photographs and films (*e.g.*, weddings), and the likelihood that many consumers will sign standard form contracts transferring their copyright to the photographer/filmmaker either unwittingly or without a full understanding of the implication. It is notable that England, Ireland, New Zealand and Holland have all seen fit to adopt a rule along these lines (see Appendix).

¹⁰ S.C. 2000, c.5.

¹¹ s.2 – definition of “personal information”

¹² subs.4(2)(c)

¹³ See *Aubry v. Éditions Vice-Versa Inc.*, [1998] 1 S.C.R. 591, in which the subject of a photograph which was published without her consent successfully sued the photographer and magazine for invasion of privacy, as well as moral prejudice to her reputation and honour. Note that s.36 of the Civil Code explicitly permits use of a person's image or voice for “the legitimate information of the public”.

¹⁴ See excerpts from the copyright laws of England, Ireland, New Zealand, Holland and Belgium, in the attached Appendix.

Regardless of copyright ownership, the subjects of photographic and other portraits should have rights to restrain the use and publication of their portraits

24. Portrait subjects have a particular interest in controlling the use, publication and distribution of their images. If consumers who commission their own portraits do not have copyright in such works (whether as a result of statute or contract), they should at least have rights to restrain use and publication of their portraits. In other words, copyright owners should not have the right to reproduce or communicate to the public a portrait without the consent of the portrait subject (at least where the subject is also the person commissioning), for a period of time such as until 10 years after the subject's death. The copyright laws in both Holland and Belgium include provisions to this effect.

Conclusion

25. Subsection 13(2) has been the subject of much study and disagreement in Canada for many years. Some writers have proposed that the section be repealed¹⁵ while others have proposed that the rule be extended to all commissioned works.¹⁶ In our submission, neither of these extreme approaches achieves a proper balance between creator and consumer rights. A more moderate approach, recognizing marketplace realities (*e.g.*, imbalances in bargaining power and the use of contracts to establish copyright), is preferable.

26. In order to ensure balance among competing interests, subs.13(2) should not be simply repealed, but rather amended, or accompanied by other amendments to the *Act*, so as to protect the legitimate interests not only of photographers, but also of consumers and subjects of visual and other works.

Recommendations

- **The *Act* should provide copyright by default to individuals commissioning a work for private or domestic purposes.**
- **The *Copyright Act* should provide those who commission photographs or films for private and domestic purposes with a right to restrain reproduction and communication to the public of the commissioned works.**
- **The *Copyright Act* should provide the subjects of portraits with rights to restrain the reproduction and communication to the public of their portraits.**

¹⁵ Barry Torno, *Ownership of Copyright in Canada* (Ottawa: Consumer and Corporate Affairs Canada, 1981) at 50-57.

¹⁶ A.A. Keyes & C. Brunet, *Copyright in Canada: Proposals for a Revision of the Law*. (April 1977) at 71.

APPENDIX

EXCERPTS FROM OTHER COUNTRIES' COPYRIGHT LEGISLATION

Many other jurisdictions have considered this issue, and have chosen to legislate protections in copyright law for consumers and/or subjects of commissioned photographs and other works. The following are relevant excerpts from the copyright laws of a number of developed nations:

A. *England*¹⁷

85 Right to privacy of certain photographs and films

85.—(1) A person who for private and domestic purposes commissions the taking of a photograph or the making of a film has, where copyright subsists in the resulting work, the right not to have-

- (a) copies of the work issued to the public,
- (b) the work exhibited or shown in public, or
- (c) the work broadcast or included in a cable programme service;

and, except as mentioned in subsection (2), a person who does or authorises the doing of any of those acts infringes that right.

(2) The right is not infringed by an act which by virtue of any of the following provisions would not infringe copyright in the work—

- (a) section 31 (incidental inclusion of work in an artistic work, film, broadcast or cable programme);
- (b) section 45 (parliamentary and judicial proceedings);
- (c) section 46 (Royal Commissions and statutory inquiries);
- (d) section 50 (acts done under statutory authority);
- (e) section 57 (anonymous or pseudonymous works: acts permitted on assumptions as to expiry of copyright or death of author).

B. *Australia*¹⁸

Ownership of copyright in original works

(1) This section has effect subject to Parts VII and X.

(2) Subject to this section, the author of a literary, dramatic, musical or artistic work is the owner of any copyright subsisting in the work by virtue of this Part.

(3) The operation of any of the next three succeeding subsections in relation

¹⁷ *Copyright, Designs and Patents Act 1988*, Ch. 48, s. 85 (Eng.)

¹⁸ *Copyright Act 1968* (Cth.), s. 35

to copyright in a particular work may be excluded or modified by agreement.

- (4) If a literary, dramatic or artistic work:
- (a) is made by the author under the terms of his or her employment by the proprietor of a newspaper, magazine or similar periodical under a contract of service or apprenticeship; and
 - (b) is so made for the purpose of inclusion in a newspaper, magazine or similar periodical; the following paragraphs apply:
 - (c) the author is the owner of the copyright only in so far as the copyright relates to:
 - (i) reproduction of the work for the purpose of inclusion in a book; or
 - (ii) reproduction of the work in the form of a hard copy facsimile (other than a hard copy facsimile made as part of a process of transmission) made from a paper edition of, or from another hard copy facsimile made from a paper edition of, an issue of the newspaper, magazine or similar periodical, but not including reproduction by the proprietor for a purpose connected with the publication of the newspaper, magazine or similar periodical;
 - (d) except as provided by paragraph (c), the proprietor is the owner of the copyright.
- (5) Subject to the last preceding subsection, where:
- (a) a person makes, for valuable consideration, an agreement with another person for the taking of a photograph for a private or domestic purpose, the painting or drawing of a portrait or the making of an engraving by the other person; and
 - (b) the work is made in pursuance of the agreement;
- the first-mentioned person is the owner of any copyright subsisting in the work by virtue of this Part, but, if at the time the agreement was made that person made known, expressly or by implication, to the author of the work the purpose for which the work was required, the author is entitled to restrain the doing, otherwise than for that purpose, of any act comprised in the copyright in the work.
- (6) Where a literary, dramatic or artistic work to which neither of the last two preceding subsections applies, or a musical work, is made by the author in pursuance of the terms of his or her employment by another person under a contract of service or apprenticeship, that other person is the owner of any copyright subsisting in the work by virtue of this Part.
- (7) In this section:
- hard copy facsimile* , in relation to a literary, dramatic or artistic work, means a facsimile which is in a material form and from which the work is visible to a human being without the use of any device.
- private or domestic purpose* includes a portrait of family members, a wedding party or children.

C. *New Zealand*¹⁹

21. First ownership of copyright—

- (1) Subject to the provisions of this section, the person who is the author of a work is the first owner of any copyright in the work.
- (2) Where an employee makes, in the course of his or her employment, a literary, dramatic, musical, or artistic work, that person's employer is the first owner of any copyright in the work.
- (3) Where—
- (a) A person commissions, and pays or agrees to pay for, the taking of a photograph or the making of a computer program, painting, drawing, diagram, map, chart, plan, engraving, model, sculpture, film, or sound recording; and
 - (b) The work is made in pursuance of that commission,—
- that person is the first owner of any copyright in the work.
- (4) Subsections (2) and (3) of this section apply subject to any agreement to the contrary.
- (5) Subsections (1) to (4) of this section apply subject to sections 26 and 28 of this Act.

105. Right to privacy of certain photographs and films—

- (1) A person who, for private and domestic purposes, commissions the taking of a photograph or the making of a film has, where copyright exists in the resulting work but is owned by some other person, the right—
- (a) Not to have copies of the work issued to the public; and
 - (b) Not to have the work exhibited or shown in public; and
 - (c) Not to have the work broadcast or included in a cable programme.
- (2) Subject to subsection (3) of this section, the right conferred by subsection (1) of this section is infringed by a person who does an act of the kind described in paragraph (a) or paragraph (b) or paragraph (c) of subsection (1) of this section.
- (3) The right conferred by subsection (1) of this section is not infringed by an act that, under any of the following provisions of this Act, would not infringe copyright in the work:
- (a) Section 41 (which relates to the incidental copying of a work in an artistic work, film, broadcast or cable programme):
 - (b) Section 59 (which relates to parliamentary and judicial proceedings):
 - (c) Section 60 (which relates to Royal commissions and statutory inquiries):
 - (d) Section 66 (which relates to acts done under statutory authority):
 - (e) Section 67 (which relates to acts permitted on assumptions as to expiry of copyright or death of the author in relation to anonymous or pseudonymous works).

¹⁹ *Copyright Act 1994*, No. 143

(4) The right conferred by subsection (1) of this section is infringed by a person who does an act described in subsection (2) of this section or who authorises another person to do such an act.

*D. Germany*²⁰

Article 60 Portraits

(1) The commissioner of a portrait or his successor in title may reproduce it or cause it to be reproduced by photography. If the portrait is a photographic work, reproduction other than by photography shall also be permissible. The copies may be distributed without payment.

(2) The same rights shall be enjoyed by the person portrayed or, after his death, by his next of kin in the case of a portrait created on commission.

(3) Next of kin in the sense of paragraph (2) shall mean the spouse and children or, if there is neither spouse nor child, the parents.

*E. Holland*²¹

Article 7

Where work performed in the service of another person consists in the production of certain literary, scientific or artistic works, the person in whose service they were produced shall be deemed to be the author thereof, unless otherwise agreed between the parties.

Article 19

The reproduction of a portrait by or on behalf of the person portrayed, or, after his death, by or on behalf of his relatives, shall not be deemed to be an infringement of copyright. If the portrait is of two or more persons, reproduction thereof by or on behalf of one of the persons portrayed shall not be lawful without the consent of the others or, during the ten years following their death, without the consent of their relatives.

It shall not be deemed to be an infringement of copyright to reproduce a photographic portrait in a newspaper or periodical if the reproduction is made by one of the persons referred to in the first paragraph of this Article or with his consent, provided that the name of the photographer is indicated if it appears on the portrait.

This Article shall apply only to portraits which have been made pursuant to an order given to the author of the portrait by or on behalf of the persons portrayed.

Article 20

Unless otherwise agreed, the owner of the copyright in a portrait shall not be entitled to make such portrait public without the consent of the person portrayed or, during the ten

²⁰ *Copyright law*, September 9, 1965, as last amended May 8, 1998.

²¹ *Copyright Act* 1912, (as last amended by the Law of October 27, 1972)

years following his death, without the consent of his relatives.

If the portrait is of two or more persons, reproduction thereof shall be lawful only with the consent of all the persons portrayed or, during the ten years following their death, with the consent of their relatives.

The last paragraph of the preceding Article shall apply.

Article 21

If a portrait is made without having been ordered by or on behalf of the person portrayed, the copyright owner shall be allowed to make it public only in so far as the person portrayed or, after his death, his relatives have no legitimate reason for opposing its being made public.

F. *Ireland*²²

114 Right to privacy in photographs and films

(1) Subject to the exceptions specified in subsection (3), a person who, for private and domestic purposes, commissions the taking of a photograph or the making of a film has, where copyright subsists in the resulting work, the right not to have the work or copies of the work made available to the public.

(2) Subject to subsection (3), the act of making available to the public, or authorising the making available to the public, of a work or copies of a work referred to in subsection (1) without the authority of the person who commissions the work infringes the right conferred by subsection (1).

(3) The right conferred by subsection (1) shall not be infringed by an act, which under section 52, 71, 72, 76 or 88 would not infringe the copyright in the work.

G. *Belgium*²³

Art. 10, Protection of Persons Portrayed in Portraits

Neither the author nor the owner of a portrait nor any other possessor or holder of a portrait shall have the right to reproduce such portrait or to communicate it to the public without the consent of the person portrayed or the consent of his successors in title during a period of 20 years as from his death.

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²² *Copyright and Related Rights Act*, 2000, No. 28

²³ *Copyright Act*, 1994