

Use of Construction Documents Prepared by Others: Plagiarism or Lawful Utilization?

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1. Introduction

On most large construction projects, architects and engineers cooperate to design what they believe to be a building that not only meets the needs of their client but is also aesthetically pleasing. In some cases, there may be several architects and engineers from different disciplines contracted to prepare a part of the total design under the supervision of an architect or engineer. Once such a project has been designed and built, both the client and the architects and engineers have an interest in protecting the design. The architects and engineers would like to be paid every time their work is used. The client, in retaining an architect and an engineer, has expressed a desire to own a somewhat unique product and does not want to see others receive a virtually identical product, much less without having gone through the same expense.² In other cases, architects and engineers may prepare plans, however, before they are paid in

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full, the owner may lose the project because it does not have the financing to complete the project or decides not to proceed with the project. A new owner may pick up the project, in some cases from a receiver, and prefer to use its own design team to complete the project. The original architects and engineers are then left, at least trying to get paid, and in some instances trying to stop the use of their construction documents.

One way in which an architect or engineer can have issues of the use of their designs and other construction documents addressed is through the complaints procedure in the legislation governing their professional organizations. Another way would be to use the courts and the copyright laws. It is the purpose of this short paper to explore the extent to which the interests of architects and engineers are protected by their own self-governing organizations and by the law of copyright generally.

² See B.M. McLachlin, W.J. Wallace, A.M. Grant, *The Canadian Law of Architecture and Engineering*, 2nd edition (Toronto: Butterworths, 1994) at p. 263.

2. Protection by Engineers' and Architects' Governing Bodies

2.1 Engineers

Both the architecture and engineering professions are self-governing. An engineer's conduct is governed by the *Professional Engineers Act*³ and the Regulations thereunder, in particular the General Regulation.⁴ An engineer may want to avail itself of the complaints procedure in the *Professional Engineers Act* regarding the unauthorized use of their construction documents. However to do so, the conduct must fit into an enumerated act of professional misconduct.

Regulation 941 is the general Regulation under the *Professional Engineers Act*.⁵ It sets out the definition of professional misconduct, however, the Regulation does not expressly mention the copying of another engineer's work as being prohibited.⁶ Section 77 of the Regulation sets out the Code of Ethics of the Association which includes that the engineer:

"give proper credit for engineering work, uphold the principle of adequate compensation for engineering work, provide opportunity for professional development and advancement of the

³ R.S.O. 1990, c. P.28, for architects, see the *Architects Act*, R.S.O. 1990, c. A.26.

⁴ R.R.O. 1990, Reg. 941, for architects, see R.R.O. 1990, Reg. 27.

⁵ R.S.O. 1990, c. P.28.

⁶ Regulation 941, s. 72.

practitioner's associates and subordinates, and extend the effectiveness of the profession through the interchange of engineering information and experience." (emphasis added)

However, a complaint that is based solely on a breach of the Code of Ethics is not an act of professional misconduct, something more is required in order to attempt to fit the conduct into an act of professional misconduct.

In order that the matter come before the Discipline Committee, there must be an act of incompetence or professional misconduct. For example, "signing or sealing a final drawing, specification, plan, report, or other document not actually prepared or checked by the practitioner"⁷ is an act of professional misconduct and may support a complaint that drawings or other construction drawings have been copied. Consider the unusual case of *Ventin v. Ont. Assn. of Architects*,⁸ where the architect was charged with, and pleaded guilty to, affixing his seal to a design that was not prepared under his personal supervision and direction. The client had previously submitted the plans to the municipality for approval but they were rejected as they were not prepared by an architect.

⁷ Regulation 941, s. 72(2)(e).

⁸ (1988), 29 C.L.R. 228 (Ont. Div. Ct.) The provision in the regulations to the *Professional Engineers Act* is virtually identical to the one in the *Architects Act* under consideration in this case.

The architect was retained and requested by the owner to affix his seal to the drawings that were previously rejected so the owner could resubmit them to obtain a building permit. The architect appealed from the sentence imposed on the basis that the architect did not know that the drawings were previously submitted and that once he affixed his seal to them, they would again be resubmitted. The Divisional Court dismissed the appeal simply on the basis that the charge of professional misconduct related to affixing his seal to plans he did not prepare, even if that was done at the request of the owner who had presumably prepared the drawing. Whether the architect knew that the drawings had been submitted and rejected and would be submitted again with his seal was irrelevant for the misconduct and sentence.

Other acts of professional misconduct, which tend to speak of the misconduct in broad terms, may be used to fit the act of copying construction documents prepared by another member. For example, an act that “constitutes a failure to maintain the standards that a reasonable and prudent practitioner would maintain in the circumstances” is defined as negligence, which in turn constitutes professional misconduct.⁹ Also, “conduct or an act relevant to the practice of professional engineering that, having regard to all the circumstances, would reasonably be regarded by the engineering profession as disgraceful,

dishonourable or unprofessional” constitutes professional misconduct.¹⁰ The Court has stated that there cannot be a more knowledgeable group than the Discipline Committee to decide what would reasonably be regarded by the engineering profession as disgraceful, dishonourable or unprofessional conduct.¹¹ The failure to make responsible provision for complying with applicable statutes in connection with work being undertaken by the engineer also constitutes professional misconduct.¹² The copying of a another engineer’s work without permission or compensation may likely fall under either of these broadly stated acts of professional misconduct.

Section 10(1) of the *Professional Engineers Act* establishes several committees including the Complaints Committee and the Discipline Committee.¹³ The composition of the Complaints Committee is set out in s. 23(1) of the *Act* and must be composed of no fewer than three members of the Association of Professional Engineers of Ontario.¹⁴

⁹ Regulation 941, s. 72(1) and 72(2)(a).

¹⁰ Regulation 941, s. 72(2)(j).

¹¹ *Assn. Of Professional Engineers (Ontario) v. Karmash* (1998), 39 C.L.R. (2d) 165 (Ont. Div. Ct.).

¹² Regulation 941, s. 72(2)(d).

¹³ For the corresponding section in the *Architects Act*, see s. 9(1).

¹⁴ For the corresponding section in the *Architects Act*, see s. 29.

The duties of the Complaints Committee are set out in s. 24 of the *Act*,¹⁵ namely the Committee shall consider and investigate complaints made by the public or other members regarding the conduct or action of a member. Once a complaint is received, the Committee must consider and investigate the complaint, however the decision of whether to refer the matter to the Discipline Committee does not arise until a written complaint in the Association's form is received by the Registrar of the Association, the member whose conduct or actions are being investigated has been notified of the complaint and given at least two weeks in which to submit in writing any explanation or representation concerning the matter and the Complaints Committee has examined or has made every reasonable effort to examine all records and other documents relating to the complaint.

With respect to the form of complaint, it is in a form provided by the Association. In the case of *Niagara South Condominium Corp. v. J. David Pounder Ltd.*¹⁶, Justice Quinn commented on the apparently odd procedure where the Association physically prepares the written complaints against its members. The Association, upon receiving the complaint, prepared a draft complaint detailing the professional negligence alleged, sent it to the complainant for

¹⁵ For the corresponding section in the *Architects Act*, see s. 30.

¹⁶ (1998), 40 C.L.R. (2d) 173.

approval, revision if necessary, and signature. Since the investigation may occur prior to the complaint being signed and returned to the Registrar, the Divisional Court in the *Nasralla*¹⁷ case indicates that when the Complaints Committee writes to the member whose conduct is under investigation to provide information regarding the incidents, the Committee should disclose to the member that their conduct is under investigation.

Also, before determining whether or not the complaint should be referred to the Discipline Committee, the Complaints Committee is required to examine records and other documents. In the *Nasralla* case, the member argued that the Complaints Committee had lost jurisdiction because it failed to examine all the records relating to the complaint. The Court reasoned that the obligation on the Committee is only to make "every reasonable effort" to examine all records such that a Committee having before it most of the relevant material, including the material submitted by the member in their defence, was found to be sufficient.

The Complaints Committee has three options for a decision. It can refer the matter, in whole or in part to the Discipline Committee, Direct that the matter

¹⁷ *Nasralla v. Association of Professional Engineers of Ontario (Discipline Committee)* (1998), 158 D.L.R. (4th) 379, (Ont. Div. Ct.).

not be referred to the Discipline Committee or take such other action as may be appropriate.¹⁸ In making a determination, the Committee is not required to hold a hearing or to afford an opportunity for a hearing or oral submissions before making a decision. The Committee must also not allow the complainant to play a greater role than is necessary or desirable. As the Divisional Court noted in the *Nasralla* case, while some communication with the complainant is necessary to investigate and prosecute a complaint, permitting the complainant to review the members response to an expert's report and asking the complainant to comment is going to far.

By section 24(3), the Complaints Committee is required to deliver its decision in writing which is then mailed to the complainant and the member.¹⁹ Where it is found that the matter should proceed to the next level, the Discipline Committee directs that the matter be referred, in whole or in part, to the Discipline Committee.

The Discipline Committee is composed of at least five members.²⁰ Whereas the Complaints Committee has a broad discretion in terms of investigating conduct or actions of its members, the duties of the Discipline Committee require it

¹⁸ S. 24(2), for the corresponding section in the *Architects Act*, see 30(2).

¹⁹ For the corresponding section in the *Architects Act*, see s. 30(3).

²⁰ The *Architects Act*, s. 33(2) requires 3 members for a quorum.

when directed "to hear and determine allegations of professional misconduct or incompetence against a member" of the Association.²¹

Incompetence tends to with issues such as lack of skill or judgment and physical or mental conditions affecting their ability to practise. Professional misconduct is defined as follows:

Professional misconduct

(2) A member of the Association or a holder of a certificate of authorization, a temporary licence or a limited licence may be found guilty of professional misconduct by the Committee if,

- (a) the member or holder has been found guilty of an offence relevant to suitability to practise, upon proof of such conviction;
- (b) the member or holder has been guilty in the opinion of the Discipline Committee of professional misconduct as defined in the regulations.

Section 28(4) sets out the powers of the Discipline Committee where its finds its member has committed an act of professional misconduct or is incompetent.²² They range from the very harsh of revoking the licence of the member to imposing specific conditions on the manner in which the holder engages in the practice of professional engineering.

²¹ For the corresponding section in the *Architects Act*, see s. 34(1).

The provisions governing the discipline hearing itself are set out in section 30 of the *Professional Engineers Act*.²³ The member is provided with disclosure of the written or documentary evidence that will be produced at the hearing including any reports the contents of which will be given in evidence at the hearing. The hearing is closed to the public. The only evidence permitted during the hearing is evidence that would be admissible in court in a civil case and the findings of the Discipline Committee shall be based exclusively on evidence admitted before it. The Divisional Court has made it clear that the Courts do not expect the Committee to give reasons that one might expect of a judge, where crucial evidence conflicts the Committee should state whose evidence is accepted and the reasons for so deciding. The decision must not only disclose the grounds upon which the Committee finds the member guilty of professional misconduct, but also be based exclusively on the evidence that was admitted.²⁴ Although the use of the complaints procedure may be of use to a member whose construction drawings are copied by another member, its utility may be limited in that the member aggrieved is not part of the process, no damages are awarded and information and documents obtained in the disciplinary proceeding generally may not be used in the civil proceeding.²⁵

²² For the corresponding section in the *Architects Act*, see s. 33(4).

²³ For the corresponding section in the *Architects Act*, see s. 35.

²⁴ *Brisson v. Assn. Of Architects (Ontario)* (1992), 6 C.L.R. (2d) 150 (Ont. Div. Ct.).

2.2 Architects

The provisions in the *Architects Act* in respect of the complaints procedure and disciplinary hearings are very similar to those found in the *Professional Engineers Act* and its regulations. In case an architect has reason to believe that one of his or her colleagues has engaged in such conduct, the *Architects Act* provides the procedure to be followed by the aggrieved party. Once an architect becomes aware of such conduct, the *Architects Act* provides for a procedure virtually identical to that of the *Professional Engineers Act*. Section 42 of the General Regulation in respect of architects defines “professional misconduct” for the purposes of the Act. Section 42(34) specifically provides that “copying the design or work of another person without the consent or agreement of the other person” constitutes such misconduct. Section 42(47) prohibits “soliciting or accepting any work when the member or holder knows or has reason to believe that another member or holder has been engaged or employed for the same purpose by the same client except as permitted by the standards of practice set out in this Regulation”.

²⁵ See *Niagra South Condominium Corp.* case, *supra*.

The standards of practice make it clear that other than providing an independent opinion or undertaking the work later,

“No holder or officer, director, employee or partner of a holder shall solicit or accept any work in respect of a building project knowing or having reason to believe that another holder has been engaged on the same building project for the same purpose by the same client.”

This standard of practice would not apply also in situations where the new architect is advised in writing that the engagement of the old architect has been terminated or the new architect provides notice in writing to the old architect that they are retained for the same purpose by the same client. As may be apparent, whether there is a violation of this standard of practice may depend on whether the clients are the same and whether the architects are engaged for the same purpose. With architects, although the complaints procedure or disciplinary proceedings may be of some use, its uses are limited like that of the statute and regulations in respect of engineers.

3. Copyright

“Copyright” in relation to a work is the sole right to produce or reproduce a work or any substantial part thereof in any material form whatever.²⁶ In Canada, such a right subsists in every original literary, dramatic, musical and artistic work.²⁷ “Every original literary, dramatic, musical and artistic work” is defined in section 2 of the *Copyright Act* as including:

Every original production in the literary, scientific or artistic domain, whatever may be the mode or form of its expression, such as compilations, books, pamphlets and other writings, lectures, dramatic or dramatico-musical works, musical works, translations, illustrations, sketches and plastic works relative to geography, topography, architecture or science.

“Artistic work” includes paintings, drawings, maps, charts, plans, photographs, engravings, sculptures, works of artistic craftsmanship, architectural works, and compilations of artistic works.²⁸ “Architectural works” are defined as any building or structure or any model of a building or structure.²⁹ Until 1988, the various Acts referred to “architectural work of art”, which was defined as “any building or structure having an artistic character or design, in respect of that character or design, or any model for the building or structure, but the

²⁶ *Copyright Act*, R.S.C. 1985, C-42, s. 3(1).

²⁷ *Copyright Act*, R.S.C. 1985, C-42, s. 5(1).

²⁸ *Copyright Act*, R.S.C. 1985, C-42, s. 2.

²⁹ *Copyright Act*, R.S.C. 1985, C-42, s. 2.

protection afforded by this Act is confined to the artistic character or design, and does not extend to processes or methods of construction.” Copyright under the former Act, therefore, subsisted not in the building itself, but in the artistic character or design.³⁰ A discussion of what was considered to be of “artistic character or design” can be found in the 1991 Ontario decision in *Viceroy Homes Limited v. Ventury Homes Inc.*³¹ In that case, the plaintiff was a package home manufacturer. The package homes were essentially kits. Potts J., after a review of the pertinent authorities, held that:

It has been said before that beauty is in the eye of the beholder. Certainly one cannot readily declare what is and is not artistic, *Hay and Hay Construction Co. Ltd. v. Sloan et al.* (1957), 16 Fox's Pat. C. 185 (Ont. H.C.). Artistry is an individual matter. Definitions here differ with each and every person. However, there is an aspect of artistry that can be addressed. An aspect of the matter that I consider determinative for our purposes. The authorities presented to me on the subject were consistent on one point, artistry here has within it an element of uniqueness...

When I refer to the matter of "uniqueness", and where it has been referred to in the cases cited in the previous paragraph, it is in reference to the matter of artistry. Are the homes novel in an artistic sense? Are they distinctive in any way? Are they set apart in some way from what one generally sees? [...]

³⁰ *Hay v. Sloan* (1957), 16 Fox Pat. C. 185 (Ont. H.C.); *Randall Homes Ltd. v. Harwood Homes Ltd.* (1987), 17 C.P.R. (3d) 372 (Man. Q.B.); *Viceroy Homes Ltd. v. Ventury Homes Inc.* (1991), 43 C.L.R. 312 (Ont. Gen. Div.),

Given these authorities, I believe it is clear as to what the characteristics are for a unique housing design. I find that Viceroy's four models that are the subject of this litigation are not unique. They are neither distinctive nor individualistic. They exhibit no "flair", no "panache" as Ferg J. put it. They appear to me to be products of what was in the "public domain" as Fox put it in reference to originality. Consequently, I find that the homes, and their brochures and plans are not protected under the *Copyright Act*.

The requirement for an artistic element led to judgments sounding more "like a real estate broker's questionnaire"³² than anything else and was removed from the recent Act. The distinguishing feature is now originality, as required by section 5 of the Act.

The requirement of originality means that a work cannot be a mere reproduction of another work with minor variations.³³ The following test has been suggested:

In determining whether a work is original, the Court could proceed as follows. Firstly, analyzing the work subjectively, it would determine if it was the fruit of the author's personal labour. Secondly, if this is the case, it would analyze the work objectively,

appeal settled and dismissed (1996), 69 C.P.R. (3d) 459 (Ont. C.A.). See J. S. McKeown, *Fox Canadian Law of Copyright and Industrial Designs*, 3rd edition (Toronto: Carswell, 2000) at 223.

³¹ (1991), 43 C.L.R. 312 (Ont. Gen. Div.), appeal settled and dismissed (1996), 69 C.P.R. (3d) 459 (Ont. C.A.).

³² D. Vaver, *Copyright Law* (Toronto: Irwin Law, 2000) at 44.

³³ J. S. McKeown, *Fox Canadian Law of Copyright and Industrial Designs*, 3rd edition (Toronto: Carswell, 2000) at 201-2.

comparing it to other similar works. If the amount of the author's contribution were substantial, the Court would hold that the work was original. Of course to do so, the Court will base its decision on a number of different criteria of which it would be impossible to make an exhaustive list here. Thus, the work's originality cannot be analyzed on the basis of a single, objective criterion. It is generally established taking into consideration the type of work and the process which led to its creation.³⁴

The Quebec Superior Court noted that courts have to engage in a subjective assessment mixed with objective criteria.³⁵ In other words, it is impossible to come up with a definition of what is original and what is merely a reproduction.

In *Slumber-Magic Adjustable Bed Co. v. Sleep-King Adjustable Bed Co.*,³⁶ Justice McLachlin, then of the British Columbia Supreme Court, held that:

The basis of copyright is the originality of the work in question. So long as work, taste and discretion have entered into the composition, that originality is established.

³⁴N. Tamaro, *The 2000 Annotated Copyright Act* (Toronto: Carswell, 2000) at 65.

³⁵ *Bilodeau v. 2821061 Canada Inc.* [1998] A.Q. no. 3243 (C.S.Q.).

³⁶ (1984), 3 C.P.R. (3d) 81 (B.C. S.C.).

In a recent case regarding copyright concerning legal publications, the Federal Court, Trial Division dealt with the requirements for a finding of originality.

Part of the headnote reads as follows:

The concept of originality requires the expansion of the traditional criteria of originality of judgment, skill and labour to include a creative aspect. This creative aspect requires certain personal effort on the author's part together with knowledge, skill, time, reflection, judgment and imagination.³⁷

In light of decisions rendered after the change from “artistic” to “original”, one has to wonder whether all that much has changed. In *Meunier Associés Inc. c. Construction de la Chaudière T.L. Inc.*,³⁸ the plaintiff complained that the defendant had used a sketch of a house for which the plaintiff claimed copyright. In discussing the prerequisite of originality, the Court held that the sketch was neither unique nor distinctive and denied the claim.³⁹ As seen, the Court in *Viceroy Homes*, in discussing artistic merit, used the following terms:

³⁷ *CCH Canadian Ltd. v. Law Society of Upper Canada* (1999), 179 D.L.R. (4th) 609 (Fed. T.D.).

³⁸ [1996] A.Q. no. 4503 (C.S.Q.).

³⁹ See the English summary of the case in N. Tamaro, *The 2000 Annotated Copyright Act* (Toronto: Carswell, 2000) at 28.

I find that Viceroy's four models that are the subject of this litigation are not *unique*. They are neither *distinctive* nor individualistic. (emphasis added)

In practice, the distinction between the two approaches therefore seems subtle at best.

The *Copyright Act* distinguishes between copyright in the work, the plans and illustrations. This distinction may be of importance:

It is important to remember that for an architectural work, the Act imposes a distinction between architectural work in itself, architectural plans and illustrations of model homes. Even if the general principles relative to originality of a work remain the same, the application is different. For example, there would be no copyright on a tri-dimensional replica of an architectural work of the 18th century. However, a copyright could attach to an illustration or photograph of the reproduction. Along the same line, the architect who draws plans of an architectural work reproducing the façade of a building created by an artist painter in a painting would not be violating the artist's rights, but another artist painter would be violating copyright by reproducing the painting.⁴⁰

The ownership of the copyright is regulated in section 13 of the *Copyright Act*:

⁴⁰ N. Tamaro, *The 2000 Annotated Copyright Act* (Toronto: Carswell, 2000) at 29.

Ownership of copyright

13. (1) Subject to this Act, the author of a work shall be the first owner of the copyright therein.

Engraving, photograph or portrait

(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.

Work made in the course of employment

(3) Where the author of a work was in the employment of some other person under a contract of service or apprenticeship and the work was made in the course of his employment by that person, the person by whom the author was employed shall, in the absence of any agreement to the contrary, be the first owner of the copyright, but where the work is an article or other contribution to a newspaper, magazine or similar periodical, there shall, in the absence of any agreement to the contrary, be deemed to be reserved to the author a right to restrain the publication of the work, otherwise than as part of a newspaper, magazine or similar periodical.

Assignments and licences

(4) The owner of the 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, and may grant any interest in the right by licence, but no assignment or grant is valid unless it is in writing signed by the owner of the right in respect of which the assignment or grant is made, or by the owner's duly authorized agent.

[...]

Thus, architects or engineers acting as independent contractors will hold the copyright of the work they author. Where, however, the architect or engineer creates the work as an agent or employee of another person, that person will be the first owner of the copyright. Of course, both premises are true only in the absence of any agreement between the parties to the contrary.⁴¹

Another important distinction is that between the ownership in the copyright and the ownership of the physical plans. In *Webb & Knapp (Canada) Ltd. v. City of Edmonton*,⁴² the Supreme Court of Canada dealt with that distinction. The developer prepared plans for the construction of a new civic centre. The contract between the plaintiff and the defendant city stipulated that should the plan be rejected by Council, the property in the plan would be transferred to the defendant. The plan was rejected, but became the basis for another plan prepared by the defendant. The plaintiff sued for breach of copyright and demanded compensation for the use of the plan. The claim was dismissed both at trial and on appeal. On further appeal to the Supreme Court of Canada, the plaintiff succeeded and was awarded substantial damages. The majority of the Court held that while the contract had indeed stipulated that property in the

⁴¹ B.M. McLachlin, W.J. Wallace, A.M. Grant, *The Canadian Law of Architecture and Engineering*, 2nd edition (Toronto: Butterworths, 1994) at p. 267-8.

⁴² (1970), 11 D.L.R. (3d) 544 (S.C.C.).

plan would transfer to the defendant, the contract was silent on the issue of copyright. The use of the plan by the city was held to have violated the copyright. The plaintiff was awarded damages in the amount of \$50,000. The minority of the Court would have dismissed the appeal, arguing that while a transfer of property and copyright did not necessarily have to go hand in hand, a separation of the two “is not regarded a natural intention of the parties”. The dissenting justices agreed with the lower courts that it had been the intention of the parties that the plaintiff would receive nothing for their efforts should the plan be rejected.

The case law indicates that generally, an architect who designs a building will retain the copyright in the plans.⁴³ In *Bemben & Kuzych Architects v. Greenhaven-Carnagy Developments Ltd.*,⁴⁴ the British Columbia Supreme Court held that:

It is clear that an architect retains copyright in architectural drawings and designs of his creation. It is also clear that use of these drawings without consent is an infringement of copyright unless there has been a written assignment of the ownership of the copyright.⁴⁵

⁴³ See J. S. McKeown, *Fox Canadian Law of Copyright and Industrial Designs*, 3rd edition (Toronto: Carswell, 2000) at 225. See *1246798 Ontario Inc. v. Sterling* (1999), 46 O.R. (3d) 72 (Ont. S.C.J.).

⁴⁴ (1992), 6 C.L.R. (2d) 261 (B.C. S.C.).

In *Bemben*, the plaintiff architect prepared plans for a townhouse project. He was paid the agreed fee of \$18,000 for the plans. The client, however, never proceeded with the project beyond the foundation stage, and the site remained unused. About six years later, the architect walked by the site and saw that 24 unites had been erected according to his plans, together with another 24 identical unites on an adjoining site. The project was finished by a new owner, who had purchased the site with the foundations and had been given the plans. At no time had the architect been asked for permission to have his plans used for the second stage. The defendant argued that it had attempted to contact the architects but had failed to locate them. In fact, while the partnership had been dissolved, the architect was listed in both the yellow and white pages and still resided at the same location indicated on the drawings. The Court held that in the absence of a written assignment of ownership of the copyright, the use of the drawings was an infringement of the copyright and awarded the plaintiff \$15,000 in damages.

The Ontario High Court, in *Holiday Pacific Ltd. v. Valballa Custom Homes Ltd.*,⁴⁶ had some difficulty with the notion of copyright in a plain structure:

⁴⁵ This passage was followed in the Alberta case of *Alvest Neon Signs Ltd. v. 464460 Alberta Ltd. (c.o.b. Coldwell*

The problem with the originality of design in structures and plans such as the ones which are the subject-matter of this litigation revolves around the problem that there are only so many ways of building a two-storey structure.

That statement should be regarded with caution, however. Obviously, in a duplex structure, there are some elements that will be similar or even identical to other duplexes. That does not mean, however, that the differences cannot be sufficient to warrant copyright. In *Kaffka v. Mountainside Developments Ltd.*,⁴⁷ the defendant had attempted to use that very argument. The British Columbia Supreme Court disagreed:

On the question of originality, the defendant submitted that the plaintiff's plan is really just another plan of just another duplex and that, because of the imperatives of lot lines and conventional room arrangements, any designer would have to come up with pretty much the same solution. The comparison to the plans of Mr. Kaffka senior show that that is not so. Even more significant is the fact that the defendant found it necessary to adapt the plaintiff's design in order to get the approval of the design panel. That panel is, according to the evidence, concerned with aesthetic matters and mainly exterior appearance. Of the three designers who attacked the problem, only the plaintiff produced a plan acceptable to the panel.

Banker Achievers Realty) (1994), 24 Alta. L.R. (3d) 420 (Alta. Prov. Ct.).

The facts in *Kaffka* were as follows. The plaintiff was a designer who drew a set of schematic plans of two duplex residences for a property owned by his father. The plans were required to obtain the necessary development permits. The plan to develop the property was not carried out, and a real estate agent was retained to present offers. The father presented the agent with a set of the plaintiff's plans for the sole purpose of illustrating to prospective buyers what kind of structure could be built on the site. The real estate agent was not authorized to include the plans in the sale. The agent did, however, provide the plans to the defendant, a developer, without putting any condition on the delivery. On more than one occasion, the plaintiff's father told the defendant that the plans could not be used without his son's consent. When the buildings were erected, they were virtually identical to those in the plans. Expert evidence revealed that the similarity could not have been accidental. The defendant's argument that it had purchased the plans and a license to use them with the property failed because the plaintiff's father was neither in a position to convey such an interest nor did he purport to do so. The plaintiff was awarded damages in the amount of \$2,500.

⁴⁶ (1990), 29 C.P.R. (3d) 1 (Ont. H.C.).

⁴⁷ (1982), 62 C.P.R. (2d) 157 (B.C. S.C.).

In the Ontario case of *Hay and Hay Construction Co. Ltd. v. Sloan*,⁴⁸ the plaintiff designed and built a number of houses. One of the defendants saw the prototype and wanted a house just like it. He did, however, not want to buy one of the plaintiff's properties, but rather obtain the permission to build the plaintiff's house on another property. The plaintiff refused permission to copy the original house, but the defendant bought the property and, regardless of the refusal, an almost exact copy of the house was erected on the lot. The plaintiff was awarded damages for infringement of copyright.

While it is the ordinary course of events that the copyright should remain with the architect, this is not necessarily so. In *Randall Homes Ltd. v. Harwood Homes Ltd.*,⁴⁹ the plaintiff was a contractor who had retained an architect and a draftsman to create, design and sketch a three bedroom bi-level home for the contractor's exclusive use. The plaintiff prepared brochures in which a show home based on the design was shown. The defendant, using the brochure, built a home almost identical to the show home. The Manitoba Court of Queen's Bench held that although the contractor was not the creator of the design, and although there was no formal assignment of the design to the contractor, the

⁴⁸ (1957), 12 D.L.R. (2d) 397 (Ont. H.C.).

⁴⁹ (1987), 26 C.L.R. 1 (Man. Q.B.).

copyright had passed to the contractor by the payment for the services performed by the architect and draftsman.

4. Implied License to Use Work

In *Netupsky v. Dominion Bridge Co.*,⁵⁰ a 1970 Supreme Court of Canada case, an architect representing the City of Ottawa for a civic centre project came up with the idea of combining an arena with a stadium by using a triangular frame with a cantilever roof. The architect entered into a contract with the plaintiff engineer, Netupsky, to produce plans for the project. The contract clearly contemplated changes and the basis for payment for such changes. When the architect requested that changes be made in order to reduce costs, the engineer refused to make the changes. In an action that went to the Supreme Court of Canada, the Court found that in doing so, the engineer had repudiated the contract.⁵¹ The plans were eventually slightly altered by the defendant, a steel fabricator, to an extent that the structure was identical in appearance. The plaintiff commenced an action for infringement of copyright. That the engineer was the owner of the copyright was common ground between the parties. The defendant submitted, however, that it had a licence to alter the plans. Judson J.,

⁵⁰ [1972] S.C.R. 368 (S.C.C.).

⁵¹ *Netupsky v. Hamilton* [1970] S.C.R. 203 (S.C.C.).

for the unanimous Supreme Court of Canada, held that when the engineer agreed with the architect representing the city to create structural plans for the city's project, those plans became the property of the city to use for the purpose of building the structure in substantial accordance with the plans. It was held that the owner, and through it the subcontractor, became licensees of the engineer. Having found that there was an implied licence, neither the city nor the subcontractor could be found liable for infringing copyright.⁵²

Similarly, in *Adi Ltd. v. Destein*,⁵³ the plaintiff was an architect which had prepared a soils report and plans for a building. The building was subsequently damaged due to settlement, and the owners succeeded in an action against the plaintiff. When the owners sold the property, the new owners hired the defendants to design plans for the repairs. The defendants copied the plaintiff's report and plans in their tender package. The Court held that there was an implied licence arising out of the arising out of the contract between owner and architect for the owner, his successor and their contractors to use the report and the plans for any legitimate repairs or renovations of the building.

⁵² In reaching this conclusion, the Supreme Court relied on the Australian decision in *Beck v. Montana Constructions Pty. Ltd.* (1963), 5 F.L.R. 298 (N.S.W. S.C.) and the English Court Appeal decision in *Blair v. Osborne and Tomkins* [1971] 2 W.L.R. 503 (C.A.), which followed *Beck*.

⁵³ (1982), 141 D.L.R. (3d) 370 (N.B. Q.B.).

Thus, courts will imply terms limiting the rights under a copyright in order to permit repairs to the structure.⁵⁴

Where the implicit consent to use plans is without consideration, the consent may be withdrawn. In *Katz v. Cytrynbaum*,⁵⁵ the plaintiff did the architectural work on a Vancouver development. The plaintiff prepared plans, but remained unpaid. When the owner transferred the property to the defendant, the plaintiff agreed to give his plans to the defendant's engineers. That, the Court of Appeal held, implied a consent to use the plans. Later, however, the plaintiff wrote to the engineers, advising them that he had not been paid for the plans and asking that the plans not be used until some arrangement for payment was made. That, according to the Court, amounted to a withdrawal of the consent. Relying on *Fox's Canadian Law of Copyright and Industrial Design*,⁵⁶ Hutcheon J.A. concluded that where the consent was given without consideration, it could be withdrawn at any time. Had it been given for valuable consideration, it would have been irrevocable and would have conveyed an equitable interest in the copyright.⁵⁷

⁵⁴ See also *John Maryon International Ltd. v. New Brunswick Telephone Co. Ltd.* (1982), 141 D.L.R. (3d) 193 (N.B. C.A.); leave to appeal top S.C.C. refused [1982] 2 S.C.R. viii (S.C.C.).

⁵⁵ (1983), 2 C.L.R. 236 (B.C. C.A.).

⁵⁶ Second edition, 1967 at pp. 339-40.

⁵⁷ See *Island View Beach Estates Corp. v. J.E. Anderson & Associates* [2000] B.C.J. No. 1553 (B.C. S.C.).

5. Conclusion

Whether architects or engineers who feel that their rights have been violated commence proceedings within their professional organizations or in the courts depends mostly on what they want to achieve. If the main aim is economic recovery, then the courts will be the right venue. If the purpose is to bring the misconduct to the attention of fellow professionals and to effect disciplinary action against the violating party, then the respective discipline committees will be the place to go. In any case of serious misconduct, it is probably desirable to take both routes.