

Putting the Cart before the Horse - Proper Proof of Right to Sue is Fundamental to Successful Copyright Claims

Tamara Celine Winegust and R. Scott MacKendrick, Bereskin & Parr LLP

In the context of copyright infringement claims, plaintiffs may assert standing by virtue of their ownership of the copyright work alleged to be infringed, or because their license in respect of that work includes a right of action. Two recent decisions from the Federal Court – [Lickerish, Ltd. v. Airg Inc., 2020 FC 1128](#) and [Dunn's Famous International Holdings Inc. v. Devine, 2021 FC 64](#) – provide instances where plaintiffs failed due to an inability to clearly establish their ownership or license and, thereby, their right to sue. The decisions highlight the importance of providing direct evidence of authorship and ownership of the works alleged to be infringed, so that, if the plaintiff's entitlement to sue is challenged by a defendant, an otherwise meritorious case is not vulnerable to dismissal.

Background

The *Copyright Act*, 1985 R.S.C. c. C-42, establishes that, in almost all instances, the author of a work is considered its first owner, including where a work is commissioned or “made for hire”. Ownership can be assigned, which assignment must be in writing. Owners can also license their copyright, including by granting an exclusive license. Like assignments, exclusive licenses must be in writing.

Importantly, copyright arises upon creation of an original work, and need not be registered with the relevant government office to be valid (in Canada, registration is obtained through the Canadian Intellectual Property Office's Copyright Office). As a practical matter, however, there are many benefits to registering ownership or a grant of interest in copyright – including a presumption that the named owner indicated on the registration document is, in fact, the copyright owner. Without a registration, or other evidence to prove the plaintiff's ownership (for example, a copyright notice with the owner's name), the *Copyright Act* presumes the author to be the owner of copyright where the plaintiff's title to the work is put into issue in any civil proceeding.

Lickerish, Ltd. v. Airg Inc.

Lickerish involved a claim brought by a U.K. photographic syndication agency, Lickerish Ltd., alleging copyright infringement by a social networking software company, AirG Inc. The works at issue were two photographs of Meghan Markle that the defendant allegedly reproduced on its website. Lickerish conceded it was not the author of the photographs. It took the position that it had standing to sue based on an exclusive license to act as the agent for syndication of the photographs at issue. To support its claim, the Plaintiff filed an affidavit of its director,

which included a copy of a purported U.S. copyright registration certificate for the photographs, which listed the photographer as the author, and Lickerish as having “rights and permissions” in the works.

The action was brought as a simplified procedure action. After reviewing this evidence, the Court dismissed the action outright on the basis that the Plaintiff lacked standing. The Prothonotary noted that the Plaintiff provided no direct evidence about the creation of the works, or that it either authored or owned the copyright in the two photographs, including by way of assignment or exclusive license. Moreover, she found the purported U.S. copyright registration inadmissible under the *Canada Evidence Act*. The certificate provided was a mere copy, not a certified copy; the Plaintiff further provided no authority to suggest that the “certified copies” exception in the *Canada Evidence Act* applied to foreign documents; and the Plaintiff failed to provide any authority to suggest that foreign registration certificates could benefit from s. 53 of the *Copyright Act* that provides that the Register of copyrights is evidence of the particulars entered in it. Moreover, the witness had no personal knowledge about the actual application for registration with the U.S. Copyright Office or the issuance of the registration certificate – in other words, there was no way for the Court to authenticate the document and its contents.

Dunn’s Famous International Holdings Inc. v. Devine

In *Dunn’s Famous*, Justice Southcott dismissed copyright infringement claims outright due to the Plaintiff’s failure to provide any evidence of authorship or ownership. The Plaintiff, Dunn’s Famous International Holdings (Dunn’s), operates a consumer retail food product development, marketing, licensing, and wholesale distribution business based out of Montreal, Quebec. The Defendants included a set of allegedly unauthorized franchisees of the Plaintiff, and their principals. Among other claims, including for trademark infringement, Dunn’s advanced claims for copyright infringement against a set of the Defendants for the unauthorized reproduction of portions of Dunn’s website, including its logo, the structure of the website, and specific content in the franchising section of the website. The evidence of copyright ownership proffered by Dunn’s consisted of an affidavit from its President and sole shareholder, in which the affiant referred to “our” website, design, and logos.

Justice Southcott found such evidence fell “significantly short” of what was required to establish copyright ownership. It did not show that the Plaintiff was the author (and thus, the first owner of the works at issue). Nor was it sufficient to show it was the owner by virtue of an assignment. As such, the copyright infringement claim was dismissed.

In contrast, the trademark-related claims succeeded. Dunn’s was awarded over \$500,000 in damages, and pre-judgement and post judgement interest, and costs from the corporate Defendants as well as some of the individually named directors and officers. This outcome suggests that had the Plaintiff filed sufficient ownership evidence, its copyright claim may have succeeded as well.