

When Does An Employer Own Copyright In A Photograph Made By An Employee?



An employee takes a photograph of a customer on the employer's premises. The employee has a signed employment agreement which states that all materials developed during the term of the contract are property of the employer. The employer obtains a copy of the photograph and uses it in social media. Later, the employee is terminated for cause.

The former employee sues for copyright infringement and, in the case of *Mejia v. LaSalle College International Vancouver Inc.*, 2014 BCSC 1559, wins. (The case also involved wrongful dismissal and defamation claims which were unsuccessful.)

In ordinary circumstances, under Canadian law, copyright in a work is initially owned by its author. Leaving the monkey selfie question to one side, the author of a photograph is normally the person who makes the picture.¹ But there is an exception; s. 13(s) of the Copyright Act says:

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[...].

The court in the *Mejia* case had to consider what it means to make a work "in the course of" one's employment. The employer, a college, argued that the photograph was taken in its classroom; the subject matter was one of its students, wearing a fashion project created by another student, in front of a backdrop created by another college instructor. The plaintiff claimed the photograph was created outside of class time and that he was not paid by the employer to create it.

Justice Cohen concluded that the work was not created in the course of the plaintiff's employment. The plaintiff was hired as an instructor, not a photographer.

[207] The plaintiff was hired by LaSalle as an instructor and not as a photographer. While an instructor "proceeding generally about his master's affairs" could possibly be engaging in a wide variety of activities, whether paid or unpaid, I do not view the taking of photographs to be an example of such an activity. In the circumstances of this case, the taking of photographs was not an activity that was

generally considered to be within the duties of the plaintiff instructor, and there was no contractual agreement that he do so. Though the photograph is connected with the employer LaSalle by virtue of its subject and the location in which it was taken, I do not view it as being connected with the plaintiff's employment.

Moreover, Justice Cohen concluded that it was "not clear" that the somewhat vague language in the employment agreement was intended to displace the operation of s. 13 of the *Copyright Act*.²

This case offers a striking reminder to employers to take care in establishing their title to intellectual property created for them by employees. While s. 13(3) of the *Copyright Act* is helpful, it should not take the place of a properly drafted agreement when the stakes are high.³ Employers should clearly document what employees are expected or required to create on their behalf, as part of their duties, and employment agreements should explicitly address intellectual property rights in work products.⁴

At the same time, employers should be wary of assuming they have ownership of all employee creations, particularly when these are tangential (or unrelated) to an employee's normal duties. Photographs taken at work functions by employees who are not paid to be photographers, as in the *Mejia* case, are common examples. Employers should consider obtaining express assignments or licenses to such works before using them for promotional or other commercial purposes. In particularly important or valuable cases, employers should also consider registering these assignments or licenses.

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Article by Keith D. Rose