

Moral Rights : Proper Attribution – *Dolmage v. Erskine*

Bob Tarantino*

A moment of uncomfortable silence often occurs when a client stumbles across a clause providing for a waiver of moral rights. This may be the result of a rhetorical hiccup: calling them “*moral rights*” conveys a certain *gravitas* which can colour the views of both authors and exploiters when dealing with the rights in question.

The recent Ontario decision of *Dolmage v. Erskine*¹ offers a thoughtful canvass of moral rights generally, and in particular clarifies the contours of the right of attribution.

In Canadian copyright law, the term “moral rights” is rooted in section 14.1 of the *Copyright Act*² and encompasses the following prerogatives: the right to the integrity of the work³ (which subsumes (a) the right to prevent a work from being distorted, mutilated or modified, and (b) the right to control use of a work in association with a product, service, cause or institution; in both cases, the impugned activity must prejudice the author’s honour or reputation); and the right of attribution (*i.e.*, the right to be “associated with” a work as the author thereof, either under one’s own name or under a pseudonym, or to remain anonymous).

The *Dolmage* Case

Rod Dolmage participated in a workshop at the University of Western Ontario’s business school, during the course of which he wrote a “case study” which described a business problem. The case study was then used by the school as a teaching tool and also sold to third parties for their own use. While the case study originally bore a credit

¹ (2003), 23 CPR (4th) 495 (Ont. Sup. Ct. (Sm. Cl. Ct.)) [hereinafter *Dolmage*].

² *Copyright Act*, RSC 1985, c. C-42, as amended.

³ See *Copyright Act*, sections 14.1 and 28.2.

reading “written by Rod Dolmage”, subsequent printings were modified to read “Rod Dolmage prepared this case under the supervision of...”. Various catalogues advertising copies of the case study for sale gave the name of the case and a brief summary, but did not mention Dolmage’s name.

Mr. Dolmage sued for infringement of his moral rights, requiring the court to consider three fundamental questions which arise in connection with the right to attribution: first, what is the substantive nature of the credit which must be accorded in order to respect the right provided for in the *Copyright Act*? Second, how does the phrase “reasonable in the circumstances” modify the right to attribution? Third, what is the measure of damages arising from an infringement of the attribution right?

Attribution – Nature of the Credit

Subject to the qualifications discussed below, an author is entitled to receive acknowledgement *as the author* of a work. *Dolmage* provides some guidance as to how the acknowledgement is to be manifested, particularly in the case of written works. The court held that the plaintiff’s moral rights had been infringed because his credit was changed from “written by” to “prepared by”, which “diminished” the role of the author. The reasoning is clear on a subtle but important point: the nature of the required attribution can be determined by industry practice – in *Dolmage* the relevant “industry” being academia. The court looked to the internal standards of the applicable milieu in determining the substance of the credit to be accorded and found that identification as an author (implied by the “written by” credit) is viewed as more prestigious among academics than the lesser contribution denoted by a “prepared by” credit.

Different facets of the entertainment and creative industries may have built up different standards as to what constitutes “acceptable” attribution (as, for example, in the film industry, where there are quite different connotations implied by the terms “producer” and “executive producer”); visual artists (*e.g.*, sculptors, animators or comic book artists) may have entirely different norms by which their contribution is measured.

With respect to song composers, in light of recording industry practice, the required credit may simply be the small-type listings found in CD booklets. Radio announcers typically only make reference to the performer of a song which has just been aired, without identifying the composers (assuming the two are different); as noted by David Vaver,⁴ this practice likely does not constitute infringement of the right of association, both in light of past practice and the “reasonable in the circumstances” threshold, discussed next.

Attribution – “Reasonable in the Circumstances”

Both the text of section 14.1 and *Dolmage* make it clear that the attribution right is not absolute: it is qualified by (a) reference to the activities mentioned in section 3(1) of the *Copyright Act* (*i.e.*, only if there is a reproduction of the work or a substantial part thereof in any material form can an author’s moral rights be infringed by the absence of a credit), and (b) the requirement that the assertion of the right must be “reasonable in the circumstances”.

The “reasonableness” qualification appears to be driven largely by practical concerns of space and time. The foregoing limitations (of “substantial part” and “reasonableness”) informed the *Dolmage* court’s finding that advertisements for the case

⁴ Vaver, David, *Copyright Law* (Toronto: Irwin Law, 2000) at 161.

studies (some of which contained short abstracts of the case) did not constitute an infringement. As in the *Ateliers Tango Argentin Inc. v. Festival d'Espagne & D'Amerique Latine Inc.*⁵ case (where a photographer was awarded damages for moral rights infringement where his photograph was used in a poster, but no credit was given), absent evidence of a compelling practical limitation on the ability of a defendant to provide attribution, courts generally frown on the absence of a credit.

These qualifications impact on a variety of situations, such as advertisements for films (both print and visual, *e.g.*, trailers): presumably, absent a contractual obligation to be credited, it is not necessary to identify a screenwriter (or other “author”, such as the director), since there is no reproduction of a substantial part of a film.

Attribution – Measure of Damages

While commentators have made clear that there is a distinction drawn in the *Copyright Act* as to the entitlement of a plaintiff to damages for infringement of copyright as compared to moral rights,⁶ potential exploiters of works should not be complacent about the possibility of being sued for potential infringement of the attribution right.

While acknowledging the inherent difficulties in calculating damages for moral rights infringement, Canadian courts have not hesitated to award them: the *Dolmage* court awarded \$3,000 in damages “for indignation and diminution of

⁵ [1997] RJQ 3030, 84 CPR (3d) 56 (SC).

⁶ Section 34(2) of the *Copyright Act* provides that: “in any proceeding for the infringement of a moral right ... the court may grant ... all remedies ... that are or may be conferred by law for the infringement of a right” [emphasis added]; this is distinct from the language of section 34(1) which provides that a plaintiff is entitled to damages for infringement of copyright.

reputation”; the court in *Weiss v. Prentice Hall Canada Inc.*⁷ awarded \$6,000, and expressly regretted that it was “trammled by the jurisdictional limits” of the Small Claims Court, else it would have awarded more; in *Boudreau v. Lin*,⁸ the court awarded \$7,500 together with costs on a solicitor/client basis. It should be noted that these damages awards are all in the context of, to use a loaded term, “minor” cases, where the infringers did not stand to make significant profit from their activities; it is likely that in a case involving significant commercial considerations (*e.g.*, a feature film or popular book) the damages would be substantially higher. The court in *Weiss* went so far as to muse that where the attribution right has been infringed, the plaintiff was entitled “at the very least ... to nominal damages, and those are not necessarily small”, and, additionally, punitive and possibly even exemplary damages depending on the presence of bad faith.

In reaching their decisions about what damages to award courts look to vague measures such as lost business opportunities and foregone improvements to reputation, and tend to invoke language reflecting the emotional and moral viewpoint alluded to at the beginning of this article: reference is made to “convey[ing] to the defendants the enormity of their misappropriation of the plaintiff’s literary creation and of their misrepresentation” due to the fact that the plaintiff had “been deprived of the chance to have his persona and advice receive

⁷ (1995), 66 CPR (3d) 417 (Ont Ct. (Gen. Div.) (Sm. Cl. Ct.)) [hereinafter *Weiss*]; this case involved the plaintiff’s article about purchasing real estate, which the defendants published as part of a collection about the topic, without any attribution to the plaintiff.

⁸ (1997), 75 CPR (3d) 1 (Ont. Ct. (Gen. Div.) [hereinafter *Boudreau*]; this case involved a university professor who misappropriated a paper written by one of his students, and passing it off as his own work, without providing credit to the student.

credit” as a result of the failure to properly attribute his authorship.⁹ Also of importance in the recent decisions is the emotional distress caused to the plaintiff and admonishing defendants for their “cavalier” behaviour.¹⁰ None of this is to argue that these are inappropriate grounds for awarding damages; rather, potential defendants should note that they are highly subjective and do not lend themselves to easy quantification, allowing judges relatively wide latitude in arriving at a final determination of an appropriate award.¹¹

Advising Your Clients and Avoiding the Uncomfortable Silence

Entertainment lawyers will often insist on the presence of a moral rights waiver in most contracts. Prudence also argues in favour of coupling that waiver with a treatment of credit entitlements in a separate clause of the contract (even if just to confirm that no credit whatsoever is being accorded), so that all parties are on notice as to what to expect. Doing so will avoid uncertainty on a number of levels: uncertainty as to (a) how the parties should conduct themselves in order to abide by their statutory moral rights and contractual obligations, and (b) how a court might interpret what actions a defendant *should* have taken in addressing the moral rights of the author. As an example, those involved in drafting contracts for the acquisition of art for display in corporate offices may wish to make explicit the wording, size and placement of plaques crediting the artist.

* *Bob Tarantino, Heenan Blaikie LLP, (416) 643-6815, btarantino@heenan.ca*

⁹ *Weiss, supra* note 7 at 429.

¹⁰ *Boudreau, supra* note 8 at 13.

¹¹ As David Vaver rather dryly notes “[d]amages for non-attribution may be big or small, depending on the case” (Vaver at 286).