FIELD LAW

Intellectual Property and Technology

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Ownership of Copyright in Software

By Richard Stobbe

Can an employee claim to own the employer's software?

An "author" of a work is the first owner of copyright. To determine ownership, it's necessary to determine which contributions will be considered "authorship" for the purposes of owning copyright in software. The recent decision in *Andrews v. 1625531 Alberta Ltd. et al*, 2016 FC 624 (June 3, 2016), considered this question in the context of a claim by an ex-employee, Mr. Andrews, that he contributed to, and therefore was a joint author of the employer's software products. The employee went so far as to register copyright in his own name in the Canadian Copyright Office. Since the Copyright Office doesn't perform any "gatekeeping" functions, the ex-employee was able to obtain a registration which purported to relate to the employer's software products. As if this conduct wasn't bad enough, Mr. Andrews then sued his former employer, claiming copyright infringement, among other things.

The former employer defended, claiming that the ex-employee was never an author because his contributions fell far short of what is required to qualify for the purposes of "authorship" under copyright law. The ex-employee argued that he provided the "context and content" by which the software received the data fundamental to its functionality.

The evidence showed that the ex-employee's involvement with the software included such things as collecting and inputting data; coordination of staff training; assisting with software implementation; making presentations to potential customers and to end-users; collecting feedback from software users; and making suggestions based on user feedback.

The evidence also showed that a software programmer engaged by the employer, Dr. Xu, was the true author of the software. Dr. Xu took suggestions from Mr. Andrews and considered whether to modify the code. Mr. Andrews did not actually author any code, and the court found that none of his contributions amounted to "authorship" for the purposes of copyright. The court stopped short of deciding that authorship of software requires the

writing of actual code; however, the court found that a number of things did *not* qualify as "authorship", including:

- Collecting and inputting data;
- Making suggestions based on user feedback;
- Problem-solving related to the software functionality;
- Providing ideas for the integration of reports from one software program with another program; and
- Providing guidance on industry-specific content.

To put it another way, these contributions, without more, did *not* represent an exercise of skill and judgment of the type of necessary to qualify as authorship of software.

The court concluded that: "It is clearly the case in Canadian copyright law that the author of a work entitled to copyright protection is he or she who exercised the skill and judgment which resulted in the expression of the work in material form." [para. 85]

In the end, the court sided with the employer. The ex-employee's claims were dismissed.

Field Law acted as counsel to the successful defendant 1625531 Alberta Ltd.

Richard Stobbe is an IP lawyer, trademark agent and Certified Licensing Professional. For questions, contact Richard in our Intellectual Property and Technology Group.

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