

Practice Note: Safeguarding Intellectual Property

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Concern has been raised to the attention of the Investigation Committee regarding the use of designs or design elements by engineering firms who did not create them. This practice note will outline the concept of copyright and the less-familiar moral rights in engineering design, and discuss the importance of establishing contractual terms to address these matters between designers and clients.

Intellectual property rights are governed in Canada by the Copyright Act (R.S.C., 1985, c. C-42), which establishes the grounds for ownership and transfer of ownership of copyright. Copyright itself is unique from other elements of intellectual property protected by Canadian law, namely: patents, trademarks, industrial designs, and integrated circuit topographies.¹

Note that some specialized questions of the Copyright Act have not been broadly explored in Canadian law and thus have limited precedent.

Copyright

The Copyright Act defines copyright as "the sole right to produce or reproduce the work or any substantial part thereof in any material form..."² Per the Copyright Act, the umbrella of artistic work includes drawings, maps, charts, plans, and architectural work. Architectural work is defined as any building, structure, or model thereof. These definitions establish the grounds by which engineering designs qualify for copyright protection, provided they are also original expressions. It is important to note that copyright does not apply to the idea or the function of the design.³

Copyright can be assigned or transferred in writing by the owner of the right, wholly or in part, per section 13(4) of the Copyright Act. Registration of copyright with the Canadian Intellectual Property Office is not required but provides administrative benefits as well as documented evidence of the registered owner.

Section 13 of the Copyright Act establishes the author of the work as the prime owner of the copyright. If the author of the work creates a design under the

employment of another person or a firm, the employer will hold the copyright unless there is an explicit arrangement otherwise.

Moral Rights

Separate from copyright is another element of intellectual property protected under the Copyright Act, called moral rights. Moral rights are not transferrable nor is their transfer implicit with an assignment of copyright; however, they may be waived wholly or in part. This aspect of intellectual property has seen limited exposure in Canadian courts with regard to its implications on design documents in the engineering and geoscience realm. Moral rights involve the author's right to the integrity of the work as well as the right, per section 14.1(1), "where reasonable in the circumstances, to be associated with the work as its author by name or under a pseudonym and the right to remain anonymous."

Safeguarding Designs

Given that copyright is transferrable and moral rights may be waived, a written contract is an important tool for protecting the work firms and designers complete from subsequent improper use by the client and others. The Association of Consulting Engineering Companies (ACEC) Document 31 provides general contract terms to establish the engineering documents as the property of the engineer (author) and set the grounds for the client's use of copies of the documents, as well as terms to indemnify the engineer should costs arise from improper use of the design documents by others.⁴

When submitting designs to an authority who takes ownership of the designs, firms should be aware that their work may be deemed good engineering practice and become subject to public use. Firms should be aware of the contract stipulations and consider making appropriate disclaimers to indemnify them from future use of the designs by others.

The Alberta Association of Architects similarly states in their practice bulletin PB-17, Copyright and Intellectual Property, that, "in the event that copyright is assigned under contract or it is otherwise agreed to provide a license to authorize some specific reuse of work products by the member, the Association advises that additional protection against unwanted liability is required."⁵

The Investigation Committee recommends that legal advice be sought when establishing contract terms and disclaimers to protect ownership and use of engineering documents.

References:

1. [Government of Canada. \(2019\). A Guide to Copyright.](#)
2. [Copyright Act. \(R.S.C., 1985, c. C-42\).](#)
3. [Pawson, O. and Tomkowicz, R., Miller Thomson LLP. \(2007\). Protecting Your Designs. Canadian Consulting Engineer.](#)
4. [The Association of Consulting Engineering Companies. \(2010\). ACEC Document 31 - 2010 Engineering Agreement Between Client and Engineer.](#)
5. [The Alberta Association of Architects. \(2019\). PB-17: Copyright and Intellectual Property.](#)