

Federal Court



Cour fédérale

Date: 20230529

Docket: T-1441-21

Citation: 2023 FC 749

Ottawa, Ontario, May 29, 2023

PRESENT: The Honourable Mr. Justice Manson

BETWEEN:

LEONARD B FRENCH

Plaintiff

and

**THE ROYAL CANADIAN LEGION
(DOMINION COMMAND)**

Defendant

JUDGMENT AND REASONS

I. Introduction

[1] The Plaintiff brings this simplified action for copyright and moral rights infringement against the Defendant. The Plaintiff is the sole creator and holder of copyright in the work the “Poppy Dalmatian Puppy” (the “Poppy Puppy”). The Plaintiff seeks an award of damages and a permanent injunction restraining the Defendant from infringing copyright in the Poppy Puppy.

II. Background

[2] The Plaintiff, Leonard B French, represented himself throughout this action. He has previously gone by the name Leonard Da Vancouver E.

[3] The Plaintiff commenced this action by filing the Statement of Claim on September 22, 2021.

[4] The Plaintiff has a registered copyright in the Poppy Puppy, registered as the “Poppy Dalmatian Puppy”. The Poppy Puppy is a stuffed animal modelled after a Dalmatian dog, with black-centered red poppies in place of the Dalmatian’s usual simple black spots. The Plaintiff registered his copyright in Canada in the Poppy Puppy on June 8, 2020 under registration number 1170451 (the “451 Registration”). The work was first published on or about February 28, 1998. There is no dispute that copyright subsists in the Poppy Puppy and that Mr. French is its creator and owner.

[5] The Poppy Puppy comes in two sizes, a 7-inch version (the “Large Version”) and a 3.5-inch version (the “Small Version”).

[6] On March 26, 2003, prior to registering any copyright, the Plaintiff registered the Small Version as an industrial design, under registration number 97954. This registration expired in 2013.

[7] The Plaintiff also registered the Large Version under a United States Design Patent as patent number Des. 418,554 on January 4, 2000 for a term of 14 years.

[8] The Defendant, the Royal Canadian Legion (Dominion Command) (the “Legion”), is an organization that advocates for veterans and their dependents. As a source of fundraising, the Defendant sells “Poppy” and “Legion” branded items. These sales occur through the Defendant’s “Legion Supply Catalogue”, a hard copy catalogue distributed to Legion members and through its e-commerce “Poppy Store” website.

[9] The Plaintiff claims that the Defendant has infringed his copyright and moral rights in the Poppy Puppy work.

[10] The Plaintiff initially supplied and licensed the Poppy Puppy to the Defendant in 2003. After the Plaintiff agreed to modify minor elements of the Poppy Puppy, such as the colours of the eyes and of the Poppy spots, the Defendant purchased approximately 100,000 units of the Small Version and 50,000 units of the Large Version. There is no dispute concerning copyright infringement in respect of these units as the Plaintiff admits he authorized these units for sale by the Defendant.

[11] However, the Plaintiff alleges that at some point thereafter, he believed that the Defendant switched to an alternative supplier and induced that supplier to create and supply Poppy Puppy toys, and by so doing, infringed his copyright.

[12] The evidence reveals that shortly after placing the initial order, in the summer of 2003, the Defendant contacted the third-party manufacturer, Ameritech International Inc. (“Ameritech”), inquiring about the potential for them to produce Poppy Puppy toys, in place of the Plaintiff. Ameritech produced samples of the larger version of the Poppy Puppy toy for the Defendant; however, there is no evidence that the Defendant purchased any units from Ameritech after receiving the samples and there was no unauthorized purchase, distribution or sale of any Poppy Puppy toys by the Defendant acquired from any supplier other than the Plaintiff.

[13] The Plaintiff also initially alleged that the Defendant engaged in secondary copyright infringement through the following:

- A. The Defendant permitted public display of the Poppy Puppy by a third party without the Plaintiff’s knowledge or consent.

- B. The Defendant permitted third party illustrations of the Poppy Puppy without the Plaintiff’s knowledge or consent.

[14] It appears the Plaintiff was referring to a children’s book authored by Deborah L Holme called “Sarah’s Poppy Puppy”, published in 2007. The book contains illustrations of the Poppy Puppy. The book was authored after discussions between Ms. Holme and the Legion about using the Poppy Puppy as a tool to teach children about the importance of Remembrance. For a period, there was a promotion that allowed purchasers of Sarah’s Poppy Puppy to receive a Poppy Puppy toy along with the book.

[15] On March 4, 2022, as part of the written examination for discovery process, the Plaintiff served a list of five questions on the Legion. Questions 2 to 5 related to Sarah's Poppy Puppy.

[16] The Defendant objected to and ignored Questions 2 to 5 on the grounds that they were irrelevant. The Plaintiff brought a motion before Associate Judge Ring to compel the Defendant to provide answers.

[17] In an order dated June 21, 2022, Associate Judge Ring dismissed the Plaintiff's motion, finding the questions to be irrelevant, given the Plaintiff did not allege facts sufficiently specific to Sarah's Poppy Puppy in his Further Amended Statement of Claim. The Plaintiff appealed Associate Judge Ring's order and that appeal was dismissed by Justice Sadrehashemi on November 25, 2022.

[18] The Plaintiff was given the opportunity to amend his Statement of Claim to include allegations relating to Sarah's Poppy Puppy, but declined to do so.

[19] Given that the Court determined that the Plaintiff's Further Amended Statement of Claim lacked sufficient allegations pertaining to Sarah's Poppy Puppy, and that claim remains as the claim before this Court, copyright issues relating to the book are not in issue before the Court.

[20] There is no evidence to support the Plaintiff's claims for copyright infringement.

[21] In addition to the claim for copyright infringement, according to the Plaintiff, he became aware in May 2020 that the Defendant claimed to be the developer of the Poppy Puppy in advertisements promoting the toy in the Legion Supply Catalogue, breaching his moral rights, contrary to subsection 14.1(1) of the *Copyright Act*, RSC, 1985, c C-42 (the “Act”).

[22] The relevant statement in issue appeared in Legion Supply Catalogue from 2004 onwards. It read as follows:

These toys have been developed by the Legion to act as an aid in teaching children about the Poppy and the Poppy’s role in Remembrance

[23] Later versions of the statement refer to the Poppy Puppy toy in the singular stating, “This toy has been developed by the Legion...”, but remain the same otherwise.

III. Issues

- A. *Is the Defendant protected from copyright and moral rights infringement given that the Poppy Puppy is a useful article of which more than fifty have been produced under subsection 64(2) of the Act?*
- B. *Has the Plaintiff commenced this action outside of the limitation period of 3 years provided in section 43.1 of the Act?*
- C. *Has the Defendant infringed the Plaintiff’s moral rights related to the Poppy Puppy?*

IV. Analysis

A. *Is the Defendant protected from copyright and moral rights infringement given that the Poppy Puppy is a useful article of which more than fifty have been produced under subsection 64(2) of the Act?*

[24] The Defendant argues that the deemed non-infringement provisions found in subsection 64(2) of the Act protect it from both the Plaintiff's copyright and moral rights claims.

[25] Subsection 64(2) of the Act reads:

64 (2) Where copyright subsists in a design applied to a useful article or in an artistic work from which the design is derived and, by or under the authority of any person who owns the copyright in Canada or who owns the copyright elsewhere,

(a) the article is reproduced in a quantity of more than fifty, or

(b) where the article is a plate, engraving or cast, the article is

64 (2) Ne constitue pas une violation du droit d'auteur ou des droits moraux sur un dessin appliqué à un objet utilitaire, ou sur une oeuvre artistique dont le dessin est tiré, ni le fait de reproduire ce dessin, ou un dessin qui n'en diffère pas sensiblement, en réalisant l'objet ou toute reproduction graphique ou matérielle de celui-ci, ni le fait d'accomplir avec un objet ainsi réalisé, ou sa reproduction, un acte réservé exclusivement au titulaire du droit, pourvu que l'objet, de par l'autorisation du titulaire — au Canada ou à l'étranger — remplisse l'une des conditions suivantes :

a) être reproduit à plus de cinquante exemplaires;

b) s'agissant d'une planche, d'une gravure ou d'un moule,

used for producing more than fifty useful articles, it shall not thereafter be an infringement of the copyright or the moral rights for anyone

servir à la production de plus de cinquante objets utilitaires.

(c) to reproduce the design of the article or a design not differing substantially from the design of the article by

(i) making the article, or

(ii) making a drawing or other reproduction in any material form of the article, or

(d) to do with an article, drawing or reproduction that is made as described in paragraph (c) anything that the owner of the copyright has the sole right to do with the design or artistic work in which the copyright subsists.

[26] Subsection 64(1) provides helpful definitions for “article”, “design”, “useful article” and “utilitarian function”:

article means any thing that is made by hand, tool or machine; (*objet*)

objet Tout ce qui est réalisé à la main ou à l’aide d’un outil ou d’une machine. (*article*)

design means features of shape, configuration, pattern or ornament and any combination of those features that, in a finished article, appeal to and are judged solely by the eye; (*dessin*)

dessin Caractéristiques ou combinaison de caractéristiques visuelles d’un objet fini, en ce qui touche la configuration, le motif ou les éléments décoratifs. (*design*)

useful article means an article that has a utilitarian

objet utilitaire Objet remplissant une fonction

function and includes a model of any such article; (*objet utilitaire*) utilitaire, y compris tout modèle ou toute maquette de celui-ci. (*useful article*)

utilitarian function, in respect of an article, means a function other than merely serving as a substrate or carrier for artistic or literary matter. (*fonction utilitaire*) **fonction utilitaire** Fonction d'un objet autre que celle de support d'un produit artistique ou littéraire. (*utilitarian function*)

[27] Subsection 64(3) provides a list of exceptions to the application of subsection 64(2).

Relevant to this case are paragraphs 64(3)(a) and (e):

<p>(3) Subsection (2) does not apply in respect of the copyright or the moral rights in an artistic work in so far as the work is used as or for</p>	<p>(3) Le paragraphe (2) ne s'applique pas au droit d'auteur ou aux droits moraux sur une oeuvre artistique dans la mesure où elle est utilisée à l'une ou l'autre des fins suivantes :</p>
<p>(a) a graphic or photographic representation that is applied to the face of an article;</p>	<p>a) représentations graphiques ou photographiques appliquées sur un objet;</p>
<p>...</p>	<p>...</p>
<p>(e) a representation of a real or fictitious being, event or place that is applied to an article as a feature of shape, configuration, pattern or ornament;</p>	<p>e) représentations d'êtres, de lieux ou de scènes réels ou imaginaires pour donner une configuration, un motif ou un élément décoratif à un objet;</p>

[28] The Defendant argues that the Poppy Puppy is a useful article and there have been more than fifty produced, such that there can be no copyright or moral rights infringement.

[29] The Plaintiff argues that the Poppy Puppy is not a useful article as it does not serve a “utilitarian function” and is merely a substrate or carrier for artistic matter. In the alternative, the Plaintiff contends that the exceptions under paragraphs 64(3)(a) and (e) are applicable.

[30] I find that that neither of the subsection 64(3) exceptions are relevant, as the Plaintiff’s copyright subsists in the Poppy Puppy toy as a whole and it has not been used as a “graphic or photographic representation applied to an article” nor as a representation of a real or fictitious being “applied to an article as a feature of shape, configuration, pattern or ornament”.

[31] The Federal Court of Appeal has commented on what it means to be a “useful article” in the context of jewellery:

It is not enough to hold without evidence that because jewellery is worn it is *ipso facto* useful. It is doubtful whether the usefulness of a work of art can be determined solely by its existence; **there must be a practical use in addition to [its] esthetic value.** Some items of jewellery that are worn may be useful whereas others may not be. For example, a tie pin or cuff links may be useful types of jewellery holding clothing together, while other objects such as a brooch or an earring may be purely ornamental and not useful at all, valuable only for their own intrinsic merit as works of art. Further, a sculpture may be created merely to be observed and admired or it may be made to be used as a paper weight.

[Emphasis Added]

(*Pyrrha Design Inc v 623735 Saskatchewan Ltd*, 2004 FCA 423 at para 14)

[32] There is a functional and practical use for the Poppy Puppy; it is a plush toy made to be played with by children.

[33] As well, the exceptions under subsection 64(3) are inapplicable, given that the Plaintiff's copyright subsists in the toy as a whole. The Plaintiff testified to this effect and the 451 Registration relates to the plush toy in its entirety and not of a graphic representation of a Poppy or pattern of Poppies that has been applied to an article. Paragraph 64(3)(a) of the Act is inapplicable.

[34] Paragraph 64(3)(e) is equally inapplicable. In some sense the Poppy Puppy may in and of itself be a fictitious being, however the toy is not a representation of a fictitious being applied to an article, nor is there any evidence that it has been used in this way.

[35] Moreover, even if the Poppy Puppy were construed to be a graphic representation or representation of a fictitious being applied to an article, which I disagree applies, subsection 64(3) would operate only to protect the copyright in the underlying representation and not the article to which it has been applied. As the Court of Appeal of Quebec explained:

Article 64(3) is intended, *inter alia*, to protect the design reproduced on a utilitarian object. For example, if an artist allows a t-shirt manufacturer to reproduce one of his designs, the t-shirts sold in thousands of copies will not be protected by copyright, but the artist's design will be protected and cannot be reproduced on another t-shirt, dress, coat or coffee cup...

[Translated from original French]

(Import-Export René Derhy (Canada) inc c Magasins Greenberg ltée, 2004 CarswellQue 566 at para 50, [2004] JQ No 2705 (QCCA))

[36] As such, I find that the Defendant is protected from the Plaintiff's infringement claims relating to the Poppy Puppy by operation of subsection 64(2) of the Act. This is dispositive of both the Plaintiff's copyright and moral rights claims.

[37] Nonetheless, I will briefly address the applicability of the limitation period and some of the Defendant's arguments relating to the substance of the Plaintiff's moral rights infringement claim.

B. *Has the Plaintiff commenced this action outside of the limitation period of 3 years provided in section 43.1 of the Act?*

[38] The Plaintiff has two species of claims. The first is a copyright infringement claim pertaining to the Defendant's procurement of samples and alleged purchase of Poppy Puppy toys from Ameritech. The second is a moral rights infringement claim pertaining to statements that appeared in the Defendant's Legion Supply Catalogue relating to the authorship of the work.

[39] The Defendant concedes that it procured samples from Ameritech in 2003, but denies that it subsequently made a purchase.

[40] The Defendant also concedes that it stated in the Legion Supply Catalogue that the Legion had developed the Poppy Puppy. This statement originally read, "These toys have been developed by the Legion to act as an aid in teaching children about the Poppy and the Poppy's role in Remembrance". Some variant of this statement appeared in the Legion Supply Catalogue since 2004. The Defendant argues that since this statement appeared in its materials over 15

years ago, the Plaintiff is statute barred from pursuing his moral rights claim by the limitation period under section 43.1 of the Act.

[41] Section 43.1 of the Act provides that an action for copyright and/or moral rights infringement must be commenced within three years of (1) when the infringing act or omission occurred or (2) when a plaintiff first knew of the alleged infringing act or omission or could reasonably have been expected to know:

43.1 (1) Subject to subsection (2), a court may award a remedy for any act or omission that has been done contrary to this Act only if

(a) the proceedings for the act or omission giving rise to a remedy are commenced within three years after it occurred, in the case where the plaintiff knew, or could reasonably have been expected to know, of the act or omission at the time it occurred; or

(b) the proceedings for the act or omission giving rise to a remedy are commenced within three years after the time when the plaintiff first knew of it, or could reasonably have been expected to know of it, in the case where the plaintiff did not know, and could not reasonably have been expected to know, of the act

43.1 (1) Sous réserve du paragraphe (2), le tribunal ne peut accorder de réparations à l'égard d'un fait — acte ou omission — contraire à la présente loi que dans les cas suivants :

a) le demandeur engage une procédure dans les trois ans qui suivent le moment où le fait visé par le recours a eu lieu, s'il avait connaissance du fait au moment où il a eu lieu ou s'il est raisonnable de s'attendre à ce qu'il en ait eu connaissance à ce moment;

b) le demandeur engage une procédure dans les trois ans qui suivent le moment où il a pris connaissance du fait visé par le recours ou le moment où il est raisonnable de s'attendre à ce qu'il en ait pris connaissance, s'il n'en avait pas connaissance au moment où il a eu lieu ou s'il n'est pas raisonnable de s'attendre à ce

or omission at the time it occurred.

qu'il en ait eu connaissance à ce moment.

[42] The Plaintiff claims that he only learned of the moral rights and copyright infringement in May 2020, after observing that the Legion was still selling Poppy Puppy toys 17 years after the initial order of 150,000 units.

[43] The Defendant contests the Plaintiff's claim that he only learned of the infringement in May 2020 and, in any event, argues that the Plaintiff could have been reasonably expected to know of it long before then. The Defendant argues that given this amount of time and the fact that the Plaintiff sold thousands of Poppy Puppy toys to the Legion in or around 2003, he should have reasonably been aware of the statements appearing in the catalogue and on the website.

[44] A plaintiff can reasonably be expected to know about infringing acts or omissions where they can be uncovered through "reasonable diligence" (*Central Trust Co v Rafuse*, 1986 CanLII 29 (SCC) at para 77, [1986] 2 SCR 147; 907687 *Ontario Inc (International Institute of Travel) v 1472359 Ontario Ltd (IBT College of Business Travel & Tourism Technology)*, 2017 FC 969 at paras 44-45).

[45] With respect to the Plaintiff's copyright infringement claim, I find the Plaintiff has commenced his claim outside of the limitation period. The relevant events occurred in 2003 and, while Mr. French may not have had actual knowledge of the alleged infringement until shortly before he commenced his claim, the alleged infringement would have been easily discoverable through reasonable diligence and, in some instances, was readily available online. Mr. French's

testimony revealed that once he began investigating, it was not difficult for him to uncover the alleged acts of infringement.

[46] With respect to the claim for moral rights infringement, the Plaintiff's claim is not statute barred. The limitation period applies only to conduct that occurred more than three years before the action was commenced. In the case of ongoing conduct, where some of the conduct occurred before the limitation period and some within, a plaintiff is not precluded from pursuing claims against conduct that occurred within the limitation period (*Wall v Horn Abbott Ltd*, 2007 NSSC 197 at para 474; *Royal Conservatory of Music v MacIntosh (Novus Via Music Group Inc)*, 2016 FC 929 at paras 89-90).

[47] Here, there is no dispute that the statements continued to appear in the Legion Supply Catalogue within the three years preceding the Plaintiff's Statement of Claim, dated September 22, 2021. The Plaintiff's evidence shows that the statement appeared as recently as in the 2020-2021 edition of the Legion Supply Catalogue.

[48] To conclude, the Plaintiff is prevented by operation of subsection 43.1(1) of the Act from pursuing his copyright infringement claim, as it was discoverable more than three years ago, but was able to pursue his claim for moral rights infringement for the period commencing three years prior to the statement of claim being filed by the Plaintiff, subject to the aforementioned bar to do so under subsection 64(2) of the Act.

C. *Has the Defendant infringed the Plaintiff's moral rights related to the Poppy Puppy under the Act?*

[49] Under subsection 14.1(1) of the Act, a creator of a work is entitled to be credited, if reasonable in the circumstances, or remain anonymous:

<p>14.1 (1) The author of a work has, subject to section 28.2, the right to the integrity of the work and, in connection with an act mentioned in section 3, the right, 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.</p>	<p>14.1 (1) L’auteur d’une oeuvre a le droit, sous réserve de l’article 28.2, à l’intégrité de l’oeuvre et, à l’égard de tout acte mentionné à l’article 3, le droit, compte tenu des usages raisonnables, d’en revendiquer, même sous pseudonyme, la création, ainsi que le droit à l’anonymat.</p>
--	---

[50] Section 28.1 of the Act operates to make any act contrary to an author’s moral rights, without the author’s consent, an infringement of those rights:

<p>28.1 Any act or omission that is contrary to any of the moral rights of the author of a work or of the performer of a performer’s performance is, in the absence of the author’s or performer’s consent, an infringement of those rights.</p>	<p>28.1 Constitue une violation des droits moraux de l’auteur sur son oeuvre ou de l’artiste-interprète sur sa prestation tout fait — acte ou omission — non autorisé et contraire à ceux-ci.</p>
---	--

[51] The Plaintiff argues that the Defendant infringed his moral rights by claiming that the Legion was the creator of the Poppy Puppy. The Plaintiff was content in remaining anonymous, but took offense to the Defendant claiming that it had developed the Poppy Puppy.

[52] There is no dispute that dating back to 2004 the Defendant claimed that “[the Poppy Puppy] toys have been developed by the Legion to act as an aid in teaching children about the

Poppy and the Poppy's role in Remembrance". This phrase or some variation of it appeared in the Legion Supply Catalogue from 2004 to 2021.

[53] The Defendant argues it had no obligation to credit the Plaintiff with creating the Poppy Puppy and it is the Defendant's ordinary practice to not credit creators of works that it sells. Furthermore, the Defendant appended to its Statement of Defense news reports that cast the Plaintiff's character in a negative light. The Defendant appears to rely on these news reports to show that the Legion had reasonable cause to distance itself from the Plaintiff by not crediting him as the creator of the Poppy Puppy.

[54] Given the findings with respect to subsection 64(2) of the Act, it is unnecessary to conclude on the substance of the Plaintiff's moral rights claim. However, the Defendant's inclusion of these news reports is improper, irrelevant and highly prejudicial to the Plaintiff. There is a stark difference between remaining silent as to the authorship of a work and, as the Legion did, falsely claiming authorship of a work. There is no valid basis whatsoever for why the Legion claimed to have developed the Poppy Puppy itself, in place of the Plaintiff, whether the Plaintiff wanted to remain anonymous or not.

V. Conclusion

[55] The action is dismissed. The Defendant is shielded from the Plaintiff's copyright and moral rights infringement actions by operation of subsection 64(2) of the Act.

[56] Both the Defendant and Plaintiff have submitted bills of costs at the mid-level of Column III of Tariff B. Mr. French tells the Court that he is a senior relying on pension income and is self-represented before the Court due to his inability to afford the services of an intellectual property lawyer.

[57] As the successful party, the Defendant is entitled to costs; however, given the Plaintiff's lack of financial means and the improper assertions about the Plaintiff's character, which are irrelevant to the claims in this action and are prejudicial to the Plaintiff, I exercise my discretion to award costs to the Defendant at the lowest level of Column I of Tariff B.

JUDGMENT in T-1441-21

THIS COURT'S JUDGMENT is that:

1. The action is dismissed.
2. Costs to the Defendant assessed in line with the Defendant's Bill of Costs at the lowest level units of Column I of Tariff B.

"Michael D. Manson"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1441-21

STYLE OF CAUSE: LEONARD B FRENCH v THE ROYAL CANADIAN
LEGION (DOMINION COMMAND)

PLACE OF HEARING: VANCOUVER, BRITISH COLUMBIA

DATE OF HEARING: APRIL 12, 2023

JUDGMENT AND REASONS: MANSON J.

DATED: MAY 29, 2023

APPEARANCES:

Leonard B French

FOR THE PLAINTIFF
(ON HIS OWN BEHALF)

Meika Ellis
Timothy C. Bourne

FOR THE DEFENDANT

SOLICITORS OF RECORD:

Ridout & Maybee LLP
Barristers and Solicitors
Ottawa, Ontario

FOR THE DEFENDANT