

Federal Court



Cour fédérale

**Date: 20130911**

**Docket: T-1070-07**

**Citation: 2013 FC 945**

**Ottawa, Ontario, September 11, 2013**

**PRESENT: The Honourable Mr. Justice Rennie**

**BETWEEN:**

**YEHUDA PINTO**

**Plaintiff**

**and**

**BRONFMAN JEWISH EDUCATION CENTRE,  
TOVA SHIMON, SHLOMO SHIMON,  
TAL AMI - TOCHNIT LIMUDIM IVRIT  
MORESHET ISRAEL BE'AM, TAL AM**

**Defendants**

**REASONS FOR JUDGMENT AND JUDGMENT**

## TABLE OF CONTENTS

Overview .....	1
Parties .....	2
Issues .....	3
Evidence .....	3
Tal Sela .....	3
Grade One Pilot.....	5
Grade One Commercial Edition .....	11
Grades Two to Four .....	14
Goof-Li.....	18
Breakdown of Relationship .....	22
Discussion.....	25
Québec Superior Court Judgment.....	25
Credibility .....	26
Copyright Ownership .....	29
Music .....	32
Songs .....	33
Sound Recordings .....	34
Compilation .....	36
Licence, Consent and Revocations .....	38
Limitations .....	41
Defendants .....	45
Statutory Damages .....	46
JUDGMENT .....	52

*Overview*

[1] The plaintiff, Yehuda Pinto, brings this action seeking damages from the Bronfman Jewish Educational Centre, TaL AM, Tova Shimon and Shlomo Shimon for copyright infringement.

[2] This allegation relates to Mr. Pinto's work composing, performing, producing and recording music for TaL AM, a curriculum for teaching Jewish language, religion, culture and history in elementary schools. The TaL AM curriculum, developed by the defendants and others, is a worldwide success, taught in at least 347 schools across Canada, the United States, Europe, South Africa, South America, Australia and Asia.

[3] The parties agreed that Mr. Pinto owns the copyright to his original compositions. However, the defendants argue that Mr. Pinto gave his permission for the use of his music, as part of the contract for his services. The determinative issue is, therefore, consent.

[4] I have concluded that Mr. Pinto did consent to the use of his music, granting an implied licence to the defendants. The defendants have not exceeded the scope of this licence. Therefore, this action is dismissed.

***Parties***

[5] Mr. Pinto immigrated to Canada from Israel in 1987. He began performing at functions such as weddings and bar mitzvahs for the Jewish community and developed a reputation as a talented musician.

[6] Bronfman Jewish Education Centre, previously known as the Jewish Education Council (referred to as BJEC throughout), is a non-profit organization incorporated in Québec. Its mandate is to coordinate, plan and support Jewish education in Montréal. It receives funding from Federation CJA, the central organization for planning and coordinating services and fundraising for Montréal's Jewish community.

[7] The defendants Shlomo Shimon and Tova Shimon are husband and wife.

[8] Mr. Shimon has worked as a high school teacher. His academic background is in Jewish studies and educational technology. Mr. Shimon was BJEC's Chief Executive Officer during the relevant times.

[9] Ms. Shimon was BJEC's Director of Curriculum Development. She was responsible for the development of TaL AM, and its precursor Tal Sela, an educational program to teach the Hebrew language in Jewish day schools. She has worked as a high school teacher and principal and taught for ten years at McGill University's teachers' training program. She has studied philosophy of religion, educational technology and curriculum development.

[10] In October of 2006, TaL AM became a separate legal entity from BJEC. On April 1, 2007, all assets and liabilities relating to the TaL AM curriculum were transferred from BJEC to TaL AM. Ms. Shimon is the President and Executive Director of TaL AM. Mr. Shimon is the Director of Operations.

### *Issues*

[11] This trial raises the following issues:

1. Who owns copyright for the music, the songs, the recordings and the curriculum;
2. Whether Mr. Pinto granted BJEC a licence, and if so, on what terms;
3. Who are the proper defendants; and
4. What is the quantum of damages.

### *Evidence*

#### *Tal Sela*

[12] Along with a team from BJEC, Mr. and Ms. Shimon created Tal Sela, a Hebrew language education curriculum for students in grades 2 to 6 at Jewish schools. In 1979, TaL Sela received government funding, and an endorsement from the Canadian Jewish Congress. This provided the seed money to develop the curriculum.

[13] The music for the curriculum was composed, arranged, performed, produced and recorded by Fran Avni, a music teacher in Montréal. Due to funding limitations, BJEC did not pay Fran Avni an hourly fee for her work. Rather, BJEC agreed to pay her a royalty per cassette sold, originally \$2.75 and then \$3.00. BJEC forwarded her an advance on the future royalties for each

grade she worked on in order to cover production expenses. For example, in 1986 Fran Avni was paid a \$6,500 advance for grade five. This advance was paid back in 2001, at which point she began earning royalties. In 2012, Ms. Avni was paid \$30 in royalties.

[14] Dina Sabbah, a music teacher, also composed some original music. Ms. Sabbah has a PhD in musicology and a Masters degree in education. She had an oral agreement for remuneration, first on a per song basis, and subsequently, based on her time. She had no expectation of receiving royalties.

[15] Ms. Shimon testified that research and development for Tal Sela cost approximately \$600,000. Production cost an additional \$400,000. The government grant was approximately \$207,000. There were other funding sources, such as \$50,000 from the Pincus Foundation, and various private donations. However, these donations and grants were not sufficient to cover Tal Sela's costs. The program "went into the red." Federation CJA acted as Tal Sela's bank and provided a loan. Additionally, Ms. Shimon volunteered her time for a year, without pay.

[16] By 1989, Tal Sela was used in 167 schools across North America, Europe, South Africa and Australia. The sales from the Tal Sela program eventually covered the expenses and all of the debts were repaid. Ms. Shimon explained that they then began saving for the next phase of curriculum development.

***Grade One Pilot***

[17] Tal Sela's success led Mr. and Ms. Shimon to consider a new program, TaL AM, which would go beyond teaching the Hebrew language but also encompass Jewish history, religion and culture in a fully integrated curriculum.

[18] Several BJEK employees were responsible for TaL AM's development. In addition to Mr. and Ms. Shimon, two coordinators, Drorit Farkas and Miriam Cohen were involved.

[19] Ms. Farkas began her involvement with Tal Sela in 1985 as a freelance story writer. Her academic background is in Jewish philosophy and thought, with a concentration in history and special courses for children's literature. She was paid per story and for her time, without any written agreement. She was never paid royalties.

[20] Ms. Cohen has a PhD in science education from the University of Florence in Italy and she has extensive curriculum writing expertise from the University of Tel Aviv. Ms. Cohen testified that TaL AM was "poor" at this stage, and so she was paid only minimum wage.

[21] The TaL AM team began developing grade one for TaL AM in 1990 and by 1992 the team was ready to begin testing of the pilot program in schools which already used TaL Sela.

[22] At this point, TaL AM required a musician to provide the musical component for the program. As Ms. Shimon explained in her testimony, music facilitates memory. It reinforces language patterns and important concepts. Additionally, music acts as a trigger, to remind students

of certain concepts from one year to the next. Finally, music sets the mood, allowing for celebration and joy in the classroom. Music was integral to the curriculum; not in and of itself, but as a means to achieve the pedagogical objectives.

[23] Mr. Pinto first became involved in 1992, when Ms. Cohen invited him to sing Israeli songs at an event for the Tal Sela teachers. At the end of the performance, Ms. Farkas approached him regarding the possibility of him composing music for TaL AM.

[24] The next day, Mr. Pinto met Ms. Shimon who explained the objectives of the Tal Sela curriculum. She explained that Tal Sela was being used in Jewish day schools to teach Hebrew to students in grades two to six. She indicated that the curriculum for grade one, TaL AM, was in the process of being written and would require supporting music.

[25] Mr. Pinto has given inconsistent evidence regarding whether he knew about Tal Sela before meeting with Ms. Farkas and Ms. Shimon. At trial, Mr. Pinto testified that he was previously unfamiliar with the curriculum. However, on cross-examination he was directed to his testimony before the Québec Superior Court on February 22, 2011, at which time he testified that he was aware of Tal Sela because his daughter was learning Hebrew through the curriculum in her grade two class.

[26] There is also some dispute as to whether Ms. Shimon informed Mr. Pinto that Tal Sela was being taught outside of Montréal. Mr. Pinto testified that she stated it was taught in the Montréal



area. Ms. Shimon specifically remembers showing Mr. Pinto a map of the world with pins showing the different countries and schools that were using Tal Sela.

[27] Ms. Shimon also told Mr. Pinto that Ms. Avni had been the composer and producer of the music for Tal Sela. Mr. Pinto testified that he wanted to meet with Ms. Avni to learn why she was not proceeding with TaL AM and the nature of her contract.

[28] Mr. Pinto met with Ms. Avni, who explained that she was not interested in working on TaL AM and had no objection to his involvement. Ms. Avni told Mr. Pinto that she had a written contract. Mr. Pinto testified that he asked Ms. Avni for details of the agreement but that Ms. Avni told him the agreement was “privileged.”

[29] After preparing a sample of his work, Mr. Pinto was retained as a freelancer to compose, arrange, perform, produce and record music for the grade one pilot of TaL AM. The curriculum would require both original compositions and his performance and arrangement of songs written by others including popular traditional songs.

[30] There was no written contract. Accordingly, it is crucial to determine what transpired between Mr. Pinto and Ms. Shimon. These conversations took place in Hebrew, without explicit reference to royalties, copyright or other legal terms. Additionally, more than two decades have now passed since the initial contract negotiations took place.

[31] Ms. Shimon testified that she informed Mr. Pinto that all artists who contributed to the curriculum would work on a freelance basis and would be paid for their services in accordance with a fee schedule. Mr. Pinto was to be paid \$30 per hour to compose, arrange, produce and record music. The finished product would belong to BJEC as its “gift to the Jewish people” and there would be no additional payments. Ms. Shimon insists that she emphasized that all “rights” would be with TaL AM, consistent with her discussions with all TaL AM freelancers, including graphic designers and illustrators. Avi Katz, an Israeli illustrator, testified that he worked for TaL AM on this basis.

[32] Ms. Shimon testified that revenues were to be saved for the next phase of curriculum development. Curriculum has longevity of about seven to ten years. After that, it must be updated to what is relevant for the next generation. Therefore, she considered it essential that TaL AM have seed money and generate funds for subsequent stages. She did not wish to repeat the funding difficulties experienced with Tal Sela.

[33] Mr. Pinto recalled requesting a written contract, and expressing the desire to retain his “rights.” He testified that the first thing he mentioned to Ms. Shimon was copyright ownership. He recalls her saying that “they are in the red.” He claims to have replied “come to me with [a] written agreement and I would be delighted to work with you.”

[34] In the meantime, Mr. Pinto stated that he agreed to work in accordance with the tariff or fee schedule that Ms. Shimon offered. He testified, “Tova Shimon offered to pay me until she gets

back to me with [an] agreement.” He agreed that the rate of \$30 per hour included composing, producing, arrangement and studio work.

[35] Ms. Shimon did not recall any mention of a written agreement. She denied agreeing to provide him with one as none of the freelancers retained for TaL AM had written contracts. Ms. Shimon insists that she was clear that no freelancer would receive additional payments beyond what was invoiced and that “everything belongs to TaL AM and nothing will be paid beyond that payment that he gets. What he invoices for, that’s what he gets.”

[36] Mr. Pinto did not raise the issue of royalties at this time, as he did not yet know about the concept.

[37] The work process, insofar as it relates to Mr. Pinto, then proceeded as follows:

- a) Mr. Pinto was given lyrics connected to a concept or lesson in the curriculum. Some of these lyrics were accompanied by music, either popular songs or songs written by other composers who had worked with the program. Ms. Shimon, Ms. Cohen and Ms. Farkas would discuss with him the mood, tone and function of the song, namely how it connected to the lessons. The BJEC Curriculum Department wrote the lyrics for 58 of the songs in question.
- b) For the texts with music, Mr. Pinto would arrange the melody to suit the texts.
- c) For the texts with no music, Mr. Pinto would create a composition. Ms. Shimon testified that Ms. Sabbah assisted Mr. Pinto as a music consultant. Ms. Sabbah

confirmed this in her testimony. However, Mr. Pinto does not recall meeting Ms. Sabbah during this time and denies that she assisted him with the compositions.

- d) After composing or arranging the music, Mr. Pinto would meet with Ms. Shimon, Ms. Cohen and Ms. Farkas. Ms. Shimon and Ms. Cohen explained that they would listen to Mr. Pinto perform his work on the guitar in their office. In some cases, they would suggest changes or adapt the lyrics of the songs to better fit the music. Ms. Cohen testified that it was collaborative. They would sing with him, to see if the tempo was appropriate or if the pitch was too high or low for the children.
- e) Mr. Pinto recorded the songs at a studio located within the Federation CJA building. A female teacher also sang for some recordings, and Mr. Pinto paid her.
- f) Henry Beagal, the studio technician, mixed the recordings and then provided BJEJ with cassettes.

[38] In 1992 and 1993, the pilot was tested in twelve schools located in Montréal, New York City, Los Angeles, Atlanta, Chicago and Seattle, according to the testimony of Ms. Shimon and Ms. Farkas.

[39] Two teachers, Tovi Varga and Sharon Cohen, explained that, during the pilot phase, the teachers were given student workbooks, large books, library books, flashcards, posters and music. Sharon Cohen explained that the components are all integrated through visual consistency, repetition and key words. As the teacher guided the students through their workbooks, the songs reinforced the lesson.

[40] The teachers then attended sessions with TaL AM to provide feedback and view videos of the actual classroom instruction. Mr. Pinto was not provided with the videotapes as the participating schools requested that no copies be made. In his testimony, Mr. Pinto stated that he was “denied categorically” from accessing the feedback and videos. However, Ms. Shimon testified that Mr. Pinto was invited to attend and hear the feedback.

***Grade One Commercial Edition***

[41] From 1993 to 1995 there was no work for Mr. Pinto as the TaL AM team prepared for the full launch of the grade one program. Mr. Pinto performed occasionally at seminars for the teachers running the pilot testing. The TaL AM team also engaged him for private functions. For example, he performed at Ms. Cohen’s son’s bar mitzvah. She prepared a book with his songs, picture and phone number to promote his work.

[42] In 1995, TaL AM approached Mr. Pinto to arrange, perform, produce and record music for the final edition (also called the commercial edition) of the grade one program.

[43] Ms. Cohen provided Mr. Pinto with final versions of the music and they worked together on pre-production between the spring of 1995 and early 1997. Mr. Pinto’s invoices demonstrate that he and Ms. Cohen spent a substantial amount of time before recording, during which he received the repertoire and they determined the “geograph[y]” of the compositions. This collaborative process is described, for example, on invoice 49022, dated August 14, 1995.

[44] Once it came time to record, Mr. Pinto selected an external studio, that of Elan Kunin. He paid Mr. Kunin \$10.00 per hour for use of the studio, including access to the equipment and Mr. Kunin's keyboard accompaniment. Mr. Pinto also hired a female teacher as a vocalist, and paid her \$10.00 per hour. He selected children to sing and rehearsed the songs with them. The various components were then mixed together at Mr. Kunin's studio onto analog chrome cassettes, which Mr. Pinto provided to Ms. Cohen or others at BJEC.

[45] Henry Biegel, the BJEC studio technician, added additional sounds or music components needed for the curriculum, such as prayers or Biblical verses read by a Rabbi, Mr. Lanton. Mr. Biegel then reproduced the final product on audiocassettes which BJEC sold to schools.

[46] As before, during the commercial production phases, Mr. Pinto was paid an hourly rate for his services. From this he paid the charges of studio time while he was recording and the female vocalist's fee. He also invoiced BJEC for certain expenses. For example, invoice number 49020 dated May 23, 1995 includes a charge of \$25.05 for two Digital Audio Tape (DAT) cassettes.

[47] Mr. Pinto testified that he raised the issue of copyright and his desire to be paid additional money several times in 1995. He says that he was always told that BJEC was "in the red" but that they would get back to him in writing at a later date.

[48] Between April 28, 1995 and July 28, 1997, Mr. Pinto invoiced and was paid \$34,941.51 for his services.

[49] Once the commercial production phase of grade one was completed, in December of 1997, BJEC gave Mr. Pinto a “bonus” of \$100 for each of his 14 compositions which would be used in the final grade one curriculum. Mr. Pinto’s payment for the pilot compositions had been relatively low and BJEC wished to provide him with additional compensation. Ms. Cohen explained that, at the pilot stage, TaL AM had few financial resources. By this point, however, there was more money. The possibility of this bonus had been discussed in or around 1995 as the pilot testing proved to be successful. It was also anticipated that, going forward, Mr. Pinto would not have work from TaL AM for some time.

[50] Mr. Pinto was given a cheque for \$1400 at a meeting with Ms. Cohen. There is no evidence that copyright or royalties were discussed at this meeting. Mr. Pinto took contemporaneous notes, which indicate that Ms. Cohen suggested that, given that his work had come to an end, he meet with principals and teachers from schools who taught the curriculum to secure performance engagements at those schools.

[51] Mr. Pinto testified that later in 1997, Mr. Shimon asked him to provide the DAT cassettes (the master tapes) for the grade one curriculum, which he did. Mr. Pinto’s invoice no. 49049 dated July 28, 1997 contains a charge for duplication of the master cassettes.

[52] Ms. Cohen’s testimony on this point is different. She testified that in 2002, the schools wanted the music on CDs, rather than cassettes. Therefore, she asked Mr. Pinto for the master tapes so that TaL AM could convert the music to CDs. She states that Mr. Pinto requested payment for the master tapes, and that she paid him by cheque on BJEC’s behalf. She did not remember how

much he was paid and could not produce an invoice or cheque confirming this payment and the date.

[53] The TaL AM materials for grade one, in particular the audiocassettes, workbooks and guide readers contain the statement that BJEC owns the copyright.

### ***Grades Two to Four***

[54] Mr. Pinto did not provide services for TaL AM between 1997 and 2002. However, he performed at schools offering the TaL AM curriculum, at teachers' seminars and at private events hosted by members of the TaL AM team.

[55] During these years, TaL AM began development of the grade two pilot, financed by the sales from the grade one program. BJEC also secured additional grants and donations. Most significantly, in 2000 BJEC began receiving grants from the AVI CHAI Foundation, in exchange for offering a 33% discount on the price of materials to be purchased at schools.

[56] During this five year *hiatus* Mr. Pinto periodically contacted members of the team to ask whether there was any work for him. In the spring of 2002, Ms. Farkas contacted him to compose music for the grades two and three pilots.

[57] Mr. Pinto testified that he again raised the issue of copyright and his desire for a written agreement. He stated that Ms. Shimon indicated that she would get back to him regarding a written agreement. As before, Ms. Shimon denies this.



[58] It is Ms. Shimon's testimony that the terms and conditions remained as before, except that Mr. Pinto's fee schedule had increased. Mr. Pinto was again to be paid an hourly rate for his services and expenses and a \$400 flat rate per composition.

[59] The rate of pay between July 2002 and July 2003 was \$35 per hour for arrangement of music, \$45 per hour for studio time, \$50 per session for text and song presentation sessions and \$25 or \$45 per track for singing.

[60] Between August 2003 and 2004, Mr. Pinto invoiced higher amounts: \$40 per hour for arrangement of music, \$50 per hour for studio time, \$55 per session for text and song presentation sessions, \$55 per track for singing, \$450 per song for composition and \$200 for performances.

[61] Between April and November 2004, Mr. Pinto invoiced: \$55 per hour for directing, rehearsals, presentations, meetings and workshops, \$25 per hour for office work, \$35 per hour for arrangement of music, \$55 per hour for studio time, \$105 per track for singing and \$450 per composition.

[62] Mr. Pinto's rates again increased in December 2004: \$55 per hour for arrangement of music, \$90 per hour for studio time and music production and \$110 per track for singing.

[63] BJEC paid every invoice as submitted. Between July 11, 2002 and June 6, 2006, Mr. Pinto invoiced and was paid \$299,562.25 for his services and expenses.

[64] Mr. Pinto testified that throughout 2002 to 2006 he would raise the issue of copyright ownership, a written agreement, and the payment of additional compensation. To a certain extent, this is corroborated by the testimony of other witnesses. Ms. Shimon recalls Mr. Pinto first speaking to her about copyright in 2002 and she states that she consistently told him that TaL AM would own the work.

[65] Ms. Cohen confirmed that Mr. Pinto asked her about copyright and compensation. Specifically, he would ask, “[w]hat about my rights?” Ms. Cohen responded by referring him to Ms. Shimon. She recalled saying, “Yehuda, listen, I don’t have rights. Tova doesn’t have rights. Drorit doesn’t have rights. Nobody has rights. The copyrights are [...] TaL AM. There is nothing to say.”

[66] Ms. Farkas agreed that Mr. Pinto often requested additional money, but that he did not raise copyright ownership specifically.

[67] Mr. Shimon recalls speaking with Mr. Pinto regarding copyright and additional compensation, and states that he always confirmed that there would be no additional compensation beyond what was invoiced. No witness other than Mr. Pinto recalled him asking specifically for a written agreement.

[68] The creative process for grades two to four was similar to that for grade one. Again, Ms. Farkas, Ms. Cohen or Ms. Shimon provided Mr. Pinto with the curriculum content in the form of

lyrics to compliment and reinforce the lessons contained in the curriculum. Ms. Farkas and Ms. Cohen described the desired theme and mood, the “colour” and “geography” of the song. Mr. Pinto composed the music and presented it to Ms. Shimon, Ms. Cohen and Ms. Farkas. Ms. Farkas offered her guidance regarding what would be agreeable to the TaL AM team.

[69] Once the compositions were settled, Mr. Pinto arranged, performed, produced and recorded the songs at a studio he selected. Mr. Pinto also edited certain songs from grade one to be included in the grade two curriculum. In the same way, he edited songs from grades one and two to be used in grade three. At the direction of the curriculum developers, songs were repeated year to year, as a memory-trigger for the children moving from one grade to the next.

[70] For the pilot version of grade two, Mr. Pinto used the music studio of Alexander Ivanov. For the final version of grade two he used the music studio of Lahit Barosh. He paid for the use of each studio and Mr. Barosh charged between \$20 and \$27 per hour.

[71] Mr. Pinto then provided BJEC with a master CD containing the music he had recorded. The final product included CDs for grades two and three which contain the statement that BJEC owns copyright.

[72] Mr. Pinto began work on grade three in 2003. The process for grade three was the same as the process for grade two.

[73] At times, Ms. Shimon would write Mr. Pinto a personal cheque because BJEC required time to process an invoice and Mr. Pinto wished to be paid on a “rush” basis. For example, Ms. Shimon wrote Mr. Pinto a personal cheque on August 4, 2002 to pay an invoice dated July 28, 2002. Mr. Shimon also assisted Mr. Pinto by guaranteeing a loan of \$7,000 in 2006. Mr. Shimon had to pay \$800 for this loan because Mr. Pinto did not repay all of it.

[74] Mr. Pinto testified that in late 2003 he received the collection of CDs for grade one, along with the pilots for grades two and three. He testified that in his view TaL AM “tampered” with his music, in transferring it from cassette to CD.

[75] In 2005, he was asked to begin work for the pilot version of grade four. He submitted a pilot, but had no further involvement in the grade four curriculum. None of his new compositions were included in grade four, though grade four did include some of his earlier compositions for grades one to three.

[76] During this time, Mr. Pinto attended seminars for teachers offering the curriculum. These teachers came from schools in Canada, the United States, France, Switzerland and Israel.

### ***Goof-Li***

[77] Dr. Goof-Li is a character who appears in grade two of TaL AM to teach healthy nutrition to students as part of a module on daily living. He had also previously appeared in TaL Sela’s, “Bon Appetite” unit. His character appears in a play for the children to perform, including various songs

to teach the material. Ms. Varga, a teacher, testified that the Dr. Goof-Li play is integrated into the grade two program. She explained that grade three also has plays.

[78] Mr. Pinto composed music to accompany the lyrics for this play, beginning in the summer of 2005. Invoice number 30832, dated August 16, 2005, indicates that he received the concept of the play during a meeting with Ms. Cohen on July 26, 2005. Ms. Farkas explained that she presented the work to Mr. Pinto in the same manner as the other songs and that she worked closely with him to provide comments and feedback.

[79] Mr. Pinto describes Dr. Goof-Li as being a separate work product, apart from the grade two curriculum. However, the exhibits and testimony of Ms. Shimon, Ms. Varga and Ms Farkas establish that Dr. Goof-Li was integrated into the curriculum, as were other plays.

[80] Invoice 30833 indicates that Mr. Pinto produced the music for “Dr. Guff [*sic*] Li” over eight hours on September 21, 2005. He charged \$90 per hour for this work. He invoiced seven hours of work, at a rate of \$55 per hour, for a January 19, 2006 meeting with Ms. Farkas. The meeting involved several topics, including Mr. Pinto’s presentation of Dr. Goof-Li.

[81] Mr. Pinto testified that on January 23, 2006, Ms. Farkas called him to request his completed work on Dr. Goof-Li on an urgent basis, as Ms. Shimon required it for a seminar in Los Angeles. That evening, Mr. Pinto delivered the CD to Ms. Farkas at the BJEC office in Montréal.

[82] What transpired during the evening of January 23, 2006 is highly contested. In the Agreed Statement of Facts and Admissions, the parties agree that the CD he provided was “for those portions of the ‘Dr. Goof Li’ play which BJEC indicated were to be incorporated into the workbook.” On delivery of the CD, Mr. Pinto states that he informed Ms. Farkas that he owned copyright to the music for Dr. Goof-Li and requested a meeting with Ms. Shimon as soon as she returned from Los Angeles. He also testified that the CD he provided contained an inscription asserting his copyright.

[83] Mr. Pinto testified that he made three identical copies of this CD. The first he gave to Ms. Farkas and it is now lost. The second and third, he kept. He tendered as evidence one CD, said to be one of the two he kept for himself.

[84] Ms. Farkas denies that Mr. Pinto raised the issue of copyright on this date and states that there was “no way” that the CD he provided her had a copyright inscription. She said “had I seen this [referring to the CD that Mr. Pinto put into evidence], I would have been at Shlomo’s in the same minute.” On cross-examination, she repeated “[n]o, I can tell you categorically this is not the CD I received in my hands because it could not have had that. Had I seen that, I would have stopped it. So categorically, no. This is not what I got.”

[85] Ms. Shimon confirmed that she did not see any assertion of copyright on the CD she received in Los Angeles. This CD has not been located.

[86] That evening, Ms. Farkas asked Ami Brandes to make a reproduction of the CD which she then sent by courier to Ms. Shimon in Los Angeles. Ms. Farkas does not remember what happened to the original CD. It is impossible to confirm, by direct evidence, exactly what, if anything, Mr. Pinto wrote on it.

[87] The next day, January 24, 2006, Mr. Pinto met with Mr. Shimon and played the Dr. Goof-Li CD. Mr. Pinto testified that he told Mr. Shimon that he owned copyright to this music and showed him the copyright notation. He states that he informed Mr. Shimon that he was providing the Dr. Goof-Li music for the purpose of the Los Angeles seminar only. Mr. Pinto claims that he advised Mr. Shimon that there was to be no reproduction of this music until the issue of copyright was resolved. Mr. Pinto recalls Mr. Shimon stating that BJEC owned the music because they were paying him to compose it, but that he could speak with Ms. Shimon about the subject when she returned from Los Angeles. Mr. Pinto also remembered Mr. Shimon telling him that Fran Avni had been paid \$8.00 per cassette for her work on the Tal Sela project.

[88] Mr. Shimon does not remember Mr. Pinto raising the issue of copyright at this meeting.

[89] Mr. Pinto met briefly with Ms. Shimon on February 6, 2006 and then again on February 9, 2006. He remembers Ms. Shimon telling him that he would not be paid royalties in respect of Dr. Goof-Li and that BJEC owned the copyright. Mr. Pinto recalls replying that BJEC could not use his music for Dr. Goof-Li beyond the Los Angeles seminar.

[90] During this meeting, Ms. Shimon advised Mr. Pinto that she considered a recent invoice to be “outrageously high” (invoice no 30836 dated January 22, 2006 in the amount of \$18,237.21). While Ms. Shimon arranged for BJEC to pay the invoice, she required him to sign a letter acknowledging that BJEC would review all of his invoices for excessive charges.

[91] Mr. Pinto testified that the meeting concluded with Ms. Shimon’s promise that she would get back to him within two weeks with an agreement for the work conditions. Ms. Shimon denies this.

[92] In February or March of 2006, Ms. Farkas asked Mr. Pinto to provide her with a Dr. Goof-Li CD containing the voices of the children. Mr. Pinto did so. He had no further involvement in the Dr. Goof-Li music.

[93] The grade two TaL AM curriculum includes CD 2S-C2. Tracks 17-36 of this CD are Dr. Goof-Li’s interactions with the different food groups and the singing of the children from the CD Mr. Pinto provided. Mr. Pinto testified that school children have performed the Dr. Goof-Li play. He states that he never authorized BJEC or TaL AM to allow this.

### ***Breakdown of Relationship***

[94] The parties ended their relationship in July of 2006.

[95] From March 6, 2006 onwards, Mr. Pinto began including hidden or concealed text in his invoices regarding copyright. Mr. Pinto submitted his invoices electronically, and each expense



was written in black font on the white background of the invoice. The hidden text, however, was written in white font, on the white background, rendering it invisible unless highlighted by the cursor on the screen. Among other things, the annotations stated that “[a]ll of my invoices in the past including this invoice are for my music production and studio services only.”

[96] On June 5, 2006, Mr. Pinto requested an advance of \$20,000 to help him pay for his daughter’s wedding, which was taking place on June 21, 2006. He made this request to Ms. Farkas, asking that she convey it to Ms. Shimon. The next day, he met with Mr. Shimon and again requested the advance. After some discussion, Mr. Shimon stated that BJEC might be able to advance \$12,000 but that the rest of the money would be retained to defray studio expenses. Mr. Shimon stated that he would have to consult with other individuals at BJEC.

[97] The next day Mr. Shimon wrote Mr. Pinto a cheque for \$2,000, as a personal loan. Mr. Pinto has not repaid it.

[98] Then, sometime in early June, a BJEC employee discovered the hidden annotations on an invoice by chance. This employee notified Ms. Farkas who informed Ms. Shimon. Ms. Shimon was distressed to learn that BJEC had paid invoices which contained these annotations. Ms. Shimon and Ms. Farkas were concerned that BJEC would be taken to have consented to those terms. They also considered the inclusion of the concealed text to be a breach of trust, requiring immediate attention. In Ms. Farkas’ words, “this was such a betrayal ... we worked very closely so why would he go behind my back? So I was very upset.”

[99] On June 13, 2006, Mr. Shimon telephoned Mr. Pinto stating that he had the \$12,000 advance cheque. They met on June 14, 2006, and Mr. Shimon asked Mr. Pinto to sign a letter acknowledging that BJEC owned the copyright in the music which Mr. Pinto had composed: “All work that you do that is paid for by TaL AM in order to produce a master tape including compositions, arrangement, performance, recording or any other additional related work is the property of TaL AM.”

[100] Mr. Pinto refused to sign this. Mr. Shimon then presented him with a second letter, stating that Mr. Pinto’s services would be terminated unless he signed the copyright acknowledgement. The meeting concluded immediately.

[101] After that date, Mr. Pinto telephoned Mr. Shimon in an attempt to resolve the issue. Mr. Shimon simply told him to sign the letter. The two men finally met on July 4, 2006, and Mr. Pinto prepared a letter summarizing the events to date, as he saw them:

To this day you turned TaLAM to be commercial, you are advertising the product, you promote the sales of the product through seminars in Canada and around the world. You never asked my written authorization and acted as if my music is yours. My request for money advance was not granted and, you did to discontinue my services immediately, while you keep using my music on a commercial basis, which is not the first instance idea where I was used to produce my music for educational purpose.

[102] At this meeting, Mr. Shimon proposed the creation of a “best of” CD for Mr. Pinto’s music, with Mr. Pinto receiving royalties from the sale. Mr. Shimon stated he would discuss this possibility with Ms. Shimon and others at BJEC.

[103] Mr. Pinto prepared a second letter summarizing that meeting which he sent to Mr. Shimon. This letter records a discussion that the CD would be sold for \$15.00 US and that Mr. Pinto would receive \$3.00 US per CD sold. The letter confirms that Mr. Shimon stated that he would have to consult with others at TaL AM.

[104] On July 18, 2006, Mr. Pinto received a telephone call from Mr. Shimon's secretary who advised that she was sending him a letter that he should read carefully. She advised him to consult a lawyer and, if he found the letter acceptable, to sign and return it. The letter contained an assignment to BJEC of his copyright interests. It also contained TaL AM's offer to pay Mr. Pinto 10% of the gross sales revenues of the TaL AM Anthologies, without any admission of copyright infringement.

[105] Mr. Pinto declined to sign this letter and instead retained counsel. His counsel sent a letter on July 27, 2006 alleging that BJEC had engaged in "illegal duplication and distribution" of the music he had composed for the TaL AM curriculum.

[106] Mr. Pinto subsequently commenced this action.

### ***Discussion***

#### ***Québec Superior Court Judgment***

[107] There has been previous litigation between the parties, *Pinto c Bronfman Jewish Education Center*, 2011 QCCS 3458, regarding Mr. Pinto's allegation that the defendants unlawfully

terminated the contract for services. The Québec Superior Court dismissed Mr. Pinto's action, and an appeal from that decision is pending.

[108] The defendants urge this Court to adopt the findings of the Québec Superior Court and submit that Mr. Pinto is attempting to collaterally attack that judgment. However, the Québec Superior Court could not address the issue of copyright ownership or infringement. Accordingly, its findings are only indirectly related and not binding on this Court. Similarly, this Court is obligated to reach its own, independent conclusion regarding credibility and key findings of fact. Fairness demands such, and for this reason, the findings of the Québec Superior Court have not been considered.

### *Credibility*

[109] There are inconsistencies between the testimonies of key witnesses. Some of this may be attributed to the difficulties inherent in recalling conversations which took place many years prior, and in Hebrew. However, even allowing for these challenges, the testimony of Mr. Pinto is problematic.

[110] In assessing credibility, the Court has considered the demeanour of each witness, firmness of memory, motive to lie, whether the testimony harmonizes with independent evidence, including the exhibits, and whether the testimony seems reasonable.

[111] Mr. Pinto's evidence has been inconsistent and he has a tendency to exaggerate or minimize evidence when it suits his interests.

[112] For example, at this trial, he stated he had no knowledge of Tal Sela prior to meeting with Ms. Farkas and Ms. Shimon. However, during the Québec Superior Court trial he stated that he knew about Tal Sela because his daughter studied the curriculum in school.

[113] Mr. Pinto recalls being told that Ms. Avni was paid \$8.00 in royalties for each cassette sold. Her royalty payments were less than half of this amount. I consider this an example of his tendency to exaggerate. Mr. Shimon testified that he could not have told Mr. Pinto that Ms. Avni received a royalty of \$8.00, because those cassettes were only sold for \$9.00 each. “[I]t’s absolutely ludicrous to even consider to pay an amount of \$8.00 to Mrs. Avni for the cassette” said Mr. Shimon.

[114] Mr. Pinto also minimized the degree of input Ms. Cohen, Ms. Farkas and Ms. Shimon had in the creative process. He testified that he would pick up the texts for the song, and then work in the studio. However, the invoices demonstrated that he spent substantial amounts of time with these women, and that the overall direction, focus and purpose of the music, as an aid to the teaching objectives, was under their direction. On cross-examination Mr. Pinto insisted that much of that time was waiting while Ms. Cohen made photocopies and other tasks. I accept the testimony of Ms. Cohen, Ms. Farkas and Ms. Shimon that the parties collaborated in the creative process, and that there was a considerable degree of back and forth.

[115] Mr. Pinto testified that he used the term “copyright” in his discussion with Ms. Shimon in 1992. However, Ms. Shimon explained that they spoke about the concept of “zkhuyot” which

translates to “rights.” Ms. Shimon testified that the term for “copyright” is “zkhuyot yotzrim,” which was never discussed.

[116] I also note that Mr. Pinto’s invoices did not mention an explicit charge for composition after March of 2004, though the parties’ expectation remained that he would charge and be paid for his work composing music. It appears that this may have been an underhanded attempt to reserve the composition rights to himself.

[117] Perhaps most significantly, Mr. Pinto’s conduct in concealing annotations on his invoices demonstrates a lack of trustworthiness.

[118] Ms. Shimon presented as an even-handed and fair witness. She was complimentary towards Mr. Pinto, stating that “he had a gift” and that she loved his work. Both she and Mr. Shimon were candid when their memory failed them. Although they had the opportunity to collude with regards to their testimony, they each provided an independent and unique perspective on the events. Their evidence did not appear scripted or designed to be corroborative. I consider their testimony reliable.

[119] Ms. Farkas and Ms. Cohen also testified in a straightforward manner, without embellishment. Each spoke highly of Mr. Pinto’s work and demonstrated no animosity towards him. I consider their evidence reliable as well.

[120] I also find that the Dr. Goof-Li CD Mr. Pinto provided to Ms. Farkas was not labelled with his assertion of copyright. There is no independent evidence to corroborate Mr. Pinto’s testimony

that the CD he placed into evidence is identical to that provided to Ms. Farkas. I find that had Ms. Farkas, Ms. Shimon, or Mr. Shimon been aware that Mr. Pinto claimed copyright over the Dr. Goof-Li music, there would have been an immediate discussion between the parties, as there eventually was with regards to the hidden annotations. As Ms. Farkas testified, if Mr. Pinto had asserted copyright with Dr. Goof-Li, “then the whole thing that we would have -- that we had in June would have happened in January.” Mr. Shimon confirmed this, “I would have immediately acted upon that.”

[121] The evidence given by Mr. Pinto that the annotation was written on all three copies of the CD is also inconsistent with the parties’ continued working relationship. Although Ms. Farkas found his invoice of January 22 “outrageously high”, she nevertheless paid it. Mr. Shimon also made efforts to assist Mr. Pinto in meeting the costs of his daughter’s wedding, including an advance and a personal loan. Further, Mr. Shimon proposed the production of a CD containing Mr. Pinto’s most popular works, which would generate royalties for Mr. Pinto.

### ***Copyright Ownership***

[122] The purpose of Canadian copyright law is to balance the public interest in dissemination of a work with preserving the just reward for the creator. Creators’ rights must be recognized with “due weight to their limited nature”: *Théberge v Galerie d'Art du Petit Champlain inc*, 2002 SCC 34 at paras 30-31, [2002] 2 SCR 336; *Entertainment Software Association v Society of Composers, Authors and Music Publishers of Canada*, 2012 SCC 34 at para 7, [2012] 2 SCR 231.

[123] Copyright infringement is defined in subsection 27(1) of the *Copyright Act*, RSC 1985, c C-42:

27. (1) It is an infringement of copyright for any person to do, without the consent of the owner of the copyright, anything that by this Act only the owner of the copyright has the right to do.

27. (1) Constitue une violation du droit d'auteur l'accomplissement, sans le consentement du titulaire de ce droit, d'un acte qu'en vertu de la présente loi seul ce titulaire a la faculté d'accomplir.

[124] Section 3 sets out the rights of the copyright owner. Those rights which are most relevant to this trial include:

3. (1) For the purposes of this Act, "copyright", in relation to a work, means the sole right to produce or reproduce the work or any substantial part thereof in any material form whatever, to perform the work or any substantial part thereof in public or, if the work is unpublished, to publish the work or any substantial part thereof, and includes the sole right

3. (1) Le droit d'auteur sur l'œuvre comporte le droit exclusif de produire ou reproduire la totalité ou une partie importante de l'œuvre, sous une forme matérielle quelconque, d'en exécuter ou d'en représenter la totalité ou une partie importante en public et, si l'œuvre n'est pas publiée, d'en publier la totalité ou une partie importante; ce droit comporte, en outre, le droit exclusif :

(a) to produce, reproduce, perform or publish any translation of the work,

a) de produire, reproduire, représenter ou publier une traduction de l'œuvre;

...

...

(d) in the case of a literary, dramatic or musical work, to make any sound recording, cinematograph film or other contrivance by means of which the work may be mechanically reproduced or performed,

d) s'il s'agit d'une œuvre littéraire, dramatique ou musicale, d'en faire un enregistrement sonore, film cinématographique ou autre support, à l'aide desquels l'œuvre peut être reproduite, représentée ou exécutée mécaniquement;

...

...

(i) in the case of a musical work, to rent out a sound recording in which the work is embodied, and

i) s'il s'agit d'une œuvre musicale, d'en louer tout enregistrement sonore;



...

and to authorize any such acts.

...

Est inclus dans la présente  
définition le droit exclusif  
d'autoriser ces actes.

[125] Therefore, it is necessary to first establish which party owns copyright.

[126] As a preliminary issue, I have considered the Certificates of Copyright Registration (nos. 1049691 and 1049692 issued on July 4, 2007) which list Mr. Pinto as the owner of “MY MUSIC COMPOSITIONS AND SINGING ONLY ON TaLAM COLLECTION Grade One to Four. Except Mrs. Fran Avni’s music on this collection.’ (NOT ON THE TEXT)” and “MY MUSIC COMPOSITIONS AND SINGING ONLY ON Dr. GOOF-LI COLLECTION.’ (NOT ON THE TEXT).”

[127] A valid certificate of registration constitutes *prima facie* proof of ownership: Roger T Hughes & Susan J Peacock with the collaboration of Neal Armstrong, *Hughes on Copyright & Industrial Design*, loose-leaf 2d ed (Markham, Ontario: LexisNexis, 2005), ch 59 at 422-23.

[128] The defendants assert that the registration is invalid because paragraph 5(1)(a) of the *Copyright Regulations*, SOR/97-457, provides that a registration may deal with one work only. Mr. Pinto has attempted to register multiple works within each certificate.

[129] Dr. Goof-Li could arguably be considered one work. However, in my view, it is unnecessary to resolve this issue. The certificates create only a presumption of ownership. As the

certificates were registered after Mr. Pinto began these proceedings, the presumption has less weight: *CCH Canadian Ltd v Law Society of Upper Canada*, 2002 FCA 187 at para 63. In any event, in this case, there is substantial additional evidence regarding copyright ownership, all of which pre-dates registration. As will be discussed below, this evidence rebuts any presumption created by registration, assuming that registration is valid.

[130] There are multiple layers of copyright for the TaL AM music, songs, recordings and curriculum overall. Each of these constitutes separate works for the purpose of copyright and will be considered in turn.

### *Music*

[131] Mr. Pinto is the owner of the copyright to the 58 compositions he created for TaL AM, in accordance with subsection 13(1) of the *Act*:

13(1) Subject to this Act, the author of a work shall be the first owner of the copyright therein.

13(1) Sous réserve des autres dispositions de la présente loi, l'auteur d'une œuvre est le premier titulaire du droit d'auteur sur cette œuvre.

[132] Subsection 13(3) provides an exception for works created in the course of an employment contract. As the defendants acknowledge, this is inapplicable to Mr. Pinto, who worked as a freelance contractor, rather than as an employee.

[133] Subsection 13(4) provides that the owner of the copyright may assign the copyright, and that any assignment must be in writing. The defendants also acknowledge that this subsection is

inapplicable. Mr. Pinto did not assign to BJEC the ownership of the copyright as there was no written agreement.

[134] Accordingly, the defendants accept that Mr. Pinto owns the copyright to the music he composed for TaL AM. Mr. Pinto composed 14 original works for grade one, 28 for grade two and 16 for grade three. He owns the copyright to these 58 compositions.

[135] As a result, BJEC required his consent, a licence, to use his music for TaL AM, including producing a sound recording and incorporating the music into the curriculum.

### *Songs*

[136] While Mr. Pinto owns the copyright to his original music, BJEC and Mr. Pinto jointly own copyright to the TaL AM songs, the music combined with the lyrics.

[137] Section 2 of the *Act* contains the following definition:

“work of joint authorship”	«œuvre créée en collaboration»
means a work produced by the	Œuvre exécutée par la
collaboration of two or more	collaboration de deux ou
authors in which the	plusieurs auteurs, et dans
contribution of one author is not	laquelle la part créée par l’un
distinct from the contribution of	n’est pas distincte de celle créée
the other author or authors;	par l’autre ou les autres.

[138] Further explanation is provided by John S McKeown in *Fox Canadian Law of Copyright and Industrial Designs*, 4th ed (Toronto, Ontario: Carswell, 2012), ch 17 at 13:

For example, where two persons collaborate in composing a comic opera, one writing the words and the other the music, the opera is a

work of joint authorship and neither one can acquire copyright independently of the other ... The contributions of each joint author need not be equal and different portions of the work may be created by different individuals. For example, an author who writes the scenario of an opera becomes a joint author in the opera based on the scenario, even though they contribute nothing further.

[139] Employees of BJEC's Curriculum Development Department wrote lyrics for the 58 songs for which Mr. Pinto composed the music. The combination of Mr. Pinto's music with BJEC's lyrics created one artistic work, the TaL AM song. There is joint authorship and therefore joint copyright ownership, in this cohesive whole.

[140] As a result, subject to the issue of consent the legal effect of which will be discussed below, both Mr. Pinto and BJEC (now TaL AM) must authorize any recording or performance of the songs at issue.

### ***Sound Recordings***

[141] In addition to the separate copyrights over the song and music, the "maker" of a sound recording owns the copyright to that recording, pursuant to section 18 of the *Act*:

18. (1) Subject to subsection (2), the maker of a sound recording has a copyright in the sound recording, consisting of the sole right to do the following in relation to the sound recording or any substantial part thereof:	18. (1) Sous réserve du paragraphe (2), le producteur d'un enregistrement sonore a un droit d'auteur qui comporte le droit exclusif, à l'égard de la totalité ou de toute partie importante de l'enregistrement sonore :
(a) to publish it for the first time,	a) de le publier pour la première fois;
(b) to reproduce it in any material form, and	b) de le reproduire sur un support matériel quelconque;

(c) to rent it out,	c) de le louer.
and to authorize any such acts.	Il a aussi le droit d'autoriser ces actes.

[142] A sound recording has “a life of its own,” apart from the performance of a work. As the Supreme Court of Canada explained, “[o]nce the composer has made or authorized a recording of his work, he has irrevocably given up much of his control over its presentation to the public”: *Bishop v Stevens*, [1990] 2 SCR 467 at para 21.

[143] Section 2 of the *Act* provides that the “maker” is “the person by whom the arrangements necessary for the first fixation of the sounds are undertaken.” Section 2.11 explains that the necessary arrangements include “entering into contracts with performers, financial arrangements and technical arrangements required for the first fixation of the sounds for a sound recording.”

[144] Case law interpreting these provisions has emphasized the element of financial risk and payment for the recording. The maker is not necessarily the person who has personally undertaken the necessary arrangements, but instead the individual or corporation that bore the financial risk of doing so, such as a record company: *Hughes on Copyright & Industrial Design*, ch 24 at 219.

[145] The evidence on this issue is mixed.

[146] Mr. Pinto engaged the services of the music studios and undertook to pay the studio’s hourly charges for the use of the facilities and equipment. He hired and paid the female vocalist, selected children to sing and rehearsed the songs with them.

[147] However, it was BJEC that ultimately assumed the financial risk for the recording, as its payments to Mr. Pinto covered all of his costs, including paying the studio and vocalist.

Additionally, Ms. Farkas had some involvement in the recording process, though she was not at the studio. She testified that "...if Mr. Pinto called me from the studio, how you do this and how you do that, then I was involved. So for sure I was involved. I wasn't involved in the singing. I wasn't involved -- I didn't play the keyboard. But for sure I was involved in what was done and I was abreast with what was done at every stage."

In my view, though he was not an employee, he was entitled to be reimbursed for his expenses and therefore did not assume the financial responsibility for the recording. It is significant that for fourteen years BJEC paid every invoice provided by Mr. Pinto, including all disbursements.

Accordingly, I conclude that BJEC was the maker of the sound recording and owned the copyright.

### *Compilation*

[148] The TaL AM curriculum is an integrated whole, with texts, illustrations, graphics, lyrics, music and plays. Many educators, illustrators, graphic designers, musicians and performers contributed to the product, under the direction of the TaL AM curriculum development team.

[149] Section 2 of the *Act* provides a definition of compilation:

“compilation” means

(a) a work resulting from the selection or arrangement of literary, dramatic, musical or artistic works or of parts thereof, or

« compilation » Les œuvres résultant du choix ou de l'arrangement de tout ou partie d'œuvres littéraires, dramatiques, musicales ou artistiques ou de données.

(b) a work resulting from the selection or arrangement of data;

[150] Furthermore, section 2 provides that compilations may be artistic works and therefore granted copyright protection:

“artistic work” includes paintings, drawings, maps, charts, plans, photographs, engravings, sculptures, works of artistic craftsmanship, architectural works, and compilations of artistic works;

« œuvre artistique » Sont compris parmi les œuvres artistiques les peintures, dessins, sculptures, œuvres architecturales, gravures ou photographies, les œuvres artistiques dues à des artisans ainsi que les graphiques, cartes, plans et compilations d’œuvres artistiques.

[151] Accordingly, in addition to the copyright which attaches to individual works, there may be a second, concurrent copyright to the compilation as a whole. This second copyright does not extinguish the copyright over individual components of the collective work. Each exists simultaneously: *Robertson v Thomson Corp*, 2006 SCC 43 at para 31, [2006] 2 SCR 363.

[152] In order for there to be a copyright in the compilation, the selection and arrangement of individual works must be original, involving the exercise of taste and discretion: *Hughes on Copyright & Industrial Design*, ch 22 at 186; *Slumber-Magic Adjustable Bed Co v Sleep-King Adjustable Bed Co*, [1984] BCJ No 3054 at para 6.

[153] I find that employees of BJEC did exercise substantial expertise and originality in selecting the compilation. Ms. Shimon, in particular, has expertise in pedagogy. Ms. Farkas explained that the music and songs were not created for artistic purposes: “if Barbara Streisand decides to produce music, she would go by, let’s say, her taste ... when you do a curriculum, then what determines what goes in is educational standards. Not -- and then how the music fits and is the music appropriate, is it age appropriate, is it content appropriate and so forth.”

[154] Ms. Shimon explained how different elements of TaL AM were selected to develop various intelligences, including the children’s creativity and logical reasoning. She explained that different characters and images were selected to establish connectivity with Israel and cohesion between the teaching tools and educational level, from the choice of colour, design, and graphics, to the lyrics and the overall pedagogical objectives.

[155] Accordingly, the question becomes whether the BJEC employees had Mr. Pinto’s consent to use his music in the compilation. If they did, subsection 3(1) of the *Act* grants BJEC (and now TaL AM) copyright over the compilation: *Slumber-Magic*, at para 7. If they did not, BJEC infringed Mr. Pinto’s copyright in creating the compilation.

### ***Licence, Consent and Revocations***

[156] The determinative issue for this trial is whether Mr. Pinto consented to BJEC’s use of his music as part of the TaL AM curriculum. Even though Mr. Pinto owns copyright to the music, and joint copyright in the songs, there can be no infringement with consent.



[157] As the party seeking to establish infringement, Mr. Pinto bears the legal burden of proving that he did not consent: *Harmony Consulting Ltd v GA Foss Transport Ltd*, 2012 FCA 226 at paras 31-32.

[158] In *Harmony Consulting*, the Federal Court of Appeal quoted with approval from an article by David Vaver, “Consent or No Consent: The Burden of Proof in Intellectual Property Infringement Suits” (2011) 23 IPJ 147 at 148-49:

It is rarely a chore for a plaintiff to prove he gave no express consent: he knows best whether he did or not ... If, on weighing the evidence, the court is satisfied the plaintiff gave no implied consent, he wins. If the defendant does show implied consent, the plaintiff fails to discharge his onus and loses. In theory, if the evidence is left in a state where the court is unsatisfied that the plaintiff did *not* grant implied consent, the plaintiff also loses. [emphasis in original]

[159] Mr. Pinto has failed to make out this critical component of infringement. The evidence establishes that Mr. Pinto consented to, and indeed actively facilitated, BJEC’s use of his music. This is not a case of uncertainty or ambiguity. The evidence is consistent with consent.

[160] A court may find an implied licence has been granted when an artistic work was created as part of a freelance contract at the request of the purchaser. In such cases, the freelance contract is construed as including an implied licence for the purchaser to use the work for the purpose it was created.

[161] In *Netupsky v Dominion Bridge Co*, [1972] SCR 368 at 377-78, the Supreme Court of Canada adopted the following articulation of the law from the Supreme Court of New South Wales in *Beck v Montana Construction Pty Ltd*, (1963), 5 FLR 298 at 304-05:

...the engagement for reward of a person to produce material of a nature which is capable of being the subject of copyright implies a permission or consent or licence in the person making the engagement to use the material in the manner and for the purpose in which and for which it was contemplated between the parties that it would be used at the time of the engagement.

[162] This principle is directly applicable to the present circumstances. BJEC engaged Mr. Pinto to compose, produce, arrange, perform and record music for the TaL AM curriculum. BJEC paid Mr. Pinto for his work, and in exchange for the consideration, received an implied licence to use the work for the purpose contemplated by the parties: *Nicholas v Environmental Systems, (International) Ltd*, 2010 FC 741 at para 49.

[163] Mr. Pinto included an explicit charge for composition on his invoices up to March, 2004. At that date, Mr. Pinto stopped including any mention of composition on his invoices, without notifying the defendants. Regardless, the substance of the agreement was unchanged. At all times, Mr. Pinto understood that his work was being commissioned for use in the TaL AM curriculum.

[164] Mr. Pinto, during his examinations for discovery and at trial, acknowledged that he permitted BJEC to use his music for the purposes of the TaL AM curriculum. In the examination before plea on July 22, 2008, Mr. Pinto said that in 1992 he told Ms. Shimon, "I allow you to use my music. That doesn't mean that you do with my music what you want." He elaborated, "[a]s I explained in the beginning, I allowed them to use the music, being charity organization, promoting Jewish education."

[165] This testimony establishes that Mr. Pinto granted his consent.

[166] When a licence is granted in exchange for consideration, as in this case, it cannot be unilaterally revoked: *Silverson v Neon Products Ltd*, [1977] BCJ No 1092 (SC) at paras 33-36; *Fox Canadian Law of Copyright and Industrial Designs*, ch 19 at 29.

[167] There is no evidentiary value in Mr. Pinto's hidden annotations in his invoices from March of 2006 onwards. This, apparently, was his attempt to induce BJEC to pay him on terms that had previously been rejected, knowing that they would not agree if the terms were made explicit.

[168] It is also irrelevant that Mr. Pinto may have requested a written agreement. While waiting for a written agreement acceptable to him, he continued accepting and completing work, based on the oral contract. Indeed, though he may have preferred a better or different arrangement, he continued to work, intermittently, in the absence of a written contract for 14 years. At minimum, an implied consent to the terms presented to him by the defendants.

[169] The Supreme Court of Canada has established that there is no requirement that consent be granted in writing for a non-exclusive licence, a grant of permission, to use the work. Writing is only necessary for actually transferring the property right, which grants the assignee the right to sue for infringement: *Robertson v Thomson Corp*, at para 56.

### ***Limitations***

[170] Having found that Mr. Pinto consented to BJEC's use of his work, the Court must consider what, if any, are the limitations on that consent.

[171] Mr. Pinto testified that he authorized BJEC to use his music on the basis that it was a non-profit organization promoting Jewish education. There is no evidence that he made these conditions explicit to BJEC as part of the contract negotiations. Regardless, Ms. Shimon testified that she considered TaL AM to be a “gift” to the Jewish people, in particular to educate children. I accept that these charitable and educational motives were apparent to all parties central to the motivation of the defendants. This does not mean that they were shared by all who worked on the project, and in particular the freelancers for whom it was a business or commercial opportunity.

[172] Mr. Pinto considers the defendants to have become “millionaires” and TaL AM to be a “commercial” as opposed to an educational product, now promoted around the world. Its use thus exceeded the scope of any implied licence for use, which he contended was confined to the Montréal region.

[173] The evidence does not support this position.

[174] I accept Ms. Shimon’s testimony that she made it clear to Mr. Pinto that TaL Sela and TaL AM would be used outside of Canada. By 1992, TaL Sela was already used in many countries and this would have been known to Mr. Pinto in 1993, given the maps in the BJEC office indicating the distribution of the curriculum.

[175] The evidence is also clear that BJEC and later TaL AM are and have always been non-profit organizations. Proceeds from the sale of the curriculum are reinvested so that the curriculum can be revised and expanded over the years.

[176] The overwhelming majority of sales are directly to schools and all schools are required to participate in the TaL AM training institutes so that the teachers develop mastery of the curriculum. There are limited direct sales to parents of students, but I accept Mr. Shimon's evidence that this constitutes less than one percent of all sales, and is intended to compliment the school curriculum.

[177] Mr. Pinto's objection is similar to that of the plaintiff in *Cselko Associates Inc v Zellers Inc*, [1992] OJ No 1456 (Gen Div). In that case, the plaintiff was paid by Zellers to create illustrations for advertising. He later learned the extent to which his drawings were being used, for packaging as well as advertising. The plaintiff argued that packaging is different from advertising. His argument failed, as he did not make this view known to the defendant. He did not put an express restriction on the scope of his consent.

[178] Similarly, while I accept that all parties intended that the music would be used for educational purposes, I do not accept that any further limitations were communicated by Mr. Pinto or reasonably contemplated by the parties. While he may have anticipated that the music would reach a smaller audience, with less distribution, there is no evidence that he communicated this expectation in terms of a limit on the permitted use. It is not a condition of the implied licence that TaL AM achieves only modest success.

[179] I also do not accept Mr. Pinto's submission that he "might have granted [the] [d]efendants the right to make use and reproduce his 58 musical compositions, subject always to the execution of a written agreement and the resolution of his claim of copyright ownership." While Mr. Pinto testifies that he requested a written agreement, he did not state that he made this an explicit condition of any licence he granted. Indeed, such a condition would be highly problematic, and arguably unenforceable, due to the lack of certainty regarding what terms it might have and on what basis either party could refuse to agree to it. Such a vague condition would grant Mr. Pinto the unilateral right to withdraw from the agreement and claim damages, at any time. As discussed above, consent is irrevocable when granted in exchange for consideration.

[180] I accept Ms. Shimon's testimony that she did not promise to provide Mr. Pinto with a written contract, and reject the argument that the licence had the implied condition that a written contract would be provided. The evidence is consistent that the defendants preferred an oral agreement.

[181] While Mr. Pinto testified that he raised the issue of copyright (his "rights") when he began work on TaL AM in 1992, he did not mention royalties until sometime later, in or around 2002. At the time of the initial meeting, he was unfamiliar with the concept of royalties.

[182] Mr. Pinto continued producing work and receiving payment despite any dissatisfaction with his compensation. Mr. Pinto would have preferred to be paid royalties, in addition to his hourly fees, but this arrangement was refused on several occasions. By continuing to work in light of that

refusal, he must be taken to have accepted it. He cannot unilaterally change the agreement at this time, imposing a requirement for additional payment which he was unable to negotiate.

[183] I find that BJEC never agreed to pay royalties. BJEC agreed to pay Mr. Pinto his hourly rate and his composition fee, no more. As set out in the Agreed Statement of Facts and Admissions “[BJEC representatives] stated that their policy was not to pay royalties to artists who worked on the TaL AM curriculum.”

[184] Various witnesses, including Ms. Farkas and Mr. Shimon, agreed that Mr. Pinto repeatedly asked for more money. Mr. Pinto would increase the fees he charged on his invoice, without first notifying BJEC. BJEC agreed to pay the higher fees but never accepted any obligation to pay royalties.

[185] In December of 1997, Mr. Pinto was paid a “bonus” for the music he composed for grade one. This was not a royalty payment. Ms. Shimon and Ms. Cohen testified that the bonus was not paid for copyright purposes, but rather it was freely given because the grade one pilot had been successful. Mr. Pinto was initially paid a relatively low fee for his services on that pilot. In addition, the amount was arbitrary, there being no evidence that it was determined on the basis of sales.

### *Defendants*

[186] While there is no dispute between the parties as to the proper defendants before the Court, the pleadings have not, given their multiple iterations and the change of counsel, been amended

accordingly. The style of cause will therefore be ordered amended to reflect the style of cause of this decision.

[187] As I have found that there is no infringement of Mr. Pinto's copyright, it is not necessary to determine which of the defendants would have been liable. I will address this issue, in the alternative.

[188] Mr. and Ms. Shimon have no personal liability. At all relevant times, they were officers and employers of BJEC and TaL AM. A corporation has a separate legal existence, and accordingly, an individual will not be liable for the infringement of a corporation with which he or she is associated, absent evidence that the individual is guilty of intentional infringement: *Fox Canadian Law of Copyright and Industrial Designs*, ch 24 at 16.2.

[189] The evidence falls well short of establishing that Mr. and Ms. Shimon deliberately or recklessly engaged in a course of conduct they knew was likely to constitute infringement.

[190] Mr. Pinto contracted directly with BJEC, and it is appropriately named in this action. Additionally, as BJEC transferred its intellectual property assets and liabilities to TaL AM, both organizations are jointly and severally liable for any damages.

### ***Statutory Damages***

[191] The last matter to be considered, in the alternative, is the quantum of damages that Mr. Pinto would have been entitled to if I had found infringement of his copyright.



[192] Mr. Pinto seeks damages in the amount of \$320,000.

[193] Mr. Pinto does not seek actual damages, but instead asks that statutory damages be assessed pursuant to paragraph 38.1(1)(a) of the *Act*:

38.1 (1) Subject to this section, a copyright owner may elect, at any time before final judgment is rendered, to recover, instead of damages and profits referred to in subsection 35(1), an award of statutory damages for which any one infringer is liable individually, or for which any two or more infringers are liable jointly and severally,

(a) in a sum of not less than \$500 and not more than \$20,000 that the court considers just, with respect to all infringements involved in the proceedings for each work or other subject-matter, if the infringements are for commercial purposes;

38.1 (1) Sous réserve des autres dispositions du présent article, le titulaire du droit d'auteur, en sa qualité de demandeur, peut, avant le jugement ou l'ordonnance qui met fin au litige, choisir de recouvrer, au lieu des dommages-intérêts et des profits visés au paragraphe 35(1), les dommages-intérêts préétablis ci-après pour les violations reprochées en l'instance à un même défendeur ou à plusieurs défendeurs solidairement responsables :

a) dans le cas des violations commises à des fins commerciales, pour toutes les violations — relatives à une œuvre donnée ou à un autre objet donné du droit d'auteur —, des dommages-intérêts dont le montant, d'au moins 500 \$ et d'au plus 20 000 \$, est déterminé selon ce que le tribunal estime équitable en l'occurrence;

[194] The amount of the statutory damages is to be assessed with regard to the following factors, provided in subsection 38.1(5):

(5) In exercising its discretion under subsections (1) to (4), the court shall consider all relevant factors, including

(a) the good faith or bad faith of the defendant;

(5) Lorsqu'il rend une décision relativement aux paragraphes (1) à (4), le tribunal tient compte notamment des facteurs suivants :

a) la bonne ou mauvaise foi du défendeur;

(b) the conduct of the parties before and during the proceedings;

(c) the need to deter other infringements of the copyright in question; and

(d) in the case of infringements for non-commercial purposes, the need for an award to be proportionate to the infringements, in consideration of the hardship the award may cause to the defendant, whether the infringement was for private purposes or not, and the impact of the infringements on the plaintiff.

b) le comportement des parties avant l'instance et au cours de celle-ci;

c) la nécessité de créer un effet dissuasif à l'égard de violations éventuelles du droit d'auteur en question;

d) dans le cas d'une violation qui est commise à des fins non commerciales, la nécessité d'octroyer des dommages-intérêts dont le montant soit proportionnel à la violation et tienne compte des difficultés qui en résulteront pour le défendeur, du fait que la violation a été commise à des fins privées ou non et de son effet sur le demandeur.

[195] There should be some relationship between the actual damages and statutory damages:

*Hughes & Peacock on Copyright and Industrial Design*, at 665. Hughes J and Susan Peacock continue and observe that:

The overarching mandate of a judge assessing statutory damages in lieu of damages and loss of profits is to arrive at a reasonable assessment in all of the circumstances in order to yield a just result. There should be some correlation between actual damages and statutory damages.

[196] This, in turn, directs the inquiry to a broad range of factors, including whether or not the defendants acted in good or bad faith and the need for deterrence.

[197] Bad faith refers to “conduct that is contrary to community standards of honesty, reasonableness or fairness. It is also conduct where a party acts in a manner that substantially nullifies the contractual objectives or causes significant harm to the other, contrary to the original purposes or expectations of the parties”: *Century 21 Canada Ltd Partnership v Rogers*

*Communications Inc*, 2011 BCSC 1196 at para 408. It cannot be said that the defendants acted dishonestly, unreasonably or unfairly.

[198] The defendants have acted in good faith. Mr. and Ms. Shimon's testimony establishes that they sincerely believed they held copyright in all of the creative works specifically created for the TaL AM curriculum and that they had Mr. Pinto's consent to use it. They used the music for the purpose it was created.

[199] The defendants submit that they have acted innocently, and therefore the Court could award as little as \$200 per work, pursuant to subsection 38.1(2) of the *Act*:

(2) If a copyright owner has made an election under subsection (1) and the defendant satisfies the court that the defendant was not aware and had no reasonable grounds to believe that the defendant had infringed copyright, the court may reduce the amount of the award under paragraph (1)(a) to less than \$500, but not less than \$200.

(2) Dans les cas où le défendeur convainc le tribunal qu'il ne savait pas et n'avait aucun motif raisonnable de croire qu'il avait violé le droit d'auteur, le tribunal peut réduire le montant des dommages-intérêts visés à l'alinéa (1)a) jusqu'à 200 \$.

[200] The conduct of the defendants, before and during these proceedings, has been reasonable. As previously stated, the defendants believed that they owned copyright and that they had Mr. Pinto's consent to use the music. They paid a substantial amount of money for the music, more than \$330,000.

[201] It is significant that Mr. Pinto allowed the defendants to use his music for 14 years, only claiming copyright infringement in July of 2006. As in *Nicholas*, at para 102, Mr. Pinto would bear

some responsibility for any confusion on the part of the defendants. As in that case, a substantial damage award is not warranted.

[202] Moreover, I also do not think deterrence is a relevant consideration in the present circumstances. BJEC and TaL AM have not demonstrated any reluctance to comply with the law. While the parties have not provided case law dealing specifically with statutory damages awarded against non-profit corporations, I consider this factor relevant to the question on what impact the award will have against the defendants. All revenue generated from the sales of TaL AM materials has been reinvested into the development of the curriculum. There is no profit motive.

[203] The defendant submits that the royalty rates of the Canadian Musical Reproduction Rights Agency Ltd (CMRRA) provide a benchmark to establish the actual value of the infringement. In my view, there is no basis to expect that any royalties Mr. Pinto may have received would have been on this basis. Though the CMRRA rates apply to 90% of music sold commercially in Canada, the work at issue here is for a niche market, young Jewish students only.

[204] I also consider the authorities provided by Mr. Pinto to have minimal relevance to the present circumstances. The defendants paid a substantial sum of money for his music. This is unlike circumstances where, without any colour of right, defendants wilfully appropriated intellectual property for profit motives.

[205] I have therefore concluded that the relevant considerations indicate an award of damages at the low end of the spectrum. I would award \$300 for each work. As Mr. Pinto owns the copyright to his 58 original compositions, this would amount to an award of \$17,400.

**JUDGMENT**

**THIS COURT'S JUDGMENT is that** this action is dismissed. Submissions on costs may be delivered within 20 days of this date. The style of cause is ordered amended to reflect the style of cause of this decision.

"Donald J. Rennie"

---

Judge

**FEDERAL COURT**

**SOLICITORS OF RECORD**

**DOCKET:** T-1070-07

**STYLE OF CAUSE:** **YEHUDA PINTO v BRONFMAN JEWISH  
EDUCATION CENTRE et al**

**PLACE OF HEARING:** Montréal, Québec

**DATE OF HEARING:** May 27 - 31 and June 6, 2013

**REASONS FOR JUDGMENT  
AND JUDGMENT:** RENNIE J.

**DATED:** September 11, 2013

**APPEARANCES:**

Richard Uditsky  
Jason S. Novak

FOR THE PLAINTIFF

Mathieu Bouchard  
Emma Lambert

FOR THE DEFENDANTS

**SOLICITORS OF RECORD:**

Robertson, Sheppard Shapiro  
Montréal, Québec

FOR THE PLAINTIFF

Irving Mitchell Kalichman  
Montréal, Québec

FOR THE DEFENDANTS