Federal Court Cour fédérale

Date: 20240228

Docket: T-1471-21

Citation: 2024 FC 322

Ottawa, Ontario, February 28, 2024

PRESENT: Mr. Justice McHaffie

BETWEEN:

GE RENEWABLE ENERGY CANADA INC.

Plaintiff

and

CANMEC INDUSTRIAL INC.

Defendant

and

RIO TINTO ALCAN INC.

Third Party

ORDER AND REASONS

I. Overview

[1] The Third Party, Rio Tinto Alcan Inc, seeks to examine Cyril Chatron for discovery in this copyright infringement action. Mr. Chatron is an engineer employed by GE Hydro France, a French affiliate of the Plaintiff, GE Renewable Energy Canada Inc [GEREC]. He has been

identified as the author of most of the works that GEREC claims were infringed by Canmec Industrial Inc in the course of Canmec's refurbishment of a power plant owned by Rio Tinto.

[2] Rio Tinto asserts that since Mr. Chatron was a French citizen employed in France by a French company at the time of the creation of the works, he was the first owner of any copyright in the works under French copyright law. Mr. Chatron assigned his copyright to GE Hydro France, who in turn assigned the Canadian copyright to GEREC. Rio Tinto argues Mr. Chatron is therefore an "assignor" within the meaning of Rule 237(4) of the *Federal Courts Rules*, SOR/98-106, and that it has the right to examine him for discovery under that rule. In the alternative, it seeks an order under Rule 238 to examine Mr. Chatron for discovery as a non-party who has information on an issue in the action.

[3] Despite Rio Tinto's interesting and well-presented arguments, I conclude that subsection 13(3) of the *Copyright Act*, RSC 1985, c C-42, applies to deem GE Hydro France, as Mr. Chatron's employer, to be the first owner of Canadian copyright in the works he authored. Canadian copyright protection is governed by the Canadian *Copyright Act*, including as to authorship and first ownership of copyright, even where the treatment of such issues may be different under foreign copyright laws. The agreement between Mr. Chatron and GE Hydro France does not include an "agreement to the contrary" that would displace the first ownership provisions in subsection 13(3).

[4] I further conclude that the requirements for an order under Rule 238 are not met. In particular, I am not satisfied Rio Tinto has been unable to obtain the information in

Mr. Chatron's possession by other means, notably through examination for discovery of GEREC.

[5] Rio Tinto's motion is therefore dismissed. In accordance with the parties' agreement, costs are payable by Rio Tinto to GEREC in the amount of $3,000 plus reasonable disbursements including expert fees, in any event of the cause. Canmec supported Rio Tinto's motion but did not participate in it. No costs were sought or are awarded against Canmec.

II. Issues

[6] Rio Tinto's motion raises the following issues:

A. Does Rio Tinto have the right to examine Mr. Chatron as an assignor pursuant to Rule 237(4)?

B. If not, should leave be granted to examine Mr. Chatron pursuant to Rule 238?

III. Analysis

A. *Rio Tinto does not have the right to examine Mr. Chatron as he is not an assignor*

(1) Examination of assignors for discovery under the *Federal Courts Rules*

[7] Rule 237 of the *Federal Courts Rules* addresses who may be examined for discovery in an action in various situations. While Rule 237(4) is the primary rule at issue on this motion, Rules 237(1) and (3) also have some bearing. I set out these three provisions here:

Representative selected	**Interrogatoire d'une personne morale**
237 (1) A corporation, partnership or unincorporated association that is to be examined for discovery shall select a representative to be examined on its behalf.	**237 (1)** La personne morale, la société de personnes ou l'association sans personnalité morale qui est soumise à un interrogatoire préalable désigne un représentant pour répondre en son nom.
[…]	[…]
Order for substitution	**Substitution ordonnée**
(3) The Court may, on the motion of a party entitled to examine a person selected under subsection (1) or (2), order that some other person be examined.	**(3)** La Cour peut, sur requête d'une partie ayant le droit d'interroger une personne désignée conformément aux paragraphes (1) ou (2), ordonner qu'une autre personne soit interrogée à sa place.
Examination of assignee	**Interrogatoire du cessionnaire**
(4) Where an assignee is a party to an action, the assignor may also be examined for discovery.	**(4)** Lorsqu'un cessionnaire est partie à l'action, le cédant peut également être soumis à un interrogatoire préalable.

[8] The examination for discovery of an assignor is more limited than that of an adverse party. The evidence given is only that of the assignor and cannot be used to bind an adverse party unless adopted by them: *Allergan Inc v Apotex Inc*, 2020 FC 658 at para 37. While the rule is most frequently used as a basis to examine inventors who have assigned their interest in an invention or a patent, the "assignor" of Rule 237(4) may be the assignor of any relevant right: *Richter Gedeon Vegyészeti Gyar Rt v Merck & Co*, 1995 CanLII 3514 (FCA), [1995] 3 FC 330 (CA) at pp 339–341; *Boehringer Ingelheim Canada Ltd v Jamp Pharma Corporation*, 2023 FC 943 at paras 16, 24.

[9] This Court has described the purpose of examinations under Rule 237(4) as being to allow the examining party to obtain general information and possible lines of inquiry with respect to the circumstances of the assignment and the right assigned; and to allow the examining party to use the transcript of the discovery to impeach the witness if the assignor is called as a witness at trial: *Faulding (Canada) Inc v Pharmacia SPA*, 1999 CanLII 7940 (FC) at para 4. That said, a party adverse to the assignee may examine an assignor as of right, and the examining party need not demonstrate a necessity to conduct the examination: *Faulding Canada Inc v Pharmacia SPA*, 1998 CanLII 7958 (FCA) at para 1.

(2) Factual and procedural context

[10] GEREC's claim asserts ownership of copyright in 33 manufacturing drawings related to a piece of equipment known as a "butterfly valve." It claims Canmec infringed copyright in those drawings in the context of Canmec's work on the refurbishment of Rio Tinto's hydroelectric power plant known as the Isle-Maligne Plant: see, generally, *GE Renewable Energy Canada Inc v Canmec Industrial Inc*, 2024 FC 187 at paras 12–25. The existence of copyright in the manufacturing drawings and the ownership of any such copyright are live issues in the action.

[11] After Canmec brought a Third Party claim against Rio Tinto, Rio Tinto demanded particulars of the Statement of Claim from GEREC. In response, GEREC stated that the authors of the drawings referred to in the claims were Mr. Chatron, whose name appears on 26 of the 33 drawings, and three GEREC employees. GEREC stated that in all instances, ownership of copyright resides with GEREC "by operation of section 13(3) of the *Copyright Act*, and/or by assignment of right (pursuant to section 13(4) of the *Copyright Act*)."

[12] The parties conducted examinations for discovery of adverse parties in April and May 2023. Claude-Frédéric Boudreau was examined as the corporate representative of GEREC. After a discovery motion in September 2023, a second round of discoveries was conducted in early 2024. Transcripts from the follow-up discoveries were not put before the Court on this motion, although the parties made some reference to them in argument.

[13] In parallel, Rio Tinto also requested an opportunity to examine GE Hydro France pursuant to Rule 237(4) as an assignor of the copyright in which GEREC claims ownership. It suggested Mr. Chatron would be a suitable representative of GE Hydro France. GEREC agreed that GE Hydro France could be examined under Rule 237(4), but put forward Nicolas Pot, President of GE Hydro France, as the company's representative pursuant to Rule 237(1). Mr. Pot was examined on September 20, 2023. At his examination, Mr. Pot was unable to respond to questions about Mr. Chatron's involvement in the creation of the works at issue, although he responded to other questions about GE Hydro France and its relationship with GEREC. Counsel for GEREC refused to provide undertakings on Mr. Pot's examination. The following day, Rio Tinto asked to examine Mr. Chatron for discovery pursuant to Rule 237(4). GEREC refused, leading to this motion.

[14] Rio Tinto's motion seeks to examine Mr. Chatron in his own role as an assignor, and not as a corporate representative of GE Hydro France. In other words, despite its concerns that Mr. Pot did not have information with respect to issues relevant to the action, Rio Tinto does not bring this motion under Rule 237(3) seeking an order substituting Mr. Chatron for Mr. Pot as the representative of GE Hydro France.

[15] The question in this case is therefore whether Mr. Chatron is “the assignor” within the meaning of Rule 237(4) as a person who assigned Canadian copyright in the works at issue to GE Hydro France, who in turn assigned it to GEREC.

(3) “The assignor”

[16] GEREC argues that, regardless of whether Mr. Chatron was the first owner of copyright, he cannot be “the assignor” as that term is used in Rule 237(4), since he did not assign copyright directly to GEREC. Rule 237(4) requires “the assignee” to be a party to the action: *Faurecia Automotive Seating Canada Ltd v Lear Corp Canada Ltd*, 2002 CarswellNat 3176 at para 21. GEREC argues that it is the party to the action and is “the assignee” of the copyrights at issue from GE Hydro France. It therefore argues that GE Hydro France is “the assignor” of that copyright, and that Rule 237(4) does not extend further back in the chain of title to any party who might have assigned their rights to GE Hydro France. It notes that Rule 237(4) uses the words “*the* assignor,” and argues that the rule only contemplates the examination of the assignor or assignors who directly assigned the right or interest to the assignee that is a party.

[17] I cannot agree. The Federal Court of Appeal in *Richter* recognized that the use of the singular term “the assignor” covered multiple assignors by application of the *Interpretation Act*, RSC 1985, c I-21: *Richter* at pp 340–343. I see no reason why such multiple assignors need all have directly assigned to the assignee party, as opposed to having assigned to other assignors in the chain of title. GEREC was able to point to no authority for such a proposition. Indeed, the *Faurecia* case that GEREC relies on states that the rule “imposes no restrictions or limitations on the type of assignor”: *Faurecia* at para 21.

[18] GEREC's narrow interpretation of the rule would create unjustified distinctions between cases in which a plaintiff has acquired rights directly from an assignor and those in which the plaintiff acquired them from a third party—related or not—who in turn acquired them from the original assignor. There is no principled reason to permit the original owner of the right, such as an inventor or author, to be examined in the former case but not in the latter. Indeed, GEREC's interpretation would permit parties to prevent the application of Rule 237(4) and thwart discovery on relevant issues relating to both the creation of a right and its assignment, as well as the potential use of the transcript for impeachment at trial, simply by inserting an intervening person or company into the chain of assignment.

(4) Mr. Chatron is not an assignor

[19] Nonetheless, I conclude Mr. Chatron is not an assignor of the copyright asserted by GEREC in the action, since he was never an owner of Canadian copyright in the works at issue. Since he is not an assignor, Rio Tinto has no right to examine him under Rule 237(4).

[20] This conclusion stems from the interpretation and application of subsections 13(1) and (3) of the *Copyright Act*, which read as follows:

Ownership of copyright	**Possession du droit d'auteur**
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.
[…]	[…]

Work made in the course of employment	**Œuvre exécutée dans l'exercice d'un emploi**
(3) Where the author of a work was in the employment of some other person under a contract of service or apprenticeship and the work was made in the course of his employment by that person, the person by whom the author was employed shall, in the absence of any agreement to the contrary, be the first owner of the copyright, but where the work is an article or other contribution to a newspaper, magazine or similar periodical, there shall, in the absence of any agreement to the contrary, be deemed to be reserved to the author a right to restrain the publication of the work, otherwise than as part of a newspaper, magazine or similar periodical.	**(3)** Lorsque l'auteur est employé par une autre personne en vertu d'un contrat de louage de service ou d'apprentissage, et que l'œuvre est exécutée dans l'exercice de cet emploi, l'employeur est, à moins de stipulation contraire, le premier titulaire du droit d'auteur; mais lorsque l'œuvre est un article ou une autre contribution, à un journal, à une revue ou à un périodique du même genre, l'auteur, en l'absence de convention contraire, est réputé posséder le droit d'interdire la publication de cette œuvre ailleurs que dans un journal, une revue ou un périodique semblable.
[Emphasis added.]	[Je souligne.]

[21] By operation of these provisions, the author of a work is generally the first owner of copyright in the work. However, where the author created the work in the course of employment, their employer is the first owner of the work, absent agreement to the contrary.

[22] There is no dispute that Mr. Chatron was employed by GE Hydro France and that his authorship of the works at issue, if any (a contested issue), was done in the course of his employment by GE Hydro France. As a result, if subsection 13(3) applies, then GE Hydro France is the first owner of any copyright in the works.

[23] However, as set out in affidavits from experts in French copyright law filed by each party (Me. Sophie Micaleff for Rio Tinto; Me. Marie Georges-Picot for GEREC), the rules in France regarding first ownership of copyright in works are not the same as those set out in subsections 13(1) and (3). Under France's Intellectual Property Code [IP Code], the author of a work is generally the first owner of the work, as is the case under subsection 13(1) of the *Copyright Act*: IP Code, Art L111-1. There are exceptions to this general rule with respect to "collective works" and with respect to software and associated documentation: IP Code, Arts L113-2, L113-9. However, there is no general exception akin to subsection 13(3) for all works created in the course of employment. As a result, under French law, to the extent that Mr. Chatron was the author of the works in question and those works are not "collective works," Mr. Chatron would be the first owner of copyright in the works.

[24] Mr. Chatron signed agreements with GE Hydro France in connection with his employment, one of which addresses intellectual property rights and confidential information. Section B(ii) of that agreement effectively states that Mr. Chatron assigns his copyright in works created in the context of his employment to GE Hydro France. It also expressly recognizes the exceptions under the IP Code relating to collective works and software. The agreement includes a choice of law and forum clause agreeing that it will be governed and interpreted in accordance with the laws of France and submitting to the exclusive jurisdiction of the French courts.

[25] Based on the foregoing, Rio Tinto argues that French law should apply with respect to creation and first ownership of copyright in the works said to be authored by Mr. Chatron. On this argument, subsection 13(3) of the *Copyright Act* does not apply to make GE Hydro France

the first owner of copyright. Rather, Mr. Chatron was the first owner, and assigned his copyright to GE Hydro France, making him an "assignor" within the meaning of Rule 237(4). Alternatively, Rio Tinto argues that if subsection 13(3) does apply, then the provisions of the agreement between Mr. Chatron and GE Hydro France constitute an "agreement to the contrary" within the meaning of subsection 13(3), such that the subsection does not apply to render GE Hydro France the first owner of copyright.

(a) *The domestic* Copyright Act *governs initial ownership*

[26] In support of its argument that the law of France should apply to first ownership of the work, Rio Tinto refers to Article 5(2) of the *Berne Convention for the Protection of Literary and Artistic Works*, 828 UNTS 221. That Article provides that the extent of copyright protection, and the means of redress afforded to the author, are exclusively governed by the laws of the country where protection is claimed:

Article 5	**Article 5**
(2) The enjoyment and the exercise of these rights shall not be subject to any formality; such enjoyment and such exercise shall be independent of the existence of protection in the country of origin of the work. Consequently, apart from the provisions of this Convention, the extent of protection, as well as the means of redress afforded to the author to protect his rights, shall be governed exclusively by the laws of the country where protection is claimed.	2) La jouissance et l'exercice de ces droits ne sont subordonnés à aucune formalité; cette jouissance et cet exercice sont indépendants de l'existence de la protection dans le pays d'origine de l'œuvre. Par suite, en dehors des stipulations de la présente Convention, l'étendue de la protection ainsi que les moyens de recours garantis à l'auteur pour sauvegarder ses droits se règlent exclusivement d'après la législation du pays où la protection est réclamée.
[Emphasis added.]	[Je souligne.]

[27] Rio Tinto notes that Article 5(2) does not state that the ownership of or title to copyright is similarly governed by the laws of the country where protection is claimed. For cinematographic works, Article 14bis of the *Berne Convention* expressly provides that ownership of copyright is a matter for legislation in the country where protection is claimed. Rio Tinto argues that this suggests that for non-cinematographic works, the laws of the country of origin ought to govern.

[28] Rio Tinto cites a thoughtful text by Professor Jane C. Ginsburg, *The Private International Law of Copyright in an Era of Technological Change*, 1998 Collected courses of the Hague Academy of International Law, Vol 273, 239–405. Chapter IV of that text addresses choice of law and conflict of law issues relating to ownership of copyright. In addressing the question of first ownership, Professor Ginsburg notes the *Berne Convention* does not expressly dictate the choice of law for initial ownership of non-cinematographic works. She concludes that each *Berne Convention* member is free to apply its own conflicts of laws rules to determine initial ownership of such works.

[29] Professor Ginsburg argues the *Berne Convention* as a whole does not support a "highly territorialist" view of copyright in which the law of the forum of enforcement dictates all matters of copyright authorship and ownership. She suggests that the choice of law rules of member countries should further the overall goal of the Convention, namely promoting the international dissemination of works of authorship. She writes:

> Application of a rule of strict territoriality could result in a multiplicity of laws governing copyright ownership; this might so disrupt international commerce in copyrighted works as to defeat one of the principal purposes of the treaty. Moreover, while it has

> long been recognized that "international copyright" is more accurately understood as a collection of national copyrights conferred on the author (or initial copyright holder) by virtue of bi- and multilateral treaties, that characterization better fits the determination of protectable subject matter and scope of rights than ownership of rights. It makes more sense to conceive of copyright as germinating in a work's source country, subsequently to flower in all other countries in which the work is protected. The countries that later host the work tend to its growth, but the welcome they extend to the work does not uproot it from its source. The work's source country (country of first publication, or residence, or domicile, or nationality of the author) thus should determine who is the initial titleholder. Instead of seeking alternative points of attachment for identifying the law competent to designate copyright ownership, "it is simpler and more just simply to refer to the substantive rule as set forth in the national law under whose aegis the work was born".
>
> [Emphasis added; footnotes omitted; Ginsburg at pp 356–357.]

[30] Professor Ginsburg goes on to note that applying the law of the work's source country would ensure that the work does not change owners by operation of law each time the work crosses an international boundary, while licensees in all countries would know that they have acquired rights from their owner.

[31] Rio Tinto argues that the applicable law for determining initial ownership of copyright should be assessed by applying Canadian conflicts of laws rules and should consider the "connecting factors" associated with the creation of the work. In the present case, it argues that all of the relevant connecting factors, including the domicile and citizenship of the author, the location of authorship, and the contract of employment, point to France as the appropriate applicable law for determining first ownership. On Rio Tinto's argument, applying Canadian conflicts of laws rules to the issue of first ownership means that subsection 13(3) of the

Copyright Act, which represents the Canadian law with respect to first ownership of copyright, does not apply.

[32] Despite the contrary arguments put forward by Rio Tinto and those expressed by Professor Ginsburg, I conclude that section 13 of the *Copyright Act* applies to determine first ownership of the works in question, despite their being authored in France by a French national. I reach this conclusion for the following reasons.

[33] I begin with the proposition, accepted by both parties, that copyright law in Canada is entirely a creature of statute. That is to say, the existence of copyright that is protectable in Canada, and the scope and nature of that protection, is governed exclusively by the *Copyright Act*: *CCH Canadian Ltd v Law Society of Upper Canada*, 2004 SCC 13 at para 9. The *Copyright Act* was originally enacted to implement the terms of the *Berne Convention*: *Society of Composers, Authors and Music Publishers of Canada v Entertainment Software Association*, 2022 SCC 30 [*SOCAN v ESA*] at para 78. The *Copyright Act* should therefore be interpreted in light of the *Berne Convention* and other applicable treaties, but ultimately the Court is charged with interpreting and applying the *Copyright Act* as drafted by Parliament: *SOCAN v ESA* at paras 43–49; *Robertson v Thomson Corp*, 2006 SCC 43 at para 94.

[34] Part 1 of the *Copyright Act* governs copyright and moral rights in works. Within this Part, section 5 sets out conditions for the subsistence of copyright in Canada, including that the author be a citizen, subject or ordinary resident of a *Berne Convention* or other treaty country at the time of creation: *Copyright Act*, s 5(1)(a). There is no requirement in section 5 that copyright in the

work be recognized in its country of origin. Whether Canadian copyright subsists in a work is therefore a matter expressly dictated by the Canadian *Copyright Act*, without reference to the law of the jurisdiction in which the work is created. It is also clear that the *Copyright Act* is expressly intended to govern the works of foreign authors. This is consistent with the statement in Article 5(2) of the *Berne Convention* that the enjoyment and exercise of copyright is independent of the existence of protection in the country of origin of the work.

[35] Section 13 of the *Copyright Act* exists in this statutory context. As set out above, subsection 13(1) provides the general rule that the author of a work is the first owner of copyright therein. The subsection places no limitation on the nature of the work or the nationality of the author. On its face, it purports to apply to all works in which Canadian copyright subsists, and not simply those works created in Canada or by Canadians. In my view, the text, context, and purpose of subsection 13(1) indicate that Parliament intended the first ownership rule to apply to all works, regardless of where they were authored: *CCH* at para 9, citing *Bell ExpressVu Limited Partnership v Rex*, 2002 SCC 42 at para 26.

[36] Rio Tinto argues that section 13 only applies in circumstances where common law rules regarding conflicts of laws indicate that Canadian law, and not foreign law, applies to the question of first ownership. I cannot agree. Any Canadian common law rules regarding private international law must cede to Canadian legislative provisions. The interpretation of subsection 13(1) that I have reached above inherently ousts the application of any common law conflicts of laws rules that might otherwise prevail. Notably, subsection 13(1) expressly states that the only limits on the general rule of first ownership are those found in the *Copyright Act*

itself: "Subject to this Act, the author of a work shall be the first owner of the copyright therein" [emphasis added].

[37] The only limitation in the *Copyright Act* on the rule of first ownership in a work (as opposed to a performer's performance, a sound recording, or a communication signal) is that found in subsection 13(3) regarding works made in the course of employment. Again, nothing in the text or context of subsection 13(3) suggests that it is limited to employment relationships governed by Canadian law, to those with a Canadian employer and/or employee, or to works created in Canada. As noted, Part 1 of the *Copyright Act* recognizes and protects copyright in works created by any citizen, subject, or ordinary resident of a treaty country, including works created overseas by foreign authors. Given this, reading subsection 13(3) to apply only in cases where the "author," the "work," and/or the "employment" had sufficient connecting factors to Canada would read limitations into the subsection that are simply not supported by the text, the context, or the purpose of the statute. I conclude that subsection 13(3) defines the first owner of Canadian copyright in any work made in the course of employment, regardless of the location of that employment or the nationality or domicile of the employee or employer.

[38] As Professor Ginsburg notes, this interpretation may mean that the owner of Canadian copyright in a work is different than the owner of copyright in the same work in another country. However, this can always be the case since copyright in different territories can be assigned or transferred independently. In any event, the language chosen by Parliament effectively makes the legislative choice that first ownership of copyright protected in Canada will be governed by Canadian law, regardless of any resulting differences with the laws of other jurisdictions. While

international licensees may have to ensure they are licensing from the owner of copyright in each applicable country, this is the inherent result of copyright being protected internationally through the application of multiple domestic laws. Conversely, Rio Tinto's approach does not necessarily result in the simplicity sought by Professor Ginsburg, as it would result in a situation where a party looking to license or enforce Canadian copyright in multiple works would have to undertake separate inquiries into the domestic law of the country of origin of each work rather than simply looking to the rules of the *Copyright Act*.

[39] I am supported in this conclusion by the recent decision of this Court in *Fox Restaurant Concepts LLC v 43 North Restaurant Group Inc*, 2022 FC 1149. There, Associate Judge Horne addressed a motion to strike certain paragraphs in a statement of claim that asserted infringement of copyright and trademark. The statement of claim included an allegation that the works in which copyright was asserted, termed the "Fox Works," constituted "works for hire" under United States copyright law. In finding that the claim did not meet the requirements of Rule 174 of the *Federal Courts Rules*, Associate Judge Horne found the following:

> Whether the Fox Works are "works for hire" under United States law is immaterial. Copyright is a statutory scheme; copyright legislation simply creates rights and obligations upon the terms and in the circumstances set out in the statute. The legislation speaks for itself and the actions of a party must be measured according to the terms of the statute […]. The *Copyright Act* […] sets out the conditions for the existence, ownership and enforceability of copyright. What is material is whether the plaintiff can demonstrate ownership pursuant to the terms of the Canadian *Copyright Act*.
>
> [Emphasis added; citations omitted; *Fox Restaurant* at para 24.]

[40] Despite the fact that the "Fox Works" in question were apparently authored in the United States, Associate Judge Horne referred to subsection 13(3) and its statutory requirements, concluding that the statement of claim failed to allege employment or a contract of service, or to identify the authors of the works: *Fox Restaurant* at paras 25–26. While it does not appear that the arguments put forward by Rio Tinto on this motion were put before Associate Judge Horne, I agree with his conclusion that it is the *Copyright Act* that governs the existence and ownership of copyright in Canada, rather than the domestic law of the jurisdiction where copyright was created.

[41] While my conclusion is based on the Canadian *Copyright Act*, it is also supported to some degree by the French approach to ownership of foreign works. As set out in Me. Georges-Picot's affidavit, France's Cour de Cassation has concluded that in French copyright law, the laws of the country where protection is claimed, and not the country of origin of the work, determines ownership of copyright of a work: Cass Civ 1re, 10 avril 2013, nº 11-12.508, ECLI:FR:CCASS:2013:C100347. The Cour de Cassation based its conclusion on Article 5(2) of the *Berne Convention*, finding that the conflicts of laws rule in that article applies equally to the determination of first ownership of a work. The Cour de Cassation thus reached the opposite construction of Article 5(2) to that proposed by Rio Tinto in this case. As GEREC points out, this means that if the situation were reversed and this action were proceeding in France, the French courts would apply French domestic law, rather than section 13 of the *Copyright Act*, to determine first ownership of copyright in any subject works, including those authored in Canada.

[42] I therefore conclude that subsection 13(3) applies to the determination of first ownership of the works said to be authored by Mr. Chatron. There is no dispute that Mr. Chatron was employed by GE Hydro France and that the works he is said to have authored were made in the course of such employment. GE Hydro France is therefore the first owner of Canadian copyright in those works, absent an "agreement to the contrary."

(b) *There is no "agreement to the contrary"*

[43] Rio Tinto argues that the agreement between Mr. Chatron and GE Hydro France governing intellectual property rights contains an agreement contrary to the first ownership provision in subsection 13(3). It relies on the choice of law clause in the agreement and section B(ii) stating that Mr. Chatron assigns his copyright in works created in the context of his employment to GE Hydro France. Rio Tinto argues that these provisions show the parties' agreement that the French law of copyright should apply, and in particular that Mr. Chatron was to be first owner of copyright. I cannot agree.

[44] With respect to the choice of law clause, the parties' agreement that the contract between them was to be governed and interpreted according to the laws of France does not amount to an agreement that the domestic law of France will apply to the ownership of copyright internationally. Indeed, I question whether it was open to the parties to simply agree that French law would apply to proceedings for the enforcement of copyright in Canada. Canadian copyright law is domestic law governed by the *Copyright Act*. While subsection 13(3) provides that parties can reach a contrary agreement with respect to first ownership, the mere selection or application of a foreign law as governing an employment agreement does not have this effect.

[45] With respect to the assignment, I cannot read the simple fact that Mr. Chatron assigned his copyright to GE Hydro France as constituting an implicit agreement between the parties that Mr. Chatron would be the first owner of copyright in Canada despite subsection 13(3). Rather, the parties' concern, including through reference to articles in the IP Code, appears to be that GE Hydro France own copyright in the works. Notably, the provision is written in the first person ("I assign"/"*je cède*"), indicating that Mr. Chatron is assigning his copyright to GE Hydro France. Nothing in the provision indicates that GE Hydro France is agreeing to relinquish any copyrights that it has acquired through operation of law in foreign jurisdictions, or that it is agreeing that Mr. Chatron is the first owner of any works in such jurisdictions.

[46] I therefore conclude that Mr. Chatron and GE Hydro France did not enter into an "agreement to the contrary" so as to oust the application of subsection 13(3). That subsection applies, and GE Hydro France was therefore the first owner of Canadian copyright in any works authored by Mr. Chatron in the course of his employment.

[47] As Mr. Chatron was never the owner of copyright that is asserted in these proceedings, namely the Canadian copyright in the works created in France, he is not an assignor of the copyright in those works. Rio Tinto does not have the right to examine him pursuant to Rule 237(4).

B. *Rio Tinto has not established that leave should be granted under Rule 238*

[48] In the alternative to its arguments under Rule 237(4), Rio Tinto asks that it be granted leave to examine Mr. Chatron pursuant to Rule 238(1). That rule permits a party to seek leave to

examine for discovery a non-party "who might have information on an issue in the action," in the circumstances described in Rule 238(3):

Examination of non-parties with leave	**Interrogatoire d'un tiers**
238 (1) A party to an action may bring a motion for leave to examine for discovery any person not a party to the action, other than an expert witness for a party, who might have information on an issue in the action.	**238 (1)** Une partie à une action peut, par voie de requête, demander l'autorisation de procéder à l'interrogatoire préalable d'une personne qui n'est pas une partie, autre qu'un témoin expert d'une partie, qui pourrait posséder des renseignements sur une question litigieuse soulevée dans l'action.
[…]	[…]
Where Court may grant leave	**Autorisation de la Cour**
(3) The Court may, on a motion under subsection (1), grant leave to examine a person and determine the time and manner of conducting the examination, if it is satisfied that	**(3)** Par suite de la requête visée au paragraphe (1), la Cour peut autoriser la partie à interroger une personne et fixer la date et l'heure de l'interrogatoire et la façon de procéder, si elle est convaincue, à la fois :
(a) the person may have information on an issue in the action;	**a)** que la personne peut posséder des renseignements sur une question litigieuse soulevée dans l'action;
(b) the party has been unable to obtain the information informally from the person or from another source by any other reasonable means;	**b)** que la partie n'a pu obtenir ces renseignements de la personne de façon informelle ou d'une autre source par des moyens raisonnables;
(c) it would be unfair not to allow the party an opportunity to question the person before trial; and	**c)** qu'il serait injuste de ne pas permettre à la partie d'interroger la personne avant l'instruction;

(d) the questioning will not cause undue delay, inconvenience or expense to the person or to the other parties.	**d)** que l'interrogatoire n'occasionnera pas de retards, d'inconvénients ou de frais déraisonnables à la personne ou aux autres parties.

[49] I accept that Mr. Chatron may have information on one or more relevant issues in the action, and in particular questions of originality and authorship in respect of the works for which he is said to be an author. GEREC does not dispute this but contends that Rio Tinto overstates the importance of this information. I agree with Rio Tinto that even if the test for originality is an objective one, as GEREC contends with reference to recent UK jurisprudence, the evidence of an author's conduct remains relevant: *THJ Systems Limited & Anor v Daniel Sheridan & Anor*, [2023] EWCA Civ 1354 at paras 24–28. The Supreme Court has held that the standard for originality is that a work be "the product of an exercise of skill and judgment" and that an original work is one "that originates from an author and is not copied from another work": *CCH* at paras 24–25. I am satisfied Mr. Chatron may have information with respect to these issues.

[50] I am not satisfied, however, that Rio Tinto has been unable to obtain the information by other reasonable means. Rio Tinto points to its efforts to obtain information from Mr. Pot during the Rule 237(4) examination of GE Hydro France, and to the refusal by GEREC's counsel on that examination to give undertakings, which might have included undertakings to ask Mr. Chatron for his information. The propriety of that refusal is not before me on this motion. However, I agree with GEREC that this was not the only, or even the best, opportunity for Rio Tinto to obtain information from Mr. Chatron.

[51] The primary source of information in the possession, power, or control of an adverse party prior to trial is the process of documentary and oral discovery. Rio Tinto and Canmec have had the opportunity to examine a representative of GEREC for discovery, Mr. Boudreau. Excerpts of the transcript of that examination show that Mr. Boudreau was asked questions regarding information in the possession of Mr. Chatron, and GEREC provided responses to undertakings with respect to that information. While Rio Tinto expresses dissatisfaction with GEREC's answer to an undertaking regarding instructions provided by Mr. Chatron to the draftsperson ("*dessinateur*") of the drawings, the propriety or completeness of that answer is not before the Court on this motion. I cannot take this single answer as indicating that GEREC was generally unable or unwilling to provide information from Mr. Chatron.

[52] As noted above, the parties have recently undertaken a second round of examinations for discovery in accordance with the operative scheduling order in this matter. Although the transcript of those examinations was not before the Court, Rio Tinto indicated that GEREC had refused to give undertakings to seek further information from Mr. Chatron, on the ground that the questions were not proper follow-up to the answers previously provided. Again, the propriety of that position is not at issue on this motion. The current scheduling order provides for a date by which parties are to advise the Court if they intend to bring a motion to compel in respect of the follow-up examinations.

[53] Without in any way pronouncing on the outcome of such a motion, Rio Tinto has not satisfied me that it was unable to obtain Mr. Chatron's information through "other reasonable means," and in particular the usual means by which such information would be obtained in

litigation in this Court. Rio Tinto had the opportunity to seek information from Mr. Chatron through the discovery process, including during the initial examinations for discovery of GEREC.

[54] It may be there are questions that Rio Tinto now wishes it had asked GEREC to put to Mr. Chatron during examinations for discovery. Rio Tinto puts forward in its written argument some of the questions it wants to ask Mr. Chatron: How did he exercise his talent and judgment in the face of limitations and technical requirements set out in Rio Tinto's bid documents? To what extent was he inspired by, or did he copy, old drawings provided by Rio Tinto? However, Rio Tinto has not satisfied me that these questions could not have been asked by way of undertaking on the examination for discovery of Mr. Boudreau as GEREC's representative.

[55] Leave will not be granted to conduct an examination under Rule 238 simply to allow a party to seek information that it could have sought in examination for discovery of an adverse party but neglected to or chose not to. Rule 238(3)(b) makes this clear. As Justice Harrington put it, a party "cannot studiously avoid asking for an undertaking then move to examine [a witness] as a non-party" under Rule 238: *Hershkovitz v Tyco Safety Products Canada Ltd*, 2006 FC 1228 at para 28.

[56] I am therefore not satisfied that the conditions for granting leave to examine Mr. Chatron as a third party under Rule 238 have been met.

IV. Conclusion

[57] As Rio Tinto is not entitled to examine Mr. Chatron as an assignor under Rule 237(4), and has not satisfied me that leave should be granted to examine him under Rule 238(1), Rio Tinto's motion is dismissed.

[58] The parties agreed that the successful party should have its costs of this motion in the amount of $3,000, plus reasonable disbursements including expert fees, payable in any event of the cause. Costs are awarded to GEREC on this basis.

ORDER IN T-1471-21

THIS COURT ORDERS that

1. The motion is dismissed.
2. Rio Tinto Alcan Inc shall pay to GE Renewable Energy Canada Inc costs of this motion in the amount of $3,000, plus reasonable disbursements including expert fees, payable in any event of the cause.
3. No costs are awarded in favour or against Canmec Industrial Inc.

"Nicholas McHaffie"
Judge

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET:	T-1471-21
STYLE OF CAUSE:	GE RENEWABLE ENERGY CANADA INC v CANMEC INDUSTRIAL INC ET AL
PLACE OF HEARING:	MONTREAL, QUEBEC
DATE OF HEARING:	FEBRUARY 20, 2024
ORDER AND REASONS:	MCHAFFIE J.
DATED:	FEBRUARY 28, 2024

APPEARANCES:

Michael Crichton Marc Crandall	FOR THE PLAINTIFF
Joanne Chriqui Lucie Tormier	FOR THE DEFENDANT
Joanie Lapalme David Turgeon	FOR THE THIRD PARTY

SOLICITORS OF RECORD:

GOWLING WLG (CANADA) LLP Ottawa, Ontario	FOR THE PLAINTIFF
ROBIC LLP Montreal, Quebec	FOR THE DEFENDANT
FASKEN MARTINEAU DUMOULIN LLP Montreal, Quebec	FOR THE THIRD PARTY