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BIM & INTELLECTUAL PROPERTY RIGHTS IN IRELAND

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- A Public Sector BIM Adoption Strategy, 15th March 2017.
- Accelerating take up of BIM at Level 2.
- Concerns raised (especially by architects and engineers) in relation to the protection of designs and intellectual property.

“Does the adoption of BIM change the legal position in relation to the protection of designs and intellectual property?”

Approach

- Review legal position in Ireland.
- Consider authorities / commentaries.
- Case law (very sparse).
- Conclusions.



- Primary right which a designer in construction can claim is copyright.
- Copyright & Related Rights Act 2000 (CRRA 2000).
- Owner is “*author*” or person who creates a work.
- The “*author*” is the first owner of the copyright.
- Work made by an employee in the course of employment, the employer is the first owner of the copyright.
- Copyright is a negative right preventing the reproduction, including copying of physical material.



- Under S.37, CRRA 2000, the owner has exclusive right to authorise others to:-
 - a) Copy the work;
 - b) Make the work available to the public;
 - c) Make an adaption of the work.
- Each of these acts are “*acts restricted by copyright*” and copyright is infringed if any of these acts are done without the consent of the owner / author of copyright.
- Computer generated works and original databases can benefit from copyright protection (CRRA 2000, S.30 & S17.2).
- Certain acts are exempted e.g. back-up copy of a computer programme or anything done for the purposes of reconstructing a building.
- Work must be original, must originate with the author, must be more than a copy of other material, should demonstrate the exercise of skill or judgement and should be an act of individuality.
- *MacMillan & Co Ltd v K & J Cooper* [1923] 58 CLR 479 (Privy Council). Plaintiff was copyright holder of North’s translation of Plutarch’s Life of Alexander, Defendant edited and abridged this work. Court held that the Defendant left out unimportant bits and verbiage and this was not an act of creation.



- Architects' and Engineers' plans can benefit from copyright protection (CRRA, S 2(1)).
- *“Architects plans can be protected as such, whether they be of a building or the floor layout of a house or building or a shopfront. Engineering plans are also artistic works” (Intellectual Property Law in Ireland, (2nd Edition), Clarke & Smith, p227).*
- *“The Architect must be able to prove that his particular design is unusual or original to such an extent that it is unlikely that any other architect would have come to the same design solution. This is difficult to establish in practice.....If an architect can show that the design derived from a well known example of the house type, then similarity to other designs also so derived would not constitute infringement of copyright” – David Keane, The RIAI Contracts, 4th Revised Edition, 2001, p. 82. [Emphasis added]*
- *Meshworks Inc v Toyota Motor Sales USA Inc, 528 D. 3d 1258 (10th Cir. 2008).*
 - Wireframe mesh models of car designs;
 - Produced by digitising physical cars to produce exact replicas;
 - Court held did not include anything original and did not deserve copyright protection.



- Most commentators indicate that the real requirement at BIM Level 2 is for licences.
- *“It is the conclusion of this paper, that although BIM may involve radical changes to the construction industry on the ground, there will be no radical changes to the legal framework of the industry generally” – Leslie Currie, “Building Information Modelling: It’s Impact on Insurance, Intellectual Property Rights and Design Liability”, SCL Paper May 2014.*
- *“The advent of BIM means that the protection of copyright and other IP rights should be considered afresh although BIM (Level 2) in itself does not really change anything in respect of IP rights or law, the creation and use of BIM will require the use of copyright material. Therefore copyright licences in the project documentation should now allow for copyright material to be used in BIM” – Burges Salmon LLP, Lexology, 28th January 2014. [Emphasis added]*
- Most standard form contracts such as the CIC BIM Protocol address the issue of IPR and provide for licencing.



- Clause 6 *“Use of Models”*.
- Any rights (including copyright) shall remain with the designer. (Clause 6.2).
- Grants non-exclusive licences to transmit, copy and use the models for the *“Permitted Purpose”*.
- *“Permitted Purpose”* is defined as *“.....purpose related to the Project (for the construction, operation and maintenance of the Project) which is consistent with the applicable Level of Detail of the relevant Model (including a Model forming part of a Federated Model) and the purpose for which the relevant Model was prepared”* (Clause 6.3).
- Under the BIM Protocol a designer grants a licence to others to use the model for the purpose for which it was prepared.



- *Trant Engineering Limited v Mott MacDonald Limited* [2017] EWHC 2061 (TCC), 5th July 2017: TCC considered access to the BIM Model as part of a construction dispute.
- £55million Mid-Atlantic Power Project to construct a power station on the Falkland Islands.
- Contract with Ministry of Defence, Work Contractors Conditions of Contract, FCOM 200, Edition 2, 2005.
- MML was carrying out design consultancy services for Trant.
- The design consultant was the BIM coordinator and controlled access to the common data environment.
- The design consultant withdrew access to the BIM model in a dispute over fees payable.
- Trant argued that without access to the design data the project cannot be progressed. Project would be forced back to square one.
- Court ordered the design consultant to permit access to the BIM model subject to Trant making a payment into court.



- BIM Objects not available from manufacturers.
- Created by designer at considerable cost.
- By sharing models, others have the ability to change the model and recreate new sets of drawings and schedules without the approval of the original designer.
- The question is whether the design is sufficiently “*unique*” or “*individual*”.
- If so, it can and should be protected by licencing in the project documentation.
- In any event, factor in the cost.



- Copyright in buildings and models for buildings is protected under Irish Legislation.
- To assert copyright, design must be innovative, unusual and / or original and this may not be easy to establish.
- Under legislation, copyright owner may authorise a third party to use the work or make the work available to others.
- The CIC BIM Protocol provides a licencing structure to facilitate the transmission, copying and use of BIM models on a project.
- BIM Level 2 does not appear to change anything in respect of IP Rights or Law.
- BIM Level 3 (a wholly integrated model) may raise different issues of ownership of copyright.

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Thank you

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