

Spectacles like football, hockey, or roller derbies, however thrilling, have been found not to be dramatic works. One reason given was their unpredictability: "no one bets on the outcome of a performance of *Swan Lake*," as one court put it.<sup>34</sup> Someone might very well bet on the outcome of an amateur or postmodernist version of the ballet, but, that apart, this test unwittingly excludes much improvisational theatre and performance art. Perhaps it is getting harder to distinguish between sport and theatre, but it is not hard to see why dramatists and performers might, more than sports participants and coaches, need copyright to protect their livelihoods. A test that relies more on sociology than on essentialism may work better here. It would also serve to explode a developing myth that sports competitors have some copyright in their "moves," despite the intriguing prospect of enlivening Olympic medal ceremonies by the added spectacle of writ service.

#### a) Film, Video, and Formats

The *Act* protects "any cinematograph." This term includes "any work expressed by any process analogous to cinematography," such as movies and material recorded electronically on any medium (e.g., video or computer disk), including probably the soundtrack.<sup>35</sup> A work may qualify even though it is not a "cinematograph production where the arrangement or acting form or the combination of incidents represented give the work an original character."<sup>36</sup> Before 1994, only such "original character" productions were classed as "dramatic"; films without this characteristic — telecasts of live events like football or of hosted rock video programs like Terry David Mulligan's *Good Rockin' Tonight* — were simply protected as a series of photographs.<sup>37</sup> Today, both classes of production are considered to be dramatic works.

Radio and television formats are problematic. In 1933 the format for a children's radio sketch was protected because the structure of the show was clearly worked out,<sup>38</sup> but, more recently, a British television

34 *FWS Joint Sports Claimants v. Canada (Copyright Board)* (1991), [1992] 1 F.C. 487 at 495 (C.A.) [FWS].

35 *C Act*, above note 1, s. 2, defs. "dramatic work" and "cinematograph." Compare W.L. Hayhurst, "Audiovisual Productions: Some Copyright Aspects" (1994) 8 I.P.J. 319, at 326–28. The Bill C-32 (above note 9) def. of "sound recording" provides that a film soundtrack has no separate copyright as a sound recording.

36 This "original character" criterion is still relevant to the length of protection. See section F, "Duration," in this chapter.

37 *Canadian Admiral Corp. v. Rediffusion Inc.* [1954] Ex.C.R. 382 at 401 [Canadian Admiral].

38 *Kantel v. Grant*, [1933] Ex.C.R. 84 [Kantel].

game-show format was denied copyright because it lacked certainty or unity: each show was different and did not "perform" the format.<sup>39</sup> The format for Mulligan's *Good Rockin' Tonight* was also thought to be unprotected because it had no story line or dramatic incident; but a format structured around the concept of a place where information on the "Top of the Pops" was gathered with high-tech equipment "lent enough dramatic incident and seminal story line" to qualify as a "dramatic work."<sup>40</sup> The distinction seems arbitrary.

## 6) Artistic Work

The following artistic works are specified in the Act: "paintings, drawings, maps, charts, plans, photographs, engravings, sculptures, works of artistic craftsmanship, . . . [and] architectural works," and "illustrations, sketches and plastic works relative to geography, topography, architecture or science."<sup>41</sup> For a non-specified work to qualify as artistic, one court has insisted that it "to some degree at least, be a work that is intended to have an appeal to the aesthetic senses not just an incidental appeal, . . . but as an important or one of the important objects for which the work is brought into being."<sup>42</sup> Coloured rods for teaching arithmetic to youngsters were found to fall outside this definition. More recently, however, coloured labels for file folders were thought to be artistic works. The court said that "artistic work" was simply "a general description of works which find expression in a visual medium as opposed to works of literary, musical or dramatic expression."<sup>43</sup> This approach seems the better view.

39 *Green v. Broadcasting Corp. of New Zealand*, [1989] 3 N.Z.L.R. 18 (C.A.), aff'd [1989] 2 All E.R. 1066 (P.C.).

40 *Hutton v. Canadian Broadcasting Corp.* (1989), 102 A.R. 6 at 39 (Q.B.), aff'd (1992), 120 A.R. 291 (C.A.). Formats may be alternatively protected on breach of confidence or unjust enrichment principles: *Promotivate International Inc. v. Toronto Star Newspapers Ltd.* (1985), 53 O.R. (2d) 9 (H.C.J.) [*Promotivate*]; R. Casswell, "A Comparison and Critique of Idea Protection in California, New York, and Great Britain" (1992) 14 Loyola L.A. Int'l. & Comp. L.J. 717.

41 C Act, above note 1, s. 2, defs. "artistic work" and "every original . . . artistic work."

42 *Cuisenaire v. South West Imports Ltd.*, [1968] 1 Ex.C.R. 493 at 514, aff'd on other grounds [1969] S.C.R. 208.

43 *DRG Inc. v. Datafile Ltd.* (1987), [1988] 2 F.C. 243 at 253 (T.D.), aff'd (1991), 35 C.P.R. (3d) 243 (Fed. C.A.) [*DRG*]. The design, however, lacked copyright protection because it should have been registered as an industrial design. See section B(7) in this chapter.

### a) Drawings, Plans, Paintings

A drawing is simply "lines drawn on paper" or any other medium; included are sketches, illustrations, silhouettes, and pattern sheets cut from drawings.<sup>44</sup> The subject is irrelevant: landscapes, cartoons, engineering and architectural drawings and plans, even ideograms depicting items in a food store, are all included.<sup>45</sup>

There is an anomalous U.K. decision that asserts that "painting" does not include facial make-up and, moreover, that "[t]wo straight lines drawn with grease-paint with another line in between them drawn with some other colouring matter . . . by itself could not possibly attract copyright."<sup>46</sup> Neither comment is particularly persuasive. Most paintings are intended for hanging, but not all: body painting and tattooing are among the oldest known arts. Similarly, the court's views on minimalist art is inconsistent with the legal position on drawings and would discriminate among different schools of art. Constable's expressionism and Barnett Newman's vertical stripe on a plain coloured field should be equal candidates for copyright.

### b) Photographs

This category includes photolithographs and "any work expressed by any process analogous to photography."<sup>47</sup> Both amateur and professional photographs are protected. No negative or other plate is required, so images produced by electronic cameras or xerography, photographs stored on computer disks, and holograms should all be protectable.<sup>48</sup> The fleeting images seen on a television screen or a computer monitor should, however, not qualify.<sup>49</sup> A single frame of a movie — perhaps enlarged for use as a poster — was formerly considered a photograph, since very often the whole film was classed in this way; but today the frame is probably protected as part of the dramatic work (the cinematograph) in which it appears.<sup>50</sup>

<sup>44</sup> *Lerose Ltd. v. Hawick Jersey International Ltd.* (1972), [1974] R.P.C. 42 at 47 (Ch.).

<sup>45</sup> *Spiro-Flex Industries Ltd. v. Progressive Sealing Inc.* (1986), 13 C.P.R. (3d) 311 (B.C.S.C.); 2426-7536 *Quebec Inc. v. Provigo Distribution Inc.* (1992), 50 C.P.R. (3d) 539 at 543 (Que. S.C.) [2426-7536].

<sup>46</sup> *Merchandising Corp. of America Inc. v. Harphond* (1981), [1983] E.S.R. 32 at 47 (C.A.). The case involved pop singer Adam Ant's three coloured lines of greasepaint, supposedly mimicking Native Indian warpaint.

<sup>47</sup> C Act, above note 1, s. 2, def. "photograph."

<sup>48</sup> C Act, *ibid.*, ss. 10(1)(b) & 10(2)(b).

<sup>49</sup> See *Canadian Admiral*, above note 37, although the conservative approach there taken on what constitutes photography and its analogues no longer holds.

<sup>50</sup> *Spelling Goldberg Productions Inc. v. BPC Publishing Ltd.*, [1981] R.P.C. 283 (C.A.).

What of a photograph that is scanned into a computer and then electronically manipulated, so that some or all of its features no longer resemble the original? At some stage, the photograph presumably loses its identity as such and dissolves into a generic artistic work or perhaps an original electronic "painting."<sup>51</sup> This classification presumably will depend on the degree of artistry used and the extent to which the result differs from the original scanned work.

### c) Engraving and Sculpture

Engravings include "etchings, lithographs, woodcuts, prints and other similar works, not being photographs"; sculpture includes "casts and models," presumably for the purpose of sculpture.<sup>52</sup> Both the original engraved plate and the prints made from it are included, as are moulds and graphic labels produced by a non-photographic process from a photographic plate.<sup>53</sup>

Work outside traditional art, such as Hogarth or Rodin, can qualify. In New Zealand a wooden model of a frisbee was classed as a sculpture — the expression in three-dimensional form of a sculptor's idea — but not the frisbees themselves, which were produced through injection-moulding.<sup>54</sup> Elsewhere machine parts and the moulds used to stamp them have been denied protection. They were not engravings, because this technique "has to do with marking, cutting or working the surface — typically, a flat surface — of an object," not (as the New Zealand case had claimed) shaping an object by cutting. Nor were they sculptures: while "some modern sculptures consist of or include parts of machines, . . . that does not warrant the conclusion that all machines and parts thereof are properly called sculptures."<sup>55</sup> These decisions will hardly be the last word on this subject.

### d) Artistic Craftsmanship

A work of artistic craftsmanship is usually the product — typically durable and handmade — of an artist-craftsperson. The work need have no artistic merit, nor need be bought for its aesthetic appeal. Whether a

51 Categorization may be important because photographs are protected for a flat fifty years, while generic art works and paintings are protected for fifty years past the author's death. See section F, "Duration," in this chapter.

52 C Act, above note 1, s. 2, defs. "engraving" and "sculpture."

53 DRG, above note 43 at 546.

54 *Wham-O Manufacturing Co. v. Lincoln Industries Ltd.*, [1984] 1 N.Z.L.R. 641 (C.A.).

55 *Greenfield Products Pty. Ltd. v. Rover-Scott Bonnar Ltd.* (1990), 95 A.L.R. 275 at 284–85 (Austl. Fed. Ct.). See section B(7), "Industrial Design," in this chapter.

work qualifies is judged objectively, aided by the expert evidence of designers and artisans. What the producer intended, how she proceeded, and what resulted are key issues. Chippendale chairs, Cellini candelabra, Coventry Cathedral tapestry, stained-glass windows, hand-painted tiles, and wrought-iron gate work have been instanced as works of artistic craftsmanship. Clothing, coloured rods for teaching children mathematics, and mass-produced toys have not qualified.<sup>56</sup>

### e) Architecture

An "architectural work" means "any building or structure or any model of a building or structure."<sup>57</sup> This description, like some modern architecture itself, has shed its rococo elements over the years. Between 1924 and 1988 the definition referred to an architectural work of art, demanded an artistic character or design of the building or structure, and confined protection to that character or design. Judges progressively elevated this requirement virtually into one of novelty, over and above the requirement of originality.<sup>58</sup> Prefabricated cottage kits were found to lack copyright since they had no "panache," "flair," "individualism," "distinctiveness," or "uniqueness": "Are the homes novel in an artistic sense? Are they set apart in some way from what one generally sees?" asked one judge, sounding like a real estate broker's questionnaire.<sup>59</sup> Finding "panache" or its synonyms should no longer be needed. Designs for any sort of building (even mass-produced low-cost housing) and products of landscape architecture, such as garden or golf course layouts, are protectable.<sup>60</sup>

Architecture may also be protected through the copyright in underlying drawings and plans. To copy the interior or exterior design of a house or store, or distinctive features that make up a substantial part of the design, may be to copy indirectly the two-dimensional plans

56 *George Hensher Ltd. v. Restawile Upholstery (Lancaster) Ltd.* (1974), [1976] A.C. 64 (H.L.); *Merlet v. Mothercare* (1984), [1986] R.P.C. 115 (Ch.), appeal dismissed (1985), [1986] R.P.C. 129 (C.A.), leave to appeal refused, [1986] R.P.C. 135 (H.L.); *Eldon Industries Inc. v. Reliable Toy Co.* (1965), [1966] 1 O.R. 409 (C.A.).

57 *C Act*, above note 1, s. 2, def. "architectural work."

58 *C Act*, *ibid.*, s. 5(1).

59 *Viceroy Homes Ltd. v. Ventury Homes Inc.* (1991), 34 C.P.R. (3d) 385 at 389-91 (Ont. Gen. Div.), appeal dismissed, filed on minutes of settlement (22 October 1996), (Ont. C.A.) [unreported] [emphasis in original].

60 *Hay v. Sloan*, [1957] O.W.N. 445 (H.C.J.); *Half Court Tennis Pty. Ltd. v. Scymour* (1980), 53 F.L.R. 240 (Q.S.C.). Naval architecture may also possibly be protected; *Bayliner Marine Corp. v. Doral Boats Ltd.* (1985), [1986] 3 F.C. 346 (T.D.), *rev'd* on other grounds [1986] 3 F.C. 421 (C.A.), to the contrary, on the pre-1988 definition, may not apply today.



from which the house was built; the copier may infringe without having ever seen the plans.<sup>61</sup>

## 7) Industrial Design

Much artistic work is devoted to making products attractive to buyers and users. The *Copyright Act* removes full copyright protection from some of this "applied" artwork, applied as a design to a finished "useful article" such as a vase, kettle, or boat, but not an ornamental sculpture, if more than fifty copies of the article are made.<sup>62</sup> This means that a Chanel "original" may be fully protected by copyright; so may any other original dress design, until the fifty-first dress is made anywhere with the copyright owner's consent. Then anybody can copy the dress (a useful article) without infringing any copyright in it or any preliminary sketches and patterns. They cannot, however, copy or photograph the sketches or patterns themselves; these are merely "carrier[s] for artistic or literary matter," and so are not useful articles.<sup>63</sup>

The only protection that designs for mass-produced useful articles may receive comes from the *Industrial Design Act*.<sup>64</sup> The design must first be registered on the industrial design register after an application for it is examined and accepted by the Industrial Design Branch of the Canadian Intellectual Property Office. All World Trade Organization members may apply for this protection, which runs for ten years from registration against copiers and independent creators alike.<sup>65</sup> The design must be "original," in that it must (a) not be copied, (b) result from some "spark of inspiration," and (c) either differ from earlier designs or be applied to a new use.<sup>66</sup> About 2000 design registrations are issued annually.

61 *New Brunswick Telephone Co. v. John Maryon International Ltd.* (1981), 33 N.B.R. (2d) 543 (C.A.) [*John Maryon*]; 2426–7536, above note 45 at 543–44.

62 *C Act*, above note 1, s. 64.

63 *C Act*, *ibid.*, *Industrial Design Act*, R.S.C. 1985, c. 1-8, s. 2 [*ID Act*], defs. "useful article" and "utilitarian."

64 Common law protection may occasionally be had for product shapes that function like trade-marks, where the market recognizes them as coming from a particular producer (whose identity need not be known): *Reckitt & Colman Products Ltd. v. Borden Inc.*, [1990] 1 All E.R. 873 (H.L.) (the yellow, lemon-shaped JIF lemon-juice container could not be imitated).

65 *C Act*, above note 1, s. 10(1).

66 *ID Act*, above note 63, s. 7(2); *Bata Industries Ltd. v. Warrington Inc.* (1985), 5 C.I.P.R. 223 at 231–32 (Fed. T.D.). This is a stiffer test than originality for copyright; see section C(1) in this chapter.

Such design artwork has been treated differently from regular fine artwork at least since the nineteenth century. The originals that Turner produced from his atelier were thought to deserve long-term copyright protection more than the long runs of pottery that the Wedgwood factory turned out. Today, this differential treatment may perhaps be justified because (1) designers are more likely to be on a payroll than are artisans, who (together with their heirs) may depend more on copyright for their subsistence; (2) industrial designs change frequently and firms can usually amortize their costs and reap a profit within a decade; (3) imitation is more desirable in the commercial sphere than in the fine arts. This distinction is, of course, highly debatable, and some of it applies equally to the utilitarian articles that copyright does protect. Copyright continues to benefit from the image of the starving author in the garret, whereas the designer sitting in front of a computer monitor in an air-conditioned high-rise office tower rarely excites much parliamentary sympathy.<sup>67</sup>

The attempt to draw a bright line between fine art and industrial design is unfortunately undermined by the list of bric-à-brac that is specifically allowed to retain full copyright: trade-mark designs, labels, architectural works, textile designs, character merchandising items, pictures on mugs, articles sold in a set (unless more than fifty sets are made), and anything else the government feels like adding by regulation.<sup>68</sup> These items may also qualify for cumulative protection under the *Industrial Design Act*. Moreover, designers of mass-produced cloth receive full copyright protection, but designers of mass-produced clothing do not, revealing the arbitrariness of the policy separating industrial designs from copyright. Design policy in many other jurisdictions is equally incoherent.

## 8) Musical Work

A musical work is defined as "any work of music or musical composition, with or without words." This definition replaces one in effect until 1993 which covered only "any combination of melody and harmony, or either of them, printed, reduced to writing or otherwise graphically produced

67 In fact, both employees and freelancers under contract have no design rights; these rights vest automatically in their employer: *ID Act*, above note 63, s. 12(1).

68 *C Act*, above note 1, s. 64(3); D. Vaver, "The Canadian Copyright Amendments of 1988" (1988) 4 I.P.J. 121 at 132-38; W.L. Hayhurst, "Intellectual Property Protection in Canada for Designs of Useful Articles" (1989) 4 I.P.J. 381.

or reproduced.<sup>69</sup> Experimental and aleatory music that had difficulty complying with the pre-1993 definition should now qualify more easily.

Problems with avant-garde music were not, however, the main reasons for the 1993 amendments. They were prompted by some odd interpretations of the Act that exonerated microwave and cable transmitters of music from any obligation to pay royalties to right-holders. These operators argued that copyright extended to communication of "the work"; their transmissions were not of "the work" because they did not transmit any "graphically produced" version; all they communicated was an acoustic presentation of the work. This, they claimed, fell outside the copyright owner's control. The courts agreed.<sup>70</sup> These decisions meant that virtually the only communications a copyright owner could control were those that featured a picture of the sheet music! Protests from the musical performing rights societies caused Parliament to drop the "graphic reproduction" requirement. At the same time, the "melody and harmony" requirement was also removed, presumably to avoid arguments that such works as drum solos were not protected.

Rearrangements, such as different piano versions of an opera score, have also long been protected as musical works. Each different arrangement can have its own separate copyright.<sup>71</sup> In practice, much early classical and jazz music remains in copyright, though its composer is long dead and buried; for the arranger who rejigs Beethoven's "Moonlight" Sonata for beginners by simplifying the source and including fingering, dynamic marks, tempo indications, slurs, and phrasing has copyright in her original arrangement.<sup>72</sup> Beethoven's descendants are entitled only to bathe in their forebear's reflected glory.

Similarly, a performer also has a limited copyright in his or her performance, distinct from any copyright in the work performed.<sup>73</sup>

69 *Copyright Act*, R.S.C. 1985, c. C-42, as am. by S.C. 1993, c. 23, s. 1.

70 *C Act*, above note 1, s. 3(1)(f); *C.A.P.A.C. Ltd. v. CTV Television Network*, [1968] S.C.R. 676; *Canadian Cable Television Assn. v. Canada (Copyright Board)*, [1993] 2 F.C. 138 (C.A.) [*Canadian Cable*].

71 *Wood v. Boosey* (1867), L.R. 2 Q.B. 340.

72 *Consolidated Music Publishers Inc. v. Ashley Publications Inc.*, 197 F. Supp. 17 at 18 (1961).

73 See section B(12), "Performances," in this chapter.



## 9) Compilation

Compilation is defined as a work resulting "from the selection or arrangement of literary, dramatic, musical or artistic works or of parts thereof" or of data.<sup>74</sup> A compilation of literary works is itself a literary work, a compilation of artistic works is an artistic work, and so on. A compilation of data — such as an electronic database — is classified according to the type of data: for example, literary material becomes a compilation of literary works. A mixed compilation — such as literary and artistic work — is classed according to whether the literary or artistic work makes up its "most substantial part."<sup>75</sup> This formula may prove troublesome. Is a catalogue of paintings that intersperses text "literary" or "artistic" in its "most substantial part"?

Just gathering data and sorting them in an obvious way may not involve "selection or arrangement," and so may not result in a protectable compilation.<sup>76</sup> In the United States this restriction has meant there is no protection for white pages telephone directories: either they lack any selection or arrangement at all or the purely alphabetic selection or arrangement is too commonplace or mechanical to be original.<sup>77</sup> Items like encyclopedias, dictionaries, anthologies, radio and television guides, betting coupons, and advertising brochures that select and arrange material from various sources, collections of "one-write" business forms, and trade catalogues, all protected before 1994,<sup>78</sup> may still qualify under the more rigorous test because they involve more than industrious collection. Items like book or customer lists, sports pro-

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74 Copyright Act, R.S.C. 1985, c. C-42, s. 2, def. "compilation," as am. by North American Free Trade Agreement Implementation Act, S.C. 1993, c. 44, s. 53(3) [NAFTA I A]. This overturns the view that only compilations of literary works were protected in Canada: *Re Royalties for Retransmission Rights of Distant Radio and Television Signals* (1990), 32 C.P.R. (3d) 97 at 146 (Copyright Bd.), aff'd (sub nom. *Canadian Cable Television Assn./Assn. Canadienne de Télévision par Cable v. American College Sports Collective of Canada Inc.*) [1991] 3 F.C. 626 (C.A.) [Royalties]. The "broadcast day," denied protection by this decision, has since been protected as a compilation of dramatic works: *Re Royalties for Retransmission Rights of Distant Television Signals 1995-1997* (28 June 1996), (Copyright Bd.) [not yet reported] [Royalties 1995-7].

75 C Act, above note 1, s. 2, 1(1).

76 *Laurier*, above note 8 at 415-16.

77 *Feist Publications Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991) [Feist]. See section C(1), "Originality," in this chapter.

78 *Bulman Group Ltd. v. "One Write" Accounting Systems Ltd.*, [1982] 2 F.C. 327 (T.D.); *Slumber-Magic Adjustable Bed Co. v. Sleep-King Adjustable Bed Co.*, (1985), 3 C.P.R. (3d) 81 (B.C.S.C.).

grams or fixtures, yellow pages business directories, and driver training manuals collecting mainly government material may involve little more than industrious collection and so may now attract closer scrutiny.<sup>79</sup>

## 10) Title of a Work

A "work" is defined to include "the title thereof when such title is original and distinctive."<sup>80</sup> The idea that this definition might confer a separate copyright on titles was rejected in 1939: the song title "The Man Who Broke the Bank at Monte Carlo" could be used for a movie without any permission from the song's copyright owner. Titles neither had a separate copyright nor were a substantial part of the work, unless they involved substantial literary composition, as did eighteenth-century full-page book titles that epitomized the book.<sup>81</sup> But the fancy graphics in which a book or film title is presented may have copyright. The unauthorized marketing of T-shirts carrying the *Crocodile Dundee* movie logo was stopped this way.<sup>82</sup>

Titles for periodicals or series (e.g., "Essentials of Canadian Law") may be registered as trade-marks, and any title may also be protected through passing-off law if it is not descriptive and if it has a market reputation.<sup>83</sup> So nobody may issue a rival *Globe and Mail*, except perhaps as an isolated spoof. By contrast, the publisher of a book called *Intellectual Property Law* cannot stop later texts from bearing the same descriptive name, so long as their get-up and marketing do not misrepresent the one as the other. The employee who quit the firm that was marketing a work under the descriptive name *Who's Who in Canada* could start up a rival publication called *The Canadian Who's Who*. The imprint, appearance, and price of the two works differed enough to prevent buyers from confusing the two.<sup>84</sup>

79 Compare *Tele-Direct (Publications) Inc. v. American Business Information Inc.* (1996), 113 F.T.R. 123 (T.D.), (listings in yellow pages directory not "original") [*Tele-Direct*]; *Ecole de Conduite Tecnic Aube Inc. v. 1509 8858 Québec Inc.* (1986), 12 C.I.P.R. 284 at 298ff (Que. S.C.); *Index Téléphonique (N.L.) de Notre Localité v. Imprimerie Garceau Ltée* (1987), 18 C.I.P.R. 133 at 140-41 (Que. S.C.).

80 C. Act, above note 1, s. 2, def. "work"; R. Stone, "Copyright Protection for Titles, Character Names and Catch-Phrases in the Film and Television Industry" (1996) 7 Ent. L. Rev. 178.

81 *Francis, Day & Hunter Ltd. v. Twentieth Century Fox Corporation Ltd.* (1939), [1940] A.C. 112 (P.C.). There was no passing-off, since nobody thought the film was based on or included the song.

82 *Paramount Pictures Corp. v. Howley* (1991), 39 C.P.R. (3d) 419 at 426 (Ont. Gen. Div.).

83 Generally, see chapter 4, "Trade-marks."

84 *International Press Ltd. v. Tunnell*, [1938] 1 D.L.R. 393 (Ont. C.A.).

## 11) Sound Recordings

Records, “perforated rolls and other contrivances by means of which sounds may be mechanically reproduced” have their own separate copyright distinct from that in the music or lyrics recorded. The recording may in fact be protected even though what it records is not — if, for example, it is public domain music, bird calls, crashing waves, or spontaneous conversation.<sup>85</sup> Bill C-32 would modernize the antiquated language of such phrases as “perforated rolls.” Sound recording would become “a recording, in any material form, consisting exclusively of sounds, whether or not of a performance of a work.” Film soundtracks would be specifically excluded: they would come under the film’s copyright.<sup>86</sup>

Bill C-32 would also allow record companies to collect money from public performances and broadcasts of their records, and also blank audio tape royalties.<sup>87</sup>

## 12) Performances

Since 1996 performers from World Trade Organization states have been able to prevent the unauthorized recording and broadcasts of their performances. This coverage includes improvisations, whether the work performed is in or out of copyright.<sup>88</sup> Protection applies retrospectively to unauthorized recordings made up to fifty years before — for example, of live Beatles or Elvis Presley concerts.

Bill C-32 would allow performers also to collect money from the rental, public performance, or broadcast of records containing their performances, as well as blank tape royalties.<sup>89</sup>

## 13) Broadcasts

Presently, a broadcaster who televises or broadcasts a live event acquires copyright in it as a cinematograph work if the event is simultaneously recorded. There is no protection for unfixed broadcasts, but the selection of programs transmitted during a twenty-four-hour or other longer

85 C Act, above note 1, s. 5(3); *Bouliane v. Service de Musique Bonanza Inc.* (1986), 18 C.I.P.R. 14 (Que. C.A.).

86 Bill C-32, above note 9, def. “sound recording.”

87 *Ibid.*, introducing cls. 18(1), 19–20, & 81.

88 C Act, above note 1, s. 14.01(1) & s. 2, def. “performer’s performance.”

89 Bill C-32, above note 9, cls. 15–17, 19–20, & 81. See section A(1), “Copyright for Non-traditional Subject Matter: Bill C-32 of 1996,” and section H, “Owner’s Rights: Sound Recordings, Performances, Broadcasts,” in this chapter.

period ("the broadcast day"), unprotected before 1994, was recently held to be protectable as an original compilation of dramatic works.<sup>90</sup>

Bill C-32 would give broadcasters located in a World Trade Organization or *Rome Convention* state a copyright over unauthorized recording and reproduction of their transmissions.<sup>91</sup>

## C. CRITERIA FOR COPYRIGHTABILITY: LITERARY, DRAMATIC, MUSICAL, AND ARTISTIC WORKS

To be protected by copyright, a work must be (1) original, (2) fixed, and (3) appropriately connected to Canada, or to a WTO, *Berne*, or *Universal Copyright Convention* member state.

### 1) Originality

Copyright protects only original work. The product must (a) originate from its author, (b) not be copied, and (c) involve some intellectual effort.<sup>92</sup> Novelty or non-obviousness in the sense of the patent law<sup>93</sup> is not required; indeed, little would qualify, if it were. So A and B, working independently, can each produce a similar or even identical "original" work and each will have his own copyright. This duplication can happen if they are both working to a similar plan or idea and using common sources. In such a case, A's work will not infringe B's copyright even if B's was made first. Someone copying B's work will infringe only B's copyright, not A's.

In aesthetics, originality is very much a contested idea. The notion of the Author as Romantic Genius, who, like the original Creator, makes something out of nothing, has been under siege at least since Marcel Duchamp exhibited an up-ended urinal signed with a concocted name

90 *Royalties 1995-7*, above note 74, distinguishing *FWS*, above note 34. See section B(5)(a), "Film, Video, and Formats," in this chapter.

91 Bill C-32, above note 9, cl. 21. The broadcasters envisaged are conventional radio and television stations, but not cable retransmitters: *ibid.*, cl. 2 def. "broadcaster." See section H, "Owner's Rights: Sound Recordings, Performances, Broadcasts," in this chapter.

92 *C Act*, above note 1, s. 5(1) & s. 2, def. "every original literary, dramatic, musical and artistic work"; *Ladbroke (Football) Ltd. v. William Hill (Football) Ltd.*, [1964] 1 All E.R. 465 (H.L.).

93 See chapter 3, "Patents."

("R. Mutt"). Was this "original" "art"? What made it so? The additions? The putting of a familiar object in a different context? The fact that an artist purported to sign it? What of Roy Lichtenstein's large-scale reproductions of frames from popular cartoons or of sketches from art history manuals? Would George Brecht's text, *Two Signs*, which reads in its entirety

TWO SIGNS

- SILENCE
- NO VACANCY

qualify as original?

The disintegration of Romanticism, at least outside Europe, has had its effect. Originality has been found in the most unlikely places. A poster of an out-of-copyright painting was called "original" because, inadvertently, it was not an exact copy. With an apparently straight face, the judge said that "[a] copyist's bad eyesight or defective musculature, or a shock caused by a clap of thunder" was enough to make the result original if the author "adopt[ed] it as his."<sup>94</sup> This decision meant that the more exact the copy, the less likely it was to have a copyright! Veering away from that conclusion, another court relocated originality in the preliminary work involved in converting a two-dimensional work into a three-dimensional engraving before running off multiple prints.<sup>95</sup>

In practice, originality may serve several public policy functions. First and foremost, it signals that enough has been done to create a potentially marketable commodity.<sup>96</sup> Production and distribution finance can then be attracted from investors who know that their outlay cannot be undercut by cheap copies. Second, the insistence that a work not be copied and that it emanate from an "author" prevents photocopiers, reprinters, tracers, or computer scanners from claiming copyright for mechanical work or for simply making material more available without added value. Third, originality helps police the borders between copyright and other rights. Words used as trade-marks, book and song titles, and slogans have all been called unoriginal, however much effort went into

94 *Alfred Bell & Co. v. Catalda Fine Arts Inc.*, 191 F.2d 99 at 105 (2d Cir. 1951).

95 *Martin v. Polyplas Manufacturers Ltd.*, [1969] N.Z.L.R. 1046 at 1049-50 (S.C.).

96 At least enough to make copyright something other than a cure for any act of unfair competition or misappropriation, torts the federal parliament cannot constitutionally enact: *Macdonald v. Vapor Canada Ltd.* (1976), [1977] 2 S.C.R. 134. The constitutionally unrestricted U.K. view that anything beyond a "single straight line drawn with the aid of a ruler" (*British Northrop Ltd. v. Texteam Blackburn Ltd.* (1973), [1974] R.P.C. 57 at 68 (Ch.) [*British Northrop*]) may be original may therefore need reconsideration in Canada, because it seems little more than a rule against people reaping where they have not sown.



devising them.<sup>97</sup> This last task is, however, too great for originality to perform alone. Judges unversed in art are sometimes too impressed by the effort in producing trivial matter — for example, the sloping *VISA* mark — and seem loath to let trade-mark law alone do the job that is its *raison d'être*.<sup>98</sup>

In fact, originality's requirement of some intellectual effort has caused it to lose its way in the twentieth century. As usual, operations at either end of the spectrum are relatively uncontroversial. Originality is rarely questioned where someone has done a translation, written her own computer program, composed her own song or painting, drafted her own engineering drawings, selected and arranged the best work of a single author or group of authors into an anthology, or even written a book on intellectual property. At the other end of the spectrum, originality also serves a useful purpose in guarding against over-easy extensions or grants of copyright when work is in, or about to go into, the public domain. Strategies concocted to extend copyrights beyond the fifty years after an author's death by bringing out "new editions" can be policed by insisting on substantial — not merely cosmetic — changes before a new copyright is allowed over the new matter. Changing a single word — however important — in a poem cannot create a fresh copyright for the poem or the word.<sup>99</sup> Other trivialities are also routinely denied copyright: (re-)arranging existing material in obvious ways, listing starters for a competition, composing a few sentences for an advertisement, producing simple application forms, shortening books with scissors and paste (or their electronic equivalent), or making minor changes to drawings without affecting their overall visual impact.<sup>100</sup>

But, while a low threshold test of originality may protect artists in their livelihood, it does not carry over well into the world of commerce. There it supports almost irresistible pressures to call virtually anything

97 For example, *Exxon*, above note 19; *Sinanide v. La Maison Kosmeo* (1928), 139 L.T. 365 (C.A.).

98 For example, *Motel 6 Inc. v. No. 6 Motel Ltd.* (1981), [1982] 1 F.C. 638 (T.D.); *Visa International Service Assn. v. Auto Visa Inc.* (1991), 41 C.P.R. (3d) 77 at 87 (Que. S.C.). See section G, "Owner's Rights," in chapter 4.

99 *Black v. Murray & Son* (1870), 9 Macph. 341 (Ct. Sess., Scot.), where one (albeit critical) word changed in a poem in the second edition of Walter Scott's novel *Antiquary* was not enough to create a new copyright in the poem or the book.

100 For example, *Commercial Signs v. General Motors Products of Canada Ltd.*, [1937] O.W.N. 58 (H.C.J.), aff'd without written reasons [1937] 2 D.L.R. 800 (C.A.); *Interlego AG v. Tyco Industries Inc.* (1988), [1989] A.C. 217 (P.C.); *FAI Insurance Ltd. v. Advance Bank Australia Ltd.* (1986), 68 A.L.J. 133 at 140–41 (Austl. Fed. Ct.); compare *Caron v. Assoc. de Pompier de Montréal Inc.* (1992), 42 C.P.R. (3d) 292 (Fed. T.D.) [*Caron*] (pocket scheduler original).

original and protected. If someone wants to pay a lot of money for an amateur home video — perhaps because, like Zapruder, the photographer happened to have his camera rolling when President Kennedy was assassinated — then, so the argument goes, surely the filmer must have “rights” in it. Or if time and money is spent scanning public domain material into a databank and making the result publicly available for a fee, surely the scanner must have “rights” in this material. So, why not a *copyright*?

How copyright deals with transcriptions of speeches or interviews is symptomatic. Perhaps a transcriber who turns incoherent babbling into polished prose may deserve to have her work called original. What, though, of the transcriber who, like a tape recorder, provides an accurate transcript, perhaps with only the occasional correction for grammar or syntax? In the United Kingdom and perhaps Canada this version is considered original because it protects the transcriber’s investment of skill, time, and labour.<sup>101</sup> In the United States, the opposite holds: a court reporter there apparently has no copyright in his transcript of evidence.<sup>102</sup>

The problem with originality therefore starts from its own internal incoherence. Although all concur that the author has to exercise some skill, ingenuity, judgment, labour, or expense (or some combination of these) in making the work, the type and amount of effort is left unclear. Courts often fudge matters by saying that it is all a question of degree and fact; that quality matters more than quantity; and that what qualifies as original for one class of work (say, compilations) is not the same as for another (say, painting). On the degree of work, some would require “little more than negligible” work, others “substantial.” On the type of work, some seem happy with industry or even experience; others demand “creativity” or the expression of the author’s own thoughts. On the latter theory, a judge’s written reasons for judgment would no doubt be original, while the listing of subscribers in a white or yellow pages telephone directory would not.<sup>103</sup> How short e-mail messages or the written “conversations” that occur on Internet “chat corners” may fare is unclear.<sup>104</sup>

101 *Express Newspapers v. News (UK) Ltd.*, [1990] 3 All E.R. 376 (Ch.); *Gould Estate v. Stoddart Publishing Co.*, [1996] O.J. No. 3288 (Gen. Div.) (QL) [*Gould*]; compare *Cala Homes (South) Ltd. v. Alfred McAlpine Homes East Ltd.*, [1995] F.S.R. 818 at 835 (Ch.) [*Cala*].

102 *Lipman v. Massachusetts*, 475 F.2d 565 (1st Cir. 1973) (Mary Jo Kopechne inquest).

103 For example, *Tele-Direct*, above note 79, and *Caron*, above note 100; compare *Feist*, above note 77; *C Act*, above note 1, s. 2, def. “compilation.” But what if the telephone directory were exhibited as an artwork, as A.C. Danto playfully suggested in *The Transfiguration of the Commonplace: A Philosophy of Art* (Cambridge, Mass.: Harvard University Press, 1981) at 136–38?

104 It is questionable, in the first place, whether these communications qualify as literary work.

Unfortunately, nobody can tell in advance what quality or quantity of work, skill, judgment, research, or time a court will demand before calling something original. The quantitative and qualitative “tests” used are notoriously unpredictable. An incentive-based test — requiring evidence that, without the stimulus of copyright, the work would not have been created<sup>105</sup> — might be more consistent with overall copyright policy; but the law, as presently understood, would need realignment, and a number of precedents, such as those finding originality in ordinary personal and business correspondence, would have to be overruled.

This preoccupation with originality has had at least one adverse result. It has tended to divert attention from other possibly more critical issues, such as when, by whom, and how far copyright should be asserted. The resolution of future disputes might be easier if more thought was given to providing guidance on these issues than on the elusive height of the copyright threshold.

## 2) Fixation

The *Act* nowhere specifies that fixation is a general condition of protection. Sometimes this condition is explicit for particular classes of work. Choreography, mime, or recitation pieces must have their “scenic arrangement or acting form” fixed in writing or otherwise. Live broadcasts or telecasts are considered fixed if they are recorded while being transmitted. Computer programs may be “expressed, fixed, embodied or stored in any manner,” although what the virtual synonyms of “fixed” add is unclear.<sup>106</sup> At other times, fixation is implicit, as for photographs. In fact, most works are fixed in some way — in writing or on tape or computer disk.

From all these considerations, one court deduced that “for copyright to subsist in a ‘work’ it *must* be expressed to some extent at least in some material form, capable of identification and having a more or less permanent endurance.”<sup>107</sup> This proposition is a *non sequitur*. The fact that some, even most, works are so fixed does not mean that all are or must be. After all, every work is supposedly protected “whatever may be the mode or form of its expression”: this language is expansive enough to cover oral works, too.<sup>108</sup> Thus, “lectures, addresses, sermons and other works of the

105 J.S. Wiley Jr., “Copyright at the School of Patent” (1991) 58 U. Chi. L. Rev. 119 at 145–54.

106 *C Act*, above note 1, s. 2, defs. “dramatic work” and “computer program,” s. 3(1.1)

107 *Canadian Admiral*, above note 37 at 394 [emphasis added].

108 *C Act*, above note 1, s. 2, def. of “every original literary, dramatic, musical and artistic work,” tracking *Berne*, above note 2, art. 2(1), although art. 2(2) allows states optionally to make fixation a precondition of protection.

same nature" are protectable under *Berne*, even though they are expressed in sign language or an oral "mode or form."<sup>109</sup> By not explicitly requiring fixation for these works, the *Copyright Act* may as plausibly imply that these and other works are protected without fixation.

On the one hand, this flexibility may seem beneficial. Even in the print era, which gave birth to the notion, fixation was an ambiguous concept. Literary critics point to the difficulty of establishing a "fixed" version of a work that has gone through various revisions by the writer and her editors. Digital technology makes the point more starkly: How is an electronic database, on which the data change by the minute, "fixed"? Far from being a general precondition for protection, fixation may function better simply by providing evidence of the existence or character of a work. Otherwise, much improvisational, performance, and kinetic art, as well as interactive art generated by "virtual reality" products, may end up unprotected.<sup>110</sup> This distinction would discriminate among artistic endeavours that, on the face of them, seem equally worthy.

On the other hand, a fixation requirement does add some certainty to the law. It prevents arguments that spontaneous activity, signing, and oral conversation automatically qualify for protection and helps identify (although sometimes artificially) who can claim to be the author of a work.<sup>111</sup> The whole concept of fixation may need some rethinking, for either imposing or removing it across the board may result in an unnecessary injustice.

### 3) Connection with Canada, or with a WTO, *Berne*, or UCC State

Works created by a Canadian national or a usual resident of Canada (e.g., a landed immigrant or even a refugee claimant), or works first published in Canada, should obviously be protected in Canada. But copyright eligibility extends well beyond this definition. Virtually every original literary, dramatic, musical, or artistic work qualifies for Canadian protection. It does not matter when or where it was first published (indeed, whether it is published at all), and what its author's nationality was.

109 *Berne*, *ibid.*, art. 2(1); S.P. Ladas, *The International Protection of Literary and Artistic Property* (New York: Macmillan, 1938) at 216–17.

110 *Komesaroff v. Mickle* (1986), [1988] R.P.C. 204 at 210 (Vict. S.C.), refusing protection to a moving sand sculpture.

111 Thus, in *Gould*, above note 101, the reporter to whom Glenn Gould gave an oral interview had copyright in his transcript, while Gould had no rights at all.

Until very recently, it was impossible to generalize in this way. Even after *NAFTA* compelled clearer eligibility criteria to be introduced in 1994, a work's eligibility for copyright still depended on poorly drafted provisions dating from the 1921 *Act*. This restriction was swept aside after 1 January 1996 by Canada's implementation of the *Agreement on Trade-Related Aspects of Intellectual Property Rights* [TRIPs]. A work is now protected in Canada if its author was, when the work was made, a citizen, subject, or ordinary resident of a *Berne*, *Universal Copyright Convention* [UCC], or *World Trade Organization Agreement* [WTO] state or a Commonwealth resident (even if not "ordinarily" resident in a Commonwealth state).<sup>112</sup> Alternatively, the work is protected if it is first published<sup>113</sup> in a *Berne*, *UCC*, *WTO*, or Commonwealth country by issuing enough copies to satisfy reasonable public demands. Publication in different countries within thirty days of the actual first publication is treated as simultaneous publication in all, apparently allowing the copyright owner to choose any as the country of origin.<sup>114</sup> Films are protectable on yet another optional basis: if the maker has its corporate headquarters in a *Berne*, *UCC*, or *WTO* country or, if an individual, is a citizen, subject, or ordinary resident there.<sup>115</sup>

It used to be critical to know what a work's country of origin was, since works made or published before the country joined *Berne* or the *UCC* fell into and remained in the public domain in Canada. This knowledge is important now only to find out whether the work was still in copyright in the country of origin when it joined *Berne* or the *WTO*. If so, the work is now automatically protected in Canada even if it was made before the country joined.<sup>116</sup>

Since almost every significant state belongs to at least one of the *WTO*, *Berne*, or *UCC*, few works fall outside the net of protection. For those that do, the Minister of Industry can, by notice in the *Canada*

112 *C Act*, above note 1, s. 5(1)(a).

113 "Publication" has a technical meaning: *C Act*, *ibid.*, s. 4(1) & (2); see section G(1), "First Public Distribution," in this chapter.

114 *C Act*, *ibid.*, ss. 5(1)(c)(i) & 5(1.1). The "reasonable public demand" criterion does not apply to the construction of architecture or the incorporation of artwork in architecture: s. 5(1)(c)(ii).

115 *C Act*, *ibid.*, s. 5(1)(b). Commonwealth residence (not necessarily "ordinary" residence) also qualifies. The film's "maker" is whoever undertook the arrangements necessary for its making (*C Act*, s. 2, def. "maker"); typically, a film production company, but sometimes an individual producer.

116 *C Act*, *ibid.*, ss. 5(1.01) & 5(1.02). Transitional provisions apply to protect reliance on a work's previous lack of copyright: ss. 29 & 70.8.



*Gazette*, extend protection if a non-treaty state protects Canadians similarly to its own nationals.<sup>117</sup>

## D. CRITERIA FOR COPYRIGHTABILITY: SOUND RECORDINGS, PERFORMANCES, BROADCASTS

Sound recordings, performances, and broadcasts have different copyrightability criteria from traditional works. Sound recordings alone require "originality" — presumably some intellectual effort in the act of recording — although Bill C-32 would eliminate even this requirement.<sup>118</sup> So only fixation and connection need discussion.

### 1) Sound Recordings

Sound recordings are protected as if they were musical, literary, or dramatic works.<sup>119</sup> The same criteria of nationality and publication in a *Berne*, *UCC*, or *WTO* state apply to them. Their "author" is whoever undertook the arrangements necessary to make the initial plate (matrix, tape, etc.); the residence of a corporate "author" is any Commonwealth or *Berne* state where it has a place of business. The copyright owner then has rights to first distribute, reproduce, rent, or authorize these acts.<sup>120</sup>

Bill C-32 would change some of these criteria. The "deemed author" fiction would be dropped. The sound recording would then be protected if its maker was a record company with its headquarters in a *Berne*, *Rome*, or *WTO* state when the record was first fixed or first published there, or a citizen or permanent resident of one of those states at that time.<sup>121</sup>

However, the new rights the bill proposes would not apply to all records. Blank audio tape royalties would be payable on records first fixed by a Canadian citizen, permanent resident, or record company with its headquarters in Canada.<sup>122</sup> Public performance and broadcast

117 *C Act, ibid.*, s. 5(2). This power existed under the original 1921 *Act*, and works protected on this basis (i.e., U.S. works since 1924) continue with this protection, too.

118 Bill C-32, above note 9, cl. 18(1).

119 *C Act*, above note 1, s. 5(3).

120 *C Act, ibid.*, s. 11; s. 2 def. "maker"; s. 5(4). See section C(3), "Connection with Canada, or with a *WTO*, *Berne*, or *UCC* State," in this chapter.

121 Bill C-32, above note 9, introducing cl. 18(2).

122 *Ibid.*, cl. 79 def. "eligible maker."

royalties would apply if the maker of the record had its corporate headquarters in Canada or a *Rome* state, or was a citizen or permanent resident of any of them, or if all the records were made there.<sup>123</sup>

## 2) Performances

Performers are protected against unauthorized fixation, reproduction, or broadcast of their live performances if the performance occurred in a WTO state.<sup>124</sup>

The expanded rights Bill C-32 proposes covering rental, public performance, and broadcasts would apply only to some performances. The performance would have to occur in Canada or in a *Rome* state; alternatively, it would have to be simultaneously broadcast from Canada or a *Rome* state by a broadcaster headquartered in such a state. For performances on sound recordings, the record would have to be protected by copyright in Canada through its connection with Canada or a *Rome* state: that is, the maker would have to be headquartered there or be a citizen or a permanent resident, or first publication would have to take place there.<sup>125</sup>

To qualify for blank audio tape royalties, the performer would have to be a citizen or a resident of Canada.<sup>126</sup>

## 3) Broadcasts

Bill C-32 would give broadcasters with their headquarters in a WTO or *Rome Convention* state a copyright if the signal was broadcast from that state.<sup>127</sup>

## 4) Additional Powers of the Minister

Bill C-32 would also allow the Minister of Industry to extend the rights given to performances, sound recordings, and broadcasts to other NAFTA members, or to other states on a reciprocal basis.<sup>128</sup> The Minister could also eliminate a right proposed for broadcasters — in respect of

123 *Ibid.*, cl. 20(1).

124 *C Act*, above note 1, s. 14.01(1).

125 Bill C-32, above note 9, cl. 15(2).

126 *Ibid.*, cl. 79 def. "eligible performer."

127 *Ibid.*, cl. 21. See section B(13), "Broadcasts," in this chapter.

128 *Ibid.*, cl. 17(4), 20(2), 22, & 85.

television programs shown wherever the public is charged an entrance fee to view — for signals coming from countries that do not grant a similar right in their legislation.<sup>129</sup>

## E. TITLE

The author owns the moral rights in a work and usually first owns the copyright, too. To market their work, however, authors may have to waive their moral rights or transfer copyright to a distributor. If the author is employed, her employer usually owns the copyright automatically, but the position with freelancers and with firms acting as independent contractors is different. Paying a freelancer or a firm does not by itself give the customer full rights to the work.<sup>130</sup> The livelihood of freelancers or such firms may depend on the copyright inventories they maintain. The *Act* therefore allocates first ownership to them, rather than to the client who hires them.<sup>131</sup>

Unfortunately, there is little consensus internationally on ownership rules. Most states adopt *Berne's* rhetoric, which makes the author the central figure on the copyright stage, but then adopt legal rules or practices that quickly allow him to be pushed out of sight.<sup>132</sup> In the United States, for example, many freelancers can, by simple signed agreement, be assimilated to employees; so a person or a corporation ordering such a "work made for hire" from them automatically becomes both the author and the first copyright owner.<sup>133</sup> The U.S. owner who sues for infringement in Canada will, however, fail unless it is the owner according to Canadian law or it joins whoever is the owner.<sup>134</sup> Whether *NAFTA* will force a different approach for U.S. and Mexican works

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129 *Ibid.*, cls. 21(1)(d) & 21(3).

130 Except for industrial designs and integrated circuit topographies (ICTs), where the person ordering the work under contract is the first owner of the design or ICT, whether the maker is an employee or a freelancer: *ID Act*, above note 63, s. 12(1); *ICT Act*, above note 28, s. 2(4).

131 Compare section E(5), "Changing Ownership and Implying Rights of Use," in this chapter.

132 *Berne*, above note 2, art. 5(1); J. Seignette, *Challenges to the Creator Doctrine* (Deventer; Kluwer, 1994).

133 *Copyright Act*, 17 U.S.C., §§ 101 ("work made for hire") & 201(b) (1976) [*Copyright Act 1976*]; similarly for ICTs in Canada (*ICT Act*, above note 28, s. 2(4)). Compare section E(1), "Author," in this chapter.

134 *Frank Brunckhorst Co. v. Gainers Inc.* (1993), 47 C.P.R. (3d) 222 (Fed. T.D.).

remains to be seen.<sup>135</sup> Meanwhile, Canadian owners who try to enforce their copyrights abroad may have to comply with the foreign forum's law on ownership.<sup>136</sup>

## 1) Author

Who is an "author"? The term compendiously describes whoever writes a book, letter, or play, as well as every other producer of creative work: scriptwriters, music composers, artists, choreographers, and computer programmers alike. In Canada the status is reserved to the individual actually making the work. A corporation can be the author of a traditional work in only one case: a photograph. Nothing of course ever prevents it from being a copyright owner.<sup>137</sup>

### a) The Unoriginal Author

Some say that "author" and "original work" are "correlative; the one connotes the other."<sup>138</sup> This is not entirely true: the author of a straight line may create something too trivial to be original. A person who does fresh work on an existing work may, however, claim to be author of the resulting product. So a musical arranger may claim authorship and copyright in her arrangement and sue those who infringe it, even if she failed to get clearance for her activity from the source work's copyright owner.<sup>139</sup>

### b) Idea Providers Generally Not Authors

Copyright exists in the expression of ideas, not in the ideas themselves. An author is the person who puts ideas into their copyright form: the painter of a canvas, the sculptor of a monument, the architect of a building or the engineer of its structural work, but not the builder who exe-

135 NAFTA, above note 2, art. 1705(3)(b), provides that "any person acquiring or holding such economic rights by virtue of a contract, including contracts of employment underlying the creation of works and sound recordings, shall be able to exercise those rights in its own name and enjoy fully the benefits derived from those rights." No amendment to the *Act* reflects this provision.

136 *Enzed Holdings Ltd. v. Wynthca Pty. Ltd.* (1984), 57 A.L.R. 167 at 179-81 (Austl. Fed. Ct.); Seignette, above note 132 at 74-79.

137 *Massie & Renwick Ltd. v. Underwriters' Survey Bureau Ltd.*, [1940] S.C.R. 218 at 232-34 [*Massie & Renwick*]. See section F(3), "Sound Recordings, Performances, Broadcasts," in this chapter.

138 *Sands & McDougall Pty. Ltd. v. Robinson* (1917), 23 C.L.R. 49 at 55 (Austl. H.C.). See section C(1), "Originality," in this chapter.

139 *Redwood Music Ltd. v. Chappell & Co. Ltd.* (1980), [1982] R.P.C. 109 at 120 (Q.B.).

cutes the architect's or the engineer's instructions.<sup>140</sup> "Ideas people" are generally not authors:

A person may have a brilliant idea for a story, or for a picture, or for a play, and one which appears to him to be original; but if he communicates that idea to an author or an artist or a playwright, the production which is the result of the communication of the idea to the author or the artist or the playwright is the copyright of the person who has clothed the idea in form, whether by means of a picture, a play, or a book, and the owner of the idea has no rights [i.e., copyright] in that product.<sup>141</sup>

A lawyer drafting an agreement on a client's instructions should be its author, even though the client has sent her specimen forms as aids. But if the lawyer simply approves or makes minor corrections to a draft the client has sent, the client should remain the author; the lawyer may be legally responsible for the document's inadequacies, but that may not make her an author, any more than a libel lawyer passing a book for publication becomes its author.<sup>142</sup>

### c) Joint Authors

The rule that the provision of ideas can never count as authorship is nevertheless coming under siege. Much work is the result of team, rather than individual, effort. Even a simple song may involve the intermingled contributions of a tunesmith, lyricist, and arranger. A collaboration like this may produce a work of joint authorship, with one copyright co-owned by the co-authors. If the contributions are distinct, each author has a separate copyright in her contribution.<sup>143</sup> The participants' conduct may help establish their relationship. So if A and B sign an exploitation agreement stating they are co-authors or, with their knowledge, are so named on their publication or in promotional material, they may be precluded from denying co-authorship, at least in any dispute between themselves.<sup>144</sup>

<sup>140</sup> John Maryon, above note 61.

<sup>141</sup> *Donoghue v. Allied Newspapers Ltd.* (1937), [1938] 1 Ch. 106 at 109. See also Gould, above note 101. The idea provider might, however, claim an equitable interest or constructive trust in the copyright. He or she might also have rights other than copyright — for example, those arising from an express or implied contract, or from a relationship of trust or confidence.

<sup>142</sup> D. Vaver, "Copyright," above note 18 at 665–66; compare *Delrina*, above note 22.

<sup>143</sup> C Act, above note 1, s. 2, def. "work of joint authorship"; *Ludlow Music Inc. v. Canint Music Corp.*, [1967] 2 Ex C.R. 109 at 124–25.

<sup>144</sup> *Prior v. Lansdowne Press Pty. Ltd.* (1975), 12 A.L.R. 685 at 688 (Vict. S.C.).



What contribution warrants co-authorship may be contentious. Trivial editing is obviously not enough. Correcting punctuation, grammar, and syntax in another's manuscript before publication should not qualify; nor should providing chapter titles or suggesting a few ideas or lines.<sup>145</sup> On the other hand, contributions to a work's expression that would independently create an original work are obviously enough. In between these two extremes is the case, for example, where A supplies B with all the ideas for the plot of a play and B turns them into a finished work. This collaboration has sometimes not counted as joint authorship unless A's ideas were independently copyrightable<sup>146</sup> — a result that may promote certainty but that still seems hard. There would have been no play at all without A's input. To elevate B's contribution and entirely discount A's may discourage some fruitful collaborations. It may also undesirably invite a minute examination and dissection of who said and did what, often long after the event when memory is unreliable. Any substantial intellectual contribution to a work's composition pursuant to a common design should, in principle, count as co-authorship. A house designer whose detailed instructions to the drafters enabled them to draw the house plan was held to be a co-author with the drafters.<sup>147</sup>

An apparent reluctance on the part of some courts to admit joint authorship may spring partly from the romantic view of the author as Lone Genius, or from a more pragmatic desire to avoid problems that plague co-ownership generally but that are particularly acute for copyright. For example, in what shares do co-owners hold? If one co-author contributed more than another, does she deserve a greater share? How is "more" to be assessed, without encountering aesthetic difficulties? What if one co-owner refuses to agree on whether or how to exploit a work? Can the court "partition" this property or order a sale? If there is a partition, what part goes to which owner, and how can exploitation practically occur without affecting the other owner's interest? U.K. law avoids some of these questions by allowing any one co-owner to prevent all forms of exploitation and to obtain an injunction and its share of

145 *Dion v. Trotter* (23 July 1987), (Que. S.C.) [unreported] at 29–31.

146 *Kantel*, above note 38; *Ashmore v. Douglas-Home* (1982), [1987] F.S.R. 553 at 560 (Ch.).

147 *Cala*, above note 101 at 835–37; see also *Najma Heptulla v. Orient Longman Ltd.* (1988), [1989] F.S.R. 598 at 609 (India H.C.). The common law could partly mitigate the results of denying co-authorship — for example, through principles of unjust enrichment, trust, confidence, or implied agreement: see *Promotive*, above note 40.

damages or profits from infringement.<sup>148</sup> U.S. law, by contrast, allows a co-owner to exploit a work by non-exclusive licensing without the other co-owners' consent, subject to accounting to the others for their share of the proceeds.<sup>149</sup> Canadian courts might prefer a similar solution to that of the United Kingdom, where one co-owner can play "dog in the manger." Until Canadian law is clarified, the tendency to avoid finding joint authorship wherever possible may perhaps continue being justified by pragmatic considerations.<sup>150</sup>

#### d) Photographs and Films

For photographs, extraordinarily, the owner of the initial negative (or if none, of the photograph) is also the author and first copyright owner. The owner may be a corporation.<sup>151</sup> Presumably, the person whose photo is taken in a coin-operated automatic photograph booth is the author of the photo, since the payment made by or for her would usually cover ownership of the negative.

The authorship of films is surprisingly unclear. For an unedited movie of live events shot before 1994, the position is the same as for photographs: the owner of the initial negative is the author, as the movie was then considered merely a series of photographs.<sup>152</sup> Such movies are now classed as dramatic works, along with regular commercial movies and television drama. The "author" of these dramatic works presumably is the person who gave the "arrangement or acting form or the combination of incidents represented" in the production "an original character." This would usually be the director. This copyright is separate from those in the underlying work — the script, the scenario, and the soundtrack.

For a home movie lacking the requisite original character, the author would presumably be whoever shoots the film, for he or she is the "effective cause of the representation when completed."<sup>153</sup> Whether scenes taken by an automatic surveillance camera are authored by any-

148 For example, *Cescinsky v. George Routledge & Sons Ltd.*, [1916] 2 K.B. 325; *Redwood Music Ltd. v. B. Feldman & Co.*, [1979] R.P.C. 1 (Ch.); similarly in Canada, *Massie & Renwick*, above note 137.

149 U.S. Senate, Subcommittee on Patents, Trademarks and Copyrights, *Joint Ownership of Copyrights* (Study No. 12) by G.D. Cary (U.S.: Comm. Print, 1958) 85.

150 B. Torno, *Ownership of Copyright in Canada* (Ottawa: Consumer & Corporate Affairs, 1981) at 63–67.

151 *C Act*, above note 1, s. 10(2). See section E(3), "Ownership: Commissioned Engravings, Photographs, and Portraits," in this chapter.

152 *Canadian Admiral*, above note 37 at 401; *NAFTA I A*, above note 74, s. 75(2).

153 Compare *Nottage v. Jackson* (1883), 11 Q.B.D. 627 at 637 (C.A.), on old-time photography.

one is doubtful: the person responsible for positioning the camera is no Atom Egoyan. Such authorless films may have no copyright at all.

## 2) Ownership: Employees

The author is usually the first owner of copyright, unless (a) she is employed under a contract of service or apprenticeship, and (b) the work was made in the course of that employment or apprenticeship. Her employer then usually first owns the copyright.<sup>154</sup> This arrangement squares with the common expectation under capitalist modes of production. A person hired to produce material as part of her work normally expects copyright to be her employer's; for, without the hire, the work would probably not have been produced at all. Where expectations are different or the work would have been produced anyway, it is consistent with copyright policy to leave ownership with the author.

### a) Contract of Service

The employer first owns the copyright only if the author is employed under a contract of service. The author must be an employee, not a freelancer. This distinction involves interpreting the parties' relationship according to familiar principles of labour law. As more employees work from home and many consultants come to the workplace, the actual site where work is done tells little about whether the worker is an employee or a freelancer. Instead, the hiring contract and the surrounding circumstances must be examined to see how the worker is treated. If she is called an employee and treated as part of the staff, is paid a salary with income tax deducted at source, is given pension and other benefits, has to attend staff meetings or report on how she spends her time, the worker will probably be found to be an employee. The fewer such factors are present, the more likely the worker will be found to be a freelancer, who *prima facie* owns the copyright in her work product.<sup>155</sup>

154 C Act, above note 1, s. 13(3) (apprentices are not separately considered). This position can be modified by simple agreement. See section E(5), "Changing Ownership and Implying Rights of Use," in this chapter. See generally K. Puri, "Copyright and Employment in Australia" (1996) 27 I.L.C. 53, where similar principles apply.

155 For other factors, see the standard labour law cases. Copyright cases include *Goldner v. Canadian Broadcasting Corp.* (1972), 7 C.P.R. (2d) 158 at 161-62 (Fed. T.D.) (television consultant not employee); *Stephenson Jordan & Harrison Ltd. v. MacDonald & Evans* (1951), [1952] 1 T.L.R. 101 (C.A.) [*Stephenson*] (management consultant partly employee, partly freelancer); *Community for Creative Non-violence v. Reid*, 490 U.S. 730 (1989) (sculptor freelancer). See also, Y. Gendreau, "La titularité des droits sur les logiciels créés par un employé" (1995) 12 Can. Intell. Prop. Rev. 147 at 149ff.

Establishing a worker's status has been likened to determining the subject of an impressionist painting which is built up from an accumulation of detail.<sup>156</sup> Unfortunately, such a painting may strike different viewers differently. Thus, the inmate of a federal penitentiary was recently held to be not only an involuntary tenant of Her Majesty but also (unbeknownst to him) her employee too — paid \$6 a day. The government of Canada therefore owned the copyright in a painting he had done as part of his rehabilitation, as well as the painting itself. After serving his time and opening an art business, the painter was not allowed even to photograph the work for his portfolio!<sup>157</sup>

#### b) Work Produced "in the Course of Employment"

Not everything an employee does for her employer is necessarily done "in the course of . . . [her] employment" under her contract. The employment contract may not compel a work to be created at all or in a form that attracts copyright. A worker who then chooses to produce in that form does so outside the course of her employment. The copyright may then be hers. One test is to ask whether the worker would have broken her contract by not producing the work the way she did. If the answer is yes, her employer owns the copyright; if no, it is the worker's.

Take the case of a university professor. Suppose his employment contract compels him to teach, but leaves how he does that — spontaneously, from jotted notes, or from fully prepared text — entirely up to him.<sup>158</sup> The copyright in any lecture notes or text he prepares should *prima facie* be his. This result could also be supported for policy reasons. Were the copyright his employer's, incentives for the production of worthy work may be reduced; employers would receive a windfall; employee mobility would be reduced, for professors could not effectively deploy their expertise elsewhere once they lost copyright in their notes to their university; and employers, who typically are responsible for preparing job descriptions, can always bargain for a different result.<sup>159</sup>

156 *Hall (Inspector of Taxes) v. Lorimer*, [1992] 1 W.L.R. 939 at 944 (Ch.), *aff'd* (1993), [1994] 1 W.L.R. 209 (C.A.).

157 *Hawley v. Canada* (1990), 30 C.P.R. (3d) 534 (Fed. T.D.) [*Hawley*].

158 H.S. Bloom, "The Teacher's Copyright in His Teaching Materials" (1973) 12 J. Soc. Pub. T.L. 333 at 341; *Stephenson*, above note 155; *Noah v. Shuba*, [1991] E.S.R. 14 (Ch.) [*Noah*]. Compare *Greater Glasgow Health Board's Application* (1995), [1996] R.P.C. 207 at 222–24 (Pat. Ct.) (copyright approach applies also to patents).

159 See *Williams v. Weisser*, 78 Cal. R. 542 (2d Dist. 1969). A similar analysis might have left the copyright in the prisoner's painting in *Hawley*, above note 157, with the prisoner, even assuming he was rightly held to be an employee.

### c) Journalist Employees

Copyright law treats journalist employees differently in one respect from other employees. For articles or other contributions (e.g., cartoons) to a newspaper, magazine, or similar periodical, the author retains "a right to restrain" publication of the work otherwise than as part of a newspaper, magazine, or similar periodical. This appears to be only a right of veto. The author has no positive right to publish. Still, unless the journalist has waived the right, the employer or any other person may be unable to republish the work in book or any other non-periodical form (e.g., on an electronic database) without first coming to terms with the author. Cartoonists may also reap the benefit of their characters' popularity on T-shirts and other bric-à-brac.<sup>160</sup>

### 3) Ownership: Commissioned Engravings, Photographs, and Portraits

Freelancers usually first own copyright in work they produce, even on order. A special rule, however, applies to ordered engravings, photographs, and portraits. If the original, or the negative or matrix from which it derives, is created by a freelancer to fulfil an order given for valuable consideration, the customer is the first copyright owner of the work, any images made from it, and any preparatory material.<sup>161</sup> This rule includes cases where the customer is liable to pay a reasonable price because she has impliedly requested the work. Someone who asks that his photograph be taken does not automatically get the copyright; this happens only if he became expressly or impliedly liable to pay for the original or the prints. Just making oneself available for a photo session may not be enough.<sup>162</sup> With wedding photos, the bride or groom who places the order with the photographer usually does so for both of them. The copyright may then be owned jointly by the spouses.<sup>163</sup>

Freelancers sometimes think that, because they own the copyright, they can do what they like with a work. This is not true. For example, a photographer has no business giving or selling prints or negatives of commis-

160 C Act, above note 1, s. 13(3); *Sun Newspapers Ltd. v. Whippie* (1928), 28 S.R. (N.S.W.) 473 (Eq. Ct.); see *De Garis v. Neville Jeffress Pidler Pty. Ltd.* (1990), 18 I.P.R. 292 (Austl. Fed. Ct.); K. Purj, "Journalists' Copyright in Australia" (1994) 9 I.P.J. 90.

161 C Act, *ibid.*, s. 13(2); *James Arnold & Co. Ltd. v. Mifflin Ltd.*, [1980] R.P.C. 397 at 403-4 (Ch.) [Arnold]; *Planet Earth Productions Inc. v. Rowlands* (1990), 73 O.R. (2d) 505 (H.C.J.). This position can be modified by simple agreement: see section E(5), "Changing Ownership and Implying Rights of Use," in this chapter.

162 *Sasha Ltd. v. Stoenesco* (1929), 45 T.L.R. 350 (Ch.); *Arnold*, *ibid.* at 404.

163 *Mail Newspapers v. Express Newspapers* (1986), [1987] E.S.R. 90 at 93 (Ch.)



sioned photographs to a newspaper, where the subjects later come into the public limelight. Conduct like this, while not infringing copyright, may violate a duty of confidentiality, privacy, or implied contractual obligation of exclusivity owed to the subject or the customer, and may expose the photographer and possibly the newspaper to an injunction and damages.<sup>164</sup> On the other hand, Glenn Gould's estate was unsuccessful in trying to stop the use of photographs of the pianist in a biography about him. A claim that Gould's personality had been mis-appropriated failed: the shots had been taken with Gould's consent during an interview and were used on an occasion of public interest, not merely to exploit Gould's personality to sell products.<sup>165</sup>

#### 4) Government Work

Federal, provincial, and municipal governments and Crown corporations can own and acquire copyrights, just like any private employer. Thus, the copyright in works produced by a municipal employee on the job belongs to the municipality. Such disparate material as departmental memoranda, cabinet or policy documents, prison manuals, and, more dubiously, artwork produced by a federal prisoner as part of his rehabilitation, has been included.<sup>166</sup>

The Act vests copyright ownership of any work prepared or published "by or under the direction or control of Her Majesty or any government department" in the federal or provincial government.<sup>167</sup> This includes artwork produced by employees or commissioned from freelancers, and reports written by government employees and published under the aegis of their departments.<sup>168</sup> In addition, "any rights or privileges of the Crown" are specifically preserved.<sup>169</sup> This language refers to

164 *Pollard v. Photographic Co.* (1888), 40 Ch.D. 345; see also *Cala* above note 101 at 836 (drafter producing design for home builder). British Columbia, Manitoba, Newfoundland, Quebec, and Saskatchewan have special privacy legislation that might also be violated by such actions. In Ontario, such action may breach a common law right of privacy: *Saccone v. Orr* (1981), 34 O.R. (2d) 317 (Co. Ct.).

165 *Gould*, above note 101.

166 For example, *Ontario (A.G.) v. Gowling & Henderson* (1984), 47 O.R. (2d) 449 (H.C.J.); *Australia v. John Fairfax & Sons Ltd.* (1980), 147 C.L.R. 39 (Austl. H.C.) [*Fairfax*]; *Hawley*, above note 157.

167 *C Act*, above note 1, s. 12; B. Torno, *Crown Copyright in Canada: A Legacy of Confusion* (Ottawa: Consumer & Corporate Affairs, 1981). This position can be modified by simple agreement: see section E(5), "Changing Ownership and Implying Rights of Use," in this chapter.

168 *Kerr v. R.* (1982), 66 C.P.R. (2d) 165 (Fed. T.D.); [*Kerr*]; *R. v. James Lorimer & Co.*, [1984] 1 F.T.R. 1065 at 1069 (C.A.) [*James Lorimer*].

169 *C Act*, above note 1, s. 12.

the government's prerogative power to control publishing. In seventeenth-century Britain, when talk of treason and sedition was rife, the power was asserted as a form of censorship over everything published. Three centuries later, a Canadian court gave this power a more limited range. It now encompassed only "a somewhat miscellaneous collection of works, no catalogue of which appears to be exhaustive."<sup>170</sup> One of the most important items today may be legislation. Both the provincial and the federal governments continue to claim a perpetual monopoly in statutes, proclamations, orders in council, and regulations.<sup>171</sup> This monopoly may operate loosely in practice, as legislation is made available online and on compact disk, and what users do with it becomes less traceable.

It is interesting to note that the Crown today still claims a prerogative power over publishing judicial decisions. The power may be exercised through delegates like provincial law societies. The idea may have seemed plausible when the monarch claimed to rule by divine right and the publication of judicial proceedings in the House of Lords was punishable as a contempt of Parliament. It seems less plausible today, especially in light of the untrammelled rise of private law reporting in Britain since at least the mid-eighteenth century. No European state, other than the United Kingdom, Eire, and Italy, claims to protect "official texts of a legislative, administrative and legal nature, and . . . official translations of such texts."<sup>172</sup> Nor does the United States. Judges there have since the nineteenth century asserted that the people's laws belong to the people. In the United States, there is therefore no copyright on federal and state court opinions and legislation as a matter of public policy.<sup>173</sup> U.S. copyright may, however, exist in added value like headnotes, annotations, indexes, compilations, and, less plausibly, pagination.<sup>174</sup>

170 *R. v. Bellman*, [1938] 3 D.L.R. 548 at 553 (N.B.C.A.) (hydrographic and admiralty charts of the Bay of Fundy).

171 Upheld in *New South Wales (A.G.) v. Butterworth & Co. (Australia) Ltd.* (1938), 38 S.R. (N.S.W.) 195 (Eq. Ct.), although the New South Wales government recently waived its rights over this material.

172 *Berne*, above note 2, art. 2(4); see also J.A.L. Sterling, "Crown Copyright in the United Kingdom and Other Commonwealth Countries" (1996) 10 I.P.J. 157.

173 This policy may, however, not extend to assertions of copyright in such material outside the U.S.: D. Vaver, "Copyright and the State in Canada and the United States" (1996) 10 I.P.J. 187 at 209.

174 *Howell v. Miller*, 91 F.129 (6th Cir. 1898) (state statutes); *Banks v. Manchester*, 128 U.S. 244 (1888); *Callaghan v. Myers*, 128 U.S. 617 (1888) (judicial decisions); *West Publishing Co. v. Mead Data Central Inc.*, 799 F.2d 1219 (8th Cir. 1986), cert. denied 479 U.S. 1070 (1987) (pagination); see also L. Patterson & C. Joyce, "Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations" (1989) 36 U.C.L.A. L. Rev. 719.

The U.S. and majority European position seems more compatible with the idea of a modern democracy. When or whether Canada's governments will eventually see things this way is a matter for speculation.

## 5) Changing Ownership and Implying Rights of Use

Copyright may always be transferred by written assignment.<sup>175</sup> Two special cases where this rule is qualified should be noted.

### a) Changing First Ownership by Simple Agreement

First ownership may be varied by simple agreement in the three situations just discussed: employees, government works, and freelance engravings, photographs, and portraits. So the *prima facie* rule that an employer owns the copyright in works employees produce on the job can be changed with no formality at all before the work is begun or even (possibly) completed. An oral agreement may work; so may an agreement implied or inferred from conduct. No special rules govern the terms and duration of the agreement, which needs to be established according to standard common or civil law principles. The person alleging a variation from the standard position established by the Act carries the burden of proving the variation.<sup>176</sup>

One major area where copyright ownership is often reallocated in this way is in the business of photography. Independent studios may, for example, have their customers sign an agreement allocating copyright to the studio, to prevent rival studios from making cheaper prints and enlargements from the negatives. In a recent interesting case, a freelance photographer took a photograph of Member of Parliament Sheila Copps at the request of *Saturday Night* magazine. The photograph turned up on the cover of the magazine and the photographer was duly paid. The *Toronto Star* newspaper later reproduced the magazine cover, without anyone's consent, for a story it ran on Copps. The photographer sued the *Star*. The court accepted evidence of a trade custom — an implied agreement contrary to the standard position — under which freelancers doing such media work continued to own copyright in their work. *Saturday Night* could use the photo once, but had to get the freelancer's consent for reuse and pay customary reuse fees. It could not authorize others to use the photograph. So the *Star* had to pay the photographer damages for infringing his copyright.<sup>177</sup>

175 See chapter 5.

176 *Noah*, above note 158 at 25–27.

177 *Allen v. Toronto Star Newspapers Ltd.* (1995), 63 C.P.R. (3d) 517 (Ont. Gen. Div.) [under appeal].

## b) Freelancers: Implied Use Rights for Clients

Many people contracting with freelancers are but dimly aware, if at all, of their copyright position. They may think that, having paid for the work, they can do what they like with it — that they own the full copyright. Firms paying for a computer program to be upgraded have sometimes been surprised to find that the programmer owns the copyright on the upgrade and can even sell it to the firm's competitors.<sup>178</sup> Courts have sometimes tried, within the *Act*'s framework, to avoid such results and to produce instead an outcome that meets their perception of the parties' expectations and the equities of the situation. Techniques such as express or implied agreements, trusts, estoppels, waivers, implied licences, proved trade custom, and finding the client to be a joint copyright owner have all been used. For example, engineers or architects hired to produce plans for a building usually keep their copyright. Courts have nevertheless held that the site owner was impliedly licensed to copy the plans when, for example, the structure needed repair or redesign.<sup>179</sup> A site owner could even prevent a freelancer from reusing plans that included significant design features provided by the site owner, for the latter may be a joint author and owner of the copyright.<sup>180</sup> Similarly, clients may be able to switch lawyers and have their documents redrafted without their ex-lawyers' using copyright to hinder the process.<sup>181</sup>

Contests to redraw rights of ownership and use in ways different from those the *Act* prescribes are becoming more common as works are increasingly available online and in new formats such as multimedia CDs. Publishers are finding that their right to put works in electronic databases and to distribute them in new formats is not always crystal clear. Challenges may come from freelancers, who say the publisher was granted merely a licence to use the material once. The *Act* obviously did not envisage how ownership and use should play out in an electronic universe. It nevertheless is the backdrop against which arrangements have been and continue to be made. Skirmishes in other fields may prove relevant to the electronic era.

A graphic artist, for example, may be hired to design promotional material for a client: a neon sign with the client's name or improvements to the logos used by the client. Can the artist use her copyright to prevent

178 *Amusements Wiltron Inc. v. Mainville* (1991), 40 C.P.R. (3d) 521, at 525ff (Que. S.C.).

179 *Netupsky v. Dominion Bridge Co. Ltd.* (1971), [1972] S.C.R. 368, rev'g (1969), 58 C.P.R. 7 (B.C.C.A.) [*Netupsky*]; *ADI Ltd. v. Destein* (1982), 41 N.B.R. (2d) 518 (Q.B.).

180 See also *Cala*, above note 101 at 835–36.

181 Vaver, "Copyright," above note 18.

the client from using the sign or logo generally in the business, perhaps for a completely new use? May the artist demand a further fee, or must the client stop the new use? So far at least, common law courts have sided with the client, finding an implied licence in the client's favour.<sup>182</sup> Since the artist could not herself honestly reuse such tailor-made work without the client's consent, courts could even have inferred a common intention that the client should be the copyright owner, not a mere licensee. British courts have done so in comparable cases. A client that had its computer program enhanced by a freelancer was found to own the copyright because of a presumed intention between the parties to this effect. The same argument applied where a producer had a choreographer work on a ballet in which the producer already owned the musical and literary copyright.<sup>183</sup> Implied agreements like these may be fully effective between the parties to make the client the second copyright owner in equity, although a written assignment is necessary to perfect title.<sup>184</sup>

It seems wrong to find such an implied or presumed licence or agreement where the freelancer would be unfairly prejudiced — for example, where a client knew or should have known it was obtaining only limited rights. Such an implication seems justifiable, however, where the artist should, from the start, have made her expectations clear to the client that only rights of limited use were being acquired. This would be so, for instance, where the artist is a professional and the client is a tyro in the copyright world. A professional who fails to explain the copyright position to a novice can hardly complain if a court rules that the beginner's belief that it is buying clear title is preferable. This is really a finding that the client's belief is "more" reasonable and thus the presumed intent of both parties. The writing requirement, intended partly to protect freelancers from imprudent assignments, should not work as a trap for unsuspecting clients.<sup>185</sup>

182 *Silverson v. Neon Products Ltd.* (1978), 39 C.P.R. (2d) 234 (B.C.S.C.); *Cselko Associates Inc. v. Zellers Inc.* (1992), 44 C.P.R. (3d) 56 (Ont. Gen. Div.).

183 *John Richardson Computers Ltd. v. Flanders* (1993), 26 I.P.R. 367 at 383–84 (Ch.); *Massine v. de Basil* (1938), [1936–45] MacG. Cop. Cas. 223 (C.A.); compare *Saphena Computing Ltd. v. Allied Collection Agencies Ltd.* (1988), [1995] F.S.R. 616 (Q.B.) appeal dismissed (1989), [1995] F.S.R. 649 (C.A.) [*Saphena*].

184 C Act, above note 1, s. 13(4). For the consequences of equitable ownership, see section B(4), "Equitable Assignments and Licences," chapter 5.

185 Artists' unions may impose an ethical obligation (that can readily turn into a legal one) on the artist to clarify the copyright position in the initial contract with the client: for example, Graphic Artists Guild (U.S.), *Graphic Artists Guild Handbook: Pricing and Ethical Guidelines*, 8th ed. (New York: Graphic Artists Guild Inc., 1994) at 27, on U.S. practice.



## 6) Sound Recordings, Performances, Broadcasts

The first copyright owner in a sound recording is whoever undertook the arrangement necessary for making the recording, typically the recording company. The ownership provisions for traditional works, detailed above, apply as if the maker were an author.<sup>186</sup> A performer is the first owner of the right in his or her performance.<sup>187</sup>

Bill C-32 would retain these ownership rules for sound recordings and performances, and similarly would make the broadcaster the first owner of the signal it broadcasts.<sup>188</sup> Record companies would not, however, be able to resort to the ownership provisions applying to traditional works; for example, first ownership may not be able to be reallocated by a simple agreement. The bill proposes that all the rights may be assigned or licensed like traditional copyrights.<sup>189</sup>

## F. DURATION

### 1) Literary, Dramatic, Musical, and Artistic Works

Copyright terms have grown over the years. What started in early eighteenth century Britain as a twenty-eight-year term (fourteen years plus an optional fourteen years renewal) was added to incrementally over the years until, by the early twentieth century, it had internationally become the life of the author plus fifty years. This has been Canada's term since 1924.<sup>190</sup> All terms now run to 31 December of the year in which they are due to expire. The term of copyright for an author who died on 1 January 1956 therefore expires after 31 December 2006.<sup>191</sup>

For jointly authored work, copyright lasts until fifty years after the last author dies.<sup>192</sup> For anonymous and pseudonymous works, copyright lasts for the shorter of fifty years from first publication or seventy-five years from making; but, if during that period, the author's identity

186 *C Act*, above note 1, s. 11; s. 2 def. "maker." See section E(4), "Government Work," in this chapter.

187 *Act*, *ibid.*, s. 14.01(4).

188 Bill C-32, above note 9, cl. 24.

189 *Ibid.*, cl. 25.

190 *C Act*, above note 1, s. 6; compare *Berne*, above note 2 (1908), art. 7, & (1971), art. 7. In Europe the term was recently increased to author's life plus seventy years, and a similar bill is presently being urged in the United States.

191 *C Act*, *ibid.*, s. 6. This "year's end" formula is repeated throughout the *Act* and Bill C-32, above note 9, for all works and beneficiaries.

192 *C Act*, *ibid.*, s. 9.

becomes commonly known, the standard life-plus-fifty-year term then applies.<sup>193</sup> For literary, dramatic, musical works, lectures, or engravings unpublished or (except for engravings) unperformed in public when the author dies, copyright lasts perpetually until publication or performance and then ceases fifty years later; but Bill C-32 proposes that the standard life-plus-fifty term would apply here, too.<sup>194</sup>

Some periods drop all reference to an author's life and provide a flat fifty-year term. Copyright in photographs thus runs for fifty years from the date when the initial photograph, negative, or plate was made.<sup>195</sup> Cinematographs that lack an original character arising from their arrangement, acting form, or combination of incidents (e.g., unedited films of live events) are also protected for fifty years. Thus, copyright runs from the date the film was made. If the film was first published during this period, the copyright is prolonged to fifty years past that publication.<sup>196</sup> For works prepared or published under the direction or control of the federal or provincial government and first owned by it, copyright lasts for fifty years after first publication.<sup>197</sup> There is, however, no term specified for works falling under the Crown prerogative.<sup>198</sup> If statutes indeed come under this power, the result is that every pre- and post-Confederation statute, regulation, and order in council, whether repealed or still in force, is still under the exclusive control of the federal and provincial governments.

## 2) Reversion

Any assignment or grant of interest in copyright (e.g., exclusive licence) by an author ends twenty-five years after he dies, and the copyright reverts to his estate. The idea is to enable the estate directly to benefit from the copyright and free itself of any improvident deal made during the author's lifetime.<sup>199</sup> Exceptions are where (a) the author was not the first copyright owner;<sup>200</sup> (b) the author was a corporation (as is possible

193 *C Act, ibid.*, s. 6.1. The same applies to jointly authored work: *C Act, ibid.*, s. 6.2.

194 *C Act, ibid.*, s. 7; Bill C-32, above note 9, cl. 6 (replacing s. 7) also proposing transitional measures for existing works.

195 *C Act, ibid.*, s. 10.

196 *C Act, ibid.*, s. 11.1. The same applies to compilations of these films.

197 *C Act, ibid.*, s. 12.

198 See section E(4), "Government Work," in this chapter.

199 *C Act*, above note 1, s. 14; *Chappell & Co. Ltd. v. Redwood Music Ltd.*, [1980] 2 All E.R. 817 at 828-29 (H.L.). Any waiver of moral rights presumably ceases too.

200 This is the case for employees' work, freelancers making a commissioned photograph, engraving, or portrait, and government works — at least, where no contrary agreement initially vesting copyright in the author was made: *C Act, ibid.*, ss. 13(3), (2), & 12. See section E, "Title," in this chapter.

for photographs and sound recordings);<sup>201</sup> (c) copyright in a "collective" work is assigned, or a licence is granted to publish a work or a part in a collective work protected by copyright;<sup>202</sup> or (d) an author not falling within these exceptions disposes of the copyright by will.

### 3) Sound Recordings, Performances, Broadcasts

Sound recordings and performances both have a fifty-year term. For sound recordings, this term presently runs from the date when the initial plate (e.g., matrix, tape) was made and is subject to reversion.<sup>203</sup> For a performance, it runs from the date when the performance first took place.<sup>204</sup>

Bill C-32 proposes two changes. Performers would have rights over their recorded performances running for fifty years from the first fixation of the performance in a sound recording. Broadcasters would have rights in the communication signal they transmit for fifty years from the date when the signal was broadcast.<sup>205</sup>

## G. OWNER'S RIGHTS: LITERARY, DRAMATIC, MUSICAL, AND ARTISTIC WORKS

The list of activities set out in the *Act* over which the copyright owner has control has grown longer over the years and will likely continue to do so as right-holders try to tighten control over the newer forms of electronic delivery. Bill C-32 is part of this trend. When Parliament balks, owners sometimes try to achieve their ends by persuading courts to interpret already listed items expansively; for unless an activity is listed, it is no infringement to do it, however harmful or unfair right-holders might think the use is. Since it is easy for a product to qualify

201 *C Act, ibid.*, ss. 10 & 11. The reversion provisions seem to apply to photographs, non-dramatic cinematographs, and sound recordings, even though the language in the *C Act* seems geared more to works with a term of life plus fifty years than to those with a flat fifty-year term.

202 *C Act, ibid.*, s. 2, defines "collective work" as "(a) an encyclopaedia, dictionary, yearbook or similar work; (b) a newspaper, review, magazine or similar periodical, and (c) any work written in distinct parts by different authors, or in which works or parts of works of different authors are incorporated."

203 *C Act, ibid.*, s. 11.

204 *C Act, ibid.*, s. 14.01(5).

205 Bill C-32, above note 9, cls. 23(1)(a), (c), & (2).

for copyright, courts should exercise great care in delineating protection suitable for that type of product. As suggested earlier,<sup>206</sup> a lottery ticket may not merit the same extent and intensity of protection as a book or a computer program. These distinctions must be borne in mind when one interprets whether a user has a formal justification<sup>207</sup> and whether an activity falls under the copyright owner's control in the first place: "the too rigorous application of legal logic" should not replace "common sense," as one court chose to put it.<sup>208</sup>

In the list of activities that follows, anyone doing any of them for whatever reason without the owner's consent may infringe copyright.<sup>209</sup> The owner may or may not give its consent as it wishes, and may impose whatever conditions it wishes.

At least a part of the activity must occur in Canada to be within the owner's control. An offshore Internet service making copyright material available to Canadian subscribers may need Canadian copyright clearance. So may a Canadian user who uploads or downloads material coming from a foreign server.<sup>210</sup> But a Canadian composer may not be able to sue in Canada for any unauthorized reproduction of her music in the United States, even if the copier's company is located in Canada: a U.S. copyright is infringed only in the United States.<sup>211</sup>

## 1) First Public Distribution

The copyright owner has the right to first distribute an unpublished work — to "mak[e] copies. . . [of it or a substantial part] available to the public."<sup>212</sup> Once the first copies of a work have been put on the market, the first distribution right has gone for those works and all other copies of the work. The owner cannot control later distribution of copies of the work, whoever puts them on the market.<sup>213</sup> Some jurisdictions — for example, France, Italy, Chile, and California — allow artists to recap-

206 See section B(1), "Literary, Dramatic, Musical, and Artistic Works," in this chapter.

207 Compare sections J and K, "Users' Rights," in this chapter.

208 *Autospin (Oil Seals) Ltd. v. Beehive Spinning*, [1995] R.P.C. 683 at 700 & 701 (Ch.).

209 C Act, above note 1, ss. 27(1) & 3(1).

210 *C.A.P.A.C. v. International Good Music Inc.*, [1963] S.C.R. 136 at 143 (border television station).

211 *Def Lepp Music v. Stuart-Brown*, [1986] R.P.C. 273 (Ch.). See section G(5), "Telecommunication," in this chapter.

212 C Act, above note 1, ss. 3(1), 4(1) & (2).

213 *Infabrics Ltd. v. Jaytex Ltd.* (1981), [1982] A.C. 1 (H.L.); *Avel Pty. Ltd. v. Multicoin Amusements Pty. Ltd.* (1990), 171 C.L.R. 88 (Austl. H.C.). See section G(10), "Distributing and Importing Infringing Copies," in this chapter.

ture a percentage of an artwork's price on resale, but no such right (sometimes called *droit de suite*) exists in Canada.<sup>214</sup>

The right to distribute is confusingly called a right of publication, reflecting the Act's print bias. It has nothing to do with publication in, say, the law of defamation. Performing, exhibiting, broadcasting, or otherwise telecommunicating a work may publicize it, but does not technically publish it.<sup>215</sup> A question arises whether the presence of the word "copies" (plural) in the above definition requires more than one copy to be made available. The plural form traces back to a *Berne* provision that has given equal trouble internationally.<sup>216</sup> "Copies" is capable of meaning "copy";<sup>217</sup> and one copy of a piece of serious music, a movie, a dreary book, or any posting on the Internet may be quite enough to satisfy public demand. This usage suggests that "copies" may well include a single copy. The key is whether it is made available "to the public." This requirement is not satisfied by making it available to a restricted group of people; this use may be "private," not "public."<sup>218</sup> So first publication occurs only when at least one physical copy is made publicly available free or for sale or hire, with or without advertising or dispositions occurring.<sup>219</sup> Work available online or sitting in a public database may therefore be considered "published."<sup>220</sup>

214 For a recent critique, see J.H. Merryman, "The Wrath of Robert Rauschenberg" (1993) 40 J. Copr. Soc. U.S.A. 241.

215 C Act, above note 1, s. 4(1)(d) to (g). Sculpture or architecture is also not published by issuing photographs or engravings of it: s. 4(1), closing words.

216 *Berne*, above note 2, art. 4(3), def. "published works" (art. 4 of the 1908 and 1928 versions is the same for present purposes); S. Ricketson, *The Berne Convention for the Protection of Literary and Artistic Works, 1886-1986* (London: Centre for Commercial Law Studies, Queen Mary College, 1987) at 182-86.

217 *Interpretation Act*, R.S.C. 1985, c. I-21, s. 33(2).

218 These disclosures, if unauthorized, may amount to an actionable breach of confidence, but that is another matter.

219 *Massie & Renwick*, above note 137; *British Northrop*, above note 96. Exceptionally, to construct architecture or to include artwork incorporated into architecture is also to publish the architecture or artwork: C Act, above note 1, s. 4(1)(b).

220 C Act, *ibid.*, ss. 4(1)(a) to (c); Information Highway Advisory Council, *Final Report of the Copyright Subcommittee: Copyright on the Information Highway* (Ottawa: The Council, 1995) at 11, compare *R. v. M. (J.P.)* (1996), 67 C.P.R. (3d) 152 at 156 (N.S.C.A.) [*M. (J.P.)*], where a seventeen-year-old computer bulletin board operator who made infringing copies of computer software available to selected users was held guilty of the criminal offence of "distribut[ing]" them to the copyright owner's prejudice: C Act, *ibid.*, s. 42(1)(c).



## 2) Reproduction

A central right is "to produce or reproduce the work . . . in any material form whatever."<sup>221</sup> To come under this right, the owner's work must be copied. This means copying the form in which the ideas are expressed — not the ideas themselves, which are free to all. There may be a "reproduction" even if the source work has not been seen by its copier. An engraver may, for example, produce an artwork according to a third party's verbal description of the original, as happened with "knock-offs" of Hogarth's engravings in the eighteenth century; or a photographer may infringe copyright in boat plans by photographing the boat itself. A copy of a copy is still a copy.<sup>222</sup>

The process by which a work is made is critical in deciding if reproduction has occurred. For example, no historian can monopolize her research and sources: a second comer can write a similar history relying on those sources, among others, but he must check them out independently.<sup>223</sup> Similarly, a filmmaker cannot base his treatment on the incidents, dialogue, and treatment of a historical event as interpreted by just one historian, without getting her prior consent.<sup>224</sup> Compilers of information or anthologies may take the idea of making a compilation from previous sources, but they must do their own work. They can use earlier work only to ensure that their own is complete; they cannot proceed the other way round and take a substantial part of the earlier compilation's original selection or arrangement, even if they add their own material.<sup>225</sup>

"Any material form whatever" has been interpreted broadly to cover all forms in which a source work is recast, however much work went into the transformation. So changing direct speech to indirect speech, transcribing a work into or out of code, braille, or shorthand, and video- and audio-taping have all been held to reproduce the source works, whether or not the new format was immediately humanly perceptible as

221 C Act, *ibid.*, s. 3(1).

222 *Dorling v. Honnor Marine Ltd.* (1964), [1965] Ch. 1 at 22–23 (C.A.).

223 *Jarrol v. Houlston* (1857), 3 K. & J. 708 at 714–17, 69 E.R. 1294 (Ch.).

224 *Harman Pictures*, above note 30, Compare *Hoehling v. Universal City Studios Inc.*, 618 F.2d 972 (2d Cir. 1980): facts and information have no copyright; infringement occurs only when actual expression is lifted.

225 *Macmillan & Co. Ltd. v. Cooper* (1923), 93 L.J.P.C. 113 at 117–21; compare *Cambridge University Press v. University Tutorial Press* (1928), 45 R.P.C. 335 (Ch.): an annotated compilation of thirteen Hazlitt essays with notes was not infringed by a later compilation of twenty essays that included the same thirteen but differently arranged and annotated.

a copy.<sup>226</sup> Similarly, two-dimensional artwork is “reproduced” in three dimensions, and vice versa, if the copy looks like its source. So the copyright owner of a cartoon character may control the making of toy doll replicas from it. Similarly, *tableaux vivants* may infringe a painting, and a building may infringe drawings or plans.<sup>227</sup>

Whether such transformed work should legally infringe the source work is another question. Too often courts mechanically assume that any unauthorized reproduction must be an infringement, whatever the nature and extent of the transformation. Thus postmodernist artist Jeff Koons was found by a U.S. court to have infringed copyright in a commonplace photograph by mimicking it in a large sculpture he designed and exhibited, even though the sculpture was meant to critique modern culture.<sup>228</sup> A century ago, when art flourished at least as much as today, this result would have been unthinkable.<sup>229</sup> And had the U.S. court been applying law like this in Shakespeare’s time, a very different opus from the Bard would be with us now. In deciding issues of infringement, especially in an era of high experimentation with digital technology, courts must consider not only the parties’ immediate interests but also how any decision may affect future artistic behaviour.<sup>230</sup> So, in Koons’s case, why postmodernism had to suffer at the hands of modernism certainly requires explanation, if not justification.

#### a) Computer Programs and Files

Copying source or object codes may reproduce the program as a literary work. The fact of reproduction may be demonstrated through expert evidence. Even rewriting code to achieve the same effect as a previous program may “reproduce” the latter. Thus, non-literal copying of a program’s structure — for example, its flow charts and organization of modules — has been held to “reproduce” the program, just as a dramatic work can be infringed by adopting its overall structure, charac-

226 C Act, above note 1, s. 2, def. “infringing”; *Apple*, above note 14. Bill C-32, above note 9, cl. 32, would allow works to be put in more suitable format for the blind in some circumstances.

227 *King Features Syndicate Inc. v. O. & M. Klecman Ltd.*, [1941] A.C. 417 (H.L.); *Bradbury, Agnew & Co. v. Day* (1916), 32 T.L.R. 349 (K.B.); *Netupsky*, above note 179.

228 *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992) [Rogers]; K. Bowrey, “Copyright, the Paternity of Artistic Works, and the Challenge Posed by Postmodern Artists” (1994) 8 I.P.J. 285 at 311ff.

229 *Hanfstaengl v. Empire Palace*, [1894] 3 Ch. 109 (C.A.).

230 See R. Posner, *Law and Literature: A Misunderstood Relation* (Cambridge, Mass.: Harvard University Press, 1988) at 343ff.

ters, plot development, and dénouement.<sup>231</sup> Similarly, the displays of a videogame may be protected as an artistic or dramatic work.<sup>232</sup> But any idea or "any method or principle of manufacture or construction"<sup>233</sup> is not protectable, so any features of a program dictated by functional considerations can be copied. Copyright in a user interface and screen display has therefore been denied, for there were only a few ways to design these elements. To force later programmers to design around them would indirectly protect the underlying ideas.<sup>234</sup> More recently, a U.S. court held the menu command tree on the Lotus 1-2-3 program an unprotectable "method of operation." Without the commands, the program was as useless as a VCR with no operating buttons.<sup>235</sup>

Computer files are certainly "reproduced" when copied to a computer's permanent memory (hard disk, tape, or diskette). U.S. courts have even held that it is infringement to download a file into temporary volatile memory so it may be viewed on a monitor — thereby creating for works in electronic form a new right: the exclusive right to read. One hopes this result will be avoided in Canada, but one cannot be confident.<sup>236</sup>

The concept of reproduction in relation to works in electronic form raises many difficulties. For example, artwork scanned into a computer file may be converted into a binary form that does not look at all like the source, but the artwork is probably "reproduced" in the file. But what if the file is later electronically manipulated so that the artwork no longer looks like its source? It should no longer be a "reproduction" of the former artistic work if the result is judged visually. But what if substantial parts of the underlying binary code are still the same? Can this be a reproduction of the underlying literary work? One trusts not. An impressionist painter may copy another's brushstrokes, and yet produce a painting that would strike the ordinary art lover as quite different. Why should this painting be held a "reproduction" of the first work, just

231 *Computer Associates International Inc. v. Altai Inc.*, 982 F.2d 693 (2d Cir. 1992).

232 *Stern Electronics Inc. v. Kaufman*, 669 F.2d 852 at 855 (2d Cir. 1982).

233 C Act, above note 1, s. 64.1(1)(d).

234 *Delrina*, above note 22 at 44.

235 *Lotus*, above note 25.

236 *MAI Systems Corp. v. Peak Computer Inc.*, 991 F.2d 511 (9th Cir. 1993) [MAI], criticized by J. Litman, "The Exclusive Right to Read" (1994) 13 *Cardozo Arts & Ent. L.J.* 29 at 40; D. Vaver, "Rejuvenating Copyright, Digitally," in *Symposium of Digital Technology and Copyright* (Ottawa: Department of Justice, 1995) 1 at 3–5, Compare Information Highway Advisory Council, *Final Report: Connecting Community Content: The Challenge of the Information Highway* (Ottawa: The Council, 1995) at 114–15 [Challenge] (copyright owner should be able to control "browsing").

because an art expert can trace the influences? The brushstrokes, like the electronic bits and bytes, are a means to an end. Art may best be judged by its impact on its intended market — typically, art buyers and spectators, not experts on artistic technique.

### b) Subconscious Copying

Reproduction implies that there is a causal connection between an earlier and a later work, although the copier may not have intended to reproduce or may not have known he or she was doing so. Moreover, close similarity between the two works, if the defendant had access to the first, presents a *prima facie* case the defendant must answer to avoid infringement.<sup>237</sup>

In combination, these two rules create a dilemma for anyone who may have seen or heard a work long ago, retained it in his subconscious memory, and later reproduced a major part without knowing it. A U.S. court found infringement in such a case against ex-Beatle George Harrison for subconsciously copying the Chiffons' 1962 hit "He's So Fine" in his 1970 composition "My Sweet Lord."<sup>238</sup> In upholding a substantial award of damages against Harrison, the appeal court said that "as a practical matter" any other rule "could substantially undermine" copyright protection.<sup>239</sup>

The issue is more complex than it would appear: cryptomnesia — involuntarily recalling something one's memory chose to retain — is not uncommon today, when so much of the manufactured environment to which everyone is daily exposed is protected by copyright. All authorship has even been called the "astigmatic repackaging of others' expression."<sup>240</sup> The problem is the defendant's lack of moral culpability: his subconscious, not he, was in control, without his knowing or being able to influence it. Society does not usually hold people legally responsible where their mind does not prompt or direct their actions. Sleepwalkers, automatons, the very young, and the insane are not usually liable for assaults or trespasses, because they cannot appreciate the nature or quality of what they are doing. The same sort of "somewhat uneasy compromises"<sup>241</sup> struck for such people may need to evolve for cryp-

237 *Francis Day & Hunter Ltd. v. Bron*, [1963] Ch. 587 (C.A.).

238 *Bright Tunes Music Corp. v. Harrisongs Music Ltd.*, 420 F. Supp. 177 (D.N.Y. 1976); compare *Gondos v. Hardy* (1982), 38 O.R. (2d) 555 (H.C.J.).

239 *ABKCO Music Inc. v. Harrisongs Ltd.*, 722 F.2d 988 at 999 (2d Cir. 1983).

240 J. Litman, "The Public Domain" (1990) 39 Emory L.J. 965 at 1011.

241 *Williams v. Williams* (1963), [1964] A.C. 698 at 752 (H.L.) (insanity). The fear that cryptomnesia will become a defence *à la mode* is unrealistic, any more than insanity or somnambulism have become such defences in civil cases.

tomnesiacs. The copyright owner may sometimes perhaps deserve protection, but it seems hard to justify the full schedule of remedies against the “infringer”; perhaps at most an injunction and an account of profits, deducting any added value. As copyright-protected material comes to occupy more and more of everyone’s physical and mental space, copyright holders as a group may have to make do with a lower overall level of protection if society is to be allowed to function reasonably or at all. This relaxed approach may not, of course, apply against the habitual involuntary recaller: courts will no doubt help him “get out of the author business and go to digging ditches, where his mind will not be able to pilfer.”<sup>242</sup>

### 3) Subsidiary Rights

Some rights are variants on the right to reproduce.

#### a) Abridgment

Abridgments and condensations are within the owner’s right to “reproduce . . . [a] substantial part” of the work.<sup>243</sup> This category includes both “scissors and paste” versions (e.g., trimming a seven-volume report down to one volume) and *Coles’ Notes*-like condensations.<sup>244</sup> Short abstracts that whet the reader’s appetite — such as those found at the head of articles in many periodicals — should usually fall outside this right. Abstracts that substitute for the original are different: a newspaper’s systematic abstraction of analyses from a financial newsletter “suck[ed] the marrow from the bone” of the source work and was enjoined.<sup>245</sup>

#### b) Translation

The right to translate is specifically mentioned in the *Act*.<sup>246</sup> It encompasses changing a work in one language or dialect into another. Even

242 E.P. Butler, “Pigs Is Pigs’ and Plagiarists Are Thieves,” in M. Salzman, *Plagiarism: The “Art” of Stealing Literary Material* (Los Angeles: Parker, Stone & Baird, 1931) at 70.

243 *C Act*, above note 1, s. 3(1); D. Vaver, “Abridgments and Abstracts: Copyright Implications” [1995] 5 E.I.P.R. 225.

244 *James Lorimer*, above note 168; *Sillitoe v. McGraw-Hill Book Co. (U.K.) Ltd.* (1982), [1983] F.S.R. 545 (Ch.) [*Sillitoe*].

245 *Wainwright Securities Inc. v. Wall Street Transcript Corp.*, 418 F. Supp. 620 at 625 (D.N.Y. 1976), aff’d 558 F.2d 91 (2d Cir. 1977).

246 *C Act*, above note 1, s. 3(1)(a); D. Vaver, “Translation and Copyright: A Canadian Focus” [1994] 4 E.I.P.R. 159.



some computer programming may be included — for example, changing code from Pascal to Fortran.<sup>247</sup> But just as changing text into braille is reproduction, not translation, converting source to object code should not be translation either: one set of symbols is simply switched for another or for electrical circuitry.

### c) Novelization, Dramatization, Movie Adaptation

Novelization, dramatization, and movie adaptation are separate rights in the Act.<sup>248</sup> They can cover quite unusual cases. Thus, *Coles' Notes'* version of Shaw's *St. Joan* infringed the novelization right by converting the play into a non-dramatic work. The summary was in indirect speech, interspersed with criticism, and intended as a study aid; but none of this mattered.<sup>249</sup> More typically, making a play or a movie will usually engage these rights. Taking a substantial part of either the dialogue or the plot of the source work may then infringe. Just taking one or two ideas or situations may not be enough, but reproducing the combination and sequence of incidents and characters has been held to be infringement.<sup>250</sup>

The protectability of characters alone has been much debated. Cartoon characters are usually more easily recognizable, and hence protectable, in movie or other adaptations than are literary characters. So Walt Disney has stopped Goofy, Mickey, and other characters from being recast in counter-culture comic books and films.<sup>251</sup> Courts are more reluctant to protect literary characters, even "obvious" copies of characters "as distinctive and remarkable" as Falstaff, Tartuffe, or Sherlock Holmes. A U.S. judge put it neatly:

If *Twelfth Night* were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress. These would be no more than Shakespeare's "ideas" in the play, as little capable of monopoly as Einstein's Doctrine of Relativity, or

247 *Prism Hospital Software Inc. v. Hospital Medical Records Institute* (1994), 57 C.P.R. (3d) 129 at 278 (B.C.S.C.).

248 C Act, above note 1, ss. 3(1)(b), (c) & (e).

249 *Sillitoe*, above note 244 at 550–51.

250 *Kelly v. Cinema Houses Ltd.* (1932), [1928–35] MacG. Cop. Cas. 362 (Ch.), aff'd (1932), [1928–35] MacG. Cop. Cas. 371 (C.A.) [*Kelly*]; *Harman Pictures*, above note 30 (John Osborne film script for *The Charge of the Light Brigade* infringed Cecil Woodham-Smith's book).

251 *Walt Disney Productions v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978).

Darwin's theory of the Origin of Species. It follows that the less developed the characters, the less they can be copyrighted: that is the penalty an author must bear for marking them too indistinctly.<sup>252</sup>

A Canadian court also indicated its willingness to protect the characters in a script for a science fiction movie if they were "sufficiently clearly delineated," but found they did not meet this test on the facts.<sup>253</sup>

#### d) Film, Audio and Video Recording

These "mechanical" rights are part of "the sole right . . . to make any record, perforated roll, cinematograph film or other contrivance by means of which the [literary, dramatic, or musical] work may be mechanically performed or delivered."<sup>254</sup> Sound and video recordings are obviously "contrivances," while record pressers, film processors, and the persons ordering the pressing or processing are included as "makers."<sup>255</sup> Even ephemeral recordings, such as those a broadcaster makes for technical reasons, have fallen under this right. So a broadcaster who transfers a work, for which it has telecommunication rights, onto a more suitable medium for broadcast in a different time zone must pay an additional fee to the owner of the mechanical reproduction right.<sup>256</sup> A temporary synchronization like this is specifically exempted in some countries, but Canada is not yet one of them.

#### 4) Public Performance

Public performance is a major means by which copyright owners make money from music, drama, and movies.<sup>257</sup> Since a performance is defined as "any acoustic representation of a work or any visual representation of a dramatic work," both live and recorded performances are included. Performance includes whatever is seen or heard when a radio, television set, or an audio or video player is turned on.<sup>258</sup>

252 *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 at 121 (2d Cir. 1930) [*Nichols*], criticized as involving vague aesthetic judgment by E.M. Nevins Jr., "Copyright + Character = Catastrophe" (1992) 39 J. Copr. Soc. U.S.A. 303 at 309ff.

253 *Preston v. 20th Century Fox Canada Ltd.* (1990), 33 C.P.R. (3d) 242 at 275, aff'd (1993), 53 C.P.R. (3d) 407 (Fed. C.A.) (*Ewoks in Return of the Jedi*).

254 C Act, above note 1, s. 3(1)(d). Bill C-32 would modernize this language.

255 *Warner Brothers-Seven Arts Inc. v. CESM-TV Ltd.* (1971), 65 C.P.R. 215 at 241 (Ex. Ct.); *Compo Co. v. Blue Crest Music Inc.* (1979), [1980] 1 S.C.R. 357 [*Compo*].

256 *Bishop v. Stevens*, [1990] 2 S.C.R. 467.

257 C Act, above note 1, s. 3(1). The right also encompasses public delivery of lectures, addresses, speeches, sermons, and the like.

258 C Act, *ibid.*, ss. 3(1) & 2 def. "performance."

Actors and musicians obviously qualify as performers, but so may anyone who causes a performance to be represented. This includes everyone from the owner of the cabaret where the band or radio plays down to the person who actually switches on the radio or television set.<sup>259</sup> Broadcasters and cablecasters also perform in public where a studio audience is present, but not when they transmit their programming: a separate right of public telecommunication<sup>260</sup> is designed not to overlap with public performance.<sup>261</sup>

A special provision extends liability where theatres and other places of entertainment are used for private profit for a public performance. If the performance has no copyright clearance, anyone "permitting" the premises to be used for it also infringes copyright, unless he was unaware and had no reasonable ground for suspecting the lack of clearance. Simply leasing or licensing premises to a performing group is not in itself "permission"; there must be some control over the performers, knowledge of the particular work to be performed, and permission to use the premises for that performance.<sup>262</sup>

Everyone is of course fully entitled to play records or the radio in private. What is not permissible is to perform a work "in public" without the copyright owner's consent. What amounts to a performance "in public" usually depends on the character of the audience. On the one hand, private or domestic performances are excluded: this exclusion should cover those in private homes and apartments, or in rooms hired for weddings, confirmations, or batmitzvahs, where the guests are family and friends and the premises are an extension of the host's home. On the other hand, performances occurring "openly, without concealment and to the knowledge of all," have been said to be "in public," whether or not anyone intends to make money from the performance. This test would include restaurants, cabarets, arenas, members' clubs open to invited guests, and offices, factories, or elevators where music plays to relax staff or customers.<sup>263</sup> Grey areas still abound. What of a performance at a firm's Christmas

259 *Vigneux v. Canadian Performing Right Society*, [1945] A.C. 108 (P.C.) [*Vigneux*].

260 See section G(5), "Telecommunication," in this chapter.

261 *C Act*, above note 1, s. 3(+), overruling *Canadian Cable*, above note 70.

262 *C Act*, *ibid.*, s. 27(5); *Corporation of the City of Adelaide v. Australasian Performing Right Assn. Ltd.* (1928), 40 C.L.R. 481 (Austl. H.C.); *de Tervagne v. Beloeil (Town)*, [1993] 3 E.C. 227 (T.D.). See also section G(8), "Authorization," in this chapter.

263 *Canadian Cable*, above note 70; *Performing Right Society Ltd. v. Rangers EC Supporters Club*, [1975] R.P.C. 626 (Ct. Sess., Scot.); compare *NAFTA*, above note 2, art. 1721, defining "public." The performance must be for "private profit" only where liability is extended to someone "permitting" a theatre or other place of entertainment to be used: *C Act*, *ibid.*, s. 27(5), discussed in the previous paragraph.

party: Are the employees there privately or as members of the public? An Australian case, interestingly, suggests the latter. An employer who played an instructional video at the workplace to a small group of employees was found to have put on a public performance. The ties that bind employees were thought to be commercial, not private or domestic.<sup>264</sup>

What of hotels that rent movies to guests to play in their rooms? In Australia, the hotel was said to be causing public performances; not so in the United States.<sup>265</sup> The U.S. rule seems preferable. The guest is, in relation to the hotel, certainly a member of the public; but the performance is surely in private, because the hotel room is merely a person's temporary home. Had the guest hired the movie from a separate rental store, the performance in her room would have been "in private." How can the identity of the supplier change the character of the performance? Finding the performance to be private nonetheless creates an anomaly: rental gets a competitive edge over in-house cable delivery systems that must pay copyright fees for "[tele]communicat[ing] to the public."<sup>266</sup> Substitute delivery systems should compete on their merits. Either both or neither should pay. Copyright law here should strive for technological neutrality.

## 5) Telecommunication

The right to communicate "to the public by telecommunication" covers transmission by "wire, radio, visual, optical or other electromagnetic system."<sup>267</sup> Sending works by radio, television, cable, fax, modem, satellite, or microwave involves telecommunication. But, to attract liability, the communication must be "to the public."<sup>268</sup> Such communication should exclude point-to-point e-mail and faxes, and transmissions between a network and its affiliate television stations.<sup>269</sup> It would, how-

264 *Australasian Performing Right Assn. Ltd. v. Commonwealth Bank of Australia* (1992), 40 F.C.R. 59 (Austl. Fed. Ct.).

265 *Rank Film Production Ltd. v. Dodds* (1983), 76 F.L.R. 351 (N.S.W.S.C.); compare *Columbia Picture Industries Inc. v. Professional Real Estate Investors Inc.*, 866 F.2d 278 (9th Cir. 1989).

266 *Canadian Cable*, above note 70; see section G(5), "Telecommunication," in this chapter.

267 C Act, above note 1, s. 3(1)(f); s. 2 def. "telecommunication."

268 Perhaps broader than the corresponding words "in public" [emphasis added] in the public performance right: *Canadian Cable*, above note 70 at 148-49.

269 A public communication occurs only when the affiliate airs the program; the network and the affiliate are then jointly liable: *CTV Television Network Ltd. v. Canada (Copyright Board)*, [1993] 2 F.C. 115 (C.A.) [CTV]; C Act, above note 1, s. 3(1.4). The provider of the means of carrying the communication is not liable: C Act, *ibid.*, s. 3(1.3).

ever, include programming — ordinary, scrambled, or interactive — delivered by cable to private subscribers.<sup>270</sup> A mass unsolicited faxing of material to telephone subscribers may also be included. So may data posted on publicly accessible electronic bulletin boards as the Internet, even if people access the data at different times from different places.<sup>271</sup>

Special schemes regulate the licensing and payment for cable retransmissions and music used in public telecommunication.<sup>272</sup> Indeed, the Society of Composers, Authors and Music Publishers of Canada recently filed a proposal with the Copyright Board to require Internet providers of musical works to pay royalties from 1996 at the greater of the rate of twenty-five cents per month per subscriber or 3.2 percent of gross revenue from advertising.<sup>273</sup> The Copyright Board is expected to give a decision shortly on whether this activity falls within this right and, if so, what method of charging for it would be appropriate.

## 6) Public Exhibition of Artwork

The copyright owner of an artistic work (except a map, chart, or plan) has the right to present it "at a public exhibition," other than for sale or hire. This right applies to works made after 7 June 1988, the date the right was first introduced.<sup>274</sup> Galleries and museums that exhibit such works are typically included; dealer galleries are not, unless the work is there purely for exhibition. Works hanging in public lobbies may not be covered either, although the point is unclear.<sup>275</sup> Whether finger-paintings hung in school hallways come under the right is a problem that caused some school boards initial anxiety, but no budding Picasso has yet come forward to sue.

Like the public performance right, this right is supposed to return some benefit to artists for the public exposure of their work. It is often more symbolic than practical. Institutions may be loath to exhibit a

270 CTV, *ibid.* This includes a communication exclusively to occupants of apartments, hotel rooms, or dwelling units in the same building; *C Act, ibid.*, s. 3(1.2).

271 Compare *Challenge*, above note 236 at 114; *M. (J.P.)*, above note 220, where a computer bulletin board operator, who made infringing copies available to selected users, was found guilty of "distribut[ing]" them to the copyright owner's prejudice, contrary to s. 42(1)(c) of the *C Act*.

272 See sections K(1) and K(2) in this chapter.

273 Further on SOCAN, see section K, "Users' Rights: Paying Uses," in this chapter.

274 *C Act*, above note 1, s. 3(1)(g). See W. Noel, *The Right of Public Presentation: A Guide to the Exhibition Right* (Ottawa: Canadian Conference of the Arts, 1990).

275 Compare French version of *C Act, ibid.*, s. 3(1)(g): "présenter [une oeuvre artistique] au public lors d'une exposition."



work unless the artist waives her right to demand a fee. If the artist holds out, there is usually plenty of pre-1988 material that can be shown free.

## 7) Rental

Canadian authors have, since 1987, received money from a fund administered by the Public Lending Rights Commission (now under the Canada Council) to compensate for book loans made through public libraries. Around \$6 million per year is distributed to 7000 writers. The scheme does not operate within the copyright system, partly to avoid any obligation to pay foreign authors.

No right to control renting exists under copyright, except for computer programs rented out "for motive of gain."<sup>276</sup> Only easily reproducible over-the-counter operating or application programs are targeted. Videogame cartridges, encrypted programs reproducible only by experts, or hard-wired programs that help run items like dishwashers or automobiles are outside the right. For programs that are caught, all types of rental (including sham transactions) should be encompassed. Loss leading and cross-subsidization practices may not avoid liability; businesses that try to attract custom by offering free rentals are obviously pursuing a motive of gain, for their purpose is to profit financially.<sup>277</sup> Genuine sales or inventory financing involving lease-back or rent-to-own schemes should, however, be excluded. So should loans by non-profit libraries, members' clubs, or other cases where no more than a cost recovery, including overhead, charge is made.<sup>278</sup>

The rental right is an exception to the rule that copyright owners cannot control dispositions past the first public distribution.<sup>279</sup> It was created because the computer industry claimed that renting cut into sales, since some renters illicitly copied programs before returning them. So far, this right is used by owners more to close down operations than to provide an alternative means of exploiting their products. This practice may change as owners experiment with rental as one form of delivery on the Internet.

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276 *C Act*, *ibid.*, s. 3(1)(h) & s. 3(2); D. Vaver, "Record and Software Rentals: The Copyright Spin" (1995) 10 I.P.J. 109. A similar rental right also applies to sound recordings; *C Act*, *ibid.*, ss. 5(4)–(6); see section D, "Sound Recording, Performances, Broadcasts," in this chapter.

277 Compare *C.A.P.A.C. v. Western Fair Assn.*, [1951] S.C.R. 596 [*Western Fair*].

278 *C Act*, above note 1, ss. 3(2)(a) & (3).

279 See section G(1), "First Public Distribution," in this chapter.

## 8) Authorization

The owner can "authorize" any of the above rights that fall under the definition of copyright.<sup>280</sup> In practice, the authorization right attaches liability to people beyond those who actually commit the infringing act. Thus, whoever grants, or purports to grant, expressly or impliedly, the right to reproduce or perform a work in public has been held to "authorize" the reproduction or performance. The authorizer is then as liable as the reproducer or the performer.<sup>281</sup> A publisher or a record company placing orders with a printer or a presser has been found to "authorize" the reproduction. Someone hiring a dance orchestra and giving it full discretion to play whatever the conductor chooses also impliedly authorizes the performance. A cablecaster, too, has been held liable for impliedly authorizing bars that are its subscribers for the public performance that occurs when the television set is turned on for the patrons to watch cable.<sup>282</sup> Liability attaches only if the "authorized" act occurs, although *quia timet* relief is available where the act authorized has not yet been committed.

Buyers of blank tapes may use them to record music without authority. Similarly, VCR users may record programming off air or from other tapes. It is, of course, difficult and politically embarrassing to pursue individual private users. Copyright owners have therefore moved against manufacturers and sellers or lenders of records, blank tapes, and copying and recording machines to try to hold them liable for the infringing acts of buyers or hirers. These attempts have typically failed.<sup>283</sup> Courts have said that merely to provide the means of infringement is not the same as authorizing it, any more than someone selling a gun thereby authorizes a buyer to hunt without a licence or to commit a crime.<sup>284</sup> A supplier of a jukebox and records at a fixed rental to a restaurant was found not to authorize the hirer to publicly perform the music on the records.<sup>285</sup>

280 *C Act, ibid.*, s. 3(1), closing words; see section G(4), "Public Performance," in this chapter.

281 *Muzak Corp. v. C.A.P.A.C.*, [1953] 2 S.C.R. 182 at 189 [*Muzak*].

282 *Compo*, above note 255; *Canadian Performing Right Society v. Yee* (1943), 3 C.P.R. 64 (Alta. Dist. Ct.); *Canadian Cable*, above note 70.

283 *CBS Songs Ltd. v. Amstrad Consumer Electronics*, [1988] A.C. 1013 (H.L.); *Sony Corp. of America v. Universal City Studios Inc.*, 464 U.S. 417 (1984).

284 *Muzak*, above note 281.

285 *Vignoux*, above note 259. The hirer and its customers, however, both performed the work in public. Had the supplier told the hirer that public performances could occur without fee, or if they were partners or joint venturers, authorization might have been found: *Muzak, ibid.*, at 189.