

Canadian Supreme Court Rules on Republication of Articles in Context of Electronic Media

By James M. Thurman

I. Introduction

In *Robertson v. Thomson Corp.*,¹ the Canadian Supreme Court dealt principally with the question of whether publishers are free to republish in electronic databases articles they have accepted from freelance journalists for publication in their newspapers. The Court held that, without prior consent and corresponding compensation, the publisher, as rightsholder in the newspaper, may only freely republish a freelance article within the context of the entire newspaper or a substantial portion of it. Newspapers represent a collective work, and whether a particular reproduction represents a substantial portion of a newspaper is a *qualitative* question of whether the reproduction maintains the essence of originality in which the publisher's copyright resides. In the case of newspapers, this essence consists of the *editorial content* of the work. Thus, the Court held that where an electronic database represents more a new collection of individual articles rather than reproducing the originality of the newspaper(s) in which the articles initially appeared, it cannot represent a reproduction or republication of the original work.

II. Factual Background

The plaintiff, Heather Robertson, was a freelance writer who submitted two articles to the *Globe and Mail* (Toronto) newspaper for publication in 1995. The first article—an excerpt from a book Robertson had authored—was governed by an agreement between the *Globe* and the publisher of the book. The second article consisted of a book review which was submitted under an oral agreement between Robertson and the *Globe*. Surprisingly, according to the Court, neither agreement addressed copyright issues.

The publishers of the *Globe*—the Thomson Corporation, Thomson Canada Limited, Thomson Affiliates, Information Access Company, and Bell GlobeMedia Publishing Inc.—maintained two online databases that were at issue in the case. One was “Info Globe Online,” which granted users access on a paid subscription basis to *Globe* articles as well as to materials from other newspapers, news wire services, magazines, and reference databases. The other database was an electronic version of the Canadian Periodical Index known as CPI.Q, which indexed selected newspaper articles from various newspapers. Both databases featured search functions to retrieve articles and, in addition to displaying the articles, permitted users to print them. Info Globe Online also allowed subscribers to download

articles. Notably, within both databases “advertisements, some tables, photographs, artwork, photo captions, birth and death notices, financial tables, weather forecasts, and some design elements from the original print edition” had been removed from featured articles.

In addition, the publishers began producing a series of CD-ROMs in 1991 which contained electronic versions of the *Globe* and several other Canadian newspapers published each year. Like the other two databases, the CD-ROMs featured a search engine for locating articles, and advertisements and photos were removed from the articles. Unlike the other databases, however, the content was fixed and finite.

The publishers included Robertson's articles in all three databases without seeking her permission or providing her with additional compensation. For this reason, Robertson brought suit for copyright infringement in the Ontario Court of Justice together with a class of plaintiffs consisting of all contributors to the *Globe* other than those who died on or before December 31, 1943.²

III. Procedural History

On behalf of herself and Cameron Smith, a *Globe* employee, Robertson brought a motion for partial summary judgment and sought an injunction preventing the publishers from using their articles in the databases. Although the motions judge seemed to be convinced that publication of Robertson's articles in all three databases would constitute *prima facie* copyright infringement, the motion for partial summary judgment was ultimately dismissed, as the judge found genuine issues for trial concerning the publishers' asserted contractual defenses.³

Upon Robertson's appeal and the publishers' cross-appeal of the motions judge's decision, the Ontario Court of Appeals dismissed both in a 2-1 decision. Although the majority did not accept all aspects of the motions judge's ruling, they agreed that none of the republications in the databases constituted reproduction of a substantial portion of the newspapers. The majority found that a qualitative test was necessary to determine whether both the selection and arrangement of the original collective work were reproduced in the databases. Since the articles in the database had been “disentangled” from their setting in the newspaper, their arrangement within the collective work was lost, and, accordingly, they could not be covered by the copyright in the collective work. Moreover, the majority found that, with respect to Info Globe Online and CPI.Q, both the form and function of the database collections

differed from that of the original newspapers, since the databases continuously expanded and served research purposes rather than a news function.

The majority also dismissed the appeal, agreeing with the motions judge that the grant of a non-exclusive license did not need to be in writing and that Robertson did not have standing to seek an injunction on behalf of Smith.

One Court of Appeals judge, Blair, dissented in part. Judge Blair argued that the question of copyright infringement should be framed as whether the electronic version of the *Globe* as found in the databases reproduced the collective work. If an article were placed in the database as part of the collective work, he contended, it was irrelevant how the article was “located, deconstructed, identified, retrieved, or displayed on screen.”⁴ Blair also seemed to find it significant that the display of retrieved articles indicated which edition they were pulled from in addition to other details such as whether they were originally accompanied by an illustration. With regard to Smith’s claim, Blair argued that the reproduction of employee articles in the electronic version of the *Globe* fell within the publishers’ rights under section 13(3) of the Canadian Copyright Act to publish employee articles in “a newspaper, magazine or similar periodical.”

IV. Supreme Court Ruling

A. Copyright Infringement of Freelance Articles

Following the decision of the Ontario Court of Appeals, both parties filed applications for leave to appeal to the Supreme Court of Canada.⁵ These applications were subsequently granted.⁶ The Supreme Court addressed four issues: On cross-appeal were the questions of whether reproduction in the databases infringed the rights of freelance writers and whether it infringed the rights of *Globe* employees. On appeal were two other questions: whether a license to republish a freelance writer’s article in an electronic database would need to be in writing and whether Robertson had standing to bring a claim on behalf of *Globe* employees.

Taking up the issues of the cross-appeal first, Justices LeBel and Fish, writing for the majority, noted that the publishers did not have a copyright in the individual articles of freelance contributors but, rather, had a distinct copyright in the newspaper as a whole. Additionally, a newspaper could be considered a “compilation” or a “collective work” under section 2 of the Canadian Copyright Act. The qualification of newspapers as compilations was particularly significant for the Court’s analysis, as explained below. Under section 3(1), the publishers were endowed with the right to produce or reproduce their newspaper “or any substantial part thereof in any material form whatever.” Thus, the Court reasoned, the question boiled down to whether the databases repro-

duced the newspapers or merely the individual articles. This question could be reformulated as whether the databases reproduced the “originality” of the individual authors alone or that of the newspaper publishers in the collective work.

Citing the case of *CCH Canadian Ltd. v. Law Society of Upper Canada*,⁷ the Court repeated the words of Chief Justice McLachlin that “originality” within the context of copyright law consists in “the exercise of skill and judgment”⁸ and that where a *compilation* is concerned, the originality of the work may reside in the *form* of the work.⁹ The Court in the present case declared that a newspaper represents a compilation resulting from the exercise of skill and judgment in selection and arrangement. Since “compilation” was defined under the Copyright Act as a work resulting from selection or arrangement, however, the Court concluded that a compilation did not require originality in both its selection *and* arrangement in order to qualify for copyright protection. Therefore, the Court disagreed with the majority below, finding that a reproduction of a compilation need not preserve both the selection and arrangement of the original in order to be within the publisher’s reproduction rights.

The Court thus concluded that the selection alone could constitute a substantial part of a newspaper so long as the essence of the original newspaper was maintained. For newspapers, this essence consists of the editorial content of the paper. However, the Court went on to state that, at a minimum, the editorial content would have to be reproduced *within the context* of the newspaper.¹⁰ Thus, it was within the publishers’ reproduction rights to reproduce the newspaper “without advertisements, graphs, charts, or in a different layout and using different fonts,” but the articles could not be “decontextualized to the point that they are no longer presented in a manner that maintains their intimate connection with the rest of that newspaper.”¹¹

On this basis, the Court determined that the Info *Globe* Online and CPI.Q databases did not constitute reproductions that fell within the publishers’ rights. In these databases, *Globe* articles were stored and presented together with “thousands of other articles” from different periodicals and with different publication dates. Furthermore, the content of the databases was constantly expanding on a daily basis as more articles were added. Thus, the Court reasoned, they were more akin to a collection of individual articles than to reproductions of the *Globe* newspaper. In short, they reproduced the originality of the individual articles and not that of the newspaper.

The Court rejected the publishers’ argument that the inclusion of references with each article to the original newspaper in which that article appeared, together with the corresponding date and page number, was sufficient to establish the necessary contextual link to the newspa-

per. Here, the Court referred to the reasoning of the U.S. Supreme Court in *New York Times Co. v. Tasini*.¹² In that case, Justice Ginsberg, writing for the Court, suggested that such references gave an indication of what periodical the article was previously a part, but that did not automatically mean that the article was being reproduced or distributed as part of that periodical.¹³ Similarly, the Court contended that the inclusion of similar references in Info Globe Online and the CPI.Q provided *historical* information but did not recreate the contextual element of the original *Globe* as a collective work.

The Court also rejected the publishers' argument that the analysis should focus on the *input* of the database rather than the *output*. The publishers argued that the *Globe* articles were input into the database in such a way that each edition of the *Globe* was stored in its own file. The Court, however, indicated that such an approach would ignore the final product as it is presented to the public and that this manifestation of the work was the proper one to compare with the original in determining whether it constituted a permitted reproduction. This final product, according to the Court, was not merely a presentation of a number of collected works joined together, but rather constituted "a collective work of a different nature."¹⁴

Additionally, the Court made clear that the addition of search functionality within the databases was irrelevant to the analysis. The principle of media neutrality inherent in section 3(1) of the Copyright Act, the Court maintained, "precludes a finding of copyright infringement merely because it is possible to search with more efficient tools than in the past."¹⁵ The principle, however, does not give publishers carte blanche with regard to republication of the works once those works have been converted into digital form.

With regard to the CD-ROMs, however, the Court held that there was no infringement of the freelancers' copyrights. Although the CD-ROMs also presented the articles without advertisements, pictures, or color and presented them in a different medium and format than in the original newspaper edition, the Court found that the CD-ROMs preserved the critical link to the newspaper in which the articles first appeared. As opposed to a collection of individual articles, the Court contended that the CD-ROM represented a compendium of daily newspaper editions. Upon loading the database, the user was able to view each newspaper individually. Moreover, when viewing an individual article within a newspaper, the user was presented in the right-hand frame of the screen with a list of the other articles that appeared in the same edition. In this way, the Court found that the CD-ROMs preserved the essence of the original newspaper as a collective work. This circumstance was not defeated by the fact that the *Globe* was included together with a number

of other newspapers on the CD, since it was possible to view each newspaper individually.

B. Licensing Issue

With regard to the licensing issue, the Court began its analysis with an examination of the relevant provisions of the Copyright Act. Section 13(4) of the Copyright Act indicates that the whole or partial assignment of copyright as well as a grant in an interest in the copyright may only be carried out in writing. Section 13(7), however, establishes that an *exclusive license* constitutes the grant of an interest in copyright.¹⁶ The Court cited *Ritchie v. Sawmill Creek Golf & Country Club Ltd.*,¹⁷ in which the Ontario Superior Court of Justice described the distinction between the granting of a license in copyright as opposed to an assignment or granting of an interest. As Section 13(7) establishes, an exclusive license is to be understood as a grant of an interest in copyright and therefore must be in writing according to section 13(4) in order to be effective. That there is no provision similar to section 13(7) with regard to non-exclusive licenses suggests that such licenses need not be in writing. Since there was conflicting evidence concerning the content of an oral agreement or implied license between freelance writers and the *Globe*, the Court ruled that there remained genuine questions for trial on this issue.

C. Standing of the *Globe* Staff Writers

Citing Canada's equivalent of the work-made-for-hire doctrine, the Court concluded that it was improper for the staff writers to be joined in the same class with the freelance writers. Under section 13(3) of the Copyright Act, employers are deemed to be the "first owner" in the copyright inhering in the works of their employees created in the course of employment, unless agreed otherwise. Employees who contribute to a periodical, however, have the right to restrain publication of their works "otherwise than as part of a newspaper, magazine or similar periodical." Since the staff writers had a different constellation of rights than the freelance writers, they could not belong to the same class of plaintiffs as the freelance writers. Furthermore, the Court dismissed their claims on the ground that there was no evidence that they had exercised their right to restrain publication. The Court did not rule on the question of whether the databases fell within the meaning of "newspaper, magazine or similar periodical," but it did explicitly indicate that it would most likely hold in the negative if forced to address the issue.

V. Dissenting Opinion

Four justices, including the Chief Justice, wrote a separate opinion which dissented in part. With regard to the claims of the *Globe* staff writers, the dissenting justices were of the opinion that the electronic databases fell within the meaning of "similar periodical" under section 17(3). Therefore, the dissent concluded that these claims

should be dismissed on the ground that the staff writers would not have the right to restrain republication of their works in the databases. With regard to the freelance writers, the dissent opined that reproduction of their articles in the Info Globe Online as well as in the CPI.Q was within the publishers' rights. According to the dissent, any reproduction of the articles from a newspaper would inevitably reproduce both the originality of the authors as well as that of the publishers. In other words, so long as every article which had been selected for publication in an original print edition was reproduced with the exact same wording as the original publication, the originality of the publishers reflected in the selection and editing of the articles would be preserved. By framing the issue along the line of whether the databases reproduced the originality of the individual authors or that of the editors, the majority suggested that the databases reproduced the originality of only one group or the other.

The dissent called particular attention to the issue of media neutrality and paid particular credence to the arguments put forth by Justice Stevens in his dissent in *Tasini*. In the opinion of the dissenting justices, an electronic edition of the *Globe* was, for copyright purposes, qualitatively identical to a collection of articles as electronic files stored on a disk that contained a reference to the newspaper edition and pages on which the articles appeared. Since both would contain all the articles and text the publishers had selected, both would reflect the skill and judgment of the publishers contained in the original collective work. In addition, that the collection was organized by article merely represented a circumstance dictated by the electronic medium, as the article was the "logical unit" by which the newspaper could be divided into manageable pieces.¹⁸ By extension, if such an organized digital collection of articles from a newspaper reproduces the newspaper, this collection does not lose this distinction by virtue of the fact that it is stored together with similarly organized articles from other newspapers, the dissent reasoned. The majority's emphasis on the loss of context within the databases, the dissent maintained, put form over substance and failed to observe the principle of media neutrality.

The dissenting justices also argued that principles reflected in the Berne Convention supported their position. The *WIPO Guide to the Copyright and Related Rights Treaties Administered by WIPO and Glossary of Copyright and Related Rights Terms* (2003) expounds on the author's right to reproduction granted by the Berne Convention, stating that "it is not a condition that, on the basis of the reproduction, the copy of the work be directly perceivable; it is sufficient if the reproduced work may be made perceivable through appropriate equipment."¹⁹ The dissent contended that this language implicated the newspapers as contained within the databases in digital form; the

entirety of the newspaper, with the exception of some features of the original arrangement, is "perceivable" within the database, although there is no exact visual replication of the newspaper. Here, also, the fact that the articles were marked in such a manner as to indicate to which edition they belonged played a significant role in establishing the "perceivability" of the newspaper as such. In addition, the dissent cited a footnote to article 1(4) of the WIPO Treaty which states that storage of a work in digital form on an electronic medium qualifies as a reproduction. Thus, the dissent suggested, storage of the newspaper within an electronic database represents a "reproduction" of the newspaper. Just as individual authors did not lose their rights in their works when these were included in a digital database, likewise the publishers did not lose their reproduction rights when they chose to include their newspapers in the same.

The dissent further relied upon policy considerations, arguing that the holding of the majority upset the balance of interests between the public at large and authors. With respect to newspapers, the dissent attributed a particularly strong public interest to archiving content for research purposes. The dissenting justices noted how the *Tasini* holding had negative consequences for the availability of such archived content. Reportedly, the *New York Times'* response to the success of the freelance writers in that case was to remove all implicated articles from its online databases.²⁰ The dissent expressed concern that the majority holding would have the same effect for Canadian media, rendering many archived articles unavailable in electronic and online databases.

VI. Conclusion

In a 5-4 decision, the Canadian Supreme Court addressed an issue similar to that presented in the U.S. Supreme Court case *New York Times v. Tasini* and resolved it in a similar fashion. The Canadian Court held that articles contributed to a newspaper by freelance writers which are republished in a "decontextualized" manner do not fall within the rights of the newspaper publishers as holders of copyright in the newspaper as a collective work. Unlike under U.S. Copyright law, Canadian law also permits the owner of a copyright in a collective work to reproduce "a substantial part" of the work.²¹ The Canadian Court deemed the reproduction of the articles on CD-ROM to be a valid exercise of the publishers' copyright. Although the articles on the CD-ROM had also been stripped of advertisements and photographs as in the other databases, the Court nonetheless held that the articles within this medium preserved the necessary contextual link to the original newspaper.

The dissent, on the other hand, opined that the reproduction of the freelance articles on all databases "conformed with the publishers' copyright in their

newspapers. Since the judgment and skill of the editors was inherent in the articles, and the databases provided sufficient reference to the newspaper edition and page number on which the article originally appeared, all databases in question reproduced “a substantial part” of the original collective work. In the opinion of the dissenting justices, the majority’s holding upsets the balance between the interests of authors and that of the public and would result in the exclusion of significant material from searchable electronic databases.

Notably, the majority did not address the issue of whether republication of the freelance articles in the Internet edition of the *Globe* fell within the publishers’ rights. The dissent noted that the class action plaintiffs had conceded that the Internet publication was permissible under the Copyright Act. Since the dissent viewed the distinction between publication in the Internet edition and on the databases as merely a difference in medium, they argued that to deem one form of publication a legal reproduction and the other not would be inconsistent with the principle of media neutrality.

Endnotes

1. 2006 SCC 43.
2. Presumably, this date relates to the term of copyright under Canadian law. Under section 6 of the Canadian Copyright Act, copyrights, as a general rule, have a duration of fifty years beginning in the first calendar year immediately following the author’s death. Thus, the class here would encompass all known contributing authors whose copyrights had not expired by 1995. In 1995, Robertson wrote the articles at issue.
3. See *Robertson v. Thomson, Corp.* (2001), 15 C.P.R. (4th) 147, available at <http://www.ontariocourts.on.ca/decisions/2004/october/C38148.pdf>.
4. 2006 SCC 43, at par. 25.
5. See, e.g., Press Release, Supreme Court of Canada, Judgments to be Rendered in Leave Applications (April 18, 2005), at http://scc.lexum.umontreal.ca/en/news_release/2005/05-04-18.2a.wpd/05-04-18.2a.wpd.html.

6. See Press Release, Supreme Court of Canada, Judgments in Appeals and Leave Applications (April 21, 2005), at http://scc.lexum.umontreal.ca/en/news_release/2005/05-04-21.3.wpd/05-04-21.3.wpd.html.
7. [2004] 1 S.C.R. 339, 2004 SCC 13.
8. 2006 SCC 43, at par. 35 (citing *CCH Canadian Ltd.*, [2004] 1 S.C.R. 339, 2004 SCC 13, at par. 16).
9. *Id.* at par. 36 (citing *CCH Canadian Ltd.*, [2004] 1 S.C.R. 339, 2004 SCC 13, at paras. 33-34).
10. *Id.* at par. 40.
11. *Id.* at par. 41.
12. 533 U.S. 483 (2001). At the same time, the Court pointed out that the automatic rights granted to publishers of collective works under U.S. law differ from those granted under Canadian law and that courts should therefore exercise caution in referring to U.S. case law on such issues. See 2006 SCC 43, at par. 43.
13. The Court cited pages 500-501 of the *Tasini* opinion.
14. Par. 47.
15. Par. 48.
16. “For greater certainty, it is deemed always to have been the law that a grant of an exclusive license in a copyright constitutes the grant of an interest in the copyright by license.”
17. 35 C.P.R. (4th) 163 (2004).
18. 2006 SCC 43, at par. 89 (citing *New York Times v. Tasini*, 533 U.S. 483, 513 n. 9 (2001) (Stevens, J., dissenting)).
19. *Id.* at par. 95 (quoting from page 55 of the WIPO *Guide*).
20. *Id.* at par. 71 (citing D. P. Bickham, *Extra! Can’t Read All About It: Articles Disappear After High Court Rules Freelance Writers Taken Out of Context* in *New York Times Co. v. Tasini*, 29 W. St. U. L. Rev. 85, 102 (2001)).
21. As opposed to a “revision” of the original work or reproduction in a “later collective work in the same series.” See 17 U.S.C. § 201(c).

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