

CONCEPT OF INFRINGEMENT IN THE CANADIAN *COPYRIGHT ACT*

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When dealing with copyright infringement, it has to be borne in mind that one of the fundamental principles of copyright law in Canada is to be found in Section 63 of the Copyright Act, R.S.C. 1985, c. C-42 (hereafter: "the "Act"). This section reads as follows:

"No person is entitled to copyright or any similar right in any literary, dramatic, musical or artistic work otherwise than under and in accordance with this Act, or of any other statutory enactment for the time being in force, but nothing in this section shall be construed as abrogating any right or jurisdiction to restrain a breach of trust or confidence."

Therefore, common law copyright is non-existent under Canadian law and consequently, there is no such thing as an infringement of common law copyright. This principle of copyright law was confirmed by the Supreme Court of Canada in Compo Co. Ltd. v. Blue Crest Music where Estey J. wrote:

"...Copyright Law is neither tort law nor property law in classification, but is statutory law. It neither cuts across existing rights in property or conduct, nor falls between rights and obligations heretofore existing in the common law. Copyright legislation simply creates right and obligation upon the terms and in the circumstances set out in the statute. This creature of statute has been known to the law of England

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at least since the days of Queen Anne when the first copyright statute was passed. It does not assist the interpretive analysis to import tort concepts. The legislation speaks for itself and the action of the appellant must be measured according to the terms of the statute."¹.

In the Act, infringement may be divided into two main categories: copyright infringement and moral right infringement.

Even though, there are some similarities between these two categories, we shall discuss them in two different parts.

1. COPYRIGHT INFRINGEMENT

Under Section 27, which deals with copyright infringement, copyright is deemed to be infringed by any person who, without the copyright owner's consent: does anything that the Act gives the owner the sole right to do (Section 27(1)), deals with an infringing work in certain manners (Section 27(4)) or performs in public a protected work for private profit (Section 27(5)).

Infringements under Sections 27(1) and 27(4) can respectively be characterized as direct or primary infringements and indirect or secondary infringements. The distinguishing feature between the two is **knowledge** on the part of the infringer that copyright is being infringed: such knowledge is required in the case of indirect infringement, whereas direct infringement may occur whether or not knowledge exists.

What are the common features in any copyright infringement?

1.1 Common Features in any direct or indirect copyright infringement:

To sustain any copyright infringement action, independently from the question of infringement in itself, there are two prerequisites: the presence of a work in which copyright subsists and the absence of consent on the part of the copyright owner.

1.1.1 Work in which copyright subsists

¹Compo Co. Ltd. v. Blue Crest Music (1979), (1980) S.C.R. 357 (S.C.C.) Estey J., at pp. 372-373.

In accordance with Section 5(1), infringement of copyright presupposes the existence of a work in which copyright subsists².

The conditions for obtaining copyright protection in a work (whether literary, musical, dramatic or artistic) may be divided into two categories: conditions concerning the author of the work and conditions pertaining to the work itself

a) the author

Shortly stated, under Sections 5(1) or 5(2.1), copyright may exist in an original work, published or not, if at the time of the creation of a work the author was a British subject, a resident within Her Majesty's Realms and Territories or a citizen, subject or resident of a Berne Convention country or a country that has adhered to the Universal Copyright Convention adopted on September 6, 1952 in Geneva, Switzerland, or to that Convention as revised in Paris, France, on July 24, 1971 or a citizen or subject of a foreign country that has not adhered to the said Conventions but which has been the object of a notice by the Minister published in the Canada Gazette (see Sections 5(1), (2) and (2.1) of the Act).

b) the work itself

i) nature of the work

To be protectable under the Act, a work must either be literary, dramatic, artistic or musical. A protectable work can also be a record, perforated roll or an other contrivance by means of which sounds may be mechanically reproduced. In the case of such contrivances, copyright shall subsist in like manner as if they were musical, literary or dramatic works (see section 5(3) and (4)).

ii) originality

Moreover and in all cases, the work to be protected must be original. Originality, under the Act, does not mean novelty. As held by Johnson J. in Kilvington Bros. Ltd. v. Goldberg:

"But novelty and inventiveness are not the tests of originality in the law of copyright. The test is whether this design is original in the sense that it is the original expression of thought of its originator, that it originated from him and that he did not copy it"³.

²See Canadian Admiral Corporation v. Reddifusion, Inc. (1954), (1954) Ex. C.R. 382 (Ex. Ct.) Cameron J. at p. 390.

iii) territory

Furthermore, in the case of a published work, it must be first published within Her Majesty's Realms and Territories or in a foreign country that has adhered to the Berne Convention and to its Additional Protocol or to the Universal Copyright Convention or its revised version or in a foreign country that has not adhered to these Conventions and Protocol but which has been the object of a notice by the Minister published in the Canada Gazette (see sections 5(1), (2) and (2.1)).

In Milliken & Co. v. Interface Flooring Systems (Canada) Inc., Giles, A.S.P. of the Federal Court of Canada, Trial Division⁴, decided that Section 5(1) required that the first publication be in the same foreign country as the one in which the work was created. This decision was recently reversed by Strayer J.⁵ wherein he wrote:

"It seems clear that the words "l'un" in the phrase "l'un de ces pays..." (in subsection 5(1)) have a different role grammatically from the word "that" as it appears in the phrase "that foreign country". "That" is, in such use, a demonstrative adjective referring to a singular noun, mentioned before (Shorter Oxford English Dictionary, 3rd ed. (19730 at 2275), in this case "foreign country" of which the author is a citizen or subject. On the other hand, according to Harrap's Standard French and English Dictionary, revised edition (1980), at p. U:2, "l'un" in this context is an indefinite pronoun and thus does not refer back to a particular thing mentioned before. "L" is added to "un" for purposes of euphony (Librairie Larousse, Dictionnaire Moderne Français-Anglais (1965). As said in Larousse, Difficultés (Librairie Larousse (1971), at p. 419): "on emploie indifféremment un de (un des) ou l'un de (l'un des); seule compte la raison d'euphonie...". Thus "l'un" has the same meaning as simply "un" in this context, both meaning in the phrase "l'un (un) de ces pays" simply "one of these foreign countries"; that is, one of the foreign countries adhering to the Berne Convention.

As the English and French texts mean different things, it is necessary to decide which, if either, should be followed.

The basic rule is that in case of disagreement between the two official language versions of a statute, one must apply other rules of

⁴Milliken & Company et al. v. Interface Flooring Systems (Canada) Inc., Giles A.S.P. T-3016-92 (yet unreported).

⁵Milliken & Co. v. Interface Flooring Systems (Canada) Inc.(1993), 52 C.P.R. (3d) 92 (F.C.T.D.), Strayer J. at pp. 95-96_and 97.

interpretation to find the true intent of Parliament (...) To do this, one may look at the entire Copyright Act, including its Schedules (...). It is apparent in the present case from Sch. II to the Act that the French version of the Berne Convention was the original. But in fact both relevant English and French provisions of the Convention are the same (...) The reference (in art. 4 of the Convention) to publication "in a country of the Union" or "dans un pays de l'Union" are consistent with each other and with the French version of s. 5(1) of the Act. Therefore that French version is to be preferred.

Further, it may be noted that the expression "l'un de ces pays" in art. 4 of the Convention is translated as "any of the countries" which is consistent with my conclusions above as to the true equivalent of "l'un de ces pays étrangers" in s. 5(1) of the Act".

iv) in a material form

Aside from originality, production of the work in a material form of expression is required for a work to be capable of copyright protection⁶. Ideas or concept cannot be protected as such under the Act. It is their expression when fixed, reduced or embodied in a material form which can be protected.

v) deeming provisions

When, in an infringement action the defendant contests the existence of the copyright or plaintiff's title to it, the work is deemed under Section 34(3)(a) to be one in which copyright subsists. Furthermore, under Section 34(3)(b), the author of the work is deemed to be the owner of the copyright. The burden is on the defendant to prove the contrary.

The introductory phrase in Section 34(3) indicates that these presumptions only apply in respect of an action for infringement of copyright and, therefore, would not seem to apply to an action for the infringement of a moral right. Section 34(3)(b) may be said to be a corollary to Section 13 of the Act which states that subject to the Act, the author of a work shall be the first owner of the copyright therein.

Section 53(1) states that every register of copyrights under the Act is evidence of the particulars entered therein and Section 53(2) further states that a certificate of registration of copyright in a work is evidence that copyright subsists in the work and that the person registered is the owner of the copyright.

⁶ Canadian Admiral case op cit. n^o 2 at page 394.

The second common feature of any copyright infringement whether direct or indirect, is the absence of consent on the part of the copyright owner.

1.1.2 Absence of Consent

i) by the owner or legal representative

Infringement depends on the an absence of consent by the owner of the copyright, who is the only person, under Section 27(1) of the Act, who can authorize acts which would otherwise constitute infringement. It must emanate from the owner itself of the particular right considered, or its legal representative⁷.

Consent may be given under the form of licenses which could be characterized as the permission to do an act that would otherwise be an infringement of copyright. Licenses are either given voluntarily or compulsorily.

ii) compulsory licenses

Compulsory licences are provided for in Sections 8, 15, 16 and 22 of the Act and, under certain circumstances, under Sections 32 and 61 of the Competition Act (R.S.C. 1985, c. C-34).

iii) voluntary licenses

Voluntary licenses may be expressed or implied, they may be verbal or in writing, with or without consideration⁸, direct or through a society, association or corporation that carries on the business of granting licenses (sections 67, 70.1 and 70.61). However, those licenses that grant an interest in the copyright must be in writing (Sections 13(4) and 57(1)). While Section 58(1) and (2) does give indications as to the forms which may take the granting of an interest in a copyright, Section 58(4) states that these forms are permissive only and the execution of any documents referred to in Section 57 may in any case be proved by oral testimony.

Consent may be presumed from circumstances or the conduct of the parties, but the inference of consent must be clear and the onus of establishing it lies on who is relying on the licence⁹. But the mere transfer of the possession or

⁷ Bishop v. Stevens (1990), (1990) 2 S.C.R. 467 (S.C.C.) McLachlin J., at pp. 485-487.

⁸ Hart v. Hayman, Christy, and Lilly, Limited (1916), (1911-16) MacG. Cop. Cas. 301 (Ch. D.)

⁹ Warner Bros. - Seven Arts Inc. v. C.E.S.M.-T.V. Inc. (1971), 65 C.P.R. 215 (Ex. C.C.) Cattnach J. at p. 235; Bishop v. Stevens op. cit. no 6.

property of a physical work, does not automatically convey the assignment of the incorporeal rights in the work¹⁰.

1.2 Direct Infringement

Section 27(1) reads:

"Copyright in a work shall be deemed to be infringed by any person who, without the consent of the owner of the copyright, does anything that, by this Act, only the owner of the copyright has the right to do."

1.2.1 Definition

Infringement of copyright in a work is deemed¹¹ when any person¹², without consent from the owner of the copyright, does anything which the Copyright Act considers as the owner's exclusive right. To infringe is to appropriate the original work of another person and without authorization deal with it as only the owner of the copyright has the right to do. Conversely, any dealing not covered by the Act will not constitute a copyright infringement, it may however constitute a breach of trust or confidence (Section 63).

Infringement consists, with respect to a protected work in producing or reproducing the work in a substantial part thereof in any material form whatever, in performing or (in the case of a lecture) delivering it in public, or in publishing the work. Copyright also carries rights of translation, conversion, recording through audio, audio visual or cinematographic media, and rights of adaptation, radio broadcasting and exhibition, all of which belong exclusively to the copyright owner¹³.

In addition, the copyright owner has the exclusive right to authorize any of the acts enumerated in Sections 3(1) and 5(4). Infringement may also consist of

¹⁰Underwriter's Survey Bureau Limited v. Massie & Renwick Limited (1940) (1940) S.C.R. 218 (S.C.C.) Duff J., at p. 229.

¹¹Use of the word "deemed" raises a presumption of infringement when the circumstances outlined in Section 27(1) are found to exist, subject of course to the stated exceptions. As written by Dickson J. in the case R. v. Sutherland (1980), (1980) 2 S.C.R. 451 (S.C.C.) at page 456: "The purpose of any "deeming" clause is to impose a meaning, to cause something to be taken to be different from that which it might have been in the absence of the clause". See also SOPINKA (John) et al., The Law of Evidence in Canada, (Toronto, Butterworth 1992).

¹²Section 35 of the Interpretation Act (R.S.C. 1985 c. I-21) provides that a "person" or any word or expression descriptive of a person, includes a corporation."

¹³Section 3(1) and 2 (definition of "infringing") of the Act.

authorizing, without permission of the copyright holder, the doing of such acts¹⁴ (section 3(1) in fine).

1.2.2 Conditions under which direct copyright infringement may occur

In order to find copyright infringement in a work, two conditions are necessary: copying of the work or a substantial part of it and an access to the copied work.

A. Copying

Although the term "copying" is not directly referred to Sections 3(1) and 27(1), it was stated by MacDonnell J. in the case British Columbia v. Mihaljevic:

"the case-law has interpreted the statutory provisions in such a way that "copying" is an essential ingredient of infringement"¹⁵.

The literal reproduction of a work in its entirety, or of a substantial part thereof, as in photocopying for instance, constitutes the primary form of infringement. However, copying goes beyond literal reproduction; the copying needs not be slavish, but similarities between the two works must be such that the first work can be said to be reproduced in the second one¹⁶.

a. Substantial part (see section 3(1))

There is no copyright infringement unless the matter produced or reproduced constitutes the whole or at least a substantial part of the infringed work. What constitutes a "substantial part" is a question of fact and in this respect, the courts have given more emphasis on the quality of what was taken from the original work rather than the quantity¹⁷.

Even though what constitutes a substantial part of a work is a question of fact and degree left to the appreciation of the trial judge, some guidelines may be derived from case law.

¹⁴Compo Company Limited v. Blue Crest Music Inc. op cit. n^o 1 at pp. 364,375 and 378-379.

¹⁵(1989), 26 C.P.R. (3d) 184 (B.C.S.C.) at p. 189.

¹⁶Beauchemin v. Cadieux (1900), 10 B.R. 255 (Q.C.A.) Lacoste J., at p. 270. VINCKE (Christian) et al. Problèmes de droits d'auteur dans le monde de l'éducation (Québec, Editeur officiel, 1974).

¹⁷Breen v. Hancock House Publishers Ltd. (1985), 6 C.P.R. (3d) 433 (F.C.T.D.) Joyal J., at p. 436.

Firstly, in the case of a compilation which is a form of literary work, a substantial part of it is taken when there is a copy of the arrangement of material in which copyright exists¹⁸; copyright in a literary work may be infringed by appropriating a substantial amount of the material published by the original author although the language employed by the infringer is different and the materials be altered¹⁹. There cannot exist copyright in mere facts, however, the arrangement of the facts can be protected as a compilation.

Secondly, in order to ascertain what constitutes a reproduction of a substantial part of a dramatic work, the plot (including in that word, the idea and the arrangement of the incidents), the dialogue and working out of the play must be considered and also the extent to which both plays included stock incidents and stock characters²⁰.

In the case of dramatic works, assessing similarities may depend upon a number of factors. These factors include plot, theme, dialogue, mood, setting or scenes, pace, sequence and characters. In assessing these factors, the test is ultimately whether the average lay observer, at least one for whom the work is intended, would recognize the alleged copy as having been appropriated from the copyrighted work²¹.

Thirdly, in the case of musical work, the test to be applied is that not only of quantity but also of quality (whether the amount of music taken was so slender that it would be impossible to recognize it)²².

Fourthly, in the case of an artistic work, what constitutes a substantial part lies in the "feeling and artistic character"²³.

Infringement may also consist in the making of colourable imitation of a work or a substantial part of a work.

b. Colourable imitation (see section 2 definition of "infringing")

¹⁸Slumber-Magic Adjustable Bed Co. Ltd. v. Sleep-King Adjustable Bed Co.Ltd. (1984), 3 C.P.R. (3d) 81 (B.C.S.C.) McLachlin J., at p. 86.

¹⁹British Columbia Jockey Club v. Standen (1983), 73 C.P.R. (2d) 164 (B.C.S.C.) Legg J., at p. 173.

²⁰Rees v. Melville (1914), (1911-16) MacG. Cop. C. 168 (Ch. D.) Pickford J., at p. 174.

²¹Preston v. Twentieth Century Fox Canada Ltd. (1990), 33 C.P.R. (3d) 249 (F.C.T.D.) MacKAY J. at pp. 273-274.

²²Canadian Performing Rights Society Limited v. Canadian National Exhibition Association(1934), (1934) O.R. 610 (O.H.C.J.) Rose J., at p. 614-615. Grignon v. Roussel (1991), 33 C.P.R. (3d) 4 (F.C.T.D.) Denault J.

²³Bauman v. Füssel (1953), (1978) R.P.C. 485 (C.A.) Somerville J. at p. 487.

This concept cannot easily be defined as it can apply to various situations²⁴.

In short, a colourable imitation is a work which is presented as original, while it is in fact a reproduction of another's work, the whole disguised with various alterations to the original work. The determination of whether a work is a colourable imitation or a legitimate original, is a question of fact, it depends on the extent and nature of the various alterations. For the new work not be an infringement, it needs to be something more than a simple disguised imitation (see French text of section 2 definition of "infringing").

The concept of "colourable imitation" may extend to a work which is the result of an appropriation of material initially created by the original author and that has been rendered in a different form by the infringer.

Indeed, in the case British Columbia Jockey Club v. Standen, Mr. Justice Legg wrote that appropriation of the results of someone else's labour is not permitted and that copyright may be infringed if such appropriation occurs even though the language employed by the infringer has been modified²⁵.

A colourable imitation can also be encountered when an infringer violates one of the various rights enumerated in Section 3 of the Act, and reproduces a work in another dimension or another medium²⁶.

B. Access to copied work

A striking similarity between two works, alone is insufficient to prove plagiarism. While it is recognized that copyright infringement may result from unconscious copying, there must be evidence of access to the copied work or a connection between the two works for a court to find that infringement has occurred, but evidence of access alone will not suffice evidence of copying of a substantial part of a protected work also has to be proved²⁷.

²⁴In fact, the determination of what constitutes a "colourable imitation" might be compared to the concept of obscenity as it was developed under the Common Law: "There is no definition of the term ... there is little more than the ability to smell it" had written Mr. Justice Douglas of the U.S. Supreme Court in A Book Named "John Cleland's Memoirs of a Woman of Pleasure" v. Attorney General of Massachusetts (1966), 383 U.S. 413 (U.S.), at p. 429, himself referring to ALPERT (Léo M.), Judicial Censorship of Obscene Literature (1938), 52 Harvard Law Review 40."

²⁵Op cit. N° 18 at p. 173.

²⁶King Features Syndicate Inc. v. O. and M. Kleeman Ltd. (1941), (1941) A.C. 417 (H.L.).

²⁷Caron v. Association des Pompiers de Montréal Inc. (1992), 42 C.P.R. (3d) 292 (F.C.T.D.).

When the common source can be shown and the allegedly infringing work is a result of independent creation, there is no infringement. Plagiarism is a question of fact and can be proven by any means: direct evidence or presumptions. The court should closely scrutinize and compare the works submitted to its appreciation. Since "resemblance" between two works can result from the limited range of expressions particular to a field of endeavour, or from use of a common source, a court must be convinced on a balance of probabilities that a defendant has actually taken the plaintiff's work to produce his own, before finding the defendant liable for infringement.

Thus, evidence of independent creation or use of a common source will serve to establish non-infringement. On the other hand, reproduction of mistakes found in the original work may constitute proof of copying.

Moreover, the fact of copying from an unauthorized copy of the work, rather than from the original, is no defense to infringement²⁸.

1.3 Indirect Infringement

Section 27(4) reads:

"Copyright in a work shall be deemed to be infringed by any person who:

- (a) sells or lets for hire or by way of trade, exposes or offers for sale or hire,
- (b) distributes either for the purposes of trade or to such an extent as to affect prejudicially the owner of the copyright,
- (c) by way of trade exhibits in public, or
- (d) imports for sale or hire into Canada,

any work that to the knowledge of that person infringes copyright or would infringe copyright if it had been made within Canada."

Section 27(4) considers certain commercial dealings as infringement. These dealings are the selling or letting for hire (section 27(4)(a)), the distribution (section 27(4)(b)), the commercial exhibition (section 27(4)(c)) and the importation for selling or hire (section 27(4)(d)) of works known to be infringing.

²⁸Underwriter's Survey Bureau Ltd. v. American Home Fire Assurance Co. (1969), (1969) Ex. C.R. 296 (Ex. C.C.) MacLean J., at p. 306.

In summary, section 27(1) deems a person to be an infringer if he, without authorization, produces or performs a protected work, while section 27(4) deems a person to be an infringer if he deals with a work produced in contravention with section 27(1).

Indirect infringement may only take place with respect to works found to infringe a validly subsisting copyright or works which would infringe copyright, if they had been made within Canada.

As already mentioned, section 27(4) requires knowledge on the part of the alleged infringer who deals with a work in any of the ways described in this sub-section, that the said work infringes a copyright.

Such knowledge is an essential element of the infringement under Section 27(4). The burden of proving this knowledge rests upon the plaintiff. However, section 27(4) must be read in conjunction with section 39, which states that if at the date of the infringement the copyright in the work was duly registered under the Act, a defendant will be irrevocably deemed to have had reasonable ground for suspecting that copyright subsisted in the work. Thus, once this fact is established, it is unnecessary to ascertain the defendant's actual state of mind concerning the subsistence of the copyright in the work. There will remain however on the part of the plaintiff the burden of establishing that the defendant (even though deemed to know that copyright subsisted in the work) had also the knowledge that this copyright in the work had been infringed, in other words, that the defendant had knowledge that the deemed protected work had been reproduced without the authorization of the copyright owner.

The term "knowledge" under section 27(4) should be given the sense of notice of fact that would suggest to a reasonable man that a breach of copyright was being committed²⁹.

The requirement of knowledge applies not only to the infringement in sub-paragraph (d) but also to sub-paragraphs (a), (b) and (c).

1.3.1 Sale or letting for hire

Under section 27(4)(a) copyright is deemed infringed by any person who sells or lets for hire or by way of trade exposes, offers for sale or for hire, any work that to the knowledge of that person infringes copyright or would infringe copyright if it had been made within Canada.

²⁹Clarke, Irwin & Co. Ltd. v. Cole & Co. Ltd. (1959), 33 C.P.R. 173 (O.H.C.) Spence J. at p. 181.

For instance, the hiring and selling of films and video tapes which are copies of protected films and video tapes would constitute infringement under this sub-section. Furthermore, if the works were reproduced by the same person without authority, section 27(1) provides an additional ground for an infringement claim³⁰.

1.3.2 Distribution

Under section 27(4)(b) copyright is being infringed by any person who distributes either for the purpose of trade or to such an extent as to prejudicially affect the owner of the copyright, any work that to the knowledge of the person infringes copyright or would infringe copyright if it had been made within Canada.

Thus, liability for the distribution of an infringing work is subject to the distributor having a trading purpose with respect to the work or causing a prejudice to the copyright owner.

For instance, the giving away of infringing works not covered under section 27(4)(a) might constitute infringement under section 27(4)(b), inasmuch as it is either done in a manner such as to prejudicially affect the owner of the copyright or for the purpose of trade.

It has to be mentioned that the prejudice to the copyright owner is not restricted to economic losses could also encompass its moral rights (if the copyright owner is the author).

1.3.3 Commercial Exhibition

Under section 27(4)(c), copyright is deemed infringed by any person who, by way of trade, exhibits in public any work that to the knowledge of that person infringes copyright or would infringe copyright if it had been made within Canada.

The operation of this section covers all kinds of infringing works (literary, musical, dramatic, or artistic), whether created before or after June 7, 1988. In this respect, this section should be contrasted with section 3(1)(g) of the Act, which deals with the public exhibition of original artistic works only, created after June 7, 1988, and exhibited for non-trade purposes, i.e. (other than sale and hire). Section 3(1)(g) deals with protected works while section 27(4)(c) deals with infringing works.

³⁰Aldrich v. One Stop Video Ltd. (1987), 17 C.P.R. (3d) 27 (B.C.S.C.) Davies J., at p. 35.

1.3.4 Importation

Under section 27(4)(d), copyright is deemed infringed by any person who imports for sale or hire into Canada, any work that to the knowledge of that person infringes copyright or would infringe copyright if it had been made within Canada.

Even though, books, records, video tapes or any other type of works may lawfully be manufactured and sold in other countries, it is an infringement to import for sale or hire into Canada such works, without the authorization of the Canadian copyright owner to do so³¹.

As copyright can be assigned territorially under section 13(4) of the Act, the copyright owner in Canada could be a person different from the copyright owner elsewhere in the world; thus, the Canadian owner could prevent the importation of works otherwise lawfully made or purchased outside Canada³².

It was thus held that books acquired on the open United States market from a licensee of the copyright owner were infringing works when imported for sale into Canada³³. However, if a book can be lawfully imported into Canada, it can be resold by the importer without infringement under this section³⁴.

For infringement to be found under section 27(4)(d), the infringing works must be imported into Canada for sale or hire.

The word "import" is not defined in the Act; but in the Custom Act (R.S.C. 1985 (2nd Supp.), c. 1, s.2(2)), for the purpose of such Act, "import means import into Canada". This definition is not very helpful. Therefore, the expression "to import" should be construed in its ordinary meaning, namely to bring in, to introduce from abroad. Even if the goods were brought into Canada in transit only, it would appear to be sufficient to contravene section 27(4)(d)³⁵.

³¹Fly by Nite Music Co. v. Record Warehouse Ltd. (1975), (1975) F.C. 386 (F.C.T.D.) Mahoney J., at pp. 394-395.

³²Dictionnaire Robert Canada S.C.C. v. Librairie du Nomade Inc. (1987), 16 C.P.R. (3d) 319 (F.C.T.D.) Denault J.

³³Clarke, Irwin & Co. Ltd. v. Cole & Co. Ltd. Op cit. N^o 28

³⁴Simon & Schuster Inc. v. Coles Book Stores Ltd. (1975), 23 C.P.R. (2d) 43 (O.H.C.J.) Wheatherson J.

³⁵Gramophone Company of India v. Pandey (1984), (1985) 11 F.S.R. 136 (S.C. Calcuta) Reddy J. at p. 154.

"Canada" includes the land mass of Canada, the internal waters and the territorial sea. Section 3 of the Territorial Sea and Fishing Zones Act, (R.S.C. 1985, c. T-8), reads as follows:

"3.(1) Subject to any exceptions under section 5, the territorial sea of Canada comprises those areas of the sea having, as their inner limits, the base lines described in that section and, as their outer limits, lines measured seaward and equidistant from those base lines so that each point of the outer limit line of the territorial sea is distant 12 nautical miles from the nearest point of the baseline.

(2) The internal waters of Canada include any areas of the sea that are on the landward side of the base lines of the territorial sea of Canada."

It is worthwhile to note that section 2 of the Territorial Sea and Fishing Zones Act provides that every provision of this Act (which includes the definitions of "territorial sea" and "internal waters") extends and applies to every Act of the Parliament of Canada.

There is another kind of infringement of copyright encompassed by section 27 of the Act, which is enounced by section 27(5).

1.4 Permitting Use of Theatre for Performance of Work

Section 27(5) reads:

"Copyright in a work shall be deemed to be infringed by any person who for his private profit permits a theatre or other place of entertainment to be used for the performance in public of the work without the consent of the owner of the copyright, unless that person was not aware, and had no reasonable ground for suspecting, that the performance would be an infringement of copyright".

This subsection deems that an infringement of copyright will occur out of permitting, without authorization from the copyright owner, a theatre or other place of entertainment to be used for the performance in public of a work, for the private profit of the person who gives such permission, unless that person was unaware and had no reasonable ground for suspecting that the performance would be an infringement of copyright. Once again, as it was the case for section 27(4), the presumption established by section 39 of the Act, may serve to defeat a defendant's claim of absence of reasonable ground for suspecting that copyright subsisted in the work. The plaintiff regardless of section 39, may still have to prove that the defendant had reasonable ground for suspecting that the copyright owner had not authorized the performance.

This section only applies to protected works performed in public. The term "performance" is defined at section 2(21) of the Act, as meaning "any acoustic representation of a work or any visual representation of any dramatic action in a work, including a representation made by means of any mechanical instrument or receiving device."

The expression "in public" is not defined in the Copyright Act, but has been interpreted as meaning "openly, without concealment and to the knowledge of all"³⁶. In CTV Television Network Ltd. v. Canada (Copyright Appeal Board) (1993), (1993) 2 F.C. 115 (F.C.A.) Létourneau J., at pp. 131-132 wrote:

"I am willing to accept that the words "to the public" are broader than "in public" and that the insertion of those words may have taken care of the concern of Pigeon (in Composers, Authors and Publishers' Association of Canada Limited v. CTV Television Network Limited (1968), (1968) S.C.R. 676 (S.C.C.), at pp. 681-682) that performance of musical works under the Act must always be in public. The words "to the public" now found in s. 3(1)(f) of the Act parallel those found in article 11(1)bis of the Rome Convention and would satisfy the requirement that a performance be in public."

As to the consent required under section 27(5), it must come from the owner of the performing rights in the executed work or the legal representative of such owner.

The expression "place of public entertainment" is not defined in the Act. The United Kingdom Copyright Act, 1956, states, however, that it "includes any premises which are occupied mainly for other purposes, but are from time to time made available for hire to such persons as may desire to hire them for purposes of public entertainment". Since United Kingdom Copyright Act extends this definition beyond the ordinary meaning of what is normally understood as a "public place of entertainment", it should only be referred to in Canada with great caution and should in fact have no application in Canada.

The wording of section 27(5) should be compared with the wording of section 69, which refers to "theatres that are ordinarily and regularly used for entertainment for which an admission fee is charged."

The permission under section 27(5), relates to a specific work that should be known to the person giving the permission. The person cannot be said to have given permission to the public performance of a work, if it cannot be established that the person knew that the work was to be performed. The

³⁶Canadian Cable Television Association v. Copyright Board et al. (1993), 46 C.P.R. (3d) 359 at p. 370 (F.C.A.) Letourneau J.A. at p.370.

owner of a building where a "place of public entertainment" is located, cannot be said to have permitted the public performance of the work in which copyright subsists by the mere fact of having rented the said place.

As expressed by SKONE JAMES (Edmund P.) et al, Copinger & Skone James on Copyright, 13th ed. (London, Sweet & Maxwell, 1991), at No. 9.30:

"Under the equivalent provisions of the 1911 Act, it was said that a person does not permit what he cannot control, and does not permit the use of a place for the performance of a work, if he does not know that the work is going to be performed. Thus, where a person permits a premises to be used, knowing which work will be performed, this will be sufficient to establish "permission" but not if the music to be performed is left to the performers and the defendant has no knowledge of what in fact will be performed. Permission may be inferred from acts which fall short of being direct and positive, and may be inferred from indifference, but permission will not be inferred from a mere general authorization to use a theatre for a performance of musical or dramatic works."

As to the profit dealt with at section 27(5), it is the profit which the person permitting the use of the premises intends to make and not the profit that might derive from the performance itself³⁷.

Taken alone, the words "private profit" in the English text could be interpreted as including non-pecuniary advantages or benefits while the words "lucre personnel" in the french version of this section put the emphasis on a pecuniary consideration.

As already said, because copyright does not exist other than under and in accordance with the Copyright Act, copyright infringement only exists when one of these rights is violated.

The Copyright Act also enounces acts which do not constitute infringement of copyright and could be invoked as defense by an infringer.

1.5 Defenses available in Case of Copyright Infringement

Sub-sections 27(2)(a) to 27(2)(m), as completed by section 27(6), enumerate acts which do not constitute infringement of copyright. Other exceptions are found elsewhere in the Act, such as under sections 28, 28.01, 64(2) and 64.1. The Act also provides for prohibitions of enforcement, such as under sections 67(5), 67.2(3) and 70.66(2).

³⁷Australian Performing Right Association v. J. Turner & Son (1927), 27 N.S.W.S.R. 344 (H.C.N.S.W.) Davidson J., at p. 348.

In this paper, it is not our purpose to make an exhaustive review of all these defenses and therefore, we will only deal with two of them: the defense of fair dealing (section 27(2)(a) and (a.1)) and the defenses concerning computer programs (section 27(2)(l) and (m)).

As stated by Fox:

"Patents and copyrights rest on the theory that the result of the original labour of the author or inventor are, both on the ground of justice and public policy, to be protected against piracy"³⁸.

Therefore, the onus of showing that a reproached act falls under one of the stated exceptions rests upon the defendant³⁹.

1.5.1 Fair Dealing

Section 27(2)(a) provides that any fair dealing with any work for the purposes of private study or research does not constitute an infringement of copyright. Section 27(2)(a.1) relates to fair dealings with any work for the purposes of criticism, review or newspaper summary, such dealings will not constitute an infringement of copyright if the source, and the author's name, if given in the source, are mentioned.

The fair dealing exception of this section is not restricted to one particular kind of work, but applies to artistic, dramatic, literary and musical work, as well as to the mechanical contrivances referred to in section 5(3) of the Act.

A. Nature of Fair Dealing

Fair dealing does not depend upon the consent or authorization of the owner of the copyright. It constitutes a defense to an infringement action. The taking of a substantial part of a work does not automatically exclude the possibility of recourse to this defense⁴⁰.

Fair dealing is not defined in the Copyright Act. Whether a defendant's dealing with a work falls into one of the five aforesaid categories of purposes

³⁸Fox (Harold George), The Canadian Law of Copyright and Industrial Designs 2nd ed. (Toronto, Carswell, 1967), at p. 3.

³⁹Sillitoe v. McGraw-Hill Book Company (U.K.) Ltd. (1982), (1983) 9 F.S.R. 545 (Ch. D.) Davis J., at p. 558.

⁴⁰Johnstone v. Bernard Jones Publications (1938), (1938) 1 Ch. 599 (Ch. D.) Morton J., at p. 603.

(i.e. private study, research, criticism, review or newspaper summary) and whether it was "fair", is left to judicial interpretation upon the facts of each case. Relevant facts include the length of quoted excerpts from the work, proportion of excerpts in relation to the critic's or journalist's own comments, the use made of the work and the object of the study, research, criticism, review or summary.

Fair dealing is ultimately a matter of impression⁴¹. The dealing, it is submitted, must be fair for one of the purposes expressed in section 27(2)(a) and not for some other purposes.

The bearing of "substantiality" on the fair dealing defense is summarized by Laddie as follows (footnote references omitted):

"For, although it is permissible to take a substantial part of the work (if not, there could be no question of infringement in the first place), in some circumstances, the taking of an excessive amount would negate fair dealing. So, if the defense alleged is fair dealing for the purposes of criticism of the work, the taking of large amount of the work and the addition of brief critical notes would not presage a successful defense, and vice versa. On the other hand, there can exist circumstances where it would be proper to quote the entire work, particularly if it is a short one. Perhaps the most important factor to be taken into account is whether the alleged fair dealing is in fact competing with or rivalling the copyright work."⁴²

As to unpublished work, Laddie wrote (footnote references omitted):

"The Courts have been reluctant to accept something involving the publication of an unpublished work as fair dealing, unless the copyright work has had some significant private circulation, but the fact that it was unpublished does not necessarily destroy the defense; so, in one case (i.e. Fraser v. Evans (1969) 1 Q.B. 349 (C.A.)), where the defendants proposed to print short extract from a confidential report for the purpose of reporting current events in the newspaper, the Court declined to prejudge whether that would be fair dealing and refused to grant an interlocutory injunction. And the point has much less force where it is a dramatic or musical work which is being criticized if, although unpublished, it has been performed in public."⁴³

⁴¹New Era Publications International, APS v. Key-Porter Books Ltd. (1987), 18 C.I.P.R. (3d) 569 (F.C.T.D.- Interlocutory) Cullen J., at p. 568.

⁴²LADDIE (Hugh) et al, The Modern Law of Copyright (London, Butterworths, 1980), at N^o 2.110.

⁴³*ibid.* at N^o 2.110.

"Fair dealing" should be distinguished from "fair use". This latter expression, broader in scope, is found under section 107 of the United States Copyright Act, 1976. Even though the criteria of fairness referred to in section 107 are appealing, they should only be imported into Canadian law with great caution. Of interest also, the 1990 Bill C-316 entitled "An Act to Amend Copyright Act" sought to amend section 27(2)(a) and (d) in order to better define "fair dealing", therein referred to as "fair use", but was withdrawn.

B. Categories of Purposes

The words "study" and "research" in section 27(2)(a) ought to be given their dictionary meaning⁴⁴. The expression "private study" does not include the appropriation of a work for educational purposes and for the use of students⁴⁵, unless the quoted excerpts fall under the exception provided in section 27(2)(d)⁴⁶.

The word "criticism" in Section 27(2)(a.1) is not limited to criticism of the expression of a work, but can extend to the ideas or theories contained therein⁴⁷, nor is it confined to literary criticism⁴⁸. Section 30(1) of the United Kingdom Copyright Act, 1988, provides that the quoted works need not necessarily be the work under criticism; use of the expression "any work" in the Canadian statute also suggests this interpretation.

"Fair dealing", with respect to criticism, is a question of fact. In this respect, Drone wrote:

"Whether the limits of lawful quotation have been exceeded is a question governed by the circumstances of each case. It is to be determined not by the intention of the critic or reviewer, but by the character of its publication and the purpose which it serves. The controlling inquiries will be, whether the extracts are of such extent, importance, or value that the publication complained of will supersede

⁴⁴De Garis v. Neville Jeffress Pidler Pty. Ltd. (1990), 95 A.L.R. 625 (F.C. Aust.) Beaumont J., at p. 629.

⁴⁵University of London Press v. University Tutorial Press (1916), (1916) 2 Ch. 601 (Ch. D.) Patterson J., at pp. 613-614.

⁴⁶Section 27(2)(d) exempts from copyright infringement the publication in a collection mainly composed of non copyright matter intended for school use, of short passages from published literary works not themselves published for school use and protected by copyright. The exception applies as long as not more than two passages from works of the same author are published by the same publisher within five years, and that the source of passages is indicated.

⁴⁷Hubbard v. Vosper (1971), (1972) 2 W.L.R. 389 (C.A.) Denning J., at p. 394.

⁴⁸Sillitoe v. McGraw-Hill Book Co. (U.K.) Ltd. Op cit. N^o 38 at p. 559.

to an injurious extent of the original work. Is a material and valuable part of the contents of original communicated by the compilation? Will the latter tend to diminish the sale of the former, by reason of being wholly or partly a substitute? If so, the results of the original author's labour are appropriated to his injury, and his rights are invaded."⁴⁹

To reproduce in totality an article from a literary journal for the purpose of reviewing it was held as not being fair dealing⁵⁰.

It was also held that to make copies of protected video cassettes for one's own employees constitute an infringement to which the exception of section 27(2)(a) does not apply⁵¹.

The fair dealing provision of Section 27(2)(a.1), applicable to newspaper summaries, is not affected by the requirements of section 27(2)(e)⁵². Amazingly, it would appear that the report of a lecture in a newspaper would be forbidden under the circumstances set forth in section 27(2)(e), while, the said summary would be allowed under section 27(2)(a). Moreover, the report in a newspaper of a particular speech (i.e. address of a political nature) will not, in view of section 28, constitute infringement of the copyright that may subsist in such a speech.

It must be remembered that under Section 27(2)(a.1), the source and the author's name, if given in the source, must be mentioned in order for the dealings with any work for purposes of criticism, review or newspaper summary to be considered fair.

1.5.2 Computer programs

Sections 27(2)(l) and 27(2)(m) of the Act, deal with exceptions related to the reproduction of computer programs. These sections were introduced in 1988 as part of the amendments of the Copyright Act that recognized computer programs as capable of copyright protection as literary works⁵³.

⁴⁹DRONE (Eaton S.), A Treaty on the Law of Property in Intellectual Productions in Great Britain and the United State (Boston, Little, Brown & Co. 1879) at p. 388.

⁵⁰Zamacois v. Douville (1943), (1944) Ex. C.R. 208 (Ex. C.C.) Angers J.

⁵¹Tom Hopkins International, Inc. v. Wall & Redekop Realty Ltd. (1984), 1 C.P.R. (3d) 348 (B.C.S.C.) Trainor J.

⁵²Section 27(2)(e) enounces that "does not constitute an infringement of copyright, the publication in a newspaper of a report of a lecture delivered in public, unless such report is expressly prohibited by a conspicuous written or printed notice on the premises where the lecture is given, both at its main entrance and, unless the building is being used for public worship, near the lecturer.

⁵³S.C. 1988, c. 15, s.1(3).

Section 27(2)(l) exempts from infringement the making of a single reproduction of the copy of a computer program. Such a making could be made either by adapting, modifying, converting the computer program or translating the computer program into another computer language.

However, in order for the exception to apply, the person who intends to rely upon it must prove that it owns an authorized copy of the computer program, the reproduction is essential for the compatibility of the computer program with a particular computer, the reproduction is solely for the person's own use and the reproduction is destroyed forthwith when the person ceases to be the owner of the copy of the computer program.

It is to be noted that such a reproduction must be essential, i.e. absolutely necessary and indispensable, for the compatibility of the computer program with a particular computer and not only useful or constituting an improvement.

The exception only applies to the owner of an authorized copy of the computer program, as opposed to an authorized user of such a copy. It is a relatively common practice in the field not to assign ownership of the copy of the computer program, but rather to grant a licence for the use thereof.

Section 27(2)(m) exempts from infringement the making of a backup copy of a computer program. For this section to apply, several conditions must be met, namely: the making of a single reproduction for backup purposes of an authorized copy of a computer program by the person who owns this copy of the computer program.

Moreover, such a backup copy must be destroyed forthwith when this person is no longer the owner of such an authorized copy.

As in the case of the exemption provided for by section 27(2)(l), this exception only applies to the owner of an authorized copy of the program which is not always the case. Furthermore, there is no grace period and the backup copy must be immediately destroyed, namely when the owner of the authorized copy of the computer program is no longer its owner.

Moreover, this section clearly indicates that the onus is on who wants to avail itself of the exception to prove each of the conditions set forth in the subsection.

Since the question of criminal and civil remedies will be analyzed by Mrs. Emma Grell, we do not intend here to discuss this matter.

Nevertheless, we would like to make a short comment on one particular remedy existing in Quebec: the seizure before judgement of infringing copies of a work.

1.6 Remedy: Seizure Before Judgement

As currently interpreted by the Quebec courts, Section 38 of the Act⁵⁴, combined with article 734(1) of the Code of Civil Procedure of the province of Quebec (R.S.Q, c. C-25)⁵⁵ permits the seizure before judgement of the infringing copies which the copyright owner is entitled to revindicate the possession thereof as alleged owner, without the need to obtain a judge's permission.

The alleged copyright owner needs only to declare in an affidavit: (1) subsistence and ownership of copyright in a work; (2) infringement of such copyright; (3) ownership in the infringing copies by virtue of section 38 of the Act. With that, a copyright owner can seize and remove truck loads of alleged infringing copies.

This is where we believe the Quebec courts have gone wrong. They have taken as infringing, copies which were simply alleged to be infringing. We submit that as long as a judgment has not declared the copies to be infringing, they cannot be taken as such. Therefore, the deeming provisions of section 38 should only come into force after judgment on the merits, not at a preliminary stage even before the statement of claim is filed.

This practice of the Quebec Superior court which was affirmed by the court of appeal (permission to appeal to the Supreme Court was refused) should, with all due respect, be abandoned⁵⁶.

⁵⁴This section reads: "All infringing copies of any work in which copyright subsists, or of any substantial part thereof, and all plates used or intended to be used for the production of the infringing copies, shall be deemed to be the property of the owner of the copyright, who accordingly may take proceedings for the recovery of the possession thereof, or in respect of the conversion thereof".

⁵⁵This section reads: "The plaintiff may also seize before judgement:
(1) The moveable property which he has a right to revindicate as owner, pledgee, depositary, usufructuary, institute, substitute or unpaid vendor;"

⁵⁶Formules Municipales Ltée v. Imprimerie Formules Légales Provinciales Ltée An unreported judgement rendered 1976.03.15 by the Honourable Mr Justice Trépanier, court docket 500-05 021366-750, translation published at (1976), 28 C.P.R. (2d) 259 (Q.S.C.); confirmed by an unreported judgement rendered 1978.02.15 by the Quebec Court of Appeal, docket 500-09-000027-763 (Q.C.A.); (1978), (1978) 1 S.C.R. viii (S.C.C.).

2. Moral Rights Infringement

The Copyright Amendment Act (S.C. 1988, c.15), introduced six (6) new sections dealing specifically with the concept of moral rights⁵⁷.

Since section 2(19) limitatively defines moral rights as those set out in section 14.1, any dealing not covered by the Copyright Act will not constitute an infringement of moral rights, even though the concept of moral rights may in some countries like France, Italy or Germany, be more encompassing than in Canada.

Sections 28.1 and 28.2 of the Act deal with the concept of moral rights infringement. Section 28.1 describes in general terms what constitutes infringement of moral rights and section 28.2 describes what constitutes an infringement of moral rights with respect to the integrity of a work.

Before going any further in the analysis of these concepts, it is useful to describe shortly what is encompassed in the concept of moral rights under the Act.

2.1 Definition of Moral Rights

Under section 14.1 of the Copyright Act the moral rights of an author are twofolds, namely: the right to the integrity of the work and the right to be associated with the work as its author.

As already stated, the restrictive definition of moral rights provided in section 2(19) combined with section 63 of the Act, which enounces that no person is entitled to copyright or any similar rights otherwise than under and in accordance with the Copyright Act, takes all its importance.

2.1.1 Paternity Right

Section 14.1(1) provides for the right of an author to be identified as the creator of a work, irrespective of the ownership of the copyright in such work.

⁵⁷These sections are:

- Definition of "moral rights" (section 2(19));
- Moral rights in general, right of authorship and waiver (section 14.1);
- Term and devolution (section 14.2);
- Infringement of moral rights (section 28.1);
- Nature of right of integrity (section 28.2); and
- Civil remedies (section 34(1.1)).

Such right of "paternity" lasts for the same period as the copyright in the work⁵⁸.

Section 14.1 provides that the author of a work has:

- i) The right to be associated with the work as its author;
 - by name or
 - under a pseudonym;
- ii) the right to remain anonymous.

This would include the right of an author to prevent the work from being attributed wrongly to someone else.

This provision would also allow an author to restrain false or erroneous designation of his quality of author as, for instance, inaccuracies in his name or designation, error in the attribution of his contribution to the work.

Under section 14.1(1), the right to be identified as an author exists only with respect to the acts referred to in section 3 of the Act.

Furthermore, the right of "paternity" can only be asserted "where reasonable in the circumstance ". It should be noted also that section 14.1(1) does not specify the way such paternity right shall be asserted.

2.1.2 Right to Integrity

Section 14.1(1) also provides that an author has the right to the integrity of his work, whether or not he has waived his right to be identified as the author of the work.

The author can therefore object to any derogatory treatment of his work, namely to the distortion of his work, the mutilation of his work, other modification to his work, or the use of his work in association with a product, service, cause or institution.

2.2 Under what conditions can moral rights be infringed

Section 28.1 reads:

⁵⁸Section 14.2(1) of the Act.

"Any act or omission that is contrary to any of the moral rights of the author of a work is, in the absence of consent by the author, an infringement of the moral rights".

Infringement of the moral rights relating to a work occurs when any person, without the consent of the author (or his successor in title as the subsequent owner of the moral rights), does anything or omits to do something which the Copyright Act considers as contrary to the author's moral rights.

Prior to the enactment of this section, the extent of an infringement of moral rights was unclear and the related civil remedies available doubted. (see Gnass v. Cité D'Alma)⁵⁹.

It is noteworthy that section 28.1, contrary to section 27(1), does not have a (deeming) provision with respect to the infringement of moral rights.

2.2.1 In General

Section 28.1 provides that the moral rights may be infringed either by an act or by an omission.

Under section 14.1, an author has the right to be associated with his work as its author by name, to be associated with his work as its author under a pseudonym and to remain anonymous with respect to his work. Therefore, omitting the name of the author or indicating someone else than the author as the author may constitute an infringement of the moral rights of the author.

Under section 14.1 and 28.2 an author is entitled, in relation with his honour, to the integrity of his work. While it is easy to conceive acts which, by themselves, will distort, mutilate, otherwise modify, or associate a work, it is more difficult to conceive omissions in regard thereto. Would, for instance, the authorization by the owner of a work or his mere passive acquiescence to the doing of an act which otherwise infringes the moral rights of the author, constitute in itself an infringement under section 28.1?

In that regard, it would appear important not to confuse the contractual obligations that may exist between the owner of a physical work and its author with the obligation of everyone to respect the moral rights of the latter under the Act.

⁵⁹ An unreported judgement rendered 1973.11.23 by the Honourable Mr. Justice Mignault, court docket A-158 (Q.S.C.) at p. 31, confirmed in appeal.

Hence, apart from the civil remedies for infringement of the moral rights that may be available to an author under section 34(1.1), other remedies depending on the circumstances, may also be available to the author under the law of contracts⁶⁰.

It may be also noted that, at common law the specific reference to infringement by omission is a derogation to the principle that, in general, there is no answerability for omissions. As expressed by Dias:

"In contrast to an "act", an "omission" is a failure to act. In this sense omission would cover everything that is not an act, which is clearly too wide. It has therefore to be restricted and at once becomes technical. The limits become apparent when it is realized that, as with act, lawyers are concerned with omissions for the purpose of ascribing responsibility justly. They are relevant only when there has been a failure to comply with duties to act. Such duties are encountered in various situations and their existence is, as always, a matter of policy. "An omission on the part of one or other of the defendant", said Willmer L.J. (in Zoernsch v. Waldock (1964) 2 All E.R. 256 (C.A., at p. 262)) "would not furnish the plaintiff with any cause of action in the absence of some duty by the defendant to the plaintiff. The dividing line between acts and omissions is not clear cut. In the first place, omissions should be distinguished from failures which are incidental to larger activities."⁶¹

This specific reference to infringement by omission is the corollary to the duty imposed on all persons to respect the moral rights of authors. Moreover, section 28.1 deals with the moral rights of an author, which encompasses the heirs of such an author for the duration of such rights (section 14.2(2)).

Furthermore, the Copyright Act does not provide for general provisions as to works in which moral rights may subsist, as it is the case under section 5 for the subsistence of copyright. In the absence of such definition or statutory qualifications, it could be argued that moral rights may be attached to any work, irrespective of its originality, the nationality or residence of its author, or the time and place of first publication, as the case may be. Such an approach, it is submitted, would appear contrary to the genesis of the introduction in the Copyright Act of the provisions dealing with moral rights.

2.2.2 In Relation with the Right of Integrity

Sections 28.2 reads:

⁶⁰Gnass v. Ville de Montréal (1974), (1974) C.S. 414 (Q.S.C.) Malouf J., at p. 414.

⁶¹DIAS (R.W.M.), Jurisprudence 5th ed. (London, Butterworths, 1985), at p. 310.

- (1) The author's rights to the integrity of a work is infringed only if the work is, to the prejudice of the honour or reputation of the author,
- (a) distorted, mutilated or otherwise modified; or
 - (b) used in association with a product, service, cause or institution.
- (2) In the case of a painting, sculpture or engraving, the prejudice referred to in sub-section (1) shall be deemed to have occurred as a result of any distortion, mutilation or other modification of the work.
- (3) For the purposes of this section,
- (a) a change in the location of a work, the physical means by which a work is exposed or the physical structure containing a work, or
 - (b) steps taken in good faith to restore or preserve the work

shall not, by that act alone, constitute a distortion, mutilation or other modification of the work."

Section 14.1(1) provides that an author has the right to the integrity of his work. This general prohibition against derogatory treatment is subject to section 28.2. The moral right of integrity is attached to a work and its author upon creation, without any kind of registration or formalities; this right, which is distinct from the paternity right, may be waived in whole or in part by the author, as provided in section 14.1(2) of the Act and may be bequeathed as provided for by section 14.2.

The author can therefore object to any derogatory treatment of his work, namely to the distortion of his work, a mutilation of his work, other modifications to his work, or the use of his work in association with a product, service, cause or institution, if these dealings are prejudicial to his honour and reputation, whether or not he has waived his rights to be identified as the author of the work.

Thus, section 28.2(1) provides for two kinds of behaviors which may encroach upon the integrity of a work: the first has to do with modifications brought to the work (section 28.2(1)(a)) and the second with the use of the work (section 28.2(1)(b)). However, for such acts or omissions to be actionable, they have to prejudice the honour or reputation of the author.

Section 28.2 and section 14.1 do not indicate whether the derogatory treatment should be in relation to a substantial part of the work, as it is the case, for instance, for direct infringement of copyright under section 3(1). The proper approach would seem to be to consider that the right to integrity applies in relation to the whole or part of the work.

However, should the modification be trivial or quantitatively unimportant in regard of the whole work, a Court may refuse to intervene on the basis *de minimis lex non curat*. Such would not, it is submitted, be correct as the infringement is not in relation to the importance of the modification but rather to its impact on the honour or reputation of the creator.

A. Distortion, Mutilation or Modification of the Work

Section 28.2(1) does not state, when a work will be held distorted, mutilated or otherwise modified in a fashion prejudicial to the honor or reputation of the author.

Section 28.2(1) imposes upon the owner of the physical work to which a right of integrity attaches, a serious restriction over the dominion that he could otherwise enjoy, be he the owner of the copyright in the work or not.

Section 28.2 does not cover as such the natural deterioration of the work without human intervention. This section does not either impose upon the owner of the physical work any formal obligation to preserve or to restore the work. However, such an owner may be under a contractual obligation to maintain the work in a proper state.

Whether the total destruction of the work would amount to a "distortion, mutilation or other modifications" of the work, has fuelled long but unconcluded debate, at least in Canada⁶².

The qualified expression "when reasonable in the circumstances" is used in section 14.1 with respect to the paternity right, but not in section 28.2. However, it is submitted that, modifications and even alterations made to a work should be allowed in some circumstances and, in fact, are contemplated - as part of an implied consent of the author, for instance, for the purposes of translating or adapting a work, as provided for by section 3.

⁶²COLAS (Emile), *Les Recours de l'Artiste en Cas de Destruction de son Oeuvre* (1980), 1 *Revue Canadienne du Droit d'auteur* 2; VAVER (David), *Authors' Moral Rights-Reform Proposal in Canada: Charter or Barter of Rights for Creators?* (1987), 25 *Osgoode Hall Law Journal* 749, at pp. 765-766.

B. Association of the Work

Section 28.2(b) provides that the integrity of a work may be violated without modifying it but simply by it being used in association with a product, a service, a cause or an institution. This prohibition, which sometime is referred to as "droit d'aval", is not restricted to commercial use, but attached to any use to which the author has not consented and which that is prejudicial to his honour or reputation.

The original of this provision may be tracked back to the Bruxelles Revision 1948 of the Berne Convention to which Canada, however, is not a party.

"Article 6 bis(1) of this Convention was then amended by the Brussels revision so as to add the periphrase," or any other derogatory action in relation to said work"⁶³. As written by Strauss:

"This part of the moral right allegedly protects the author against unfair use or misuse of his name, his work, or his personality"⁶⁴.

This new provision was adopted in order to protect a work against any attack, irrespective of any modification to the work itself. As expressed by Puttemans:

"L'atteinte à l'intégrité de l'oeuvre peut donc être indirecte et résider dans la présentation ou le contexte entourant l'oeuvre, lorsque ceux-ci sont de nature à donner au public une idée inexacte de l'oeuvre. (...) le droit au respect protège son titulaire non seulement contre toute atteinte directe à l'intégrité de l'oeuvre, mais aussi envers toute utilisation qui en déprécierait de (sic) valeur ou en dénaturerait l'esprit."⁶⁵.

C. Honour or Reputation of the Author

⁶³Article 6 bis(1) of the Berne Convention reads: "Independently of the author's copyright, and even after transfer of said copyright, the author shall have the right, DURING HIS LIFETIME, to claim authorship of the work AND to object to any distortion, mutilation or other alteration THEREOF, OR ANY OTHER ACTIONS IN RELATION TO THE SAID WORK which would be prejudicial to his honour or reputation."

⁶⁴STRAUSS (William), The Moral Right of the Author (1955), 4 *The American Journal of Comparative Law* 506, at p. 514.

⁶⁵PUTTEMANS (Andrée), Les Auteurs sont-ils responsables de leurs actes?(ou: du droit au respect de l'intégrité de l'oeuvre face aux contrats et aux exigences actuelles du commerce et de la technique), in *Les Journées du Droit d'Auteur - Actes du Colloque* (Bruxelles, Bruylant, 1989), at pp. 308-309.

To give rise to an action for infringement of the integrity right, the bad treatments given to the work under subsections 28.2(a) or (b) must prejudice the honour or reputation of the author. It may be said that the right of an author to the integrity of his work, flows from the fact that a work expresses the personality of its creator and it is nothing but a continuation of the very person of its creator.

In the context of the Copyright Act, these two words "honour" or "reputation" do not appear to have any special meaning and refer to the good standing of the name of the author. Useful reference could

be made to the 1984 Third Revision Edition of the Shorter Oxford English Dictionary to ascertain the nuances between those two terms, namely:

"Honour: high respect, esteem, or reverence accorded to exalted work or rank; differential admiration or approbation";

"Reputation: the common or general estimate of a person with respect to character or other qualities; the relative esteem in which a person is held".

As written by LESTER:

"Presumably, it is something which will have to be judged by some objective standard. It may be that some assistance would be gained from libel cases, as referenced to "honour or reputation", seem to have more in common with the law of defamation than the law of copyright"⁶⁶.

As expressed by VAVER:

"The reputation referred to no doubt is primarily the author's literary or artistic reputation but, since a person's reputation is ordinarily indivisible, should also encompass the author's personal reputation as well⁶⁷."

Finally, to paraphrase the question put by NORDEMANN, with respect to article 6 bis of the Berne Convention: Does section 28.2(1) cover those alterations that are detrimental to the honour or reputation of the author

⁶⁶LESTER (David) et al., Joyson-Hicks on U.K. Copyright Law (London, Sweet & Maxwell, 1990), at No. 11.19.

⁶⁷VAVER (David), Authors' Moral Rights in Canada (1983), 14 *International Review of Industrial Property and Copyright Law* 329, at p. 356.

(actual harm) or does it also extend to those alterations that could be detrimental to the honour or reputation of the author (threatening harm)?⁶⁸

D. Presumption of Prejudice in Certain Circumstances

Section 28.2(2) creates a presumption of prejudice in favour of three (3) types of artistic works, namely paintings, sculptures and engravings. These are generally referred to as the "fine art". It is to be noted that this sub-section refers to "sculpture", which is a term as such not defined in the Act. There is however a definition of "work of sculpture" at section 2(27).

This presumption does not apply with respect to the other types of artistic works, like those enumerated under section 2(2), namely: drawings, maps, charts, plans, photographs, works of artistic craftsmanship and architectural work of art. It does not apply neither to literary, musical or dramatic works nor to mechanical contravencies by means of which sounds may be mechanically reproduced (section 5(1) and (3)).

This presumption comes into operations whereupon the designated types of works are distorted, mutilated or modified; it is to be noted that the presumption does not apply to the associated uses referred to in section 28.2(1)(b).

Once the derogatory treatment of the designated work is proved, there is a presumption that such treatment has prejudiced the honour and reputation of the author.

E. Permitted Acts

Section 28.2(3) indicates that a change in the location of a work or its restoration, will not amount as such to a distortion, mutilation or modification of said work.

This subsection applies to any work and is not restricted to works of fine arts (i.e., paintings, sculptures and engravings); it also applies to the deemed prejudicial situations depicted in sub-section 28.2(2), as well as to the any encroachment upon the integrity right more generally described under section 28.2(1).

⁶⁸NORDEMANN (Wilhelm) et al., International Copyright and Neighboring Rights Law (Weinheim, VCH, 1990), at pp. 87-88.

This section provides that the following changes shall not, by themselves alone, be considered as distorting, mutilating or otherwise modifying a work, namely a change in the location of a work, a change in the physical means by which a work is exposed or a change in the physical structure containing the work.

In a case of a change in a location, it is to be noted that there is no requirement of good faith, as is the case with respect to restoration.

Finally, it has to be noted that the Copyright Act does not provide for any specific exemptions to the infringement of the moral rights, as it is the case, for instance for acts not constituting infringement of copyright under sections 27(2) and 28.

However, section 64(2) provides for a limited exemptions from copyright and moral rights infringements with respect to designs applied to a useful article or in an artistic work from which the design is derived.

2.3 Remedies in Case of Moral Rights Infringement

Section 34(1.1) provides that where a moral right in any work has been infringed, the author or his heirs (section 14.2(2)) is entitled to civil remedies by way of injunction, damages, accounts, delivery up, or remedies that are or may be conferred by law for the infringement of a right.

It is of interest to note that this section specifically deals with the power of the Court to order the delivery of the goods infringing a moral right while section 34(1) does not refer namely to such a remedy with respect to the infringement of copyright.

Whether section 35 applies also to infringement of moral rights is left open to judicial determination. It should be noted that section 35 makes specific reference only to the infringement of the copyright in a work, and not to infringement of moral rights. However, section 34(1.1) opens the door to other remedies when it uses the expression "... and otherwise that are or may be conferred by law for infringement of a right".

Similarly, the discretionary award of cost "in any proceedings in respect of "infringement of copyright" referred to in section 34(2) may not apply to proceedings for infringement of moral rights, save for the inherent powers that a court may have to award these costs.

Whether the conversion/detinue provisions set forth in section 38 may apply to the copies which infringe the moral rights is also debatable. The wording of

section 38 refers to "infringing copies" but gives deemed property of the said infringing copies to the copyright owner only, with no reference to the moral rights owner.

It has to be noted that section 43(2) of the Act provides that, with respect to any dramatic work, any operatic work, or any musical composition, the following constitutes an offense, namely: any change in the title, any suppression of the title, any change in the name of the author, any suppression in the name of the author.

Such offenses cover, in a limited way, the right of paternity and the right to the integrity of a work; they co-exist with the civil remedies provided for by section 34(1.1).

Moreover, as sections 44 and 45 of the Copyright Act refers to the prohibition of importation in favour of a copyright owner, it would appear that, in the absence of any clear provisions in favour of the moral right's owner, the latter may not be able to invoke section 44 and 45. This uncertainty remains to be clarified by the Court.

Finally, section 41 provides for statutory limitation of three (3) years for civil remedies arising from infringement.

It is of interest to note that the word "copyright" was removed from the text of section 41 in the Copyright Amendment Act (S.C. 1988, c.15, s.9). The use of the all-encompassing word "infringement" instead of the terms "copyright infringement" or "infringement of copyright" was most likely intended to prevent the courts from concluding that the limitation period of three (3) years set forth in section 41 did not apply to an action for infringement of moral rights pursuant to section 34(1.1).

Therefore, the time limitation of section 41 applies to infringement of copyright as well as moral rights.

