

Originality and Utilitarian Works: The Uneasy Relationship between Copyright Law and Unfair Competition

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THE U.S. CASE OF *INTERNATIONAL NEWS SERVICE V. ASSOCIATED PRESS*¹ is often taught in property law classes as defining the boundaries between conduct that infringes copyright and conduct that amounts to a species of "unfair competition." Although the tort of unfair competition has had an uneven track record since *INS*,² the attempt by the majority of the United States Supreme Court to separate unfair competition concerns from copyright law remains interesting. The rapid proliferation of utilitarian works for which copyright protection is sought in the "information age" has placed copyright law under increasing strain with respect to the protection of these works. Recent case law in the United States and Canada illustrates the struggle to define the limits of copyright law in relation to utilitarian works, the content of which is primarily appropriated in a context of business competition. In Canada, the concept of unfair competition, which the Court in *INS* sought to separate from copyright law, is flourishing within, and not outside of, Canadian copyright law jurisprudence.

Utilitarian works are defined in this paper as works that do not have creative or artistic expression as their primary purpose. Instead, they are intended to perform a practical or useful function. Generally speaking, they are created as commercial products. Utilitarian works can include telephone directories,³ com-

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1. 248 U.S. 215, 39 S. Ct. 68 (1918) [*INS* cited to U.S.].
 2. Copyright pre-emption has raised problems where the state tort action is seen as infringing on federal jurisdiction over copyright issues. See Wendy J. Gordon, "On Owning Information: Intellectual Property and the Restitutionary Impulse" (1992) 78 Va. L. Rev. 149 at 150-59. Gordon is critical of trends towards recognizing relief on this basis. She criticizes judges for "expanding state law to give creators of intangibles both tort and property rights in the 'fruits of their labors.'" Furthermore, she raises concerns that "traditional defenses to the creation of such rights on notions of public interest are sometimes improperly resisted and desirable prerequisites for suit ignored." (Gordon at 153).
 3. *Tele-Direct (Publications) Inc. v. American Business Information, Inc.* (1996), 113 F.T.R. 123, (1996), 27 B.L.R. (2d) 1 (F.C.T.D.) [*Tele-Direct* (F.C.T.D.)], aff'd (1997), [1998] 2 F.C. 22, <<http://reports.fja.gc.ca/fc/1998/pub/v2/1998fc21425.html>>, (1997), 76 C.P.R. (3d) 296 (F.C.A.) [*Tele-Direct* (F.C.A.) cited to F.C.], leave to appeal to the S.C.C. denied [1998] 1 S.C.R. xv.

puter software,⁴ race-track forms,⁵ tax forms,⁶ brochures,⁷ menus,⁸ lottery tickets,⁹ case reporters and indices,¹⁰ to give a few examples. Many utilitarian works are “information products.” Indeed, it is no accident that the illustrations listed above are all ones that would fall under the category of “literary works”; in the information age it is in the area of “literary works” that the greatest challenges to copyright have arisen.

Case law dealing with utilitarian works illustrates the struggles that have arisen with respect to the very boundaries of copyright law. Although recent decisions of the Federal Court of Appeal have emphasized that copyright lies in original works and that originality can flow from the exercise by an author of “skill, judgment and labour,” the phrase “skill, judgment and labour” offers great latitude for a finding of “originality.” There remains confusion as to whether labour alone—in other words, “sweat of the brow”—is sufficient in Canada to give rise to originality. The confusion about the standard for originality is profound; in one recent case, the Federal Court of Appeal went so far as to protect the idea behind the work, rather than its expression.¹¹ In other cases, courts have openly protected facts on a “sweat of the brow” basis.¹² Because copyright issues involving utilitarian works arise primarily in contexts where the defendant has appropriated such materials in order to gain a business advantage, courts in these instances may well be motivated to protect the plaintiff from a loss that has been framed in terms of copyright infringement.

This paper examines the concept of “originality” in light of the shifting purposes of copyright law in Canada and of the historical relationship of utilitarian works to copyright law. After situating this discussion in the context of the issues raised in *INS*, it is argued that the protection of utilitarian works under Canadian copyright law has been controversial in the past and that the law has, in some cases, been amended to exclude or limit such protection. By examining the treatment of the concept of “originality” in recent Canadian cases dealing

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4. *Apple Computer Inc. v. Mackintosh Computers Ltd.* (1986), [1987] 1 F.C. 173, (1986), 10 C.P.R. (3d) 1 (F.C.T.D.), (1987), aff'd [1988] 1 F.C. 673, (1987), 18 C.P.R. (3d) 129 (F.C.A.), aff'd [1990] 2 S.C.R. 209, <http://www.lexum.umontreal.ca/csc-scc/en/pub/1990/vol2/html/1990scr2_0209.html>, (1990), 30 C.P.R. (3d) 257 [*Apple Computer* cited to S.C.R.].
 5. *British Columbia Jockey Club v. Standen (c.o.b. Winbar Publications)* (1985), 22 D.L.R. (4th) 467, (1985), 8 C.P.R. (3d) 283 (B.C.C.A.) [*B.C. Jockey Club* cited to C.P.R.].
 6. *U & R Tax Services Ltd. v. H & R Block Canada Inc.* (1995), 97 F.T.R. 259, (1995), 62 C.P.R. (3d) 257 (F.C.T.D.) [*U & R Tax Services* cited to C.P.R.].
 7. *Slumber-Magic Adjustable Bed Co. v. Sleep-King Adjustable Bed Co.* (1984), [1985] 1 W.W.R. 112, (1984), 3 C.P.R. (3d) 81 (B.C.S.C.) [*Slumber-Magic* cited to C.P.R.].
 8. *Tomas v. Boaden Catering Ltd.* (1995), 115 F.T.R. 236, (1995), 68 C.P.R. (3d) 275 (F.C.T.D.) [*Boaden Catering* cited to C.P.R.].
 9. *Boutin v. Distributions C.L.B. Inc.* (1992), 56 Q.A.C. 206, (1992), 46 C.P.R. (3d) 395 (Que. C.A.), rev'd [1994] 2 S.C.R. 7, <http://www.lexum.umontreal.ca/csc-scc/en/pub/1994/vol2/html/1994scr2_0007.html>, (1994), 54 C.P.R. (3d) 160 [*Boutin* cited to S.C.R.].
 10. *CCH Canadian Ltd. v. Law Society of Upper Canada*, 2002 FCA 187, <<http://decisions.fct-cf.gc.ca/fct/2002/2002fca187.html>>, [2002] 4 F.C. 213, (2002), 18 C.P.R. (4th) 161 (F.C.A.) [*CCH* cited to F.C.].
 11. *Édutile Inc. v. Automobile Protection Assn.*, [2000] 4 F.C. 195, <<http://reports.fja.gc.ca/fc/2000/pub/v4/2000fc26366.html>>, (2000), 6 C.P.R. (4th) 211 (F.C.A.) [*Édutile* cited to F.C.] (leave to appeal to the S.C.C. denied, SCC Bulletin, 2001 at 139), discussed *infra*.
 12. See *Weetman (c.o.b. Beta Digital Mapping) v. Baldwin*, 2001 BCPC 292 (B.C. Prov.Ct.) [*Weetman*]; *B & S Publications Inc. v. Max-Contracts Inc.* (2001), 287 A.R. 201 (Alta. Q.B.) [*B & S Publications*]; *B.C. Jockey Club*, *supra* note 5.

with utilitarian works, this paper explores the uneasy relationship between unfair competition law and copyright law in Canada. It is argued that the proliferation of utilitarian works protected by copyright, and, in particular, of information products, has rendered the low, “sweat of the brow” threshold for originality extremely problematic. The effect of this judge-made approach to interpreting the legislation has been to broaden the scope of the legislation to the point of changing its character. The problem lies in the tension between copyright and unfair competition, primarily in relation to utilitarian works. Copyright law is an inapt vehicle for resolving issues of competition in the information economy.

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1. *INS*: SEPARATING PROPERTY RIGHTS FROM UNFAIR COMPETITION

INTERNATIONAL NEWS SERVICE V. ASSOCIATED PRESS is often cited as standing for the proposition that there is no copyright in facts¹³ and for the existence of a species of tort of unfair competition.¹⁴ In fact, it is noteworthy as a case in which the United States Supreme Court struggled to distinguish between a harm that is actionable as an illegitimate business practice and one that interferes with property rights. The dispute, which arose during World War I, involved two rival companies, each in the business of gathering and distributing news for publication in the United States. The commercial success of the competing companies depended upon their ability to deliver up-to-date news in a prompt fashion. It also depended upon accurate and impartial reporting of the news.¹⁵ The plaintiff gathered news of the war from journalists that it had posted overseas and via its arrangements with other international news-gathering agencies. It incurred substantial costs in doing so. The defendant obtained news gathered by the plaintiff in a number of ways, including by bribing employees of the plaintiff’s newspapers to provide the defendant the news before publication and “by copying news from bulletin boards and from early editions of complainant’s newspapers and selling this, either bodily or after rewriting it, to the defendant’s customers.”¹⁶

The plaintiff alleged, *inter alia*, that the defendant’s activities violated their copyrights. Pitney J., writing for the majority of the Court, emphasized the need to distinguish “between the substance of the information and the particular form or collocation of words in which the writer has communicated it.”¹⁷ In other words, he sought to separate the underlying facts and ideas from their expression. With respect to the informational element of the news, he held there could be no copyright: “[T]he information respecting current events contained in the literary production is not the creation of the writer, but is a report of matters

13. *Feist Publications v. Rural Telephone Service* (1991), 449 U.S. 340, <http://www.law.cornell.edu/copyright/cases/499_US_340.htm>, (1991), 111 S. Ct. 1282 [Feist cited to U.S.]. In a decision penned by O’Connor J., the majority of the United States Supreme Court stated that *INS* stands for a rejection of the “sweat of the brow” principle (*Ibid.* at 353).

14. See e.g. *National Basketball Association v. Motorola*, 105 F.3d 841, <http://www.law.cornell.edu/copyright/cases/105_F3d_841.htm>, 41 U.S.P.Q.2D (BNA) 1585 (2d Cir. 1997) [NBA cited to F.3d].

15. *INS*, *supra* note 1 at 230.

16. *Ibid.* at 231.

17. *Ibid.* at 234.

that ordinarily are *publici juris*; it is the history of the day."¹⁸ Rejecting copyright as a basis for the action, Pitney J. focused instead on unfair competition. He accepted that there was a property interest of sorts in the news, but distinguished between the monopoly nature of the copyright interest and another more focused interest:

... we may and do assume that neither party has any remaining property interest as against the public in uncopyrighted news matter after the moment of its first publication, it by no means follows that there is no remaining property interest in it as between themselves. For, to both of them alike, news matter, however little susceptible of ownership or dominion in the absolute sense, is stock in trade, to be *gathered at the cost of enterprise, organization, skill, labor, and money*, and to be distributed and sold to those who will pay money for it, as for any other merchandise.¹⁹

The majority of the Court thus articulated a limited "proprietary" interest which operated between two competitors and which arose from the one attempting to profit from the investment of "skill, labor and money" of the other.²⁰

Pitney J. emphasized the commercial value of the information gathered by the plaintiff:

Not only do the acquisition and transmission of news require elaborate organization and a large expenditure of money, skill, and effort; not only has it an exchange value to the gatherer, dependent chiefly upon its novelty and freshness, the regularity of the service, its reputed reliability and thoroughness, and its adaptability to the public needs; but also, as is evident, the news has an exchange value to one who can misappropriate it.²¹

In rejecting copyright law as a basis for relief in the circumstances, Pitney J. reiterated that the concern with use of the information was not a concern with respect to the public at large, but, rather, it was one with respect to a competitor. He argued that the fault in relying upon copyright "lies in applying as a test the right of the complainant as against the public, instead of considering the rights of complainant and defendant, competitors in business, as between themselves."²² While it would be unobjectionable for a member of the public to communicate what he or she has read in a newspaper to another individual, it is problematic from a legal standpoint when a business rival conveys the same information in a manner that competes economically with the complainant. In doing so, the defendant "...is taking material that has been acquired by com-

18. *Ibid.*

19. *Ibid.* at 236 [Emphasis added].

20. While this was the basis of a finding for the plaintiff based on unfair competition, language very similar to that used by the United States Supreme Court arises in Canadian copyright cases involving utilitarian works. See e.g. *Slumber-Magic*, *supra* note 7 at 84, where McLachlin J. referred to "the amount of skill, judgment or labour that has been involved in making the compilation." See also *B.C. Jockey Club*, *supra* note 5 at 286, where the British Columbia Court of Appeal upheld the trial judge's finding of copyright infringement based on an appropriation of "a substantial amount of the work, skill, judgment and knowledge of the Club."

21. *INS*, *supra* note 1 at 238.

22. *Ibid.* at 239.

plainant as the result of organization and the expenditure of labor, skill, and money, and which is salable by [the] complainant for money."²³ Furthermore, Pitney J. characterized the defendant as "endeavoring to reap where it has not sown," and as "appropriating to itself the harvest of those who have sown."²⁴ The fault, therefore, lies in the unfair nature of the competition, and not in the taking of material that is the intellectual property of the complainant.

The majority of the Court clearly separated out unfair competition from property rights in the form of copyright, and argued substantial public policy reasons why copyright law should not govern the taking of factual material from the plaintiff's news reports. Although entitled to relief, the boundaries of the complainant's right to be free from unfair competition with respect to the gathering of the news were characterized by the Court as being limited to "the extent necessary to prevent that competitor from reaping the fruits of [the] complainant's efforts and expenditure."²⁵ Unlike a copyright, the right is confined to a narrow window of time reflecting the commercial value of "hot" news.²⁶

Significantly, Brandeis J., in dissent, took the view that it was inappropriate for the courts to carve out a quasi-property protection for "hot news" through the vehicle of the tort of unfair competition, which would lack clearly articulated boundaries. He wrote:

The creation or recognition by courts of a new private right may work serious injury to the general public, unless the boundaries of the right are definitely established and wisely guarded. In order to reconcile the new private right with the public interest, it may be necessary to prescribe limitations and rules for its enjoyment; and also to provide administrative machinery for enforcing the rules.²⁷

While Brandeis J. agreed that there was no copyright in the factual information that constituted the news, he would have preferred to leave the complainant with no remedy rather than to fashion one to address a matter best left to the legislature.

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2. CORE PURPOSES OF CANADIAN COPYRIGHT LAW

THE KIND OF STRONG STATEMENT about the boundaries of copyright law that was made in *INS* is largely absent from Canadian copyright jurisprudence. In spite of the "public interest" dimension to copyright, the public interest has not always been at the forefront of judicial interpretations. There has been much ambiva-

23. *Ibid.*

24. *Ibid.* at 239–40.

25. *Ibid.* at 241.

26. The sensitivity to the term of protection is interesting as it foreshadows similar concerns raised with respect to copyright protection of such utilitarian works as industrial designs and databases. In the case of industrial designs, the term of protection has been set at 10 years. Under EC, *European Database Directive*, Directive 96/9/EC of the European Parliament and of the Council of the European Union of 11 March 1996 on the Legal Protection of Databases, [1996] O.J. L. 77/20, <<http://europa.eu.int/ISPO/infosoc/legreg/docs/969ec.html>> [*European Database Directive*], the term of protection for compilations of fact is set at 15 years (Article 10).

27. *INS*, *supra* note 1 at 262–63.

lence about the scope and purpose of copyright law,²⁸ and Canadian courts have not traditionally been very helpful in this regard.²⁹

The history of copyright reform in Canada also suggests legislative ambivalence about the purpose of copyright law. At one point, proposals for copyright reform in Canada emphasized protection of the inherent right of the author to the fruits of his or her labour.³⁰ More recently, courts and authors have adopted the view that copyright legislation serves to provide a limited monopoly to authors as an incentive to produce works that will benefit society.³¹ The incentive theory has received some highly placed support. In *Théberge v. Galerie d'Art du Petit Champlain Inc.*,³² a recent decision of the Supreme Court of Canada, Binnie J. for the majority described Canadian copyright law as striking "a balance between promoting the public interest in the encouragement and dissemination of works of the arts and intellect and obtaining a just reward for the creator...."³³ This statement of purpose would appear to be at odds with the theory of inherent authorial rights.

This statement reflects a "classic" view of the purpose of copyright law³⁴ and it is not surprising that it arises in the context of a dispute over one of the most traditional kinds of works protected by copyright: an artist's painting. The statement of purpose is interesting, as it seems to suggest that the public interest is at least as important in the equation as the rights of the creator of a work. In a "sweat of the brow" paradigm, it is the entitlement of the creator of a work that forms an almost exclusive basis for the justification of the copyright monopoly. It is much more difficult to justify granting copyright over facts, via the principle of "sweat of the brow," where there is a robust concept of the public domain and the public interest. The expansion of copyright law to protect works of a less creative and more utilitarian character is in many ways inconsistent with the public policy objectives of copyright law identified by Binnie J.

28. Neither s. 91(23) of the *Constitution Act, 1867*, (U.K.) 30 & 31 Vict., c. 3, <<http://laws.justice.gc.ca/en/const/index.html>> nor the Canadian *Copyright Act*, R.S.C. 1985, c. C-42, <<http://laws.justice.gc.ca/en/C-42/>> contains a statement of purpose.
29. In *Bishop v. Stevens*, [1990] 2 S.C.R. 467, <http://www.lexum.umontreal.ca/csc-scc/en/pub/1990/vol2/html/1990scr2_0467.html>, (1990), 31 C.P.R. (3d) 394 at 477 [*Bishop* cited to C.P.R.], McLachlin J. (as she then was) stated that "copyright law is purely statutory law," and took the view that resolving the issues in dispute was a matter of statutory interpretation. This echoes an earlier decision of the Supreme Court of Canada, *Compo Co. v. Blue Crest Music Inc.*, [1980] 1 S.C.R. 357 at 373, (1979), 45 C.P.R. (2d) 1 [*Compo* cited to S.C.R.], wherein Estey J. referred to the *Copyright Act* as providing simply "rights and obligations upon the terms and in the circumstances set out in the statute."
30. See House of Commons, Standing Committee on Communications and Culture, *A Charter of Rights for Creators—Report of the Subcommittee on the Revision of Copyright* (Ottawa: Supply and Services Canada, 1985). Unfortunately, to equate labour to the work of creators of traditional works is confusing when translated to utilitarian works.
31. As Vaver aptly notes, the calculation of what is of benefit to society involves a range of considerations that may vary from one society to another or that, within a single society, may vary over time. See David Vaver, *Copyright Law* (Toronto: Irwin Law, 2000) at 8–10.
32. 2002 SCC 34, <http://www.lexum.umontreal.ca/csc-scc/en/pub/2002/vol2/html/2002scr2_0336.html>, [2002] 2 S.C.R. 336 [*Théberge* cited to S.C.R.].
33. *Ibid.* at 355.
34. For example, the *United States Constitution* has, from the outset, articulated the purpose of copyright as being "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." *United States Constitution*, art. 1, § 8, cl. 8, <<http://www.house.gov/Constitution/Constitution.html>>.

In a recent report to Parliament, it was noted that alongside the cultural policy objectives of the *Copyright Act* are objectives related to using the legislation “as a powerful lever to promote innovation, entrepreneurship and success in the new economy.”³⁵ The explicit objective of the federal government’s latest round of copyright reforms is to promote “the dissemination of new and interesting content on-line, for and by Canadians.”³⁶ The economic objectives relate in part to the balance between creators and users of more traditional kinds of works and in part to the creation of incentives for economic growth in the digital and information society. Certainly, the above-mentioned statements of objective extend beyond a predominant concern for the right of creators to be rewarded for their efforts. At the same time, these statements seem to embrace copyright law as a central source of rights in a digital economy. The messages are, at best, mixed. The multiplicity of interests and objectives now recognized as being furthered by copyright law reflect the growing significance of copyright protection for utilitarian works, and make the act of “balancing” a much more complex and context-sensitive endeavour.³⁷

The problem of the shifting purposes of copyright law is highlighted by the *Théberge* decision. The central issue in the case was the scope of the economic rights of an artist in relation to his works of art. In this regard, Binnie J. noted that:

The proper balance among these and other public policy objectives lies not only in recognizing the creator’s rights but in giving due weight to their limited nature. In crassly economic terms it would be as inefficient to over-compensate artists and authors for the right of reproduction as it would be self-defeating to undercompensate them.³⁸

The discussion of over- and under-compensation is more straightforward in *Théberge*, where it is the scope of economic rights that is at issue rather than the copyrightability of the work itself.³⁹ In many cases dealing with utilitarian works, the issue for the courts is whether a particular kind of work falls within the definition of an “original literary, dramatic, musical and artistic work.”⁴⁰ In such cases, a decision to extend copyright protection to such works results in the creation of a monopoly lasting for the life of the author plus an additional fifty years.

35. Industry Canada, *Supporting Culture and Innovation: Report on the Provisions and Operation of the Copyright Act* (Ottawa: Industry Canada, 2002), <<http://strategis.ic.gc.ca/epic/internet/incrprda.nsf/vwGeneratedInterE/rp00863e.html>>, at Preface, i.

36. Industry Canada and Heritage Canada, *Consultation Paper on Digital Issues* (Ottawa: Intellectual Property Policy Directorate and Copyright Policy Branch, 2001), <http://strategis.ic.gc.ca/epic/internet/incrprda.nsf/vwGeneratedInterE/h_rp01102e.html>, [Consultation Paper] at 5.

37. Gordon argues that a trend toward increased protection of copyrighted works can, in part, be explained by “the gradual decline in our nation’s industrial manufacturing sectors, the dramatic growth of high-tech information industries, and the perception that our nation’s wealth is declining relative to that of other nations.” Gordon, *supra* note 2 at 156.

38. *Théberge*, *supra* note 32 at 355. This interpretive approach has since been adopted in other cases. See e.g. *Society of Composers, Authors and Music Publishers of Canada (SOCAN) v. Canadian Association of Internet Providers (Tariff 22)*, 2002 FCA 166, <<http://decisions.fct-cf.gc.ca/fct/2002/2002fca166.html>>, [2002] 4 F.C. 3, (2002), 19 C.P.R. (4th) 289, (F.C.A.) [Tariff 22 cited to C.P.R.].

39. The Court had to determine whether the right of reproduction extends to uses of a work that do not multiply the number of copies.

40. *Copyright Act*, *supra* note 28, s. 5, as defined in s. 2.

Siebrasse argues that “[T]he balancing argument for denying protection to ideas becomes stronger as the duration of protection is extended...”⁴¹ In other words, the “balancing” approach with respect to issues of copyrightability is fraught with difficulty, as the choices may well be between extreme over-compensation and extreme under-compensation. In such a context, the balancing may more appropriately be between the role of the courts and the role of legislators in extending copyright protection beyond its traditional domain.

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3. UTILITARIAN WORKS AND COPYRIGHT LEGISLATIVE HISTORY

IT WOULD BE WRONG TO SAY that copyright law has historically served only to protect artists’ and creators’ interests, or that utilitarian works were considered to be uncopyrightable until the digital age. Both the statute and case law indicate otherwise. However, the relationship between copyright law and utilitarian works has historically been an uneasy one. Reichman and Samuelson have argued that “cyclical fluctuations between states of under- and overprotection are a characteristic response to borderline subject matters that fit imperfectly within the classical patent and copyright paradigms.”⁴² Utilitarian works often fall into the category of “borderline subject matters” for copyright.

Some of the earliest “utilitarian” works protected by copyright legislation were maps, charts and plans. Originally treated as “literary works,”⁴³ these works conveyed information in a diagrammatic rather than in a strictly prose format. Maps, charts and plans were often inherently utilitarian: they existed to serve a functional purpose, with aesthetic qualities being of secondary importance.⁴⁴ The inclusion of maps, charts and plans within the definition of “literary work” in fact contributed to judicial interpretations of that category of work that favoured a broad, non-qualitative assessment. Thus, in *University of London Press Ltd. v. University Tutorial Press Ltd.*, after referring to the inclusion of “maps, charts, plans, tables, and compilations” in the definition of “literary work,” Peterson J. stated that “it seems to be plain that it is not confined to ‘literary work’ in the sense in which that phrase is applied, for instance, to Meredith’s novels and the writings of Robert Louis Stevenson.”⁴⁵

41. Norman Siebrasse, “A Property Rights Theory of the Limits of Copyright” (2001), 51 U.T.L.J. 1 at 16.

42. Jerome H. Reichman & Pamela Samuelson, “Intellectual Property Rights in Data?” (1997) 50 Vand. L. Rev. 51 at 64.

43. The *Copyright Act* was amended in 1988 to include “maps, charts and plans” under artistic, rather than literary, works. (*Copyright Amendment Act, 1988*, S.C. 1988, c. 15 (R.S.C. 1985, c. 10 (4th Supp.)), s. 1). In spite of the apparent view that such works are of a different character within the overall category of artistic works, it was nonetheless felt that they were a closer fit with artistic works than with literary works. However, their uneasy relationship to that latter category is also illustrated by the exclusion of these works from the exhibition right provided to “artistic works” in the same revision of the *Copyright Act*. In the parliamentary debates and committee hearings relating to the exclusion of maps, charts and plans from the exhibition right for artistic works, it was explained, among other things, that: “The intent behind the exhibition right was to benefit artists of fine works of art—painting and sculptures—where there is a curated show to which the public is invited, so that a fee for that exhibition would in fact flow to artists of that nature. However, it was not intended that cartographers, for example, the people who draw maps, benefit from that kind of a right.” Canada, Parliament, *Minutes of Proceedings and Evidence of the Legislative Committee on Bill C-60*, 32d Parliament, 2nd Session (December 10, 1987) at 1230.

44. Of course, some maps could be considered works of art (in the qualitative sense) as well.

45. [1916] 2 Ch. 60 at 608, (1916), 86 L.J.Ch. 107 [*University of London Press* cited to Ch.].

Most likely, the inclusion of maps, charts and plans in the category of “literary works” was largely due to the fact that these instruments were considered to exist in order to convey information or instruction rather than to serve an artistic function. They were thus arguably closer in nature to an instruction book than to a work of art, and were also more likely to be found in books or on desktops than on gallery walls. However, the relationship of charts and plans in particular to three-dimensional objects that might be constructed from them did pose problems for copyright law. Through this avenue, courts demonstrated that they were amenable to interpretations of the legislation that offered protection to works of practical, industrial or commercial orientation. Not only were charts and plans protected by the *Copyright Act*, but three-dimensional objects created from those charts, plans or drawings could also be protected under copyright law. Thus, functional items such as boat hulls,⁴⁶ office desk drawers⁴⁷ and even automobile parts⁴⁸ might qualify for copyright protection. The problematic interpretations of copyright in these areas underlined some of the tensions that exist between the extensive protection offered under copyright legislation and the realities of commercial and industrial production and competition.

Concerns about the role of the *Copyright Act* in relation to industrial production led to various attempts to carve out a relationship between copyright and industrial design that recently culminated in the reworking of the *Industrial Design Act*⁴⁹ and of the *Copyright Act* in 1988.⁵⁰ In the debates leading up to the amendments, the Honourable Flora MacDonald noted:

...designers of utilitarian objects which ought to be covered by the *Industrial Design Act* have been found potentially eligible for full copyright protection by recent judicial decisions. The uncertainty created by these decisions has created a pressing need to clarify the present wording of the law.⁵¹

She went on to express the view that “[t]he *Copyright Act* should not be transformed into a kind of catch-all legislation protecting works for which copyright is

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46. *Bayliner Marine Corp. v. Doral Boats Ltd.* (1985), 5 C.I.P.R. 268, (1985), 5 C.P.R. (3d) 289 (F.C.T.D.) [*Bayliner (F.C.T.D.)* cited to C.P.R.], rev'd on other grounds [1986] 3 F.C. 421, (1986), 10 C.P.R. (3d) 289 (F.C.A.) [*Bayliner (F.C.A.)* cited to C.P.R.], leave to appeal to S.C.C. denied (1986), 14 C.P.R. (3d) 446.
47. *L.B. (Plastics) Ltd. v. Swish Products Ltd.*, [1979] R.P.C. 551, [1979] F.S.R. 145 (H.L.) [*L.B. Plastics*].
48. *British Leyland Motor Corp. Ltd. and another v. Armstrong Patents Co. Ltd. and another*, [1986] A.C. 577, [1986] 1 All E.R. 850 (H.L.) [*British Leyland* cited to A.C.].
49. R.S.C. 1985, c. I-9, <<http://laws.justice.gc.ca/en/I-9/text.html>>. Although this was the first industrial design act titled as such, Muhlstein and Wilkinson note that there were legislative precursors to the *Industrial Design Act*, especially with respect to textile designs. See their account of the history of industrial-design legislation in Canada in Amy Muhlstein & Margaret Ann Wilkinson, “Whither Industrial Design” (1999) 14 I.P.J. 1 at 8-15.
50. *Copyright Amendment Act, 1988*, *supra* note 43, subsequently amended by the *North American Free Trade Implementation Act, 1993*, S.C. 1993, c. 44, s. 68 and by the *Copyright Amendment Act, 1997*, S.C. 1997, c. 24, ss. 39–40. According to s. 64 of the *Copyright Act*, *supra* note 28, copyright and moral rights do not apply to designs applied to useful articles produced in quantities of more than fifty, or to plates, engravings or casts used for producing more than fifty useful articles (ss. 64(2)(a) and (b)). A “useful article” is defined as “an article that has a utilitarian function” (s. 64(1)). The effect of these provisions is that, even though there may otherwise be a copyright in the designs, the scope of the monopoly right is limited because of the use made of the design. Muhlstein and Wilkinson express the view that the 1988 amendments to the *Copyright Act* were “an attempt to completely sever design protection from copyright protection.” (Muhlstein & Wilkinson, *supra* note 49 at 24).
51. *House of Commons Debates*, Volume VI, 1987 (June 26, 1987) at 7669 (Hon. Flora MacDonald).

not appropriate."⁵² In canvassing the history of industrial design legislation, Muhlstein and Wilkinson noted the tension between the treatment of industrial works and that of works of the creative arts: "It was considered appropriate to treat artistic works applied to products produced in certain industries separately from other works which enjoyed full copyright protection."⁵³ In their view, design laws

...evolved from copyright as an exception for artistic designs applied to specific classes of industrial goods, or goods within particular industries. The designs applied to these goods were thought to require some form of protection, but not of the same strength as copyright.⁵⁴

The scope of protection offered under copyright law was thus considered to be too extensive for designs used in industrial contexts. It was not that legislators felt that there should be no protection from copying in these contexts; rather, the protection should be of a less extensive nature. Furthermore, under the *Industrial Design Act*, the onus was placed on the owner of the industrial design to register the design in order to receive protection; this, in turn, expanded the scope of the public domain in relation to industrial designs.⁵⁵

In spite of the inclusion of maps, charts and plans within the definition of literary work and notwithstanding the rather expansive judicial interpretations, there were other aspects of the *Copyright Act* that suggested that utilitarian or purely functional objects were not intended to fall within the scope of the legislation. For example, the inclusion of "works of artistic craftsmanship" within the definition of "artistic works" suggests a qualitative barrier to the inclusion of otherwise functional three-dimensional objects within the *Copyright Act*. In *George Hensher Ltd. v. Restawile Upholstery (Lancs.) Ltd.*,⁵⁶ the House of Lords struggled with the definition of a work of "artistic craftsmanship." The majority of the panel was of the view that such a work, though it might have functional utility (such as a piece of furniture), would nonetheless also have the "added character of being artistic"⁵⁷; the implication was that a work which had functional utility but which was lacking in "artistic quality" would not qualify for copyright protection. Furthermore, until fairly recently a building had to be an "architectural work of art" in order to receive protection under the *Copyright Act*.⁵⁸ Buildings that were purely functional, or mundane, were excluded from protection.⁵⁹ The distinction

52. *Ibid.*

53. Muhlstein & Wilkinson, *supra* note 49 at 9-10.

54. *Ibid.* at 12. It is interesting to note that at the time of the enactment of the early precursors to the *Industrial Design Act*, three-dimensional objects were the more tangible primary objects of commerce in an industrial society.

55. The interface between the *Industrial Design Act* and the *Copyright Act* does not obliterate copyright in the design; rather, it limits a finding of infringement where the design elements are part of a utilitarian or functional object.

56. *George Hensher Ltd. v. Restawile Upholstery (Lancs.) Ltd.* (1974), [1976] A.C. 64, [1974] 2 All E.R. 420 (H.L.) [*George Hensher* cited to All E.R.]

57. *Ibid.* at 425, Lord Morris of Borth-Y-Gest.

58. The *North American Free Trade Agreement Implementation Act*, S.C. 1993, c. 44 [*NAFTA Implementation Act*], changed "architectural work of art" to "architectural work." <<http://laws.justice.gc.ca/en/n-23.8/86212.html>>.

59. Prior to 1988, an "architectural work of art" was protected only with respect to its "artistic character and design" (s. 2(a) of the *Copyright Act*, 1921, S.C. 11-12 Geo. V, c. 24). This requirement was removed by the *Copyright Amendment Act*, 1988, *supra* note 43.

was not purely one of the “originality” of the expression of the building; an “architectural work of art” was held to have some inherent aesthetic qualities.⁶⁰

More recently, the *Copyright Act* has been amended to reflect developments that have arisen, *inter alia*, from judicial interpretation of the Act and from international agreements. “Architectural works” are now included within purview of the Act without the requirement of a qualitative assessment.⁶¹ Computer software has formally been included in the category of “literary work,”⁶² and the definition of a “compilation” has been clarified to include compilations of fact made original by virtue of the “selection and arrangement of data.”⁶³ These changes appear to suggest a consensus that the *Copyright Act* is the appropriate vehicle for protecting such works; on the other hand, at least in the context of software and of compilations of fact, it may simply reflect the lack of another more suitable legislative framework.⁶⁴

The increasing importance of utilitarian works, such as “information products,” as objects of commerce in an information economy has already created tensions with respect to the interpretation of copyright legislation. The history of the treatment of utilitarian works under copyright law in Canada makes it clear that Parliament has played a significant role in confining and constraining the scope of copyright protection for these works. In the case of information products, it is interesting that it has largely been the activity of the courts that has expanded the scope of copyright protection.

★

4. THE ORIGINALITY THRESHOLD

AS NOTED ABOVE, it has sometimes been through judicial interpretation that copyright protection has been extended to utilitarian works. This expansiveness is perhaps best reflected in cases that interpret the category of “literary work,” which has historically been treated as one of the broadest copyright categories. In the classic case of *University of London Press*, the court rejected a qualitative approach to interpreting the category. According to Peterson J.,

60. *Ibid.* See e.g. *Hay v. Sloan* (1957), 12 D.L.R. (2d) 397, (1957), 27 C.P.R. 132 (Ont. H.C.) [*Hay* cited to C.P.R.]. See also *Lifestyle Homes Ltd. v. Randall Homes Ltd.* (1991), 70 Man.R. (2d) 124, (1991), 34 C.P.R. (3d) 505 (Man. C.A.) [*Lifestyle Homes* cited to C.P.R.].

61. *Copyright Act*, *supra* note 28, s. 2, definitions of “artistic work” and “architectural work.”

62. Although the amendment made clear the legislative intent, the Supreme Court of Canada in *Apple Computer*, *supra* note 4, confirmed that software fell within the category of “literary work” as a matter of interpretation.

63. This amendment may reflect an attempt to narrow, rather than to expand, the reach of copyright law with respect to compilations of data by placing the emphasis on the originality of the selection and the arrangement. Significantly, recent Canadian court decisions could render irrelevant the distinction between a selection and arrangement of data on the one hand and the data themselves on the other hand. See Weetman, *supra* note 12, and *B & S Publications*, *supra* note 12, discussed *infra*.

64. The European approach, as set out in the *European Database Directive*, *supra* note 26, is to create a *sui generis* right for the protection of data in data compilations. At least one Canadian commentator supports a similar approach in Canada on the basis that copyright law is no longer an effective solution. See Graham A. Knight, “The Fall and Rise of Sweat of the Brow” (1998–99), 13 I.P.J. 337. Gordon argues that “As the economic hopes of a less confident, service-oriented economy have become increasingly dependent on the nation’s intangible assets, legislatures and courts seem willing to extend intellectual-property protections on the questionable, and surely often unconscious, assumption that protection means prosperity.” Gordon, *supra* note 2 at 156–57.

...the words "literary work" cover work which is expressed in print or writing, irrespective of the question whether the quality or style is high. The word "literary" seems to be used in a sense somewhat similar to the use of the word "literature" in political or electioneering literature and refers to written or printed matter.⁶⁵

In discussing the possibility of a sleeve chart used in dressmaking qualifying as a literary work in *Hollingrake v. Truswell*,⁶⁶ the court indicated that a literary work should give "information and instruction, or pleasure in the form of literary enjoyment."⁶⁷ The bar for printed matter to qualify as a "literary work" was set fairly low.

Clearly, if any printed matter were to qualify for copyright protection, the scope of copyright would be extremely broad. Courts were unwilling to offer such a seemingly limitless scope of protection. They focused on "originality" as a basis for distinguishing works in which copyright could subsist. In particular, courts distinguished original works from mere ideas; it was the author's original expression of facts or ideas that would be protected, not the underlying ideas.⁶⁸ However, it soon became clear that it was not always easy to distinguish between an idea and its expression. In the leading case of *Baker v. Selden*,⁶⁹ the United States Supreme Court attempted to articulate the point at which expression merged with an idea so as to become inseparable from the idea.

At issue in *Baker v. Selden* was the scope of copyright protection for a book setting out in detail a system of book-keeping. The Court acknowledged that the book itself could be protected by copyright, but that the underlying ideas expressed in the book were not a part of the monopoly. The book contained a series of illustrations and diagrams for use in conjunction with the book-keeping system described in the work; given the fact that the expression of the system through these ledger pages had merged with the underlying idea, the Court concluded that "the mere copyright of Selden's book did not confer upon him the exclusive right to make and use account-books, ruled and arranged as designated by him and described and illustrated in said book."⁷⁰

The doctrine of merger, or at least an analogous concept, is also present in common law jurisdictions outside of the United States. In *Kenrick & Co. v. Lawrence & Co.*,⁷¹ for example, a British court accepted only a very limited scope to the copyright over the drawing of a hand making a check-mark in a box. The drawing had been provided as a pictorial instruction of how to vote for those with limited or non-existent literacy skills. In that case, the court noted that "the mere choice of subject can rarely, if ever, confer upon the author of the drawing

65. *University of London Press*, *supra* note 45 at 608.

66. [1894] 3 Ch. 420 [*Hollingrake*]. This case is dealt with under the category of "literary works" because of the inclusion of "maps, charts and plans" within that category at that time.

67. *Ibid.* at 428, Davey L.J.

68. *Moreau v. St. Vincent*, [1950] Ex. C.R. 198 at 203, (1950), 12 C.P.R. 32 (Ex. Ct.) [*Moreau* cited to Ex. C.R.], where the court said: "It is, I think, an elementary principle of copyright law that an author has no copyright in ideas but only in his expression of them."

69. *Baker v. Selden*, 101 U.S. 99 (1879).

70. *Ibid.* at 107.

71. (1890), 25 Q.B.D. 99 [*Kenrick*].

an exclusive right to represent the subject.”⁷² Since, in the court’s view, the depiction of how to vote could really only be expressed in a very limited number of ways, any copyright protection in the drawing would be limited to the precise depiction made or “in which the variations from such a minute agreement shall be microscopic.”⁷³ To give broader copyright protection would essentially be to grant a monopoly over the idea being expressed as opposed to the expression itself. Courts in Canada have accepted the underlying principle in the idea/expression dichotomy. In *Delrina Corp. v. Triolet Systems Inc.*,⁷⁴ the Ontario Court of Appeal noted:

The merger notion is a natural corollary of the idea/expression distinction which, as I have said, is fundamental in copyright law in Canada, England and the United States. Clearly, if there is only one or a very limited number of ways to achieve a particular result in a computer program, to hold that that way or ways are protectable by copyright could give the copyright holder a monopoly on the idea or function itself.⁷⁵

To grant such a monopoly would be counter to public policy, as copyright seeks to promote a diversity of original expression, rather than to restrict the expression of particular ideas or concepts. It is significant that merger cases almost invariably relate to utilitarian works, because in such cases the concept expressed in the work is usually of greater value to the creator than its expression.

The other main principle at play in relation to originality is the principle that there can be no copyright in facts. In the view of the United States Supreme Court, originality cannot reside in facts, as facts are copied from the world around us.⁷⁶ While originality may reside in the selection or arrangement of facts, the underlying facts are, in theory at least, not covered by the copyright in the selection and arrangement.⁷⁷ The principle that there can be no copyright in facts has been stated most vigorously in the United States. In Canada and in other common law jurisdictions, such as the U.K. and Australia, there is a view that a sufficient expenditure of labour can create a property interest in facts. Yet the

72. *Ibid.* at 102.

73. *Ibid.*

74. (1993), 9 B.L.R. (2d) 140, (1993), 47 C.P.R. (3d) 1, aff’d (2002), 58 O.R. (3d) 339, (2002), 17 C.P.R. (4th) 289 (Ont. C.A.) [*Delrina* (Ont. C.A.) cited to O.R.].

75. *Ibid.* at 353.

76. *Feist*, *supra* note 13 at 347.

77. For example, Article 1705 of the *North American Free Trade Agreement Between the Government of Canada, the Government of Mexico and the Government of the United States*, December 17, 1992, Can. T.S. 1994 No. 2, 32 I.L.M. 289 (entered into force January 1, 1994), <<http://www.sice.oas.org/trade/nafta/naftatce.asp>> [NAFTA] states that “compilations of data or other material, whether in machine readable or other form, which by reason of the selection or arrangement of their contents constitute intellectual creations” can be protected under copyright, but that such copyright “shall not extend to the data or material itself.” A similar provision is contained in Article 5 of the *WIPO Copyright Treaty*, December 20, 1996, <<http://www.wipo.int/clea/docs/en/wo/wo033en.htm>>.

Canadian *Copyright Act* seems to indicate, at least indirectly, that copyright does not extend to facts.⁷⁸

Because the value of many utilitarian works—and, in particular, of information products—tends to reside either in the concept behind them or in the aggregate of factual or non-original material of which they are comprised, it is not surprising that disputes over copyright in these works have proven controversial. In Canada, recent case law demonstrates both uncertainty and incoherence with respect to the use of copyright to protect such works. It is clear, however, that decisions that exert pressure on the boundaries of originality also exert pressure on the fundamental principles of copyright law. The undermining of the idea/expression and fact/expression dichotomies is more than just an “interpretive” exercise; it is one with the potential to alter the scope of copyright as effectively and as dramatically as a legislative amendment.

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5. ORIGINALITY AND “SWEAT OF THE BROW”

THE “SWEAT OF THE BROW” DOCTRINE, which directly undermines the fact/expression dichotomy, emerged in U.K., U.S. and Canadian case law as a basis for finding the requisite originality in works that are of a mundane, commercial and often essentially factual nature. The issue became whether copyright law could protect something that reflected minimal creativity, yet which also required an investment of time and labour in order to create it. The doctrine of the “sweat of the brow” acknowledged the labour that went into the creation of certain types of works. It clearly emerged in the context of cases in which there was a strong sense that something of value had been taken from the creator of a non-traditional copyrighted work.⁷⁹ Reviewing the evolution of the “sweat of the brow” doctrine in U.S. case law, the United States Supreme Court in its landmark 1991 decision in *Feist* noted that the “underlying notion was that copyright was a reward for the hard work that went into compiling facts.”⁸⁰ Furthermore, in *Feist* the Court rejected “sweat of the brow” as a basis for a finding of originality. With respect to compilations of facts, the Court emphasized the need to find originality in the selection and arrangement of the facts, and opined that a “creative spark” would be required to distinguish a routine selection and arrangement from one in which copyright resided.⁸¹

The doctrine of “sweat of the brow” reflects a view of copyright that recognizes an entitlement to a copyright monopoly on the basis of the hard work or

78. Section 2 (definition of “compilation”) of the *Copyright Act*, *supra* note 28, as amended by S.C. 1993, c. 44, s. 53. The principle is stated somewhat indirectly in *CCH*. In his analysis of copyright in reported decisions, Linden J.A. said: “The publishers do not monopolize information in the sense that they can preclude others from independently producing similar materials; they merely acquire the right to preclude others from copying their works.” *CCH*, *supra* note 10 at 263. This statement can be compared with that of the United States Supreme Court in *Feist*, *supra* note 13 at 349, where O’Connor J. wrote that “copyright in a factual compilation is thin.”

79. See e.g. *Kelly v. Morris* (1866), L.R. 1 Eq. 697 (Ch.) where the court protected a compilation of facts and information in the form of a post-office directory.

80. *Feist*, *supra* note 13 at 352.

81. *Ibid.* at 359.

effort required to create the work at issue. The rationale for the doctrine is expressed in *University of London Press*, which involved the copying of exams, where the court fashioned what it deemed to be the rough test that “what is worth copying is *prima facie* worth protecting.”⁸² This oft-quoted phrase expresses a significant dimension of the development of modern copyright law. Rather than focus on defining a “work” in terms of certain inherent qualities, this phrase suggests that a “work” can be defined in terms of its commercial value. If it is worth someone’s while to copy something, then that thing has an inherent value that is deserving of protection. This “inherent value” may well be purely commercial. This notion of protecting the value of a work in which labour has been invested is at the root of the “sweat of the brow” doctrine.

The 1996 decision of the Federal Court of Appeal in *Tele-Direct* offered the first opportunity for that court to consider the post-*Feist* Canadian position with respect to copyright in factual compilations. Prior to *Tele-Direct*, Canadian case law suggested that the “sweat of the brow” approach was viable in Canada. In fact, in Canada the phrase “skill, judgment or labour” as a basis for assessing originality had already emerged in the context of cases dealing with utilitarian works. In *Slumber-Magic*,⁸³ the British Columbia Supreme Court dealt with a case involving an allegation of copyright infringement where the defendant had copied an advertising brochure that was created by the plaintiff. The defendant challenged the plaintiff’s claim of copyright in the brochure, arguing that it used “ideas and elements” also found in competitors’ brochures. McLachlin J. (as she then was) held that “compilations of material produced by others may be protected by copyright, provided that the arrangement of the elements taken from other sources is the product of the plaintiff’s thought, selection and work.”⁸⁴ She further stated that:

The basis of copyright is the originality of the work in question. So long as work, taste and discretion have entered into the composition, that originality is established. In the case of a compilation, the originality requisite to copyright is a matter of degree depending on the amount of *skill, judgment or labour* that has been involved in making the compilation.⁸⁵

Significantly, the phrase “skill, judgment or labour” carries echoes of the discussion in *INS*, where the Court rejected a finding of copyright in information “gathered at the cost of enterprise, organization, skill, labor, and money.”⁸⁶ Although McLachlin J. refers to “skill, judgment or labour” as the test for originality, the decision clearly finds copyright in the originality of the selection and arrangement—that is, the “composition”—of more routine materials, as opposed to copyright in the routine materials themselves.

By contrast, in *B.C. Jockey Club*,⁸⁷ the British Columbia Court of Appeal dealt with a case involving competing publications aimed at those who followed

82. *University of London Press*, *supra* note 45 at 610.

83. *Supra* note 7.

84. *Ibid.* at 84.

85. *Ibid.* [Emphasis added].

86. *INS*, *supra* note 1 at 236.

87. *Supra* note 5.

horse racing. The plaintiff's publication contained a great deal of factual information relating to the particular races to be run, including their dates and times, the purses, the horses competing, the jockeys, the weather and track conditions, and so on. The defendant's publication reproduced a great deal of this information, but provided it in a substantially different format, and with additional original content. The case is similar in many respects to *INS* in that in both cases there were two competing publications reporting factual information, albeit in different formats. The Court of Appeal upheld the decision of the trial judge, who had found copyright infringement on the basis that "the defendant has made a substantial use of all the essential facts compiled by the Club."⁸⁸ In particular, the trial judge had ruled:

Although he adopted that information to his own style and added information of his own, the defendant nevertheless appropriated a substantial amount of the work, skill, judgment and knowledge of the Club. *The copyright of the Club does not reside solely in the order of the information which it has compiled.* Although the defendant has rearranged and republished that information in a different style, *he nevertheless continued to appropriate a substantial part of the Club's original work.*⁸⁹

If there is a fine line between protecting the original work in which copyright subsists and protecting a plaintiff's expenses and efforts in creating the work, this case would appear to cross it. In contrast to the approach of the Court of Appeal in *B.C. Jockey Club*, the United States Supreme Court in *INS* rejected a finding of copyright infringement, notwithstanding the fact that "the acquisition and transmission of news require elaborate organization and a large expenditure of money, skill, and effort."⁹⁰ However, Canadian courts did not appear interested in the issues and concerns raised in *INS*. In *U & R Tax Services*,⁹¹ Richard J. of the Federal Court Trial Division went so far as to state that "[i]ndustriousness ('sweat of the brow') as opposed to creativity is enough to give a work sufficient originality to make it copyrightable."⁹² He cited *B.C. Jockey Club* with approval, stating that "[i]n *British Columbia Jockey Club v. Standen* (1985) [citation omitted], copyright in a form, which amounted to protecting facts included in a compilation, was held to subsist where *those facts were the result of independent research and labour.*"⁹³

The reference to "skill, judgment or labour" from *Slumber-Magic*, and its reiteration in *B.C. Jockey Club* as "work, skill, judgment and knowledge," left the door open to the possibility that labour alone could give a work sufficient originality for it to be protected by copyright. This position was rejected in *Tele-Direct*, where Décaré J.A. took the view that, in McLachlin J.'s reference to "skill, judgment or labour" in *Slumber-Magic*, the word "or" should be read in its con-

88. *Ibid.* at 286.

89. Cited with approval by the B.C.C.A. in *ibid.* [Emphasis added].

90. *INS*, *supra* note 1 at 238.

91. *Supra* note 6.

92. *Ibid.* at 264.

93. *Ibid.* [Emphasis added].

unctive sense.⁹⁴ The court in *Tele-Direct*, a case which involved the use of information contained in yellow-pages listings by a competing business, attempted to draw a line between non-copyrightable facts and the copyright that could subsist in any original selection or arrangement of such facts. In doing so, Décaré J.A. borrowed language from the *Feist* decision, and referred to “creativity”⁹⁵ and the “creative element”⁹⁶ that could separate an original selection or arrangement of data from one that is merely routine. No doubt Décaré J.A. was attempting to separate skill, judgment and labour *qua* hard work from that kind that could give rise to originality for the purpose of copyright. The reference to “creativity” was a means of signaling that something more than hard work was required. Yet the case engendered debate as to whether the court had caused a significant shift in the Canadian standard, and many commentators were critical of what they perceived to be a shift to a more qualitative assessment of originality.⁹⁷ Indeed, the Canadian Federal Court of Appeal reached a different result from that of the Australian Federal Court in *Telstra Corporation Ltd. v. Desktop Marketing Systems Pty. Ltd.*,⁹⁸ where a purely “sweat of the brow” approach was adopted by the court in order to find that copyright subsisted in the telephone directories at issue in that case.⁹⁹

The *Tele-Direct* decision was followed by another case before the Federal Court of Appeal dealing with originality in a utilitarian work. The decision in *Édutile*¹⁰⁰ contributed greatly to the uncertainty surrounding the court’s approach to originality. The decision in *Édutile* amounts to nothing short of the protection of an idea as opposed to its expression. The case involved two rival publishers of used-car price guides for consumers. Although such guides had typically featured columns containing information about the trade-in value of such cars and their retail value, the plaintiff had come up with the idea of including a third column listing the private-sale value of the vehicles. Décaré J.A., who had written the decision of the court in *Tele-Direct*, made a number of startling statements concerning the protection of the plaintiff’s guide. For example, he

94. *Tele-Direct* (F.C.A.), *supra* note 3 at 37.

95. *Ibid.* at 37 and 41.

96. *Ibid.* at 39.

97. In *Hager v. ECW Press Ltd.* (1998), [1999] 2 F.C. 287, (1998), <<http://reports.fja.gc.ca/fc/1999/pub/v2/1999fc23716.html>>, 85 C.P.R. (3d) 289 at 307 (F.C.T.D.) [*Hager* cited to C.P.R.], Reed J. rejected the view that *Tele-Direct* had turned Canadian law on originality away from its “previous alignment with the law of the United Kingdom towards an alignment with that of the United States.” The Federal Court of Appeal in *CCH*, *supra* note 10 at 252, also rejected what it called the “American threshold for copyright protection.”

98. [2001] FCA 612, <http://www.austlii.edu.au/au/cases/cth/federal_ct/2001/612.html>, (2001), 181 A.L.R. 134 (Aust. F.C.) [*Telstra Corporation*].

99. The fact that the leading cases on originality in Canada, Australia and the United States all deal with telephone directories is problematic. Given the nature of the business of telephone service providers, the collection of the information in telephone directories occurs as a by-product of the companies’ main business operations. Given the monopoly position of most telephone service providers, these providers are at an enormous advantage when it comes to the ability to collect and compile this data. To require competitors in the provision of telephone directories or other such products to go out and independently collect this information is to require of them an effort not required by the original service provider in the creation of its directory. The telephone-directory cases are thus complicated by the fact that the collection of the data in the plaintiff’s directories requires relatively little skill or labour, and by the fact that to grant copyright further enhances the monopoly position of the providers. These cases provide difficult facts on which to establish a standard of originality for factual compilations.

100. *Supra* note 11.

found persuasive the testimony of the defendant's president wherein he admitted that "the extent to which the idea embodied in the *Édutile* guides was original."¹⁰¹ Décarry J.A. accepted that "[t]he fact of setting out the 'Private Sale' market and the 'Retail Value' market side by side in columns was a 'brilliant' [and] 'innovative' move."¹⁰² He then went on to note: "It is not easy in compilation situations to draw a line between what signifies a minimal degree of skill, judgment and labour and what indicates no creative element."¹⁰³ He found that the plaintiff's copyright existed by virtue of the fact that "*Édutile* organized its information according to unpublished standards of selection for the first time in Quebec and in Canada."¹⁰⁴ In effect, the court granted *Édutile* copyright in the idea of adding a third column containing retail-price information. This is further underlined by the fact that the actual price information in the defendant's guide was not copied from the plaintiff's book.¹⁰⁵ The decision in *Édutile* is bizarre in that it follows on *Tele-Direct*, which appeared to adopt the *Feist* approach to originality. This approach offers protection to original expression, but not to facts, ideas or labour alone. In *Édutile*, the court struggled to come to terms with two competing utilitarian works in which that which constituted the plaintiff's "competitive edge"—the unique value of his work—was essentially an original, or "creative," concept.

Given the reasoning and the result in *Édutile*, it is perhaps not surprising that the Federal Court of Appeal took such pains to distance itself from the references to "creativity" and "creative spark" in *Tele-Direct*. In its subsequent decision in *CCH*, the majority of the Federal Court of Appeal sought to alter the impact of the decision in *Tele-Direct* by rephrasing the court's approach to originality. In *CCH*, the court was not dealing with pure compilations of fact; the matters at issue included case head notes and compilations of material in which Crown copyright subsisted, such as case reporters and topical indices. Although *Tele-Direct* contained several references to creativity in relation to assessing the originality of a composition of fact, the court in *CCH* took the view that *Tele-Direct* did not find creativity to be necessary in order for originality to subsist.¹⁰⁶ Rather, what was required was an expenditure of "skill, judgment and labour" in the creation of the compilation. The individual components of skill, judgment and labour are, in the words of Linden J.A., "all possible ingredients in the recipe for originality, which may be altered to suit the flavour of the work at issue."¹⁰⁷ Linden J.A. went on to add that these elements are not "prerequisites to copyright protection, but rather evidence of the sole prerequisite, originality."¹⁰⁸ Although returning to a standard that included the problematic reference to "labour," Linden J.A. dismissed any concerns and emphasized that "the crucial requirement for a finding of originality is that the work be more than a mere

101. *Ibid.* at 203.

102. *Ibid.* at 205.

103. *Ibid.*

104. *Ibid.*

105. *Ibid.* at 206.

106. *CCH*, *supra* note 10 at 251–52.

107. *Ibid.* at 255.

108. *Ibid.*

copy.”¹⁰⁹ He thus attempted to distinguish between the rote labour of a copyist, which would not give rise to originality, and the labour involved in creating a work that involved some exercise of skill and judgment.¹¹⁰

The distinctions among types of labour are not particularly helpful as they take us back to the starting point of an original work being one that has not been copied,¹¹¹ without giving much assistance as to the nature of the “skill and judgment” required in order to find originality. Essentially what is required is hard work that creates something that did not previously exist in that form, as opposed to hard work that produces a copy of someone else’s work. This formulation, however, does not assist much in dealing with the copying of utilitarian or fact-based works, as it does not make a sensible distinction between the skill or labour that goes into the organization of a collection of facts and the underlying facts themselves. Indeed, Linden J.A. makes the following statement regarding compilations of facts: “Because the selection and arrangement of the underlying elements, not the elements themselves, must be original, a compiler must demonstrate something more than merely copying those elements into a new work before the Act will award copyright protection.”¹¹² The statement leaves unclear whether, in the view of the court, the copyright would then attach only to the original selection or arrangement, or to the work as a whole, which is made original by virtue of the selection and arrangement. Thus, in *CCH* the Court might accept the result in *B.C. Jockey Club* on the basis that “skill and judgment” went into the selection and arrangement of the information in the plaintiff’s news-sheet. However, the problem in *B.C. Jockey Club* is that once the underlying data has been extracted and arranged in a different format there should, in theory at least, be no copyright infringement, since the copyright lies in the skill and judgment involved in the *selection and arrangement* of the data. It is not clear from *CCH* what the Federal Court of Appeal would do with the set of facts in *B.C. Jockey Club*. It does seem clear, however, that the standard is open to the interpretation that the existence of the facts, or, more problematically, their existence in one convenient location, is the result of the “skill, judgment and labour” of the plaintiff and that, therefore, there is a copyright over the “selection” of those facts which effectively amounts to a copyright over the facts themselves.

The *CCH* case also reveals problems with the court’s approach to originality in its analysis of copyright in headnotes. The application of the test of “skill, judgment and labour” to headnotes indicates the difficulties with this test, both in relation to giving copyright in ideas and in relation to copyright in facts. A headnote must be a concise and precise summary of the decision of the court in a given case. Arguably, one of the ways in which such information could be conveyed might be through a blunt abridgement which copies key passages. The Federal Court of Appeal did find that headnotes are copyrightable. However, the court made this finding more on the basis of the skill, judgment or labour expended in the creation of headnotes *generally* than on the relationship

109. *Ibid.*

110. *Ibid.* at 255-56.

111. *University of London Press*, *supra* note 45 at 609.

112. *CCH*, *supra* note 10 at 256.

between the expression of the particular headnotes at issue and the court opinions on which they were based. A headnote is meant to be a concise summary of another written text in which the author of the headnote does not have copyright. Presumably there is much less latitude available to the headnote writer than there is available to a journalist, both in terms of the choice of what to report and in terms of the manner in which it can be reported. In *CCH* the court avoided discussing the possibility of a merger of expression and idea by focusing on the effort required to produce an accurate headnote and by not looking at the particular headnotes at issue. Linden J.A. appeared to treat headnotes as a particular kind of literary work, rather than to deal with them on a case-by-case basis to determine whether they are sufficiently original. For example, he extolled the virtue of past Canadian headnotes "authored by some of the greatest legal minds in our country," arguing that headnotes "are obviously more than simply abridged copies of the reasons for judgment."¹¹³ On the other hand, Linden J.A. treated the headnotes not so much as an expression of facts or ideas contained in the judgment; rather, "the headnote summarizes reasons for judgment so that a reader can decide whether or not it is necessary to actually consult those reasons."¹¹⁴ In other words, Linden J.A. seemed to find originality in the fact that headnotes serve a function that is distinct from that of a judgment.¹¹⁵ He also ignored the possibility that some headnotes are in effect nothing more than blunt abridgements of the decisions to which they are attached.

The uncertainty over the standard of originality for utilitarian works means that in Canada there is currently great latitude and uncertainty with respect to the scope of protection for utilitarian works—and, in particular, for information products. Ironically, while the Federal Court of Appeal was struggling with "skill, judgment and labour" as a basis for copyright protection of, *inter alia*, headnotes, the Ontario Court of Appeal in *Delrina*¹¹⁶ accepted that there could be no copyright in ideas¹¹⁷ or in public-domain materials;¹¹⁸ the Ontario Court of Appeal thus approved an approach to copyright in software that would require the filtering out of non-original material from the scope of any copyright over the software itself, regardless of the skill, judgment and labour that went into the creation of the software as a whole. In contrast, in two recent cases, courts have gone so far as to extend a copyright monopoly over facts, and have done so bluntly. In *B & S Publications*, the court considered this issue with respect to facts in the "Oil and Gas Index," which had been collected and compiled through the efforts of the plaintiff. The index contained listings of explorers and producers in the oil and gas industry, along with additional information. The court found that the defendant's copying of the data violated the plaintiff's copyright, not in the selection and arrangement of the data, but in the data itself.

113. *Supra* note 10 at 262–63.

114. *Ibid.* at 264.

115. These judges are perhaps blissfully ignorant of the fact that, for many law students, headnotes serve as a substitute for the judgment itself.

116. *Supra* note 74.

117. *Ibid.* at 348–49.

118. See the Court of Appeal's acceptance of the trial judge's filtering out of a range of public-domain material. *Ibid.* at 353–55.

Hutchison J. noted:

...I am of the opinion that the data relating to the exploration and production companies as researched and presented by the plaintiff is capable of and by itself of being copyrighted, owing in part to the criteria used to select the names by the plaintiff, the research done on its currency and accuracy, and its categorization.¹¹⁹

Effectively, therefore, the court found the plaintiff to be the “author” of the underlying facts themselves.

In *Weetman*,¹²⁰ Romilly J. of the British Columbia Provincial Court (Small Claims Division) dealt with a case of alleged copyright infringement involving maps. The defendant had argued, *inter alia*, that the copying of some features from the plaintiff’s map could not infringe copyright because the features, which represented characteristics of the landscape, amounted to facts. Romilly J. rejected this argument, noting that:

The state of Canadian law on the subject is that it is not open for someone to argue that trails, roads and other features detailed with a precision and an accuracy not previously attained by other mapmakers of the region in question, which was facilitated by a particular process pioneered by a mapmaker, become a compilation of facts which everyone can copy and/or use without the consent of the mapmaker because it has somehow been placed in the “public domain”...¹²¹

He concluded that, in contrast to U.S. law, Canadian law would protect “facts which contain a certain level of creativity.”¹²² In his view, the innovative techniques used by the plaintiff to arrive at the geographical data incorporated into his map produced the required originality for copyright to subsist in the resultant map and in its specific features. Nevertheless, it is difficult to characterize the precise location of a trail as a “creative” fact.

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6. CONCLUSION

LIKE OTHER CASES OF THEIR KIND, *Weetman* and *B & S Publications* involved elements of what was perceived by the court to be unfair competition. Indeed, the difficulty of distinguishing between unprotectable fact and protectable expression in the context of competing works is partly what the United States Supreme Court was up against in the classic case of *INS*. Clearly, concerns with unfair competition have influenced results in cases such as these, and may go a long way to explaining the “sweat of the brow” line of cases.

If a case analogous to *INS* were to arise in Canada today, the plaintiff news agency might well succeed with an argument that the presence of the fac-

119. *B & S Publications*, *supra* note 12 at para. 44. Hutchison J. found that the design layout and format of the work were also independently “original and unique” and were thus copyrightable.

120. *Weetman*, *supra* note 12.

121. *Ibid.* at para 45.

122. *Ibid.* at para 46.

tual material in their news reports was the result of their "skill, judgment and labour." By selecting the journalists to post overseas, the locations of the postings, the battles or other incidents to be reported and the elements of those engagements to be reported, the plaintiff could make a strong case for having produced an original "selection" of facts in which they could have copyright. Yet in *INS*, the Court was leery of an interpretation of copyright law that would result in something dangerously close to a monopoly over public domain material. In Canada, the situation is made more complex by the Supreme Court of Canada's recent statement of the purpose of copyright as effectively embracing a public interest dimension.¹²³ The view of the majority of the United States Supreme Court in *INS* was that something other than a pure proprietary right was at issue in the case, and that the matter was better dealt with as a tort claim. Certainly, a monopoly comprised of the life of the author plus an additional fifty years, with no formalities for registration or maintenance, is a remarkably extensive level of protection for utilitarian works, particularly in a legislative context that has clearly been hesitant to protect such works. Brandeis J., in dissent in *INS*, would have preferred a legislative response. In his view, "[t]he fact that a product of the mind has cost its producer money and labor, and has a value for which others are willing to pay, is not sufficient to ensure to it this legal attribute of property."

Ironically in *CCH*, Linden J.A., in lowering the threshold of originality so as to accommodate all manner of utilitarian works, nonetheless suggested that "copyright monopolies are better controlled through the avenues that Parliament has established than through the imposition of an arbitrary and subjective standard of 'creative spark' or 'imagination.'"¹²⁴ In its recent decision in *Harvard Mouse*, the Supreme Court of Canada has already debated whether it is more interventionist to open threshold terms to the broadest possible meaning while leaving Parliament with the option of legislating to "close the barn door," or to leave Parliament to decide in what manner, if at all, to extend the scope of the legislation.¹²⁵ Clearly, copyright protection for compilations of data and for other utilitarian works is only one of a range of options. Whether the tort law approach or *sui generis* protection would be more appropriate is an open question and one that deserves to be asked more often and more forcefully in the Canadian context. While the Departments of Industry and Canadian Heritage struggle with an elaborate process of consultation in relation to reforms of copyright legislation in order to address such issues as the liability of internet service providers, technical measures of protection and the making available right,¹²⁶ courts in Canada have effectively usurped a legislative function by extending the reach of copyright protection to an ever-expanding category of utilitarian works.

123. *Théberge*, *supra* note 32 at 355. By indicating that the purpose of copyright law is to strike a balance between the interests of the public and the interests of authors, Binnie J. appears to move Canadian law closer to the position of U.S. law.

124. *Supra*, note 10 at 258.

125. *Harvard College v. Canada (Commissioner of Patents)*, 2002 SCC 76, <http://www.lexum.umontreal.ca/csc-scc/en/pub/2002/vol4/html/2002scr4_0045.html>, [2002] 4 S.C.R. 45, (2002), 21 C.P.R. (4th) 417 [*Harvard Mouse* cited to S.C.R.]. The majority of the Court in that case opted for an approach that would leave it to Parliament to address the extent to which patent legislation should be extended, and the terms under which such an extension ought to be granted.

126. See *Consultation Paper*, *supra* note 36.