



SUPREME COURT OF CANADA

CITATION: Robertson v. Thomson Corp.,
2006 SCC 43
[2006] S.C.J. No. 43

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BETWEEN:

Heather Robertson
Appellant/Respondent on cross-appeal
and
**The Thomson Corporation, Thomson Canada Limited,
Thomson Affiliates, Information Access Company
and Bell Globemedia Publishing Inc.**
Respondents/Appellants on cross-appeal
- and -
**Canadian Newspaper Association and
Canadian Community Newspaper Association**
Interveners

CORAM: McLachlin C.J. and Bastarache, Binnie, LeBel, Deschamps, Fish, Abella, Charron and Rothstein JJ.

REASONS FOR JUDGMENT: LeBel and Fish JJ. (Bastarache, Deschamps and Rothstein
(paras. 1 to 64) JJ. concurring)

REASONS DISSENTING IN PART ON THE CROSS-APPEAL Abella J. (McLachlin C.J. and Binnie and Charron JJ.
(paras. 65 to 101) concurring)

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robertson v. thomson corp.

Heather Robertson

Appellant/respondent on cross-appeal

v.

**The Thomson Corporation, Thomson Canada Limited,
Thomson Affiliates, Information Access Company
and Bell Globemedia Publishing Inc.**

Respondents/appellants on cross-appeal

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**Canadian Newspaper Association and
Canadian Community Newspaper Association**

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Indexed as: Robertson v. Thomson Corp.

Neutral citation: 2006 SCC 43.

File No.: 30644.

Hearing: December 6, 2005.

Present: McLachlin C.J. and Major, Bastarache, Binnie, LeBel, Deschamps, Fish, Abella
and Charron JJ.

Rehearing: April 18, 2006.

Judgment: October 12, 2006.

Present: McLachlin C.J. and Bastarache, Binnie, LeBel, Deschamps, Fish, Abella, Charron and Rothstein JJ.

on appeal from the court of appeal for ontario

Intellectual property — Copyright — Infringement — Right to reproduce work — Newspaper publishers reproducing in databases and CD-ROMs articles by freelance and staff writers published in newspapers — Freelance author bringing class action against newspaper publishers for copyright infringement — Whether newspaper publishers entitled to reproduce in databases and CD-ROMs freelance articles acquired for publication in newspapers and staff written articles — Copyright Act, R.S.C. 1985, c C-42, s. 3(1).

Intellectual property — Copyright — Licences — Whether licence from freelance author granting right to newspaper publishers to republish his or her articles in databases and CD-ROMs must be in writing — Copyright Act, R.S.C. 1985, c. C-42, s. 13.

Civil procedure — Class actions — Class members — Newspaper publishers reproducing in databases and CD-ROMs freelance and staff writers' articles published in newspapers — Freelance author bringing class action against newspaper publishers for copyright infringement — Whether staff writers should have been certified as members of class.

In 1995, the appellant R wrote two freelance articles that were published in *The Globe and Mail*. Copyright was not addressed in the agreements with respect to

either article. R initiated an action against the respondents (“publishers”) for copyright infringement, objecting to the presence of her articles in two databases, Info Globe Online and CPI.Q, and a CD-ROM. In Info Globe Online and CPI.Q, articles from a given daily edition of *The Globe and Mail* are stored and presented in a database together with thousands of other articles from different newspapers or periodicals and different dates. The databases identify each article by publication date, page number and other contextual information. The CD-ROMs also contain *The Globe and Mail* and various newspapers. Their content is fixed and finite and users are able to view a single day’s edition. The databases and the CD-ROMs all omit advertisements, most graphic elements, daily information, birth and death notices and some design elements from the original print edition. R’s action was certified as a class action, the class being all contributors to *The Globe and Mail* except those who died before 1944. R sought partial summary judgment and an injunction restraining the use of her works in the databases, seeking judgment for herself and S, an employee of *The Globe and Mail*. The motions judge found that the databases and the CD-ROMs reproduced individual articles, not the collective work of the newspapers, but dismissed the motion on the grounds that there were genuine issues for trial. The Court of Appeal affirmed the decision.

Held (McLachlin C.J. and Binnie, Abella and Charron JJ. dissenting in part on the cross-appeal): The appeal should be dismissed. The cross-appeal should be allowed with respect to the CD-ROMs only.

Per Bastarache, **LeBel**, Deschamps, **Fish** and Rothstein JJ.: Newspaper publishers are not entitled to republish freelance articles acquired for publication in their newspapers in Info Globe Online or CPI.Q without compensating the authors and

obtaining their consent. Newspaper publishers have a copyright in their newspapers and have a right, pursuant to s. 3(1) of the *Copyright Act*, “to reproduce the work or any substantial part thereof in any material form whatever”. It follows that a substantial part of a newspaper may consist only of the original selection so long as the essence of the newspaper is preserved. The task of determining whether this essence has been reproduced is largely a question of degree but, at a minimum, the editorial content of the newspaper — the true essence of its originality — must be preserved and presented in the context of that newspaper. Here, in Info Globe Online and CPI.Q, the originality of the freelance articles is reproduced, but the originality of the newspapers is not. The newspaper articles are decontextualized to the point that they are no longer presented in a manner that maintains their intimate connection with the rest of that newspaper. Viewed “globally”, these databases are compilations of individual articles presented outside of the context of the original collective work from where they originated. The resulting collective work presented to the public is not simply each of the collective works joined together — it is a collective work of a different nature. The references to the newspaper where the articles were published, the date they were published and the page number where they appeared merely provide historical information. By contrast, the CD-ROMs are a valid exercise of *The Globe and Mail*’s right to reproduce its collective work. By offering users, essentially, a compendium of daily newspaper editions, the CD-ROMs remain faithful to the essence of the original work. Lastly, the concept of media neutrality reflected in s. 3(1) of the Act is not a license to override the rights of authors. Media neutrality means that the *Copyright Act* should continue to apply in different media, but it does not mean that once a work is converted into electronic data anything can then be done with it. The resulting work must still conform to the exigencies of the *Copyright Act*. [1-4] [37-49] [51-53]

A non-exclusive license granting the right to republish an article in databases or CD-ROMs does not need to be in writing. Under s. 13(4) and (7) of the *Copyright Act*, only an exclusive license requires a written contract. [56]

The newspaper staff writers should not have been certified as members of the class because they have no cause of action. Pursuant to s. 13(3) of the Act, the employer owns copyright in articles written in the course of employment while the employee is given a right to restrain publication of the work (other than in a newspaper, magazine or similar periodical). In this case, S never attempted to restrain publication of his articles, and no evidence was introduced indicating that other staff members exercised such a right. [59] [62]

Per McLachlin C.J. and Binnie, **Abella** and Charron JJ. (dissenting in part on the cross-appeal): The class action should be dismissed. The newspaper publishers own the copyright in their newspapers. Since Info Globe Online and CPI.Q contain a reproduction of a “substantial part” of the skill and judgment exercised by the publishers in creating their newspapers, they are within their right of reproduction conferred by s. 3(1) of the *Copyright Act*. The “originality” that conferred copyright in relation to the newspapers has been preserved in the databases because they reproduce fully both the publisher’s selection and editing of the articles appearing in the newspaper, as well as some of the arrangement. This being the case, the databases reproduce the newspaper. Integrating the electronic reproduction into a database containing similarly organized versions of other newspapers or periodicals is the electronic analogy to stacking print editions of a newspaper on a shelf and does not cause the electronic version to lose its

character as a reproduction of a newspaper. Further, any difference between the print and database versions of the newspaper is attributable to the digital “form” alone, and thus does not detract from the publisher’s right to reproduce its newspaper in the online databases. Under the concept of media neutrality reflected in s. 3(1), an author’s exclusive right to reproduce a “substantial part” of a copyrighted work is not limited by changes in form or output made possible by a new medium. It is not the physical manifestation of the work that governs, it is whether the product perceivably reproduces the exercise of skill and judgment by the publishers that went into the creation of the work. The loss of “context” emphasized by the majority underlines the form, not the substance, of the databases, and is inconsistent with the media neutral approach mandated by s. 3. [67] [73] [76] [80] [89-92] [97] [99-100]

It follows that the copyrights of freelance authors whose works appear in those databases are not infringed, and that the employees cannot restrain publication of their individual works in those databases under s. 13(3) of the *Copyright Act* since that publication continues to be “part of a newspaper, magazine or similar periodical”. [67]

Cases Cited

By LeBel and Fish JJ.

Referred to: *New York Times Co. v. Tasini*, 533 U.S. 483 (2001); *Allen v. Toronto Star Newspaper Ltd.* (1997), 36 O.R. (3d) 201; *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13; *Édutile Inc. v. Automobile Protection Assn.*, [2000] 4 F.C.195; *Thrustcode Ltd. v. W. W. Computing Ltd.*, [1983] F.S.R. 502; *Apple Computer, Inc. v. Mackintosh Computers Ltd.*, [1988] 1 F.C. 673, aff'd [1990] 2 S.C.R. 209; *Ritchie v. Sawmill Creek Golf & Country Club Ltd.* (2004), 35 C.P.R. (4th) 163.

By Abella J. (dissenting in part on the cross-appeal)

Théberge v. Galerie d'Art du Petit Champlain inc., [2002] 2 S.C.R. 336, 2002 SCC 34; *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13; *Society of Composers, Authors and Music Publishers of Canada v. Canadian Assn. of Internet Providers*, [2004] 2 S.C.R. 427, 2004 SCC 45; *New York Times Co. v. Tasini*, 533 U.S. 483 (2001); *Apple Computer, Inc. v. Mackintosh Computers Ltd.*, [1987] 1 F.C. 173, judgment subsequently aff'd [1990] 2 S.C.R. 209; *Édutile Inc. v. Automobile Protection Assn.*, [2000] 4 F.C. 195; *Allen v. Toronto Star Newspapers Ltd.* (1997), 36 O.R. (3d) 201; *Slumber-Magic Adjustable Bed Co. v. Sleep-King Adjustable Bed Co.* (1984), 3 C.P.R. (3d) 81.

Statutes and Regulations Cited

Copyright Act, R.S.C. 1985, c. C-42, ss. 2, 2.1(2), 3, 5, 13(1), (3), (4), (7).

Copyright Act, S.C. 1921, c. 24, s. 3.

Copyrights Act, 17 U.S.C. § 201(c) (2000).

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Geist, Michael. *Our Own Creative Land: Cultural Monopoly & The Trouble With Copyright*. Toronto: Hart House Lecture Committee, 2006.

McKeown, John S. *Fox on Canadian Law of Copyright and Industrial Designs*, 4th ed. Toronto: Thomson/Carswell, 2003 (loose-leaf updated 2006, rel. 2).

Sims, Charles S., and Matthew J. Morris. “*Tasini* and Archival Electronic Publication Rights of Newspapers and Magazines” (2001), 18:4 *Comm. Law.* 9.

Treaties and Other International Documents

Berne Convention for the Protection of Literary and Artistic Works, September 9, 1886, art. 9.

WIPO Copyright Treaty, CRNR/DC/94, December 23, 1996, art. 1(4).

World Intellectual Property Organization. *Guide to the Copyright and Related Rights Treaties Administered by WIPO and Glossary of Copyright and Related Rights Terms*, 2003, art. BC-9.6.

APPEAL and CROSS-APPEAL from a judgment of the Ontario Court of Appeal (Weiler, Gillese and Blair JJ.A.) (2004), 72 O.R. (3d) 481, 243 D.L.R. (4th) 257, 190 O.A.C. 231, 34 C.P.R. (4th) 161, [2004] O.J. No. 4029 (QL), affirming a judgment of Cumming J. (2001), 15 C.P.R. (4th) 147, [2001] O.J. No. 3868 (QL). Appeal dismissed and cross-appeal allowed in part, McLachlin C.J. and Binnie, Abella and Charron JJ. dissenting in part on the cross-appeal.

Michael McGowan, Ronald E. Dimock, Dorothy Fong, Sangeetha Punniyamoorthy and Gabrielle Pop-Lazic, for the appellant/respondent on cross-appeal.

Sheila R. Block, Wendy Matheson, Andrew Bernstein and Jill Jarvis Tonus, for the respondents/appellants on cross-appeal.

Thomas G. Heintzman and Barry B. Sookman, for the interveners.

The judgment of Bastarache, LeBel, Deschamps, Fish and Rothstein JJ. was delivered by

LEBEL AND FISH JJ. —

I. INTRODUCTION

1 The central issue on this appeal is whether newspaper publishers are entitled as a matter of law to republish in electronic databases freelance articles they have acquired for publication in their newspapers — without compensation to the authors and without their consent. In our view, they are not. Their copyright over the newspapers they publish gives them no right to reproduce, otherwise than as part of *those* collective works — their newspapers — the freelance articles that appeared in them.

2 Pursuant to the *Copyright Act*, R.S.C. 1985, c. C-42, newspaper publishers own the copyright in their newspapers and have a right to reproduce a newspaper or a

substantial part of that newspaper but do not have the right, without the consent of the author, to reproduce individual freelance articles. Info Globe Online and CPI.Q are vast electronic databases. They are compilations of individual articles presented outside the context of the collective work of which they were a part. The resulting collective work presented to the public is not simply the collective works joined together — it is a collective work of a different kind.

3 In our view, therefore, *The Globe and Mail* (“*Globe*”) cannot republish freelance articles in the Info Globe Online or CPI.Q electronic databases. The right to reproduce a collective work under the *Copyright Act* does not carry with it the right to republish freelance articles as part of an entirely different collective work.

4 On the other hand, we believe the CD-ROMs are a valid exercise of the *Globe*’s right to reproduce its collective work. The CD-ROMs can be viewed as collections of daily newspapers in a way that Info Globe Online and CPI.Q cannot.

5 For these reasons and the reasons set forth below, we would dismiss the appeal and dismiss the cross-appeal except with respect to the CD-ROMs.

II. BACKGROUND

6 At its core, this case concerns the competing rights of freelance authors and newspaper publishers. The *Copyright Act* establishes a regime of layered rights. Freelance authors who write newspaper articles retain the copyright in their work while the publisher of the newspaper acquires a copyright in the newspaper.

7 It is undisputed that freelance authors have the right to reproduce their individual works. The extent and scope of a publisher's right to reproduce those same articles as part of its right to reproduce its newspaper is less clear.

8 Advancements in computer technology have drastically altered the newspaper reality. Newspapers, once synonymous with the printed word, can now be stored and displayed electronically. The electronic databases in question archive thousands upon thousands of newspaper articles. Like a stream in constant flux, these databases are continuously growing and therefore changing. Search engines enable users to sift through these articles at lightning speed with the click of a mouse. These advancements, however, like most others, carry with them new challenges. One of these challenges is to evaluate the rights of newspaper publishers in this evolving technological landscape.

9 For well over a century, newspapers have archived back issues. Initially, as the motions judge observed, this was achieved by keeping them in a library – sometimes referred to in newspaper parlance as a “morgue”. With the advent of microfilm and microfiche, past editions were archived using photographic imaging technology. Currently, newspapers are archived in electronic form. The subject electronic databases, however, do more than simply archive back issues.

10 The transfer of articles from their newspaper format and environment to Info Globe Online and CPI.Q, unlike the conversion to microfilm or microfiche, is no mere conversion of the newspaper from the print realm to the electronic world. As we will

explain, the result is a different product that infringes the copyrights of freelance authors whose works appear in those databases. We begin with a review of the factual and judicial history.

III. FACTUAL HISTORY

11 Heather Robertson is a freelance author. In 1995, she wrote two articles that were published in the *Globe*. One, a book excerpt, was the subject of a written agreement between the *Globe* and the publisher of Robertson's book; the other, a book review, was written under oral agreement with Robertson. Copyright was not addressed in either case. Subsequently, in 1996, it became the practice of the *Globe* to enter into written agreements with freelance authors expressly granting it certain electronic rights in freelance work. The agreement was later modified to expand the electronic rights clause. These agreements are not at issue in this case.

12 The *Globe* is one of Canada's leading national newspapers and has been produced in both print and electronic editions since the late 1970s. The named respondents on the appeal are: The Thomson Corporation, Thomson Canada Limited, Thomson Affiliates, Information Access Company and Bell GlobeMedia Publishing Inc., the current publisher of the *Globe* (collectively, the "Publishers").

13 Ms. Robertson objects to the presence of her articles in three databases: InfoGlobe Online, CPI.Q and the CD-ROMs (collectively, the "electronic databases"). The use of freelance articles in the daily internet edition of the *Globe* is not in issue before us.

14 Info Globe Online is a commercial database that has existed since April 1979, with stories going back to November 1977. It provides subscribers with access to stories from the *Globe* for a fee. It also allows subscribers to find articles in many other newspapers, news wire services, magazines and reference databases. Subscribers can search by key word and retrieve articles electronically. The subscriber may display, read, download, store, or print the articles.

15 CPI.Q is the electronic version of the Canadian Periodical Index. The Canadian Periodical Index indexes selected newspaper articles from various newspapers. It is available at libraries and is routinely used in research. In 1987, it became available electronically. CPI.Q is an enhanced form of the original index. It allows subscribers to search the electronic archives of indexed periodicals by key word and to retrieve articles electronically. Once an article is displayed it is possible to print it as well.

16 The CD-ROMs, each containing the *Globe* and several other Canadian newspapers from a calendar year, have been available since 1991. Users can navigate using search engines and retrieve and print articles. Notably, the content of the CD-ROM is fixed and finite and users are able to view a paper as a single day's edition.

17 The electronic databases all omit the advertisements, some tables, photographs, artwork, photo captions, birth and death notices, financial tables, weather forecasts and some design elements from the original print edition.

18 Robertson's action against the Publishers for copyright infringement was certified as a class action, with the class consisting of all contributors to the *Globe* other

than those who died on or before December 31, 1943: *Robertson v. Thomson Corp.* (1999), 43 O.R. (3d) 161 (Gen. Div.), at p. 168. Robertson brought a motion for partial summary judgment and an injunction restraining the use of her works in the databases. She sought judgment for two individual class members: herself and Cameron Smith, a former employee of the *Globe*.

IV. DECISIONS BELOW

19 The motions judge found that the electronic databases reproduced “individual” articles and not the collective work of the newspapers.

20 The Publishers asserted a number of defences, including an implied contractual right or an implied licence to reproduce the articles. Robertson countered that such an implied license, to be valid, had to have been in writing. Cumming J. dismissed the motion for partial summary judgment on the grounds that there were genuine issues for trial: (2001), 15 C.P.R. (4th) 147.

21 Weiler J.A. wrote the majority decision for the Ontario Court of Appeal: (2004), 72 O.R. (3d) 481. She found that the motions judge had relied too heavily on *New York Times Co. v. Tasini*, 533 U.S. 483 (2001), an American case. She also found that Cumming J. erred by attaching significance to the Publishers’ creation of a different economic activity and by focussing excessively on the technological means of accessing the database using advanced search engines.

22 Weiler J.A. dismissed the cross-appeal nonetheless, concluding that neither the databases nor the CD-ROMs reproduced a substantial part of the *Globe*. She found that approximately half of the newspaper's content (the articles) was transferred to Info Globe Online daily. Quantitatively, that was a substantial part. Qualitatively, it was not. Applying a qualitative test, she found it necessary for both the selection and arrangement of the original collective work to be preserved if the collective work was to be reproduced.

23 Weiler J.A. found that when the individual articles are disentangled from the collective work they are not covered by the collective copyright because their arrangement within the collective work is lost. She further observed that the "form" and "function" of the new work were different. As to form, the *Globe* newspaper is limited to the events of the day, whereas Info Globe Online and CPI.Q are ever-expanding. With respect to function, *Globe* readers read the news, whereas users of Info Globe Online or CPI.Q research.

24 Weiler J.A. also dismissed the appeal. She found no error in the motions judge's conclusion that the grant of a non-exclusive license did not have to be in writing. She also agreed that Robertson did not have standing to assert a claim for injunctive relief on behalf of *Globe* staff writers.

25 Blair J.A. agreed that the appeal should be dismissed for the reasons given by Weiler J.A., but disagreed with her disposition of the cross-appeal. Blair J.A. framed the question by asking specifically "whether the electronic version of the *Globe* as found in the electronic archive [was] a reproduction of the collective work" (para. 131

(emphasis deleted)). He found that once an article is placed in the database as part of the collective work it is not relevant how it is located, deconstructed, identified, retrieved or displayed on screen.

26 Moreover, Blair J.A. noted that each article, when retrieved, showed clearly that it was from the *Globe* by referring to the date of the edition, its original page number, the section in which it was contained, whether it was accompanied by an illustration, its title or headline and the author's byline.

27 Blair J.A. also agreed with Weiler J.A.'s conclusion that the Publishers could place staff written articles in the electronic databases because employees have no right to restrain publication of their articles in a newspaper, magazine or similar periodical pursuant to s. 13(3) of the *Copyright Act*. According to Blair J.A., the "electronic version of the *Globe*", as found in the electronic databases, falls within the ambit of s.13(3).

V. ANALYSIS

28 Two issues were raised on the cross-appeal: Whether the electronic databases infringed the right of (1) freelance authors; and (2) *Globe* staff writers. The appeal raises two other issues: (1) would a license from a freelance author specifically granting a publisher the right to republish his or her article in the electronic databases need to be in writing? and (2) does Robertson have standing to assert a claim on behalf of employees of the *Globe*?

29 We propose to deal first with the first issue on the cross-appeal since the bulk of argument related to that issue. We will then turn to the remaining issues.

A. *Cross-Appeal: the Main Issue*

30 Section 13(1) of the *Copyright Act* states: “Subject to this Act, the author of a work shall be the first owner of the copyright therein.” And, s. 2.1(2) of the *Copyright Act* confirms that “[t]he mere fact that a work is included in a compilation does not increase, decrease or otherwise affect the protection conferred by this Act in respect of the copyright in the work”. Accordingly, Robertson, as the author of her freelance works, is the owner of the copyright in those articles. The same is true for other freelance authors.

31 A publisher does not have any rights in freelance articles themselves but has another, distinct, copyright in the daily newspapers in which the freelance articles appear. Newspapers are included in the definition of “collective work” in accordance with s. 2 of the *Copyright Act*. A newspaper can also be characterized as a “compilation” pursuant to s. 2 of the *Copyright Act*, which defines “compilation” as a work resulting from “selection or arrangement”. We are thus confronted with two different but overlapping copyrights.

32 Section 3(1) of the *Copyright Act* provides:

3.(1) For the purposes of this Act, “copyright”, in relation to a work, means the sole right to produce or reproduce the work or any substantial part thereof in any material form whatever, ... and includes the sole right

(a) to produce, reproduce, perform or publish any translation of the work,

(b) in the case of a dramatic work, to convert it into a novel or other non-dramatic work,

(c) in the case of a novel or other non-dramatic work, or of an artistic work, to convert it into a dramatic work, by way of performance in public or otherwise,

(d) in the case of a literary, dramatic or musical work, to make any sound recording, cinematograph film or other contrivance by means of which the work may be mechanically reproduced or performed,

(e) in the case of any literary, dramatic, musical or artistic work, to reproduce, adapt and publicly present the work as a cinematographic work,

(f) in the case of any literary, dramatic, musical or artistic work, to communicate the work to the public by telecommunication,

(g) to present at a public exhibition, for a purpose other than sale or hire, an artistic work created after June 7, 1988, other than a map, chart or plan,

(h) in the case of a computer program that can be reproduced in the ordinary course of its use, other than by a reproduction during its execution in conjunction with a machine, device or computer, to rent out the computer program, and

(i) in the case of a musical work, to rent out a sound recording in which the work is embodied,

and to authorize any such acts.

33 Plainly, freelance authors have the right to reproduce, and authorize the reproduction of, their articles. Similarly, as the holders of the copyright in their newspapers, the Publishers are entitled to “produce or reproduce the work or any substantial part thereof in any material form whatever”.

34 The real question then is whether the electronic databases that contain articles from the *Globe* reproduce the newspapers or merely reproduce the original articles. It is open to the Publishers to reproduce a substantial part of the collective work

in which they have a copyright; it is a violation of the *Copyright Act* for the Publishers to reproduce, without consent, the individual works with respect to which an author owns the copyright. The answer to this question lies in the determination of whose “originality” is being reproduced: the freelance author’s alone or the Publishers’ as a collective work?: see *Allen v. Toronto Star Newspaper Ltd.* (1997), 36 O.R. (3d) 201 (Div. Ct.).

35 “Originality” is the foundation stone of copyright. Section 5 of the *Copyright Act* states that copyright shall subsist “in every original literary, dramatic, musical and artistic work”. This was explained by McLachlin C.J., for the Court, in *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13:

For a work to be “original” within the meaning of the *Copyright Act*, it must be more than a mere copy of another work. At the same time, it need not be creative, in the sense of being novel and unique. What is required to attract copyright protection in the expression of an idea is an exercise of skill and judgment. [para. 16]

36 More specifically, McLachlin C.J. addressed originality as it relates to compilations – in that case, judicial decisions:

The reported judicial decisions, when properly understood as a *compilation* of the headnote and the accompanying edited judicial reasons, are “original” works covered by copyright. Copyright protects originality of *form* or expression. A compilation takes existing material and casts it in different form. The arranger does not have copyright in the individual components. However, the arranger may have copyright in the form represented by the compilation. “It is not the several components that are the subject of the copyright, but the over-all arrangement of them which the plaintiff through his industry has produced”: *Slumber-Magic Adjustable Bed Co. v. Sleep-King Adjustable Bed Co.* (1984), 3 C.P.R. (3d) 81 (B.C.S.C.), at p. 84; see also *Ladbroke (Football) Ltd. v. William Hill (Football) Ltd.*, [1964] 1 All E.R. 465 (H.L.), at p. 469.

The reported judicial decisions here at issue meet the test for originality. The authors have arranged the case summary, catchlines, case title, case information (the headnotes) and the judicial reasons in a specific manner. The arrangement of these different components requires the exercise of skill and judgment. The compilation, viewed globally, attracts copyright protection. [Emphasis in original; paras. 33-34.]

37 Similarly, the Publishers have a copyright in their newspapers, each an original collection of different components reflecting the exercise of skill and judgment. Section 2 of the *Copyright Act*, as noted above, defines a compilation as an original work that is created as a result of selection or arrangement. This same conception of originality underlies the inclusion of the newspapers in the definition of collective work. We note that the use of the disjunctive “or” in s. 2 is significant. The *Copyright Act* does not require originality in both the selection and arrangement. Similarly, and with all due respect to Weiler J.A.’s contrary finding, we agree with the Publishers that a reproduction of a compilation or a collective work need not preserve *both* the selection and arrangement of the original work to be consistent with the Publisher’s reproduction rights.

38 Section 3 of the *Copyright Act* provides the copyright owner with the right to reproduce a work *or* a substantial part thereof. It follows that a substantial part of a newspaper may consist only of the original selection so long as the essence of the newspaper is preserved, i.e., that which embodies the originality of the collective work that is capable of attracting copyright. In *Édutile Inc. v. Automobile Protection Assn.*, [2000] 4 F.C.195, the Federal Court of Appeal stated:

To determine whether a “substantial part” of a protected work has been reproduced, it is not the quantity which was reproduced that matters as much as the quality and nature of what was reproduced. ...

It seems clear that APA appropriated a “substantial part”, indeed the very essence, of Édutile’s work ... [Emphasis added; paras. 22-23.]

39 There is much originality in a newspaper: the editorial content, the selection of articles, the arrangement of articles, the arrangement of advertisements and pictures, and the fonts and styles used. But the true essence of the originality in a newspaper is its editorial content. It is the selection of stories, and the stories themselves, that resonate in the hearts and minds of readers.

40 The task of determining whether this essence has been reproduced may be difficult. Indeed, it is largely a question of degree. At a minimum, however, the editorial content of the newspaper must be preserved and presented *in the context* of that newspaper.

41 We again agree with the Publishers that their right to reproduce a substantial part of the newspaper includes the right to reproduce the newspaper without advertisements, graphs and charts, or in a different layout and using different fonts. But it does not follow that the articles of the newspaper can be decontextualized to the point that they are no longer presented in a manner that maintains their intimate connection with the rest of that newspaper. In Info Globe Online and CPI.Q, articles from a given daily edition of the *Globe* are stored and presented in a database together with thousands of other articles from different periodicals and different dates. And, these databases are

expanding and changing daily as more and more articles are added. These products are more akin to databases of individual articles rather than reproductions of the *Globe*. Thus, in our view, the originality of the freelance articles is reproduced; the originality of the newspapers is not.

42 The Publishers argue that the connection with the original newspaper is not lost in the databases because the articles in Info Globe Online and CPI.Q contain references to the newspaper they were published in, the date they were published and the page number where the article appeared. We do not share this view. Rather, we agree with the United States Supreme Court’s finding in *Tasini* where the same argument was canvassed and rejected. Ginsburg J., for the majority, stated:

One might view the articles as parts of a new compendium – namely, the entirety of works in the Database. In that compendium, each edition of each periodical represents only a minuscule fraction of the ever-expanding Database. The Database no more constitutes a “revision” of each constituent edition than a 400-page novel quoting a sonnet in passing would represent a “revision” of that poem.... The massive whole of the Database is not recognizable as a new version of its every small part.

Alternatively, one could view the Articles in the Databases “as part of” no larger work at all, but simply as individual articles presented individually. That each article bears marks of its origin in a particular periodical (less vivid marks in NEXIS and NYTO, more vivid marks in GPO) suggests the article was *previously* part of that periodical. But the markings do not mean the article is *currently* reproduced or distributed as part of the periodical. The Databases’ reproduction and distribution of individual Articles – simply as individual Articles – would invade the core of the Authors’ exclusive

rights under §106. [Footnote omitted, underlining added, italics in original;
p. 500-501.]

43 Weiler J.A. correctly pointed out that caution must be adhered to when referencing *Tasini* in the Canadian context due to differences in the applicable governing legislation. Pursuant to the U.S. *Copyrights Act*, 17 U.S.C. §201(c) (2000), the publisher does not have a separate copyright in the collective work but has only the “privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series”. Nonetheless, we find the reasoning in the foregoing passage, which simply describes the nature of the decontextualization that occurs in similar databases, compelling and applicable.

44 This decontextualization is critical to the disposition of this case. As Weiler J.A. observed, “In this vast storehouse of information, the collective work that is the *Globe* is fragmented, submerged, overwhelmed and lost” (para. 82). In our view, date and page references do not change this – they merely provide historical information, as the U.S. Supreme Court observed.

45 The Publishers also argue that the Court should focus on *input* rather than *output*. This was also the view of Blair J.A. in his dissenting opinion. According to this reasoning, a substantial part of the print edition of each day’s *Globe* (excluding pictures, advertisements, tables and charts) is stored in an electronic file. Blair J.A. found that this electronic data, *input* into the databases, which represents the electronic reproduction of the print daily. He therefore concluded that the electronic file contains the editorial

content of the newspaper and is therefore a “reproduction” within the meaning of s. 3(1) of the *Copyright Act*, regardless of what use it is put to afterwards.

46 With respect, we believe this approach prematurely terminates the analysis. And the manner in which Blair J.A. framed the question – by asking whether the *electronic version* of the *Globe* in the electronic databases is a reproduction of the *Globe* – presupposes an answer in favour of the Publishers. It is not the electronic data that is presented to the public but the finished product, i.e., the databases. We cannot avoid comparing the original collective work with the finished collective work when determining whether there has been a reproduction. As Megarry V.C., put it in *Thrustcode Ltd. v. W. W. Computing Ltd.*, [1983] F.S.R. 502 (Ch. D.), cited with approval by Mahoney J.A. in *Apple Computer, Inc. v. Mackintosh Computers Ltd.*, [1988] 1 F.C. 673 (C.A.), aff’d [1990] 2 S.C.R. 209: “For computers, as for other things, what must be compared are the thing said to have been copied and the thing said to be an infringing copy” (p. 505).

47 Viewed “globally”, to use the language of this Court in *CCH*, Info Globe Online and CPI.Q are different selections than the selections that they incorporate. They are compilations of individual articles presented outside of the context of the original collective work from where they originated. The resulting collective work presented to the public is not simply each of the collective works joined together – it has become a collective work of a different nature.

48 To be clear, this analysis is not predicated on the ability of a user to search by key word. We agree with both Weiler J.A. and Blair J.A. that the search mechanism

which enables a user to isolate individual articles is not determinative. The focus of our analysis firmly remains on what the *Globe* presents to the user; not on how the user makes use of it. In this sense, the input/output dichotomy is misleading. Moreover, we are mindful of the principle of media neutrality under the *Copyright Act* and agree that the principle precludes a finding of copyright infringement merely because it is possible to search with more efficient tools than in the past. That being said, focussing exclusively on input in the name of media neutrality takes the principle too far and ultimately, turns it on its head.

49 Media neutrality is reflected in s. 3(1) of the *Copyright Act* which describes a right to produce or reproduce a work “in any material form whatever”. Media neutrality means that the *Copyright Act* should continue to apply in different media, including more technologically advanced ones. But it does not mean that once a work is converted into electronic data anything can then be done with it. The resulting work must still conform to the exigencies of the *Copyright Act*. Media neutrality is not a license to override the rights of authors – it exists to protect the rights of authors and others as technology evolves.

50 Recent developments in international agreements on copyright have not changed these principles. On the contrary, they recognize and apply them.

51 Notwithstanding the foregoing, we part ways with Weiler J.A. regarding the CD-ROMs. In our view, the CD-ROMs are a valid exercise of the *Globe*’s right to reproduce its collective works (or a substantial part thereof) pursuant to s. 3(1) of the *Copyright Act*. The CD-ROMs, like Info Globe Online and CPI.Q, do not contain

advertisements, pictures or colour and are presented in a different medium and format than the print edition. The critical distinction, however, is that the CD-ROMs preserve the linkage to the original daily newspaper.

52 The user of the CD-ROM is presented with a collection of daily newspapers which can be viewed separately. When viewing an article on CD-ROM after searching for a particular edition, the other articles from that day's edition appear in the frame on the right hand side of the screen. To pass muster, a reproduction does not need to be a replica or a photographic copy. But it does need to remain faithful to the essence of the original work. And, in our view, the CD-ROM does so by offering users, essentially, a compendium of daily newspaper editions.

53 In our view, the fact that the CD-ROM includes other newspapers is not fatal. The essential characteristic of the newspaper is not lost when it is presented together on a CD with a discrete number of other newspapers, each of which is viewable as a separate and distinct paper. Moreover, as we indicated above, the ability to search by key word does not make the CD-ROM reproduction any less of a reproduction.

B. *The Remaining Issues*

54 Section 13(4) of the *Copyright Act* provides:

13. ...

(4) The owner of the copyright in any work may assign the right, either wholly or partially, and either generally or subject to limitations relating to territory, medium or sector of the market or other limitations relating to the

scope of the assignment, and either for the whole term of the copyright or for any other part thereof, and may grant any interest in the right by license, but no assignment or grant is valid unless it is in writing signed by the owner of the right in respect of which the assignment or grant is made, or by the owner's duly authorized agent.

55 Section 13(7) of the *Copyright Act* states:

13. ...

(7) For greater certainty, it is deemed always to have been the law that a grant of an exclusive license in a copyright constitutes the grant of an interest in the copyright by license.

56 We are satisfied that Weiler J.A. was correct in concluding that only an exclusive license must be in writing. If Parliament intended for any type of non-exclusive license to be deemed a “grant of an interest” requiring a written contract, it could have explicitly provided so just as it did for exclusive licenses in s. 13(7). In our view, the following passage from the Ontario Superior Court of Justice decision in *Ritchie v. Sawmill Creek Golf & Country Club Ltd.* (2004), 35 C.P.R. (4th) 163, correctly states the matter:

The “grant of an interest” referred to in s.13(4) is the transfer of a property right as opposed to a permission to do a certain thing. The former gives the licensee the capacity to sue in his own name for infringement, the latter provides only a defence to claims of infringement. To the extent there was any uncertainty as to the meaning of “grant of an interest” and whether

this section applied to non-exclusive licenses, the issue was resolved in 1997 when the *Copyright Act* was amended to include s. 13(7) ... [para. 20]

57 There was conflicting evidence before the motions judge regarding the scope of such an alleged implied license. The content of these licenses is a live issue that should go to trial, as ordered by the motions judge.

58 If it is determined that freelance authors have in fact impliedly licensed the *Globe* the right to republish their articles in the electronic databases, this decision will, of course, be of less practical significance. Parties are, have been, and will continue to be, free to alter by contract the rights established by the *Copyright Act*.

59 With respect to the second issue on the appeal, we find that employees of the *Globe*, including Cameron Smith, should not have been certified as members of the class because they have no cause of action.

60 In a class action, the class definition must be supported by a statement of claim that includes one or more causes of action applicable to each class member. The class definition in the present case does not distinguish between freelance authors and staff writers. The rights of each, however, are fundamentally different.

61 Section 13(3) of the *Copyright Act* states:

13. ...

(3) Where the author of a work was in the employment of some other person under a contract of service or apprenticeship and the work was made in the course of his employment by that person, the person by whom the author was employed shall, in the absence of any agreement to the contrary,

be the first owner of the copyright, but where the work is an article or other contribution to a newspaper, magazine or similar periodical, there shall, in the absence of any agreement to the contrary, be deemed to be reserved to the author a right to restrain the publication of the work, otherwise than as part of a newspaper, magazine or similar periodical.

62 When a staff member writes an article for a newspaper, magazine or similar periodical during the course of his or her employment, s. 13(3) of the *Copyright Act* provides that copyright vests with the employer while the employee is given a right to restrain publication of the work (other than in a newspaper, magazine or similar periodical). Thus, even when freelance authors have a cause of action for copyright infringement, staff writers have no cause of action unless they previously exercised their right to restrain publication. In this case, Cameron Smith never attempted to restrain publication of his articles. And, no evidence was introduced indicating that other staff members exercised such a right.

63 It is therefore unnecessary for the purposes of this case to determine whether the electronic databases constitute “newspaper[s], magazine[s] or similar periodical[s]” within the meaning of s. 13(3) of the *Copyright Act*. We have already found that Info Globe Online and CPI.Q do not constitute reproductions of a substantial part of the underlying print newspapers because they are works of a different nature. Without so deciding, it follows, we believe, for essentially the same reasons, that these same databases cannot be characterized as newspapers, magazines or similar periodicals for purposes of s. 13(3).

VI. DISPOSITION

64 For the foregoing reasons, we would dismiss the appeal and allow the cross-appeal with respect to the CD-ROMs only. Taking into account all of the circumstances and the mitigated result, the parties should bear their own costs in this Court.

The reasons of McLachlin C.J. and Binnie, Abella and Charron JJ. were delivered by

65 ABELLA J. — The basic right of every copyright holder, according to s. 3(1) of the *Copyright Act*, R.S.C. 1985, c. C-42, is to “produce or reproduce the work or any substantial part thereof in any material form whatever”.

66 At issue in this appeal are online databases into which the publishers place all articles selected by them for inclusion in each day’s edition of their newspapers. An article’s date, page and headline in the printed version of those newspapers appear on every article.

67 I agree with LeBel and Fish JJ. that the appeal should be dismissed and that the cross-appeal should be allowed in connection with the CD-ROM issue. I have a different view, with respect, of the application of the *Copyright Act* to Info Globe Online and CPI.Q and would allow the cross-appeal in connection with them as well. In my view, these databases reproduce a “substantial part” of the publishers’ “work”, and are, as a result, within the right of reproduction conferred by s. 3(1) of the Act. It follows that the employees cannot restrain publication of their individual works in those databases under s. 13(3) since that publication continues to be “part of a newspaper, magazine or similar periodical”.

Analysis

68 Section 3 of the *Copyright Act* has remained substantially unchanged since it was first introduced in 1921: see S.C. 1921, c. 24, s. 3. It was promulgated a year after the Westinghouse Electric and Manufacturing Company released the first domestic radio sets, and many decades before the technological revolution that produced, among other innovations, online databases.

69 This Court has repeatedly held that the overarching purposes of the *Copyright Act* are twofold: promoting the public interest in the encouragement and dissemination of artistic and intellectual works, and justly rewarding the creator of the work. See *Théberge v. Galerie d'Art du Petit Champlain inc.*, [2002] 2 S.C.R. 336, 2002 SCC 34, at para. 30; *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13, at para. 23; and *Society of Composers, Authors and Music Publishers of Canada v. Canadian Assn. of Internet Providers*, [2004] 2 S.C.R. 427, 2004 SCC 45 (“*SOCAN*”), at para. 40. Since these purposes are often in opposition to each other, courts “should strive to maintain an appropriate balance between those two goals”: J. S. McKeown, *Fox on Canadian Law of Copyright and Industrial Designs* (4th ed. (loose-leaf.)), at pp. 1-13.

70 The public interest is particularly significant in the context of archived newspapers. These materials are a primary resource for teachers, students, writers, reporters, and researchers. It is this interest that hangs in the balance between the

competing rights of the two groups of creators in this case, the authors and the publishers.

71 The aftermath of the litigation in *New York Times Co. v. Tasini*, 533 U.S. 483 (2001), is instructive. Freelance authors had sued the New York Times for copyright infringement arising out of the inclusion of articles written by them in online databases. They were successful. The New York Times Co.'s response was to remove all of the affected articles from its online databases: D. P. Bickham, "Extra! Can't Read All About It: Articles Disappear After High Court Rules Freelance Writers Taken Out of Context In *New York Times Co. v. Tasini*" (2001), 29 *W. St. U. L. Rev.* 85, at p. 102. Its response is not surprising, since "[t]he economic calculus runs sharply in favor of deletion", with publishers having "virtually no economic upside to retaining freelance articles in the electronically available archived editions, and substantial economic downside": C. S. Sims and M. J. Morris, "*Tasini* and Archival Electronic Publication Rights of Newspapers and Magazines" (2001), 18:4 *Comm. Law.* 9, at p. 15.

72 The detrimental impact of such a ruling may be even more profound in Canada since, under s. 13(3) of the *Copyright Act*, the publisher's employees have the right to prevent republication of their articles in online databases if those databases are found not to be a "newspaper". In my view, such a ruling is not mandated by the Act. The publishers own the copyright in their newspaper which, for purposes of the *Copyright Act*, is a "collective work". A newspaper is also a "compilation", which is defined by the Act to include "a work resulting from the selection or arrangement of data". The key is in the disjunctive. Either the selection *or* the arrangement of data is sufficient to constitute a copyrighted "work".

73 The most fundamental right conferred by the publisher’s copyright is the right to produce *and reproduce* the copyrighted work. Copyright in relation to a work, as described in s. 3, means “the sole right to produce or reproduce the work or any substantial part thereof in any material form whatever”. The right contains two key features. The first is that in Canada, unlike the narrower privilege conferred under the American *Copyrights Act*, 17 U.S.C. § 201(c) (2000), the holder of the copyright may reproduce not only the work, but also a “substantial part thereof”.

74 The second is that, like its American counterpart, Canada’s *Copyright Act* is media neutral: the right is to reproduce the work in “any material form whatever”. Those are the words that inform the concept of “media neutrality”. The publisher’s right to contribute to the online databases at issue here stands or falls on the meaning of those words.

75 The concept of media neutrality is how Parliament chose to come to grips with potential technological developments. On its face, the media neutrality protection found in s. 3(1) is a simple concept. As Gonthier J. pointed out in *Théberge*, s. 3(1) offers “an appropriate and carefully worded recognition that a work may be reproduced *even if* the new medium is different” (para. 148 (emphasis in original)).

76 The words “any material form whatever” in s. 3(1) should be taken to mean what they say: the author’s exclusive right to reproduce a “substantial part” of a copyrighted work is not limited by changes in form or output made possible by a new medium. A media neutral *Copyright Act* ensures that such transformations in form do

not erode the content of the copyright protection: see *Apple Computers, Inc. v. Mackintosh Computers Ltd.*, [1987] 1 F.C. 173 (T.D.), at p. 33, judgment subsequently aff'd [1990] 2 S.C.R. 209.

77 Under a media neutral *Copyright Act*, mere visual comparison of the work and the item said to be a reproduction of that work may be deceptive. The conversion of a work from one medium to another will necessarily involve changes in the work's visual appearance, but these visual manifestations do not change the content of the right.

78 As Binnie J. discussed in *Théberge*, at para. 47, the *Copyright Act's* understanding of the right to reproduce is not limited to "only literal physical, mechanical reproduction", and the concept of reproduction has broadened to recognize that "technologies have evolved by which expression could be reproduced in ways undreamt of in earlier periods, such as evanescent and 'virtual' copies in electronic formats".

79 The *Copyright Act* was designed to keep pace with technological developments to foster intellectual, artistic and cultural creativity. In applying the *Copyright Act* to a realm that includes the Internet and the databases at issue in this case, courts face unique challenges, but in confronting them, the public benefits of this digital universe should be kept prominently in view. As Professor Michael Geist observes:

The Internet and new technologies have unleashed a remarkable array of new creativity, empowering millions of individuals to do more than just consume our culture, instead enabling them to actively and meaningfully participate in it.

(M. Geist, *Our Own Creative Land: Cultural Monopoly & The Trouble With Copyright* (2006), at p. 9)

80 The source of every copyright, as this Court discussed in *CCH*, subsists in a work as long as it is “original”. Regardless of whether the work in question is individual or collective, the inquiry into whether a work has been reproduced for purposes of s. 3 must focus on whether the “originality” that conferred copyright in relation to that work has been preserved in what is said to be a reproduction.

81 In *CCH*, originality was held to encompass the exercise of “skill and judgment” by an author: see para. 16. Every copyrighted work — individual or collective — is the product of the exercise of skill and judgment. In determining, therefore, whether a work like a newspaper, or “any substantial part thereof”, has been reproduced, what will be determinative is the extent to which the item said to be a reproduction contains within it, in qualitative rather than quantitative terms, a substantial part of the skill and judgment exercised by the creator of the work: see *Édutile Inc. v. Automobile Protection Assn.*, [2000] 4 F.C. 195 (C.A.), at para. 22.

82 The right of reproduction adheres equally to the benefit of authors of individual works and to those of collective works or compilations. In considering the publisher’s right of reproduction, the majority says that the line between the rights of individual authors and the rights of authors of collective works should be drawn on the basis of whose originality is being reproduced. This suggests that the databases in question reproduce only one group’s originality. This, with respect, seems to me to contradict the essence of collective works and compilations, which inherently contain the

“originality” of both the authors of individual works as well as of the creator of the collective work or compilation. Any reproduction of a collective work will necessarily involve the reproduction of *both* sets of originality.

83 Yet this does not bar the creator of a collective work, such as a newspaper, from reprinting the newspaper. On the contrary, creators of collective works, like authors of individual works, have the “sole right” under s. 3 to produce and reproduce their works, which in the case of the former will necessarily include the originality of contributing authors: see, for example, *Allen v. Toronto Star Newspapers Ltd.* (1997), 36 O.R. (3d) 201 (Div. Ct.). This continuing right of use of the individual authors’ originality creates no unfairness to those authors since, as McLachlin J. observed in *Slumber-Magic Adjustable Bed Co. v. Sleep-King Adjustable Bed Co.* (1984), 3 C.P.R. (3d) 81 (B.C.S.C.), at pp. 84-85, the ability to produce a collective work in the first place depends on the individual authors’ authorization to use the materials that form the compilation.

84 In the context of a collective work, the question is whether the author of a collective work or compilation has reproduced the work, or a “substantial part” of the work, accepting that doing so will necessarily involve substantial reproduction of the “originality” of individual authors. Framing the issue, as the majority does, as “whether newspaper publishers are entitled ... to republish in electronic databases freelance articles they have acquired for publication in their newspapers” (para. 1), presupposes the conclusion that the publishers have “republis[hed] ... freelance articles”, rather than the collective work — the newspaper — over which they unquestionably have a right of reproduction.

85 If the publishers were to convert every article from a given day's edition into electronic form by placing each article in its own electronic file, marking each electronic article with its page and date of appearance, and transferring all of those files onto a disk or attaching them all to an e-mail, the resulting bundle of electronic articles would clearly constitute an electronic reproduction of "any substantial part [of that day's newspaper] in any material form whatever".

86 If media neutrality is to have any meaning, it must permit the publishers to convert their daily print edition into electronic form. The means by which the publishers do so is to remove advertisements, photographs, and other aspects of the arrangement of the articles from the newspaper, then place each article in its own electronic file. Each story is dated and includes a section, page number, headline and by-line, and is identified as appearing in *The Globe and Mail*.

87 Ms. Robertson concedes that the electronic daily edition in existence in 1995 does not infringe the copyright held by individual freelance authors. In substance, there is no difference between the actual electronic daily edition and a bundle of electronic articles from a given day's paper (each in their own file). Because both contain every article selected by the editors for inclusion in the newspaper, and because the text of every article in the electronic edition is as it appears in the newspaper, the skill and judgment of the newspaper's editors exercised in selecting and editing the articles are fully contained in either form of electronic reproduction.

88 Whether it is presented in an e-mail as an “electronic daily edition”, or consists of a bundle of files on a disk, this electronic edition contains a substantial part of the skill and judgment exercised by the publishers in creating that day’s newspaper. It is a reproduction of the print edition in electronic form. That is precisely what media neutrality protects. As discussed by Stevens J. in his compelling dissent in *Tasini*:

No one doubts that the New York Times has the right to reprint its issues in Braille, in a foreign language, or in microform, even though such revisions might look and feel quite different from the original. Such differences, however, would largely result from the different medium being employed. Similarly, the decision to convert the single collective work newspaper into a collection of individual ASCII files can be explained as little more than a decision that reflects the different nature of the electronic medium. Just as the paper version of the New York Times is divided into “sections” and “pages” in order to facilitate the reader’s navigation and manipulation of large batches of newsprint, so too the decision to subdivide the electronic version of that collective work into individual article files facilitates the reader’s use of the electronic information. The barebones nature of ASCII text would make trying to wade through a single ASCII file containing the entire content of a single edition of the New York Times an exercise in frustration. [Footnote omitted; pp. 512-13.]

89 Given how unwieldy it would be to view an entire newspaper as a single stream of electronic text, the individual article provides the “logical unit” by which to divide the newspaper into manageable pieces: *Tasini*, per Stevens J., at p. 513, fn. 9. There is, consequently, nothing colourable about the publishers’ decision to use individual articles as the more practical and more easily accessible unit of organization for an electronic version.

90 The analysis is unchanged if a number of these hypothetical electronic editions are collected together. This is simply the electronic analogy to stacking print editions of a newspaper on a shelf.

91 Having concluded that a collection of electronic articles from one day's edition of the newspaper constitutes a reproduction of that day's newspaper, I have difficulty seeing how the integration of the electronic reproduction into a database containing similarly organized versions of other periodicals causes the electronic version to lose its character as a reproduction of a newspaper and, correspondently, to lose its protection under s. 3.

92 The ultimate question to be asked is whether the database contains a reproduction of a substantial part of the skill and judgment exercised by the publishers in creating the newspaper. If an "electronic edition" reproduces the publishers' skill and judgment and is, on that basis, a reproduction of the publishers' newspaper, there is no reason why the nature of the database in which the electronic editions are housed should change the designation and character of those editions. This too was addressed by Stevens J. in *Tasini*:

A microfilm of the New York Times for October 31, 2000, does not cease to be a revision of that individual collective work simply because it is stored on the same roll of film as other editions of the Times or on a library shelf containing hundreds of other microfilm periodicals. Nor does § 201(c) compel the counterintuitive conclusion that the microfilm version of the Times would cease to be a revision simply because its publishers might choose to sell it on rolls of film that contained a year's editions of both the New York Times *and* the Herald-Tribune. Similarly, the placement of our hypothetical electronic revision of the October 31, 2000, New York Times within a larger electronic database does nothing to alter either the nature of our original electronic revision or the relationship between that revision and the individual articles that exist as "part of" it. [Emphasis in original; pp. 517-18.]

93 The database is, as Blair J.A. described it, better seen as an electronic archive, "just as a traditional library consists of a collection of books, newspapers,

journals, periodicals and a plethora of printed materials” (para. 149). As he rightly observed, “[n]o one suggests ... that a library must be a newspaper before the copyright of a newspaper publisher in the newspapers found in the library is protected” (para. 149). The loss of “context” emphasized by the majority underlines the form, not the substance, of the databases, and, in my respectful view, is, as a result, inconsistent with the media neutral approach mandated by s. 3 of the *Copyright Act*.

94 This conclusion is reinforced by international copyright treaties to which Canada is a party, and which elaborate on the principle of media neutrality. In interpreting the *Copyright Act*'s application to new technologies, it is instructive to examine these treaties, including the *Berne Convention for the Protection of Literary and Artistic Works* (1886) and the *WIPO Copyright Treaty* (1996), CRNR/DC/94: see *Théberge*, at para. 71, and *SOCAN*, at para. 97.

95 Article 9 of the *Berne Convention* guarantees authors a right of reproduction of works “in any manner or form”, which the *WIPO Guide to the Copyright and Related Rights Treaties Administered by WIPO and Glossary of Copyright and Related Rights Terms* (2003), at p. 55, develops as follows:

BC9.6. The text of the *Berne Convention* does not contain any complete and explicit definition of “reproduction”. Certain elements of the concept of reproduction may, however, be identified in it. A good example is the clarification offered in Article 9(3) [sound or visual recordings deemed to be reproductions] ... which makes it obvious that it is not a condition that, on the basis of the reproduction, the copy of the work be directly perceivable; it is sufficient if the reproduced work may be made perceivable through appropriate equipment.

(See also *Apple Computer, F.C.T.D.*, at para. 81.)

96 Applying the WIPO Guide language to the newspaper context, “the work” is the publisher’s exercise of skill and judgment in selecting and editing the articles included in the newspaper. The entirety of the publishers’ newspapers, minus certain arrangement features, remains “perceivable”, as opposed to visually replicated, in the database because every article selected and edited by the publishers is contained in the database and marked as such.

97 That there is no loss of copyright by virtue of reproduction in digital storage form, such as databases, is further confirmed by an Agreed Statement concerning Art. 1(4) of the WIPO Treaty which is set out in a footnote to that article:

The reproduction right, as set out in Article 9 of the Berne Convention, and the exceptions permitted thereunder, fully apply in the digital environment, in particular to the use of works in digital form. It is understood that the storage of a protected work in digital form in an electronic medium constitutes a reproduction within the meaning of Article 9 of the Berne Convention.

Just as individual authors do not lose copyright in their articles by virtue of their inclusion in an electronic database, newspaper publishers do not lose their right to reproduce their newspaper, including the articles that comprise it, by doing the same.

98 The fact that the actual newspaper page is not fully or identically reproduced in the database, and the articles are therefore presented in a different form from a *paper* newspaper, is irrelevant. It is not the physical manifestation of the work that governs, it

is whether the product perceivably reproduces the exercise of skill and judgment by the publishers that went into the creation of the work.

99 The argument that, in order to remain within their right of reproduction, the publishers must enter the entirety of each newspaper into the database as an unwieldy stream of continuous text, rather than permitting each article to be viewed separately, finds no conceptual home in the *Copyright Act*. So long as a “substantial part” of the work is ultimately reproduced, the publisher’s entitlement under our media neutral *Copyright Act* is to be able to adjust the form of its work to suit the exigencies of new media technologies.

100 The exercise of skill and judgment producing the work — the newspaper — namely, the selection, editing and arrangement of articles, is what gives rise to the publishers’ copyright in the work. The databases reproduce fully both the publishers’ selection and editing of the articles appearing in the newspaper, as well as some of the arrangement. This being the case, the databases reproduce the newspaper. In my view, any difference between the print and database versions of the newspaper is attributable to the digital “form” alone, and thus does not detract from the publisher’s right to reproduce its newspaper in the online databases.

101 I would therefore dismiss the appeal, allow the cross-appeal, and dismiss the class action.

Appeal dismissed, cross-appeal allowed in part, MCLACHLIN C.J., BINNIE, ABELLA and CHARRON JJ., dissenting in part on the cross-appeal.

Solicitors for the appellant/respondent on cross-appeal: McGowan & Company, Toronto.

Solicitors for the respondents/appellants on cross-appeal: Torys, Toronto.

Solicitors for the interveners: McCarthy Tétrault, Toronto.