

Canadian Copyright Law and Indexing

by Donald Howes

Introduction

Copyright¹ is one of the four pillars of Canadian intellectual property (IP) law.² This article deals with Canadian copyright law, the international copyright and trade agreements that affect that law, and the relevant case law that illuminates the statute. The focus is on how this applies to the Canadian indexer creating an index for a domestic or foreign client.

Articles on copyright that have appeared in *The Indexer* demonstrate that interest in and the application to indexers of copyright law are sporadic at best and that the idea of copyright assertion is not often considered.³

While existing Canadian case law affirmatively addresses this issue (see "The Index as an Original Work," below), its existence is almost certainly unknown to indexing *clients*. It is therefore incumbent on every indexer to present each client with a logical copyright policy, as in many instances the client may not agree with the indexer's position on copyright ownership and will require a convincing argument in order to change their mind.

Part 1: Overview of Canadian Copyright

What Is Covered by Copyright?

Section 5(1) of the *Copyright Act* lists the categories of things in which copyright may subsist. This section states, in part, that "Subject to this Act, copyright shall subsist in Canada, for the term hereinafter mentioned, in every original literary, dramatic, musical and artistic work." The *Act* defines "*every original literary, dramatic, musical and artistic work*" as including

every original production in the literary, scientific or artistic domain, whatever may be the mode or form of its expression, such as compilations, books, pamphlets and other writings, lectures, dramatic or dramatico-musical works, musical works, translations, illustrations, sketches and plastic works relative to geography, topography, architecture or science.⁴

Further discussion of copyright in this article is confined to literary works. The *Act* defines a *literary work* as including "tables, computer programs, and compilations of literary works." As demonstrated in these definitions, the

legal determination of literary is broader than its common usage.⁵

Copyright Eligibility

A specific work must satisfy three requirements in order to determine whether it deserves copyright protection. These requirements are originality, fixation, and residency.

Originality

In 2004 the Supreme Court of Canada addressed the concept of originality,⁶ arriving at what was termed a "skill and judgement" standard. In this decision they assert:

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 or unique. What is required to attract copyright protection in the expression of an idea is an exercise of skill and judgment. By skill, I mean the use of one's knowledge, developed aptitude or practised ability in producing the work. By judgment, I mean the use of one's capacity for discernment or ability to form an opinion or evaluation by comparing different possible options in producing the work. This exercise of skill and judgment will necessarily involve intellectual effort.⁷

The Court goes on to state that the skill and judgement employed must be non-trivial in nature before a work can be judged original. That is, simply changing the font of a previous work would not make the new version an original work subject to copyright protection.

Fixation⁸

Under copyright law it is not possible to copyright an idea, only the expression of that idea.

As Tomkowicz has stated, "although the requirement of fixation is uncontroversial, its practical effects can sometimes be harsh."⁹ In general, it is the person who "fixes" the idea that is considered the author of the work and the first holder of copyright.¹⁰

That the ownership of copyright abides in the individual who fixes the work was reaffirmed in 1998, in cases that covered, first, the copyright status of photographs, tape recordings, and written notes,¹¹ and second, the reuse of previously published interview quotes by a third party.¹²

In both cases, copyright was affirmed to be held by the individual who first fixed the content.¹³

Residency

In order to qualify for copyright protection within Canada, the author of a work must be a Canadian citizen or resident or a citizen of or resident in a treaty country.¹⁴ A **treaty country** is defined in the **Act** as a “Berne Convention country, UCC country, WCT country or WTO Member.”¹⁵

International Copyright and Trade Agreements

Canadian copyright protection is extended to any work published by someone who resides in a country that is a member of the Berne Convention, the UCC, the WCT, or the WTO.¹⁶ Of these agreements, the Berne Convention is the primary international copyright agreement.

This protection is reciprocated by member nations to Canadian authors through what is called “national treatment”. That is,

In copyright treaties, national treatment means that each country signatory to the treaty must give citizens and permanent residents of other signatory countries at least the same copyright protections that it gives its own nationals.¹⁷

Regardless of national treatment, indexers should be familiar with the copyright law of the client’s country of residence, as it will be different in detail from that of Canada.

In addition to international copyright agreements, Canada is a signatory to bilateral and multilateral trade agreements that have significant intellectual property sections. These include TRIPS, CETA, CPTPP, and CUSMA.¹⁸

Copyright Economic and Moral Rights

The **Copyright Act** lists two broad categories of rights enjoyed by the copyright owner; they are economic rights and moral rights.

Economic Rights

The economic rights given by copyright ownership are a group of sole rights that are individually severable. That is, the copyright owner can sell, license, or give away these rights, in whole or in part, to a third party through particular contract conditions.

The preamble to section 3(1) of the **Copyright Act** lists the core rights held by the owner:

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 thereof¹⁹ in any material form whatever, to perform the work or any substantial part thereof in public or, if the work is unpublished, to publish the work or any substantial part thereof.²⁰

Murray and Trosow explain “**sole right**” as meaning

the owner of the right not only can do the thing specified, but also can exclude others from doing it. For example, the right of reproduction does not just grant the owner the right to make reproductions of the work, it excludes the rest of the world from doing so without the owner’s consent. The word “sole” is why copyright is referred to as a sort of monopoly.²¹

Section 27 of the **Act** lays out what constitutes infringement of economic rights.

Moral Rights

In addition to economic rights, the **Copyright Act** also enumerates the moral rights that adhere to the copyright owner.²² Unlike economic rights, moral rights can be inherited or waived (in whole or in part) but they cannot be assigned. Moral rights allow the author to protect the integrity of their work.

The **Copyright Act** provides for three moral rights:²³

- right to the integrity of the work²⁴
- right to be associated with the work as its author by name or under a pseudonym
- right to remain anonymous.

Sections 28.1–28.2 of the **Act** lay out what constitutes infringement of moral rights.

Part 2: Copyright and the Indexer

Self-Employed or Employee?

The Canada Revenue Agency (CRA) determines the employment status of an individual by looking at **intent**.²⁵ Did the indexer intend to enter a **contract of service** (employer-employee relationship, whether contract or full-time) or did they intend to enter a **contract for services** (a business relationship with a self-employed independent contractor). In almost all instances, an indexer enters into a **contract-for-services** relationship with their client.

It is clear that most indexers will meet all the CRA requirements to qualify as self-employed. This has implications for application of the **Copyright Act**.²⁶

Is an Index a Literary Work?

This determination is important, because if an index is a literary work, the indexer would be considered the author of that work. Since I have shown that the CRA considers most indexers as self-employed freelancers, Section 13(1) of the *Copyright Act* applies to them: “Subject to this Act, the author of a work shall be the first owner of the copyright therein.”

Recall that the legal definition of a literary work (see “**What is Covered by Copyright?**” above) is broad and includes many things one would not normally consider “literary.” From that description it is clear that an index meets the threshold of a literary work, and it is equally clear that the indexer is the one who fixes the index (see “**Fixation,**” above) in its physical form and is, therefore, its author. However, whether an index is a work that is eligible for copyright protection depends on its meeting the standard for originality (see “**Originality,**” above) as defined in case law.

The Index as an Original Work

What is an index? Mulvaney identifies the index as a “paratext”: “As paratext, the book index bridges a gap between author and reader. It reconciles the vocabulary of the reader with that of the author.”²⁷ Meanwhile, Kasdorf states:

Whereas the Glossary provides a shallow, topical view of the content, and the Table of Contents provides a logical, structured view, a good index provides an intellectual view of the content unavailable by any other means. It is the result of an intelligent reading by an indexer trained in recognizing and documenting the interrelationships of the intellectual content: the indexer not only notes topics and subtopics, but also makes judgements about them, selecting the most important and relevant sections to direct readers to.²⁸

The purpose and originality of an index is also understood by standards organizations.²⁹

As part of the decision in *CCH Canadian Ltd. v. Law Society of Upper Canada*, the Supreme Court looked at four classes of work to determine whether they met the standard of originality set forth earlier in the decision and therefore constituted original works in which copyright subsists. The four classes are:

- headnotes (abstract)
- case summary
- topical indexes
- compilations of reported judicial decisions.

The Court found that all four of these classes of work met the “skill and judgement” standard for originality and were subject to copyright.³⁰

While a topical index is a specialized type of legal index, it is reasonable to conclude that the Court would consider all indexes to be original works in which copyright subsists.

Infringement of Economic or Moral Rights

In theory, if you believe your economic or moral rights have been infringed, you can seek injunctive relief from the courts to halt the infringement and damages to compensate for that infringement. In practice it is difficult and expensive for individuals to bring a copyright action, as that action may have to be litigated all the way to the Supreme Court of Canada.

As an alternative, the *Copyright Act* allows for collective societies to represent individual copyright holders.³¹ However, rights granted to the collective by the copyright owners may have a significant bearing on the ability of the collective to take effective action on behalf of its members.³² Every indexer should investigate this issue carefully before deciding on which collective society best represents their interests.

Conclusions

From the analysis above, it is clear that an index created by a Canadian indexer meets the requirements of originality, fixation, and residency needed to qualify under Canadian copyright law as an original work in which copyright subsists. If the indexer is a self-employed freelancer, they are the first holder of copyright in that original work.

As the holder of copyright, it is important that the indexer have a contract that adequately covers the economic rights that are being assigned to the client, that clearly lays out the conditions that govern the assignment of those rights, and that asserts their moral rights.

Afterword

If this article prompts you to further investigate Canadian copyright, the three Supreme Court copyright decisions that are particularly applicable to literary works are *CCH, Alberta (Education)*, and *York University*. While the thought of reading legal decisions may be intimidating, I’m sure you will be (as I was) pleasantly surprised to find them logical, clearly worded, and remarkably absent of jargon. The justices can also be refreshingly blunt in their decisions.

Additionally, the *CCH* decision dramatically changed the course of copyright law in Canada and has been

fundamental to every Supreme Court copyright decision since 2004. If you have any interest in copyright, you must understand this decision. There is a plethora of legal scholarship freely available on this and other Supreme Court copyright decisions, most of it quite readable.³³ Enjoy!

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About the Author

Donald Howes is a freelance indexer who provides back-of-book and embedded indexes for a diverse clientele. You can reach him through his website (www.dhindexing.ca) and by email at dwhowes@shaw.ca.

Notes

1. *Copyright Act*, R.S.C., 1985, c. C-42.
2. The other three pillars are patent (*Patent Act*, R.S.C., 1985, c. P-4), trademark (*Trademarks Act*, R.S.C., 1985, c. T-13), and case law that applies to confidential information and trade secrets.
3. Tamara Eisenschitz, "Copyright for Indexers," *The Indexer* 14, no. 4 (1985): 253–54; Christine Jacobs, "Around the World," *The Indexer* 23, no. 2 (2002): 92–93; Geraldine Triffitt, "Bibliography in a Digital Age," *The Indexer* 26, no. 3 (2008): 127–31; Karen Gillen, "'There's Many a Slip 'Twixt Cup and Lip': Acknowledgement of Indexers on Imprint Pages," *The Indexer* 37, no. 2 (2019): 177–84.
4. *Copyright Act*, s. 2.
5. See *University of London Press, Limited v. University Tutorial Press, Limited*, [1916 U. 119] [1916] 2 Ch. 601 for a discussion of the meaning of literary that is cited in current Canadian case law.
6. For an overview of the development of originality in Canadian copyright law, see Carys J. Craig, "The Evolution of Originality in Canadian Copyright Law: Authorship, Reward and the Public Interest," *University of Ottawa Law and Technology Journal* 2, no. 2 (2005): 425–45. https://digital-commons.osgoode.yorku.ca/scholarly_works/1410/.
7. *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 SCR 339, at para. 16.
8. "Fixation," as it appears in this article, applies only to printed works or digital representations of those works. The *Copyright Act* also deals with fixation (or the explicitly defined lack of it) for a number of different classes of work.
9. Robert Tomkowicz, "Copyright in Ideas: Equitable Ownership of Copyright," *Canadian Intellectual Property Review* 29, no. 1 (2013): 76, <https://canlii.ca/t/sr9w>.
10. That the case law on fixation identifies the individual who fixes the work as the author is important, since, while the *Copyright Act* uses the term author in its discussion of ownership of copyright, that term is not defined in the *Act*.
11. *Glen Gould Estate v. Stoddart Publishing Co. Ltd.*, [1998] CanLII 5513 (ON CA).
12. *Hager v. ECW Press Ltd.*, 1998 CanLII 9115 (FC), [1999] 2 FC 287.
13. Fixation was also addressed in the *CCH* case; see para. 8.
14. *Copyright Act*, s. 5(1)(a).
15. *Copyright Act*, s. 2.
16. *Berne Convention for the Protection of Literary and Artistic Works*, World Intellectual Property Organization; UCC: *Universal Copyright Convention*, UNESCO; WCT: *WIPO Copyright Treaty (1996)*, World Intellectual Property Organization; WTO: World Trade Organization.
17. Lesley Ellen Harris, *Canadian Copyright Law*, 4th ed. (Hoboken, NJ: John Wiley & Sons, 2014), 58.
18. *TRIPS: Agreement on Trade-Related Aspects of Intellectual Property Rights*, World Trade Organization; *CETA: Canada–European Union Comprehensive Economic and Trade Agreement Implementation Act*, S.C. 2017, c. 6; CPTPP: *Comprehensive and Progressive Agreement for Trans-Pacific Partnership Implementation Act*, S.C. 2018, c. 23; CUSMA: *Canada–United States–Mexico Agreement Implementation Act*, S.C. 2020, c. 1.
19. The substantiality requirement is frequently involved in litigation. Both *CCH* and *Alberta (Education) v. Canadian Copyright Licensing Agency (Access Copyright)*, [2012] 2 SCR 345], contribute significantly to the case law in this area.
20. *Copyright Act*, s. 3(1). See sub-sections 3(1)(a) to 3(1)(j) for specific enumerations of the core rights.
21. Laura J. Murray and Samuel E. Trosow, *Canadian Copyright: A Citizen's Guide*, 2nd ed. (Toronto: Between the Lines, 2013), 55.
22. *Copyright Act*, s. 14.1(1)–14.1(4).
23. *Copyright Act*, s. 14.1(1).
24. The best-known Canadian moral rights case turns on this right. In *Snow v. The Eaton Centre Ltd. et al.*, (1982) 70 C.P.R. (2d) 105 (Ont. H.C.), the artist Michael Snow obtained injunctive relief against Toronto's Eaton Centre, forcing

the removal of ribbons they had added to his sculpture of flying geese. As Vaver says, “The Ontario High Court upheld the artist’s judgment that the modifications were ‘prejudicial to his honour or reputation’”; see David Vaver, “Authors’ Moral Rights: Reform Proposals in Canada; Charter or Barter of Rights for Creators?” *Osgoode Hall Law Journal* 25, no. 4 (1987): 758). An overview of the case can be found at <https://www.cipil.law.cam.ac.uk/virtual-museum/snow-v-eaton-centre-ltd-1982-70-cpr-2d-105>.

25. Canada Revenue Agency, *Employee or Self-employed?* RC4110(E) rev. 20, accessed 28 July 2021, https://www.canada.ca/en/revenue-agency/services/forms-publications/publications/rc4110/employee-self-employed.html#workers_employment_status. The document contains exhaustive detail on this and other matters.

26. Whether s. 13(3) of the *Copyright Act* applies to indexers depends on their employment status. This section states, in part: “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.”

27. Nancy C. Mulvaney, *Indexing Books*, 2nd ed. (Chicago, IL: University of Chicago Press, 2005), 6.

28. William E. Kasdorf, *The Columbia Guide to Digital Publishing (New York: Columbia University Press, 2003)*, cited in Mulvaney, 6.

29. See the current US standard: National Information Standards Organization, ANSI/NISO Z39.4-2021 *Criteria for Indexes*, July 14, 2021, 4–5, <https://www.niso.org/publications/z394-2021-indexes>.

30. CCH, para. 28–34.

31. See the website of the Canadian Authors Association, which maintains a list of organizations that represent Canadian authors and authors’ rights, <https://canadianauthors.org/national/advocacy/organizations/>.

32. For example, Access Copyright has an almost 20-year history of losing copyright cases at the Supreme Court of Canada. In *York University v. Canadian Copyright Licensing Agency (Access Copyright)*, (2021) SCC 32, Justice Abella bluntly identifies its root problem: “The source of Access Copyright’s grievance, it seems to me, stems not so much from the voluntary nature of an approved tariff, but from the fact that Access Copyright cannot initiate infringement actions on behalf of its members. To the extent that this is a problem, it has nothing to do with s. 68.2(1) and is largely outside the scope of this appeal. But it is important to recall that Access Copyright chooses to operate on the terms of

a non-exclusive licence that does not give it the right to sue for infringement in respect of the rights it administers. Nothing compels Access Copyright and its members to operate this way” (para 74).

33. The website of the Canadian Legal Information Institute, <https://www.canlii.org/en/>, is an invaluable resource.

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