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Derivative Works and Unauthorized Indexes. Part 1: Derivative Works

by Donald Howes

Introduction

Indexes share with adaptations and translations[1] the distinction of being derivative works[2] in which copyright subsists.[3] In cases where the copyright holder creates the derivative work, or has authorized another individual to create that work, there is no conflict between the holders of copyright in the underlying and derivative works. But is that the case when the creation of the derivative work is unauthorized?

Consider the following hypothetical case:

> ***Alex is an author who publishes a non-fiction book that is lacking an index. After publication, Isabel, who is a professional indexer, purchases a copy of the book. Isabel creates an index for Alex's book, which she then posts on her website, where visitors can view and download the index. Has Isabel infringed[4] Alex's copyright?***

This is something many indexers (myself included) have done, as a way to showcase their skill to potential clients early in their careers.

Note that these two articles (this and the following article on unauthorized indexes) are unavoidably theoretical in scope and somewhat speculative in tone. There is limited case law that addresses derivative works,[5] so precisely how the relevant sections of the ***Copyright Act*** would be interpreted is not yet settled. However, modern scholarship in the field of translation studies, and that of adaptations more generally, advances positions vis-à-vis copyright that have potential applicability to indexes.

Derivative Works

William Braithwaite defines a ***derivative work*** as:

> the contribution of further creative effort to an existing intellectual product to produce a new and different intellectual product. This new creation is known in copyright law as a "derivative work." … A derivative work, by definition, involves a second tier of creative effort superimposed upon that of the underlying author.[6]

Braithwaite recognizes three instances in which a derivative work may be created:

> first, where the underlying work is in the public domain, that is, the underlying work is not or no longer is, the subject of copyright; second, where there is copyright in the underlying work and the owner of the copyright produces the derivative work; and third, where the derivative work is produced by someone else, with or without the permission of the owner of the copyright in the underlying work.[7]

While derivative works are afforded copyright protection,[8] only the creation of a derivative work without permission of the copyright owner is problematic, since s. 3(1) of the ***Act*** gives the copyright holder the sole right to "produce or reproduce the work or any substantial[9] part thereof in any material form whatever."

In this case, the question to be answered is—does an unauthorized index constitute the reproduction of a "substantial part" of the underlying work?

Translations

During the 18th and early 19th centuries, translations were acknowledged not only as works that deserved copyright protection, but also as original works that did not infringe the copyright of the underlying source text.[10] This changed in the mid-19th century with the development of a new conceptual paradigm of copyright and the concomitant development of a new idea of authorship.[11] These changes are reflected in **the Berne Convention**[12] and, in fact, were a major catalyst for the creation of the **Convention**.[13]

In article 2(3), the **Convention** lists translations as protected original works: "Translations, adaptations, arrangements of music and other alterations of a literary or artistic work shall be protected as original works without prejudice to the copyright in the original work." As Tong points out, the phrase "original work" has two distinct senses in this article: "first, that translations are to be considered on the same footing as other works protected under the Convention; and second, that they are nonetheless to be considered derivative (i.e., non-original) in relation to an antecedent work that is translated."[14]

Additionally, article 8 of the **Convention** treats the right of translation as follows: "Authors of literary and artistic

works protected by this Convention shall enjoy the exclusive right of making and of authorizing the translation of their works throughout the term of protection of their rights in the original works." There is an inherent contradiction here—between the originality of a translation, on the one hand, and the right of the author of the source text to control the creation of that translation.[15]

This contradiction is reflected in the Canadian *Copyright Act*, where the definition of "**every original literary, dramatic, musical and artistic work"** lists translations as a separate class of work in which copyright subsists. But the ***Act*** also gives the copyright owner the sole right "to produce, reproduce, perform or publish any translation of the work."[16]

Attempts to resolve this contradiction is one of the driving forces in translation studies.[17] As Basalamah has stated,

> On the one hand, the language (the form) of the work changes, and, on the other, the work passes from one set of culturally-influenced potential interpretations or readings to another, thereby adding a supplementary dimension to the original. The resulting translation necessarily escapes the original's interpretative determinations ... how can the original remain present within the translation, when the change in language constitutes a major change in form, and it is the form alone—the expression—which is protected under copyright?[18]

Venuti also comments on this contradiction:

> since authorship here is defined as the creation of a form or medium of expression, not an idea, as originality of language, not thought, British and American law permits translations to be copyrighted in the translator's name, recognizing that the translator uses another language for the foreign text and therefore can be understood as creating an original work … In copyright law, the translator is and is not an author.[19]

Taken to its logical conclusion, attempts to solve this contradiction have allowed some scholars in translation studies to advocate the position that a translation is a distinct original work.[20] This work is related to, but not dependent on, the underlying source text.[21] Tong takes a more centrist path, advocating a distributed approach to originality and authorship.[22] He states:

> It is in this light that the duplicity of the term "original" in Art. 2(3) Berne Convention should be properly understood. There is no necessary contradiction in the proposition that a translation is and is not an original, or that a translator is and is not an author at the same time, if we understand authorship and originality not as bounded concepts but as distributed ones. The paradox on the face of the language should not prevent us from acknowledging that copyright law does afford translation and translators their own tier of originality/authorship.[23]

Adaptations

In a similar vein to the scholarship on translations, van Eechoud holds that adaptations should be considered as a general category of work and something distinct from copies (reproductions): "I use adaptation as the more general term that covers the realm beyond mere direct copying, that of the reworking of works whether in text, image or sound. When I speak of 'copying' it refers to taking verbatim or literal parts."[24]

The rights of reproduction and adaptation are explicitly granted to the copyright holder in the ***Copyright Act***.[25] However, the act of creating an adaptation may create a situation where the relationship between the source and the adaptation is complex and hard to define. The distinction between copying (reproduction) and adaptation is important for two reasons:

> The first is that copying does not give rise to new rights, whereas the making of an adaptation often will. Standards of originality required for copyright protection are low, so the adaptation will qualify as a protected work itself. The second reason is that ***copying without permission—in whole or in part—will normally infringe whereas creating something on the basis of another work without literal copying might not***.[26]

When an analysis is being made as to whether copyright has been infringed by an adaptation, the following holds:

> To lawyers, adaptations are not about what is lost, but about what is not lost ... The predominant view in law is that what matters is how much has been taken, not how much has been added[27] ... ***when courts are called upon to decide whether a work is original, they tend to consider the creative space that was available to the author in the case at hand***. If such space existed, the work is judged to be original. No particular comparison is made with other creations to ascertain originality, the existence of creative space suffices. If on the other hand ***courts are asked to judge whether a work infringes, they will compare the later with one very specific earlier work***.[28]

Canadian courts take this holistic approach to the determination of infringement. This also explains how a derivative work can potentially be simultaneously both original and infringing.

Afterword

The two questions posed above—whether an unauthorized index constitutes a "substantial part" of the source work, and whether an unauthorized index infringes the copyright of the source work—will be answered in Part 2: "Unauthorized Indexes."

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Notes

1. The Copyright Act (Canada, Copyright Act, R.S.C., 1985, c. C-42, https://laws-lois.justice.gc.ca/eng/acts/c-42/fulltext.html) does not define either adaptation or translation, but s. 3(1)(a)–3(1)(e) lists the sole adaptation rights held by the copyright owner, including translation. As a comparison, UK copyright law (Copyright, Designs and Patents Act 1988, https://www.legislation.gov.uk/ukpga/1988/48/contents) in s. 16(1)(e) grants the exclusive right to create an adaptation, while s. 21(3)(a)(i) defines a translation as an adaptation in respect to literary and dramatic works; US Copyright Law (Copyright Act of 1976, 17 U.S.C., https://www.copyright.gov/title17/title17.pdf), in 17 U.S.C. §106(2) grants the copyright holder the right to create derivative works, and 17 U.S.C. §101 defines derivative works to include translations.

2. The Canadian Copyright Act (see note 1, above) does not define or directly address derivative works. However, many of the sub-sections of s. 3(1) enumerate sole rights that are derivative in nature. US copyright law (17 U.S.C § 101) defines a "derivative work" very broadly:

A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations or other modifications which, as a whole, represent an original work of authorship, is a derivative work.

While UK copyright law does not define "derivative work," the UK copyright service does: "A derivative work is a work that is based on (derived from) another work; for example a painting based on a photograph, a collage, a musical work based on an existing piece or samples, a screenplay based on a book" (UK Copyright Service, Fact Sheet P-22, "Derivative Works," https://copyrightservice.co.uk/copyright/p22_derivative_works), and holds that derivative works can be produced only with permission of the copyright holder. Note that this is at odds with the narrow definition of literary adaptations as defined in the Act, where literary adaptations are restricted to translations, dramatizations, and the conveyance of the story wholly or in part by pictures; Copyright, Designs and Patents Act, s. 21(3)(1)(i)-(iii).

3. See Donald Howes, "Canadian Copyright Law and Indexing," ISC/SCI Bulletin 43, no. 3 (2021): 19–23, https://tinyurl.com/mr2hnpz3, for an examination of the copyright status of indexes under Canadian copyright law.

4. Under Canada, Copyright Act, s. 2, "infringing means: (a) in relation to a work in which copyright subsists, any copy, including any colourable imitation, made or dealt with in contravention of this Act." There are additional definitions that cover performance, sound recording, and telecommunications that are not relevant here. Merriam-Webster defines colourable as "having an appearance of truth, validity, or right," https://www.merriam-webster.com/dictionary/colorable#legalDictionary.

5. See Théberge v. Galerie d'Art du Petit Champlain Inc ([2002] 2 SCR 336, https://scc-csc.lexum.com/scc-csc/scc-csc/en/item/1973/index.do, at paras. 49, 56, 70–73); Beach v. Toronto Real Estate Board (2009 CanLII 68183 (ON SC), https://canlii.ca/t/26xg8 at para. 101; and Desgagné c. Groupe Ville-Marie Littérature inc. (2015 QCCS 5448 (CanLII), https://canlii.ca/t/gm810 at para. 52. The large majority of decisions that even tangentially involve derivative works are narrowly divided on whether contract or user agreement provisions governing the creation and/or distribution of derivative works had been violated. Those decisions deal mainly with contract, not copyright, law.

6. William Braithwaite, "Derivative Works in Canadian Copyright Law," Osgoode Hall Law Journal 20, no. 2 (1982): 191–231, http://digitalcommons.osgoode.yorku.ca/ohlj/vol20/iss2/1, 192, 193.

7. Ibid., 193.

8. See Canada, Copyright Act, s. 5, for the conditions in which copyright will subsist in a work. I have previously shown that copyright subsists in an index as an original work (Howes, "Canadian Copyright Law"). Authorization (or its lack) does not effect that protection.

9. "Substantial" is not defined in the Copyright Act, making this an area of frequent litigation.

10. See Burnett v. Chetwood [1720] 35 Eng. Rep. 1008; 2 Mer 439, Millar v. Taylor [1769] 98 Eng. Rep. 201; 4 Burr 2303, Wyatt v. Barnard [1814] 35 Eng. Rep. 408; 3 V. & B. 77; and Stowe v. Thomas [1853] 23 F. Cas. 201. All these cases held that a translation was an original work in its own right and did not infringe the copyright of the source text.

11. Lee identifies this paradigm shift in copyright as a change "from the right to print a work (the Gutenberg Model) to the right to revenues generated by a work in the market (the Market Model)." As part of the actualization of this change, the idea of authorship also changes, so that "an original work is seen as authentic in that it ostensibly captures the author's thoughts and feelings directly, unmediated by transindividual determinants (linguistic, cultural, social) that might complicate authorial identity and originality ... The implication is that a translation is always of a derivative order and subsidiary status." This leads inexorably to the conclusion that an unauthorized translation is a violation of the copyright held by the author of the original text. Tong King Lee, "Translation and Copyright: Towards a Distributed View of Originality and Authorship", The Translator 26, no. 3 (2020): 246.

12. Berne Convention for the Protection of Literary and Artistic Works, World Intellectual Property Organization, https://wipolex.wipo.int/en/text/283698.

13. Lee, "Translation and Copyright," 243–45.

14. Ibid., 251.

15. This contradiction arises because the word original is being used in both its legal and ordinary senses within these articles; ibid. A translation (like an index) can never be "original" in the ordinary sense, since it is based on a source text. Its legal originality "lies in the cognitive effort expended by a translator in rendering a text from one language into another. Cognitive effort is entailed in, for instance, the selection of specific words from among a range of candidates in the target language to translate corresponding words in the original text"; ibid., 251, citing Vaver. This language should sound very familiar to an indexer, as it echoes how we describe the index creation process. It also echoes the language used in the CCH decision (CCH Canadian Ltd. v. Law Society of Upper Canada, [2004] 1 SCR 339, https://decisions.scc-csc.ca/scc-csc/scc-csc/en/item/2125/index.do) for the determination of originality. See CCH, para. 16.

16. Canada, Copyright Act, s. 3(1)(a). To make matters even more confusing, translators are considered to be the authors and first holders of copyright in their translations; David Vaver, "Translation and Copyright: A Canadian Focus," European Intellectual Property Review 16, no. 4 (1994): 161, https://digitalcommons.osgoode.yorku.ca/scholarly_works/1250/. The acknowledgement of an independent copyright for translations is longstanding; ibid., 160.

17. Much of the recent criticism in translation studies of the relationship between translations and copyright takes a post-positivist and post-colonial perspective and can become quite forceful. See, for example, David Venuti, The Scandals of Translation: Towards an Ethics of Difference (Milton Park, UK: Routledge, 1998); The Translator's Invisibility: A History of Translation (Milton Park, UK: Routledge, 2003); Translation Changes Everything: Theory and Practice (Milton Park, UK: Routledge, 2013); and Contra Instrumentalism: A Translation Polemic (Milton Park, UK: Routledge, 2019).

18. Salah Basalamah, "Translation Rights and the Philosophy of Translation," in Translation: Reflections, Refractions, Transformations, ed. Paul St-Pierre and Prafulla C. Kar, 117–32 (Amsterdam: John Benjamins, 2007), 122.

19. Venuti, Translator's Invisibility, 8.

20. What was old is new again. These scholars are advocating a position that was held in British and American case law until the mid-19th century; see note 10 above.

21. See Basalamah, "Translation Rights," 122–23; and Venuti, Scandals of Translation, 62–66. See also Mireille van Eechoud, "Adapting the Work," in The Work of Authorship (Amsterdam: University of Amsterdam Press, 2014), 145–73, on adaptations in general.

22. Lee, "Translation and Copyright," 252–54.

23. Ibid., 253.

24. Van Eechoud, "Adapting," 147–48.

25. While the Copyright Act does not specifically name them as such, s. 3(1)(b) – 3(1)(e) specify the adaptation rights reserved to the copyright holder.

26. Van Eechoud, "Adapting," 148 [emphasis added].

27. Canadian courts take a more holistic view of the determination of infringement than the EU and European national courts that van Eechoud studies in her article; see Cinar Corporation v. Robinson [2013] 3 SCR 1168, https://decisions.scc-csc.ca/scc-csc/scc-csc/en/item/13390/index.do, paras. 34–36, 41, 143.

28. Van Eechoud, "Adapting," 160 [emphasis added].