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Derivative Works and Unauthorized Indexes. *Part 2:* Unauthorized Indexes

by Donald Howes

In Part 1 of this article I examined derivative works, translations, and adaptations, focusing on how those three classes of works relate to Canadian copyright law. In this second part, I examine unauthorized indexes and answer the two questions that arose in Part 1: First, does an unauthorized index infringe the source text?[1] And second, does an unauthorized index constitute a "substantial part" of the source as defined by Canadian copyright law?

Unauthorized Indexes

An index is, by definition, a derivative work. The creation of an index requires the existence of a source text. In almost all instances, an indexer creates an index as part of a contractual relationship with the author or publisher of the original work. However, if the index is unauthorized, the potential for infringing the underlying work arises.

It is clear that the unauthorized index meets the requirement of originality as defined in ***CCH2***and qualifies as an original work in which copyright subsists. However, because of the unsettled nature of this area of law, arguments can be made both for and against this unauthorized index infringing the original work.

Infringing

Braithwaite,[3] Vaver,[4] and Zener and Etkin[5] all take it as given that the creation of an unauthorized derivative work is an infringement of the underlying source.[6] If they are correct, then the holder of copyright in the infringed work could take action to enforce copyright. The copyright holder could potentially compel the removal of the unauthorized index from the indexer's website and the destruction of all copies of the index. This is due to both the infringement of the original copyright and the subordinate nature of the copyright held by the indexer in relation to the original work (fig. 1).

The copyright holder of the original work could not use the unauthorized index without permission, as to do so would be a violation of the copyright held by the indexer. However, compelling arguments can be made that an unauthorized index does ***not*** infringe the source material copyright.

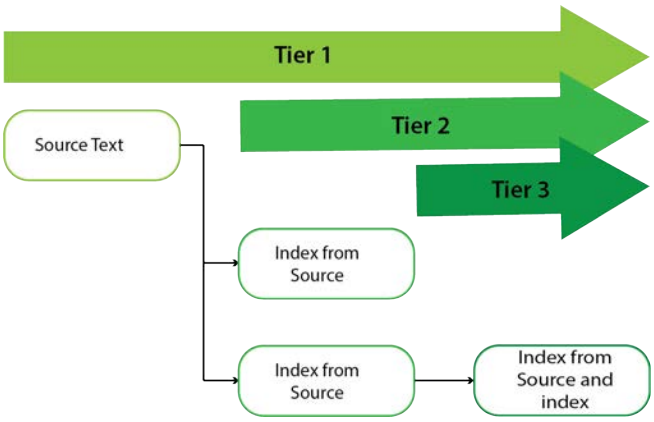

Figure 1. Distributed relationship of originality. Authors at each tier hold a subordinate copyright to that of the authors at higher-level tiers.

No Infringement

Three strong arguments can be made to support the assertion that an unauthorized index does not infringe the copyright of the source text. The first of these arguments deals with the substantiality requirement for infringement. The second falls under the doctrine of **user rights** as promulgated by the Supreme Court of Canada.[7] The third deals with the conceptual basis of an index.

Note that the holder of copyright in the original work could potentially attempt to compel action on the part of the indexer through invocation of the moral right they hold to maintain the integrity of their work.[8] However, an action of this type would be very problematic in the case of an unauthorized index, given the arguments made below.

Substantiality

For a work to infringe the copyright of another, the material being copied must be substantial. Most recently, in ***Cinar Corporation v. Robinson***,[9] the Supreme Court of Canada dealt extensively with the concept of substantiality.

Since what is substantial is not defined in the ***Copyright Act***, the Court first addresses substantiality:

> The Act protects ***original*** literary, dramatic, musical, and artistic works: s. 5. It protects the expression of ideas in these works, rather than ideas in and of themselves. An original work is the expression of an idea through an exercise of skill and judgment. Infringement consists of the unauthorized taking of that originality.
>
> However, the Act does not protect every "particle" of an original work, "any little piece the taking of which cannot affect the value of [the] work as a whole". Section 3 of the ***Copyright Act*** provides that the copyright owner has the sole right to reproduce "the work or any substantial part thereof".
>
> A substantial part of a work is a flexible notion. It is a matter of fact and degree. "Whether a part is substantial must be decided by its quality rather than its quantity". What constitutes a substantial part is determined in relation to the originality of the work that warrants the protection of the ***Copyright Act***. As a general proposition, a substantial part of a work is a part of the work that represents a substantial portion of the author's skill and judgment expressed therein.
>
> A substantial part of a work is not limited to the words on the page or the brushstrokes on the canvas. The Act protects authors against both literal and non-literal copying, so long as the copied material forms a substantial part of the infringed work. (paras. 24–27, citations omitted)

They then examine the approach to be taken when determining substantiality:

> As a general matter, it is important to not conduct the substantiality analysis by dealing with the copied features piecemeal. (p. 1173)
>
> Canadian courts have generally adopted a qualitative and holistic approach to assessing substantiality. "The character of the works will be looked at, and the court will in all cases look, not at isolated passages, but at the two works as a whole to see whether the use by the defendant has unduly interfered with the plaintiff's right." (para. 35, citation omitted)

Finally, they make clear the importance of assessing substantiality from the view of the potentially infringed work:

> The question of whether there has been substantial copying focuses on whether the copied features constitute a substantial part ***of the plaintiff's work***—not whether they amount to a substantial part ***of the defendant's work***. The alteration of copied features or their integration into a work that is notably different from the plaintiff's work does not necessarily preclude a claim that a substantial part of a work has been copied.
>
> ***This is not to say that differences are irrelevant to the substantiality analysis. If the differences are so great that the work, viewed as a whole, is not an imitation but rather a new and original work, then there is no infringement.*** As the Court of Appeal put it, "the differences may have no impact if the borrowing remains substantial. Conversely, the result may also be a novel and original work simply inspired by the first. Everything is therefore a matter of nuance, degree, and context." (paras. 39–40, emphasis added)

As Sookman has noted,

> An infringing work may also be an original work. Accordingly, this passage by the Court might be interpreted to mean that substantial differences in two works may suggest that the defendant has not reproduced all or any substantial part of the allegedly infringed work.[10]

By focusing on the factual and conceptual content of a work rather than the "expression of an idea through an exercise of skill and judgment" (this is explored in more detail below), an index does not substantially duplicate the ***expression*** of the underlying work, which is what copyright protects. Indeed, the indexer will often draw connections and highlight relationships between facts and concepts that are not explicitly expressed in the underlying work. Drawing from the arguments advanced by Basalamah in relation to translations,[11] this change in form is sufficiently substantial as to render the index a new, original, non-infringing work.

To answer the question posed earlier, an unauthorized index does not substantially reproduce the content of the underlying work and therefore does not infringe the copyright of that underlying work.

User-Generated Content Exception

The user-generated content (UGC) exception was added to the ***Copyright Act*** in 2012 and, despite attempts by stakeholders in the publishing industry to have it weakened or removed, will remain in the Act in its present form (fig. 2).[12] The UGC exception codified what had become common practice with the development of digital social media platforms, what is known as "Web 2.0."[13] This is but the latest twist in a practice that has been common for centuries.[14]

Non-commercial user-generated content

29.21 (1) It is not an infringement of copyright for an individual to use an existing work or other subject-matter or copy of one, which has been published or otherwise made available to the public, in the creation of a new work or other subject-matter in which copyright subsists and for the individual—or, with the individual's authorization, a member of their household—to use the new work or other subject-matter or to authorize an intermediary to disseminate it, if

(a) the use of, or the authorization to disseminate, the new work or other subject-matter is done solely for non-commercial purposes;

(b) the source—and, if given in the source, the name of the author, performer, maker or broadcaster—of the existing work or other subject-matter or copy of it are mentioned, if it is reasonable in the circumstances to do so;

(c) the individual had reasonable grounds to believe that the existing work or other subject-matter or copy of it, as the case may be, was not infringing copyright; and

(d) the use of, or the authorization to disseminate, the new work or other subject-matter does not have a substantial adverse effect, financial or otherwise, on the exploitation or potential exploitation of the existing work or other subject-matter—or copy of it—or on an existing or potential market for it, including that the new work or other subject-matter is not a substitute for the existing one.

Figure 2. Copyright Act, section 29.21, non-commercial user-generated content exception

A common example of UGC is when a parent records their child dancing to a piece of popular music, then posts the video to social media. The use of the music in this context would be covered by UGC and the creator of the video would not be liable for copyright infringement. This example (and others like it) explains why the UGC exception is often called the "YouTube exception."

However, as Scassa points out, there is nothing in the language of the Act that limits the application of the UGC exception to digital content:

> To qualify as UGC for the purposes of this exception, the author of UGC must use an existing work—with no limitations on kind or category; and they must use it to create a new work in which copyright subsists.
>
> This is a very broad definition with the potential to include all manner of works. Leaving aside dancing toddlers, ***the exception is broad enough to include things such as an unauthorized translation of a work***, and a compilation (which can be a work that is comprised of other works) … the UGC exception seems not only to include such a creature within the definition of UGC, it also legitimates the non-commercial distribution.[15] (emphasis added)

If the UGC exception is flexible enough to cover an unauthorized translation (where the entire source text is translated) or a compilation (where multiple works are aggregated), it is also broad enough to cover an unauthorized index (where the source text is abstracted into a new form) and the non-commercial distribution of that index.

Composed of Facts and Concepts

We must first look at the composition of an index. Duncan describes the qualities of an index thus: "[an] index will distil its source work into a collection of keywords: names, places, concepts. Abstraction, then: reducing the material, summarizing it, to create something new and separate. The index is not a copy of the thing itself."[16] More fundamentally, Fetters states, "Indexes for books and journals include names of important people, events, dates, and broad concepts."[17]

Indexes are composed of facts and ideas (concepts). While these facts and ideas are derived from the source material, they are arranged in a new and distinctive way. The differentiation from the underlying source text has been shown clearly in a study by McMaster where multiple indexers created indexes from the same source.[18] It was found that the different indexes could vary widely as to metatopic, topic, and heading selection, resulting in a difference in the degree of detail present in each index. The index created by each indexer was distinctly individual.

In Canadian copyright law, ideas and facts are not covered by copyright, only the specific expression of those ideas[19] and facts[20] within a work. Because an indexer abstracts the ideas and facts present in the source text and arranges them in an individually unique way, an unauthorized index does not (indeed cannot, given the nature of its composition) infringe the copyright of the underlying source material.

What Now?

As shown in Part 1 of this article, there is a body of

scholarship that holds translations (and adaptations more generally) to be distinct original works in their own right. As original works, they do not infringe the copyright of the source text, whether the translation/adaptation is authorized or not. This argument can be applied even more forcefully to the consideration of an unauthorized index.

While some Canadian legal scholars might hold it as axiomatic that an unauthorized index would infringe the copyright of the source text, there is a clear likelihood they are incorrect. Arguments based on substantiality, UGC, and index structure show that, first, an index does not infringe, as it does not substantially duplicate the expression of the underlying work; second, an unauthorized index does not infringe, as it falls under the UGC exception to copyright; and third, because of the "ideas and facts" structure of an index, it is incapable of infringing the source text, as facts and ideas are not entitled to copyright protection.

Which of these positions the courts would consider correct is presently unknown. However, the weight of argument supports the following answer to the question posed in the original hypothetical: Isabel did not infringe the copyright on Alex's work.

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About the Author

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Notes

1. In Part 1 I posed the following hypothetical: "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 Alex's copyright?"

2. CCH Canadian Ltd. v. Law Society of Upper Canada, [2004] 1 SCR 339, https://decisions.scc-csc.ca/scc-sc/scc-csc/en/item/2125/index.do, para 16.

3. 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, 211.

4. David Vaver, "Translation and Copyright: A Canadian Focus," European Intellectual Property Review 16, no. 4 (1994):159–66, https://digitalcommons.osgoode.yorku.ca/scholarly_works/1250/, 161.

5. Zener and Etkin (Naomi Zener and Prudence Etkin), "Don't Get Lost in Translation: Copyright Protection in Translated Works," 2021, https://www.bereskinparr.com/doc/don-t-get-lost-in-translation-copyright-protection-in-translated-works.

6. It is important to remember that the author of a derived work (in this case an index) holds copyright in that work separately from the copyright held by the author of the source text. This holds true for either an authorized or unauthorized derived work.

7. The concept of user rights is not addressed in the Copyright Act. Prior to the 21st century, copyright exceptions were interpreted narrowly, simply as a defence against an allegation of infringement (see Bishop v. Stevens [1990] 2 SCR 467, https://decisions.scc-csc.ca/scc-csc/scc-csc/en/item/640/index.do, and Michelin v. CAW [1997] 2 FC 306, https://www.canlii.org/en/ca/fct/doc/1996/1996canlii11755/1996canlii11755.html). This began to change in 2002, when the Théberge decision (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, paras. 31–33) first articulated the idea that the copyright exceptions present in the Act are not just a defence against infringement but should have equal weight with the rights of the copyright holder. This doctrine was fully articulated in the CCH decision of 2004, where the Court stated:

> *The fair dealing exception, like other exceptions in the Copyright Act, is a user's right. In order to maintain the proper balance between the rights of a copyright owner and users' interests, it must not be interpreted restrictively. As Professor Vaver has explained "User rights are not just loopholes. Both owner rights and user rights should therefore be given the fair and balanced reading that befits remedial legislation." (para. 48, citation omitted; emphasis added].*

With the five copyright decisions in 2012, and most recently with the York University decision in 2021 (York University v. Canadian Copyright Licensing Agency [Access Copyright], [2021] SCC 32, https://decisions.scc-csc.ca/scc-csc/scc-csc/en/item/18972/index.do), the Court has reaffirmed the doctrine of user rights as a counterbalance to the economic rights of the copyright owner. As Michael Geist has said, "the users' rights framework has attracted growing attention worldwide, as Canadian copyright law is increasingly cited as the paradigm example for emphasizing both creator and user rights"; Michael Geist, ed., The Copyright Pentalogy: How the Supreme Court of Canada Shook the Foundations of Canadian Copyright Law (Ottawa: University of Ottawa Press, 2013), iii–iv, https://canlii.ca/t/nh.

For literary works and the application of user rights, the three most important Supreme Court decisions are CCH (see note 2 and above),

Alberta Education (Alberta [Education] v. Canadian Copyright Licensing Agency [Access Copyright], [2012] 2 SCR 345, https://decisions.scc-csc.ca/scc-csc/scc-csc/en/item/9997/index.do), and York University.

For a recent overview of the concept of user rights, see Saleh Al-Sharieh, "Securing the Future of Copyright Users' Rights in Canada," Windsor Yearbook on Access to Justice 35 (2018): 11–59, https://canlii.ca/t/2bdw. A detailed study of the five 2012 copyright cases can be found in Geist, Copyright Pentalogy. See also Michael Geist, "Copyright Vindication: Supreme Court Confirms Access Copyright Tariff Not Mandatory, Lower Court Fair Dealing Analysis Was 'Tainted,'" 2021, https://www.michaelgeist.ca/2021/08/copyright-vindication-supreme-court-confirms-access-copyright-tariff-not-mandatory-lower-court-fair-dealing-analysis-was-tainted, and "Same Old Spin: Why Access Copyright Needs a Reality Check on Canadian Copyright", 2021, https://www.michaelgeist.ca/2021/08/same-old-spin-why-access-copyright-needs-a-reality-check-on-canadian-copyright); Martin Kratz, "Supreme Court: Collective Copyright Licenses Are Not Mandatory," 2021, https://www.slaw.ca/2021/08/25/supreme-court-collective-copyright-licenses-are-not-mandatory/); and John Willinsky, "Supreme Court Rules on Copyright in the University," 2021, https://www.slaw.ca/2021/09/07/supreme-court-rules-on-copyright-in-the-university/ for discussion of the York University decision. Both Al-Sharieh and Reynolds have argued that the Canadian Charter of Rights and Freedoms (https://laws-lois.justice.gc.ca/eng/const/page-12.html) should be applied to interpretation of the Copyright Act in order to provide legislative support for user rights; see Graham Reynolds, "The Limits of Statutory Interpretation: Towards Explicit Engagement, by the Supreme Court of Canada, with the Charter Right to Freedom of Expression in the Context of Copyright," Queen's Law Journal 41, no. 2 (2016): 455–500, https://commons.allard.ubc.ca/fac_pubs/397/, and "Reconsidering Copyright's Constitutionality," Osgoode Hall Law Journal 53, no. 3 (2016): 898–947, http://digitalcommons.osgoode.yorku.ca/ohlj/vol53/iss3/5.

8. Copyright Act (R.S.C., 1985, c. C-42, https://laws-lois.justice.gc.ca/eng/acts/c-42/fulltext.html,) s. 14.1(1). The best-known Canadian moral rights case that turns on maintenance of the integrity of the work is Snow v. The Eaton Centre Ltd., 70 CPR (2d) 105, https://h2o.law.harvard.edu/cases/2708. The judgment in that case relied entirely on the subjective opinion of the artist. More recent decisions acknowledge that determination of a moral rights violation has both a subjective and an objective component. See Maltz v. Witterick, 2016 FC 524 (CanLII), https://canlii.ca/t/gr8mf, para. 49; Wiseau Studio, LLC et al. v. Harper et al., 2020 ONSC 2504, https://canlii.ca/t/j6w8w, paras. 203–4.

9. Cinar Corporation v. Robinson [2013] 3 SCR 1168, https://decisions.scc-csc.ca/scc-csc/scc-csc/en/item/13390/index.do.

10. Barry Sookman, "Robinson v. Cinar in the Supreme Court," 2013, https://www.barrysookman.com/2013/12/24/robinson-v-cinar-in-the-supreme-court. This point is also made by Mireille van Eechoud, "Adapting the Work," in The Work of Authorship (Amsterdam: University of Amsterdam Press, 2014), 145–73.

11. Basalamah holds that translations cannot infringe the translated work, stating:

> *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?*

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

12. See Dan Ruimy, Statutory Review of the Copyright Act (Ottawa: House of Commons, 2019), 72–74, https://www.ourcommons.ca/Content/Committee/421/INDU/Reports/RP10537003/indurp16/indurp16-e.pdf.

13. "Web 2.0"—also known as participative (or participatory) web and social web—refers to websites that emphasize user-generated content, ease of use, participatory culture, and interoperability (i.e., compatibility with other products, systems, and devices) for end users. https://en.wikipedia.org/wiki/Web_2.0.

14. As is made clear by Powell, who states:

> *Creative appropriation refers to the repurposing and re-contextualizing of an existing creative work or elements of it into a new work. Appropriation as a creative method can be used to convey new and original ideas through the use of existing expressions. Appropriation has occurred long before modern copyright laws were adopted and has always played a fundamental role in creative processes and in artistic and self-expression. Borrowing and taking inspiration from existing works has been common practice throughout history: artists have often re-examined existing works through new artistic styles or based their own work on existing ones. Creative works are never created in a complete social or cultural vacuum.*

Linda Powell, "Non-commercial User-Generated Content and Exceptions to Copyright" (master's thesis, University of Turku, Finland, 2020), 1, https://www.utupub.fi/bitstream/handle/10024/150523/Powell_Linda_Thesis.pdf.

15. Teresa Scassa, "The UGC Exception: Copyright for the Digital Age," 2013, https://www.teresascassa.ca/index.php?option=com_k2&view=item&id=142:the-ugc-exception-copyright-for-the-digital-age. See also Teresa Scassa, "Acknowledging Copyright's Illegitimate Offspring: User-Generated Content and Canadian Copyright Law," in Geist, Copyright Pentalogy, 431–53, where she examines the UGC exception in detail. More recently Awan has argued that, with the increasing sophistication of UGC, the lines between amateur/non-commercial and professional/commercial are becoming increasingly arbitrary and cannot be maintained; Mariam Awan, "The User-Generated Content Exception: Moving away from a Non-commercial Requirement," Canadian Intellectual Property Review 32 (2016): 12.

16. Dennis Duncan, Index, A History of the: A Bookish Adventure (London: Allen Lane, 2021), 4. Note the similarity of his language with that used

by Basalamah in describing the process of translation in "Translation Rights."

17. Linda Fetters, Handbook of Indexing Techniques: A Guide for Beginning Indexers, 5th ed. (Medford, NJ: Information Today, 2013), 13.

18. Max McMaster, "Same Publication + Many Indexers = ???" The Indexer 30, no. 2 (2012): 98–100.

19. For the public domain nature of ideas, see CCH, paras. 8 and 22; David Vaver, Intellectual Property Law: Copyright, Patents, Trade-Marks, 2nd ed. (Toronto: Irwin Law, 2011), 158: Cinar, para. 24; and MacNutt v. Acadia University, 2016 NSSC 160 (CanLII), https://canlii.ca/t/gs5qk, para. 34.

20. For the public domain nature of facts, see CCH, para. 22; Maltz v. Witterick; Winkler v. Hendley, 2021 FC 498 (CanLII), https://canlii.ca/t/jg4zp. Scassa notes that copyright can subsist in the specific expression of facts in a work, but not in the facts themselves; Teresa Scassa, "Information Law in the Platform Economy: Ownership, Control, and Reuse of Platform Data," in Law and the "Sharing Economy": Regulating Online Market Platforms, edited by Derek McKee, Finn Makela and Teresa Scassa, 149–94 (Ottawa: University of Ottawa Press, 2018), 168, https://canlii.ca/t/2cxf.

The following example makes clear the distinction between the expression of facts and the facts themselves: Suppose an individual creates a historical table of seasonal water levels for major British Columbia rivers. This table is protected by copyright, and if you reuse the table without permission, you have infringed that copyright. However, if you use the data from that table to produce a series of graphs for seasonal water levels, you have not infringed copyright (and indeed, hold copyright on the graphs). This is because copyright protects the form in which data is presented, not the data itself.