Articles

The Meaning of Publication in Canadian Copyright Law: An Archival Perspective[1]

JEAN DRYDEN

RÉSUMÉ La publication a été l'enfant oublié du droit canadien de la propriété intellectuelle. Elle a rarement été discutée dans la jurisprudence, et les traités classiques ne vont pas au-delà des avis traditionnels sur ce sujet, malgré la perturbation occasionnée par l'environnement numérique. Traditionnellement, la publication impliquait de mettre à la disposition du public des copies physiques; cependant, des copies numériques peuvent maintenant être disponibles via Internet. Au Canada, c'est le droit à la communication plutôt que le droit à la publication qui s'applique à la diffusion sur Internet. La jurisprudence canadienne récente qui s'est penchée sur le droit à la communication par rapport au téléchargement de jeux vidéo et de la musique a suscité des questions au sujet des rapports entre le téléchargement, la communication et la publication. De plus, des amendements récents à la *Loi sur le droit d'auteur* ont ajouté de nouveaux droits de distribution et de mise en disponibilité. Notre compréhension du sens de la publication et de la portée du droit de publier, en particulier à l'ère du numérique, n'est plus claire. Cet article explore ces questions à partir d'une perspective archivistique, alors que les archives adoptent de nouvelles technologies pour rendre leur contenu disponible en ligne. Cet article examine d'abord l'importance de la publication avant d'aborder le lien entre le droit de publier et la définition de la publication, et les façons dont le statut de publication affecte le fonctionnement de la *Loi sur le droit d'auteur*. Ensuite, cet article analyse la définition de la publication et applique cette analyse à certaines questions au sujet des pratiques archivistiques qui peuvent impliquer la publication dans le contexte du droit canadien sur le droit d'auteur. Alors que le concept de la publication continue à être ambigu, l'incertitude de son sens n'a pas d'incidence sur le besoin pour les pratiques archivistiques de profiter pleinement des occasions offertes par l'environnement numérique.

1 This article is the archives portion of the major research paper written in partial fulfillment of the requirements for the Master of Laws degree (specializing in intellectual property) at Osgoode Hall Law School, York University, Toronto. I would like to thank my supervisor, Professor Carys Craig, for her encouragement and helpful feedback, and Terry Eastwood for his suggestions during the revision process. I would also like to thank the anonymous peer reviewers for their thorough reading and thoughtful comments.

ABSTRACT Publication has been the neglected child in Canadian intellectual property law. It has rarely been addressed in jurisprudence, and the standard treatises do not go beyond traditional views of the topic, despite the disruption posed by the digital environment. Traditionally, publication has involved making physical copies available to the public; however, digital copies can now be made available via the Internet. In Canada, it is the communication right, rather than the right to publish, that applies to Internet dissemination. Recent Canadian jurisprudence that looked at the communication right in relation to downloading video games and music raises questions about the relationship between downloading, communicating, and publishing. Furthermore, recent amendments to the *Copyright Act* added new rights of distribution and making available. Our understanding of the meaning of publication and the scope of the right to publish, particularly in this digital age, is no longer clear. This article explores these issues from an archival perspective as archives embrace new technologies to make their holdings available online. The article first considers the importance of publication, before examining the link between the right to publish and the definition of publication, and the ways in which publication status affects the operation of the *Copyright Act*. The article then analyzes the definition of publication and applies the analysis to certain questions about archival practices that may implicate publication in the context of Canadian copyright law. While the concept of publication continues to be ambiguous, uncertainty about its meaning does not change the need for archival practices to seize the opportunities offered by the digital environment.

Introduction

The author's right to decide when to publish her work for the first time (and to prevent others from doing so without permission) is fundamental to copyright law, but publication is a neglected child in Canadian copyright discourse. "Publication" is defined in the *Copyright Act*; however, its meaning has been muddied by the addition of new rights that may overlap with the right of first publication. Moreover, although we well understand what publication means in the analog world, its meaning in the digital environment is not clear, and there is little jurisprudence to assist in its interpretation. Legal scholars who have analyzed how publication has been interpreted by American courts conclude that publication is "an elusive concept"[2] whose "precise meaning remains ambiguous."[3] The Canadian situation is no different.

Traditionally, publication has involved making physical copies available to the public; however, digital copies can be made available via the Internet. In Canada, it is the communication right, rather than the right to publish, that applies to Internet dissemination. Recent Canadian jurisprudence has looked at the communication right in relation to downloading video games

2 Thomas F. Cotter, "Toward a Functional Definition of Publication in Copyright Law," *Minnesota Law Review* 92 (2008): 1795.

3 Deborah R. Gerhardt, "Copyright Publication: An Empirical Study," *Notre Dame Law Review* 87, no. 1 (2011): 149.

and musical works on the Internet.[4] Although publication was not at issue in these cases, the decision in *Entertainment Software Association v Society of Composers, Authors and Music Publishers of Canada (ESA v SOCAN)* raises questions about the relationship between downloading, communicating, and publishing. Furthermore, recent amendments to the *Copyright Act* added new rights of distribution and making available in order to comply with the World Intellectual Property Organization (WIPO) Internet Treaties.[5] Questions arise in understanding the meaning of publication and the scope of the right to publish, particularly in this digital age.[6]

This article explores the meaning of publication in Canadian copyright law from the perspective of archives. This introductory section provides an overview of the challenges posed in interpreting publication in the digital environment and identifies the questions that archives face in dealing with the concept of publication. The following section provides the legal context for the discussion by setting out the relevant provisions of Canada's *Copyright Act* and examining the link between the right to publish and the definition of publication. The third section enumerates the ways in which publication status affects the operation of the *Copyright Act*. It is followed by an analysis of

4 *Entertainment Software Association v Society of Composers, Authors and Music Publishers of Canada (ESA v SOCAN)*, 2012 SCC 34; *Rogers Communications Inc. v Society of Composers, Authors and Music Publishers of Canada (Rogers v SOCAN)*, 2012 SCC 35.

5 *Copyright Modernization Act*, SC 2012, c 20 ss 3, 4, 9(1), and 11(1). The World Intellectual Property Organization (WIPO) Internet Treaties, consisting of the WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonograms Treaty (WPPT), were concluded in 1996 to establish standards for copyright protection in the digital environment. See World Intellectual Property Organization, "WIPOInternet Treaties," accessed 23 January 2017, http://www.wipo.int/copyright/en/activities/internet_treaties.html. Canada signed the treaties in 1997 but did not ratify them until 2014.

6 We lack clarity about the precise meaning of terms related to digital technologies. The *Copyright Act* itself is not consistent. For example, it is prohibited to tamper with "any rights management information *in electronic form*" (s 41.22); however, the Act refers to "*digital* reproductions" with regard to educational institutions (ss 30.02 and 30.03) and "copies in *digital form*"/"*digital copies*" with regard to libraries, archives, and museums (s 30.2). The phrase "tangible object" was added in 2012 as part of the distribution right. (The WCT and WPPT specify that "copies" "refer[s] exclusively to fixed copies that can be put into circulation as tangible objects" (WCT, nn6&7; WPPT, nn3,7,8,10,11). The phrase "any material form" has been in the statute since 1921, long before electronic formats were even imaginable. However, as discussed below, "any material form" has been interpreted to include digital formats.

Within this article, the terms "physical" and "digital" are used to refer to the two forms of copies (or objects) and to avoid the related terms used in the statute, i.e., "material" and "tangible." The term "physical" refers to objects/copies that are real, tangible things. "Digital" refers to objects/copies in electronic form that cannot be touched or held. Such objects may have been "born digital" or converted (by scanning) to electronic form. Digital objects are fixed, but not necessarily physical. Digital objects can be made physical by printing them or copying them onto a tangible support, e.g., a USB drive or a CD.

the three components of the definition of publication with reference to recent case law. The next section applies that analysis to the questions about archival practices posed in the introduction. The conclusion takes a broader perspective and calls for clarification of the meaning of publication in a digital world.

Why is publication important? For one thing, the publication status of a work or other subject matter affects the operation of the *Copyright Act* in many ways. For example, it triggers the period of copyright protection in some instances[7] or determines the scope of users' rights.[8] Viewed more broadly, citizens seeking to use or reuse copyrighted material must understand copyright law in order to know what uses are permitted. Because the current law does not match the popular understanding about what is "published," some risk of error exists. From the layperson's perspective, making content available on the Internet publishes it. Our everyday vocabulary reflects this in expressions such as "web page" and "online publishing." Even copyright experts have publicly espoused this view; for example, the Copyright SubCommittee of the Information Highway Advisory Council found that "electronic transmissions resulting in the making of copies available to the public constitute a publication."[9] The initial draft of the WIPO Copyright Treaty (WCT) proposed extending the definition of published works to include works made available online, although this provision was dropped from the final version.[10]

Evidence of the difficulty of dealing with publication in the digital environment is found in the provision of the Act that, for the purposes of equitable remuneration of performers and makers, deems a sound recording communicated to the public by telecommunication to have been published, notwithstanding the fact that the Act's definition of publication deems that communicating a work to the public by telecommunication (the right implicated in Internet dissemination) does not mean it is published.[11] Thus, online dissemination seemingly constitutes publication for one category of copyright-protected material but not for another. Citizens are unlikely to respect laws that do not make sense or are unduly complex. Even with due respect for the law, citizens cannot be expected to follow laws that they do not understand.

7 *Copyright Act (CA)*, s 12.
8 Ibid., s 30.21.
9 Information Highway Advisory Council, Copyright SubCommittee, *Final Report of the Copyright SubCommittee* (Ottawa: Information Highway Advisory Council, 1995), 11.
10 Mihály Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, Their Interpretation and Implementation* (Oxford: Oxford University Press, 2002), §§2.53–2.55, pp. 78–80.
11 *CA*, ss 19.1 and 19.2.

The Supreme Court of Canada (SCC) has stated that the purpose of copyright law is to balance the public interest in both promoting the encouragement and dissemination of works of the arts and intellect and obtaining a just reward for the creator.[12] In *CCH Canadian Ltd. v Law Society of Upper Canada (CCH v LSUC)*, the court framed this balance in terms of the rights of copyright owners on the one hand and users of protected material on the other.[13] Both rights holders and users must be clear about what activities comprise the exclusive rights of the copyright owner. Rights holders may be entitled to compensation, and unauthorized use may leave users vulnerable to charges of infringement. If rights overlap, that permits "double dipping" by rights holders (or double jeopardy for users), which upsets copyright's fundamental balance.[14] On the other hand, more than one right might apply to a particular activity, and the copyright balance is also skewed if owners cannot benefit from all the rights involved. These issues also have implications for the principle of technological neutrality as articulated by the SCC (that copyright law applies equally to traditional and technologically advanced media forms and methods).[15] However, at this time there is no single agreed-upon understanding of technological neutrality.[16] Thus, it is difficult to state precisely the implications of the principle for the issues at hand.

Turning to archival practice, archives acquire, preserve, and make available for research the information by-products of organizational or personal activity deemed to be of enduring value. Such materials were seldom created for commercial purposes; consequently, they are largely unpublished.[17] Except for certain private archives, most are open to the general public. Traditionally, archival material could only be consulted in the repository that housed it, and archival institutions have well-established practices for making their holdings available onsite and providing users with copies. However, archives are embracing new technologies to make their holdings available online. In

12 *Théberge v Galerie d'Art du Petit Champlain* (*Théberge v Galerie d'Art*), 2002 SCC 34, ¶30; *CCH Canadian Ltd. v Law Society of Upper Canada (CCH v LSUC)*, 2004 SCC 13, ¶23.

13 *CCH v LSUC*, ¶48.

14 *ESA v SOCAN*, ¶¶5–9.

15 *ESA v SOCAN*, ¶¶5–10.

16 See, for example, Carys J. Craig, "Technological Neutrality: (Pre)Serving the Purposes of Copyright Law," in *The Copyright Pentalogy: How the Supreme Court of Canada Shook the Foundations of Canadian Copyright Law*, ed. Michael Geist (Ottawa: University of Ottawa Press, 2013), 272–76; and *CBC v SODRAC*, 2014 FCA 84, ¶¶36–40. The subsequent SCC decision failed to clarify the application of the principle of technological neutrality (*CBC v SODRAC*, 2015 SCC 57).

17 Archival holdings also include published materials, e.g., maps, pamphlets, etc. However, this article focuses on the unpublished material that constitutes a large proportion of archival holdings.

doing so, one of the issues to be considered is whether the material they want to share is published or unpublished. This presents problems because the *Copyright Act* has different rules for published and unpublished material and, at the same time, publication is not well defined or understood. This situation raises the following issues regarding the meaning of publication:

- Depositing material in an archives makes it available for research by the general public. Does the very act of depositing archival material in an archives publish it?
- The new distribution right appears to overlap with the publication right.[18] Does the distribution right apply to selling or donating archival material to an archives?
- Because archival material cannot be borrowed, archives provide users with copies upon request. Consequently, archives have made copies of (in many cases) unpublished works available to the public. In doing so, have they published them? Is there any legal difference between providing a paper copy or photographic print and providing a digital copy on a CD or as an email attachment? Does the format or method of delivery make a difference to the legal analysis?
- Archives have enthusiastically begun to digitize their holdings and make them available on the Internet so that users can consult them from anywhere in the world. Does making these (largely unpublished) holdings available online "publish" them within the meaning of the Act?

What, if anything, must be done to adapt archival practices to legally exploit the opportunities the digital age presents?

What Is Publication?

Publication is addressed in two ways in the *Copyright Act*: in the economic rights of the copyright owner and in certain definitions. None of the economic rights is formally defined, but the Act in some cases clarifies their scope and/or meaning, e.g., publication,[19] performance,[20] telecommunication,[21] and communication to the public by telecommunication.[22]

18 *CA*, s 3(1)(j).
19 *CA*, s 2.2(1).
20 Ibid., s 2.
21 Ibid.
22 Ibid., s 2.4(1.1).

Definition of publication

Section 2.2(1) of the *Copyright Act* defines "publication" as follows:

"Publication" means
- (*a*) in relation to works,
  - (i) making copies of a work available to the public,
  - (ii) the construction of an architectural work,[23] and
  - (iii) the incorporation of an artistic work into an architectural work, and
- (*b*) in relation to sound recordings, making copies of a sound recording available to the public,

but does not include
- (*c*) the performance in public, or the communication to the public by telecommunication, of a literary, dramatic, musical or artistic work or a sound recording, or
- (*d*) the exhibition in public of an artistic work.[24]

The activities listed in (c) and (d) above are excluded from the scope of publication because they produce "only a fleeting impression of the work, whereas publication involves the distribution of material things (books, discs, films, etc.)."[25]

23 Architectural works have occupied an uneasy place in relation to publication. The construction of architectural works was initially excluded from the definition of publication, along with performances and broadcasts. This made some sense because no distribution of copies was involved. However, in 1993, as part of the *[NAFTA] Implementation Act*, the construction of an architectural work and "the incorporation of an artistic work into an architectural work" were added to the activities that constituted publication (*[NAFTA] Implementation Act*, SC 1993, c 44, s 56).

The provision that deemed built architectural works to be published was applied by the Copyright Board from 2001 to 2007, when it issued licences allowing overzealous municipal planning departments in Calgary and Ottawa to copy plans for citizens wanting to renovate their homes. Although copies of the plans had never been made available to the public in the classic sense of publication, the plans were deemed to be published by the very fact that these homes had been built. Because they were published, the plans fell within the scope of the board's mandate to issue licences to use published works whose copyright owners were unlocatable. The board eventually stopped the practice, noting that copies could be provided under fair dealing or an access to information request. See Jeremy De Beer and Mario Bouchard, *Canada's "Orphan Works" Regime: Unlocatable Copyright Owners and the Copyright Board* (Ottawa: Copyright Board of Canada, 2009), 12, 37–38. See also Copyright Board of Canada, *Policy of the Copyright Board of Canada re: Issuing Licences for Architectural Plans Held in Municipal Archives* (Ottawa: Copyright Board of Canada, 2007), accessed 23 January 2017, http://www.cb-cda.gc.ca/unlocatable-introuvables/municipal-municipales-b.pdf.

24 *CA*, s 2.2(1).

25 Claude Masouyé, *Guide to the Berne Convention for the Protection of Literary and Artistic Works (Paris 1971)* (Geneva: World Intellectual Property Organization, 1978), §3.9, p. 28. However, a building is hardly "fleeting" in the way that performances are.

Section 2.2 of the Act then sets out two other situations in which protected subject matter is not deemed to be published:[26]

(2) For the purpose of subsection (1), the issue of photographs and engravings of sculptures and architectural works is not deemed to be publication of those works.

(3) For the purposes of this Act, other than in respect of infringement of copyright, a work or other subject matter is not deemed to be published or performed in public or communicated to the public by telecommunication if that act is done without the consent of the owner of the copyright.

As noted, however, for the purposes of equitable remuneration of performers and makers of published sound recordings, a sound recording is in certain situations deemed to be published when it has been communicated to the public by telecommunication, despite section 2.2(1).[27] Having the same act constitute publication in one situation and not in another creates an awkward contradiction, which suggests that the concept of publication is increasingly blurry in the digital environment.

Right of first publication

Turning to publication as one of the rights of a copyright owner, "copyright" means the rights that apply to the categories of protected matter, as enumerated in sections 3, 15, 18, 21, and 26.[28] One of the exclusive rights of the copyright owner is the right to publish a work or a sound recording for the first time, and to authorize that act.[29] The right to publish is also included in the rights relating to translations – "to produce, reproduce, perform or *publish* any translation of the work."[30] The wording of these sections has remained substantially unchanged from the text introduced in 1921. "Copyright" also means the rights that apply to sound recordings.[31] The exclusive rights of the makers of sound recordings have included the right of first publication since 1921 (with one hiatus).[32]

26 *CA*, ss 2.2(2) and (3).
27 Ibid., ss 19.1 and 19.2.
28 Ibid., s 2.
29 Ibid., ss 3(1) and 18(1)(a).
30 Ibid., s 3(1)(a). Although not explicitly stated, the right to publish a translation is presumably limited to first publication (Elizabeth F. Judge and Daniel Gervais, *Intellectual Property: The Law in Canada*, 2nd ed. (Toronto: Carswell, 2011), 166.
31 *CA*, s 18(1)(a). Sound recordings have been protected since 1921, although until 1997 they were referred to as "records, perforated rolls or other contrivances by means of which the work may be mechanically performed or delivered" (SC 1921 c 24, s 4).
32 The right was rescinded in 1971 (*An Act to Amend the Copyright Act*, SC 1970-71-72, c 60, s 1(4)), but was restored in 1993 (*[NAFTA] Implementation Act*, SC 1993, c 44, s 57(2)).

It is important to emphasize that the publication right refers to publication *for the first time*. As Lord Chief Justice Mansfield said in 1769,

> It is fit that he [the author] should judge when to publish, and whether he will ever publish. It is fit he should not only choose the time, but the manner of publication; how many, what volume, what print. It is fit, that he should choose to whose care he will trust the accuracy and correctness of the impression; in whose honesty he will confide on not to foist in additions.[33]

It is entirely possible that someone may incorporate a work or sound recording that has already been published by the rights holder into a new work that will be made available to the public. The activity involved in this second distribution could fall within the legal definition of publication (making copies available to the public), but the activity (if not authorized by the rights holder) does not infringe on the publication right because that right applies only to hitherto unpublished material.[34]

The right and the definition

Critical to this discussion is the distinction between the right to publish for the first time and the definition of publication. While obviously related, they are not the same thing. Normand Tamaro explores these concepts, arguing that the right to publish consists of two aspects – a positive right to disseminate the work to the public (or to authorize someone to do so) and a negative right to prohibit publication.[35] He further says that the concept of publication involves two conditions: the author's intention to publish and the actual issuing of copies to the public.[36] The difference between the right to publish and publication is seen in section 2.2(3), which stipulates that a work is not deemed to be published if it has been published, performed in public, or communicated to the public without the copyright owner's consent, even if the public has encountered it in some way. The right to publish involves the author's (or rights holder's) intention to do so (or not);[37] the act of publication involves the work's availability to the public.

33 *Millar v Taylor*, [1769] 98 ER 201, p. 252.

34 The right that would be infringed is the right to reproduce the work or sound recording.

35 Normand Tamaro, *The 2015 Annotated Copyright Act* (Toronto: Carswell, 2014), 348.

36 Ibid., 244. A work can also be legally "published" by someone other than the author, e.g., by an employer, an assignee, or a licensee.

37 See Sam Ricketson and Jane C. Ginsberg, *International Copyright and Neighbouring Rights: The Berne Convention and Beyond*, 2nd ed. (Oxford: Oxford University Press, 2006), §6.40, p. 270; and Gerhardt, "Copyright Publication," 204. Although Ricketson and Ginsberg argue that the author's intention to publish is irrelevant to the definition of publication, Gerhardt found that American courts rely heavily on the copyright owner's intention in interpreting whether something is published. If authorized copies are freely

The definition of publication specifies the actions that must take place before a work or sound recording is considered to be published. Determining whether something is published is an assessment of facts regarding the three components enumerated in the definition: whether (1) copies (2) have been made available (3) to the public. The right to publish for the first time and the definition of publication connect through these components. Inherent in the right to publish is the right to undertake the actions specified in the definition. This article includes an analysis of the three components in order to explore the impact of publication on archival practice. When something is published, actions have taken place so that the work takes on the characteristics specified in the definition of publication, i.e., copies have been made available to the public. The definition is operationalized throughout the statute as an adjective that indicates the publication status of the work or sound recording as published or unpublished, which in turn determines how the work or sound recording can be dealt with.

New rights: Distribution and making available[38]

The interpretation of the concept of publication may be complicated by the rights added in 2012 to comply with the WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonograms Treaty (WPPT). Digital technologies had blurred the lines between the rights of reproduction, distribution, and communication to the public,[39] and rights holders wanted to clarify what rights should apply to "interactive, on-demand transmissions in digital networks."[40] Any international solution had to acknowledge the context of existing rights in both the Berne Convention[41] and the Rome Convention[42] and in the resulting array of national laws and commercial arrangements. The parties agreed

distributed, courts are likely to consider the work published. But if the work is made accessible in a way that demonstrates that the copyright owner is retaining control over the copies, courts are less likely to consider it published.

38 It is important to note that the phrase "making available," which appears in the definition of publication (and in a number of other places in the *Copyright Act*), is different from the making available right in the WIPO Internet Treaties. In 2012, Canada amended its Act to comply with those treaties and incorporated the making available right into the Act. Both are discussed in the article; however, the distinction between the two is clear from the context.

39 Ficsor, *The Law of Copyright and the Internet*, §4.84, p. 204.

40 Ibid., §4.01, p. 146.

41 Berne Convention for the Protection of Literary and Artistic Works (as amended on 28 September 1979), accessed 23 January 2017, http://www.wipo.int/treaties/en/ip/berne.

42 International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (1961), accessed 23 January 2017, http://www.wipo.int/treaties/en/ip/rome.

to conclude two companion treaties that expanded two existing rights (the distribution right[43] and the making available right[44]) to cover all categories of protected matter.

With regard to the so-called distribution right ("distribution" appears nowhere in the *Copyright Act*), in 2012 Canada included a new economic right for authors, performers, and makers of sound recordings. With regard to works, the following was added: "in the case of a work that is in the form of a tangible object, to sell or otherwise transfer ownership of the tangible object, as long as that ownership has never previously been transferred in or outside Canada with the authorization of the copyright owner."[45] Similar wording was added to the sections that outline the rights of a performer in a performance fixed in a sound recording,[46] and the rights of a sound recording maker.[47] The distribution right incorporates into Canadian law the American first-sale doctrine, which provides that the copyright holder can control only the first transfer of ownership of a copy of her work. Once ownership of that particular copy has been lawfully acquired, the owner of the physical object can control its further disposition (by sale, gift, or other transfer of ownership) without the rights holder's permission.

With regard to the making available right, Canada added the following to the exclusive rights of makers of sound recordings[48] and performers:[49] "to make [a sound recording or a performance fixed in a sound recording] available to the public by telecommunication in a way that allows a member of the public to have access to it from a place and at a time individually chosen by that member of the public, and to communicate it to the public in that way." For works, no new right was added. Instead, the existing communication right was clarified by adding the following: "Communication of a work or other subject-matter to the public by telecommunication includes making it available to the public by telecommunication in a way that allows a member of the public to have access to it from a place and at a time individually chosen by that member of the public."[50] However, the changes were not intended to have an impact on the meaning of publication because Canada did not remove the communication exclusion from the definition of publication.

43 WCT (http://www.wipo.int/treaties/en/ip/wct), Article 6; WPPT (http://www.wipo.int/treaties/en/ip/wppt), Article 8 (performances) and Article 12 (phonograms).
44 WCT, Article 8; WPPT, Article 10 (performances) and Article 14 (phonograms).
45 *CA*, s 3(1)(j).
46 Ibid., s 15(1.1)(e).
47 Ibid., s 18(1.1)(b).
48 Ibid., s 18(1.1)(a).
49 Ibid., s 15(1.1)(d).
50 Ibid., s 2.4(1.1).

Why Publication Matters

Whether something is published affects the operation of the *Copyright Act* in many ways, including the existence of copyright protection, term of protection, and the scope of certain users' rights.

Subsistence of copyright

Publication and the circumstances in which it took place may determine the subsistence of copyright in Canada and the level of copyright protection afforded to foreign authors, although the subsistence of copyright is rarely in doubt when dealing with archival material. Copyright subsists in a published work if it was first published in a treaty country[51] or, if first published elsewhere, published in a treaty country within 30 days of such first publication.[52] Copyright subsists in sound recordings that were first published in Canada or specified countries.[53]

Triggers term

More significant for archival material are the situations in which the copyright term depends on whether or not something is published. Once the copyright has expired, items can be used freely without permission or payment. Because public domain material presents no copyright complications, archivists need to know if the copyright has expired, and given the age of archival material, this is entirely possible. The act of first publication triggers the 50-year period of copyright protection for Crown works[54] and certain posthumous works.[55] In other cases, the duration of protection can vary, depending on whether (and when) the work has been published. For anonymous and pseudonymous works, the term is the shorter of 50 years from publication or 75 years from the creation of the work (if unpublished).[56] For cinematographic

51 Ibid., s 5(1)(c). With regard to works, a treaty country is one that has ratified the Berne Convention, the Universal Copyright Convention, the WCT, or is a member of the World Trade Organization (*CA*, s 2).
52 Ibid., s 5(1.1).
53 Ibid., s 18(2)(b) (countries that have ratified the Berne Convention, the Rome Convention, the WPPT, or are members of the World Trade Organization (s 18(2)(a)(ii)); s 18(2.2)(b) (a WPPT country (s 18(2.2)(a)).
54 Ibid., s 12.
55 Ibid., s 7(1) and (2).
56 Ibid., ss 6.1(a) and 6.2(a).

works that lack dramatic character,[57] the term is 50 years from the creation of the film unless the film is first published within that 50 years, in which case the term is 50 years from publication.[58]

Similar provisions apply to sound recordings and performances. Copyright in sound recordings lasts for 50 years from the first fixation of the sounds unless the sound recording is first published within that 50 years, in which case the term is the earlier of 70 years from first publication or 100 years from first fixation of the sounds.[59] Copyright in a performer's performance normally subsists for 50 years after the performance occurs.[60] However, if the performance is fixed in a sound recording during that 50 years, the copyright lasts for 50 years from the first fixation of the performance in a sound recording;[61] and if that sound recording is published before the copyright expires, the copyright in the performance is the shorter of 70 years from first publication of the sound recording and 100 years from the first fixation.[62]

Users' rights

Publication status also determines entitlement to certain users' rights. The users' rights for non-profit libraries, archives, and museums (LAMs) often depend on publication. The provision permitting LAMs to make copies of archival holdings for patrons for their research and private study is limited to unpublished works.[63] While section 30.1, which allows LAMs to make copies for the maintenance and management of their holdings, applies to both published and unpublished holdings, section 30.1(a) applies only to items that are rare or unpublished.

Individuals can create non-commercial user-generated content without infringing copyright (subject to certain conditions). One such condition requires that their raw material be limited to works or other subject matter that

57 "Dramatic character" is not defined in the act; it is the result of "the arrangement or acting form or combination of incidents represented" (§8.7(a)). John S. McKeown, in *Fox on Canadian Law of Copyright and Industrial Designs*, 4th ed. (Toronto: Carswell, 2012), states that there must be "some element of dramatic action in the dialogue, scene, incident or situation being represented," and that it "must have sufficient unity to be capable of performance" (§8.7(a).). Within archival practice, it is generally agreed that moving image material that simply records a live event, such as unedited news footage, home movies, etc., lacks dramatic character. David Vaver's interpretation supports this practice; see David Vaver, *Intellectual Property Law*, 2nd ed. (Toronto: Irwin, 2011), 147.

58 *CA*, s 11.1.

59 Ibid., s 23(1.1).

60 Ibid., s 23(1).

61 Ibid., s 23(1)(a).

62 Ibid., s 23(1)(b).

63 Ibid., s 30.21. Unpublished sound recordings (e.g., oral history interviews or convocation addresses) are thus excluded.

has been "published or otherwise made available to the public."[64] In a different provision, it is not an infringement of copyright for any person to read or recite in public a reasonable extract from a published work.[65]

Other provisions limited to published matter

Publication status also determines the scope of certain other provisions. The right of sound recording makers and performers to be equitably remunerated applies to published sound recordings only.[66] Of particular concern to archives is the unlocatable copyright owner provision.[67] If a rights holder cannot be located after a good-faith effort, one can apply to the Copyright Board for a licence to use the copyrighted material. However, this provision applies only to published works and sound recordings. This is a problem because archival holdings consist in large part of unpublished material, which comprises a far greater proportion of unlocatable copyright owners.

Although not a statutory provision, publication status is a factor to be considered by courts in determining whether a particular dealing with copyrighted subject matter is "fair."[68] Earlier jurisprudence has generally found that using an unpublished work weighs against a finding of fair dealing.[69] However, the SCC in *CCH Canadian Ltd. v Law Society of Upper Canada* (*CCH v LSUC)* found that dealing with unpublished works strongly favours a finding of fair dealing, stating, "If a work has not been published, the dealing may be more fair in that its reproduction with acknowledgement could lead to a wider public dissemination of the work – one of the goals of copyright law."[70] For archives, whose holdings consist in large part of unpublished materials, this decision is very important because it clearly establishes that fair dealing applies to unpublished works. As Giuseppina D'Agostino notes, however, the court's reasoning seems to be at odds with the fundamental right of the copyright owner to control when, how, and whether a work will be disclosed to the public.[71]

64 Ibid., s 29.21(1).
65 Ibid., s 32.2(1)(d).
66 Ibid., ss 19(1), 19(1.1), and (2).
67 Ibid., ss 77(1)(a) and (c)
68 Ibid., ss 29, 29.1, and 29.2.
69 Giuseppina D'Agostino, "Healing Fair Dealing? A Comparative Copyright Analysis of Canada's Fair Dealing to U.K. Fair Dealing and U.S. Fair Use," *McGill Law Journal* 53, no. 2 (2008): 323, 342–44, 347, 357. For an analysis of the American cases from an archival perspective, see Kenneth D. Crews, "Fair Use of Unpublished Works: Burdens of Proof and the Integrity of Copyright," *Arizona State Law Journal* 31 (1999): 1–94; Robert Spoo, "Fair Use of Unpublished Works: Scholarly Research and Copyright Case Law Since 1992," *Tulsa Law Review* 34, no. 1 (1998): 83–200; and Robert Spoo, "Copyright Law and Archival Research," *Journal of Modern Literature* 24, no. 2 (2000/2001): 205–12.
70 *CCH v LSUC*, 2004 SCC 13, ¶58.
71 D'Agostino, 323.

Deconstructing Publication

The stage is set to deconstruct the definition of publication (making copies of a work or a sound recording available to the public)[72] in the *Copyright Act* by examining the three components of this definition, i.e., whether (1) copies (2) have been made available (3) to the public. Their meanings may seem straightforward, but many questions can be asked, particularly in the digital environment. The following analysis examines each component of the definition and considers related sub-issues. The summary of the analysis then demonstrates the impact on archives.

Making available

Turning to the first of the three components enumerated in the definition of publication (making copies available to the public), although the phrase "making available" appears throughout the *Copyright Act*, it is of interest here only when it is part of a definition (i.e., publication) or a right (communication to the public by telecommunication). The phrase is not defined. Two issues arise: limits on the means of making available, and whether a transfer of ownership is required.

Means of making available

On its own, as is the case with the definition of publication itself, the phrase "making available" is technologically neutral in that no limitations are put on the means of making [copies] available. Depending on the form (physical or digital) of the copies, making copies available could presumably include electronic dissemination, and it is now possible to distribute digital copies of works or other subject matter (e.g., ring tones, sound recordings, or video games) via the Internet. However, the definition of publication is limited by the exclusion of certain acts (performance in public, communication to the public, public exhibition of an artistic work) that traditionally have not involved distribution of copies.[73] Even though copies of ring tones and the like can now be distributed online, they cannot be considered published because the means of dissemination is an act that is excluded from publication: communication to the public by telecommunication.

Recent jurisprudence may change the interpretation of digitally distributed material as unpublished. The SCC recently addressed the matter of digital distribution in two cases. In *Rogers Communications Inc. v Society of*

72 *CA*, s 2.2(1).
73 *CA*, s 2.2(1)(c) and (d).

Composers, Authors and Music Publishers of Canada (Rogers v SOCAN), the court unanimously distinguished between a download ("the transmission over the Internet of a file containing data, such as a sound recording of a musical work, that gives the user a permanent copy of the file to keep as his or her own") and a stream ("a transmission of data that allows the user to listen to or view the content transmitted at the time of the transmission, resulting only in a temporary copy of the file on the user's hard drive").[74] In *ESA v SOCAN*, the court found (by a narrow majority) that a "download" is not a "communication" but "merely an additional, more efficient way to deliver copies of the [video games] to customers. The downloaded copy is identical to copies purchased in stores or shipped to customers by mail."[75] Although publication of the downloaded works was not at issue, the *ESA v SOCAN* decision opens the door to the possibility that Internet dissemination resulting in a copy for the end-user to keep constitutes publication. If downloading is not a communication, making a copy of a work or sound recording available to the public by downloading is no longer outside the scope of publication. As Sam Ricketson and Jane C. Ginsberg suggest, "If the author makes the work available to the public to make copies, e.g., by offering it as a download from a publicly accessible website, the work should be deemed 'published.'"[76]

Although the majority decision in *ESA v SOCAN* that downloads are not communications rendered moot much of the minority discussion about the connection between a work's publication status and the scope of the communication right, Justice Marshall Rothstein's observation is nonetheless relevant when he says that section 2.2(1) determines only the scope of publication; it does not inform the scope of the right to communicate to the public by telecommunication.[77]

Transfer of ownership

For the purposes of publication, "making available" does not appear to require a transfer of ownership; the work or sound recording simply has to be available. Even if no one buys it or takes a free copy, the work or sound recording has still been published. A British case found that six copies of sheet music were "exposed for sale" on the counter of a store for two weeks (after which they were put in the stockroom); their availability was not advertised, and none was sold at that time. The court determined that the work had been

74 *Rogers Communications Inc. v Society of Composers, Authors and Music Publishers of Canada (Rogers v SOCAN)*, 2012 SCC 35, ¶1.
75 *ESA v SOCAN*, ¶¶4–5.
76 Ricketson and Ginsberg, *International Copyright and Neighbouring Rights*, §6.52, p. 278.
77 *ESA v SOCAN*, ¶111.

published as of the date it was placed on the counter because the copies had been "issued to the public"[78] (in the words of the British statute at the time) and were sufficient to constitute publication.[79]

Copies

The next component (copies) is not defined in the *Copyright Act*; however, "copy" has been defined in case law in relation to infringement of the reproduction right as "that which comes so near to the original as to give to every person seeing it the idea created by the original."[80] This interpretation of copy originated in 1822[81] and has been cited with approval during the intervening decades, but it has not been referred to with regard to publication, nor in cases involving digital copies, which can be "so near to the original[s]" as to be indistinguishable from them.

With regard to copies, three questions arise. First, is publication limited to physical copies or does it encompass digital copies? Second, how many copies are required to "publish" something – is making one copy available to the public sufficient? Third, who makes the copies?

Digital forms

The concept of publication obviously involves copies, which is intimately tied to the reproduction right – the right to reproduce a work or a sound recording "in any material form whatever."[82] The Copyright Board, in determining that digital copies of musical works in the buffer of the Sirius music service were reproductions in a material form, summarized the cases that have interpreted "in material form" to reflect changing technologies.[83] The SCC has reiterated that this phrase demonstrates a public policy commitment to what has been called media or technological neutrality to ensure that the *Copyright Act* continues to apply as technology evolves.[84] Thus, reproducing a work in "any material form" includes digital forms. If, for the purposes of Canadian copyright law, we assume that reproductions and copies are synonymous, it

78 *Copyright Act, 1911 (UK),* 1 & 2 Geo 5, c 46, s 1(3).
79 *Francis, Day & Hunter v Feldman & Co.* [1914] 2 Ch 728; affirmed by UK Court of Appeal 3 LTR 521.
80 *King Features Syndicate Inc. v Lechter* [1950] Ex. CR 297, ¶19.
81 *West v Francis* (1822), 106 ER 1361 at 1361; cited with approval in *King Features Inc. v Kleemann Ltd.* [1949] 2 All ER 406, 2.
82 *CA*, s 3(1); s 18(1)(b).
83 Copyright Board. Public Performance of Musical Works; Public Performance of Sound Recordings; Reproduction of Musical Works. Statement of Royalties to Be Collected By SOCAN, NRCC and CSI in Respect of Multi-Channel Subscription Satellite Radio Services, April 2009, ¶¶100–102, 110.
84 *Rogers v SOCAN*, ¶39; *ESA v SOCAN*, ¶5.

is logical to assume that the term "copies" includes digital copies that are not necessarily physical, such as a copy saved to computer memory, sent as an email attachment, or downloaded from a server to another computer.

Furthermore, the SCC has stated that "although the words 'in any material form whatever' qualify the right to 'produce or reproduce the work' in section 3(1), the same principle should guide the application of the neutral wording of the right to 'communicate … to the public by telecommunication.'"[85] If the right of first publication were at issue, the SCC would presumably argue that the same phrase should also apply. Thus, we can conclude that "copies" in the definition of publication includes digital forms.

Quantity

Another aspect of "copies" is the quantity required to be made available to the public in order for publication to have taken place. For works, the Act states that the first publication must be "in such a quantity as to satisfy the reasonable demands of the public, having regard to the nature of the work."[86] A similar requirement applies to sound recordings.[87] However, this quantity requirement is obviously non-specific and context dependent. Would making a single copy available to the public constitute publication of that item? The *Interpretation Act*, which applies to all federal statutes and regulations, provides that "words in the singular include the plural, and words in the plural include the singular."[88] Based on this, it appears that making a single copy available to the public meets the requirements of the definition of publication. Furthermore, as David Vaver suggests, a single copy (including a posting on the Internet) may in some situations be sufficient to satisfy public demand.[89] If the copy is available for download, only one copy is available on the web server, but it can be downloaded by millions.

While a single copy may be sufficient, publication is usually understood to involve multiple copies.[90] Thus, it is useful to consider the connection between publication and the right of reproduction. In *Théberge v Galerie d'Art du Petit Champlain (Théberge v Galerie d'Art)*, the SCC found that "'reproduction' is usually defined as the act of producing additional or new copies of the work in any material form"[91] while recognizing that there were many ways of making

85 *Rogers v SOCAN*, ¶39.
86 *CA*, s 5(1)(c)(i).
87 *CA*, ss 18(2)(b) and 18(2.1)(b).
88 *Interpretation Act*, RSC 1985, c I-21, s 33(2).
89 Vaver, *Intellectual Property Law*, 156–57.
90 "Multiplying copies" was one of the rights of the copyright owner in the British copyright law of 1842 (*An Act to Amend the Law of Copyright* (UK), 5 & 6 Vict, c 45, s II.).
91 *Théberge v Galerie d'Art*, 2002 SCC 34, ¶42. See also ¶¶43–44.

copies.[92] Although reproduction and first publication are distinct core rights in the Act,[93] reproduction is nonetheless an aspect of publication, and the idea that reproduction involves the multiplication of copies is implied in the publication right.

Maker of the copies

Although not explicitly addressed in the Act, traditionally the (multiple) copies made available to the public have been made by the rights holder or, more likely, a third party (a publisher or printer) authorized by the rights holder. In the digital world, however, members of the public have the technical capability to make copies by various means (e.g., copying and pasting, downloading). If a rights holder posts unpublished content online with a licence authorizing users to use the content for non-commercial purposes (including making copies for themselves), could that constitute publication? According to *ESA v SOCAN*, the transmission is not a communication because users can obtain authorized "durable copies." If it is not a communication, it is not excluded from the definition of publication. Ricketson and Ginsberg suggest that one reason for excluding certain activities from the scope of publication is to maintain the rights holder's ability to control copies of communicated works.[94] They argue convincingly that there is no practical difference between publication by distribution of copies and publication by wired/wireless communication if users can make their own copies.

To the public

Finally, the copies must be made available *to the public*. The phrase appears in a number of places in the *Copyright Act*, most often in relation to the right to communicate by telecommunication or the activity of doing so. The phrase is not defined in the Act but has been extensively considered in jurisprudence. Earlier jurisprudence in Britain and Canada established what was excluded from "the public" with regard to publication. Courts have found that distribution to one's family and friends,[95] to a limited group in accordance with conditions imposed by the author,[96] to the employees of a company,[97] or through samizdat circulation in Russia[98] was not "to the public."

92 Ibid., ¶47.
93 *ESA v SOCAN*, ¶42.
94 Ricketson and Ginsberg, *International Copyright and Neighbouring* Rights, §6.49, p. 276.
95 *Prince Albert v Strange* [1849] 47 ER 1302.
96 *Kenrick v Danube Collieries* [1891] 39 WR 473.
97 *Massie and Renwick v Underwriters Survey Bureau* [1940] SCR 218.
98 *Bodley Head v Flegon* (1971)[1972] 1 WLR 680, p. 687.

Other cases have examined the issue from the opposite view, i.e., if "the public" does not include limited groups, does it mean everybody? The Federal Court of Appeal explored this issue in relation to faxing copies of articles to individual members of the Law Society on request, stating,

> The ordinary meaning of the phrase "to the public" indicates that a communication must be aimed or targeted toward "people in general" or "the community."… Article 1721(2) of NAFTA [quoted in full below[99]], which is not binding on this Court but is nevertheless helpful since "public" is not otherwise defined, states that the public includes "any aggregation of individuals intended to be the object of, and capable of perceiving communications." A communication that is targeted only at a segment of the public may however also be a communication to the public. Paragraph 2.4(1)(*a*) [of the Copyright Act] … clarifies that a communication may be to the public if it is "intended to be received by" a "part of the public," specifically persons who occupy apartments, hotel rooms, or dwelling units in the same building. Thus, to be "to the public" a communication must be targeted at an aggregation of individuals, which is more than a single person but not necessarily the whole public at large.[100]

The meaning of the phrase "to the public" in the communication right[101] was "the sole issue" in *Rogers v SOCAN*.[102] The court found that a series of online transmissions of the same work to individuals on demand is a communication to the public, stating,

> Following the online music services' business model, musical works are indiscriminately made available to anyone with Internet access to the online music service's website. This means that the customers requesting the streams are not members of a narrow group, such as a family or a circle of friends. Simply, they are "the public."[103]

99 *North American Free Trade Agreement Between the Government of Canada, the Government of the United Mexican States and the Government of the United States of America,* Article 1721(2). The full text states: "'Public' includes, with respect to rights of communication and performance of works provided for under Articles 11, 11bis(1) and 14(1)(ii) of the Berne Convention, with respect to dramatic, dramatico-musical, musical and cinematographic works, at least, any aggregation of individuals intended to be the object of, and capable of perceiving, communications or performances of works, regardless of whether they can do so at the same or different times or in the same or different places, provided that such an aggregation is larger than a family and its immediate circle of acquaintances or is not a group comprising a limited number of individuals having similarly close ties that has not been formed for the principal purpose of receiving such performances and communications of works." While it relates specifically to the rights of communication and performance in Berne, it is not so rights-specific that it could not be useful in determining the meaning of "public" for the purposes of the definition of publication.

100 *CCH v LSUC*, 2002 FCA 187, ¶100. See also *Rogers v SOCAN*, ¶25.

101 *CA*, s 3(1)(f).

102 *Rogers v SOCAN*, ¶2.

103 Ibid., ¶56.

While publication was not at issue in *Rogers v SOCAN*, it seems reasonable to assume that the same principle applies, i.e., a work or sound recording is published when copies have been made available to an aggregation of individuals that constitute part of the public. That a series of individual online requests is within the scope of the communication right (rather than a series of private transactions) has been settled by the 2012 amendment of the *Copyright Act*, clarifying the meaning of communication by telecommunication to the public.[104]

Analysis summarized

What can we glean from this analysis about the meaning of "making copies available to the public" in the context of Canadian copyright law? "Copies" can be physical or digital; they are not limited to any particular form. Although not stated explicitly, it is strongly implied that publication generally involves multiple copies, although a single copy may be sufficient if it meets the reasonable demands of the public (if, for example, it is available online for download). Even though publication can occur without a single copy being acquired by the public, the idea of multiple copies also suggests that copies will change hands so that many members of the public will possess a copy. In light of *ESA v SOCAN*, users' ability to make their own copies may change the scope of publication. "Making available" is limited by the exclusions, although making available electronically for download is no longer precluded from publication because it is no longer a communication. "The public" need not include everyone, but it must be more than a family or other narrow group formed through limited common ties. However, many aspects of publication remain fuzzy, particularly the aspects that are only implied, as well as the operation of the definition in the rapidly changing digital world, and the line between a narrow group and "the public."

Overlap with distribution right

To fully understand how the publication concept affects archival practice, it must be distinguished from the distribution right. An issue to consider is the possible overlap between the right of first publication and the distribution right, as suggested by Laura J. Murray and Samuel E. Trosow.[105] The distribution right applies to works, sound recordings, and performances fixed in a sound recording.[106]

104 *CA*, ss 2.4(1.1), 18(1.1), and 15(1.1)(d).
105 Laura J. Murray and Samuel E. Trosow, *Canadian Copyright: A Citizen's Guide*, 2nd ed. (Toronto: Between the Lines, 2013), 66.
106 *CA*, ss 3(1)(j), 18(1.1)(b), and 15(1.1)(e).

The classic situation addressed by the distribution right is when someone buys a copy of a tangible object (e.g., a book, CD, DVD, vinyl record) that embodies protected matter that has been published with the authorization of the rights holder. On the other hand, the distribution right would be infringed if copies of hitherto unpublished works or sound recordings were made and sold without such authorization. The latter activities were already infringements of the reproduction right and the first publication right, so it is not entirely clear what rights holders gain through the addition of the distribution right to the Act. Vaver links the distribution right to what he calls the "first public distribution" right (the right of first publication), which, in his view, has been greatly expanded to give rights holders control over not just the work or sound recording, but over each copy.[107] The addition of the distribution right to the exclusive rights of the copyright owner replicates in primary infringement a number of activities that already constitute secondary infringement.[108] The rights holder's position is strengthened because, unlike the provisions for secondary infringement, the distribution right does not require knowledge that the activity infringes copyright. However, the expansion of rights concomitant with the addition of the distribution right is more closely related to secondary infringement rather than first publication.

The distribution right appears to apply most clearly to situations that involve the dissemination of multiple copies. How does it apply to protected matter that is not distributed in multiple copies? This question is particularly relevant to archival material. For example, someone sends a personal letter to a friend or a business letter to an organization via the postal service.[109] While the author owns the copyright in the letter, the recipient owns the actual letter (the tangible object). Similarly, if an employee sends a memo or letter to a customer or another organization on behalf of the employer, the recipient owns the letter (the tangible object), and the employer owns the copyright in the letter. The ownership of the tangible object is legally transferred when the letter is received, as is the case if a person gives a friend or family member a copy of a photo or a video or sound recording created by that person. No rights, including the distribution right, are infringed in these situations.

How does the distribution right relate to the right to publish for the first time? Table 1 compares the two rights, incorporating the definition of publication into the right of first publication.

107 Vaver, *Intellectual Property Law*, 155–56, 196–7.

108 *CA*, s 27(2).

109 If the communication is in the form of an email, presumably it is not a tangible object, unless it is printed or copied to a USB drive.

Table 1: Comparison of the distribution right and the first publication right

	Distribution right	**First publication right**
Action	Sell or otherwise transfer ownership	Make available
Object of the action	A work, sound recording, or performance fixed in a sound recording that is in the form of a tangible object	Copies of any work or sound recording
Recipient of the object	Not specified	The public
For the first time?	Yes	Yes
Right exhausted after first "sale"?	Yes (s 3(1)(j))	Not codified, but see *Théberge v Galerie d'Art*[110]

It appears that the first publication right largely encompasses the distribution right. First publication is broader with regard to both the "action" and its object. Selling or otherwise transferring ownership (e.g., as a gift) is a particular, more limited means of making available (although the exclusions to the definition of publication limit other means of making available). Furthermore, the object of the distribution right is the tangible objects that embody a subgroup of protected matter. "Tangible object" is not defined in the Act; *Black's Law Dictionary* defines the word *tangible* as "having or possessing physical form."[111] Tangible objects are clearly, in the vocabulary of this article, physical (not digital) objects. The object of first publication is the much broader concept of copies, which could, by virtue of *ESA v SOCAN*, include downloaded digital copies. The distribution right can apply to a single tangible object, but in relation to the definition of publication, "tangible objects" is a subset of "copies."[112]

With regard to the related concepts of *first* publication and the first-sale doctrine, both rights are similar in scope. Both involve a specified action

110 "Once an authorized copy of a work is sold to a member of the public, it is generally for the purchaser, not the author, to determine what happens to it" (*Théberge v Galerie d'Art*, 2002 SCC 34, ¶31). See also Jeremy de Beer and Robert Tomkowicz, "Exhaustion of Intellectual Property Rights in Canada," *Canadian Intellectual Property Review* 25, no. 1 (2009): 12–13, 17–18.

111 Bryan A. Garner, ed., *Black's Law Dictionary*, 10th ed. (St. Paul, MN: Thomson Reuters, 2014).

112 The treaties specify making the original and copies available: WCT, Article 6(1); WPPT, Articles 8(1) and 12(1).

(transferring ownership or making available) for the first time. First publication of an unpublished work or sound recording can occur only once. Similarly, if ownership of a tangible object embodying the protected matter has already been transferred with the authorization of the rights holder, the distribution right has been exhausted. Although exhaustion of the first publication right is not codified in the statute, it has been addressed in jurisprudence as an aspect of the copyright balance.[113]

The only aspect of the distribution right that may be broader than its counterpart in the first publication right is that of the "recipients." While jurisprudence has limited the concept of "the public," the other party in the transfer of ownership of the tangible object is not specified in the distribution right, and thus is not limited in any way. While the wording of the WCT and WPPT specifies "to the public,"[114] that is not explicit in the *Copyright Act*, and the distribution right could conceivably include the entities that have been excluded from "the public" by jurisprudence. Overall, however, the distribution right appears to be a subset of the first publication right.

The distribution right was added to the *Copyright Act* so that Canada could ratify the WIPO treaties.[115] Was it necessary to add this right? An earlier discussion of issues to be addressed in future rounds of copyright reform stated that "[distribution] may be covered to a large extent by the publication right."[116] The foregoing analysis bears this out. If one of the goals was to limit publication to the making available of *physical copies*, the definition of publication could have been amended accordingly, leaving the communication/making available right to apply to electronic dissemination. If enshrining the first-sale doctrine in the *Copyright Act* was felt to be necessary, the provision could have been added to section 2, where the scope of other rights has been clarified.

Discussion

This study has looked at the concept of publication from the perspective of archival material preserved in Canadian archives. It is now time to consider the archival questions that inspired this study.

- Does the very act of depositing archival material in an archives publish it?
- Does the distribution right apply to selling or donating archival material to an archives?

113 de Beer and Tomkowicz, "Exhaustion of Intellectual Property Rights," 12–14, 16–18.

114 WCT, Article 6; WPPT, Article 8 (performances) and Article 12 (phonograms).

115 The WIPO treaties also included a making available right, but Canada simply clarified the existing communication right rather than add a separate making available right.

116 *Supporting Culture and Innovation: Report on the Provisions and Operation of the Copyright Act* (Ottawa: Industry Canada, 2002), 15.

- In making copies of unpublished works for users on request, has the archives published them? Does the format of the copies (digital or physical) or the method of delivery make a difference?
- In digitizing unpublished works or sound recordings from their holdings and making them available on the Internet, has the archives published them?

Depositing material in an archives

Although archives now acquire material in digital form, the majority of archival holdings are received in physical form, including letters, photo albums, audiotapes, videotapes, and the like.[117] In most cases, the deposit consists of the originals.[118] The donor may not own the copyright in all the items (for example, letters received from others). The original (or, if the archives accepted copies instead of the originals, a single copy) of each work is being made available for research by the general public. Generally speaking, what is being made available is not a copy (and even if it is, the archives owns only one copy). Making archival holdings available for research expresses a different sense of availability, i.e., the researching public cannot take or even borrow the material; they can only consult it and, if the content is relevant to their research, take notes or request copies from the archives.

Whether depositing an unpublished work in an archives publishes it has not been addressed in the archival professional literature. The absence of any discussion suggests that it is settled practice that deposit in an archives does not publish a work. The matter has, however, been addressed by archivists in the contexts of British and American copyright law. Tim Padfield concludes that "allowing public access to an original work [in an archives' holdings] does not constitute 'issuing' it to the public [in the sense of publication as defined in the British statute]."[119] Kevin Garnett et al. concur,[120] although the matter is not explicitly addressed in legislation, nor has it been judicially considered.

From the American perspective, Peter B. Hirtle concludes that "the likelihood that deposit of unpublished materials in a repository constitutes publication would seem small," citing a court ruling that "an unpublished

117 Archival acquisitions often include older recordkeeping technologies because of the time lapse between the creation of the material and the time it is no longer needed for its initial purpose and thus is deposited in an archives.

118 Occasionally, the donor will want to keep the originals, and the archives will accept a copy of the items in the acquisition (traditionally a photocopy or microform).

119 Tim Padfield, *Copyright for Archivists and Records Managers*, 4th ed. (London: Facet Publishing, 2010), 84–85.

120 Kevin Garnett, Gillian Davies, and Gwilym Harbottle, *Copinger and Skone James on Copyright*, 15th ed. (London: Sweet & Maxwell, 2005), §17-09, p. 902.

work's presence in an academic library, on its own, is not the same thing as publication."[121] Deborah R. Gerhardt has argued that depositing a work in an archives publishes it. However, her argument depends on compliance with certain technicalities of American copyright law rather than simple deposit in archives, and would require item-level analysis to ascertain which items are published and which are not.[122] Gerhardt found that, while the authors of the leading treatises concede the possibility that deposit in a public institution may constitute publication, "taken together, the treatises do not provide sufficiently clear guidance on the copyright status of works publicly available in museums and libraries."[123]

Furthermore, if depositing works in archives published them, there could be a number of regrettable consequences. A donor, if also the copyright owner, might be reluctant to deposit unpublished works in archives until after the works had been fully exploited. If the collection contained the works of many authors other than the donor, the donor might also be reluctant to deposit the collection in an archives because deposit (and thus first publication) would potentially infringe by usurping those authors' rights to decide when, where, and how to make their work available. Trying to obtain the necessary permissions of all rights holders would be laborious, time-consuming, and incomplete. Because the works are usually hitherto unpublished originals (not copies), it is the right of first publication (not the reproduction right) that would be infringed. As a matter of professional international practice, simply depositing materials in an archives has never been understood to constitute publication.

Donating archival material

As noted, the distribution right involves selling or otherwise transferring ownership of a tangible object containing a work, a sound recording, or a performance fixed in a sound recording, as long as that ownership has never been transferred previously with the authorization of the rights holder. Although archives are acquiring "born digital" records, the majority of archival

121 Peter B. Hirtle, Emily Hudson, and Andrew T. Kenyon, *Copyright and Cultural Institutions: Guidelines for Digitization for U.S. Libraries, Archives and Museums* (Ithaca, NY: Cornell University Library, 2009), 31, citing *Wright v Warner*, 748 F. Supp.105 (SDNY 1990), p. 110, affirmed 953 F.2d 731, 1991 (2d Cir 1991).

122 Deborah R. Gerhardt, "Copyright at the Museum: Using the Publication Doctrine to Free Art and History," *Journal of the Copyright Society of the USA* 61 (2014): 393–451. Gerhardt's proposed test requires that three conditions be met: the work was deposited in a public archives, the deposit was made or authorized by the copyright owner, and there are no restrictions on copying the work. If deposited before 1978, the work would be in the public domain and thus freely available for use. The requirement that deposit in the archives must be authorized by all rights holders in any particular collection would be difficult to meet.

123 Ibid., 415.

holdings are still physical items acquired by donation. In other words, the donor has transferred to the archives ownership of tangible objects embodying works. In many cases, the items are received directly from the creator or the recipient of a lawfully acquired work. In many other cases, however, acquisition by the archives may have been preceded by a series of transfers of ownership – for example, family records that have been passed from generation to generation, or the records of an organization that no longer exists and whose functions (and records) have been taken over by a new organization. In such cases, the first transfer of ownership of the physical items very likely took place with the authorization of the rights holder and thus exhausted the distribution right. Subsequent transfers of ownership are outside the scope of the distribution right.[124] Thus, it is highly unlikely that the distribution right applies to transfers of ownership involving an aggregation of original documents (as distinct from copies). Archives need not be concerned that the distribution right will require changes to the longstanding practices that govern the transfer of ownership in the tangible objects occurring between donors and archives.

Making copies for users

Making copies of unpublished works for users on request does not publish them for two reasons. The issue turns first on whether such copies are made available *to the public*. The archival practice of making copies available to individuals on request mirrors the situation in *CCH v LSUC*, in which the Law Society library was mailing or faxing copies of particular legal materials in response to requests from individual members.[125] The SCC found that "the fax transmission of a single copy to a single individual is not a communication *to the public*."[126] Publication was not at issue in *CCH v LSUC*, but if publication is defined as making copies available *to the public*, the same principle should apply to an archives responding to individual requests for copies regardless of the format of the copy (photocopy, photographic print, scan) or the means of delivery (mail, fax, or email attachment).

However, the SCC later determined that online music services' streaming of the same work to a series of individuals on demand was a communication *to the public*.[127] How is this different from *CCH v LSUC*? The court distinguished *CCH v LSUC* from *Rogers v SOCAN* in that the staff of the

124 Archivists nonetheless want to know as much as possible about the custodial history of each aggregation of records in order to understand and verify their authenticity and integrity. See Laura A. Millar, *Archives Principles and Practices* (New York: Neal-Schuman, 2010), 164, and Richard Pearce-Moses, *A Glossary of Archival & Records Terminology* (Chicago, IL: Society of American Archivists, 2005), 100–101.

125 *CCH v LSUC*, ¶1.

126 Ibid., ¶78 (emphasis added).

127 *Rogers v SOCAN*, ¶53.

Law Society library controlled the dissemination of copies because they reviewed each request before making the copies (or not).[128] Such requests were considered private communications because they were mediated by the staff.[129] From an archival perspective, orders for copies are similarly reviewed by archives staff to ensure compliance with any restrictions on copying and to safeguard the physical condition of the item(s). Despite the *Rogers v SOCAN* decision, the archival practice of making a copy available to an individual upon request does not constitute publication of that work, whatever the format of the copy or the means of delivery.

In any case, even if making copies for individual users on request did constitute making them available to the public, such copies are not deemed to be published if the first publication occurred without the rights holder's permission.[130] Archives are legally permitted to make copies for users because they are the beneficiaries of certain users' rights (fair dealing, section 30.21), not because they have the rights holder's permission.[131]

Making holdings available on the Internet

The digital environment provides an opportunity to make archival holdings available to users in a different way. Increasingly, archives are making digital copies of selections from their holdings available to anyone with Internet access to the archives' website. The quality of the online images may be limited by low resolution or a visible watermark, but they are adequate for research and private study. Users wanting a copy of an image need not request it from the archives. The user can obtain a copy in a variety of ways: by copying, pasting, and saving; by using the "save image as" function on the right-click/control-click menu;[132] or by downloading it (if the archives' website is set up to do so).[133] Copying and pasting is not technically downloading, but the effect is the same: the user has a copy of the online image. Such copying is not mediated the way that requests for copies of specific documents are. Consequently, the copies are not private communications, and in this situation archival researchers can be said to be part of the public.

128 Ibid., ¶55.
129 Ibid., ¶7.
130 *CA* 2.2(3).
131 The archives may be the rights holder in certain cases.
132 See, for example, Nova Scotia Archives, "Copying and Use Protocols for Archival and Library Holdings," accessed 23 January 2017, https://archives.novascotia.ca/copying-and-use-protocols-archival-and-library-holdings.
133 See, for example, University of Manitoba, "About UM Digital Collections," accessed 23 January 2017, http://digitalcollections.lib.umanitoba.ca/about.

In a similar fashion, digital copies of protected matter, such as ring tones, sound recordings, or video games, are distributed to end-users via the Internet, and the SCC in *ESA v SOCAN* made it clear that such downloads are not a communication to the public. *ESA v SOCAN* did not, however, address whether making an unpublished digital item available for download published it, although Justice Rothstein left open that possibility in his dissent.[134] Does a user's ability to download a copy of an image from an archives' website mean that the archives has published the work by putting it online?

In the context of the Internet, it is established law that the content provider authorizes the communication to the public.[135] Assuming that the archives has made the content available online with the permission of the rights holders, the archives has, in the language of the definition of publication, made a single copy of a work available to the public. Quantitatively speaking, a single copy that can be accessed online is sufficient to meet the demand of the public. Furthermore, the *ESA v SOCAN* decision suggests that the *means* of making the copies of these works available to the public – by telecommunication – no longer excludes online posting from the definition of publication. It would therefore appear that the archives has published the hitherto unpublished works and sound recordings it makes available online with the permission of the rights holders.

If, however, the content was posted *without* the permission of the rights holders, the same process would constitute infringement of the reproduction right and possibly the right of first publication. However, the online content would not be deemed to be published if the first publication occurred without the rights holders' permission.[136] Thus, we have the curious situation in which the same act results in two different outcomes with respect to publication status.

Summary of archives issues

Whether or not items in an archives' holdings are published is a significant matter, particularly regarding the duration of copyright and entitlement to users' rights for LAMs. If archival practices relating to acquisition, making copies for users, and online dissemination change the publication status of the material in question, it is a matter of concern. For one thing, archives would face an impossible burden of recordkeeping to keep track of changed publication status. More importantly, archives do not want to be vulnerable to the risk of copyright infringement by publishing something for the first time without

134 *ESA v SOCAN*, ¶¶111–112.

135 *Society of Composers, Authors and Music Publishers of Canada v Canadian Assn. of Internet Providers*, 2004 SCC 45, ¶¶93–95, 111–12.

136 *CA* 2.2(3).

the rights holder's permission. The foregoing analysis suggests that there is no need for archives to change their practices when it comes to acquiring new collections and responding to users' requests for copies (regardless of format). These activities do not publish the items involved. Nor does first publication's new sibling, the distribution right, affect acquisition practices.

However, when it comes to making copies of holdings available online, two outcomes are possible. If the images are made available with the permission of the rights holder(s), *ESA v SOCAN* suggests that images of unpublished works and sound recordings available online for copying or download are published by the act of putting them online. If the archives has not obtained the authorization of the rights holders, the items are not deemed to be published. This bifurcated outcome creates a problem for archives in tracking the publication status of items made available online. Tracking publication status of items in their holdings has never been easy because archivists are often unaware of what items users have published. Until *ESA v SOCAN*, it was not necessary to consider the publication status of what the archives itself put online because making images of their holdings available online was excluded from the definition of publication.

However, the ambiguity created by *ESA v SOCAN* will have little practical impact on archival practice. In making holdings available online, the risk of infringement has generally been a far greater concern than publication status. Unless the archives is the rights holder or has obtained the necessary permissions, digitizing its holdings *prima facie* infringes the reproduction right, and making them available on the Internet infringes the communication right. Thus, archives have generally selected for online dissemination the holdings that pose no copyright complications, i.e., materials in which the copyright has expired or in which the archives owns the copyright.[137] However, for various reasons, such an approach is not sustainable, and there is some evidence that archivists are shifting from an item-level copyright analysis to a risk assessment approach in selecting for Internet access.[138] The ambiguity in the meaning of publication is no reason to stop this shift in practice. A bolder approach and a higher tolerance for risk will better serve the archival mission.

Conclusion

Publication has been the neglected child in Canadian intellectual property law. It has rarely been addressed in jurisprudence, and the standard treatises do not go beyond traditional views of the topic, despite the potential disruption

137 Jean Dryden, "Copyright Issues in the Selection of Archival Material for Internet Access," *Archival Science* 8, no. 2 (2008): 123–47; Jean Dryden, "The Role of Copyright in Selection for Digitization," *American Archivist* 77, no. 1 (2014), 64–95.

138 Dryden, "The Role of Copyright," 81–83.

posed by the digital environment. This study has looked at related rights that deal with the dissemination of copyright-protected matter and has explored the relationship between publication and the principles established in judicial consideration of the communication right, such as the meaning of "the public," the form of copies, and the transmission of "durable copies." The SCC's determination of what is and is not a communication turns on what a member of the public possesses at the end of the transmission process. If the user streamed the content and has nothing but a memory of what she saw or heard, it was a communication. But if the user has downloaded a "durable copy," it was not a communication. If not a communication, what right applies to downloading?[139] Since the content in question was already published, whether or not the act of downloading published it is not at issue, but the door is open to having certain things that are transmitted online "published," depending not on the means of delivery (which, after all, is still via telecommunication), but on what the end-user retains from the transmission.

As Mihály Ficsor says, "Digital transmissions scramble the beautifully arranged ... and justified picture of … two families of rights [copy-based (e.g., distribution, rental) and non-copy-based (e.g., performance, broadcast, communication to the public)].[140] But despite the scrambling of the boundaries, the WIPO treaties maintained the distinction. Based on *ESA v SOCAN* and the amendments made to comply with the WIPO treaties, if we match downloading and streaming with the relevant rights in Canada's *Copyright Act*, they correspond respectively to distribution (of tangible copies) and communication/making available by telecommunication (which does not result in a "durable copy").

Ricketson and Ginsberg argue that "the distinction between distribution of tangible copies of a work, and communication to the public of digital files containing the same work, is rather scholastic,"[141] and they call for a rethinking of the publication/transmission distinction.[142] Ficsor maintains that both the making available right and the distribution right in the WIPO treaties are minimum levels of protection only, and that member states in their national implementations could extend the distribution right to digital copies.[143] As well, the making available right was intended to be sufficiently broad to apply

139 It goes without saying that downloading also involves the right of reproduction; however, this article focuses on certain rights associated with dissemination of protected material, i.e., communication, first publication, and distribution.

140 Ficsor, *The Law of Copyright and the Internet*, §C8.08, p. 498.

141 Ricketson and Ginsberg, *International Copyright and Neighbouring* Rights, §11.94, p. 697.

142 Ibid., §6.50, p. 277.

143 Ficsor, *The Law of Copyright and the Internet*, §C8.09, 499–500; Ficsor, *Guide to the Copyright and Related Rights Treaties Administered by WIPO* (Geneva: WIPO, 2003), §CT6.4, p. 203 and §CT8.13, pp. 209–10. Ricketson and Ginsberg also suggest that distribution could be extended to classify digital transmissions as a form of distribution (§11.94, p. 697).

to copy-based and non-copy-based rights.[144] To extend either (or both) in this way would render the distinction meaningless, which suggests that the distinction itself may not be a particularly innovative way of solving the problem created by the increasingly blurred lines between rights that were clear in the pre-digital age.

It appears that the meaning of publication in Canadian copyright law is ambiguous, particularly in the digital environment. While a substantial body of jurisprudence would greatly assist in clarifying the matter, it is not realistic to expect courts to resolve the ambiguity. Even if we had the body of jurisprudence available to Americans,[145] Canadian courts might not be any more consistent in their interpretation of the term than American courts have been.

In the meantime, what would help us to better understand its meaning? One solution may be to change the terms we use. Vaver notes the confusion between the activity of publication and the right of first publication, and suggests renaming the latter the right of "first public distribution."[146] Another possibility is more and better definitions. Attempting to define terms in a rapidly changing technological environment while maintaining the principle of technological neutrality is challenging. Nevertheless, the Act would be clearer if more terms were defined (e.g., communication, public) and if existing definitions were more extensive, particularly by incorporating examples of electronic forms. Another possibility to consider is different concepts of what it means to be published, depending on the category of protected matter, as seen in the Australian statute.[147]

Re-examining the boundary between reproduction-based rights and performance-based rights offers a more extreme possibility. While such a distinction was logical in the analog world, the means of making copies available has been transformed by digital and communications technologies, and the exclusion of communication to the public from publication begins to break down. Drafting an amendment that would move some communications into the scope of publication would be extremely challenging, but there are some situations in which communication to the public should be considered publication.

On the other hand, ambiguity has certain advantages in that it permits flexibility in interpreting the law. Clarity might be achieved by tighter boundaries and a narrower scope, but the unrelenting pace of technological change demands definitions and provisions that are sufficiently flexible to accommodate technologies not yet at hand.

144 Ficsor, *The Law of Copyright and the Internet* §4.87, p. 208.
145 Cotter, "Toward a Functional Definition of Publication in Copyright Law," and Gerhardt, "Copyright Publication."
146 Vaver, *Intellectual Property Law*, 155.
147 *Copyright Act 1968* (Australia), s 29(1)(a)–(c).

The digital environment has changed the copyright landscape, but despite the amendments that have implemented the requirements of the Internet treaties, the Act remains rooted in attempting to control the products of the printing press, including what it means to publish something. We struggle to apply a law that does not match the digital environment. The ease of copying and dissemination has alarmed rights holders who fear losing control over their works. Consequently, the jurisprudence has focused on the communication right. Does the lack of attention to publication mean that it is irrelevant? Or does it mean that we understand it? Neither is the case. We will still need to understand what it means to be published because of the many ways that publication triggers certain provisions in the *Copyright Act*. Until it receives more judicial and academic attention, publication will continue to be an ambiguous concept.

Given that this ambiguity may continue for some time, what are Canadian archives to do? It is worth remembering that "perfect safety and absolute certainty are extremely rare in copyright law."[148] Uncertainty about the meaning of publication does not change the need for our practices to continue to evolve to seize the opportunities offered by the digital environment. If archival institutions increasingly move toward a risk-management stance vis-à-vis copyright issues, publication status will be but one of many factors to consider when assessing risk. While it is important to be aware of the ambiguity around publication, it is something archivists can live with.

An information professional with qualifications in records management, archives, and librarianship, ***Jean Dryden*** *has over 35 years of experience as a staff archivist and archival administrator at the National Archives of Canada, the Provincial Archives of Alberta, and as Chief Archivist of the United Church of Canada/Victoria University Archives. Her doctoral dissertation investigated the copyright practices of Canadian archival repositories in making their holdings available online. While a faculty member at the University of Maryland, she completed a grant-funded comparative study of the practices of American repositories. In 2015, she completed a Master of Laws degree specializing in intellectual property at Osgoode Hall Law School at York University, Toronto. She has been active throughout her career on committees and boards of professional associations. As chair of the Bureau of Canadian Archivists Copyright Committee, she played a lead role in successful lobbying for amendments to the* Copyright Act *that benefited libraries, archives, and museums. In addition to being the author*

148 *Code of Best Practices in Fair Use for Academic and Special Libraries* (Washington, DC: ARL, 2012), 10.

of numerous publications and presentations on copyright issues, she is the author of Demystifying Copyright: A Researcher's Guide to Copyright in Canadian Libraries and Archives, *2nd ed. (Ottawa, 2014) and a past editor of* Archivaria.