INTRODUCTION

The copyright environment in Canada is in a dynamic phase. New legislation to amend the Copyright Act is anticipated to shift the balance inherent in copyright between the rights of the right holders and those of users. At the same time, public sector educational institutions, both in the kindergarten to grade twelve (K-12) and at the post-secondary level, are facing a fundamental shift as licenses for reprography are being phased out and replaced with a tariff. The changes in legislation and the move to
a tariff-setting environment to cover reprography are generating important discussions on the rights of copyright holders and the public interest. The exclusive rights granted by copyright to creators are delineated in the section 3 of the Canadian Copyright Act\(^1\) but the public interest has no similar delineation.

The public interest is a concept that is much in use in discussions about copyright. A “public good,” the “public sphere,” and the “public domain” are concepts that also involve the public and which have been explored in connection with copyright. In a thesis on copyright, consortia\(^2\) and academic libraries, Catherine Maskell defines the three related terms. “Public goods” she describes as existing “for the greater social and cultural benefit of society [and] are not considered part of the market economic system.”\(^3\) They are considered “non-commodifiable” and “should be maintained for the good of the whole, that is, for the good of society or the economy . . ..”\(^4\) The “public sphere” is explained as:

> a real or virtual space in which the public, the community, or the enlightened citizenry, can discuss, criticize and inform each other as to the government and economic policies of the day. . .. For the public sphere to operate efficiently it is important to make sure that all the necessary information is available for use by the citizenry in order for them to fully participate in their community.\(^5\)

The “public domain” is defined as referring to works “that cannot be owned by anyone and therefore are freely available for the public to use.”\(^6\)

When copyright was first created in England in 1710 in the Statute of Anne,\(^7\) Parliament created what has become known as the “public domain” by creating certain limited term rights in works and delineating those works from others which did not carry such rights, thus leaving the latter “in the public domain.” As well, works in which copyright has expired, the underlying facts, ideas, and information in all works are said to lie in the public domain and therefore, among other uses, can be copied freely.\(^8\)

\(^1\) Copyright Act, R.S.C. 1985, ch. C-42.

\(^2\) Consortia in the library context are associations of libraries that have joined together to leverage pooled funds and expertise for the purpose of purchasing electronic books and journals.


\(^4\) Id. at 60-61.

\(^5\) Id. at 60.

\(^6\) Id. at 59.

\(^7\) Statute of Anne, 1710, 8 Ann., c. 19 (Eng.), available at http://avalon.law.yale.edu/18th_century/anne_1710.asp.

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The public domain is a nuanced concept that applies to intellectual property as a whole.\footnote{Margaret Ann Wilkinson, \textit{National Treatment, National Interest and the Public Domain}, 1 U. OTTAWA L. & TECH. J. 23 (2003–2004).} Certainly there are works that are unequivocally in the public domain, but there are many works that hover around the edges of the public domain that can be copied under specific circumstances and not under others. Pamela Samuelson has offered a map of the public domain, identifying an unambiguous core of material in the public domain, and protections outside the core material that can either allow or prohibit uses, depending on the circumstances.\footnote{Pamela Samuelson, \textit{Mapping the Digital Public Domain: Threats and Opportunities} (2003) 66 LAW & CONTEMPORARY PROBS. 149 (2003).} She states that the public domain may be threatened by the laws and policies of the digital age but she also argues that the public domain may be more effectively used when commercialized even though such commercial uses may violate public policy. Margaret Ann Wilkinson, on the other hand, posits that the public domain as previously conceived may now be outmoded and be rightfully considered as a theoretical space. Wilkinson argues that the digital age has blurred the crisp lines of any mapping exercise as other dimensions of rights, such as moral rights, factor in decisions on uses of works in the public domain.\footnote{Wilkinson, \textit{supra} note 9, at 44.}


Excessive control by holders of copyrights and other forms of intellectual property may unduly limit the ability of the public domain to incorporate and embellish creative innovation in the long-term interests of society as a whole, or create practical obstacles to proper utilization. This is reflected in the exceptions to copyright infringement enumerated in ss. 29 to 32.2, which seek to protect the public domain in traditional ways such as fair dealing for the purpose of criticism or review and to add new protections to reflect new technology, such as limited computer program reproduction and “ephemeralrecordings” in connection with live performances.\footnote{Id. at 356.}

The Court is using the concept of the public domain to reinforce access and use of works to ensure their proper utilization by society. This interpretation provides fluidity, or nuance, to the concept of the public domain and aligns the public domain with the public’s use of work that does not impinge on the creator’s exclusive rights.
Maskell does not define the “public interest,” but the Supreme Court of Canada’s clear, unanimous statement in *CCH Canadian, Ltd. v. Law Society of Upper Canada*\(^{14}\) provides the authoritative definition:

> [T]he purpose of copyright law was to balance the public interest in promoting the encouragement and dissemination of works of the arts and intellect and obtaining a just reward for the creator.\(^{15}\)

The original subtitle of England’s first law on copyright, the Statute of Anne, from which Canada’s legislation is descended, was “An Act for the Encouragement of Learning by Vesting the Copies of Printed Books in the Authors or Purchasers of Such Copies, during the Times therein mentioned.”\(^{16}\) The title aligns the original purpose of copyright directly with the societal benefit of learning, or, in other words, with the public interest.

The purpose of the original legislation was stated to be the encouragement of learning; the creation of the monopoly legislated for copying was Parliament’s instrument for carrying out the purpose of encouraging learning. Logically, if learning is not encouraged by so “vesting the copies,” then a modern Parliament should reconsider such a vesting. But Canada’s Supreme Court has articulated that the public interest should not only reflect “promoting the encouragement and dissemination of works of the arts and intellect” (i.e., learning) but should be balanced with “obtaining a just reward for the creator.” It is this notion of the “public interest” which requires the balancing of the interest of the public in learning with the interest of the public in rewarding creators.

Limitations and exceptions to copyright, sections 29 to 32.2 of the Copyright Act, with fair dealing being one such exception or “users’ right,”\(^{17}\) represent the public interest in copyright. This article will document the authority of the statutes and the Courts that establishes this truth and illustrate the mechanisms in intellectual property regimes that represent the public interest.

### I. INSTITUTIONS THAT PROMOTE THE PUBLIC INTEREST

Libraries and educational institutions are involved in learning activities and qualify as entities that promote “the encouragement and dissemination of works of the arts and intellect” by the fact of their activities in teaching and learning and by acquiring and lending, disseminating or otherwise providing access to works. Librarians espouse a professional ethos on access. Statements from Canadian library associations connect the provision of information as a public good and in the public interest with the

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\(^{15}\) *Id.* at 356.

\(^{16}\) *Statute of Anne*, 1710, 8 Ann., c. 19 (Eng.).

\(^{17}\) *CCH*, [2004] 1 S.C.R. at 365.
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protection and defence of the right of intellectual freedom in Canadian society. The Canadian Library Association’s statement on Intellectual Freedom asserts:

All persons in Canada have the fundamental right, as embodied in the nation’s Bill of Rights and the Canadian Charter of Rights and Freedoms, to have access to all expressions of knowledge, creativity and intellectual activity, and to express their thoughts publicly. This right to intellectual freedom, under the law, is essential to the health and development of Canadian society.  

The Canadian Association of Research Libraries Policy Statement on Freedom of Expression declares:

It is the responsibility of research libraries to facilitate access to all expressions of knowledge, opinion, intellectual activity and creativity from all periods of history to the current era including those which some may consider unconventional, unpopular, unorthodox or unacceptable. To this end research libraries shall acquire and make available, through purchase or resource sharing, the widest variety of materials that support the scholarly pursuits of their communities.

The statement of the Canadian Association of Research Libraries bridges the concepts of access and freedom of expression as societal values to the acquisition, purchase and sharing of works. The statements echo the Supreme Court’s position on the purpose of copyright in *Théberge*:

The Copyright Act is usually presented as a balance between promoting the public interest in the encouragement and dissemination of works of the arts and intellect and obtaining a just reward for the creator (or, more accurately, to prevent someone other than the creator from appropriating whatever benefits may be generated).

The statements from the Canadian library associations conflate the public interest with access to works and freedom of expression. Aligning with the librarians’ position, the Supreme Court recognizes the public interest in learning and dissemination of works and views public interest uses as consistent with the purpose of copyright. The order of the policies given by the Supreme Court indicates a priority: first is the public interest in learning and dissemination of works and the second is obtaining a
just reward for the creator. As noted above, libraries, archives, museums and educational institutions are inextricably linked to the encouragement of learning and the dissemination of knowledge. They operate at the fulcrum of copyright’s balance because they purchase works and in that way reward the creator. And they provide access to works and encourage learning, and, in doing both, serve the public interest as defined by the Supreme Court.

In serving the public interest in copyright, the exceptions and limitations to exclusive rights are critical to providing access to information to the public, supporting learning and research, promoting the free flow of information, preserving cultural heritage and encouraging free expression. Without limitations to copyright, the advancement of knowledge and innovation could not proceed, which would result in, as Justice Binnie stated in Théberge, “(e)xcessive control by holders of copyright,”\(^{22}\) and the public interest would not be served. These limitations are so important in the modern copyright environment that Canada’s Supreme Court has labelled them “users’ rights”\(^{23}\) — as important as the economic and moral rights that are vested explicitly under the Copyright Act.

Copyright is but one facet of Canada’s intellectual property regime. The intellectual property regime is a public system, legislated by government, of private rights, such as copyright and patent rights, and private rights are conferred in a public system only if it serves “some collective good”\(^{24}\) or the public interest. Two other schemes of Canada’s intellectual property environment that balance public and private rights are the patent and trade-mark regimes. How is the public interest asserted in each of the three intellectual property regimes (patent, trademark and copyright)?

Statutory intellectual property rights are reasonable agreements between the state and rights holders. The state grants a limited monopoly in return for some type of public use or societal benefit. The public policy justification for intellectual property is described by Professors Daniel Gervais and Elizabeth Judge:

From a larger public policy perspective . . . intellectual property law seeks to promote the dissemination and circulation of ideas by giving the creator some control over the ideas without resorting to hiding and hoarding them; intellectual property laws provide the right in the intangibles which the “natural” non-rivalrous and non-exclusive qualities of intellectual property otherwise make difficult to protect. By rewarding inventors and creators, intellectual property rights provide an incentive to create and

\(^{22}\) Théberge, [2004] 1 S.C.R. at 356.


\(^{24}\) TARLETON GILLESPIE, WIRED SHUT: COPYRIGHT AND THE SHAPE OF DIGITAL CULTURE 57 (2007).
invent and, in turn, by encouraging the circulation of that intellectual production, increase the pool of human intellectual creations.25

The Patent Act,26 Copyright Act, and Trade-marks Act,27 as it applies to statutory marks,28 each set out protections that balance the public interest with private interests upon the grant of the patent, the creation of the work, or registration of the mark.

The Patent Act and Trade-marks Act each authorize an administrative agency to supervise and regulate the issuance of patents and trade-marks. These administrative agencies have a quasi-judicial role enabling them to make decisions with legal effect on the rights of the parties involved. Their decisions can be considered by courts of law as set out in the statutes. As will be established below, the Copyright Act grants no similar authority to a corresponding administrative agency — although it does create a Copyright Office. On the other hand, the Copyright Act does provide for an administrative agency which does not have a corollary in the Patent Act nor in the Trade-Marks Act, namely the Copyright Board. Its role, however, does not affect all copyright holders or reach all copyrights.

This article will explore the question of who guards the public interest in intellectual property in Canada. It will consider the patent regime and the role of the Patent Office and the Commissioner of Patents. Are they gatekeepers of the public interest in that area of intellectual property? In the Trade-marks Office, is the Registrar of Trade-marks an arbiter of the public interest? In the copyright regime, is the Copyright Office a guardian of the public interest? Is it structured to negotiate the line between the public interest in the promotion of learning and dissemination of works and that of the limited monopoly which provides just rewards for creators? If it is not, is there any other institution created under the Copyright Act which has this role?

The article will examine the statutes for patents, trade-marks, and copyright to determine how the public interest is represented in each area. It will consider the institutions created under each regime and their duties and responsibilities in balancing the private interests of the rightholders and those of the public. In particular, with respect to the copyright regime, the paper will examine role of the Copyright Board which is created under the Copyright Act in addition to the Copyright Office. In connec-

28 The article will examine only statutory marks in order to compare statutory regimes; common law protection of trademarks does not fit the comparative structure.
tion with the Copyright Board, the article will look specifically to the decisions of the Copyright Board, Federal Court of Appeal and the Supreme Court of Canada to date as they have been delivered in two cases: Society of Composers, Authors and Music Publishers of Canada v. Canadian Association of Internet Providers \(^{29}\) and Alberta (Education) v. Access Copyright.\(^{30}\) In examining the legislative framework of the three intellectual property regimes, we will observe how effectively the public interest is represented through the respective institutions.

II. LEGISLATIVE CONTEXT

In the patent regime every application must be examined in reference to the provisions of the Patent Act. It is a formal process. In the trade-marks regime formalities are required for registration and full protection under the Trade-marks Act. Unregistered marks are an anomaly and can only be dealt with under s. 7 of the statute or at common law. In patents, the Patent Examiner, a civil servant, safeguards the public interest by only allowing inventions that meet the statutory requirements of the grant of patent. With trade-marks the Registrar safeguards fair competition in the public interest by allowing in the Register only those trade-marks that are not confusing.

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<th>Intellectual Property Regime Matrix</th>
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In contrast to patents and registered trade-marks, copyright is automatic, immediate and arises upon creation\(^{31}\) and fixation\(^{32}\) of a work or other subject matter.\(^{33}\) Works in copyright qualify for statutory protection. No formalities are required. There is no requirement to register the copyright, and there is no refusal of registration in copyright.

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\(^{30}\) Alberta (Educ.) v. Access Copyright, 2010 FCA 198.

\(^{31}\) Copyright Act, R.S.C. 1985, ch. C-42, § 5.


\(^{33}\) There is copyright in performer’s performances, sound recordings and communication signals as per the Copyright Act, R.S.C. 1985, ch. C-42, §§ 15, 18, 21.
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began as a formal regime under the Statute of Anne in 1710. Registration was required and copyright was protected for a limited but renewable term. A change occurred when the Berne Convention34 was ratified in 1886, which specified (art. 5(2)) no formalities were required to register copyright, and Canada abandoned the formalities of copyright registration. The benefits of registration are outlined in American sources. The United States held on to the formalities of copyright registration until 1989. Registration served four principal functions:

1. [Notice] has the effect of placing in the public domain a substantial body of published material that no one is interested in copyrighting;
2. It informs the public as to whether a particular work is copyrighted;
3. It identifies the copyright owner; and
4. It shows the date of publication.35

The formalities of U.S. registration included an imprinted notice, a published announcement, and a deposit of a copy of the work in a public place. All formalities were required to be fulfilled in advance to secure copyright and delays could invalidate the right and place the works in the public domain. The copyright term was renewable upon application. The deposit created a public record of the work for the benefit of the public.36 Registration did involve an examination; its purpose was to look for any discrepancy in dates or facts. There was no examination for plagiarism.37 Without formalities, how is the public interest in copyright represented? There is no adjudication of the copyright, no refusal of registration of copyright. There are no authoritative records of registration; there is no clear expression of the public interest because there is no authorized Officer to speak for it.

III. PATENTS

A. Overview

Patents are issued by the Patent Office through a lengthy and robust examination process. As the first step, and prior to any application of the criteria for the grant of patent, it must be determined that the invention qualifies as patentable subject matter. For example, higher life forms are

36 BENJAMIN KAPLAN, CASES ON COPYRIGHT, UNFAIR COMPETITION, AND OTHER TOPICS BEARING ON THE PROTECTION OF LITERARY, MUSICAL, AND ARTISTIC WORKS 148 (2d ed. by Ralph S. Brown, Jr. 1974).
37 Id. at 156.
not patentable in Canada.\textsuperscript{38} The Supreme Court of Canada ruled in \textit{Commissioner of Patents v. President and Fellows of Harvard College}\textsuperscript{39} that unless Parliament specifically included higher life forms under the statute’s definition of invention, the majority of the Court\textsuperscript{40} agreed with the Commissioner of Patents that higher life forms are not patentable:

\begin{quote}
Owing to the fact that the patenting of higher life forms is a highly contentious and complex matter that raises serious practical, ethical and environmental concerns that the Act does not contemplate, I conclude that the Commissioner was correct to reject the patent application. This is a policy issue that raises questions of great significance and importance and that would appear to require a dramatic expansion of the traditional patent regime. Absent explicit legislative direction, the Court should not order the Commissioner to grant a patent on a higher life form.\textsuperscript{41}
\end{quote}

Patentable subject matter also excludes scientific principles, abstract theorem\textsuperscript{42}, or medical methods of treatment.\textsuperscript{43}

The Federal Court recently clarified that business methods are not statutorily excluded from patent.\textsuperscript{44} In the same case, the court provided clear guidance on the limitations of the role of the Commissioner of Patents:

\begin{quote}
The Commissioner’s decision introduced one more novel and unnecessary requirement for patentability into the Canadian patent regime: the technical or technological requirement. She also suggests that “new and useful knowledge” must be “scientific or technological” in order to constitute a patentable art. Thus, according to this reasoning, one must now assess whether an invention — and specifically what has been added to human knowledge — is technological in nature.

In fairness, in this instance the Commissioner does glean some of her rationale from the language in the Patent Rules and Canadian jurisprudence, but this does not translate into an endorsement or imposition of a “technical test”. There is no reference to such a test in the Canadian jurisprudence (or none was advanced in this Court). It was not within the Commissioner’s jurisdiction to introduce one. . .\textsuperscript{45}
\end{quote}

\textsuperscript{39} \textit{Id.}.
\textsuperscript{40} The majority decision (L’Heureux-Dubé, Gonthier, Iacobucci, Bastarache and LeBel, J.J.) was written by Justice Bastarache. The dissenting position (McLachlin, C.J. and Major, Binnie and Arbour, J.J.) was written by Justice Binnie.
\textsuperscript{44} Amazon.com, Inc. v. Canada (Attorney General), 2010 FC 1011, [2010] 4 F.C.R. 541, ¶ 63. Case is now under further appeal.
\textsuperscript{45} \textit{Id.} ¶¶ 69-70.
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The Federal Court concluded that the Commissioner of Patents erred in law regarding patentable subject matter and overstepped her authority in deciding policy matters rather than applying the law:

The absolute lack of authority in Canada for a “business method exclusion” and the questionable interpretation of legal authorities in support of the Commissioner’s approach to assessing subject matters underline the policy driven nature of her decision. It appears as if this was a “test case” by which to assess this policy, rather than an application of the law to the patent at issue.46

Ensuring that the patent application is patentable subject matter is the first step for the Commissioner of Patents. Once the invention is determined to be patentable subject matter, the Patent Office must ensure the invention conforms to the definition in section 2 of the Act:

“Invention” means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter.47

Each of the requirements, novelty, utility and inventiveness is examined separately.

An invention must be “new” and must not have been previously available to the public.48 Section 28.2(1) of the Patent Act specifies:

The subject-matter defined by a claim in an application for a patent in Canada (the “pending application”) must not have been disclosed

(a) more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant, in such a manner that the subject-matter became available to the public in Canada or elsewhere. . .

The invention must not have been made or wholly described in such a way as to provide sufficient information for the invention to have been built beforehand. In Apotex, Inc. v. Sanofi-Synthelabo Canada, Inc.,49 the Supreme Court of Canada established a two-pronged test for novelty or anticipation. It was determined that both disclosure and enablement were required:

Where there is no such disclosure, there is no discovery of the special advantages of the selection patent as compared to the genus patent, and the disclosure requirement to prove anticipation fails. At this stage, the person skilled in the art is reading the prior patent to understand whether it discloses the special advantages of the second invention. No trial and error is permitted. If in reading the genus patent the special advantages of the invention of the selection patent are not disclosed, the genus patent does not anticipate the selection patent

46 Id. ¶ 78.
48 Id. § 28.2(1) a.
What amount of trial and error or experimentation is permitted before a prior disclosure will not constitute enabling disclosure? Certainly, if the applications judge finds that an inventive step was required to get to the invention of the second patent, the specification of the first patent will not have provided enabling disclosure. But even if no inventive step is required, the skilled person must still be able to perform or make the invention of the second patent without undue burden.50

The Supreme Court of Canada stated in Sinofi that to establish anticipation of a patent two criteria must be met: 1) disclosure and 2) enablement. The Court held that the “Beloit test”51 dealt solely with the first criterion, specifically that the prior art must disclose the claimed invention at issue. In Sinofi the Court added the second criterion of enablement which would require that the disclosure would have enabled a person skilled in the art to make the claimed invention without difficulty or “undue burden.”52

The Court is setting out that if the public had prior access to the knowledge to build the invention, novelty is destroyed because nothing new is being given to the public in exchange for the patent monopoly. The Court is also stating that if there is sufficient information and detail in the disclosure to enable a skilled technician to follow the disclosure and arrive at the invention without difficulty, the invention is not new. The public interest requires that an invention be novel. With the novelty test, the Commissioner of Patents is ensuring that the public is the beneficiary of a new, unanticipated invention, sufficiently novel to merit private monopoly rights for the inventor. Novelty is established through the prior art search and enabling disclosure. Without novelty the patent application will fail.

The second criterion is utility. A patentable invention must be useful. It is deemed to be useful if there is a public benefit; if it achieves a specified goal; if it improves a process; if it has advantages; and if it works.53 The art, process, machine, manufacture or composition of matter is useful if it solves a problem or achieves a specific goal. It must do what it claims to do and the disclosure and claims must identify all the components and requisite steps to make the invention work. Section 27(1) of the Patent Act provides:

The Commissioner shall grant a patent for an invention to the inventor or the inventor’s legal representative if an application for the patent in Canada is filed in accordance with this Act and all other requirements for the issuance of a patent under this Act are met.

(2) The prescribed application fee must be paid and the application must be filed in accordance with the regulations by the inventor or
the inventor’s legal representative and the application must contain a petition and a specification of the invention. 

(3) The specification of an invention must

(a) correctly and fully describe the invention and its operation or use as contemplated by the inventor;

(b) set out clearly the various steps in a process, or the method of constructing, making, compounding or using a machine, manufacture or composition of matter, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it pertains, or with which it is most closely connected, to make, construct, compound or use it;

(c) in the case of a machine, explain the principle of the machine and the best mode in which the inventor has contemplated the application of that principle; and

(d) in the case of a process, explain the necessary sequence, if any, of the various steps, so as to distinguish the invention from other inventions.

(4) The specification must end with a claim or claims defining distinctly and in explicit terms the subject-matter of the invention for which an exclusive privilege or property is claimed.

The invention must be of some use or have some value to the public. As a factor in utility, the public benefit is determined by commercialization. It is deemed to be useful it there is a market for the invention. It must be operable to the extent that “the effects which the patentee professed to produce can be, in fact produced.” With the utility test, the Commissioner of Patents is ensuring that the public interest is satisfied and will benefit from a) a useful art, process, machine, manufacture or composition of matter and b) its full disclosure so when the patent expires the public is sufficiently able to make and use the invention. Without utility, operability and disclosure, the public would have gained nothing useful in exchange for the monopoly and the patent application would not succeed.

The third criterion for patentability requires that the invention must be non-obvious. It cannot be that anyone could have done it. In section 28.3 the Patent Act states:

The subject-matter defined by a claim in an application for a patent in Canada must be subject-matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to

(a) information disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or

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indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere; and
(b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere.

An inventive step or ingenuity is required. The statute excludes inventions that a worker skilled in the art or science, on the date of claim, would have been able to work out, with access to all previously available information. In weighing inventiveness the Supreme Court of Canada provides guidance on the question of obviousness:

Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?56

Excluded from patent are routine improvements that could have been achieved without difficulty, through deduction, without an inventive leap. When a patent application is considered, the Commissioner of Patents must make a judgment that an invention is a worthy addition to the store of public knowledge with sufficient ingenuity to serve the public interest and merit the private right of patent. If the application fails to give the public an inventive leap over the prior art, the patent will not succeed.

The private interests of the inventor are protected by the exclusive use of the patent for the term. The Patent Act in section 42 grants the inventor:

The exclusive right, privilege and liberty of making, constructing and using the invention and selling it to others to be used . . . .

The term of protection for patents is twenty years as per s. 44 of the Patent Act. Once the patent term ends the exclusive rights of manufacture, sale, use and distribution expire.

The private interest of the patent holder to make, use and sell the invention is balanced against the public interest which is served through the dissemination of knowledge by virtue of the full disclosure of the invention, the limited term of the patent, and the limitation of the grant of patent to only those that meet the criteria.

Research may be conducted on patents, based on the enabling disclosure, to spur innovation and facilitate further invention. The very fact of disclosure, as required in s. 10 of the Patent Act, assumes some use.

Use of the patent for research and experimentation furthers society’s interest in innovation and is a matter of public policy. In Merck & Co. Inc. v. Apotex Inc.57 the Federal Court of Appeal recognized a common-law fair use defence to patent infringement:

“In my analysis, all that is required is that the infringing product was made merely by way of *bona fide* experiment, and not with the intention of selling and making use of the product in the commercial market.\(^5\)

A rationale on the exception for research and experimental use of patents is documented by the World Trade Organization’s Dispute Settlement Panel Report:

The existence of an experimental use exception was common among WTO Members . . . Similarly, judicial decisions in common law countries such as the United States and Canada had also recognized such an exception. The scope of the exception varied from country to country, but would ordinarily include one or more of the following: (a) testing an invention to determine its sufficiency or to compare it to prior art; (b) tests to determine how the patented invention worked; (c) experimentation on a patented invention for the purpose of improving on it or developing a further patentable invention; (d) experimentation for the purpose of “designing around” a patented invention; (e) testing to determine whether the invention met the tester’s purposes in anticipation of requesting a licence; and (f) academic instructional experimentation with the invention.\(^5\)

The experimental use exception was grounded in the theory that the experimentation was either a *de minimis* use of the invention or a form of scientific experimentation, i.e. a “fair use”. As such, the exception was well within the four corners of Article 30 of the TRIPS Agreement. It was “limited” in that it only applied to non-commercial experimentation, i.e. testing for academic or scientific purposes, or to commercial experimentation when a licence was anticipated. It would not be worth the trouble to sue a researcher or university for patent infringement, particularly if the research did not threaten the commercial interests of the patent holder.\(^\)\(^6\)

The report added that:

It would be unthinkable to shut the door to further research for 20 years in this way by granting a patent. The research community proceeded on the assumption that science would advance most rapidly if the community enjoyed free access to prior discoveries.\(^\)\(^6\)

The public policy inherent in the regime is set out in the Patent Act, which is administered through the Patent Office and its Officers as established by statute. Section 4 of the Patent Act provides that a Commissioner of Patents shall be appointed and sets out the Duties of the Commissioner as follows:

\(^5\) Id., ¶ 109.

\(^6\) Id. (citing WEGNER, supra note 59, at 455; Frearson v. Loe (1878), 9 Ch. D. 48 66, cited in Micro Chemicals, 2 C.P.R. at 203).
4. (1) The Governor in Council may appoint a Commissioner of Patents who shall, under the direction of the Minister, exercise the powers and perform the duties conferred and imposed on that officer by or pursuant to this Act.

Duties of Commissioner

(2) The Commissioner shall receive all applications, fees, papers, documents and models for patents, shall perform and do all acts and things requisite for the granting and issuing of patents of invention, shall have the charge and custody of the books, records, papers, models, machines and other things belonging to the Patent Office and shall have, for the purposes of this Act, all the powers that are or may be given by the Inquiries Act to a commissioner appointed under Part II of that Act.62

Through the Patent Office and under the authority of the Commissioner of Patents, patent applications are examined upon request as per section 35 of the Patent Act. The Patent Office reviews the patent application’s compliance with the statute, ensuring that the invention is new, useful and inventive. Based on the examination process, including any amendments to the application, the patent is either allowed, and, upon payment of final fee, granted, or the application is refused. The applicant of a refused application may request that the patent application be sent to the Patent Appeal Board, where the Board hears the applicant and advises and recommends a course of action to the Commissioner.63 The Commissioner makes a decision based on the findings of the Patent Appeal Board. The Commissioner’s decision may be appealed to the Federal Court as per s. 17 of the Patent Act.

The Commissioner of Patents administers the Patent Act and is responsible for the granting of patents in Canada based on the criteria in the Act. The decision and issuance of a patent serves the public interest by virtue of adherence to strict procedures and restricting the grant of patent to inventions that are new, useful, and non-obvious as set out in s.2 of the Patent Act. Without patent protection, inventors would have no incentive to share their inventions and at least some would keep them secret. Society would be unable to benefit from the advancements of the inventions and would not learn from the inventors’ ideas and embellish and add further to the inventions of others.64

B. The Public Interest in the Statutory Patent Scheme

In patents the public interest is adjudicated by the Commissioner of Patents. The Commissioner is the gatekeeper. Every patent application

64 JUDGE & GERVAILS. supra note 25, at 3.
must be patentable subject matter and it must qualify as new, useful and non-obvious. The Commissioner of Patents adjudicates only to the extent granted in the Act. In the Harvard Mouse case, while the majority of the Court agreed with the decision of the Commissioner of Patents not to grant the patent, it disagreed with the Commissioner’s exercise of discretion beyond the Office’s statutory authority:

As noted above, the Patent Examiner concluded that the Commissioner of Patents has the right to deny a patent on the basis that it is not in the public interest to grant a patent on the subject matter in question. In his dissenting opinion, Isaac J.A. approved of this approach, stating that one of the purposes of the Patent Act is that the Commissioner must always be aware of, and take into account, the public interest in granting a patent. In a morally divisive case, the court should defer to the Commissioner’s decision to refuse to grant a patent pursuant to s. 40 where this decision is informed by considerations of public policy.

I disagree that s. 40 of the Patent Act gives the Commissioner discretion to refuse a patent on the basis of public policy considerations independent of any express provision in the Act.65

The Court clarified that the Commissioner of Patents safeguards the public interest only as long as it is within the Commissioner’s statutory duties. Fully within its statutory authority is the adjudication of the tests of novelty, utility and inventiveness. In return for the monopoly the Commissioner of Patents, on behalf of the public, has provided society with a new invention and laid open the workings of the patent which are available for current research and future use upon expiry of the term. In a different, unanimous decision, the Supreme Court set out:

“the bargain” that lies at the heart of patent protection. A patent is a statutory monopoly which is given in exchange for a full and complete disclosure by the patentee of his or her invention. The disclosure is the essence of the bargain between the patentee, who obtained at the time a 17-year monopoly on exploiting the invention, and the public, which obtains open access to all of the information necessary to practise the invention. Accordingly, at least one of the policy objectives underlying the statutory remedies available to a patent owner is to make disclosure more attractive, and thus hasten the availability of useful knowledge in the public sphere in the public interest.66

The decision to grant the patent is at the fulcrum of the balance between public interest and the patent monopoly. The public interest requires that an appropriate balance be reached between the private rights of the inventor for protection of his inventive ideas and reward and the exchange of the full disclosure to the public of a new invention.

With regard to patents, the private interests of the inventor are protected by certain monopolies, the manufacture, sale, use and distribution, given under section 42 of the Patent Act and the public interest is served by the full disclosure, the ‘how to manual’ of the patent. Patent, like copyright, is a limited term monopoly. Once the patent term expires, any use of the patented knowledge is open to the public.

The Supreme Court of Canada summarized the public policy of patent as follows:

In Canada the granting of a patent means the kind of contract between the Crown and the inventor in which the latter receives an exclusive right to exploit his invention for a certain period in exchange for complete disclosure to the public of the invention and the way in which it operates.67

The state rewards the inventor with protection during the term of the patent and represents the interests of the public by ensuring access to the accurate description of the invention to enable the creation of new knowledge and further innovation based on the information available from the disclosure of the patent. The state grants patents only if the invention qualifies; that is the patent has to meet the criteria required: it must qualify as proper subject matter of patent and it must be new, useful, and inventive. By so restricting the grant, the government protects the public interest by excluding incremental or anticipated innovations.68

The Supreme Court of Canada makes clear that Parliament, as representative of the democratic public will of the Canadian people, through legislation, sets the balance in patents. The Patent Act is adjudicated by the Commissioner of Patents, as authorized by statute to be the gatekeeper in the patent regime. Challenges to the decisions of the Commissioner of Patents go before the courts and the courts ensure the will of Parliament is accurately interpreted by the gatekeeper.

IV. TRADE-MARKS

A. Overview

With regards to trade-marks, the private interests in marks that distinguish products or services are protected under the Trade-marks Act. Trade-marks are usually one or more words, a set of numbers or letters, a slogan, design or a guise, and are symbols that link the source or reputation of a product or service with the product or service. Trade-marks are a way to guarantee the source and quality of a good or service and provide a shortcut for consumers in selecting goods and services in the market place.

68 JUDGE & GERVAIS. supra note 25, at 423.
Who Safeguards the Public Interest?

Trade-marks cannot overreach to prevent competition but they can protect consumers from marketplace confusion. The public interest is served by the avoidance of confusion about the source of goods or services in the marketplace. The Federal Court has articulated Canada’s position on how the public interest is protected by trade-marks. Though the Federal Court is addressing the tort of passing off in the quote below, the action under the statute is in the same context as it relates to the statutory regime and the protection of the public interest:

The protection of trade-marks as property is based in the common law action for passing off. Historically, the marketplace has been very concerned with guaranteeing consumers the quality of goods that they had come to rely upon in the course of trade. To further that guarantee, the common law developed the tort of passing off, which helped to assure that a person was representing his or her goods as being his or her own goods and not the goods of someone else. A necessary element of the tort of passing off was always an attempt to deceive. When this attempt to deceive caused confusion and damage, it was actionable. While the rationale for the tort was to protect the public, it was not the consumer who sued, but the owner of the trade-mark who brought the action, thereby protecting the public, as well as its own interest.69

The Trade-marks Office under the authority of the Registrar of Trade-marks adjudicates the grant of private rights to protect a mark or symbol that differentiates the owner’s wares from those of competitors and insures the public interest is satisfied as to source and quality of wares. In determining whether or not to register a mark, the Registrar examines the mark as per section 12 of the Act: the Registrar determines if the mark is primarily a name or surname of a person who died less than thirty years ago; if it is clearly descriptive or deceptively misdescriptive of character or quality of products or services; if it is the name in any language of the product or services; if it is confusing with a registered trade-mark; or if it is prohibited as a mark or is a geographical indication. With the exception of confusion, the criteria in section 12 are binary, requiring either a ‘yes’ or ‘no’ answer. However, in deciding whether the mark should be found to be confusing the Registrar will consider the criteria in section 6(5) of the Act which entails deliberation about:

(a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;
(b) the length of time the trade-marks or trade-names have been in use;
(c) the nature of the wares, services or business;
(d) the nature of the trade; and
(e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

The Registrar has the authority to use judicial discretion to weigh the criteria in s. 6(5) of the Act according to the circumstances.\(^70\)

The Registrar may refuse registration under section 37 if the formalities of the application process are not met, or if the trade-mark is not registrable as per section 12, or because the trade-mark is confusing. If a mark is confusing with another mark on the Register and the registered mark is not in use, the unused mark may be expunged through a challenge under section 45. Expungement would clear the Register of deadwood and open the possibility of a new registration. The examination process leads to registration of the mark unless the mark contravenes the enumerated prohibitions in section 12.

Registered trade-marks attract statutory rights. Trade-mark registration is a private, exclusive right that protects the owner of the mark from unfair competition or passing off (section 7(b)), unauthorized use of the mark, including infringement through use of an identical mark (section 19) or confusing mark (section 20) or depreciation of goodwill (section 22). Registration confers the benefits of national protection, presumptive validity of the mark, exclusive rights (section 19), statutory remedies (section 22), and public notice in the Canadian Trade-Marks Journal published by the Trade-marks Office.

Unregistered trade-marks are not as well protected but they do attract a common law right which can be asserted against competitors for passing off. Unregistered trade-marks have no formalities because the mark is never registered and there is no adjudication of the public interest. The cause of action initiated by the owner of the unregistered mark must establish the existence of goodwill or reputation attached to goods or services that are associated with a word, symbol or design; demonstrate a misrepresentation using a confusing mark or indicia that would confuse the public; and show damages that resulted from the misrepresentation of the source of the goods of the competitor as the same source as the owner of the trade-mark. In the unregistered environment the public interest is adjudicated by a judge. Only in the registered environment is there an adjudicator of the public interest at the registration stage. However, both registered and unregistered trade-marks have recourse to the courts for adjudication.

While registered trademarks attract additional benefits, registered and unregistered marks are on the same footing when priority of title is determined. The Supreme Court of Canada recently illustrated the adjudication of trade-mark rights in the registered and unregistered environments in *Masterpiece, Inc. v. Alavida Lifestyles, Inc.*\(^71\)

\(^70\) *Trade-Marks Act and Commentary* 10 (Roger T. Hughes ed., 2009).

\(^71\) 2011 SCC 27.
At the outset, it is important to recall the relationship between use and registration of a trade-mark. Registration itself does not confer priority of title to a trade-mark. At common law, it was use of a trade-mark that conferred the exclusive right to the trade-mark. While the Trade-marks Act provides additional rights to a registered trade-mark holder than were available at common law, registration is only available once the right to the trade-mark has been established by use. As explained by Ritchie C.J. in *Partlo v. Todd* (1888), 17 S.C.R. 196, at p. 200:

> It is not the registration that makes the party proprietor of a trade-mark; he must be proprietor before he can register.

That principle established under Canada’s early trade-mark legislation continues under the present Act. Rights arising from use have been incorporated into the Act by granting rights to the first user of a trade-mark in two ways. First, under s. 16, a party normally gains a priority right to register a trade-mark when it first uses that trade-mark. Second, a user is also able to oppose applications or apply to expunge registrations based on its earlier use of a confusing trade-mark. This explains why an unregistered trade-mark of Masterpiece Inc. can be the basis of a challenge to Alavida’s subsequently registered mark. Section 16(3) of the Act recognizes the right of a prior user against any application for registration based upon subsequent use. Section 17(1) preserves that right, subject to certain limitations that are of no relevance here, where the trade-mark has been registered.

It should also be explained why Alavida’s application for a proposed trade-mark on December 1, 2005, would preclude Masterpiece Inc.’s subsequent trade-mark applications based on actual use. As noted above, at common law, trade-mark protection only arose from actual use. However, under the current Trade-marks Act, the opportunity was created for an applicant to claim priority as of the date the applicant files for a proposed but yet unused trade-mark. Registration will, however, not occur unless the applicant subsequently provides a declaration demonstrating that the proposed trade-mark was actually used within the time specified in s. 40(2) of the Act.

In this case, Alavida did provide such a declaration, with the result that its priority claim as of December 1, 2005, the date it filed its registration application, precluded Masterpiece Inc. from obtaining registration of “Masterpiece Living”, the exact same trade-mark as Alavida, by a subsequent application based on use after December 1, 2005. Instead, it would have had to oppose Alavida’s application or would have to apply to expunge Alavida’s trade-mark registration on the grounds of likelihood of confusion between Alavida’s trade-mark and its trade-marks or trade-name that had been in use before December 1, 2005. Because Masterpiece Inc. did not oppose Alavida’s application, which was granted, the only remedy open to Masterpiece Inc. was to apply to have Alavida’s mark expunged. If successful, this remedy would allow Masterpiece Inc.’s application for registration of its own trade-marks to be considered on its merits by the Registrar of Trade-marks.72

Trade-marks are unique in the industrial property regime because the lack of formalities in the unregistered environment does not preclude the

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72 *Id.* ¶¶ 35-38.
protection of the law and the courts. In trademark litigation, private companies litigate against other private companies and it can be difficult to see how the public interest figures in such private matters.

Trade-marks are not limited by a specific term. Trade-mark protection expires through non-use of the mark as per section 45.3 of the Trade-marks Act or for failure to renew registration within a fifteen year period from the day of registration or the last renewal as per s. 46 of the Act.

B. The Public Interest in the Statutory Trade-Marks Scheme

The public interest in trade-marks differs from the public interest in the patent and copyright regimes. The public benefit of trade-marks lies in protecting consumers. The Supreme Court of Canada articulated the public interest in trade-marks in the *Mattel, Inc. v. 3894207 Canada, Inc.* decision:

"Trade-marks are something of an anomaly in intellectual property law. Unlike the patent owner or the copyright owner, the owner of a trade-mark is not required to provide the public with some novel benefit in exchange for the monopoly. . . . By contrast, a patentee must invent something new and useful. To obtain copyright, a person must add some expressive work to the human repertoire. In each case, the public through Parliament has decided it is worth encouraging such inventions and fostering new expression in exchange for a statutory monopoly (i.e. preventing anyone else from practising the invention or exploiting the copyrighted expression without permission). The trade-mark owner, by contrast, may simply have used a common name as its ‘mark’ to differentiate its wares from those of its competitors. Its claim to monopoly rests not on conferring a benefit on the public in the sense of patents or copyrights but on serving an important public interest in assuring consumers that they are buying from the source from whom they think they are buying and receiving the quality which they associate with that particular trade-mark. Trade-marks thus operate as a kind of shortcut to get consumers to where they want to go, and in that way perform a key function in a market economy. Trade-mark law rests on principles of fair dealing. It is sometimes said to hold the balance between free competition and fair competition.

Fairness, of course, requires consideration of the interest of the public and other merchants and the benefits of open competition as well as the interest of the trade-mark owner in protecting its investment in the mark. While trade-marks confer a different kind of public interest benefit, there is a quasi-judicial role established by the Trade-marks Act for the Registrar of Trade-marks."  

The Trade-marks Act establishes statutory protection for the owner of registered marks and protects the public from unfair competition. Parliament, representing the will of the electorate, has authorized the Registrar

73 [2006] 1 S.C.R. 772.
74 *Id.* at 788-89.
Who Safeguards the Public Interest?

of Trade-marks to be the gatekeeper for the public interest in the trade-marks regime. The Trade-marks Act sets out the statutory framework of the regime. Section 19 of the Act establishes that through registration the owner of a mark is granted statutory rights throughout Canada in respect of the wares or services. Section 30 of the Trade-marks Act sets out that the application for the trade-mark shall be filed with the Registrar of Trade-Marks. Section 40 of the Act established that when an application for a mark is allowed the Registrar shall register the trade-mark and issue a registration certificate.

Sections 62 and 63 of the Act authorize the administration of the statute through the establishment of the position of Registrar of Trade-marks:

62. This Act shall be administered by the Minister of Industry.
63. (1) There shall be a Registrar of Trademarks, appointed by the Governor in Council, to hold office during pleasure, who shall be paid such annual salary as the Governor in Council determines and shall be responsible to the Deputy Minister of Industry.75

The duties of the Registrar of Trade-marks spring from the statute. In the Trade-Marks Act the rights are expressed in the sections noted above and the duties of the Registrar of Trade-marks are similar to the duties of the Commissioner of Patents. The Canadian Intellectual Property Office (CIPO) confirms the similarity of statutory duties of the Commissioner of Patents and the Registrar of Trade-marks:

The Trade-marks Branch receives and examines all trade-mark applications. The Registrar of Trade-marks is responsible for determining whether or not to register such marks pursuant to the Trade-marks Act and Trade-marks Regulations. The Registrar of Trade-marks carries out these decision-making functions on an independent quasi-judicial basis, and these decisions are subject to appeal to the Federal Court.76

In addition, “The same person acts as Registrar of Trade-marks and Commissioner of Patents (and Chief Executive Officer, Canadian Intellectual Property Office).”77 The Registrar administers the Trade-marks Act and the Rules of Registration. All decisions of the Registrar may be appealed to the Federal Court. The Federal Court has exclusive jurisdiction for expungement or amendments to the Register as per section 57 of the Act.

Parliament represents the democratic public will of the people through legislation and provides for the public interest by avoidance of confusion in the marketplace. The Trade-marks Act is adjudicated by the Registrar and challenges to the decisions of the Registrar go before the courts. The courts interpret the statute with the intentions of Parliament

77 Id.
firmly in view. Unregistered marks go directly before the courts where the common law and public interest are adjudicated.

V. COPYRIGHT

Unlike patent or registered trademark protection in Canada, copyright arises upon the creation\(^\text{78}\) and fixation\(^\text{79}\) of a work or other subject matter.\(^\text{80}\) Section 3 of the Act sets out that copyright is the exclusive right to produce or reproduce a work or a substantial part of the work, to publish an unpublished work and the sole right:

\(\text{(a)}\) to produce, reproduce, perform or publish any translation of the work,
\(\text{(b)}\) in the case of a dramatic work, to convert it into a novel or other non-dramatic work,
\(\text{(c)}\) in the case of a novel or other non-dramatic work, or of an artistic work, to convert it into a dramatic work, by way of performance in public or otherwise,
\(\text{(d)}\) in the case of a literary, dramatic or musical work, to make any sound recording, cinematograph film or other contrivance by means of which the work may be mechanically reproduced or performed,
\(\text{(e)}\) in the case of any literary, dramatic, musical or artistic work, to reproduce, adapt and publicly present the work as a cinematographic work,
\(\text{(f)}\) in the case of any literary, dramatic, musical or artistic work, to communicate the work to the public by telecommunication,
\(\text{(g)}\) to present at a public exhibition, for a purpose other than sale or hire, an artistic work created after June 7, 1988, other than a map, chart or plan,
\(\text{(h)}\) in the case of a computer program that can be reproduced in the ordinary course of its use, other than by a reproduction during its execution in conjunction with a machine, device or computer, to rent out the computer program, and
\(\text{(i)}\) in the case of a musical work, to rent out a sound recording in which the work is embodied, and to authorize any such acts.

The term of copyright for works subsists for the life of the author plus fifty years.\(^\text{81}\) For other subject matter, a performer holds copyright in the performer’s performances,\(^\text{82}\) the maker of a sound recording holds copy-

\(^{80}\) There is copyright in performer’s performances, sound recordings and communication signals as per the Copyright Act, R.S.C. 1985, ch. C-42, §§ 15, 18, 21.
\(^{82}\) Id. § 15.
Who Safeguards the Public Interest?

right in the sound recording;\textsuperscript{83} and a broadcaster has a copyright in the signals that it broadcasts\textsuperscript{84} for a term of fifty years.

In the Copyright Act three types of rights are protected: economic rights,\textsuperscript{85} moral rights,\textsuperscript{86} and users’ rights.\textsuperscript{87} From the perspective of the economic rights holders, the Copyright Act creates exclusive rights to produce or reproduce a work or any substantial part of the work, to perform the work or any substantial part of the work in public, or if unpublished, to publish the work or any substantial part of the work.\textsuperscript{88} Copyright also includes the sole right to translate, convert a work to different forms, adapt as a cinematographic work, and communicate the work to the public by telecommunication.\textsuperscript{89} There are economic rights in the copyright of other subject matter: in performer’s performances, sound recordings and communication signals.\textsuperscript{90} Moral rights protect the integrity and associations with the work, and users’ rights\textsuperscript{91} permit specific otherwise unauthorized uses. All three types of rights create the balance in the Copyright Act, which Parliament has passed in the public interest.

The public policy objectives of the Copyright Act are articulated by the Supreme Court of Canada:

As mentioned, in \textit{Théberge, supra}, this Court stated that the purpose of copyright law was to balance the public interest in promoting the encouragement and dissemination of works of the arts and intellect and obtaining a just reward for the creator,\textsuperscript{92}

and:

The proper balance among these and other public policy objectives lies not only in recognizing the creator’s rights but in giving due weight to their limited nature. In crassly economic terms it would be as inefficient to overcompensate artists and authors for the right of reproduction as it would be self-defeating to undercompensate them. 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.

Excessive control by holders of copyrights and other forms of intellectual property may unduly limit the ability of the public domain to incorporate and embellish creative innovation in the long-term interests of

\textsuperscript{83} Id. \textsection 18.
\textsuperscript{84} Id. \textsection 21.
\textsuperscript{85} Id. \textsection 3.
\textsuperscript{86} Id. \textsection 14.1.
\textsuperscript{87} Id. \textsections 29, 30.
\textsuperscript{88} Id \textsection 3.
\textsuperscript{89} Id. \textsection 3(1).
\textsuperscript{90} Id. \textsections 15, 18, 21.
\textsuperscript{91} Id. \textsections 29, 30.
828 Journal, Copyright Society of the U.S.A.

society as a whole, or create practical obstacles to proper utilization. This
is reflected in the exceptions to copyright infringement enumerated in
ss. 29 to 32.2, which seek to protect the public domain in traditional ways
such as fair dealing for the purpose of criticism or review and to add new
protections to reflect new technology, such as limited computer program
reproduction and “ephemeral recordings” in connection with live
performances.

This case demonstrates the basic economic conflict between the
holder of the intellectual property in a work and the owner of the tangible
property that embodies the copyrighted expressions.93

The Supreme Court addressed moral rights in the Théberge case vis-à-
vis economic rights:

Moral rights, by contrast, descend from the civil law tradition. They
adopt a more elevated and less dollars and cents view of the relationship
between an artist and his or her work. They treat the artist’s œuvre as an
extension of his or her personality, possessing a dignity which is deserving
of protection. They focus on the artist’s right (which by s. 14.1(2) is not
assignable, though it may be waived) to protect throughout the duration
of the economic rights (even where these have been assigned elsewhere)
both the integrity of the work and his or her authorship of it (or anonymity,
as the author wishes).94

The Copyright Act protects the private interests of the creators and
copyright owners by the protection of the moral rights and the grant of
exclusive rights of production and reproduction (amongst others), respec-
tively. The three sets of rights in copyright must be balanced and main-
tained. The public interest is ensured in an important respect through
attention to the user rights which are granted through the exceptions and
limitations to the copyright owners’ exclusive rights. In copyright, excep-
tions include uses for research and private study and various uses by “li-
braries, archives, museums”95 and “educational institutions,” amongst
others.96

94 Id. at 15.
95 Section 2 of the Copyright Act defines “libraries, archives and museums” to
mean:
(a) an institution, whether or not incorporated, that is not established or
conducted for profit or that does not form a part of, or is not adminis-
tered or directly or indirectly controlled by, a body that is established or
conducted for profit, in which is held and maintained a collection of docu-
ments and other materials that is open to the public or to researchers, or
(b) any other non-profit institution prescribed by regulation.
Not all libraries, archives and museums benefit from the limitations and
exceptions as per the statutory definition.
96 Section 2 of the Copyright Act defines “educational institution” to mean:
(a) a non-profit institution licensed or recognized by or under an Act of
Parliament or the legislature of “a province to provide pre-school, ele-
mentary, secondary or post-secondary education,
Distinct from patents and from registered trade-marks, copyright protection is automatic if the conditions of the statute are met: no registration is necessary. Copyright is an unregistered environment and is without formalities. It is possible to formally register copyright in works\(^7\) but this process is voluntary and has no bearing on copyright protection.\(^8\) There is therefore no comparable, authorized administrator for the Copyright Act as exists under the Patent Act (the Commissioner of Patents) or the Trade-marks Act (the Registrar of Trade-marks). There is a Copyright Office created under section 46 of the Copyright Act but its role is not as robust as the corollary offices associated with the Commissioner of Patents or the Registrar of Trade-marks. The Copyright Office merely maintains the register of copyrights in an environment where registration is an option. Unlike under the patent regime where the formality of registration is required to attract legal protection of the patent, all copyrights, registered and unregistered, attract the full protection of the law.\(^9\)

The Registrar of Copyrights has no quasi-judicial administrative function and simply “receives and processes copyright applications and registers copyrights in accordance with the Copyright Act.”\(^10\) There is no decision-making role associated with the Office of the Registrar of Copyrights. Also distinct from patents and trade-marks, there is no examination or verification process as part of the registration of copyright.\(^11\) There are no formalities to adjudicate in the Copyright Act.

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\(^7\) Copyright Act, R.S.C. 1985, ch C-42, § 54.
\(^9\) In trade-marks there is legal protection without formalities for the tort of passing off at common law but it is not the same protection granted to registered marks through the formalities of the Trade-marks Act.
A. The Public Interest in the Statutory Copyright Scheme

While there is no decision-making or quasi-judicial Commissioner to balance the public interest in copyright, the Copyright Act does provide for an independent administrative tribunal with an entirely different role than is provided for under either the Patent Act or the Trade-marks Act. The Copyright Act establishes a quasi-judicial, decision-making body, the Copyright Board,102 but its role is as a regulatory body. Unlike the Patent Office or Trade-marks Office in their respective spheres of intellectual property, the Copyright Board is not encountered necessarily by all rights holders and not all copyright interests are ever considered.

The Copyright Board’s duties are to make decisions “respecting royalties103 or their related terms and conditions . . . .”104 The Board’s general powers include:

swearing and examination of witnesses, the production and inspection of documents, the enforcement of its decisions and other matters necessary or proper for the due exercise of its jurisdiction, all such powers, rights and privileges as are vested in a superior court of record.105

The Copyright Board defines its role as:

an economic regulatory body empowered to establish, either mandatorily or at the request of an interested party, the royalties to be paid for the use of copyrighted works, when the administration of such copyright is entrusted to a collective-administration society. The Board also has the right to supervise agreements between users and licensing bodies . . . .”106

The Copyright Board’s Annual Report 2009–2010 describes its responsibilities under the Act as follows:

- [to] certify tariffs for the public performance or the communication to the public by telecommunication of musical works and sound recordings [sections 67 to 69]107;
- [to] certify tariffs, at the option of a collective society referred to in section 70.1, for the doing of any protected act mentioned in sections 3, 15, 18 and 21 of the Act [sections 70.1 to 70.191];
- [to] set royalties payable by a user to a collective society, when there is disagreement on the royalties or on the related terms and conditions [sections 70.2 to 70.4];
- [to] certify tariffs for the retransmission of distant television and radio signals or the reproduction and public performance by educational institutions, of radio or television news or news commentary programs
and all other programs, for educational or training purposes [sections 71 to 76];

- [to] set levies for the private copying of recorded musical works [sections 79 to 88];
- [to] rule on applications for non-exclusive licences to use published works, fixed performances, published sound recordings and fixed communication signals, when the copyright owner cannot be located [section 77];
- [to] examine, at the request of the Commissioner of Competition appointed under the Competition Act, agreements made between a collective society and a user which have been filed with the Board, where the Commissioner considers that the agreement is contrary to the public interest [sections 70.5 and 70.6];
- [to] set compensation, under certain circumstances, for formerly unprotected acts in countries that later join the Berne Convention, the Universal Convention or the Agreement establishing the World Trade Organization [section 78].

The Board’s statutory duties are concerned exclusively with compensation: tariffs, levies and royalties. The Board will consider any objections, examine them, may take into account other factors it deems appropriate, and will certify the tariffs, having regard for any objections made regarding the proposed tariff. The Copyright Board has the power to make interim tariff decisions, amend earlier decisions, create its own regulations on procedures, and publish and distribute notices.

The Copyright Board must be chaired by “a judge, either sitting or retired, of a superior, county or district court” and but none of the other board members is required by statute to have legal training or judicial experience. There have been extended periods when the Board had no chairman or was chaired by a vice-chairman, a position that requires no legal or judicial training. It may be problematic for a quasi-judicial board, with “all such powers, rights and privileges as are vested in a superior court of record” to be led by a vice-chairman without the requisite knowledge and experience of the judicial system. The Supreme Court of Canada refers to this lack of a statutory requirement for Board members to have judicial knowledge in the Tariff 22 decision:

There is neither a preclusive clause nor a statutory right of appeal from decisions of the Copyright Board. While the Chair of the Board must be a current or retired judge, the Board may hold a hearing without

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108 ANNUAL REPORT, supra note 106, at 7.
109 Tariffs, levies and royalties are forms of payment for use of protected works.
110 Copyright Act, R.S.C. 1985, ch. C-42, § 68(1).
111 Id. § 66.
112 Id. § 66(3).
114 Copyright Act, R.S.C. 1985, ch. C-42, § 66.7(1).
any legally trained member present. The Copyright Act is an act of general application which usually is dealt with before courts rather than tribunals. The questions at issue in this appeal are legal questions. For example, the Board’s ruling that an infringement of copyright does not occur in Canada when the place of transmission from which the communication originates is outside Canada addresses a point of general legal significance far beyond the working out of the details of an appropriate royalty tariff, which lies within the core of the Board’s mandate.\footnote{115 Soc’y of Composers, Authors and Music Publishers of Canada v. Canadian Ass’n of Internet Providers, [2004] 2 S.C.R. 427, 452 (Tariff 22 case).}

Under section 28(j) of the Federal Courts Act,\footnote{116 Federal Courts Act, R.S.C. 1985, ch. F-7, § 28(j).} the Federal Court of Appeal has jurisdiction for judicial review of the Copyright Board but there is no comparable appeal process in the copyright scheme as exists in the patent and trade-marks scheme.

The Commissioner of Competition, whose authority is derived from the federal Competition Act,\footnote{117 Competition Act, R.S.C., 1985, ch. C-34.} has access, under the Copyright Act, to the tariff decisions and may request the examination of agreements if the Commissioner considers them to be contrary to the public interest.\footnote{118 Copyright Act, R.S.C. 1985, ch. C-42, § 70.5(5).} Section 70.5(5) pertaining to the role of the Commissioner of Competition, is the only instance where the phrase “the public interest” appears in Part VII of the Copyright Act. Section 70.5(5) has never been used.\footnote{119 DAVID VAVER, INTELLECTUAL PROPERTY LAW 262 (2d ed. 2011).} It certainly does not fully address the public interest broadly in copyright. There is no statutory reference in any role for the Copyright Board in relation to the public interest and this is confirmed in the Board’s 2009–2010 Annual Report.\footnote{120 ANNUAL REPORT, supra note 106, at 7.}

B. The Copyright Board’s Autonomy in Decisions

The Supreme Court of Canada makes it clear by its statement in Tariff 22 that “[t]he Copyright Act is an act of general application which usually is dealt with before courts rather than tribunals”\footnote{121 Tariff 22, [2004] 2 S.C.R. 427, 452.} and that questions of broad application of law will be adjudicated according to the standard of correctness which is beyond the purview of the Copyright Board. The Court is stating that the Copyright Board must follow the law as set out in the statute and be correct in legal decision-making. The Board cannot interpret the law, as that is beyond its purview. The Court affirms however, that setting out compensation rates for tariffs according to the standard of reasonableness is entirely within its jurisdiction:
This authority does not sufficiently support the applicants’ or the inter-
vener-1’s argument. First, the SOCAN was decided prior to Dunsmuir, which put a renewed emphasis on the importance of deference to admin-
istrative tribunals when they interpret their own statute. Second, the dis-
pute in the case at bar lacks wide ranging legal significance. The judicial
review turns on whether or not a specific type of copying, as revealed in
the volume study, qualifies as fair dealing. This is a largely factual inquiry
well within the competence of the Board. Accordingly, the appropriate
standard of review is reasonableness.122

The standard of review in factual matters is reasonableness. Factual find-
ings by the Board are accorded deference by the courts unless there are
obvious errors or the factual findings are based on a weighing of evidence
in which case the Board’s decisions would be reviewed by the courts.

Determining the boundaries of fair dealing is a matter of law but ap-
plying the tests enunciated by the Supreme Court for determining when a
dealing is fair in a particular case will be a question which involves fact. In
some cases such a determination may lie within the Board’s competence.
We saw the Copyright Board taking on this role by deciding that thirty-
second previews of a musical work would constitute a “research” use under fair dealing in the context of an audio preview of excerpts of musical
works.123 The Federal Court of Appeal in the Society of Composers,
Authors and Music Publishers of Canada v. Bell Canada124 decision, there-
fore supported the Board’s foray into that matter:

The legislator chose not to add restrictive qualifiers to the word “re-
search” in section 29. It could have specified that the research be “scien-
tific”, “economic”, “cultural”, etc. Instead it opted not to qualify it so that
the term could be applied to the context in which it was used, and to
maintain a proper balance between the rights of a copyright owner and
users’ interests.125

The court concluded:

I do not consider the contextual interpretation of the concept of research
in section 29 applied by the Board to be unreasonable or in error. This
brings me to the second step of the exception: is the dealing fair?126

122 Alberta (Educ.) v. Access Copyright, 2010 FCA 198, ¶ 32.
123 Soc’y of Composers, Authors & Music Publishers of Canada v. Bell Canada 18,
2010 FCA 123.
124 Id.
125 Id. ¶ 18.
126 Id. ¶ 23.
As the Supreme Court of Canada has granted leave to appeal the case,\(^{127}\) the matter of the thirty-second “research” preview as a fair dealing use is as yet undecided.\(^{128}\)

In July 2010, the Federal Court of Appeal, consistent with the Supreme Court in the 2004 Tariff 22 judgment, stated in its K-12 decision that the Copyright Board does not adjudicate on matters of legal significance but rather that it conducts factual inquiries concerning tariffs:

I see no reviewable error in the Board’s finding that the dealing with Category 4 copies was unfair under the Act and the CCH test. It is important to restate that the step 2 fairness inquiry is a factual one and therefore merits a high degree of deference. Furthermore, the six factors outlined by the Supreme Court do not comprise a checklist or necessary or sufficient conditions; they are a non-exhaustive guideline. Therefore, the reasonableness of the Board’s fairness Decision must be assessed based on the Board’s reasons as a whole. From this point of view, it is clear that the Board came to the conclusion that the applicants’ dealing was unfair as it did not properly qualify as “research and private study.” This is a legitimate conclusion that was open to the Board based on the evidence before it. The Board’s reasons are also comprehensible and transparent, and therefore reasonable.\(^{129}\)

In September 2010 the Federal Court of Appeal expanded its explanation of the role of the Board, distinguishing between the Board’s role in legally interpreting its own function (as the Supreme Court had recognized it could do, in the Tariff 22 decision quoted above) and in taking wider positions of law which will affect matters beyond its statutory mandate:

The Board is a specialist tribunal which deals extensively with copyright matters. The Copyright Act is its home statute. It is therefore entitled to deference with respect to its interpretation of that Act: see Dunsmuir v New Brunswick, 2008 SCC 9, [2008] 1 S.C.R. 190, at paragraph 54. The question in issue here is one of mixed fact and law. If the Board is entitled to deference on pure questions of law, and it is entitled to deference with respect to findings of fact, it must necessarily be entitled to deference on questions of mixed fact and law involving the application of its home statute to the facts of a case.\(^{130}\)

The role of the Copyright Board and the extent of its jurisdiction will likely continue to attract the attention of the courts as it has done both in SOCAN v. Bell (above, in the Federal Court of Appeal) and in the recent


\(^{128}\) The Supreme Court of Canada decision of July 12, 2012, Society of Composers, Authors and Music Publishers of Canada v. Bell Canada, 2012 SCC 36, ¶ 49, found no errors in the Copyright Board’s conclusions on matters of fact.


decision of the Supreme Court\footnote{2012 SCC 36.} and similarly, in the\textit{K-12} decision,\footnote{The majority in the Supreme Court of Canada decision of July 7, 2012 in\textit{Alberta (Education) v. Canadian Copyright Licensing Agency (Access Copyright)}, 2012 SCC 37, ¶ 37 found the Copyright Board misapplied the CCH fair dealing factors and the Board’s finding of unfairness did not meet the reasonableness standard.} and previously at the Supreme Court in cases such as\textit{Tariff 22}.

\section*{The Copyright Board’s Approach to the Public Interest}

The Copyright Board’s view of its role vis-à-vis the public interest is evidenced in its 2009–2010\textit{Annual Report}. The “public interest” appears three times in the document; twice in reference to section 70.5(5) of the Copyright Act in relation to the Commissioner of Competition and once in the Historical Overview section where it notes that in the 1931 Copyright Act the Minister had the authority to trigger an inquiry if a collective was thought to be acting against the public interest.\footnote{ANNUAL REPORT, supra note 106, at 8, 9, 36.} The documentation shows that the Copyright Board has no view of itself in that role.

Parties entitled to seek tariffs before the Copyright Board are, for the most part, private entities seeking a market price for uses of works in the collective’s repertoire. There is a statutory provision in section 70.2 of the Copyright Act where either party to an existing blanket license can apply to the Board to fix royalties if the parties are “unable to agree on the royalties to be paid.” However there has been a recent spate of tariff applications filed by a collective concerning public sector institutions, such as provincial and territorial governments, and post-secondary educational institutions, where no attempt to reach an agreement was made.\footnote{Paul Davidson,\textit{Opting Out: Why Some Universities are Opting Out of Access Copyright, Association of Universities and Colleges of Canada, Association of Universities and Colleges of Canada} (Oct. 17, 2011), http://www.aucc.ca/media-room/news-and-commentary/opting-out-why-some-universities-are-opting-out-of-access-copyright.} Public sector entities, universities, colleges and municipalities are non-commercial entities, with public interest roles and statutory mandates, and the collective is unilaterally moving these institutions away from a negotiated agreement into a quasi-judicial environment.\footnote{Margaret Ann Wilkinson,\textit{Copyright, Collectives and Contracts: New Math for Educational Institutions and Libraries, in From “Radical Extremism” to "Balanced Copyright": Canadian Copyright and the Digital Agenda} 503, 513 (Michael A. Geist & Abraham Drassinower eds., 2010). http://www.ncac.gov.cn/cms/html/309/3502/201203/740608.html}

Dealing with public sector institutions puts the tariff equations in an entirely different sphere for the Copyright Board and beyond a numbers game. Gervais observes that “there is a significant degree of public interest
in the tariff-setting process and outcomes and in the operation of the copyright system.”

Prior to the public sector tariff applications, the Copyright Board dealt almost exclusively with private entities. While there is a “public interest in a fair and well-functioning copyright system,” the tariffs applied to private entities such as commercial radio and television stations. Prior to the K-12 tariff process, the Board had little experience in factoring in the broader public policy considerations that would be required when considering tariffs for public sector schools, governments, and universities. As noted above, the Board has no authority to stray into matters of pure law but it has the power “to press questions from the standpoint of the public interest . . . [and] a moderately increased level of inquisitorial activity in the public interest would surely be welcomed by all concerned, particularly the public.”

As noted above the Board is entitled to “deference on questions of mixed fact and law involving the application of its home statute to the facts of a case.” The statute does not confer a broader policy role on the Board, but it has been posited that it should be provided with “the necessary leeway and discretion to ensure that all interests, including those of the public, (which are not formally represented at Board hearings) are adequately protected.”

The Copyright Board has the authority to consider evidence other than that which the parties provide. While the Board may have factored in the public interest in its Decision in the Educational Institutions 2005–2009 tariff through the fair dealing analysis, the Board did not take the opportunity to consider further evidence of the public interest in education even though the Board admitted in its introduction to the Decision that “this is the first time the Board has been requested to certify a tariff for these types of works” and by extension, with these types of institutions.

D. Representation of Public Interest Is Necessary and Largely Missing in Copyright Regime

The Copyright Board defines its role as:

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137 *Tariffs, Copyright Board of Canada*, http://www.cb-cda.gc.ca/tariffs-tarifs/index-e.html (providing a list of current and proposed tariffs).


139 *Id.* at 210.


142 Gervais, *supra* note 133, at 216.

143 Copyright Act, R.S.C. 1985, c. C-42, § 68.2(b).
“an economic regulatory body empowered to establish, either mandatorily or at the request of an interested party, the royalties to be paid for the use of copyrighted works, when the administration of such copyright is entrusted to a collective-administration society. The Board also has the right to supervise agreements between users and licensing bodies . . . .”

Its self-described role does not extend to general protection of the public interest in the copyright regime in Canada. The Copyright Board cannot take into account interests beyond those involved in tariff proceedings and therefore does not ensure the public interest is adequately protected under the Copyright Act.

The Copyright Board is a decision-making, quasi-judicial body established by the statute to set and monitor royalties involving copyright collectives for the use of works. Uses and users in the Copyright Board’s decisions refer to transactions and trans-actors, not to the beneficiaries associated with the public interest or users’ rights in the Copyright Act. The Copyright Board does not function as gatekeeper; rather it sets a fair price. The public interest in copyright has no gatekeeper. There is no Commissioner, Registrar, or Examiner. The public interest in copyright is not effectively managed; it is generally left unguarded at the initial gatekeeping stage, unlike patents and trademarks.

The Patent Act and the Trade-marks Act are similar in structure as each relates to its respective quasi-judicial decision-making administrative body. The provisions in the statutes empower the Commissioner of Patents and the Registrar of Trade-marks with the authority and responsibility to ensure the public interest is served. The structure and provisions in the two statutes safeguard the public interest. There is a right to appeal the decisions of the Commissioner of Patents (section 17 of Patent Act) and the Registrar of Trade-marks (section 55 of the Trade-marks Act) to the Federal Court, further ensuring that the public interest inherent in Canada’s intellectual property regimes is considered.

Neither the Patent Act nor the Trade-marks Act resembles the Copyright Act in these respects since in the Copyright Act there are no similar structural provisions ensuring the public interest is balanced as a matter of course by any administrative body. There is no universal authorized administrator to take the public interest into account for the Copyright Act. There is no right to appeal decisions of the Copyright Board; the only recourse is for judicial review of Board decisions through the Federal Court of Appeal. As mentioned above, the Patent Act and the Trade-marks Act each provide an appeal route from their respective administra-

144 ANNUAL REPORT, supra note 106, at 7.
145 Gervais, supra note 133, at 216.
146 Knopf, supra note 113, at 132.
tive body’s decisions, in comparison to the Copyright Act’s provision where there is only the possibility of judicial review of Copyright Board decisions. The lack of an appeal route reduces access to the courts for copyright matters. The public interest in copyright has no formally constituted arbiter and is without a safeguard comparable to those legislated in the other statutory areas of intellectual property law in Canada.

E. Are the Courts the Sole Arbiter of the Public Interest in Copyright?

The Courts have brought public interest balance to bear in the copyright regime. Case law from Canadian courts supports the doctrine of strict and liberal construction, which provides that “legislation that interferes with individual rights and freedoms is strictly interpreted, while legislation that confers benefits on subjects or advances social welfare is interpreted liberally so as to advance the benevolent purpose of the legislation.”\textsuperscript{147} In the copyright area Canadian courts are reflecting this general principle of strict and liberal construction. The Supreme Court’s decisions in \textit{Théberge} and \textit{CCH} provide evidence of this doctrine in play as it pertains to the public interest in copyright. In \textit{Théberge} Justice Binnie writes:

The proper balance among these and other public policy objectives lies not only in recognizing the creator’s rights but in giving due weight to their limited nature. In crassly economic terms it would be as inefficient to overcompensate artists and authors for the right of reproduction as it would be self-defeating to undercompensate them. 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.

Excessive control by holders of copyrights and other forms of intellectual property may unduly limit the ability of the public domain to incorporate and embellish creative innovation in the long-term interests of society as a whole, or create practical obstacles to proper utilization. This is reflected in the exceptions to copyright infringement enumerated in ss. 29 to 32.2, which seek to protect the public domain in traditional ways such as fair dealing for the purpose of criticism or review and to add new protections to reflect new technology, such as limited computer program reproduction and “ephemeral recordings” in connection with live performances.\textsuperscript{148}

In \textit{CCH}, Chief Justice McLachlin writes for a unanimous Court:

\textit{Moorhouse, supra}, is inconsistent with previous Canadian and British approaches to this issue. . . . In my view, the \textit{Moorhouse} approach to authorization shifts the balance in copyright too far in favour of the owner’s

\textsuperscript{147} Ruth Sullivan, \textit{Statutory Interpretation} 46 (2d ed. 2007).
rights and unnecessarily interferes with the proper use of copyrighted works for the good of society as a whole. . . .

The Chief Justice also stated:

[T]he fair dealing exception is perhaps more properly understood as an integral part of the Copyright Act than simply a defence. Any act falling within the fair dealing exception will not be an infringement of copyright. The fair dealing exception, like other exceptions in the Copyright Act, is a user’s right. In order to maintain the proper balance between the rights of a copyright owner and users’ interests, it must not be interpreted restrictively. As Professor Vaver, supra, has explained, at p. 171: “User rights are not just loopholes. Both owner rights and user rights should therefore be given the fair and balanced reading that befits remedial legislation . . . .”

He concluded that: “[T]he purpose of the fair dealing exception, which is to ensure that users are not unduly restricted in their ability to use and disseminate copyrighted works.

In CCH the Supreme Court’s “large and liberal interpretation” of the public interest in research “is to ensure that users’ rights are not unduly constrained”: For example, for the purpose of research or private study, it may be essential to copy an entire academic article or an entire judicial decision. However, if a work of literature is copied for the purpose of criticism, it will not likely be fair to include a full copy of the work in the critique.

The Court’s public policy approach, based on the doctrine of strict and liberal construction and reinforced by the Supreme Court in Théberge and CCH, is the necessary representation of the public interest, or balance, in copyright.

The courts are the sole arbiters of the public interest in copyright. There is no administrative mechanism or body authorized by the Copyright Act to mediate and balance the public interest with other interests.

F. The Special Contribution of Certain Institutions to the Public Interest

Public sector libraries, archives, museums and educational institutions that are defined and provided for in the Copyright Act require special consideration in the copyright regime because they are the nation’s repositories of the historical and scientific record, the preservers of its cul-

150 Id. at 363.
151 Id. at ¶ 63.
152 Id. at ¶ 56.
153 Sullivan, supra note 147, at 46.
155 Id. §§ 29.4, 30.1
tural history, and disseminators of knowledge. They are public institutions and are integral to operation of the public sphere and the public interest for the benefit of society at large and their “information and ideational goods are public goods.” Supreme Court Justice Abella (dissenting) gave voice to the public good aspect of the availability of content in *Robinson v. Thomson Corp.*:

The public interest is particularly significant in the context of archived newspapers. These materials are a primary resource for teachers, students, writers, reporters, and researchers. It is this interest that hangs in the balance between the competing rights of the two groups of creators in this case, the authors and the publishers. . . .

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

Without influential and substantive weight in representation “the gaping holes in electronic databases arising from the recognition of freelance journalists’ rights” will become commonplace and compromise the veracity and completeness of the historical record.

The ability of public sector libraries, archives, museums and educational institutions to fulfill their role in support of education, research, and activities of lifelong learning is dependent on a legal framework that formally represents their public interest function in the courts and in the new tariff environment in which the institutions now find themselves. Libraries, archives, museums and educational institutions promote the economic interests of authors as they provide a market for their works and purchase the works. These public institutions promote the public interest by providing access to and dissemination of the works through the services of the institutions, and they protect moral rights in works through regard for the integrity and association of the work with its author. The contribution of public sector libraries, archives, museums and educational institutions in promoting the interests of authors and the public requires special recognition in the copyright scheme.

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156 Gervais, *supra* note 133, at 216.
158 *Id.* at 388.
159 *Id.* at 390.
CONCLUSION

The encouragement and dissemination of works of the arts and intellect is central to the public interest in copyright just as the public interest is central to other intellectual property regimes such as patents and trademarks. We have documented that the primary purpose of copyright was to serve the public interest through the dissemination of information, by encouraging learning and the advancement of knowledge. Education, research, and access to information have long held special status in policy matters, and Canada’s intellectual property policies and judicial decisions are compatible with the public interest provisions in the Berne Convention.\footnote{Berne Convention art. 9.} Intellectual property regimes were originally conceived to confer private rights if they served the public interest.\footnote{PATTERSON & LINDBERG, supra note 21, at 70.} The public interest is an essential element of intellectual property regimes. In copyright, how is the public interest taken into consideration where there are no formalities? There is an administrative gap that leaves the non-commercial aspects of copyright law unaddressed and there is no appropriate forum in the copyright regime for that discussion and adjudication to take place. The public interest is disadvantaged in copyright.

While public sector and non-profit libraries, archives, museums and educational institutions have received special treatment in sections 29 to 32.2 of the Copyright Act and can therefore play a central role in promoting lifelong learning and the dissemination of works of art of the intellect, the legislative framework of copyright in Canada fails to provide a statutory safeguard for these institutions that contribute in a unique way to the public interest.

Public sector libraries, archives, museums and educational institutions collect, organize, store, preserve and provide access to the record of scholarship and culture and are therefore essentially involved in the activities and discussions on reprography that are taking place in educational institutions. A tariff for reprography necessarily involves a definition and a valuation of fair dealing as a public good. Its non-commercial value must be factored into the tariff equation. The public interest in copyright deserves the same kind of adjudication that is found in the patent and trademark regimes.

In this article we examined the provisions for safeguarding the public interest in three statutory intellectual property regimes, patents, trademarks and copyright. Based on our examination of the Offices and Officers of each regime, we can conclude that copyright alone among the three statutes operates without an appropriate quasi-judicial, decision-making body to safeguard the inherent balance in a statutory area of intel-
lectual property. There is no champion of balance, no defender or up-
holder of the public interest in copyright.

The Copyright Act does have one quasi-judicial body, the Copyright
Board, but it has no authority to adjudicate specifically in the public inter-
est. The Copyright Board is concerned with tariffs and economic transac-
tions. Its jurisdiction does not position it to act as guardian of the public
interest in copyright: the Copyright Board only sets a price and only deals
with entities that appear before the Board.

We have established that public sector libraries, archives, museums
and educational institutions have a role beyond the market system and
play a privileged role in advancing the public interest. Where do Canada’s
public institutions seek protection for the public interest?

Indeed, as has been documented, the role of the Copyright Board is
without the power and authority to represent the public interest. Where is
this responsibility vested? Without the statutory parallels with the Patent
Act and the Trade-marks Act, the public interest in copyright remains un-
represented, without its due consideration, and societal interests only
come to the fore when matters are forced to go before the Courts. The
public interest in copyright is a serious matter; “Canada’s Federal Court of
Appeal, and on occasion the Supreme Court of Canada, have played a
vital role in reviewing all of this activity and ensuring the public interest
inherent in copyright law is kept in mind.”163

Public sector institutions that play a privileged role in advancing the
public interest are currently before the Copyright Board in a discussion
that takes no account of their primary role in advancing the public inter-
est. There is a need for an authorized body to represent the public interest
and ensure its value is measured beyond simply economics. In the absence
of such a body, we must conclude that there is nothing in the legislation to
protect the public interest. Public institutions have no recourse except to
litigate through the courts to guarantee the public interest in copyright is
appropriately adjudicated.

163 Knopf, supra note 113, at 158.