

FISSURES IN THE FAÇADE OF FAIR-DEALING: USERS' RIGHTS IN WORKS PROTECTED BY COPYRIGHT

BURTON ONG*

A significant part of the copyright regime is premised on a delicate balance being struck between the rights of those who create works for commercial exploitation and the interests of the audience of “users” for whom those works were created to edify, engage and entertain. In view of the increasing pressures from copyright owners seeking to fortify the nature and scope of their exclusive rights, what role do the courts play in restoring balance to the copyright system through the way they interpret the statutory defences to copyright infringement? This article will evaluate a recent attempt by the Canadian Supreme Court to widen the scope of the “fair dealing for private study or research” defence, which has traditionally been applied restrictively, in a way which suggests that “users” of copyrighted works may have a stronger claim to make copies of these works than was previously thought.

I. INTRODUCTION

Reported cases from Canada have frequently left an indelible mark on the international intellectual property community. What would the debates surrounding the value of moral rights be without the ribboned geese from *Snow v. Eaton*?¹ More recently, the Canadian Supreme Court gave us the latest instalment on the *Harvard Oncomouse* saga,² creating a stir in the patent world by rejecting the patentability of higher life forms under the Canadian *Patents Act*.³ The Canadian Supreme Court has produced yet another noteworthy gem in *CCH Canadian Ltd. v. Law Society of Upper Canada*,⁴ a copyright case with interesting insights into the nature and scope of the “fair dealing for private study or research” defence to copyright infringement.

This article seeks to explore the inroads which have been made into the fair-dealing defences, which have traditionally been interpreted in a restrictive fashion, along with related copyright issues that are raised by this case. Close attention will be paid to the judicial philosophy underlying these legal developments, especially the willingness of the Canadian Supreme Court to recognise the notion of “users’ rights” as a relevant factor in determining the existence of liability for copyright infringement. This article will examine the ramifications of the approach taken by the Canadian Supreme Court on the scope of protection which copyright owners should receive, in light of current

* LL.M (Harvard), BCL (European & Comparative Law) (Oxford), LL.B (NUS); Assistant Professor, Faculty of Law, NUS. The author wishes to thank Professor George Wei for his encouragement and helpful comments, without which this note might not have materialised. All errors which remain are attributable to the author alone.

¹ *Snow v. Eaton Centre Ltd.* (1982) 70 C.P.R. (2d.) 105.

² *Commissioner of Patents v. President and Fellows of Harvard College* [2002] S.C.C. 76.

³ *Patents Act*, R.S.C. 1985, c. P-4.

⁴ *C.C.H. Canadian Ltd. v. Law Society of Upper Canada* [2004] S.C.C. 13.

global efforts to strengthen their exclusive rights, while evaluating the significance of these developments to the law of copyright in Singapore.

II. THE FACTS

The plaintiffs (and respondents) in the case, C.C.H. Canada Ltd., Thomson Canada Ltd. and Canada Law Book Inc., published law reports, legal treatises, and various other legal materials. In 1993, they commenced actions for copyright infringement against the Law Society of Upper Canada, seeking a declaration of subsistence and ownership of copyright in 11 specific works (including headnotes, case summaries, topical indexes and reported judicial decisions), as well as a declaration that their copyrights had been infringed through the activities of the Great Library at Osgoode Hall in Toronto, a reference and research library maintained and operated by the Law Society. The publishers also sought a permanent injunction prohibiting the Law Society from reproducing these eleven works as well as any other works published by them.

The defendant (and appellant) was the Law Society of Upper Canada, a statutory non-profit corporation that regulates the legal profession in Ontario. Since 1845, the Law Society has managed the Great Library and built up one of the largest collections of legal materials in Canada. The Great Library provides a request-based photocopy service (the “custom photocopy service”) for Law Society members, the judiciary and other authorised researchers.

Users of the custom photocopy service—which include lawyers, law students, and judges—put in requests for copies of extracts from legal materials which are then photocopied by the library staff and delivered to the requesters in person, by mail or by facsimile transmission. The service is provided on a not-for-profit basis and a small fee is chargeable to cover the costs of the Law Society. In 1996, the Law Society implemented an “Access to the Law Policy” (the “Access Policy”) to govern the Great Library’s custom photocopy service by setting limits on the types of requests that would be entertained. In essence, the access policy limited the availability of the service to specific categories of persons, with only single copies of extracts made for the purposes of research, review, private study and criticism, as well as use in judicial and government proceedings. Ordinarily, requests for a copy of a case, one article or one statutory reference would be satisfied as a matter of routine, whereas requests for “substantial copying” from secondary sources would be evaluated by the Reference Librarian on a case-by-case basis and could ultimately be refused.

The Law Society also maintained self-service photocopiers in the Great Library for use by library patrons. The use of these machines was not monitored directly but since the mid-1980s, a notice was posted by the Law Society above each machine warning users against copyright infringement, as well as disclaiming responsibility for infringing acts committed by users of these machines. No evidence was tendered by the plaintiff publishers to establish that the photocopiers were actually used in an infringing manner.

In pursuing their claims against the Law Society before the Federal Trial Court, and subsequently at the Federal Court of Appeal, the plaintiffs succeeded in establishing that their copyright had been infringed when the Great Library reproduced a copy of

each of their works. On appeal to the Supreme Court of Canada, the Law Society denied breaching the publishers' copyright and sought a declaration that it had not infringed copyright in those works when a single copy of a reported decision, case summary, statute, regulation or a limited selection of text from a treatise was made, for the purposes of research, (1) by staff members of the Great Library, or (2) by one of its patrons using one of the self-service photocopiers in the library.

The Supreme Court was thus tasked with addressing two key questions: whether the Law Society has committed copyright infringement by (1) providing the custom photocopy service in the Great Library where single copies of the publishers' works are reproduced and sent to patrons upon their request, or by (2) authorising acts of copyright infringement by maintaining self-service photocopiers in the Great Library for use by its patrons to make copies of the publishers' works. On these facts, the Court also had to consider the availability of the "fair dealing" defence to copyright infringement under the relevant copyright legislation,⁵ as well as to consider whether the maintenance of the self-service photocopiers in the Great Library amounted to copyright infringement by way of infringing authorisation.⁶

III. THE CANADIAN SUPREME COURT'S DECISION

The Law Society's appeal was allowed and it was held that the Great Library's custom photocopy service did not infringe the publisher's copyright in its various publications. In making single copies of the publisher's works for their patrons upon request, the Great Library's actions were held to be fair dealings for the purpose of research, thereby making the statutory defence⁷ under s. 29 of the Canadian *Copyright Act* available to the Law Society. Furthermore, the Supreme Court also concluded that the Law Society did not authorise copyright infringement by maintaining self-service photocopiers in the Great Library for use by its patrons.

Before we examine the Supreme Court's analysis of the relevant "fair dealing" defence, two other copyright issues addressed in the case are noteworthy and need to be dealt with briefly. The first deals with the qualifying criterion for copyright protection, that the work in question is "original", while the second is concerned with the concept of "infringing authorisation" and the circumstances in which a party is held liable for the actions of the actual copyist.

A. Originality

A preliminary issue which had to be resolved before the claim of copyright infringement could be pursued by the publishers was whether copyright subsisted in the works that were copied by the Great Library pursuant to its custom photocopy service. Under s. 5 of the Canadian *Copyright Act*, copyright subsists "in every *original*

⁵ See s. 29 *Copyright Act*, R.S.C. 1985, c. C-42, as amended: "Copyright in a work is not infringed by a fair dealing for the purpose of research or private study".

⁶ See s. 3 *Copyright Act*, R.S.C. 1985, c. C-42, as amended, where the author's exclusive rights over the use of the work are defined, including the right to authorize the commission of those acts which he has the sole right to do.

⁷ See s. 29 *Copyright Act*, R.S.C. 1985, c. C-42, as amended.

literary, dramatic, musical and artistic work”.⁸ Unsurprisingly, the concept of originality is not defined anywhere in the statute, even though the concept of originality is central to the very existence of copyright in a work.⁹

The federal trial and appellate courts had considered the issue of originality because of the nature of the works over which the publishers were asserting copyright: headnotes, case summaries, a topical index and reported judicial decisions. These were essentially derivative works, or works dependent upon underlying primary materials—written judgements—to generate the final output. The preliminary issue was thus whether these works were “original” for the purposes of copyright law, a necessary prerequisite to the subsistence of the exclusive rights provided for under the *Copyright Act*.

Anyone familiar with contemporary judicial and academic discourse in the realm of copyright law should be aware of the divergent attitudes taken towards the concept of originality, traditionally regarded as encompassing notions of skill, judgment or labour expended by an author. It has been the subject of considerable attention in several scholarly works,¹⁰ with the debate centring around the transatlantic judicial divide: the English courts take the view that “original” means that which originates from an author and is not copied from elsewhere,¹¹ whereas the American courts require some “modicum of creativity” (or “creative spark”) to be exhibited in the work before it can be considered an “original” work deserving of copyright.¹² The basic disagreement lies in whether the exertion of raw effort and labour would, on its own, be enough to make a work “original” for copyright to subsist.

As to whether copyright subsists in a compilation, the Canadian Court of Appeal has ruled in an earlier case that the expenditure of mere labour is not enough to justify the grant of copyright, and that it was “doubtful that *considerable labour* combined with a *negligible degree of skill and judgment* will be sufficient in most

⁸ Emphasis added. Section 5, *Copyright Act*, R.S.C. 1985, c. C-42, as amended.

⁹ The criterion of originality is similarly used in s. 27(1) of the Singapore *Copyright Act* (Cap. 63, 1999 Rev. Ed. Sing.), s. 1(1)(a) of the U.K. *Copyright, Designs and Patents Act 1988*, and §102(a) of the U.S. *Federal Copyright Act 1976* (Title 17 U.S.C.), as amended. In all these jurisdictions, there has been no attempt to legislate the meaning of “originality” which has ultimately been left to the courts to interpret and apply.

¹⁰ See, for example, Wei, *The Law of Copyright in Singapore* (Singapore: S.N.P., 2000) at para. 2.21 to 2.36; Cornish & Llewelyn, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (London: Sweet & Maxwell, 2003) at para. 10-04 to 10-10.

¹¹ See *University of London Press Ltd. v. University Tutorial Press Ltd.* [1916] 2 Ch. 601. An approach closely associated with the “sweat of the brow” or “industrious collection” standard of originality, which rewards an author with copyright on the basis of the effort he has expended in creating the work. This standard of originality rewards the author so long as the work is the fruit of his own labour and expense, while preventing others from free-riding on his expenditure of effort in producing the work. Using copyright law in this way to prevent a copyist from reaping what he has not sown is probably a response to the absence of an established law of unfair competition that deals with situations of misappropriation. But see Ng-Loy W. L., “Copyright Protection for Traditional Compilations of Facts and Computerised Databases—Is Sweat Copyrightable?” [1995] Sing. J.L.S. 96 at 118.

¹² See *Feist Publications Inc. v. Rural Telephone Service Co.* 499 U.S. 340 (1991) at 362-3. It may be helpful to view the copyright policy articulated by the U.S. Supreme Court in *Feist* as a judicial response to its Constitutional mandate “to promote the progress of science and the useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries”. See *U.S. Federal Constitution*, Art. I, Section 8, Clause 8.

situations to make a compilation of data original”.¹³ The position taken by the Court of Appeal in that case was that legislative amendments made by the Canadian Parliament introduced the concept of copyright protection for compilations pursuant to a provision in the North American Free Trade Agreement (NAFTA), and that it must have been the intention of the legislature to endorse the “creativity” school of cases exemplified by the American Supreme Court’s decision in *Feist*.¹⁴ Following this school of cases, the Court of Appeal took the view that one of the purposes of the copyright legislation was to reward the intellectual effort of the author, and that authorship entailed a “sense of creativity and ingenuity”, such that the amount of effort expended should not be a determinative source or originality. Applying this conception of originality, the compilation of data in that case—a Yellow Pages telephone directory—was found to be “obvious and commonplace as not to qualify for copyright protection”.¹⁵

What is noteworthy about the Canadian Supreme Court’s contribution to this debate is its reluctance¹⁶ to wholeheartedly endorse the American Supreme Court’s approach over the approach taken by the English courts, preferring to adopt a more conciliatory middle ground position instead. In the opinion of the Chief Justice, who delivered the judgement of the Court and which bears repetition *in extenso*:

... the correct position falls *between these extremes*. For a work to be ‘original’ within the meaning of the Copyright Act, it must be more than a mere copy of another work. At the same time, it need not be creative in the sense of being novel or unique. What is required to attract copyright protection in the expression of an idea is an exercise of *skill and judgement*. By skill, I mean the use of one’s knowledge, developed aptitude or practised ability in producing the work. By judgment, I mean the use of one’s capacity for discernment or ability to form an opinion or evaluation by comparing different possible options in producing the work. This exercise of skill and judgment will necessarily involve *intellectual effort*. The exercise of skill and judgment required to produce the work must not be so trivial that it could *not* be characterised as a *purely mechanical exercise* . . .¹⁷

¹³ Emphasis added. *Tele-Direct (Publications) Inc. v. American Business Information Inc.* [1998] 2 F.C. 22 (C.A.) at para. 29.

¹⁴ Care needs to be taken to avoid overstating the level of “creativity” which the U.S. Supreme Court has required the author to establish before it enjoys copyright protection. Justice O’Connor’s conclusions in the *Feist* decision seem to suggest that only a “*de minimis* quantum of creativity” is required: this “creativity” can be established from the selection, coordination and arrangement of the facts used to assemble a compilation. *Supra* note 12 at 363-4. If this “creativity” requirement can be satisfied by showing conscious authorial selection and arrangement of the facts which comprise the compilation, the gulf between the North American and the U.K. approaches to the question of originality may not be as wide as initial appearances suggest. The difference between the jurisdictions may simply lie in the degree of choice and judgement that has to be exercised in the creation of the work.

¹⁵ See *ibid.* at para. 32. For a contrary perspective in another case involving telephone directories, see the *Desktop Marketing Systems Pty. Ltd. v. Telstra Corporation Ltd.* [2002] F.C.A.F.C. 112, where the Full Court of the Federal Court of Australia adopted the “industrious collection” approach used by the English Courts to affirm that the various factual compilations involved were “original” for the purposes of copyright subsistence.

¹⁶ McLachlin C.J. was unwilling to “go so far as O’Connor J. (who delivered the U.S. Supreme Court’s decision in *Feist*: *supra* note 12) in requiring that the work possess a minimal degree of creativity to be considered original” (at para. 22 of the judgement).

¹⁷ *Supra* note 4 at para. 16.

This middle ground approach recoils from the position taken by the Court of Appeal somewhat, simultaneously recognising that the “sweat of the brow” approach to originality is too low a standard while the creativity standard of originality is too high.¹⁸ What the Supreme Court proposed instead was a double-barrelled test of originality, requiring the work to originate from an author in the sense that it is not copied from another work, *and* further evidence that the work is the product of an author’s skill and judgment. While creative works will necessarily qualify as “original” and be protected by copyright, creativity itself is not required to make a work “original”.¹⁹ In other words, when establishing the originality of a work, it was not sufficient to rely just on the fact that it was not copied; it also had to be shown that skill and judgment was involved in the production of the work and that this skill and judgment was not so trivial as to amount to a purely mechanical exercise. This approach to originality clearly rejects the argument that raw effort and labour from the author is not, on its own, sufficient, but still leaves open the question as to *how much* skill, judgement or intellectual effort would be enough to overcome the threshold of triviality that is necessary for a work to qualify as “original”.²⁰

Besides referring to prior domestic and foreign cases which dealt with the concept of originality in copyright law, the Canadian Supreme Court also considered the plain meaning of “original”, the history of copyright law, a purposive interpretation of the Canadian *Copyright Act* and, as a matter of policy, the need to formulate a “workable, yet fair standard” of originality. Ultimately, the Supreme Court affirmed the conclusion that there was sufficient skill and judgment exercised to render the publishers’ headnotes, case summaries, indexes and reported judicial decisions (viewed as compilations of a case summary, catchlines, case title, headnotes and judicial reasons) “original” works in which copyright could subsist.

The Canadian experience with the concept of “originality” should be instructive to the evolution of copyright law in Singapore. Like Canada, Singapore’s copyright laws were modelled closely after the English system for historical reasons and we have been strongly influenced by the approach taken by the English courts towards interpreting the statutory language employed in our own *Copyright Act*.²¹ Like Canada, our domestic intellectual property laws have been exposed to American copyright ideology through various international channels: Canada amended its *Copyright Act* in 1993 after entering into the NAFTA²², whereas Singapore amended its *Copyright Act* in 1999 in response to TRIPS.²³ The introduction of s. 7A(2) into

¹⁸ *Ibid.* at para. 24.

¹⁹ *Ibid.* at para. 25.

²⁰ While the Canadian Supreme Court has sought to *conceptually* distance itself from the U.S. position on “originality”, the formulation it has chosen may very well incline the Canadian position closer towards the *Feist* decision *in substance*. The degree of “skill and judgement” required by McLachlin C.J. does not appear to be all that different from that which would have satisfied O’Connor J. in *Feist*.

²¹ Cap. 63, 1999 Rev. Ed Sing.

²² *North American Free Trade Agreement (NAFTA) Implementation Act*, Art. 1705, S.C. 1993, c. 44, assented to on 23 June 1993.

²³ Article 10(2) of the TRIPS Agreement exhorts Member States to protect compilations which “by reason of the *selection or arrangement* of their contents constitute intellectual creations” [emphasis added]. The attention paid to this aspect of compilations is consistent with the approach taken in *Feist*, if the “creativity” criterion referred to by O’Connor J. in that case essentially means that some modicum of *intellectual effort or choice* must be exerted (over and above any *physical effort* or “sweat of the brow”) for there to be copyrightable subject matter. A similar provision on compilations can also be found in

the Singapore *Copyright Act*, which limits copyright in a compilation to the elements of “selection” and “arrangement” of its contents, is already indicative of a shift away from the English “sweat of the brow” approach that is embodied by the *University of London Press* case. Any further departure from the English²⁴ conception of “originality” could head down a path similar in direction to that which Canada has taken. Practically speaking, however, the impact of such a change to our understanding of what makes a work “original” will only be felt in cases along the margins: compilations of factual data, photographic reproductions of two-dimensional artistic works, and works produced by primarily mechanical or computer-generated processes.

B. *Infringing Authorisation*

Copyright infringement extends beyond the actual commission of those acts over which the author has the exclusive right to engage in. Copyright infringement can also include the “authorisation”²⁵ of other individuals who carry out those infringing acts. Enjoying the sole right to make reproductions of a work necessarily entails the sole right to authorise others to make reproductions of your work. But what exactly does “authorisation” mean for the purposes of defining the scope of the copyright owner’s exclusive rights? How does a non-owner of copyright “authorise” another person to engage in an infringing act? The question which the Canadian Supreme Court had to consider was whether the Law Society was liable for copyright infringement by way of infringing authorisation because it maintained self-service photocopiers in the Great Library for use by library patrons.

In determining the statutory meaning of “authorise”, the Court was faced with a choice which appellate courts from other jurisdictions, including Singapore, have encountered before.²⁶ A broader definition of “authorise”—to “sanction, approve

Article 5 of the WIPO Copyright Treaty 1996. These influences are evident in s. 7A(2) of Singapore’s *Copyright Act*, a provision that was introduced by the *Copyright (Amendment Act) 1999*, Act 38 of 1999. Section 7A(2) provides that copyright which subsists in a compilation is *limited* to the *selection* and *arrangement* of its contents.

²⁴ It should be noted that the English approach towards databases has evolved in response to European Council Directive No. 96/9/EC on the legal protection of databases. The U.K. *Copyright and Rights in Databases Regulations 1997* (S.I. 1997/3032) which came into force on 1 January 1998 create *sui generis* database rights which supplement the copyright enjoyed by the author of a compilation under the U.K. *Copyright, Designs and Patents Act* (CDPA) of 1988. Section 3A(2) of the U.K. CDPA also limits the originality of a database to the “selection and arrangement of the contents of the database”. These developments go some way towards bringing the English position on *databases* in line with the U.S. approach, though the more fundamental conceptual divergence over the meaning of the “originality” criterion remains in relation to “a table or compilation *other than a database*” [emphasis added], which are also protectable as literary works under s. 3(1)(a) of the U.K. CDPA 1988.

²⁵ Section 5, *Copyright Act*, R.S.C., 1985, c. C-42, as amended, defines the “copyright” of an author to include the sole right to “authorize” someone to engage in any of the acts (of publication, reproduction, translation *etc.*) enumerated in that section. See also s. 31(1) of the Singapore *Copyright Act* (Cap. 63, 1999 Rev. Ed. Sing.) and s. 16(2) U.K. *Copyright, Designs and Patents Act 1988*, c. 48.

²⁶ In deciding how widely or narrowly to interpret the concept of “infringing authorisation”, a court is essentially faced with the task of determining how wide a net of copyright liability it should cast beyond the copyst who commits the infringing act. The policy concerns which underpin this judicial exercise require the court to consider whether the defendant should bear some liability to the copyright owner because he should be held accountable in some way for contributing to the infringing act of another

and countenance”²⁷—was used by the High Court of Australia in *Moorhouse*²⁸ to establish a university’s liability when it operated photocopying machines in its library which were used by its students to make unauthorised copies of the plaintiff publisher’s copyrighted work. A narrower definition of “authorise”—to “grant or purport to grant the right”²⁹ (to copy)—was used by the House of Lords in *C.B.S. v. Amstrad*³⁰ to exonerate the manufacturer of high-quality home recording machines, advertised as having high-speed recording functions, which were used by consumers to make copies of the plaintiff’s musical and literary works and sound recordings. The facts of both *Moorhouse* and *Amstrad* bear some resemblance to the Law Society’s situation in that they involved defendants who have some connection with the copying equipment utilised by others, either as owner and operator or manufacturer of the machine used to commit the acts of copyright infringement. While these cases can be distinguished in terms of the degree of control possessed by the defendant over the actions of the actual users of the copying equipment, a more fundamental distinction lies in their divergent interpretations of what it means to “authorise” an infringing act.

Both the broader and narrower approaches to the concept of “authorisation” would require the defendant to have more than just mere knowledge of the infringing acts committed by another, or the likelihood of such acts being committed, before liability for “authorising” copyright infringement is imposed. The broader approach would be satisfied if, in addition to his actual or constructive knowledge of the activities of the people engaged in the infringing acts, the defendant has *made available* the *means* by which the infringing acts are carried out, has *control* over those *means*, and *omits* to take *reasonable steps* to limit the use of those means to legitimate purposes.³¹ Under this view, authorisation need not be an express action taken by the defendant but may be inferred from sufficient evidence of inactivity or indifference. To “authorise” an infringement, according to this view, essentially means to *permit* the infringing activity to take place.³²

In contrast, the narrower view of “authorisation” would require the defendant to go beyond just enabling, assisting, facilitating or encouraging the commission of the infringing act. To attract liability, the defendant must “authorise” the copyist to commit the infringing act, and not just “authorise” the use of the equipment to commit the infringing act. Under this view, to “authorise” requires the defendant to have, or purport to have, the power (or “authority”) to grant the right to copy to the persons who actually carry out the infringing act.

person, or whether the defendant has been pursued by the copyright owner simply because he has deep pockets.

²⁷ A definition taken from the Oxford English Dictionary and used by Bankes L.J. in *Falcon v. Famous Players Film Co.* [1926] 2 K.B. 474 at 491.

²⁸ *Moorhouse and Angus & Robertson (Publishers) Ltd. v. University of New South Wales* [1976] R.P.C. 151.

²⁹ A narrower formulation used by Atkins L.J. in *Falcon v. Famous Players Film Co.* [1926] 2 K.B. 474 at 499.

³⁰ *C.B.S. Songs Ltd. & Ors. v. Amstrad Consumer Electronic plc.* [1988] A.C. 1013. Similar observations were made by Whitford J. in *C.B.S. Inc. & Anor. v. Ames Records and Tapes Ltd.* [1982] Ch. 91 at 106. The Canadian Supreme Court considered only *C.B.S. Inc. v. Ames* as well as several Canadian judicial decisions which followed the same position.

³¹ On the facts in *Moorhouse*, it was found that the use of the photocopiers in the University’s library were not properly supervised, and that the library guide for users and the notices placed on each machine did not adequately explain the nature and amount of copying that was permissible under the law.

³² *Supra* note 28 at 165 *per* Jacob J.

Merely having control over the devices or equipment (the means) used to commit the infringing acts is not enough; there must be some form of *control* exercised by the defendant on the *persons* engaged in the infringing act. Giving the actual copyist the means to copy is not the same as giving him, or purporting to give him, the right to copy.³³ Indifference and inactivity on the defendant's part is unlikely to amount to "authorisation" following this approach. The distinction between the broader and narrower approaches to infringing authorisation thus lies in the nature and degree of control exercised by the defendant over those who have engaged in the infringing acts, as well as the means employed to commit those acts.

In what circumstances can a defendant be liable for infringing authorisation on the basis that he has purported to grant the right to copy to the actual copyist?³⁴ The Singapore Court of Appeal had to address this question in *Ong Seow Pheng*,³⁵ a case involving a defendant who had sold one pirated copy of a software program together with many pirated copies of the manual for that program to a retailing party downstream, who would then make further infringing copies of the software program to sell to customers together with the pirated manuals. The allegation of infringing authorisation made against the defendant was dismissed by the Court of Appeal which appeared to favour the narrower approach described above. The Court took the view that the retailer pirate did not make copies of the software program because they were "authorised" to do so—the copies were made of their own accord and for their own commercial gain.³⁶ The defendant had no real control over what the retailer pirate did with the single copy of the software program which the defendant had supplied him. Since the choice to make the infringing copies lay with, and was exercised by, the retailer pirate, the defendant could not have properly been described as in a position to purportedly grant the right to make infringing copies. Facilitating, or even inciting, the infringing act is not the same as "authorising it".³⁷ This interpretation of "authorisation" suggests that the defendant must be in a position of control, or authority, over the actual copyist, or in some other relationship with him which enables the defendant to direct the commission of the specific infringing acts.³⁸

³³ *Supra* note 30, *Amstrad* at 1055 *per* Lord Templeman.

³⁴ The defendant, who does not own the copyright which has been infringed, will necessarily lack any real power to grant the right to copy to someone else, and will thus only be liable for infringing authorisation if he *purports* to grant the right to copy to the copyist. It is not clear whether, under this narrower view of "authorization", the actual copyist is deceived or misled into believing that the defendant has the authority to grant him the right to make copies of a work, or whether the copyist must be under the impression that his actions are justified because of the defendant's actions. This would be a highly restrictive reading of the concept of authorization and would limit its reach to a very narrow set of circumstances.

³⁵ *Ong Seow Pheng v. Lotus Development Corp.* [1997] 3 S.L.R. 137.

³⁶ "Lur was a software pirate himself . . . and he hardly needed the appellants or anyone else to tell him to make any infringing copies for sale to his customers or otherwise." *Supra* note 35 at para. 33.

³⁷ *Supra* note 35 at para. 34.

³⁸ As a practical matter, this also means that the owner, operator or manufacturer of any device or equipment that can be used to commit an infringing act, as in the case of the defendants in *Moorhouse* and *Amstrad*, are unlikely ever to be liable for infringing authorization where there is no prior relationship between them and the actual copyists. In fact, insofar as this narrower approach to infringing authorization is premised on the defendant purporting to grant the actual copyist the right to make the infringing copies, it will be almost impossible to succeed against these equipment makers or owners because they are never in the position to grant such a right. In what circumstances would the library patron using a self-service photocopier actually believe that the library which owns the machine had granted them the right to make

The Canadian Supreme Court has taken a similar position on the issue of infringing authorisation in emphasising the importance of the defendant's *control* over those individuals who actually carry out the infringing acts.³⁹ In allowing the Law Society's appeal, the Court concluded that the Law Society had not authorised copyright infringement by providing self-service photocopiers, as well as copies of the plaintiff publishers' works, for use by its patrons in the Great Library. The Court gave the examples of "master-servant" or "employer-employee" relationships as scenarios where infringing authorisation may be established because of the element of control present "such that the Law Society can be said to exercise control over the patrons who might commit infringement".⁴⁰ In the absence of any control over which publications the library patron chooses to copy, their purposes for copying, or the photocopiers themselves, infringing authorisation could not be made out.

In fact, the Canadian position also takes this narrower approach to infringing authorisation one step further by introducing a presumption in favour of the authorising defendant:

Courts should *presume* that a person who authorizes an activity does so only so far as it is in accordance with the law . . . This *presumption* may be *rebutted* if it is shown that a certain *relationship* or degree of *control* existed between the alleged authorizer and the persons who committed the copyright infringement.⁴¹

A judicially recognised presumption of this sort limits the copyright owner's ability to establish infringing authorisation even more than the already narrow approach adopted by the English and Singapore courts. The amount of emphasis placed on the degree of control over the acts of the copyist suggests that a case for infringing authorisation can only be made out in situations where the infringing acts were carried out at the defendant's behest or, at the very least, direction.

This restrictive reading of the concept of "authorisation" can probably be explained by a judicial reluctance to further strengthen the copyright owner's already formidable quiver of rights. The copyright owner's arsenal against the infringing copyist has been progressively fortified by a number of recent or impending legislative enhancements: longer terms of copyright protection,⁴² the breadth of subject matter in which copyright subsists,⁴³ the growing bundle of exclusive rights given to the copyright owner,⁴⁴ and the additional legislative measures taken in response to modern copying

an infringing copy of a work? Which machine owner could ever purport to grant users such a right in respect of works which it clearly has no copyright over?

³⁹ *Supra* note 4 at para. 45. "... the Law Society lacks sufficient control over the Great Library's patrons to permit the conclusion that it sanctioned, approved or countenanced the infringement . . .".

⁴⁰ *Ibid.*

⁴¹ Emphasis added. *Ibid.* para. 38.

⁴² Many jurisdictions are moving from a "life plus fifty" to a "life plus seventy" term of protection. Singapore's *Copyright Act* (Cap. 63, 1999 Rev. Ed. Sing.) is to be amended later in 2004 to lengthen the duration of copyright pursuant to Article 16.4.4 of the U.S.-Singapore Free Trade Agreement.

⁴³ Copyright traditionally subsisted in literary, dramatic, musical and artistic works. Under the Singapore *Copyright Act*, legislative changes (Act 38 of 1999) have been introduced to expand the definition of the "literary work" to include compilations (of facts, other works, and other materials) and computer programs. The scope of copyright law has also been expanded to include sound recordings (Act 6 of 1998), cinematograph films, television broadcasts, sound broadcasts, cable programmes, and published editions of works.

⁴⁴ In addition to the copyright owner's exclusive rights of reproduction, publication, performance, broadcast, adaptation, inclusion in a cable programme or television broadcast (see s. 26(1) *Copyright Act*

and anti-circumvention technologies.⁴⁵ Judicial circumspection is justifiable when determining whether liability for infringement action should be extended to someone other than the actual copyist—the equipment manufacturer or an institution which maintains self-service photocopiers, for example—because it introduces a fresh set of targets (with deeper pockets than the individual infringing copyist) for the copyright owner to pursue. By limiting the copyright owner’s action for infringing authorisation to situations where the defendant has effective control over the actions of the copyist, the courts are essentially seeking to confine liability to those situations where the defendant ought to be held accountable for the actions of the actual copyist. A narrow interpretation of the concept of “authorisation” will have the desired effect of shortening the range of a copyright owner’s slings and arrows.

IV. THE “FAIR DEALING” DEFENCES TO COPYRIGHT INFRINGEMENT

Quite apart from the limitations built into the scope of the copyright owner’s exclusive rights,⁴⁶ there are also statutorily created defences to copyright infringement which seek to qualify the scope of the rights granted under the copyright system. In particular, the “fair dealing” defences play a crucial role in setting limits to the copyright owner’s quasi-monopoly rights by articulating basic values and underlying objectives which the law seeks to advance. Instead of a single overarching defence of “fair dealing”,⁴⁷ discrete categories of “fair dealing” are carved out by statutory provisions in the copyright legislation which correspond to three areas of activity which relate to broader societal interests: carrying out research or private study⁴⁸ of copyrightable works, engaging in criticism or review⁴⁹ of copyrightable works, and reporting news and current events.⁵⁰ These are intrinsically valuable activities which copyright law permits to take precedence over the property rights of the copyright owners. The user who makes unauthorised copies of works, or infringes any of the copyright owner’s statutorily designated exclusive rights, will be exonerated by the operation of these defences if he is able to show that he was using the copyrighted

(Cap. 63, 1999 Rev. Ed. Sing.), legislative amendments have also been made to introduce rental rights in the case of computer programs and sound recordings (Act 6 of 1998).

⁴⁵ See Articles 11 and 12 of the WIPO Copyright Treaty 1996. Singapore has committed itself to ratifying and implementing this Treaty under Article 16.1(iii) of the U.S.-Singapore Free Trade Agreement. An example of anti-circumvention legislation can be found in s. 296 of the U.K. *Copyright, Designs and Patents Act 1988*.

⁴⁶ With copyright protecting only authorial expression and not ideas, and only against acts of copying and not independent creation, the subject matter of copyright protection (the authorial expression which gives rise to the “work”) is kept distinct from its contents (facts and ideas) which can be freely used by anyone else.

⁴⁷ Such as the “Fair Use” defence found in the U.S. Copyright System. See §107 of Title 17 U.S.C. (1976), as amended, which is not confined to any particular category of uses.

⁴⁸ See s. 35 of the Singapore *Copyright Act* (Cap. 63, 1999 Rev. Ed. Sing.); s. 29 U.K. CDPA 1988 (as amended); s. 29 Canadian *Copyright Act*, R.S.C. 1985, c. C-42, as amended.

⁴⁹ See s. 36 of the Singapore *Copyright Act* (Cap. 63, 1999 Rev. Ed. Sing.); s. 30(1) U.K. CDPA 1988 (as amended); s. 29.1 Canadian *Copyright Act*, R.S.C. 1985, c. C-42, as amended.

⁵⁰ See s. 37 of the Singapore *Copyright Act* (Cap. 63, 1999 Rev. Ed. Sing.); s. 30(2) U.K. CDPA 1988 (as amended); s. 29.2 Canadian *Copyright Act*, R.S.C. 1985, c. C-42, as amended.

work for one of these permitted purposes. In addition, the user will have to go on to show that the character of his use also qualifies as a “fair” dealing.⁵¹

In the case before the Canadian Supreme Court, the Law Society escaped liability for copyright infringement because it managed to successfully argue that the actions of the librarians in the Great Library, in making single copies of copyrighted works at the request of library patrons in accordance with the library’s “Access to the Law Policy”, were protected by the “Fair dealing for research or private study” defence found in s. 29 of the Canadian *Copyright Act*.⁵² In successfully invoking this defence, the Law Society was able to prove that (1) the dealing was for the purpose of either research or private study and (2) that it was fair.⁵³

A. “Research”: The Purpose of the Dealing

The works reproduced by the librarians in the Great Library were made at the request of lawyers and other members of the legal community in accordance with an access policy which stated that copies would be made “for the purposes of research, review, private study and criticism”.⁵⁴ The Supreme Court of Canada took the view that “research” should be given a large and liberal interpretation which spanned both non-commercial and commercial contexts. In this case, the research that was carried out by the library patrons was “for the purpose of advising clients, giving opinions, arguing cases, preparing briefs and factums” and, in agreeing with the position taken by the Court of Appeal, the Supreme Court held that “lawyers carrying on the business of law for profit are conducting research within the meaning of s. 29 of the *Copyright Act*”.⁵⁵

This interpretation of the scope of the “fair dealing for private study and research” defence to include commercially-motivated research activities is not unusual in light of the underlying policy imperatives that justify the defence.⁵⁶ research is the cornerstone of discovery and the development of new ideas which, necessarily, requires the researcher to have access to pre-existing knowledge embodied in copyrighted works. Activity of this nature leads to the generation of further works and potentially useful

⁵¹ See s. 35(2) of the Singapore *Copyright Act* (Cap. 63, 1999 Rev. Ed. Sing.), which gives a non-exhaustive list of factors which the courts have to take into account when evaluating the fairness of the dealing for private study and research. These include the purpose and character (whether for commercial or non-commercial purposes), the nature of the protected work, the amount or substantiality of the part copied, and the effect of the dealing on the potential market or value of the protected work. These factors are drawn from the “Fair Use” statutory provisions in the U.S. *Copyright Act* (17 U.S.C. 107) and have also been judicially endorsed in the U.K. See *Hubbard v. Vosper* [1972] 2 Q.B. 84 and *Beloff v. Pressdram* [1973] R.P.C. 765 (cases decided under the “Fair Dealing for Criticism or Review” defence).

⁵² *Supra* note 4 at para. 73.

⁵³ *Ibid.* at para. 50.

⁵⁴ *Ibid.* at para. 64.

⁵⁵ *Ibid.* at para. 51.

⁵⁶ The current position in Singapore is the same in that commercial research may qualify for this defence: the deletion of s. 35(5) as a result of the 1998 amendments to the *Copyright Act* removed a provision which had specifically excluded commercial research from the scope of the defence. This existence of this provision before the amendments played a significant part in the Court of Appeal’s decision in *Aztech Systems Pte. Ltd. v. Creative Technology Ltd.* [1997] 1 S.L.R. 621 where the defence was held to be unavailable to the defendant who copied the plaintiff’s computer programme as part of a process of developing a compatible commercial product.

output which may benefit society as a whole. However, while the commercial nature of the research does not prevent such activity from qualifying as one of the allowable purposes under this defence, it may still be relevant in determining whether the dealing is fair.⁵⁷ The Court of Appeal in Singapore, for example, has held that the commercial nature of the dealing is a factor, to be considered in light of many other factors, that tends to militate against a finding of a “fair dealing”.⁵⁸

B. *Research and Private Study Carried Out By Third Party*

A more interesting question that is raised in the application of this defence is this: to what extent is the defence open to a copyist who is not engaged in research or private study himself, but is copying the protected work to facilitate the research activity of other persons? On the facts before the Supreme Court of Canada, the librarians who made the unauthorised copies were facilitating the research activities of third parties—lawyers and members of the legal community—who had requested for those copies to be made. Must the copyist be the one who uses the work for the allowable purposes set out in the three “fair dealing” defences?

The English and Commonwealth have traditionally taken a fairly conservative approach to this issue. The position in Singapore is laid out in *Aztech v. Creative Technology*,⁵⁹ where the Court of Appeal held that, to come within the exception, the dealing in question must be undertaken by the student himself.⁶⁰ In other words, the copyist must be the one engaged in private study or research if he makes an unauthorised copy of a work which enjoys copyright protection and seeks to invoke the “fair dealing for private study or research” defence. A school or other educational institution that wishes to make copies of a work to facilitate study activities carried out by its students will thus not be able to rely on the “fair dealing” defence, but will have to rely on a special statutory licensing scheme available to education institutions instead.⁶¹

The Canadian Supreme Court chose to take a different path. While recognising that the activities of the librarians in the Great Library—the retrieval and photocopying of legal works—did not qualify as “research” in and of itself, their actions nevertheless attracted the operation of this “fair dealing” defence because “they are *necessary conditions of research* and thus *part of the research process*” and that the “reproduction of legal works is for the purpose of research in that it is an essential

⁵⁷ *Supra* note 4 at para. 54, where the Court observed that “some dealings, even if for an allowable purpose, may be more or less fair than others; research done for commercial purposes may not be as fair as research for charitable purposes”.

⁵⁸ *Aztech Systems v. Creative Technology*, *supra* note 56 at 637. See also *Robert John Powers School Inc. v. Tessensohn* [1993] 3 S.L.R. 724 at 730. For a more comprehensive discussion of the policy considerations surrounding the deletion of s. 35(5) of the Singapore *Copyright Act*, following the *Aztech Systems v. Creative Technology* decision, see D. Seng, “Reviewing the Defence of Fair Dealing for Research or Private Study” [1996] Sing. J.L.S. 136.

⁵⁹ *Supra* at note 56.

⁶⁰ Following the approach adopted by the U.K. courts in *University of London Press v. University Tutorial Press* [1916] 2 Ch. 601 at 603, and *Sillitoe v. McGraw-Hill Book Co.* [1983] F.S.R. 545 at 558. A similar approach was taken by the Federal Court of Australia in *De Garis v. Neville Jeffress Pidler Pty. Ltd.* (1990) 18 I.P.R. 292.

⁶¹ See s. 52 of the Singapore *Copyright Act* (Cap. 63, 1999 Rev. Ed. Sing.).

element of the *legal research process*”.⁶² With this line of reasoning, the Supreme Court concluded that the custom photocopying service was *provided for the purpose* of research, review and private study. The “fair dealing” defence is available to the copyist even if he is not the party directly engaged in the actual use of the copied work for the statutorily sanctioned purposes.⁶³

C. The Copyist’s Burden of Proof

Making the “fair dealing for private study or research” defence available to intermediaries not directly using the copied works for the allowable purposes is a bold step to take,⁶⁴ but this is counterbalanced to a significant extent by the other requirement—that the dealing is one which is fair⁶⁵—which needs to be established. But the Supreme Court has taken its approach one step further: the copyist who raises this defence does not even have to adduce evidence that the *actual* user of the copied works uses the material in a fair dealing manner.⁶⁶ The Law Society did not have to establish that the library *patrons* who made use of the Great Library’s custom photocopy service actually made use of the unauthorised reproductions for the allowable purposes of private study and research and that their dealings were fair; instead, it was sufficient if it was shown that the Library’s *own* dealings were for these permissible purposes and were fair.⁶⁷ The Court took the view that the “dealing” referred to in s. 29 of the *Copyright Act* was not confined to individual acts, but also included a general practice or system such as the custom photocopy service operated by the Great Library that was governed by the Access Policy which imposed limits on the

⁶² Emphasis added. *Supra* note 4 at paragraph 64.

⁶³ Note s. 30.2(1) of Canadian *Copyright Act* (R.S.C., 1985, c. C-42, as amended) which permits a library, archive, museum or authorized person to take the benefit of the s. 29 fair dealing defence (private study or research) where it acts on behalf of someone who could have personally engaged in the activities protected by s. 29. This was referred to as the “library exception” which was briefly discussed by the Supreme Court in paras. 83 to 84 of its judgement. The Law Society did not have to rely on the library exception, though it was entitled to do so, because their dealings with the publishers’ works fell within the general “fair dealing for private study or research” exception.

⁶⁴ Apart from libraries, it would appear that educational institutions (both public and private) and photocopy shops patronised by students or researchers may potentially be able to avail themselves of the “fair dealing for private study or research” defence to copyright infringement. The availability of this defence to these parties will depend heavily on whether the Singapore courts choose to follow the expansive approach taken by the Canadian Supreme Court, and will always be subject to these parties being able to show that their dealings are “fair”.

⁶⁵ See discussion below at text accompanying footnote 70.

⁶⁶ The trial judge had held that the fair dealing exception should be strictly construed and that the copying for the custom photocopy service was not for the purpose of either research or private study. The Court of Appeal rejected this argument and held that the Law Society could rely on the purposes of its patrons to prove that its dealings were fair, but it concluded that there was not sufficient evidence to determine whether or not the dealings of those patrons were fair or not. *Supra* note 4 at para. 62. The Supreme Court agreed that the purpose and character of the Law Society’s dealing with the copyrighted works was connected with the dealings of its patrons, but it had to consider whether it was necessary for Law Society to prove the fairness of these individual dealings before it could avail itself of the defence.

⁶⁷ *Supra* note 4 at para. 63 where the Court held that “[p]ersons or institutions relying on the s. 29 fair dealing exception *need only prove* that their *own* dealings with the copyrighted works were for the purpose of research or private study and were fair. They may do this either by showing that their *own* practices and policies were research-based and fair, or by showing that all individual dealings with the materials were in fact research-based and fair.” [Emphasis added.]

types of patron requests which would be honoured. As long as the actual copying was part of a course of dealing in which the work was ultimately used for research or private study, there was a “dealing” within the scope of the defence. The Law Society was thus able to rely on the general practices which governed the Great Library’s photocopying activities to establish a “fair” dealing on its part. The Supreme Court held that it was enough that these general practices and policies were “research-based and fair”.

D. Assessing the “Fairness” of the Dealing

The imprecision inherent in the concept of a “fair dealing” was readily apparent to the Canadian Supreme Court which, quite sensibly, declined to offer any real definition of what amounted to a “fair” dealing in recognition of the fact that it is ultimately a “question of degree” and a “matter of impression”.⁶⁸ The Canadian *Copyright Act* does not set out any of the matters articulated in s. 35(2) of the Singapore *Copyright Act*⁶⁹ and the Supreme Court endorsed the series of factors outlined by Linden J.A. of the Court of Appeal as relevant in the assessment of whether a dealing is fair. These factors⁷⁰ were drawn together from the approaches adopted by the U.K.⁷¹ and U.S.⁷² courts.

In reaching its conclusion that the Law Society had, through the actions of its librarians in the Great Library, engaged in “fair” dealings, the Court emphasised that the Access Policy which governed the custom photocopying service provided reasonable safeguards to the integrity and legitimacy of the entire process.⁷³ The following factors also featured prominently in the Supreme Court’s reasoning.

Firstly, that the Great Library’s custom photocopying service helped “to ensure that legal professionals in Ontario can access the materials necessary to conduct the research required on the practice of law” and that it was “an *integral* part of the legal research process, an allowable purpose under s. 29 of the *Copyright Act*”.⁷⁴ The facilitation of legal research is a policy objective which any court of law would be sympathetic towards, and there is little doubt that considerable weight was placed on

⁶⁸ *Ibid.* at para. 52.

⁶⁹ *Supra* note 51.

⁷⁰ The factors used by the Supreme Court were: (1) the purpose of the dealing (whether for one of the allowable purposes, whether with commercial objectives or not); (2) the character of the dealing (number of copies made, whether copies kept or destroyed after intended use, trade custom and industry practice); (3) the amount of the dealing (whether work copied in its entirety or only extracts reproduced); (4) the alternatives to the dealing (whether non-copyrighted equivalents available, whether the dealing was necessary to achieve the intended purpose); (5) the nature of the work (published or unpublished, confidential or not); and (6) the effect of the dealing on the work (whether likely to compete with the market of the original work or not).

⁷¹ Exemplified by the decision in *Hubbard v. Vosper* [1972] 1 All E.R. 1023 (C.A.).

⁷² *Supra* notes 47 and 51.

⁷³ *Supra* note 4 at paras. 61 to 64.

⁷⁴ *Ibid.* at para. 64. Linden J.A. in the Court of Appeal had also observed that “It is generally in the public interest that access to judicial decisions and other legal resources not be unjustifiably restrained”. See *C.C.H. Canadian Ltd. v. Law Society of Upper Canada* 2002 CarswellNat 1000, 2002 F.C.A. 187 at paragraph 159.

this purpose in arriving at the conclusion that the Library's dealings were "fair".⁷⁵ This factor is unlikely to have any real significance to the Singapore approach to the "fair dealing" defences because this pro-legal research policy has already been enshrined in the Singapore *Copyright Act* through a specific provision to exonerate liability for copyright infringement where anything is done for the purposes of a judicial proceeding and the giving of professional advice by a lawyer.⁷⁶

Secondly, there was some emphasis placed on the fact that the Law Society did not profit from its custom photocopy service and was essentially providing a service to the legal community. The Supreme Court also agreed with the Court of Appeal that there were no apparent alternatives to the custom photocopy service provided by the Great Library's librarians. It could not be reasonable to expect the patrons of the custom photocopy service to conduct their research on-site at the Great Library, as it would be burdensome to expect the twenty per cent of requesters who lived outside the Toronto area to travel to the city each time they wanted to track down a specific legal source. Given the heavy demands placed on the legal collection in the Great Library, researchers were not allowed to borrow materials from the library. If patrons were unable to request for copies to be made of those materials or make copies those materials themselves, they would have to do all their research and notetaking in the library itself—this would be an unreasonable expectation given the volume of research that is required in complex legal matters.⁷⁷

Thirdly, the Supreme Court pointed out that the character and amount of the dealings were factors which weighed in favour of a finding that the dealings were fair. The Court took great pains to stress that the Access Policy adopted by the Great Library in running its custom photocopy service only provided patrons with *single* copies of works at their request.⁷⁸ There was no evidence of multiple copies being disseminated to multiple members of the legal profession. This restriction on the photocopying service to one copy of one case, one article or one statutory reference was a significant factor which suggested that Law Society's dealings with the publishers' works were fair. It is submitted that this was a factual detail in the case before the Supreme Court that was crucial to the Law Society's success in

⁷⁵ It is perhaps ironic that any judicial policy which is accommodating towards the unauthorized reproduction of legal materials for the purposes of legal research, through a generous interpretation of the "fair dealing for private study or research" defence to copyright infringement, is tempered by the concern that lawyers overzealously reproduce unnecessarily lengthy bundles of case reports and other legal materials for use in the trial process. In his Response Opening of the Legal Year 2003, the Chief Justice of Singapore castigated "the undesirable practice of indiscriminate compilation of large numbers of documents" which some trial lawyers were responsible for, with the use of these "unnecessarily voluminous core bundles" persisting notwithstanding the introduction of substantial court fees. The Chief Justice cited the example of a \$19,000 filing fee for a "core bundle" comprising 2,000 pages in 7 volumes, not a page of which was used by counsel in his 75-minute submission. Another example given of the "excesses of legal practice" was a law firm filing a bill of costs which claimed \$259,000 in photocopying charges. See online: Supreme Court of Singapore <<http://www.supcourt.gov.sg/supcourt/upload/speeches/2003/DOC165.pdf>> at page 9.

⁷⁶ See s. 38 of the Singapore *Copyright Act* (Cap. 63, 1999 Rev. Ed. Sing.). The sheer breadth of this statutory defence to copyright infringement liability may not be consistent with Article 13 of the TRIPS Agreement. *Infra* at footnote 98.

⁷⁷ *Supra* note 4 at para. 69.

⁷⁸ There were no less than 11 clear references in the 90-paragraph judgment to the fact that the librarians at the Great Library made only *single* copies of legal materials requested for by patrons pursuant to its Access Policy.

raising the “fair dealing for private study or research” defence. On the other hand, as the court also observed, numerous requests for multiple reported judicial decisions submitted by a specific patron of the library over a short period of time may prevent the conclusion that the dealing is fair.⁷⁹

Following the guidelines described above, a law library or law school which reproduces cases and other legal materials *en masse* for the students enrolled in a professional course would not be able to raise the “fair dealing for private study or research” defence.⁸⁰ The dealing may be construed as furthering an allowable purpose—as part of the process of private study—but it will probably not be fair. But consider this alternative scenario: what if all of these students, or lawyers taking a professional education course, had individually submitted identical requests for single copies of these materials to the library? Would the intermediate copyist (the library) be able to avail himself of this defence?⁸¹

V. WHAT SHOULD WE MAKE OF ALL THIS?

The robustness of the approach taken by the Canadian Supreme Court in its interpretation of the “fair dealing for private study or research” defence to copyright infringement is evident when compared to recent decisions of the U.K. courts on the fair dealing defences. In evaluating the scope of the “fair dealing for reporting current events”⁸² defence, the U.K. Court of Appeal appears to have taken a more conservative view of the circumstances in which dealings with unauthorised copies of copyrighted works should be considered fair.

In both cases, British newspapers defendants made unauthorised use of copyrighted material by publishing them as accompaniments to news reports about a public figure. *Hyde Park Residences v. Yelland*⁸³ involved the reproduction of stills from security camera videos to accompany an article which discredited a prominent Knightsbridge businessman, while *Ashdown v. Telegraph Group*⁸⁴ involved the reproduction of meeting minutes from the diary of the former leader of the Liberal Democratic Party to accompany a report on a planned alliance between two political parties. Without going too much into the details of these two cases, it should be noted that the Court of Appeal arrived at the same conclusion in both cases—that the dealings with the copyrighted material were not fair. The fairness of a dealing was to be judged, according to the Court of Appeal, “by the objective standard of whether a fair minded and honest person would have dealt with the copyright work, in the manner that [the defendant] did, for the purpose of reporting the relevant current events”.⁸⁵ In *Hyde Park v. Yelland*, the dealing was not fair because an objective and fair-minded

⁷⁹ *Supra* note 4 at para. 68.

⁸⁰ Educational institutions may, however, qualify under the more limited exemptions or the statutory licensing scheme provided for in ss. 50A to 53 of the Singapore *Copyright Act* (Cap. 63, 1999 Rev. Ed. Sing.).

⁸¹ Logic suggests one outcome, while policy may point to another. Ultimately, as McLachlin C.J. has pointed out, “after all is said and done, it must be a matter of impression”. *Supra* note 68.

⁸² See s. 30(2) U.K. CDP 1988 (as amended) which is very similar to s. 37 of the Singapore *Copyright Act* (Cap. 63, 1999 Rev. Ed. Sing.).

⁸³ [1999] R.P.C. 655 (H.C.); [2000] R.P.C. 604 (C.A.).

⁸⁴ [2001] R.P.C. 34 (H.C.); [2002] R.P.C. 5 (C.A.).

⁸⁵ [2000] R.P.C. 604 at para. 38.

person would not have used the video stills, which were dishonestly taken, in a newspaper report.⁸⁶ It was also an excessive, and perhaps unnecessary,⁸⁷ use of the stills as the relevant information which the news reporter wished to convey—the timing of events prior to the death of the late Princess of Wales—could have been given in the newspaper articles themselves. Similarly, in *Ashdown v. Telegraph Group*, the use of the diary extract that was leaked to the newspaper was not a fair dealing because the extensive reproduction of the author's expression was not necessary to give an authentic account of the events which transpired, and the newspaper could have simply stated that they had obtained a copy of the minute and used just one or two short extracts from it.⁸⁸ In both cases, the U.K. Court of Appeal rejected the fair dealing defence because the copyrighted works were used “for reasons that were essentially journalistic in furtherance of the commercial interests” of the defendants.⁸⁹

While the English cases discussed above involve situations quite different from the facts before the Canadian Supreme Court, and despite the unmistakable influence of policy considerations relating to journalistic ethics which shaped the conclusions reached by the U.K. Court of Appeal, they still set useful benchmarks on the “fair dealing” defences in general against which the Canadian Supreme Court's decision can be evaluated. Notwithstanding the inherent differences in the policy factors which have to be assessed where the purpose of the dealing is “private study or research”, and when it is “reporting current events, the underlying assessment of the “fairness” of the dealing is similar enough for a meaningful comparison to be drawn between the judicial attitudes in these two jurisdictions.

The current judicial attitude adopted by the Singapore courts towards the fair dealing defences is probably closer to the approach taken by the U.K. courts. English authorities are heavily relied upon by our courts in the few cases⁹⁰ which have arisen in this area of copyright law, all of which have centred around judicial assessments of the purposes of the dealings rather than whether or not they were “fair” dealings. Even so, had the facts of the case before the Canadian Supreme Court appeared in Singapore, the same outcome would have been reached because of the special defence provisions that exist in the Singapore *Copyright Act* which are not present in its Canadian counterpart. The actions of the librarians from the Great Library, in operating the custom photocopying service at the request of library patrons, would have been exonerated from copyright infringement liability under s. 45(7) of the Singapore

⁸⁶ Aldous L.J. was particularly critical of the shady circumstances in which the video stills were acquired by the news reporter and was of the opinion that “to describe what [the newspaper] did as fair dealing is to give honour to dishonour”. *Ibid.* at para. 40.

⁸⁷ The test of necessity as a gauge of fair dealing was rejected by Jacob J. in the court below (see [1999] R.P.C. 655 at 662) where the “fair dealing” defence was successfully raised, a result that was subsequently overturned by the Court of Appeal.

⁸⁸ [2002] R.P.C. 5 (C.A.) at para. 81.

⁸⁹ In the Court of Appeal's view, the leaked diary extract was “deliberately filleted in order to extract colourful passages that were most likely to add flavour to the article and thus to appeal to the readership of the article”. *Ibid.* at para. 82.

⁹⁰ See *Robert John Powers School Inc. & Ors. v. Tessensohn* [1993] 3 S.L.R. 724 (fair dealing for private study or research), *Creative Technology Ltd. v. Aztech Systems Pte. Ltd.* [1997] 1 S.L.R. 621 (fair dealing for private study or research), *Bee Cheng Hiang Hup Chong Foodstuff Pte. Ltd. v. Fragrance Foodstuff Pte. Ltd.* [2003] 1 S.L.R. 305 (fair dealing for reporting current events).

Copyright Act.⁹¹ The terms of the Access Policy which govern the Great Library's custom photocopying service—request forms completed by library staff with input from the requesting patron,⁹² only single copies of works made on each request⁹³, identification of specific purposes for requests by patrons⁹⁴, and the not-for-profit basis of the service provided⁹⁵—correspond broadly with the key requirements of this special statutory defence.

What is significant, however, about the Canadian Supreme Court's decision is that the court was willing to interpret the "fair dealing for private study or research" defence in the Canadian *Copyright Act* broadly enough to encompass a situation which legislators in Singapore had to specifically provide for in the Singapore *Copyright Act*. Given the plethora of specific defences⁹⁶ found in the Singapore *Copyright Act* which stand apart from the trilogy of more flexible "fair dealing" defences,⁹⁷ what can we infer about the breadth of the latter group of defences? Should the "fair dealing" defences be interpreted narrowly, as the U.K. courts appear to have done, bearing in mind Singapore's obligations under Article 13 of the TRIPS Agreement⁹⁸ and Article 9(2) of the Berne Convention?⁹⁹ Given the inherently elastic nature of the boundaries of the "fair dealing" defences, just *how far* a court should be prepared to stretch those limits?

While it is tempting to give an it-depends-on-the-facts-and-circumstances explanation because of the degree of impressionistic assessment involved,¹⁰⁰ it may be more productive to inquire into the underlying judicial philosophy towards the *raison d'être* of these defences. The Canadian Supreme Court's decision gives us a few tantalising clues as to its own philosophy towards copyright law that may help explain why a court might be inclined to give a more liberal interpretation to the "fair dealing for private study or research" defence.

⁹¹ *Copyright Act* (Cap. 63, 1999 Rev. Ed. Sing.). Section 45 is titled "Copying by libraries and archives for users".

⁹² *Ibid.* Section 45(1)(a) requires a request in writing to be submitted to the officer-in-charge of the library.

⁹³ *Ibid.* Section 45(1)(a) limits the requests that can be made to just one copy of an article or copyrighted work. Section 45(1)(b)(ii) requires the requesting party to declare that he has not been previously supplied a copy of the work or material which he has requested for.

⁹⁴ *Ibid.* Section 45(1)(b)(i) requires the requesting party to declare that he requires the copy for the purpose of research or private study and that he will not use it for any other purpose.

⁹⁵ *Ibid.* Section 45(3) requires the amount charged by the library in relation to the request to be capped at the cost of making and supplying the copy and a reasonable contribution to the general expenses of the library.

⁹⁶ *Ibid.* Section 38 (judicial proceedings and professional legal advice), s. 39 (back-up copy of computer program), s. 40 (works included in collections for use by educational institutions), s. 41 (reading or recitation in public or for broadcast), s. 42 (religious performances), s. 43 (reproduction for broadcasting purposes), ss. 45-49 (use of works by libraries and archives), ss. 51-52A (copying works for educational purposes), and ss. 54-54A (copying of works in institutions assisting disabled readers).

⁹⁷ *Ibid.* Section 35 (private study or research), s. 36 (criticism or review) and s. 37 (reporting of current events).

⁹⁸ Agreement on Trade-Related Aspects of Intellectual Property Rights 1994. Article 13 requires member states to confine their limitations or exceptions to copyright in three ways: (1) only in special cases; (2) in cases which do not conflict with a normal exploitation of the work; and (3) which do not reasonably prejudice the legitimate interests of the copyright holder.

⁹⁹ Berne Convention for the Protection of Literary and Artistic Works 1886. Article 9(2) reflects the same criteria found in Article 13 of TRIPS (see previous note).

¹⁰⁰ See text above accompanying note 68.

VI. WHAT SHOULD THE RIGHTS OF THE COPYRIGHT OWNER BE BALANCED AGAINST?

The traditional view of copyright law has been to approach the “fair dealing” defences as embodiments of the broader public interest in curtailing the rights of the intellectual property owner, limiting the scope of protection afforded to him in the furtherance of important policy objectives: the dissemination and advancement of knowledge, the development of human capital, the propagation of new and improved works of authorial expression, and so forth. In applying the defences to copyright infringement, the role of the courts is to balance the rights of the copyright holder, as the owner of a species of intangible property, against the broader societal interests of the community which is bound by law to respect those rights. From this perspective, the scope of the “fair dealing” defences will correspond to the extent to which the courts endorse the inviolability of an individual’s property rights.

Contrast this with the observations of Chief Justice of the Canadian Supreme Court:

... the fair dealing exception is perhaps more properly understood as an integral part of the *Copyright Act* than simply a defence. Any act falling with 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 the *copyright owner and users’ interests*, it must not be interpreted restrictively. As Professor Vaver¹⁰¹ ... has explained ... ‘User rights are not just loopholes. Both owner rights and user rights should therefore be given the fair and balanced reading that befits remedial legislation.’¹⁰²

By conceptualising the “fair dealing” defences as manifestations of *users’* rights, the complexion of the balancing exercise undertaken by a court changes significantly. Rather than evaluating the copyright holder’s interests against a backdrop of ethereal considerations of public policy, the courts have to pursue a narrower line of inquiry into the extent of the rights of those who wish make use of a copyrighted work. Copyright law moves away from a preoccupation with the scope of the copyright owner’s exclusive rights *vis-à-vis* society at large, and has to start paying more attention instead to the *rights* of *non-copyright* owners who use copyrighted works within the copyright system. Are these rights of the same order as those conferred on copyright holders? Can they even be properly called “rights” in the first place?

These are questions which require far more sophisticated scrutiny and careful consideration than space permits in this article.¹⁰³ It is sufficient for the purposes of this commentary to indicate how this shift in copyright philosophy may impact

¹⁰¹ David Vaver, *Copyright Law* (Toronto: Irwin Law, 2000) at 171.

¹⁰² Emphasis added. *Supra* note 4 at para. 48. McLachlin C.J. delivered the unanimous opinion of the nine judges who comprise the Supreme Court of Canada.

¹⁰³ Taking the propositions put forward by the Canadian Supreme Court further, do users acquire a *right* to copy if they do so for an allowable purpose and in a manner which is fair? Are the rights of the ultimate user (the student or researcher) identical to the rights of the intermediary who makes copies for the former? Can the intermediary (*e.g.* the librarians operating the custom photocopying service at the Great Library) exercise the rights of the ultimate user (*e.g.* the library patrons who request for copies to be made) or are they rights which have to be personally exercised?

upon the attitude adopted by a court towards the application of the “fair dealing” defences. A court which shares the Canadian Supreme Court’s interpretation of the “fair dealing for private study or research” defence as a vehicle for vindicating the user’s rights may end up having to differentiate between the rights of different categories of users. Users who are students in a discipline identical to the subject matter of a copyrighted work that is used may have rights which are different from other users. Users which function as public libraries or archives may have stronger rights to deal with copyrighted works than other institutional users.

Even without accepting the Canadian Supreme Court’s views, given the broadly worded character of the “fair dealing” defences, is not a court free to take into account the identity of the user when assessing the fairness of the dealing in question? Yes, it is. The difference lies in the fact that, if the approach taken by McLachlin C.J. is followed, the law will cease to view these defences as merely *exceptions* to the rights of copyright holders, elevating them instead to the status of *rights* which copyright holders have to respect in relation to their copyrighted works. Once a user’s competing rights are introduced into the balancing exercise, it is submitted that a court is far more likely to widen the scope of the “fair dealing” defence to permit the unauthorized use of a copyrighted work.

VII. REVISITING THE “ORIGINALITY” DEBATE

Recognising that users have, or ought to have, certain “rights” to use works protected by copyright entails a shift in copyright policy which emphasises the role of copyright law in encouraging the creation of new works of authorship, promoting scholarship and the dissemination of ideas and information.¹⁰⁴ These policy impulses are not confined to issues relating to the breadth of the “fair dealing” defences, or determining which parties are entitled to invoke these defences. The same policy considerations spill over into the “originality” debate discussed earlier,¹⁰⁵ where the issue is whether a work should attract copyright protection in the first place, or whether it should be available for others to make free use of.

At the very heart of the idea-expression dichotomy, arising from which is the sacrosanct principle of copyright law that no copyright may subsist in facts, lies the notion that there are elements in the public domain—as well as simple compilations of those elements—which users should be entitled to make unfettered use of. The cases which have produced divergent approaches to the “originality” concept have primarily been concerned with factual compilations of data, where judicial attention is directed towards determining whether or not the author has exercised sufficient intellectual effort, or independent choice in the selection or arrangement of the data, to render his work “original” for the purposes of copyright law. By refusing to

¹⁰⁴ These are objectives closely associated with U.S. copyright policy which draws its inspiration from the Constitutional mandate “To promote the progress of science and the useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries”. See *U.S. Federal Constitution*, Art. I, Section 8, Clause 8. Placing greater emphasis on these objectives necessarily diverts attention away from the other roles which copyright law may perform—protecting and rewarding the author’s expenditure of skill, effort and judgement, for example, where more attention is directed towards a conception of copyright as a bundle of proprietary rights that is personal to the author.

¹⁰⁵ See text above accompanying footnotes 8 to 23.

recognise the subsistence of copyright in compilations which lack any “modicum of creativity”, the U.S. courts have sought to ensure that individuals other than the compiler are able to make use of these works to build further databases, or superior compilations, or for any other project they may wish to pursue. This is consistent with the policy-driven approach taken by the Canadian Supreme Court to give consideration to user rights when assessing whether or not an unauthorised dealing with a copyrighted work is “fair”.

VIII. USERS’ RIGHTS AND THE TRIPS AGREEMENT

Adopting an approach to the “fair dealing” defences which formally recognises users’ rights as a relevant factor in determining their scope of application raises further issues of compatibility with the requirements of the TRIPS Agreement. Article 13 of the TRIPS Agreement, which deals with the standards that have to be applied when formulating defences to copyright infringement, obliges Member States to “confine limitations or exceptions to exclusive rights to certain *special cases* which *do not conflict with a normal exploitation of the work* and *do not unreasonably prejudice the legitimate interests* of the right holder”.¹⁰⁶ Reconciling the expectations placed on Member States by the TRIPS Agreement, which appear more consistent with the conservative approach taken by the U.K. courts, with the robust approach taken by the Canadian Supreme Court will not be an easy task.

In contrast, the importance of giving weight to users’ rights is explicitly recognised elsewhere in the TRIPS Agreement in a provision concerned with the defences to *patent* infringement. Under Article 30, Member states

may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, *taking account of the legitimate interests of third parties*.¹⁰⁷

What could explain the distinction between these provisions? Why should users’ rights receive greater prominence in the realm of patent law than under copyright law?

An authoritative response to these questions would require a thorough examination of the negotiation history which led up to the TRIPS Agreement, an enterprise which is beyond the scope of this article. I would suggest, however, that it probably has something to do with our conventional understanding of copyrights and patents as different species of intellectual property. Given that the patent is traditionally viewed as comprising a bundle of exclusive rights that are of a “higher order” than the rights enjoyed by the copyright holder¹⁰⁸, the patent system should, as a matter of sound public policy, incorporate checks and balances of a similarly “higher order”.

¹⁰⁶ Emphasis added. Agreement on Trade-related Aspects of Intellectual Property Rights 1994, Part II. All members of the World Trade Organisation (WTO) are obliged to comply with the standards set in the TRIPS Agreement.

¹⁰⁷ *Ibid.* Emphasis added.

¹⁰⁸ Copyright only protects the copyright holder from unauthorised *copying* of the *actual expressive elements* of a work, whereas the scope of protection derived from a patent extends considerably further. The patentee’s rights are infringed by acts of copying as well as acts of *independent creation*, and the inventive concept which is protected may extend to functional *variants* which are not found in the literal wording of the patent claims and specifications.

Balancing the rights of third party users against those of the patentee would serve as an important counterweight to the panoply of legal rights protecting the latter. If copyright law continues to evolve along its current trajectory, such that the rights enjoyed by the copyright holder are progressively enhanced and the gap between the these two species of intellectual property is narrowed, perhaps a stronger case can be made out for reviewing the narrowly worded Article 13.

IX. CONCLUSION: WHAT LIES AHEAD?

The approach taken by the Canadian Supreme Court towards the proper role and scope of the “fair dealing for private study or research” defence reveals a subtle, but significant, shift in the underlying philosophy that fuels copyright law in Canada. The significance of such a robust approach to the application of the defence is more than just a matter of semantics. It signals a judicial willingness to entertain arguments made by users that they should, in the appropriate circumstances, be entitled to avail themselves of the defence because of some *entitlement* derived from their *status* as *users*. This shift in judicial attitude is evident from the unconventional way in which the Court applied this “fair dealing” defence. An intermediary copyist who facilitated the research process, but did not use the copies it made for its own research, could avail itself of the defence and evade liability for copyright infringement, without having to prove that the ultimate users of the copies actually made use of the copied material for research or private study.

This note has sought to explain the policy implications of these developments, as well as the significance of the inroads which have been made into the traditional frontiers of the “fair dealing” defences which the U.K. and Singapore courts have erected. Can this shift in philosophy be accounted for, at least in part, by a judicial reaction to the global trend towards strengthening the position of copyright holders? Have the courts come to realise, consciously or otherwise, that they have a crucial role to play in restoring the balance that is upset every time legislative enhancements are introduced to bolster the copyright owner’s arsenal?¹⁰⁹ These are just some of issues which the Singapore courts may wish to consider in light of the impending changes to the Singapore *Copyright Act* to achieve compliance with the terms of the U.S.-Singapore Free-Trade Agreement.¹¹⁰

¹⁰⁹ See text above accompanying footnotes 42 to 45.

¹¹⁰ The U.S.-Singapore F.T.A. entered into force on 1 January 2004. Article 16.10 of the Agreement provides that the agreed amendments to Singapore’s intellectual property laws, including those which strengthen the position of copyright holders, have to be implemented within six months of this date.