IP Osgoode Speaker Series: The Honourable Mr. Justice Marshall Rothstein – Reflections on the Supreme Court of Canada 2012 Copyright Decisions

November 29, 2012 by Adam Del Gobbo

On November 27th, 2012, IP Osgoode was pleased to welcome **The Honourable Mr. Justice Marshall Rothstein** of the Supreme Court of Canada to share his thoughts with respect to the 5 important copyright cases (known as the "Copyright Pentalogy") that he took part in deciding earlier this year.

The IPilogue has covered these 5 cases in depth and our analysis of each can be found here.

The lecture began with introductory statements by the Founder and Director of IP Osgoode, **Professor Giuseppina D'Agostino**. IP Osgoode's **Professor David Vaver** followed with a short outline of Justice Rothstein's legal career and past accomplishments. We learned that before becoming a judge, Justice Rothstein spent a number of years in private practice dealing primarily with administrative and transportation law issues. He later became a member of the Canadian Human Rights Tribunal and held a host of other offices throughout his career. (More information on Justice Rothstein's career can be found here.) Upon his appointment to the Federal Court in 1992, Justice Rothstein developed an interest in intellectual property law, writing a number of influential decisions. He was eventually elevated to the Supreme Court of Canada (SCC) in 2006. Professor Vaver made special note that the date of Justice Rothstein's official swearing-in ceremony – April 10th, 2006 – was auspicious for sharing the anniversary of the commencement of the Statute of Anne and potentially meant important things to come for the field of copyright law as a result.

Justice Rothstein, taking to the podium, made his sizable audience laugh at his forgetfulness to bring his "red Santa Claus robes" for the lecture and mentioned that his introduction would have been very different had his wife Sheila given it. This set the tone for the rest of the lecture – Justice Rothstein proceeded to give a very frank and honest discussion on the Copyright Pentalogy cases, eager to generate discussion on the cases and to answer questions the audience had on his experiences when deciding these cases.

Justice Rothstein began with a short discussion of 3 of the Copyright Pentalogy cases: *Re:Sound v. Motion Picture Theatre Associations of Canada*; *Society of Composers, Authors and Music Publishers of Canada v Bell Canada*; and *Rogers Communications Inc v Society of Composers, Authors and Music Publishers of Canada*. To an extent, these could be considered the "less-controversial" decisions by the Supreme Court of Canada in the Pentalogy (as evidenced by the unanimous decisions in *Re:Sound* and *SOCAN v Bell* and the majority of 8 in *Rogers v SOCAN*). However, Justice Rothstein had some important points he wanted to share with respect to the latter two cases.

In *SOCAN v Bell*, the court had to determine if an online preview of a song could be considered "research" for the purpose of avoiding a claim of copyright infringement under a fair dealing exception. The SCC agreed with the decision of the Copyright Board – such a use was reasonable and was protected under fair dealing. Justice Rothstein referred to what he thought were 4 interesting aspects of this case:

1) "Research" as described in the case is a very low hurdle to overcome and provides an expansive approach to the first part of the fair dealing test laid out in *CCH Canadian Ltd v Law Society of Upper Canada*.
2) In determining whether the specific dealing at issue was fair or not under the second part of the fair dealing test, the reviewing courts should give deference to first instance courts that make a determination on this issue.
3) Fair dealing is to be assessed from the point of view of the purchaser/user.
4) "Research" need not be associated with traditional intellectual pursuits.

In *Rogers v SOCAN*, the court determined the meaning of "to communicate the work to the public" in s. 3(1)(f) of the Copyright Act in the context of streaming musical works. Justice Rothstein wrote the decision for the majority: streaming of a copyright work to a number of individuals is a public communication. The determination of this issue could be different depending on whose point of view (the sender or the receiver); in the end the desire for the court to remain technologically neutral led to it's decision.

The discussion of the last two cases in the Copyright Pentalogy (*Entertainment Software Association v Society of Composers, Authors and Music Publishers of Canada* and *Alberta (Education) v Canadian Copyright Licensing Agency (Access Copyright)*) provided interesting insight into the thoughts and opinions of the Supreme Court Justice (it should be noted that Justice Rothstein wrote dissenting opinions in each of the cases).

To begin his discussion of *ESAC v SOCAN*, Justice Rothstein told a story about a case he worked on in 1990 about railway companies and grain rates, representing four provinces in the case. Ian Binnie, who would also later become a Justice of the SCC presented a very compelling statutory interpretation argument to the court. After a sleepless night preparing a response, Justice Rothstein was able to convince the court that the railway company was attempting to get double compensation for its product ("double-dipping"). The purpose of the story was to illustrate that judges do not like double-dipping and will go to great lengths to prevent any such unjust enrichment. The relevance of the anecdote became readily apparent as *ESAC v SOCAN* concerned copyright holders of musical works wanting to receive royalties for their music used in video games which had been downloaded over the internet. SOCAN attempted to construe the download as a communication (the artists only negotiate a right to reproduce the musical works), thereby entitling artists to a separate communication tariff. For Justice Rothstein, applying his caselaw experience as a practitioner, now on the other side, it wasn't very difficult to see how some of the judges viewed SOCAN's approach as an attempt to "double-dip".

Justice Rothstein repeated the well-known concept that the purpose of the court is to give effect to legislation that has been created by governmental bodies and to interpret those laws in accordance with their purpose. However, Justice Rothstein disagreed with the approach that the majority took in this case – in determining that the list in s. 3(1) of the *Copyright Act* are not individual and distinct rights (as he and the minority believed) but rather enumerated examples of the sole rights to reproduce, perform and publish works that is outlined in the preamble to s. 3(1). He also disagreed with the majority's decision to push technological neutrality (a desirable objective but not one enshrined in the *Copyright Act*) ahead of some of the statutory requirements that he felt were overlooked. Justice Rothstein then pointed out that SCC judges are not prescient or clairvoyant – the court does not usually know what will happen as a result of their decisions until they take place.

If technological neutrality becomes an overriding issue in copyright cases, Justice Rothstein is not sure if copyright laws will be read more narrowly now or what effect the *Copyright Modernization Act* will have on future cases that come to the federal courts. He noted that some cases have already come forward as a result and that there will likely be many more.

Justice Rothstein finished his presentation with a discussion of the *Access Copyright* case – where photocopies made by teachers and distributed to their students as part of class instruction were determined to be fair dealing under s. 29 of the Copyright Act. These types of copies were considered "Category 4" photocopies – the other 3 categories were already considered fair dealing and were either copies made for the teacher's use or at the request of a student. While the majority determined that these copies could be considered fair dealing (the end user was the student and considerations towards their research should weigh in their favour), the minority believed that since the teacher would be doing the copying, the teacher's purpose should weigh in their favour.

After the decision by the SCC on the subject, the redetermination by the Copyright Board was, in the words of Justice Rothstein, "terse" (as most 1-sentence decisions tend to be). The SCC's decision did not allow for much flexibility and went against one of the usual practices of appellate courts – to give deference to the Copyright Board in findings of fact (fairness in claims of fair dealings is one such finding of fact). Justice Rothstein noted that while the courts "don't always practise what they preach", one of

the differences between the relationship between the Copyright Board and the courts as opposed to other tribunals is that the federal and provincial courts have concurrent jurisdiction with the Copyright Board in interpreting rights. He finished his discussion of the case by stating that he agreed with a deferential review by appellate courts on factual questions but not on legal questions decided by any tribunal.

After a round of applause concluded his presentation, Justice Rothstein took a seat between Professors D'Agostino and Vaver and answered some of the questions that audience members had with respect to the Copyright Pentalogy and his thoughts on copyright issues. One such question was posed by IP Osgoode's **Professor Carys Craig** concerning the role of the balancing principle as discussed in *Théberge v Galerie d'Art du Petit Champlain Inc* and its effect on statutory interpretation. Rothstein replied that this balancing is at the very heart of many of the decisions the court makes, not only in copyright cases but other intellectual property cases such as the *Teva Canada Ltd v Pfizer Canada Inc*. He also stated that while some may believe that the "balancing" done by the court is an after-the-fact justification of the court's decisions, the concept of balance is always in the mind of the adjudicators.

Another thought-provoking question by an audience member was whether there is room for common law equity considerations in copyright law (being a creature of statute). Justice Rothstein responded that even though the court is bound to the statute in a number of ways, equitable considerations can come into play. While he was unsure of the application of the equity doctrine to Canadian copyright law, he mentioned one possibility could be new factors being added to the six factor CCH fair dealing test.

After a resounding applause from the audience at the closing of the discussion and a short wait as the Supreme Court Justice answered the personal questions of some inquisitive Osgoode students, I was able to thank Justice Rothstein for speaking at our school and providing us his insights on these important copyright issues. It was an enlightening afternoon and I hope that he returns to speak to us again in the future. Perhaps we can get his wife Sheila to introduce him next time? (You had to be there for his opening remarks, please do watch the webcast when it becomes available).

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