

Richard Warman and National Post Company (applicants) v. Mark Fournier and Constance
Fournier (respondents)
(T-784-11; 2012 CF 803; 2012 FC 803)

Indexed As: Warman et al. v. Fournier

Federal Court
Rennie, J.
June 21, 2012.

Summary:

Warman asserted that the respondents infringed his copyright in three works and applied for several remedies.

The Federal Court dismissed the application.

Copyright - Topic 4405

Infringement of copyright - General principles - Substantial similarity or substantial copying - An article authored by Kay and published in the National Post was highly critical of Warman - Warman obtained an exclusive license to the copyright in the article through an agreement with the National Post on January 13, 2010 - He registered the copyright on March 10, 2011 - Warman asserted that the respondents infringed his copyright in the article by reproducing excerpts from it on their website - He asserted that the excerpts constituted a substantial part of the article - He applied for various remedies - The respondents asserted that the application was barred by the three year limitation period set out in s. 41(1) of the Copyright Act - The Federal Court held that the application was not statute barred since Warman could not have become aware of the infringement until he obtained a license to the copyright in 2010 - Whether a substantial part of the work had been reproduced was a question of fact - The court referred to and applied the relevant factors, concluding that Warman had not established that the excerpts constituted a substantial part of the article and there was therefore no infringement - Quantitatively, the reproduction constituted less than half of the work - Qualitatively, the portions reproduced were the article's opening "hook" and the summary of the facts on which the article was based - Most of the commentary and original thought expressed by Kay was not reproduced - Most of the other facts were not directly relevant as Warman was not using the subject matter of the copyright in the sense of reproducing or publishing it - The respondents had not reproduced the excerpts to save time and effort, but to preserve a record of the facts summarized in the article so that members of their online forum could continue to discuss those facts on the forum - Alternatively, the excerpts constituted fair dealing for the purposes of news reporting (s. 29.2) - See paragraphs 22 to 35.

Copyright - Topic 4546

Infringement of copyright - Acts not constituting infringement - Implied licence to use - Warman discovered that the respondents had reproduced a photograph of him and another person on their website in August 2010 - He obtained the copyright in the photograph on

February 18, 2011- Warman asserted that the respondents infringed his copyright in the photograph and applied for various remedies - The respondents asserted that the photograph was never uploaded to the server for their online forum, rather a member had posted an inline link to the photograph as it appeared on Warman's personal website - The photograph was no longer displayed on the Warman website and therefore the inline link no longer worked - The Federal Court held that there was no copyright infringement where Warman had authorized the communication of the photograph by posting it on his website and making it available to the public - Warman asserted that the respondents could not rely on the fact that the photograph was posted on his website because that would amount to "blaming the victim" - However, Warman was only a victim of infringement if the respondents did something that only Warman had the right to do without his authorization - The photograph was within Warman's full control and if he had not wanted it to be communicated by telecommunication, he could have removed it from his website, as he eventually did - See paragraphs 36 to 38.

Copyright - Topic 4563

Infringement of copyright - Internet, on-line services, CD Rom and other electronic media - Newspapers and newspaper articles - [See **Copyright - Topic 4405**].

Copyright - Topic 4566

Infringement of copyright - Internet, on-line services, CD Rom and other electronic media - Use on website - [See **Copyright - Topic 4405** and **Copyright Topic 4546**].

Copyright - Topic 4583

Infringement of copyright - Remedies - Injunctive relief - Warman asserted that the respondents infringed his copyright in a speech authored by him in July 2005 - The copyright was registered on February 18, 2011 - Warman discovered that the speech had been reproduced on the respondents' website in September 2007 - The respondents acknowledged that the speech was uploaded to their website at that time - The Federal Court held that Warman had established a prima facie infringement of his copyright, however he was precluded from obtaining a remedy where his application was not commenced within three years of his discovering the infringement (Copyright Act, s. 41(1)) - Warman asserted that the s. 41(1) limitation period did not apply to injunctive relief because of the equitable nature of that relief (*Milliken & Co. v. Interface Flooring Systems (Canada) Inc.* (F.C.T.D., 1996) - The only cases cited in *Milliken* dated back to the 1920's - Recent cases, including those in which an injunction was sought, had applied the limitation period and denied any remedy - It was unclear if the parties in those cases had argued that injunctive relief was available outside the limitation period - Even if s. 41(1) did not preclude the granting of injunctive relief, it at the very least informed the exercise of the court's discretion to grant an injunction for copyright infringement - It would be contrary to Parliament's intent to find that an injunction was presumptively available for an infringement if the application was brought outside the three year period - It was more consistent with the Act, for the court to limit the exercise of its discretion to grant an injunction to circumstances where it would have some practical effect and the balance of convenience strongly favoured granting the injunction - Here, Warman had not established that an injunction was necessary to prevent further infringement - Rather, the

respondents had removed the speech from their server and the physical copies that they retained were for the purpose of defending a defamation action that Warman had brought against them - See paragraphs 11 to 22.

Copyright - Topic 4642

Defences - Consent - [See **Copyright - Topic 4546**].

Copyright - Topic 4645

Defences - Fair dealing - [See **Copyright - Topic 4405**].

Copyright - Topic 6007

Practice - General - Limitation of actions - [See **Copyright - Topic 4405** and **Copyright - Topic 4583**].

Limitation of Actions - Topic 15

General principles - Discoverability rule - Application of - [See **Copyright - Topic 4405**].

Limitation of Actions - Topic 16

General principles - Applicability to equitable relief - [See **Copyright - Topic 4583**].

Limitation of Actions - Topic 4408

Statutory causes of action - Copyright infringement - [See **Copyright - Topic 4405** and **Copyright - Topic 4583**].

Limitation of Actions - Topic 9305

Postponement or suspension of statute - General - Discoverability rule - [See **Copyright - Topic 4405**].

Cases Noticed:

Public Performance of Musical Works, Re, [1999] C.B.D. No. 5, refd to. [para. 13].
Philip Morris Products S.A. et al. v. Marlboro Canada Ltd. et al. (2010), 374 F.T.R. 213; 2010 FC 1099, refd to. [para. 15].
Milliken & Co. v. Interface Flooring Systems (Canada) Inc. (1996), 123 F.T.R. 269; 75 C.P.R.(3d) 481 (T.D.), refd to. [para. 18].
Drolet v. Gralsbotschaft et al. (2009), 341 F.T.R. 44; 2009 FC 17, refd to. [para. 19].
Smith v. Hayden, [2010] O.A.C. Uned. 398; 2010 ONCA 271, refd to. [para. 19].
CCH Canadian Ltd. et al. v. Law Society of Upper Canada, [2004] 1 S.C.R. 339; 317 N.R. 107; 2004 SCC 13, refd to. [para. 20].
Kraft Canada Inc. v. Euro Excellence Inc. (2007), 365 N.R. 332; 2007 SCC 37, refd to. [para. 22].
U&R Tax Services Ltd. v. H&R Block Canada Inc. (1995), 97 F.T.R. 259 (T.D.), appld. [para. 23].

Counsel:

James Katz, for the applicant, Richard Warman;

Mark Fournier and Constance Fournier, on their own behalf.

Solicitors of Record:

Brazeauseller LLP, Ottawa, Ontario, for the applicant, Richard Warman.

This application was heard at Ottawa, Ontario, on May 28, 2012, by Rennie, J., of the Federal Court, who delivered the following reasons for judgment on June 21, 2012.

Application dismissed.

Editor: Gary W. McLaughlin

Copyright - Topic 4563

Infringement of copyright - Internet, on-line services, CD Rom and other electronic media - Newspapers and newspaper articles - An article authored by Kay and published in the National Post was highly critical of Warman - Warman obtained an exclusive license to the copyright in the article through an agreement with the National Post on January 13, 2010 - He registered the copyright on March 10, 2011 - Warman asserted that the respondents infringed his copyright in the article by reproducing excerpts from it on their website - He asserted that the excerpts constituted a substantial part of the article - He applied for various remedies - The respondents asserted that the application was barred by the three year limitation period set out in s. 41(1) of the Copyright Act - The Federal Court held that the application was not statute barred since Warman could not have become aware of the infringement until he obtained a license to the copyright in 2010 - Whether a substantial part of the work had been reproduced was a question of fact - The court referred to and applied the relevant factors, concluding that Warman had not established that the excerpts constituted a substantial part of the article and there was therefore no infringement - Quantitatively, the reproduction constituted less than half of the work - Qualitatively, the portions reproduced were the article's opening "hook" and the summary of the facts on which the article was based - Most of the commentary and original thought expressed by Kay was not reproduced - Most of the other facts were not directly relevant as Warman was not using the subject matter of the copyright in the sense of reproducing or publishing it - The respondents had not reproduced the excerpts to save time and effort, but to preserve a record of the facts summarized in the article so that members of their online forum could continue to discuss those facts on the forum - Alternatively, the excerpts constituted fair dealing for the purposes of news reporting (s. 29.2) - See paragraphs 22 to 35.

Copyright - Topic 4566

Infringement of copyright - Internet, on-line services, CD Rom and other electronic media - Use on website - An article authored by Kay and published in the National Post was highly critical of Warman - Warman obtained an exclusive license to the copyright in the article through an agreement with the National Post on January 13, 2010 - He registered the copyright on March 10, 2011 - Warman asserted that the respondents infringed his copyright in the article by reproducing excerpts from it on their website - He

asserted that the excerpts constituted a substantial part of the article - He applied for various remedies - The respondents asserted that the application was barred by the three year limitation period set out in s. 41(1) of the Copyright Act - The Federal Court held that the application was not statute barred since Warman could not have become aware of the infringement until he obtained a license to the copyright in 2010 - Whether a substantial part of the work had been reproduced was a question of fact - The court referred to and applied the relevant factors, concluding that Warman had not established that the excerpts constituted a substantial part of the article and there was therefore no infringement - Quantitatively, the reproduction constituted less than half of the work - Qualitatively, the portions reproduced were the article's opening "hook" and the summary of the facts on which the article was based - Most of the commentary and original thought expressed by Kay was not reproduced - Most of the other facts were not directly relevant as Warman was not using the subject matter of the copyright in the sense of reproducing or publishing it - The respondents had not reproduced the excerpts to save time and effort, but to preserve a record of the facts summarized in the article so that members of their online forum could continue to discuss those facts on the forum - Alternatively, the excerpts constituted fair dealing for the purposes of news reporting (s. 29.2) - See paragraphs 22 to 35.

Copyright - Topic 4566

Infringement of copyright - Internet, on-line services, CD Rom and other electronic media - Use on website - Warman discovered that the respondents had reproduced a photograph of him and another person on their website in August 2010 - He obtained the copyright in the photograph on February 18, 2011- Warman asserted that the respondents infringed his copyright in the photograph and applied for various remedies - The respondents asserted that the photograph was never uploaded to the server for their online forum, rather a member had posted an inline link to the photograph as it appeared on Warman's personal website - The photograph was no longer displayed on the Warman website and therefore the inline link no longer worked - The Federal Court held that there was no copyright infringement where Warman had authorized the communication of the photograph by posting it on his website and making it available to the public - Warman asserted that the respondents could not rely on the fact that the photograph was posted on his website because that would amount to "blaming the victim" - However, Warman was only a victim of infringement if the respondents did something that only Warman had the right to do without his authorization - The photograph was within Warman's full control and if he had not wanted it to be communicated by telecommunication, he could have removed it from his website, as he eventually did - See paragraphs 36 to 38.

Copyright - Topic 4642

Defences - Consent - Warman discovered that the respondents had reproduced a photograph of him and another person on their website in August 2010 - He obtained the copyright in the photograph on February 18, 2011- Warman asserted that the respondents infringed his copyright in the photograph and applied for various remedies - The respondents asserted that the photograph was never uploaded to the server for their online forum, rather a member had posted an inline link to the photograph as it appeared on Warman's personal website - The photograph was no longer displayed on the Warman

website and therefore the inline link no longer worked - The Federal Court held that there was no copyright infringement where Warman had authorized the communication of the photograph by posting it on his website and making it available to the public - Warman asserted that the respondents could not rely on the fact that the photograph was posted on his website because that would amount to "blaming the victim" - However, Warman was only a victim of infringement if the respondents did something that only Warman had the right to do without his authorization - The photograph was within Warman's full control and if he had not wanted it to be communicated by telecommunication, he could have removed it from his website, as he eventually did - See paragraphs 36 to 38.

Copyright - Topic 4645

Defences - Fair dealing - An article authored by Kay and published in the National Post was highly critical of Warman - Warman obtained an exclusive license to the copyright in the article through an agreement with the National Post on January 13, 2010 - He registered the copyright on March 10, 2011 - Warman asserted that the respondents infringed his copyright in the article by reproducing excerpts from it on their website - He asserted that the excerpts constituted a substantial part of the article - He applied for various remedies - The respondents asserted that the application was barred by the three year limitation period set out in s. 41(1) of the Copyright Act - The Federal Court held that the application was not statute barred since Warman could not have become aware of the infringement until he obtained a license to the copyright in 2010 - Whether a substantial part of the work had been reproduced was a question of fact - The court referred to and applied the relevant factors, concluding that Warman had not established that the excerpts constituted a substantial part of the article and there was therefore no infringement - Quantitatively, the reproduction constituted less than half of the work - Qualitatively, the portions reproduced were the article's opening "hook" and the summary of the facts on which the article was based - Most of the commentary and original thought expressed by Kay was not reproduced - Most of the other facts were not directly relevant as Warman was not using the subject matter of the copyright in the sense of reproducing or publishing it - The respondents had not reproduced the excerpts to save time and effort, but to preserve a record of the facts summarized in the article so that members of their online forum could continue to discuss those facts on the forum - Alternatively, the excerpts constituted fair dealing for the purposes of news reporting (s. 29.2) - See paragraphs 22 to 35.

Copyright - Topic 6007

Practice - General - Limitation of actions - An article authored by Kay and published in the National Post was highly critical of Warman - Warman obtained an exclusive license to the copyright in the article through an agreement with the National Post on January 13, 2010 - He registered the copyright on March 10, 2011 - Warman asserted that the respondents infringed his copyright in the article by reproducing excerpts from it on their website - He asserted that the excerpts constituted a substantial part of the article - He applied for various remedies - The respondents asserted that the application was barred by the three year limitation period set out in s. 41(1) of the Copyright Act - The Federal Court held that the application was not statute barred since Warman could not have become aware of the infringement until he obtained a license to the copyright in 2010 -

Whether a substantial part of the work had been reproduced was a question of fact - The court referred to and applied the relevant factors, concluding that Warman had not established that the excerpts constituted a substantial part of the article and there was therefore no infringement - Quantitatively, the reproduction constituted less than half of the work - Qualitatively, the portions reproduced were the article's opening "hook" and the summary of the facts on which the article was based - Most of the commentary and original thought expressed by Kay was not reproduced - Most of the other facts were not directly relevant as Warman was not using the subject matter of the copyright in the sense of reproducing or publishing it - The respondents had not reproduced the excerpts to save time and effort, but to preserve a record of the facts summarized in the article so that members of their online forum could continue to discuss those facts on the forum - Alternatively, the excerpts constituted fair dealing for the purposes of news reporting (s. 29.2) - See paragraphs 22 to 35.

Copyright - Topic 6007

Practice - General - Limitation of actions - Warman asserted that the respondents infringed his copyright in a speech authored by him in July 2005 - The copyright was registered on February 18, 2011 - Warman discovered that the speech had been reproduced on the respondents' website in September 2007 - The respondents acknowledged that the speech was uploaded to their website at that time - The Federal Court held that Warman had established a prima facie infringement of his copyright, however he was precluded from obtaining a remedy where his application was not commenced within three years of his discovering the infringement (Copyright Act, s. 41(1)) - Warman asserted that the s. 41(1) limitation period did not apply to injunctive relief because of the equitable nature of that relief (Milliken & Co. v. Interface Flooring Systems (Canada) Inc. (F.C.T.D., 1996) - The only cases cited in Milliken dated back to the 1920's - Recent cases, including those in which an injunction was sought, had applied the limitation period and denied any remedy - It was unclear if the parties in those cases had argued that injunctive relief was available outside the limitation period - Even if s. 41(1) did not preclude the granting of injunctive relief, it at the very least informed the exercise of the court's discretion to grant an injunction for copyright infringement - It would be contrary to Parliament's intent to find that an injunction was presumptively available for an infringement if the application was brought outside the three year period - It was more consistent with the Act, for the court to limit the exercise of its discretion to grant an injunction to circumstances where it would have some practical effect and the balance of convenience strongly favoured granting the injunction - Here, Warman had not established that an injunction was necessary to prevent further infringement - Rather, the respondents had removed the speech from their server and the physical copies that they retained were for the purpose of defending a defamation action that Warman had brought against them - See paragraphs 11 to 22.

Limitation of Actions - Topic 15

General principles - Discoverability rule - Application of - An article authored by Kay and published in the National Post was highly critical of Warman - Warman obtained an exclusive license to the copyright in the article through an agreement with the National Post on January 13, 2010 - He registered the copyright on March 10, 2011 - Warman

asserted that the respondents infringed his copyright in the article by reproducing excerpts from it on their website - He asserted that the excerpts constituted a substantial part of the article - He applied for various remedies - The respondents asserted that the application was barred by the three year limitation period set out in s. 41(1) of the Copyright Act - The Federal Court held that the application was not statute barred since Warman could not have become aware of the infringement until he obtained a license to the copyright in 2010 - Whether a substantial part of the work had been reproduced was a question of fact - The court referred to and applied the relevant factors, concluding that Warman had not established that the excerpts constituted a substantial part of the article and there was therefore no infringement - Quantitatively, the reproduction constituted less than half of the work - Qualitatively, the portions reproduced were the article's opening "hook" and the summary of the facts on which the article was based - Most of the commentary and original thought expressed by Kay was not reproduced - Most of the other facts were not directly relevant as Warman was not using the subject matter of the copyright in the sense of reproducing or publishing it - The respondents had not reproduced the excerpts to save time and effort, but to preserve a record of the facts summarized in the article so that members of their online forum could continue to discuss those facts on the forum - Alternatively, the excerpts constituted fair dealing for the purposes of news reporting (s. 29.2) - See paragraphs 22 to 35.

Limitation of Actions - Topic 16

General principles - Applicability to equitable relief - Warman asserted that the respondents infringed his copyright in a speech authored by him in July 2005 - The copyright was registered on February 18, 2011 - Warman discovered that the speech had been reproduced on the respondents' website in September 2007 - The respondents acknowledged that the speech was uploaded to their website at that time - The Federal Court held that Warman had established a prima facie infringement of his copyright, however he was precluded from obtaining a remedy where his application was not commenced within three years of his discovering the infringement (Copyright Act, s. 41(1)) - Warman asserted that the s. 41(1) limitation period did not apply to injunctive relief because of the equitable nature of that relief (*Milliken & Co. v. Interface Flooring Systems (Canada) Inc.* (F.C.T.D., 1996) - The only cases cited in *Milliken* dated back to the 1920's - Recent cases, including those in which an injunction was sought, had applied the limitation period and denied any remedy - It was unclear if the parties in those cases had argued that injunctive relief was available outside the limitation period - Even if s. 41(1) did not preclude the granting of injunctive relief, it at the very least informed the exercise of the court's discretion to grant an injunction for copyright infringement - It would be contrary to Parliament's intent to find that an injunction was presumptively available for an infringement if the application was brought outside the three year period - It was more consistent with the Act, for the court to limit the exercise of its discretion to grant an injunction to circumstances where it would have some practical effect and the balance of convenience strongly favoured granting the injunction - Here, Warman had not established that an injunction was necessary to prevent further infringement - Rather, the respondents had removed the speech from their server and the physical copies that they retained were for the purpose of defending a defamation action that Warman had brought against them - See paragraphs 11 to 22.

Limitation of Actions - Topic 4408

Statutory causes of action - Copyright infringement - An article authored by Kay and published in the National Post was highly critical of Warman - Warman obtained an exclusive license to the copyright in the article through an agreement with the National Post on January 13, 2010 - He registered the copyright on March 10, 2011 - Warman asserted that the respondents infringed his copyright in the article by reproducing excerpts from it on their website - He asserted that the excerpts constituted a substantial part of the article - He applied for various remedies - The respondents asserted that the application was barred by the three year limitation period set out in s. 41(1) of the Copyright Act - The Federal Court held that the application was not statute barred since Warman could not have become aware of the infringement until he obtained a license to the copyright in 2010 - Whether a substantial part of the work had been reproduced was a question of fact - The court referred to and applied the relevant factors, concluding that Warman had not established that the excerpts constituted a substantial part of the article and there was therefore no infringement - Quantitatively, the reproduction constituted less than half of the work - Qualitatively, the portions reproduced were the article's opening "hook" and the summary of the facts on which the article was based - Most of the commentary and original thought expressed by Kay was not reproduced - Most of the other facts were not directly relevant as Warman was not using the subject matter of the copyright in the sense of reproducing or publishing it - The respondents had not reproduced the excerpts to save time and effort, but to preserve a record of the facts summarized in the article so that members of their online forum could continue to discuss those facts on the forum - Alternatively, the excerpts constituted fair dealing for the purposes of news reporting (s. 29.2) - See paragraphs 22 to 35.

Limitation of Actions - Topic 4408

Statutory causes of action - Copyright infringement - Warman asserted that the respondents infringed his copyright in a speech authored by him in July 2005 - The copyright was registered on February 18, 2011 - Warman discovered that the speech had been reproduced on the respondents' website in September 2007 - The respondents acknowledged that the speech was uploaded to their website at that time - The Federal Court held that Warman had established a prima facie infringement of his copyright, however he was precluded from obtaining a remedy where his application was not commenced within three years of his discovering the infringement (Copyright Act, s. 41(1)) - Warman asserted that the s. 41(1) limitation period did not apply to injunctive relief because of the equitable nature of that relief (*Milliken & Co. v. Interface Flooring Systems (Canada) Inc.* (F.C.T.D., 1996) - The only cases cited in *Milliken* dated back to the 1920's - Recent cases, including those in which an injunction was sought, had applied the limitation period and denied any remedy - It was unclear if the parties in those cases had argued that injunctive relief was available outside the limitation period - Even if s. 41(1) did not preclude the granting of injunctive relief, it at the very least informed the exercise of the court's discretion to grant an injunction for copyright infringement - It would be contrary to Parliament's intent to find that an injunction was presumptively available for an infringement if the application was brought outside the three year period - It was more consistent with the Act, for the court to limit the exercise of its discretion to

grant an injunction to circumstances where it would have some practical effect and the balance of convenience strongly favoured granting the injunction - Here, Warman had not established that an injunction was necessary to prevent further infringement - Rather, the respondents had removed the speech from their server and the physical copies that they retained were for the purpose of defending a defamation action that Warman had brought against them - See paragraphs 11 to 22.

Limitation of Actions - Topic 9305

Postponement or suspension of statute - General - Discoverability rule - An article authored by Kay and published in the National Post was highly critical of Warman - Warman obtained an exclusive license to the copyright in the article through an agreement with the National Post on January 13, 2010 - He registered the copyright on March 10, 2011 - Warman asserted that the respondents infringed his copyright in the article by reproducing excerpts from it on their website - He asserted that the excerpts constituted a substantial part of the article - He applied for various remedies - The respondents asserted that the application was barred by the three year limitation period set out in s. 41(1) of the Copyright Act - The Federal Court held that the application was not statute barred since Warman could not have become aware of the infringement until he obtained a license to the copyright in 2010 - Whether a substantial part of the work had been reproduced was a question of fact - The court referred to and applied the relevant factors, concluding that Warman had not established that the excerpts constituted a substantial part of the article and there was therefore no infringement - Quantitatively, the reproduction constituted less than half of the work - Qualitatively, the portions reproduced were the article's opening "hook" and the summary of the facts on which the article was based - Most of the commentary and original thought expressed by Kay was not reproduced - Most of the other facts were not directly relevant as Warman was not using the subject matter of the copyright in the sense of reproducing or publishing it - The respondents had not reproduced the excerpts to save time and effort, but to preserve a record of the facts summarized in the article so that members of their online forum could continue to discuss those facts on the forum - Alternatively, the excerpts constituted fair dealing for the purposes of news reporting (s. 29.2) - See paragraphs 22 to 35.