

Federal Court



Cour fédérale

Date: 20161130

Docket: T-428-13

Citation: 2016 FC 1313

Ottawa, Ontario, November 30, 2016

PRESENT: The Honourable Mr. Justice Southcott

BETWEEN:

DANIEL DAVYDIUK

Plaintiff

and

**INTERNET ARCHIVE CANADA AND
INTERNET ARCHIVE**

Defendants

ORDER AND REASONS

SOUTHCOTT J.

I. Overview

[1] These Reasons relate to two motions, heard by the Court in Toronto on November 1, 2016, in the within action for copyright infringement.

[2] The Plaintiff claims to be the owner of the copyright in certain cinematographic works and unfixed performances described in his original Statement of Claim. He seeks leave to amend his Statement of Claim to add express references to a claim for ownership of the copyright in photographs, images and audiovisual recordings created in the production of these works and performances.

[1] The other motion is brought by the Defendants for summary judgment, seeking an Order dismissing the Plaintiff's claim.

[2] For the reasons that follow, each of the motions is allowed in part. As explained in greater detail below, the Plaintiff is granted leave to amend his Statement of Claim as it relates to the works, but not the performances. The Defendants are granted summary judgment and dismissal of the Plaintiff's claim as it relates to the performances, but not to the works.

II. Background

[3] In 2002 and 2003 the Plaintiff, Daniel Davydiuk, performed in two pornographic videos and a series of unfixed performances broadcast live over the internet. In 2003, Mr. Davydiuk decided that he no longer wanted to be associated with the pornography industry and undertook to secure the copyright in the videos so that he could ensure their permanent deletion. The videos were produced by a company located in Montreal called Intercan Media Design Inc. [Intercan]. By a written assignment dated May 22, 2009, Mr. Davydiuk acquired from Intercan the worldwide copyright in the videos and all related material including images and photographs, and Intercan agreed to remove them from their websites and delete all copies in their possession.

[4] In 2009, Mr. Davydiuk discovered that the Defendant, Internet Archive, was hosting some of this material as part of its web archive collection. Internet Archive is a California-based non-profit digital library that operates a service called the Wayback Machine, which preserves publicly available internet sites in a free, searchable archive. The other Defendant, Internet Archive Canada, is a non-profit organization based at the University of Toronto, which scans books for this archive. As the distinctions between the respective roles of the two Defendants are not relevant to the issues and arguments raised in the present motions, these Reasons will refer to the Defendants collectively as “Internet Archive”.

[5] Mr. Davydiuk or his agents sent to Internet Archive a number of requests that certain webpages he identified be removed or excluded from their archive. These requests included notices under the *Digital Millenium Copyright Act* of the United States, asserting copyright infringement and identifying the copyrighted work alleged to have been infringed and the infringing web page. Mr. Davydiuk says that Internet Archive advised him in 2009 that the material he had identified had been taken down from their websites and removed from their collections. However, he discovered in 2011 that Internet Archive was running a new version of one of its archiving websites and that this material was being displayed there.

[6] Mr. Davydiuk subsequently retained counsel, and his counsel and agents pursued further efforts on his behalf to have the material in which he asserted a copyright interest removed from Internet Archive’s Wayback Machine. On March 8, 2013, Mr. Davydiuk filed his Statement of Claim in this matter, alleging copyright infringement by Internet Archive and their commission of acts prohibited under sections 15 and 27(2) of the *Copyright Act*, RSC 1985, c C-42 [the Act].

The Statement of Claim identifies the alleged infringement as including reproduction of Mr. Davydiuk's copyrighted material on webpages identified through a list of URLs appended at Schedule "A" to the Statement of Claim.

[7] Internet Archive admits that there were occasional errors in the process by which they blocked access to the webpages identified by Mr. Davydiuk. However, the affidavit evidence of their Office Manager, Christopher Butler, is that not all of the webpages listed at Schedule "A" to the Statement of Claim were owned, operated or controlled by Internet Archive. He also states that, of those webpages which were controlled by Internet Archive [referred to as the Pages Complained of], all had been blocked from access, and the majority had been deleted, prior to the filing of the Statement of Claim on March 8, 2013, and the remainder had been deleted by July 2013.

[8] On October 18, 2013, Internet Archive brought a motion challenging the Court's jurisdiction to hear this action. Prothonotary Aalto dismissed that motion on November 27, 2013. Internet Archive appealed, and Justice McVeigh dismissed the appeal on October 6, 2014.

[9] Internet Archive then filed its Statement of Defence on December 16, 2014, the parties exchanged Affidavits of Documents, and Mr. Davydiuk was examined for discovery on December 7, 2015. During his discovery examination, Internet Archive's counsel raised the issue whether his claims in this action covered photographs taken during the filming of the videos to which the action relates, and Mr. Davydiuk expressed that this was his intention.

[10] On June 30, 2016, Mr. Davydiuk brought the present motion for leave to amend the Statement of Claim. Paragraph 1(a) of the Statement of Claim describes the material in which Mr. Davydiuk claims ownership of the copyright, defining that material as “Works” and “Performances”. His proposed amendment seeks to add language to that paragraph. Paragraph 1(a), with the proposed amendments underlined, reads as follows:

1. The Plaintiff claims:

(a) a declaration that the Plaintiff is the owner of copyright in each of:

- (i) an original work (in the nature of a cinematographic work) entitled MARK & XANDER DUO created in 2003 and an original work (in the nature of a cinematographic work) entitled MARK SOLO created in 2002, and all photographs, images, and audiovisual recordings created during the production of same (collectively the “Works”), and
- (ii) a series of unfixed performances, performed by the Plaintiff in Canada and communicated over the Internet on a semi-weekly basis between June 2002 and September 2003, and all photographs, images, and audiovisual recordings created during the production of same (the “Performances”);

[11] Internet Archive opposes the amendment motion. It also filed the within motion for summary judgment on June 30, 2016. Based on evidence given by Mr. Davydiuk on discovery, Internet Archive argues that there is no genuine issue for trial. It takes this position regardless of whether Mr. Davydiuk succeeds in his motion to amend the Statement of Claim.

III. Issues

A. *Motion for Leave to Amend Statement of Claim*

[12] Mr. Davydiuk submits that the following are the issues raised by his motion for leave to amend the Statement of Claim:

- A. When can leave to amend be granted?
- B. Should leave be granted to amend the Statement of Claim?

[13] In its written representations filed in response to this motion, Internet Archive characterizes the issues to be considered as follows:

- A. Is it plain and obvious that the proposed amendments will fail?
- B. Will the proposed amendments cause prejudice to the Defendants that cannot be compensated with costs?

[14] Based on my analysis below of the test applicable to a motion to amend a statement of claim, I consider Internet Archive's articulation of the issues to represent the better framework within which to analyse whether Mr. Davydiuk meets the test.

B. *Motion for Summary Judgment*

[15] Internet Archive submits that its motion for summary judgment raises the following issues:

- A. Is there a genuine issue for trial with respect to whether the Plaintiff can establish infringement of the Works?
- B. Is there a genuine issue for trial with respect to whether the Plaintiff can establish infringement of the Performances?

[16] Mr. Davydiuk similarly submits that this motion raises the question whether there is a genuine issue requiring a trial.

[17] As the evidence related to alleged infringement of the Works differs significantly from that related to alleged infringement of the Performances, I will employ in my analysis below the articulation of the issues provided by Internet Archive.

IV. Analysis

A. *Motion for Leave to Amend Statement of Claim*

(1) Performances

[18] As a preliminary matter, I note that Mr. Davydiuk's counsel acknowledged at the hearing that, based on the evidence now available, none of the URLs listed in Schedule "A" represent either video or still images that infringe his copyright interest in the Performances. As such, he is not pursuing the request for leave to amend paragraph 1(a)(ii) of the Statement of Claim.

(2) Test Applicable to Motion to Amend Statement of Claim

[19] In support of his motion to amend the Statement of Claim, Mr. Davydiuk relies on Rule 75(1) of the *Federal Courts Rules*, SOR/98-106, which provides as follows:

Amendments with leave

75 (1) Subject to subsection (2) and rule 76, the Court may, on motion, at any time, allow a party to amend a document, on such terms as will protect the rights of all parties.

Modifications avec autorisation

75 (1) Sous réserve du paragraphe (2) et de la règle 76, la Cour peut à tout moment, sur requête, autoriser une partie à modifier un document, aux conditions qui permettent de protéger les droits de toutes les parties.

[20] Mr. Davydiuk also refers to the decision in *Khadr v Canada*, 2014 FC 1001 [*Khadr*], at para 6, to the effect that an amendment should be allowed at any stage of an action for the purpose of determining the real questions in controversy between the parties, provided that the amendment would not result in an injustice to the other party not capable of being compensated by costs and that it would serve the interests of justice.

[21] Mr. Davydiuk notes that even an amendment that seeks to add a new cause of action outside a limitation period can be allowed, if the new cause of action arises out of substantially the same facts as an action that was already pleaded, and if it seems just to do so (see *Francoeur v Canada*, [1992] 2 FC 333 at para 8). Internet Archive does not contest that proposition, relying on *Seanix Technology Inc. v Synnex Canada Ltd.*, 2005 FC 243, although it argues that Mr. Davydiuk's proposed amendment does raise a new cause of action which does not arise out of the same facts as originally pleaded.

[22] In relation to the assessment of injustice or prejudice to the other party, Mr. Davydiuk refers to the factors identified as follows at paragraph 6 of *Khadr*:

[6] ... Factors relevant to the prejudice assessment include the timeliness of the motion to amend, the extent to which the amendment would delay an expeditious trial, the extent to which the original position caused another party to follow a course which is not easily altered, and whether the amendment facilitates the Court's consideration of the merits of the action: *Valentino Gennarini SRL v Andromeda Navigation Inc*, 2003 FCT 567 (Fed. T.D.) at para 29 citing *Scannar Industries Inc.(Receiver of) v R.* (1994), 172 N.R. 313 (Fed. C.A.)

[23] Internet Archive refers to *Video Box Enterprises Inc. v. Lam*, 2006 FC 546, at paragraphs 6 to 9, both for the proposition that an amendment should not be allowed if there is prejudice to the opposing party that is not capable of being compensated through costs and the principle that leave to amend should be refused where it is plain and obvious that the party proposing the amendment could not succeed on it.

[24] In reliance on these authorities, I will consider the two issues raised above by Internet Archive in opposition to Mr. Davydiuk's proposed amendments.

(3) Is it plain and obvious that the proposed amendments will fail?

[25] Mr. Davydiuk wishes to amend his statement of claim to include an express reference to a claim for infringement of his copyright in photographs and images created during the production of the Works referred to in the original Statement of Claim. His affidavit evidence filed in this motion attaches copies of 50 photographs that he says were taken with a camera during the

filming of the video entitled MARK SOLO and 17 images which his counsel acknowledged in argument are screenshots taken from the video entitled MARK & XANDER DUO.

[26] Mr. Davydiuk takes the position that the proposed amendments are really just a clarification of the original pleading, which already implicitly captured an assertion of his copyright interest in photographs and images. He seeks the amendment in response to the issue raised by Internet Archive's counsel during his discovery examination, to the effect that the copyright interest he pleaded in the original statement of claim related only to cinematographic works and performances and not to photographs or images. The evidence is that most or all of the alleged reproductions contained on the Pages Complained Of are still images or photographs, not video. As will be explained in the below analysis of the summary judgment motion, Internet Archive takes the position that still images and photographs cannot represent substantial reproductions of the videos in which Mr. Davydiuk asserts a copyright interest, so as to represent an infringement under the Act. Mr. Davydiuk therefore seeks the amendment, at least in part, in response to Internet Archive's position that his claim as originally pleaded does not raise a genuine issue for trial.

[27] While Internet Archive did not advance this point in oral argument, its written submissions argue that the proposed amendments raise a new cause of action which is statute barred, referring to the three-year limitation period under section 43.1 of the Act. Under that section, the limitation period commences at the latest at the time when the plaintiff first knew, or could reasonably have been expected to know, of the act or omission for which a remedy is claimed. Internet Archive argues that Mr. Davydiuk has been aware of the material facts to

which the proposed amendments relate since 2009, such that the three-year limitation period has expired.

[28] Mr. Davydiuk’s position is that the amendments do not raise a new cause of action. He argues that it is clear that the allegations in the original Statement of Claim related not just to video but also to photographs and images, because many of the URLs listed in Schedule “A” end with the suffix “jpg”, which refers to image files.

[29] The difficulty with Mr. Davydiuk’s argument is that it conflates the allegations in the Statement of Claim as to the material in which he asserts copyright interests with the allegations as to the actions of Internet Archive which are asserted to represent an infringement of such interests. Paragraphs 3 to 7 assert Mr. Davydiuk’s ownership of copyright in the Works, which term is defined in paragraph 1(a) of the Statement of Claim. That paragraph, set out earlier in these reasons, defines the Works as being in the nature of cinematographic works.

[30] Internet Archive refers the Court to the definition of “cinematographic work” as found in section 2 of the Act. While the Statement of Claim does not expressly indicate an intention that statutory definitions apply to terms used therein, I consider such definitions to represent a useful interpretive tool. Section 2 provides the following relevant definitions:

artistic work includes paintings, drawings, maps, charts, plans, photographs, engravings, sculptures, works of artistic craftsmanship, architectural works, and compilations of artistic works; (emphasis added)

oeuvre artistique Sont compris parmi les oeuvres artistiques les peintures, dessins, sculptures, oeuvres architecturales, gravures ou photographies, les oeuvres artistiques dues à des artisans ainsi que les graphiques,

cartes, plans et compilations
d'oeuvres artistiques.

cinematographic work
includes any work expressed
by any process analogous to
cinematography, whether or
not accompanied by a
soundtrack;

oeuvre cinématographique Y
est assimilée toute œuvre
exprimée par un procédé
analogue à la cinématographie,
qu'elle soit accompagnée ou
non d'une bande sonore.

dramatic work includes
(a) any piece for recitation,
choreographic work or mime,
the scenic arrangement or
acting form of which is fixed
in writing or otherwise,
(b) any cinematographic work,
and (c) any compilation of
dramatic works;
(emphasis added)

oeuvre dramatique Y sont
assimilées les pièces pouvant
être récitées, les oeuvres
chorégraphiques ou les
pantomimes dont
l'arrangement scénique ou la
mise en scène est fixé par écrit
ou autrement, les oeuvres
cinématographiques et les
compilations d'oeuvres
dramatiques. (emphase ajouté)

[31] Internet Archive also notes that section 5 of the Act provides that, subject to other requirements of the Act, copyright subsists in Canada in "... every original literary, dramatic, musical and artistic work...". The effect of these statutory provisions is a distinction between a "dramatic work" (which includes a "cinematographic work") and an "artistic work" (which includes "photographs"). It is also apparent that the definition of "cinematographic work" does not easily encompass photographs or still images.

[32] It is therefore my conclusion that the term "Works" as employed in the Statement of Claim does not include photographs or still images.

[33] Turning to Schedule "A", while I accept that many of the URLs identified therein have ".jpg" suffixes and therefore refer to images, Schedule "A" is referenced in paragraph 15 of the

Statement of Claim, which asserts particulars of webpages that Mr. Davydiuk alleges to represent reproductions, fixations and public communications by Internet Archive of the Works as defined in the Statement of Claim. That is, Schedule “A” identifies the allegedly infringing reproductions, not the Works the copyright in which is allegedly infringed. Therefore, Schedule “A” does not assist Mr. Davydiuk in arguing that the original pleading asserted ownership of copyright in photographs and images and that the requested amendment is just a clarification or particularization of the claim.

[34] It is therefore necessary to address Internet Archive’s argument that the requested amendment raises a new cause of action which is statute barred. As noted above, such an amendment can be allowed notwithstanding the limitation period if the new cause of action arises out of substantially the same facts as an action that was already pleaded, and if it seems just to do so.

[35] I find that the cause of action raised by the proposed amendment does arise out of substantially the same facts as the action as originally pleaded. The amendment relates to the assertion of a copyright interest in photographs and still images created during the production of the two cinematographic works in which Mr. Davydiuk asserts copyright ownership in the original Statement of Claim. The webpages allegedly hosted by Internet Archive, which allegedly infringe Mr. Davydiuk’s copyright, are the same as originally pleaded. Mr. Davydiuk also correctly points out that his correspondence with Internet Archive dating back to 2009 clearly relates to alleged infringement of copyright in both videos and photographs, such that the

allegations represented by the proposed amendment have been the subject of communications between the parties for some time.

[36] I therefore do not find the potential application of a limitation period to preclude granting leave for the amendment. It remains necessary to consider whether it is just to do so, which I assess below through an analysis of the prejudice alleged by Internet Archive. However, I must first consider another argument raised by Internet Archive as to why it is plain and obvious that the proposed amendment will fail.

[37] Internet Archive argues that, to the extent the proposed amendment contemplates a claim that the photographs and images created during the production of the two videos are capable of independent copyright protection, this claim must fail because the photographs and images do not satisfy the requirement for originality necessary to attract such protection. Under section 5 of the Act, it is “original” works to which copyright protection applies. Internet Archive refers to the following explanation of this requirement for originality provided by the Supreme Court of Canada in *CCH Canadian Ltd. v Law Society of Upper Canada*, [2004] 1 SCR 339 [*CCH*], at para 16:

16 I conclude that 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 judgment. 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 be characterized as a purely mechanical exercise. For example, any skill and judgment that might be involved in simply changing the font of a work to produce “another” work would be too trivial to merit copyright protection as an “original” work.

[38] With respect to the 50 photographs related to the MARK SOLO video, which Mr. Davydiuk has produced in support of his motion, Internet Archive submits that these are not the original photographs taken during the video shoot. Mr. Davydiuk’s evidence is that, in the course of his negotiations with Intercan, that company permitted him access to its server and he downloaded the files for these photographs, hard copies of which are attached his affidavit. However, Internet Archive’s position is that, without production of the original digital images or evidence from the photographer who Mr. Davydiuk says took these photographs, it is not possible to assess the skill and judgment employed in creating the photographs and therefore their originality.

[39] With respect to the 17 screenshots related to the MARK & XANDER DUO video, Internet Archive argues that the claim for copyright protection is even more untenable, as the extraction of these images from the video represents a purely mechanical exercise not capable of copyright protection under the principles explained in *CCH*.

[40] Mr. Davydiuk responds that both the photographer’s decisions in operation of the camera during the filming of the MARK SOLO video, and the decisions taken in selecting which screenshots to extract from the MARK & XANDER DUO video, represent exercises of skill and judgment sufficient to satisfy the originality requirement for copyright protection to apply to these photographs and images.

[41] Internet Archive advances similar arguments in support of its motion for summary judgment, which will be considered below in the context of the test applicable to that motion and the resulting evidentiary burden upon Mr. Davydiuk. However, for purposes of the motion to amend the Statement of Claim, while the arguments raised by Internet Archive in relation to the originality of the photographs and images may be asserted in defence of the claim represented by the amendments, I do not consider these arguments to demonstrate that it is plain and obvious that such a claim must fail. Subject to the outcome of the summary judgment motion, these are arguments to be assessed with the benefit of the evidence adduced at trial following completion of pretrial production and discovery processes.

- (4) Will the proposed amendments cause prejudice to the Defendants that cannot be compensated with costs?

[42] Referencing the factors identified in *Khadr* as relevant to the assessment of prejudice, Mr. Davydiuk argues that his motion for amendment is timely, having been brought immediately following identification at his discovery examination of the issue precipitating the amendment. He also argues that there is no evidence the amendment will delay the progress of this case to trial and that the amendment facilitates the Court's consideration of the merits of the action, because it allows for consideration of the entirety of his copyright claims arising from the material generated in the production of the videos in 2002 and 2003. I agree that these factors favour Mr. Davydiuk.

[43] The factor requiring more detailed analysis is the extent to which Internet Archive has followed a course of action which cannot be altered, which I consider to be the factor most relevant to the assessment of prejudice as it has been asserted by the Defendants. Internet Archive states that it has been prejudiced by its decision to delete the Pages Complained Of, which has resulted in a loss of evidence relevant to its defence of Mr. Davydiuk's action. It argues that it performed these deletions at Mr. Davydiuk's request and in reliance on the pleadings as originally framed.

[44] In support of its position on this issue, Internet Archive relies on Mr. Butler's affidavit evidence which states that, with the Pages Complained Of having been deleted, Internet Archive now cannot establish certain information related to those webpages. He refers to the following examples of information that is no longer available:

- A. identification of filenames or extensions that might establish the provenance of certain images;
- B. access to metadata that might identify the author, date and equipment used to capture certain images;
- C. determination of the native resolution of the images, so as to determine whether they are full or partial reproductions of the original file; and
- D. determination of the contents of certain sites' "robots.txt" files, which a website operator places on a website in order to tell automated indexing software (the "crawlers" used by search engines and the Internet Archive) whether or not to scan the site.

[45] Mr. Butler's affidavit also states that, with the passage of time, the operators of the various websites identified in the claim may have changed or disappeared, such that their evidence may no longer be available.

[46] In oral submissions, Internet Archive places particular emphasis on the loss of the "robots.txt" files, explaining that, under industry-standard search engine protocols, it is these files which allow website owners to exclude access to "crawlers". Internet Archive argues that, in the absence of such exclusion, it would be in a position to argue that it has an implied license to crawl such sites.

[47] Internet Archive also emphasizes that Mr. Butler has not been cross-examined on his assertions of prejudice resulting from the deletion of the Pages Complained Of. However, Mr. Davydiuk points out that Mr. Butler was cross-examined on the nature of such deletion. Mr. Butler explained that the deletion is from the Wayback Machine's index, taking away the Wayback Machine's ability to find these files in its servers, but that there was not a practical way to physically remove the files directly. He also testified that Internet Archive has not tried to recover any of the files that have been deleted from the index. When asked about the distinction between exclusion (another method by which Internet Archive responded to Mr. Davydiuk's requests) and deletion, Mr. Butler explained that exclusion prevents the Wayback Machine from accessing the URL in the index, whereas deletion removes any reference to that URL from the index. He testified that it is much easier to include back in the index a previously excluded site than to recover files that were deleted from the index. Mr. Davydiuk accordingly submits that the Pages Complained Of still exist on Internet Archive's servers and that the evidence does not

establish that they cannot be recovered. I agree with Mr. Davydiuk's characterization of the evidence.

[48] I also note Mr. Davydiuk's argument that his requests of Internet Archive were intended to achieve removal of the Pages Complained Of, so that they would not be accessible to the public. He argues they were not requests that Internet Archive eliminate evidence relevant to this litigation, which result Mr. Davydiuk submits is potentially prejudicial to his ability to establish his claim. In response, Internet Archive points out that Mr. Davydiuk requested the permanent deletion of all reproductions for the Works.

[49] I would be reluctant to conclude that Internet Archive can rely on Mr. Davydiuk's requests as a basis for eliminating evidence relevant to the issues in this litigation, particularly after the litigation has commenced. In that respect, I note that the webpages that were deleted from the Wayback Machine's index, the majority before commencement of Mr. Davydiuk's action in March 2013 and the remainder by July 2013, are among those listed in Schedule "A" to the Statement of Claim, which are the pages identified in the action as infringing Mr. Davydiuk's copyright interests. Internet Archive says that it relied to its detriment on the pleadings as originally framed when it complied with Mr. Davydiuk's request and deleted the remainder of the webpages between March 2013 and July 2013. Its argument is that it was comfortable deleting these webpages because they contained no video, only still images and text, and it therefore considered them to have little relevance to Mr. Davydiuk's claims for infringement of copyright in the two videos. However, regardless of how confident Internet Archive may have been in its defence position, I have difficulty accepting that it relied on this confidence, and

therefore on the pleadings as originally framed, in deciding to deprive itself of access to the webpages that the original Statement of Claim expressly identified as representing the alleged copyright infringement.

[50] I therefore find that Internet Archive has not established prejudice resulting from the proposed amendment that should preclude the Court granting the requested leave. Internet Archive has argued in the alternative that, if the Plaintiff's motion is granted, the resulting Order should require the Plaintiff to particularize the alleged photographs, images, and audiovisual recordings, including original creators and dates of creation, as well as to produce original copies of same. Mr. Davydiuk argues that there are no grounds for this relief. I concur, as the Rules impose obligations upon Mr. Davydiuk, and afford rights to Internet Archive, through which any requirements for particulars and/or production can be addressed. If the parties encounter difficulties in connection with compliance with these Rules, relief can then be sought in the particular context of such difficulties.

[51] My Order will therefore grant leave to the Plaintiff to amend paragraph 1(a)(i) of the Statement of Claim as requested.

B. *Motion for Summary Judgment*

(1) Test Applicable to Motion for Summary Judgment

[52] Internet Archive relies on Rule 215(1), which states:

If no genuine issue for trial

215 (1) If on a motion for summary judgment the Court is satisfied that there is no genuine issue for trial with respect to a claim or defence, the Court shall grant summary judgment accordingly.

Absence de véritable question litigieuse

215 (1) Si, par suite d'une requête en jugement sommaire, la Cour est convaincue qu'il n'existe pas de véritable question litigieuse quant à une déclaration ou à une défense, elle rend un jugement sommaire en conséquence.

[53] Internet Archive refers to the articulation of the test, for whether there is a genuine issue for trial, by the Supreme Court of Canada in *Hryniak v Mauldin*, [2014] 1 SCR 87 [*Hryniak*], where the Court held as follows at para 49:

[49] There will be no genuine issue requiring a trial when the judge is able to reach a fair and just determination on the merits on a motion for summary judgment. This will be the case when the process (1) allows the judge to make the necessary findings of fact, (2) allows the judge to apply the law to the facts, and (3) is a proportionate, more expeditious and less expensive means to achieve a just result.

[54] Referencing *Granville Shipping Co. v Pegasus Lines Ltd*, [1996] 2 FC 853 (TD), at para 8, Internet Archive submits that it is not required to show that Mr. Davydiuk's case is impossible. Rather, the inquiry is "whether the case is so doubtful that it does not deserve consideration by the trier of fact at a future trial."

[55] Mr. Davydiuk does not take issue with Internet Archive's reliance on these authorities, and I accept that they correctly articulate the relevant test. I note that the Federal Court of Appeal

has also recently commented on the test for summary judgment, and in particular on the applicable legal and evidentiary burdens, in *Collins v Canada*, 2015 FCA 281, at paragraph 71:

[71] Some additional light can be shed upon this test by the Ontario Court of Appeal decision in *Dawson v. Rexcraft Storage & Warehouse Inc.* (1998), 1998 CanLII 4831 (ON CA), 111 O.A.C. 201, 164 D.L.R. (4th) 257 [*Dawson*]. This case was decided at a time when the summary judgment provisions of the Ontario *Rules of Civil Procedure*, R.R.O. 1990, Reg. 194 were essentially the same as Rule 215 of the *Federal Courts Rules* and, as such, it provides useful guidance. At paragraphs 17 and 18, Justice Borins stated:

[17] At the summary judgment stage, the court wants to see what evidence the parties have to put before the trial judge, or jury, if a trial is held. Although the onus is on the moving party to establish the absence of a genuine issue for trial, as rule 20.04(1) requires, there is an evidentiary burden on the responding party who may not rest on the allegations or denials in the party's pleadings, but must present by way of affidavit, or other evidence, specific facts showing that there is a genuine issue for trial. The motions judge is entitled to assume that the record contains all the evidence which the parties will present if there is a trial. See *Rogers Cable T.V. Ltd. v. 373041 Ontario Ltd.* (1994), 1994 CanLII 7367 (ON SC), 22 O.R. (3d) 25 (Gen. Div.), and the cases cited therein.

[18] The caselaw and the experience of this court suggest that motions judges frequently encounter difficulty in the analytical exercise of determining whether the record demonstrates that there is no genuine issue in respect to a material fact which requires resolution by a trial judge or jury. In this regard, it is helpful to emphasize that the dispute must center on a material fact, and that it must be genuine: *Irving Ungerman Ltd. v. Galanis* (1991), 1991 CanLII 7275 (ON CA), 4 O.R. (3d) 545 (C.A.); *Rogers Cable T.V. Ltd.*, *supra*; *Royal Bank of Canada v. Feldman* (1995), 1995 CanLII 7060 (ON SC), 23 O.R. (3d) 798 (Gen. Div.), appeal quashed (1995), 1995 CanLII 8962 (ON CA), 27 O.R. (3d) 322 (C.A.); *Blackburn v. Lapkin* (1996),

1996 CanLII 7973 (ON SC), 28 O.R. (3d) 292
(Gen. Div.).

[Emphasis added]

- (2) Is there a genuine issue for trial with respect to whether the Plaintiff can establish infringement of the Performances?

[56] I address this issue first, as the evidence and the acknowledgements by Mr. Davydiuk’s counsel at the hearing dictate that the Defendants’ motion for summary judgment should succeed in relation to Mr. Davydiuk’s claims related to infringement of his copyright in the Performances.

[57] As noted above, Mr. Davydiuk’s counsel acknowledged at the hearing that, based on the evidence now available, none of the URLs listed in Schedule “A” represent either video or still images that infringe his copyright interest in the Performances. I therefore find that there is no genuine issue for trial with respect to whether the Plaintiff can establish infringement in relation to the Performances. My Order will therefore dismiss the claim as it relates to the Performances.

- (3) Is there a genuine issue for trial with respect to whether the Plaintiff can establish infringement of the Works?

[58] Relying on *Waldman v Thomson Reuters Corporation*, 2012 ONSC 1138 (leave to appeal refused, 2012 ONSC 3436), Internet Archive submits that, in order to succeed in his action for copyright infringement, Mr. Davydiuk must establish that: (a) copyright subsists in a particular

work; (b) he holds copyright in that work; (c) Internet Archive has done something with the work that is reserved for the copyright holder; and (d) Internet Archive did not have his consent.

[59] Internet Archive’s Memorandum of Fact and Law submits that there are three reasons why there is no genuine issue for trial with respect to the Works. First, without copies of the original Works, Mr. Davydiuk cannot meet his burden in this action of establishing that copyright protection applies to the Works. Second, without being able to show the Court an original copyrighted work, Mr. Davydiuk cannot adduce evidence necessary to conduct the comparative analysis to show that Internet Archive has reproduced the Works in whole or substantial part. Internet Archive notes that section 3(1) of the Act defines copyright as including “the sole right to produce or reproduce the work or any substantial part thereof in any material form whatever, to perform the work or any substantial part thereof in public or, if the work is unpublished, to publish the work or any substantial part thereof” (emphasis added). Third, Internet Archive argues that photographs and still images (which are the allegedly infringing reproductions) are not capable of amounting to a “substantial” reproduction of the videos for which Mr. Davydiuk claims copyright protection.

[60] In oral argument, in recognition that the Court had not yet decided whether to allow the requested amendment to the Statement of Claim, Internet Archive also presented its argument as to why there would still be no genuine issue for trial if the amendment was allowed. This argument focused on whether the photographs and still images, that Mr. Davydiuk alleges are reproduced on Internet Archive’s websites, represent infringement of the copyright that Mr. Davydiuk claims in the photographs and images created during the production of the videos.

Noting again that the allegedly infringing webpages have been deleted from the Wayback Machine's index at his request, Internet Archive's position is that Mr. Davydiuk has not met his burden to adduce in this motion evidence of Internet Archive infringing the copyright he claims in the photographs and images.

[61] I will address first the arguments that, without copies of the original Works, Mr. Davydiuk cannot meet his burden in this action to establish that copyright protection applies or to conduct the comparative analysis to show that Internet Archive has reproduced the Works in whole or substantial part. Internet Archive refers to Mr. Davydiuk's discovery evidence that he did have VHS copies of the two videos but that he discarded them in 2003. He testified that he was not aware of anywhere that a copy of either video could be obtained. However Mr. Davydiuk has since produced a copy of the MARK SOLO video, composed of six video clips, which he says were downloaded from Intercan's server. It appears to remain his evidence that no copy of the MARK & XANDER DUO video is available.

[62] Internet Archive therefore asserts this argument principally in relation to alleged infringement of the MARK & XANDER DUO video. It submits that, without any copy of this video available to present to the Court at trial, Mr. Davydiuk will not be able to establish that this work is the product of skill and judgment and therefore meets the originality requirement necessary to attract copyright protection. Nor can the Court conduct the comparative analysis necessary to establish reproduction in whole or substantial part.

[63] Mr. Davydiuk responds that there is no authority to support Internet Archive's propositions that a party who asserts that copyright subsists in a work and has been infringed is incapable of succeeding in this assertion without producing an original of the work. He refers to the decision of the Northwest Territories Supreme Court in *Carte v Dennis*, 1901 CarswellNWT 13, which addressed a claim for copyright infringement of a comic opera, in which the plaintiff did not file an original copy of the opera but relied on witnesses who could attest to the similarity between the original work and the allegedly infringing work. The Court in turn relied on *Lucas v Williams* (1892), 2Q. B. 113, a case involving an action for infringement of copyright in a painting in which the original picture was not produced in evidence, and concluded at paragraph 38 that it is not necessary in every case to produce the original of the work in which copyright is asserted.

[64] Internet Archive points out that this case was decided in a very different context and a very different era. However, it has cited no authority particularly on point in support of its arguments to the contrary. I see no basis either in law or logic to conclude that production of a copy of the original work is an absolute prerequisite to success in establishing either subsistence of copyright in the work or that a reproduction of the work represents a sufficiently substantial reproduction to constitute infringement.

[65] I reach the same conclusion with respect to Internet Archive's submission that, without production of the original digital images of the 50 MARK SOLO photographs, or evidence from the photographer, it is not possible to assess the skill and judgment employed in creating these photographs and therefore their originality and capability of copyright protection. I recognize the

evidentiary burden upon a party responding to a summary judgment motion to present by way of affidavit, or other evidence, specific facts showing that there is a genuine issue for trial.

However, Mr. Davydiuk has deposed in his affidavit evidence that the MARK SOLO video was captured with a video camera at Intercan's offices and that, during the filming, a Mr. Duncan operated a camera that was used to create a series of photographs to be packaged along with the video that was filmed. Internet Archive may argue at trial that the photographer's role does not represent a sufficient exercise of skill and judgment to confer copyright protection upon the resulting photographs. However, I find Mr. Davydiuk's evidence, as to the circumstances in which the photographs were taken, to be sufficient to discharge his evidentiary burden to show that his claim for copyright protection represents a genuine issue for trial.

[66] I also reach this conclusion with respect to Internet Archive's submission that the extraction of the 17 screenshots from the MARK & XANDER DUO video represents a purely mechanical exercise, not capable of copyright protection under the principles explained in *CCH*. Mr. Davydiuk's affidavit evidence explained the circumstances in which the video was created and that the purpose of creating the images was to entice customers to purchase the video on VHS or DVD, as the technology of the time was such that many people did not have high-speed internet connections and could access online only photographs but not streaming video. He submits that the decision as to which particular screenshots were taken from the video represents an exercise of skill and judgment capable of supporting copyright protection. I find these arguments sufficiently compelling that the Defendants have not satisfied me there is no genuine issue for trial surrounding the claim for copyright protection of these images.

[67] Turning to the argument that that the photographs and still images are not capable of amounting to a substantial reproduction of the videos, Internet Archive submits that, as a matter of law, photographs and images which represent artistic works cannot represent reproduction and therefore infringement of videos which are cinematographic and dramatic works. Internet Archive also notes the evidence that the MARK SOLO video has a running time of approximately 8 minutes and 45 seconds and that the MARK & XANDER DUO video ran approximately one hour and 14 minutes. It therefore submits that 50 photographs and 17 screenshot images represent a sufficiently small sample of the content captured in the videos that they cannot constitute substantial reproductions of the videos.

[68] In support of this latter position, Internet Archive relies on the decision by the Copyright Board of Canada in *Collective Administration of Performing Rights and of Communication Rights (Re)*, [2009] C.B.D. No. 4, which considered allegations that various satellite radio services were engaged in unauthorized reproductions of copyrighted songs. The alleged reproduction involved the use of a “buffer” in the satellite devices that held a copy, at any given time, of 4 to 10 seconds of the song being streamed over the service. The Copyright Board found that these 4 to 10 seconds were not “substantial” reproductions of the copyrighted songs. The decision was appealed to the Federal Court of Appeal, which confirmed the reasonableness of the Board’s conclusion (see *Sirius Canada Inc. v CMRRA/SODRAC Inc.*, 2010 FCA 348, at paras 50-52).

[69] In contrast, Mr. Davydiuk refers to the decision of the British Columbia Supreme Court in *Century 21 Canada Ltd. Partnership v Rogers Communications Inc.*, 2011 BCSC 1196, which

referred at paragraph 184 to authority for the principle that whether a substantial part of a work has been reproduced depends much more on the quality than on the quantity of what has been copied. That case also noted at paragraph 194 the decision in *Hawkes & Son (London) Ltd. v Paramount Film Service Ltd.*, [1934] Ch. 593 (Eng. C.A.), which considered a film that had reproduced 20 seconds of the 4 minute long “Colonel Bogie March”. The English Court of Appeal held that the portion reproduced was clearly recognizable as the Colonel Bogie March and that what was reproduced was “a substantial, vital, and an essential part”, noting that matters beyond quantity have to be considered.

[70] Mr. Davydiuk accordingly argues that the appropriate analysis must include whether a vital and essential part of the copyrighted work has been reproduced, that this is a qualitative rather than quantitative exercise, and that particular photographs and still images can therefore represent substantial reproductions of a cinematographic work.

[71] Internet Archive acknowledges that the analysis is not a purely mathematical exercise, and I accept that the authorities support the proposition that a qualitative assessment must form part of the analysis comparing the copyrighted work with the allegedly infringing work. Moreover, this analysis is necessarily a contextual exercise, highly dependent upon the facts of each individual case, which I consider to preclude a finding as a matter of law in this summary judgment motion that photographs and still images are incapable of infringing the copyright in a cinematographic work. The requirement for such an analysis also precludes a finding that there is no genuine issue for trial based on the quantitative comparison of the amount of material represented by the photographs and images to the length of the videos. I find that the question

whether the photographs and images hosted on Internet Archive's websites infringe Mr. Davydiuk's alleged copyright in the videos does represent a genuine issue for trial in this matter.

[72] Finally, I have considered the argument that Mr. Davydiuk has not met his burden to adduce in this motion evidence of Internet Archive infringing the copyright he claims in the photographs and images. In response to this argument, Mr. Davydiuk submits that, notwithstanding Internet Archive's position that information available from the deleted Pages Complained Of may no longer be available, he can pursue his action in reliance on screenshots of such webpages which are included in the productions he made through his Affidavit of Documents in this matter. The body of his Affidavit of Documents has been filed in this motion and lists by URL a number of webpages which appear to relate to domains hosted by Internet Archive, although copies of these documents themselves have not been filed.

[73] For purposes of responding to the motion for summary judgment, Mr. Davydiuk also relies on paragraphs in his affidavit in which he deposes that in or around March 2009 he used several digital image tracking tools to determine if the pornographic works in which he had performed were being hosted on any websites other than those of Intercan. He states that he thereby identified that these works were being hosted on Internet Archive's website and that Internet Archive had taken Intercan's webpages and re-created them for use on its own websites, making these works part of their web archive collection.

[74] Mr. Davydiuk might have had a better evidentiary foundation to respond to Internet Archive's argument if he had filed copies of the webpages that he says result in the infringement,

as opposed to relying on the list of pages in his Affidavit of Documents. However, his counsel noted at the hearing his understanding that the Defendants' argument in this motion was that the photographs and images cannot represent a substantial reproduction of the videos. I consider this to be a fair characterization of the relevant argument raised by Internet Archive's motion materials. In advancing its arguments that Mr. Davydiuk's claims do not raise a genuine issue for trial, Internet Archive's written materials did not advance a position that Mr. Davydiuk did not possess sufficient evidence of the allegedly infringing webpages. I am therefore not prepared to conclude that Mr. Davydiuk was fixed with an evidentiary burden to include these documents as evidence in his motion record in order to avoid a finding that there is no genuine issue for trial.

[75] My conclusion is that that the Defendants' have not met their legal burden to demonstrate that there is no genuine issue for trial with respect to whether the Plaintiff can establish infringement of the Works. This portion of the motion for summary judgment must therefore be dismissed.

V. Costs

[76] At the hearing of these motions, the parties agreed that \$5000 would be an appropriate award of costs to whichever party succeeded in the motion for amendment of the Statement of Claim and that \$10,000 would be an appropriate costs award to whichever succeeded in the summary judgment motion. However, Internet Archive also took the position that, if success in either motion was divided, no costs should be awarded on such motion. Mr. Davydiuk did not adopt this position but asked that the Court exercise its discretion as to an appropriate costs award in the event of divided success.

[77] Success on each motion has been to some extent divided, as Mr. Davydiuk has been granted leave to amend the Statement of Claim only in relation to photographs and images created during the production of the Works (not the Performances), and the motion for summary judgment has been granted in relation to infringement of the Performances but dismissed in relation to infringement of the Works. Internet Archive prevailed on both motions as they related to the Performances as a result of Mr. Davydiuk's acknowledgement at the hearing that the evidence did not support his position, which acknowledgement was warranted given the evidence in the record. However, in substance, it is the Plaintiff who has prevailed on both motions, and my assessment is that most of the written and oral submissions on these motions related to the Works rather than the Performances. As such, my decision is that costs should be awarded to Mr. Davydiuk on both motions but that such costs should be reduced from the figures that the parties had agreed should be awarded in the event of full success.

[78] I therefore award Mr. Davydiuk costs of \$2500 on the amendment motion and \$5000 on the summary judgment motion.

ORDER

THIS COURT ORDERS that:

1. The Plaintiff is granted leave to amend his Statement of Claim such that paragraph 1(a)(i) shall read as follows:
 1. The Plaintiff claims:
 - a) a declaration that the Plaintiff is the owner of copyright in each of:
 - i) an original work (in the nature of a cinematographic work) entitled MARK & XANDER DUO created in 2003 and an original work (in the nature of a cinematographic work) entitled MARK SOLO created in 2002, and all photographs, images, and audiovisual recordings created during the production of same (collectively the “Works”), and
2. The Plaintiff is awarded costs of \$2500 in his motion to amend his Statement of Claim.
3. The Plaintiff’s action is dismissed insofar as it relates to the Performances (as defined in the Statement of Claim). The Defendants’ motion for summary judgment is otherwise dismissed.
4. The Plaintiff is awarded costs of \$5000 in the Defendants’ motion for summary judgment.

“Richard F. Southcott”

Judge

FEDERAL COURT
SOLICITORS OF RECORD

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CANADA AND INTERNET ARCHIVE

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