Court File No. A-203-04
(T-292-04)

FEDERAL COURT OF APPEAL

B E T W E E N :

BMG CANADA INC., EMI MUSIC CANADA, A DIVISION OF EMI GROUP CANADA INC., SONY MUSIC ENTERTAINMENT (CANADA) INC., UNIVERSAL MUSIC CANADA INC., WARNER MUSIC CANADA LTD., BMG MUSIC, ARISTA RECORDS, INC., EMI MUSIC SWEDEN AB, CAPITOL RECORDS, INC., CHRYSALIS RECORDS LTD, VIRGIN RECORDS LTD., ZOMBA RECORDING CORPORATION, SONY MUSIC ENTERTAINMENT INC., SONY MUSIC ENTERTAINMENT (UK) INC., UMG RECORDINGS, INC., WEA INTERNATIONAL INC.

Appellants
(Plaintiffs)

- and -

JOHN DOE, JANE DOE AND ALL THOSE PERSONS WHO ARE INFRINGING COPYRIGHT IN THE PLAINTIFFS' SOUND RECORDINGS

(Defendants)

- and -

SHAW COMMUNICATIONS INC., ROGERS CABLE COMMUNICATIONS INC., BELL CANADA, TELUS COMMUNICATIONS INC., and VIDEOTRON LTEE.

Respondents
(Non-Party Respondents)

- and -

CANADIAN INTERNET POLICY AND PUBLIC INTEREST CLINIC

Intervener

MEMORANDUM OF FACT AND LAW OF THE NON-PARTY RESPONDENT ROGERS CABLE COMMUNICATIONS INC.

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MEMORANDUM OF FACT AND LAW OF THE NON-PARTY RESPONDENT ROGERS CABLE COMMUNICATIONS INC.

PART I – STATEMENT OF FACTS

Overview

1. The Appellants seek to overturn the decision of the Honourable Mr. Justice von Finckenstein, which denied the Appellants' motion for an order requiring Rogers Cable Communications Inc. ("Rogers") to disclose personal information regarding nine of its account holders.[1] Similar motions were brought, unsuccessfully, against other Internet Service Providers, specifically, Shaw Communications Inc., Bell Canada/Sympatico, Telus Communications Inc., and Videotron Ltee, and are also the subject of this appeal.

2. The Appellants' motion sought an extraordinary order, for which the Court had to be satisfied on the evidence that all prerequisites for such an order had been met. Justice von Finckenstein was not satisfied on the evidence the Appellants put before him. To succeed on this appeal, the Appellants' must demonstrate that Justice von Finckenstein made palpable and overriding errors in respect of each aspect of the test now challenged on this appeal.

3. If this Court concludes that the appeal should be allowed and an order should be made, the terms of the order sought by the Appellants are inappropriate, insofar as they extend beyond the terms of the order sought by the Appellants on the motion itself, which were, themselves, ruled over-broad by Justice von Finckenstein.

Facts

4. Rogers is an Internet Service Provider ("ISP") from which the Appellants are seeking disclosure of information and documents in connection with nine IP addresses used on specific

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[1] referred to in the Reasons for Order as customers

dates and times, as listed in Schedule "A" of the Appellants' notice of motion (the "IP addresses").

Notice of Motion, Appeal Book, Vol. I, Tab 5, p. 59

Data availability

5. In paragraphs 25 and 34 of their Memorandum of Fact and Law, among others, the Appellants wrongly suggest that Rogers has single documents that identify the Defendants, and wrongly suggest that the order sought will not cause inconvenience or expense to Rogers. On the contrary, as expressly found by Justice von Finckenstein, the process of attempting to determine whether there is any information to disclose is time-consuming and costly, requires the creation of documents not normally held by an ISP, and at best may generate the name of an account holder for an IP address, but not the actual Internet end user at any point in time.

Reasons for Order and Order of Justice von Finckenstein ("Reasons") (2004), 2004 FC 488 (F.C.T.D.), Appeal Book, Vol. I, Tab 2, para. 34

6. Contrary to the Appellants' assertions, Rogers has limited information about the IP addresses. This information does not include a record of the unique identifier put forward by the Appellants (that is, the KaZaA pseudonym), and does not match the exact dates and times for the IP addresses that are the subject of the Appellants' motion.

7. Rogers has taken steps to search for the information that could be the subject of the requested order. It was a time-consuming and resource-intensive process and put Rogers to considerable expense.

Affidavit of Andrew Ho, P. Eng., Appeal Book, Vol. IX, Tab 20, paras. 4, 7-10

8. More than four person-days of total time was spent by more than six Rogers employees in an attempt to locate information in response to the Appellants' motion. The administrative costs associated with the process of searching for information were substantial, with thousands of dollars of administrative costs incurred.

> *Affidavit of Andrew Ho, P. Eng.*, Appeal Book, Vol. IX, Tab 20, paras. 4-5

9. Ultimately, Rogers located some information about the account holders associated with eight out of the nine IP addresses. For these eight IP addresses, Rogers has a last known name and address of an account holder within about six days of the date and time sought in the Appellants' motion. However, Rogers has no records that identify the account holders associated with these eight IP addresses for the exact dates and times sought in the Appellants' motion.

> *Affidavit of Andrew Ho, P. Eng.*, Appeal Book, Vol. IX, Tab 20, paras. 4-5

10. As admitted by the Appellants, IP addresses for ISP customers can, and do, change from time to time. IP addresses are generally not permanently assigned to account holders.

> *Affidavit of Gary Millen*, Appeal Book, Vol. III, Tab 10, p. 606, para. 102

11. Rogers has no records that contain the KaZaA pseudonyms listed in the Appellants' motion material, nor any information regarding to whom those pseudonyms relate.

> *Affidavit of Andrew Ho, P. Eng.*, Appeal Book, Vol. IX, Tab 20, paras. 4-5

12. Additionally, Rogers does not have any information that confirms that the account holders are the end users who engaged in the activities that are the subject of the Appellants' claim.

Affidavit of Andrew Ho, P. Eng., Appeal Book, Vol. IX, Tab 20, paras. 4-5

13. Rogers has no information about any account holder associated with the ninth IP address (the proposed defendant who is identified by the Appellants with the KaZaA pseudonym "mr_socks@KaZaA"). That IP address relates to a specific type of modem, for which the requested data was not available for the relevant period of time.

Affidavit of Andrew Ho, P. Eng., Appeal Book, Vol. IX, Tab 20, para. 4

Privacy interests

14. In their Memorandum of Fact and Law, the Appellants repeatedly refer to the ISPs, including Rogers, as having "refused" to provide the requested information. These assertions fail to acknowledge that the ISPs are not at liberty to provide the information absent consent or a court order, as a result of privacy-related obligations. As specifically stated by Justice von Finckenstein, all of the parties (including the Appellants) agreed before him that ISP account holders have an expectation that their identity will be kept private and confidential, which expectation is based on sections 3 and 5 of the *Personal Information Protection and Electronic Documents Act (PIPEDA)* among other things. The Appellants cannot, now, resile from their agreement made before the motions judge, as they attempt to do, for example, in paragraph 77 of their Memorandum of Fact and Law.

Reasons, Appeal Book, Vol. I, Tab 2, para. 9

The Appellants' motion

15. The Appellants' motion sought an order for disclosure of certain personal information and documents related to certain IP addresses, as well as an affidavit from the ISP and certain relief from the implied undertaking rule. The request for an affidavit and relief from the implied undertaking rule was specifically disapproved of by Justice von Finckenstein, and is no longer sought by the Appellants in this appeal.

> *Notice of Motion*, Appeal Book, Vol. I, Tab 5, pp. 63-64
> *Notice of Appeal*, Appeal Book, Vol. I, Tab 1

16. The Appellants' motion did not seek an order for the examination for discovery of Rogers, nor did it seek an order for the preservation of documents. Further, this relief is not sought in the Appellants' Notice of Appeal. It arises, for the first time, in the Appellants' Memorandum of Fact and Law in this appeal. It is Rogers' position that such relief cannot be sought, for the first time, on appeal.

> *Notice of Motion*, Appeal Book, Vol. I, Tab 5, pp. 63-64
> *Notice of Appeal*, Appeal Book, Vol. I, Tab 1

17. The original return date of the Appellants' motion was February 16, 2004. At that time, Rogers, among others, sought an adjournment, to permit fair notice to be given to the account holders who were potentially affected by the motion. In connection with the requested adjournment, the ISPs agreed to preserve any existing records in their possession, only until the disposition of the motion. This term then formed part of the terms of the adjournment.

> *Order of Justice von Finckenstein*, dated February 20, 2004, Appeal Book, Vol. X, Tab 32, p. 2809

18. Rogers then sent notice of the Appellants' motion to the eight account holders who were identified through the above process. For one of the account holders, Rogers' records indicated that the account holder had moved and terminated Rogers' Internet service. Rogers sent a notice to the former account holder's last known address. The notice was returned to Rogers marked "moved".

> *Affidavit of Andrew Ho, P. Eng.*, Appeal Book, Vol. IX, Tab 20, para. 6
> *Answers from the Cross-Examination of Andrew Ho*, Appeal Book, Vol. X, Tab 25

Decision of Justice von Finckenstein

19. Justice von Finckenstein dismissed the Appellants' motion, finding, among other things, that the Appellants had failed to provide the required evidence to establish the basis for the requested order.

> *Reasons*, Appeal Book, Vol. I, Tab 2, para. 43

20. Justice von Finckenstein addressed the three issues before him, specifically:

(1) what legal test the Court should apply;

(2) whether the Plaintiffs met the test; and

(3) if an order was issued, what should be the scope and terms of such order.

> *Reasons*, Appeal Book, Vol. I, Tab 2, para. 43

(1) What legal test the Court should apply

21. In considering what legal test to apply, Justice von Finckenstein reviewed the authority in *Glaxo Wellcome PLC v. Canada (Minister of National Revenue)*, a decision of this Court, which adopted *Norwich Pharmacal Co. v. Customs and Excise Commissioners*, a decision of the House

of Lords. Following that established authority, Justice von Finckenstein held that the test for granting an equitable bill of discovery involved the following five criteria:

(a) the applicant must establish a *prima facie* case against the unknown alleged wrongdoer;

(b) the person from whom discovery is sought must be in some way involved in the matter under dispute, he must be more than an innocent bystander;

(c) the person from whom discovery is sought must be the only practical source of information available to the applicants;

(d) the person from whom discovery is sought must be reasonably compensated for his expenses arising out of compliance with the discovery order in addition to his legal costs; and

(e) the public interests in favour of disclosure must outweigh the legitimate privacy concerns.

Reasons, Appeal Book, Vol. I, Tab 2, para. 13

Glaxo Wellcome PLC v. Canada (Minister of National Revenue) (1998), 81 C.P.R. (3d) 372 (F.C.A.)

Norwich Pharmacal Co. v. Customs and Excise Commissioners, [1974] A.C. 133 (H.L.)

22. Justice von Finckenstein further held that there is no reason why the same principles enunciated above should not also apply to an application brought under Rule 238, where the Plaintiffs have simply commenced a "John Doe" action.

Reasons, Appeal Book, Vol. I, Tab 2, para. 14

23. The Appellants now assert, on appeal, that Justice von Finckenstein erred in law in articulation of the above test, where he held that the applicant must establish a "*prima facie*" case, and have asked this Court to contrast that test with an allegedly different test - that is, a "*bona fide*" claim. However, before Justice von Finckenstein, the Appellants expressly submitted that the two terms were the same.

> *Plaintiff's written representations for motion return of March 12, 2004*, which state at para. 33 "the criteria for issuing a bill of discovery involve three threshold requirements: (i) the Applicant must establish a *bona fide* (i.e. *prima facie*) claim against the alleged wrongdoer ...", excerpt attached as Appendix "B".

24. With respect to Rule 233, the motions judge held that the definition of a "document" under the Rules was not broad enough to cover the creation of documents *not normally held* by a party nor retrievable through computer systems used by a party in its ordinary business, and found that documents did not pre-exist that linked the IP addresses to the account holders of the ISPs. The Court further found that documents would be generated should an ISP be compelled to make the connection; however, this was not something contemplated by Rule 233.

> *Reasons*, Appeal Book, Vol. I, Tab 2, para. 15

25. The Appellants now seek to ask this Court to draw a distinction between the legal test under Rules 233 and 238, and that applicable to an equitable bill of discovery as addressed by this Court in the case of *Glaxo Wellcome PLC*. However, before Justice von Finckenstein, it was the Appellants' submission that these tests were the same - specifically that the "criteria for the granting of an order under Rule 233 and 238 generally mirrored those of the equitable bill of discovery".

> *Plaintiff's written representations for motion return of March 12, 2004*, at para. 41, excerpt attached at Appendix "B"

(2) Whether the Plaintiffs met the test

26. Justice von Finckenstein found that, based on the evidence put forward by the Appellants, or lack thereof, the Appellants had failed to meet the test for disclosure.

Reasons, Appeal Book, Vol. I, Tab 2, paras. 16-43

(3) If an order is issued, what should be the scope and terms of such order

27. Justice von Finckenstein held that any order made should be accompanied by such restrictions and confidentiality orders as the Court deems appropriate. He further held that the order:

(a) should be limited to disclosure of the name and last known address, which was sufficient in order to allow the Appellants to proceed with their action,

(b) should not require the ISPs to provide an affidavit in support of their findings,

(c) should not include a waiver of the implied undertaking rule as requested by the Appellants; and

(d) should provide that only the Internet pseudonyms be added as defendants in the statement of claim.

Reasons, Appeal Book, Vol. I, Tab 2, paras. 44-46

PART II – STATEMENT OF ISSUES

28. The issues raised by this appeal and Rogers' position on those issues are summarized as follows:

(a) *Standard of Appellate Review.* Rogers submits that the alleged errors raised by the Appellants are findings of fact or findings of mixed fact and law. The

standard of appellate review is, therefore, whether there was a "palpable and overriding error". This standard accords the appropriate deference to the findings of the motions judge.

(b) *Threshold Test for order sought on Motion*. Rogers submits that the motions judge did not err in law in respect of the test that must be satisfied before an order for disclosure can be made. The Appellants must therefore demonstrate palpable and overriding errors with respect to each element of the test now challenged on appeal.

(c) *Terms of order*. Rogers submits that certain of the terms of the order now sought by the Appellants are, in any event, inappropriate and ought not be granted.

PART III– SUBMISSIONS

Standard of Appellate Review

29. The Supreme Court of Canada has recently affirmed the deference that must be accorded to motions judges' findings of fact and inferences of fact. Findings of fact and inferences of fact cannot be overturned unless the judge made a palpable and overriding error. Further, where an issue on appeal involves a judge's interpretation of evidence as a whole, it should not be overturned absent palpable and overriding error. Such a standard should be adopted unless it is clear that the judge made some extricable error in principle with respect to the characterization of the standard or its application.

Housen v. Nikolaisen [2002], 2 S.C.R. 235 (S.C.C.), at paras. 10, 19, 26, 36-37

30. Despite the Appellants' attempt to characterize its issues otherwise, the errors alleged by the Appellants all involve either findings or inferences of fact made by the motions judge, or mixed findings of fact and law. Accordingly, Rogers submits that the appropriate standard of review to be applied in this appeal is "palpable and overriding error".

Threshold Test for order sought on Motion

31. The order sought on the Appellants' motion was an extraordinary one, seeking disclosure from a non-party of personal information about parties not before the Court for the purpose of suing parties not before the Court.

32. Justice von Finckenstein articulated a five-point test for entitlement to such an order. In doing so, he followed the established authority of this Court, in its decision in *Glaxo Wellcome PLC v. M.N.R.*, in which this Court addressed the relevant issues in the context of an equitable bill of discovery.

Glaxo Wellcome PLC v. M.N.R., supra

33. Justice von Finckenstein further followed the established authority with respect to the disclosure in the context of potential litigation concerning activity on the Internet, as set out in *Irwin Toy Ltd. v. Doe.*

Irwin Toy Ltd. v. Doe (2000), 12 C.P.C. (5th) 103 (Ont. S.C.J.)

34. Justice von Finckenstein also followed the submissions of the Appellants themselves which, as set out in paragraphs 23 and 25 above:

(1) equated the phrase "*bona fida*" with "*prima facie*"; and

(2) equated the test for an equitable discovery with the appropriate test under Rules 233 and 238 of the *Federal Court Rules*.

Memorandum, paras. 23 and 25, above

35. The Appellants cannot, now, allege that the motions judge erred in law where the motions judge accepted the Appellants' own submissions on those issues of law.

36. In their Memorandum of Fact and Law, the Appellants wrongly suggest that each ISP confirmed that it has the relevant information. On the contrary, as stated above:

(1) Rogers engaged in a process of attempting to locate information from data that was not collected for this purpose;

(2) As a result of that process, which was time consuming, resource intensive and potentially imperfect, Rogers has identified a last known name and address for account holders associated with eight IP addresses, but not for the exact dates and times referred to in the Appellants' motion;

(3) The available data relates to a Rogers' account holder, but the account holder may or may not be the end user;

(4) Rogers has no record of the KaZaA pseudonyms, the only unique identifier put forward by the Appellants; and

(5) As a result, Rogers can make no representation as to whether the last known account holder name and address in respect of the IP addresses, at a different date and time, are the actual end users of a KaZaA pseudonym whom the Appellants claim are infringing copyrights.

37. The Appellants have also asserted in their Memorandum of Fact and Law that the ISPs regularly comply with inquiries of this type. This is a misleading characterization of the evidence put forth by Rogers. Rogers does not regularly provide this type of information upon

receipt of a request for disclosure. Rogers has disclosed information regarding IP addresses and account holders in the past pursuant to a warrant or a court order. Such a warrant or court order would have been granted based on the evidentiary record before that decision-maker, not the record before this Court, and thus cannot usefully advance the Court's consideration of this appeal.

> *Cross-Examination of Andrew Ho, held March 5, 2004*, Appeal Book, Vol. X, Tab 24, p. 4-6 of the transcript, qq. 8-17

38. Nor is Rogers under an obligation to voluntarily provide the Appellants with the information sought, as suggested by the Appellants. There is no obligation on an ISP to voluntarily disclose the personal information of an account holder or to provide that information upon request.

> *Reasons*, Appeal Book, Vol. 1, Tab 2, para. 37
> *Irwin Toy*, *supra*, at paras. 10-11

39. Moreover, Rogers is subject to federal privacy legislation. Section 7(3)(c) of the *Personal Information Protection and Electronic Documents Act* (PIPEDA) allows for the disclosure of personal information without consent if the disclosure is required to comply with a subpoena, warrant, or court order.

> *Reasons*, Appeal Book, Vol. 1, Tab 2, para. 39
> *Personal Information Protection and Electronic Documents Act* (PIPEDA), 2000, S.C. 2002, Chap. 5, s. 7(3)(c)

40. The Appellants incorrectly state in their Memorandum of Fact and Law that single documents exist linking the IP address information in their motion to account holders. In fact, no such single documents exist. On the contrary, Rogers has limited information about the IP addresses from different dates and times, which was obtained through a process of information

gathering. The Appellants appear to rely on the notices that were sent out by Rogers and other ISPs to their account holders. Although Rogers did send notices to eight account holders, the information used to identify those account holders was obtained as a result of the information-gathering process described above, and is subject to the other frailties previously discussed.

41. Moreover, notice was given to these account holders as a matter of fairness, since, if the Court concluded that an order should be made, those account holders would be directly affected by the order of the Court. The giving of notice should not in any way be relied upon by the Appellants as a basis for arguing that a single document exists for the purposes of Rule 233. To accept otherwise would frustrate the important public policy interest in due process for persons potentially affected by the Court process.

42. Since the order sought by the Appellants is an extraordinary one, the motions judge had to be satisfied both that the court had jurisdiction to make an order, and that it was appropriate to do so in the circumstances. It was the Appellants' obligation to put forward the evidence necessary for an order of this extraordinary nature to be granted. It was Justice von Finckenstein's assessment that the Appellants failed to do so. On this appeal, the Appellants attempt to challenge the motion judge's assessment of the evidence, including findings of fact and inferences of fact, which they cannot do absent palpable and overriding errors with respect to every element of the test now challenged on this appeal.

Terms of Requested Order

43. If this Court allows the appeal, Rogers submits that the terms of the order should be more limited than those sought by the Appellants on this appeal.

Appellants' Memorandum of Fact and Law, p. 29

44. With regard to paragraph 1 of the proposed order, the time requirement for production of the information should run from the date upon which the issued order is served upon the ISP, rather than the date of the order, having regard for the possibility of a delay between the date of the order and the date it is served upon the non-party respondent.

45. Further, the information sought by the Appellants in subparagraph 1(a) of the proposed order should be narrowed to the last known available name and address of the Rogers account holder associated with the relevant IP address. This is consistent with the requirements in analogous situations under the Rules, for example Rule 240(b), which requires a party to an examination for discovery to disclose only the name and address of any person who might reasonably be expected to have knowledge relating to a matter in question in the action.

46. The additional information sought on this motion by the Appellants - namely, "any and all records relating to the identity and address for service" - is overbroad, excessive, and should not be required. Moreover, ordering disclosure of this information goes far beyond that which is necessary for the Appellants' stated purposed in seeking the information. As such, ordering this disclosure would be inconsistent with the principles enshrined in *PIPEDA* that require only the personal information reasonably necessary for a particular purpose be collected, used or disclosed.

PIPEDA, supra, Schedule 1, ss. 4.2.2, 4.4.1
Federal Court Rules, 1998, SOR/98-106, Rule 240(b)

47. Nor should Rogers be ordered to attend for examination for discovery, as requested in subparagraph 1(b) of the proposed order:

- There is no jurisdiction for such an order under the Rules relied on by the Appellants. Rule 233 only authorizes a Court to order production of documents

from a non-party. While Rule 238 permits examination of a third party witness, it does not permit discovery of a third party prior to discovery of the defendant.

- An order requiring a Rogers representative to attend for examination for discovery was not part of the order sought from Justice von Finckenstein, and it is inappropriate to seek new relief before an appellate court.

Bayside Towing Ltd. v. Canadian Pacific Railway (2000), F.T.R. 247 (F.C.T.D.) aff'd (2000) F.T.R. 158 (F.C.T.D.) at para. 25

48. As set out in paragraph 2 of the Appellants' proposed order, the Appellants agree to a term requiring them to reimburse the ISPs for the reasonable expenses of the ISPs associated with complying with the order sought. In doing so, the Appellants do not challenge on this appeal the ruling of Justice von Finckenstein that ISPs are entitled to be reimbursed for such expenses. These expenses would include all administrative and internal and external legal costs of the ISP in connection with identifying the information sought on this motion and responding to this motion.

Glaxo Wellcome PLC v. M.N.R., supra, paras. 24, 66-67
Reasons, Appeal Book, Vol. I, Tab 2, para. 34

49. In paragraph 3 of the proposed order, the Appellants seek, for the first time, an order that the ISPs maintain any records in their possession, power and control regarding the usage of the IP addresses. This relief was not part of the order sought originally, and it is inappropriate to expand the relief sought on appeal. It is also inconsistent with the requirements in analogous situations under the Rules, for example, Rule 240(b), as discussed above. Moreover, the requirement to maintain records regarding "the usage" of the Rogers account holders is an exercise that is broader in scope than what is necessary for the Appellants' stated purpose.

50. Nor are the Appellants entitled to any costs order against Rogers in connection with either the motion or this appeal. As stated above, it is the Appellants' obligation to demonstrate to the Court an entitlement to a disclosure order. In the circumstances, there should be no order of costs made against a non-party ISP from which disclosure is sought.

51. The terms of an order that, in Rogers' submission, would be appropriate, are set out below in Part IV.

PART IV– ORDER SOUGHT

52. Rogers respectfully requests that the appeal be dismissed.

53. If, however, the Court allows the appeal, and makes an order for disclosure, Rogers requests that the terms of the Order be as follows:

1. The Internet service provider division of the non-party respondent, Rogers Cable Communications Inc. (the "ISP"), shall, within fourteen (14) days of the date of the service upon it of a copy of this Court's Order, disclose to counsel for the Appellants the last known name and address in the business records of the ISP associated with the IP addresses, dates and times listed in Schedule "A" to the Appellants' Notice of Motion, if available;

2. The Appellants shall pay all administrative and internal and external legal costs of the ISP in connection with identifying the information sought on this motion and responding to this motion.

54. In any event, Rogers should be awarded its legal costs of both the motion below and of this appeal.

August 11, 2004

ALL OF WHICH IS RESPECTFULLY SUBMITTED

Wendy Matheson per

Wendy Matheson

Laura Malloni

Of counsel for Rogers Cable Communications Inc.

PART V– LIST OF AUTHORITIES

Court Orders

Orders of Justice von Finckenstein dated March 1, 2004

Regulations and Statutes

Personal Information Protection and Electronic Documents Act, 2000, S.C. 2002, Chap. 5, s. 7(3)(c); Schedule 1, ss. 4.2.2, 4.4.1

Federal Court Rules, 1998, SOR/98-106, Rule 240(b)

Cases and Secondary Authorities

Glaxo Wellcome PLC v. Canada (Minister of National Revenue) (1998), 81 C.P.R. (3d) 372 (F.C.A.)

Norwich Pharmacal Co. v. Customs and Excise Commissioners, [1974] A.C. 133 (H.L.)

Housen v. Nikolaisen [2002], 2 S.C.R. 235 (S.C.C.)

Irwin Toy Ltd. v. Doe (2000), 12 C.P.C. (5th) 103 (Ont. S.C.J.)

Bayside Towing Ltd. v. Canadian Pacific Railway (2000), F.T.R. 247 (F.C.T.D.), aff'd (2000) F.T.R. 158 (F.C.T.D.)

APPENDIX A - PROVISIONS OF STATUTES

Personal Information Protection and Electronic Documents Act (Part 1 of 2)

2000, Chap. 5, Parts 1 and 2 (ss. 1 to 51); Part 2 (ss. 31 to 51) brought into force May 1, 2000 by para. (a) of SI/2000-29, Can. Gaz., Part II, April 26, 2000; Part 1 (ss. 1 to 30) brought into force by para. (b) of SI/2000-29, Can. Gaz., Part II, April 26, 2000

[Excerpts]

Preamble

An Act to support and promote electronic commerce by protecting personal information that is collected, used or disclosed in certain circumstances, by providing for the use of electronic means to communicate or record information or transactions and by amending the Canada Evidence Act, the Statutory Instruments Act and the Statute Revision Act

[. . .]

Purpose -- s. 3

3. The purpose of this Part is to establish, in an era in which technology increasingly facilitates the circulation and exchange of information, rules to govern the collection, use and disclosure of personal information in a manner that recognizes the right of privacy of individuals with respect to their personal information and the need of organizations to collect, use or disclose personal information for purposes that a reasonable person would consider appropriate in the circumstances.

[. . .]

Disclosure without knowledge or consent -- s. 7(3)

(3) For the purpose of clause 4.3 of Schedule 1, and despite the note that accompanies that clause, an organization may disclose personal information without the knowledge or consent of the individual only if the disclosure is

[. . .]

(c) required to comply with a subpoena or warrant issued or an order made by a court, person or body with jurisdiction to compel the production of information, or to comply with rules of court relating to the production of records,

[. . .]

SCHEDULE 1
(Section 5)

PRINCIPLES SET OUT IN THE NATIONAL STANDARD OF CANADA ENTITLED MODEL CODE FOR THE PROTECTION OF PERSONAL INFORMATION, CAN/CSA-Q830-96

[. . .]

4.2 Principle 2 - Identifying Purposes

The purposes for which personal information is collected shall be identified by the organization at or before the time the information is collected.

[. . .]

4.2.2

Identifying the purposes for which personal information is collected at or before the time of collection allows organizations to determine the information they need to collect to fulfill these purposes. The Limiting Collection principle (Clause 4.4) requires an organization to collect only that information necessary for the purposes that have been identified.

[. . .]

4.4 Principle 4 - Limiting Collection

The collection of personal information shall be limited to that which is necessary for the purposes identified by the organization. Information shall be collected by fair and lawful means.

4.4.1

Organizations shall not collect personal information indiscriminately. Both the amount and the type of information collected shall be limited to that which is necessary to fulfil the purposes identified. Organizations shall specify the type of information collected as part of their information-handling policies and practices, in accordance with the Openness principle (Clause 4.8).

[Excerpt]

Scope of examination -- s. 240

240. A person being examined for discovery shall answer, to the best of the person's knowledge, information and belief, any question that

(a) is relevant to any unadmitted allegation of fact in a pleading filed by the party being examined or by the examining party; or

(b) concerns the name or address of any person, other than an expert witness, who might reasonably be expected to have knowledge relating to a matter in question in the action.

APPENDIX B - EXCERPTS FROM APPELLANTS' WRITTEN REPRESENTATIONS TO THE MOTIONS JUDGE

Court File No. T-292-04

FEDERAL COURT

B E T W E E N:

BMG CANADA INC., EMI MUSIC CANADA, A DIVISION OF EMI GROUP CANADA INC., SONY MUSIC ENTERTAINMENT (CANADA) INC., UNIVERSAL MUSIC CANADA INC., WARNER MUSIC CANADA LTD., BMG MUSIC, ARISTA RECORDS, INC., ZOMBA RECORDING CORPORATION, EMI MUSIC SWEDEN AB, CAPITOL RECORDS, INC., CHRYSALIS RECORDS LIMITED, VIRGIN RECORDS LIMITED, SONY MUSIC ENTERTAINMENT INC., SONY MUSIC ENTERTAINMENT (UK) INC., UMG RECORDINGS, INC., MERCURY RECORDS LIMITED AND WEA INTERNATIONAL INC.

Plaintiffs

- and –

JOHN DOE, JANE DOE AND ALL THOSE PERSONS WHO ARE INFRINGING COPYRIGHT IN THE PLAINTIFFS' SOUND RECORDINGS

Defendants

WRITTEN REPRESENTATIONS
on behalf of the Plaintiffs (Applicants)
for motion returnable March 12, 2004

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IV. Plaintiffs' Argument

A. Test for Obtaining Relief

31. There is a duty on the ISPs to disclose the identities of their customers in this set of circumstances. A person who becomes involved in the wrongful acts of another, even if innocently, is under a duty to assist another who is injured by those acts by giving full information to disclose the identity of the wrongdoer.

> **Glaxo Welcome PLC v. Canada (Minister of National Revenue) (1998), 81 C.P.R. (3d) 372 (F.C.A.), leave to appeal to S.C.C. refused, [1998] S.C.C.A. No. 422.**
>
> **Norwich Pharmacal Co. v. Customs and Excise Comrs. [1974] A.C. 133 (H.L.) per Lord Reid at 175**
>
> **Straka v. Humber River Regional Hospital et al. (2000), 51 O.R. (3d) 1 (C.A) at 13-14.**
>
> **K. LaRoche & G.J. Pratte, "The Norwich Pharmacal Principle and Its Utility in Intellectual Property Litigation" (2001) 24 Advocates Quarterly 301 at 301.**

32. This principle can go beyond merely identifying the wrongdoer to requiring the person to include all information necessary to enable the plaintiff to decide whether it is worth suing the wrongdoer or not. In this case, the plaintiffs merely want to learn the identity of certain wrongdoers; they already have evidence of wrongdoing.

> **Glaxo Welcome PLC v. Canada (Minister of National Revenue) (1998), 81 C.P.R. (3d) 372 (F.C.A.), leave to appeal to S.C.C. refused, [1998] S.C.C.A. No. 422.**
>
> **Norwich Pharmacal Co. v. Customs and Excise Comrs. [1974] A.C. 133 (H.L.) per Lord Reid at 175**
>
> **Straka v. Humber River Regional Hospital et al. (2000), 51 O.R. (3d) 1 (C.A) at 13-14.**

33. The criteria for issuing a bill of discovery involves three threshold requirements:

1) The applicant must establish a *bona fide* (i.e. *prima facie*) claim against the alleged wrongdoer;

2) The applicant must share some sort of relationship with the respondent through the wrongdoing; and,

3) The person from whom discovery is sought must be the only practical source of information available.

The general object is to do justice. The requirements are satisfied on the facts of this case. In exercising its discretion, a court should also take into account the public interests both in favour of and against disclosure. Without disclosure, the plaintiffs would be "non-suited" On the facts of this case, there is nothing that weighs against giving the plaintiffs the opportunity to go forward with their lawsuit.

Straka v. Humber River Regional Hospital et al. (2000), 51 O.R. (3d) 1 (C.A) at 14

Glaxo Welcome PLC v. Canada (Minister of National Revenue) (1998), 81 C.P.R. (3d) 372 (F.C.A.), leave to appeal to S.C.C. refused, [1998] S.C.C.A. No. 422.

34. This motion is brought pursuant to Rules 233 and 238 of the Federal Court Rules, 1998[1].

35. The Federal Court has the power, under Rule 233(1), to order the production of any document in the possession of a person who is not a party to the action, if the document is relevant and its production could be compelled at trial.

Rule 233(1), Federal Court Rules, 1998, SOR/98-106, as am.

36. The defendants are identified by the specified Internet Protocol addresses. The specified Internet Protocol addresses are registered to ISPs who have assigned those Internet Protocol addresses to subscribers whose identity is solely known by the ISPs. The information sought is relevant and could be compelled at trial; only the ISPs have possession of the relevant information.

Affidavit of Gary Millin, *Plaintiffs' Motion Record*, paras. 16, 24, 33, 36 and 37

Notice of Motion, *Plaintiffs' Motion Record*, Schedule 'A'

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[1] In a letter dated February 25, 2004, the Plaintiffs indicated to counsel for the ISPs that the motion would be based on Rule 238 as well as 233.

(a) the ISPs have information on an issue in the action, namely the identity of the alleged infringers.

(b) the plaintiffs have been unable to obtain the information from the ISPs through informal means. The ISPs are the only practical source of the information.

(c) it would certainly be unfair not to allow the plaintiffs an opportunity to question the ISPs; otherwise, the plaintiffs would be non-suited without this information.

(d) providing the information would not cause unreasonable delay, inconvenience or expense.

Affidavit of Gary Millin, *Plaintiffs' Motion Record*, paras. 90, 91

41. The criteria for the granting of an order under Rules 233 and 238 generally mirror those for the equitable bill of discovery. The principle of the duty to identify the wrongdoer can be invoked whether the order is sought in a John Doe action against the wrongdoer or in another action brought against the third party by way of a bill of discovery.

42. This motion is not a novel proceeding. Third parties have been compelled to disclose documents identifying the name and address of a defendant previously identified solely by an Internet Protocol address. In no case have privacy or other concerns against disclosure outweighed the interest in obtaining the documents and information to identify the defendants.

Irwin Toy v. Doe (2000), 12 C.P.C. (5th) 103 (Ont. S.C.J.).

Ontario First Nations Limited Partnership v. John Doe (3 June 2002) (Ont. S.C.J.)

Canadian Blood Services/Société Canadienne du Sang v. John Doe (June 17, 2002) (Ont. S.C.J.)

Wa'el Chehab v. John Doe (October 3, 2003) (Ont. S.C.J.)

Kibale v. Canada, [1991] F.C.J. No. 634 (QL) (FC)

Loblaw Companies Ltd. v. Aliant Telecom Inc. and Yahoo [2003] N.B.J. No. 208 (N.B.Q.B.), online: QL (NBJ).

43. In *Irwin Toy v. Doe*, the Ontario Superior Court of Justice granted the applicant leave to examine an Internet service provider for discovery of the name, address or other identification information of a customer of the ISP who had sent out allegedly defamatory e-