

Federal Court



Cour fédérale

Date: 20110829

Docket: T-1373-11

Citation: 2011 FC 1024

[UNREVISED ENGLISH CERTIFIED TRANSLATION]

Montréal, Quebec, August 29, 2011

PRESENT: The Honourable Mr. Justice Shore

BETWEEN:

VOLTAGES PICTURES LLC

Plaintiff

and

JANE DOE and JOHN DOE

Defendants

REASONS FOR JUDGMENT AND JUDGMENT

I. Preliminary

[1] A copyright infringement gives rise to extraordinary measures in order to find the parties guilty of that infringement.

II. Introduction

[2] In *BMG Canada Inc. v. John Doe*, 2005 FCA 193, [2005] 4 F.C.R. 81, the Federal Court of Appeal confirmed the following:

[42] ... in cases where plaintiffs show that they have a *bona fide* claim that unknown persons are infringing their copyright, they have a right to have the identity revealed for the purpose of bringing action. ...

[3] The Court accepts the plaintiff's position in support of its motion as follows:

- (i) an order allowing for a written examination for discovery of Bell Canada, Cogeco Cable Inc. and Videotron GP to be held so that they identify the names and addresses connected to their customer accounts associated with the IP addresses at the times specified in Annex A of the Statement of Claim filed in this record; and
- (ii) an order requiring Bell Canada, Cogeco Cable Inc. and Videotron GP to disclose to Voltage Pictures LLC the names and addresses related to their customer accounts associated with the IP addresses at the times specified in Annex A of the Statement of Claim filed in this record.

[4] Voltage Pictures LLC is the owner of the copyright on the film *Hurt Locker*. The defendants copied and distributed this film over the internet without the authorization of Voltage Pictures LLC.

[5] Voltage Pictures LLC has identified the IP addresses used by the defendants, but only their internet service providers can identify them more precisely.

[6] Voltage Pictures LLC is seeking leave to conduct a written examination for discovery of the internet service providers so that they disclose the names and addresses of the customers corresponding to the IP addresses already obtained. Once these customers have been identified,

Voltage Pictures LLC can send formal notices and, where applicable, add these persons as defendants to this action.

III. Facts

[7] The defendants downloaded, copied and distributed the film *Hurt Locker* through peer-to-peer networks on the internet, without the authorization of Voltage Pictures LLC. They did so anonymously; they can be identified only by their IP addresses (Affidavit of Daniel Arheidt, sworn on August 24, 2011, at paras. 23-25).

[8] An IP address is merely a series of numbers, as appears from the table attached as Annex A to the Statement of Claim dated June 20, 2011.

[9] The IP addresses in question belong to Bell Canada, Cogeco Cable Inc. and Videotron GP (internet service providers) and are used by customers when they access the internet. The internet service providers record the use of their IP addresses and can identify who has used an IP address at a specific time and date (Affidavit of Daniel Arheidt at para 23).

[10] Voltage Pictures LLC must therefore call upon the internet service providers to obtain the names and addresses corresponding to the IP addresses that it has already obtained by consulting public sources.

[11] Without this information, Voltage Pictures LLC cannot identify those persons who have infringed its copyright and will be deprived of its right to bring an action against them.

IV. Analysis

Subsection 7(3) of the *Personal Information Protection and Electronic Documents Act*, S.C. 2000, c. 5

[12] Voltage Pictures LLC is asking the internet service providers to disclose the names and addresses of some of their customers who have allegedly infringed its copyright.

[13] Subsection 7(3) of the *Personal Information Protection and Electronic Documents Act*, S.C. 2000, c. 5, allows for the disclosure of personal information on a court order:

7. (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;

7. (3) Pour l'application de l'article 4.3 de l'annexe 1 et malgré la note afférente, l'organisation ne peut communiquer de renseignements personnel à l'insu de l'intéressé et sans son consentement que dans les cas suivants :

[...]

c) elle est exigée par assignation, mandat ou ordonnance d'un tribunal, d'une personne ou d'un organisme ayant le pouvoir de contraindre à la production de renseignements ou exigée par des règles de procédure se rapportant à la production de documents;

[14] According to the Federal Court of Appeal, a written examination for discovery of the internet service providers is appropriate where their customers have infringed the plaintiff's copyright:

[25] However, the appellants argued that the main issue on the motion was the identity of each person who is committing infringement of the appellants' copyrights. I agree and find that because this issue inevitably falls within the words in subsection 238(1) of the Rules as being "an issue in the action," rule 238 is broad enough to permit discovery in cases such as this.

...

[41] Modern technology such as the Internet has provided extraordinary benefits for society, which include faster and more efficient means of communication to wider audiences. This technology must not be allowed to obliterate those personal property rights which society has deemed important. Although privacy concerns must also be considered, it seems to me that they must yield to public concerns for the protection of intellectual property rights in situations where infringement threatens to erode those rights.

[42] Thus, in my view, in cases where plaintiffs show that they have a *bona fide* claim that unknown persons are infringing their copyright, they have a right to have the identity revealed for the purpose of bringing action. However, caution must be exercised by the courts in ordering such disclosure, to make sure that privacy rights are invaded in the most minimal way.

(*BMG*, above)

[15] These principles also apply to the case at bar.

Rule 238 of the *Federal Courts Rules*, SOR/98-106

[16] To obtain the name and address of a customer of an internet service provider, plaintiffs must prove that they have a *bona fide* claim against that customer and that they meet the criteria of Rule 238 of the *Federal Courts Rules* (*BMG*, above, at paras. 33 and 34).

[17] Voltage Pictures LLC has a *bona fide* claim against the defendants: it has brought an action against them for having infringed its copyright when they copied and publicly distributed the film *Hurt Locker*.

[18] Rule 238 of the *Federal Courts Rules* allows for the holding of an examination for discovery of a third party where the third party has relevant information on an issue in the action:

238. (1) A party to an action may bring a motion for leave to examine for discovery any person not a party to the action, other than an expert witness for a party, who might have information on an issue in the action.

...

(3) The Court may, on a motion under subsection (1), grant leave to examine a person and determine the time and manner of conducting the examination, if it is satisfied that

(a) the person may have information on an issue in the action;

(b) the party has been unable to obtain the information informally from the person or from another source by any other reasonable means;

238. (1) Une partie à une action peut, par voie de requête, demander l'autorisation de procéder à l'interrogatoire préalable d'une personne qui n'est pas une partie, autre qu'un témoin expert d'une partie, qui pourrait posséder des renseignements sur une question litigieuse soulevée dans l'action.

[...]

(3) Par suite de la requête visée au paragraphe (1), la Cour peut autoriser la partie à interroger une personne et fixer la date et l'heure de l'interrogatoire et la façon de procéder, si elle est convaincue, à la fois :

a) que la personne peut posséder des renseignements sur une question litigieuse soulevée dans l'action;

b) que la partie n'a pu obtenir ces renseignements de la personne de façon informelle ou d'une autre source par des moyens raisonnables;

(c) it would be unfair not to allow the party an opportunity to question the person before trial; and

c) qu'il serait injuste de ne pas permettre à la partie d'interroger la personne avant l'instruction;

(d) the questioning will not cause undue delay, inconvenience or expense to the person or to the other parties.

d) que l'interrogatoire n'occasionnera pas de retards, d'inconvénients ou de frais déraisonnables à la personne ou aux parties.

[19] These criteria are factual and are assessed on a case-by-case basis.

Paragraph 238(3)(a) of the *Federal Courts Rules* – the internet service providers have relevant information

[20] Voltage Pictures LLC does not know the names and addresses of the defendants. Since they are all customers of the internet service providers, the internet service providers can match the IP addresses identified by Voltage Pictures LLC with their internal records and provide the names and addresses of the defendants.

[21] This information is, in fact, relevant to this case.

Paragraph 238(3)(b) of the *Federal Courts Rules* – Voltage Pictures LLC has been unable to obtain this information informally

[22] The internet service providers cannot disclose the names and address of their customers without an order of this Court.

Paragraph 238(3)(c) of the *Federal Courts Rules* – it would be unfair not to allow Voltage Pictures LLC an opportunity to question the internet service providers

[23] In *BMG*, above, the Federal Court of Appeal confirmed:

[42] ... in cases where plaintiffs show that they have a *bona fide* claim that unknown persons are infringing their copyright, they have a right to have the identity revealed for the purpose of bringing action...

[24] Voltage Pictures LLC cannot assert its copyright or bring an action against the defendants if it does not know their names and addresses.

[25] Defendants should not have the possibility of hiding behind the anonymity of the internet and continuing to infringe the copyright of Voltage Pictures LLC.

Paragraph 238(3)(d) of the *Federal Courts Rules* – the questioning will not cause undue delay, inconvenience or expense to the person or to the other parties

[26] Voltage Pictures LLC agrees to reimburse any reasonable expenses incurred by the internet service providers in collecting the information sought.

[27] Obtaining the names and addresses of the defendants will speed up this action. Without this information, Voltage Pictures LLC cannot assert its rights.

[28] Voltage Pictures LLC is asking this Court that the minimum information necessary to allow it to assert its rights against the defendants be disclosed to it.

IV. Conclusion

[29] The Court grants Voltage Pictures LLC's motion without costs given that the plaintiff's motion is not contested by any of the internet service providers.

JUDGMENT

Further to the analysis undertaken, **the Court orders that:**

1. Voltage Pictures LLC proceed with a written examination for discovery of Bell Canada, Cogeco Cable Inc. and Videotron GP in order to obtain the names and addresses related to their customer accounts associated with the IP addresses at the times specified in Annex A attached to the Notice of Motion.
2. Within two weeks, Bell Canada, Cogeco Cable Inc. and Videotron GP disclose to Voltage Pictures LLC the names and addresses related to their customer accounts associated with the IP addresses at the times specified in Annex A. This disclosure shall be in Microsoft Excel format, with publishing rights, encrypted on a compact disk or any other electronic medium.
3. Voltage Pictures LLC reimburse any reasonable expenses incurred by Bell Canada, Cogeco Cable Inc. and Videotron GP in collecting the personal information identified in paragraph 1 of this order.
4. Without costs.

“Michel M.J. Shore”

Judge

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET: T-1373-11

STYLE OF CAUSE: VOLTAGE PICTURES LLC v.
JANE DOE AND JOHN DOE

PLACE OF HEARING: Montréal, Quebec

DATE OF HEARING: August 29, 2011

**REASONS FOR JUDGMENT
AND JUDGMENT:** SHORE J.

DATED: August 29, 2011

APPEARANCES:

Greg Moore

FOR THE PLAINTIFF

Not present

FOR THE DEFENDANT

SOLICITORS OF RECORD:

Goudreau Gage Dubuc, LLP
Montréal, Quebec
Not present

FOR THE PLAINTIFF

FOR THE DEFENDANT