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Domain Name Disputes

"epsonink.ca," "epsoncartridge.ca," "epsoninkjet.ca"

In *Seiko Epson Corp. v. Zokool Technologies Inc.*, sole CIRA panelist Peter Cooke considered a dispute over the domain names epsonink.ca, epsoncartridge.ca and eponinkjet.ca. The Complainant ("Seiko") is a Japanese computer technology company, dealing inter alia in printer parts and components. It owns a number of registered Canadian trademarks, all including the word EPSON and a serial number, the last of which was registered in 1998. The Registrant ("Zokool") is a company based in Thornhill, Ontario, and did not respond to the complaint. It registered the domain names epsonink.ca and epsoninkjet.ca in November, 2000 and the domain name epsoncartridge.ca in January, 2001.

Panelist Cooke first examined whether the domain names were "confusingly similar" to Seiko's marks under 3.4 of the CIRA Policy. He noted that with regard to marks which are actually registered with CIPO, there is no need to "go behind" the registration and the panel need not inquire into demonstrative distinctiveness or use of a mark, since the registration itself is sufficient to establish sufficient rights to attract protection under the Policy. The domain names themselves contained "the whole of [Seiko]'s mark EPSON" within each, which supported a finding of confusing similarity; "the addition of descriptive or non-distinctive terms in the Domain Names [here "ink," "inkjet" and "cartridge"] will not prevent them from being found confusingly similar…." (para. 28, citation omitted). The Panelist next turned to whether Seiko had proven that Zokool had "no legitimate interest" in the domain names under the criteria set out in 3.6 of the Policy. In large part because Zokool had submitted no evidence regarding its use of the domain names, the Panelist found that it could meet none of the criteria for legitimate interest and thus ruled that there was none.

As to the final criterion, whether Zokool had registered the names "in bad faith" under 3.7 of the Policy, the Panelist considered evidence that Zokool had registered domain names containing the trademarks of Seiko and three other mark owners. He noted previous authority that as few as two registrations of domain names containing third party marks was proof of a pattern of abusive registration, and ruled that this was the case with Zokool. He also noted that the websites in question "appeared" to offer products similar to those of Seiko (para. 46), and thus ruled that the registration had been made to disrupt Seiko's business. All of this underpinned a finding that the registration had been made in bad faith. The domain names were ordered transferred to Seiko.

Foreign Notes of Interest: Ethical Aspects of Dealing with Facebook in Litigation

In March 2009, the Professional Guidance Committee of the Philadelphia Bar Association issued an opinion on the ethics of Facebook access in the context of contested litigation. A Philadelphia lawyer had deposed a witness who was adverse in interest to his client, and the witness indicated she had Facebook and MySpace accounts. The lawyer wished to view the contents of the accounts, which were protected by privacy settings but would be accessible to anyone who was "friended" by the witness. The lawyer proposed that he would have a third party attempt to become "friended" by the witness, using only truthful information but not revealing the connection with the lawyer, and the third party would report the contents of the pages to the lawyer. The lawyer solicited the Committee's view on whether it would be ethical to do so, and whether he could use the contents of the pages if obtained.

The Committee first opined that since the lawyer would be the one commissioning the obtaining of the information, then he would be responsible for it under the ethical code just as if it was his own act. It next stated that the proposed course of action would violate the lawyer's obligation under Rule 8.4(c) of the state's Rules of Ethical Conduct to refrain from fraud, deceit or misrepresentation. This was because it was deceptive, in that the third party was going to omit a primary material fact, i.e. that he/she was trying to obtain the information simply to share it with the lawyer. The witness would effectively be deceived into giving out information she might otherwise not have disclosed. It was suggested that the lawyer simply ask the witness for access, rather than deceive her from the outset. It dismissed the lawyer's argument that the proposed actions were analogous to surreptitious video recording of plaintiffs in personal injury cases, since in that situation the videographer would be obtaining information the plaintiff presented publicly, rather than gaining access to private spaces by way of deception, which was what the lawyer was proposing.

The Committee also opined that the proposed actions would violate the lawyer's obligation under Rule 4.1 not to make untrue or deceitful statements. It acknowledged and surveyed various controversies surrounding the use of deception as being acceptable in some litigation settings, but felt that the dominant opinion was that such deception was not acceptable. The question of whether he could use the information if he obtained it in this matter was held not to be within the Committee's remit, and would be appropriately addressed before the courts.

Privacy: More Nightclubs Gathering Personal Information

On 8 May 2009 the Office of the Privacy Commissioner of Canada (OPC) released a summary of the findings of the Assistant Privacy Commissioner after an investigation into a beverage room operated by the Canad Inns Hotel chain in Brandon, Manitoba. (A similar case, on judicial review before the Alberta Queen's Bench, was reported in the IT-Can newsletter of 3 April 2009) A patron at the bar complained that her driver's license had been copied into an "ID machine" which copied and recorded information from the face of the license. The patron also objected to the fact that there was no signage to advise customers beforehand of the collection and retention of their information, and to the use of security cameras that recorded all people entering the bar. The bar argued that it used the information to help in its statutory obligation to ensure that all patrons were of legal age, and retained the information for "security purposes." The video footage, which was retained for 31 days, was submitted to be for similar purposes.

The Assistant Commissioner considered each of these information-gathering methods under *PIPEDA*. She noted that principles 4.3-4.5 under the Act provide that information require the knowledge and consent of the person whose information is collected, as well as limiting the collection to purposes for which it is necessary and limiting the retention of the information to only as long as is necessary for the purpose. Regarding the ID machine, she found that there had been no previous notification to patrons that the information would be collected, though the bar had since rectified this by posting a sign. However, she found that the collection of the information was not necessary for either of the purposes argued by Canad Inns. The machine did not assist in age verification, since this was done by physical inspection of each customer's identification; moreover, Canad Inns had not provided any evidence suggesting that collecting and retaining the identifying information served any security purpose. Regarding the security cameras, the Assistant Commissioner accepted that there was a valid security purpose for having the cameras. However, none of the cameras in the bar were trained on any area other than the entrances and exits. Since these were areas already monitored by staff, she reasoned that a more valid security use of the cameras would be to point them at other areas of the bar not as easily monitored by staff, such as the dance floor, bars or VIP areas.

In the result, Canad Inns accepted the Assistant Commissioner's recommendations to post appropriate signage in all locations, to retain the video footage for no more than 30 days and to provide individuals with access to any footage of themselves upon request (with the images of others pixilated out). However, it did not accept the

Assistant Commissioner's recommendation to cease collecting and storing identification information via the ID machine, nor would it remove all personal information that had been collected thus far. In response, the OPC has brought an application for a hearing before the Federal Court of Canada, which is currently pending.

Use of Personal Website as Harassment?

The Ontario Court of Appeal has delivered its decision in *Metropolitan Toronto Condominium Corp. No. 932 v. Labrkamp*. The appellant is a unit owner in a condominium managed by the respondent. The relationship between the appellant and the respondent Board of Directors and management staff was "extremely strained". The respondent claims that appellant's unrelenting stream of requests for condominium records from the management in effect amounted to harassment of its management staff. Consequently, it applied for an injunction to, among other things, restrain the appellant from harassing, communicating, or having contact with any member of the Board of Directors, management staff or security personnel, or any other employee of the respondent; requesting further condominium record from the respondent or coming within stipulated distance of the respondent management office. Also, the respondent sought to enjoin the appellant to either dismantle or render inactive his internet website.

The application judge found that the appellant's conduct to a Board member and staff of the management office amounted to harassment and that even though the *Condominium Act* (the Act) gave the appellant the right to examine the condominium records, he was not to do so in a circumstance that amounts to the abuse of the right. Consequently, the court enjoined the appellant, inter alia, from communicating with the management staff and Board of the respondent other than in writing. The court also restrained the appellant from entering or coming with 25 feet of the respondent management office.

On appeal, the court of appeal found that, the act of harassment by the appellant did not amount to actionable harassment. In the opinion of the court: the motion judge's remedy is too extreme to be sustained as it deprived the appellant's right of access to condominium record under the Act. According to the court, "Given the respondent's acknowledgment that the appellant's behaviour did not amount to actionable harassment, we were not persuaded that the orders made by the application judge prohibiting the applicant from exercising his statutory right to examine the respondent's record, coming within 25 feet of the management office, or communicating with members of the Board of Directors or management staff than in writing were supportable. Accordingly, we would set aside these injunctive aspect of the application judge's order" (para 11).

This newsletter is intended to keep members of IT.Can informed about Canadian legal developments as well as about international developments that may have an impact on Canada. It will also be a vehicle for the Executive and Board of Directors of the Association to keep you informed of Association news such as upcoming conferences.

If you have comments or suggestions about this newsletter, please contact Professors Robert Currie, Chidi Oguamanam and Stephen Coughlan at it.law@dal.ca.

Disclaimer: The IT.Can Newsletter is intended to provide readers with notice of certain new developments and issues of legal significance. It is not intended to be a complete statement of the law, nor is it intended to provide legal advice. No person should act or rely upon the information in the IT.Can Newsletter without seeking specific legal advice.

Le présent bulletin se veut un outil d'information à l'intention des membres d'IT.Can qui souhaitent être renseignés sur les développements du droit canadien et du droit international qui pourraient avoir une incidence sur le Canada. Le comité exécutif et le conseil d'administration de l'Association s'en serviront également pour vous tenir au courant des nouvelles concernant l'Association, telles que les conférences à venir.

Pour tous commentaires ou toutes suggestions concernant le présent bulletin, veuillez communiquer avec les professeurs Robert Currie, Chidi Oguamanam et Stephen Coughlan à l'adresse suivante : it.law@dal.ca

Avertissement : Le Bulletin IT.Can vise à informer les lecteurs au sujet de récents développements et de certaines questions à portée juridique. Il ne se veut pas un exposé complet de la loi et n'est pas destiné à donner des conseils juridiques. Nul ne devrait donner suite ou se fier aux renseignements figurant dans le Bulletin IT.Can sans avoir consulté au préalable un conseiller juridique.