



NEWSLETTER

Canadian IT Law Association

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Criminal Law: Accessing & Storage of Images Does Not Equal Possession

In *R. v. Woods*, G. Campbell J. of the Ontario Court of Justice presided over the trial of the accused, who was charged with possessing child pornography contrary to s. 163.1(4) of the *Criminal Code*. The accused was a co-owner and the primary user of a Toshiba laptop computer, which he left behind at his wife's apartment when their marriage ended. While looking for some wedding pictures on the computer, the wife encountered what she thought were child pornography images and reported the accused to the police. A police computer expert who analyzed the computer found, and the trial judge accepted, that the images viewed by the wife were actually images of adults pretending to be children. However, the analysis also turned up 36 images which were actual child pornography. At issue was whether the accused had intentionally "possessed" the images for the purpose of the offence.

The decision turned on the detailed analysis of the computer's hard drive by the police computer personnel. The analysis indicated that the computer had been used to visit a number of websites which appeared to offer child pornography, but in actual fact had only "images of young adults dressing down to appear as children engaged in sexual acts" (para. 26). The child pornography images themselves were found in the "page file," a secondary storage system in which files are automatically stored by the computer when the available RAM memory is exceeded (usually because of multi-tasking; see para. 18). The court accepted that the page file was an area of computer memory which was inaccessible to most

computer users, requiring specialized knowledge and software in order to do so. While in the expert's opinion the child pornography images had been downloaded and not uploaded from a digital camera, there was no indication that any websites containing child pornography had been accessed. Nonetheless, the court accepted the expert's conclusion that the images had been viewed on the computer's screen before they were stored in the page file.

Ultimately the court held that the accused did not know that the child pornography images were stored on the computer and were available for his use. However, given the evidence that the accused had visited websites purporting to offer child pornography, Justice Campbell found that "the images found in the page file were the product of Mr. Woods' efforts to locate child pornography on the Internet" (para. 44), and specifically that they ended up in the page file based on Mr. Woods having accessed child pornography, likely over the internet" (para. 48). Accordingly, the accused could not be convicted of having "possessed" the images, as the evidence did not prove that he was aware that the images were stored on the computer. The court noted that accessing child pornography is an offence under s. 163(4.1) of the *Criminal Code*, and raised the possibility of the Crown being permitted to amend the charge to reflect this.

Copyright: End of the Ringtone Buzz

In *Canadian Wireless Telecommunication Association v. Society of Composer, Authors and Music Publishers of Canada (SOCAN)*, the Supreme Court has rejected an application for leave to appeal the decision of the Federal Court of Appeal. In the substantive and originating action before the [Copyright Board of Canada](#), SOCAN had argued that ringtones incorporated into telephone and other devices communicate musical works to the public and therefore attract a tariff. A consortium of wireless carriers, including Bell Mobility, the

Canadian Wireless Telecommunications Association (CWTA) and the Canadian Recording Industry Association took objections to aspects of the tariff proposed by SOCAN. The Copyright Board of Canada ruled that the communication of ringtones amounts to communication by telecommunication pursuant to section 3(1)(f) of the *Copyright Act*, R.S.C. 1985, c.-42. According to the Board, even when the communication is intended to be received by a segment of the public in individual/private settings, it still amounts to a communication to the public in so far as the transmission happens outside an exclusively domestic environment. After assessing a method of determining tariffs for ringtones, the Board then set the tariff for SOCAN. The [Federal Court of Appeal subsequently upheld the decision](#) of the Board. In this present action, the Supreme Court dismisses the Appellants' application for leave to appeal with costs and without assigning reasons.

Domain Name Decisions

“spafinder.ca”

In *Spafinder Inc. v. Ontario Spa Inc.*, sole CIRA panellist David Lametti considered a dispute over the domain name spafinder.ca. The Complainant (“Spafinder”) is a New York-based company which serves as a “spa resource;” its main website, spafinder.com, “provides information and links about spas and spa services, and a variety of related travel, health and beauty products and services” (para. 8) and has an international market. It has used the CIPO-registered mark SPAFINDER in Canada since 2001 to promote its services. The Registrant (“Ontario Spa”) is a Mississauga-based company which, at most relevant times, operated the website SpasWorldwide.com, offering “spa and wellness services” in a manner similar to that of Spafinder. It registered the disputed domain name in 2003.

Panellist Lametti first considered (seemingly *proprio motu*) the scope of Spafinder's rights in the mark. He noted that “it might be argued” that the elements of the mark—“spa” and “finder”—might render the mark either purely descriptive of services or a generic neologism covering those services (para. 18). If this was so, then to enjoy exclusive rights in the mark the holder must provide significant evidence that the mark has acquired “secondary meaning”

and was associated with the holder's services in Canada. He indicated that this was a heavy burden, citing the recent CIRA decision of *Cohen v. 3824152 Canada Inc.* (“canadavisa.ca”) (which was reported in the [18 September 2008 issue](#) of this newsletter). The Panellist was satisfied that, given the company's international profile, Spafinder had offered sufficient indirect evidence that the mark was distinct enough to have acquired secondary meaning in Canada.

Panellist Lametti next considered the requirement under 4.1(a) of the CIRA Policy that a Complainant prove that the disputed name is “confusingly similar” to the Complainant's mark. He noted that the domain name (read, as is required, without the “dot-ca” suffix) was identical to the mark, but found that this was not dispositive. This was because of the possible descriptive quality of the mark referred to above, given that “to the extent that a domain name is a generic word or description, simple similarity or even complete identity of the domain name and the mark may not be sufficient to determine whether or not there has been confusion, actual or likely” (para. 23). The Panellist stated that, while it would have been possible for a registrant to use the name “spa finder” in a way that was not confusing, in this case the services offered by the two companies were similar enough that consumers could easily confuse one with the other. He ruled that Ontario Spa had an obligation to make reasonable efforts to dispel confusion between the two, which it had not done, and accordingly the domain name was “confusingly similar” to the mark.

The Panellist then considered whether the registration was made “in bad faith,” under 4.1(b) and 3.7 of the CIRA Policy. He held that Spafinder had adduced sufficient evidence that the registration had been made in an attempt to divert consumers to the Ontario Spa website and to interfere with Spafinder's business. In so deciding he rejected Spafinder's argument that to make out good faith, a registrant must conduct a trademark search. He noted that the registration of a domain name containing a mark “does not in and of itself constitute bad faith,” and held that while so doing was prudent it was not a requirement under the Policy (para. 32).

Panellist Lametti finally considered whether Spafinder had provided some evidence that Ontario Spa had “no legitimate interest” in the domain name,

under 4.1(c) and 3.6 of the Policy. The only criteria of legitimate interest which were at all in question were under 3.6(b) and (c) of the Policy, which provide for legitimate interest based on the name describing services offered on the website or if the name was a generic name for the goods/services, respectively. He noted again the generic, descriptive nature of the name, but found that since each of these criteria required a finding of good faith associated with it, the fact that Ontario Spa had been seeking to divert customers from Spafinder allowed a finding of no legitimate interest. The domain name was ordered transferred to the Complainant.

Evidence: Admissibility of E-mail Apology and Voir Dire Imperative

In *R v. SGT*, the Saskatchewan Court of Appeal has upheld the Accused's appeal, set aside his conviction for sexual assault and ordered a new trial. The accused was involved in a bitter matrimonial dispute with the complainant's mother. The complainant was born in 1989 before the accused married her mother in 1996. The accused was alleged to have been involved in three separate fondling incidents with the complainant. At the trial, the complainant did not provide sufficient particulars of the allegations and admitted on cross-examination that she had lied to her mother and friends sometimes. During the investigation of the complaint, the police were alleged to have exerted pressure on the accused to confess to sexually assaulting the complainant with a promise that if he apologized to the complainant's mother, charges would be withdrawn and he will escape being jailed. Consequently, he made a formal (confession) statement to the police and subsequently wrote an e-mail of apology to the Complainant's mother. The trial judge ruled that the accused's formal confession to the police which was obtained under coercion and inducement via police interrogation was tainted, involuntary and therefore inadmissible. However, the court found that the derivative e-mail apology from the tainted interrogation was not only a crucial piece of information; it also affirmed the credibility of the complainant and indicated lack of credibility on the part of the accused.

In reviewing the decision, the Court of Appeal relied on a long list of authorities on the credibility of evidence derived from tainted interrogation method. While admitting that the complainant's mother does not qualify as a person in authority to whom a confession (e-mail apology) has been made, the court held that where the (confessional) statement of an accused person was obtained in coercion, inducement and in questionable circumstances, the jury should be directed to be cautious about accepting such evidence. Also, they should be directed that little, if any, weight should be given to such evidence as it might be unreliable, untrue on its own or by association. The court held that the confessions rule requires that protected statement be excluded from evidence if derived from prior inadmissible statement. In order to determine whether the accused's e-mail apology in this case is admissible evidence, the court has to examine it in the light of prior inadmissible formal confession arising from coerced police interrogation. The court ruled that the degree of such connection could only be assessed or ascertained during a *voir dire*. On the facts of the present case, a *voir dire* is an important step that should be taken in regard to the admissibility or otherwise of the e-mail apology of the accused to the complaint's mother.

Trade-Mark: Abandonment & 'Expungement'

In *Cross-Canada Auto Body Supply (Windsor) Ltd. v. Hyundai Auto Canada, A Division of Hyundai Motors of America*, the Supreme Court has rejected an application for leave to appeal the decision of the Federal Court of Appeal which upheld the judgment of first instance by the Federal Court of Canada. In the substantive and originating action, the Plaintiff/Applicants, who are in the business of re-selling automobile parts and accessories, including those of the Hyundai brand, had brought an action for expunging from the Trade-mark Register in Canada five trade marks of Hyundai Auto Canada. They argue that three of the trade-marks have been abandoned; all of the trade-marks were invalid being not distinctive of Hyundai Auto Canada at the time of the application for expunging. Overall, it was their position that the purchasing public in Canada associated the five marks and corresponding

goods with Hyundai Motor Company of Korea, the manufacturer and not the Hyundai Auto Canada. The Defendant/Respondent's contention was for the most part that it was the exclusive source of the implicated Hyundai wares in Canada via its network of franchise dealers across the country and there is no basis for confusion by the relevant public on the subject. It denied abandoning or intending to abandon the trade-marks and argued that not only were most of the marks in continuing use, their registrations had been renewed regularly and up-to-date. In the present application, the Supreme Court turned down the Plaintiff/Appellants' application for leave to appeal the decision of the Court of Appeal with costs and without assigning reasons.

U.S. Decisions: Admissibility of Expert Evidence About Internet Chatrooms

In *U.S. v. Dennis Joseph*, the accused was tried before a jury and convicted of Internet enticement of a girl he believed was underaged to engage in sexual activity. On the accused's successful appeal of his conviction, the Court of Appeals for the Second Circuit (New York) questioned the trial judge's decision to exclude expert opinion evidence which the accused sought to adduce regarding "role-playing in the context of sexually explicit conversations" in Internet chat rooms (p. 20). Dr. James Herriot, an Associate Professor of Clinical Sexuality at the Institute of Advanced Human Sexuality in San Francisco, was prepared to testify that:

[a] major component of the entertainment on the Internet is the rapid repartee, in addition to having imaginative fun. When engaging in Internet role-play, people love to experiment with their personas. Typically, people weave a bit of truth about themselves with a great deal of imagination and/or exaggeration. The Internet presents [a] competitive entertainment. . . . Sexually explicit conversations tend to drive the chatting relationship, and are fueled by the anonymity of the created personas. . . . Often, chatters become curious about who is "behind the screen." There are many methods chatters use to "de-mask" the other participant: such as

asking for a photograph, attempting a phone conversation, asking for information that can be independently verified or even attempting to meet in a public space (p. 22).

A majority of the Court of Appeals ruled that this expert evidence could help jurors to understand part of the accused's defence, namely that he only intended to meet with the supposed child and did not intend any sexual activity. This would be helpful because many prospective jurors would not have visited chat rooms (indeed, this had been the case with many of the prospective jurors at Joseph's trial), and/or would not be aware of common dynamics and relationships there. The Court of Appeals urged the District Court which would be re-trying the accused to give "more thorough consideration" to admitting the testimony (p. 21).

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.

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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

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