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Docket: T-2084-12

Citation: 2017 FC 616

BETWEEN:

UNITED AIRLINES, INC.

Plaintiff

and

JEREMY COOPERSTOCK

Defendant

REASONS FOR JUDGMENT

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PHELAN J.

I. Introduction

[1] This is an action relating to the alleged infringement by the Defendant, Dr. Jeremy Cooperstock [Cooperstock], the owner-operator of the website www.untied.com [UNTIED.com], of trademarks and copyright owned by the Plaintiff, United Airlines, Inc. [United].

[2] The Plaintiff claims that the Defendant has infringed its registered trademarks pursuant to ss 20(1)(a), 7(b), 7(c), and 22 of the *Trade-marks Act*, RSC 1985, c T-13. Further, the Plaintiff claims that the Defendant has infringed its copyright pursuant to ss 3(1) and 27 of the *Copyright Act*, RSC 1985, c C-42.

II. Background

[3] The Plaintiff is a commercial airline that was formed by the merger of two predecessor airlines, United Air Lines, Inc. [UAL] and Continental Airlines [Continental]. This merger was announced in 2010 and finalized on March 31, 2013. United and its predecessor UAL have been operating commercial flight services in and out of Canada since 1939 under the brand name of UNITED. UAL used the domain name www.ual.com for its online presence until December 17, 1998, when it began using www.united.com.

[4] Following the merger between UAL and Continental, the Plaintiff unveiled its brand name and logo in August 2010: the United brand name with the United Logo (previously used by UAL) and the Globe Design (previously used by Continental). At that time, UAL began to use the United brand name and United Logo, including on its website. Continental continued to use its own branding, including the Globe Design. On November 30, 2011, UAL and Continental started operating under a single operating certificate, and on March 3, 2012 they merged their consumer-facing platforms (i.e., their websites). The new, merged website was located at www.united.com and it used the design of the previous Continental website, which had used the same basic design and artwork since 2006.

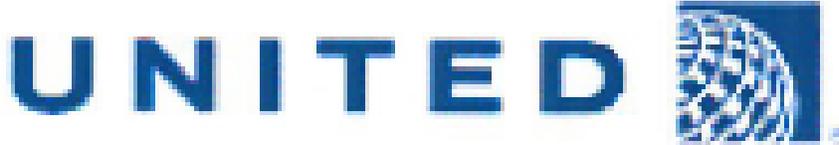
[5] The Plaintiff has made use of a number of trademarks in association with its services [the United Marks or United Trademarks], including:

- a) The UNITED word mark (Registration TMA204,456) [UNITED Mark], which was registered by UAL in January 1975 and renewed in January 2005. This trademark has been used in Canada in relation to air transportation services for passengers since as early as 1939.
- b) The UNITED AIRLINES word mark (Registration TMA367,179) [UNITED AIRLINES Mark], which was registered by UAL in March 1990 and renewed in March 2013. This trademark has been used in Canada in relation to air transportation of passengers, property, and mail since as early as 1939.
- c) The Globe Design (Registration TMA492,886), which was registered by Continental in April 1998 and renewed in April 2013. This trademark has been used in Canada in relation to air transportation of persons and property since as early as 1995.



[6] The Plaintiff also claims copyright with respect to the following logos and designs:

- a) The United logotype (Registration 1099766) [United Logo], which was first published on August 11, 2010 and was registered on October 29, 2012.



- b) The Globe Design (Registration 1099765), which was first published on February 1, 1991 and was registered on October 29, 2012.

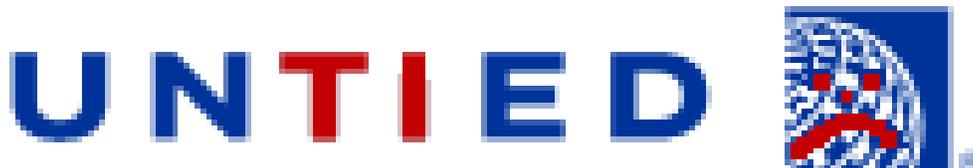


- c) The INTERNET WEBSITE CONTENT INCLUDING, WITHOUT LIMITATION: (TEXT, IMAGES, DESIGNS, LAYOUT, DOMAIN: WWW.united.com) (Registration 1099767) [United Website], which was first published on July 29, 2006 and was registered on October 29, 2012.

[7] The Defendant operates UNTIED.com, which was registered and launched on or about April 24, 1997. UNTIED.com is the successor to a personal webpage operated by the Defendant titled "Poor Show", which was launched around the summer of 1996. The "Poor Show" webpage displayed information about the Defendant's negative experience with United (then UAL) and United's purportedly inadequate responses. After launching this webpage, the Defendant began to receive letters from other travellers regarding their negative experiences with United and he posted these on his webpage. The content related to United was removed from the "Poor Show" webpage around March 24, 1997; about one month later, the Defendant launched UNTIED.com. The Defendant chose the domain name UNTIED.com as a play on the word "United", so as to highlight the disconnection and disorganization that he perceived in the company. The Defendant

continues to maintain UNTIED.com as a consumer criticism website where visitors can find information on the Plaintiff, submit complaints about the Plaintiff, and read complaints about the Plaintiff dating back to 1998 in the database of complaints.

[8] Between August and September 2011, the Defendant redesigned UNTIED.com – it was at this time that graphics similar to the current graphics [the Untied Marks] were displayed in the top left-hand corner of the website, including an “UNTIED” logo [Untied Logo] (a blue sans-serif rendering of the word “UNTIED” in evenly spaced capital letters) and a globe logo covered with a frown [Frowning Globe Design]:



[9] At this time, UNTIED.com also adopted, for the first time, a design similar to the design of the United Website.

[10] Following the redesign of UNTIED.com in September 2011, the Plaintiff became aware of the strong resemblance between UNTIED.com and the United Website. UNTIED.com was updated again in June 2012 to mirror the United Website design launched in March 2012.

[11] The Plaintiff contacted the Defendant on July 16, 2012, to request that changes be made to the appearance of UNTIED.com so as to diminish the potential for confusion in the minds of visitors. The Defendant responded on July 17, 2012, indicating that he would “study” these concerns; at this time, he also offered his services to the Plaintiff as a consultant.

[12] The Plaintiff contacted the Defendant again on September 10, 2012 to restate its request and to “formally” put the Defendant on notice with respect to the Plaintiff’s intellectual property rights. The Defendant responded on September 25, 2012 but did not address the request to change UNTIED.com’s appearance.

[13] The Plaintiff contacted the Defendant for a third time on October 2, 2012. The Defendant responded on October 12, 2012, but he did not alter UNTIED.com’s appearance as requested. However, in October 2012, the Defendant made certain alterations to UNTIED.com: he changed the colour of the T and I in the Untied Logo to red (from blue), changed the frown on the Frowning Globe Design to red (from blue), and added a disclaimer and a pop-up dialogue box to the website indicating that this was not the website of United. The disclaimer, stating “(This is not the website of United Airlines)”, was placed at the top of the website in small black type – next to the graphic identifying “Untied” as “An Evil Alliance Member”.

[14] The Parties to this litigation are not unfamiliar with each other. Proceedings have taken place before the Superior Court of Quebec with respect to the Defendant’s practice of making the personal information of United employees available on UNTIED.com. On September 27, 2016, in *United Airlines inc v Cooperstock*, 2016 QCCS 4645, 2016 CarswellQue 9046 (WL Can), the Superior Court issued an injunction requiring the Defendant to remove the contact information of employees with no customer care responsibilities from his website. The Superior Court found that the employees in question (co-plaintiffs in that proceeding) had no responsibility for customer care and had received phone calls, voice messages, and e-mails following the publication of their contact information on UNTIED.com, causing “significant prejudice”

(para 75). The Superior Court further found that the publication of such information served “absolutely no purpose whatsoever” with respect to resolving customer complaints, and that it had a negative influence on the job performance of at least one employee (paras 70, 78). In reaching its conclusion, the Superior Court noted that the Plaintiff was not seeking to shut down the Defendant’s website, and rejected the Defendant’s contention that he would be forced to shut down his website if the injunction were granted.

[15] The Court of Appeal of Quebec upheld this injunction on January 16, 2017 in *Cooperstock v United Airlines Inc*, 2017 QCCA 44, 2017 CarswellQue 223 (WL Can). The Court of Appeal stated:

[4] In effect, the Appellant wants to continue harassing employees without anyone benefitting from the exercise: certainly not the customers who complain to someone who is unable to respond to their complaint and certainly not the employees who are not meant to handle such complaints.

[5] It is our unanimous view that the appeal is doomed to fail.

[16] The Court of Appeal rejected Cooperstock’s contention that the injunction limited his freedom of speech, commenting that the injunction simply allowed United non-customer care employees to do the tasks that they were hired to perform. Likewise, this Court is of a similar view in respect of the Defendant’s suggestion that freedom of speech is at issue in this litigation.

[17] In September 2015, the current design for the United Website was launched. It continues to make use of the United Logo and the Globe Design, as well as the domain name www.united.com. Although the design of UNTIED.com had not been updated at the time of the

trial in December 2016, a “beta” website (www.untied.com/beta) operated by the Defendant directs visitors to a website that closely resembles the current United Website.

III. Issues

[18] There are five issues to be determined:

1. Has the Defendant infringed the Plaintiff’s trademarks contrary to s 20(1)(a) of the *Trade-marks Act*?
2. Has the Defendant directed public attention to his services offered on UNTIED.com in a way as to cause or be likely to cause confusion with the services of the Plaintiff contrary to s 7(b) of the *Trade-marks Act*? Has the Defendant passed off the services offered on UNTIED.com as those of the Plaintiff contrary to s 7(c) of the *Trade-marks Act*?
3. Has the Defendant used the Plaintiff’s trademarks in a manner susceptible of depreciating the value of the goodwill attached thereto contrary to s 22 of the *Trade-marks Act*?
4. Has the Defendant infringed the Plaintiff’s copyright in the United Website, the United Logo, and the Globe Design, contrary to the *Copyright Act*?
5. Has the Plaintiff engaged in delay or abuse of process?

[19] For the reasons that follow, the Court concludes that the Defendant has infringed the Plaintiff’s trademarks and copyright. In addition, the Court concludes that the current version of UNTIED.com does not fall within the fair dealing for the purpose of parody exception to copyright infringement.

IV. Witnesses

[20] The Plaintiff called three fact witnesses and one expert witness, while the Defendant called one fact witness and one expert witness.

A. *United's Witnesses*

(1) Mr. Scott Wilson

[21] Mr. Wilson was, at the time of the trial, the Vice-President of eCommerce and Merchandising at United and had been with the company since 2010. His position involved designing, managing, and maintaining all of the digital efforts through which consumers interact with the Plaintiff. Mr. Wilson gave evidence on topics such as the various iterations of the United Website, the various iterations of UNTIED.com, the Plaintiff as an airline, and the Plaintiff's branding initiatives.

(2) Mr. Jeff Wittig

[22] Mr. Wittig is senior counsel for finance and fleet in the legal department of United. He was first employed by Continental in 1997 and became an employee of United on April 1, 2013, following the merger of the operating companies. He gave evidence on topics such as the merger between UAL and Continental and the history of his personal information being made available on UNTIED.com.

(3) Ms. Nancy Proietti

[23] Ms. Proietti is a travel agent employed at Groupe Voyages VP in Montreal. She represents corporate customers in both Quebec and Ontario and services clients in English and French. She gave evidence on her experience submitting a complaint to UNTIED.com.

[24] Ms. Proietti was a credible and convincing witness. It was clear that she had a great deal of experience working in the travel industry, including interacting with air carriers such as the Plaintiff and resolving customer service issues for her clients. Her evidence with respect to confusion was compelling, particularly as she was a sophisticated user of air carrier websites and had experience dealing with air carriers such as United.

(4) Mr. Stephen Buffo

[25] Mr. Buffo was called as an expert witness. He is an economist with experience in forensic accounting and valuation. He is an expert in the valuation of intellectual property rights, including with respect to trademarks and copyrights, as well as evaluating the impairment and diminution of value of intellectual property rights, in a broad range of industries including the transportation industry. Mr. Buffo gave evidence on the existence of goodwill in the United Trademarks and the depreciation of goodwill.

[26] Mr. Buffo's evidence was relatively unhelpful.

B. *Cooperstock's Witnesses*

(1) Dr. Jeremy Cooperstock

[27] The Defendant called himself as his sole fact witness. He is a professor of electrical engineering at McGill University in Montreal and does occasional consulting work. He is the owner-operator of UNTIED.com, and he gave evidence on topics such as the creation of UNTIED.com, his reasons for continuing the website, the rationale for collecting complaints, the intended audience of the website, the costs of maintaining the website, the various updates to UNTIED.com, the complaints posted on the website, the current content of UNTIED.com, and the beta website.

(2) Mr. Ron Hall

[28] Mr. Hall was called as an expert witness in the extraction and analysis of data. He gave evidence on the percentage of complaints posted on UNTIED.com which contained unredacted personal information in the form of MileagePlus numbers.

V. Analysis

A. *Trademark Infringement*

[29] Trademark infringement occurs where a defendant has used a trademark or a confusingly similar mark, without the consent of the trademark rights holder, in association with wares or services. Section 20(1)(a) states:

20 (1) The right of the owner of a registered trade-mark to its exclusive use is deemed to be infringed by any person who is not entitled to its use under this Act and who

(a) sells, distributes or advertises any goods or services in association with a confusing trade-mark or trade-name;

20 (1) Le droit du propriétaire d'une marque de commerce déposée à l'emploi exclusif de cette dernière est réputé être violé par une personne qui est non admise à l'employer selon la présente loi et qui :

a) soit vend, distribue ou annonce des produits ou services en liaison avec une marque de commerce ou un nom commercial créant de la confusion;

[30] The elements of infringement under s 20(1)(a) are: the existence of a registered trademark, “use” of a confusing trademark by an allegedly infringing party, sale, distribution, or advertisement of any goods or services in association with that confusing trademark or trade-name, and lack of entitlement or authorization.

(1) Registration

[31] The Parties agreed that the trademarks at issue are registered.

(2) Cooperstock Provides Services through UNTIED.com

[32] The Parties disagreed as to whether the Defendant was offering the sale, distribution, or advertisement of “services” through UNTIED.com. The Defendant admitted that he provides services in the form of information delivery, advice on legal rights, and publication of complaints through UNTIED.com; however, he argued that these do not constitute “services” pursuant to the *Trade-marks Act* because there is no commerce involved. Although the Plaintiff led some

evidence that the Defendant received revenue through advertising and donations, this income was minimal.

[33] In my view, “services” in s 20(1)(a) of the *Trade-marks Act* does not require a monetary element. There is no explicit requirement in the legislation of a monetary or commercial element to services. In *Kraft Ltd v Registrar of Trade-marks*, [1984] 2 FC 874, 1 CPR (3d) 457, 1984 CarswellNat 79 (WL Can) at paras 8-9 (TD) [*Kraft Ltd*], the Court indicated that “services” should not be narrowly interpreted. In *TSA Stores, Inc v Registrar of Trade-Marks*, 2011 FC 273 at para 16, 91 CPR (4th) 324 [*TSA Stores*], Justice Simpson affirmed the broad interpretation to be given to “services” under s 20 of the *Trade-marks Act* and found that the key element of “services” was the benefit to the public. In *TSA Stores*, Justice Simpson found that the website at issue in that case offered services in the form of information and guidance to visitors and this did not involve a monetary element.

[34] It is important not to cast the meaning of “services” so broadly that any provision of information falls within the scope of “services”. However, in certain circumstances, the provision of information for the benefit of the public may constitute a service under the *Trade-marks Act*. The Defendant in this case was offering information and guidance to disgruntled flyers. This would be similar to, for example, phoning a “consumer help line” for guidance in dealing with an airline. Further, the evidence clearly established that the Defendant intended to provide services that were consistent with his general critique of the Plaintiff, such as the publication of complaints. Therefore, in my view, it is clear that the Defendant offers services through UNTIED.com.

(3) Use

[35] The Plaintiff must show that the Defendant “used” its trademarks in the manner contemplated by the legislation. With respect to infringement pursuant to s 20(1), this involves two elements: the Defendant must have used the marks within the meaning of s 4 of the *Trade-marks Act* and the Defendant must have used the marks as trademarks (that is, for the purpose of identifying the origin of the goods or services as described in s 2 of the *Trade-marks Act*). With respect to a service, s 4(2) deems a trademark to be used in association with a service if the mark is used or displayed in the advertising or performance of the service in question. Section 2 states:

trade-mark means

(a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish goods or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,

(b) a certification mark,

(c) a distinguishing guise, or

(d) a proposed trade-mark;
(*marque de commerce*)

...

marque de commerce Selon le cas :

a) marque employée par une personne pour distinguer, ou de façon à distinguer, les produits fabriqués, vendus, donnés à bail ou loués ou les services loués ou exécutés, par elle, des produits fabriqués, vendus, donnés à bail ou loués ou des services loués ou exécutés, par d’autres;

b) marque de certification;

c) signe distinctif;

d) marque de commerce projetée. (*trade-mark*)

...

<p>use, in relation to a trade-mark, means any use that by section 4 is deemed to be a use in association with goods or services; (<i>emploi ou usage</i>)</p>	<p>emploi ou usage À l'égard d'une marque de commerce, tout emploi qui, selon l'article 4, est réputé un emploi en liaison avec des produits ou services. (<i>use</i>)</p>
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[36] To constitute use as a trademark, a mark must be used to indicate the origin of goods or services; that is, to distinguish goods or services of an individual from those of others. If, as in *Clairol International Corp v Thomas Supply & Equipment Co*, [1968] 2 Ex CR 552, 1968 CarswellNat 32 (WL Can) [*Clairol*], the trademark of another is merely being used to compare one's own goods or services to those of others, then this will not constitute trademark use. In *Cie générale des établissements Michelin-Michelin & Cie v CAW-Canada* (1996), [1997] 2 FC 306, 71 CPR (3d) 348, 1996 CarswellNat 2297 (WL Can) (TD) [*Michelin* cited to CarswellNat], Justice Teitelbaum stated :

[26] I am satisfied that the classic *Clairol* analysis of use under Section 20 is still good law. The test for "use" in Section 20 requires two separate elements of proof from both Section 2 and Section 4. In effect, the first element taken from Section 4 is: (1) did the Defendants associate their services with the Plaintiff's trademarks? The second element from Section 2 is: (2) did the Defendants use the mark as a trademark for the *purpose* of distinguishing or identifying the Defendants' services in connection with the Plaintiff's wares or services?

[37] Although s 20(1) does not explicitly specify that there must be trademark "use", this requirement is implied by the wording of the provision (*Michelin* at paras 19, 29). The Defendant submits that any "use" of the United Marks on UNTIED.com does not constitute use within the purview of the *Trade-marks Act* and that the Untied Marks displayed on UNTIED.com are not being used to distinguish the goods or services of the Defendant from those of others.

[38] The Defendant's intention is not determinative with respect to a finding of trademark use – whether marks or confusingly similar marks are being used as trademarks depends on the message given to the public. In *Tommy Hilfiger Licensing Inc v International Clothiers Inc*, 2004 FCA 252 at para 40, [2005] 1 FCR 148 [*International Clothiers*], the Federal Court of Appeal indicated that the crucial question was “whether, irrespective of its intentions, the respondent had used its crest so as to denote the origin of the shirts and boys' shorts sets, or used the crest in such a way as to have served the purpose of indicating origin”.

[39] With respect to the Defendant's use of the marks as trademarks, I find the reasoning of the Federal Court of Appeal in *International Clothiers* to be persuasive. In that case, the Court of Appeal considered the similarity of the marks, the placement of the marks on clothing, and the respondent's awareness that it was common practice to affix a logo to the breast of a sweater or shirt to indicate its source. All of the same considerations apply in this case. Visually, the marks are very similar (with some minor additions to the marks displayed on UNTIED.com). In addition, the placement of the Untied Logo and the Frowning Globe Design in the upper left hand corner of UNTIED.com mirrors that of the placement of the UNITED Mark/United Logo and the Globe Design on the United Website (as it then was). Further, the Defendant's beta website shows the same identical placement of the allegedly infringing marks. Although this was not raised in evidence, I would note that this appears to be a common placement for a website “identifier”.

[40] Similar to the respondent in *International Clothiers*, the Defendant was aware that he had placed the Untied Marks in the same location as the United Marks were displayed on the United

Website. When giving evidence, the Defendant stated, “I decided I could be far more effective in the parody by humorously mimicking the appearance, but with a twist on numerous elements of United’s own website. And this was reflected, not just in the update of the parodied logo, with the frown over the globe, but also in numerous other elements within the webpage”.

[41] The Untied Logo and the Frowning Globe Design are displayed prominently on UNTIED.com. In addition, a mark similar to the UNITED AIRLINES Mark is displayed on UNTIED.com – for example, during the relevant time period the bottom left-hand corner of UNTIED.com stated “Copyright © Untied Air Lines, Inc.”.

[42] The marks are therefore being used or displayed in the advertising or performance of services pursuant to s 4(2) of the *Trade-marks Act*. I find the Defendant’s display of the Untied Marks constitutes use under s 20(1)(a) of the *Trade-marks Act*.

(4) Confusion

[43] Section 20(1) of the *Trade-marks Act* protects against a defendant’s use of a plaintiff’s trademarks or confusingly similar marks. “Confusing” is defined in s 2 of the *Trade-marks Act* with reference to s 6. Section 6(2) states:

6 (2) The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or

6 (2) L’emploi d’une marque de commerce crée de la confusion avec une autre marque de commerce lorsque l’emploi des deux marques de commerce dans la même région serait susceptible de faire conclure que les produits liés à ces marques de

performed by the same person, whether or not the goods or services are of the same general class.	commerce sont fabriqués, vendus, donnés à bail ou loués, ou que les services liés à ces marques sont loués ou exécutés, par la même personne, que ces produits ou ces services soient ou non de la même catégorie générale.
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[44] Pursuant to s 6(5), the following factors are relevant to a determination of whether marks are confusing: inherent distinctiveness and the extent to which the marks have become known, length of time the marks have been in use, nature of the goods, services, or business, nature of the trade, and the degree of resemblance between the marks.

[45] In determining whether trademarks or trade-names are confusing, the marks should not be scrutinized in detail; rather, they should be considered from the perspective of the first impression of the “casual consumer somewhat in a hurry”. In *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltee*, 2006 SCC 23, [2006] 1 SCR 824 [*Veuve Clicquot*], the Supreme Court stated:

[20] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the name Cliquot on the respondents’ storefront or invoice, at a time when he or she has no more than an imperfect recollection of the VEUVE CLICQUOT trade-marks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks. As stated by Pigeon J. in *Benson & Hedges (Canada) Ltd. v. St. Regis Tobacco Corp.*, [1969] S.C.R. 192, at p. 202:

It is no doubt true that if one examines both marks carefully, he will readily distinguish them. However, this is not the basis on which one should decide whether there is any likelihood of confusion.

... the marks will not normally be seen side by side and [the Court must] guard against

the danger that a person seeing the new mark may think that it is the same as one he has seen before, or even that it is a new or associated mark of the proprietor of the former mark.

(Citing in part *Halsbury's Laws of England*, 3rd ed., vol. 38, para. 989, at p. 590.)

[46] The Defendant argued that the Untied Marks on UNTIED.com are not confusingly similar to the United Marks on the United Website, and that the Plaintiff had not put forward any evidence showing real confusion. He suggested that the disclaimers and the content on UNTIED.com mean that “you’d have to be somebody who is, you know, cognitively challenged... to believe that they’re actually complaining to the airline” through UNTIED.com.

(a) *Inherent distinctiveness*

[47] The trademarks at issue in this case, and particularly the UNITED Mark, are not inherently distinctive. However, the United Marks have acquired distinctiveness due to their long-running and continuous association with the Plaintiff in the marketplace. I am satisfied that the Plaintiff’s large-scale marketing and advertising of air transportation services as well as its operation of thousands of daily flights, described in more detail below with respect to goodwill, have created a strong secondary meaning which would tend to cause consumers to associate the UNITED Mark (as well as the UNITED AIRLINES Mark and the Globe Design) with the Plaintiff in the appropriate circumstances.

(b) *Length of use*

[48] The length of time that a mark has been used will influence the distinctiveness of the mark (*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 77, [2006] 1 SCR 722 [*Mattel*]). As noted above, the UNITED and UNITED AIRLINES Marks have been used by the Plaintiff's predecessor UAL since 1939 and have been registered since 1990. The Globe Design has been registered since 1998 and used by the Plaintiff's predecessor Continental since 1995.

(c) *Nature of the services*

[49] The Defendant emphasized the disparity between the services offered on the United Website (sale of air transportation) and those offered on UNTIED.com (information and complaint submission). However, competition between goods or services is not a controlling factor in a confusion analysis: "the general class of wares and services, while relevant, is not controlling" (*Mattel* at para 51). Nonetheless, it is an important consideration and, in my view, the nature of the services offered by the parties is similar. Both the Plaintiff and the Defendant provide information to prospective travellers as well as post-flight engagement with United customers. Further, as noted by the Plaintiff, it is not required that the services be identical or related as the ordinary consumer may perceive them to be related.

[50] It is conceivable that a consumer would perceive the provision of a "complaints database" to be related to the service of customer care (perhaps in an attempt to encourage transparency). This is relevant to the consideration of whether a consumer may perceive the services as related. Although the services offered through UNTIED.com are more limited than

those offered on the United Website, they are nonetheless parallel in key areas such as the provision of pre-flight information and the reception of post-flight complaints.

(d) *Nature of the trade*

[51] With respect to the nature of the trade, this factor speaks to the channels of trade and the nature and kind of intended customer (*Mattel* at paras 86-87).

[52] It is relevant that the services at issue are being offered through the internet. The character of the market is therefore identical – in both cases, consumers would reach the websites by either typing a domain name into their browsers or searching for the websites using terms such as, in the case of Ms. Proietti, “united” and “complaints”.

(e) *Resemblance*

[53] The final factor, resemblance, weighs heavily in favour of confusion. Resemblance is the similarity between two marks, and it allows for some differences between two marks (*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 62, [2011] 2 SCR 387). The Defendant admitted that he wanted to maximize the resemblance between his own marks and those of the Plaintiff – he wanted visitors to UNTIED.com to “recognize the similarities to the target of my criticism”.

[54] The Defendant took a substantial majority of the UNITED Mark and changed it slightly by reversing the order of the T and I. The prominently displayed Untied Logo displays font,

spacing between letters, number of characters, and letters themselves that are the same as the United Logo (which, of course, contains the UNITED Mark). Cooperstock admitted that he transformed elements of the United Logo when creating the Untied Logo.

[55] With respect to the Frowning Globe Design, the Defendant took the entirety of the Globe Design and covered it with a frown to create the Frowning Globe Design. The Defendant admitted that he was aware that the Globe Design was from the United Website when he appropriated it. Prior to 2012, the frown was in the same shade of “United blue” as the background of the design.

(f) *Surrounding Circumstances and Conclusion*

[56] UNTIED.com is clearly designed to evoke the general appearance of the United Website, including the trademarks. In *Source Perrier SA v Fira-Less Marketing Co*, [1983] 2 FC 18, 70 CPR (2d) 61, 1983 CarswellNat 23 (WL Can) (TD) [*Source Perrier* cited to CarswellNat], Justice Dubé acknowledged that in certain cases a defendant’s use of marks may in fact be designed to cause confusion:

[10] ... To the eyes of the ordinary purchaser, the “Pierre Eh!” bottle definitely resembles the Perrier bottle. The size and colour of the bottles, the positioning and colour of the yellow labels on the bottles, the similar typeface of the trade marks, and the similarity in appearance and pronunciation of “Perrier” and “Pierre Eh!”, are **not only likely to cause confusion but are obviously meant to cause confusion. Otherwise, the spoof would not be a spoof. In such cases of obvious imitation what imports is not the small print but the general appearance of the product.**

[Emphasis added]

[57] Similarly, in this case, the Defendant's obvious imitation of the United Marks and the United Website is meant to cause visitors to associate UNTIED.com with the Plaintiff. The small details differentiating the marks are less important than the general appearance of the marks and of the websites.

[58] In addition, it is important to note that in his testimony, the Defendant attempted to differentiate the two Globe Design marks by "zooming in" on the image to show that his mark included a red frown. This would not be the approach of the hurried consumer with an imperfect recollection. Further, consumers would not be engaging in a side-by-side comparison of the two marks, particularly if they are unaware that there is any need to be diligent in this regard (i.e., if they are not aware that a "spoof" website exists).

[59] A plaintiff is not required to show actual confusion under s 20(1)(a) (*Veuve Clicquot* at para 6). However, evidence of actual confusion will be very weighty. If actual confusion is established, the standard for establishing that marks are confusingly similar – that is, would the marks likely be confusing – is clearly met.

[60] I find the evidence of Ms. Proietti in particular to be valuable and credible evidence of confusion. Ms. Proietti was clearly confused as to the source of the website that she visited and the services she sought: although she submitted a complaint on UNTIED.com, she believed that she was on the United Website. She also believed that the resulting e-mail from UNTIED.com originated with the Plaintiff.

[61] This evidence shows that the Defendant's use of the United Marks or confusingly similar marks conveys to the public the false and misleading impression that the services associated with UNTIED.com originate from the same source as the services associated with the Plaintiff's marks.

[62] However, even if the evidence of actual confusion is disregarded, I find that there was ample evidence adduced to support a finding that there is a likelihood of confusion. The complaints submitted to UNTIED.com show that Canadian consumers submit complaints with requests for action and resolution that would only be within the power of a United customer care employee. The Plaintiff introduced a number of these complaints, which had been produced by the Defendant as part of his production obligations, into evidence. Several of these examples were of visitors to UNTIED.com who had submitted multiple complaints, with later complaints citing the reference numbers assigned by UNTIED.com and complaining that no action had yet been taken by the Plaintiff. In response, the Defendant introduced a number of complaints into evidence in an attempt to show that the "tone of the complaints" had not changed over time. By his own admission, these complaints indicated that visitors to UNTIED.com were submitting complaints to the Defendant's website which were addressed to the Plaintiff and which requested assistance from the Plaintiff. During cross-examination on one such complaint, the Defendant himself acknowledged that "clearly this customer is confused".

[63] The Defendant relied on the complaints to show that visitors to UNTIED.com have always interacted with his website in the same manner. The Defendant argued that the redesign of the website and the "parodical" marks displayed on UNTIED.com could not be the source of

any alleged confusion, as complaints to UNTIED.com have exhibited the same tone since UNTIED.com was first launched. He adduced evidence of complaints dated as early as 1998 which were addressed to the Plaintiff and which requested relief from the Plaintiff. The Defendant suggested that complaints “intended to go to the Plaintiff” are received through UNTIED.com because UNTIED.com solicits complaints and forwards them to the Plaintiff.

[64] The Defendant was therefore attempting to use this evidence as a shield against the Plaintiff’s argument of confusion. However, these complaints are also a “sword” in that they are evidence of at least a likelihood of confusion. Although the Court does not rely on these complaints for the truth of their contents, the tone of these complaints points to a likelihood of confusion. This evidence establishes that the marks on UNTIED.com would likely be recognized by the public as an indication of the source of the website.

[65] Further, the unchanged tone of the complaints does not establish that visitors to UNTIED.com were not confused. If it establishes anything, it is that visitors are and have always been confused by the similarity between the domain names www.untied.com and www.united.com. Further, the fact that the complaints were forwarded to the Plaintiff after being submitted to UNTIED.com does not serve to obviate the confusion experienced by visitors to UNTIED.com and, in fact, this only further establishes that visitors would perceive a connection between the Plaintiff and UNTIED.com.

[66] The Defendant argued at trial that the liberal use of disclaimers and distinguishing additions to the marks (e.g., the frown on the Frowning Globe Design and the reversed T and I

on the Untied Logo, both in red) obviated any danger of confusion. Quite apart from the question of whether the use of disclaimers is a defence to trademark infringement, this was clearly not the case: the evidence of Ms. Proietti and of the complaints submitted to UNTIED.com showed that visitors to UNTIED.com were or were likely to be confused as to the source of the website that they were visiting and the services offered through that website. Further, the pop-up dialogue box disclaimer was flawed in that it could be disabled and it was not always functional – Ms. Proietti indicated that she did not see a pop-up dialogue box when she visited the website. If the “Do not show this message again” box is selected then subsequent visitors to UNTIED.com from the same computer will not see the pop-up dialogue, and this box has been pre-selected at certain points in time.

[67] The Defendant put forward an expert on data extraction and analysis, Mr. Hall, who testified that the percentage of complaints showing non-redacted MileagePlus numbers had remained relatively static since 1998 – this was meant to establish that visitors were not confused by the redesign of the UNTIED.com website. I give little weight to the evidence of Mr. Hall. Even if the questions as to the reliability of the data are put aside and Mr. Hall’s conclusions are accepted as accurate, they amount to very little. Mr. Hall’s analysis did not take into account a number of other personal identifiers that were posted on UNTIED.com, such as addresses and telephone numbers. Based on Mr. Hall’s evidence, it is impossible to reach any conclusions with respect to whether people were or were likely to be confused by the redesign of UNTIED.com.

[68] As noted above, the Defendant intended that UNTIED.com would evoke the United Website and the United Trademarks. Although the Defendant’s intent is not determinative in an

action under s 20(1), “[h]istorically, courts have been slow to conclude that a demonstrated piratical intent has failed to achieve its purpose” (*Mattel* at para 90). While intent is not determinative in that its absence is not a defence to trademark infringement, its presence can be a relevant factor – in this case, the Defendant intended that visitors to his website would identify his symbols and name with the Plaintiff. His efforts serve no other useful purpose. The changes that the Defendant made to the United Marks were small and were designed to maintain his core purpose: identification of his website with United. In this case, the Defendant sailed too close to the wind – and he was put up on the rocks.

(5) Authorization

[69] There was no disagreement that the Defendant was not authorized to use the Plaintiff’s registered marks.

(6) Conclusion on s 20(1)(a)

[70] Based on the analysis above, the Defendant’s use of confusingly similar marks in association with pre-flight and post-flight customer service constitutes infringement of the Plaintiff’s registered trademarks contrary to s 20(1)(a).

B. *Passing Off*

[71] The Plaintiff argues that the Defendant’s actions are contrary to ss 7(b) and 7(c) of the *Trade-marks Act*:

<p>7 No person shall</p> <p>...</p> <p>(b) direct public attention to his goods, services or business in such a way as to cause or be likely to cause confusion in Canada, at the time he commenced so to direct attention to them, between his goods, services or business and the goods, services or business of another;</p> <p>(c) pass off other goods or services as and for those ordered or requested[.]</p>	<p>7 Nul ne peut :</p> <p>[...]</p> <p>b) appeler l'attention du public sur ses produits, ses services ou son entreprise de manière à causer ou à vraisemblablement causer de la confusion au Canada, lorsqu'il a commencé à y appeler ainsi l'attention, entre ses produits, ses services ou son entreprise et ceux d'un autre;</p> <p>c) faire passer d'autres produits ou services pour ceux qui sont commandés ou demandés;</p>
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[72] The statutory and common law causes of action for “passing off” both require three elements: “the existence of goodwill, deception of the public due to a misrepresentation and actual or potential damage to the plaintiff” (*Ciba-Geigy Canada Ltd v Apotex Inc*, [1992] 3 SCR 120, 1992 CarswellOnt 1007 (WL Can) at para 33 [*Ciba-Geigy*]).

(1) Goodwill or Reputation

[73] Goodwill was described in *Veuve Clicquot* as “the positive association that attracts customers towards its owner’s wares or services rather than those of its competitors” (para 50). In *Ciba-Geigy*, the Supreme Court indicated to succeed in an action for passing off, a plaintiff must show that its product has acquired a secondary meaning (para 36).

[74] In *Veuve Clicquot*, the Supreme Court laid out factors for determining the existence of goodwill as follows:

[54] While “fame” is not a requirement of s. 22, a court required to determine the existence of goodwill capable of depreciation by a “non-confusing” use (as here) will want to take that approach into consideration, as well as more general factors such as the degree of recognition of the mark within the relevant universe of consumers, the volume of sales and the depth of market penetration of products associated with the claimant’s mark, the extent and duration of advertising and publicity accorded the claimant’s mark, the geographic reach of the claimant’s mark, its degree of inherent or acquired distinctiveness, whether products associated with the claimant’s mark are confined to a narrow or specialized channel of trade, or move in multiple channels, and the extent to which the mark is identified with a particular quality. See generally F.W. Mostert, *Famous and Well-Known Marks: An International Analysis* (1997), at pp. 11-15; Protection of Well Known Marks in the European Union, Canada and the Middle East, INTA, (October 2004).

[75] Consideration of these general factors indicates that the United Marks have a large and significant amount of goodwill attached to them. Goodwill or reputation may be shown through, among other things, acquired distinctiveness, length of use (the Plaintiff has been using the trademarks at issue since 1939 and 1995), sales (United had over \$37 billion USD in operating revenue in 2015), advertising and marketing (illustrated by the Plaintiff’s advertising campaigns and branding efforts), and intentional copying. These elements were described in more detail above with regard to the factors in the analysis under s 6(5) of the *Trade-marks Act*.

[76] The Plaintiff operates around 200 flights per day in Canada, carrying around 11,000 passengers. Globally, it operates over 4,500 daily flights carrying around 375,000 passengers. It devotes significant resources to its branding strategy and carefully controls the consumer experience of its branded spaces, including the colours used, the spacing between marks (and between letters), the symbols used, the type of font used, and the placement of its trademarks and colours. It has an extensive advertising strategy, deploying advertisements in Canadian airports

and in publications that showcase the United Trademarks and the Plaintiff's offerings. For 2015, the Plaintiff listed the value of its goodwill as \$4.5 billion USD in its Form 10-K annual report, including \$593 million USD for tradenames and logos.

[77] The Plaintiff put forward an expert, Mr. Buffo, to provide evidence on the existence of goodwill. I find that this evidence does not contribute a great deal to a finding of the presence of goodwill. I was troubled by the fact that Buffo acknowledged that it was important to solicit the input of customers, and yet he did not attempt to do this (or to explain his failure to do this) in his Expert Report. He relied on "studies", but could not recall how those "studies" chose their lists of most admired companies (even though he claimed that they did "detailed analysis"). I also found his responses during cross-examination to be evasive. However, I do give some weight to his acknowledgement that branding and advertising takes on an additional importance in the case of undifferentiated products such as flights or hotel accommodations.

[78] I am satisfied that there is significant goodwill attached to the Plaintiff's trademarks, and I reject the Defendant's contention that the evidence put forward was insufficient to establish the presence of goodwill.

(2) Deception of the Public due to Misrepresentation

[79] In *Mattel*, the Supreme Court indicated that the misrepresentation aspect of the second requirement is in relation to the source of the goods or services: in the context of that case, "[i]n an action for passing off, it would have been necessary for the appellant to show that the respondent restaurateur intentionally or negligently misled consumers into believing its

restaurant services originated with the appellant and that the appellant thereby suffered damage” (para 27). There is no requirement that the misrepresentation be wilful.

[80] The list of ways in which a defendant may misrepresent its goods or services is not closed. A common form of misrepresentation is where a defendant uses an imitation of a symbol, trademark, or get-up associated with a plaintiff; this is the manner of misrepresentation in this case, which has the impact of causing confusion in the public as to the source of the services available through UNTIED.com.

[81] In *Asbjorn Horgard A/S v Gibbs/Nortac Industries Ltd*, [1987] 3 FC 544, 14 CPR (3d) 314, 1987 CarswellNat 643 (WL Can) at para 44 (CA) [*Asbjorn*], the Federal Court of Appeal indicated that confusion can be assessed by looking to the factors in s 6(5) of the *Trade-marks Act*. This likelihood of confusion must be established as of the time that the defendant commenced directing attention to its wares, services, or business (*Asbjorn* at para 40).

[82] The Defendant argued that if Ms. Proietti’s testimony is the only evidence of confusion, then there is no confusion. However, the Plaintiff is not required to show that a majority of customers are confused. In *Canada Post Corp v Paxton Developments Inc*, 198 FTR 72, 9 CPR (4th) 429, 2000 CarswellNat 3003 (WL Can) at para 12 (TD), in the context of trademark opposition, Justice Pelletier indicated that “[i]t is sufficient that a substantial number of consumers, more than enough to pass any *de minimis* threshold but less than a majority, be confused or be likely to be confused”. Further, the evidence of confusion, discussed in more

detail above, was not limited to the testimony of Ms. Proietti, although that evidence carried significant weight.

[83] As parody and satire are not defences to trademark infringement, the addition of the frown to the Frowning Globe Design on UNTIED.com does not avoid trademark infringement or passing off (*Source Perrier* at para 20). In *Green v Schwarz*, 12 CPR (3d) 84, 1 ACWS (3d) 401, 1986 CarswellOnt 877 (WL Can) (H Ct J), the Ontario High Court of Justice found confusion in a case wherein the defendant was attempting to “spoof” the plaintiff’s trademark:

[4] ... True enough, on closer examination, one can see that there is an element of the spoof or the humorous take-off of the plaintiff’s trade mark in the words and figure appearing on the defendant’s product.

[5] I am satisfied that notwithstanding that the defendant is obviously spoofing the plaintiff’s trade mark he is also cashing in on the goodwill that the plaintiff has obtained for its trade mark. I am satisfied that based upon many years in trade the plaintiff has had attached in the public perception to the word “Roots” in its stylistic configuration associated with the depiction of a beaver, a significant measure of goodwill. ...

[84] As discussed above, a review of the factors in s 6(5) of the *Trade-marks Act* demonstrates that there was confusion and the likelihood of confusion in this case.

[85] Therefore, I find that the Defendant misled visitors to UNTIED.com as to the source of the services available on that website.

(3) Damages

[86] In *Ciba-Geigy*, the Supreme Court indicated that proof of damages encompasses actual or potential damages (para 33). However, damages cannot simply be presumed; there must be some evidence of “proof of actual damage or the likelihood of damage” (*Remo Imports Ltd v Jaguar Cars Limited*, 2007 FCA 258 at para 90, [2008] 2 FCR 132). There is no limit on the types of damages that may be considered under this element. Loss of control over a mark, for example, may constitute damage. Further, some cases have suggested that the likelihood of confusion will lead inexorably to a finding of the probability of damage (see, for example, *Noshery Ltd v Penthouse Motor Inn Ltd*, 61 CPR 207, 1969 CarswellOnt 44 (WL Can) at para 25 (SC)).

[87] The Plaintiff relied heavily on the link between the likelihood of confusion and the probability of damages. However, the Plaintiff also identified the depreciation of goodwill as a harm that it has suffered. It also argued that the barrier UNTIED.com created between the Plaintiff and its customers was harmful. In addition, Mr. Buffo indicated that if a customer was confused and mistakenly posted a complaint to UNTIED.com, then this was a lost opportunity for the Plaintiff to resolve the complaint and turn an unfavourable experience into a memorable one. Further, damages may occur in the form of “tarnishing” the Plaintiff’s brand (discussed further below).

[88] In my view, the evidence establishes that the Plaintiff has suffered damages or is likely to suffer potential damages.

(4) Conclusion on ss 7(b) and 7(c)

[89] Therefore, for all of these reasons, I find that the Defendant has acted contrary to ss 7(b) and 7(c) of the *Trade-marks Act*.

C. *Depreciation of Goodwill*

[90] There are four elements to consider in the analysis of the depreciation of goodwill pursuant to s 22 of the *Trade-marks Act*: the use of a plaintiff's registered trademark by a defendant in connection with wares or services, the presence of goodwill attached to the trademark, the plaintiff's trademark was used in such a way as to have a likely effect on that goodwill (i.e., linkage), and the likely impact would be to depreciate the value of the goodwill (i.e., damage) (*Veuve Clicquot* at para 46).

(1) Use

[91] As discussed in detail above, the Defendant has made use of the Plaintiff's registered trademarks on UNTIED.com.

(2) Goodwill

[92] As discussed in detail above, there is goodwill in the United Marks.

(3) Effect/Linkage

[93] The third requirement, linkage, is assessed from the perspective of a somewhat-hurried consumer; for example, in the case of *Veuve Clicquot*, “[i]f the somewhat-hurried consumer does not associate what is displayed in the respondents’ stores with the mark of the venerable champagne maker, there can be no impact - positive or negative - on the goodwill attached to VEUVE CLICQUOT” (para 56). This is not a speculative exercise and evidence must be produced to show that the trademarks in question were used in such a way as to have an impact on goodwill.

[94] Confusion is not a required element of s 22. However, in my view, the evidence of confusion put forward in this case establishes that customers would be likely to “associate” the marks on the United Website and the marks on UNTIED.com. As discussed above, the evidence of Ms. Proietti was that she associated the marks on UNTIED.com with United – in fact, she believed that she was on the United Website when she was actually on UNTIED.com.

[95] In *Future Shop Ltd v A & B Sound Ltd*, 93 BCLR (2d) 40, 55 CPR (3d) 182, 1994

CarswellBC 267 (WL Can) (SC), the British Columbia Supreme Court stated:

[12] The question, depending on the evidence in any particular case, is whether the use of the competitor’s trademark is for a purpose which stresses the similarities or the differences with the trademarked competition. If the purpose is to stress the similarities, the value of the goodwill associated with the trademark is appropriated in a manner contrary to the intent of s. 22. If use stresses the differences with the trademark, then the use is for the purpose of distancing the trademarked ware or service and s. 22 is not offended.

[96] It is clear that the Defendant intended to stress the similarities between the United Marks and his own. In his testimony, he indicated that he “transformed elements of United’s logo and I made changes to it... I would say that my purpose was to identify the target of my criticism as that of United”. The Defendant therefore appropriated the goodwill associated with the United Marks.

[97] In my view, the somewhat-hurried consumer would be likely to associate the marks displayed on the Defendant’s website with the Plaintiff’s registered trademarks.

(4) Depreciation

[98] The final requirement, likelihood of depreciation, was described in *Veuve Cliquot* thus:

[63] The word “depreciate” is used in its ordinary dictionary meaning of “lower the value of” as well as to “disparage, belittle, underrate”: *The New Shorter Oxford English Dictionary* (5th ed. 2002), at p. 647. In other words, disparagement is a possible source of depreciation, but the value can be lowered in other ways, as by the lesser distinctiveness that results when a mark is bandied about by different users. Although the appellant makes much of the licencing provisions in the Act, the fact is that a trade-mark owner can depreciate its value by spreading the mark too thinly over too many products of differing quality. ...

...

[67] These references to U.S. cases are made for the purpose of illustration. Our Act is differently worded and I do not suggest that the concept of “depreciation” in s. 22 is necessarily limited to the notions of blurring and tarnishment. Canadian courts have not yet had an opportunity to explore its limits. Nevertheless, the key question remains. Acknowledging that the VEUVE CLICQUOT trade-mark carries an aura beyond its particular products, and that the extended aura carries significant goodwill, in what way is the value of that goodwill likely to be diminished by the respondents’ “use” (if use there be) of the appellant’s registered trade-mark? Acceptance of the argument that depreciation *could* occur, is not

acceptance of the assertion that on the facts of this case depreciation is *likely* to occur, still less that depreciation *did* occur. The appellant need only prove *likelihood* but there is nothing in the evidentiary record from which likelihood could be inferred.

[99] The Defendant's position at trial was that any depreciation of goodwill caused by UNTIED.com was not attached to the attractive force of the United Marks, but rather to the Plaintiff's business reputation. He argued that it was "ludicrous" to suggest that the Plaintiff has experienced depreciation of goodwill due to his actions, and argued that the evidence of goodwill adduced did not establish that there was goodwill associated with the Plaintiff's logo, its name, or its image.

[100] In my view, the Plaintiff has established that there is a likelihood of depreciation of goodwill. The Defendant reproduces and disparages the Plaintiff's registered trademarks on UNTIED.com, as shown by the "frown" on the Globe Design (and the "angry eyes" on the Globe Design on the beta website). Further, the crudeness of UNTIED.com is likely to depreciate the goodwill of United's marks. In *Thoi Bao Inc v 1913075 Ontario Limited (Vo Media)*, 2016 FC 1339 at para 38, 275 ACWS (3d) 375, Justice McDonald found, similarly, that "Mr. Vo used the THOI BAO's trade-mark for the name of a website of inferior quality, which projects an unprofessional character which is therefore likely to depreciate the value of the goodwill attached to TB Inc.'s trade-mark". The unprofessional nature of the Defendant's website similarly tarnishes the goodwill attached to United's trademarks.

[101] Further, the Defendant's use of marks confusingly similar to the United Marks decreases the distinctiveness of the United Marks. The similarities between the United Marks and the

Untied Marks is likely to confuse some members of the public and may discourage others from continuing their search for the Plaintiff's customer service website due to anger, frustration, or the mistaken belief that the Plaintiff does not have a "complaints" page.

(5) Conclusion

[102] Therefore, I find that the Defendant has intentionally attempted to attract the Plaintiff's online consumers to his own website for notoriety. In doing so, he has depreciated the value of goodwill attached to the United Trademarks contrary to s 22 of the *Trade-marks Act*.

D. *Copyright Infringement*

(1) Infringement

[103] In a copyright infringement claim, the plaintiff must establish that its copyrighted work is original, that the defendant has copied from that work, and that a substantial portion of the work has been reproduced. The first of these elements have clearly been met in this case: the Defendant admitted that the development of a website design would require skill and judgment, and the United Website is therefore "original" within the meaning of the *Copyright Act*. Similarly, it would have required skill and judgment to create the Globe Design and the United Logo. With respect to the second element, the Defendant admitted that he knew the Globe Design originated from the United Website and that the design of UNTIED.com was intended to humorously "mimic" that of the United Website. There would be no other purpose for the use of similar colours, fonts, layout, and other elements of the United Website on UNTIED.com.

[104] Finally, in order to constitute copyright infringement, the infringer must have produced or reproduced a “substantial part” of the copyrighted material. This phrase is not defined in the *Copyright Act*, but in *Michelin* the Court emphasized that this is a question of quality rather than simply one of quantity (para 54). In *Warman v Fournier*, 2012 FC 803, 104 CPR (4th) 21, Justice Rennie stated:

[23] ... Whether a substantial part of a work has been reproduced is a question of fact and involves a qualitative rather than quantitative analysis. The relevant factors to be considered include:

- a. the quality and quantity of the material taken;
- b. the extent to which the respondent’s use adversely affects the applicant’s activities and diminishes the value of the applicant’s copyright;
- c. whether the material taken is the proper subject-matter of a copyright;
- d. whether the respondent intentionally appropriated the applicant’s work to save time and effort; and
- e. whether the material taken is used in the same or a similar fashion as the applicant’s: *U & R Tax Services Ltd v H & R Block Canada Inc*, [1995] FCJ No 962, at para 35.

[105] In this case, it is clear that substantial copying has taken place. The Defendant has reproduced the entirety of the United Logo and the Globe Design, with some small additions or changes, and he also admits that the overall layout of the two websites is similar.

(2) Fair Dealing

[106] In *CCH Canadian Ltd v Law Society of Upper Canada*, 2004 SCC 13, [2004] 1 SCR 339 [*CCH*], the Supreme Court of Canada laid out a two-step test for determining whether use of

copyrighted material comes within the fair dealing exception: firstly, the defendant must show that the dealing is for an allowable purpose (limited, at the time, to research or private study), and, secondly, the defendant must show that the dealing is fair.

[107] More recently, in *Socan v Bell Canada*, 2012 SCC 36, [2012] 2 SCR 326 [*Socan*], the Court affirmed that the provision for fair dealing should not be interpreted restrictively, and stated that “*CCH* confirmed that users’ rights are an essential part of furthering the public interest objectives of the *Copyright Act*” (para 11).

[108] The Supreme Court noted that the American approach and American jurisprudence cannot automatically be imported into the Canadian context given the differences between “fair dealing” in Canada and “fair use” in the United States, because “[u]nlike the American approach of proceeding straight to the fairness assessment, we do not engage in the fairness analysis in Canada until we are satisfied that the dealing is for one of the allowable purposes enumerated in the *Copyright Act*” (*Socan* at para 26).

(a) *Is the dealing for an allowable purpose?*

[109] Parody is now an allowable purpose under s 29 of the *Copyright Act*, which states:

29 Fair dealing for the purpose of research, private study, education, parody or satire does not infringe copyright.

29 L’utilisation équitable d’une oeuvre ou de tout autre objet du droit d’auteur aux fins d’étude privée, de recherche, d’éducation, de parodie ou de satire ne constitue pas une violation du droit d’auteur.

[110] However, the legislation is silent as to the content, meaning, or scope of “parody”. Therefore, the words of the legislation must be “read in their entire context and in their grammatical and ordinary sense harmoniously with the scheme of the Act, the object of the Act, and the intention of Parliament” (Elmer Driedger, *Construction of Statutes*, 2d ed (Toronto: Butterworths, 1983) at 87, cited in *Rizzo & Rizzo Shoes Ltd (Re)*, [1998] 1 SCR 27 at para 21).

[111] In *CCH*, the Court commented on the purpose of the fair dealing provisions within the *Copyright Act*, emphasizing the importance of balance between the rights of creators or authors and those of users:

[48] Before reviewing the scope of the fair dealing exception under the *Copyright Act*, it is important to clarify some general considerations about exceptions to copyright infringement. Procedurally, a defendant is required to prove that his or her dealing with a work has been fair; however, the fair dealing exception is perhaps more properly understood as an integral part of the *Copyright Act* than simply a defence. Any act falling within the fair dealing exception will not be an infringement of copyright. The fair dealing exception, like other exceptions in the *Copyright Act*, is a user’s right. In order to maintain the proper balance between the rights of a copyright owner and users’ interests, it must not be interpreted restrictively. As Professor Vaver, *supra*, has explained, at p. 171: “User rights are not just loopholes. Both owner rights and user rights should therefore be given the fair and balanced reading that befits remedial legislation.”

[112] The *Concise Canadian Oxford Dictionary* defines “parody” thus:

... **1 a** humorous exaggerated imitation of an author, literary work, style, etc., esp. for purposes of ridicule. **b** a work of this kind. **2 a** thing done so badly that it seems to be an intentional mockery of what it should be; a travesty. **3** a comic or satirical imitation of a person, event, etc. ...

(Katherine Barber & Robert Pontisso, eds, *Concise Canadian Oxford Dictionary* (Don Mills, ON: Oxford University Press, 2005) at 974)

[113] In the Canadian context, parody was not an exception to copyright infringement prior to the introduction of the parody exception in s 29. Plaintiffs who attempted to argue that parody could be included within the realm of “criticism” were unsuccessful – for example, in *Michelin*, Justice Teitelbaum rejected the notion that criticism was synonymous with parody.

[114] The Quebec Court of Appeal commented on the meaning of parody in *Productions Avanti Ciné-Vidéo Inc c Favreau*, 177 DLR (4th) 568, 1 CPR (4th) 129 (QC CA) [*Favreau* cited to DLR]. Justice Rothman, in concurring reasons, described parody thus (at 575):

Parody normally involves the humorous imitation of the work of another writer, often exaggerated, for purposes of criticism or comment. Appropriation of the work of another writer to exploit its popular success for commercial purposes is quite a different thing. It is no more than commercial opportunism. The line may sometimes be difficult to trace, but courts have a duty to make the proper distinctions in each case having regard to copyright protection as well as freedom of expression.

[Emphasis added.]

[115] In *Favreau*, parody was contrasted with imitation of a work that is done simply to capitalize on the success of the source work or to gain commercial benefit, as was the case with the pornographic *La Petite Vite* capitalizing on the success of *La Petite Vie*.

[116] A number of jurisdictions preceded Canada in recognizing a parody exception to copyright infringement. In the seminal case of *Campbell v Acuff-Rose Music, Inc*, 510 US 569, 1994 US LEXIS 2052 [*Campbell*], the Supreme Court of the United States made a number of useful comments on the meaning of parody. However, this decision should be used cautiously

considering the differences between fair use in the United States and fair dealing in Canada. The Supreme Court of the United States observed:

The germ of parody lies in the definition of the Greek *parodeia*, quoted in Judge Nelson's Court of Appeals dissent, as "a song sung alongside another." 972 F. 2d, at 1440, quoting 7 Encyclopedia Britannica 768 (15th ed. 1975). Modern dictionaries accordingly describe a parody as a "literary or artistic work that imitates the characteristic style of an author or a work for comic effect or ridicule," or as a "composition in prose or verse in which the characteristic turns of thought and phrase in an author or class of authors are imitated in such a way as to make them appear ridiculous." **For the purposes of copyright law, the nub of the definitions, and the heart of any parodist's claim to quote from existing material, is the use of some elements of a prior author's composition to create a new one that, at least in part, comments on that author's works.** See, e. g., *Fisher v. Dees*, *supra*, at 437; *MCA, Inc. v. Wilson*, 677 F. 2d 180, 185 (CA2 1981). If, on the contrary, the commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another's work diminishes accordingly (if it does not vanish), and other factors, like the extent of its commerciality, loom larger. Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim's (or collective victims') imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing. See *ibid.*; Bisceglia, Parody and Copyright Protection: Turning the Balancing Act Into a Juggling Act, in ASCAP, Copyright Law Symposium, No. 34, p. 25 (1987).

[Footnotes omitted; emphasis added.]

[117] In *Deckmyn v Vandersteen* (2014), Case C 201/13 (Court of Justice of the EU)

[*Deckmyn*], the Court of Justice of the European Union considered the scope of a parody exception to copyright infringement in the EU Copyright Directive and in Belgian law. The Court of Justice of the European Union considered whether a parody must satisfy characteristics such as displaying originality, displaying its character in such a way that the parody could not

reasonably be attributed to the author of the source work, having a purpose of humour or mockery, or mentioning the source of the work.

[118] Since the Copyright Directive did not provide a definition for parody, the Court of Justice of the European Union concluded that it should look to the meaning of the term in everyday language, the essential characteristics of which are “first, to evoke an existing work while being noticeably different from it, and, secondly, to constitute an expression of humour or mockery” (*Deckmyn* at para 20). The Court of Justice of the European Union found that the everyday use of “parody” as well as the language of the Belgian legislation and the EU Copyright Directive did not indicate that parody should be subject to the additional requirements described above.

[119] I find that the definition of parody used by the European Court of Justice is consistent with the ordinary meaning of the term, the purpose and scheme of the fair dealing provisions in the *Copyright Act*, and the intention of Parliament. Parody should be understood as having two basic elements: the evocation of an existing work while exhibiting noticeable differences and the expression of mockery or humour. I would also note that the fair dealing exception for the purpose of parody in s 29 of the *Copyright Act* does not require a user to identify the source of the work being parodied. In addition, in my view, parody does not require that the expression of mockery or humour to be directed at the exact thing being parodied. It is possible, for example, for a parody to evoke a work such as a logo while expressing mockery of the source company, or to evoke a well-known song while expressing mockery of another entity entirely.

[120] In my view, UNTIED.com falls within the definition of parody described above: it evokes existing works (the United Website, the United Logo, and the Globe Design) while showing some differences (such as content and disclaimers), and it expresses mockery (and criticism) of the Plaintiff. Therefore, the first stage of the *CCH* test has been met in this case.

(b) *Is the dealing fair?*

[121] In *CCH*, the Supreme Court approved six factors that can be used as an analytical framework in determining whether a dealing is “fair” under s 29: “(1) the purpose of the dealing; (2) the character of the dealing; (3) the amount of the dealing; (4) alternatives to the dealing; (5) the nature of the work; and (6) the effect of the dealing on the work” (para 53). Fairness is a question of fact that depends on the context of each case (*Socan* at para 32).

(i) The Purpose of the Dealing

[122] In *CCH*, the Supreme Court indicated that the allowable purposes should not be restrictively interpreted so as to unduly limit the rights of users; however, “courts should attempt to make an objective assessment of the user/defendant’s real purpose or motive in using the copyrighted work” (para 54). This should include considerations of whether there is some sort of “ulterior motive” behind the dealing (*Alberta (Education) v Canadian Copyright Licensing Agency (Access Copyright)*, 2012 SCC 37 at para 23, [2012] 2 SCR 345).

[123] I would note that it is questionable whether the parody exception may successfully be invoked when there is confusion. Parody depends on the recipient or viewer recognizing that the

work in question is a spoof – therefore, it will be difficult to establish that the true purpose of a given work is parody when it is confusingly similar to the original work.

[124] As the Defendant pointed out during the trial, UNTIED.com has long claimed to be a “parody” website. However, the Defendant did not satisfy the Court that there was ever any intent for humour – rather, the Defendant’s intent was to embarrass and punish United for its perceived wrongdoings. As discussed above, parody must include some element of humour or mockery – if extended too far, what may be designed in jest as parody may simply become defamatory.

[125] Therefore, I find that the Defendant’s real purpose or motive in appropriating the copyrighted works was to defame or punish the Plaintiff, not to engage in parody.

(ii) The Character of the Dealing

[126] This factor requires courts to consider “how the works were dealt with” including whether the material was widely distributed or used for a specific purpose, if the copy was destroyed following use, and if there are any specific practices or customs in the relevant industry (*CCH* at para 55).

[127] In this case, the works were published online. They were made available to any person with internet access and were likely widely distributed (although there was no evidence adduced as to website traffic).

(iii) The Amount of the Dealing

[128] In *CCH*, the Supreme Court stated that “[b]oth the amount of the dealing and importance of the work allegedly infringed should be considered in assessing fairness” (para 56). As fair dealing is a right of the user, this should “be assessed based on the individual use, not the amount of the dealing in the aggregate” (*Socan* at para 41).

[129] The amount of dealing is substantial. The Defendant has copied the entirety of the home page of the Plaintiff’s website (as it then was) including colours, layout, some functionality/movement, and logos. The work is also extremely important – Mr. Wilson indicated that the consumer’s interaction with United’s digital platforms is crucial, stating:

I’ve worked for a lot of very large companies and branding is a key part of any company’s representation of itself to the consumer. It’s extremely important for United because often times, especially in today’s day and age, the first interaction you have with United Airlines is through its digital channels.

In fact, a ratio that we tend to use very often at work and it’s roughly correct, if not absolutely correct for every individual, you’ll have 10 digital interactions with United Airlines before you actually get on your flight to wherever it is that you are going to go.

...

And then post-flight, and this is the important thing I think for this case, especially so is relationship management and that could be formalized through the Mileage Plus Program that we have and the way that you can earn miles and status with United Airlines. But equally if not of greater importance is our ability to provide customer service and resolution when things do go wrong.

We have a number of mechanisms by which consumers can go on to united.com and either ask questions or submit concerns and try to get resolution on those.

[130] This factor therefore weighs heavily in favour of a finding of unfairness.

(iv) Alternatives to the Dealing

[131] In *CCH*, the Supreme Court indicated that alternatives to the dealing such as the potential use of non-copyrighted equivalents to the work ought to be considered. The Supreme Court affirmed that alternatives should be understood with reference to the purpose of the dealing, stating:

[57] ... I agree with the Court of Appeal that it will also be useful for courts to attempt to determine whether the dealing was reasonably necessary to achieve the ultimate purpose. For example, if a criticism would be equally effective if it did not actually reproduce the copyrighted work it was criticizing, this may weigh against a finding of fairness.

[132] When considering parody, available alternatives to the dealing cannot be weighed too heavily. This is because although alternatives may be available, they may not be as effective in meeting the goals of parody (i.e., mocking or criticizing in a humorous manner). In this case, the appropriate question would seem to be this: would the Defendant's use of alternative logos and website design be as effective in mocking and criticizing the Plaintiff? In fact, the Defendant acknowledged that there were alternatives to the dealing, but argued that his criticism would be less humorous and less effective if he made use of such alternatives.

[133] However, in my view, alternatives to the current design of UNTIED.com would be effective in meeting the goals of the website, if the overall purpose of the website is to be properly understood as collating complaints about the Plaintiff, offering passengers a resource for understanding their rights, and pressuring the Plaintiff to provide more effective customer

service. It is unclear why substantial copying of the United Website or the other copyrighted works was necessary in order to meet the parodic goal of humorously criticizing the Plaintiff; as discussed above, parody requires humour, whereas the Defendant's website was simply mean-spirited. The minimal use of certain parodic elements in the past (i.e., "fly the unfriendly skies" and the wordplay between "united" and "untied") present an example of an alternative to the current dealing. Indeed, if the Defendant truly wished the best outcome for the Plaintiff's passengers, it is unclear why he would run any risk of confusing passengers.

[134] Prior to the redesign of the website, UNTIED.com was able to fulfill its purpose without substantial copying of the United Website. Therefore, I find that this factor weighs against a finding of fairness.

(v) The Nature of the Work

[135] In *CCH*, the Supreme Court indicated that the nature of the work should be considered, giving the examples of published, unpublished, and confidential works. This factor "examines whether the work is one which should be widely disseminated" (*Socan* at para 47).

[136] The United Website was published online and available openly to the public, as was UNTIED.com.

(vi) The Effect of the Dealing on the Work

[137] The Supreme Court in *CCH* stated that courts must consider the effect of the dealing, such as competition with the original in the market.

[138] In this case, it is not the effect on the market that ought to be considered, but rather the confusion caused by the similarity between UNTIED.com and the United Website. As such, it may be useful to consider the comments of the Supreme Court of the United States in *Campbell*:

We do not, of course, suggest that a parody may not harm the market at all, but when a lethal parody, like a scathing theater review, kills demand for the original, it does not produce a harm cognizable under the Copyright Act. Because “parody may quite legitimately aim at garroting the original, destroying it commercially as well as artistically,” B. Kaplan, *An Unhurried View of Copyright* 69 (1967), the role of the courts is to distinguish between “[b]iting criticism [that merely] suppresses demand [and] copyright infringement[, which] usurps it.” *Fisher v. Dees*, 794 F. 2d, at 438.

[139] By analogy, criticism under s 29.1 of the *Copyright Act* might always aim to harm the market for or public opinion of the original work; however, it is nonetheless protected under the *Copyright Act*. The Defendant argued that it was not the “parodic elements” of his website that were harmful to United, but rather the criticism contained on the website.

[140] In my view, it is the substantial copying of the Plaintiff’s copyrighted material that is having a harmful impact, not the criticism contained on UNTIED.com. Negative commentary regarding the Plaintiff abounds on the internet. The Plaintiff is not so much concerned with the informational aspect of UNTIED.com (which may lead customers to purchase tickets with other

airlines) as it is with the potential that customers will believe they are interacting with the Plaintiff when they are actually interacting with UNTIED.com (which may, in turn, cause customers to believe that the Plaintiff is unprofessional or that it does not respond to complaints).

(3) Conclusion on Copyright Infringement

[141] Parody is not simply a defence to copyright infringement – it is also an aspect of free speech. However, like all free speech, it is not unrestricted. The Defendant’s website meets the first step of the *CCH* test, as it is for the allowable purpose of parody, but it does not meet the second step of the test. The questionable purpose of the dealing, amount of the dealing, and effect of the dealing all weigh in favour of the conclusion that this dealing is not fair.

E. *Abuse of Process*

[142] The Defendant invoked the defence of estoppel or acquiescence. He claimed that the Plaintiff knew about the Defendant’s alleged infringement and delayed from taking steps “year after year after year” and that this led the Defendant to believe that the Plaintiff would not enforce its rights against him. He further claimed that he had “taken steps and acted to [his] detriment” in relying on that belief. In *Canadian Memorial Services v Personal Alternative Funeral Services Ltd*, 182 FTR 28, 4 CPR (4th) 440, [2000] FCJ No 140 (QL) (TD) [*Canadian Memorial Services*], Justice Pelletier reviewed the jurisprudence on estoppel in trademark cases and indicated that mere delay would not support estoppel. Justice Pelletier stated that “[a]s in all cases where there is said to be a failure to enforce a right, there must be a clear knowledge of the right” (para 55). In that case, Justice Pelletier found that the plaintiff had knowledge of the

alleged infringement by the defendant and, instead of asserting its rights, it actually encouraged the defendant's use of the marks. The delay of four years in that case was not extraordinary on its face, but during that time period the defendants had made significant investments in the name and the mark. Therefore, Justice Pelletier concluded that the defence of acquiescence was established and it would be inequitable to allow the plaintiff to now assert its rights against the defendants to their detriment.

[143] In *Remo Imports Ltd v Jaguar Cars Ltd*, 2005 FC 870, 2005 CarswellNat 7479 (WL Can) [*Remo Imports FC*], Justice Shore stated that the defence of laches by acquiescence requires a defendant to establish:

[53] ...1. Something more than mere delay is required. Silence alone is not sufficient to bar a proceeding... 2. the rights holder must know of its right and must know of the other party's breach of that right... 3. the rights holder must encourage the other party to continue the breach... and 4. the other party must act to its detriment in reliance upon the encouragement by the rights holder[.] ...

[Citations omitted.]

[144] The passage of time alone is not sufficient for the denial of a remedy (*Remo Imports FC* at para 53).

[145] In my view, the Defendant has not made out the defence of estoppel or acquiescence. As noted by the Plaintiff, passage of time alone does not justify a remedy, and this is all that the Defendant has put forward to ground his claim. Further, the delay is not a delay of some fifteen years as claimed by the Defendant (since UNTIED.com launched in 1997), as the trademark and copyright infringement at issue in this case commenced with the redesigns of UNTIED.com in

2011 and 2012; therefore, the delay is of less than two years in pursuing litigation, and in the interim the Plaintiff acted to pursue a less litigious solution by contacting the Defendant and making its intellectual property rights known. Prior to the redesign of UNTIED.com, the design of the Defendant's website was sufficiently distinct from the United Website, such that visitors to UNTIED.com who were searching for the United Website could easily recognize they were in the wrong location and "self correct". Unlike the case of *Canadian Memorial Services* cited by the Defendant, the Plaintiff did not act in any manner that would "encourage" the Defendant to continue his breach.

[146] Further, in my view, laches is inapplicable because a statutory limitation applies in this case (*Remo Imports FC* at para 51).

F. *Re-Examination*

[147] The Defendant was self-represented in this trial. Although he ably presented his position, this caused something of a procedural difficulty in the examination and re-examination of his primary witness: himself. The Defendant creatively addressed this in his examination-in-chief by providing a list of questions to the Court and to opposing counsel to serve as something of a guide for his testimony. However, when it came time for re-examination, the Defendant clearly wanted to "cooper up" his case rather than to clarify it. Re-examination is predicated on the fact that the witness cannot speak to counsel once they are under cross-examination and until they are released from the witness box. A self-represented litigant would not face that limitation in re-examining himself or herself.

[148] In this case, given the way in which the litigation has been conducted including pre-trial, it was appropriate to limit the Defendant. The Defendant did not seek to clarify his evidence so much as to rebut and defend his evidence – this is inappropriate re-examination.

VI. Conclusion

[149] For these reasons, I find that the Defendant has infringed the Plaintiff's registered trademarks and copyright.

[150] The Plaintiff is entitled to an injunction restraining the Defendant's use of the United Marks and the copyrighted works. The Court retains jurisdiction over this matter to provide effective relief against the Defendant. The Defendant may retain the use of the domain name www.untied.com – however, this must not be in association with the same services as provided by the Plaintiff.

[151] The Parties shall have 45 days from the release of this judgment to provide written submissions to the Court as to the nature and scope of the injunction to be issued. Each submission shall be no more than 20 pages in length.

[152] The Parties are encouraged to settle the issue of costs directly. If the Parties cannot settle the issue of costs, they shall have 45 days from the release of this judgment to provide written submissions to the Court. Each submission shall be no more than five (5) pages in length.

"Michael L. Phelan"

Judge

Ottawa, Ontario
June 23, 2017

FEDERAL COURT
SOLICITORS OF RECORD

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