

Federal Court



Cour fédérale

Date: 20090909

Docket: T-1378-08

Citation: 2009 FC 883

Ottawa, Ontario, September 9, 2009

PRESENT: The Honourable Mr. Justice Kelen

BETWEEN:

RICHARD KOSLOWSKI

Plaintiff

and

**HOGAN SCOTT COURRIER
carrying on business as
GEEKS GALORE COMPUTER CENTER**

Defendant

REASONS FOR ORDER AND ORDER

[1] This is a motion by the Plaintiff Richard Koslowski for summary judgment in an action for a breach of copyright and not trademark since the Defendant and Plaintiff operate in completely different markets. The Plaintiff is seeking a declaration of infringement of his copyright by the Defendant, a permanent injunction, delivery or destruction of all infringing articles and materials, and damages pursuant to ss. 2, 2.2, 3, 5, 6, 13(1), 14.1, 14.2, 27, 28.1, 28.2, 34(1)-(3), 34.1, 35, 38, and 53 of the *Copyright Act*, R.S.C. 1985, c. C-42 as amended. The Plaintiff alleges that the Defendant infringed his copyright in the “THE3GEEKS” characters depicted in the motion by the

Defendant reproducing the image on internet web pages and various articles and materials used in the Defendant's business.

FACTS

[2] The Plaintiff is an artist of U.S. nationality residing in the state of Wisconsin in the U.S. The Plaintiff states in his affidavit that he is the author and originator of "THE3GEEKS" characters which are featured in comic books.

[3] The Defendant is an individual carrying on "a small computer sales/repair" business as Geeks Galore Computer Center in Marmora, Ontario [Statement of Defence, para 1].

[4] The Defendant was at all material times the owner of Geeks Galore Computer Centre in Marmora, Ontario [Statement of Defence]. The Court takes judicial notice of the fact that the Village of Marmora is at about halfway between Toronto and Ottawa on Ontario Highway No. 7.

[5] The Plaintiff commenced this action for copyright infringement and trademark passing off by Statement of Claim on September 5, 2008. The Defendant filed a Statement of Defence on October 3, 2008 denying the Plaintiff's allegations.

[6] The Plaintiff states that since at least 2006 the Defendant has displayed the Infringing Image as depicted at para. 9 of the Plaintiff's affidavit on the Defendant's internet homepage, other websites, invoices, business cards, and shirts worn by sales staff. The Plaintiff states at para. 10 of

his affidavit that “THE3GEEKS” characters as depicted in the motion and the Infringing Image as depicted at para. 10 of the affidavit are identical or substantially similar.

[7] The Plaintiff attached to his affidavit printouts of the Defendant’s web pages that bear the Infringing Image on the body of the web pages or in pictures that show staff members wearing shirts that bear the Infringing Image [Exhibit B to the Plaintiff’s Affidavit].

[8] The Plaintiff states that after receiving the Statement of Claim the Defendant removed the Infringing Image from his home page but not from <http://geeksgaloreca.tripod.com/> or the Defendant’s forum webpage [Exhibits B and C of the Plaintiff’s affidavit].

[9] The Plaintiff subsequently brought this motion for summary judgement for the copyright infringement allegations in his Statement of Claim.

ISSUE

[10] The issue in this proceeding is whether summary judgement should be granted.

LAW AND JURISPRUDENCE ON SUMMARY JUDGMENT

The Test for Summary Judgment

[11] Rule 213(1) of the *Federal Courts Rules* allows a Plaintiff in an action to bring a motion for summary judgment after the Defendant has filed a Statement of Defence.

Where available to plaintiff

213. (1) A plaintiff may, after the defendant has filed a defence, or earlier with leave of the Court, and at any time before the time and place for trial are fixed, bring a motion for summary judgment on all or part of the claim set out in the statement of claim.

Requête du demandeur

213. (1) Le demandeur peut, après le dépôt de la défense du défendeur — ou avant si la Cour l'autorise — et avant que l'heure, la date et le lieu de l'instruction soient fixés, présenter une requête pour obtenir un jugement sommaire sur tout ou partie de la réclamation contenue dans la déclaration.

[12] Rule 214 of the *Federal Courts Rules* requires the parties to serve and file a notice of motion and moving motion record and a responding motion record respectively.

Obligations of moving party

214. (1) A party may bring a motion for summary judgment in an action by serving and filing a notice of motion and motion record at least 20 days before the day set out in the notice for the hearing of the motion.

Obligations du requérant

214. (1) Toute partie peut présenter une requête pour obtenir un jugement sommaire dans une action en signifiant et en déposant un avis de requête et un dossier de requête au moins 20 jours avant la date de l'audition de la requête indiquée dans l'avis.

Obligations of responding party

(2) A party served with a motion for summary judgment shall serve and file a

Obligations de l'autre partie

(2) La partie qui reçoit signification d'une requête en jugement sommaire signifie

respondent's motion record not later than 10 days before the day set out in the notice of motion for the hearing of the motion.	et dépose un dossier de réponse au moins 10 jours avant la date de l'audition de la requête indiquée dans l'avis de requête.
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[13] Rule 215 of the *Federal Courts Rules* states that a response to a motion for summary judgment shall not rest on mere denials of the allegations in the Statement of Claim.

Mere denial

215. A response to a motion for summary judgment shall not rest merely on allegations or denials of the pleadings of the moving party, but must set out specific facts showing that there is a genuine issue for trial.

Réponse suffisante

215. La réponse à une requête en jugement sommaire ne peut être fondée uniquement sur les allégations ou les dénégations contenues dans les actes de procédure déposés par le requérant. Elle doit plutôt énoncer les faits précis démontrant l'existence d'une véritable question litigieuse.

[14] Rule 216 of the *Federal Courts Rules* provides that the Court may grant summary judgment where there is not genuine issue for trial or the only genuine issue is a question of law, or the only genuine issue for trial is the amount of damages to be assessed:

Where no genuine issue for trial

216. (1) Where on a motion for summary judgment the Court is satisfied that there is no genuine issue for trial with respect to a claim or defence, the Court shall grant summary judgment accordingly.

Genuine issue of amount or question of law

(2) Where on a motion for summary judgment the Court is satisfied that the only

Absence de véritable question litigieuse

216. (1) Lorsque, par suite d'une requête en jugement sommaire, la Cour est convaincue qu'il n'existe pas de véritable question litigieuse quant à une déclaration ou à une défense, elle rend un jugement sommaire en conséquence.

Somme d'argent ou point de droit

genuine issue is

(a) the amount to which the moving party is entitled, the Court may order a trial of that issue or grant summary judgment with a reference under rule 153 to determine the amount; or

(b) a question of law, the Court may determine the question and grant summary judgment accordingly.

Summary judgment

(3) Where on a motion for summary judgment the Court decides that there is a genuine issue with respect to a claim or defence, the Court may nevertheless grant summary judgment in favour of any party, either on an issue or generally, if the Court is able on the whole of the evidence to find the facts necessary to decide the questions of fact and law.

...

(2) Lorsque, par suite d'une

requête en jugement sommaire, la Cour est convaincue que la seule véritable question litigieuse est

a) le montant auquel le requérant a droit, elle peut ordonner l'instruction de la question ou rendre un jugement sommaire assorti d'un renvoi pour détermination du montant conformément à la règle 153;

b) un point de droit, elle peut statuer sur celui-ci et rendre un jugement sommaire en conséquence.

Jugement de la Cour

(3) Lorsque, par suite d'une requête en jugement sommaire, la Cour conclut qu'il existe une véritable question litigieuse à l'égard d'une déclaration ou d'une défense, elle peut néanmoins rendre un jugement sommaire en faveur d'une partie, soit sur une question particulière, soit de façon générale, si elle parvient à partir de l'ensemble de la preuve à dégager les faits nécessaires pour trancher les questions de fait et de droit.

...

[15] In *Rachelex Holdings Inc. v. W & M Wire and Metal Products Ltd.*, 2007 FC 502, 15

A.C.W.S. (3d) 629, I set out the test for summary judgment at para. 8 (citing my decision in *Spenco*

Medical Corp. v. Emu Polishes Inc., 2004 FC 963 at paras. 6-8):

...The Court is not to grant summary judgment where it is shown that there is a genuine issue for trial. However, Rule 216(3) specifically permits this Court to grant summary judgment even where there is a genuine issue for trial so long as the Court "is able on the whole of the evidence to find the facts necessary to decide the questions of fact and law" ...

[16] In *Granville Shipping Co. v. Pegasus Lines Ltd. S.A.*, [1996] 2 F.C. 853 (F.C.T.D.), Madam Justice Tremblay-Lamer set out the general principles applicable to a motion for summary judgment at paragraph 8:

[8] I have considered all of the case law pertaining to summary judgment and I summarize the general principles accordingly:

1. the purpose of the provisions is to allow the Court to summarily dispense with cases which ought not proceed to trial because there is no genuine issue to be tried (*Old Fish Market Restaurants Ltd. v. 1000357 Ontario Inc. et al.*, [1994] F.C.J. No. 1631, 58 C.P.R. (3d) 221 (T.D.));
2. there is no determinative test [...] but Stone J.A. seems to have adopted the reasons of Henry J. in *Pizza Pizza Ltd. v. Gillespie* [(1990), 75 O.R. (2d) 225 (Gen. Div.)]. It is not whether a party cannot possibly succeed at trial, it is whether the case is so doubtful that it does not deserve consideration by the trier of fact at a future trial;
3. each case should be interpreted in reference to its own contextual framework [...];
4. provincial practice rules (especially Rule 20 of the Ontario Rules of Civil Procedure, [R.R.O. 1990, Reg. 194]) can aid in interpretation [...];
5. this Court may determine questions of fact and law on the motion for summary judgment if this can be done on the material before the Court [...];
6. on the whole of the evidence, summary judgment cannot be granted if the necessary facts cannot be found or if it would be unjust to do so [...];

7. in the case of a serious issue with respect to credibility, the case should go to trial because the parties should be cross-examined before the trial judge [...] The mere existence of apparent conflict in the evidence does not preclude summary judgment; the court should take a "hard look" at the merits and decide if there are issues of credibility to be resolved.

[17] The Federal Court of Appeal affirmed this test in *ITV Technologies Inc. v. WIC Television Ltd.*, 2001 FCA 11, [2001] F.C.J. No. 400 (F.C.A.), and quoted it with approval in *MacNeil Estate v. Canada (Indian and Northern Affairs Department)*, 2004 FCA 50, 316 N.R. 349, wherein the Court provided the guidelines specifically with respect to the application of Rule 216(3) at paras. 32-29. I summarized these guidelines in *Rachelex Holdings*, supra, at para. 8 as follows:

1. where an issue of credibility arises from evidence presented, the case should not be decided on summary judgment under rule 216(3) but rather should go to trial because the parties should be cross-examined before the trial judge (see paragraph 32 of *MacNeil Estate*);
2. under rule 216(3), motions judges can only make findings of fact or law provided the relevant evidence is available on the record and does not involve a "serious" question of fact or law which turns on the drawing of inferences (see paragraph 33 of *MacNeil Estate*);
3. Rule 216(3) permits a judge on a motion for summary judgment, after finding that a "genuine issue" exists, to conduct a trial on the affidavit evidence with a view to determining the issues in the action. However, this is not always possible, particularly where there are conflicts in the evidence, where the case turns on the drawing of inferences or where serious issues of credibility are raised (see paragraph 46 of *MacNeil Estate*);
4. Parties responding to a motion for summary judgment do not have the burden of proving all of the facts in their case; rather ... responding parties have only an evidentiary burden to put forward evidence showing that there is a genuine issue for trial ... (see paragraph 25 of *MacNeil Estate*).

[18] In view of the case law, the test for summary judgment is clear: based on the evidence, has the plaintiff shown that the defendant has no genuine issue for trial?

Analysis with respect to the issue: Is there a genuine issue for trial?

[19] I note at the outset that the only evidence before the court on this motion is present in the Plaintiff's moving motion record. The Defendant failed to serve and file a responding motion record in accordance with Rule 214(2) of the *Federal Courts Rules*.

[20] To succeed on a motion for summary judgment the Plaintiff has to demonstrate that he will meet every element in his copyright infringement action.

Ownership of Copyright

[21] The Plaintiff has not produced a copy of a certificate of registration of copyright with the Canadian Intellectual Property Office. The absence of a certificate leads the court to determine that the Plaintiff's work was not registered in accordance with s. 53 of the *Copyright Act*, and the Plaintiff is therefore not eligible for the s. 53 presumption of subsistence of copyright in his work and the presumption of his ownership of the impugned works.

[22] The Plaintiff is nevertheless entitled to the presumption of copyright ownership in accordance with s. 34.1(2) of the *Copyright Act* since his name is printed across many of the Plaintiff's comic book works for which he claims copyright (Plaintiff's Motion Record, Tab A, page 35).

[23] The Defendant has not adduced any evidence to the contrary. I therefore find that Richard Koslowski is the owner of copyright in “THE3GEEKS” characters.

Infringement of Copyright

[24] The affidavit of Richard Koslowski states that he has personally conducted internet searches of the Defendant’s business and witnesses the alleged unauthorized reproductions of “THE3GEEKS” characters.

[25] The Plaintiff has produced printouts of the Defendant’s web pages under exhibits B and C of his affidavit. They show the reproduction of an identical image of “THE3GEEKS” as depicted in the motion.

[26] Section 3 of the *Copyright Act* grants the sole right to the owner of copyright to “produce or reproduce the work or any substantial part thereof in any material form whatever”.

[27] The evidence under Exhibits B and C to the plaintiff’s affidavit shows printouts of web pages that are under the control of the Defendant containing “THE3GEEKS” characters’ image in an identical form as depicted in the motion or in a substantially similar form.

[28] The Defendant has offered no explanation or response to Plaintiff’s allegations except the outright denials of any wrongdoing in the statement of defence.

[29] Based on the evidence, the Court is satisfied that the Defendant has reproduced the Plaintiff's copyrighted images, "THE3GEEKS", and that there is no genuine issue for trial.

ORDER

THIS COURT DECLARES that:

1. the Plaintiff is the author of “THE3GEEKS” characters as depicted in the motion;
2. the above-mentioned “THE3GEEKS” characters constitute an original artistic work in which copyright subsists;
3. the Plaintiff is the owner of the copyright in the above-mentioned “THE3GEEKS” characters; and
4. from at least as early as 2006 to date, the Defendant has infringed the Plaintiff’s copyright, by virtue of having reproduced, or otherwise produced, all or a substantial part of the Plaintiff’s “THE3GEEKS” characters, or having otherwise authorized such acts, contrary to Sections 3 and 27 of the *Copyright Act* R.S.C. 1985, c. C-42, as amended, including without limitation by displaying the image as reproduced in the motion on his website (hereinafter the “Infringing Image”).

THIS COURT ORDERS that:

1. the Defendant is hereby restrained, by himself, through agents, or otherwise, from any further copying the Plaintiff’s works, including without limitation displaying the above-mentioned Infringing Image, or any other image which is substantially similar to, or a colourable imitation of any of “THE3GEEKS” characters;
2. the Defendant deliver up to the Plaintiff; or his representatives, or delete or destroy under oath, as the Plaintiff may elect, all articles and materials (including without limitation any web pages, brochures, letterhead, business cards), in the possession, power, custody or control of the Defendant displaying the Infringing Image, or any

other image which is substantially similar to, or a colourable imitation of; any of “THE3GEEKS” characters;

3. the Defendant produce to the Plaintiff, within 30 days hereof, a list of all articles and materials (including without limitation any web pages, brochures, letterhead, business cards), that have been, and are no more, in the possession, power, custody or control of the Defendant displaying the Infringing Image, or any other image which is substantially similar to, or a colourable imitation of, any of “THE3GEEKS” characters;
4. the Defendant pay the Plaintiffs damages for copyright infringement and, in addition to those damages, the profits that the Defendant has made from the infringement that are not taken into account in the calculation of the damages;
5. the Defendant produce to the Plaintiff, within 30 days hereof, copies of all invoices, financial statements and any other records evidencing business revenues from and including 2006 to date;
6. the Plaintiff’s claim for damages be referred to a Prothonotary for assessment by a Prothonotary in accordance with Rule 153 of the *Federal Courts Rules*;
7. the Defendant pay forthwith the Plaintiff’s costs of this motion and of the Statement of Claim which is \$3,642 including counsel fee and disbursements.

“Michael A. Kelen”

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1378-08

STYLE OF CAUSE: RICHARD KOSLOWSKI v. HOGAN SCOTT
COURRIER carrying on business as GEEKS GALORE
COMPUTER CENTER

PLACE OF HEARING: Toronto, Ontario

DATE OF HEARING: August 31, 2009

**REASONS FOR ORDER
AND ORDER:** KELEN J.

DATED: September 9, 2009

APPEARANCES:

Mr. Tony Bortolin FOR THE PLAINTIFF

N/A FOR THE DEFENDANT

SOLICITORS OF RECORD:

Mr. Tony Bortolin FOR THE PLAINTIFF

N/A FOR THE DEFENDANT