

Federal Court



Cour fédérale

Date: 20240917

Docket: T-2304-24

Citation: 2024 FC 1465

Ottawa, Ontario, September 17, 2024

PRESENT: The Honourable Justice Fuhrer

BETWEEN:

INDIGO BOOKS & MUSIC INC.

Moving Party / Plaintiff

and

**JOHN DOE 1 dba INDIGO KILLS KIDS,
JOHN DOE 2 dba INDIGOKILLSKIDS.CA, and
JOHN DOE 3 dba INDIGOKILLSKIDS.COM**

Defendants

and

**BELL CANADA,
ROGERS COMMUNICATIONS CANADA INC.,
TELUS COMMUNICATIONS INC., and
VIDEOTRON LTD.**

Third Party Respondents

ORDER AND REASONS



UPON the Plaintiff's motion filed on September 11, 2024 for an Order:

1. for an interim and/or interlocutory injunction, pursuant to subsection 53.2(1) of the *Trademarks Act*, RSC 1985, c T-13, subsection 34(1) of the *Copyright Act*, RSC 1985, c C-42, and section 44 of the *Federal Courts Act*, RSC 1985, c F-7, ordering John Doe Defendant 1, John Doe Defendant 2, and John Doe Defendant 3 (collectively, the "John Doe Defendants"), by themselves or by their employees, representatives and agents, or by any company, partnership, trust, entity or person under their authority or control, or with which they are associated or affiliated, to immediately:
 - (a) take down and cease operating or carrying on business through the infringing website domains: www.indigokillskids.ca and www.indigokillskids.com (collectively, the "IKK Domains"), and any confusingly similar domains, or IKK Social Media accounts identified in (c)(i)-(iv) below;
 - (b) take down and cease operating the website hosted at www.indigokillskids.ca (the "IKK Website") and any other website, domain or subdomain, including IKK Social Media accounts identified in (c)(i)-(iv) below, that is being used to provide access to, or redirect or forward to, the website, webpages, and/or website content of the IKK Website;
 - (c) take down and remove all copies of the infringing material, including any mark, design, word, title or name that uses or infringes the Plaintiff's INDIGO Marks

(as defined below) or !NDIGOKIDS Work (as defined below), or any confusingly similar marks or substantial copies of works, including from:

- i. the IKK Website, and any other website, domain, or subdomain that is being used by the John Doe Defendants to publish infringing material or content;
- ii. the Instagram accounts: www.instagram.com/indigokillskids/ and www.instagram.com/indigokillskids.ca/;
- iii. Tiktok @indigokillskids; and
- iv. X Corp. (formerly Twitter) account: x.com/indigokillskids/; and (collectively, “IKK Social Media”)

- (d) cease these infringing activities on any other websites or social media accounts pending a resolution of this matter at trial;
2. validating service of this Notice of Motion upon the Defendants pursuant to Rule 147, by email at indigokillskids@proton.me, the contact email provided on the IKK Website, and by way of delivery through the Canadian Internet Registration Authority’s [CIRA] Message Delivery Form platform, intended to deliver communications to the registrant of the domain: www.indigokillskids.ca;
 3. in the form of the draft order, attached as Schedule “1” to the Notice of Motion, for an interim and/or interlocutory injunction, pursuant to subsection 53.2(1) of the *Trademarks Act*, RSC 1985, c T-13, subsection 34(1) of the *Copyright Act*, RSC

1985, c C-42, and section 44 of the *Federal Courts Act*, RSC 1985, c F-7, ordering the Third Party Respondents, *inter alia*, to block, or attempt to block access by their respective internet service customers, including customers of cellular or mobile network services and fixed internet services, to each of the domains and subdomains identified in Schedule 1 of the draft order, subject to any subsequent variance to the order or amendment to Schedule 1, for a period of two (2) years; and

4. Such further and other relief as this Honourable Court deems just;

AND UPON reading the Plaintiff's motion material, including the Affidavits of Damien Liddle, Colleen Stanley, and Andrew Johnstone, and the pleadings and proceedings to date;

AND UPON receiving on September 16, 2024 a letter addressed to the Court from Tamir Israel stating that he is counsel for Charlotte Kates, an individual who is associated with the website at issue on this motion, and seeking to postpone the hearing;

AND UPON receiving on September 17, 2024 (immediately prior to the hearing of the motion) an email sent to the Court by Stephen Ellis, counsel for the Legal Centre for Palestine [LCP] indicating that his client is interested in applying for intervener status;

AND UPON convening the hearing of this motion remotely by Zoom at 10:00 am on September 17, 2024;

AND UPON hearing preliminary submissions from the Plaintiff's counsel, and from Mr. Israel, and Mr. Ellis, about the logistics of proceeding today in light of the developments subsequent to the filing of this motion on September 11, 2024;

AND UPON determining that the motion would proceed today, but only in respect of items 2 and 3 above (with item 3 limited to a possible interim order, as opposed to an interlocutory order), with directions to follow from the Court about the procedure and timing at least for confirming the status of Charlotte Kates' relation to the John Doe Defendants (no evidence of the association, connection, or relationship having been provided to the Court in advance of the hearing), as well as a possible motion for intervener status by the LCP;

AND UPON hearing the Plaintiff's submissions on items 2 (validation of service) and 3 (interim domain blocking order);

AND UPON finding that the Plaintiff has satisfied the Court that an order validating service and an interim (i.e. short term) domain blocking order are warranted in the circumstances for the following reasons:

Validation of Service

[1] I find that the Plaintiff has established the Statement of Claim and Notice of Motion have come to the attention of the Defendants and, thus, that the Plaintiff has effected service of both by sending these documents to the Defendants by email on September 12, 2024 to the email address available on the IKK Website (i.e. indigokillskids@proton.me), as contemplated by Rule 147 of the *Federal Courts Rules*.

[2] The Plaintiff provides details in its evidence (in the form of the affidavits of Colleen Stanley and Damien Liddle) and submissions about the steps taken to attempt to identify the John Doe Defendants. Given the anonymity with which a domain name can be held, the

Plaintiff's efforts, including cease and desist letters sent to email contact information for the Defendants publicly available online at the IKK Website, communications with CIRA requesting disclosure of the Defendants' identities, abuse reports filed with applicable social media platforms, and CDRP and UDRP complaints filed to have the IKK Domains transferred, have proved fruitless to date, notwithstanding the diligence and speed with which the Plaintiff took these steps from the time it discovered the IKK Domains, the IKK Website, and the IKK Social Media accounts in about mid August 2024.

[3] The Plaintiff also provides evidence (in the form of one of two affidavits of Andrew Johnstone) showing that the Plaintiff's Statement of Claim has been posted to the Instagram page @indigokillskids at least as of 9:07 am on September 17, 2024, while the cease and desist notice and Notice of Motion have been posted on the website at indigokillskids.ca/legal at least as of 9:08 am on September 17, 2024.

Interim Domain Blocking Order

[4] I find that the Plaintiff has met the test for an interim domain blocking order, to permit sufficient time for Charlotte Kates to establish a connection to the Defendants and for the LCP to pursue intervener status, and if achieved, to prepare for the hearing of the motion on the merits for the interlocutory domain blocking and injunction orders the Plaintiff seeks.

[5] A domain blocking or site-blocking order is a form of injunctive relief enjoining Internet Service Providers [ISPs] to block their subscribers' attempts to access the infringing domains, handles, and content on the Internet. It is aimed at preventing users from accessing infringing

content in situations where it is not possible to stop infringers effectively from distributing infringing content.

[6] In this case, the Plaintiff seeks a site-blocking order known as Domain Name System [DNS] blocking, limited to the specific domains or subdomains involved, thus diminishing the risk that untargeted websites nonetheless could be affected by the order.

[7] It is settled law that this Court has the jurisdiction to issue the type of site-blocking order the Plaintiff seeks: *Bell Media Inc v GoldTV.Biz*, 2019 FC 1432 [*GoldTV*] at paras 22-26.

[8] I note that the Third Party Respondents, Bell Canada, Rogers Communications Canada Inc., Telus Communications Inc., and Videotron Ltd. are the ISPs at issue in this matter, and further, they either have consented (Rogers and Telus) to the form of order sought by the Plaintiff, or do not oppose (Videotron), or take no position (Bell) on the issuance of the order.

[9] The test for interim injunctive relieve is essentially the same as for an interlocutory injunction, namely, the conjunctive, three-part test articulated in the following line of cases: *Manitoba (AG) v Metropolitan Stores Ltd*, 1987 CanLII 79 (SCC), [1987] 1 SCR 110; *RJR-MacDonald v Canada (Attorney General)*, 1994 CanLII 117 (SCC), [1994] 1 SCR 311. In short, to succeed on its motion for an interim domain blocking order, the Plaintiff must satisfy all three elements of the test - serious issue, irreparable harm, and balance of convenience: *Janssen Inc v Abbvie Corporation*, 2014 FCA 112 at para 14. See also *Bell Canada v 1326030 Ontario Inc (iTVBox.net)*, 2016 FC 612 [*iTVBox*] at para 19.


[10] In addition, more recent jurisprudence of this Court has established the appropriateness of the following factors, known as the *Cartier* factors, in determining the proportionality of a site-blocking order in the context of whether it would be a just and equitable remedy in all the circumstances: (a) necessity; (b) effectiveness; (c) dissuasiveness; (d) complexity and cost; (e) barriers to legitimate use or trade; (f) fairness; (g) substitution; and (h) safeguards. See *GoldTV*, above at paras 51-52; appeal dismissed *Teksavvy Solutions Inc v Bell Media Inc*, 2021 FCA 100 [*Teksavvy*]. The Federal Court of Appeal held specifically that the *Cartier* factors appropriately were considered: *Teksavvy*, at para 77.

[11] *GoldTV* further guides (at para 56), citing *iTVBox*, that a strong showing on one element of the three-part test may lower the threshold on the other two.

[12] Turning next to the Plaintiff's evidence on this motion, it describes the Plaintiff as Canada's largest and most recognized book, gift, stationery, home decor, and specialty toy retailer that has been operating since 1997. The Plaintiff operates physical retail locations and provides online retail services.

[13] The Plaintiff owns the following registered trademarks in Canada [INDIGO Marks]:

Trademark	Type	Registration No.	Registration Date
INDIGO	Word	TMA510146	1999-03-26
!ndigo	Design	TMA967316	2017-04-03

!INDIGOKIDS	Word	TMA816679	2013-10-01
	Design	TMA1093433	2021-02-10

[14] According to the Plaintiff, it has used the trademark !INDIGOKIDS since at least as early as 2008 in association with children's books, apparel, toys, and gifts at its retail and online stores.

[15] Noting that there is no requirement for copyright to be registered to find that it subsists, I am prepared to find, for the purpose of this motion, that the Plaintiff owns copyright in the following image [!INDIGOKIDS Work]:



[16] The Plaintiff describes that in about mid August 2024, it became aware that the John Doe Defendants (i.e. the as yet unidentified Defendants) operate the IKK Website and IKK Domains, as well the IKK Social Media [all collectively, IKK Platforms].

[17] The IKK Platforms display the following image [IKK Image]:



[18] In addition to the express message conveyed by the IKK Image (i.e. that the Plaintiff is responsible for killing children), the IKK Website calls for a boycott of the Plaintiff's stores, redirects visitors to competitors of the Plaintiff, and claims to be organizing a day of action against the Plaintiff on September 25, 2024.

[19] Turning to the applicable three-part test, I am persuaded that the Plaintiff has shown a serious issue, if not a *prima facie* case, of copyright infringement in respect of the !INDIGOKIDS Work and depreciation of the goodwill attaching to the INDIGO Marks, particularly !INDIGOKIDS and !indigokids Design.

[20] First, I find that the IKK Image is a substantial copy of the !INDIGOKIDS Work.

[21] Second, I agree with the Plaintiff that the apparent purpose of the IKK Platforms is to damage the Plaintiff's business and reputation, including tarnishing the INDIGO Marks and depreciating the value of the attendant goodwill, through the message inherent in the IKK Image and other content and messages on the IKK Platforms implicating the INDIGO Marks. In other words, the Defendants intentionally have attempted to attract the Plaintiff's consumers to their own website for notoriety and in a manner likely to tarnish the goodwill attached to the INDIGO Marks: *United Airlines, Inc v Cooperstock*, 2017 FC 616 at para 102.

[22] Regarding the next elements of the test, I also am persuaded that the Plaintiff's strong showing on the first element lowers the threshold for the remaining two prongs.

[23] Regarding irreparable harm, generally the Plaintiff must show with clear, convincing evidence that this is a harm which is non-compensable by a monetary award. The requirement is met here, in my view, where the Defendants are anonymous and have made efforts to remain that way and avoid liability or responsibility: *Teksavvy*, at para 87.

[24] I further find that an interim domain blocking order is necessary and proportional to limit the harm to the Plaintiff, as well as the potential risk to untargeted websites, until the merits of the motion for interlocutory relief can be heard, while providing Charlotte Kates and the possible intervener an opportunity to establish their status and participate. In itself, it is not an order that engages freedom of expression values or interferes with the principle of net-neutrality: *Google Inc v Equustek Solutions Inc*, 2017 SCC 34.

[25] In the end, I am satisfied that the *Cartier* factors, and hence, the balance of convenience favours the Plaintiff.

AND UPON concluding, for the above reasons, that service of the Statement of Claim and Notice of Motion on the Defendants will be validated and that an interim domain blocking order will issue on the terms outlined below.

ORDER in T-2304-24

THIS COURT’S ORDER is that:

1. Further to Rule 147 of the *Federal Courts Rules*, the Plaintiff has effected service of the Statement of Claim and the Notice of Motion by sending these documents to the Defendants by email on September 12, 2024 to the email address, indigokillskids@proton.me, available on the website at www.indigokillskids.ca.
2. Subject to the terms of this Order, the Third Party Respondents, within seven (7) days after the issuance of this Order, shall block, or attempt to block access by their respective residential internet service customers and, if technically feasible and reasonably practicable, their mobile network service customers (the “**Internet Services**”), to each of the domains and subdomains identified in Schedule 1 of this Order (the “**Infringing Domains**”), subject to any subsequent variance to this Order or amendment to Schedule 1, by the Court.
3. Schedule 1 to this Order and the list of Infringing Domains may be updated, with leave of the Court, through the following mechanism:
 - (a) the Plaintiff may serve and file a motion to amend Schedule 1 and add additional domains and subdomains with appropriate evidence and submissions to support the motion, including affidavit and/or any other admissible evidence demonstrating a strong *prima facie* case of similar infringement in the domain name or website content of the additional domain(s) and subdomain(s);
 - (b) a Third Party Respondent may bring a motion to object to the additional proposed domain(s) and subdomain(s) by serving and filing a motion record within ten (10) business days of service of the Plaintiffs’ affidavit and proposed amended Order;
 - (c) if no Third Party Respondent serves and files a motion record within in ten (10) business days in accordance with paragraph 3(b), the Court may grant the Order without further proceedings.

4. The Third Party Respondents have no obligation to verify whether the Plaintiff's Schedule 1 to this Order, or updates to Schedule 1, are correct, and are wholly reliant on the Plaintiff accurately identifying the domains and subdomains associated with the Infringing Websites.
5. A Third Party Respondent will be deemed to have complied with paragraphs 2 and 3 of this Order if it uses domain name system ("DNS") blocking, DNS re-routing, or an alternative or equivalent technical means (provided that the Third Party Respondent provides reasonable notice to the Plaintiff of said alternative or equivalent means).
6. If a Third Party Respondent, in complying with this Order, is unable to implement DNS blocking, DNS re-routing, or alternative or equivalent technical means, that Third Party Respondent shall, within ten (10) business days of this Order or of being first made aware it is unable to implement the blocking, as applicable, notify the Plaintiff of the step(s) it has taken and why it will be unable to comply with the Order. The Plaintiff shall treat any information received pursuant to this paragraph confidentially and shall use it solely for the purposes of monitoring compliance with this Order.
7. The Internet Service customers of the Third Party Respondent will be notified through the following mechanism:
 - (a) the Plaintiff shall post this Order, as well as an explanation of the purpose of the Order, on a separate website domain (the "**Notification Website**") that will also make the following information immediately available:
 - i. that access has been blocked by this Order;
 - ii. the identity of the Plaintiff and the Federal Court File for this matter and contact information of the Plaintiff or its counsel;
 - iii. a statement to the effect that the operators of the Infringing Domains (i.e. the John Doe Defendants), any third party who claims to be affected by this Order, and any internet service customer affected by the Order, may

apply to the Court to discharge or vary the Order pursuant to paragraph 12 below; and

- (b) where an Internet Service customer has access to an Infringing Domain blocked by a Third Party Respondent pursuant to this Order, to the extent practicable, the Third Party Respondent shall setup the DNS blocking, DNS re-routing, or an alternative or equivalent technical means, to redirect the internet service customer to the Notification Website; and
 - (c) the Plaintiff shall notify the Third Party Respondents of any changes to the domain or website address of the Notification Website as soon as reasonably practicable.
8. A Third Party Respondent shall not be in breach of this Order if it temporarily suspends its compliance with paragraphs 2 or 3, in whole or in part, when such suspension is reasonably necessary:
- (a) to correct or investigate potential over-blocking that is caused or suspected to be caused by the steps taken pursuant to paragraphs 2 or 3;
 - (b) to maintain the integrity or quality of its internet services or the functioning of its network and/or system(s);
 - (c) to upgrade, troubleshoot, or maintain its internet services or blocking system(s), including as a result of technical or capacity limitations of its blocking system(s);
or
 - (d) to prevent or respond to an actual or potential security threat to its network or systems;

provided, if the suspension lasts longer than 48 hours that the Third Party Respondent gives notice to the Plaintiff during or following such suspension and provides the reason for such suspension and an estimate of its duration. The Plaintiff shall treat any information received pursuant to this paragraph confidentially and shall use it solely for the purposes of monitoring and ensuring compliance with this Order.

9. For greater certainty a Third Party Respondent may hold a reasonable portion of its capacity to implement DNS blocking in reserve, if it deems it necessary to do so, in order to be able to respond to threats to its subscribers and to maintain the integrity of its network and services. Any such measure must be justified with reference to the network capacity used for similar purposes within the 12 months preceding this Order.
10. The Plaintiff must notify the Third Party Respondents as soon as reasonably practicable if:
 - (a) any domain(s) or subdomain(s) in Schedule 1 to this Order (as updated) no longer provides access to or redirects to the Infringing Domains or are transferred and assigned to the Plaintiff, in which case the Plaintiff shall immediately provide to the Third Party Respondents and file with the Court an updated Schedule 1 removing said domain(s) and subdomain(s) and the Third Party Respondents shall no longer be ordered to block or attempt to block access to said domain(s) or subdomains(s); or
 - (b) the operators of the Infringing Domains (i.e. the John Doe Defendants), the operators of any other website who claim to be affected by this Order, or any internet service customer affected by the Order, has applied to the Court to seek a variation of this Order pursuant to paragraph 12.
11. Notices and service of documents under this Order may be made by the Plaintiff and the Third Party Respondents to one another by electronic means at addresses to be determined and agreed upon by them. Service and filing of documents pursuant to paragraph 3 may be made no more frequently than every ten (10) business days.
12. The operators of the Infringing Domains (i.e. the John Doe Defendants), the operators of any other website or domain who claim to be affected by this Order, and any Internet Service customer of the Third Party Respondents affected by the Order, may bring a motion to seek a variation of this Order insofar as this Order affects their ability to access or distribute non-infringing content by serving and filing a motion record within thirty

- (30) days of the first occurrence of the event that allegedly affects them and that results from this Order.
13. This Order shall in no way limit the ability of a Third Party Respondent to seek to stay, vary, or set aside this Order or oppose on any basis any other related or similar Order sought by the Plaintiff or any other party. In particular, and without limitation, this Order shall in no way limit the ability of a Third Party Respondent to raise issues in connection with the implementation of this Order on grounds relating to the technical implementation of this Order, impacts on a Third Party Respondent's services to its subscribers, or the effectiveness of the Order.
 14. The Plaintiffs shall indemnify and save harmless the Third Party Respondents for:
 - (a) the reasonable marginal cost of implementing paragraphs 2 and 7(b) of this Order and updating the implementation of this Order in response to notifications and/or service from the Plaintiffs pursuant to paragraph 3; and
 - (b) any reasonably incurred loss, liability, obligation, claim, damages, costs (including defence costs), or expenses resulting from a third party complaint, demand, action, claim, application or similar proceeding whether administrative, judicial, or quasi-judicial in nature, in respect of the Third Party Respondents as a result of their compliance with the Order.
 15. With respect to the costs referenced in paragraph 14(a) of this Order:
 - (a) the Third Party Respondents shall provide the Plaintiff with an invoice setting out the claimed cost elements and the total cost claimed after having complied with one or more terms of this Order;
 - (b) the Plaintiff shall, within thirty (30) days of receipt of the invoice, either (i) pay the invoice or (ii) serve and file a motion disputing the reasonableness of the costs claimed in the invoice, failing which the costs shall be deemed to be reasonable; and

- (c) without prejudice to any other recourse through which a Third Party Respondent may seek reimbursement, in the event the Plaintiff fails to pay the invoice or serve and file the motion referred to in paragraph 15(b), the Third Party Respondents shall no longer be required to comply with terms of this Order with respect to the domains and subdomains to which the invoice relates.
16. This Order shall terminate fourteen (14) days from the date of its issuance, unless the Court orders otherwise.
17. There shall be no costs on the motion.

"Janet M. Fuhrer"

Judge

Schedule 1 – Infringing Domain(s) and Subdomain(s) to be blocked

Domain(s) to be blocked	Subdomain(s) to be blocked
Indigokillskids.ca	
Indigokillskids.com	

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-2304-24

STYLE OF CAUSE: INDIGO BOOKS & MUSIC INC. v JOHN DOE 1 dba
INDIGO KILLS KIDS,JOHN DOE 2 dba
INDIGOKILLSKIDS.CA, and JOHN DOE 3 dba
INDIGOKILLSKIDS.COM AND BELL CANADA,
ROGERS COMMUNICATIONS CANADA INC.,
TELUS COMMUNICATIONS INC., and VIDEOTRON
LTD. (THIRD PARTY RESPONDENTS)

PLACE OF HEARING: HELD VIA VIDEOCONFERENCE

DATE OF HEARING: SEPTEMBER 17, 2024

ORDER AND REASONS: FUHRER J.

DATED: SEPTEMBER 17, 2024

APPEARANCES:

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Bradley Adams
May M. Cheng
Riley Sun

FOR THE MOVING PARTY / PLAINTIFF

Tamir Israel

FOR THE DEFENDANTS

Daniel Pink
Kristina Milbourn

FOR THE THIRD PARTY RESPONDENTS
(ROGERS COMMUNICATIONS CANADA INC.)

Shawn Irving

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