What is the Role of New Technology in Tensions in IP?

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“Classic” IP

**Patent**

Statute of Monopolies exception for patent protection, s.6, 1624

**Copyright**

Statute of Anne, 1709

The Congress shall have power ... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

US Constitution Art 1 §8 cl 8 (1787)
STAKEHOLDERS REPRESENTED IN THE CREATION OF PATENT & COPYRIGHT

Individuals

As consumer AND as business

Society

National economic interest AND public interest

Patent and Copyright created as mechanisms to provide incentives to *individuals* to spur them to creativity and innovation -- in turn producing public benefits through dissemination of information.
Trademark a long history back into antiquity—1787 US Constitution does not remark on them and nor does Canadian constitution in 1867…

but by 1842 evolved into tort of passing off in common law and had first national legislative coverage in France, Manufacture and Goods Mark Act, 1857…

Concurrently, separation of companies from their owners is occurring…
17th - 18th C.  

Mid-19th C.  

Late 19th C. to Present

Patent

Copyright

Trademark

Separation of company from its individual owners
- e.g. Joint Stock Companies Act, UK 1844

The corporation as a person in its own right.
- e.g. Santa Clara Cty v Southern Pacific RR Co. 1886 US
- e.g. Salomon v A Salomon & Co Ltd 1897 HL
Rise of the Corporation – changes the landscape

- **Individual Interests**
- **Corporate Interests**
  - Not explicitly recognized in Patent or Copyright Law, at least in theory, OR
  - So recognized that they obliterate Individual Interests
- **Societal Interests**
  - In classic IP, societal growth through access to information

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Trademark

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As the Technology Advances, the Tension between the Divisions Created after the Creation of the Original IP Triad intensifies:

Moral Rights:
- Paternity
- Integrity
  (Divulgation)
  (Withdrawal)

Copyright
  (Economic Rights)
  (Patent Trademarks)

(Societal Interests)

(Dissemination, economic development)
New candidates for IP status:

17th - 18th C.  
Patent  
Copyright

Mid-19th C.  
Trademark

Late 19th C. to Present  
Moral Rights  
Confidential Information  
Personal Data Protection  
Data Protection

(Separation of company from individuals)  
(Corporation as person)
As Technology Advances, Tensions and Divisions Created by Separation of Individuals from Companies (after Creation of Original IP) intensifies:

- Individual Interests
  - Moral Rights
  - [Privacy]
- Corporate Interests
  - Confidential Information
  - Data Protection
  - Copyright (Economic Rights)
    - Patent
    - Trademarks
  - (Dissemination, economic development)
- Societal Interests

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Recently before Canadian courts:
Conundrum in individual/corporate rights situated in IP context of new technology - Enforcement of copyright “through” ISPs
“Modern technology … must not be allowed to obliterate those personal property rights which society has deemed important. Although privacy concerns must also be considered, it seems to me that they must yield to public concerns for the protection of intellectual property rights in situations where infringement threatens to erode those rights.”
IP approach of Canadian federal courts and related approaches of Ontario courts:

- **BMG Canada Inc v John Doe**, 2005 FCA 193, [2005] 4 FCR 81, Sexton, J., for the Court
  - **ONTARIO COURTS**
    - **Warman v Fournier et al** 2010 ONSC 2126 (Ont Div Ct)
      [Charter-like concerns about privacy; production from a party, not a third party, sought and denied]
    - **But 1654776 Ont. Ltd v Stewart**, 2013 ONCA 184 (ONCA) appears to overrule Warman in favour of **BMG - type approach**...
  - **Voltage Pictures LLC v John Doe and Jane Doe**, 2014 FC 161(Aalto (Prothonotary)) – follows the **BMG FCA approach**
Two different contexts of “privacy” in *BMG v. John Doe* (2005):

**OLDER**

“legitimate privacy concerns”

- referred to in the 5th branch of the test for granting equitable bills of discovery –
- which, in *BMG*, the FCA found were the 5 tests to be applied in determining discovery under Federal Court Rule 238;
- approach continued in 2014 *Voltage Pictures*

**MORE RECENT**

Personal Information Protection and Electronic Documents Act [PIPEDA] –

- came into force for ISPs on January 1, 2004 –
- except in Quebec, first PRIVATE sector personal data protection in Canada
- acknowledged in *BMG* – BUT, I have argued, not incorporated
- quoted in *Voltage Pictures*, but, again, not actually used in the decision
R. v. Spencer, 2014 SCC 43
(8 person unanimous court, Cromwell writing, June 13, 2014)

[32] The subject matter of the search was not simply a name and address of someone in a contractual relationship with Shaw [the ISP]. Rather, it was the identity of an Internet subscriber which corresponded to a particular Internet usage...

ON WHAT I TERM THE MORE RECENT CONTEXT OF ‘PRIVACY,’

PIPEDA: personal information NOT to be released by a business, inter alia:

• unless order by court with power to compel production (s.7(3)(c)), involved in IP ISP cases, or
• to a government institution with lawful authority, s.7 (3)(c.1)(ii)) in *Spencer case* of police request related to child pornography investigation.

[61] The provisions of PIPEDA are not of much help in determining whether there is a reasonable expectation of privacy...[as they] lead us in a circle.
ON WHAT I TERM THE ‘OLDER’ CONCEPT OF PRIVACY:

Factor 5 of the test for granting equitable bills of discovery, being used to order release of ISP subscriber information to copyright holder plaintiffs in Canada, involves asking about the “legitimate privacy concerns”—

THE SCC IN SPENCER HAS NOW HELD, concerning “reasonable expectation of privacy”

[38] …privacy in relation to information includes at least three conceptually distinct though overlapping understandings…privacy as secrecy, privacy as control and privacy as anonymity.

[41] …the concept of privacy potentially protected by s.8 [of the Canadian Charter of Rights and Freedoms] must include this understanding of privacy [as anonymity].

[48] …Thus, anonymity may, depending upon the totality of the circumstances, be the foundation of a privacy interest that engages constitutional protection against unreasonable search and seizure [s.8].
Is the “Spencer” reasoning upholding ISP subscriber privacy applicable to the civil (IP) context as well as the criminal context?

- In the civil Alberta (Information and Privacy Commissioner) v United Food and Commercial Workers, Local 401 (2013 SCC 62) the union was successful because the opposing interest to privacy was the *Charter* right to freedom of information – in a copyright civil suit there is no opposing *Charter* interest...

- As well, in the SCC found [26] ...the personal information collected, used and disclosed by the Union was limited to images of individuals crossing a picketline ... No intimate details of the lifestyle or personal choices of the individuals were revealed.

In *Spencer*, the Court found ISP subscriber information does involve lifestyle and personal choices... and for that reason deserved to remain private through anonymity.

- The recent Federal Court decision in *Voltage Pictures* (above), in following the 2005 *BMG v John Doe* from the FCA, also relied on R v Ward, 2012 ONCA 660 (see paras 59 & 60 – AND

- *R v Ward* was specifically disapproved by the SCC in *Spencer* as useful in helping determine whether there is a “reasonable expectation of privacy” [para 63]

Thus a key underpinning of a leading civil appellate decision, a criminal case, has been removed...

...so, YES
What is the role of New Technology in tensions in IP?

- Each new technology highlights the historical tension in IP caused by the separation of the individual from the company since the original patent, copyright, and trademark regimes emerged: tensions which have spawned numerous new “claimants” for IP law status (moral rights, confidential information protection, data protection).

- New “claimants” have each represented either individual interests or company interests -- none carry the clear “balance” evident in patent, copyright and trademark regimes; together their claims to IP status also highlight deficiencies in traditional IP, particularly patent and copyright.

- The Canadian Supreme Court solution preferring individuals’ constitutional “Charter” privacy interest over IP interests may point to an urgent need for internal developments in IP to recognize and address the tension created by the historic separation of company and individual.

Technology is the catalyst for IP tensions, but not the cause.
See, as background, Margaret Ann Wilkinson, “Battleground between New and Old Orders: Control Conflicts between Copyright and Personal Data Protection,” in Ysolde Gendreau (ed.) Emerging Intellectual Property Paradigm -- Perspectives from Canada (Cheltenham (UK): Edward Elgar, 2008), 227-266.

THANK YOU