



[2022] 2 F.C.R. D-17

**PRACTICE**

PLEADINGS

*Amendments*

*Related subject: Copyright*

Appeal from Federal Court decision (2021 FC 1239) overturning portion of earlier unreported speaking order (T-900-20, April 7, 2021) by prothonotary (now known as associate judge) — Prothonotary, acting as case management judge, struck out statement of claim of respondent with leave to amend certain claims not relevant to this appeal — Claim in underlying action relating to Multiple Listing Service (MLS) online system operated by respondent — In its claim, respondent sought declaration, *inter alia*, that it was creator, author custodian of MLS — Appellant asserted that claim fell outside Federal Court jurisdiction, that copyright claims disclosed no reasonable cause of action under *Federal Courts Rules*, SOR/98-106, r. 221(1)(a), or were otherwise abuse of process within meaning of that rule, that claims related to *Personal Information Protection and Electronic Documents Act*, S.C. 2000, c. 5 (PIPEDA) disclosed no reasonable cause of action — Prothonotary struck copyright claims, claims under PIPEDA — Stated that respondent had failed to plead that it was owner of copyright or expressly how there had been breach of copyright — Federal Court granted respondent's appeal, overturned Prothonotary's order in respect of copyright claims, granted respondent leave to amend those claims — Appellant submitting, *inter alia*, that Federal Court erred by conducting what was in essence *de novo* review; misapprehended nature of Prothonotary's decision; that ruling in *Toronto Real Estate Board v. Canada (Commissioner of Competition)*, 2017 FCA 236, [2018] 3 F.C.R. 563 (*TREB v. Canada*) disposed of issue of whether respondent possesses copyright in MLS — Main issues whether Federal Court erred in concluding that necessary part of Prothonotary's reasoning involved determination that works at issue in action were same as those at issue in *TREB v. Canada*; that Prothonotary made palpable, overriding error in finding works at issue in action same as those at issue in *TREB v. Canada* — Federal Court not erring in holding that portion of Prothonotary's order at issue in this appeal premised on determination that works at issue in this action same as works at issue in *TREB v. Canada* — Incontrovertible that copyright protecting expression used by author or creator as opposed to facts or ideas — Copyright thus pertaining to works, not to information — Apparent that requisite assessment involving consideration of particular work in question, that originality can only be determined on case-by-case basis — Prothonotary making palpable and overriding error in finding that works at issue in case at bar same as those at issue in *TREB v. Canada*, but not precisely for reasons given by Federal Court — Contrary to what Federal Court indicated in reasons, party may move to strike pleading that it alleges raises issue finally determined in earlier proceeding under either r. 221(1)(a) or 221(1)(f) — Where, as in case at bar, no evidence before Court, Court must assess whether same issues were determined in earlier case by comparing what was decided in earlier case with what is pleaded in statement of claim — Review of reasons in *The Commissioner of Competition v. The Toronto Real Estate Board*, 2016 Comp. Trib. 7, *TREB v. Canada* indicating that works at issue in that case not entirely same as those described by respondent in its statement of claim — Federal Court of Appeal's comments in *TREB v. Canada* made in *obiter*, thus not conclusively determining copyright issue so as to prevent relitigation — Federal Court not erring in

mentioning fact that there were interim orders for injunctions, as well as default, consent judgments, issued in which respondent's copyright in MLS system recognized — Having set aside Prothonotary's order to extent it struck out respondent's copyright claim without leave to amend, no need for Federal Court to issue order granting respondent leave to amend its copyright claim — Paragraph 3 of Federal Court's order therefore unnecessary, confusing — Appeal allowed to extent of deleting paragraph 3 of Federal Court's order — Appeal allowed in part.

IMS INCORPORATED V. TORONTO REGIONAL REAL ESTATE BOARD (A-330-21, 2023 FCA 70, Gleason J.A., reasons for judgment dated March 28, 2023, 22 pp.)