

Protecting copyrighted works in the mobile app space

Smartphone apps are a new battleground for copyright infringement. Marshall Gerstein & Borun attorney, **Michael Graham**, looks at the options for content owners

Companies and individuals that create movies, photographs, news, music, and other types of copyrighted content have long battled to protect their content against online piracy and unlicensed copying, distribution and use of their materials. But the threat of peer-to-peer file sharing may be overshadowed by a new threat to content creators' ability to control and profit from the online use of their works: the use of and linking to unlicensed copyrighted works by smartphone apps.

Smartphones, tablets and other mobile devices, and the apps which run on them have become pervasive features of modern life. These mobile devices are supplementing personal computers and changing the way we access, use and share information, communications, and resources. Gartner predicted in 2010 that by this year mobile phones would overtake personal computers as the most common web access device worldwide. And apps, the application programs that enable mobile devices to access and operate everything from email to movies to music to messaging are inexpensive and everywhere. Unfortunately, they also occasionally use and access unlicensed copyrighted content.

Most apps are distributed through one of the major online services. Apple opened its platform specific App Store in 2008 and presently lists more than 800,000 apps. Google also opened its Google Play application store in 2008 and currently boasts more than 700,000 apps.

This explosive growth in the smartphone application market is attracting individuals and companies that seek to make a quick profit from the use of popular media, images, and reputations. Although only a small portion of apps may contain or link users to infringing material, the threat to the rights and potential earnings of content developers is real and substantial.

The seriousness of this problem and the efforts of content owners to control it recently came to very public light when Reuters published a story about Time Warner and its

Warner Brothers motion picture production company's challenge of Google, demanding that it remove the 'Hobbit 3D Wallpaper HD' mobile application from Google Play. The application enabled users to access unlicensed photographs from the popular film. But the company that sold the app through Google Play had not obtained a license to use images. In response, Google posted a copy of the cease and desist letter to *ChillingEffects.org* but removed the application from its offerings.

Protecting against app infringement of copyright

Although the threat to content owners is real, Google's experience shows that through diligent monitoring and forthright challenges, owners of copyrighted content can protect their material and take down infringing smartphone apps. Content creators need to develop and make monitoring part of their intellectual property protection programmes. The following outlines some steps that may be taken by content creators and owners to protect their IP on online app stores.

A. Identify and secure your rights

The bedrock of any rights protection programme is to secure copyright and, where possible, to register copyright in original works. Motion pictures, photographs, images, writings and music are all protected under national and international copyright laws and conventions. Companies not in the entertainment or other content-centric businesses should still consider protecting their copyrightable assets: advertising images, company descriptions and the like.

First, prepare an inventory of your company's copyrighted works. These may be your company's products or images and text used in marketing. Identify what rights your company owns and those created for your company. Use the inventory to identify which works you graphic and textual works you wish to protect and which are likely to be infringed.

Although registration is no longer a prerequisite for copyright protection, it can provide significant benefits. In the US these include the ability for third parties to search for

copyrighted works and their owners in order to seek licences and permission, the ability to record important licenses and a presumption of copyrightability that is useful when you need to assert copyright.

B. Use digital tags to identify protected works

One of the more difficult parts of enforcement is establishing the provenance of copied or linked-to works. In addition to including proper copyright notices in the images and code for digital works, content creators should attach digital watermarks, markers, or tags to any works they post online. The most effective tags include metadata containing the owner's name and contact information. This enables copyright owners to trace the works, and enables app developers to contact the owner for permission.

In addition, use digital rights management tools such as encryption, copyright notice, and digital watermarks. In the event these tools are removed or circumvented, content creators can claim additional protection under the Digital Millennium Copyright Act (DMCA) in the US. The DMCA provides *sui generis* statutory protection against and damages for the destruction or circumvention of these tools.

C. Develop application licensing programmes

The number and popularity of smartphone apps, and the shift from personal computers to tablets and smartphones, means that content providers need to develop licensing programmes for app developers. The terms and scope of rights appropriate to such programmes are beyond the scope of this article. However, by establishing a licensing programme, content owners can not only establish an income-generating scheme, recruit licensees to provide additional monitoring for third party misuses. In addition, by becoming involved in content licensing for apps, content providers can develop relationships and establish lines of communication with the various application development and sales services, and improve their ability to have

complaints considered expeditiously.

D. Monitor third party apps

The most challenging component of a smartphone apps copyright enforcement programme is uncovering infringing uses of copyrighted materials. Although a number of services monitor the internet for trademark and copyright infringements on websites, monitoring smartphone apps for similar infringements is a relatively new area of concern for which few services exist. One such service is IP Lasso. Trade organisations such as the Motion Picture Association of America (MPAA) are also beginning to monitor apps to identify infringements of their members' works.

Search engine searches may not identify content in smartphone apps that do not also operate web pages. Instead, content developers and owners need to establish programmes of reviewing new applications as they are announced, and periodically review established applications to ensure that they are not using or linking to infringing materials.

E. Identify infringers and application sources

Identifying infringers and accurate contact information for them can often be a major challenge for intellectual property owners. Websites may be registered and operated under fictitious names, contact information may be incomplete or intentionally inaccurate and domain name registrants may use proxy or privacy services to mask or anonymise their identities. The same may be true for creators of applications for smartphones and tablets.

Content creators that identify infringing content or links can utilise the application developer information from these services to identify the developers of infringing content. This is especially important for content creators that licence their properties. Before determining whether to issue a complaint or send a cease and desist letter, ensure that the application developer is not a licensee or sublicensee of the creator.

F. Coordinate and execute takedowns and challenge efforts

Content creators and practitioners need to carefully consider and coordinate their challenges of third party application infringements.

While some legal officers of application distribution companies suggest that the first step in stopping infringing apps should be to contact the app's developer to request that infringing materials or links be removed, before contacting the application stores distributing the app, this strategy may backfire. The app

developer could drag out a response or may be using false contact information that enables it to delay responding while it shifts ownership or location to avoid liability.

A better strategy is to combine and coordinate the sending of a cease and desist letter with the filing of takedown notices to the application platforms on which the infringing app is listed. Generally, application sources will act expeditiously to investigate and act on notices sent to them in order to avoid liability as ISPs under the DMCA.

Under Section 512 of the US Copyright Act, ISPs are granted immunity from infringement claims based on their users infringement of copyright provided that they (1) register as ISPs with the Copyright Office, (2) post contact information and procedures for filing notices of infringement with them and (3) institute a policy of removing content for which they receive appropriate notices of infringement. Although it is not yet clear that application service providers qualify as ISPs under the DMCA, by complying with this established procedure, they have avoided direct claims by content providers. In fact, the notice and takedown procedure offers content creators with their best means of removing infringing applications from the app space.

While the use of DMCA-like notice and takedown procedures should help remove infringing smartphone applications from application distribution channels, copyright owners should also directly challenge the infringers in order to force them to permanently cease the distribution and sale of infringing applications, to obtain an accounting for possible damages and lost profits and to help prevent future infringement by recidivist infringers.

Under the US Copyright law, infringement claims against apps and app developers that knowingly link to unlicensed copyrighted materials can include requests for damages, profits, costs and attorney fees. In addition, in both the US and internationally, infringement can lead to criminal claims. In a recent French case, the operator of a website that provided links to hundreds of downloading sites where films, television programmes and other pirated content could be accessed and downloaded, a French court issued a criminal copyright infringement conviction. Similar judgments suggest an increasing awareness by the courts of the danger of downloading and aggregation sites.

Keep in mind, however, that copyright owners should be careful to collect clear evidence of both ownership of valid copyright and infringement of those rights before asserting them, as under the laws of many countries such challenges can result in the filing

of actions for anti-competitive activities or for declaratory judgment of non-infringement. False or poorly-researched claims can also lead to financial judgment against the accuser.

G. Confirm compliance

If a complainant follows the rules of the particular service and provides the required information, it should receive a confirmation of receipt of the notice within 48 hours. The service will then determine whether the allegedly infringing materials are present in or linked to by the app or if the app enables infringing activities and, if so, will determine what action to take within its policies. The application service will generally notify the complainant of the actions it takes. Practitioners and content owners should carefully review these confirmation notices to determine whether the actions taken appear appropriate. If not, they should send an explanation why the reported actions are inadequate or inappropriate to the application service.

In addition, although the application services will generally report the actions they take and the results of these, content owners and their representatives should always re-examine the infringing app to confirm that the infringing materials have been removed, and should periodically review the app and the application store through which it was available to ensure that the infringement does not recommence.

The increasing number and popularity of smartphone apps suggests that the problem of copyright infringement and abuse by apps will continue to grow. By establishing a policy of security rights and using digital tags on their work, monitoring the app space for infringements, and taking affirmative steps to remove infringing apps and seek damages from unlicensed app developers, copyright owners can help mitigate the threats by publicising their efforts and they may even discourage all but the most aggressive infringers.

Author



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