



Why Policing Your Intellectual Property on the Internet is More Important Than Ever

By Anna K. Heint & Kevin J. Heint
December 2, 2010

Copyright and trademark infringement is rampant on the Internet. This is, in part, due to judicial recognition of expansive protections for Internet service providers (ISPs), like Google.

In the recent decision *Viacom International, Inc. v. YouTube, Inc.1*, a New York District Court ruled that Google's YouTube is protected from copyright infringement liability under the Digital Millennium Copyright Act (D.M.C.A.). The D.M.C.A. protects ISPs from infringement liability as long



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as the ISPs promptly remove illegal content upon notification. The court held that YouTube was not liable for copyright infringement because its existing take-down procedures were sufficient. YouTube took down more than 100,000 videos within 24 hours after Viacom specifically notified them of the infringing videos.

In its decision, the *Viacom* court discussed a similar trademark infringement case: *Tiffany(NJ) Inc. v. eBay Inc.2*. In this case, the Second Circuit held that eBay was not liable for trademark infringement when it allowed its users to sell fake Tiffany & Co. jewelry that infringed trademarks owned by Tiffany & Co. As in *Viacom*, the *Tiffany* court reasoned that eBay's takedown procedures met the requirement of the law that shields ISPs. In *Tiffany*, eBay removed specific listings and suspended the accounts of specific sellers upon notice that these users were selling infringing goods. No shield is provided by the law for the actual sellers.

Stopping Infringement of Valuable Copyrights and Trademarks on the Internet

Intellectual property owners are required to provide more than "generalized notice" that their works are being infringed. The rights holder must provide the ISP with a specific website address that was valued to be "information reasonably sufficient to permit the

service provider to locate the material.” An ISP is only responsible for taking down postings if an intellectual property owner notifies the ISP that a specific posting infringes its copyright or trademark. Companies have an affirmative duty to police the Internet for infringement of their intellectual property

Companies may want to establish or bolster existing monitoring methods in order to prevent their copyright-protected content or counterfeit trademarked goods from appearing on YouTube, eBay and other websites. For companies with substantial holdings of valuable copyrights and trademarks, monitoring departments may be necessary to protect valuable intellectual property

Available ways to monitor the Internet for infringement include following RSS feeds, or by generating basic search engine searches on sites like Google, Yahoo, and Bing. It is also possible to set up Google Alerts, and regularly search YouTube and eBay.

When infringement is found, it is important for intellectual property owners to take swift action. Companies should note as many details about the offending material as possible, including a description of the infringing material and the URL (i.e., website address) where the material can be found. Many sites like Facebook, eBay, Twitter and YouTube have designed simple forms that intellectual property owners can use to assert their rights. For example, eBay offers a Notice of Claimed Infringement form for intellectual property owners to fill out, print and fax to eBay, which who then follows up with electronic correspondence and removes infringing material.

If ISPs fail to take down infringing material after the intellectual property owner has provided specific notice of infringement, legal action may be required.

Outlook for Intellectual Property Owners and Infringers on the Internet

Locating illegal materials is now, more than ever, an immense challenge. Independent monitoring companies or agencies have already begun to emerge. These businesses are tasked to monitor sites like YouTube and eBay and send takedown notices.

ISPs have also started to offer monitoring services. YouTube has created Content Verification and Content Identification Programs, which electronically notifies the intellectual property owner and YouTube of potentially infringing material. Similarly, eBay has created the Verified Rights Owner Program so that eBay and intellectual property owners can easily identify infringing listings. YouTube and eBay will, of course, charge for services associated with these programs.

One of the most controversial monitoring services is provided by Google. In response to requests by the Recording Industry Association of America and the International Federation of the Phonographic Industry, Google offered to assist the intellectual property owners in tracking down pirated material—for a price. Google offered to provide access to its web search application programming interface (API) at the standard

rate of \$5 per one thousand searches. It is estimated that this change could cost in the music industry several million dollars per year.

In September, several members of the Senate Judiciary Committee introduced a bipartisan bill called the Combating Online Infringement and Counterfeits Act. If passed, the Act would give Department of Justice broad powers to initiate lawsuits against Internet infringers.⁴

Meanwhile, Viacom has appealed the New York District Court's *Viacom International, Inc. v. YouTube, Inc.* decision.

For now, the bottom line is that copyright holders and trademark owners must be vigilant to protect valuable intellectual property rights.

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¹ *Viacom International, Inc. v. YouTube, Inc.*, Case No. 07 CV 2103 (Southern District New York, 2010).

² *Tiffany(NJ) Inc. v. eBay Inc.*, 600 F.3d 93 (2d Cir. 2010).

³ Greg Sandoval, *Big Media Wants More Piracy Busting From Google*, Cnet News, October 13, 2010, http://news.cnet.com/8301-31001_3-20019411-261.html#ixzz14KnVf2qu.

⁴ *Combating Online Infringement and Counterfeits Act*, S. 3804, 111th Congress 2009-2010

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