



Protecting Online Technology:

Is there an app for that?

The last decade has been defined by the steady advance of online technologies. At the beginning, it was enough for a business to maintain an online presence via a website. Soon, having a web presence wasn't enough – you had to have an interactive web presence, one that responds to the user's personal tastes and needs.

BY RYAN SHEBELSKI PHOTOS COURTESY OF MCKERCHER LLP BARRISTERS & SOLICITORS

Most recently, however, your online presence has to not only be interactive, but mobile. If your company is thinking of delving into the world of mobile applications,

there are important considerations involving intellectual property laws.

Copyright

When developing a mobile application, one is left with a choice: do we do this

internally, or do we outsource it? If you have staff that are qualified to develop mobile applications, then, subject to any contrary intention in an employment contract, the copyright in the application is the employer's. However, if your company outsources the development, there is no deemed copyright ownership by the party paying for development; your development agreement must clearly state this.

Independent application developers are not too keen on transferring copyright in their work product – after all, this would require them to re-invent the wheel for each new client, or risk infringing the copyright they sold to the last client. Instead, developers will typically license copyright in their work for the client's use. It is important, then, to be very cognizant of the scope of the license that your company is granted. The major distribution networks of mobile applications, the major “app stores,” are worldwide. You will want to ensure that



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410,000

An estimated 410,000 people are employed in Canada as a result of wide adoption of mobile technologies according to a June 2013 report from the Information and Communications Technology Council.

your license is geographically broad enough to cover all of the areas in which your application will be distributed. It is also a good idea to receive an indemnity from the developer with respect to third-party copyright infringement, just in case any portion of the developed application infringes someone else's rights.

Trademark

Some mobile apps become overnight successes, grossing millions in sales and gaining worldwide recognition and exposure. If you find out after you've launched your application that the trademark you used is infringing on that of another, it is too late to recover. It is important from the outset of the development cycle to check the availability of the trademark(s) you intend to use, and get the registration process underway. This is true not only for your home jurisdiction, but also the other areas in which the application will be distributed. It does your company no good to have valid trademark

registrations in Canada, while at the same time be found to be infringing in the United States of America. If your intention is to use an existing registered trademark to market your mobile application, then you will also need to make sure that the declared wares and services of that current registration are broad enough to cover the new mobile application. If this is not the case, then a new trademark registration will have to be sought.

Ryan Shebelski is an intellectual property lawyer in the Saskatoon office of McKercher LLP and is a registered trademark agent. Ryan represents several of Saskatchewan's premiere mobile software developers, and he assists them in both protecting and licensing their intellectual property. BSK

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