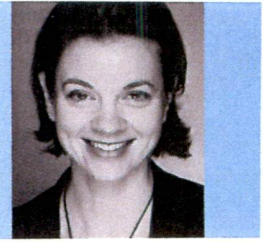


# THE FORMALITIES OF ASSIGNING COPYRIGHT

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New French case law has developed regarding the formalities required for copyright assignments related to a work created by individuals, whether or not they are employees.

Article L131-3 of the French Intellectual Property Code provides that “assignment of copyright is subject to the conditions that each of the assigned rights is separately mentioned in the deed of assignment and that the field of exploitation of the assigned rights is defined as to its scope and destination, as to its geographical extent and as to its duration”.

The November 2006 decision by the French Supreme Court in the *EOS* case restricted the application of this article to certain assignments only.

That decision ruled that “only the agreements listed under article L132-2 al.1 of the French Intellectual Property Code, namely representation agreements, publishing agreements and audiovisual production agreements” were subject to specific requirements as to their form.

It therefore phased out the application of this provision for other kinds of transfer agreements. The court confirmed a Court of Appeal ruling which had decided that evidence of the assignment of copyright was free from formal requirements and that this evidence could be brought according to the general rules provided by articles 1,341 to 1,348 of the French Civil Code.

In a September 2009 decision the Supreme Court ruled the opposite way regarding a copyright assignment contract concluded between a teacher and a private establishment. This contract had provided for the transfer of the teacher’s rights related to all documents that were prepared by the teacher for a criminal law course. The teacher made a claim against the private establishment in respect of the publication of a book reproducing his course (same ideas, same lesson plan, and large extracts from the original texts).

The Court of Appeal considered that his action for infringement was inadmissible on the grounds that he was no longer the copyright owner. This decision was overruled by the Supreme Court for two reasons:

- (1) The assignment could not cover moral rights of the author; and
- (2) The judges had not ruled on the scope of application of the assignment and they did not check whether the field of application of the transferred rights had, in fact, been delineated in accordance with article L131-3 of the French Intellectual Property Code.

## The need to mention

Similarly, with regard to the amendment to an employment contract providing the exclusive and free transfer of intellectual property rights to the employer, the Supreme Court (labour chamber) recalled that every right to be transferred has to be expressly mentioned in the assignment agreement and that the field of application of the transferred rights has to be delineated with regard to its scope, its destination, its geographical extent and its duration.

“WHATEVER THE CREATOR’S SITUATION IS (EMPLOYEE OR FREELANCE), IT IS STRONGLY RECOMMENDED TO PUT IN WRITING THE ASSIGNMENT CONDITIONS OF ANY CREATIONS THAT MAY BE MADE.”

In a decision dated June 19, 2015, the Paris Court of First Instance ruled in the same way with regard to application of article L131-3 of the French Intellectual Property Code, and decided that the putting on the market of a range of fragrances constituted infringement in the absence of the authorisation or transfer of rights from the creator of the bottles.

The court observed that the transmission of the creator’s copyright is subject to the condition that each of the transmitted rights is individually mentioned in the deed of assignment, that these assignment agreements must be interpreted strictly, that the contract must enumerate the modes of commercialisation included in the assignment and that all non-expressly mentioned modes of commercialisation are deemed not to be assigned or licensed by the author.

To conclude, whatever the creator’s situation is (employee or freelance), it is strongly recommended to put in writing the assignment conditions of any creations that may be made, respecting the formal requirements of article L131-3 of Intellectual Property Code, until a harmonisation of the positions taken by different chambers of the Supreme Court arises. However, it has already been decided that these formal requirements do not apply between an assignee and a sub-assignee. ■

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