

HOW TO KEEP CONTENT SAFE WHEN IT TRAVELS TO THE EUROPEAN UNION AND IN PARTICULAR FRANCE?

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Los Angeles Copyright Society
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Protection of titles

- PROTECTION BY COPYRIGHT?

- Article L.112-4 of the French IPC

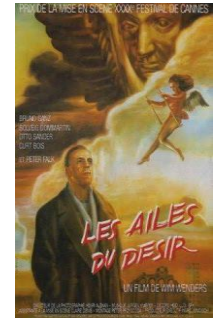
- Protection of the title as the work itself when it is original on the date of creation

YES: *Le Père Noël est une ordure* (« Santa Claus is rubbish »)

Les Ailes du désir (« Wings of desire »)

Modulor, Carview

Hara Kiri



NO: *Le Parrain* (« The Godfather »)

Tueurs de flic (« Cop killers »)

- If not original, still a protection if there is a risk of confusion for a work of the same genre

Protection of titles

- **FOREIGN TITLES CAN BE PROTECTED AS PER FRENCH LAW**
- Art. 5.2 of the Berne Convention: protection independent of the existence of protection in the country of origin
- Titles not listed in the Berne convention
- Case law: Application of French law /protection as per the law of the country where protection is claimed
 - « **Hors ligne** » /Offline (for a Swiss magazine)
original title - *Paris Court of Appeals (Sep. 20, 1994)*
 - **Fashion Television**/Fashion TV (for a TV program released in Canada)
not original-*French Supreme Court (Jan. 28, 2003)*

Protection of titles



THE TRANSLATION OF A TITLE CAN BE ORIGINAL

-No literal translation: **YES**

- Wuthering heights/Les hauts de Hurle-Vent, *Paris Court of Appeals* (Oct. 25, 1996)

-Literal translation: **NO**

- Fifty shades of Grey/Cinquante nuances de Grey, *Paris Court of Appeals* (Apr. 2, 2014)

➤ Recommendation

Make sure to acquire the rights to use the foreign translation

CHARACTER NAMES CAN BE ORIGINAL

Barbarella, *Paris First Instance Court* (Mar. 16, 2005): ORIGINAL

Protection of titles

- Does use as a title infringe a prior trademark?

- As the title of a standalone work: **NO**

A trademark should not prevent the use of a title as a title

Case law: « *Tout peut arriver* » (Something's gotta give) (2006)

« *Le Monde des choristes* » (2008)



Prior trademark



- Novelization, DVDs, Videograms, Phonograms, etc.: **NO**

Protection of titles

- Does use as a title infringe a prior trademark?
 - As the title of a collection or series or television show: **YES**
Example: The Glee case, London Court of Appeals, 2016



Can a title be considered as a well-known non registered trademark?

Decision T-435/05, June 30, 2009

- James Bond: **YES**
- Doctor No.: **NO**

Protection of titles

- Can a French title be asserted against a subsequent trademark?

If original, **YES** (Art. L 711-4 of the French IPC)

➤ Oppositions FR/ EUIPO: **NO**

➤ Cancellation and infringement actions: **YES**

➤ For all products and services

Example: A trademark for cosmetics in class 3 infringes upon the prior movie title Les Ailes du Désir, i.e., « *Wings of Desire* » (*Paris First Instance Court, January 25, 2016*)

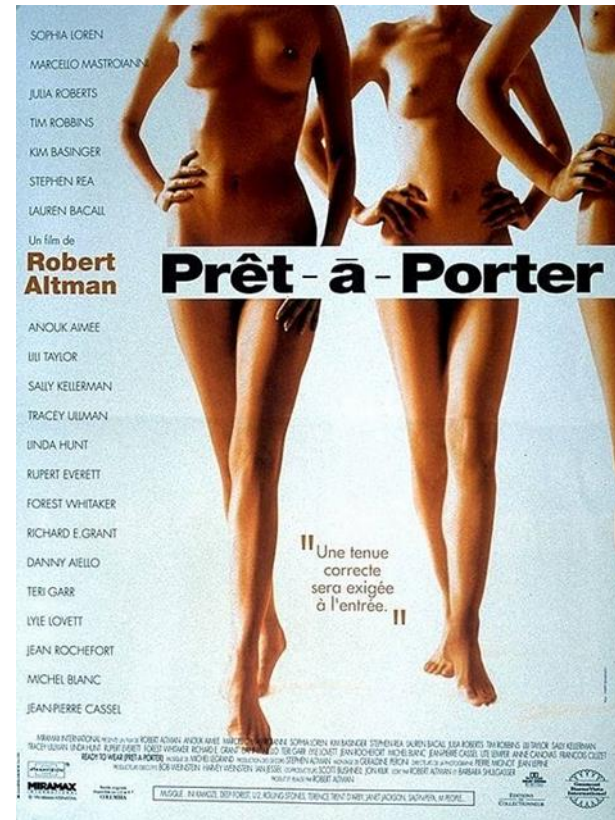
Content of the movie

- No protection of the idea
- No infringement if same idea is treated differently
- Infringement only if **similarities on elements that characterize originality**
- Theory of the « **chance encounter** » (*théorie de la rencontre fortuite*) developed by French Supreme Court since 2000:
 - **Accidental conjunction** / independent creations
 - If reminiscences from a common source of inspiration
 - if no possibility of access

Example: Supreme court, first civil chamber (Oct. 2, 2013)

EXAMPLES OF POSTERS

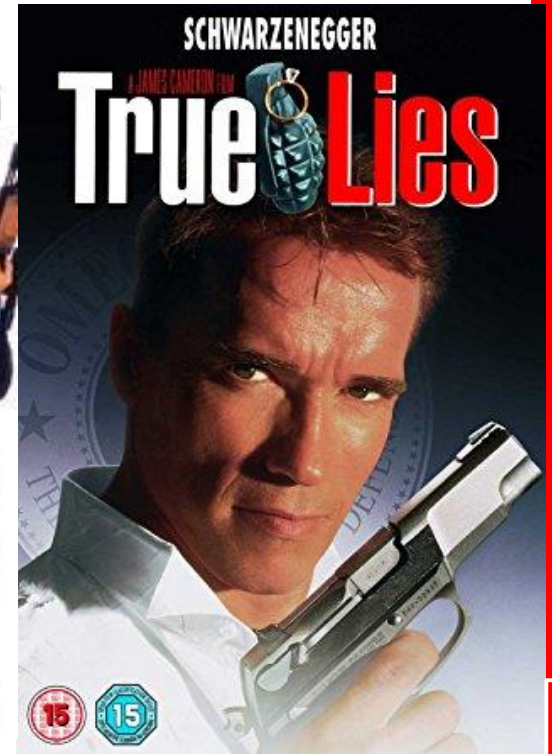
- H. Newton v. Gaumont, *Paris First Instance Court* (Jan. 17, 1997)



EXAMPLES OF MOVIES

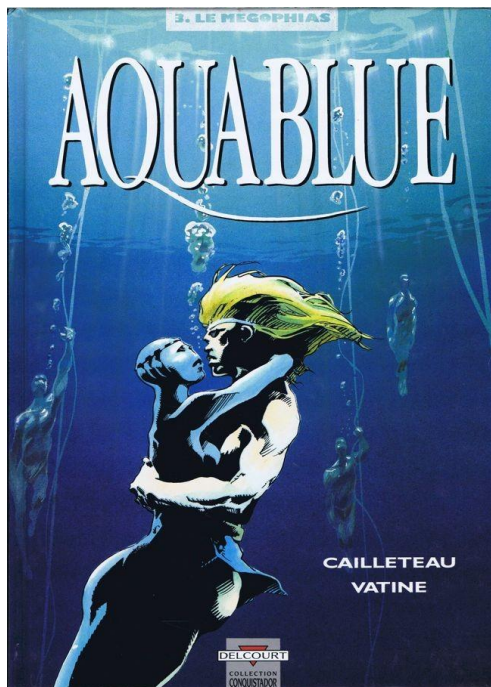
- L. Lambert v. C. Zidi and J. Cameron, *Paris Court of Appeals* (Dec. 19, 2007)

Prior screenplay Emily v./



EXAMPLES OF MOVIES

- *Avatar, Paris First Instance Court (June 26, 2015)*



EXAMPLES OF MOVIES

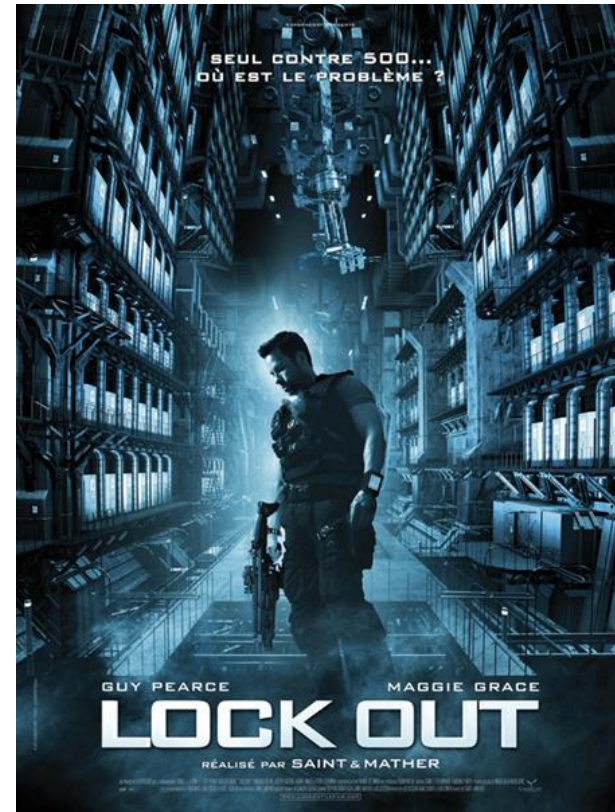
- The Artist, *Paris Court of Appeals* (Oct. 24, 2017)

Prior screenplay TIMIDITY



EXAMPLES OF MOVIES

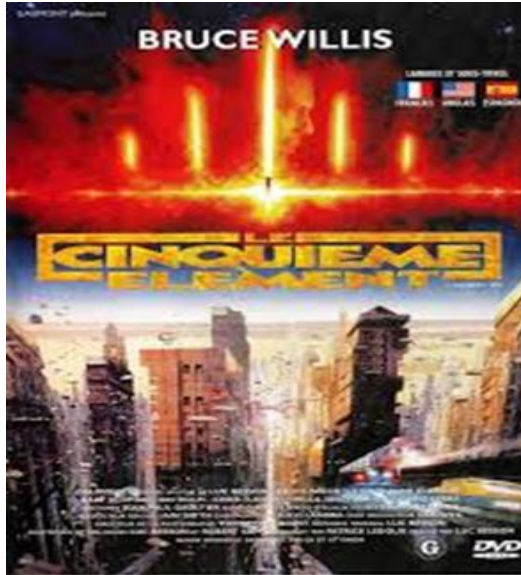
- Lock out / New York 1997, *Paris Court of Appeals* (June 10, 2016)



Example of an advertising

➤ SFR/The Fifth Element

Paris Court of Appeals (Sep. 8, 2004)



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➤ Infringement



Parasitism

Dior/Ferragamo

*French Supreme court, commercial chamber
(Feb. 4, 2014)*



➤ Parasitism

dtm
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Parasitism

C'était un rendez-vous, *Paris Court of Appeals* (Sep. 12, 2017)

- Mere inspiration OK
Anyone should be free to take inspiration in prior works
- No parasitism



Exceptions or limitations to copyright

Focus on freedom of panorama exception

- Article 5 of the INFOSOC Directive
 - mostly optional
 - not implemented in the same way in all countries
- Article 5.5 of the INFOSOC Directive
 - **three step test**
 - exceptions applied only
 - in certain special cases
 - which do not conflict with the normal exploitation of the
 - work
 - do not unreasonably harm the general interest of the author

Examples of architectural works protected by French Copyright Law



La Géode – La Cité des Sciences et de l'Industrie, Paris, France - © Unknown



PYRAMIDE DU LOUVRE, Paris, France - © Unknown



La Grande Arche de la Défense, Paris, France - © Don Weston

Examples of architectural works in the public domain



Examples of architectural works in the public domain



Survival of moral rights which are in perpetuity, inalienable and imprescriptible



The lighting of the Eiffel Tower is protected by copyright(*Supreme Court, March 3, 1992, SYN A.P.S and Karen von Spreckelsen v. Abeilles Cartes*)



The Centennial of the Eiffel Tower, Paris, France - © LE MONDE EN IMAGES

Freedom of panorama exception?

- Freedom of panorama exception provided by INFOSOC Directive
(a non-mandatory exception)

Article 5 (3) (h): « (...) use of works, such as works of architecture or sculpture, made to be located permanently in public places. »

- Different implementations according to the different EU countries
- Introduced into French copyright law by the *Law for a Digital Republic* of Oct. 7, 2016:
 - **Article L.122-5 (11°) of the French IPC:** « Once the work has been revealed, the author cannot ban [...] representations and reproductions of sculptures and architectural works placed permanently in public places, which are taken by individuals for non-profit purposes. »



ONLY FOR

NO GENERAL FREEDOM OF PANORAMA EXCEPTION
a late, partial and limited transposition

- Sculptures and architectural works
- Represented or reproduced by individuals
- For non-profit purposes

Freedom of panorama exception?

« **Background exception** » (*exception dite d'arrière-plan*)/ « *incidental principle* » (*theorie de l'accessoire*) established by **French case law**

- Supreme Court, 1st Civil Chamber, March 15, 2005, no. 03/14-820, D. Buren v. Editions Cellard:

The representation of a work located in a public place is not infringing when it is incidental to the subject treated.



Daniel Buren's fountains, Place des Terreaux, Lyons, France - © Daniel Buren



Place des Terreaux, Lyons, France - © Muriel Chaulet

Only incidental
No infringement

Freedom of panorama exception?

« **Background exception** » (*exception dite d'arrière-plan*) established by **French case law**

- Supreme Court, 1st Civil Chamber, July 4, 1995, no. 93/10.555, Aristide Maillol case:

The representation of a work located in a public place is legal only when it is incidental to the main subject that is represented or treated ; (...) as the sculptures were filmed in their entirety and close up, which was not necessary given the subject treated, they were voluntarily presented for themselves.



Aristide Maillol, *Monument à Cézanne* and *Trois Nymphes*, Tuileries Gardens, Paris, France - © Bernard Le Lann and © Véronique M.

Close up
Infringement

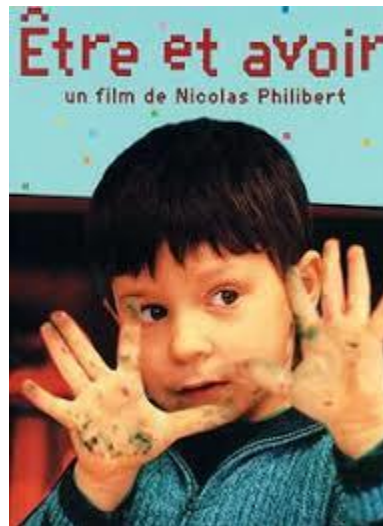
Freedom of panorama exception?

« **Background exception** » (*exception dite d'arrière-plan*) established by **French case law**

Not only for works in public space

➤ Etre et avoir, *Paris Court of Appeals* (Nov. 13, 2008) / (*Supreme Court* May.12, 2011):

22 posters protected by author's rights appeared in the background of a movie
These illustrations were also secondary in relation to the main subject of the film, since they [did] not appear on screen in a predominant way and remain in the background, and since they [were] never represented for their own sake.



Only incidental
No infringement

Freedom of panorama exception?

➤ Design and trademark infringement

Britney Spears v. Louis Vuitton, *Paris First Instance Court* (Nov. 14, 2007)



Close up
Infringement



For buildings: exception to the exceptions?

Kronenbourg v. Chambord Domain, *French Council of State* (Apr. 13, 2018)



➤ Image used in 2010 in a commercial

➤ No fees due

➤ But the decision would be different if the picture was taken today

For buildings: exception to the exceptions?



New provision of July 2016: **Article L. 641-42 of the French Heritage Code**

- Use of the image of **buildings in the « national domain »**
- Use for commercial purposes
- Subject to authorization and fees
- Authorization not required when image used for **artistic purposes**

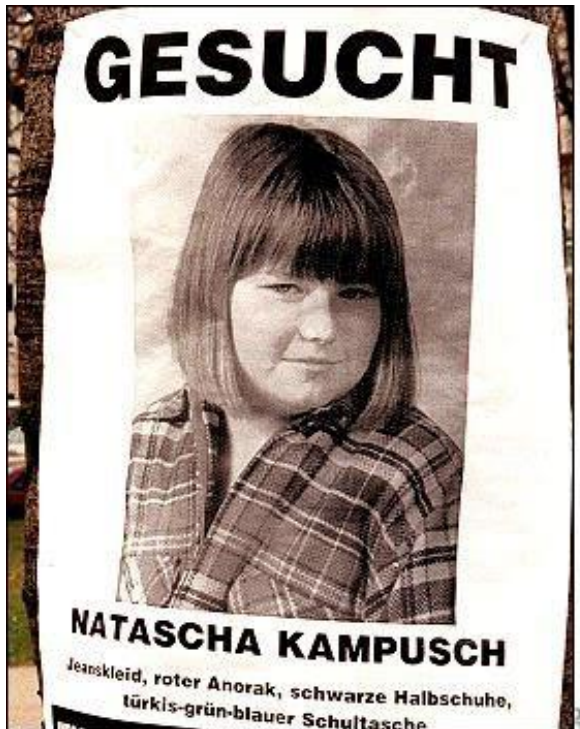
For buildings: exception to the exceptions?

- List of the **national domains** according to decree no. 2017-720 (May 2, 2017):
 - The Chambord domain
 - The Louvre and Tuileries domains (Paris)
 - The Pau domain
 - The Angers castle
 - The Élysée Palace (Paris)
 - The Palace of the Rhine (Strasbourg)

Fair balance of interests and rights

- No general fair use exception
- 3 steps test
- Case law : Fair balance of IP Rights with other fundamental rights

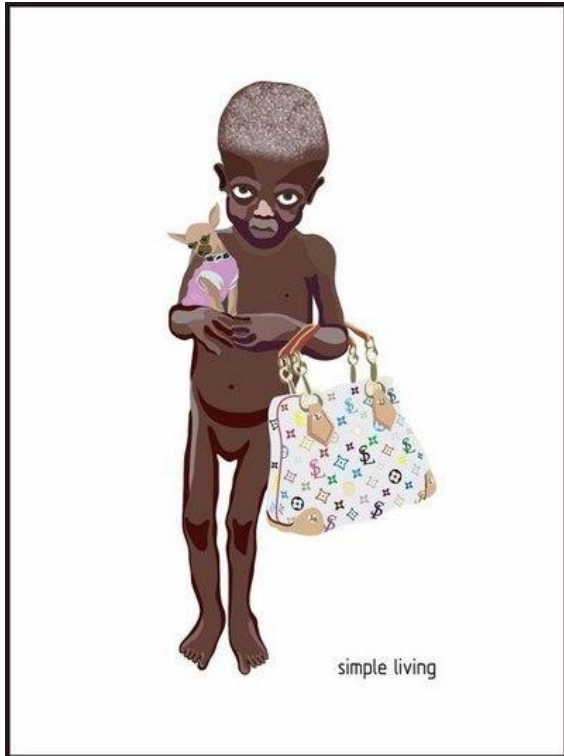
Painer, CJEU (Dec. 1, 2011, C-145/10)



- Pictures published in the press without the author's name and authorization
- Fair balance necessary in specific cases:
 - information purposes
 - Objective of public security
- Fair balance with freedom of expression prevailed over photographer's copyright, no copyright infringement

Fair balance of interests and rights

Vuitton v. Plessner, *The Hague Court of Appeals* (May 4, 2011)



- Photograph of an African kid holding a Vuitton bag
- The freedom of artistic expression prevailed over design rights, no infringement

Fair balance of interests and rights

Ashby Donald et al. v. France, *ECHR* (Jan. 10, 2013)

➤ **Article 10 of the European convention of Human Rights**



➤ Pictures of a fashion show

➤ French Supreme Court (Feb. 5, 2008):
copyright infringement

➤ ECHR: fair balance needed when interference with the right of expression and information

➤ ECHR: no violation of freedom of expression by the French Supreme court in this case

➤ No issue of general interest for society

Fair balance of interests and rights



Klasen, French upreme court, first civil chamber (May 15, 2015)

- Peter Klasen incorporated fashion pictures in his painting
- Supreme court: fair balance necessary
- Versailles Court of Appeals (March 16, 2018):
 - Up to the artist to evidence that there is a breach of freedom of expression
 - Photographs substitutable and not well-known
 - Copyright infringement



Fair balance of interests and rights

➤ Don't go too far!



Koons v. Naf Naf,
Paris first instance court (Nov. 8, 2018)

➤ copyright infringement



Koons v. Bauret,
Paris first instance court (March 9, 2017)



Exception of parody

➤ Exception of Parody in Copyright

- INFOSOC Directive Article 5.3 (k)

- Article L. 122-5 French IPC

- "Once a work has been disclosed, the author may not prohibit [...] parody, pastiche and caricature, observing the rules of the genre"

- humoristic intention

- absence of likelihood of confusion or intention to harm

- Case law:

- **Tarzoon, la honte de la jungle**
(Tarzoon, the shame of the jungle)

- **Les aventures de saint-tin et de son ami lou**
(adventures of Saint Tin and his friend Lou)

YES

- **CALIMERO**

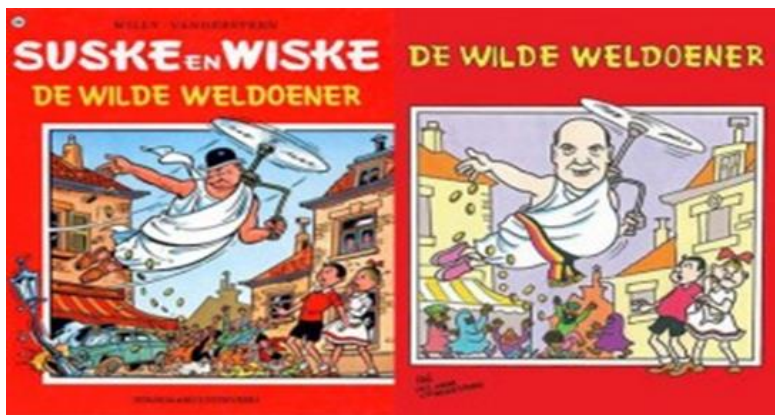
NO

- No exception of parody in trademark law



Fair balance of interests and rights

Deckmyn, CJEU (Sep. 3, 2014) C-201/13



- **2 essential characteristics for a parody:**
 - Evoking an existing work while being noticeably different from it
 - Constituting an expression of humor
- **Fair balance needed** between the interests and rights of authors and the freedom of expression of the user of a protected work
- **Taking into consideration « all the circumstances of the case »**
- **No parody in case of discriminatory message**

Moral rights

- Berne convention:
 - Right of paternity and right to integrity
- Article L. 121-1 of the French IPC:
 - **right of paternity, right to integrity, right of disclosure, right of withdrawal**
 - In perpetuity, inalienable and imprescriptible
 - The rules regarding moral rights are **public policy** and can never be waived

Moral rights

Asphalt Jungle, Supreme court, first civil chamber (May 28, 1991)



- Even when work made for hire agreement,
 - Application of the law of the country of protection
-
- Moral rights: international public policy
 - Moral rights cannot be waived
-
- Colorization = violation of moral rights

Moral rights

Barbelivien case (“on va s’aimer”/“on va fluncher”):

- Adaptation rights assigned including for advertising
- The lyrics of the song were then modified to promote the Flunch fast food chain Flunch in a TV commercial
 - *Inalienability of right to integrity*
 - *French Supreme Court (Apr. 2, 2009): “The inalienability of right to integrity, a principle of public policy, precludes the author from abandoning to the assignee, in a general and prior manner, the exclusive assessment of the use, dissemination, adaptation, withdrawal, addition and change which it would be appropriate for the latter to proceed”*
 - *MORAL RIGHTS ARE OF PUBLIC POLICY*

Moral rights

The little prince, *Supreme court, first civil chamber (June 12, 2001)*



- The adaptation of a book into a movie implies a certain freedom
- In this case the adaptation faithfully reproduced the plot and the personality of the main character
- Saint-Exupéry's heirs couldn't ban the adaption of The Little Prince into an animation movie
- Moral rights are not absolute

Moral rights

Les Misérables, Supreme Court, first civil chamber (Jan. 30, 2007)

Public domain



- two books published and presented as the sequels to “Les Misérables”:
 - *The freedom of creation precludes the heirs from prohibiting any adaptation*
 - *Sequel was faithful to the work which does not exclude a certain freedom of expression*
- Moral rights are not absolute

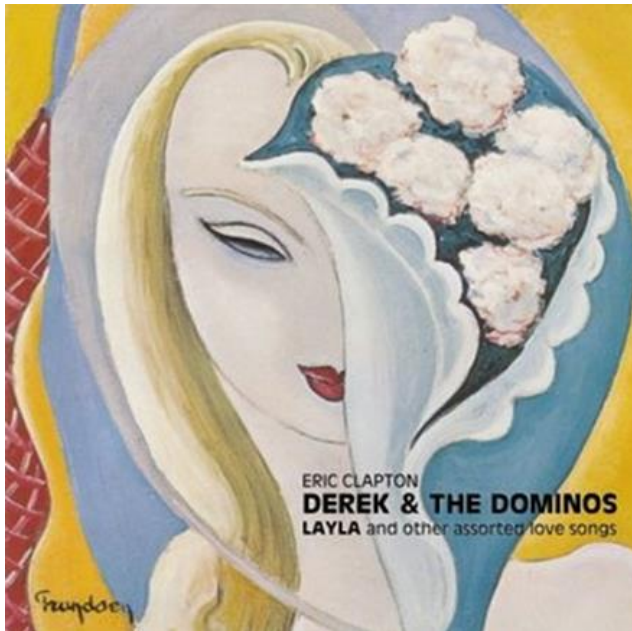
Moral rights

Dialogues of the Carmelites, *Supreme Court (June 22, 2017) and Versailles Court of Appeals (Nov. 30, 2018)*

- Staging of the opera with modifications in the last scene
 - Fair balance between freedom of creation and moral rights
 - Respect of the themes, possible interpretation
 - No violation of right to integrity
-
- Moral rights are not absolute

Moral rights

Eric Clapton, *Supreme court, first civil chamber* (Oct. 10, 2018)



- Painting offered to Eric Clapton used as the cover of his new album
- Violation of the moral right of disclosure

Is it an issue if a trademark is reproduced in a work of fiction?

- **Use in the course of trade = trademark infringement**
- **EU Directive 2015/2436:**
 - Article 14: *no prohibition of the use of signs or indications by third parties which are used fairly and thus in accordance with honest practices in industrial and commercial matters.*
 - Whereas 27 : Artistic use = fair use
- **No use in the course of trade:**
 - Pizza girl, with a common meaning
 - Primperan, for the sole purpose of dialogues
- **Possible unjustified exploitation of the mark:**
 - Primperan, mentioned only for side effects
 - Securitas, security company which was a cover for criminal activity

Contractual precautions when dealing with French authors

- **Agreements governed by foreign law**
- French courts apply **agreements governed by foreign law** if:
 - Legitimate choice of foreign law
 - Not contrary to international public policy (moral rights)
- Authorship governed by the **law of the country of origin or by the law of the country where the protection is claimed?** (art.5.2)
 - ABC news, Supreme court, first civil chamber (April 10, 2013) and Paris Court of Appeals (Oct. 5, 2018): **law of the country where the protection is claimed** (French law)
 - But specific case with no agreement signed between the parties

Contractual precautions when dealing with French authors

- **PRACTICAL RECOMMENDATIONS**

as regards work made for hire agreements

- Legitimate choice US law
- Include a jurisdiction provision
- Include an assignment of rights in the event the work is deemed not to be a work made for hire under the laws of any country
- **NO GENERAL WAIVER OF MORAL RIGHTS**
 - Right to integrity
 - Right of paternity

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Thank you for your attention

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