

Article

Moral Rights Clauses after Barbelivien

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Two recent French court decisions, one by the Court of Cassation and another by the Paris Court of Appeals, illustrate the difficulty of drafting moral rights clauses. Before the Court of Cassation decision, practitioners could rely on a 2000 Paris Court of Appeals decision¹ holding that an author's advance written consent to certain listed modifications to the work was a valid exercise of moral rights, not an invalid waiver of them. But the Court of Cassation reversed in January 2003,² holding that the advance consent to the modifications was invalid. Meanwhile, in a separate case, the Paris Court of Appeals held in March 2003³ that an author's advance consent to the insertion of television logos and commercial breaks was valid. We are now left in a situation where the advance consent to a specific, objectively defined alteration of a work (e.g. the insertion of a channel logo on the screen) will be held to be a valid exercise by the author of his or her moral rights, but the advance consent to a long list of alterations will be held to be an invalid waiver or assignment of those rights. Somewhere in between these two extremes lies the perfect moral rights clause: a clause in which the author gives his or her advance consent to certain well-defined modifications of the work, but which does not go so far as to grant a broad (and therefore unenforceable) assignment or waiver of the author's moral rights. At least as important as the wording in the clause itself is the conduct of the right holder and of the author. French courts tend to look more kindly on entities that make a good faith effort to get the author's input to a proposed alteration. Moral rights cases are highly fact specific, making it difficult to extract hard-and-fast rules from the case law.

The Facts of the Barbelivien Case

The composer and lyricist of the popular song "On va s'aimer" granted to their publisher the right to alter the song, to use it in commercials and to modify its lyrics, all in the publisher's (or its assignee's) discretion. The publisher granted a sub-licence to an

1. Paris Court of Appeals, June 28, 2000, (2000) 187 RLD.A.
2. *D Barbelivien v S&A Agence Business*, Cass. (1^{ère}) Civ., January 28, 2003, (2003) 196 RLD.A. 415.
3. *MD Productions v France*, Paris Court of Appeals, March 14, 2003.

Italian company, which in turn granted a sub-licence to an advertising agency. The advertising agency modified the song's lyrics to vaunt the benefits of the "Flunch" fast-food chain: instead of singing "On va s'aimer", the performers sang "On va Fluncher". The Paris Court of Appeals held that the composer and lyricist had not waived their moral rights (a waiver would have been invalid), but had validly exercised their moral rights by authorising the publisher to do certain well-defined things, including modifying the lyrics and using the song in a commercial. The sub-licencee did exactly what had been contemplated to the original licence agreement: the sub-licencee modified the lyrics and used the song in a commercial. The authors therefore had nothing to complain about. The Paris Court of Appeal's decision raised some hope for practitioners that an author could give his or her consent in advance to certain explicit modifications of the work, and that the consent would be recognised by French courts.

The Court of Cassation disagreed. The Court of Cassation held that the clause was invalid both because it amounted to an invalid "global assignment" of moral rights, invalid under Art. L 112-1 of the French Intellectual Property Code, and because it amounted to an illusory contractual condition, invalid under Art. 1174 of the French Civil Code. This second ground for invalidating the clause is novel; we will examine it below. But let us start by looking at the first ground for invalidity, which is based on traditional notions of moral rights.

Background to moral rights

As many readers know, the French moral rights statute gives authors, in addition to their economic bundle of rights, a bundle of non-economic, or moral, rights. The economic rights (e.g. the right to perform, to adapt, to reproduce the work) can be licensed or sold outright to third parties. The economic rights for motion pictures are generally assigned to the producer in exchange for the producer's undertaking to pay the author a proportional remuneration.⁴ The non-economic "moral" rights cannot be assigned.

4. French Code of Intellectual Property ("CPI"), Arts L 132-24, L 131-4.

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They are inalienable,⁵ and remain inseparably attached to the author's persona. They also last forever.⁶ In theory, the heirs of William Shakespeare could sue today in a French court to object to a modification of *Romeo and Juliet*. In practice, such an action might prove difficult, due to the high burden of proof placed on heirs of long-dead authors.

Moral rights give the author the right to ensure that he or she gets credit as the author of the work.⁷ This right, referred to as the right of attribution, is well known to US studios because it is similar to the rights conferred on screenwriters and directors under applicable guild agreements. The US Lanham Act also provides some protection of the right of attribution, albeit reduced as a result of the recent *Dastar* case.⁸

Where miscomprehension begins is in connection with the author's right to ensure "respect" of his or her work. The right of "respect" includes the right to object to anything that harms the work's "integrity". Taken literally, this means that an author can object to any modification to his or her work, no matter how minor, since any modification would, by definition, affect the work's integrity. Both statute and case law limit this rule somewhat, yielding an approach that is fact specific and sensitive to the right holder's and author's conduct and motivations in a given situation.

Moral rights are put on hold during production

One limit to the author's right to ensure "respect" of the work flows from the moral rights statute itself. The statute provides that authors of a motion picture may only exercise their moral rights with regard to the *finished* motion picture.⁹ Readers may recall that a motion picture is deemed a "collaborative" work under French law, meaning that several individuals are presumed to be joint authors of the work: the director, the screenwriter(s), the author of the adaptation and dialogue (if he or she is a different person from the screenwriter), the composer of the original music, and the author of the underlying literary work (if any).¹⁰ Each of these individuals is presumed a co-author, absent proof to the contrary. If each author could object to any modification of his or her contribution to the film while the film is being produced, the film might never be finished. Any one of the co-authors could hold this picture hostage because of an artistic whim. To protect against this kind of deadlock, the French moral rights statute provides that authors' moral rights shall be put on hold while the film is being made. Authors may exercise their moral rights, but only with regard to the finished picture.

But who decides what constitutes the "finished picture"? Generally speaking, the director and producer must agree on the final cut. The French Code's language is ambiguous: "The final version is decided by the director, and as the case may be the other co-authors, on the one hand, and the producer, on the other

hand."¹¹ Case law has interpreted this provision as meaning that as among the various co-authors of the picture, the director has final say, and can overrule dissent expressed by other co-authors as regards the content of the final cut.¹² For this purpose, the director has more power than the other co-authors, as long as the director acts in good faith *vis-à-vis* the other co-authors, taking their views into account.¹³ Once a film is complete, authors once again have full rights to raise moral rights claims.

Second limit: screen adaptations

One area of concern is whether the author of a pre-existing literary work can object to the screen adaptation. Here case law tempers the otherwise harsh rule of moral rights. Normally, the right to integrity permits the author to object to any change in his or her work. The judge is not supposed to second-guess the author's judgment. If the author objects to a given modification, that is sufficient in itself to constitute a moral rights violation, whether or not the author's position might be considered reasonable. This highly subjective approach does not apply to motion picture adaptations of literary works. French judges have held that a motion picture adaptation of a novel necessarily involves changes to the underlying storyline and characters. A novel cannot be transposed "as is" to the screen. Once an author gives his or her authorisation to a motion picture adaptation, he or she necessarily understands that the screenwriter and director may modify the plot, add or delete characters, as long as the screenplay respects the "spirit" and "themes" of the underlying work. This rule flows from the Court of Cassation's 2001 decision in the *Little Prince*.¹⁴ Judges apply a objective reasonableness test, instead of the subjective approach traditionally applied to moral rights claims.

Legitimate theatre: courts are less forgiving

For legitimate theatre, courts give directors limited artistic freedom to modify plays. The director of a play cannot disregard the instructions of the playwright without running afoul of moral rights. The most famous example involves Samuel Beckett's *Waiting for Godot*.¹⁵ A director wanted to stage the play using actresses, even though Beckett had indicated that the roles were to be played by male actors only. The director argued that as part of his artistic freedom, he had the right to innovate. The court disagreed, holding that this staging of *Godot* violated Beckett's moral rights. The stricter standard applied to legitimate theatre is no doubt attributable to the fact that stage plays are originally written for performance on the stage. The director of legitimate theatre, like the conductor of a symphony orchestra, performs the work according to the playwright's instructions. There is not the same kind of metamorphosis as that involved in transforming a novel into a film. As explained by one lower court, the director of a

5. CPi, ArtL 121-1.

6. *Ibid*.

7. *Ibid*.

8. *Dastar v 20th Century Fox*, 123 S.Ct. 2041, 2003 U.S.

LEXIS 4276 (2003); see Jane Ginsburg, "Developments in US

Copyright since the Digital Millennium Copyright Act, Part II"

(2003) 197 R.L.D.A. 155.

9. CPi, ArtL 121-5.

10. CPi, ArtL 113-7.

11. CPi, ArtL 121-5.

12. See A. Lucas and H.-J. Lucas, *Traité de la Propriété*

Littéraire et Artistique (Ulac 2001), s.1194.

13. *Enola Films v Léo Ferré*, Paris Court of Appeals,

December 2, 1968.

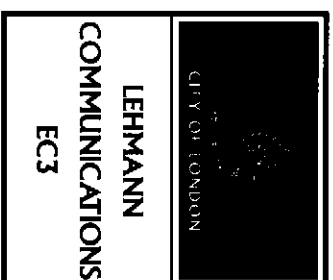
14. Cass. Civ., June 12, 2001.

15. *London v Boussagol*, Paris Tribunal de Grande Instance,

3d Chamber, October 15, 1992.

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play must be "faithful to the text, preserving the concept of the author in translating the author's intent on the stage".¹⁶

Using characters out of context

Some motion pictures do more than simply change the storyline of the underlying literary work. They may ignore the storyline completely, borrowing only the character from the underlying work. This happened in connection with the "Fantomas" novels, written by Marcel Allain. Gaumont used the Fantomas character but did not use the author's underlying story. The author sued, claiming a violation of moral rights. The Paris Court of Appeals rejected the author's moral rights claim, holding that the author had agreed to license to Gaumont the right to use the Fantomas character out of context, in stories unrelated to the original novels.¹⁷ Gaumont's usage of the character violated no moral rights, held the Court, as long as the movie credits did not mislead the public by suggesting that the story was based on the Allain novels. The credits should indicate only that the film is based on the character created by Marcel Allain. This shows how much moral rights cases can resemble Lanham Act cases in the United States. Though not discussed by the Court, the outcome of the *Fantomas* case was no doubt linked to Gaumont's treatment of the subject. Gaumont respected the spirit of the original Fantomas character, thereby satisfying the "spirit" test mentioned in the *Little Prince* case for motion picture adaptations. If Gaumont had distorted the character, by transforming him into a serial killer, for example, the Court would no doubt have reached a different outcome. In one case involving a comic strip character, the court found that the motion picture producer had violated the author's moral rights because the character had been portrayed as a "violent" character.¹⁸ Unfortunately, the cases draw no bright lines; common sense is the rule.

Modifying the picture after it has been completed

French courts have shown little tolerance for changes made to a motion picture once it has been completed. Seemingly minor changes made to the final cut have been held to violate the director's and other co-authors' moral rights.¹⁹ Courts revert to a strict, absolutist approach, as opposed to the "spirit and themes" test applied under the *Little Prince* case for motion picture adaptations. French case law provides abundant examples of small modifications that can constitute a breach of moral rights: inserting a commercial break in the middle of a movie²⁰; breaking the movie into two parts²⁰; inserting a channel logo on the TV screen²¹; editing the movie to make it shorter²²; modifying credits²³; adding

a soundtrack²⁴; colourising a black and white movie²⁵; and changing the sound format.²⁶ As moral rights cases have proliferated, it has become commonplace in French contracts to ask each of the co-authors of the picture to accept in advance, in their contract, certain modifications to the finished film. Authors agree in advance to the insertion of a channel logo and to commercial interruptions, for example. As demonstrated by the March 14, 2003 Paris Court of Appeals decision, those clauses are generally held to be valid. If these two contractual provisions involving channel logos and commercial interruptions are valid, why could not one go further, by including a list of 20 other possible modifications, and asking the author expressly to accept each of those as well?

The Limits of Contractual Consents

This goes to the heart of the two decisions that are the subject of this article. In the March 14, 2003 Paris Court of Appeals case, the authors of a book (*The Judge and the Prostitute*) challenged a motion picture adaptation agreement on several grounds, including that the contractual clause in the agreement purporting to give advance consent to insertion of commercial breaks and the TV channel logo constituted an illegal waiver of the authors' moral rights. The Paris Court of Appeals rejected the authors' claim, finding that the clause did not amount to a waiver of moral rights, since the authors retained the ability to raise moral rights claims later, in the event the channel logo or commercial breaks went beyond the bounds of what was reasonable in light of the authors' work. The court said that the authors would remain free to raise their moral rights claims

"if the conditions of exploitation of their work with commercial interruptions and logo violated their moral right via distortion of their work by numerous commercial interruptions (which would be contrary to French law anyway) or by a logo which would be in a spirit contrary to the work or which might harm the authors' honour, for example. Contrary to the assertion by the plaintiffs, this clause cannot be considered as a waiver of moral rights."

This holding by the Paris Court of Appeals suggests that an author may agree contractually to certain future modifications to the finished movie, because the author always retains his moral right to object in case the producer or licensee goes beyond what is reasonably contemplated at the time the author signed his or her contract. As we saw in the *Barbelivien* case, however, if the contract lists too many modifications, or if the modifications are discretionary, the clause is invalid. The reason the clause in the *Judge and the Prostitute* works and the clause in *Barbelivien* does not, is that the modifications listed in the *Judge* contract are objectively delimited. They refer to events that are part of normal French broadcasting practice, regulated by French broadcasting law. The author could always object, based on his or her moral rights, if a

16. *Zorbie v Lucernaire*, Paris Tribunal de Grande Instance, 1st Chamber, November 27, 1985.
17. Paris Court of Appeals, November 23, 1970.
18. *Borg v Eurodiff*, Paris Tribunal de Grande Instance, 3d Chamber, December 1, 1983.
19. *Carle v TFI*, Paris Tribunal de Grande Instance, 1st Chamber, May 24, 1989.
20. *Ibid*.
21. *Marchand v La Cinq*, Paris Tribunal de Grande Instance, 1st Chamber, June 29, 1988.
22. *Schoendorfer v MOD films*, Paris Tribunal de Grande Instance, 3d Chamber, March 23, 1994.
23. *Argos Films v Mews*, Paris Court of Appeals, March 9, 1989.

24. *Chaplin v Les Films Roger Richabá*, Paris Court of Appeals, April 29, 1954.
25. *Turner Entertainment v Huston*, Versailles Court of Appeals, December 19, 1994.
26. *AD Disques v Bregovic*, Paris Court of Appeals, June 29, 2001.

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channel logo suddenly tripled in size, or if the channel inserted ten commercial breaks instead of the customary (and legally permitted) one.

In *Barbeilvien*, the clause contained no objective limits. The modifications were open-ended, subject only to the discretion of the licensee. A narrower clause might be valid. For example, a clause pursuant to which an author gives advance consent to cuts of violent or sexually explicit scenes, as required by censorship authorities, might be valid. From a moral rights standpoint, cutting footage is more sensitive than the insertion of a channel logo. Nevertheless, a cut required by censorship authorities is an objective and well-defined event, particularly if further limited in the contract to violent or sexually explicit scenes. If the cutting process went awry, extending beyond the violent or sexually explicit scenes originally contemplated in the contract, the author could always raise a moral rights objection. Under the Court of Appeal's reasoning in *The Judge and the Prostitute*, this kind of clause should work.

If we posit that a censorship clause such as the one used in the previous example might work, why would not a clause permitting the film's distributor to edit the film to adapt it to local market and cultural conditions? In this example, we have no objective reference to censorship authorities, but instead a vaguer concept of "local market and cultural conditions". This clause would permit the distributor of an Asian movie to make cuts to make the film more accessible to Western audiences, more "jinnear". Here we are stepping nearer to the open-ended clause invalidated by the *Barbeilvien* court. Recall that there were two fatal defects in the *Barbeilvien* clause: the first was that it contained a long laundry list of possible modifications, which the court characterised as a "global waiver in advance" of moral rights. The second defect was that the clause permitted the modifications to be made in the licensee's discretion. This second aspect violated Art.1174 of the French Civil Code, which states that a contractual obligation that is subject to an illusory condition is null and void. An illusory condition is a condition that one of the parties has the power to make happen or not. An example is a contractual clause pursuant to which "I promise to mow your lawn on the condition that I finish my breakfast before 8am." Because I can decide whether I finish breakfast before 8am, the promise is null and void, being subject to an illusory condition.

The lesson here is that a moral rights clause (such as our hypothetical clause pursuant to which the author consents to edits required for local cultural or market conditions) needs some objectivity in order to be valid. Typically, one can overcome the problem of illusory conditions by referring the matter to an outside panel. In our hypothetical clause, we could imagine referring the issue of what edits are really necessary for local cultural or market conditions to an arbitration panel. Because the edits would no longer be within the sole discretion of the producer or distributor, the clause would be valid under Art.1174 of the Civil Code. But referring to an arbitration panel is antithetical to the moral rights statute, which provides that moral rights are "inalienable". The author can no more delegate the exercise of his moral rights to an arbitration panel than he can to a producer or distributor. The moral rights prerogatives remain inseparably attached to the

author's persona. It seems difficult therefore to design a clause that would permit the producer or distributor to make edits for local cultural or market reasons and still pass muster under the moral rights statute.

To the extent that certain well-defined modifications to the picture can be listed (e.g. pan and scan, logos, TV commercial interruptions, change in sound format to accommodate DVD, etc.), the author can validly give his or her prior consent to those changes, as demonstrated by *The Judge and the Prostitute* case. But if drafters go too far, creating a long list of every conceivable modification—however well-defined those modifications may be—the contract would collide with the *Barbeilvien* court's statement that "numerous possibilities" are tantamount to a "global waiver in advance" of moral rights. Moreover, a clause providing for modifications "in licensee's sole discretion" would be invalid under Art.1174 of the Civil Code.

Applicable Law and Sanctions

Applicable law was an issue in moral rights cases prior to the *Huston Asphalt Jungle* case. Prior to that decision, there was uncertainty as to whether a non-French author, bound by a non-French law contract, in connection with a non-French film, could invoke moral rights before a French court even though none of the normal choice of law rules pointed to French law. That debate was settled by the French Court of Cassation in 1991.²⁷ The Court held that moral rights rise to a sufficient level of public policy to be applied by a French court regardless of the nationality of the author, or of the provisions of foreign law governing the author's contract. Indeed, even if the person is not considered an author under the law applicable to his or her contract (a work-made-for-hire situation, for example), French courts would apply French concepts of authorship to qualify the person as the "author", and then proceed to apply the moral rights statute to that person's work. The Court in the *Huston* case relied on Art.1114 of the French Intellectual Property Code to justify its application of the moral rights statute to John Huston's work. Article 1114 provides that France is not required to provide copyright protection to certain foreign works if the home country of the work does not provide reciprocal protection for French works. But, the statute continues, in no event may the right of integrity or right of attribution relating to the foreign work be violated. The Court read this provision as meaning that French courts must *always* apply the protection of French moral rights, even to non-French works not otherwise entitled to protection in France. This special treatment of moral rights is also attributable to the Universal Declaration of Human Rights, which states that "Everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author."²⁸ Moral rights thus have a quasi-constitutional basis in French law as well, not unlike freedom of expression and other fundamental rights.

27. Court of Cassation, Civil Chamber, May 28, 1991.

28. Universal Declaration of Human Rights, Art.27(2).

The result of the *Huston* case is that a director or other individual recognised as an "author" under French law (regardless of whether he or she is considered an author under the law applicable to his or her contract with the producer) can walk into a French court and invoke moral rights claims even if he, the film and the contracts related to the film have no nexus with France. There does, however, need to be an act of exploitation in France giving rise to the alleged moral rights violation. A director cannot obtain redress in a French court because a truncated version of his film is being released in the United States, for example. Berne Convention Art. 16bis, para. 3, provides:

"The means of redress for safeguarding the rights granted by this Article [i.e. moral rights] shall be governed by the legislation of the country where the protection is claimed."

This argument was used against a French director who sued in a French court to complain about distribution of a DVD version of *Diva* in the United States. (The DVD released in the United States contained an allegedly modified soundtrack.) In emergency proceedings, the French court dismissed the director's claims on other grounds, not resolving the conflict of law question.²⁹ Nevertheless, when the exploitation is outside of France, there is a strong argument that the law of the country where exploitation is occurring should apply to the "means of redress", meaning remedies.³⁰ By contrast, where exploitation occurs within France, French courts would, under the *Huston* case, apply the full panoply of French law on moral rights, including sanctions. This principle was recently reaffirmed by the Paris Court of Appeals, in a case involving an Italian author and a contract governed by UK law. The French Court applied UK law to the issues involving the author's "economic" rights and French law to issues involving the author's "moral" rights.³¹

Waiver and Indemnification Clauses

Many US- or UK-law contracts contain a covenant by the author not to bring a claim for alleged breach of moral rights. This clause would have no value before a French court, but could give rise to a claim for damages against the author before a foreign court or arbitration panel, should the author attempt to invoke moral rights to block the release of the picture in France. The success of any such claim, and the amount of damages awarded, would depend on the facts surrounding the author's claims. A US court or arbitral tribunal may find an author liable for damages if he used his moral rights in bad faith as a tool to renegotiate his contract. But if the author brought a moral rights claim in reaction to some improper conduct by the producer or distributor, a court or arbitral tribunal may find that the producer or distributor is estopped from raising a breach of contract claim against the author. Consequently, a covenant by the author not to raise a moral rights claim could serve as a deterrent against attempts by the author to use French moral rights as a negotiation tool. But even without such a clause,

French courts limit an author's ability to raise moral rights for the wrong reasons. Where it becomes clear that the author is only interested in money, French courts will bar the author's moral rights claims.³²

Remedies

French courts can temper the sometimes extreme aspects of moral rights claims by crafting appropriate remedies. In one well-known case, the court found that Rostropovich's moral rights as a performer were violated as a result of lewd sound effects contained in Zeffirelli's film *Boris Goudonov*.³³ But the court refused to enjoin the release of the film, preferring merely to order the insertion of a disclaimer in the main credits stating that Maestro Rostropovich did not approve of some of the sound effects. A disappointing outcome for Maestro Rostropovich, due in part to the fact that Rostropovich was only a performer, not an author. (Moussorgsky's heirs might have had a moral rights claim on behalf of the dead composer.) But the fact remains that courts will temper the extreme nature of moral rights when crafting sanctions. Where it appears that the producer or distributor is running roughshod over an author's moral rights, an injunction barring the release of the film may be issued. But if the court senses that the producer or distributor has tried to address the author's concerns, but that the author is just being unreasonable, or being a nuisance to increase his bargaining leverage, the court may find that there is a technical moral rights violation, yet that the sanction should be limited to symbolic damages or a disclaimer. As noted above, where it is clear that an author's motivation for bringing a moral rights claim is not really related to artistic integrity but rather serves as a pretext for the negotiation of better royalties, courts will dismiss the claim as a "misuse" of moral rights.³⁴

Burden of Proof

Finally, courts will be particularly careful when dealing with heirs of dead authors. Moral rights last forever, which means in theory that a modification of *Romeo and Juliet* could give rise to a claim by Shakespeare's heirs. To guard against abuse, courts will impose a higher burden of proof, both as to the plaintiff's standing to sue (i.e. "how can you prove that you hold the moral rights of Victor Hugo?"),³⁵ and as to whether the modification being complained of is really something to which the dead author would have objected. The *Huston* case is a good illustration. Angelica Huston did not simply assert that her father would have objected to colourisation, she produced statements published during her father's lifetime in which John Huston said he objected to colourisation. John Huston's position on colourisation was a matter of public record. An heir that simply asserts that "my father would have objected" will be greeted with some scepticism by French courts.

29. *Behnek v. Sudio/Canal Images*, Nanterre Tribunal de

Grande Instance, Référé, December 4, 2002.

30. *Société Informatique Service Réalisation Organisation v. Ampérand*, Cass. Civ., March 5, 2002.

31. *Marduelly v. Gallinard*, Paris Court of Appeals, 4th Chamber, April 2, 2003, (2003) 198 RLD.A. 413.

32. *Chilverino v. SFE*, Court of Cassation, Civil Chamber, May 14, 1991.

33. *Rostropovich v. Erzo*, Paris Tribunal de Grande Instance, January 10, 1990.

34. *Chilverino v. SFE*, above, n.32.

35. *Hugo v. Pion*, Paris Tribunal de Grande Instance, 1st Chamber, September 12, 2001.