

FRENCH REFORM OF AUTOMATIC INTELLECTUAL PROPERTY ASSIGNMENT FOR NON-EMPLOYEE PERSONNEL

Date: 29 December 2021

Paris Intellectual Property Alert

By: Camille J. Scarparo, Claude-Étienne Armingaud

France is widely known for its author-centric intellectual property right (IPR) framework: except for a limited number of very specific situations, all IPR must be expressly assigned and there is no “work for hire” doctrine.

This situation is changing, further to Decree n°[2021-1658](#) dated 15 December 2021, replicating the regime applicable to inventions and software created by employees or public servants to those made by natural persons accommodated by private or public law entities carrying out research.

This decree amended the French Intellectual Property Code (FIPC), by creating two new articles: [L.113-9-1](#) (with regard to software IPR) and [L.611-7-1](#) (with regard to patent IPR) FIPC.

THE AFFECTED STAKEHOLDERS

“Accommodated” Workers - The Affected Authors

The authors referred to in the decree are the natural persons who are not referred to in articles [L.113-9](#) and [L.611-7](#) FIPC, i.e. non-employees, but who would be “accommodated” within the framework of an agreement, by a private or public legal entity carrying out research.

The preliminary [Report to the President of the Republic](#) indicated that this category of “accommodated personnel” should be construed as to include “trainees, foreign doctoral students and emeritus professors or directors.”

While not explicitly stated, it may also be logically inferred to:

- Include other non-employee personnel such as persons volunteering international service in companies as, in this situation, there is an agreement between the person and the accommodating legal entity (article [L.122-7](#) of the French National Service Code).
- Exclude the case of independent consultants who would work for a company. In this case, while there is a consulting agreement, no accommodation properly speaking in the sense of the decree would be provided.

The Affected Beneficiary

Any legal entities under private or public law “carrying out research activities” would benefit from the assignment of the intellectual property rights. These terms, rather imprecise, could be interpreted as meaning any academic, theoretical or applied research, or even any structure with an R&D division to which the accommodated worker would be assigned.

A NEW AUTOMATIC STATUTORY ASSIGNMENT OF IPR

Software

Further to the new article [L.113-9-1 FIPC](#), the software authors should be (i) placed under the responsibility of the accommodating legal entity and (ii) receive compensation (e.g. internship allowance).

According to the [Report](#), the consideration may be financial or material.

Without such compensation, the accommodating entity will not be able to benefit from the new framework and the author will remain the owner of the underlying IPR.

Patentable Works

All three pre-existing categories of inventions under article [L.611-7 FIPC](#) (detailed below) have been transposed to this new regime under article [L.611-7-1 FIPC](#).

Mission Works

Further to article [L.611-7, 1° FIPC](#), mission works (i.e. invention created in the execution of (i) an agreement including an inventive mission or (ii) studies and research specifically entrusted to the worker) belong ab initio to the accommodating entity.

However, the inventor remains entitled to receive an additional compensation.

Non-Mission Pre-Emptible Works

Further to article [L.611-7, 1° FIPC](#), invention resulting from the performance of the missions and activities within the accommodating entity by the accommodated worker are referred to as “non-mission pre-emptible” inventions.

They mainly include inventions generated within the realm of the activities of the accommodated worker and:

- Over the course of the performance;
- During mission/activities hours;
- On the premises of the accommodating entity; or
- With the material, organizational or computerized means provided by the accommodating entity.

In case of non-mission pre-emptible inventions, article [L.611-7, 2° FIPC](#): mandates a right of first refusal to the benefit of the accommodating entity which, if exercised, would make such entity the owner ab initio of the non-mission pre-emptible works, subject to the author compensation for the assignment of ownership of the works. With regard to such compensation, the only indication thus far, like for the pre-existing employee regime, is that it should be a “fair price,” which may be specific in upcoming regulation.

Non-Mission Non-Pre-Emptible Works

Any other works, commonly referred to as “non-mission non-pre-emptible” inventions belong to their inventors, who remain free to use, file for patent or assign as they see fit.

DISPUTE RESOLUTION MECHANISMS

With respect to software under article [L.113-9-1 FIPC](#), the decree provides that any dispute is to be brought before the court where the accommodating entity has its registered office.

With respect to inventions, any dispute relating to the compensation or the classification is to be brought before the conciliation commission referred to in article [L.615-21](#) FIPC or, failing such mediation remediation, before the competent court.

K&L Gates [Intellectual Property](#) team remains available to assist you in the implementation of this new framework.

KEY CONTACTS



CAMILLE J. SCARPARO
ASSOCIATE

PARIS
+33.1.58.44.15.11
CAMILLE.SCARPARO@KLGATES.COM



CLAUDE-ÉTIENNE ARMINGAUD
PARTNER

PARIS
+33.1.58.44.15.16
CLAUDE.ARMINGAUD@KLGATES.COM

This publication/newsletter is for informational purposes and does not contain or convey legal advice. The information herein should not be used or relied upon in regard to any particular facts or circumstances without first consulting a lawyer. Any views expressed herein are those of the author(s) and not necessarily those of the law firm's clients.