

Abiding by the law is key when assigning copyright

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Like other forms of intellectual property, copyright can be transferred by an assignment agreement between the author of the original work and an assignee. Assignment agreements create legal and enforceable rights and can be effectively enforced in case of any breach. However it is important to determine the ownership before assigning the copyrighted work, e.g. if it was created by an employee, whether it was created during the course of employment must be determined.

Legal framework

Sections 18 and 19 of India's Copyright Act, 1957, provide for assignment and mode of assignment of copyrighted work. "Assignment" is not defined in the act and its existence can be inferred from the agreement terms.

The law clearly states that both existing and future works can be assigned, provided that the assignment of future works will come into effect only after the work is created. The Supreme Court in the case of *Indian Performing Rights Society v Eastern Indian Motion Picture Association* (1977) held that an existing and future right of a music composer and lyricist was capable of assignment, subject to the conditions that the assignment would take effect only when the work came into existence and the assignment had to be in writing, signed by the assignor or his duly authorized agent.

The author of a copyrighted work may assign the work to any person – either wholly or partially, and either generally or subject to limitations, and either for the whole or any part of the term of the copyright. Once the work is assigned the assignee will be treated as the owner of the assigned

work for the purposes laid down in the Copyright Act.

Every assignment to have effect must be in writing and be signed by the assignor or their duly authorized agent. The assignment must always be recorded as per the law and the terms must be brief and clear. The terms of assignment, the rights assigned, the amount of royalty payable, and the duration and territorial extent must be included in the assignment. Where period of assignment is not mentioned it will be deemed to exist for five years from the date of assignment and if the territorial extent is not mentioned it will be presumed to extend within India.

To ensure that assignments are done for some fruitful purpose and not to impede others who might wish to use the same work, the assignee should exercise the rights in the agreement within one year. Failing to do so may result in the lapse of the assignment unless otherwise agreed between the parties.

Dispute resolution

Section 19A of the Copyright Act provides a mechanism to resolve disputes arising out of assignments. If an assignee fails to exercise their rights under an assignment agreement the assignor may file a complaint with the Copyright Board. The board after sufficient investigation may revoke the assignment. An aggrieved assignee may also ask the board for an order for the recovery of any royalty payable.

An assignment agreement can be enforced either by filing a suit for damages under section 73 of the Indian Contract Act, 1872, or by a civil suit for specific performance under section 10 of the Specific Relief Act, 1963. The aggrieved party can also file a criminal action for breach of trust under section

405 of the Indian Penal Code, 1860.

Section 57 of the Copyright Act confers moral rights on the author which exist independent of any assignment agreement and can be claimed even after the work has been assigned. Moral rights allow the author to claim authorship and to restrain or claim damages with regard to any distortion, mutilation or modification of the copyrighted work which occurs before the term of copyright expires and would be prejudicial to the author's honour or reputation.

Why assignments?

Assignment plays a pivotal role in completing works which require works of others to be incorporated in them, e.g. a cinematographic film, which generally includes literary, dramatic and musical works and, in many cases, pre-existing sound recordings. Each of these elements may be separately copyrighted to different people. The producer, who is generally the author of the film, may not own copyright in all copyrighted material incorporated into the film, such as the screenplay or the music. These may be incorporated by way of assignment agreements between the producer and the owner of other copyrighted works.

Authors spend their time and other resources to create copyrighted work and when the product is ready they desire benefit from it. Assignment of copyright brings monetary and commercial gain to those who invest their money and effort in creating new work. However authors and assignees must be careful to comply with the law when entering into assignment agreements.

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