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OWNERSHIP OF COPYRIGHTABLE WORKS OF UNIVERSITY PROFESSORS: THE INTERPLAY BETWEEN THE COPYRIGHT ACT AND UNIVERSITY COPYRIGHT POLICIES

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I. INTRODUCTION

THE ownership of copyrightable works produced by university professors has become an issue of interest in the scholarly world since the publication in 1983 of an influential article on the subject.¹ The ownership issue has become of interest also to university administrators since the 1970s, when administrators began to covet certain of these copyrightable works for their universities.² The broader topic of the commercialization of all the products of university research, patentable, copyrightable and other, has become a subject of general interest and concern in the past decade.³ The purposes of this Article are narrow: to address the

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1. See Todd F. Simon, *Faculty Writings: Are They "Works Made for Hire" Under the 1976 Copyright Act?*, 9 J.C. & U.L. 485 (1983). Simon concludes that university professors do not own their copyrightable works under copyright law and advises university professors to obtain a written agreement from the university that guarantees ownership of the copyright to the professor. See also Rochelle C. Dreyfuss, *The Creative Employee and the Copyright Act of 1976*, 54 U. CHI. L. REV. 590 (1987) (contending that removal of copyright ownership from creators will reduce quality and quantity of created work); Leonard D. DuBoff, *An Academic's Copyright: Publish and Perish*, 32 J. COPYRIGHT SOC'Y 17 (1985) (arguing that work-made-for-hire doctrine as codified could undermine professors' incentive to create); J.H. Reichman, *Computer Programs As Applied Scientific Know-How: Implications of Copyright Protection for Commercialized University Research*, 42 VAND. L. REV. 639 (1989) (surveying problems in university policy regarding computer software).

2. For a further discussion of the interest of universities in ownership of works produced by university professors, see *infra* notes 120-58 and accompanying text.

3. See, e.g., Reichman, *supra* note 1, at 646-47; Wayne Biddle, *A Patent on Knowledge*, HARPER'S, July 1981, at 22; Naomi Freundlich, *Business Goes to College*, BUS. WK., June 16, 1989, at 50; *Institutions and Scholars Face Ethical Dilemmas Over*

questions of who now owns the copyrightable works of professors, how universities currently attempt to control such ownership issues, and how these issues should be controlled.

Part II presents an analysis of work-made-for-hire⁴ cases under the Copyright Act of 1909 (the 1909 Act).⁵ This analysis differs from that of prior commentators by making clear the limited role of agreements that grant the employee ownership of the copyright in employee-created works. Part III explores the existence of an exception for professors from the work-made-for-hire doctrine prior to the Copyright Act of 1976 (the 1976 Act).⁶ Part IV corrects a mistaken view of the impact of the 1976 Act, which is widely accepted, though unpopular with commentators and courts.⁷ Part V discusses whether university copyright policies are effective to alter copyright ownership. Part VI analyzes and critiques the copyright policies at seventy leading research universities in effect at some time between February of 1990 and February of 1991 inclusive. Part VII makes recommendations concerning the structure within which copyright ownership issues between the university and professors should be resolved.

II. WORKS MADE FOR HIRE UNDER 1909 ACT

The judicially-created doctrine of works made for hire was first codified in the Copyright Act of 1909.⁸ Prior to the 1909 revision of the Copyright Act, courts had applied work-made-for-hire principles in some cases, but by no means uniformly, and

Pursuit of Research with Commercial Value, CHRON. HIGHER EDUC., July 29, 1987, at 11; *The Big Bucks of Biology*, NEWSWEEK, Apr. 5, 1982, at 69.

4. Throughout this Article the term "work made for hire" means work made for hire within the terms of the federal Copyright Act or within the terms of common law copyright. Unless indicated otherwise, the term "work made for hire" does not herein connote work made for hire within the terms of an employment contract.

5. Copyright Act of 1909, ch. 320, §§ 1-64, 35 Stat. 1075 (current version codified at 17 U.S.C. §§ 101-914 (1988)).

6. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-914 (1988)).

7. For a discussion of conflicting interpretations of the 1976 Act, see *infra* notes 51-94 and accompanying text.

8. Copyright Act of 1909, ch. 320, § 62, 35 Stat. 1075, 1087-88 (codified as amended at 17 U.S.C. § 201(b) (1988)); see, e.g., *Murray v. Gelderman*, 566 F.2d 1307, 1309 (5th Cir. 1978) (recognizing that 1909 Act was first federal statute to give employers ownership of works made for hire). The previous major revision of the Copyright Act, the Copyright Act of 1870, provided that the author, inventor, designer or proprietor had the sole liberty of printing, and otherwise using the work, and contained no provision dealing with work made for hire. See Copyright Act of 1870, ch. 230, § 86, 16 Stat. 198, 212 (codified as amended at 17 U.S.C. §§ 106, 201(a) (1988)).

usually with relatively little comment.⁹ The work-made-for-hire provision of the 1909 Act appears, based on the sparse legislative history, to be a codification of prior case law.¹⁰ Representatives of publishers' organizations at the Librarian's Conference on Copyright in 1905¹¹ commented that although courts were holding employers to be the owners of copyright in works produced by their employees, adoption of an express provision to that effect was desirable.¹² Section 26 of the 1909 Act provided merely that "the word 'author' shall include an employer in the case of works made for hire."¹³ As author, the employer was entitled to obtain

9. Some cases showed hostility to the doctrine of works made for hire. See, e.g., *Pierpont v. Fowle*, 19 F. Cas. 652 (C.C.D. Mass. 1846) (No. 11,152); *Binns v. Woodruff*, 3 F. Cas. 421 (C.C.D. Pa. 1821) (No. 1,424). The court in *Pierpont* denied the existence of a judicially-created work-made-for-hire doctrine and criticized an act of Parliament establishing such a rule as aiding "those kinds of patrons, who fatten on the labors of genius." *Pierpont*, 19 F. Cas. at 660. In *Binns*, the court construed the Copyright Act of April 29, 1802, to deny copyright to one whose employees had designed a print, since the employer had not "represented the subject in some visible form" with his own hands. *Binns*, 3 F. Cas. at 423-24; see also *Boucicault v. Fox*, 3 F. Cas. 977, 980 (C.C.S.D.N.Y. 1862) (No. 1,691) ("[T]itle to literary property is in the author whose intellect has given birth to the thoughts," not in the employer for whom the work was written.).

In cases decided prior to the 1909 Act, in which work-made-for-hire principles were applied, courts dealt with the doctrine briefly, and did not usually expressly integrate the doctrine into the statute by stating that the employer fell within a term in the statute, such as "author" or "proprietor." See, e.g., *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 248 (1903) (Court's entire discussion of work-made-for-hire principles: "There was evidence warranting the inference that the designs belonged to the plaintiffs, they having been produced by persons employed and paid by the plaintiffs in their establishment to make those very things."); *Hanson v. Jaccard Jewelry Co.*, 32 F. 202, 203 (C.C.D. Mo. 1887) (finding copyright in pamphlet belonged to railroad company because produced at its "instance and expense"); *Schuberth v. Shaw*, 21 F. Cas. 738, 738 (C.C.E.D. Pa. 1879) (No. 12,482) (assuming that employer owned copyright, rather than employee who composed work); cf. *Edward Thompson Co. v. American Law Book Co.*, 119 F. 217, 219-20 (N.Y.C.C. 1902) (stating employer was within meaning of term "proprietor" in statute).

10. For a comprehensive source of the legislative history of the 1909 Act, see E. FULTON BRYLAWSKI & A.B.E. GOLDMAN, *LEGISLATIVE HISTORY OF THE 1909 COPYRIGHT ACT* (1976).

11. Two sessions of this conference were held, May 31-June 2, 1905, and November 1-4, 1905, at the suggestion of the Chairman of the Senate Committee on Patents for the purpose of discussing a general revision of the Copyright Act. Letter of Herbert Putnam, Librarian of Congress (Apr. 10, 1905), reprinted in BRYLAWSKI & GOLDMAN, *supra* note 10, at C vii.

12. Report of the Proceedings of the Librarian's Conference on Copyright, reprinted in BRYLAWSKI & GOLDMAN, *supra* note 10, at C 100 (statement of Mr. Furniss); D 65 (statement of Mr. Elson); E 153 (statement of Mr. Luckling); E 155 (statement of Mr. Ames).

13. Copyright Act of 1909, ch. 320, § 62, 35 Stat. 1075, 1087-88.

copyright under section 9.¹⁴ The 1909 Act did not define the term “works made for hire.” Further, the act did not address how to vary the ownership result produced by the statute. The Copyright Office prepared two memoranda drafts with clauses that would have made the work-made-for-hire provision expressly subject to an agreement to the contrary.¹⁵ These clauses did not appear in the bills considered by Congress prior to adoption of the 1909 Act or in the 1909 Act itself.

In cases decided under the provision of the 1909 Act, courts were given no guidance by the statute as to when a work was a work made for hire.¹⁶ In cases in which existence of a work made for hire was an issue, some courts defined a work made for hire as a work produced by an employee for his employer in the “scope” or “course” of his employment.¹⁷ In many cases courts decided whether the work was for hire based on the facts of the employment relationship and the circumstances surrounding the crea-

14. Copyright Act of 1909, ch. 320, § 9, 35 Stat. 1075, 1077 (codified as amended at 17 U.S.C. § 201(a) (1988)). “The author or proprietor of any work made the subject of copyright by this title, or his executors, administrators, or assigns, shall have copyright for such work under the conditions . . . specified in this title. . . .” *Id.*

15. Memorandum Draft of a Bill to Amend and Consolidate the Acts Respecting Copyright, *reprinted in* BRYLAWSKI & GOLDMAN, *supra* note 10, at D LIX, E XXX.

16. Since the work-made-for-hire provisions of the 1976 Act apply prospectively, cases are still being decided under the 1909 Act. *See* Roth v. Pritikin, 710 F.2d 934, 937 (2d Cir.) (stating that 1976 Act does not govern agreements entered into before act’s effective date, January 1, 1978), *cert. denied*, 464 U.S. 961 (1983); May v. Morganelli-Heumann & Assocs., 618 F.2d 1363, 1368 n.4 (9th Cir. 1980) (stating work-made-for-hire provisions of 1976 Act do not apply retroactively); National Broadcasting Co. v. Sonneborn, 630 F. Supp. 524, 532-33 (D. Conn. 1985) (finding work-made-for-hire provisions of 1976 Act do not control works created before January 1, 1978). *Contra* Rand McNally & Co. v. Fleet Management Sys., 591 F. Supp. 726, 737 (N.D. Ill. 1983) (finding work-made-for-hire provisions of 1976 Act govern materials created before January 1, 1978 that were published and registered after that date).

17. *See, e.g.,* Scherr v. Universal Match Corp., 417 F.2d 497, 500 (2d Cir. 1969) (stating employee-created work within scope of employment as part of employment duties is property of employer), *cert. denied*, 397 U.S. 936 (1970); Reporters Comm. for Freedom of Press v. Vance, 442 F. Supp. 383, 386 (D.D.C. 1977) (stating that “work created by an employee within the scope of employment is the property of the employer”); Kinelow Publishing Co. v. Photography in Business, Inc., 270 F. Supp. 851, 853 (S.D.N.Y. 1967) (stating that article prepared by employees in regular course of business belongs to employer); Fred Fisher Music Co. v. Leo Feist, Inc., 55 F. Supp. 359, 360 (S.D.N.Y. 1944) (stating that “work made for hire by an employee in the regular course of his employment” belongs to employer). In cases in which the existence of a work made for hire was an issue, relatively few courts defined or referred to a work made for hire as a work created by an employee within the scope or course of his employment.

tion of the work. The facts expressly considered by the courts varied widely from case to case and included: (1) whether the work was produced on the purported employer's time; (2) whether the purported employer paid for materials, equipment, and other labor used in creating the work; (3) whether the work was produced in the purported employer's place of business; (4) whether the purported employee received a salary; (5) whether the purported employer had the right to supervise the manner in which work was performed; (6) whether the purported employer did exercise such right to supervise; (7) whether the contract referred to the purported employee as an "employee"; and (8) whether the purported employer instigated creation of the work.¹⁸

18. Compare *Fred Fisher Music Co.*, 55 F. Supp. at 360 (considering fact that employee agreed to write songs for employer who promised to pay regular weekly salary) with *Olympia Press v. Lancer Books, Inc.*, 267 F. Supp. 920, 924 (S.D.N.Y. 1967) (considering facts that translator worked in cafes and at home, proposed works for translation, submitted unsolicited translations, was paid in lump sum; typing was done at translator's expense, while publisher did not control style and content). See also *Universal Match*, 417 F.2d at 500-01 (considering employer's right and exercise of right to direct and supervise manner in which work was performed; use of employer's funds, time and facilities; payment of compensation; and assignment of work by employer); *Tobani v. Carl Fischer, Inc.*, 98 F.2d 57, 59 (2d Cir. 1938) (considering facts that contract recognized arranger as employee, employee received weekly salary, and employer specified type of composition to be produced); *National Cloak & Suit Co. v. Kaufman*, 189 F. 215, 216-17 (M.D. Pa. 1911) (considering facts that employer caused book to be written, made large outlays in production of work, and supervised artists and authors carefully); *Schmid Bros. v. W. Goebel Porzellanfabrik K.G.*, 589 F. Supp. 497, 503-04 (E.D.N.Y. 1984) (finding work not made for hire because nun had full artistic control, work done not on orders of convent, work done in free time, and convent incurred only minimal expense); *Vance*, 442 F. Supp. at 386-87 (considering facts that work produced to comply with regulations, and government time, employees, equipment and materials used); *Kinelow*, 270 F. Supp. at 853 (considering facts that article produced at expense and under sponsorship of employer); *Von Tilzer v. Jerry Vogel Music Co.*, 53 F. Supp. 191, 193-94 (S.D.N.Y. 1943) (considering fact that work done from nine to five in employer's place of business for fixed salary).

Some courts neither defined works made for hire nor explicitly considered the particular conditions of the relationship between the parties in order to determine whether the work was for hire, appearing to assume a relationship sufficient to create a work made for hire. See, e.g., *Yale Univ. Press v. Row, Peterson & Co.*, 40 F.2d 290, 291 (S.D.N.Y. 1930) (finding book copyrightable by employer of book's compilers). Not surprisingly, some of these cases dealt with the works of independent contractors. See, e.g., *May*, 618 F.2d at 1368-69 (treating independent contractors as employees under work-made-for-hire doctrine); *Herbert Rosenthal Jewelry Corp. v. Grossbardt*, 428 F.2d 551, 554 (2d Cir. 1970) (finding designer of pin, hired as independent contractor, had no claim to copyright).

There developed independent of the work-made-for-hire cases two related lines of cases, the commissioned-photography and commissioned-art-work cases. See *Yardley v. Houghton Mifflin Co.*, 108 F.2d 28 (2d Cir. 1939), *cert.*

Many cases decided after 1960 stated that the rule that the copyright in a work made for hire vested in the employer could be overcome by evidence of an agreement between employer and employee giving the employee ownership of the copyright.¹⁹ The

denied, 309 U.S. 686 (1940); *Avedon v. Exstein*, 141 F. Supp. 278 (S.D.N.Y. 1956). Courts in these cases held that a commissioned photograph or work of art belonged to the commissioning party. *Yardley*, 108 F.2d at 30-31; *Avedon*, 141 F. Supp. at 279. These decisions did not purport to be, nor did they rely on, work-made-for-hire cases. The court in *Yardley*, dealing with a commissioned work of art, stated that there was only one case on point (*Dielman v. White*, 102 F. 892 (C.C.D. Mass. 1900)), and relied, by analogy, on the line of photography cases which held that the copyright vests in the party that commissioned and paid for the photographs. *Yardley*, 108 F.2d at 30-31. The court in *Avedon*, dealing with a commissioned photograph, relied on "a long line of photography cases" and did not mention § 26 of the 1909 Act or work-made-for-hire cases. *Avedon*, 141 F. Supp. at 279; *see also* *Lumiere v. Robertson-Cole Distrib. Corp.*, 280 F. 550 (2d Cir. 1922) (stating that copyright to photographs vests in party that commissioned and paid for photographs).

Note that in cases in which the work-made-for-hire doctrine was applied to commissioned works or to works which were possibly commissioned works, the courts frequently considered only whether the work was produced at the "instance" and "expense" of the commissioning party. *See, e.g.*, *Brattleboro Publishing Co. v. Winmill Publishing Corp.*, 369 F.2d 565, 567 (2d Cir. 1966) (finding work-made-for-hire doctrine applicable whenever work made at "instance and expense" of commissioning party); *National Broadcasting Co.*, 630 F. Supp. at 532 ("In the absence of evidence to the contrary, ownership of the copyright would . . . be presumed to lie with the 'person at whose instance and expense the work [was] done.'" (quoting *Brattleboro Publishing Co.*, 369 F.2d at 567)); *Goldman-Morgen, Inc. v. Dan Brechner & Co.*, 411 F. Supp. 382, 391 (S.D.N.Y. 1976) (finding work-made-for-hire doctrine applicable whenever work produced at instance and expense of commissioning party); *Irving J. Dorfman Co. v. Borlan Indus., Inc.*, 309 F. Supp. 21, 23 (S.D.N.Y. 1969) (stating that when independent contractor produces work at instance and expense of commissioning party, work-made-for-hire doctrine applies); *Electronic Publishing Co. v. Zalytron Tube Corp.*, 151 U.S.P.Q. (BNA) 613, 616-17 (S.D.N.Y. 1966) (stating that, where employer engages independent contractor to produce copyrightable work, copyright vests in party at whose instance and expense work was performed); *Gustave v. Zuppiger*, 540 P.2d 176, 178 (Ariz. Ct. App. 1975) (finding common law copyright vests in party at whose instance and expense work was performed).

19. *See, e.g.*, *May*, 618 F.2d at 1369 (stating that § 26 "must be read as creating a presumption of copyright in the employer which may be rebutted only by a preponderance of evidence of a contrary agreement as between the parties" (quoting 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 5.03[D] (1991))); *Universal Match*, 417 F.2d at 500 (stating that § 26 "creates a rebuttable presumption of copyright in the employer, a presumption which can be overcome by evidence of a contrary agreement between the parties"); *Charon v. Meaux*, 60 F.R.D. 619, 625 (S.D.N.Y. 1973) (stating that § 26 must be read as creating rebuttable presumption that copyright vests in employer); *Royalty Control Corp. v. Sanco, Inc.*, 175 U.S.P.Q. (BNA) 641, 643 (N.D. Cal. 1972) (stating that § 26 creates rebuttable presumption of copyright in employer).

These decisions, which held that § 26 creates a rebuttable presumption, rather than an absolute rule, of ownership in the employer in the case of a work made for hire, occurred at the same time as, and may have been caused by, the proliferation of decisions explicitly applying the work-made-for-hire doctrine to

existence of such an agreement was an issue only if a work made for hire had been found.²⁰ If the work was not a work made for hire, then section 26 did not apply and the creator of the work was entitled to the copyright to the work as its author under section 9.²¹

the work of independent contractors. See, e.g., *Brattleboro Publishing Co.*, 369 F.2d at 568; *Electronic Publishing Co.*, 151 U.S.P.Q. (BNA) at 616-17. Prior to the 1960s, courts did not apply the work-made-for-hire doctrine to the works of independent contractors. See HOUSE COMM. ON THE JUDICIARY, 87TH CONG., 1ST SESS., REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF U.S. COPYRIGHT LAWS 86 (Comm. Print 1961) ("The courts, however, have not generally regarded commissioned works as 'made for hire.'").

Under the commissioned-photograph and the commissioned-art-work cases, if a photograph or painting was commissioned, the commissioning party was entitled to the copyright unless the artist by the terms of the contract reserved the copyright to himself or herself. See, e.g., *Yardley*, 108 F.2d at 30-31 (stating that where city commissioned artist to paint mural for school, there is rebuttable presumption that city owns copyright in mural); *Avedon*, 141 F. Supp. at 279-80 (stating that party who hires photographer owns copyright in photograph unless photographer expressly reserves copyright); *Dielman v. White*, 102 F. 892, 894 (C.C.D. Mass. 1900) (stating that copyright in commissioned work of art belongs to hiring party unless artist reserves copyright to himself). Starting in the 1960s, the commissioned-photograph and the commissioned-art-work lines of cases were subsumed into the work-made-for-hire doctrine. See *Brattleboro Publishing Co.*, 369 F.2d at 568 (copyright for work of independent contractor vests in employer, relying on *Yardley*); *Electronic Publishing Co.*, 151 U.S.P.Q. (BNA) at 616-17 (stating that *Yardley* decision is applicable to works of independent contractor). The treatment of § 26 as a rebuttable presumption arguably resulted from the injection of the commissioned-photograph and the commissioned-art-work lines of cases into the work-made-for-hire line of cases.

A majority of the decisions stating that § 26 created a rebuttable presumption, rather than an absolute rule, of copyright ownership in the paying party involved independent contractors. See, e.g., *Samet & Wells, Inc. v. Shalom Toy Co.*, 429 F. Supp. 895 (E.D.N.Y. 1977); *Irving J. Dorfman Co.*, 309 F. Supp. 21; *Boulez v. Commissioner*, 83 T.C. 584 (1984).

20. *Royalty Control Corp.*, 175 U.S.P.Q. (BNA) at 643. "Thus, where an employment relationship is present, determination of ownership of a copyright requires a resolution of whether or not the employment relationship is such as to invoke the 'works for hire' provision of Section 26 and its attendant presumption of ownership in the employer." *Id.*

Courts stating that § 26 created a presumption decided, first, whether there was an employment or commissioned relationship sufficient to establish a work made for hire and, second, whether there was an agreement between the employer and employee that the employee own the copyright, thus rebutting the presumption. *Murray v. Gelderman*, 566 F.2d 1307, 1310-11 (5th Cir. 1978) (finding that author created work as employee and failed to overcome presumption of employer ownership because no facts suggested parties intended employee to have copyright); *Frontino v. Avon Prods., Inc.*, 197 U.S.P.Q. (BNA) 713, 714 (S.D.N.Y. 1977) (finding relationship between parties was commissioning party and independent contractor; independent contractor's evidence did not rebut presumption of employer ownership); *Boulez*, 83 T.C. at 595-96 (finding conductor was independent contractor to whom work-made-for-hire doctrine applied; contract reserved no rights in recordings to independent contractor).

21. See *Van Cleef & Arpels, Inc. v. Schechter*, 308 F. Supp. 674, 679

The treatment of section 26 as creating a presumption, rather than an absolute rule, of copyright ownership in the employer was frequently not of great importance in cases decided under the 1909 Act.²² Courts sometimes found works made for hire and concluded that the employer was entitled to the copyright without any reference to a "presumption" or without raising the possibility of a contrary agreement.²³ In a number of other cases in which works made for hire were found, the courts addressed the possibility of a contrary agreement in cursory fashion, simply stating that insufficient rebuttal evidence had been presented.²⁴ There are very few reported cases in which a court found a contrary agreement, remanded for further consideration of the existence of a contrary agreement, or denied summary judgment on the grounds that there was an issue of fact as to the existence of a contrary agreement.²⁵

(S.D.N.Y. 1969). Where no work made for hire is found, no presumption of copyright ownership in the employer arises. *Id.* "The plaintiff has failed to prove . . . the relationship of employer and independent contractor existed between [plaintiff] and [designers] so as to entitle the plaintiff to the presumption of copyright ownership." *Id.*

In some cases in which no work made for hire was found, the decision did not state that § 26 creates a presumption, rather than an absolute rule, of copyright ownership in the employer. *E.g.*, *Epoch Producing Corp. v. Killiam Shows, Inc.*, 522 F.2d 737 (2d Cir. 1975), *cert. denied*, 424 U.S. 955 (1976); *Donaldson Publishing Co. v. Bregman, Vocco & Conn, Inc.*, 375 F.2d 639 (2d Cir. 1967); *Schmid Bros.*, 589 F. Supp. 497. This is not surprising since, if no work made for hire is found, the rule that the employer holds the copyright does not apply, and there is no need to ask whether the parties agreed to the contrary.

22. The truth of this statement is not necessary to my thesis that the 1976 Act did not abolish the exception for professors from work made for hire.

23. *Shapiro, Bernstein & Co. v. Bryan*, 123 F.2d 697, 700 (2d Cir. 1941); *Reporters Comm. for Freedom of the Press v. Vance*, 442 F. Supp. 383, 386-87 (D.D.C. 1977); *R. Dakin & Co. v. Charles Offset Co.*, 441 F. Supp. 434, 438 (S.D.N.Y. 1977); *Fred Fisher Music Co. v. Leo Feist, Inc.*, 55 F. Supp. 359, 360 (S.D.N.Y. 1944).

24. *Murray*, 566 F.2d at 1311 (finding that creator alleged no facts suggesting parties intended creator to own copyright); *Scherr v. Universal Match Corp.*, 417 F.2d 497, 500 (2d Cir. 1969) (finding that sculptors' bare allegations of agreement contrary to presumption did not create triable issue of fact), *cert. denied*, 397 U.S. 936 (1970); *Frontino*, 197 U.S.P.Q. (BNA) at 714 (finding creator's evidence not sufficient to rebut presumption in favor of employer); *Bertolino v. Italian Line*, 414 F. Supp. 279, 284 (S.D.N.Y. 1976) (finding no evidence of express or implied reservation of copyright by artist).

25. *Real Estate Data, Inc. v. Sidwell Co.*, 809 F.2d 366, 377 (7th Cir. 1987) (remanding for further findings as to existence of contrary agreement), *aff'd*, 907 F.2d 770 (7th Cir. 1990) (finding creator failed to establish existence of contrary agreement), *cert. denied*, 111 S. Ct. 965 (1991); *May v. Morganelli-Heumann & Assocs.*, 618 F.2d 1363, 1364 (9th Cir. 1980) (reversing summary judgment and remanding to determine whether parties contracted contrary to presumption); *Sargent v. American Greetings Corp.*, 588 F. Supp. 912, 922-24 (N.D. Ohio 1984) (denying motion for summary judgment after finding "ques-

In those 1909 Act work-made-for-hire cases in which section 26 was stated to create a presumption rather than an absolute rule, there was no uniformity in the types of evidence admissible to prove the existence of a contrary agreement in favor of the employee.²⁶ In a number of such cases, the courts did not indicate what types of evidence were admissible.²⁷ A few cases explicitly required an "express contractual provision," apparently conceived of as a writing, in order to prove the existence of an agreement that the employee own the copyright.²⁸ In a few cases, the courts showed uncertainty as to whether an agreement that the employee own the copyright had to be express or could be implied.²⁹ In a very few 1909 Act work-made-for-hire cases, all

tions of material fact . . . concerning the parties' intent with respect to the ownership of the copyright"); *Charron v. Meaux*, 60 F.R.D. 619, 625 (S.D.N.Y. 1973) (denying motion for summary judgment after finding questions of fact as to existence of contrary agreement).

26. In commissioned-photograph and commissioned-art-work cases, courts required evidence of an express agreement that the employee own the copyright. *Lumiere v. Robertson-Cole Distrib. Corp.*, 280 F. 550, 552-53 (2d Cir. 1922); *Dielman v. White*, 102 F. 892, 894 (C.C.D. Mass. 1900); *Avedon v. Exstein*, 141 F. Supp. 278, 280 (S.D.N.Y. 1956). The court in *Avedon* agreed with defendant-employer's contention that "evidence of custom and usage cannot be offered to alter a general rule of law and . . . there is a general rule of law that a photographer, employed to take a picture for a client, retains no rights in the picture after delivery except such as are expressly reserved." *Avedon*, 141 F. Supp. at 279. "If in the transfer [of the photographs] there was any limitation for the benefit of the [photographer], that limitation . . . must have been expressed and clearly imposed." *Id.*

27. *E.g.*, *National Broadcasting Co. v. Sonneborn*, 630 F. Supp. 524, 524 (D. Conn. 1985) (finding existence of work made for hire and that employer held copyright, ignoring fact that some employees' written contracts granted employer license); *Charron*, 60 F.R.D. at 625 (denying summary judgment in part because written contract appeared to rebut presumption of copyright in employer); *Kinelow Publishing Co. v. Photography in Business, Inc.*, 270 F. Supp. 851, 854-55 (S.D.N.Y. 1967) (finding work made for hire and that employer held copyright).

28. *E.g.*, *Goldman-Morgen, Inc. v. Dan Brechner & Co.*, 411 F. Supp. 382, 391 (S.D.N.Y. 1976) (finding no express reservation of copyright and stating that employer has copyright in absence of "expressed contractual reservation to the contrary"); *Electronic Publishing Co. v. Zalytron Tube Corp.*, 151 U.S.P.Q. (BNA) 613, 617 (S.D.N.Y. 1966) (stating that independent contractor made no claim of any agreement expressly reserving copyright to it, and that hiring party holds copyright "in the absence of an express contractual reservation of the copyright"); *Boulez v. Commissioner*, 83 T.C. 584, 595-96 (1984) (stating that written contract did not reserve copyright to independent contractor and that "express contractual provisions between the employee and the employer, reserving to the former the copyrightable interest" were required in order to overcome presumption of copyright in employer).

29. *E.g.*, *Brattleboro Publishing Co. v. Winmill Publishing Corp.*, 369 F.2d 565, 567-68 (2d Cir. 1966) (requiring "express contractual reservation"; permitting "express or implicit" reservation of copyright); *Sargent*, 588 F. Supp. at 920-22 (requiring "express contractual reservation"; finding extrinsic evidence of

decided after the effective date of the 1976 Act, courts stated that extrinsic evidence, including the conduct and course of performance of the contracting parties and the prevailing custom and usage in the industry, could be used to prove an agreement that an independent contractor would own the copyright.³⁰

III. WORKS OF PROFESSORS UNDER 1909 ACT

A professor's scholarly writings, textbooks, computer programs or other copyrightable works could be considered works made for hire under the 1909 Act. Several commentators have so suggested, as has the Seventh Circuit in dicta.³¹ Professors generally receive regular salaries pursuant to employment contracts. They write using university-supplied facilities, libraries, research

parties' intent admissible); *Samet & Wells, Inc. v. Shalom Toy Co.*, 429 F. Supp. 895, 901-02 (requiring "express contractual reservation;" finding extrinsic evidence of parties' intent admissible); *Bertolino v. Italian Line*, 414 F. Supp. 279, 284 (S.D.N.Y. 1976) (finding contrary agreement may be express or implied; requiring "express contractual reservation").

30. *Real Estate Data, Inc. v. Sidwell Co.*, 809 F.2d 366, 374-75 (7th Cir. 1987) (remanding for consideration of existence of agreement that independent contractor own copyright by analysis of parties' conduct and course of performance), *aff'd*, 907 F.2d 770 (7th Cir. 1990), *cert. denied*, 111 S. Ct. 965 (1991); *May v. Morganelli-Heumann & Assocs.*, 618 F.2d 1363, 1369 (9th Cir. 1980) (denying summary judgment and remanding for district court to consider evidence including "prevailing custom and usage"). The court in *May* acknowledged that there was little authority for its holding. *May*, 618 F.2d at 1369 n.5. The court relied on *Lin-Brook Builders Hardware v. Gertler*, 352 F.2d 298, 300 (9th Cir. 1965). *May*, 618 F.2d at 1369. The court in *Lin-Brook* stated that an express contractual reservation was required, but admitted a written assignment of the copyright from the independent contractor to the employer as evidence of such a reservation. *Lin-Brook*, 352 F.2d at 300. The court in *May* also relied on *Yardley*, 108 F.2d at 31, in which the court "suggested that extrinsic evidence is permissible to rebut the presumption." *May*, 618 F.2d at 1369. The *May* court concluded: "We think it proper, then, to consider extrinsic evidence to determine whether the parties intended to contract contrary to the presumption of the 'works for hire' doctrine. Such evidence includes prevailing custom and usage." *Id.*

31. *Hays v. Sony Corp. of Am.*, 847 F.2d 412, 416 (7th Cir. 1988) (dealing with work created by high school teachers, and applying Copyright Act of 1976). "Although college and university teachers do academic writing as a part of their employment responsibilities and use their employer's paper, copier, secretarial staff, and (often) computer facilities in that writing, the universal assumption" until the 1976 Act was that the teacher was entitled to the copyright. *Id.*; see also DuBoff, *supra* note 1, at 30-32, 34; Patricia A. Hollander, *An Introduction to Legal and Ethical Issues Relating to Computers in Higher Education*, 11 J.C. & U.L. 215, 230 (1984); Simon, *supra* note 1, at 502-05. But see Dreyfuss, *supra* note 1, at 597. "Although universities paid faculty salaries, required (and supported) research, exercised some rudiments of control over the sorts of scholarship that counted toward advancement, and made library and other facilities available for scholarly pursuits, these activities did not usually prove that the university was the motivating force behind the work." Dreyfuss, *supra* note 1, at 597.

assistants, secretaries, computers and supplies. Publication in the professor's field is usually expected by the university and is therefore a part of the professor's employment responsibilities; the works produced might therefore be found to have been created at the employer's insistence. Although the university neither controls when and where a professor writes nor directly controls style and content, the power to make decisions regarding tenure, dismissal and salary may amount to indirect control over the content of a professor's writings, since the university's evaluation of the writings is an important part of such decisions.³²

In spite of the plausibility of finding that the works of professors are works made for hire under the 1909 Act, no court did so find. Two cases, *Williams v. Weisser*³³ and *Sherrill v. Grieves*,³⁴ considered the work-made-for-hire concept with respect to professors but did not find works made for hire, in large part due to policy and custom.³⁵ Since neither court found a work made for hire, the question whether there was an agreement that the employee own the copyright was not reached.³⁶ These two cases comprise the scant case authority prior to the 1976 Act for the existence of an exception from the work-made-for-hire doctrine for professors.³⁷

Sherrill applied section 7 of the 1909 Act, which provided that

32. Cf. *Hays*, 847 F.2d at 416 ("university does not supervise its faculty in the preparation of academic books and articles"). For a more thorough discussion of whether the works of professors fall within the definition of works made for hire, see Simon, *supra* note 1, at 502-05.

33. 78 Cal. Rptr. 542 (Ct. App. 1969).

34. 57 Wash. L. Rep. 286 (D.C. 1929).

35. I use the term "concept" advisedly since neither case involved the application of § 26 of the 1909 Act.

36. *Williams*, 78 Cal. Rptr. at 546; *Sherrill*, 57 Wash. L. Rep. at 290-91.

37. These two cases were cited by Professor Nimmer to support the proposition that a professor's works are beyond the work-made-for-hire provisions of federal copyright law. 1 NIMMER & NIMMER, *supra* note 19, § 5.03[B][1][b][i] & n.94; see also William H. Carnahan, *Copyright in Our Realm of Learning*, 7 C. COUNS. 421, 436 (1972) ("[T]he right of academicians, whether employed by the Government or a private institution, to copyright and retain a proprietary [sic] interest in their works, including lecture notes and manuscripts, has been well defined by the courts."). But see *Manasa v. University of Miami*, 320 So. 2d 467, 468 (Fla. Dist. Ct. App. 1975) (finding grant proposal written by director of university program was work made for hire, distinguishing *Williams*), *cert. denied*, 336 So. 2d 602 (Fla. 1976). Case authority for the existence of the exception for professors may have been sparse because universities and professors were convinced of its existence. *Hays v. Sony Corp. of Am.*, 847 F.2d 412, 416 (7th Cir. 1988) (noting that reason for lack of authority was that "virtually no one questioned that the academic author was entitled to copyright"). Another explanation for the paucity of litigation in this area is that universities have not been interested in acquiring the types of copyrightable works produced by professors.

a publication of the United States government, a concept analogous to a work made for hire, was not subject to copyright protection.³⁸ Sherrill, while employed by the army to teach military map-related skills at a post-graduate school for officers, prepared a book on the same subjects, and permitted the army to print one part of the book in pamphlet form.³⁹ The Supreme Court of the District of Columbia rejected the infringing defendants' contention that the portion so printed was a publication of the United States government, based in part on the court's conclusion that producing the work did not constitute part of Sherrill's employment duties, and therefore did not meet the definition of a government publication.⁴⁰ The court's decision, however, rested also, perhaps primarily, on the absence of judicial precedent holding that a professor's works belong to the university and on the custom of military schools not to claim ownership of instructors' writings.⁴¹ To the extent that the court refused to apply work-made-for-hire principles to the professor's work, relying on the lack of judicial precedent and military school custom, rather than on finding that the definition of a work made for hire was not

38. It is an unstated premise of the court's reasoning in *Sherrill* that, in order to qualify as a publication of the United States government within the terms of § 7 of the 1909 Act, a work must be produced by a government employee in fulfillment of his employment duties. See *Sherrill*, 57 Wash. L. Rep. at 290; see also Copyright Act of 1909, ch. 320, § 7, 35 Stat. 1075, 1077.

The current version of § 7 of the 1909 Act appears in § 105 of the 1976 Act, 17 U.S.C. § 105 (1988). "Copyright protection under this title is not available for any work of the United States Government . . ." 17 U.S.C. § 105. The legislative history of § 105 indicated that "[a]lthough the wording of the definition of 'work of the United States Government' differs somewhat from that of the definition of 'work made for hire,' the concepts are intended to be construed in the same way." H.R. REP. NO. 1476, 94th Cong., 2d Sess. 58 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5672. "A 'work of the United States Government' is a work prepared by an officer or employee of the United States Government as part of that person's official duties." 17 U.S.C. § 101 (1988).

39. *Sherrill*, 57 Wash. L. Rep. at 286, 289-90.

40. *Id.* at 290.

41. *Id.* at 290-91. With respect to judicial precedent, the court stated: "The plaintiff at the time was employed to give instruction just as a professor in an institution of learning is employed. The court does not know of any authority holding that such a professor is obliged to reduce his lectures to writing or if he does so that they become the property of the institution employing him." *Id.* *Sherrill* dealt with a textbook on the subject matter taught by the professor, not with notes for or a transcription of his lectures. *Id.* at 290.

With respect to custom, the court stated: "The fact is that officers do write such books which are copyrighted and used in Government schools with the approval of the military establishment . . ." *Id.* But see William S. Rome, *Scholarly Writings in the University Setting: Changes in the Works and on the Books*, 35 COPYRIGHT L. SYMP. (ASCAP) 41, 50-51 (1988) (interpreting *Sherrill* as holding that faculty owns works created outside scope of employment).

met, *Sherrill* supports the proposition that a professor's works are excepted from the work-made-for-hire doctrine.

Williams more explicitly excepted the works of professors from the work-made-for-hire doctrine. Williams, a professor of anthropology at the University of California at Los Angeles (UCLA), argued that the common law copyright in his lectures, both the unpublished notes and the oral delivery, had been infringed by Weisser's publication of notes of the professor's lectures taken by Weisser's employee.⁴² Weisser argued that the university, rather than Williams, held the copyright to the lectures on the ground that the lectures were works made for hire.⁴³ The court noted that the university could not control Williams' manner of expressing his ideas,⁴⁴ and that Williams had no duty to record notes for his lectures.⁴⁵ Although these findings would support a holding that Williams' lectures did not meet the definition of a work made for hire, this was not explicitly held. Instead, the court broadly rejected the application of the work-made-for-hire doctrine to the lectures of professors.⁴⁶ The court gave three bases for its decision. First, the court cited the undesirable consequences of finding that universities own the copyright to profes-

42. *Williams v. Weisser*, 78 Cal. Rptr. 542, 553-54 (Ct. App. 1969). The plaintiff had alleged infringement of a state common law copyright in his lectures, rather than federal statutory copyright infringement, because under the 1909 Act oral lectures were not protected and unpublished notes were not protected without registration. See Copyright Act of 1909, ch. 320, §§ 9, 11, 35 Stat. 1075, 1077-78 (codified by An Act of July 30, 1947, ch. 391, §§ 10, 12, 61 Stat. 652, 656) (copyright obtained by publication with copyright notice or by registration). Prior to the 1976 Act, "common law copyright," i.e., state common law or statutory copyright, protected unfixed and/or unpublished works. 1 NIMMER & NIMMER, *supra* note 19, § 2.02 n.3. *Williams* was decided under common law copyright established by state statute. See *Williams*, 78 Cal. Rptr. 542; 1953 Cal. Stat., ch. 1557, § 2 (current version at CAL. CIV. CODE § 980(a)(1) (West 1982 & Supp. 1989)).

43. *Williams*, 78 Cal. Rptr. at 546.

44. *Id.*

45. *Id.* at 549. The court, relying on *Sherrill*, stated that neither *Sherrill* nor *Williams* was under a duty to make notes. *Id.*

46. *Id.* at 546-47. The court stated:

The many cases cited by defendant for the general rule [regarding work made for hire] probably reach desirable results that are in accord with common understanding in their respective areas, but a rule of law developed in one context should not be blindly applied in another where it violates the intention of the parties and creates undesirable consequences. University lectures are *sui generis*. Absent compulsion by statute or precedent, they should not be blindly thrown into the same legal hopper with valve designs . . . [and] motion picture background music . . .

Id. (citations omitted).

sors' lectures.⁴⁷ Second, the court relied on the precedent of *Sherrill* and other cases dealing with rights to lectures.⁴⁸ Third, the court noted the university's lack of interest in holding the copyright to such lectures.⁴⁹ The court did not say that professors' works satisfy the definition of works made for hire and that in all instances there are agreements that the professor own the copyright; the court said that, in this context, the work-made-for-hire doctrine should not be applied at all.

Relying on the foregoing two cases, commentators asserted that prior to the adoption of the 1976 Act the work-made-for-hire provision of federal copyright law did not apply to the works of professors.⁵⁰

IV. IMPACT OF ADOPTION OF 1976 ACT

The Copyright Act of 1976,⁵¹ a general revision of federal copyright law, treats work made for hire in two sections, a definition of work made for hire in section 101,⁵² and section 201(b),⁵³ which is analogous to section 26 of the 1909 Act. Contrary to a

47. *Id.* at 546. "Indeed the undesirable consequences which would follow from a holding that a university owns the copyright to the lectures of its professors are such as to compel a holding that it does not." *Id.* Professors move from campus to campus developing their ideas as they go; which university would own the lectures? Could a professor be enjoined from using the material at his next post? See *id.*

48. See *id.* at 547-49. These lecture cases dealt with the question whether there was any legal theory under which a lecturer could prevent the audience from publishing his lectures, and whether lecturing was a divesting publication. *Id.* In *Abernethy v. Hutchinson*, 47 Eng. Rep. 1313 (Ch. 1825), the court held that a lecturer has a property right in his lectures. The court in *Abernethy* also stated that there was no evidence that the lecturing surgeon did not have the right to publish his lectures in spite of the "peculiar situation which he filled in the hospital." 47 Eng. Rep. at 1318; see also *Caird v. Sime*, 12 App. Cas. 326, 360 (H.L. 1887) (holding that lecturing is not divesting publication); *Nicols v. Pitman*, 26 Ch. D. 374, 381 (1884) (finding implied contract that audience will not publish lecture). With the exception of the ambiguous sentence in *Abernethy* concerning the surgeon's "peculiar situation" quoted above, these lecture cases had only peripheral relevance to the work-made-for-hire doctrine. This relevance is that the defendants did not raise the issue by arguing that the institutions employing the lecturers owned the copyright.

49. *Williams*, 78 Cal. Rptr. at 545 n.5. The court noted that UCLA made no claim to Williams' lectures and had filed an amicus curiae brief in his favor. *Id.* The court stated that no reason had been suggested why a university would want to own a professor's lectures. *Id.* at 546.

50. For a discussion of the views of selected commentators, see *supra* note 37.

51. 17 U.S.C. §§ 101-914 (1988).

52. *Id.* § 101.

53. *Id.* § 201(b).

commonly held belief,⁵⁴ the language of the work-made-for-hire provisions of the 1976 Act does not preclude the continued existence of an exception for professors. The 1976 Act incorporates a definition of an employee's work made for hire which codifies language developed in cases decided under the 1909 Act: "a work prepared by an employee within the scope of his or her employment."⁵⁵ The legislative history of the work-made-for-hire provisions of the 1976 Act shows continuity with the prior law by stating that "[s]ection 201(b) of the bill adopts one of the basic principles of the present law: that in the case of works made for hire the employer is considered the author of the work. . . ."⁵⁶

54. See Dreyfuss, *supra* note 1, at 598-99 ("[s]cholars have indeed concluded that the 1976 Act abolishes the teacher exception to the work for hire doctrine"); DuBoff, *supra* note 1, at 25, 33; Simon, *supra* note 1, at 507; see also Hays v. Sony Corp. of Am., 847 F.2d 412, 416 (7th Cir. 1988) ("[I]t is widely believed that the 1976 Act abolished the teacher exception."); Weinstein v. University of Illinois, 811 F.2d 1091, 1094 (7th Cir. 1987) (1976 Act "is general enough to make every academic article a 'work made for hire' and therefore vest exclusive control in universities rather than scholars").

55. See 17 U.S.C. § 101. For a discussion of work prepared within the scope or course of employment, see *supra* note 17 and accompanying text. The Register of Copyright has rejected a suggestion to use this more specific language in lieu of the term work made for hire in the new statute and suggested instead that it be adopted as a definition of work made for hire. HOUSE COMM. ON THE JUDICIARY, 87TH CONG., 1ST SESS., REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF U.S. COPYRIGHT LAW 87 (Comm. Print 1961).

The 1976 Act did change the definition of works made for hire produced by an independent contractor. See 17 U.S.C. § 101. Prior to the 1976 Act, courts found works made for hire based simply on the fact that the works were commissioned. For a further discussion of commissioned works, see *supra* note 18 and accompanying text. The 1976 Act defines a work made for hire as either:

- (1) a work prepared by an employee within the scope of his or her employment; or
- (2) a work specially ordered or commissioned [which falls within one of nine enumerated categories of works] if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.

Id. § 101. The 1976 Act is more protective of independent contractors than was the 1909 Act, as the latter act was applied; under the 1976 Act, a commissioned work by an independent contractor can be a work made for hire only if it meets the requirements of § 101(2). See *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 737-38 (1989). Professors may well produce works within the categories enumerated in § 101(2), such as translations, supplementary works, instructional texts and contributions to a collective work. However, a professor's work would be a commissioned work only where he had been specifically hired to produce a work aside from his regular employment duties. Thus, the protection given by the 1976 Act to independent contractors is of limited importance in determining the rights of professors to their works under the act.

56. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 121 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5736-37; S. REP. NO. 473, 94th Cong., 1st Sess. 104 (1976). The reports stated that Congress rejected a suggestion for a major change in the nature of an employer's rights to works produced by its employees. It had been proposed that the employer receive only a right to the works analogous to the "shop right" doctrine of patent law. H.R. REP. NO. 1746, *supra*, at 121, *reprinted*

The legislative history makes no mention of the exception for professors. In determining whether the producer of a work was an employee within the meaning of the work-made-for-hire definition in the 1976 Act, the Supreme Court has used the same sort of agency law factors that had been used by many courts under the 1909 Act.⁵⁷ Thus, with respect to employees, the definition of a work made for hire was not changed by the 1976 Act. There is nothing in the 1976 Act or its legislative history to suggest that the common law exception for professors from the common law definition of work made for hire was eradicated by the act.

The 1976 Act, however, did clarify and limit the types of evidence admissible, after a work made for hire has been found, to prove an agreement that the employee owns the copyright. Section 201(b) provides: "In the case of a work made for hire, the employer . . . is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright."⁵⁸ The question of what types of evidence can prove an agreement that the employee own the copyright only comes into play if a work made for hire has been found. There-

in 1976 U.S.C.C.A.N. at 5736-37; S. REP. NO. 473, *supra*, at 104-05. The Conference Report did not mention the work-made-for-hire provisions. H.R. REP. NO. 1733, 94th Cong., 2d Sess. 69 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5810.

57. *Community for Creative Non-Violence*, 490 U.S. at 740. For a further discussion of the agency law factors in cases decided under the 1909 Act, see *supra* note 18 and accompanying text. Factors employed by the Court which had been used in the 1909 Act work-made-for-hire cases were: the right of the purported employer to control the manner of performance, use of the purported employer's tools and materials, work performed in the purported employer's place of business, purported employer's control of work hours, and method of payment. *Community for Creative Non-Violence*, 490 U.S. at 740-41. The Court in *Community for Creative Non-Violence* understandably did not stress the 1976 Act's continuity with the 1909 Act's definition of work made for hire in the case of agency law employees since the Court was focusing on the new § 101 definition's change of prior law with respect to independent contractors. See *id.* The Court overruled a line of cases which held that the work of an independent contractor was work made for hire under § 101(1) of the 1976 Act if the hiring party had the right to control the final product or had exercised control over the creation of the work. *Id.* at 742.

Lower courts have found that, with respect to employees, the definition of work made for hire remains unchanged by the 1976 Act. See, e.g., *Mister B Textiles, Inc. v. Woodcrest Fabrics, Inc.*, 523 F. Supp. 21, 25 (S.D.N.Y. 1981) (stating that "[t]he work for hire doctrine survives intact with respect to employer and employees").

58. 17 U.S.C. § 201(b) (1988).

fore, the precedential value of *Sherrill*⁵⁹ and *Williams*⁶⁰ was not modified by this revision. In neither case did the court get past the initial determination whether there was a work made for hire; both courts refused to find a professor's work made for hire.⁶¹ A common law exception to the definition of work made for hire is undisturbed by section 201(b).

The extent to which the requirement of a written instrument in section 201(b) of the 1976 Act constitutes a major change from section 26 of the 1909 Act may be exaggerated. Under section 26 courts often did not clarify what types of evidence of an agreement were admissible, there was no uniformity among the courts that did address this issue, and there were few reported cases in which a creator successfully defended a claim to a copyright on the basis of such an agreement, either express or implied.⁶² A few courts, applying section 26, required an "express contractual provision," thus apparently requiring a writing.⁶³

It should be noted that under neither the 1909 Act nor the 1976 Act can an agreement between employer and employee determine whether a work is a work made for hire within the terms of the statute.⁶⁴ An agreement to assign his copyright is enforceable against an employee, but the rights of an employer who holds a copyright as assignee differ from those of an employer who is a section 201(b) author of a work made for hire.⁶⁵

59. For a discussion of *Sherrill*, see *supra* notes 34 & 38-41 and accompanying text.

60. For a discussion of *Williams*, see *supra* notes 33 & 42-49 and accompanying text.

61. For a further discussion of the holdings in *Sherrill* and *Williams*, see *supra* notes 33-50 and accompanying text.

62. For a further discussion of what evidence was admissible under the 1909 Act, see *supra* notes 26-30 and accompanying text.

63. For a further discussion of courts requiring an "express contractual provision" under the 1909 Act, see *supra* note 28 and accompanying text.

64. 1 NIMMER & NIMMER, *supra* note 19, § 5.03[B][1][b][iii], [D]. Under the 1976 Act, an agreement that an employee's work is made for hire will not convert a work which does not fall within the definition of work made for hire into a work made for hire. *Id.* Similarly, if a work is a work made for hire, the parties' agreement that the work not be work made for hire does not change the status of the work. *Id.*; see also Reichman, *supra* note 1, at 675 n.186. The employer and employee could, of course, structure their relationship so that the employee's work would fall within the definition of work made for hire.

65. 1 NIMMER & NIMMER, *supra* note 19, § 5.03[B][1][b][i]. Under the 1976 Act, the author of any work other than a work made for hire can terminate a transfer of copyright executed on or after January 1, 1978, during the five years following the expiration of a period of 35 years after the execution of the transfer, with the result that all rights transferred revert to the author. 17 U.S.C. § 203 (1988); see also *id.* § 304(c) (similar provision for termination of transfers of renewal copyrights made before January 1, 1978). Thus, if an employer holds

Two influential articles published in 1983 and 1985 concluded that the 1976 Act abolished the exception for professors from the work-made-for-hire doctrine.⁶⁶ The arguments proposed by these commentators to support this proposition were: 1) the 1976 Act's purported strengthening of the presumption that employers own the copyright of the works of their employees;⁶⁷ 2) the preemption of common law copyright by section 301;⁶⁸ and 3) the rejection by the 1976 Act of evidence of custom.⁶⁹ These arguments are logically flawed and therefore fail to support the conclusion drawn from them.

the copyright as assignee, the employee author can terminate the grant. If the employer holds the copyright as author of a work made for hire, the employee cannot affect the employer's copyright. If an agreement could determine whether a work is a work made for hire within the terms of the statute, assignees could avoid the termination of transfer provision of § 203. 3 NIMMER & NIMMER, *supra* note 19, § 11.02[A][2].

The person entitled to the renewal in a work which was in its first copyright term on January 1, 1978 varies according to whether the work is a work made for hire. If it is a work made for hire, the proprietor may renew; otherwise, the author may renew. 17 U.S.C. § 304(a).

The term of copyright in works created after January 1, 1978 differs depending on whether the work is a work made for hire. *Id.* § 302(a), (c).

66. DuBoff, *supra* note 1, at 24-25; Simon, *supra* note 1, at 507. The United States Court of Appeals for the Seventh Circuit and commentators have cited these two articles for the proposition that the 1976 Act abolished the professors' exception or for the proposition that it is commonly believed that the act abolished the exception. See *Hays v. Sony Corp. of Am.*, 847 F.2d 412, 416-17 (7th Cir. 1988) (citing Simon article for proposition that "it is widely believed that the 1976 Act abolished the teacher exception"); *Weinstein v. University of Illinois*, 811 F.2d 1091, 1094 (7th Cir. 1987) (citing DuBoff article for proposition that § 201(b) of 1976 Act "is general enough to make every academic article a 'work for hire'"); see also Dreyfuss, *supra* note 1 at 598-99 ("Scholars have indeed concluded that the 1976 Act abolishes the teacher exception . . ."); Rome, *supra* note 41, at 53-54 ("If *Williams* was ever authority for excluding scholarly writing from the work for hire rule, this conclusion is no longer viable."). Professor Dreyfuss cites these articles with the proviso: "I summarize commentators' findings regarding the operation of the work for hire doctrine, conclusions that I accept for argument's sake but do not personally endorse." Dreyfuss, *supra* note 1, at 593.

67. Simon, *supra* note 1, at 486. The purported strengthening of the presumption is argued to flow from the § 201(b) requirement of a writing in order for an employee to own the copyright in a work made for hire. *Id.* Professor Simon notes that the typical faculty employment agreement is comprised of many implicit agreements and understandings that do not satisfy § 201(b). *Id.* Professor Simon's argument, however, ignores the fact that § 201(b) only applies if a work made for hire has been found.

68. *Id.* at 486, 507. Section 301(a) of the 1976 Act partially preempts common law copyright. 17 U.S.C. § 301(a) (1988). Professor Simon argues that, since *Williams* was decided under common law copyright, the case is no longer valid precedent. Simon, *supra* note 1, at 507.

69. DuBoff, *supra* note 1, at 33. Professor DuBoff's argument appears to be that since the 1976 Act no longer permits evidence of custom to prove the existence of an agreement giving the employee ownership of the copyright, evidence

The "strengthening of the presumption" argument posits that the writing requirement of section 201(b) of the 1976 Act strengthens the presumption that the employer owns the copyright in a work made for hire.⁷⁰ The only way to rebut the presumption is by a written agreement that the employee own the copyright.⁷¹ However, the fact that the presumption, once established, may now be more difficult to rebut does not make it any easier to establish the presumption.

Section 301 provides that all rights equivalent to those granted by the Copyright Act in works fixed in tangible form are governed exclusively by that act.⁷² This section partially preempts common law copyright, that is, state copyright, which prior to the 1976 Act had protected unfixed works and unpublished works.⁷³ The argument based on section 301 is that the 1976 Act abolished the professors' exception because, since *Williams* was decided under common law copyright, section 301 "washes away the *Williams* rule."⁷⁴ This does not appear to be the case. First, *Sherrill*, which offers some support for the proposition that there is an exception for professors from the work-made-for-

of custom is no longer admissible to prove that a work is not a work made for hire. *Id.*

It has been suggested that the gist of the articles by Professors Simon and DuBoff is that the 1976 Act discourages courts from deciding whether a work is a work made for hire by considering the presence of certain facts and circumstances in the employment relationship and in the creation of the work. Dreyfuss, *supra* note 1, at 598-99. For a further discussion of these facts and circumstances, see *supra* note 18 and accompanying text. This was not the thrust of the Simon and DuBoff articles. Furthermore, it does not appear to be an accurate assessment of the impact of the 1976 Act. See Dreyfuss, *supra* note 1, at 599 n.37; see also *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 740-41 (1988) (courts should use principles of agency law to determine whether there is work made for hire). Professor Reichman cited the Simon and DuBoff articles for the proposition that some commentators believe that the 1976 Act abolished the professors' exception, but Professor Reichman did not address the changes between the 1976 Act and prior law which have been said to bring about this result. See Reichman, *supra* note 1, at 673-74.

70. Simon, *supra* note 1, at 486, 501, 505-06.

71. Note that the presumption is established by finding that a work is a work made for hire.

72. 17 U.S.C. § 301(a) (1988). "A work is 'fixed' in a tangible medium of expression when its embodiment in a copy . . . is sufficiently permanent or stable to permit it to be . . . reproduced, or otherwise communicated for a period of more than transitory duration." *Id.* § 101.

73. 1 NIMMER & NIMMER, *supra* note 19, § 2.02. Common law copyright was either state common law copyright or state statutory copyright. *Id.*

74. Simon, *supra* note 1, at 507. Simon states that "*Williams* is no longer precedent for exempting scholarly writings from the 1976 Act's works-for-hire provisions." *Id.*

hire doctrine, was decided under section 7 of the 1909 Act.⁷⁵ Judicial glosses on sections of the 1909 Act reenacted in the 1976 Act survived adoption of the 1976 Act unless precluded by that act.⁷⁶ Thus, to the extent that *Sherrill* supported the existence of a professors' exception from the work-made-for-hire provision of the 1909 Act, *Sherrill* now supports the existence of an exception to the 1976 Act. Second, section 301 expressly does not preempt state protection of unfixed works.⁷⁷ Since *Williams* dealt with both the professor's written notes and the oral expression of his lectures, the *Williams* decision could be made today under common law copyright with respect to the latter.⁷⁸ Finally, even to the extent that *Williams* dealt with a written work, which state law could no longer protect, this fact does not undercut the court's reasoning concerning the work-made-for-hire doctrine as applied to professors.

The argument that the 1976 Act's rejection of evidence of custom abolished the professors' exception appears to be as fol-

75. For a further discussion of the *Sherrill* decision, see *supra* notes 38-41 and accompanying text.

76. *Stewart v. Abend*, 110 S. Ct. 1750, 1758 (1990) ("[W]e must look to the language of and case law interpreting § 24 [of the 1909 Act in order to interpret § 304 of the 1976 Act which reenacts § 24]."); see also 3 NIMMER & NIMMER, *supra* note 19, § 10.03[A] ("It may be assumed that other judicial glosses upon the 1909 Act writing requirement will also be carried over to the current Act.").

Professor DuBoff appears to argue that the *Sherrill* and *Williams* exception for professors was a "common law doctrine" and therefore was preempted by § 301. DuBoff, *supra* note 1, at 33 n.107. The exception for professors was a judicial interpretation of or gloss on the terms "work made for hire" and "publication of the United States Government." The 1976 Act did not preempt all judicial interpretation of or glosses on the 1909 Act. See, e.g., *id.* at 26-32 (citing judicial interpretations of or glosses on the term work made for hire in cases decided under the 1909 Act in order to interpret "work made for hire," "employee" and "scope of employment" under the 1976 Act).

77. 17 U.S.C. § 301(b)(1) (1988); 1 NIMMER & NIMMER, *supra* note 19, § 2.02. "[S]ection 301(b) explicitly preserves common law copyright protection for one important class of works: works that have not been 'fixed in any tangible medium of expression.'" H.R. REP. NO. 1476, 94th Cong., 2d Sess. 131 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5747. "Unfixed" works, for example, are "extemporaneous speech, 'original works of authorship' communicated through conversations or live broadcasts . . ." *Id.*

78. See *Williams v. Weisser*, 78 Cal. Rptr. 542, 543 (Ct. App. 1969). Admittedly, the court appears to have viewed the written notes as more important than the oral expression. *Id.* Professor Simon recognized this fact but discounted the applicability of *Williams* as authority for cases dealing with any professorial works other than oral lectures. Simon, *supra* note 1, at 507. Prior to the 1976 Act, *Williams*, although involving only lectures, was considered authority for the proposition that all copyrightable works by professors were exempt. 1 NIMMER & NIMMER, *supra* note 19, § 5.03[B][1][b][i]; Carnahan, *supra* note 37, at 436. *Williams* is not distinguishable from cases concerning other types of works since the court's decision did not rest on characteristics unique to lectures.

lows: 1) custom was admissible under the 1909 Act; 2) *Williams* used custom to determine whether a work is a work made for hire; and 3) under the 1976 Act, only a written agreement can "alter the work-for-hire rules set forth in section 201."⁷⁹ In reality, however, very few cases under the 1909 Act admitted evidence of custom in order to prove the existence of an agreement that the employee own the copyright.⁸⁰ More significantly, the existence of such an agreement is relevant only after a work made for hire has been found.⁸¹ The court in *Williams* relied on custom, policy and the lack of judicial precedent holding that the work-made-for-hire doctrine applies to professors, to hold that the work-made-for-hire doctrine should not be applied to professors at all.⁸² If no work made for hire is found, section 201 does not apply. Therefore, if courts rely on the precedent of *Sherrill* and *Williams*, which the 1976 Act does not prevent them from doing, the writing requirement of section 201 of the 1976 Act will not affect the ability of a professor to claim copyright in his works.⁸³

Commentators and the Seventh Circuit have cited these two articles for the proposition that the 1976 Act abolished the professors' exception from the work-made-for-hire doctrine.⁸⁴ Although the Seventh Circuit does not approve of the consequences of abolishing the professors' exception, the court appears to have accepted the commentators' arguments leading to this conclusion.⁸⁵ In the Seventh Circuit's 1987 decision in *Weinstein v. University of Illinois*,⁸⁶ the court indicated in dictum that it

79. DuBoff, *supra* note 1, at 33-34.

80. For a further discussion of the admission of extrinsic evidence under the 1909 Act, see *supra* notes 26-30 and accompanying text.

81. For a further discussion of the creation of the presumption of copyright ownership in the employer, see *supra* notes 19-21 and accompanying text.

82. For a further discussion of the *Williams* holding, see *supra* notes 42-49 and accompanying text.

83. For a further discussion of the writing requirement of § 201, see *supra* notes 58-63 and accompanying text.

84. *Hays v. Sony Corp. of Am.*, 847 F.2d 412, 416 (7th Cir. 1988) ("[I]t is widely believed that the 1976 Act abolished the teacher exception." (citing Simon, *supra* note 1, at 502-09)); *Weinstein v. University of Illinois*, 811 F.2d 1091, 1094 (7th Cir. 1987) ("[The 1976 Act] is general enough to make every academic article a 'work for hire' and therefore vest exclusive control in universities rather than scholars." (citing DuBoff, *supra* note 1, at 24-26)); Dreyfuss, *supra* note 1, at 593, 598-99 (citing Simon and DuBoff for proposition that scholars have concluded that 1976 Act abolished professors' exception, which conclusion author accepts for argument's sake but does not endorse).

85. *Hays*, 847 F.2d at 416-17; *Weinstein*, 811 F.2d at 1094. The Seventh Circuit noted the "havoc that such a conclusion would wreak" on the long settled traditions of universities and colleges. *Hays*, 847 F.2d at 416.

86. 811 F.2d 1091 (7th Cir. 1987). A professor of pharmacy administration

believed the 1976 Act had abolished the professors' exception,⁸⁷ but did not make clear whether it found the work in question, a professor's scholarly article, to be a work made for hire.⁸⁸ The court also failed to clarify the relationship between the work-made-for-hire provisions of the 1976 Act and the university copyright policy incorporated in the professor's contract.⁸⁹ In a 1988 decision, *Hays v. Sony Corporation of America*,⁹⁰ the Seventh Circuit accepted in dictum the commentators' arguments that the 1976 Act had abolished the professors' exception. The court stated: "To a literalist of statutory interpretation, the conclusion that the

at the University of Illinois at Chicago, who co-authored an article concerning a clinical clerkship funded by the university, sued his co-authors, the university and others for, *inter alia*, violation of the due process clause by revising the article and listing his name last. *Id.* at 1092-93.

87. *Id.* at 1094. The court argued that "[t]he statute [§ 201(b) of the 1976 Act] is general enough to make every academic article a 'work for hire' and therefore vest exclusive control in universities rather than scholars." *Id.* (citing DuBoff, *supra* note 1, at 24-26). The statement of one commentator that "*Weinstein sub silentio* rejected the notion of a 'teacher exception' " is too strong. Russell VerSteeg, *Copyright and the Educational Process: The Right of Teacher Inception*, 75 Iowa L. Rev. 381, 402 (1990). The court's statement citing DuBoff merely indicated that it believed the exception had been abolished by the 1976 Act.

88. *Weinstein*, 811 F.2d at 1093-94. The court did not apply the definition of a work made for hire to the article. *Id.*

89. *Id.* Under § 201(b), if the article was a work made for hire, a written agreement would be necessary in order for Weinstein to own the copyright. 17 U.S.C. § 201(b) (1988). Weinstein's annual written contract, which expressly incorporated the university copyright policy, would qualify as such an agreement. See *Weinstein v. University of Illinois*, 628 F. Supp. 862, 863 (N.D. Ill. 1986), *aff'd*, 811 F.2d 1091 (7th Cir. 1987). However, the Seventh Circuit's decision did not clarify whether this was the court's line of reasoning. If the article was not a work made for hire, the policy (as a term of Weinstein's contract) could operate as an assignment or a promise to assign the copyright to the university. For a further discussion of the effect of the incorporation of a university copyright policy in an employment contract, see *infra* notes 105-16 and accompanying text.

The Seventh Circuit in *Weinstein* argued that the university copyright policy allocated the copyright in the article to the professor rather than to the university. *Weinstein*, 811 F.2d at 1094-95. The court concluded that even if the professor owned the copyright, he was not deprived of this property since his co-authors, as joint authors, were entitled to revise and publish the article. *Id.* at 1095.

90. 847 F.2d 412 (7th Cir. 1988). Two of the three judges who decided *Hays*—Judges Posner and Easterbrook—had decided *Weinstein*. *Hays* was an appeal of Rule 11 sanctions against an attorney representing high school teachers who claimed copyright infringement with respect to a computer manual they had prepared for their students. *Id.* at 413. The court found that even if the exception from the work-made-for-hire doctrine did not exist, there would still have been a reasonable basis for the teachers' claim since it was unclear whether the manual would fall within the definition of a work made for hire. *Id.* at 417.

Act abolished the exception may seem inescapable.”⁹¹ The court’s brief summary of the argument fails to come to grips with the salient points of the commentators’ argument that the 1976 Act had this effect, but rather assumes the point to be proven, that the exception no longer exists.⁹² Searching for a “possible textual handle” with which to save the exception, the court suggested an implausible construction of section 201(b).⁹³ Swayed by both the desirability of maintaining a professors’ exception and the absence of any indication that Congress intended to abolish the exception, the *Hays* court stated that, if forced to decide whether the 1976 Act had abolished the exception, it might decide that the exception had survived.⁹⁴ However, the court expressly did not decide the issue.

91. *Id.* at 416 (citing Dreyfuss, *supra* note 1, at 598-600; Simon, *supra* note 1, at 502-09).

92. *Id.* at 416. The court explained that “[t]he argument would be that academic writing, being within the scope of academic employment, is work made for hire, per se; so, in the absence of an express written and signed waiver of the academic employer’s rights, the copyright in such writing must belong to the employer.” *Id.* Academic work was just as much within the scope of employment under the 1909 Act, and courts refused to apply the doctrine at all. For a further discussion of the treatment of professors’ works under the 1909 Act, see *supra* notes 31-50 and accompanying text. For the arguments made by commentators that the 1976 Act abolished the exception, see *supra* notes 66-83 and accompanying text.

93. *Hays*, 847 F.2d at 417. The court suggested that § 201(b) “appear[s] to require not only that the work be a work for hire but that it have been prepared for the employer—which the [teachers’] manual may or may not have been.” *Id.* Section 201(b) provides:

In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.

17 U.S.C. § 201(b) (1988). Work which qualifies as a work made for hire under either of the definitions in § 101, whether a commissioned work or “a work prepared by an employee within the scope of his or her employment,” will always have been prepared “for” someone. See *id.* § 101. Further, the phrase “for whom the work was prepared” in § 201(b) modifies “other person,” not “employer.” See *id.* § 201(b). The phrase “other person for whom the work was prepared” is a periphrasis for “commissioning party”; such a term is necessary since the term “employer” is not appropriate to all work-made-for-hire situations. Compare the bifurcated definition of work made for hire in § 101. See *id.* § 101.

94. *Hays*, 847 F.2d at 416-17. Professor Reichman has predicted that the courts will preserve the academic’s ownership of copyrights. Reichman, *supra* note 1, at 675 n.187 (citing *Hays*, 847 F.2d 412; *Weinstein v. University of Illinois*, 811 F.2d 1091 (7th Cir. 1987)). Professor Reichman stated: “The courts will probably . . . preserve the academic’s ownership of his or her general literary and artistic output, even though the current provisions on works for hire give rise to diverse and conflicting interpretations.” *Id.*

Based on the foregoing analysis, the 1976 Act did not disturb the professors' exception from the work-made-for-hire doctrine; to the extent that such an exception ever existed, it continues to exist. However, the developing interest of universities in faculty copyrights, expressed in the adoption of university copyright policies,⁹⁵ may have an impact on faculty ownership of copyrights in several ways.⁹⁶ Most importantly, copyright policies may vary copyright ownership as a matter of contract between the professor and the university.

V. EFFECT OF UNIVERSITY COPYRIGHT POLICIES

Initial ownership of the copyright in a professor's work is determined by the provisions of the Copyright Act, rather than by the terms of any contract, including an employment contract.⁹⁷ If the professor's work is *not* a work made for hire, the copyright vests in the professor as author, and can be transferred only by a writing complying with section 204(a).⁹⁸ Section 204(a) requires for all transfers other than those by operation of law "an instru-

95. For a discussion of the adoption of university copyright policies, see *infra* notes 120-23 and accompanying text.

96. University acquisition of faculty copyrights could persuade courts that the exception for professors from work made for hire is no longer in keeping with university custom.

97. See 17 U.S.C. § 201(a), (b). "Copyright in a work protected under this title vests initially in the author or authors of the work." *Id.* § 201(a). "In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and . . . owns all of the rights comprised in the copyright." *Id.* § 201(b). See Reichman, *supra* note 1, at 675 n.186.

The 1909 Act and common law copyright governed initial vesting of copyright in works created prior to January 1, 1978. See generally 1 NIMMER & NIMMER, *supra* note 19, § 5.01[B].

The statement in the text is not intended to deny that an employment contract could, by the way in which it structures the employment relationship, contribute to the conclusion that a work is or is not a work made for hire under the act.

98. See 17 U.S.C. § 201(a) ("[c]opyright . . . vests initially in the author"). A "transfer of copyright ownership" is an assignment, exclusive license or any other conveyance other than a nonexclusive license. *Id.* § 101. Section 204(a) states the circumstances under which "a transfer of copyright ownership" is valid. See *id.* § 204(a).

Section 204(a) governs the validity of transfers made on or after January 1, 1978. *Id.* Transfers of statutory copyright made prior to January 1, 1978 were governed by § 28 of the 1909 Act, which required "an instrument in writing signed by the proprietor of the copyright." Copyright Act of 1909, ch. 320, § 42, 35 Stat. 1075, 1084 (codified by An Act of July 30, 1947, ch. 391, § 28, 61 Stat. 652, 660).

The work-made-for-hire provisions of the Copyright Act do not limit which works can be transferred by a writing complying with § 204(a). 17 U.S.C. § 204(a). *Contra* Reichman, *supra* note 1, at 679.

ment of conveyance, or a note or memorandum of the transfer" in writing and signed by the transferor.⁹⁹ Written university copyright policies in which universities claim copyright ownership of certain faculty works may qualify as instruments of conveyance.¹⁰⁰ It appears that the fact that a professor's future works are not in existence at the time that the professor signs his contract is not an impediment to the interpretation of these policies as instruments of transfer.¹⁰¹ The copyright policies may also be treated as agreements by professors to transfer copyrights at a future date, which agreements must be in writing under section 204(a).¹⁰² Alternatively, if the professor's work is a work made for hire, the university owns the copyright under section 201(b) "un-

99. 17 U.S.C. § 204(a). The term "note or memorandum of the transfer" appears to include a writing memorializing a prior oral transfer. *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 36 (2d Cir. 1982); *Dan-Dee Imports, Inc. v. Well-Made Toy Mfg. Corp.*, 524 F. Supp. 615, 618 (E.D.N.Y. 1981).

100. Current university copyright policies claiming copyright ownership of certain faculty works employ language such as the following. "[T]he University shall be deemed to own all rights, title and interest in materials . . ." UNIVERSITY OF VIRGINIA, FINANCIAL AND ADMINISTRATIVE POLICIES MANUAL 15.5.1.2 (1989) (Copyright Policy, approved by Visitors, May 29, 1986). "The University will claim Copyright ownership in those cases where . . ." UNIVERSITY OF NEW MEXICO, INTELLECTUAL PROPERTY POLICY 6 (approved by Regents, Mar. 13, 1989). "University faculty . . . retain all rights in copyrightable materials they create, except when . . ." UNIVERSITY OF WASHINGTON, 4 HANDBOOK 49 (1984) (Copyright Policy, dated Mar. 1969; revised Oct. 3, 1977 and Sept. 26, 1983).

If the professor's work is not a work made for hire, and the copyright policy provides that the work belongs to the professor, the policy would not vary the result produced by the Copyright Act.

101. See *Rosette v. Rainbo Record Mfg. Corp.*, 354 F. Supp. 1183, 1193-94 (S.D.N.Y. 1973) (decided under 1909 Act, transferee effectively assigned statutory copyright in 1951 prior to assignment to itself in 1955), *aff'd*, 546 F.2d 461 (2d Cir. 1976); 3 NIMMER & NIMMER, *supra* note 19, § 10.03[A] (though work not in existence at time of transfer, transfer effective to give equitable title in work upon its creation). Cases decided under the 1909 Act in which the transferor granted in writing the copyright in works not yet in existence, and the transferee thereafter obtained statutory copyright by publication or registration, are not persuasive authority for the statement in the text since it appears that the common law copyright in unpublished works could be transferred without a writing. See, e.g., *Fantasy, Inc. v. Fogerty*, 664 F. Supp. 1345, 1347, 1349 (N.D. Cal. 1987); see also 3 NIMMER & NIMMER, *supra* note 19, § 10.03[B][2], at 10-38 n.28 (although no cases expressly so hold, it appears assignment of common law copyright was not within Statute of Frauds).

102. *Mellencamp v. Riva Music, Ltd.*, 698 F. Supp. 1154, 1162 (S.D.N.Y. 1988) (stating that contract to transfer copyright cannot be enforced without a writing); *Library Publications, Inc. v. Medical Economics Co.*, 548 F. Supp. 1231, 1232-34 (E.D. Pa. 1982) (finding oral agreement to give plaintiff right to distribute work unenforceable because "[s]ection 204(a) of the Act requires such agreements to be in writing"), *aff'd*, 714 F.2d 123 (3d Cir. 1983). Some courts may not draw a clear distinction between a transfer of copyright and an agreement to transfer copyright. See, e.g., *Library Publications*, 548 F. Supp. at 1231-34.

less the parties have expressly agreed otherwise in a written instrument signed by them.”¹⁰³ Written university copyright policies which state that the copyright in certain faculty works shall belong to the professor-creator may qualify as such express written agreements.¹⁰⁴

However, the written university copyright policy is generally not included verbatim in a writing signed by the professor and by a representative of the university.¹⁰⁵ The question, then, is whether a written university copyright policy, which may or may not be expressly incorporated by reference into a writing signed by the professor and the university, satisfies the section 204(a) requirement of a writing signed by the professor, or the section 201(b) requirement of a writing signed by the professor and the university.

If the copyright policy is expressly incorporated by reference into a written employment contract signed by the professor and the university, the policy appears to satisfy both the section 204(a) and the section 201(b) writing requirements. The Seventh

103. See 17 U.S.C. § 201(b) (1988). By the terms of § 201(b), if a work is a work made for hire, an agreement by the parties cannot change the employer's status as author. Further, an agreement by the parties cannot change the status of the work as a work made for hire. For a further discussion of the impact of an agreement on the status of a work, see *supra* notes 64-65 and accompanying text.

104. *Contra* Dreyfuss, *supra* note 1, at 600. Professor Dreyfuss states that “while many faculty handbooks announce policies favoring faculty retention of copyright, handbooks are unlikely to be considered signed writings within the meaning of the Act [i.e., within the meaning of § 201(b)].” *Id.* (without citation or explanation). Although *Weinstein* did not clarify the court's line of reasoning, the Seventh Circuit's analysis may have been that the article at issue was a work made for hire, but that the university's copyright policy satisfied the requirement of a written instrument in § 201(b). For a further discussion of the *Weinstein* decision and the requirement of a writing under § 201(b), see *supra* notes 86-89 and accompanying text.

Current university copyright policies which provide that the copyright in certain faculty works shall be owned by the faculty use language such as the following. “Inventors/Authors will own inventions/materials which are” MASSACHUSETTS INSTITUTE OF TECHNOLOGY, GUIDE TO THE OWNERSHIP, DISTRIBUTION AND COMMERCIAL DEVELOPMENT OF M.I.T. TECHNOLOGY 3 (Patent and Copyright Policy Statement, dated May 24, 1989). “Except for writings that . . . all rights to copyrightable material shall be reserved by the author” VANDERBILT UNIVERSITY FACULTY MANUAL 60 (1989-90) (Copyrights, no date). “Except . . . , textbooks and other products of teaching, research, scholarship, and artistic endeavors belong to the faculty or staff member” UNIVERSITY OF IOWA, UNIVERSITY OPERATIONS MANUAL 30.16 (Policy on Intellectual Property, approved by Regents, Mar. 1983).

105. See generally Beverly T. Watkins, *Even Seemingly Innocuous Faculty Manuals Are Frequently Ruled to Be Legally Binding*, CHRON. HIGHER EDUC., Oct. 2, 1985, at 27-28 (“faculty manual has been adopted in higher education as ‘a substitute for an employee contract’”).

Circuit indicated in *Weinstein v. University of Illinois*¹⁰⁶ that the written university copyright policy, which was expressly incorporated into the professor's written contract,¹⁰⁷ was effective to vary copyright ownership.¹⁰⁸ In the context of other university policies, such as tenure, retirement, and dismissal policies, courts have found the policies, where expressly incorporated by reference into a written employment contract, binding on both faculty and universities.¹⁰⁹ Such cases are, however, less persuasive in the context of copyright policies because such aspects of annual employment contracts are not subject to state statutes of frauds.¹¹⁰

If, on the other hand, the copyright policy is not expressly incorporated by reference into a written employment contract, the policy appears to satisfy neither the section 204(a) nor the section 201(b) writing requirements. The purpose of the section 204(a) requirement of a writing is to provide evidence of grants in order to protect copyright owners from false claims of transfer.¹¹¹ In other words, the section's purpose is to insure that a grant by

106. 811 F.2d 1091 (7th Cir. 1987).

107. *Id.* at 1094; *Weinstein v. University of Illinois*, 628 F. Supp. 862, 863 (N.D. Ill. 1986), *aff'd*, 811 F.2d 1091 (7th Cir. 1987).

108. *Weinstein*, 811 F.2d at 1094. The court did not clarify the interaction of the policy and the Copyright Act. *Id.* The court may have thought that the university policy could redefine work made for hire within the meaning of the Copyright Act. *Id.* (noting that university adopted "a policy defining 'work for hire' for purposes of its employees"). The district court in *Weinstein* decided the question of copyright ownership by construing the university copyright policy without reference to the work-made-for-hire and transfer provisions of the Copyright Act. *Weinstein*, 628 F. Supp. at 865.

109. *See, e.g., Sacchini v. Dickinson State College*, 338 N.W.2d 81, 82-85 (N.D. 1983) (tenure policy incorporated by reference in professor's contract enforced against professor); *Brady v. Board of Trustees*, 242 N.W.2d 616, 618-19 (Neb. 1976) (enforcing dismissal policy incorporated in professor's contract against university).

110. With respect to the cases cited in note 109, for example, see N.D. CENT. CODE § 9-06-04 (1987); NEB. REV. STAT. § 36-202 (1988).

Gordy Co. v. Mary Jane Girls, Inc., 1989-1990 Copyright L. Dec. (CCH) ¶ 26,515 (S.D.N.Y. 1989), which was decided outside the university context, offers some support for the proposition that a writing providing for transfer of copyright ownership, which is expressly incorporated in a written contract signed by the copyright owner, does not satisfy the § 204(a) writing requirement. The *Gordy Co.* court did not say that the writing expressly incorporated into the signed contract did not satisfy § 204(a), but relied on estoppel to find that the transferee owned the copyright. *Id.* ¶ 23,092-93.

111. *See Effects Assoc., Inc. v. Cohen*, 908 F.2d 555, 557 (9th Cir. 1990) (stating that § 204(a) prevents inadvertent transfers), *cert. denied*, 111 S. Ct. 1003 (1991); *Eden Toys v. Florelee Undergarment Co.*, 697 F.2d 27, 36 (2d Cir. 1982) (explaining purpose of § 204(a) is to protect copyright holders from mistaken or fraudulent claims of oral licenses); *Mellencamp v. Riva Music Ltd.*, 698 F. Supp. 1154, 1162 (S.D.N.Y. 1988); *Library Publications v. Medical Economics Co.*, 548 F. Supp. 1231, 1234 (E.D. Pa. 1982) (explaining purpose of § 204(a) is

the copyright owner has in fact been made. A copyright policy which is not expressly incorporated by reference into a writing signed by the professor fails to provide any evidence that a grant has been made. The writing requirement of section 201(b) serves a similar purpose¹¹² but, unlike section 204(a), it requires an express agreement signed by both the employer and the employee.¹¹³ The legislative history of section 201(b) does not explain why the employee's signature is required in order for the employee to own the copyright in a work made for hire.¹¹⁴ The requirement in section 201(b) of an agreement entered into by both parties appears to be the result of those 1909 Act cases which stated that, in the case of a work made for hire, the rule that the employer was entitled to the copyright could be overcome by evidence of an agreement between employer and employee that the employee own the copyright.¹¹⁵ Given that section 201(b) requires an express agreement evidenced by a writing signed by both parties, the signature of a representative of the university affixed to the copyright policy at its adoption would not seem to bind even the university because it is not signed by both parties. With respect to such university policies as tenure and retirement, courts are in less agreement that the policies are terms of the employment contract when the policies are not expressly incorporated by reference into a written contract than when they are so incorporated.¹¹⁶

"to insure the integrity of copyright interests, once granted"), *aff'd*, 714 F.2d 123 (3d Cir. 1983).

112. *Baltimore Orioles v. Major League Baseball Players Ass'n*, 805 F.2d 663, 672 (7th Cir. 1986), *cert. denied*, 480 U.S. 941 (1987).

113. 17 U.S.C. § 201(b) (1988). In the case of a work made for hire, the employer owns the copyright "unless the parties have expressly agreed otherwise in a written instrument signed by them." *Id.*

114. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 121 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5736. "The subsection also requires that any agreement under which the employee is to own rights be in writing and signed by the parties." *Id.*

115. For a further discussion of the presumption of employer ownership of copyrights, see *supra* notes 19-21 and accompanying text.

116. Compare *Hillis v. Meister*, 483 P.2d 1314, 1315, 1317 (N.M. Ct. App. 1971) (finding reappointment policy not expressly incorporated into written contract was term of employment contract) and *Rehor v. Case Western Reserve Univ.*, 331 N.E.2d 416, 419-20 (Ohio) (finding retirement policy not set forth in full and not expressly incorporated by reference was term of employment contract binding professor), *cert. denied*, 423 U.S. 1018 (1975) with *Drans v. Providence College*, 383 A.2d 1033, 1037-38 (R.I. 1978) (finding professor did not agree to retirement policy not expressly incorporated by reference into renewal employment contract). The *Drans* court stated that "a person is not bound by the terms of a written agreement if he had no knowledge of its terms because the manner in which they are embodied in the instrument would not lead a reason-

VI. ANALYSIS OF UNIVERSITY COPYRIGHT POLICIES

Universities have long claimed ownership of the patentable inventions of faculty members, but traditionally have not claimed their copyrightable works.¹¹⁷ Universities began adopting written policies claiming professors' patentable inventions early in this century.¹¹⁸ Most colleges and universities currently have written policies concerning the ownership of the patentable inventions of faculty.¹¹⁹ In the early 1970s, significant numbers of universities began to adopt written policies governing the ownership of copyrights in works created by faculty members.¹²⁰ However, it still

able person to suspect that the terms are part of the contract." *Drans*, 383 A.2d at 1037-38.

117. See, e.g., THOMAS E. BLACKWELL, *COLLEGE LAW: A GUIDE FOR ADMINISTRATORS* 187 (1961); Hollander, *supra* note 31, at 222. Of 83 written policies compiled by the National Academy of Sciences in a 1955 survey, only five mentioned copyrights, and these claimed either no works or extremely limited categories of works. See ARCHIE M. PALMER, *SUPPLEMENT TO UNIVERSITY PATENT POLICIES AND PRACTICES* 45-93 (1955); ARCHIE M. PALMER, *UNIVERSITY PATENT POLICIES AND PRACTICES* 27-229 (1952); see also Charles Weiner, *Universities, Professors and Patents: A Continuing Controversy*, 89 *TECH. REV.* 32 (1986) (history of university ownership of patents). In 1934, 18 universities were developing patents; by 1947, 200 universities were doing so. *Id.* at 39.

118. The first written patent policy was adopted by Lehigh University in 1924. Lehigh required faculty members to assign certain patents to the university. ARCHIE M. PALMER, *SUPPLEMENT TO UNIVERSITY PATENT POLICIES AND PRACTICES* 18 (1955); ARCHIE M. PALMER, *SURVEY OF UNIVERSITY PATENT POLICIES, PRELIMINARY REPORT* 146 (1948). Of 800 universities studied by the National Academy of Sciences in 1955, only 83 had written patent policies adopted by the board of trustees, state legislature, or other governing body. Of those, approximately 70 universities claimed ownership of certain faculty patents. ARCHIE M. PALMER, *SUPPLEMENT TO UNIVERSITY PATENT POLICIES AND PRACTICES* 9, 18, 45-93 (1955); ARCHIE M. PALMER, *UNIVERSITY PATENT POLICIES AND PRACTICES* 27-229 (1952). A 1977 survey of 48 "major research" universities found that 47 had adopted written patent policies, of which 38 claimed ownership of certain faculty patents. NATIONAL ASS'N OF COLLEGE AND UNIV. BUSINESS OFFICERS, *SURVEY OF INSTITUTIONAL PATENT POLICIES AND PATENT ADMINISTRATION* 2 (1978).

119. See Phyllis S. Lachs, *University Patent Policy*, 10 *J.C. & U.L.* 263, 263 n.1 (1983-1984) (stating trend since early 1960s is development of institutional policy and assertion of rights); NATIONAL ASS'N OF COLLEGE AND UNIV. BUSINESS OFFICERS, *SURVEY OF INSTITUTIONAL PATENT POLICIES AND PATENT ADMINISTRATION* 1 (1978) (stating survey results showing 47 of 48 universities had adopted written patent ownership policy were representative of "general community of research universities"); see also Victoria McNamara, *UH Files Lawsuit in Health Value Dispute*, *Hous. Bus. J.*, May 14, 1990, § 1, at 1 (reporting University of Houston suit to enforce patent policy against professor); Julie A. Traxler, *Lovers, Lawyers, Upstart Firms—Just About Everybody Loves Retin-A*, *BUS. FOR CENT. N.J.*, Aug. 20, 1990, § 1, at 3 (reporting University of Pennsylvania suit to enforce patent policy against professor).

120. For example, Cornell University, Massachusetts Institute of Technology and the University of California adopted their first written copyright ownership policies in 1971, 1974 (effective date) and 1975 respectively. NATIONAL

appears to be the case today that most colleges and universities have no such written policy.¹²¹

In order to more accurately assess the impact of written university policies on questions of copyright ownership between faculty and universities, I collected the written copyright ownership policies, if any, of seventy leading research universities classified as "Research Universities I" by the Carnegie Foundation for the Advancement of Teaching.¹²² Of these seventy universities, eleven currently have adopted no written policy governing ownership of copyright in faculty works and an additional five have such policies in draft form only.¹²³ Given that major research

ASS'N OF COLLEGE AND UNIV. BUSINESS OFFICERS, PATENT AND COPYRIGHT POLICIES AT SELECTED UNIVERSITIES (1978).

121. NATIONAL ASS'N OF COLLEGE AND UNIV. BUSINESS OFFICERS, COPYRIGHTS AT COLLEGES AND UNIVERSITIES 5 (1980) ("Many institutions have well-defined patent policies and procedures, but few have adequate formal policies governing copyrights."); Ivars Peterson, *Bits of Ownership*, 128 SCI. NEWS 188, 188 (1985) (noting that most universities do not have comprehensive copyright policy).

122. The 70 universities classified as "Research Universities I" were selected by the Carnegie Foundation for the Advancement of Teaching based on their range of baccalaureate programs, commitment to graduate education and research, and level of federal support. *Leading Research Universities*, CHRON. HIGHER EDUC., Sept. 6, 1989 (Almanac), at 24. The 70 universities are listed in Appendix A of this Article. I solicited the policies of the above universities by letters directed to university counsel at the respective schools from February of 1990 through February of 1991. I received responses from all 70 universities. All discussion in this Article relates to policies current at the respective universities at some time between February of 1990 and February of 1991 inclusive.

For additional discussion of the policies of New York University, Pennsylvania State University, California Institute of Technology, Stanford University and Massachusetts Institute of Technology, see Rome, *supra* note 41, at 61-67.

123. Of the 11 universities that have not adopted a written copyright ownership policy as of the date of this study, four indicated that adoption of such a policy is not contemplated. See Letter from Ralph McCaughan, Office of the University Counsel, Duke University (Feb. 8, 1990); Letter from Albert J. Velasquez, Office of the University Counsel, Indiana University at Bloomington (May 29, 1990); Letter from Caroline Kerl, Legal Advisor, Oregon State University (Feb. 15, 1990); Telephone conversation with Toby Stone, Yeshiva University (Feb. 8, 1991). All correspondence cited throughout this Article was directed to the author.

Of the remaining 54 universities that have adopted written copyright ownership policies, one, Columbia University, states in its faculty handbook, to which the written copyright policy is made expressly subject, that the policy is not complete. The policy with respect to "designs, both architectural and theoretical, computer programs, and technical writings" is in the process of being developed. COLUMBIA UNIVERSITY FACULTY HANDBOOK 113 (1987); COLUMBIA UNIVERSITY, STATEMENT OF POLICY ON PROPRIETARY RIGHTS IN THE INTELLECTUAL PRODUCTS OF FACULTY ACTIVITY 14 (adopted by Trustees, June 5, 1989) [hereinafter COLUMBIA UNIVERSITY, STATEMENT OF POLICY]. The University of Michigan has a "Regents' Bylaw" which addresses the ownership of patents and copyrights; a more detailed policy is not planned. Letter from John D. Ketelhut, Deputy General Counsel, University of Michigan (Feb. 20, 1990).

universities may be expected to adopt copyright ownership policies before smaller universities and colleges, these figures would indicate that a smaller proportion of the latter have adopted such policies to date.

Why have universities begun to adopt copyright ownership policies and why have they done so now? Those current copyright ownership policies collected for this study for which the adoption date (or effective date) is available were adopted between 1967 and 1990 inclusive.¹²⁴ At least one court has suggested that universities have adopted copyright ownership policies in response to the passage of the 1976 Act.¹²⁵ The adoption of many such policies prior to 1976, however, tends to refute this assumption. Further, none of the policies collected in this study fails to claim at least some faculty works,¹²⁶ which suggests that the purpose of adoption was not to maintain the pre-1976 Act status quo, but rather to claim ownership of certain works for the university. Of the policies studied, eight offer express expla-

Of the five draft policies, that of Northwestern University does not purport to be binding with respect to works claimed by the university, but merely to constitute the university's plan for future negotiations with faculty. NORTHWESTERN UNIVERSITY, COPYRIGHT POLICY DRAFT I (approved by Intellectual Property Committee, Mar. 28, 1989).

124. The adoption (or effective) dates of these current policies are as follows: University of Miami, 1967; New York University, 1972; Michigan State University, 1973; Case Western Reserve University, 1974; University of California (six schools), 1975; Harvard University, 1976 (first copyright policy adopted in 1975); University of Wisconsin at Madison, 1977; University of Maryland at College Park, 1979; University of Georgia, 1982; Pennsylvania State University, 1982; University of Iowa, 1983; University of North Carolina at Chapel Hill, 1983; North Carolina State University, 1983; Rockefeller University, 1984; University of Tennessee at Knoxville, 1984; Carnegie Mellon University, 1985; University of Cincinnati, 1986; University of Illinois at Chicago, 1986; New Mexico State University, 1986; University of Virginia, 1986; University of Kentucky, 1988 (1988 is effective date; first copyright policy adopted in 1974); University of Chicago, 1989; Columbia University, 1989; University of New Mexico, 1989; University of Pittsburgh, 1990 (effective date); University of Rochester, 1990 (effective date); Yale University, 1990. Note that some of these policies may have been revised since the adoption or effective date.

125. *Weinstein v. University of Illinois*, 811 F.2d 1091, 1094 (7th Cir. 1987) ("The University of Illinois, like many other academic institutions, responded to the 1978 [sic] revision of the copyright laws by adopting a policy defining 'work for hire' for purposes of its employees, including its professors.").

126. A possible exception is the University of Connecticut, whose patent policy is contained in state statutes and provides in relevant part, "The provisions of [the patent policy] shall not entitle the university . . . to claim any literary, artistic, musical or other product of authorship [protected by copyright]." CONN. GEN. STAT. §§ 10a-110g (1988). This provision does not constitute a copyright policy; if given works are works made for hire under the Copyright Act and therefore belong to the university, this statement would not vary that ownership result.

nations for the timing of the adoption of the policy.¹²⁷ The advent of new technology and an increased interest in commercialization of faculty works are the primary reasons presented.¹²⁸ Only one policy cites the adoption of the 1976 Act as a motivating force; this policy goes on to state that the policy was also motivated by ownership issues raised by the increased use of university resources in creating technologically complex works.¹²⁹ Of the policies collected, nineteen distinguish computer programs from other copyrightable works,¹³⁰ permitting an

127. COLUMBIA UNIVERSITY, STATEMENT OF POLICY, *supra* note 123, at 2; GEORGIA INSTITUTE OF TECHNOLOGY, FACULTY HANDBOOK 6:16 (no date) (Copyright Policy, dated Jan. 1981); HARVARD UNIVERSITY, STATEMENT OF POLICY IN REGARD TO INVENTIONS, PATENTS AND COPYRIGHTS 1 (adopted by President and Fellows, Nov. 3, 1976, amended Mar. 17, 1986); UNIVERSITY OF KENTUCKY, INTELLECTUAL PROPERTIES POLICY AND PROCEDURES 1 (effective Jan. 12, 1988); UNIVERSITY OF MARYLAND, COPYRIGHT POLICY 2 (approved by Regents, June 15, 1979); MICHIGAN STATE UNIVERSITY, FACULTY HANDBOOK 149 (1985) (Development of Instructional Materials, approved by Trustees, Nov. 16, 1973; revised July 28, 1983); UNIVERSITY OF TENNESSEE, STATEMENT OF POLICY ON PATENTS, COPYRIGHTS, AND LICENSING (Foreward) (adopted by Trustees, Oct. 19, 1984); UNIVERSITY OF UTAH, COPYRIGHT POLICY: OWNERSHIP 2 (dated July 26, 1983).

128. *E.g.*, HARVARD UNIVERSITY, *supra* note 127, at 1 (growing use of technology raises new problems relating to ownership); UNIVERSITY OF KENTUCKY, *supra* note 127, at 1 (recent developments have broadened scope of commercially valuable information and technology, which should be treated as university assets); MICHIGAN STATE UNIVERSITY, *supra* note 127, at 149 ("new technology" requires expensive resources provided by university, thus raising issue of ownership). Letters from two university counsel stated that policies were under consideration or adopted in response to the issue of ownership of computer programs. Letters from William H. Griesar, General Counsel, The Rockefeller University (Feb. 13, 1990). The other university counsel requested anonymity for his university. For a further discussion of works claimed by genre (computer programs and works requiring advanced technology), see *infra* notes 148-51 and accompanying text.

129. UNIVERSITY OF MARYLAND, *supra* note 127, at 1-3 ("Works in other than simple written form as well as simple written works are more often a specific job task and more often involve release time, special funding, computer use, special equipment and the like.").

130. CALIFORNIA INSTITUTE OF TECHNOLOGY, FACULTY HANDBOOK ch. 7, at 6 (no date) (Royalties and Copyrights, revised May 1984); CARNEGIE-MELLON UNIVERSITY, INTELLECTUAL PROPERTY POLICY 6 (dated July 30, 1985; effective Aug. 27, 1985); CASE WESTERN RESERVE UNIVERSITY, FACULTY HANDBOOK 28-34 (1988) (University Policies on Research and Scholarship, approved by Trustees, Aug. 5, 1974); COLORADO STATE UNIVERSITY, FACULTY MANUAL J-6 (1989-1990) (Scholarly and Creative Activities of the Faculty, no date); COLUMBIA UNIVERSITY, STATEMENT OF POLICY, *supra* note 123, at 3; UNIVERSITY OF ILLINOIS AT URBANA-CHAMPAIGN, GENERAL RULES CONCERNING UNIVERSITY ORGANIZATION AND PROCEDURE 30-31 (Copyrights, no date); UNIVERSITY OF ILLINOIS AT CHICAGO, POLICY ON PATENTS AND COPYRIGHTS 11-12 (approved by Trustees, May 8, 1986); UNIVERSITY OF IOWA, UNIVERSITY OPERATIONS MANUAL, *supra* note 104, at 30.16; LOUISIANA STATE UNIVERSITY, COPYRIGHT POLICIES AND PROCEDURES 9 (no date); MASSACHUSETTS INSTITUTE OF TECHNOLOGY, *supra* note 104, at 12; UNIVERSITY OF MICHIGAN, BYLAWS OF THE BOARD OF REGENTS (Ownership of Patents, Copy-

inference that their treatment was a matter of concern to the universities.

The impact of copyright policies on issues of copyright ownership has been discussed above.¹³¹ The existence of a writing

rights, Computer Software, and Other Property Rights, dated Dec. 1985); UNIVERSITY OF NORTH CAROLINA AT CHAPEL HILL, PATENT AND COPYRIGHT PROCEDURES (adopted by Trustees, Aug. 19, 1983); OHIO STATE UNIVERSITY, POLICY ON PATENTS AND COPYRIGHTS 1 (revised May 1989); UNIVERSITY OF PITTSBURGH, POLICY: 11-02-02, at 2 (Copyrights, effective June 29, 1990); UNIVERSITY OF ROCHESTER, POLICY ON INTELLECTUAL PROPERTY AND TECHNOLOGY TRANSFER 1 (effective June 1, 1990); ROCKEFELLER UNIVERSITY, COPYRIGHT POLICY 1 (approved by Trustees, Jan. 18, 1984); UNIVERSITY OF TEXAS, RULES AND REGULATIONS, ch. V, § 2.4 (Basic Intellectual Property Policy, amended through Dec. 7, 1989); TEXAS A & M UNIVERSITY, ADMINISTRATIVE POLICY AND REPORTING MANUAL ch. 104, at 2 (no date) (Copyrights, dated Apr. 22, 1985). I have not cited by name the policy of one university, which requested anonymity.

Policies that include computer programs in a laundry list of types of works are not included in the above tally. In addition, policies for computer programs separate from the copyright policy are not included in the above tally. Of the universities considered in this study, at least the following five have a separate policy dealing with the ownership of computer programs: UNIVERSITY OF MIAMI, UNIVERSITY SOFTWARE, PATENT AND COPYRIGHT POLICY (amended Feb. 6, 1989); NEW YORK UNIVERSITY, FACULTY HANDBOOK 124-C (1989) (Statement of Policy on Computer Software Copyrights, approved by Trustees, Jan. 24, 1972); NORTH CAROLINA STATE UNIVERSITY, GUIDELINES AND PROCEDURES FOR DETERMINING OWNERSHIP OF COMPUTER SOFTWARE (approved by Trustees, Apr. 11, 1987); UNIVERSITY OF PENNSYLVANIA, ALMANAC 38 (Apr. 15, 1986) (Policy on Computer Software, approved Mar. 19, 1986); UNIVERSITY OF WISCONSIN-MADISON, GENERAL ADMINISTRATIVE POLICY PAPER 10 (Computer Software Ownership, revised Oct. 21, 1985).

Some universities treat the ownership of computer programs in their patent policies, even if such programs are protected by copyright rather than by patent. See UNIVERSITY OF MINNESOTA, PATENT & TECHNOLOGY TRANSFER POLICY 1 (enacted by Regents, Oct. 10, 1986); PRINCETON UNIVERSITY, COPYRIGHT POLICY 13 (dated May 1, 1982) (computer programs shall be governed by patent policy because they are "closer to inventions"). Some universities have attempted to split the treatment of computer programs between their patent and copyright policies, thus compounding the interpretation problems inherent in such policies. See CASE WESTERN RESERVE UNIVERSITY, *supra*, at 28-34 (computer programs other than "computer-aided instructional material" governed by patent policy); UNIVERSITY OF CHICAGO, STATUTE 20: PATENTS AND SOFTWARE 1-2 (approved by Trustees, Apr. 25, 1989) ("device-like software" to be treated like inventions, "textual software" to be treated like "published material").

It has been suggested that it is the advent of computer programs that has prompted universities to reevaluate their intellectual property policies. See Hollander, *supra* note 31, at 222; see also Peterson, *supra* note 121, at 188 (reporting that growing computer software sales are forcing universities to rethink copyright policies, stating that "real issue is money"); D'Vera Cohn, *Professors Invent Collegiate Quandary*, WASH. POST, Oct. 22, 1986, at A1 (reporting interest in intellectual property policies accelerated by computer programs). Many faculty members are in fact writing computer programs. Judith Axler Turner, *Colleges, Scholarly Societies, and Foundations Create Software-Dissemination Projects to Share Expertise*, CHRON. HIGHER EDUC., Oct. 17, 1990, at A17.

131. For a discussion of the impact of copyright policies, see *supra* notes 97-116 and accompanying text.

signed by the professor and the university, into which the copyright policy is expressly incorporated by reference, appears to determine the policy's effectiveness in varying copyright ownership.¹³² It is not clear what proportion of the policies collected are expressly incorporated by reference, although six of the policies mention such a signed writing.¹³³ Those universities which do not have an effective copyright policy, or which have no policy, do not alter the ownership result produced under the Copyright Act, as discussed above.¹³⁴ It is important to bear in mind that the absence of an effective policy is not necessarily equivalent to yielding ownership of all works to the faculty.

The copyright policies collected in this study vary in terms of the types of faculty works claimed for the university. A few policies protect the university's perceived interest by providing for one of the following in place of sole copyright ownership by the university: joint copyright ownership by the professor and the university, a royalty-free license for the university, or reimbursement of the university for use of university resources. Most of the policies make some effort to protect the professor's interests, in spite of the fact that the university claims certain works. Examples of this effort are statements of support for academic freedom, provisions for professors to receive a share of royalties, and provisions giving some limited degree of control over the copyright to the professor. Many policies make some provision for construction and enforcement of the policies' terms.

It should be noted at the outset that many policies contain internal inconsistencies, undefined terms, and unnecessarily vague language. The policies therefore are fertile ground for future litigation, such as *Weinstein v. University of Illinois*, in which the copyright policy of the University of Illinois at Chicago was construed.¹³⁵ Of the policies studied, some of the best drafted from a

132. For a discussion of the effect of incorporation of copyright policies in employment contracts, see *supra* notes 105-16 and accompanying text.

133. CARNEGIE-MELLON UNIVERSITY, *supra* note 130, at 10; UNIVERSITY OF FLORIDA, FLORIDA ADMINISTRATIVE CODE, Rule 6C1-7.0392, at 44 (Academic Affairs: Copyrights and Patents, no date); UNIVERSITY OF GEORGIA, COPYRIGHT POLICY 3 (approved by Regents, June 10, 1982); MASSACHUSETTS INSTITUTE OF TECHNOLOGY, *supra* note 104, at 20; UNIVERSITY OF MINNESOTA, COPYRIGHT POLICY 7 (Draft, dated Feb. 22, 1990); STANFORD UNIVERSITY, GUIDE MEMO 76: COPYRIGHTABLE MATERIALS AND OTHER INTELLECTUAL PROPERTY 3 (dated Apr. 15, 1990).

134. For a discussion of the effect of university copyright policies, see *supra* notes 97-104 and accompanying text.

135. For a discussion of *Weinstein*, see *supra* notes 86-89 and accompanying text.

technical standpoint are those of the University of Georgia, Massachusetts Institute of Technology, and Ohio State University.¹³⁶

The most common standard employed by universities for claiming ownership of faculty works is "use of university resources" or "significant or substantial use of university resources;" forty-two of the policies in this study employ some variant of this language.¹³⁷ That universities should use this standard is not surprising because the use of university resources is often cited by universities as the equitable basis for their claims.¹³⁸ However, since there is no tradition of applying this standard, the process of defining it will be one of uncertainty for both parties, possibly resulting in conflict and litigation. Sixteen of the forty-two policies narrow the scope of works claimed under this standard by excluding from "significant use of university resources" some of the following commonly provided resources: libraries, offices, salaries, classrooms, laboratories, and secretaries.¹³⁹ Two policies provide greater predictability by defining "substantial" or "significant" use in terms of fixed dollar

136. UNIVERSITY OF GEORGIA, *supra* note 133; MASSACHUSETTS INSTITUTE OF TECHNOLOGY, *supra* note 104; OHIO STATE UNIVERSITY, *supra* note 130.

137. *E.g.*, LOUISIANA STATE UNIVERSITY, *supra* note 130, at 9 ("significant use of funds, space or facilities"); NEW MEXICO STATE UNIVERSITY, ADMINISTRATIVE POLICY AND PROCEDURES MANUAL 153 (1989) (Policies and Procedures Governing Intellectual Property, approved by Regents, Oct. 1986) ("significant use of university facilities"); UNIVERSITY OF PITTSBURGH, *supra* note 130, at 1 (materials created at least in part with use of university resources); PURDUE UNIVERSITY, EXECUTIVE MEMORANDUM No. B-10 (Statement of University Policy, Principles and Administrative Procedures Relating to the Ownership of Patents, Copyrights, dated Mar. 21, 1973) ("use of facilities or funds").

138. *E.g.*, CARNEGIE-MELLON UNIVERSITY, *supra* note 130, at 7-8 (distribution of financial rewards should reflect resources contributed by and risks assumed by university); UNIVERSITY OF WISCONSIN, GENERAL ADMINISTRATIVE POLICY PAPER, SUBJECT: OWNERSHIP, USE AND CONTROL OF INSTRUCTIONAL MATERIALS 1 (dated Apr. 15, 1977) (university "may have a direct interest in certain instructional materials because substantial public resources have been used in their creation and production").

139. *E.g.*, UNIVERSITY OF GEORGIA, *supra* note 133, at 2 (excludes libraries); TEXAS A & M UNIVERSITY, *supra* note 130, ch. 104, at 3 (excludes office and library; expressly includes classroom and laboratory facilities); UNIVERSITY OF VIRGINIA, *supra* note 100, at 15.5.1.3 (excludes office, library, salary; expressly includes computer use, graduate assistant's services, laboratory materials and secretarial assistance). The excluded resources listed in the text appear roughly in the order of the frequency of their exclusion. Some of the policies clarify that "significant or substantial use of university resources" means use of resources beyond those usually available to faculty. *E.g.*, NEW YORK UNIVERSITY, *supra* note 130, at 124-C ("use of resources commonly available to all faculty" not considered substantial use); UNIVERSITY OF VIRGINIA, *supra* note 100, at 15.5.1.3 (significant use of university resources is use "over and above that provided in the normal course of . . . support of faculty in the pursuit of scholarly activities").

amounts.¹⁴⁰ Defining "substantial" with reference to such an ascertainable standard is advisable.

The use of university resources is a broad standard and could subsume almost any faculty work. This is particularly the case where "use" is not modified by "substantial" or where secretarial and word-processing assistance are not excluded. In spite of the breadth of the university-resource standard, universities are not currently enforcing such policies to their full extent.¹⁴¹ Aside from the possibility that the university may be found to have waived promises by faculty members to assign copyrights by non-enforcement of the policy,¹⁴² broad claims that are selectively enforced will lead to surprise on the part of professors and increased conflict between professors and the university.¹⁴³

140. CARNEGIE-MELLON UNIVERSITY, *supra* note 130, at 3 (use qualifies if "use of similar facilities would cost the creator more than \$5,000 . . . in constant 1984 dollars if purchased or leased in the public market"); VIRGINIA POLYTECHNIC INSTITUTE AND STATE UNIVERSITY, POLICY ON INTELLECTUAL PROPERTY 8 (no date) (use of non-excluded resources in excess of \$1,000 in any 12-month period is substantial); *see also* NORTH CAROLINA STATE UNIVERSITY, *supra* note 130, at 2 (significant use of resources includes use of consultants or research/teaching assistants for more than eight hours in one semester).

A standard similar in rationale to "substantial use of university resources," which appears in nine of the policies in this study, is "direct allocation for a specific project." *E.g.*, CALIFORNIA INSTITUTE OF TECHNOLOGY, *supra* note 130, ch. 7, at 6 ("if . . . the Institute provides its own funds . . . to finance . . . a specific research or educational project"); UNIVERSITY OF CINCINNATI, INTELLECTUAL PROPERTY POLICIES AND PROCEDURES 22 (Copyright Policy, adopted Dec., 1986) ("direct allocation of University funds for the pursuit of a specific project"); STANFORD UNIVERSITY, *supra* note 133, at 1 ("direct allocation of funds through the University for a specific project"). This standard should prove relatively straightforward to construe and apply.

141. *See, e.g.*, Letter from Elizabeth B. O'Brien, Assistant General Counsel, University of Pennsylvania (June 12, 1990); Janis Clark, Formulation of a Guide to University Copyright Policy Revision 80-81 (1984) (unpublished doctoral dissertation in education, University of Northern Colorado) (consisting of survey of opinions of university administrators and faculty at 36 universities and suggesting that fact that faculty is generally unaware of policies is evidence of nonenforcement).

142. *See, e.g.*, *Saverslak v. Davis-Cleaver Produce Co.*, 606 F.2d 208, 213 (7th Cir. 1979) (stating waiver occurs when known right is intentionally relinquished, either expressly or by conduct inconsistent with intent to enforce right), *cert. denied*, 444 U.S. 1078 (1980); *see generally* 5 SAMUEL WILLISTON, A TREATISE ON THE LAW OF CONTRACTS § 678 (3d ed. 1961 & Supp. 1991).

143. None of the policies in this study appears to be so broad as to be invalid under state statutes invalidating contracts by employees to assign to employers their "inventions" produced without the employer's resources, on the employee's own time, unrelated to the employer's business and research, and not resulting from the employee's work for the employer. *See* CAL. LAB. CODE § 2870 (West 1989); DEL. CODE ANN. tit. 19, § 805 (1985); ILL. REV. STAT. ch. 140, para. 302 (Smith-Hurd 1986); KAN. STAT. ANN. § 44-130 (1986); MINN. STAT. ANN. § 181.78 (West Supp. 1991); N.C. GEN. STAT. § 66-57.1 (1985); UTAH CODE ANN. § 34-39-3 (1991); WASH. REV. CODE ANN. § 49.44.140 (West 1990).

With the exception of policies which claim works by genre, the remaining standards for determining which works are claimed by the university all derive from the concept of work made for hire. These policies claim works produced as a result of "specific," "direct" or "written" "job assignment" or "duties" (twenty-five policies),¹⁴⁴ works produced by "persons hired to produce such works" (nine policies),¹⁴⁵ "commissioned" works (ten policies),¹⁴⁶ or works made for hire within the meaning of the Copyright Act (six policies).¹⁴⁷ The use of the language "works produced by persons hired to produce such works" is not recommended; such language might or might not include, for example, traditional scholarship. Given the confusion in the courts concerning the survival of the exception for professors from the work-made-for-hire doctrine, it is not advisable to draft a copyright policy in terms of works made for hire within the meaning of the Copyright Act.

Some policies claim and disclaim works by genre. The type of work most often claimed by genre is computer programs; nineteen copyright policies in this study specifically claim some or all computer programs created by faculty.¹⁴⁸ A few policies at-

The above statutes do not define the term "invention," with the result that the statutes may be applicable to some copyrightable works, particularly computer programs. See Ronald Cooley, *Recent Changes in Employee Ownership Laws: Employers May Not Own Their Inventions and Confidential Information*, 41 BUS. LAW. 57, 66 (1985); Henrik D. Parker, Note, *Reform for Rights of Employed Inventors*, 57 S. CAL. L. REV. 603, 614 (1984). To comply with the above statutes, other than those of North Carolina, Delaware and Utah, the university must include notice of the limits imposed by the statute in any contract requiring assignment of "inventions."

144. E.g., UNIVERSITY OF MARYLAND, *supra* note 127, at 2 ("specific assignments or specific duties not connected with conventional teaching, research, scholarship or artistic endeavors"); OHIO STATE UNIVERSITY, *supra* note 130, at 1 ("specific University duty or assignment"); PRINCETON UNIVERSITY, *supra* note 130, at 2 ("specifically assigned duties").

145. See, e.g., UNIVERSITY OF HAWAII, HAWAII ADMINISTRATIVE RULES tit. 20, ch. 3 (Patent and Copyright Policy, effective Nov. 22, 1968) ("produced by persons who are engaged by the university specifically to produce such manuscripts or works"); UNIVERSITY OF KENTUCKY, *supra* note 127, at 3 (works of faculty employed "for the purpose of producing such works"); PURDUE UNIVERSITY, *supra* note 137, at 2 (work produced by person "employed by the University for the specific purpose of preparing materials").

146. E.g., MICHIGAN STATE UNIVERSITY, *supra* note 127, at 151; UNIVERSITY OF MISSOURI, COLLECTED RULES AND REGULATIONS 100.030, at 1 (1986) (Copyright Regulations, no date); STANFORD UNIVERSITY, *supra* note 133, at 1.

147. E.g., UNIVERSITY OF CINCINNATI, *supra* note 140, at 21; UNIVERSITY OF ROCHESTER, *supra* note 130, at 3; TEXAS A & M UNIVERSITY, *supra* note 130, ch. 104, at 1-2.

148. For a further discussion of policies claiming computer programs, see *supra* note 130 and accompanying text. A few of the claims to computer pro-

tempt to define claimed works in terms of genres or types of work other than computer programs,¹⁴⁹ such as "technical materials" developed "under the jurisdiction of the university," including photographs, audiotapes, films, and broadcasting scripts,¹⁵⁰ or "material in non-print media."¹⁵¹ Thus, works claimed by genre tend to be potentially marketable works, whose production may require expensive equipment.

Eighteen policies in this study limit the impact of the policies on faculty by claiming for the university an interest less than sole copyright ownership with respect to at least some works. Those few policies which provide for the university and the professor to be "joint owners" or "co-authors" of certain works¹⁵² are presumably intended to create, and in fact do create, tenancies in common rather than joint tenancies, by analogy to section 201(a) of the Copyright Act, which creates a tenancy in common in co-owners of a joint work.¹⁵³ Such provisions creating cotenancies between the university and the professor are inadvisable. Since either co-owner can license the work,¹⁵⁴ joint decisions by the

grams are extremely broad. For example, the California Institute of Technology policy claims "all rights to computer software . . . whether copyrightable or patentable produced by Faculty members in the line of Institute duty or with the use of Institute facilities." CALIFORNIA INSTITUTE OF TECHNOLOGY, *supra* note 130, ch. 7, at 6.

149. Two policies apply only to "educational materials." MICHIGAN STATE UNIVERSITY, *supra* note 127, at 150; UNIVERSITY OF MISSOURI, *supra* note 146, at 1. The University of Missouri policy, however, defines the above term so broadly that it might include any copyrightable work. UNIVERSITY OF MISSOURI, *supra* note 146, at 1-3. For a discussion of works disclaimed by genre, see *infra* note 163 and accompanying text.

150. COLORADO STATE UNIVERSITY, *supra* note 130, at J-3. The policy does not define "technical materials" or "jurisdiction of the University," but gives examples, including those cited in the text.

151. ROCKEFELLER UNIVERSITY, *supra* note 130, at 1. Materials in non-print media are claimed only if produced "in the course of employment by the University" or "through the use of facilities or funds of the University." *Id.*

152. UNIVERSITY OF GEORGIA, *supra* note 133, at 2; GEORGIA INSTITUTE OF TECHNOLOGY, *supra* note 127, at 6:16; UNIVERSITY OF NORTH CAROLINA AT CHAPEL HILL, UNIVERSITY COPYRIGHT GUIDELINES 7 (approved by Faculty Council, no date); NORTH CAROLINA STATE UNIVERSITY, *supra* note 130, at 1.

153. See 17 U.S.C. § 201(a) (1988). Section 101 provides that a "joint work" is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." *Id.* § 101. "The authors of a joint work are co-owners of copyright in the work." *Id.* § 201(a). The form of cotenancy between co-owners of copyright is tenancy in common. 1 NIMMER & NIMMER, *supra* note 19, § 6.09.

Such a policy provision does not create a "joint work" within the meaning of the Copyright Act because the policy cannot make the university an "author" within the meaning of the act. For a discussion of the effect of employer-employee agreements, see *supra* notes 64-65 and accompanying text.

154. 1 NIMMER & NIMMER, *supra* note 19, § 6.10.

university and the professor will be necessary for effective marketing of the work.¹⁵⁵ A more workable alternative, employed with respect to at least some works by ten policies in this study, is to give the university a non-exclusive, royalty-free license to use the work.¹⁵⁶ Such a provision permits the professor to market the work independently outside the university because the university has no right to license use of the work to others.¹⁵⁷ An alternative which creates even less possibility of future friction between the professor and university is reimbursement of the university by the professor for the resources used. Reimbursement provisions appear in five policies with respect to certain works.¹⁵⁸ However, neither a license to use the work within the university nor reimbursement satisfies the university's interest in generating revenue.

University copyright policies generally show concern for the interests of faculty. Attempts to protect these interests range from purely symbolic assertions of commitment to academic freedom¹⁵⁹ to royalty provisions and express disclaimers by the university of copyright in certain works. Eighteen of the policies in

155. For a discussion of the advisability of co-ownership between elementary and secondary schools and their teachers, see VerSteeg, *supra* note 87, at 410.

156. See, e.g., UNIVERSITY OF CALIFORNIA, UNIVERSITY COPYRIGHT POLICY 4 (dated Aug. 1, 1975; revised Apr. 15, 1977) ("free and irrevocable license" to use works created without university resources "in conjunction with . . . University employment"); CASE WESTERN RESERVE UNIVERSITY, *supra* note 130, at 33 ("royalty-free right to . . . internal use" of material developed "as a consequence of initiatives taken by others" than the professor); UNIVERSITY OF WASHINGTON, *supra* note 100, at 49 ("right to royalty-free use" of material when development was "advanced" through use of university resources). Note that such licenses are analogous to the rights conferred on the employer by the "shop right" doctrine of patent law. See 1 PETER D. ROSENBERG, PATENT LAW FUNDAMENTALS § 11.04, at 11-16 (1988). Not included in the tally is one policy which claims an exclusive license in works to which the university's contribution is "de minimis." VIRGINIA POLYTECHNIC INSTITUTE AND STATE UNIVERSITY, *supra* note 140, at 6.

A non-exclusive, royalty-free license held by schools in the works of teachers is the solution recommended in the context of elementary and secondary schools by Professor VerSteeg. VerSteeg, *supra* note 87, at 410-12.

157. Such policy provisions do not always state explicitly that the license does not include the power to grant further licenses.

158. E.g., HARVARD UNIVERSITY, *supra* note 127, at 4 (where "significant additional costs" to university, reimbursement expected); UNIVERSITY OF NEW MEXICO, *supra* note 100, at 7 (where employee makes extensive use of university resources, director, department chair or dean may require reimbursement); PRINCETON UNIVERSITY, *supra* note 130, at 2 (where "substantial expenditures for additional work, . . . part of the income received should be used to reimburse").

159. For a statement of traditional academic freedom, see *American Association of University Professors and Association of American Colleges (Joint Conference), 1940 Statement of Principles in Academic Freedom and Tenure*.

this study contain statements of commitment to academic freedom or the free dissemination of ideas.¹⁶⁰ Such concerns are raised by university ownership of faculty works because the copyright owner has exclusive power to publish¹⁶¹ and may suppress publication.¹⁶² Sixteen policies expressly disclaim university ownership of copyrights in traditional scholarly works, such as books and articles, although most of these policies contain exceptions to this disclaimer.¹⁶³ Nearly every policy (forty-six) provides for payment of a share of the income from at least some works claimed by the university to the creator of the work.¹⁶⁴

The most creative measures designed to protect the professor's interests are those which recognize the importance to the professor of control over dissemination of works whose copyright is claimed by the university. Most of the universities in this study have not employed such measures. Relatively few policies contain, for example, provisions which grant the professor the power to control use of the work within the university (five policies),¹⁶⁵

160. *E.g.*, LOUISIANA STATE UNIVERSITY, *supra* note 130, at 9 ("The copyright policy seeks to protect and promote the traditional academic freedom of the University's faculty, staff, and students in matters of publication."); STANFORD UNIVERSITY, *supra* note 133, at 1 ("[t]o enable the University to foster the free and creative expression and exchange of ideas and comment"); YALE UNIVERSITY, UNIVERSITY COPYRIGHT POLICY 1 (adopted by Corporation, June, 1990) ("[T]he University encourages the wide dissemination of scholarly work produced by members of the Yale community, including copyrightable works.").

161. 17 U.S.C. § 106(3) (1988) (owner of copyright has exclusive right to distribute copies or phonorecords of copyrighted work to public by sale, rental or lending).

162. *Salinger v. Random House, Inc.*, 650 F. Supp. 413, 423 (S.D.N.Y. 1986) (the owner's "copyright permits him to suppress its publication"), *rev'd on other grounds*, 811 F.2d 90 (2d Cir.), *cert. denied*, 484 U.S. 890 (1987).

163. *E.g.*, UNIVERSITY OF ROCHESTER, *supra* note 130, at 3 ("the University generally does not claim for itself copyrights in those books, articles, theses, papers, novels . . . and similar works which are intended to disseminate the results of the academic research, scholarship, and artistic expression of its faculty"; excepted are works produced with significant use of university resources, "institutional works" and sponsored works); UNIVERSITY OF TENNESSEE, *supra* note 127, at 3 (rights to textbooks and monographs and scholarly and literary publications belong to creator unless work is commissioned or sponsored).

164. *See, e.g.*, CALIFORNIA INSTITUTE OF TECHNOLOGY, *supra* note 130, ch. 7, at 1 ("the author . . . will receive fifteen percent (15%) of the gross sum of any royalty received by the Institute"); NEW MEXICO STATE UNIVERSITY, *supra* note 137, at 153 ("[F]or earnings less than or equal to \$1,000,000, the originator will receive not less than 50 percent and the university the remainder. For those earnings in excess of \$1,000,000, the originator will receive not less than 25 percent, and the university the remainder."); UNIVERSITY OF VIRGINIA, *supra* note 100, at 15.5.1.4 ("[T]he work's author(s) will receive, from any work in which it is determined that the University owns the copyright interest, fifty percent of the net royalties or other income which accrue.").

165. CASE WESTERN RESERVE UNIVERSITY, *supra* note 130, at 29; MICHIGAN

the power to revise the work (seven policies),¹⁶⁶ or the power to make new works based on the claimed work (one policy).¹⁶⁷ None of the policies in this study gives the professor unilateral control over any aspect of use of the work outside the university, such as how or where the work is marketed or published.¹⁶⁸ Only six policies provide for transfer of the copyright in works claimed by the university to the professor if commercialization or publication has not taken place within a given time period, and most such provisions are not mandatory.¹⁶⁹

STATE UNIVERSITY, *supra* note 127, at 152; UNIVERSITY OF MISSOURI, *supra* note 146, at 5; PURDUE UNIVERSITY, *supra* note 137, at 3; UNIVERSITY OF WASHINGTON, *supra* note 100, at 50-51.

All but one of the above policies also provide that the university and the professor shall make an agreement concerning the conditions of use outside the university. *E.g.*, PURDUE UNIVERSITY, *supra* note 137, at 3 (licensing or sale by university shall be preceded by written agreement between university and author regarding conditions of use).

166. CASE WESTERN RESERVE UNIVERSITY, *supra* note 130, at 29; MICHIGAN STATE UNIVERSITY, *supra* note 127, at 153; PURDUE UNIVERSITY, *supra* note 137, at 3; TEXAS A & M UNIVERSITY, *supra* note 130, ch. 104, at 2; UNIVERSITY OF MISSOURI, *supra* note 146, at 5; UNIVERSITY OF UTAH, *supra* note 127, at 7; UNIVERSITY OF WISCONSIN, *supra* note 138, at 3.

167. UNIVERSITY OF MISSOURI, *supra* note 146, at 3. The right to make a new work based upon an existing work is the copyright owner's exclusive right to make a derivative work. 17 U.S.C. §§ 101, 106(2) (1988).

Fourteen policies require the university to consult with the professor concerning use or revision of the work; such a provision gives the professor no control over his work. *See, e.g.*, VIRGINIA POLYTECHNIC INSTITUTE AND STATE UNIVERSITY, *supra* note 140, at 8 (author shall have the right to make recommendations to the president regarding marketing).

168. A few policies provide that the university may, at its discretion, grant the author control over certain aspects of distribution. *E.g.*, MASSACHUSETTS INSTITUTE OF TECHNOLOGY, *supra* note 104, at 13.

169. *E.g.*, CARNEGIE-MELLON UNIVERSITY, *supra* note 130, at 8 (if university does not develop commercially, ownership "may be acquired by the creator"); UNIVERSITY OF KENTUCKY, *supra* note 127, at 6 (if no commercialization within two years, originator may request that all rights be returned); VIRGINIA POLYTECHNIC INSTITUTE AND STATE UNIVERSITY, *supra* note 140, at 5 (if university fails to make progress toward exploitation within 12 months, employee may make written request that ownership pass to employee).

The provisions dealing with revisions, derivative works, and transfer of copyright to the author if there is not timely commercialization, as well as author's warranties (seven policies), may have been suggested by publishing contracts, which often contain such provisions. The author's warranties consist of promises that works claimed by the university do not infringe any copyrights or violate any other rights, and of promises to indemnify the university for any loss if the works do so infringe or violate rights. *See, e.g.*, MICHIGAN STATE UNIVERSITY, *supra* note 127, at 156 (faculty member shall certify that materials do not infringe any copyright or other rights and shall be liable to university for judgments resulting from such infringements); TEXAS A & M UNIVERSITY, *supra* note 130, ch. 104, at 7 (author shall warrant that work does not infringe any copyright or other rights and that work contains no libelous material or material that invades privacy).

Construction of the policies will become necessary as disputes arise; the issues of construction and adjudication of disputes are addressed by some of the policies. Of these policies, many provide for a committee within the university to perform the initial decision making, with a final "binding" decision to be made either through "arbitration" or by a university official, such as the provost or president.¹⁷⁰ To the extent that the policy is enforceable as a contract,¹⁷¹ such provisions would constitute an agreement to arbitrate, which is generally enforceable.¹⁷² The fact that university officials are also representatives of the university does not appear to disqualify them from acting as the sole arbitrators of disputes.¹⁷³ However, use of university officials as final arbiters of ownership disputes between the university and faculty may create the appearance of unfairness and therefore lead to increased conflict.

VII. OWNERSHIP OF PROFESSORS' WORKS

The previous sections of this Article have addressed the questions of who owns the copyright in professors' works under the Copyright Act and under the terms of university copyright policies. This section suggests approaches to the question of who should own faculty works.

Asking who should own the copyright in faculty works suggests an overly simplistic response. The interest taken by universities in faculty copyrights is primarily monetary, as demonstrated

170. *E.g.*, CARNEGIE-MELLON UNIVERSITY, *supra* note 130, at 9 (party not satisfied with decision of committee may seek binding arbitration); UNIVERSITY OF MIAMI, *supra* note 130, at 123 (appeal from committee to president whose decision is binding).

171. The enforceability of an arbitration provision would be an issue only where the ownership provisions of the policy were enforceable. For a discussion of the enforceability of ownership provisions, see *supra* notes 97-116 and accompanying text.

172. *Zechman v. Merrill Lynch, Pierce, Fenner & Smith*, 742 F. Supp. 1359, 1365 (N.D. Ill. 1990) (question whether issue is arbitrable is to be resolved in favor of arbitration); *Frager v. Pennsylvania Gen. Ins. Co.*, 231 A.2d 531, 533 (Conn. 1967) ("duty to arbitrate may be created by contract"), *appeal after remand*, 289 A.2d 896 (Conn. 1971).

173. *See Westinghouse Elec. Corp. v. New York City Transit Auth.*, 735 F. Supp. 1205, 1226 (S.D.N.Y. 1990) (parties free to agree upon identity of arbitrators); *City of Baltimore v. Allied Contractors, Inc.*, 204 A.2d 546, 552 (Md. 1964) (parties may provide for submission of disputes to arbitrator who is an official of one of the parties). *But see Hope v. Superior Court of Santa Clara County*, 175 Cal. Rptr. 851, 856 (Ct. App. 1981) (finding arbitration provisions unconscionable where arbitrators were associated with employer), *cert. denied*, 456 U.S. 910 (1982).

by the universities' interest in holding copyright in technologically complex works, evident in the university policies discussed above.¹⁷⁴ Some university officials assert that the university's motive in claiming professors' works is not solely revenue raising, but that the university thereby assists the professor in distribution.¹⁷⁵ However, assistance in exploitation through publication and licensing can be offered to professors without claiming any interest in faculty works. Further, the model of narrow-minded professors, who lack the wider vision of university administrators necessary in order to protect the interests of society in their copyrightable works, does not reflect reality. Faculty members have, on the other hand, in addition to monetary interests in their works, an interest in controlling their dissemination, such as the manner of distribution, the making of revisions, and the production of later works based on their works.¹⁷⁶ The latter interests have received too little recognition from universities that establish the rights of the parties by contract, as demonstrated by the analysis of university policies in the preceding section. The university has little to gain by claiming aspects of the copyright in which it has no real interest; to the extent possible the economic and academic interests in faculty works should be separated.¹⁷⁷ Aspects of the copyright that should be considered in any determination of who should own which rights include: (1) the right to determine whether to distribute, when to distribute, through what marketing organization, at what price, with what revisions ini-

174. For a discussion of university interest in faculty copyrights, see *supra* notes 128-30 and 148-51 and accompanying text.

175. See, e.g., Cohn, *supra* note 130, at A1.

176. The monetary rights and other rights comprising the copyright discussed in the text are narrower than the "pecuniary" and "nonpecuniary interests . . . at stake in the creative process," discussed by Professor Dreyfuss. See Dreyfuss, *supra* note 1, at 605. For example, one of the nonpecuniary interests discussed by Professor Dreyfuss is the choice of what works to create and when to create them. *Id.* at 606-14. Professor Dreyfuss argues that copyright ownership in the university is undesirable in part because the university would then have the incentive to influence these decisions. *Id.* Universities presently exert enormous influence over these decisions regardless of copyright ownership.

See *id.* at 617, 620, 625 (discussing impact on creative employee's reputation of timing of publication and of form in which work published; harm to creator if unable to make derivative works); Clark, *supra* note 141, at 79 (reporting that survey shows faculty fear university control of their works).

177. Professor Dreyfuss warns of a problem that may arise if the creator owns the right to decide when to publish, but not the right to income: the creator may delay publication. Dreyfuss, *supra* note 1, at 618. This problem will not arise if the creator has some share of the right to income, which is the case under most of the copyright policies in this study. For examples of universities sharing income with faculty, see *supra* note 164 and accompanying text.

tially, and when to make further revisions (such as a second edition); (2) the right to make such further revisions; (3) the right to make and license the making of other works based on the work; (4) the right to perform the work; (5) the right to receive income produced by the work in its original form, to receive income produced by the work with subsequent revisions, and to receive income produced by works based on the work; and (6) the right to acquire distribution rights if the other party fails to distribute.

Of course, the academic and economic interests in copyrightable works may, in some cases, be inextricable, as where the professor wishes to distribute his work free of charge in the interest of scholarship, and the university wishes to exploit the work financially.¹⁷⁸ Among copyrightable works this particular conflict is especially likely to arise with respect to computer programs written by faculty.¹⁷⁹

The issues that bear on the determination of who should own even the monetary interest in a work are complex. Colleges and universities face a pressing need for sources of revenue as enrollments decline¹⁸⁰ and government spending for higher education decreases.¹⁸¹ Advances in technology impose new costs on universities for expensive equipment and specialized personnel.¹⁸²

178. See, e.g., Lisa Gerrard, *When a University Faculty Member Develops Academic Software, Who Should Share in the Profits?*, CHRON. HIGHER EDUC., July 22, 1987, at A64 (noting conflict between academic tradition to share work freely and profit motive).

179. See, e.g., Turner, *supra* note 130, at A17 (most professors "happy to share their [higher-education software] with their colleagues"). An example is the case of a professor who left the California Institute of Technology in 1983 when the university, claiming it owned the copyright in a computer program he had developed, tried to prevent him from distributing it cheaply to others in his field. Gina Kolata, *Caltech Torn by Dispute Over Software*, 220 SCI. 932-33 (1983); *The Tempest Raging Over Profit-Minded Professors*, BUS. WK., Nov. 7, 1983, at 86.

180. For a discussion of the level of concern over declining enrollments, see *infra* note 182.

181. See, e.g., Karen Grassmuck, *Colleges Scramble for Money to Reduce Huge Maintenance Backlog, Estimated to Exceed \$70-Billion; New Federal Help Seen Unlikely*, CHRON. HIGHER EDUC., Oct. 10, 1990, at A1; Scott Jaschik, *States Spending \$40.8-Billion on Colleges This Year; Growth Rate at a 30-Year Low*, CHRON. HIGHER EDUC., Oct. 24, 1990, at A1.

182. See, e.g., Constance Holden, *Paying for Research Instrumentation*, 229 SCI. 1247, 1247 (1985) (reporting that funds are insufficient to meet rising cost of university research equipment); *Colleges Pleased that Growth of Computer Science Majors is Slowing*, CHRON. HIGHER EDUC., Jan. 8, 1986, at 28 (investment in computer technology overwhelms many institutions). In response to a survey conducted by the American Council on Education in 1989, the most frequently cited problems facing colleges and universities during the next five years were adequate finances (39%), maintaining enrollment (44%), and facilities and technology (42%). See *Leading Research Universities*, *supra* note 122, at 24.

Individuals generally cannot amass the resources necessary for the production of technologically complex works. Therefore, if such works are to be produced, larger institutions, including universities, must be given the means to do so.¹⁸³ On the other hand, those professors with skills marketable outside the university may, as has already occurred in the fields of business, engineering and computer science,¹⁸⁴ leave the university for more lucrative positions in industry. Depriving such professors of supplemental income they might derive from their copyrightable works may contribute to this flight from the university. The issues to be balanced are complex and circumstances vary from university to university and among fields of work. Thus, ownership issues should be resolved, as the major research universities have begun to resolve them,¹⁸⁵ by contract, rather than by one monolithic rule of law.

How should such contracts, in the form of university copyright policies, look? Suggestions as to drafting techniques have been made in Part VI above. With respect to the substance of such policies, it is impossible to lay out a model plan which will be appropriate to every university and to every type of work. Upon consideration of the concerns discussed above, universities with sufficient endowments may find it expedient to allocate all copyrights to faculty creators, while other universities may decide to fund the production of expensive, technologically complex works with a share in the revenue produced by such works. Still other

183. Ownership of copyright has traditionally been considered an incentive to investment and creation. See, e.g., *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) (explaining that copyright monopoly "is intended to motivate the creative activity of authors"). Copyright revenues can also provide funds for further investment and, consequently, the means for further creation. Professor Reichman advocates university commercialization of faculty computer programs as a means of obtaining funding. Reichman, *supra* note 1, at 712-13, 722.

184. Scott Heller, *Faculty-Salary Systems Are Strained as Colleges Try to Hire and Retain Professors in Competitive Fields*, CHRON. HIGHER EDUC., Feb. 26, 1986, at 1; Robert L. Jacobson, *Low Pay and Declining Working Conditions Seen Threatening Colleges' Teacher Supply*, CHRON. HIGHER EDUC., Mar. 27, 1985, at 21 (reporting that leaving university for industry is trend in business, engineering, computer science); see also HOWARD R. BOWEN & JACK H. SCHUSTER, *AMERICAN PROFESSORS: A NATIONAL RESOURCE IMPERILED* 170 (1986) (finding relative attractiveness of business, government and other fields of employment lures faculty away from academia); Debra E. Blum, *Job Market Begins Predicted Turnaround Survey Indicates, Many Colleges Find It Difficult to Fill Faculty Vacancies*, CHRON. HIGHER EDUC., July 25, 1990, at A1 (reporting difficulty in filling faculty positions in engineering, accounting).

185. For a discussion of universities' adoption of copyright policies, see *supra* notes 120-23 and accompanying text.

universities may find it advisable to allocate to themselves some interest in additional types of works based on either expense of production or profitability or both. What is essential is that the university allocate to itself only those aspects of the copyright in which it truly has an interest.

As discussed in Part IV, to the extent that the judge-made exception for professors from work-made-for-hire provisions ever existed, it continues to exist.¹⁸⁶ The question whether such an exception should exist is really the question whether, in the absence of any contract dealing with copyright ownership (which still appears to be the case at most colleges and universities),¹⁸⁷ it is preferable for all faculty works to belong to the university or to the professor. Since faculty members have traditionally assumed and generally still assume that they own the copyright in their works, the parties' expectations are protected by preserving the exception to the work-made-for-hire provisions of the Copyright Act.

VIII. CONCLUSION

The picture frequently presented of work-made-for-hire cases under the 1909 Act is misleading. The treatment of section 26 as creating a presumption rather than an absolute rule of copyright ownership in the employer played a smaller role in cases decided under the 1909 Act than prior commentators indicate. Further, there was no uniformity as to the form of evidence admissible in order to prove the existence of an agreement that the employee own the copyright. In particular, very few cases stated that evidence of custom in the industry could be used for this purpose.

In spite of a widely held, though unpopular, view that the Copyright Act of 1976 abolished the exception for professors from work-made-for-hire provisions, originating in two influential articles published in 1983 and 1985, the 1976 Act did not disturb the exception. To the extent that the exception ever existed, it continues to exist. However, a university copyright policy, if expressly incorporated by reference into a written employment contract, signed by both the professor and the university, appears to

186. For an explanation of the widespread, mistaken belief that the 1976 Act abolished the professors' exception to the work-made-for-hire provisions, see *supra* notes 51-94 and accompanying text.

187. For a discussion of the fact that most colleges and universities have not adopted copyright ownership policies, see *supra* note 121 and accompanying text.

satisfy the requirements of sections 204(a) and 201(b), thereby effectively varying ownership results produced by the Copyright Act. The university copyright policies, if any, of seventy leading research universities, collected for this study, vary in terms of the works claimed for the university. Most of the copyright policies in this study make some effort to protect the interests of professors. Of these efforts, those few policies that subdivide the copyright in works claimed by the university in order to protect the professors' interest in controlling dissemination are most notable.

The exception for professors from the work-made-for-hire provisions should be preserved in order to protect the parties' expectations, ownership issues should be resolved by means of copyright policies, and the economic and academic interests in faculty works claimed by universities should be separated in order to protect the interests of professors.

APPENDIX A

Boston University
California Institute of Technology
Carnegie-Mellon University
Case Western Reserve University
Colorado State University
Columbia University
Cornell University
Duke University
Georgia Institute of Technology
Harvard University
Howard University
Indiana University at Bloomington
Johns Hopkins University
Louisiana State University
Massachusetts Institute of Technology
Michigan State University
New Mexico State University
New York University
North Carolina State University
Northwestern University
Ohio State University
Oregon State University
Pennsylvania State University
Princeton University
Purdue University
Rockefeller University
Rutgers University
Stanford University
State University of New York at Stony Brook
Texas A & M University
University of Arizona
University of California at Berkeley
University of California at Davis
University of California at Irvine
University of California at Los Angeles
University of California at San Diego
University of California at San Francisco
University of Chicago
University of Cincinnati
University of Colorado at Boulder
University of Connecticut

University of Florida
 University of Georgia
 University of Hawaii at Manoa
 University of Illinois at Chicago
 University of Illinois at Urbana-Champaign
 University of Iowa
 University of Kentucky
 University of Maryland at College Park
 University of Miami
 University of Michigan at Ann Arbor
 University of Minnesota-Twin Cities
 University of Missouri at Columbia
 University of New Mexico
 University of North Carolina at Chapel Hill
 University of Pennsylvania
 University of Pittsburgh
 University of Rochester
 University of Southern California
 University of Tennessee at Knoxville
 University of Texas at Austin
 University of Utah
 University of Virginia
 University of Washington
 University of Wisconsin at Madison
 Virginia Polytechnic Institute and State University
 Vanderbilt University
 Washington University
 Yale University
 Yeshiva University

