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Copyright Ownership Of Scholarly Works Created By University Faculty And Posted On School-Provided Web Pages

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I. INTRODUCTION

This article will discuss the issue of copyright ownership to a scholarly work that is written by a university faculty member.[1] The analysis will include a general discussion of copyright law, including the work for hire doctrine, the development and applicability of the common law exception to the work for hire doctrine for academic writings, whether a university professor publishing a scholarly article is "within the scope of employment," web page publishing issues for professors who want to put their papers online and a discussion of the most practical strategies for professors who want to claim copyright ownership to their scholarly works.[2]

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1 The term university as used in this article refers to any school of higher education beyond the secondary school system.

2 The fact that the scholarly work is found on a web page will be considered a means of publication of the faculty work. The the term professor as used in this article will refer to any faculty member at a university.

II. COPYRIGHT LAW BASICS

The origins for United States copyright laws are found in the Constitution, which provides that Congress shall have the power "to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."[3] This clause "permits Congress to grant authors certain rights with regard to the works they create."[4] The reasoning behind the founding fathers offering copyright protection was to "reward individual artists for their creative genius by granting them a limited monopoly over the duplication and distribution of their works."[5] In the case of a university professor, copyright protection offers the professor an incentive to produce new scholarly works. Society then gains from the introduction of the new works, which tends to improve the overall qualify of life in the community. However, the "copyright monopoly is limited so that the public cannot be deprived permanently of the benefits of the work created."[6]

The first United States Copyright Act was enacted in 1790. Since then, there have been four subsequent major revisions, the most recent being the Copyright Act of 1976.[7] The 1976 Act,[8] which was a general revision of federal copyright law,[9] provides copyright protection for "original works of authorship fixed in any tangible medium of expression."[10] This includes literary works like a professor's scholarly article.[11] A work becomes protected "at the very instant that. . . a word is written on a page or encoded onto a computer disk."[12] Additionally, "an author is not required to register a copyright, nor even affix a copyright notice to the work to obtain copyright safeguards."[13] The 1976 Act, which was a general revision of federal copyright law, makes it clear that copyright ownership "is distinct from ownership of any material object in which the work is embodied."[14]

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3 U.S. CONST. art. I, § 8, cl. 8.

4 Michael J. Luzum and Daniel S. Pupel, Jr., *Weinstein v. University of Illinois: The "Work-For-Hire" Doctrine and Procedural Due Process for Nontenured Faculty*, 15 J.C. & U.L. 369, 372 (1989).

5 *Id.*

6 *Id.*

7 Sherri L. Burr, *A Critical Assessment of Reid's Work for Hire Framework and Its Potential Impact on the Marketplace for Scholarly Works*, 24 J. MARSHALL L. REV. 119, 120 (1990).

8 Hereafter the 1976 Act will be referred to as "the Act."

9 Russ VerSteeg, *Copyright and the Educational Process: The Right of Teacher Inception*, 75 IOWA L. REV. 381, 386 (1990).

10 17 U.S.C. §101(1) (1990).

11 VerSteeg, *supra* note 9, at 383.

12 *Id.* at 384.

13 *Id.*

14 *Id.* at 386.

Thus, in a situation where a scholarly article appears on a university owned web page, the ownership of the web page is separate from the ownership of the copyright to the scholarly article.

Copyright ownership is a unique form of proprietorship.[15] The Act provides that initial ownership of the "bundle" of copyrights vests in the author of the work.[16] While it is true that the Act does not define the term "author," the Supreme Court, over one hundred years ago, construed the term to mean the person "to whom anything owes its origin; originator; maker . . ."[17]

In order to determine who owns a copyright, the relevant federal statute is 17 U.S.C. §201, entitled "Ownership of Copyright." Section 201(a) states that a "copyright in a work protected under this title vests initially in the author or authors of the work."[18] If this statute is taken on its face, it appears that the professor would own the copyright to his scholarly article, as the author of the work. However, a legal concept called "work for hire" makes this answer less clear in an employment situation.

Work made for hire is covered in two sections of the 1976 Copyright Act. First, a definition of "work made for hire" can be found at 17 U.S.C. §101.[19] This section breaks down the definition into two distinct categories. "Subsection (1) defines work made for hire as a work prepared by an employee within the scope of his or her employment."[20] Alternatively, "subsection (2) defines 'work for hire' as work ordered or commissioned for use as a collective work, as a translation, as part of a motion picture, as an atlas, as a compilation . . ."[21]

Section 201(b) of the 1976 Act also deals with the work for hire doctrine. This section states that "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." This provision appears to make the university, as the employer, the holder of the copyright for the scholarly works of its employees. In the case of works made for hire, the employer is considered the author of the work, and is regarded as the initial owner of copyright unless there has been an express agreement otherwise.[22] If the

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15 *Id.*

16 *Id.* at 387.

17 *Id.*

18 17 U.S.C. §201(a) (1990).

19 17 U.S.C. §101 (1990).

20 Luzum, *supra* note 4, at 373.

21 *Id.*

22 17 U.S.C. §201 (b) (1990).

parties wish to alter this relationship, "any agreement under which the employee is to own rights must be in writing and signed by the parties."[23]

III. THE EXCEPTION TO WORK FOR HIRE FOR ACADEMIC WRITINGS

According to the legislative history of the 1976 Act, "Congress did not intend to change the law prior to the 1976 Act regarding work for hire when a regular employment relationship exists."[24] Therefore, in order "to evaluate what works created by a teacher should be considered works for hire under the 1976 Act, it is critical to understand the interpretation of works for hire under the prior law."[25] This prior law was the Copyright Act of 1909[26], which was in effect from 1909 through December 31, 1978. Under the older Copyright Act, "courts and commentators regarded the work for hire doctrine, as largely inapplicable to teachers."[27] The most well known of these commentators is "the leading authority in the copyright field,"[28] Melville B. Nimmer.[29] Nimmer's view was "that professors own the copyright to scholarly work"[30] because "courts fashioned a 'teacher exception' to the work for hire rules."[31]

Nimmer refers to two common law cases, *Sherrill v. Grieves*[32] and *Williams v. Weisser*,[33] for creating the academic exception to the work for hire doctrine. In both of these cases, the courts "considered the work made for hire concept with respect to professors but did not find works made for hire, in a large part due to policy and custom."[34] In the United States, these two cases alone comprise the judicial "authority prior to the 1976 Act for the existence of an exception from the work made for hire doctrine for

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23 *Id.*

24 VerSteeg, *supra* note 9, at 388.

25 *Id.*

26 Copyright Act of March 4, 1909, Pub. L. No. 60-349, ch. 320, 35 Stat. 1075.

27 Rochelle Cooper Dreyfuss, *The Creative Employee and The Copyright Act Of 1976*, 54 U. CHI. L. REV. 590, 591 (1987).

28 Todd F. Simon, *Faculty Writings: Are They "Works Made For Hire" Under the 1976 Copyright Act?*, 9 J.C. & U.L. 485, 499 (1982-83).

29 Melville B. Nimmer, 1 NIMMER ON COPYRIGHT §5.03[B] (1984). Nimmer bases his conclusion on dicta in a number of cases; *see* Williams v. Weisser, 78 Cal. Rptr. 542 (Ct. App. 1969).

30 Simon, *supra* note 28, at 499.

31 Dreyfuss, *supra* note 27, at 597. *See also* 1 NIMMER ON COPYRIGHT at §5.03[B][1][b][i] and §5.03[B] n.31.

32 57 Wash. L. Rep. 286 (D.C. Cir. 1929).

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

34 Laura G. Lape, *Ownership of Copyrightable Works of University Professors: The Interplay Between the Copyright Act and University Copyright Policies*, 37 VILL. L. REV. 223, 233 (1992).

professors."[35] Most interestingly, these cases, "stand in stark contrast to the general rule that the copyright to works created pursuant to an employment relationship vest with the employer."[36]

Sherrill and *Williams* do follow an English tradition that allowed a professor to own copyright in their works.[37] That tradition stems from the 1825 English case of *Abernethy v. Hutchinson*,[38] where Lord Elton held that "precedent warranted a recognition of a litigant's claim to ownership of his lectures in medicine" since Sir William Blackstone had been found to own the copyright to his lectures on law.[39]

In *Sherrill v. Grieves*,[40] the Supreme Court of the District of Columbia held that "a professor's works are excepted from the work made for hire doctrine."[41] In this case, the issue was whether a military instructor's book for his classes fell under the work for hire provisions of the 1909 Act.[42] The instructor, Mr. Sherrill, "taught military sketching, map reading, and surveying to United States Army officers, and prepared and wrote a textbook on these subjects."[43] Prior to publication, "Sherrill allowed United States military authorities to print a pamphlet incorporating the section from his textbook on military sketching."[44] The defendants published an infringing work, but when sued, they argued that Sherrill did not own the copyright to his academic writing since his work was a work for hire.[45] The court disagreed and held that Sherrill owned the copyright "because a professor is not obliged to reduce his or her lectures to writing, if he or she does so the lectures do not become the property of the employing institution."[46] The case is important because it was the first judicial case in the United States that recognized an exception to the work for hire doctrine for an academic work product.

Williams v. Weisser,[47] a 1969 California Court of Appeals case, more "explicitly excepted the works of professors from the work made for hire

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35 *Id.*

36 VerSteeg, *supra* note 9, at 392.

37 Robert A. Gorman and Jane C. Ginsburg. COPYRIGHT FOR THE NINETIES 266-67 (editor 4th ed. 1993) (original date).

38 3 L.J. 209, 214-15 (Ch.) (1825).

39 Gorman, *supra* note 37, at 267.

40 57 Wash. L. Rep. 286 (D.C. Cir. 1929).

41 Lape, *supra* note 34, at 235.

42 Margaret D. Smith and Perry A. Zirkel, *Implications of CCNV v. Reid for the Educator Author: Who Owns the Copyright?*, 63 ED. LAW REP. 703, fn. 59 (1991).

43 VerSteeg, *supra* note 9, at 394.

44 *Id.*

45 *Id.*

46 Burr, *supra* note 7, at 140.

47 Williams, 78 Cal. Rptr. at 542.

doctrine."[48] In that case, "a California court of appeals enjoined a student from publishing his lecture notes."[49] Williams, an anthropology professor at UCLA sued Weisser, the owner of a company that sold lecture notes from UCLA classes.[50] In order to obtain the notes from Professor Williams' most recent class, Weisser hired a student in the class take detailed notes and then to turn over the notes to Weisser's company, called Class Notes.[51] Weisser then proceeded to reproduce the notes and sell them to other students in the class.[52] Professor Williams sued Weisser for infringing on the copyright of his lectures.[53] Weisser's defense was that Professor Williams lacked standing to sue him, since the university, not Professor Williams owned the copyright to his lectures under the work for hire doctrine.[54] The court disagreed with this argument and "found that the student's professor, and not the university the student attended, owned the common law copyright to the professor's lectures."[55] The court based it's ruling on the academic exception precedent established in *Sherrill v. Grieves*.[56] The court's reasoning for not applying the work for hire doctrine was the "University's lack of supervision and control, the absence of a motive for the University to own the copyright, and the 'undesirable consequences' that would flow from granting ownership to the University, e.g., the restraint on a professor's mobility."[57]

Commentators have relied on these two cases to assert "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."[58] The decision in *Williams* is especially important because the "Williams court appears to have recognized that academic tradition, which had always assumed that professors owned the copyrights to their works, was incongruous with copyright law and its attendant work for hire doctrine."[59] The court "conceded that its decision carved out an exception to the general rule" and noted that "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

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48 Lape, *supra* note 34, 235.

49 Simon, *supra* note 28, at fn 5.

50 Williams, 78 Cal. Rptr. at 542, fn 1.

51 *Id.* At 542.

52 VerSteeg, *supra* note 9, at 393.

53 *Id.*

54 *Id.*

55 Simon, *supra* note 28, at fn. 5.

56 57 Wash. L. Rep. 286 (D.C. Cir. 1929).

57 VerStegg, *supra* note 9, at 393. *See also* Willaims, 78 Cal. Rptr. at 546.

58 Lape, *supra* note 34, at 236.

59 VerSteeg, *supra* note 9, at 395.

undesirable consequences."[60] Thus, *Williams* stands for "the proposition that works created by teachers summon forth a 'teacher exception' to the work for hire doctrine." [61]

The next relevant case to the academic exception to work for hire was *Weinstein v. University of Illinois*,[62] which was a 1987 case from the Seventh Circuit of the United States Court of Appeals. The case dealt with the work for hire issue in relation to faculty publishing and was decided by Judge Easterbrook, a former law professor.[63] In Weinstein, Judge Easterbrook held that a professor owned the copyright to his published work because the University of Illinois had adopted "a policy defining 'work for hire' for professors."[64] This policy, which "was incorporated into each professor's contract with the University," stated that "a professor retains the copyright unless the work falls" into one of three specified categories.[65] The third of these categories[66] stated that the university retained the copyright to "works created as a specific requirement of employment or as an assigned duty."[67] The district court[68] had held that Weinstein's work was covered by this paragraph because "the university funded the clerkship program" that the scholarly article was about "and because, as a clinical professor, Weinstein was required to conduct and write about clinical programs."[69] However, Judge Easterbrook ruled that the district court failed to recognize the fact that the three categories from the university policy were exceptions to the "rule that faculty members own the copyrights in their academic work."[70] This is an important statement because it is an explicit judicial recognition of the academic tradition. The appellate court went on to say that when Weinstein was told that he needed to write more scholarly articles to obtain tenure, he was not being told that it was a "requirement or duty" of his job within the meaning of paragraph three of the university copyright policy.[71] Thus, the court held that Weinstein's scholarly writing was not work for hire because his work did

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60 *Id.*

61 *Id.* at 396.

62 811 F.2d 1091 (7th Cir. 1987).

63 Gorman, *supra* note 37, at 267.

64 Weinstein v. University of Illinois, 811 F. 2d 1091, 1094 (7th Cir. 1987).

65 *Id.*

66 This third category is also known as "paragraph three." *See* Weinstein, 811 F.2d at 1094.

67 *Id.*

68 Weinstein v. University of Illinois, 628 F. Supp. 862 (N.D. Ill. 1986).

69 Weinstein, 811 F.2d at 1094.

70 *Id.*

71 *Id.*

not fall under the university copyright policy, but instead fell under the academic exception to the work for hire doctrine.[72]

It is important to note that the Weinstein court looked beyond the employment "contract to incorporate the academic tradition into its terms."[73] The court did this because it found that granting teachers an exception to the work for hire doctrine "has been the academic tradition since copyright law began . . . the tradition covers scholarly articles and other intellectual property."[74] The court added that a professor "who proves a new theorem in the course of his employment will own the copyright to his article containing that proof."[75] Thus, the Weinstein court felt that the common law academic exception to the work for hire doctrine needed to be applied.

There was however one part of the *Weinstein* decision that was not beneficial for professors who want copyright ownership to their scholarly works. This was the court's statement that the work for hire statute is "general enough to make every academic article a 'work for hire' and therefore vest exclusive control in universities rather than scholars."[76] However, the court's explicit recognition that the academic exception for scholarly articles belonging to their authors was still valid after the 1976 Copyright Act, was an important judicial statement.[77]

Judge Easterbrook incorporated the academic tradition into Weinstein's employment contract, thus salvaging the professor's copyright ownership.[78] Looking outside the specific terms of the contract is not new to determinations of copyright ownership. In the case of *May v. Morganelli-Heumann & Associates*,[79] the Ninth Circuit stated that if a practice is known to the parties or widely held, "the custom is an implied in fact term of the contract" between the parties.[80] The Weinstein court relied upon *May* to incorporate professional custom into the disputed contract, by bringing academic tradition into the copyright agreement. The Weinstein court appears to have stretched the *May* holding, because while *May* relied

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72 Smith, *supra* note 42, at 712.

73 Luzum, *supra* note 4, at 374.

74 *Id. See also* M. Nimmer, NIMMER ON COPYRIGHT §5.03 [B] [1] [b] (1978 ed.).

75 Weinstein, 811 F. 2d at, 1094.

76 *Id.* Citing DuBoff, *An Academic's Copyright: Publish or Perish*, 32 J. COPYRIGHT SOC'Y 17 (1984).

77 This same analysis does not apply for patentable professorial creations because universities traditionally have required faculty members in the sciences to assign to their employers the patent rights to their inventions. Thus, the teacher exception does not apply for patents because they are considered work for hire. *See* Dreyfuss, *supra* note 27, at fn. 9.

78 Luzum, *supra* note 4, at 375.

79 618 F.2d 1363 (9th Cir. 1980).

80 Luzum, *supra* note 4, at 375.

on custom in usage in the absence of any specific mention of an agreement to that custom, *Weinstein* looked to academic tradition in spite of a specific provision dealing with the vesting of copyrights that contradicted the academic tradition.[81]

One year after *Weinstein* in 1988, Judge Posner issued a ruling in *Hays v. Sony Corp. of America*[82] that strongly urges the recognition of a "teacher exception" in dicta.[83] Interestingly, Judge Posner, was also a former law professor.[84] The case involved two high school teachers who taught business courses in a public school and who had written a manual explaining how to operate the school's word processors.[85] The Sony Corporation of America "created a manual that incorporated sections of the teachers' original manual verbatim" and thus, the teachers sued Sony for copyright infringement.[86] Judge Posner, writing for the Seventh Circuit, discussed at length the applicability of the work for hire doctrine to works created by school teachers.[87] In this discussion, Judge Posner "commented on but did not decide whether the teacher exception survived under the Act."[88] The reason he only commented instead of offering a holding on the teacher exception was that the issue was not properly before the court, and thus he was unable to make binding law with the case. 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" the revisions to the copyright law.[89] Consequently, this was "persuasive dicta from a federal circuit court which now supports the argument that teachers, not schools, own the copyrights to materials that teachers create.[90]

Even with the academic exception apparently intact because of common law, some commentators believe that Congress eliminated the "exception to the work for hire doctrine when it passed the Copyright Act of 1976."[91] Their argument is that the 1976 Act permits universities to claim copyright to, and even 'authorship' of, their faculty's output.[92] They

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81 *Id.*

82 Hays v. Sony Corp. of America, 847 F.2d 412 (7th Cir. 1988).

83 VerSteeg, *supra* note 9, at 406.

84 Gorman, *supra* note 63, at 267.

85 *See generally* Hays, 847 F.2d at 416.

86 VerSteeg, *supra* note 9, at 403.

87 *Id.*

88 Smith, *supra* note 42, at 712.

89 Lape, *supra* note 34, at 245.

90 VerSteeg, *supra* note 9, at 382.

91 Dreyfuss, *supra* note 27, at 591. *See also* DuBoff, *supra* note 76 and Simon, *supra* note 28.

92 *Id.*

make this claim because "the plain language of the 1976 Act and cases decided thereunder appear to negate Williams as well as to demonstrate that when teachers, or any employees, create copyrightable works pursuant to the duties of their jobs, such are works for hire with the copyrights vesting in the employer."[93] Thus, "scholars have indeed concluded that the 1976 Act abolishes the teacher exception to the work for hire doctrine."[94] The reasoning for this conclusion is that "since the 1976 Act suggests that courts should limit their inquiry to the existence of an employment relationship, employees under long term contracts - such as academics - may no longer argue that the factors surrounding their employment rebut the presumption of employer ownership."[95] Accordingly, "the circumstances under which the work was created and the expectations of the parties have now become largely irrelevant."[96] "The dispositive issue is whether production of scholarly material is 'within the scope of employment,' that is, a part of the job."[97] Some experts feel that "since scholarship clearly is a factor in decisions regarding tenure, promotion, salary increases, sabbatical leaves, and reduced teaching loads, scholarly works should now belong to universities rather than to faculty members."[98]

Although the Weinstein court "relied on academic tradition,"[99] it has been argued that tradition was "apparently not a factor in determining copyright ownership under the 1976 Act."[100] Proponents of this theory believe that, "[t]he 1976 Act effectively preempted state common law of copyright."[101] Because of this, the argument continues that decisions like *Sherrill* and *Williams* are not only "negligible in number and narrow in scope, but they are based on outmoded law."[102] This theory is given credence by the Supreme Court case of *Community for Creative Non-Violence v. Reid* ("CCNV").[103] In that case, "the Court virtually rejected the pre-Act judicial approach to determine a work made for hire."[104] The plaintiff in *CCNV* argued that "[n]owhere in the 1976 Act or in the Act's

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93 VerSteeg, *supra* note 9, at 396-97.

94 Dreyfuss, *supra* note 27, at 598.

95 *Id.* at 599.

96 *Id.*

97 *Id.*

98 *Id.*

99 Burr, *supra* note 7, at 140.

100 *Id. See also* May v. Morganelli Heumann & Assoc., 618 F.2d 1363, 1368 n.4 (9th Cir. 1980); *see also* DuBoff, *supra* note 76, at 33.

101 Burr, *supra* note 7, at 140 *citing* 17 U.S.C. § 301.

102 Burr, *supra* note 7, at 140; *see also* Sherrill v. Grieves, 57 Wash. L. Rep. 286 (D.C. Cir. 1929); *see also* Williams, 78 Cal. Rptr. at 542.

103 Community for Creative Non-Violence v. Reid, 490 U.S. 730, 748 (1989).

104 *Id.* at 730; *see also* Burr, *supra* note 7, at 140.

Legislative history does Congress state that it intended to . . .reject the pre-Act judicial approach to identifying a work for hire employment relationship."[105] However, the Supreme Court disagreed. According to Justice Marshall, author of the court's unanimous opinion, "We are unpersuaded. Ordinarily, 'Congress' silence is just that . . . silence."[106] Accordingly, since "Congress failed to incorporate the 'teacher exception' in the 1976 Act or its legislative history," professors have to face this obstacle in attempting to apply the academic exception to their scholarly works.[107]

However, there are still signs that the academic exception continues to exist. Judge Posner in Hayes disputed "that the 1976 Act abolished the teacher exception" because he argued that if the exception was abolished by Congress, then why was there no discussion of this abolition in the 1976 Act's legislative history?[108] Furthermore, Posner hypothesized that a conclusion that the exception no longer exists "would wreak havoc 'in the settled practices of academic institutions.'"[109] By making this statement, Posner implies that the academic exception for scholarly works is still the standard practice in universities, despite the work for hire doctrine.[110]

Another valid point is that "the language of the work made for hire provisions of the 1976 Act did not preclude the continued existence of an exception for professors."[111] The reasoning for this argument is that "the 1976 act incorporates a definition of employees work made for hire which codified language developed in cases decided under the 1909 act: 'a work prepared by an employee within the scope of his or her employment.'"[112] Thus, the common-law exception for professors from the work for hire doctrine arguably still exists because, "there's nothing in the 1976 Act 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."[113]

Another theory is that, "the legislative history suggests that Congress intended to alter the definition of works for hire with respect to works prepared by independent contractors on special order or commission, but it appears that the definition vis-a-vis employees was meant to remain

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105 Community for Creative Non-Violence, 490 U.S. at 749.

106 *See* Alaska Airlines v. Brock, 480 U.S. 678, 686 (1987).

107 Community for Creative Non-Violence, 490 U.S. at 749.

108 VerSteeg, *supra* note 9, at 404.

109 *Id.*

110 *Id.*

111 Lape, *supra* note 34, at 237.

112 *Id.*

113 *Id.* at 238.

unchanged."[114] This argument continues that the "1976 Act offers no definition for the phrase 'prepared within the scope of his or her employment,' and the legislative history states that this provision constitutes an adoption of the 'present law.'"[115] Another point in defense of the academic exception is that "the assumption follows that Congress intended prior decisions interpreting the work for hire doctrine under the 1909 Act to define the language of the current statute."[116] Additionally it can be argued that "if prior law is the appropriate guide, courts should continue to recognize the *Williams* 'teacher exception' . . ."[117] Thus, it can reasonably be concluded that "the 1976 Act did not disturb the professors' exception from the work made for hire doctrine . . .it continues to exist."[118]

The policy reasons behind giving scholars full rights to the works they create is that it promotes free discussion of ideas for the ultimate goal of academic excellence. "Stripping these rights from authors restricts their incentive to write."[119] Without the common law academic exception, based on academic tradition, professors would have very little legal basis to claim the copyright of their scholarly work. Thus, as Judge Posner in *Hays* explained, the "reasons for a presumption against finding academic writings to be work made for hire are as forceful today as they ever were."[120]

IV. WHETHER PUBLISHING A SCHOLARLY ARTICLE IS WITHIN THE SCOPE OF EMPLOYMENT

Since the adoption of the 1976 Copyright Act, one of the issues which has divided the case law regarding work for hire, has been the definition of the clause "employee within the scope of his or her employment." This clause is from subsection (1) of the work for hire statute.[121] In order for the work for hire doctrine to apply, the work must be prepared by the employee within the scope of his or her employment. The relevance of the clause is that if professors can prove that writing the scholarly article is not within their job duties or within the scope of employment, then an academic exception is not needed because it will not be construed as a work for hire.

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114 VerSteeg, *supra* note 9, at 397.

115 *Id.*

116 *Id.*

117 *Id.* at 398.

118 Lape, *supra* note 34, at 246. This statement was made in 1992, after the Community for Creative Non-Violence case.

119 Luzum, *supra* note 4, at 376.

120 VerSteeg, *supra* note 9, at 404.

121 U.S.C. §101(1).

The decision as to whether the work at issue was produced within the scope of employment will determine who owns the copyright.[122]

By arguing a "narrow construction of 'scope of employment,'"[123] the professor would claim that even though the employer pays the professor's salary, that salary is for teaching and not for writing scholarly articles. Additionally, the professor can argue that the university often has little or no direction, control or supervision over the professor's article and that the professor often generates the ideas, concepts and does the analysis of the work himself.[124] Another point that bolsters this argument is that professors select their own "research goals, procure their own funding, determine their research strategy, and choose the format through which their findings are expressed."[125] Although universities pay faculty salaries, support research, exercise aspects of control over the sorts of scholarship that counts toward advancement, and make library and other facilities available for scholarly pursuits, these activities do not prove that the university was the motivating force behind the work.[126] According to Judge Posner in *Hays*, a "college or university does not supervise its faculty in the preparation of academic books and articles . . ."[127] These arguments lend support to the claim that the university professors work relationship falls under a narrow construction of the term employment and thus work for hire should not apply to them.

The most important factor for determining whether the work is within the scope of employment is determining what is "the employer's right to direct, control, and supervise the employee's work."[128] A certain level of control by the employer exists, since in most universities, "faculty members are expected to publish books or articles within their particular subject area."[129] "Approval of research projects is informal, if necessary at all."[130] Publications are "expected . . . to meet standards of both quality and quantity and occasionally, frequency."[131] In addition, "control and supervision also exist to the extent that the faculty member is required to publish scholarly material in a particular field."[132] Another factor is the

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122 Burr, *supra* note 7, at 140.

123 Luzum, *supra* note 4, at 376.

124 *See generally* Community for Creative Non-Violence v. Reid, 490 U.S. 730 (1989).

125 Dreyfuss, *supra* note 27, at 603.

126 *Id.* at 597.

127 VerSteeg, *supra* note 9, at 404.

128 Simon, *supra* note 28, at 502.

129 *Id.*

130 *Id.*

131 *Id.*

132 *Id.*

quality of "both of the work and of the publication the work appears in."[133] The employment contract also has importance for deciding this issue. Whether the contract contains an express requirement that the faculty member perform research and write scholarly articles is important.[134] Usually, a professor must publish to gain tenure as well . . . every new faculty member knows he must "publish or perish"[135] In addition, claims of employment are bolstered by the fact that universities also bear most of the costs related to scholarly research. These costs "include supplies, offices, personnel, telephones, furniture, computers, research aides and travel fees."[136] Thus, colleges and universities appear to have a strong argument that scholarly writings fit the course of employment tests used to determine if a work is made for hire.[137]

A professor will have difficulty proving that he is an independent contractor due to the strong employment relationship.[138] Thus, most teachers are certainly considered employees. "In legal jargon one would say that a master servant relationship exists between the school and teacher."[139] However, it is not "an easy task to determine precisely what the phrase 'within the scope of his or her employment' means for school teachers."[140] "Where the answer to the employee question is yes, the remaining question is whether the work in question was produced within the scope of employment."[141]

Unfortunately for professors, the court in *Weinstein* acknowledged that a literal reading of the work for hire statute gives ownership of scholarly articles to universities. This occurred when the Weinstein court stated that because "a university 'requires' its scholars to write," the university's "demands—especially the demands of departments deciding whether to award tenure—will be 'the motivating factor in the preparation of' many a scholarly work."[142] Since publication by professors is usually expected by universities "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."[143] The issue hinges upon whether

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133 *Id.*

134 *Id.* at 503.

135 *Id.*

136 *Id.* at 504.

137 *Id.* at 505.

138 For an analysis of whether a professor is an employee or an independent contractor, see Community for Creative Non-Violence v. Reid, 490 U.S. 730 (1989).

139 VerSteeg, *supra* note 9, at 387.

140 *Id.* at 388.

141 Smith, *supra* note 42, at 710.

142 Weinstein v. University of Illinois, 811 F. 2d 1091, 1094 (7th Cir. 1987).

143 Lape, *supra* note 34, at 223.

scholarly works are in fact found to be "publications required as a condition of promotion and tenure and produced during the university contract period."[144] Publications of that type "may be considered within the scope of employment because they are required to fulfill the professor's duties to the university."[145] It does not help the professor's argument that "academics are hired by universities with the understanding that in addition to teaching, they will conduct research, analyze their research, and publish the results of their analysis."[146] Professors are faced with the fact that they must "publish or perish"[147] in order to advance their professional standing. Proponent of this interpretation argue that "scholarly writings and other faculty work products, including the fruits of some externally sponsored research projects, meet the scope of employment test of the Act's made for hire provision . . ."[148] Under this interpretation, academic writings are work for hire.

However, while most universities require scholarly writing, there is room for debate whether particular academic articles, publications outside the academic institution, are actually within the scope of a professor's employment. There may be "scholarly works that fall outside the academician's duties or works that are produced outside of the contract period, and are, therefore, outside the scope of the academician's employment."[149] Some examples of these situations are "works produced by non-tenured faculty members beyond the number needed for promotion and tenure purposes as determined by the university's department, and perhaps all works produced by tenured faculty members that are not a condition for merit raises."[150] Another example is "works that are prepared during the one day a week that universities usually allow for outside work, or works that are prepared during a summer when the faculty member did not receive a research grant."[151]

In 1989, the Supreme Court offered some guidance on the scope of employment issue in the case of *Community for Creative Non-Violence v. Reid.*[152] In this case, CCNV, a non-profit association, commissioned Mr. Reid to create a sculpture. Once the sculpture was complete, both Reid and CCNV claimed to own the copyright to the work of art. CCNV claimed

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144 Burr, *supra* note 7, at 141.

145 *Id.*

146 *Id.* at 119.

147 Weinstein, 811 F. 2d at 1094.

148 Smith, *supra* note 42, at 711.

149 Burr, *supra* note 7, at 142.

150 *Id.*

151 *Id.*

152 Community for Creative Non-Violence v. Reid, 490 U.S. 730, 730 (1989).

copyright under the work for hire doctrine. In contrast, Reid claimed that since he created the work, he was the rightful owner of the copyright. The court held that Reid was the author of the work under the Copyright Act, and that he was not an employee of CCNV since the sculpture was not prepared within the scope of employment. Instead, the court found that Reid was an independent contractor who was able to copyright the work of art.

Although the facts in *CCNV* fall outside the education field, the case is relevant to the scope of employment issue because it has "implications for determining whether the educator is an employee"[153] within the scope of employment. *CCNV* offers thirteen factors for determining when a hired party is an employee or an independent contractor.[154] When these factors are applied to the academic context, the result is difficult to determine. "Scholarly works produced by academics may or may not be considered works for hire because while four of the thirteen factors weigh in favor of the faculty member and four of the factors weigh in favor of the university, the remaining five factors have equities for both sides."[155]

The court in *CCNV* strongly suggests that "Congress intended 'scope of employment' to be defined under the general common law of agency."[156] The Restatement considers work as occurring within the scope of employment when "(a) it is of the kind he is employed to perform; (b) it occurs substantially within the authorized time and space limits; [and] (c) it is actuated, at least in part, by a purpose to serve the [employer]".[157] Thus, the court in *CCNV* suggests another way to interpret the scope of employment clause.

V. WEB PAGE PUBLISHING ISSUES

Scope of employment is also involved when a professor publishes his scholarly work on a university owned web page. One issue is whether the web page is part of the university community or a part of the global Internet? The answer hinges on whether the professor or the university initiates the scholarly work. Another issue is whether the professor's writing is in response to a university's general publication requirement for continued employment. If the writing is due to this requirement, then that will constitute a work for hire, unless the academic exception is in effect.

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153 Smith, *supra* note 42, at 705.

154 Burr, *supra* note 7, at 120.

155 *Id.* at 140.

156 *Id.*

157 RESTATEMENT (SECOND) OF AGENCY §228 (1957).

Another factor to consider is whether the university exercises any editorial control over the published article. The Weinstein court stated that it makes more sense to only give the university a work for hire right in areas such as administrative writings . . . like a university published report for example, but not for scholarly works.[158] But does the fact that the scholarly work is located on the university server bring it further away from the academic exception and closer to a university related writing? It is important to consider whether this article is on a professor's official or unofficial web page, meaning what connection to the university does this page have? These aspects will influence whether the exception will apply. To clarify, an official web page is one created by the university to inform web site visitors about their faculty's accomplishments and qualifications. In contrast, an unofficial web page is one that the professor creates independently, but often is located on the school server, and the professor alone is responsible for all aspects of programming and content selection. The reason this distinction is important has to do with the independence of the scholarly article from the employment relationship. The fact that a professor published an article on his own private web page may not count as work within the scope of his employment.

Whether the professor created his own web page may be of some importance. The academic exception to work for hire may not apply if the professor did not create his own web page, but instead had the university computer department or his secretary create the web page and post the article for him. The involvement of the additional parties to the creation of the work could bring in the aspect of a collective work from the work for hire definition. Also, the work done by the computer department or the secretary would be work for hire, since there is no academic exception for non-faculty members. These facts might give the university a stronger claim on the copyright, assuming these other people involved in the production of the work are university employees.

Also relevant is the issue of whether it would be considered independent publishing for a professor to create an unofficial web page on a school server. If it were considered independent publishing, then the web page and articles published on it would be outside the scope of employment. If the unofficial page falls within the work for hire definition, then it could be considered more like publishing in an internal university bulletin.[159]

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[158] Luzum, *supra* note 4, at 371. *See also* Manasa v. University of Miami, 320 So. 2d 467 (Fla. Dist. Ct. App. 1975) (holding that a university owned the copyright to a funding proposal written by an administrative officer).

[159] Luzum, *supra* note 4, at 371.

Another related issue is that universities usually own their web server. One result of this ownership is that universities often have policies stating that all information and files saved on the server become the property of the university. The key question here would be whether the academic exception for scholarly writings gets around these policies. This question draws comparisons to the Weinstein case, where there was an express copyright policy that the court chose to ignore in favor of the academic exception.

While professors may argue that the creation of their scholarly work is not within the scope of employment, academic writings published on web pages may be construed as within the scope of employment if those articles are being done to meet the scholarship requirements for tenure.[160] Another related problem is that most professors use their employed period of time, the work week, to work on their scholarly articles. This detracts from the argument of the work not being within the scope of employment. Additionally, it can be argued that scholarly writings fall within the course of employment because "aspects of employment, such as availability of resources" point to the idea that scholars are working for hire.[161]

VI. STRATEGIES FOR PROFESSORS TO OBTAIN COPYRIGHTS IN THEIR SCHOLARLY WORKS

While Judge Posner's discussion of the inapplicability of the 1976 Act's work for hire provisions to teachers is dicta, the fact that it is "from a court and jurist as well respected as the Seventh Circuit and Judge Posner will be difficult to ignore."[162] Since Judge Posner's decision in *Hays* is the most recent case directly discussing work for hire and the academic exception, "if a school were to challenge a teacher's claim to copyright in educational materials, *Hays* clearly would be a valuable tool for a teacher claiming ownership under the 'teacher exception' theory."[163] Judge Posner's dicta in *Hays* suggests that if faced directly with the question of the existence of teacher exception under the 1976 Copyright Act, courts would respond that it does in fact exist.[164]

But until that case comes along, professors would be wise to pursue other measures besides the academic exception to secure the copyright to their scholarly works. One suggestion is that "the simplest, most effective way for professors to retain copyright in their scholarly publications is to

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160 Dreyfuss, *supra* note 27, at 599.

161 Simon, *supra* note 28, at 486.

162 VerSteeg, *supra* note 9, at 405.

163 *Id.*

164 *Id.* at 412.

obtain a written agreement expressly reserving those rights, as the Copyright Act requires."[165] "The maximum protection will be obtained by an agreement which states that the faculty member's writings are not considered works made for hire and are not produced in the course of employment."[166] Thus, the professor should attempt to incorporate a claim for the copyright of his writings into his employment contract.[167] The reason that a university might agree to such a clause in an employment contract is that the university's main goal of the "prestige that faculty writings bring" will be upheld regardless of such a clause.[168] On the other hand, that prestige may not be enough for some universities. Some schools have "begun to take a more active interest in the financial dimensions of the faculty's work product, and increasingly they have come to view exploitation of scholarly output as a means of filling the revenue gaps left by shrinking government grants and student tuition payments."[169] Even though "[m]ost scholarly writing is geared to specialized journals which offer little or no payment" to the author,[170] some universities feel that they end up paying twice for research done by their professors.[171] At the California Institute of Technology, Provost Steven E. Koonin argues that his school library spends a large portion of its budget on subscriptions to high-priced, for profit journals that run articles about research by Caltech's own faculty members.[172] Koonin proposes that journal publishers should be told that they can only publish articles by Caltech researchers if the authors and the university retain copyrights to the material.[173] Koonin says he would "like to see Caltech and its faculty members jointly own and retain rights to journal articles and license those copyrights to publishers on a limited basis."[174] This is a perfect example of a university trying to claim a copyright in the professor's work. In a scenario like the one proposed at Caltech, professors may be "risking their chances of publication in respected journals."[175] Professors who obtain an express copyright to their scholarly works in their employment agreement will maintain control of their articles and will be at liberty to protect their own interests,

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165 Simon, *supra* note 28, at 509.

166 *Id.*

167 *See generally* Community for Creative Non-Violence v. Reid, 409 U.S. 730 (1989).

168 Burr, *supra* note 7, at 143.

169 Dreyfuss, *supra* note 27, at 591-92.

170 Simon, *supra* note 28, at 507.

171 Lisa Guernsey, *A Provost Challenges His Faculty to Keep Copyright on Journal Articles*, CHRON. OF HIGHER EDUC., Sept. 18, 1998, at A29.

172 *Id.*

173 *Id.*

174 *Id.*

175 *Id.*

One way for the professor to handle the employment agreement issues is for the professor is to negotiate a clause in his employment contract that states that the university recognizes and agrees to abide by the academic exception to the work for hire doctrine for academic writings. This clear language will resolve any ambiguity that Congress' silence on the issue has caused. The effect of this language will be to rebut the presumption that the employer is the copyright owner.[176]

Another issue that arises is whether a written university copyright policy even "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."[177] In addition, "while many faculty handbooks announce policies favoring faculty retention of copyright, handbooks are unlikely to be considered signed writings" by courts.[178] However, a good strategy for a professor is to expressly incorporate a beneficial handbook copyright policy by reference into a writing signed by the professor and the university.[179] Still, the typical institution of higher education does not have an applicable policy; even for the few who do, the policy is not sufficient unless contained or perhaps incorporated in an agreement signed by both parties.[180] This is relevant to publishing an article on a university web page. The ramifications are that a clause in a university acceptable use policy for university computer systems, which states that files stored on the computer system become the property of the university, appears not to be binding on the professor unless there is an express signed writing between the professor and the university to that effect. Thus, the university can not seize a professor's web page files without an express agreement allowing the school to do so. Conversely, professors should not be soothed by beneficial "statements of policy in various university bylaws, operating guidelines, and regulations."[181] In court, "these documents will not replace an express written agreement and are probably not a formal part of the employment contract."[182]

Professors may also attempt to circumvent the work for hire doctrine by preparing work "under a grant, one time contract or fellowship."[183] These methods may be "considered 'commissioned' under section 101" of

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176 Dreyfuss, *supra* note 27, at 599.

177 Lape, *supra* note 34, at 248.

178 Dreyfuss, *supra* note 27, at 600.

179 *See generally* Dreyfuss, *supra* note 27, at 600. *See also* Weinstein v. University of Illinois, 811 F. 2d 1091, 1094 (7th Cir. 1987).

180 Smith, *supra* note 42, at 711.

181 Simon, *supra* note 28, at 513.

182 *Id.*

183 *Id.* at 510 *citing* 17 U.S.C. §101.

the 1976 Copyright Act "because under that section, a commissioned work may be considered a work made for hire only if expressly agreed by the parties."[184]

VII. CONCLUSION

If a professor does not have an express agreement giving the copyright to himself, and if the academic exception is not applied, then the "professor's best approach in court is to convince the court that the work was not prepared within the course of employment, which may be difficult."[185] Thus, the most prudent course of action is for professors to obtain an express written agreement with the university where he is employed which grants copyright to the professor for his scholarly works, either upon taking an employment position or as soon as practical if already employed. Despite the arguments available to the professor via the dicta of the Seventh Circuit, the most prudent strategy for the professor under the current copyright law is to take affirmative steps to assure copyright control over scholarly writings. By doing this, university faculty best protect their interests. If the professor decides to move from school to school and would like to continue to have control over his writings, this type of agreement is an especially good idea.[186] Additionally, by signing an express agreement, professors will protect their legitimate interests in the recognition achieved by creating original materials, as well as "protecting their interest in reaping whatever financial rewards are available from exploiting their original works in the marketplace."[187] If Congress had specifically incorporated the "teacher exception" into the 1976 Copyright Act or in its legislative history, then this type of express agreement would not be necessary to protect the professor's rights. But since Congress did not expressly consider "the effect of the new statute on environments like universities" and codify the 'teacher' exception' into the 1976 Act, professors must rely on dicta or express agreements to secure their creative rights.[188] Therefore, while professors may prevail without an express agreement, it is the most prudent course of action to protect a professor's copyright rights in his scholarly articles.

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184 Simon, *supra* note 28, at 510.

185 *Id.*

186 VerSteeg, *supra* note 9, at 409-10.

187 *Id.* at 410.

188 Dreyfuss, *supra* note 27, at 639.