

YOURS, MINE, OR OURS?: AN ANALYSIS OF FACULTY INTELLECTUAL PROPERTY UNDER THE WORKS-FOR-HIRE DOCTRINE

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ABSTRACT

This article traces the development of the Works for Hire Doctrine through case law under the 1909 Copyright Act, legislative history and the 1976 Copyright Act. Although case law under the 1976 Act has been sparse, the author analyzes case law and other writings to discuss ownership rights for faculty works. Various methods of protection for private and public sector faculty members as well as union and non-union faculty are analyzed and the author provides advice for future protection of faculty intellectual property.

For decades a debate has raged over ownership of faculty intellectual property such as lectures, written works, performances, inventions, and the like. The universities, as employers, have argued that faculty members research and write within the scope of their employment. Faculty members rebut this presumption by asserting that although their research assists them in obtaining tenure and promotion, the work belongs to them.

This article reviews the development of the work for hire doctrine under the 1909 Copyright Act through case law, the legislative history of the 1976 Copyright Act, the 1976 Act itself, and case law under the current statute, including the concepts of scope of employment and agency law. The author analyzes these developments in this article and applies them to faculty works.

Speculation on the direction the courts will proceed in deciding the ownership of faculty research and publications and methods of faculty protection are discussed. After analyzing the effect of collective bargaining agreements on the works-for-hire doctrine, the author offers suggestions to faculty organizations when negotiating later contracts. Finally, the author examines the effect of this doctrine on faculty members in Pennsylvania.

The Constitution provides that Congress shall have the power “to promote the progress of Science and the Useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries” [1]. Beginning with the first Congress, statutes have existed protecting authors and inventors. However, the act of Congress on March 4, 1909 represents the earliest congressional pronouncement important to today’s copyright practitioner [2]. The 1909 Copyright Act [3] was superseded in toto by the 1976 Copyright Act [4], which was effective January 1, 1978. The 1976 Act was amended when President George Bush signed the Berne Convention amendments on March 1, 1989, which is the preeminent international treaty on copyright. The Berne amendments are of little or no significance to the issues discussed in this article.

THE 1909 ACT

The 1909 Act contained no definition of a work made for hire, but it did vest ownership of copyrightable works in the employer under the definition of author. Section 26 provided that the term “author” included the employer in the case of works made for hire [5]. It was left to the courts to determine, through case law, a definition of “works made for hire.” The court first had to determine that an employment relationship existed. The amount of supervision and direction was probative of this relationship. This theory of employer ownership even preceded the 1909 Act. In the *Bleistein v. Donaldson Lithographing Co.* decision, the Supreme Court held that ownership of the designs on lithographs belonged to the employer, as they were created by persons employed by the company that created the designs [6]. The employer–employee relationship was not the major issue of *Bleistein*; however, the Court relied heavily on a master and servant relationship to prove that the design originated in the plaintiff’s studios.

The constitutionality of Section 26 of the 1909 Act was never challenged, although Judge Friendly severely criticized the constitutionality of that section. In the Second Circuit’s decision in *Scherr v. Universal Match Corp.*, he dissented. The court held in *Scherr* that ownership of the work rested with the employer as the author because the creators were employees under the direct control and supervision of the employer. Friendly’s dissent noted that the Constitution authorized only enactment of legislation securing protection only to authors. He stated, “It would be thus quite doubtful that Congress could grant employers the exclusive right to the writings of employees regardless of the circumstances” [7].

Judge Friendly’s analysis is predicated on the argument that an employer cannot, by definition, be regarded as author and claim copyright in the absence of an assignment from his author–employee. Friendly believed Congress had created a legal fiction regarding an employer as the author. Prior to Friendly’s dissent in *Scherr*, the courts had held under the 1909 Act there was an implied assignment from the employer–author to the employer. Absent an agreement to the contrary,

a rebuttable presumption existed that the copyright was to be assigned to the employer [8].

The linchpin issue for the courts under the 1909 Act was whether the work was produced within the employee's scope of employment. The courts applied a two-part test to resolve this issue. First, the court had to determine the employee's duties. Second, the court had to determine whether the work was created within those duties. This test was identified in *Public Affairs Associates v. Rickover*. Vice Admiral Hyman Rickover gave a series of speeches that were held to be his property and not that of the United States government.

The District Court in *Rickover* stated that copyright works that arise out of employees' official actions are not necessarily works for hire when creating the work in question is not part of the employee's official duties. The court further stated that no one sells or mortgages the products of his brain to his employer by the mere fact of his employment [9].

COPYRIGHT REFORM

Copyright reform began nearly twenty years before the 1976 Act. In 1958, a study was conducted by the staff of the Senate Committee on the Judiciary [10]. The 1909 Act did not define the terms "employee," "independent contractor," or "work for hire." All of these terms had been defined by the courts and had caused splits among the circuits. This study, called the Varmer Study, examined the judicial treatment of employees and independent contractors under the 1909 Act. The study concluded that courts treated employees differently from independent contractors. The works-for-hire doctrine was applied to employees, but not to independent contractors, who were treated under the common law of agency. The Varmer Study also concluded that case law had interpreted the works-for-hire provision to apply to salaried employment [10, p. 130].

The Registrar of Copyrights produced a report three years later which agreed that works for hire excluded commissioned works. The Registrar also stated that the works-for-hire doctrine applied to regular employees [11]. There was strong opposition to the Registrar's report by the motion picture representatives. The motion picture producers believed the employer should be the author and the term "regular" employee might limit the employer's ability to claim authorship, as it excluded temporary, short-term employees [12].

A preliminary draft of a new statute was prepared by the Copyright Office in 1963 as a basis for further debate. The draft gave author status to employees and copyright ownership to the employer, but allowed the parties to contractually transfer ownership rights back to the employee. The works-for-hire definition excluded commissioned works. The Copyright Office convened a series of eight meetings with a panel of consultants. Much of the criticism centered on the preemptive effect of the draft on state common law copyright. The draft attached copyright protection at the time the work was fixed in a tangible medium, not

when it was published under state common law. This drastic change from the 1909 Act would override the presumption of implied assignment to the employer. Additionally, the employer continued to be denied ownership of commissioned works. Suggestions were made to add the concept of master-servant relationship under agency law for commissioned works, but the registrar rejected the idea [12, pp. 677-80].

A year later a revision bill was introduced in both Houses of Congress. It contained a new works-for-hire definition that included specially commissioned works, if both parties agreed in writing that it was a work made for hire. This bill drew criticism from the agents of authors because the hiring parties had superior bargaining power. Negotiations between the House and Senate broke down [12, p. 681].

In 1965, a historic compromise was reached. The new bill included categories of commissioned works as works for hire if both parties agreed in writing. The Copyright Office developed four categories of commissioned works:

1. contributions to collective works
2. parts of motion pictures
3. translations
4. supplementary works [12, pp. 681-82]

In 1966, the House Committee on the Judiciary added four additional categories:

1. compilations
2. instructional tests
3. texts
4. atlases [12, p. 682]

These eight categories became section 101 of the 1976 Copyright Act with one addition. The category of answer materials for a test was added at the passage of the 1976 Act. There was no extensive debate in Congress on the works-for-hire provisions between 1965 and 1976 [12, p. 684].

One of the first breakthroughs for commissioned works as works for hire was a decision by the Second Circuit Court in 1966. In its *Brattleboro Publishing Co. v. Windmill Publishing Corp.* decision, the court applied the works-for-hire doctrine to an independent contractor [13]. A merchant hired a local newspaper to create and run an advertisement for his business. The newspaper claimed ownership of the copyright, but the court held that absent an agreement to the contrary, the hiring party of a commissioned work owned the copyright. The court placed great weight on the fact that the work was done at the insistence and expense of the merchant, which was consistent with case law as it applied to employees.

Three years later the Second Circuit issues its *Scherr* decision [7]. In *Scherr*, two former servicemen sued the Universal Match Corporation for copyright infringement. Universal had printed and sold match books bearing a picture of a statue created by the plaintiffs, Scherr and Goodman, during their service in the military.

Plaintiffs were assigned to Fort Dix, New Jersey, as illustrators for visual training aids for the Army. In their leisure time, they worked on a clay model of an infantryman. An Army public relations officer saw the model and suggested that the plaintiffs make a larger statue for the base. The base commander agreed the statue could be a symbol of Fort Dix.

For the next nine months, plaintiffs were relieved of their regular duties to create the statue. All costs, materials, and equipment were borne by the Army. Even the title, "The Ultimate Warrior," was chosen by the Army. Plaintiffs were completely accountable to military supervisors during the project.

The statue, which remained at Fort Dix, differed from the clay model. The plaintiffs never attempted to copyright the clay model, but they did register the copyright for the statue some three months after the unveiling.

The United States government intervened in the plaintiffs' suit against Universal as a defendant and requested assignment of the copyright, if the court would hold that the plaintiffs had one. It conceded that it had permitted Universal to use the picture without payment to the government. The district court granted defendant's summary judgment motions.

The Second Circuit held that the United States government owned the copyright to the statue because it was created during the course of plaintiffs' employment. The court stated that section 26 of the Copyright Act created a rebuttable presumption that the employer was the author of a work made for hire. It held that the plaintiffs had not presented sufficient evidence to the contrary to rebut the presumption [7, at 500].

In ruling on the issue of scope of employment, the court held that the essential factor was the degree of control the employer had over the employee. Other factors considered were whose time, expenses, and facilities were used. The nature and the amount of compensation were minor factors; the evidence favored the employer [7, at 500-01].

In his famous dissent discussed earlier, Judge Friendly argued that section 26 must be narrowly construed to meet constitutional muster. Since the Constitution gave authors the "exclusive right" to the work, Congress' legal fiction of the employer as author would render the term "author," as used in the Act, meaningless. Judge Friendly stated that the factors discussed by the court should create an implied assignment of the copyright to the employer. Without such an implied assignment, an employer could not constitutionally claim ownership rights to the copyright [7, at 502]. The drafters of the 1976 Act, and the courts that would interpret it, later looked to Judge Friendly's opinion for guidance.

THE 1976 ACT

For this analysis of the works-for-hire doctrine, the relevant statute is the 1976 Copyright Act, passed on October 19, 1976. As previously stated, section 101 of the Act contains a definition of a work made for hire:

- (1) A work prepared by an employee within the scope of his or her employment; or
- (2) a work specially ordered or commissioned for use . . . if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire [14].

The remainder of paragraph (2) above contains the eight enumerated categories from the 1966 bill, plus the added category of answer materials for a test. In addition, section 201(b) of the 1976 Act states:

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 [15].

It would appear that section 201(b) of the 1976 Act passes constitutional muster under Judge Friendly's test. The definition of author no longer includes the employer. The employee is the author, but section 201(b) simply assigns the ownership of the copyright to the employer, absent a written, signed agreement to the contrary. The implied assignment desired by Judge Friendly had been accomplished.

The legislative history of the 1976 Act stated that it indeed was a carefully balanced compromise under the works-made-for-hire provision. The new act did not incorporate the amendments proposed by the screenwriters and composers for a "shop right" similar to patent law. These amendments may have improved the bargaining of writers and others in the motion picture industry; however, the practical benefits of the proposals are highly conjectural. The principle of ownership in the employer for works made for hire is well-established in American copyright law, and that principle should not be exchanged for a "shop right" [16].

SCOPE OF EMPLOYMENT

Despite the lengthy debates over the years in Congress, the 1976 Act still left terms undefined and subject to judicial interpretation. The 1976 Act failed to define either "employee" or "scope of employment." Without statutory guidance on these terms, courts continued to look to case law decided under the 1909 Act. The Fifth Circuit, in 1978, held that the crucial element in deciding ownership was whether the work was created at the employer's insistence and expense. The employer induced the creation and was the motivating factor. Finally, the court added that another factor considered was that the employer had the right to direct and supervise the work. The actual exercise of this right by the employer was not controlling [17]. The Ninth Circuit implied a term of contract for an architect by

the custom and usage of the profession. The widely held practice of ownership of designs by the employer became an implied in-fact term of contract [18]. In dealing with commissioned works, one court held that only works which fall under one of the statutory categories set forth in the Act is a work made for hire [19].

It would be a dramatic understatement to conclude that the courts were confused over the lack of definition of “employee” and “scope of employment” in the Act. Under the works-for-hire doctrine, the only clear change appeared to be the inclusion of limited commissioned works under the doctrine, but no clear guidance was provided to identify the employee from an independent contractor. In the early days after the passage of the 1976 Act, there appeared to be no significant changes in the interpretation of the works-for-hire doctrine from the case law under the 1909 Act. Courts looked to the degree of control over the author by the “employer” and any express or implied contractual agreements between them, but it appeared that everyone had his/her own ideas of what constituted the scope of employment. One district court even held that research conducted outside of normal working hours at facilities other than that of the employer was a work for hire owned by the employer [20].

The plaintiff in the *Marshall v. Miles Laboratories, Inc.* decision was hired as a laboratory researcher. His job description stated he was to develop, summarize, and report information about advances in research [20, at 1327]. Marshall requested permission pursuant to company policy to publish the abstracts of his research, but resigned over an unrelated dispute with his employer before the approval was granted or the abstract was completed. The court held it must look at the job description and employment contract to define what is in the scope of employment; the simple fact that work was done outside of normal working hours, or in a facility not owned by the employer, does not escape the work-for-hire doctrine. Here, the employer controlled and supervised the creation, the evidence being the policy requiring employer approval of the abstract before publication of the research conducted at Miles [20, at 1330-31].

Legal scholars also expressed their opinions on the subject of scope of employment. Melville Nimmer, one of the premier authorities on copyright law, believed the 1976 Act changed nothing from the 1909 Act for employees. He stated that the 1976 Act merely added nine categories of works by independent contractors under works for hire. In Nimmer’s opinion, no definition of “prepared within the scope of his or her employment” was necessary in the 1976 Act because it had been defined by case law under the 1990 Act. He then cited the *Scherr* [7], *Rickover* [9], and *Sawyer* [21] decisions as support of his theory. Nimmer believed that courts should use the general principles of agency law and prior decisions establishing a substantial body of law under tort law to determine scope of employment under the 1976 Act [22].

Writing in the *Iowa Law Review* [23], Russ VerSteege quoted from the treatise of Proser and Keeton on Torts. Proser wrote on scope of employment:

The servant's conduct is within the scope of employment if it is of the kind which he is employed to perform, occurs substantially within authorized limits of time and space, and is activated, at least in part, by a purpose to serve the master [23, p. 400].

VerSteeg also cited the Restatement of Agency, section 229(1) for support [23, 24]. To be within the scope of employment, the conduct must be of the same general nature as that authorized or incidental to the conduct authorized by the employer. For example, educational materials prepared by teachers for the school district fall under section 229(1) [23, p. 399]. It was the opinion of VerSteeg that courts should use the cases interpreting the work-for-hire provisions of the 1909 Act, as well as case law construing the term "within scope of employment" in tort and agency law when interpreting the 1976 Act's works-for-hire provisions [23, p. 400].

Many legal scholars urged courts to apply the principles of agency law to determine scope of employment. The Restatement of Agency defines the employee-servant as follows:

(1) A servant is a person employed to perform services in the affairs of another and who with respect to the physical conduct in the performance of the services is subject to the other's control or right to control.

(2) In determining whether one acting for another is a servant or an independent contractor, the following matters of fact, among others, are considered:

(a) the extent of control which, by the agreement, the master may exercise over the details of the work;

(b) whether or not the one employed is engaged in a distinct occupation or business;

(c) the kind of occupation, with reference to whether, in the locality, the work is usually done under the direction of the employer or by a specialist without supervision;

(d) the skill required in the particular occupation;

(e) whether the employer or the workman supplies the instrumentalities, tools, and the place of work for the person doing the work;

(f) the length of time for which the person is employed;

(g) the method of payment, whether by the time or by the job;

(h) whether or not the work is part of the regular business of the employer;

(i) whether or not the parties believe they are creating the relation of master and servant; and

(j) whether the principal is or is not in business [24, § 220].

Despite the position of a number of prominent legal scholars, including Nimmer, the circuit courts were split on determining what constituted the scope of employment. There were four different tests developed under the 1976 Act.

The first two tests are ones that looked very similar to analyses of scope of employment cases under the 1909 Act. These tests analyze the degree of control by the employer over the employee. One school of thought preferred to examine the actual control over the employee, while the other examined the right of the employer to control the employee regardless of how much actual control was exercised.

The Second Circuit court announced its actual control test in its *Aldon Accessories v. Spiegel, Inc.* decision. In *Aldon*, an artist who was not a regular salaried employee was ruled an employee under the works-for-hire provision when operating under the direct supervision and direction of the hiring party. An independent contractor may be subject to the works-for-hire doctrine when the hiring party holds control over the creation of the work [25]. The right-to-control test was developed in the *Peregrine v. Lauren Corp.* decision. In this decision, the district court held the advertising agency owned the copyright of photographs taken by a free-lance photographer because the agency retained the right to control the work. Similar to *Aldon*, a work-for-hire relationship existed because the employer initiated the project and maintained the right to direct and supervise the project [26].

The Ninth Circuit applied a traditional employee test when it decided the case of *Dumas v. Gommerman*. It held that a nonsalaried artist who prepared scenes of lithographs was not an employee of the hiring party under the works-for-hire doctrine, regardless of the degree of control by the hiring party. The court stated the 1976 Act favored predictability and it replaced the old common law tests with a new, clear delineation between employees and independent contractors. Only formal, salaried employees were covered by paragraph (1) under the works-made-for-hire definition of section 101 of the 1976 Act [27].

The Fifth Circuit took the rationale of *Dumas* one step further. In 1987, it decided *Easter Seal Society v. Playboy Enterprises*, which held that paragraph (1) under the works-made-for-hire definition applied only to employees. Independent contractors were covered by paragraph (2) and only if the commissioned work was one of the nine categories listed in that paragraph. The right to control the work could not bring a commissioned work under the works-for-hire doctrine unless it was specified in the statute. The Restatement of Agency should determine employee status under the 1976 Act [28].

By 1989, most courts were either following the *Aldon* test of the Second Circuit or the *Easter Seals* test of the Fifth Circuit. It was at this point that the United States Supreme Court had seen enough of the split among the circuits and decided to hear an appeal from the District of Columbia Circuit in *Community for Creative Non-Violence v. Reid*. The Court, in a unanimous decision, rejected the *Aldon* control test and held that the agency law test of *Easter Seals* was the proper standard to determine employee status [29].

The Community for Creative Non-Violence (CCNV) commissioned Reid to make a sculpture depicting the plight of the homeless. Reid used his own studio

and supplies to create, but he had considerable input from the hiring party. Reid had no signed contract and there was no prior discussion of the copyright. Both parties claimed copyright ownership of the work. The district court held for CCNV under the works-for-hire provision. Reid was deemed to be an employee under paragraph (1). The court of appeals reversed and held Reid not to be an employee under agency law. The Supreme Court held Reid to be an independent contractor and, therefore, not subject to the works-for-hire doctrine, since sculptures were not identified in paragraph (2) of the definition.

In affirming the court of appeals, the Supreme Court noted that since the 1976 Act did not define employee, it had to assess the language, structure, purpose, and legislative history of the act to determine its application. The Court stated that the language of section 101 clearly creates a dichotomy between employee and independent contractor that makes the terms mutually exclusive. The Court also noted the legislative history revealed the language was a product of negotiation among industry representatives and was extensively supervised by the Copyright Office and Congress. The negotiators and Congress also viewed employees and independent contractors as separate entities.

As for the nine categories of commissioned works identified in section 101, the Court held that they would be the only categories of commissioned works that would be considered to be works for hire. These categories of works are prepared at the direction of the publisher or producer who bears the economic risk of production, and therefore, should be the owner of the work.

In other statutes, the term employee refers to a conventional master and servant relationship under agency law. The *Reid* Court saw no reason to interpret employee any other way in the 1976 Act. The Court noted the next of the Act does not state that it should be interpreted otherwise. Scope of employment is also a term of art in agency law. The Court noted a great body of common law of agency that defines scope of employment. The use of this term reinforced the rationale that employee status should be determined under agency law principles. The court also listed a number of factors to examine to determine whether an employer-employee relationship existed:

1. skill required for job;
2. source of instrumentalities and tools;
3. location of work;
4. duration of relationship between parties;
5. hiring party's right to assign additional work;
6. extent of discretion of hiring party over when and how long to work;
7. method of payment;
8. hiring party's role in hiring and paying of assistants;
9. regular business of hiring party;
10. employee benefits;
11. tax treatment of hired party.

The Court noted that these factors are to be used as a balancing test, not as a checklist.

The control tests of *Aldon* and *Peregrine* were soundly rejected by the *Reid* decision, as they ignore the dichotomy of the works-made-for-hire provision of section 101. The second paragraph would be superfluous under such tests because all works under that paragraph would be works for hire under the control test for employees. The actual control test impedes the paramount goal in revising copyright law, which is enhancing the predictability and certainty of ownership. Under the actual control test, the amount of control could not be determined until the work was completed, or at least not until very late in the process. The goal of planning and appropriately contracting for ownership rights in advance would be defeated because the amount of control would not necessarily be known at the time of contracts [12, pp. 691-95].

It appears that after the *Reid* decision, courts should consider the copyright cases interpreting the works-made-for-hire provisions of the 1909 Act as well as case law construing the term “scope of employment” under tort and agency law when interpreting the works-made-for-hire provisions of the 1976 Act [23, p. 400]. Although the *Reid* Court took great pains to list a number of factors to be considered in determining an employer–employee relationship under agency law, it gave little guidance on the interpretation of the term “scope of employment,” other than the use of the common law of agency. Perhaps the Court desired to give the trial courts great flexibility to determine what works were created within the scope of employment, or perhaps the Court did not address that issue because *Reid* was held to be an independent contractor, or perhaps the Court was simply careless. One will never know. One thing we do know is that the trial and appellate courts will have a wide range of common law to draw from in deciding whether works are within the scope of employment. This wide range is exactly the problem confronting the courts that examine faculty intellectual property.

THE TEACHER EXCEPTION

The discussion of faculty intellectual property ownership should begin with a definition of intellectual property. One writer stated that intellectual property is the product of people’s thoughts and minds. The ideas that are translated into writings, communications, documents, and tangible things constitute one’s intellectual property [30].

The case law regarding faculty works is scarce. The first American case addressing this issue was a 1929 case, *Sherrill v. Grieves*, which held that professors have a copyright to their works [31]. Sherrill was an instructor who taught military sketching, map reading, and surveying to United States Army officers. He prepared and wrote a textbook on these subjects. Prior to publication, he allowed the United States military authorities to print a pamphlet incorporating the section on military sketching. When the defendants published an infringing work, they

argued that Sherrill's book was a work for hire and that he did not own the copyright. The court held that Sherrill was simply hired to teach. He was not obligated to put his lectures into writing and, therefore, he owned the copyright to his textbook [31, p. 687].

Forty years later, the California Court of Appeals decided *Williams v. Weiser* [32]. Williams was a professor of anthropology at the University of California at Los Angeles. Weiser's company hired one of Williams' students to take copious notes of his lectures. Weiser published the notes and sold them to other students of Williams. Williams sued for copyright infringement of his lectures. In his defense, Weiser argued that Williams' lectures were works for hire because he was employed by the university to teach. Weiser argued that Williams lacked standing because the university owned the copyright as the employer.

The court based its decision not so much on the copyright law, but on custom. The court held that university faculty are *sui generis* and based its decision on three factors.

First, the court held that the university lacked control over the supervision and direction of Williams' lectures. It noted that under the concept of academic freedom, the university could not dictate the manner in which the professor expressed his ideas. Second, the record did not suggest that the university had any motive to own the copyright to his lectures. Third, neither the record nor custom suggests that any restraint should be placed on a professor's mobility [32, at 734].

Judge Kaus' decision stated that custom has shown that no university wishes to prescribe the way a professor should express his ideas before the students, nor would a university wish to retain ownership of his expression. That expression would be useless if Williams moved on to teach elsewhere. Judge Kaus also noted that it would be unreasonable to restrain a faculty member's mobility:

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. Professors are a peripatetic lot, moving from campus to campus. The courses they teach begin to take shape at one institution and are developed and embellished at another. That, as a matter of fact, was the case here. Plaintiff testified that the notes on which his lectures were based were derived from a similar course which he had given at another university. If defendant is correct, there must be some rights of that school which were infringed at UCLA. Further, should plaintiff leave UCLA and give a substantially similar course at his next post, UCLA would be able to enjoin him from using the material which according to defendant, it owns [32, at 734-35].

It certainly appears that the trial court was attempting to identify with Judge Friendly's standard in the *Scherr* dissent that an implied contract existed in a university setting between the university and its faculty. The reader should keep in mind the fact that *Williams* was decided under the 1909 Copyright Act. The court of appeals held there was no implied contract between Williams and UCLA.

Williams owned a common law copyright as a matter of law absent an agreement to the contrary. The lectures to the class did not constitute a general publication to divest plaintiff of his copyright. The court held that class lectures are limited publications because they are given to a select group. Even though he cited only one American case, *Sherrill v. Grieves*, for support, Judge Kaus cited a number of English cases to support the proposition that faculty own the copyright to their works [33].

The first faculty copyright decision under the 1976 Act was decided by the Seventh Circuit in 1987. The decision of *Weinstein v. University of Illinois* held that a “publish or perish” order by a university does not mean that the publication becomes a work for hire under copyright law [34]. Plaintiff Marvin Weinstein was hired by the University of Illinois, a public institution, in 1980 in the pharmacy administration program. He received two unfavorable reviews citing his failure to publish. His contract was extended until August 31, 1985. The university suggested he write an article to chronicle the results of its pharmacy clerkship program and agreed to provide some funding. The project was undertaken along with two other faculty members, Belsheim and Hutchinson. A dispute arose among the authors, and the university attempted to mediate. It urged that the article be published. In July 1985, Belsheim published his own version. Weinstein’s contract expired and he sued the university and his two former coauthors alleging, *inter alia*, copyright infringement.

The district court dismissed the suit on a failure to state a claim [35]. On appeal, Judge Easterbrook wrote the decision for the court. Weinstein had a contract that vested copyright ownership in his works to him and gave ownership to the university for works under the university’s direction. Despite this fact, the court of appeals relied on academic tradition, which provided ownership to the faculty for their scholarly works. Perhaps this decision is based upon the fact that Easterbrook himself is a professor of law.

When reading Judge Easterbrook’s decision, one would believe that his discussion is leading up to a holding for the university. He discussed the language of the 1976 Copyright Act and stated the statute is general enough to make all faculty writing works for hire because writing and research are universal requirements for faculty. Easterbrook stated the language implies all academic articles are works for hire and vests exclusive control in the universities. The parties must agree to give the faculty member ownership in the work by a written agreement. The parties did contract to give ownership to Weinstein, except for those works under the university’s direction, which appears to be the case here, since it suggested the article and provided some funding.

After stating the court’s interpretation of the works-for-hire provision of section 101 and section 201(b) and noting the contractual agreement that appeared to comply with the statute, Easterbrook dropped the bomb. Despite the legal analysis and the facts favoring the university, the court held professors must rely on academic tradition and not the works-for-hire doctrine to protect their works.

Easterbrook stated that any other interpretation by the court would deny faculty authors the fruits of their labor and would leave no incentive for research. The court noted Weinstein initiated the work in response to a general publication request and even though the university provided funding, Weinstein was free to choose any subject for his work. Also cited as factors were the facts that the university exercised no editorial control, nor did it publish the article. The article was published by the *American Journal of Pharmacy Education* [34, at 1094-95].

It is obvious that the court went beyond the university's copyright policy and the clear language of the statute to render its decision on "academic tradition" to award ownership to Weinstein. Easterbrook's opinion sounds much like Kaus' *sui generis* rationale for faculty in his *Williams* decision. It appears the court approached the decision from the wrong direction, which had caused much confusion. Rather than ruling that ownership vested with Weinstein because his writing was not within his scope of employment, the court simply disregarded the statute and employment contract and ruled on the "academic tradition". This decision provides little security and much unpredictability for future cases involving faculty publications. The universities have no idea what express language to place in contracts because the University of Illinois had very explicit language on ownership in Weinstein's contract but still lost the case. Faculty are confused because despite Weinstein's victory on the ownership issue [36], much of the court's analysis supports the concept of faculty publications being considered works for hire [37].

One year later, the Seventh Circuit decided *Hays v. Sony Corp. of America* with another professor of law, Judge Posner, authoring the decision [38]. It was not the actual decision, but Posner's dicta that received the publicity. Although the plaintiffs lost their appeal, Posner stated there was a "teacher exception" to the works-for-hire doctrine [38, at 416].

Plaintiffs Stephanie Hays and Gail MacDonald were public school business teachers at Des Plaines, Illinois. They prepared a manual in 1983 for students on how to operate the school's word processors. One year later, the school purchased Sony word processors and gave Sony the plaintiffs' manual for modification. The Sony manual was very similar to, and in some places, verbatim with the plaintiffs' manual. In February 1985, plaintiffs registered their copyright and filed suit against Sony for copyright infringement.

The court held that plaintiffs had no standing to bring suit, as the common law copyright was abolished by the 1976 Act and plaintiffs had no damages since Sony neither sold the manual to the school nor marketed it to the general public. The court of appeals was asked to consider Rule Eleven sanctions against plaintiffs' counsel for a frivolous suit. Writing for the court, Judge Posner stated that an infringement of a statutory copyright is not a frivolous claim [38, at 415].

Posner noted that some courts had adopted a "teacher exception" prior to the 1976 Act, noting an article from Professor Rochelle Dreyfuss on the subject [39].

He noted that authority on the subject was scanty, not because the exception was doubted, but because virtually no one questioned that the academic author was entitled to copyright his/her writings. Posner stated it is a universal assumption and practice that, absent an agreement to the contrary, the teacher owned the copyright, not the college or university. The teacher owned the copyright even though writing and research are part of his or her employment responsibilities and the teacher uses the employer's paper, copier, secretarial staff, and computers. There are good reasons for this belief. The college or university does not supervise its faculty in the preparation of academic books and articles, and is poorly equipped to exploit their writings. We may set aside cases where a school district directs teachers to prepare teaching materials and then directs other teachers in the districts to use them [38, at 416].

Posner further stated it was widely believed that the 1976 Act abolished the teacher exception, but there is no discussion of it in the legislative history of the Act. A literalist of statutory interpretation might say the 1976 Act abolished this exception. Considering the havoc such a conclusion would wreak on the settled practices of academic institutions, the lack of a fit between works for hire and conditions of academic production, and the absence of any indication that Congress meant to abolish the teacher exception, we might, if forced to decide the issue, conclude the exception survived the 1976 Act [36, at 416]. Posner also stated the academic writing would not be a work prepared *for* the employer under section 201(b) and, therefore, would not become a work for hire despite the writing and research requirements of faculty [38, at 416].

Hays does not overrule *Weinstein*, but it certainly must be considered along with it. The rationale of Judge Posner has much more legal support than that of Judge Easterbrook [46]. Posner looked to the legislative history and language of the 1976 Act for his support, in contrast to Easterbrook's "academic tradition." Critics of Posner's opinion state that it is only dicta and not the holding. One must note, however, that it is dicta from Judge Posner, a respected legal scholar and often-discussed candidate for the U.S. Supreme Court, and it is a Seventh Circuit decision, which is a very respected court. It must also be noted that the Seventh Circuit appears to be reversing itself from its *Weinstein* decision, and if the issue arises, would hold that a "teacher exception" does indeed exist.

Posner's theory was that since the legislative history for the 1976 Act stated that "prepared within the scope of employment" constitutes an adaptation of the present law, the case law under the 1909 Act is still good law [23, p. 382]. It is ironic that Posner borrowed the "teacher exception" phrase from a law review article by Professor Rochelle Dreyfuss in the *University of Chicago Law Review*. Dreyfuss obtained the phrase from a footnote by Judge Duffy in his *Clarkstown v. Reeder* decision [23, p. 403]. The footnote by Judge Duffy was a note rejecting the argument of the defendant in *Clarkstown* that he was a teacher [41]. Keeping in mind that the Constitution states that it is promoting the progress of science and the useful arts, there should be a teacher exception because many faculty create,

not so much for financial gain, but for educational objectives, and for satisfaction and pride. The lack of a teacher exception could have a dramatic chilling effect on faculty writings and research [23, p. 407]. Vesting ownership in the university could destroy a faculty member's mobility, as Judge Kaus stated in *Williams*.

Not all ownership should go to the teacher, as there are some tasks that the school district requires them to do that should be the employer's property. Awarding all ownership to the teacher may deprive the employer of the benefit of works created within the teacher's scope of employment that the employer directed. For example, the set construction or art work for a school play done by an art teacher may be a work for hire. If there is a teacher exception, it should not be a blanket one. It would be dangerous to vest complete ownership in either teacher or employer [23, pp. 408-9]. The courts must balance the interests in creativity and mobility and the fruits of labor for the faculty against the interests of the college or university in collegiality, free flow of access to information, creative educational materials, and prestige [23, p. 410].

In the article from which Judge Posner borrowed the "teacher exception" term, Professor Dreyfuss noted that creative production does not always equal other types of production. The focus should not be on the pecuniary benefit of copyright, but that the public interest in creative enterprises depends on the quality of the works themselves [39, p. 59]. The academic community is dedicated mainly to the pursuit of knowledge. If the copyright's sole consequence is protection of the creator's ability to earn profit from it, the works-for-hire doctrine should have little effect on the quantity, quality, or mix of scholarly output. If the output does change when universities assert ownership, then copyright protects interests beyond financial gain. It protects the quality and integrity of scholarly works [39, pp. 592-93].

Opponents of the "teacher exception" argue that the publish or perish standard for tenure makes faculty research and publications works for hire. Those scholars also believe that tenured faculty publish for other benefits such as promotion, salary raises, merit pay, released time for research, grants, and sabbatical leaves, thus bringing those publications under the term "scope of employment" [42]. Professor Dreyfuss argued that a teacher exception exists because even though the university pays faculty salaries, supports research, exercises some rudiments of control, and provides facilities such as libraries and computers, these factors do not prove the university was the motivating force behind the research. Faculty writings are not in the scope of their employment because under the concept of academic freedom, universities exercise little or no supervision over faculty works. Professors are more than just scribes who carry out plans laid down by the universities. The university is rarely the genesis of the ideas memorialized in the work [39, p. 603].

To equate a general duty to write with a duty to produce specific works for a university distorts the nature of academic employment and downgrades the

professorial rank to that of ordinary staff members. The fact that professors may be attracted because research support is provided, or that they write to obtain tenure, hardly entitles a university to regard itself as the author of a scholarly product over which it has exercised no direct supervisory control [43].

Creators have three central nonpecuniary interests in their works. One is the possessory interest that satisfies the creator's initial vision. A second interest is in the integrity of the work, which can be endangered by commercial demands that compromise the vision. The third interest is reputation, which is how the work is presented to the public. Society shares the same concerns. High quality work enriches cultural heritage and its integrity should be protected. If the author does not have to compromise for popular demand, the contributions will endure until they can be appreciated, if not immediately appreciated or understood. Reputation, whether good or bad, is a motivator [39, pp. 605-6].

The copyright must be at least initially controlled by a party who best understands the creator's work. That party is the creator. Severing financial considerations from creative concerns harms not only the interests of authors in the integrity of their work and their reputation, but also those of the public in high quality, accessible, creative material [39, p. 606]. Copyright transfer to the university may cause premature publication that will sacrifice long-term social interests to the university's short-term interest in commercialization [39, p. 617]. The ability of the owner to protect intellectual good from being easily copied allows the author to be compensated for the use of that good because it will be purchased instead of appropriated by free-riders. When the owner loses control of his property, the incentive to produce it is also lost, and the solution must be legal protection [44].

Whenever new technology is involved, the courts must often balance the interest of the public in having free access to copyrightable works against the interests of copyright owners in the protection of, and compensation for, their works [44, p. 320]. In the late 1970s, Universal City Studios sued the Sony Corporation over copyright infringement. The dispute arose over Sony's manufacturing of videocassette recorders, the Betamax. Universal argued that every time a viewer of a television program recorded that program on the Betamax, infringement occurred. The United States Supreme Court ruled for Sony on the basis of the fair use doctrine [45]. The Court held the recorders were not used for commercial purposes but for home entertainment and their use actually increased the television audiences, as viewers could record programs while they were away from home for later viewing. These viewers would otherwise be lost without the benefit of the recorder [46].

In reaching this decision, the Court recognized that public interest in the copyright information outweighed Universal's ownership rights. This holding can be applied to a university setting. By permitting ownership to remain with faculty members, the public will continue to benefit from the fruits of faculty labor.

Ownership by the university will tend to discourage faculty production and research will be limited. If the faculty member is to have an incentive to do research and to publish the results of that research, he or she must be assured some ownership rights to that work.

THE UNIVERSITY'S DESIRE FOR OWNERSHIP

Universities had customarily retained property interest in patentable discoveries by their faculties while relinquishing the rights of copyrightable literary output to the faculty [43, p. 648]. This practice was a result of decisions such as *Miller v. Universal City Studios*, which held that research is not copyrightable. The facts and discoveries are in public domain, but the means of expression are protected [47]. However, the development of computer software has dramatically changed the position of colleges and universities. The courts have held that computer programs are literary works and are afforded copyright, rather than patent, protection [48].

Traditionally, universities have expressed greater interest in patent ownership due to its greater potential for profit. Faculty writings are traditionally aimed at other scholars and are usually published in scholarly journals. The writings are targeted for educational purposes rather than for profit, whereas inventions have generally been profitable for the institution. For example, the University of Florida jointly owns the patent for Gatoraide with its two faculty inventors [39, p. 632]. Facing reduced revenues, particularly in the public sector, universities have begun to take a closer look at copyright ownership policies for works such as computer software as a source of new revenue [39, p. 628].

An attempt was made by the academic community to address this issue in 1982. The Pajaro Dunes Conference Statement appealed to caution and restraint [42, p. 533]. However, this statement was naive on its face, as it assumed copyright and patent laws would continue to operate as they had in the past. The statement was simply a declaration of ideals [43, p. 648]. The statement was overtaken by an overload, if not a breakdown, of the classic intellectual property system. The resulting proliferation in technological developments and the accompanying restraints renders just about everything a university does both protectable and commercially exploitable provided the faculty, students, and administrators are willing to pay the price [43, p. 668].

The Pajaro Dunes statement did provide some guidance for new technology to the extent that it made faculty and administrators think about and reflect upon the cost of conducting the university's business for profit:

The translation from opportunity to reality is not simple or easy. Serious problems . . . center on the preservation of the independence and integrity of

the university and its faculty, both faced with unprecedented financial pressures and complex commercial relationships. Universities are a repository of public trust, and, in many cases, of public funds as well, and they have an obligation . . . to ensure that they remain devoted to their primary goals of education and research and that their resources be properly used in their pursuit of these goals [43, f.n. 154].

Had there been more time to digest the changes occurring in both applied science and intellectual property law in the 1980s, the Pajaro Dunes message might have exerted a more lasting influence [43, f.n. 154].

Additionally, as universities continue to seek alternative sources of revenue, external sponsorship becomes a factor. Often, corporations and others seeking research results will turn to the universities for help. Often, the university, utilizing its faculty, students, and facilities, can accomplish the desired results as a much lesser cost than the sponsor can inhouse [30, p. 1373]. This situation creates a complex employment relationship, and whether the faculty research is a work made for hire will depend on the allocation of rights among the sponsoring agency, the university, and the faculty member.

It is clear under section 220 of the Restatement (Second) of Agency that the university is not the agency law employee of the sponsor, according to the *Reid* decision [30, p. 1377]. Faculty should not fear the loss of ownership simply because the funding source comes from outside the university. Generally, the sponsor exercises little control over the university and, the university exercises little control over the faculty researcher [30, f.n. 166]. Ownership rights can be allocated by a written sponsorship agreement [30, p. 1378]. Such an agreement would be consistent with section 201(b) of the 1976 Act.

The involvement of external sponsoring agencies further confuses an already complex state of ownership for faculty works. As the university control tightens over faculty as a result of external sponsorship, the case for agency law employment and a "for hire" relationship strengthens. If sponsorship funds are directly allocated to faculty salaries, the case for a "for-hire" relationship between the faculty and university weakens, but the potential for ownership rights for the external sponsor increases [30, p. 1378]. The present state of the work-for-hire doctrine casts a pall of uncertainty over the burgeoning industry-university partnership and inhibits the free exchange of information and ideas in academia because parties are unwilling to risk proprietary interests in potentially valuable copyrightable works [30, p. 1379].

It appears the use of other types of technology will follow the route of computer software under the 1976 Act. If a university faculty member's lectures are copyrightable when he delivers them in front of a live class [32, n. 51], the same lectures should fall under copyright coverage if delivered by other means such as fiber-optic, multisite computer transmission, videotape, or interactive video. Additionally, support lies in the statute itself. Section 102(a) of the 1976 Act states the work must be

. . . fixed in any tangible medium of expression now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, whether directly or with the aid of a machine or device [49].

Clearly, the technological methods of delivery are tangible mediums of expression, some known now and some to be developed later. The work can be communicated, perceived, or reproduced directly, or with the aid of a machine or device. It is clear that the rapid development of new technological methods of delivery will cause additional ownership problems for faculty members. Faculty members must look for some means of protection of their intellectual property.

PROTECTION OF FACULTY COPYRIGHT

The most logical method of protection for faculty is a written, signed agreement between the university and the faculty member that establishes ownership rights with the faculty member. Theoretically, this solution sounds easy, but in reality such an agreement is very difficult. The individual faculty member has difficulty negotiating such an agreement because of bargaining inequity. In the absence of a collective bargaining agreement, most faculty are subject to at-will employment. The university can impose whatever conditions it wishes onto faculty contracts of employment and can terminate an untenured faculty member for any reason or no reason. Additionally, the fair use doctrine for scholarly works makes most faculty works very difficult to market. In negotiating ownership rights, the faculty member may not get enough return from the work in exchange for what it cost to obtain ownership from the university [39, pp. 628-29].

Many universities have copyright policies, much like the University of Illinois in the *Weinstein* case. Some policies favor the faculty member and some favor the university. The Stanford University policy states that computer software developed by faculty is owned by the faculty, unless it is a work made for hire contracted for by the university, or as a work made with significant use of university resources [43, p. 677]. The policy is very general, not defining key terms such as "significant use" or "contracted." In comparison, the Carnegie-Melon University policy states that the university retains the patent and copyright for 120 days. Ownership of the copyright for educational materials is returned to the author, while computer software copyrights will be retained by the university if a market for the software is anticipated [43, p. 678]. It is clear the university wishes to retain the copyright for works that would bring a profit to the university.

The university, as owner of the copyright, creates major problems. Universities will not only become too competitive and will not share their results with sister institutions, but university lawyers will be left in a quandary over rights. The university that owns the research will desire strong protection to keep exclusive control, but that same university will also desire soft protection to legally "borrow" the research results from other universities to use in its own works [43,

p. 698]. In exchange for the modest chance for pecuniary gain, the university risks fundamental alterations in the environment it creates for the student body and professional staff. The works-for-hire doctrine should be legislatively reviewed or judicially limited. The Copyright Act was intended to fulfill a public purpose. The works-for-hire doctrine divests creative employees of the capacity to fulfill that purpose or requires them to buy it back, if that concept was indeed realistic [39, p. 638].

Congress should have codified the teacher exception into the 1976 Act or at least created a "shop right" similar to patent law. The concept of shop right allows the patent ownership to remain with the employee, but gives the employer the exclusive right to use the patent free of charge. The distribution of royalties under shop right is a matter of contract. The employee may retain all royalties, but more realistically, royalties are shared between employer and employee. The motion picture industry prevented this type of arrangement in the 1976 Act by lobbying against it. Their lobbying arose out of a fear that actors, directors, writers, composers, and other artists who collaborate to create a motion picture would all assert ownership rights and demand a voice in the creation of the work [39, p. 639]. The problem with this concept is that it again depends on the ability of the employee to negotiate rights with an employer who has superior bargaining power.

Until such time as the Supreme Court gives guidance or until Congress amends the Copyright Act, many faculty members must depend on their employers to be more committed to fostering innovative behavior by transferring copyright ownership rights to the employee. In consideration for this transfer, the university could share in the copyright royalties and/or be reimbursed for the university's share of the cost of creation. A portion of the profit could go to the university in reimbursement for secretarial services; computer, laboratory, or library use; grants; travel, etc. It would be to the university's benefit to place such provisions in faculty handbooks or as standard language in employment contracts.

Much like the Pajaro Dune Statement, this concept is very idealistic. Reality says that universities are desperate for new sources of revenue. The rapid development of computer software and other technologies has caught the attention of university administrators. In a period where many public universities are struggling to keep the doors open in the face of declining state appropriations, faculty members can hardly depend on the employer to foster innovative behavior when it believes it can share the wealth or "steal the pot of gold." Faculty members employed by institutions not concerned with short-term gain will be protected. The remainder must seek methods to protect their intellectual property.

State laws may offer some remedies to faculty. There may be remedies in the laws of contract as employment contracts and handbooks may create either actual or implied contracts under which faculty members could sue for breach [50]. Again, this remedy would assume the employment contract or faculty handbook vested some ownership rights in the faculty member. Courts may be reluctant to fall back on state law of contracts because the 1976 Act begins with the premise

that the parties negotiated the employment contract. There may be a treat reluctance to infer what is not present if the contract is silent on copyright ownership [39, p. 636].

Similarly, the power to protect and defend one's reputational interests and to preserve the integrity of the work finds support in state actions of torts, trademark infringement, and unfair competition. Relief may come from actions for defamation, misrepresentation, misappropriation of creator's name, invasion of privacy, and false light [39, pp. 634-35]. The courts may also decide the faculty member lacks standing to bring state law claims because the 1976 Act clearly states the employer is the owner [51], or the Copyright Act preempts state law [52].

It appears that collective bargaining may offer the best solution for faculty who can benefit from union representation. Most of the faculty unionization has occurred in the public sector under state labor relations statutes. Private colleges and universities have been hampered by the Supreme Court's decision in *National Labor Relations Board v. Yeshiva University*, in which the Court held the faculty to be managers due to their role in promotions, hiring, tenure, etc. This decision prevented faculty from organizing and electing a union [53]. Where the individual faculty member has little or no bargaining strength against the university, the unionized faculty has greater strength in bargaining, including the right to strike. In Pennsylvania, faculty members at the fourteen state-owned universities are covered by the Public Employees Relations Act [54]. That act permits faculty members as public employees to bargain over wages, hours, and terms and conditions of employment [54, § 1101.701]. Since 1971, the collective bargaining agreements between the faculty and the Commonwealth have contained elaborate procedures for evaluation, promotion, and tenure. These procedures encourage scholarly growth through research and publication. The parties have not formalized a "publish or perish" clause, but it is clear that faculty works are weighed in consideration of promotion and tenure applications.

Although never tested in the courts, the long-standing practice of the parties has been to consider these evaluation procedures to be "terms and conditions" of employment and thus mandatory subjects of bargaining. The rationale for this agreement is the broad interpretation of "terms and conditions of employment" by the Pennsylvania courts [55]. The practice of the parties and the prevailing case law lead this author to believe copyright ownership would be a term or condition of employment under Pennsylvania law. Additional support for advanced technology is found in a New York case involving one of its state universities. *Sierra Telecom Services, Inc. v. Harnett* held that union wage rates would apply in a telecommunications project. The state appellate court upheld the commissioner of labor's decision that union wages must be paid even for the subcontractor's employees, as the work was bargaining unit work [56].

Although the current collective bargaining agreement for Pennsylvania's faculty does not contain any provision vesting copyright ownership with the

faculty member, it is this author's strong recommendation that such a provision be negotiated, not only for the reasons stated in this article, but for job security as well. As the Pennsylvania State System of Higher Education develops new technologies, the potential for loss of faculty jobs rises. Inadequate state budgets have left the universities with decreased revenues to hire additional faculty. The student population had increased, and one viable alternative may be to establish multisite classes or courses videotaped for rebroadcast. If faculty ownership is not protected, not only will current faculty members lose compensation for their creative efforts, but they may even lose their jobs.

Technological innovation and advancements in teaching should be used to share the wealth just as any intellectual property should be used. If the ownership right of the intellectual property is properly protected, the faculty will not fear the onset of new technology. University employers should recognize that such a clause in a collective bargaining agreement will benefit all parties because it will help to keep morale high, it will avoid a chilling effect on faculty research, and it will preserve the integrity of faculty intellectual property. Pennsylvania's fourteen universities could share the best and brightest of each of its faculties with its sister institutions, both within the public system and with private institutions, if faculty could be assured that technological advances will not place them or their colleagues in the unemployment lines.

CONCLUSION

It is uncertain how Pennsylvania's three federal district courts or the Third Circuit Court of Appeals will rule on the "teacher exception." Congress has provided no guidance on faculty works since the 1976 Act was passed, nor is any foreseeable in the future.

It appears that for the faculty at Pennsylvania's public universities, the best method of protecting faculty works under the 1976 Copyright Act will be for its union to negotiate ownership rights into the collective bargaining agreement. Even if the courts would happen to hold that faculty works in Pennsylvania are works for hire, the written language of the collective bargaining agreement will satisfy the Copyright Act's requirement of a written, signed agreement between the parties assigning the university's ownership rights to the faculty where they rightfully belong.

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END NOTES

1. United States Constitution, art. I section 8, cl. 8.
2. M. Nimmer *et al*, Cases and Materials on Copyright, Matthew Bender and Co., N.Y. (4th ed. 1991).
3. 17 U.S.C. Section 1 *et seq*, Pub L. No. 94-533 (1909 Act).
4. 17 U.S.C. Section 101 *et seq*. (1976 Act), Pub L. No. 94-553.
5. 17 U.S.C. Section 26 (1909 Act), Pub L. No. 60-349, 35 Stat. 1088.
6. *Bleistein v. Donaldson Lithography Co.*, 188 U.S. 239, 23 S.Ct. 298, 47 L.Ed. 460 (1903).
7. *Scherr v. Universal Match Corp.*, 417 F.2d 497, 502 (2d Cir. 1969).
8. *Yardley v. Houghton Mifflin Co.*, 108 F.2d 28, 31 (2d Cir. 1939).
9. *Public Affairs Associates v. Rickover*, 177 F. Supp. 601 (D.D.C. 1959), *rev'd on other grounds*, 284 F.2d 262 (D.C. Cir. 1960) *vacated for insufficient record*, 369 U.S. 111 (1962).
10. Staff of Subcommittee on Patents, Trademarks, and Copyrights of Senate Committee on the Judiciary, 86th Congress 2d Sess., Study No. 13, Works Made for Hire and on Commission, p. 139 (Comm. Printing 1960) (reported by B. Varmer), reprinted in 1 Studies on Copyright 731 (Fisher Memorial ed. 1963).
11. House Committee on the Judiciary, 87th Congress, 1st Sess., Copyright Law Revision: Report on Register of Copyrights on the General Revision of United States Copyright Law at 86 (Comm. Printing 1961), reprinted in 3 Omnibus Copyright Revision Legislative History (George S. Grossman, ed. Hein Co., Buffalo, N.Y. 1976).
12. C. L. Weinberg, *Community for Creative Non-Violence v. Reid: A Specious Solution to the "Works Made for Hire" Problem*, 32 B.C.L. Rev. p. 663 (1991).
13. *Brattleboro Publishing Co. v. Windmill Publishing Corp.*, 369 F.2d 565 (2d Cir. 1966).
14. 17 U.S.C. Section 101.
15. 17 U.S.C. Section 201(b).
16. House Committee on the Judiciary, House Report No. 94-1476.
17. *Murray v. Gelderman*, 566 F.2d 1307, (5th Cir. 1978).
18. *May v. Morganelli—Heumann & Associates*, 618 F.2d. 1363 (9th Cir. 1980).
19. *Meltzer v. Zoller*, 520 F.Supp. 847 (D.C.N.J. 1981).
20. *Marshall v. Miles Laboratories, Inc.*, 647 F.Supp. 1326 (N.D. Ind. 1986).
21. *Sawyer v. Crowell Publishing Co.*, 46 F.Supp. 471 (S.D.N.Y. 1942).
22. 1 M. Nimmer on Copyright, Section 5.03 [B][1][b][i] at 5-12 (1992).
23. R. VerSteege, *Copyright and the Educational Process: The Right of Teacher Inception*, 75 Iowa L. Rev., pp. 381-416 (January 1991), quoting Prosser and Keeton on Torts, West Publishing Co., St. Paul, MN, Section 70, pp. 503-05.
24. Restatement (Second) of Agency, Section 229 (1958).
25. *Aldon Accessories v. Spiegel, Inc.*, 738 F.2d 548 (2d Cir.), *cert. denied*, 469 U.S. 982 (1984).
26. *Peregrine v. Lauren Corp.*, 601 F.Supp. 828 (D. Colo. 1985).

27. *Dumas v. Gommerman*, 865 F.2d 1093 (9th Cir. 1989).
28. *Easter Seals Society v. Playboy Enterprises*, 815 F.2d 323 (5th Cir. 1987).
29. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 109 S.Ct. 2166, 104 L.Ed.2d 811 (1989).
30. P. S. Bousquet, *Externally Sponsored Faculty Research Under the "Work for Hire Doctrine: Who's the Boss?"*, 39 Syracuse L. Rev. 1351, 1352 f.n. 7 (December 1, 1988).
31. *Sherrill v. Grieves*, 57 Wash. L. Rep. 286, 20 C.O. Bull., p. 675 (1929).
32. *Williams v. Weiser*, 273 Cal. App. 2d 726, 78 Cal. Rptr. 542 (1969).
33. *Caird v. Sime*, 12 App. Cas. 326 (1887); *Abernathy v. Hutchinson*, 3 L.J. Ch. 209, 1 H. & T. 28 (1825); and *Nicols v. Pitman*, 26 Ch.D. 374 (1884). See *Williams*, Id, at 736-78 and 78 Cal. Rptr. at 547-48.
34. *Weinstein v. University of Illinois*, 811 F.2d 1091 (7th Cir. 1987).
35. *Weinstein v. University of Illinois*, 628 F.Supp. 862 (N.D. Ill. 1986).
36. Weinstein was awarded ownership, but he lost his position at the university. As an untenured faculty member, he had no property rights and thus no protection under the due process clause.
37. M. J. Luzum and D. S. Pupel, Jr., *Weinstein v. University of Illinois: The "Work for Hire" Doctrine and Procedural Due Process for Nontenured Faculty*, 15 J. College and University of Law 369 (1989).
38. *Hays v. Sony Corp. of America*, 847 F.2d 412 (7th Cir. 1988).
39. R. C. Dreyfuss, *The Creative Employee and the Copyright Act of 1976*, 54 U. Chi. L. Rev. 590 (1987).
40. Judge Easterbrook dissented in *Hays v. Sony Corp of America* [38].
41. *Clarkstown v. Reeder*, 566 F.Supp. 137, 143 n.3 (S.D.N.Y. 1983).
42. T. F. Simon, *Faculty Writings: Are They "Works Made for Hire" Under the 1976 Copyright Act?*, 9 J. Col. & Univ. Law 485, 504 (1982-83).
43. J. H. Reichman, *Computer Progress as Applied Scientific Know-How: Implications of Copyright Protection for Commercialized University Research*, 42 Vand. L. Rev. 639, 674 (April 1989).
44. M. L. Mills, *New Technology and the Limitations of Copyright Law: An Argument for Finding Alternatives to Copyright Legislation in an Era of Rapid Technological Change*, 65 Chi-Kent L. Rev. 307, 311 (1989).
45. 17 U.S.C. Section 107.
46. *Sony Corp. of America v. Universal City Studios*, 464 U.S. 417, 104 S.Ct. 774, 78 L.Ed.2d 574 (1984).
47. *Miller v. Universal City Studios*, 650 F.2d 1365 (5th Cir. 1981).
48. *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240 (3d Cir. 1983); see also, *Stern Electronics, Inc. v. Kaufman*, 669 F.2d 852 (2d Cir. 1982), *Williams Electronics, Inc. v. Artic International, Inc.*, 685 F.2d 870 (3d Cir. 1982).
49. 17 U.S.C. Section 102(a).
50. *Stanley v. CBS*, 35 Cal. 2d 653, 221 P.2d 73 (1950).
51. *Moran v. London Records, Ltd.*, 642 F.Supp. 1023 (N.D. Ill. 1986).
52. *Association of Medical Colleges v. Carey*, 728 F.Supp. 873 (N.D.N.Y. 1990), see also, *Baltimore Orioles v. Major League Baseball Players Assn.*, 805 F.2d 663 (7th Cir. 1986).

53. *National Labor Relations Board v. Yeshiva University*, 444 U.S. 672, 100 S.Ct. 856, 63 L.Ed.2d 115 (1979).
54. 43 Pa. Stat. Ann. Section 1101.101 et seq. (Purdon 1991, Supp. 1992).
55. *State College Education Assn. v. Pennsylvania Labor Relations Board*, 9 Pa. Cmwlth. 229, 306 A.2d 404, *remanded*, 461 Pa. 494, 337 A.2d 262 (1973).
56. *Seirra Telecom Services, Inc. v. Hamett*, 579 N.Y.S.2d 753, 72 Ed. Law Rep. 991 (1992).

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