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## Copyright and the Harvard Open Access Mandate

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N O R T H W E S T E R N  
JOURNAL OF TECHNOLOGY  
AND  
INTELLECTUAL PROPERTY

**Copyright and the Harvard Open Access Mandate**

*Eric Priest*



# Copyright and the Harvard Open Access Mandate

By Eric Priest\*

## ABSTRACT

Open access proponents argue that scholars are far more likely to make their articles freely available online if they are required to do so by their university or funding institution. Therefore, if the open access movement is to achieve anything close to its goal of seeing all scholarly articles freely available online, mandates will likely play a significant role. In 2008, the Harvard University Faculty of Arts and Sciences adopted a policy that purports not only to require scholars to deposit their works in open access repositories, but also to grant the university nonexclusive copyright licenses to archive and publicly distribute all faculty-produced scholarly articles. A number of other American universities have since adopted similar policies. The principal aim of this Article is to analyze the legal effect of these Harvard-style open access “permission” mandates.

By invoking copyright law terminology in permission mandates, schools might intend that they have the legal effect of transferring nonexclusive rights to the school, thereby clarifying and fortifying the school’s rights to reproduce and publicly disseminate faculty works. However, the legal effect of these mandates is uncertain for several reasons. First, it is unsettled whether scholars or their university employers are the authors and initial owners of scholarly articles under U.S. copyright law’s work-made-for-hire rules, which vest authorship and copyright ownership in the employer for works created by employees within the scope of employment. Second, the mandates are broad university policies that purport to grant the university nonexclusive copyright licenses in every scholarly article unless a faculty member affirmatively opts out on a per-article basis. Are the policies specific enough to provide the essential terms of the grant? Furthermore, can the mere adoption of a school policy, without some additional affirmative act by the author, effectuate such a grant without unduly encroaching upon the author’s autonomy interests? Lastly, even if the policies effectuate nonexclusive license grants, will the licenses survive after the author transfers copyright ownership to a journal publisher as per common practice? Section 205(e) of the Copyright Act provides

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that a prior nonexclusive license evidenced in a writing signed by the right holder prevails over a subsequent conflicting transfer of copyright ownership, so the answer appears to turn on whether permission mandates satisfy the requirements of § 205(e).

This Article argues that permission mandates can create legally enforceable, durable nonexclusive licenses. First, it argues that although there are important justifications, including academic freedom concerns, for recognizing the controversial “teacher exception” to the work for hire rules for scholarly articles, such an exception may be unnecessary because a strong argument also exists that much scholarship is produced outside the scope of employment for work for hire purposes. Second, it argues that permission mandates provide sufficient evidence of the grantor’s intent and the rights granted to create effective nonexclusive licenses. Third, permission mandates satisfy the requirements of § 205(e) and establish the license’s priority over the subsequent transfer of copyright ownership largely because they fulfill the underlying purposes of § 205(e) by providing sufficient evidence and notice of the license to potential copyright transferees (typically academic publishers). In reaching these conclusions, this Article emphasizes that Courts should consider the uniformity costs (social costs resulting from applying uniform rules and granting uniform entitlements across diverse conditions) that arise from applying to scholarly articles copyright rules developed to address proprietary models of information production. Applying the relevant copyright rules in a manner sensitive to the nonmarket nature of scholarly production is the most effective way to reduce these social costs, and reinforces the conclusion that mandate licenses are enforceable.

Lastly, the Article considers whether the opt-out nature of permission mandates offends notions of authorial autonomy in copyright. It compares permission mandates with another high profile opt-out licensing regime: the proposed Google Books settlement agreement, which the court rejected partly because of authorial autonomy concerns. However, authorial autonomy is far less of a concern for scholarly articles than for the books at issue in the Google Books case, due to the nonmarket nature of scholarly article production coupled with academic community norms. Accordingly, it does not substantially interfere with authors’ autonomy interests to find that the opt-out structure of permission mandates creates valid nonexclusive licenses in universities.

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## I. INTRODUCTION

¶1 On February 12, 2008, the Harvard University Faculty of Arts and Sciences unanimously approved a policy requiring every faculty member to make all of their future scholarly articles freely available to the world online.<sup>1</sup> The vote was hailed as a watershed<sup>2</sup> for the open access movement, that is, the movement to increase social welfare by making scholarship publicly available online free of cost and access restrictions.<sup>3</sup> This was not the first university policy mandating that faculty make their works open access, but it was the first at an American university, and adoption by an institution of Harvard's stature was sure to raise awareness and inspire other universities to do the same.<sup>4</sup> Indeed, in the three years since the Harvard vote, nearly thirty U.S. universities and academic departments have adopted similar mandates, including Massachusetts Institute of Technology, Duke, Kansas, Princeton, and six other schools at Harvard.<sup>5</sup>

¶2 The Harvard mandate also marked a watershed for its key contribution to the open access movement. Whereas previous university mandates only required faculty to *deposit* their own scholarly articles online, the Harvard mandate purports to automatically *grant the school a nonexclusive license* to archive and distribute every scholarly article produced by its faculty unless a faculty member expressly opts out on a per-article basis.<sup>6</sup> Mandates are viewed by some as critical to the success of the open access movement because without mandates, a relatively low percentage of scholars (about fifteen to twenty percent) make some version of their articles freely available online.<sup>7</sup> With mandates in place, however, research suggests that nearly all scholars would agree to permit their articles to be freely distributed online, the vast majority willingly.<sup>8</sup>

¶3 In the university setting, the Harvard-style "permission mandate" is a far more powerful open access tool, with the potential to be more disruptive, than its "deposit mandate" cousin. First, and most importantly, a permission mandate resets the default in

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<sup>1</sup> See *Harvard University Unanimously Votes 'Yes' for Open Access*, BERKMAN CENTER FOR INTERNET & SOC'Y (Feb. 19, 2008), <http://cyber.law.harvard.edu/node/3927>.

<sup>2</sup> See Peter Suber, *The Open Access Mandate at Harvard*, SPARC OPEN ACCESS NEWSLETTER, no. 119, Mar. 2, 2008, <http://www.earlham.edu/~peters/fos/newsletter/03-02-08.htm>; PHILIP YOUNG, THE SERIALS CRISIS AND OPEN ACCESS: A WHITE PAPER FOR THE VIRGINIA TECH COMMISSION ON RESEARCH 9 (2009), available at <http://vtechworks.lib.vt.edu/bitstream/handle/10919/11317/OAwhitepaper.pdf>.

<sup>3</sup> See *Read the Budapest Open Access Initiative*, BUDAPEST OPEN ACCESS INITIATIVE (Feb. 14, 2002), <http://www.soros.org/openaccess/read.shtml> (defining open access).

<sup>4</sup> See Suber, *supra* note 2; YOUNG, *supra* note 2, at 9.

<sup>5</sup> See ROARMAP: REGISTRY OF OPEN ACCESS REPOSITORIES MANDATORY ARCHIVING POLICIES, <http://roarmap.eprints.org/> (last visited June 3, 2012) [hereinafter ROARMAP] (listing twenty-eight higher education or research institutions in the United States that at the time of this writing have adopted permission-style mandates).

<sup>6</sup> See Suber, *supra* note 2.

<sup>7</sup> Yassine Gargouri et al., *Self-Selected or Mandated, Open Access Increases Citation Impact for Higher Quality Research*, PLOS ONE, Oct. 18, 2010, <http://www.plosone.org/article/info%3Adoi%2F10.1371%2Fjournal.pone.0013636>.

<sup>8</sup> Alma Swan, *The Culture of Open Access: Researchers' Views and Responses*, in OPEN ACCESS: KEY STRATEGIC, TECHNICAL AND ECONOMIC ASPECTS 65, 69–70 (Neil Jacobs ed., 2006).

copyright law.<sup>9</sup> Rights of exclusion are the core of copyright: copying, distributing, or making some other privileged use of another's work is infringement absent the author's permission.<sup>10</sup> The mandate seemingly turns this exclusive right on its head by automatically granting broad permissions absent the author's written objection.<sup>11</sup> Second, a permission mandate empowers the university to proactively post an article online in the event that the faculty author does not. This ensures that the university need not wait on faculty in order to achieve online dissemination of nearly all of the school's scholarly article output. Third, the permission mandate enables retention of rights by vesting rights in the school that it can later grant back to the author after she has transferred copyright ownership to a journal according to common practice in the scholarly publishing industry.<sup>12</sup> This way, the author need not seek the publisher's permission when she wants to distribute her article in class or include it as a chapter in a subsequent book.<sup>13</sup>

14 The advent of permission mandates ups the ante in the escalating tensions between universities and academic journal publishers over open access. Publishers worry that as more scholarship becomes available online for free, university libraries will have less incentive to purchase journal subscriptions.<sup>14</sup> Open access proponents, by contrast, argue that academic journal prices have become excessive in many cases, while publishers—many of which are commercial—enjoy sizable profits.<sup>15</sup> Open access proponents further contend that the Internet has changed the economics of scholarly publishing: now that producers can make scholarship freely available online at relatively low cost, there is less need to distribute it through subscription-access-only journals.<sup>16</sup> They argue that open access produces the dual benefit of relieving university libraries of high scholarly periodical prices while providing the public with free access to scholarship.<sup>17</sup> Open access proponents acknowledge the importance of the article peer review process,

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<sup>9</sup> See Stuart Shieber, *University Open-Access Policies as Mandates*, OCCASIONAL PAMPHLET (June 30, 2009), <http://blogs.law.harvard.edu/pamphlet/2009/06/30/university-open-access-policies-as-mandates/>.

<sup>10</sup> See 17 U.S.C. § 106 (2011).

<sup>11</sup> *Harvard Faculty of Arts and Sciences Open Access Policy*, HARV. U. LIBR. OFF. FOR SCHOLARLY COMM. (Feb. 12, 2008), <http://osc.hul.harvard.edu/hfaspolicy> [hereinafter *Harvard FAS Mandate*]; see *infra* Appendix, p. 440.

<sup>12</sup> Stuart M. Shieber, *A Model Open-Access Policy*, HARV. U. LIBR. OFF. FOR SCHOLARLY COMM. 2 (2010), [http://osc.hul.harvard.edu/sites/default/files/model-policy-annotated\\_0.pdf](http://osc.hul.harvard.edu/sites/default/files/model-policy-annotated_0.pdf).

<sup>13</sup> Because the nonexclusive licenses that arise from Harvard-style permission mandates permit non-profit uses only, subsequent use of the article in a book sold for profit might exceed the scope of the license.

<sup>14</sup> Karen M. Albert, *Open Access: Implications for Scholarly Publishing and Medical Libraries*, 94 J. MED. LIBR. ASS'N 253, 256–57 (2006).

<sup>15</sup> See Adam Stevenson, *The Economic Case for Open Access in Academic Publishing*, ARS TECHNICA (Nov. 29, 2010, 6:25 AM), <http://arstechnica.com/science/news/2010/11/the-economic-case-for-open-access-in-academic-publishing.ars>.

<sup>16</sup> Peter Suber, *Open Access Overview*, PETER SUBER AT EARLHAM C. (June 21, 2004), <http://www.earlham.edu/~peters/fos/overview.htm> (“[T]he purpose of [open access] is not to punish or undermine expensive journals, but to provide an accessible alternative and take full advantage of new technology—the internet—for widening distribution and reducing costs.”).

<sup>17</sup> See *Why Librarians Should Be Concerned with Open Access*, OPEN ACCESS SCHOLARLY INFO. SOURCEBOOK, [http://www.openoasis.org/index.php?option=com\\_content&view=article&id=254&Itemid=256](http://www.openoasis.org/index.php?option=com_content&view=article&id=254&Itemid=256) (last updated June 26, 2009); *The Public's Right to Research*, OPEN ACCESS SCHOLARLY INFO. SOURCEBOOK, [http://www.openoasis.org/index.php?option=com\\_content&view=article&id=547&Itemid=265](http://www.openoasis.org/index.php?option=com_content&view=article&id=547&Itemid=265) (last updated June 8, 2009).



currently superintended by journals,<sup>18</sup> and that there are substantial costs to publishing scholarship.<sup>19</sup> The goal of open access, they argue, is not to supplant peer review or seek a cost-free publication model; rather, it is to ensure that all peer-reviewed scholarship is publicly accessible at no cost to the user.<sup>20</sup>

¶5 By invoking copyright law terminology in permission mandates, schools might intend that they have the legal effect of transferring nonexclusive rights to the school, thereby clarifying and fortifying the school's rights to reproduce and disseminate faculty works. If a publisher challenges the validity of these rights in court, however, the outcome is uncertain.<sup>21</sup> It is unclear whether permission mandates satisfy the legal requirements for effective grants of nonexclusive licenses, and even if they do, whether those licenses will remain valid after the author subsequently transfers copyright ownership to a publisher. Furthermore, the opt-out structure of permission mandates raises difficult questions of authorial autonomy. In a widely followed lawsuit, Google sought to use a class action settlement agreement to automatically acquire nonexclusive rights to reproduce and sell millions of books, subject only to express opt-out by a book's copyright owner.<sup>22</sup> The court rejected the settlement agreement in large part because the opt-out structure offended traditional notions of authorial autonomy: "[I]t is incongruous with the purpose of the copyright laws to place the onus on copyright owners to come forward to protect their rights . . . ."<sup>23</sup> Is the opt-out structure of permission mandates likewise invalid for failure to protect the autonomy interests of authors? Or in the context of scholarship, open access, and permission mandates should authorial autonomy be analyzed in a different light? This Article considers whether permission mandates create legally enforceable licenses. It argues that they do, and that the mandates do not raise the same concerns about authorial autonomy as the proposed Google Books settlement, largely because of the unique, nonmarket nature of scholarly production.

¶6 Part II of this Article provides an overview of scholarly journal publishing and the movement for open access scholarship, which arose in part as a response to an academic publishing market many perceive as dysfunctional. It then discusses the role of mandates as an important thrust of the open access movement. Part III examines issues that arise

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<sup>18</sup> See Stevan Harnad, *Post-Peer-Review Open Access, Commentary and Metrics Versus Post Hoc "Peer Review,"* OPEN ACCESS ARCHIVANGELISM (Sept. 7, 2011, 2:11 PM), <http://openaccess.eprints.org/index.php?archives/837-Post-Peer-Review-Open-Access,-Commentary-and-Metrics-versus-Post-Hoc-Peer-Review.html>.

<sup>19</sup> See Suber, *supra* note 16 ("No serious [open access] advocate has ever said that [open access] literature is costless to produce, although many argue that it is much less expensive to produce than conventionally published literature, even less expensive than priced online-only literature.").

<sup>20</sup> See Peter Suber, *A Field Guide to Misunderstandings About Open Access*, SPARC OPEN ACCESS NEWSLETTER, no. 132, Apr. 2, 2009, <http://www.earlham.edu/~peters/fos/newsletter/04-02-09.htm#fieldguide> ("The [open access] movement focuses on [open access] for peer-reviewed literature. The goal is to remove access barriers, not quality filters."); Suber, *supra* note 16 ("The question is not whether scholarly literature can be made costless, but whether there are better ways to pay the bills than by charging readers and creating access barriers.").

<sup>21</sup> Publishers are openly critical of open access mandates, and it is plausible that they might one day seek to challenge the validity of the licenses the mandates purport to grant. See, e.g., Patricia Cohen, *At Harvard, a Proposal to Publish Free on Web*, N.Y. TIMES, Feb. 12, 2008, at E1 ("Asked about the Harvard proposal, Allan Adler, vice president for legal and governmental affairs at the Association of American Publishers, said that mandates are what publishers object to . . . . 'As long as they leave the element of choice for authors and publishers,' he said, 'there isn't a problem.'").

<sup>22</sup> *Authors Guild v. Google Inc.*, 770 F. Supp. 2d 666, 680–82 (S.D.N.Y. 2011).

<sup>23</sup> *Id.* at 682.

when copyright law, scholarship, and open access intersect. It begins by highlighting the U.S. copyright law's utilitarian roots and largely uniform focus on economic incentives to produce information goods, and the fact that the incentives for academics to produce scholarly articles are generally non-economic, so scholarly articles result from a nonmarket model of information production. The poor interface between rules crafted under a proprietary conception of copyright and nonmarket scholarly production can result in "uniformity costs"—social costs resulting from applying uniform rules and granting uniform entitlements across diverse conditions—including uncertainty and suboptimal outcomes.<sup>24</sup> Part III then analyzes two areas of U.S. copyright law that have particular relevance to open access scholarship and permission mandates but the rules of which incline toward an economic conception of information production resulting in uncertainty when applied to scholarly articles: the rules that govern "works made for hire" (that is, does initial ownership of scholarship vest in the university or the faculty member employee), and the rules that govern the priority of nonexclusive licenses over conflicting transfers of copyright ownership. In examining the work made for hire rules, Part III observes that whether scholars or their universities are the legal authors and initial owners of scholarship is a surprisingly unsettled question. It then argues that although academic freedom and uniformity cost concerns provide powerful justifications for recognizing the controversial "teacher exception" to the work for hire rules, such an exception may nevertheless be unnecessary because a strong argument also exists that much scholarship is produced outside the scope of employment for work for hire purposes. Lastly, Part III canvasses the copyright rules that govern the creation and durability of nonexclusive licenses, which are central to the open access model. In particular, it examines the effects of and purposes underlying § 205(e) of the Copyright Act, which provides that a nonexclusive license evidenced in a writing signed by the grantor prevails over a conflicting subsequent transfer of copyright ownership.

Part IV considers the enforceability of mandate-effectuated licenses. First, it argues that permission mandates provide sufficient evidence of the grantor's intent and the rights granted to create effective nonexclusive licenses. Additionally, permission mandates provide sufficient evidence of the license's existence, and provide potential copyright transferees (typically academic publishers) with sufficient notice of the nonexclusive license to establish the license's priority over the subsequent transfer of copyright ownership. Second, Part IV considers whether permission mandate licenses offend notions of authorial autonomy in copyright. It discusses the two important aspects of authorial autonomy in copyright theory—economic autonomy and personal autonomy. It argues that authorial autonomy is far less of a concern for scholarly articles than for the books at issue in *Authors Guild* (the Google Books case) due to the nonmarket nature of scholarly article production coupled with academic community norms. Accordingly, it does not substantially interfere with authors' autonomy interests to find that the opt-out structure of permission mandates creates valid nonexclusive licenses in universities. Lastly, Part IV argues that courts should be mindful of the uniformity costs, introduced in Part III, that arise from applying to scholarly articles copyright rules developed to address proprietary models of information production. Situating this argument within the existing literature on uniformity costs in intellectual property law, this Article argues that

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<sup>24</sup> See generally Michael W. Carroll, *One for All: The Problem of Uniformity Cost in Intellectual Property Law*, 55 AM U. L. REV. 845 (2006).

applying copyright rules in a manner sensitive to the nonmarket nature of scholarly production is the most effective way to reduce these social costs, and reinforces the conclusion that mandate licenses are enforceable.

¶8 By examining the enforceability of permission mandates, this Article seeks to provide a close analysis of the legal effect of permission mandates that seems needed but is missing from the scholarly literature. This Article is not intended to argue that permission mandates are the optimal information access solution. Whether the mandates are the best way to achieve their desired ends is an empirical question beyond the scope of this Article. Rather, this Article takes the position that if the legal validity of permission mandates is challenged, there are compelling reasons not to nip them in the bud based on a rigid, textualist interpretation of copyright rules developed to address very different, economically centered appropriability problems that are largely irrelevant to scholarly articles. Universities, by adopting permission mandates, signal that they view the mandates as an important tool for managing one of their most critical knowledge resources: scholarly articles. If courts can reasonably interpret the relevant copyright rules to permit schools to utilize permission mandates to archive scholarship and disseminate it freely to the public, they should do so. This is especially true given that the goal of permission mandates is to promote the dissemination and advancement of knowledge—important copyright law objectives.

¶9 Finally, to be clear, this Article’s analysis does not apply to all “scholarship”—an extremely broad term. It is limited to scholarly articles. The reason is that monographs, treatises, and the like may result from economic motivations since their authors are paid royalties, while authors of scholarly articles are not. Additionally, and for largely that reason, the open access movement and the Harvard mandate strictly target scholarly articles.

## II. SCHOLARLY PUBLISHING AND THE MOVEMENT FOR OPEN ACCESS SCHOLARSHIP

¶10 The movement for open access scholarship arose as a result of two converging factors: an ongoing “serials crisis” in academic publishing, which has witnessed an unsustainably steep rise in scholarly periodical prices coupled with increasingly strained university library budgets,<sup>25</sup> and the rise of the Internet, which enables instantaneous, inexpensive global information dissemination.<sup>26</sup>

### A. *The Scholarly Journal Publishing Market*

#### 1. The Roots of the Serials Crisis

¶11 Traditionally, scholarly publishing was in the hands of learned societies.<sup>27</sup> Commercial publishers rose to prominence in the field during the latter half of the twentieth century as the federal government shifted toward private publication of federally funded research and other government-produced information, and learned

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<sup>25</sup> See YOUNG, *supra* note 2, at 1.

<sup>26</sup> See Michael W. Carroll, *The Movement for Open Access Law*, 10 LEWIS & CLARK L. REV. 741, 747–51 (2006).

<sup>27</sup> See generally JEAN-CLAUDE GUÉDON, IN OLDENBURG’S LONG SHADOW: LIBRARIANS, RESEARCH SCIENTISTS, PUBLISHERS, AND THE CONTROL OF SCIENTIFIC PUBLISHING (2001).

societies shifted their journal publication duties to private publishing houses as a cost-saving, revenue-generating measure.<sup>28</sup> A diverse field of players and potentially high profit margins predictably induced consolidation in the commercial academic publishing industry. By the 1990s, a small handful of international publishing conglomerates controlled the distribution of the most widely read, prestigious academic journals, and subscription fees for major scientific journals skyrocketed.<sup>29</sup> Between 1990 and 2000, the average price of academic science and technology journals increased by 178%.<sup>30</sup> In the humanities and social sciences, the average journal price increased by 185%.<sup>31</sup> University libraries were charged annual subscription fees as high as \$20,000 for some commercially published major scientific journals (as much as six times higher than fees for nonprofit journals in the same field), while the publishers enjoyed profit margins nearing forty percent.<sup>32</sup> The rise in journal subscription fees, coupled with increasingly tight acquisition budgets at many university libraries, has led many university libraries to pare down their journal subscriptions.<sup>33</sup> Journals that institutions drop often seek to offset those losses by raising prices even further for their remaining subscribers.<sup>34</sup> Many university libraries are also forced to offset costs by purchasing fewer books, resulting in reduced access to information for scholars and precious revenue lost for nonprofit university presses.<sup>35</sup>

¶12 Several unique features of the academic publishing market catalyze the trend of higher access costs. Once a journal establishes itself as a “must have” title in its subject matter area and attracts top scholarship in the field, it effectively becomes a miniature monopoly because of the absence of adequate substitutes.<sup>36</sup> Such must-have journals therefore have low price elasticity; that is, libraries will continue to purchase the title

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<sup>28</sup> Nancy Kranich, *Countering Enclosure: Reclaiming the Knowledge Commons*, in UNDERSTANDING KNOWLEDGE AS A COMMONS: FROM THEORY TO PRACTICE 85, 87–88 (Charlotte Hess & Elinor Ostrom eds., 2007) [hereinafter UNDERSTANDING KNOWLEDGE].

<sup>29</sup> *Id.*; see also Stephen Pinfield, *Libraries and Open Access: The Implications of Open-Access Publishing and Dissemination for Libraries in Higher Education Institutions*, in DIGITAL CONVERGENCE: LIBRARIES OF THE FUTURE 119, 123 (Rae Earnshaw & John Vince eds., 2008).

<sup>30</sup> SQW LTD., ECONOMIC ANALYSIS OF SCIENTIFIC RESEARCH PUBLISHING: A REPORT COMMISSIONED BY THE WELLCOME TRUST 3 (rev. ed. 2003) [hereinafter WELLCOME TRUST REPORT], available at [http://www.wellcome.ac.uk/stellent/groups/corporatesite/@policy\\_communications/documents/web\\_document/wtd003182.pdf](http://www.wellcome.ac.uk/stellent/groups/corporatesite/@policy_communications/documents/web_document/wtd003182.pdf).

<sup>31</sup> *Id.*

<sup>32</sup> Kranich, *supra* note 28, at 88.

<sup>33</sup> *Journals, the Cost of Education, and the Value We (Don't) Get for Our Money*, SPARC, <http://www.arl.org/sparc/students/journalvalue.shtml> (last visited June 3, 2012); Philippe C. Baveye, *Sticker Shock and Looking Tsunami: The High Cost of Academic Serials in Perspective*, 41 J. SCHOLARLY PUBLISHING 191, 194 (2010); OPEN SOC'Y INST., GUIDE TO BUSINESS PLANNING FOR LAUNCHING A NEW OPEN ACCESS JOURNAL 5 (2d ed. 2003), available at [http://www.soros.org/openaccess/pdf/business\\_planning.pdf](http://www.soros.org/openaccess/pdf/business_planning.pdf).

<sup>34</sup> John Willinsky, *The Nine Flavours of Open Access Scholarly Publishing*, 49 J. POSTGRADUATE MED. 263, 266 (2003).

<sup>35</sup> See GARY HALL, DIGITIZE THIS BOOK!: THE POLITICS OF NEW MEDIA, OR WHY WE NEED OPEN ACCESS NOW 42–43 (2008); see also Kranich, *supra* note 28, at 87–88.

<sup>36</sup> Pinfield, *supra* note 29, at 123; see also WELLCOME TRUST REPORT, *supra* note 30, at 15; THOMAS M. SUSMAN ET AL., PUBLISHER MERGERS: A CONSUMER-BASED APPROACH TO ANTITRUST ANALYSIS 23 (2003), available at <http://www.arl.org/bm~doc/whitepaperv2final.pdf> (“[D]ifferent journals in the same academic field are not substitutes in the same way that two brands of consumer products, like auto tires, might be. Since academic journals are the source of original research, each journal is in reality a poor substitute for any other in the same field.”).

even if the price increases because while the consumers of the content (researchers) will demand access to it, they are not the purchasers, so “price signals do not operate as they would in most markets.”<sup>37</sup> This enables publishers to impose price increases higher than the rate of inflation and well above production costs.<sup>38</sup> Indeed, the nature of the market allows publishers of must-have journals to gain market share through price *increases*, as they force libraries operating on fixed budgets to drop subscriptions to other journals that may be perceived as less essential.<sup>39</sup> These effects have led some researchers to conclude that the academic journal publishing market is dysfunctional.<sup>40</sup>

¶13 Adding insult to injury for university administrators, the universities themselves subsidize the production of much of the research and scholarship published in academic journals.<sup>41</sup> Universities pay the salaries of professors, assistants, and graduate students who perform the research and produce the scholarship, and universities routinely provide substantial grants and other funding to support research and scholarship. Universities also provide the physical means of scholarship production: laboratories, equipment, offices, libraries, and computers in and on which research is conducted, analyzed, and communicated in scholarly works. In other words, universities furnish many of the vital tools, inputs, and funds that make scholarship possible. The scholars who write the articles (and who are customarily treated as the copyright owners)<sup>42</sup> typically then transfer the copyright to journal publishers for no monetary compensation. Universities are then obliged to buy (or lease)<sup>43</sup> back, sometimes at extremely high prices, the scholarship they collectively supported and subsidized.

¶14 What do journals provide to scholars and universities in return for their fees? Journals add value by providing legitimization of scholarship through organizing the peer review process—a crucial component of open, rigorous scholarly inquiry.<sup>44</sup> Some journals provide substantive or technical editing services. Most importantly, however, journals offer branding. The names of the most famous journals in a given field are generally viewed as proxies for quality and cutting-edge scholarship. Scholars seek to have their works published in the most highly regarded journals because of the associated prestige, and universities view having access to those journals as critical to accessing the latest, most influential scholarship.

¶15 Digital distribution enabled by the Internet is a double-edged sword for academic publishers and universities. The Internet’s ubiquity has enabled widespread unauthorized duplication and dissemination of copyrighted works, including works of scholarship. It has also enabled and encouraged many scholars to authorize free dissemination of their

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<sup>37</sup> Pinfield, *supra* note 29, at 123; *see also* WELLCOME TRUST REPORT, *supra* note 30, at 15.

<sup>38</sup> Pinfield, *supra* note 29, at 123.

<sup>39</sup> *Id.*

<sup>40</sup> *Id.* (citing recent independent studies sponsored in Europe, SCIENCE AND TECHNOLOGY COMMITTEE, SCIENTIFIC PUBLICATIONS: FREE FOR ALL?, REPORT, 2003-4, H.C. 399-I (U.K.), *available at* <http://www.publications.parliament.uk/pa/cm200304/cmselect/cmsctech/399/399.pdf>; Directorate-General for Research, *Study on the Economic and Technical Evolution of the Scientific Publication Markets in Europe* (Jan. 2006), *available at* [http://ec.europa.eu/research/science-society/pdf/scientific-publication-study\\_en.pdf](http://ec.europa.eu/research/science-society/pdf/scientific-publication-study_en.pdf) (EC)).

<sup>41</sup> *See* CHRISTINE L. BORGMAN, SCHOLARSHIP IN THE DIGITAL AGE: INFORMATION, INFRASTRUCTURE, AND THE INTERNET 111 (2007).

<sup>42</sup> *See infra* Part III.B (discussing initial copyright ownership).

<sup>43</sup> *See infra* text accompanying notes 47–52.

<sup>44</sup> *See* BORGMAN, *supra* note 41, at 66.

scholarship by making their articles publicly available for free download from the web,<sup>45</sup> perhaps affecting the market for some journal subscriptions, and undoubtedly sparking deeper questions about the long-term viability of commercial academic publishing. At the same time, new digital information technologies have led to lucrative new business models for publishers, particularly in the form of vast databases of digitized works, both copyrighted and in the public domain, for which universities pay substantial access fees.<sup>46</sup>

¶16

The e-subscription approach allows publishers to deemphasize physical media (which are costly to produce and in some senses notoriously difficult to control once they are in the hands of users who can photocopy their pages, loan them, resell them, and so on) and shift to a service model, which allows publishers to license content—as opposed to selling physical copies—giving publishers far more control over pricing and use of the content.<sup>47</sup> Electronic subscription services offer unprecedented convenience, speed, and search functionality, but these features can come at a steep cost, both financially and in preservability terms. Annual subscription fees for a single electronic bundle from one publisher can range from half a million dollars to over \$2 million, further straining maxed-out library budgets.<sup>48</sup> Publishers frequently condition access to the most desired journals on the purchasing of less popular journals<sup>49</sup> or bundle a number of the most desired journals together, with minimal flexibility to select or cancel titles.<sup>50</sup> The bundling model effectively ensures publishers are able to charge more for top content and makes it more difficult for libraries to cancel subscriptions.<sup>51</sup> Because libraries frequently need to purchase licenses for multiple bundles to satisfy their collection requirements, they often pay for duplicate journals. Moreover, subscription-licensing terms limit database access to current subscribers only. If a university subscribes for a decade and then cancels, its access terminates. A school that purchases access to the same content year after year will not acquire a single permanent title in the end, despite spending millions of dollars.<sup>52</sup>

## 2. Peer-Review and the Scholarly Article Production Process

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The production process for scholarly articles varies among disciplines, but can generally be described as follows. It begins with research into a specific question, issue,

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<sup>45</sup> *Id.* at 88.

<sup>46</sup> Carroll, *supra* note 26, at 748.

<sup>47</sup> For example, academic publishers' digital licenses are often structured to require universities to pay on a per-use basis, a pricing model that was impossible with physical media. BORGMAN, *supra* note 41, at 112.

<sup>48</sup> Ted Bergstrom, *Watching Your Cards in the Big Deal*, ASS'N RES. LIBR. (May 3, 2011), <http://www.arl.org/bm~doc/mm11sp-bergstrom.pdf>.

<sup>49</sup> Kranich, *supra* note 28, at 87–88.

<sup>50</sup> Pinfield, *supra* note 29, at 123–24.

<sup>51</sup> *Id.*

<sup>52</sup> Adrienne Muir, *Digital Preservation: Awareness, Responsibility and Rights Issues*, 30 J. INFO. SCI. 73, 74 (2004). However, to address this concern, some publishers now permit “perpetual access,” that is, “the ability to retain access to previously paid for electronic journals after the contractual agreement for these materials has passed in the same way as the [sic] would have previously retained print copies on library shelves for future years.” *Perpetual Access*, OXFORD JOURNALS, [http://www.oxfordjournals.org/for\\_librarians/perpetual\\_access.html](http://www.oxfordjournals.org/for_librarians/perpetual_access.html) (last visited June 3, 2012). Oxford University Press, for example, permits subscribers to have perpetual access to PDF copies of journal volumes covered by a subscription even after the subscription has lapsed. *Id.*

or area, and the research and data-gathering in all disciplines builds upon and informs existing scholarship in the field. The next stage is the analysis and synthesis of the data or other products of the research, which scholars organize and synthesize with theories or commentary, ultimately reducing it to an article intended for publication in a scholarly journal. During this process (and often during the research stage as well), the scholar will usually communicate with peers about the research and resultant article, including private discussions with colleagues and peers, presentations of findings and theories at academic conferences, and seeking feedback by circulating preprints of an article privately among peers or publicly by posting it on a personal webpage, a university repository, or an open access repository such as arXive.org or SSRN.com.<sup>53</sup> All articles draw upon previous research and use citations to position themselves relative to prior scholarship in the field.<sup>54</sup>

¶18 When the article is ready to begin the publication process, the author submits it to journals, initiating a prepublication quality control process. In most disciplines (law is a notable exception),<sup>55</sup> this process involves formal peer review as the primary quality control mechanism.<sup>56</sup> Peer reviews are organized by journal staff; the reviewers are typically prominent scholars in the field selected by the journal to read and comment on submissions, and advise the journal on which papers to reject and which to accept and on which, if any, conditions (for example, that the article author make certain minor or substantial revisions). In hopes of assuring confidentiality and objectivity, the peer review process is typically “blind,” that is, the reviewers’ identities are withheld from the author. Sometimes the peer review process is “double blind,” meaning the author’s identity is also withheld from the reviewers.<sup>57</sup> Naturally, the more prestigious or influential a journal is, the more selective it tends to be.

¶19 Since the advent of e-journals and digital scholarship archives, several traditional functions of publishers have become less essential to the production and dissemination of scholarly articles—in particular, printing and binding, sales and distribution, and even layout and formatting.<sup>58</sup> Some of the services journals provide remain as valuable as ever to the article production process, notably the filtering and legitimization functions, including arranging peer reviews. Nevertheless, while there are certainly costs involved in providing these services, they do not necessarily justify the high prices many journals charge or the meteoric rise in pricing over the past two decades.<sup>59</sup> It is also notable that peer reviewers are usually not paid for their services.<sup>60</sup> The substance, quality, and utility

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<sup>53</sup> See BORGMAN, *supra* note 41, at 47–74.

<sup>54</sup> See *id.* at 47.

<sup>55</sup> See Carroll, *supra* note 26, at 751–54.

<sup>56</sup> See Fytton Rowland, *The Peer-Review Process*, 15 LEARNED PUBLISHING 247, 247 (2002).

<sup>57</sup> *Id.* at 247–48.

<sup>58</sup> This is not to suggest that digital distribution of scholarship is a panacea that provides a complete or perfect replacement to print publishing. One major challenge presented by electronic distribution is preservation. See Muir, *supra* note 52, at 73. Format compatibility raises other concerns. BORGMAN, *supra* note 41, at 245–48. Migrating the information to new formats has its own substantial risks and costs. *Id.*

<sup>59</sup> See Peter Suber, *Creating an Intellectual Commons Through Open Access*, in UNDERSTANDING KNOWLEDGE, *supra* note 28, at 171, 173.

<sup>60</sup> See *id.*; see also Leanne Tite & Sara Schroter, *Why Do Peer Reviewers Decline to Review?: A Survey*, 61 J. EPIDEMIOLOGY & COMMUNITY HEALTH 9, 9, 12 (2007).

of editing do not appear to have any correlation to whether the publisher is commercial or nonprofit.<sup>61</sup>

## B. *The Open Access Movement*

### 1. The Rise of the Movement

¶20 The combination of library budgets pressured by soaring journal costs and the high barriers to information access as a result of the traditional proprietary rights-based publishing model pushed many university librarians, administrators and faculty to vociferously pursue new publishing and distribution models for scholarship that utilize empowering and cost-reducing features of the Internet. A movement for “open access” scholarship emerged in the mid-1990s and has gained considerable momentum since, influenced by traditional open science norms as well as a number of closely connected social, political, and economic theories espousing the societal benefits of making scholarship publicly accessible and unfettered by financial, technological, or legal barriers.<sup>62</sup> Open access proponents argue that the optimal and inevitable solution to the dysfunctional academic publishing market and restrictive access to information is to make all scholarship freely and publicly available online.<sup>63</sup>

### 2. “Open Access” Does Not Equal “No Copyright”

¶21 Most open access advocates do not suggest that open access and copyright are mutually exclusive or that society would be better off if all copyright rights in scholarship were eliminated.<sup>64</sup> At a minimum, open access requires the copyright owner to grant

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<sup>61</sup> Aaron S. Edlin & Daniel L. Rubinfeld, *Exclusion or Efficient Pricing?: The “Big Deal” Bundling of Academic Journals*, 72 ANTITRUST L.J. 119, 120 (2004).

<sup>62</sup> See BORGMAN, *supra* note 41, at 101; Yochai Benkler, *The Idea of Access to Knowledge and the Information Commons: Long-Term Trends and Basic Elements*, in ACCESS TO KNOWLEDGE IN THE AGE OF INTELLECTUAL PROPERTY 217, 223–26 (Gaëlle Krikorian & Amy Kapczynski eds., 2010).

<sup>63</sup> See generally Nigel Shadbolt et al., *The Open Research Web*, in OPEN ACCESS: KEY STRATEGIC, TECHNICAL AND ECONOMIC ASPECTS, *supra* note 8, at 195, 195.

<sup>64</sup> Professor Shavell, however, has recently argued that a strong economic case can be made for statutorily abolishing copyright rights in all scholarship (scholarly articles as well as books and monographs). Steven Shavell, *Should Copyright of Academic Works be Abolished?*, 2 J. LEGAL ANALYSIS 301 (2010). In Professor Shavell’s view, since academic authors create scholarship for substantially nonmarket reasons, eliminating copyright protection for scholarship would have little impact on its production, and substantial social benefits would follow from making scholarship freely available. *Id.* at 301–04. Journals would, however, be affected, so he argues that universities and grantors should pay the journals publication fees so they can recover first-copy costs. *Id.* at 320–21. In sum, he argues that “[i]f publication fees would be largely defrayed by universities and grantors, as [he] suggest[s] would be to their advantage, then the elimination of copyright of academic works would be likely to be socially desirable: it would not compromise academic publication activity and would yield the social benefits of a copyright-free regime.” *Id.* at 304. Paradoxically, he reasons, the increased access to scholarly works brought about by eliminating copyright might incentivize scholars to publish *more* scholarship than they currently do because scholars would be getting more of what they are after: readership and esteem. *Id.* at 320–21.

Professor Shavell’s argument is compelling in many respects, and is attractive for the reasons he suggests. Nevertheless, the argument raises practical and philosophical difficulties. First, as Professor Shavell acknowledges, his proposal to amend the statute to eliminate copyright protection for scholarship potentially conflicts with U.S. intellectual property treaty obligations. *Id.* at 339 n.82. Second, this Author is less optimistic than Professor Shavell that the proposal would be well received by academics and universities. *Id.* at 340 (making the case for why universities and academics would be likely to favor



rights to the public permitting the public to view, copy, and distribute a work. The author's retention of rights in the work, however, is compatible with most definitions of open access. For example, the Harvard University Faculty of Arts and Sciences (FAS) permission mandate provides that the author retains copyright ownership in the work.<sup>65</sup> Likewise, the Budapest Open Access Initiative, an influential statement of open access principles, recognizes the need to grant users certain permissions while simultaneously ensuring scholars retain certain exclusive rights, namely the rights of attribution and integrity<sup>66</sup>—neither of which is expressly recognized for literary works under U.S. copyright law.<sup>67</sup> Thus open access content, as it is usually defined, is distinct from public domain content. In the case of open access works, the copyright owner retains some rights in the work but grants other rights to the public, while public domain content is accessible and usable by all for any purpose, with no individual or group holding exclusive rights.<sup>68</sup>

### 3. Two Forms of Open Access: Open Access Journals Versus Self-Archiving Scholarship Online

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In theory, building a comprehensive corpus of freely and publicly accessible scholarship is relatively straightforward. Proponents have identified two ways in which scholars can make their articles open access. One may choose to publish in one of the growing number of academic journals that make their publications freely available to the public online (sometimes called the “gold road” to open access). Alternatively, one may publish in a subscription-access journal but self-archive an e-print of the article in an online open access repository (sometimes called the “green road” to open access).<sup>69</sup>

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abolition of copyright in scholarship). That is true even if, as Professor Shavell recommends, *id.* at 337 n.79, Congress replaces economic rights in scholarship with the right of attribution. *See, e.g.,* Kevin Smith, *Maybe Not So Revolutionary After All*, SCHOLARLY COMMUNICATIONS @ DUKE, <http://blogs.library.duke.edu/scholcomm/2009/09/07/maybe-not-so-revolutionary-after-all/> (“My biggest concern with [Professor Shavell’s] proposal is that it neglects one benefit which academic authors do gain from copyright, the ability to control the dissemination of their work and, especially, the preparation of derivative works.”). Permission mandates, which do not divest academics of any of their copyright rights, seem far more politically palatable than a proposal to divest academics of *all* their present rights and supplant them with new and untested rights. Third, by seeking a statutory amendment to impose a top-down solution, the proposal further complicates an already bloated copyright statute with yet another subject-matter-specific carve-out, instituting a bright-line rule with dramatic, across-the-board effects that are difficult to predict. *See* Dan L. Burk & Mark A. Lemley, *Policy Levers in Patent Law*, 89 VA. L. REV. 1575, 1637-38 (2003) (“The copyright model . . . [is one] in which industry-specific rules and exceptions have led to a bloated, impenetrable statute that reads like the tax code . . .”).

<sup>65</sup> *See Harvard FAS Mandate, supra* note 11.

<sup>66</sup> *Read the Budapest Open Access Initiative, supra* note 3.

<sup>67</sup> *See* 17 U.S.C. § 106 (2011) (enumerating the exclusive rights granted by the Act). Nevertheless, the influence of “moral” rights can be found sprinkled throughout the U.S. Copyright Act. *See* ROBERT P. MERGES, JUSTIFYING INTELLECTUAL PROPERTY 156–58 (2011).

<sup>68</sup> *See, e.g.,* Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 U. DAYTON L. REV. 215, 256–62 (2003).

<sup>69</sup> *See* Stevan Harnad, *The Green Road to Open Access: A Leveraged Transition*, ELECTRONICS & COMPUTER SCI. (Jan. 7, 2004, 1:45 PM), <http://users.ecs.soton.ac.uk/harnad/Hypermail/Amsci/3379.html>; *Self-Archiving FAQ*, EPRINTS, <http://www.eprints.org/openaccess/self-faq/> (last visited June 3, 2012). Note that open access proponents strongly favor authors depositing their articles in open access repositories rather than making them available on the author’s personal web page. *See* Swan, *supra* note 8, at 71.

Once an article is freely accessible via either method, it is indexed by search engines such as Google and immediately locatable and retrievable by anyone with Internet access.<sup>70</sup>

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“Gold” open access, that is, publishing in and developing open access journals, is an important open access strategy, but some leading open access advocates do not view it as the main thrust of the movement for the time being. These advocates view persuading and motivating researchers and their institutions to make their works open access as a faster, more direct route to widespread open access than attempting to convert the entire academic publishing industry to a nonprofit open access model. As one commentator put it, “a transition to green [open access] self-archiving already rests entirely in the hands of the research community (researchers, their institutions and their funders), whereas a transition to gold [open access] publishing depends on the publishing community.”<sup>71</sup> The vast majority of academic journals worldwide—over ninety percent—are already compatible with green open access as they permit some form of open access self-archiving.<sup>72</sup> Of these journals, relatively few permit the author to self-archive a PDF of the final publication version of the article.<sup>73</sup> Most permit the author to archive either “preprints” (a version of the article before it has been formally peer-reviewed) or “postprints” (a version that has undergone peer review and final edits and is identical to the published version except for formatting and page numbering).<sup>74</sup> Many journals also require the author to observe an embargo period, typically up to twelve months following publication, during which the author may not self-archive any version of the article.<sup>75</sup> Others allow open access publication only if the author or the author’s institution pays a fee, typically several hundred to a few thousand dollars.<sup>76</sup>

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By most measures, the benefits of open access are significant. Several studies indicate that articles made freely available online are cited considerably more frequently than subscription-access-only articles,<sup>77</sup> although one recent study challenges that

<sup>70</sup> See Stephen Cramond, *Explainer: Open Access vs Traditional Academic Journal Publishers*, CONVERSATION (July 27, 2011, 7:03 AM), <http://theconversation.edu.au/explainer-open-access-vs-traditional-academic-journal-publishers-2511>.

<sup>71</sup> Stevan Harnad, *Gold Dust Still Obscuring the Clear Green Road to Open Access*, OPEN ACCESS ARCHIVANGELISM (May 31, 2011, 2:27 PM), <http://openaccess.eprints.org/index.php?/archives/813-Gold-Dust-Still-Obscuring-the-Clear-Green-Road-To-Open-Access.html>. *But see* Peter Murray-Rust, *The Benefits and Limitations of Green Open Access*, PETERMR’S BLOG (July 20, 2011, 5:47 PM), <http://blogs.ch.cam.ac.uk/pmr/2011/07/20/the-benefits-and-limitations-of-green-open-access/> (arguing that the clarity of licenses provided for gold open access content and the fact that gold open access articles may be more readily located, linked to, and data mined because they “may be systematically discovered by iterating through the publisher’s tables of contents,” are significant advantages over green open access).

<sup>72</sup> *Publisher Policies on Self-Archiving*, OPEN ACCESS SCHOLARLY INFO. SOURCEBOOK, [http://www.openoasis.org/index.php?option=com\\_content&view=article&id=552&Itemid=375](http://www.openoasis.org/index.php?option=com_content&view=article&id=552&Itemid=375) (last visited June 3, 2012).

<sup>73</sup> *Id.*

<sup>74</sup> *Id.*

<sup>75</sup> See Bo-Christer Björk et al., *Open Access to the Scientific Journal Literature: Situation 2009*, PLOS ONE, June 23, 2010, <http://www.plosone.org/article/info%3Adoi%2F10.1371%2Fjournal.pone.0011273>.

<sup>76</sup> For a list of publishers providing the author-pays open access option, see *Publishers with Paid Options for Open Access*, SHERPA ROMEO, <http://www.sherpa.ac.uk/romeo/PaidOA.html> (last updated May 2, 2012).

<sup>77</sup> See HALL, *supra* note 35, at 47 (citing studies indicating that open access articles are cited two to four times more frequently than their subscription-access-only counterparts). One study examined the research impact of more than 27,000 articles in subscription-access journals, about 22 percent of which had also been made available in open access repositories. Gargouri et al., *supra* note 7, at 1, 3. It found that “[o]verall, [open access] articles are cited significantly more than non-[open access] articles,” however

conclusion.<sup>78</sup> That study does suggest, however, that making one's article open access significantly boosts readership, if not citations.<sup>79</sup> Increased citations and readership is important in a profession in which scholarly impact is the coin of the realm. The broader societal benefits of open access are self-evident. Knowledge is an essential social resource, vital to education, cultural and physical well-being, as well as political self-determination. Information is not just consumed; it also functions as an input in its own production process.<sup>80</sup> The creation of new knowledge is made possible only by accessing preexisting knowledge to build upon, test, assimilate, and incorporate. The greater the access is to the existing corpus of knowledge, the greater the potential for new knowledge to be created. As the cliché goes, no library in the world can afford to purchase and store all 2.5 million scholarly articles published annually in the 25,000 scholarly journals that exist worldwide. Thus, in theory, open access has the potential to benefit researchers at every institution, rich or poor. But the benefits of open access are especially evident to institutions in the United States and around the world that cannot afford expensive subscription access.<sup>81</sup> In short, "open access of information provides a universal public

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"[t]he [open access] advantage is greater for the more citable articles, not because of a quality *bias* from authors self-selecting what to make [open access], but because of a quality *advantage*, from users self-selecting what to use and cite, freed by [open access] from the constraints of selective accessibility to subscribers only." *Id.* at 1. Another study examined the research impact of law review articles by studying citation rates over an eighteen year period for self-archived open access articles versus subscription-access-only articles published in the same three subscription access law reviews. James M. Donovan & Carol A. Watson, *Citation Advantage of Open Access Legal Scholarship* 103 L. LIBR. J. 553 (2011). The authors concluded that

[t]he open access advantage reported for other bodies of literature extends to legal scholarship, albeit with some identified caveats. Open access is most likely to impact other legal scholarship, less so the citations within court opinions. The expected impact of the average article is an additional fifty-eight percent above that made by works of similar quality appearing in the same or similar publication venue.

*Id.* at 573.

<sup>78</sup> Philip M. Davis, *Open Access, Readership, Citations: A Randomized Controlled Trial of Scientific Journal Publishing*, 25 FASEB J. 2129, 2129 (2011) (examining the research impact of 3,245 subscription-access journal articles, 21 percent of which were randomly selected by the journal publishers for concurrent open access release, and concluding that the open access articles "received significantly more downloads and reached a broader audience . . . , yet were cited no more frequently, nor earlier, than subscription-access control articles . . . . These results may be explained by social stratification, a process that concentrates scientific authors at a small number of elite research universities with excellent access to the scientific literature. The real beneficiaries of open access publishing may not be the research community but communities of practice that consume, but rarely contribute to, the corpus of literature.").

<sup>79</sup> *See id.* at 2131 (finding no advantage in the frequency with which open access articles are cited but noting a significant increase in readership of open access versus subscription-access-only articles).

<sup>80</sup> *See* Michael J. Madison et al., *Constructing Commons in the Cultural Environment*, 95 CORNELL L. REV. 657, 672 (2010); YOCHAI BENKLER, *THE WEALTH OF NETWORKS: HOW SOCIAL PRODUCTION TRANSFORMS MARKETS AND FREEDOM* 37 (2006).

<sup>81</sup> *See* YOUNG, *supra* note 2, at 5 (2009) ("[S]cholars in the developing world find themselves unable to fully participate in or benefit from research. While some publishers provide free or discounted access in developing countries, not all publishers participate, and countries like India are left out.") (footnote omitted); Peter Murray-Rust, *What's Wrong with Scholarly Publishing? It's Only for Academics*, PETERMR'S BLOG (Aug. 2, 2011, 12:54 PM), <http://blogs.ch.cam.ac.uk/pmr/2011/08/02/what's-wrong-with-scholarly-publishing-it's-only-for-academics/>. *But see* Andrew Robinson, *Open Access: The View of a Commercial Publisher*, 4 J. THROMBOSIS & HAEMOSTASIS 1454, 1456 (2006) ("Open access to research literature would significantly improve the quality of health care and scientific research in some of the world's poorest nations, or so the story goes. So, what about HINARI, the Health InterNetwork Access to Research Initiative that is jointly administered with the World Health Organization? This philanthropic

good: the more quality information, the greater the public good.”<sup>82</sup> For these reasons, most scholars agree in principle with open access scholarship.<sup>83</sup>

#### 4. The Emergence of Open Access Mandates

¶25 Despite widespread agreement with open access principles, researchers voluntarily self-archive a relatively small percentage of articles—about fifteen to twenty percent—in open access repositories,<sup>84</sup> even in universities that have established their own institutional repositories and encourage faculty to self-archive.<sup>85</sup> Efforts by funders to encourage open access have had equally tepid results. When the National Institutes of Health (NIH)<sup>86</sup>—following a Congressional directive—implemented a policy in 2005 requesting but not requiring that publications resulting from NIH funding be made freely available in NIH’s open access repository, the participation rate was around nineteen percent.<sup>87</sup> There are myriad reasons<sup>88</sup> for the low participation rates, but among the more pronounced are: a lack of researcher awareness of open access;<sup>89</sup> researcher concerns that articles in electronic formats are less permanent and more alterable or corruptible than those in print;<sup>90</sup> researcher concerns and misconceptions about infringing copyrights by self-archiving their own articles or downloading others’ open access articles;<sup>91</sup> researcher concerns that self-archiving an article before publication will render it unpublishable in a journal;<sup>92</sup> and researcher concerns that open access generally threatens the survival of smaller, learned societies reliant on journal publication income.<sup>93</sup>

¶26 Given the low voluntary participation rates, open access advocates recognize that their goal of one day seeing all of the world’s scholarly output freely available online<sup>94</sup> is

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initiative was launched in 2002, and makes available online across 1590 institutions in 113 countries, over 3230 journals from more than 60 publishers . . . . So, the subscription is not the problem, and yet, in reality, usage of JTH [the *Journal of Thrombosis and Haemostasis*] is depressingly low. How can this be, if there is an insatiable appetite for knowledge that can only be met by [open access]? Maybe it is because the basic infrastructure is absent.”)

<sup>82</sup> Charlotte Hess & Elinor Ostrom, *Introduction: An Overview of the Knowledge Commons*, in UNDERSTANDING KNOWLEDGE, *supra* note 28, at 3, 13.

<sup>83</sup> See Eyal Amiran, *The Open Access Debate*, 18 SYMPLOKE 251, 252 (2010); Alma Swan & Sheridan Brown, *Authors and Open Access Publishing*, 17 LEARNED PUBLISHING 219, 223 (2004).

<sup>84</sup> Gargouri et al., *supra* note 7, at 1 (“Only about 15–20% of the 2.5 million articles published annually worldwide are being self-archived by their authors today.”).

<sup>85</sup> *Id.*

<sup>86</sup> The National Institutes of Health, an agency of the U.S. Department of Health and Human Services, is the world’s largest funder of medical research, funding research at universities in every state in the United States and around the world. *About NIH*, NAT’L INSTS. OF HEALTH, <http://www.nih.gov/about/> (last updated Dec. 5, 2011).

<sup>87</sup> See NAT’L INSTS. OF HEALTH, *Capitalizing on Discovery*, in BIENNIAL REPORT OF THE DIRECTOR: NATIONAL INSTITUTES OF HEALTH, FISCAL YEARS 2008 & 2009, ABOUT NIH 1-39, 1-41 (2010), available at [http://report.nih.gov/biennialreport/pdf/NIH\\_Biennial\\_FY0809\\_Volume\\_I.pdf](http://report.nih.gov/biennialreport/pdf/NIH_Biennial_FY0809_Volume_I.pdf).

<sup>88</sup> See *Self-Archiving FAQ*, *supra* note 69 (listing (and refuting) thirty-eight concerns about open access commonly expressed by researchers).

<sup>89</sup> Swan, *supra* note 8, at 70.

<sup>90</sup> *Self-Archiving FAQ*, *supra* note 69.

<sup>91</sup> *Id.*

<sup>92</sup> *Id.*

<sup>93</sup> See Vanessa Spedding, *Will Learned Societies Signal the Change?*, RES. INFO., May/June 2004, [http://www.researchinformation.info/features/feature.php?feature\\_id=117](http://www.researchinformation.info/features/feature.php?feature_id=117).

<sup>94</sup> See Stevan Harnad, *Open Access*, EPRINTS, <http://www.eprints.org/openaccess/> (last visited June 3,

unattainable through reliance on researchers' good will alone.<sup>95</sup> Moreover, surveys indicate that nearly all researchers (ninety-five percent) would self-archive their articles if a university or funder mandate compelled them to do so.<sup>96</sup> Many open access advocates therefore argue that maximizing participation is best achieved through institutional or funder mandates that require faculty or researchers to make their articles freely accessible online.<sup>97</sup> Open access advocates, therefore, have sought the development and proliferation of mandates imposed by funders or universities requiring researchers to deposit their works in an online open access repository. Two types of mandates have developed: (1) "deposit" mandates, which require faculty members themselves to deposit their scholarly articles in an open access repository, and (2) "permission" mandates, which grant the institution a license to, at a minimum, reproduce and distribute articles produced by its faculty.<sup>98</sup>

i) *Deposit Mandates*

¶27 The Wellcome Trust and the NIH are both funding institutions that employ deposit mandates. Since 2005, the Wellcome Trust, the United Kingdom's largest non-governmental biomedical research funder, has made open access a condition of funding. Specifically, it requires that "electronic copies of any research papers that have been accepted for publication in a peer-reviewed journal, and are supported in whole or in part by Wellcome Trust funding," be made publicly available in PubMed Central, the NIH's full-text open access article repository,<sup>99</sup> within six months of publication.<sup>100</sup> Beginning in 2008, the NIH amended its policy at Congress's direction from one that encourages open access to one that requires funding recipients to deposit their resultant postprint research articles in PubMed Central within twelve months of publication.<sup>101</sup> So far, the results have largely borne out predictions that switching from a policy encouraging open access to one mandating it would increase participation rates: in the first year following the NIH switch, participation rates leapt from nineteen percent to nearly sixty percent.<sup>102</sup>

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2012).

<sup>95</sup> See, e.g., *Open Access Policies for Universities and Research Institutions*, ENABLING OPEN SCHOLARSHIP, [http://www.openscholarship.org/jcms/c\\_6226/open-access-policies-for-universities-and-research-institutions?hlText=policie](http://www.openscholarship.org/jcms/c_6226/open-access-policies-for-universities-and-research-institutions?hlText=policie) (last visited June 3, 2012) [hereinafter *Open Access Policies*] ("Policies that rely on voluntary action by researchers fail.").

<sup>96</sup> See Swan, *supra* note 8, at 69, 70 fig.7.4.

<sup>97</sup> See, e.g., David Shulenburg, *University Public-Access Mandates Are Good for Science*, PLOS BIOLOGY, Nov. 10, 2009, at 2, <http://www.plosbiology.org/article/info%3Adoi%2F10.1371%2Fjournal.pbio.1000237> ("The most effective method of ensuring that the majority of important work is available is by replicating across the academy university public-access mandates like those of Harvard, MIT, and Kansas throughout the world."); *Open Access Policies*, *supra* note 95 ("The fact is that if research managers wish to establish a repository that successfully gathers together the whole output of the institution, then a mandatory Open Access policy is needed.").

<sup>98</sup> See Suber, *supra* note 2.

<sup>99</sup> See PUBMED CENTRAL, <http://www.ncbi.nlm.nih.gov/pmc/> (last visited June 3, 2012).

<sup>100</sup> *Open Access Policy: Position Statement in Support of Open and Unrestricted Access to Published Research*, WELLCOME TRUST, <http://www.wellcome.ac.uk/About-us/Policy/Spotlight-issues/Open-access/Policy/index.htm> (last visited June 3, 2012). The Wellcome Trust requires that articles be made available through both the U.S. and U.K. versions of PubMed Central. *Id.*

<sup>101</sup> NAT'L INSTS. OF HEALTH, *supra* note 87, at 1-41.

<sup>102</sup> *Id.*

Proposed legislation in the United States would require that eleven U.S. government agencies adopt deposit mandates for research resulting from funding.<sup>103</sup>

¶28 A number of universities and departments within universities have also adopted policies requiring faculty to self-archive their scholarly articles in an institutional open-access repository. Worldwide since 2004, well over one hundred universities and nearly fifty institutions that fund research have adopted policies mandating that their faculty or funding recipients deposit their works in an online open access repository.<sup>104</sup>

ii) *Permission Mandates*

¶29 The 2008 Harvard University FAS mandate was the first *permission* mandate adopted anywhere, and most U.S. schools that have adopted mandates have followed the general form and language of the FAS mandate.<sup>105</sup> The FAS mandate was also the first mandate adopted by university faculty and not imposed by administrators: the FAS faculty voted unanimously to bind itself to the policy terms. At the time of this writing, thirty-three U.S. schools and departments have adopted mandates, the vast majority of which are permission mandates. Schools that have adopted permission mandates include: the Massachusetts Institute of Technology; seven schools within Harvard University;<sup>106</sup> Duke University; Princeton University; Oberlin College; Trinity University; the University of North Texas; the University of Kansas; Emory University; and Stanford University School of Education.<sup>107</sup>

¶30 Deposit mandates' key limitation is their reliance on the participation of each faculty member. Permission mandates, on the other hand, empower the school to proactively archive by purporting to grant the institution a broad, nonexclusive license to exercise all copyright rights in every faculty member's scholarly articles, though usually limited to nonprofit uses only. Under the terms of the Harvard FAS policy,

Each Faculty member grants to the President and Fellows of Harvard College permission to make available his or her scholarly articles and to exercise the copyright in those articles. In legal terms, the permission granted by each Faculty member is a nonexclusive, irrevocable, paid-up, worldwide license to exercise any and all rights under copyright relating to each of his or her scholarly

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<sup>103</sup> See Federal Research Public Access Act of 2010, H.R. 5253, 111th Cong. (2010). *But see* Research Works Act, H.R. 3699, 112th Cong. (2011) (proposing to repeal the NIH public access policy).

<sup>104</sup> See ROARMAP, *supra* note 5.

<sup>105</sup> Suber, *supra* note 2.

<sup>106</sup> At the time of this writing, the Faculty of Arts and Sciences, Harvard Law School, the John F. Kennedy School of Government, the Graduate School of Education, Harvard Business School, Harvard Divinity School, and the Graduate School of Design have all adopted a sub-institutional mandate. *Id.* Harvard's governance structure involves considerable sub-institutional autonomy, thus the policies are not adopted university wide. Most faculties within the university have adopted a mandate similar to the FAS policy.

<sup>107</sup> ROARMAP, *supra* note 5. At the time of this writing, a permission mandate is under discussion at the University of California. See generally UNIVERSITY COMMITTEE ON THE LIBRARY AND SCHOLARLY COMMUNICATION, AN OPEN ACCESS POLICY FOR THE UNIVERSITY OF CALIFORNIA: MATERIALS FOR DISCUSSION AND CONSULTATION (Mar. 1, 2012), available at <http://osc.universityofcalifornia.edu/openaccesspolicy/UCOLASC-Open-Access-Policy-Discussion-Documents-March2.pdf>.

articles, in any medium, and to authorize others to do the same, provided that the articles are not sold for a profit.<sup>108</sup>

¶31 The FAS policy's opt-out regime is key to its structure.<sup>109</sup> To make the policy politically palatable, it provides that "[t]he Dean or the Dean's designate will waive application of the policy for a particular article upon written request by a Faculty member explaining the need."<sup>110</sup> Thus, the policy sets the default 180 degrees from that of the traditional grant of copyright rights: instead of requiring every individual faculty member to expressly grant the school a nonexclusive license for every scholarly article, the school, by virtue of the policy, automatically acquires a prospective nonexclusive license to archive and distribute every scholarly article for which a faculty member has not expressly opted out.<sup>111</sup> Regarding the legal mechanics of the waiver provision, because the license is expressly irrevocable, a faculty member's request that the policy be waived should not to be construed as a revocation. Rather, the waiver provision appears to be best construed as a binding commitment by the school to abandon its license upon the faculty member's request.<sup>112</sup> Although some observers argue that any policy that is waivable is not really a mandate at all,<sup>113</sup> this Article refers to the policy as a mandate since it is typically referred to that way and because the policy does in fact set as the default a mandatory grant of a nonexclusive license.

¶32 Unsurprisingly, permission mandates "directly contradict the publication policies of most scientific journals, and as such have led to difficult negotiations between publishers and universities adopting this approach."<sup>114</sup> As a result, some mandate schools and publishers have agreed to an embargo period of six to twelve months following publication during which the article cannot be deposited in an open access repository.<sup>115</sup> In addition, Harvard encourages its faculty to request that publishers sign an author-proposed addendum to the publisher's standard publication agreement.<sup>116</sup> The addendum modifies the publication agreement to permit authors to retain various rights including the

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<sup>108</sup> *Harvard FAS Mandate*, *supra* note 11.

<sup>109</sup> See THINH NGUYEN, OPEN DOORS AND OPEN MINDS: WHAT FACULTY AUTHORS CAN DO TO ENSURE OPEN ACCESS TO THEIR WORK THROUGH THEIR INSTITUTION 2 (2008), *available at* [http://sciencecommons.org/wp-content/uploads/opendoors\\_v1.pdf](http://sciencecommons.org/wp-content/uploads/opendoors_v1.pdf).

<sup>110</sup> *Harvard FAS Mandate*, *supra* note 11.

<sup>111</sup> According to Stuart Shieber, who chaired of the faculty committee that recommended adoption of the FAS mandate, "by specifying rights retention and deposit for those cases where a waiver does not occur, [the policy] places the defaults in a better place. Such changes in default are known to have dramatic effect on participation rates for activities ranging from 401K participation to organ donation." Shieber, *supra* note 9.

<sup>112</sup> For a discussion of the judicial doctrine of copyright abandonment, which of course typically arises in the context of abandoning copyright ownership or exclusive rights, not nonexclusive licenses, see Lydia Pallas Loren, *Building a Reliable Semicommons of Creative Works: Enforcement of Creative Commons Licenses and Limited Abandonment of Copyright*, 14 GEO. MASON L. REV. 271, 319–22 (2007).

<sup>113</sup> See, e.g., Shieber, *supra* note 9 ("As any dean will tell you, there is no such thing as a mandate on faculty."); Stevan Harnad, *Optimizing Harvard's Proposed Open Access Self-Archiving Mandate*, OPEN ACCESS ARCHIVANGELISM (Feb. 12, 2008), <http://openaccess.eprints.org/index.php?/archives/361-guid.html>.

<sup>114</sup> Jorge L. Contreras, *Data Sharing, Latency Variables, and Science Commons*, 25 BERKELEY TECH. L.J. 1601, 1654 (2010).

<sup>115</sup> *Id.*

<sup>116</sup> See *Amend a Publishing Agreement*, HARV. U. LIBR. OFF. FOR SCHOLARLY COMM. (2010), <http://osc.hul.harvard.edu/authors/amend>.

right to reproduce and distribute the article, and expressly provides that the author's transfer of copyright ownership to the publisher is subject to the prior grant of a nonexclusive license to the author's institution or funder.<sup>117</sup> Harvard also requests that its faculty back up the permission mandate license by memorializing the nonexclusive license grant in a separate, signed writing.

### III. THE INTERRELATIONSHIP BETWEEN COPYRIGHT, SCHOLARSHIP, AND OPEN ACCESS

#### A. *Utilitarian Theory, Nonmarket Information Production, and Uniformity Costs*

¶33 As literary works, scholarly articles are protected by copyright law.<sup>118</sup> Copyright law is designed to remedy an appropriability problem inherent in information products.<sup>119</sup> The problem stems from the fact that information in whatever form—text in a book or article, a song, a film, or some other medium of expression—is “nonrivalrous” in economic terms. That is, the same information can exist in infinite minds or copies simultaneously, and one person's possession and enjoyment of it does not reduce its availability to everyone else.<sup>120</sup> Indeed, millions of others can copy that same work (as is often the case with popular works on the Internet), and all can simultaneously possess and enjoy copies of it.

¶34 Because information is nonrivalrous, economic theory presumes that information goods are subject to a “public goods” problem. That is, if authors are unable to cost-effectively exclude competitors and nonpaying consumers from copying and consuming their information goods (such as books, movies, and so on), authors will be unable to recover their costs of producing information goods. Authors will then cease to invest their time and efforts in creating them, resulting in underproduction of valuable information goods to society's detriment.<sup>121</sup> Copyright's exclusive rights allow authors to capture the economic value of their information goods by erecting around the work legal barriers to access. Thus, the utilitarian rationale for copyright is that social welfare is maximized when the greatest number of new works of knowledge and information are created, and that economic incentives enabled by exclusive rights are necessary to stimulate maximum production of creative works. To achieve the optimal outcome, the exclusive rights should be limited so as not to extend any further than is necessary to produce the optimal level of creative output, otherwise society's compelling interest in

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<sup>117</sup> See Scholarly Publ'g and Academic Res. Coal., *Author Rights: Using the SPARC Author Addendum to Secure Your Rights as the Author of a Journal Article* (2006), <http://www.arl.org/sparc/author/addendum.shtml> (providing an addendum template). The author addendum proposed by the Scholarly Publishing and Academic Resources Coalition (SPARC) provides that “where applicable . . . Publisher acknowledges that Author's assignment of copyright or Author's grant of exclusive rights in the Publication Agreement is subject to Author's prior grant of a non-exclusive copyright license to Author's employing institution and/or to a funding entity that financially supported the research reflected in the Article as part of an agreement between Author or Author's employing institution and such funding entity, such as an agency of the United States government.” *Id.*

<sup>118</sup> See 17 U.S.C. § 102(a) (2011) (providing that copyright protection subsists “in original works of authorship fixed in any tangible medium of expression” and including the broad category “literary works” among its eight enumerated subject matter categories).

<sup>119</sup> See Carroll, *supra* note 24, at 849–50.

<sup>120</sup> A key point here, of course, is that the copyrighted work contained in the pages of the book and represented by the words on the page is distinct from any particular physical copy of the book.

<sup>121</sup> See Madison et al., *supra* note 80, at 666.



having reasonable access to that knowledge is unnecessarily burdened, resulting in a net social loss.<sup>122</sup> The assumption that exclusive rights are necessary to spur the production of valuable works greatly influenced the development of U.S. copyright law.<sup>123</sup>

¶35 Some, however, criticize the argument that exclusive rights are indispensable to the information production process as “woefully inadequate as a descriptive matter” and “a caricature”<sup>124</sup> because the exclusive rights-based models “represent only a fraction of our information production system.”<sup>125</sup> Scholarship is a well-cited example of an entire stratum of valuable information produced outside the exclusive rights—or market—production model.<sup>126</sup> Incentives for producing scholarly articles might range from a desire to attain tenure and career advancement, to attracting grant and research funding, to attracting consulting work, to receiving feedback from and engaging intellectually with peers, to an altruistic desire to share and disseminate knowledge, and often some combination of these. But *direct* financial compensation from scholarly articles is not part of the equation since publishers do not pay scholars, and scholars do not earn royalties from the publication of their articles.<sup>127</sup>

¶36 From a utilitarian perspective, intellectual property laws always impose “uniformity costs” as they grant entitlements that are sometimes stronger than necessary to motivate investment in innovation.<sup>128</sup> The law does not discriminate based on author motivation or industry context—it grants the same entitlements and the same rules apply regardless of the circumstances of a work’s creation. If a work protected under the current copyright law would have been created even under a regime of weaker or no copyright, then society suffers a net loss vis à vis that work because public access is restricted more than necessary.<sup>129</sup> Nevertheless, society’s access to both is limited

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<sup>122</sup> See generally William Fisher, *Theories of Intellectual Property*, in *NEW ESSAYS IN THE LEGAL AND POLITICAL THEORY OF PROPERTY* 168 (Stephen R. Munzer ed., 2001).

<sup>123</sup> See Madison et al., *supra* note 80, at 667 (“At the core of IP law, as traditionally conceived, is the right to exclude, without which it is assumed that some producers would abandon their efforts for fear of free riding (unlicensed sharing) by competitors.”).

<sup>124</sup> *Id.* at 668.

<sup>125</sup> BENKLER, *supra* note 80, at 44.

<sup>126</sup> The generally nonmarket motivations of academic researchers are separate from the question of the extent to which the university enterprise and the research itself are supported by direct or indirect collateral revenue streams based on exclusive rights, such as teaching services and tuition. For a discussion of how the university information commons is embedded within and supported by a larger complex system of proprietary rights, public funding, and gifts, see Jonathan M. Barnett, *The Illusion of the Commons*, 25 *BERKELEY TECH. L.J.* 1751, 1799–1804 (2010).

<sup>127</sup> See, e.g., BENKLER, *supra* note 80, at 47, 97 (citing universities and other research institutes as examples of nonmarket information production and asserting that “the academic who writes for money is rendered suspect in her community of scholarship”); Suber, *supra* note 59, at 174–75 (“The focus of the [Open Access] movement is on a special category of content that does *not* earn royalties for its creators: peer-reviewed research articles and their preprints. . . . [A]uthors want their work to be noticed, read, taken up, built upon, applied, used, and cited. . . . These intangible rewards (made nearly tangible in tenure and promotion) compensate scholars for relinquishing royalties on their journal articles.”); Jessica Litman, *The Economics of Open Access Law Publishing*, 10 *LEWIS & CLARK L. REV.* 779, 782 (2006) (“The role of copyright in the dissemination of scholarly research is in many ways curious, since neither authors nor the entities that compensate them for their authorship are motivated by the incentives supplied by the copyright system. . . . The authors of scholarly works (and the institutions that pay their salaries and support their research) have had no objection to paying for publishing in the currency of copyrights, since the copyrights had little intrinsic value in the academy.”).

<sup>128</sup> See Carroll, *supra* note 24, at 849–50.

<sup>129</sup> *Id.*

uniformly. Applying copyright law to scholarly articles clearly results in over-inclusion and overprotection: scholarly articles face neither an appropriability problem (academic authors are compensated through salaries and do not sell their articles) nor an underproduction problem (production of scholarly articles does not rely on economic incentives or the market). Thus, the restricted access to scholarship is a higher price than society needs to pay to ensure its production.

¶37 While the literature on uniformity costs generally focuses on costs resulting from uniformity of intellectual property entitlements granted,<sup>130</sup> such entitlement grants are embodied in rules. One can say more broadly, then, that uniformity costs can result from applying to one context intellectual property rules devised presuming a different context. For example, the poor interface, discussed below, between copyright's work made for hire rules and scholarly articles means those rules could easily lead to a result—a finding that the university is the legal author and owner of scholarly articles written by faculty—that profoundly contradicts academic tradition and defies the expectations of all stakeholders (faculty, universities, and publishers). The resultant costs are uncertainty about the legal entitlements each of these stakeholders holds, and potential disruption of the core academic community value of academic freedom.

*B. Initial Ownership: The Effect of Copyright's Work Made for Hire Rules on Scholarship*

¶38 An examination of copyright law's work made for hire rules is significant for two reasons. First, since much of the discussion in this Article involves attempts to allocate copyright rights in scholarship, it is important to understand the surprisingly unsettled issue of who owns scholarship from the outset—the faculty member or the university. Second, the uncertainty resulting from applying the work made for hire rules to scholarship demonstrates uniformity costs of applying to a nonmarket information production model rules that were developed according to a proprietary conception of copyright.<sup>131</sup> This Section proceeds by providing an overview of the issues raised by applying copyright law's work made for hire doctrine to scholarship, discussing the judicially crafted “teacher exception” to the work made for hire rules, and discussing university policies, adopted in nearly all major research universities, that purport to recognize faculty copyright ownership in scholarship notwithstanding the work made for hire rules. Lastly, this Section discusses the implications of university ownership of scholarship for academic freedom.

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<sup>130</sup> See, e.g., Carroll, *supra* note 24, at 856–57 (introducing a dual typology of uniformity costs, both types highlighting the uniformity of rights and entitlements granted despite varying appropriability problems facing creators: “Type I uniformity costs arise when the creators of the same class of subject matter face different magnitudes or types of the appropriability problem” but the law supplies the same rights and entitlements to all creators of that subject matter anyway; “Type II” uniformity costs result from varying appropriability problems not within the same industry or technological field but between different industries and technological fields).

<sup>131</sup> See Timothy K. Armstrong, *Shrinking the Commons: Termination of Copyright Licenses and Transfers for the Benefit of the Public*, 47 HARV. J. ON LEGIS. 359, 378 (2010) (noting “the underlying bias of contemporary copyright law in favor of proprietary production”).

## 1. Applying the Work Made for Hire Doctrine to Scholarship

¶39 Ambiguity concerning the application of copyright law’s “work made for hire doctrine” to scholarship raises significant questions about whether scholars or their institutions are the initial copyright owners of scholarly works. The general rule concerning copyright ownership is that it “vests initially in the author or authors of the work.”<sup>132</sup> In most instances, of course, the “author” is the individual (or individuals) who actually created and fixed the work. There is an important exception to this general rule, however. In instances in which the author is an “employee” and creates the work “within the scope of his or her employment,” the Copyright Act provides that the work is “made for hire” and vests authorship and copyright ownership in the employer, although the employer and employee may expressly agree in a writing signed by both parties that the employee owns the copyright.<sup>133</sup> The Copyright Act does not define “employee” or “scope of employment.” However, the Supreme Court has held that one should consult agency law rules, as summarized in the Restatement (Second) of Agency, to determine whether to classify an individual as an employee (in which case the employer owns the copyright if the work was made within the scope of the employment) or an independent contractor (in which case the individual owns the copyright).<sup>134</sup> The Restatement factors are meant to identify objective indicators of the existence (or lack thereof) of a conventional employer–employee relationship.<sup>135</sup> The nonexhaustive list of factors to consider includes: (1) whether the employer has the right to control the manner and means by which the work was completed; (2) the skill required to complete the work; (3) the source of the instrumentality and tools used to perform the work (including the provision of office space, computers, printers, and so on); (4) the location of the work; (5) the duration of the relationship between the parties; (6) the method of payment (for example, a recurring salary versus a one-time remuneration); (7) whether the hiring party has the right to assign additional projects to the hired party; (8) the extent of the hired party’s discretion over when and how long to work; (9) the method of payment; (10) the hired party’s role in hiring and paying assistants; (11) whether the work is part of the regular business of the hiring party; (12) whether the hiring party is in business; (13) provision of employee benefits; and (14) the tax treatment of the hired party (for example, whether or not the employer withholds taxes).<sup>136</sup>

¶40 It seems intuitive that a full-time, salaried professor at a university is an employee, and applying the aforementioned *Reid* agency law factors to the university–scholar

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<sup>132</sup> 17 U.S.C § 201(a) (2011).

<sup>133</sup> *Id.* §§ 101, 201(b). As an alternative basis for finding that a work is “made for hire,” the statute enumerates nine specific categories of commissioned works created by independent contractors that can qualify as works for hire if the parties “expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.” *Id.* § 101. The nine specifically enumerated categories are: (1) a contribution to a collective work; (2) part of a motion picture or other audiovisual work; (3) a translation; (4) a supplementary work; (5) a compilation; (6) an instructional text; (7) a test; (8) answer material for a test; and (9) an atlas. *Id.*

<sup>134</sup> *Cmt. for Creative Non-Violence v. Reid*, 490 U.S. 730, 739 (1989) (citing RESTATEMENT (SECOND) OF AGENCY § 220 (1958)). Of course, even if the individual is deemed to be an independent contractor, the work could still be a work for hire if it falls within one of the nine enumerated categories in the definition of work for hire in § 101 and the parties expressly agree in a written instrument signed by them that it shall be considered a work made for hire. *See supra* note 133.

<sup>135</sup> *See Reid*, 490 U.S. at 752.

<sup>136</sup> *Id.* at 751–52.

relationship bears out that intuition. After all, universities typically supply the key tools of the professor's trade (library, books, office, computer, research stipends, administrative assistance, and so on), they typically provide professors with health insurance and other employee benefits, they typically pay professors regular, ongoing salaries, and they typically treat them as employees for tax purposes, withholding federal and state taxes. Not all of the *Reid* factors necessarily point toward the existence of an employer–employee relationship in the university–scholar context. For example, one can make a strong argument that universities do not “control the manner and means” by which the work is completed. While scholarly publication is a general requirement for tenure and promotion at most institutions, schools rarely exercise or even desire to control specific works of scholarship. Moreover, whatever general influence schools do have over scholarly production is muted in the case of tenured professors, who are “no longer directly measured by their scholarly output.”<sup>137</sup> Nevertheless, there is no suggestion that all of the *Reid* factors need point unanimously toward the existence of an employer–employee relationship; an employer–employee relationship exists if the factors on balance indicate such a relationship.<sup>138</sup>

¶41 Even if an employer–employee relationship is found to exist, the work is deemed “made for hire” only if it was created within the scope of employment.<sup>139</sup> Courts cite three factors, also drawn from the Restatement (Second) of Agency, as probative of whether the work was created within the scope of employment: (1) whether the work is of the kind the employee was hired to perform; (2) whether the work “occurs substantially within authorized time and space limits”; and (3) whether the work “is actuated, at least in part, by a purpose to serve” the employer.<sup>140</sup> Applying these factors to works of faculty scholarship has led some commentators to conclude that scholarly articles fall within the scope of university faculty members’ employment, largely because scholarly publication is typically required for promotion and tenure.<sup>141</sup> Below, this

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<sup>137</sup> Jon Garon, *The Electronic Jungle: The Application of Intellectual Property Law to Distance Education*, 4 VAND. J. ENT. L. & PRAC. 146, 152 (2002).

<sup>138</sup> See *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 752–53 (1989) (holding that even when the hiring party exercises substantial control over the work product—the first of the common law of agency factors enumerated by the court—“the extent of control the hiring party exercises over the details of the product is not dispositive,” and finding in that case that “all the other circumstances weigh heavily against finding an employment relationship”).

<sup>139</sup> 17 U.S.C. § 101 (2011).

<sup>140</sup> See, e.g., *Avtec Sys. v. Pfeiffer*, 21 F.3d 568, 571 (4th Cir. 1994) (quoting RESTATEMENT (SECOND) OF AGENCY § 228 (1958)).

<sup>141</sup> See, e.g., Robert C. Denicola, *Copyright and Open Access: Reconsidering University Ownership of Faculty Research*, 85 NEB. L. REV. 351, 375–76 (2006) (“Like the case law, the commentators are not unanimous, but there seems to be a clear, if reluctant, consensus that the work-for-hire rules sweep in most of the traditional output of teachers and university faculty.”); Rochelle C. Dreyfuss, *The Creative Employee and the Copyright Act of 1976*, 54 U. CHI. L. REV. 590, 599 (1987) (“The dispositive issue [in a pre-*Reid* determination of whether professors’ scholarship falls within the 1976 Act’s work for hire provisions] is whether the production of scholarly material is ‘within the scope of employment,’ that is, a part of the job. 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.”) (footnotes omitted); Garon, *supra* note 137, at 152 (“For most tenure-track faculty positions, academic writing remains a requirement of the job. Faculty members often receive mentoring by peers, secretarial and administrative support and sometimes receive stipends or other additional compensation. As such, the academic writings are part of the employment because they are obligations undertaken in order for the faculty member to receive tenure.”) (endnotes omitted); Thomas G. Field, Jr., *From Custom to Law in Copyright*, 49 IDEA 125, 144 (2008) (“Despite lack of incentive to claim ownership in some cases,

Article refutes the notion that this requirement necessarily leads to the conclusion that scholarly articles are created within the scope of employment for copyright purposes.<sup>142</sup>

## 2. The Enigmatic “Teacher Exception” to the Work Made for Hire Doctrine

¶42 Although the work made for hire rules arguably vest initial copyright ownership of scholarship in the employing institution, the academic community has proceeded, according to its own norms and tradition, to presume that initial ownership remains with the author. This tradition has formally manifested in two ways. First, some courts have recognized the tradition in academia as the basis for a common law “teacher exception” to copyright’s work made for hire rules. Second, nearly all universities have now adopted a written policy disclaiming copyright ownership of the scholarship produced by faculty.<sup>143</sup>

¶43 The teacher exception originated in a pair of cases under the 1909 Copyright Act,<sup>144</sup> receiving its most extensive discussion in *Williams v. Weisser*,<sup>145</sup> a 1969 California appeals court decision. In *Williams*, a UCLA anthropology professor sued a proprietor for infringing the professor’s common law copyright (hence the case was in state, not federal, court) by reproducing and selling notes taken at the professor’s lectures.<sup>146</sup> The defendant argued that the professor lacked standing to sue because under the work for hire rules the university was the copyright owner.<sup>147</sup> However, the court held that the professor’s expression, in the form of lectures, was *sui generis* and “should not be blindly thrown into the same legal hopper with valve designs, motion picture background music, commercial drawings” and other types of copyrighted works.<sup>148</sup> This expression should be exempt from the work for hire rules because to hold otherwise would contravene custom and precedent as well as the intentions of the university and the professor.<sup>149</sup> Professors, the court reasoned, “are a peripatetic lot, moving from campus to campus.

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schools as employers own copyright in faculty works.”) (footnote omitted).

<sup>142</sup> See *infra* Part III.B.4.

<sup>143</sup> See *infra* Part III.B.3.

<sup>144</sup> *Sherrill v. Grieves*, 57 Wash. L. Rep. 286 (D.C. Cir. 1929); *Williams v. Weisser*, 78 Cal. Rptr. 542 (Cal. Ct. App. 1969).

<sup>145</sup> *Williams*, 78 Cal. Rptr. at 543.

<sup>146</sup> *Id.* at 544–45. Note, therefore, that the defendant was not the employing institution but rather a third party maintaining that the professor-plaintiff lacked standing because the university, and not the professor, was the copyright owner under the work for hire rules. One commentator has noted that “school ownership of copyright in employees’ work has been denied only when the issue is tangential to assertions by disputants entitled to little sympathy.” Field, *supra* note 141, at 144. Of course, unsympathetic defendants raising the work for hire doctrine as a defense against an infringement claim are not unique to the university context, but are symptomatic of the challenges that arise from equitably applying the work for hire doctrine’s all-or-nothing ownership rules. See *Easter Seal Soc’y for Crippled Children & Adults, Inc. v. Playboy Enters.*, 815 F.2d 323, 333 (5th Cir. 1987) (“The ‘work for hire’ issue in *Aldon Accessories* arose as a defensive tactic adopted by a third-party infringer to dispute the validity of the plaintiff’s copyright. This posture makes the ‘literal’ reading of the 1976 Act particularly unattractive, because it is the infringer and not the independent contractor who will benefit from a ruling that the work was not made ‘for hire.’ In other words, the *Aldon Accessories* court may have been driven to create the narrow ‘actual control’ exception to the general rule that independent contractors hold the copyright under the 1976 Act by the fact that on appeal the defendant more or less conceded infringement but tried to escape liability on ‘work for hire’ grounds.”).

<sup>147</sup> *Williams*, 78 Cal. Rptr. at 543.

<sup>148</sup> *Id.* at 547 (citations omitted).

<sup>149</sup> *Id.* at 545–46.

The courses they teach begin to take shape at one institution and are developed and embellished at another.”<sup>150</sup> To hold that an earlier employing university acquires copyright in portions of the professor’s lectures incubated there would unreasonably restrain the professor’s ability to later teach the same course at other institutions; universities, on the other hand, have few legitimate uses for copyright in lectures.<sup>151</sup> Thus, according to the court, concern about faculty mobility far outweighs any exiguous interest the university might have in copyright ownership.

¶44

The teacher exception thus arose under the Copyright Act of 1909, which provided that “the word ‘author’ shall include an employer in the case of works made for hire.”<sup>152</sup> The 1909 Act did not specify whether a written agreement was necessary to rebut the statutory presumption of copyright ownership in the employer, but courts and commentators construed the 1909 Act to permit oral or implied agreements to situate copyright in the employee.<sup>153</sup> Consequently, a custom by which employees retain copyright ownership could form the basis of an implied contract term between the employee and employer.<sup>154</sup> This history suggests that the teacher exception rested on an implied agreement between university and professor, informed by custom, reserving copyright in the latter. Because the 1976 Act amended the work for hire rules to require a writing signed by both parties to reserve copyright ownership in the employee,<sup>155</sup> and because Congress did not expressly incorporate a teacher exception into the substantially amended 1976 work made for hire rules, commentators and courts have debated whether the exception survived the amendment. A pair of Seventh Circuit decisions from the late 1980s, both penned by former law professors,<sup>156</sup> posited in dictum that the exception remains intact. In the first of those, *Weinstein v. University of Illinois*,<sup>157</sup> Judge Easterbrook wrote that although the copyright statute’s work for hire rules are “general enough to make every academic article a ‘work for hire’ and therefore vest exclusive control in universities rather than scholars,” it “has been the academic tradition since copyright law began” for professors to own the initial copyright in their “scholarly

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<sup>150</sup> *Id.* at 546.

<sup>151</sup> *Id.* at 546–47.

<sup>152</sup> Copyright Act of 1909, ch. 320, § 62, 35 Stat. 1075, 1087–88 (1909) (originally codified at 17 U.S.C. § 62, repealed 1976).

<sup>153</sup> See 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 5.03[D] (2011) (“Although the current Act requires an agreement reserving rights in the employee to be contained in a written instrument signed by both parties, under Section 26 of the 1909 Act, as construed, such an agreement could be either oral or implied. In accordance with general principles of contract law, this meant that a custom or usage whereby certain rights are reserved to the employee, if such custom or usage was known to the parties, or might be presumed to have been so known, would become an implied in fact term of the contract of employment.”) (footnotes omitted).

<sup>154</sup> *Id.*

<sup>155</sup> 17 U.S.C. § 201(b) (2011).

<sup>156</sup> Commentators often point out that Judges Easterbrook and Posner, the respective authors of the *Weinstein* and *Hayes* opinions, are themselves law professors, hinting perhaps that their academic ties might have rendered them less than impartial on the subject. See, e.g., Assaf Jacob, *Tort Made for Hire—Reconsidering the CCNV Case*, 11 YALE J.L. & TECH. 96, 99–100 (2009) (colorfully raising the issue in a satirical, hypothetical dialog between a professor and an academic publisher in which the professor cites *Weinstein* and *Hayes* as proof that the teacher exception exists, “[a]nd the publisher replies dismissively, ‘That’s just one Circuit’s dicta, and written by judges with virtually a conflict of interest. They’re professors themselves!’”).

<sup>157</sup> 811 F.2d 1091 (7th Cir. 1987). The professor in *Weinstein* alleged that his article co-authors and former university infringed his copyright.

articles and other intellectual property.”<sup>158</sup> The following year Judge Posner reflected on the teacher exception in a lengthy aside in *Hays v. Sony Corp. of America*,<sup>159</sup> an opinion that considered copyright ownership of an instruction manual for school word processors prepared by two high school (not university) teachers.

The authority for this conclusion [the teacher exception] was in fact scanty, . . . not because the merit of the exception was doubted, but because, on the contrary, virtually no one questioned that the academic author was entitled to copyright his writings. . . . [T]he universal assumption and practice was that (in the absence of an explicit agreement as to who had the right to copyright) the right to copyright such writing belonged to the teacher rather than to the college or university. There were good reasons for the assumption. A college or university does not supervise its faculty in the preparation of academic books and articles, and is poorly equipped to exploit their writings, whether through publication or otherwise. . . .

The reasons for a presumption against finding academic writings to be work made for hire are as forceful today as they ever were. . . . To a literalist of statutory interpretation, the conclusion that the [1976] Act abolished the exception may seem inescapable. . . . But considering the havoc that such a conclusion would wreak in the settled practices of academic institutions, the lack of fit between the policy of the work-for-hire doctrine and the 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 that the exception had survived the enactment of the 1976 Act. A possible textual handle may be found in the words of section 201(b), . . . which appear to require not only that the work be a work for hire but that it have been prepared for the employer . . . .<sup>160</sup>

¶45 Despite sweeping claims about academic tradition in *Weinstein* and *Hays*, two decades later the teacher exception’s very existence remains, in the words of one court that recently considered the issue, “a question unanswered and highly debated by the courts and intellectuals.”<sup>161</sup> To begin with, both *Weinstein* and *Hays* predated the Supreme Court’s decision in *Reid*, which sought to clarify the meaning of “employee” and “employment” by looking to their definitions under the common law of agency.<sup>162</sup> As one professor observes, “the commentators are not unanimous, but there seems to be a clear, if reluctant, consensus that the work-for-hire rules sweep in most of the traditional output of teachers and university faculty.”<sup>163</sup> Similarly, another commentator believes that literal application of the Act’s work for hire rules necessarily leads to the conclusion

<sup>158</sup> *Id.* at 1094.

<sup>159</sup> 847 F.2d 412 (7th Cir. 1988).

<sup>160</sup> *Id.* at 416–17.

<sup>161</sup> *Molinelli-Freytes v. Univ. of P.R.*, 792 F. Supp. 2d 150, 159 (D.P.R. 2010); see also Kenneth D. Crews, *Instructional Materials and “Works Made for Hire” at Universities: Policies and Strategic Management of Copyright Ownership*, in THE CENTER FOR INTELLECTUAL PROPERTY HANDBOOK 15, 19 (2006) (“This possible [teacher] exception[] is simply too elusive for educators and universities to rely upon, with an assumption that it will clarify and resolve uncertainties in the law.”).

<sup>162</sup> See *supra* text accompanying notes 134–36

<sup>163</sup> Denicola, *supra* note 141, at 376.

that universities own faculty works, and in any event “literal application of those sections [ §§ 101 (defining “work made for hire”) and 201(b)] seems to have harmed no one over the past three decades.”<sup>164</sup>

¶46

Cases that expressly consider the exception are rare, although their frequency has increased in recent years. As of this writing, five courts have done so since *Hays* in 1989, with divergent outcomes.<sup>165</sup> In the first, *Shaul v. Cherry Valley-Springfield Central School District*, the Second Circuit considered the teacher exception in connection with tests, quizzes, and homework problems created by a high school teacher.<sup>166</sup> The court distinguished teaching materials (including the plaintiff’s) that “were never explicitly prepared for publication” from “published articles by university professors.”<sup>167</sup> It held the “‘academic tradition’ granting authors ownership of their own scholarly work is not pertinent” to the former; the apparent implication is that there is a teacher exception that applies to published articles by university professors.<sup>168</sup> The second case, *Pittsburg State University v. Kansas Board of Regents*, considered the teacher exception in the context of a labor dispute between a state university board of regents and a union representing faculty at a public university.<sup>169</sup> The dispute involved whether the Copyright Act’s work for hire rules preempted the parties’ right to negotiate the issue of intellectual property ownership.<sup>170</sup> In considering whether the work for hire rules vest authorship of faculty-created works in the employer and whether a teacher exception applies, the Supreme Court of Kansas found it is “far from clear that there is an absolute teacher exception.”<sup>171</sup> It held that whether the employer owns faculty-created intellectual property depends on whether a particular work falls within the scope of employment agency factors per *Reid*.<sup>172</sup> The third case, *Bosch v. Ball-Kell*,<sup>173</sup> an unreported 2006 decision from the Central District of Illinois, seemingly affirmed the teacher exception and reasoned it applied to course syllabi and exam questions created by a professor within the scope of her employment.<sup>174</sup>

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<sup>164</sup> Field, *supra* note 141, at 144.

<sup>165</sup> The analysis in this Section focuses on the teacher exception; it does not include cases that considered whether the work for hire doctrine applies to higher education faculty work product but did not consider the teacher exception. *See, e.g., Vanderhurst v. Colo. Mountain Coll. Dist.*, 16 F. Supp. 2d 1297, 1307 (D. Colo. 1998) (finding without discussion of the teacher exception that the work for hire rules vested initial ownership of a course outline in the employing college and not in the professor who created it).

<sup>166</sup> 363 F.3d 177, 180–81 (2d Cir. 2004).

<sup>167</sup> *Id.* at 186.

<sup>168</sup> *Id.*

<sup>169</sup> 122 P.3d 336 (Kan. 2005).

<sup>170</sup> *Id.* at 338–39.

<sup>171</sup> *Id.* at 346.

<sup>172</sup> *Id.*

<sup>173</sup> No. 03-1408, 2006 U.S. Dist. LEXIS 62351 (C.D. Ill. Aug. 31, 2006).

<sup>174</sup> In *Bosch*, a pathology professor sued two former faculty colleagues for infringing her copyright in various teaching materials (course syllabi and exam questions) by copying and distributing them to students without the plaintiff’s permission after she left her position at the university. *Id.* at \*7. The defendants raised the issue of work for hire as a defense, arguing that the university, not the plaintiff, owned the copyright in the materials because she created them while she was a university employee. *Id.* at \*9. The plaintiff countered that the teaching materials were “traditional academic copyrightable works owned by the creator” under the university’s intellectual property ownership policy. *Id.* The court denied the defendants’ summary judgment motion on the issue of copyright ownership and in so doing appeared to hold that the teacher exception applied to the materials by citing the “compelling” logic in *Weinstein* and



¶47 The fourth case, *Molinelli-Freytes v. University of Puerto Rico*,<sup>175</sup> offered the most comprehensive discussion of the exception by a court since *Hays*. The plaintiffs, professors at the University of Puerto Rico, drafted a curricular proposal that they alleged the university infringed when it established a new graduate degree program.<sup>176</sup> The court queried whether the proposal manuscript was a work for hire, and if so, whether the teacher exception applied.<sup>177</sup> After canvassing the history and policies behind the exception, the court concluded it did not survive the 1976 amendments to the Act.<sup>178</sup> The court reasoned that Congress's failure to mention the teacher exception, both in the legislative history and in the language of the Act itself, "weighs heavily towards a finding that no 'teacher exception' remains in existence."<sup>179</sup> The court also found key policy justifications lacking. It found *passé* the suggestion in *Williams* that universities had little reason to want ownership of faculty works: "In an age of distance-learning and for-profit institutions of higher learning, universities stand to gain much by retaining ownership of certain works created by their employees."<sup>180</sup> The court further reasoned that the proliferation of university policies purporting to allow faculty authors to retain copyright ownership ameliorates concerns about undermining the academic tradition of professors owning the copyright in their works.<sup>181</sup>

¶48 Most recently, in *Roop v. Lincoln College*<sup>182</sup> the court deemed the exception inapplicable but did not foreclose the possibility of its existence to the extent its application is limited to works sufficiently academic in nature. Decided shortly after *Molinelli-Freytes*, *Roop* involved a long-time instructor at Lincoln College whom the school asked to develop a new degree program curriculum.<sup>183</sup> Following a dispute over her contract and educational qualifications, the instructor left the employ of the college and brought suit alleging, *inter alia*, that the school infringed her copyright by using the curriculum and materials she developed.<sup>184</sup> The court found that under the work for hire doctrine, the university was the author of curriculum materials developed by the instructor because she created the materials within the scope of her employment.<sup>185</sup> The court declined to expressly recognize the existence of the teacher exception despite being located in the Seventh Circuit, which after *Weinstein*, *Hays*, and *Bosch* would appear to be hospitable to the exception. The court instead referred to a "potential" teacher exception, which it considered at some length but concluded was inapplicable because "the copyrighted curriculum materials [at issue] here [we]re not 'academic writings' akin

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*Hays*, and noting that the academic setting is unlike "the typical work for hire scenario" in which "the employer assigns and directs the topic, content, and purpose of the work." *Id.* at \*20. Also central to the court's reasoning was the fact that the plaintiff presented evidence indicating that the university's intellectual property policy intended to exclude teaching materials from university ownership. *Id.* at \*21.

<sup>175</sup> 792 F. Supp. 2d 164 (D.P.R. 2010).

<sup>176</sup> *Id.* at 165.

<sup>177</sup> *Id.* at 165–66.

<sup>178</sup> *Id.* at 172.

<sup>179</sup> *Id.* at 171.

<sup>180</sup> *Id.*

<sup>181</sup> *Id.* at 172.

<sup>182</sup> No. 09-cv-1051, 2011 U.S. Dist. LEXIS 25670 (C.D. Ill. Mar. 14, 2011).

<sup>183</sup> *Id.* at \*1–2.

<sup>184</sup> *Id.* at \*6–8, \*10.

<sup>185</sup> *Id.* at \*28.

to academic books or articles that a professor would typically submit for publication”;<sup>186</sup> rather, recalling Judge Posner’s language from *Hays*, the court reasoned that the plaintiff “create[d] the materials for [the] College.”<sup>187</sup>

TABLE 1. TEACHER EXCEPTION DECISIONS AFTER *HAYS* AND *REID*

Case Name	Year	Court	Type of Work at Issue	Teacher Exception Exists?
<i>Shaul</i>	2004	2d Cir.	High school quizzes, tests, and problems	Not for works not explicitly prepared for publication; Maybe for published articles by university professors
<i>Pittsburgh State Univ.</i>	2005	Kan.	All works created by university faculty	Probably no “absolute” teacher exception, but some faculty-created works fall outside the scope of employment
<i>Bosch</i>	2006	C.D. Ill.	Course syllabi and exam questions	Yes
<i>Molinelli-Freytes</i>	2010	D.P.R.	New curriculum proposal	No
<i>Roop</i>	2011	C.D. Ill.	Curriculum materials	Not for curriculum materials; Maybe for academic writings of the type that are typically published

¶49 As Table 1 illustrates, rumors of the teacher exception’s death post-*Reid* are premature, at least regarding its application to scholarship.<sup>188</sup> Indeed, three of the five opinions leave open the possibility that a teacher exception applies to scholarly articles. Nevertheless, the health and scope of the exception remain unclear. One thing does seem clear: the increasing frequency with which the exception has been invoked in recent years suggests the doctrine is bound to linger as academics claim individual ownership of their intellectual work product.

### 3. The Effect of University Copyright Policies on Initial Ownership

¶50 Many universities have intellectual property policies that purport to allocate copyright ownership of works created by employees, and some courts that have considered the teacher exception have expressed deference to such policies.<sup>189</sup> Nevertheless, as discussed above, under a literal application of the work made for hire rules, if the faculty member who creates the work is deemed to be a university employee and if the work is deemed to be within the scope of her employment, then the university is the author and copyright owner *ab initio* unless a teacher exception applies.<sup>190</sup> This

<sup>186</sup> *Id.* at \*30.

<sup>187</sup> *Id.* at \*31.

<sup>188</sup> In none of these five cases was the work at issue a scholarly article or book (with the possible exception of *Pittsburgh State*, which used a broad brush to address all faculty-created copyrighted works). Three of the five cases (*Shaul*, *Bosch*, and *Roop*), however, seemed to regard favorably the notion that a teacher exception applies to scholarship in higher education.

<sup>189</sup> See, e.g., *Weinstein v. Univ. of Ill.*, 811 F.2d 1091, 1094 (7th Cir. 1987) (noting, however, that the policy is “part of each professor’s contract with the University”); *Molinelli-Freytes v. Univ. of P.R.*, 792 F. Supp. 2d 164, 172 (D.P.R. 2010); *Shaul v. Cherry Valley-Springfield Cent. Sch. Dist.*, 363 F.3d 177, 186 (2d Cir. 2004).

<sup>190</sup> See *supra* Part III.B.2.

would seem to be the case regardless of how the university's policy purports to allocate copyright ownership.

¶51 Of course, employers and employees can, and often do, contract to reallocate copyright ownership to the employee for works created during the term and scope of the employment.<sup>191</sup> Section 201(b) requires, however, that any such agreement between the employer and employee be in writing and signed by both parties<sup>192</sup>—a requirement arguably not satisfied by the existence of a university policy absent a more traditional writing signed by both parties.<sup>193</sup> Presumably to satisfy § 201(b)'s writing requirement, some schools require faculty to sign agreements concerning allocation of intellectual property rights and others expressly incorporate the intellectual property policy terms into their faculty employment agreements.<sup>194</sup> Some schools, however, appear to rely on the existence of a copyright policy alone to stipulate faculty ownership.<sup>195</sup>

¶52 Dubiety about the legal effect of university copyright policies notwithstanding, it seems universities themselves feel compelled to formally express their intentions about copyright ownership. Most if not all U.S. universities now have policies addressing intellectual property ownership, and over the past two decades, most schools have adopted policies expressly disclaiming ownership of scholarly works. A 1992 study of copyright policies at seventy major U.S. research universities revealed that at that time, sixteen had policies expressly disclaiming university ownership of faculty-authored scholarly articles.<sup>196</sup> A follow-up study in 2002 surveying the same seventy universities

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<sup>191</sup> 17 U.S.C § 201(b) (2006) (“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.”) (emphasis added).

<sup>192</sup> *Id.*

<sup>193</sup> *See, e.g., Forasté v. Brown Univ.*, 248 F. Supp. 2d 71, 74, 81 (D.R.I. 2003) (finding a university policy “patently inadequate” as a writing that vests copyright ownership in the employee under § 201(b), where the policy stated that “ownership of copyrightable property which results from performance of one’s University duties and activities will belong to the author or originator,” and no other writing or agreement existed between the university and the employee concerning copyright ownership); Llewellyn Joseph Gibbons, *Tech Transfer: Everything (Patent) Is Never Quite Enough*, 48 U. LOUISVILLE L. REV. 843, 870–72 (2010) (“University employment policies or handbooks and faculty senate resolutions do not divest a university of its copyright ownership if it is the legal author under the 1976 Copyright Act. Nor will equity provide a remedy to the faculty member who detrimentally relies on these written policies for a transfer of copyright ownership in the absence of a signed writing. . . . To reiterate, the best university copyright policies are those that carefully track the requirements of the 1976 Copyright Act.”).

<sup>194</sup> In addition to agreements signed individually by the parties, some commentators suggest that collective bargaining agreements that incorporate the copyright policy terms and are signed by employers’ and employees’ agents would likely satisfy § 201(b)’s writing requirement. *See* Field, *supra* note 141, at 140 n.114. That conclusion seems less likely if the agreement does not include the express language of the transfer but rather incorporates the university policy by reference. *See* Manning v. Board of Trustees, 109 F. Supp. 2d 976, 980 (C.D. Ill. 2000) (holding insufficient as a writing for purposes of § 201(b) a collective bargaining agreement and annual employment agreements that purportedly incorporated the community college’s copyright policy).

<sup>195</sup> It is often not clear whether university copyright policies disclaiming ownership of faculty scholarship are intended to rebut the presumption of employer ownership under § 201(b) or to effect transfers of copyright ownership under §§ 201(d) and 204(a). In all likelihood, most schools simply intend to formalize in writing the expectations of the university and its employees without regard to the Copyright Act’s technical requirements. Adding a further layer of complexity is the question of whether prospective transfers of copyright ownership are enforceable. In short, they probably are. *See infra* note 283.

<sup>196</sup> 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, 262 (1992).

found that that number had risen to forty-nine.<sup>197</sup> This Author has reviewed the copyright policies of the same schools. While the policies vary substantially in clarity and specificity, it appears that all seventy universities now disclaim ownership of most faculty scholarship, although a handful appear to assume that ownership vests initially in the university, and purport to subsequently transfer copyright ownership to the faculty member who created the work.<sup>198</sup> A former university general counsel suggested to this Author that one reason universities feel fairly secure in their position concerning the legal effect of these disclaimers is that the disclaimers are the opposite of the potentially more objectionable arrangement; here the policies are intended to *waive* rather than *acquire* rights. That argument makes some sense, since the purpose underlying the § 102(b) and 204(a) writing requirements is generally held to be the reduction of fraudulent or inadvertent transfers of copyright ownership.<sup>199</sup> These are not usually major concerns with regard to university attempts to transfer their own purported interests via express, albeit general, policies. Nevertheless, courts appear unwilling to find that a university policy expressly disclaiming copyright ownership creates a valid transfer if the policy falls short of the requirements for a written instrument.<sup>200</sup> The following Section argues that university copyright disclaimer policies are best interpreted not as instruments intended to transfer copyright ownership per the requirements of §§ 102(b) or 204(a); rather they are best interpreted as defining the types of copyrighted works that are excluded from the scope of employment for work for hire purposes.

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<sup>197</sup> Ashley Packard, *Copyright or Copy Wrong: An Analysis of University Claims to Faculty Work*, 7 COMM. L. & POL'Y 275, 298 (2002).

<sup>198</sup> Research on file with the Author. The University of Michigan is one school that expressly takes the position that scholarly works of its faculty, including scholarly articles and textbooks, are created within the scope of employment and are therefore works made for hire owned by the university. UNIV. OF MICH. STANDARD PRACTICE GUIDE, *Who Holds Copyright at or in Affiliation with the University of Michigan* 1–3 (Sept. 21, 2011), available at <http://spg.umich.edu/pdf/601.28.pdf> (providing that works authored by faculty “within the scope of their employment as part of or in connection with their teaching, research, or scholarship” typically include journal articles, scholarly papers, and textbooks). The policy then purports to transfer copyright ownership to the faculty member who created the work less various rights retained by the university to use, preserve, archive, and host the work in an institutional repository. *Id.* at 1. The copyright policy at Johns Hopkins University is an example of a fairly typical copyright disclaimer policy, providing that

[c]opyright to, and royalty from, literary or scholarly works in tangible or electronic form (e.g., textbooks and other curricular materials, reference works, journal articles, novels, music, photographs, etc.) produced by faculty members as a part of their usual teaching, service, and research activities, and which do not result directly as a specified deliverable from projects funded in whole or in part by the University or a sponsored research agency shall belong to the faculty who prepared such works and may be assigned or retained by them.

*Intellectual Property Policy*, JOHNS HOPKINS U. 3 (Oct. 5, 2011), available at [http://jhuresearch.jhu.edu/JHU\\_Intellectual\\_Property\\_Policy.pdf](http://jhuresearch.jhu.edu/JHU_Intellectual_Property_Policy.pdf).

<sup>199</sup> See *infra* Part III.C; see also *Balt. Orioles, Inc. v. Major League Baseball Players Ass’n*, 805 F.2d 663, 672 (7th Cir. 1986) (“[Section] 201(b) requires that an agreement altering the statutory [work for hire] presumption be both written and express. In essence, this provision is a statute of frauds.”).

<sup>200</sup> See, e.g., *Forasté v. Brown Univ.*, 290 F. Supp. 2d 234, 236–41 (D.R.I. 2003).

#### 4. Copyright Ownership and Academic Freedom

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Ensuring academic freedom is a compelling reason to exempt scholarly articles from the work for hire rules.<sup>201</sup> According to the influential *1940 Statement of Principles on Academic Freedom and Tenure* agreed upon by the American Association of University Professors (AAUP) and the Association of American Colleges and Universities, the “common good depends upon the free search for truth and its free exposition,” and “[a]cademic freedom is essential to these purposes and applies to both teaching and research.”<sup>202</sup> University faculty, the Statement provides, are entitled to “full freedom in research and in the publication of the results” without subjection to institutional censorship.<sup>203</sup> Vesting in universities the exclusive right to reproduce, publish, perform, display, and prepare derivative works based upon<sup>204</sup> scholarly articles plainly conflicts with the principles of independence and noninterference at the heart of the Statement.<sup>205</sup> One can imagine many scenarios in which this would present more than a theoretical conflict of interest: for example, when a faculty member produces an article critical of or offensive to the university administration, a powerful alumnus, or a major donor. Regardless of whether a school today would alter or submerge a scholarly article under such circumstances, it is troubling to imagine that it has the right to do so by default. This is especially so because it is far from clear, and indeed appears increasingly doubtful, that faculty members have a constitutional right of academic freedom on which they can rely to protect their speech from institutional interference.<sup>206</sup>

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<sup>201</sup> See Packard, *supra* note 197, at 293 (“[A]cademic freedom is the natural justification for the teacher exception, and, in fact, frequently is cited by academics and universities as the basis for exempting traditional faculty writings from university copyright claims.”).

<sup>202</sup> *Academic Freedom and Tenure: 1940 Statement of Principles and Interpretive Comments*, 56 AAUP BULLETIN 323, 324 (1970), reprinted in AM. ASS’N OF UNIV. PROFESSORS, AAUP POLICY DOCUMENTS AND REPORTS 3 (10th rev. ed. 2006), available at <http://www.aaup.org/NR/rdonlyres/EBB1B330-33D3-4A51-B534-CEE0C7A90DAB/0/1940StatementofPrinciplesonAcademicFreedomandTenure.pdf>.

<sup>203</sup> *Id.*

<sup>204</sup> See 17 U.S.C. § 106 (2011) (enumerating the exclusive rights granted by the Copyright Act).

<sup>205</sup> Unsurprisingly, the AAUP shares this view. See *Statement on Copyright*, in AM. ASS’N OF U. PROFESSORS, *supra* note 202, at 214–15 (“Were the institution to own the copyright in [traditional academic] works, under a work-made-for-hire theory, it would have the power, for example, to decide where the work is to be published, to edit and otherwise revise it, to prepare derivative works based on it (such as translations, abridgments, and literary, musical, or artistic variations), and indeed to censor and forbid dissemination of the work altogether. Such powers, so deeply inconsistent with fundamental principles of academic freedom, cannot rest with the institution.”).

<sup>206</sup> See, e.g., Judith Areen, *Government as Educator: A New Understanding of First Amendment Protection of Academic Freedom and Governance*, 97 GEO. L.J. 945, 987–88 (2009) (“The constitutional standard [of academic freedom], unlike the professional standard, applies to public colleges and universities only. Faculty at public institutions may not have a constitutional right to participate in academic governance, but their speech on academic matters such as student academic standards has been granted constitutional protection by the Supreme Court. . . . The *Garcetti* [*v. Ceballos*, 547 U.S. 410 (2006),] official-duty test now threatens to terminate all constitutional protection for . . . academic freedom generally.”) (footnotes omitted); J. Peter Byrne, *Academic Freedom: A Special Concern of the First Amendment*, 99 YALE L.J. 251, 311–12 (1989) (“In the last decade, the Supreme Court’s decisions concerning academic freedom have protected principally and expressly a First Amendment right of the university itself—understood in its corporate capacity—largely to be free from government interference in the performance of core educational functions. . . . Commentators steeped in the traditional notion of academic freedom—understood as the protection of the scholarly integrity of faculty from institutional interference—have expressed both surprise at this change in doctrine and concern that a university may have a constitutional right to violate an individual professor’s academic freedom.”).

¶54 The lynchpin of a well-tailored teacher exception, then, seems to be academic freedom. That is, copyright ownership should vest in the scholar for any works for which “full freedom in research and in the publication of the results” or “freedom in the classroom” is crucial. Adopting this broad standard would not provide certainty in every case. Disputes involving faculty-produced software or involving educational materials developed by high school or elementary school teachers, for example, could present challenging questions about the scope of academic freedom. At least, however, delineating the contours of a teacher exception around academic freedom principles would ensure that the exception encompasses anything that can reasonably be considered scholarship.

¶55 As discussed above, however, doubt abounds as to whether the teacher exception survived the 1976 Act amendments at all.<sup>207</sup> Is there a step in the work for hire analysis that affords courts an opportunity to take academic freedom into account? The 1976 Act does require that any employee-created work deemed “for hire” be created within the scope of employment.<sup>208</sup> Some courts and commentators argue, therefore, that under the 1976 Act the need for a teacher exception to the work for hire rules is diminished because the scope of employment analysis permits courts to consider the unique context in which scholarship is created.<sup>209</sup> This approach fits more comfortably within the established framework of the work for hire rules under the 1976 Act and shifts the focus of the inquiry from academic custom itself (scholars’ retention of copyright ownership) to the importance of independence in faculty research and publishing. “Faculty members in colleges and universities,” as noted legal scholar and former AAUP president Ralph Fuchs observed, “are usually not employed to follow orders but to render instruction and to pursue inquiries in their fields of competence, largely free of supervision and direction

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<sup>207</sup> See *supra* text accompanying notes 152–64.

<sup>208</sup> See *supra* text accompanying notes 139–141.

<sup>209</sup> See *Pittsburg State Univ. v. Kan. Bd. of Regents*, 122 P.3d 336, 346–47 (Kan. 2005) (“While it is far from clear that there is an absolute teacher exception to the work-for-hire doctrine[,] . . . whether any particular creative work of a faculty member constitutes work for hire will depend on whether the work meets the Restatement test [for scope of employment], *i.e.*, whether it is the type of work the faculty member was hired to create; whether it was created substantially within the time and space limits of the job; and whether it was motivated by a purpose to serve the university employer.”); James B. Wadley & JoLynn M. Brown, *Working Between the Lines of Reid: Teachers, Copyrights, Work-for-Hire and a New Washburn University Policy*, 38 WASHBURN L.J. 385, 431 (1999) (“Under the work-for-hire test structured by the Court in *Reid*, the [teacher] exception, if needed at all, may have lost its conventional ‘exception to the rule’ utility. Since the analytical structure in *Reid* considers the nature of the particular work created within the context of the employment as critical to the inclusion decision, the most that can be expected from a recognized academic exception is that it might flag academic work as requiring further inquiry as compared to nonacademic work.”); 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 5:71 (2011) (“While state law cannot alter the content of federal law, parties can contractually agree about the scope of employment, which in turn may dramatically impact on whether the work is for hire. For example, while an academic would for all other purposes be regarded as an employee, the parties could agree that the academic’s duties did not extend to the writing of particular material, thereby permitting the academic to be the author of such material. Such an approach does not conflict with federal law; rather, state law provides the facts (the scope of employment) upon which federal law is then applied. This approach of defining the scope of employment in a way so as to preserve for academics copyright in teaching materials they prepare at their own initiative is the correct way to mediate between the impulses behind the false teacher exception and the clear language of the statute.”); Crews, *supra* note 161, at 31 (2006) (recommending that university copyright policies “clearly define ‘works made for hire’ and the work that falls ‘within the scope of employment’”).

...<sup>210</sup> This separation of the faculty member's scholarly (as opposed to administrative) functions from the university is institutionalized, intentional, and hard-won in the history of higher education in the United States,<sup>211</sup> and should be an important consideration in the scope of employment analysis.

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A scope of employment analysis that takes into account the intentions of the parties, the requirements of academic freedom, and the unique context in which scholarship is produced should lead to the conclusion that the faculty member, not the university, is the author of her scholarly articles. It is important to keep in mind that "scope of employment" is a term of art.<sup>212</sup> Lay notions of what professors do at their jobs are not dispositive. Only if all three elements of the Restatement test are satisfied is a work created within the scope of employment.<sup>213</sup> When interpreting the first factor of the Restatement's scope of employment test (that is, whether the work is of the kind the employee was hired to perform), courts rely heavily on the employee's job description and the employer's degree of control over the works created.<sup>214</sup> Publicly available job descriptions for "university professor" uniformly list scholarly publication as a central requirement of the job.<sup>215</sup> The content of scholarship surely matters to schools when evaluating faculty for tenure or promotion and some commentators find this fact virtually dispositive on the question of whether scholarship falls within the scope of employment.<sup>216</sup> This view, however, ignores the unique context in which scholarship is produced—context that may be taken into account when analyzing this factor of the scope of employment test. The tenure and promotion standards do not focus on the production of works for university ownership. They focus on publication, which results in increased esteem for the scholar and, by association, the university. In other words, it is the act of *publishing* works of high academic standards that fulfills the tenure requirement, not the act of *producing* specific works *for* the university at its behest while in its employ.<sup>217</sup> This distinction is apparent in the fact that schools frequently decide to

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<sup>210</sup> Ralph F. Fuchs, *Academic Freedom—Its Basic Philosophy, Function, and History*, 28 LAW & CONTEMP. PROBS. 431, 445 (1963).

<sup>211</sup> See generally RICHARD HOFSTADTER, *ACADEMIC FREEDOM IN THE AGE OF THE COLLEGE* (1955); WALTER P. METZGER, *ACADEMIC FREEDOM IN THE AGE OF THE UNIVERSITY* (1955).

<sup>212</sup> *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 740 (U.S. 1989).

<sup>213</sup> RESTATEMENT (SECOND) OF AGENCY § 228 (1958). Case law developed under the Restatement (Second) of Agency, but another edition has been published. Compare *id.*, with RESTATEMENT (THIRD) OF AGENCY § 7.07(2) (2006) ("An employee acts within the scope of employment when performing work assigned by the employer or engaging in a course of conduct subject to the employer's control. An employee's act is not within the scope of employment when it occurs within an independent course of conduct not intended by the employee to serve any purpose of the employer.").

<sup>214</sup> See *City of Newark v. Beasley*, 883 F. Supp. 3, 8 (D.N.J. 1995).

<sup>215</sup> See, e.g., *Postsecondary Teachers*, in BUREAU OF LABOR STATISTICS, U.S. DEP'T OF LABOR, OCCUPATIONAL OUTLOOK HANDBOOK, 2012–13 EDITION (Apr. 10, 2012), <http://www.bls.gov/ooh/education-training-and-library/postsecondary-teachers.htm>; Marty Nemko, *Professor: Executive Summary*, U.S. NEWS & WORLD REP. (Dec. 19, 2007), <http://money.usnews.com/money/careers/articles/2007/12/19/professor-executive-summary>; *College Professor Job Description & Career Opportunities*, JOBDSCRIPTIONS.NET, <http://www.jobdescriptions.net/education/college-professor/> (last visited June 3, 2012).

<sup>216</sup> See, e.g., Dreyfuss, *supra* note 141, at 599; Garon, *supra* note 137, at 152 ("For most tenure-track faculty positions, academic writing remains a requirement of the job. Faculty members often receive mentoring by peers, secretarial and administrative support and sometimes receive stipends or other additional compensation. As such, the academic writings are part of the employment because they are obligations undertaken in order for the faculty member to receive tenure.").

<sup>217</sup> As Judge Posner emphasized in *Hays*, § 201(b) indicates that works made for hire are those works

grant tenure to professors hired away from other institutions. In such cases, the hiring institution bases its tenure decision at least in part on articles published while the faculty member was employed at prior institutions. As for the level of control universities exercise, because of the academic freedom principle schools have little or no control over the content of scholarly articles. Faculty are free to determine the subject matter and content of their scholarly articles. Further, that schools engage in post hoc evaluation of scholarship for tenure and promotion review, sometimes years after publication, is itself evidence of the universities' lack of creative control.

¶157 Moreover, although university copyright policies intended to disclaim copyright ownership to the employee are perhaps insufficient to vest ownership in the employee,<sup>218</sup> the policies provide powerful evidence of the job requirements and of which works, if any, the parties intend to include within the scope of employment. University copyright policies disclaiming ownership are best viewed not as attempts to legally assign copyright but rather as evidence that the job description includes only a requirement of publication—not production of scholarly works for university ownership. This interpretation better harmonizes university copyright policies with the work for hire rules and effectuates the intentions and understandings of all parties.<sup>219</sup>

¶158 In addition to academic freedom concerns, financial disincentives arguably exist for schools to bring scholarly production within the scope of employment. If universities are deemed the authors of faculty scholarship, they could bear legal responsibility for the content of every article produced by every faculty member on its campus.<sup>220</sup> Academics are threatened from time to time with defamation suits arising from statements made in their scholarship.<sup>221</sup> Former University of Oregon General Counsel Melinda Grier

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prepared “for” the employer. *Hays v. Sony Corp. of America*, 847 F.2d 412, 417 (7th Cir. Ill. 1988).

<sup>218</sup> See *supra* Part III.B.3.

<sup>219</sup> See 2 PATRY, *supra* note 209, § 5:71; see also *Vanderhurst v. Colo. Mountain Coll. Dist.*, 16 F. Supp. 2d 1297, 1307 (D. Colo. 1998) (referring to a school policy that defined faculty duties in order to help determine whether a course outline was created within the scope of a junior college professor's employment).

<sup>220</sup> Employers may be held liable for an employee's defamatory writings under *respondeat superior*, although under what circumstances remains unclear. Compare *Easter Seal Soc'y for Crippled Children & Adults v. Playboy Enters.*, 815 F.2d 323 (5th Cir. 1987) (suggesting that an employer may be held liable for defamatory writings by an employee), with *Masson v. New Yorker Magazine, Inc.*, 832 F. Supp. 1350, 1370–74 (N.D. Cal. 1993), *aff'd*, 85 F.3d 1394 (9th Cir. 1996) (holding that the First Amendment requires a stringent standard of “actual malice” to show defamation, and finding the facts insufficient to impute liability to the employer).

<sup>221</sup> See, e.g., AMY GAJDA, *THE TRIALS OF ACADEME: THE NEW ERA OF CAMPUS LITIGATION* 176–77 (2009). Gajda details a pair of cases involving defamation suits arising out of legal scholarship. In 2005, a man whose court case was mentioned in an article about custody cases and domestic violence threatened to sue the article's author, University of Oregon law professor Merle Weiner, for defamation. *Id.* The University of Oregon “disclaimed any obligation to represent her in legal action arising from her publications.” *Id.* at 177. In 1998, the *Denver Journal of International Law and Policy* published an article titled “The Critical Need for Law Reform to Regulate the Abusive Practices of Transnational Corporations: The Illustrative Case of Boise Cascade Corporation in Mexico's Costa Grande and Elsewhere.” June M. Besek & Philippa S. Loengard, *Maintaining the Integrity of Digital Archives*, 31 *COLOM. J.L. & ARTS* 267, 273 (2008). Boise Cascade Corporation sent cease and desist letters to the authors and the journal withdrew the article, directed Lexis and Westlaw to terminate online access to it, and published an errata notice that the article “was not consistent with the [journal's] editorial standards.” *Id.* Interestingly, in this instance, the law professors successfully sued the journal for defamation as a result of the retraction, winning an apology, payment, and the return of copyright ownership in the article. *Id.* In another example, a professor of women's studies at the University of Rhode Island was forced to remove two articles she wrote about trafficking of women and children after the individuals accused in the articles of sex trafficking



pointed out to this Author that if universities are deemed the authors of scholarly articles, insurance companies could condition liability coverage on whether a university has sufficient procedures in place to screen articles for potentially libelous content prior to publication. Although the Copyright Act permits parties to agree to situate ownership of a work made for hire in the employee rather than the employer,<sup>222</sup> an attempt to do so might not relieve the university of liability because such an agreement merely transfers copyright ownership to the faculty member—it does not change the university’s status as the article’s author.<sup>223</sup> Whether insurers would actually require screening of scholarship is an open question (they do not, presumably, require screening for other tort liability risk factors such as the physical coordination of university employees).<sup>224</sup> What *is* clear is that most universities evince little desire to be the legal authors of scholarship, and have disincentives to exercise control over faculty scholarship.<sup>225</sup>

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hired a law firm and threatened to sue. *Id.* at 274. The university told the professor that the case “did not have merit,” but still refused to defend it due to the potential costs involved. *Id.*

<sup>222</sup> 17 U.S.C. § 201(b) (2011).

<sup>223</sup> See 1 NIMMER & NIMMER, *supra* note 153, § 5.03[D][2] (“Under the above formulation [in § 201(b)] the parties may by agreement memorialized in writing vary the rights which would otherwise be owned by the employer, but they may not vary such person’s status as the ‘author’ of the work. This distinction was intentional, and was made in order to prevent the parties from avoiding the legal consequences (other than the ownership of rights) which arise by reason of the status of a work as one made for hire.”) (footnotes omitted).

<sup>224</sup> Thanks to my colleague Merle Weiner for making this colorful point.

<sup>225</sup> Note that determining the scope of employment for copyright ownership purposes presents a quandary for academic freedom. If scholarship is found to be created within the scope of employment, then schools own the copyright, giving rise to the uncertainty and potential threats to academic freedom discussed above. If, on the other hand, scholarship is found to be outside the professor’s scope of employment, professors at some public universities may be unable to avail themselves of laws that require states to defend public employees against tort claims arising from the performance of their professional duties. This could leave a professor without state resources to defend against a defamation suit arising from the content of a scholarly work, potentially having a chilling effect on scholarship. See Merle H. Weiner, Publish and Perish: Lessons About Academic Freedom that Every Law Professor Should Know 19 (2007) (unpublished manuscript) (on file with the author). In her manuscript, Professor Weiner describes how she was threatened with a defamation lawsuit based on claims she made in a scholarly article. *Id.* at 3–39. She argues that because she is a professor at a public university (the University of Oregon), because publishing scholarship is a job requirement, and because her article was produced using substantial university resources, her article was therefore produced within the scope of her employment and the Oregon Tort Claims Act (OTCA) compelled the state to defend her. *Id.* at 19–25 (citing the Oregon Tort Claims Act, which provides that “[t]he governing body of any public body shall defend, save harmless and indemnify any of its officers, employees and agents, whether elective or appointive, against any tort claim or demand, whether groundless or otherwise, arising out of an alleged act or omission occurring in the performance of duty”). The state declined to defend her. *Id.* at 24 (“So, what happened to my claim for coverage? Absolutely nothing. Despite the language in the statute that the Attorney General ‘shall defend’ pending a determination of coverage, the Attorney General’s office took the position that it had a reasonable amount of time to decide whether or not to cover me and no interim obligation to defend arose.”). This quandary is ultimately rooted in the Supreme Court’s application of tort doctrine to the copyright context. *Com. for Creative Non-Violence v. Reid*, 490 U.S. 730, 739 (1989). Scholarship is a prime example of a kind of work for which it might make sense to consider authored by the employee for copyright purposes but created “in the performance of duty” for purposes of triggering the institution or state’s duty to provide legal defense under statutes such as the OTCA. (I say this bearing in mind the additional layer of complication, discussed above, that extending legal liability for defamation to an academic employer could have academic freedom implications.) The current law, however, in which the authorship and tort liability standards are coterminous, appears to negate the possibility of different scope of employment standards for copyright and tort purposes. For a discussion of some of the problems arising from the importation of tort rules to copyright’s work for hire doctrine see Jacob, *supra* note 156 (arguing that authorship under the work for hire doctrine should be decided according to copyright principles, such

¶159 Factor two of the Restatement test (whether the work is performed substantially within authorized work hours and space) is unlikely to significantly affect the scope of employment analysis in cases involving university scholarship. As with many professions today, professors enjoy relative flexibility regarding when and where they work. Even if many do the bulk of their writing away from the office or during evenings or on weekends, however, their work product might still be found to fall within the scope of employment.<sup>226</sup> Nevertheless, this factor is seldom dispositive,<sup>227</sup> indicating the degree of malleability in the scope of employment test despite its purportedly conjunctive elements.<sup>228</sup>

¶160 Courts and commentators typically find that the third factor (whether the work was actuated at least in part to serve the employer) is satisfied if a desire to serve the master motivated the employee to any appreciable extent.<sup>229</sup> This establishes a very low threshold; applying this standard, most works that are even tangentially related to the job may be “undertaken to serve the employer.” Perhaps for that reason, not all courts have adopted this interpretation of “at least in part.” Some look instead to the employee’s “primary” motivation for creating the work. One court refused to find that a desire to serve his employer motivated an employee when the employee programmed software at his own initiative to automate job-related tasks.<sup>230</sup> Although the software “benefitted

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as in which parties do the incentives to create the work lie, and considerations of public access to the work, rather than agency law rules aimed at determining when employers should be vicariously liable for their employees’ torts).

<sup>226</sup> See, e.g., *Vanderhurst v. Colo. Mountain Coll. Dist.*, 16 F. Supp. 2d 1297, 1307 (D. Colo. 1998) (holding that a course outline created by plaintiff professor was within the scope of his employment with the college even though he “prepared the Outline on his own time with his own materials” because “there is no genuine dispute that Vanderhurst’s creation of the Outline was connected directly with the work for which was [sic] employed to do and was fairly and reasonably incidental to his employment” and “may be regarded fairly as one method of carrying out the objectives of his employment”).

<sup>227</sup> Compare *Cramer v. Crestar Fin. Corp.*, No. 94-2629, 1995 U.S. App. LEXIS 25906, at \*14 (4th Cir. Sept. 13, 1995) (finding that a computer program was created within the scope of employment even though the employee “wrote the [computer] program . . . substantially within the authorized time and space limits of his job—even if he did so at home, outside regular work hours, on his own initiative, and using his own equipment,” and observing that “[w]hen the first element of the Restatement test is met—that the work is of the kind the employee is hired to perform—‘courts have tended not to grant employees authorship rights solely on the basis that the work was done at home on off-hours’”) (quoting *Avtec Sys. v. Peiffer*, 21 F.3d 568, 571 (4th Cir. 1994)), and *Miller v. CP Chems., Inc.*, 808 F. Supp. 1238, 1243 (D.S.C. 1992) (holding that a computer program written “at [the employee’s] home on his own time and for no additional pay” was nevertheless within the scope of employment based on the first and third Restatement factors), with *City of Newark v. Beasley*, 883 F. Supp. 3, 8 (D.N.J. 1995) (holding that employee created the copyrighted work outside of authorized work hours, work held not to be within scope of employment as Restatement factors one and three also not satisfied), and *Roeslin v. District of Columbia*, 921 F. Supp. 793, 798 (D.D.C. 1995) (finding computer program written primarily at home was created outside of authorized time and space limits and not within scope of employment as Restatement factors one and three also not satisfied). See also *Jacob*, *supra* note 156, at 121 (“[C]ourts have reduced the importance of the second element and essentially have disregarded it altogether, establishing the scope of employment with only the first and third factors.”).

<sup>228</sup> See *Jacob*, *supra* note 156, at 115–24.

<sup>229</sup> See, e.g., *Denicola*, *supra* note 141, at 373 (“Although faculty research may be motivated primarily by a personal desire for knowledge, career advancement, or prestige, or by an altruistic desire to benefit others, it is sufficient under the *Restatement* if the purpose of serving the employer’s interests ‘actuates the servant to any appreciable extent.’”); *Beasley*, 883 F. Supp. at 8–9.

<sup>230</sup> *Roeslin*, 921 F. Supp. at 798; see also *Jacob*, *supra* note 156, at 123 (“[T]he third element is interpreted by some courts as emphasizing the employee’s motivation and not the outcome of her acts. By so doing, the court can safely reach a conclusion that, even though the employer has benefited from the

[the] employer, and the Court could fairly infer that part of [the employee’s] motivation was to achieve this result,” the software fell outside the scope of employment because the employee “was *primarily* motivated by self-fulfilling purposes.”<sup>231</sup> If one applies this higher standard, few would disagree that for most scholars, self-fulfilling purposes (including the desire to communicate ideas to peers, advance the state of knowledge, enhance personal esteem, and so on) are the primary motivations for writing scholarship, while a desire to serve the university “master” is at best secondary.

¶61 Determining that faculty scholarship falls outside the scope of employment accords with the virtually unanimous understanding in the academic community that scholars own the copyright in their scholarship, as reflected in the express institutional policies of most major research universities in this country. It also avoids rendering virtually every academic publisher a mass copyright infringer, since requesting a transfer of copyright from the scholar—not her institution—is the industry practice.<sup>232</sup> Nevertheless, it is a double-edged sword with respect to academic freedom. If the scope of employment analysis turns substantially on schools’ “voluntary” disclaimer of copyright ownership, the presumption is that schools have the power to redefine the scope of employment in the future and “reclaim” their status as legal authors. Powerful justifications remain, therefore, for recognizing a blanket teacher exception for scholarship, bounded by the principle of academic freedom. Most importantly for present purposes, however, is that whether a court employs the teacher exception or the scope of employment analysis, the legal and policy justifications for finding that faculty are the legal authors of their scholarly works are compelling.

¶62 This position contrasts with a proposal by Professor Denicola, who argues that each university should embrace the work for hire rules, claim initial ownership of all scholarly articles produced by its faculty, and then, to preserve academic freedom, automatically transfer copyright ownership to the author less a limited nonexclusive license that the university would retain for itself to make the article publicly available for noncommercial purposes.<sup>233</sup> The proposal is attractive for its legal elegance, but is unlikely to receive broad support in the academic community and raises academic freedom concerns. The proposal cuts against the widely held expectation among academics that they are the legal authors of their scholarship, and it is likely to prove far more difficult to persuade academics to accept universities’ unilateral claim of authorship and subsequent transfer of most rights to faculty members—well intentioned though it may be—than to bind themselves to an open access mandate that allows them to retain copyright authorship and ownership. Furthermore, as discussed above, a strong argument can be made that most

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activity, the employee was not motivated by the employer’s benefit and therefore the third element’s requirements were not met.”).

<sup>231</sup> *Id.* (emphasis added).

<sup>232</sup> One could argue that if universities are deemed to be the copyright owners of scholarly articles under the work for hire rules the publishers would be immune from infringement liability under the theory that universities, by acquiescing historically to publishers’ use and exploitation of scholarly articles, have granted publishers an implied nonexclusive license. Even in that case the results are equally undesirable for publishers. Holding a mere nonexclusive license, the publishers would have no recourse against universities, authors, or even third parties who reproduce the works or disseminate them freely online.

<sup>233</sup> Denicola, *supra* note 141, at 379–82. The University of Michigan has adopted this approach, more or less, although it permits faculty to control the timing and scope of access to their scholarship once the university places the works in its digital repository. See UNIV. OF MICH. STANDARD PRACTICE GUIDE, *supra* note 198, at 1.

scholarship is created outside of the scope of employment for work for hire purposes. Most importantly, Professor Denicola's proposal raises the same academic freedom concerns discussed above in relation to the scope of employment analysis. Vesting in the university legal authorship of scholarship, and the associated legal control, is repugnant to academic freedom principles even if universities are presently inclined to transfer most rights in scholarship back to faculty as Professor Denicola recommends. As Professor Weiner counsels from experience, "never assume that academic institutions—either for whom you work or with whom you publish—care about academic freedom."<sup>234</sup>

### C. *Priority of Nonexclusive Licenses over Conflicting Transfers of Copyright Ownership*

¶63 This Part examines the copyright rules governing nonexclusive licenses, which are the primary form of public access permission, and therefore occupy a central role in open access. Because copyright in the United States attaches immediately and automatically at the moment of a work's creation so long as the work is sufficiently original and fixed in a tangible medium of expression for longer than a transitory duration,<sup>235</sup> any attempt to make the work freely accessible to the public has copyright implications. Even when an author intends to release a work to the public free of cost, he often retains certain interests in the work.<sup>236</sup> An author who wishes to make the work freely available but only under specified conditions might, for example, grant the public certain permissions vis à vis the work under a standardized "open content" license such as a Creative Commons license.<sup>237</sup> The terms of the license, as determined by the author, might grant the public a nonexclusive license to make noncommercial uses of the work or require that any uses of the work attribute ownership and origination to the author. If the author wished to enforce these restrictions, she would have to rely on rights in the work that are senior to those of the subsequent user, and those rights would originate in copyright.

¶64 The situation naturally is more complex when a person other than the author has a claim to copyright ownership—including any exclusive right—in the work.<sup>238</sup> This often arises when an author has made a preprint of an article available in her university or other open access repository but aims to publish the article in a scholarly journal. Journals typically require the author to transfer the entire copyright in the work. If the author decides to make a preprint publicly available, subsequent transfer of the article's copyright to a publisher can raise doubts about the status of the public access permissions attached to the draft.

¶65 Typically, when an author posts a work online in a way that invites others to download, view, reproduce, or redistribute it, the author is granting the world an express or implied nonexclusive license to reproduce and distribute the work. Nonexclusive licenses, therefore, are the lifeblood of open access. Many online scholarship repositories

<sup>234</sup> Weiner, *supra* note 225, at 3. Permission mandates raise far fewer academic freedom concerns as they involve only nonexclusive licenses, not copyright ownership.

<sup>235</sup> 17 U.S.C. § 102(a) (2011).

<sup>236</sup> See generally Loren, *supra* note 112.

<sup>237</sup> See CREATIVE COMMONS, <http://creativecommons.org> (last visited June 3, 2012).

<sup>238</sup> The Copyright Act defines "transfer of copyright ownership" as "an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright . . . but not including a nonexclusive license." 17 U.S.C. § 101 (2011).

require the author to grant the archive and its users a nonexclusive license as a condition of posting the work. For example, arXiv.org, a popular open access repository for scholarly articles in disciplines including physics, mathematics, computer science, quantitative biology, and statistics, requires submitting authors to agree to either license the work to the site and its users under one of two Creative Commons licenses or simply grant the site a “perpetual, non-exclusive license” as part of the site’s terms of service.<sup>239</sup> Indeed, arXiv.org warns that submitters should

take care to upload an article only if they are certain that they will not later wish to publish it in a journal that prohibits prior distribution on an e-print server. arXiv will not remove an announced article to comply with such a journal policy—the license granted on submission is irrevocable.<sup>240</sup>

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What is the status of these prior-existing nonexclusive licenses after the author has transferred copyright ownership to a publisher?<sup>241</sup> Put another way, what rights do universities have to archive and distribute a work initially distributed freely under a nonexclusive license granted by the author but later subject to a transfer of copyright ownership? The Copyright Act says relatively little about nonexclusive licenses, but it does provide for this scenario with some specificity. Although the Act requires a written instrument signed by the transferor to effect a valid transfer of copyright ownership,<sup>242</sup> the statute is silent about whether a writing is required to validate the grant of a nonexclusive license. Courts interpret the omission to mean that a nonexclusive license can be implied or oral; thus, a signed writing is not required to effectuate a nonexclusive license.<sup>243</sup> Section 205(e) does, however, provide that a nonexclusive license memorialized in a signed writing “prevails over a conflicting transfer of copyright ownership.”<sup>244</sup> In other words, any subsequent transfer of copyright ownership (including transfer of a conflicting exclusive right) destroys the permissions created by the earlier nonexclusive license unless a signed writing perfected the license.<sup>245</sup> This is

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<sup>239</sup> *Non-exclusive License to Distribute*, ARXIV.ORG, <http://arxiv.org/licenses/nonexclusive-distrib/1.0/license.html> (last visited June 3, 2012); *see also arXiv License Information*, ARXIV.ORG, <http://arxiv.org/help/license> (last visited June 3, 2012).

<sup>240</sup> *arXiv License Information*, *supra* note 239.

<sup>241</sup> Note that this issue would not affect all open access articles posted online. Some authors post their articles and grant a public nonexclusive license and never subsequently transfer copyright ownership in the article because either the author never publishes it in a journal or journal policy does not require the author to transfer ownership.

<sup>242</sup> 17 U.S.C. § 204(a) (2011).

<sup>243</sup> *See, e.g., Effects Assocs. v. Cohen*, 908 F.2d 555 (9th Cir. 1990).

<sup>244</sup> 17 U.S.C. § 205(e) (2011). Section 205(e) provides:

A nonexclusive license, whether recorded or not, prevails over a conflicting transfer of copyright ownership if the license is evidenced by a written instrument signed by the owner of the rights licensed or such owner’s duly authorized agent, and if—

- (1) the license was taken before execution of the transfer; or
- (2) the license was taken in good faith before recordation of the transfer and without notice of it.

*Id.*

<sup>245</sup> Section 205(e) is ambiguous in that it states conditions under which a nonexclusive license will prevail over a conflicting transfer of copyright ownership, but does not expressly provide that a

true even if the grantor of an oral nonexclusive license intended it to be perpetual and irrevocable.

¶167 The Act does not specify what constitutes a satisfactory writing for the purposes of § 205(e), and to date no court has considered the issue.<sup>246</sup> A court faced with the issue will likely look to sufficiency criteria for writings in the context of transfers of copyright ownership under § 204(a), where case law is abundant. Section 204(a) requires that any transfer of copyright ownership (a concept that includes the grant of any exclusive copyright license but excludes nonexclusive licenses)<sup>247</sup> be memorialized in a written “instrument of conveyance, or a note or memorandum of the transfer, . . . signed by the owner of the rights conveyed or such owner’s duly authorized agent.”<sup>248</sup> Courts and commentators analogize the writing requirement to state statutes of frauds because it performs similar evidentiary and cautionary functions: it aims to reduce fraud and inadvertent transfers of ownership by ensuring that no transfer of ownership can occur without a written record evidencing it; it also forces the parties to consider the terms of the transaction more clearly in order to reduce it to writing and impresses upon them the significance of the transaction.<sup>249</sup> In these ways, “section 204 enhances predictability and certainty of copyright ownership—‘Congress’ paramount goal’ when it revised the Act in 1976.”<sup>250</sup>

¶168 Some courts, when considering the sufficiency of writings in the context of transferring copyright ownership, emphasize effectuating the intent of the parties over adherence to any specific set of formalities in the writing.<sup>251</sup> Naturally, a written transfer agreement signed by the transferor that unambiguously provides the essential terms—the identities of the parties, the works at issue, and the scope of the rights transferred—would suffice. Short of an unambiguous express written agreement or memorandum, courts vary somewhat on the level of specificity they require—for example, the extent to which essential terms must be unambiguously provided for in the writing.<sup>252</sup> Courts generally

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nonexclusive license will prevail under the stated conditions only. According to the legislative history, however, the provision was specifically intended to “*require a nonexclusive license to be in writing and signed by the copyright owner before it can be given priority over a conflicting transfer.*” H.R. REP. NO. 90-83, at 96 (1967) (emphasis added).

<sup>246</sup> As of this writing, only one opinion has addressed the question of the sufficiency of a written instrument memorializing the prior grant of a nonexclusive license under § 205(e). In that case, however, the form of the writing—a payment receipt signed by an alleged representative of the author—was inconsequential because the court refused to find the alleged nonexclusive license existed because it was predated by the author’s transfer of copyright to the plaintiff, and in any event the court found the defendant’s testimony concerning the very existence of the nonexclusive license to be “unbelievable.” *Ice Music Ltd. v. Schuler*, 1996 WL 474192, at \*5–6 (S.D.N.Y. 1996).

<sup>247</sup> 17 U.S.C. § 101 (2011).

<sup>248</sup> 17 U.S.C. § 204(a) (2011).

<sup>249</sup> See *Effects Assocs. v. Cohen*, 908 F.2d 555, 557 (9th Cir. Cal. 1990); 3 NIMMER & NIMMER, *supra* note 153, § 10.03[A][2]; 2 PATRY, *supra* note 209, § 5:106.

<sup>250</sup> *Effects Assocs.*, 908 F.2d at 557.

<sup>251</sup> The Copyright Act provides that a “note or memorandum of the transfer”—presumably memorializing a prior oral agreement to transfer—will also suffice. 17 U.S.C. § 204(a) (2011); 3 NIMMER & NIMMER, *supra* note 153, § 10.03[A][2].

<sup>252</sup> Compare *Pamfiloff v. Giant Records, Inc.*, 794 F. Supp. 933, 935–36 (N.D. Cal. 1992) (finding insufficient as a signed writing an unsigned, undated document referencing royalty payments combined with a recording agreement that “makes no mention of any transfer of ownership rights in the musical compositions” and contains “no provisions transferring to plaintiff any of the rights to reproduce, perform, distribute, market, promote, or otherwise exploit the compositions”), with *SCO Group, Inc. v. Novell, Inc.*, 578 F.3d 1201, 1212–13 (10th Cir. Utah 2009) (“[W]hen it is clear that the parties contemplated that

look to see that the writing is sufficient to memorialize an agreement intending to transfer copyright ownership and is not so vague that the intent of the parties is unclear.<sup>253</sup> Of particular relevance, in *Forasté v. Brown University*, the court held a university policy purporting to vest in the employee (a university staff photographer) “ownership of copyrightable property [] result[ing] from performance of one’s University duties and activities”<sup>254</sup> insufficient as a writing for purposes of § 204(a). The policy, the court observed, “fails to make any reference at all to the subject matter of the rights to be transferred, the recipient of the transferred rights, the timing of the transfer, or any other particulars of the deal.”<sup>255</sup>

¶69 Patry argues in his copyright treatise that it is misguided to focus on the parties’ intent when determining whether a writing is sufficient to evidence a transfer of copyright ownership under § 204(a).<sup>256</sup> Rather, the provision’s underlying purpose of “protect[ing] authors from those claiming, contrary to the authors’ view of the facts, that he or she transferred rights in the work” necessitates that the sole inquiry be whether the formal statutory writing requirements are met, construing any ambiguity or insufficiency in the writing in favor of the author or present copyright owner.<sup>257</sup>

¶70 Just as courts refer to the purposes underlying § 204(a) when interpreting the sufficiency of a writing under that section of the statute,<sup>258</sup> it makes sense to evaluate writings under § 205(e) in light of the section’s purposes. Sections 204(a) and 205(e) address somewhat different concerns, however. Section 204(a) aims to protect against fraudulent or inadvertent transfers of copyright ownership. Section 205(e), on the other hand, governs priority of nonexclusive licenses over subsequent conflicting transfers of copyright ownership, and thus seeks to clarify the interests of nonexclusive licensees versus copyright transferees. Congress adopted § 205(e) ostensibly to protect purchasers of expensive exclusive rights in commercially valuable works against unknown prior nonexclusive licenses that could diminish or destroy the value of the later-acquired exclusive right.<sup>259</sup> The motion picture industry lobbied for a rule that would have given priority to only those earlier nonexclusive licenses that were recorded, ensuring that purchasers of exclusive motion picture rights would have adequate notice of any preexisting nonexclusive licenses.<sup>260</sup> Legislators expressed concern, however, about the

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copyrights transfer, we do not think that a linguistic ambiguity concerning which particular copyrights transferred creates an insuperable barrier invalidating the transaction.”).

<sup>253</sup> See 3 NIMMER & NIMMER, *supra* note 153, § 10.03[A][1].

<sup>254</sup> 290 F. Supp. 2d 234, 236 (D.R.I. 2003).

<sup>255</sup> *Id.* at 240.

<sup>256</sup> 2 PATRY, *supra* note 209, § 5:106.

<sup>257</sup> *Id.*

<sup>258</sup> See, e.g., *Pamfiloff v. Giant Records, Inc.*, 794 F. Supp. 933, 936 (N.D. Cal. 1992) (“Section 204(a) is analogous to a statute of frauds . . . as its purpose ‘is to protect copyright holders from persons mistakenly or fraudulently claiming oral licenses.’ Thus, it is appropriate to borrow the requirements necessary to satisfy the statute of frauds to determine whether a given document satisfies.” (citations omitted)).

<sup>259</sup> See *Copyright Law Revision: Hearings on H.R. 4347, H.R. 5680, H.R. 6831, and H.R. 6385 Before Subcomm. No. 3 of the H. Comm. on the Judiciary*, 89th Cong. 1035 (1966); H.R. REP. NO. 90-83, at 199–200 (1967).

<sup>260</sup> H.R. REP. NO. 94-1476, at 129 (1976) (“Under subsection (f) [now (e)] of section 205, a nonexclusive license in writing and signed, whether recorded or not, would be valid against a later transfer, and would also prevail as against a prior unrecorded transfer if taken in good faith and without notice. Objections were raised by motion picture producers, particularly to the provision allowing unrecorded

administrative burden that would result from a rule requiring the recordation of nonexclusive licenses.<sup>261</sup> The Register of Copyrights recommended a rule that every nonexclusive license prevails over a subsequent transfer of copyright ownership, requiring neither that nonexclusive licenses be recorded nor that they be in writing.<sup>262</sup> Congress ultimately split the difference, providing that a prior nonexclusive license in writing prevails over a subsequent transfer of copyright ownership but that the license need not be recorded.<sup>263</sup> It appears, therefore, that Congress intended writings under § 205(e) to provide subsequent transferees with some measure of notice and evidence of the prior nonexclusive license's existence.<sup>264</sup>

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The upshot for open access is that online repositories that require submitting authors to grant an express, written nonexclusive license to reproduce and distribute the article should be able to rely on those licenses even after the author transfers copyright ownership to a publisher. Repositories often do require authors to fill out an electronic form with the author's name and the title of the article, and to click a button indicating agreement with the site's terms of service, which specify the scope of the copyright license being granted to the site.<sup>265</sup> These elements form the essential terms of the license and the fact that the grant and "signature" are in electronic form seems unlikely to render the licenses unsatisfactory as "writings."<sup>266</sup> Schools that host and distribute faculty scholarship are well advised to require the author to complete such an online form and expressly assent to the grant of a nonexclusive license by clicking "upload" or "submit." Alternatively (or additionally), schools can follow Harvard's lead and request that faculty sign paper licenses to satisfy the requirements of § 205(e). Many scholars also request that publishers sign an author-proposed addendum to the publisher's standard publication agreement.<sup>267</sup> The addendum expressly acknowledges the prior nonexclusive license granted to the institution, identifies the work and the author, and bears the author's signature; it therefore usually should be a writing sufficient to memorialize the nonexclusive license for purposes of § 205(e).

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nonexclusive licenses to prevail over subsequent transfers, on the ground that a nonexclusive license can have drastic effects on the value of a copyright. On the other hand, the impracticalities and burdens that would accompany any requirement of recordation of nonexclusive licenses outweigh the limited advantages of a statutory recordation system for them.").

<sup>261</sup> *Id.*

<sup>262</sup> REGISTER OF COPYRIGHTS, U.S. PATENT & TRADEMARK OFFICE, REPORT ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 97 (Comm. Print 1961).

<sup>263</sup> 17 U.S.C. § 205(e) (2011).

<sup>264</sup> H.R. REP. NO. 90-83, at 96 (1967) ("The committee, while recognizing the practical problems of transferees in identifying and dealing with outstanding nonexclusive licenses, concluded that the impracticalities and burdens that would accompany any requirement of recordation of nonexclusive licenses outweigh the limited advantages of a statutory recordation system for them. On the other hand, it accepted the proposal, advanced by producers of audiovisual materials, that subsection (f) [now (e)] in the 1965 bill be amended to require a nonexclusive license to be in writing and signed by the copyright owner before it can be given priority over a conflicting transfer.").

<sup>265</sup> See, e.g., MICHAEL W. CARROLL, SPARC ET AL., COMPLYING WITH THE NATIONAL INSTITUTES OF HEALTH PUBLIC ACCESS POLICY: COPYRIGHT CONSIDERATIONS AND OPTIONS 10 (2008) (describing the NIH's internet browser-based electronic manuscript submission process involving a "submission statement" expressly providing for the manuscript's "public release," to which the submitter assents by clicking "Agree").

<sup>266</sup> See 3 NIMMER & NIMMER, *supra* note 153, § 10.03[A][1].

<sup>267</sup> See *supra* notes 116–117 and accompanying text.



¶72 A more challenging question is whether, in the absence of such an individual writing, a collective policy such as a permission mandate could initiate the grant of a nonexclusive license and constitute a sufficient writing for purposes of § 205(e). If not, the subsequent transfer of copyright ownership would nullify the nonexclusive license that members of the public believe they hold, and in many cases, those licensees would not even be aware of the transfer. Pervasive uncertainty about the status of permissions granted by many such licenses would result. The next Part considers whether permission mandates effectuate the grant of nonexclusive licenses, and if so, whether those licenses are likely to survive a subsequent conflicting transfer of copyright ownership.

#### IV. EVALUATING THE LEGAL EFFECT OF PERMISSION MANDATES: A CONTEXT-SENSITIVE APPROACH

##### A. *Do Permission Mandates Grant Universities Durable Nonexclusive Licenses?*

¶73 The permission mandate is attractive to open access proponents because it blends a powerful grant of rights with ingenious simplicity. By its own terms, the policy upon enactment automatically and prospectively grants the university a broad nonexclusive license in each faculty member's scholarly articles without requiring the faculty or the university to comply with any further formalities. The nonexclusive license purportedly covers *all* rights under copyright pertaining to scholarly articles, namely the rights to reproduce, prepare derivative works based on the copyrighted work, distribute copies, perform the work publicly, and display it publicly.<sup>268</sup> The school thus receives maximum flexibility with which to archive, preserve, and distribute faculty scholarship at low administrative cost by making the mechanism for obtaining licenses for faculty scholarship practically and politically feasible. Obtaining a signed license from every faculty member at an institution would be challenging, to say the least. Many faculty members simply find copyright agreements confusing, intimidating, or not worth their time. Others may be unaware of, misunderstand, or disagree with open access principles, while others might be philosophically opposed to signing any grant of copyright rights to the university.

¶74 Schools that resolve to enact an open access mandate should have clear expectations about what they intend it to accomplish. Do they intend it to have the legal effect of reposing nonexclusive licenses in the university (as the language of most permission mandates suggests), or is it an aspirational statement in support of open access principles? Some schools, including Harvard, appear to view the policy language as a "back-up" license, relying primarily on written licenses that provide the same nonexclusive license grant as the policy.<sup>269</sup> As mentioned above, however, it is not always feasible to acquire a writing from every faculty member. If schools rely on permission mandates for their legal effect, and if the terms of the mandate policy are somehow insufficient to effectuate the grant of nonexclusive licenses in scholarly articles from faculty to the university, then the university is exposed to copyright infringement

<sup>268</sup> *Harvard FAS Mandate*, *supra* note 11; 17 U.S.C. § 106 (2011).

<sup>269</sup> The NIH similarly views its general "federal purpose" licenses as a back-up, requiring all NIH grantees to grant an express "public access" license upon submission of the manuscript to PubMed Central and relying primarily on the public access license. *See infra* note 301 and accompanying text; CARROLL, *supra* note 265, at 5–7.

liability risk. There are two possible sources of such risk: the faculty member author if he retains copyright ownership, and a subsequent transferee of copyright ownership, namely a journal publisher. The risk of litigation from the former seems slight. It is plausible, however, that publishers would consider suing universities if publishers fear that open access mandates threaten their business model.<sup>270</sup> That three large academic publishers have sued Georgia State University over the school's practice of making scholarship available to students as "e-reserves" exemplifies publishers' willingness to sue universities over a practice that threatens revenues.<sup>271</sup> Academic journal publishers ardently oppose the NIH open access policy, and lobbied in support of a bill that would force the NIH to repeal the policy.<sup>272</sup> These actions further exemplify publishers' fear that open access would negatively affect their revenue streams. If permission mandates propagate, publishers might attempt to discourage their spread by threatening one or more "mandate" schools with an infringement lawsuit. If permission mandates remain an important strategy of the open access movement, the threat of copyright litigation over works released under such policies could chill the movement as university administrators worry about the litigation risks involved in adopting a mandate.

¶75 As noted above,<sup>273</sup> some "mandate schools," including Harvard, reinforce the policy by seeking a signed license from each faculty member individually<sup>274</sup> that duplicates the policy's grant language. The school can then rely on the signed licenses as durable grants of nonexclusive rights. Nevertheless, most U.S. schools that have adopted open access mandates have opted for permission-style mandates, presumably in part because obtaining signed licenses from all, or even most, faculty members is usually not feasible even if it is prudent.

¶76 For a school to rely on the nonexclusive licenses that a permission mandate purportedly grants, the policy must accomplish two things. First, it must effect the grant of a prospective nonexclusive license for all future scholarly articles by faculty members.

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<sup>270</sup> One commercial publisher points out that "'traditional' publishers are far more concerned about the long-term impact of institutional repositories than the author-pays model." Robinson, *supra* note 81, at 1458.

<sup>271</sup> See Katie Hafner, *Publishers Sue Georgia State on Digital Reading Matter*, N.Y. TIMES, Apr. 16, 2008, at C2. "E-reserving" is the digital analog of the traditional practice in universities by which faculty keep a physical copy of a book or article on library reserve for students, who can view it at their convenience but cannot remove the copy from the library. Today, faculty often scan or download a copy of a book chapter or article and post it to a server where students can access it, which sometimes includes printing, downloading, or sharing a copy. See Andrew Richard Albanese, *A Failure to Communicate: In a Lawsuit Against Georgia State University over E-reserves, Scholarly Publishing Faces a Defining Moment*, PUBLISHERS WKLY., Jun. 14, 2010, at 26. Publishing royalties displaced by the practice of e-reserving "'is a significant enough revenue stream for publishers to be concerned about. . . . The paperback and the permissions markets have eroded over time because of e-reserves and course management systems . . .'" *Id.* (quoting the Executive Editor for Social Sciences and Humanities at Penn State University Press).

<sup>272</sup> See Fair Copyright in Research Works Act, H.R. 801, 111th Cong. (2009); see also Lawrence Lessig & Michael Eisen, *John Conyers, It's Time to Speak Up*, HUFFINGTON POST (Mar. 6, 2009, 12:19 PM), [http://www.huffingtonpost.com/lawrence-lessig-and-michael-eisen/john-conyers-its-time-to\\_b\\_172536.html](http://www.huffingtonpost.com/lawrence-lessig-and-michael-eisen/john-conyers-its-time-to_b_172536.html) (citing a report that the bill was backed by publisher lobbying money); John Willinsky, *The Publisher's Pushback Against NIH's Public Access and Scholarly Publishing Sustainability*, PLOS BIOLOGY, Jan. 27, 2009, <http://www.plosbiology.org/article/info:doi/10.1371/journal.pbio.1000030>. In 2011, a new bill was introduced in Congress again seeking to repeal the NIH open access policy. See Research Works Act, H.R. 3699, 112th Cong. (2011).

<sup>273</sup> See *supra* text accompanying notes 265–267.

<sup>274</sup> The license might be in paper or electronic form.

Second, even if the policy effectuates such a grant, the licenses granted must be durable: they must be able to survive a conflicting subsequent transfer of copyright ownership<sup>275</sup> to a journal that agrees to publish the article.<sup>276</sup>

### 1. Do Permission Mandates Effectuate Nonexclusive License Grants?

¶77 To find the grant of a nonexclusive license effective, the terms “[a]s with any other license . . . should be reasonably clear.”<sup>277</sup> Generally, the key question is whether the intent of the parties and essential terms of the license are evident enough to support finding a nonexclusive license.<sup>278</sup>

¶78 One might conclude that the mandate policy on its own is insufficient to grant nonexclusive licenses. Two essential terms for establishing a nonexclusive license—identification of the parties and works involved—are arguably unacceptably vague. While the mandate adequately specifies the school as the licensee, the licensors are identified in far more general terms: all faculty members of the school.<sup>279</sup> Likewise, the policy fails to identify the specific works licensed. Instead, it purports to encompass *all* scholarly articles written by faculty following adoption of the policy, with the exception of those for which the policy is waived upon request.<sup>280</sup> The unorthodox waiver provision might cast further doubt on the clarity and precision of the grant: is a grant illusory if any or all works purportedly covered by it can be exempted at any time by the grantor at will? Most importantly, the structure of the permission mandate raises concerns about evidence of grantor intent. By sweeping in an entire class of authors and works, the policy might appear more like a unilateral acquisition of rights by the institution than a voluntary grant by authors.

¶79 In this Author’s view, however, permission mandates are adequate to evidence an affirmative grant of nonexclusive rights to the institution and to constitute a writing for the purposes of perfecting the licenses against conflicting subsequent transfers of copyright ownership. While the grant language of permission mandates does not specify each grantor by name, there is no rule that it must. The grant should simply reasonably identify the parties, and a compelling argument exists that it does. The language clearly identifies the grantors as faculty members,<sup>281</sup> and it is easy to determine who comprises the faculty at an institution. Likewise, the permission mandate adequately identifies subject works as scholarly articles written by members of the institution’s faculty during their time on the faculty but after adoption of the policy.<sup>282</sup> While the permission

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<sup>275</sup> Recall that under the Copyright Act the transfer of any exclusive right is considered a “transfer of copyright ownership.” 17 U.S.C. § 101 (2011).

<sup>276</sup> See *supra* Part III.C (discussing § 205(e) of the Copyright Act).

<sup>277</sup> 3 NIMMER & NIMMER, *supra* note 153, § 10.03[A][7] (discussing criteria for finding the existence of an implied nonexclusive license).

<sup>278</sup> *Id.*

<sup>279</sup> See *Harvard FAS Mandate*, *supra* note 11 (“*Each Faculty member grants to the President and Fellows of Harvard College permission to make available his or her scholarly articles . . .*”) (emphasis added).

<sup>280</sup> *Id.*

<sup>281</sup> *Id.*

<sup>282</sup> *Id.* The policy further limits the scope of covered works by excluding “any articles for which the Faculty member entered into an incompatible licensing or assignment agreement before the adoption of this policy.” *Id.* Courts generally hold unenforceable for public policy reasons blanket provisions purporting to

mandate does not enumerate the specific works subject to the grant—by its own terms, the grant is prospective—that fact is unlikely to be material. Such prospective grants are commonplace in the entertainment industry, for example, where music publishing companies routinely sign promising songwriters to deals in which the songwriter assigns copyright in any compositions that do not exist when the agreement is executed but are created later during the term of the agreement.<sup>283</sup> In short, it is easy to ascertain with certainty which works are within the purview of the policy.

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As for the issue of grantor intent, the grantor's intent may be inferred from the circumstances. U.S. schools that adopt permission mandates typically do so by way of a faculty vote. Harvard's Faculty of Arts and Sciences, for example, adopted its mandate by a unanimous vote of the faculty (that is, of those faculty present and voting).<sup>284</sup> Presumably, the faculty present and voting in favor of the policy are expressly assenting to the terms of the grant, but what of faculty not present, not voting, or voting in opposition? Can properly enacted faculty legislation intended to bind the faculty as a whole constitute assent? Because nonexclusive copyright licenses need not be in writing and do not involve the transfer of any exclusive rights,<sup>285</sup> courts have developed a fairly liberal conception of nonexclusive licenses. Courts have found that nonexclusive licenses may even be implied, as "consent given in the form of mere permission or lack of objection is also equivalent to a nonexclusive license."<sup>286</sup> For example, Internet search engines have an implied license to copy and display content posted on webpages if the website publisher fails to embed code in the webpage instructing search engines not to cache.<sup>287</sup> One commentator suggests that by continuing to work under a university's intellectual property policy that purports to transfer a copyright interest from the faculty member to the school, the faculty member "has acquiesced to a nonexclusive license for

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acquire rights in all future creations by an author or inventor, sometimes evocatively referring to such provisions as a "mortgage on a man's brain." *Aspinwall Mfg. Co. v. Gill*, 32 F. 697, 700 (C.C.D.N.J. 1887). However, in the patent context, university policies that prospectively transfer rights in all future works or inventions resulting from research performed at the university have been held to be sufficiently well-defined to avoid unenforceability under this rule. *See St. John's Univ. v. Bolton*, 757 F. Supp. 2d 144, 161–62 (E.D.N.Y. 2010) ("Federal courts have consistently upheld the validity of patent-assignment obligations imposed on university students, faculty, and staff as a condition of their research activities at the university. These patent-assignment provisions do not implicate all of a researcher's future inventions 'in gross'; instead, . . . they apply to inventions derived from research performed while the researcher is at the university.") (citations omitted).

<sup>283</sup> *Contractual Obligation Prods., LLC v. AMC Networks, Inc.*, 546 F. Supp. 2d 120, 127 (S.D.N.Y. 2008) (calling prospective assignments of copyright "commonplace in the entertainment industry" and stating that they "have repeatedly been held enforceable in federal courts"); *see also Gladys Music, Inc. v. Arch Music Co.*, 150 U.S.P.Q. 26 (S.D.N.Y. 1966). While cases have held that "a copyright licensing agreement can assign only preexisting copyrights," *see, e.g., Recht v. Metro Goldwyn Mayer Studio, Inc.*, 580 F. Supp. 2d 775, 784 (W.D. Wis. 2008), Professor Nimmer observes that that position appears to be "without substance." 3 NIMMER & NIMMER, *supra* note 153, § 10.03[A][8]. Prospective grants of property interests are also well established in commercial law. *See* U.C.C. § 9-204(a) (2011–12 Official Text) (establishing the validity of security interests granted in after-acquired property).

<sup>284</sup> *Open Access*, HARV. MAG., May–June 2008, at 61, available at <http://harvardmag.com/pdf/2008/05-pdfs/0508-61.pdf>.

<sup>285</sup> *See supra* notes 238–243 and accompanying text.

<sup>286</sup> *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775 (7th Cir. 1996); *see also Lowe v. Loud Records*, 126 Fed. Appx. 545, 547 (3d Cir. 2005) ("Circumstances establishing permission, or even lack of objection, can establish a nonexclusive license.") (citing *Shaver*, 74 F.3d at 775).

<sup>287</sup> *See Field v. Google Inc.*, 412 F. Supp.2d 1106, 1116 (D. Nev. 2006).

use of the copyrighted work.”<sup>288</sup> This argument seems especially forceful where, in the case of permission mandates, the faculty has adopted an express policy granting the school a nonexclusive license. Moreover, many universities’ employment agreements have provisions to the effect that the “Faculty Member agrees . . . to adhere to and enforce all University policies and regulations in place from time to time,” incorporating the policy by reference.<sup>289</sup> In short, it appears there are ample grounds on which to conclude that a faculty member at a permission mandate school acquiesces to the grant of a nonexclusive license. This conclusion seems inescapable where a permission mandate includes a waiver or opt-out provision such as that of the Harvard mandate, and the faculty member fails to object to the license by seeking a waiver.<sup>290</sup>

## 2. Do Permission Mandates Satisfy § 205(e)’s Writing Requirement?

¶81 If permission mandates do effectuate the grant of nonexclusive licenses in scholarly articles, as this Article argues they do, will those licenses survive after authors transfer their articles’ copyright ownership to publishers? As discussed above, § 205(e) provides that a nonexclusive license will prevail over a subsequent transfer of copyright ownership if the license is evidenced in a writing signed by the licensor.<sup>291</sup> The question still remains, however, whether the existence of a permission mandate constitutes a “written instrument” for the purposes of § 205(e).

¶82 When determining the sufficiency of written instruments under § 204(a), which governs transfers of copyright ownership, courts and commentators typically refer to the purposes underlying the writing requirement.<sup>292</sup> Courts considering the sufficiency of a writing for purposes of § 205(e) should similarly consider Congress’ apparent intentions behind § 205(e)’s writing requirement: the writing enhances certainty and reduces risk to subsequent copyright transferees by providing tangible evidence and potential notice of the nonexclusive license.<sup>293</sup> Permission mandates provide an unambiguous record of the license and its terms, and potentially provide actual notice to prospective copyright transferees (that is, academic publishers) that articles authored by any faculty member covered by the policy are subject to a nonexclusive license.<sup>294</sup> Permission mandates are

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<sup>288</sup> Gibbons, *supra* note 193, at 869.

<sup>289</sup> See, e.g., *Employment Agreements*, VILLANOVA U., <http://www.villanova.edu/vpaa/office/facultyservices/guidelines/handbook/recruitment/agreements.htm> (last visited Mar. 1, 2012). Note that this language is quoted as an example of provisions in faculty employment agreements that incorporate university policies by reference. Villanova University does not have a permission mandate in place at the time of this writing.

<sup>290</sup> A faculty member’s failure to object to the license by seeking a waiver of the policy should be construed as acquiescence. For a discussion about whether this result unduly encroaches on the author’s autonomy interests, see Part IV.B.1, *infra*.

<sup>291</sup> See *supra* Part III.C.

<sup>292</sup> See *supra* text accompanying notes 249–258.

<sup>293</sup> See *supra* text accompanying notes 259–263.

<sup>294</sup> Academic publishers are, unsurprisingly, well aware of Harvard’s permission mandate. See Mary Minow, *Open Access to Scholarship, Part I: A Conversation with Michelle Pearse*, COPYRIGHT & FAIR USE (Dec. 30, 2010, 5:10 PM), <http://fairuse.stanford.edu/blog/2010/12/open-access-to-scholarship-par.html> (“Most of the larger publishers of the peer-reviewed journals are already aware of [Harvard’s open access] policy, and some have started asking their authors to show proof that they have submitted waivers.”) (quoting Michelle Pearse, Research Librarian for Open Access Initiatives and Scholarly Communication at Harvard Law School). As a practical matter, a publisher arguing that any nonexclusive license the university may hold by virtue of the mandate has been voided for failure to satisfy the signed

publicly available on university websites and are often publicized in press releases and news stories. They provide, therefore, far better notice to potential copyright transferees than would be the case if one merely complies with the minimum statutory requirements. A private writing between parties might satisfy the requirements of § 205(e) but might also be completely unknown to, and therefore provide no notice to, a subsequent transferee of copyright ownership.

¶83 While permission mandates fulfill § 205(e)'s policy goals of providing evidence and potential notice of the license, they are not a traditional signed writing. Nevertheless, it is reasonable to find that the permission mandates satisfy § 205(e)'s writing requirement in many instances. Many universities expressly incorporate school policies into faculty employment agreements by reference.<sup>295</sup> Where they do so, an argument can be made that the signed agreement incorporating policies by reference, including the open access policy, is a signed writing for purposes of § 205(e). Even when a faculty employment agreement does not expressly incorporate university policies, it could impliedly incorporate them based on the university and faculty member's mutual expectation of compliance with school policies.<sup>296</sup> Although courts have been disinclined to find that a school copyright policy satisfies § 201(b)'s writing requirement (rebutting the presumption of employer ownership under the work for hire rules),<sup>297</sup> those cases are generally inapposite. Concerns underlying the writing requirements of §§ 201(b) and 204(a) relating to inadvertent or fraudulent divestment of copyright ownership are

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writing requirement under § 205(e) would face a conundrum. After all, journal publishers have sought copyright assignments from authors, not institutions. Publishers would risk that a court would not recognize the teacher exception and deem scholarly articles to be created within the scope of employment for purposes of the work for hire doctrine (contrary to the opinion expressed in this Article). *See supra* Part III.B.4. In that case, the universities own the copyright in scholarship. Publishers' chain of title would then rely on university copyright disclaimer policies. As discussed above, however, courts have been reluctant to find that such policies satisfy § 201(b)'s requirement that presumptive employer ownership be rebutted by a writing signed by both parties. *See supra* note 193. This would put the publisher in the difficult position of having to argue that its copyrights are valid because copyright disclaimer policies are sufficient writings to effect a transfer of copyright ownership from the institution to the author, but mandate policies are insufficient writings to enable the nonexclusive mandate license to prevail over the subsequent transfer of copyright ownership to the publisher.

<sup>295</sup> *See supra* note 289 and accompanying text.

<sup>296</sup> While cases considering whether employee handbooks are incorporated by reference into employment agreements typically consider the question from the perspective of whether the *employer* is bound by promises or representations in the handbook, the consensus seems to be that policies in handbooks may be incorporated. *See* Robert K. Kuehn, *A Normative Analysis of the Rights and Duties of Law Professors to Speak Out*, 55 S.C. L. REV. 253, 264–65 (2003) (“A majority of states recognize that employers may be bound by specific promises in personnel handbooks, and some courts have incorporated the terms of handbooks even when there is an express disclaimer that the manual does not create enforceable rights.”) (footnote omitted); 19 WILLISTON ON CONTRACTS § 54:10 (4th ed. 2011) (“Various rationales for finding that the terms of a[n employee] handbook were incorporated into an employment contract have been set forth in the cases.”).

<sup>297</sup> *See, e.g.,* Manning v. Board of Trustees, 109 F. Supp. 2d 976 (C.D. Ill. 2000). The plaintiff in *Manning*, a community college staff photographer, claimed that the college's copyright policy, which provided that “Members of the staff who develop materials . . . shall have complete copyrights to such materials,” constituted an agreement sufficient to overcome the presumption of employer ownership under § 201(b). *Id.* at 978. He argued that the policy satisfied § 201(b)'s signed writing requirement because the policy was incorporated by reference into his employment agreement. *Id.* at 980. The court declined to decide whether the agreement incorporated the policy by reference, holding that even if it did that merely created an implied contract, which was unhelpful to the plaintiff because “[a]n agreement altering the statutory presumption under [§ 201(b) of] the Copyright Act must be *express*.”

inapplicable to § 205(e) and nonexclusive licenses.<sup>298</sup> Moreover, permission mandates employ the language of an express license, as opposed to many university copyright policies that state general policy positions. Lastly, the notice and documentation of the prior nonexclusive license that the policies provide adequately protect potential transferees of copyright ownership. Finding that permission mandates satisfy § 205(e)'s writing requirement would not, therefore, unduly prejudice the copyright owner's interests or divest her of ownership.

¶84 Notably, the interpretation of permission mandates as sufficient writings for § 205(e) purposes is consistent with how the federal government appears to treat "federal purpose" licenses. The nonexclusive license grant in permission mandates mirrors established federal research grant policy, which vests in federal funding agencies "a royalty-free, nonexclusive and irrevocable right to reproduce, publish, or otherwise use [any work developed under a grant] for Federal purposes, and to authorize others to do so."<sup>299</sup> While the terms and language of funding agreements can vary significantly by agency, agreements typically only incorporate the federal purpose license into the agreement by reference to the relevant federal regulation. Because the university, and not the individual researcher or researchers, is typically the designated grantee,<sup>300</sup> it is the university's obligation to prospectively grant this federal purpose license for the work.<sup>301</sup> Universities can reasonably claim that each researcher (assuming faculty are the legal authors of their scholarship) grants the school an implied nonexclusive license to reproduce and distribute any scholarly articles resulting from the research, and authorize others to do the same, in exchange for access to the research funds. Unsurprisingly, the NIH has taken the position that the nonexclusive federal purpose licenses it receives from grantee universities prevail over subsequent conflicting transfers of copyright ownership.<sup>302</sup> If granting agencies can rely on a writing that satisfies § 205(e), then, it will typically be an agreement signed by the award grantee incorporating the regulation by reference.

¶85 Lastly, it is worth pausing to consider a possible alternative interpretation of § 205(e). The language of § 205(e) is ambiguous: it provides only that a nonexclusive license "prevails over a conflicting transfer of copyright ownership if the license is

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<sup>298</sup> This interpretation of a sufficient writing under § 205(e) is consistent with the position that a general university copyright policy does not satisfy the writing requirements for purposes of § 204(a) (transfers of copyright ownership) or § 201(b) (rebutting the presumption of employer ownership of a work made for hire) given the substantially different rationales and concerns underlying the writing requirements in §§ 204(a) and 201(b) (concerns about fraudulent and inadvertent divestment of copyright ownership) as compared with that of § 205(e) (notice to subsequent copyright transferees). *See supra* Parts III.B.3, III.C.

<sup>299</sup> 2 C.F.R. § 215.36 (2011).

<sup>300</sup> *See* LEO F. BUSCHER, JR., U.S. DEPT. OF HEALTH & HUM. SERVS., EVERYTHING YOU WANTED TO KNOW ABOUT THE NCI GRANTS PROCESS BUT WERE AFRAID TO ASK 39 (2005).

<sup>301</sup> *See* CARROLL, *supra* note 265, at 5. Additionally, although the NIH maintains that it could rely on the federal purpose licenses alone to make these works publicly available, it nevertheless requires grantees to expressly grant a nonexclusive license when submitting the manuscript (the NIH's "public access license"). *See id.* at 5–7.

<sup>302</sup> NAT'L INSTS. OF HEALTH, REVISED POLICY ON ENHANCING PUBLIC ACCESS TO ARCHIVED PUBLICATIONS RESULTING FROM NIH-FUNDED RESEARCH, NOT-OD-05-022 (Apr. 7, 2008), *available at* <http://grants.nih.gov/grants/guide/notice-files/not-od-05-022.html> ("NIH does not need to seek permission from journals who may acquire copyrights from authors or institutions because any copyright transfer or assignment is currently subject to the government purpose license . . .").

evidenced by a written instrument signed by the owner.”<sup>303</sup> Section 205(e) could therefore be interpreted as setting forth conditions that are sufficient but not necessary for a nonexclusive license to prevail over a conflicting transfer of copyright ownership. That is, if the nonexclusive license is memorialized in a signed writing then it prevails over a conflicting transfer of ownership; if the license is not in writing it may still survive a subsequent transfer of ownership if the nonexclusive license is deemed irrevocable under state law.<sup>304</sup> Under this interpretation, the express grant of an irrevocable nonexclusive license (such as the licenses granted under permission mandates) could still prevail over a conflicting transfer of copyright ownership even in the absence of a signed writing. Alternatively, § 205(e) might be interpreted as having an implied negative, that is, a nonexclusive license does not prevail over a conflicting transfer of copyright ownership if the license is not evidenced by a written instrument signed by the owner. It appears from the legislative history that Congress intended the latter interpretation, as § 205(e) was meant to “*require* a nonexclusive license to be in writing and signed by the copyright owner before it can be given priority over a conflicting transfer.”<sup>305</sup>

### B. Taking into Account the Nonmarket Context of Scholarly Production

#### 1. Permission Mandates and Authorial Autonomy

¶86 Even if a blanket policy such as a permission mandate can effectuate a license grant from a class of individuals (the faculty members at an institution), as I have argued above that it can, would such a grant unduly interfere with the author’s autonomy interests? This Section examines the notion of authorial autonomy in copyright and concludes that it would not.

##### i) Analogy to the Google Books Settlement Agreement’s Opt-Out Structure

¶87 The permission mandate’s opt-out structure is bound to raise concerns about authorial autonomy. It is reminiscent of the opt-out scheme proposed in the recent Google Books settlement, which the court ultimately rejected in part due to concerns about the potential for the involuntary transfer of rights, even nonexclusive rights.<sup>306</sup> Google, as defendant in a class action copyright suit over its massive book digitization project, sought to use a proposed settlement agreement to acquire broad nonexclusive rights to reproduce and sell digital copies of all works owned by class members, which amounted to virtually every book subject to U.S. copyright law.<sup>307</sup> While the settlement agreement ensured that copyright owners could at any time opt to exclude their works from the scope of the agreement and Google’s services, the agreement set as the default a

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<sup>303</sup> 17 U.S.C. § 205(e) (2011). In addition, the statute requires that the nonexclusive license “was taken before execution of the transfer” or “was taken in good faith before recordation of the transfer and without notice of it.” *Id.*

<sup>304</sup> Professor Nimmer argues that a nonexclusive license must be backed by consideration to be irrevocable. 3 NIMMER & NIMMER, *supra* note 153, § 10.03[A][8]. *Contra* 2 PATRY, *supra* note 209, § 5:128 (arguing that the terms of a nonexclusive license, including whether or not the license is irrevocable, are determined by the parties’ intent regardless of the presence or lack of consideration).

<sup>305</sup> H.R. REP. NO. 90-83, at 96 (1967) (emphasis added).

<sup>306</sup> *See* Authors Guild v. Google Inc., 770 F. Supp. 2d 666 (S.D.N.Y. 2011).

<sup>307</sup> *Id.* at 675–77.



grant of rights to Google to copy and sell every book subject to the agreement unless told otherwise by the copyright owner.<sup>308</sup> Google preferred the opt-out structure primarily because it afforded Google tacit consent to exploit millions of “orphan works,” that is, works still under copyright whose owners cannot be located through reasonably diligent search.<sup>309</sup> Without the opt-out structure, Google would have been unable to acquire rights to include most orphan works in its services, but the structure would effectively transfer rights to Google without the copyright owner’s express consent or, in many cases, even knowledge. In rejecting the settlement agreement, the court emphasized the sanctity of the copyright owner’s “right to exclude others from using his property,” calling it “fundamental and beyond dispute.”<sup>310</sup> The copyright owner need not act to ensure he retains his rights; he is free to “sit back, do nothing and enjoy his property rights untrammelled by others exploiting his works without permission.”<sup>311</sup> The court worried that due to the agreement’s opt-out structure, “if copyright owners sit back and do nothing, they lose their rights. Absent class members who fail to opt out will be deemed to have released their rights even as to future infringing conduct.”<sup>312</sup>

¶88 While there are significant differences between the Google Books settlement agreement and institutional permission mandates, both start from the default position that the grantee automatically acquires nonexclusive rights in works by virtue of the fact those works are owned by individuals in a specified class, unless and until the grantee is informed otherwise by the copyright owner. And in both cases, the owner of a work subject to a nonexclusive license might not have been involved in drafting or negotiating the instrument or the policy, and indeed might not even be aware of the instrument or policy’s existence. A court interpreting a permission mandate could well take the position that the permission mandate, like the Google Books settlement agreement, causes users to “lose their rights” by doing something entirely within their rights—that is, by doing nothing.

¶89 In the Google Books settlement, however, there is no previously existing relationship—employment, contractual, or otherwise—between the copyright owner of

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<sup>308</sup> *Id.*

<sup>309</sup> Pamela Samuelson, *The Google Book Settlement as Copyright Reform*, 2011 WISC. L. REV. 479, 495.

<sup>310</sup> *Authors Guild*, 770 F. Supp. 2d at 681.

<sup>311</sup> *Id.* (quoting counsel for objector Amazon.com).

<sup>312</sup> *Id.* (citation omitted). The court also cited § 201(e) of the Copyright Act, which provides:

When an individual author’s ownership of a copyright, or of any of the exclusive rights under a copyright, has not previously been transferred voluntarily by that individual author, no action by any governmental body or other official or organization purporting to seize, expropriate, transfer, or exercise rights of ownership with respect to the copyright, or any of the exclusive rights under a copyright, shall be given effect under this title . . . .

17 U.S.C. § 201(e) (2011). The *Authors Guild* court noted there was some debate about whether this section was intended to apply to government seizure only or whether it includes actions of private parties such as Google, but found it unnecessary to decide the issue: the mere “notion that a court-approved settlement agreement can release the copyright interests of individual rights owners who have not voluntarily consented to transfer is a troubling one.” *Authors Guild*, 770 F. Supp. 2d at 681. While § 201(e) arguably raises concerns in the context of a class action settlement of the sort in *Authors Guild*, it is unlikely to raise similar concerns where a university policy purports to initiate the grant of a nonexclusive right from its faculty in the context of a voluntary employment relationship. In any event, § 201(e) appears only to prohibit certain attempts to acquire or transfer exclusive, not nonexclusive, rights.

an orphan work and Google. The relationship would have arisen solely from the fact that the copyright owner is a member of the class as determined by the court. Scholarly articles present a different case. The university has an employment relationship with the author, who is subject to university policies. Moreover, it is important to recognize that universities have an interest in the management and dissemination of scholarship that they support, even if universities might not be the legal authors.<sup>313</sup> As one commentator has argued, universities and scholars should not feel constrained by the work for hire rules' binary, all-or-nothing allocation of copyright interests.<sup>314</sup> Permission mandates are a tool by which universities and scholars can share rights, thereby recognizing the university's limited interest in the work while respecting the faculty member's authorship interests.

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Another difference between the Google Books settlement and permission mandates is the nature of the works and their proposed uses. Authors are able to exploit books commercially. Even the most obscure, out-of-print book has a potential market, at least theoretically. That is not the case with scholarly articles. No market exists for scholars to sell their articles individually: no libraries purchase them individually from their authors, no publishers pay authors for them, and authors do not earn royalties from them when they are ultimately sold to libraries as parts of journals.<sup>315</sup> Google and the permission mandate schools' proposed uses are also dissimilar. Google intends to commercially exploit the scanned books by selling online access to them and placing advertisements on their pages.<sup>316</sup> Permission mandates, on the other hand, are not an attempt to acquire authors' proprietary rights in scholarly articles—indeed, the licenses are limited to non-profit uses only. Rather, the mandates are occurring within the broader context of the university as a commons,<sup>317</sup> and can be understood as an effort to manage and disseminate the information contained in scholarly articles as a common resource vital to the scholarly community and the production of new knowledge.

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<sup>313</sup> See *supra* Part III.B.

<sup>314</sup> Crews, *supra* note 161, at 23–25.

<sup>315</sup> See *supra* text accompanying notes 126–127. Technology is indeed catalyzing some changes in the market for scholarly articles. For example, performing a general Google search for an article title or citation might produce a link to an online database such as LexisNexis or J-STOR, providing the option to purchase an individual electronic copy of the article, often in the range of ten to twenty dollars. This might enable a new form of supplemental revenue for journal publishers and online databases, but authors are not partaking in the revenue (and indeed, why would they, as they typically no longer own any rights in the work after transferring ownership to the publisher). Academic authors do not, at least for the time being, have realistic options for earning royalties from their scholarly articles. Although new self-publishing platforms are emerging from which academics can sell scholarly articles directly to consumers, such as Amazon's CreateSpace and Kindle Store and Apple's iTunes Bookstore, it is unlikely that the market for most scholarly articles would be large enough to alter the general proposition that scholars do not write their scholarly articles for commercial exploitation.

<sup>316</sup> *Authors Guild*, 770 F. Supp. 2d at 671.

<sup>317</sup> See Michael J. Madison et al., *The University as Constructed Cultural Commons*, 30 J.L. & POL'Y 365, 371 (2009). (“What constructed cultural commons share are member or participant contributions of information and knowledge resources to some distinguishable and bounded collectively managed enterprise, and the ability of those members to appropriate and build on those shared resources.”).

ii) *Copyright Theory and Authorial Autonomy*

¶91 Nevertheless, authorial autonomy would still appear to be a formidable obstacle to validating opt-out licensing structures in light of *Authors Guild* (the Google Books decision). It is therefore worth unpacking the notion of authorial autonomy in copyright.

¶92 The theoretical literature recognizes two senses in which authorial autonomy is important to the U.S. copyright system. The first is *economic autonomy*: copyright law helps ensure the author's autonomy from the state or other powerful influences by enabling authors to "look to the market, not government patronage, for financial sustenance."<sup>318</sup> This, in turn, enhances democratic discourse in society by promoting expressive diversity.<sup>319</sup> The second sense in which autonomy is important to copyright is *personal autonomy*: the property right afforded by copyright law protects the author's ability to broadly control the creative products of his mind. This derives from notions of individual freedom, self-determination, and human dignity—ultimately "'self-rule,' the ability to steer oneself according to one's own plan and design."<sup>320</sup> Autonomy in this sense, therefore, speaks to freedom of action vis à vis one's creative works—the right to determine how the works can be used and by whom.<sup>321</sup> There is, of course, also an economic dimension to personal autonomy. After all, the right to determine how one's creative works are used includes the ability to alienate them at a price acceptable to the creator.<sup>322</sup> In short, one might say that these two notions of autonomy in copyright boil down to the idea that copyright promotes freedom of thought and expression, on one hand, and freedom to act (or forbear from acting), on the other.<sup>323</sup>

¶93 *Economic autonomy*—The economic autonomy afforded by copyright is nonessential and indeed largely irrelevant to scholarship. Freedom of thought and expression is paramount to scholars and the academic community, to be sure. However, in no way do scholars rely on copyright law or the market to ensure that freedom. Indeed, the academy employs a robust patronage model of knowledge and cultural production: universities (and sometimes foundations and other granting institutions), and not the market, financially support scholars' creative output. Patronage, which was the primary form of livelihood for creative professionals before the institution of modern intellectual property systems, often trammels creativity because authors are beholden to the preferences and purposes of their patrons.<sup>324</sup> To ensure they are not ideologically beholden to universities, therefore, scholars must rely on long-standing norms within the academic community, in particular the norm of academic freedom.<sup>325</sup> Academic freedom, in turn, encompasses more than freedom from influence by the university or even the state; it also involves freedom from the market. While the market has generally

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<sup>318</sup> NEIL WEINSTOCK NETANEL, *COPYRIGHT'S PARADOX* 81 (2008). Netanel calls this copyright's "structural function" in underwriting free speech and democratic discourse. *Id.*

<sup>319</sup> *Id.* at 38, 89–94.

<sup>320</sup> MERGES, *supra* note 67, at 18. *See generally id.* at 68–101.

<sup>321</sup> *Id.* at 72, 83.

<sup>322</sup> *Id.* at 18, 81.

<sup>323</sup> *See Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 555 (1985) (implicitly recognizing both forms of autonomy, the Court noted that "[t]he author's control of first public distribution implicates not only his personal interest in creative control but his property interest in exploitation of prepublication rights, which are valuable in themselves").

<sup>324</sup> *See MERGES, supra* note 67, at 198.

<sup>325</sup> *See Packard, supra* note 197, at 287–93.

enhanced authorial autonomy as compared with the alternative modes of information production (private or public patronage),<sup>326</sup> it poses its own threats to autonomy and free thought.<sup>327</sup> Salaries and research funding afforded by universities insulate scholars from the market, ensuring equal compensation whether their articles are contentious, esoteric, or have mass appeal.<sup>328</sup> Commercial incentives therefore need not influence scholars, enabling them to freely write whatever they wish. The model of scholarship production, then, is nonmarket not only because journals do not pay scholars for articles; it is by design. In short, scholars rarely, if ever, need the economic autonomy afforded by copyright, and it might even be counterproductive for them to have that autonomy. Therefore, one should not object to the opt-out structure of permission mandates based on concerns that they encroach too deeply on faculty authors' economic autonomy.

¶94 *Personal autonomy*—Despite the economic orientation of U.S. copyright law, economic interests are not the only interests protected by copyright. Various protections for personhood or dignity interests are scattered throughout the Copyright Act and relevant judicial opinions.<sup>329</sup> In rejecting the Google Books settlement agreement, for example, Judge Chin seems as concerned about personal autonomy interests as economic autonomy interests, if not more so.<sup>330</sup> Personal autonomy interests are more relevant to scholarship than economic autonomy interests; the justifications for recognizing personhood interests in works of creative expression—promotion and recognition of authorial freedom, dignity, and the author's creative contributions<sup>331</sup>—all apply to scholarly articles while economic autonomy has little relevance to scholarly articles or their production.<sup>332</sup>

¶95 Nevertheless, the open access mandate's automatic grant of a nonexclusive license seems unlikely to unduly burden faculty members' personhood interests in their scholarly articles. First, the author's interest in factual works, including most scholarly articles, is comparatively attenuated to begin with, as “[t]he law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy.”<sup>333</sup> Second, the economic aspect of personhood interests—the idea that the author should be free to economically exploit her work at a price and according to terms acceptable to her<sup>334</sup>—is of little concern regarding scholarly articles. There is presently no market for authors to sell individual scholarly articles since journals do not pay for them and libraries will only purchase them as part of a journal subscription. This is in stark contrast to the books covered by the Google Books proposed settlement, which generally have a potential market and the opportunity to earn revenue for their authors. Third, the “right” with

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<sup>326</sup> See MERGES, *supra* note 67, at 198–203.

<sup>327</sup> See Suber, *supra* note 59, at 175 (“[B]ecause . . . insulation from the market makes two important freedoms possible—open access and academic freedom—we have good reason to resist any development that would remove this insulation and make scholars’ income—through salaries or royalties—dependent upon the popularity of their ideas.”).

<sup>328</sup> See *id.*

<sup>329</sup> See MERGES, *supra* note 67, at 156.

<sup>330</sup> See *Authors Guild v. Google Inc.*, 770 F. Supp. 2d 666, 681 (S.D.N.Y. 2011); see also *supra* Part IV.B.1.a.

<sup>331</sup> See MERGES, *supra* note 67, at 156–58.

<sup>332</sup> See Roberta Rosenthal Kwall, *Copyright Issues in Online Courses: Ownership, Authorship and Conflict*, 18 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1, 26–30 (2001).

<sup>333</sup> *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 563 (1985).

<sup>334</sup> See *supra* text accompanying notes 320–322.

which academic authors are most concerned—attribution<sup>335</sup>—is not directly enforceable through copyright law since the Copyright Act provides no express right of attribution for literary works,<sup>336</sup> nor does the law protect the ideas underlying an author’s specific expression.<sup>337</sup> If one academic author uses another’s ideas without attribution, the originator will enforce her attribution interest through academic community norms, such as the condemnation of plagiarism, rather than copyright law.<sup>338</sup> Lastly, the mandate has an effective built-in protection for the author’s personal autonomy interests—the faculty member has the power to exclude from the scope of the grant any work at any time for any reason.<sup>339</sup> Even a permission mandate without this opt-out provision, however, probably would not unduly burden the scholar’s autonomy interests for the other reasons previously discussed.

## 2. Reducing Open Access-Related Uniformity Costs Through Judicial Tailoring

¶96 This Article previously outlined the concept of uniformity costs in intellectual property and showed how applying economic-centric copyright rules to scholarly articles, which result from a nonmarket model of information production, can produce uniformity costs including uncertainty about the allocation of copyright ownership and the potential to undermine community norms of academic freedom.<sup>340</sup> It provided two examples of particular relevance to open access scholarship: the work made for hire rules as applied to scholarly articles,<sup>341</sup> and the writing requirement of § 205(e).<sup>342</sup> As uniformity cost is “the central problem that intellectual property law must manage,”<sup>343</sup> courts should seek to apply copyright rules in a context-sensitive manner that reduces uniformity costs. Taking a context-sensitive approach, a court is more apt to uphold common understandings and expectations within the academic community and advance copyright’s underlying principles of promoting progress and disseminating knowledge by finding that scholarship is created outside the scope of a faculty member’s employment (or, alternatively, that a well-tailored teacher exception exists for scholarly articles),<sup>344</sup> and by adopting a view of signed writings for purposes of § 205(e) that includes permission mandates.

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<sup>335</sup> See Catherine L. Fisk, *Credit Where It’s Due: The Law and Norms of Attribution*, 95 GEO. L.J. 49, 81 (2006) (“Unlike popular books, films, magazines, or most other copyrighted works, scientific publications (like much academic writing) are usually far less valuable as intellectual property than as claims to truth. . . . In most cases, the value of scientific authorship is widely recognized to be in the attribution, not in the intellectual property.”).

<sup>336</sup> See *supra* note 67 and accompanying text.

<sup>337</sup> 17 U.S.C. § 102(b) (2011) (“In no case does copyright protection for an original work of authorship extend to any idea, . . . concept, principle, or discovery . . . embodied in such work.”).

<sup>338</sup> See Shavell, *supra* note 64, at 337 n.79.

<sup>339</sup> See Molly Shaffer Van Houweling, *Author Autonomy and Atomism in Copyright Law*, 96 VA. L. REV. 549, 636 (2010) (describing the opt-out provision in the Harvard FAS mandate as a “nod to authorial autonomy”).

<sup>340</sup> *Supra* Part III.A.

<sup>341</sup> *Supra* Part III.B.

<sup>342</sup> *Supra* Part III.C.

<sup>343</sup> Carroll, *supra* note 24, at 849.

<sup>344</sup> This Article argues that the teacher exception, if it persists, should be limited to works for which academic freedom is required. See *supra* Part III.B.4.

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Context-sensitive rule making and application of rules is the acknowledged remedy for uniformity costs.<sup>345</sup> This “tailoring” of intellectual property laws to render them more context-sensitive and reduce uniformity costs can occur at both the legislative and judicial interpretation stages. Tailoring at the legislative stage involves enacting statutory amendments that either grant additional rights or limit the scope of protection of rights available for certain classes of works.<sup>346</sup> Judicial tailoring involves courts’ systematically different treatment of uniform rights and rules.<sup>347</sup> Professors Burk and Lemley argue that in the patent law context it is often preferable to do this kind of tailoring in courts rather than the legislature for several reasons. First, they express concerns about how statutory amendments aimed at particularizing rules for different industries might violate U.S. intellectual property treaty obligations. Second, it is difficult to prescribe optimal, detailed rules for particular contexts in a statute. Third, there are substantial administrative costs and uncertainties involved in writing industry-specific rules. Fourth, statutes drafted with current technologies and conditions in mind rapidly become obsolete. Lastly, each new amendment presents an opportunity for rent-seeking and special interest lobbying.<sup>348</sup> Likewise, in the copyright context, Professor Carroll argues that judicial tailoring is often preferred as well.<sup>349</sup>

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Judicial tailoring is an appropriate remedy for uniformity costs that arise from applying economic-centric copyright rules to scholarly articles.<sup>350</sup> Indeed, the teacher exception, to the limited extent courts have recognized it, is an attempt by judges to reduce uniformity costs by tailoring the law to exclude scholarship and lectures from work for hire rules that have no practical relevance to the production of scholarly articles.<sup>351</sup> The history of the work for hire doctrine suggests that in fashioning those rules Congress had business and industry in mind—that is, commercial information production: the script writer at the movie studio, the copy writer at the ad agency, the analyst drafting reports for the credit rating agency, and so on.<sup>352</sup> By and large, the

<sup>345</sup> Carroll, *supra* note 24, at 878–900; Burk & Lemley, *supra* note 64, at 1579.

<sup>346</sup> See Michael W. Carroll, *One Size Does Not Fit All: A Framework for Tailoring Intellectual Property Rights*, 70 OHIO ST. L.J. 1361, 1401 (2009).

<sup>347</sup> *Id.* at 1403.

<sup>348</sup> Burk & Lemley, *supra* note 64, at 1634–38.

<sup>349</sup> Carroll, *supra* note 346, at 1401 (“[C]onsiderations of political economy . . . suggest that judicial tailoring is likely to be the most efficiency-promoting form of tailoring patent and copyright law.”).

<sup>350</sup> Professor Raban persuasively argues that “courts would often *reduce* certainty and predictability if they act as textualists and faithfully follow the clear language of bright-line rules.” Ofer Raban, *The Fallacy of Legal Certainty: Why Vague Legal Standards May Be Better for Capitalism and Liberalism*, 19 B.U. PUB. INT. L.J. 175, 184 (2010).

<sup>351</sup> See *Williams v. Weisser*, 78 Cal. Rptr. 542, 546–47 (Cal. Ct. App. 1969) (“The many cases cited by defendant for the general rule [that the employer is the copyright owner under the work made for hire doctrine] probably reach desirable results that are in accord with common understanding in their respective areas, but a rule of law developed in one context should not be blindly applied in another where it violates the intention of the parties and creates undesirable consequences.”).

<sup>352</sup> See Catherine L. Fisk, *Authors at Work: The Origins of the Work-for-Hire Doctrine*, 15 YALE J.L. & HUMAN. 1, 7 (2003) (“[A] crucial part of the development of the work-for-hire doctrine [in the nineteenth and early twentieth centuries] was the expansion of the types of works eligible for copyright protection to include collaboratively produced commercial media. The expansion of copyright made copyright ownership an important asset to an ever-growing array of businesses and, therefore, simultaneously created incentives for firms to claim ownership of their employees’ products and made it easier for courts to accept these claims.”); Deborah Tussey, *Employers as Authors: Copyrights in Works Made for Hire*, in INTELLECTUAL PROPERTY AND INFORMATION WEALTH: ISSUES AND PRACTICES IN THE DIGITAL AGE, COPYRIGHT AND RELATED RIGHTS 71, 86 (Peter K. Yu ed., 2007) (“The employee default rule [which

“employees” Congress had in mind are individuals paid to create at the behest or direction of their employer works that directly or indirectly enhance the employer’s business function or profits.<sup>353</sup> Given scholarship’s nonmarket production model,<sup>354</sup> it is not the kind of work that Congress targeted with the work for hire rules.

¶99 Carroll, Burk, and Lemley, in their discussion of judicial tailoring of uniformity costs, advocate working within the intellectual property doctrines and statutory provisions that feature flexible standards that provide room for judicial discretion.<sup>355</sup> If a court is reluctant to find a teacher exception exists, the agency factors in *Reid* afford courts some discretion in application. Courts would reduce uniformity costs by using that discretion to find that scholarship falls outside the scope of employment for the reasons noted above.<sup>356</sup> It makes little sense for a court to find that scholarship is created within the scope of employment for copyright purposes when the justifications supporting the work for hire rules seem inapplicable to scholarship, universities do not control the content of the scholarship, most universities actively disclaim ownership of scholarship, and university ownership undermines principles of academic freedom.<sup>357</sup> A determination that scholarly articles are not within the scope of employment for work for hire purposes, however, exemplifies a context-sensitive approach that upholds the socially valuable institution of academic freedom, aligns outcomes with the expectations of the relevant community (scholars, universities, and publishers), and thereby increases certainty about the allocation of entitlements.

¶100 Likewise, when evaluating the legal effect of permission mandates, a court might adopt a more flexible view of signed writings for purposes of § 205(e). Section 205(e)’s writing requirement developed to protect purchasers of expensive exclusive rights in commercially valuable works against unknown prior nonexclusive licenses, a concern pertinent to the entertainment industry that has little relevance to nonmarket production of scholarly articles.<sup>358</sup> If permission mandate licenses are challenged based on their sufficiency as writings, courts should consider using their discretion to minimize uniformity costs, including uncertainty of entitlements and the resultant chilling effect on

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vested authorship in the employee] accommodated a world in which creators were likely to be individuals or small groups of collaborators. In the late nineteenth century, however, the prevailing mode of production for copyrighted works changed dramatically and the legal system responded. The corporate business form became dominant in the copyright industries, as elsewhere in the economy. Reckoning the odds against supporting oneself through an artistic career in industrialized economies, many would-be Michelangelos traded their artistic aspirations for secure employment with advertising agencies, graphic design firms, architecture firms, and similar enterprises. Would-be Jane Austens took day jobs with publishers of newspapers, books, and magazines or churned out scripts for the movie and television industries. While freelancers continued to play an important role in . . . copyright industries, a significant proportion of creative endeavor shifted from lofts, galleries, and coffeehouses to office buildings where it was directed and financed by corporations. During the same period, the scope of copyright protection expanded to encompass many new works and media. Courts adjusted their conceptions of creative authorship to include commercial subject matters like advertisements and other applied arts.”); Deborah Tussey, *What If Employees Owned Their Copyrights?*, 2008 MICH. ST. L. REV. 233, 236 [hereinafter Tussey, *What If Employees Owned Their Copyrights?*] (“The adoption of the [work made for hire] doctrine appears to be a reward for the investment and political influence of established industries . . .”).

<sup>353</sup> See Tussey, *What If Employees Owned Their Copyrights?*, *supra* note 352, at 236.

<sup>354</sup> See *supra* Part III.A.

<sup>355</sup> See Burk & Lemley, *supra* note 64, at 1670; Carroll, *supra* note 24, at 890–91.

<sup>356</sup> See *supra* Part III.B.4.

<sup>357</sup> See *id.*

<sup>358</sup> See *supra* Part III.C.

research dissemination as researchers and universities increasingly come to rely on licenses effectuated by permission mandates. Finding that permission mandates are satisfactory writings for purposes of § 205(e) is consistent with the objectives of § 205(e) of providing evidence of the license and notice to subsequent copyright transferees, and promotes the copyright goals of advancing and disseminating knowledge.

## V. CONCLUSION

¶101 Open access proponents argue that scholars are far more likely to make their articles freely available online if they are required to do so by their university or funding institution. Therefore, if the open access movement is to achieve anything close to its goal of seeing all scholarly articles freely available online, it seems that mandates of some sort will play a significant role. Since 2008, a number of American universities have adopted policies that purport not only to require scholars to deposit their works in open access repositories, but also to grant the university nonexclusive copyright licenses in all works of faculty scholarship. The principal aim of this Article has been to analyze the legal effect of “Harvard-style” open access permission mandates. This required first analyzing whether scholars are the legal authors (and therefore initial owners) of their scholarly articles under the Copyright Act’s work made for hire rules. It then required determining whether a permission mandate in fact vests, as its terms suggest, nonexclusive licenses in the university for all scholarly articles created by its faculty. Lastly, this analysis required determining whether those licenses survive after the faculty member who writes the article transfers copyright ownership to a publisher. As the foregoing analysis shows, in the Author’s opinion the answer to all three of these questions is “yes”: scholars should be deemed the authors of their works, and permission mandates create in universities effective, durable nonexclusive licenses to archive and distribute faculty scholarship and permit the university to license others to do the same.

¶102 The implications of this analysis extend beyond permission mandates and open access, however. The analysis highlights the poor fit between copyright rules developed with proprietary modes of information production in mind and the non-proprietary production of scholarly articles. It is misguided to assume that the circumstances of scholarship’s creation and its role as a social information resource are the same as those of all other works of original expression. Two observations follow from that statement. First, if the current copyright rules were forged under the assumption that information production is proprietary, then applying them to a class of works derived from a non-proprietary production model in a community that particularly values that model can lead to uncertainty, unmet expectations, and jeopardize important norms such as academic freedom. These are social costs that courts should minimize where possible. One example highlighted throughout this Article is the application of the work for hire rules to scholarly articles. The work for hire rules, which automatically vest in an employer authorship of any works created by an employee within the scope of employment, developed without regard to concerns about academic freedom or the peculiar circumstances in which scholarly articles are produced, which are decidedly different from those of commercial information production. The work for hire rules should therefore be applied with sensitivity to academic community norms as reflected in the expectations of scholars and their institutions, particularly where those norms are



compatible with the important copyright objectives of promoting the creation and dissemination of knowledge.

¶103 Second, the analysis highlights that not all copyright licensing opt-out regimes are created equal. The opt-out regime that Harvard-style permission mandates establish is not necessarily synonymous with the regime proposed in the Google Books settlement agreement, for example. The latter targeted a class of works that possess revenue-earning potential for their authors and thus fit comfortably within the traditional context of copyright rules and notions of authorial autonomy. Authorial autonomy in its two aspects—economic autonomy and personal autonomy—is foundational to copyright. However, where works derive from a nonmarket model of information production and are highly factual, intended to disseminate knowledge, and unmarketable as individual works, as is the case with most scholarly articles, the automatic grant does not unduly encroach upon authorial autonomy in either sense.

¶104 Lastly, it bears mentioning that the discussion of the durability of permission mandate licenses is relevant to nonexclusive licenses in other contexts, as well. This issue will only increase in importance, as the vast majority of online content is made available under express or implied nonexclusive licenses. Does, for example, a nonexclusive Creative Commons license in the form of code embedded in a website or document constitute a signed writing for purposes of § 205(e), so that a user who relies on the license to distribute or adapt the content is not an unwitting infringer if the author of the preexisting work has transferred her copyright? Given § 205(e)'s underlying concern that the writing provide evidence and notice of the nonexclusive license's existence, it might make sense to find the license satisfies the writing requirement if the license is conspicuous or easily identified, even if the license does not take the form of a traditional signed written instrument. More generally, however, it seems prudent now to evaluate the need to recalibrate current rules governing nonexclusive licenses, including § 205(e), for today's highly networked digital information environment.

## APPENDIX

**Harvard Faculty of Arts and Sciences Open Access Policy<sup>359</sup>**  
Voted February 12, 2008

The Faculty of Arts and Sciences of Harvard University is committed to disseminating the fruits of its research and scholarship as widely as possible. In keeping with that commitment, the Faculty adopts the following policy: Each Faculty member grants to the President and Fellows of Harvard College permission to make available his or her scholarly articles and to exercise the copyright in those articles. In legal terms, the permission granted by each Faculty member is a nonexclusive, irrevocable, paid-up, worldwide license to exercise any and all rights under copyright relating to each of his or her scholarly articles, in any medium, and to authorize others to do the same, provided that the articles are not sold for a profit. The policy will apply to all scholarly articles written while the person is a member of the Faculty except for any articles completed before the adoption of this policy and any articles for which the Faculty member entered into an incompatible licensing or assignment agreement before the adoption of this policy. The Dean or the Dean's designate will waive application of the policy for a particular article upon written request by a Faculty member explaining the need.

To assist the University in distributing the articles, each Faculty member will provide an electronic copy of the final version of the article at no charge to the appropriate representative of the Provost's Office in an appropriate format (such as PDF) specified by the Provost's Office.

The Provost's Office may make the article available to the public in an open-access repository. The Office of the Dean will be responsible for interpreting this policy, resolving disputes concerning its interpretation and application, and recommending changes to the Faculty from time to time. The policy will be reviewed after three years and a report presented to the Faculty.

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<sup>359</sup> See *Harvard FAS Mandate*, *supra* note 11.