Outlines from "Intellectual Property on Campus: Computers, Copyright, and Cyberspace"

Monograph 99-2

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University of Houston Law Center/ Institute of Higher Education Law and Governance (IHELG)

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The UHLC/IHELG works in a series of concentric circles. At the core of the enterprise is the analytic study of postsecondary institutions -- with special emphasis on the legal issues that affect colleges and universities. The next ring of the circle is made up of affiliated scholars whose research is in law and higher education as a field of study. Many scholars from all over the world have either spent time in residence, or have participated in Institute activities. Finally, many others from governmental agencies and legislative staff concerned with higher education participate in the activities of the Center. All IHELG monographs are available to a wide audience, at low cost.

Programs and Resources

IHELG has as its purpose the stimulation of an international consciousness among higher education institutions concerning issues of higher education law and the provision of documentation and analysis relating to higher education development. The following activities form the core of the Institute's activities:

- Higher Education Law Library
- Houston Roundtable on Higher Education Law
- Houston Roundtable on Higher Education Finance
- Publication series
- Study opportunities
- Conferences
- Bibliographical and document service
- Networking and commentary
- Research projects funded internally or externally
ISSUES OF ATTRIBUTION

This paper is about the attribution of authorship in academia, with a special emphasis on so-called "Big Science" and multiauthorship. I have picked the case of multiauthorship in science because of its ability to foreground with great clarity the problems of attribution shared by all forms of academic authorship.

I argue that attribution is a particularly difficult problem in academic authorship because of the ways in which that kind of authorship is defined. In fact, academic and scientific authorship operate largely outside of the norms of intellectual property law. It is not about property rights but about truth and scholarship -- categories that can be evaluated but cannot quantified (precisely because they are cast as independent from the potentially tainting logic of commercial interests). This places an additional burden on the process of attribution because attribution is not separable from evaluation. Saying that John Doe owns a house, and that such a house is worth $200,000 is very
different from saying that John Doe is the author of an article published in the last issue of Nature. Because it's very hard (perhaps impossible) to attach a firm value to that article, the act of attribution is already part of the process of evaluation (though what "part of the process" might mean is a million-dollar question in and of itself).

Furthermore, unlike IPR, authorship credit in science is not transferable but is directly and permanently attached to the scientist's name. And what is also attached to (and cannot be detached from) that name is responsibility. A scientist gets credit, but has to take epistemological (and perhaps legal) responsibility for the truth of the claims s/he publishes. These issues have become particularly urgent after the emergence of a few but well-advertised cases of scientific fraud and misconduct. Finally, the development of large-scale collaborations has resulted in the publication of articles with hundreds of authors -- a development that has multiplied the complexity of issues of attribution of credit and responsibility.

This essay begins with a discussion of the peculiar economy of the scientist's name by analyzing the relationship between scientific authorship and intellectual property law. I then look at two very recent redefinitions of multiauthorship (one from biomedicine, the other from particle physics). These two proposals indicate that scientific authorship may be becoming something that has little to do with authorship as we knew it. They also suggest that the notion of epistemological responsibility may be in the process of being re-conceptualized
as a subject of risk accounting. Truth may not have a price, but it may end up coming with an insurance premium.

- The peculiar economy of scientific names

In liberal economy, the objects of intellectual property are artifacts, not nature. One becomes an author by creating something new, something that is not to be found in the public domain. Copyright is about "original expression," not content or truth. If you paint a landscape, you may claim intellectual property (a form of private property) on the painting (the expression), but not on the landscape itself (the content). Scientists, therefore, cannot copyright the content of their claims as nature is a "fact" and facts (like the landscape represented in a painting) cannot be copyrighted because they belong to the public domain. Also, saying that scientists are authors because their papers reflect personal creativity and original expression (the kind of claim one has to make to obtain copyright) would actually disqualify them as scientists because it would place their work in the domain of artifacts and fictions, not truth. Therefore while researchers (or journals) can copyright scientific publications (i.e., the "form" they have used to express their findings) and gain some protection against piracy, their rights in these texts do not and cannot translate into scientific credit. In sum, copyright can make scientists authors, but not scientific authors.
Like copyright, patents too reward novelty as they cover "novel and non-obvious" claims. But, unlike copyrights, such claims need to be useful to be patentable. Scientists, then, can become "authors" as patent-holders, but cannot patent theories or discoveries per se (either because they are "useless" or because they are about something that belongs to the public domain).  

While it is increasingly common for scientists (mostly geneticists) to patent what would appear to be natural objects, they make these objects patentable by extracting them from their original state of nature and by packaging them within processes (usually diagnostic tests) that are deemed useful.  

Scientists can patent useful processes stemming from their research, but academic scientific authorship is defined in terms of the truth of scientific claims, not of their possible usefulness in the market. In sum, according to the categories and tools of intellectual property, a scientist qua academic scientist is, literally, a non-author.

Moreover, intellectual property is deemed to result from taking as little as possible from the public domain and transforming it into some kind of "original expression." But a scientist is not represented as someone who transforms reality or produces "original expressions" out of thin air, but as a researcher who, with much work, "detects" something specific within nature -- the domain of public and "brute" facts. Then, for that finding to be recognized as true, s/he has to put it back in the public domain (here construed as the "public sphere" which includes, but is not limited to, the community of
scientific colleagues). Although this is a loop that begins and ends in some version of the public domain, fundamental changes take place along the way. The starting point is generic nature, but the result is a specific item of true knowledge about nature. While the production of value in liberal economy involves a movement between two complementary categories (from generic public domain to specific private property), in science the movement is within the same category (the public domain) and it goes from unspecified to specified truth.

Both cases involve a tranformation from something unspecific to something specific. But if in the case of intellectual property such transition can be legally tracked (as it moves across two different categories), the case of scientific credit is much trickier because the movement from nature and the public domain to a specific true claim about nature does not cross any recognizable legal threshold. As a result, it cannot be legally tracked or quantified monetarily. The unique role of the author’s name in science stems precisely from these difficulties. The name becomes the only device left to mark the production of a scientific claim out of nature. It also becomes the only possible tool for marking scientific credit.

The pinning of the epistemological responsibility for a claim on the author’s name follows from a similar logic. If a true claim about nature were like an artifact, a novel expression, or a piece of literary fiction, responsibility could be negotiated legally. In market environments, an author’s responsibility is usually construed as financial liability.
Also, the legally responsible author may not be the actual producer of those claims, but the individual or corporation that paid the producer for his/her labor or rights in those claims. But this cannot apply to true claims about nature because they are in the public domain -- a category complementary to that of property and, therefore, to monetary liability. As a result, the responsibility for scientific claims is made to fall on the scientist who produced them simply because his/her name is the only "hook" on which the movement from unspecified to specified truth can be pinned.

While intellectual property works through three related but distinct devices (the object of intellectual property rights, the name of the holder of such rights, and their monetary value), science has only the name to work with. The author's name marks the object, designate the person who has produced (and is responsible for) that object, and embodies the credit for its production. This last statement may sound paradoxical, and it probably is. What I am trying to convey through the awkward notion of "embodiment" is that the name of the scientist becomes something else than the point around which scientific credit accrues. Such a picture assumes there is one thing called "credit" and another one called "owner of that credit". But because in science there is neither an owner, nor a property, nor a unit of measurement for such a property, everything (whatever that "everything" is) gets folded into the name (and onto the body attached to that name).
In science, in fact, credit it is attached exclusively to the author's name and is construed as a "symbolic", non-monetary, and assigned through peer-recognition (reputation, prizes, tenure, membership in societies, etc.). Some have argued that science works like a peculiar "gift economy". Furthermore, scientific credit is, in some way, "instantaneous". While it can accrue on a scientist's name during his/her career, each "unit" of credit results from the scientist's ability to produce new claims, that is, to be recognized as the first to have made that specific claim. There is no Coca Cola and Pepsi Cola in science. The first "Cola" takes all. Credit in science does not come from market shares, but from first discovery.

The use of eponymy in science reflects such a name economy. Discoveries, laws, and theories are sometimes attached to a scientists' names (Boyle's law, Golgi's apparatus, Fermat's theorem, Feynman's diagrams, etc.) to indicate neither actual property (as in "this house belongs to Robert Boyle"), nor to certify the "authenticity" of a product (like trademarks attached to sneakers or designer clothing). Rather, eponymy works as a form of symbolic capital, because monetary capital or material property cannot translate into scientific authorship. Furthermore, the fact that eponymy usually comes into play only after the scientist's death strengthens its role as a "monument" rather an acknowledgment of property.

Therefore, the most important kind of credit for a living scientist is not that of eponymy, but that attached to his/her name through publications. The problem is that no one can
quantify such a credit because it is defined as something that can be "judged" (by other peers) but cannot be quantified. The unquantifiability of scientific credit helps to cast it as "pure" and "disinterested" (and thus reinforces the perception of science as dealing with "truth") but creates extraordinary problems in the day-by-day management and reward of the scientists' work. Everyone agrees that not all articles have the same value (and actually only a minority of all published scientific articles is ever cited), but there is also a widespread awareness that, in practice, the number of one's publications is a reliable index of one's chances to succeed in science's extremely competitive marketplace. This is because while the qualitative evaluation of one's work is a most time-consuming process (as opposed to the speed with which the IRS can calculate one's income), time is the most rare of commodities in science. Furthermore the evaluation of "quality" is an inherently contestable process. The routine complaints about the fact that promotions should be judged on the quality rather than quantity of publications indicates that scientific credit, precisely because of its definition as something that is unquantifiable, often ends up being quantified, by default, in the most crude manner: by adding up the articles bearing the author's name.

- Too many names, too few names
Until the development of multiauthorship, science administrators and editors tried to control the tensions of scientific authorship by treating it as something similar to its literary cousin (or, more specifically, to the literary author before the development of intellectual property law). After all, a scientist was a person who had the idea, did the work, wrote the paper, and took credit and responsibility for it. Despite all the differences between credit and responsibility in science and literature, the individuality of the scientific author seemed to provide an envelope to contain its hard-to-define functions without calling to much attention to them.

Multiauthorship has unhinged this unstable but plausible-looking conceptualization, and has produced opposite reactions among science administrators and practicing scientists. Science administrators (usually more concerned with responsibility than with credit) have tried to hold on to traditional notions of individual authorship and to treat multiauthorship as an aggregate of individual authors, not a different, more corporate kind of authorship. For instance, the ICMJE (International Committee of Medical Journal Editors), an influential body representing hundreds of anglophone biomedical journals, has required that each name listed in an article’s byline (no matter how long that byline might be) must refer to a person who is fully responsible for the entire article (not just for the task he/she may have performed).

This position is largely a response to the finger-pointing that tends to develop among co-authors accused of having
published fraudulent claims. In some of these cases, senior authors listed in the byline have argued that they were either unaware that their name had been added to the author list (a sort of "inverse plagiarism" aimed at increasing the publication chances of the article), or that, although they did participate in the research, they had nothing to do with the fraudulent aspects of the publication.

Additionally, the ICMJE has been concerned with the potential inflation of authorship credit due to multiauthorship. How can one be sure that all these names refer to people whose diverse skills were actually necessary for such large project? These worries are understandable, though it is unlikely that numerical restrictions on the scale of multiauthorship could put them to rest. Scientific credit can be secured only by having one’s name included in the authors’ byline, and therefore it is reasonable to assume that everyone would try to get a piece of the pie -- the only pie around. Furthermore, scientific authorship makes for a very unusual pie. Because credit does not work like quantifiable monetary credit, scientific authorship is not a zero sum game. It is, therefore, a pie with a potentially infinite number of slices. Like in a hologram, each name, each slice, can carry full authorship credit.

But because the connection between the qualitative and quantitative dimensions of scientific credit opens a Pandora’s box that no one knows quite how to handle, the ICMJE’s pragmatic response to the conceptual challenges posed by multiauthorship has been to reaffirm a narrow notion of authorship in an attempt
to cut down its scale. If the scale of multiauthorship can be cut down, then one might be able to cling on to the belief that, in the end, nothing has really changed.

According to the ICMJE, what qualifies a person for authorship author are his/her intellectual contributions, not other forms of labor that are deemed non-intellectual:

Authorship credit should be based only on substantial contributions to (1) conception and design, or analysis and interpretation of data; (2) drafting the article or revising it critically for important intellectual content; and on (3) final approval of the version to be published. Conditions 1, 2, and 3 must be all met.

Participation solely in the acquisition of funding or the collection of data does not justify authorship. General supervision of the research group is also not sufficient for authorship [...].

Like the so-called "romantic author", the scientific author is separated from and placed above those "workers" who contributed to the production of that text but did not contribute to its "uniqueness", to the specificity of its claims and its epistemological status.

The "workers", of course, have objected to this definition. Many scientists feel that they cannot be responsible for those aspects of a project that fall outside of their work and expertise, and have argued that a narrow definition of authorship is unfair to many scientific workers who, while not engaged in the conceptualization and writing of a certain publication, still made such work possible. If these contributors do not receive authorship credit, they would receive almost no credit at all. Being "thanked" in the acknowledgment section is not something
one can put on his/her vitae. In sum, the "workers" tend to think of authorship in corporate terms, that is, as stocks in a company that carry credit and responsibility in proportion to their share of the total value of the enterprise.

Unfortunately, both the positions of the ICMJE and of the "workers" (however reasonable they may be) do clash against different elements of the logic of scientific authorship. The prescriptions of ICMJE fail to take into account the extent of the empirical division of labor, skill, and credit that makes big science possible, while the positions of its critics threatens a fundamental axiom of scientific authorship: individual responsibility.

This has led to a conceptual and administrative deadlock: authorship must change but cannot change. But while the heated discussions continue, two radical alternative (coming from two very different areas of science) have been put forward and, in one case, implemented.

- From authorship to contributorship

In a recent article published in JAMA, one of the most prestigious medical journals, one of its deputy editors, Drummond Rennie, has proposed to drop the notion of authorship altogether and to replace it with two related categories: contributorship and guarantorship. Some aspects of Rennie's proposal have been temptatively adopted by leading medical journals like JAMA,
Lancet, and British Medical Journal. Nature is also experimenting with it.

According to this proposal, each and every person who worked at a project that led to a publication should be listed as a "contributor" and should have his/her name included in the byline. The function of the order of names in the byline is radically modified. A name does not receive its "value" from its position, but from the description of that person's contribution that is appended to the byline. These blurbs are reminiscent of film credits, but do not need to make use of standardized job titles. The contributors are asked to write down what they did, without packaging their work into pre-existing categories. The team is then asked to ratify these self-descriptions, and is also given the opportunity to attach numerical values to each contribution -- numbers that would not represent absolute measurements of those contributions' value, but only the group's local assessment of them.

This proposal's goal is explicitly pragmatic: to add transparency to an unusually opaque process, and to reduce its arbitrariness for both authors, editors, and users. The additional information provided would give the reader a better understanding of who did what, while tenure committees and institutional evaluators would have their work simplified (though not necessarily reduced) by these descriptions and their internal ranking. This information would also provide the authors themelves with some safeguard against arbitrary distribution of credit, and could play a crucial role in assessing
responsibilities in the case of fraud allegations. Furthermore, the order of the byline would cease to be tied to local disciplinary customs -- a practice that is made increasingly problematic by the confluence of many different subdisciplines and subcultures into large-scale projects.

This proposal introduces important conceptual innovations too. For instance, the traditional distinction between the names of authors and those of people thanked in the acknowledgment section would come to an end (and with it the distinction between the author as the "creator" of the distinctive traits of the work and the "helpers" who provided only the background conditions for the creator's work). Then, empirical descriptions of one's contribution would replace authorship-policing. The traditional opaqueness of the figure of the author (the unverbalizable "je ne sais quoi" of the romantic author) would be unceremoniously replaced by a mundane paper trail. The name of the contributor would continue to work as an entity that circumscribes and constitutes a text as a "work", while becoming simultaneously circumscribed by a description of its own agency. Or, to put it differently, the contributors' names would be not only names of "certifying" authors, but names of workers whose authorship claims should be assessed by the readers, that is, by the "market". The description of an author's contribution would function as his/her "specifications", thus casting the author as a product, not only as a producer.

But while Rennie's proposal reconceptualizes authorship credit and distances it from the figure of the romantic author,
it does not do the same with scientific responsibility. Contributors, in fact, are paired with "guarantors", people whose function is very much like that of the traditional and all-responsible scientific author envisaged by the ICMJE.

[I WILL EXPAND ON THIS IMPORTANT POINT DURING MY PRESENTATION]

- Making names local (and irrelevant)

A more radical change in the notion of scientific authorship has emerged at about the same time, but in a very different discipline and with little engagement with the debates that have occupied biomedical practitioners and editors. Its introduction has been accompanied by no fracas whatsoever. The proposal has not even been printed out, but only distributed electronically and posted on a laboratory’s web page.

A few years ago, high energy particle physicists working at Fermilab appointed a committee to develop bylaws for regulating their multi-institution (and multi-million-dollar) collaboration. It was felt that the collaboration had reached a remarkable size (more than a thousand physicists) and level of complexity, but was still operating as a large tribe guided by a few "wise men" who were now approaching retirement age without having consigned their wisdom to paper. As part of these bylaws, the committee articulated the definition of authorship and the modalities of its management. This proposal was approved in 1998 and is now in the process of being extended to CERN, Europe’s largest physics laboratory.
The CDF (Collider Detector at Fermilab) Collaboration has stipulated that all publications emerging from the lab should automatically include all names included in the so-called "Default Author List". This list includes hundreds of names. All of them are to be included in the byline in alphabetical order, no matter what their specific contribution to that paper might have been. The "Default Author List" is updated bi-annually (in January and July) by a committee which reviews the authors' fulfillment of membership requirements in the Collaboration.

There is a substantial overlap between authorship and membership. The Collaboration is a consortium of institutions and universities that support and staff the laboratory. Members are engineers, students, and physicists who are said to be "blessed" by their home institution for work at Fermilab. Each member is committed to dedicating at least 50% of his/her research time to CDF experiments over a three-year period. The names of all members with 1 FTE-year service work at Fermilab are automatically added to the "Default Author List". In this sense, the author is seen as someone who has "worked enough", not as a uniquely individualized "creator". S/he is seen as a worker who has received "stock options" in CDF -- though stocks that cannot be sold or translated into cash value.

The "labor mentality" that reigns at CDF (as opposed to the "originality mentality" that frames IPR as well as the ICMJE authorship guidelines for biomedicine) is inscribed in its leave policies. An author, in fact is allowed up to a year of leave of
absence without losing his/her author status. For a limited amount of time, one can remain an author without being physically present (provided he/she has accumulated sufficient work-credit in the past). These policies indicate that physicists do not think of responsibility in the same terms biomedical practitioners do. The very idea of an absentee author is inconceivable to both Rennie and the ICMJE.

This does not mean that physicists have a lax attitude about responsibility, but simply that both authorship credit and responsibility are drastically reframed in this context. This has much to do with the internal structure and physical distribution of the community, as well as with the nature of the work and its temporal framework. In many ways, the CDF Collaboration is a community that congregates at a specific site, around a specific facility: the accelerator. Unlike biomedical practitioners who may be scattered over thousands of miles and institutions, the members of CDF work in the same "factory" for much of their research time. As a result, they eventually get to know each other. At Fermilab the same experiment can go on for years.

Also, while biomedical research teams who compete against each other across the country, the CDF Collaboration has come into place because of the physicists’ need to share, develop, and maintain, an extremely expensive facility. While biomedical researchers go find patients wherever they happen to be, physicists have only a handful of places where they can find particles, and Fermilab is one of the best ones. And "singular
events", the phenomena to whose discovery scientific credit is attached, can happen almost under anyone's watch. In sum, although particle physics and biomedicine are both "science", the name of their authors document vastly different ecologies (of labor, of collaboration, of space, of credit, of resources, of epistemology).

The bureaucratization of the author's name at CDF indicates that authorship credit and responsibility is not crucial in that setting, and it is not crucial because those functions have been taken up by other relations. Authorship becomes little more than a form of "registration". It is more of a "fact of life" than a struggle for professional life. Credit, for instance, is not "performed" through one's publication list (because everyone has pretty much the same list). One's credit travels through letters of recommendation and through the kind of personal relationships developed by working at CDF for several years, often shoulder-to-shoulder with one's colleagues. The authors' byline is a tribal inscription, not the primary source for individual vitae. Given the size of the collaboration, one's "colleagues" are likely to be the very members of CDF, not other scientists at other institutions. Credit comes from here, not from elsewhere.

Similarly, responsibility is not seen as a dominant concern because the "critics that count" are inside, not outside CDF. When a sub-group of CDF wishes to publish an article or to present a conference paper, the text goes through three rounds of internal review. The first is a preliminary approval from the publication committee, the last two take place on CDF's homepage
and involve all the collaboration members who send their comments electronically. After the texts has undergone the required revisions, those whose name is in the "Default Author List" can decide (within three days from the submission date) whether they want to keep or withdraw their name from that publication.

Interestingly, an article carrying fewer names would appear to be less (not more) credible than one with more names -- a scenario that is exactly opposite to what happens in biomedicine. Most competent reviewers are inside the Collaboration, so more names mean more peer-endorsements (especially because the peers who would have most to lose if the article turned out poor or, worse, fraudulent). The function of peer-review -- a function that in biomedicine is constitutive of authorship but is farmed out to colleagues external to the project -- is performed internally.

Sanctions for misconduct are also local. But because of the size of the community, local sanctions are effectively global. I believe that it precisely because of the community's ability to enforce these sanctions (and to do so swiftly) that responsibility talk is minimal at CDF. If you can enforce responsibility, you don't need to legislate (or simply obsess) endlessly about it. In fact, CDF members can be involuntarily removed from the author list if they do not live up to their labor commitments or if they are found responsible of professional misconduct. Misconduct is assessed by specific committees operating according to the rules specified in the CDF bylaws. The process is conducted internally, without input from
other agencies and institutions. Expulsion amounts to a form of "exile" from the community. And because there isn't much community outside that community, expulsion can have grave professional consequences.

- Conclusions (to be developed)

- The attribution of authorship is always problematic, no matter what field one looks at.

- The case of science is worse because:
  - The tacitness and elusiveness of "credit".
  - Problems with definitions of responsibility.
  - Local factors such as the teams' size, spatial arrangement, levels of trust and interdependence, as well as different sociabilities of different teams in different disciplines.

- Possible future developments.
Fair Use and Distance Education

Intellectual Property Issues on Campus:
Computers, Copyright & Cyberspace

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Exclusive Rights of Copyright Owners

- Reproduction
- Distribution
- Derivative Works
- Public Performance
- Public Display
- Moral Rights
- Digital Audio Transmissions of Sound Recordings

Exceptions or "Limitations"

- §107 Fair Use
- §108 Library Copying
- §109 First Sale
- §110 Classroom Teaching & Distance Learning

Distance Learning:
The Eligibility Requirements

- Regular Part of Systematic Instruction
- Directly Related to Teaching Content
- Primarily for Reception in Classrooms or Similar Places; or for Reception by Persons with "Disabilities or Other Special Circumstances"
Distance Learning: The Content Limits

- "Displays" of Any Work
- "Performances" of
  Nondramatic Literary Works
  Nondramatic Musical Works
- "Literary" excludes "Audiovisual Works"

Problems with Existing §110(2)
The Statutory Language

- Limits Teaching to "Nondramatic" Works
- Precludes Audiovisual Works
- Performances & Displays Only
  - No reproduction
  - No distribution
- Limited Places of Access

Problems with Existing §110(2)
Practical Implementation

- Requirements of Digital Transmissions
  - Necessary Reproduction
  - Possibility of Unauthorized Access
- Limited Enforcement of Instructional Contents
  - No Institutional Enforcement Mechanism
  - Protection of Academic Freedom
- Failure of License Options
  - Educators have Limited Resources to Seek Licenses
  - Owners are Often Unresponsive
Chronology of §110(2)

- 1909 Act: Performance Right for "Non-dramatic Works" applied to "For-Profit" uses
- 1961: Copyright Office recommends no change
- 1965: Bill introduced in House has major concepts
- 1976: Congress enacts §110(2) in Copyright Act
- 1993: Congress adds "Digital Audio Transmission" rights for Sound Recordings
- 1998: Congress directs the Copyright Office to conduct study
- 1999: Copyright Office recommends revision of §110(2) and 112(b)
- 1999: Still no revision bill introduced in Congress

Distance Learning:
Report from the U.S. Copyright Office
May 1999

Highlights of the Recommended Changes:
> D & P allowed in "Mediated Instruction"
> Expanded scope of materials
> "Limited Portions" of some works
> Allow transmissions beyond classrooms
> Retention of materials during academic term
> Continue to apply fair use
> Inform community about copyright
> Limit access to enrolled students

Policy Foundations of the Copyright Office Report
A Policy to Continue Existing Policy

"Where a statutory provision that was intended to implement a particular policy is written in such a way that it becomes obsolete due to changes in technology, the provision may require updating if that policy is to continue... In the view of the Copyright Office, section 110(2) represents an example of this phenomenon."
Policy Foundations of the Copyright Office Report

Accommodating Social Good

"Many students drawn to distance education are professionals whose jobs prevent them from attending classes on a campus."

"Senior citizens may choose to take courses online due to restricted mobility or a desire to study privately."

"[P]rimary goals [of education and library groups] are to avoid discrimination against remote site students...."

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Policy Foundations of the Copyright Office Report

Balancing Expanded Ownership Rights

"It is therefore critical, if section 110(2) is expanded to cover digital transmissions, that safeguards be incorporated into the statute to minimize these risks."

"When section 110(2) was enacted in 1976, there was no public performance right for sound recordings... The failure to include sound recording in the scope of current section 110(2) does result in a discrepancy between a distance educator’s ability to perform nondramatic musical works and her ability to perform the sound recording in which it is embodied."

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Policy Foundations of the Copyright Office Report

Balancing Expanded Ownership Rights

"Technological protection measures [under the DMCA], as they continue to develop and enter into widespread use, are likely to make copyright owners more comfortable with licensing digital uses."

"These provisions [of the DMCA] should assist in lessening some of the risks involved in digital distance education."
Policy Foundations of the Copyright Office Report

Technology as Viable Alternative for Protection

"Many technology companies and content-provider groups are working to develop technologies for protecting works in the digital environment that will be viable in the marketplace."

Policy Foundations of the Copyright Office Report

Failure of Fair Use as Alternative

"It also became apparent during the course of the hearings and comment process that a number of misunderstandings cloud the public's conception of fair use."

"Similar confusion occurred with regard to the meaning and effect of fair use guidelines."

"Ultimately, the entire process [of developing fair use guidelines] became controversial, ... [in part] because of conflicting views of the value and function of fair use guidelines generally. . . ."
Policy Foundations of the Copyright Office Report
*Accommodating Practical Realities*

"Eliminating the physical classroom limitation would better reflect today’s realities."

"The amendment would add those students who are able to attend class, but prefer to learn at a time and place of their own choosing."

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Policy Foundations of the Copyright Office Report
*Accommodating Technological Inevitabilities*

"[D]igital transmission by definition involves multiple acts of reproduction, and often distribution, which are not covered by section 110(2). Therefore, even if the performance and display were exempted, these digital transmissions would result in an infringement unless the accompanying acts of reproduction and distribution were otherwise authorized."

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National Association of Educational Broadcasting, 1965
*Accommodating Social Good*

"The place-of-reception criterion in the bill... fails to recognize the true purpose of the educational broadcaster. Such criterion... will result in shortsighted and unsupportable discrimination among people who have the greatest need for educational services through broadcasting."
Deputy Register of Copyrights, 1965
Balancing Rights and Exemptions

Performance of a nondramatic work under the 1909 Act "by an educational or other nonprofit radio or television station . . . is not an infringement of copyright . . . ."
The making of ephemeral copies "is a right that is not granted in the present law and is thus an additional limitation on the author's exclusivity."

American Book Publishers Council, 1965
Accommodating Technological Inevitabilities

Argument for allowing use of dramatic works as well as nondramatic works: "But nonprofit television is now becoming a major educational instrument reaching simultaneous audiences of hundreds of thousands. It is certain to grow."

American Textbook Publishers Institute, 1965
Accommodating Technological Inevitabilities

"The proposed bill not only continues these [current] rights but appears to go much further. It appears to provide free use by educational institutions of copyrighted materials not only in the commonsense, traditional manner but by the use of machines."
Policy Dynamics and the DE Statute

Policy: Not to Change the Law or Policy
Policy: Maintain Balance Between Social Good & Market Protection
Policy: Create Exemptions only if Alternatives are Inadequate
Policy: Rights & Exemption Justify One Another
Policy: Accommodate Technological Inevitabilities
Policy: Resolve Complexities & Not Interfere with Growth

Conclusions

- Statutory Developments are Tested Against an Idealized Balance
  - Encouraging Education
  - Promoting Commercial Markets
- Accepting Inevitabilities
  - Allowing New Technologies
  - Allowing Expansion of Activities
- Relying on Alternative Solutions
  - Fair Use as "Fill-in"
  - Licensing, but only if practical
- Importance of Objective Information
  - Role of Testimony
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Fair Use and Distance Education

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Institutional Interests in Copyright Policies on Campus

Do We Have To?

Georgia Harper

Office of General Counsel
University of Texas System

Overview

Introduction

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Summary

Introduction
The recent confluence of two circumstances seems ironically timed: There has been a
tremendous rise in the use of Internet technology to distribute distance learning
materials thus increasing University exposure to liability for copyright infringement at
the same time that Supreme Court cases suggest that State Universities might be
immune from suit for copyright infringement. Do we really need to worry about
copyright policy if this is true? Is it much ado about nothing?

What would be a University's interests in having a copyright policy if the University were
immune from suit under federal law?

A Copyright Policy Should be a "Many Splendored Thing"

The idea that there's no need for a copyright policy if the University is immune from suit
probably is based at least in part on an assumption that a copyright policy need only address
the use of others' works, that is, fair use and maybe getting permission. If Universities are
immune from suit, why worry about fair use? As discussed in more detail below, immunity
doesn't necessarily relieve a University of all concerns about copyright infringement, but further,
fair use is just the tip of the copyright iceberg.

Today we need copyright policies that go beyond mere recitation of the fair use statute or even
reference to specific guidelines. If there are good reasons to care about copyright even if we
are immune (as I will discuss below), fair use requires more explanation. More importantly, fair
use is just the starting point. Even if we all understand fair use perfectly, we still would need to
know about other important exemptions and what to do if a proposed use were not fair. The
answer should not be "Don't use the work," but rather, "Get permission." But, that answer can
lead to other questions: "How do I get permission?" and "Why can't the University license all
these permissions at once?" and "Why doesn't the library have this in electronic form so I do
not need permission?"

Even these questions only cover one aspect of our copyright concerns - the use of others'
work. What about all the copyright works we create and own?

To be comprehensive, a copyright policy should address the use of
others' copyrights and the creation, ownership and management of
institutional copyrights.

Using Others' Works:

Every educational use is not a fair use. It's not that simple. For example, some photocopies for
each of the following activities may be fair use, but rarely will all such uses be fair:

Reserves
Coursepacks
Copies for research, scholarship and private study
Interlibrary loan and document delivery
Administrative copies
If a use is not a fair use, faculty need help to get permission. Relying on individuals to obtain needed permissions is inefficient and perhaps even ineffective. Since the University is likely to share responsibility for faculty liability for infringement, it makes sense to provide faculty with a centralized resource.

Universities may need permission at times to digitize, display, perform and distribute print or other analog works. Even if the library has licensed an electronic work, someone may need rights to use the work in a way that is not covered by the license. We certainly need to negotiate better access licenses that cover all anticipated educational uses.

So, a comprehensive copyright policy provides:

Fair use guidance
- As explained further below, regardless of the status of state sovereign immunity for copyright infringements, Universities need to ensure that normal activities comply with copyright law by getting information about fair use and how to apply it in the various contexts we encounter on campus to the people who need it when they need it in a way that makes sense and is truly helpful.

Help to get permission
- In addition to providing effective guidance about fair use, Universities have to make it easier to get permission for those uses that go beyond fair use. As we learn more about transactionally based and blanket licenses and assess their strengths and weaknesses, we will be better able to judge when to exploit each type to most efficiently promote copyright compliance. On the other side, when we are copyright owners, we need to make it easier for those who wish to use our works.

Comprehensive access licensing
- Universities also must provide support for staff who negotiate license agreements for initial access to electronic works. If we acquire sufficient access upfront, we should not need additional permissions for the uses that we know we'll need to make of electronic works.

Managing our Copyrights:

University faculty, students and staff create educational materials, scholarly works and administrative publications by the thousands every day. Our creations are getting more complex and more valuable. We simply must not fail to recognize their value and preserve it for the University community's benefit.

A comprehensive copyright policy also should address:

Who owns these
and who has rights to use and exploit them? This is up to us as institutions and as an educational community. These are our works, made by us, for us. In the past, we haven't taken them or their value very seriously.
It's time we woke up and smelled the coffee

Summary

All aspects of a comprehensive copyright policy are related:
As Universities get serious about 
fair use
, they must also get serious about getting
permission

As Universities get serious about getting permission, they also have to get serious about
licensing comprehensive access

As they get serious about protecting every else's copyrights, they'd better get serious about
their own copyrights
and
begin to manage them more effectively

The
University of Texas System Comprehensive Copyright Policy
, linked to herein, provides an example of how to address all of these related issues.

Only State Institutions Get to Dream About Sovereign Immunity

The possibility of immunity only applies to State Institutions, so the thousands of private
Universities and Colleges don't even get to imagine what it might be like to be immune from
suit. For them, there's no excuse. They need to address all the copyright issues on campus
right away.

Sovereign Immunity is Not a "Sure Thing"

State Institutions shouldn't be lulled to sleep thinking that sovereign immunity will protect them
from infringement lawsuits. Many things might happen to wake them up from their dream:

There is at best a possibility that state entities might be immune from suit for copyright
infringement. A patent case decided by the Supreme Court on June 23, 1999, Florida Prepaid
Postsecondary Education Expense Board v. College Savings Bank, 119 S.Ct. 2219 (1999)
involving the review of the Patent and Plant Variety Protection Remedy Clarification Act
("Patent Remedy Clarification Act") authorizing suits in federal court against the states for
patent infringement, found the Patent Remedy Clarification Act to be unconstitutional. Suits
against the states for copyright infringement are similarly authorized by another statute that is
at issue in a different case, Chavez v. Arte Publico Press, 157 F.3d 282 (5th Cir. 1998), and
other cases holding the same (the Copyright Remedy Clarification Act). Therefore, many people
hoped that the Florida Prepaid decision would also settle the issue of whether states might be
immune from suit for copyright infringement. While the reasoning in the Florida Prepaid case
did not settle the issue for copyright, it seems possible, and perhaps even likely, that the
Copyright Remedy Clarification Act is similarly flawed and would be found unconstitutional if it w
Before the Supreme Court accepted Florida Prepaid by writ of certiori, an appeal of Chavez to the full 5th Circuit was pending. Rehearing en banc granted and judgment vacated by Chavez v. Arte Publico Press, 178 F.3d 281 (5th Cir. 1998). The case has now been remanded to the panel for reconsideration in light of Florida Prepaid and College Savings Bank. Chavez v. Arte Publico Press, 180 F.3d 674 (5th Cir. 1999). So, we await a new 5th Circuit decision, which may go either way, and a likely appeal to the Supreme Court, which could go either way. It may be some time before this issue is finally decided. This level of uncertainty does not permit us to count on immunity.

Even if immunity were a sure thing, Congress could try to pass new legislation to subject the states to suits for infringement in federal or state court. In accordance with Florida Prepaid, however, such legislation would have to be an explicit response to actual state activities that violate others' copyrights and would have to be proportional to those violations. Given very good faith efforts of most state institutions to comply with copyright law today, legislators may not be able to meet this burden.

While, at least for now, state Universities are not likely to be named in copyright infringement suits in federal court asking for money damages, it does not mean that they should throw caution to the wind and ignore others' copyrights (or patents and trademarks for that matter). We strongly advise all our U.T. System component institutions and all of our employees and our students to follow our Copyright Policy.

Even if State Institutions are Immune, Their Immunity is Not Complete

Copyright infringement is still against the law and copyright owners have many other ways to enforce their rights besides federal lawsuits for money damages! They may:

*Sue the people who run a University for injunctive relief;*  
*Sue a University in state court for breach of contract* if the University violates the terms of a software, database or other information license agreement that protects works covered by copyright laws;  
*Sue a University employee*  
*individually*  
*for copyright infringement* for money damages or injunctive relief or both in federal court, especially where the employee's allegedly infringing activity is clearly outside the scope of activity permitted by the copyright statute, including reasonable interpretations of fair use.  
There is nothing that bars a plaintiff from bringing suit against an administrator or faculty member individually. Scheuer v. Rhodes, 416 U.S. 232, 237-38 (1974). In such a case, the plaintiff can ask for money damages and injunctive relief. The courts have found that an individual defendant's payment of money damages in no way implicates the state's interests, even if the state has an indemnification obligation to the individual employee. See, e.g., Jackson v. Georgia Dept. of Transp., 16 F.3d 1573 (11th Cir. 1994) and discussion therein of rule in other circuits.
Under some circumstances an individual sued in his or her individual capacity may be entitled to qualified or "good faith" immunity. *Harlow v. Fitzgerald*, 457 U.S. 800, 102 S.Ct. 2727 (1982). Usually this defense is invoked to protect officials accused of civil rights violations, but it should apply to violations of copyright law too; however, in a recently reported case in which a faculty member was sued in his individual capacity, the faculty member did not raise qualified immunity as a defense. *Rainey v. Wayne State University*, 26 F. Supp. 2d 973 (E.D. Mich. 1998). Even if qualified immunity does exist for violations of copyright owners' rights, it is, as its name implies, limited. It is not available where the right allegedly infringed was clearly established at the time of the infringement, where the defendant knew or should have known of that right or knew or should have known that his or her conduct violated the statute. *West v. Keve*, 541 F. Supp. 534, 539 (D. Del. 1982), citing *Procunier v. Navarette*, 434 U.S. 555 (1978).

"A court evaluating a claim of qualified immunity 'must first determine whether the plaintiff has alleged the deprivation of an actual [statutory] right at all, and if so, proceed to determine whether that right was clearly established at the time of the alleged violation.' *Wilson v. Layne*, 119 S.Ct. 1692, 1696 (1999), quoting *Conn v. Gabbert*, 119 S.Ct. 1292 (1999). Whether an official may be held personally liable for an infringement would turn on the 'objective legal reasonableness' of the action, assessed in light of the legal rules that were 'clearly established' at the time it was taken." *Wilson* at 1699, quoting *Anderson v. Creighton*, 483 U.S. 635, 107 S.Ct. 3034 (1987). Thus, if a reasonable person in the defendant's position would understand that his or her actions would violate the plaintiff's rights, the defendant will be liable.

Applying this test to a violation of a copyright owner's rights, a court would first determine whether the actions complained of were infringing. Next, the court would analyze whether the rights infringed were clearly established at the time. While a court is likely to find that copyright rights generally are very well established, there may be more room for debate on the issue of whether a reasonable person in the defendant's position would know that his or her actions constituted a violation of those rights because fair use, which is an affirmative defense to a claim of infringement, is quite vague, especially in the electronic environment. In fact, the scope of fair use in any medium is the subject of considerable disagreement. Conflicting court opinions on the very issue raised by the plaintiff's allegations would tend to show that the rights were not clearly established; however, at this time there are few if any court opinions analyzing fair use in the nonprofit educational environment. Further, an institutional Copyright Policy that clearly explains fair use and sets out its scope in an understandable way, for example by includin

Overall, the standard for qualified immunity might seem to be met most easily where an individual has done his or her best to conform behavior to a Copyright Policy that clearly explains rights and responsibilities under the law. In effect, this is not very different from the parameters of the Good Faith Fair Use Defense.
Ironically, where an employee's University either does not have such a Copyright Policy or its Policy is insufficiently clear, it may be possible to argue that failure to comply was due to such lack of clarity. *Class v. Norton*, 505 F.2d 123, 128 (2d Cir. 1974). In other words, a reasonable person in the defendant's position would not have known what his or her responsibility under the statute was. But, with all the attention being paid to copyright law today it may be difficult to argue that a reasonable person would not know what a copyright owner's rights are and that the scope of fair use is limited. In fact, there has been considerable public debate on the issue of fair use with both copyright owners and users becoming clearer and more vocal about their views on its scope.

The ultimate question may be simply how far outside the scope of fair use or another statutory exemption an activity falls. Again, this is very much the same argument one might make in asserting the Good Faith Fair Use Defense. If the activity reasonably can be defended as a fair use, qualified immunity or the Good Faith Fair Use Defense should operate to prevent, respectively, suits or awards for money damages. On the other hand, if an activity violates clear Copyright Policy and is not otherwise reasonably defensible as a fair use or within another statutory exemption, qualified immunity and the Good Faith Fair Use Defense both could be unavailing. Unfortunately, in either case, the defendant is likely to undergo at least part of a trial to explore the issue of whether he or she is entitled to qualified immunity. That in itself is a most torturous punishment.

Universities may have indemnification obligations to faculty infringers
Many Universities agree to indemnify a faculty author if he or she is sued and the actions upon which the suit is based were authorized by the Institutional Copyright Policy. Thus, even if a state University is immune from suit, it may find that it is obligated to reimburse faculty members who are sued individually and suffer losses.

**We are Copyright Owners Too**

The rapid rise in the importance of distance education and creating and distributing educational materials online sensitizes us to the issues facing copyright owners. It is entirely inappropriate for us to act as though others' rights are unimportant while we insist that our own rights be respected.

**Institutions that are Not Immune are Likely Liable for Faculty Infringements**

At least all private institutions, and possibly all State Institutions as well must address their likely liability for faculty infringements in the preparation and distribution of distance learning materials. Universities may be liable under theories of *respondeat superior* (agency), vicarious liability or contributory liability.

**Agency Liability**
The Supreme Court has indicated in the Reid case (cited below), that courts must look to general common law, rather than any particular state's common or statutory law, to determine issues of agency and the scope of employment as that law is set forth in the Restatement (Second) of Agency. In accordance with § 228, a University may be liable for the infringements of a faculty member under the theory of respondeat superior where the faculty member is shown to be an employee and the infringement (i) is an activity of the kind the faculty member is employed to perform (one within the employee's general scope of authority); (ii) occurs substantially within the authorized time and space limits; and (iii) is actuated, at least in part, by a purpose to serve the employer, that is to further the employer's business and accomplish the objective for which the employee was hired. Restatement (Second) of Agency § 228 (1958).

The employment relationship is established through analysis of at least thirteen (13) factors including whether the hiring party has the right to control the manner and means by which the hired party's job is accomplished; the skill required; the source of the instrumentalities and tools; the location of the work; the duration of the relationship between the parties; whether the hiring party has the right to assign additional projects to the hired party; the extent of the hired party's discretion over when and how long to work; the method of payment; the hired party's role in hiring and paying assistants; whether the work is part of the regular business of the hiring party; whether the hiring party is in business; the provision of employee benefits; and the tax treatment of the hired party. Community for Creative Non-Violence v. Reid, 490 U.S. 730, 109 S.Ct. 2166 (1989).


Under these rules, how likely are Universities to be found liable for faculty infringements? Employee status often will not be in dispute. The other issues may not be open to argument either. Faculty have many duties likely to lead to infringement that are clearly within the general scope of faculty authority and aimed at accomplishing the objectives for which faculty are hired. Faculty members certainly have authority to prepare coursepacks and to place materials on reserve. They are authorized, indeed encouraged, to populate their websites with all kinds of online course materials. Publishing scholarly writings is imperative, and posting them to websites or otherwise distributing them electronically is common. Whereas they are not authorized to infringe, per se, this is not the issue. It is only necessary that the wrongful act be similar to what is authorized.

It would appear that faculty members are almost assuredly agents of their University employers: their activities likely to infringe are within the general scope of their employment duties and would usually further University business goals and accomplish their teaching and research objectives.

Vicarious Liability
Vicarious Liability

Where Universities persuasively argue that one or more of the elements that constitute agency is lacking in a particular case such that the direct infringer would not be an employee for purposes of *respondeat superior*, they might still be held vicariously liable for the actions of such non-employees where they have sufficient right and ability to supervise them and derive direct or indirect financial benefit from the infringer’s exploitation of copyrighted materials. *Shapiro, Bernstein & Co., Inc. v. H. L. Green Co., Inc.*, 316 F.2d 304 (2d Cir. 1963); *Gershwin Pub. Corp. v. Columbia Artists Mgt., Inc.*, 312 F. Supp. 581 (S.D.N.Y. 1970), aff’d 443 F.2d 1159 (2d Cir. 1971); *Polygram International Publishing, Inc. v. Nevada/TIG, Inc.*, 855 F. Supp. 1314 (D. Mass. 1994). The rules of vicarious liability thus extend *respondeat superior* principles to independent contracting.

*Green* is the landmark case in this area. The *Green* court reviewed earlier cases along a continuum from those addressing landlord/tenant issues where landlords usually did not have vicarious liability, to those dealing with dance halls, whose proprietors usually were vicariously liable. The *Green* court concluded that the owner of a department store that leased space to a vendor who sold counterfeit records was more like a dance hall proprietor than a landlord. That approach to the analysis and the *Green* articulation of the test is still followed today.

The right and ability to supervise is usually found where the supervisor has the ability to terminate the relationship for any reason, or where the direct infringer is obligated to follow rules and regulations. *Fonovisa, Inc. v. Cherry Auction, Inc.*, 76 F.3d 259 (9th Cir. 1996). It is not necessary that actual control is exercised, just that there is a right to control. Thus, the same facts that tend to show how faculty members are subject to controls for agency purposes, especially with respect to the behaviors that are likely to lead to infringement, will support the finding of vicarious liability as well.

The required financial benefit need not be derived from the particular work that infringes. Rather, all that is necessary is that there be benefit from the general type of activity that is found to infringe. House of Representatives Report to the 1976 Copyright Act, p.159-160; *Broadcast Music, Inc. v. Blumonda, Inc.*, 32 U.S.P.Q. 2d 1474 (D. Nev. 1994).

The principle of academic freedom may tend to undercut the assertion that the University has the power to control faculty members. On the other hand, that argument could be countered by showing that giving faculty members the right to determine what they will say does not strip the University of the right to control whether the faculty member infringes another’s rights in the process of saying it. Academic freedom is not *carte blanche*.

Similarly, the existence of an Intellectual Property Policy granting faculty members ownership of copyright in their educational course materials might suggest that the University lacks control over what faculty authors do in the course of creating such materials. This argument is likely to meet the same response: because a University does not exercise every possible control over faculty does not negate the control it does exercise.
How might the existence of specific contracts for the creation of course materials affect the analysis? Contracts with faculty members who are employees are not likely to address the relationship at all, but would focus on copyright, production and liability issues. There could, however, be some question as to whether anything in the contract, or the contract itself, negates employee status with respect to that particular work. Contracts with individuals who are not employees will tend to establish independent contractor status. The necessary elements of control and benefit can be proved from the provisions of the contract or otherwise. Thus, the existence of a contract per se would only affect the analysis if it stated or negated elements of the cause of action.

May a University shift all liability for copyright infringement through contract? For example, could a University contractually require a faculty member to obtain all necessary permissions and even provide funds for the faculty member to use to obtain them, and thereby avoid vicarious liability for the faculty member's infringement in connection with the project that is the subject of the contract? Probably not, because courts are likely to view a University as better able than faculty members to obtain licenses and better able to protect itself through contractual indemnification. This underscores the need to obtain indemnification from faculty members who create and place educational courses online. The general rule that trying but failing to stop an infringement is no defense also militates against shifting responsibility to faculty members. *Warner Bros., Inc. v. Lobster Pot, Inc.*, 582 F. Supp. 478 (N.D. Ohio 1984).

Thus, faculty members who may not be employees under agency principles may still subject Universities to vicarious liability for their infringements where the direct infringer is subject to University rules and regulations governing behavior. Further, Universities are likely to get little relief from arguments that academic freedom, intellectual property policies that grant faculty members ownership of copyright in educational materials or contracts that delegate the responsibility to faculty to obtain copyright clearances outweigh facts showing right and ability to control and direct or indirect financial benefit.

**Contributory Liability**

Universities may also be contributorily liable where the facts to support agency or vicarious liability are lacking, but they have knowledge of a direct infringement and either participate in it or supply the means by which it is carried out. *ITSI T.V. Productions, Inc. v. California Auth. of Racing Fairs*, 785 F. Supp. 854, 861 (E.D. Cal. 1992); *aff'd in part, rev'd on other grounds*, 3 F.3d 1289 (9th Cir. 1993); *Cable/Home Communication Corp. v. Network Prods., Inc.*, 902 F.2d 829, 845-47 (11th Cir. 1990).

Participating in an infringement means inducing, causing or materially contributing to it. For example, selecting the material to be copied, played or distributed (*Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354, 365 (9th Cir. 1947)); working closely with the direct infringer to modify a work, in effect, co-authoring it, and agreeing to share royalties from sales of the work (*Baron v. Leo Feist, Inc.*, 173 F.2d 286 (2d Cir. 1949); *MCA, Inc. v. Wilson*, 425 F. Supp. 443 (S.D.N.Y. 1976); *aff'd in part, modified in part*, 677 F.2d 180 (1981)); or guiding or supervising the direct infringement (*Boz Scaggs Music v. KND Corp.*, 491 F. Supp. 908 (D. Conn. 1980)) all have been characterized as participating in the infringement.
The participation must be a significant part of the direct infringement. If the act is immaterial or the knowledge element is missing, courts will not find contributory liability. An individual who provided a copy of a journal article to a superior who used pictures from it in an infringing way was not found contributorily liable because she did not take an active part in determining what would be done with the article. Varon v. Santa Fe Reporter, Inc., 218 U.S.P.Q. 716, 718 (D.N.M. 1982).

In close cases, courts are likely to focus on whether the contributory infringer knew or should have known about the infringement. (Gershwin Publishing Corp. v. Columbia Artists Management, Inc., 443 F.2d 1159, 1162 (2d Cir. 1971); Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Const. Co., 542 F. Supp. 252, 261-262 (D. Neb. 1982)). The knowledge requirement means only general knowledge about the direct infringing activities. It does not require that the University have reached a legal conclusion that the activities are infringing. This "strict liability" rule in copyright law dates back to as early as 1869. Lawrence v. Dana, 15 F. Cas. 26, 60 (C.C.D. Mass. 1869). Further, any University employee can have the knowledge. It need not be an official or officer for that person's knowledge to be imputed to the University.

Where the contribution of materials or equipment is at issue, it is difficult to make out a case against a contributory infringer because of the doctrine of "substantial non-infringing uses." This doctrine is explained in the Sony case. Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417 (1984). It provides that if material or a machine or equipment that enables an infringement has substantial non-infringing uses, providing such a machine to another will not satisfy the test for contributory infringement, even where there is knowledge of the infringing use. In Sony, a video tape recording device was found to have such a substantially non-infringing use, namely, timeshifting (recording broadcast television programs for viewing at a later time), which the court found to be fair use.

Universities could be contributory infringers where students are infringing with the knowledge of a faculty member who is involved in some material way with the infringement, such as requiring classroom activities that are infringing, knowing that such activity is prohibited. In such a case, the faculty member's knowledge can be imputed to the University and it will be found contributorily liable. Even if the faculty member does not know that infringing activity is taking place or whether an activity is infringing, if he reasonably should have known, the University will be contributorily liable. Casella v. Morris, 820 F.2d 362, 365 (11th Cir. 1987).

Copyright Policy

The University of Texas System's (U.T. System) Copyright Policy contains references to other documents that provide more detailed guidance on fair use. The most important of these is Fair Use of Copyrighted Materials. This document contains specific guidelines for a variety of circumstances (coursepacks, distance learning, image archives, multimedia and electronic reserves, among others) and a detailed description of how to use the statutory Four Factor Fair Use Test. Together, these tools help to guide faculty members' choices about using others' copyright works without permission. We also have an online tutorial that faculty members and others soon will be required to review before undertaking online courseware projects. Further, as copyright counsel I conduct seminars, workshops and lectures for University faculty members and others, create and maintain the Copyright Crash Course.
a comprehensive online fair use resource, and answer, on average, 50 inquires related to copyright monthly. Nevertheless, if a faculty member fails for whatever reason to follow our Copyright Policy and both the University and the faculty member are sued, the University likely will be liable.


Since contributory infringement liability requires that the University knowingly participate in or supply the means for accomplishing the infringement, the existence of a policy prohibiting infringement and providing detailed guidance about fair use would tend to show what would be reasonable for administrators and faculty members on our campuses to know about copyright law. This may also affect the availability of defenses, as discussed further below.

For this reason, it is not enough just to just have a Policy; Universities must do more to familiarize faculty members with the Policy and help them to understand and follow it. Unfortunately, trying hard may not reduce our risk of sustaining considerable losses. Only when we eliminate activities that are beyond the scope of fair use or outside the other applicable statutory exemptions will we really reduce our risk of liability.

The Good Faith Fair Use Defense

Faculty members who do not follow their University's Copyright Policy subject themselves and the University to liability. Unfortunately, even those who do follow the Policy might be sued for their actions. This results from the considerable difference of opinion as to the scope of fair use among copyright owners and users. If a University and any of its faculty members were sued for actions that are within the scope of what the University considers fair use, that is, within its Policy, the University and the faculty members quite likely will qualify for the best defense available under law. If it applies, the Good Faith Fair Use Defense (17 U.S.C. § 504(c)) permits a court to refuse to award any damages at all if it so chooses, even if the copying at issue is found not to be a fair use. The requirement to qualify is that the direct infringer must have reasonably believed that the infringing activity was a fair use. Following a Copyright Policy is good insurance both for the University and for faculty.

Summary

There are numerous Institutional interests in having a comprehensive copyright policy even if Sovereign Immunity may protect some Institutions from some copyright claims. We have much to gain from sorting through the issues of fair use, getting permission, licensing comprehensive access, clarifying ownership of copyright in distance learning materials (among others) and managing our copyrights for the benefit of the University community.
Comments to Georgia Harper
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MORAL RIGHTS FOR UNIVERSITY EMPLOYEES AND STUDENTS: CAN EDUCATIONAL INSTITUTIONS DO BETTER THAN THE U.S. COPYRIGHT LAW?

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I. INTRODUCTION

A. Copyright law protects economic interests.
B. Moral rights include three primary rights: the right of disclosure; the right of attribution; and the right of integrity. These are personal, as opposed to pecuniary, interests.
C. Protection for moral rights in the U.S. lags behind other countries; this situation is especially problematic for authors in a university setting because educational institutions provide creators with a nurturing environment where process and the intrinsic value of expression reign supreme.
D. My argument is that universities should attempt to better educate their authors about moral rights, and to the extent possible, to safeguard their authors’ moral rights.

II. A COMPARISON OF MORAL RIGHTS PROTECTION IN THE U.S. AND ABROAD

A. In the United States, courts have applied a variety of laws such as unfair competition, contracts, and even copyright doctrines to redress moral rights violations.
B. The Visual Artists Rights Act (“VARA”) is the cornerstone for moral rights protection in this country. 17 U.S.C. § 106A.
   1. VARA has a very narrow application to particular works of fine art.
   2. VARA covers limited rights of attribution and integrity (i.e., intentional modifications that will prejudice a creator’s honor and reputation).
   3. VARA permits waivers but only with a specific signed instrument.
   4. One joint author can waive the specified rights for all other joint authors.
C. Many European and Third World nations have extensive moral rights laws. France’s protections are among the strongest. Recently, there has been a renewed interest in moral rights abroad, but still no European Union Directive on moral rights.
D. Differing theoretical and cultural frameworks are responsible for the disparity in treatment of moral rights in the U.S. and abroad. U.S. copyright law is more influenced by social utility; Continental copyright doctrine focuses on the author and her personal relationship to her work.
III. MORAL RIGHTS ASSERTIONS IN THE UNIVERSITY SETTING

A. A review of the cases involving universities and their personnel in the context of moral rights, or "quasi" moral rights litigation reveals the following fact patterns: student vs. university; student vs. professor; professor vs. student; and professor vs. university. The underlying themes of the litigation involve violations of authors' rights of attribution, integrity and disclosure.

B. A study of this litigation is useful for the following reasons:
   1. The cases reveal important ways in which moral rights of those working in university settings are not being effectuated;
   2. The cases highlight that universities face particular types of challenges in dealing with their personnel with respect to moral rights issues;
   3. The cases suggest ways in which universities can be more responsive to the moral rights of their faculty, students and staff.

C. Inadequacy of Other Legal Doctrines
   1. Moral rights oriented cases in the university context recognize that often university faculty or students have relatively no commercial interest in their creations. Reputational concerns prevail. Sometimes other legal doctrines provide moral rights substitutes, but they do not adequately represent reputational interests.
   2. Copyright Law: Right of disclosure violations figure prominently and plaintiffs concerned with this issue must successfully invoke principles of copyright law. See e.g., Williams v. Weisser, 273 Cal. App.2d 726 (1969) (plaintiff professor successfully sued defendant for publishing his class notes based on violation of the professor's common law copyright in lectures).
      Copyright law addresses economic concerns but does not theoretically address the reputational harms caused by the premature publication of altered, and defective, lecture notes that are published with an attribution of authorship.
   3. Section 43(a) of the Lanham Act: Provides a remedy for false designations of origin and therefore can apply to the extent an author's works are published in an altered state, with name attached. See, e.g., Choe v. Fordham University School of Law, 920 F. Supp. 44 (S.D.N.Y. 1995) (student sued school and law journal, alleging mutilation of his law review article due to publication with numerous errors; court denied relief on the ground that despite the errors, readers still would be able to understand the article).
      Given the vastly different objectives between 43(a)'s focus on economic rights, and the moral right doctrine's focus on reputational interests, any protection that an author may receive for her personality rights under 43(a) is fortuitous.

D. The Joint Authorship Dilemma
   1. Academic environments give rise to many co-authorship arrangements that can result in disputes. These situations reveal that no adequate cause of action exists in the U.S. to address a moral rights violation committed by
one co-author who publishes the work in an altered, and objectionable, state.

2. *See, e.g., Seshadri v. Kasraian, 130 F.3d 798 (7th Cir. 1997)* (in dispute between professor and former student, court observes that the publication of a jointly authored article with errors reflecting unfavorably on co-author does not violate copyright law); *Weinstein v. University of Illinois, 811 F.2d 1091 (7th Cir. 1987)* (in suit by professor co-author against university and university employees based on due process clause violation arising from the publication of an article with the authors' names in the wrong order, court held that co-authors can make changes in a work and publish the original or a revision).

3. For co-authorship disputes involving VARA works, the situation is especially difficult because the statute provides that one joint author can unilaterally waive the other joint authors' moral rights.

E. **Copyright Actions Against State Entities**

1. Presently unclear whether plaintiffs will continue to be able to recover damages against state institutions for copyright infringement. This uncertainty also effects plaintiffs seeking to use copyright law to recover for moral rights violations.

2. The Copyright Remedy Clarification Act (CRCA) expressly eliminated state immunity for copyright infringement and therefore state universities can be sued for both copyright infringement and moral rights violations under VARA.

3. Last term, the Supreme Court declared the Patent Remedy Clarification Act unconstitutional in *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank, 119 S.Ct. 2199 (1999)*. In a companion case, *College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board, 119 S.Ct. 2219 (1999)*, it also concluded that the Trademark Remedy Clarification Act does not permit a State to be sued for its alleged misrepresentation of its own product.

4. The constitutionality of the CRCA may be tested soon in *Chavez v. Arte Publico Press*, which has been remanded by the Fifth Circuit given these recent Supreme Court decisions. *See 1999 WL 486653 (1999)*.

F. **Preemption**

1. Litigation involving university personnel parallels the case law involving non-academic situations in that preemption of other state laws potentially is an issue.

2. The difficulty courts face when confronted with claims implicating moral rights in connection with copyrightable property is how the preemption provision of the 1976 Copyright Act should be applied. 17 U.S.C. §301(a).

   a. Preemption will not occur if the state law does not pertain to “works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright.”
b. Preemption will not occur if the state seeks to protect rights that are "not equivalent to any of the exclusive rights within the general scope of copyright."


4. As a general matter, if the state law is violated by some action other than the exercise of economic rights protected by §106 of the 1976 Copyright Act, or other than the rights specifically protected by VARA, there will be no preemption of the state law. See Rainey v. Wayne State University, 26 F. Supp. 963 (E.D. Mich. 1998) (in suit by student against her professor and a car manufacturer for including her artwork in manufacturer's brochure, the court held that the student's state cause of action against her professor for breach of fiduciary duty was not preempted; the state claims based on intentional infliction of emotional distress and unjust enrichment were preempted).

5. State created rights specifically protecting an author's right to compel recognition for her work or preventing the designation of anyone else as the author are not technically equivalent to the rights protected by the 1976 Act, but arguably conflict with the spirit of the 1976 Act since the copyright law does not expressly safeguard these rights.

6. Unauthorized modifications by one other than the copyright owner are actionable under §106(2) of the copyright statute, but this application of copyright law does not expressly govern alleged distortions to the work. Yet, state laws specifically addressing reputational harms suffered in conjunction with the unauthorized modifications of copyrightable works are likely to be preempted.

III. FACILITATION OF AUTHORS' MORAL RIGHTS BY UNIVERSITIES

A. Universities should attempted to protect the moral rights of authors regarding any work created for the university itself or under its auspices. This should be the case even if the work is a work for hire, or the author has assigned the copyright to the university.

B. Universities should provide more education about authors' moral rights to their faculty, students, and staff.
   1. Education regarding substantive copyright, VARA, and contract law.
   2. Practical education about safeguarding moral rights in connection with contract negotiations.
   3. Assistance to authors involved in contract disputes and violations.

C. Universities should encourage their faculty to be protective of their students' moral rights. Rainey v. Wayne State University, supra (professor apparently ignored his student's request for assistance in safeguarding her personal interests in her work).

D. Universities should encourage their personnel to be more sensitive to authors' moral rights when disputes arise. Choe v. Fordham, supra (more thoughtful and explicit consideration of the moral rights implications of this dispute might have avoided litigation).
Intellectual Property Issues on Campus:
Computers, Copyright and Cyberspace
University of Houston
December 3, 1999
Robert M. O’Neil, University of Virginia and
Thomas Jefferson Center for the Protection of Free Expression

Campus Database Issues

I. The Dramatically Changing Database Landscape

A. Universities move from being primarily database creators to primarily users of commercially created databases

B. Congress offers two contrasting solutions to a perceived need for greater database protection:

1. H.R. 354

2. H.R. 1858

C. The academic and commercial database communities respond

II. The Legal Background and Context

A. The Law before Feist v. Rural Telephone -- confusion and uncertainty, with marginal recognition of protection for “sweat of the brow.”

B. Feist settles some issues, but leaves others to the lower courts and to Congress.

C. Post-Feist litigation recognizes a significant level of protection for database creation and compilation.

1. Many print-material cases confer protection and enjoin infringement of databases and similar data collections
2. The one case dealing directly with electronic databases (other than telephone listings), *Corsearch v. Thomson & Thomson*, protects the database and enjoins infringement.

III. The Congressional Response

A. H.R. 354 -- summary and implications

B. H.R. 1858 -- summary and implications

IV. The University Community Identifies Concerns Which Favor the H.R. 1858 approach:

A. The post-*Feist* copyright caselaw is substantially more protective than commercial database producers acknowledge (including *Corsearch*, the one truly apposite electronic database decision)

B. State common law of misappropriation (a premise of H.R. 1858) provides additional protection in meritorious cases

C. Trademark law may also afford protection of certain branded databases

D. Electronic database producers enjoy certain technological protections (e.g., encryption, serial copy controls, watermarking) which were enhanced by the Digital Millennium Copyright Act.

E. The restrictions imposed by H.R. 354 would seriously constrain academic scholarship and research access in many disciplines to the factual data and databases which they comprise.

F. An approach such as that embodied in H.R. 1858 would adequately protect against unfair competition and piracy the vital interests of database producers.
University Patent and Copyright Policies and Politics – A Case Study

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The Existing Policy

In 1985, Temple University (where I began teaching in 1997) adopted for the first time an “Invention and Patent Policy.” Like many universities, Temple was responding to the Bayh-Dole Act of 1980 (P.L. 96-517), which provided that small businesses and nonprofit organizations, including universities, can retain title to materials and products they inventoried with the use of federal funds and which opened up an entire “technology transfer” industry within the US university research community.

The critical provisions of the Policy (which is available at
http://www.techtrans.temple.edu/ip_policy.html and which is still in effect) are as follows. First, with regard to ownership, the Policy provides that the University is entitled to “the entire right, title and interest to any invention (including computer-related software and ancillary materials, but not including pure works of art or musical compositions) which [a] is developed in whole or in part by any University employee, including, without limitation, faculty, staff member, fellow, resident, graduate student or assistant (whether paid or unpaid), [b] which emerges from any University research or development activity, or [c] which emerges from use of any University facilities or equipment.” The individual inventor is deemed the owner of “all right, title and interest to any discovery or invention which is developed wholly on the inventor’s own time and with the inventor’s own facilities and which does not involve use of any University funds, equipment, facilities or personnel.”

In return for that transfer of ownership, the University is obligated to “decide expeditiously upon the method for administering the invention which best fulfills the objectives of this Policy.” If the University decides that seeking a patent for the invention, it is obligated to “assume all costs associated with patent prosecution, maintenance and enforcement.” Additionally, the University must “seek and negotiate licensing or other agreements for inventions to which the University has rights, with consultation with the inventor or a representative, and to assume all costs associated therewith.”

Income from any such license transactions is divided as follows:

The net income\(^1\) to the University from a royalty agreement or other agreement resulting from an invention is divided 50/50 between the University and the individual inventor, “provided

\(^1\)Net income is defined as “gross income minus the patenting, legal and marketing costs incurred by the University related to such invention, including as a cost any income share that may be retained by an outside patent management organization.”
that the inventor(s)' share shall not fall below five percent (5%) of the University's gross receipts." As for the University’s share of income, the Policy provides that the first $500,000 of the University’s share of royalties is to be divided among the “Department or Research Unit responsible for the invention,” (35%), the “School or College responsible for the invention,” (15%), and “the University” (50%). University royalties in excess of $500,000 is to be allocated “to stimulate and support research, provided that ten percent (10%) of such excess royalties shall continue to be allocated to the Department or Research Unit responsible for the invention, and an additional ten percent (10%) of such excess royalties shall continue to be allocated to the School or College responsible for the invention.”

Pressure for Change

As far as I can tell, the Policy was considered to be a great success. That is, the University established an Office of Technology Transfer (see http://www.techtrans.temple.edu/index.htm and http://www.techtrans.temple.edu/licensing.html) that began systematically to commercialize faculty inventions. Income from commercialized inventions has been substantial; by 1998, Temple inventions generated $1,028,000 in gross royalty income, plus an additional $565,000 in funding for basic research related to inventions under license or option. Inventors received $387,000, and an additional $226,000 was provided to departments and colleges as discretionary research funding. Faculty members – especially those in the biomedical sciences, where patentable inventions are most likely to result from research activities – had a partner willing to share the risks of licensing (and, significantly, willing to bear the entire expense of navigating the patent process for them).

By the mid-1990s, there was a general (and, I believe, fairly uncontroversial) view that the Policy needed some revision, and a small working group, composed of faculty, administration, and OTT staff, was appointed to consider changes to the Policy. The working group was charged with implementing new allocation formulas regarding the income from inventions; although the basic 50/50 split appeared to be working well, the working group adjusted the way in which the University’s share of any income was allocated under the Policy.²

²A complete list of Temple inventions that are currently being commercialized can be found at http://www.techtrans.temple.edu/lt/lt.html.

³See http://www.techtrans.temple.edu/techreport.html. Between 1990 and 1998, approximately $1.9 million was paid to Temple inventors under the Policy, and $1.0 million to departments and colleges.

⁴The new formula (a) subjected the initial $1 million of University income (instead of the initial $500,000) to the 35/15/50 split between the Department, the College, and the University; (b) the Departments were given a greater share of income beyond this initial tranche (20% of income above $1 million, instead of 10% of the income above $500,000, as in the original Policy), and (c) the inventor was given a voice in directing how the funds used by his/her Department were to be used (via a provision that "one half (½) [of the Department’s funds] shall be used as
That was, surprisingly perhaps, the easy part. The working group also identified some latent ambiguity in the critical definitions in the Policy. Although everyone recognized that the Policy was designed to cover patent rights only, it did not, in fact, say that expressly; that is, because the policy granted the University ownership of “the entire right, title and interest to any invention (including computer-related software and ancillary materials, but not including pure works of art or musical compositions), questions began to be asked about the scope of the “inventions” – an undefined term in the Policy – to which the University’s ownership rights attached. This coincided, of course, with what I call the “Copyright Re-Awakening.” As the digital revolution commenced, faculty members began to realize that much of what they produced could, in fact, be “owned” in the sense that there were copyright rights attached to their creations that could be exploited. What did the inclusion of “computer-related software and ancillary materials” mean? Was an English professor’s webpage covered by the Policy? Did the University own “the entire right, title and interest” to that?

Copyright issues enormously complicate the picture. First, the inclusion of copyright ownership issues means that a lot of people who thought they had no particular stake in an “Invention and Patent Policy” began to be a bit concerned. Second, copyright law (unlike patent law) has its own internal ownership provisions – the “work for hire doctrine” foremost among them – that has a number of unfortunate characteristics: while it appears, on its face, to do what the Policy does, i.e., to grant ownership to the University of the entire copyright interest in faculty members’ works of authorship, it has rarely been interpreted in that fashion. Third and perhaps most importantly, copyright lacks the quid pro quo that made the royalty provisions of the Policy acceptable to all sides; because there are no expenses or risks associated with “copyright prosecution,” as there are for patents, the assertion of University ownership over copyrights in return for a percentage of the royalties strikes many as an unequal and unfair bargain in a way that it does not for patents.

To add to the uncertainty and unhappiness, the University – again, like many others – began to explore “distance learning” options. This necessarily involves the creation of large numbers of “Copyrightable works” that are presumptively covered by the Policy. At the same time, many faculty members are of a view that distance learning initiatives will present the University with an opportunity to “outsource” teaching functions long handled by full-time, tenured or tenure-track faculty, and that the University will leverage its presumed power over contractors to obtain rights to the materials produced (putting further pressure on faculty members to “sign over” their copyrights to the University if they are to compete with these outside contractors).

And, finally, because everyone now realizes that the future will bring rapid change but nobody knows exactly the direction that change will take, the debate over intellectual property issues has all sides worrying that they will somehow be cut out of some lucrative future market(s). The Invention and Patent Policy has thus become a battleground in a very contentious dispute. This has brought forth calls for a more sweeping review of the University’s broader intellectual

directed by the inventor, and the other half (½) shall be used as directed by the Department or Research Unit head.”
property policies, and at the moment, no fewer than 5 separate University Committees are involved in those efforts. Agreement on basic principles seems further away than ever.

The Way Out?

There are, I believe, ways to deal with this impasse, although the atmosphere surrounding these discussions may be so politically charged that progress is unlikely. I will discuss, in my talk, a number of possible means of bringing some semblance of order to these negotiations, including (a) a clearer separation of patent rights from other intellectual property rights, (b) elimination of all references to “ownership” of creations (inventions, works, etc.) in place of a more careful delineation of the “bundle of sticks” to which each of the parties is entitled, and (c) more attention to process, and less to substance, in whatever intellectual property policy is proposed.