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## Copyrightable Works in the Undergraduate Student Context: An Examination of the Issues

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## I. INTRODUCTION

Imagine that you are an undergraduate student who, while enrolled at a university, created a copyrightable and potentially marketable work such as a software program. Your rights in your own work of original authorship will depend on a number of factors including how your relationship with the university is defined by the institution's intellectual property policies and by U.S. copyright law. Due to ambiguities and inconsistencies in many university intellectual property policies your rights may not be apparent.<sup>1</sup> Moreover, given the current academic commercialization Zeitgeist, emerging

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1. Anthony J. Luppino, *Fixing a Hole: Eliminating Ownership Uncertainties to Facilitate University-Generated Innovation*, 78 UMKC L. REV. 367 (2009) (describing the lack of clarity surrounding the ownership rights of university-generated inventions as one of the impediments to university-based innovation).

particularly after the Bayh-Dole University and Small Business Patent Procedures Act of 1980<sup>2</sup> (the “Bayh-Dole Act”), in which many universities have established policies requiring students to assign most, if not all, of their patentable and creative works to the university,<sup>3</sup> you may wonder whether your university has established a broad policy encompassing your copyrightable work, or whether your university may establish such policies in the future. What might this mean in terms of your perceived ownership rights to your creative product and what might you do to preclude your university from acquiring rights to your creative work? If your university has a policy, and chances are that it does, have you been notified of the policy?<sup>4</sup> Could the spirit of entrepreneurship regarding patentable works lead universities to consider folding all copyrightable student work product into its intellectual property mix?

Although the general presumption is that students retain copyrights in their own “student works,”<sup>5</sup> even when created within the university setting,

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2. 35 U.S.C. §§ 200–12 (2010).

3. See Luppino, *supra* note 1, at 374–77, for an excellent description of a number of university intellectual property policies and a general discussion of the broad range of inventions and creative materials encompassed by these policies. For example, Luppino describes the following university policies: the Arizona Board of Regents has a policy that “‘covers all forms of legally recognized ‘Intellectual Property’ which is created at the universities;” the University of Texas also has a policy that covers “‘intellectual property of all types;” Princeton University’s policy covers technology developed by “‘faculty, staff, students, and others participating in Princeton Programs;” and Boston University’s policy states that “‘[T]he University shall claim equity in all discoveries and its right to acquire title to and control of such discoveries where the discoveries are made by faculty, staff, employees, or students (including all types of trainees and postgraduate fellows) working on or arising from programs supported in whole or part by funds, space, personnel, or facilities provided by the University.”; see also Carmenelisa Perez-Kudzma, *Fiduciary Duties in Academia: An Uphill Battle*, 48 IDEA 491, 495 (2008) (describing the Tufts University intellectual property policy which “‘applies to all university personnel,” including “‘students . . . whether compensated by the University or not.” The Tufts policy also states that students “‘are covered to the extent that their creative work involves the use of University resources such as space, facilities, equipment, staff, or funds . . . for both patentable and copyrightable material.” As Perez-Kudzma goes on to explain, the Tufts policy describes a broad scope of “‘copyrightable intellectual property” includ[ing] “‘all creative works, including electronic or paper documents, as long as University resources were used for their creation.”).

4. See Perez-Kudzma, *supra* note 3, at 499 (asserting that some universities may fail to notify students of their intellectual property policies, and as a result, students might engage in research or creative activities without knowing the full extent of their rights).

5. The Minnesota State Colleges & Universities Board of Trustees defines “student works” in its intellectual property policy as follows:

- a) Intellectual property rights in student works belong to the student who created the work.
- b) A creative work by a student to meet course requirements using college or university resources for which the student has paid tuition and fees to access courses/programs or using resources available to the public, is the property of the student.
- c) A work created by a student employee during the course and scope of employment is an institutional work and intellectual property rights to such creation belong to the college or university unless

there are certain circumstances under which a university may acquire such rights.<sup>6</sup> While others have correctly asserted that ownership issues surrounding copyrights in the university setting are not as significant as those related to patents,<sup>7</sup> these rights are nevertheless significant to the student creator who may un-understandably lose ownership of a personal creation to the university to which the student, somewhat paradoxically, pays tuition. Moreover, ownership rights in traditional scholarly writings, which typically fall under the umbrella of copyrightable subject matter, carry with them the notion that such rights are fundamental to the author/creator. While the ultimate solution to overcoming the confusion surrounding ownership rights to student work product would be for each university to provide clear and comprehensive intellectual property policies to students and faculty, this comment will ultimately suggest that the very purpose of copyright law—to stimulate and incentivize creativity in order to foster the development of more creative works—would be frustrated by universities seeking to acquire copyrights to most if not all copyrightable undergraduate student work product.

To this end, Part II of this comment will begin with a discussion of how the spirit of academic entrepreneurship emerging after the Bayh-Dole Act has shaped university intellectual property policies regarding student work product. Part III will provide a brief introduction to copyright law and the most notable aspects of copyright law, namely the work for hire doctrine as it pertains to students in the university setting. Part IV will provide a summary and discussion of the main issues regarding copyrightable works for undergraduate students including an application of the work for hire doctrine and a description of how contractual university policies may alter copyright law. Finally, Part V will suggest that, with the exception of student employees, universities should not seek to acquire all copyrightable student work product as this would likely stifle student innovation and creativity.

## II. THE BAYH-DOLE ACT AND ITS INFLUENCE ON UNIVERSITY COPYRIGHT POLICY

### A. *Introduction to the Bayh-Dole Act*

Since its enactment nearly thirty years ago, the Bayh-Dole Act frequently

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an agreement, sponsorship agreement, or other condition . . . provides otherwise.  
MINNESOTA STATE COLLEGES & UNIVERSITIES BOARD POLICIES, § 3.26, Pt. 4 (A)(4), <http://www.mnscu.edu/board/policy/326.html> (last visited Feb. 26, 2013).

6. Luppino, *supra* note 1, at 383.

7. Sandip H. Patel, *Graduate Students' Ownership and Attribution Rights in Intellectual Property*, 71 IND. L.J. 481, 492 (1996); Luppino, *supra* note 1, at 378.

has been both credited with and criticized for transforming universities from relatively isolated “ivory towers” into commercial entities rapidly churning out patents and granting licenses for new technology invented in the university laboratory.<sup>8</sup> Prior to the passage of the Bayh-Dole Act, all inventions that were invented through federally funded research were assigned to the federal government.<sup>9</sup> Bayh-Dole created a patent policy that allowed universities to retain title to patents developed as a result of federally funded research and created a national emphasis on the development of the university-industry relationship.<sup>10</sup> This led many research universities, formerly inactive in patent and licensing activity, to develop technology transfer offices and engage in patenting and licensing of faculty, staff, and student inventions.<sup>11</sup> As a result, universities revised and established intellectual property policies requiring their faculty and staff to sign intellectual property assignment agreements,<sup>12</sup> and the courts have held that such policies are valid and enforceable as part of an employment contract with the university.<sup>13</sup>

### B. Changes to University Copyright Policies in Light of Bayh-Dole

Although the general presumption under the “teacher exception” has been that university faculty members retain copyright ownership in their academic writings<sup>14</sup> and traditional scholarly works,<sup>15</sup> universities have recently begun

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8. Carmen J. McCutcheon, *Fairplay or Greed: Mandating University Responsibility Toward Student Inventors*, 2003 DUKE L. & TECH. REV. 26 (2003); Dovid A. Kanarfogel, *Rectifying the Missing Costs of University Patent Practices: Addressing Bayh-Dole Criticisms through Faculty Involvement*, 27 CARDOZO ARTS & ENT. L.J. 533, 536–37 (2004); Luppino, *supra* note 1, at 368–69; Lorelei Ritchie de Larena, *The Price of Progress: Are Universities Adding to the Cost?*, 43 HOUS. L. REV. 1373, 1374–75 (2007).

9. Council on Government Regulations, *The Bayh-Dole Act: A Guide to the Law Implementing Regulations* (Oct. 1999), available at <http://www.cogr.edu/viewDoc.cfm?DocID=15744>.

10. *Id.*

11. David C. Mowery, Richard R. Nelson, Bhaven N. Sampat & Arvids A. Ziedonis, *The growth of patenting and licensing by U.S. universities: an assessment of the effects of the Bayh-Dole act of 1980*, 30 RES. POL'Y 99, 116 (2001); Council on Governmental Relations, *supra* note 9, at 2–3; Matthew Rafferty, *The Bayh-Dole Act and university research and development*, 37 RES. POL'Y 29 (2008).

12. Council on Government Regulations, *supra* note 9, at 4; K.J. Nordheden & M.H. Hoefflich, *Undergraduate Research & Intellectual Property Rights*, 6 KAN. J.L. & PUB. POL'Y 34 (1997).

13. *Fenn v. Yale University*, 283 F. Supp. 2d 615, 628–29 (D. Conn. 2003); *Chou v. University of Chicago*, 254 F.3d 1347, 1356–57 (Fed. Cir. 2001).

14. *See Weinstein v. University of Illinois*, 811 F.2d 1091, 1094 (7th Cir. 1987); *Hays v. Sony Corp. of America*, 847 F.2d 412, 416 (7th Cir. 1988) (explaining that a court “forced to decide the issue” should conclude that the teacher exception to the scope of employment rule persists).

15. “Scholarly works” are broadly defined by the Minnesota State Colleges & Universities

revising their policies to capitalize on the potential for licensing revenues generated by faculty-developed copyrightable works such as software and digital distance learning materials.<sup>16</sup> Realizing that the patent assignment agreements occasioned by the Bayh-Dole Act could also be inferred to include not only patentable but also copyrightable student innovation, universities then tapped into this commercial potential by revising their intellectual property policies to include students using university facilities or resources.<sup>17</sup> The “use” of university resources is often vaguely defined by university policies, and this comment will discuss the case law related to its interpretation in Parts III and IV.

Just as the Bayh-Dole Act has been criticized for shifting the focus of universities away from the traditional pursuit and dissemination of knowledge toward patentable and licensable ideas,<sup>18</sup> the spirit of academic commercialization of copyrightable innovation has an inherent danger of shifting control and selection of traditional scholarly works from the individual creator(s) (including faculty and students) to university control and selection for acquisition of ownership rights (*i.e.*, a change in philosophy from traditional academic freedom to mission research as in industry). This danger is not difficult to realize once one considers several of the notable and profitable innovations made by individuals while undergraduate students. To illustrate, Bill Gates made significant progress toward developing what would become Microsoft while tinkering with computers as a pre-law student at Harvard;<sup>19</sup> Fred Smith originated the idea for FedEx in a term paper while an undergraduate;<sup>20</sup> Larry Page and Sergey Brin, while Stanford computer

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Board of Trustees as:

[C]reations that reflect research, creativity, and/or academic effort. Scholarly works include course syllabi, instructional materials (such as textbooks and course materials), distance learning works, journal articles, research bulletins, lectures, monographs, plays, poems, literary works, works of art (whether pictorial, graphic sculptural, or other artistic creation), computer software/programs, electronic works, sound recordings, musical compositions, and similar creations.

MINNESOTA STATE COLLEGES & UNIVERSITIES BOARD POLICIES, *supra* note 5, at Pt. 4 (2)(A)(2).

16. Jeff Todd, *Student Rights in Online Course Materials: Rethinking the Faculty/University Dynamic*, 17 ALB. L.J. SCI. & TECH. 311, 323–326; JULIE E. COHEN, LYDIA PALLAS LOREN, RUTH L. OKEDIJI & MAUREEN A. O’ROURKE, COPYRIGHT IN A GLOBAL INFORMATION ECONOMY 138 (3d ed. 2010).

17. McCutcheon, *supra* note 8; Luppino, *supra* note 1, at 370–71.

18. Kanarfogel, *supra* note 8, at 544; de Larena, *supra* note 8, at 1427–30 (describing the university-industry relationship and providing examples of increased industry-university partnerships).

19. Luppino, *supra* note 1, at 414.

20. Dean Foust, *Fred Smith on the Birth of FedEx*, BUSINESSWEEK (Sept. 20, 2004), available at [http://www.businessweek.com/print/magazine/content/04\\_38/b3900032\\_mz072.htm?chan=gl](http://www.businessweek.com/print/magazine/content/04_38/b3900032_mz072.htm?chan=gl).

science students, began a graduate research project that led to the development of Google;<sup>21</sup> Shawn Fanning, while a student at Northeastern University, created the peer-to-peer software application, Napster;<sup>22</sup> and Mark Zuckerberg created Facebook while an undergraduate student at Harvard.<sup>23</sup>

### III. COPYRIGHT LAW

#### A. Introduction to Copyrights

The Constitution provides that “The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>24</sup> Congress has defined a copyright as “the right of an author to control the reproduction of his intellectual creation;”<sup>25</sup> and the United States Supreme Court has explained that the primary purpose of copyright is “to motivate the creative activity of authors and inventors by the provision of special reward, and to allow the public access to their genius after the limited period of exclusive control has expired.”<sup>26</sup> Thus, copyright protection exists to incentivize further creativity and to promote general welfare through the enjoyment of creative works.

The Copyright Act of 1976 provides that the scope of copyrightable subject matter extends to “original works of authorship” that are “fixed in any tangible medium of expression,”<sup>27</sup> and case law requires that the work evidence a modicum of creativity.<sup>28</sup> Copyright protection does not extend to procedures, processes, systems, methods of operation, concepts, or principles; and although copyright protects the expression of ideas, it does not protect ideas themselves.<sup>29</sup> Categories of works that can be copyrighted include: (1)

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21. See GOOGLE HISTORY, <http://www.google.com/about/corporate/company/history.html> (last visited Jan. 11, 2013).

22. See Spencer E. Ante, *Inside Napster: How the music sharing phenom began, where it went wrong, and what happens next*, BUSINESSWEEK, Aug. 14, 2000, [http://www.businessweek.com/2000/00\\_33/b3694001.htm](http://www.businessweek.com/2000/00_33/b3694001.htm).

23. See Miguel Heft, *Court Upholds Facebook Settlement with Twins*, N.Y. TIMES, Apr. 11, 2011, [available at http://www.nytimes.com/2011/04/12/technology/12facebook.html?\\_r=1&ref=markzuckerberg](http://www.nytimes.com/2011/04/12/technology/12facebook.html?_r=1&ref=markzuckerberg) (last visited Feb. 26, 2013).

24. U.S. CONST. art. I, § 8, cls. 1, 8.

25. Patel, *supra* note 7, at 491, citing *Copyright Law Revision: Report of Copyrights on the General Revision of the U.S. Copyright Law*, 87th Cong., 1st Sess. Pt. 1, at 3 (1961).

26. Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 429 (1984).

27. 17 U.S.C. § 102(a) (2010).

28. Feist Publications, Inc. v. Rural Telephone Service Co., Inc., 499 U.S. 340, 362 (1991); Kitchens of Sara Lee, Inc. v. Nifty Foods Corp., 266 F.2d 541, 545 (2d Cir. 1959).

29. 17 U.S.C. § 102(b) (2010).

literary works; (2) musical works; (3) dramas; (4) pantomimes and choreographies; (5) photos, graphics, and sculptures; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works.<sup>30</sup>

In the university setting, undergraduate students may create a wide range of copyrightable works while performing course work or course projects. Students may also write papers, create poems or art, establish blogs or websites, develop computer programs, write music or participate in competitions.<sup>31</sup> These are just a few examples of the potential for student innovation. In contrast to the relatively stringent requirements and formalities for patents, copyright protection extends the moment the original and minimally creative work is fixed in a tangible medium, and copyright registration formalities are not required.<sup>32</sup> Accordingly, as soon as the student writes a paper, creates a poem, or posts a blog or a website, that creative work becomes copyrightable.

### B. Ownership of Copyrights

Copyright ownership at universities is determined by both U.S. copyright law and internal university intellectual property policies. Section 201(a) of the Copyright Act provides that copyright ownership “vests initially in the author or authors of the work” with co-authors of a joint work being co-owners of the copyright in the work.<sup>33</sup> The Supreme Court has defined an “author” as “the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection.”<sup>34</sup> Authorship is the *sine qua non* of copyright law as it determines who may exercise the various exclusive rights comprised in a copyright.<sup>35</sup> Absent an agreement to the contrary, each copyright owner or co-owner has the exclusive right: (1) to reproduce the copyrighted work; (2) to make derivative works; (3) to distribute copies to the public; (4) to publicly perform the copyrighted work; (5) to publicly display the copyrighted work; and (6) to publicly perform the work by means of digital audio transmission.<sup>36</sup>

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30. 17 U.S.C. § 102(a) (2010).

31. TYANNA K. HERRINGTON, INTELLECTUAL PROPERTY ON CAMPUS: STUDENTS’ RIGHTS AND RESPONSIBILITIES 30 (2010).

32. 17 U.S.C. § 102(a) (2010).

33. 17 U.S.C. § 201(a) (2010).

34. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989).

35. See MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 5.01 (2011) [hereinafter NIMMER ON COPYRIGHT].

36. 17 U.S.C. § 106 (2010).

### C. *The Work for Hire Doctrine*

Although copyright ownership and the Supreme Court's interpretation of "author" appear straightforward, defining copyright ownership in the university setting can nevertheless prove difficult. Regarding student copyrightable creations, the work for hire doctrine is the most notable exception to the general ownership rule. The Copyright Act provides that "[i]n the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for [copyright] purposes . . . unless the parties have expressly agreed otherwise."<sup>37</sup> Under the work for hire doctrine, the university, not the creator, may be deemed the "author," and therefore, the owner of a copyrightable work, in two situations: (1) if the work is "prepared by an employee within the scope of his or her employment;" or (2) if the work is "specially ordered or commissioned" for certain purposes.<sup>38</sup>

The first situation, in which ownership depends upon whether the creator is (i) an "employee" (ii) working "within the scope of his or her employment," presents the most challenging scenario with respect to the university-student relationship. The Supreme Court clarified the meaning of "employee" in *Community for Creative Non-Violence v. Reid* ("*C.C.N.V.*").<sup>39</sup> In *C.C.N.V.*, the Court provided a list of thirteen factors relevant under agency law to assist lower courts in determining whether the creator can be classified as an "employee," in which case the employer would be defined as the author for purposes of ownership, or an "independent contractor," in which case the creator retains ownership.<sup>40</sup> These factors include: "the hiring party's right to control the manner and means by which the product is accomplished[;] . . . the skill required; . . . the source of the instrumentalities and tools; the location of the work; . . . whether the hiring party has the right to assign additional projects; . . . the method of payment; [and] . . . the provision of employee benefits."<sup>41</sup> Although the Court stated that no single factor was determinative,<sup>42</sup> it failed to provide further guidance with respect to the relative weight that should be accorded each factor.

In *Aymes v. Bonelli*, the Second Circuit further clarified that the *C.C.N.V.* factors should be applied in a manner consistent with their relative importance to each case.<sup>43</sup> The *Aymes* court explained that although no single *C.C.N.V.*

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37. 17 U.S.C. § 201(b) (2010).

38. 17 U.S.C. § 101 (2010).

39. *Community for Creative Non-Violence*, 490 U.S. at 730.

40. *Id.* at 751.

41. *Id.*

42. *Id.* at 752.

43. *Aymes v. Bonelli*, 980 F.2d 857, 862 (2d Cir. 1992).

factor is dispositive, some of the factors will be significant in nearly every case while others will be irrelevant or have little or no bearing on a case.<sup>44</sup> In particular, the court suggested that two factors, the provision of employee benefits and the tax treatment factors, were the most important. As court explained, “every case since [C.C.N.V.] that applied the test has found the hired party to be an independent contractor where the hiring party failed to extend benefits or pay social security taxes.”<sup>45</sup> However, as Nimmer cautions, this holding should not be taken to mean that there is a select list of factors that may be dispositive in every case.<sup>46</sup> Rather, the analysis is likely to be fact-intensive where certain factors will weigh more heavily than others.

Even if the creator is deemed an “employee,” § 101 of the Copyright Act also requires that the work be created within the employee’s “scope of employment.”<sup>47</sup> The specific issue of whether an employee created a work within the scope of employment was addressed by the United States District Court for the District of Columbia in *Roeslin v. District of Columbia*.<sup>48</sup> In *Roeslin*, the court applied the three-step test from the Restatement (Second) of Agency in order to determine whether a creation was a work for hire. Section 228 of the Restatement provides that:

(1) Conduct of a servant is within the scope of employment if, but only if: (a) it is of the kind he is employed to perform; (b) it occurs substantially within the authorized time and space limits; [and] (c) it is actuated, at least in part, by a purpose to serve the master.<sup>49</sup>

In applying this test, the court held that a computer program developed by an employee at home on his own time, using his own personal computer, and arising out of motivation for his own personal benefit, was not a work made for hire.<sup>50</sup>

While some have argued that students, in their capacity as students, could

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44. The *Aymes* court explained that:

*Reid* established that no one factor was dispositive, but gave no direction concerning how the factors were to be weighed. It does not necessarily follow that because no one factor is dispositive all factors are equally important, or indeed that all factors will have relevance in every case. The factors should not merely be tallied but should be weighed according to their significance in the case.

*Id.* at 861.

45. *Id.* at 863.

46. NIMMER ON COPYRIGHT § 5.03 [B][1][a][iv] (2011).

47. 17 U.S.C. § 101 (2010).

48. *Roeslin v. District of Columbia*, 921 F. Supp. 793 (D.D.C. 1995).

49. RESTATEMENT (SECOND) OF AGENCY § 228 (1958).

50. *Roeslin*, 921 F. Supp. at 798–99.

never be considered “employees” of the university such that their copyrightable works would fall under the work for hire doctrine,<sup>51</sup> others have presented the issue whether a “use” of university resources could be “substantial” enough to bring the student’s copyrightable work within the bounds of the work for hire doctrine.<sup>52</sup> Although the trend may be for universities to require students to assign the rights to all intellectual property created during their academic careers to the university, these policies do not carry with them the force of law.<sup>53</sup> Therefore, such assignments may be invalid if the student can demonstrate that the work was created outside of a work-for-hire relationship with the university.<sup>54</sup> Such situations, along with several different scenarios, will be explored further in Part IV.

In the realm of copyrightable works produced in the university setting, the work for hire doctrine is the primary means for regulating the allocation of intellectual property rights between the university and *employee* researchers.<sup>55</sup> One of the challenges with respect to allocating intellectual property rights between universities and undergraduates lies within determining whether the student who pays tuition can ever be defined as an “employee” of the university in various situations to be discussed in Part IV; and even if the student is an employee, the challenge may still remain in determining whether the student employee was working within the scope of the duties for which the student was hired.

With respect to non-student university researchers, Nordheden & Hoeflich have explained that: “In all of these various scenarios, [] there is in common the fact that the researchers are paid by the institution to do the research which may lead to a valuable discovery, and, therefore, an employee-employer or independent contractor-purchaser of services relationship exists at law.”<sup>56</sup> In fact, universities often hire professors with the expectation that they will conduct research and publish works in their field of interest.<sup>57</sup> The phrase “publish or perish” is, for many faculty members, a reality as publications have become an important factor in determining tenure and promotion.<sup>58</sup>

Graduate students in the applied sciences are typically employed as

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51. HERRINGTON, *supra* note 31, at 38–39; Patel, *supra* note 7, at 502; Todd, *supra* note 16, at 328.

52. McCutcheon, *supra* note 8; Luppino, *supra* note 1, at 383, 414.

53. HERRINGTON, *supra* note 31, at 39.

54. *Id.*

55. Nordheden & Hoeflich, *supra* note 12, at 34.

56. *Id.*

57. Patel, *supra* note 7, at 500.

58. *Id.*

research assistants and/or receive stipends as a condition of performing research.<sup>59</sup> Accordingly, the law has also treated such graduate students as employees. In contrast, with the exception of paid undergraduate researchers, most undergraduates are not employed by the universities at which they perform research or engage in creative projects.<sup>60</sup> Rather, these students are customers who pay tuition to the university.<sup>61</sup> In the context of undergraduate education, where the line between students as paying customers and students as employees providing research or creative innovation may become blurred, it is essential for all parties to understand their ownership rights in order to avoid not only confusion but also litigation.<sup>62</sup> Given the potential for uncertainty, the applicability of the work for hire doctrine may depend on how the university defines the student-university relationship; and, if the work for hire doctrine under the Copyright Act does not apply, the allocation of intellectual property rights may depend upon whether the student has a contractual agreement with the university governed by internal university policy.

#### *D. Assignment of Copyright Ownership and Student Contracts*

Because of the employer-employee relationship between universities and faculty members, and because, as alluded to above, universities increasingly expect faculty to publish in their areas of interest as part of their promotion and employment conditions, it is not difficult to see how faculty works can be deemed “works for hire.” However, there are situations in which faculty work may not fall within the realm of the work for hire doctrine.<sup>63</sup> In these instances, universities may nevertheless require faculty to assign all copyrightable works created during their employment to the university.<sup>64</sup> As Patel explains, these requirements may take the form of a contract clause similar to preinvention assignment agreements which are consistently enforced by the courts.<sup>65</sup> Moreover, the Federal Circuit has held that even in the absence of a signed contract expressly assigning inventions to the university, a researcher may nevertheless be obligated to assign those

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59. Nordheden & Hoeflich, *supra* note 12, at 35.

60. *Id.* at 36.

61. *Id.*

62. HERRINGTON, *supra* note 31, at 41.

63. Patel, *supra* note 7, at 501. Moreover, in *Weinstein v. University of Illinois*, the Seventh Circuit recognized a long-standing tradition in permitting professors to retain copyright in their scholarly writings. 811 F.2d 1091, 1094 (7th Cir. 1987).

64. Patel, *supra* note 7, at 501.

65. *Id.*

inventions to the university.<sup>66</sup>

This begs the question of whether students could be required to contractually assign all copyrights to the university and whether such contractual provisions would be enforced. In general, most undergraduates are not paid employees of their universities.<sup>67</sup> Rather, they pay tuition in exchange for the opportunity to perform research for academic credit.<sup>68</sup> Where students are not employees of the university, and therefore, do not fall under the work for hire doctrine, universities may require undergraduates to sign contractual agreements delineating the allocation of intellectual property rights.<sup>69</sup> One of the main concerns regarding the use of contractual agreements is whether the university is able to provide adequate consideration for such contracts when the undergraduate is neither employed by the institution nor receives compensation for performing research.<sup>70</sup> As Nordheden & Hoeflich explain, adequate consideration may be provided either by employing the undergraduate as a research assistant with compensation or by requiring the student to sign such contracts as a prerequisite for entry into the laboratory.<sup>71</sup> Under the first option, there is an inherent fiscal challenge of providing compensation sufficient to rise to the level of adequate consideration.<sup>72</sup>

The alternative option of requiring students to assign all of their intellectual property rights to the university as a precondition for performing research presents its own unique set of challenges.<sup>73</sup> As mentioned above, institutions often require professors and graduate students to sign, and courts consistently uphold, preinvention assignment agreements as a condition of employment.<sup>74</sup> However, most graduate students receive compensation in the form of stipends, and faculty members not only receive compensation, but are also typically in a better position to bargain with their university. By contrast, the undergraduate student who is not employed by her university may present a number of contract issues including adequacy of consideration and freedom of contract. In situations where undergraduate students lacking bargaining

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66. *Chou v. University of Chicago*, 254 F.3d 1347, 1357 (Fed. Cir. 2001).

67. Nordheden & Hoeflich, *supra* note 12, at 37.

68. *Id.*

69. *Id.* at 38.

70. *Id.*

71. *Id.*

72. *Id.*

73. *Id.*

74. Patel, *supra* note 7, at 501; Sean B. Seymore, *My Patent, Your Patent, or Our Patent? Invention Disputes within Academic Research Groups*, 16 ALB. L.J. SCI. & TECH. 125, 137 (2006).

power are required to sign contractual agreements assigning all of their intellectual property rights to the university, such agreements may be deemed void as containing unenforceable adhesion clauses.<sup>75</sup> Furthermore, such agreements may be seen as “antithetical to the educational mission of the university and highly exploitative of undergraduate labor.”<sup>76</sup>

As another method for retaining rights to undergraduate student work product, Nordheden & Hoeflich offer the suggestion that universities ask students interested in research to make a gratuitous assignment of any intellectual property rights that they might acquire as a result of their efforts.<sup>77</sup> As Nordheden & Hoeflich suggest, this would mitigate the consideration issue.<sup>78</sup> However, given the nature of gratuitous agreements, the university would have to permit students to perform research even if they refused to sign such agreements; otherwise, the agreements would no longer be “gratuitous.”<sup>79</sup>

#### IV. APPLICATION OF LAW AND POLICY TO SCENARIOS IN WHICH UNDERGRADUATES MAY DEVELOP COPYRIGHTABLE WORKS

This section will consider several different scenarios in which undergraduate students may create copyrightable material. These scenarios will elucidate the potential for uncertainty and confusion that may arise as a result of either a general lack of awareness of university intellectual property policies or ambiguities contained within these policies. As one scholar has observed, a set of common themes emerge from university policies that contain student-specific provisions.<sup>80</sup> Luppino summarizes these policies and their themes by explaining that “if the student is an employee performing work for hire or sponsored or commissioned research, or has made significant use of university resources, the university reserves that right to claim ownership in the student’s creation.”<sup>81</sup>

##### A. *Student Employees*

In the context of student employment where the student is hired for the purpose of applying her creative and inventive skills and is receiving adequate compensation (not nominal), there seems to be little if any dispute that the

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75. HERRINGTON, *supra* note 31, at 47; Nordheden & Hoeflich, *supra* note 12, at 39; Patel, *supra* note 7, at 505.

76. Nordheden & Hoeflich, *supra* note 12, at 38.

77. *Id.*

78. *Id.*

79. *Id.*

80. Luppino, *supra* note 1, at 383.

81. *Id.*

university has the ownership claim in the intellectual property created by the student employee. Work product arising under this context would most likely fall under the work for hire doctrine.

However, as alluded to above, even where the student is an employee of the university and has signed a valid contract to that effect, a challenge may still remain in determining whether the student who goes above and beyond the call of her duties was working outside of the scope of the duties for which she was hired. For example, imagine the student who is hired to create a recruitment brochure for an academic department. Beyond this, the student independently and on her own time, away from her workplace, using her own computer writes a letter of introduction to the department and develops recruitment posters and a website featuring the department and the courses it offers. Creating the letter, the posters, and the website would all appear to fall outside of the scope of employment. The facts from this hypothetical situation are similar to those in *Roeslin* in which the court held that a computer program developed by an employee almost entirely at his home, on his own time, using his personal computer, and arising out self-fulfilling motivation, was not a work for hire.<sup>82</sup> By similar reasoning, such student work product would fail to meet the three standards erected under § 228 of the Restatement (Second) of Agency<sup>83</sup> that are used by the courts in determining whether an employee's conduct falls within the scope of employment.<sup>84</sup>

### *B. Students Working for Academic Credit*

As universities have realized the benefits of incorporating undergraduate students into their research programs and as the National Science Foundation (NSF) has provided funding and incentives for universities to involve undergraduate students in research and creative endeavors, many undergraduates interested in gaining such experience may find themselves in this category.<sup>85</sup> In some instances, students are hired for summer research experience in areas of research funded by the NSF, and are paid a stipend under the Research Experiences for Undergraduates (REU) program.<sup>86</sup> In other instances, these students are paying tuition, and hence are not employees of the university. However, in exchange for the research experience, they are receiving academic credit. In these situations, the work for hire doctrine will

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82. *Roeslin v. District of Columbia*, 921 F. Supp. 793, 798–99 (D.D.C. 1995).

83. See RESTATEMENT (SECOND) OF AGENCY § 228 (1958).

84. NIMMER ON COPYRIGHT, *supra* note 46, at § 5.03[B][1][b][i].

85. Nordheden & Hoeflich, *supra* note 12, at 35–36.

86. See RESEARCH EXPERIENCE FOR UNDERGRADUATES [http://www.nsf.gov/funding/pgm\\_summ.jsp?pims\\_id=5517&from=fund](http://www.nsf.gov/funding/pgm_summ.jsp?pims_id=5517&from=fund) (last visited Feb. 16, 2013) for general information on the Research Experiences for Undergraduates program.

be of little help in determining the allocation of intellectual property rights.<sup>87</sup> Instead, the contractual arrangements established upon entering a sponsored research program or other agreements will be the instruments that will provide guidance regarding ownership of copyrights.

As described earlier in Part III-D, such arrangements may pose challenging contract issues regarding adequate consideration, particularly when one considers the fact that the student is paying tuition to the university in exchange for the privilege of undertaking research.<sup>88</sup> Because internal university intellectual property policies do not carry with them the force of law, disputes over ownership of copyrights may come down to an analysis of the work for hire doctrine after all. In which case, courts will likely undertake an analysis of the relevant agency law factors identified by the Supreme Court in *C.C.N.V.*<sup>89</sup> in order to determine whether the student could be characterized as an “employee.” As the *Aymes* court noted, several of the factors will almost always be significant;<sup>90</sup> however, others have cautioned that no single factor or set of factors is likely to be determinative in every case.<sup>91</sup> Nevertheless, whether the student was receiving payment (*i.e.*, the method of payment),<sup>92</sup> may be the key factor to consider in the university context when determining whether a student qualifies as an employee.<sup>93</sup>

Another *C.C.N.V.* factor that may potentially play an important role in determining whether an institution can assert ownership rights over copyrightable student work product is whether the student made a certain level of “use” of the institution’s resources. As Luppino has observed, the level of use is often vaguely and inconsistently defined from institution to

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87. Nordheden & Hoeflich, *supra* note 12, at 36.

88. *Id.* at 38.

89. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 751 (1989).

90. *Aymes v. Bonelli*, 980 F.2d 857, 862 (2d Cir. 1992).

91. NIMMER ON COPYRIGHT, *supra* note 46, at § 5.03[B][1][a][iv].

92. For example, was the payment method that of an hourly or salaried employee? If so, this would favor a classification of the student as an employee. On the other hand, if the student was paid on a per-project basis, this may favor a finding the student to be an independent contractor rather than an employee. Moreover, a consideration of several of the institutional policies available, suggests that financial aid and scholarships would not suffice to characterize the student as an employee. *See, e.g., infra* note 95.

93. The Marquette University Intellectual Property Policy, Pt. XI provides: “Marquette University students are subject to this Policy when, working for *pay* or for *academic credit*, they participate in faculty research programs. A student working for *pay* for the University or for a third party under a Sponsored Research Agreement is an *employee* within the meaning of this policy.” *Marquette University Intellectual Property Policy*, (1999) <http://www.marquette.edu/orsp/documents/IntellectualPropertyPolicy.pdf>. (emphasis added). This policy lends support to the notion that payment may be the key factor in determining whether a student is an “employee.”

institution.<sup>94</sup> While some institutions further define the level of use set forth in their policies,<sup>95</sup> others appear to have left this factor open for interpretation.<sup>96</sup> Although there appears to be a significant disparity in terms of how an institution may define the level of use, what is clear is that the use of resources (or “source of the instrumentalities and tools”) factor is but one factor in a list of thirteen provided by the Court in *C.C.N.V.*<sup>97</sup> In light of the fact that the courts and others have explained that neither a single factor nor a

94. While some institutions provide that “exceptional,” “significant,” or “substantial” use of resources will suffice, others suggest that any use may be sufficient for an institution to claim ownership rights in the student’s creation. Luppino, *supra* note 1, at 375–76.

95. See, e.g., *Guide to the Ownership, Distribution and Commercial Development of MIT Technology*, § 13.1.2, (2006), <http://web.mit.edu/tlo/www/downloads/pdf/guide.pdf>. In the absence of either sponsored research or other agreement, the issue becomes:

[W]hether or not a significant use was made of MIT funds or facilities . . . Generally, an invention, software, or other copyrightable material, mask work, or tangible research property will not be considered to have been developed using MIT funds or facilities if: . . . only a minimal amount of time has been spent using significant MIT facilities or only insignificant facilities have been utilized (note: use of office, library, machine shop facilities, and of traditional desktop personal computers are examples of facilities and equipment that are not considered significant).

*Id.*; WORCESTER POLYTECHNIC INSTITUTE, INTELLECTUAL PROPERTY POLICY, OWNERSHIP OF INVENTIONS, <http://www.wpi.edu/offices/policies/intell.html> (last visited Feb. 16, 2012) Worcester Polytechnic Institute clarifies “significant use” as follows:

Use of office or classroom space, libraries, or general computational facilities does not constitute significant use of WPI resources. The use of specialized experimental or computational facilities or equipment is not significant if it involves brief periods of time or limited use, e.g., for exploratory tests; otherwise, the use is significant. Use of any WPI facility in a way that leads to an appreciable expenditure of WPI funds, that would not otherwise have occurred, constitutes significant use.

*Id.*; INTELLECTUAL PROPERTY, COPYRIGHT AND RELATED ISSUES AT THE UNIVERSITY OF DENVER, INTELLECTUAL PROPERTY POLICY, Pt. II (D)(4), <http://www.du.edu/intellectualproperty/iprop.html> (last visited Feb. 16, 2012) In determining whether “substantial University assistance” is involved, “the University’s participation in or support of the creative or developmental activity leading to a Work must be material, significant, and beyond the resources normally provided to individual Employees, Staff Members and Students.” This does not include:

[S]tudent financial aid, library resources, office or laboratory facilities, office staff or laboratory support, telecommunications facilities, individual personal computers, and ordinary and reasonable access to the University’s computer network and websites or similar University provided electronic communication tools used for non-commercial scholarly pursuits . . . In the case of students, support or assistance beyond ordinary and reasonable classroom/laboratory resources provided in conjunction with a specific academic program.

*Id.*

96. See, e.g., *Marquette University Intellectual Property Policy*, *supra* note 93, at Pt. XI (“Thus, in circumstances where a student originates Intellectual Property independently, using resources generally available to students, and without faculty supervision, such Intellectual Property is owned by the student.”).

97. See *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 751 (1989).

set of factors will likely be dispositive,<sup>98</sup> institutions may not be able to claim ownership rights to student work product on the basis of the student's use of resources alone. Moreover, it seems unethically paradoxical for an institution to claim ownership rights over student work product where the student pays tuition to the institution. Therefore, institutions should not only clarify what is meant by "substantial," "significant," "reasonable," or "general" use, but they should perhaps also consider defining a number of the other factors including the extent of supervision exercised over the student.

### C. *Students as Students*

This section contemplates the student who is applying her creative talents to required course projects or may be tinkering but nevertheless creating works with university resources. In general, students acting in their capacity as students retain ownership in their original works of authorship.<sup>99</sup> Although it may be difficult to imagine that a student acting purely as a student could ever be considered an "employee" for purposes of determining the allocation of intellectual property rights, any disputes in this context would likely amount to an analysis of the "substantial use" factor as described in the previous section. Even so, Patel asserts that "unless the student is an employee of the university hired to use her creative or inventive skills, the university should have no ownership claim in the intellectual property created by the student regardless of whether the student used university resources and supplies."<sup>100</sup>

## V. PROPOSAL FOR ACTION

As the spirit of academic entrepreneurship has swept through many universities in the post-Bayh-Dole era, the traditional spirit of academic freedom and the ideal of dissemination of knowledge appear to be compromised. The natural extension of the Bayh-Dole Act has been for universities to also attempt to sweep copyrightable works into their realm of ownership with an eye towards financial gain. The content of this paper has

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98. *Aymes v. Bonelli*, 980 F.2d 857, 862 (2d Cir. 1992); NIMMER ON COPYRIGHT, *supra* note 46, at § 5.03 [B][1][a][iv].

99. See, e.g., MINNESOTA STATE COLLEGES & UNIVERSITIES BOARD POLICIES, *supra* note 5; INTELLECTUAL PROPERTY, COPYRIGHT AND RELATED ISSUES AT THE UNIVERSITY OF DENVER, INTELLECTUAL PROPERTY POLICY, *supra* note 95, at Pt. II (D)(3) ("The University acknowledges the right of faculty, staff and students to generate a Work and its associated Intellectual Property in their ordinary daily pursuits to which they have sole ownership."); *Marquette University Intellectual Property Policy*, *supra* note 93, at Pt. XI (B) ("independent student scholars own the Copyrights without limitation or license, to their written theses, essays, dissertations, or other copyrighted works and TRP [Tangible Research Property].").

100. Patel, *supra* note 7, at 506.

demonstrated that universities as a whole have been inconsistent in formulating their policies for copyright ownership. This is due, in part, to there being no uniform guidelines, leaving universities to develop these policies in a vacuum.

Perhaps a legislative act encompassing consistent and systematic guidelines regarding the allocation of intellectual property rights would clarify the ambiguities and lack of foresight regarding not only the ownership of patents, but the natural extension to copyrightable works. This would allow the legislative branch to iron out some of the wrinkles of copyright ownership and the work for hire doctrine rather than handing the ironing board to the judiciary. If legislative action is not feasible, then universities, at minimum, should seek to inform students as early as possible of their intellectual property policies, and supervisors and faculty should educate their students as to their rights. On the other hand, informing students that they may not maintain ownership in their own works may hamper their enthusiasm for developing works that reach their full creative potential. Hence, if the true mission of a university involves education of the next generation, universities may want to moderate their desire for retaining copyrights in favor of helping students realize their full creative potential.

## VI. CONCLUSION

While others who have published their research and opinions in this area have advocated for universities to clarify their policies and/or make them more evident to faculty and students,<sup>101</sup> I would take this yet one step further, and argue that uniform regulations could go a long way toward clarifying the allocation of intellectual property rights in student work product in the university setting. The issues creating uncertainty, ignorance, and ambiguity should be addressed in rules of general applicability, such that universities should have less discretion. University policies seem to be as varied as there are universities, and, often times, these policies may not even be written by intellectual property attorneys. As the examples discussed in the introduction indicated, work product generated by undergraduate students can be tremendously remunerative and beneficial to society. Ownership issues surrounding copyrights in the university setting can be significant to the student creator who, without understanding, may unforeseeably lose ownership of a personal creation to the university to which the student, somewhat paradoxically, pays tuition. Viewing this from the perspective of an undergraduate student leads me to conclude that some institutional policies

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101. See, e.g., Luppino, *supra* note 1, at 417; McCutcheon, *supra* note 8; Nordheden & Hoeflich, *supra* note 12, at 38; Patel, *supra* note 7, at 498; Perez-Kudzma, *supra* note 3, at 499.

are flawed, and our nation's laws should be changed to promote understanding and clarity. In so doing, the purpose of copyright law—to promote creativity—can be realized. In order to assure that the general public can enjoy the fruits of their labor, our nation's laws should reflect a uniform intent to protect undergraduate creators' rights.

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