

OPENING THE DOOR : HOW FACULTY AUTHORS CAN IMPLEMENT AN OPEN ACCESS POLICY AT THEIR INSTITUTIONS

BY SIMON J. FRANKEL AND SHANNON M. NESTOR¹



This work is licensed under the Creative Commons Attribution Unported 3.0 (CC-BY 3.0), available at <http://creativecommons.org/licenses/by/3.0/>

¹ Mr. Frankel is a litigation partner in the San Francisco office of Covington & Burling LLP, where his practice focus on copyright and trademark litigation and counseling, technology and licensing disputes, and legal issues related to visual art. Ms. Nestor is a litigation associate at Covington & Burling LLP in Washington, D.C. Her intellectual property practice focuses on patent, trademark, copyright, antitrust, and Internet-related matters. The views expressed here are solely those of Mr. Frankel and Ms. Nestor, and do not reflect the views of Covington & Burling LLP or any of its clients. This document is not legal advice, and this document does not create any attorney-client relationship.

This White Paper is intended as a companion to the “Open Door and Open Minds” SPARC/Science Commons White Paper of April 2008.² The purpose of this companion paper is to provide the legal and statutory bases for implementation of an open access policy, as well as to explain best practices for implementation of that policy. It is intended to be used by faculty and administrators interested in implementing an open access policy at their own educational institutions.

I. INTRODUCTION

As the first decade of this new millennium has come to a close, the Internet continues to foster an explosive distribution of ideas and expression and to facilitate the exchange of scholarly works. Nearly all of this distribution and exchange is free. At the same time, however, the costs of scholarly journal subscriptions have continued to rise. As a consequence, educational institutions have been forced to discontinue subscriptions to these journals, resulting in a loss of access to scholarly work and a disruption to the free flow of ideas within the academic community. The academic community has expressed a growing desire for an *open access* program that would address these problems.

In response to these desires, some institutions have taken the step of creating digital depositories for their instructors’ works. While faculty members have been generally open to contributing their works to such digital depositories, this was somewhat in tension with academics historical practice of taking steps to retain rights in their scholarly works in negotiations with publishers. While both faculty and their institutions had been working to achieve the goals of an open access system, these actions had, for the most part, not been made in a concerted effort. In addition, a standard open access policy for all institutions to use had not emerged until the past two years or so.

In February 2008, the Faculty of Arts and Sciences at Harvard voted to implement an open access policy. The policy relied on a two-step process: (1) creating a nonexclusive licensing program whereby all faculty granted a nonexclusive license in their scholarly works to the university so that those works could be (2) placed into a digital depository, created by the institution, that would be publicly available via the Internet for any noncommercial use. Following the success of Harvard’s program, and on the heels of similar efforts by the National Institutes of Health (“NIH”), in March 2009 the entire faculty of the Massachusetts Institute of Technology (“MIT”) voted unanimously to adopt an open access policy that is practically identical to the one adopted by Harvard.

² Available for free download at <http://sciencecommons.org/wp-content/uploads/opendoors_v1.pdf>.

By their unanimous March 2009 vote, MIT's faculty voted to adopt an open access policy that includes the following licensing language:

The Faculty of the Massachusetts Institute of Technology is committed to disseminating the fruits of its research and scholarship as widely as possible. In keeping with that commitment, the Faculty adopts the following policy: Each Faculty member grants to the Massachusetts Institute of Technology *nonexclusive permission* to make available his or her scholarly articles and to exercise the copyright in those articles for the purpose of open dissemination. *In legal terms, each Faculty member grants to MIT a nonexclusive, irrevocable, paid-up, worldwide license to exercise any and all rights under copyright relating to each of his or her scholarly articles, in any medium, provided that the articles are not sold for profit, and to authorize others to do the same.* The policy will apply to all scholarly articles written while the person is a member of the Faculty except for any articles completed before the adoption of this policy and any articles for which the Faculty member entered in an incompatible licensing or assignment agreement before the adoption of this policy. The Provost or Provost's designate will waive application of the policy for a particular article upon written notification by the author, who informs MIT of the reason. (Emphasis added)

In light of both institutions implementing nearly-identical license policies, it appears that a model open access policy has emerged. This paper will focus on the issues presented by the Harvard/MIT policy and will describe how institutions and faculty can go about implementing a similar policy, using the Harvard/MIT policy as a model.³ Standard language in open access policies will undoubtedly have positive network effects. It is easier for all parties—institutions, faculty, and journals—to be familiar with a single one open access policy, rather than having to become familiar with a patchwork of policies. Certainly it will be easier in the future if all interested parties negotiate from the same policy language, thereby having the same expectations for every scholarly work that is available.

Implementing such a policy requires a two-step process. First, of course, the licensing policy must be implemented. Doing so involves three primary steps: (1) identifying whether current policies meet all the requirements for moving forward with an institutional licensing policy; (2) if they do not, identifying the particular changes that would be necessary to achieve those ends; and (3) determining the

³ This paper will address only the United States copyright regime. Given the complexities of intellectual property regimes, readers interested in the application of the issues discussed here outside the United States should review the particular copyright and related laws for appropriate jurisdiction(s).

steps needed to be taken to implement that policy language. Second, after implementation of the licensing portion of the policy, institutions must then create a publicly available, Internet-accessible digital depository. The focus of this paper will be the implementation of an effective licensing policy, with recommendations for next steps.

This paper uses certain terms for convenience and readability. Faculty who write the scholarly works that are the focus of this paper are referred to as “faculty authors” or “authors” so as to parallel the vocabulary used in the Copyright Act and copyright jurisprudence. Scholarly works by such authors are referred to as “articles,” except where to do so would be confusing.⁴ Finally, the universities, colleges, and other non-profit educational institutes would be governed by the same legal rules and are referred to generally as “institutions.”

This paper begins with a review of certain fundamental rules of U.S. copyright law that are necessary to evaluate and implement an appropriate open access policy, then discusses the mechanics of a non-exclusive license, the potential significance of subsequent transfers by faculty authors, potential complications presented by copyright’s “work made for hire doctrine,” and, finally, steps for implementation of an open access policy for faculty at educational institutions.

II. BASICS OF THE U.S. COPYRIGHT REGIME

The U.S. Constitution specifically authorizes Congress to grant copyrights.⁵ The Copyright Act of 1976⁶ is the current framework governing copyright in the U.S., and that federal law preempts any state copyright law regimes.⁷

⁴ This paper does not address non-scholarly works by faculty authors, such as fiction publications, which would be beyond the scope of the open access policies discussed.

⁵ U.S. Const. art. I, § 8, cl. 8 (“The Congress shall have the power to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries . . .”).

⁶ 17 U.S.C § 101 *et seq.*

⁷ See 17 U.S.C. § 301 (Preemption With Respect to Other Laws). Despite federal copyright preemption of state law, there are areas where artistic media and expression are nonetheless governed by state law. General state contract law will often apply to works subject to copyright, and rights of publicity and of performance are subject to state law. See, e.g., *Brown v. Ames*, 201 F.3d 654 (5th Cir. 2002) (claims under state law tort for misappropriation of publicity rights—*i.e.*, names and likenesses—not preempted by federal copyright law); *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977) (right of performance in cannonball act that was videotaped—and thus “fixed” under copyright law—not subject to preemption under prior copyright regime, the Copyright Act of 1909). While there can be considerable uncertainty regarding whether certain state laws will preempted by the Copyright Act, those issues are unlikely to arise in the context of an open access policy for scholarly works.

The U.S. copyright regime grants rights to an author once a particular work is “fixed” in a tangible medium of expression. For our purposes, copyright in an article—and all the rights afforded under that copyright—vests in an author the moment that the article in question has been written down.⁸ However, copyright does not protect ideas or facts, only the *expression* of ideas and facts. Hence, while the words chosen by a faculty author, and in certain cases, the particular arrangement of data, are protected by copyright, the underlying data and scholarly ideas being discussed in the article are not the exclusive property of the faculty author.⁹

U.S. copyright law grants a number of exclusive rights to the author to the author of an article. The author has the exclusive right to copy and distribute the article and to create a “derivative work” based on the article.¹⁰ Under the current regime, a faculty author holds these exclusive rights in its work for the author’s entire life, plus 70 years after that author’s death.¹¹ In the case of joint-authorship, where two or more authors create a single work together, the copyright term is the

⁸ In addition to the requirement that a work be “fixed” in a medium that can be communicated, the work must also include a quantum of originality, or “authorship”, in order to be provided protection. *See* 17 U.S.C. § 102 (Subject Matter of Copyright: In General) (“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”). The originality requirement is not a high bar to meet, and virtually any article by a faculty author would be sufficiently original to qualify.

⁹ *See* 17 U.S.C. § 102(b) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”)

¹⁰ *See* 17 U.S.C § 106 (Exclusive Rights in Copyrighted Works). This statute grants other rights applicable to particular media, such as the right to perform the work publicly and the right to perform the work via digital audio transmission. For present purposes, faculty authors would be most concerned with their exclusive rights in reproduction, distribution, and derivative works. Under Section 101 of the Copyright Act, a “‘derivative work’ is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a ‘derivative work.’” 17 U.S.C. § 101.

¹¹ *See* 17 U.S.C. § 305; Sonny Bono Copyright Term Extension Act, Pub. L. 105-298. These numbers assume that a faculty author holds the copyright directly and that copyright in the article is not held by the faculty’s employer under the “work for hire” doctrine, as discussed in Section V, below. Works created as “works for hire” have a copyright term of 120 years from the year of creation or 95 years from the year of publication, whichever comes first. *See* 17 U.S.C. § 302(c).

life of the last surviving author, plus an additional 70 years.¹² After the author's death, the rights in the copyright are held by the author's estate and control of those rights passes by will or intestate pursuant to state law.¹³

Copyright is divisible, which means that an author can choose to give only certain rights in its article rather than hand over the entire bundle of rights that make up a copyright.¹⁴ This means that an author can, for example, choose to license distribution rights to one person, yet license reproduction rights to another person and derivative rights to yet another person. An author could also divide the copyright by time or by geography, so that the license only allows another party to distribute an article in certain states and only for a certain period of time.

Articles often have "joint" (that is, multiple) authors, especially in the context of scientific scholarship, so issues of multiple authorship will undoubtedly come up in connection with implementing an open access policy. A "joint work" is "a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole."¹⁵ Under Section 201(a) of the Copyright Act the co-authors of a joint work each hold all the rights in an article, whether or not their contributions are equal.¹⁶ Importantly, each author may *independently* grant a nonexclusive license in the work to a third party, absent some contrary agreement between or among the authors.¹⁷ In general, while disputes can and do arise between and among joint authors, the potential complications that may be created by joint authorship are unlikely to

¹² 17 U.S.C. § 302(b).

¹³ See 17 U.S.C. § 201(d)(1).

¹⁴ Copyright rights have been divisible since the passage of the Copyright Act of 1976. See 17 U.S.C. § 201(d) ("Transfer of Ownership"). Under earlier statutes, rights could not be divided and parceled out in such a manner. See M. Nimmer & D. Nimmer, NIMMER ON COPYRIGHT § 10.01 (2009) ("NIMMER").

¹⁵ 17 U.S.C. § 101 (defining "joint work").

¹⁶ 17 U.S.C. § 201(a); see *Community for Creative Nonviolence v. Reid*, 846 F.2d 1485, 1498 (D.C. Cir. 1988) (explaining that joint authors are tenants in common in regards to copyright, and therefore "[i]n the absence of an agreement specifying otherwise, any profits earned are to be divided equally, 'even where it is clear that [the] respective contributions to the joint work are not equal'" (citation omitted), *aff'd*, 490 U.S. 730 (1989)).

¹⁷ NIMMER § 6.10[A]. This proposition, however, does not hold for transfers to foreign jurisdictions, nor does it hold for a transfer of the *entire* copyright in the work to another party, as one joint author cannot transfer the interests of the other joint authors. See *id.* §§ 6.01[D], § 6.11.

impair the effectiveness of the open-access policy discussed here, as such a policy would only contemplate non-exclusive licenses granted by authors of articles.¹⁸

There is a non-trivial concern, however, regarding potential disputes between joint authors that is beyond the scope of this paper. Where one author’s institution has an open-access policy and the other authors’ institutions do not, the open-access author can comply with its institution’s policy, but it is possible that the other authors may not agree.¹⁹

Against this background of copyright fundamentals, we turn to the licensing aspect of the Harvard/MIT model. The key to any successful open access policy is the adoption of a valid and robust licensing program. Therefore, it is imperative that decision makers and institutional champions of these policies insure that the formalities set out in the next section are met.

III. MECHANICS OF A NONEXCLUSIVE LICENSE

Under the U.S. regime, there are two types of copyright licenses, exclusive and nonexclusive. As the name suggest, an “exclusive” license is a complete grant of certain or all the copyright rights held by the author to an exclusive licensee, so that the licensor retains no rights for itself and no right to license the licensed rights to others.²⁰ On the other hand, a nonexclusive license is a grant²¹ of some or all of the copyright rights from the author to one or more licensees. As discussed in Section II

¹⁸ The kinds of disputes between joint authors in this context would be, for example, the order of authors listed on the article, to which publications to submit the article. Moreover, not all of the “authors” that may be listed on the byline of an article contributed a sufficient amount to the article to qualify as an author for copyright purposes. Such issues would not affect the license proposals here.

¹⁹ See NIMMER § 6.01 *et seq.* for a more in-depth discussion of joint-authorship. While peer-reviewed journal articles undoubtedly involve contributions made during the peer review process, those contributions would likely not amount to *de minimis* “authorship” under the joint-work doctrine. See, e.g., *Aalmuhammed v. Lee*, 202 F.3d 1227 (9th Cir. 2000) (consultant on film did not contribute enough to qualify as an author under the joint authorship doctrine because “[s]o many people might qualify as an ‘author’ if the question were limited to whether they made a substantial creative contribution...the person to whom the work owes its origin and who superintended the whole work, the ‘master mind’” is an author).

²⁰ The Copyright Act defines a “transfer of ownership” as “an assignment, mortgage, *exclusive license*, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright . . .” 17 U.S.C. § 101 (emphasis added). The licensee, then, is afforded all of the protections and remedies that a copyright owner has for whatever rights have been transferred to it. 17 U.S.C. § 201(d)(2).

²¹ Nonexclusive licenses are not referred to as “transfers” because a “transfer of rights” is specifically defined in the Copyright Act to not include nonexclusive licenses. See 17 U.S.C. § 101 (defining “transfer of ownership” as “not including a nonexclusive license”).

above, whether making an exclusive or nonexclusive license, an author can choose to license all of its copyright rights, or only a portion of those rights.

Certain formalities must be satisfied to create an exclusive license; in particular, exclusive licenses must be in writing. Nonexclusive licenses can be created quite informally, by oral agreement or even implied by a person's conduct.²² This paper will only address the creation of nonexclusive licenses.²³ Although nonexclusive licenses can be made informally and orally, we suggest that any license policy be done in writing. Maintaining a written record of what particular rights have been licensed, for how long, and in what manner is important not only to make sure that all parties know exactly what they are getting—and giving up—but also for the purposes of maintaining an evidentiary record in the event of disputes (especially disputes involving conflicting transfers, addressed below in Section IV).

Finally, we must be careful to distinguish between a license mandate and a deposit mandate. Whereas a license—whether exclusive or nonexclusive—transfers some amount of rights in the article, a deposit mandate merely allows for (or requires) a physical copy of the article to be given to the institution. Simply handing over a physical copy of an article, or draft of that article, is not sufficient under copyright law to constitute a grant of any rights, as physical possession of an article does not give the owner of that copy any copyright rights in work embodied in the copy.²⁴

Deposit mandates certainly are useful for institutions to retain the knowledge and scholarship of its faculty members. Indeed, some journals already permit institutional depositories. But such permissions do not address the increasing loss of knowledge in the academic community caused by the ever-increasing costs of journal subscriptions and the inability for academic institutions to keep up with shouldering the burden of those costs. The open access policy goes beyond a simple university depository—limited in size, scope, and, most importantly, accessibility—and instead seeks to create a universal depository, with

²² See, e.g., NIMMER § 10.03[A][7] & n. 68 (citing relevant case law).

²³ This paper does not address how to implement an exclusive license policy. Such policies would be difficult to put in place and would necessarily require the institution implementing that policy to police all the scholarly articles of its faculty, creating substantial logistical burdens. Moreover, implementing an exclusive licensing policy could potentially put an institution and its faculty at odds, quickly spawning complicated conflicts that would likely add unnecessary institutional strife.

²⁴ See 17 U.S.C. § 202. That is not to say that physical ownership is worthless. Under the first-sale doctrine, possession affords the owner certain rights, just not the rights under consideration here. For a discussion of the doctrine, see NIMMER § 8.12.

universal scope and accessibility. By combining the nonexclusive license discussed in this paper with a deposit policy, an institution can create open access.

Of course, any licensing program would not be worth the effort if it could be overridden by a subsequent transfer of all the rights that the license attempts to retain. The next section addresses how a nonexclusive can prevail over such a transfer.

IV. WHAT HAPPENS WHEN AN AUTHOR MAKES A SUBSEQUENT TRANSFER OF COPYRIGHT RIGHTS?

As discussed in the White Paper, any license policy must carefully be crafted so that it will prevail over any subsequent, inconsistent transfer of copyright ownership by the author. In other words, any policy adopted by a university runs the risk of being less effective if a publisher can override that policy by requiring authors to make a later transfer of rights that violates the terms of the nonexclusive license.

Even the most robust policy could be diminished in its effectiveness by similarly coordinated efforts of publishers to force or coerce authors to grant contrary transfers of rights. Moreover, it may not be enough to permit authors to opt-out of a nonexclusive license policy because (1) overuse of the opt-out provision could effectively undermine the entire policy, and (2) inconsistent transfers could occur long after the initial opt-in takes place.²⁵

For our purposes, an inconsistent transfer of rights would include any license or assignment of copyright rights that conflicted with any language of the specific nonexclusive license in place. Naturally, any demand for an exclusive license of any of the rights listed in the nonexclusive license proposal would be an inconsistent transfer because exclusivity is at odds with nonexclusive licensing.

A. Nonexclusive licenses can prevail over conflicting transfers of copyright ownership

Luckily, the Copyright Act specifically addresses this issue. Section 205(e) on “Priority Between Conflicting Transfer of Ownership and Nonexclusive License” states that “a nonexclusive license, whether recorded or not, *prevails over a*

²⁵ For example, a university author could comply with an institution’s license policy while contemplating publication of an earlier draft of an article, but then later decide on a final, printed version of an article and deliver it to a publisher that demands an inconsistent, exclusive license or assignment of rights.

conflicting transfer of copyright ownership”²⁶ where the following conditions are met:

- (1) the nonexclusive license is in writing;
- (2) the author or its agent has signed the written license;
- (3) the license was given before the conflicting transfer (i.e., an exclusive licensing agreement with a journal publication) was made; and
- (4) the license was taken in “good faith” before the conflicting transfer was recorded with the Copyright Office and without notice of the conflicting transfer.²⁷

The Harvard/MIT nonexclusive license model does not apply retroactively to articles written and/or published before implementation of the policy, and other institutions are recommended to do the same.

Notably, all four of these requirements can be met using the Harvard/MIT license. As mentioned earlier in Section III, it is highly recommended that any nonexclusive license policy be in writing. It is also recommended that all institutions consider requiring that faculty authors sign that license (though the Harvard/MIT license model does not require this). The other two requirements should also be well-met so long as faculty authors take care to comply with the institution’s license policy before seeking out any publisher. The last requirement of good faith generally should be met, too, assuming that no faculty author engages in any deception, whether intentional or not, with a journal publication that requires an exclusive license agreement.

This good faith requirement is yet another reason why it is recommended to include an opt-out provision like the one included in the Harvard/MIT model. Without such an opt-out provision, faculty authors would, in the face of an implacable journal publisher, be forced either to not publish the article at all, or to choose to falsely represent to the institution that the author was complying with the open access policy and then turning around and agreeing to a conflicting license with a publisher. It would not be “good faith” for a faculty author to agree to a journal publisher’s exclusive or otherwise conflicting license knowing full well that

²⁶ 17 U.S.C. § 205(e) (emphasis added).

²⁷ It also is possible for the nonexclusive license to prevail over a prior transfer under certain conditions, but this paper will not address those conditions. Should an institution wish to apply its nonexclusive license retroactively, it is possible for the subsequent nonexclusive license to prevail over a previous, conflicting transfer. For more details, see NIMMER, § 10.07[B].

such an agreement contravenes the particular open access policy of its institution. To avoid such problems, it is recommended that institutions consider both making its nonexclusive license policy public and requiring that its faculty authors include a copy of the policy in any submission to a publisher.

So far, we have not considered whether an inconsistent transfer is, in effect, a revocation of the earlier nonexclusive license.²⁸ Unluckily, the Copyright Act of 1976 does not squarely address this issue. Assuming that such a conflicting transfer could be characterized as a revocation—or at least creates the potential for a non-trivial dispute—it is therefore strongly recommended that any proposed license policy be irrevocable.²⁹

Finally, as noted above, to avoid any later disputes regarding the license program, faculty authors are recommended to forward along with an article a copy of the respective license agreement to any potential publisher. This puts the publisher on notice of that author’s obligations under its institution’s open access policy. Putting any would-be publishers on notice of these obligations serves both to

²⁸ See NIMMER § 10.07[B] & n 42, which raises the issue of whether the “execution of a subsequent conflicting transfer in itself constitutes an indirect revocation of the nonexclusive license, under the doctrine of *Dickinson v. Dodds*, 2 Ch. D. 463 (1875).” The authors are not aware of any present case law addressing this exact point, but it is a non-trivial issue requiring attention when implementing a license policy that will withstand criticism or attack. While it is unlikely that a faculty author would revoke his or her nonexclusive license to the institution (assuming that the author has an opt-out option available through the institution’s licensing policy), institutions should be careful to insulate their open access policies from any collective attack by publishers.

²⁹ It may not be sufficient, however, simply to characterize an open access policy as “irrevocable,” as saying it is does not necessarily make it so. Generally, in order for a nonexclusive license to be irrevocable, it must include consideration. Born from contract law, consideration is often understood as some kind of payment in exchange for some thing. It is not a difficult requirement to satisfy, and, although it often is, it does not have to be monetary.

While the bar for consideration is generally low, it still requires an additional right to be added to the relationship in exchange for the transfer of rights. In that professors are already compensated by the university, college, or academic institution, their salary and position might not be deemed “consideration” for this transfer as it is not an extra element, depending on the employment agreements in place. For example, “[i]llusory promises—awards, bonuses, and career advancement, none of which were actually received—have been held inadequate consideration in this context.” NIMMER § 10.02[C] (noting *Carson v. Dynegy, Inc.*, 344 F.3d 446, 452 (5th Cir. 2003)).

What could qualify as consideration, however, is conditioning *future* employment on agreeing to the terms of the open access policy itself. In adding the policy, implementers should review the current employment agreements of tenured, non-tenured, and temporary faculty members, as well as the review the obligations imposed on each class of faculty via the vote on implementing the open access policy so as to ensure that that vote fulfills the consideration requirement.

avoid any unwelcome surprises for the publisher during the publication process, as well as any disputes down the road involving claims that the publisher was unaware of the open access policy. Moreover, should there be any problems, the author and publisher would then be able to address them earlier on in the process and the author could, if need be, resort to the opt-out option under the Harvard/MIT model.³⁰ This issue also highlights the need for an opt-out option in any license adopted by an institution. In that way, faculty authors who are confronted with a publisher requiring an exclusive license will not be forced to choose between complying with an employer's licensing policy and the license requirements of a journal publisher.

We next address the relationship between the institution and its employee, the faculty author. For reasons that will be discussed below, this relationship is unique in the context of copyright law.

V. COMPLICATIONS PRESENTED BY THE "WORK MADE FOR HIRE" DOCTRINE

Faculty authors traditionally have asserted ownership in the copyright of their scholarly work. Nevertheless, faculty authors are employees of their institutions, and usually, that relationship has consequences for copyright ownership of certain works. Under the U.S. copyright regime, a work created by an employee for its employer may, if particular conditions are met, be considered a "work made for hire."³¹ If an article is considered a work made for hire, the copyright rights in that article vest initially in the employer (in this case, the institution employing the faculty author) and not the employee (the faculty author).³²

³⁰ Notice would also serve to diminish any later attempt to claim that a subsequent transfer was a revocation of the nonexclusive license. A publisher would have difficulty claiming that it demanded an exclusive license in good faith from a faculty author when the publisher had already been put on notice of that author's obligations under the respective institution's policy.

³¹ 17 U.S.C. § 101(1) defines a "work made for hire" as "a work prepared by an employee within the scope of his or her employment" or as "a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire." Subsection (2) of the definition for a work made for hire only applies in particular circumstances generally not relevant here.

³² In many ways, our task would be much easier if all of these scholarly articles were considered works made for hire; however the short-term efficiencies would be outweighed by the burdens inherent in such a system. While declaring all faculty work to be works made for hire would shorten our inquiry by (continued...)

Historically, faculty authors generally were not considered employees under the work made for hire doctrine.³³ While that assumption has persisted throughout changes to the Copyright Act, it is not a belief held by all.³⁴ Further complicating the issue is the separate and disparate treatment of instructors on issues regarding class notes and materials (“inside the school” materials) versus scholarly articles and other publications (“outside the school” materials). And, although commentators have suggested that the faculty exception to the work made for hire doctrine no longer exists, that conclusion is by no means widely accepted.³⁵

Where an institution has either declared through employment contracts or otherwise that it owns all copyright rights of its faculty authors as works made for hire, that particular institution must take steps to ensure that its policies are sound. Simply stating that an article is a work made for hire does not make it so—whatever label is given to an article in an institution’s policies or employment contracts cannot transform an article into a work for hire.³⁶ The article must therefore qualify as a work made for hire on its own. If it does not, then the

obviating the need for an open access proposal—it would invite as many, or more, problems than it solves.

Should an institution choose, for whatever reasons, to pursue a work made for hire model, it could do so. In such cases, the university would need to ensure that employment contracts make that stance clear. For new employees, that would not be a problem. For established faculty employees, however, an institution would need to review the respective employment agreements and determine whether changes need to be made.

Finally, as briefly mentioned in footnote 31, *supra*, copyright law also permits specially commissioned works to be considered works made for hire. Arguably, some of the listed items might qualify here, such as compilations, instructional texts, and tests and answer materials for test, but given the confines of this paper, we will not be addressing these highly fact-specific instances. For more insight into specially commissioned works made for hire, see NIMMER, § 5.03[B][2][a][i] and accompanying notes.

³³ See, e.g., *Weinstein v. University of Illinois*, 811 F.2d 1091, 1094 (7th Cir. 1987) (describing professors keeping copyright in their scholarly articles as an “academic tradition since copyright law began”); also *Hays v. Sony Corp. of Am.*, 847 F.2d 412, 416-17 (7th Cir. 1988) (“[u]ntil 1976 . . . some courts had adopted a ‘teacher exception’ whereby academic writing was presumed not to be work made for hire . . . we might, if forced to decide the issue, conclude that the exception had survived the enactment of the 1976 Act”).

³⁴ See, e.g., Dreyfuss, *The Creative Employee and the Copyright Act of 1976*, 54 U. CHI. L. REV. 590 (1987). Congress’ treatment of the doctrine—or to be more precise, lack thereof—further complicates the issue. See, e.g., *Hays*, 847 F.2d at 416 (“there is no discussion of the issue [work made for hire doctrine] in the legislative history” of the passage of the Copyright Act of 1976).

³⁵ Indeed, if it was well-settled that the exception had been removed by the Copyright Act of 1976, then this entire licensing policy would be, for the most part, unnecessary.

³⁶ See NIMMER, § 5.03{B}[1][b][ii] (The Effect of Agreement as to Scope of Works).

institution is merely an assignee of the rights in the work, therefore possessing different rights vis-à-vis renewal and termination rights.³⁷ More important, the faculty author in that case would be the copyright owner, and not the particular institution. Given the non-trivial likelihood for disputes involving these issues, institutions relying on the work made for hire doctrine should review their policies carefully.

Unfortunately, as discussed above, the relevant copyright statutes do not address whether faculty articles are works made for hire. Judicial decisions in this area are few and far between, and are often of a highly fact-specific nature. The paucity of case law, however, does not necessarily mean that there is confusion or uncertainty in the area. In fact, the lack of case law in the area has been characterized as a result of the fact that most people take it for granted that faculty authors' articles are *not* works for hire.³⁸ Nevertheless, to avoid any potential problems involving the doctrine, policy implementers should carefully review the respective institution's employment agreements for all of its instructors—tenured, nontenured, and temporary.

For the purposes of this paper and the Harvard/MIT model, and unless there are institutional policies to the contrary, institutions should assume that all scholarly articles written by faculty authors are not captured by the work made for hire doctrine, and therefore the copyright rights in those articles remain in the hands and control of the faculty authors.³⁹ Therefore, under this model, faculty

³⁷ Renewal and termination rights are beyond the scope of this companion paper and are not germane to the discussion here.

³⁸ *Hays*, 847 F.2d at 416 (“The authority for this conclusion was in fact scanty...but it was scanty not because the merit of the exception was doubted, but because, *on the contrary, virtually no one questioned that the academic author was entitled to copyright his writings.*”) (emphasis added).

³⁹ Admittedly, many problems presented by the work made for hire doctrine, as well as inequities in bargaining with publishers and the expenditure of resources by authors who may not be familiar with copyright law and its complexities, would be eliminated by universities claiming copyright in all of its faculty-published works. Although temporarily expeditious, that position would complicate any later works by the same instructor at a new university, not to mention the reactions of faculty to such a policy change.

It is doubtful that any proposed policy could be adapted if it required professors, who previously had not been required to do so, to relinquish all their rights in their scholarly work. *See, e.g., Hays*, 847 F.2d at 416 (“To a literalist of statutory interpretation, the conclusion that the [Copyright] Act abolished the exception [from the work for hire doctrine] may seem inescapable. . . . But considering the havoc that such a conclusion would wreak in the settled practices of academic institutions...”).

As discussed above, if such articles were instead found to be works made for hire, and the copyright rights in them automatically vested with the faculty author's employer-institution, then there would be no need for adoption of an open access policy.

must be involved in the process of implementing the open access policy, as they control the copyrights in the scholarly articles that are the subject of the licensing component of the policy.

VI. IMPLEMENTATION

A. What to include in any open access policy

What terms, then, are necessary for a university open access policy to be successful, and what terms are negotiable? As discussed above, it is recommended that institutions adopt language similar to that adopted by the faculty at Harvard and MIT. Below is a discussion of (a) the specific language needed for an effective licensing program; (b) the steps for implementing a publicly accessible digital depository; and (c) the steps for going forward with an open access program.

1. The five criteria for an effective license

For the licensing portion of an open-access policy, it is recommended that an institution adopt a license, *in writing and signed by each faculty author*, that contains the following five criteria: (1) nonexclusive, (2) irrevocable, (3) worldwide, (4) perpetual, and (5) non-commercial.

It is also recommended that any policy have an *opt-in as a default*, so as to avoid compliance problems. Conversely, and for the same reason, an *opt-out provision* should also be included. Unsurprisingly, it is imperative that any license policy be noncommercial, given the goals of academic freedom and free exchange of ideas underpinning the open access policy.

As discussed above in Section III, it is highly recommended that faculty authors include a notice or addendum to any journal submission, notifying that journal of the particular open access policy at the respective faculty author's institution.

Finally, any policy should require that the faculty author deposit with its institution the article in its "final form." This "final form" requirement refers to depositing a copy of the final, published work. For copyright purposes, an author retains rights in all drafts of the article, as well as the final work. The faculty author cannot be forced to split those rights between the drafts and the "final form" as the drafts and published article are, presumably, sufficiently substantially similar under copyright law. Therefore, any unauthorized use of rights in the final, published article would, effectively, be similar to an unauthorized use of rights in any of the drafts. Publishers, therefore, cannot circumvent the Harvard/MIT policy by accepting a "publication form" of an article via an agreement that violates the open access policy while allowing the faculty author to grant a nonexclusive license to its institution in the draft form of the article.

2. Adopting a license for the publicly-available depository

Just as a license is needed for the incoming articles from faculty, a license policy is also needed for the outgoing public use of the article depository. Internal champions and institutional coordinators will need to review their specific needs and determine the parameters of the licensing program for its depository. In order to operate this publicly available, Internet-accessible depository, an institution will also have to decide what rights should be granted to those public users. Readers searching for language for this depository license may consider one of the Creative Commons' licenses (such as attribution, no-derivatives, non-commercial and/or share-alike).⁴⁰ Finally, institutions will need to decide the electronic format that works best for their depository—both an incoming format for articles from faculty authors, as well as an outgoing format for the online database and outgoing use by the public.

3. Future steps

After implementing both the nonexclusive license for faculty authors' works and the outgoing license for public use of those works, institutions will need to continue to assess the efficacy of their particular program. MIT's program provides for a review after five years by the university's Faculty Policy Committee. Institutions adopting the Harvard/MIT model are recommended to make a similar review of their policies for accessibility, effectiveness, and compliance.

⁴⁰ The text of these licenses are publicly available at <<http://creativecommons.org/about/licenses>>.

Appendix A

(MIT)

AMENDMENT TO PUBLICATION AGREEMENT

1. This Amendment hereby modifies the attached Publication Agreement concerning the following Article:

(manuscript title)

(journal name)

2. The parties to the Publication Agreement and to this Amendment are:

_____ (the "Author") and

_____ (the "Publisher").

3. The parties agree that wherever there is any conflict between this Amendment and the Publication Agreement, the provisions of this Amendment are paramount and the Publication Agreement shall be construed accordingly.
4. All terms and conditions of the Publication Agreement, including but not limited to all transfers, licenses, grants, agreements, representations, and warranties, are subject to and qualified by an irrevocable, non-exclusive license previously granted by the Author to the Massachusetts Institute of Technology ("MIT"). Under that license, MIT may make the Article available, and may exercise any and all rights under copyright relating thereto, in any medium, provided that the Article is not sold for a profit, and may authorize others to do the same. Neither the existence of the license to MIT nor MIT's exercise of rights under that license will be deemed to violate any representation or warranty by the Author to the Publisher or to breach the Publication Agreement.
5. Notwithstanding any terms in the Publication Agreement to the contrary and in addition to the rights retained by the Author or licensed by the Publisher to the Author in the Publication Agreement and any fair use rights of the Author, the Author and the Publisher agree that the Author shall also retain the following rights:
 - a. To provide, or to allow the Author's employing institution to provide, an electronic version of the final manuscript of the Article, including all modifications from the peer review process and all graphics and supplemental materials associated with the manuscript (hereinafter the "peer-reviewed manuscript"), to the National Library of Medicine's PubMed Central database ("PMC") at the time the Article is accepted for publication.
 - b. To authorize, or to allow the Author's employing institution to authorize, the National Institutes of Health ("NIH") to make a copy of the peer-reviewed manuscript of the Article available for public access in PMC, in any medium chosen by NIH, no later than 12 months after the official date of publication.

COVINGTON & BURLING LLP

- c. To take any additional steps reasonably necessary to comply with NIH's Revised Policy on Enhancing Public Access to Archived Publications Resulting from NIH-Funded Research (<http://grants.nih.gov/grants/guide/notice-files/NOT-OD-08-033.html>).
 - d. To use, reproduce, distribute, create derivative works including update, perform, and display publicly, the Article in electronic, digital, or print form in connection with the Author's teaching, conference presentations, lectures, other scholarly works, and for all of Author's academic and professional activities.
 - e. To make, or to authorize others to make, the Article available in digital form over the Internet, including but not limited to a website under the control of the Author or the Author's employer or through any digital repository, such as MIT's DSpace.
6. **Final Agreement.** This Amendment and the Publication Agreement, taken together, constitute the final agreement between the Author and the Publisher with respect to the publication of the Article and allocation of rights under copyright in the Article. Any modification of or additions to the terms of this Amendment or to the Publication Agreement must be in writing and executed by both Publisher and Author in order to be effective.

AUTHOR		PUBLISHER
(corresponding author on behalf of all authors)		
Date		Date

MIT Authors:

Please email to amend-cip@mit.edu or fax a copy of the agreement to 617-253-8894