Who Owns Online Curriculum and Content? A Primer on Intellectual Property

Jon Garon
NKU Law and Informatics Institute

Follow this and additional works at: https://thekeep.eiu.edu/jcba

Part of the Higher Education Commons, and the Labor Relations Commons

Recommended Citation
DOI: https://doi.org/10.58188/1941-8043.1330
Available at: https://thekeep.eiu.edu/jcba/vol0/iss9/17

This Proceedings Material is brought to you for free and open access by the Journals at The Keep. It has been accepted for inclusion in Journal of Collective Bargaining in the Academy by an authorized editor of The Keep. For more information, please contact tabruns@eiu.edu.
Who Owns On-Line Curriculum and Content?
A Primer on Intellectual Property (CLE Credit)
Monday, April 7, 2014: 2:00 – 3:30 PM

Description:
The ownership of copyrights in a faculty member’s copyrighted works has been a source of
tension between labor and management for many years, affecting content created for the
classroom, for scholarship, and for creative endeavors. Ownership of on-line learning content
adds to these tensions and presents a number of important labor-management and pedagogical
issues. The legal default rules of copyright provide the starting point for negotiations between
labor and management. This panel will explore whether the institution or the faculty member
owns the intellectual property associated with on-line learning, course content, and other works.
In addition, it will present practical labor-management approaches to resolving intellectual
property disputes.

Panelists:

Deborah Cooperstein, Chapter President, American Association of University Professors,
Adelphi University. Dr. Cooperstein is a Professor of Biology with a specialization in
biochemistry and cell biology. As president of the Adelphi AAUP chapter, she has negotiated
contracts that include on-line education and intellectual property language.

Professor Jon M. Garon, Director, NKU Law + Informatics Institute. Professor Garon has
taught and written extensively on copyright issues as they relate to traditional media, education,
emerging industries, and new technologies. He is an attorney and professor of informatics,
éntertainment, intellectual property, and business law. His teaching and scholarship often focus
on business innovation and structural change to media, education and content-based industries.

Jim Gilkeson, Associate Professor, Finance, Chief Negotiator, United Faculty of Florida
(UFF/AFT/NEA-UCF), University of Central Florida. Jim has served as chief contract negotiator
for UFF-UCF for the last 10 years, representing a unit of approximately 1,400 faculty members.

Dr. Richard Novak, Vice President for Continuing Studies and Distance Education, has been
engaged with distance education at Rutgers for over 15 years. He leads Rutgers Online, Rutgers’
home for fully online degree programs, and regularly teaches fully online courses for the
Graduate School of Education. He also directs teams that assist faculty and students with
pedagogical and technical issues in online learning.

Dr. Karen R. Stubaus holds the position of Vice President for Academic Affairs and
Administration at Rutgers. In addition to other academic and management responsibilities, she
oversees academic labor relations with respect to tenured and tenure-track faculty, non-tenure
track faculty, adjuncts, postdocs, teaching and graduate assistants, and medical interns and
residents, including negotiating and implementing all labor agreements in these areas as well as
handling related grievances and litigation. She holds a Ph.D. in American History and teaches
from time to time in the Departments of American Studies and Women’s and Gender Studies.
Background Materials:

Jon Garon, *The Electronic Jungle: the Application of Intellectual Property Law to Distance Education*, 4 *VAND. J. ENT. L. & PRAc.*, 146 (Spring 2002) [excerpt]

Kenneth D. Crews, Work for hire case summaries, Columbia University (2009)


---

**Teacher's Exception to the Work-for-Hire Doctrine**

In addition to the issue of employment status, a second question to be answered is whether the materials have been prepared in the scope of the person's employment.\(^1\) This issue has generated significant consternation among faculty members who fear encroachment into their autonomy in scholarship and having to share revenue generated from projects that may create commercially viable products.\(^2\)

For class assignments that are part of a full-time faculty member's normal teaching schedule, both criteria embodied in the 1976 Copyright Act are typically going to be met. The employment status satisfies the first element of the test, and the nature and purpose for which the teaching materials are prepared supports the second element that the work be prepared in the scope of employment.\(^3\) Few educational cases have analyzed this issue. Typically, however, even if the instructor has not been directly supervised by the school, classroom materials and testing materials are used directly for the benefit of the institution’s students. In looking at the copyright ownership of a course outline, one lower court explained that a course outline “was connected directly with the work for which [the teacher] was employed to do and was fairly and reasonably incidental to his employment.”\(^4\) Direct supervision was not required.\(^5\) Further, the notion that a common law tradition survives despite the language of the statute may be undermined when the academic tradition that gave rise to that tradition is itself transforming through the growth of new teaching media.\(^6\)

---

3 Gregory Laughlin, *supra* n. ___ at 573-74.
5 *Id.*
6 The issue was also addressed under state law in Williams v. Weisser, 78 Cal. Rptr. 542, 546 (Cal. Ct. App. 1969). Reliance on this case is misplaced for a variety of reasons. First, the subject matter was oral lectures which were protected by state law, not federal copyright law. Second, UCLA, the university employing the plaintiff stated in a letter to the faculty that “regarding the faculty member's right to control distribution of notes taken in classroom
Full-time faculty members may also retain certain ownership in works they create if those works are not within the scope of their employment or if the parties agree to another arrangement in writing. Under a common law exception to the work-for-hire doctrine known as the teacher’s exception, work-for-hire had not applied to faculty members’ academic writings under the 1909 Copyright Act. Significant controversy exists whether this exception survives the enactment of the Copyright Act of 1976. For most tenure-track faculty positions, academic writing remains a requirement of the job. Faculty members often receive mentoring by peers, secretarial and administrative support, and sometimes receive stipends or other additional compensation. As such, the academic writings are part of the employment because they are obligations undertaken in order for the faculty member to receive tenure. Nonetheless, most colleges and universities have historically never sought ownership of their faculties’ academic writings and have either waived claims of ownership through collective bargaining or through common practice.

In two decisions, the Seventh Circuit has strongly suggested that the doctrine does or should survive the re-codification of the 1976 Copyright Act. Neither case represents strong legal authority because in both cases the court was addressing this topic even though it was not in dispute between the parties. More importantly, the emphasis was on “academic books and articles.” The court stated that "the universal assumption and practice was ... that the right to copyright such writing belonged to the teacher rather than to the college or university [because the college or university] is poorly equipped to exploit their writings, whether through publication or otherwise ...”

Such an assertion by the court is baseless and unsupported. It ignores the value of research to an academic research institution; the importance of scholarship in the development and training lecture, it appears quite clear that under California’s recognition of common law copyright, the lecturer retains a property right to his words spoken before a limited audience. Any unauthorized duplication and distribution of these words, either verbatim or in the form of notes may therefore constitute an infringement of this right.” More than failing to assert any claims to their faculty’s lectures, UCLA had adopted the position of the common law copyright as its position. Third, UCLA never claimed any interest in this instance, so the record before the court could not support any contention by UCLA that it had any claims – regardless of the materials sought. Even under California law in 1969, nothing in the case suggests that UCLA was not the copyright holder of handouts, examinations, and other written materials prepared for college students and distributed by the faculty. While this is an open question, the case hardly provides any basis for a contrary determination.

9 ERNEST BOYER, SCHOLARSHIP RECONSIDERED 28 (1990) (“at most four-year institutions, the requirements of tenure and promotion continue to focus heavily on research and on articles published in journals, especially those that are refereed...”).
10 Id. at 50. The authors suggest that to break the oppressive role over-emphasis on scholarship has generated on many college campuses, co-called “creativity contracts” be used that allow the individual faculty member to negotiate with the employer for the specific types of scholarship, writing, and service activities that professor will perform. The creativity contract assumes that all scholarship is for the institution such that it can be bargained against other services the institution values from the faculty member.
11 Arguably, these scholarship requirements are enforced despite the needs to provide student instruction. See id. at 29.
12 Weinstein v. University of Illinois, 811 F.2d 1091 (7th Cir. 1987); Hays v. Sony Corporation of America, 847 F.2d 412 (7th Cir. 1988).
13 Hays, 847 F.2d at 416.
14 Id.
of the intuition’s employees; and creating a perverse incentive for universities to commercialize scholarship as a means of demonstrating ownership in the faculty’s work product. Despite the increasingly important role scholarship plays throughout higher education, the recitation of the need for a continuing teacher’s exception does not flow either from the text of the statute or the institutional realities of the academic community.

The reasons for providing a teacher’s exception to the work for hire doctrine flow primarily from the desire to provide faculty sufficient autonomy from their employers and a realization that the relationship between scholarship and incentives at most institutions is a very poor fit, particularly for faculty who have achieved tenure and are no longer directly measured by their scholarly output.

To solve these problems, some school policy manuals incorporate the teacher’s exception into school policy, disclaiming the employer’s copyright. This further indicates that any custom underlying the teacher’s exception has been replaced by negotiated academic policies. The Copyright Act specifically provides that the transfer of copyright by the employee may be altered by the parties, so long as “the parties have expressly agreed otherwise in a written instrument signed by them.”

**Work-for-Hire Case Summaries**

Used under a Creative Commons BY license from the Copyright Advisory Office of Columbia University, Kenneth D. Crews, director.

A few courts have ruled on the question of whether works created by faculty members are works made for hire, and whether the policy at the college or university effectively resolves questions about copyright ownership. These cases might address some legal questions, but they leave unclear whether general university copyright policies are enforceable and whether a "teacher’s exception" to the doctrine actually exists. While general university policies giving ownership of works to the faculty author can be helpful, these policies should be supplemented with written and signed agreements when the need for resolution of the ownership issues is critical. In light of the contradictory results in some of these cases, a proper signed agreement about copyright ownership of specific works may be of growing importance.


15 ERNEST BOYER, SCHOLARSHIP RECONSIDERED, supra n. __ at 29.
16 Of course, the only writings on the subject are by the faculty members who would risk losing the independence of their writings. While I recognize that the law is on the side of the universities, I strongly believe that the authorship of academic writings should not be transferred to the employer institution. As a faculty author, primary goal is to promote the non-economic interests in my writings – greater dissemination (often free of charge) and control over the attribution and integrity of my writings. While critically important to me as an academic, neither of these interests are protected or recognized by copyright law, except in limited circumstances. Cf., Rochelle Cooper Dreyfus, supra n. __ at 1200.
17 See Weinstein, 811 F.2d at 1094; Manning v. Board of Trustees, 109 F. Supp. 2d 976 (C.D. IL 2000).
18 17 U.S.C.A. §201(b) (2000). The technical language of the statute suggests that the manner of adoption of the collective bargaining agreement or copyright use policy should be adopted in a manner that provides for a signed writing by the institution and each faculty member. While this may be incorporated by reference into other signed documents, publication of an unsigned policy promulgated by a university that was not signed upon acceptance by the faculty members may be insufficient and will not fully comport with the writing requirements.
In a dispute over patent rights to a reformulated pharmaceutical developed in part by faculty researchers at the University of Colorado, the university argued that the defendant copied portions of a published research article written by the researchers. While the defendant disputed the university’s ownership, the court resolved that the article was a work made for hire created by employees within the scope of their employment. Consequently, the court concluded that the university was the copyright owner, held all the rights, and could proceed with the infringement claim.
Hays v. Sony Corporation of America, 847 F.2d 412 (7th Cir. 1988)

Two high school teachers wrote a manual for a DEC word processor and circulated the manual to students and other faculty members. A few years later, the school district gave the manuals to Sony and asked the company to modify it so that it could be used with Sony word processors that the district had bought. The court suggested the possibility of a "teacher’s exception" to the works-made-for-hire doctrine. That discussion, however, was only dictum and not a ruling by the court.

Weinstein v. University of Illinois, 811 F.2d 1091 (7th Cir. 1987)

A professor who had co-written an article and had requested for his name to be credited first argued that the university had deprived him of his property without due process. While the university claimed it was a work made for hire, the professor argued that the university’s general policy had given him ownership of the work. The court held that faculty members could retain the copyright to a research article depending on the interpretation of the university’s copyright policy. However, the court ruled on the question of due process and did not substantively resolve the issues of copyright ownership and policy interpretation.

Vanderhurst v. Colorado Mountain College District, 16 F. Supp. 2d 1297 (D.Colo. 1998)

A professor of veterinary technology prepared an outline on his own time with his own materials for a course that he taught at the college. After termination of his employment, the professor claimed ownership of the copyright to his course work; however, the court held that the creation of the outline should be fairly regarded as one method of carrying out the objectives of his employment, making it a work made for hire. Bolstering the court’s reasoning that the rights belonged to the college was a university policy specifying that the duties of faculty members included professional service activities, such as development of courses, programs, and curricula.

Manning v. Board of Trustees of Community College District No. 505 (Parkland College), 109 F. Supp. 2d 976 (C.D. Ill. 2000)

After a community college had terminated the full-time employment of a staff photographer, both the college and the photographer claimed ownership of the copyrights to photographs taken for the college during the term of his employment. The photographer alleged that he owned the copyrights because a policy included in the college’s policy manual sweeping granted copyrights to employees who create new works. The court held that a general policy was insufficient to meet the statutory requirements for changing the copyright ownership.


Like Manning, a professional staff photographer claimed ownership of the copyrights to his work following termination of his employment. The court held that the photographer was an employee creating the works within the scope of his duties and rejected the argument that the broad university policy designating that copyrights belonged to the author or originator of the work was sufficient to meet the statutory requirement of a writing signed by the parties. Therefore, the employer held the copyrights.

Bosch v. Ball-Kell, 206 WL 2548053 (C.D. Ill. 2006)

A professor claimed ownership in course materials she created and that were used by the college after her termination of employment. This decision was not the final ruling in the case. The court was only leaving open the possibility that a general university policy placing the
copyright with the creator of the work could in fact be enforceable. Because this ruling was on a motion for summary judgment, the court did not rule on the effectiveness of the policy.

Foraste v. Brown Univ.

This is the latest stage in an action concerning ownership rights to photographs taken by Plaintiff John Foraste ("Plaintiff" or "Foraste") while in the employ of Defendant Brown University ("Brown"). Foraste has alleged that he owns the copyright to these photographs pursuant to a copyright policy instituted at Brown during his years of employment. …

Foraste alleges two different theories of copyright infringement under the Copyright Act of 1976 ("1976 Act"), the first based on the express agreement exception to the work made for hire doctrine (17 U.S.C. § 201(b)), and the second on transfer of copyright interest (17 U.S.C. §§ 201(d)(1) and 204(a)). …

Foraste was employed by Brown as a full-time staff photographer from February 1975 to September 1998, when his employment was terminated due to a staff cutback. He was an employee-at-will, and had never signed an employment contract. He took pictures at the request of editors, art designers and other Brown personnel, as well as on his own initiative. His photographs were used in Brown publications and by various Brown departments to convey a positive image of Brown to the public.

In 1986, Brown adopted certain "Policies and Procedures Relating to Copyright" (the "Policy"). The Policy applies when an employee creates "copyrightable materials under University auspices or using University facilities" and is administered by Brown's Dean of Research. It appears in two other Brown handbooks, one entitled "Faculty Rules and Regulations" and the other "Staff Information Guide, You & Brown."

Of special significance to the instant motion is the following provision of the Policy:

3. Ownership: It is the University's position that, as a general premise, ownership of copyrightable property which results from performance of one's University duties and activities will belong to the author or originator. This applies to books, art works, software, etc.

There is no other writing in evidence that arguably could represent an agreement between the parties as to ownership of the images that Foraste created. …

Plaintiff's sole remaining claim of copyright infringement is based on an allegation that Brown transferred its copyright interest in the photographs to Foraste, pursuant to sections 201(d) and 204(a) of the 1976 Act. In order to determine whether Plaintiff can prevail on this theory, it is necessary to set forth the three statutory provisions in play:

§ 201. Ownership of copyright

. . . .
(b) Works Made for Hire. -- In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright. . . .

(d) Transfer of Ownership. --

(1) The ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law, and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession.

§ 204. Execution of transfers of copyright ownership

(a) A transfer of copyright ownership, other than by operation of law, is not valid unless an instrument of conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed or such owner's duly authorized agent.17 U.S.C §§ 201(b), 201(d)(1), and 204(a).

Congress, in designing section 201(b), undoubtedly intended to protect employers' proprietary rights in works made for hire. Indeed, the drafters of section 201(b) explicitly declined to incorporate language that would have vested partial ownership rights in creators. In excluding the so-called "shop right" doctrine, the drafters reasoned that

the presumption that initial ownership rights vest in the employer for hire is well established in American copyright law, and to exchange that for the uncertainties of the shop right doctrine would not only be of dubious value to employers and employees alike, but might also reopen a number of other issues. The drafters' emphasis on an employer's "ownership rights" and avoiding "other issues," as well as the glaring absence of reference to any "value" distinct from ownership (e.g., the value associated with authorship) severely undercuts Plaintiff's argument based on any alleged authorship/ownership dichotomy contemplated in section 201(b).

Moreover, the predecessor of the 1976 Act, the Copyright Act of 1909 ("1909 Act"), clarifies that authorship and ownership of works made for hire were both intended to vest, as an initial matter, in the employer. The work made for hire provision of the 1909 Act was simple: "the word 'author' shall include an employer in the case of works made for hire." 17 U.S.C. § 26 (current version at 17 U.S.C. § 201(b)).

The implication of this unqualified designation of employers as authors was elaborated upon by the Court of Appeals for the Second Circuit:

an employer and an employee [are not] precluded as a matter of law from agreeing that the copyright in the resulting work shall vest in the employee. See, generally, Nimmer, Copyright § 62.1 (1968). Rather, § 26 merely creates a rebuttable presumption of copyright in the employer, a presumption which can be overcome by evidence of a contrary agreement between the parties. Scherr v. Universal Match Corp., 417 F.2d 497, 500 (2nd Cir. 1969) (all other citations omitted).
The 1976 Act codified the explanation of section 26 provided in Scherr, explicitly permitting agreements altering the ownership scheme from that under section 201(b) by adding the "unless" clause. In so doing, however, the 1976 Act preserved from the 1909 Act its unalterable designation of employers as authors. "Under section 201(b) of the current Act, the parties may agree that the employee rather than the employer 'owns all rights comprised in the copyright,' but the proviso that 'the employer or other person for whom the work was prepared is considered the author for purposes of this title' is not subject to variation by agreement between the parties." Nimmer, Copyright § 1.06[C] (2003) (quoting 17 U.S.C. § 201(b)).

The legislative history of section 201(b) therefore demonstrates that, contrary to Plaintiff's contentions, its drafters intended to safeguard employers' "authorship" and "ownership" rights.

It would defy that intention to accept the claim that an employer could transfer copyright ownership in a work made for hire to an employee without complying with the strict requirements of section 201(b)'s "unless" clause.5

[ Footnote 5: The Court notes that the traditional "faculty exception" to the work made for hire doctrine, "whereby academic writing [is] presumed not to be work made for hire," see Hays v. Sony Corp. of America, 847 F.2d 412, 416 (7th Cir. 1988), is inapposite here. That exception is meant to protect the "scholarly articles and other intellectual property" created by university professors while in the employ of an academic institution. Weinstein v. University of Illinois, 811 F.2d 1091, 1094 (7th Cir. 1987). Various equitable considerations often mandate that a scholar retain the copyrights in his work, notwithstanding the work made for hire doctrine. See, e.g., id. at 1094-95 (for example, the requirement that a scholar "publish or perish"); Hays, 847 F.2d at 416 ("A college or university does not supervise its faculty in the preparation of academic books and articles, and is poorly equipped to exploit their writings, whether through publication or otherwise; we may set to one side cases where a school directs a teacher to prepare teaching materials and then directs its other teachers to use the materials too."). These equitable policy concepts do not apply here because Foraste was not working under an implicit or explicit "publish or perish" directive, and because he was usually directed by Brown officials to photograph specific scenes.]

2. Section 204(a). Even assuming, however, that the Plaintiff could circumvent the "unless" clause, and that one could transfer a work made for hire without adhering to section 201(b), there remains the question of whether what occurred in this case constitutes a valid transfer pursuant to section 204(a). As set forth above, the statute itself only requires a written "instrument of conveyance, or a note or memorandum of the transfer" that is "signed by the owner of the rights conveyed or such owner's duly authorized agent."

Judge Kozinski of the Ninth Circuit has explored the purposes underlying the requirements of section 204(a) in some detail. In Effects Assoc., Inc. v. Cohen, he listed several reasons for the section 204(a) writing requirement, which include: spelling out the terms of the deal to prevent misunderstandings; forcing the parties to clarify their thinking and consider problems that could potentially arise; and determining precisely which rights are to be transferred. 908 F.2d 555, 557
The Policy, when measured against these criteria, is too vague to fulfill any of them. It spells out no material terms specific to the contested photographs; in fact, it does not even mention the subject matter of the transfer. The Policy also gives no indication that the parties had clarified their thinking (indeed, that there was any "thinking" about copyright in the photographs at all) or considered any problems that could potentially arise. Foraste himself acknowledges that he did not even contemplate ownership of the photographs until well after the Policy's adoption, and it would be absurd and unsupportable to suppose that Brown had Foraste's photographs in mind when it enacted the Policy. Lastly, the Policy shows an utter absence of precision regarding the rights to be transferred, again for the reason that the photographs are nowhere mentioned, nor are there any details of the purported deal.

In *Konigsberg Int'l, Inc. v. Rice*, Judge Kozinski hinted at a "meeting of the minds" requirement, intimating that a valid section 204(a) writing should be the product of the parties' negotiations. 16 F.3d 355, 357 (9th Cir. 1994). In this case, there is no evidence of a negotiation or "meeting of the minds" between Foraste and Brown regarding the contested photographs. There is no indication that Foraste ever bargained for the copyrights he now seeks, for example. Indeed, it would be impossible for the Policy to have been the product of a "meeting of the minds" between Brown and Foraste, since Foraste never even thought about copyright ownership until after his termination.

Judge Gertner of the District of Massachusetts has cited approvingly a rigorous standard for section 204(a) transfers [including] (1) identification of the subject matter of the agreement; (2) an indication that the parties have come to that agreement; and (3) a reasonably certain statement of the essential terms of the agreement. The Policy does not meet even a single one of these three conditions.

While the approaches of Judges Kozinski and Gertner toward section 204(a) are not universally accepted, the requirement that the instrument of transfer be "clear" finds frequent emphasis in other section 204(a) decisions. … The Court finds it significant that the Policy fails to make any reference at all to the subject matter of the rights to be transferred, the recipient of the transferred rights, the timing of the transfer, or any other particulars of the deal. … This Court finds that the Policy fails as a section 204(a) transfer instrument. Not a single relevant detail of the purported transfer is stated in the Policy. …

**Molinelli-Freytes v. University of Puerto Rico**

792 F.Supp.2d 164 (2010)

The instant case is a copyright infringement action brought pursuant to the Court’s exercise of federal question subject matter jurisdiction over claims arising under the Copyright Act of 1976 (the “1976 Act”), as amended, 17 U.S.C. § 101 et seq. Plaintiffs aver that they created an original manuscript (“the Proposal”) during non-working hours while employed as professors at Defendant University of Puerto Rico (“UPR”). Plaintiffs also allege that Defendant Puerto Rico Council on Higher Education (“PRCHE”) knowingly approved implementation of an unauthorized modified version of the Proposal and that UPR subsequently began to implement a
Masters and Doctorate Program based upon the Proposal in violation of Plaintiffs’ duly registered copyright. …
WORK FOR HIRE DOCTRINE AND THE COMMON LAW “TEACHER EXCEPTION”

At this juncture, the Court must assume the role of a legal historian in order to unearth the octogenarian common law roots of a “teacher exception” in order to determine if this relic has survived the years and silently incorporated itself into modern day copyright law. Accordingly, the Court shall begin its discussion at the birth of the “teacher exception” while the 1909 Copyright Act and common law of copyright were still the law of the land.

Although the 1909 precursor to the present Copyright Act mentioned a “work for hire” doctrine under which employers could qualify as “authors”, the doctrine under that Act was not further defined and courts were left to apply this ambiguous doctrine without further guidance. See e.g. Cmty. for Creative Non–Violence v. Reid, 490 U.S. 730, 744, 109 S.Ct. 2166, 104 L.Ed.2d 811 (1989). Ultimately, the courts of yesteryear determined that “the work for hire doctrine codified in [the 1909 Act] referred only to works made by employees in the regular course of their employment.” Id.

It was under this framework that the first case recognizing an exception to the work for hire doctrine for professors’ academic work, Sherrill v. Grieves, was decided. See 57 Wash. L.Rep. 286. In that case, a military instructor drafted a textbook of his own initiative and during his leisure time once he discovered that no textbook matching his course’s curriculum existed. Id. at 290. Prior to publication of the textbook, the instructor authorized publication of a pamphlet which incorporated a portion of the book. Id. Later, the defendant incorporated portions of that pamphlet in two books which he authored and, once sued, claimed that the military instructor did not own the copyright to the pamphlet because it was produced for his military employer. Id. at 286–87. Ultimately, the Supreme Court for the District of Columbia held that the pamphlet was not a work for hire, stating that “[t]he court does not know of any authority holding that ... a professor is obliged to reduce his lectures to writing or if he does so that they become the property of the institution employing him.” Id. at 290. Thus the “teacher exception” was born.2

The next case to apply the common law “teacher exception” prior to enactment of the 1976 Act was Williams v. Weisser, a California case. See 153 U.S.P.Q. 866, aff’d 273 Cal.App.2d 726, 78 Cal.Rptr. 542. In that case, decided under California’s common law of copyrights in 1967 and appealed in 1969, the trial court once again held that a professor retained the copyright to his lectures, adding that this copyright also extends to other unspecified writings. 153 U.S.P.Q. at 868. Unlike the plaintiff in Sherrill, the plaintiff in Williams had not written the contents of his lectures in the form of a textbook; in fact, the plaintiff had not reduced his lectures to a written form at all. Id. at 867. Rather, defendant, a company that sold college notes, placed a note-taker in the plaintiff’s class and subsequently printed and sold the notes taken by the note-taker during the plaintiff’s lectures. Id.

When sued, the defendant countered by stating that the plaintiff had no standing to sue as the copyright to his lectures was held by the university, rather than by the professor himself. Id. at 866–67. Interestingly, the trial court placed great emphasis on a letter circulated by the university to its professors in which the university informed the professors that they, not the university, held copyright to their lectures under California common law. Id. at 867–68. The court in that case concluded that this letter constituted the “apparent relinquishment of any rights to such literary
property by the university, if indeed it possessed any.” *Id.*

Upon appeal, the court rejected defendant’s assertion that the plaintiff was an employee whose work fell under the work for hire doctrine. 273 Cal.App.2d at 734–35, 78 Cal.Rptr. 542. Therein, the appeals court cited *Sherrill*, as well as several English and Scottish common law cases, to support its view that copyright lies with the person who produces or delivers a lecture. *Id.* at 736–739, 78 Cal.Rptr. 542. Further, the appeals court stated that it considered lectures *sui generis*, particularly in light of the peripatetic nature of professors, and emphasized that “[n]o reason ha[d] been suggested why a university would want to retain the ownership in a professor’s expression” in reaching its determination. *Id.* at 734–735, 78 Cal.Rptr. 542. This case marks the second and last application of the common law “teacher exception” to date.

Before the Court moves on to discuss the 1976 Copyright Act and its consequences for the work for hire doctrine and the potential application of a “teacher exception,” the Court finds it pertinent to note that, prior to the enactment of the 1976 Act, at least one case declined to apply a “teacher exception” to a professor’s work product. See *Manasa v. Univ. of Miami*, 320 So.2d 467. In the brief opinion rendered by the Florida appeals court, they distinguished that case, which centered around ownership of a copyright to a proposal for an academic program, from *Williams* based upon the type of document involved. *Id.* The court then decided that the proposal was created within the scope of the plaintiff’s employment and, accordingly, that the professor was not entitled to recover for copyright infringement against the university for use of the proposal. *Id.*

When Congress enacted the 1976 Copyright Act, replacing the 1909 Act and abolishing all state common law regarding copyright, it set forth a more detailed outline of the work for hire doctrine than that contained in the 1909 Act. See 17 U.S.C. § 301(a)(containing the expression of preemption); 17 U.S.C. § 101 (containing the expanded definition of work for hire). Specifically, under the 1976 Act, a work for hire is defined as:

(1) a work prepared by an employee within the scope of his or her employment; or

(2) a work specially ordered or commissioned for use 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.

17 U.S.C. § 101 (emphasis ours). Thus, where a work falls within the scope of the work for hire doctrine, the employer, rather than the author, is deemed the owner of the copyright, “unless the parties have expressly agreed otherwise in a written instrument signed by them.” 17 U.S.C. § 201(b).

The question of whether the “teacher exception” created by *Sherrill* and *Williams* survived the enactment of the 1976 Act has provided much fodder for academic debate. ... However, case law regarding the potential applicability of the “teacher exception” in the wake of the 1976 Act’s enactment is scant, and no reported opinion exists holding either that such an exception survived or that it was extinguished by the 1976 Act. Nevertheless, two cases from the Seventh Circuit,
Weinstein v. Univ. of Ill., 811 F.2d 1091 (7th Cir.1987), and Hays v. Sony Corp. of America, 847 F.2d 412 (7th Cir.1988), have addressed the issue in dicta.

In Weinstein, an opinion authored by Circuit Judge Easterbrook\(^5\) for a panel on which Judge Posner sat, the Court noted that an “academic tradition [existing] since copyright law began” vests ownership of theorem, scholarly articles and an unspecified group of “other intellectual property” created by professors in the professors themselves, rather than in the universities that employ them. 811 F.2d at 1094. However, Judge Easterbrook also admitted that the applicable statute appears “general enough to make every academic article a ‘work for hire’ and therefore vest exclusive control in universities rather than scholars[,]” noting that many universities now adopt policies in order to relinquish ownership of certain works to the professors who create them. \textit{Id.} at 1093–94. The court in that case did not base its ultimate decision regarding ownership upon application of a “teacher exception,” but, rather, based its finding that the disputed work, an article co-authored by the plaintiff university professor,\(^6\) did not constitute a work for hire upon a reading of the employer-university’s copyright policy and the custom within that university. \textit{Id.} at 1094–95.

A year later, Judge Posner authored an influential opinion again discussing the common law “teacher exception.” \textit{See} Hays, 847 F.2d 412. In that case, high school teachers of business brought a copyright infringement claim against a corporation which, at the request of the teachers’ school district, allegedly performed an illegal modification of a manual which the teacher-plaintiffs had authored. \textit{Id.} at 413. The court in that case was thus tasked with rendering a determination of whether the manual constituted a work for hire. \textit{Id.} at 416. The Court acknowledged that “it is widely believed that the 1976 Act abolished the teacher exception.” \textit{Id.} Further, the court admitted that “[t]o a literalist of statutory interpretation, the conclusion that the Act abolished the exception may seem inescapable” as there is no discussion of the “teacher exception” in the legislative history of the Act and as the exception was not included in the body of the Act itself. \textit{Id.} However, Judge Posner, a professor himself,\(^7\) also stated that failure to recognize a “teacher exception” would wreak havoc on the “settled practices of academic institutions” and would run contrary to the usual practices of academia before determining that “if forced to decide the issue, [the court might] conclude that the exception had survived the enactment of the 1976 Act.” \textit{Id.} at 416–17. However, the discussion of the “teacher exception” in this opinion was, once again, dicta, as the court found that “even if the statute abolished the teacher exception this would not necessarily spell victory for” the defendant-corporation. \textit{Id.} at 417.

In 1989, the Supreme Court broke new ground in \textit{Reid}, a case which forever changed the work for hire analysis. \textit{See} 490 U.S. 730, 109 S.Ct. 2166. In that case, the Supreme Court established a three-step process for resolving whether a work constitutes a work for hire. 490 U.S. at 751–752, 109 S.Ct. 2166. Under this new guideline for application of the work for hire doctrine, courts are directed to first “ascertain, using principles of general common law agency,\(^8\) whether work was prepared by an employee or an independent contractor.” \textit{Id.} at 751, 109 S.Ct. 2166. Next, courts are directed to the Act itself in order to make a determination of whether the work at dispute falls within the first or second category of works which the Act states constitute works for hire. \textit{Id.} Finally, courts must apply the common law of agency to determine whether the work was created within the scope of employment. \textit{See id.} at 751, 109 S.Ct. 2166 (discussing in tandem the inquiry as to whether a person is an employee and whether a work is created within the scope of
employment); see also Vanderhurst v. Colorado Mtn. College Dist., 16 F.Supp.2d 1297, 1307 (D.Colo.1998), aff’d on other grounds 208 F.3d 908 (10th Cir.2000) (utilizing the Restatement (Second) of Agency to define “scope of employment”). In reaching its holding, the Court explicitly rejected the argument that Congress silently intended “to incorporate a line of cases decided under the 1909 Act” which advocated a different method, noting that “Congress’ silence is just that—silence.” Reid, 490 U.S. at 748–49, 109 S.Ct. 2166 (quoting Alaska Airlines, Inc. v. Brock, 480 U.S. 678, 686, 107 S.Ct. 1476, 94 L.Ed.2d 661 (1987))(internal quotation omitted).

In the wake of Reid, courts appear to have abandoned the “teacher exception” and those which cite the earlier Seventh Circuit cases do so solely in the context of determining whether teachers’ work-product falls within the scope of their employment. See Shaul v. Cherry Valley–Springfield Central School Dist., 363 F.3d 177, 185–86 (2d Cir.2004) (applying the Reid guidelines for the work for hire doctrine to materials created by a teacher without addressing a “teacher exception”); see also Pavlica v. Behr, 397 F.Supp.2d 519, 525–26 (S.D.N.Y.2005) (discussing Hays while determining whether a genuine issue of material fact existed as to whether a manual created by a high school teacher was created within the scope of his employment); see also Vanderhurst, 16 F.Supp.2d at 1307. Additionally, this apparent abandonment of the “teacher exception” is chronicled in a September, 2010 treatise on copyright law, which concludes that the “teacher exception,” if it ever indeed existed in federal law, perished with the enactment of the 1976 Act. William F. Patry, Copyright § 5:71 (2010 ed.).

Although a state court’s decisions are not binding upon this Court, the Court also notes that the one court which has squarely addressed the issue of whether the “teacher exception” survived until the present day answered that question in the negative. See Pittsburg State University/Kansas Nat’l Educ. Ass’n v. Kansas Board of Regents/Pittsburg State University, 280 Kan. 408, 421–24, 122 P.3d 336 (2005) (analyzing the potential application of a “teacher exception” to the 1976 Copyright Act work for hire doctrine in the wake of Reid). Thus, the Court concludes that the current trend in both high-level academia and in relevant jurisprudence is to forego application of the common law “teacher exception” and to determine whether a work prepared by a teacher or professor falls within the work for hire doctrine, utilizing the steps set forth by Reid.

Additionally, as Posner noted in Hays, there is no mention of a “teacher exception” in the legislative history of the 1976 Act. See Hays, 847 F.2d at 416. In light of the Supreme Court’s subsequent decision in Reid that silence on the part of the legislature regarding inclusion of common law jurisprudence indicates that such jurisprudence should not apply under the 1976 Act, the Court finds that this silence weighs heavily towards a finding that no “teacher exception” remains in existence. See 490 U.S. at 748–49, 109 S.Ct. 2166 (finding that legislative silence does not indicate legislative intent to include common law from prior to enactment of the 1976 Act and noting that, in other portions of the Act, where Congress intended to include prior case law, it did so explicitly). Accordingly, the legislative history, weighs against finding that a “teacher exception” to the work for hire doctrine exists today, particularly following the Supreme Court’s analysis thereof with reference to the work for hire doctrine in Reid.

Thus, only policy and historical custom weigh in favor of a finding that a “teacher exception” remains. Even if the Court were inclined to engage in the judicial lawmaking which would be required to resurrect the common law exception at this stage, the Court harbors serious
reservations regarding the continued applicability of the policy and custom which traditionally upheld the exception. In Williams, the court placed emphasis on its view that universities had no reason to “want to retain the ownership in a professor’s expression” in finding that a teacher exception applied. 273 Cal.App.2d at 734–35, 78 Cal.Rptr. 542. This rationale no longer rings as true as it once did, however. In an age of distance-learning and for-profit institutions of higher learning, universities stand to gain much by retaining ownership of certain works created by their employees. See e.g. Garon, Jon, The Electronic Jungle: the Application of Intellectual Property Law to Distance Education, 4 VAND. J. ENT. L. & PRAC.., 146, 147–48 (Spring 2002) (discussing the economics of for-profit education and distance learning); see also Townsend, Elizabeth, Legal and Policy Responses to the Disappearing “Teacher Exception,” or Copyright Ownership in the 21st Century, 4 MINN. INTELL. PROP. REV.. 209, 243–44 (2003) (discussing the increasing commercialization of higher learning institutions). In fact, Plaintiffs admit as much in their brief when they argue that UPR wishes to use the Proposal for commercial, profit-maximizing reasons.

Additionally, the policy of continuing to apply the “teacher exception” so as to defer to the “settled practices of academic institutions” and the traditional “conditions of academic production” emphasized by Judge Posner in Hays no longer applies with the strength which it held in 1988. Most academic institutions today have already responded to the uncertainty regarding the “teacher exception” by enacting policies, returning ownership of works traditionally copyrighted by professors to the professors themselves. See e.g. Denicola, Robert C., Copyright and Open Access: Reconsidering University Ownership of Faculty Research, 85 NEB. L.REV. 351, 379–80 (2006) (recognizing that most universities have such policies but noting that compliance with the strictures of 17 U.S.C. § 201(b) is not satisfied by many at this time); Townsend, Elizabeth, Legal and Policy Responses to the Disappearing “Teacher Exception,” or Copyright Ownership in the 21st Century, 4 MINN. INTELL. PROP. REV.. 209, 251–75 (2003) (analyzing the policies of several universities). Thus, two decades from when Posner cited his concerns for preserving academic tradition by recognizing the “teacher exception,” this concern has already become de minimis as universities have proactively created policies that grant professors ownership of copyrights which the “teacher exception” once ensured. Accordingly, the only remaining enunciated policy concerns involve the transient nature of university professors and Plaintiffs’ speculative concerns that failure to recognize a “teacher exception” would cause a chilling in academic innovation. The Court will not find that a “teacher exception” continues to exist based solely upon these two potential concerns. Accordingly, the Court rules that no such exception survived the enactment of the 1976 Copyright Act and, accordingly, Plaintiffs may claim no such exception in relation to Defendants’ work for hire defense.

Thus, the Court must resolve the instant case within the framework of the work for hire doctrine, utilizing the standard set forth in Reid as well as considering any relevant University regulations specifically recognizing professor or university ownership over certain works.

IT IS SO ORDERED.

Footnotes

1 Although the Court has considered this portion of Defendants’ brief as it relates generally to the function of university
policies in counteracting a work-for-hire presumption for employer ownership, it finds that a request to determine whether the Proposal constitutes a work-for-hire based upon the merits of the instant case is at this time premature as discovery has not yet concluded. Further, such an inquiry would proceed under a summary judgment standard for weighing the sufficiency of the evidence and, as it includes no separate statement of material facts as required by Local Rule 56(b), the request for summary judgment would be summarily denied. See Morales v. A.C. Orsleff's EFTF, 246 F.3d 32, 33 (1st Cir.2001)(affirming this District Court’s grant of summary judgment where the Court refused to consider facts which were not presented in compliance with the precursor to the current anti-ferreting rule).

The exception was not referred to by this name, however, until the 1983 case of New York Southern District Court in Town of Clarkstown v. Reeder, 566 F.Supp. 137, 143 n. 3 (S.D.N.Y.1983), so named it in dicta.

This case also arose under copyright common law.

The Court notes that one unpublished opinion from the Central District of Illinois quoted the dicta from Weinstein v. Univ. of Ill., 811 F.2d 1091 (7th Cir.1987), and Hays v. Sony Corp. of America, 847 F.2d 412 (7th Cir.1988), regarding the policy behind recognizing a “teacher exception” before concluding that the university in that case intended that the disputed work would belong to the professor when it enacted its intellectual property policy. See Bosch v. Ball–Kell, No. 03–1408, 2006 WL 2548053 (C.D.Ill.2006).


The basic factual dispute of that case was immortalized by Judge Easterbrook as follows:

Many disputes may be compromised by converting the stakes to a common denominator such as money and splitting the difference. Few commercial disputes end up in court, because the disputants may readily compromise and move on. Other disputes are harder to resolve because they seem to involve principles for which no compromise is readily apparent. The result may be a private war. A dispute that would be resolved quickly in the commercial world may fester. We have such a dispute. It is about the order in which the names of an article’s authors will be listed.

José Molinelli–Freytes (“Molinelli”) and Lillian Bird–Canals (“Bird”) (collectively, “Plaintiffs”) brought suit against the University of Puerto Rico (“UPR”), the Puerto Rico Council on Higher Education (“CHE”), past and present UPR and CHE officers, the UPR trustees, and other allegedly responsible individuals, for copyright infringement under the Copyright Act of 1976 (“the Copyright Act”), 17 U.S.C. §§ 101 et seq.1. Plaintiffs assert that they created an original manuscript (the “Proposal”) during nonworking hours while employed as a professor and program director at UPR. Plaintiffs aver that UPR has used the Proposal improperly in order to create a new graduate program based upon the contents of the Proposal in violation of the Copyright Act. Plaintiffs further contend that CHE authorized the creation and implementation of this program in violation of the Copyright Act. …

When analyzing a motion for summary judgment, the Court must view the facts in the light most favorable to the non-moving party, in this case Plaintiffs. However, the Court will not “draw
unreasonable inferences or credit bald assertions, empty conclusions, [or] rank conjecture.” Caban–Hernandez v. Philip Morris USA, Inc., 486 F.3d 1, 8 (1st Cir.2007) (emphasis in original). Similarly, “summary judgment may be appropriate if the non-moving party rests merely upon conclusory allegations, improbable inferences, and unsupported speculation.” Ayala–Gerena, 95 F.3d at 95 (internal quotations omitted).

Furthermore, the Court will not consider hearsay statements nor allegations presented by parties that do not properly provide specific reference to the record. Keeping these limitations firmly in mind, the Court proceeds with its analysis. …

A certificate of copyright made within five years of publication is *prima facie* evidence of a valid copyright pursuant to 17 U.S.C. § 410(c). However, the Magistrate did not grant Plaintiffs the benefit that their copyright certificate enjoys *prima facie* evidentiary weight as Plaintiffs submitted a certificate of registration for the Proposal which states that the Proposal was first published in 2001 while the certificate was effective in 2007. As the certificate was made more than five years after the stated date of publication …

At any rate, “[t]he presumption flowing from § 410(c) is not an insurmountable one, and merely shifts to the defendant the burden to prove the invalidity of the plaintiff’s copyrights.” Masquerade Novelty v. Unique Indus., 912 F.2d 663, 668 (3d Cir.1990) (citation omitted). Thus, even without the benefit of the presumption, Plaintiffs still have been afforded ample opportunity to make their case squarely on the merits.

Plaintiffs object to the Magistrate Judge’s analysis and ultimate conclusion that drafting the Proposal was within the scope of Plaintiffs’ employment. The Magistrate Judge stated that “[t]here is simply no evidence from which a jury could conclude that creating degree programs was not the kind of work Bird and Molinelli were employed to perform” and that “Plaintiffs have not established a genuine issue of material fact as to any element of the work for hire doctrine.”

Plaintiffs argue that creating a new graduate program is not the kind of work that employees in their position traditionally perform. Plaintiffs note that there is no written agreement between them and UPR describing their duties and that the ordinary duties of a professor and a program director do not include the design and creation of a new program of study. Further, Plaintiffs argue that they were not given release time from their work obligations, or extra compensation, which is customary when additional projects exceed the 37.5 hours per week.

As to the second element, Plaintiffs object to the Magistrate Judge’s conclusion that “plaintiffs provided no evidence ... from which a jury could conclude that UPR did not authorize them to work from home or on weekends or on holidays.” (Docket No. 409, page 20). Plaintiffs advance that the fact that a professor’s and a program director’s schedules are flexible and that they may choose to perform some of their duties off site and at irregular hours, does not automatically entail that the specific work was performed within “authorized time and space limits.” Plaintiffs further posit that UPR has failed to demonstrate that the use of vacation time in the development of the Proposal was “authorized” by UPR. Therefore, Plaintiffs assert that a jury could conclude that the vacation time spent in research and drafting of the Proposal occurred outside of “authorized” time.
The Court agrees with the Magistrate, upon conducting its own *de novo* review, that the work for hire doctrine is applicable and vests ownership of the Proposal in UPR and that Plaintiffs have not demonstrated a genuine issue of material fact as to any element of the work for hire doctrine. We agree with the Magistrate Judge that the creation of the Proposal was “of the kind” of work that Plaintiffs were employed to perform. The drafting of a proposal for a new academic program, and thereby improving upon the educational content and offerings of UPR, is the kind of work Plaintiffs were employed to do as a professor and as a program director. *See Shaul v. Cherry Valley–Springfield Cent. Sch. Dist.*, 363 F.3d 177, 186 (2d Cir.2004) (“It is clear that preparing materials for class was the kind of work that [Plaintiff] was employed to perform as a teacher (satisfying the first prong) ... regardless of his purported desire to publish the materials.”). The Court finds that the development of a new course of academic study satisfies the first requirement of the Restatement test for a university professor and program director because such work falls “within the ultimate objective of the principal and [is] an act which is not unlikely that such a servant might do.” *Miller v. CP Chemicals, Inc.*, 808 F.Supp. 1238, 1243 (D.S.C.1992) (citing Restatement (Second) of Agency § 229 cmt. b).

“When [the first] element of the Restatement test is met, courts have tended not to grant employees authorship rights solely on the basis that the work was done at home on off-hours.” *Avtec*, 21 F.3d at 571. Thus, while “Molinelli testified that he used spare time, including vacations and holidays, to work on the proposal,” the time, place and manner of the creation of the Proposal is afforded less weight when the first element of the Restatement test has been satisfied.

Finally, Plaintiffs also object to the Magistrate Judge’s scope of employment analysis on the basis that the Magistrate Judge omitted the control and skill factors. Plaintiffs’ objection is without merit. While these are factors in a work for hire analysis, they are utilized to determine whether an employment relationship exists. As Plaintiffs have admitted that they are employees of UPR (Docket No. 362, page 14), these factors are not relevant to the instant inquiry. *See Cnty. for Creative Non–Violence v. Reid*, 490 U.S. 730, 751 (1989)(“In determining whether a hired party is an employee under the general common law of agency, we consider the hiring party’s right to control the manner and means by which the product is accomplished. Among the other factors relevant to this inquiry are the skill required....”); Restatement (Second) of Agency § 220(1); *see also Drescher v. Shatkin*, 280 F.3d 201, 205 (2d Cir.2002) (“We have often applied [the Reid ] factors in deciding whether a person is an employee or a non-employee independent contractor.”).

Finally, Plaintiffs argue that even if the work for hire doctrine vests ownership of the Proposal in UPR, UPR’s IP policy constitutes a valid transfer of ownership to Plaintiffs. Thus, Plaintiffs object to Magistrate Judge McGiverin’s conclusion that “defendants have demonstrated a lack of evidence that the UPR IP policy alters work for hire under 17 U.S.C. § 201, and plaintiffs have not met their burden of showing a triable issue of fact on this question.” (Docket No. 409, page 24).

Plaintiffs assert that the UPR’s IP Policy constitutes a transfer of ownership of the Proposal as the IP Policy fulfills the Copyright Act requirements under § 204(a) because the IP Policy is a written instrument executed by the UPR. Therefore, Plaintiffs advance that, UPR, as the owner of the Proposal, was entitled to, and did, transfer the copyrights to Plaintiffs.
However, if the work is made for hire, as in the instant matter, the Copyright Act states that “the employer or other person for whom the work was prepared is considered the author ... and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.” 17 U.S.C. § 201(b). Thus, in work for hire situations, a written instrument signed by both parties is required to create a valid transfer. Plaintiffs rely on the more general § 204(a), which only requires the writing to be signed by one party, the transferor; however, this reliance is misplaced as the more specific § 201(b) is the applicable provision in the work for hire context. See 1 Melville B. Nimmer and David Nimmer, Nimmer on Copyrights, § 10.03[A][6], (“for the employer to transfer copyright ownership of the work for hire to the employee requires compliance with the specialized provisions of the Act [referring in a footnote to § 201(b) ] applicable to works for hire rather than the general provisions currently under discussion [referring in a footnote to § 204(a) ].

The IP Policy is unavailing for Plaintiffs as it is executed only by one party, UPR Defendants/the employer, and not by both UPR Defendants and Plaintiffs. Even if the IP Policy was signed by Plaintiffs however, the policy is so broad that it would fail to constitute an express agreement whereby the employer knowingly and voluntarily consented to transfer a property right. See Manning v. Board of Trustees, 109 F.Supp.2d 976, 981 (C.D.Ill.2000) (“An agreement altering the statutory presumption under the Copyright Act must be express.”)(citing Baltimore Orioles, Inc. v. Major League Baseball Players Ass’n, 805 F.2d 663, 672 (7th Cir.1986)); Rouse v. Walter & Assocs., L.L.C., 513 F.Supp.2d 1041, 1063–64 (S.D.Iowa 2007); (“An employee policy is insufficient to alter the statutory presumption under the Copyright Act.”); Foraste v. Brown Univ., 248 F.Supp.2d 71, 81 (D.R.I.2003) (“The Policy [relating to copyrights] is patently inadequate to overcome the presumption of Brown’s ownership under the work made for hire doctrine.”). Here, the IP Policy does not mention the Plaintiffs or the Proposal or references any type of negotiation and consideration given for the bargain of the supposed transfer. Indeed, these specifics must be lacking as the IP Policy was issued in 1993 whereas the Proposal was drafted in 2001.

As Plaintiffs have not supplied a signed agreement between UPR and Plaintiffs as required by § 201(b), nor pointed to any evidence to infer the existence of such an agreement, the Court finds that Plaintiffs’ argument that UPR transferred the copyrights in the Proposal to Plaintiffs fails as a matter of law....

For the reasons elucidated above … the Court ADOPTS the Report and Recommendation IN TOTO and GRANTS Defendants’ Motion for Summary Judgment. Finding no viable claims of copyright infringement, the Court hereby DISMISSES these causes of action WITH PREJUDICE. Judgment shall be entered accordingly.

IT IS SO ORDERED.

Footnotes

1 The Court previously dismissed Plaintiffs’ § 1983 claims and unjust enrichment claims as well as claims under the Puerto Rico Intellectual Property Act, 31 L.P.R.A. §§ 1401 et seq. (Docket Nos. 151, 294 and 318).

8 The Magistrate Judge utilized the Restatement (Second) of Agency in his scope of employment analysis. “To fall within the scope of employment, an employee’s conduct must (1) be ‘of the kind [the employee] is employed to perform’; (2) occur “substantially
within authorized time and space limits'; and (3) be ‘actuated, at least in part, by a purpose to serve the master.’ See Restatement (Second) of Agency § 228.” (Docket No. 409, page 19).

That provision of the Copyright Act provides that “[a] transfer of copyright ownership ... is not valid unless an instrument of conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed or such owner’s duly authorized agent.” 17 U.S.C. § 204(a).