II. THE WORK FOR HIRE DOCTRINE VERSUS THE EDUCATOR EXCEPTION

1. The Work for Hire Doctrine

The work for hire doctrine is a prevailing rule that has found its way into the copyright laws of the countries where the universities included in this study exist [7]. This doctrine has been particularly useful for profitable e-learning experiments. One of those reported was the Cardean University (CU), which offered an online graduate business education with materials supplied by an academic consortium comprised of Columbia University, Stanford University, University of Chicago, Carnegie Mellon University and the London School of Economics and Political Science [8]. This consortium sprang from the UNext.com venture. Under the commercial arrangement universities turn over to CU academic content they own, but which their educators create, in return for a "guaranteed stream of royalties that, according to some sources at the universities, amount to a minimum of $20 million over five to eight years" [9]. Educators, who in traditional settings would have been entitled to royalties for their academic works, did not appear to have any part in the determination and allocation of these royalties, or in the control of

their works. This is one way in which universities that "missed out on textbooks" in real time can have "a piece of the action" [10] in virtual time.

2. The Educator Exception: Copyright of Educators over their Lectures

An exception to the rigorous application of the work for hire rule was traditionally provided for educators who are generally regarded as owning the copyright in their works.

3. The United Kingdom Position

This exception is a judge made law that found its earliest recorded expression in the 1825 United Kingdom case of *Abernethy v. Hutchinson* [11]. Here, the lectures on surgery delivered by the complainant to students at Saint Bartholomews Hospital in London were published by the defendant in a periodical called "The Lancet". The court likened the position of the complainant to a university professor and granted the injunctive relief that he sought. Professors were recognized to have at common law, copyright over their lectures. The court gave the example of Sir William Blackstone, who held the appointment of Vinerian Professor of Law at Oxford University and who published his lectures. It noted:

> Now, if a professor be appointed, he is appointed for the purpose of giving information to all students who attend him, and it is his duty to do that; but I have never yet heard that anybody could publish his lectures; nor can I conceive on what ground Sir William Blackstone had the copyright in his lectures for twenty years, if there had been such a right as that; we used to take notes at his lectures… it was the duty of certain persons to give those lectures but it never was understood, that the lectures were capable of being published by any of the persons who heard them [12].

Nicols v. Pitman upheld the right of a lecturer to profit from his/her own lecture. Even if the lecture was delivered in a public place and from memory, "the understanding between the lecturer and the audience is that…the audience are quite at liberty to take the fullest notes they like for their own personal purposes but they are not at liberty, having taken those notes, to use them afterwards for the purpose of publishing the lecture for profit" [13].

In *Caird v. Sime*, the court enjoined a bookseller from the publication and advertisement for sale of a book which the complainant claimed to contain mere reproductions of lectures he delivered to his University classes [14]. The court said that it was a "fact that professors and their representatives have been in frequent use to publish lectures which had been annually delivered for years before such publication, and have enjoyed, without objection or challenge, the privilege of copyright" [15]. The court also noted that the "relation of the professor to his students is simply that of teacher and pupil; his duty is, not to address the public at large, but to instruct his students; and their right is to profit by his instruction, but not to report or publish his lectures" [16].

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More than a century later, a United Kingdom appellate court considered the copyright ownership of lectures delivered by an engineer in the course of his employment with a private firm in the case of *Stevenson Jordan & Harrison Ltd v. Macdonald & Evans*[17]. It held that in the absence of clear stipulation in the contract of employment, it is the employee that owns the copyright, not the employer. It noted the example of Professor Maitland who taught at Cambridge University, and how inconceivable it would be if the University or anyone else for that matter would lay claim to the copyright in his lectures [18]. The court further stated that one might be employed under a contract of service and still performs services outside the contract. A teacher employed to give oral lectures to students is not required to reduce those lectures to writing. The written material is an "accessory" to the "contracted work but it is not really part of it. The copyright is in him and not in his employers" [19].

The 1990 case of *Noah v. Shuba*, upheld the copyright ownership of Dr. Noah (Professor of Epidemiology and Public Health at King's College) of "A Guide to Hygienic Skin Piercing" which he wrote while serving as an epidemiology consultant at the Public Health Laboratory Service (PHLS) that published the Guide [20]. Portions of the Guide were infringed by the defendant who claimed that PHLS owned the copyright in the work, not Dr. Noah, since it was part of his job to provide information that was covered in the Guide, that it was written with the use of PHLS time, equipment and secretarial staff who typed the script, and that if Dr Noah held the copyright, he would be in a position to prevent the dissemination of the Guide without his permission, which would affect the public interest. The court disposed of these arguments by

relying on the *Stevenson* case [21] and finding that PHLS had a long standing policy not to claim the copyright ownership over works produced by its staff, even in the course of their employment [22]. This case observes the long standing tradition recognized in *Abernethy*.

4. Reiteration of UK Position in Australia and Canada

The last two cases have been referenced by Australian commentators in discussing the rights of educators vis-à-vis universities [23].

A reiteration of the *Abernethy* ruling took place in Canada in the early part of this millennium. The 2003 case of *Dolmage v. Erskine* involved a three page business case study that was written by the plaintiff at the time when he was employed as an Assistant Professor at the University of Western Ontario, one of the defendants [24]. The work entitled "Sarah Binks Memorial" was written when he attended a case writing workshop conducted by two professors (the other defendants) at the defendant university. It was streamed, published and advertised for sale by Ivey Management Services (IMS), an entity controlled by the university. On later copies of the case study, the plaintiff's name was mixed with the two other professors, and in the catalogues and flyer for the same, the work was attributed to the two professors while the plaintiff's name was deleted. The work became one of IMS' best selling case studies during 1998-1999. The defendant university claimed that the plaintiff wrote the case study during his employment and

the university owned the copyright to it by law. Although the court found that the plaintiff validly assigned his copyright to the work to the university in writing, the court validated the academic tradition of excepting from university ownership the copyright over scholarly articles, authors and case works that academics produce. Noting the *Abernethy* case and citing the testimony of a witness, the court held that the university's ownership of the copyright in a professor's work is contrary to academic freedom and the educator exception.

5. The Questionable Status of the Educator Exception in the United States of America

The educator exception's existence has suffered the vicissitudes of time in the United States.

In the early and not often cited case of *Bartlette v. Crittenden* [25], the complainant, an instructor in book-keeping, wrote the system he taught on cards that he allowed his students to copy so they in turn could instruct others. One of his students became a teacher and used the material he copied from the complainant's cards. A student of the complainant's former student copied the material from the cards and placed them in the first ninety two pages of a book called "*An inductive and practical system of double-entry book-keeping, on an entirely new plan*". The complainant sought an injunction to restrain the publication of the book which the court granted. It was held that the complainant's permission for his students to copy his card manuscript did not constitute an abandonment of his right over the manuscript. His students had a right to use the

manuscript as the complainant originally intended, "[b]ut they have no right to a use which was not in the contemplation of the complainant and of themselves, when the consent was first given. Nor can they, by suffering others to copy the manuscripts, give a greater license than was vested in themselves" [26].

Tompkins v. Halleck [27] emphatically ruled, "where persons are admitted as pupils or otherwise to hear public lectures, it is upon the implied confidence and contract that they will not use any means to injure or take away the exclusive right of the lecturer in his own lecture" [28].

In *Sherill v. Grieves* [29], the court ruled that the permission granted by an educator to the institution to use portions of his book did not transfer the copyright over to the work to the institution, nor transfer the book into the public domain. The court emphasized that educators are generally employed to teach, not write books.

The California Court of Appeal in *Williams v. Weisser* [30] recognized the copyright ownership of a lecturer, instead of the university, over his lecture that comprised the notes compiled by him and his oral expression that constituted his delivery. This recognition allowed the lecturer to stop a company that hired students to write down the lectures and publish the lectures commercially without the lecturer's consent.

What is also of significance in this case is the recognition by the court that university ownership of lectures by an educator would bind the educator to the university for his or her academic life "for the university would have a right to his lectures and he could only go to another institution if he were to turn his attention to a new subject" [31]. The consequences of this can lead to the stagnation of knowledge and learning by educators and their students, and the derailment of the whole educational enterprise.

In *Hays v. Sony Corp. of America* [32], the Appellate Court recognized the copyright of two teachers over the work book they had created in the course of their employment for the use of their students on the operation of word processors by relying on the "teacher exception". The authority for this exception was admittedly "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" [33].

The Court further observed that despite the fact that college and university educators write for a living, and use their employer's resources in doing so, "the universal assumption and practice was that (in the absence of an explicit agreement as to who had the right to copyright) the right to copyright such writing belonged to the teacher rather than to the college or university" [34]. The Court was of the opinion that the teacher exception had not been abolished by the 1976 *Copyright Act* which did not mention it. The legislative history of the Act did not indicate any intent to do away with the exception. Furthermore, to entertain such notion would wreak havoc

in the practices of academia [35] where these creations actually contribute to the academic's standing in the academic community, in tenure issues, salary increases and other employment issues personal to the faculty, not the employer [36].

The indubitability of the educator's exception was questioned in *Weinstein v. University of Illinois* [37]. The dispute revolved around the order of the names of authors who were credited for a six page article published in an academic journal. The plaintiff, who was an Assistant Professor of Pharmacy Administration in the College of Pharmacy of the defendant University of Illinois at Chicago, claimed he had an agreement with his co-authors of the article that he would be the lead author. One of the other authors revised a draft the plaintiff had made and reversed the order of authors. The plaintiff claimed that the university denied him due process when he complained. The court considered the question whether the article was a work for hire and held that the 1976 *Copyright Act* "is broad enough to make every academic article a 'work for hire' and therefore vest exclusive control in universities rather than scholars" [38]. The defendant University's policy included among the works for hire those which were created by educators for specific employment requirements or assigned University duties or which were prepared at the University's instance and expense, "that is, when the University is the motivating factor in the preparation of the work" [39]. It also stated that a "university 'requires' all of its scholars to write. Its demands – especially the demands of departments deciding whether to award tenure – will be the motivating factor in the preparation of many a scholarly work" [40].

It must be noted however, that the court held that this policy seemed more applicable to administrative work, but observed that "[w]e do not say that a broader reading is impossible" [41]. One writer said that this case made the existence of the educator exception in the United States a matter of university policy [42].

Another case that had important consequences for the educator exception in the United States is *Community for Creative Non-Violence (CCNV) v. Reid* [43]. The court in looking at the question of whether or not a commissioned work fell under the work for hire doctrine will look at the type of the work (that is if it is a contribution to a collective work, or part of a motion picture or other audiovisual work, or a translation, or a supplementary work, or a compilation, or an instructional text, or a test, or material for answer to a test, or an atlas), and if the parties expressly agreed in a written instrument signed by them that the work would be considered a work made for hire [44]. The court also considered several factors under the Restatement common law agency doctrine like the source of the tools, the location of the work, duration of the parties' relationship, method of payment, discretion of the hired party as to how long and when to work, provision of employee benefits, and tax treatment of the hired party.

The result is that conflicting views are held on the survival of the educator exception. Some commentators have taken the *Reid* case as authority for the proposition that an educator exception is no longer necessary because the application of the Restatement agency factors would make the works of educators fall within the work for hire doctrine [45]. Some believe that

the educator exception was abolished by the fact that the 1976 US *Copyright Act* did not mention it [46]. Others believe the opposite [47]. There is no express, recent and authoritative judicial adoption or validation of either view. Even Nimmer's author on *Copyright* cannot give a definitive statement:

> Given that universities typically do not dictate the manner and means for a professor to reduce his lectures to writing…*perhaps such works still fall outside the work for hire doctrine even under the 1976 Act* (emphasis supplied) [48].

6. The Absence of Philippine Recognition of the Educator Exception

In the Philippines, although there is a law which provided for educators' "right to intellectual property consistent with applicable laws" [49] the educator exception itself is not recognized by any statute. There is also no case which establishes the exception, since no dispute of this nature has been presented or reached the Philippine Supreme Court. However, should one arise, it is likely that the Philippine courts will look for guidance to United States jurisprudence which is considered to have "persuasive merit" [50]. This is problematic because of the uncertainty on the status of the exception in the United States.