



## Academic Freedom, Copyright and the Academic Exception

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The academic and university are guardians of the public domain, where knowledge is freely generated and criticized. At the heart is academic freedom, the idea that university teachers and researchers have the right to pursue academic interests, research and publish, and engage in teaching and discussion without threats of institutional reprisals and arbitrary constraints. Intellectual property law, which views knowledge as property, may seem incompatible with this role of the university as the guardian of the public domain. Nevertheless, copyright applies to the research and publications of academics, and many innovations derived from university research are patentable. Of particular interest is the issue of copyright in course materials and lectures developed by university teachers. Copyright subsists in such works, but the issue arises as to whom that copyright is to be first allocated; to the academics who produce the work, or to the universities that employ them? In the wider world, the copyright for works produced in the course of employment typically vests in the employer, and not the creator of the work. However, academics have long received preferential treatment, viewed by the law as somehow different from other employees. This academic exception holds that first copyright resides in the academic, and not the institution.

In recent years, however, the academic exception has been shifted from a norm of practice to a legal question. New technologies, resulting in novel forms of educational delivery, are making course content a valuable commodity. Universities, eager for new sources of revenue, are asserting an interest in courses and course materials. Although few disputes have made it to the legal system, the nature of the interests in copyright ownership for universities and faculty suggest that legal disputes are likely to increase. A recent labor arbitration case, *University of British Columbia Faculty Association v. The University of British*

*Columbia (Re Dr. Mary Bryson and Master of Educational Technology) ("Bryson and MET")*,<sup>1</sup> is illustrative of many of the issues involved.

### ***Bryson and MET***

In 2000, the University of British Columbia (UBC) and the Tec de Monterrey (TdM) began collaborating on the development of a joint online Master of Educational Technology (MET) program (see Petrina, this issue of *Workplace*). In early 2002, Dr. Mary Bryson, an associate professor of the Faculty of Education at UBC, was asked to develop one of the MET courses in collaboration with a colleague, Dr. Stephen Petrina. The development of the MET program throughout 2002 necessarily involved the development of policies relating to intellectual property. During this time, a contract was prepared for faculty members involved in the development of MET courses.

It was only when Dr. Bryson returned from sabbatical to UBC in September 2002 that she first became aware of the contract faculty members were required to sign in order to design a course. It contained an intellectual property clause, which stated in part:

### **7.2 Original materials**

For greater clarity, Author Materials include:

- works created by an Author before this course was contemplated; and
- works created by an Author specifically for this course, but without significant input from individuals at the academic

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<sup>1</sup> *University of British Columbia Faculty Association v. The University of British Columbia (Re Dr. Mary Bryson and Master of Educational Technology)*(2004), available online at: <http://www.caut.ca/en/issues/academicfreedom/MaryBrysonArbitrationAward.pdf>.

or service units of the University working to develop and deliver MET.

For example, Author Materials include, without limitation, course outlines, case studies and student exercises. Each Author owns copyright in Author Materials. Each Author agrees that Author Materials may be used, in perpetuity:

- By the University and/or by Tec de Monterrey in connection with their joint MET; and
- By the University in connection with other courses to be offered in either electronic or paper media. ...

The University owns copyright in Course Materials. The University agrees that those elements of Course Materials that comprise "content" (including without limitation the syllabus, but excluding the "look and feel") may be used, in perpetuity, by an Author who contributed to the creation of those materials, for the purposes of teaching and/or publication.

The University owns copyright in the MET courses as a collective work.<sup>2</sup>

Several faculty members signed this agreement, while others, including Dr. Bryson, were concerned with the implications. She had not previously considered copyright as applicable to course materials. She later testified that the wording of the contract created a distinction between the course author and course material ownership, raising concerns about academic freedom, and control or oversight over course materials.<sup>3</sup>

Dr. Bryson entered into an extended email exchange with the Coordinator of the MET program, in an attempt to resolve her concerns. In particular, she wanted to know what components of the course she would retain copyright to, what components UBC would own, and what this meant for her academic freedom. The MET Coordinator, Dr. Gaskell, provided his opinion that:

[F]aculty members' intellectual property is protected within the MET contract. ... Particular pieces or objects written or developed by any of the 4 course authors that they want protected from future modification can be designated as author materials. Authors also have the right to continue to use these elements in other teaching and publishing that they do. However, the course as a whole is ultimately created and put on the web by a team of people employed by the universities and the two universities together will hold joint ownership to the course as a collective work.<sup>4</sup>

Further communications and consultations took place. In a later email, Dr. Gaskell stated that copyright of any material designated as author material would reside with the faculty member, and the copyright of the course as a whole would be granted to the university. Dr. Bryson had not been asked to sign a contract for any course she had previously developed. UBC's Policy 88 on intellectual property provides that "[o]wnership of and intellectual property rights to 'literary works' produced by those connected with the University are invested in the individuals involved."<sup>5</sup> The individuals who create "literary works" retain first author rights.

Dr. Bryson consulted with the Faculty Association, which advised its members not to sign any such individual contracts with the university. The Faculty Association took the position that it "is the sole bargaining agent for its members. It is...inappropriate for the University to ask members to sign a separate contract, with distinct provisions, in order to teach any courses— on-line or otherwise— as part of the faculty member's regular course-load."<sup>6</sup> Dr. Bryson ultimately refused to sign the MET agreement and was consequently dismissed from developing the MET course. The union then grieved, making two central submissions. First, that the attempt by the employer to negotiate directly with employees over terms and

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<sup>2</sup> *Ibid.* at 49-50.

<sup>3</sup> *Ibid.* at 57.

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<sup>4</sup> *Ibid.* at 61.

<sup>5</sup> *Ibid.* at 8, citing UBC's *Policy #88: Patents and Licensing*, in place since 1993.

<sup>6</sup> *Ibid.* at 68.

conditions of employment was a violation of the collective agreement. Second, that Dr. Bryson was discriminated against because of union activity, when she was dismissed from the MET program after taking the union's advice not to sign the agreement.

James Dorsey, Q.C. arbitrated the dispute and found for the union on both issues. The case primarily involves a labor dispute, but in the course of his decision Arbitrator Dorsey had much to say about copyright and academic freedom. He noted that, while the Canada *Copyright Act* generally provides that ownership of the copyright of work done in the course of employment resides with the employer,<sup>7</sup> it is generally accepted that academics employed by a university have first copyright ownership. This is known as the academic exception, and is considered to be essential to academic freedom. Arbitrator Dorsey stated:

Faculty members are expected to engage in scholarly activity and to produce and disseminate their scholarly work. Because of this expectation and to protect the unfettered pursuit of knowledge that is necessary for scholarship, it is accepted, in the context of employment at a university, that academic authors have copyright ownership of their writings... Ownership of the copyright in work produced in the course of employment by an academic author, rather than the university employer is important to support, foster and preserve academic freedom.<sup>8</sup>

This statement reflects a widely held view that there is something unique about work produced by academics that requires that it be treated differently than work created by other employees.

### **The Academic Exception**

#### *The Statutory Background*

The Canada *Copyright Act* states that the author of a work is the first owner of the

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<sup>7</sup> R.S.C. 1985, c. C-42, s.13(3).

<sup>8</sup> *Bryson and MET*, *supra* note 1 at 6-7.

copyright in that work.<sup>9</sup> The author is the person who actually creates the work.<sup>10</sup> However, section 13(3) of the Act provides that:

Where the author of a work was in the employment of some other person under a contract of service or apprenticeship and the work was made in the course of employment by that person, the person by whom the author was employed shall, in the absence of any agreement to the contrary, be the first owner of the copyright.

Thus, if three conditions are fulfilled, first ownership of the copyright belongs to the employer, rather than the author-employee: 1) the author must have been employed in a contract of service; 2) the work must have been created in the course of employment; and 3) there is no agreement to the contrary. If a person is hired to write a report, or to create an advertising campaign, the copyright in the work produced will belong to the employer, not to the employee. This situation is viewed as consistent with the expectations of the parties: "A person hired to produce material as part of her work normally expects copyright to be her employer's; for, without the hire, the work would probably not have been produced at all."<sup>11</sup> The salary or wage received by the employee is considered to be adequate reward for the effort involved. Today, university faculty are typically salaried employees of the university, and *prima facie*, section 13(3) of the Act should apply so as to deprive them of the copyright in course materials and other works produced as part of their employment. However, there is a long history of treating academics differently than other employees; the academic exception provides that first ownership of copyright belongs to the university teacher and researcher, rather than to the university.

#### *Development of the Academic Exception*

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<sup>9</sup> *Copyright Act*, *supra* note 7, s.13(1).

<sup>10</sup> David Vaver, *Copyright Law* (Toronto: Irwin Law, 2000) at 73.

<sup>11</sup> *Ibid.* at 84.

The ownership of academic work by those who create it was first explicitly recognized in the 1825 case of *Abernethy v. Hutchinson*.<sup>12</sup> Dr. Abernethy was a surgeon, who gave a series of lectures on surgery at the hospital at which he was employed. The defendant Hutchinson procured notes from someone in attendance at the first lectures, and published them verbatim in a periodical of which he was the editor. Dr. Abernethy sought an injunction preventing the publication of any further lectures, which was granted. In his judgment, Lord Chancellor Eldon held that those attending lectures are under an implied contract not to publish what they hear for profit; they can make notes for personal use, but they do not obtain any right to sell those notes.<sup>13</sup> It was argued that, because of the "peculiar" situation Dr. Abernethy filled at the hospital at which the lectures were delivered, he would be precluded from publishing his own lectures for profit; this appears to have been an attempt to characterize his position as a public one, and his lectures as part of the public domain.<sup>14</sup> However, Lord Eldon compared Dr. Abernethy to a university professor, and stated that there was no evidence before the court that such a professor appointed to provide information to his students did not have the right to restrain publication of lectures by others.<sup>15</sup> It was assumed that any copyright belonged to Dr. Abernethy, and no mention was made of any right of the hospital.<sup>16</sup>

An underlying issue in *Abernethy* was the right of an author to prevent publication of an unpublished work, or common law copyright. This issue was of particular importance in relation to lecturers, because if the oral delivery of the lecture amounted to publication, the author would have no right to restrain members

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<sup>12</sup> (1825), 47 E.R. 1313, 3 L.J. 209 (Ch.) [*Abernethy* cited to E.R., unless otherwise noted].

<sup>13</sup> *Ibid.* at 215 (L.J.).

<sup>14</sup> See Ann Monotti with Sam Ricketson, *Universities and Intellectual Property: Ownership and Exploitation* (Oxford: Oxford University Press, 2003) at 44; *Williams v. Weisser*, 78 Cal. R. 542 at 547 (2d Dist. 1969).

<sup>15</sup> *Abernethy*, *supra* note 12 at 1318.

<sup>16</sup> See *Weisser*, *supra* note 14 at 547.

of the audience from publishing the lecture in written form.<sup>17</sup> In *Abernethy*, it was held that, because Dr. Abernethy was employed as a surgeon, and giving lectures was not part of his duties, the lectures were private and not public communication, so publication had not occurred.<sup>18</sup> In a similar case, *Caird v. Sime*, a university professor sought an injunction preventing the publication of notes taken of his lectures by a student. It was held that the author, the professor, had "undoubted" copyright in his work.<sup>19</sup>

*Abernethy* and other early cases spent considerable time discussing common law copyright, and the significance of the context in which the material was communicated. Common law copyright was the right of first publication of any unpublished work, and the author could only restrain the publication of those works that had not yet been made publicly available. In Canada, the *Copyright Act* has replaced common law copyright. Today, copyright subsists in every original work, whether published or unpublished.<sup>20</sup> Section 3(1) of the *Copyright Act* provides that copyright includes the sole right to publish an unpublished work. Although common law copyright has been replaced by statutory rights, the right of first publication is essentially the same. Whether the right is common law or

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<sup>17</sup> In fact, shortly after *Abernethy*, the *Lectures Copyright Act, 1835* (U.K.), 5 & 6 Will. 4, c. 65 was passed. The Act provided, in section 1, that "the author of any lecture...shall have the sole right and liberty of printing and publishing such lecture." In section 3, it stated that "no person allowed for certain fee and reward, or otherwise, to attend and be present at any lecture delivered in any place, shall be deemed and taken to be licensed or to have leave to print, copy, and publish such lectures only because of having leave to attend such lecture or lectures." The Act was repealed by the *Copyright Act, 1911*, *infra* note 20.

<sup>18</sup> *Abernethy*, *supra* note 12 at 1315.

<sup>19</sup> *Caird v. Sime* (1887), 12 A.C. 326 (H.L. Scot.) [*Caird*].

<sup>20</sup> *Copyright Act*, *supra* note 7, s.5(1). In England, common law copyright was abolished by the *Copyright Act, 1911* (U.K.), 1 & 2 Geo. 5, c. 46, s.1.

statutory copyright, the issue is who owns the original copyright. In the case of common law copyright, the author had the right to restrain publication by others until he or she had first done so. In the case of statutory copyright, the copyright-holder (usually the author) has the right to prevent any unauthorized publication. Therefore, the earlier decisions are not irrelevant under the current regime.

*Abernethy* and *Caird* both involved a dispute between a professor and someone who profited from publishing notes of the lectures, rather than the allocation of rights between the professor and the employing institution. The dispute was essentially the same in *Williams v. Weisser*, a leading American case.<sup>21</sup> In that case, the defendant hired students to take notes in classes offered at the University of California (UCLA). The notes were then reproduced and sold as "Class Notes," with a copyright notice in the defendant's name. The plaintiff, an anthropology professor, objected to this use of notes taken in his classes, and sought a permanent injunction and damages. However, unlike in *Abernethy* and *Caird*, the defendant in *Weisser* argued that the university, and not the plaintiff, was the owner of the copyright in the course materials, and therefore the plaintiff had no basis for his action. The court rejected this argument, and after reviewing both American and English cases, found that, "in the absence of evidence the teacher, rather than the university, owns the common law copyright to his lectures."<sup>22</sup> Referring to *Abernethy* and *Caird*, Justice Kaus noted that the "fact that none of the defendants—pirates all—ever thought that the question of the institution's rights, as such, was worth raising is surely not without significance."<sup>23</sup>

In *Sherrill v. Grieves*, an instructor at a U.S. Army officer training school produced a book on military sketching, map reading and surveying, and it was held that the instructor, not the U.S. government, owned the copyright.<sup>24</sup> It was argued in *Weisser* that *Sherrill* should be distinguished on the grounds that in that case the

Army instructor produced the book in his spare time. However, Justice Kaus held that such a distinction was "illusory." He stated: "There is no real difference between Sherrill and the plaintiff. Neither was under a duty to make notes, neither was under a duty to prepare for his lectures during any fixed hours, but the notes each made did directly relate to the subjects taught."<sup>25</sup> Justice Kaus considered the work for hire provisions of American copyright law<sup>26</sup> in relation to academics, and stated that:

The many cases cited by the defendant for the general rule probably reach desirable results that are in accord with common understanding in their respective areas, but a rule of law developed in one context should not be blindly applied in another where it violates the intention of the parties and creates undesirable consequences. University lectures are *sui generis*.<sup>27</sup>

Ultimately, Justice Kaus ruled that neither authority nor common sense supported the contention that the copyright belonged to the university, but in fact supported the opposite conclusion, that the copyright in the lecture notes belonged to the professor.<sup>28</sup>

<sup>25</sup> *Weisser*, *supra* note 14 at 549.

<sup>26</sup> The work for hire provisions in American copyright law are essentially the same as those found in s.13(3) of the Canadian Act: While ownership of copyright initially vests in the author of a work, where an employee prepares a work within the scope of his or her employment, or where the work is specially commissioned, the initial owner is the employer, or person for whom the work was prepared: *Copyright Act 1976* (U.S.C. Title 17, § 101, 201). The previous Act, under which *Weisser* was decided, was the *Copyright Act, 1909*, c. 320, 35 Stat. 1075, which stated, at § 62, that "the word 'author' shall include an employer in the case of works made for hire."

<sup>27</sup> *Weisser*, *supra* note 14 at 547.

<sup>28</sup> *Ibid.* at 550. It should be noted that this reasoning may no longer apply in the United States. American copyright law underwent a major revision in 1976, and the new legislation

<sup>21</sup> *Weisser*, *supra* note 14.

<sup>22</sup> *Ibid.* at 545.

<sup>23</sup> *Ibid.* at 547.

<sup>24</sup> 57 Wash. L.R. 286 (1929 D.C.).

There are few Canadian cases involving the allocation of ownership of copyright between academics and universities. The only case cited by Arbitrator Dorsey in *Bryson and MET* in support of the academic exception was *Dolmage v. Erskine*, an Ontario Small Claims Court case.<sup>29</sup> In that case, the plaintiff Dolmage was a fixed term Assistant Professor employed by the Faculty of Education at the University of Western Ontario (UWO). He attended a business case writing workshop held by the UWO business school, run by the defendants Erskine and Leenders. Dolmage wrote a business case as part of the workshop, which was subsequently published by the business school's publishing division. Over time, the attribution on the business case changed, from originally listing Dolmage as the writer, to eventually stating "Rod Dolmage prepared this case under the supervision of Professors M.R. Leenders and J.A. Erskine."<sup>30</sup> Dolmage sued for copyright infringement, and the defense relied partly on the argument that the case was written in the course of Dolmage's employment by UWO. After reviewing *Abernethy* and *Weisser*, as well as UWO's copyright policy (which provided that first ownership of copyright belonged to faculty), the court concluded that:

The academic exception is pervasive in the university community. It has been thoroughly understood and accepted for a very long time, including the 80 years the Act has been in force. It applies to the plaintiff's case. Academic exception is an implied "agreement to the

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does not contain any reference to an academic exception, which has caused some commentators to suggest it may not have survived the modifications, although the issue is unclear. See Corynne McSherry, *Who Owns Academic Work?: Battling for Control of Intellectual Property* (Cambridge, Mass.: Harvard University Press, 2001) at 107; and Monotti, *supra* note 14 at 278-83.

<sup>29</sup> (2003), 23 C.P.R. (4<sup>th</sup>) 495 (Ont. Sup. Ct. (Sm. Cl. Div.)).

<sup>30</sup> *Ibid.* at 514.

contrary" within the meaning of s.13(3) of the Act.<sup>31</sup>

Dolmage ultimately lost his claim for copyright infringement because he was found to have assigned the copyright to the university. However, the case represents the view that the default position is that first ownership of copyright belongs to academics, and not to the universities that employ them.

### Challenging the Exception – Emerging Issues

The academic exception has a long history, and seems well-established. The dearth of cases on the issue has been taken as a sign that the exception is so well accepted that it has rarely been challenged.<sup>32</sup> In *Weisser*, Justice Kaus could plausibly state that "[n]o reason has been suggested why a university would want to retain the ownership in a professor's expression. Such retention would be useless except possibly for making a little profit from a publication."<sup>33</sup> Those words were written in 1969, and as *Bryson and MET* demonstrates, today online education holds promise of significant revenues.<sup>34</sup> Distance education, as described by Arbitrator Dorsey in *Bryson and MET*, "enables students to study at a distance from the persons who prepared the teaching material," through correspondence of some kind, including postal service, and radio or television.<sup>35</sup> Online learning is a form of distance education, in which course materials are made available via the web, and correspondence is through courseware, email, videoconferencing, or other means.<sup>36</sup>

Copyright issues in distance education are not entirely new. In the early 1970s, Harry Bloom discussed the problems that had arisen in the context of England's Open University, which

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<sup>31</sup> *Ibid.* at 521.

<sup>32</sup> Monotti, *supra* note 14 at 279, citing *Hays v. Sony Corp. of America*, 847 F. 2d 412 (U.S. 7<sup>th</sup> Cir., 1988).

<sup>33</sup> *Weisser*, *supra* note 14 at 546.

<sup>34</sup> There are even greater profit motives at work regarding patentable research and computer software, but the focus of this paper is on copyright.

<sup>35</sup> *Bryson and MET*, *supra* note 1 at 19.

<sup>36</sup> *Ibid.* at 19-20.

used the BBC as well as the postal service to deliver courses.<sup>37</sup> Bloom raises several issues which remain relevant: 1) whether or not course materials are produced "in the course of employment;" 2) the fact that distance education materials, unlike traditional course materials, require the use of university resources to produce; and, 3) the fact that curriculum materials are usually produced by a team, including technicians and administrators. Further, even if the academic is acknowledged as owning the content of the course, universities may try to "sweep it up" by claiming ownership of the audio-visual, (or print-based, or now digital, package produced).<sup>38</sup>

The resources required to develop an online course are used as justifications for university ownership.<sup>39</sup> For the MET program, courses were to be developed by teams of project managers, programmers, graphic designers, and others, as well as faculty members, or "content experts."<sup>40</sup> Development was to be a team effort, drawing on significant university resources. It is also clear that the university wanted to be able to offer courses for an indefinite period, regardless of whether the developing instructors remained at the university. In such a situation, a university would understandably wish to find a method of protecting its investment.

The Canadian Association of University Teachers (CAUT) has issued bargaining advisories regarding online education, recognizing that administrations are asserting ownership rights to online course content, on the bases of technical support supplied by the university, as well as the mixing of faculty content with university-owned software.<sup>41</sup> The

CAUT notes that new technologies have the potential to "unbundle" the faculty member's job: they allow "the role of the teacher to be divided into course creator, deliverer, reviser, tutor and grader."<sup>42</sup> The Advisory suggests collective agreement language to strengthen faculty ownership of course content, as well as oversight over the use and revision of such content. Faculty ownership of course content is necessary to protect academic freedom, by ensuring faculty are able to alter and update the course when necessary.<sup>43</sup> It is also clear from the Advisory that faculty ownership is about job security: "The alternative is the casualization of university teaching wherein course content is separated from its creator and its delivery is performed by a pool of contract employees with little or no job security."<sup>44</sup> Academic freedom is largely about autonomy: according to Corynne McSherry, "[d]efense of the professorial copyright is defense of the profession itself."<sup>45</sup>

McSherry views this assertion of faculty ownership of copyright as a "second academic revolution," in which "faculty copyrights are being constructed as badges of autonomy, independence and control."<sup>46</sup> She identifies the "first academic revolution" as the emergence of the research university in the nineteenth century as the guardian of a public domain of science and knowledge.<sup>47</sup> McSherry acknowledges that universities have always had close ties to government and industry, but argues that "the value of the academy's intellectual products still derived from its positioning outside the market."<sup>48</sup> Universities existed in contrast to intellectual property law, as a public domain of knowledge against which the domain of private knowledge could be justified—justified because there exists a realm of knowledge freely

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<sup>37</sup> Harry S. Bloom, "The Teacher's Copyright in His Teaching Materials" (1972-73) 12 J. Soc'y Pub. Tchrs. L. 333 at 334.

<sup>38</sup> *Ibid.* at 338.

<sup>39</sup> In *Bryson and MET*, it was noted that the MET program was allocated a budget of two million dollars over seven years for development and delivery. *Supra* note 1 at 33.

<sup>40</sup> *Ibid.* at 34.

<sup>41</sup> Canadian Association of University Teachers, "Bargaining Advisory: Online Education" (Jan. 2001), online:

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<http://www.caut.ca/en/publications/bargaining/jan2001onlineeducation.pdf>, at 1. The American Association of University Professors (AAUP) has issued similar bargaining advisories.

<sup>42</sup> *Ibid.*

<sup>43</sup> *Ibid.* at 3.

<sup>44</sup> *Ibid.* at 5.

<sup>45</sup> McSherry, *supra* note 28 at 108.

<sup>46</sup> *Ibid.* at 102.

<sup>47</sup> *Ibid.* at 55-58.

<sup>48</sup> *Ibid.* at 57.

available to all.<sup>49</sup> However, this dichotomy is eroding, and universities increasingly view knowledge produced within their walls as exploitable property. In response, faculty ownership of copyright is offered as one way in which "the commodification of education and the proletarianization of the professoriate" can be prevented.<sup>50</sup> As Dr. Bryson put it, "Because the administration was treating the material as property, my unhappy response had to be to view it in the same way and assert my rights."<sup>51</sup>

Universities are increasingly driven by commercial activities, and assuming a corporate model, leading to what has been described as the emergence of the "enterprise university."<sup>52</sup> The corporate or enterprise university is still a center of teaching and research, but it is also concerned with revenue. Reduced government funding, and the need for alternative sources of funding, as well as the commercialization of research, are identified as reasons for this development.<sup>53</sup> Additional issues of ownership arise where third parties are involved, such as government funding agencies, and particularly industry funding sources, which often attach conditions to funding, such as allocation of intellectual property rights. Such third party issues are more likely to arise in the context of patents than of copyright; however, the ability to publish the results of research are generally affected.

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<sup>49</sup> See *ibid.* at 63-64.

<sup>50</sup> *Ibid.* at 103.

<sup>51</sup> CAUT, "Landmark Academic Freedom Decision at UBC" *Bulletin Online*, (April 2004) 51:4, online: [http://www.caut.ca/en/bulletin/issues/2004\\_apr/default.asp](http://www.caut.ca/en/bulletin/issues/2004_apr/default.asp).

<sup>52</sup> Monotti, *supra* note 14 at 38-40, discussing an Australian study by S. Marginson and M. Considine: *The Enterprise University: Power, Governance and Reinvention in Australia* (Cambridge, UK: Cambridge University Press, 2000). See also David Lametti, "Publish and Profit?: Justifying the Ownership of Copyright in the Academic Setting" (2000-2001) 26 *Queen's L.J.* 497 at 511. See also Petrina & Weir, this issue of *Workplace*.

<sup>53</sup> Monotti, *ibid.* at 39. One assumes that the need for other sources of revenue is itself motivating the commercialization of research.

### Exception to the Exception, or Implied Agreement Otherwise?

Given these concerns of the university to protect its investment on the one hand, and of faculty to maintain control of their profession on the other, disputes over academic copyright ownership are increasing. As *Bryson and MET* demonstrates, intellectual property is a significant issue for employers and unions, and will continue to be an issue in collective bargaining. As such, it is important to determine the default legal position: must faculty negotiate for the right to own the copyright in academic work, or do they already possess that right, which they must be careful not to bargain away? The CAUT clearly believes the latter, and its bargaining advisories encourage strengthening "traditional" faculty ownership.<sup>54</sup> However, there are several ways of viewing the academic exception.

David Lametti suggests three potential interpretations of section 13(3) of the *Copyright Act*, in the context of university faculty: 1) a literal interpretation, in which copyright belongs to the employer unless there is an express agreement otherwise; 2) that the employment relationship between academics and universities is sufficiently different that section 13(3) should not apply at all; and 3) that section 13(3) does apply to the academic context, but scholarly work is exempted either because it does not fall within the scope of employment, or because of an implicit agreement that copyright belongs to faculty.<sup>55</sup> The first interpretation, though a plausible reading of the *Act*, clearly is not supported by tradition or jurisprudence. Lametti ultimately concludes that copyright should in most cases belong to faculty, on either the second or third interpretation, but he does so on policy reasons, which will be discussed below. It is the third interpretation that is most commonly encountered, and which is the basis for the academic exception: section 13(3) applies, but

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<sup>54</sup> See CAUT, "Bargaining Advisory: Intellectual Property" (Sept. 2004), online: [http://www.caut.ca/en/publications/bargaining/2004sept\\_ip.pdf](http://www.caut.ca/en/publications/bargaining/2004sept_ip.pdf).

<sup>55</sup> Lametti, *supra* note 52 at 517-18.



copyright in scholarly work still belongs to faculty.

Recall the wording of section 13(3): Where the work is made *in the course of employment*, the employer, *in the absence of any agreement to the contrary*, is the first owner of the copyright. Section 13(3) is an exception to the general rule that the author is the first owner of copyright: copyright only belongs to the employer if all conditions are fulfilled. Thus, if the work is not created in the course of employment, or if there is an agreement to the contrary, copyright belongs to the author. The academic exception can be viewed as just that, an exception to the 13(3) exception, on the basis that academic work somehow does not fall under a strict "in the course of employment" interpretation, as other work does. Alternatively, the academic exception can be viewed as creating an implied agreement that copyright belongs to the author and not the employing institution. Courts and commentators offer both views, although it appears that the latter has overtaken the former.

#### *Outside the Scope of Employment*

As indicated, courts have historically found that writings and lecture notes were outside the scope of the academic's employment. In *Abernethy*, the plaintiff's duties as a surgeon at the hospital were entirely distinct from his role as a lecturer, and the court found no evidence that his employment by the hospital should in any way prevent him from publishing his own lectures for profit.<sup>56</sup> In *Weisser*, the purpose for which a university hires a professor was held to be to make the content of a course available for study. However, the court continued that, "neither the record in this case nor any custom known to us suggests that the university can prescribe his way of expressing the ideas he puts before his students."<sup>57</sup> In this way, a university professor is different from an employee for hire, because the employer cannot direct the manner, form or timing of any copyrightable work.

There is a legal distinction between employment that involves a contract *for* services,

and that involving a contract *of* service. The English Court of Appeal, in *Stevenson v. Macdonald*, stated that the distinction between the two was that, in the former "the master [employer] can order or require what is to be done, while in the [latter] he can not only order or require what is to be done but how it shall be done."<sup>58</sup> A person under a contract for services is often referred to as an independent contractor. However, it is possible even for a person employed under a contract of service to perform services outside the contract. It has often been argued that university teachers are employed to give lectures, but not necessarily to write down those lectures, and therefore any such writings are outside the scope of employment. David Vaver provides the example of a professor employed to teach copyright law: "His contract may oblige him also to do research, but he usually breaks no obligation of his contract if he does not publish (although he risks losing promotion, tenure, or contract renewal)."<sup>59</sup> Even if the terms of employment require publication, it is unlikely that these terms will provide any specific direction as to what to publish, or the content, timing or means of publication.

Ann Monotti suggests that it is difficult in any individual case to determine whether the work at issue falls within the scope of employment.<sup>60</sup> She notes that any employment contract is likely to describe the duties that fall within the scope "with a mix of specific and general terms," and may incorporate by reference various statutory provisions, rules, and

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<sup>58</sup> *Stevenson Jordan and Harrison, Ltd. v. Macdonald and Evans*, [1952] 1 T.L.R. 101 (C.A.) [*Stevenson v. Macdonald*]. Decisions of the English Court of Appeal (and even more so of the House of Lords), while not binding on Canadian courts, are persuasive. English law is, in many areas, applicable in the Canadian context.

<sup>59</sup> Vaver, *supra* note 10 at 88. Lametti, *supra* note 52 at 509, also notes that the argument that the obligation to publish places academic work within the scope of employment becomes particularly problematic once a professor achieves tenure.

<sup>60</sup> See Monotti, *supra* note 14 at 100-103.

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<sup>56</sup> *Abernethy*, *supra* note 12 at 1318.

<sup>57</sup> *Weisser*, *supra* note 14 at 546.

agreements.<sup>61</sup> Certain duties may be described with relative precision, while others may be quite vague. Vaver suggests the following test, which consists of two questions:

(1) Would the worker have broken her contract by not producing the work in the form she did? (2) Would the acquisition or retention of copyright by the worker be inconsistent with her duty of good faith and loyalty to her employer? If either question is answered yes, the employer should own the copyright. If both questions are answered no, the copyright belongs to the worker.<sup>62</sup>

In the context of academic work, it would generally seem that the answer to both questions should be no. However, what falls within the scope of employment may depend to a great extent on the terms of the particular contract.

In certain circumstances it is reasonable to view academic works as being outside the scope of employment, particularly in the case of traditional works such as lecture notes and academic papers. However, in other circumstances, it would seem that the work is exactly what the academic was employed to produce. In relation to England's Open University, Bloom noted that the content providers were in a unique legal position, "since they are employed specially to produce its teaching materials."<sup>63</sup> Distance education and online learning can pose problems, because the faculty member employed to provide the course content is likely to be faced with a question of format. In particular, the work will of necessity have to be produced in some enduring material form, rather than merely orally.<sup>64</sup> Thus, while the ideas may still be entirely up to the faculty member, the expression is likely to be specifically defined, and copyright applies to the expression rather than to the idea.

A further complication is raised by *Bryson and MET*. At issue was whether or not

the university could properly negotiate with individual faculty members regarding the assignment of copyright. Arbitrator Dorsey acknowledged that an employer is entitled "to deal directly with individual employees on routine matters related to the administration of the collective agreement."<sup>65</sup> However, the employer cannot negotiate directly with individual employees on central and significant terms and conditions of employment. Arbitrator Dorsey found that, "in the university context, because of the importance of the expression of ideas to academic freedom and the presumptive first ownership of copyright in faculty, issues related to copyright are part of the core of the relationship between employer and employee. They are part of the conditions of employment."<sup>66</sup> Therefore, in the university context, issues relating to copyright are so central to employment that they fall within the scope of issues for which the union has exclusive bargaining authority. While the decision has been hailed by the CAUT as a "stunning win" and a "remarkable achievement," both for labor and academic freedom,<sup>67</sup> it would seem to have potential implications for the view that academic work is outside the scope of employment. It is difficult to see how copyright issues can be "central and significant terms and conditions of employment," and at the same time, outside the course of employment. If this is so, there will be a greater need to rely on the idea that the academic exception is an implied agreement that copyright resides with faculty.

#### *Implied Agreements*

Section 13(3) of the *Copyright Act* allows for the alteration of the statutory position by agreement between author and employer. Express agreements will certainly be effective, and many university-faculty collective agreements, as well as university policies, contain some provision dealing with copyright and intellectual property.<sup>68</sup> However, implied or

<sup>61</sup> *Ibid.* at 100.

<sup>62</sup> Vaver, *supra* note 10 at 86.

<sup>63</sup> Bloom, *supra* note 37 at 334.

<sup>64</sup> Monotti, *supra* note 14 at 271.

<sup>65</sup> *Bryson and MET*, *supra* note 1 at 84.

<sup>66</sup> *Ibid.* at 88.

<sup>67</sup> CAUT "Landmark Decision," *supra* note 51.

<sup>68</sup> For example, University of Saskatchewan Faculty Association 2002-05

unwritten agreements can also be effective,<sup>69</sup> and the academic exception can be viewed as an implied agreement regarding copyright ownership. In *Bryson and MET*, Arbitrator Dorsey stated that academic copyright ownership "can be characterized as the academic or teacher exception to the presumption of first ownership of copyright in the employer or it may be treated as an implied agreement to the contrary based on custom, tradition, practice or a common and shared understanding."<sup>70</sup> In *Dolmage v. Erskine*, the court found that there was no agreement between the plaintiff and the employing university as to copyright ownership. However, it was held that the academic exception "has been thoroughly understood and accepted for a very long time, including the 80 years the Act has been in force. ... Academic exception is an implied 'agreement to the contrary' within the meaning of s. 13(3) of the Act."<sup>71</sup> It is the long history and widespread acceptance of the exception that creates the implied agreement; because it is generally assumed that academics retain copyright in their works, it must be expressly agreed that they will not.

Two practices in particular provide evidence of an implied agreement in academic contracts of employment.<sup>72</sup> First, there is a long

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Collective Agreement provides, in section 28, that the employee is the sole copyright holder of the following works produced by the employee: lectures delivered, artistic works, printed works, computer programs, and recorded works (except, in the case of the latter three, where the work is part of the employee's assigned duties). Online: [http://www.usask.ca/hrd/docs/usfa\\_ca-2002-2005.pdf](http://www.usask.ca/hrd/docs/usfa_ca-2002-2005.pdf). In *Bryson and MET*, *supra* note 1 at 8, reference was made to UBC's "Policy #88," which provided that for literary works, "[o]wnership of and intellectual property rights to 'literary works' produced by those connected with the University are invested in the individuals involved."

<sup>69</sup> Vaver, *supra* note 10 at 86.

<sup>70</sup> *Bryson and MET*, *supra* note 1 at 7 (emphasis added).

<sup>71</sup> *Dolmage v. Erskine*, *supra* note 29 at 521.

<sup>72</sup> See Monotti, *supra* note 14 at 277.

history of university non-interference with academics in arranging for the publication of books and articles with third party publishers. In *Caird*, in 1887, Lord Watson noted that professors were in the habit of publishing their lectures "without objection or challenge."<sup>73</sup> The situation has generally remained unchanged. It was noted in *Bryson and MET* that UBC "does not become involved in negotiations between faculty members and publishers."<sup>74</sup> The ability of faculty to control publication is an important component of academic freedom. For example, the University of Saskatchewan Faculty Association 2002-05 Collective Agreement recognizes this, and under the heading "Academic Freedom" states: "The common good of society depends upon freedom in the search for knowledge and in its exposition. ... Accordingly, all employees...are entitled to the exercise of their rights as citizens and to freedom in carrying out research *and in publishing its results*."<sup>75</sup>

The recent English case of *Noah v. Shuba* is closely analogous.<sup>76</sup> Noah, a doctor employed by the Public Health Laboratory Service (PHLS), wrote *A Guide to Hygienic Skin Piercing*. Noah sued Shuba for copyright infringement, and the court rejected Shuba's

<sup>73</sup> *Caird*, *supra* note 19 at 345.

<sup>74</sup> *Bryson and MET*, *supra* note 1 at 11.

<sup>75</sup> U of S Collective Agreement, *supra* note 68, s.6.1 (emphasis added). McSherry, *supra* note 28 at 107, notes the irony of faculty fighting to retain copyright in their works from universities, only to turn around and assign that copyright to publishers. However, in the case of publication, the academic loses control of the copyright after publication, rather than before, which would be the case if the original copyright belonged to the university. As will be discussed below, the academic is likely to be both in the best position to know when a work is ready for publication, and most interested in seeing the work published. Perhaps the public interest is still best served by recognizing first copyright in the academic, however short a period the academic retains that copyright.

<sup>76</sup> *Noah v. Shuba*, [1991] F.S.R. 14 (Ch.). Described in Monotti, *supra* note 14 at 277-78.

claim that the copyright belonged to the PHLIS instead of Noah. The PHLIS had a long practice of allowing employees to retain copyright in articles they wrote in the course of employment, and on this basis the court was prepared to find that an implied contractual term existed which assigned copyright to the employee. Thus, a longstanding practice of allowing employees to retain copyright can develop into an implied agreement that such an arrangement is a term of employment. If an implied contractual term can develop out of the historical practices of one institution, as in *Noah v. Shuba*, with how much more force must such reasoning apply to the university context, involving centuries of practice at hundreds of institutions in many countries?

The second practice evidencing an implied agreement is found in the movement of academics between universities. It has been the practice that, when faculty members move from one university to another, they are allowed to take with them research, course materials, and other work produced in the course of their employment at the one institution for use at the other.<sup>77</sup> Justice Kaus, in *Weisser*, observed: "Professors are a peripatetic lot, moving from campus to campus. The courses they teach begin to take shape at one institution and are developed and embellished at [the] other."<sup>78</sup> If the universities, and not the professor, owned the copyright in course materials, Justice Kaus noted several potential problems that could arise when an academic moved to a different institution.<sup>79</sup> If a course developed at University A was taught at University B, the copyright of the first would be infringed, and University A would be able to prevent the teaching of the course at University B. Such a situation would have profound implications for academic freedom, not to mention the everyday conduct of teaching. A related problem would be the necessity of determining the extent to which a course had been developed by an academic prior to his or her employment at the university, because the academic would have the copyright in materials

developed on his or her own time. Monotti raises even more complicated scenarios, such as where research is funded by two or more universities, or by industry or government partnerships.<sup>80</sup> In practice, the difficult task of determining when and where and to what degree particular acts of creation occurred do not arise, at least in relation to copyright. This is because universities do not challenge the ownership of copyright by academics, reinforcing the tradition of the academic exception, and the implied agreement that results.

A few observations about the general legal position can be made. Academic employees would seem to *prima facie* fall under the provision of section 13(3) of the *Copyright Act*. However, the position of academics is unique, and will in most cases not meet all the criteria required to give effect to section 13(3). In many cases, the work produced by researchers and faculty members will not, strictly speaking, fall within the course of employment, especially on the test proposed by Vaver. In certain circumstances, however, the terms of a particular contract of employment may be specific enough that the work will fall under the scope of employment, such as where a faculty member is specifically contracted to provide content for an online course. The Act also provides that the operation of section 13(3) can be varied by agreement between the academic and the university. Such an agreement may be express, as in a collective agreement or in a university policy statement, but it may also be implied. Where the terms of employment are silent as to the allocation of copyright, the long tradition of

<sup>77</sup> Lametti, *supra* note 52 at 510; CAUT Online, *supra* note 41 at 5-6.

<sup>78</sup> *Weisser*, *supra* note 14 at 546.

<sup>79</sup> *Ibid.*

<sup>80</sup> Monotti, *supra* note 14 at 103-104. *Bryson and MET*, *supra* note 1 at 33, provides an example of one type of problem. In that case, UBC and TdM entered into an agreement as to the allocation of intellectual property rights, agreeing that both institutions would hold joint ownership of the core courses, which then limited UBC in its ability to negotiate with faculty. More difficult situations may arise, for example where the academic participates in a program funded by two or more institutions that do not have formal agreements between them, each with different policies on intellectual property allocation.

allowing academic ownership of copyright apply as an implied agreement to that effect. Each situation is somewhat unique. The presence or absence of an agreement, and its terms, as well as the particular terms of employment and the nature of the work at issue, are factors militating in one direction or another. However, in general, the default position is that first copyright belongs to the academic author, and not to the university.

### Justifying the Academic Exception

If the legal position is that, generally speaking, academics own the copyright to works they produce, the question remains as to whether this is a justifiable allocation of ownership. A wide range of justifications are offered, and the consensus is that the academic exception is both necessary and desirable. One basis on which academic ownership is justified is that practical difficulties result if the situation were otherwise. Some of these difficulties were suggested above, such as the effect on academic mobility. Recall that the court in *Weisser* noted that, if universities owned copyright, an academic teaching a course developed at another university would be infringing on the copyright of that prior university.<sup>81</sup> Vaver states that "employee mobility would be reduced, for educators could not effectively deploy their expertise elsewhere once they lost copyright in their course material to their institution."<sup>82</sup> The CAUT asserts a right to delivery—availability of a course must "remain contingent on the availability and desire of the faculty member who developed and owned it to teach it."<sup>83</sup> The CAUT views this right as integral to the job security of faculty, but notes that of greater concern to society is academic freedom, guarding against a system under which university copyright owners could prevent the mobility of academics, and their ability to fully and freely pursue and disseminate knowledge.

Another practical difficulty involves students. Students are not employed by universities, and therefore section 13(3) will not apply to work they produce in the course of their

studies. Students own first copyright in their coursework and research.<sup>84</sup> It is not uncommon for graduate students, in particular, to collaborate with faculty in research. Where a work is jointly created, copyright is co-owned.<sup>85</sup> Thus, if the university owned the copyright in work produced by faculty, the result would be that the work jointly produced by the student and faculty member would be jointly owned by the student and the university. Lametti suggests that this allocation would be unfair, assuming the faculty member has made a similar intellectual contribution.<sup>86</sup> The salary received by the faculty member could be characterized as an adequate reward, but the student also receives a reward in the form of course credit, and the fulfillment of degree requirements.

On the other hand, the ownership of copyright by academics creates certain practical difficulties for universities. Universities require affordable access to scholarly work, particularly journals, and also require the ability to use such works for educational purposes.<sup>87</sup> The problem arises from the fact that academics routinely assign copyright in any work to be published to a publisher, the academic retaining only a license to use the work.<sup>88</sup> Once the author has assigned

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<sup>84</sup> Vaver, *supra* note 10 at 88. See *e.g.* *Breen v. Hancock House Publishing Ltd.* (1985), 6 C.I.P.R. 129 (F.C. T.D.), and *Boudreau v. Lin* (1997), 150 D.L.R. (4<sup>th</sup>) 324 (Ont. Gen. Div.). Of course, this allocation could also be set aside by agreement, such as where a student signs a declaration that the intellectual property rights in any work produced will vest in the university, perhaps in an application for admission form.

<sup>85</sup> See *Copyright Act*, *supra* note 7, s.2 "work of joint authorship"; and Vaver, *supra* note 10 at 75-79, for the requirements of joint authorship. Vaver, *ibid.* at 78, states that joint authors will usually hold copyright in common in equal shares, but that this presumption can be displaced, depending on the common intention of the parties.

<sup>86</sup> Lametti, *supra* note 52 at 512.

<sup>87</sup> Monotti, *supra* note 14 at 337.

<sup>88</sup> For example, the *Saskatchewan Law Review* requires authors to sign an agreement which states, in part: We will accede to any requests by you to use part or all of your article

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<sup>81</sup> *Weisser*, *supra* note 14 at 546. See text accompanying note 79, *supra*.

<sup>82</sup> Vaver, *supra* note 10 at 88.

<sup>83</sup> CAUT Online, *supra* note 41 at 6.

the copyright to the publisher, it is the publisher who determines the price at which a university (generally the libraries) can buy back the published work, and in the case of certain scholarly journals, the price can be thousands of dollars annually. One proposed solution is for universities to claim copyright in the works produced by their faculty, requiring publishers to deal with the institution rather than the individual author, and giving universities control over the terms of publication.<sup>89</sup> A university could provide the publisher with merely a license to publish, or alternatively, could assign copyright while retaining a university-wide license for use. However, the transaction costs involved for a university to administer all the copyrights, licenses and assignments of its faculty may outweigh any benefit received.<sup>90</sup> Universities also require the use of academic works for educational use, including classroom use. However, in Canada and the United States the issue is unlikely to pose much difficulty, given the "fair dealing" and "fair use" provisions in copyright law. The Canada *Copyright Act* allows use of copyrighted materials "for the purpose of research or private study."<sup>91</sup> In *CCH*

*Canadian Ltd. v. Law Society of Upper Canada*, the Supreme Court gave a broad interpretation to the fair dealing exception, and it is likely that most classroom use will not constitute copyright infringement.<sup>92</sup>

Arguments based on practical difficulties are equivocal. Although problems result from allocating copyright to universities, rather than to academics, there are also problems resulting from the reverse situation. If university concerns can be addressed through carefully crafted licenses, it would seem that the alternative should also be true, that problems created by university ownership could be addressed by licenses granted to the academic-author (such as a perpetual, worldwide, license to use the work for teaching and research purposes, without need to seek permission). However, as Vaver notes, the university employer is in the better position to negotiate the terms of employment.<sup>93</sup> Given the greater ability of the university to negotiate necessary licensing terms, arguments based on practical difficulties tilt slightly in the direction of academic ownership.

The academic exception has also been justified on the grounds that it promotes and protects academic freedom, particularly the freedom to disseminate knowledge. Monotti describes academic freedom as follows:

In the case of research, the spirit of free inquiry means that the unfettered exchange of ideas and intellectual debate is the most effective means of promoting production and dissemination of the kinds of knowledge the wider

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in a work published under your exclusive or joint authorship or editorship, provided suitable acknowledgment of its first appearance is made.

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Letter from the *Saskatchewan Law Review* to Chris Triggs (8 February 2005).

<sup>89</sup> See Monotti, *supra* note 14 at 338. Monotti, at 340-42, also discusses other possible solutions, such as alternative publications promoting competition (such as scholar-led electronic journals), and collaborations between libraries, scientific societies, academics and publishers.

<sup>90</sup> *Ibid.* at 492.

<sup>91</sup> *Copyright Act*, *supra* note 7, s.29, also sections 29.4-29.9 'Educational Institutions.'

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<sup>92</sup> [2004] 1 S.C.R. 339, S.C.J. No. 12 (QL). However, providing copies to students may be infringement – the Court provided several criteria to assess fair dealing, including the amount and character of the dealing, and the wide distribution of multiple copies of a work, or the copying of a significant portion of a work, may not constitute fair dealing, *ibid.* at paras. 51, 54-60). Monotti, *supra* note 14 at 337, suggests that educational use may pose a problem under Australian and English copyright law, and universities may be required to pay for each use.

<sup>93</sup> Vaver, *supra* note 10 at 88.

community needs. ... Integral to this is the freedom of those working within universities to publish or make available the results of their work.<sup>94</sup>

The CAUT describes the right to publish as "a cornerstone of academic freedom."<sup>95</sup> The public interest is involved, as academic freedom and the freedom to disseminate ensures that the public domain has the full benefit of the knowledge produced by universities. This is in contrast to the private sector, where research conducted by commercial entities will be driven by self-interest,<sup>96</sup> and cloaked in secrecy,<sup>97</sup> as well as to the public sector, where government policy will determine research and publication.<sup>98</sup> Universities are unique institutions, guardians of the public domain, or an intellectual commons, however imperfect.<sup>99</sup> Academic freedom is at the heart of this notion of the public domain.

If universities owned the copyright in academic works, they would have the ability to prevent or control publication, limiting academic freedom. Although academics are often motivated by selfish considerations (reputation, prestige, career enhancement, attracting funding), just as much as the selfless pursuit of knowledge, they are in the best position to know when a work is ready for publication. They are most likely to pursue publication as soon as possible, for both selfless and selfish reasons, and for this reason the public interest is best served by academic copyright ownership.

Because the university is seen as a guardian of the public domain, it is sometimes considered incongruous to apply intellectual property laws to academic knowledge. Monotti provides a list of several ways in which intellectual property laws do not conflict with the idea of academic freedom, and in fact promote it.<sup>100</sup> First, it would be unfair if

knowledge generated within universities and made freely available could be taken by third party free riders, built upon and profited from, with no rewards flowing to the original creators. Further, if third parties built upon that knowledge, and then acquired intellectual property protection of their own, the result could be universities restricted in the use of work generated within their own walls. Second, intellectual property rights may allow universities control over the content of the work, and this control can be used to promote freedom of inquiry: "a university could ensure that an invention that has profound significance for research can be licensed widely at a reasonable cost."<sup>101</sup> Conversely, innovation may be reduced if commercial entities cannot acquire rights to basic research from university researchers, and consequently are unwilling to devote considerable resources to developing new products. For the same reason, commercial entities may become less willing to provide funding for university research. Third, as noted above, academics "have a very clear non-material interest in being credited with what they have produced" (such as reputation and career advancement), and without intellectual property protection there is a greater risk of misattribution and wrongful assumption of credit.<sup>102</sup> Finally, there is the concern that, without the potential economic benefit that comes from intellectual property ownership, there would be greater pressure on academics to leave the university and join commercial enterprises. Some of the justifications Monotti lists for the application of intellectual property laws to universities are equally consistent with either university or academic ownership, but the point is that academic freedom can be promoted by intellectual property law. And as was noted above, academic freedom is best served by academic ownership of copyright.

Lametti provides a theoretical analysis of copyright to determine how it should be allocated. He provides two broad categories of arguments justifying intellectual property rights,

discussed here, rather than the more narrow copyright.

<sup>101</sup> *Ibid.* at 47.

<sup>102</sup> *Ibid.* at 48.

<sup>94</sup> Monotti, *supra* note 14 at 45-46.

<sup>95</sup> CAUT IP, *supra* note 54 at 6.

<sup>96</sup> Monotti, *supra* note 14 at 46.

<sup>97</sup> CAUT IP, *supra* note 54 at 6.

<sup>98</sup> Monotti, *supra* note 14 at 46.

<sup>99</sup> *Ibid.* at 43-44; McSherry, *supra* note 28 at 53-54, 109-110.

<sup>100</sup> Monotti, *supra* note 14 at 47-48. Intellectual property rights in general are

and applies them to the university context. The first category "consists of arguments emanating from the individual and her relationship to social resources, or arising from her creation of an object of social wealth."<sup>103</sup> The second category involves arguments based on utility and efficiency.

There are two kinds of arguments from the individual. The first is a labor and desserts argument, which states that the author does the work of creation and therefore deserves reward in the form of ownership.<sup>104</sup> However, just because someone creates something, providing society with what would otherwise not have existed, it does not necessarily follow that the reward must take the form of property ownership. In the context of universities, the salary received by academics could be viewed as sufficient reward.<sup>105</sup> Further, this argument requires some link between the work produced and the author's creativity, and is therefore even less forceful where teamwork is involved.<sup>106</sup>

The second argument from the individual, the personhood argument, involves the idea that there is an "intrinsic or indelible link between traditional academic work and the author."<sup>107</sup> The author's reputation, self-esteem and sense of personal accomplishment are closely tied to the work produced; no one else has a better or more just claim to copyright ownership.<sup>108</sup> That an academic should have control of the work because of the implications for his or her reputation may have been one of the concerns driving the decision in *Caird*. That the infringing copy in that case was "a blundering and unsuccessful reproduction" was held irrelevant, as a bad copy is no less an infringement than an exact copy.<sup>109</sup> The CAUT states that "[w]ithout the creator of the course content, there is no course," emphasizing the connection of the professor to the course materials he or she creates.<sup>110</sup> Academic

ownership of copyright protects the personhood of academic authors, by giving them control over their work product, over their ideas, and over their reputations and careers.

Lametti notes that both labor-dessert and personhood arguments downplay context, and the role of the university in the process of creation.<sup>111</sup> Universities provide resources that make the work possible, even if only the security of employment that makes it possible to research and write. The labor-dessert argument is weakened by the presence of rewards in the form of salaries. The personhood argument is the more compelling, especially the more creative the work is, and the more closely linked to the author.<sup>112</sup>

Lametti also examines arguments based on utility and efficiency. Utility is, essentially, the greatest good for the greatest number.<sup>113</sup> Efficiency involves achieving a desired goal at the lowest cost.<sup>114</sup> One argument is that the greatest good can be achieved only by granting full ownership rights, because private ownership creates incentive to fully develop, but not over-exploit resources, avoiding the "tragedy of the commons."<sup>115</sup> The tragedy of the commons occurs where a common resource exists (e.g., the communal pasture), to which all have access: each takes a little more than his or her share (or adds a little waste). Each individual benefits because, while the benefits are individual, the costs are spread among all the shareholders. In the end, however, everyone suffers as the resource is depleted.<sup>116</sup> However, it is not apparent that this argument is applicable to intellectual property. Intellectual property is unlike physical property; it is theoretically unlimited. Ideas are not depleted by use.

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<sup>111</sup> Lametti, *supra* note 52 at 532.

<sup>112</sup> *Ibid.* at 533.

<sup>113</sup> *Ibid.* at 534, citing John Stuart Mill as the originator of utility arguments.

<sup>114</sup> *Ibid.* at 536.

<sup>115</sup> *Ibid.* at 538.

<sup>116</sup> See Garrett Hardin, "The Tragedy of the Commons" in Herman E. Daly and Kenneth N. Townsend, eds., *Valuing the Earth: Economics, Ecology, Ethics* (Cambridge, Mass.: The MIT Press, 1993) 127.

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<sup>103</sup> Lametti, *supra* note 52 at 520.

<sup>104</sup> *Ibid.* at 527.

<sup>105</sup> *Ibid.* at 528.

<sup>106</sup> *Ibid.* at 529.

<sup>107</sup> *Ibid.* at 530.

<sup>108</sup> *Ibid.* at 530.

<sup>109</sup> *Caird*, *supra* note 19 at 336-37.

<sup>110</sup> CAUT Online, *supra* note 41 at 3.



However, there are other utility and efficiency approaches.

The utility and efficiency approach requires an examination of the goals of copyright protection, and a distribution of ownership rights that best serves those goals.<sup>117</sup> The objective of copyright is "to promote and protect the production of a variety of creative and useful works."<sup>118</sup> This is done by providing economic incentives, and the greatest incentive is full ownership of the intellectual property produced.<sup>119</sup> However, there is a tension between productive and allocative efficiency: "It is productively efficient to encourage the creation of intellectual resources *ex ante*, but allocatively inefficient *ex post* to allow the entitlement holder to charge a positive price for them."<sup>120</sup> A utilitarian approach weighs the competing interests, and divides and assigns the rights accordingly in order to achieve the most efficient result.

Authors presumably want to profit in some way from their works, while universities want to see some return on resources invested. Striking a balance, in favor of the academic or the university, depends on which factor is more important, the physical inputs of resources, or the "creative spark" of the individual author.<sup>121</sup> Lametti suggests that, intuitively, the incentive will be stronger for an individual than for a corporate body, and further, that the more marketable the product, the more effective the incentive of ownership. If this reasoning is plausible, "a system which had the primary goal of fostering and protecting human creative processes would vest the fullest possible ownership rights in the author of the creative outcomes."<sup>122</sup> This is particularly true in relation to most traditional copyrightable material (such as journal articles), the ownership of which provides little, if any, financial reward, and where prestige associated with the publication accrues indirectly to the university regardless of the allocation of ownership. On the other hand, it

holds less true where the works have a specific financial value, such as online courses.

There are other considerations as well. Some have argued that university copyright ownership reduces the incentive for the academic to produce her or his best work, that it might be withheld until the academic was in a position to claim ownership (after termination of employment).<sup>123</sup> However, it is difficult to believe that an academic would not publish her or his best work, even without the incentive of copyright ownership, given other incentives such as reputation, career advancement and the simple desire to share knowledge. Additionally, universities may wish to consider the possibility that those institutions that allow faculty ownership of academic work will have an easier time attracting talented individuals than those that do not.<sup>124</sup>

Utility justifications tend to favor allocating ownership of copyright to academic authors, but more ambiguously than do personhood arguments. Academics are motivated by more than economic incentives, particularly with regard to traditional scholarly works. On the other hand, in the case of some works, such as copyrightable gene sequences, computer software, or online courses, there is a profit-motive, and therefore incentive arguments are strong for both universities and academics.<sup>125</sup> Further, in such cases the works will likely be produced by a team, reducing the claim to ownership of any individual academic, and the university will provide greater resources, increasing its claim. On balance, both "universities and authors have some claim to the copyrightable fruits of the paid labour of professors and researchers."<sup>126</sup> In some cases the university has a claim to an interest in the works produced. However, most arguments tend towards an initial allocation of copyright ownership in academics. Academic ownership is also justified on the basis that the university is in the more powerful position to create or assert

<sup>117</sup> Lametti, *supra* note 52 at 534.

<sup>118</sup> *Ibid.* at 542.

<sup>119</sup> *Ibid.* at 545.

<sup>120</sup> *Ibid.* at 543.

<sup>121</sup> *Ibid.* at 546-47.

<sup>122</sup> *Ibid.* at 548.

<sup>123</sup> Vaver, *supra* note 10 at 88. Caird, *supra* note 19 at 346.

<sup>124</sup> Monotti, *supra* note 14 at 503.

<sup>125</sup> Lametti, *supra* note 52 at 559.

<sup>126</sup> *Ibid.* at 563.

contractual clauses necessary to protect its interests.<sup>127</sup>

### Conclusion

The academic exception is an historically, legally and theoretically justifiable allocation of copyright ownership. Various arguments support the default legal position that first copyright vests in the academic author, rather than with the university employer. This allocation avoids more practical difficulties than it creates, promotes utility and productive efficiency, recognizes the connection between the author and the work, and most importantly, promotes academic freedom. Justice Kaus, in *Weisser*, was correct when he said that it is "apparent that no authority supports the argument that the copyright to plaintiff's notes is in the university. The indications from the authorities are the other way and so is common sense."<sup>128</sup> Despite its long tradition, developments in new media are prompting universities to reconsider the academic exception, and to begin to assert an interest of their own in certain copyrightable material. There is some validity to the claim by universities to an interest in certain works, particularly where numerous people are involved in the development, and significant university resources are involved. However, academic freedom, and the public interest, is best served by faculty ownership of course materials, lecture notes, and other traditional works. Universities are in a position to negotiate for appropriate licensing arrangements, which should be sufficient to meet their needs. Disputes over the allocation of copyright in academic works are increasing. Both universities and academics (and the associations or unions that represent them) must be aware of the repercussions of any copyright allocation. It is in the interest of the public domain that both parties protect academic freedom.

### Postscript

UBC applied for review of Arbitrator Dorsey's decision in *Bryson and MET* to the British Columbia Labour Relations Board

(LRB). The appeal was heard in June of 2005, and a decision was issued February 28, 2006: *The University of British Columbia and University of British Columbia Faculty Association*.<sup>129</sup> UBC raised five grounds of appeal, five errors it claimed were made by Arbitrator Dorsey in arriving at his decision. The LRB upheld Arbitrator Dorsey's decision on all grounds.

Of particular interest is the LRB's conclusion regarding the second ground of appeal, that while UBC was precluded from negotiating the assignment of copyright directly with individual faculty members, it was not precluded from unilaterally instituting a rule or policy "requiring the assignment of copyright as a pre-condition to participation in the MET program,"<sup>130</sup> so long as there was nothing to the contrary in the collective agreement. UBC had argued that the effect of Arbitrator Dorsey's decision was that UBC could only obtain assignment of copyright through negotiation with the Faculty Association, which would conflict with a principle of labour law that an employer may, after dialogue and debate, unilaterally implement a rule or policy requiring an employee to execute an individual agreement dealing with his or her individual rights (provided the unilaterally implemented rule does not conflict with the collective agreement).<sup>131</sup> The LRB held that this argument failed in light of Arbitrator Dorsey's finding of fact that UBC had *not* unilaterally implemented a policy requiring the assignment of copyright, but had in fact attempted to negotiate directly with Dr. Bryson in her capacity as an employee. It was held that the effect of Arbitrator Dorsey's decision was not to prevent UBC from

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<sup>129</sup> BCLRB No. B56/2006 ("*UBC and UBCFA*"), available online at: <http://www.lrb.bc.ca/decisions/NUM2006.HTM>.

<sup>130</sup> *Ibid.* at 23.

<sup>131</sup> See *KVP Co. Ltd. and Lumber & Sawmill Worker's Union, Local 2537* (1965), 16 L.A.C. 73 (B.C.L.R.B.), which established certain criteria for the unilateral imposition of rules by an employer. See also *e.g. Re Ventur Steel (1990) Ltd.*, BCLRB No. B57/1997, at para. 23.

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<sup>127</sup> *Ibid.* at 565.

<sup>128</sup> *Weisser*, *supra* note 14 at 550.

unilaterally implementing policy, because that was not what had occurred.

UBC also argued that the source of faculty copyright ownership was UBC's Policy 88, that Policy 88 either created the right, or had overtaken it.<sup>132</sup> The LRB rejected this argument, upholding Arbitrator Dorsey's conclusion that the source of faculty ownership of copyright is the academic exception, and that Policy 88 merely confirmed that fact.<sup>133</sup> Although academics, and the unions representing them, should be aware of the LRB's finding that UBC could have unilaterally imposed a policy requiring faculty to assign copyright, this finding also confirms that first copyright resides in the academic author, and not the employing institution; such a policy would serve no purpose if faculty have no copyright to assign.

- Chris Triggs, March 2, 2006

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