Is the Work-for-Hire Doctrine Trumped by Custom?
Thomas G. Field, Jr.

In an earlier piece, I considered whether custom might stand in the way of copyright for lawyers' work. Because lawyers rarely have occasion to sue one another, however, dearth of litigation proves little — particularly when nothing supports an exemption based on general principles. Copyright, itself is not in doubt, but the situation is similar with regard to title in works created by academic employees.

In Hays v. Sony Corp. of America, 847 F.2d 412, 416 (7th Cir. 1988), Judge Posner notes that virtually no one questioned academic author's title to their writings under the 1909 Act. At 416-17, he goes on to say: "The reasons for a presumption against finding academic writings to be work made for hire are as forceful today as they ever were…. To a literalist … the conclusion that the Act abolished the exception may seem inescapable…. But considering the havoc that such a conclusion would wreak in the settled practices of academic institutions, the lack of fit between the policy of the work-for-hire doctrine and the conditions of academic production, and the absence of any indication that Congress meant to abolish the teacher exception, we might, if forced to decide the issue, conclude that the exception had survived the enactment of the 1976 Act."

More recently, Bosch v. Ball-Kell, 80 USPQ2d 1713, 1720 (C.D.Ill. 2006), cites *Hays* and finds "The logic behind such a conclusion is compelling." That finding also constitutes dicta, and, as acknowledged in *Hays,* the logic of that case is at odds with the plain language of 17 U.S.C. §§ 101("works made for hire") and 201(b).

The statute makes it clear that schools, as employers, own copyright in works of academic employees created as part of their duties (perhaps even when prepared off campus). Yet, that is usually irrelevant. No one is apt to care whether scholars hold copyright in books that generate little income or in articles that may even require publishers to be subsidized. Until schools see an economic benefit to offset substantial overhead, de facto title is all that most scholars are apt to have.

Publishers with assignments, however, could acquire title by adverse possession. *See* Merchant v. Levy, 92 F.3d 51 (9th Cir. 1996) (title disputes are subject to the three year statute of limitation in § 507(b)). But, absent applicability of the statute of limitations, laches or estoppel, even scholars who claim copyright based on university policies have little support. This is clear from § 201(b). Whereas § 204 requires transfers to be in writing and signed by transferors, § 201(b) requires both transferees and transferors to sign agreements giving title to employee-authors.

In Forasté v. Brown University, 248 F.Supp.2d 71, 81 (D.R.I. 2003), for example, the court rejected claims of a staff photographer based on Brown's blanket copyright waiver. Moreover, the plain meaning of § 201(b) made it unnecessary for the court to interpret Brown's written policy to cover only academic authors.

Many universities have technology transfer offices. Few, if any, such offices would be able or willing, much less eager, to deal with typical faculty publications. Software is, however, unlikely to be included in a school's blanket waiver of copyright for scholarly work and is more likely to be explicitly excluded. That alone belies existence of a broad de facto scholar's or academic's exemption to the work-for-hire doctrine.

That havoc has never been and is unlikely to be wreaked with regard to typical academic publications is explained by lack of motivation, not lack of title. Indeed,

academic programmers who designate work as “open source” may pose the largest potential source of problems. Absent agreements that conform to § 201(b), such programmers are surely waiving rights they don’t have.

In any event, where substantial cash may be involved, authors and publishers of copyrighted works are well advised to heed the plain meaning of § 201(b) — even in the Seventh Circuit.

[I much appreciate comments on an earlier draft made by my colleague, Karen Hersey.]