

COPYRIGHTS IN ACADEMIA: IP POLICIES FAIL TO TRANSFER RIGHTS

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A recent pair of decisions from the Federal District Court in Rhode Island reminds employees of colleges and universities that the rules on copyright ownership and transfer found in the Copyright Act apply to them as well as to employees in private enterprise. The case, *Foraste v. Brown University*, involved a Brown University photographer who, after leaving Brown, claimed that Brown's published intellectual property ("IP") policy vested copyright ownership in him and, therefore, Brown's continuing use of his photos in violation of the policy infringed his copyrights.

The court held, to the contrary, that under Federal copyright law works created by employees within the scope of their jobs are "works made for hire," that the copyrights in these works are employer property, and that only a signed transfer agreement – or, at a minimum, a note or memorandum signed by the transferor – that describes the terms of transfer will effect an assignment of copyright. In other words, educational institutions own the copyrights in works created by their employees, perhaps even if their published IP and copyright policies state otherwise.

Therefore, if an institution truly intends to transfer copyright ownership to faculty or staff, it may need to act affirmatively. For example, it should consider including in its IP policies a procedure whereby interested employees can obtain a formal assignment or agreement of transfer.

Similarly, faculty and staff should assume that when they create copyrightable courseware, software or other works of authorship as part of their job, the copyrights remain the property of their employing institution ... perhaps even if the institution's published IP and copyright policies state otherwise. Therefore, if they create works of significance within their job responsibilities, and they want to be sure they own the copyright, they should seek an instrument or agreement of transfer signed by an official of the institution.

At a minimum, the transfer document should identify the assignee, specify the subject matter (which courseware, text, photographs etc. are assigned), state when the transfer is effective, and specify any other relevant aspects of the transfer or ongoing relationship, such as revenue-sharing and reserved rights.

♦ *If you would like more information on this topic, please feel free to contact Howard Zaharoff or our other IP attorneys.*

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