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More Than an Academic Question: Defining Student Ownership of Intellectual Property Rights

Kurt M. Saunders

California State University, Northridge, kurt.saunders@csun.edu

Michael A. Lozano

Loyola Law School, Los Angeles, michael.lozano.940@my.csun.edu

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Cover Page Footnote

*Professor of Business Law, California State University, Northridge. **J.D., Loyola Law School, Los Angeles (expected 2020); B.S. Business Administration in Business Law, California State University, Northridge (2017).

More Than an Academic Question: Defining Student Ownership of Intellectual Property Rights

Kurt M. Saunders*

Michael A. Lozano**

Intellectual property is increasingly important due to technology's rapid development. The importance of intellectual property is also reflected within universities as traditional centers of research and expression, where students and faculty are encouraged to develop inventions and creative works throughout the educational experience. The commercialization potential of the intellectual property that emerges from these efforts has led many universities to adopt policies to determine ownership of intellectual property rights. Many of these policies take different approaches to ownership, and most students are unaware of their rights and are unlikely to consider whether the university has a claim to ownership. The purpose of this Article is to outline how intellectual property rights arise in the academic environment and to analyze how university policies determine ownership rights for students and the university. This Article concludes by urging universities and students to acknowledge the existence of these issues, adopt policies to address ownership rights, and make these policies known to members of the university community.

* Professor of Business Law, California State University, Northridge.

** J.D., Loyola Law School, Los Angeles (expected 2020); B.S. Business Administration in Business Law, California State University, Northridge (2017).

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INTRODUCTION

“[A]s a man is said to have a right to his property,
he may be equally said to have a property in his rights.”

– James Madison¹

Universities are a hub for research and discovery. Since their inception, research and the acquisition of knowledge have been the primary objectives of every university and school throughout the world. Many of the greatest discoveries, such as the periodic table,² several anti-cancer vaccines,³ ultrasound,⁴ CAT scans,⁵ the Internet,⁶ and even Gatorade,⁷ were discovered through university research. Universities and university members do more for their communities than most realize, but what is not always clear is who owns the intellectual property rights to these inventions and creations. Faculty and students alike engage in creative and inventive activities, not only to benefit society, but also—in some instances—to commercialize their creations and discoveries. This is where ownership problems may arise.

Almost always, ownership rights in intellectual property vest in the inventor or creator.⁸ In an academic environment, issues of

¹ 6 JAMES MADISON, *Property*, in THE WRITINGS OF JAMES MADISON 101 (Gaillard Hunt ed., 1906).

² See *Dmitry Mendeleev*, SAINT-PETERSBURG.COM, <http://www.saint-petersburg.com/famous-people/dmitry-mendeleev/> [https://perma.cc/8QFD-3RSW] (last visited Oct. 22, 2017).

³ See *Leading Medical Center*, UNIV. OF ROCHESTER, <https://www.rochester.edu/research/medical-center.html> [https://perma.cc/BY6Z-FU8A] (last visited Mar. 6, 2017).

⁴ See *A Condensed History of Ultrasound*, GENESIS ULTRASOUND, <http://www.genesis-ultrasound.com/history-of-ultrasound.html> [https://perma.cc/84AP-47PV] (last visited Mar. 6, 2017).

⁵ See *Robert S. Ledley, DDS, FACMI*, AMIA, <https://www.amia.org/about-amia/leadership/acmi-fellow/robert-s-ledley-dds-facmi> [https://perma.cc/F3JZ-MVCY] (last visited Mar. 6, 2017).

⁶ See *The Invention of the Internet*, HISTORY, <http://www.history.com/topics/inventions/invention-of-the-internet> [https://perma.cc/5F6F-BQRJ] (last visited Mar. 6, 2017).

⁷ See *History*, GATORADE, <https://www.gatorade.co.nz/history/> [https://perma.cc/596K-BXBM] (last visited Mar. 6, 2017).

⁸ For instance, copyright “vests initially in the author or authors of the work.” 17 U.S.C. § 201(a) (2012). Likewise, an application for a patent must be made by the

ownership most frequently occur as to faculty-generated intellectual property, or as to the rights of the university vis-à-vis external funding sources, such as the federal government or private industry.⁹ Many universities have adopted policies that resolve faculty ownership issues, and have negotiated contractual arrangements with external funding sources stipulating the allocation of intellectual property rights.¹⁰

Typically, such policies address who has the right to own a patent or copyright in a particular invention or work, determine who has the right to disclose the details of the invention or publish the work, and allocate royalties derived from the commercial exploitation of the invention or work.¹¹ Some university policies simply allow faculty to retain all intellectual property rights, or do so with exceptions for certain circumstances that require faculty to share rights with the university as a condition of employment.¹² In these exceptional circumstances, the allocation of ownership and rights is made by a contractual agreement between the university and the faculty member, and may be incorporated in faculty

inventor who owns the patent, unless he or she has assigned it to another. 35 U.S.C. §§ 111(a)(1), 261 (2012).

⁹ See CARY R. NELSON ET AL., AM. ASS'N OF UNIV. PROFESSORS, DEFENDING THE FREEDOM TO INNOVATE: FACULTY INTELLECTUAL PROPERTY RIGHTS AFTER *STANFORD V. ROCHE* 3 (2014), https://www.aaup.org/sites/default/files/files/aaupBulletin_IntellectualPropJune5.pdf [<https://perma.cc/AAJ5-MM8W>] (discussing faculty ownership rights).

¹⁰ See Ashley Packard, *Copyright or Copy Wrong: An Analysis of University Claims to Faculty Work*, 7 COMM. L. & POL'Y 275, 294–96 (2002). The American Association of University Professors has approved several statements regarding protection and allocation of faculty intellectual property rights. See, e.g., *AAUP Policy Work on Intellectual Property*, AM. ASS'N OF UNIV. PROFESSORS, <https://www.aaup.org/get-involved/issue-campaigns/intellectual-property-risk/aaup-policy-work-intellectual-property> [<https://perma.cc/FFJ8-TWHE>] (last visited Sept. 29, 2017).

¹¹ See, e.g., GEORGETOWN UNIV., *Intellectual Property Policy*, in FACULTY HANDBOOK: OTHER POLICIES GOVERNING EMPLOYMENT ch. IV, pt. B, at §§ 2, 4, 7(a) (2006), <https://facultyhandbook.georgetown.edu/toc/section4/b> [<https://perma.cc/6AZP-RFW7>]; JOHNS HOPKINS UNIV., INTELLECTUAL PROPERTY POLICY 2–3 (2011), https://www.jhu.edu/assets/uploads/2014/09/intellectual_property_policy.pdf [<https://perma.cc/3T4W-3A3M>]; UNIV. OF N.M., *E70: Intellectual Property Policy*, in FACULTY HANDBOOK: RESEARCH § E (2010), <http://handbook.unm.edu/pdf/unm-faculty-handbook-section-e.pdf> [<https://perma.cc/79GU-XZCK>].

¹² See, e.g., GEORGETOWN UNIV., *supra* note 11, § 2; JOHNS HOPKINS UNIV., *supra* note 11, § IV; UNIV. OF N.M., *supra* note 11, § 2.

employment contracts and handbooks as well.¹³ In either case, these faculty policies override the statutory presumptions of shop rights¹⁴ arising in patent law, and the work made for hire doctrine¹⁵ found in copyright law.

Nevertheless, the focus on faculty and university ownership issues overlooks the reality that students may develop intellectual property in the course of their studies as well. It is not hard to imagine the possibilities. Does a student who authors a short story in a creative writing course or who writes a program in a computer science course own the copyright in these works? Is a student who actively participates in laboratory research with a faculty member a co-owner of any resulting patent rights? Can a well-known student athlete acquire a right of publicity or trademark rights related to his or her identity? University-sponsored competitions and programs designed to foster student entrepreneurial activity, such as the development of business ideas and software applications, are becoming increasingly common.¹⁶ Inevitably, questions arise as to whether the students who participate own the intellectual property rights that result. In an attempt to sort out issues of student ownership, some universities have begun adopting intellectual property policies similar to those used to address faculty ownership rights.¹⁷

This Article examines how students may come to own intellectual property rights in the academic environment.¹⁸ In Part

¹³ See Michael W. Klein & Joy Blanchard, *Are Intellectual Property Policies Subject to Collective Bargaining? A Case Study of New Jersey and Kansas*, 20 TEX. INTELL. PROP. L.J. 389, 404 (2012).

¹⁴ See *infra* notes 47–50 and accompanying text.

¹⁵ See *infra* notes 72–76 and accompanying text.

¹⁶ See Bryce C. Pilz, *Student Intellectual Property Issues on the Entrepreneurial Campus*, 2 MICH. J. PRIV. EQUITY & VENTURE CAP. L. 1, 7 (2012); Jacob H. Rooksby, *A Fresh Look at Copyright on Campus*, 81 MO. L. REV. 769, 777–78 (2016).

¹⁷ See Pilz, *supra* note 16, at 23–24, 28.

¹⁸ This Article adopts the definition of “student” proposed by the Association of University Technology Managers: “[A] *student* is . . . any individual registered in university courses who anticipates earning a degree, diploma, or certificate.” Abigail Barrow et al., Ass’n of Univ. Tech. Managers, *Managing Student Intellectual Property Issues at Institutions of Higher Education: An AUTM Primer*, in 2 AUTM TECHNOLOGY TRANSFER PRACTICE MANUAL 1, 3 (3d ed. 2014), <https://www.autm.net/AUTMMain/>

I, this Article reviews the main types of intellectual property, with attention to the requirements for protection and the rights granted to owners under existing federal or state law. Part II analyzes how university policies determine ownership rights as between students and the university. Part III then presents and analyzes a series of hypothetical scenarios to illustrate how the law would determine student intellectual property ownership, and how university policies may lead to a different determination. Finally, this Article concludes by urging universities and students to acknowledge the existence of these issues, adopt policies to address ownership rights, and make these policies known to members of the university community.

I. A PRIMER ON INTELLECTUAL PROPERTY PROTECTION AND OWNERSHIP

Broadly defined, intellectual property is the product of the inventive and creative activity of the human mind.¹⁹ Intellectual property law affords protection for these products and delineates the legal rights of owners and users of such products.²⁰ Like all forms of property, the legal concept of intellectual property centers on the right to exclude others from using the property without the owner's permission.²¹ This Section reviews the types of intellectual property protections that are most relevant to student work, with attention to the requirements for protection and the rights of ownership.

media/ThirdEditionPDFs/V2/TTP_Manual_3rd_Edition_Volume2_StudentIP.pdf [https://perma.cc/UTT2-P8B3]. This Article adds that a student may be enrolled in an undergraduate or graduate program, and that some students may be employees of the university or involved in collegiate athletic programs.

¹⁹ KURT M. SAUNDERS, *INTELLECTUAL PROPERTY LAW: LEGAL ASPECTS OF INNOVATION AND COMPETITION* 1 (2016).

²⁰ *See id.* at 5.

²¹ *See id.* at 2.

A. Patents

Patents protect applied technological inventions.²² The U.S. Constitution makes clear that patent law's purpose is to promote the progress of the useful arts through disclosure of inventions in exchange for a limited term of protection.²³ According to the Patent Act, which defines the requirements for patentability, inventions that may be patented include: "any . . . process, machine, manufacture, or composition of matter, or . . . improvement" on any of these.²⁴ In addition, the invention must be useful, novel, and nonobvious.²⁵ An invention is useful when it serves a "specific benefit,"²⁶ and is novel if it has never before been publicly disclosed anywhere in the world.²⁷ Finally, an invention is nonobvious when those knowledgeable in the field and familiar with the existing technology could not have easily conceived of it.²⁸

²² This Article focuses on utility patents rather than design patents. A utility patent applies to useful, functional inventions, whereas a design patent protects the appearance and ornamental features of an article of manufacture, unrelated to its utilitarian function. See 35 U.S.C. §§ 101, 171 (2012).

²³ See U.S. CONST. art. I, § 8, cl. 8. As the Supreme Court explained in *Kewanee Oil Co. v. Bicron Corp.*:

When a patent is granted and the information contained in it is circulated to the general public and those especially skilled in the trade, such additions to the general store of knowledge are of such importance to the public weal that the Federal Government is willing to pay the high price of [seventeen] years of exclusive use for its disclosure, which disclosure, it is assumed, will stimulate ideas and the eventual development of further significant advances in the art.

416 U.S. 470, 481 (1974). Compare *id.* (defining a patent term as no longer than seventeen years), with *infra* text accompanying note 31 (differentiating utility patents, which have a term of up to twenty years).

²⁴ 35 U.S.C. § 101.

²⁵ See *id.*; see also *id.* §§ 102(a), 103.

²⁶ See *Brenner v. Manson*, 383 U.S. 519, 534–35 (1966).

²⁷ See 35 U.S.C. § 102(a)(1).

²⁸ See *id.* § 103 (stating that an invention is obvious "if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains"). An invention is useful when it is capable of providing some identifiable specific and substantial benefit. See U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 2107 (9th ed., rev. 7, Nov. 2015), <https://www.uspto.gov/web/offices/pac/>

In order to obtain a patent, an inventor must file an application with the U.S. Patent and Trademark Office (the “USPTO”), where it is subject to an examination process to determine whether the claimed invention satisfies the requirements for patentability,²⁹ and is thereby entitled to patent protection.³⁰ The term of protection for a utility patent is twenty years from the date on which the application was filed.³¹ After a patent expires, the invention becomes part of the public domain, allowing others to freely use it without limitation.³²

Only the inventor shall file an application for a patent at the USPTO³³—i.e., the individual who conceives of the invention.³⁴ During the term of protection, a patent grants an inventor the right to exclude others from making, using, selling, or importing the invention the patent protects.³⁵ The USPTO can grant a patent to joint inventors who collaborated in making the invention, regardless of whether they “physically work[ed] together or at the same time” on the invention, and even if each did not equally contribute to it.³⁶ When the invention was the product of collaborative work by joint inventors, each joint inventor shares

mpep/s2107.html [https://perma.cc/7D8Y-DJV8]. A novel invention is one that has not already been identically disclosed in a publicly accessible prior art reference. *See* 35 U.S.C. § 102(a)(1). For a more extensive explanation of the nonobvious, utility, and novelty requirements, see ROGER E. SCHECHTER & JOHN R. THOMAS, *INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS, AND TRADEMARKS* §§ 15.1–17.3 (2003).

²⁹ *See* SCHECHTER & THOMAS, *supra* note 28, § 19.2.3.

³⁰ *See id.* The claims of a utility patent define the invention. *See id.* § 18.2. A patent application must contain “one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor” regards as his or her invention. 35 U.S.C. § 112(b).

³¹ *See* 35 U.S.C. § 154(a)(2).

³² *See* *Kimble v. Marvel Entm’t, LLC*, 135 S. Ct. 2401, 2407 (2015).

³³ *See* 35 U.S.C. § 111.

³⁴ Conception of an invention is the “formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.” *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376 (Fed. Cir. 1986) (quoting 1 ROBINSON ON PATENTS 532 (1890)). As such, not every person who contributes to the development of an invention is classified as an “inventor” for purposes of applying for a patent. *See, e.g., Hess v. Advanced Cardiovascular Sys., Inc.*, 106 F.3d 976, 980–81 (Fed. Cir. 1997).

³⁵ 35 U.S.C. § 154(a)(1).

³⁶ *Id.* § 116(a).

the right to exclude, and owns a proportionately equal, undivided interest in the patent.³⁷

Patents have the attributes of personal property, so that the inventor may transfer ownership of the patent, or a patent application, to another person by agreement.³⁸ Such an assignment of ownership must be in writing.³⁹ On the other hand, the inventor may opt to retain ownership and grant a license to use the patent.⁴⁰ Unlike an assignment, a license is not an outright transfer of full ownership of the patent.⁴¹ The license may be exclusive to one person who has the sole right to use the patent, or nonexclusive so that multiple persons can make use of the patent.⁴²

The general rule is that the inventor is entitled to the patent, even if he or she developed the invention in the course of his or her employment.⁴³ However, an employer may require assignment of the patent from the inventor as a condition of employment.⁴⁴ One exception to this rule arises when an employee was “hired to invent,” meaning that he or she was hired to invent something or resolve a specific problem. If the employee’s work results in a patentable invention, then the employee is obligated to assign any patents resulting from the work to his or her employer.⁴⁵

³⁷ See *id.* § 262.

³⁸ *Id.* § 261.

³⁹ See *id.*

⁴⁰ See DONALD S. CHISUM ET AL., UNDERSTANDING INTELLECTUAL PROPERTY LAW 192 (2d ed. 2011).

⁴¹ See *Exxon Corp. v. Oxxford Clothes, Inc.*, 109 F.3d 1070, 1076 (5th Cir. 1997) (defining a license as “a transfer of limited rights, less than the whole interest which might have been transferred” (quoting *Acme Valve & Fittings Co. v. Wayne*, 386 F. Supp. 1162, 1165 (S.D. Tex. 1974))).

⁴² See CHISUM ET AL., *supra* note 40, at 192.

⁴³ See *id.* at 193.

⁴⁴ See *Bd. of Trs. of the Leland Stanford Junior Univ. v. Roche Molecular Sys., Inc.*, 131 S. Ct. 2188, 2195 (2011) (“In most circumstances, an inventor must expressly grant his rights in an invention to his employer if the employer is to obtain those rights.”); see also *Kucharczyk v. Regents of Univ. of Cal.*, 946 F. Supp. 1419, 1426–27 (N.D. Cal. 1996) (holding that university’s patent policy was incorporated by reference, implicitly or explicitly, into patent agreements and license agreements between faculty and university).

⁴⁵ See, e.g., *United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 187 (1933) (“One employed to make an invention, who succeeds, during his term of service, in accomplishing that task, is bound to assign to his employer any patent obtained.”).

Otherwise, an employee is not required to assign his or her patent rights unless there is a contract to do so.⁴⁶ Nevertheless, if the invention was developed as part of his or her general work for the employer, the shop right doctrine gives the employer a nonexclusive, royalty-free license to use the employee's invention if it was created during work time and with the use of the employer's resources.⁴⁷ No express licensing agreement is required.⁴⁸ Note that a shop right is not an ownership interest, because the employee retains full ownership of the patent.⁴⁹ A shop right is limited to the employer's internal use, and the employer may not transfer it to another.⁵⁰

When university research is funded by the federal government, a federal statute known as the Bayh–Dole Act⁵¹ comes into play. The Bayh–Dole Act was enacted to encourage universities to patent and commercialize the products of federally-funded research, and “to ensure that the Government obtains sufficient rights in federally supported inventions to meet the needs of the Government and protect the public against nonuse or unreasonable use of inventions.”⁵² Universities may retain ownership of inventions developed with federal assistance, and may commercialize those inventions through exclusive licensing agreements with the private sector.⁵³ The statute requires non-

⁴⁶ *See, e.g.*, *DDB Techs., L.L.C. v. MLB Advanced Media, L.P.*, 517 F.3d 1284, 1290 (Fed. Cir. 2008); *Filmtec Corp. v. Allied–Signal Inc.*, 939 F.2d 1568, 1570 (Fed. Cir. 1991).

⁴⁷ *See* *McElmurry v. Ark. Power & Light Co.*, 995 F.2d 1576, 1581–82 (Fed. Cir. 1993) (discussing the contours of the shop rights doctrine).

⁴⁸ *See id.* at 1581.

⁴⁹ *See* *Beriont v. GTE Labs., Inc.*, No. 2013-1109, slip op. at 8–9 (Fed. Cir. Aug. 6, 2013).

⁵⁰ *See id.* slip op. at 8.

⁵¹ 35 U.S.C. §§ 200–11 (2012).

⁵² *Id.* § 200. The Bayh–Dole Act allows the federal government to exercise “march-in rights” against universities that have received federal grants and contracts to compel licensing of inventions developed with such federal assistance. *See id.* § 203.

⁵³ *See, e.g.*, *Fenn v. Yale Univ.*, 283 F. Supp. 2d 615, 621 (D. Conn. 2003). Alternatively, universities may opt to not claim ownership over faculty inventions, but require inventors to share royalties with the university. *See, e.g., id.*

profit organizations, such as universities, to share with inventors royalties resulting from such licenses.⁵⁴

The work of students engaged in scientific research or the development of software may lead to patentable inventions. If accomplished for traditional academic purposes, such as part of a course assignment, the student would own the patent on the resulting invention.⁵⁵ On the other hand, a student may be in a position to assist a faculty member with his or her research, whether as a research assistant employed by the university or as part of coursework. Whether the student's contribution to the effort amounts to joint inventorship will depend on whether he or she actively participated in the conception and development of any invention that emerges.⁵⁶ It is also possible that a student's ownership of patent rights will depend on whether he or she is obligated by university policy, or a contractual agreement with a federal or an external funding source, to disclose and assign or share rights.⁵⁷

⁵⁴ See 35 U.S.C. § 202(c)(7)(B).

⁵⁵ See *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1465 (Fed. Cir. 1998) (noting that an invention belongs to its creator).

⁵⁶ For example, in *Stern v. Trustees of Columbia University*, a medical student's contribution to patented treatment for glaucoma was insufficient to support claim of joint inventorship because the student neither conceived of relevant ideas nor collaborated with the professor in developing the treatment, but simply carried out experiments previously done by the professor on animals suggested by the professor. 434 F.3d 1375, 1378 (Fed. Cir. 2006).

⁵⁷ See, e.g., *Univ. of W. Va., Bd. of Trs. v. VanVoorhies*, 278 F.3d 1288, 1298 (Fed. Cir. 2002) (ruling that a graduate student's joint inventorship with a professor was governed by the university's policy on invention disclosure and assignment of patent rights); *Chou v. Univ. of Chi.*, 254 F.3d 1347, 1356–57 (Fed. Cir. 2001) (ruling that a research assistant was obligated to assign her patent rights to an invention to the university based on university policy); *St. John's Univ. v. Bolton*, 757 F. Supp. 2d 144, 159–61 (E.D.N.Y. 2010) (determining that a professor and graduate student violated their contractual obligations to share licensing royalties with the university, as the “terms of the Bolton Research Agreement impose[d] express contractual duties on [the university] and [professor] to share the revenues derived from the sale or licensing of inventions or patents[,] resulting in whole or in part from [the professor's] research related services at [the university]”).

B. Copyrights

A copyright is “a set of exclusive rights granted to authors as to the ownership and use of their creative works.”⁵⁸ Pursuant to the federal Copyright Act, copyright protection extends only to the expression found in works of authorship.⁵⁹ The types of works that may be copyrighted are: “(1) literary works; (2) musical works . . . ; (3) dramatic works . . . ; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other” creative works having both a visual and audio component; “(7) sound recordings [of music]; and (8) architectural designs.”⁶⁰ Copyright protection also extends to computer software,⁶¹ as well as compilations of data and information.⁶² Ideas, facts, principles, methods, procedures, and useful articles are not eligible for copyright protection.⁶³

The work must be original and fixed in a tangible medium, meaning that it was recorded or preserved in some stable, physical form.⁶⁴ For instance, a poem can be fixed when written on paper or saved on a flash drive, a sculpture is fixed when it is fashioned from stone, and a sound recording is fixed when stored on a compact disk.⁶⁵ Originality is a relatively easy requirement to meet. The origin of the work must be the author, who did not copy it from another, and the work must demonstrate “some minimal degree of creativity.”⁶⁶ Copyright protection vests the moment the

⁵⁸ SAUNDERS, *supra* note 19, at 7.

⁵⁹ See 17 U.S.C. § 102; see also MARSHALL A. LEAFFER, UNDERSTANDING COPYRIGHT LAW 78 (5th ed. 2010) (“The Copyright Act has codified the longstanding, judicially evolved rule that copyright protects the expression of an idea but not the idea itself.”).

⁶⁰ 17 U.S.C. § 102(a).

⁶¹ See *Comput. Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 702 (2d Cir. 1992); *Apple Comput., Inc. v. Franklin Comput. Corp.*, 714 F.2d 1240, 1248–49 (3d Cir. 1983).

⁶² See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). To qualify for copyright protection, the data or information must demonstrate originality in its selection, coordination, or arrangement. See *id.* at 358.

⁶³ See 17 U.S.C. § 102(b).

⁶⁴ See *id.* § 102(a).

⁶⁵ This would preclude, for instance, an oral presentation by a student or instructor from copyright protection unless it had been otherwise recorded. See *Fritz v. Arthur D. Little, Inc.*, 944 F. Supp. 95, 99 (D. Mass. 1996).

⁶⁶ *Feist*, 499 U.S. at 345; see also *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249–50 (1903).

work is created and fixed, regardless of whether the work is published.⁶⁷ Once vested, a copyright owner may register the copyright with the U.S. Copyright Office, but registration is not required for the copyright to exist.⁶⁸ A joint work results when two or more authors have created the work intending that their contributions be merged into a single whole.⁶⁹ Joint authors co-own the copyright.⁷⁰ For instance, the writer of a children's book and the artist who illustrates the book both contribute copyrightable expression to create the book, and therefore, are joint owners of the copyright.⁷¹ By contrast, an employer owns the copyright for a work made for hire, which results when the employee creates the "work . . . within the scope of his or her employment."⁷² This occurs when he or she created the work during work time, in the work place, while doing the type of work he or she was hired to perform, and for the employer's purposes.⁷³ For example, the employer of a software designer would own the copyright on the resulting program.⁷⁴ In addition, an independent contractor can create a work made for hire if the work was specially ordered or commissioned.⁷⁵ This type of work made for

⁶⁷ See U.S. COPYRIGHT OFFICE, COPYRIGHT BASICS 1 (2017), <https://www.copyright.gov/circs/circ01.pdf> [<https://perma.cc/7RL9-4QYA>]; see also 17 U.S.C. § 102(a).

⁶⁸ See 17 U.S.C. § 408. Nevertheless, registration creates a presumption of ownership of a valid copyright. See H.R. REP. NO. 94-1476 (1976), *reprinted in* 17 U.S.C. § 410. In addition to providing public notice of ownership, registration is a prerequisite for bringing an action for infringement of works originating in the United States. See 17 U.S.C. § 411(a).

⁶⁹ See 17 U.S.C. § 101.

⁷⁰ See *id.* § 201(a).

⁷¹ Note that a joint author must not only intend that his or her contribution become part of the resulting work, but must contribute copyrightable expression to the work. See *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1070, 1073 (7th Cir. 1994) (holding that theatre that made minor artistic suggestions were not joint authors of a writer's theatrical play).

⁷² See 17 U.S.C. § 101.

⁷³ See *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 751–52 (1989).

⁷⁴ See, e.g., *Genzmer v. Pub. Health Tr. of Miami-Dade Cty.*, 219 F. Supp. 2d 1275, 1280–81, 1283 (S.D. Fla. 2002); *Roeslin v. District of Columbia*, 921 F. Supp. 793, 799 (D.D.C. 1995).

⁷⁵ See 17 U.S.C. § 101 (defining a "work made for hire").

hire is limited to certain types of works.⁷⁶ The term of copyright protection for most works is the author's lifetime, plus seventy years.⁷⁷ The duration of protection for works made for hire is the lesser of ninety-five years from the date on which the work was published, or 120 years from the date on which it was created.⁷⁸ Copyright owners have the exclusive rights to reproduce their works, adapt them to create derivative works, publicly distribute their works, and publicly perform and display their works.⁷⁹ The copyright owner may transfer by license or assignment any or all of these rights to another.⁸⁰

Anyone who exercises any of the copyright owner's exclusive rights without permission may be liable for copyright infringement.⁸¹ The Copyright Act provides that a fair use of copyrighted materials is a defense to infringement.⁸² Fair use includes use of the work for "criticism, comment, news reporting, teaching . . . , scholarship, or research."⁸³ In determining fair use, the court must consider four factors: "(1) the purpose and character of the [defendant's] use"; "(2) the nature of the copyrighted work"; "(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole"; and "(4) the effect of the [defendant's] use upon the potential market for or value of the copyrighted work."⁸⁴

In the academic context, faculty members routinely create and are usually required to produce copyrightable works in the form of

⁷⁶ Specifically, a specially ordered or commissioned work must be:
a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them.

⁷⁷ 17 U.S.C. § 101.

⁷⁷ *See id.* § 302(a).

⁷⁸ *Id.* § 302(c).

⁷⁹ *See id.* § 106.

⁸⁰ *See id.* § 201(d).

⁸¹ *See id.* § 501(a).

⁸² *See id.* § 107.

⁸³ *Id.*

⁸⁴ *Id.*

lecture notes,⁸⁵ journal articles, books, software, and various forms of artistic media—all of which are normally considered works made for hire, because faculty members are employees, and the works were created within their scope of employment.⁸⁶ However, at most universities, copyright ownership, like patent rights, is the subject of contractual agreement.⁸⁷ Most often, these agreements allow faculty to retain copyright ownership for academic works if the work is created independently and at the faculty's own initiative—except in instances where the university has commissioned the work, or furnished financial and other forms of support beyond that traditionally provided to faculty, among others.⁸⁸ Of all the categories of intellectual property, students are

⁸⁵ See *Faulkner Press, L.L.C. v. Class Notes, L.L.C.*, 756 F. Supp. 2d 1352, 1357 (N.D. Fla. 2010) (holding that a professor's published lecture notes and electronic textbooks were factual compilations that were protected by copyright). This raises the question of whether a student owns the copyright in his or her class notes, or whether class notes are an authorized derivative work. For a discussion of this issue, see Matthew M. Pagett, *Taking Note: On Copyrighting Students' Lecture Notes*, 19 RICH. J.L. & TECH. 6, 23–27 (2013).

⁸⁶ Ownership of faculty-created copyrightable works remains somewhat unclear. See *Hays v. Sony Corp. of Am.*, 847 F.2d 413, 416–17 (7th Cir. 1988), *abrogated by* *Cooter & Gell v. Hartmarx Corp.*, 496 U.S. 384 (1990); *Weinstein v. Univ. of Ill.*, 811 F.2d 1091, 1094–95 (7th Cir. 1987). For additional discussion regarding ownership of faculty-created copyrightable material, see Gregory K. Laughlin, *Who Owns the Copyright to Faculty-Created Web Sites?: The Work-for-Hire Doctrine's Applicability to Internet Resources Created for Distance Learning and Traditional Classroom Courses*, 41 B.C. L. REV. 549, 584 (2000); Jed Scully, *The Virtual Professorship: Intellectual Property Ownership of Academic Work in a Digital Era*, 35 MCGEORGE L. REV. 227, 229 (2004); and Nathaniel S. Strauss, *Anything but Academic: How Copyright's Work-for-Hire Doctrine Affects Professors, Graduate Students, and K-12 Teachers in the Information Age*, 18 RICH. J.L. & TECH. 4, 45 (2011).

⁸⁷ See 17 U.S.C. § 201(b) (creating an exception to the work made for hire presumption when “the parties have expressly agreed otherwise in a written instrument signed by them”). There is ongoing debate about whether there is a so-called “teachers exception” to the work for hire doctrine by which academics retain copyright ownership in their works. See *Molinelli-Freytes v. Univ. of P.R.*, 792 F. Supp. 2d 150, 161–62 (D.P.R. 2010) (holding that no such exception is found on the Copyright Act so that faculty ownership must be resolved using the work for hire doctrine and any relevant university regulations specifically recognizing professor or university ownership).

⁸⁸ See Ann Springer, *Intellectual Property Legal Issues for Faculty and Faculty Unions* (2005), pt. IV, AM. ASS'N OF UNIV. PROFESSORS (Mar. 18, 2005), <https://www.aaup.org/issues/copyright-distance-education-intellectual-property/faculty-and-faculty-unions-2005> [<https://perma.cc/3HKH-6HNC>].

most likely to independently create copyrightable works as part of their coursework. Students in the arts produce pictorial, graphic, and sculptural works, choreography, musical works and sound recordings, photography, and motion pictures. Humanities and social science students create literary works, as do students in business, science, and engineering, who may produce literary works in the form of compilations, reports, and software.⁸⁹ Courts recognize student copyright protection for such works as research papers, dissertations, and paintings, among other works;⁹⁰ so long as these expressive works are original and fixed in a tangible medium, and are created for traditional academic purposes.⁹¹ In some instances, these works are the product of collaborative group projects, and are likely to be joint works.⁹² More difficult questions about copyright ownership arise when the student creates a work and is employed by the university. If the work is not the product of a course assignment, but is related to his or her employment with the university, it may constitute a work made for hire.⁹³ On the other hand, a research assistant working with a professor who is writing an article for publication would not necessarily be a joint

⁸⁹ Software may be eligible for both patent and copyright protection. *See, e.g.*, *State St. Bank & Tr. Co. v. Signature Fin. Grp., Inc.*, 149 F.3d 1368, 1370 (Fed. Cir. 1998), *abrogated by In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008), *aff'd but criticized sub nom. Bilski v. Kappos*, 561 U.S. 593 (2010); *Apple Comput., Inc v. Franklin Comput. Corp.*, 714 F.2d 1240, 1247 (3d Cir. 1983).

⁹⁰ *See, e.g.*, *Diversey v. Schmidly*, 738 F.3d 1196, 1198 (10th Cir. 2013) (finding that a student stated plausible claim of contributory copyright infringement for infringement of his distribution right to his unpublished dissertation against dean of graduate studies at university); *A.V. ex rel. Vanderhye v. iParadigms, L.L.C.*, 562 F.3d 630, 645 (4th Cir. 2009) (holding that Turnitin anti-plagiarism system is copyright fair use of students' papers while assuming student ownership of copyright); *Rainey v. Wayne State Univ.*, 26 F. Supp. 2d 963, 968 (E.D. Mich. 1998) (allowing a copyright infringement claim by art student against her professor and automobile manufacturer, which used her paintings in brochures distributed at an art show without her permission).

⁹¹ In other words, copyright protection vests in the student at the moment he or she fixes an original work of authorship in a tangible medium of expression as set forth in the Copyright Act. *See* 17 U.S.C. § 102(a); U.S. COPYRIGHT OFFICE, *supra* note 67.

⁹² *See supra* notes 69–71 and accompanying text.

⁹³ *See supra* notes 72–75 and accompanying text.

author.⁹⁴ Alternatively, the student may be contractually bound to assign his or her copyright if the particular work was specially commissioned or funded by the university.⁹⁵

C. Trademarks and the Right of Publicity

A trademark can be a distinctive word, phrase, symbol, design, or a combination of these, used to identify the origin or source of the goods or services sold in commerce.⁹⁶ Words like “Sprint,” slogans such as “Just do it,” the shape of the Coca-Cola bottle, and the Apple logo are examples of protected trademarks.⁹⁷ Trademarks protect consumers from being confused or deceived about the source of goods or services, and protect the goodwill associated with the mark.⁹⁸ Merchants can obtain trademark protection under state common law or by registration under the federal Lanham Act.⁹⁹ Like patents and copyrights, trademark owners may license the use of the mark or assign it to another.¹⁰⁰ Universities routinely register their names, logos, and school colors as trademarks¹⁰¹ to ensure their proper use and generate revenue through licensing of merchandise.¹⁰²

⁹⁴ See *Seshadri v. Kasraian*, 130 F.3d 798, 803 (7th Cir. 1997) (reasoning that to be a joint author in the preparation of a scholarly paper, a research assistant must contribute significant copyrightable material).

⁹⁵ See *infra* notes 168–70 and accompanying text.

⁹⁶ See 15 U.S.C. §§ 1051(a)(3), 1127 (2012).

⁹⁷ SPRINT, Registration No. 4,282,285; JUST DO IT, Registration No. 1,875,307; The mark consists of a three dimensional configuration of a modernized version of the Coca-Cola Contour Bottle, rendered as an aluminum bottle having a distinctive curved shape, Registration No. 4,200,433; APPLE, Registration No. 1,078,312 (word only); The mark consists of a silhouette of an apple with a bite removed, Registration No. 1,114,431 (design logo).

⁹⁸ See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995).

⁹⁹ The process of registering a trademark is similar to that of applying for a patent. A merchant must file an application with the USPTO which will assign an examiner to review the application and determine whether the trademark meets the requirements for protection. For an overview of the registration process, see generally MARY LAFRANCE, UNDERSTANDING TRADEMARK LAW § 2.10 (2d ed. 2009). The term of federal registration of a trademark is ten years, although it can be renewed as long as the mark is in actual use. 15 U.S.C. §§ 1058–1059.

¹⁰⁰ See CHISUM ET AL., *supra* note 40, at 521–22.

¹⁰¹ See generally, e.g., John Grady & Steve McKelvey, *Trademark Protection of School Colors: Smack Apparel and Sinks Decisions Trigger Color-ful Legal Debate for the*

The right of publicity is the exclusive right of prominent individuals, such as entertainers, models, and professional athletes, to control the commercial exploitation of their identity.¹⁰³ Publicity rights allow individuals to benefit from the commercial value of their names, image, and other distinctive aspects of their identity, such as voice, style of clothing, or mannerisms.¹⁰⁴ This prevents dilution of the commercial value of his or her reputation, and the goodwill associated with it.¹⁰⁵ Likewise, the right of publicity protects against any false or misleading suggestions that a prominent individual has endorsed or sponsored a product when he or she has not.¹⁰⁶ In this sense, the right of publicity resembles a personal trademark.

Like other intellectual property rights, the right of publicity may be transferred by license or assignment.¹⁰⁷ Many states also recognize the right of publicity as an inheritable interest that passes to the famous individual's heirs, who can then commercially

Collegiate Licensing Industry, 18 J. LEGAL ASPECTS SPORT 207, 225–26 (2008); R. Charles Henn Jr. et al., *Protecting Collegiate Color Schemes: How Recent Developments in Trademark Law Enable Institutions to Further Preserve and Strengthen Their Brand Identities*, 12 VA. SPORTS & ENT. L.J. 1, 9 (2012); Jacob H. Rooksby, *University™: Trademark Rights Accretion in Higher Education*, 27 HARV. J.L. & TECH. 349, 371 (2014).

¹⁰² The amount of revenue generated by licensing of university trademarks is considerable, yielding billions of dollars in merchandise sales. See John Jennings, *University Trademark Licensing: Creating Value Through a “Win-Win” Agreement*, WORLD INTELLECTUAL PROP. ORG., http://www.wipo.int/sme/en/documents/uni_trademark_licensing_fulltext.html [https://perma.cc/5CRC-R96D] (last visited Jan. 9, 2017).

¹⁰³ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (AM. LAW INST. 1995).

¹⁰⁴ See *id.* § 38. The scope of the modern right of publicity is broad, encompassing a wide range of indicia of distinctive personal identity beyond name and likeness. See, e.g., *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 811 (9th Cir. 1997) (discussing the right of publicity for a portrayed fictional character); *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 836 (6th Cir. 1983); *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 824 (9th Cir. 1974).

¹⁰⁵ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. c.

¹⁰⁶ See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

¹⁰⁷ See 2 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* §§ 10.13, 10.15 (2d ed. 2008).

exploit it for a certain period of time afterward.¹⁰⁸ When an individual's right of publicity has been used for advertising or commercial purposes without permission, he or she may sue for misappropriation.¹⁰⁹ Closely related to an action for misappropriation of the right of publicity is a claim for false endorsement under the federal Lanham Act.¹¹⁰ False endorsement occurs when a person is connected with a product in such a way that is likely to mislead consumers about that person's association with or sponsorship or approval of the product.¹¹¹

Although most students do not possess publicity rights, student athletes are in a different category. Increasingly, merchandisers seek out prominent student athletes to secure endorsements and the use of their images and names for promotional purposes.¹¹² In a pair of recent decisions, the Ninth Circuit Court of Appeals recognized the right of student athletes to be compensated for the use of their names and likenesses for purposes of trade. In the first case, the court held that a video game developer's use of images of college athletes in its video games was not protected by the First Amendment, and therefore upheld a former college football player's right of publicity claims.¹¹³ The use of student athlete publicity rights is governed by the rules of the National Collegiate

¹⁰⁸ See, e.g., IND. CODE §§ 32-36-1-8(a), 32-36-1-17 (2017); OKLA. STAT. tit. 12, § 1448(D) (2017); TENN. CODE ANN. § 47-25-1104 (2017).

¹⁰⁹ See 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 3.2 (2d ed. 2008).

¹¹⁰ See 15 U.S.C. § 1125(a) (2012).

¹¹¹ See *Fifty-Six Hope Rd. Music, Ltd. v. A.V.E.L.A., Inc.*, 778 F.3d 1059, 1069 (9th Cir. 2015); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992).

¹¹² James A. Johnson, *The Right of Publicity and the Student-Athlete*, 7 ELON. L. REV. 537, 546 (2015) (noting that student athletes are of great publicity value to academic institutions).

¹¹³ See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1284 (9th Cir. 2013); see also *Lightbourne v. Printroom, Inc.*, 122 F. Supp. 3d 942, 948 (C.D. Cal. 2015) (finding that a student athlete's consent to use of his image pursuant to an authorization form allowing the university to use or sell photographs taken during his participation in the university's intercollegiate athletic team precluded a right of publicity claim against the university's exclusive licensee relating to the sale of his photograph through an online store operated by the licensee); *Keller v. Elec. Arts, Inc.*, No. C 09-1967 CW, 2010 WL 530108, at *5 (N.D. Cal. Feb. 8, 2010) (determining that a video game creator's depiction of a former college football player in a video game was not sufficiently transformative to bar his California right of publicity claims).

Athletic Association (the “NCAA”),¹¹⁴ which is the governing body for intercollegiate sports.¹¹⁵ Its member institutions agree to abide by its rules and student athletes similarly must follow NCAA rules,¹¹⁶ which seek to preserve amateurism in collegiate sports by limiting student-athletes’ compensation and their interactions with professional sports leagues.¹¹⁷ These rules forbid student athletes from accepting any compensation based on athletic ability from organizations or merchants seeking endorsements through the use of the athlete’s name, image, or likeness.¹¹⁸

In the second case, the Ninth Circuit ruled that NCAA’s compensation rules could be subject to scrutiny under the federal antitrust laws.¹¹⁹ Thus, while not all university students may achieve a level of fame or popular recognition that allows them to assert a right of publicity in their identities, the rights of student athletes are clear—even though NCAA compensation rules may be in flux, pending the outcome of further litigation. Moreover, as is often done by professional athletes, some student athletes may be able to claim trademark protection for words or phrases they have coined or with which they have become associated.¹²⁰

¹¹⁴ See *O’Bannon v. Nat’l Collegiate Athletic Ass’n*, 802 F.3d 1049, 1052 (9th Cir. 2015).

¹¹⁵ See *id.*

¹¹⁶ See *id.* at 1054.

¹¹⁷ See Victoria Roessler, *College Athlete Rights After O’Bannon: Where Do College Athlete Intellectual Property Rights Go From Here?*, 18 *VAND. J. ENT. & TECH. L.* 935, 938–40 (2016) (explaining the history of the NCAA rules and their purpose in preventing the exploitation of student athletes for potential profit).

¹¹⁸ See *id.* at 940. For additional discussion of the NCAA rules, see Daniel E. Lazaroff, *The NCAA in Its Second Century: Defender of Amateurism or Antitrust Recidivist?*, 86 *OR. L. REV.* 329, 333–36 (2007).

¹¹⁹ See *O’Bannon*, 802 F.3d at 1075. For an analysis of the antitrust aspects of the NCAA rules, see William W. Berry III, *Employee-Athletes, Antitrust, and the Future of College Sports*, 28 *STAN. L. & POL’Y REV.* 245 (2017) (discussing antitrust case law in the context of college athletics).

¹²⁰ See Ryan S. Hilbert, *Maintaining the Balance: Whether a Collegiate Athlete’s Filing of a Federal Trademark Application Violates NCAA Bylaws*, 2 *BERKELEY J. ENT. & SPORTS L.* 120, 121–22 (2013) (discussing registration by specific athletes); Roessler, *supra* note 117, at 954 (discussing trademark registration by student athletes).

II. UNIVERSITY POLICIES ADDRESSING STUDENT OWNERSHIP RIGHTS

In this Part, this Article surveys the intellectual property policies adopted by selected universities to identify ownership rights as they may be vested in the university and its students. This Article also examines the policies to identify common provisions among them, as well as differences in their provisions. In addition, this Article discusses some of the specialized provisions found in the policies and notes other observations.

A. *Why Have University Intellectual Property Policies?*

According to the World Intellectual Property Organization, there are eighty-two universities and research institutions in the United States that have adopted student intellectual property policies.¹²¹ These policies act as a response to the exploration and research that university members regularly conduct.¹²² Often, these activities lead to the discovery of an invention or creation of a work of authorship.¹²³ These creations and inventions may be developed in the regular course of research or creative activity as part of employment, pursuant to a contractual agreement with the university or external funding source; as a result of a class assignment; as part of a student extracurricular activity or competition; or simply by free will during a person's free time. In each case, the issue arises as to ownership rights in the resulting intellectual property, and whether universities have any claim of ownership along with the creators.

However, many universities do not have intellectual property policies, as they either make no claims in any instance where a student develops an invention or creates a work of authorship, or they address ownership only through contractual agreements

¹²¹ *Intellectual Property Policies for Universities*, WORLD INTELLECTUAL PROP. ORG., http://www.wipo.int/policy/en/university_ip_policies/ [https://perma.cc/BAU5-DQXQ] (last visited Mar. 14, 2017) (search Country/Territory field for United States of America).

¹²² *See id.*

¹²³ *See id.*

involving specific grants or sponsorships.¹²⁴ The problem with this approach is that these agreements do not cover the spectrum of scenarios involving ownership that may arise. Another problem with relying solely on contractual agreements on a case-by-case basis is that students have no prior notice or guidance about potential ownership rights. This may have led many universities to adopt student intellectual property policies to govern ownership interests, depending on university involvement in the creation of the work or conception of the invention.

B. Universities Chosen and Selection Process

This Section begins by describing how the universities were selected for review. For the purposes of this study, twenty of the eighty-two student intellectual property policies at U.S. universities were selected from the WIPO database in order to examine the similarities and differences in separate university policies. The twenty universities chosen represent U.S. universities overall and provide a spectrum of selection criteria. The universities chosen are from different geographic regions of the United States, including the west coast, east coast, and midwest, in order to examine a range of policies from across the country. The universities range from California State University, San Bernardino¹²⁵ on the west coast, to Carnegie Mellon University¹²⁶ and Harvard University¹²⁷ on the east coast. Our selection process also includes private universities—such as the University of

¹²⁴ See, e.g., ANTELOPE VALLEY COLL. DIST., ADMINISTRATIVE PROCEDURES: GENERAL INSTITUTION ch. 3 (2017), <https://www.avc.edu/sites/default/files/administration/board/board%20policy/Administrative%20Procedures%20-%20Chapter%203%20%28General%20Institution%29.pdf> [https://perma.cc/QJ9F-EZCG].

¹²⁵ See generally UNIV. COPYRIGHT/FAIR USE COMM., CAL. STATE UNIV., SAN BERNARDINO, INTELLECTUAL PROPERTY POLICY: FAM 500.8 (2001), [http://senate.csusb.edu/fam/Policy/\(FSD00-11.R1\)Intellectual_Property.pdf](http://senate.csusb.edu/fam/Policy/(FSD00-11.R1)Intellectual_Property.pdf) [https://perma.cc/6HLW-466T].

¹²⁶ See generally *Intellectual Property Policy*, CARNEGIE MELLON UNIV., <http://www.cmu.edu/policies/administrative-and-governance/intellectual-property.html> [https://perma.cc/5YSP-PGKD] (last visited Feb. 2, 2018).

¹²⁷ See generally HARVARD UNIV., STATEMENT OF POLICY IN REGARD TO INTELLECTUAL PROPERTY (2013), http://otd.harvard.edu/upload/files/IP_Policy_12-12-13_FINAL.pdf [https://perma.cc/L46M-DU4G].

Southern California (“USC”)¹²⁸ and Howard University¹²⁹—as well as public universities—such as the University of Washington¹³⁰ and the University of Illinois.¹³¹

The analysis of this selection identifies any variations among universities that are private versus those universities that are public research institutions. The selection process also considered the prestige of these universities’ research reputation, based on high, low, or medium prestige, ranging from Yale University¹³² to New York University¹³³ and Kansas State University.¹³⁴ The selection process also separated religious universities, such as Notre Dame University¹³⁵ and St. John’s University,¹³⁶ in an attempt to discover any anomalies. The intent of these criteria is to avoid discrepancies due to unique policies from different geographic locations or unique provisions from universities of different prestige. The

¹²⁸ See generally UNIV. OF S. CAL., INTELLECTUAL PROPERTY POLICY, LA/609055.3 (2001), http://policy.usc.edu/files/2014/02/intellectual_property.pdf [<https://perma.cc/G6UR-K23F>].

¹²⁹ See generally OFFICE OF THE GEN. COUNSEL, HOWARD UNIV., 100-006 INTELLECTUAL PROPERTY POLICY (2014), <http://www.howard.edu/secretary/documents/100-006IntellectualPropertyPolicy.pdf> [<https://perma.cc/W6EQ-GZR9>].

¹³⁰ See generally UNIV. OF WASH., EXECUTIVE ORDER NO. 36, PATENT, INVENTION, AND COPYRIGHT POLICY (2015), <http://www.washington.edu/admin/rules/policies/PO/EO36.html> [<https://perma.cc/C268-3QAB>].

¹³¹ See generally *Student Ownership Policy*, OFFICE OF TECH. MGMT. ILL., <http://otm.illinois.edu/disclose-protect/student-ownership-policy> (last visited Feb. 24, 2017) [<https://perma.cc/5FQT-RGV5>].

¹³² See generally YALE UNIV., YALE UNIVERSITY PATENT POLICY (1998), https://ocr.yale.edu/sites/default/files/files/Yale_Patent_Policy.pdf [<https://perma.cc/7ZN7-LT8L>] [hereinafter YALE PATENT POLICY]; *Yale University Copyright Policy*, YALE UNIV., <http://ocr.yale.edu/faculty/policies/yale-university-copyright-policy> [<https://perma.cc/7UUM-KTVZ>] (last visited Feb. 24, 2017).

¹³³ See generally N.Y. UNIV., STATEMENT OF POLICY ON INTELLECTUAL PROPERTY (2012), <https://www.nyu.edu/content/dam/nyu/compliance/documents/IPPolicy.pdf> [<https://perma.cc/3W99-WZSA>].

¹³⁴ See generally KAN. STATE UNIV., *Intellectual Property*, in POLICIES AND PROCEDURES MANUAL: SPONSORED RESEARCH PROJECTS ch. 7095 (July 30, 2013), <https://www.k-state.edu/policies/ppm/7000/7095.html> [<https://perma.cc/S6TM-S83S>].

¹³⁵ See generally UNIV. OF NOTRE DAME, INTELLECTUAL PROPERTY POLICY no. 5.7 (2015), <http://policy.nd.edu/assets/203061/intellectualpropertypolicy.pdf> [<https://perma.cc/2UL5-YQ9V>].

¹³⁶ See generally ST. JOHN’S UNIV., INTELLECTUAL PROPERTY POLICY (2014), http://www.stjohns.edu/sites/default/files/documents/law/intellectual_property_policy_fin_al_2.pdf [<https://perma.cc/UQ94-6VCJ>].

twenty universities selected allow these criteria to be met without the need to examine all eighty-two institutions. This study compares and contrasts the similarities among the university policies chosen, as well as the differences the study discovered.

C. Common Provisions

Most universities take a similar approach to intellectual property policies. Their policies share a traditional approach to research that is reflected within their stated purposes and material provisions. Most universities agree in their policies that their main purpose is to encourage research and innovation for the benefit of the public. Yale's policy states: "Encouragement of such inventions [i.e., patents] in appropriate ways is both supportive of the public interest and consistent with the advancement of knowledge for its own sake, the primary purpose of teaching and research in a university."¹³⁷ The goal of USC's policy "is to encourage creative activity and the prompt and open dissemination of ideas and inventions by recognizing and rewarding individual members of the faculty and staff. The commitment to develop new knowledge includes facilitating the practical application of that knowledge for public use."¹³⁸ The Kansas State University policy states its purpose as "foster[ing] both the development and the dissemination of useful creations, products or processes," and adds that "[d]issemination of products and materials is encouraged by providing for their protection, thus making their commercial development and public application attractive with the intent of providing the most benefit for society."¹³⁹

One rationale underlying these policies is to reaffirm each university's commitment to research and its support of inventors and creators within each university's community. Because so many of the policies share the same purpose, they tend to contain substantially similar provisions as to patentable inventions and copyrightable works. These policies mostly govern faculty, but

¹³⁷ YALE PATENT POLICY, *supra* note 132, § 1.

¹³⁸ UNIV. OF S. CAL., *supra* note 128, § 1.

¹³⁹ KAN. STATE UNIV., *supra* note 134, § 7095.020.

many apply these policies to students as well.¹⁴⁰ Some universities apply the same policies to both faculty and students.¹⁴¹ As a general matter, students typically have more self-determination in terms of ownership, as long as they are not employees of the university.¹⁴² Does the fact that university students are not employed mean that they are always free from university ownership? Most students, even those who may be familiar with intellectual property law, would assume so, but they may be in for a surprise if they attend universities with student intellectual property policies. For example, students do not have to be employees to assign their ownership rights to a university—under Kansas State University’s policy, students also assign rights when collaborating with faculty members.¹⁴³ These policies even require licensing agreements if the university does not have the right to assignment under the policy.¹⁴⁴ Most university policies contain similar provisions involving: substantial use, works created through agreements or contracts, specific assignments of intellectual property, employment for work on specific research, commissioned works for hire, provisions on student classwork, computer software, and copyright freedom. The similarities will be explained in the next Section. This Section begins with the common provision of substantial use and continues down the list. Most people believe that an inventor or creator will always retain ownership of the intellectual property for their work, because the foundation of intellectual property law is to encourage innovation through the reward of ownership rights. However, university policies contradict that presumption in some instances.

Many policies contain provisions that would require students to assign their ownership rights to the universities they attend if they make “significant use” of a university’s facilities.¹⁴⁵ The policies

¹⁴⁰ See, e.g., *Student Ownership Policy*, *supra* note 131.

¹⁴¹ See, e.g., *id.*

¹⁴² See, e.g., *Student Entrepreneurship Activities Section of Student Ownership Policy*, *supra* note 131.

¹⁴³ See KAN. STATE UNIV., *supra* note 134, § 7095.050.E.

¹⁴⁴ See, e.g., *id.*

¹⁴⁵ See, e.g., UNIV. OF S. CAL., *supra* note 128, § 2.1.

of the University of Washington,¹⁴⁶ NYU,¹⁴⁷ Carnegie Mellon,¹⁴⁸ USC,¹⁴⁹ Howard,¹⁵⁰ Notre Dame,¹⁵¹ Kansas State University,¹⁵² and Yale,¹⁵³ all agree that substantial use of facilities or other resources will grant the respective universities the right to ownership of a patent or copyright. What exactly defines substantial use? Every university defines substantial use differently. The Carnegie Mellon Policy defines it as the:

[E]xtensive unreimbursed use of major university laboratory, studio or computational facilities, or human resources. The use of these facilities must be important to the creation of the intellectual property; merely incidental use of a facility does not constitute substantial use, nor does extensive use of a facility commonly available to all faculty or professional staff (such as libraries and offices), nor does extensive use of a specialized facility for routine tasks.¹⁵⁴

Many of the policies agree that substantial use is not defined as that of library use or use of facilities that an ordinary student would be able to make without permission.¹⁵⁵ To be substantial, the use must occur in a facility where a student would need permission from the university to use that space.¹⁵⁶ The reason behind this treatment is that special facilities are exclusive university properties that act as monetary support to an individual. Meanwhile, Harvard,¹⁵⁷ University of Illinois,¹⁵⁸ St. John's,¹⁵⁹

¹⁴⁶ See UNIV. OF WASH., *supra* note 130, § 1.C.

¹⁴⁷ See N.Y. UNIV., *supra* note 133, § III-A(1).

¹⁴⁸ See CARNEGIE MELLON UNIV., *supra* note 126, § 2.

¹⁴⁹ See UNIV. OF S. CAL., *supra* note 128, § 2.1.

¹⁵⁰ See HOWARD UNIV., *supra* note 129, § V.1.C.2.

¹⁵¹ See UNIV. OF NOTRE DAME, *supra* note 135, § 3.

¹⁵² See KAN. STATE UNIV., *supra* note 134, § 7095.050.

¹⁵³ See *Yale University Copyright Policy*, *supra* note 132, § 4.

¹⁵⁴ See CARNEGIE MELLON UNIV., *supra* note 126, § 2.

¹⁵⁵ See, e.g., KAN. STATE UNIV., *supra* note 134, § 7095.110.

¹⁵⁶ See *id.* (indicating that a unit leader may provide “a written statement . . . concerning the level of use of . . . [u]niversity . . . facilities”).

¹⁵⁷ See HARVARD UNIV., *supra* note 127, § II-B.

¹⁵⁸ See *Student Ownership Policy*, *supra* note 131.

Tennessee State University,¹⁶⁰ Missouri State University,¹⁶¹ University of Texas, Dallas (“UT Dallas”),¹⁶² Fayetteville State University,¹⁶³ and Pacific University,¹⁶⁴ all require assignment, or at least disclosure by the student for the possibility of assignment, if the student made use of facilities that would normally be inaccessible to the public without permission. The University of Georgia requires that the owner simply share ownership in the case of substantial use.¹⁶⁵ It is common for the policies to include provisions governing agreements involving inventors and authors before intellectual property is created.¹⁶⁶ The universities surveyed agree that any agreement made between the university and a third party, the federal government, or between a student and a third party, determines ownership rights according to the terms of the agreement. As an example, Carnegie Mellon’s policy states: “Intellectual property created as a result of work conducted under an agreement between an external sponsor and the university that specifies the ownership of such intellectual property shall be owned as specified in said agreement.”¹⁶⁷ Similarly, Harvard’s policy states, “[w]henever research or a related activity is subject

¹⁵⁹ See ST. JOHN’S UNIV., *supra* note 136, § III(a).

¹⁶⁰ See *Applicability*, Section 805.00 of *Intellectual Property Policies: Official Documents*, TENN. STATE UNIV. (June 3, 2004), <http://www.tnstate.edu/research/policies.aspx> [<https://perma.cc/ZDL9-VJHC>].

¹⁶¹ See MO. STATE UNIV.-W. PLAINS, APPENDIX A: INTELLECTUAL PROPERTY § 3 in FACULTY HANDBOOK (2015), <https://experts.missouristate.edu/display/WP14/WP+-+West+Plains+Faculty+Handbook+documentation?preview=/31883267/54274608/faculty-handbook-20150515.pdf> [<https://perma.cc/54EX-NLVW>].

¹⁶² See *Definition*, UNIV. OF TEX. DALL., UTDPP1002 – INTELLECTUAL PROPERTY POLICY § 1.1 (2016), <https://provost.utdallas.edu/policy/makepdf/utdpp1002> [<https://perma.cc/P4VC-L5GM>].

¹⁶³ FAYETTEVILLE STATE UNIV., *Patent and Copyright Policies*, in THE UNC POLICY MANUAL ch. 500.2, § IV (2001), <http://www.northcarolina.edu/apps/policy/index.php?pg=dl&id=s2787&format=pdf&inline=1> [<https://perma.cc/KSU2-D62K>].

¹⁶⁴ See PACIFIC UNIV., INTELLECTUAL PROPERTY POLICY § II (2011), https://www.pacificu.edu/system/files/forms/2011IntellectualPropertyPolicy_FS_UC_Aproved.pdf [<https://perma.cc/HSU6-S26P>].

¹⁶⁵ *Intellectual Property Policy of the University of Georgia* § II.C, UNIV. OF GA. (Nov. 8, 1995), <https://research.uga.edu/documents/intellectual-property/> [<https://perma.cc/3M7P-L555>].

¹⁶⁶ See, e.g., CARNEGIE MELLON UNIV., *supra* note 126, § 3-1.

¹⁶⁷ *Id.*

to an agreement between the University and a third party that contains obligations or restrictions concerning copyright or the use of copyrighted materials, those materials shall be handled in accordance with the agreement.”¹⁶⁸ All twenty university policies agree that specific assignment of inventions or works of authorship by the university results in an assignment of ownership rights to the university. Howard’s policy on copyright begins by stating:

The University has a right to assignment of copyrightable works that are “works for hire” as defined by the *Copyright Act of 1976, as amended*, to the extent that such copyrightable works are created within the scope of the author’s employment including, but not limited to, online courses commissioned by the University, with the University, or within the scope of work of the author’s contract with the University.¹⁶⁹

Similarly, Notre Dame’s policy provides that the university owns all of the:

Educational Materials (including computer programs, software, mobile apps, games, or multimedia productions) that are works made for hire . . . unless otherwise specified . . . or that are required to be assigned to the University by contract terms with third parties or by the terms of a grant or sponsored program under which the University is a recipient.¹⁷⁰

Students do not even have to be employees of the universities for this provision to hold true.¹⁷¹ The university may simply direct that student in what will be created and offer either financial support or support by any other means.¹⁷² The student would then create the work, but would do so knowing that he or she will not own the

¹⁶⁸ HARVARD UNIV., *supra* note 127, at 5.

¹⁶⁹ HOWARD UNIV., *supra* note 129, § V.1.C.1.a.

¹⁷⁰ UNIV. OF NOTRE DAME, *supra* note 135, § 2.3.1.

¹⁷¹ *See* CARNEGIE MELLON UNIV., *supra* note 126, § 3-2 (failing to distinguish between faculty and students).

¹⁷² *See id.*

rights in the work in the end. University policies require that such provisions be made known to students before the creation occurs.¹⁷³

University policies also agree that ownership of intellectual property resulting from employment to create a specific invention or work of authorship will transfer to the universities. Notre Dame's policy applies to student employees through this provision: "The intellectual property resulted from a student's employment with, or other related compensation by, the University."¹⁷⁴ Likewise, the UT Dallas policy applies to "[a]ll persons employed by UT Dallas."¹⁷⁵ Some universities hire employees that mirror the duties of a Research and Development employee, whose specific job is to create inventions or author works for the university. The university acts as the employer in this case, and the employee is working within the scope of employment, so the employees must assign their rights to the university.¹⁷⁶

Further, the university policies this study reviewed provide that authors of works commissioned by written agreements with the university assign their copyrights to that university.¹⁷⁷ These works are known as "works made for hire," and university policies recognize their rights to ownership in these cases. For example, the UT Dallas policy mirrors the language of the Copyright Act:

[P]ursuant to a signed contract through which intellectual property is created by (a) an employee, student, or other individual commissioned, required, or hired specifically to produce such intellectual property by System or any of its member institutions and (b) an employee or student as part of an institutional project, or . . . that fits within one of the nine categories of works considered "works made for hire" under copyright law.¹⁷⁸

¹⁷³ See, e.g., *id.*

¹⁷⁴ UNIV. OF NOTRE DAME, *supra* note 135, § 3.

¹⁷⁵ See UNIV. OF TEX. DALL., *supra* note 162, § 2.1.1.

¹⁷⁶ See HOWARD UNIV., *supra* note 129, § V.1.B.2.

¹⁷⁷ See, e.g., *id.* § V.1.B.3–C.1.a.

¹⁷⁸ UNIV. OF TEX. DALL., *supra* note 162, § 2.1.4.4.

In accordance with provisions like these, the universities can claim ownership just as employers would when commissioning the creation of a work by way of a written agreement.

In addition, university policies assert that student-authored works created within a class, or as part of a class assignment for traditional academic purposes, remain the student's intellectual property.¹⁷⁹ The reasoning is that students are not employees of the university, and even when they are student-employees, assignments from a degree-required class are not specific assignments of employment. USC's policy, for instance, states that students generally retain full ownership of works unless the student is sponsored, compensated, or has made significant use of a university facility or resources.¹⁸⁰ Some universities make an exception, however, in terms of licensing. These policies require that universities receive a license for use of a student's work for educational purposes, such as the use of a thesis or a copy of a dissertation.¹⁸¹ The same exception usually applies to other forms of work created solely by a student, including: class notes; notes made from a textbook; poems; creative essays; and work created in the completion of assignments, such as algorithms and the like.¹⁸² The one exception for ownership of authored works—which is recognized by many of the universities, including Duke and Carnegie Mellon—involves computer programs and databases. Duke's policy applies to “[c]omputer programs, when the programs are primarily created to perform utilitarian tasks.”¹⁸³ Carnegie Mellon's copyright policy usually grants the creators full ownership, but in terms of computer software, “[t]his provision does not include computer software (other than educational courseware) or data bases.”¹⁸⁴ The computer programs must have

¹⁷⁹ See, e.g., *Exclusions* Section of *Student Ownership Policy*, *supra* note 131.

¹⁸⁰ See UNIV. OF S. CAL., *supra* note 128, §§ 2.1, 2.1(b).

¹⁸¹ See, e.g., *id.* § 2.1(b).

¹⁸² See, e.g., CARNEGIE MELLON UNIV., *supra* note 126, § 3-6-1.

¹⁸³ DUKE UNIV., *Policy on Intellectual Property Rights* Section of APPENDIX P: POLICIES RELATED TO RESEARCH, in *FACULTY HANDBOOK* § II(A)(1), at P-14 (2017), https://provost.duke.edu/wp-content/uploads/FHB_App_P.pdf [<https://perma.cc/SRW4-3C24>].

¹⁸⁴ CARNEGIE MELLON UNIV., *supra* note 126, § 3-6-1.

been created to perform utilitarian tasks.¹⁸⁵ If so, then the university has a right to assignment by the respective authors.¹⁸⁶ The logic behind this type of provision is that these programs or compilations of information are created for the purpose of the university, not the author. Thus, in the case of students, the university or faculty member would assign the creation of a program to students with the expectation that the program would have the potential for use throughout the university, and not just for the personal use of the student. This study observes that many of the policies contain a separate section for these types of works and all reserve similar rights of university ownership.

A final similarity of note among most of the university policies is that they grant authors more ownership rights than inventors. For the most part, students and faculty alike own their copyrights unless an exception applies. As this Article has pointed out, some universities make no demands as to copyrightable works that students create in class, and as to the class notes they take, since these are part of traditional degree-required work.¹⁸⁷ By contrast, inventors must assign their patent rights when their inventions occur as part of specific work or are the product of specific assignments.¹⁸⁸ Inventions, on the other hand, are usually developed for the purpose of research, and that purpose is more likely to serve the university's objectives, rather than those of the student.¹⁸⁹ In sum, most universities acknowledge that unless a substantial amount of support has been provided through the use of funding, facilities, and resources, or if the university has assigned the creation or invention of the work, then there is no claim to any of the student's intellectual property.

D. Differences Among Intellectual Property Policies

Although the policies share a number of similar provisions, this survey reveals that universities take a different approach to

¹⁸⁵ See, e.g., *id.*

¹⁸⁶ See, e.g., *id.*

¹⁸⁷ See *supra* note 179 and accompanying text.

¹⁸⁸ See UNIV. OF WASH., *supra* note 130, § 1.C.

¹⁸⁹ See *id.* § 1.B.

ownership interest in at least one provision, and many reveal more differences. This Section discusses the differences in university provisions, and illustrates these differences with examples. The core ideas of facility use—along with sponsorship agreements—remain the same throughout the policies, but many policies disagree on the details—such as income distribution, disclosure, sponsorship possibility, employees on leave or visit, outside agreements, and research notes. Universities adjust their policies as they see fit, and this is where problems may arise. Even students who possess some understanding of intellectual property law may be surprised by the idiosyncrasies of some policies.

One major difference among university policies is income distribution to inventors and authors. Universities usually divide the income earned from intellectual property in the form of royalties and licensing fees as credit due to the original creator.¹⁹⁰ In addition, some universities collect the net proceeds of intellectual property at the start to fully cover the expenses of commercializing and protecting the rights, and then share the remaining net income with the inventor or author once these expenses are covered.¹⁹¹ It might be expected that net income would be divided equally between the university and student, but that is not always the case. Some universities, such as UT Dallas, do provide for a fifty-fifty split as to net income,¹⁹² but others do not. The Fayetteville policy provides that only up to fifteen percent of gross royalties will be given to the inventor or author,¹⁹³ while Pacific University will only divide the net royalties equally up to \$100,000, at which point the creators will only be allocated forty-five percent of the income until \$200,000, followed by only forty percent thereafter.¹⁹⁴ Carnegie Mellon distributes fifty percent of income earned only if it fails to give original creators prior notice as to their intellectual property rights for externally sponsored work.¹⁹⁵ Yale follows a similar formula to Fayetteville, but only

¹⁹⁰ See, e.g., HARVARD UNIV., *supra* note 127, at 8.

¹⁹¹ See, e.g., HOWARD UNIV., *supra* note 129, § V.2.C.1.

¹⁹² See UNIV. OF TEX. DALL., *supra* note 162, § 6.2.

¹⁹³ See FAYETTEVILLE STATE UNIV., *supra* note 163, § V.

¹⁹⁴ See *Patents* Section of PACIFIC UNIV., *supra* note 164, § I.

¹⁹⁵ See CARNEGIE MELLON UNIV., *supra* note 126, § 3-1.

distributes thirty percent to authors and inventors once \$200,000 in net royalties has been exceeded.¹⁹⁶ Harvard even retains the right to twenty percent of the income if it releases the intellectual property to the creator due to no interest for commercialization by the university.¹⁹⁷ As this demonstrates, income distribution from royalties and licensing fees varies from university to university, and student inventors and authors may find that income paid to them is less than expected.

There are also differences among the policies as to required disclosure of intellectual property and sponsorship. The University of Washington, for instance, requires disclosure from all student employees in order to determine if a university interest in the intellectual property exists.¹⁹⁸ California State University, San Bernardino, encourages that members of the university community disclose all intellectual property for scholarly purposes.¹⁹⁹ Yale requires that all inventions made within a university facility be reported to the university,²⁰⁰ while Duke requires disclosure by Duke full-time faculty of non-Duke internet teaching projects to determine if a conflict of interest exists.²⁰¹ Some universities, such as USC, require disclosure generally, while offering the possibility of sponsorship.²⁰² The implication there is that the university would also have the right to assignment once the sponsorship occurs.²⁰³ The University of Washington reviews an invention after disclosure to determine if sponsorship should occur.²⁰⁴ A number of universities take different approaches as to when disclosure must occur.

Some universities even have separate policies for employees on leave or visit, as well as outside agreements. NYU applies the same facility use, scope of employment and agreement provisions

¹⁹⁶ See YALE PATENT POLICY, *supra* note 132, § 4-d.

¹⁹⁷ See HARVARD UNIV., *supra* note 127, at 4-5.

¹⁹⁸ See UNIV. OF WASH., *supra* note 130, § 1.C.

¹⁹⁹ See CAL. STATE UNIV., SAN BERNARDINO, *supra* note 125, § V.

²⁰⁰ See YALE PATENT POLICY, *supra* note 132, § 3.

²⁰¹ See DUKE UNIV., *supra* note 183, § IV(B), at P-16.

²⁰² See UNIV. OF S. CAL., *supra* note 128, § 2.4.

²⁰³ See *id.* § 2.4-2.4(a).

²⁰⁴ See UNIV. OF WASH., *supra* note 130, § 1.C.

to employees on leave and visiting employees.²⁰⁵ This reflects the idea that universities should treat all creators equally, as well as ensure equal access to creations from all creators that fall under its policy. Some universities even show interest in agreements made between students who are employees and outside organizations. The University of Georgia's policy states that faculty agreements made with outside organizations, as well as consulting with outside organizations, shall be governed by the university's policy provisions.²⁰⁶ Yale must review outside agreements to determine if exceptions can be made to its policy for the agreement.²⁰⁷ It appears that many universities will extend their policies as far as they can, with the result that some students who believe their intellectual property is outside of the policy's reach may in fact be subject to the policy.

Some universities even apply their policies to research notes and related documents involved in the creation of the intellectual property. For example, NYU claims ownership over the research data involved with assigned inventions.²⁰⁸ Likewise, the University of Georgia claims ownership over all research notes, data reports, and notebooks if the works involved were assigned, utilized university resources, or were part of a sponsored agreement.²⁰⁹ Research property, such as non-patentable microorganisms, are claimed by some universities through the same provisions as patentable inventions. The policies of St. John's,²¹⁰ Harvard,²¹¹ Fayetteville State University,²¹² as well as Kansas State University,²¹³ include this type of provision, but other policies make no mention of this type of material.

What accounts for these differences among the policies? Based on our examination of the university policies this study surveyed,

²⁰⁵ See N.Y. UNIV., *supra* note 133, § III.C–D.

²⁰⁶ See UNIV. OF GA., *supra* note 165, § II.E.

²⁰⁷ See YALE PATENT POLICY, *supra* note 132, § 7.

²⁰⁸ See N.Y. UNIV., *supra* note 133, § III-G.

²⁰⁹ See UNIV. OF GA., *supra* note 165, § II.F.

²¹⁰ See ST. JOHN'S UNIV., *supra* note 136, §§ II(k), VIII(a).

²¹¹ See HARVARD UNIV., *supra* note 127, at 8.

²¹² See FAYETTEVILLE STATE UNIV., *supra* note 163, § IV.

²¹³ See KAN. STATE UNIV., *supra* note 134, § 7095.060.A, D.

the main area of distinction seems to be the reputation of the universities for research and scholarship. Universities with higher prestige and private universities appear to demand higher income from intellectual property and disclosure more often.²¹⁴ Universities such as Yale and Harvard demand higher income from their intellectual property.²¹⁵ Public universities less known for research usually offer more balanced terms as to ownership rights, and allow the student more leverage in negotiating and retaining ownership.²¹⁶

E. Specialized Provisions

Some university policies contain other provisions unique to their policies. USC's policy contains a provision on student filmmaking by which USC reserves ownership of the copyright to the film through the use of university resources and facilities.²¹⁷ NYU's policy contains a separate provision for intellectual property associated with "the treatment of any patient or the provision of other clinical services occurring at or under the auspices of NYU."²¹⁸ Duke's policy does not mention facility use, but does refer to resource use,²¹⁹ raising the question of whether a student would recognize that resources may include use of university facilities. Carnegie Mellon's policy measures income distribution and other provisions on the basis of 1984 dollars.²²⁰ The University of Illinois allows creators to retain copyrights in cases where students create and direct entrepreneurial events.²²¹ The policy at St. John's contains a section on commercialization that does not allow any creators to commercialize any course content, even if the creator owns it, without the written consent

²¹⁴ See, e.g., UNIV. OF NOTRE DAME, *supra* note 135, § 6.5.3; TENN. STATE UNIV., *supra* note 160, § 835.00.

²¹⁵ See YALE PATENT POLICY, *supra* note 132, § 4.d; HARVARD UNIV., *supra* note 127, at 5–6, 8–10.

²¹⁶ See, e.g., CAL. STATE UNIV., SAN BERNARDINO, *supra* note 125, §§ 6–7.

²¹⁷ See UNIV. OF S. CAL., *supra* note 128, § 2.1(b).

²¹⁸ N.Y. UNIV., *supra* note 133, § XI.A(1).

²¹⁹ See DUKE UNIV., *supra* note 183, § II(A)(3), at P-14.

²²⁰ See CARNEGIE MELLON UNIV., *supra* note 126, § 2.

²²¹ See *Student Entrepreneurship Activities* Section of *Student Ownership Policy*, *supra* note 131.

from the university.²²² Fayetteville expressly states that its policy is a condition of both employment as well as enrollment.²²³ The Fayetteville policy also dedicates the university to informing and educating the campus community about fair use for copyrightable works, as well as stipulating that the university can file for patents in any nations it so chooses.²²⁴ Finally, Kansas State University requires disclosure of all marketable computer software.²²⁵ Some of these provisions, along with the differences in policies noted in the previous section, may be a reflection of a university's institutional mission and priorities.

F. Summary and Observations

This Article's analysis of university policies allows for multiple observations. Many university policies contain provisions that are identical or substantially similar to those found at other universities. However, there are a number of significant differences among the policies as well. Most students are probably unaware of their intellectual property rights or the existence of student intellectual property policies at universities that have them. The probable cause is that many universities simply place these policies in a handbook or on a website with the unrealistic expectation that students will actually take the time to read such policies.

Aside from the concern of whether students at these universities are aware of or understand their rights under the policies, there is a question as to whether the policies are contractually binding on the students.²²⁶ Students must agree to the provisions of the policies, and thereby limit or release their rights to the university. Even when they are presented with an agreement to release their intellectual property rights, they rarely have the power to refuse these contracts if they wish to attend these

²²² See ST. JOHN'S UNIV., *supra* note 136, § VI(b).

²²³ See FAYETTEVILLE STATE UNIV., *supra* note 163, § IV.

²²⁴ See *id.* §§ IV, XII.1.

²²⁵ See KAN. STATE UNIV., *supra* note 134, §§ 7095.050.D, 7095.070.

²²⁶ One commentator has suggested that the policies may not be binding outside of works or inventions created by students within the course of their employment with the university. See TYANNA K. HERRINGTON, INTELLECTUAL PROPERTY ON CAMPUS: STUDENTS' RIGHTS AND RESPONSIBILITIES 39 (2010).

universities, or engage in research and participate in activities likely to generate intellectual property. As such, these policies may amount to contracts of adhesion,²²⁷ which are unenforceable when one party is viewed as possessing greater bargaining power so as to force the other party into agreement with little or no ability to negotiate terms.²²⁸ Finally, it is unlikely that many students are aware of their legal rights in the absence of the policies, or that they would be able to fully understand the intricacies of U.S. intellectual property law.

III. RESOLVING UNIVERSITY STUDENT INTELLECTUAL PROPERTY RIGHTS: LAW VERSUS UNIVERSITY POLICIES

As the discussion in the previous parts of this Article suggest, answering the question of ownership of intellectual property in student-created work may lead to different conclusions from those based on existing law, depending on whether a university policy applies. In this Part, this Article illustrates these possible divergent outcomes through a series of scenarios. The scenarios describe common situations in which students may develop or be involved in the development of intellectual property.

A. *Course Assignments and Projects*

Scenario: I Wrote It, I Sang It, I Own It!

A student enrolled in a creative writing class is required to write a poem as a course assignment that ends up expanding into a publishable work. Two other students majoring in music compose

²²⁷ An adhesion contract is “[a] standard-form contract prepared by one party, to be signed by another party in a weaker position, [usually] a consumer, who adheres to the contract with little choice about the terms.” *Adhesion Contract*, BLACK’S LAW DICTIONARY (10th ed. 2014).

²²⁸ See K.J. Nordheden & M.H. Hoeflich, *Undergraduate Research and Intellectual Property Rights*, 6 KAN. J.L. & PUB. POL’Y 34, 39 (1997) (describing a requirement that all students execute agreements assigning their rights as a condition of doing research “as antithetical to the educational mission of the university and highly exploitative of undergraduate labor”); Jaclyn Sayegh, Note, *Ownership Rights Don’t Stop at the Schoolhouse Gate: A Call for Protection of Undergraduate Students’ Rights to Copyrightable Work*, 23 J.L. & POL’Y 803, 821–38 (2015) (describing university policies as procedurally and substantively unconscionable).

a song as a project for a music composition class. They use a university piano and studio, and then record the song using university equipment. One student composed the lyrics and the other composed the music, and both were involved in recording the song. In a computer science class, the professor assigns students to create an online appointment scheduling system for use by the university in a tutoring lab for students enrolled in computer science classes. The students build the program on university time while in class. What are the rights of the students in these courses to the works created?

Analysis:

The copyrights in each of these works belong to their authors. The poem and computer program are considered literary works.²²⁹ The original expression found in the poem is protectable, but not the underlying idea, theme, or form.²³⁰ Likewise, the literal elements of the program expressed in its object and source are protected, but not its architecture, sequence, or algorithms.²³¹ Even though the program might be used by the university, the students are neither employees nor independent contractors retained by the university as software designers. As a result, the university would need to secure a license from the students to use the program.²³² Note also that software code is patent-eligible subject matter, so patent protection might be an alternative.²³³

As for the two music students, they have produced two copyrightable works. Both students contributed expressive elements to the resulting musical work and will be co-owners of the copyright in a joint work.²³⁴ Assuming they collaborated in

²²⁹ See 17 U.S.C. § 101 (2012) (defining “literary works”).

²³⁰ See *id.* § 102.

²³¹ See *Lotus Dev. Corp. v. Borland Int’l, Inc.*, 49 F.3d 807, 815 (1st Cir. 1995).

²³² Such a license is a transfer of the copyright, in whole or in part, authorizing the licensee to use the work. See 17 U.S.C. § 201(d).

²³³ See generally *Diamond v. Diehr*, 450 U.S. 175 (1981) (holding rubber molding software patentable); *State St. Bank & Tr. Co. v. Signature Fin. Grp., Inc.*, 149 F.3d 1368 (Fed. Cir. 1998), *abrogated by In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008), *aff’d but criticized sub nom. Bilski v. Kappos*, 561 U.S. 593 (2010) (holding financial services software patentable).

²³⁴ See *supra* note 71 and accompanying text.

recording the song, the students will co-own a copyright in the sound recording as well.²³⁵ In all of these instances, the university does not acquire any status as an author under U.S. copyright law simply by furnishing the students the opportunity or resources to create the works.²³⁶ The answers under the university policies differ a bit in this scenario. Generally, students retain their copyrights even when a class assignment or project leads to the creation of a work.²³⁷ “University faculty, staff, and students retain all rights in copyrightable materials they create, including scholarly works, subject to . . . exceptions and conditions.”²³⁸ Typically, these works are part of a student’s coursework and do not involve out of the ordinary use of university resources. The resources used in all three instances are typical for students and are used to the extent that the class project demands. The main area of difference lies in licensing. The university may not be able to claim ownership over the poem or song, but intellectual property policy provisions can grant universities licenses to use the works for educational purposes.²³⁹ Copyrightable songs for a music class and poems for writing courses have value for education of students, so

²³⁵ See *supra* note 71 and accompanying text.

²³⁶ In other words, contributing an idea for a class assignment or project, or the resources to complete it, is not a contribution of copyrightable expression to the creation of the work. See *Childress v. Taylor*, 945 F.2d 500, 506 (2d Cir. 1991); *S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081, 1086–87 (9th Cir. 1989).

²³⁷ See Lisamarie A. Collins, *Copyrightable Works in the Undergraduate Student Context: An Examination of the Issues*, 17 MARQ. INTELL. PROP. L. REV. 285, 300–01 (2013) (arguing that it should be presumed that students retain the rights to works and inventions created by students acting in their capacity as students); Rooksby, *supra* note 16, at 802–07 (arguing that students should presumptively own all the works they create as students).

²³⁸ UNIV. OF WASH., *supra* note 130, § 2.B.

²³⁹ See, e.g., N.Y. UNIV., *supra* note 133, § XI.G(3). The policy states:

In addition to any other NYU rights, NYU reserves, and effective upon the date the Creator becomes a member of the University Community, the Creator grants to NYU, a non-exclusive, perpetual, world-wide, royalty-free license (with the right to sublicense) to use such Copyrightable Work in any form or media for any purpose consistent with the mission of NYU, including educational and research purposes and for publicizing NYU or any program or department of NYU, and including the right to make derivative works for such purpose.

Id.

the universities can invoke their policies to obtain licenses for use of the works for educational purposes.

Computer programs, however, are an exception at universities. As the Duke Policy states, “intellectual property rights arising in certain categories of academic works (i.e., works primarily related to the teaching or research missions of the university), appear to justify exceptional treatment on a recurring or categorical basis: Computer programs, when the programs are primarily created to perform utilitarian tasks.”²⁴⁰ Many of the policies mentioned earlier include provisions that grant assignment to the universities in instances where computer programs have utilitarian use for the institutions.²⁴¹ The logic behind these exceptions may be that many of the programs assigned to students actually serve the university’s purpose and not the creator’s purpose. In this case, an online tutoring program probably serves the university more than it does the student, so the university can make a claim for ownership. To avoid conflict, universities tend to require students to execute assignment agreements at the beginning of courses involving such projects.²⁴²

*Scenario: Is It Yours? Is It Mine? With One Click, We’ll
Know in Time*

While enrolled in an information systems capstone class, a student conceives of and develops a one-click search system for use in conducting an industry analysis. This system allows analysts to view full industry information compiled from various sources. Instead of executing multiple searches in various databases, the one-click system locates such information as legal cases, financial information, management style, industry outlook, and competition through one search. The system is created as a course project. To build the system, the student had to access proprietary databases licensed by the university, and made use of the university’s mainframe computer for bulk data processing. Initially, the student

²⁴⁰ DUKE UNIV., *supra* note 183, § II(A), at P-14.

²⁴¹ *See, e.g.*, CARNEGIE MELLON UNIV., *supra* note 126, § 3-6-1; DUKE UNIV., *supra* note 183, § II(A)(1), at P-14; UNIV. OF S. CAL., *supra* note 128, § 2.1(b).

²⁴² *See, e.g.*, CARNEGIE MELLON UNIV., *supra* note 126, § 3-2; UNIV. OF WASH., *supra* note 130, § 2.B.4.

discussed the idea for the system with several members of the university faculty, and consulted regularly with her professor in developing the system. The professor assisted the student in designing a working model of the system by contributing ideas, suggestions, and advice. The system may be patentable. Does the university have any claims of ownership?

Analysis:

A capstone course or project provides a culminating experience for students. Often, a capstone involves producing a deliverable of some kind, such as the system in this scenario.²⁴³ Assume the system, which is a computer-assisted research process with a specific and substantial application for doing an industry analysis, is most likely patentable subject matter. However, to qualify for patent protection, the process will also need to be novel and nonobvious.²⁴⁴ Assuming that the system meets these requirements, the primary issues presented are inventorship and ownership of the patent rights. Based on the facts, the student appears to be responsible for conception of the invention, which means that the student had a definite idea of a complete and operative invention in her mind, rather than an abstract idea or course of research to pursue.²⁴⁵ If so, she is the inventor and is entitled to file a patent application claiming the invention.²⁴⁶

Whether her professor is a joint inventor entitled to apply for a patent with the student is less certain. Although joint inventors need not make the same type or amount of contribution, or at the same time, to claims of the invention,²⁴⁷ the professor's input must amount to a significant contribution as measured by the invention as a whole.²⁴⁸ In addition, it is not necessarily enough to simply

²⁴³ See Abigail Barrow et al., *supra* note 18, at 10.

²⁴⁴ See *supra* notes 27–28 and accompanying text.

²⁴⁵ See *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376 (Fed. Cir. 1986).

²⁴⁶ See 35 U.S.C. §§ 100, 115 (2012).

²⁴⁷ See *id.* § 116.

²⁴⁸ See *Acromed Corp. v. Sofamor Danek Grp., Inc.*, 253 F.3d 1371, 1379 (Fed. Cir. 2001).

assist the inventor in reducing her idea to practice.²⁴⁹ If the level of the professor's input and assistance amounted to guidance in the development and building of the system, rather than a contribution to its conception—even if in part—then it is unlikely that he is a joint inventor with the student. In that case, the student is the sole inventor entitled to ownership of the patent, if granted.

The analysis under typical university policies, however, could lead to a different conclusion. University policies generally allow students to retain ownership of patentable inventions in scenarios where classes are required by degree, and no substantial resource use occurred.²⁵⁰ In this case, a professor assisted in the work. Faculty members are treated as university resources in policies, so ownership rights depend on the level of their assistance.²⁵¹ The contribution of abstract ideas is not support, but contribution of ideas that lead to the conception and development of the invention can be sufficient.²⁵² A faculty member who assists a student in the creation of an invention may be considered support given by the university, depending on the level of contribution those ideas deliver. The university would only have the right to make a claim on the invention if the professor provided a significant contribution to the invention that would qualify the professor as a joint inventor.²⁵³ Additionally, the student utilized proprietary databases and the university's mainframe computer, which would not be normally offered to the public as resources. Under the definition of substantial use in most policies, use of resources not normally available to the public constitutes substantial use.²⁵⁴ In these circumstances, the university can make a claim to ownership.

²⁴⁹ See *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1460 (Fed. Cir. 1998).

²⁵⁰ See *MO. STATE UNIV.*, *supra* note 161, § 4.3; *UNIV. OF S. CAL.*, *supra* note 128, § 2.1(b).

²⁵¹ See, e.g., *CARNEGIE MELLON UNIV.*, *supra* note 126, § 2 (referring to use of “human resources”); *KAN. STATE UNIV.*, *supra* note 134, § 7095.110 (defining staff support as a resource).

²⁵² See *Hess v. Advanced Cardiovascular Sys., Inc.*, 106 F.3d 976, 980–81 (Fed. Cir. 1997).

²⁵³ See, e.g., *CARNEGIE MELLON UNIV.*, *supra* note 126, § 3–4.

²⁵⁴ See, e.g., *id.* § 2; *UNIV. OF S. CAL.*, *supra* note 128, § 2.1.

*B. Students as Employees**Scenario: Filching a Phenolic Phenomenon*

A professor of biochemistry is pursuing research on phenolic compounds. He is aided in his work by a graduate research assistant, who is employed by the university in that capacity while pursuing his Ph.D. studies, and an undergraduate student as part of her clinical studies. All of their work is done in university laboratories using university-owned equipment. In the course of their work, they develop a new synthetic phenolic compound that can be used as an antiseptic and decide to apply for a patent. Does the university have the right to claim ownership of the patent? What if the university enters into a sponsorship agreement with the outside organization or the professor receives a federally-funded grant to create this work?

Analysis:

Compositions of matter are patentable inventions.²⁵⁵ With respect to ownership of the patent rights, the main issue is whether the professor and students are joint inventors. This is likely to depend on whether the graduate research assistant and undergraduate student actually collaborated in the conception and development of the compound, or merely provided routine laboratory assistance.²⁵⁶ This result will change if there is external funding involved. Faculty intellectual property policies provide that ownership of “[i]ntellectual property created as a result of work conducted under an agreement between an external [funding source] and the university . . . [will] be . . . specified in [the] agreement.”²⁵⁷ If instead the research is funded by the federal government, then the Bayh-Dole Act comes into play. Under the Bayh-Dole Act, the university may retain ownership of the invention since it was developed with federal assistance, and may commercialize this invention through exclusive licensing agreements.²⁵⁸ However, the university must share the royalties

²⁵⁵ See 35 U.S.C. § 101 (2012).

²⁵⁶ See *supra* notes 36–37 and accompanying text.

²⁵⁷ CARNEGIE MELLON UNIV., *supra* note 126, § 3-1; see also UNIV. OF NOTRE DAME, *supra* note 135, § 2.3.5.

²⁵⁸ See 35 U.S.C. § 203.

that result from such licenses with the inventors.²⁵⁹ In this case, the professor and the graduate research assistant have both been hired to conduct research for the university that would normally be mentioned within their employment contracts. For example, USC's policy states: "Unless otherwise stated in this Policy, the University is the owner, under federal and California law, of all intellectual property created by members of the [u]niversity community which is . . . created or developed during the course of an individual's responsibilities to USC, including works made for hire."²⁶⁰ Both the professor and the research assistant would be required to assign their interests in the invention to the university as an invention created through the normal course of their employment.²⁶¹ Professors and graduate research assistants are typically hired to conduct research for universities, and must assign their rights when the work is conducted within the scope of their work.²⁶² This may lead to the anomalous result where the faculty member and graduate assistant, having agreed to assign their rights to the university, have no patent rights in the invention, but the undergraduate student—assuming she is a joint inventor and having signed no such agreement—shares the patent rights with the university.²⁶³

The university's claim on the undergraduate student's interest would depend on whether the student is considered to be a joint inventor.²⁶⁴ Joint inventorship in this case would depend on the nature of the contribution made by the undergraduate student. A student who merely cleans up the lab or acts as a secretary will not be considered a joint inventor, as no material contribution to the conception of the invention has been made.²⁶⁵ In contrast, a student who collects data, and conducts experiments that further the conception and reduction to practice of the compound, will most

²⁵⁹ See *supra* note 54 and accompanying text.

²⁶⁰ UNIV. OF S. CAL., *supra* note 128, § 2.1.

²⁶¹ See *id.*

²⁶² See *supra* note 176 and accompanying text.

²⁶³ See Nordheden & Hoeflich, *supra* note 228, at 36–37 (describing this result as “unexpected and ironic” and predicting that it would lead to litigation).

²⁶⁴ See *supra* notes 36–37 and accompanying text.

²⁶⁵ See *supra* note 56 and accompanying text.

likely be classified as a joint inventor. In the case that the student is not an inventor, the university would have full ownership. If the student is a contributor, then the university may only claim a share in the interest of the invention as a joint owner of the patent along with the undergraduate student.

*Scenario: Never Ask a Question for Which You Don't
Already Know the Answer*

A student, who is employed as a tutor by a university, creates a study guide for business law courses in order to make the process of tutoring students easier. The study guide contains many useful tips for tutors and their tutees for use in many of the courses offered at the university. It features lists of key terms, explanations of concepts, and visual diagrams to illustrate the material. In addition, the study guide uses questions and answers that present the information to readers in a way that resembles a Frequently Asked Questions (“FAQs”) section of a website. The study guide also contains fact patterns and examples to simplify the process of learning the material. The examples and hypotheticals are completely made up, and in no way reflect actual cases or examples found in textbooks. Is the study guide copyrightable and, if so, who owns the copyright? What if instead the student is employed as an office cashier for admissions, and he created the study guide for use in tutoring biology students in his spare time as an independent contractor?

Analysis:

The tutor would, most likely, create the study guide as a work made for hire, such that the university could make a claim of ownership under both the Copyright Act and its policy. The Copyright Act provides that a fixed work of authorship is copyrightable if it includes original expression.²⁶⁶ Facts and data already in existence are not generally protectable, as they present no original expression by the author.²⁶⁷ For this reason, FAQs are not generally held to be protectable by copyright because they use

²⁶⁶ See 17 U.S.C. § 102(a) (2012).

²⁶⁷ See *supra* note 63 and accompanying text.

common terms and common phrases found in every FAQ.²⁶⁸ Only the original expression contained in the questions and answers is protected, to the extent it does not merge with the underlying concepts.²⁶⁹ If this study guide was solely a compilation of terms and concepts, then it would probably qualify for “thin” copyright protection at most, depending on whether there was any original selection and arrangement of the content.²⁷⁰ However, the remainder of the study guide is more like instructional material since it contains tips, explanatory text, and diagrams, as well as explanations of concepts, fact patterns, and examples created by the student. These are original forms of expression, and the study guide as a whole would qualify for copyright protection.

In this case, the tutor is an employee of the university, and was hired to facilitate student learning. A study guide would serve the purpose of the tutor’s employment, so it is possible that the university may have a claim of ownership on any of the protectable material, due to the study guide being a work made for hire created in the normal course of his employment.²⁷¹ A definitive answer would probably turn on whether the student was encouraged or expected to develop instructional materials as part of his tutoring job.²⁷² On the other hand, if the student is employed as a cashier, it

²⁶⁸ See *Mist-On Sys., Inc. v. Gilley’s European Tan Spa*, 303 F. Supp. 2d 974, 978 (W.D. Wis. 2002) (“It follows that a business cannot copyright a Frequently Asked Questions page as such or copyright words or phrases commonly used to assemble any given Frequently Asked Questions page.”).

²⁶⁹ See *id.* at 978–80.

²⁷⁰ Meeting the bare minimum of originality in expression entitles the work to only “thin” copyright protection, which prevents virtually identical copying. See David E. Shipley, *Thin but Not Anorexic: Copyright Protection for Compilations and Other Fact Works*, 15 J. INTELL. PROP. L. 91, 132–34 (2007). To the extent that the choice and sequencing of the material is dictated by the nature of the subject matter, they would be *scènes à faire* for the course or raise the problem of merger of idea and expression. See *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 765 (9th Cir. 2003). These doctrines limit or preclude protection of expression that is standard to the genre or that is inseparable from ideas and facts. *Id.*

²⁷¹ See *supra* notes 72–74 and accompanying text.

²⁷² However, this conclusion is less than certain for the same reasons that ownership of faculty-created copyrightable works remains somewhat unclear in the absence of faculty copyright policies or pursuant to a collective bargaining agreement. See *supra* notes 13–15 and accompanying text.

is unlikely that the university would own the study guide as a work made for hire. He would not have created such a work as part of his duties as a cashier, and it would not normally be used within the scope of his university employment. Likewise, the study guide is not a specially ordered or commissioned work made for hire, since the student did not create it at the request of the university pursuant to a signed writing.²⁷³

University policy provisions are generally consistent with the definitions and requirements of the Copyright Act.²⁷⁴ Applying the policies to these facts, a tutor is hired for the purpose of assisting and guiding student learning. For instance, the Notre Dame policy states: “The intellectual property resulted from a student’s employment with, or other related compensation by, the University.”²⁷⁵ The same policy adds: “The University owns all Educational Materials (including computer programs, software, mobile apps, games, or multi-media productions) that are works made for hire under copyright law, unless otherwise specified in this policy.”²⁷⁶ The study guide facilitates that purpose, and is directly related to the student’s employment and the goals of the university. Accordingly, under at least one of the policies surveyed, the university would most likely have a claim on the copyrightable material contained in the study guide as outlined above. A cashier would most likely not be hired to create intellectual property, so the creation of a study guide lies outside the scope of his employment according to intellectual property policies as well.²⁷⁷ The cashier appears to have created the study guide for the purpose of his private tutoring job, which is outside the scope of employment for his university position as a cashier. As such, he would own the copyright in the work, rather than the university.

²⁷³ See *supra* note 76 and accompanying text.

²⁷⁴ See, e.g., *supra* notes 169, 174–78 and accompanying text.

²⁷⁵ UNIV. OF NOTRE DAME, *supra* note 135, § 3.

²⁷⁶ *Id.* § 2.3.1.

²⁷⁷ See, e.g., CARNEGIE MELLON UNIV., *supra* note 126, § 3-4; UNIV. OF NOTRE DAME, *supra* note 135, § 3.

*C. University-Sponsored Competitions and Activities**Scenario: Copyright Ownership Is Just a Brush Stroke Away*

A university sponsors a competition to redesign the university sports mascot. The winner is an art student, who receives a cash prize and is hired by the university to paint the newly designed mascot on the floor of the gymnasium. The new design of the mascot is featured in photographs posted on the university website, social media, and in university publications. In addition, the competition and the winning design and the painting are the subject of several articles in the student newspaper.

Analysis:

The artwork is a pictorial work eligible for copyright protection.²⁷⁸ As the author of the work, the student would be entitled to ownership of the copyright. Most likely, however, the university will end up owning the copyright. Given that the purpose of the competition is to benefit the university by redesigning the mascot, it is likely that the university would require transfer of the copyright as a condition of participating in the competition since it is a type of sponsorship, or require the winning participant to agree to assign his copyrights in the design and the painting to the university.²⁷⁹ If so, the assignments of copyright would likely be permanent, and must be in writing and signed by the student as owner of the rights conveyed.²⁸⁰ The analysis under university student intellectual property policies leads to a similar result. The university, in this case, has assigned students to create works for the university's purpose. The university is compensating the winning student with a cash prize, and the work serves no purpose to the student aside from the prize and recognition it brings. If the university does not make its ownership of the copyright clear in the agreement that students

²⁷⁸ See 17 U.S.C. § 102(a)(5) (2012). Pictorial works include two-dimensional works of graphic and applied art. See *id.* § 101 (defining "pictorial" works).

²⁷⁹ See *supra* notes 202–04 and accompanying text.

²⁸⁰ See 17 U.S.C. § 204(a). Furthermore, to the extent that the painting might qualify for moral rights protection under the Visual Artists Rights Act, the agreement would probably require the student to waive those rights since such rights cannot be transferred. *Id.* § 106A(e).

must sign to participate in the competition, then the student may still have a claim for a share of any profits made from the design as its creator. As the Carnegie Mellon Policy provides: “If the university fails to notify a creator, effectively and in advance, of limitations imposed on his intellectual property rights by internal university sponsorship, the creator is entitled to receive from the university 50% (fifty percent) of the net proceeds to the university resulting from his intellectual property.”²⁸¹ As such, the university will own the copyright.

*Scenario: When You Create VR, the Ownership Rights
Only Go So Far*

A university organizes and directs a competition for augmented reality (“AR”) and virtual reality (“VR”) software for use in compatible headsets and mobile devices that students hope to market as a start-up business. The event’s stated purpose is to encourage innovation in the fields of AR as well as VR. Students will design software with a multitude of uses, including: education, entertainment, health, and architectural planning. Some of the students’ VR applications submitted to the competition may be patentable and many will be marketable. This event offers not only a cash prize for the winner, but also offers consulting by business professionals to the student participants during their work. The consultants have been recruited by the university, and are volunteering their services free of charge or any claims to student work. The students demonstrate their software applications during a series of presentations at the end of competition. Along with funds, the university also supplies facilities not usually accessible to the public, and will assist in filing patent applications. The university has created this activity for the purpose of encouraging entrepreneurship and innovation, raised funds from university donors to support it, and has actively promoted the competition on campus. Attendance at presentations during the competition is open to the public. Who owns the intellectual property in the student software developed for the competition? What if an audience member during one of these events decides to create a

²⁸¹ CARNEGIE MELLON UNIV., *supra* note 126, § 3-2.

business using one of the VR business ideas presented during the competition?

Analysis:

The VR software may be protected by patent as well as copyright law.²⁸² As a business decision, the students will need to consider the advantages and disadvantages of copyright versus patent protection. An overall business idea built around the software, however, is protected by neither patent nor copyright law.²⁸³ Nevertheless, to prevent idea theft, the university should consider requiring participating students to sign nondisclosure agreements and alerting those who attend the presentations that the ideas presented are proprietary.²⁸⁴

Typically, student created and directed events allow creators to retain their intellectual property according to most of the university policies surveyed. The University of Illinois, for example, allows creators to retain copyrights in cases where students create and direct entrepreneurial events.²⁸⁵ The problem in this scenario, however, is that the university organized and directed the event. The participating students may create the software themselves, but the university may still make a claim due to its sponsorship of the activity. Sponsorship may equate to support in some instances.²⁸⁶

²⁸² See Jonathan M. Purow, *Virtual Reality May Create Novel IP Issues in the Real World*, LAW360 (Mar. 28, 2016), <https://www.law360.com/articles/769479/virtual-reality-may-create-novel-ip-issues-in-the-real-world> (“Creators that have made coded content that is sold in VR can protect it by copyright and register a federal copyright in the products.”).

²⁸³ The legal protection of ideas is limited—to qualify for such protection, the idea must be sufficiently novel and concrete. See *Baer v. Chase*, 392 F.3d 609, 620 (3d Cir. 2004) (illustrating the requirement of novelty); *Smith v. Recrion Corp.*, 541 P.2d 663, 665 (Nev. 1975) (noting the requirement of concreteness and novelty for quasi contractual recovery). Some states afford protection through the law of implied contract, while a few others recognize ideas as quasi-property in some instances. See *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 489–90 (9th Cir. 1984); *Blackmon v. Iverson*, 324 F. Supp. 2d 602, 607 (E.D. Pa. 2003).

²⁸⁴ In any event, it would be advisable for students not to disclose all details of their ideas to the public. For a discussion of idea protection law, see SAUNDERS, *supra* note 19, at 14.

²⁸⁵ See *Student Entrepreneurship Activities*, Section of *Student Ownership Policy*, *supra* note 131.

²⁸⁶ See *supra* notes 200–02 and accompanying text.

Here, sponsorship that contributes resources to an event may allow start-up businesses to come into fruition, and provides support to those students who participate.

The ownership claim in this case would depend on just how much the sponsorship contributed to the creation of the businesses that result from the activity. By way of example, according to the Carnegie Mellon Policy:

When the university provides funds or facilities for a particular project to the extent of substantial use, it may also choose to designate itself as sponsor of that work. The university may declare itself the owner of intellectual property resulting from said work. In such cases the university must specify in advance the disposition of any intellectual property rights arising from the project.²⁸⁷

The type of sponsorship that provides funds to start a business or directs students on how to initiate a business may constitute support that would allow a university to claim ownership.²⁸⁸ The university initiated and directed the competition, and plays a significant role in the creation of the business idea by providing funding and assistance from business professionals recruited to volunteer as consultants. Therefore, the university in this scenario may make a claim of ownership based on the support that it offers students in the creation of their respective businesses.

Scenario: Teacher, Look – I Made You a Notebook!

The university sponsors an engineering class with the goal of having students create marketable lecture/presentation/meeting-recording electronic notebook devices that would be used by the university's staff for meetings and conferences. The university also hopes to sell the notebooks to the public through its campus bookstore. Neither the university nor the professor assigned to teach the course offer much assistance in the actual creation of the notebooks, but the university does supply the funds for the devices, and provides access to faculty work spaces and equipment that

²⁸⁷ CARNEGIE MELLON UNIV., *supra* note 126, § 3-2.

²⁸⁸ See *Yale University Copyright Policy*, *supra* note 132, § 4.

would not normally be used by engineering students. Some students use these resources, but others choose to work at home on their own time. The notebook devices that result from their inventive efforts may be patentable. Who owns the rights to the notebooks if a patent is granted?

Analysis:

As previously discussed, the inventor of patent-eligible subject matter is entitled to the patent.²⁸⁹ Because the students are not employees of the university, the shop rights doctrine would not apply.²⁹⁰ The notebooks are designed for the purposes of the university, but the class may also be a degree requirement. In that case, the university would normally need a written agreement informing the inventor of ownership claims prior to the creation process. Many university policies contain such provisions on sponsorship and assignment.²⁹¹ The same policies imply that without such an agreement in place, the student will retain a claim to some percentage of the profits from the resulting intellectual property.²⁹² For instance, Carnegie Mellon's policy states that without an agreement in place, the university may still own the inventions under the provision of substantial use, but must at least share fifty percent of the profits from the invention with the inventor.²⁹³

If the students were specifically assigned to develop the invention for the university, then most policies agree that the university would be able to make a claim of ownership.²⁹⁴ The university assigned the invention for the purposes of the university and not the student. Generally, the policies provide that universities should make such ownership clear through pre-invention agreements because the students are not employees. For

²⁸⁹ See *supra* note 33 and accompanying text.

²⁹⁰ See *supra* notes 47–50 and accompanying text.

²⁹¹ See, e.g., UNIV. OF S. CAL., *supra* note 128, § 2.1; UNIV. OF WASH., *supra* note 130, § 1.C.

²⁹² See, e.g., UNIV. OF S. CAL., *supra* note 128, § 4.1(a); UNIV. OF WASH., *supra* note 130, § 2.E.1.

²⁹³ See CARNEGIE MELLON UNIV., *supra* note 126, § 3-2.

²⁹⁴ See, e.g., UNIV. OF S. CAL., *supra* note 128, § 2.1(b); UNIV. OF WASH., *supra* note 130, § 2.B.4.

example, a Carnegie Mellon policy provision exists for this purpose.²⁹⁵ The university may provide resources, but it also demands work from the inventor without compensating the students as employees. Policies acknowledge the need for agreement to avoid ownership conflicts with students, especially when potentially marketable intellectual property is involved.²⁹⁶

D. Student Extracurricular Activities

Scenario: Lights, Camera, Copyright!

Film students at a university belong to a documentary filmmaking club. The club receives money allocated by the student government. The members also raise money from external sources for their projects, such as educational development grants and scholarships from nonprofit organizations and film studios. For a set of recent projects, members wrote screenplays, and then produced short documentary films using university equipment and facilities, including soundstages and editing suites and software. Several of the films also featured campus locations. Later in the semester, the club sponsored a student film festival on campus to screen their films. The screenings were free to the campus community. Does the university have any claim of copyright ownership to the student films?

Analysis:

Motion pictures are audiovisual works, a category of works eligible for protection under the Copyright Act.²⁹⁷ Assuming the student films are original and fixed on film stock or in a digital medium, they are protected by copyright.²⁹⁸ Filmmaking tends to be a collaborative process, with creative contributions by a director, cinematographer, screenwriter, and others involved in the process.²⁹⁹ In the film industry, motion pictures are usually works made for hire—and the subject of assignments—with the copyright

²⁹⁵ See, e.g., *CARNEGIE MELLON UNIV.*, *supra* note 126, § 3-2 (requiring the university to give written notice in advance of the beginning of the work).

²⁹⁶ See, e.g., *CAL. STATE UNIV., SAN BERNARDINO*, *supra* note 125, §§ 5–7.

²⁹⁷ See 17 U.S.C. § 102(a)(6) (2012).

²⁹⁸ See *supra* notes 64–66 and accompanying text.

²⁹⁹ See *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247, 258 (2d Cir. 2015).

ownership vesting in the studio or production company.³⁰⁰ This simplifies the licensing and distribution process. It is unlikely that the student organization itself has entered into such a work made for hire arrangement with its members. Therefore, copyright ownership will have vested in each student filmmaker individually, or in a group of students, as a joint work where more than one student was involved in the creative aspects of the production, unless the grant and scholarship providers required assignment of the copyrights as a condition of funding.

From the standpoint of university policies, this set of facts presents multiple issues, one being external funding, another being university support, and the other being resource use. The university offers little support in this case. Here, the students themselves initiated and directed the event, which leaves little room for contribution from the university to the work in question. Indeed, since the university is not involved with funding, it has no claim of ownership rights. Rather, the students raised the funds and received remaining funds from external sources. The only means by which the university would be able to make a claim to ownership would be under the substantial resource use provision.³⁰¹ The students did use university equipment and facilities, so its claim to ownership would depend on the level of use by the students, and whether this use was significant beyond that typically used by student organizations and student-directed campus activities.

The only university policy examined in this study that addressed student films was the USC Policy, which reads:

A specific application of this policy is found in the School of Cinema-Television. Generally the University owns the copyright in any student-produced film or other audiovisual work, as such works typically require significant use of University resources in the form of cameras, editing devices and other equipment and facilities. The student

³⁰⁰ See *Garcia v. Google, Inc.*, 786 F.3d 733, 743, 752 (9th Cir. 2015).

³⁰¹ See *supra* notes 145–56 and accompanying text.

author, though, retains ownership (subject to a nonexclusive license to the University) of rights to the treatment, script or other written work product related to any such audiovisual work.³⁰²

As to the external funding in the form of grants or scholarships, the students may have to share ownership rights with or grant nonexclusive licenses to those external funders, depending on whether they reserved ownership or licensing rights as a condition of funding.

E. Student Athletes

Scenario: I Play the Game, Don't Be Lame, Pay Me for My Fame

A student football player for a major university has become widely known for his outstanding athletic prowess as a wide receiver. He has been interviewed often on local and national television, and his achievements on the field have been the subject of numerous articles in local newspapers and national sports media. In addition, he is widely followed on social media. His popularity extends to a distinctive celebratory dance that he does in the end zone when he scores a touchdown. He originated the dance and videos of it have been viewed on YouTube thousands of times. Recently, he has been approached about appearing in a television commercial for athletic apparel. Has the student acquired a right of publicity in his identity? Could the student obtain federal trademark registration in the use of his name or likeness? If a video game developer wanted to create a virtual college football game using the student's image and those of his teammates, would the student be able to license his rights?

Analysis:

Due to news coverage of his athletic accomplishments, and through interviews in the media, the student appears to have gained the level of popular attention and recognition to claim a right of publicity in his identity as a college athlete. His right of publicity would extend to the use of his name and likeness, as well his distinctive touchdown dance, which he has popularized and which

³⁰² UNIV. OF S. CAL., *supra* note 128, § 2.1(b).

has become associated with him.³⁰³ It is also likely that his jersey number in the context of his football uniform would be protected as part of his identity as well.³⁰⁴ The student would need to authorize any uses of these indicia of his identity for commercial or advertising purposes.³⁰⁵

As for the student's potential trademark rights, the name or likeness of a celebrity can function as a trademark if it is used to identify the source of particular goods or services.³⁰⁶ For instance, if the student uses his name or likeness as a source indicator on a consistent basis to market a particular line of sports apparel or sporting goods, he can obtain registration of his name or likeness as a mark.³⁰⁷ It is even possible that he might be able to claim trademark rights in his touchdown dance, although registration of such a mark has not yet occurred.³⁰⁸

Normally, a celebrity who licensed the commercial use of his identity in a television advertisement or as an avatar in a video game for trademark purposes would be entitled to compensation.³⁰⁹ However, because of NCAA rules, this is impossible for the student. Because the NCAA prevents student athletes from profiting from their names and likeness, any compensation from

³⁰³ See *supra* note 104 and accompanying text.

³⁰⁴ See Vladimir P. Belo, Note, *The Shirts Off Their Backs: Colleges Getting Away with Violating the Right of Publicity*, 19 *HASTINGS COMM. & ENT. L.J.* 133, 139 (1996) (arguing that marketing a college jersey with the same number a star player wears for each game is a use of the player's identity and the right of publicity).

³⁰⁵ See *supra* note 103 and accompanying text.

³⁰⁶ See *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1364–65 (D.N.J. 1981).

³⁰⁷ He can obtain federal trademark registration for his name if he can establish that the public recognizes his name as a source identifier for certain products or services. See *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1288 (9th Cir. 1992). The use of the student athlete's image would have to be used consistently, so as to "create a consistent and distinct commercial impression as an indicator of a single source of origin or sponsorship." *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 922–23 (6th Cir. 2003) (citing *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 755 (6th Cir. 1998)).

³⁰⁸ See JOSHUA A. CRAWFORD, *TRADEMARK RIGHTS FOR SIGNATURE TOUCHDOWN DANCES* 10 (2014), http://www.vsb.org/docs/sections/intellect/Joshua_A_Crawford_-_Trademark_Rights_for_Signature_Touchdown_Dances.pdf [<https://perma.cc/6ZSU-JH28>].

³⁰⁹ See *supra* notes 100–02 and accompanying text.

the video game would actually go to the student's respective university as part of an assignment from all student athletes of their publicity and trademark rights during their time in college.³¹⁰ Along with receiving the compensation, the university would also be able to license a student's rights to others as part of the assignment.³¹¹ This would allow the student's university to give a video game developer a license to use a student's publicity rights without permission from the student.³¹²

Finally, one author has postulated that the mere filing of an intent-to-use trademark application with the USPTO does not violate NCAA rules, although the NCAA itself has not yet addressed the issue.³¹³ However, filing such an application with bona fide intent to use the mark when he is eligible to do so would allow the athlete to establish priority to use the mark until his or her college athletic career has ended and he can engage in commercial activities.³¹⁴

CONCLUSION

The rapid development and diffusion of technology and information has underscored the role of intellectual property rights and the importance of defining ownership in those rights, particularly in academic institutions where so much basic and applied research occurs. Although the law is well settled as to most ownership issues, the rights of faculty and students have not always been so clearly defined. At most universities, faculty intellectual property is the subject of an agreement or policy defining ownership rights. Absent a contractual agreement with the

³¹⁰ See *supra* notes 117–18 and accompanying text.

³¹¹ See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 990 F. Supp. 2d 996, 998 (N.D. Cal. 2013) (noting that NCAA bylaws allow universities to sell or license student-athletes' names, images, and likenesses to third parties).

³¹² The use of student athletes' likenesses for video games was the backdrop of the challenge to the NCAA rules in *Keller v. Electronic Arts*, No. C 09-1967 CW, 2010 WL 530108, at *1 (N.D. Cal. 2010); see also *supra* notes 107–11.

³¹³ See Roessler, *supra* note 117, at 954–55.

³¹⁴ See Christie Cho, *Protecting Johnny Football®: Trademark Registration for Collegiate Athletes*, 13 NW. J. TECH. & INTELL. PROP. 65, 76, 81 (2015).

university or external funding source, ownership over the copyright and patent rights in their work most often belongs to the faculty member.

Less certain and less contemplated are the rights of students as to the intellectual property they may invent or create. Most universities have yet to consider this issue, although some universities have adopted policies similar to those that govern faculty. It would be wise for all universities to adopt student intellectual property policies and to educate their students about them. In addition, student intellectual property policies should be disseminated to promote student awareness of their rights.³¹⁵ As this Article has illustrated, outcomes as to ownership under such policies will differ from outcomes according to law in some cases. For that reason and others, student ownership policies must be balanced. Any policy should be based on the presumption that students own their intellectual property rights, with university or third-party ownership considered the exception. When students create intellectual property in their role as students, however, they should be owners of those rights.

Conversely, when the student is a university employee, or is compensated or supported by external funding, this presumption might not apply to any resulting intellectual property. At the same time, such policies should acknowledge the university's investment of its resources and the costs it may bear. However, universities should more clearly define when use of its resources or facilities is considered "substantial," since this is most often the basis for the university to assert a claim of ownership.³¹⁶ Most importantly, the policy must protect student expectations as to their work and not discourage creativity, intellectual exploration, and active and experiential learning.

³¹⁵ For recommendations as to how student intellectual property policies can be disseminated, see Barrow et al., *supra* note 18, at 12–13.

³¹⁶ See *supra* notes 145–56 and accompanying text.