department, the legislative purpose would be thwarted. Accordingly, it is my opinion that the Medical Practice Board has both the authority and the duty to promulgate rules concerning public access to its records. Once the standards are promulgated, the Board may utilize the services of the Department of Licensing and Regulation in the implementation of them.

FRANK J. KELLEY,
Attorney General.

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COLLEGES AND UNIVERSITIES: Copyrights and patents.

COPYRIGHTS: Rights of institutions of higher education and faculty members.

PATENTS: Rights of institutions of higher education and faculty members.

Copyrights of lecture notes, textbooks and articles belong to a faculty member rather than the institution he or she serves, unless an agreement is entered into between the institution and the faculty member providing for a different arrangement.

Although a professor who makes an invention is entitled to its patent rights, his interests may be superseded by those of an employer by agreement. Employers are also entitled to shoprights in inventions of their employees where the invention is made during hours of employment with the employer's materials and appliances.

Opinion No. 5081 October 15, 1976.

Edwin L. Novak, O.D., Trustee
Charles Stewart Mott Community College
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You have requested my opinion regarding the respective rights of a college or university and its faculty to copyrights and patents for work product developed in conjunction with faculty assignments.

COPYRIGHTS

Prior to publication, the author of a work retains control over it.[1] If, however, a work is published with the author's consent, it enters the public domain and may be published by any person unless the author has complied with the provisions of the Copyright Act[2] and thereby retained for himself the exclusive right to republish the work for a limited period.[3]

An exception to the author's right to control prior to publication is the

[1] *Werckmeister* v *American Lithographic Co.*, 134 F2d 321, 324 (CA 2, 1904).
[2] 61 Stat 652 (1947), 17 USC 1 *et seq.*
[3] *Caliga* v *Inter Ocean Newspaper Co.*, 157 F2d 186, 188 (CA 7, 1907), *aff'g* 215 US 182 (1909).

"works for hire doctrine." This doctrine provides that the copyright of a work produced by an employee within the scope of his employment belongs to the employer;[4] thus, a crucial problem under this doctrine is finding parameters of the duties to be performed within the scope to employment for, if the employee produced the intellectual material while acting beyond these parameters, the copyright resulting from the fruits of his labor remain his.

There are few cases dealing with the respective rights of professors and the university to the work product of the professor.

In *Sherrill* v *Grieves*,[5] it was held that lecture notes of a professor remain his property and not the property of the institution employing him. This suit was filed by an instructor at Levenworth Military Academy who claimed a fellow instructor infringed on his copyrights to a book for training officers. The defendant claimed *inter alia* that the rights to the book published pursuant to the plaintiff's teaching duties belong to the government and not to him. In rejecting this contention the court used the analogy of case[6] in which the court reporters had a right to sell their notes even though they were being paid by the government.

Also, in *Public Affairs Associates* v *Rickover*,[7] the court noted:

> ". . . no one sells or mortgages all the products of his brain to his employer by the mere fact of employment. The officer or employee still remains a free agent. His intellectual products are his own, and do not automatically became the property of the Government. The circumstance that the ideas for the literary product may have been gained in whole or in part as a result or in the course of the performance of his official duties, does not affect the situation."

In *Williams* v *Weisser*, the court ruled that a professor's lecture notes were property of the professor, not the university.[8]

In support of its position, the court cited a memorandum of university policy and the fact that professors frequently move from campus to campus so that to require them to create a new set of notes would be an impractical burden. The memorandum read, in part:

> "The lecturer retains a property right to his words spoken before a limited audience. Any unauthorized duplication and distribution of these words, either verbatim or in the form of notes may therefore constitute an infringement of this right. It is emphasized that the common law copyright is the property of the lecturer rather than the University, and therefore any legal actions for the infringement of such right must be brought in the name of the aggrieved faculty member."

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[4] 1 *Nimmer on Copyright*, § 62.31, pp 240-241 (1976).

[5] Copyright Decisions, 1924-1935, p 675; 57 Wash LR 286.

[6] *Calaghan* v *Myers*, 128 US 617; 9 S Ct 177; 32 L Ed 547 (1888) interpreting *Wheaton* v *Peters*, 33 US 591 (8 Peters); 8 L Ed 1055 (1834).

[7] *Public Affairs Associates* v *Rickover*, 177 F Supp 601, 604 (D DC, 1959), rev'd on other grounds, 284 F2d 262 (DC Cir, 1960), vacated, 369 US 111 (1962).

[8] *Williams* v *Weisser*, 273 Cal App 726, 733; 78 Cal Rptr 542, 545 (1969).

Having dealt with the scope of the professor's duties in employment three questions remain to be resolved: (1) Who has the copyright on a work which is commissioned? (2) Does an employee have a duty to turn over the copyrights on work created outside the scope of employment but on university time or with university facilities? (3) What effect will employer supervision have upon the copyrights?

In the case of commissioned works the law is clear that the copyrights belong to the employer.[9] Turning to the problem of development on company time with company facilities the *Rickover* case[10] said:

> ". . . title to literary property cannot be made to depend on such minor considerations, as whether any part of the work was done during office hours, whether a Government secretary participated in getting the manuscript ready, or whether a Government mimeograph or multigraph machine was used in preparing copies. If any Government agency objects to such a course, the matter can be dealt with by regulations or other intramural action, but no such circumstances can deprive the officer or employee of title to property which otherwise belongs to him. . . ."

In *Donaldson Publishing Co.* v *Bregman, Vacco and Conn Inc.*,[11] the court dealt with the issue of supervision. The employer's right to supervise is a sina qua non without which an employment relationship would not exist. Without the employer-employee relationship, the work product could not fall within the works for hire doctrine. In the university setting, it is clear that most lecture notes, books and articles are produced at the professor's leisure without direct supervision.

PATENTS

With respect to inventions, Congress has allowed a Letter Patent to issue in exchange for full public disclosure of the invention. This document allows the owner a non-renewable right to exclude others from making, using or selling the patent invention within the United States for a period of years.[12] Sections 102(f) and 116 of the Patent Act[13] require that application for a patent be made by no less than and no more than all its joint investors.[14] The courts have had great difficulty determining who is an inventor.

> ". . . The exact parameters of what constitutes joint inventorship are difficult to define. It is one of the muddiest concepts in the muddy metaphysics of the patent law. On the one hand, it is reasonably clear that a person who has merely followed instructions of another in performing experiments is not a co-inventor of the object to which those

[9] *Yardley* v *Houghton Mifflin Co.*, 108 F2d 28 (CA 2, 1939).

[10] *Supra* at 604.

[11] *Donaldson Publishing Co.* v *Bregman, Vacco and Conn Inc.*, 375 F2d 639, 643 (1967).

[12] 35 USCA 173, p 709.

[13] *Id.*

[14] Rosenberg, *Patent Fundamentals*, p 158 (1975).

> experiments are directed. To claim inventorship is to claim at least some role in the final conception of that which is sought to be patented. Perhaps one need not be able to point to a specific component as one's sole idea, but one must be able to say that without his contribution to the final conception, it would have been less—less efficient, less simple, less economical, less something of benefit. . . ."[15]

This right granted to inventors is a property right exclusive to the inventors under the Patent Act.[16]

One exception to the general rule allowing the inventor to patent his invention is that his right may be superseded by that of his employer. If an express agreement exists between an employer and an employee regarding patent ownership, the courts will enforce it[17] although the plaintiff has the burden of proving the existence of the agreement.[18] It is also to be noted that an employee may not avoid the obligation to assign a patent to his employer by deferring his patent application until after his employment has ended.[19]

In the absence of an express contract, a court may determine the existence of an implied contract and may assign the patent rights of an employee's invention to the employer.[20]

In some situations, it may be noted, employers are entitled to "shoprights" in inventions of their employees. In *United States* v *Dubilier Condenser Corporation,*[21] the court stated:

> ". . . Recognition of the nature of the act of invention also defines the limits of the so-called shop right, which shortly stated, is that where a servant, during his hours of employment, working with his master's materials and appliances, conceives and perfects an invention for which he obtains a patent, he must accord his master a non-exclusive right to practice the invention. . . ."

A college or university may deal with patent and copyright problems by adoption of a resolution or bylaw of its governing board. An example of a resolution and a bylaw are those adopted by the Board of Governors of Wayne State University and the Board of Regents of the University of Michigan which are attached as an appendix.

FRANK J. KELLEY,
Attorney General.

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[15] *Mueller Brass Co.* v *Reading Industries, Inc.,* 352 F Supp 1357, 1372 (ED PA 1972).

[16] 35 USCA 261.

[17] *Goodyear Tire and Rubber* v *Miller,* 22 F2d 353, 355 (CA 9, 1927).

[18] *Standard Parts* v *Peck,* 264 US 52, 55; 44 S Ct 239; 68 L Ed 560 (1923). Also see *Gemco Engineering and Mfg* v *Henderson,* 82 Ohio App 324, 325; 77 NE2d 742, 743; moot on other grounds 151 Ohio St 95; 84 NE2d 596 (1949).

[19] *New Jersey Zinc Co.* v *Singmaster,* 71 F2d 277, 279 (CA 2, 1934).

[20] *Melin* v *United States,* 177 USPQ 580; Ct Claims (1973).

[21] *United States* v *Dubilier Condenser Corporation,* 289 US 178; 53 S Ct 554; 77 L Ed 1114 (1933).

WAYNE STATE UNIVERSITY
PREAMBLE

"The Board of Governors of Wayne State University recognizes that the purpose of University research is to seek new knowledge for the general benefit of the public and not to make inventions for profit. It is recognized, therefore, that only in relatively rare instances will patentable discoveries be made in the course of University research. In such cases, it is deemed to be generally in the best interests of Wayne State University and of the public that patents should be obtained and administered as hereinafter provided in order that such inventions may be usefully developed and the net proceeds be devoted to support of the University.

"The Board of Governors reserves the right, however, to determine by special action in any such case that it would not be in the best interests of the University or the public to obtain a patent for a particular invention and to publish such discovery without patenting it. Questions as to patentability and patenting shall not be allowed to delay prompt publication of the results of University reseach; and all concerned with research shall cooperate to the end that any patent application shall be timely made.

"I. *Inventions by Faculty, Staff or Other Persons in the Course of Their Employment*

"All patentable inventions made by persons employed by the University in the course of research programs or projects being carried on by the University, or by persons in the course of working on such programs and/or projects under contracts or agreements with the University, shall belong to the University. The inventor or inventors shall make application for patents thereon as directed by the University and shall assign such application or patents resulting therefrom to, or as directed by, the University. Any such inventions, made by University faculty and staff members or other persons in the course of their employment by or for the University or with the use of facilities owned by the University or made available to it for research purposes, shall be deemed to have been in the course of a research program or project of the state-operated institution of the University.

"II. *Inventions Outside Course of Employment*

"A discovery made by an individual wholly on his own time and without the use of University facilities shall belong to the individual, even though it falls within the field of competence relating to his University position. If there is a question as to the ownership of an invention or patent under these provisions, the matter shall be referred to a committee of five members of the University community, to be named by the President of the University. At least three of these members shall be members of the academic faculty of the University selected by the President from a list of names nominated by the University Council. The committee shall make a careful investigation of the circumstances under which the invention was made and shall transmit its findings and conclusions to the President for review. If the committee determines that the invention has been made without the use of University facilities and not in the course of the inventor's employment by or for the University, and the President concurs in such

determination, the University will assert no claim to the invention or to any patent obtained thereon.

"* * *

"VIII. *Copyright*

"Generally, the members of the University faculty and staff shall retain all rights to copyright in published works which they have authored as a part of their traditional scholarly pursuits. However, in cases where persons are employed or directed within the scope of their employment to produce specific works subject to copyright, the University shall have the right to publish such works without copyright, or to copyright in its own name. When this occurs, the copyright may be subject to contractual arrangements between the University and the personnel involved. In those cases where the author requests the use of University facilities and/or the participation of University personnel, arrangements should be made through the administrative staff in advance with respect to the assistance which may be appropriately given and the equity of the University in the finished work.

"* * *"

UNIVERSITY OF MICHIGAN PATENT POLICY

"A. *Authority*

"The University Bylaw relevant to patents (sec. 3.10) reads as follows:

" '*Ownership of Patents, Copyrights, and Other Property Rights Acquired in Research.* Unless otherwise specifically provided by action of the Board, patents issued in connection with University research conducted by members of the University staff and supported by funds administered by the University, and all royalties and profits derived therefrom, shall belong to the University unless the terms of the agreement with an outside sponsor providing such funds specify a different disposition.

" 'Copyrights secured in connection with the publication of the results of research financed by funds administered by the University and the royalties derived therefrom shall be owned as agreed in advance in each instance between the research investigator and the Vice-President for Research.

" 'Patents from inventions, and copyrights resulting from authorship, by a member of the University staff independent of use of University funds, or University property or other University connection through contract, sponsorship, or financing, shall belong solely to the inventor or author without any limitation which may otherwise arise merely by virtue of employment by the University.'

"B. *Responsibility*

"The implementation of this Bylaw has been delegated to the Vice-President for Research. Assisting him is a three-member Committee on Patents selected by him from nominations made by the Senate Committee on University Affairs. A term of office will run three years; two consecutive terms will be the maximum. To assure continuity of effort, the expiration dates of membership will vary. The Vice-President for Research will

also select a Patent Officer to handle the administrative duties and to effect University-wide coordination.

"C. *Rights in Inventions*

"The University is concerned only with those patentable ideas that are a direct result of the use of University laboratories and other facilities or equipment and the use of University funds or funds administered by the University. These funds include general funds, special funds, grants, and contracts. Employment alone does not carry any special patent rights. It must be recognized that certain federal agencies retain all patent rights; this could also be true, if so specified, in industrial contracts. If both the sponsor and the University decline to file a patent application, the inventor may petition for reversionary rights. If approved, the inventor will pay 15% of any future royalties to the University.

"D. *Royalties*

"The inventor always shares in the royalties. The share will vary according to the source of funds, if any, that supported the activities that led to the invention and will depend also on whether a patent management firm is brought in for development and marketing. Royalties are distributed as follows:

"1. If the University assumes the cost of patenting, the inventor receives 20% of the royalties after expenses.

"2. Patent management firms usually agree to pay 15% of the royalties to the inventor; the University and the management firm share equally in the royalties after expenses.

"3. If the research that resulted in the invention was funded by the Department of Health, Education and Welfare, the handling of the patent and the distribution of the royalties are prescribed in an institutional agreement between the Department and the University signed in 1970. The agreement specifies that the inventor is to receive the following percentages of the royalties:

"a. 50% of royalties of first $3,000;

"b. 25% of royalties from $3,000 to $13,000;

"c. 15% of royalties in excess of $13,000.

"4. The University's share of royalties is used in fostering research and graduate instruction."