

**Who Owns Academic Work? Battling for Control of Intellectual Property by Corynne McSherry, Cambridge, Massachusetts, and London, England: Harvard University Press, 2001, ISBN 0-674-01243-7 (Price \$16.95 paper), pp. 275**

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Journal of High Technology Law  
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## **Introduction**

Corynne McSherry is a practicing attorney at Bingham McCutchen, LLP in San Francisco who also holds a Ph.D. in Communications. *Who Owns Academic Work?* is a thought-provoking book that examines the interplay between intellectual property law and the university. Both of these institutions are shown to be “in crisis” in ways that are caused by and affect each other. The book does not answer the question posed by its title. Instead, McSherry’s purpose is to define the problem, by explaining the time-honored but evolving function that the university serves in our society: of fostering disinterested scholarship within the public domain and ultimately for the public good. She shows how that purpose, the university’s “reason for being,” is threatened by trends to propertize academic work, particularly through invocation of intellectual property law. These trends are part of a Second Academic Revolution that is ongoing and appears likely to fundamentally alter the nature of academic work and the principles of intellectual property law.

## **Background**

In order to appreciate the gravity of the “crises” that McSherry explores, some understanding of the history of the key institutions of intellectual property law and the university is necessary. Chapter 1 of McSherry’s book offers enough of this history to set the stage for the contemporary conflicts on which the book focuses. IP law has historically and does today serve to reward and facilitate the “creative spark” of human ingenuity. Copyright and patent

protections evolved as incentives for authors and inventors to make their work public, by assuring that they would enjoy the exclusive economic benefit of their work for a limited period of time. These intellectual property rights were extended to private individuals primarily for the public good. The pecuniary benefits guaranteed by IP rights thus encourage individual creators to put their work into the public domain where they can teach and be built upon by others, instead of keeping their discoveries secret for their own personal and more limited benefit. Thus, “[t]he essential task of IP law is to ensure that monopoly rights (the private) do not erode the space of freedom (the public).” (p. 30).

### **Analysis**

The modern university, like intellectual property law, developed to enhance the progress of society. Unlike IP law, however, the university did not act as a means of transfer from the private to the public realms. Instead, the university was considered the central institution of the public domain, and quite independent of private interests. This conception of the university dates at least to the seventeenth century, when the principle of reason as a basis for all higher learning gained prominence. Academics dedicated themselves to “basic research,” that was removed from the commercial world. “Basic research” was independent of the commercial world because it did not seek to offer direct, tangible benefits. Instead, the basic research performed in the university provided the fertile “soil of human intellect” from which learned professionals in the private sector could reap more immediately beneficial discoveries. (p. 144). The university was said then to be “usefully useless” to society generally. Remnants of this tradition remain in the contemporary research university, where it often is considered unseemly to pursue practical knowledge. Only through such isolation from the commercial world could

academics presume to objectively discover “truth” and retain credibility as the arbiters of quality scholarship.

McSherry demonstrates that for a time in the late nineteenth and early twentieth centuries, the American research university adapted from its European forbearers, and became a more direct vehicle for national progress. American academicians sought to advance more “applied” knowledge than their European counterparts. During World War II and then the Cold War, however, the American university returned to its European roots in basic research. The demands of what McSherry terms the “military-industrial-university complex” were the primary catalyst for this development. (p. 62). That complex needed a multitude of experts trained in basic research, who could objectively identify high quality research. This required that the academy provide the necessary expertise in order to receive both federal (often Department of Defense) funding and private investment. The government and industry both sought credible, objective verification of the promise of more practical-oriented endeavors before making commitments. As recognized verifiers, academics became arbiters of policy, indispensable to government and industry. (p. 63). The university, then, became inextricably linked to the public interest (represented by the state) and to the commercial world. Its central and defining role in relation to the other institutions, however, depended on its perceived autonomy from those very institutions. This paradox characterizes the “epistemic regime” of which the university was a part on the eve of the Second Academic Revolution.

To sustain its role in the “epistemic regime,” the university embraced its own “economy” which rewarded success with stature. This economy was essentially non-monetary, as its participants sought to transfer the discoveries inspired by their basic research into the public domain. The act of publicizing one’s advances was a “gift,” for which the reward consisted

solely of enhanced reputation. The ideal of a gift economy is compromised, however, by betrayals of the gift ethos from within the academy, and attempts to appropriate and commodify the gift materials from without. The university's gift economy is ill-equipped to remedy these breaches, so victims have turned to the legal system for relief. The difficulty occasioned by these efforts is that the legal system deals almost exclusively in "property" which virtually by definition means financial value. The collision of the academy and the legal system therefore thrusts together two economies which deal in fundamentally different currencies. It appears impossible to reconcile this contrast without altering the nature of one or both of the constituent institutions.

In Chapter 2, McSherry exposes the difficulties posed by the attempted propertization of academic work in the context of authorship of research articles. To illustrate the problem, McSherry uses a controversy that developed over authorship of a medical "syllabus" in the late 1980's. Heidi Weissman, a young research doctor at the Albert Einstein College of Medicine performed research with her mentor Leonard Freeman on the use of a radionuclide, iminodiacetic acid to diagnose liver and biliary disorders. The two then jointly developed a syllabus, essentially a working paper, summarizing their research for use with a class they were co-teaching at Harvard Medical School. Weissman and Freeman later revised the syllabus separately over a period of time, before Weissman published her own revised version under her own name only. Two years later, Freeman reproduced Weissman's revised version for use in a class he was teaching, putting it forth under his own name. Weissman then sued him for infringement of copyright, asserting that she had changed the work enough from the original that it constituted a new "derivative work" of which she was the sole author.

As McSherry explains, the fact that a researcher would be feel aggrieved by another using her article without giving her credit is natural to the “gift” community of academia. Such an appropriation violates the “honor system” within a university, and deprives the legitimate author of the enhanced stature she would expect to receive as the only return for her invested labor. McSherry depicts the often unspoken struggle that goes on among joint contributors to a particular article, which culminates in the “order of authorship” listed on an article. The order of authorship signifies to the world the relative credit that the respective authors deserve for their contributions. Senior researchers commonly receive authorship credit in works that they only passively participate in, but this is accepted within the academic community as an appropriate sort of homage for their senior position. The benefit that this kind of “authorship” bestows upon a senior researcher is justified by the “gifts” of tutelage and guidance they have given to their junior researchers who do most of the actual research and writing. This situation does not typically violate the “gift economy” of the university, as long as the higher-ups who determine order of authorship assure that the credit reflects legitimate contributions in a fair way.

When “authorship” is presented to the world unfairly, however, the “gift economy” is threatened. The *Weissman* case represents an extreme example of this kind of unfairness, as Weissman claimed that she was completely deprived of the credit for her work, by the unjustified appropriation of that credit by Freeman. Weissman’s remedies within the “gift economy” were unsatisfactory. Wrongful appropriation of another’s research article may constitute plagiarism – a charge that may taint the accused party with a “bad reputation.” There is no commensurate remedy for the victimized party, however, and victims of plagiarism are often reluctant to speak out for fear of being branded a trouble maker. Seeing no adequate remedy within the academic

world for the loss of stature she suffered at the hands of Freeman, Weissman therefore turned to the legal system, and specifically copyright law.

After filing suit, Weissman's first hurdle in her copyright suit was to establish that as an academic author she held a "property" right in her authorship of the article in question. Authorship is a recognized basis for pursuing legal copyright protection, but Weissman was coming from the academic world where authorship was viewed exclusively as a "gift" to the public that extinguished any private right in the work. Weissman thus had to cross the "boundary" from the academic world to the realm of intellectual property law. (p. 72). The "fair use doctrine," a traditional defense to a copyright infringement claim, further complicated Weissman's case. Generally, others are permitted to use another copyrightable work for certain permitted "fair uses," among which education is a classic example. Here, Freeman had used Weissman's work exclusively for education. Weissman contended, however, that by using her work in an educational setting, within academia, Freeman had gathered enhanced stature which he did not earn and which was rightfully hers. To deprive the rightful author of stature, the only "value" associated with academic work, could hardly be considered "fair." Weissman was thus asking the courts, the domain of "property," to vindicate her lost interest in the "value" of the "gift" she had given within the academic domain. Weissman technically won her suit after appeal to the Second Circuit Court of Appeals, but the resolution of the case demonstrates the present incompatibility of the academic and intellectual property worlds. *Weissman v. Freeman*, 868 F.2d 1313 (2nd Cir. 1989). Weissman was not awarded monetary damages because she could not value her loss. Almost by definition, Weissman could not place a dollar value on her authorship, because she intended the act of authorship as a "gift" to the public domain. The Court paradoxically recognized that Weissman had lost something of "value" so as to meet the

legal definition of a copyright infringement, but was unwilling to assign a legal (monetary) value to that loss.

In Chapter 3, McSherry further examines the contradictory intersection of academic work and IP law within the “*sui generis*” category of university lectures. She demonstrates how university lectures developed as an exception to the “work for hire” doctrine. “The doctrine of work for hire establishes, in a nutshell, that copyrightable creative works produced by employees in the scope of their employment are the property of the employer.” (p. 107). Under this formulation, lectures would constitute the property of universities because they are given within the scope of a professor’s employment with the university. “Yet by policy and precedent ‘traditional scholarly works’ made by ‘independent academic effort’ are not considered works for hire, and the majority of professors own the knowledge they produce in the course of their employment as researchers and instructors.” (p. 107). This “academic exception” to the work for hire doctrine is premised on notions of academic freedom. The exception serves not so much to secure professor’s ownership rights in their work, as to ensure their control over the classroom. The professoriate’s “ownership” of lectures then is devised to enhance academic freedom, which in turn preserves the autonomy of the university from the outside world.

McSherry again uses a “property story” to explore the legal implications of the propertization of academic work. The first example is from the late nineteenth century, when a student at the University of Glasgow took careful notes from one of his classes, and then published them for future students’ use as a study guide. The professor sued for copyright infringement, presenting the courts directly with the question whether a professor “owns” his lecture, or whether instead a lecture constitutes a “gift” to the public. The House of Lords and Privy Council focused their analysis largely on the professor’s reputation: the notes bore his

name so any errors in their transcription would be imputed to him. Also, by lecturing the professor was not expressing himself in the public domain, but only to a limited audience. The students thus did not represent the public while in class, but were there as select members of the university. The lectures had therefore not entered the public domain via their limited “publication,” but remained the “property” of the professor, basically as a type of privacy interest in his ideas.

The issue resurfaced at UCLA in the late 1960’s with in a nearly identical factual scenario. A company hired students to audit classes and create outlines based on the professors’ presentations. The company would then publish the “Class Notes.” A professor objected to the practice and sued the publisher for copyright infringement. The case went to the California Court of Appeals, which held in favor of the professor. *Williams v. Weiser*, 273 Cal. App. 2d 726 (1969). The Court’s reasoning was essentially the same as the Scottish court over a hundred years earlier. The lecture was again treated as a sui generis “limited publication” that did not transfer the professor’s work into the public domain. The Court also reaffirmed the academic exception to the work for hire doctrine, because the lecture is tied so closely to the professor’s reputation, and is part of the “sphere of honor” of the classroom setting. As McSherry points out, the irony is that here, again, a court is using “gift economy” rhetoric to define a legal (“market economy”) property right. (p. 136).

In Chapter 4, McSherry addresses the host of issues related to IP law and the patenting of academic scientists’ inventions. Many of these issues are reminiscent of the contradictions that arise when academic authors seek copyright protection. For example, scientific researchers are not supposed to be concerned with the direct utility of their work, yet a demonstration of utility is a prerequisite obtaining patent protection. Similarly, recognizing property rights in an invention

requires identifying a particular inventor(s). The “inventorship” determination creates potential disputes between collaborating workers comparable to the issues that the “order of authorship” problem creates for academic writers. In both instances, the academy has a sort of code of honor that governs such determinations within the “gift economy.” Transferring the conflicts to the legal arena, however, both raises the stakes and alters the meanings of key concepts.

Finally, in Chapter 5, McSherry examines “the most dramatic and troubling border skirmish for both academia and the law: the propertization of scientific data.” (p. 190) This “skirmish” is the most dramatic because data is classically considered to be synonymous with facts, and facts are almost by definition the stuff of the public domain. The notion that facts are by their nature public, and incapable of being privately-held property, is demonstrated by *Feist Publications v. Rural Telephone Directory*, 499 U.S. 340 (1991), where the Supreme Court held that an alphabetical compilation of names, addresses and phone numbers in a telephone book was not copyrightable. A manufacturer of a telephone book may have invested tremendous labor in compiling the data, but the project lacks the creativity to qualify as an original work worthy of legal protection. The same principle has been applied in the context of scientific research, in *Miller v. University Studios*, 650 F.2d 1365, 1372 (5th Cir. 1981), the Court held that: “The valuable distinction in copyright law between fact and expression cannot be maintained if research is held to be copyrightable ... to hold that research is copyrightable is no more or no less than to hold that the facts discovered as a result of research are entitled to copyright protection.” (p. 204).

The law’s stubborn refusal to recognize “facts” as property is troublesome in light of sophisticated academic research. A researcher, in the performing “basic research” which is idealized in the academy as “usefully useless” might invest extensive labor in uncovering a “data

stream.” The problem is that the data existed in nature prior to, and independent of, being “discovered” by the researcher. No matter how dedicated the researcher, or how sophisticated her work, this natural data is difficult to distinguish in a legal sense from the facts that comprise a telephone book as in *Feist*. Another “property story” illustrates the problem.

Huguette Pelletier was a post-doctoral researcher who saw her research on crystallizing a protein as a potential ticket to fame as soon as she could publish. Before she could publish, however, a former lab partner who had entered the private sector published the work through her employer. Pelletier claimed that her former associate had “stolen” her work and brought an action for trademark infringement. Pelletier’s first obstacle was to establish a property interest in her unpublished research. To escape the “fact” classification, Pelletier claimed that her research constituted a work of scholarship, and was the product of her creativity. Within the intellectual property framework, however, a requisite characteristic of trademark material is that it have demonstrable utility and value to its owner. To argue that her work was useful and valuable, Pelletier had to forsake the principles of basic academic research. Pelletier was aided in her efforts, however, by the fact that the defendant company found the research commercially desirable. This belied its argument that the research did not meet the utility and value elements of a trademark claim. Pelletier was therefore able to establish that she held a trademark in her work. Her next obstacle recalls the failure in the *Weissman* copyright case to establish damages. Because Pelletier’s intent was to publish her research, that is, to “give” it to the public domain, her only injury was in the stature she lost as a result of someone publishing first. A jury found that this stature was valuable and rendered a verdict for \$200,000, but an appellate court reduced the award to \$1 because there was no objective measure of Pelletier’s damages. *Pelletier v. Agouron*, Cal Ct. App., 4th Dist., Div. 1 (Feb. 14, 1997). Once again, the intellectual property

regime recognized that a cognizable injury had occurred, but was unwilling to translate that injury from the academic world across the “boundary” to legal remedies.

McSherry interprets both the *Weissman* and the *Pelletier* cases as demonstrating that even when faced with technical proven intellectual property violations, the courts consider themselves an improper forum for the airing of academic disputes. Such are the difficulties that “owners” of academic work face when they seek to invoke IP law to vindicate their rights. So long as their rights originate in the autonomous, non-monetary world of academia, they are unable to remedy violations of those rights in any meaningful way. This is perhaps where the joint crisis of the academy and IP law is most clear. A right without a remedy is no right at all, and academics can hardly be expected to continue their integral work while left unprotected.

## **Conclusion**

*Who Owns Academic Work?* offers a comprehensive and insightful description of the societal implications of invoking intellectual property law to formulate and resolve disputes concerning the multitude of “interests” in academic work. The book is a valuable resource for any academic researcher who wishes to understand the opportunities that intellectual property may present to them, as well as the perhaps unwelcome way that IP law may encroach on their disciplines. Similarly, IP lawyers, whether or not working closely with academia, would be well-served to read the book for a new perspective on the most fundamental meanings of intellectual property. The potential audience for the book probably does not extend much further than this, however, given the complexity of the subject matter and the sophisticated style in which McSherry writes. To the intended audience, however, the book is thought-provoking because it leaves so much unresolved. “Who Owns Academic Work?” is not a question that McSherry seeks to answer, but is instead an amalgam of conflicting principles, with logical

conclusions that often contradict one another. For McSherry (or probably any other author) to purport to offer a solution to this labyrinth would clearly be over-reaching. The book neither advocates a particular course of action, nor predicts the way the crises in the academy and the law are likely to unfold. It does give its reader the tools to intelligently observe the ongoing “boundary skirmishes,” and (one hopes) act in a rational manner when drawn into the fray.