

Whose IP is it anyway?

This publication is aimed at UK further and higher education staff working in areas related to knowledge transfer, work based learning, community links, outreach, CPD, employer engagement, wider participation, and lifelong learning.

It is one of a series of publications produced by JISC Legal to raise awareness of the potential legal issues related to the use of technology by colleges and universities in relation to their business and community engagement activities.

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1. Introduction

This paper is intended to assist staff in UK further and higher education establishments who are involved in the use and creation of intellectual property as part of Business and Community Engagement (BCE) activities.

A vast amount of copyright material is created by staff and students in further and higher education institutions throughout the UK. The material may be academic in nature, such as teaching materials and articles, or may be produced in the course of BCE activities, such as consultancy and research reports.

But when a work is created in an institution, who owns the intellectual property rights? Is it the institution or the individual? This briefing paper will consider what the law says on this issue.

2. Staff

By virtue of s.11(2) of the Copyright, Designs and Patents Act 1988, the general rule is that work created by an employee *in the course of his or her employment* automatically belongs to the employer, if there is no agreement to the contrary.

Job Description

Whether something falls within the course of someone's employment will depend on that person's job description or specification. So, for instance, an academic's job description may only cover his or her teaching or lecturing duties. This means that activities outwith the job description (such as writing articles or other publications) may not be carried out in the course of employment, even if the work was produced during work hours using the institution's resources. As such, the academic (and not the institution) may own the rights.

The main areas of dispute to date have typically involved the ownership of teaching materials, articles and academic research - but BCE activities represent an additional and significant risk.

So it is important to know what the institution's job descriptions say as these will determine what the institution does (and does not) own and the areas of risk. Are they confined to academic duties or do they make provision for commercial activities which the institution may take part in? If commercial activities are not covered, then the institution could be losing out on the intellectual property rights which arise from those activities. Also, it could be exposing itself to risk in its dealings with the commercial customer. The project may, for instance, involve the institution transferring the rights in the research report or software to the customer with a warranty that it owns the rights being transferred. If the institution does not own the rights, the transfer will be ineffective and the institution will be in breach of this warranty.

Agreement

The parties may agree that, even though a particular activity does fall within an individual's job description, the institution will not own the rights in the work. There could be a specific written agreement to this effect (ie, a clause in the employment contract) or it could have been agreed orally.

An agreement about ownership however can also be implied, either by the parties' actions or from the institution's custom and practice. For example, there may be a general practice in the institution that academics are allowed to write and publish their articles privately. So, by implication, ownership of that material rests with the academic.

Implied Ownership

Implied ownership does create a degree of uncertainty. Take the situation where an employee conducts an academic research project and then enters into a private

agreement with a publisher to have the research findings and analysis published. Some months later, the institution recognises that there may be an opportunity to develop that research with a commercial partner and take it to market. Can it do so?

The institution could face difficulties here, particularly if it does have an established practice of allowing academics to retain ownership of such work. This may well be regarded as an implied agreement in which case the institution has no control over the work - the academic, as owner, can do what he or she likes with it. If the academic has assigned those rights to a third party, he or she may be precluded from using that work in the future or allowing anyone else (including the institution) to do so.

So, implied agreements about ownership could undermine the institution's ability to use the material in question for BCE activities. For this reason alone, there is benefit in setting out the ownership position in writing (ie in the person's employment contract, in the institution's IP Policy or even by way of letter) to remove the uncertainty of implied agreements.

There is also benefit in making sure that academic staff understand the implications of entering into an agreement with a third party such as a publisher. JISC Legal have prepared a brief guide to Exploiting Copyright which can be accessed online at - <http://www.jisclegal.ac.uk/bce/publications.html>.

3. Consultants

If the institution engages a third party to develop or create something on its behalf, such as a website, e-learning module or software, the third party will be the first owner of the copyright in that work, in the absence of an agreement otherwise. If the rights are not transferred to the institution or if an appropriate licence is not obtained, this could significantly restrict the institution's ability to use the work for its educational and commercial activities.

So, for instance, the institution may commission a third party to develop an e-learning module. If the rights are not transferred or a specific licence granted, the institution will only have very limited rights to use the module for that specific purpose. It could not be used for an entirely new purpose, such as the delivery of that module on a commercial basis (i.e. for professional training or work based learning).

In these circumstances, the third party should be required to transfer the copyright in the work to the institution. This means that the institution will become the owner of the rights and so can use the material as it sees fit. The transfer must be committed to writing, but there is no specific form which the document should take. It could be a formal agreement or a letter from the third party stating that it assigns all copyright in the material to the institution. The key requirement is that it is in writing and conveys the intention to transfer ownership.

As a fallback, if the third party is unwilling to transfer the rights to the institution, then a specific written licence should be obtained. The purposes for which the material

may be used should be as wide as possible to allow the institution maximum flexibility – it should consider current uses but also possible future uses.

4. Students

The general rule is that students will own copyright in the work which they create, subject to any agreement to the contrary. In terms of BCE activities, this issue may arise in relation to work based learning, student research done in collaboration with industry partners, and the use of student work, such as software code, as an input to BCE activity.

The scope of what constitutes an agreement is very wide – it could cover a student contract, IP policy or even statements which are made in a student handbook or prospectus. Accordingly, the institution should consider what provision is currently made (if any) in relation to student ownership and whether that position is acceptable to the institution.

Again, there is benefit in dealing with this issue in clear and unequivocal terms to avoid disputes at a later date, particularly if students may be involved in BCE activities. In connection with this issue, the JISC Legal publication “Investigation into Student Work and IPR” at <http://www.jisclegal.ac.uk/publications/studentipr.htm> may be of use.

5. Conclusion

The key issues are to:-

- Know who is carrying out the work; and
- Establish the capacity in which that person is acting.

If the person is an employee, that person’s job description will determine whether something is (or is not) within the course of his or her employment. If an activity is not covered, then provision should be made, either for that specific activity or a more general amendment to the person’s job description. The institution should also be aware of “carve outs” where the employee has reserved copyright ownership, either specifically in the employment contract (or other document) or by way of institution convention or practice.

More generally, a clear institution wide policy will also help to introduce certainty about the ownership of material which is produced in the course of BCE activities.

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