

Rights in Theses and Dissertations: Facts and Fallacies

Faculty advisors of graduate students often provide novel ideas for projects for the students' graduate research activities. In what is becoming a more common problem nationwide, students may treat those ideas as their own and attempt to commercialize them after they leave the university, without recognizing the intellectual contribution of their faculty advisors. As a result, both the faculty member and the university may lose the opportunity to reap the financial rewards that a commercially viable invention brings.

The matter is further complicated by some fundamental misunderstandings held by faculty concerning intellectual property law and the failure of faculty to protect their rights in inventions and discoveries because of those misunderstandings. For example, some faculty believe that if a student copyrights his/her thesis or dissertation the student then "owns" all of the data and ideas presented in his/her work. The faculty then fear that they may have lost their intellectual property rights to the student or that they must ask the student's permission to use their own ideas or data. Both of these assumptions are incorrect.

It may be helpful to approach discussion of this issue by first describing briefly the rights that are conferred by a copyright. A copyright protects an original expression of ideas and facts in a authored work. It arises immediately when that expression is fixed in some tangible form, without the need for registration or other formal proceedings, although formal registration does provide some procedural and substantive rights not otherwise available. It is not necessary to include a notice that a work is copyrighted by using of the symbol © or the word "copyright." The copyright holder has the power to control the right to reproduce the work, the right to prepare derivative works, the right to distribute copies, and the right to perform or display the work publicly.

The Copyright Act of 1976 specifically provides further, however, as follows:

In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

17 U.S.C. § 102(b). This section of the copyright law describes what is known as the idea/expression dichotomy. Under this rule, the particular way in which an author expresses an idea is protected by copyright law, which prohibits others from copying, distributing, etc. that particular expression without the permission of the author. The copyright law does not, however, give the author any rights in the underlying idea. Likewise, copyright law does not confer any rights in particular facts, simply because a "fact" cannot be the original work of an author. Only the particular expression of those facts is protected.

Applying this principle to the faculty/graduate student interaction mentioned above is an easy exercise. If a student's thesis or dissertation describes an idea conceived by the faculty advisor or simply data generated by an experiment, copyright law does not rob the faculty

member of his intellectual property rights in that idea nor does it place any limitations on the use by others of the data. The only effect of copyright law here is that the faculty member, just like any other non-author, cannot copy, distribute, etc. the thesis or dissertation, or significant portions of it, without the consent of the student.

Copyright law does not, therefore, confer upon the graduate student any rights to underlying ideas or data simply by virtue of the student's incorporating such ideas or data in his/her work. Patent law places an additional restriction on the ability of students to "pirate" a faculty member's intellectual property rights. A patent may not be issued if the patent applicant did not invent the subject matter sought to be patented, 35 U.S.C. § 102(f), and the failure of the applicant to properly name the inventors may invalidate a patent. As a result, a student who fails to appropriately name a faculty member as an inventor on a patent application runs the risk, at a minimum, of holding an invalid patent at the end of the long and expensive patent application process.

Although the copyright and patent laws provide protection to the faculty advisor, these statutes may require expensive and protracted litigation before those rights can be vindicated. In cases where there are serious concerns about protection of intellectual property rights, these matters may be better addressed prior to beginning the project or assignment rather than at the time a problem or dispute surfaces. One approach to this strategy is for the faculty advisor and the graduate student to acknowledge ownership of ideas or data in a written document. Other approaches may work equally well.

These other approaches and additional issues that arise from the faculty advisor/graduate student relationship will be the subject of a seminar co-sponsored by the Dean of Graduate Studies and the Office of Counsel on a yet-to-be-determined date in September. Faculty with an interest in these issues are encouraged to watch for information announcing the date of the seminar and to make plans to attend. In the meantime, feel free to contact the Office of Counsel to discuss any questions or concerns that may arise.