From: "Edelman, Benjamin"
To: "Kester, W." <wkester@hbs.edu>
Subject: RE: Edelman follow-up: case copyright policy & rationale, rights in software
Date: Wed, 24 Mar 2010 22:39:51 +0000
Importance: Normal

Carl,

Thanks. I look forward to the updates.

Do you have a sense of how long it will take to get a response on the software ownership question?

On the case copyright question: The 1947 faculty vote is intriguing. But it certainly sounds like there's a tension between the 1947 vote and the Harvard University Intellectual Property Policy, http://www.techtransfer.harvard.edu/resources/policies/IP/ (the document I gave you, excerpted in relevant part).

My initial thinking here:

* University policy ordinarily supersedes policies of the various faculties. All the more so here, where the university IP policy is the more recent of the two.

* The university's IP policy specifically limits how, and to what extent, the individual faculties may override the university's IP policy. See Section II.C., sentence two. Note the requirement that an individual faculty policy be "generally consistent with the principles stated in this policy." From what you've said so far, it seems the HBS 1947 vote is exactly contrary to the university's IP policy: The 1947 vote apparently provides that case copyright flows to HBS, whereas the university's IP policy says faculty authors retain their copyrights. If the 1947 vote is not consistent with the university's IP policy, then the university policy says the university policy governs.

* Provision II.B.2 of the university's IP policy provides further limits on how and when faculties may modify the university's IP policy. I'm not sure these conditions are satisfied either.

As to the theory that cases are a work for hire: I always thought this was a weak argument because the university IP policy is exactly on point, limiting the scope of copyright transfer to Harvard. Furthermore, the university IP policy exactly provides that faculty writing is only a work for hire if the university "commission[s]" such work (section II.B.4.). That provision seems to call for the university to specifically request a given document, which does not ordinarily occur with cases.

It may be possible to reconcile these documents in a way that supports the conclusion that the HBS 1947 vote governs or that the work for hire doctrine prevails. But I don't think that's obvious. Given the importance of this question to HBS, and HBP's aggressive positions on other copyright questions, I still think this matter would benefit from further examination. My instinct remains to seek a written memorandum that explores more carefully the apparent tension between the 1947 HBS faculty vote and the university IP policy.

Finally, I think the absence of an explicit and well-known copyright transfer agreement creates numerous additional problems. Can a faculty member copy two pages of a case into a scholarly article? (I've sometimes found that this would be helpful -- for example, for an industry overview.) Publish the same document through HBP and another publisher? (This too is not unprecedented. Some faculty apparently do this all the time.) After leaving HBS, must a case author pay license fees to HBP to obtain copies of his own cases when teaching them

elsewhere? Any copyright transfer agreement would address these questions. By instead relying on a 60-year-old vote, unknown to almost all current faculty, we're creating unnecessary confusion as well as (on one understanding of the rule) widespread small-scale rule-breaking. Seems like that's worth fixing. If all parties in fact share an understanding of what the rules should be, it won't be hard to put that understanding in writing. But in fact I think we'll find there's no such understanding, which makes an explicit agreement all the more important in setting things straight. As the Internet makes self-publishing that much easier and more attractive, I do think there's good cause to address these questions. Please let me know if I can help.

Ben

-----Original Message-----
From: Kester, W.
Sent: Thursday, March 11, 2010 5:36 PM
To: Edelman, Benjamin
Subject: Re: Edelman follow-up: case copyright policy & rationale, rights in software

Ben,

I'll do what I can on that first bulleted item. However, with respect to HBS/Harvard's view of copyright ownership of cases, I don't know that the "view" extends much beyond, "The HBS faculty voted to give case copyrights to HBS in 1947; ergo, HBS owns the copyrights and has ever since then." I'm not sure there is an actual memo on that point, in other words. If there is, I haven't seen it. I think the OGC also has this other theory about cases funded by the HBS being a so-called "work for hire." There may be a memo on that since it's more of an application of legal principles and court precedents, which are no doubt open to interpretation. I'll see what I can find out. And I'll also look into your software ownership issue, as agreed.

Thanks for coming by and talking. I always learn something. This time, there was the unexpected dividend for me of a new tax tip on top of everything else!

Best,

Carl

On 3/11/10 4:59 PM, "Edelman, Benjamin" <bedelman@hbs.edu> wrote:

> Carl,
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> Thanks again for your time today. Just to recap the follow-up we
> discussed --
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>
> On the case copyright question:
>
> * You'll forward me documents confirming the HBS/Harvard view of
> copyright ownership in cases faculty write, and the reasons for that

> view.
>
> * After the semester is over, probably this summer, we'll discuss
> further what more could be done to better distribute faculty research,
> to assure that official rules match our shared understandings, and
> otherwise to improve the areas I've identified. I'm happy to follow up
> directly with HBP folks, DRFD folks, others, or though you, as you
> prefer.
>
>
>
> On the software ownership question, you requested a recap of the key
> facts:
>
> I developed an idea for software that would collect data I'd find useful
> for multiple research projects. I identified a suitable developer and
> wish to pay that developer a modest fee ($1500-$2000) to implement
> software to my specification.
>
> The standard Research Staff Services contract provides that all rights
> in the software will flow from the developer to Harvard. From my
> perspective, that could be undesirable: I'd like to let others
> (including others outside of Harvard) use the software; I'd like to be
> able to continue to use the software if I should ever leave HBS; I'd
> like to feel confident in my ability to do these things without
> requesting permission or accepting a further delay.
>
> I believe one suitable approach is that both Harvard and I have a
> perpetual nonexclusive license to the developer's work. I'm open to
> other appropriate alternatives. I think a short email waiver,
> confirming my rights in the software I designed, could suffice.
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> Thanks,
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>
> Ben

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