

ACADEMIC FREEDOM AND THE COURTS

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Recent events in the United Kingdom have focused attention on the protection at law of academic freedom. Institutional academic freedom may be defined as the freedom of a university to determine its scholarly agenda and system of governance, notwithstanding dependence on external support. Individual academic freedom may be similarly defined as the freedom of individual university members to determine their own scholarly agenda, including how to pursue and present their research, notwithstanding dependence on institutional support. While such freedoms sit in tension, they share a basis in the liberal ideal of the pursuit of truth through teaching, discussion and scholarly research.

It is a truism that this ideal is currently under threat, and with it academic freedom itself. The source of the threat is complex and varied, but includes changes in the economy, scientific research, and British higher education policy. One result of these changes has been what W. R. Cornish described in the Herchel Smith Lecture for 1991 as “a rising determination to see how far the research conducted in institutions of higher learning can be turned to industrial account”, and a pressure on the British university in general to operate more as Technopolis than as Academe ([1992] E.I.P.R. 13 at 13, 14).

Courting the market can be a dangerous game, as intellectual property scholars understand. The reason is its utilitarian conception of value, which sits uneasily with the democratic and moral conceptions to which the aims of universities are most appropriately referred. This was demonstrated by the announcement of the Higher Education Funding Council of England in 2009 that funding for English universities would henceforth depend on the “impact” of their research. In the debate that followed the question arose, what protection can academic freedom expect from the courts? (A. Mroz, “Leader: Rise up, freedom fighters”, THE (11/02/2010)).

Some indication may be gleaned from an Australian case, *University of Western Australia v Gray* [2009] FCAFC 116. There, the University of Western Australia (UWA) claimed ownership of inventions and associated patent rights originating with its former Professor of Surgery, Dr Bruce Gray. At first instance ([2008] FCA 498), UWA argued that it was an implied term of Dr Gray’s employment that it owned any inventions he devised, and that university regulations asserting such ownership in any case applied.

French J rejected UWA’s claim. According to his Honour, in the absence of express agreement to the contrary, inventions devised by Dr Gray in the course of his employment were owned by him as their inventor under s.15(1)(a) of the *Patents Act 1990* (Cth). Further, this was not altered by common law principles governing the ownership of employee inventions, which did not apply. The reasons were that Dr Gray: (a) had no contractual duty to invent, but simply a contractual duty to research; (b) was free to publish his research, notwithstanding the impact of doing so on the patentability of inventions thereby disclosed; (c) was expected to solicit, and did solicit, external funds to support his research; and (d) was required by the nature of his research to enter collaborative arrangements with external scientific organisations ([1366]). In short, and as French J dryly noted, Dr Gray “was working for a university” ([1360]).

There remained the effect of UWA's regulations. According to the Judge, to the extent that these purported to appropriate academics' intellectual property, they were invalid. This was because s.16E of the *UWA Act 1911* (Cth), which conferred UWA's regulation-making power, was "not apposite to such a wide construction", particularly in light of the "well established presumption against construing legislation as interfering with vested proprietary interests" ([86]–[89]). Whether a university could ever be empowered by a parliamentary Act to acquire academics' intellectual property was a question his Honour refrained from deciding ([89]).

UWA appealed French J's decision to the Full Federal Court, focusing on the first of the arguments above. While accepting his Honour's analysis of the general law, it challenged his application of that law to the facts. In particular, it argued that he ought not to have distinguished UWA from other employers, nor to have construed Dr Gray's duty to research as insufficient to support its claim ([181]). Both arguments were unanimously rejected, however, as ignoring the distinctiveness of universities and academic employment, and the circumstances of Dr Gray's own employment ([182]). On the distinctiveness of universities, the Court said as follows ([184]):

...UWA has not been immune from the forces, financial and otherwise, that are forcing changes in the character of the university sector in Australia. ... UWA has engaged in commercial activities, as have done "most, if not all, universities". The evidence put on by UWA as to the range, character and significance of such activities of UWA was slight, though it hoped ... that we would take judicial notice of these matters... What is notable ... is that there is nothing ... to suggest that those commercial activities have displaced, either totally or if in part to what extent, UWA's traditional public function as an institution of higher education in favour of the pursuit of commercial purposes (if it lawfully could do so under its Act). Its function, in other words, was not limited to that of engaging academic staff for its own commercial purposes. Accordingly, we agree ... that on the evidence Dr Gray was not required to advance a commercial purpose of UWA when selecting the research he would undertake.

Thus, while universities increasingly operate in the market, they are not – if they could ever be – of the market, being rather of the purposes contained in their Act. Central to the purposes of many universities is the liberal ideal referred to above, an ideal at the heart of the *UWA* case ([186]):

A further distinctive feature of many ... universities ... is that ... academic staff are part of the membership that constitutes the corporation... To define the relationship of an academic staff member with a university simply in terms of a contract of employment is to ignore a distinctive dimension of that relationship. ... It probably is the case – though it is not a matter we need explore – that some of the practices revealed in the evidence in this matter (not repudiated by UWA), and the underlying values which seem to inform them, are more likely to be referable to understandings that have been traditionally associated with membership. The seeming freedom to choose the subject or line of research and the manner of its pursuit and the freedom to decide when and how to publish the products of one's research to the extent that these subsist, sit uneasily with employment notions such as the implied duty of an employee to obey all lawful and reasonable instructions of the employer within the scope of the employee's employment, or to maintain the secrecy of confidential information generated in the course of employment. Yet they are apparent manifestations of the contested value of "academic freedom"...

According to the Court, to recognize an implied contractual term of ownership in the context of such considerations would have a "quite significant collateral impact on the practices of academics such as Dr Gray" ([190]). Specifically, it would erode their freedom of research, as well as their freedom of exchange and collaboration, and restrict the mobility of their academic employment. Further, it would have implications for other areas of law, including copyright and the breach of confidence action. With respect to copyright, it would support a claim by universities to

ownership of the copyright in academic lectures and publications. With respect to the breach of confidence action, it would impose a duty of confidentiality on academics in respect of information that might prejudice the patentability of university-owned inventions.

In February 2010 the High Court of Australia, of which French J is now Chief Justice, refused an application by UWA for leave to appeal the Full Federal Court's decision. Given this, it seems an appropriate time to consider the applicability of that decision in the UK. The starting point for doing so is the principle expressed in *Higgs v R* [2008] EWCA Crim 1324, [28], that UK courts may rely on the reasoning of Australian decisions when the logic of those decisions makes them applicable. According to *Higgs*, this is so even when interpreting a UK statutory provision subject to EU regulation, and without identical counterpart in Australian law.

There are several reasons for believing the decision might be applicable. One is that it was based on the principles of English common law from which s. 39(1) of the *Patents Act 1977* was derived (see *LIFFE Administration & Management v Pinkava* [2007] EWCA Civ 217, [92]). According to s. 39(1)(a), an invention made by an employee in the course of carrying out his or her normal or specifically assigned duties, and in circumstances in which an invention might reasonably be expected to result from carrying out those duties, is owned by the inventor's employer (cf s.7).

Another reason the decision might be applicable is its consistency with post-1977 UK decisions, including *Greater Glasgow Health Board's Application* [1996] R.P.C. 207. In that case, Jacob J overturned a finding of the Hearing Officer that an invention devised by a junior registrar employed to treat patients, and expected to teach and engage in research, was made in the course of his "normal duties", which included a duty to research. According to Jacob J, even if it were so made, it would still have been owned by the registrar, for it could not reasonably have been expected to result. "[W]ere the position otherwise," he said, "considerable complications and difficulties" would arise (223):

Doctors frequently devise new and better treatments. Some of those will involve patentable inventions. Most doctors are employed. If, just because they are employed and because the invention could be used for the purpose of their employment, the invention belongs to the employer then many doctors would be placed in a very difficult position – "Can they publish what they have devised?", "Do they have to get their employer's permission to publish?" At present they do not. I do not see why they should in the future.

Thus, he concluded, just as justice and commonsense support employee academics' ownership of the copyright in their lectures (citing *Stephenson Jordan & Harrison v MacDonald & Evans* (1952) 69 R.P.C. 10, 19), so too they support employee doctors' ownership of their inventions (223). The reason, I suggest, is the effect the alternative finding would have in undermining the ethos constitutive of medicine *qua* profession, and of the university *qua* Academe.

Jacob J's reasoning plainly influenced the UWA Courts. In its concern with the impact of s. 39(1) on academic freedom, it is consistent with the norms which govern university arrangements in other European states (eg, C. Stallberg, "The legal status of academic employees' inventions in Britain and Germany and its consequences for R&D agreements" [2007] I.P.Q. 489). That such norms might influence the UK courts is consistent with the Europeanization of UK patent jurisprudence. Of relevance in this regard is the reason for the Act's omission of an equivalent to s. 52(1) of the *Patents Act 1949*, which protected the freedom of academics to publish their research without destroying the novelty of their inventions. According to Hansard, that reason was the perceived inappropriateness of encouraging delayed patent

applications given the philosophy of the Convention on the Grant of European Patents (1973) 13 I.L.M. 268 (see HL Deb, vol 379, col 1422 (15/02/1977)).

As a final point, there remains the doubt expressed by French J that a university could ever acquire the intellectual property of its academics by provision of its regulations. That a UK university could not is supported by ss. 3 & 6 of the *Human Rights Act 1998*, in conjunction with Article 1 of Protocol 1, which protects the peaceful enjoyment of a person's "possessions", including by implication from *Anheuser-Busch Inc v Portugal* [2007] E.T.M.R. 24, a person's "inventions" within the meaning of s.39(1) of the Act.

In conclusion, the considerations above, in combination with the similarity in the legal status and structure of British and Australian universities, and in the political and economic context in which they exist, ought to make the reasoning of *UWA v Gray* applicable in the UK. This is notwithstanding the uncertainty introduced by *LIFFE Administration* with respect to s.39(1), including the relationship between duties to research and invent (see [102]), and the relevance of employee duties of confidence (see [100]), and "academic and technical ability" itself (see [60], [78], cf [103]). Indeed, such uncertainty merely underlines the need for further consideration of this area, including in the context of university academics. It is submitted that in undertaking that consideration, the UK courts might find assistance in *UWA v Gray*.

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