

COMMENT

WRONGED BY A PROFESSOR?
BREACH OF FIDUCIARY DUTY AS A REMEDY
IN INTELLECTUAL PROPERTY
INFRINGEMENT CASES*

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I. INTRODUCTION

The relationship most students share with their teachers is undeniably special and unique. Old adages engrained from our youth remind us to respect teachers, and seek their advice and guidance. Time away from the academic environment does not erase memories of our teachers' influence and support. Although these fond memories typically begin in elementary or high school, college professors also have a dramatic influence over their students. The roles college professors play may be more significant because they extend guidance in shaping careers and provide direction to students uncertain of their futures. Graduate students especially encounter this unique relationship because the research and scholarship developed in these programs establish the foundation for their careers.

In some unfortunate cases, particular students will not experience the benefits of these relationships and their memories will be forever tainted. These regrettable cases have exposed professors who have abused their positions and selfishly replaced their student's interests with their own.¹ Students possess few remedies to counter this abuse; ironically, injured students cannot rely on the university for assistance because university research policies are structured to protect the university at the expense of students.² For example, many universities mandate that students assign patents for any inventions developed while

1. See, e.g., *Chou v. Univ. of Chicago*, 254 F.3d 1347, 1361 (Fed. Cir. 2001); see also *Johnson v. Schmitz*, 119 F. Supp. 2d 90, 91 (D. Conn. 2000); *Rainey v. Wayne State Univ.*, 26 F. Supp. 2d 963, 966 (E.D. Mich. 1998).

2. See, e.g., *Chou v. Univ. of Chicago*, 254 F.3d at 1356–57 (the university's patent policy provided, "[e]very patentable invention or discovery that results from research or other activities carried out at the University, or with the aid of its facilities or funds administered by it, shall be the property of the University . . ."); *Johnson*, 119 F. Supp. 2d at 92.

enrolled.³ Such assignment clauses render the students unable to prove damages caused by patent infringement.⁴ For published works, an assignment clause will reduce research students' chances to prove a copyright in the work if a professor misappropriates their ideas.⁵

This comment will examine the claim for breach of a fiduciary duty, a new remedy developing in United States courts to compensate students damaged by professors infringing upon their works. Traditional methods of recourse against the wrongdoer often fail, but a claim for breach of fiduciary duty offers some hope of relief.⁶ The development of this claim could provide a useful tool for students whose professors unfairly appropriated their work. Often, students are unable to prove other claims for infringement because of the university bylaws or their work's inherent qualities. However, a student may be able to prove the existence of a fiduciary relationship with his or her professor that is violated by the professor's use of the student's work.

The first section of this Comment examines the concept of fiduciary duty as well as the relationship between university professors and students. Next, this Comment provides a brief overview of intellectual property law and how it interacts with university policies to explain the failure of traditional claims to compensate students. The third section considers several cases in which students brought claims for breach of fiduciary duty. In this part, some of the more important factors leading to the use of this claim are discussed. Finally, the last section addresses

3. See Steven Z. Szczepanski, 2 Eckstrom's Licensing in Foreign and Domestic Operations app. 11D (David M. Epstein ed. 2000).

4. See *id.* (providing a provision from a sample university patent policy stating, "[s]tudents who are hired to perform specific tasks that contribute to a copyrightable work will ordinarily have no rights to ownership of that work, regardless of the source of funds from which they are paid").

5. See 17 U.S.C. § 412(1) (2000) (providing that a claimant may not recover statutory damages or attorney's fees for "any infringement of copyright in an unpublished work commenced before the effective date of its registration"); see also *Patrick v. Francis*, 887 F. Supp. 481, 486 (W.D.N.Y. 1995) (holding that a student researcher did not own a valid copyright and, thus, the student had not made a valid copyright infringement claim and was not protected by federal copyright law).

6. See *Chou*, 254 F.3d at 1362–63 (allowing a claim for breach of fiduciary duty against a professor); *Johnson*, 119 F. Supp. 2d at 97–98, 102, 105 (remanding the case to the trial court to determine whether a fiduciary duty existed between a graduate student and his dissertation advisor, but granting the motion to dismiss counts alleging CUTPA violations and defamation); see also *Rainey*, 26 F. Supp. 2d at 968 (requiring the plaintiff to establish the existence of a fiduciary relationship with her professor to prove a breach of a fiduciary duty).

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the probable impact of this new remedy on claims for patent and copyright infringement.

II. FIDUCIARY DUTY

Not every relationship between students and professors can be characterized as fiduciary in nature because the student must show the development of the closeness and trust inherent in a fiduciary relationship. Generally, this type of relationship “arises when there is an unequal relationship between the parties; the party reposing the confidence must be in a position of inequality, dependence, weakness, or lack of knowledge.”⁷ Students, as a group, depend on professors for guidance and advice and are less knowledgeable about the subject matter they are learning. The students discussed in the following cases displayed characteristics of dependence relative to their professors: (1) Joany Chou worked with Bernard Roizman as a graduate student and employee in his lab for thirteen years and, thus, he was a dominant force in her education and career;⁸ (2) Kris Johnson, a graduate student at Yale University, was encouraged to trust the faculty who later misappropriated his research theory;⁹ and (3) Jocelyn Rainey, a masters student in fine arts, was deceived by her professor concerning the ramifications of allowing an exhibit sponsor to use her work for an art exhibit.¹⁰

Because not all supervisory relationships give rise to a fiduciary relationship, courts have developed factors, which, when exhibited, indicate a fiduciary duty exists.¹¹ These factors “include: the degree of kinship between the parties; the disparity in age, health, mental condition, and education and business experience between the parties; and the extent to which the ‘servient’ party entrusted the handling of its business affairs to the ‘dominant party’ and placed trust and confidence in it.”¹² Furthermore, some courts have required additional elements to establish a fiduciary relationship.¹³ The students in the above-

7. 37 AM. JUR. 2D *Fraud and Deceit* § 32 (2001); see also *Snortland v. State*, 615 N.W.2d 574, 578–79 (N.D. 2000) (accepting this definition of fiduciary relationship).

8. *Chou*, 254 F.3d at 1353.

9. *Johnson*, 119 F. Supp. 2d at 91.

10. *Rainey*, 26 F. Supp. 2d at 965–66.

11. See 37 AM. JUR. 2D *Fraud and Deceit* § 32 (2001).

12. *Id.*

13. See, e.g., *Bancoklahoma Mortgage Corp. v. Capital Title Co.*, 194 F.3d 1089, 1106 (10th Cir. 1999) (stating that Missouri law requires the following elements:

(1) as between the parties, one must be subservient to the dominant mind and will of the other as a result of age, state of health, illiteracy,

mentioned cases played the part of the subservient party in a fiduciary relationship. They placed themselves and their educations in a role subservient to their supervising professors, entrusting those professors with their future careers.¹⁴ Moreover, they depended on the professors for guidance and were forced to share their ideas and work with the professors as a result of that dependent relationship.¹⁵

Universities and professors owe distinct duties to students. When the imposing party is an institution as a whole, it becomes difficult for the student to prove the existence of the characteristics of a fiduciary relationship. In fact, in most instances, to bring an action for breach of fiduciary duty against the university, it must be brought through a claim for respondeat superior.¹⁶ Some commentators have advocated the imposition of a fiduciary duty between universities and students for various reasons, many of which apply to university professors as well.¹⁷ One observer noted, “[a]ll of the elements of a fiduciary relation are present in the student-university relationship. It is no small trust—no small display of confidence to place oneself under the educational mentorship of a particular university. The value of an educational experience is directly affected by the school’s conscientious, faithful performance of its duties—duties which

mental disability, or ignorance; (2) things of value such as land, monies, a business, or other things of value which are the property of the subservient person must be possessed or managed by the dominant party; (3) there must be a surrender of independence by the subservient party to the dominant party; (4) there must be an automatic or habitual manipulation of the actions of the subservient party by the dominant party; and (5) there must be a showing that the subservient party places a trust and confidence in the dominant party).

14. See *Chou v. Univ. of Chicago*, No. 99 C 4495, 2000 WL 222638, *1 (N.D. Ill. Feb. 22, 2000); *Johnson*, 119 F. Supp. 2d at 91; *Rainey*, 26 F. Supp.2d at 968.

15. See *Chou v. Univ. of Chicago*, 254 F.3d 1347, 1361–63 (Fed. Cir. 2001); see also *Johnson*, 119 F. Supp. 2d at 91; *Rainey*, 26 F. Supp. 2d at 968.

16. See *Chou*, 254 F.3d at 1361 (holding that Chou adequately stated a claim against the University of Chicago under the doctrine of respondent superior for the professor’s “alleged concealment of his misappropriation of Chou’s inventions”).

17. See, e.g., Alvin L. Goldman, *The University and the Liberty of its Students—A Fiduciary Theory*, 54 KY. L.J. 643, 671–73 (1966) (reasoning that students have a large amount of confidence in their university, and the university is dominant over its students and their destinies); Paul G. Haskell, *The University as Trustee*, 17 GA. L. REV. 1, 32 (1982) (“The private university exists to serve the students particularly and the community generally, and it should be required to be more responsive to this obligation. . . . The relationship with its students is fiduciary in nature, and its duties to them should reflect this.”). But see Theodore C. Stamatakis, Note, *The Doctrine of In Loco Parentis, Tort Liability and the Student-College Relationship*, 65 IND. L.J. 471, 478–79 (1990) (discussing the impracticality of applying a pure fiduciary model to universities).

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are directed toward the student's benefit."¹⁸ This application of a fiduciary duty has only been considered in a few cases, under specialized circumstances.¹⁹ However, this may be as much a result of parties not claiming this duty in their suits for infringement as a reluctance by courts to impose it.²⁰

The present failure of courts to impose this duty should not deter students who believe they have a valid claim. Courts have become involved in similar disputes in other areas, including, for instance, universities' implied obligations of good faith and fair dealing.²¹ One commentator, Hazel Glenn Beh, expressed, "[g]ood faith and fair dealing can provide a framework to adjudicate student claims that is not unduly intrusive in that gray area where student claims are less specific but reasonable expectations seem clear."²² These claims encompass misrepresentation and fraud between students and the university.²³ Although students and universities do not usually arrange formal contracts with one another, each party has expectations of the other that generally include good faith and fair dealing.²⁴ Beh suggests courts can and should recognize these implied contracts by observing external evidence of each party's expectations and obligations and, consequently, imposing remedies for students who have been damaged by unfair acts of the university.²⁵

An extension of this reasoning can be made to cases involving a professor's breach of a fiduciary duty rather than the university institution. Because the university can be held to its

18. Goldman, *supra* note 17, at 671.

19. See *Chou*, 254 F.3d at 1362–63; see also *Johnson*, 119 F. Supp. 2d at 97–98; *Rainey*, 26 F. Supp. 2d at 968–69.

20. See Goldman, *supra* note 17, at 673 (implicating two primary reasons for judicial resistance: (1) lawyers' failure to pursue this approach, applying a fiduciary relationship, and (2) *laissez faire* jurisprudence).

21. See generally Hazel Glenn Beh, *Student Versus University: The University's Implied Obligations of Good Faith and Fair Dealing*, 59 MD. L. REV. 183 (2000). See also *Ross v. Creighton Univ.*, 957 F.2d 410, 416–17 (7th Cir. 1992) (holding that a court may enforce the duties imposed by a contract between university and student, but must be wary not to overstep its bounds by supervising the relationship between the two parties). *But see Andre v. Pace Univ.*, 655 N.Y.S.2d 777, 779 (App. Div. 1996) (holding, despite the existence of a contractual relationship, a claim for educational malpractice was not warranted; however, a claim might be warranted if a defendant provided "no educational services," or [if it] failed to meet its contractual obligation to provide certain specified services, such as a designated number of hours of instruction").

22. Beh, *supra* note 21, at 215.

23. See *id.* at 216.

24. See *id.* at 215–17.

25. See *id.* at 216–17 (opining that "[r]elying on objective, external standards addresses judicial concern that it should not substitute its own judgment for that of the institution, while still imposing a standard of conduct upon the institution").

representations, so should its professors, and a breach of those representations should be grounds for liability. Imposing obligations of good faith and fair dealing on the universities, “derived in part from the absence of improper motivations and in part from the educational community’s own standards of conduct, allows courts to protect the greater societal interests at the root of its traditional deference while acknowledging a need to protect students entering the marketplace of higher education.”²⁶ This rationale also applies to the imposition of a fiduciary duty on those university professors who develop close confidences with their graduate students. Regrettably, some students have been injured by the actions of their professors, and courts have an interest not only in remedying the immediate wrongs, but also in deterring similar injustices in the future.

III. AN OVERVIEW OF PATENT AND COPYRIGHT INFRINGEMENT

To decipher the courts’ rejection of these claims, an underlying foundation of the law of patents and copyrights is essential. These fundamental principles will also clarify the difficulties students confront in relying on these claims to protect works developed or completed under university supervision.

A. *Patents*

The federal Patent Act provides, “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”²⁷

1. Requirements for Issuance of a Patent

The purpose of patent law is to secure exclusive rights in inventors;²⁸ thus, it seems counterintuitive to vest those rights in persons who merely copy the inventions of others. The first requirement for patentability is that the invention must be

26. *Id.* at 217–18.

27. 35 U.S.C. § 101 (2000).

28. See Steven Cherkensky, *A Penny for Their Thoughts: Employee-Inventors, Preinvention Assignment Agreements, Property and Personhood*, 81 CAL. L. REV. 597, 635–36 (1993) (asserting utilitarian justifications for the patent system); see also Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 303 (1988) (asserting the economic justification of patent and copyright law is “the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare”) (quoting *Mazer v. Stein*, 347 U.S. 201, 219 (1954)).

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novel.²⁹ Section 102 of the Patent Act enumerates the various ways through which a lack of novelty will destroy patent rights.³⁰ As stated, if the invention is already known or used by others in this country, or is patented or described in a printed publication in any country, before the invention by the applicant, no right to a patent exists.³¹ Additionally, if any of the above actions were taken more than a year prior to the date of the patent application, there is no right to a patent.³² Other circumstances in which the novelty requirement would not be fulfilled include abandonment of the invention by the inventor, a patent application filed in a foreign country more than twelve months before the United States filing, or a published patent application or patent granted to another filed in the United States before the invention by the applicant.³³ Perhaps the most important component of the novelty requirement is that the person seeking the patent must be the actual inventor.³⁴ This component was important in two infringement disputes that centered on the actual development and creation of patented inventions: *Chou v. University of Chicago*³⁵ and *University of West Virginia v. VanVoorhies*.³⁶

The second requirement for patentability is non-obviousness.³⁷ Specifically, Section 103 of the Patent Act provides “[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art”³⁸ Thus, for example, changing the shape or texture of an object may not suffice to secure a patent if such change was obvious from prior art.³⁹ In general, courts rely

29. 35 U.S.C. § 102 (2000).

30. *See id.*

31. *See* § 102(a).

32. *See* § 102(b) (mandating that a person is not entitled to a patent if “the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . .”).

33. *See* § 102(c)–(e).

34. *See* § 102(f); *see also* Patent and Trademark Office, Manual of Patent Examining Procedure § 2137 (8th ed. 2001).

35. *See Chou v. Univ. of Chicago*, 254 F.3d 1347, 1360 (Fed. Cir. 2001).

36. *See Univ. of W. Va. v. VanVoorhies*, 278 F.3d 1288, 1292–93 (Fed. Cir. 2002).

37. 35 U.S.C. § 103 (2000).

38. § 103(a).

39. *See In re Spreter*, 661 F.2d 1220 (C.C.P.A. 1981) (finding a cigarette lighter design unpatentable in view of prior art references because a change in the surface pattern on a lighter was the sole design difference).

on various factors to ascertain the meaning of “obvious to an ordinary person skilled in the art.”⁴⁰ Among these are types of problems previously encountered, prior art solutions to those difficulties, changes in the field, and educational levels of workers in the field.⁴¹ Courts may also take into account the invention’s commercial success, whether there is an unfulfilled demand for the invention, and others’ reactions and efforts.⁴²

The third prerequisite for patentability is utility.⁴³ Courts can consider three forms of utility in assessing this requirement: (1) general utility (“whether an invention is operable or capable of any use”);⁴⁴ (2) specific utility (“whether the invention works to solve the problem it is designed to solve”);⁴⁵ and (3) beneficial utility (“whether the intended purpose of the invention has some minimum social benefit, or whether it is completely harmful or deleterious”).⁴⁶ Courts have focused mainly on specific utility in their patentability analyses and generally have required specific assertions of usefulness.⁴⁷

2. Patent Applications

Patents are obtained through a process of application and examination conducted by the Federal Patent and Trademark Office.⁴⁸ The Patent Act states that an application for a patent shall contain a specification,⁴⁹ a drawing,⁵⁰ and an oath by the applicant.⁵¹ After the application is made, an examiner from the

40. See, e.g., *Teton W. Constr. Inc. v. Two Rivers Constr. Inc.*, 961 F. Supp. 1422, 1426–27 (D. Idaho 1997) (listing six factors courts examine).

41. *Id.* (citing *Envtl. Designs v. Union Oil Co. of Cal.*, 713 F.2d 693 (Fed. Cir. 1983)).

42. See *id.* at 1427.

43. 35 U.S.C. § 101 (2000) (stating, “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore”).

44. *Messerschmidt v. United States*, 29 Fed. Cl. 1, 19 (1993) (quoting ROBERT PATRICK MERGES, *PATENT LAW AND POLICY* 147 (1992)).

45. *Id.*

46. *Id.*

47. See *Messerschmidt*, 29 Fed. Cl. at 19; see also *Newman v. Quigg*, 877 F.2d 1575, 1581 (Fed. Cir. 1989) (holding a device unpatentable because it did not produce what inventor claimed it did).

48. 35 U.S.C. § 131 (2000); see also § 3(a)(1) (defining “Director” as the head of the U.S. Patent and Trademark Office).

49. 35 U.S.C. § 112 (2000) (stating the specification must include “a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention”).

50. 35 U.S.C. § 113 (2000) (requiring the inventor to “furnish a drawing where necessary for the understanding of the subject matter sought to be patented”).

51. 35 U.S.C. § 115 (2000) (requiring that the applicant must state, under oath, “he

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Patent and Trademark Office determines whether the proposed invention should be issued a patent.⁵² If a patent is issued, the inventor-owner possesses the right to exclude others from making, selling or using the invention⁵³ during the term of the patent.⁵⁴ These rights are generally enforced through civil litigation.⁵⁵

B. *Copyrights*

Copyright law is a second area of intellectual property law applicable to the misappropriation of student research and other works.⁵⁶ Under federal law, copyright protection exists “in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”⁵⁷

A copyright is created automatically when a work is fixed in a tangible medium;⁵⁸ therefore, registration is not required,⁵⁹ but if the inventor desires to secure certain infringement remedies, it may be necessary.⁶⁰ In addition to the requirements of authorship and fixation in a tangible medium, copyrighted works must be original.⁶¹ In order to be considered original, “an

believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and . . . of what country he is a citizen”).

52. § 131.

53. See 35 U.S.C. § 271(a) (2000) (stating, “whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefore, infringes the patent”).

54. See 35 U.S.C. § 154(a)(2) (2000) (providing that, generally, the term of a patent commences on the date the patent issues and terminates twenty years from the date the application was filed).

55. See 35 U.S.C. § 281 (2000) (stating, “a patentee shall have remedy by civil action for infringement of his patent”).

56. See generally Roberta Rosenthal Kwall, *Moral Rights for University Employees and Students: Can Educational Institutions Do Better than the U.S. Copyright Law?*, 27 J.C. & U.L. 53 (2000) (discussing universities’ interests in protecting faculty and students’ copyright interests in their works).

57. 17 U.S.C. § 102(a) (2000) (establishing that works of authorship include “literary works; musical works; . . . dramatic works; . . . pantomimes and choreographic works; pictorial, graphic and sculptural works; motion pictures and other audiovisual works; sound recordings; and architectural works”).

58. § 102(a).

59. 35 U.S.C. § 408(a) (2000)

60. 35 U.S.C. § 412 (2000) (stating no award of statutory damages or attorney’s fees is available for unpublished works infringed prior to registration or for infringement after the first publication of the work and before the effective date of its registration).

61. See *Maurizio v. Goldsmith*, 84 F. Supp. 2d 455, 466–67 (S.D.N.Y. 2000); *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991); see also Steven S. Boyd,

author's work must (1) be independently created by the author and (2) possess at least a minimal degree of creativity."⁶² Generally, the duration of the copyright term equals the life of the author plus seventy years.⁶³

1. Rights of the Copyright Owner

The owner of a copyright has several exclusive rights: to reproduce the work; to prepare derivative works; to distribute copies or phonorecords through sale or rental; to perform the work; to display the work; and, in the case of sound recordings, to perform the work through an audio transmission.⁶⁴ These rights are subject to various limitations, the most prominent of which is the "fair use" doctrine.⁶⁵ This doctrine dictates the fair usage of copyrighted material that does not constitute infringement.⁶⁶ In order to determine the fair use of a copyrighted work, courts will examine "(1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the amount and substantiality . . . used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work."⁶⁷

2. Copyright Infringement

In order to prevail in a suit for infringement, a plaintiff must demonstrate: "(1) it owns a valid copyright in an original work; and (2) the defendants copied original constituent elements of the work."⁶⁸ An action for infringement will not succeed, however, if

Deriving Originality in Derivative Works: Considering the Quantum of Originality Needed to Attain Copyright Protection in a Derivative Work, 40 SANTA CLARA L. REV. 325, 326 (2000); Roger D. Blair & Thomas F. Cotter, *An Economic Analysis of Damages Rules in Intellectual Property Law*, 39 WM. & MARY L. REV. 1585, 1601-02 (1998).

62. Maurizio, 84 F. Supp. 2d at 457, 466-67 (describing the requirements for copyright protection in a dispute between the author of the novel *The First Wives Club* and another writer).

63. 17 U.S.C. § 302(a) (providing the relevant duration of copyrights created after January 1, 1978). For the applicable duration of copyrights in works created, but not published or copyrighted, before January 1, 1978, see 17 U.S.C. §§ 303-04(a). For a recent discussion of copyright terms, see *Eldred v. Ashcroft*, 123 S.Ct. 769 (U.S. 2003).

64. § 106; see also *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 432-33 & n.14 (1984).

65. See § 107; Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1135 (1990); see also *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 574-77 (1994) (discussing generally the purpose and application of the fair use doctrine).

66. § 107; see also *Campbell*, 510 U.S. at 569 (applying the fair use doctrine to the alleged infringement of a song).

67. § 107; *Campbell*, 510 U.S. at 569-71 (exploring the four statutory factors in the court's analysis).

68. *Earth Flag Ltd. v. Alamo Flag Co.*, 154 F. Supp. 2d 663, 667 (S.D.N.Y. 2001).

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the infringing material is similar only in trivial ways.⁶⁹ In *Earth Flag Ltd. v. Alamo Flag Co.*, the court contemplated whether a public domain photograph transferred onto a flag, thus creating “Earth Flag,” was sufficient to accord copyright protection to the flag, and, if so, whether Alamo’s similar flag infringed on that copyright.⁷⁰ Furthermore, while discussing the motion to award attorney’s fees in a later opinion, the district court held Earth Flag Ltd. did not prove infringement and Earth Flag’s original position that it held a copyright on the flag was objectively unreasonable because the flag “was not sufficiently original to warrant copyright protection.”⁷¹ This case exhibits the fact-intensive nature of copyright infringement suits; and, although the court determined Alamo’s flag was similar in nature to the one created by Earth Flag, it found that the similarities only involved non-copyrightable elements.⁷²

Several statutory remedies exist for infringement of a copyright, including injunction, seizure and destruction of the infringing articles, recovery of actual and statutory damages, and recovery of costs and reasonable attorney’s fees.⁷³

C. University Intellectual Property Policies

Most major universities have adopted written policies governing intellectual property developed on their campuses utilizing their resources.⁷⁴ A typical policy notifies students and faculty of the university’s interest in works created on campus or using its resources and identifies the rights and obligations of all parties.⁷⁵ For example, the University of Colorado has established a “Policy on Discoveries” that applies to “all faculty members, fellows, and staff employees (including students on

Plaintiffs can “prove the second element circumstantially by showing that: (1) the defendants had access to the copyrighted work; and (2) that the allegedly infringing material is ‘substantially similar’ to copyrightable elements of plaintiff’s work.” *Id.* (citing *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067, 1072 (2nd Cir. 1992)).

69. *Id.*

70. *See id.*

71. *Id.*

72. *Id.* at 668; *see also* *Tone Bros., Inc. v. Sysco Corp.*, 28 F.3d 1192, 1196 n.2 (Fed. Cir. 1994) (describing design patent infringement as a fact-intensive issue).

73. 17 U.S.C. §§ 502–505 (2000); *see also* *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 433–34 (1984); Alisa E. Anderson, *The Future of Software Copyright Protection: Arbitration v. Litigation*, 12 HASTINGS COMM. & ENT. L.J. 1, 6–7 (1989) (discussing remedies available to authors in copyright infringement case).

74. *See* Ashley Packard, *Copyright or Copy Wrong: An Analysis of University Claims to Faculty Work*, 7 COMM. L. & POL’Y 275, 294 (2002).

75. *See* SZCZEPANSKI, *supra* note 3, at 11-79 to 11-82 (reprinting the University of Colorado’s “Policy on Discoveries”).

appointment as University employees).⁷⁶ This policy states that all included persons “shall comply with this policy and hereby agree[] . . . [t]o assign to the Foundation, its designee, or a sponsoring agency if required under agreements governing research, any and all rights in and to discoveries in which the University has an interest”⁷⁷ A similar policy at Yale University states, “Yale will retain title to all such patent applications and resulting patents.”⁷⁸ Thus, once an invention is created, faculty members and students in an employment relationship with the university have no choice but to assign their patent rights to the university.⁷⁹ Although these policies do provide compensation to the inventors in the form of royalties,⁸⁰ the student or faculty member still cedes a portion of these profits to the university.⁸¹

Universities have developed similar policies for copyrighted material.⁸² These policies are traditionally more favorable to students and faculty members, but do have limitations.⁸³ For example, the May 1990 copyright policy of Cornell University explicitly stated, “[t]he University makes no claim to copyright ownership of works created by students working on their own . . . , and not making [s]ubstantial [u]se of University resources.”⁸⁴ The inclusion of this last phrase may raise a factual issue regarding whether a student utilized university resources.⁸⁵ Courts may consider whether university faculty supervised the student, where the student did most of the work, the resources relied upon, and other characteristics of the development of the material.⁸⁶ In this circumstance, a university would most likely

76. *Id.*

77. *Id.*

78. *Id.* at 11-89 to 11-93 (reprinting Yale University’s “Patent Policy,” effective September 1989).

79. *See id.* at 11-79 to 11-93.

80. *See id.*

81. *See id.*

82. Packard, *supra* note 74, at 276.

83. For further analysis of university copyright policies, consult Packard, *supra* note 74.

84. SZCZEPANSKI, *supra* note 3, at 11-95 to 11-101 (reprinting Cornell University’s copyright policy).

85. See Laura G. Lape, Ownership of Copyrightable Works of University Professors: The Interplay Between the Copyright Act and University Copyright Policies, 37 VILL. L. REV. 223, 256-57 (1992) (noting that “many policies contain internal inconsistencies, undefined terms, and unnecessarily vague language,” and, in using a “significant or substantial use” standard, “the process of defining [this standard] will be one of uncertainty for both parties, possibly resulting in conflict and litigation”).

86. See Pat K. Chew, *Faculty-Generated Inventions: Who Owns the Golden Egg?*, 1992 WIS. L. REV. 259, 277 (1992) (attempting to define the university “significant use” standard, and pointing out the term “presumably includes work time, facilities, personnel,

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attempt to prove that faculty commitment and advice on the project, as well as the student's use of the university's library or computing materials, constituted "substantial use of University resources." Alternatively, the student could argue that the use of university resources was not substantial because all students are supervised in their work and are encouraged to use the library and other resources, making the entire policy inapplicable.⁸⁷

Another significant aspect of university copyright policies is deference to more stringent patent policies.⁸⁸ For instance, Yale University's 1984 copyright policy stated, "[w]here a copyrighted work, such as certain computer software, is also patentable, the University Patent Policy will apply to it, notwithstanding any inconsistent provisions of this policy."⁸⁹ The Yale Patent Policy is stricter than its copyright counterpart, requiring assignment of all discoveries to the university.⁹⁰ Thus, although these copyright policies seem, at first glance, to be more generous to the student, their application may not impart any additional rights.⁹¹

Discussion of the application of university policies to students has been sparse, but there has been abundant analysis of these policies as applied to faculty members.⁹² One commentator suggests universities rely on several rationales for justifying their patent and copyright policies, which "include: (1) all universities follow this policy, (2) this policy is consistent with business practice, (3) this policy is legally enforceable"⁹³

Although that commentator successfully refuted these justifications as applied to faculty members, the same arguments

equipment, and funds," with the exception of the faculty's offices and libraries).

87. See Lape, *supra* note 85, at 257–58 (noting that some universities have limited the scope of the "significant use" standard by excluding certain areas and funds, while others have based the standard in terms of "fixed dollar amounts").

88. See SZCZEPANSKI, *supra* note 3, at 11-95 to 11-104 (reprinting the copyright policies from both Cornell University and Yale University, both of which apply their patent policies in situations where the materials at issue are both patentable and copyrightable).

89. See *id.*

90. See *id.* at 11-89 to 11-93 (reprinting Yale University's Patent Policy, which specifies that the University expects "included persons" to assign to it all their rights in and to any discoveries in which the university has an interest).

91. Compare SZCZEPANSKI, *supra* note 3, at app. 11D, with *id.*, at app. 11E (illustrating that, although a university's copyright policies may appear to be more favorable to the creator than the corresponding patent policies, the creator must be wary of making any assumptions).

92. See Chew, *supra* note 86, at 273–311 (analyzing various university policies regarding faculty-generated inventions, identifying policy arguments for and proffered rationales against faculty ownership of these inventions, and concluding faculty ownership "enhances professional productivity").

93. *Id.* at 281.

pertain to student-inventors.⁹⁴ First, the “industry practice” rationale is unsupported. Neither faculty nor students who are “likely to innovate commercializable products or [are] inclined toward entrepreneurial activities . . .” will lean toward being employed with a university that has a policy requiring university ownership of inventions or other original works.⁹⁵ These individuals will have more attractive options, such as opportunities for employment in private industry, where they will be better able to preserve ownership of their inventions.⁹⁶

Second, the rationale that university ownership of inventions is an acceptable business practice also cannot realistically be applied to student-inventors. A university-student relationship is inherently different from an employer-employee relationship.⁹⁷ Unlike traditional business employees, students working for the university are provided a considerable amount of flexibility in their work.⁹⁸ Further, universities possess characteristics distinct from typical business employers.⁹⁹ Specifically, while the goal of businesses is to achieve a profit, “universities’ articulated mission is the generation and dissemination of knowledge for the welfare of the university community and society as a whole.”¹⁰⁰

Third, the proposition that these policies are legally enforceable is often insufficient.¹⁰¹ The assumption is incorrect because student-inventors often do not expressly assign their inventions to universities.¹⁰² The cases discussed below do not

94. See G. Kenneth Smith, *Faculty and Graduate Student Generated Inventions: Is University Ownership a Legal Certainty?*, 1 VA. J.L. & TECH. 4, ¶¶ 15–26 (1996), available at http://www.vjolt.net/vol1/issue/vol1_art4.html (providing a detailed analysis of various university policies regarding faculty and student generated inventions).

95. See Chew, *supra* note 86, at 284 (refuting the universities’ rationale with regard to faculty members).

96. See *id.* at 284–85 (arguing that “if the university has a policy of university ownership of faculty inventions, faculty members’ desires for ownership rights may be a prime motive [for] moving to another university or leaving academia entirely”).

97. See *Chou v. Univ. of Chicago*, 254 F.3d 1347, 1362 (Fed. Cir. 2001) (establishing that the existence of a fiduciary relationship, like the professor-student relationship, prohibits the dominant party with the duty from seeking a benefit for himself at the expense of the servient party); 27 AM. JUR. 2D *Employment Relationship* § 4 (1996) (stating an employer is one whose employees act for the employer’s benefit).

98. See Chew, *supra* note 86, at 286 (applying parallel reasoning to faculty members).

99. See *id.* at 285–86 (discussing the differing goals of business employers and universities).

100. *Id.*

101. See *id.* at 281 (stating that courts will not uphold the assignment of rights to the university when “misrepresentation[s], inequality of bargaining positions, or overly broad terms” are present).

102. See *id.* at 288–89 (noting, with regard to faculty members, an assignment of

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dispute this proffered rationale, but demonstrate students may employ alternative methods to enforce their rights against professors and universities.¹⁰³ Therefore, universities should not hastily assume their policies will act as complete shields to liability in cases of alleged infringement or misappropriation.

IV. CASELAW RECOGNIZING BREACH OF FIDUCIARY DUTY CLAIMS

A. *Chou v. University of Chicago*

This case stems from a dispute concerning three inventions for which Dr. Bernard Roizman (“Roizman”) was listed as sole or joint inventor, but for which Dr. Joany Chou (“Chou”) also claims to be a joint inventor.¹⁰⁴ From 1983 to 1996, Chou was a doctoral student and subsequently a post-doctoral research assistant at the University of Chicago’s Department of Molecular Genetics and Cell Biology.¹⁰⁵ Roizman acted as chairman of this department and as Chou’s advisor.¹⁰⁶

This dispute commenced in February of 1991, when Chou allegedly suggested to Roizman that her discoveries should be patented and he opposed the idea.¹⁰⁷ At the time the discussion occurred, however, Roizman had already filed a patent application for the inventions, listing himself as the sole inventor.¹⁰⁸ In 1996, Roizman asked Chou to resign, and told her if she did not resign, he would fire her.¹⁰⁹

1. Chou’s Claims

In 1999, Chou sued Roizman, the University of Chicago, and two other defendants for declaratory judgment and correction of inventorship, seeking to be named either sole or co-inventor on one of the patents and co-inventor on two others.¹¹⁰ Finally, she

rights will often not be enforceable as a matter of law because the faculty member did not expressly agree); *Chou*, 254 F.3d at 1356–57 (stating that a student still assigned her rights even though she never expressly assigned them to the university).

103. See *Chou v. Univ. of Chicago*, No. 99 C 4495, 2000 WL 222638 (N.D. Ill. Feb. 22, 2000); *Chou*, 254 F.3d 1347; *Johnson v. Schmitz*, 119 F. Supp. 2d 90 (D. Conn. 2000); *Rainey v. Wayne State Univ.*, 26 F. Supp. 2d 963 (E.D. Mich. 1998).

104. *Chou*, 254 F.3d at 1353.

105. *Id.* at 1353.

106. *Chou*, 2000 WL 222638, at *1 (describing their relationship as “friendly and consistent” during the fourteen years).

107. *Chou*, 254 F.3d at 1353.

108. *Id.* at 1353–54 (stating that Roizman subsequently assigned the patent application to the company that funded the research).

109. *Id.* at 1354.

110. *Id.*

asserted claims for “fraudulent concealment, breach of fiduciary duty, unjust enrichment, breach of express and implied contract, and academic theft and fraud.”¹¹¹

The trial court found Chou had no standing to sue for correction of ownership because, as an employee of the University during the relevant time period, she had no rights in the invention.¹¹² Because she had no standing to sue for correction of ownership, Chou was also unable to obtain a declaratory judgment as to her interests in the patents.¹¹³ The district court also found there was no merit to the claims of fraud, breach of fiduciary duty, or unjust enrichment.¹¹⁴ The court denied Roizman’s motion to dismiss on the issue of conversion, stating that Chou had a slim chance of prevailing on this claim.¹¹⁵ The court granted Roizman’s motion to dismiss the claims of breach of express contract and breach of implied contract.¹¹⁶

Dr. Chou appealed the granting of the motion to dismiss and sought reinstatement of her claims against the University.¹¹⁷ The Federal Circuit Court of Appeals held that while Chou was obligated to assign her inventions to the University under the University’s Patent Policy, she still had a right to sue for correction of ownership.¹¹⁸ The court surmised, “[a]n expectation

111. *Id.*

112. *Chou*, 2000 WL 222638, at *2 (discussing the applicable provision of the University of Chicago’s Patent Policy, which states that every patentable invention developed from research at the University or with University funds or facilities is the property of the University); 2 Donald S. Chisum, CHISUM ON PATENTS, § 2.04 (2002). For further discussion of the problems of assignment of student inventions, see G. Kenneth Smith, *supra*, note 94.

113. *Chou*, 2000 WL 222638, at *2.

114. *Id.* at *3 (rationalizing Roizman did not conceal anything from Chou and that there was a lack of authority to support “a fiduciary duty to inform about the status of patent applications”).

115. *Id.* The trial court held Chou had to show conversion of real property by Roizman because Illinois did not permit a claim for conversion of intangible property. *Id.* Furthermore, the court declared, in dicta, that if Roizman had simply reviewed Chou’s papers and then returned them to her, the claim for conversion would fail. *Id.* It seems that in disallowing claims for conversion of intangible property, Illinois has created a gap in their intellectual property protection. Roizman was Chou’s advisor and supervisor in the lab; therefore, he had a right to examine her papers. This lack of protection means students in comparable positions may have little recourse against professors who misappropriate their ideas but return the tangible pages on which the ideas were written.

116. *Id.* at *4.

117. *Chou v. Univ. of Chicago*, 254 F.3d 1347, 1353 (Fed. Cir. 2001). Chou also appealed the district court’s decision granting a motion to dismiss by Aviron Company, another defendant claiming rights in the patents at issue. *Id.* at 1353–54.

118. *Id.* at 1356–59 (finding standing to sue for correction of ownership).

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of ownership of a patent is not a prerequisite for a putative inventor to possess standing to sue to correct inventorship.”¹¹⁹ The court reinstated the claims against Roizman and the University for fraudulent concealment and breach of fiduciary duty and against Roizman for unjust enrichment.¹²⁰ It then affirmed the district court’s dismissal of the claims against Roizman for breach of express and implied contracts.¹²¹

2. Chou’s Breach of Fiduciary Duty Claim

The appellate court upheld Chou’s claim against Roizman for breach of fiduciary duty,¹²² recognizing that “a fiduciary relationship may . . . arise from the special circumstances of the parties’ relationship, such as when one party justifiably places trust in another so that the latter gains superiority and influence over the former.”¹²³ The rapport between Chou and Roizman suggests a fiduciary relationship between the two parties.¹²⁴ For thirteen years, Roizman was Chou’s supervisor in the laboratory as well as her educational advisor.¹²⁵ A long-term supervisory relationship such as this, especially during the initial development of a student’s career, should indicate a fiduciary duty on the part of the supervising professor.¹²⁶ Further, the court specifically found certain factors present in the relationship indicating Roizman’s fiduciary duty to Chou.¹²⁷ Specifically, the court determined that there was a disparity in the two parties’

119. *Id.* at 1358.

120. *Id.* at 1361–63. The court determined Chou had adequately pleaded all of the elements of a claim for fraudulent concealment. *Id.* at 1361–62 (stating that, in Illinois, a fraudulent concealment claim requires an individual to have “concealed a material fact when he was under a duty to disclose that fact to the [injured party]”). The court further stated if Chou was correct in her allegation that she was one of the inventors of the disputed patents, she should have received royalties from the invention. *Id.* at 1363. If Roizman wrongfully appropriated Chou’s position, he should not be allowed to benefit from that offense to Chou’s detriment. *Id.*

121. *See id.* at 1364–66. However, the court reinstated Chou’s claim against the University for breach of express contract. *Id.* at 1364.

122. *Id.* at 1362–63.

123. *Id.* at 1362.

124. *See id.* at 1362–63.

125. *Id.* at 1353, 1362.

126. Kyle Grimshaw, *Patents & Technology: A Victory for the Student Researcher: Chou v. University of Chicago*, DUKE L. & TECH. REV., Oct. 3, 2001, at 35, ¶ 7, available at <http://www.law.duke.edu/journals/dltr/articles/2001dltr0035.html>.

127. *Chou*, 257 F. 3d at 1362–63 (stating that the relevant factors “include the disparity in age, education, and business experience between the parties, and the extent to which the ‘servient’ party entrusted the handling of its affairs to the ‘dominant’ party and placed its trust and confidence in that party”).

experience and roles and that Roizman had the power to make decisions regarding the patenting of Chou's inventions.¹²⁸

Although the court ordered the district court to reinstate Chou's claim for breach of fiduciary duty,¹²⁹ there have been no further proceedings in the case. After the decision was entered, Chou's lawyer stated that the court's opinion "gives hope to researchers and assistants and students that their inventorship rights cannot be trampled upon."¹³⁰ He further stated that no monetary value had been assigned to the claim, and also that he hoped the lower court would hear the case in late 2001 or early 2002.¹³¹

B. Johnson v. Schmitz

Another case addressing professorial infringement was brought by Kris Johnson ("Johnson"), a doctoral student at the Yale University School of Forestry and Environmental Studies, who sought judicial relief for alleged misappropriation of his doctoral dissertation by members of his faculty advisory committee.¹³² Defendants David Skelly ("Skelly") and Oswald Schmitz ("Schmitz"), Yale faculty members, were Johnson's dissertation advisors.¹³³ Johnson developed an idea for his dissertation and recorded his notes in a private journal throughout the summer of 1995; he also worked for Schmitz during this time.¹³⁴ Johnson later discovered two students reading his private journal without his permission and overheard them discussing the notes with Schmitz.¹³⁵ When Schmitz later asked Johnson to explain his ideas, Johnson hesitated.¹³⁶ Schmitz explained to Johnson that "in order to complete his dissertation and pass his qualifying exam, he would have to trust the faculty."¹³⁷ After Johnson described his dissertation theory to Schmitz, Schmitz indicated he thought the idea was worth pursuing and recommended that Johnson try to obtain funding

128. *Id.*

129. *Id.* at 1366.

130. J. Linn Allen, *Ex-Student Can Sue U. of C., Judges Rule*, CHI. TRIB., July 7, 2001, at 1.13, 2001 WL 4091555 (quoting J. Linn Allen, Chou's attorney).

131. *Id.* As of the publication of this comment, there have been no further published judicial opinions in this case.

132. Johnson v. Schmitz, 119 F. Supp. 2d 90, 98 (D. Conn. 2000).

133. *Id.* at 91.

134. *Id.*

135. *Id.*

136. *Id.*

137. *Id.*

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for further research.¹³⁸ Although Johnson expressed concern about Schmitz's behavior and the possible misappropriation of his ideas to the other co-chair of his faculty advisory committee, Kristina Vogt, she assured him his concerns were unfounded.¹³⁹

In the fall semester of 1996, Johnson took the oral portion of the qualifying exam for his doctoral degree.¹⁴⁰ During the exam, Johnson was told "his 'thinking was flawed,' 'he could not see the big picture,' and his ideas were 'ridiculous and unoriginal.'"¹⁴¹ Despite these harsh criticisms, Schmitz and Skelly published Johnson's research theory without recognizing Johnson's contribution or development of the idea.¹⁴² Subsequently, Johnson was unable to obtain further funding for research on his theory and was forced to abandon the idea as a dissertation topic.¹⁴³

In January 1997, Johnson filed a formal letter with the Director of Doctoral Studies at Yale alleging academic fraud.¹⁴⁴ In September, after Johnson's university stipend was abruptly terminated,¹⁴⁵ he wrote to the Dean of the School, who assured him an inquiry committee would be formed.¹⁴⁶ After five months of deliberation, the committee determined the allegations of academic fraud were groundless.¹⁴⁷ Johnson appealed to the Provost of the University, who refused to reevaluate his claim or the decision of the inquiry committee.¹⁴⁸

1. Johnson's Claims

Johnson then brought this suit against Yale University and individual members of his faculty advisory committee.¹⁴⁹ The defendants moved to dismiss nine of Johnson's sixteen claims.¹⁵⁰

138. *Id.*

139. *See id.*

140. *Id.*

141. *Id.* at 92 (explaining that Johnson was criticized during the exam and discouraged from pursuing further research on his theory, despite the fact that two members of the committee were working on the same ideas in their own research).

142. *Id.*

143. *Id.*

144. *Id.* Surprisingly, Johnson did not receive a response from the Director regarding the complaints in this letter. *Id.*

145. *Id.* (noting that the stipend included funding for research and a monthly salary supplement).

146. *Id.*

147. *Id.*

148. *Id.*

149. *See id.* at 92.

150. *Id.* (noting that Johnson's claims included breach of express contract, breach of implied contract, breach of fiduciary duty, negligence, defamation, and a violation of the

The district court denied defendants' motion to dismiss the claims for breach of express contract, breach of implied contract, and negligence.¹⁵¹

2. Johnson's Claim for Breach of a Fiduciary Duty

The Johnson court also denied the defendants' motion to dismiss the claim for breach of fiduciary duty.¹⁵² It noted, "[a] fiduciary relationship is 'characterized by a unique degree of trust and confidence between the parties, one of whom has superior knowledge, skill or expertise and is under a duty to represent the interests of the other.'"¹⁵³ After reviewing the pertinent facts, the court concluded that Johnson's relationship with Schmitz and Skelly had the potential to place a fiduciary duty on the two faculty advisors, emphasizing the close relationship between the parties and that the advisors were entrusted with guiding Johnson in writing his dissertation.¹⁵⁴ Because this opinion solely addressed the defendants' motions to dismiss, it did not conclusively establish the existence of a fiduciary relationship, but did note that Johnson should be entitled to prove at trial whether such a relationship existed.¹⁵⁵

C. Rainey v. Wayne State University

Rainey v. Wayne State University is a third case discussing breach of fiduciary duty claim in an academic context.¹⁵⁶ Jocelyn Rainey ("Rainey"), a graduate student at Wayne State University, expressed interest in displaying her art at an exhibit that was to take place at the 1997 North American Auto Show.¹⁵⁷ Rainey helped coordinate the exhibit, assisted in planning the show, suggested a theme, and allowed one of her art pieces to be photographed for the auto show brochure.¹⁵⁸ She produced several other works under the direction of her professor, Peter Williams, which were ostensibly used to establish the color scheme for the cargo containers.¹⁵⁹ In the advertising brochure

Connecticut Unfair Trade Practices Act).

151. *Id.* at 105.

152. *Id.* at 98 (opining that further factual development was needed).

153. *Id.* at 97 (quoting *Dunham v. Dunham*, 528 A.2d 1123 (Conn. 1987)).

154. *Id.* at 98.

155. *See id.* Because the court denied many of Johnson's other claims and discussed specific elements of a potential fiduciary relationship between the parties, one may infer that the court was somewhat convinced Johnson could meet his burden at trial.

156. *Rainey v. Wayne State Univ.*, 26 F. Supp. 2d 963 (E.D. Mich. 1998).

157. *Id.* at 965.

158. *Id.* at 965-66.

159. *Id.* at 966.

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promoting the exhibit, Mercedes-Benz of North America, Inc. (“Mercedes-Benz”) reprinted all of Rainey’s pieces, only one of which she had authorized.¹⁶⁰ Williams did not assist Rainey in terminating Mercedes-Benz’s unauthorized use of her work after she protested the inclusion of the three additional pieces in the brochure.¹⁶¹ Rainey brought suit against Professor Williams, Wayne State University, and the car manufacturers.¹⁶² Her complaint alleged copyright infringement, violation of the Lanham Act, intentional infliction of emotional distress, fraud, and unjust enrichment.¹⁶³ She also brought a claim for breach of fiduciary duty against Williams.¹⁶⁴ The defendants moved for summary judgment on the grounds that federal copyright law preempted Rainey’s state law claims and that her claim for profit damages was too speculative.¹⁶⁵ The district court granted the defendants’ motion in part, but denied the portion relating to the breach of fiduciary duty claim.¹⁶⁶

1. Rainey’s Breach of Fiduciary Duty Claim

The district court noted that reproduction of Rainey’s work without more did not give rise to a claim for breach of a fiduciary duty.¹⁶⁷ To succeed on this claim, Rainey would have to demonstrate a fiduciary relationship and that Williams breached his fiduciary duty to her.¹⁶⁸ The court further clarified these elements in its analysis: “[A] fiduciary relationship arises from the reposing of faith, confidence, and trust and the reliance of one upon the judgment and advice of another.”¹⁶⁹ The district court also indicated that to prove a violation of this duty, Rainey had to “show that the ‘position of influence has been acquired and abused,’ or the ‘confidence has been reposed and betrayed.’”¹⁷⁰ She essentially was granted another chance to prove these elements because the court held federal copyright law did not preempt this state law claim.¹⁷¹

160. *Id.* Rainey also alleged that she was not credited as the artist of the works and that one of her works was upside down in the brochure. *Id.*

161. *Id.*

162. *Id.*

163. *Id.*

164. *Id.*

165. *Id.* at 965.

166. *Id.* at 973.

167. *Id.* at 968.

168. *See id.*

169. *Id.* (quoting *Vicencio v. Ramirez*, 536 N.W.2d 280 (Mich. Ct. App. 1995)).

170. *Id.*

171. *See id.* at 973.

The *Rainey* decision is analogous to the *Johnson* and *Chou* decisions because the district courts, in both cases, declined to rule on the merits of the breach of fiduciary duty claim, but still afforded the respective plaintiffs another opportunity to prove their particular claims.¹⁷² *Rainey's* new evidence will likely focus on her close relationship with Williams and her allegations that he coaxed her into participating in the show exhibit. Williams' actions may also reveal a fiduciary duty, as he allegedly asked *Rainey* to produce the works that the car manufacturers subsequently misappropriated.¹⁷³ These factual circumstances point at least to the existence of the duty, if not to its violation.

D. *The Relationship Between Chou, Johnson, and Rainey*

These cases present similar legal and factual scenarios. In all three cases, an appellate court reversed a ruling in order to allow a graduate-level student who claimed harm as a result of wrongful misappropriation of work product to present evidence supporting those claims.¹⁷⁴ These three plaintiffs were students in graduate programs, which implies not only a higher level of educational achievement, but also a greater level of involvement with the faculty in the program. Many graduate programs encourage, if not require, close relationships with faculty supervisors.¹⁷⁵ In the *Chou* decision, the plaintiff had worked in Roizman's laboratory for thirteen years.¹⁷⁶ Undoubtedly, the two shared a close relationship. Likewise, the courts in *Johnson* and *Rainey* noted that the plaintiffs should be allowed to prove a fiduciary relationship existed between students and their professors, after describing the intense supervision and control the faculty members provided these particular students.¹⁷⁷

Graduate academic programs often lay the foundation for a student's career.¹⁷⁸ The student's reputation and career path are shaped by the faculty throughout the program.¹⁷⁹ Individualized

172. See *Johnson*, 119 F. Supp. 2d 90, 98 (D. Conn. 2000); *Rainey*, 26 F. Supp. 2d at 968–69, 973.

173. See *Rainey*, 26 F. Supp. 2d at 966.

174. See *Chou v. Univ. of Chicago*, 254 F.3d 1347, 1362–63 (Fed. Cir. 2001) (At the time of the suit, Chou had already received her degree, but her relationship with Roizman began as a result of her enrollment in the Ph. D. program.); *Johnson*, 119 F. Supp. 2d at 98; *Rainey*, 26 F. Supp. 2d at 968–69, 973.

175. See, e.g., STANFORD UNIVERSITY, GRADUATE STUDENT HANDBOOK 44 (2001), available at <http://www.stanford.edu/dept/DoR/GSH/Sec3F.html>.

176. *Chou*, 254 F.3d at 1353.

177. See *Johnson*, 119 F. Supp. 2d at 97–98; *Rainey*, 26 F. Supp. 2d at 968–69, 973.

178. Rachel Shea, *Does Grad School Make Sense for You?*, U.S. NEWS & WORLD REP., Apr. 15, 2002, <http://www.usnews.com/usnews/edu/grad/articles/brief/03escape.htm>.

179. *Id.*

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attention and dedication of faculty members is a noted aspect of most graduate schools.¹⁸⁰

However, such involved programs may actually hurt the student's intellectual and career development. For instance, the professor may feel the student is indebted to him for the time and attention he has invested in the student's career. It may also be difficult for some professors to work with students whose dedication and ideas surpass their own. This resentment was likely present in the aforementioned cases, when the student developed a unique idea or product with the potential to be patented, published or marketed, and the professor took advantage of the originality and success of the idea without giving due credit to the student.¹⁸¹

A second theme in these cases is the harm students experienced as a result of the professors' actions.¹⁸² While the students may not have suffered significant monetary damages, the actions of the professors were clearly injurious. Chou lost her position in the laboratory as well as the benefits of her invention.¹⁸³ She also would have been entitled to royalties from the invention had she been named as a sole or co-inventor.¹⁸⁴ Instead, she was required to sue Roizman and the University to protect her interests in the invention.¹⁸⁵ Johnson sustained damages when he was unable to complete his research topic, lost his scholarship funding, and potentially had to start another project to complete his degree requirements.¹⁸⁶ Rainey's works were used without her permission in a commercial endeavor.¹⁸⁷ Although the court determined the car manufacturer did not directly profit from her works,¹⁸⁸ Rainey was less able to

180. *Id.*

181. *See Chou*, 254 F.3d at 1353–54 (describing the dispute over the professor naming himself as sole inventor on patents relating to “herpes simplex virus and its use as an avirulent vaccine”); *Johnson*, 119 F. Supp. 2d at 92 (recounting the publication of the student's dissertation theory without proper attribution); *Rainey*, 26 F. Supp. 2d at 966 (alleging that the professor asked for the student's paintings without informing her they would be published).

182. *See Chou*, 254 F.3d at 1359 (recognizing the student's alleged loss of proceeds from licensing and invention as injury-in-fact); *Johnson*, 119 F. Supp. 2d at 92 (showing that the alleged misappropriation of the student's research theory resulted in loss of funding and inability to pursue further research); *Rainey*, 26 F. Supp. 2d at 970 (alleging reduction in value of paintings and damage to her reputation).

183. *Chou*, 254 F.3d at 1354, 1359.

184. *Id.* at 1363.

185. *Id.* at 1354.

186. *Johnson*, 119 F. Supp. 2d at 92. The case does not discuss what happened in the academic program as a result of the misappropriation and ensuing litigation.

187. *Rainey*, 26 F. Supp. 2d at 966.

188. *Id.* at 971 (noting that the defendants benefited indirectly by “enhanced

individually market those pieces that were displayed in the brochure.¹⁸⁹ In addition to the injuries directly related to their works, the students necessarily suffered a loss of trust in the institution and professors who were expected to guide them in their educational pursuits. While the courts may not have found legal damages compensable under the law, it is undeniable these three students were wronged by the actions of their professors.

A final similarity between these cases is that, while denying other claims, the courts allowed the student's claim relating to a breach of fiduciary duty.¹⁹⁰ These rulings afforded the students opportunities to prove the existence of fiduciary relationships and breaches of the duties emanating from those relationships.¹⁹¹ While there have been no further proceedings in any of these cases, the rulings exemplify the courts' willingness to allow the plaintiffs opportunities to prove this breach of trust and resulting damages.

V. CASES DISMISSING BREACH OF FIDUCIARY DUTY CLAIMS

A. University of West Virginia v. VanVoorhies

In 1997, the University of West Virginia brought suit against Kurt VanVoorhies ("VanVoorhies"), a former graduate student and research assistant professor at the University, for failure to assign rights in his patented invention to the University.¹⁹² While a graduate student at the University, VanVoorhies and Dr. James E. Smith ("Smith") worked together to invent a particular type of antenna.¹⁹³ Pursuant to the University's policy, VanVoorhies executed an invention disclosure form including a description of the antenna and a reference to Smith as a co-inventor.¹⁹⁴ After VanVoorhies and

goodwill").

189. For a general discussion of the valuation of art, see John G. Steinkamp, *Fair Market Value, Blockage, and the Valuation of Art*, 71 DENV. U. L. REV. 335 (1994).

190. See *Chou*, 254 F.3d at 1366; see also *Johnson*, 119 F. Supp. 2d at 105; *Rainey*, 26 F. Supp. 2d at 973.

191. See *Chou*, 254 F.3d at 1366 (directing the lower court to reinstate the claim); *Johnson*, 119 F. Supp. 2d at 98 (reasoning that Johnson may be able to demonstrate a factual basis to support his claim for breach of fiduciary duty); *Rainey*, 26 F. Supp. 2d at 969 (refusing to consider the professor's argument, improperly raised on appeal, that Rainey failed to present sufficient proof of a fiduciary relationship and allowing Rainey the opportunity to respond on remand).

192. Univ. of W. Va. v. VanVoorhies, 278 F.3d 1288, 1291–92 (Fed. Cir. 2002).

193. *Id.* at 1292.

194. *Id.* (discussing the university's policy, which stated that all inventions developed by university personnel or with substantial use of university resources became property of the university and inventors were to cooperate with the university in the patenting of

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Smith patented the invention, they assigned their rights to the University.¹⁹⁵ VanVoorhies subsequently invented another type of antenna.¹⁹⁶ He first suggested to the University that it patent the invention, but when counsel for the University sent him a patent application and assignment form, VanVoorhies did not respond.¹⁹⁷ The University then filed a patent application for this second invention.¹⁹⁸ Two months later, VanVoorhies filed a separate patent application for the same invention, in which he attempted to assign all interests in the invention to a company of which he was president and majority shareholder.¹⁹⁹

The University filed suit against VanVoorhies, alleging he had breached his obligation to assign his invention.²⁰⁰ VanVoorhies filed various counterclaims, including a claim for breach of fiduciary duty.²⁰¹ The district court granted the university's motion for summary judgment on all claims, with the exception of any contract claims that could be developed with further discovery.²⁰² VanVoorhies subsequently appealed the decision of the district court.²⁰³

With so many claims at issue and with such clear facts presented, the Federal Circuit Court of Appeals unfortunately did not devote a substantial portion of its opinion to analyzing VanVoorhies' claim for breach of fiduciary duty.²⁰⁴ The court noted, "[a] fiduciary duty arises when a person assumes a duty to act for another's benefit, while subordinating his own personal interest to that other person," but declined to rule on whether such a fiduciary relationship existed between VanVoorhies and Smith.²⁰⁵ However, the court did hold that even if such a

inventions and assignment of patents).

195. *Id.*

196. *Id.* at 1293. This invention was developed close to the time VanVoorhies was completing his doctoral degree requirements and may have been completed in the brief period during which he had received his degree but was not yet employed as a research professor at the University. VanVoorhies relied on this contention in his defense for failing to assign the patent, an argument the court ultimately rejected. *Id.* at 1298–99.

197. *Id.* at 1293.

198. *Id.* (stating that the United States Patent and Trademark Office awarded the patent as a continuation-in-part of the claims listed in the first patent applied for by Smith and VanVoorhies).

199. *Id.*

200. *Id.* at 1294.

201. *Id.* Other counterclaims included fraud, breach of contract, and violations of RICO, as well as a declaration of invalidity of the University's patent assignment. *Id.*

202. *Id.*

203. *Id.* at 1295.

204. *See id.* at 1299–300.

205. *Id.* at 1300 (citing *Elmore v. State Farm Mut. Auto Ins. Co.*, 504 S.E.2d 893, 898 (W. Va. 1998)).

relationship had been shown, “VanVoorhies did not present any evidence that Smith breached that trust.”²⁰⁶ Specifically, the court determined VanVoorhies was fully aware of and acquiesced in the decisions made regarding the first invention, that he and Smith jointly signed the patent application, and that he knew the proceeds would be divided with Smith under the University’s patent policy.²⁰⁷ Furthermore, because the claim against Smith was dismissed, the court also held VanVoorhies’ claim for breach of fiduciary duty against the university could not stand.²⁰⁸

1. Distinguishing *VanVoorhies* from *Chou*

The *VanVoorhies* court explicitly distinguished *Chou v. University of Chicago* in its opinion, noting that, contrary to the facts before it, Chou had proven a fiduciary relationship with her professor.²⁰⁹ In addition to engaging in patent infringement, Roizman engaged in other actions contrary to Chou’s interests, including forcing her to resign from the lab when she became aware of his actions.²¹⁰ In contrast, VanVoorhies did not allege any specific egregious actions by Smith.²¹¹ Thus, the court could not hold that there was a breach of fiduciary duty if the professor did not take direct and obvious steps against the student’s interests. Indeed, Smith was not even originally involved in the proceedings between the university and VanVoorhies, but was joined in the suit only because of VanVoorhies’ third party complaint.²¹²

Although not discussed in the *VanVoorhies* opinion, *Johnson v. Schmitz* is also distinguishable from that case. While Johnson successfully argued that his faculty advisor, Schmitz, deterred him from his research and did not otherwise adequately supervise his work,²¹³ VanVoorhies failed to present similarly convincing evidence.²¹⁴ Specifically, the court emphasized that VanVoorhies worked with Smith to patent the initial invention and he was aware he and Smith were co-inventors.²¹⁵ It is also significant that VanVoorhies was unable to demonstrate specific

206. *Id.*

207. *Id.*

208. *Id.* The claim was based solely on the theory of respondeat superior. *Id.*

209. *Id.*

210. *See Chou v. Univ. of Chicago*, 254 F.3d 1347, 1354 (Fed. Cir. 2001).

211. *See VanVoorhies*, 278 F.3d at 1299–301.

212. *See id.* at 1294.

213. *See Johnson v. Schmitz*, 119 F. Supp. 2d 90, 91–92 (D. Conn. 2000).

214. *See VanVoorhies*, 278 F.3d at 1299–301.

215. *Id.* at 1300.

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instances in which Smith's actions harmed him.²¹⁶ VanVoorhies' inability to prove damages may have influenced the court's decision to deny him relief. The court dismissed his claim for patent infringement because he developed the invention while working for the University and, thus, was obligated to assign the patent under the University's patent policy.²¹⁷ VanVoorhies was listed as the co-inventor on the first patent and was presumably receiving royalties from that invention.²¹⁸ It is true that VanVoorhies would most likely have received a greater share of profits by having complete ownership in the second invention. However, under the patent policy, he was still entitled to thirty percent of the net royalty income of the University's second patent application, which listed him as the sole inventor.²¹⁹

VanVoorhies also did not present evidence of retaliation by Smith or the university for his actions.²²⁰ The court's opinion did not discuss whether VanVoorhies remained at the University as a research professor or was terminated in the same manner as Chou. Because VanVoorhies certainly was not reluctant to bring counterclaims against the University, if he felt he had been wrongly terminated, he may have brought suit on these grounds as well.²²¹ Thus, one may safely assume a student must prove actual damages, caused by the actions of the professor and the university, in order to succeed on a claim for breach of fiduciary duty.

B. Patrick v. Francis

In *Patrick v. Francis*, Donna Patrick ("Patrick") sued her professor alleging copyright infringement and intentional infliction of emotional distress, but was unsuccessful in her claims.²²² In 1992, Patrick was a student at Alfred University, engaging in a research project under the supervision of defendant

216. See *id.* (concluding that VanVoorhies put forth no evidence that Smith breached his trust).

217. *Id.* at 1298–99.

218. See *id.* at 1292 (noting that the university's policy paid inventors thirty percent of the net royalty income after patent assignment).

219. See *id.* at 1292–93.

220. See *id.* at 1299–301.

221. The court noted that VanVoorhies "apparently proceed[ed] on the unsound assumption that the more issues raised, the better the chance for success." *Id.* at 1296. Of course, the absence of a claim is not completely conclusive, but rather only an indication of the ongoing relationship between the parties.

222. *Patrick v. Francis*, 887 F. Supp. 481, 482 (W.D.N.Y. 1995) (considering only the defendant's motion to dismiss and the plaintiff's motion to remand the case, and not the actual merits of the claims).

Dr. Amy Rummel (“Rummel”).²²³ Rummel directed Patrick to research together with defendant Julie Francis (“Francis”), another student at the university, on the project.²²⁴ In the spring of 1993, the two students concluded the research and submitted it to Rummel.²²⁵ In late 1994, Patrick discovered that the defendants had published the research in a medical journal.²²⁶ The publication did not list Patrick as an author or contributor, despite her allegations she was the chief author and contributing researcher.²²⁷

1. Patrick’s Claims

Patrick brought an action in state court against the authors listed in the publication, claiming unlawful conversion, unlawful competition, unjust enrichment, copyright violation, and intentional infliction of emotional distress.²²⁸ The defendants removed the case to federal district court and subsequently moved to dismiss the action for failing to state a claim upon which relief could be granted.²²⁹ Meanwhile, Patrick moved to have the case remanded back to state court.²³⁰ The district court first held it had proper jurisdiction over the action because the Federal Copyright Act preempted four of Patrick’s state law claims.²³¹ Second, the court considered whether Patrick had stated a claim for infringement under the Copyright Act or a claim for intentional infliction of emotional distress.²³² Unfortunately for Patrick, because her complaint admitted no federal copyright in the work, the court held that she failed to state a claim for copyright infringement.²³³ Because it had

223. *Id.*

224. *Id.*

225. *Id.*

226. *Id.* (explaining that the article was published in the spring 1994 edition of HOSPITAL TOPICS, naming Francis, Rummel, and several others as co-authors).

227. *Id.*

228. *Id.* (specifying that Patrick sought \$500,000 in damages for each cause of action).

229. *Id.* The dismissal was sought pursuant to Federal Rule of Civil Procedure 12(b)(6). *Id.*

230. *See id.*

231. *See id.* at 483–85 (explaining the federal statute, which “preempts a state cause of action if the subject matter of the state law rights falls within the subject matter of federal copyright law and the state law rights asserted are equivalent to the exclusive rights federal copyright law protects”). The court held the Copyright Act preempted Patrick’s claims for copyright infringement, unlawful conversion, unlawful competition, and unjust enrichment. *Id.* at 484.

232. *Id.* at 486.

233. *Id.*

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dismissed the federal claims, the court found it had no supplemental jurisdiction over the intentional infliction of emotional distress claim and dismissed it as well.²³⁴

2. Breach of Fiduciary Duty

Patrick did not allege the defendants breached a fiduciary duty owed to her, although such a claim probably would have failed under the standards discussed in *Chou*, *Johnson*, and *Rainey*. First, Patrick was an undergraduate student while she was working for Rummel.²³⁵ In contrast, Chou, Johnson, and Rainey were graduate students or employees of their respective universities, which implied a higher level of commitment and the increased importance of their work.²³⁶ Second, Patrick worked with Rummel for only ten months and with her fellow student Francis for five months.²³⁷ In contrast, the students in the other cases demonstrated perpetual, more personal relationships with the offending professors, more indicative of fiduciary relationships.²³⁸ Third, although Rummel supervised her, Patrick did not allege that Rummel deceived her about the future of the research or that she would be listed as an author or contributor.²³⁹ Finally, Patrick worked concurrently on the project with another student, lending more credence to the argument the work was not completely hers.²⁴⁰ Altogether, the circumstances in *Patrick* imply a supervisory relationship more akin to that of an employer-employee rather than a professor-

234. *Id.* (dismissing the intentional infliction of emotional distress claim for lack of jurisdiction and stating, “[i]f the federal claims are dismissed before trial, even though not insubstantial in a jurisdictional sense, the state claims should be dismissed as well”) (quoting *Purgess v. Sharrock*, 33 F.3d 134, 138 (2d Cir. 1994)). The court did not feel the unauthorized use and publication of Patrick’s research met the elements of this tort claim, noting that Patrick did not allege “the ‘extreme and outrageous conduct’ necessary to state a claim for intentional infliction of emotional distress.” *Id.* at 486 n.6.

235. *Id.* at 482.

236. *See Chou v. Univ. of Chicago*, 254 F.3d 1347, 1353 (Fed. Cir. 2001); *Johnson v. Schmitz*, 119 F. Supp. 2d 90, 91 (D. Conn. 2000); *Rainey v. Wayne State Univ.*, 26 F. Supp. 2d 963, 965 (E.D. Mich. 1998). Presumably, these three students had to begin another project to complete or continue the obligations of their degree plan or employment; therefore, the actions of their supervising professors were decidedly more egregious.

237. *See Patrick*, 887 F. Supp. at 482.

238. *See Chou*, 254 F.3d at 1362 (stating that a fiduciary duty “may also arise from the special circumstances of the parties’ relationship, such as when one party justifiably places trust in another so that the latter gains superiority and influence over the former”); 37 AM. JUR. 2D *Fraud and Deceit* § 32 (2001) (noting that a relevant factor in determining whether a fiduciary relationship exists is the extent to which the “servient” party placed trust and confidence in the “dominant” party).

239. *See Patrick*, 887 F. Supp. at 482.

240. *Id.*

student.²⁴¹ Patrick also failed to prove she sustained any actual damages as a result of her professor's actions.²⁴² Because she was unable to prove she owned a copyright in the published material, it is unlikely Patrick could have proven an ability to profit from her own publication of the work. In stark contrast, Chou, Johnson, and Rainey alleged they incurred actual damages, both monetarily and academically, and the respective courts granted them additional chances to prove those damages.²⁴³

VI. IMPLICATIONS OF A BREACH OF FIDUCIARY DUTY REMEDY FOR INFRINGEMENT ACTIONS

Allowing a claim for breach of fiduciary duty may have a significant impact on three distinct aspects of patent or copyright infringement actions: jurisdiction and preemption of claims, the underlying nature of the claims, and damages available to the injured student.

A. *Jurisdiction*

The Copyright Act specifically provides for vertical preemption of copyright claims: "[A]ll legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright . . . are governed exclusively by this title [N]o person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State."²⁴⁴ Correspondingly, the United Judiciary and Judicial Procedure Code provides, "[t]he district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, . . . copyrights and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent . . . and copyright cases."²⁴⁵ Thus, if a student were to bring a claim solely alleging infringement, she would have to file

241. See generally Carrie N. Baker, Comment, *Proposed Title IX Guidelines on Sex-Based Harassment of Students*, 43 EMORY L.J. 271, 290–92 (1994) (comparing student-teacher relationships and employer-employee relationships).

242. See *Patrick*, 887 F. Supp. at 486–87 (holding that Patrick owned no copyright in the published material).

243. *Chou*, 254 F.3d at 1359 (noting that Chou, due to her lack of a patent, was deprived of "a concrete financial interest"); *Johnson v. Schmitz*, 119 F. Supp. 2d 90, 91, 98 (D. Conn. 2000) (giving Johnson the opportunity, on remand, to prove damages as a result of his faculty advisor misappropriating his research theory and accompanying ideas); *Rainey v. Wayne State Univ.*, 26 F. Supp. 2d 963, 970–72 (E.D. Mich. 1998) (allowing Rainey to recover either actual damages or statutory damages as a remedy for the unauthorized reproduction and diminution in value of her work).

244. 17 U.S.C. § 301(a) (2000).

245. 28 U.S.C. § 1338(a) (2000).

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the suit in a federal district court.²⁴⁶ This procedure is often more expensive and time-consuming than having the claim heard in state court.²⁴⁷ In contrast, a claim for breach of fiduciary duty, which is a form of action for fraud, may be brought in state court.²⁴⁸

Additionally, a claim for breach of fiduciary duty is not preempted by the Copyright Act or Patent Act.²⁴⁹ The *Rainey* court explained that the key question in determining whether a claim is preempted “is to ask if the state law claim requires proof of an ‘extra element’ in addition to the acts of reproduction, performance, distribution or display, which are protected by federal copyright law § 106.”²⁵⁰ If an “extra element” is necessary to prove the state law claim, and it makes this claim “qualitatively different [than] a copyright infringement claim,” the state law claim will not be preempted.²⁵¹

Establishing a claim for breach of fiduciary duty clearly requires proving elements beyond those required in a copyright infringement suit. The student must assert the existence of a close relationship, characterized by guidance, trust, and dependence.²⁵² For instance, in *Patrick*, the student did not bring a claim for breach of fiduciary duty, but rather alleged intentional infliction of emotional distress.²⁵³ The court, having dismissed all of Patrick’s federal claims, chose not to exercise supplemental jurisdiction over the state law emotional distress claim, and therefore dismissed her action in whole.²⁵⁴ Thus, if she had alleged a breach of fiduciary duty instead, Patrick may have been given a chance to prove the elements of her case.

246. *Id.*

247. See *Gulf Offshore Co. v. Mobil Oil Corp.*, 453 U.S. 473, 484 (1981) (discussing the advantages of the state-court forum in litigation); David W. Robertson, *Admiralty and Maritime Litigation in State Court*, 55 La. L. Rev. 685, 686–87 (1995).

248. See, e.g., *Rainey*, 26 F. Supp. 2d 963, 965, 973 (E.D. Mich. 1998) (holding a state law claim for breach of fiduciary duty was not preempted by federal copyright law); *Ruhrgas AG v. Marathon Oil Co.*, 526 U.S. 574, 579 (1999) (discussing a state law claim for breach of fiduciary duty).

249. Compare *Rainey*, 26 F. Supp. 2d at 968–69, 973 (evidencing that the student’s claim for breach of fiduciary duty overcame summary judgment) with *Patrick v. Francis*, 887 F. Supp. 481, 486–87 (W.D.N.Y. 1995) (holding the student’s state law claims were dismissed because they were pre-empted by the Copyright Act).

250. *Rainey*, 26 F. Supp. 2d at 968.

251. *Id.*

252. See 37 AM. JUR. 2D *Fraud and Deceit* § 32 (2001).

253. *Patrick*, 887 F. Supp. at 482.

254. See *id.* at 486–87 (following 28 U.S.C. § 1367(c)(3), which allows a district court to “decline to exercise supplemental jurisdiction over a claim . . . if . . . (3) the district court has dismissed all claims over which it has original jurisdiction”).

B. *Nature of the Underlying Claim*

The second aspect of intellectual property infringement impacted by claims for breach of fiduciary duty is the underlying nature of the claims students may bring.²⁵⁵ It may not always be possible for the student to prove a copyright in the work or the ability to have patented the invention. For example, Patrick was unable to prove a copyright in the published work, and Chou and VanVoorhies were obligated to assign their patents to their universities.²⁵⁶ The courts in these cases did not entertain claims for infringement because the students could not show an interest in the work.²⁵⁷ However, these students did have standing to bring a claim for breach of fiduciary duty.²⁵⁸

A student's work is, by nature, not as advanced as the work done by professional researchers or university professors. Students are still mastering their craft and, as a consequence, their works may not meet patent or copyright statute requirements. For example, Chou may have developed a new method or invention deserving of a patent; however, because she was a student at the time, she could not simply file an application without the professor reviewing her work.²⁵⁹ Likewise, Johnson may have actually been obligated to share his research ideas with the doctoral committee before fixing the work in a tangible medium as required by the statute.²⁶⁰ He should not have suffered such harsh repercussions as losing the rights to his idea as a result of his classification as a student. While a majority of courts may not fully recognize the special nature of student work, these cases suggest a strong minority is amenable to more equitable solutions, offering students more protection.²⁶¹

C. *Damages*

A final area of intellectual property that claims for breach of fiduciary duty will affect is the scope of damages a student may

255. Compare *Chou v. Univ. of Chicago*, 254 F.3d 1347, 1362 (Fed. Cir. 2001), *Johnson v. Schmitz*, 119 F. Supp. 2d 90, 98 (D. Conn. 2000), and *Rainey*, 26 F. Supp. 2d at 973 (finding that the student presented valid claim for breach of fiduciary duty in all cases), with *Patrick*, 887 F. Supp. at 482, 486–87 (explaining that the student did not successfully allege a breach of fiduciary duty and eventually dismissing the entire cause of action).

256. *Patrick*, 887 F. Supp. at 486; *Chou*, 254 F.3d at 1356–57; *Univ. of W. Va. v. VanVoorhies*, 278 F.3d 1288, 1292 (Fed. Cir. 2002).

257. See, e.g., *Patrick*, 887 F. Supp. at 486.

258. See *Chou*, 254 F.3d at 1363.

259. *Id.* at 1362.

260. *Johnson*, 119 F. Supp. 2d at 97; 17 U.S.C. § 102(a) (2000).

261. See *Chou*, 254 F.3d at 1362–63; *Johnson*, 119 F. Supp. 2d at 97–98.

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collect in an infringement action. The Patent Act provides that damages in an infringement action are awarded by the jury or the court and gives the court discretion to award treble damages.²⁶² The Copyright Act allows the claimant to recover either actual damages and the infringer's additional profits or statutory damages.²⁶³ Certainly an award of treble damages would be appealing to these students, but if they are unable to prove patent ownership or infringement, they may not be able to recover such an award.²⁶⁴ A court may decrease the student's actual damages because of an assignment clause in the university policy, thereby lessening the student's recovery.

A claim for breach of fiduciary duty would be compensable like other civil claims and would not be subject to the limitations in these Acts.²⁶⁵ This would entitle the student to an award closer to her actual damages.

VII. CONCLUSION

The students in the above-mentioned cases were betrayed and victimized by their professors. Although the students trusted these professors for guidance and academic support, their trust was betrayed when the professors used the students' innovative research or other work for their personal benefit and professional advancement. A claim for breach of fiduciary duty provides an adequate remedy for these students. Fortunately, some courts have begun to realize this new claim offers students some recourse for the injurious acts of professors. It remains to be seen how courts will rule on this issue in future cases, but presently in certain instances, this claim can be successfully argued and may provide relief where traditional actions for infringement and misappropriation fail.

Because this remedy is new, courts have not clearly delineated the factors used to determine whether the claim will succeed. However, courts appear willing to grant relief to graduate students who have a close relationship with and are able to show damages from the offending professor's actions.²⁶⁶ It

262. 35 U.S.C. § 284 (2000).

263. 17 U.S.C. § 504(a) (2000).

264. See 17 U.S.C. § 504 (2000) (limiting the action for infringement to copyright owner); 35 U.S.C. § 284 (2000) (limiting the remedies for patent infringement to the actual patent owner).

265. See, e.g., 18 AM. JUR. 2D *Copyright and Literary Property* § 7 (1985 & Supp. 2002).

266. See e.g., *Chou*, 254 F.3d at 1353, 1362–63 (reversing summary judgment on a breach of fiduciary duty claim where the student and professor had a thirteen year working relationship).

is also noteworthy that courts have tended to deny or reverse orders of dismissal or summary judgment and allow the student to present evidence when this claim is alleged, thus giving the student another opportunity to prove his case.²⁶⁷ As these cases continue to arise, the circumstances in which courts are willing to grant this new form of relief will become more apparent. In the interim, students, professors and universities should be aware of this possible action, probable remedies and the implications for intellectual property infringement.

Melissa Astala

267. *Chou*, 254 F.3d at 1353; *Johnson v. Schmitz*, 119 F. Supp. 2d 90, 97–98 (D. Conn. 2000); *Rainey v. Wayne State Univ.*, 26 F. Supp. 2d 963, 973 (E.D. Mich. 1998).