



ANNOUNCEMENT

from the Copyright Office, Library of Congress, Washington, D.C. 20559

INTERIM REGULATIONS

MASK WORK PROTECTION; IMPLEMENTATION OF THE SEMICONDUCTOR CHIP PROTECTION ACT OF 1984

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LIBRARY OF CONGRESS

Copyright Office

37 CFR Part 211

[Docket RM 84-6]

Mask Work Protection; Implementation of the Semiconductor Chip Protection Act of 1984

AGENCY: Copyright Office, Library of Congress.

ACTION: Interim regulations.

SUMMARY: This notice is issued to inform the public that the Copyright Office is amending 37 CFR Chapter II on an interim basis by adding a new Part 211. These regulations implement certain provisions of the Semiconductor Chip Protection Act of 1984, Pub. L. 98-620 (Nov. 8, 1984). The Act establishes a registration system for mask works to be administered by the Copyright Office and authorizes the Office to establish regulations in several cases, including the registration of claims of protection in mask works, the recordation in the Copyright Office of documents pertaining to mask works and the mask work notice. Part 211 of 37 CFR Chapter II sets forth specific requirements for filing applications for registration of mask work claims and for the recordation of documents. The regulations also provide examples of methods of affixation and placement of the mask work notice. Since owners of mask works may begin filing applications for registration on January

7, 1985, in order to provide guidance to the public on the implementation of the Act, the Copyright Office has decided to make these regulations effective, on an interim basis, upon their publication in the Federal Register. A lengthy comment period is provided, however, to allow for review of the regulations, in light of experience, before they are adopted in final form.

EFFECTIVE DATE: January 3, 1985.

Written comments should be received on or before March 4, 1985.

ADDRESSES: Ten copies of written comments should be addressed, if sent by mail, to: Library of Congress, Department D.S., Washington, D.C. 20540.

If delivered by hand, copies should be brought to: Office of the General Counsel, James Madison Memorial Building, Room 407, First and Independence Ave., SE., Washington, D.C.

FOR FURTHER INFORMATION CONTACT: Dorothy Schrader, General Counsel, U.S. Copyright Office, Library of Congress, Washington, D.C. 20559 (202) 287-8380.

SUPPLEMENTARY INFORMATION: On November 8, 1984, the President signed into law the Semiconductor Chip Protection Act of 1984, Pub. L. 98-620. The Act creates a new form of intellectual property law separate and apart from any earlier law. The legislation consists of an amalgam of patent and copyright principles, but also contains new features. The law will be codified as chapter 9 of title 17 of the U.S. Code, and will be administered by the Copyright Office. Noteworthy is the

requirement in section 908(a) of the Act¹ that registration in the Copyright Office of a claim of protection in a mask work must be made within two years of first commercial exploitation of the work anywhere in the world or protection under the Act terminates. The Act also provides for a notice of mask work protection; however, unlike the copyright notice, this notice is not a condition of protection.

Under section 905 of the Act, the owner of a protected mask work enjoys the exclusive rights to do and to authorize any of the following:

"(1) To reproduce the mask work by optical, electronic, or any other means;

(2) To import or distribute a semiconductor chip product in which the mask work is embodied; and

(3) to induce or knowingly to cause another person to do any of the acts described in paragraphs (1) and (2)."

The Act provides that the owner of these exclusive rights may transfer or license any or all of the rights by a duly signed written document, and authorizes the Register of Copyrights to record any transfer, license or other document pertaining to a mask work.

With the exception of the international transitional provisions in Section 914, all administrative functions and duties under the Act are made the responsibility of the Register of Copyrights.

In addition to specific grants of regulatory authority in connection with

¹ Citations to the Act will be to the text as published in the Congressional Record. 129 Cong. Rec. S 12913 (daily ed. Oct. 3, 1984).

issues as the mask work notice, there is a general reference in section 906(b) to the provisions of chapter 7 of title 17 U.S.C. relating to the regulatory authority of the Register. Section 702 of title 17 authorizes the Register of Copyrights "to establish regulations not inconsistent with law for administration of the functions and duties made the responsibility of the Register under this title." It also provides that "[a]ll regulations established by the Register under this title are subject to the approval of the Librarian of Congress."

On October 4, 1984, the Copyright Office issued a Notice of Inquiry and of Public Hearing in the Federal Register to advise the public that the Office would institute a rulemaking proceeding to implement certain provisions of the Semiconductor Chip Protection Act of 1984, and to invite public comment, views and information to assist it in the preparation of regulations (49 FR 39171). The Copyright Office was particularly interested in receiving public comment on a registration form, filing fee for registration and fees for other services, application for registration, deposit of identifying material, mask work notice and publication of registrations made by the Copyright Office.

At the public hearing on the implementing of the Semiconductor Chip Protection Act of 1984 that was held at the Copyright Office on October 18, 1984, representatives of the Semiconductor Industry Association (SIA) testified on the issues raised in the Notice of Inquiry and submitted a written statement for the record. During the course of the hearing, the Copyright Office circulated for information and comment a preliminary draft form, Form MW, to be used for registration of a claim of protection in a mask work. Following the hearing, supplemental comments were received from SIA and from other interested parties. The comment period was held open until October 31, 1984.

At the public hearing Mr. Rick Willson, a representative of SIA, discussed the terminology SIA would use in their presentation. He indicated that the terms were commonly understood in the semiconductor industry. Since the Copyright Office has decided to refer generally to the same terminology in its Interim Regulations, it may be helpful to summarize briefly Mr. Willson's comments.²

²For full text of Mr. Rick Willson's testimony, see *Testimony of the Semiconductor Industry Association, Transcript of the Public Hearing on the Implementation of the Semiconductor Chip Protection Act of 1984 (Oct. 18, 1984)* (copy available at the Copyright Office).

(a) *Composite or single layer plots:* Mr. Willson noted that, before the development of computer-aided design (CAD) systems, a circuit design was usually drawn by hand. As circuits grew larger and more complex, however, this process gave way to composite or single layer plots generated by electrostatic plotters, pen plotters, and other devices.

(b) *Data base tape or disk:* Once plots are made and checked either manually or by machine, the information is fixed in a data base tape or disk. These tapes are made using a CAD system. The data on a tape is then "fractured," that is, broken up into a format more accessible to a machine.

(c) *Reticle:* Mr. Willson described a reticle as a piece of glass, quartz, or some other type of material, usually coated with a hard substance like chrome. The patterns on the data base tape are transferred to the reticle. The reticle shown at the hearing was 10 times the final size of the "chip" (or "die"); however, he indicated the magnification varies. Using one type of technology, a reticle is reduced further to make a plate or mask from which a wafer is then exposed.

(d) *Plastic overlays:* Once reticles are made, the process is checked for accuracy. According to Mr. Willson, the most common way to verify the data is to blow up the image from the reticle and make what are called "plastic overlays," usually on acetate material. These overlays, essentially photographic blow-ups, may be checked against single layer plots.

Mr. Willson stressed, however, that the technology is changing rapidly. He indicated that a goal of the semiconductor industry was to go from conceptual design to the die as quickly as possible. Where an electron beam machine is used, it is sometimes possible to write directly on a wafer, thereby eliminating most intervening steps. Although, in such cases, it would be impractical to make plastic overlays, he thought it would always be possible to make composite plots, or to take photographs of a mask work embodied in an intermediate or final form of a semiconductor chip product.

The general overview of terminology presented by SIA at the public hearing was particularly helpful to the Copyright Office in analyzing the various proposals put forward with respect to the deposit of identifying material for registration purposes. It became apparent that there is no one uniform process used in the semiconductor industry to produce circuit chips and that any registration requirements issued by the Copyright Office should be

flexible enough to accommodate a wide spectrum of practices. In drafting its regulations the Office has been sensitive to the complexities inherent in the semiconductor industry. The Copyright Office reviewed carefully the oral testimony and written comments as well as the language of the Semiconductor Chip Protection Act of 1984 and reached certain conclusions with respect to the administration of the Act. The following discussion of the issues considered by the Office in preparing its regulations covers generally the same points raised in its Notice of Inquiry and of Public Hearing (49 FR 39171; Oct. 4, 1984).

1. *Registration form.* Section 906(c) of the Act requires that applications for registration in the Copyright Office of claims of protection in mask works must be made on a form prescribed by the Register of Copyrights and include "any information regarded by the Register as bearing upon the preparation or identification of the mask work, the existence or duration of protection of the mask work * * * or ownership of the mask work."

In accordance with the Act, the Copyright Office has adopted a form, designated Form MW, to be used to apply for registration of claims in mask works. As noted above, a preliminary draft of this form was made available for comment at the public hearing on October 18, 1984. The draft form has been revised and is currently being printed in final form. Copies of Form MW should be available upon request from the Public Information Office, Copyright Office, Library of Congress, Washington, D.C. 20559 on or about December 28, 1984. The regulations require the use of an original Form MW in filing all applications for registration of mask works in the Copyright Office on and after January 7, 1985. Photocopies of the form will not be accepted.

In its Notice of Inquiry, the Copyright Office invited public comment on whether, in view of the unique character of mask works, "a more detailed registration record [than that required for copyrights] would be beneficial to the public." It specifically asked: "Where a prior work has been substantially reproduced in a second mask work, should there be a clear indication in an application form of the portions reproduced and the new material added?" 49 FR at 39173. This concern was raised in light of the "reverse engineering" exception in section 906(a) of the Act.

Most commentators urged the Copyright Office to follow generally its experience in drafting existing forms for

copyright registration in preparing the new mask work form and regulations. They were concerned that the Office might require an applicant to supply a detailed description of the nature and scope of a claim, specifically identifying the "old" and "new" elements in a mask work. It was felt that, to require something more than a general statement of the nature of the contribution made in a particular case would be impractical and unduly burdensome, and might even become a "trap for the unwary" applicant. There was some support, however, for requiring an applicant "to indicate whether or not the work is a modified version of a prior work, and to identify any such prior work."

In revising the preliminary draft form, the Copyright Office decided not to require a detailed dissection of the "old" and "new" elements in a mask work. Form MW does require an applicant to describe generally at space 8 "the new, original contribution" for which protection is sought. There is recognition that, for the most part, mask works contain preexisting designs that are common in the semiconductor industry, or are designs which will have been previously registered for protection or commercially exploited. Consequently applicants are encouraged to describe any previous mask work upon which the new work is based in order to distinguish the new contribution from the preexisting material. The Copyright Office did adopt the SIA proposal that the phrase "which is the subject of this application" be added after "mask work" at space 5.

The Copyright Office welcomed the assistance provided by SIA and other commentators in clarifying several provisions of the draft registration form. Many suggestions were adopted and will be reflected in Form MW. Because of time constraints, there will not be any further opportunity for public comment on the form before it is issued in final form. As the Copyright Office, the semiconductor industry and the public develop experience under the regulations and Form MW, however, there will be occasion to revisit this matter and to make any necessary changes. The Office will particularly monitor the standards or originality developed for mask works under the Act to determine whether additional information should be required on Form MW and whether the Copyright Office should issue a new regulation on material not subject to protection under the Semiconductor Chip Protection Act of 1984

2. *Filing fee for registration and fees for other services.* Under section 908(d) of the Act, the Register of Copyrights is authorized to "set reasonable fees for filing of applications to register claims of protection in mask works under this chapter [chapter 9], and for other services relating to the administration of this chapter or the rights under this chapter, taking into consideration the cost of providing those services, the benefits of a public record, and the statutory fee schedules under this title [title 17]." Although the Act did not specifically apply the copyright fee schedule in section 708 of chapter 7 to mask works, it did not preclude the application of the same or similar fees, and invited the Register to consider these fees in determining the cost of services relating to mask works.

In its Notice of Inquiry, the Copyright Office indicated that, with the exception of the fee for filing of an application for registration, the Register of Copyrights was inclined to establish, by regulation, that the fees for copyright services set in section 708 of title 17 U.S.C. apply, where appropriate, to services rendered by the Copyright Office under chapter 9. For the filing of an application for registration of a mask work claim, however, the Office noted a preference for a fee of twenty dollars (\$20) in order to allow recovery of a higher percentage of costs.

No objection was raised at the public hearing or in written comments concerning the proposed fee schedule for services of the Copyright Office relating to mask works. The Copyright Office is issuing a regulation listing the fees for filing of applications for registration and other services. The filing fee for applications for registration is set at twenty dollars (\$20), and the cost of other services reflects the fees established for comparable copyright services in section 708 of title 17.

3. *Application for registration. (a) Who May Apply.* In its Notice of Inquiry, the Copyright Office announced its intention, at that point, "to allow only the initial owner of all of the exclusive rights in a mask work, or a person who has obtained ownership of all rights in the work initially belonging to such owner, to be identified in an application as the 'claimant' for purposes of registration." In its discussion of this issue, the Office referred to the draft definition of "owner" of a mask work then under consideration by Congress where provision was made for the "author" of a mask work.

As finally enacted, section 901(a) of the Act no longer speaks of an "author" and defines the "owner" of a mask work

as "the person who created the mask work, the legal representative of that person if that person is deceased or under a legal incapacity, or a party to whom all the rights under this chapter [chapter 9] of such person or representatives are transferred in accordance with section 903(b); except that, in the case of a work made within the scope of a person's employment, the owner is the employer for whom the person created the mask work or a party to whom all the rights under this chapter of the employer are transferred in accordance with section 903(b)." In light of this new definition of "owner," the Copyright Office has decided, in new § 211.4(b)(2) of its regulations, to allow only the "owner of the mask work, or the duly authorized agent of any such owner" to apply for registration of a mask work claim.

Further guidance on this matter was provided in the *Explanatory Memorandum—Mathias-Leahy Amendment to S1201* (130 Cong. Rec. S12916, S12917 (daily ed. Oct. 3, 1984) (hereafter, the Senate Memorandum)). It was expressly stated in the *Senate Memorandum* that: "While the transferee of all rights under the Act is an owner, a licensee of all or some rights is not, a distinction recognized in section 903(b). While only an owner (including a transferee) may register a mask work under section 908, an exclusive licensee of all rights is also entitled, under section 910(b)(1), to bring an infringement action * * *." A document transferring less than all of the exclusive rights in a mask work, or licensing all or less than all rights in the work may be recorded in the Copyright Office.

(b) *Intermediate Forms.* A "semiconductor chip product" is defined in section 901 of the Act as including "the final or intermediate form of any product * * *." A mask work cannot be protected under the Act until it has been fixed in such a product. The question arises whether it is possible for an application for registration of a claim in a mask work to be made for a mask work fixed in an intermediate form of the product. Since, under section 904(a), the term of protection for a mask work is computed from the date of registration or first commercial exploitation, if multiple applications for registration were allowed, different parts of a semiconductor chip product fixed in final form at the same time could be protected for varying periods. In its Notice of Inquiry, the Copyright Office asked whether it should encourage or discourage this development, whether any safeguards or conditions should be

applied to protect the public interest, other than a clear disclosure of the basis of the claim, and what statements or descriptions of the basis of claiming are appropriate for mask works?

Most commentators urged the Copyright Office to register claims of protection for mask works fixed in intermediate forms of semiconductor chip products, and any revisions of such works where the material added is sufficiently original to merit protection as a new mask work. SIA noted that "[d]esigning the part of the gate array or ROM up to the final interconnection stages involves considerable expense and creativity, of the same kind as for other semiconductor chip products We therefore, urge that the Copyright Office expressly authorize the registration of semifinal gate arrays, ROMs, and similar intermediate products." SIA also discussed the registration of "cells" in cell libraries and significant "modules" contained in semiconductor chip products. There was concern that the Copyright Office register claims in such cells or modules as original mask works. This question is related to the issue of what is a "basic registration," and the Office position is discussed in the next point.

(c) *Single Basic Registration.* The Copyright Office understands that "gate arrays" (aggregations of gates without metal connections, which are later customized to the purchaser's specifications or by the purchaser) frequently comprise five or more layers of a final semiconductor chip product. They are nonfunctioning intermediate forms, which are intended to be incorporated in a functioning semiconductor chip product. "Cells" or "cell libraries" (collections of counters, registers, oscillators, and transistors) are an even more amorphous concept, which may refer to a one-transistor component of the chip or to a collection of functions comprising as much as 30 percent of the final semiconductor chip product.

While the industry has made clear its wish to register mask works fixed in gate arrays, cells, and other intermediate forms, the Copyright Office has grave concerns about the ramifications of such registrations on the standard of originality and the "reverse engineering" limitation on exclusive rights and the statutory damages provision of section 911(c). First, with respect to originality, the Copyright Office does not intend to examine the prior art. The Copyright Office will conduct a facial examination of the application and deposit, in light of the requirements of the statute. Office

regulations and practices, and the case law as it develops. Since most mask works appear to result from a combination of previously existing components, the Office generally assumes that the nature of the "new contribution" will be very roughly analogous to a copyright claim in a compilation of pre-existing materials. To the extent this is true, attempts to register mask works fixed in intermediate forms, which comprise small "parts" of final semiconductor chip products, make it difficult to apply any standard of originality without examining the prior art. While a one-transistor cell may be so unique that it is patentable, it does not seem possible to determine originality of a small component when conducting a facial examination. To illustrate the point with a rough analogy: a cartographic representation of the United States with a few points of interest identified for each of the 50 states (capital, principal river, and largest city) is arguably copyrightable as a compilation, but "compilation authorship" for a single state under the same facts (selection of three points of interest) would be de minimis and uncopyrightable.

Second, a principal feature of the Act, and one which has no counterpart in copyright law, is the limitation on exclusive rights to permit "legitimate" reverse engineering. Under section 906(a), a mask work may be dissected and disassembled for purposes of teaching, analyzing, or evaluating the concepts or techniques embodied therein, and the results of this "reverse engineering" may be incorporated in an original mask work made for distribution, without infringement of the mask work right. The two key elements in establishing the reverse engineering defense are that the person invoking the defense can show by a "paper trail" that legitimate analysis and study, as compared with direct, simple copying took place, and that some new contribution was made, which resulted in an original mask work. What if the person claiming the reverse engineering defense satisfies both of the former conditions, but nevertheless identically copies a certain feature which was registered separately as a mask work fixed in an intermediate form of a product? Does the reverse engineering defense fail? This point is ultimately for the courts to decide. The Copyright Office is concerned, however, that the registration system may be manipulated to make the burden of establishing the reverse engineering defense greater than that intended by Congress, and hence

frustrate the congressional intent to sanction legitimate reverse engineering.

Third, section 911(c) allows the mask work owner to elect statutory damages of \$250,000 maximum "with respect to any one mask work for which any one infringer is liable" The Copyright Office is concerned that registration may be sought in intermediate form for several "parts" of a final semiconductor chip product in order to increase the potential award of statutory damages. For example, if Company X claims separate protection in "mask works" fixed in intermediate form that comprise six different "parts" of a final semiconductor chip product, and all "parts" are later infringed by one act of unauthorized reproduction, distribution, or importation, a claim for statutory damages may be made of six times \$250,000. While the Act gives the court discretion to award an amount it considers just, the court may be bound to award statutory damages for each separately registered mask work. Even if the courts can generally deal with this problem by lowering the award for each work sufficiently, the chilling effect on competition of potentially great statutory damage awards is a matter of concern.

As an interim solution, pending review in light of experience, the Copyright Office has concluded that it should allow registration of certain mask works fixed in intermediate forms of semiconductor chip products, but that beyond a certain limit, registration will be refused until the courts give clear guidance about the standard of originality. The interim regulation provides that where registration is requested for a mask work fixed in an intermediate form of a semiconductor chip product, that fact shall be disclosed on the application form (at space 2) and the applicant aver whether the proffered "mask work" consists of 20 percent or more of a final semiconductor chip product. If the mask work comprises less than 20 percent of a final product, the Office will refuse to register the work as fixed in the intermediate form on the ground that, absent an examination of the prior art, it must be presumed that a mask work comprising less than 20 percent of the final chip is de minimis, and an unoriginal combination of staple elements, commonplace in the semiconductor industry. The refusal to register may of course be tested in the courts against a purported infringer, or against the Office itself. Alternatively, the claimant can elect to register the "entire" mask work, as fixed in a final semiconductor chip product.

As a preliminary matter, the Office believes some limit must be placed on registration for mask works fixed in intermediate forms to avoid registration of spurious claims, and to carry out the congressional intent to sanction legitimate reverse engineering. The Office believes that the limit established by the regulation is reasonable in light of the purposes of the Act, and will not significantly, if at all, hamper the industry's ability to license gate arrays, cells, and other intermediate forms. Gate arrays and cells can be licensed separately, if they have marketable value, even though they are registered as part of a "larger" mask work fixed in a final semiconductor chip product.

Where registration has been made for an earlier version of a mask work fixed in an intermediate form of a semiconductor chip product, SIA commented that a second registration in the Copyright Office for a later version of the work "should confer mask work rights only in the registrable variations embodied in the second mask work, or in the new ensemble rather than the old parts as such, just as copyright in a derivative work confers rights only in the modifications or new ensemble."

The Copyright Office agrees that registration in the Copyright Office should only be made for original mask works. Certain mask work claims may be registrable at the time the work is fixed in an intermediate form of a semiconductor chip product; however, if registration is sought for the same version of the work fixed in a final form of the product, a second registration would be limited to any new original elements added to the earlier version of the mask work. For example, where registration has been made for a mask work fixed in nine layers of a semiconductor chip product, and registration is sought for a later version of the work consisting of twelve layers, the second registration would cover only the new elements added to the first nine layers and any original design material in the three new layers. Registration could not be based on merely trivial variations of the previously registered work. Section 211.4(c) of the Copyright Office regulations provides, in this respect, that: "As a general rule only one registration can be made for the same version of a mask work fixed in an intermediate or final form of any semiconductor chip product."

In drafting § 211.4 of its regulations, the Copyright Office considered whether to specify that, where registration has been made for a claim of protection in a mask work fixed in a final form of a semiconductor chip product, registration

could no longer be made for any part of the work fixed in an intermediate form. Since only one registration for a mask work is generally permitted under § 211.4(c), once registration is made for a particular mask work fixed in a final form of a semiconductor chip product, a second registration could not be made for the same version of the work whether fixed in an intermediate or some other final form of the product.

(d) *Bulk Registration.* The Office has been asked to establish a "bulk registration" procedure to cover all registrable parts of cell libraries that were first commercially exploited between July 1, 1983 and the date of enactment of the Semiconductor Chip Protection Act of 1984. The Office does not believe it is authorized to permit the filing of a single application for claims of protection in multiple mask works incorporated in cell libraries first commercially exploited at different times during the transition period. The term of protection would be different for the 1983 and 1984 chips. In any event, group or bulk registrations would tend to confuse the basis of claim and would perhaps allow registration of unoriginal mask works. Registration on a single application and upon payment of a single registration fee can only be made in accordance with new § 211.4(d) of the Copyright Office regulations.

(e) *Section 914 Orders.* With respect to the international transitional provisions in section 914 of the Act, the Copyright Office was asked to provide, by regulation, for the submission of applications for registration for interim protection of mask works before the effective date of an Order issued pursuant to that section. There was some concern that, if applications could not be processed before an Order is issued, it might result in a delay before registration could be made even after the Order has issued. It was noted that applicants could encounter special difficulties where an Order protects retroactively mask works first commercially exploited on and after July 1, 1983 and before November 8, 1984 (the date of enactment).

To alleviate any potential problems or delays that foreign applicants may experience when claiming protection under an Order issued pursuant to section 914 of title 17 U.S.C., the Copyright Office has decided to allow such persons to file applications for registration before the effective date of an Order extending protection. The application will be examined to the extent possible and held pending issuance of an Order, provided that a request for such issuance has been filed

with the Secretary of Commerce and the Order is issued before July 1, 1985. No certificate of registration will be issued, however, and a registration will not be effective, until the effective date of the relevant Order.

A similar rule would apply where the section 914 Order pertains to mask works first commercially exploited on or after November 8, 1984. The Office will accept and process applications whose eligibility is dependent on issuance of an Order, provided a petition is pending and the Order is later issued no more than two years after the first commercial exploitation of the particular mask work. While the Office recognizes that the Secretary of Commerce has the general discretion to specify an effective date for the Order as early as the date the petition was received, the Office does not believe that Congress intended that discretion to be applied in a way that waives the July 1, 1985 deadline for pre-November 8, 1984 chips, or the two year deadline from first commercial exploitation for all other chips. The nearly 8 month period between November 8, 1984 and July 1, 1985 seems sufficient for foreign claimants to petition the Secretary and for the Secretary to act, if only on a provisional basis, on the petitions. A contrary interpretation would create public uncertainty about which chips are protected and which are in the public domain, insofar as federal protection is concerned.

The status of applications for registration of mask works eligible only pursuant to a section 914 Order and that are pending in the Copyright Office when an Order extending such protection is terminated or allowed to expire, was also questioned. The Copyright Office has concluded that, in such cases, registration may be made provided that an application, deposit, and fee in acceptable form have been received in the Office before termination or expiration of the relevant Order.

(f) *Ownership and Eligibility.* In one of the unusual features of the Act, section 902(a)(1)(A) provides that a mask work is eligible for protection based on the criterion of ownership of the mask work at the time protection commences (i.e., the date of registration, or the date of first commercial exploitation, which ever occurs first). Persons who are stateless and United States citizens and domiciliaries who are owners are eligible under this provision. Foreign owners may become eligible in their own right, if the country of which the owner is a citizen, domiciliary or sovereign authority is a party to a multilateral or bilateral treaty with the

United States which protects mask works. At present, no such multilateral treaty appears to exist. (In adopting this sui generis law, the United States has taken the position that the Universal Copyright Convention does not require members to protect mask works.) No bilateral agreements have been concluded.

Since ownership can be transferred, however, the question has arisen whether an exclusive licensee of all rights in the United States is an "owner" for purposes of satisfying the eligibility condition of section 902(a)(1)(A). For example, if the initial owner is an ineligible foreigner, will a transfer of "all mask work rights in the United States" to a United States person (either a subsidiary, parent company, or stranger), before first commercial exploitation anywhere make the mask work eligible? Is the conveyance properly characterized as a "transfer" or is it a "license," where only U.S. rights are conveyed? The Act seems to make a distinction between "the owner of a mask work protected under this chapter" and "the exclusive licensee of all rights under this chapter." Section 910(b) uses these phrases in the disjunctive, in providing that either may institute an action for infringement. However, only the "owner of a mask work" may apply for registration of claims to mask work protection. The Senate Memorandum also suggests that the two concepts are different.

The Semiconductor Chip Protection Act seems to follow the patent law concept of indivisibility of ownership and the similar concept of the copyright statute under the Act of 1909 (in effect until December 31, 1977). It appears that there is an owner (including joint owners) of a given mask work, and ownership (as compared to an exclusive license) is conveyed only by a transfer of all mask work rights. If some rights are withheld, even though they would be enforced outside the United States, for example, the conveyance would seem to be a license rather than a transfer of ownership. This analysis does not lead to extraterritorial application of United States law. No foreign court would be required to apply United States law to enforce rights in mask works. As a property right, mask work rights however would seem to be subject to conveyance by contract law, either as existing or contingent rights.

The question is important. The criteria for eligibility allow foreign owners to claim the protection of United States law by first commercial exploitation in this country. Did Congress also intend that, by a conveyance of United States

rights alone, mask works created by foreigners would be eligible to claim mask work protection? If the ownership criterion of section 902(a)(1)(A) includes licensees of United States rights, it would be fairly simple for a foreign owner to retain all rights outside the United States, and license a subsidiary, parent, or third party to claim rights in the United States before first commercial exploitation. In some cases, the conveyance might constitute a license of United States rights without further qualifications; in other cases, the conveyance might purport to require a license-back to the original foreign owner.

Congress established a unique transitional procedure in section 914 apparently because it believed the general eligibility criteria would foreclose registration of most foreign-owned chips. An overbroad interpretation of the general eligibility criteria will largely, if not completely, eliminate the incentive to seek section 914 Orders or bilateral agreements. The United States would in effect offer unilateral protection for mask works with no assurance of protection for United States mask works in foreign countries.

The Copyright Office invites Comment specifically on the meaning of ownership for purposes of section 902 eligibility, since this question was not mentioned in our Notice of Inquiry. As an interim matter, the Copyright Office has concluded that Congress has made a distinction between "owners of mask works" and "exclusive licensees of all rights." The former may claim protection by registration, but the latter cannot. Since a conveyance of "all mask work rights in the United States" seems to be a license rather than a transfer of ownership, the Office concludes that, absent a bilateral or multilateral treaty basis for protection, foreign mask works can be made eligible only by (1) first commercial exploitation in the United States, (2) by issuance of a section 914 Order, or (3) by a transfer from the initial foreign owner of the totality of rights in the mask work to an eligible national or domiciliary. For eligibility purposes, a conveyance of "all mask work rights in the United States" would seem to be a license and not a transfer of ownership in the mask work and therefore, the mask work would not be eligible for registration.

(g) *Supplemental Filings.* At the public hearing there was some consideration given to whether the Copyright Office should establish procedures similar to those established in the case of copyright registrations for the correction

or amplification of a record of a completed mask work registration. Section 408(d) of the Copyright Act of 1976 authorized the Register of Copyrights "to establish, by regulation, formal procedures for the filing of an application for supplementary registration, to correct an error in a copyright registration or to amplify the information given in a registration."

Since registration in the Copyright Office of a claim of protection in a mask work is a condition of protection under the Semiconductor Chip Protection Act of 1984, and the Act does not require the Office to make provision for supplemental registrations, the Copyright Office concluded that, with the exception of its own errors or omissions, no procedures for supplemental registrations should be established for the correction or amplification of the information contained in the record of a completed registration. This decision is reflected in section 211.4(f) of its regulations. A document purporting to correct or amplify information in a registration record may be recorded in the Copyright Office under section 903 of the Act. The Copyright Office takes no position on the value of any such recordation. Claimants should take care to submit full and correct information in the first application.

4. *Deposit of identifying material.* Section 908(d) of the Act authorizes the Register of Copyrights to "specify the identifying material to be deposited in connection with the claim for registration." Although there is no further guidance in the Act on the nature of the "identifying material," there was some congressional concern expressed that the Copyright Office not require deposit of material that might disclose trade secrets. In an explanatory memorandum inserted in the Congressional Record by the Hon. Robert W. Kastenmeier, the Copyright Office was advised that: "Applicants should not, of course, be required to deposit material that would disclose trade secrets or would facilitate domestic or foreign chip piracy; it is anticipated that the Copyright Office's implementing regulations should reflect this principle to the greatest extent possible, while keeping in mind the necessity of benefitting the public by keeping a public record."¹

¹ *Explanatory Memorandum of the Senate Amendment to H.R. 6163, as Considered by the House of Representatives, 130 Cong. Rec. E 4432, E 4433 (daily ed. Oct. 10, 1984); See also Explanatory Memorandum—Mathias-Leahy Amendment to S. 1201, 130 Cong. Rec. S 12918, S 12918 (daily ed. Oct. 3, 1984).*

¹ Error; line should read: "keeping a public record."²

At the public hearing on October 18, 1984, consideration was given to the purpose of requiring identifying material. It was asked whether the material would be useful in an infringement action: (1) To show clearly the basis of a mask work claim at the time of registration; or (2) merely to indicate that something existed. There was general agreement that the first purpose was acceptable as long as it did not create serious business problems. The representatives of the Semiconductor Industry Association (SIA) thought the deposited material should disclose the mask work on the date of registration and not what an applicant might allege at a later point, perhaps after the changing his or her² mind about the nature of the claim.

SIA in its oral testimony and written comments recommended that the Copyright Office allow the submission of any of the following identifying material for deposit purposes:

(1) Sets of approximately $8\frac{1}{2} \times 11$ inch plastic overlay sheets (typically made of acetate material), or photocopies thereof;

(2) drawings of a mask work fixed in a semiconductor chip product, either in composite form on a single sheet or on separate sheets, plotted on about $8\frac{1}{2} \times 11$ inch [Mylar] plastic sheets of approximately 20 to 30 times the actual size of a chip or die;

(3) a photograph of the chip, magnified to about 20 to 30 times actual size;

(4) a printout of the design/layout data, together with a few selected overlays; or

(5) a reproduction of the mask work fixed in a semiconductor chip product, i.e., the chip or die itself.

SIA urged the Copyright Office to be flexible in its deposit requirements since, in its opinion, "there is no uniform or standard process within the semiconductor industry for preparing mask works or for manufacturing chips based upon the prepared mask works." SIA noted that, absent uniformity, "alternatives for identifying material must be available."

SIA and other commentators thought that any identifying material deposited should clearly identify the mask work for which protection was claimed, while not divulging any trade secret or other sensitive information. To accomplish this task, SIA asked the Copyright Office to establish optional deposit requirements. It suggested two specific options: (1) *Incomplete mask work descriptions*—this would be accomplished "by leaving out the description of entire layers, such as the ion implant layers, or by 'blocking out'

(similar to the approach used for source code) the sensitive material by submitting, for example, only 'stripes' from each layer;" and (2) *secured deposits*—except for identifying material, such a deposit would not be left with the Copyright Office and would not generally be accessible to the public for inspection.

Although in its Notice of Inquiry the Copyright Office concurred in the view expressed in a report of the Senate Committee on the Judiciary that "deposit of chips in the Library of Congress would serve no useful purpose" (i.e., no useful library purpose), S. Rep. No. 98-425, 98th Cong., 2d Sess. 19 (1984), it became apparent during the public hearing that the chip or die itself was the best reproduction of the mask work to require for deposit purposes in the Copyright Office. In comments submitted following the hearing SIA cautioned, however, that, if the chip or die were the only deposit permitted, it might preclude a manufacturer from registering prior to commercial exploitation. Captive manufacturers were particularly concerned that a chip or die "might include such valuable information and be so expensive that public deposit even after commercial exploitation would be unadvisable."

After reviewing the comments and testimony received in this regulatory proceeding, the Congressional Record and the Act itself, the Copyright Office concluded that its deposit requirements under section 908(d) of the Semiconductor Chip Protection Act of 1984, Pub.L. 98-620, should generally allow for optional deposit of identifying material in order to preserve trade secrets and other sensitive information, provided that the public record (archival) purpose and examining needs are also satisfied. The Office divided its regulations into two general categories depending on whether a mask work fixed in a semiconductor chip product was commercially exploited.

For all commercially exploited mask works, the Copyright Office requires, in new § 211.5(b) of its regulations, the deposit of "four reproductions of the mask work fixed in the form of the semiconductor chip product in which it was first commercially exploited." The Office decided to require four chips or dies, since it understood that, in the context of an action for infringement, a chip may be dissected for evidentiary purposes, and thereby destroyed. Where a chip is furnished to a court in the first instance, three additional reproductions of the mask work would remain in the files of the Copyright Office to be used in the event of other infringement actions involving the same work. Since

Copyright Office examiners will not be able to examine facially the deposited chips or dies, however, the Office provides in § 211.5(b)(1) that the four reproductions of the mask work be accompanied by visually perceptible representations of the mask work consisting of sets comprising all layers of the mask work in the form of either plastic overlays, composite plots, or photographs. To minimize the risk of divulging trade secrets, the Office allows applicants to withhold one of two layers of the "visually perceptible representation" containing sensitive material, and permits the deposited material for the remaining layers to be produced at 20 to 30 times magnification of the actual size of the mask work. Apparently, at that magnification, the danger of divulging trade secrets is reduced, but not eliminated. Finally, where one or two layers are withheld under claim of trade secrecy, the applicant shall in addition deposit "identifying portions" of the affected layers, consisting of a printout of the mask work design data pertaining to each withheld layer, reproduced in microform; the sensitive material may be blocked out or stripped from the deposited material.

In the case of mask works that have not been commercially exploited, the Copyright Office does not require the deposit of the chip or die. For the interim, the Office has accommodated the need expressed by SIA and other representatives of the semiconductor industry to all alternative deposits³ preserve trade secrets and to reduce any expense involved in complying with the deposit requirements. In § 211.5(b)(2) of its regulations, the Copyright Office generally requires the deposit of a visually perceptible representation of a mask work that has not been commercially exploited, consisting of either sets of plastic color overlay sheets or composite plots of each layer. Where an applicant wishes to withhold overlays or plots relating to certain layers of a chip in which trade secret protection is asserted, including all layers in some cases, the interim regulations allow the withholding of this material; however, an applicant must submit specific identifying portions (as discussed above) in lieu of the layers of⁴ the mask work.

Since the Register of Copyrights anticipates that applicants may be faced initially with unique difficulties in complying with the deposit requirements in § 211.5 of the regulations, the Register decided to establish a procedure for special relief. The request should state reasons for a favorable response and

³Error; line should read: "industry to allow alternative deposits to"

⁴Error; line should read: "discussed above) in lieu of the overlays or plots, and a single photograph of the top or other visible layers of"

²Error; line should read: "perhaps after changing his or her"

should propose alternative deposit material. Eventually, it may be necessary to set a fee for this service; however, until more experience is developed in administering the deposit regulations, requests for special relief will be processed free of charge. There will also be no charge, at this time, for the retention of deposited material in accordance with § 211.5(e)(2) of the regulations.

The Office in these interim regulations has accommodated industry concerns about unnecessary public disclosure of trade secrecy. We view these regulations as experimental and will closely monitor the experience under the Act to assure that sufficient disclosure of the mask work is made on the public record. If necessary, additional disclosure requirements will be imposed.

5. *Mask work notice.* (a) *Affixation and Location.* Section 909(a) of title 17 U.S.C. authorizes the Register of Copyrights to prescribe, by regulation, "specific methods of affixation and placement of notice" for purposes of that section. It is provided, however, that "these specifications shall not be considered exhaustive." Unlike the copyright law, the mask work notice is not a condition of protection, but constitutes "prima facie evidence of notice of protection."

In its Notice of Inquiry, the Copyright Office asked whether the general standard applied to the copyright notice in § 201.20(c)(1) of 37 CFR should also be applied to the mask work notice.⁴ It noted that, in applying this standard to mask works, the acceptability of a notice would vary depending upon the nature of the material object in which the work was fixed. Although a mask work must be fixed in a semiconductor chip product to secure protection under section 902(a) of the Act, the work might later be infringed in a different form.

SIA urged the Copyright Office to specify, by regulation, methods of affixation and placement of the mask⁵ notice on semiconductor chip products; the requirements could later be expanded to include other forms such as magnetic tapes or disks. They asked the Office not to make any special provision for the situation where a notice is placed on either the container for a chip or the chip itself, and the work is later inserted in the ignition of an automobile or some other product. There was concern that, if

⁴ Section 201.20(c)(1) provides that "the acceptability of a notice depends upon its being permanently legible to an ordinary user of the work under normal conditions of use, and affixed to the copies in such manner and position that, when affixed, it is not concealed from view upon reasonable examination." 37 CFR 201.20(c)(1) (1984).

⁵Error; line should read:
"affixation and placement of the mask work"

the words "concealed from view" in the general copyright standard were applied to a mask work notice in such a case, the notice would not be acceptable.

In setting a general standard of acceptability for a mask work notice in § 211.6(a) of its regulations, the Copyright Office requires generally that a mask work notice be legible under normal conditions of use, and "affixed in such manner and position that, when affixed, it may be viewed upon reasonable examination." No reference is made to "ordinary user" or "concealed from view." The Office agreed with SIA that this language should not apply in the case of a mask work notice.

The Copyright Office decided to follow the recommendations of SIA on the acceptable locations for the affixation and placement of a mask work notice fixed in a semiconductor chip product. Although it may become necessary to prescribe methods of affixation and placement of a notice where mask works are fixed in other forms, the Office did not think such a provision was required at this time.

(b) *Combined Copyright and Mask Work Notice.* SIA asked that the Copyright Office by regulation specifically authorize use of a combined copyright and mask work form of notice on semiconductor chip products in the case where one entity is the mask work owner and the owner of copyright in copyrightable subject matter embodied in a chip product.

The Copyright Office declines to adopt this suggestion because of concerns about possible confusion between copyright and mask work protection and doubts about the number of instances in which both claims can properly be made by one entity in different aspects of a semiconductor chip product. Of course, the Copyright Office does not have the authority to prohibit use of a combined notice, if the claimant believes such a notice satisfies the separate requirements of the Copyright Act and the Semiconductor Chip Protection Act.

(c) *Form of Notice.* This regulation is issued before the official public law print of the Semiconductor Chip Protection Act is available. In specifying the form of the mask work notice, the Office has followed the form of the notice in H.R. 6163 as it was passed by the House of Representatives on October 9, 1984.

6. *Recordation.* Section 903(c) provides that "[a]ny document pertaining to a mask work may be recorded in the Copyright Office if the document filed for recordation bears the

actual signature of the person who executed it, or if it is accompanied by a sworn or official certification that it is a true copy of the original, signed document." Since this language tracks the language of the comparable provision in the Copyright Act, the Office in these regulations has simply provided that the existing copyright regulation, 37 CFR 201.4, shall also apply, as appropriate, to recordation of mask work documents.

As a preliminary matter, the Office believes that documents pertaining to mask works should be recorded even if executed before registration or first commercial exploitation. The document would cover any inchoate or contingent rights. The Office is not inclined however to record documents relating to mask works commercially exploited before July 1, 1983, since no inchoate or contingent mask work rights would seem to exist. We have not however issued specific regulations, and invite public comment on both points.

7. *Publication of registrations and other actions taken by the Copyright Office.* Most commentators urged the Copyright Office not to reproduce and publish the complete record of a registration, including any forms and identifying material. It was felt that the costs involved were not justified.

In light of the comments received, and its own experience in administering the copyright law, the Copyright Office decided generally to handle any information or materials submitted under the Semiconductor Chip Protection Act of 1984 in the same way it processes copyright information and deposits. It concluded that a new regulation specifying different procedures for mask works was not required.

8. *Interim Effect and Regulatory Flexibility Act Statement.* These regulations are issued on an emergency basis and given interim effect since the 60-day period between enactment and implementation of the registration-recordation provisions has not been sufficient to give notice of a hearing, conduct a hearing, evaluate the comments, and issue proposed regulations with a 30-day comment period and subsequent evaluation of the comments. The Office does invite public comments before the regulations are made final.

With respect to the Regulatory Flexibility Act, the Copyright Office takes the position this Act does not apply to Copyright Office rulemaking. The Copyright Office is a department of the Library of Congress and is part of the legislative branch. Neither the

Library of Congress nor the Copyright Office is an "agency" within the meaning of the Administrative Procedure Act of June 11, 1946, as amended (title 5, Chapter 5 of the U.S. Code, Subchapter II and Chapter 7). The Regulatory Flexibility Act consequently does not apply to the Copyright Office since that Act affects only those entities of the Federal Government that are agencies as defined in the Administrative Procedure Act.⁵

Alternatively, if it is later determined by a court of competent jurisdiction that the Copyright Office is an "agency" subject to the Regulatory Flexibility Act, the Register of Copyrights has determined that this interim regulation will have no significant impact on small businesses.

List of Subjects in 37 CFR Part 211

Mask works, Semiconductor chip products.

Interim Regulations

In consideration of the foregoing, Chapter II of 37 CFR is amended in the manner set forth below.

PARTS 205-210—[RESERVED]

1. Parts 205-210 are reserved.
2. A new Part 211 is added to 37 CFR Ch. II as follows:

PART 211—MASK WORK PROTECTION

Sec.

- 211.1 General provisions.
- 211.2 Recordation documents pertaining to mask works.
- 211.3 Mask work fees.
- 211.4 Registration of claims of protection in mask works.
- 211.5 Deposit of identifying material.
- 211.6 Methods of affixation and placement of mask work notice.

Authority: 17 U.S.C.—702; 908.

§ 211.1 General provisions.

(a) Mail and other communications with the Copyright Office concerning the Semiconductor Chip Protection Act of 1984, Pub. L. 98-620, chapter 9 of Title 17 U.S.C., shall be addressed to: Library of Congress, Department MW, Washington, D.C. 20540.

⁵ The Copyright Office was not subject to the Administrative Procedure Act before 1978, and it is now subject to it only in areas specified by section 701(b), of the Copyright Act (i.e., "all actions taken by the Register of Copyrights under this title [17], except with respect to the making of copies of copyright deposits). [17 U.S.C. 706(b)]. The Copyright Act does not make the Office an "agency" as defined in the Administrative Procedure Act. For example, personnel actions taken by the Office are not subject to APA-FOI requirements.

(b) Section 201.2 of this chapter relating to the information given by the Copyright Office, and Parts 203 and 204 of this chapter pertaining to the Freedom of Information Act and the Privacy Act, shall apply, where appropriate, to the administration by the Copyright Office of the Semiconductor Chip Protection Act of 1984, Pub. L. 98-620.

(c) For purposes of this part, the terms "semiconductor chip product," "mask work," "fixed," "commercially exploited," and "owner," shall have the meanings set forth in section 901 of Title 17 U.S.C.

§ 211.2 Recordation of documents pertaining to mask works.

The conditions prescribed in § 201.4 of this chapter for recordation of transfers of copyright ownership and other documents pertaining to copyright are applicable to the recordation of documents pertaining to mask works under section 903 of Title 17 U.S.C.

§ 211.3 Mask work fees.

(a) The following fees or charges are established by the Register of Copyrights for services relating to mask works:

- (a) For filing an application for registration of a mask work claim....\$20.00
- (b) For recordation of a document consisting of six pages or less covering no more than one title.....\$10.00
- (c) For recordation of each page over six and each title over one.....\$.50
- (d) For a certified copy of a certificate of registration.....\$4.00
- (e) For certifications of photocopies of other Copyright Office records.....\$4.00
- (f) For the issuance of a receipt of a deposit.....\$2.00
- (g) For each hour or fraction of an hour consumed in the making and reporting of a routine search, and for any related services.....\$10.00
- (h) For special handling of an application for registration of a claim.....\$200.00
- (i) For any special services not listed above requiring a substantial amount of time or expense, the fees will be fixed on the basis of the cost of providing the service.....

(b) Section 201.6 of this chapter on the payment and refund of Copyright Office fees shall apply to mask work fees.

§ 211.4 Registration of claims of protection in mask works.

(a) *General.* This section prescribes conditions for the registration of claims of protection in mask works pursuant to section 908 of Title 17 U.S.C.

(b) *Application for registration.* (1) For purposes of registration of mask work claims, the Register of Copyrights has designated "Form MW" to be used for all applications submitted on and after

January 7, 1985. Copies of the form are available free upon request to the Public Information Office, U.S. Copyright Office, Library of Congress, Washington, D.C. 20559. Applications submitted before January 7, 1985 will be held and dated January 7, 1985.

(2) An application for registration of a mask work claim may be submitted by the owner of the mask work, or the duly authorized agent of any such owner.

(i) The owner of a mask work includes a party that has obtained the transfer of all of the exclusive rights in the work, but does not include the transferee of less than all of the exclusive rights, or the licensee of all or less than all of these rights.

(ii) For purposes of eligibility to claim mask work protection pursuant to section 902(a)(1)(A) of 17 U.S.C., the owner of the mask work must be either the initial owner or a person who has obtained by transfer the totality of rights in the mask work.

(3) An application for registration shall be submitted on Form MW prescribed by the Register under paragraph (b)(1) of this section, and shall be accompanied by the registration fee and deposit required under 17 U.S.C. 908 and §§ 211.3 and 211.5 of these regulations. The application shall contain the information required by the form and its accompanying instructions, and shall include a certification. The certification shall consist of: (i) A declaration that the applicant is authorized to submit the application and that the statements made are correct to the best of that person's knowledge; and (ii) the handwritten signature of the applicant, accompanied by the typed or printed name of that person.

(c) *One registration per mask work.* As a general rule only one registration can be made for the same version of a mask work fixed in an intermediate or final form of any semiconductor chip product. However, where an applicant for registration alleges that an earlier registration for the same version of the work is unauthorized and legally invalid and submits for recordation a signed affidavit, a registration may be made in the applicant's name.

(d) *Registration as a single work.* For purposes of registration on a single application and upon payment of a single registration fee, the following shall be considered a single mask work:

(1) In the case of a mask work that has not been commercially exploited: all elements of the mask work fixed in a particular form of a semiconductor chip product at the time an application for registration is filed and in which the

⁶ Error; line should read:
" 211.2 Recordation of documents pertaining to"

⁷ Error; line should read:
"701(d), of the Copyright Act (i.e., "all actions taken"

owner or owners of the mask work is the same; and

(2) In the case of a mask work that has been commercially exploited: All elements of the mask work fixed in a semiconductor chip product at the time that product was first commercially exploited and in which the owner or owners of the mask work is the same.

(e) *Fixation in intermediate form.* (1) In the case of a mask work fixed in an intermediate form of a semiconductor chip product, registration may be considered provided the applicant avers at Space 2 of Form MW:

(i) That fixation has occurred solely in the intermediate form; and

(ii) That the intermediate form represents twenty per cent or more of the intended final form of the semiconductor chip product.

(2) Registration will be refused for the mask work as fixed in an intermediate form if fixation in a final form of a semiconductor chip product has occurred before registration is sought, or if the intermediate form comprises less than twenty per cent of the intended final form of the semiconductor chip product.

(f) *Section 914 Orders.* (1) For purposes of this section, the terms "Commissioner" and "Order" shall have the meaning given them in the *Guidelines for the Submission of Applications for Interim Protection of Mask Works under 17 U.S.C. 914* (49 F.R. 44517; Nov. 7, 1984).

(2) In the case of a mask work which is eligible for registration only after issuance of an Order of the Commissioner pursuant to section 914, 17 U.S.C., applications for registration under section 908 may be submitted, along with the proper identifying material and fee, if a request for issuance of an Order has been made in accordance with the *Guidelines*. The Copyright Office will process and examine the claims, but will not issue a certificate of registration unless and until an Order is issued pursuant to 17 U.S.C. 914.

(3) The effective date of any registration premised on a section 914, 17 U.S.C. Order shall not be earlier than the effective date of the Order.

(4) Registration premised on a section 914, 17 U.S.C. Order will be refused unless a proper application, deposit of identifying material, and fee are received in the Copyright Office and the Order is issued before:

(i) July 1, 1985, in the case of mask works first commercially exploited between July 1, 1983 and November 8, 1984; or

(ii) the expiration of two years following first commercial exploitation,

in the case of a mask work first commercially exploited on or after November 8, 1984.

(5) Subject to paragraph (e)(4) of this section, registration of a claim premised on a section 914, 17 U.S.C. Order will be made even after the termination or expiration of an Order, provided that a proper application, deposit of identifying material, and fee are received in the Copyright Office while the Order is in effect, and the claim is otherwise entitled to registration under chapter 9 of Title 17 U.S.C.

(g) *Corrections amplifications of prior registration.* Except for errors or omissions made by the Copyright Office, no corrections or amplifications can be made to the information contained in the record of a completed registration after the effective date of the registration. A document purporting to correct or amplify the information in a completed registration record may be recorded in the Copyright Office for whatever effect a court of competent jurisdiction may later give to it, if the document is signed by the owner of the mask work, as identified in the registration record, or by a duly authorized agent of the owner.

§ 211.5 Deposit of identifying material.

(a) *General.* This section prescribes rules pertaining to the deposit of identifying material for registration of a claim of protection in a mask work under section 908 of Title 17 U.S.C.

(b) *Nature of required deposit.* Subject to the provisions of paragraph (c) of this section, the deposit of identifying material to accompany an application for registration of a mask work claim under § 211.4 of these regulations shall consist of:

(1) In the case of a commercially exploited mask work, four reproductions of the mask work fixed in the form of the semiconductor chip product in which it was first commercially exploited. The four reproductions shall be accompanied by a visually perceptible representation of each layer of the mask work consisting of: (i) Sets of plastic color overlay sheets; (ii) drawings or plots in composite form on a single sheet or on separate sheets; or (iii) a photograph of each layer of the work fixed in a semiconductor chip product. The visually perceptible representation of a mask work deposited under this section shall, to the extent possible, be reproduced on material that is 8½ x 11 inches in size, and shall be produced at 20 to 30 times magnification of the actual size of the work;

(2) In the case of a mask work that has not been commercially exploited, a visually perceptible representation of

the work in accordance with paragraph (b)(1) (i) or (ii) of this section.

(c) *Trade secret protection.* Where specific layers of a mask work fixed in a semiconductor chip product contain information in which trade secret protection is asserted, certain material may be withheld as follows: (i) For commercially exploited mask works, no more than two layers of a five or more layer mask work; (ii) for mask works not commercially exploited, any layer. In lieu of the visually perceptible representations required under paragraph (b) (1) and (2) of this section, identifying portions of the withheld material must be submitted. For these purposes, "identifying portions" shall mean a printout of the mask work design data pertaining to each withheld layer, reproduced in microform. In the case of a mask work that has not been commercially exploited, the identifying portions shall be accompanied by a single photograph of the top or other visible layers of the mask work fixed in a semiconductor chip product. Sensitive information maintained under a claim of trade secrecy may be blocked out or stripped from the identifying portions.

(d) *Special relief.* The Register of Copyrights may decide to grant special relief from the deposit requirements of this section, and shall determine the conditions under which special relief is to be granted. Requests for special relief under this paragraph shall be made in writing to the Chief, Examining Division of the Copyright Office, Washington, D.C. 20559, shall be signed by the person signing the application for registration, shall set forth specific reasons why the request should be granted and shall propose an alternative form of deposit.

(e) *Retention and disposition of deposits.* (1) Any identifying material deposited under this section, including material deposited in connection with claims that have been refused registration, are the property of the United States Government.

(2) Where a claim of protection in a mask work is registered in the Copyright Office, the identifying material deposited in connection with the claim shall be retained under the control of the Copyright Office, including retention in Government storage facilities, during the period of protection. After that period, it is within the joint discretion of the Register of Copyright and the Librarian of Congress to order its destruction or other disposition.

§ 211.6 Methods of affixation and placement of mask work notice.

(a) *General.* (1) This section specifies methods of affixation and placement of

the mask work notice that will satisfy the notice requirement in section 909 of Title 17 U.S.C. A notice deemed "acceptable" under this regulation shall be considered to satisfy the requirement of that section that it be affixed "in such manner and location as to give reasonable notice" of protection. As provided in that section, the examples specified in this regulation shall not be considered exhaustive of the methods of affixation and positions giving reasonable notice of the claim of protection in a mask work.

(2) The acceptability of a mask work notice under these regulations shall depend upon its being legible under normal conditions of use, and affixed in such manner and position that, when

affixed, it may be viewed upon reasonable examination.

(b) *Elements of mask work notice.* The elements of a mask work notice shall consist of:

(1) The words "mask work", the symbol "* M *," or the symbol " M " (the letter M in a circle); and

(2) the name of the owner or owners of the mask work or an abbreviation by which the name is recognized or is generally known.

(c) *Methods of affixation and placement of the notice.* In the case of a mask work fixed in a semiconductor chip product, the following locations are acceptable:

(1) A gummed or other label securely affixed or imprinted upon the package

or other container used as a permanent receptacle of the product; or

(2) A notice imprinted or otherwise affixed in or on the top or other visible layer of the product.

(17 U.S.C. 702; 908)

Dated: December 27, 1984.

Dorothy Schrader,

Associate Register of Copyrights for Legal Affairs.

Approved by:

Daniel J. Boorstin,

The Librarian of Congress.

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