

## MASK WORKS

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## MASK WORKS

### 1201 What This Chapter Covers

This Chapter covers issues related to the examination and registration of **mask works** fixed in semiconductor chip products (referred to as “mask works”). Mask works are protected pursuant to the Semiconductor Chip Protection Act (“SCPA”) of 1984, **17 U.S.C. §§ 901-14**, as implemented in **Chapter 9** of the Copyright Act.

### 1202 What Is a Mask Work?

A “mask work” is “a series of related images, however fixed or encoded — (A) having or representing the predetermined, three-dimensional pattern of metallic, insulating, or semiconductor material present or removed from the layers of a semiconductor chip product; and (B) in which series the relation of the images to one another is that each image has the pattern of the surface of one form of the semiconductor chip product.” **17 U.S.C. § 901(a)(2)**.

### 1203 Mask Work Protection Distinguished from Copyright Protection

Mask works are not protected by copyright law. Instead, Congress enacted the SCPA to provide **sui generis** protection for mask works. The legal requirements for mask work protection differ from those for copyright protection in terms of eligibility, ownership rights, registration procedures, term, and remedies for rights violations.

### 1204 Protectable Mask Works

A mask work is protectable under **Chapter 9** of the Copyright Act if it (i) is fixed in a semiconductor chip product, (ii) contains protectable expression, (iii) is original, (iv) meets the required criteria for eligibility, and (v) is registered. **17 U.S.C. § 902**.

#### 1204.1 Fixation in a Semiconductor Chip Product

One required element for protection of a mask work is that the mask work must be fixed in a semiconductor chip product. A mask work is “fixed” in a semiconductor chip product “when its embodiment in the product is sufficiently permanent or stable to permit the mask work to be perceived or reproduced from the product for a period of more than transitory duration.” **17 U.S.C. § 901(a)(3)**.

A “semiconductor chip product” is defined as “the final or intermediate form of any product — (A) having two or more layers of metallic, insulating, or semiconductor material, deposited or otherwise placed on or etched away or otherwise removed from, a piece of semiconductor

material in accordance with a predetermined pattern; and (B) intended to perform electronic circuitry functions.” 17 U.S.C. § 901(a)(1).

## 1204.2 Originality

A mask work must be original to be protectable. The House Report on the Semiconductor Chip Protection Act of 1984 provides that a mask work is “original” if it is the independent creation of an author and was not copied from another source. H.R. Rep. No. 98-781, at 17 (1984). The mask work cannot consist solely of “designs that are staple, commonplace, or familiar in the semiconductor industry, or variations of such designs, combined in a way that, considered as a whole, is not original.” 17 U.S.C. § 902(b)(2).

## 1204.3 Protectable Expression

A mask work must contain protectable expression. Protectable expression in a mask work extends to the three-dimensional images or patterns formed on or in the layers of metallic, insulating, or semiconductor material and fixed in a semiconductor chip product, *i.e.*, the “topography” of the “chip.”

Although these images or patterns are purely functional features, they are nevertheless protected, provided that a mask work is neither dictated by a particular electronic function nor results from one of only a few available design choices that will accomplish that function.

Protection for mask works does not “extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery” associated with a mask work, “regardless of the form in which it is described, explained, illustrated, or embodied in such work.” 17 U.S.C. § 902(c).

## 1204.4 Eligibility Based on Nationality of Owner or Nation of First Commercial Exploitation

Any original mask work fixed in a semiconductor chip product by or under the authority of the mask work owner is eligible for protection if it meets one of the following criteria:

1. On the date the mask work is registered with the U.S. Copyright Office or the date the mask work is first commercially exploited anywhere in the world, whichever occurs first, the owner of the mask work is:
  - A national or domiciliary of the United States; or
  - A national, domiciliary, or sovereign authority of a foreign nation that is a party with the United States to a treaty affording protection to mask works; or
  - A stateless person;
2. The mask work is first commercially exploited in the United States; or
3. The mask work comes within the scope of a Presidential proclamation extending protection to mask works of nationals and domiciliaries of a foreign country and to works first

commercially exploited in that country, on the basis of a finding that mask works protected under [Chapter 9](#) of the U.S. Copyright Act are also protected in the particular foreign country, either under the principle of reciprocity or under the principle of national treatment.

[17 U.S.C. § 902\(a\)](#).

To “commercially exploit” a mask work means “to distribute to the public for commercial purposes a semiconductor chip product embodying the mask work; except that the term includes an offer to sell or transfer a semiconductor chip product only when the offer is in writing and occurs after the mask work is fixed in the semiconductor chip product.” [17 U.S.C. § 901\(a\)\(5\)](#).

**NOTE:** All countries that are members of the World Trade Organization (“WTO”) became eligible for mask work protection on June 1, 1996, under Presidential Proclamation 6780, which was issued on March 23, 1995. Additionally, that proclamation extended mask work protection to Australia, Canada, Japan, Switzerland, and the member states of the European Community as of July 1, 1995. *See* Proclamation No. 6780, 60 Fed. Reg. 15,844 (Mar. 27, 1995). A complete and current list of WTO members is maintained on the WTO’s [website](#).

## 1204.5 Registration

Applicants must register a claim in a mask work to secure the protections discussed below in Section [1207](#). For detailed information on how to register a claim in a mask work see Sections [1210](#) through [1214](#) below.

### 1204.5(A) Registration Required Within Two Years of First Commercial Exploitation

To secure protection of a mask work for the entire ten-year term, owners must register their works with the U.S. Copyright Office within two years of the date on which the mask work is first commercially exploited, otherwise protection will be lost. [17 U.S.C. § 908\(a\)](#). For example, a claim in a mask work that was first commercially exploited on March 15, 2013 must be received in the U.S. Copyright Office prior to or on March 15, 2015 in order to be protected.

### 1204.5(B) Effective Date of Registration

The effective date of registration of a claim to protection in a mask work is the date on which an acceptable application, **deposit** of identifying material, and appropriate **filing fee** are received in the U.S. Copyright Office. [17 U.S.C. § 908\(e\)](#).

### 1204.5(C) Benefits of Registration

In addition to providing the protection discussed below in Section [1207](#), registration of a claim in a mask work provides the following benefits:

- A **certificate of registration** for a mask work issued by the U.S. Copyright Office constitutes *prima facie* evidence of the facts stated in the certificate and that the applicant has met the requirements for protection.

- After a certificate of registration has been issued by the Office, the owner of the mask work or the exclusive licensee of all rights in the mask work may institute a civil action for **infringement** provided the infringement occurred after the commencement of the term of protection.

17 U.S.C. §§ 908(f), 910.

## 1205 Ineligible Mask Works

### 1205.1 *De Minimis* Authorship

Sections 902(b)(1) and (2) of the Act state that protection shall not be available to a mask work that is not original or that consists of designs that are staple, commonplace, or familiar in the semiconductor industry, or variations of such designs, combined in a way that, considered as a whole, is not original. The Office may question applications for mask works that appear to be very simple (consisting of only a few electronic components) if the Nature of Contribution statement or the deposit material indicate that the mask work is unoriginal, staple, commonplace, or familiar. The Office will refuse registration if it is clear from the deposit materials or from statements given in space 8 of the application that the mask work is unoriginal, staple, commonplace, or familiar.

### 1205.2 Claim Received More Than Two Years After the Date of First Commercial Exploitation

As discussed in Section 1204.5(A), protection of a mask work is lost if a claim is not registered within two years of the date of first commercial exploitation of the mask work. Thus, the Office will refuse any claims received more than two years after the date of first exploitation. The Office will deem a claim timely received if the Office receives an acceptable completed application, deposit, and filing fee within the two-year period.

## 1206 Term of Protection

Protection for a mask work commences on the date the mask work is registered with the U.S. Copyright Office or the date that the mask work is first commercially exploited anywhere in the world, whichever occurs first. Protection lasts for ten years (terminating at the end of the tenth calendar year after it began). 17 U.S.C. § 904.

## 1207 Exclusive Rights in Mask Works

During the term of protection, the mask work owner has the following exclusive rights:

- To reproduce the mask work by optical, electronic, or any other means;
- To import or distribute a semiconductor chip product in which the mask work is embodied; and



- To induce or knowingly to cause another person to do any of the acts described immediately above.

17 U.S.C. § 905.

### 1207.1 Limitation on Exclusive Rights: Reverse Engineering

**Chapter 9** permits reverse engineering of a mask work “solely for the purposes of teaching, analyzing, or evaluating the concepts or techniques embodied in the mask work or in the circuitry, logic flow, or organization of components used in the mask work.” The person who performs legitimate reverse engineering can incorporate the results in an original mask work intended for distribution. 17 U.S.C. § 906(a).

### 1207.2 Limitation on Exclusive Rights: First Sale

Purchasers of semiconductor chip products have the right to use and redistribute the chip products freely but not to reproduce the mask works embodied in the semiconductor chip product without the permission of the owner of the rights in the mask work. 17 U.S.C. § 906(b).

### 1208 Ownership in Mask Works

The owner of a mask work is:

- The initial owner of the mask work, or
- The person who has obtained all of the rights in the mask work by transfer.

37 C.F.R. § 211.4(b)(2)(ii).

### 1208.1 Transfer of Ownership and Licensing of Rights in Mask Works

The owner of the exclusive rights in a mask work may transfer all of the rights or license all or fewer than all of the rights. A transfer or license must be in writing and signed by the owner of the rights or by a duly **authorized agent** of the owner. The exclusive rights in a mask work also can be transferred by one of the following:

- Operation of law.
- Terms of a will.
- Intestate succession.

17 U.S.C. § 903(b).

## 1208.2 Recordation of Documents Related to Transfer and Licensing of Rights

Documents related to the transfer of ownership in all of the rights in a mask work, or the licensing of one or more of the rights in a mask work may be recorded with the U.S. Copyright Office. For information on the recordation of documents related to ownership in a mask work, see [Chapter 2300](#), Section 2309.

## 1208.3 Ownership by the U.S. Government and Its Employees

Federal protection does not extend to any mask work created by U.S. government employees as part of their official duties. The U.S. government, however, is not precluded from receiving and holding rights in a mask work. [17 U.S.C. § 903\(d\)](#).


## 1209 Notice

The owner of a protectable mask work may affix a notice of ownership to mask works in a manner and location that gives reasonable notice of the claim to protection. [17 U.S.C. § 909](#).

Notice is not a condition for protection of a mask work, but when properly affixed to a work, will provide *prima facie* evidence of notice of protection. [17 U.S.C. § 909\(a\)](#).

### 1209.1 Content of Notice

To serve as *prima facie* evidence of notice of protection, the form of the notice shall consist of:

- The words “mask work,” the symbol \*M\*, or  (the letter M in a circle); and
- The name of the owner(s) of the rights in the mask work or an abbreviation by which the name is recognized or generally known.

[17 U.S.C. § 909\(b\)](#).

### 1209.2 Location of Notice

The following specific methods of affixation and positions of the notice are acceptable:

- A gummed or other label securely affixed or imprinted upon the package or other container used as a permanent receptacle for the semiconductor chip product; or
- A notice imprinted or otherwise affixed in or on the top or other visible layer of the product.

[37 C.F.R. § 211.6](#).

## 1210 Registration Procedures

Generally, only one registration of a claim is permitted for the same version of a mask work fixed in either (i) an intermediate form of any semiconductor chip product, or (ii) a final form of any semiconductor chip product. [37 C.F.R. § 211.4\(c\)\(1\)](#). Notwithstanding that general rule, owners of mask works that are created by adding metal-connection layers to unpersonalized gate arrays may separately register the entire unpersonalized gate array as well as any custom metallization layers. [37 C.F.R. § 211.4\(c\)\(2\)](#).

### 1210.1 Registration in Most Complete Form Required

Owners seeking registration of a mask work must submit the entire original mask work in its most complete form as fixed in a semiconductor chip product, with the exception of entire unpersonalized gate arrays and custom metallization layers (which may be registered separately). [37 C.F.R. § 211.4\(c\)\(2\)](#). The “most complete form” means the stage of the manufacturing process that is closest to completion. [37 C.F.R. § 211.4\(e\)](#).

### 1210.2 What to File: Required Elements for Registration

Applications to register claims in mask works must contain the following three elements to be considered complete:

- A completed paper application using Form MW;
- A nonrefundable filing fee; and
- A deposit that contains identifying material.

[37 C.F.R. § 211.4\(b\)](#).

#### 1210.2(A) Form MW

Applicants must use Form MW to register a claim in a mask work. This form is available on the U.S. Copyright Office’s [website](#) and for free upon request to the Public Information Office.

Applicants also may request a hard copy Form MW from the U.S. Copyright Office’s Public Information Office by using one of the following forms of contact information:

**BY TELEPHONE:** (202) 707-9100.

**IN PERSON:** James Madison Building, Public Information Office, Room LM-401, Monday through Friday, between the hours of 8:30 AM–5:00 PM Eastern Time, except on federal holidays.

**BY U.S. MAIL:** Library of Congress, U.S. Copyright Office, 101 Independence Avenue SE, Washington, DC 20559-6000.

All forms submitted to the Office must be clear and legible and suitable for automatic feeding through a photocopier. Forms not meeting this requirement will be returned.

For information on completing Form MW and the Office’s practices regarding the examination of the application, see Section 1212 below.

### **1210.2(B) Filing Fee**

The current filing fee is set forth in the Office’s **fee schedule** under the heading “Form MW (mask works).”

For information concerning the methods for paying this filing fee, see **Chapter 1400**, Sections 1413.4 and 1413.5.

### **1210.2(C) Deposit of Identifying Material**

The required deposit for a mask work consists of identifying material (“ID material”). The **Register of Copyrights** has broad authority to specify the identifying material to be deposited in connection with the claim for registration. In recognition of the need to preserve trade secrets or avoid public disclosure of sensitive information embodied in various identifying materials, the Office’s regulations provide different deposit options, depending upon whether the mask work has been commercially exploited and whether the deposit contains trade secret material. The U.S. Copyright Office encourages the fullest disclosure of the mask work within the deposit options established by the regulation. **37 C.F.R. § 211.5**.

For more information on how to prepare the deposit for a mask work, see Section 1213 below.

## **1211 Who May File Form MW?**

An application to register a claim in a mask work may be filed by (i) the owner of the mask work or (ii) her or his authorized agent. **37 C.F.R. § 211.4(b)(2)**.

## **1212 Completing the Application**

This Section provides tips on how to complete each section of Form MW.

### **1212.1 Space 1: Title of this Work**

The title should clearly identify the mask work being claimed.

#### **1212.1(A) Symbols in the Title**

The applicant should provide a title comprised of alphanumeric letters and numbers. Common keyboard symbols may also be accepted, but if the title includes less frequently used symbols, such as Greek letters, the symbols will be identified as “[symbol]” in the record.

**1212.1(B) Descriptive Titles**

Titles that are merely descriptive are acceptable.

*Examples:*

- A title that describes the intended uses of the mask work.
- A title that describes the functions that the mask work performs.

**1212.1(C) Title for More Than One Mask Work Given**

Only one mask work may be registered on a single application form with one set of chips. However, in cases where the mask works are substantially identical (*i.e.*, the differences are *de minimis*), the U.S. Copyright Office will allow applicants to refer to substantially identical mask works in the “Additional Information” space of **Form MW/CON** (a continuation form for Form MW). For example, the applicant may state “Mask work substantially identical to those contained in [titles of other mask works].”

The deposit, however, must be limited to the single mask work identified in space 1 (*i.e.*, only one set of visual representations, and one set of four chips).

**1212.1(D) Variance Between the Title in Space 1 and Titles/Numbers Appearing on the Deposit**

As a general rule, the U.S. Copyright Office will not automatically question variances between the title provided on the application and titles/numbers appearing on the deposit, unless other circumstances suggest an error. Ordinarily, the Office will annotate space 1 with an indication of the title/number appearing on the deposit. If the registration specialist communicates with the applicant for other reasons, however, he or she may ask the applicant to confirm that the correct materials have been deposited.

**1212.2 Space 2: Nature of Deposit**

The applicant should complete this space in all cases by describing what is contained in the deposit material.

*Examples:*

- Composite plot.
- Four chips and composite plot.
- Four chips and seventeen single layer plots.

**1212.2(A) Space 2 Is Blank or Incomplete**

Space 2 asks the applicant to describe the nature of the deposit, *i.e.*, a short description of the object deposited as ID material. If space 2 is blank or incomplete, the registration specialist may

annotate space 2 without contacting the applicant when the nature of the deposit is clear from reviewing the deposit materials.

*Example:*

- If only “plots” appears in space 2, and chips have also been deposited, the registration specialist may annotate space 2 with “and four chips” and space 5 with “Added by Copyright Office.”

#### **1212.2(B) No Numeric Totals Required**

The applicant may identify the number of individual layer plots or semiconductor chip products contained in the ID material (although providing this information is optional). For example, “plots and chips” is an acceptable description.

#### **1212.2(C) Variance in Number of Chips**

If the number of chips deposited differs from the number indicated in space 2, the registration specialist will annotate space 2 with the number actually deposited.

#### **1212.2(D) Chips Deposited for Non-Commercially Exploited Mask Work**

For mask works that have not been commercially exploited, the applicant may include chips in the ID material (although this is optional). Should the applicant choose to deposit chips without stating so on the application, the registration specialist will add this information to space 2 without communicating with the applicant.

#### **1212.2(E) Variance in Number of Plots**

If the deposit contains a different number of plots than is indicated in space 2, the registration specialist will communicate with the applicant.

#### **1212.2(F) Space 2 Refers to a “Composite Plot,” but Individual Layer Plots Deposited (or Vice Versa)**

If the application refers to composite plot(s) and the deposit contains individual layer plot(s) or *vice versa*, and it is clear that the correct plot(s) has been deposited, the registration specialist will annotate space 2 to reflect the correct nature of the deposit.

#### **1212.3 Space 3: Name(s) and Address(es) of Current Owner(s)**

The applicant must provide the name(s) and address(es) of the owner(s) of the mask work. As mentioned in Section 1208, the owner of a mask work is either the initial owner or a person who has obtained all of the exclusive rights in the mask work by transfer. A transferee of less than all of the exclusive rights, or the licensee of all or less than all of these rights, is not considered an owner.

**1212.3(A) Omission of Name of Owner(s)**

If the applicant fails to provide the name of the owner(s) in space 2, the registration specialist will communicate with the applicant to obtain that information, which may delay the examination of the application.

**1212.3(B) Omission of Address**

If the applicant fails to provide an address in space 2, but provides an address in spaces 9 or 12, and it is reasonable to assume that it is the current owner's address, the registration specialist may accept the application. If there is any doubt that the current owner's address appears elsewhere on the application, the registration specialist will communicate with the applicant to verify the correct address and may annotate space 3 with the correct information.

**1212.3(C) More Than One Current Owner in Space 3**

More than one owner may be identified in space 3, but the information must be clear and complete. If the names are not clearly separated or are otherwise incomplete, the registration specialist will communicate with the applicant to ascertain the correct information and, if the information is illegible, will ask the applicant to complete a new **Form MW** and **Form MW/CON**.

**1212.4 Space 4: Citizenship or Domicile of Current Owner(s)**

The nation of citizenship or domicile of the current owner(s) provided in space 4 establishes eligibility only if the mask work has not been commercially exploited. If the applicant states that the mask work has been commercially exploited, space 6 or space 7 will determine whether eligibility has been established. For more information on eligibility, see Section **1204.4** above.

**1212.5 Space 5: Derivation of Ownership**

Space 5 provides three boxes, "a (\_\_\_\_)," and "b (\_\_\_\_)," and "c (\_\_\_\_)." This space should be completed as follows, depending on the ownership status of the applicant:

- The applicant should check box "a" if the owner is the employer of a person who created the mask work within the scope of his or her employment.
- The applicant should check box "b" if the owner acquired the rights by transfer from the creator, employer or legal representative.
- The applicant should check box "c" if the owner is the legal representative of the deceased or legally incapacitated creator.

**1212.5(A) Neither Box "a" Nor "b" Is Checked**

It is acceptable to leave space 5 blank only if the current owner is a living individual who created the mask work, *i.e.*, not a legal entity or deceased person. If the owner acquired ownership as

the employer of the creator or by transfer from the original owner, the applicant must check box “a” and/or box “b.”

#### **1212.5(B) Both Boxes “a” and “b” Are Checked**

Both boxes “a” and “b” may be correctly checked if the owner acquired the rights to the mask work by transfer (box “b”) and then modified the work (box “a”), or if the owner developed the mask work in association with another entity and the other entity transferred its rights to the owner identified in the application.

#### **1212.5(C) Acquisition of Rights by Transfer (Box “b”)**

Box “b” should be checked if ownership was obtained by a written transfer. To be effective, a transfer of a mask work must be by a written instrument that has been signed by the owner or the owner’s authorized agent. [17 U.S.C. § 903\(b\)](#). The U.S. Copyright Office does not require the applicant to deposit the document of transfer, although the applicant may record the document with the Office. For more information on recordation, see [Chapter 2300](#), Section 2309.

### **1212.6 Space 6: Date and Nation of First Commercial Exploitation**

If the mask work has been commercially exploited, then the applicant must provide the complete date of first commercial exploitation in space 6. If the applicant has left space 6 blank, the registration specialist may communicate with the applicant to determine whether the mask work has been commercially exploited and will amend and annotate space 6, as appropriate, which will delay the examination of the application.

As discussed in Section [1205.2](#), a claim received more than two years from the date of first commercial exploitation is ineligible for registration. If, however, the two-year period ends on a day on which the U.S. Copyright Office does not receive mail (*e.g.*, a Sunday or government holiday), the two-year period is extended to the next business day.

#### **1212.6(A) Incomplete Date of First Commercial Exploitation**

Applicants must provide a complete date of first commercial exploitation (month, day, and year). An approximation is acceptable so long as it is complete. To be acceptable, a complete approximate date should be prefaced by one of the following statements:

- On or about
- Approximately
- No later than
- No earlier than



**1212.6(B) Date but No Nation Provided**

If the first commercial exploitation of the mask work has occurred, the applicant must provide the nation of first commercial exploitation to establish eligibility.

**1212.6(C) Nation but No Date Provided**

If the applicant provides a nation of first commercial exploitation without providing a date of first commercial exploitation, the U.S. Copyright Office will communicate with the applicant to determine whether first commercial exploitation has occurred.

**1212.6(D) Future Date of First Commercial Exploitation**

If the applicant provides a date of commercial exploitation that is later than the date on which the claim was received by the U.S. Copyright Office, the registration specialist will communicate with the applicant to clarify the facts of exploitation. If the date has passed and is confirmed to be correct, the specialist will annotate the application to state that the date has been confirmed. If first commercial exploitation has occurred, but on a different date, the specialist will correct the date and annotate the application accordingly. If the mask work has not yet been commercially exploited, the specialist will delete the date and nation of first commercial exploitation and annotate the application accordingly.

**1212.6(E) Applicant Left Space 6 Blank, but Completed Space 7**

If space 6 is incomplete or blank but space 7 is complete, the registration specialist will communicate with the applicant to determine whether the mask work has been commercially exploited. The specialist will amend and annotate space 6 or 7 to reflect, as appropriate, the accurate information.

**1212.7 Space 7: Citizenship or Domicile of Owner at the Time of First Commercial Exploitation**

An applicant should complete this space only if eligibility has not been, or cannot be, established in Space 4 (Citizenship or Domicile of Current Owner), or Space 6 (Nation of First Commercial Exploitation). For more information on eligibility see Section [1204.4](#) above.

**1212.8 Space 8: Nature of Contribution**

Applicants must complete this space. The applicant should describe the new, original contribution to the mask work made by the claimed owner. In addition, the applicant should identify any preexisting mask work(s) that the mask work being claimed is based on or incorporates. For purposes of registration, a preexisting mask work is a previously commercially exploited or previously registered mask work.

*Examples:*

- Entirely new mask work.
- Revised version of previous registered mask work entitled XYZ500.
- Improved layout of previously exploited Maxi Chip.

**1212.8(A) Description Indicates That the Mask Work Is “Original” or “Entirely New”**

If the mask work is not based on a preexisting mask work, the applicant may state “original” or “entirely new” or the like. The registration specialist will not question such a statement unless information elsewhere in the registration materials suggests otherwise.

**1212.8(B) Mask Work Is Based on or Incorporates a Preexisting Mask Work**

If the mask work for which protection is sought is based on or incorporates a preexisting mask work, the applicant may make note of that in space 8, in addition to stating the new, original contribution that forms the basis of the claim. In such cases, the preexisting mask work may be described simply by the title or previous registration number.

*Examples:*

- Modification of mask work contained in MW 12,348.
- Modification of XJ254.

**1212.8(C) Description Limits the Claim with No Indication of Preexisting Material**

The U.S. Copyright Office’s regulations require applicants to register a single claim in the most complete form of the mask work in existence at the time of registration, so long as the elements claimed are original and have not previously been commercially exploited or previously been registered. Applicants may not divide a single mask work into multiple registrations unless different portions of the mask work were first commercially exploited on different dates. *See* [37 C.F.R. § 211.4\(d\)](#). There is one exception: a 1991 amendment to the regulations permits separate registrations of an unpersonalized gate array and the custom metallization layer(s) despite the existence of a completed final form that combines the two. [37 C.F.R. § 211.4\(c\)\(2\)](#).

**1212.8(D) Description Clearly Presents a Claim in the Functions or Uses of the Semiconductor Chip Product Embodying the Mask Work**

A description of the mask work that clearly presents a claim in the functions or uses of the semiconductor chip product embodying the mask work goes beyond the scope of protection. *See* [17 U.S.C. § 902\(c\)](#). In such cases, the registration specialist will communicate with the applicant to amend space 8 so that it clearly limits the claim to the mask work contained within the chip.

**1212.8(E) Description Contains Technical Terminology**

An applicant can include technical terminology that includes descriptions of functionality in the contribution of authorship statement if it is clear that the applicant is not claiming protection for authorship beyond the scope of mask work protection. See [17 U.S.C. § 902\(c\)](#).

**1212.9 Space 9: Contact Person for Correspondence about the Claim**

In space 9, the applicant should provide the name and address of the person the Office should contact if the registration specialist has questions or concerns regarding the claim. If space 9 is blank or incomplete, the specialist will register the claim if it is otherwise acceptable and there is no need to correspond with the applicant, and if an address is provided in space 12. If no address is provided the registration specialist will communicate with the applicant to obtain the address, which may delay the examination of the application.

**1212.10 Space 11: Certification**

The application must contain a handwritten, typed, or printed signature certifying that the applicant is authorized to submit the application and that the statements made are correct to the best of that person's knowledge. If the signature is handwritten it must be accompanied by the typed or printed name of that person.

A signature anywhere within the boundaries of space 11 is acceptable; signatures outside space 11 are unacceptable.

The applicant may be either the owner of the mask work or the duly authorized agent of the owner. [37 C.F.R. § 211.4\(b\)\(2\)](#).

A certification date is not required. However, if the application provides a certification date later than the receipt date or precedes the date of first commercial exploitation, the registration specialist will communicate with the applicant to confirm the facts stated on the application.

**1212.11 Space 12: Mail Certification To**

Applicants must complete this space to ensure prompt delivery of the certificate of registration. If it is left blank and the U.S. Copyright Office received other claims from the same applicant with space 12 is completed, the registration specialist may add the same address with an annotation and may register the claim without communicating with the applicant. If the address can be determined with certainty from space 4, space 6, or from a cover letter, the specialist may add that address to space 12 with an annotation without communicating with the applicant. Otherwise, the registration specialist will communicate with the applicant to obtain the correct address, provided a telephone number, mailing address, or email address has been given in space 9 of the application.

## 1213 Preparing the Deposit Material

The required deposit material for mask works is identifying material. The required contents of the ID material vary depending on (i) whether the work has been commercially exploited, or (ii) whether the work contains trade secrets.

As stated above in Section 1204.4, commercial exploitation is defined as the distribution of a semiconductor chip product embodying a mask work to the public for commercial purposes. The term includes an offer to sell or transfer the mask work when the offer is in writing and occurs after the mask work is fixed in the semiconductor chip product. 17 U.S.C. § 901(a)(5).

Where an applicant makes a claim that the identifying materials normally required to be deposited contain information that is subject to trade secret protection, certain material may be withheld from the deposit of identifying material.

A discussion of identifying material for commercially exploited mask works containing trade secrets is set forth in Section 1213.2 below. A discussion of identifying material for mask works that have not been commercially exploited but contain trade secret material is set forth in Section 1213.4 below.

All visually perceptible representations should be reproduced at a magnification sufficient to reveal the basic circuitry design of the mask work and should be at least twenty times the actual size. Poor resolution plots will be questioned, which could delay the effective date of registration. Large visually perceptible materials are acceptable if they can be folded or cut into a roughly 8½ inches by 11 inches format and are storable in a 12 inches by 15 inches envelope.

Titles should be placed on all identifying materials so that applications and deposit materials can be matched.

### 1213.1 ID Material for Commercially Exploited Mask Works

For a commercially exploited mask work, the applicant is required to submit the following as identifying material:

- Four chips (dies) as first commercially exploited; and
- One full set of visually perceptible representations of each layer of the mask work.

37 C.F.R. § 211.5(b)(1). The U.S. Copyright Office will accept the deposit of loose chips in plastic containers or plastic bags, defective chips (commonly marked with a dot on the surface of the chip), and chips in pronged housings. The Office will not accept the deposit of chips in wafer format. Chips that do not appear to be integrated into a semiconductor substrate will be questioned.

Regarding the visually perceptible representations, the applicant may elect to deposit plastic color overlays, composite plots, or photographs of each layer of the mask work, or any combination thereof. *Id.*

### 1213.2 ID Material for Commercially Exploited Mask Works Containing Trade Secrets

If the commercially exploited mask work contains trade secrets, the identifying material should consist of:

- Four chips as first commercially exploited;
- Color overlays, plots, or photographs for all other layers; and
- Special “identifying portions” for no more than two of each of the five layers of the mask work in which trade secrecy is claimed.

Specifically, the identifying portions should consist of (i) a printout of the mask work design data pertaining to each withheld layer, reproduced in microform, or (ii) visually perceptible representations, such as sets of plastic color overlay sheets, drawings or plots in composite form on a single sheet or on separate sheets, or photographs of each layer of the masks in which portions maintained under a claim of trade secrecy are blocked out, provided that the remaining portions are greater than the blocked out portions. [37 C.F.R. § 211.5\(c\)\(1\)\(i\)-\(ii\)](#).

### 1213.3 ID Material for Mask Works That Have Not Been Commercially Exploited: Mask Work Contains More Than Twenty Percent of Intended Final Form

If a mask work has not been commercially exploited and if the contribution in which registration is sought represents twenty percent or more of the area of the intended final form, the applicant is required to submit one full set of either plastic color overlays or composite plots of each layer of the semiconductor chip product. In addition, the applicant may deposit up to four representations of the most complete form as fixed in a chip product, although chips (dies) are not required for registration. [37 C.F.R. § 211.5\(b\)\(2\)\(i\)](#).

**NOTE:** Regarding the visually perceptible representations, the applicant may elect to deposit plastic color overlays, composite plots, or photographs of each layer of the mask work, and any combination thereof.

### 1213.4 Mask Works Not Commercially Exploited Containing Trade Secrets

If a mask work that has not been commercially exploited contains trade secrets, the ID material should consist of:

- A single photograph of the top or other visible layers of the mask work with the sensitive information maintained under a claim of trade secrecy blocked out, provided the blocked out portions do not exceed the remaining portions; and
- Special “identifying portions” for any layer or layers in which trade secrecy is claimed.

Specifically, the identifying portions should consist of (i) a printout of the mask work design data pertaining to each withheld layer, reproduced in microform, or (ii) visually perceptible representations (plastic color overlays, composite plots) in which portions maintained under a

claim of trade secrecy are blocked out, provided that the portions remaining are greater than the portions blocked out. [37 C.F.R. § 211.5\(c\)\(2\)\(i\)\(A\)-\(B\), \(ii\)](#).

### **1213.5 Mask Works Not Commercially Exploited: Mask Work Contains Less Than Twenty Percent of Intended Final Form**

Where the mask work for which registration is sought represents less than twenty percent of the area of the intended final form of the chip product, the deposit must include a visually perceptible representation of the work that reveals the totality of the mask work contribution to a person trained in the state of the art. The representation may consist of any combination of the following:

- Plastic color overlay sheets.
- Drawings or plots in composite form.
- Photograph(s) of the entire mask set.

If needed, additional explanatory material may accompany the visually perceptible representation to identify all the elements in the mask work contribution. [37 C.F.R. § 211.5\(b\)\(2\)\(i\)](#).

### **1213.6 Special Relief from Deposit Requirements for Mask Works**

On a case-by-case basis, the Register of Copyrights may decide to grant **special relief** from the deposit requirements. Requests for special relief must be made in writing to:

Associate Register of Copyrights and Director of Registration Policy & Practice  
U.S. Copyright Office  
P.O. Box 70400  
Washington, DC 20024-0400

The applicant may also send special relief requests by fax to (202) 707-3698.

The request must contain the following:

- The specific reasons why the request should be granted.
- A proposal for an alternative form of deposit.
- The signature of the applicant.

[37 C.F.R. § 211.5\(d\)](#).

### **1213.7 Deposit Retention**

Identifying material deposited to support an application to register a claim in a mask work, whether the claim is registered or refused, becomes the property of the U.S. government. The

U.S. Copyright Office will retain copies of all deposits for registered claims for the entire term of protection. [37 C.F.R. § 211.5\(e\)](#).

#### 1214 Submitting the Application, Filing Fee, and Identifying Material

Applicants may submit Form MW, the filing fee, and the identifying material deposit in person or by U.S. mail, by commercial carrier, such as Federal Express or United Parcel Service, or by courier, to the following addresses:

**BY U.S. MAIL OR COMMERCIAL CARRIER:** Library of Congress, U.S. Copyright Office–MW, 101 Independence Avenue SE, Washington DC 20559.

**IN PERSON:** James Madison Building, Public Information Office, Room LM-401, Monday through Friday, between the hours of 8:30 AM–5:00 PM Eastern Time, except on federal holidays.

**BY COURIER:** Congressional Courier Acceptance Site (CCAS), 2nd and D Streets NE, Washington, DC, between the hours of 8:30 AM–4:30 PM Eastern Time, except on federal holidays.

**NOTE:** Couriers will receive a dated receipt from CCAS rather than the U.S. Copyright Office. The Office will consider the date of receipt at CCAS as the date of receipt in the Office. A courier may deliver up to ten items at a time. Packages accepted at CCAS may not exceed four by fourteen by eighteen inches in size. Larger packages will not be accepted by CCAS. In such cases, the courier will be directed to deliver these packages to the offsite mail processing center.

#### 1215 Special Handling

Expedited processing of an application to register a claim in a mask work is referred to as “**special handling**,” and may be granted at the discretion of the Register of Copyrights in cases involving pending or prospective litigation, customs matters, or contract deadlines. For details, see [Special Handling \(Circular 10\)](#).

#### 1216 Correction or Amplification of a Completed Registration

Except for errors or omissions made by the U.S. Copyright Office, no corrections or amplifications can be made to the information contained in the registration record for a completed mask work registration. In particular, a supplementary registration cannot be used to correct or amplify the information set forth in this type of registration. [37 C.F.R. § 211.4\(f\)](#). If the Office made an error or omission in preparing the certificate, the owner of the mask work should contact the Office in writing using the form posted on the office’s [website](#). If appropriate, the Office will correct the mistake and issue a new certificate to the correspondent named in the certificate.

A document purporting to correct or amplify the information in a completed registration may be recorded in the Office if it is signed by the owner of the mask work or by the owner’s duly authorized agent. [37 C.F.R. § 211.4\(f\)](#). For information on how to record a document, see [Chapter 2300](#), Section 2309.

**1217 Reconsideration of Refusals to Register**

The requirements for reconsideration of refusals to register copyright claims (which are prescribed in [37 C.F.R. § 202.5](#)) apply to requests to reconsider refusals to register claims in mask works. See [Chapter 1700](#) (Administrative Appeals).