

1989 No. 1100

DESIGNS

The Design Right (Semiconductor Topographies)
Regulations 1989

Made - - - - - *29th June 1989*
Coming into force *1st August 1989*

Whereas a draft of the following Regulations has been approved by resolution of each House of Parliament:

Now, therefore, the Secretary of State, being designated(a) for the purposes of section 2(2) of the European Communities Act 1972(b) in relation to the conferment and protection of exclusive rights in the topographies of semiconductor products, in exercise of the powers conferred on him by the said section 2(2) hereby makes the following Regulations:

Citation and commencement

1. These Regulations may be cited as the Design Right (Semiconductor Topographies) Regulations 1989 and shall come into force on 1st August 1989.

Interpretation

2.—(1) In these Regulations—

“the Act” means the Copyright, Designs and Patents Act 1988(c);

“semiconductor product” means an article the purpose, or one of the purposes, of which is the performance of an electronic function and which consists of two or more layers, at least one of which is composed of semiconducting material and in or upon one or more of which is fixed a pattern appertaining to that or another function; and

“semiconductor topography” means a design within the meaning of section 213(2) of the Act which is a design of either of the following:

(a) the pattern fixed, or intended to be fixed, in or upon—

(i) a layer of a semiconductor product, or

(ii) a layer of material in the course of and for the purpose of the manufacture of a semiconductor product, or

(b) the arrangement of the patterns fixed, or intended to be fixed, in or upon the layers of a semiconductor product in relation to one another.

(2) Except where the context otherwise requires, these Regulations shall be construed as one with Part III of the Act (design right).

Application of Copyright, Designs and Patents Act 1988, Part III

3. In its application to a design which is a semiconductor topography, Part III of the Act shall have effect subject to regulations 4 to 9 below.

Qualification

4.—(1) Section 213(5) of the Act has effect subject to paragraphs (2) to (4) below.

(2) Part III of the Act has effect as if for section 217 of the Act there was substituted the following:

“217.—(1) In this Part—

“qualifying individual” means a citizen or subject of, or an individual habitually resident in, a qualifying country; and

“qualifying person” means—

- (a) a qualifying individual,
- (b) a body corporate or other body having legal personality which has in any qualifying country or in Gibraltar a place of business at which substantial business activity is carried on, or
- (c) a person who falls within one of the additional classes set out in Part I of the Schedule to the Design Right (Semiconductor Topographies) Regulations 1989.

(2) References in this Part to a qualifying person include the Crown and the government of any other qualifying country.

(3) In this section “qualifying country” means—

- (a) the United Kingdom, or
- (b) another member State of the European Economic Community.

(4) The reference in the definition of “qualifying individual” to a person’s being a citizen or subject of a qualifying country shall be construed in relation to the United Kingdom as a reference to his being a British citizen.

(5) In determining for the purpose of the definition of “qualifying person” whether substantial business activity is carried on at a place of business in any country, no account shall be taken of dealings in goods which are at all material times outside that country.”.

(3) Where a semiconductor topography is created in pursuance of a commission or in the course of employment and the designer of the topography is, by virtue of section 215 of the Act (as substituted by regulation 5 below), the first owner of design right in that topography, section 219 of the Act does not apply and section 218(2) to (4) of the Act shall apply to the topography as if it had not been created in pursuance of a commission or in the course of employment.

(4) Section 220 of the Act has effect subject to regulation 7 below and as if for subsection (1) there was substituted the following:

“220.—(1) A design which does not qualify for design right protection under section 218 or 219 (as modified by regulation 4(3) of the Design Right (Semiconductor Topographies) Regulations 1989) or under the said regulation 4(3) qualifies for design right protection if the first marketing of articles made to the design—

- (a) is by a qualifying person who is exclusively authorised to put such articles on the market in every member State of the European Economic Community, and
- (b) takes place within the territory of any member State.”;

and subsection (4) of section 220 accordingly has effect as if the words “in the United Kingdom” were omitted.

Ownership of design right

5. Part III of the Act has effect as if for section 215 of the Act there was substituted the following:

“215.—(1) The designer is the first owner of any design right in a design which is not created in pursuance of a commission or in the course of employment.

(2) Where a design is created in pursuance of a commission, the person commissioning the design is the first owner of any design right in it subject to any agreement in writing to the contrary.

(3) Where, in a case not falling within subsection (2) a design is created by an employee in the course of his employment, his employer is the first owner of any design right in the design subject to any agreement in writing to the contrary.

(4) If a design qualifies for design right protection by virtue of section 220 (as modified by regulation 4(4) of the Design Right (Semiconductor Topographies) Regulations 1989), the above rules do not apply and, subject to regulation 7 of the said Regulations, the person by whom the articles in question are marketed is the first owner of the design right.”.

Duration of design right

6.—(1) Part III of the Act has effect as if for section 216 of the Act there was substituted the following:

“ 216. The design right in a semiconductor topography expires—

- (a) ten years from the end of the calendar year in which the topography or articles made to the topography were first made available for sale or hire anywhere in the world by or with the licence of the design right owner, or
- (b) if neither the topography nor articles made to the topography are so made available within a period of fifteen years commencing with the earlier of the time when the topography was first recorded in a design document or the time when an article was first made to the topography, at the end of that period.”.

(2) Subsection (2) of section 263 of the Act has effect as if the words “or a semiconductor topography” were inserted after the words “in relation to an article”.

(3) The substitute provision set out in paragraph (1) above has effect subject to regulation 7 below.

Confidential information

7. In determining, for the purposes of section 215(4), 216 or 220 of the Act (as modified by these Regulations), whether there has been any marketing, or anything has been made available for sale or hire, no account shall be taken of any sale or hire, or any offer or exposure for sale or hire, which is subject to an obligation of confidence in respect of information about the semiconductor topography in question unless either—

- (a) the article or semiconductor topography sold or hired or offered or exposed for sale or hire has been sold or hired on a previous occasion (whether or not subject to an obligation of confidence), or
- (b) the obligation is imposed at the behest of the Crown, or of the government of any country outside the United Kingdom, for the protection of security in connection with the production of arms, munitions or war material.

Infringement

8.—(1) Section 226 of the Act has effect as if for subsection (1) there was substituted the following:

“ 226.—(1) Subject to subsection (1A), the owner of design right in a design has the exclusive right to reproduce the design—

- (a) by making articles to that design, or
- (b) by making a design document recording the design for the purpose of enabling such articles to be made.

(1A) Subsection (1) does not apply to—

- (a) the reproduction of a design privately for non-commercial aims; or
- (b) the reproduction of a design for the purpose of analysing or evaluating the design or analysing, evaluating or teaching the concepts, processes, systems or techniques embodied in it.”.

(2) Section 227 of the Act does not apply if the article in question has previously been sold or hired within—

- (a) the United Kingdom by or with the licence of the owner of design right in the semiconductor topography in question, or
- (b) the territory of any other member State of the European Economic Community or the territory of Gibraltar by or with the consent of the person for the time being entitled to import it into or sell or hire it within that territory.

(3) Section 228(6) of the Act does not apply.

(4) It is not an infringement of design right in a semiconductor topography to—

(a) create another original semiconductor topography as a result of an analysis or evaluation of the first topography or of the concepts, processes, systems or techniques embodied in it, or

(b) reproduce that other topography.

(5) Anything which would be an infringement of the design right in a semiconductor topography if done in relation to the topography as a whole is an infringement of the design right in the topography if done in relation to a substantial part of the topography.

Licences of right

9. Section 237 of the Act does not apply.

Revocation and transitional provisions

10.—(1) The Semiconductor Products (Protection of Topography) Regulations 1987^(a) are hereby revoked.

(2) Sub-paragraph (1) of paragraph 19 of Schedule 1 to the Act shall not apply in respect of a semiconductor topography created between 7th November 1987 and 31st July 1989.

(3) In its application to copyright in a semiconductor topography created before 7th November 1987, sub-paragraph (2) of the said paragraph 19 shall have effect as if the reference to sections 237 to 239 were a reference to sections 238 and 239; and sub-paragraph (3) of that paragraph accordingly shall not apply to such copyright.

29th June 1989

Eric Forth
Parliamentary Under Secretary of State,
Department of Trade and Industry

^(a) S.I. 1987/1497.

SCHEDULE

Regulation 4(2)

ADDITIONAL CLASSES OF QUALIFYING PERSONS

PART I

DESCRIPTIONS OF ADDITIONAL CLASSES

1. British Dependent Territory citizens.
2. Citizens and subjects of any country specified in Part II or III below.
3. Habitual residents of any country specified in Part II or III below, the Isle of Man, the Channel Islands or any colony.
4. Firms and bodies corporate formed under the law of, or of any part of, the United Kingdom, Gibraltar, another member State of the European Economic Community or any country specified in Part II below with a place of business within any country so specified at which substantial business activity is carried on.

PART II

SPECIFIED COUNTRIES: CITIZENS, SUBJECTS, HABITUAL RESIDENTS, BODIES CORPORATE AND OTHER BODIES HAVING LEGAL PERSONALITY

Japan
Switzerland
United States of America

PART III

SPECIFIED COUNTRIES: CITIZENS, SUBJECTS AND HABITUAL RESIDENTS ONLY

Austria
Finland
French overseas territories (French Polynesia; French Southern and Antarctic Territories; Mayotte; New Caledonia and dependencies; Saint-Pierre and Miquelon; Wallis and Futuna Islands)
Iceland
Norway
Sweden

EXPLANATORY NOTE

(This note is not part of the Regulations)

These Regulations revoke and replace the Semiconductor Products (Protection of Topography) Regulations 1987. They implement Council Directive 87/54/EEC (O.J. No. L24, 27.1.1987, p.36) on the legal protection of topographies of semiconductor products and Council Decisions 87/532/EEC (O.J. No. L313, 4.11.1987, p.22) and 88/311/EEC (O.J. No. L140, 7.6.1988, p.13) on the extension of that protection in respect of persons from certain countries and territories. The only change of substance is the implementation of the latter Decision, reflected in Parts II and III of the Schedule to the Regulations.

The 1987 Regulations created topography right and were free-standing. Topography right is now superseded by design right under Part III of the Copyright, Designs and Patents Act 1988, and these Regulations modify the application of that Act in respect of semiconductor topographies to ensure compliance with the Directive and Decisions.

Regulation 4 modifies the requirements which must be complied with for an original semiconductor topography to qualify for design right.

Regulations 5 and 6 modify the rules about first ownership and duration of design right.

Regulation 7 gives effect to the special provisions in the Directive about confidential information.

Regulation 8 modifies the provisions in the Act relating to infringement.

Regulation 9 excludes the provision in the Act for automatic licences of right in the last five years of design right.

Regulation 10 revokes the 1987 Regulations and modifies the transitional provisions of the Act.

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