

Federal Law of June 23, 1988, on the Protection of the Topographies of Microelectronic Semiconductor Products

(Semiconductor Protection Law)*

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* *German title:* Bundesgesetz vom 23. Juni 1988 über den Schutz der Topographien von mikroelektronischen Halbleitererzeugnissen (Halbleiterschutzgesetz–HISchG).

Source: Bundesgesetzblatt für die Republik Österreich (BGBl.), July 15, 1988, p. 2629.

Entry into force: October 1, 1988.

** Added by WIPO.

Subject of Protection

1.–

(1) Protection under this Federal Law may be obtained, upon request, for three-dimensional structures of microelectronic semiconductor products (topographies) if and insofar as they are original (Section 2).

(2) The protection of a topography of a semiconductor product under subsection (1) shall not apply to the concepts, processes, systems, techniques or stored information contained in the topography, but only to the topography as such.

Originality

2.–

(1) A topography shall be original if it is the result of its creator's own intellectual effort and is not commonplace in semiconductor technology.

(2) A topography consisting of an arrangement of portions that are commonplace in themselves shall nevertheless be protected insofar as the arrangement is original as a whole.

Right to Protection

3.–

(1) The right to semiconductor protection shall belong to the creator of the topography.

(2) If the topography has been created in the course of employment or otherwise on commission of another person, the right to semiconductor protection shall belong, where not otherwise agreed, to the employer or the person who has given the commission.

(3) Where the person entitled under subsections (1) or (2) is unable to assert his right for failure to satisfy the requirements of Section 5 and where the topography has not previously been commercially exploited by another person or has only been exploited confidentially, the right shall belong to the person who has received from the entitled person an exclusive authorization to commercially exploit the topography for the first time in the country other than confidentially. Assertion of such right through an application shall cause the right based on subsections (1) and (2) to lapse.

(4) The right to semiconductor protection (subsections (1) to (3)) shall be assignable.

Lapse of Right

4.–

The right shall lapse 15 years after the day of first fixation if the topography has up to that date been neither

1. commercially exploited, other than confidentially, nor
2. filed with the Patent Office.

Assertion of Right

5.–

(1) The right to semiconductor protection (Section 3) may only be asserted by Austrian nationals or by natural persons who have their permanent domicile in the country and by legal entities and associations under commercial law that are not incorporated and that possess a real and effective establishment in the country.

(2) Other persons may only assert a right to semiconductor protection if they possess the nationality of the State that affords persons or firms within the meaning of subsection (1) the same protection or if they have their permanent domicile or a real and effective establishment in such State and reciprocity has been established by international agreement or by order published in the Federal Law Gazette by the Federal Minister for Economic Affairs.

Effect of Protection

6.–

(1) Semiconductor protection shall have the effect that the owner of the right may prohibit others, for commercial purposes, from:

1. reproducing the topography or its independently exploitable portions or producing representations for the manufacture of the topography;
 2. offering, putting on the market or distributing, or importing for such purposes, representations for the manufacture of the topography or a semiconductor product containing the topography or its independently exploitable portions.
- (2) The effect of protection of the topography shall not extend, in particular, to
1. acts done for non-commercial purposes,
 2. reproduction of the topography for the purpose of analysis, evaluation or teaching, or
 3. the commercial exploitation of a topography created on the basis of such analysis or evaluation and which is itself original (Section 2).

7.–

Semiconductor protection shall not have effect with respect to a person who acquires a semiconductor product without knowing or without being assumed to know that it contains a protected topography; as soon as that person knows or is assumed to know that the topography is protected by a semiconductor protection right, he shall be required to pay to the owner of protection, at the latter's demand, for any further commercial exploitation of the previously acquired semiconductor product, an adequate compensation in accordance with the circumstances. The owner of protection shall be entitled to require the rendering of accounts in accordance with Section 151 of the Patent Law 1970 (BGBl. No. 259).¹

Commencement and Duration of Protection

8.–

(1) Protection shall commence on the day of the first commercial exploitation, other than confidential, of the topography, if the latter is filed with the Patent Office within two years or on the day of filing with the Patent Office, if the topography has not been previously exploited commercially, or has only been exploited confidentially.

(2) Protection shall terminate at the latest on expiry of the tenth calendar year after the year of commencement of protection.

(3) Protection can only be enforced once the semiconductor protection right has been entered in the Semiconductor Register.

Application Requirements

9.–

(1) Applications in respect of topographies shall be filed in writing with the Patent Office. A separate application shall be filed for each topography.

¹ See *Industrial Property Laws and Treaties*, AUSTRIA – Text 2-001.

(2) The application shall contain:

1. a request for registration of protection of the topography in the Semiconductor Register and a brief and precise designation thereof (title);
2. materials identifying or illustrating the topography or a combination thereof and, in addition, where appropriate, the semiconductor product itself;
3. the day of first commercial exploitation, other than confidential, of the topography, where such day is earlier than the application; and
4. particulars from which the right to semiconductor protection under Section 3(3) results and particulars concerning the entitlement to assert the right (Section 5).

(3) The request shall be subject to a fee of 3,000 schillings.

(4) The detailed requirements for application as well as the materials to be furnished shall be laid down in a decree issued by the Federal Minister for Economic Affairs, whereby attention shall be paid to introducing provisions that are as effective, speedy, simple and economic as possible and that take into account the needs of the semiconductor industry and the current status of technical development.

Semiconductor Register

10.–

(1) Where the application complies with the requirements of Section 9 and of the decree under that Section, the semiconductor protection right shall be entered in the Semiconductor Register kept by the Patent Office, without further examination.

(2) The Semiconductor Register shall contain the number, title, filing date and, where appropriate, the date of first commercial exploitation, other than confidential, of the topography (Section 9(2)3) as well as the name and place of residence of the owners of protection and of their representatives. The commencement, expiry, nullity, lack of title and transfer of rights of protection, grant of licenses, liens and other rights *in rem*, restoration of rights, declaratory statements and disputes shall also be entered in the Register.

(3) Any person may inspect the Semiconductor Register.

(4) The detailed provisions on the Semiconductor Register shall be laid down in a decree issued by the Federal Minister for Economic Affairs, whereby the maintenance of industrial and business secrets and also the need for public information shall be taken into account.

(5) The materials filed in accordance with Section 9(2)2 and, where appropriate, the semiconductor product itself shall be kept for a period of six years after the end of semiconductor protection. On expiry of this period, the last owner of protection entered in the Semiconductor Register shall be given a time limit to recover the materials and, where appropriate, the semiconductor product. If he does not comply within the time limit, the materials and, where appropriate, the semiconductor product shall be destroyed by the Patent Office.

(6) Where an application does not lead to entry in the Semiconductor Register, the period of storage shall be one year computed from the date on which the refusal decision takes force.

Publication

11.–

Entries in the Semiconductor Register (Section 10(2)) shall be published in the Patent Gazette [*Patentblatt*].

Transfer; Licenses

12.–

(1) A semiconductor protection right may be transferred as a whole or conceptual in shares. It shall be inheritable; it shall not pass to the State.

(2) Any transfer shall be entered in the Semiconductor Register and shall become effective on entry.

(3) License rights may be acquired in respect of a semiconductor right. License rights shall be entered, upon request, in the Semiconductor Register; through the entry they shall be effective also in respect of third parties.

(4) The provisions of Sections 27 and 37 of the Patent Law 1970 shall otherwise apply *mutatis mutandis*.

Declaration of Nullity

13.–

(1) Any person may request that a specifically designated semiconductor right be declared null and void if

1. the protected topography was not protectable (Sections 1 and 2),
2. the right to semiconductor protection under Section 4 had lapsed or the time limit for application (Section 8(1)) had lapsed without use having been made of it,
3. entitlement to assert the right (Section 5) was lacking or subsequently ceased to apply, or
4. the materials under Section 9(2)2 did not correspond to the semiconductor product where filed.

(2) The final declaration of nullity shall be retroactive to the commencement of protection (Section 8(1)); where the declaration of nullity is based on the fact that entitlement to assert the right has ceased to apply (subsection (1)3), the final declaration of nullity shall be retroactive to the time at which the semiconductor right became contestable.

Declaration of Lack of Title

14.–

(1) The owner shall be declared to lack title to the semiconductor right if it is proven that he was not entitled to claim the grant of such right (Section 3).

(2) Only the person having the claim to the protection right shall have a claim to declaration of lack of title in respect of the semiconductor right and such a claim shall become statute-barred against a *bona fide* owner of protection after three years of the date of entry in the Semiconductor Register.

(3) Where the applicant's claim is allowed, he may, within one month of the decision becoming final, request transfer of the semiconductor right to himself, subject to his being entitled to assert the right to semiconductor protection (Section 5).

(4) Failure to request such transfer in good time shall be deemed equivalent to renunciation of the semiconductor right.

Requests for Declaration

15.–

(1) Anyone who commercially exploits a topography, particularly by offering, putting on the market, distributing, or importing for such purposes, a semiconductor product containing a topography, or who intends to carry out such acts, may request the Patent Office to issue a declaration against the owner of a semiconductor right or the exclusive licensee that the topography or the semiconductor product containing such topography is neither in whole nor in part subject to the semiconductor right (Section 6).

(2) The owner of a semiconductor right or the exclusive licensee may request the Patent Office to issue a declaration against anyone who commercially exploits a topography, in particular who offers, puts on the market, distributes, or imports for such purposes, a semiconductor product containing such topography, or who intends to carry out such acts, that the topography or the semiconductor product containing such topography is subject in whole or in part to the semiconductor right (Section 6).

(3) Requests under subsections (1) and (2) shall be refused where the person opposing the request proves that infringement proceedings between the same parties, concerning the same topography, instituted prior to presentation of the request for a declaration are pending before a court (Section 21).

(4) A request for a declaration may only relate to a single semiconductor right. The request must be accompanied by materials within the meaning of Section 9(2)2 and, where appropriate, also by the semiconductor product itself, in four copies. One copy of the materials and, where appropriate, of the semiconductor product shall be attached to the final decision.

(5) In assessing the scope of protection of the semiconductor right that is the subject matter of the declaratory proceeding, the Patent Office shall take into account the state of the art proven by the parties.

(6) Where the behavior of the opposing party has not given reason for the filing of the request and that party has recognized the claim within the period of time stipulated for the reply, the cost of proceedings shall be borne by the requesting party.

Competence

16.–

(1) The Semiconductor Register shall be kept by the Patent Office.

(2) The decision on entry in the Semiconductor Register (Section 10) shall be taken by the technical member competent according to the distribution of responsibilities.

(3) Decisions in matters relating to granted semiconductor rights shall be taken, except where the courts, the Supreme Patent and Trademark Chamber or the Appeals Section or the Nullity Section of the Patent Office are competent, by the legal member of the Legal Section competent according to the distribution of responsibilities.

(4) The Appeals Section and the Nullity Section shall take their decisions composed of three members, one of whom shall preside. The presiding member and one further member must be legally qualified.

(5) Sections 58 to 61 and 74, 75, and 76(1), (4) and (5) of the Patent Law 1970 shall apply.

Procedure

17.–

Where not otherwise stipulated, Sections 52 to 56, 64, 66 to 73, 77 to 79, 82 to 86, 112 to 126, 127(1), (2), (4) and (5), 128, first sentence, 129 to 145, 168 and 169 of the Patent Law 1970 shall apply *mutatis mutandis* to procedure; the procedural fee laid down in Section 132(1)(b) of the Patent Law 1970 shall correspond to the application fee in patent proceedings.

Inspection of Files

18.–

(1) The parties to proceedings shall be entitled to inspect files relating to the proceedings.

(2) Any person may inspect files concerning granted semiconductor rights—with the exception of records of deliberations and those parts of the files relating to internal business—, subject to the following provisions. Such inspection shall also apply to the materials and, where appropriate, to the semiconductor product itself filed with the application under Section 9(2)2, with the proviso, however, that inspection of materials that contain industrial or commercial secrets and have been designated as such by the applicant in the application shall only be granted in nullity, lack of title or declaration proceedings on the instructions of the Nullity Section or in a legal dispute concerning the infringement of the semiconductor right on the instructions of the court, in respect of persons who are party to the nullity, lack of title or declaration proceedings or to the legal dispute. Materials required to identify or illustrate the topography may not be designated as a whole as industrial or commercial secrets.

(3) Secrecy under subsection (2) shall not prevent inspection of files by that person against whom the owner of protection has invoked his right.

Representation

19.–

The provisions of Section 21 of the Patent Law 1970 shall apply to representation in proceedings before the Patent Office and before the Supreme Patent and Trademark Chamber.

Obligation to Furnish Information

20.–

Any person who designates articles in such a way as to create the impression that they enjoy semiconductor protection shall be required, on request, to provide information on the right on which the designation is based.

Infringement of Semiconductor Rights

21.–

(1) Any person who has suffered an infringement of his semiconductor right (Section 6) may take action under Sections 147 to 154 and 164 of the Patent Law 1970, applied *mutatis mutandis*, for injunction, removal, publication of judgment, appropriate compensation, damages, surrender of profit and rendering of accounts. Any person who has reason to suspect such infringement may also institute action for injunction and for publication of judgment.

(2) Injunction orders can be issued even where they do not fulfill the requirements of Section 381 of the Injunctions Code. Where reasonable grounds exist, the court may withdraw an injunction it has issued if the defendant provides adequate security.

22.–

(1) Any person who infringes a semiconductor right (Section 6) shall be condemned by the court to a fine of up to 360 daily amounts.

(2) The same penalty shall be imposed on the owner or director of an enterprise who does not prevent the infringement of a semiconductor right by a person working for him or on his behalf in the course of the activities of the enterprise. Where the owner of the enterprise is a legal entity, this provision shall apply to those organs of the enterprise that have committed such omission. The enterprise shall be jointly and equally liable with the guilty party for the fines inflicted on the organs.

(3) Prosecution shall take place only at the request of the injured party.

(4) In penal proceedings, Sections 160 and 161 of the Patent Law 1970 shall apply *mutatis mutandis*.

Competence

23.–

(1) The Commercial Court of Vienna shall have exclusive jurisdiction for actions and injunctions under this Federal Law. Decisions shall belong to the Chamber (Section 7(2), first sentence, Section 8(2) of the Jurisdictional Rules), irrespective of the value in dispute. This shall also apply to injunctions.

(2) Jurisdiction in criminal matters under this Federal Law shall belong to the Vienna District Court for Criminal Matters [*Landesgericht für Strafsachen Wien*].

Preliminary Questions

24.–

(1) Sections 156 and 157 of the Patent Law 1970 shall apply *mutatis mutandis*, subject to subsection (2), in assessing the validity or effectiveness of a semiconductor right on which an infringement action is based.

(2) Section 156(3) of the Patent Law 1970 shall apply with the restriction that proceedings shall only be interrupted if nullity is claimed on the basis of Section 13(1)1 or 4.

Relationship to the Copyright Law

25.–

The commercial exploitation of topographies shall not be affected by copyright in works of literature under Section 2(3) of the Copyright Law (BGB1. No. 111/1936) and neighboring rights for photographs under Section 73 of the Copyright Law.

Citations

26.–

The Federal law provisions cited in this Federal Law shall be applied in their currently valid version.

Entry into Force

27.–

(1) This Federal Law shall enter into force at the start of the third month following its publication.

(2) Decrees based on this Federal Law may be issued as from the day following its publication. However, they may not enter into force until this Federal Law enters into force.

Implementation

28.–

The following shall be responsible for implementing this Federal Law:

1. with respect to Section 17, where application *mutatis mutandis* of Section 168(6) of the Patent Law 1970 is provided for, the Federal Minister for Economic Affairs, in consultation with the Federal Minister for Finance,
 2. with respect to Sections 21 to 24, the Federal Minister for Justice, in consultation with the Federal Minister for Economic Affairs,
 3. with respect to all other provisions of this Federal Law, the Federal Minister for Economic Affairs.
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