

the unambiguous intent of the Federal Government to ensure equal access to an adequate education for all students of limited English proficiency.

The role of the Federal Government in assisting quality education programs, however, has been the subject of intense debate for many years. This is especially true of programs such as bilingual education.

In recent years, opponents of bilingual education have argued that instructional methods involving the child's native language is counterproductive. This debate, unfortunately, stems more from politics than from a real concern for the best interest of limited English proficient (LEP) children.

Without programs like the Federal Bilingual Education Program such children are being denied a basic right to an adequate education. I have studied the evidence closely, Mr. President, and I see no reason to challenge what the Supreme Court concluded 10 years ago in *Lau versus Nichols*.

Basic English skills are at the very core of what these public schools teach. Imposition of a requirement that, before a child can effectively participate in the education program, he must already have acquired those basic skills is to make a mockery of public education. We know that those who do not understand English are certain to find their classroom experiences wholly incomprehensible and in no way meaningful.

Title VII of ESEA is a result of this landmark decision. Basically, Title VII provides subject matter instruction in the native language of a child not proficient in English, while he or she receives English language instruction. The primary purpose of Title VII is to assist these students to master the English language while ensuring they do not fall behind in other academic programs.

The authorization of Title VII becomes crucially more important as the numbers of LEP children rapidly increase. For example, recent statistics from the Department of Education show that there are currently about 3.5 million children in the United States who have not achieved full control of the English language. In addition, the National Center for Education Statistics estimates the numbers of limited English proficient children aged 5 to 14 will increase by 400,000 in this decade and another 600,000 in the 1990's.

Other national statistics reveal that two-thirds of all LEP children are Hispanic while the largest remaining segments are of Asian and American Indian ancestry. The numbers also show the toll imposed on many of them by the lack of English language skills.

For example, almost 60 percent of Hispanics 25 years and older have not completed high school; one-third of all Hispanic youths aged 16 to 24 have dropped out of school completely; and in some urban areas, dropout rates are as high as 74 to 88 percent. It may be interesting to note that approximately

1.8 million of these students are not receiving any bilingual education. And, more importantly, these numbers are certain to escalate unless adequate bilingual education instruction—which includes structured English language components—is made available to LEP students.

Not everyone concerned with education issues, however, agrees with the concept of bilingual education. Some opponents, for example, use statistics from school districts who offer immersion programs—subject matter instruction given only in the English language—in lieu of bilingual education programs.

Some studies have focused on the fact that 45 percent of those students participating in immersion programs have, within 1 year, read at their grade level and joined regular classes.

At first glance, one might quickly assume immersion to be the correct method of instruction for all students at the expense of bilingual education. Nevertheless, other important information must be considered before endorsing this concept.

Many children involved in those immersion programs with high statistical rates of academic success came from well-educated, multilingual families. In addition, many of these students already possessed a good education background in their native language.

In addition, these students were placed in classes of approximately 20 children and received intense coaching in written and oral vocabulary by teachers who had received special education training. It is little wonder that these students scored above the 50th percentile of standardized tests.

On the other hand, many of the newly established students, or their families, have recently immigrated to the United States to escape severe economic, political, or social crises of their native homelands. These students, for the most part, have been forced to deal with the realities of social injustice, war, and poverty. They were unable, through no fault of their own, to become academically proficient in their native tongue.

It is not surprising that many of these disadvantaged students have been hard-pressed to perform on a par with their English-proficient counterparts who have had years of competent, graduated instruction.

In addition, many less affluent school districts have been unable to afford quality, intensive immersion programs or the special teacher training courses necessary to assist children in acquiring adequate English language skills and mastery of course curricula. This is one reason the reauthorization of bilingual education was so crucial.

One new and important component of bilingual education as outlined in H.R. 11 is that of developmental bilingual education. These programs would encourage a mix of students whose native language is English and those

whose native language is other than English. Courses will be taught in both languages so that students are able to assist each other in their studies while gaining an appreciation for another's culture and language.

This approach should prove to be a positive asset to public schools that have long been deficient in foreign language training. One only has to look at the events in the present international marketplace and the success of other industrialized nations to appreciate the merits of being fluent in other languages.

For example, many American businessmen currently are relying on individuals in their host countries for assistance in language, contract, and other business translations. In addition, U.S. trade deficits might well pass the \$100 billion mark this year. It has been estimated that approximately 25,000 American jobs are lost for every \$1 billion increase in the trade deficit. This translates into approximately 1 million jobs lost in the last 3 years.

As national legislators, we have a special responsibility to promote adequate education for all students, regardless of race, creed or national origin.

The provisions in H.R. 11, in my judgment, are one small but important step in addressing the special education needs of limited English proficient children as well as improving the foreign language capacities of our public schools.

The PRESIDING OFFICER. The question is on agreeing to the conference report.

The conference report was agreed to.

Mr. BAKER. Mr. President, I move to reconsider the vote by which the conference report was agreed to.

Mr. BYRD. Mr. President, I move to lay that motion to reconsider on the table.

The motion to lay on the table was agreed to.

Mr. BAKER. Mr. President, I ask unanimous consent that the order for the quorum call be rescinded.

The PRESIDING OFFICER. Without objection, it is so ordered.

#### EXTENSION OF TIME FOR ROUTINE MORNING BUSINESS

Mr. BAKER. Mr. President, I ask unanimous consent that notwithstanding the previous order, it be in order to proceed as in morning business for an additional 5 minutes.

The PRESIDING OFFICER. Without objection, it is so ordered.

#### FEDERAL DISTRICT COURT ORGANIZATION ACT

Mr. BAKER. Mr. President, I am advised that Calendar No. 1265, H.R. 6163, is now ready for consideration. If the minority leader has no objection, I

will ask the Senate to proceed to the consideration of that measure.

Mr. BYRD. Mr. President, there is no objection on this side.

Mr. BAKER. I thank the minority leader.

Mr. President, I ask unanimous consent that the Senate proceed to the consideration of Calendar No. 1265, H.R. 6163.

The bill will be stated by title.

The legislative clerk read as follows: A bill (H.R. 6163) to amend the title 28, United States Code, with respect to the places where court shall be held in certain judicial districts, and for other purposes.

The PRESIDING OFFICER. Without objection, the Senate will proceed to consider the bill.

#### AMENDMENT NO. 6995

(Purpose: To clarify the circumstances under which a trademark may be cancelled, to create a State Justice Institute, and to amend title 17, United States Code, regarding semiconductor chips, and for other purposes.)

Mr. BAKER. Mr. President, I send to the desk an amendment in the nature of a substitute, on behalf of Senator MATHIAS, and Senator LEAHY.

The PRESIDING OFFICER. The amendment will be stated.

The legislative clerk read as follows:

The Senator from Tennessee [Mr. BAKER], on behalf of Senator MATHIAS, and Senator LEAHY, proposes an amendment numbered 6995.

Mr. BAKER. Mr. President, I ask unanimous consent that reading of the amendment be dispensed with.

The PRESIDING OFFICER. Without objection, it is so ordered.

The amendment is as follows:

Strike out all after the enacting clause and insert in lieu thereof the following:

#### TITLE I

##### SHORT TITLE

SEC. 101. This title may be cited as the "Trademark Clarification Act of 1984".

##### AMENDMENT TO THE TRADEMARK ACT

SEC. 102. Section 14(c) of the Trademark Act of 1946, commonly known as the Lanham Trademark Act (15 U.S.C. 1064(c)) is amended by adding before the semicolon at the end of such section a period and the following: "A registered mark shall not be deemed to be the common descriptive name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the common descriptive name of goods or services in connection with which it has been used".

##### DEFINITIONS

SEC. 103. Section 45 of such Act (15 U.S.C. 1127) is amended as follows:

(1) Strike out "The term 'trade-mark' includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others." and insert in lieu thereof the following: "The term 'trademark' includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify and distinguish his

goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."

(2) Strike out "The term 'service mark' means a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others." and insert in lieu thereof the following: "The term 'service mark' means a mark used in the sale or advertising of services to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown."

(3) Add at the end of subparagraph (b) in the paragraph which begins "A mark shall be deemed to be 'abandoned'", the following new sentence: "Purchaser motivation shall not be a test for determining abandonment under this subparagraph."

#### JUDGMENTS

SEC. 104. Nothing in this title shall be construed to provide a basis for reopening of any final judgment entered prior to the date of enactment of this title.

#### TITLE II

##### SHORT TITLE

SEC. 201. This title may be cited as the "State Justice Institute Act of 1984".

##### DEFINITIONS

SEC. 202. As used in this title, the term—

(1) "Board" means the Board of Directors of the Institute;

(2) "Director" means the Executive Director of the Institute;

(3) "Governor" means the Chief Executive Officer of a State;

(4) "Institute" means the State Justice Institute;

(5) "recipient" means any grantee, contractor, or recipient of financial assistance under this title;

(6) "State" means any State of the United States, the District of Columbia, the Commonwealth of Puerto Rico, the Virgin Islands, Guam, American Samoa, the Northern Mariana Islands, the Trust Territory of the Pacific Islands, and any other territory or possession of the United States; and

(7) "Supreme Court" means the highest appellate court within a State unless, for the purposes of this title, a constitutionally or legislatively established judicial council acts in place of that court.

##### ESTABLISHMENT OF INSTITUTE; DUTIES

SEC. 203. (a) There is established a private nonprofit corporation which shall be known as the State Justice Institute. The purpose of the Institute shall be to further the development and adoption of improved judicial administration in State courts in the United States. The Institute may be incorporated in any State pursuant to section 204 (a)(6) of this title. To the extent consistent with the provisions of this title, the Institute may exercise the powers conferred upon a nonprofit corporation by the laws of the State in which it is incorporated.

(b) The Institute shall—

(1) direct a national program of assistance designed to assure each person ready access to a fair and effective system of justice by providing funds to—

(A) State courts;

(B) national organizations which support and are supported by State courts; and

(C) any other nonprofit organization that will support and achieve the purposes of this title;

(2) foster coordination and cooperation with the Federal Judiciary in areas of mutual concern;

(3) promote recognition of the importance of the separation of powers doctrine to an independent judiciary; and

(4) encourage education for judges and support personnel of State court systems through national and State organizations, including universities.

(c) The Institute shall not duplicate functions adequately performed by existing nonprofit organizations and shall promote, on the part of agencies of State judicial administration, responsibility for the success and effectiveness of State court improvement programs supported by Federal funding.

(d) The Institute shall maintain its principal offices in the State in which it is incorporated and shall maintain therein a designated agent to accept service of process for the Institute. Notice to or service upon the agent shall be deemed notice to or service upon the Institute.

(e) The Institute, and any program assisted by the Institute, shall be eligible to be treated as an organization described in section 170(c)(2)(B) of the Internal Revenue Code of 1954 (26 U.S.C. 170(c)(2)(B)) and as an organization described in section 510(c)(3) of the Internal Revenue Code of 1954 (26 U.S.C. 510(c)(3)) which is exempt from taxation under section 501(a) of such Code (26 U.S.C. 501(a)). If such treatments are conferred in accordance with the provisions of such Code, the Institute, and programs assisted by the Institute, shall be subject to all provisions of such Code relevant to the conduct of organizations exempt from taxation.

(f) The Institution shall afford notice and reasonable opportunity for comment to interested parties prior to issuing rules, regulations, guidelines, and instructions under this title, and it shall publish in the Federal Register, at least thirty days prior to their effective date, all rules, regulations, guidelines, and instructions.

##### BOARD OF DIRECTORS

SEC. 204. (a)(1) The Institute shall be supervised by a Board of Directors, consisting of eleven voting members to be appointed by the President, by and with the advice and consent of the Senate. The Board shall have both judicial and nonjudicial members, and shall, to the extent practicable, have a membership representing a variety of backgrounds and reflecting participation and interest in the administration of justice.

(2) The Board shall consist of—

(A) six judges, to be appointed in the manner provided in paragraph (3);

(B) one State court administrator, to be appointed in the manner provided in paragraph (3); and

(C) four members from the public sector, nor more than two of whom shall be of the same political party, to be appointed in the manner provided in paragraph (4).

(3) The President shall appoint six judges and one State court administrator from a list of candidates submitted to the President by the Conference of Chief Justices. The Conference of Chief Justice shall submit a list of at least fourteen individuals, including judges and State court administrators, whom the conference considers best qualified to serve on the Board. Whenever the term of any of the members of the Board described in subparagraphs (A) and (B) terminates and that member is not to be reappointed to a new term, and whenever a vacancy otherwise occurs among those members, the President shall appoint a new member from a list of three qualified individuals submitted to the President by the Conference of Chief Justices. The President may reject any list of individuals submitted by the Conference under this paragraph

and, if such a list of so rejected, the President shall request the Conference to submit to him another list of qualified individuals. Prior to consulting with or submitting a list to the President, the Conference of Chief Justices shall obtain and consider the recommendations of all interested organizations and individuals concerned with the administration of justice and the objectives of this title.

(4) In addition to those members appointed under paragraph (3), the President shall appoint four members from the public sector to serve on the Board.

(5) The President shall make the initial appointments of members of the Board under this subsection within ninety days after the effective date of this title. In the case of any other appointment of a member, the President shall make the appointment not later than ninety days after the previous term expires or the vacancy occurs, as the case may be. The Conference of Chief Justices shall submit lists of candidates under paragraph (3) in a timely manner so that the appointments can be made within the time periods specified in this paragraph.

(6) The initial members of the Board of Directors shall be the incorporators of the Institute and shall determine the State in which the Institute is to be incorporated.

(b)(1) Except as provided in paragraph (2), the term of each voting member of the Board shall be three years. Each member of the Board shall continue to serve until the successor to such member has been appointed and qualified.

(2) Five of the members first appointed by the President shall serve for a term of two years. Any member appointed to serve an unexpired term which has arisen by virtue of the death, disability, retirement, or resignation of a member shall be appointed only for such unexpired term, but shall be eligible for reappointment.

(3) The term of initial members shall commence from the date of the first meeting of the Board, and the term of each member other than an initial member shall commence from the date of termination of the preceding term.

(c) No member shall be reappointed to more than two consecutive terms immediately following such member's initial term.

(d) Members of the Board shall serve without compensation, but shall be reimbursed for actual and necessary expenses incurred in the performance of their official duties.

(e) The members of the Board shall not, by reason of such membership, be considered officers or employees of the United States.

(f) Each member of the Board shall be entitled to one vote. A simple majority of the membership shall constitute a quorum for the conduct of business. The Board shall act upon the concurrence of a simple majority of the membership present and voting.

(g) The Board shall select from among the voting members of the Board a chairman, the first of whom shall serve for a term of three years. Thereafter, the Board shall annually elect a chairman from among its voting members.

(h) A member of the Board may be removed by a vote of seven members for malfeasance in office, persistent neglect of, or inability to discharge duties, or for any offense involving moral turpitude, but for no other cause.

(i) Regular meetings of the Board shall be held quarterly. Special meetings shall be held from time to time upon the call of the chairman, acting at his own discretion or pursuant to the petition of any seven members.

(j) All meetings of the Board, any executive committee of the Board, and any council established in connection with this title, shall be upon and subject to the requirements and provisions of section 552b of title 5, United States Code, relating to open meetings.

(k) In its direction and supervision of the activities of the Institute, the Board shall—

- (1) establish policies and develop such programs for the Institute that will further the achievement of its purpose and performance of its functions;

- (2) establish policy and funding priorities and issue rules, regulations, guidelines, and instructions pursuant to such priorities;

- (3) appoint and fix the duties of the Executive Director of the Institute, who shall serve at the pleasure of the Board and shall be nonvoting ex officio member of the Board;

- (4) present to other Government departments, agencies, and instrumentalities whose programs or activities relate to the administration of justice in the State judicials of the United States, the recommendations of the Institute for the improvement of such programs or activities;

- (5) consider and recommend to both public and private agencies aspects of the operation of the State courts of the United States considered worthy of Special Study; and

- (6) award grants and enter into cooperative agreements or contracts pursuant to section 206 (a).

#### OFFICERS AND EMPLOYEES

SEC. 205. (a)(1) The Director, subject to general policies established by the Board, shall supervise the activities of persons employed by the Institute and may appoint and remove such employees as he determines necessary to carry out the purposes of the Institute. The Director shall be responsible for the executive and administrative operations of the Institute, and shall perform such duties as are delegated to such Director by the Board and the Institute.

(2) No political test or political qualification shall be used in selecting, appointing, promoting, or taking any other personnel action with respect to any officer, agent, or employee of the Institute, or in selecting or monitoring any grantee, contractor, person, or entity receiving financial assistance under this title.

(b) Officers and employees of the Institute shall be compensated at rates determined by the Board, but not in excess of the rate of level V of the Executive Schedule specified in section 5316 of title 5, United States Code.

(c) (1) Except as otherwise specifically provided in this title, the Institute shall not be considered a department, agency, or instrumentality of the Federal Government.

(2) This title does not limit the authority of the Office of Management and Budget to review and submit comments upon the Institute's annual budget request at the time it is transmitted to the Congress.

(d) (1) Except as provided in paragraph (2), officers and employees of the Institute shall not be considered officers or employees of the United States.

(2) Officers and employees of the Institute shall be considered officers and employees of the United States solely for the purposes of the following provisions of title 5, United States Code: Subchapter I of chapter 81 (relating to compensation for work injuries); chapter 83 (relating to civil service retirement); chapter 87 (relating to life insurance); and chapter 89 (relating to health insurance). The Institute shall make contributions under the provisions referred to in this subsection at the same rates appli-

cable to agencies of the Federal Government.

(e) The Institute and its officers and employees shall be subject to the provisions of section 552 of title 5, United States Code, relating to freedom of information.

#### GRANTS AND CONTRACTS

SEC. 206. (a) The Institute is authorized to award grants and enter into cooperative agreements or contracts, in a manner consistent with subsection (b), in order to—

- (1) conduct research, demonstrations, or special projects pertaining to the purposes described in this title, and provide technical assistance and training in support of tests, demonstrations, and special projects;

- (2) serve as a clearinghouse and information center, where not otherwise adequately provided, for the preparation, publication, and dissemination of information regarding State judicial systems;

- (3) participate in joint projects with other agencies, including the Federal Judicial Center, with respect to the purposes of this title;

- (4) evaluate, when appropriate, the programs and projects carried out under this title to determine their impact upon the quality of criminal, civil, and juvenile justice and the extent to which they have met or failed to meet the purposes and policies of this title;

- (5) encourage and assist in the furtherance of judicial education;

- (6) encourage, assist, and serve in a consulting capacity to State and local justice system agencies in the development, maintenance, and coordination of criminal, civil, and juvenile justice programs and services; and

- (7) be responsible for the certification of national programs that are intended to aid and improve State judicial systems.

(b) The Institute is empowered to award grants and enter into cooperative agreements or contracts as follows:

- (1) The Institute shall give priority to grants, cooperative agreements, or contracts with—

- (A) State and local courts and their agencies,

- (B) national nonprofit organizations controlled by, operating in conjunction with and serving the judicial branches of State governments; and

- (C) national nonprofit organizations for the education and training of judges and support personnel of the judicial branch of State governments.

- (2) The Institute may, if the objective can better be served thereby, award grants or enter into cooperative agreements or contracts with—

- (A) other nonprofit organizations with expertise in judicial administration;

- (B) institutions of higher education;

- (C) individuals, partnerships, firms, or corporations; and

- (D) private agencies with expertise in judicial administration.

(3) Upon application by an appropriate Federal, State, or local agency or institution and if the arrangements to be made by such agency or institution will provide services which could not be provided adequately through nongovernmental arrangements, the Institute may award a grant or enter into a cooperative agreement or contract with a unit of Federal, State, or local government other than a court.

(4) Each application for funding by a State or local court shall be approved, consistent with State law, by the State's supreme court, or its designated agency or council, which shall receive, administer, and

be accountable for all funds awarded by the Institute to such courts.

(c) Funds available pursuant to grants, cooperative agreements, or contracts awarded under this section may be used—

(1) to assist State and local court systems in establishing appropriate procedures for the selection and removal of judges and other court personnel and in determining appropriate levels of compensation;

(2) to support education and training programs for judges and other court personnel, for the performance of their general duties and for specialized functions, and to support national and regional conferences and seminars for the dissemination of information on new developments and innovative techniques;

(3) to conduct research on alternative means for using nonjudicial personnel in court decisionmaking activities, to implement demonstration programs to test innovative approaches, and to conduct evaluations of their effectiveness;

(4) to assist State and local courts in meeting requirements of Federal law applicable to recipients of Federal funds;

(5) to support studies of the appropriateness and efficacy of court organizations and financing structures in particular States, and to enable States to implement plans for improved court organization and finance;

(6) to support State court planning and budgeting staffs and to provide technical assistance in resource allocation and service forecasting techniques;

(7) to support studies of the adequacy of court management systems in State and local courts and to implement and evaluate innovative responses to problems of record management, data processing, court personnel management, reporting and transcription of court proceedings, and juror utilization and management;

(8) to collect and compile statistical data and other information on the work of the courts and on the work of other agencies which relate to and effect the work of courts;

(9) to conduct studies of the causes of trial and appellate court delay in resolving cases, and to establish and evaluate experimental programs for reducing case processing time;

(10) to develop and test methods for measuring the performance of judges and courts and to conduct experiments in the use of such measures to improve the functioning of such judges and courts;

(11) to support studies of court rules and procedures, discovery devices, and evidentiary standards, to identify problems with the operation of such rules, procedures, devices, and standards, to devise alternative approaches to better reconcile the requirements of due process with the need for swift and certain justice, and to test the utility of those alternative approaches;

(12) to support studies of the outcomes of cases in selected subject matter areas to identify instances in which the substance of justice meted out by the courts diverges from public expectations of fairness, consistency, or equity, to propose alternative approaches to the resolving of cases in problem areas, and to test and evaluate those alternatives;

(13) to support programs to increase court responsiveness to the needs of citizens through citizen education, improvement of court treatment of witnesses, victims, and jurors, and development of procedures for obtaining and using measures of public satisfaction with court processes to improve court performance;

(14) to test and evaluate experimental approaches to providing increased citizen access to justice, including processes which

reduce the cost of litigating common grievances and alternative techniques and mechanisms for resolving disputes between citizens; and

(15) to carry out such other programs, consistent with the purposes of this title, as may be deemed appropriate by the Institute.

(d) The Institute shall incorporate in any grant, cooperative agreement, or contract awarded under this section in which a State or local judicial system is the recipient, the requirement that the recipient provide a match, from private to public sources, not less than 50 per centum of the total cost of such grant, cooperative agreement, or contract, except that such requirement may be waived in exceptionally rare circumstances upon the approval of the chief justice of the highest court of the State and a majority of the Board of Directors.

(e) The Institute shall monitor and evaluate, or provide for independent evaluations of, programs supported in whole or in part under this title to ensure that the provisions of this title, the bylaws of the Institute, and the applicable rules, regulations, and guidelines promulgated pursuant to this title, are carried out.

(f) The Institute shall provide for an independent study of the financial and technical assistance programs under this title.

#### LIMITATIONS ON GRANTS AND CONTRACTS

Sec. 207. (a) With respect to grants made and contracts or cooperative agreements entered into under this title, the Institute shall—

(1) ensure that no funds made available to recipients by the Institute shall be used at any time, directly or indirectly, to influence the issuance, amendment, or revocation of any Executive order or similar promulgation by any Federal, State, or local agency, or to undertake to influence the passage or defeat of any legislation or constitutional amendment by the Congress of the United States, or by any State or local legislative body, or any State proposal by initiative petition, or of any referendum, unless a governmental agency, legislative body, a committee, or a member thereof—

(A) requests personnel of the recipients to testify, draft, or review measures or to make representations to such agency, body, committee, or member; or

(B) is considering a measure directly affecting the activities under this title of the recipient or the Institute;

(2) ensure all personnel engaged in grant, cooperative agreement or contract assistance activities supported in whole or part by the Institute refrain, while so engaged, from any partisan political activity; and

(3) ensure that each recipient that files with the Institute a timely application for refunding is provided interim funding necessary to maintain its current level of activities until—

(A) the application for refunding has been approved and funds pursuant thereof received; or

(B) the application for refunding has been finally denied in accordance with section 9 of this title.

(b) No funds made available by the Institute under this title, either by grant, cooperative agreement, or contract, may be used to support or conduct training programs for the purpose of advocating particular nonjudicial public policies or encouraging nonjudicial political activities.

(c) The authorization to enter into cooperative agreements, contracts or any other obligation under this title shall be effective only to the extent, and in such amounts, as are provided in advance in appropriation Acts.

(d) To ensure that funds made available under this Act are used to supplement and improve the operation of State courts, rather than to support basic court services, funds shall not be used—

(1) to supplant State of local funds currently supporting a program or activity; or

(2) to construct court facilities or structures, except to remodel existing facilities to demonstrate new architectural or technological techniques, or to provide temporary facilities for new personnel or for personnel involved in a demonstration or experimental program.

#### RESTRICTIONS ON ACTIVITIES OF THE INSTITUTE

Sec. 208. (a) The Institute shall not—

(1) participate in litigation unless the Institute or a recipient of the Institute is a party, and shall not participate on behalf of any client other than itself;

(2) interfere with the independent nature of any State judicial system or allow financial assistance to be used for the funding of regular judicial and administrative activities of any State judicial system other than pursuant to the terms of any grant, cooperative agreement, or contract with the Institute, consistent with the requirements of this title; or

(3) undertake to influence the passage or defeat of any legislation by the Congress of the United States or by any State or local legislative body, except that personnel of the Institute may testify or make other appropriate communication—

(A) when formally requested to do so by a legislative body, committee, or a member thereof;

(B) in connection with legislation or appropriations directly affecting the activities of the Institute; or

(C) in connection with legislation or appropriations dealing with improvement in the State judiciary, consistent with the provisions of this title.

(b)(1) The Institute shall have no power to issue any shares of stock, or to declare or pay any dividends.

(2) No part of the income or assets of the Institute shall enure to the benefit of any director, officer, or employee, except as reasonable compensation for services or reimbursement for expenses.

(3) Neither the Institute nor any recipient shall contribute or make available Institute funds or program personnel or equipment to any political party or association, or the campaign of any candidate for public or party office.

(4) The Institute shall not contribute or make available Institute funds or program personnel or equipment for use in advocating or opposing any ballot measure, initiative, or referendum.

(c) Officers and employees of the Institute or of recipients shall not at any time intentionally identify the Institute or the recipient with any partisan or nonpartisan political activity associated with a political party or association, or the campaign of any candidate for public or party office.

#### SPECIAL PROCEDURES

Sec. 209. The Institute shall prescribe procedures to ensure that—

(1) financial assistance under this title shall not be suspended unless the grantee, contractor, person, or entity receiving financial assistance under this title has been given reasonable notice and opportunity to show cause why such actions should not be taken; and

(2) financial assistance under this title shall not be terminated, an application for refunding shall not be denied, and a suspension of financial assistance shall not be continued for longer than thirty days, unless

the recipient has been afforded reasonable notice and opportunity for a timely, full, and fair hearing, and, when requested, such hearing shall be conducted by an independent hearing examiner. Such hearing shall be held prior to any final decision by the Institute to terminate financial assistance or suspend or deny funding. Hearing examiners shall be appointed by the Institute in accordance with procedures established in regulations promulgated by the Institute.

#### PRESIDENTIAL COORDINATION

SEC. 210. The President may, to the extent not inconsistent with any other applicable law, direct that appropriate support functions of the Federal Government may be made available to the Institute in carrying out its functions under this title.

#### RECORDS AND REPORTS

SEC. 211. The Institute is authorized to require such reports as it deems necessary from any recipient with respect to activities carried out pursuant to this title.

(b) The Institute is authorized to prescribe the keeping of records with respect to funds provided by any grant, cooperative agreement, or contract under this title and shall have access to such records at all reasonable times for the purpose of ensuring compliance with such grant, cooperative agreement, or contract or the terms and conditions upon which financial assistance was provided.

(c) Copies of all reports pertinent to the evaluation, inspection, or monitoring of any recipient shall be submitted on a timely basis to such recipient, and shall be maintained in the principal office of the Institute for a period of at least five years after such evaluation, inspection, or monitoring. Such reports shall be available for public inspection during regular business hours, and copies shall be furnished, upon request, to interested parties upon payment of such reasonable fees as the Institute may establish.

(d) Non-Federal funds received by the Institute, and funds received for projects funded in part by the Institute or by any recipient from a source other than the Institute, shall be accounted for and reported as receipts and disbursements separate and distinct from Federal funds.

#### AUDITS

SEC. 212. (a)(1) The accounts of the Institute shall be audited annually. Such audits shall be conducted in accordance with generally accepted auditing standards by independent certified public accountants who are certified by a regulatory authority of the jurisdiction in which the audit is undertaken.

(2) The audits shall be conducted at the place or places where the accounts of the Institute are normally kept. All books, accounts, financial records, reports, files, and other papers or property belonging to or in use by the Institute and necessary to facilitate the audits shall be made available to the person or persons conducting the audits. The full facilities for verifying transactions with the balances and securities held by depositories, fiscal agents, and custodians shall be afforded to any such person.

(3) The report of the annual audit shall be filed with the General Accounting Office and shall be available for public inspection during business hours at the principal office of the Institute.

(b)(1) In addition to the annual audit, the financial transactions of the Institute for any fiscal year during which Federal funds are available to finance a portion of its operations may be audited by the General Accounting Office in accordance with such rules and regulations as may be prescribed

by the Comptroller General of the United States.

(2) Any such audit shall be conducted at the place or places where accounts of the Institute are normally kept. The representatives of the General Accounting Office shall have access to all books, accounts, financial records, reports, files, and other papers or property belonging to or in use by the Institute and necessary to facilitate the audit. The full facilities for verifying transactions with the balances and securities held by depositories, fiscal agents, and custodians shall be afforded to such representatives. All such books, accounts, financial records, reports, files, and other papers or property of the Institute shall remain in the possession and custody of the Institute throughout the period beginning on the date such possession or custody commences and ending three years after such date, but the General Accounting Office may require the retention of such books, accounts, financial records, reports, files, and other papers or property for a longer period under section 3523(c) of title 31, United States Code.

(3) A report of such audit shall be made by the Comptroller General to the Congress and to the Attorney General, together with such recommendations with respect thereto as the Comptroller General deems advisable.

(c)(1) The Institute shall conduct, or require each recipient to provide for, an annual fiscal audit. The report of each such audit shall be maintained for a period of at least five years at the principal office of the Institute.

(2) The Institute shall submit to the Comptroller General of the United States copies of such reports, and the Comptroller General may, in addition, inspect the books, accounts, financial records, files, and other papers or property belonging to or in use by such grantee, contractor, person, or entity, which relate to the disposition or use of funds received from the Institute. Such audit reports shall be available for public inspection during regular business hours, at the principal office of the Institute.

#### REPORT BY ATTORNEY GENERAL

SEC. 213. On October 1, 1978, the Attorney General, in consultation with the Federal Judicial Center, shall transmit to the Committees on the Judiciary of the Senate and the House of Representatives a report on the effectiveness of the Institute in carrying out the duties specified in section 203 (b). Such report shall include an assessment of the cost effectiveness of the program as a whole and, to the extent practicable, of individual grants, an assessment of whether the restrictions and limitations specified in sections 207 and 208 have been respected, and such recommendations as the Attorney General, in consultation with the Federal Judicial Center, deems appropriate.

#### AMENDMENTS TO OTHER LAWS

SEC. 214. Section 620 (b) of title 28, United States Code, is amended by—

(1) striking out "and" at the end of paragraph (3);

(2) striking out the period at the end of paragraph (4) and inserting in lieu thereof "; and"; and

(3) inserting the following new paragraph (5) at the end thereof:

"(5) Insofar as may be consistent with the performance of the other functions set forth in this section, to cooperate with the State Justice Institute in the establishment and coordination of research and programs concerning the administration of justice."

#### AUTHORIZATIONS

SEC. 215. There are authorized to be appropriated to carry out the purposes of this

title, \$13,000,000 for fiscal year 1986, \$15,000,000 for fiscal year 1987, and \$15,000,000 for fiscal year 1988.

#### EFFECTIVE DATE

SEC. 216. The provisions of this title shall take effect on October 1, 1985.

#### TITLE III

#### SHORT TITLE

SEC. 301. This title may be cited as the "Semiconductor Chip Protection Act of 1984".

#### PROTECTION OF SEMICONDUCTOR CHIP PRODUCTS

SEC. 302. Title 17, United States Code, is amended by adding at the end thereof the following new chapter:

#### "CHAPTER 9—PROTECTION OF SEMICONDUCTOR CHIP PRODUCTS

"Sec.

"901. Definitions.

"902. Subject matter of protection.

"903. Ownership and transfer.

"904. Duration of protection.

"905. Exclusive rights in mask works.

"906. Limitation on exclusive rights; reverse engineering; first sale.

"907. Limitation on exclusive rights; innocent infringement.

"908. Registration of claims of protection.

"909. Mask work notice.

"910. Enforcement of exclusive rights.

"911. Civil actions.

"912. Relation to other laws.

"913. Transitional provisions.

"914. International transitional provisions.

"§ 901. Definitions

"(a) As used in this chapter—

"(1) a 'semiconductor chip product' is 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;

"(2) 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;

"(3) 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;

"(4) to 'distribute' means to sell, or to lease, bail, or otherwise transfer, or to offer to sell lease, bail, or otherwise transfer;

"(5) to 'commercially exploit' a mask work is to distribute to the public for commercial purposes a semiconductor chip product embodying the mask work; except that such 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;

"(6) the 'owner' of a mask work is 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 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);

"(7) an 'innocent purchaser' is a person who purchases a semiconductor chip product in good faith and without having notice of protection with respect to the semiconductor chip product;

"(8) having 'notice of protection' means having actual knowledge that, or reasonable grounds to believe that, a mask work is protected under this chapter; and

"(9) an 'infringing semiconductor chip product' is a semiconductor chip product which is made, imported, or distributed in violation of the exclusive rights of the owner of a mask work under this chapter.

"(b) For purposes of this chapter, the distribution or importation of a product incorporating a semiconductor chip product as a part thereof is a distribution or importation of that semiconductor chip product.

#### "§ 902. Subject matter of protection

"(a)(1) Subject to the provision of subsection (b), a mask work fixed in a semiconductor chip product, by or under the authority of the owner of the mask work, is eligible for protection under this chapter if—

"(A) on the date on which the mask work is registered under section 908, or is first commercially exploited anywhere in the world, whichever occurs first, the owner of the mask work is (i) a national or domiciliary of the United States, (ii) a national, domiciliary, or sovereign authority of a foreign nation that is a party to a treaty affording protection to mask works to which the United States is also a party, or (iii) a stateless person, wherever that person may be domiciled;

"(B) the mask work is first commercially exploited in the United States; or

"(C) the mask work comes within the scope of a Presidential proclamation issued under paragraph (2).

"(2) Whenever the President finds that a foreign nation extends, to mask works of owners who are nationals or domiciliaries of the United States protection (A) on substantially the same basis as that on which the foreign nation extends protection to mask works of its own nationals and domiciliaries and mask works first commercially exploited in that nation, or (B) on substantially the same basis as provided in this chapter, the President may by proclamation extend protection under this chapter to mask works (i) of owners who are, on the date on which the mask works are registered under section 908, or the date on which the mask works are first commercially exploited anywhere in the world, whichever occurs first, nationals, domiciliaries, or sovereign authorities of that nation, or (ii) which are first commercially exploited in that nation.

"(b) Protection under this chapter shall not be available for a mask work that—

"(1) is not original; or

"(2) 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.

"(c) In no cause does protection under this chapter for a mask work extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

#### "§ 903. Ownership, transfer, licensing and recordation

"(a) The exclusive rights in a mask work subject to protection under this chapter belong to the owner of the mask work.

"(b) The owner of the exclusive rights in a mask work may transfer all of those rights, or license all or less than all of those rights, by any written instrument signed by such owner or a duly authorized agent of the owner. Such rights may be transferred or licensed by operation of law, may be bequeathed by will, and may pass as personal property by the applicable laws of interstate succession.

"(c)(1) Any 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. The Register of Copyrights shall, upon receipt of the document and the fee specified pursuant to section 908(d), record the document and return it with a certificate of recordation. The recordation of any transfer or license under this paragraph gives all persons constructive notice of the facts stated in the recorded document concerning the transfer or license.

"(2) In any case in which conflicting transfers of the exclusive rights in a mask work are made, the transfer first executed shall be void as against a subsequent transfer which is made for a valuable consideration and without notice of the first transfer, unless the first transfer is recorded in accordance with paragraph (1) within three months after the date on which it is executed, but in no case later than the day before the date of such subsequent transfer.

"(d) Mask works prepared by an officer or employee of the United States Government as part of that person's official duties are not protected under this chapter, but the United States Government is not precluded from receiving and holding exclusive rights in mask works transferred to the Government under subsection (b).

#### "§ 904. Duration of protection

"(a) The protection provided for a mask work under this chapter shall commence on the date on which the mask work is registered under section 908, or the date on which the mask work is first commercially exploited anywhere in the world, whichever occurs first.

"(b) Subject to subsection (c) and the provisions of this chapter, the protection provided under this chapter to a mask work shall end ten years after the date on which such protection commences under subsection (a).

"(c) All terms of protection provided in this section shall run to the end of the calendar year in which they would otherwise expire.

#### "§ 905. Exclusive rights in mask works

"The owner of a mask work provided protection under this chapter has 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).

#### "§ 906. Limitation on exclusive rights: reverse engineering: first sale

"(a) Notwithstanding the provisions of section 905, it is not an infringement of the exclusive rights of the owner of a mask work for—

"(1) a person to reproduce the mask work solely for the purpose of teaching, analyzing, or evaluating the concepts or techniques embodied in the mask work or the circuitry, logic flow, or organization of components used in the mask work; or

"(2) a person who performs the analysis or evaluation described in paragraph (1) to incorporate the results of such conduct in an original mask work which is made to be distributed.

"(b) Notwithstanding the provisions of section 905(2), the owner of a particular semiconductor chip product made by the owner of the mask work, or by any person authorized by the owner of the mask work, may import, distribute, or otherwise dispose of or use, but not reproduce, that particular semiconductor chip product without the authority of the owner of the mask work.

#### "§ 907. Limitation on exclusive rights: innocent infringement

"(a) Notwithstanding any other provision of this chapter, an innocent purchaser of an infringing semiconductor chip product—

"(1) shall incur no liability under this chapter with respect to the importation or distribution of units of the infringing semiconductor chip product that occurs before the innocent purchaser has notice of protection with respect to the mask work embodied in the semiconductor chip product; and

"(2) shall be liable only for a reasonable royalty on each unit of the infringing semiconductor chip product that the innocent purchaser imports or distributes after having notice of protection with respect to the mask work embodied in the semiconductor chip product.

"(b) The amount of the royalty referred to in subsection (a) (2) shall be determined by the court in a civil action for infringement unless the parties resolve the issue by voluntary negotiation, mediation, or binding arbitration.

"(c) The immunity of an innocent purchaser from liability referred to in subsection (a) (1) and the limitation of remedies with respect to an innocent purchaser referred to in subsection (a) (2) shall extend to any person who directly or indirectly purchases an infringing semiconductor chip product from an innocent purchaser.

"(d) The provisions of subsections (a), (b), and (c) apply only with respect to those units of an infringing semiconductor chip product that an innocent purchaser purchased before having notice of protection with respect to the mask work embodied in the semiconductor chip product.

#### "§ 908. Registration of claims of protection

"(a) The owner of a mask work may apply to the Register of Copyrights for registration of a claim of protection in a mask work. Protection of a mask work under this chapter shall terminate if application for registration of a claim of protection in the mask work is not made as provided in this chapter within two years after the date on which the mask work is first commercially exploited anywhere in the world.

"(b) The Register of Copyrights shall be responsible for all administrative functions and duties under this chapter. Except for section 708, the provisions of chapter 7 of this title relating to the general responsibilities, organization, regulatory authority, actions, records, and publications of the Copyright Office shall apply to this chapter, except that the Register of Copyrights may make such changes as may be necessary in applying those provisions to this chapter.

"(c) The application for registration of a mask work shall be made on a form prescribed by the Register of Copyrights. Such

form may require 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 under this chapter, or ownership of the mask work. The application shall be accompanied by the fee set pursuant to subsection (d) and the identifying material specified pursuant to such subsection.

"(d) The Register of Copyrights shall by regulation set reasonable fees for the filing of applications to register claims of protection in mask works under this chapter, 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 statutory fee schedules under this title. The Register shall also specify the identifying material to be deposited in connection with the claim for registration.

"(e) If the Register of Copyrights, after examining an application for registration, determines, in accordance with the provisions of this chapter, that the application relates to a mask work which is entitled to protection under this chapter, then the Register shall register the claim of protection and issue to the applicant a certificate of registration of the claim of protection under the seal of the Copyright Office. The effective date of registration of a claim of protection shall be the date on which an application, deposit of identifying material, and fee, which are determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration of the claim, have all been received in the Copyright Office.

"(f) In any action for infringement under this chapter, the certificate of registration of a mask work shall constitute prima facie evidence (1) of the facts stated in the certificate, and (2) that the applicant issued the certificate has met the requirements of this chapter, and the regulations issued under this chapter, with respect to the registration of claims.

"(g) Any applicant for registration under this section who is dissatisfied with the refusal of the Register of Copyrights to issue a certificate of registration under this section may seek judicial review of that refusal by bringing an action for such review in an appropriate United States district court not later than sixty days after the refusal. The provisions of chapter 7 of title 5 shall apply to such judicial review. The failure of the Register of Copyrights to issue a certificate of registration within four months after an application for registration is filed shall be deemed to be a refusal to issue a certificate of registration for purposes of this subsection and section 910(b)(2), except that, upon a showing of good cause, the district court may shorten such four-month period.

#### "§ 909. Mask work notice

"(a) The owner of a mask work provided protection under this chapter may affix notice to the mask work, and to masks and semiconductor chip products embodying the mask work, in such manner and location as to give reasonable notice of such protection. The Register of Copyrights shall prescribe by regulation, as examples, specific methods of affixation and positions of notice for purposes of this section, but these specifications shall not be considered exhaustive. The affixation of such notice is not a condition of protection under this chapter, but shall constitute prima facie evidence of notice of protection.

"(b) The notice referred to in subsection (a) shall consist of—

"(1) the words 'mask work', the symbol 'M', or the symbol mask work (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.

#### "§ 910. Enforcement of exclusive rights

"(a) Except as otherwise provided in this chapter, any person who violates any of the exclusive rights of the owner of a mask work under this chapter, by conduct in or affecting commerce, shall be liable as an infringer of such rights.

"(b)(1) The owner of a mask work protected under this chapter, or the exclusive licensee of all rights under this chapter with respect to the mask work, shall, after a certificate of registration of a claim of protection in that mask work has been issued under section 908, be entitled to institute a civil action for any infringement with respect to the mask work which is committed after the commencement of protection of the mask work under section 904(a).

"(2) In any case in which an application for registration of a claim of protection in a mask work and the required deposit of identifying material and fee have been received in the Copyright Office in proper form and registration of the mask work has been refused, the applicant is entitled to institute a civil action for infringement under this chapter with respect to the mask work if notice of the action, together with a copy of the complaint, is served on the Register of Copyrights, in accordance with the Federal Rules of Civil Procedure. The Register may, at his or her option, become a party to the action with respect to the issue of whether the claim of protection is eligible for registration by entering an appearance within sixty days after such service, but the failure of the Register to become a party to the action shall not deprive the court of jurisdiction to determine that issue.

"(c)(1) The Secretary of the Treasury and the United States Postal Service shall separately or jointly issue regulations for the enforcement of the rights set forth in section 905 with respect to importation. These regulations may require, as a condition for the exclusion of articles from the United States, that the person seeking exclusion take any one or more of the following actions:

"(A) Obtain a court order enjoining, or an order of the International Trade Commission under section 337 of the Tariff Act of 1930 excluding, importation of the articles.

"(B) Furnish proof that the mask work involved is protected under this chapter and that the importation of the articles would infringe the rights in the mask work under this chapter.

"(C) Post a surety bond for any injury that may result if the detention or exclusion of the articles proves to be unjustified.

"(2) Articles imported in violation of the rights set forth in section 905 are subject to seizure and forfeiture in the same manner as property imported in violation of the customs laws. Any such forfeited articles shall be destroyed as directed by the Secretary of the Treasury or the court, as the case may be, except that the articles may be returned to the country of export whenever it is shown to the satisfaction of the Secretary of the Treasury that the importer had no reasonable grounds for believing that his or her acts constituted a violation of the law.

#### "§ 911. Civil actions

"(a) Any court having jurisdiction of a civil action arising under this chapter may grant temporary restraining orders, preliminary injunctions, and permanent injunctions on such terms as the court may deem reasonable to prevent or restrain infringe-

ment of the exclusive rights in a mask work under this chapter.

"(b) Upon finding an infringer liable, to a person entitled under section 910(b)(1) to institute a civil action, for an infringement of any exclusive right under this chapter, the court shall award such person actual damages suffered by the person as a result of the infringement. The court shall also award such person the infringer's profits that are attributable to the infringement and are not taken into account in computing the award of actual damages. In establishing the infringer's profits, such person is required to present proof only of the infringer's gross revenue, and the infringer is required to prove his or her deductible expenses and the elements of profit attributable to factors other than the mask work.

"(c) At any time before final judgment is rendered, a person entitled to institute a civil action for infringement may elect, instead of actual damages and profits as provided by subsection (b), an award of statutory damages for all infringements involved in the action, with respect to any one mask work for which any one infringer is liable individually, or for which any two or more infringers are liable jointly and severally, in an amount not more than \$250,000 as the court considers just.

"(d) An action for infringement under this chapter shall be barred unless the action is commenced within three years after the claim accrues.

"(e)(1) At any time while an action for infringement of the exclusive rights in a mask work under this chapter is pending, the court may order the impounding, on such terms as it may deem reasonable, of all semiconductor chip products, and any drawings, tapes, masks, or other products by means of which such products may be reproduced, that are claimed to have been made, imported, or used in violation of those exclusive rights. Insofar as practicable, applications for orders under this paragraph shall be heard and determined in the same manner as an application for a temporary restraining order or preliminary injunction.

"(2) As part of a final judgment or decree, the court may order the destruction or other disposition of any infringing semiconductor chip products, and any masks, tapes, or other articles by means of which such products may be reproduced.

"(f) In any civil action arising under this chapter, the court in its discretion may allow the recovery of full costs, including reasonable attorneys' fees, to the prevailing party.

#### "§ 912. Relation to other laws

"(a) Nothing in this chapter shall affect any right or remedy held by any person under chapters 1 through 8 of this title, or under title 35.

"(b) Except as provided in section 908(b) of this title, references to 'this title' or 'title 17' in chapters 1 through 8 of this title shall be deemed not to apply to this chapter.

"(c) The provisions of this chapter shall preempt the laws of any State to the extent those laws provide any rights or remedies with respect to a mask work which are equivalent to those rights or remedies provided by this chapter, except that such preemption shall be effective only with respect to actions filed on or after January 1, 1986.

"(d) The provisions of sections 1338, 1400(a), and 1498 (b) and (c) of title 28 shall apply with respect to exclusive rights in mask works under this chapter.

"(e) Notwithstanding subsection (c), nothing in this chapter shall detract from any rights of a mask work owner, whether under

Federal law (exclusive of this chapter) or under the common law or the statutes of a State, heretofore or hereafter declared or enacted, with respect to any mask work first commercially exploited before July 1, 1983.

**§ 913. Transitional provisions**

"(a) No application for registration under section 908 may be filed, and no civil action under section 910 or other enforcement proceeding under this chapter may be instituted, until sixty days after the date of the enactment of this chapter.

"(b) No monetary relief under section 911 may be granted with respect to any conduct that occurred before the date of the enactment of this chapter, except as provided in subsection (d).

"(c) Subject to subsection (a), the provisions of this chapter apply to all mask works that are first commercially exploited or are registered under this chapter, or both, on or after the date of the enactment of this chapter.

"(d)(1) Subject to subsection (a), protection is available under this chapter to any mask work that was first commercially exploited on or after July 1, 1983, and before the date of the enactment of this chapter, if a claim of protection in the mask work is registered in the Copyright Office before July 1, 1985, under section 908.

"(2) In the case of any mask work described in paragraph (1) that is provided protection under this chapter, infringing semiconductor chip product units manufactured before the date of the enactment of this chapter may, without liability under sections 910 and 911, be imported into or distributed in the United States, or both, until two years after the date of registration of the mask work under section 908, but only if the importer or distributor, as the case may be, first pays or offers to pay the reasonable royalty referred to in section 907(a)(2) to the mask work owner, on all such units imported or distributed, or both, after the date of the enactment of this chapter.

"(3) In the event that a person imports or distributes infringing semiconductor chip product units described in paragraph (2) of this subsection without first paying or offering to pay the reasonable royalty specified in such paragraph, or if the person refuses or fails to make such payment, the mask work owner shall be entitled to the relief provided in sections 910 and 911.

**§ 914. International transitional provisions**

"(a) Notwithstanding the conditions set forth in subparagraphs (A) and (C) of section 902(a)(1) with respect to the availability of protection under this chapter to nationals, domiciliaries, and sovereign authorities of a foreign nation, the Secretary of Commerce may, upon the petition of any person, or upon the Secretary's own motion, issue an order extending protection under this chapter to such foreign materials, domiciliaries, and sovereign authorities if the Secretary finds—

"(1) that the foreign nation is making good faith efforts and reasonable progress toward—

"(A) entering into a treaty described in section 902(a)(1)(A); or

"(B) enacting legislation that would be in compliance with subparagraphs (A) or (B) of section 902(a)(2); and

"(2) that the nationals, domiciliaries, and sovereign authorities of the foreign nation, and persons controlled by them, are not engaged in the misappropriation, or unauthorized distribution or commercial exploitation, of mask works; and

"(3) that issuing the order would promote the purposes of this chapter and interna-

tional comity with respect to the protection of mask works.

"(b) While an order under subsection (a) is in effect with respect to a foreign nation, no application for registration of a claim for protection in a mask work under this chapter may be denied solely because the owner of the mask work is a national, domiciliary, or sovereign authority of that foreign nation, or solely because the mask work was first commercially exploited in that foreign nation.

"(c) Any order issued by the Secretary of Commerce under subsection (a) shall be effective for such period as the Secretary designates in the order, except that no such order may be effective after the date on which the authority of the Secretary of Commerce terminates under subsection (e). The effective date of any such order shall also be designated in the order. In the case of an order issued upon the petition of a person, such effective date may be no earlier than the date on which the Secretary receives such petition.

"(d)(1) Any order issued under this section shall terminate if—

"(A) the Secretary of Commerce finds that any of the conditions set forth in paragraphs (1), (2), and (3) of subsection (a) no longer exist; or

"(B) mask works of nationals, domiciliaries, and sovereign authorities of that foreign nation or mask works first commercially exploited in that foreign nation become eligible for protection under subparagraphs (A) or (C) of section 902(a)(1).

"(2) Upon the termination or expiration of an order issued under this section, registrations of claims of protection in mask works made pursuant to that order shall remain valid for the period specified in section 904.

"(e) The authority of the Secretary of Commerce under this section shall commence on the date of the enactment of this chapter, and shall terminate three years after such date of enactment.

"(f)(1) The Secretary of Commerce shall promptly notify the Register of Copyrights and the Committees on the Judiciary of the Senate and the House of Representatives of the issuance or termination of any order under this section, together with a statement of the reasons for such action. The Secretary shall also publish such notification and statement of reasons in the Federal Register.

"(2) Two years after the date of the enactment of this chapter, the Secretary of Commerce, in consultation with the Register of Copyrights, shall transmit to the Committees on the Judiciary of the Senate and the House of Representatives a report on the actions taken under this section and on the current status of international recognition of mask work protection. The report shall include such recommendations for modifications of the protection accorded under this chapter to mask works owned by nationals, domiciliaries, or sovereign authorities of foreign nations as the Secretary, in consultation with the Register of Copyrights, considers would promote the purposes of this chapter and international comity with respect to mask work protection."

**TECHNICAL AMENDMENT**

Sec. 303. The table of chapters at the beginning of title 17, United States Code, is amended by adding at the end thereof the following new item:

"9. Protection of semiconductor chip products ..... 901"

**AUTHORIZATION OF APPROPRIATIONS**

Sec. 304. There are authorized to be appropriated such sums as may be necessary

to carry out the purposes of this title and the amendments made by this title.

Mr. MATHIAS. Mr. President, this amendment is offered on behalf of myself, the Senator from Utah [Mr. HATCH], and the Senator from Vermont [Mr. LEAHY] and the Senator from Alabama [Mr. HEFLIN]. It incorporates three measures: first, the Trademark Clarification Act, S. 1990, which was recently reported by the Judiciary Committee; second, the State Justice Institute Act, which the Senate passed unanimously last June; and third, the Semiconductor Chip Protection Act, S. 1201, when also received our unanimous approval, in May. In each case, the amendment contains compromise versions of this legislation, which we believe to be acceptable to the other body.

I ask unanimous consent that the following material be printed in the RECORD at this point: a Joint Explanatory Memorandum of Senator LEAHY and myself with respect to the semiconductor chip legislation.

There being no objection, the material ordered to be printed in the RECORD, follows:

**EXPLANATORY MEMORANDUM—MATHIAS—LEAHY AMENDMENT TO S. 1201**

**I. SEC. 901 (A) (5): COMMERCIAL EXPLOITATION**

The amendment sharpens the definition of "commercial exploitation," a concept that is important in determining when protection commences under the Act, and when it expires. In this definition, the amendment substitutes the words "for commercial purposes" for the phrase "for profit." Many non-profit organizations, such as universities, engage in research and development in the semiconductor chip product field. If such an organization distributes a new chip to others for commercial purposes, its not-for-profit status should not place it in a different position than an ordinary commercial business undertaking the same conduct. The ten-year term of protection should commence, and the clock should begin to run on the two-year registration requirement.

**II. OWNERSHIP—SECTION 901 (A) (6), 903 (A) - (B)**

The amendment includes a recession to H.R. 5525 (as passed by the House) on the question of the meaning of ownership of a mask work, in light of the business realities and practices of the semiconductor industry.

Under S. 1201, as passed by the Senate, general copyright law principles applied. Thus in theory, an exclusive licensee of each divisible right in a mask work would "own" that particular right and would be entitled to sue infringers thereunder. (E.g., the exclusive licensee of the right to distribute the semiconductor chip as a component inserted to a printed circuit board sold as such, east of the Connecticut River.) H.R. 5525 allowed only the "owner" of all of the rights in the mask work to sue for infringement.

The prospect of licensees of less than all rights bringing their own independent lawsuits could disrupt customary business arrangements and practices in the industry. To avoid this, the Senate is prepared to yield to the ownership concept of H.R. 5525.

Under Section 901(a) (6), the owner of a mask work is its creator, the creator's legal representatives, or the transferee of all rights under the Act in the mask work. These rights include the privilege of secur-

ing inchoate rights by registration of a mask work under Section 908(a). 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, an option that is not available to nonexclusive licensees and licensees of less than all rights.

### III. 902(B)—ORIGINALITY

The Mathias-Leahy amendment follows the House bill by including, in Section 902(b), a provision that makes mask works unprotectable under the Act if they are made up of "staple, familiar, or commonplace designs," or variations thereof, combined together in a way that, considered as a whole, is unoriginal. Like the House (see H. Rep. 98-781, at 19, 25) (hereafter "House Report"), we do not intend by Section 902(b) to set up an examination system in the Copyright Office. Rather, the question of invalidity on this ground is an issue to be raised for the first time by the defendant in an infringement suit (or, of course, by the plaintiff in a declaratory judgment action for a judgment of invalidity). Nonetheless, the evaluation of whether the design is staple, or merely an insubstantial variation on what is staple, should be made in the light of the prior art existing at the time of registration.

When a mask work owner goes into court with its registration certificate from the Copyrights Office, the mask work registration should be considered presumptively valid, and the registered mask work should be presumed to satisfy all of the requirements for protection under chapter 9, including Section 902(b). But if the defendant then adduces probative evidence of invalidity (e.g., that the mask work is "staple"), and not mere unsupported allegations of invalidity, we envision that the plaintiff mask work owner will be asked to come forward with actual testimonial or documentary evidence to overcome the defendant's evidence on validity. The test is the usual civil "preponderance of the evidence" standard. In a very close case, the certificate of registration should be given at least some measurable weight as prima facie evidence. Also, on emergency applications such as motions for temporary restraining orders and motions for preliminary injunctions, the registration should be assumed valid and proper unless the court is persuaded otherwise by probative and substantial evidence.

Finally, like the House (House Report at 19), we believe that section 902(b) does not make a mask work "staple" merely because, if the individual circles, arcs, rectangles, and lines of the mask work are dissected away from the whole mask work, they each appear "staple." The question for a court to resolve is whether a mask work, considered as a whole, is just a collection of such staple elements combined in an old, "staple" way? Stated another way, a court may have to decide whether a new mask work is just an insubstantial variation of prior work in the field as it stood on the date of registration. On the other hand, the work may be found protectable if it reflects effort and original contributions resulting in a work that, considered as a whole, is not old and staple. In that connection, although clearly a mask work need not meet the unobviousness requirements of 35 U.S.C. section 103, nonetheless the case law under that section of the Patent Act, which uses similar language, is instructive. It warns us not to dissect old elements away from a new combination, lest we run the danger of failing to recognize

the novelty and intellectual creativity of the combination considered as a whole. Although it is impossible to quantify a creativity standard precisely and objectively, the purpose of section 902(b)(2) is to weed out mere insubstantial or trivial variations on prior mask works and to allow protection of new mask works in the creation of which their owners have expended substantial toil and investment, and which contain more than insubstantial variations on the prior mask work art.

### IV. RECORDATION—SECTION 930(C)

S. 1201 did not have a recordation section for ownership, transfer and licensing because as part of the Copyright Act it automatically included 17 U.S.C. Section 205. H.R. 5525 similarly lacked a recordation section, and this amendment therefore inserts one. Mask work owners and other concerned parties are entitled to record transfers and licenses relating to mask works in the Copyright Office. Recordation constitutes constructive notice of the transfer or license. In this connection, a security interest under the Uniform Commercial Code or other state law may also be recorded as a transfer.

### V. DURATION OF PROTECTION—SECTION 904

S. 1201 provided mask work protection from the initial fixation of a mask work, such as in a drawing. See 17 U.S.C. Section 101 (definitions of "created" and "fixed"), 102(a). Section 904(a) of H.R. 5525 began protection for mask works only when they are registered (after fixation of the work in a semiconductor chip product) or upon their first commercial exploitation, whichever comes first. This amendment basically adopts the House language. As a result, state trade secret law (rather than this Act) is the principal safeguard for mask work owners until registration or first commercial exploitation occurs. Accordingly, state trade secret law is not preempted under Section 912(c) until the earlier of those two events occurs, since until that point the protection provided by trade secret law is not "equivalent" to that provided by this Act.

The words "anywhere in the world" are added in Section 904(a) to clarify and carry forward the original intent of that provision. A change is made in Section 904(b) to clarify how long mask work protection continues after its commencement: it is, mask work protection continues until the end of the calendar year of the tenth year after registration or first commercial exploitation, whichever is first. To accomplish this end, a new Section 904(c) is added to make this section conform to 17 U.S.C. Section 305, a provision of the Copyright Act previously incorporated by S. 1201.

### VI. EXCLUSIVE RIGHTS—SECTION 905

This amendment incorporates H.R. 5525's shorter list of exclusive rights, on the basis of the House Report's assurance that reproduction under Section 905(1) embraces all of the various reproduction rights of S. 1201's section 4 (amending 17 U.S.C. section 105). Also, since the "inducing infringement" and "causing infringement" provisions of Section 905(3) cover the Senate bill's prohibition of distribution of pirated masks, Section 905 is at least as comprehensive as S. 1201's section 4.

### VII. REVERSE ENGINEERING—SECTION 906(A)

Although the reverse engineering provisions of S. 1201 and H.R. 5525 were almost identical, this amendment includes a provision (section 906 (a)(2)) to clarify the intent of both chambers that competitors are permitted not only to study protected mask works, but also to use the results of that study to design, distribute and import semiconductor chip products embodying their own original mask works. While this in-

tent appears indisputable from the legislative history in both Houses, it seems prudent to spell it out in the bill itself.

The end product of the reverse engineering process is not an infringement, and itself qualifies for protection under the Act, if it is an original mask work, as contrasted with a substantial copy. If the resulting semiconductor chip product is not substantially identical to the original, and its design involved significant toil and investment so that it is not a mere plagiarism, it does not infringe the original chip, even if the layout of the two chips is, in substantial part, similar. As noted in the Senate report, the courts are not likely, as a practical matter, to find it unduly difficult to draw the line between reverse engineering and infringement, because the additional work required to come within the privilege established by section 906(a) will ordinarily leave a "paper trail."

Of course, apart from the foregoing, the amendment, like both bills, incorporates the familiar copyright principle of substantial similarity. Although, as a practical matter, copying of an insubstantial portion of a chip and independent design of the remainder is not likely, copying of a material portion nevertheless constitutes infringement. This concept is particularly important in the semiconductor chip industry, where it may be economical, for example, to copy 75% of a mask work from one chip and combine that with 25% of another mask work, if the copies parts are transferable modules, such as units from a cell library.

As the Senate report notes, no hard and fast percentages govern what constitutes a "substantial" copying because substantial similarity may exist where an important part of a mask work is copied even though the percentage copied may be relatively small. Nonetheless, mask work owners are protected not only from wholesale copying but also against piecemeal copying of substantial or material portions of one or more mask works.

### VIII. FIRST SALE—SECTION 906(B)

Section 906(b) of the amendment clarifies the application of the first sale doctrine to mask works. Among other things, it now is made clear that a customer is free to use a semiconductor chip product unit as he chooses, after becoming its owner by buying it from the mask work owner or its licensee. However, the customer's permissible use does not include reproducing the semiconductor chip product (except in the course of reverse engineering, which is separately governed under Section 906(a)).

### IX. INNOCENT INFRINGEMENT—SECTION 907

The intent and contours of this provision were similar in the two bills, but the House's version is simpler in form, so this amendment incorporates it. In this connection, it should be understood that, as in the case of the first sale rule of Section 906(b), the first payment of a reasonable royalty under Section 907 liberates the semiconductor chip product unit from the intellectual property monopoly, for the benefit of all downstream purchasers; only one reasonable royalty per unit may be required under Section 907.

### X. REGISTRATION—SECTION 908

In general, this Section follows the pattern of H.R. 5525, which in turn largely replicates the corresponding provisions of the Copyright Act. Those provisions had been automatically incorporated by S. 1201, which was part of the Copyright Act.

Some technical changes were necessary, however, to correct errors and omissions in the House Bill. Thus, we have revised Sec-

tion 908(a) to authorize mask work owners to file applications for registration under the Act. Also, Section 908(c) is amended to require applicants to pay a fee, and to submit identifying materials prescribed by the Copyright Office. Applicants should not, of course, be required to deposit material that would disclose trade secrets or would facilitate domestic or foreign chip piracy; we would anticipate that the Copyright Office's implementing regulations should reflect this principle to the greatest extent possible.

Further, Section 908(g) is modified to permit applicants to go immediately to court in emergency situations, such as a flood of piratical imports, or when there is other "good cause" why they cannot wait for up to four months for the Copyright Office to complete its processes. For an intellectual property owner to secure an order of exclusion of such piratical imports from the United States, a registration certificate must ordinarily be provided to the Customs Service or (in an unfair import practices case) to the International Trade Commission, and thus a registration may be necessary at once.

Section 908(f) deals with the legal effect of the issuance of a registration certificate. As noted above, a registrant has what amounts to a rebuttable presumption of the validity of the registrant's claim of protection under chapter 9, which may only be overcome by probative, plausible evidence, not by mere allegations of invalidity or statements made on "information and belief". The ordinary civil standard of preponderance of the evidence is applicable on the validity issue.

It would be inappropriate to require the clear and convincing evidence that some patent cases have called for to overcome the presumption of patent validity. Patents issue on inventions after an examination of their novelty, unobviousness, and compliance with other substantive requirements; the examination is carried out by persons supposed to be of skill in the relevant field of technology, so that the decision to issue a patent reflects a considered and expert judgment on the merits. But mask work registration certificates, like copyright registration certificates, issue after an examination of only the face of the application form and a necessarily cursory examination of the identifying material accompanying the application, perhaps aided by other facts of which the Copyright Office may be aware. The Copyright Office cannot be expected to deliver a considered judgment on the technical questions involved in Section 902(b). Instead, the Copyright Office issues the registration certificate if the application appears to be in order and then, as the House Report notes, "In the event of mask work infringement litigation, failure to satisfy the requirements of Section 902(b) would be a defense." House Report, at 19.

If the rare case arises where the evidence is exactly balanced on both sides, or the plaintiff rests on its certificate and the defendant elects to put in no evidence, the certificate should be enough to permit the court to assume that the plaintiff has a valid and proper registration. If nothing else, this can be rested on the presumption of regularity and correctness of an agency's administrative action. Moreover, on applications for a preliminary injunction or similar relief, where the court does not have the opportunity to canvass the issues as thoroughly as at trial, it is proper to put some weight on the certificate. In these situations, giving the mask work registrant the benefit of the doubt furthers the statutory purpose of promoting security of investment in develop-

ment of new chip technology and thereby encouraging semiconductor innovation.

#### XI. NOTICE—SECTION 909

S. 1201 included the Copyright Act's mandatory notice and use of ©. H.R. 5525 created a new, M-in-a-circle symbol for its non-mandatory notice, and also allowed use of the words "Mask Work". Since printers do not usually carry M-in-a-circle symbols in stock, and most typewriters and word processing equipment also lack them, the amendment provides an alternative abbreviation: "M\*". The amendment also follows 17 U.S.C. Sec. 401(b)(2)'s elimination of the date for notice on useful articles. In promulgating notice regulations, the Copyright Office may permit combined copyright/mask work notices to conserve space.

#### XII. COMMERCE—SECTION 910 (A)

In order to avoid any constitutional questions on the issue of whether, as both Houses found, mask works are protectable as "writings" within the meaning of the Constitution's intellectual property clause, section 910(a) of the amendment includes a commerce limitation, so that it reaches only piratical conduct in or affecting commerce. As a practical matter, this will cover virtually all of the kind of conduct that gave rise to this legislation.

#### XIII. ENFORCEMENT—SECTIONS 910 AND 911

Changes to the House bill are also made in other parts of section 910. In section 910(b), a clause is added to make it clear that a timely registrant may sue for pre-registration damages (as well as for post-registration damages) so long as they occur as a result of conduct during the ten-year term. Additional clarification of section 910(b) permits the exclusive licensee of all rights in a mask work to sue, as an owner may. A change in section 910(c) permits the Customs Service to exclude not only piratical copies but also products used for purposes of contributory infringement in violation of the rights of mask work owners.

Section 911(e)(1) restores impounding orders S. 1201 included these from the Copyright Act, but H.R. 5525 omitted them. Like temporary restraining orders and preliminary injunctions, impounding orders are a useful and important remedy, if not abused. To prevent such abuse, the amendment provides that applications for impounding orders should be heard, where practicable, in the same manner as applications for temporary restraining orders and preliminary injunctions, i.e., not ex parte, and with customary procedural safeguards.

Section 911(f) provides for attorneys' fees for prevailing parties in all civil actions arising under the Semiconductor Chip Protection Act, including declaratory judgment actions.

#### XIV. RELATION TO OTHER LAWS—SECTION 912

The relationship of the Semiconductor chip Protection Act to other laws is made somewhat complicated by the uncertainty of the application of those laws to mask works—the very predicament that motivated this legislation in the first place.

Enactment of this bill will provide an explicit federal remedy for misappropriation and unauthorized copying of mask works. Within the carefully defined ambit of the reach of this legislation, the remedy it provides is intended to be exclusive. However, four factors limit the effect of this principle.

First, as expressed in section 912(e), nothing in the bill affects rights in mask works first commercially exploited prior to July 1, 1983. The rights that remain untouched by this bill include claims arising under the Copyright Act. As the Senate report noted, the availability of copyright protection for

mask works was "sufficiently doubtful" to discourage investment and innovation; but this amendment should clarify that Congress does not find that such protection is unavailable. The decision not to provide relief under this Act for future misappropriations of mask works that came to market before July 1, 1983 should not be misinterpreted as a conclusion that no such protection ought to be accorded. To the contrary, the policy underlying this Act condemns unauthorized copying even of these earlier chips as unfair.

With respect to state law, the same principles apply. The states are permitted to regulate these older chips as they see fit, so long as the state enactment does not directly conflict with some other federal law. See *Goldstein v. California*, 412 U.S. 546 (1973). Of course, since state contract law is not affected by this Act, existing license agreements with respect to per-July 1, 1983 mask works may still be enforced. Nor are future enactments, or future decisions of state or federal courts, barred from this field. As to chips first commercially exploited prior to July 1, 1983, this legislation simply has no preemptive effect.

Second, with respect to mask works first commercially exploited after July 1, 1983, the preemption of "equivalent" state law remedies is ineffective until January 1, 1986. This provision of the amendment, section 912(c), conforms with the House bill.

The third limiting principle is that state law remedies which are not "equivalent" are not preempted, even after January 1, 1986, unless they directly conflict with the federal act. As the House Report recognized, at page 29, "state trade secret law is a necessary adjunct to this Act, and provides a needed protection during a time period when this law provides none," referring to the period prior to commercial exploitation or registration.

Finally, enactment of the bill has no preemptive or superseding effect upon other, more general legislation which may affect the semiconductor industry, e.g., unfair trade practice laws or patent laws.

Subject to these limiting principles, the Act is intended to provide an exclusive remedy. Congress does not intend to provide protection which is (as to post-July 1, 1983 chips) cumulative to the protections that may be claimed under the Copyright Act; as to these chips, the Act will replace copyright protection. Similarly, the privileges created by this Act, such as the reverse engineering right, may not be restricted by reference to the narrower privileges that obtain under copyright, such as fair use. The legislative history of this bill includes repeated assurances that mask work protection in no way erodes copyright protection for subject matter such as computer programs or data bases, even if that subject matter is embodied in a semiconductor chip. The converse is also true; assertions of copyright in mask works masquerading as copyright subject matter should not be permitted to detract from the integrity and exclusivity of the protection scheme created by this Act.

#### XV. TRANSITIONAL PROVISION—SECTION 913

The amendment follows the general concept of H.R. 5525, with some important changes and clarifications.

The Semiconductor Chip Protection Act is fully effective upon enactment. However, section 913(a) holds the registration and enforcement mechanisms in abeyance for sixty days, to allow adequate time for the Copyright Office to prepare to receive applications for registration.

“§ 1657. Priority of civil actions

“(a) Notwithstanding any other provision of law, each court of the United States shall determine the order in which civil actions are heard and determined, except that the court shall expedite the consideration of any action brought under chapter 153 or section 1826 of this title, any action for temporary or preliminary injunctive relief, or any other action if good cause therefor is shown. For purposes of this subsection, ‘good cause’ is shown if a right under the Constitution of the United States or a Federal Statute (including rights under section 552 of title 5) would be maintained in a factual context that indicates that a request for expedited consideration has merit.

“(b) The Judicial Conference of the United States may modify the rules adopted by the courts to determine the order in which civil actions are heard and determined, in order to establish consistency among the judicial circuits.”

(b) The section analysis of chapter 111 of title 28, United States Code, is amended by adding at the end thereof the following new item:

“1657. Priority of civil actions.”

AMENDMENTS TO OTHER LAWS

SEC. 402. The following provisions of law are amended—

(1)(A) Section 309(a)(10) of the Federal Election Campaign Act of 1971 (2 U.S.C. 437g(a)(10)) is repealed.

(B) Section 310(c) of the Federal Election Campaign Act of 1971 (2 U.S.C. 437h(c)), is repealed.

(2) Section 552(a)(4)(D) of title 5, United States Code, is repealed.

(3) Section 6(a) of the Commodity Exchange Act (7 U.S.C. 8(a)) is amended by striking out “The proceedings in such cases in the court of appeals shall be made a preferred cause and shall be expedited in every way.”

(4)(A) Section 6(c)(4) of the Federal Insecticide, Fungicide, and Rodenticide Act (7 U.S.C. 136d(c)(4)) is amended by striking out the second sentence.

(B) Section 10(d)(3) of the Federal Insecticide, Fungicide, and Rodenticide Act (7 U.S.C. 136h(d)(3)) is amended by striking out “The court shall give expedited consideration to any such action.”

(C) Section 16(b) of the Federal Insecticide, Fungicide, and Rodenticide Act (7 U.S.C. 136n(b)) is amended by striking out the last sentence.

(D) Section 25(a)(4)(E)(iii) of the Federal Insecticide, Fungicide, and Rodenticide Act (7 U.S.C. 136w(a)(4)(E)(iii)) is repealed.

(5) Section 204(d) of the Packers and Stockyards Act, 1921 (7 U.S.C. 194(d)), is amended by striking out the second sentence.

(6) Section 366 of the Agricultural Adjustment Act of 1938 (7 U.S.C. 1366) is amended in the fourth sentence by striking out “At the earliest convenient time, the court, in term time or vacation,” and inserting in lieu thereof “The court”.

(7)(A) Section 410 of the Federal Seed Act (7 U.S.C. 1600) is amended by striking out “The proceedings in such cases in the court of appeals shall be made a preferred cause and shall be expedited in every way.”

(B) Section 411 of the Federal Seed Act (7 U.S.C. 1601) is amended by striking out “The proceedings in such cases shall be made a preferred cause and shall be expedited in every way.”

(8) Section 816(c)(4) of the Act of October 7, 1975, commonly known as the Department of Defense Appropriation Authorization Act of 1976 (10 U.S.C. 2304 note) is amended by striking out the last sentence.

(9) Section 5(d)(6)(A) of the Home Owners’ Loan Act of 1933 (12 U.S.C. 1464(d)(6)(A)) is amended by striking out “Such proceedings shall be given precedence over other cases pending in such courts, and shall be in every way expedited.”

(10)(A) Section 7A(f)(2) of the Clayton Act (15 U.S.C. 18a(f)(2)) is amended to read as follows: “(2) certifies to the United States district court for the judicial district within which the respondent resides or carries on business, or in which the action is brought, that it or he believes that the public interest requires relief pendente lite pursuant to this subsection, then upon the filing of such motion and certification, the chief judge of such district court shall immediately notify the chief judge of the United States court of appeals for the circuit in which such district court is located, who shall designate a United States district judge to whom such action shall be assigned for all purposes.”

(B) Section 11(e) of the Clayton Act (15 U.S.C. 21(e)) is amended by striking out the first sentence.

(11) Section 1 of the Act of February 11, 1903, commonly known as the Expediting Act (15 U.S.C. 28) is repealed.

(12) Section 5(e) of the Federal Trade Commission Act (15 U.S.C. 45(e)) is amended by striking out the first sentence.

(13) Section 21(f)(3) of the Federal Trade Commission Improvements Act of 1980 (15 U.S.C. 57a-1(f)(3)) is repealed.

(14) Section 11A(c)(4) of the Securities Exchange Act of 1934 (15 U.S.C. 78k-1(c)(4)) is amended—

(A) by striking out “(A)” after “(4)”; and

(B) by striking out paragraph (B).

(15)(A) Section 309(e) of the Small Business Investment Act of 1958 (15 U.S.C. 687a(e)) is amended by striking out the sixth sentence.

(B) Section 309(f) of the Small Business Investment Act of 1958 (15 U.S.C. 687a(f)) is amended by striking out the last sentence.

(C) Section 311(a) of the Small Business Investment Act of 1958 (15 U.S.C. 687(c)(a)) is amended by striking out the last sentence.

(16) Section 10(c)(2) of the Alaska Natural Gas Transportation Act (15 U.S.C. 719h(c)(2)) is repealed.

(17) Section 155(a) of the National Traffic and Motor Vehicle Safety Act of 1966 (15 U.S.C. 1415(a)) is amended by striking out “(1)” and by striking out paragraph (2).

(18) Section 503(b)(3)(E) of the Motor Vehicle Information and Cost Savings Act (15 U.S.C. 2003(b)(3)(E)) is amended by striking out clause (ii) and redesignating clauses (iii) and (iv) as clauses (ii) and (iii), respectively.

(19) Section 23(d) of the Toxic Substances Control Act (15 U.S.C. 2622(d)) is amended by striking out the last sentence.

(20) Section 12(e)(3) of the Coastal Zone Management Improvement Act of 1980 (16 U.S.C. 1463a(e)(3)) is repealed.

(21) Section 11 of the Act of September 28, 1976 (16 U.S.C. 1910), is amended by striking out the last sentence.

(22)(A) Section 807(b) of the Alaska National Interest Lands Conservation Act (16 U.S.C. 3117(b)) is repealed.

(B) Section 1108 of the Alaska National Interest Lands Conservation Act (16 U.S.C. 3168) is amended to read as follows:

“INJUNCTIVE RELIEF

“Sec. 1108. No court shall have jurisdiction to grant any injunctive relief lasting longer than ninety days against any action pursuant to this title except in conjunction with a final judgment entered in a case involving an action pursuant to this title.”

(23)(A) Section 10(b)(3) of the Central Idaho Wilderness Act of 1980 (Public Law 96-312; 94 Stat. 948) is repealed.

(B) Section 10(c) of the Central Idaho Wilderness Act of 1980 is amended to read as follows:

“(c) Any review of any decision of the United States District Court for the District of Idaho shall be made by the Ninth Circuit Court of Appeals of the United States.”

(24)(A) Section 1964(b) of title 18, United States Code, is amended by striking out the second sentence.

(B) Section 1966 of title 18, United States Code, is amended by striking out the last sentence.

(25)(A) Section 408(l)(5) of the Federal Food, Drug, and Cosmetic Act (21 U.S.C. 346a(l)(5)) is amended by striking out the last sentence.

(B) Section 409(g)(2) of the Federal Food, Drug, and Cosmetic Act (21 U.S.C. 348(g)(2)) is amended by striking out the last sentence.

(26) Section 8(f) of the Foreign Agents Registration Act of 1938 (22 U.S.C. 618(f)) is amended by striking out the last sentence.

(27) Section 4 of the Act of December 22, 1974 (25 U.S.C. 640d-3), is amended by striking out “(a)” and by striking out subsection (b).

(28)(A) Section 3310(e) of the Internal Revenue Code of 1954 (26 U.S.C. 3310 (e)) is repealed.

(B) Section 6110(f)(5) of the Internal Revenue Code of 1954 (26 U.S.C. 6110(f)(5)) is amended by striking out “and the Court of Appeals shall expedite any review of such decision in every way possible”.

(C) Section 6363(d)(4) of the Internal Revenue Code of 1954 (26 U.S.C. 6363(d)(4)) is repealed.

(D) Section 7609(h)(3) of the Internal Revenue Code of 1954 (26 U.S.C. 7609 (h)(3)) is repealed.

(E) Section 9010(c) of the Internal Revenue Code of 1954 (26 U.S.C. 9010(C)) is amended by striking out the last sentence.

(F) Section 9011(b)(2) of the Internal Revenue Code of 1954 (26 U.S.C. 9011 (b)(2)) is amended by striking out the last sentence.

(29)(A) Section 596(a)(3) of title 28, United States Code, is amended by striking out the last sentence.

(B) Section 636(c)(4) of title 28, United States Code, is amended in the second sentence by striking out “expeditious and”.

(C) Section 1296 of title 28, United States Code, and the item relating to that section in the section analysis of chapter 83 of that title, are repealed.

(D) Subsection (c) of section 1364 of title 28, United States Code, the section heading of which reads “Senate actions”, is repealed.

(E) Section 2284(b)(2) of title 28, United States Code, is amended by striking out the last sentence.

(F) Section 2349(b) of title 28, United States Code, is amended by striking out the last two sentences.

(G) Section 2647 of title 28, United States Code, and the item relating to that section in the section analysis of chapter 169 of that title, are repealed.

(30) Section 10 of the Act of March 23, 1932, commonly known as the Norris-LaGuardia Act (29 U.S.C. 110), is amended by striking out “with the greatest possible expedition” and all that follows through the end of the sentence and inserting in lieu thereof “expeditiously”.

(31) Section 10(i) of the National Labor Relations Act (29 U.S. 160(i)) is repealed.

(32) Section 11(a) of the Occupational Safety and Health Act of 1970 (29 U.S.C. 660(a)) is amended by striking out the last sentence.

(33) Section 4003(e)(4) of the Employee Retirement Income Security Act of 1974 (29 U.S.C. 1303(e)(4)) is repealed.

Section 913(b) clarifies that the bill has no retroactive effect. No act of chip piracy that occurred prior to the date of enactment is an actionable infringement. The disposition of semiconductor chip products that result from such pre-enactment unauthorized copying is governed by section 913(d).

Subsection (d) deals with protection of mask works first commercially exploited between July 1, 1983 and the date of enactment. Unauthorized copies of chips embodying these mask works may be imported or distributed, subject to two important conditions. First, the importation and distribution privilege applies only to semiconductor chip product units that were in existence on the date of enactment. In other words, existing inventory may be disposed of, but further manufacture must cease upon enactment. Second, the importer or distributor must agree to pay a reasonable royalty to the mask work owner. If he does not agree, or if he fails to make such payments, the importer or distributor forfeits the privilege, and the mask work owner may make use of the remedies provided for post-enactment mask works, including injunctions and exclusion orders.

The owner of a mask work first commercially exploited after July 1, 1983 but before enactment may obtain protection (subject to the privilege just described) by registering the mask work with the Copyright Office before July 1, 1985. The privilege terminates two years after such registration. Thus, by July 1, 1987, all privileges will have expired, and the pre-enactment mask work will be treated identically to one first commercially exploited after enactment. The two-year period provides ample time to dispose of inventory of unauthorized copies of chips, and removes from litigation within a reasonable time the potentially contentious factual issue of when a particular semiconductor chip product unit was manufactured.

#### XVI. INTERNATIONAL TRANSITION—SECTION 914

H.R. 5525 would deny protection to foreign owners of mask works unless the works were first commercially exploited in the U.S. While it was contemplated that foreign countries would eventually obtain full protection by concluding treaties or enacting chip protection legislation, no protection was available in the interim other than by transferring rights to a U.S. national or domiciliary before first commercial exploitation. In order to encourage such steps toward a regime of international comity in mask work protection, the amendment includes international transitional provisions, contained in Section 914.

Section 914(a) provides that the Secretary of Commerce may extend the privilege of interim protection under the Semiconductor Chip Act to nationals of foreign nations under certain conditions. These are: (1) that the foreign nation in question is making progress (either by treaty negotiation or legislative enactment) toward a regime of mask work protection generally similar to that under the Act; (2) that its nationals and persons controlled by them (such as subsidiaries or affiliated companies) are not engaging and have not in the recent past engaged in chip piracy or the sale of products containing pirated semiconductor components; and (3) that entry of the Secretary's order would promote the purposes of the Act and of achieving international comity toward mask work protection.

The Secretary is particularly well situated to make these determinations because of the Department's broad ranging intellectual property and trade responsibilities. The Assistant Secretary of Commerce and Commis-

sioner of Patents and Trademarks is in a position to evaluate the legal adequacy of proposed foreign legislation and, as well, can advise the Secretary on the international intellectual property law aspects of foreign chip protection. The International Trade Administration with its worldwide network of Foreign Commercial Service Officers in the United States Embassies is in a position to provide input on commercial activities in foreign countries where there may be concern with actual or potential misappropriation of United States semiconductor chip products. The Secretary thus will have the benefit of a balanced consideration of legal and trade issues to draw in making the determination to extend, deny, or withdraw the interim protection provided under section 914.

In making determinations of good faith efforts and progress (section 914(a)(1)), the Secretary should take into account the attitudes and efforts of the foreign nation's private sector, as well as its government. If the private sector encourages and supports action toward chip protection, that progress is much more likely to continue. With respect to the participation of foreign nationals and those controlled by them in chip piracy, the Secretary should consider whether any chip designs, not simply those provided full protection under the Act, are subjected to misappropriation. The degree to which a foreign concern that distributes products containing misappropriated chips knows or should have known that it is trafficking in pirated chips is a relevant factor in making a finding under section 914(a)(2). Finally, under section 914(a)(3), the Secretary should bear in mind the role that issuance of the order itself may have in promoting the goal of international comity, while ensuring that transitional protection is not being used to shelter continued chip piracy.

The Secretary's order is to be made in an informal rulemaking proceeding, reviewable in an appropriate district court under the Administrative Procedures Act for abuse of discretion or want of substantial evidence. If the privilege of interim protection is abused, or if the conditions that led to its issuance appear to the Secretary no longer to exist, the Secretary may rescind the order in a further informal rulemaking proceeding (or simply allow it to expire). Proceedings may be initiated by the Secretary upon his own motion or at the request of a foreign nation, or other interested party. The Secretary may begin any such proceeding and may issue an appropriate order at any time after the enactment of this Act. In the case of those countries already having a system allowing mask work protection, or having substantial semiconductor industries, expedited action may be particularly appropriate to encourage and facilitate efforts to establish international comity. Also, the Secretary has discretion to make his order effective as of the date he receives a request to initiate a proceeding under Section 914.

The Secretary may set the expiration date of the order. A short term order may be appropriate where progress is not substantial enough to justify a longer order. Thus, a foreign nation might be unable actually to introduce any proposed law for the protection of semiconductor chip products, because its parliament is out of session. Yet, it might be able to announce its intention to propose such a law, and then appoint a study group to draft appropriate legislation that would be consistent with stated general principles. In such circumstances, it would be appropriate that the Secretary enter a short term order, and subsequently re-evaluate the situation. If reasonable progress was being made, the Secretary would then issue

a further order for an additional appropriate period.

The interim protection would permit citizens of the relevant foreign nation to apply for mask work registration under Section 908, to sue for infringement of mask work rights under Section 910(b), and to secure legal and equitable remedies under Section 911, as United States citizens may, during the 10-year terms of their mask work registrations. If a Secretarial order were rescinded, the effect would be to withdraw the privilege of further registrations, but not the 10-year period of rights under those registrations previously issued.

The Secretary's power under this section is limited to three years, and all orders issued will expire at that time. In consultation with the Register of Copyrights, the Secretary is to report to the Congress one year before the expiration of his authority, as to the progress being made toward international comity in mask work protection, and as to the further steps, if any, that are believed appropriate. Of course, aside from the interim order procedure created by section 914, it remains possible for a foreign concern to obtain mask work protection in the U.S. by transferring all rights under the Act to a U.S. national or domiciliary before the mask work is commercially exploited, or by commercially exploiting the mask work first in the United States. As noted above, a transferee of all rights (under this Act) in the mask work is an "owner," and the nationality of ownership on the date of registration or first commercial exploitation (whichever occurs first) governs eligibility for protection under section 902(a)(1)(A). Thus, if a foreign subsidiary of a U.S. company owns a mask work that has not been commercially exploited, it may transfer all rights under this Act to its U.S. parent; the parent would then be entitled to obtain protection under this Act by registering the mask work or commercially exploiting it. By the same token, a U.S. subsidiary of a foreign company would be entitled to claim protection under the bill for a mask work created by its foreign parent by securing a transfer of all rights under this Act from the parent prior to first commercial exploitation. Finally, under section 902(a)(1)(B), a mask work that is first commercially exploited in the United States is eligible for protection, regardless of the nationality of its owner.

#### AMENDMENT NO. 6996

Mr. BAKER. Mr. President, I send to the desk an amendment to the substitute, on behalf of Senator DOLE and Senator MATHIAS.

The PRESIDING OFFICER. The amendment will be stated.

The legislative clerk read as follows:

The Senator from Tennessee [Mr. BAKER], for Mr. MATHIAS and Mr. DOLE, proposes an amendment numbered 6996.

Mr. BAKER. Mr. President, I ask unanimous consent that reading of the amendment be dispensed with.

The PRESIDING OFFICER. Without objection, it is so ordered.

The amendment is as follows:

#### TITLE IV—FEDERAL COURTS IMPROVEMENTS

##### Subtitle A—Civil Priorities

#### ESTABLISHMENT OF PRIORITY OF CIVIL ACTIONS

SEC. 401. (a) Chapter 111 of title 28, United States Code, is amended by adding at the end thereof the following new section:

(34) Section 106(a)(1) of the Federal Coal Mine Health and Safety Act of 1969 (30 U.S.C. 816(a)(1)) is amended by striking out the last sentence.

(35) Section 1016 of the Impoundment Control Act of 1974 (31 U.S.C. 1406) is amended by striking out the second sentence.

(36) Section 2022 of title 38, United States Code, is amended by striking out "The court shall order speedy hearing in any such case and shall advance it on the calendar."

(37) Section 3628 of title 39, United States Code, is amended by striking out the fourth sentence.

(38) Section 1450(i)(4) of the Public Health Service Act (42 U.S.C. 300j-9(1)(4)) is amended by striking out the last sentence.

(39) Section 304(e) of the Social Security Act (42 U.S.C. 504(e)) is repealed.

(43) Section 814 of the Act of April 11, 1968 (42 U.S.C. 3614), is repealed.

(44) The matter under the subheading "Exploration of National Petroleum Reserve in Alaska" under the headings "ENERGY and MINERALS" and "GEOLOGICAL SURVEY" in title I of the Act of December 12, 1980 (94 Stat. 2964; 42 U.S.C. 6508), is amended in the third paragraph by striking out the last sentence.

(45) Section 214(b) of the Emergency Energy Conservation Act of 1979 (42 U.S.C. 8514(b)) is repealed.

(46) Section 2 of the Act of February 25, 1885 (43 U.S.C. 1062), is amended by striking out "; and any suit brought under the provisions of this section shall have precedence for hearing and trial over other cases on the civil docket of the court, and shall be tried and determined at the earliest practicable day".

(47) Section 23(d) of the Outer Continental Shelf Lands Act (43 U.S.C. 1349(d)) is repealed.

(48) Section 511(c) of the Public Utilities Regulatory Policies Act of 1978 (43 U.S.C. 2011(c)) is amended by striking out "Any such proceeding shall be assigned for hearing at the earliest possible date and shall be expedited by such court."

(49) Section 203(d) of the Trans-Alaska Pipeline Authorization Act (43 U.S.C. 1652(d)) is amended by striking out the fourth sentence.

(50) Section 5(f) of the Railroad Unemployment Insurance Act (45 U.S.C. 355(f)) is amended by striking out ", and shall be given precedence in the adjudication thereof over all other civil cases not otherwise entitled by law to precedence".

(51) Section 305(d)(2) of the Regional Rail Reorganization Act of 1973 (45 U.S.C. 745(d)(2)) is amended—

(A) in the first sentence by striking out "Within 180 days after" and inserting in lieu thereof "After"; and

(B) in the last sentence by striking out "Within 90 days after" and inserting in lieu thereof "After".

(52) Section 124(b) of the Rock Island Transition and Employee Assistance Act (45 U.S.C. 1018(b)) is amended by striking out ", and shall render a final decision no later than 60 days after the date the last such appeal is filed".

(53) Section 402(g) of the Communications Act of 1934 (47 U.S.C. 402(g)) is amended—

(A) by striking out "At the earliest convenient time the" and inserting in lieu thereof "The"; and

(B) by striking out "10(e) of the Administrative Procedure Act" and inserting in lieu thereof "706 of title 5, United States Code".

(54) Section 405(e) of the Surface Transportation Assistance Act of 1982 (Public Law 97-424; 49 U.S.C. 2305(e)) is amended by striking out the last sentence.

(55) Section 606(c)(1) of the Rail Safety and Service Improvement Act of 1982 (Public Law 97-468; 49 U.S.C. 1205(c)(1)) is amended by striking out the second sentence.

(56) Section 13A(a) of the Subversive Activities Control Act of 1950 (50 U.S.C. 792a note) is amended in the third sentence by striking out "or any court".

(57) Section 12(a) of the Military Selective Service Act of 1967 (50 U.S.C. App. 462(a)) is amended by striking out the last sentence.

(58) Section 4(b) of the Act of July 2, 1948 (50 U.S.C. App. 1984(b)), is amended by striking out the last sentence.

#### EFFECTIVE DATE

Sec. 403. The amendments made by this subtitle shall not apply to cases pending on the date of the enactment of this subtitle.

#### Subtitle B—District Court Organization

Sec. 404. This subtitle may be cited as the "Federal District Court Organization Act of 1984".

Sec. 405. The second sentence of subsection (c) of section 112 of title 28, United States Code, is amended to read as follows: "Court for the Eastern District shall be held at Brooklyn, Hauppauge, and Hempstead (including the village of Uniondale)."

Sec. 406. (a) Subsection (a) of section 93 of title 28, United States Code, is amended—

(1) in paragraph (1) by striking out "De Kalb," and "McHenry,"; and

(2) in paragraph (2)—

(A) by inserting "De Kalb," immediately after "Carroll,"; and

(B) by inserting "McHenry," immediately after "Lee,".

(b) The amendments made by subsection (a) of this section shall apply to any action commenced in the United States District Court for the Northern District of Illinois on or after the effective date of this subtitle, and shall not affect any action pending in such court on such effective date.

(c) The second sentence of subsection (b) of section 93 of title 28, United States Code, is amended by inserting "Champaign/Urbana," before "Danville."

Sec. 407. (a) Subsection (b) of section 124 of title 26, United States Code, is amended—

(1) by striking out "six divisions" and inserting in lieu thereof "seven divisions";

(2) in paragraph (4) by striking out "Hidalgo, Starr,"; and

(3) by adding at the end thereof the following:

"(7) The McAllen Division comprises the counties of Hidalgo and Starr.

"Court for the McAllen Division shall be held at McAllen."

(b) The amendments made by subsection (a) of this section shall apply to any action commenced in the United States District Court for the Southern District of Texas on or after the effective date of this subtitle, and shall not affect any action pending in such court on such effective date.

Sec. 408. (a) Paragraph (1) of section 90(a) of title 28, United States Code, is amended—

(1) by inserting "Fannin," after "Dawson,";

(2) by inserting "Gilmer," after "Forsyth,"; and

(3) by inserting "Pickens," after "Lumpkin,".

(b) Paragraph (2) of section 90(a) of title 28, United States Code, is amended by striking out "Fannin," "Gilmer," and "Pickens,".

(c) Paragraph (6) of section 90(c) of title 28, United States Code, is amended by striking out "Swainsboro" each place it appears and inserting in lieu thereof "Statesboro".

(d) The amendments made by this section shall apply to any action commenced in the United States District Court for the North-

ern District of Georgia on or after the effective date of this subtitle, and shall not affect any action pending in such court on such effective date.

Sec. 409. Section 85 of title 28, United States Code, is amended by inserting "Boulder," before "Denver".

Sec. 410. The second sentence of section 126 of title 28, United States Code, is amended by inserting "Bennington," before "Brattleboro".

Sec. 411. (a) The amendments made by this subtitle shall take effect on January 1, 1985.

(b) The amendments made by this subtitle shall not affect the composition, or preclude the service, of any grand or petit jury summoned, impaneled, or actually serving on the effective date of this subtitle.

#### "Subtitle C—Amendments to the Federal Courts Improvements Act of 1982"

This subtitle may be cited as the "Technical Amendments to the Federal Courts Improvement Act of 1982".

Sec. 412. (a) Section 1292(b) of title 28, United States Code, is amended by inserting "which would have jurisdiction of an appeal of such action" after "The Court of Appeals".

(b) Section 1292(c)(1) of title 28, United States Code, is amended by inserting "or (b)" after "(a)".

Sec. 413. Section 337(c) of the Tariff Act of 1930 (19 U.S.C. 1337(c)) is amended in the fourth sentence by inserting ", within 60 days after the determination becomes final," after "appeal such determination".

Sec. 414. (a) Sections 142, 143, and 144 of title 35, United States Code, are amended to read as follows:

#### "§ 142. Notice of appeal

"When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Commissioner, within such time after the date of the decision from which the appeal is taken as the Commissioner prescribes, but in no case less than 60 days after that date.

#### "§ 143. Proceedings on appeal

"With respect to an appeal described in section 142 of this title, the Commissioner shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Commissioner forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Commissioner shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Commissioner and the parties in the appeal.

#### "§ 144. Decision on appeal

"The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case."

(b) Paragraphs (2), (3), and (4) subsection (a) of section 21 of the Act entitled "An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes", approved July 5, 1946 (15 U.S.C. 1071(a) (2), (3), and (4)), are amended to read as follows:

"(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Commissioner, within such time after the date of the decision from which the appeal is taken as the Commissioner prescribes, but in no case less than 60 days after that date.

"(3) The Commissioner shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Commissioner forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Commissioner shall submit to that court a brief explaining the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Commissioner and the parties in the appeal.

"(4) The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the Commissioner, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case."

(c) The amendments made by this section shall apply to proceedings pending in the Patent and Trademark Office on the date of the enactment of this Act and to appeals pending in the United States Court of Appeals for the Federal Circuit on such date.

SEC. 415. Any individual who, on the date of the enactment of the Federal Courts Improvement Act of 1982, was serving as marshal for the Court of Appeals for the District of Columbia under section 713(c) of title 28, United States Code, may, after the date of the enactment of this Act, so serve under that section as in effect on the date of the enactment of the Federal Courts Improvement Act of 1982. While such individual so serves, the provisions of section 714(a) of title 28, United States Code, shall not apply to the Court of Appeals for the District of Columbia.

SEC. 416. Title 28, United States Code, is amended in the following respects:

(a) There shall be inserted, after section 797 thereof, in Chapter 51 thereof, the following new section 798, which shall read as follows:

"798. Places of holding Court; appointment of special masters.

a. The United States Claims Court is hereby authorized to utilize facilities and hold court in Washington, D.C. and in four locations outside of the Washington, D.C. metropolitan area, for the purpose of conducting trials and such other proceedings as may be appropriate to executing the court's functions. The Director of the Administrative Office of the United States Courts shall designate such locations and provide for such facilities.

b. The Chief Judge of the Claims Court may appoint special masters to assist the court in carrying out its functions. Any special masters so appointed shall carry out their responsibilities and be compensated in accordance with procedures set forth in the rules of the court."

(b) The caption of Chapter 51, Title 28 shall be amended to include the following item:

"798. Places of holding Court; appointment of special masters."

GOVERNMENT RESEARCH AND DEVELOPMENT  
PATENT POLICY

SEC. 501. Chapter 18 of title 35, United States Code, is amended—

(1) by adding "or any novel variety of plant which is or may be protectable under the Plant Variety Protection Act (7 U.S.C. 2321 et seq.)" immediately after "title" in section 201 (d);

(2) by adding "": *Provided*, That in the case of a variety of plant, the date of determination (as defined in section 41 (d) of the Plant Variety Protection Act (7 U.S.C. 2401 (d))) must also occur during the period of contract performance" immediately after "agreement" in section 201 (e);

(3) in section 202 (a), by amending clause (i) to read as follows: "(i) when the contractor is not located in the United States or does not have a place of business located in the United States or is subject to the control of a foreign government," ; by striking the word "or" before "iii" , and by adding, after the words "security of such activities" in the first sentence of such paragraph, the following: "or, iv) when the funding agreement includes the operation of a Government-owned, contractor-operated facility of the Department of Energy primarily dedicated to that Department's naval nuclear propulsion or weapons related programs and all funding agreement limitations under this subparagraph on the contractor's right to elect title to a subject invention are limited to inventions occurring under the above two programs of the Department of Energy."

(4) by amending paragraphs (1) and (2) of section 202 (b) to read as follows:

"(b)(1) The rights of the Government under subsection (a) shall not be exercised by a Federal agency unless it first determines that at least one of the conditions identified in clauses (i) through (iii) of subsection (a) exists. Except in the case of subsection (a)(iii), the agency shall file with the Secretary of Commerce, within thirty days after the award of the applicable funding agreement, a copy of such determination. In the case of a determination under subsection (a)(ii), the statement shall include an analysis justifying the determination. In the case of determinations applicable to funding agreements with small business firms, copies shall also be sent to the Chief Counsel for Advocacy of the Small Business Administration. If the Secretary of Commerce believes that any individual determination or pattern of determinations is contrary to the policies and objectives of this chapter or otherwise not in conformance with this chapter, the Secretary shall so advise the head of the agency concerned and the Administrator of the Office of Federal Procurement Policy, and recommend corrective actions.

"(2) Whenever the Administrator of the Office of Federal Procurement Policy has determined that one or more Federal agencies are utilizing the authority of clause (i) or (ii) of subsection (a) of this section in a manner that is contrary to the policies and objectives of this chapter, the Administrator is authorized to issue regulations describing classes of situations in which agencies may not exercise the authorities of those clauses."

4A. By adding at the end of section 202(b) the following new paragraph:

"(4) If the contractor believes that a determination is contrary to the policies and objectives of this chapter or constitutes an abuse of discretion by the agency, the determination shall be subject to the last paragraph of section 203(2)."

(5) by amending paragraphs (1), (2), (3), and (4) of section 202(c) to read as follows:

"(1) That the contractor disclose each subject invention to the Federal agency within

a reasonable time after it becomes known to contractor personnel responsible for the administration of patent matters, and (or such additional time as may be approved by the Federal agency) whether the contractor will retain title to a subject invention. *Provided*, That in any case where publication, or sale, or public use, has initiated the one year statutory period in which valid patent protection can still be obtained in the United States, the period for election may be shortened by the Federal agency to a date that is not more than sixty days prior to the end of the statutory period: And *provided further*, That the Federal Government may receive title to any subject invention in which the contractor does not elect to retain rights or fails to elect rights within such times.

"(3) That a contractor electing rights in a subject invention agrees to file a patent application prior to any statutory bar date that may occur under this title due to publication, on sale, or public use, and shall thereafter file corresponding patent applications in other countries in which it wishes to retain title within reasonable times, and that the Federal Government may receive title to any subject inventions in the United States or other countries in which the contractor has not filed patent applications on the subject invention within such times.

"(4) With respect to any invention in which the contractor elects rights, the Federal agency shall have a nonexclusive, non-transferrable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States any subject invention throughout the world: *Provided*, That the funding agreement may provide \* \* \* foreign patent rights in the subject invention, as are determined by the agency as necessary for meeting the obligations of the United States under any treaty, international agreement, arrangement of cooperation, memorandum of understanding, or similar arrangement, including military agreements relating to weapons development and production."

(6) by striking out "may" in section 202 (c) (5) and inserting in lieu thereof "as well as any information on utilization or efforts at obtaining utilization obtained as part of a proceeding under section 203 of this chapter shall";

(7) by striking out "and which is not, itself, engaged in or does not hold a substantial interest in other organizations engaged in the manufacture or sales of products or the use of processes that might utilize the invention or be in competition with embodiments of the invention" in clause (A) of section 202(c)(7);

(8) by amending clauses (B) (D) of section 202(c)(7) to read as follows: "(B) a requirement that the contractor share royalties with the inventor; "(C) except with respect to a funding agreement for the operation of a Government-owned-contractor-operated facility, a requirement that the balance of any royalties or income earned by the contractor with respect to subject inventions, after payment of expenses; (including payments to inventors) incidental to the administration of subject inventions, be utilized for the support of scientific research; or education; (D) a requirement that except where it proves infeasible after a reasonable inquiry in the licensing of subject inventions shall be given to small business firms; and (E) with respect to a funding agreement for the operation of a Government-owned-contractor-operator facility, requirements (i) that after payment of patenting costs, licensing costs, payments to inventors, and other expenses incidental to the administration of subject inventions, 100 percent of the balance of any royalties or income

earned and retained by the contractor during any fiscal year, up to an amount equal to five percent of the annual budget of the facility, shall be used by the contractor for scientific research, development, and education consistent with the research and development mission and objectives of the facility, including activities that increase the licensing potential of other inventions of the facility provided that if said balance exceeds five percent of the annual budget of the facility, that 75 percent of such excess shall be paid to the Treasury of the United States and the remaining 25 percent shall be used for the same purposes as described above in this clause (D); and (ii) that, to the extent it provides the most effective technology transfer, the licensing of subject inventions shall be administered by contractor employees on location at the facility."

(9) By adding "(1.) before the word 'With' in the first line of section 203, and by adding at the end of section 203 the following:

"(2) A determination pursuant to this section or section 202(b)(4) shall not be subject to the Contract Disputes Act (41 U.S.C. S. 601 et seq.). An administrative appeals procedure shall be established by regulations promulgated in accordance with section 206. Additionally, any contractor, inventor, assignee, or exclusive licensee adversely affected by a determination under this section may, at any time within sixty days after the determination is issued, file a petition in the United States Claims Court, which shall have jurisdiction to determine the "appeal on the record and to affirm, reverse, remand or modify, ", as appropriate, the determination of the Federal agency. In cases described in paragraphs (a) and (c), the agency's determination shall be held in abeyance pending the exhaustion of appeals or petitions filed under the preceding sentence.";

(10) by amending section 206 to read as follows:

"§ 206. Uniform clauses and regulations

"The Secretary of Commerce may issue regulations which may be made applicable to Federal agencies implementing the provisions of sections 202 through 204 of this chapter and shall establish standard funding agreement provisions required under this chapter. The regulations and the standard funding agreement shall be subject to public comment before their issuance.";

(11) In section 207 by inserting "(a)" before "Each Federal" and by adding the following new subsection at the end thereof:

"(b) For the purpose of assuring the effective management of Government-owned inventions, the Secretary of Commerce authorized to—

"(1) assist Federal agency efforts to promote the licensing and utilization of Government-owned inventions;

"(2) assist Federal agencies in seeking protection and maintaining inventions in foreign countries, including the payment of fees and costs connected therewith; and

"(3) consult with and advise Federal agencies as to areas of science and technology research and development with potential for commercial utilization."; and

(12) in section 208 by striking out "Administrator of General Services" and inserting in lieu thereof "Secretary of Commerce".

(13) By deleting from the first sentence of section 210(c), "August 23, 1971 (36 Fed. Reg. 16887)" and inserting in lieu thereof "February 18, 1983", and by inserting the following before the period at the end of the first sentence of section 210(c) "except that all funding agreements, including those with other than small business firms and nonprofit organizations, shall include the

requirements established in paragraph 202(c)(4) and section 203 of this title."

(14) by adding at the end thereof the following new section:

"Sec. 202 Disposition of rights in educational awards

"No scholarship, fellowship, training grant, or other funding agreement made by a Federal agency primarily to an awardee for educational purposes will contain any provision giving the Federal agency any rights to inventions made by the awardee." and

(15) by adding at the end of the table of sections for the chapter the following new item:

"212. Disposition of rights in educational awards."

AMENDMENT TO SEMICONDUCTOR CHIP PROTECTION ACT

Mr. MATHIAS. Mr. President, I am pleased to place before the Senate an amendment in the nature of a substitute to S. 1201, the Semiconductor Chip Protection Act of 1984. This amendment, which is cosponsored by the distinguished junior Senator from Vermont (Mr. LEAHY), is the culmination of extensive negotiations with our counterparts in the other body. This compromise amendment resolves the differences between the bill that the Senate originally passed last May, and the corresponding measure approved by the House in June. The result is a bill that breaks new ground by providing strong protection against the unauthorized copying of the design of that miniaturized miracle of microelectronics technology, the semiconductor chip. Enactment of this bill, as amended, will demonstrate our commitment to bring intellectual property law up-to-date to meet the challenges posed by today's high technology. The approval of the amendment before us is a critical step in this process, and I urge its immediate adoption.

When this measure was last before the Senate, I noted that the House of Representatives was considering a similar but somewhat different measure on the same topic. Shortly thereafter, the other body did, in fact, pass its bill. Both the House and Senate versions of the legislation accorded similar protection to the creativity embodied in the intricate designs of semiconductor chips. The major distinction was that the Senate bill accorded protection under the copyright law, while the House bill established a new, free-standing form of protection. The House sui generis protection was similar to copyright, but applied only to the particular type of expression embodied in chip design, which both bills referred to as a "mask work." The amendment before us today adopts the approach favored by the House of Representatives. To a great extent, the difference between copyright and sui generis protection is a matter of labeling; the variations in the protection accorded chip design are not likely to be of much practical significance. But the acceptance of the House approach is a recession by the Senate of sufficient importance that a few words of explanation are in order.

The controversy about copyright or "copyright-like" sui generis protection has simmered ever since hearings were first held on S. 1201 before the Subcommittee on Patents, Copyrights and Trademarks some 16 months ago. The arguments on both sides of the issue were explored in depth. The report of the Senate Judiciary Committee explained in some detail the reasons for the Senate's adoption of the copyright approach. The question also received thorough discussion in the Senate debate accompanying passage of S. 1201 in May. But while the Senate concluded that, on balance, the evolving copyright law was sufficiently flexible to accommodate the new form of expression embodied in mask works, the House of Representatives was firmly convinced that chip protection would confuse and distort the copyright law. It was apparent from the earliest negotiations between the Houses that the other body's rejection of the copyright approach was irrevocable, and that if a semiconductor chip protection bill were to gain approval from both Houses, it would have to reflect the sui generis approach.

In any event, it is clear that the substantive differences between the two approaches were more apparent than real. Both bills provided for a limited, 10-year term of protection for chip design. Both opted for a registration rather than an examination system of protection, so that a shield against piracy could be obtained quickly and inexpensively. Both accorded the owner of the chip design the exclusive right to make, import, and distribute a chip embodying that design. Both provided, in almost identical terms, for the accepted and beneficial industry practice of reverse engineering. Both also recognized a limited immunity for innocent infringers of rights in the chip design. Under both bills, the protection system would be administered by the Copyright Office in the Library of Congress, with enforcement efforts left primarily to private civil litigation in the U.S. district courts. In short, both bills contemplated a system of protection that closely resembled existing copyright law, with certain key deviations from that model. The Senate bill followed the copyright model while providing for stated exceptions; the House bill simply created a new legal structure patterned on copyright and incorporating similar exceptional features. The closeness to copyright of the sui generis approach may best be illustrated by the fact that many of the speakers in the House debate on chip protection referred to the House bill as a "copyright bill." Furthermore, the fact that the House approach was fully acceptable to the original sponsors of the companion measure to the Senate-passed chip protection bill added some weight to the argument for recession to the House bill.

Additionally, the compromise bill now before the Senate also incorporates some additional improvements which, to some extent, satisfy the concerns that led the Senate to choose a copyright solution to the problem of chip piracy. Three of these deserve particular mention.

First, the Senate was concerned that jettisoning the copyright approach might consign the semiconductor industry to years of litigation and uncertainty before the courts arrived at definitive interpretation of a host of new legal concepts contained in *sui generis* legislation. This fear has been assuaged somewhat by the publication, almost simultaneous with Senate passage of S. 1201, of a detailed report of the House Judiciary Committee on the noncopyright bill. Additionally, Senator LEAHY and I have prepared a further explication of some of the provisions of the amendment that we offer today. I ask unanimous consent that this memorandum appear in the RECORD at the conclusion of my remarks. Taken together, along with the Senate Judiciary Committee's report on S. 1201, these documents ought to provide sufficient legislative history to allow for business planning among semiconductor chip manufacturers and consumers with a fair degree of confidence in the outcome of litigation arising under the Semiconductor Chip Protection Act.

Second, the House has agreed to some changes that will help to give the act more vigor in the immediate future. These include a concession as to the cutoff date for chip protection: the date by which a chip must be on the market in order to enjoy protection against copying and other infringements occurring after the effective date of the act. The House-passed bill denied full protection to chips coming to market before 1985, while allowing limited protection to 1984 chips. The amendment before us provides full protection as of the date of enactment, while chips that came to market as early as July 1, 1983, will eventually enjoy the same status, subject only to a 2-year compulsory license that allows copyists who agree to pay reasonable royalties to distribute their inventory of chip copies in existence on the day of enactment.

Perhaps more importantly, the amendment contains provisions designed to clarify that Congress in no way intends to discourage attempts to prevent copying of chips that were marketed before the cutoff date, an intent that could have been inferred from some language in the House legislative history. To the contrary, the enactment of this legislation is in no way intended to detract from any legal protection that now is, or that may in the future become, available for chips brought to market before July 1, 1983, whether under Federal law, including the existing Copyright Act, or under State statutes, or common law principles.

I know that the junior Senator from Vermont shares my disappointment that the other body would not agree to provide any protection under this act against future acts of piracy directed against chips that were first commercially exploited prior to July 1, 1983. We both feared that this resolution would place at risk the massive investment in some of the most sophisticated semiconductor chip designs, including those embodied in the 1982 generation of 16-bit microprocessors. These advanced "computers-on-a-chip" are only now beginning to enjoy widespread commercial application in personal computers, industrial workstations, and other uses. We take some comfort, however, from the fact that the other body has agreed to write into this legislation, in the most emphatic way possible, that would-be copyists ought not to interpret the exclusion of these chips from coverage under the bill as a declaration of "open season." Nothing could be farther from the truth.

Third, the amendment before us incorporates international transitional provisions that, in my view, mark an important improvement. These provisions are needed precisely because this legislation breaks new ground: The United States will be the first country to adopt legislation explicitly protecting chip designs against unauthorized copying. As the trailblazers, we must grapple with the question of how to treat those other nations that may wish to follow us down the path of chip protection. In the global market in which semiconductor chip products move, few questions are of greater importance.

The Senate bill sought to encourage international protection for mask works by action within the established framework of international copyright law, including, particularly, the Universal Copyright Convention to which the United States adheres. The House bill explicitly rejects reliance on the U.C.C., and calls for the creation of a new international protection system specifically for mask works. However, since no other nation now provides for chip protection, the practical effect of the House-passed bill would have been to make it very difficult for foreign chip designers to obtain protection here in the United States. While it might be anticipated that this problem would eventually be resolved as other chip-producing countries followed our lead, either by enacting similar legislation or by entering into treaty arrangements, in the short run, the problems might be acute. An "open season" on foreign chip designs in the United States, which still boasts the bulk of the semiconductor chip market, could lead to retaliatory measures abroad, and could also disrupt other commercial dealings, such as U.S. licensing arrangements for foreign-designed chips. Thus, while the house bill's goal was a regime of international comity for mask work protec-

tion, the actual outcome might have been quite different and less satisfactory.

The international transitional provisions contained in the amendment before us fully address this problem. In effect, they allow for a transitional period in which nationals of those countries that are making progress toward chip protection legislation or treaties, and that respect intellectual property rights in chip design, may protect, in the United States, the mask works they have created, on an equal basis with the creations of U.S. nationals. This transitional regime, to be administered by the Secretary of Commerce, will last for 3 years, which should give sufficient time to erect a more permanent framework of international cooperation in this area.

We have already seen increased international interest in the prospects for chip protection. Representatives of several chip-producing nations are following closely the progress of this legislation. The international transitional provisions, which are discussed in more detail in the joint explanatory memorandum that follows this statement, should go far toward encouraging a prompt and positive response in Japan, Western Europe, and elsewhere.

Finally, I want to underscore some of the implications of the adoption of this legislation. A *sui generis* approach is appropriate in the case of mask works because mask works are, truly, *sui generis*. They are a hybrid form of expression. In some ways, they are similar to audiovisual or graphic works, which are, of course, subjects of copyright. Yet the ultimate medium of this expression, and the locus of its extraordinary value to our high-technology society, is a useful article, something more closely resembling the subject matter of the patent system. The amendment before us renounces the project of incorporating protection for this unique form of expression within the copyright system. It should follow, therefore, that the precedential value for future copyright legislation of some of the features contained in this bill is extremely limited.

For example, the Senate is prepared, with some reluctance, to recede to the House approach of eliminating criminal penalties for even the most blatant and egregious violations of exclusive rights in mask works. But this decision is entirely consistent with a recognition that criminal enforcement must continue to play a limited but important role in the copyright sphere. It may also be necessary to reconsider the question of criminal penalties for the violation of mask work rights, should the enhanced civil remedies provide in this bill prove to be insufficient.

Similarly, the adoption of a non-copyright approach to chip protection carries with it no implication with regard to the notion that computer

programs ought to be protected under a sui generis statute rather than under copyright. Throughout the consideration of chip protection legislation, the Senate proponents have been extremely careful to underline the distinctions between protection for chip design and protection for software, even when the software is in the form of object code embodied in a Read Only Memory [ROM] semiconductor chip. Both versions of the bill contained specific savings clause provisions disclaiming any intention to alter existing rights in software or other works now protected by copyright. Indeed, in the Senate's view on this subject is clearly expressed in the amendment recently adopted to the Omnibus Tariff and Trade Act of 1984, H.R. 3398, which expresses the sense of this body that any abandonment of copyright protection for software in favor of a scheme of broad compulsory licensing would be inappropriate. As a cosponsor of that amendment, I hope that the passage of a sui generis chip protection bill will not detract in the slightest from that important message.

Mr. President, this is path-breaking legislation. Many hands have contributed to the blazing of this trail. The Senator from Vermont, Mr. LEAHY, and his staff have been deeply involved in the complex negotiations that have brought us to the verge of enactment of semiconductor chip protection. The distinguished chairman of the Judiciary Committee, Senator THURMOND, has been of invaluable assistance in moving this legislation along. Of the 26 Senate cosponsors of this measure, the Senator from Colorado, Mr. HART, deserves particular mention for his early recognition of the importance of this time. In the other body, the leadership of Representatives DON EDWARDS and NORMAN MINETA, the original sponsors of the companion bill, should be noted. Finally, we would not have advanced this legislation to this point without the active participation of the chairman of the Subcommittee on Courts, Civil Liberties, and the Administration of Justice of the House Judiciary Committee, Representative ROBERT KANSTENMEIER. While I have not agreed with all the positions that Representative KANSTENMEIER has taken with regard to this legislation, his views have shaped the measure before us to an extraordinary degree, and if we are successful in enacting it into law during this Congress, he will deserve a lion's share of the credit.

Mr. President, I commend this amendment to the Senate, and urge its immediate adoption.

#### THE TRADEMARK CLARIFICATION ACT OF 1984

Mr. President, title 1 of the substitute draft now before the Senate is a slightly revised version of S. 1990, the Trademark Clarification Act of 1984, as it was approved by the Judiciary Committee. Passage of this legislation will help to protect our Nation's trade-

mark system from the potentially detrimental effect of the erroneous reasoning of the ninth circuit in the famous Anti-Monopoly case.

The one change from the committee text of this bill is the addition of a new section 104, which reads:

Nothing in this title shall be construed to provide a basis for reopening any final judgment entered prior to the date of enactment of this title.

This amendment merely codifies the clear intent of the bill as approved by the Judiciary Committee. As the report on that bill indicated, S. 1990 does not overrule the *Anti-Monopoly* decision, 684 F.2d 1316 (9th Cir. 1982), cert. denied, 103 S. Ct. 1234 (1983), as to the parties in that case. The bill merely overturns certain elements in the reasoning of that case, and does not say whether or not Monopoly is a valid trademark.

Section 104 does not forbid the reopening of judgments on grounds other than the passage of this legislation, such as on the basis of newly discovered evidence. It does, however, clearly forbid the reopening of any judgment entered prior to the date of enactment of this act based on the provisions of this legislation.

By virtue of this act, Congress does not intend to alter accepted principles of collateral estoppel and res judicata. These are judicial doctrines of continuing validity, and should be applied by the courts in accordance with all appropriate equitable factors.

As used in section 104, the term "final judgment" means that judgment that is entered or made conclusive at the termination of a lawsuit.

Mr. President, I urge Senators to support this legislation.

Mr. HATCH. Mr. President, it is a pleasure to join many of my able colleagues in approving a worthy package of amendments to S. 1990, my Trademark Clarification Act. In particular, I would like to thank Chairman THURMOND of the Judiciary Committee for once again facilitating the advancement of meritorious legislation, Chairman MATHIAS of the Trademarks Subcommittee for his professional processing of this legislation, and the many cosponsors of this bill, most notably Senator LEAHY, who worked closely with me in drafting and perfecting this measure. The amendment attached to S. 1990 will expand this package bill to include provisions giving necessary protection to the designers of sophisticated computer chip technology and provisions establishing a State Justice Institute.

#### THE TRADEMARK CLARIFICATION ACT

Before proceeding to explain the reasons for S. 1990, I would like to acknowledge the valuable advice and counsel of the U.S. Trademark Association through its Federal legislation chairman, Mike Grow, and the Patent and Trademark Office through its director, Gerald Mossinghoff. These two gentlemen were more than simply very competent witnesses before the

subcommittee on these questions; they continued to serve long after their testimony by offering advice and drafting suggestions. The final form of this bill owes much to their expertise.

Federal trademark law has provided consumers and producers with marketplace protection for more than a century.

Consumers are assured they are purchasing the product that they desire and that the product is of the same consistent quality that they experienced previously in purchasing that trademarked product. Producers know the time, money, and energy invested in developing and establishing products or services which bear trademarks will be protected from misappropriation.

While trademarks are designed primarily to provide protection and assurance, they may not last indefinitely. The Lanham Trademark Act of 1946 provides for cancellation when a mark "becomes the common descriptive name of an article or substance." Both aspirin and escalator are examples of trademarks that have become common descriptive, or generic, names; there are many more.

In making these decisions on which terms are generic and which are protected marks, the courts have followed a standard test that has existed for more than 60 years. That test is whether the majority of the public recognizes and accepts the term as a trademark. This standard has been well recognized, well understood, and well accepted. It has served to lend stability and clarity to trademark law and litigation involving the determination whether a trademark is valid.

Last year, however, a circuit court handed down a ruling that threatens to undermine this clarity and stability. In a radical and unwarranted departure from accepted judicial practice, the ninth circuit, in a case involving Monopoly, the popular board game manufactured by Parker Bros., ignored the issue of whether the public recognized the name as a trademark.

It focused instead on an entirely new issue: Did consumers purchase this game because they wanted a product made by Parker Bros. or because they wanted to play a specific real-estate-trading game? Because a majority of consumers surveyed were motivated by a desire to play the game and not by the fact that Parker Bros. manufactured Monopoly, the ninth circuit ruled against Parker Bros.

In applying a new standard, one of consumer motivation, the ninth circuit ruled that Monopoly had become a generic name because 65 percent of the people surveyed said they bought the game because they wanted to play Monopoly, and "don't much care who makes it," while some 32 percent—a minority—said they bought Monopoly because they "like Parker Bros. products."

This new motivation test is both unjustified and unreasonable. It ignores past law and common sense, and, most importantly, it is contrary to accepted principles of trademark law. It denies brand-name status to products that always have been bought by their brand name, simply because the purchaser or consumer cannot identify the maker or manufacturer.

Few trademarks can survive this standard, because most consumers cannot identify the companies that produce the products and goods they buy. Moreover, accepted trademark law does not require this identification, as long as consumers associate the goods with a single source. They do, however, have clear expectations regarding the quality of the products they purchase and rely on the trademark for assurance of this quality. Yet the ninth circuit has declared these customary and usual expectations to be insufficient.

It would be inappropriate for the Congress to take action that would have a retroactive impact on the parties affected directly by the ninth circuit decision in the Monopoly case. I also have no wish to further expand the authority of existing law or establish new standards, definitions or boundaries regarding the cancellation of trademarks.

I do believe, however, that the fundamental conflict which now exists within trademark law and litigation, as a result of the ninth circuit decision, must be resolved. Otherwise, chaos and confusion will result—everyone will be the loser. An amendment that clarifies the Lanham Trademark Act, that reaffirms and spells out the basic principles that have underscored trademark law for more than six decades, is the most direct, least complicated, and most reasonable way of achieving this goal.

Mr. President, in 1921, Judge Learned Hand articulated the basic standard for determining when a trademark became a generic name. That standard was the level of understanding the consumer exhibited regarding the trademark. If the primary significance of the term was to symbolize the kind or genus of goods sold, then the term was generic and the producer was not entitled to protection. If, on the other hand, the term meant something more than that, then the seller deserved the protection of a trademark. This landmark decision of Bayer Co. against United Drug Co., (272 F.2d 505, 509 (1921)) is still followed by many courts.

Over the years, there have been some refinements in this standard. In the 1938 case of Kellogg Co. against National Biscuit Co. (305 U.S. 111 (1938)), the court said a trademark owner had to show that "the primary significance of the term in the minds of the consuming public is not the product, but the producer" in order to retain the trademark. In other words, the consumer had to recognize the

trademark as the name of a product that came from a particular source, even though the consumer might not be able to identify that source. In the 1962 case of Feathercombs, Inc. against Solor Products, Inc.) 306 F.2d 252, 256), the court said that in order for a trademark to become generic, "the principal significance of the word must be its indication of the nature or class of an article rather than an indication of its origin."

Although these cases have served to sharpen and clarify the standard for determining when a trademark becomes generic, the basic and fundamental criteria the courts employed for making this determination always have remained the same—the level of consumer understanding regarding the term in question and whether it could be said that a majority of the public recognized the term as a trademark, rather than as a descriptive term for an entire type or class of products, goods, or services.

This historic standard, as well as thousands of reputable trademarks and the protection and confidence the consumer enjoys in the marketplace, now have been placed in jeopardy by the ninth circuit's disruptive departure from decades of accepted judicial practice.

This decision has shaken reputable trademark attorneys as well as many businesses and members of Congress. The U.S. Trademark Association, for example, believes the motivational test employed by the ninth circuit in Anti-Monopoly against General Mills Fun Group (684 F.2d 1316 (9th Cir. 1982)), is a "significant threat to the entire trademark system." After considerable deliberation, the USTA recently decided to support legislative efforts aimed at clarifying the legal basis for determining when a trademark becomes generic.

Like many of us, the members of the USTA are troubled because the ninth circuit ignored the dual-function provision of our trademark law. This provision allows trademarks to stand when they serve as the proper name of a product, article, or substance so long as they also serve as an indication of the product's origin, even if that origin is unknown or anonymous to the consumer. By ruling that consumers must associate the trademark with a specific company, the ninth circuit turned its back on the dual-function principle that has long been an integral part of trademark law.

We are troubled, too, because the Anti-Monopoly decision is not an isolated case that other judicial courts will ignore. The motivational test employed by the ninth circuit, as Judge Nies has stated, has led "some courts into an esoteric and extraneous inquiry focusing on what motivates the purchasing public to buy particular goods." In re DC Comics (689 F.2d 1942, 1954 (C.C.P.A. 1982) (concurring opinion)).

Meanwhile, another ninth circuit court already has referred to the Monopoly motivation survey as one conducted "according to accepted principles." Prudential Insurance against Gibraltar Financial Corp. (694 F.2d 1150, 1156 (9th Cir. 1982)). And, in the case of The Nestle Co. against Chester's Market Inc. (D. Conn. 1983), Judge Blumenfeld, in holding that the term "Toll House" was generic, cited the Anti-Monopoly decision extensively. The judge also indicated that if a motivation test submitted to the court had not been deficient with respect to a few technicalities, he would have admitted it as evidence.

The reasons individuals buy products should have no bearing on these cases because they are not designed to ascertain whether a product has become generic. They should have no standing in court and no bearing on these cases, because they do not show whether or not a product has become generic. Another survey in the Anti-Monopoly case asked the public if they bought the detergent "Tide" because they wanted a Proctor & Gamble product, or if they bought Tide because they thought it did a good job; 68 percent said they bought Tide because it did a good job. Does this mean that the Tide trademark should now be declared a generic name? Of course not. Yet the ninth circuit did not dismiss the thought, and that could easily happen if we do not take some minimal but essential steps to protect the validity and integrity of our trademarks and our system of trademark law.

Mr. President, the dilemma the ninth circuit created was best summed up by Robert C. Lyne, Jr., chief patent counsel for Reynolds Aluminum Co. when he wrote:

The point of trademark protection is to permit a purchaser to recognize the goods he wishes to buy, and to distinguish them from other goods. It is not to enable him to match up various goods with the companies that sell them.

S. 1990, the Trademark Clarification Act, will resolve this ambiguity.

The bill is not intended to effect important substantive changes in the mainstream of trademark law. Thus its purpose remains primarily that of clarifying and rendering more precise in the statute what the law is today and should be in the years to come, undisturbed and undiverted by the troubling and potentially dangerous elements of the Anti-Monopoly case. In short, the bill does four things:

First, it disapproves use of the so-called purchaser motivation test in determining whether a trademark has become the common descriptive name of a product or service.

Second, it recognizes the dual function that a mark plays in the marketplace.

Third, it recognizes that the name of a unique product may also function as

a trademark so long as the public associates that mark with a single source.

Fourth, it continues the principle that a mark may identify and distinguish a product from that manufactured by others and indicate its source, even if that source is unknown.

Fifth, it conforms various parts of the Lanham Trademark Act to assure uniformity of application in both the courts and in the U.S. Patent and Trademark Office.

Finally, although the Senate Judiciary Committee report offers the most concise agreement of all parties of the legislation as to its terms, one section has been added to this bill on the floor. Since this language has not profited from the careful explanation given the other terms in the committee report, I feel that it would be wise for me to describe its intent in more detail.

The new final section of title I, the Trademark Clarification Act of 1984, states that "Nothing in this Act shall be construed to provide a basis for reopening of any final judgment entered prior to the date of enactment of this Act." This language is intended to mean exactly what it says.

The Federal District Court for the Northern District of California entered a judgment in August 1983 determining that the owners of the trademark Monopoly have no legal or equitable remedy against the producer of the game named Anti-Monopoly for its use of the latter mark under certain circumstances. Nothing in this legislation shall be construed to affect that judgment, in any way, as between those parties. It should be kept in mind, however, that the judgment in that case only covered the rights and obligations of the parties; ultimately no declaration was entered on the question of validity of the Monopoly mark.

The legislation also does not, as the Senate report on S. 1990 says on page 8, determine as a statutory matter "whether or not Monopoly is a valid trademark." That is not the province of the Congress, but of the courts.

The Senate report underlines this point when it says, on page 10, that this legislation "is not intended to be retroactive in effect as to the parties to completed litigation." The new section in this title merely restates this intent, nothing more. The legislation thus does not allow the owners of the Monopoly trademark to reopen the Anti-Monopoly litigation as between the parties to that case.

The legislation does overturn the reasoning of the ninth circuit's Anti-Monopoly decision. It therefore brings about an unequivocal change in that law applied by the ninth circuit in the Anti-Monopoly case in each of the respects spelled out in the Senate report. Thus, to the extent that the Anti-Monopoly case might otherwise be seen to have established any controlling legal principles, the legislation constitutes a modification of those

controlling legal principles. Application of *Szwarc*, 319 F.2d 277 (CCPA 1963). See Commissioner against *Sunnan*, 333 U.S. 591 (1948); U.S. against *Stone & Downer Co.*, 274 U.S. 225 (1927); *Artukovic against INS*, 693 F.2d 894 (9th Cir. 1982); *Del Rio Distr., Inc. against Aldolph Coors Co.*, 589 F.2d 176 (5th Cir. 1979).

Congress is not, by virtue of this legislation, expressing its views on the application of collateral estoppel or res judicata, which are, of course, judicial doctrines of continuing validity.

#### THE SEMICONDUCTOR CHIP PROTECTION ACT

Mr. President, I wish to echo the words of Senator *MATHIAS*, the distinguished chairman of the Subcommittee on Patents, Copyrights and Trademarks, and the author of the Semiconductor Chip Protection Act. This portion of this package bill may prove to be one of the most important anti-piracy bills enacted in recent years.

We are all cognizant of the importance of innovation in high technology and its contribution to our economy. Perhaps the most significant such innovation has been the semiconductor chip, with quantum leap refinements in its manufacturing process, and in its applications.

The investment required to produce these chips is not small. In testimony before the subcommittee, Mr. F. Thomas Dunlap, Jr., of Intel Corp. testified that a family of chips typically costs \$80 million to develop. Yet a pirate can accomplish the same result at a cost of about \$100,000.

As Mr. Dunlap testified, a typical pirate:  
has a minimal research and development cost.

\*\*\* and certainly does not have to recover market development cost. He is simply interested in making a profit above his manufacturing cost \*\*\* [and] uses price as his weapon.

The Copyright Office has echoed the sentiments of us all by observing that "those who create must be rewarded and protected by our laws." But, to date, there has been no protection, and the semiconductor innovator's reward has been drastically impaired by chip piracy.

Mr. President, this part of the bill preserves the incentives for innovation intended by our Founding Fathers to be the right of those who create. I congratulate the authors of these provisions and, as a member of the subcommittee in which it originated, I am delighted to have been a part of their progress through the legislative process.

#### STATE JUSTICE INSTITUTE

The final part of this package is the State Justice Institute. Although this provision has raised the question of whether the Federal Government, consistent with the principles of federalism, ought to offer financial assistance to State government institutions, this form of the Institute proposal has been recast to minimize the difficulties. Its funding levels have been re-

duced to \$43 million over 3 years. Its matching requirement has been increased to require State governments to finance one-half of the projects and grants, instead of only one-quarter. Moreover, several provisions have been added to prevent the Institute from interfering with State judicial independence, from engaging in litigation, from lobbying in any Federal or State legislative body, or from undertaking a number of other activities inconsistent with the Institute's limited mission. For instance, the Institute shall not involve itself in partisan activity of any kind, nor become involved in any State ballot process, nor participate in political campaigns, nor issue stock or raise funds as a corporation might.

With these and other limitations, the Institute should operate effectively and become a tribute to its primary Senate sponsor, Senator *HEFLIN*, a former State chief judge, who deserves great commendation for his work on this provision.

Mr. *LEAHY*. Mr. President, it is very hard to exaggerate the impact of one very small, insignificant looking device on all of our lives. That device is the silicon chip, the semiconductor device that now turns up everywhere in our lives and which already has turned our century inside out.

It is not enough to say that we live, willing or not, in the age of computers. We also live in the age of the automobile and the age of miraculous wireless communications—radio and television. Each of these has rewritten the patterns of our lives—where we live, where we work, where we travel, what we see and know of the world.

But the silicon chip extends the potential of the human mind, and therefore, of human endeavor, beyond the realm of rapid travel and communication. The computer collects vast banks of information. It gives us the power to look at that information in new ways and to compare it with information in other computers.

It gives us the power to analyze in seconds what used to take months or years, with the result that we can begin to simulate natural and social systems, and therefore, to make predictions about the future that would have seemed pointless to attempt even a short time ago.

Of course, I am not talking about mere scientific or technological breakthroughs that might leave commercial exploitation down the road. Make no mistake: The explosion of semiconductor technology has hit the marketplace. Virtually every month we see another new product or a giant improvement of an old one.

We constantly witness the advent of more powerful chips, suitable for more and more varied applications. It is even likely that in the future semiconductors will be made of many materials, not just silicon.

More than just new semiconductors and the new products, we are constantly seeing entire new product fields opening up. We are seeing millions of dollars in sales a year in products that were not even on the drawing board 10 years ago.

The dramatic rush of innovative products is one of the reasons I am so glad we are passing this bill this year. New ideas are the product of genius and incentive. We cannot legislate the genius, and it is clear we do not need to. We do need to create the incentives for that genius to flourish and for industry to devote the resources necessary to turn genius into productivity.

That is what this bill is about.

And that is why this bill cannot wait.

Semiconductor chips are at the heart of the worldwide computer revolution, and at the heart of those chips are American semiconductor chip designs. If we fail to provide adequate legal protection for these designs, we will stifle the investment of American companies in innovative product designs and ultimately we will risk falling far behind our international competitors.

While these goals have been clear and agreed upon from the outset, the paths of the House and Senate in reaching those goals have been different.

It should be no surprise that a bill dealing with innovation contains much innovation itself. Protecting semiconductor chip designs was a difficult intellectual, as well as legal, problem.

Just what is embodied in a chip, conceptually? Were we to think of it as a piece of original hardware invented by its creator, or was its essence more the assemblage of written ideas and designs, subject rather to copyright protection?

The House and Senate bills took different approaches initially. The House looked at semiconductor chips as a sui generis and opted for a sui generis solution, though it contained copyright-like elements.

The Senate version was clearly an amendment of the Copyright Act and relied on the adaptation of traditional approaches to the protection of copyrighted works.

We worked long and hard on narrowing the differences, and I am happy to say that some of the differences were more apparent than real. The House bill was very soundly conceived, and we found that its grounding in basic copyright law gave us common ground on which to work.

The subject matter was complex and the agenda long. But Senator MATTHIAS, Congressman KASTENMEIER, and I worked hard over the summer to get through that agenda, and the bill that resulted was a true blend of the work of each body.

When the Senate passed S. 1201 in May, I mentioned some concerns that I had with the House sui generis approach. I am pleased to say that these

concerns have been squarely dealt with.

I raised the issue of protection of American chip designs in the international marketplace. It was my view that the multinational copyright conventions as well as bilateral negotiations would be useful in securing American rights in chip designs overseas.

Given the uncertainty that a semiconductor mask work is a proper subject matter for copyright protection, both here and abroad, I am now convinced that the detailed international transitional provision contained in the Mathias-Leahy substitute provides a more solid basis for securing American rights abroad.

I also was concerned about the limited protection the House bill gave to chips which were first commercially exploited after January 1, 1984, and the fact that the House bill gave no protection to chips exploited before that date.

The substitute, together with the accompanying explanation, makes it clear that chips first exploited after July 1, 1983, are fully protected, subject only to limited rights to sell off any inventory of copied chips manufactured before the effective date of the legislation. While I had hoped that we would provide explicit protection to chips first commercially exploited in 1982, including the important new generation of 16-bit microprocessors, I am pleased that the House has agreed to make it clear that any copyright protection which those chip designs currently are entitled to will not be cut off by passage of this bill.

Finally, I have been concerned throughout the development of this legislation that there be a clear understanding of what is protected, what is not protected, and what rights a company has to conduct reverse engineering in developing its own original chip. Uncertainty in this area could retard rather than spur innovation. I think that both committee reports and the joint explanatory memorandum give abundant guidance on these questions as well as the kinds of evidence which a court should admit in deciding these issues.

I would like to also note that the bill leaves untouched the authority the Copyright Office has to accept secure deposits. It currently uses this procedure, for example, in the case of standardized tests, and may wish to consider adopting such a procedure for mask works.

I want to make one substantive point about title I of this bill, the Trademark Clarification Act of 1984. It is important to underscore a point made well in the Judiciary Committee report that S. 1990 does not overrule the case of *Anti-Monopoly, Inc. v. General Mills Fund Group, Inc.*, 195 U.S.P.Q. 634 (N.D. Cal. 1977). The reasoning of the court in that case is overruled, but the bill does not pur-

port to say if monopoly is a valid trademark.

The antimonopoly litigation has been concluded, and the current bill is not intended to be retroactive in effect. Since the bill is intended primarily to restate and clarify existing law already applicable to pending cases, the legislation will apply to cases where there has been no final judgment. Such application is not a form of retroactivity. We have included legislative language to make that point clear.

Mr. President, I would like to conclude by stating something that I have said on this floor many times before. America's innovators and the country in general owe a great debt of gratitude to the chairman of the Subcommittee on Patents, Copyrights, and Trademarks, Senator MATTHIAS. His dedication and fine work, together with that of the distinguished chairman of the House Subcommittee on Courts, Civil Liberties, and the Administration of Justice, Congressman KASTENMEIER, have made this important piece of legislation possible. They deserve our thanks.

I would also like to thank committee staff who have done an impressive job of honing this legislation—specifically Steve Metalitz, John Podesta, Mike Remington, and Deborah Leawy who worked on the Semiconductor Chip Protection Act, and Tom Olson, Randy Rader, Ben Scotch, and David Beier who worked on the Trademark Improvement Act, and Arthur Briskman and Karen Kremer who worked on the State Justice Institute legislation.

Mr. HEFLIN. Mr. President, I rise in support of the State Justice Institute, which would establish a private nonprofit corporation to aid State and local governments in strengthening and improving their judicial systems.

The Framers of our Constitution realized the important position that State courts would assume in the evolution of our judicial process. In fact, the only Federal court mandated by the Constitution is the Supreme Court of the United States. Therefore, it is evident that our forefathers placed substantial confidence in the abilities of our State judicial systems. The foresight of these men proved prophetic.

Today, State courts handle over 96 percent of all the cases tried in the United States. They are charged, along with the Federal courts, with the awesome responsibility of protecting and enforcing the rights granted by the Constitution and the laws of this land.

There is little doubt that a compelling Federal interest exists in ensuring that our State courts have the necessary resources available to meet the demands of their increasing dockets.

State courts not only consider State issues, but they are bound by the supremacy clause of the Constitution to consider Federal law as well.

This legislation authorizes the creation of a State Justice Institute to administer a national program for the improvement of State court systems. In keeping with the doctrines of federalism, and separation of powers, the institute will be an independent, federally chartered corporation—accountable to Congress for its general authority, but under the direction of State judicial officials as to specific programs, priorities and operating policies.

The State has passed similar legislation establishing a State Justice Institute during the past two Congresses and it has done so by a unanimous vote. The amendment I am offering today on the State Justice Institute, is similar to the version passed by the Senate on June 21, 1984. The authorization dates have been changed from 1985, 1986, and 1987 to 1986, 1987, and 1988, and the matching funds required by States have been increased.

In addition, included within this amendment is a requirement that the Attorney General, in consultation with the Federal Judicial Center, submit a report to the Senate and House Judiciary Committees on the effectiveness of the institute.

It is apparent that the quality of justice in this country is largely determined by the quality of justice by State courts. While Federal assistance to State courts should never replace the basic financial support provided by State legislatures, Federal financial contribution administered in a manner that respects the independent nature of the judiciary can provide a margin of excellence that will not only improve the quality of justice, but will guarantee that the justice administered is of the highest caliber and that our courts provide the greatest accessibility for the citizens of this great land.

Mr. MOYNIHAN. Mr. President, I rise today to urge my colleagues to support worthy and important legislation, H.R. 6163, the Federal District Court Organization Act of 1984.

H.R. 6163, which the House of Representatives passed on September 24, 1984, establishes in Hauppauge, NY, an additional site for the Federal court of the eastern district of New York. Currently, the eastern district court hears cases in Brooklyn and Uniondale, in Nassau County. At present, the court has no judicial seat in Suffolk County, NY, despite the fact Suffolk County residents are responsible for more than 20 percent of the caseload for the eastern district court.

The Federal District Court Organization Act of 1984, which I endorse wholeheartedly, would remedy this situation by providing a new location for the eastern district court to meet in Suffolk County. The 1.3 million residents of Suffolk County now must travel 35 miles to the nearest district court location in Uniondale; the cre-

ation of a new court site will remedy this situation.

H.R. 6163 authorizes the leasing of space for two Federal judges, their courtrooms, chambers, and libraries. In addition, offices will be acquired for the U.S. attorney, the commissioner of jurors, and the clerk of the eastern judicial district of New York.

This proposal, which has been endorsed by the judicial council of the second circuit, the judges of the eastern district court, the Administrative Office of the U.S. Courts, and the Department of Justice, was introduced in the House of Representatives by the Honorable ROBERT J. MRAZEK.

Mr. President, I urge my colleagues to act swiftly and pass this legislation, and I ask unanimous consent that a copy of the testimony of Congressman ROBERT J. MRAZEK before the House Subcommittee on Courts, Civil Liberties and the Administration of Justice, of the House Judiciary Committee, on August 9, 1984, be printed in the RECORD.

There being no objection, the material was ordered to be printed in the RECORD, as follows:

TESTIMONY OF CONGRESSMAN ROBERT J. MRAZEK BEFORE THE SUBCOMMITTEE ON COURTS, CIVIL LIBERTIES AND THE ADMINISTRATION OF JUSTICE OF THE COMMITTEE ON THE JUDICIARY

Mr. Chairman and members of the Subcommittee. Thank you for allowing me this opportunity to testify in support of H.R. 5619, a bill relating to the geographical organization of the Eastern District of New York. Specifically, H.R. 5619 would amend Section 112 of Title 28 of the U.S. Code to allow the Eastern District to hold court in Hauppauge. Right now, the District sits in Brooklyn and is authorized (and does) hold court in Uniondale, located in Nassau County. Hauppauge is found in Suffolk County and serves as its demographic center, and the *de facto* seat of government.

Mr. Chairman, it has been my privilege to represent the interests of Suffolk County, first as a member of that County's legislature, and now as a member of this House—over 12 years. I have seen the rapid growth in Suffolk's population, standard of living, employment opportunities, technology and economy. Suffolk today has a life of its own, distinct, free and independent from that colossus of the West, New York City.

A direct consequence of this phenomenon is the intensity of social and business interactions which touch upon our federal laws, and it is the federal judiciary which is most responsible in assuring that the tailored and deliberate application of these laws occurs.

Of course, the judiciary's most visible figure is the federal judge—but as this Committee well knows—more people than just the judge provide input into the doings of justice. I refer to litigants, attorneys, clerks, juries and court personnel, each of whom need, give, facilitate, regulate or supervise, as the case may be, access to the judge and in the broader sense, the administration of justice. Where these people come from, their roots and commitment to the community as well as their own valuable notions of honor, ethics, justice and civil duty, all affect to a substantial degree how the administration of justice is fashioned and perceived.

Suffolk needs and deserves a federal court so that its 1.3 million people can benefit

from, participate in, and give local life to the federal judiciary's promotion of justice. H.R. 5619 serves Suffolk's best interests and, at the same time, weds the federal judiciary to her growth and bustle.

I would now like to address the questions posed by the Chairman. Of course, I stand ready to respond to any other inquiry by this Committee and would welcome the opportunity.

The need to enact H.R. 5619 is manifest. If my earlier remarks leave any doubts, they are resolved by empirical data and circumstance. In 1983, 5,729 cases were filed in the Eastern District, a 27.7% increase over 1982 (4,485 cases), and a 77.4% increase over the filings made in 1978 (3,229 cases). From December, 1983 to May, 1984, the most recent data available, Long Island cases amounted to approximately 30% of all civil cases filed with the Court. During this period alone, there were 2,778 civil cases filed (excluding the Agent Orange cases), of which 47.5% were "Suffolk County cases". Suffolk County, it seems, is already a font of federal litigation and exacerbates the already congested court calendar. Of course, more judges authorized to sit in the Eastern District would relieve the congestion to some degree—but circumstance has intervened, which makes the passage of H.R. 5619 crucial.

The existing federal court facilities in Brooklyn and Uniondale are in full use and overcrowded. There is simply no more room to accommodate even one more judge, let alone the two currently approved for the Eastern District by P.L. 98-353. H.R. 5619 relieves the pressure for more space.

Another circumstance underscoring the need to enact H.R. 5619 is the distance litigants, attorneys, jury members and candidates must now commute in order to participate in the working of the federal judiciary. Depending on where the Suffolk resident begins the trip, as much as four hours can be spent travelling one way to the Court. These distance and time factors place great hardship on litigants, lawyers, jurors and witnesses. Their proclivity to participate in the process becomes lessened.

The costs of the proposed reorganization are minimal. Additional authorization for the expenditure of federal dollars is neither necessary nor sought by my bill, certainly good news for the budget conscious. Suffolk's federal courthouse would be located on leased property, having an average cost of less than \$20 per square foot. Approximately 12,560 square feet of space would be sufficient to accommodate the chambers, courtrooms and libraries of two federal judges, one magistrate, a clerk and probation office, conference rooms and jury deliberation rooms, for a total of \$251,200 per year.

The alternative means serving the same purpose as H.R. 5619 would be: (1) to establish a new judicial district for Long Island, or (2) take over space somewhere in Brooklyn. Suffice it to say that these options would be more costly and, in the latter case, insensitive to the present need for the federal court facility in Suffolk.

The support for a federal court facility in Suffolk County is broad-based. I am pleased to advise the Chairman that I have secured the approvals of the judicial council of the Second Circuit as well as the Chief Judge and judges who sit on the Board of Judges of the United States District Court for the Eastern District of New York. I include herewith, for the record, copies of the correspondence to such effect. Further, my office has been advised that the Suffolk County Bar Association, as well as the administrative office of the local courts, approve of the

establishment of a federal courthouse in Hauppauge.

I am aware of no opposition to H.R. 5619.

#### CONCLUSION

The administration of justice in this federal republic admits to no formula. It is molded by people who have diverse interests and concerns. The duty of the judge is to harmonize these seemingly conflicting voices so that fair and equitable application of our laws occurs in a convenient and accessible environment. Where the judge holds court and where the litigants, attorneys, jurors, witnesses and court employees live and have their roots, indelibly colors the process by which the judge is summoned to fashion justice. Suffolk County deserves to be part of this process. H.R. 5619 enables Suffolk, with its own distinct values of law and order, to participate fully in and reap the benefits of the tailored, deliberate application of justice.

Thank you again for allowing me this opportunity to state my case for Long Island.

U.S. COURTS, JUDICIAL COUNCIL  
OF THE SECOND CIRCUIT,  
New York, NY, April 10, 1984.

Mr. WILLIAM E. FOLEY,  
Director, Administrative Office of the U.S.  
Courts, Washington, DC.

DEAR MR. FOLEY: This is to inform you that the Judicial Council of the Second Circuit unanimously supports the proposal of the Board of Judges of the Eastern District of New York that Hauppauge, Long Island be made a place where court may be held in that district. In accordance with this action and the attached resolution, the Judicial Council and the Eastern District Board of Judges will be pleased if you will take the earliest possible steps to amend 28 U.S.C. § 112(c) and begin the process of obtaining space. There are, I understand, available facilities that could possibly serve the court's purpose.

Hauppauge is in Suffolk County, Long Island, a county that now has a population in excess of 1.3 million people. Hauppauge is 35 miles east of the courthouse that was recently opened at Uniondale, in Nassau County, and would serve a fast-growing and populous region. As you know, there is an acute shortage of space for court facilities in the Eastern District of New York. Adding Hauppauge will permit the Administrative Office to resolve a portion of the urgent need for space in the district at the relatively low costs available in Suffolk County, rather than responding entirely by undertaking much higher costs for space in Brooklyn.

Thank you for your assistance in this matter. Please let me know if I or any of us can provide any additional information.

Sincerely,

STEVEN FLANDERS.

#### RESOLUTION

Be it resolved by the Board of Judges, United States District Court for the Eastern District of New York that Hauppauge in Suffolk County on Long Island be designated as a place of holding court for the United States District Court.

#### THE FEDERAL COURTS CIVIL PRIORITIES ACT

● Mr. LEAHY. I think every Member of this body, and particularly members of the Judiciary Committee, must be aware of the importance of the Federal Courts Civil Priorities Act. There are so many different priorities scattered through the Federal statutes right now that no Federal judge can be expected to resolve conflicts.

I am pleased that we are eliminating the problem, and I am doubly pleased that we are doing so in a way that acknowledges the special importance of the Freedom of Information Act.

Under this legislation, we are imposing a good cause standard to replace the maze of specific priorities existing up to now. "Good cause" is then defined as follows:

For purposes of this subsection, "good cause" is shown if a right under the Constitution of the United States or a Federal Statute (including rights under section 552 of title 5) would be maintained in a factual context that indicates that a request for expedited consideration has merit.

Section 552, of course, is the Freedom of Information Act.

Is it the Senator's understanding, as it is mine, that in adopting this legislation, we are underscoring the unique importance of FOIA?

● Mr. DOLE. I see no other way to construe that statutory language.

● Mr. LEAHY. The language in the House report is excellent on this point—and I think it strongly supports our own understanding.

I was very pleased that on page 5 of the report, the following assurance is given:

The Committee recognizes in Section 2(A) the special nature of Freedom of Information Act cases. This section recognizes the need to expedite hearings upon the showing of "good cause" and defines good cause as including a right under section 552 of title 5, the Freedom of Information Act (FOIA).

This language, together with remarks on page 6 of the report, is a clear direction to judges to construe this bill liberally to give FOIA cases the same fast track they would enjoy as a matter of absolute right under existing law.

My understanding is that as a practical matter, FOIA cases will have the same priority under this bill as under present law.

● Mr. DOLE. Again, I agree. And while we are talking about practicality, it occurs to me that this bill is a stronger direction to judges than under present law in some cases. Under existing law, a FOIA priority might have to compete with other statutory priorities and might not, in fact, get expedited treatment. Since FOIA is the only statute specifically named in the definition of "good cause" and since some cases will always be heard before others, I take this language to mean that judges will weigh the importance of expedition in FOIA cases very heavily in determining priorities.

● Mr. LEAHY. I agree that FOIA cases should come out of this bill with a very strong presumption of priority, and I agree with the Senator that, as a practical matter, most FOIA cases should be in a better position to enjoy priority treatment than under present law.

There is just one more point I would like to raise. The House report makes it very clear that the repeal of statutory priorities is not intended to elimi-

nate or discourage the continuation of judicially created priorities which experience shows are warranted.

● Mr. DOLE. That is an important point. We are making our statutes simpler and less rigid for the very purpose of giving room to judges to use their practical experience. It would be ironic, and wrong, if anyone construed this bill to have the effect of eliminating priorities that judges know are needed.

● Mr. LEAHY. In the House report, the committee gives some specific examples, and cites *United States v. Hodgson*, 492 F.2d 1175, 1178 (10th Cir. 1974) and *United States v. Davey*, 426 F.2d 842,845 (2d Cir. 1970), concerning certain appeals from decisions of the Commodity Futures Trading Commission.

Where cases, such as the Commodity Futures Trading Commission cases, have deserved priority in the past, the judicial discretion that led to that priority should be applied under the new "good cause" standard.●

The PRESIDING OFFICER. The question is on agreeing to the second-degree amendment.

The second-degree amendment (No. 6996) was agreed to.

The PRESIDING OFFICER. The question is on agreeing to the substitute, as amended.

The substitute amendment (No. 6996), as amended, was agreed to.

Mr. CRANSTON. Mr. President, I think this is a fine amendment and will be of great help to the semiconductor industry in California.

The PRESIDING OFFICER. The question is on the engrossment of the amendments and the third reading of the bill.

The amendments were ordered to be engrossed and the bill to be read a third time.

The bill was read the third time and passed.

Mr. BAKER. Mr. President, I move to reconsider the vote by which the bill was passed.

Mr. BYRD. I move to lay that motion on the table.

The motion to lay on the table was agreed to.

#### CONSIDERATION OF CERTAIN RESOLUTIONS

Mr. BAKER. Mr. President, I ask unanimous consent that the Senate proceed to the consideration of four resolutions.

The PRESIDING OFFICER. Without objection, it is so ordered.

#### SENATE LEGAL COUNSEL APPEARANCE IN DR. PAUL KURTZ VERSUS WILLIAM J. BARRETT

The Senate proceeded to consider the resolution (S. Res. 468) to direct the Senate Legal Counsel to appear as amicus curiae in Dr. Paul Kurtz versus