Republic of the Philippines
Department of Trade and Industry
Bureau of Patents, Trademarks
and Technology Transfer
Trade and Industry Building
361 (Buendia) Sen. Gil J. Puyat Avenue
Makati, Metro Manila, Philippines 3117

METAL FORMING CORPORATION, Petitioner,	INTER PARTES CASE NO. 3492 Cancellation
- versus -	Letters Patent No. D-3903 Issued on : August 19, 1987 Patentee : Abeto Uy Title : **ROOFING SHEET**
ABETO UY, Respondent-Patentee.	DECISION NO. 94-13 (PAT) January 24, 1994

D E C I S I O N

This is an inter partes proceedings for the cancellation of Philippine Letters Patent No. D-3903 for a design of a roofing sheet issued on 19 August 1987 in the name of Respondent-Patentee, Abeto Uy with postal address at 357 Buendia Avenue Extension, Makati, Metro Manila.

The Petitioner, a Philippine Corporation with principal Office at Reliance Street, 1501 Mandaluyong, Metro Manila filed this Petition on 06 November 1989 alleging the following grounds for cancellation:

"1. The design embodied in D-3903 is not novel;

2. The design embodied in D-3903 is not original;

3. The Patentee of D-3903, Uy, is not the first, original, true and actual designer of said design;

4. The Letters Patent No. D-3903 was issued erroneously, not having taken into consideration the prior art therefor, namely Letters Patent No. D-313 ("D-313") for structural Roofing granted on December 22, 1966 to herein Petitioner and renewed as D-241 on November 2, 1977;

5. The Petitioner has been damaged and prejudiced and continues to suffer and be prejudiced by the issuance of D-3903;

6. The goodwill and business reputation of Petitioner has suffered and continues to suffer great and irreparable injury."

In addition the Petitioner averred the following facts to support this Petition:

"1. The design embodied in D-3903 has been disclosed by Ricardo L. Segismundo, Designer-Assignor in D-313, which patent was however not cited as prior art in the prosecution of SN D-6174;

2. Petitioner filed Patent Application Serial Nos. UM-8788 and D-5351 both for TWIN-RIB ROOFING SHEETS on March 23, 1989, which applications were however rejected for lack of novelty, with D-3903 cited as prior art;

3. The grant of D-3903 places Petitioner in danger of being sued for patent infringement, being a manufacturer, distributor and marketing agent for roofing materials which are in accordance with the design embodied in D-313, D-5351 and UM-8788;

4. Petitioner has manufactured, distributed and marketed said roofing materials for more than five (5) years, and as a result thereof, said roofing materials have become distinctive to Petitioner who has acquired goodwill thereover."

In its answer, the Respondent-Patentee denied the material allegations of the Petition for Cancellation and set raised the following affirmative special defenses:

"1. Respondent-Patentee is the first, original, true and actual designer of the design embodied in D-3903;

2. The design embodied in D-3903 is novel and original;

3. The design embodied in D-3903 and petitioner's D-313 are not identical or similar, there being substantial differences marking the uniqueness of the designs. A comparison of the two designs will easily reveal the differences. Marked as Annexes "A" and "B" are D-3903 and petitioner's D-313, respectively;

4. The examination of respondent-patentee's Application Serial No. D-6174 (which eventually became D-3903) was done in the regular course of duty which legal presumption rebuts petitioner's allegation that "the design embodied in D-3903 has been disclosed by Ricardo L. Segismundo, Designor-Assignor in D-313, which patent was

however not cited as prior art in the prosecution of Serial No. D-6174"; (par. 1 of the Factual Basis of the Grounds for Cancellation)

5. If the designs embodied in petitioner's Application Serial Nos. D-5351 and UM-8788 are indeed identical or similar to respondent-patentee's D-3903, then petitioner's applied design patent should not be granted;

6. Moreover, should the designs covered by petitioner's Serial Nos. D-5351 and UM-8788 continue to be used in its roofing structures and being marketed as such, such practice should discontinue for violating the right of the respondent-patentee given to him by D-3903;

7. Petitioner's patent Application Serial Nos. UM-8788 and D-5351 are actionable documents as the designs therein are alleged to be similar to respondent-patentee's D-3903."

After failing to reach an amicable settlement between the parties during the pre-trial conference, this Office proceeded to receive the evidence of both parties.

In proving that the roofing design of the Respondent-Registrant was not new at the time it was applied for Petitioner offered in evidence Exhibits "E-1" to "E-7" consisting of brochures describing a design of a roofing material with twin trapezoidal-shaped ridges. It also offered in evidence, Exhibit "A" and its submarkings which refers to Letters Patent No. D-95 (Extended as D-241 and D-313) issued to Ricardo Segismundo on 22 December 1966.

On this point, this Office rules that Exhibits "E-1" to "E-7" cannot be considered as a, "prior art" because they do not contain dates of publication. The date found in the brochures was hand written and could not be considered as part of the brochures hence, inadmissible as evidence of the date of their publication.

With respect to the alleged Patent Application Serial Nos. UM-8788 and D-5351 filed by the Petitioner, these documents were not presented but only a certification of this Office that the same was declared abandoned and lost. Hence, the contents thereof could not be considered in this proceeding.

The only issue to be resolved is whether the design sought to be cancelled D-3903, is similar to Letters Patent No. D-313?

D-313 is a roofing design consisting of a series of closely arranged trapezoidal ridges. On the otherhand, D-3Ø3 displays spaced minute triangular ridges disposed alternately between pairs of closely arranged trapezoidal-shaped ridges.

A design in the view of the Patent Law, is that characteristic of physical substance which by means of lines, images, configuration and the like taken as a whole make an impression, through the eye, upon the mind of the observer, with the thing observed, of uniqueness and character. In other words, it is that which gives a peculiar or distinctive appearance to the article to which it may be applied, or to which it may give form. The characteristic features of a design may reside in the symmetry and proportion of the manufacturer, or in its decorative design, or in the combination of the two. In other words, the impression produced may be the result of peculiarity of configuration or of ornament alone, or of both jointly. The essence of a design resides in the appearance of the design as a whole, not in the elements individually, or in their method of arrangement (48C.J., Section 21).

In Co San v Jose Ong Lian Bio (Decision No. 1Ø8, March 15, 1956), the Director cited the rule laid down in Gorham v White, 81 U.S. 511, to wit:

> "If in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, including him to purchase one, supposing it to be the other, the first one patented is infringed by the other".

We find that there is no substantive identity between the two designs.

WHEREFORE, premises considered, this Petition for Cancellation of Letters Patent No. 3Ø3 is hereby DISMISSED.

Let a copy of this Decision be furnished the Mechanical and Electrical Examining Division for their information and guidance.

SO ORDERED.

IGNACIO S. SAPALO
Director