

JESSIE G. CHING & SHIRLEY
ORGAS CHING, doing business under
the partnership name JESHICRIS
MFG. COMPANY,
Petitioners,

Inter Partes Case No.
13-2001-00017/29/30/31/32

Petition to Cancel:
Industrial Design Registration
No. 3-1999-000175/76/78/79/80

-versus-

Title: Tumbler, Plate, Soup
Bowl, Oval Plate, Soup Plate

WILLIAM L. SALINAS, JR.,
Respondent-Registrant.

Decision No. 2003-39

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DECISION

Jessie Ching and Shirley Orgas Ching (“Petitioners”, for brevity), doing business as partners under the name Jeshicris Manufacturing Company, brought the above-captioned petitions to cancel various industrial design registrations for Tumbler, Plate, Soup Bowl, Oval Plate and Soup Plate all issued in the name of William Salinas, Jr. (“Respondent”, for brevity) on the ground of lack of novelty.

Petitioner made the following allegations in its petitions dated July 10, 2001:

“19. Section 120 of R.S. 8293 provides for the cancellation of Industrial Registration at any time during the term of said registration to cancel the industrial design on any of the following grounds: (a) if the subject matter of the industrial design registration is not registrable within the terms of Secs. 112 and 113; (b) if the subject matter is not new; or (c) if the subject matter of the industrial design extends beyond the content of the application as originally filed;

20. Respondent’s Industrial Design Patents (Annexes “A” to “E”) cannot possibly pass for NEW AND INDUSTRIAL PRODUCTS OR HANDICRAFTS. There is no way for a plastic tumbler, soup plate, oval plate, soup bowl and plate as claimed by Respondent to be a new and industrial product.

21. On the basis of the applications alone of respondent with the IPO, the drawings of the plastic tumbler, soup plate, oval plate, soup bowl and plate bear no original or special appearance to qualify as an industrial design worthy of protection and registration.

22. Indeed, the plastic tumbler, soup plate, oval plate, soup bowl and plate of Respondent suing the name WILLAWARE are not distinguishable from Complainant’s products using the name MILLWARE except for minor details. This is because a plate is a plate; a soup bowl is a soup bowl; a plastic tumbler is a plastic tumbler.

23. As a matter of fact, Respondent’s Willaware plastic products are not DISTINGUISHABLE from other plastic tumblers, plastic plates, plastic soup bowls manufactured and sold in the market with the brand names MELAWARE, BEST WARE AND WARE TECH, to name a few. The only difference, if any, between Willaware plastic products and others in the market (i.e., Melaware, Best Ware, and Ware Tech) are in minor designs and colors, and the EMBOSSSED NAME which the manufacturer relies on.

24. Complainant is therefore entitled for the cancellation of the Industrial Design Patents (Annexes "A" to "E") of Respondent under Sec. 120 of R.A. 8293 in relation to Sec. 112 and 113 thereof."

In its Answer dated August 28, 2001, Respondent denied the material allegations of the Petition and interposed the following affirmative defenses:

"(a) The design registration subject matter of this Petition for Cancellation is novel at the time of the application therefor;

(b) There is no showing of lack of novelty in the Petition."

After joinder of the issues, the case was set for pre-trial conference, but when the parties failed to arrive at an amicable settlement, the case proceeded to trial on the merits.

Petitioners presented the testimonies of Jessie Ching and Zaide Delfin, and offered documentary and object evidence consisting of the following: Exh. "A" (cookbook entitled Kikkoman Supple Gourmet); Exh. "B" (cookbook entitled Entertaining by Malcolm Hillier); Exh. "C" (recipe book entitled The Authentic Taste of China); Exh. "D" (recipe book entitled Le Cordon Blu Home Collection Potatoes); Exh. "E" (recipe book entitled Oriental Noodles; Exh. "F" (recipe book entitled The Food Cook Book); Exhs. "G" to "PP" (dinner plates, oval plates, tumblers, soup plates and soup bowls); Exhs. "QQ" to "UU" (various brochure and catalogues); Exhs. "BB" to "AAA" (various brands of dinner plates, tumblers, oval plates, soup bowls, soup plates); Exhs. "BBB" to "FFF" (industrial design registrations issued to Respondent); Exhs. "GGG" to "SSS" (various plates and bowls manufactured by Petitioner); Exhs. "TTT" to "TTT-9" (product catalogue to Melaware); Exhs. "UUU" (company profile of Melaware); and Exhs. "VVV" to "VVV-5" (pricelist of kitchenware products of Melaware), which were admitted evidence under Order No. 2003-89 dated February 28, 2003.

For its part, Respondent presented the testimony of William Salinas, and offered the following documents: Exhs. "1-G" to "1-Z", "1-AA", "1-CC" to "1-FF", "1-HH" to "1-KK", "1-MM" to "1-NN", "1-VV" to "1-ZZ", "1-AAA" (store receipts covering the purchase of various kitchenware products) and Exh. "2" (affidavit to William Salinas), which were admitted in evidence under Order No. 2003-393 dated September 30, 2003.

After the parties submitted their memoranda, the case was deemed submitted for decision on the issue of whether the industrial design patents in the name of the Respondent should be cancelled for lack of novelty.

An industrial design is any composition of lines or colors or any three-dimensional form, whether or not associated with lines or colors, provided that such composition or form gives a special appearance to and can serve as pattern for an industrial product or handicraft. [Sec. 11, Rep. Act 8293]. It refers to that aspect of a useful article which is ornamental or aesthetic and which is not determined by technical or functional necessity, and may consist of three-dimensional features, such as the shape of an article, or of two-dimensional features, such as patterns, lines or color. [Rule 301, Rules and Regulations on Utility Models and Industrial Designs].

The claims of the design patents subject matter of these cases read as follows:

Title	Registration No.	Date Filed	Claim
Tumbler	3-99-00175	3-15-99	The ornamental design for a tumbler substantially as shown in the drawing.
Plate	3-99-00176	3-15-99	The ornamental design for a plate substantially shown in the drawing.

Soup Bowl	3-99-00178	3-15-99	The ornamental design for a soup bowl substantially as shown in the drawing.
Oval Plate	3-99-00179	3-15-99	The ornamental design for an oval plate substantially as shown in the drawing.
Soup Plate	3-99-00180	3-15-99	The ornamental design for a soup plate substantially as shown in the drawing.

A reading of the above claims together with the drawing contained in the file wrappers indicate that the only limitation or feature of the articles for which design protection is asserted is in respect of their three-dimensional features or shapes. At the pre-trial conference, Respondent stipulated that his tumblers, plates, soup bowls, oval plates and soup plates do not contain any paintings, designs or inscriptions, except for the mark appearing on their bottom sections. [see *Pre-trial Order No. 2002-435 dated September 10, 2002*]. This means that the novelty being claimed by Respondent relates to the shape or configuration of the kitchenware products, and there is no element relating to their two-dimensional features like patterns, lines or colors.

Under the law, only industrial designs that are new or original shall benefit from protection, [Sec. 13.1] and an industrial design that does not satisfy this requirement may be cancelled pursuant to the same novelty and prior art standards used in inventions. [Sec. 120.1 (b) and Sec. 119 in relation Secs. 23 & 24]. The standard of novelty established by Sections 23 (Novelty) and 25 (Non-prejudicial Disclosure) of Rep. Act 8293 applies to industrial designs: provided that the period of twelve (12) months specified in Section 25 shall be six (6) in the case of designs. [Rule 302, Rules and Regulations on Utility Models and Industrial Designs].

Whether a design possesses the requirement of novelty must be judged from the overall visual appearance of the design, not from emphasis upon or preoccupation with any of its individual elements. It must be the sameness in appearance, and mere differences in lines in the drawing or sketch, a greater or smaller lines or slight variances in configuration, if insufficient to change the effect in the eye, will not destroy the substantial identity. [*Hanabishi Philippines, Inc. vs. Segundo Ng and 3D Industries, Inc., Inter Partes Case No. 3420, November 12, 1991*].

The cookbooks presented by the Petitioner show pictorial illustrations of tumblers, plates, bowls and various kitchenware products that are no different in design compared to those of Respondent. For instance, the dinner plate shown in the cookbooks exhibit the same shape and contour as those of Respondent's plate designs. [see page 87, Exh. "E"; pages 18-19, 107, Exh. "B"]. The oval plates of Respondent share the same configuration as those in the recipe books. [see page 61, 85, Exh. "E"; page 19, Exh. "C"]. Also, the soup bowls in the recipe books and design of Respondent have the same tapered walls and configuration of the base and rim. [see pages 3, 4, 32, 57, Exh. "E"]. The soup plates of Respondent and those shown in the recipe books have the same outline. [see page 68, Exh. "F"]. The tumbler of Respondent also has the same configuration of mouth, base and sidewalls as those in the cookbooks. [page 140, Exh. "B"]. In short, the overall visual appearance of Respondent's designs are no different from those in the prior art references, which were published several years ahead of the filing of Respondent's application for design registrations in 1999. [see *Entertaining by Malcolm Hillier, Dorling Kindersley, London, 1997, 1999, pages 19, 27, 107, 141 (Exh. "B"); The Authentic Taste of China, Lorenz Books, London, 1996, 1999, pages 19-20 (Exh. "C"); The Australian Women's Weekly Cookbooks, ACP Publishing Pty. Limited, 1997, 1999, pages 4, 47, 48, 57, 58, 61, 62, 85-88 (Exh. "E"); and The Good Food Cookbook, Optimum Publishing Company, 1993, page 68 (Exh. "F")*].

From the evidence presented, it is not difficult to see why the designs of Respondent cannot be considered to possess the requirement of novelty. When compared to the designs illustrated in the prior art references, they show sameness in appearance and minimal variances in their configuration. This must be so since the designs of kitchenware articles like plates, bowls and tumblers have universally accepted shapes or outlines. The fact that ordinary kitchenware products have very common configurations can further be shown by the brochures and catalogues presented by Petitioner [see *Melawares Product Brochure, Melamine Dinnerware*

(Exh. "QQ" to "QQ-10"); Melawares Product Catalogue, Melamine Dinerware (Exh. "TTT" to "TTT-7"); J&T Product Catalogue (Exh. "SS" to "SS-3"); Tupperware Product Catalogue, July 2-December 30, 2001, page 9 (Exh. "TT-1") and page 15 (Exh. "TT-2" to "TT-3"); Waretech Product Brochure (Exh. "UU"); Best Ware Product Brochure (Exh. "RR" to "RR-1"); Melaware Company Profile (Exh. "UUU"); and Melaware Price List (Exh. "VVV"), as well as the various brands of tumblers, plates, oval plates, soup plates and soup bowls available in the market. [see Exhs. "G" to "PP", "WW" to "ZZ", and "GGG" to "SSS"].

An industrial design shall not be considered new if it differs from prior designs in minor respects that it can be mistaken as such prior designs by an ordinary observer. It is the appearance itself that constitutes mainly, if not entirely, the contribution to the public (by any design), which the law deems worthy to recompense. [see *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511 (1871)]. Since the designs of the Respondent do not show any difference compared to the prior designs and therefore, nor novel, Respondent cannot seek protection under the provisions on industrial design laws.

WHEREFORE, finding substantial and clear evidence that the design patents of Respondent are not novel having been anticipated by prior art, the instant petitions are hereby GRANTED, and industrial Design Registration No. 3-1999-000175/76/78/79/80 all issued in the name of William Salinas, Jr. are hereby ordered CANCELLED.

Let the file wrappers of the abovementioned design patents subject matter of the instant cases be forwarded to the Administrative, Financial and Human Resources Development Service Bureau for appropriate action in accordance with this Decision, with a copy thereof to be furnished the Bureau of Patents for information and to update its record.

SO ORDERED.

Makati City, December 23, 2003.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs