

ERIBERTO G. SANDOVAL,  
Complainant-Appellant,

APPEAL NO. 10-2004-00001  
IPV NO. 10-2001-00003

- versus -

For: Infringement of Copyright and  
Industrial Design with Prayer  
For Damages and Application  
for TRO and / or Preliminary  
Injunction

SPOUSES LIBERATOR and  
HEIDI BISCOCHO

Respondents-Appellees.

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## DECISION

This concerns Decision No.2003-03 dated 23 December 2003 rendered by the Director of the Bureau of Legal Affairs (Director) dismissing the Complaint for Infringement of Copyright and Industrial Design with Prayer for Damages and Application for TRO and /or Preliminary injunction filed by ERIBERTO G. SANDOVAL against spouses LIBERATO AND HEIDI BISCOCHO The Director also ordered the Cancellation of Certificate of Industrial Design Registration No. 3-2000-00528 issued on March 2001 in favor of ERIBERTO G. SANDOVAL.

The controversies in this case are: (1) Whether or not Respondents-Appellees LIBERATO AND HEIDI BISCOCHO (Appellees) are liable for infringement of copyright and Industrial Design supposedly owned by Complainant-Appellant ERIBERTO G. SANDOVAL (Appellant); and (2) Whether or not Industrial Design Registration No. 3-2000-00528 should be cancelled.

Records show that on 25 May 2001, Appellant initially filed with the Bureau of Legal Affairs a Complaint for Infringement of Industrial Design. Although the Appellees already filed an Answer with Counterclaim on 21 June 2001, Appellant however filed a Notice of Appearance with Motion with Leave to Withdraw First Complaint Filed and to Admit Attached Amended Complaint on 12 July 2001. The Amended Complaint was for infringement of Patent and of Copyright and Related Rights with Prayer for a Writ or Preliminary Injunction or a Temporary Restraining Order (TRO), and alleged the following, to wit:

1. Appellant is the maker/designer and registered owner of an Industrial design (ornamental wall décor) entitled "GODDESS OF FORTUNE AND GOODWILL" covered by Certificate of Registration No. 3-2000-00528.
2. The ornamental design is also recorded, registered and deposited with the National Library as shown by the Certificated of Copyright Registration and Deposit No. G-2000-234 issued on 22 September 2000.
3. Immediately after 21 September 2000, the filling date of his application for registration of an Industrial Design and also of his application for copyright Registration and Deposit, Appellant commenced the making, production, distribution and sale to the public of the aforestated products/article.
4. Sometime in February 2001, Appellant discovered that the Appellees were making, producing, distributing offering for sale and actually selling to the public for profit/commercial purposes a product/article bearing or embodying a design which is a copy or imitation, or substantially a copy or imitation, of the protected product/article of Appellant without his consent and authority.
5. Appellant confronted the Appellees about the matter and demanded that they stop and refrain from further doing so but the latte refused and continuously refused to do so for no justifiable reason.

6. The malicious and unwarranted acts of the Appellees constitute acts of infringement in clear violation of the Intellectual Property Rights of the Appellant. As a patentee, and holder of an Industrial Design registration and a copyright holder as well, the Appellant is duly entitled to the fullest protection of Republic Act No. 8293, otherwise known as the Intellectual Property Code, and its implementing guidelines.

Appellant sought the issuance of a TRO and/or writ of preliminary injunction, alleging that the continuous conduct of the Appellees in making, producing, distributing, offering for sale, and actually selling to the public of a copied or imitated product causes him grave and irreparable injury.

In their Amended Answer, the Appellees denied the material allegations of the complaint and sought the dismissal of the case for lack of cause of action on the ground that Appellant is not the author, maker or designer of the contested work. The Appellees claimed that the Appellant just borrowed the will décor from somebody else, copied it, and immediately, thereafter, reproduced the same in commercial quantities intended for sale to the public and actually engaged in actual sale thereof. According to the Appellees, the Appellant, not being the true designer and maker thereof, has not presented any evidence showing his authority from the original creator, believed to be of foreign and medieval origin, of such design much less, with knowledge and consent of the person from whom he borrowed the same.

The Appellees also contended that given the availability of the subject wall décor in the market for a long period of time which is even prior to the Appellants patent application, and coupled with the Appellant's erroneous and self-serving proclamation to be the author of such creation, the latter cannot claim exclusive right to use the same since irrevocable rights thereon vested to the public in general.

On 23 December 2003, the Director rendered the assailed Decision. The pertinent portion of which reads, as follows, to wit:

Consequently, Appellant filed a Notice of Appeal together with the Appeal together with the appeal fee on 28 January 2004. Noting that the mode of appeal pursued by the Appellant was not in accordance with section 3 of the IPO Uniform Rules on Appeal, this Office issued an order dated 29 January 2004 giving the Appellant not later than 13 February 2004 to file the required appeal Memorandum. The Appellant filed a Motion for Time Extension to File Appeal memorandum on 10 March 2004, seeking an additional period of thirty (30) days from 13 February 2004 or until 14 March 2004, within which to file the appeal memorandum. In the interest of substantial justice, this Office per order dated 24 February 2004 gave Appellant up to 05 March 2004, to file his appeal memorandum and to pay the corresponding fee in filing the motion, as well as the applicable surcharge for late payment of fees.

On 10 March 2004, the Appellant filed a Motion for Reconsideration claiming that his non-compliance to the aforesaid order was due to the lapses in communication when he transferred to his new office in Laguna. He asked that this Office reconsider its Order dated 24 February 2004 and allow him to file the Appeal Memorandum on or before 14 March 2004. The Appellant, however, filed the Appeal Memorandum on 15 March 2004. On 31 March 2004, this Office issued an Order giving Appellees thirty (30) days from receipt thereof to file their Comment to the Appeal Memorandum and at the same time ordering the Director to forward the records of the case within the aforementioned period.

In his appeal, The Appellant contends that the Director gravely erred in:

- 1) Totally disregarding and ignoring the fact that Appellant is a registered owner of a certificate of Patent Registration issued by the Intellectual Property Office, and therefore, entitled to the full protection of R.A 8293 and its implementing guidelines; and

- 2) Holding that the Industrial Design of Appellant is neither new or original having been anticipated by prior act and hence should be cancelled.

In their comment filed on 30 April 2004, Appellees argued that this Office should not have given the Appellant additional period until 05 March 2004 to file his appeal memorandum because the decision of the Director dismissing the complaint and ordering the cancellation of the Industrial design registration had attained finality by that time. The Appellees posits that having sufficiently established that the subject wall décor is not new or original, it is understandable that the Director found no difficulty in rejecting the Appellant's claims. According to the Appellees, the verdict of the Director is fully supported by substantial evidence and that she had not acted whimsically and with grave abuse of discretion.

Meanwhile, the Appellees filed a Motion to Defer Resolution of Appeal on 09 July 2004. According to the Appellees, they have a pending Motion for [partial] Reconsideration of the appealed Decision in the BLA which should be first resolved. Denying said motion, this Office held that it has acquired jurisdiction over the case on appeal and the Director has already forwarded the entire records of the case. Also the records show that the Appellee participated in the proceedings by filing their comment and subsequently their Memorandum and Draft Decision

After consideration of the foregoing and review of the records of this case, this Office finds the appeal devoid of merit.

On the procedural issue raised by the Appellees, this Office holds that the matter should be tempered with reason. In this instance, the Supreme Court has held that the court has discretion to dismiss an appeal. It is a power conferred on the court, not a duty. The discretion must be a sound one, to be exercised in accordance with the tenets of justice and fair play, having in mind the circumstances obtaining in each case. Technicalities, as much as possible, should be avoided. The law abhors technicalities that impede the cause of justice. The court's primary duty is to render or dispense justice. A litigation is not a game of technicalities. Law suits, unlike duels, are not to be won by a rapier's thrust. Technicality, when it deserts its proper as an aid to justice and becomes its great hindrance and chief enemy, deserves scant consideration from courts. Litigations must be decided on their merits and not on technicality. Every party litigant must be afforded the amplest opportunity for the proper and just determination of his cause, free from the unacceptable plea of technicalities. Thus, dismissal of appeals purely on technical grounds is frowned upon where the policy of the court is to encourage hearings of appeals on their merits and rules of procedure ought not to be applied in a very rigid, technical sense; rules of procedure are used only to help secure, not override substantial justice. It is a far better and more prudent course of action for the court to excuse a technical lapse and afford the parties a review of the case on appeal to attain the ends of justice rather than dispose of the case on technicality and cause a grave injustice to the parties, giving a false impression of speedy disposal of cases while actually resulting in more delay, if not a miscarriage of justice

As to the main issues, this Office agrees with the Director that the Appellees cannot be held liable for infringement of copyright and industrial design in this case. As observed by the Director, indeed, with respect to the element of copying, there is no question that the works of the Appellant and Appellees are similar. As correctly pointed out by the Director, during the pre-trial conference, Appellees admitted that they are making, producing, distributing, offering for sale and actually selling to the public for profit/commercial purposes a product / article bearing or embodying a design which is a copy of imitation, or substantially a copy or limitation of the protected product / article of the Appellant, without the latter's consent. Appellee Liberato Biscocho even declared in his testimony that he only copied the wall décor sometime in the year 2000 from an existing work of another person whose name he could not recall. On this note, this Office concurs with the Appellee's assertions that the Appellant has no cause of action against them because he is not the author, maker or designer of the contested wall décor. The Appellees were able to submit evidence to show that the subject wall décor, which varies in name and representations, had been in the market long before the Appellant applied his "creation" for

patent registration on 21 September 2000 and that there are numerous identical and strikingly similar designs available in the market depicting the same images and style subject matter of Appellant's patented wall décor. The Appellees presented documentary and testimonial evidence, specifically, Plate No. 13, which was derived from page 379 of Encyclopedia Britannica (15<sup>th</sup> Edition) showing the Image of Helios. One of the paintings illustrated therein is a ceiling fresco painted by Guido Reni (1613-1614) called the "Aurora", which is presently displayed in the Casino Rospigliosi, Rome. The Appellant's design and the image of the aforementioned painting are reproduced below for comparison:

Front View of the Appellant's Wall Décor (Exhibit "A")



Image of Helios, the Sun God, (Plate No. 13) derived from Encyclopedia Britannica, 15<sup>th</sup> edition, page 379 (Exhibit "1-Rebuttal")



It can be gleaned from the foregoing pictures that they are similar in all aspects. This Office agrees with the Director that both of them show a female character leading a procession of several characters consisting of a man riding a chariot that is pulled by several horses and surrounded by seven (7) other female figures. A representation of an angle also appears on the upper right hand portion of both images.

Adding substance to the foregoing observation is the statement of the Appellant's witness, Irmina S. India, which suggests that the Appellant's work is similar with the "Aurora" of Guido Reni, to wit:

"ATTY. DIMAILIG: Now, would you kindly tell me what is the similarity between Exhibit 'A', that colored picture that I have there and this one?"

Let me show you again Exhibit 'A', the picture I have shown you. What is the similarity? Are they exactly similar?

WITNESS: Opo.

ATTY. DIMAILIG: And could you kindly read the information indicated on the right bottom side of that picture?

WITNESS: Aurora Ceiling Fresco by: Guido Reni.

ATTY. DIMAILIG: OK, and then?

WITNESS: 1613-14, in the casino Rispigliosi, Rome.”

The Appellant advances the argument that he came up with the wall décor design based on the ideal that horses bring good luck. He also declared that a certain Pastor Dadula assisted him in coming up with the design. However, the Appellant failed to provide an answer when asked to discuss the meaning of the other characters in the wall décor. Instead, he declared that his only contribution was in the design of the horses and the rest was by Rolando Dadula, to wit:

“ATTY. DIMAILIG: Now, you made mention also in your direct testimony that bits and pieces of horses, chariots, have been taken together in order to form what you now claim as the ornamental décor you named Goddess of Goodwill and Fortune. Do you attribute any significance on the horses, on the Chariot, on the angel that I have seen in the photocopy depicting the actual ornamental design? Ang ibig kong sabihin sa pagke-create mo, sa paglikha mo ng nasabing wall décor, mayroong mga kabayo kong nakikita noon, may mga anghel na nalipad, meron ka bang ibig sabihin sa mga ito?

WITNESS: Meron po.

ATTY. DIMAILIG: Itong kabayo, anong ibig sabihin nito?

WITNESS: Kasi po ang kabayo po sa pagkakaalam ko kasi, kadalasan kong nakikitang display sa mga bahay ang kabayo, swerte raw po iyon.

ATTY. DIMAILIG: Swerte?

WITNESS: Opo.

ATTY DIMAILIG: How about yung anghel?

ATTY. BARRAMEDA: Anong significance noon? Ano ang gusto mong ipahiwatig doon? Bakit mo ipinasok yung anghel sa disenyo? Ano ang purpose mo?

ATTY. DIMAILIG: Pwede naming isingit ang Diyos diyan, bakit anghel?

WITNESS: Yoon daw po ang liwanag.

ATTY. DIMAILIG: Ang anghel.

WITNESS: Opo.

ATTY. DIMAILIG: Sinong may sabi sa yong anghel ang liwanag?

WITNESS: Dahil ganito po yon, yon pong disenyo nabuo naming, hindi ng ako lang.

ATTY. DIMAILIG: I know. Sinong nag-recommend?

WITNESS: Yun pong aking kasama.

ATTY. DIMAILIG: Do you know who is this companion?

WITNESS: Rolando Pastor Dadula (sic).

ATTY. DIMAILIG: How about the people who surrounds the chariot being carried by this horse or horses? Anong ibig sabihin ng mga taong yan? What do they signify, their presence here?

ATTY. BARRAMEDA: Ang tinutukoy ni Attorney, itong mga taong ito, ano ang purpose niyan bakit mo isinigit yan? Ano ang gusto mong ipahiwatig diyan?

WITNESS: Eto po bale ang aming design na ito ay nakakaalam po ng ibig sabihing nito ay ang aking kasama. Siya po kasi ang nagdesign. Ang design ko lang po dito ay kabayo.”

Accordingly, the Copyright Law protects only works that are original to the author. As such, original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works) and that it possesses at least some minimal degree of creativity. In a nutshell, the works must have their origin in the labor of the author.

This Office, therefore, yields to the observation of the Director that it cannot give credence to the rather obscure testimony of Rolando Dadula. Indeed, it is peculiar that the alleged combined efforts of Appellant and Rolando Dadula in coming up with a wall décor design that would result to something that is exactly similar or identical to a complex and intricate 16<sup>th</sup> century baroque painting – with the same number of character, same position of figures and arrangement of elements up to their minutest details, and essentially depicting the same scene or overall impression that the wall décor that Appellant claims to be his original work is a mere copy of an already pre-existing work.

The argument of the Appellant that in addition to the Certificate of Copyright Registration and Deposit No. G2000-234 dated 22 September 2000, he was also issued an Industrial Design and Regulation No. 3-2000-00528, is of no moment. The law is clear that only new or original industrial designs are protected, and that an invention shall not be considered new if it forms part of a prior art. Aptly, prior art shall consist of everything which has been made available to the public anywhere in the world, before the filing date or the priority date of application claiming the invention. As correctly pointed out by the Director, an Industrial design shall not be considered new if it differs from prior art designs in minor respects that it can be mistaken as such prior designs by an ordinary observer.

Under the law, “original” has special reference to inventive genius in creating design, that is, the inventor must have created a design that is essentially different and superior to that might be created by person skilled in art. Mere exercise of routinary skill does not amount to design invention. It was held that to constitute a new design that is patentable, it had to be so different from all other existing before, as to have appeared to have been such to ordinary observer. On the same token, it was held that mere differences or variation in form, however pleasant and appealing, do not of themselves constitute patentable differentiation. What is required is that the design show some originality beyond the competency of the routine designer, some

characteristically different effect not suggested by the prior art or conventional formal variation which every designer or craftsman employs in the normal performance of his functions.

Precisely, as the Director held, the novelty of a design is to be tested, not by investigation of the means employed for its creation, but by ocular comparison of the design itself with prior designs, which are alleged to be substantially the same, Truly, the subject for consideration is not the process of creation, but the effect produced upon the eye by the thing created. What is required is that the design shows such originality, which may not be within the competence of the routine designer. To be patentable the design should display a characteristically different effect not suggested by the prior art.

For these reasons, this Office finds that the Industrial design of the Appellant is not new for it forms part of a prior art. The subject wall décor does not show any significant disparity if compared with the "Aurora" ceiling fresco of Guido Reni painted during the years 1613-1614, long before the Appellant's alleged date of creation and publication on 08 August 2000 and application for Industrial design Registration on 21 September 2000.

WHEREFORE, premises considered, there is no cogent reason to disturb Decision No. 2003-03 dated 23 December 2003 rendered by the Director of the Bureau of Legal Affairs. Accordingly, the instant appeal is DENIED and the appealed Decision is hereby AFFIRMED.

Let a copy of this Decision be furnished the Director of Bureau of Legal Affairs for appropriate action, and the records be returned to her for proper disposition. Further, let the Directors of the Bureau of Patents, the Documentation, Information and Technology Transfer Bureau and the Administrative, Financial and Human Resource Development Service Bureau be furnished copies hereof for information and/or appropriate action.

SO ORDERED

December 7, 2004, Makati City, Philippines

EMMA C. FRANCISCO  
Director General