Republic of the Philippines
SUPREME COURT
Manila

EN BANC

G.R. No. L-38010 December 21, 1933

PATRICK HENRY FRANK and WILLIAM HENRY GOHN, plaintiffs-appellants,

vs.

G. KOSUYAMA, defendant-appellee.

*J.W. Ferrier for appellants.*
*Pablo Lorenzo for appellee.*

IMPERIAL, *J.:*

Patent No. 1519579 (Exhibit 117) on improvement in hemp stripping machines, issued by the United States Patent Office on December 16,1924, and registered in the Bureau of Commerce and Industry of the Philippine Islands on March 17,1925, was the origin of this action brought by the plaintiffs herein who prayed that the judgment be rendered against the defendant, ordering him thereby to refrain immediately from the manufacture and sale of machines similar to the one covered by the patent: to render an accounting of the profits realized from the manufacture and sale of the machines in question; that in case of refusal or failure to render such accounting, the defendants be ordered to pay the plaintiffs the sum of P60 as profit on each machine manufactured or sold by him; that upon approval of the required bond, said defendant be restrained from continuing the manufacture and sale of the same kind of machines; that after the trial the preliminary injunction issued therein be declared permanent and, lastly, that the said defendant be sentenced to pay the costs and whatever damages the plaintiffs might be able to prove therein. The action therefore was based upon alleged infringement by the defendant of the rights and privileges acquired by the plaintiffs over the aforesaid patent through the manufacture and sale by the former of machines similar to that covered by the aforesaid patent.

The plaintiffs appealed from the judgment rendered by the trial court dismissing their complaint, with cost, as well as the defendant's counterclaim of P10, 000. The defendant did not appeal.

In their amended complaint, the plaintiff alleged that their hemp stripping machines, for which they obtained a patent, have the following characteristics: "A stripping head, a horizontal table, a stripping knife supported upon such table, a tapering spindle, a rest holder adjustably secured on the table portion, a lever and means of compelling the knife to close upon the table, a pallet or rest in the bottom of the table, a resilient cushion under such palletor rest." In spite of the fact that they filed an amended complaint from which the "spindle" or conical drum, which was the only characteristic feature of the machine mentioned in the original complaint, was eliminated, the plaintiffs insisted that the said part constitutes the essential difference between the machine in question and other machines and that it was the principal consideration upon which their patent was issued. The said plaintiffs sustained their contention on this point even in their printed brief and memorandum filed in this appeal.

During the trial, both parties presented voluminous evidence from which the trial court arrived at the following conclusions:

> In constructing their machine the plaintiffs did nothing but improve, to a certain degree, those that were already in vogue and in actual us in hemp producing provinces. It cannot be said that they have invented the "spindle" inasmuch as this was already known since the year 1909 or 1910. Neither it can be said that they have invented the stripping knife

> and the contrivance which controls the movement and pressure thereof on the ground that stripping knives together with their control sets were already in actual use in the different stripping machines long before their machine appeared. Neither can it be said that they invented the fly wheel because that part or piece thereof, so essential in every machine from time immemorial, was already known and actually employed in hemp stripping machines such as those of Riesgo (Exhibit 4-A), Crumb (Exhibit 1-A), Icsiar (Exhibit A-Suzara), Browne (Exhibit 28-A), McFie, etc., all of which were in use for the benefit of hemp long before the appearance of the plaintiffs' machines in the market. Much less can it be said that they invented the pedal to raise the knife in order to allow the hemp to be stripped to pass under it, on the ground that the use of such contrivance has, likewise, been known since the invention of the most primitive of hemp stripping machines.
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> On the other hand, although the plaintiffs alleged in their original complaint that "the principal and important feature of said machine is a spindle upon which the hemp to be stripped is wound in the process of stripping," nevertheless, in their amended complaint of March 3, 1928, which was filed after a portion of the evidence therein had already been submitted and it was known that the use of the spindle was nothing new, they still made the allegations appearing in paragraph 3 of their said amended complaint and reproduced on pages 2,3,4 and 5 hereof, copying the same from the application which they filed with the United States Patent Office, under which they obtained their patent in question. The aforesaid application clearly shows that what they applied for was not a patent for a "pioneer or primary invention" but only for some "new and useful improvement in hemp stripping machines."

We have carefully reviewed the evidence presented and have had the opportunity of ascertaining the truth of the conclusions above stated. We agree with the trial court that, strictly speaking, the hemp stripping machine of the plaintiffs does not constitute an invention on the ground that it lacks the elements of novelty, originality and precedence (48 C.J., sec. 101, p. 97, and 102, p. 98). In fact, before the plaintiffs herein obtained their patent, they themselves had already publicly used the same kind of machine for some months, at least, and, various other machines, having in general, the same characteristics and important parts as that of the said plaintiffs, were known in the Province of Davao. Machines known as Molo, Riesgo, Crumb, Icsiar, Browne and McFie were already known in that locality and used by the owners of hemp plantations before the machine of the plaintiffs came into existence. It may also be noted that Adrian de Icsiar applied for a patent on an invention which resulted in the rejection by the United States Patent Office of the plaintiffs' original application for a patent on the so called "spindle" or conical drum which was then in actual use in the Dringman and Icsiar hemp stripping machines.

Notwithstanding the foregoing facts, the trial court did not decree the annulment of the plaintiffs' patent and the herein defendant-appellee insists that the patent in question should be declared null and void. We are of the opinion that it would be improper and untimely to render a similar judgment, in view of the nature of the action brought by the plaintiffs and in the absence of a cross-complaint to that effect. For the purposes of this appeal, suffice it to hold that the defendant is not civilly liable for alleged infringement of the patent in question.

In the light of sound logic, the plaintiffs cannot insist that the "spindle" was a patented invention on the ground that said part of the machine was voluntarily omitted by them from their application, as evidenced by the photographic copy thereof (Exhibit 41) wherein it likewise appears that the patent on Improved Hemp Stripping Machines was issued minus the "spindle" in question. Were we to stress to this part of the machine, we would be giving the patent obtained by the plaintiffs a wider range than it actually has, which is contrary to the principles of interpretation in matters relating to patents.

In support of their claim the plaintiffs invoke the doctrine laid down by this court in the case of Frank and Gohn *vs.* Benito (51 Phil., 712), wherein it was held that the therein defendant really infringed upon the patent of the therein plaintiffs. It may be noted that the plaintiffs in the former

and those of the latter case are the same and that the patent then involved is the very same one upon which the present action of the plaintiffs is based. The above-cited case, however, cannot be invoked as a precedent to justify a judgment in favor of the plaintiffs-appellants on the ground that the facts in one case entirely different from those in the other. In the former case the defendant did not set up the same special defenses as those alleged by the herein defendant in his answer and the plaintiffs therein confined themselves to presenting the patent, or rather a copy thereof, wherein the "spindle" was mentioned, and this court took for granted their claim that it was one of the essential characteristics thereof which was imitated or copied by the then defendant. Thus it came to pass that the "spindle" in question was insistently mentioned in the decision rendered on appeal as the essential part of the plaintiffs' machine allegedly imitated by the then defendant. In the case under consideration, it is obvious that the "spindle" is not an integral part of the machine patented by the plaintiffs on the ground that it was eliminated from their patent inasmuch as it was expressly excluded in their application, as evidenced by the aforesaid Exhibit 41.

Wherefore, reiterating that the defendant cannot be held civilly liable for alleged infringement of the patent upon which the present action is based on the ground that there is no essential part of the machine manufactured and sold by him, which was unknown to the public in the Province of Davao at the time the plaintiffs applied for and obtained their patent for improved hemp stripping machines, the judgment appealed from is hereby affirmed, with the costs against the plaintiffs-appellants. So ordered.

*Avanceña, C.J., Malcolm, Villa-Real, and Hull, JJ., concur.*