

JOSE A. GO,  
Junior Party-Applicant,

INTER PARTES CASE NO. 2044

INTERFERENCE BETWEEN:

Application Serial No. D-6098  
Filed : October 23, 1986  
Applicant : Jose A. Go  
For : SHOE SOLE

- versus -

- and -

Application Serial No. D-6084  
Filed : October 1, 1986  
Applicant : Dennis Tan Co  
For : SHOE SOLE

DENNIS TAN CO,  
Senior Party-Applicant.  
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DECISION NO. 89-103 (PAT.)  
December 14, 1989

### DECISION

Captioned case pertains to an interference proceeding declared by this Bureau involving two pending design patent applications for "SHOE SOLE", namely:

- (1) Application Serial No. D-6098 filed on October 23, 1986 by Junior Party-Applicant, Jose A. Go; and
- (2) Application Serial No. D-6084 filed on October 1, 1986 by Senior Party-Applicant, Dennis Tan Co.

Junior Party –Applicant is a Filipino citizen residing at 7483 Bagtikan Street, San Antonio Village, Makati, Metro Manila, while Senior Part-Applicant is likewise a Filipino citizen, with residence at 19 Guerilla Street, Sto. Niño, Marikina, Metro Manila.

The bone of contention in this interference proceeding is the ornamental design for a shoe sole.

In the words of Junior Party-Applicant, the characteristics feature of this design resides "in the formation at the bottom portion thereof a series of parallelly arranged protrusion forming a triangular-shaped like configuration disposed at the portion and heel portion of said shoe sole".

On the other hand, Senior Party –Applicant described this shoe sole as follows:

"The characteristics features of my new design of a shoe sole resides in the provision of marginal grooves forming a horse-shoe configuration on the toe portion and a dipper-like configuration on the heel portion,

The horseshoe configuration encompasses a substantially triangular formation distinctly defined by grooves, said formation having an arcuate side and a diagonally extending side with an extended end, the distal end of which

intersect one end portion of said horseshoe configuration. The triangular formation encompasses a plurality of lugs defined by parallel grooves.

The dipper-like configuration has its one end forming the handle portion which extends parallel to the diagonal side of said triangular formation, the distal end of which connects to one side of said horseshoe configuration; and the other end of which diagonally extends and connects to said handle portion to form the cup-shape portion, which portion encompasses a plurality of lugs defined by parallel grooves.”

Analyzing each claim of the two design applications, with reference to their respective characteristic features and drawings (Figures 1, 2 and 3 for Application Serial No. D-6084, and Figures 1 and 2 for Application Serial No, D-6098), we find that though they differ in phraseology, and in presentation of the drawings, both are claiming the same subject matter hence; interference is proper.

A notice of Declaration of Interference was then sent on January 28, 1987, requiring both parties to submit within fifteen (15) days from receipt thereof their respective Preliminary Statements. Only the Senior Party-Applicant was able to submit a Preliminary Statement.

In his Preliminary Statement, Senior Party-Applicant stated that:

- “1. The first drawing and written description of the design in question was made sometime in 1985;
2. The first prototype of the design in question was made on February 14, 1986;
3. The design was actually reduced to practice, that is, by means of prototype and on an experimental basis on February 14, 1986;
4. The design in question was disclosed to a very limited number of friends and associates on February 14, 1986;
5. Commercial exploitation of the utility model (sic) in question began on April 9, 1986;
6. Senior Party-Applicant has no other pending application more or less related to the design in question.”

On January 28, 1988, noting that the period for the filing of the parties’ preliminary statements had long expired, Senior Party-Applicant moved that the case be set for pre-trial. A Notice of Pre-Trial Conference was then sent on February 3, 1988 informing the parties that a pre-trial conference will be held on February 29, 1988 at 2:30 P.M. On the scheduled pre-trial date, both counsels were present. Nevertheless, the pre-trial was postponed to March 25, 1988 upon motion of the Junior Part-Applicant’s counsel. Several postponements followed.

On the scheduled hearing of July 1, 1988, upon motion of the Senior Party-Applicant, the case was submitted for decision on the basis of the records of the two (2) applications.

To be resolved is the question of who is the first true and actual designer of the subject “SHOE SOLE”

Resolving this question, we advert to Sections 10 and 55 of Republic Act No. 165, as amended by Republic Act No. 637, the pertinent portions of which are quoted hereunder:

“SEC.10. Right to patent. – The right to the patent belongs to the first true and actual inventor, his heirs, legal representatives, or assigns. x x x If two or more persons

have made the invention separately and independently of each other the right to the patent shall belong to the person who is the first to file a application for such invention, unless it is shown that the second to file an application was the original and first inventor.” (Underscorings supplied)

“SEC. 55. Design patents and patents for utility models. –

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Applications for design patents and patents for utility models shall be subject to interference proceedings as authorized in section ten of this Act, as amended by Section one of Republic Act Numbered Six hundred and thirty-seven.

xxx”

Judging from the records of the instant case, Senior Party was the first to file an application for such design for a “SHOE SOLE”, he having filed his application on October 1, 1986, or twenty-two days earlier than October 23, 1986, the date Junior Party filed his application. This earlier filing date was never overcome by the Junior Party who not only failed to file his Preliminary Statement but also failed to appear at several scheduled hearings.

WHEREFORE, Senior Party-Applicant, Dennis Tan Co, is hereby adjudged the first true and actual designer of the subject “SHOE SOLE”.

Let the Application Serial No. D-6084 be given due course, and Application Serial No. D-6098 be REJECTED

SO ORDERED.

IGNACIO S. SAPALO  
Director