

RE: APPEAL TO THE DIRECTOR OF PATENTS
FROM FINAL DECISION OF THE SENIOR
PATENT EXAMINER

EXPARTE CASE NO.211

Application Serial No. 18824
Filed : August 24, 1976
Applicant : Bonifacio Co
For : MANUALLY
CONTROLLED WELDING
APPARATUS FOR FORMING
WIRE SCREEN

BONIFACIO CO,
Respondent-Applicant
x-----x

DECISION NO. 88-57 (PAT.)
July 26, 1988

DECISION

This is an Ex-Parte Appeal from the action of the Senior Patent Examiner finally rejecting Patent Application Serial No. 18824 for the registration of an invention of a "MANUALLY CONTROLLED WELDING APPARATUS FOR FORMING WIRE SCREEN" filed on August 24, 1976 by Bonifacio Co of 54 Talayan Street, Talayan Village, Quezon City, Philippines.

The above-identified application was finally rejected in Paper No. 84-5 on the ground that "the elements of the apparatus as claimed are substantially similar to the elements disclosed in Philippine Patent No. UM-2449 considered in the context of the combination as a whole". For purposes of clarification, the Senior Patent Examiner made a detailed comparison of the elements of the subject apparatus as recited in claim thereof and the corresponding equivalent elements of said Philippine Patent No. UM-2449:

Claim 1 of Patent Application Serial No. 18824:

- (a) Structural supporting frame;
- (b) Multiplicity of adjustable push rod assembly;
- (c) Horizontal shaft having a multiplicity of eccentric cams;
- (d) A Multiplicity of uniformly spaced positive and negative electrode terminals;
- (e) Carriage assembly; and
- (f) Electric power line.

Corresponding equivalent elements in Philippine Patent No. UM-2449:

- (a) Main frame 2 (p.6, line 16);
- (b) Plurality of push rods 5 (P.6, line 10);
- (c) Shaft 31 (Fig. 4), and a plurality of out-of-center discs (p.6, line 11);
- (d) Movable electrode 4 and fixed electrode 4' (p.7, line 13);
- (e) Wire mesh supporting platform 10 (p.6, line 14); and
- (f) Three-phase power line (p.11, line 9).

Applicant admits the similarity of the functions of the aforementioned parts but proceeds to point out that the means or manner of carrying out these functions are entirely different as may be seen in the welding electrode terminals and movable rods (Fig. 5). The Senior Patent Examiner contends, however, that when compared to the push rods of the reference (Phil. Patent No. UM-2449) as illustrated in Figure 8, 14, and 15, they are obviously similar except for subordinate differences, and as the two machines are alike in their functions, combinations and

elements, it is unnecessary to go further and inquire whether they are "alike or unlike" in their details, and cited a similar case on the matter, thus:

"Mere structural changes, which involves nothing more than exercise of the skill of the art do not rise to the dignity of invention." (Thompson vs. American Tobacco Co., 81 USPQ 323; 326-327)

The Respondent Patent Examiner argued further that even "granting that the carriage assembly (Item if Claim I) is indeed an improvement of the wire mesh platform 10 of the reference, it gives no right to claim the old combination with such new element" as decided:

"The improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination." (Lincoln Engineering Co. vs. Stewart Warner Corp., 37 USPQ 1; 3)

In his Appeal Brief, Applicant-Appellant raised the following grounds/issues:

1. Patent Office Paper No. 84-5, released by registered mail on March 5, 1985, which enters a final rejection, is signed by a Senior Patent Examiner who does not appear to be the appropriate responsible officer for the particular Patent Examining Division.

2. The Senior Patent Examiner erred in entering a finding of lack invention and this finding is made final for purposes of appeal.

3. The Senior Patent Examiner erred in citing as reference Utility Model Patent No. UM-2449 issued on March 25, 1977; the disclosure of which came of public knowledge only after the filing date of the present application, August 24, 1976."

In ground No. 1, Applicant-Appellant is contesting the authority of Rogelio R. Pulido, a Senior Patent Examiner, who entered the final rejection of the herein application by reason of lack of inventiveness for purposes of appeal under Rule 256-258 of the Rules of Practice in Patent Cases.

Applicant-Appellant is of the mistaken impression that the rank of a Senior Patent Examiner is disqualified by the rules from acting on a final rejection of patent applications because the rules provide that the action should be done by a Principal Patent Examiner which, according to him (Applicant), is a ranking or a supervisory patent officer. The truth of the matter is that the Senior Patent Examiner (Patent Examiner II) is holding a supervisory position over Patent Examiners I. Senior Patent Examiner Rogelio R. Pulido is, therefore, qualified to decide on the final rejection for registration of the subject patent application.

In ground No. 2, Applicant-Appellant admits that the functions, combinations and elements of the machine intended to perform similar or identical functions are alike, but contends that the specific manner of carrying out the intended function frequently vary; that the structural differences as between the present invention and the cited prior art are obviously numerous from a mere cursory inspection of the drawings and specifications: and that the differences relate to the manner of operating the machine, the adjustment of the machine from time to time, the manner of actuating the various parts of the machine and the relative motion of the moving parts.

In ground No. 3, Applicant-Appellant questioned the Senior Patent Examiner's action in rejecting herein patent application by citing a reference which is not yet legally known as August 24, 1976 (filing date of Appellant's application), the fact being Patent No. UM-2449 became known only on March 25, 1977 and, therefore, such a final rejection was not based on any ground set forth under Section 9 of Republic Act No. 165, as amended.

With reference to the third argument of Appellant, the records of the case bears out the fact that in identifying the reference, the filing date thereof has been declared, which is March 16, 1976.

Section 9 states in part that an invention shall not be considered new and capable of being patented if "it is the subject matter of a validly issued patent in the Philippines granted on an application filed before the filing of the application for patent therefore".

Since the filing date of the reference antedates the filing date of the subject invention application, the reference is therefore valid and binding.

After a review of the records of the case, this Bureau agrees with the action of the Senior Patent Examiner when he finally rejected subject Patent Application No. 18824 based on the finding that "the elements of the apparatus as claimed are substantially similar to the elements disclosed in Philippine Patent No. UM-2449 considered in the context of the combination as a whole" and is, therefore, not registrable for lack of inventiveness pursuant to Section 9, Republic Act No. 165 and Rules 33 and 34 of the Rules of Practice in Patent Cases.

WEHEREFORE, in view of all the foregoing premises, the final rejection for registration of subject patent application made by the Senior Patent Examiner Rogelio R. Pulido is hereby AFFIRMED.

Let the records of this patent application be remanded to the Mechanical and Electrical Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director