

RE: APPEAL FROM FINAL  
REJECTION OF APPLICATION  
BY PATENT EXAMINER

EX-PARTE CASE NO. 215

Serial No. UM-6776  
Filed : October 30, 1980  
Applicant : Benito C. Lao  
For : PUNCHED GRIP-HOLE  
PLASTIC BAG, etc.

BENITO C. LAO,  
Applicant-Appellant.  
x-----x

DECISION NO. 88-2 (PAT.)

January 20, 1988

### DECISION

This is an ex-parte appeal from the final rejection of the Patent Examiner of Application Serial. No. UM-6776 filed on October 30, 1980 by herein Appellant-Applicant, Benito Lao, of 485 Lavezares Street, Manila.

The appeal pertains to an application for a utility model, entitled "Punched Grip-Hole Plastic Bag, etc." its main feature as embodied in the specification is the thicker upper portion of the bag, which part was made stronger without the need for any add-on reinforcement or patches around the grip.

For lack of novelty, the said application was rejected. The Examiner, in his final action of rejection, stated thus:

"According to the third paragraph of Sec. 55 of R.A. 165, a utility model shall not be considered 'new' if x x x it is substantially similar to any other utility model so known, used or described within the country x x x." (Underscoring supplied)

The sole reference cited and relied upon by the Examiner in rejecting the application is Letters Patent No. D-22591, a design patent granted on March 23, 1983 in favor of Benito Lao, the herein Appellant Applicant. Said patent discloses a plastic bag with a heart-shaped punched grip hole disposed at the upper portion of the bag. Being a design patent, the specification did not mention the purpose of the hole but it can be inferred that the said heart-shaped hole is for the fingers of the hand to pass through when one grips the bag.

Appellant-Applicant's arguments boil down to the resolution of two major issues, to wit:

- (1) Whether or not a design patent can be validly used as a prior art reference against a utility model application; and
- (2) Whether or not varying the thickness of the plastic bag, i.e., making the upper portion thicker than the other part of the bag is patentable.

Tackling the first issue, Appellant-Applicant, citing Rule 134 of the Revised Rules of Practice in Patent Cases (Sec. 155, Republic Act 165), argues that a design patent cannot be cited as a prior art reference for utility model application. Appellant-Applicant construed the term utility model as equivalent to the term utility model patent. This Office begs to disagree. The law uses the term utility model, not utility model patent. The two terms are different from each other. The former is generic while the latter is a specific term. Being generic, the term utility model when used in relation to the field of prior art searching is deemed to include not only utility model patent but also invention and design patents. Also, the term utility model as used in the law

means any device or article. This is the gist of the decision in *Electro Mfg. Co. V. Yellin*, 56 USFQ 290, 292 where it was held that a design patent may anticipate a mechanical patent, and a design patent issued before a mechanical patent, or a mechanical patent issued before a design patent, is a part of prior art and a valid anticipation (*Lein v. Myers*, 105 F 962, C.C.A. 2). If a design patent cannot be used as a prior art reference against a utility model application as alleged by Appellant-Applicant then, conversely, it follows that a utility model patent cannot also be used as a valid prior art reference against a design patent. This should not be the case. Thus, the Director of Patents in the case of *Co Su Lin v. Nicholas Tiu* (Decision No. 84-39, March 30, 1984) cancelled Patent No. D-1646 on the basis of Patent No. UM-2328.

In this case, the cited design patent as a prior art reference discloses the main feature that Appellant-Applicant is claiming in his utility model application. Therefore, the utility model sought to be patented by Appellant-Applicant is unpatentable pursuant to Section 55 of Republic Act 165, as amended.

With respect to the second issue, Rule 134 of the Rules of Practice in Patent Cases provides that "a utility model shall not be considered new and patentable for that reason x x x if it is substantially similar to any other utility model so known, used and described within the Philippines". (Underscoring supplied)

The phrase "substantially similar" as defined in relation to the "doctrine equivalents" in the case of *Pessumal Tolaram v. Chi Chuan Ko* (Decision No. 262, June 7, 1963) means that "in order that one device may be considered equivalent of another, it must perform the same function in substantially the same way to obtain same result (*Westro Inc. v. Illinois Watch Care Co.*, 98 USPG 354), and "if two devices do the same work in substantially the same result, they are the same even though they differ in name, form or shape (*Machine Co. v. Murphy*, 97 U.S. 12U, 24 L Ed. 935).

The variation of thickness claimed by Appellant-Applicant in his application is not apparent and cannot be appreciated using the naked eye alone. Neither such thickness be appreciated by trying to feel it between the finger. In effect, the variation of thickness has very little or no impact in the form or shape of the plastic bag. Taken in the light of the meaning of the phrase "substantially similar", as enunciated in the aforecited doctrine, this Office believes and is so convinced that the subject plastic bag is deemed substantially similar with the cited reference; hence, unpatentable.

The claim that material savings can be derived by making the upper portion of the bag thicker is likewise unmeritorious. The material saving is significant only in theory but not in actual commercial practice. The proof submitted by Appellant-Applicant was based only on theoretical mathematical computation without regard to other factors involved in actual production.

To allow the subject application which is substantially similar to Appellant-Applicant's patented design (D-225, the reference) is a commercial strategy that confers no benefit to the public other than an opportunity for Appellant-Applicant to prolong his monopoly to make, use and sell his design patent beyond the period prescribed by law.

WHEREFORE, premises considered, this ex-parte appeal is, as it is hereby, DISMISSED. Accordingly, Appellant-Applicant's Serial No. UM-6776 filed on October 30, 1980 is, as it is hereby, ordered REJECTED.

Let the records of this case be remanded to the Mechanical, Electrical Division for appropriate action in accordance with, this Decision.

SO ORDERED.

IGNACIO S. SAPALO  
Director