

MARY LOU L. WONG
Petitioner

IPC No. 12-2005-00045

-versus-

Petition for Cancellation:
I.D. Reg. No. 3-2002-000186
Date issued: April 20, 2004
TITLE: BIHON NOODLES

CARLOS NGOSIOK
Respondent

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DECISION

This is a petition to cancel Industrial Design Registration No. 3-2002-000186 titled "BIHON NOODLES" issued on April 20, 2004 in the name of Carlos Ngosiok as designer.

Petitioner, Mary Lou L. Wong, is a businesswoman presently engaged in the business of buying and selling various noodle products. She buys her noodles from several producers and sells these to her outlets located in various commercial centers in Cagayan, Isabela, Quirino and Nueva Vizcaya. In order to lower the cost of production, it came to her mind the idea of producing noodle products in Isabela. In the course of her study of the said project, she came to know that most of the machines that she will use are covered by patents issued in the name of Respondent, Carlos Ngosiok. She then consulted her lawyer about these patents and after research, she was told that the patents are void.(Exhibit "A" of Petitioner)

Respondent, Carlos Ngosiok, is the designer of the disputed Industrial Design Registration. Respondent filed the application on May 25, 2002, leading to the issuance of the Industrial Design Registration No. 3-2002-000186 titled BIHON NOODLES claiming the ornamental designs of bihon shown in Figures 1 to 9 of the Specification and the in the drawings submitted.

On March 9, 2005, Petitioner, through her lawyer, filed a petition for cancellation of the above identified Industrial Design Registration.

The grounds for Cancellation are as follows:

- (a) The subject matter of the industrial design is not new.
- (b) The said design is not registrable within the terms of Section 12 to 113.

Petitioner relied upon the following facts to support her petition:

- (a) The design registered is very much similar if not identical to the exiting design of noodle products in the market and/or in public use at the time the application therefore was filed.
- (b) If ever there are variations between the prior art and the subject design, said variations do not involve a protected design.
- (c) The curling of noodles exists as a common phenomenon in its preparation.
- (d) The description is vague as to the "invention" defined and covered by the registration.
- (e) The registrant is not the designer of the alleged "invention" covered by the registration.

On May 26, 2005, Respondent, through counsel, filed a motion for a bill of particulars alleging that the Petition for Cancellation are not averred with sufficient definiteness or particularity to enable the registrant to intelligently prepare his responsive pleading.

On June 7, 2005, Petitioner, through Counsel, answered the bill of particulars by way of a Manifestation to the effect that one of the design of noodle products existing in the market and in public use. earlier than the year 2002 and identical to the design of noodles covered by the present industrial design registration is the product described in the brochure of Mifentiao Shengchan Jishu dated 1999, attaching a copy thereof. Thereafter, Respondent filed its answer on June 27, 2005 denying all the allegations of Petitioner.

On September 1, 2005, Office Order No. 79, series of 2005 or the Amendments to the Regulations on Inter Partes Proceedings prescribing summary rules took effect which mandatorily covers the instant petition. Hence, parties were ordered to submit all its evidence duly marked in compliance with the new rules.

After submission of all the parties evidence, the case was set for preliminary conference on December 12, 2005 to compare documents and clarify certain issues. The conference was terminated on January 20, 2006 after the parties withdraw their request for ocular inspection. Consequently, the parties were ordered to submit their respective position paper and the case is now submitted for decision.

Petitioner's Position

Petitioner in its position paper alleged that Industrial Design Registration No. 3-2002-000186 lacks novelty on three grounds:

- a) There exists a Chinese publication in 1999 showing the said design. It is interesting to note that the Respondent even presented the author of this book as their witness.
- b) There exists since 1989 a machine that is being operated by Komeya Food Corporation the product of which result to the said design. This matter is also admitted by the Respondents in their position paper.
- c) The machinery owned by Mr. Ngo Siok bought in 1989 produces the design covered by his patent. Thus, clearly, he registered a design manufactured by a machine he bought in 1989.

According to Section 120 of the Intellectual Property Code, a design registration shall be cancelled on the ground that the subject matter is not new. On the other hand, the said design is considered not new if it belongs to the prior art according to Section 23 and 24 of the same Code. On the other hand, it was defined that prior art includes all that has been made available anywhere in the world before the filing dated of the application therefore.

Consequently, it will be shown hereunder that the above mentioned design of noodles is in public use prior to 25 March 2002 (the date of filing of the application for the eventually matured into the questioned design registration).

The Prior Art
Mifentiao Shengchan Jishu
Book of 1999

Petitioner submitted in evidence a book entitled Mifentiao Shengchan Jishu and marked as Exhibit C (E), a copy of the pertinent pages thereof are hereto attached as Annex "A" for reference. The said book was done in 1999 and 2000 as shown on the copyright page of the said book, as highlighted on Annex "A" and marked as Annex "A-1". Consequently, this book existed

years prior to the date of filing of the application of the Ngo Siok Registration which is 25 March 2002.

Emphasis should also given that the Respondent presented in evidence a certification coming from a certain witness (whose name is written in Chinese) that in fact the said book exists and that said witness is actually one of the authors thereof. For easy reference, the said certification marked by the Respondent as Exhibit "5-C" is attached as Annex "B" of Petitioner's Position Paper.

In the said certification, the Respondent practically admitted that the design covered in the Ngo Siok Registration is the same as the Mifentiao product when in pars. 3 and 4(d) of the said certification, the said witness said:

"The finished product of the instant rice vermicelli as mentioned in Chapter 6 of our book is very similar to that of instant noodles although the color is dirty white in contrast to the yellowish color of the instant noodle that is made of wheat flour.

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Design – the wave of our product moves up and down and can be seen from the side. The waves of Super Q golden bihon can be seen from the top as the movement of the waves is from side to side."

Thus, in par. 3 of the said certification, the products of the witness as shown in his book published in 1999/2000 is the same as product of Mr. Ngo Siok and covered by his registration.

On the other hand, in par. 4 of said certification, it is very clear that the said wave design is the same although the difference is not that apparent as the:

- a) said design can be seen from a side view in the products of the witness; while
- b) said design can be seen from a top view in the products of Ngo Siok.

Thus, as pointed out by no less than the expert witness of the Respondent, the said wave designs are the same.

Furthermore, as shown in the said book and as glaringly pointed out by Mr. Joven Gertes, the expert witness for the petitioner, the design of the noodles covered by the Ngo Siok Registration is the same as the design of the noodles shown in the said book.

Consequently, in as much as the patent examiners are considered the experts in the field of patent examination whose conclusions should be given respect, it is submitted that said conclusion should be highly considered. Emphasis should be given to the fact that witness, Joven Gertes, was patent examiner for almost forty years whose expert testimony should be respected.

The Prior Art
The Komeya Machine

Another ground for cancellation of this registration is the existence of the production line operated by Komeya Food Corporation. As can be seen from the affidavit of Ms. Carolina Medina, the machine showing the production of its bihon products particularly the cutting assembly was presented as Exhibit C(D), a copy of which is hereto attached as Annex "C". In the said pictures, the resulting bihon noodles produced by the said machine produced a certain design identical to the design covered by the design registration of Ngo Siok. Furthermore, Mr. Gertes mentioned in his affidavit that products by Komeya Food is the same as that of the Ngo Siok registration with respect to the wave design.

Moreover, the author of Mifentiao in par. 4 (d) of his Certification mentioned that:

Process of forming – we use a sloping horizontal forming device plate while Super Q Golden Bihon is the result of the free fall from the extruder to the conveyor screen.

By this statement, attention of this Honorable Court is invited to Exhibit C (D) of IPC No. 12-2005-00042 involving as assembly for automatic forming and cooking of bihon whose output are bihon noodles transferred to a screen conveyor. In this picture (Annex “D” hereof), it is very clear that the said “wave” design was created through the free fall of the said noodles as part of the operation of the said machine.

It should be noted that this particular machine was bought from Fan Seng in the year 2001 based on the brochures of Fan Seng. Said brochure was even presented by the Respondent as their own evidence. It is interesting to note that no less than the Respondent admitted the existence of the said brochure which they marked as Exhibit “8”.

As evidence of purchase by Komeya Food Product of the said machinery, several shipping documents were presented as follows:

- a) Invoice No. 1455 of Fan Seng Engineering Works (Exhibit (B)(4.0)
- b) Packing List of Fan Seng (Exhibit B(4.1)
- c) Bill of Lading (Exhibit B(4.2)
- d) Entry and Internal Revenue Declaration (Exhibit B (4.3)

Said documents clearly prove that Komeya Food Corporation imported its machinery from Fan Seng in 2001 based on a brochure distributed by Fan Seng since 1989.

The Prior Art
The Ngo Siok Machine

Exhibit “9” referring to the Affidavit of Teo Kim Seng, proprietor of Fan Seng Engineering Works, the source of the said brochure mentioned in par. C of his Affidavit, recited the following fact:

Mr. Ngosiok ordered his first machine in 1989 based on my catalogue with the heading “instant rice vermicelli (beehoon) Main Equipment,” a copy of which is attached herewith and made an integral part hereof as Annex “A”. He ordered a complete set of machinery as described in my quotation for Vermicelli Making Machinery dated September 26, 1989. A copy of said quotation is herein attached as Annex “B”. The whole set of machinery includes rice grinder, stainless steel wetrile flour pump, conveyor mixer, upper and lower mixture compressor set, movable heating cabinet, conveyor unit, main manufacturing plant, auto control cutter and support unit, and heating cabinet. The automatic dryer as shown in the catalogue was subsequently ordered.

It is very clear that since 1989, Fan Seng has been distributing said brochure as declared by no less than Respondent’s own witness-the proprietor and publisher of the said Fan Seng brochure, Teo Kim Seng.

It is also very clear that Respondent Ngo Siok bought the said machines to manufacture bihon. In particular, Mr. Teo mentioned the purchase in 1989 of a main manufacturing plant and a heating cabinet. For all intents and purposes, main manufacturing plant is simply as extruder while a heating cabinet is the heater conveyor, as shown by Annexes “E” and “E-1” which are part of Exhibit 4.7.

On the other hand, the author of Mifentiao in par. 4 (d) of his certification mentioned that:

Process of forming – we use a sloping horizontal forming device plate while Super Q Golden is the result of the free fall from the extruder to the conveyor screen.

Thus, there is no doubt that the machines bought by Ngo Siok in 1989 which are the same machine operated by Komeya since 2000, particularly an extruder and a conveyor, will produce a particular design of noodles as a result of a free fall. (please see pictures Annex “D”). Annex “D” hereof, taken from the machine of Komeya clearly shows a resulting noodles having the wave design freely falling from an extruder into a screen conveyor.

Said design of noodles as mentioned by the author of Mifentiao in his certification has the same wave design similar to the Mifentiao wave design and consequently, the said wave design registered by Mr. Ngo Siok.

Respondent's Position

Respondent alleges that Engr. Ngosiok does not claim design patent rights over bihon per se or all kinds of bihon products. He allegedly invented one kind of bihon design that is novel, unique and even revolutionary. Thus, it deserves patent protection.

That what Engr. Ngosiok invented is a particular kind of bihon product design that is novel and unique which he was able to create by modifying the process and machines used in the process. This is a new process, a new set of machines for bihon and a new product of bihon.

Prior to Engr. Ngosiok's invention, bihon was not strictly uniform in size and cut angularly (it was loosed and flexible) because it was manually formed. It was not compact and flattened (or “planstado”) to the point that the bihon strands were sticking to each other. Engr. Ngosiok revolutionized the bihon design to a uniformly-sized, rectangular biscuit-like bihon product that is angularly cut up to four sides, highly highly flattened (“plantsado”) from top to bottom, with visible curly or wavy-strand bihon sticking to each other. Now, this kind of bihon design is certainly not centuries-old and the machines making them are, of course, newly innovated. In fact, the product is uniquely found only in the equipment is not sold to manufacturers in other countries. It is only sold to Philippine bihon manufacturers.

Engr. Carlos Ngosiok (Engr. Ngosiok), who is a mechanical engineer by profession and a third generation manufacturer of bihon, introduced innovations in the bihon product sometime in 2001, with experimentations starting a few years back. He specifically improved the manufacturing process of bihon and introduced technical modifications in the manufacturing equipment to arrive at a distinctly new bihon product with a totally different appearance from the existing bihon products. Engr. Ngosiok's novel bihon product design may be described as follows: a uniformly-sized golden or yellowish rectangular biscuit-like bihon product that is angularly cut up to four sides, highly compacted and flattened (or “plantsado”) from top to bottom, with visible curly and wavy-strand bihon sticking to each other as clearly shown in the illustrations found in the registrant's Industrial Design Registration No. 3-2002-000286.

Engr. Ngosiok's bihon is pleasing to the eye and looks like a big yellow biscuit that is inviting and mouthwatering. This is in contrast to the traditional and other bihon products, which generally comprise of loosely bound strands of straight or curly bihon formed fluffy or bouncy “pillow-like” products. He was able to create such a unique design for bihon because of the innovations made in the manufacturing process.

There are at least twelve (12) other bihon products existing in the market at the time Engr. Ngosiok filed his industrial design application. Each product is substantially different in look from the unique “golden biscuit-like” bihon product of Engr. Ngosiok, which is covered by Industrial Design Registration No. 3-2002-000186. This fact is readily apparent a simple visual comparison of the Honorable Office to ascertain the differences of the designs, actual samples of the said twelve (12) bihon products (save for one), were submitted as Exhibit “4” to “4-J”. (To further demonstrate the differences between these bihon designs, photographs of the same

bihon designs, marked also Exhibit “4” to “4-J”) Also submitted as Exhibit “4-K” is an actual sample of Engr. Ngosiok’s bihon. (Also submitted is a photograph of Engr. Ngosiok’s bihon also marked as Exhibit “4-K”).

Notably, all of the above-mentioned varieties of bihon product are manually formed except for the straight sticks (Exhibits 4-D), which are automatically formed as a mere natural consequence of and by reason of its simple straight shape. It is only Engr. Ngosiok’s bihon product that is machine formed to the desired shape (and is not “straight sticks”). This will partly explain why the other bihon products are different from those of Engr. Ngosiok’s, which has the noodle strands sticking to each other, in a rectangular and angularly-cut flattened compact (“plantsado”) biscuit-like appearance.

It should also noted that throughout the noodle and vermicelli-eating population of Asia, the looks and appearance of the Bihon and noodle products are likewise different from those of Engr. Ngosiok’s “golden biscuit-like” product. Please refer to as the registrant’s Exhibits “2” to “2-EE” for the pictures of various bihon and noodle (including other kinds of vermicelli) products in Asia as taken from the Internet. Further, original copies of the certifications from foreign industry associations and entities were submitted as Exhibit “5” to “5-B” attesting to the fact that Engr. Ngosiok’s “golden biscuit-like” product is not found in their respective countries. Further, a bihon expert from China who co-authored the Chinese book “Mifentiao Shengchan Jishu” on bihon history and development with ISBN 7-5982-0921-4 certified that Engr. Ngosiok’s bihon design is not like the bihon product developed in China. Said certification dated November 2, 2005 mentions the stark differences between the instant rice vermicelli as described in the said book and the Super Q Golden Bihon of Engr. Ngosiok. The pertinent portion of the said certification (Exhibit “5-C”) is hereby quoted below.

CERTIFICATION

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4. Upon comparison of the rice vermicelli that is produced by the process and machinery as mentioned in our book and that of Ngosiok Marketing with the Super Q Brand, the following differences are very apparent:

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d. Design – the wave of our product moves up and down and can be seen from the side. The waves of Super Q golden Bihon can be seen from top as the movement of the waves is from side to side;

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That Engr. Ngosiok’s “yellow biscuit” bihon is an original pinoy product – distinguished and proudly Filipino innovation to the centuries – old traditional bihon product. Notably, there are no “X” documents cited in the registrability report issued by the Intellectual Property Office on Engr. Ngosiok’s Industrial Design No. 3-2002-0086, and the “A” document cited therein obviously has a substantially distinct over-all shape and ornamental appearance. This only confirms the novelty of the industrial design of the “yellow biscuit” bihon product of Engr. Ngosiok.

That Komeya seeks to prove that the registrations of the respondent are invalid for lack of novelty. As proof of its alleged prior use, Komeya presents the following evidence:

- Its Bureau of Food and Drugs (“BFAD”) License to Operate dated October 23,2001
- Sales Invoices of bihon product sold issued in 2001
- Purchase documents of equipment issued in 2001

- Brochure (from Fan Seng Engineering Works) of the equipment it purchased in 2001

However, the foregoing documentary evidence do not show that the product and equipment referred or mentioned in the documents are the same product and equipment covered by the respondent's registrations.

The BFAD License to Operate does not refer to any particular noodle product. Neither does the BFAD require that the said license be applied for and granted on the basis of a particular kind of product design. Thus, no product design is specified in the application and in the license itself. Clearly, the BFAD license proves nothing. The unsubstantiated statement of the petitioner's witness, Ms. Medina, is obviously self serving. It is rather convenient for Ms. Medina to claim that Komeya's product is the one "involved in said registration when there is no proof whatsoever of this effect.

Similarly, the sales invoices and delivery receipts presented by the petitioner (Exhibits "B(3.3)" to "B(3.7)" are devoid of any probative value because they do not show the product design of the items sold under these sales invoices and delivery receipts. These could not demonstrate if the product sold is indeed identical or similar to the design of the respondent. In fact, the sales invoices mention another types of bihon, the "Taiwan bihon", which is an entirely different product from that of the respondent.

Notwithstanding the expertise in patents and experience of the petitioner's expert witness, he is not an expert in the noodle industry and he is not an expert in the sub-industry of bihon-making. As stated at the start of this position paper, there are many kinds of noodles and several types of bihon. There are also numerous types of bihon mixer, pelletizer, automatic cooker, extruder and cutter. The petitioner's expert witness is not an expert on noodles, bihon and bihon-making equipment.

The photographs (presented by the petitioner as Exhibit "C(D)" of equipment allegedly similar to the registrant's were taken only recently – not in 2001. Therefore, it proves nothing more that the fact that Komeya is infringing upon the intellectual property rights of the respondent. The key consideration in the issue of anticipation is time. It should be proven that a particular utility model is made public prior to the date of application. In here, the photographs were taken on November 26, 2005, which is more than three years after the date of application of the respondent. How can the present photographs be used as evidence to show the existence of prior art five years ago?

To reiterate, the Fan Seng brochure shows photographs of a different equipment altogether. This again proves that in 2001, Komeya was not using the equipment represented in the recently taken photographs. It purchased a different equipment then and was using the traditional manufacturing process.

The dates of alleged prior art should be established. Mere photographs are inadequate to the detailed construction of the prior art machines for comparison with the elements of the registrant's utility model.

RULING

Design patents are issued pursuant to Sections 112 and 113 of R.A. 8293, the law applicable in this case, which provide in relevant part that:

"Sec. 112. Definition of industrial Design. - An industrial design is any composition of lines or colors or any three-dimensional form, whether or not associated with lines or colors; Provided, That such composition or form gives a special appearance to and can serve as pattern for an industrial product or handicraft.(Sec. 55, R.A. No. 165a)

Sec. 113. Substantive Conditions for Protection, - 113.1. Only industrial designs that are new or original shall benefit from protection under this Act.

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For the standard of novelty and prior art required for design patents, Sec. 119 of R.A. 8293 provides:

“Section 119. Applications of other sections and chapters – 119.1. The following provisions relating to patents shall apply mutatis to an industrial design registration:

Section 23 – Novelty;

Section 24 – Prior art; Provided, that the disclosure is contained in printed documents or in any tangible form;

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Referring to Section 23, of R.A. 8293 it further provides that –

“Section 23. Novelty. – an invention shall not be considered new if it forms part of prior art.

Prior art is defined in Section 24 of R.A. 8293 as:

Section 24. Prior art shall consist of:

24.1 Everything which has been made available to the public anywhere in the world, before the filing date or the priority date of the application claiming the invention; and

24.2 The whole contents of an application for a patent, utility model, or industrial design registration, published in accordance with this Act, filed or effective in the Philippines, with a filing or priority date that is earlier than the filing or priority of the application: Provided, that the application which has validly claimed the filing date of an earlier application under Section 31 of this Act, shall be prior art with effect as of the filing date of such earlier application: Provided further, that the applicant or the inventor identified in both applications are not one and the same.

The element of novelty is an essential requisite of the patentability of a design. If a design has been known or used by others prior to its application by the applicant, an application for a patent therefor should be denied; and if the application has been granted, the court, in a judicial proceeding in which the validity of the patent is drawn in question, will hold it void and ineffective. It has been repeatedly held that a design must possess the essential elements of novelty, originality and precedence, and for the patentee to be entitled to the protection the design must be new to the world. (ANGELITA MANZANO vs. COURT OF APPEALS, G.R. No. 113388. September 5, 1997)

However, once a party has been issued a design patent, the design patent is presumed to be valid and a challenge to the validity of the design patent must be proven by clear and convincing evidence. (VARGAS vs. YAPTICO & CO., GR No. 14101, September 24, 1919)

To invalidate a design patent based upon a prior public use, the Petitioners must establish patent invalidity under the “Ordinary Observer Test” and the “Point of Novelty Test.” These are two distinct tests which must be satisfied in order to find patent invalidity as well as infringement. Thus the fact finder must compare the claim and the prior public use, employing both tests. (BERNHARDT L.L.C. VS. COLLEZIONE EUROPA USA, INC., No. 04-1024, Fed. Cir. Oct. 20, 2004)

Before comparing the parties 'Design, Respondents' design patent claim must be construed and its meaning and scope is determined. As the drawings are substantially "the claims" in a design patent application, all illustrated elements or features can be limiting to the scope of the patent.

Petitioner's Design Patent No. 3-2002-000186 with reference to the drawings reveals that it is an ornamental design for "Bihon Noodles" with the following specification, drawings and claims:

I CLAIM:

The ornamental design for a bihon noodles substantially as show:"

A reading of Petitioner's claims together with the drawings indicate that the novelty of Petitioner's design lies in the particular shape and arrangement of the waves of the bihon strands thus creating a clean and seamless look. This means that the novelty being claimed is its visual appearance as a whole and in particular the visual impression it creates.

Petitioner submitted in evidence a book entitled Mifentiao Shengchan Jishu marked "C"(D) with the pertinent pages marked Annex A of the Petitioner's Position Paper. It appears from the copyright page of the book marked as Annex A-1 that the book is copyrighted in 1999. The existence of said book since 1999 was not denied by the Respondent. In fact, Respondent even presented in evidence a Certification of one of the co-authors of the book marked as Exhibit "5-C" who in fact, enumerated the similarities as well as the alleged differences of the design of their rice vermicelli from the design of the bihon of Carlos Ngosiok subject of the disputed industrial design registration.

Comparing Respondent's design for bihon noodles specifically marked as Exhibit "4-K" to the design of the instant rice vermicelli appearing at the front cover, and that appearing on pages 1 and 2 of the Mifentiao shengchan Jishu book done in 1999 marked Exhibit "C" (D), this Bureau finds that they are very similar, in fact almost identical to the design of the bihon noodles covered by the disputed Industrial Design Registration 3-2002-000186 issued to Carlos Ngosiok filed on March 25, 2002.

The above findings was also made by Respondent's own witness, the co-author of the Mifentiao Shengchan Jishu when he started in his Certification (Exhibit "5-C) that-

"xxx

"3. The finished product of the instant rice vermicelli as mentioned in Chapter 6 of our book is very similar to that of instant noodles although the color is dirty white in contrast to the yellowish color of instant noodle that is made of wheat flour.

xxx"

The "Ordinary Observer Tests" measure the similarity of design through the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed the degree of observation which men of ordinary intelligence give. (*GORHAM CO. vs. WHITE*, 81 U.S. (14 Wall.) 511, 528 (1871). If the two designs are so alike that one may readily be taken as the other by an ordinary observer, the earlier constitutes an anticipation of the later, notwithstanding differences in detail and in non-essential matters. (*SAGANDORTH VS. HUGER* 95 FED. 478)

Moreover, the differences that the same witness of Respondent enumerated in his Certification marked Exhibit "5-C" as to the color. Ingredient, size, that the design moves up and down while the other is from side to side and the number of cuts are different are minor details or slight variances in configuration which is non-essential and therefore, not sufficient to destroy the

substantial identity of the disputed industrial design with respect to the prior arts submitted in evidence by the Petitioner.

In comparing the design, it must be judged from the overall visual appearance of the design, not from emphasis upon or pre-occupation with any of its individual elements. It must be the sameness in appearance, and mere difference in lines in the drawing or sketch, a greater or smaller lines or slight variances in configuration, if insufficient to change the effect in the eye, will not destroy the substantial identity. (*JESSIE G. CHING VS. WILLIAM L. SALINAS JR., IPC DECISION NO.2003-39, DECEMBER 23, 2003*).

Another ground for cancellation of subject industrial design registration is the existence of the machine purchased by Komeya from Fan Seng Engineering Works sometime in June 2001 as evidenced by the shipping documents presented with the Affidavit of Carolyn Medina, General Manager of Komeya Food Product Corporation marked as Exhibit "B"(4.0) to "B"(4.3).

In this regard in par. 4.d) of the Certification of the co-author of Mifentiao Shengchan Jishu presented by Respondent as Exhibit "5-C", one of the differences that he mentioned is-

"Process of forming – We use a sloping horizontal forming device plate while Super Q Golden Bihon is the result of the free fall from the extruder to the conveyor screen."

The machine showing production of bihon products of Komeya particularly the cutting assembly was presented as Exhibit "C" (D) attached in Petitioner's Position Paper as Annex "C". The resulting bihon noodles produced by the said machine is a design identical to the design covered by the industrial design of Ngosiok. This was confirmed by Engr. Joven Gertes, Petitioner's expert witness when he mentioned in his Affidavit marked Exhibit "C" that the products produced by Komeya is the same as that of the Ngosiok registration with respect to the wave design.

The Ngosiok machine as prior art

This Bureau takes notice of the fact that in Exhibit "C"(D) of Inter Partes Case No. 12-2005-00042 the machine which consist of An Assembly for Automatic Forming and Cooking of Bihon, was found by this Bureau to be part of prior art, hence no longer novel. The output of this machine are bihon noodles transferred to a screen conveyor and as shown by Annex D of Petitioner's Position Paper, it is very clear that the "wave" design claimed by Respondent was created through the free fall of the noodles and part of the operation of said machine.

It is likewise noted that the source of the above mentioned machine was Fan Seng Engineering Works of Singapore and that the ,machine was bought by Ngosiok in 1989 based on a catalogue, as testified to by Respondent's own witness, the proprietor and publisher of Fan Seng brochure, Mr. Teo Kim Seng (See Exhibit "9").

Likewise, In paragraph C of his Affidavit marked Exhibit "9", Mr. Teo Kim Seng mentioned that-

"Mr. Ngosiok ordered his first machine in 1989 based on my catalogue with the heading "a copy of which is attached instant rice vermicelli (beehoon) Main Equipment," herewith and made an integral part hereof as Annex "A". He ordered a complete set of machinery as described in my quotation for Vermicelli Making Machinery dated September 26, 1989. A copy of said quotation is herein attached as Annex "B". The whole set of machinery includes rice grinder, Stainless steel wetrice flour pump, conveyer mixer, upper and lower mixture compressor set, movable heating cabinet, conveyer unit, manufacturing plant, auto control cutter and support unit, and heating cabinet. The automatic dryer as shown in the catalogue was subsequently ordered."

This Bureau agrees with the Petitioner's expert witness who is a Registered Mechanical Engineer and whose expertise in the examination of invention, utility model and industrial design cannot be questioned as he has been a Patent Examiner for more than thirty five years in the former Philippine Patent Office changed to Bureau of Patents, Trademark and Technology Transfer, now Intellectual Property Office and who has attended several trainings and seminars in the field of patent examination of invention, utility model and industrial design, when he mentioned that the special appearance as shown in the disputed industrial design registration and the prior arts discussed earlier namely, design of bihon noodles shown in the Mifentiao Shengchan Jishu Book existing since 1999, the machineries shown in the catalogue of Fan Seng Engineering Works since 1989 and the Komeya machine bihon products as a result of using the machinery , i.e., main manufacturing plant (extruder), movable heating cabinet and the auto control electric cutter all bought by Komeya Food Product Corporation from Fan Seng in 2001 , show a bihon product cut to a square or rectangular shape containing plurality of bihon strands where one or two ends thereof are curled which is the same design covered by the disputed industrial design registration.

As indicated by the then Director of Patents in the case of Presto vs. Zembrano, (Decision No. 82-56, August 20, 1982) the following tests in the determination of identity or substantial identity of designs are as follows:

In determining infringement, one does not pick apart the elements of a design patent; the question should be determined by the appearance of the alleged infringing device as a whole as compared with the design as claimed in the patent.

The test of infringement of a design patent is the resultant effect of the whole design on the eye of an untutored purchaser as compared with the effect of the accused device.

The claim in this case covers the design as a whole, and not any part of it, as a part and it is to be tested as a whole as to novelty and infringement.

Considering that the subject industrial design covered by Regn. No. 3-2002-000186 is no longer new as it forms part of prior art, the same should be cancelled in accordance with Sec. 120 of Republic Act 8293 which provides thus-

“Sec. 120. Cancellation of Design Registration –

120.1 – At any time during the term of the industrial design registration, any person upon payment of the required fee, may petition the Director of Legal Affairs to cancel the industrial design on any of the following grounds:

- a) If the subject matter of the industrial design is not registrable within the terms of Section 112 and 113;
- b) If the subject matter is not new; or
- c) If the subject matter of the industrial design extends beyond the content of the application as originally filed.

WHEREFORE, in view of all the forgoing, the Petition for Cancellation filed by Petitioner, Mary Lou Wong, is hereby GRANTED. Consequently, Industrial Design Registration No. 3-2002-000186 titled “BIHON NOODELS” issued on April 20, 2004 in the name of Carlos Ngosiok is, as it is hereby, CANCELLED.

Let the filewrapper of Bihon Noodles subject matter of this case be forwarded to the Bureau of Patents for appropriate action in accordance with this DECISION.

SO ORDERED.

City of Makati, 03 July 2006.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office