ROLANDO G. PEREZ,	}	IPC NO. 12-2007-00309
Petitioner,	}	Petition for Cancellation:
	}	Utility Model (UM) No. 2-2006-000261
-versus-	}	Date Issued: 28 November 2006
	}	Title: "An Improved Fire Truck"
TEOFISTA A. ANOS,	}	
Respondent-Registrant.	}	Decision No. 2008-220

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DECISION

For decision is the Petition for Cancellation of Utility Model Registration No. 2-2006-000261 issued on 28 November 2006, entitled "An Improved Fire Truck" and registered in the name of Teofista A. Anos, a Filipino Citizen with address at #4 Apo Street cor Quezon Avenue, Sta. Mesa Heights, Quezon City, hereinafter referred to as Respondent-registrant, filed by Rolando G. Perez, Filipino citizen, with address at 113 11th Street, near corner 12th Avenue, East Grace Park, Caloocan City, herein after referred to as Petitioner.

Petitioner alleged the following in his petition:

"3. Petitioner is filing this petition pursuant to Section 61 of the IP Code, in relation to the Intellectual Property Office (IPO) IRR on Inter Partes Proceedings (Series of 2005). The provisions on novelty and prior art of the IP Code are likewise relied upon by the petitioner as well as the Implementing Rules and Regulations on Utility Models ("the Rules").

Sec. 23, 24 and 61 of the IP Code provides as follows:

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

Section 24. Prior Art. 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 date that is earlier than the filing date or priority date 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.

Section 612. Cancellation of Patents. Any interested person may, upon payment of the required fee, petition to cancel the patent or any claim thereof, or parts of the claim, on any of the following grounds:

(a) That what is claimed as the invention is not new or patentable;
(b) That the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by any person skilled in the art;
(c) That the patent is contrary to public order or morality;

Where the grounds for cancellation relate to some of the claims or parts f the claim, cancellation may be affected to such extent only.

4. The petition seeks to cancel the respondent's utility model Registration No. 2-2006-000261 for AN IMPROVED FIRE TRUCK which the Bureau of Patents issued to the respondent on 28 November 2006. xxx"

In support of his petition, petitioner submitted the following evidence:

EXHIBIT	DESCRIPTION
"A"	Certificate of Registration No. 2-2006-000261
"B", "C"	Photograph of fire truck (rear mounting structure)
"D", "E", "F"	Photograph of fire truck (water turret)
"G"	Certification of Fernando A. Lu
"H", "I", "J"	Photograph of fire truck (front mounting structure)
"K", "L"	Photograph of fire truck (rear spotlight)
"M"	Certification issued by Alexander Ecker
"N", "O", "P"	Photograph of respondent-registrant's fire truck
"Q"	Affidavit of Rolando G. Perez
"R"	Isuzu Leaflet
"S", "T", "U"	Commercial documents

Respondent-registrant, in his Answer filed on 27 February 2008, alleged the following affirmative defenses:

"2.0 It should be noted that there is a distinction between lack of novelty and lack of inventiveness. Lack of novelty means that all the elements of a claim is found in one specific prior art. On the other hand, inventiveness in essence means that the elements of an invention (utility model) can be found in one or more references but the combination of which is not obvious to a person skilled in the art,

2.1 It should be emphasized that for utility model there is no requirement of lack of inventiveness (lack of inventive step)

2.2 Consequently, the only issue is only lack of novelty.

"3.0 With respect of lack of novelty, it is very clear that the Petitioner did not present any single reference or prior art showing all elements of this utility model."

In support of her Answer, respondent-registrant submitted the following evidence:

EXHIBIT	DESCRIPTION
"1"	Answer

The issue is whether the utility model (UM) registration can be cancelled for lack of novelty.

The UM Registration No. 2-2006-000261 issued in 28 November 2006 entitled "An Improved Fire Truck" with filing date on 26 June 2006 claim the following:

"CLAIMS:

1. The construction on an improved fire truck comprising a vehicle mounted with a fire fighting equipment having a water tank being provided with ports on its side portions being attached with a hose for siphoning and discharging of water, conventional mounting structure provided on the rear portion of said fire fighting equipment wherein firemen could mount, characterized by an additional mounting structure located at the front portion thereof and a water turret located at the upper back portion of said fire fighting equipment for the discharge of high pressure water.

2. The improved fire truck of claim 1, wherein said additional mounting structure on the front portion is being provided with seat portion.

3. The improved fire truck of claim 1, wherein a spotlight is provided on the upper portion of said fire-fighting equipment.

4. The improved fire truck of claim 1, wherein said water tank has a capacity of at least 3,000 gallons."

The law provides that an invention qualifies for registration as a utility model if it is new and is industrially applicable. Clearly, that the invention involves an "inventive step" is not a requisite for registration as a utility model. Thus, we shall explore the issue of whether UM Registration No. 2-2006-000261 is new and does not form part of prior art.

Petitioner examined the wordings of the claims vis-à-vis pictorial representations of fire trucks and concludes that respondent-registrant's utility model is not new because its principal elements are present in other fire trucks and they are the same in all important particulars. As regards to the wording of the claim that it is an "improved fire truck comprises a vehicle mounted with a firefighting equipment having a water tank being provided with ports on its side portions being attached with a hose for siphoning and discharging of water", petitioner surmises that it is a general description of a fire truck without any improvements.

As regards the part of the claim stating "conventional mounting structure provided on the rear portion of said fire fighting equipment wherein firemen could mount, characterized by an additional mounting structure located at the front portion thereof", petitioner alleges that truck designed with an open crew cab as mounting structure on the front and at the back have been available since the 1980's. However, apart from the undated pictures (Exhibits "B" and "C") there is no evidence showing their availability in the 1980's as alleged by the petitioner.

As regards the part of the claim stating "a water turret located at the upper back portion of said fire fighting equipment for the discharge of high pressure water", petitioner offers pictures of fire trucks with water turrets (Exhibits "D", "E", "F").

As regards to the additional mounting structure as stated in claim 2 of the UM petitioner provided evidence consisting of pictures of fire trucks with additional mounting structures (Exhibits "H", "I", "J") and certification issued by Fernando A. Lu to the effect that an importation of a Fire truck 12.20 LE LAM truck was made (Exhibit "G").

As regards to “spotlight” on the structure as claimed in claim 3, petitioner offers pictures of prior art (Exhibits “K”, “L”) with certification issued by Alexander Ecker to the effect of authorizing the tender of 4 units of fire fighting vehicles (Exhibit “M”).

In the case of Manzano v. Court of Appeals (GR113388, 5 September 1997) the Supreme Court held that “the element of novelty is an essential requisite of the patentability of the invention or discovery. If a device or process has been known or used by others prior to its invention or discovery by the applicant, an application for a patent should be denied. It has been repeatedly held that an invention must possess the essential elements of novelty, originality and precedence, and for the patentee to be entitled to protection, the invention must be new to the world.” A utility model invention is considered “not new” if before the application, it has been publicly known or publicly used in this country or has been described in a printed publication or publications circulated within, or if it is substantially similar to any other utility model so known, used or described within the country. Under the present IP Code, an invention is considered new if it is part of prior art. In the abovementioned case, the utility model on an LPG Burner was not anticipated. The various pictorial representations of burners were not identical or substantially identical to the utility model and the brochures which supposedly consisted prior art were undated.

Similarly in the evidence presented, there is no positive evidence to indicate the dates of the pictorial representations of the alleged prior existing similar fire trucks. Further, the certifications issued by various persons alluding to transactions involving prior existing fire trucks does not imply identity or substantial similarity to the respondent’s UM on an improved fire truck.

The technical problem being solved by the utility model is that water pressure coming from the fire hose is too low which hinders water with fire extinguishing chemicals to reach upper portion of house or building. The objective of the utility model is to solve drawbacks and problems in conventional fire fighting.

In the case of Aguas v. de Leon, No. L-32160, January 30, 1982, the Supreme Court noted:

> “It should be noted that the private respondent does not claim to be the discoverer or inventor of the old process of tile-making. He only claims to have introduced an improvement in the process. … The Court of Appeals found that the private respondent has introduced an improvement in the process of tile-making because:
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> > “While it is true that the matter of easement, lip width, depth, protrusions and depressions are known to some sculptors, still, to be able to produce a new and useful wall tile, by using them all together, amounts to an invention.”

Similarity, in the instant case, respondent does not claim that a fire truck with turret, spotlight, front mounting structure is new. What is being claimed is that these features combined in the utility model to solve an existing problem in the art. This Bureau finds that the combination of the features in respondent’s fire truck is new and is an improvement from the old art which renders the invention qualified for registration as a utility model. It is established that an invention being a combination of old elements is not relevant in determining patentability (Mac Corp. v. Williams Patent Crusher Co., 767 F.2d 882, 226 USPQ 515, Fed. Cir. 1985). Virtually all inventions are combinations of old known elements and most inventions employ known principles (Lindeman Maschinenfabrik v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, Fed. Cir. 1984).

More importantly, this Bureau finds that UM Registration No. 2-2006-000261 is novel and not anticipated by prior art. The petitioner was unable to adduce evidence that a single prior art

reference, device or art containing all the elements or features of UM Registration No. 2-2006-000261, failing which the patent remains valid.

Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference (In re Spada, 911 F.2d 705, 15 USPQ 2d 1655, Fed. Cir. 1990), or embodied in a single prior art device or practice (Minnesota Min. & Mfg. Co. v. Johnson Orthopedics, Inc., 976F.2d 1226, 9 USPQ2d 1913, Fed. Cir.1989). Those elements must either be inherent or disclosed expressly and must be arranged as in the claim (Constant v. Micro-Devices, Inc., 848 F2d 1560, 7 USPQ2d 1057, Fed. Cir. 1986).

WHEREFORE, premises considered the instant PETITION FOR CANCELLATION is hereby DENIED. Accordingly, Utility Model UM Registration no. 2-2006-000261 entitled AN IMPROVED FIRE TRUCK granted on 28 November 2006 in the name of Teofista A. Anos, (hereinafter referred to as respondent-registrant) stands and remains valid and existing.

Let a copy of this decision be forwarded to the Bureau of Patents for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, 9 December 2008.

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