PRESCON PHILIPPINES, INC.
Petitioner,

-versus-

Inter Partes Case No. 3727
Petition to Cancel:
Letters Patent No.: UM-7264
Date Issued: August 21, 1991
For: Anchorage Assembly for Tensioning Elements

ISIDRO L. ERA
Respondent-Patentee

Decision No. 2003 – 06

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DECISION

This is a petition to cancel Letters Patent No. UM-7264 entitled "an anchorage assembly for anchoring tensioning elements" issued on August 21, 1991 in favor of Isidro Era ("Respondent").

On December 13, 1991, Prescon Philippines, inc. ("Petitioner"), a corporation organized and existing under Philippine laws, filed its Petition to cancel subject letters patent based on the following grounds:

> "1. The utility model is not new as required under Section 55, RA 165, as amended;
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> 2. The person to whom the patent was issued was not the first original, true and actual inventor, designer or maker of the utility model (RA 165, Sec. 28, as amended by RA 884);
>
> 3. The utility model is being produced, and marketed long before the registration thereof."

In its Answer, Respondent denied the material allegations of the Petition and interposed the following affirmative defenses:

> "1. Petitioner has no cause of action against Respondent-Patentee herein.
>
> "2. Petitioner is not the real-party-in-interest to institute the instant action for cancellation of a patent granted to Respondent since it has no interfering registered patent of its own.
>
> "3. Respondent-patentee, Isidro L. Era is the first true actual maker of the utility model "Anchorage Assembly for Anchoring Tensioning Elements", and for which Letters Patent No. UM-7264 was issued after full compliance with the technical and procedural requirements of Section 55 of RA 165, as amended.
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> "4. Respondent-patentee's "Anchorage Assembly for Anchoring Tensioning Elements", is a new model and product which does not resemble, nor is it substantially similar to any prior or existing utility models. Letters Patent No. 9917 relied upon by the applicant for "Apparatus for Anchoring Wires or Stranded Wires", is an invention patent which is of different technical features and description as that of the respondent-patentee's utility model are of different patent categories, and the application of patentability criteria with respect to the

novelty or newness for both patents are different as mandated by Section 9 and Section 55, respectively, of RA 165, as amended.

"5. The technical manual presented by petitioner has no showing of likelihood to that of the respondent-patentee's utility model and that said manual is of a foreign publication such that pursuant to Section 55 of RA 165, as amended, could not be used as prior art.

"6. Petitioner and several other utilities were among those illegally manufacturing, using, distributing and selling respondent-patentee's products to the damage and prejudice of the latter and the instant petition for cancellation of patent was primarily resolved to by petitioner for the purpose of coercing, harassing, and intimidating respondent-patentee herein to ignore their infringement on respondent-patentee's utility model."

Upon joinder of issues, the case was set for pre-trial, but as the parties failed to arrive at an amicable settlement, the case was set for trial on the merits.

During trial, Petitioner presented the testimony of Reynold Madamba, and offered Exhibits "A" to "D" and their sub-markings that were admitted in evidence under Order No. 92-698 dated October 9, 1992. Petitioner asserts that the utility model of Respondent is not new and novel because it has been publicly known and made available worldwide even before the filing of Respondent's application and that it is similar to another utility model described as "Apparatus for Anchoring Wires or Stranded Wires" covered by Letters Patent No. 9917 issued on June 8, 1976 in favor of Gerald Welbergen and Hans-Rudolf Siegwart.

In his affidavit marked Exh. "A", Reynold Madamba, an engineer and production manager of Petitioner company, declared that Petitioner has manufactured and sold its post tensioning products since 1967 as shown by a newspaper article on the Prescon method of post-tensioning (Exhs. "C" to "C-1"), and that the technology for post-tensioning is an old technology that has been used worldwide since the 1960's and published in manuals disseminated to builders, constructors, engineers and architects such as the VSL manual of multi-strand system (Exhs. "A-1" to "A-8").

The witness also compared the claims in Letters Patent No. UM-7264 (Exh. "B") to the description in the VSL manual (Exhs. "A-1" and "A-8") and found that the elements of the design and configuration as well as the post-tensioning technology of Respondent's utility model are similar to the multi-strand system of VSL, particularly with respect to the cable block holder, external figure and design, anchorage members, conical housing, and plurality of strands. Finally, the same witness evaluated the claims in Letters Patent No. 9917 in the name of Welbergen and Siegwart (Exh. "D") and Respondent's Letters Patent No. UM-7264 (Exh. "B") and concluded that the claims relating to the anchor block design, position of wedges, cable, anchor plate and conical holes of the anchor block are similar to each other.

For his part, Respondent presented his own testimony, and offered Exhibits "1" to "8" and their sub-markings which were admitted the evidence according to Order No. 94-148 dated February 15, 1994. He presented photographs and actual samples of his anchorage assembly model (Exhs. "3" and "6") and the VSL type assembly (Exhs. "5" and "7"), and claimed that his utility model is technically different because "(a" in the VSL multi-strand system, the bearing assembly is casted whereas in the utility model of Respondent, there is no bearing assembly but a conical housing member which is not casted; (b) in the first, the grouting tube is situated outside of the assembly, whereas in the second, it is located inside the assembly; (c) the cable block holder in the first is concave which suits only a specific jack, whereas in second, the cable block holder is flat and suits any kind of jack; (d) the holes in the cable block holder of the first ranges from two (2) to twelve (12) which are not arranged, whereas, whereas in the second, the holes range from (1) to nineteen (19) and arranged in circular position to protect the grouting

inside the tube; and (e) in the first, there is no cone ring while in the second, there is a cone to protect the concrete during the tensioning operation so that it will not crack".

Upon submission by the parties of their memoranda, the case was deemed submitted for decision on the issue of whether Respondent's utility model lacks novelty.

According to Sec. 55 of rep. Act No. 165, the law applicable and in effect at the time the patent for the subject utility model was issued, any new model of implements or tools of any industrial product, or of part of the same, which does not possess the quality of invention, but which is of practical utility by reason of its form, configuration, construction or composition, may be protected by the author thereof by a patent for a utility model, in the same manner and subject to the same provisions and requirements as related to patents for inventions in so far as they are applicable. *[see also Sec. 134 of the Rules of Practice in Patent Cases].*

In order to be entitled to a patent, a utility model must satisfy two requirements: (1) it must be new or novel, which means that the utility model must not form part of prior art; and (2) it must be of practical utility, which means that it serves some purpose or use, or has some industrial application.

As regards the requirement of novelty, Sec. 55 also provides that a utility model shall not be considered "new" if, before the application of the patent, it has been publicly known or publicly used in this country, or has been described in a printed publication or publications circulated within the country, or if it is substantially similar to any other utility model so known, used or described within the country. The novelty of a utility model may therefore be negated by prior art which may take the form of: (a) prior public knowledge or usage in the Philippines; (b) publications that were printed or circulated in the Philippines prior to the filing of the patent application; and (c) substantial similarity to another utility model that is earlier known, used or described in the Philippines.

The burden of proving want of novelty is on him who avers it and the burden is a heavy one that is met only by clear and satisfactory proof which overcomes every reasonable doubt. In determining whether novelty or newness is negative by any prior art, only one item of the prior art may be used at a time, and for anticipation to occur, the prior art must show that each element is found either expressly or described under principles of inherency in a dingle prior art reference or that the claimed invention was probably known in a single prior art device or practice. *[Manzano v. Court of Appeals, 278 SCRA 688, G.R. No. 113388, September 5, 1997, citing Kalman v. Kimberly Clark, 218 USPQ 781 789].*

The phrase "described in a printed publication" means that it is printed in nearly and any kind of document by any means (including electronic means) and has been made available to the public *(Bouchoux Deborah E., Intellectual Property: The Law of Trademarks, Copyright, Patents, and Trade Secrets, 2000 ed.)*. Critical to whether something is a "printed publication" or not is the question of open dissemination to workers skilled in the art. Where workers skilled in the art are able to get copies of a reference, it may be a "printed publication". *(Massachusetts Institute of Technology v. AB Fortia, 227 USPQ 428, Fed. Cir. 1985).*

Petitioner's evidence consisting of the newspaper article on the Prescon method of tensioning appeared in the March 11, 1969 issue of the Manila Times (Exh. "C") or almost two (2) decades earlier than the filing of Respondent's application on September 6, 1989. However, for the same to be considered as prior art, it is still necessary to show that all the elements in the claim are found in the printed document because "[i]n order for a prior printed publication to anticipate an invention, the description thereof must disclose the complete and operative invention in such full, clear, and exact terms as to enable any person skilled in the art to which it pertains to practice the invention to the same extent as he would have been enabled to do so if the information were derived from a prior patent" *(60 Am Jur. 2d, p.358, citing Fames v. Andrews, 122 U.S. 40, 30 L. Ed 1065, 7 S Ct 1073).*

In this case, the newspaper article merely referred to the "birth of a new construction system in the Philippines", but did not in any way discuss any of the elements of the claims of the new system. The article simply announced that Prescon Philippines was introducing a new method or system of post-tensioning, but no sufficient description and disclosure of the method was made therein in such manner as will enable any person skilled in the art to practice the said system of post-tensioning. For this reason, we hold that the newspaper article cannot be said to have anticipated the utility model of Respondent.

As regards the VSL manual (Exhs. "A-1" to "A-8") presented by Petitioner, this document consists of several pages containing the general description, principles and sequence of operations of the VSL strand system. The manual also includes a description and drawings of the strand, sheathing, anchorages and jacks, as well as technical information on its design. According to Petitioner's witness, the strand system shown in the VSL manual is similar to Respondent's utility model in terms of design and configuration except in the placement of the holes *(TSN dated June 24, 1992, p. 12 to 14).* In particular, the witness declared that there is no difference in technology, cable block holder, body shape, and sheath having a plurality of strands *(TSN dated July 28, 1882, p. 2 to 15)*. With this comparison, the witness concluded that the utility model of Respondent is not new or novel having been anticipated by the multi-strand system described in the VSL manual.

We note, however, that while the VSL manual contains the description and drawings of the multi-strand system that is allegedly similar to Respondent's utility model, there is no indication of the date when the manual was actually published and/or circulated in the Philippines. Other than the term "Asian Edition" appearing in the front page of the manual and the unsubstantiated allegation of the witness that the manual was circulated in the Philippines in the 1970s *(TSN dated July 28, 1992, p. 71)*, the records are bereft of any evidence that would show when the VSL manual was released for publication or circulation in this country. For being undated, the VSL manual is a useless prior art reference that cannot serve as an anticipatory bar. *[see Manzano v. Madolaria, Decision No. 86-56, July 7, 1986].*

With respect to Petitioner's claim that the utility model of Respondent is similar to the invention covered by Letters Patent No. 9917 issued on June 8, 1976 in favor of Welbergen and Siegwart (Exh. "D"), the law provides that an invention shall not be considered new or capable of being patented if it was the subject matter of a validity issued patent in the Philippine granted on an application filed before the filing of the application for a patent therefore *(see Sec. 9 of Rep. Act No. 165 in relation to Sec. 55 thereof, providing that utility models shall be subject to the provisions and requirements that relate to inventions in so far as applicable).*

Petitioner contends that the invention covered by the Wendelbergen patent is substantially similar to the utility model of Respondent, particularly the claims (Exh. "D-1") and the design of the anchor block, cable, final position of the wedges, anchor plate, and conical holes of anchor block (Exh. "D-2" to "D-7"). Petitioner's allegation of substantial similarity between the Wendelbergen patent and Respondent's utility model calls for the application of the doctrine of equivalents that has been applied by this Office in its decisions. *(Tolaram v. Kong, Decision No. 285-A dated January 18, 1965; Samson v. Tarroza, Decision No. 222 dated April 13, 1963).* This doctrine provides that "[a]n infringement also occurs when a device appropriates a prior invention by incorporating its innovative concept and, albeit with some modification and change, performs substantially the same function in substantially the same way to achieve substantially the same result." *[Godlines v. CA, 226 SCRA 338, G.R. No. 97343, September 13, 1993].* The reason for the doctrine of equivalents is that to permit the limitation of a patented invention which does not copy any literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such imitation would leave room for – indeed encourage – the unscrupulous copyist to make unimportant and insubstantial changes and substitution in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of the law. *[Godlines v. CA, 226 SCRA 338, G.R. No. 97343, September 13, 1993].*

The claim in the Welbergen patent called “apparatus for anchoring wires or stranded wires” under Letters Patent No. 9917 issued on June 18, 1976 reads:

> “An apparatus for anchoring wires or stranded wires incorporating an anchor equipped with throughpassage bores for the wires or stranded wires. The throughpassage bores possess at one end a conical recess for receiving the clamping wedges and also have a subsequently merging cylindrical section. Means are provided for applying the clamping wedges, during the mounting of the apparatus at the wires or stranded wires and during the tensioning thereof, against a press-in plate arranged in spaced relation from the anchor plate and which press-in plate is provided with holes or perforations for the throughpassage of the wires or stranded wires. The applying means retains the clamping wedges out of their effective clamping position. The press-in plate, after tensioning of the wires or stranded wires, is displaceable against the anchor plate for simultaneously and uniformly bringing the wedges into their clamping position.”

According to the claims, description and specification (Exh. “D”), the Welbergen patent relates to a new and improved construction of apparatus for anchoring wires or strands. It incorporates an anchor plate that contains bores or holes for the wires as well as clamping wedges for anchoring the wires. The bores or holes are provided at one end with a conical recess for the reception of said clamping wedges and with a subsequently merging cylindrical section.

The main claim of the Welbergen patent is an improvement that comprises a means for applying the clamping wedge against a press-in plate located at a distance from the anchor plate, said press-in plate having openings for the passage of wires, said applying means out of their effective clamping position, and after tensioning of the wires or stranded wires said press-in plate being displaceable against the anchor plate for simultaneously bringing the wedges into their clamping position.

The prior art refers to a whole series or solutions used to anchor (or to fasten or secure) wires with the aid of clamping means, and the problem that the Welbergen patent seeks to solve is the reliability of anchoring techniques. In particular, the invention seeks to achieve the following: (a) as small as possible subsidence (or collapsing) of the wedges (locks) with respect to the anchoring plate; (b) as small as possible slip of the wires or strands relative to the clamping means; and (c) the clamping means, which is a set of two to three wedges, should not carry out any relative displacement after anchoring of the wires, meaning, as nearly as possible all of the wedge ends should be located in the same plane.

To achieve these objectives, Welbergen’s anchoring apparatus incorporates several components: anchor plate, wedges, springs, and press-in plate. The apparatus is provided means to apply the clamping wedges, during application of the apparatus at the wires or strands and during the stressing or tensioning thereof, against a press-in plate arranged at a spacing from the anchor plate, and the press-in or pressing plate is provided with perforations or bores for the passage of wires, said applying means serving to retain the wedges out of their operable clamping position, and after tensioning of the wires of stranded wires the press-in plate is displaceable towards the anchor plate for simultaneously and uniformly bringing the wedges into their clamping position.

According to the description of the preferred embodiments of the said patent, a spring is inserted in the cylindrical section of the holes of the anchor plate. Then, the clamping wedges are introduced into the conical recess of the anchor plate in such a way that the wedges come to bear at the wall of the said conical recess. The press-in plate, which is also provided with holes, is mounted at the anchor plate in such manner that a space remains between the press-in plate and anchor plate, and then the springs are compressed so that the wedges are presses against the press-in plate. In this manner, the wedges are retained out of their effective clamping

position, which means that the stranded wires can move within and along tire wedge sets, without the wedges clamping the wires.

The prepared apparatus is then placed upon the bundle of stranded wires, and amounted at the region of the end of the said wires, afterwards, a tensioning or stressing head can now be applied to the outermost end of the wire bundle with the wedges now secured to the stranded wires. The anchoring apparatus is then displaced or moved against the support plate of a building with the wedges still not in their effectual clamping position.

The tensioning or stressing operation follows, and as soon as the final tensioning force of the wire bundle has been reached, a contact mechanism is used to press the press-in plate against the wedges which are also pressed into the conical recesses. During the reduction of the tensioning force of the tensioning apparatus, the wedge press-in force continues to be effective and ensures that all of the wedges ends will be located in one plane until reaching the force locking seat. In this manner, the purposes of the invention are thereby achieved. The apparatus does not rely on friction to introduce the wedges into their conical seats since this could lead to slipping of the wedges and wires, and could affect the reliability of the wedge anchoring.

Having discussed the features and method of using the Welbergen apparatus, we now consider the utility model of Respondent, the claim of which reads as follows:

> "An anchorage assembly for anchoring tensioning elements such as steel wires, steel strands or the like to a concrete structure comprising;
>
> An elongated body having a vertically extending bearing plate member provided thereon with a centrally disposed opening;
>
> A cable block holder member vertically disposed to one side of said bearing plate number and fixedly secured centrally thereto relative to said centrally disposed opening and having a plurality of apertures provided thereon;
>
> Anchoring members detachably fitted to said plurality of apertures for gripping the free ends of the strands which pass through thereon;
>
> An open ended conical housing member transversely disposed at the other side of said bearing plate member with the broader end fixedly secured thereto align with said opening and the narrow end adapted to receive thereon a snugly fitted corrugated sheath having a plurality of strands projecting therefrom and extending thereto said plurality of aperture;
>
> Said cable holder further having a passage member provided thereon for injection of the grouting material after stressing the strands and said bearing plate member having corner apertures adapted for fixing said bearing plate to said structural body."

The utility model of Respondent relates to an anchorage assembly for anchoring tensioning or stressing elements usually made of steel wires or strands arranged to lie side in a circular manner, and consists of the following parts: a cable block holder, bearing plate member, and conical housing.

The prior cited in Respondent's application consists of the practice of using steel bars embedded in concrete which entails so much time since the bars are embedded one at a time. In addition, the length of a steel bar may cause unwanted deflection. Respondent's utility model, therefore, seeks to remedy the foregoing problems by an apparatus that is defined by a hollow elongated body consisting of a bearing plate member, a conical housing member, and an anchor block holder that is secured to the bearing plate. According to the specification, this particular construction permits no limits as to the length of a beam that could be supported since the wire

strands are inserted in the body where they are stretched and where cement is introduced, thus eliminating the use of a post.

The bearing plate member has a central opening that is welded to a cable block holder having a plurality of apertures of holes containing anchoring wedges with internal threads for gripping the wire strands. Corner slots are also provided in the bearing plate member for fixing the anchoring device to a concrete structure. The conical housing member has broad and narrow ends, with the broad end being welded to the bearing plate member, and the narrow end adapted to receive a corrugated sheath having a plurality of strands. The cable block holder also has a small circular passage by which grouting material like cement is injected after stressing the strands.

The anchoring device is placed in a recess or depression of a concrete structure, and the corrugated sheath of wire strands is fitted to the narrow end of the conical housing member, passing through the bearing plate member and then gripped by the threads in the anchor block holder. A stressing jack is then used to stress the ends o the wire strands. Finally, a tube is inserted to the circular passage in the cable block holder and grouting material such as cement is injected to fill the spaces around the strands and the whole of the anchorage assembly.

A reading of the claims, description and specification of the Welbergen patent (Exh. “D”) and Respondent’s utility model (Exh. “B”) shows that both are used to anchor or to fasten wire strands during the process of tensioning or stressing the wires. The Welbergen patent refers to an “apparatus for anchoring wires or stranded wires”, while the utility model of Respondent refers to an “anchorage assembly for anchoring tensioning elements”. From their titles alone, it is unquestionable that the two (2) devices perform substantially the same function, namely, as anchoring devices in the tensioning of wires, but while they perform substantially similar functions, we do not find substantial similarity in the way they are used or operated nor is there substantial similarity in the results.

Welbergen’s patent employs a press-in plate that is pressed against an anchor plate during the tensioning process. The holes in the anchoring plate also have helical springs that prevent the wires from being prematurely clamped by the wedges during the tensioning process. The utility model of Respondent, however, has a bearing plate and anchor block holders that are not pressed against each other, and does not use helical springs. In the Welbergen patent, the individual wire strands to be anchored and stressed are inserted from their position in the building component toward the holes located in the press-in plate and anchor plate all the way to the tensioning or stressing head. On the other hand, Respondent’s utility model uses a corrugated sheath of wire bundles that is inserted at the narrow end of the conical housing member and then made to pass through the holes in the anchor block holder that is welded to the central opening of the bearing plate member. Moreover, in Respondent’s utility model, grouting material like cement is inserted after the tensioning process into the central opening in the cable block holder and made to pass through the cavity inside the anchorage assembly. No such opening or method of grout injection is provided in the Welbergen patent.

The differences between the Welbergen patent and Respondent’s utility model can be further explained by the problems that each anchoring device seeks to solve. The Welbergen apparatus prevents the possible collapsing of the wedges or locks with respect to the anchor plate, and ensures that the clamping means do not experience displacement or movement so that the wedge ends are located in the same plane. On the other hand, Respondent’s utility model seeks to replace the method of using steel bars which are embedded one at a time and may cause deflection due to their length.

The records and evidence clearly support the finding that there is no substantial similarity between the Welbergen patent and Respondent’s utility model. Where the Respondent’s product performs substantially the same function but achieves a different result through a different way, there is no equivalence.

As Petitioner failed to present any clear, convincing and satisfactory proof that would show lack of novelty of Respondent's utility model, the above-captioned Petition for Cancellation of Letters Patent No. 3727 is hereby DENIED.

Let the filewrapper of the utility model subject matter of the instant case be forwarded to the Administrative, Financial Human Resource Development Service Bureau for appropriate action in accordance with this Decision, with a copy thereof to be furnished the Bureau of Patents for information and update of its record.

SO ORDERED.

Makati City, January 29, 2003.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs