

ERIBERTO G. SANDOVAL,  
Complainant,

IPV CASE NO. 10- 2001- 00003

-versus-

For: Infringement of Copyright  
and Industrial Design with  
Prayer for Damages and  
Application for TRO and/or  
Preliminary Injunction

SPOUSES LIBERATO and  
HEIDI BISCOCHO,  
Respondents.

Decision No. 2003 - 03

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### DECISION

In this action for infringement of copyright and industrial design, Eriberto Sandoval ("Complainant") in his Amended Complaint dated July 11, 2001 alleges that he is the maker, designer and registered owner of a wall decor entitled "Goddess of Fortune and Goodwill", having been issued Cert. of Copyright Registration No. G2000-234 dated September 22, 2000 and Cert. of Registration of Industrial Design No. 3-2000-000528 dated March 15, 2001.

The complaint further states that sometime in February 2001, complainant learned that Spouses Liberato and Heidi Biscocho ("Respondents") had been making, producing, distributing, offering for sale and actually selling to the public for profit/ commercial purposes a product/ article bearing or embodying a design which is a copy or imitation, or substantially a copy of the protected product/article of Complainant without his consent or authority and which is a violation of his intellectual property rights. Complainant thereafter, demanded that Respondents stop and refrain from making and selling similar wall decors. However, Respondents refused to heed the request of complainant, hence, the filing of the instant suit for infringement of copyright and industrial design with claims for damages, attorney's fees and costs of suit.

Complainant also sought the issuance of a temporary restraining order and/ or writ of preliminary injunction, alleging that the continued performance any Respondents of said acts has caused him grave and irreparable injury, that the writ is necessary to maintain the status quo, that if no such writ is issued, the complaint would become moot and academic, and that whatever judgment that may be rendered in this case would become useless and ineffectual and would cause grave and irreparable damage and prejudice to Complainant.

After hearing and reception of evidence on the restraining order, this Office denied Complainant's application for the issuance of the writ under Order No. 2001-53 dated October 22, 2001.

In their Amended Answer dated September 19, 2001, Respondents denied the material allegations of the complaint, and sought the dismissal of the case for lack of cause of action on the ground that Complainant was not the author, maker or designer of the work. Respondents claimed that the subject design had been in the market long before Complainant filed his application for copyright and/or industrial design registrations, that there were numerous identical and similar designs available in the market depicting the same images and style, and that Complainant committed misrepresentations before this Office and the National Library when he filed his application for industrial design and copyright registrations.

Respondents also averred that Complainant simply borrowed the design from somebody else, that Complainant had no evidence that he had been authorized by the original creator of

said design, and that given the earlier availability of the design in the market, Complainant could not claim any exclusive right on the work since the same had already been vested to the public. As compulsory counterclaims in their Answer, Respondents sought moral and exemplary damages as well as attorney's fees and costs of suit.

After joinder of issues, the case was set for pre-trial conference, but when the parties failed to arrive at any settlement, the case went to trial on the merits. In support of his allegations, Complainant presented his own testimony and that of Rolando Dadula, and offered documentary evidence consisting of the following: photograph, specification and features of the subject wall decor (Exhs. "A" to "A-2"); Certificate of Industrial Design Registration No. 3-2000-000528 (Exh. "A-3" to "A-4"); Certificate of Copyright Registration and Deposit (Exh. "B"); Application for Copyright Registration (Exh. "B-1"); Memorandum dated April 2, 2001 (Exh. "C"); Letter dated April 2, 2001 (Exh. "C-1"); BIR Certificate of Registration dated December 1, 2000 (Exh. "D"); and Sales Booklet containing receipts (Exh. "E" to "E-1"), which were admitted in evidence under Order No. 2002-26 dated February 8, 2002.

Complainant also presented rebuttal evidence that included the testimonies of Nestor Reyes and Irmina India, and documentary evidence consisting of the following: identification card of Nestor Reyes (Exh. "A"- Rebuttal); diplomas and certificates conferred on Irmina India (Exhs. "B" to "B-1" Rebuttal); computer printout depicting information and illustration of Helios, the Greek God of the Sun (Exh. "C"-Rebuttal); search results downloaded from the internet (Exh. "D" to \* "E"- Rebuttal); and computer printout depicting an illustration of Helios (Exhs. "F" to "F-4"- Rebuttal), which were admitted in evidence per Order No. 2002-115 dated October 1, 2002.

Respondents for their part presented the testimonies of Albert Atienza, Flora Atienza and Manuelo Gonzales. Respondent Liberato Biscocho also testified for and in his own behalf. They also presented documentary evidence consisting of the following: photograph of wall decor (Exh. "1"); certification dated June 19, 2001 (Exh. "2"); version of wall decor design (Exh. "3" to "3-C"); affidavit of Flora Atienza (Exh. "4"); duplicate original copy of official receipt by Le Franz General Merchandise (Exh. "5"); affidavit of Manuelo Gonzales (Exh. "6"); electronic copy of Helios and short history (Exhs. "7" to "8"); medical certificate for Heidi Biscocho (Exh. "9"); Respondent's business permit (Exh. "10" to "11"); receipts for food, medical and transportation expenses incurred by Respondents in defending the case (Exh. "12"); passport of Liberato Biscocho (Exh. "13"); airline ticket of Liberato Biscocho (Exh. "14"); retainer agreement (Exh. "15"); airline ticket of Liberato Biscocho (Exh. "16"), which were admitted in evidence under Order No. 2002-78 dated July 1, 2002.

On rebuttal, Respondents recalled Albert Atienza to the witness stand, and offered documents that included the following: image of helios from Encyclopedia Britannica (Exh. "1" - Rebuttal); and pages from Mythman's homework help center (Exh. "2" to "2-5"- Rebuttal), which were admitted in evidence under Order No. 2002-227 dated November 25, 2002.

After the parties submitted their memoranda, the case was deemed submitted for decision on whether there is substantial evidence to hold Respondents liable for infringement of copyright and industrial design. Complainant relies on the copyright and industrial design provisions of Rep. Act 8293 ("IP Code") to enforce his intellectual property rights. The protection afforded by copyright law does not preclude Complainant from claiming concurrent protection under the provisions on industrial designs in as much as the IP Code does not contain any prohibition against the application of the principle of cumulative protection, which provides that a work may be protected simultaneously by copyright and design law. [*WIPO Intellectual Property Handbook, June 2001, page 117*].

It must be noted, however, that while simultaneous protection is allowed under Philippine laws, copyright and industrial design laws are governed by different sets of rules. The subject matter of legal protection of industrial design is not articles or products, but rather the design that is applied to or embodied in such articles, while in copyright, the subject matter of the right is the

work created by the author. (WIPO Intellectual Property Handbook June 2001, pages 113 & 116]. For this reason, we will discuss each right separately.

### Copyright Infringement

Copyright infringement is the unauthorized exercise of an author's economic rights such as the right of reproduction, preparation of derivative works, first public distribution, rental, public display, public performance and other communication to the public of the work. [Secs. 177 to 177.7 of the IP Code]. In order to succeed in a claim for copyright infringement, complainant must show that he has a valid copyright in the work, and that respondent infringed his copyright by copying protected elements of the work. [see *1.A.E., Inc., et al. vs. Paul shaver, et al., USCA, 7th Circuit, January 17, 1996*].

With respect to the element of copying, there is no question in this case that the works of Complainant and Respondents are similar. During the pretrial conference, Respondents admitted that they are making, producing, distributing, offering for sale and actually selling to the public for profit/commercial purposes a product/article bearing or embodying a design which is a copy or imitation, or substantially a copy or imitation, of the protected product/article of the Complainant, without the latter's consent. [see *Pre-Trial Order No. 2001-67 dated November 21, 2001*]. In fact, Respondent Liberato Biscocho even declared in his testimony that he only copied the wall d6cor sometime in year 2000 from an existing work of another person whose name he could not recall. [See *TSN dated October 9, 2001, pages 42-45*].

But while Respondents admit that the articles they manufacture and sell are similar to those made by Complainant, they assert that no copyright subsists over Complainant's work because it is not original, having been copied only from another pre-existing work . Respondents presented documentary and testimonial evidence to prove that the work subject matter of the instant case had already been in existence prior to the date of the alleged creation by Complainant.

As proof, Respondents offered Exhibit "1-Rebuttal" which is a page from Encyclopedia Britannica depicting the history of baroque paintings in Italy, which Respondent denominated as the Image of Helios. One of the paintings illustrated therein is the "Aurora", a ceiling fresco that was painted by Guido Reni during the years 1613-1614 and presently displayed in the Casino Rospigliosi in Rome, Italy. [Exh. "1-Rebuttal "]. For reference, the front view of Complainant's wall decor [see Exhibit "A"] together with the page from Encyclopedia Britannica showing a pictorial illustration of the "Aurora" painting [Exh. "1-Rebuttal"] done by Guido Reni in the 16th century as well as the photograph of Complainant's wall decor [Exh. "1"] are reproduced for comparison:



Exh. "A"



Exh. "1-Rebuttal"  
("Auror" Painting by Guido Reni)



Photograph of Complainant's Wall Decor  
Exh. "1"

An examination of the two works (that is, front view of Complainant's wall decor and the "Aurora" painting) indicate that they are similar in all respects. Both of them show a female character leading a procession of several characters consisting of a man riding a chariot that is pulled by several horses and surrounded by seven (7) other female figures. A representation of an angel also appears on the upper right hand portion of the images. No less than the witness for Complainant, Irmina India, confirmed during her cross-examination the similarities between the supposed original work of Complainant and the "Aurora" painting by Guido Reni:

ATTY. DIMAILIG : Now, would you kindly tell me what is the similarity between Exhibit "A", the colored picture that I have there and this one (referring to Respondent's Exhibit "1-Rebuttal") let me show you again Exhibit "A" ["1"J, what is the similarity? Are they exactly similar? (*Emphasis supplied*).

WITNESS : Opo. (*Emphasis supplied*).

ATTY. DIMAILIG : And could you kindly read the information indicated on the bottom side of the picture?

WITNESS : Aurora ceiling fresco by Guido Reni.

ATTY. DIMAILIG : OK, and then?

WITNESS : 1613-14. In the casino Rispoliosi, Rome."  
(TSN dated August 28, 2002, page 61).

The foregoing suggests that Complainant's work "Goddess of Fortune and Goodwill" is not an original creation but is a mere copy of a painting entitled "Aurora" done by Guido Reni in the early 16th century. An ordinary observer would easily find that the two works are exactly the same and without doubt a copy of each other, as what Complainant's own witness declared.

It must be stressed that copyright cannot extend to those creations that are already in the public domain, such as characters based on ancient mythology or popular paintings whose copyright had already expired. Copyright law protects only original creations as a means to spur creative activity and ensure the promotion of science, culture and the arts. The essential requirement for copyrightability is that the work must be an original work of the author. Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity. [*Amador, Copyright Under the Intellectual Property Code, 1998 ed., at p. 281*].

Complainant tried to establish his authorship of the work by declaring that he has been engaged for the last five (5) years in the business of manufacturing and selling religious articles and decors, thus:

"ATTY. BARRAMEDA : Now what is your occupation?

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WITNESS : Dati po ang trabaho naming una, mga scaiola. Yung mga santo-santo ganon. Kami po ang gumagawa ng mg pang-display po, sari-sari pong mga item. Mangyari po naman, dati scaoila, sa ngayon po fiber glass ang aming ginagawa .

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ATTY. BARRAMEDA : Now, you said that you've been engaged in that kind of business. How long have you been engaged in that business? Gaano katagal ka na dyan sa trabahong yan?

WITNESS : Limang taon na po na nagtatrabaho ako. "(TSN dated September 27, 2001, page 5-6).

Complainant then narrated how he came up with the wall decor design, thus:

"ATTY. BARRAMEDA : Your Honor please, we would like to make it of record that this witness herein is referring to a picture which is already attached to the complaint. He is actually referring to a wall decor. Now Mr. Witness, how did you come up with that design or that wall decor? Pano ka nakabuo ng design na ganyan?

WITNESS : Kasi nga po ang trabaho namin dati nga scaiola. Ngayon po yung design na ito po bale napagtulungan po naming ng aking isang kasama . Ngayon po dahil sa tagal naming sa aming trabaho dahil kasi po nakikita naming yung mga kabayo swerte raw sa bahay. Ngayon kami bale magkasama nito palagi ay gusto gumawa kami ng isang design na binuo naming sa tulong naming na yung alam nya pinagtugma-tugma naming hanggang sa nabuo naming yung design.

ATTY. BARRAMEDA : Now, you are referring to a person. What is the name of this person who according to you, assisted you in coming up with this design? Sinong tao yung tinutukoy mo?

WITNESS : Kasama ko po ngayon.

ATTY. BARRAMEDA : What is his name? Anong pangalan?

WITNESS : Pastor Dadula po, Rev. Pastor Dadula po. "(TSN dated September 27, 2001, page 8-9).

But when asked during cross-examination the meaning of the chariots and horses, Complainant answered:

"ATTY. DIMAILIG : Now, you made mention also in your direct testimony that bits and pieces of horses, chariots have been taken together in order to form, what you now claim as the ornamental decor you named Goddess of Goodwill and Fortune. Do you attribute any significance on horses, on the chariot, on the angel that I have seen in the photocopy depicting the actual ornamental design? Ang ibig kong sabihin sa pagkecreate mo, sa paglikha mo ng nasabing wall decor, mayroong mga kabayo akong nakita noon, may mga anghel na nalipad, meron ka bang ibig sabihin sa mga ito ?

"WITNESS : Meron po.

ATTY. DIMAILIG : Itong kabayo, anong ibig sabihin nito?

WITNESS : *Kasi po ang kabayo po sa pagkakaalam ko kasi, kadalasan kong nakikitang display sa mga bahay ang kabayo, swerte raw po iyon.* (emphasis supplied).

ATTY. DIMAILIG : Swerte?

WITNESS : Opo.

ATTY. DIMAILIG : How about yung anghel?

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WITNESS : Yoon daw po ang liwanag.

ATTY. DIMAILIG : Ang anghel.

WITNESS : Opo

ATTY. DIMAILIG : Sinong maysabi sa yong anghel ang liwanag?

WITNESS : Dahil ganito po yon, yon pong disenyo nabuo naming, hindi ng ako lang.

ATTY. DIMAILIG : I know. Sinong nag-recommend.

WITNESS : Yun pong aking kasama.

ATTY. DIMAILIG : Do you know who is this companion?

WITNESS : Rolando. Pastor Dadula (sic).

ATTY. DIMAILIG : How about the people who surround the chariot being carried by this horse or horse? Anong ibig sabihin ng mga taong yan? What do they signify, their presense here?

ATTY. BARRAMEDA : Ang tinutukoy ni Attorney, itong mga taong ito, ano ang purpose niyan bakit mo isiningit yan? Ano ang gusto mong ipahiwatig diyan?

WITNESS : Eto go bale ang amingdesign na ito ay ang nakakaalam go ng ibig sabihin nito ay ang aking kasama . Siya yo kasi ang nagdesign. Ang design ko lang po dito ay kabayo. "(TSN dated September 27, 2001, page 46-49) (emphasis supplied).

From the testimony of Complainant, it appears that his wall decor design was "inspired" by the concept of horses bringing good luck. However, when Complainant was asked to discuss the meaning of the other characters in the wall decor, Complainant could not provide an answer and instead declared that his only contribution was in the design of the horses, while the rest was done by another person, Rolando Dadula, who later provided corroborative testimony as follows:

"ATTY. BARRAMEDA : How did you know that the Complainant came up with the design?

WITNESS : No sinagest (suggested) niya ang idea, dinagdagan ko thru my intellect. Mula sa Henesis 1:6, binuo ko muna ang frame, walang anyo.

ATTY. BARRAMEDA : Are you saying in effect that this ornamental wall decor, the design is your idea?

WITNESS : Nabuo po ang design na yan na pinagsama-sama po ang utak ng manggagawa, ang spiritual mind. So sinabi ko sa kanya ito ang meaning nito, ganyan , .... (emphasis supplied)

ATTY. BARRAMEDA : I noticed that the name of this ornamental wall decor is goddess of fortune and goodwill. How did you come up with the name?

WITNESS : As spiritual adviser, I read this scripture, di ko lang pa abot dahil di ko pa nakita, may kahulugan na di lang lalake ang dapat sa. .. (sic) Sa kaunting bagay ay pinahahalagahan o dapat sambahin.

ATTY. BARRAMEDA. : So in effect you are saying that this is your idea?

WITNESS : Yes. (emphasis supplied)

ATTY. BARRAMEDA : Could you kindly explain how you came up with that title goddess of fortune and goodwill.

WITNESS : Yes, not fully literal translation but as spiritual explanation pero di natin kayang biruin . Goddess is what we call, sa translation eh di sa salitang diyosa, di na mabibil yan. As salesman, that is what we call charming woman o beautiful woman, bilang magandang babae, hindi po natin ipinapaliwanag ito literally but biblically." (TSN dated December 3, 2001, page 6-8)

In his testimony, Rolando Dadula declared that the concept of the wall d6cor design was based on certain passages in the bible, that the work was a creation of different minds and that the title "goddess of fortune and goodwill" should be given a "spirituaY" explanation instead of literal translation . He stated that he was the one who was directly involved in the work and that Complainant's only participation was only with respect to the design of the horse. He further declared:

"ATTY. DIMAILIG : So it appears to us now that on the basis of your testimony, you did not only assist the Complainant and the formulation of the concept of his creation named Goddess of Fortune and Goodwill. In fact, you are directly involved in his creation, right? (Emphasis supplied).

WITNESS : Yes. (Emphasis supplied).

ATTY. DIMAIUG : Ok, so what then is the participation of the Complainant in this particular creation? Kung ganon po, ano po ang nagging participation ng Complainant kasi base sa iyong testimonya, halos kayong lahat ang parang nag-create,

in fact gave particular characteristic in every character depicted in that wall decor. Ano po ang nagiging partisipasyon?

WITNESS : Siya rin po ang nag-suggest ng kanyang alam at kung paano isasagawa, siya na rin ang nag-manage kung paano isaayos yang design na yan kasi actually po hindi lang naman sa kanyang kamay lang nagdaan yan.

ATTY. DIMAILIG : *So in what particular respect did he participate? What was his contribution?(Emphasis supplied).*

WITNESS : *Yun pong katulad po ng mga inilagay niyang bagay katulad ng horse. (Emphasis supplied).*

ATTY. DIMAILIG : Ng?

WITNESS : Yung horse na yan at tinitignan niya at tinitignan ko naman sa historical, kung tatama o hindi." (TSN dated December 3, 2001, page 35).

Under these circumstances, we cannot see how Complainant could possibly acquire ownership of copyright over the work. The evidence is clear that Complainant is not the author of the work. We find it unusual for someone who claims to be the original creator of a work to be unable to explain the meaning or significance of the details of his creation. He could not explain how he was able to come up with the wall decor, declaring instead that the extent of his participation is only with respect to the design of the horses.

We can only surmise if Complainant's assertion of his supposed copyright arose from the fact that he transferred a scene from a popular wall painting or fresco into a wall decor using a method he himself created. However, it must be emphasized that the subject matter of protection in copyright law is the work created by an author, and not the process for making or transferring that work.

Copyright law protects originality of creation, not effort . [Feist Publications v. Rural Telephone Service, Co., 499 U.S. 340 (1991)]. Thus, a person who transfers an image of the Mona Lisa to a t-shirt using the silkscreen process could not acquire copyright over the image because it was an original creation of Leonardo da Vinci, whose copyright over said portrait had already expired hundreds of years ago.

Moreover, the fact that Complainant contributed to the design of the horses could not give rise to ownership of copyright since the wall decor consists of many other characters, figures and details which must be taken in its entirety and should be considered as a single piece of work and not as a joint work of many authors.

We also cannot give credence to the rather obscure testimony of Rolando Dadula. We find it peculiar that the alleged combined efforts of Complainant and Rolando Dadula in coming up with a wall decor design would result to something that is exactly similar or identical to a complex and intricate 16<sup>th</sup> century baroque painting - with the same number of characters, same position of figures and arrangement of elements up their minutest details, and essentially depicting the same scene or overall impression which Respondent presented as "Exh" 1- Rebuttal." We are led to no other conclusion that the wall decor that Complainant claims to be his original work is a mere copy of an already pre-existing work.

Finding substantial evidence that Complainant's work is not original but is a mere copy of the "Aurora" painting by Guido Reni, this Office is convinced that Complainant cannot seek protection under the Copyright Law.

Infringement of Industrial Design

In addition to the certificate of copyright registration, Complainant also holds Industrial Design Registration No. 3-2000-000528 issued by this Office on March 15, 2001. Under Sec. 113 of the IP Code, only industrial designs that are new or original shall benefit from protection, and under Sec. 119 in relation to Sec. 23, an industrial design shall not be considered new if it forms part of prior art.

Only industrial designs that are new or original shall benefit from protection, [Sec. 131.1] and an industrial design that does not satisfy this requirement may be cancelled pursuant to the same novelty and prior art standards used in invention. [Sec.120.1(b) and Sec. 119 in relation Secs. 23 & 241. This means that an industrial design shall not be considered new if it differs from prior designs in minor respects that it can be mistaken as such prior designs by an ordinary observer. [see also *Gorham Co. v. Mite*, 81 U.S. (14 Wall.) 511 (1871)].

The novelty of a design is to be tested, not by investigation of the means employed for its creation, but by ocular comparison of the design itself with prior designs, which are alleged to be substantially the same. The subject for consideration is not the process of creation, but the effect produced upon the eye by the thing created. [*Co San v. Jose Lian Bio*, decision No. 108, March 15, 1956]. What is required is that the design shows such originality, which may not be within the competence of the routine designer. To be patentable the design should display a characteristically different effect not suggested by the prior art. [*Ex Parte Sy Pio Lato*, Decision No. 88-7, February 3, 1988].

From the eye of an ordinary observer, Complainant's Goddess of Fortune and Goodwill does not show any significant difference compared to the "Aurora" painting by Guido Reni, which had already been in existence long before Complainant's alleged date of creation on 8 August 200() and long before the filing of Complainant of his application for Industrial Design Registration on September 21, 2001.

Having considered the evidence and having found from our earlier discussion on copyright that Complainant's work is neither new or original, it is not difficult to determine why Complainant's claim for industrial design infringement should also fail.

For the above reasons, this Office finds and so holds that Complainant's industrial design is not new, having been anticipated by prior art, hence, should be cancelled in accordance with Sec. 10.2(b) (vi) of the 4 P Code and Rule 12, Section 1(f) of the Rules and Regulations on Administrative Complaints for Violation of Laws Involving Intellectual Property Rights.

WHEREFORE, it appearing that Complainant's work is neither new nor original, Respondent's use of a similar work cannot constitute infringement of copyright and/or industrial design. Accordingly, the instant complaint filed by Complainant is hereby DISMISSED, and Cert. Industrial Design Registration No. 3-2000-000528 issued by this Office on March 15, 2001 is hereby ordered CANCELLED.

Let the filewrapper of the design patent subject matter of the instant case be forwarded to the Administrative, Financial and Human Resources 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, December 23, 2003.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs