

SI KA CHONG,
Petitioner,

INTER PARTES CASE NO. 1970

PETITION FOR CANCELLATION:

- versus -

Letters Patent No. D-3399
Issued : October 4, 1985
Patentee : Rogelio Tan
For : ELECTRIC CANDLE
LIGHT

ROGELIO TAN,
Respondent-Patentee.
x-----x

DECISION NO. 89-58 (TM)
August 3, 1989

DECISION

This pertains to a Petition for Cancellation instituted by the herein Petitioner, Si Ka Chong, asking for the cancellation of Letters Patent No. D-3399 issued on October 4, 1985 in favor of the herein Respondent-Patentee, Rogelio Tan, for "ELECTRIC CANDLE LIGHT".

Petitioner is a Filipino of Chinese origin and a resident of Bo. Gen. T. de Leon Street, Valenzuela, Metro Manila.

Respondent is also a Filipino citizen of Chinese descent, with business address at 890 Carmen Planes, Binondo, Metro Manila.

The grounds for the petition are as follows:

"1. The design patent for electric candlelight is not new nor patentable under Section Fifty-Five and Section 56 in relation to Section Nine of Republic Act No. 165 as amended by Republic Act No. 864 at the time the application for grant of patent therefor was lodged at the Philippine Patent Office.

2. Rogelio G. Tan, the person to whom the patent was issued was not the true and actual designer nor did he derive his rights from the Petitioner, the true and actual owner and designer."

Respondent-Patentee, on January 27, 1986, filed his Answer denying specifically all the material averments contained in the said petition and raised the following significant Special and/or Affirmative Defenses, to wit:

"6. That respondent was the original, first, sole, true and actual designer and owner of the industrial design for electric candlelight for which he was granted by this Honorable Office Letters Patent No. 3399; that respondent was the first one to be granted a Letters Patent by this Honorable Office for such industrial design;

7. That, as the instant Petition itself shows, petitioner's alleged application for registration under the principal and supplemental register is for a trademark while respondent's application for registration with this Honorable Office is for an industrial

design; that the instant petition should be dismissed outright because trademark and industrial design are two (2) different things;

8. That the industrial design of respondent is materially and patentably different from the alleged trademark of petitioner; that, before respondent was granted Letters Patent No. 3399, the examiner assigned must have examined the records of the trademark application for registration filed by petitioner with this Honorable Office and considered the same before recommending the grant of such mark application of the petitioner was not cited as a reference, if ever there was any;

9. That when he filed his design application on January 31, 1985, respondent did not know and did not believe that his particular industrial design was ever known or used by others in the Philippines before his design thereof, or patented or described in printed publication in the Philippines or in any country more than six (6) months prior to January 31, 1985, or in public use or on sale in the Philippines by persons other than he more than six (6) months before January 31, 1985 or that the subject matter of said industrial design is the same as that of some other design covered by a patent validly issued in the Philippines, filed before the filing of his (respondent's) application and that no application for patent on such industrial design had been filed by him (respondent), or his representative or assigns in any country foreign to the Philippines;

x

x

x

After the joinder of issues, the pre-trial conference was made between the parties and their respective counsels. No amicable settlement could be effected so the case was tried on the merits.

Petitioner's exhibits consisted of both testimonial and documentary evidences which are as follows:

<u>Exhibits</u>		<u>Description</u>
"A"	-	Receipt No. 2805, dated April 20 1983.
"A-1"	-	Invoice .No. 2806 dated April 29, 1983.
"A-2"	-	Invoice No. 2807 dated April 29, 1983.
"A-3"	-	Invoice No. 2808 dated April 29, 1983.
"A-4"	-	Invoice No. 2809 dated April 29, 1983.
"A-5"	-	Invoice No. 2853 dated May 17, 1983.
"A-6"	-	Invoice No. 2854 dated May 17, 1983.
"A-7"	-	Invoice No. 2855 dated May 17, 1983
"A-8"	-	Invoice No. 2856 dated May 17, 1983.
"B"	-	Trademark application filed by Mr. Si Ka Chong dated September 10, 1983
"B-1"	-	A label attached to the trademark application.
"B-2"	-	Drawing of the trademark application.

“C”	-	A trademark application filed by Mr. Si Ka Chong for an electric candlelight holder, also dated August 15, 1985.
“C-1”	-	Drawing attached to the aforementioned trademark application.
“D”	-	A United Daily newspaper dated December 12, 1985.
“D-1”	-	The Chinese notice of the fact that Mr. Rogelio Tan has notified the public that he has registered the design for an electric candlelight holder with the Patent Office.
“D-2”	-	The English notice.
“E”	-	The electric candlelight holder itself.

(Tsn., April 15, 1986 hearing)

The said exhibits were admitted by this Bureau for whatever worth they may have in aid of the decision of this case in an order made in open session in the hearing of April 15, 1986, with Respondent's objections duly noted to be considered in the final evaluation of the issues involved in this case.

Respondent started to present its evidence since May 7, 1986 by presenting as hostile witness the Petitioner, Si Ka Chong, followed by the testimony of Rogelio Tan, as set forth in his affidavit marked Exhibit “5” and that of Antonio Go, as set forth in his affidavit marked Exhibits “3” and “3-A”. Respondent's evidence, in summary, are:

<u>Exhibits</u> (There is no Exhibit “1”)	<u>Descriptions</u>
“2” and “2-A”	One set of the electric candlelight holder design by respondent, Rogelio Tan.
“2-B”	Carton where such electric candlelight holder is placed.
“2-C”	Removable bulb socket or respondent Rogelio Tan's electric candlelight holder.
“2-D”	Trademark on the second layer of the base of respondent Rogelio Tan's electric candlelight holder.
“3” and “3-A”	Affidavit of witness, Antonio Go, sworn to by him on June 13, 1986; second page of said affidavit (Exh. “3”).
“4”	Invoice No. 5045 dated June 18, 1984 of Supersonic Engineering.
“5”	Affidavit of respondent Rogelio Tan, sworn to by him on June 27, 1986.

“6”	Application for issuance of design letters patent dated January 31, 1985 of Respondent, Rogelio Tan
“7”	Letters Patent No. 3399 dated October 14, 1985 issued by the Philippine Patent Office.
“8” and “8-A”	Certification of Copyright Registration dated February 5 and October 14, 1985 issued by the National Library.
“9”	December 12, 1985 issue of United Daily News.
“9-A”	Chinese notice in Exhibit “9” about the design patent of Respondent Rogelio Tan for his electric candlelight holder.
“9-B”-	Electric version of such notice.

The said exhibits were admitted by this Bureau for whatever worth they may have in the determination of the issues involved in this case, with Petitioner's objections duly noted and made part of the records hereof.

In the determination of whether the Petition for Cancellation be given due course, reference is made to Sections 55 and 56 of the Patent Law, the pertinent provisions of which are:

“SEC. 55. Design patents and patents for utility models. – (a) Any new, original and ornamental design for an article of manufacture x x x may be protected by the author thereof, the former by a patent for a design x x x in the same manner and subject to the same provisions and requirements as relate to patents for inventions insofar as they are applicable, except as otherwise herein provided.

The standard of novelty established by section nine for inventions shall apply to ornamental designs.

x x x

“SEC. 56. Six months publication. -The period of one year specified in section nine, Chapter II, and section fifteen, Chapter III hereof, for inventions shall be six months in the case of designs.”

Likewise, Section 9, supra, provides as follows:

“SEC. 9. Invention not considered new or patentable. - An invention shall not be considered new or capable of being patented if it was known or used by others in the Philippines before the invention thereof by the inventor named in an application for patent for the invention, or if it was patented or described in any printed publication in the Philippines or any foreign country more than one year before, the application for a patent therefor; or if it had been in public use or on sale Philippines for more than one year before the application for a patent therefor; or if it is the subject matter of a validly issued patent in the Philippines granted on an application filed before the filing of the application for patent therefor.”

Petitioner, on the other hand, filed an application under Serial No. 9953 on September 15, 1983 for the registration in the Supplemental Register of the mark REPRESENTATION OF A DRAGON” which he claimed to have adopted and used for “electric candlelight” and that the

mark was first used on the March 15, 1982 (please see Exh. "B"). The accompanying drawing (Exh. "B-2") indicates a representation a dragon which is facing towards the right, about two inches in height and right across it, in the same line but separated by a space about an inch and a half wide, is the representation of a bird, also of the same height. This application was converted into an application for registration in the Principal Register, as per Conversion Order No. 84-99 dated October 30, 1984. On August 15, 1985, the Petitioner filed anew an application for trademark registration in the Principal Register of the mark "REPRESENTATION OF A DRAGON ATTACHED TO AN ELECTRIC CANDLELIGHT HOLDER" (Exhs. "C"). The drawing of the application was presented in evidence as Exhibit "C-1" sets forth the drawing of two electric candlelight holders, each with a representation of a dragon and a bird at the base.

The issue to be resolved is whether or not the design covered by Patent No. D-3399 is cancellable on the ground that it is not new.

We resolve to deny the petition.

"Design, in this view of the Patent Law, is that characteristic of a physical substance which, by means of line, images, configuration and the like, taken as a whole, makes an impression, through the eye upon the mind of the observer. The essence of a design resides, not in the elements individually, nor in their method of arrangement but in their tout ensemble, in that indefinable whole that awakens some sensation in the observer's mind." (Lipscomb's Walker on Patents, 3rd Ed., Vol. 5, P. 9)

"To find a lack of novelty, it is necessary that a prior single reference fully discloses the patent claim in issue. x x x As applied to design patents, it would be necessary to find the overall appearance of a prior reference was virtually identical to plaintiff's design. x x x" (Sidewinder Marine Inc. vs. Starbuck Kustom Boats & Products Inc., 418 F Supp. 224, 193 USPQ 776)

"The appearance of a design as a whole is primarily determinative of the issue of patentability; a design is to be tested by its 'overall aesthetic effect'. To be patentable, the design viewed as a whole must produce a near upon the eye, and upon the eye of the ordinary or, average observer, not the expert. The degree of difference required to establish novelty occurs when the average observer takes the new design for a different design and not a modified already existing design.

A design is not anticipated merely because some or all of its elements are old, since the essence of design lies in appearance as a whole." (Deller's Walker on Patents, 3rd Ed., Vol. 5, pp. 28-29).

Following the standards or criteria above discussed, the fact that Petitioner may have established prior use of a holder of electric candlelight with a representation of a dragon and a bird which is identical in design as the pair of opposed animal-like figures which merely form part of the design covered by Patent No. D-3399 does not justify the cancellation of the patent. Likewise, the invoices marked Exhibits "A" to "A-8" establish only the sale by Petitioner of candlelight. They could not be considered proof that what were sold were electric candlelights with identical or substantially similar design as that under Patent No. D-3399.

In a petition for cancellation of a design patent, the determinative factor as above stated is identity or substantial similarity of the overall appearance or overall aesthetic effect. Reliance on similarity of only a part or element of the design, or the documentary evidence such as the invoices presented by Petitioner would not suffice.

The filing by Petitioner of another application for registration (Exh. "C") on August 15, 1985 of the "REPRESENTATION OF A DRAGON ATTACHED TO AN ELECTRIC CANDLELIGHT HOLDER" which claims as first use on the goods March 15, 1983 further weakened the case of the Petitioner.

It is noted that the overall design of the pair of electric candlelight holders represented in the drawings (Exh. "C-1") of this later application appear similar to that of the design subject of Patent No. D-3399.

The fact that the trademark application was filed on August 15, 1985 after the filing of Patent No. D-3399 on January 31, 1985 prevents the Petitioner from raising the ground of lack of novelty against the patent.

Furthermore, March 15 1983 (the date of first use claimed in Exhibit "C") was not established convincingly. In fact, Petitioner in claiming March 15, 1983 as the date of first use of the mark "REPRESENTATION OF A DRAGON ATTACHED TO AN ELECTRIC CANDLELIGHT" which is different from the date of first use (March 15, 1982) he claimed in his earlier application for registration for the mark "REPRESENTATION OF A DRAGON" (Exh. "B"), puts in serious doubt his credibility. The allegations of the testimony of Petitioner Bernadette Tsang in her affidavit dated March 10, 1986 clearly suggests that the subject matter of both applications are one and the same so that the claim of first use in both applications should have been the same. Consequently, we will consider only August 15, 1985 – the date of filing of the later application (Exh. "C") – as the date of first use of the mark (Rule 173, Revised Rules of Practice in Trademark Cases). As such, its filing date being earlier, the novelty of Patent No. D-3399 cannot be questioned.

WHEREFORE, the Petition for Cancellation is DISMISSED.

Let the records of this case be forwarded to the Patent/ Trademark Registry & EDP Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director