

VIVIAN UCHIUMI

Opposer,  
- versus -

IPC 14-2004-00013

Opposition to:  
TM Application No. 3-2001-00468  
For Child's Barber Shop Hydraulic Toy Car  
Chair

CINDY CHAN, DOING BUSINESS  
UNDER THE NAEM "CUTS 4 TOTS"  
Respondent-Applicant.

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Decision No. 2006-07

## DECISION

This is an action for patent infringement of Industrial Design Registration No. 3-2001-00498 for "Child's Barbershop Hydraulic Chair" filed by complainant Vivian Uchiumi, of legal age, married, Filipino, with residential address at 1836 Leveriza St., Pasay City against respondent Cindy Chan, of legal age and proprietor of the establishment "Cuts 4 Tots", with business address at 2<sup>nd</sup> Level Gloreitta 2, Makati City.

Complainant alleges that it applied for registration of her industrial design on 31 August 2001 and was issued Design Registration No. 3-2001-00498 for "Child's Barbershop Hydraulic Chair" on 20 May 2003. She further alleges that:

- "5. The Complainant has been using the said Industrial Design even pending application in its establishment "KIDS HAIR SALON" as early as December 1997 with principal business address at LA-108 4<sup>th</sup> Level, Robinson's Galleria main Mall, Ortigas Avenue, Quezon City. It has likewise a branch in Rustan's in Ayala Avenue, Makati City.
- "6. The Respondent started her own business using the Industrial design in the year 2002. Attached is a copy of the Certificate of Business Name Registration from the DTI as Annex "B"
- "7. Sometime in October 2004, the Complainant confirmed and learned that the Respondent was still using her Industrial Design at "CUTS 4 TOTS". The Complainant was able to secure a photograph of the said act herewith attached as Annexes "C" to "E".
- "8. The act of respondent in using the industrial design of the complainant without the latter's consent infringes into her intellectual property rights enunciated in Section 71.1 (a) of the Intellectual Property Code which states that a Patent shall confer on its owner the following exclusive rights:
  - a. "Where the subject matter of a patent is a product, to restrain, prohibit and prevent any unauthorized person or entity from making, using, offering for sale, selling or importing that product;"
9. Further section 76 of the Intellectual Property Code provides that "the making, using, offering for sale, selling, or importing a patented products. Xxx without the authorization of the patentee constitutes patent infringement."
10. The act of the respondent of appropriating the said industrial design without her consent lead to business losses on the part of the complainant.

11. The act of infringement leads the complainant to seek administrative relief and has to hire counsels to protect and assert her intellectual property rights.”

On 25 January 2005, respondent filed its answer and raised the following special and affirmative defenses:

- “1. Complainant has no personality to file the instant Complainant and to seek injunctive relief;
2. Complainant is guilty of forum shopping;
3. The complainant states no cause of action;
4. No irreparable or great injury shall be suffered by the complainant that would justify the issuance of a writ of preliminary injunction.”

Thereafter, hearings were conducted for the purpose determining complainant’s application for a temporary restraining order (TRO). Complainant presented the testimony of two witnesses and offered the following documentary evidence:

EXHIBIT	DESCRIPTION
“A”	Certificate of Registration of Industrial Design No. 3-2001-00498 titled “Child’s Barber Shop Hydraulic Toy Car Chair”
“B”	Certification from the Department of Trade and Industry in Favor of Cuts 4 Tots Hair Salon
“C”	Photograph of a toy car chair with a hydraulic base used a barber shop chair
“D”	Photograph of a toy car chair with a hydraulic base used a barber shop chair.
“E”	Photograph of a toy car chair with a hydraulic base used a barber shop chair.
“F”	Photograph of Child’s Barber Shop Hydraulic Toy Car Chair as used in the complainant’s establishment.
“G”	Affidavit of Liza Ong

Respondent did not submit any evidence in the proceedings for application of a TRO. On 5 August 2005, the Bureau issued Order No. 2005-78 denying complainant’s application for TRO. Further hearings were conducted to determine complainant’s entitlement to the wit of preliminary injunction. Complainant offered additional evidence consisting of:

“H”	Affidavit of Vivian Uchiumi
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For its part, respondent offered the following documentary evidence:

EXHIBIT	DESCRIPTION
“1”	Official Receipt of Roosevelt Bicycle Center No. 30780 in the amount of P 4,150.00
“2”	Official Receipt of Violy Beauty Supply, Inc. No. 003 dated 20 April 2002

- “3” Page 12 of the catalogue of Sallybeauty.com entitled “kiddy Korner”
- “4” Web page printouts showing various styles of a child’s barber seat including designs involving a toy car on top of a hydraulic base
- “5” Page 8 of a catalogue entitled “My First Wheels”
- “6” Judgement in Civil Case No. 03-121 entitled “Vivian O. Uchiumi vs. Cindy Chan”, RTC-Makati, Branch 138
- “7” Job Order of ACL Service Center

On 31 January 2006, Order No. 2005-23 was promulgated denying complainant’s application for the writ of preliminary injunction. Pre-trial Conference was initially set on 10 April 2006. During trial on 9 and 23 August 2006, both counsels manifested that they will be adopting the evidence they have offered during the earlier proceedings and submitted their respective memoranda.

The core of the controversy is whether the use by respondent of “child’s barber shop hydraulic chair” as depicted in evidence shown by complainant constitute an infringement of Industrial Design Registration No. 3-2001-00498 for “Child’s Barbershop Hydraulic Chair”.

It must be borne in mind that the subject matter is an industrial design patent. The Intellectual Property Code defines an industrial design as follows:

“SEC. 112. Definition of Industrial Deign.

An industrial design is any composition of lines or colors or ant 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.”

In *Gorham Co. v. White*, 81 U.S. 511, 14 Wall 511, 20L, Ed. 731 (1872), the U.S. Court explains: “The act of Congress which authorizes the grant of patents for designs were plainly intended to give encouragement to the decorative arts. They contemplate not so much the utility as appearance, and that not an abstract impression, or picture, but an aspect given to those objects mentioned in the acts. It is a new and original design for a butts, statute, bas relief, or composition in alto or basso relievo; a new or original impression or ornament to be placed on any article, anew and original design for printing of woollen, silk, cotton or other fabrics; a new and useful pattern, print or picture, to be either worked into or on, any article of manufacture – it is one or all of these that the law has in view. And the thing invented or produced, for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which it gives form. The law manifestly contemplates that giving certain new and original appearance to a manufactured article may enhance its saleable value and enlarge the demand for it, and may be a meritorious service to the public. It therefore proposes to secure for a limited time to the ingenious produces of those appearances the advantages flowing from them.

In the instant case, industrial design registration secures for the patentee/designer protection for the special appearance he has created for a hydraulic chair. Protection does not extend to the invention of a hydraulic chair per se but the “look” or “façade” of the car manufactured as a hydraulic chair used specially for children in barbershops.

Determining whether a design is infringed requires (1) construction of the patent claim, and (2) comparison of the construed claim to the accused product. *Elmer & HTH v. ICC Fabricating, Inc.* 67 F.3D 1571, 1577, 36 USPQ2d 1417, 1420 (Fed. Cir. 1995).

Respondent points out the object or subject matter of the instant case lack originality. She argues that the equipment have been in existence since 1980's as evidenced by brochures of hydraulic barbershop chairs (Exhibits "3", "4") and emphasize that she has purchased seats from a supplier in the Philippines. (Exhibit "1", "2" and "7").

We do not agree that the novelty of the subject industrial design is negated by these proofs. Exhibit '7' is an M-Benz model hydraulic chair and Exhibits "1" is a receipt for Toyota Ferrari and Rav 4 model which has not been proven to look the same as the patented car design. Neither do any of the pictorial representations of toy cars (Exhibit "4") used as hydraulic barber chairs look exactly like the patented design. On the contrary, respondent's cars used in her shop as it appears in photograph (Exhibits "C", "E" and "F") look similar to the design registered.

Inspite of this, we find that the designs are no longer new because they have been used as early as 1997 in the business of the complainant herself prior to the filing of an application for the design in the 31 August 2001. By its own admission, complainant has been using the said industrial design since 1997. The complaint states:

"5. The Complainant has been using the said Industrial Design even pending application in its establishment "KIDS HAIR SALO" as early as December 1997 with principal business address at LA-108 4<sup>th</sup> Level, Robinson's Galleria Main Mall, Ortigas Avenue, Quezon City. It has likewise a branch in Rustan's in Ayala Avenue, Makati City.

Complainant attempted to clarify the nature of its use of the subject patent in the testimony of Vivian Uchiumi herself. She thus explained in her testimony-affidavit (Exhibit "H") dated 28 September 2005:

- "2. Sometime in 1997, together with my husband Nobuhiko Uchiumi, a Japanese national, came out with an idea of having a child barbershop hydraulic toy car chair barbershops.
- "3. Our first product, together with my sister, Liza Ong, we set up a Kid's Hair Salon wherein we used the said product.
4. Our first model during that time was a hydraulic toy car chair with a base made of wood a top a hydraulic base. We used the said design to test the response of the public to the idea of having a salon barbershop exclusive for kids. It was experimental at that time.
5. It was during the year of 2000 that we made some improvements to the same by making the base more stable and we used steel as the primary element of support to the toy car. And this is the industrial design that I applied for with the IPO sometime in August 2001.
6. The products out of the said Industrial Design was manufactured exclusively for the use of Kid's Hair Salon. I never offered the said product to the public for sale or profit at the time prior to application for an Industrial Design with the IPO. I did not put the said products of the Industrial Design on the market."

The experimental use of an invention can negate any allegation of prior public use that anticipates an invention if it can be shown that such experimentation was for the purpose of bringing the invention to perfection or in preparation for its ultimate or intended purpose.

In *Steven G. Mclough v. Brunswick Corp. D/B/A Mercury Marine* USCA Federal Circuit, 12 June 1996, "A patentee may negate a showing of public use by coming forward with evidence that its use of the invention was experimental. If prima facie case is made of

public use, the patent owner must be able to point to or must come forward with convincing evidence to counter that showing.

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To determine whether a use is “experimental”, a question of law, the totality of circumstances must be considered, including various objective indicia of experimentation surrounding the use, such as the number of prototypes and duration of testing, whether records or progress reports were made concerning the testing, the existence of secrecy agreement between the patentee and the party performing the testing.

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When individual inventors or small business units are involved however, less formal and seemingly casual experiments can be expected, such less formal experiments may be deemed legally sufficient to avoid the public, but only if they demonstrate the presence of the same basic elements that are required to validate any experimental program.

Such manner of experimental use is not obtaining in the instant case. For one, the subject matter of the action is an industrial design. The practical utility of using steel as primary element of support for the car instead of a wooden base is not a part of its industrial design. The essence of a design is to give special appearance to an article of manufacture. It is irrelevant that the experimentation were made for the purpose of strengthening the base. In sum, no iota of evidence indicates any difference or alteration from the original design of the ‘hydraulic toy car’ as applied for and the one used during experimentation on its bases support.

The witness, Liza Ong, confirmed that in 1997, complainants have set up Kid’s Hair Salon to cater to grooming needs of toddlers. Moreover, no evidence was presented by the complainant to prove that the design subject of the industrial design registration in a different design for hydraulic chairs in 1997 used in its establishment Kid’s Hair Salon in December 1997.

In this regard, the Intellectual Property Code law further provides that:

“Sec. 113.1. Only industrial design that are new or original shall be benefit from protection under this Act.

In determining novelty in an industrial design, the following criteria used in inventions are applicable. The law states:

“SEC. 119. Application of Other Sections and Chapters

119.1 The following provisions relating to patents shall apply mutatis mutandis to an industrial design registration:

Sec. 21 – Novelty

Sec. 24 – Prior Art; Provided; That the disclosure is contain in printed documents or in any tangible form.

Sec. 23 Novelty

An invention shall not be considered new if it forms part of a prior art.

Sec. 24 Prior Art

Prior art shall consist of:

24.1. Everything which has been made available to the public anywhere in the world, before 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 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.

“xxx A(an)n inventor’s creation must not have been in public use or on sale in the Unites States and the Philippine island for more than two years prior to his application. Xxx A single instance of public use of the invention by a patentee for more than two years before the date of his application for his patent will be fatal to the validity of the patent when issued. (Angel Vargas v. F.M. Yaptico & Co. (Ltd) G.R. No, 14101, 24 September 1999).

Complainant’s use of the industrial design three years prior to the filing of the application is fatal to its validity. Un view this Bureau’s substantial finding on the invalidity of the Industrial Design Registration No. 3-2001-00498, it is unnecessary to belabour the issue of complainant’s standing to sue or similarity of the respondent’s toy cars with the complainant’s patented design.

WHEREFORE, it appearing the Complainant’s industrial design registration is not novel, Respondent’s use of similar design cannot constitute infringement. Accordingly, the instant complaint filed by complaint is hereby DISMISSED. Consequently, it appearing the Certificate of Industrial Design Registration No. 3-200100498 issued by this Office in 26 May 2003 lacks novelty, the same is hereby ordered CANCELLED.

Let the file wrapper of the design patent subject matter if this instance case together with a copy of this decision be forwarded to the Bureau of Patents for appropriate action.

SO ORDERED

6 November 2006

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