

MARY LOU L. WONG  
Petitioner,

- versus -

CARLOS NGOSIOK  
Respondent

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IPC NO. 12-2005-00040

Petition for Cancellation:  
U.M. Reg. No. 2-2002-000112  
Date Issued: March 27, 2003  
Title: A DOUGH PELLETIZING  
ASSEMBLY FOR MAKING  
BIHON NOODLES

Decision No. 2006-45

## DECISION

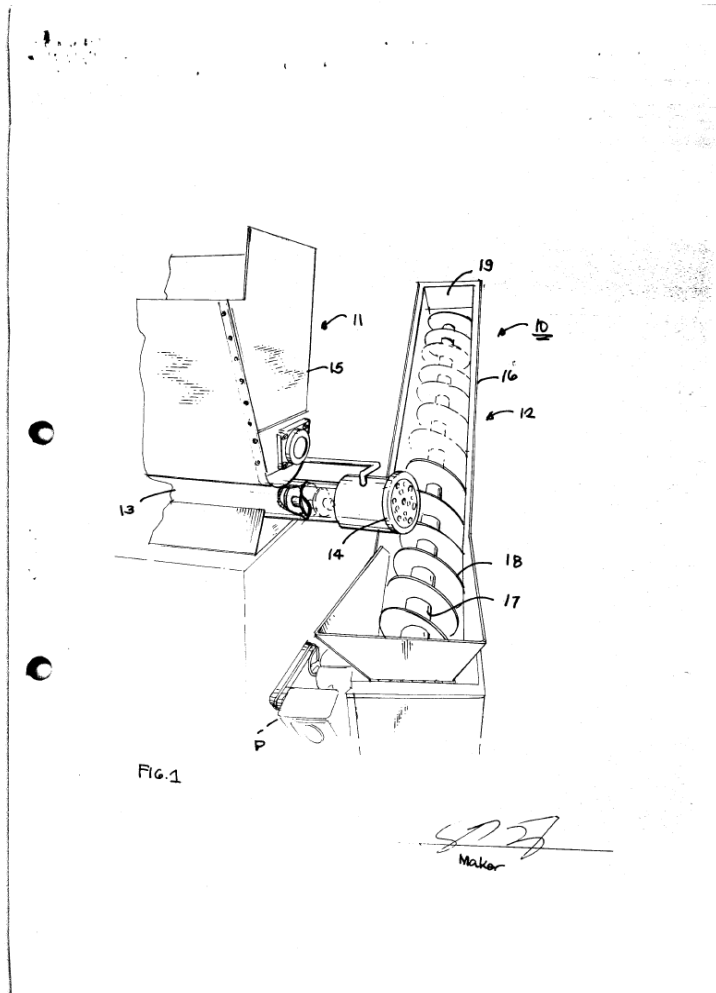
This is a petition to cancel Utility Model Registration No. 2-2002-00112 titled "A DOUGH PELLETIZING ASSEMBLY FOR MAKING BIHON" issued on March 27, 2003 in the name of Carlos Ngosiok as maker and Ngo Siok Marketing as applicant.

Petitioner, Mary Lou L. Wong is a businesswoman presently engaged in the business of buying and selling various noodle products. She buys her noodles from several producers and sell these to her outlets located in various commercial centers in Cagayan, Isabela, Quirino and Nueva Vizcaya. In order to lower the cost of production, it came to her mind the idea of producing noodle products in Isabela. In the course of her study of the said project, she came to know that most of the machines that she will use are covered by patents issued in the name of Respondent, Carlos Ngosiok. She then consulted her lawyer about these patents and after research, she was told that the patents are void. (Exhibit A of Petitioner)

Respondent, Carlos Ngosiok, is the maker of the disputed Utility Model (UM) Registration. He is the Vice-President of Ngosiok Marketing. Respondent filed the application leading to the issuance of the Utility Model Registration on March 15, 2002. Below are the claim and drawing of Respondent's Utility Model Registration No. 2-2002-000112:

### "1 CLAIM:

The construction of a dough palletizing assembly comprising an extruder unit and a pelletizing unit, said extruder unit comprises an extruding chamber having a feed crew powered by a prime mover contained within thereof, a perforated mould disposed at the free end of said feed screw and a feed hopper mounted over said chamber, its outlet port in communication with said feed screw, said pelletizing unit comprising an elevated trough having an opening at its upper end, a shaft rotatably contained within said trough, and a plurality of crushing blades keyed to said shaft, said perforated mould being directed towards the elevated trough of the palletizing unit."



On March 9, 2005, Petitioner, Mary Lou L. Wong, through her lawyer, filed a Petition for Cancellation of Utility Model Registration No. 2-2002-00112 titled "A DOUGH PELLETIZING ASSEMBLY FOR MAKING BIHON NOODLES".

She averred the following grounds for cancellation:

- "a) That the claimed invention does not qualify for registration as a utility model and does not meet the requirements of registrability in particular, having regard to Subsection 109.1 and Sections 22, 23, 24 and 27.
- "b) That the description and the claim do not comply with the prescribed requirements;
- "c) That any drawing which is necessary for the understanding of the invention has not been furnished;
- "d) That the owner of the utility model registration is not the inventor or his successor in title.

Petitioner relied on the following facts to support her petition:

- “a) The utility model registered is very much similar if not identical to the existing models in the market and/or public use at the time the application therefore was filed.
- “b) If ever there are variations between the prior art and the subject utility model, said variations do not involve a technical solution defined in Section 22 of R.A. 8293.
- “c) The description is vague as to the “invention” defined covered by the registration.
- “d) The registrant is not the inventor of the alleged “invention” covered by the registration.

On May 26, 2005, Respondent, through counsel, filed a motion for a bill of particulars alleging that the Petition for Cancellation are not averred with sufficient definiteness or particularity to enable the registrant to intelligently prepare his responsive pleading.

On June 7, 2005, in answer to the bill of particulars, Petitioner through counsel, manifested that one of the models existing in the market and in public use earlier than the year 2002 and identical to the machine covered by the present utility model registration is the one being used by Golden Chua Co. Noodles, Inc. of Cebu City which was the subject of seize and seizure operation by the Respondent after filing of this case, with the qualification that the foregoing should not be considered as a limitation on his part to present other models showing public use thereof prior to March 15, 2002.

On June 27, 2005, Respondent filed its answer denying the grounds for cancellation and alleging the following:

- 1) The UM offers a technical solution to problems existing in the current state of the art at the time of its filing. There are no identical prior art at the time of filing and the UM is industrially applicable.
- 2) The description is enabling, precise, detailed and complete, specifically as to the elements comprising the machine and the relationship between or among the elements as well as the function, operation and result obtained therefrom.
- 3) The drawing of the subject utility model is labeled with particularity, complete and the same could be understood based on the said drawing.
- 4) He is the inventor/maker of the subject utility model. Mr. Ngosiok’s family has been in the business of bihon manufacturing for generations, and utilizing his vast knowledge and experience in noodle making, he introduced substantial innovations and modifications to the equipment and process to achieve a unique bihon product, which no one ever thought of nor has successfully done.
- 5) There are no identical equipment in prior public use at the time of filing, and the innovations and/or improvements made on the existing machines at the time of filing achieved a different result using a different process.
- 6) The description and claims of the subject utility model are quite clear.
- 7) The machine used by Golden Chua Co Noodle Corporation which was the subject of a Writ Search and Seizure issued by the Regional Trial Court of Cebu City, was existing in the market and in public earlier than 2002. The truth being that Golden Chua Co Noodle Corporation did not know of, much less have used the subject

machine with the innovations and improvements introduced by the registrant prior to 2002. It had different version or model of the machine – one without modification and innovation described in the UM.

- 8) The recent commercial success of registrant's product, which led other bihon manufacturers to want to use, albeit illegally, the registrant's innovated process and equipment, is a testimony that long felt but unresolved problems in the field of bihon manufacturing were successfully addressed by the registrant. The registrant's UM substantially changed the bihon product."

On September 1, 2005, Office Order No. 79, series of 2005 or the Amendments to the Regulations on Inter Partes Proceedings prescribing summary rules took effect which mandatorily covers the instant petition. Hence, parties were ordered to submit all its evidence duly marked in compliance with the new rules.

After submission of all the parties evidence, the case was set for preliminary conference on December 12, 2005 to compare documents and clarify certain issues. The conference was terminated on January 20, 2006 after the parties withdrew their request for ocular inspection. Consequently, the parties were ordered to submit their respective position paper which they did and the case is now submitted for decision.

Petitioner in her Memorandum raised the following grounds for cancellation:

- "a) *That Utility Model Registration No. 2-2002-00112 lacks enabling disclosure as required in Section 35 of R.A. 8293;*
- "b) *That Utility Model Registration No. 2-2002-00112 is not a utility model in accordance with Section 21 of R.A. 8293;*

Petitioner argues that the disputed UM cannot achieve the solution it proposes to the problem it recognizes which is:

- a) *That the problem recognized by the Respondent is that the dough is sticky and not fully homogenized and blended*
- b) *That the solution proposed by the maker is to make expelling of excess water contained in the dough easy.*

Engr. Joven Gertes in his Affidavit marked Exhibit "C", testified that the utility model registration in question lacks enabling disclosure as the most important feature of the utility model which is the manner or identification as to where the excess water is to be removed or flowed out of the system was not disclosed. He likewise testified that as can be seen from the specification and drawing of the disputed UM, the input dough enters the system through feed hopper 15, the same dough exits at opening 19. If there is no provision for removal of excess water, then such excess water exit with the dough at opening 19. Consequently, a person skilled in the art in the field of making machines and/or the baker who operated said machine constructed according to this utility model, cannot carry out the process of removal of water by merely reading said specification as written.

He also testified that in addition, the disputed utility model lacks enabling disclosure on the palletizing unit. As described in lines 4 and 5 of the specification, the utility model (UM) assembly 10 comprises of extruder unit 11 and palletizing unit 12. In line 14 of page 2, it was described that said palletizing unit comprises of elevated trough 16. Said elevation of the trough was part of the claim and hence, part of the inventive aspect of the Respondent. However, there is no explanation as to why elevation is needed. There is likewise no disclosure of the manner sufficient and complete for it to be carried out by a person skilled in the art such as a machine

manufacturer and/or baker who use the said machine as the following questions have not been answered:

How high should it be elevated?

Should one end of the trough be elevated in relation to the other end? Does the term elevation means the palletizing unit is elevated in relation to the extruder?

Engr. Geretes contends that the disputed UM is not a utility model as contemplated in Section 21 of RA 293. As mentioned above, the disputed utility model recognizes the problem of excess water in the dough. If there is no provision for removal of excess water then such excess water exits with the dough. Hence, it did not solve the problem of excess water because it does not remove it. Thus, the disputed UM is not registrable.

He further contends that the disputed UM is not a utility model because the desired products being a dough pellet is not achieved. In order to make a pellet, there should be a perforated mould similar to the perforated mould 14 of the disputed utility model. In local parlance, there should be a "molde" to create the shape of the pellet. Without that mould, the resulting product is actually a dough not a pellet. Consequently, the solution of making a pellet as final product cannot be achieved by the disputed UM. Hence, it is not a solution to a problem and not registrable.

Engr. Joven Gertes also pointed out in his Affidavit (Exhibit "C") that after comparing the important elements of the disputed utility model, he found that the important elements in said utility model are also found in the machineries he actually inspected and which are being operated by Komeya Food Corporation marked as Annex D.

In this regard, Ms. Carolyn Medina, General Manager of Komeya Food Products Corporation, another witness for the Petitioner, stated in her Affidavit marked Exhibit "B", that the machineries being used by their company and compared by Engr. Joven Gertes with the utility model under question, were imported by Komeya Food Products Corporation from Fan Seng Engineering Works of Singapore in the middle part of 20012 or before the filing of the disputed UM on March 15, 2002, as shown by the following:

Sales Invoice No. 1455 dated June 4, 2001 of Fan Seng Engineering works of Singapore showing importation of the following machineries:

- 1 Unit – Main Manufacturing Plant with One 4' Outlets 25 HP x 2.
- 1 Unit – Auto Control Vermicelli Dryer, Length 120ft. x 6ft., Height 13ft.
- 1 Unit – Auto Control Electric Cutter & Support, Unit 1 HP.
- 1 Unit – Stainless Steel Conveyor Heating Cabinet Length 70 ft. 4000 pcs. – Aluminum Rod 3/8"x50"

The packing list dated 04 June 2001 covering the same machinery.

Bill of Lading No. MNL 89253-01 dated June 4, 2001 by Express Links Pte. Ltd. Showing that the consignor is Fang Seng Engineering Works of Singapore and that the consignee is Food Product Corporation marked Annex 4.2, Import Entry and Internal Revenue Declaration No. 38954 issued by the Department of Finance, Bureau of Customs with Fan Seng Engineering Works of Singapore consignee (Annex 4.3) the Exporter/Supplier and Komeya Food Product Corporation as Importer/Consignee (Annex 4.4); (Annex 4.3)

Statement of Account 1757 dated April 27, 2001 issued by BCBC Baraso Customs Brokerage Corporation to Komeya Food Product Corporation covering handling and brokerage fee and other expanses to various machineries onboard the vessel AVEIRO 020 marked Annex 4.4;

Sales Invoice 13595 issued by Asian Consolidation International Services to Komeya Food Corporation covering the same shipment, marked as Annex 4.5;

Official Receipt No. BA 792525 dated April 20, 2001 issued by Philippine Ports Authority to Komeya Food Corporation/BCBC Baraso Customs Brokerage Corporation Annex 4.6; all of which are attached to her Affidavit marked as Exhibit B.

Witness Carolyn Medina also submitted copies of six (6) sales invoices showing sales of noodle products manufactured by said machinery since the year 2001 as follows:

- a) Delivery Receipt No. 6686 dated December 7, 2001 issued by Komeya Food Products Corporation to JC Bazaar of San Fernando, La Union. Annex 3.2
- b) Delivery Receipt No. 6687 dated December 7, 2001 issued by Komeya Food Products Corporation to Tony-Rose of San Francisco, La Union. Annex 3.3
- c) Sales Invoice NO. 15491 dated December 12, 2001 issued by Komeya Food Products Corporation to Makro Store 1 of Cainta Rizal. Annex 3.4
- d) Delivery Receipt No. 6689 dated December 7, 2001 issued by Komeya Food Products Corporation to Jelra Supermart of San Fernando, La Union Annex 3.5
- e) Delivery Receipt No. 6703 dated December 8, 2001 issued by Komeya Food Products Corporation to CBN Enterprises of Valenzuela City Annex 3.6
- f) Sales Invoice No. 15487 dated December 12, 2001 issued by Komeya Food Products Corporation to Makro Store 4 of Sucat, Muntinlupa City Annex 3.7

On the other hand, Respondent argues that Petitioner, through her witness, twists the words of the Respondent's utility model by claiming that the Respondent's utility model is supposed to perform "one special task namely easy expelling of excess water", the utility model is invalid for not containing an explanation as to excess water and allegedly does not solve this problem of excess water, that this interpretation is farfetched and only demonstrates that the petitioner's witness is on a fault-finding fishing expedition.

Respondent alleges that his registration will show that expelling water is not the primary function of the utility model; the primary object of the utility model is the mixing and palletizing of the dough so the dough is fully homogenized and not sticky, which activities are explained in detail and disclosed in the description of the utility model registration as discussed above, that this objective is very achievable under this utility model; that the primary purpose of the utility model is to mix and palletize the dough while another purpose is to pelletize the dough into small pieces; that the parameters of a utility model are those stated in its claims; the expelling of excess water is not included in the claim of registrant's utility model. Thus, it is the error for the petitioner to insist that the primary object of this utility model is to expel excess water, that the Petitioner belabors the lack of definition of the word "elevate" in the utility model registration vis-à-vis the trough; that the person skilled in the art is "presumed to have knowledge of all reference that are sufficiently related to one another and to the pertinent art and to have knowledge of all art reasonably pertinent to the particular with which the inventor was involved."

Respondent likewise argues as to the questions of Petitioner that –

How high is the trough; Is one end higher than the other; What is its position relative to the extruder; are not even relevant to the function and purpose of the trough which is defined as a channel, a gutter or a line and that as stated in the utility model registration, the trough is provided to mix and cut the string of dough into small pieces using a plurality of crushing blades keyed to a shaft in the middle of the trough; that it does not matter how elevated it is or what is its inclination because the shaft is connected to the prime mover as stated in the utility model

registration. With the electric power, the dough is cut, mixed and pushed in the direction of the opening at the end of the trough. Nowhere is gravity being used herein. Thus, the extent and nature of the trough being elevated is not pertinent. The only material consideration is that the trough should be able to mix and cut the strings of dough, and this is sufficiently explained in the utility model registration. A discussion of the elevation of the trough is not necessary as this not critical, so long as the dough drops from the perforated mould to the trough; that the innovation introduced by the Respondent is instead of manually transforming the dough mixture into the spherical masses (“bola-bola” and /or pellets, or using a machine that compacted the dough into elongated cake bands; that Respondent made use of an extruding machine (extruder unit) to form minute pellets with a perforated mould disposed horizontally at the free end of the machine and an elevated trough with attached cutter (“crushing”) rotating blades; that the dough mixture passes through the perforated mould to transform into continuous strands of dough, which are then cut, mixed and turned to pellets by rotating blades in the elevated trough.

#### RULING:

Petitioner in her Petition for Cancellation raised all the grounds for cancellation to invalidate the disputed utility model registration. However, in her Memorandum, she discussed the main grounds for the petition for cancellation which are:

- a) WHETHER OR NOT UTILITY MODEL REGISTRATION NO. 2-2002-00112 LACKS ENABLING DISCLOSURE and
- b) THAT THE UTILITY MODEL IS REGISTRATION NO. 2-2002-00112 IS NOT A UTILITY MODEL IN ACCORDANCE WITH SECTION 21 OF R.A. 8293.

Firstly, this Bureau observed that the title of the utility model is – “Dough Pelletizing Assembly for Making Bihon Noodles”. However, instead of the word “pelletizing” as shown in its title, the word “palletizing” consistently appear in the specification and claim which confuses the public reading the same as the word “palletizing” used in the Specification and Claims is quite different from the word “pelletizing” appearing in the title thereof.

The word “palletizing” means to store or move by means of pallet whereas “pelletizing” is the process where the polymer powder is homogenized, addivated and made to pellets”. Axiomatic is the rule that what controls is not the designation of the title but its description in the body. The real nature of a written instrument, which is in this case is the Specification and Claim, is determined not from the title of the written instrument but by the actual recital of facts in the said written instrument.

Likewise, this Bureau notes that although there is nothing in the claim stating that the utility model is for easy removal of excess water in the dough nor in its claim construction, a reading of Registration No. 2-2002-00112 would reveal that the “PALLETIZING” ASSEMBLY which comprises of two distinct units namely, the extrude unit and “palletizing” unite recognizes the problem in the existing prior art and that is –

“Bihon dough are prepared conventionally by hydraulic presses. But due to the credulity of these presses, the dough are sticky and hot fully homogenized and blended.”

Petitioner presented as expert witness, Engr. Joven Gertes who has been a former Patent Examiner of the then Philippine Patent Office which later became the Bureau of Patents, Trademarks and Technology Transfer, now the Intellectual Property Office and who has been performing formal as well as substantive examination of patent applications for invention, utility model and industrial design for thirty five (35) years. This Bureau takes notice of the fact that Engr. Gertes is a registered Mechanical Engineer who is very conversant and knowledgeable with respect to formal and substantive examination of utility models pertaining to machineries & industrial design which he did for more than thirty five years in the Patent Office. Likewise, he

has attended various trainings and seminars in foreign countries on the subject of invention, utility model and industrial design during his employment with the Intellectual Property Office.

This Bureau agrees with the Petitioner's expert witness that as shown in the Specification of the utility model in question, while the primary objective of the utility model is to mix and "palletize" the dough, another objective is to perform one special task namely, easy expelling of excess water in the dough. It states as follows:

"It is therefore the primary object of the present utility model to provide a dough palletizing assembly for making bihon noodles wherein doughs are mixed and palletized before cooking so as the doughs are fully homogenized and not sticky.

"Still another object is to provide a dough palletizing assembly wherein the dough are palletized into small pieces for easy expelling of excess water contained in the dough."

Likewise as shown in the Specification of the utility model in question, the objectives reveal that the palletizing assembly is supposed to perform the task of not only mixing and palletizing the dough but also easily expelling excess water contained in the dough. However, the utility model did not explain at what portion of the assembly is water being expelled. There is likewise no identification where excess water is being flowed out of the system.

Furthermore, as correctly pointed out by Engr. Gertes, there is a reference in the utility model as to an "elevated trough" but there is no mention in the Specification and Claim as to the meaning of the term elevated. There is no disclosure of the utility model in the manner sufficiently clear and complete for it to be carried out by a person skilled in the art as to how high it should be elevated, or, should one end of the trough be elevated in relation to the other end or, does the term elevation mean that the palletizing unit is elevated in relation to the extruder?

In this regard, Sec. 35 of R.A. 8293 explicitly provides that-

"Sec. 35. Disclosure and Description of the invention. – 35.1 Disclosure. – The application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. x x x"

In exchange for a patent, an inventor must be enabling others to practice the invention. The inventor must disclose for the benefit of the public, how to make and use the invention, as provided in Sec. 35 of R.A. 8293.

The policy behind this is that the inventor is rewarded for his or her disclosure of the invention to the public with a right, for a limited time, to exclude others from making, offering for sale, selling, using, and importing the claimed invention. After expiration of the patent, the public has free use of the invention. The failure to provide an enabling disclosure would result in the inventor getting the benefit of the exclusionary right during the term of the patent, but the public not getting the full benefit of free use of the invention thereafter. (ARNOLD B. SILVERMAN, "CLAIM INTERPRETATION UNDER THE DOCTRINE OF CLAIM DIFFERENTIATION", JOM 53 (2) (2001), P. 64)

Specifically, Rule 208.5 of the Rules and Regulations on Utility Model and Design Registrations requires the distinction of what is within the patent system on one hand and what is within the public domain. It provides as follows:

"Rule 208.5. Detailed Description. The detailed description must specifically include a complete description of the manner of making and using the utility model. It must set forth the precise or exact utility model for which the registration is sought, in such a manner as to distinguish the utility model from the prior art it pertains to and the technical problem solved by the utility model should be indicated." (Underscoring provided)



Based on the foregoing, this Bureau finds that the utility model in question did not sufficiently disclose the same in a manner sufficiently clear and complete specifically as to how to easily expel excess water in the dough and the explanation as to the elevated trough so that persons skilled in the art may carry out the utility model. It did not contain a complete description of the manner of making and using the utility model as provided under Rule 208.5 of Rules and Regulations on Utility Model and Industrial Design. Moreover, it did not set forth the precise or exact utility model for which registration is sought, in such a manner as to distinguish the utility model from the prior art it pertains to as well as the technical problem solved by the utility model, hence, the same should be cancelled.

As to the other grounds raised by the Petitioner in her petition, Petitioner's witness, Carolyn Medina, General Manager of Konya Foods Corporation presented pictures of machineries their corporation uses in the manufacture of bihon (Annex 4) which Petitioner's expert witness, Engr. Joven Gertes stated in his Affidavit (Exhibit "C") that he has actually seen in the manufacturing plant of Komeya Food Product Corporation and has compared with the utility model in question. He likewise stated that the machineries of Komeya Food Corporation contain the main elements of the utility model in question as shown by Annex D. As earlier discussed, the machineries of Komeya Food Corporation have been imported from Fan Seng Engineering Works of Singapore (See Annexes "4.0 to 4.6 of Exhibit "B") on June 4, 2001, or long before the utility model of herein Respondent was filed on March 15, 2002 and therefore, no longer novel at the time it was filed, contrary to the provisions of Secs. 23 and 24 of R.A. 8293 which provide as follows:

"SEC. 23. Novelty. – An invention shall not be considered new if it forms part of a prior art. (Sec. 9, R.A. No. 165a)

"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 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 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 inventor identified in both applications are not one and the same. (Sec. 9, R.A. No. 165a)

In view thereof, subject utility model should be cancelled for being contrary to the provisions of Sec. 109 and 109.4 (a) in relation to Sec. 23 and 24 of Republic Act 8293 which provide as follows:

"SEC. 109. Special Provisions Relating to Utility Models. – 109.1 (a) An invention qualifies for registration as a utility model if it is new and Industrially applicable.

109.4. In proceedings under Sections 61 to 64, the utility model registration shall be canceled on the following grounds:

(a) That the claimed invention does not qualify for registration as a utility model and does not meet the requirements of registrability, in particular having regard to Subsection 109.1 and Sections 22, 23, 24 and 27;"

WHEREFORE, in view of all the foregoing, the Petition for Cancellation filed by Petitioner, Mary Lou Wong, is, as it is hereby GRANTED. Consequently, Utility Model Registration No. 2-2002-000112 issued on March 27, 2003 for A DOUGH PELLETTIZING

ASSEMBLY FOR MAKING BIHON NOODLES issued in favor of Respondent, Carlos Ngosiok as maker and Ngosiok Marketing as applicant is, as it is hereby, CANCELLED.

Let the filewrapper of subject utility model "A DOUGH PELLETIZING ASSEMBLY FOR MAKING BIHON NOODLES", subject matter of this case be forwarded to the Bureau of Patents for appropriate action in accordance with this Decision.

SO ORDERED.

City of Makati, 28 June 2006.

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