



VISITA INTERNATIONAL PHILS. INC.,
Petitioner,

-versus-

EDDIE T. DIONISIO and ULTIMATE
EXIM TRADING & DEVELOPMENT CO.,
Respondent-Registrant.

x-----x

IPC No. 12-2009-00133
Cancellation of:
UM Reg. No. 2-2008-000427
Date issued: 25 September 2008
TITLE: "FOLDABLE LADDER"

NOTICE OF DECISION

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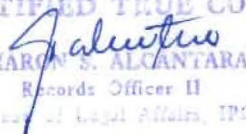
GREETINGS:

Please be informed that Decision No. 2013 – 92 dated May 28, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 28, 2013.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III, Bureau of Legal Affairs

CERTIFIED TRUE COPY

SHARON S. ALCANTARA
Records Officer II
Bureau of Legal Affairs, IPO



VISITA INTERNATIONAL PHILS. INC.,
Petitioner,

IPC No. 12-2009-00133
Case Filed: 14 May 2009

-versus-

Cancellation of:
UM Reg. No. 2-2008-000427
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EDDIE T. DIONISIO and ULTIMATE
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TITLE: "FOLDABLE LADDER"

x-----x Decision No. 2013- 92

DECISION

VISITA INTERNATIONAL PHILS. INC. ("Petitioner")¹ filed on 14 May 2009 a Verified Petition to Cancel Utility Model Registration No. 2-2008-000427. The registration, issued to EDDIE T. DIONISIO ("Respondent-Registrant")², covers the Utility Model "FOLDABLE LADDER".

The Petitioner alleges, among other things the following:

1. Under Republic Act. No. 8293, otherwise known as the Intellectual Property Code of the Philippines, specifically Section 109.4 (Special Provisions Relating to Utility Models), Chapter XII (Registrations of Utility Models), Part II (The Law on Patents), it is stated that a 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; and
 - (d) That the owner of the utility model registration is not the inventor or his successor in title.

The Petitioner's evidence consists of the following:

1. Annex "A" – Packing list of plaintiff company showing that it has imported the foldable ladders from CPS China Production Service Limited

¹ A corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines, with business address at Visita Bldg., 146 Yakal St., Makati City, Philippines.

² Doing business under Ultimate Exim Trading and Development Co. and with address at 63 Celia St., Tinejeros, Malabon City.

- in 2005 even before defendant registered its alleged utility model in September 2008;
2. Annex "B" – Letter dated 06 March 2009;
 3. Annex "C" and "D" – U.S. Patents US4543006, Foldable Multi-Position Ladder joint and US4842098, Adjustable Folding Ladder;
 4. Annex "E" and "F" – Samples of the multi-purpose ladders and its different variations carried by Runva Enterprises Limited and Zhejiang Yongkang Kexun Industry & Trade Co. Ltd.;
 5. Annex "G" – Statement issued by China Fortune Housewares Ltd. Dated 07 May 2009; and
 6. Annex "H" – "H-15" – A copy of a quick search in a commercial website like "Alibaba.com".

On 14 September 2009, the Respondent-Registrant filed his Verified Answer admitting some of the allegations of the Petition but denied all the material allegations thereof and further arguing that the Respondent-Registrant's Utility Model is novel because of an element not found in the cited patents.

The Respondent-Registrant's evidence consists of the affidavit executed by Eddie T. Dionisio dated 14 September 2009.

Should Certificate of Registration No. 2-2008-000422 be cancelled?

Utility Models are issued pursuant to Sections 108 and 109 of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

Sec. 108. Applicability of Provisions Relating to Patents. –
108.1. Subject to Section 109, the provisions governing patents shall apply, *mutatis mutandis* to the registration of utility models.

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.

Corollarily, Section 109.4 (a) of the IP Code provides that in proceedings under Sections 61 and 64, the Utility Model registration shall be cancelled if it does not qualify for registration and does not meet the requirements of registrability, specifically, novelty and industrial applicability.

Section 61. Cancellation of Patents – 61.11 Any interested person may, upon payment of the required fee, Petition to cancel the patent or any claim thereof, or parts of the claim, on any of the following grounds:

- (a) That what is claimed as the invention is not new or patentable;
- (b) That the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by any person skilled in the art; or
- (c) That the patent is contrary to public order or morals.

Rule 4, Sec. 1 of the Inter Partes Regulations, as amended, states that:

At any time during the term of the utility model registration, any person, upon payment of the required fee, may petition the Director to cancel the utility model registration on any of the grounds provided for by law.

Aptly, one of the requirements for the registration of a UM is that it must be new³. To be new or novel means that no prior art exists before the filing date of the application for the registration of the UM. Sec. 24 of the IP Code states that 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 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 inventors identified in both applications are not one and the same.

The Petitioner put into issue the novelty of UM Reg. No. 2-2008-000427 contending that the utility model covered by said registration is not new since it already forms part of a prior art. The Petitioner alleges that the Respondent-Registrant is merely an importer of the folder ladders from the People's Republic of China and his Utility Model is actually based on two US Patents⁴.

³ Sec. 109.1 (a) of the IP Code; Rule 200 of the Rules and Regulations on Utility Models and Industrial Design.

⁴ Annexes "C" and "D".

1. US Patent No. 4842098
 Filed On : 29 October 1987
 Date of Patent: 27 June 1989
 Description : Adjustable Folding Ladder
 Inventor : Haison Yuen (Taiwan)

2. US Patent No. 4543006
 Filed On : 16 November 1984
 Date of Patent: 24 September 1985
 Description : Foldable Multi-Position Joint Ladder
 Inventor : Chien-Yuan (Taiwan)

The subject Utility Model for a foldable ladder is substantially similar to the adjustable folding ladder as claimed in the prior art represented by US Patent No. 4,842,098 issued on 27 June 1989 to Haison Yuen. All the essential elements of the folding ladder in the subject Utility Model Patent are present in the ladder claimed in the said prior art US Patent.

A comparative summary of the essential elements of the subject Utility Model and the prior art is shown in the following table below:

Elements in the US Patent No. 4,842,098	Subject UM
Foldable Sections	present
A pair of spaced apart uprights longitudinal poles	present
A plurality of rungs Transverse bars	present
Lockable hinge	present

Both foldable ladders, the subject Utility Model and the Prior Art, US Patent No. 4,842,098 are consisting of plurality of sections, each sections are formed by spaced apart upright (2)/ (longitudinal poles 12, 13) and spaced apart rungs (3)/ (transverse bars 14). Each of the sections is interconnected by means of a lockable hinge (15) to allow the sections to be foldable and adjustable with respect to each other. Furthermore, the substantially similar arrangement and interconnection of all the essential elements of both ladders, the subject Utility Model and the Prior Art allows the ladders to be adjusted and folded in same manner resulting to the shapes shown in the drawings of both patents.

The drawings of the Subject Utility Model:

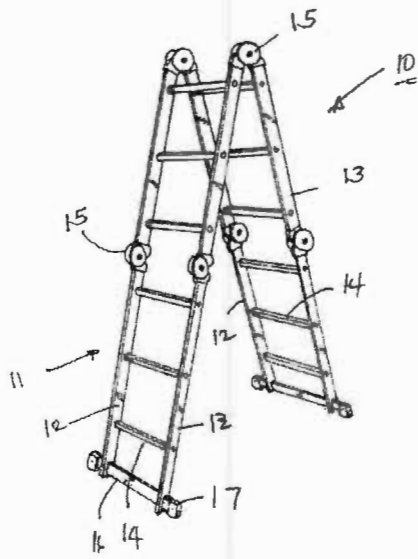


Figure 1

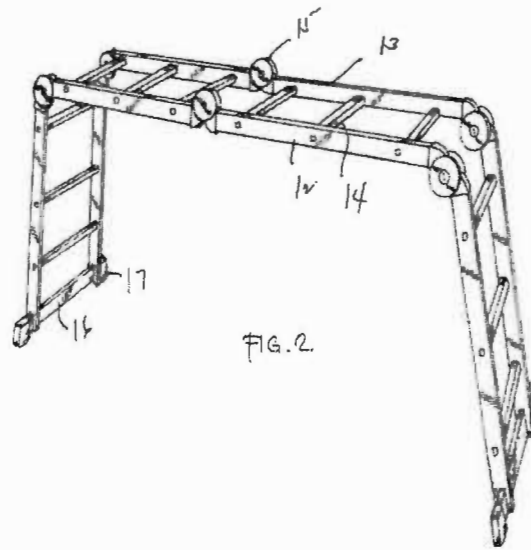


Figure 2

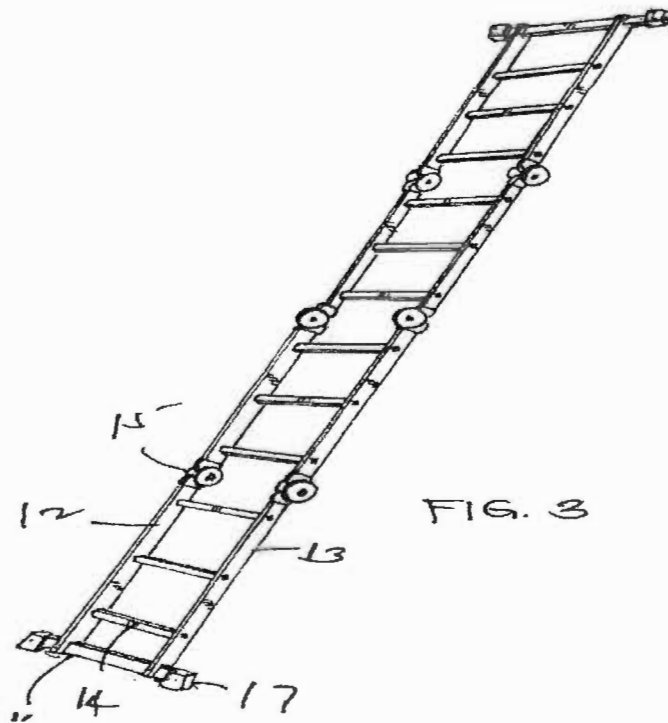


Figure 3

The drawings of the US Patent 4,842,098 and/or the prior art.

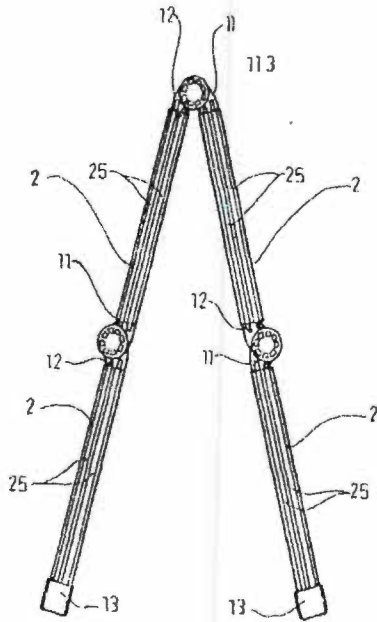


Figure 16

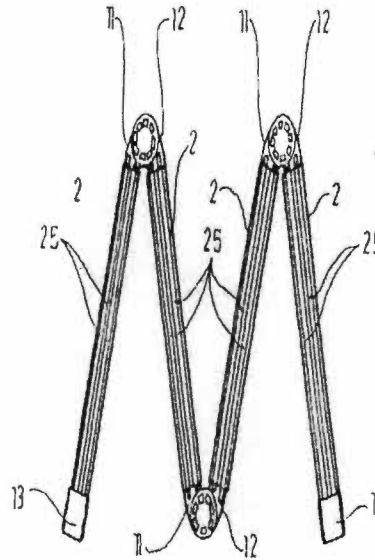


Figure 15

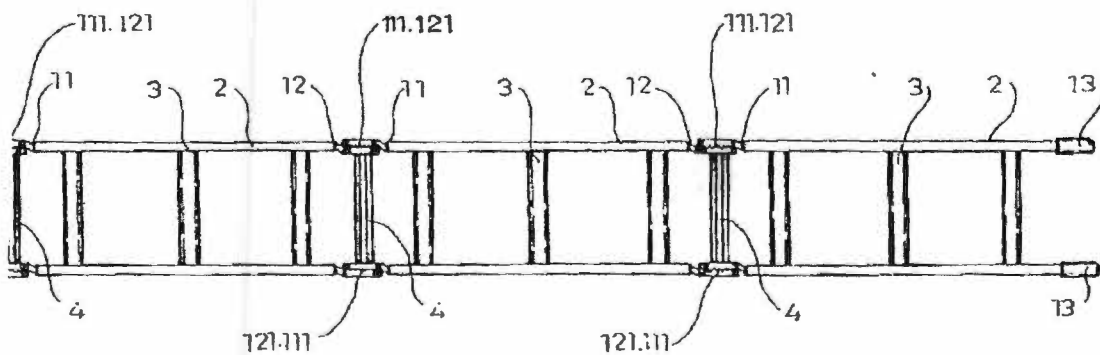


Figure 17

A thorough evaluation of the claims of the cited US Patent No. 4,842,098 and the claims of the Respondent-Registrant Utility Model show that the Respondent-Registrant includes every element as recited in the cited US Patent.

All elements of an assailed patent as a whole must be found in a single prior art reference.

Aptly, in determining whether a patent has been anticipated by a prior art reference, the claim of the said patent must read or include every element in the prior art reference. In other words, each and every element of the claimed invention must be disclosed in a prior art reference⁵.

Considering therefore that US Patent No. 4,842,098 has been made available to the public before the filing date of the Respondent-Registrant's Utility Model Patent, it constitutes an anticipation of the latter or the Respondent-Registrant's Utility Model Patent.

Accordingly, this Bureau finds that the Respondent-Registrant's Utility Model Patent No. 2-2008-000427 should be cancelled for lack of novelty.

WHEREFORE, premises considered the instant Petition for Cancellation is hereby **GRANTED**. Let the filewrapper of Utility Model Patent No. 2-2008-000427 be returned, together with a copy of this Decision, to the Bureau of Patents for information and appropriate action.

SO ORDERED.

Taguig City, 28 May 2013.


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

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⁵ See *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F. 2d 1540, 220 USPQ 303, Fed. Cir. 1983, LEXIS 13701.