



ROAD FIT SERVICE Q. C. CORPORATION,
Petitioner,

IPC No. 12-2011-00166
Petition for Cancellation:
Registration No. 2-2009-000399
Issued on: 7 December 2009
TM: "IMPROVED CAR COVER"

-versus-

ALBERTO S. GO,
Respondent-Registrant.

X-----X

NOTICE OF DECISION

SANDIEGO LAW OFFICE

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ALBERTO S. GO

Respondent-Registrant
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GREETINGS:

Please be informed that Decision No. 2014 - 243 dated October 07, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 07, 2014.

For the Director:

Edwin O. Dating
Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs

“3.05 The examination and recommendation for registration and publication of Application No. 2-2009-000399 were done pursuant to Rule 211 and 314 of the Implementing Rules and Regulations for Utility Models and Industrial Designs as per Office Order No. 61, Series of 2001. Corollary to the approval for publication of the subject application, Respondent-Registrant received a Notice of Recommendation for Registration with a stamped mailing date on 4 December 2009.

“3.06 The distinguishing feature of the latest Utility Model Registration No. 2-2009-000399, of Respondent-Registrant is the inclusion of claim 4, among others, which claimed a feature not found in the previous Utility Model of the same respondent, Alberto S. Go, stating thus:

‘A car cover as in claim 1 wherein each parts of the car cover are joined by double stitches’.

“3.07 The inclusion of double stitches is an improvement to the previous Utility Model of Respondent-Registrant and the Utility Model Application having complied with the requisites under Chapter XII of R.A. 8293, it is only proper that the latest IMPROVED CAR COVER be accorded registration.

“3.08 Pertinent to this case is Section 109.4 where it provided that grounds for cancellation, thus:

‘109.4. In proceedings under Section 61 to 64, the utility model registration shall be cancelled on the following grounds:

- (a) That the claimed invention does not qualify for registration as 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 claims 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.

“3.09 The added double stitches feature in Respondent-Registrant latest Utility Model Registration is new and not existing in any manufactured car cover before the filing date, hence it is novel and is absolutely distinguishable compared to the previous Utility Model Registration of Respondent-Registrant contrary to what is being claimed by Petitioner or its lone witness. Considering that the parts of the car cover are joined by double stitches and this feature is new to the market or to any car cover manufacturer, it does not form part of prior art pursuant to Section 24 of R.A. 8293.”

The Respondent-Registrant’s evidence consists of the following:

1. Copy of Recommendation for Registration dated 22 October 2009;
2. Copy of Registration No. 2-2009-000399 issued on 7 December 2009; and

3. Copy of Registration No. 2-2002-000447 issued on 27 June 2006.⁴

The Hearing Officer issued on 31 May 2012 a notice setting the Preliminary Conference on 16 July 2012. During the Preliminary Conference, the Hearing Officer directed the Respondent-Registrant to file his position paper. On 7 September 2012, Order No. 2012-1189 was issued declaring the Petitioner to have waived its right to file a position paper for its failure to attend the preliminary conference. Respondent-Registrant filed his position paper on 26 July 2012.

Should the Respondent-Registrant's utility model registration be cancelled?

Sec. 61 of Republic Act 8293, also known as the Intellectual Property Code of the Philippines (IP Code) provides that a patent may be cancelled, if the patent is no longer new. The IP Codes states:

Section 61. *Cancellation of Patents.* - 61.1. 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

In determining whether an invention is new or novel, the invention must not form part of prior art. The pertinent provisions of the IP Code states:

Section 23. *Novelty.* . - An invention shall not be considered new if it forms part of a prior art.

Section 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 the inventor identified in both applications are not one and the same.

The provisions of the law on patentability and novelty of patents shall likewise apply to utility models which is the subject matter of this instant case. The law provides:

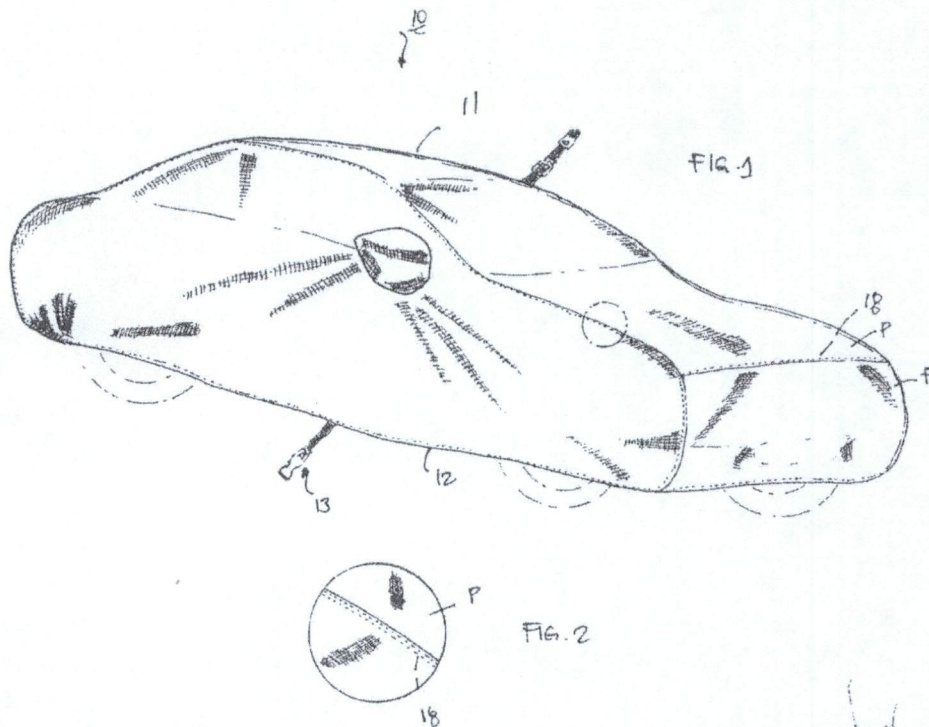
Sec. 108. *Applicability of Provisions Relating to Patents.* - 108.1. Subject to Section 109, the provisions governing patents shall apply, mutatis mutandis, to the registration of utility models.

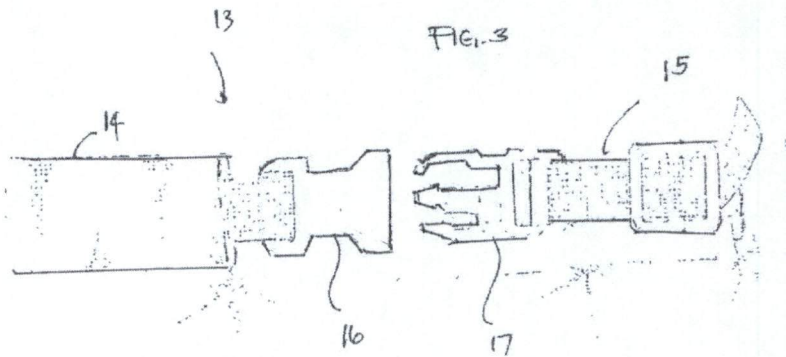
The utility model registration being challenged is an "improved car cover" consisting of the following claims:

⁴ Exhibits "A" to "C"

1. An improve car cover comprising a shroud made from fabric, the lower edge of the shroud having a garter provided thereon, characterized in that a locking means is provided on the said lower edges defined by opposing straps having locking members provided thereon adapted to lock with each other.
2. A car cover as in claim 1 wherein the locking members are male and female buckle members.
3. A car cover as in claim 1 wherein the locking members are Velcro tapes.
4. A car cover as in claim 1 wherein each parts of the car cover are joined by double stitches.

The drawings of the questioned Utility Model (UM) Registration No. 2-2009-000399⁵ consists of three figures, as shown below:



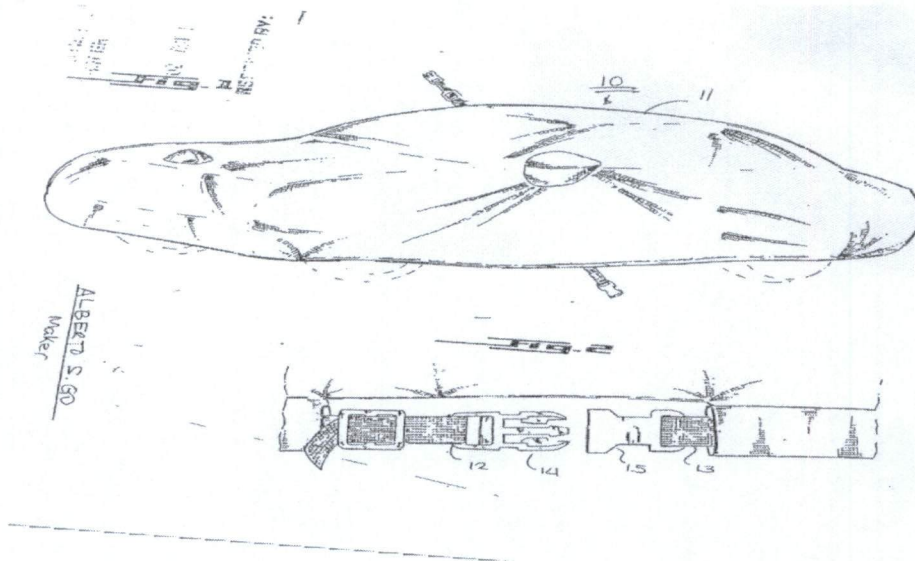


The evidence show that the Respondent-Registrant has applied for an earlier Utility Model Registration No. 2-2002-000447 which was issued on 27 June 2006 entitled "An Improved Car Cover" which claims the following:

1 Claim

In the construction of an improved car cover comprising a shroud made of water impermeable material, the improvement comprising of opposing adjustable strap extend from the traverse peripheral edge of said shroud, and male and female locking members, preferably male and female buckles, extending from said straps.

The drawings of the previous Utility Model (UM) Registration No. 2-2002-000447⁶ consist of two figures, as shown below:



Clearly, as depicted in the drawings, the questioned registration contains all the characteristics of the Respondent-Registrant's previous UM registration 2-2002-000447. Thus, UM registration 2-2002-000447 is considered a prior art with respect to UM registration 2-2009-000399.

In particular, both registrations have the same essential elements described in the abstract of UM registration 2-2002-000447 and claim 1 of UM registration 2-2009-000399. Both drawings refer to the car cover as element 10 in figure 1; the shroud as element 11 and the locking means with opposing straps as Figure 3. A cursory inspection of both drawings show that they are strikingly similar, if not identical and practically the same.

The Specifications similarly described the car cover in line 18 page 2 of the challenged registration and line 6 page 3 of the previous registration. The shroud is described on page 2, line 18 of the questioned registration and page 3 line 18 of the prior registration. Similarly, the material of the shroud is the same, general fabric material while the other is of impermeable material, not particularly described, which protects against heat, dust, rain.

Further, the challenged registration describes a garterized lining of the lower edge of the shroud. In the same specification, the Respondent-Registrant admits that a garter is a common element⁷ in most car covers. The garter was also described in the prior art and found in line 9, page 3. The element of a garterized shroud is not novel, being part of prior art because it is described before the wording "characterized in that", as analysed according to Jepson type claims. Jepson type claims are explained as follows:

Jepson claims are a special type of claim which are most often used when the invention is an improvement on an existing product. Here is claim 1, written as a single Jepson-style claim:

7. An improved motor vehicle for transporting people and objects, of the type having a chassis and a body mounted on the chassis, a plurality of wheels under the body, supporting the chassis, a transmission mounted on the chassis and coupled to at least one of the plurality of wheels, a motor mounted on the chassis having a fluid input and an output coupled to the transmission, and fluid supply mounted within the body and coupled to the fluid input, in which the improvement comprises:

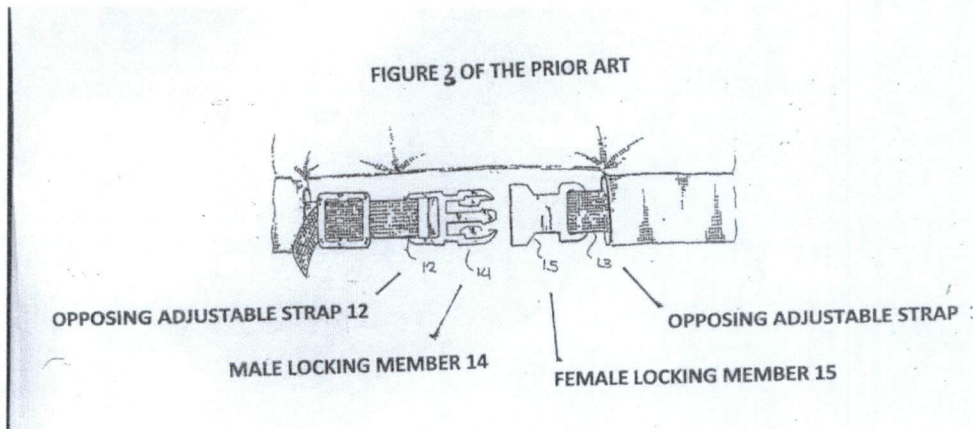
the fluid supply being coupled to the fluid input of the motor by a portoflan armature coupled to the fluid supply, a gronk tube coupled to the fluid input of the motor; and a variable orifice between the portoflan armature and the gronk tube..

In the "ordinary" claim form of claim 1, above, the body of the claim lists elements which are both old and new. In this form, everything before the "in which the improvement comprises" is admitted to be prior art for the purposes of this claim, and everything after the phrase are considered to be the novel elements of the invention. Although this kind of claim is not often used in US practice, it can be very effective in separating the old and new parts of an invention.

⁷ Line 12, page 1 of Specification – UM Reg. No. 2-2009-000399 (Exhibit "A")

This style of claim is the preferred form in European practice, where they are called "two-part format" claims, and the transitional phrase is "characterised by..." or "characterised in that..."⁸

Moreover, in the questioned registration, the improvement consists of a locking mechanism defined by opposing straps. This feature is the same locking mechanism described on line 10 of page 3 of the previous registration. A comparison of the drawing of the previous registration, as culled from affidavit of the Petitioner's witness, as reproduced below, bears no difference with figure 3 of the present registration.



As regards to the rest of the claims referring to the preferably male and female buckle as locking members, use of Velcro and the double stitch, which the Respondent-Registrant emphasized to be new and non-existing in previous car covers, are for all intents, substantially included and are merely equivalents of the art described in the earlier utility model. The Supreme Court explained the doctrine of equivalents in the case of *Godines v. Court of Appeals*, to wit:

An infringement also occurs when a device appropriates a prior invention by incorporating its innovative concept, and albeit with some modifications and change, performs substantially the same function in substantially the same way to achieve the same result.⁹

The improvements in the present utility model are essentially the same, lacking novelty or precedence that merits a new registration. In the case of *Angelita Manzano v. Court of Appeals*, the Supreme Court held:

The element of novelty is an essential requisite of the patentability of an invention or discovery. If a device or process has been known or used by others prior to its invention or discovery by the applicant, an application for a patent therefor should be denied; and if the application has been granted, the court, in a judicial proceeding in which the validity of the patent is drawn in question,

⁸ Brown & Michaels, *How to Read A Patent*, 2004-2014 accessed at www.bmplegal.com/howtopat5.html
⁹ G. R. No. 97343, 13 September 1993


will hold it void and ineffective. It has been repeatedly held that an invention must possess the essential elements of novelty, originality and precedence, and for the patentee to be entitled to the protection the invention must be new to the world.

Hence, a utility model shall not be considered "new" if before the application for a patent it has been publicly known or publicly used in this country or has been described in a printed publication or publications circulated within the country, or if it is substantially similar to any other utility model so known, used or described within the country.¹⁰

WHEREFORE, premises considered, the Petition for Cancellation is, as it is hereby GRANTED. Let the file wrapper of Utility Model Registration No. 2-2009-000399 together with a copy of the DECISION be returned to the Bureau of Patents (BOP) for appropriate action.

SO ORDERED.

Taguig City, 7 October 2014.


NATHANIEL S. AREVALO
Director
Bureau of Legal Affairs

¹⁰ G.R. No. 113388 September 5, 1997