



PRIMAL ENTERPRISE CORPORATION,
Petitioner,

-versus-

CHESTER UYCO,
Respondent-Registrant.

}
} **IPC No. 13-2011-00381**
} Petition for Cancellation of Design:
} Reg. No. 3-2010-000523
} Issued on: 8 November 2010
} Title: **"VEHICLE PLATE NUMBER**
} **COVER"**
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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 95 dated May 14, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 14, 2015.

For the Director:


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



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IPC No. 13-2011-00381

Petition for Cancellation of Design:
Reg. No. 3-2010-000523
Issued on: 8 November 2010

Title: **“VEHICLE PLATE NUMBER
COVER”**

Decision No. 2015- 95

DECISION

PRIMAL ENTERPRISE CORPORATION (“Petitioner”)¹ seeks the cancellation of Industrial Design Reg. No. 3-2010-000523. The registration, issued to **CHESTER UYCO** (“Respondent-Registrant”)², covers the design for vehicle plate number cover.

The Petitioner alleges, among other things, that the subject of Design Reg. No. 3-2010-000523 is practically the same vehicle plate number cover described in the earlier Design Reg. No. 3-1999-00001 issued to Jessie Ching and Joseph Yu on 22 May 2002. To support its petition, the Petitioner submitted the Affidavit of Charlie C. Tiu dated 7 July 2011, copy of Design Reg. No. 3-2010-000523, copy of Design Reg. No. 3-1999-00001 (for “Vehicle Plate Number Cover”).³

In his Answer, the Respondent-Registrant alleges among other things that Design Reg. No. 3-2010-000523 was issued as the design was found out by the Bureau of Patents to be in compliance with the provisions of Rep. Act No.8293, also known as the Intellectual Property Code of the Philippines (“IP Code”) and the implementing rules and regulations on Patents. According to the Respondent-Registrant, his design is new and useful and not identical or even practically the same as the design covered by Design Reg. No. 3-1999-00001. He also claims that the Registrability Report issued by the Bureau of Patents shows that the design is new and not anticipated by any relevant prior art. To support his defense, the Respondent-Registrant submitted a copy of Design Reg. No. 3-2010-000523 and the pertinent Registrability Report and the Respondent-Registrant’s Affidavit.⁴

Should the Respondent’s Industrial Design Registration No. 3-2010-000523 be cancelled?

Sec. 120 of the IP Code provides:

Section 120. Cancellation of Design Registration. – 120.1. At anytime during the term of the industrial design registration, any person upon payment of the required fee, may

¹A corporation organized and existing under Philippine laws with address at #8 Miller Street, Barangay Bungad, San Francisco Del Monte, Quezon City.

²Filipino with business address at 4907 Enrique St. Palanan, Makati City

³Marked as Exhibits “A” to “C”.

⁴Marked as Exhibits “1” to “3”.

petition the Director of Legal Affairs to cancel the industrial design on any of the following grounds:

- (a) If the subject matter of the industrial design is not registrable within the terms of Sections 112 and 113;
- (b) If the subject matter is not new; or
- (c) If the subject matter of the industrial design extends beyond the content of the application as originally filed.

The instant petition is anchored on the argument that the design covered by Design Reg. No. 3-2010-000523 is not novel. In this regard, the IP Code defines industrial design, to wit:

Sec. 112. Definition of Industrial Design.- An industrial design is any composition of lines or colors or any 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.

and as a requisite for registration:

Sec. 113. Substantive Conditions for Protection.- 113.1 Only industrial designs that are new or original shall benefit from protection under this Act.

The designs covered by Reg. Nos. 3-2010-000523 and 3-1999-00001 are reproduced below for comparison:

FIGURE 1 OF UYCO'S DESIGN

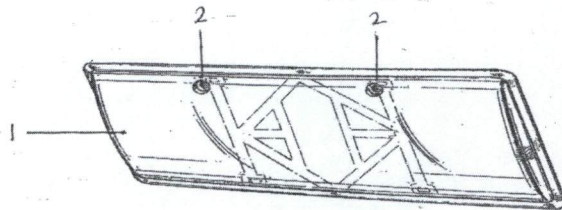
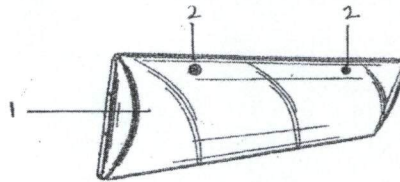


FIGURE 1 OF CHING'S DESIGN

While it is true that in the Registrability Report⁵, Reg. No. 3-1999-00001 was cited as "*Category A (Document defining the general state of the art which is not considered to be of practical relevance)*", it

⁵ Exhibit "2"

does not mean that the Respondent-Registrant's design is conclusively novel. In fact, the same Registrability Report contains a disclaimer that "*All of the above listed information is based on documents available in our Office at the time this report was made but not precluding other submission of information that may result to a different finding*". The Petitioner pointed out that in Inter Partes Case No. 3420, entitled Hanabishi Philippines, Inc. v. Segundo Ng and 3D Industries, Inc. (12 November 1991), it was held that "*It is well settled that patentability of a design can not be based on elements which are concealed in the normal use of the device to which the design is applied.*"

There is no doubt that in the eyes of an observer, the Respondent-Registrant's design is practically a copy of the design covered by Design Reg. No. 3-1999-00001. Both have a rectangular mounting frame with two visible screw holes on the upper portion, and a bulging or convex transparent cover. The only difference between the Respondent-Registrant's design and that covered by Design Reg. No. 3-1999-00001 is the latter's back plate design consisting of hexagonal rib bridging posts. However, the back plate is hidden from view. The definition of an industrial design implies that such design must be visible in relation to its normal use or purpose. When a plate is used according to its purpose, there is no way one can see the "back plate design". What can be seen and appreciated is the front design. In this instant, when two vehicles are placed side by side, one car with its plate covered by the design under 3-2010-000523 and the other car with the design Reg. No. 3-1999-00001, an observer can easily conclude that the designs are one and the same. In fact, all the elements in the Respondent-Registrant's design can be found in the design covered by Design Reg. No. 3-1999-00001.

Succinctly, Sec. 24.2 of the IP Code adopted the definition of the mark under the old Law on Trademarks (Rep. Act No. 166), to wit:

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

WHEREFORE, premises considered the Petition for Cancellation is hereby **GRANTED**. Let the filewrapper of Design Registration No. 3-2010-000523 be returned, together with a copy of this Decision to the Bureau of Patents for information and appropriate action.

SO ORDERED.

Taguig City, 14 May 2015.


Atty. **NATHANIEL S. AREVALO**
Director IV, Bureau of Legal Affairs