



PRIMAL ENTERPRISE CORPORATION,
Petitioner,

-versus-

CHESTER UYCO,
Respondent-Registrant.

}
} **IPC No. 13-2011-00380**
} **Petition for Cancellation of Design:**
} **Reg. No. 3-2010-000524**
} **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 - 81 dated May 05, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 05, 2015.

For the Director:


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



PRIMAL ENTERPRISE CORPORATION,
Petitioner,

IPC Case No. 13-2011-00380
Petition for Cancellation of Design:
Reg. No. 3-2010-000524
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-versus-

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

CHESTER UYCO,
Respondent-Registrant.

X-----X

Decision No. 2015- 81

DECISION

PRIMAL ENTERPRISE CORPORATION (“Petitioner”)¹ seeks the cancellation of Industrial Design Reg. No. 3-2010-000524. 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 the Design Reg. No. 3-2010-000524 is practically the same vehicle plate number cover described in the earlier Design Reg. No. 3-2006-00019. To support its petition, the Petitioner submitted the Affidavit of Charlie C. Tiu dated 7 July 2011, copy of Design Reg. No. 3-2006-000019 (for “Car Plate Cover Assembly”), copy of Design Reg. No. 3-2010-000524; and comparative analysis of the parties’ respective industrial designs³.

The Respondent-Registrant filed his Answer on 8 February 2012, alleging among other things, the following:

“8. As shown in Exhibit ‘1’, (Industrial Design Registration No. 3-2010-000524) it was issued to respondent after his industrial design of a vehicle plate number cover was found out by the Bureau of Patents to be in compliance with the provisions of the IP Code and the Implementing Rules and Regulations on Patents, etc.

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 “D”.

"9. Respondent's industrial design of a vehicle number plate cover is new and useful and not identical, nor even 'practical the same' as the industrial design of a vehicle plate number cover subject of Industrial Design Registration No. 3-2006-00019 (Exhibit 'B')

Attached as Exhibit '2' and made an integral part hereof is the Registrability Report on respondent's Industrial Design Registration No. 3-2010-000524 issued last January 10, 2012 by the Bureau of Patents showing that the industrial design subject thereof is new and not anticipated by any relevant prior art.

"10. Indeed, a comparison of the drawings showing the industrial design of the vehicle plate number cover subject of respondent's Industrial Design No. 3-2010-000524 (Exhibit '1') with the drawings forming part of Industrial Design Registration No. 3-2006-00019 (Exhibit 'C'), will readily show last the two industrial designs are distinctly different and not identical to, 'nor practical the same' with, each other."

Should the Respondent's Industrial Design Registration No. 3-2010-000524 be cancelled?

Sec. 120 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("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 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. 3-2010-000524 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. 3-2010-000524 and 3-2006-000019 are reproduced below for comparison:

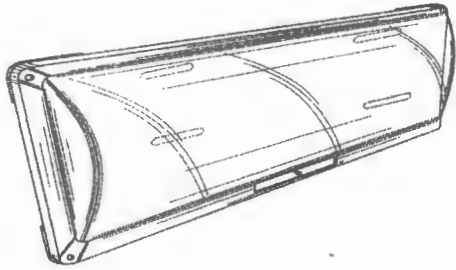


Fig. 1

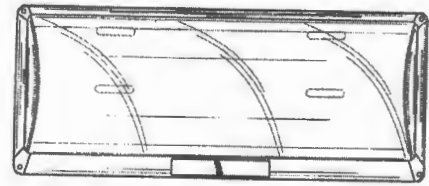


Fig. 2



Fig. 3



Fig. 4



Fig. 5

Reg. No. 3-2010-000524

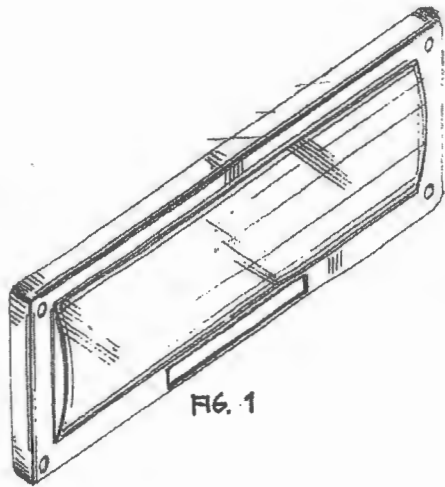


FIG. 1

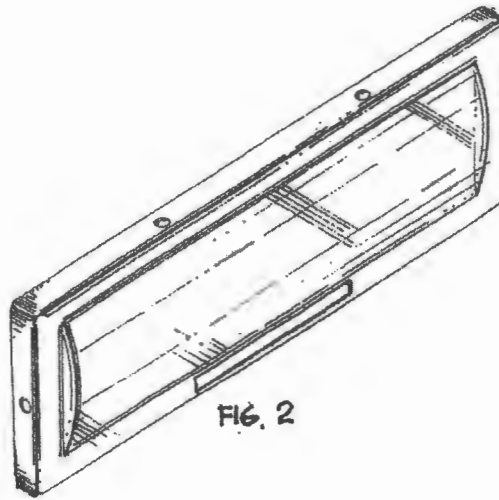


FIG. 2

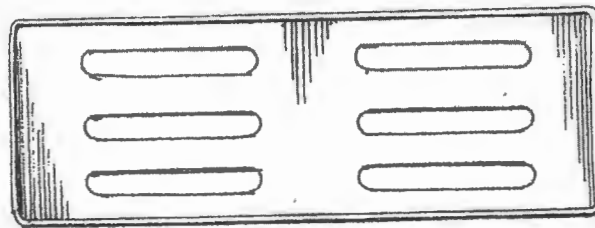


FIG. 3

Registration No. 3-2006-000019⁴

In the instant case, both designs are characterized by a convex cover, screw holes, rectangular frames and a name plate. The comparative analysis⁵ of the Petitioner illustrates these points of similarity, to wit:

⁴ Exhibit "B"

⁵ Exhibit "D"

Handwritten signature or initials in blue ink, located in the bottom right corner of the page.

EXHIBIT "D"
COMPARATIVE ANALYSIS

LEGEND:

- 3- CONCAVE COVER
- 2- SCREW HOLES
- 1- RECTANGULAR FRAME
- 4- NAMEPLATE

FIGURE 2 OF LYCO'S DESIGN



FIGURE 3 OF PRIMAL'S DESIGN

In addition, the Petitioner also raised the similarity in the "back plates"⁶, to wit:

EXHIBIT "E"
COMPARATIVE ANALYSIS

LEGEND:

- 1- BACK PLATE
- 2- OBLONG DESIGN

FIGURE 3 OF LYCO'S DESIGN

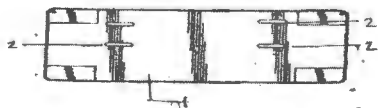


FIGURE 5 OF PRIMAL'S DESIGN

In sum, the Petitioner has established a majority of points of similarity between the designs:

1. the number and locations of the screw holes;
2. rectangular frames;
3. the location of the name plate at the central lower portion; and
4. the convex transparent cover.

While it is true that the Respondent submitted a registrability report⁷, where Reg. No. 3-2006-000019 dated 28 July 2008 was cited as "Category A (Document defining the general state of the art

⁶ Exhibit "E"

which is not considered to be of practical relevance)", it does not mean that the Respondent-Registrant's design is conclusively novel. In fact, the 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." Significantly, 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:

24.2 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 differences as regards the "back plates" of the designs are inconsequential considering that these are hidden from view when the parts of the cover plate are joined together. 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.*"

Corollarily, this Bureau noticed that the frame in the Respondent-Registrant's design differs from the frame in the design cited by the Petitioner as prior art. In Design No. 3-2006-000019, the frame is flat in contrast with that of in the Respondent-Registrant's design where the supporting frame followed the curvature of the transparent material/cover. Nevertheless, this difference is no moment as the overall appearance of the plates is essentially the same. This Bureau finds merit in the Petitioner's citation/memorandum of authorities, thus:

"5.4. In the book *DESIGN: Modern Law and practice* by A.I. Morrison (LLB(Hons) and Barry Quest MA European Patent Attorney, 1987:

New or original does not really mean different. Degree of novelty was considered in *Le May v. Welch (1884) 28 ChD 24 at 34* in relation to a design for a collar and it was observed:

It is not every mere difference of cut, every change of outline, every change of length or breadth, or configuration, in a simple most familiar article of dresslike this which constitute novelty of design. To hold that would be to paralyze industry and to make the Patents, Designs and Trademark Act a trap to catch honest traders. It cannot be said that there is a new design everytime a coat or a waist coat is made with a different slope, a different number of buttons. Tailoring would become impossible if such were the law and it does not appear to me that such is the law. There must not be a mere outline of novelty but a substantial novelty in the design having regard to the nature of the article.

Novelty in combination of known features was considered in relation to a show heel in *Philips v. Harbour Rubber Co (36 RPC 79, CA)* and it was observed by the master of the rolls:

⁷ Exhibit "2"

In my opinion, it is not open to a manufacturer to take one or more leading features of different goods already on the market and by registering a design showing merely a combination of those features and without any real mental activity being required for its production acquire copyright in a registered design.


In reflection of the principles established by the case such as the *Le May vs. Welch* and *Philips vs. Harbo*, the present act exclude from registered designs which differ in 'immaterial details' or in features which are variants commonly used in the trade from prior designs (s1(2)). The exclusion form registrability of 'trade variants' notably in the *Philips v. Harbo* case, and it was observed:

The introduction of ordinary variants into an old design cannot make it new or original. For example, it is common practice to have or not to have spikes in the soles of running shoes a man does not make a new and original design out of an old type of running shoes by putting spikes under the soles. The working world as well as the trade world is entitled at its will to take all cases its choice of ordinary variants and use in any particular instance and no patent or no registration of a design can prevent an ordinary workman from using or not using trade knowledge of this kind.

WHEREFORE, premises considered the Petition for Cancellation is hereby **GRANTED**. Let the filewrapper of Design Registration No. 3-2010-000524 be returned, together with a copy of this Decision to the Bureau of Patents for information and appropriate action.

SO ORDERED.

Taguig City, 05 May 2015.


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