



**PRIMAL ENTERPRISES CORPORATION,**  
Petitioner,

**-versus-**

**CHESTER UYCO,**  
Respondent-Registrant.

x-----x

} **IPC No. 13-2013-00493**  
} Petition for Cancellation of:  
} ID Reg.No.3-2013-000466  
} Date Issued: 05 October 2013  
} **Title: "PLATE NUMBER HOLDER"**

### NOTICE OF DECISION

**BENGZON NEGRE UNTALAN**  
**Intellectual Property Attorneys**  
Counsel for Petitioner  
Second Floor SEDCCO Building  
Rada corner Legaspi Village  
Makati City


**SIOSON SIOSON & ASSOCIATES**  
Counsel for Respondent-Registrant  
Unit 903 AIC-Burgundy Empire Tower  
ADB Avenue corner Garnet & Sapphire Roads  
Ortigas Center, Pasig City

#### GREETINGS:

Please be informed that Decision No. 2015 - 170 dated August 27, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 27, 2015.

For the Director:

  
**MARILYN S. RETUTAL**  
IPRS IV, Bureau of Legal Affairs



**PRIMAL ENTERPRISES CORPORATION,**

Petitioner,

-versus-

**CHESTER UYCO,**

Respondent-Registrant.

x ----- x

IPC No. 12-2013-00493

Petition for Cancellation of

ID Reg. No. 3-2013-000466

Date Issued: 05 October 2013

Title: **"PLATE NUMBER HOLDER"**

Decision No. 2015- 170

**DECISION**

Primal Enterprises Corporation ("Petitioner")<sup>1</sup> seeks the cancellation of Industrial Design (ID) Registration No. 3-2013-000466. The registration, issued to Chester Uyco ("Respondent-Registrant")<sup>2</sup>, covers the design for vehicle plate number cover.

The Petitioner contends that the subject of ID Registration No. 3-2013-00466 is almost identical to ID Registration No. 3-2010-000524 issued to the Respondent-Registrant on 08 November 2010, except with respect to the respective back views of the said designs.

In support of its petition, the Petitioner submitted the following:

1. copy of ID Registration No. 3-2013-00466,
2. copy of ID Registration. No. 3-2010-00524; and
3. affidavit of Charlie Tiu.<sup>3</sup>

The Respondent-Registrant filed his Answer on 08 April 2014 alleging, among other things, that ID Registration Nos. 3-2010-000574 and 3-2013-00466 are different. He asserts that:<sup>4</sup>

"4.1 As shown in Figure 1 of Industrial Design Registration No. 3-2010-00574 (Exhibit '2'), the transparent curved cover thereof is arctuated and directed towards the frame, while as shown in Figure 1 of Industrial Design No. 3-2013-000466 (Exhibit '1'), the transparent curved cover thereof has a raised portion making the arctuated upper portion extending to a flanged panel portion that is directed towards the frame. This makes the cover more bulging thus leaving a greater clearance from the top portion.

x x x

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

<sup>2</sup> Filipino with business address at 4907 Enrique St. Palanan, Makati City

<sup>3</sup> Marked as Exhibits "A" to "C".

<sup>4</sup> See Verified Answer, pp. 3-4.

4.2 Furthermore, as shown in the comparative top views (Figures 4 in both exhibits), in the Industrial Design Registration No. 3-2013-000466, there is a chamfered end portion of the curvature this making a flanged panel portion.

x x x

4.3 In addition, when viewed at the top portion of the transparent cover, the industrial design registered in Exhibit '2' has a substantially flat configuration as shown in Fig. 5 thereof, while the industrial design registered in Exhibit '1' has a curved configuration as shown in Fig. 7 thereof."

The Respondent-Registrant's evidence consists of:

1. copy of ID Registration No. 3-2013-000466;
2. copy of ID Registration No. 3-2010-00524; and
3. his notarized affidavit.<sup>5</sup>

The Preliminary Conference was conducted on 07 July 2014. Upon the termination thereof on even date, the parties were directed to submit their respective position papers. After which, the case is submitted for resolution.

The issue to be resolved is whether the Respondent-Registrant's ID Registration No. 3-2013-000466 should be cancelled.

Section 120 of the R.A. No. 8293, also known as the Intellectual Property Code ("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 subject design is not novel. In this regard, the IP Code defines industrial design as follows:

**"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."**

---

<sup>5</sup> Marked as Exhibits "1" to "3".

As a requisite for registration, it is stated that:

**"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 3-2013-000466 are reproduced below for comparison:

ID No. 3-2010-000523:

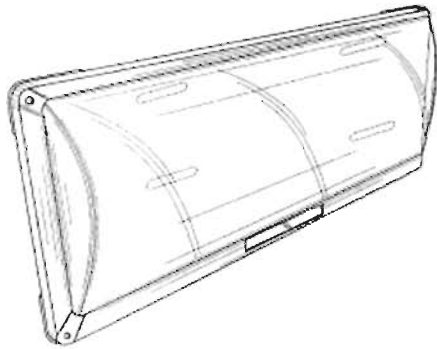


Fig. 1

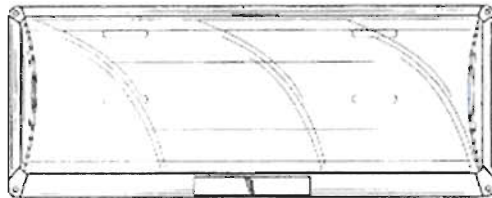


Fig. 2



Fig. 3

ID No. 3-2013-000466

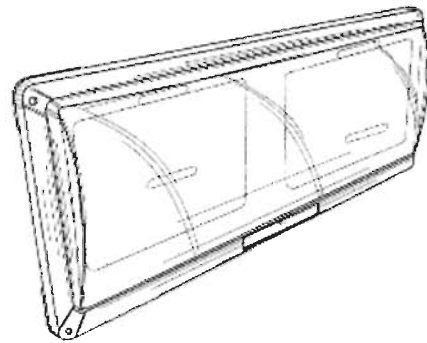


Fig. 1

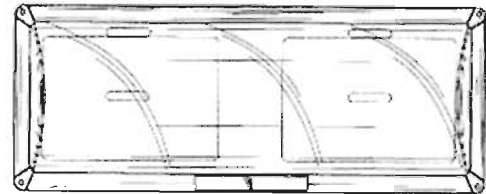


Fig. 2

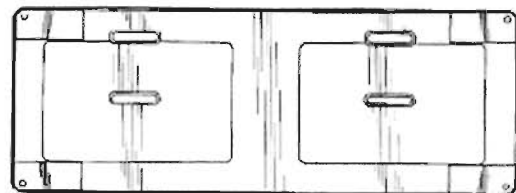


Fig. 3

A handwritten signature or mark in blue ink, located in the bottom right corner of the page. It consists of several overlapping, sweeping lines.



Fig. 4



Fig. 4

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 questioned industrial design is practically a copy of the previously registered design covered by ID Reg. No. 3-2010-000524. Both consist of a curved and transparent cover supported by a frame that has four screw holes at the corner and a nameplate where the brand of the automobile is placed. The only difference between the two is their back designs wherein ID Registration No. 3-2013-000466 includes a pair of squares. 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 design. What can be seen and appreciated is the front design. In this instance, when two vehicles are placed side by side, one car with its plate covered by the design under 3-2010-000524 and the other car with the design Reg. No. 3-2013-000466, an observer can easily conclude that the designs are one and the same in view of the similarities in their elements.

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."***

Finally noteworthy, this Bureau has ordered the cancellation of ID Registration No. 3-2010-00524 for lack of novelty in IPC Case No. 13-2011-00380<sup>6</sup> in the case entitled "**Primal Enterprise Corporation vs. Chester Uyco**", the pertinent portion of which reads:

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

1. ***the number and location 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.***

***x x x***

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

With the previous finding of the existence of a prior art in connection with ID Registration No. 3-2010-00524, all the more that the subject industrial design registration should be cancelled. To reiterate, ID Registration Nos. 3-2010-00524 and 3-2013-00466 comprise of the same elements with negligible differences, if at all.

**WHEREFORE**, premises considered the Petition for Cancellation is hereby **GRANTED**. Let the filewrapper of Design Registration No. 3-2013-000466 be returned, together with a copy of this Decision to the Bureau of Patents for information and appropriate action.

**SO ORDERED.**

Taguig City, 27 August 2015.

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

---

<sup>6</sup> Decision No. 2015-81, 05 May 2015.