



YAN YAN INTERNATIONAL PHILIPPINES, INC., }
Petitioner, }

-versus-

WILSON DY GO, }
Respondent-Registrant. }

IPC No. 12-2013-00079
Petition for Cancellation:
UM Regn. No. 2-2010-00494
Date Issued: November 15, 2010
Title: "LIQUID PACKAGING"

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NOTICE OF DECISION

ESTRELLITA BELTRAN-ABELARDO
Counsel for the Petitioner
Blk 22, Lot 13 Singkil St. Lagro Subdivision
Novaliches, Quezon City

SIOSON SIOSON & ASSOCIATES
Counsel for the 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 - 205 dated September 28, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 28, 2015.

For the Director:


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



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Decision No. 2015- 205

DECISION

Yan Yan International Philippines¹ ("Petitioner") filed a petition to cancel Utility Model ("UM") Registration No. 2-2010-000494 issued to Wilson Dy Go² ("Respondent-Registrant") and titled "LIQUID PACKAGING".

The Petitioner alleges that the Respondent-Registrant's UM "LIQUID PACKAGING" is substantially similar in function, shape and design to the Industrial Design ("ID") covered by Registration No. 3-2003-000315 ("JUICE CONTAINER") issued on 31 May 2004 to one Danny Co Tue Tiu. Thus, according to the Petitioner, the Respondent-Registrant's utility model lacks in novelty. In support of the Petition, the Petitioner submitted the following as evidence:³

1. Judicial Affidavit of Malisa Chua;
2. certified copy of ID Registration No. 3-2012-000551 for "BEVERAGE POUCH";
3. actual juice container from China with the year 2005 printed at the middle portion thereof;
4. actual juice container of "YUMMY TSUP TSUP";
5. actual juice container of "CHOOGA CHOOGA";
6. letter from the Respondent-Registrant's counsel dated 11 December 2011;
7. certified copy of UM Registration No. 2-2010-000494;
8. certified copy of ID Registration No. 3-2010-000688;
9. request or registrability report re: UM and ID registrations for "LIQUID PACKAGING";
10. registrability reports for "LIQUID PACKAGING" by the Bureau of Patents ("BOP");
11. certified copy of ID Registration No. 3-2003-000315 for "JUICE CONTAINER"; and,
12. Judicial Affidavit of Domingo Zapanta.

¹ A domestic corporation with business address at 258 Kabatuhan Street, Deparo, Caloocan City.

² A Filipino citizen with address at 2066 Candido Street, Mapulang Lupa, Valenzuela City.

³ Marked as Exhibits "A" to "K", inclusive.

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

Intellectual Property Center, 28 Upper McKinley Road, McKinley Hill Town Center
Fort Bonifacio, Taguig City 1634 Philippines

T: +632-2386300 • F: +632-5539480 • www.ipophil.gov.ph

The Respondent-Registrant filed his Answer on 06 June 2013 alleging that he is the registered holder of UM Registration No. 2-2010-000494 and that the same is new, original and industrially applicable. He avers that a comparison between its utility model and the industrial design of Danny Co will show a distinctive and new feature namely: "a tearable member at the upper portion of said packaging body made such that it is capable of tearing to facilitate opening of said liquid outlet through imaginary tearing line provided."⁴ He also claims that the Petitioner only filed the instant case in anticipation of its filing of an infringement case against the latter.

The Respondent-Registrant's evidence consists of:⁵

1. judicial affidavit of the Respondent-Registrant;
2. certified copy of UM Registration No. 2-2010-000494 for "LIQUID PACKAGING";
3. actual sample of "CHOOGA CHOOGA";
4. copy of ID Registration No. 3-2003-000315;
5. actual sample of "YUMMY TSUP-TSUP" orange flavoured juice drink;
6. judicial affidavit of Rolando B. Saquilabon;
7. updated 201 file and copy of PAQE certificate of Saquilabon; and
8. demand letter dated 11 December 2012.

The Hearing Officer conducted a Preliminary Conference on 12 November 2013. Upon termination, the parties were directed to submit their respective position papers within ten days therefrom. The parties thereafter submitted their position papers.

The issue is whether the Respondent-Registrant's UM registration for "LIQUID PACKAGING" should be cancelled.

Section 61 of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), provides that:

"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;
(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 morality."

⁴ See Answer, p. 6.

⁵ Marked as Exhibits "1" to "7", inclusive.

Corollarily, Rule 213 of the Rules and Regulations on Utility Models and Industrial Designs ("Rules") provides:

"Rule 213. Cancellation of the utility model registration. The utility model registration shall be cancelled on the following grounds:

(a) That the utility model does not qualify for registration as a utility model and does not meet the requirements of novelty and industrial applicability or it is among non-registrable utility models;

(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 utility model has not been furnished;

(d) That the owner of the utility model registration is not the maker or his successor in title."

A utility model is a technical solution to a problem in any field of human activity which is new and industrially applicable. It may be, or may relate to, a product, or process, or an improvement of any of the aforesaid. Essentially, a utility model refers to an invention in the mechanical field. This is the reason why its object is sometimes described as a device or useful object.⁶

The Petitioner contends that UM Registration No. 4-2010-000494 should be cancelled for lack of novelty citing ID Registration No. 2003-00315 for "A JUICE CONTAINER" issued on 31 May 2004 to one Danny Co Tue Tiu, the latter having one claim, to wit: "An ornamental design for juice container substantially as shown and described." Danny Co Tue Tiu further describes his industrial design as:

"The characteristic features of this new design for a juice container resides on its container body convexing heel portion, a tubular mid portion, a concaving heel portion and a reducing mouth portion."

On the other hand, the Respondent Registrant's UM Registration No. 4-2010-000494 has the following claim:

"A liquid comprising: a packaging body having a liquid containing chamber provided thereof; a liquid outlet in communication with the liquid containing chamber; a tearable member integrally provided at the upper portion of said packaging body being made such that it is capable of tearing to facilitate opening of said liquid outlet through imaginary tearing line provided thereof."

From the above claims and/or description, this Bureau cannot arrive at a conclusion that one is a prior art of the other. The Respondent-Registrant's utility model has a tearable opening. Whether the same is present or not in Danny Co Tue Tiu's registration cannot be ascertained. While both registrations cover liquid/juice container, they are registered for different purposes. Danny Co Tue Tiu's registration

⁶ Jessie G. Ching vs. William M. Salinas, Sr., G.R. No. 161295, 29 June 2005.

covers the ornamental features of its product while the Petitioner's utility model refers to its functionality.

The Petitioner's reliance on ID Registration No. 2003-00315 for "A JUICE CONTAINER" is therefore misplaced. This Bureau finds merit in the Respondent-Registrant argument that its utility model for "LIQUID PACKAGING" is distinct in view of the tearable upper portion for its juice drink container. Scrutinizing ID Registration No. 2003-00315, there is no way for validating or confirming the same as the latter pertains solely on the ornamental design and not as to function. As such, the extent of the protection of the industrial design registration for "A JUICE CONTAINER" cannot encompass to more than what is granted. To allow the same will create a dangerous precedent wherein industrial designs, which do not require the element of industrial applicability, can be used as a ground to cancel a utility model registration.

Succinctly, while a utility model pertains to a useful object, 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.⁷ From the above definitions alone, it is clear that utility models and industrial designs differ in many aspects. An industrial design pertains to the ornaments or aesthetic feature while the utility model as to the use or function. In addition, as to registrability, the law only requires novelty for an industrial design while that of a utility model requires, in addition to novelty, that it must be industrially applicable.

Finally, the burden of proving want of novelty is on him who avers it and the burden is a heavy one which is met only by clear and satisfactory proof which overcomes every reasonable doubt.⁸ In this case, the Petitioner failed to discharge such burden.

WHEREFORE, premises considered, the instant petition for cancellation is hereby **DISMISSED**. Let the filewrapper of Utility Model Registration No. 2-2010-000494 be returned, together with a copy of this Decision, to the Bureau of Patents for information and appropriate action.

SO ORDERED.

Taguig City, 28 September 2015.


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

⁷ Section 112 of RA No. 8293.

⁸ Angelita Manzano vs. Court of Appeals, G.R. No. 113388, 05 September 1997.