

INTEGRATED FORMWORKS BUILDER,
represented by Daniel L. Ranon,
Petitioner,

-versus-

FREDERICK V. ERUM,
Respondent- Patentee.

x-----x

} **IPC No. 11-2013-00473**
} Petition for Cancellation:
} Letters Patent No. 1-2006-00047
} Date Issued: 15 October 2012
} **Title: "A TABLE FORM**
} **SUPPORT SYSTEM FOR**
} **CONCRETE FORMING"**

NOTICE OF DECISION

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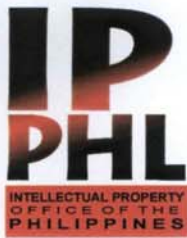
GREETINGS:

Please be informed that Decision No. 2016 - 70 dated March 08, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 08, 2016.

For the Director:

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



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**FREDERICK V. ERUM,
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IPC. No. 11-2013-00473
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Letters Patent No. 1-2006-00047
Date Issued: 15 October 2012

Title: **"A TABLE FORM
SUPPORT SYSTEM FOR
CONCRETE FORMING"**

Decision No. 2016- 70

DECISION

Integrated Formworks Builder, represented by Daniel L. Ranon ("Petitioner")¹ filed a petition for cancellation to Letters Patent No. 1-2006-00047. The contested registration, issued to Frederick V. Erum² ("Respondent-Patentee") covers "A TABLE FORM SUPPORT SYTEM FOR CONCRETE FORMING".

The Petitioner maintains that the invention as claimed in the questioned patent is no longer new at the time of filing of the invention as there were similar inventions available to the public in the Philippines and other foreign countries including U.S. Patent Nos. 4,787,183 issued on 29 November 1988 to Ronald J. Johnston and his assignee Aluma Systems Ltd. entitled "TRUSS ARRANGEMENT" and U.S. Patent No. 4,585,304 issued to Lawrence A. Parker on 29 April 1986 entitled "CONCRETE FORMING SYSTEM". It contends that Respondent-Patentee's patent is available in Philippine and local market long before the filing of the patent application as the same has been featured in various trade catalogues, one of which is the Aluma Systems catalogue published in 2006.

The Petitioner also alleges that the subject invention does not involve an inventive step as the Respondent-Patentee merely made the upper and lower chords to have double-wall and removed the flanged bolt slot channel in the upright member of the table form disclosed in U.S Patent 4,787,183. It further contends that the description and claims in the Respondent-Patentee's patent do not disclose the invention sufficiently clear as to enable a person skilled in art to apply and follow the teachings set forth in the disclosure to make and use the subject table form support system. The specification, according to the Petitioner, did not include all related arts and known technology relevant to the invention nor provide references to specific

¹ Sole Proprietorship owned and represented by Daniel L. Ranon with address at 22 Concha St., Tinajeros, Malabon City.

² Filipino with address at #89 Cambridge St., Hillsborough Alabang, Muntinlupa City.

documents and source of information. It asserts that the patent examiner has been misled as the Respondent-Patentee cited U.S. Patent No. 6, 237, 890B, instead of U.S. Patent 4, 787, 183. The cited patent pertains to a non-novelty reference because the same merely involved a support apparatus with a tie lock tool and a clamp for a concrete form system.

In support of the allegations in the instant Petition, the Petitioner submitted the following as evidence:³

1. affidavit-direct testimony of Daniel Ranon;
2. copies of U.S. Patent Nos. 4,787,183 and 4,585,304;
3. pertinent page of Aluma Systems catalogue; and
4. affidavit of Rolando Saquilabon.

In his Answer to the Petition, the Respondent-Patentee alleges that the instant case should be dismissed for lack of cause of action. He avers that while the Petitioner stated that it may be damaged by the existence of the Letters patent, it did not allege the material facts as to why and how it would incur damage. According to the Respondent-Patentee, the claimed invention is new and patentable and that the issuance of the letters patent enjoys the presumption of regularity. He asserts that his invention is distinct from the prior arts referred to in the petition as it solved the various shortcomings and technical problems encountered with the use of the prior arts.

The Respondent-Patentee moreover alleges that the Petitioner merely made blanket generalizations but did not specify nor explain which portion of the disclosure, description or claim is unclear to him. Thus, the Respondent-Patentee argues that the Petitioner failed to overcome the presumption of validity of the subject patent.

In support of his Answer, Respondent-Patentee submitted the following as evidence:⁴

1. affidavit of Respondent-Patentee;
2. affidavit of Cecilio M. Fernandez; and
3. Tables 1-2A.

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

⁴ Marked as Exhibits "1" to "5", inclusive.

The Hearing Officer conducted a preliminary conference on 23 October 2014. Upon termination, the parties were directed to submit their respective position papers within ten days. After which, the case was deemed submitted for resolution.

The Respondent-Patentee alleges that the petition must be dismissed for failure to state a cause of action. Petitioner, however, has shown that it is the owner of Integrated Formworks Builder and a practicing civil engineer, thus, it has a business and professional interests that may be damaged by the existence of the patent. All that is required for an interested person in filing the petition for cancellation is to verify the petition, specify the grounds upon which it is based, include a statement of the facts to be relied upon, and pay the required fee.⁵ What is material in a petition for cancellation of patents is whether there exist valid grounds for the cancellation. As such, the Petitioner is an interested person who may institute a petition for cancellation.

Proceeding now to the primordial issue in this instant case, that is, whether the subject letter patent should be cancelled. Section 61 of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), provides that:

"Sec 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, or 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."

The Letters Patent sought to be cancelled relates to construction forms used in the construction industry, particularly, a table form support system for concrete forming. It contains twelve (12) pages of specification and claims, fourteen (14) Figures of the drawings and eleven (11) claims. Claim 1 is an independent claim and claims 2 to 11 are dependent claims. The supposed new and patentable features of the patent are defined in the independent claim as follows:

"1. A table form support system for concrete forming (10) comprising opposed trusses (11) parallel and spacedly interconnected, each of said trusses (11) including a top chord (12) and a bottom chord (13) interconnected by upright and bracing members (14,15), said upright members (14) being extendable respectively at the top and bottom end portions (14a,14b) thereof by lockable upper and lower

⁵ Section 62, R.A. 8293.

extension members (16, 16b) telescopically inserted therein wherein said lower extension member (16b) thereof is adjustably and stably mounted on an adjustable base jack (16b'), said top chord (12) being clampedly secured by at least an adjustable packer (12a) on which beam joists (12b) are stably secured, wherein each of said upright members (14) is defined by a pair of tubular members (17a) longitudinally and spacedly connected together integrally by a central web section (17b) having co-extending flanged bolt slot channels (18) at the respective opposite sides thereof, and wherein each of said chords (12, 13) is defined by at least a single-walled channel; characterized in that each of said chords (12, 13) is defined by at least a double-walled channel (20), and said central web section (17b) of said upright members (14) having no flanged bolt slot channels (18). (Emphasis supplied.)

The essential elements recited in claim 1 are shown in Figure 2 of the drawing which is a cut-away, enlarged and perspective view thereof with focus and emphasis on its enhanced chords and upright members.⁶

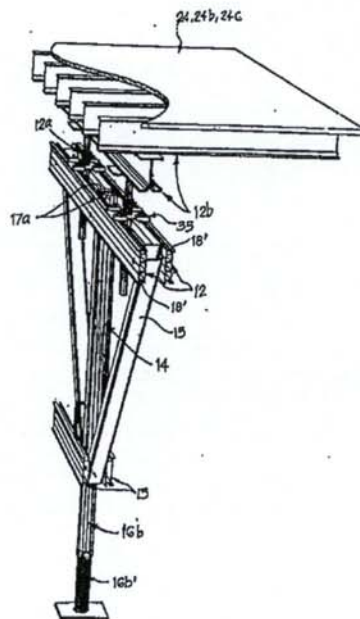


FIG. 2

Figure 2 is cut-away portion of **Figure 1**, shown below, which is a perspective view of the complete assembly of the invention.

⁶ Page 3, lines 25-26 of the specification, Letters Patent No. 1-2006-000417.

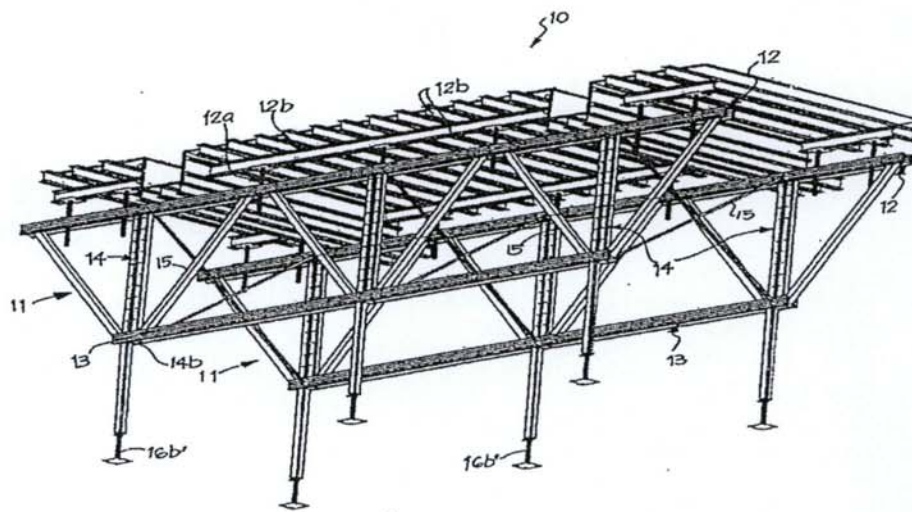
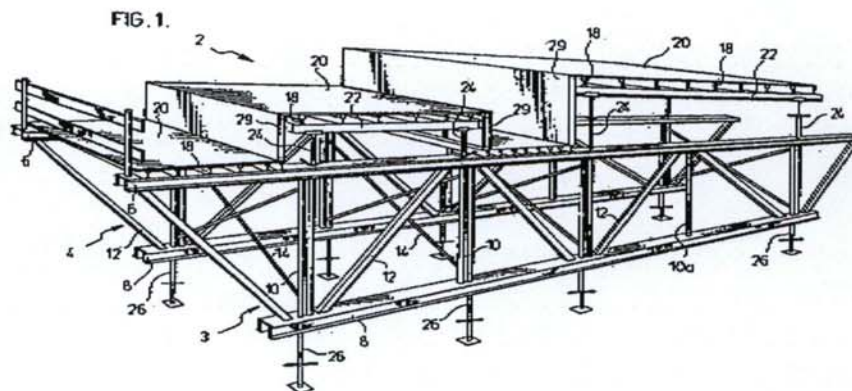


FIG. 1

Section 23 of the IP Code states that "an invention shall not be considered new if it forms part of the prior art." A prior art shall consist of everything which has been made available to the public anywhere in the world, before the filing date or priority date of the application claiming the invention.⁷

In this regard, the Petitioner relies on two (2) prior art documents to cancel the subject patent. The first prior art document is U.S. Patent No. 4, 787, 183 issued on 29 November 1988 to Ronald Johnston ("Johnston patent"). Like the contested patent, this Johnston patent relates to construction form system used in the construction industry. Specifically, the Johnston patent relates to forms and components thereof for use in concrete forming which include trusses for forming of concrete floors. The relevant figure of the drawings, Figure 1 is reproduced below:



⁷ Section 24.1 of the IP Code.

Analyzing claim 1 and reading it in relation to the Johnston patent, it is clear that the essential elements recited in the first part of claim 1 are found in the Johnston patent, to wit:

- a. opposed trusses
- b. top chord
- c. bottom chord
- d. upright and bracing members (with the upright member being extendible respectively at the top and bottom end)
- e. lockable upper and lower extension members
- f. adjustable base jack where the lower extension member is adjustably and stably mounted.
- g. adjustable packer on which beam joists are stably secured.

In the Johnston patent, the top chord and the bottom chord have single-walled channel. What the Respondent-Patentee did was to introduce another wall to the single-walled channel to convert it to a double-walled channel. After converting a single-walled channel into a double-walled channel, he removed the flanged bolt slot channels 18 from the upright members 14 as shown in Figure 4a, as shown below, wherein the channels 18 are shown in invisible line to show that they do not form part of the upright members 14⁸.

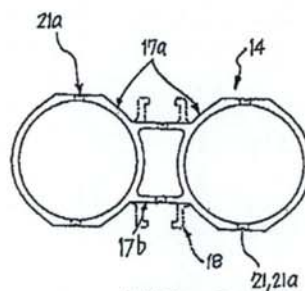


FIG. 4a

Obviously, merely adding another wall to an existing single-walled channel, and merely removing the flanged bolt channels in the Johnston patent does not make claim 1 of the contested patent substantially different from the former. The two table form support systems may be different in form and yet they still perform the same function in substantially the same way. It is naturally expected that if you add one more wall to the chords, the resulting structure will be stronger. It does not

⁸ Lines 5-8, p. 5 of Letters Patent No. 1-2008-00047.

produce new and unexpected result in the performance of the table form support system. As stated by Engr. Rolando Saquilabon in his affidavit:⁹

"24. Q. Let us take the first prior art, the Jonnston patent. What is the relevance of this patent to Erum's patent Pat. '417?"

A. First, the Johnston patent was issued ahead of Erum's Pat. '417, or ahead by more than 23 years. Second, it pertains to a TRUSS ARRANGEMENT whose elements and functions are substantially similar to the elements and functions being claimed in Erum's patent." (Undelining supplied).

Moreover, removing remove the flanged bolt slot channels 18 from the upright members 14 as shown in Fig. 4a of Erum's patent is obvious to a person skilled in the art if one wants to simplify the structure. This Bureau quotes with favor the following observation of Engr. Saquilabon:

"28. Q. Mr. Witness, if claim 1 is considered novel, what is the effect of such characterizing feature on the inventiveness aspect of claim 1 of Erum's patent?"

A. xxx It is not inventive to merely add additional wall to the top and bottom chords of Johnston patent. Such an act is obvious to the person skilled in the art. It does not produce new and unexpected result in the performance of the table support system. It is naturally expected if you add additional wall to the chords, the resulting structure will be stronger."

In fact, in the affidavit of Respondent-Patentee's expert witness Engr. Cecilio Fernandez¹⁰, it was stated that the only advantage derived from the differences introduced by the contested patent is that it enhanced the design of the prior art. Also, it made the table form "structurally stronger, high rigidity and such other feature as structural stability, lightness in weight, design flexibility and practically more efficient". These types of advantages are expected by a person skilled in the art. They are not the advantages that would qualify to be called unexpected result. To reiterate, making something stronger than the prior art is not the type of innovation which is considered patentable under the law.

Anent the second prior art relied upon by the Petitioner, U.S. Pat. No. 4,585,204 issued on 29 April 1986 to Lawrence A. Parker, the same relates to concrete forming systems which include telescoping jacks, bottom chords and top chords. All elements of the Respondent-Patentee's patent also constitutes Parker's

¹⁰ Exhibit "2".

patent. Consequentially, both perform the same functions. For clarity, Figure 1 of the drawings is shown below to show the telescoping jacks, bottom chords and top chords.

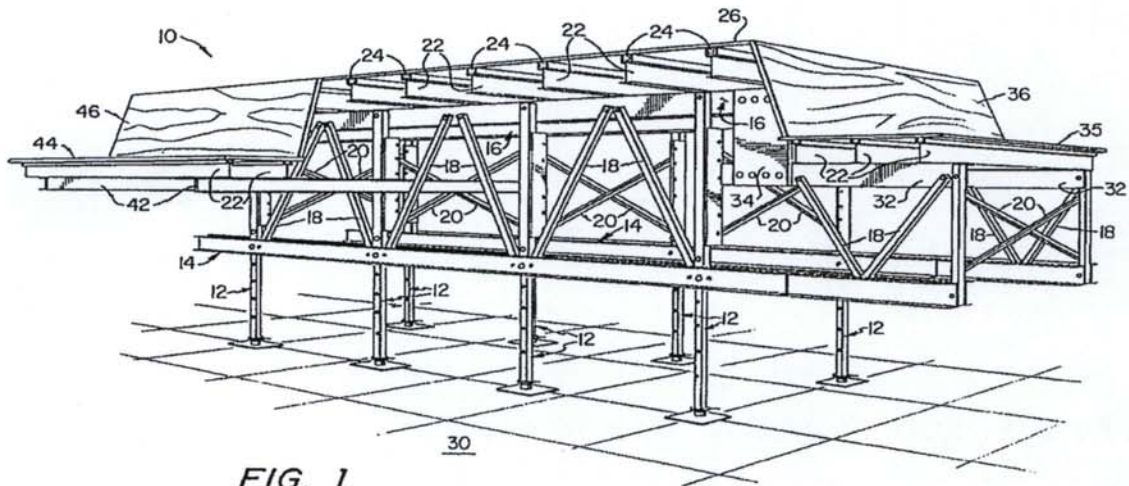


FIG. 1

Considering that the Parker patent (U.S. Pat. No. 4,585,204) and the Johnston patent (U.S. Pat. No. 4,787,183) constitute prior arts with respect to Letters Patent No. 1-2006-00047, the requirement of novelty, thus, has not been met or complied with.

WHEREFORE, premises considered, the Petition is hereby **GRANTED**. Let the records of the subject patent be forwarded to the Bureau of Patents for appropriate action. Further, let a Notice of Cancellation of the patent be published in the IPO Gazette in accordance with law.

Taguig City, 08 March 2016.


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