



KPI MANUFACTURING, INC., doing business
 Under the name and style **KEY LARGO CAR**
ACCESSORIES CENTER,
Petitioner,

-versus-

ALWIN T. GO,
Respondent-Registrant.

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IPC No. 13-2015-00526
 Petition for Cancellation
 of Industrial Design

Reg. No. 3-2012-00340
 Issued On: 25 July 2014

Title: A CAR TRUNK MAT

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 309 dated 14 September 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 14 September 2016.


Atty. ADORACION U. ZARE
 Adjudication Officer
 Bureau of Legal Affairs

“32. Indubitably, therefore, at the time of the filing of respondent’s application for industrial design registration on May 10, 2012, the industrial design applied for was not new and registrable under the facts of the case and the provisions of the IP Code quoted above.

“33. As petitioner KPI has proven in this case that respondent is not the true and original designer of the subject car mat as it been printed in a publication/catalog and that the respondent’s industrial design for car mat has been existence in the markets and known to the world, it only goes to show that respondent’s industrial design lacks novelty.

“34. Truly, respondent is not the true and original designer of the industrial design for the subject car trunk mats. Hence, respondent’s Industrial Design Patent Registration No. 3-2012-00340 for “A Car Trunk Mat” is not registrable. As a result, any person including the herein petitioner KPI may appropriate the same design without the risk of committing an act of infringement. xxx”

To support its petition, the Petitioner submitted the following as evidence:

1. Copy of Amended Articles of Incorporation under Securities and Exchange Commission (SEC) Reg. No. ASO96-00198;
2. Copy of KPI’s General Information Sheet;
3. Copy of Corporate Secretary’s Certificate dated 29 October 2015;
4. Copy of letter signed by Oscar G. Raro dated 14 October 2015;
5. Copy of letter signed by Clarence Lee B. Evangelista dated 19 October 2015;
6. Copy of Certificate of Registration No. 3-2012-00340 dated 25 July 2014;
7. Picture of actual car mat
8. Pages of car mat catalog of Hongshengyuan;
9. Copies of Proforma Invoice and delivery receipts and
10. Affidavit of Mario G. Gamboa dated 29 October 2015³

The Respondent-Registrant filed his Answer on 14 March 2016, alleging among others, the following special and affirmative defenses:

“15. Respondent is the true and original designer of the car mat design covered by the said registration specifically and simply described as A Car Trunk Mat. As admitted by petitioner, this is exactly the same car mat design which it has been importing abroad as early as 12 May 2014 from a China supplier (par. 17-Petition).

“16. Respondent created and designed the subject car mat as early as 7 August 2010, using a specific computer program known as ‘Solidworks,’ He has been continuously tinkering with the design in that it was modified on 23 August 2010, copy of his computer printout showing the relevant date and the actual

³ Exhibits “A” to “M”

design of the subject car mat hereto attached and made integral parts hereof as Exhibits '1' to '1-B'.

"17. Upon being satisfied with his design, the respondent had the design mould manufactured by *Allied Flourish* SDN BHD, a Malaysian manufacturer with which respondent has a business relationship since 2010, a copy of *Allied Flourish* SDN BHD's certification dated 15 February 2016 attesting to this fact hereto attached and made integral part hereof as Exhibit '2'. xxx

"18. The purchase order signed by respondent, specifically PO#AF20100823 dated 23 August 2010, showed that respondent through his family corporation, paid the amount of Twenty Three Thousand Fifty U.S. Dollars (USD23,058.00) to *Allied Flourish* SDN BHD of Malaysia for the manufacture of one (1) set of mould for the subject car mat design, copy of such document issued by *Allied Flourish* SDN BHD for the same amount and order is hereto attached and made integral part hereof as Annex '3'. xxx

"19. When respondent filed for the registration of this Industrial Design with the Intellectual Property Office of the Philippines (IPO), he complied with the requirements under the provisions of the law and regulations for Industrial Design registration, primarily under Republic Act No. 8293. xxx"

The Respondent-Registrant's evidence consists of the following:

1. Copy of computer print-out of creation of the car mat design;
2. Authenticated and notarized certification of *Allied Flourish* SDN BHD dated 15 February 2016;
3. Copies of purchase order, proforma invoice, telegraphic transfer application, certificate of bank deposit and/or placement;
4. General Information Sheet of Bionic Auto Seat Cover Mfg., Incorporated;
5. Certified true copy of Registrability Report requested on 25 January 2016; and
6. Affidavit of Alwin T. Go dated 14 March 2016.⁴

The Hearing Officer issued on 10 June 2016 a notice setting the Preliminary Conference on 21 July 2016. During the Preliminary Conference, the Hearing Officer directed the parties to file their position papers. Both Petitioner and Respondent-Registrant filed their position papers on 10 August 2016.

Should the Respondent-Registrant's industrial design registration be cancelled?

Section 122 of Republic Act. No. 8293, otherwise known as the Intellectual Property Code of the Philippines (IP Code) state that:

⁴ Exhibits "1" to "6"

Section 122. An Industrial Design is any composition of lines or colors or any three-dimensional form, whether associated with lines or colors: Provided, that such composition or form gives a special appearance to and can serve as a pattern for an industrial product or handicraft.

Sec. 120 of the Intellectual Property Code of the Philippines (IP Code) provides that an industrial design may be cancelled on the following grounds:

Section 120. At any time during the term of the industrial design registration, any person upon the payment of the required fee, may petition the Director of Legal Affairs to cancel the industrial design on the following grounds:

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

The industrial design registration entitled “A CAR TRUNK MAT” consists of a claim:

“1 CLAIM:

The ornamental design of a car trunk mat substantially as shown.”



FIG.1

The Petitioner argues that the subject industrial design is no longer new because it had already imported and sold car mats embodying designs that are similar to the Respondent-Registrant’s Industrial Design Registration No. 3-2012-000340. In support of its contention, it

submitted pictures⁵ of actual car mats with a design similar to that of Respondent-Registrant's car mat, as seen below:



The Petitioner explains that it delivered car trunk mats embodying Respondent-Registrant's design under "Unit No. 16400" to Ace Hardware Philippines, Inc. on 19 October 2011, as stated in the delivery receipt⁶. It has placed orders for car mats, "Supplier Part No. 16400" from a supplier, Shichao Rubber in a document⁷ dated 18 April 2011.⁸ Petitioner submitted a proforma invoice⁹ dated 8 May 2012, highlighting item "C307434", the item with a design allegedly similar to Respondent-Registrant's industrial design registration, issued by Ningbo Carbest Auto Accessories Co. Ltd and pages of Carbest catalog¹⁰ and a page from Hongshengyuan Carmats catalog¹¹ to prove that the design of Respondent-Registrant lack the element of newness.

In determining whether an invention is new or novel, the invention must not form part of prior art. The pertinent provisions of the IP Code state:

Section 23. *Novelty.* . - An invention shall not be considered new if it forms part of a prior art.

Section 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,

⁵ Exhibit "G"

⁶ Exhibit "H"

⁷ Exhibit "I"

⁸ Exhibit "I"

⁹ Exhibit "J"

¹⁰ Exhibit "K"

¹¹ Exhibit "L"

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.

A perusal of the cover page of Hongshengyuan car mat product catalog¹² show the year, "2013". While the cover page indicates the year 2013, it does not specify the exact date of its publication, hence, it cannot be verified when it was actually printed. Likewise, the Carbest catalog cover page merely indicate the year "2012", without any other evidence to prove its actual publication or printing date. More importantly, the Respondent-Registrant's filing date is 10 May 2012 which is earlier than the Hongshenyuan catalogue. Hence, these pages from the catalogues are useless prior art references. Furthermore, a cursory examination of the mats¹³ fail to yield any marking of its production or manufacturing date. Without the dates, these cannot serve to anticipate Respondent-Registrant's design. The Supreme Court in Angelita Manzano v. Court of Appeals¹⁴ illustrates:

Thus the Director of Patents explained his reasons for the denial of the petition to cancel private respondent's patent —

Even assuming *gratia arguendi* that the aforesaid brochures do depict clearly on all fours each and every element of the patented gas burner device so that the prior art and the said patented device become identical, although in truth they are not, they cannot serve as anticipatory bars for the reason that they are undated. The dates when they were distributed to the public were not indicated and, therefore, they are useless prior art references.

xxx Another factor working against the Petitioner's claims is that an examination of Exh. "L" would disclose that there is no indication of the time or date it was manufactured. This Office, thus has no way of determining whether Exh. "L" was really manufactured before the filing of the aforesaid application which matured into Letters Patent No. UM-4609, subject matter of the cancellation proceeding.

Moreover, the Petitioner submitted delivery receipts dated 2011 showing item, "Unit No. 16400" and a sample car trunk mat with a label CG16400. The label was merely placed on the car mat but the actual car mats do not bear any marking to show its manufacturing or production date. The Proforma Invoice dated in 2012¹⁵ with the description "C307434" is a mere photocopy, as such, the evidence is insufficient to prove that this item code corresponds to the actual design Carbest catalog¹⁶, which date of publication is also lacking. Thus, these cannot constitute anticipatory bars to the subject design.

¹² Exhibit "L"

¹³ Exhibit "G", "G-1"

¹⁴ G.R. No. 113388, 5 September 1997

¹⁵ Exhibit "J"

¹⁶ Exhibit "K"

On the other hand, the Respondent-Registrant requested a Registrability Report¹⁷ which findings reveal documents the general state of the art but did not point to any document of particular relevance in determining novelty. This implies that the examiner conducting the search did not find on record any information that destroyed the industrial design's newness and originality. "This is a matter which is properly within the competence of the Patent Office the official action of which has the presumption of correctness and may not be interfered with in the absence of new evidence carrying thorough conviction that the Office has erred. Since the Patent Office is an expert body preeminently qualified to determine questions of patentability, its findings must be accepted if they are consistent with the evidence, with doubts as to patentability resolved in favor of the Patent Office."¹⁸ The Supreme Court has held:

Where, however, the plaintiff introduces the patent in evidence, if it is in due form, it affords a *prima facie* presumption of its correctness and validity. The decision of the Commissioner of Patents in granting the patent is always presumed to be correct.¹⁹

Finally, the Petitioner asserts that Respondent-Registrant's disclosed his design to third parties more than twelve months before the filing of the application. According to the Petitioner, this renders the registration void for lack of novelty. Section 25 of the IP Code states:

Section 25. *Non-Prejudicial Disclosure.* . - 25.1. The disclosure of information contained in the application during the twelve (12) months preceding the filing date or the priority date of the application shall not prejudice the applicant on the ground of lack of novelty if such disclosure was made by:

- (a) The inventor;
- (b) A patent office and the information was contained (a) in another application filed by the inventor and should not have been disclosed by the office, or (b) in an application filed without the knowledge or consent of the inventor by a third party which obtained the information directly or indirectly from the inventor; or
- (c) A third party which obtained the information directly or indirectly from the inventor.

Considering that the filing date is 10 May 2012, any disclosure beyond the twelve month period prior to the filing date, or any disclosure before 10 May 2011, will be detrimental to the Respondent-Registrant. His act of purchasing a mould for his car mat design is not tantamount to a prejudicial disclosure because the mould is merely a prelude or preparatory to making the article bearing the new industrial design. The records are bereft of any evidence that Respondent's car mat was disclosed, known to the public or sold more than twelve months before the filing date of 10 May 2012. Therefore, at the time of the application, the design has not been anticipated by any prior art.

¹⁷ Exhibit "5"

¹⁸ Note 9

¹⁹ Vargas v. F.M. Yaptico, G.R. No. 14101, 24 September 1919

WHEREFORE, premises considered, the Petition for Cancellation is, as it is hereby DENIED. Let the file wrapper of Industrial Design Registration No. 3-2012-00340 together with a copy of the DECISION be returned to the Bureau of Patents (BOP) for appropriate action.

SO ORDERED.

Taguig City, 14 SEP 2016



ADORACION U. ZARE
Adjudication Officer
Bureau of Legal Affairs