

**ASAHI ELECTRICAL  
MANUFACTURING CORP.,**

Petitioner,

-versus-

**REGINALD JOSEPH O. CHUA,**  
Respondent.

X-----X

**IPC No. 13-2011-00430**

Cancellation of:

ID. Reg. No. 3-2009-000488

Date Issued: 26 October 2009

Title "AN AERODYNAMIC FAN  
BLADE"

**NOTICE OF DECISION**

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**GREETINGS:**

Please be informed that Decision No. 2016 - 418 dated November 18, 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, November 21, 2016.

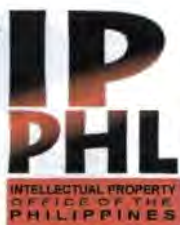
**MARILYN F. RETUTAL**  
IPRS IV  
Bureau of Legal Affairs

**Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE**

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Decision No. 2016 - 418

### DECISION

ASAHI ELECTRICAL MANUFACTURING CORPORATION ("Petitioner")<sup>1</sup> filed a Verified Petition for Cancellation of Certificate of Industrial Design Registration No. 3-2009-000488 entitled "An Aerodynamic fan Blade" issued to REGINALD JOSEPH O. CHUA ("Respondent-Registrant")<sup>2</sup>.

The Petitioner anchors its Petition on the ground that the subject Industrial Design is not new or original and therefore not registrable. To support its Petition, the Petitioner submitted the following:

1. Certified true copy of its Article of Incorporation and By-Laws issued by the Securities and Exchange Commission;
2. Petitioner's company profile (original copy);
3. Product brochure featuring Asahi-branded Aerodynamic Fans and/or Power-series Fan Blade products (original copies);
4. Secretary's Certificate authorizing the said firm to represent herein Petitioner in this proceeding;
5. Certified true copy of Industrial Design Utility Registration No. 3-2009-000488;
6. Affidavit of the witness forming part of this Petition by way of Reference;
7. Representative samples of Sales Invoices proving sale of our Asahi branded 'Power Fan' series electric fans;
8. Sales Invoice No. 33052 dated 26 October 2002;
9. Sales Invoice No. 33270 dated 18 November 2002;
10. Sales Invoice No. 33265 dated 18 November 2002;
11. Sales Invoice No. 33367 dated 26 November 2002;
12. Sales Invoice No. 12886 dated 07 April 2005;
13. Sales Invoice No. 16049 dated 21 July 2005;
14. Sales invoice No. 36455 dated 04 May 2006;
15. Sales Invoice No. 41982 dated 23 November 2007;
16. Sales Invoice No. 31687 dated 24 January 2007;
17. Sales Invoice No. 46862 dated 25 April 2008;
18. Sales Invoice No. 48190 dated 02 June 2008; and,

<sup>1</sup> A corporation organized and existing under and by virtue of the laws of the Philippines with business address at 117 P, Parada Street, Sta. Lucia, San Juan City, 1550 Philippines.

<sup>2</sup> With address at No. 82 Biak Na Bato, Quezon City.



19. Representative samples of product brochure and flyers showing angularly-shaped Aerodynamic Fan Blades of other electric fan manufacturers;

On 21 February 2012, the Respondent-Registrant filed his Verified Answer denying all the material allegations of the Petitioner and argued that the prior art cited and/or claimed by the Petitioner did not clearly and fully disclosed all the elements of the device as claimed in the challenged industrial design. Further, the aerodynamic fan blade disclosed and claimed in the subject industrial design satisfies the requisite of ornamentality in view of the unique shape and proportion of the fan blade which creates an impression upon the eyes of the observer. It is in the uniqueness of the shape and proportion of the fan blades compared to the conventional ones that makes this design registrable.

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

1. Affidavit direct testimony of Neptali L. Bulilan; and
2. Affidavit of Reginald Joseph O. Chua.

On 24 January 2012, the Petitioner filed its reply to the answer and stated among other things that Respondent-Registrant Chua considered Petitioner's fan blades as prior art and/or Petitioner's fan design as the same or deceptively similar to his Aerodynamic Fan Designs.

Should Industrial Design Reg. No. 3-2009-000488 be cancelled?

The Petitioner alleges that Industrial Design Reg. No. 3-2009-000488 lacks novelty because it is not new and formed part of prior art years before it was filed by Respondent-Registrant. As such, the same is subject to cancellation.

The subject industrial design lacks any matter that could be protected as it is technical and/or functional in nature. It is the same "Aerodynamic Fan Blade" covered by Utility Model Registration No. 2-2010-000196, also in the name of the Respondent-Registrant.

Section 113 of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

Sec. 113. Substantive Conditions for Protection – 113.1 – Only industrial design that are new or original shall benefit from protection under this Act.

Corollarily, Sections 23 and 24 of the IP Code relating to patents are applicable *mutatis mutandis* to industrial design registrations under Section 119 of the same Code, to wit:

Sec. 23. Novelty – An invention shall not be considered new if it form part of a prior art.

Section 24. Prior Art – prior art shall consist of:

Everything which has been made available anywhere in the world, before the filing date or the priority date of the application claiming the invention. (Emphasis supplied)

Also, Section 120 of the IP Code states:

Section 120. Cancellation of Design Registration – 120.1 – At any time 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.

One of the requirements for registration of an industrial design is that it must be new<sup>3</sup>. To be new, the design should not form part of a prior art before the filing date of the application for registration. Section 24 of the IP Code provides that, prior art shall consist of everything made available to the public anywhere in the world before the filing date of the application for the design; or the whole contents of an application for an industrial design registration, published and filed in the Philippines, with a filing date that is earlier than the filing of priority date of the subject industrial design application.

In invalidating a design patent, the Petitioner should establish patent invalidity through the “Points of Novelty Test” and the “Ordinary Observer Test”. These are two distinct tests employed in order to find patent invalidity as well as infringement<sup>4</sup>.

Accordingly, in comparing the competing Design Patents, their respective claims must be construed with the meaning and scope determined. Claims refer to the drawings where the illustrated elements or features limit the scope of the patent.

The Petitioner puts into issue the novelty of Industrial Design No. 3-2009-000488 contending that the industrial design covered by said registration is not new since it already formed part of a prior art. The Petitioner cites and alleges as prior art, Petitioner’s Power Series Electric Fan Blade, which has been manufactured, sold and distributed by the Petitioner since the year 2002 or at least seven to eight (7-8) years before the Respondent filed the subject Industrial Design No. 3-2009-000488 on 31 July 2009.

Comparisons of the respective claims in the Petitioner’s products and in the subject Industrial Design Patent are shown below:

**POWERS SERIES ELECTRIC FAN BLADE of the Petitioner:**

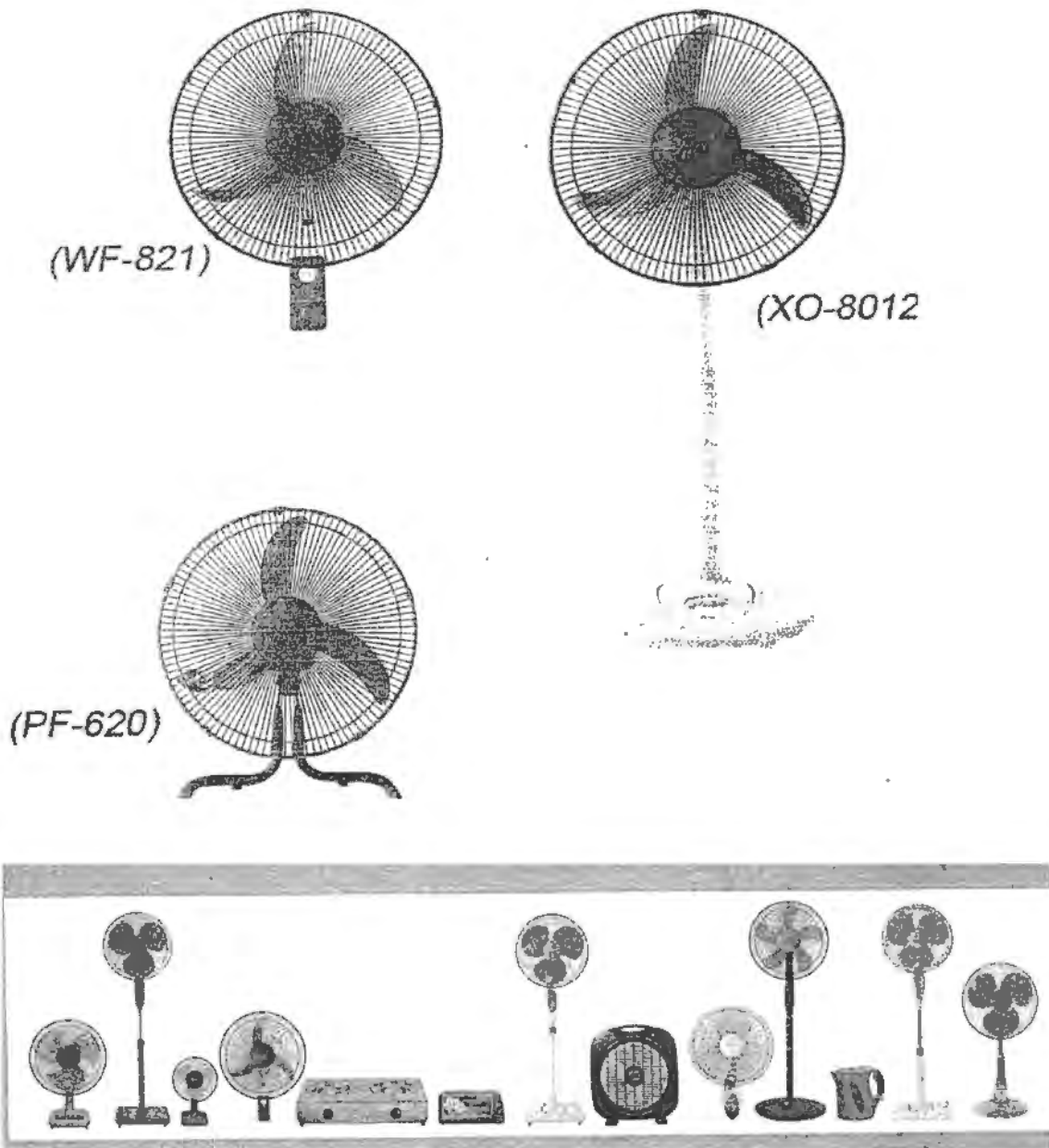
1. Power Series electric fans are made out of A.S. or Acrylonitrill Styrene with the middle circular part being made out of engineering plastics or Acetyl, which are either in shaded colour or transparent hue;
2. Power Series Fan Blades weight range, is 130 to 140 grams; and
3. Power Series Fan Blades, Asahi-branded Fan Blades are angularly-shape.

Product brochures featuring Asahi-branded Aerodynamic Fans and/or Power Series Fan Blades as shown below:

<sup>3</sup> 113.1 IP Code Rule 301 of the Rules and Regulations on Industrial Design.

<sup>4</sup> Bernhardt L.L.C. vs. Collezione Europa USA Inc. No. 04-1024, Fed. Cir. 20 October 2004.





On the other hand, the characteristic feature of the subject Industrial Design is as follows:

The present design for an Aerodynamic Fan Blade resides in a fan blade having a generally tubular main body with a number of blades disposed at an angle in respect to the said tubular body.

The pertinent drawings of the subject Industrial Design are depicted below:

Figure 1 is a front view of the present design for an aerodynamic fan blade.

Figure 2 is a perspective view of the same

*just*

Figure 3 is a back view of the same; and

Figure 4 is a side view thereof.

**Claim:**

The ornamental design for an aerodynamic fan blade as substantially shown:

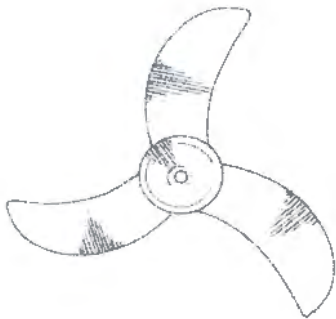


FIG. 1



FIG. 2

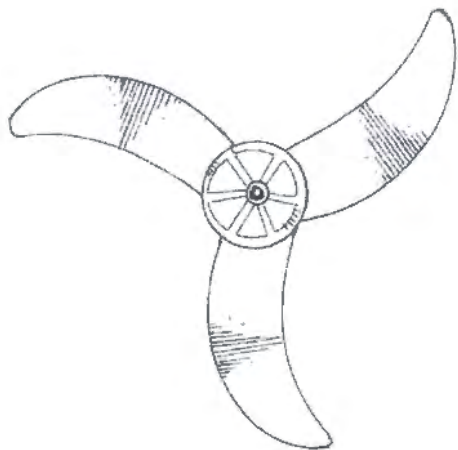


FIG. 3



FIG. 4

The Subject Industrial Design No. 3-2009-000488 is also covered by a Utility Model Registration No. 2-2010-000196, both in the of the Respondent and under the same title, to wit:

**An Aerodynamic Fan Blade**

*just*

Interestingly, both the Industrial Design and the Utility Model Patent Registrations are of the same shape/configuration as shown in their respective drawings/figures.

After a judicious evaluation of this instant Petition and the evidence on records, this Bureau finds the Petition meritorious. It is a fact that the Respondent-Registrant filed his Industrial Design application only on 31 July 2009, while the Petitioner's fan design and/or Products Power Series Fan Blades were already sold in the market in the year 2002, several years ahead of the assailed Industrial Design application.

This Bureau agrees with the Petitioner in its argument that since the Respondent-Registrant claimed on 25 July 2011, that Petitioner's fan design is the same or deceptively similar to the design of his Aerodynamic Fan Blade, hence, it is really no longer new. Sections 23 and 24 of the IP Code provides:

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*, 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 applications: *Provided further*, That the applicant or the inventor identified in both applications are not one and the same.

With the admission of the Respondent-Registrant that Petitioner's Fan Blades as prior art<sup>5</sup>, it is no longer necessary to belabor on the issue of whether or not the Petitioner's products would render the Respondent-Registrant's Industrial Design not novel.

Notwithstanding the admission of the Respondent-Registrant, the Petitioner submitted evidence to prove its allegations that the subject Industrial Design is not new as it forms part of a prior art, such as its Power Series Electric Fan Blade.

In sum, the Subject Industrial Design and the Petitioner's Power Series Fan Blades refer to:

1. An Aerodynamic Fans Blade made out of a plastic material acrylonitrile styrene;
2. An Aerodynamic Fans Blade having a lightweight; and
3. An Aerodynamic Fans Blade with a central bore or middle circular part made out of a transparent plastic material ad angularly shaped.

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<sup>5</sup> Exhibit "J" of Opposer.



Significantly, Section 113.2 of R.A. No. 8293 of the IP Code provides:

Sec. 113.2 Industrial designs dictated essentially by technical or functional considerations to obtain a technical result or those that are contrary to public order, health or morals shall not be protected.

As previously discussed, Subject Industrial Design Reg. No. 3-2009-000488 is also covered by a Utility Model Reg. No. 2-2010-000196, also in the name of the Respondent-Registrant and under the same title, "An Aerodynamic Fan Blade".

Under the Utility Model Reg. No. 2-2010-000196, the specification clearly stated, to wit:

"It is noted that the angularly shaped is together with the desired weight provides a maximum delivery of air flow with much higher volume and eases the load burden to the motor of the electric fan making the aerodynamic fan blade of the present Utility Model ideal for electric or industrial fan usage."

Thus, the subject Industrial Design with angular shape of the fan blade<sup>6</sup> dictates essentially a technical or functional result/consideration, to wit: to provide a maximum delivery of air with a much higher volume, thereby easing the load burden to the motor of the electric fan.

Accordingly, this Bureau finds that the Respondent-Registrant's Industrial Design Reg. No. 3-2009-000488 should be cancelled for lack of novelty and in violation of Section 113.2 of the IP Code.

**WHEREFORE**, premises considered the instant Petition for Cancellation is hereby **GRANTED**. Let the filewrapper of Industrial Design No. 3-2009-000488 be returned, together with a copy of this Decision, to the Bureau of Patents for information and appropriate action.

**SO ORDERED.**

Taguig City. 18 NOV 2016

Atty. GINALYN S. BADIOLA, LL.M.  
*Adjudication Officer, Bureau of Legal Affairs*

<sup>6</sup> As shown in Utility Model Reg. No. 2-2010-000196.