

**YAN YAN INTERNATIONAL
PHILIPPINES, INC.,**
Petitioner,

-versus-

WILSON DY GO,
Respondent- Registrant.

X-----X

} **IPC No. 13-2013-00080**
} Petition for Cancellation of:
} ID Reg. No. 2-2010-000688
} Date Issued: 10 January 2011
} **TITLE: "LIQUID PACKAGING"**
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}
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}
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 35 dated February 10, 2017 (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, February 10, 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

YAN YAN INTL. PHILIPPINES,

Petitioner,

-versus-

WILSON DY GO,

Respondent-Registrant.

x ----- x

IPC No. 12-2013-0080

Petition for Cancellation of

ID Reg. No. 2-2010-000688

Date Issued: 10 January 2011

Title: **"LIQUID PACKAGING"**

Decision No. 2017- 35

DECISION

Yan Yan International Philippines¹ ("Petitioner") filed a petition to cancel Industrial Design ("ID") Registration No. 2-2010-000688 issued to Wilson Dy Go² ("Respondent-Registrant") entitled "LIQUID PACKAGING".

The Petitioner alleges, among others, that the Respondent-Registrant's ID registration for "LIQUID PACKAGING" is substantially similar in function, shape and design to the Industrial Design 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 industrial design lacks in novelty. In support of the allegations in the instant 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, Calocan City.

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

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

The Respondent-Registrant filed his Answer on 29 May 2013 alleging, among others, that he did not come across ID Registration No. 3-2003-00315 or any liquid packaging similar to his industrial design registration. He claims that the Petitioner only filed the instant case in anticipation of his filing of an infringement case against the latter. He asserts that the two have the following differences:

5.2.1 Danny Co's design shows a plain tip portion, while Wilson Go's design has a scored tip with V-shaped cut which functions as a tearable tip as indicated in the corresponding utility mode registration of respondent-registrant;

5.2.2 Danny Co's design simulates a capped bottle as shown by a horizontal outline at the upper portion thereof, while Wilson Go's design has a tapering upper portion; and

5.2.3 Danny Co's design has prominent side fins, while Wilson Go's design has minimal side fins."⁴

The Respondent-Registrant's evidence consists of:⁵

1. his judicial affidavit, with annexes;
2. judicial affidavit of Rolando B. Saquilabon, with annexes; and
3. demand letter dated 11 December 2012.

The Adjudication 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 industrial design 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."**

Corollarily, Rule 137 of the Rules and Regulations on Utility Models and Industrial Designs state that:

⁴ See Answer, p. 6.

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

"Rule 317. Cancellation of design registration. 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 of the IP Code;**
- (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."

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 Registration Nos. 3-2003-000315 and 3-2010-000688 are reproduced hereafter for a side-by-side comparison:

ID Reg. No. 3-2003-00315

ID Reg. No. 3-2010-000688



ID Reg. No. 3-2003-00315

ID Reg. No. 3-2010-000688



Figure 1



Figure 2



Figure 3



Figure 4

There is no doubt that the questioned industrial design is practically a copy of the previously registered design covered by ID Registration No. 3-2010-000668. Both feature a bottle-like design with a thick body and slimming tip. Even if viewed in different angles, they are substantially similar. The only notable differences are their thickness and the reduced flaps in the Respondent-Registrant's design, which however, are not sufficient to consider the latter novel. An industrial design shall not be considered new if it differs from prior designs only in minor respects that it can be

mistaken as such prior designs by an ordinary observer.⁶ Likewise noteworthy, the Petitioner submitted a Registrability Report⁷ where ID Registration No. 3-2003-000315 was cited as Category X (Document of particular relevance in determining novelty of the claimed application). In this regard, Section 308.5 of the Rules and Regulations on Utility Models and Industrial Designs provides that:

"Rule 308.5. Registrability report. This report shall contain citations of relevant prior art documents with appropriate indications as to their degree of relevance which will serve as an aid to the parties concerned in the determination of the validity of the industrial design claim in respect to newness."

Finding that ID Registration No. 3-2003-000315 is substantially similar with the Respondent-Registrant's industrial design registration, the former is considered a prior art. 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."

WHEREFORE, premises considered, the instant petition for cancellation is hereby **GRANTED**. Let the filewrapper of Industrial Design Registration No. 3-2010-000688 be returned, together with a copy of this Decision, to the Bureau of Patents for information and appropriate action.

SO ORDERED.

Taguig City, **10 FEB 2017**


Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer, Bureau of Legal Affairs

⁶ Rule 302 of the Rules and Regulation on Utility Models and Industrial Designs.

⁷ Exhibit "I".