

SY TIAN HUI,	)	INTER PARTES CASE NO. 2070
Junior Party-Patentee,	)	
	)	INTERFERENCE BETWEEN:
	)	
	)	Appln. Serial No. UM-9715
	)	Patent No. UM-6178
	)	Issued : Sept. 5, 1986
	)	Patentee : Sy Tian Hui
	)	For : Easy to Hold
	)	Nursing Bottle
- versus -	)	
	)	- and -
	)	
	)	Serial No. D-5764
	)	Filed : Sept. 11, 1985
	)	Applicant : William O.
	)	Campbell, et. al.
	)	
	)	<u>DECISION NO. 92-11 (PAT)</u>
	)	
WILLIAM O. CAMPBELL, ET.AL.,	)	April 28, 1992
Senior Party-Applicant.	)	
x-----x	)	

DECISION

This is an Interference Proceedings declared by this Office between Sy Tian Hui, as Junior Party-Patentee and Messrs. William Campbell as Senior Party-Applicants.

The records show that the Junior Party-Patentee whose postal address is at Doneza Street, Balubaran Valenzuela, Metro Manila filed on 16 April 1986 a Utility Model Application for an easy to hold nursing bottle with Serial No. UM-9715. Said application matured into a patent with Letters Patent No. UM-6178 issued on 05 September 1986.

On the other hand, Senior Party-Applicants whose postal address is 2633 North Country Club Road, Muskosee, Oklahoma, U.S.A. filed on 11 September 1985, a design patent application with Serial No. D-5764 for a baby bottle.

On 17 July 1987, this Bureau issued the aforesaid declaration of interference on the ground of similarity between the subject matter in Patent No. UM-6178 and design Patent Application Serial No. D-5764. The similarity lies in the construction of a nursing bottle comprising a doughnut shaped body having an elliptical opening at the center.

As required in the notice of declaration of interference and pursuant to Rule 202 of the Revised Rules in Patent Cases, the Senior Party-Applicant filed their preliminary statement on 21 September 1988 while the Junior Party-Patentee submitted his preliminary statement on 16 September 1988.

During the pre-trial conference scheduled on 20 March 1989, the parties agreed to submit this case for decision based on the preliminary statements already on file and requested for time to file their respective memorandum. On 28 April 1989, the Senior Party-Applicants submitted their memorandum while the memorandum of the Junior Party-Patentee was filed on 29, May 1989. On 05 June 1989, a Reply memorandum was filed by the Senior Party-Applicants.

On 04 October 1988, this Office opened the sealed preliminary statements of the parties. For the Senior Party-Applicants, the following allegations were made:

“1. The date the design which is the subject of Philippine Design Application Serial No. D-5764, BABY BOTTLE, was made at least as early as December 1, 1983.

2. The date the first written description of the design was made is at least as early as January 11, 1984, a copy of which is attached as Exhibit A.

3. The date the design was first introduced to another person was on January 11, 1984 to the patent attorneys for Applicants, as indicated in Exhibit A. The date the design was offered for sale to a person of the public was August 5, 1984. Copies of the invoices related to the offer for sale are also attached as Exhibits B and C.

4. The date of the first act or acts susceptible of proof which would establish conception of the design and a brief description of the act is as follows:

The conception, as noted above, occurred as early as December 1, 1983. At that time, we realized that conventional, cylindrical baby bottles, in addition to being difficult to hold by our infant son, lacked an aesthetically pleasing external appearance, we experimented with modeling clay to create different shapes, designs for three-sided bottled, four-sided bottles and bottles with detachable handles were discarded. Finally, in December, 1983, we prepared the clay model shown in Exhibit D which is the subject of our application.

5. The date of actual reduction to practice of the design is discussed in 4. above.

6. In regard to diligence, reduction to practice is believed to have occurred shortly after conception, i.e., in December 1983, even though our first written evidence is dated January 11, 1984

7. The following is a list of the applications for the same design in a foreign country:

<u>Country</u>	<u>Patent No.:</u> <u>Issue Date</u>	<u>Serial No.:</u> <u>Filing Date</u>
West Germany	MR 25039; 01/09/86	
Benelux (Netherlands, Luxembourg, and Belgium)	14204-00; 10/31/85	
Great Britain	1,029,599; 10/02/85	
New Zealand	20044; 09/11/85	
Switzerland	11525; 06/26/86	

Canada	56799; 08/19/86	
Ireland	D7043; 06/03/86	
Canada	1,218,037; 02/17/87	
Spain		295,574; 06/25/86
Italy		36,214 B/85; 10/01/85
Japan		46560/85; 11/06/85
France		855,018; 10/25/85
Australia	95814 03/26/87	
Portugal		19,130; 06/30/86
Jamaica		D2/86; 08/13/86
Bahamas		88; 09/05/86

On the other hand the Junior Party-Patentee alleged the following:

“1. Mr. Sy Tian Hui has been in the business of manufacturing ordinary feeding bottles since June, 1982 for PAGODA Philippines.

2. Sometime in the early part of 1984, however, Mr. Sy Tian Hui was compelled to experiment with new designs because of the markedly decreased demand for the ordinary feeding bottle, and on account of his plan to manufacture on his own.

3. Sometime in June 1984, the idea of a doughnut shaped feeding bottle was conceptualized by Mr. Sy Tian Hui who, with the help of his employees prepared wax models from crude sketches.

4. Mr. Sy Tian Hui and his employee worked on these wax models, discarding, remaking and improving on them, until the wax model of the subject feeding bottle, in its present form was decided as the best to manufacture. For this purpose, the necessary molds were made sometime in January, 1986. The wax models have since been destroyed, but the molds remain in existence.

5. The subject utility model, although initially conceptualized by Mr. Sy Tian Hui as simply a doughnut shaped bottle, has evolved as a result and has

actually been the work of several persons. Thus, disclosure to third persons must be reckoned from June, 1984

6. The first drawing and written description of the subject utility model were made only in preparation for the filing of the patent application of 16 April 1986.”

As defined by Rule 191 of the Rules of Practice in Patent Cases, an interference is a proceeding for the purpose of determining the question of priority claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or an application and a patent. This interference proceeding was declared as a consequence of a common patentable subject matter defining a nursing bottle comprising of a doughnut shaped body having an elliptical opening at the center disclosed in the application of the Senior Party-Applicants as well as and in the patent of the Junior Party-Patentee. In as much as no full blown trial on the merits was conducted, as agreed upon the parties, this Office is therefore constrained to decide this interference based on the pleadings submitted by the parties.

In resolving the issue of priority of invention in an interference case, this Office, in the case of Alegre vs. Chua, Decision No. 474, March 7, 1968 considered the principle that “the first to conceive an invention and who additionally is the first to reduce to practice wins the interference”.

In paragraph 5 of the preliminary statement of the Junior Party-Patentee, it was mentioned that:

5. Mr. Sy Tian Hui and his employee worked on these models, discarding, remaking and improving on them, until the wax model of the subject feeding bottle, in its present form was decided as the best to manufacture. For this purpose, the necessary molds were made sometime in January, 1986. The wax models have since been destroyed, but the molds remain in existence.

Hence, the Junior Party-Patentee through his preliminary statement declared that the actual reduction into practice of the feeding bottle in question is January 1986.

On the other hand, Senior Party-Applicants have shown that on 05 August 1984, they have sold models of their feeding bottle design to the public as evidenced by the invoices submitted and marked as Exhibit “B” and “C”, said actual feeding bottle design was alleged to have been reduced into actual practice based on clay models prepared in December 1983, which is way before the actual reduction into practice alleged by the Junior Party-Registrant.

Furthermore, the patents issued to the Senior Party-Applicant in Benelux Countries (dated 31 October 1985). Great Britain (02 October 1985) and New Zealand (dated 11 September 1985 clearly show the priority of invention by the Senior Party-Applicants.

WHEREFORE, premises considered, the Senior Party-Applicants are hereby DECLARED to have priority of invention over the nursing bottle design in question.

Consequently, Letters Patent No. UM-6178 issued on 05 September 1986 is hereby CANCELLED and Application Serial No. D-5764 is hereby GIVEN DUE COURSE.

Let the filewrapper of this case be forwarded to the Patent/Trademark Registry and EDP Division and Mechanical/Electrical Examining Division for their information and proper disposition in accordance herewith.

SO ORDERED.

IGNACIO S. SAPALO  
Director