

EXPO RUBBER INDUSTRIAL  
CORPORATION,  
Junior Party-Applicant,

INTER PARTES CASE NO. 2079

PETITION FOR CANCELLATION

Letter Patent No. D-3891  
Issued : August 5, 1987  
Patentee : Bun Liong L. Santos  
For : SHOE

-versus-

BUN LIONG L. SANTOS,  
Respondent-Applicant.

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DECISION NO. 88-59 (TM)

August 3, 1988

### DECISION

A petition for cancellation of Design Patent No. 3891 for shoe granted on August 5, 1987 to herein Respondent-Patentee, Bun Liong L. Santos of Quezon City, Metro Manila was filed on September 30, 1987 by herein Petitioner, Expo Rubber Industrial Corporation, a domestic corporation with principal office address at 562 Lara Street, Tondo, Manila.

The petition alleges that Design Patent No. 3891 is not new; neither is it original or inventive, alleging that more than six (6) months prior to the filing of the application for patent by Respondent-Patentee, the design was already known and/or used by others in the Philippines and other countries; was described and/or illustrated in printed publications circulated in the Philippines; and had been in public use and/or on sale in the Philippines and other countries.

On October 2, 1987, this Office sent a Notice to Answer registered mail with return card to Respondent-Patentee at his given address at 57 Road Valley, Cubao, Quezon City, requiring him to answer the petition within fifteen (15) days from receipt thereof. Having failed to file an answer despite proper receipt of the said notice, Respondent-Patentee was declared in default under Office Order No. 88-60 issued on February 22, 1988. Thereafter, the case was set for hearing for the ex-parte reception of Petitioner's evidence.

Admitted as Petitioner's evidence were documents marked Exhibits "A" to "F", inclusive of sub-markings, and the oral testimony of Danilo de Leon Domingo, the Vice-President and Administrative Manager of the above-named Petitioner.

We must resolve whether or not Petitioner is entitled to cancel Letters Patent No. 3891 on the ground that the design is not new within the context of law at the time of the application thereof for a letters patent.

Section 55 of Republic Act 165, as amended, reads:

"SEC. 55. Design patents and patents for utility models. – (a) Any new, original and ornamental design for an article of manufacture and (b) any new model of implements or tools or of any industrial product, or of part of the same, which does not possess the quality of invention, but which is of practical utility by reason of its form, configuration, construction or composition, may be protected by the author thereof, the former by a patent utility model, in the same manner and subject to the same provisions and requirements as relate to patents for inventions in so far as they are applicable, except as otherwise herein provided.

The standard of novelty established by section nine hereof for invention shall apply to ornamental designs. (Underscoring supplied)

Conjunctively, Section 9 of the said Act provides:

“SEC. 9. Invention not considered new or patentable. - An invention shall not be considered new or capable of being patented if it was known or used by others in the Philippines before the invention thereof by the inventor named in an application for patent for the invention, or if it was patented or described in any printed publication in the Philippines or any foreign country more than one year before the application for a patent therefore; or of it is the subject matter of a validly issued patent in the Philippines granted on an application filed before the filing of the application for patent therefor.” (Underscoring supplied)

For purpose of determining the required period of publication for design patents, Section 56 of the same law reads:

“SEC. 56. Six months publication. – The period of one year specified in section nine, Chapter II, and section fifteen, Chapter III, hereof, for inventions shall be six months in the case of designs.” (Underscoring supplied)

Certificate of Letters Patent No. D-3891 (Exhs. “E” to “E-3”) indicates that the design claimed by Respondent-Patentee is characterized by a U-shaped strip on each side of the upper shoe. An actual comparison of Respondent-Patentee’s shoe design as appearing in the drawing of his application with that of the shoe (Exh. “F”) designed and used by Tretorn of Sweden reveals that their respective designs are strikingly similar to each other. Both shoes show identical designs of a U-shaped strip on the side of the upper portion of the shoe.

Design Letters Patents No. 3891 likewise disclose its date of filing to be June 2, 1987. Clearly, then, it lacks of novelty. The Footwear News Magazines dated April, 1983 (Exh. “B”), November 19, 1984 (Exh. “C”) and September 22, 1986 (Exh. “D”) publishing the Tretorn Shoes, by their dates of publication, confirm Petitioner’s allegation that more than six (6) months prior to the filing by Respondent-Patentee of his design application, the design sought to be patented was already known, used by others, described or illustrated in printed publications circulated in the Philippines and had been in public use and sale in the Philippines and in other countries as provided by Section 55, 9 and 56, supra.

Likewise, Respondent-Patentee’s silence, despite proper notice of the petition for cancellation, is constructed by this Bureau under the attending circumstances as a virtual recognition of Petitioner’s right over the subject design.

WHEREFORE, premises considered, the herein petition for cancellation filed by Expo Rubber Industrial Corporation is hereby GRANTED. Accordingly, Letters Patent No. D-3891 issued on August 2, 1987 to Bun Lion L. Santos is hereby ordered CANCELLED.

Let the records of this case be remanded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO  
Director