

SENTINEL PLASTICS MANUFACTURING,
Petitioner,

-versus-

ISHIP LOGIPACK, INC.,
Respondent-Registrant.

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IPC No. 13-2010-00123
Petition for Cancellation
of Industrial Design

Reg. No. 3-2003-000820
Issued on : 09 June 2005

**Title: "CORRUGATED PLASTIC
DANBOARD SHEET"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 334 dated 30 September 2016
(copy enclosed) was promulgated in the above entitled case.

Taguig City, 30 September 2016.

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

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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SENTINEL PLASTICS MANUFACTURING, } IPC Case No. 13-2010-00123
Petitioner, } Petition for Cancellation of Industrial Design
 } Registration No. 3-2003-000820
-vs- } Issued on: 9 June 2005
 } Title: "**CORRUGATED PLASTIC**
ISHIP LOGIPACK, INC. } **DANBOARD SHEET**
Respondent-Registrant. }
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x-----x Decision No. 2016- 334

DECISION

SENTINEL PLASTICS MANUFACTURING, ("Petitioner")¹, filed a Petition for Cancellation of Industrial Design Registration No.3-2003-000820. The registration issued in the name of ISHIP LOGIPACK, INC., ("Respondent-Registrant")², entitled "CORRUGATED PLASTIC DANBOARD SHEET" was issued on 9 June 2005.

The Petitioner alleges that the subject matter claimed under ID Reg. No. 2-2003-000820/ "corrugated plastic danboard sheet" failed to meet the novelty requirement under Rep. Act. No. 8293, also known as the Intellectual Property Code of the Philippines (IP Code), to wit:

Section 23. - 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 application: Provided further, That the applicant or the inventor identified in both applications are not one and the same.

The Petitioner asserts that corrugated plastic sheets have been in existence and use for the past fifty (50) years. According to the Petitioner, "corrugated plastic sheets" or "corriboard" or "danboard" as they were originally denominated by its inventor, Toyo Unicon Co. Ltd (Japan), were first introduced in the Philippines by Taiyo Plastic Corporation of the Philippines in 1995.

¹ Philippine corporation with address at 60 West Ave., Quezon City.

² Philippine Corporation with address at Building 1, 123-125 Technology Ave., Phase 4, Laguna Technopark (LTI) Binan, Laguna



Before that time, corrugated plastic sheets have already been used widely in Japan in the 1960s. Immediately after that, it made its way from Japan to the rest of the world.³

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

1. Photocopy of the July 2002 Official magazine publication of Orbis Corporation;
2. Company Profile of Coroplast;
3. Company Profile of Kaysersberg Plastics;
4. Company Profile and history of Toyo Seikan Kaisha Group of Companies;
5. Company profile of Taiyo Plastic Corporation of the Philippines;
6. 1974 U.S. Patent for a Method for Continuously Making a Hollow Board Article of Thermoplastic Resin;
7. 2001 Patent for a Recyclable Hollow panel Made of Synthetic Resin;
8. 2001 Patent for a Cushioning Material Using Corrugated Plastic Board Material;
9. Company Profile of Convoy Containers;
10. Company History of Respondent-Patentee, Iship Logipack Incorporated; and
11. Print-out of webpages advertising corrugated plastic products, packages, boxes etc.⁴

The Respondent-Registrant filed its Answer on 8 September 2010, alleging among other things, the following defenses:

“It must be taken into account that this Honorable Office continued its recognition of the inventiveness of respondent’s patent when it REISSUED the same upon granting respondent’s Petition for 1st Extension Term Design, thereby extending its validity for another five (5) years or until December 2, 2013.

It is not only this Office which acknowledged that respondent is the first to introduce special corrugated plastic sheet bearing its design. In its Board Resolution No. 07-491, the PHILIPPINE ECONOMIC ZONE AUTHORITY or PEZA accorded respondent the pioneer status in the manufacture of special corrugated plastic.xxx”

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

1. Copy of Recommendation for Registration dated 22 October 2009;
2. Copy of Registration No. 2-2009-000399 issued on 7 December 2009; and
3. Copy of Registration No. 2-2002-000447 issued on 27 June 2006.⁵

The Preliminary Conference was set on 23 June 2011. During the Preliminary Conference, both parties were directed to file their position papers. The Petitioner and Respondent-Registrant filed their position papers on 27 July 2011 and 18 July 2011, respectively.

³ Petition for cancellation

⁴ Annex “A” to “K”

⁵ Exhibits “A” to “C”

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

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.

Corollary, Section 119 of the IP Code provides:

Section 119. *Application of Other Sections and Chapters.* - 119.1. The following provisions relating to patents shall apply mutatis mutandis to an industrial design registration:

Section 21. Novelty;

Sec. 24. Prior Art. Provided, That the disclosure is contained in printed documents or in any tangible form.

Section 24 of the IP Code in turn, states:

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

The Industrial Design Registration No. 3-2003-000820⁶ being challenged is a "corrugated plastic danboard sheet, the characteristic feature, as shown in the registration is reproduced below:

⁶ Annex "1"

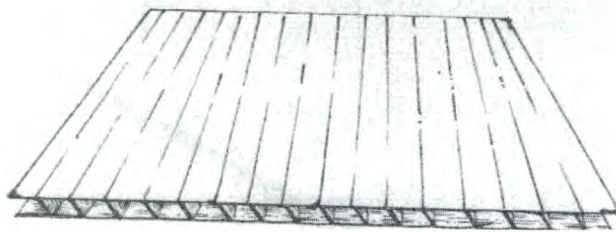


Figure 1

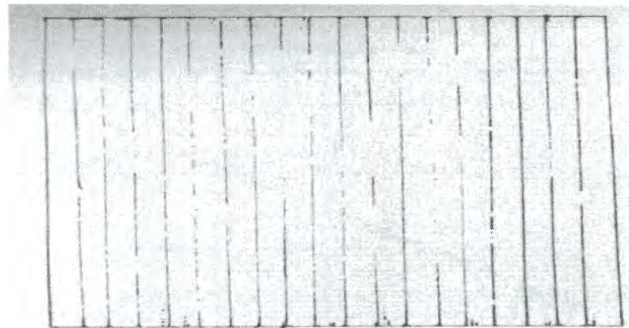


Figure 2

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 to and can serve as pattern for an industrial design.⁷ In the instant case, it is clear that corrugated plastic danboard sheets *per se* are no longer new. The Petitioner submitted evidence to show the availability and production of corrugated plastics/corrugated board plastics⁸ by various entities. The issue of novelty must be weighed in respect of the new design of corrugated plastic sheets. To prove that the subject design has been anticipated by prior art, it is necessary to show that all elements of the subject industrial design are present in one single prior art reference. The Supreme Court in *Angelita Manzano v. Court of Appeals*⁹, held:

For anticipation to occur, the prior art must show that each element is found either expressly or described or under principles of inherency in a single prior art reference or that the claimed invention was probably known in a single prior art device or practice. (*Kalman v. Kimberly Clark*, 218 USPQ 781, 789)

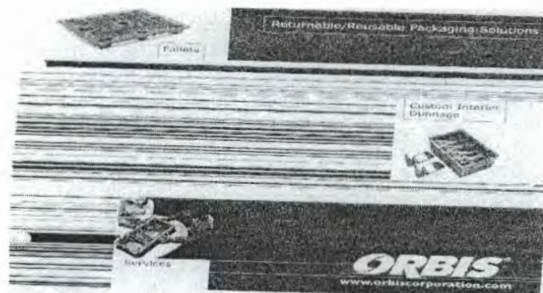
It is observed from the pictures of corrugated plastic sheets presented by the Petitioner, that the containers have a different design from the subject registration, as seen below:

⁷ Section 112, Rep.Act. No. 8293

⁸ Annex "C" to "F"; "P" to "Z"

⁹ G.R. No. 113388, September 5, 1997

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Annex "C"

The Respondent-Registrant's contention that its design is new because it has been granted pioneer status by the PEZA is misleading because the government agency does not conduct a prior art search or examination of relevant art. At any rate, a cursory inspection of all the evidence submitted by the Petitioner, the Bureau could not find a single prior art reference that contains all the elements and features that is similar in all respects to the Respondent-Registrant's design or one that existed before the Respondent-Registrant's filing date. In the case of *Angelita Manzano v. Court of Appeals*, the Supreme Court held:

The element of novelty is an essential requisite of the patentability of an invention or discovery. xxx It has been repeatedly held that an invention must possess the essential elements of novelty, originality and precedence, and for the patentee to be entitled to the protection the invention must be new to the world.

Hence, a utility model shall not be considered "new" if before the application for a patent it has been publicly known or publicly used in this country or has been described in a printed publication or publications circulated within the country, or if it is substantially similar to any other utility model so known, used or described within the country.¹⁰

To reiterate, there records are bereft of any claim by the Respondent-Registrant that it invented or discovered the corrugated plastic sheets nor claimed to have improved the efficacy or strength of such product for that matter. The registrability of an industrial design depends on its newness and its capacity to serve as a new design or pattern to an industrial product. There being no prior art substantially similar to the industrial design of the Respondent-Registrant, it is presumed that the patent examiners have correctly determined the registrability of the subject design. The Supreme Court in the case of *De Leon v. Aguas*¹¹, held:

The validity of the patent issued by the Philippines Patent Office in favor of the private respondent and the question over the inventiveness, novelty and usefulness of the improved process therein specified and described are matters which are better determined by the Philippines Patent Office. The technical staff of the Philippines Patent Office, composed of experts in their field, have, by the issuance of the patent in question, accepted the thinness of the private respondent's new tiles as a discovery. There is a presumption that the Philippines Patent Office has correctly determined the patentability of the improvement by the private respondent of the process in question.

¹⁰ G.R. No. 113388 September 5, 1997


¹¹ G. R. L. 32160 January 30, 1982

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WHEREFORE, premises considered, the Petition for Cancellation is, as it is hereby DISMISSED. Let the file wrapper of Industrial Design Registration No. 3-2003-000820 together with a copy of the DECISION be returned to the Bureau of Patents (BOP) for appropriate action.

SO ORDERED.

Taguig City, 30 SEP 2016


Atty. **ADORACION U. ZARE, LLM**
Adjudication Officer
Bureau of Legal Affairs