

Decisions of the Director of Patents

REPUBLIC OF THE PHILIPPINES
DEPARTMENT OF COMMERCE AND
INDUSTRY
IN THE PHILIPPINES PATENT OFFICE

Patents Decision No. 2 Ser. 1952

EX PARTE A. T. ICASIANO

A. T. Icasiano, Appellant

Adolfo A. Scheerer, of Manila, for the
Patent Appl. Ser. No. 23, filed
May 24, 1948

APPEAL FROM DECISION OF
PRINCIPAL EXAMINER

DECISION

This is an appeal from the decision of one of the Principal Patent Examiners rejecting the application of ARISTO TANTOCO ICASIANO for an alleged invention, which the applicant has entitled, "Bamboo Board which is Rigid, Solid, Light, and Durable as a Material for Building and Construction Purposes, and which is Resistant to Heat, Weather, Abrasion, and to Deteriorations Caused by Fungus, Termites or other Insects."

The application is for a product invention, containing three claims as follows:

"(1) A BAMBOO BOARD, rigid, tough, solid and durable, made up of two layers or plies of woven bamboo strips, impregnated or coated with adhesive, and bonded together by application of pressure with or without heat, depending on the type of adhesive used, to be used as a building or construction material and for other uses:

"(2) A BAMBOO BOARD which has the same properties and similarly manufactured as the bamboo board described under claim No. 1 above, but more rigid, heavier and tougher, being made up of three or more layers (plies) of woven bamboo strips; and

"(3) A BAMBOO BOARD which has essentially the same properties and is similarly manufactured as the bamboo boards described under claims Nos. 1 and 2 above, but which is lighter and flexible, being made up of a single layer or ply of woven bamboo strips."

The making of these boards is described by the applicant in the specifications, as follows:

"My boards consists of bamboo strips and an adhesive of synthetic origin, such

as phenolic resins, urea resins, etc. The adhesive may also be of animal origin, such as case in, blood albumen, etc., or of vegetable origin, such as natural resins, rubber latex, etc., or a combination of any two or more of the above types of adhesives; but if adhesive of animal or vegetable origin is used the product will be less durable.

"In preparing the board, strips of bamboo are impregnated or coated with synthetic resin adhesive, such as phenolic or urea resins. The strips are then woven according to the desired pattern and two layers (plies) of woven strips are permanently bonded together by application of pressure by means of a press, or some device which will give a similar action, with or without heat depending on the type of synthetic resin adhesive used. If so desired, the strips may first be woven before the application of the adhesive.

"For a more rigid and tougher board, three or more layers (plys) of adhesive-treated woven bamboo strips are ply-bounded. For a lighter board with some flexibility, only one layer (ply) of woven strips is used. To secure more artistic effect, the bamboo strips may be stained with any desired color before applying the adhesive and before weaving."

The Principal Examiner rejected all these three product claims on the ground of lack of novelty and lack of invention.

On the point of novelty, the Principal Examiner was of the opinion that the bamboo products described in the three claims were not new in the sense of Sec. 9 of the patent law, in that:

(a) bamboo products become *tough* and *durable* and *light* because of impregnation with resins, such as phenolic or urea resins, were matters already within existing knowledge, some such products having been disclosed in United States Patent No. 2,352, 740, granted to Shannon on July 4, 1944; (b) boarding materials consisting of separate thin plies, become *solid* and *rigid* because of bonding together with adhesives (among them, phenolic and urea resins) and pressure, were known to have been manufactured in the past, the well-known "plywood" being a particular example of such type of boarding material.

On the point of invention, the Principal Examiner was of the opinion that there could possibly be no invention (as

this word is understood in patent law) in a boarding material fashioned in practically the same way and possessed basically of the same characteristics as "plywood", the only difference existing between the two boards being that, while the one is made from bamboo plies, the other is fashioned from wood plies. The Principal Examiner believed, the applicant's boards to be a case of mere substitution of materials (bamboo for wood); which substitution, he said, can never, under the well settled principles of the patent law, impart to any device or product the dignity of an invention.

Reference to the patent to Shannon, cited by the Principal Examiner, shows it to be for a method of treating bamboo with resins for the purpose of imparting to it certain characteristics.

Claim 2 of the said patent, which may be considered as representative of all the claims, is hereinafter quoted.

"2. Method of impregnating bamboo containing cells and intercellaneous cell walls with a synthetic resin of the group consisting of phenolic aldehyde resins and urea aldehyde resins, which comprises soaking the bamboo in water until the cells and cell walls are impregnated with water and thereafter, without substantial drying of the bamboo, susantating it in a watery solution comprising the synthetic resin until the cells and cell walls are impregnated with the resin, heating the treated bamboo in a humid atmosphere to decrease travel of the resin to the surface of the bamboo, and to insolubilize the resin and deposit it within and around the cells and cell walls."

Note Shannon's mention of the use of synthetic resins, such as phenolic and urea resins — the same resins the applicant ICASIANO employs in connection with his alleged invention.

Paragraph 3, page 2 of the specifications of the same Shannon patent describes the bamboo product resulting from processing the raw material with phenolic and urea resins, in accordance with the method outlined in Claim 2.

"By proceeding in the manner described herein it has been found possible to control the characteristics of the final product. The treated bamboo is somewhat heavier than the untreated material but is much stronger and, on the basis of equal strengths, a piece of bamboo treated in this manner is lighter in weight than untreated bamboo. The

finished product may be used for poles for pole vaulting, oars, sailboat masts, shafts of golf clubs and polo mallets, bristles for brushes, etc. Where the resin is baked hard after the woody base material is treated, the composite has great dimensional stability under any atmospheric condition and is resistant to abrasion; it is therefore useful for: propellers and other parts of aircraft, patterns for casting, phonograph needles, etc."

Note that Shannon asserts that the resulting bamboo product has the following characteristics not found in the unprocessed product: strength, lightness, stability, resistance to abrasion. Excluding rigidity and solidity—qualities to be expected when a number of thin, swaying plys are firmly bonded together—these are essentially the same attributes (rigid, tough, solid, light and durable) which the applicant ICASIANO claims to have in his specifications and Claims for his phenol-urea-resin-treated bamboo board.

We may reasonably assume that, like the applicant's product, Shannon's is also resistant to heat, water, weather, fungus, termites, and other insects, since such attributes in applicant's product result from treatment with phenolic and urea resins, and Shannon's is similarly treated.

From the foregoing, it should be evident that, in respect of its special attributes or characteristics—characteristics which would be absent, if the bamboo were not treated with phenolic and urea resins—the type of bamboo product claimed by the applicant ICASIANO as new, is not in fact new in the accepted sense of the patent law, since it is clearly anticipated by Shannon's earlier bamboo product possessing the same attributes or characteristics.

Reference to literature on plywood, glues, adhesives, and resins shows the following—

"So far as we can trace, one of the earliest mentions of the word 'plywood' in any standard dictionary appears in the Appendix of the 1931 Edition of Chamber's Twentieth Century Dictionary:

"n., a thin board made from three very thin layers of wood, the grain of the middle layer at right angles to the grain of the outer two, cemented together under pressure."

"Mr. Onion, in the edition of the *Shorter Oxford English Dictionary* previously mentioned, gives the origin of the word as being 'U.S. 1917 form of Ply (substantive 1: 'layer or thickness') wood."

"A compound wood made of three (two, etc.) thin layers glued or cemented together under pressure, and arranged so that the grain of one layer runs at right

angles to the grain of any adjacent layer." (Plywoods, their Development, Manufacture and Application by ANDREW DICK WOOD and THOMAS GARY LINDY, Chemical Publishing Company, Inc., Brooklyn, N. Y., U.S.A. 1943, page 9)

"PLYWOOD: A product made up of layers of veneer bonded with glue, often bonded with synthetic resin. Alternate layers have grain at right angles to increase strength and to reduce the tendency to 'shrink and split.'" (*Handbook of Plastics* by H. R. Simonds, A. J. Weith, and M. H. Bigelow, 2nd Ed., D. Van Nostrand Company, Inc., General Glossary, p. 1428)

"The glues and adhesives used in woodworking and plywood fall into six principal groups, with several minor types that will be mentioned briefly:

- animal
- vegetable
- casein
- soya bean
- blood albumin
- synthetic resins, phenolic and urea
- miscellaneous"

"Resin—A raw material, made synthetically, which is the basis for products called the plastics. Certain resins can be used to adhere pieces of wood, and these are called resin adhesives, less correctly resin glues. These adhesives are of relatively recent development and are much more durable than the older types of conventional glues.

"Phenolic resin adhesives are made from phenol and formaldehyde, harden only in the presence of heat, and are the most durable. They are available in liquid, powder, and film form.

"Urea resin adhesives are made from ureas and formaldehyde, harden when heated and in the presence of certain chemicals (catalysts or hardeners) this hardening can be rapid and at moderate temperatures." (*Modern Plywood* by Thomas D. Perry, Fourth Printing, 1945; Pitman Publishing Corporation, New York and Chicago, pages 55 and 13).

The foregoing technical information confirms the Principal Examiner's finding that, except for the basic material used in each case (wood, bamboo), there is absolutely no difference between plywood and the applicant's bamboo board, either in the process of manufacturing or in the resulting product. Each consists of a number of relatively thin layers, or plys, bonded together into a solid rigid board, tough and durable, by application, firstly, of adhesives (among them phenolic and urea resins) and, secondly, of pressure.

Upon these facts, it appears that the Principal Examiner's decision, rejecting all the three Claims in question was not in error.

The bamboo board of the type characterized in Claim 3 (single-ply) is undoubtedly a new commercial product, but it certainly is not a new or novel product in the sense of the patent law. The ply itself (locally known as sawale) is old. What applicant claims as patentably new is the old sawale through rigid, tough, and heated. Section 9 says that an alleged invention shall not be considered new, if it has been described in a printed publication in the Philippines or elsewhere. Shannon's patent, describing the qualities of bamboo products treated with his process (which is substantially similar to the process disclosed by the applicant herein) is a printed publication, since United States patents, like Philippines patents, are, after issue, printed and copies sold to the public. Applicant's alleged invention, as characterized in Claim 3, is thus not new, having been described in the earlier Shannon patent.

For the same reasons, while the bamboo boards characterized in Claims 1 and 2 (two or more plys bonded together, each ply being of the Claim 3 type) are new commercially, they cannot be new in the patent-law sense. Except for the substitution of bamboo plys for wood plys, these bamboo boards are in all respects the same as plywood, both in the method of manufacture and in the resulting product. As shown in the cited *Plywoods, their Development, Manufacture and Application* (1943), plywood and the method of its manufacture have been described in printed publications as far back as the year 1931. They are described in the *Handbook of Plastics* (first published July, 1943, second ed., Jan., 1949), and mentioned in *Modern Plywood* (1945).

There certainly can be no invention involved in the two types of bamboo board in question. They constitute no more than an extension of Shannon's original thought and of the original conception of commercial plywood. For that extension the skill of the mechanic was sufficient; the creative genius of the inventor was not necessary.

In *Smith v. Nichols*, 112 L. ed. 566, the Supreme Court of the United States said:

"x x x a mere carrying forward or a new or more extended application of the original thought, a change only in form, proportion or degree, the substitution of equivalents doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent."

Speaking of the U. S. patent law, which is similar to ours in respect of the requisites for patentability, the same tribunal said in *Cuno Engineering Corporation v. Automatic Devices Corporation*, 86 L. ed. 58:

"Under the statute, the device must not only be new and useful, but it must be an invention and discovery. That is to say, the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain."

It is urged by the applicant that his two types of bamboo board should be regarded both as novel and inventive in that (a) prior to applicant's alleged invention thereof, no one in the Philippines had ever thought of processing sawale and of bonding together several sheets of sawale so processed into a solid, thick, upright board, in the manner disclosed in his specifications; and (b) in that by his alleged invention he has substantially advanced the sawale-making industry, making sawale converted into the form he has conceived, useful for multifarious purposes, some of which purpose were impracticable before — for walls, partitions, panels, ceilings, shingles for roofs, door, windows, tiles, floorings, etc. and also for the manufacture of screens, table-tops, boxes, decorative articles, veneers, etc." (Specifications, p. 1, lines 6-10).

Conceding all these, the three Claims in question are still not allowable, for, after everything has been said in favor of the applicant's priority and of the many new uses of his bamboo boards, said boards still lack the one quality needed for their patentability — invention in themselves. The patentability of a product claim, it has been said, must be found in the product itself, and not solely upon alleged new functions or uses thereof. *In re Lewis* 108 F(2d) 248 (1939); and in claims for structure, patentability, it has been declared, must be found in the structure, not in the results obtained therefrom. *In re Luck*, 108 F(2d) 263 (1940). In *Buono v. Yankee Maid*, 77 F(2d) 274 (1935), the famous Judge Learned Hand said must be exclusively in the conception of the product; that, while that imposes a that a product Claim must stand upon its own invention; that the invention, severe standard, it is not severer than it

should be if the monopoly is to extend, as it does in such cases, to the product however made; for unless conception alone is the test and if the inventor may cke out his right by recourse to the ingenuity involved in any process or machine, he gains an unfair advantage, for the claims cover the products produced by processes and machines to which, by hypothesis, he has contributed nothing.

These considerations compel an affirmance of the decision appealed from, rejecting all three claims of applicant's Appl. Serial No. 23. Said decision is, therefore, affirmed.

AFFIRMED.

This decision is final for the purposes of Chapter XIII of the patent law relating to appeals from the Director of Patents to the Supreme Court.

Manila, Philippines, June 30, 1952.
(SGD.) CELEDONIO AGRAVA
Director of Patents

SOME INTERESTING LEGAL FACTS SAID OF THE U. S. PATENT OFFICES, WHICH APPLY TO THE PHILIPPINES PATENT OFFICE

The Judicial Nature of the Functions of the Patent Office.

The U. S. Supreme Court in *Butterworth, Commissioner of Patents v. the U.S. 28 L. ed. 656:*

"The general object of that system is to execute the intention of that clause of the Constitution, article I, section VIII, which confers upon Congress the power "To promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." The legislation based on this provision regards as the medium of the public advantage derived from his invention; so that in every grant of the limited monopoly two interests are involved, that of the public, who are the grantors, and that of the patentee. There are thus two parties to every application for a patent, and more, when, as in case of interfering claims or patents, other private interests compete for preference. The questions of fact arising in this field find their answers in every department of physical science, in every branch of mechanical art; the questions of law, necessary to be applied in the settlement of this class of public and private rights, have founded a special branch of technical jurisprudence. The investigation of every claim presented involves the adjudication of disputed questions of fact, upon scientific or legal principles, and is, therefore, essentially judicial in its character and requires the intelligent judgment of a trained body science and art, learned in the history of invention, and proceeding by fixed rules to systematic conclusions."

The U. S. Court of Customs and Patent Appeals in *California Packing Corp. v. Sun-Maid Raisin Growers*, relative to the trademark *Sun-Maid*, 64 F(2d) 370:

"In the case of *In re Barratt's Appeal*, 14 App. D. C. 255, it was stated, with respect to proceedings in the Patent Office, that they are so nearly akin to judicial proceedings as to be most appropriately designated as quasi-judicial." See, also, *American Fruit Growers, Inc. v. John Brandland, Ltd.*, 45 F. (2d) 443, 18 C. C. P. A. 790."

The District Court (Dist. of Columbia) in *Carter Carburator Corporation v. Commissioner of Patents*, 73 U. S. P. O. 278, (1947):

"(4) 3. The exercise of his jurisdiction by the Primary Examiner upon any reference to him by the Examiner in interference of a motion to shift the burden of proof calls into action the powers and functions exercised by a judge in his admission, rejection and evaluation of evidence and particularly so in an interference, such as No. 82, 382, wherein a party thereto claimed to be entitled to the benefit of the filing date of an earlier joint application filed not by himself alone but by himself and another. Such jurisdiction is truly judicial.

"11. Hunt's petition to review and reverse the ruling of the Examiners of Interferences dismissing Hunt's motion to shift the burden of proof" was not addressed to the Commissioner in view of his supervisory authority. The action taken thereon by the Commissioner may not be upheld on such hypothesis. His order of July 19, 1946 was not an exercise of supervisory power but was a review of the decision of the Examiner of Interferences, and in disregard and violation of Rules of Practice in the United States Patent Office Nos. 97, 101, 116, 122 and 124 which have the force and effect of a statute, x x x A petition may not be entertained by the Commissioner when it seeks to obtain indirectly a review of an examiner's judicial or quasi judicial decision from which no direct appeal lies by merely misnaming the action and calling it a petition. *Goss v. Scott*, 1901 C. D. 80; *Manny v. Easley v. Greenwood, Jr.*, 1889 C. D. 179, 181; *Waite v. Macy*, 246 U.S. 606, 608.

"(6) 12. The executive supervision and direction which the head of a department may exercise over his subordinate in matters administrative and executive do not extend to matters in which the subordinate is directed by statute or rule having the force of statute to act judicially, or quasi judicially. *Butterworth v. Hoe*, 112 U. S. 50."

The Rules of Practice of the Patent Office

The same district Court in the same case:

"(3.) 6. The Rules of the Patent Office have the force of a statute and are as binding upon the Commissioner and all officials of the Patent Office as upon applicants for patents and parties to interferences. *Westinghouse TrACTION Brake Co. v. Christensen*, 243 F. 901, 905 (C. C. A. 3); *Anderson v. Welch*, 1552, F. 2d 973; *Avery v. Chase*, 101 F. 2d 205, 210 (40 USPO 343, 347-347); *In re Kortzon*, 58 F. 2d 682 (13 USPO 345). Interference Law and Practice, by Rivise and Caesar. Vol. 1, p. 25, §10; Defendant's answer to Paragraph 8 of Amended Complaint."

Jurisdiction of the Department Head

The U. S. Supreme Court in the same case cited above:

"x x x x The conclusion cannot be resisted that, to whatever else supervision and direction on the part of the head of the department may extend, in respect to matters purely administrative and executive, they do not extend to a review of the action of the Commissioner of Patents in those cases in which, by law, he is appointed to exercise his discretion judicially. It is not consistent with the idea of judicial action that it should be subject to the direction of a superior, in the sense in which that authority is conferred upon the head of an executive department in reference to his subordinates. Such a subjection takes from it the quality of a judicial act. That it was intended that the Commissioner of Patents, in issuing or withholding patents, in re-issues, interferences and extensions, should exercise quasi judicial functions is apparent from the nature of the exami-

nations and decisions he is required to make, and the modes provided by law, according to which, exclusively, they may be reviewed."

PRACTICE BEFORE THE PHILIPPINES PATENT OFFICE

BY ATTORNEYS AND AGENTS

[Republic Act No. 637]

"Section 7. x x x x x.

"The Director may prescribe rules and regulations governing the recognition of attorneys, agents, or other persons representing applicants or other parties before his office in patent and trademarks cases, and may require such persons, attorneys or agents, before being recognized as representatives of applicants or other persons, that they shall show that they are of good moral character and in good repute, are possessed of the necessary qualifications to enable them to render to applicants or other persons valuable service, and are likewise competent to advise and assist applicants or other persons in the presentation or prosecution of their applications or other business before the Office. And the Director of Patents may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before his office any persons, attorney, or agent shown to be incompetent or disreputable, or guilty of gross misconduct, or gross discourtesy or disrespect towards any Patent Office official or examiner while the latter is in the discharge of his official duty, or who refuses to comply with the rules and regulations of the

Patent Office, or who shall, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant or other person having immediate or prospective business before the office, by word, circular, letter, or by advertising. The reasons for any such suspension or exclusion shall be duly recorded. And the action of the director may be reviewed upon the petition of the person so refused recognition or so suspended or excluded by the Supreme Court under such conditions and upon such proceedings as the said Court may by its rules determine.

"It shall be unlawful for any person who has not been duly recognized to practice before the Patent Office to hold himself out or knowingly permit himself to be held out as a patent or trademark solicitor, patent or trademark agent, or patent or trademark attorney, or otherwise in any manner hold himself out, either directly or indirectly, as authorized to represent applicants for patent or trademark in their business before the Patent Office, and it shall be unlawful for any person who has, under the authority of this section, been disbanded or excluded from practice before the Patent Office, and has not been reinstated, to hold himself out in any manner whatever as entitled to represent or assist persons in the transaction of business before the Patent Office; and any offense against the foregoing provision shall be a misdemeanor and be punished by a fine of not less than one hundred pesos and not exceeding one thousand pesos."

Decision on Montano Bail Plea

People of the Philippines, plaintiff, vs. Justiniano S. Montano, et al., accused, Crim. Case No. 11396, December 2, 1952, Court of First Instance of Cavite.

The determination of the plea for bail by Senator Montano is one of the spectacular legal steps taken by our courts of justice. Due to the high position being held by the defendant and the important questions involved therein, we are publishing this decision for the benefit of the readers.—The Editors.

ORDER
I.—INTRODUCTION

OCAMPO, J.:

This case is before this Court upon the application for bail of defendant Justiniano S. Montano, who stands charged herein together with several others with the complex crime of kidnapping with multiple murders and frustrated murders, committed in the manner specified in the information of the Special Prosecutor dated September 29, 1952. No bail was recommended, the charge

being for a capital offense. (Sec. 5, Rule 110).

The information of the Special Prosecutor was directly lodged with this Court. After conducting a preliminary investigation, this Court disposed that a warrant be issued for the arrest of Justiniano S. Montano and some of his co-accused against whom the existence of a "probable cause" had been shown. (Sec. 4, Rule 108). Hence, the instant petition for bail which was opposed by the Government.

In the determination of the right of the accused to be admitted to bail, precedents decree that it is now mandatory to conduct a separate proceeding (*Germylo v. Judge of First Instance of Ilocos Norte, G. R. No. L-3451, May 29, 1950*), which would imperatively involve the presentation of evidence in anticipation of the regular trial, nevertheless this Court decided to grant the request of counsel for the petitioners for a separate hearing. This hearing was summary in nature. In the interest of justice, however, both parties were afforded a wide

latitude in the presentation of their respective evidence, both in chief and in rebuttal. The hearing lasted during the month of October, in the course of which an Amended Information was filed by the Special Prosecutors on the 3rd of the same month.

At the outset, the Court laid down its clear-cut norm of conduct — that the hearing shall be conducted heedless of the high position of the person involved, and that each judicial actuation and every ruling to be laid down shall be unmindful of and irrevocable to the rank and eminence which the petitioner holds in Congress — in order to stress and vouch to the public at large who have been following these proceedings the supremacy of the law and the principle of equal justice before the law.

II.—FACTS OF THE CASE

(a) Evidence for the prosecution.

The concrete evidence for the prosecution discloses that at about five o'clock in the afternoon of August 31, 1952 (t.s.n. 71) se-