

ABBOT LABORATORIES, PETITIONER, VS. HON. CELEDONIO AGRAVA, DIRECTOR OF PATENTS, RESPONDENT.

G.R. No. L-4234. May 21, 1952

Ponente: BENGZON, J.

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BENGZON, J.:

Abbot Laboratories, a Philippine corporation, has appealed from the decision of the Director of Patents disallowing Patent Application Serial No. 77 on an invention relating to a medical preparation better known as "Tridione." The review is expressly authorized by Chapter XIII of Rep. Act No. 165 known as the Philippine Patent Law.

The application for patent was submitted in June 1948 by Abbot Laboratories of Illinois, U.S.A. and it represented that the invention was the same as that involved in three applications filed in the United States Patent Office by the inventor Marvin A. Spielman, (assignor of applicant) to wit: Application Serial No. 403,073 filed July 18, 1941; Application Serial No. 630,994 filed November 26, 1945; and Application Serial No. 779,424 filed October 11, 1947, the last two applications merely modifying the preceding one. And it made the specific request that pursuant to the provisions of Section 76 of the local Patent Law, priority rights be granted by virtue of the above United States Patent applications.

The appellee Director of Patents denied the request for priority on the ground that it had been filed out of time, i.e., after February 28, 1948.

Contending that the deadline was July 1, 1948—and not February 28, 1948—the Abbot Laboratories, a subsidiary of the applicant, interposed this appeal.

Root-cause of the controversy is section 76, fully quoted below for convenience:

"SEC. 76. Certain priority rights for filing application extended.—The rights of priority provided by section nine, Chapter II; section fifteen, Chapter III; and section fifty-six, Chapter XII hereof for the filing of applications for patent for inventions and designs, which rights had not expired on the eight day of December, nineteen hundred and forty-one, are extended until the first day of July, nineteen hundred and forty-eight, in favor of the citizens or subjects of countries which have extended, or which now extend, or which within said period ending the first day of July, nineteen hundred and forty-eight, shall extend substantially reciprocal privileges to citizens of the Philippines."

The Patent Office, argues the petitioner, has changed the above date, July 1, 1948 to February 29, 1948, even though it has no power to "alter and much less shorten the period expressly set by our Legislature as found in sec. 76."

The Director of Patents reasons out that inasmuch as Filipinos may enjoy in the United States priority rights similar to those granted by section 76, only up to February 29, 1948, therefore American citizens may invoke in the Philippines priority rights only up to February 29, 1948.

Explaining his position said officer quotes a note of the U.S. Secretary of State dated February 12, 1948 to the Philippine Ambassador, and the latter's reply thereto dated August 23, 1948. Both notes declare that, in the matter of priority patent rights, the deadline for Filipinos in the U.S. and for Americans in the Philippines is February 29, 1948.

This exchange of correspondence called "executive agreement" gave ground to petitioner's main proposition in this instance that the Executive Branch of our government has absolutely no power to abridge or curtail the period expressly fixed in section 76, that such executive agreement is illegal and that consequently, in applying it respondent committed reversible error.

The notes exchanged between the diplomatic representatives of the two nations are as follows:

"NOTE OF THE UNITED STATES SECRETARY OF STATE, DATED FEBRUARY 12, 1948, TO THE AMBASSADOR OF THE PHILIPPINES.

"* * * the question of the war-caused delay in the use of the right of priority arises. Section 76 of the Philippine Patent Law extends the right of priority for the filing of patents which accrued during the war period on a reciprocal basis with countries according substantially the same privileges to citizens of the Philippines. The Boykin Act (United States Public Law 690, 79th Congress) contains substantially the same provisions and, upon a statement by the appropriate Philippine officials indicating that Section 76 of the Philippine Patent Law is applicable to citizens of the United States, the United States Patent Office could apply Section 1 of the Boykin Act to citizens of the Philippines. It should be noted, however, that the present expiration date of the extension of the right of priority under the Boykin Act is February 29, 1948. Unless a further extension of time is provided for by Congressional action, benefits of the Act will apply only to cases filed before February 29, 1948."

"NOTE OF THE AMBASSADOR OF THE PHILIPPINES, DATED AUGUST 23, 1948, TO THE UNITED STATES SECRETARY OF STATE

"I am pleased to inform Your Excellency that my Government has instructed me to convey to your Government that the following text of the 3rd indorsement of the Director of the Philippines Patent Office, dated May 26, 1948 and concurred in by the Department of Commerce and Industry of my Government, represents the official position of the Philippine Government on the matter:

* * * * *

"In view of the statement of the Honorable, the Secretary of State of the United States that the U.S. Patent Office could consider the United States Boykin Act (which grants to foreigners substantially the same patent prior rights as those which Section 76 of the Philippine Patent Law accords to foreigners) applicable to citizens of the Philippines up to February 29, 1948, the Philippines Patent Office will likewise regard Section 76 of the Philippine Patent Law (Republic Act No. 165) applicable to citizens of the United States whose patent applications were received at the Philippine Patent Office between June 20, 1947 and February 29, 1948, both dates inclusive."

"It is the understanding of my Government that the aforesaid note of February 12, 1948 of the Department of State, as reiterated by its note of August 4, 1948, and this note signifying my Government's assent thereto shall constitute an agreement between the Republic of the Philippines and the United States on patent."

We find it unnecessary to delve into the question whether an official agreement between the diplomatic representative of this country and the corresponding official of another may have the effect of amending our statutes enacted prior to such agreement, because it is our opinion that the above notes do not change any part of section 76, nor abridge the period therein established. They merely constitute an interpretation or application of said provision in so far as Americans and Filipinos are concerned—interpretation which appears to be in

accordance with law.

The first letter, in effect, declares that, under the laws of the United States, Filipinos could be granted priority rights similar to those mentioned in sec. 76, provided their applications are filed on or before February 29, 1948. The second letter, answers that pursuant to such statement, the Philippine Government will grant Americans priority rights if applied for not later than February 29, 1948.

We must assume that the U.S. Secretary of State correctly stated the American law. Was the Philippine law properly read in the reply communication? We believe it was, because sec. 76 being essentially a reciprocity measure, it is no more than logical to conclude that if priority rights are not accorded Filipinos in the U.S. after February 29, 1948, an American who makes application here in June 1948 can not assert nor claim that at that time reciprocal privileges are extended to Filipinos in his country. There is no reason to suppose that the Legislature intended to give foreigners here preferential privileges in 1948 provided that their respective countries have given to Filipinos priority rights at any time, at some period in the past, e.g. in 1940-1941. The law clearly speaks of reciprocal privileges, and when Filipinos receive no preferences in the U.S. or any other foreign country, there is no reciprocal privilege to consider. Reciprocity is never a one-sided affair.

It is true that the section says "subjects of countries which have extended or which now extend or which within said period ending July 1, 1948 shall extend." It is also true that the U.S. "has extended" in its literal sense. Yet it is believed that the employment of the three tenses of the verb "extend" merely conveyed the legislative idea that foreigners here may invoke priority rights on or before July 1, 1948 provided that Filipinos in their countries enjoy similar rights, no matter when the law granting such right in their country was approved—whether before Republic Act 165, or at the same time, or afterwards.

In other words July 1, 1948 is the expiry date fixed by the Legislature beyond which the Director of Patents may not award priority rights to foreigners. The law does not imply that before that day he necessarily has to grant priority rights to any foreigner who can establish that sometime in the past his government had granted similar concessions to Philippine citizens, irrespective of whether at the time of such foreigner's application, Filipinos are actually afforded reciprocal privileges of priority in his own country.

Contrary to appellant's contention, in this case there was no alteration of the statutory limit. The Director of Patents merely declared that Abbot Laboratories of Illinois could not invoke section 76 in June 1948, because at that time Filipinos in the United States could not acquire patent priority rights therein.

A subordinate issue discussed by the appellant relates to respondent's holding that under section 9 of Act 165 the invention is unpatentable by reason of its having been previously published in the August 1944 number of the Journal of the American Chemical Society. Because the appellant's argument under this heading is premised on the alleged right to priority—which, as we find, does not exist—the point requires no further elucidation.

Having found for respondent on the main controversy, we deem it unnecessary to resolve the procedural question raised by the Solicitor-General regarding petitioner's personality to prosecute this appeal.

Wherefore, the decision of the Director of Patents denying the request for priority is affirmed. Costs against petitioner.

Paras, C.J., Feria, Pablo, Tuason, Montemayor, Bautista Angelo, and Labrador, JJ., concur.

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