

SECOND DIVISION

G.R. No. 214148 – PHILLIPS SEAFOOD PHILIPPINES CORPORATION, petitioner v. TUNA PROCESSORS, INC., respondent.

Promulgated:

FEB 06 2023

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CONCURRENCE

LAZARO-JAVIER, J.:

I concur with Justice Mario V. Lopez on his *ponencia* to grant the present Petition. I humbly opine, as the *ponencia* does, that there was no patent infringement committed by petitioner Phillips Seafood Philippines Corporation of Patent No. I-31138 entitled “*Method for Curing Fish and Meat by Extra Low Temperature Smoking*” owned by respondent Tuna Processors, Inc.

Antecedents

Respondent’s predecessor-in-interest Kanemitsu Yamaoka (Yamaoka) is one of the patentees of Philippine Patent No. I-31138. The independent claim of Patent No. I-31138 is the process of curing tuna meat by exposing it to filtered smoke cooled in a cooling unit to between 0° and 5°C, while retaining ingredients exerting highly preservative and sterilizing effects.

On May 5, 2003, Yamaoka filed an administrative complaint for patent infringement and preliminary injunction with prayer for the issuance of a temporary restraining order against petitioner before the Intellectual Property Office’s (IPO) Bureau of Legal Affairs. He alleged that petitioner appropriated their patented process in curing its tuna products. Petitioner denied infringing Patent No. I-31138 as its process does not require a cooling unit because the filtered smoke is only allowed to cool to ambient temperature before it is injected directly into the tuna meat.

The Bureau of Legal Affairs dismissed Yamaoka’s complaint for patent infringement, holding that petitioner’s process does not fall within the scope of Patent I-31138. Meanwhile, respondent substituted Yamaoka pending the latter’s appeal before the IPO’s Office of the Director General. The substitution became necessary in view of the supervening death of Yamaoka. The Office of the Director General eventually dismissed the appeal, which was initially affirmed by the Court of Appeals.

On February 28, 2014, however, the Court of Appeals amended its initial ruling and ordained that there was an infringement under the doctrine

of equivalents because both processes involve the burning of combustible material to produce smoke, filtration of the smoke; cooling of filtered smoke before curing, and curing the tuna meat with cold filtered smoke. Therefore, petitioner was found liable for patent infringement.

Reasons for Concurrence

There was no literal infringement committed by petitioner

In using literal infringement as test, resort must be had to the words of the claim. If the accused matter clearly falls within the claim, infringement is established. To determine whether the particular item falls within the literal meaning of the patent claims, the Court must juxtapose the claims of the patent and the accused product to determine whether there is exact identity of all material elements.¹

As illustrated by the *ponencia* via the table below, there is no exact identity of all material elements between petitioner's and respondent's tuna curing processes. Only the first two steps are identical while the rest are markedly different, viz.:²

PATENT I-31138	PETITIONER'S PROCESS
Step 1: Burning of smoking material at 250° to 400°C.	Step 1: Burning of sawdust at 250° to 400°C.
Step 2: Filtering of the produced smoke to remove mainly tar.	Step 2: Filtering of the produced smoke to remove tar, odor, and other impurities.
Step 3: Cooling of the filtered smoke in a cooling unit to a temperature <u>between 0° and 5°C</u> while retaining ingredients exerting highly preservative and sterilizing effects.	Step 3: Cooling of the filtered smoke at an <u>ambient temperature</u> .
Step 4: Smoking of tuna meat <u>by exposing it to the filtered smoke</u> cooled to between 0° and 5°C.	Step 4: Exposing the frozen tuna meat to the filtered smoke <u>by smoking and injection of the filtered smoke directly into the tuna meat</u> .
	Step 5: Cooling of the tuna meat injected with ambient temperature filtered smoke to 4°C to 5°C before the ocular inspection or -3°C during the ocular inspection.

There is no infringement under the Doctrine of Equivalents

The doctrine of equivalents states that an infringement also occurs when a device appropriates a prior invention by incorporating its innovative concept and, despite some modification and change, performs substantially the same function in substantially the same way to achieve substantially

¹ See *Godines v. CA*, 297 Phil. 375, 380 (1993).

² *Ponencia*, p. 26.

the same result.³ Applying the doctrine, it is clear that the assailed device: (a) appropriates the prior invention by incorporating its innovative concept; and (b) it performs substantially the same function, in the same way, with the same result.


To recall, here, the innovative step claimed by Patent No. I-31138 is the unique process of curing tuna meat by exposing it to filtered smoke cooled in a cooling unit to between 0° and 5°C. Respondent duly explained in the patent's *Summary of Invention* that this innovative step is employed to achieve maximum sterilizing, and decomposition and discoloration-preventing effects.

Notably, however, this innovative step is absent from petitioner's process. For while the innovative step uniquely requires the filtered smoke to be cooled specifically to between 0° and 5°C, petitioner's process only cools the filtered smoke to ambient temperature (around 24°C). Verily, it cannot be said that the two cooling steps are the same.

Neither was it established that petitioner's process, which injects the filtered smoke into the tuna **then** simultaneously cools the tuna meat and smoke to 4°C to 5°C then -3°C, performs substantially the same functions in substantially the same way to achieve substantially the same result as respondent's process. Relying on the Report of the technical expert Professor Teresita P. Acevedo, the *ponencia* explicated that the curing process occurs when the compounds in the filtered smoke **bind** with the myoglobin and hemoglobin of the tuna meat.

There was no evidence adduced, however, that the simultaneous cooling of the filtered smoke and tuna meat **after** the smoke had already been injected directly into the tuna meat (petitioner's process) achieves substantially the same result and performs substantially the same functions as when the filtered smoke was cooled **before** it is applied to the tuna meat (respondent's process).

ACCORDINGLY, I vote to **GRANT** the Petition and **REINSTATE** the Decision dated June 25, 2013 of the Court of Appeals.


AMY C. LAZARO-JAVIER
Associate Justice

³ *Supra*, note 1.