

Title: Taiwan Kolin Corporation, Ltd. vs. Kolin Electronics Co., Inc., G.R. No. 209843

Facts:

Taiwan Kolin Corporation, Ltd. (hereafter Taiwan Kolin) filed on February 29, 1996, an application with the Bureau of Patents, Trademarks, and Technology Transfer (now IPO) to register the trademark “KOLIN” for various goods under Classes 9, 11, and 21 of the Nice Classification (NCL). However, the application was considered abandoned for failure to respond to IPO’s requirement to select one class of goods. Taiwan Kolin then revived its application in 2002, focusing on Class 9 goods such as television sets and DVD players.

Kolin Electronics Co., Inc. (hereafter Kolin Electronics), which had a prior “KOLIN” trademark registration for different goods under Class 9, opposed Taiwan Kolin’s revived application. Kolin Electronics claimed prior registration in the Philippines, having overcome a previous opposition by Taiwan Kolin. The Bureau of Legal Affairs of the IPO (BLA-IPO) denied Taiwan Kolin’s application in 2007 for being identical to Kolin Electronics’ registered mark for related goods under Class 9. Upon appeal, the IPO Director General reversed the BLA-IPO’s decision, allowing Taiwan Kolin’s trademark application subject to restrictions. Kolin Electronics appealed to the Court of Appeals (CA), which reinstated the BLA-IPO’s decision.

Issues:

1. Whether Taiwan Kolin’s trademark application for “KOLIN” should be denied for being identical to Kolin Electronics’ registered mark for related goods under Class 9.
2. Whether the goods covered by Taiwan Kolin’s application are related to those covered by Kolin Electronics’ registration.

Court’s Decision:

The Supreme Court granted Taiwan Kolin’s petition, reversed the CA’s decision, and reinstated the IPO Director General’s decision.

1. Identical marks for products from the same classification: The Court held that mere categorization in the same class under the NCL did not automatically result in trademark infringement and stressed on the similarity of the products involved.
2. Unrelated products: The Court emphasized that products should be analyzed based on various factors to determine relatedness, including the business, quality, purpose, and channels of trade, and not solely on their classification. The Court found Taiwan Kolin’s goods (home appliances) unrelated to Kolin Electronics’ goods (power supply and audio

equipment accessories).

Doctrine:

The Supreme Court set forth the principle that identical marks may still be registered for products from the same classification, provided that the goods in question are not similar in terms of their function, purpose, and channels of trade. Additionally, the Court emphasized that relatedness between goods should be determined by a multifactorial approach beyond mere classification under the NCL.

Class Notes:

Essential concepts central to this case include:

- The categorization under the Nice Classification (NCL) is not the sole factor in trademark infringement cases.
- The multifactorial approach in determining whether goods are related, including factors such as business location, product class, quality, and channels of trade.
- Intellectual property rights, especially the granting of the exclusive right to use a registered mark and the potential for confusion among consumers.

The IP Code's relevant provisions include Section 123(d) regarding identical marks and Section 138 concerning the prima facie evidence of the registrant's exclusive rights.

Historical Background:

The historical context of this case involves the evolution of intellectual property laws in the Philippines and their alignment with international standards such as the TRIPS Agreement and the Paris Convention. The case also demonstrates the development of jurisprudence in the area of trademark conflicts, particularly regarding the interpretation and application of the IP Code's provisions on trademark registration, relatedness of goods, and consumer confusion.