

TELECOMMUNICATIONS TECHNOLOGIES	}	IPC No. 14-2005-00074
PHILS., INC.,	}	Opposition to:
Opposers,	}	Serial No. 4-2002-007124
	}	
-versus-	}	Date Filed: 08-26-02
	}	
TELETECH HOLDINGS, INC.,	}	TM: "TELETECH"
Respondent-Applicant.	}	
x-----x	}	Decision No. 2007 – 10

JUDGMENT  
 BASED ON COEXISTENCE AGREEMENT

For this Bureau's consideration is the parties' Coexistence Agreement filed on January 18, 2006.

The Coexistence Agreement executed by and between Opposer, Telecommunications, Technologies Phils., Inc. and Respondent-Applicant Teletech Holdings, Inc. provides, to wit:

"1. Opposer agrees to amend the Class 38 description for its Philippine Trademark Application No. 4-2002-009994 for the TELETECH mark from "telecommunications service" to telecommunications services (not including providing customer care and customer relationship management services for others or receiving and responding to sales, service, technical support and general information inquiries of customers of others), namely, providing telephone communication and internet telephony services; electronic voice messaging, namely the recording, storage and subsequent transmission of voice messages by telephone; providing multiple user dial-up, high speed and dedicated access to the internet, global computer networks, other computer networks, on-line services and bulletin boards; electronic transmission of messages, data, images, video and information via the internet; wireless transmission of voice messages, data and information; high-speed access services and wireless access services to the internet, global computer networks, other computer networks, on-line services and bulleting boards; cellular and mobile telephone communications; streaming of audio and video material on the internet; computer aided transmission of messages and images; private line voice, text, facsimile, video and data telecommunications services; integrated services digital network (ISDN) telecommunication services; the transmission over cable of entertainment services and voice, video, data and facsimile telephony services."

"2. Respondent agrees to amend the Class 38 services description for its Philippine Trademark Application No. 4-2002-007124 for the TELETECH mark from "telecommunication services, namely, providing telephone, electronic mail services and providing multiple-user access to a global computer information network" to telecommunications services, namely, providing customer care and customer relationship management services for others via telephone, electronic mail and providing multiple-user access to a global computer information network; receiving and responding to sales, service, technical support and general information inquiries of customers via telephone, electronic mail and multiple-user access to a global computer information network; receiving and responding to sales, service, technical support and general information inquiries of customers via telephone, electronic mail and multiple0user access to a global computer information network; receiving and responding to sales, service, technical support and general information inquiries of customers via telephone, electronic mail and

multiple-user access to a global computer information network; advanced computer telephony integration for intelligent routing and operational efficiency across all media; and computer telephony integration including email, chat and other custom media types.”

“3. Respondent agrees not to use or file an application for the registration of the mark TELETECH in the Philippines in connection with the Class 38 services used by Opposer, namely “telecommunications services (not including providing customer care and customer relationship management services for others or receiving and responding to sales, service, technical support and general information inquiries of customers of others), namely, providing telephone communication and internet telephony services; electronic voice messaging, namely the recording, storage and subsequent transmission of voice messages by telephone, providing multiple user dial-up, high speed and dedicated access to the internet, global computer networks, other computer networks, on-line services and bulletin boards; electronic transmission of messages, data, images, video and information via the internet; wireless transmission of voice, messages, data and information; high speed access services and wireless access services to the internet, global computer networks, other computer networks, on-line services and bulletin boards; cellular and mobile telephone communications; streaming of audio and video material on the internet; computer aided transmission of messages and images; private line voice, text, facsimile, video and data telecommunications services; integrated services digital network (ISDN) telecommunications services; the transmission over cable of entertainment services and voice, video, data and facsimile telephone services.”

“4. Opposer agrees not to use or file an application for the registration of the mark TELETECH in the Philippines in connection with any of the Class 9, 35, 38, 41 and 42 goods or services used by Respondent, namely “telecommunication services, namely, providing telephone, electronic mail and automated call services and providing multiple-user access to a global computer information network; advanced computer telephony integration for intelligent routing and operational efficiency across a media; and computer telephony integration including email, chat and other custom media types” in Class 9; “customer relationship management services and customer care services for others, namely, managing databases and receiving and responding to sales, service, technical support and general information inquiries of customers through a variety of media; employment agency services; and management of customer interaction management centers providing customer care and customer relationship management services” in class 35; “telecommunication services, namely, providing customer care and customer relationship management services for others via telephone, electronic mail and providing multiple-user access to a global computer information network; receiving and responding to sales, service, technical support and general information inquiries of customers via telephone, electronic mail and multiple-user access to a global computer information network; advanced computer telephony integration for intelligent routing and operational efficiency across all media; and computer telephony integration including email, chat and other custom media types” in Class 38; “education services, namely, training courses and seminars in the field of providing customer care and customer relationship management services, namely, services which focus on receiving and responding to sales, service, technical support and general information inquiries of customers of others” in Class 41; and “computer programming services for others, application service provider services, namely designing, installing, integrating, networking, hosting, operating and maintaining computer software solutions for others; database development services and technical consultation and implementation services in the field of customer care

and customer relationship management; product research and development for others; and computer disaster recovery planning services” in Class 42.

“5. Respondent agrees not to commence any opposition or cancellation action against any trademark application or registration which Opposer has filed, may decide to file, or has obtained in the Philippines for the mark TELETECH in connection with “telecommunications services, namely, providing customer with voice data, internet and telephone services” in class 38.

“6. Opposer agrees not to commence any opposition or cancellation action against any trademark application or registration which Respondent has filed, may decide to file, or has obtained in the Philippines for the mark TELETECH in connection with “telecommunication services, namely, providing telephone, electronic mail and automated call services and providing multiple-user access to a global information network; advanced computer telephony integration for intelligent routing and operational efficiency across all media; and computer telephony integration including email, chat and other custom media types” in Class 9; “customer relationship management services and customer care services for others, namely, managing data bases and receiving and responding to sales, service, technical support and general information inquiries of customers through a variety of media; employment agency services; and management of customer interaction management centers providing customer care and customer relationship management services, namely managing databases and receiving and responding to sales, service, technical support and general information inquiries of customers through a variety of media; employment agency services; and management of customer relationship management services” in Class 35; “telecommunications services, namely providing customer care and customer relationship management services for others via telephone, electronic mail and providing multiple-user access to a global computer information network; receiving and responding to sales, service, technical support and general information inquiries of customers via telephone, electronic mail and multiple-user access to a global computer information network; advanced computer telephony integration for intelligent routing and operational efficiency across all media; and computer telephony integration including email, chat and other custom media types” in Class 38; education services, namely training courses and seminars in the field of providing customer care and customer relationship management services namely, services which focus on receiving and responding to sales, service, technical support and general information inquiries of customers of others” in Class 41; and “computer programming services for others, application service provider services, namely, designing, installing, integrating, networking, hosting, operating, and maintaining computer software solutions for others; database development services and technical consultation and implementation services in the field of customer care and customer relationship management; product research and development for others; and computer disaster recovery planning services” in Class 42.

“7. The parties mutually recognize their respective rights to the concurrent use of their respective marks TELETECH for their respective goods and business in the Philippines as mentioned above and accordingly waive any cause of action that either party may have against the other for the use of said marks in the Philippines.

“8. This Agreement shall not be construed as to bind the parties to agree to the concurrent use of the mark TELETECH in other jurisdictions.

“9. The parties agree to file a Joint Motion for Judgment based on this Agreement to effect the dismissal of Inter Partes case No. 14-2005-00074.

“10. The parties shall cooperate in good faith to avoid any possibility of confusion resulting from their coexistence in the Philippines and shall take all commercially reasonable steps to sure any confusion that may occur. The parties agree to refrain from making in any manner whatsoever any steps to cure any confusion that may occur. The parties agree to refrain from making in any manner whatsoever any statement or representation or performing any act or using any name, mark symbol, or the like which (a) leads the public to believe that one party or its business, services or products, is in any manner, directly or indirectly, associated or causes confusion, mistake or deception as to the source or sponsorship of any of the other party’s businesses, products and/or services.

“11. Upon the execution of this Agreement, the parties irrevocably release and forever discharge each of their respective affiliates partners, divisions, departments, directors, officers, employees, agents, shareholders, accountants and attorneys and their heirs, successors, and assigns from all claims, demands, causes of action, costs, expenses, attorneys’ fees, obligations, indebtedness, liabilities, indemnities, claims over and any and all obligations relating to or arising out of the use by either party of their respective marks up until the date of this Agreement.

“12. The parties covenant and agree to prepare, execute, acknowledge, file, record, publish and deliver to the other party such other instruments, documents and statements, and take such other action as may be reasonably necessary or convenient in the discretion of the requesting party, to carry out more effectively the purposes of this Agreement.

“13. This Agreement is the entire agreement between the parties and constitutes the complete, final and exclusive embodiment of their agreement with respect to the subject matter hereof. This Agreement may not be amended except by written agreement executed by both parties.

“14. Each person signing the Agreement on behalf of a party warrants that he or she has full authority to do so on behalf of that party and to bind said party to the terms and conditions herein.

“15. This Agreement is executed without reliance upon any promise, warranty or representation by any party or any representative of any party other than those expressly contained herein.

“16. This Agreement shall bind and inure to the benefit of each party and its directors, officers, employees, parent corporations, subsidiaries, affiliates, predecessors, successors, licensees, agents and assigns.

“17. In the event of any breach of this Agreement, the non-breaching party shall be entitled to recover its reasonable attorney’s fees in addition to any other remedies it may have at law or in equity.

“18. Whenever possible, each provision of this Agreement shall be interpreted in such a manner as to be effective and valid under applicable law, but if any provision of this Agreement should be held invalid or enforceable under applicable law, such provision shall be ineffective to the extent of such probation or invalidity without invalidating the remainder of such provision or the remaining of this Agreement.

“19. The rights and remedies of the parties to this Agreement are cumulative and not alternative. Neither the failure not any delay by any party in exercising

any right, power or privilege under this Agreement shall operate as a waiver of such right, power or privilege shall preclude any other or further exercise of such right, power or privilege or the exercise of any other right, power or privilege.

WHEREFORE, finding the parties' Coexistence Agreement to have been duly executed and signed by the parties and the terms and conditions thereof to be in consonance with law, morals, good customs, public policy or public order, the same is hereby APPROVED. Accordingly, Application Serial No. 4-2002-007124 filed by Respondent-Applicant TELETECH HOLDINGS, INC. on August 26, 2002 for the trademark "TELETECH" is hereby AMENDED in accordance with paragraph 2 of the terms and conditions of the Coexistence Agreement. Consequently, the parties are hereby enjoined to faithfully comply with the terms and conditions of the Compromise Agreement, failure of which shall be cause for the erring party to be cited for indirect contempt after property charge and hearing.

Let the filewrapper of the trademark "TELETECH" subject matter under consideration together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 31 January 2007.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs  
Intellectual Property Office