

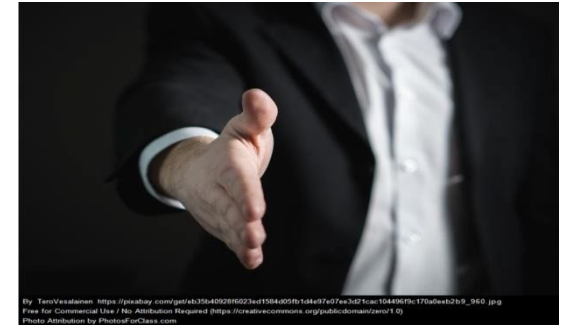
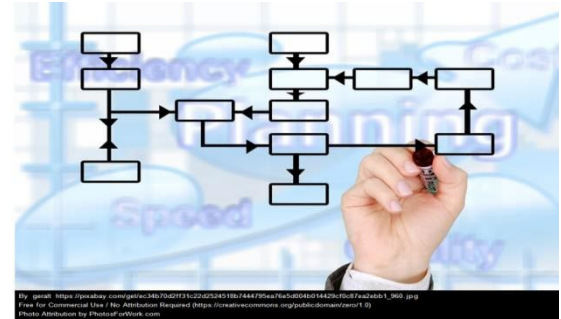
MEDIATION AND CONCILIATION AT THE EUIPO's BOARDS OF APPEAL

MEDIATION

DEFINITION OF MEDIATION

Article 3 of Directive 2008/52 EC of 21 May 2008:

- Structured process
- Voluntary
- Attempt to reach agreement by parties
- Intervention of mediator
- Initiated by the parties / court / law
- Distinct from judicial-led settlement



CHARACTERISTICS OF THE PROCESS

- Voluntary participation
- Attendance of all parties and their legal representatives (optimal)
- Focus on commercial interests and business solutions
- Neutral (impartial) assistance
- Flexible
- Confidential



CONFIDENTIALITY OF THE MEDIATION

- What happens in the mediation must be kept confidential.
- All persons involved (mediator, parties, representatives, advisors, experts and any other person present during the meetings) sign a **confidentiality agreement**.
- Separate mediator **e-mail accounts**.



CONFIDENTIALITY OF THE MEDIATION

- **No recording** of any kind shall be made of any meeting with the mediator
- Participants may **not** use or **disclose** any information concerning, or obtained in the course of mediation
- Mediator **destroys** all notes and documents at the close of the mediation

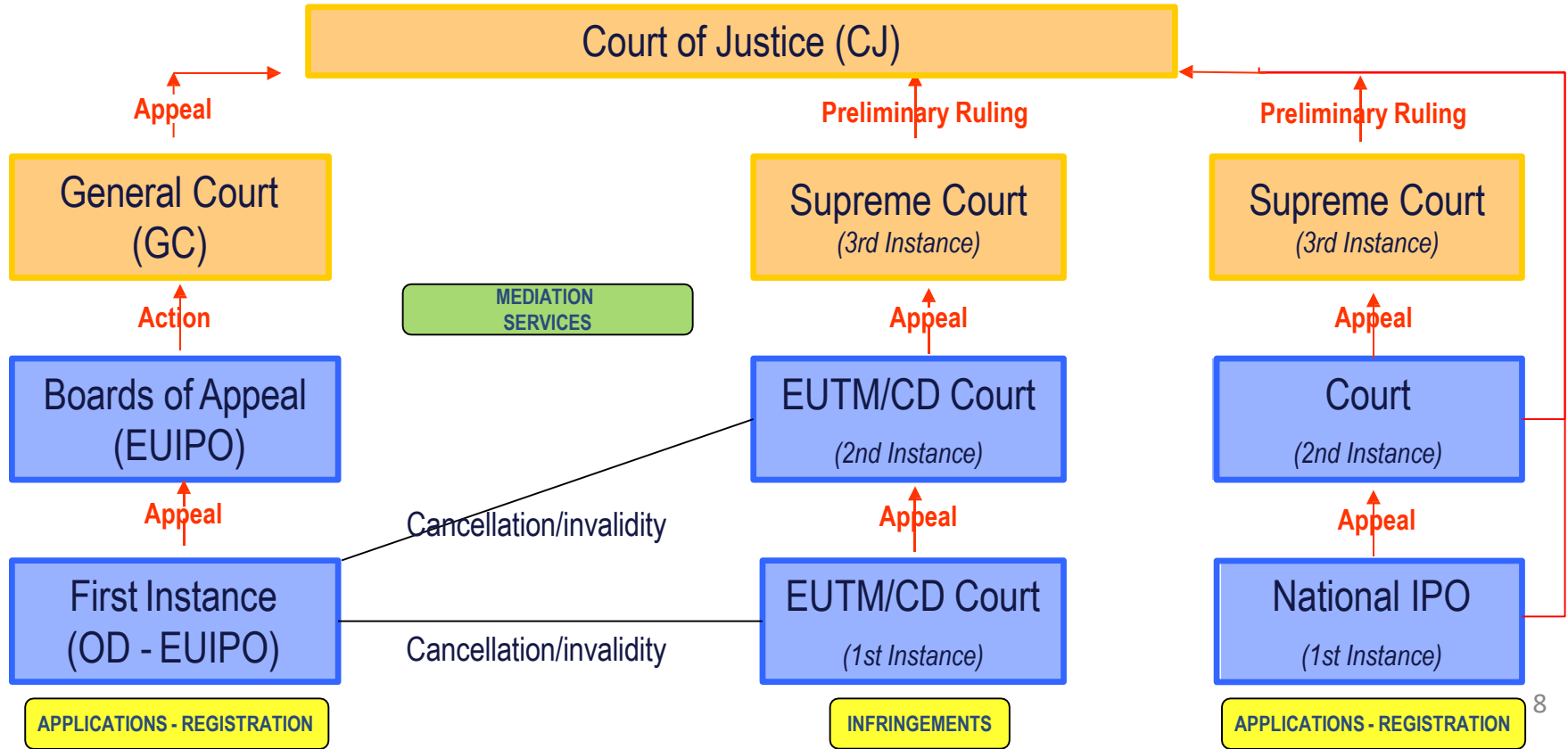


LEGAL FRAME WORK

- Articles 151 (3) and 170 EUTMR, Article 31(5) CDIR.
- Decision No 2013-3 of the Presidium of the Boards of Appeal of 5 July 2013 on amicable settlement of disputes (Mediation).
- Decision No 2014-2 of the Presidium of the Boards of Appeal of 31 January 2014 on the friendly settlement of disputes by the competent Board (Conciliation).
- Decision No EX-11-04 of the Executive Director of the administration charges related to Mediation.
- Rules on Mediation of the Presidium of the Boards of Appeal.
- Instructions to parties.



JURISDICTIONAL SYSTEM OF PROTECTION OF EUTM/CDR



WHEN?

- Only available in EUTM/RCD inter-partes proceedings (oppositions and cancellations based on relative grounds / invalidity);
- Only currently possible before Boards of Appeal;
- Need to file notice of appeal, statement of grounds and pay appeal fee;
- Mediation included in appeal fee.



STRUCTURED PROCESS

Scope of the Mediation

- Reach an agreement on the settlement of the dispute
- Not a judicial or extra-judicial decision



MEDIATION – EFFECTIVE DISPUTE RESOLUTION

Advantages of mediation:

- ✓ Cost and time-effective;
- ✓ Quick extrajudicial resolution of trade mark and design disputes;
- ✓ Process tailored to the needs of the parties;
- ✓ Promotes voluntary compliance by preserving amicable and sustainable relationships.



WHERE?



WHERE?



WHERE?



WHO?



**EXPERT
ADVICE**

WHO?



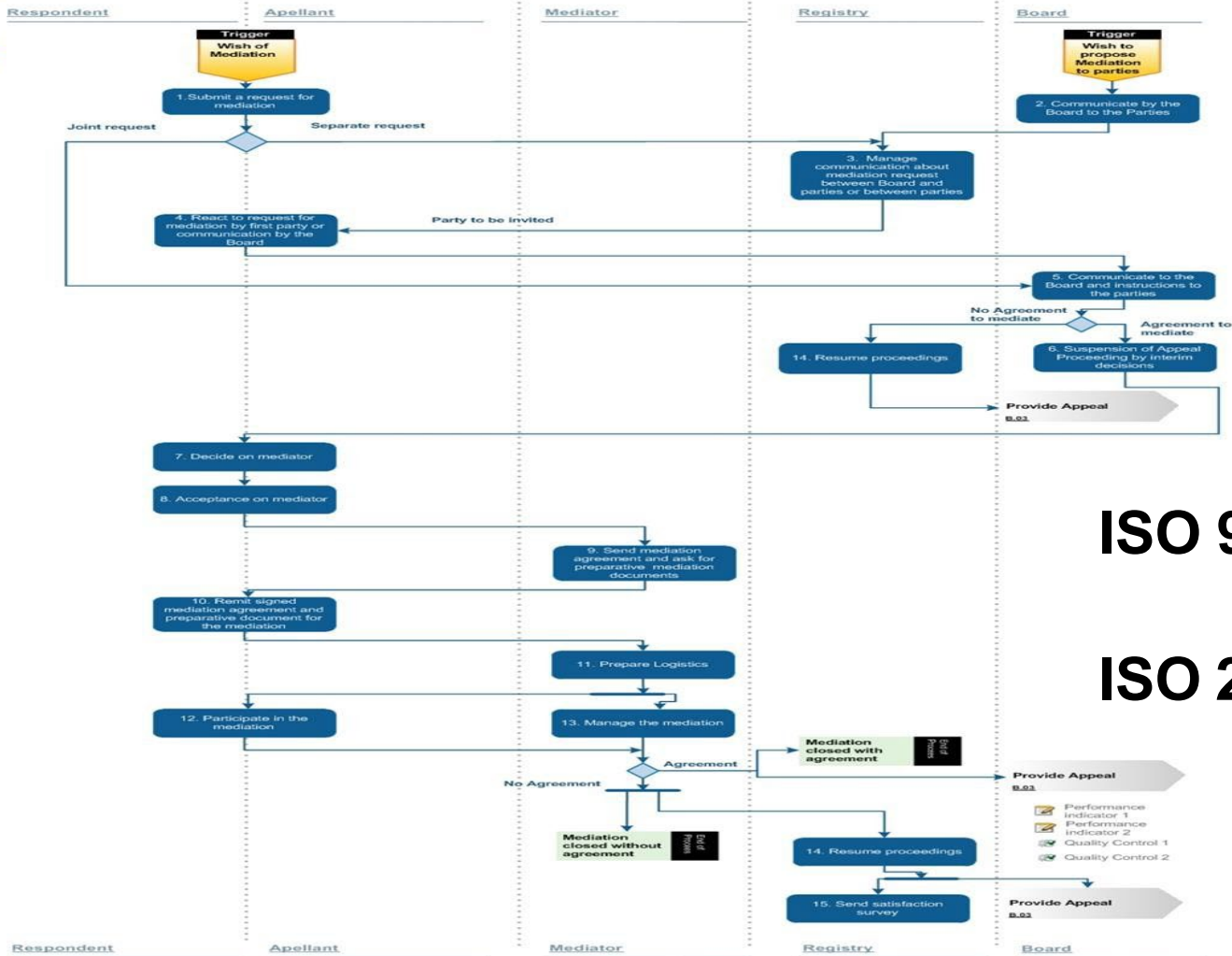
WHO?

- EUIPO staff
- Chartered Institute of Arbitrators (CIArb) or Centre for Effective Dispute Resolution (CEDR) accreditation
- European Code of Conduct for Mediators
- Co-Mediation





STANDARDS



HOW?

JOINT REQUEST FORM FOR MEDIATION

N° of pages (including this one):		
A. Appellant / Mediation applicant	Mediation applicant / Representative reference (not more than 20 characters)	
Address / ID Number		
Representative		
Address / ID Number		

HOW? - STEPS OF THE MEDIATION

Preparation

Opening

Exploration

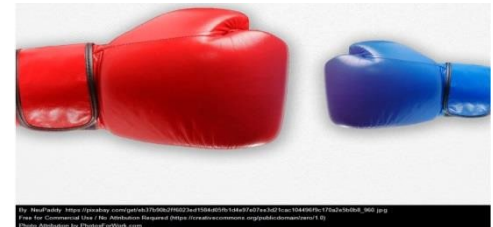
Search of Solution
Bargaining

Conclusion



EVALUATING MEDIATION SUITABILITY

- Identical or similar proceedings in other countries (national/EU/worldwide).
- Conflicts between the same parties but with regard to other IP rights: patents, designs, copyright, domain names, etc.
- Longstanding relations between the parties: licensee – licensor; agent/representative – trade mark owner, manager – company owner, family relations, etc.
- Parties have already negotiated but without success.
- Each party has strong and weak legal points.
- Parties are doing business in different areas.



IP DISPUTES SUITABLE FOR MEDIATION

- ✓ Trade mark oppositions on relative grounds.
- ✓ Trade mark invalidation on relative grounds.
- ✓ Disputes over trade mark / designs ownership.
- ✓ Disputes about the licensing of IP rights.
- ✓ Disputes concerning the infringement of IP rights.

IP DISPUTES NOT SUITABLE FOR MEDIATION

- ✗ Where trade mark disputes concern the distinctiveness of the mark.
- ✗ Where the disputes are ex parte in general.



CASE STUDY: LITIGATION VS MEDIATION

- Disputes between EU based companies relating to similar product labels registered as trade marks at EU and national level by both parties. Issue of scope of protection of weak marks and level of protection of colour marks.
- ➔ **Potential Result Litigation:** Parties would have mutually destroyed their trade marks by filing of cross-invalidity and revocation actions. Dispute would have lasted at EU and several national Member States for many years with huge costs involved.
- ➔ **Result Mediation:** Agreement to delimit product labels by modifying the trade marks. Payment of compensation. Both parties maintain their trade mark rights. All EU and national proceedings closed.



EXPERIENCES

27 mediations:

- 15 mediations have resulted in the parties jointly signing documents with a view to terminating proceedings.
- In 10 mediations, the mediation is closed without agreement, but the mediation helped the parties to better understand their business interests.
- 2 mediations are still pending.
- **116 mediation requests which were not accepted by one of the parties.**
- 186 appeals withdrawn in 2017.



Positive Feedback via satisfaction surveys.

CONCILIATION

CONCILIATION (Presidium Decision No 2014-2, 31/01/2014)

- Rapporteur encourages parties to put an end to the dispute;
- Submits proposals for a friendly settlement of the case;
- Calls parties individually or via a conference call and/or e-mail;
- Rapporteur must remain impartial and give equal treatment;
- Rapporteur refrains from expressing any opinion on the outcome of the case.



CONCILIATION CASE STUDY

- Application for Class 9 software opposed by company with Class 9 registration;
- Applicant actually involved in software for the hearing-impaired;
- Opponent involved in nanotechnology software;
- Proposed solution: Clear restriction of specification of EUTMA delimiting the area of software activity.

Further Information: <https://euipo.europa.eu/ohimportal/en/mediation>





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Thank you