



OVERVIEW OF THE STAGES OF THE MEDIATION PROCESS

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PROGRAMME

50'
Presentation

- Legal basis – Mediation
- EUIPO BoA Mediation process
- Post-mediation formalities
- Why an EUIPO mediation?

10'
Questions and answers

Legal basis – Mediation

Preamble 35 EUTMR

It is desirable to facilitate **friendly, expeditious and efficient dispute resolution** by entrusting the Office with the establishment of a **mediation centre** the services of which could be used by any person with the aim of achieving a friendly settlement of disputes relating to EU trade marks and Community designs by mutual agreement

Article 151(3) EUTMR – Tasks of the Office

The Office may provide **voluntary mediation services** for the purpose of assisting parties in reaching a friendly settlement

Legal basis – Mediation

Article 170 EUTMR – Mediation Center ('MC')

Establishes 'MC', any natural or legal person may use the **Centre's services on a voluntary basis** with the aim of reaching a friendly settlement of disputes, and sets out basic provisions

Article 47(4) EUTMR, Article 64(4) EUTMR, and Article 31(5) CDIR – Designs

The Office may call upon the parties to make a friendly settlement in **trade mark opposition**, application for **revocation** or declaration of **invalidity**, and in **design invalidity** proceedings

EUIPO BoA Mediation process



Unilateral or joint request



Proposal of Rapporteur

The moment both parties finally agree on entering mediation



Appeal proceedings are suspended

Proposing a mediation

Why propose?

- **History of litigation**, numerous parallel proceedings in several jurisdictions
- **Earlier mark** can be attacked by the other party. *Classic situation is the earlier mark may be subject to a cancelation.*
- **Both may lose out** and neither obtain EUTM.
- **Coexistence**: Different business models and get up
- **Legal uncertainty** e.g., weak marks
- **Prior relationship**

LITIGATE

Legal solution: **Positional**

Companies want to ensure the broadest protection against third parties.

Past: Based on a retrospective assessment; future marketing strategies are irrelevant



Requires examining the relevant legal provisions, facts, evidence and arguments

OR

MEDIATE

Mediation: **Real Interests**

Focus on what each is willing to accept of the other.

Future: Companies do have business strategies that describe how they plan to position themselves to achieve short, medium and long term objectives which are relevant in a mediation



Case file is not determinative

Why mediate, when it is quicker to render a decision?

Cost- Benefit Analysis cannot be limited to the time it takes to mediate and the time in drafting a decision

- One mediation often offers the possibility of resolving amicably a number of disputes simultaneously; saves time in drafting a number of decisions
- Saves litigation costs for the parties
- Legal certainty
- User satisfaction
- Improves the image of the EUIPO

Mediation in essence

Structured process managed by an independent and neutral mediator

- **Voluntary**
- **Flexible**
- Conducted **confidentially**
- **Without prejudice**
- **Parties define scope**
- **Parties have ownership** of the solution
- **Nothing is binding** except the agreement if reached
- **Legal certainty**

Confidentiality

- Discussions and negotiations are **confidential**. Information disclosed that is not otherwise publicly available is confidential
- **Mediator does not disclose information given in a private session without express consent**
- **No recording. No records kept other than Mediation Agreement, Confidentiality Agreement and Settlement if reached.**
- Documents, information and correspondence do **not form part of the case file** and may **not be subject to inspection**
- **Mediator cannot be called as witness** or produce records or notes in other proceedings

CONCILIATE

- **Rapporteur assists** the parties, normally through representatives authorised to represent
- **If fails, rapporteur decides**
- Can only assist in the case he/she is **assigned**
- **Proposes a solution:** may do so at the outset
- In the **languages** of the Rapporteur

OR

MEDIATE

- Structured process managed by an **independent and qualified mediator**
- **Authority to bind** must attend
- **Rapporteur any not act as mediator**, and mediator is not involved if the case proceeds if no agreement
- **Formal joint request for mediation**
- **Scope of the mediation** may cover several proceedings before EUIPO, MS and Third countries
- **Co-mediation : Optimal communication**
- **Multilingual**
- At the request of the parties, **the mediator may make proposals** to resolve the dispute
- **Expert determination** may be requested in a mediation

EUIPO BoA Mediation process

INITIATION

- Parties agree to mediate
- Selecting the mediator within **20 days**
- **Suspension of legal proceedings**

PREPARATION

- Mediation agreement
- Pre-mediation **planning**
- Online private **preparatory meetings** to explore real interests

MEDIATION DAY

- **Opening**
- **Exploration**
- **Bargaining**
- **Concluding**

Initiation of mediation

- List of **EUIPO mediators** + bios available on EUIPO website
- **ADR Service** can help in the selection
- **Criteria for selection** used by most parties: language, experience, availability
- **Communication to EUIPO** on the choice of mediator
- **Mediator confirms no conflict of interest** (*no prior involvement in proceedings, no personal interest and has not represented either party*)

Preliminary contact & preparation

Preparatory and pre meetings with each party

- Process **briefing**
- **Approval** of Mediation Agreement
- Practical **arrangements**
- **Case summary** of facts going beyond the case file
 - Information on previous negotiations
 - Client's real and commercial interests
 - Possible solutions envisaged

Mediation agreement

It is the formal commitment to mediate and should be signed at the earliest convenience. It sets out **the terms and conditions** of the mediation.

- **Mediator's role**
- Participant's to **cooperate in good faith**
- Person with **authority to bind** attends or has access to authority
- **Scope** of the mediation
- **Case summaries**
- **Means and manner of communication** (online Mediation Platform)
- **Confidentiality**
- **Termination**

Copy of Attendance and Confidentiality Agreement is provided

Mediation day

- Signing of the **Attendance and Confidentiality agreement**
- **Opening Joint Meeting**
 - Mediator's opening
 - Parties' opening statements
 - Agenda
- **Exploration phase**
 - Confidential private meetings
 - Understanding of what matters to the parties
 - Shifting focus from positional to interests
 - Joint sessions where appropriate
- **Bargaining:** Facilitating movement, reality testing, overcoming deadlock
- **Concluding:** i) Settlement / Heads of Agreement ii) No settlement

Concluding phase

- **No settlement on the day:**
 - One party withdraws
 - Heads of agreement
 - Parties continue negotiations
- **Settlement:**
 - Co-existence
 - Limitation
 - phase out
 - Transfer
 - License
 - Monetary compensation
- Drafting of settlement is the responsibility of the parties. Mediator has the role of contributing and checking that all points are covered

ADR Contractual Clauses recommended by the ADR Stakeholder Advisory Board foresee that parties may agree to settle any future dispute through Mediation following the EUIPO Mediation Rules, and may make a written request to launch a mediation process.

Post-mediation formalities

EUIPO

- **Mediator disposes of confidential documentation** other than Mediation and Confidentiality Agreements
- **Settlement may be deposited** with the Mediation Centre
- Mediation Centre sends out **satisfaction survey**

Parties and Lawyers

- **Settlement:** formal closure of litigious proceedings (termination of appeal proceedings)
- **No settlement:** appeal proceedings resume before EUIPO

Why an EUIPO mediation?



Online ADR platform

means of **electronic communication** for procedures administered by Medication Centre ensuring the **highest levels of confidentiality**



No additional charge

if online or at EUIPO premises in Alicante



Mediators are IP experts

who undergo continuing **professional training**



Multilingual



Mediation Centre

case management team



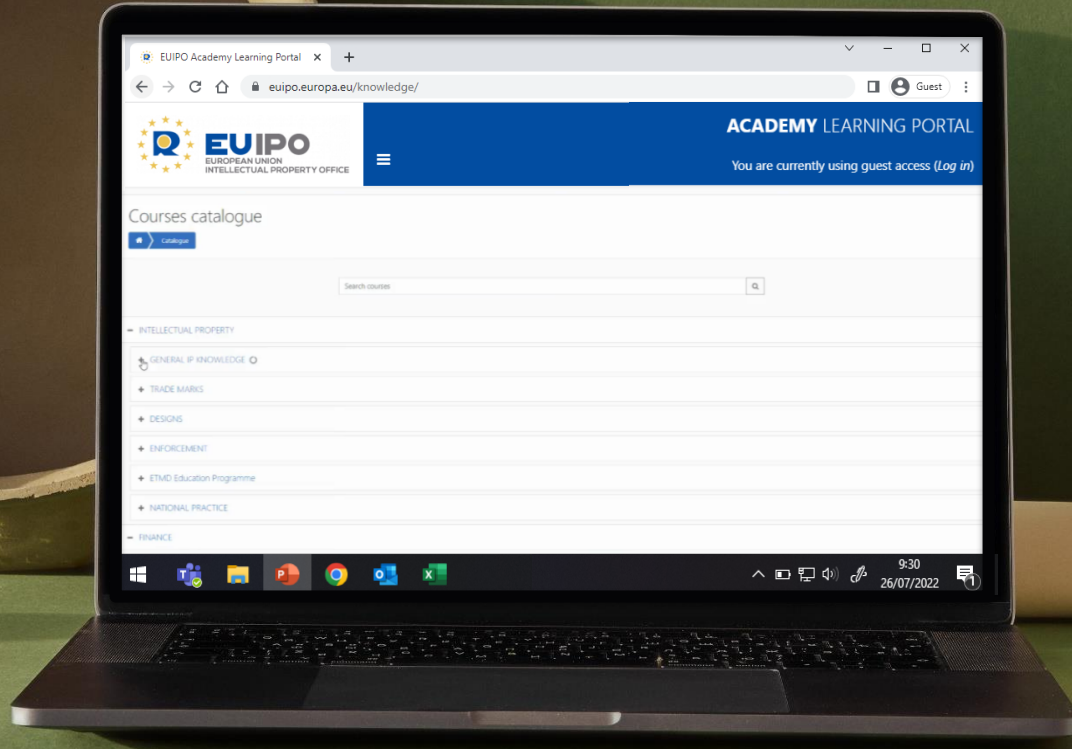
IT support

FUTURE

- Establishment of Mediation Centre opens up new possibilities :
- Extension to all First Instances : Opportunity to resolve at an early stage
- It may be possible for parties to request the MC to launch a mediation process in accordance with the EUIPO Rules on Mediation in any dispute arising out of or in connection with a contract in which, an EUTM or Community design
- Proposal for the Office to conciliate the license fee in Standard Essential patents.
- Singapore convention



Keep in touch with EUIPO Academy



To go further

Mediation centre

<https://www.euipo.europa.eu/en/manage-ip/mediation-centre>





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THANK YOU



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