

Key elements for successful mediations

How to negotiate a satisfactory settlement agreement

Anton Petro
Marisol Orts Moreno
EUIPO Mediation Centre
11 June 2024

PROGRAMME

50'
Presentation

1. The EUIPO Mediation Centre
2. Mediation for IP disputes
3. Specifics of EUIPO Mediation Proceedings
4. Additional information

10'
Questions and answers



The EUIPO Mediation Centre

The EUIPO Mediation Centre

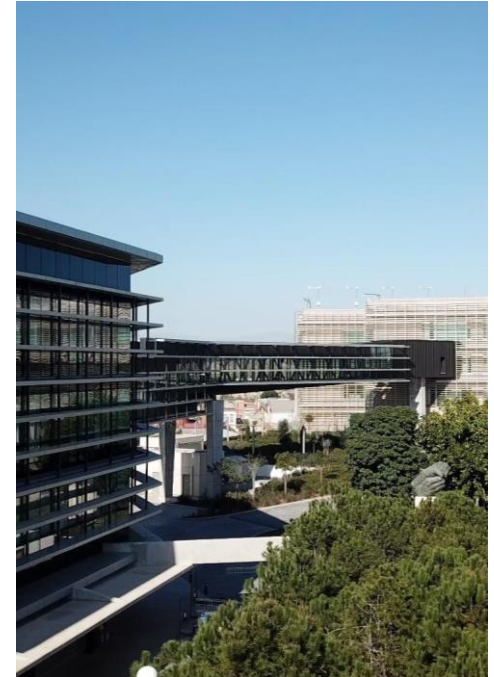
Establishment of the Mediation Centre: 22 November 2023

Objective

To provide **complementary, voluntary, confidential** and **accessible** dispute resolution **options** to **users** so that they can **choose the most appropriate path** in the event of an IP dispute

Legal basis

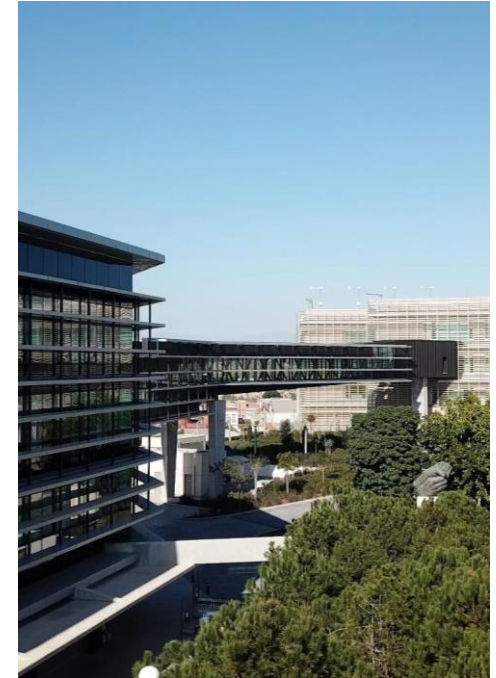
- Article 170 EUTMR
- Decision ADM-23-45 on the Establishment and Operation of the Mediation Centre
- Decision EX-23-9 “Rules on Mediation”



Disputes at the EUIPO and ADR potential

Huge potential for ADR in inter-partes proceedings:

- **300,000 IP rights applications per year**
 - 200,000 EUTM
 - 100,000 RCD
- **24,500 disputes every year**
 - 20.000 oppositions
 - 2.000 cancellations
 - 2.500 appeals
- **ADR is effective**
 - 70% Settlement rate
 - 80% User satisfaction



The EUIPO ADR Services



Mediation

Reach an amicable settlement with the assistance of a mediator



Conciliation

The conciliator suggests possible solutions. Conciliator is always the rapporteur



Expert determination

In the context of a mediation, parties may appoint an expert to provide an opinion on a specific matter



Friendly settlement

Invitation to the parties to consider negotiating, without the intervention of a neutral



ADR case management and good offices

Case management team manages procedural aspects of the ADR processes, guides on suitable ADR mechanisms and facilitates contacts between parties

Benefits of Mediation

Mediation

Voluntary

Collaborative

Confidential

Focused on **business interests**

Cost-effective

Flexible and **less time-consuming**



vs

Litigation

Not voluntary (at least not for defendant)

Adversarial

Public by nature

Focused just on the **matter of proceedings**

Not cost-effective

Rigid and **more time-consuming**



Why an EUIPO Mediation?

Mediation for ongoing *inter-partes* disputes concerning EU TM and/or RCD



No additional
cost



Mediators are IP
experts



Multilingual



Online ADR
platform

How does it work?

Eligible disputes

Ongoing inter-partes dispute concerning **EU TMs and/or RCD**

Possibility to **include**:

- Disputes about **other IP rights** (copyright, domain names, patents...) or **any other related pending dispute**;
- Disputes **anywhere in the world**

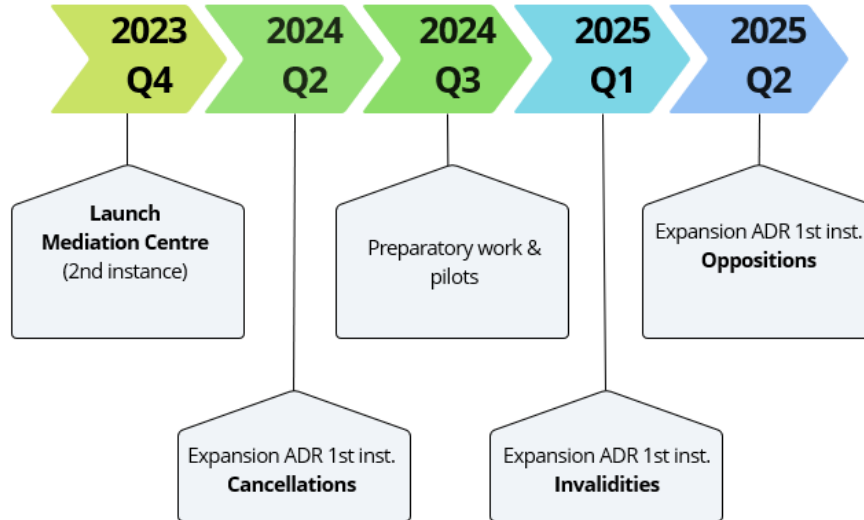
First instance: Oppositions – Cancellations -
Design invalidities

- Service currently tailored for **SMEs only**

Second instance: Appeals

- Service offered to **all parties**: no limitation as to size, nature or seat of company

Mediation Centre roadmap: expansion of mediation services



2024

- Cancellations by end Q2
- Preparatory work for RCD invalidities and oppositions

2025

- RCD invalidities by end Q1
- Oppositions by end Q2

2 Mediation for IP Disputes

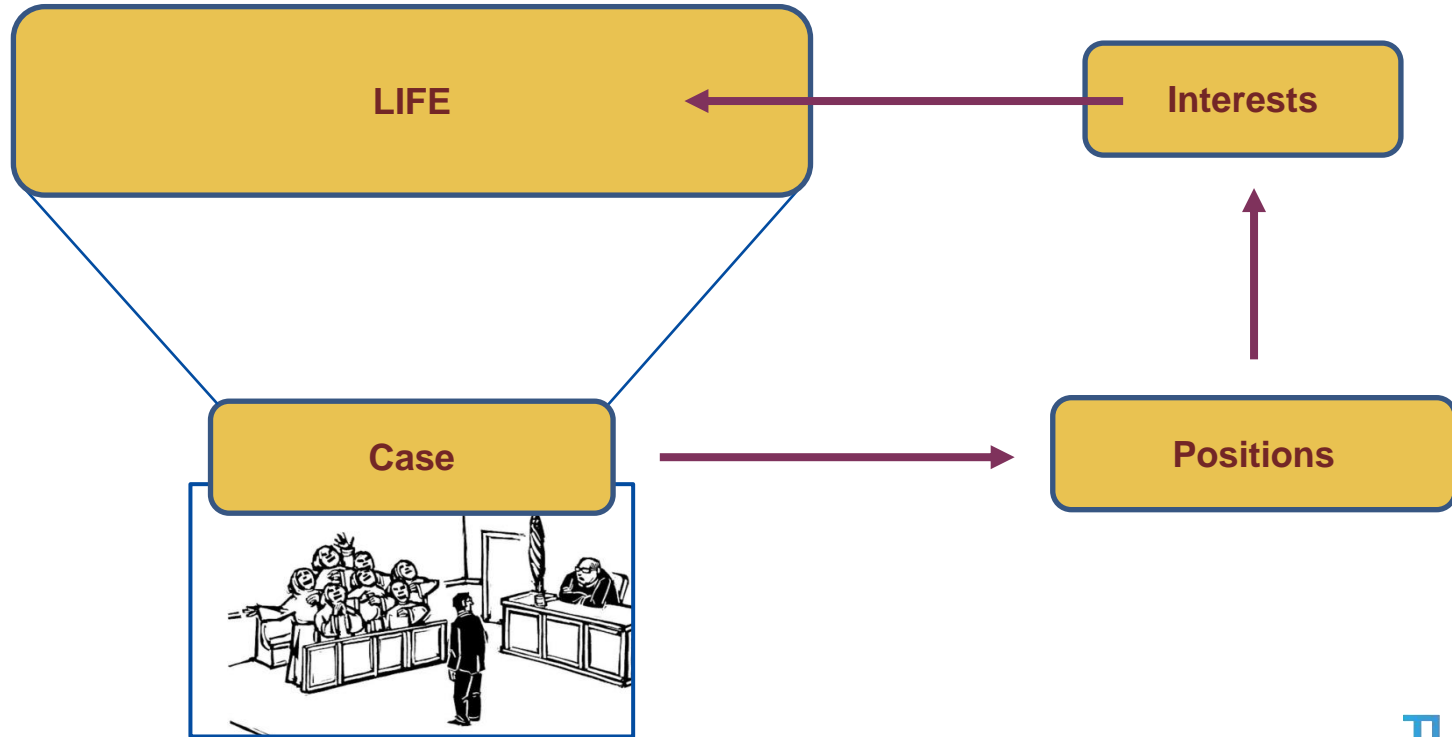
10 reasons why your dispute may be suitable for settlement

- 1 Your dispute is still at an **early stage** of the conflict
- 2 Your dispute is **complex** or involves **several jurisdictions**
- 3 A court decision in your dispute would be **difficult to enforce**
- 4 The other party and you have, or may have, **co-existing IP rights** in your dispute
- 5 A **tailored** approach is essential for you
- 6 You and the other party are, or wish to be, engaged in a **business venture**
- 7 **Confidentiality** is important to you
- 8 You want to preserve your business **reputation**
- 9 A **language barrier** exists between you and the other party
- 10 You want to resolve the dispute **quickly**

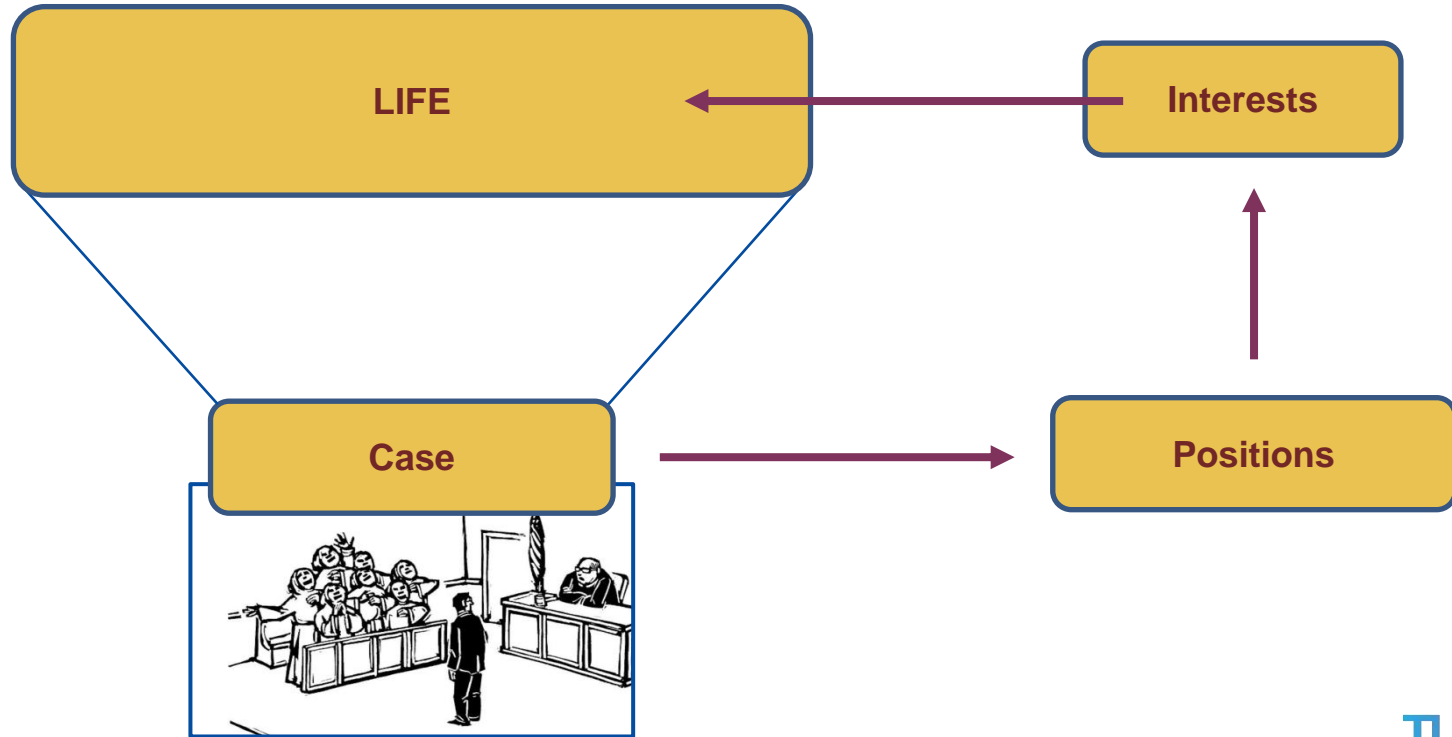
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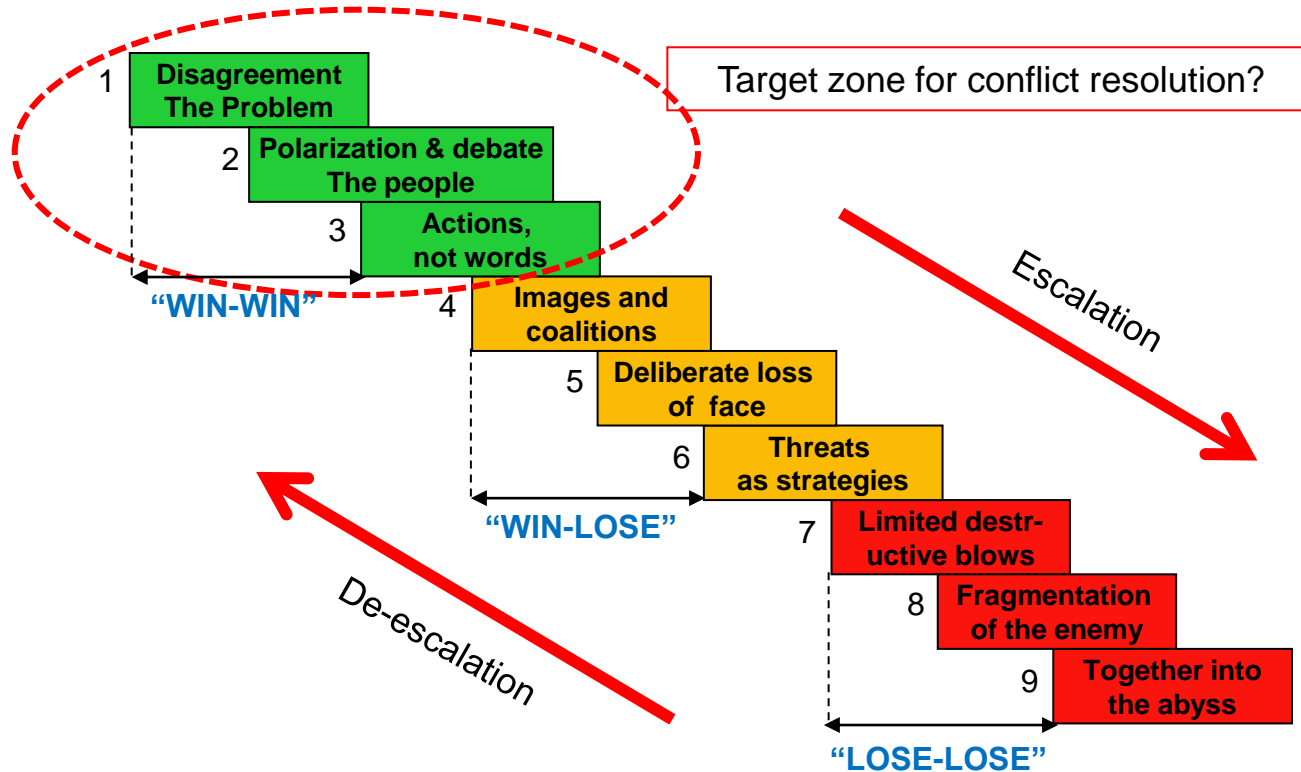
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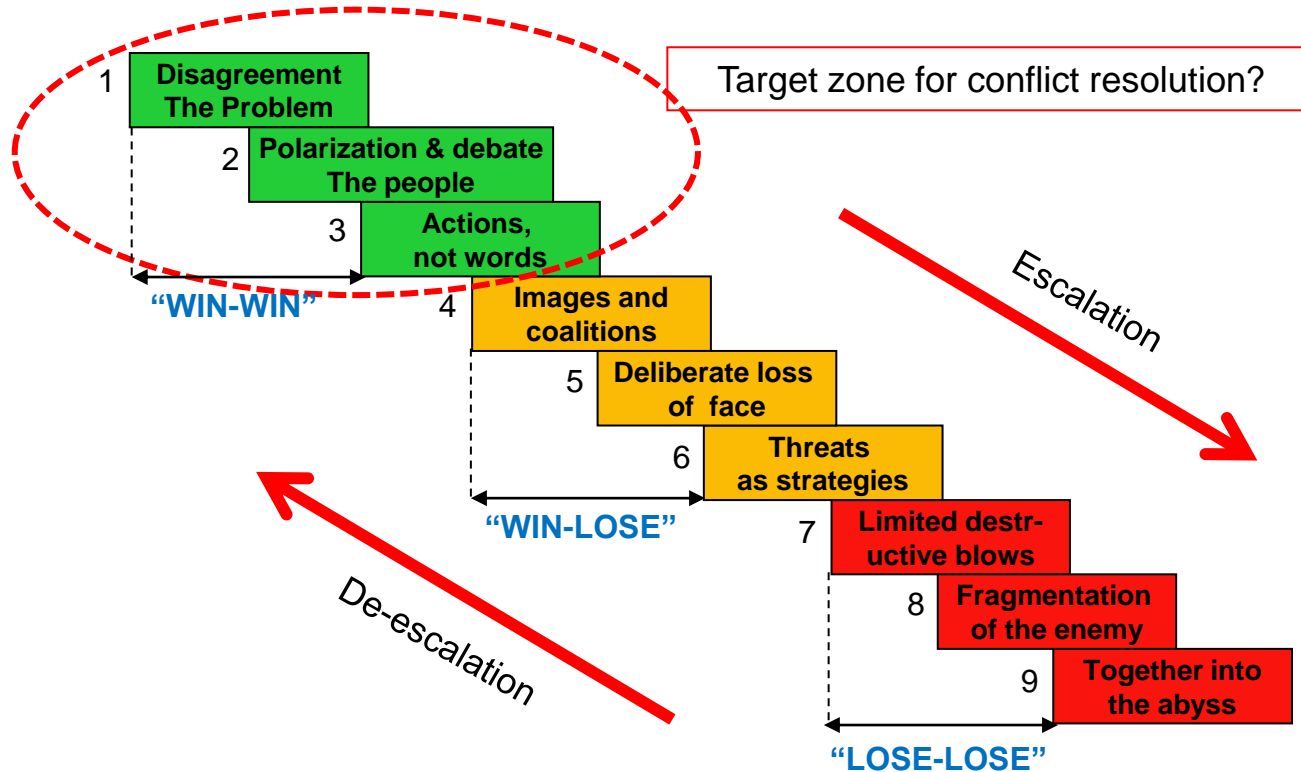
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Common challenges



Common challenges



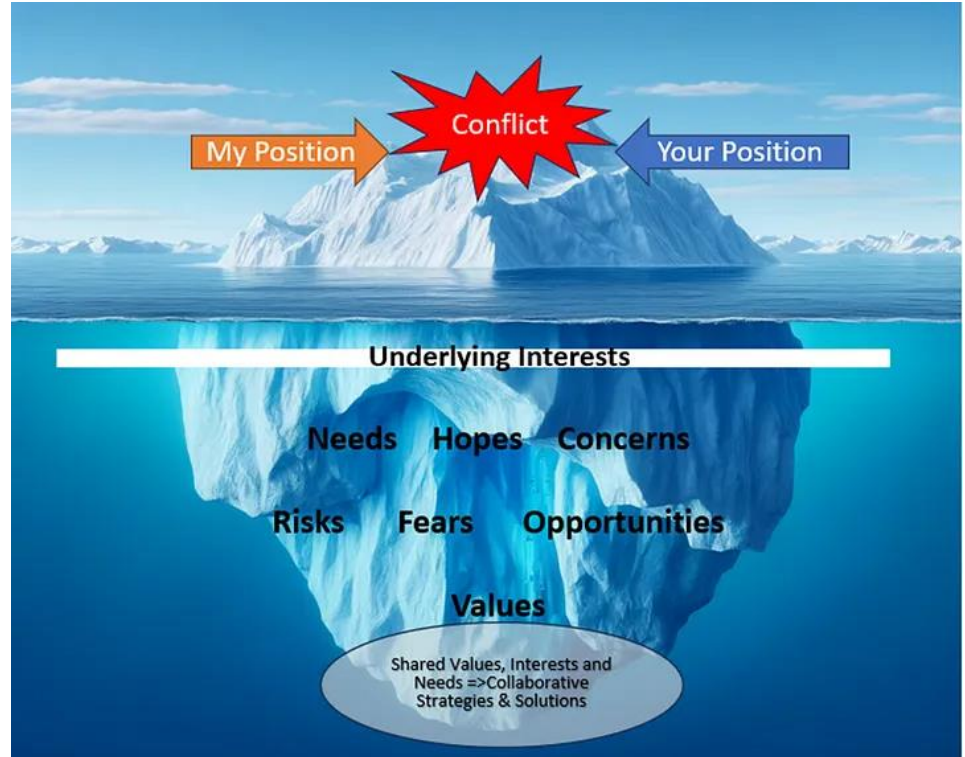
Negotiation techniques

Position-based Negotiation

- Focus on demands / positions
- Competitive approach
- Win-Lose outcomes

Interest-based Negotiation

- Focus on underlying needs
- Collaborative approach
- Win-Win outcomes



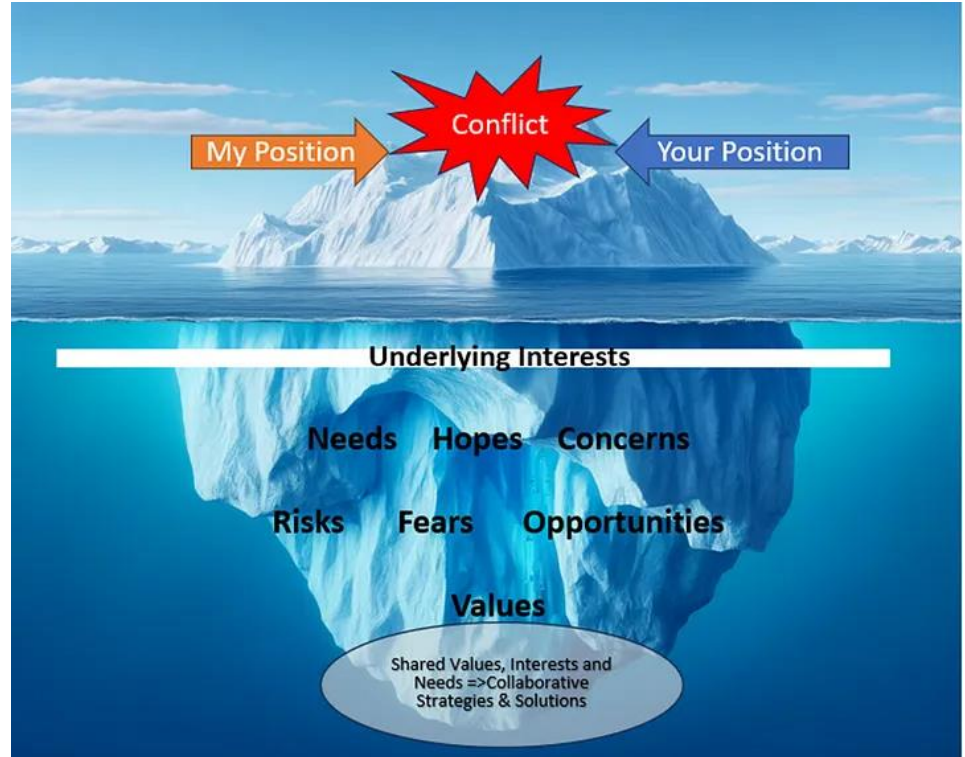
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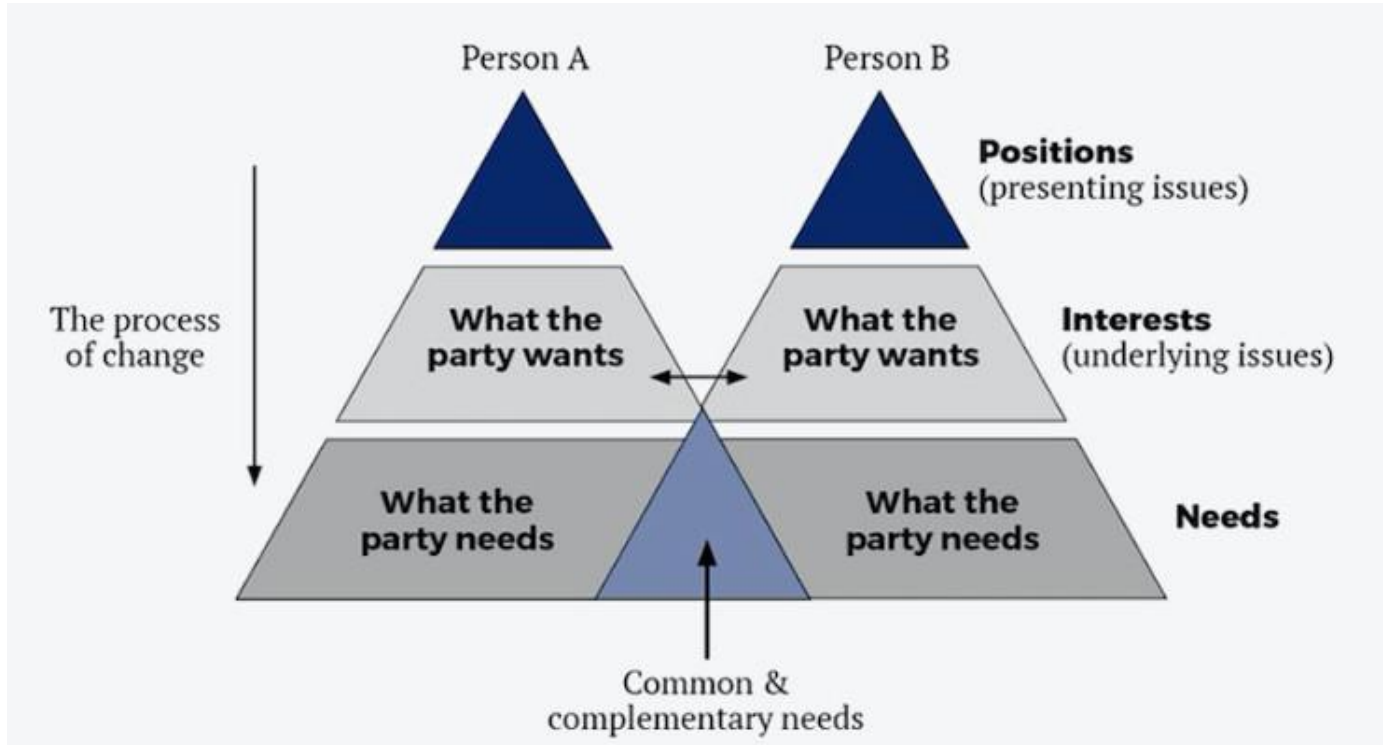
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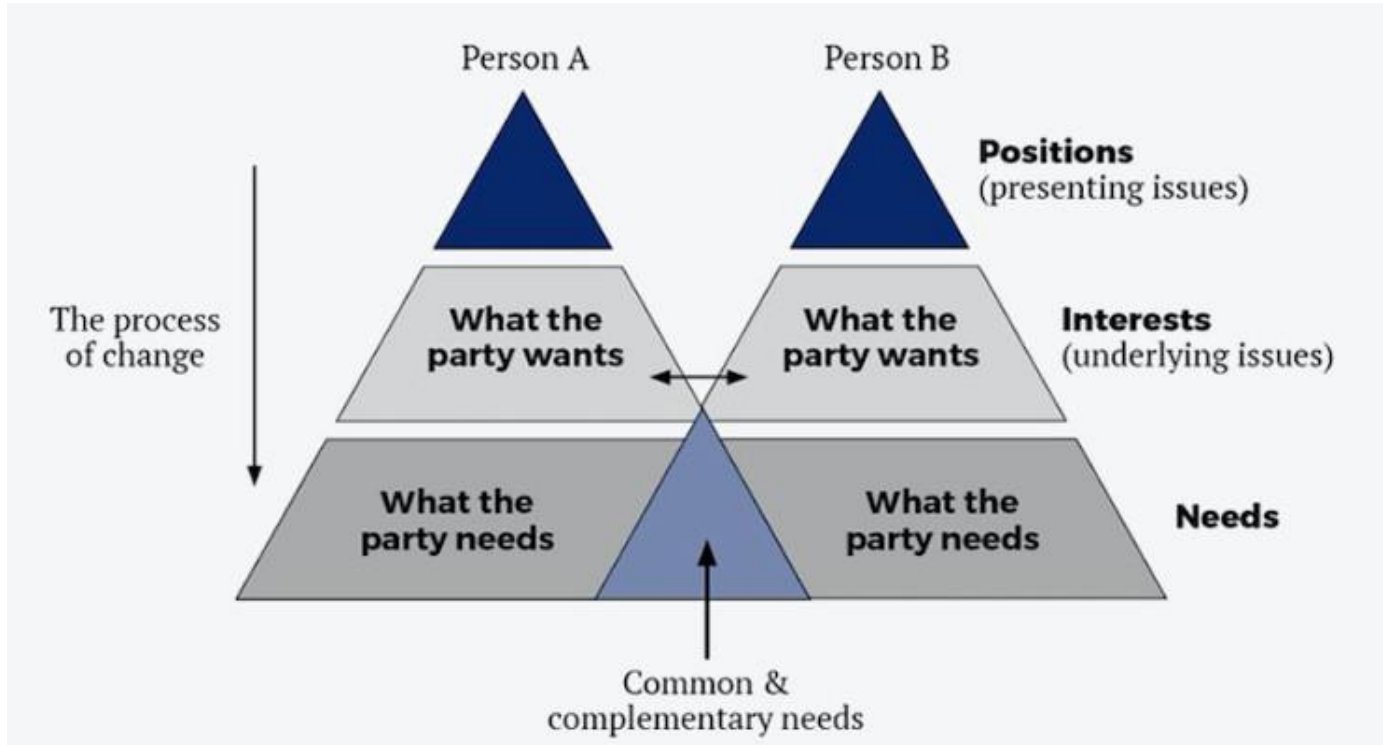
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Finding the 'Zone of Possible Agreement'



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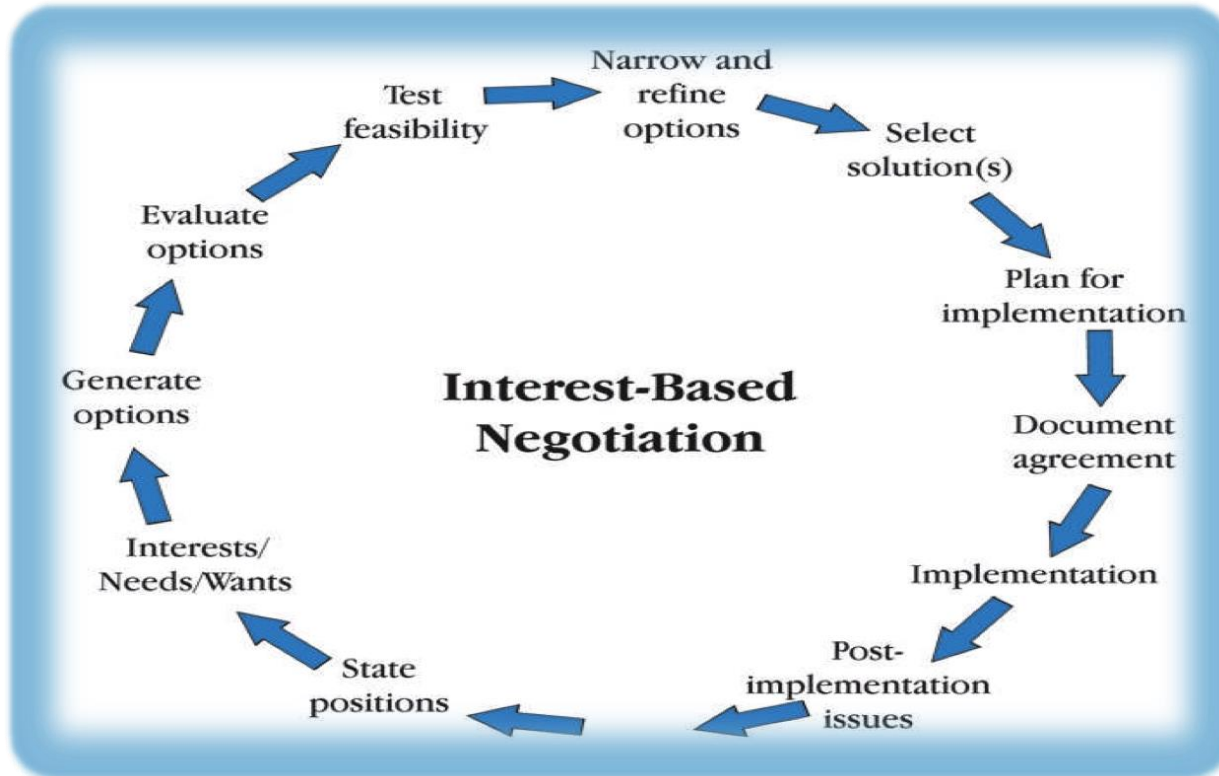
Negotiation in Action: Luxury Goods Trademark Licensing

- **Background:** Licensee develops a thriving business for luxury goods under a long-standing trademark license.
- **Challenge:** As license expiration approaches, licensor plans to take over the business.
- **Negotiation Breakdown:** Licensee demands compensation for the business developed, licensor resists as license expiry looms.
- **Turning Point:** Shift from legalistic to interest-based negotiation reveals the economic value of copyrighted packaging designs developed by the licensee.
- **Resolution:** Recognizing the value of the licensee's business to licensor's turnover leads to an agreed compensation.

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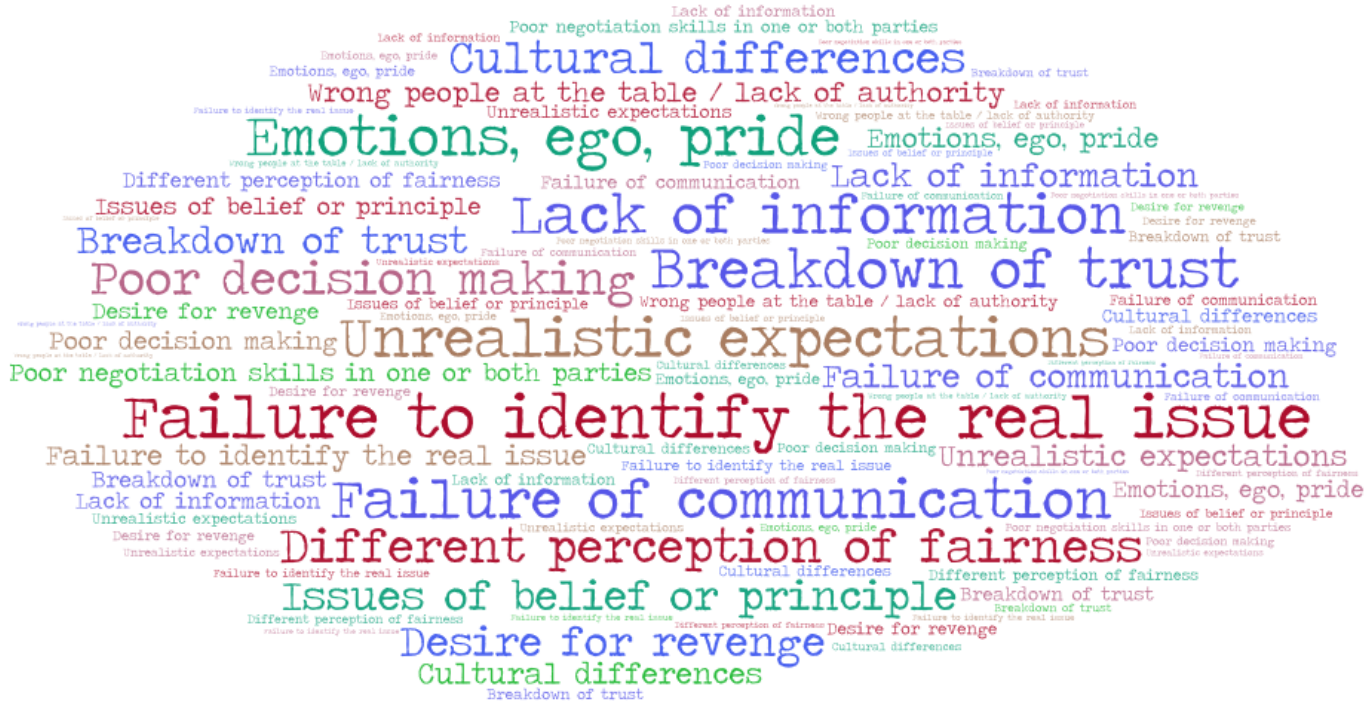
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Step-by-Step Negotiation Process





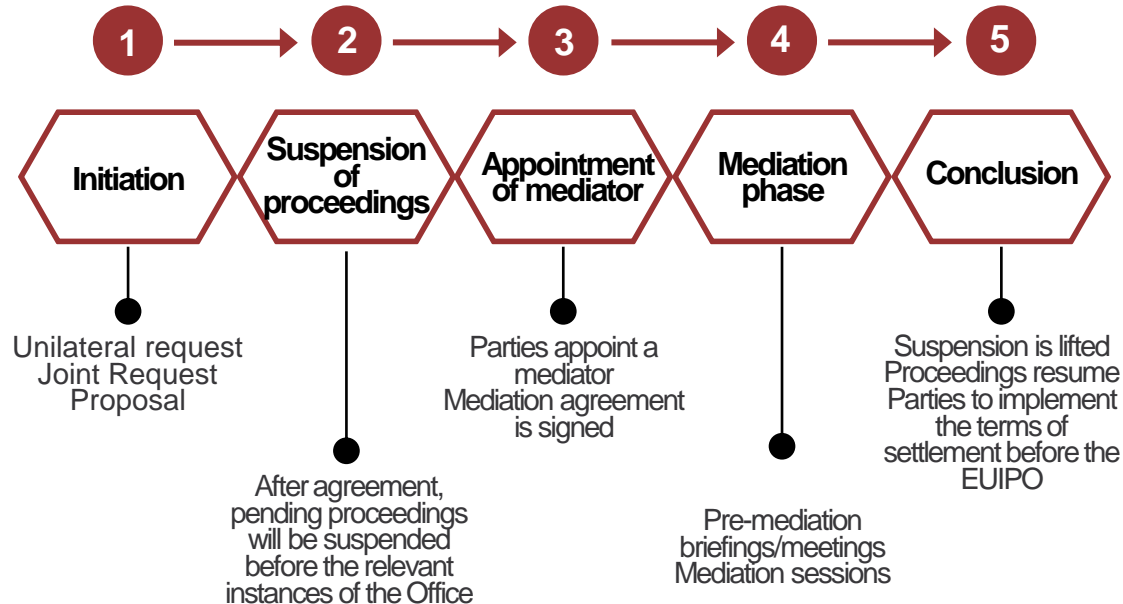
Reasons for negotiation failure





Specifics of EUIPO Mediation Proceedings

The mediation process step by step



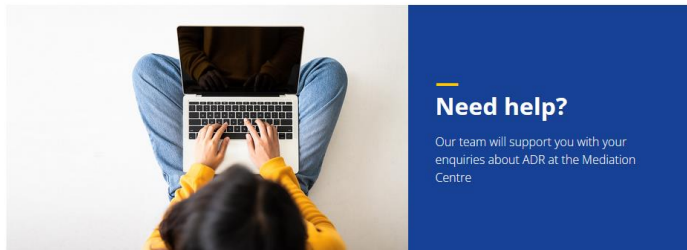
1 How to request mediation

Initiation

- Overview and Services
- Benefits of ADR
- How does it work?
- Our mediators
- Ten reasons to try mediation
- Partners and Networks
- Resources
- Contact and FAQs**

Request ADR

Contact and FAQs



Contact the Mediation Centre

Please **contact us** for information on our services or **assistance about the ADR options for your case**.

In order to better support you, we recommend that you indicate in the e-mail the EUIPO Case Reference number(s) (e.g. R-XXXX/202X for appeals, B0000000 for oppositions, C00000 for cancellations, etc.)


Send an e-mail to: MediationCentre-Info@euipe.europa.eu

Request ADR Services

If you wish to request a mediation or a conciliation, please complete and sign the relevant form and send it through your **User Area** account.

[Mediation request](#) →

Request for Mediation

Requesting Party	
Name of legal entity or first name and surname:	
EUIPO ID Number:	
Business e-mail:	
Business telephone:	
Representative	
Name and surname:	
EUIPO ID Number:	
Business e-mail:	
Business telephone:	
On behalf of the party indicated hereinabove, I hereby request mediation for the following formal proceeding(s) pending before the EUIPO: ¹	
Signed on behalf of the requesting party:	
Name:	Signature: 
Place:	Date:

¹Please insert EUIPO case reference number(s), e.g. R-XXXX/2023 for appeals, BXXXXXXX for oppositions, CXXXXXXX for cancellations, etc.

1 How to request mediation

Entrepreneurs IP professionals

Accessibility | English



Discover IP ▾ Protect IP ▾ Manage IP ▾ Enforce IP ▾ News & events The Office ▾

Search Login Sign Up

Welcome to our new website. Help us to improve it by giving us feedback.



IP professionals

We provide you with information on intellectual property developments and offer tools to assist your day-to-day work.



Databases

Search our EUIPO databases



Protect

Online services



Disputes

Mediation Centre



Guidelines

Guidelines for examination



Courses

Courses for IP professionals



User Area

Access to your User Area



2 Suspension of proceedings



Suspension

For proceedings at the EUIPO:

- **Joint request:** automatic suspension

Article 170(5) EUTMR



- **Unilateral request or Proposal from the EUIPO**
Proceedings will be suspended when mediation is accepted by other party

- Proceedings before the Office subject to mediation shall be suspended
- Time periods interrupted (other for payment of the applicable fee)

For proceedings NOT at the EUIPO:

Parties to request suspension to competent national authority

Art 12(3) Rules on Mediation

3 Important points to decide

Appoint a
mediator

Parties' decision on:

- **Language** of mediation
- **Mediator**
- **Venue and suitable dates:**
 - Online
 - Onsite: Alicante or Brussels
- **Other disputes** to be **included** in the scope of the mediation
- **Business interests vs legal position**



3 Invitation and onboarding

Invitation to
join ADR
platform



Dear Mr Barabas,

Stan Spenser (Case Manager) is inviting you to participate in a case.

The details of the case are as follows:

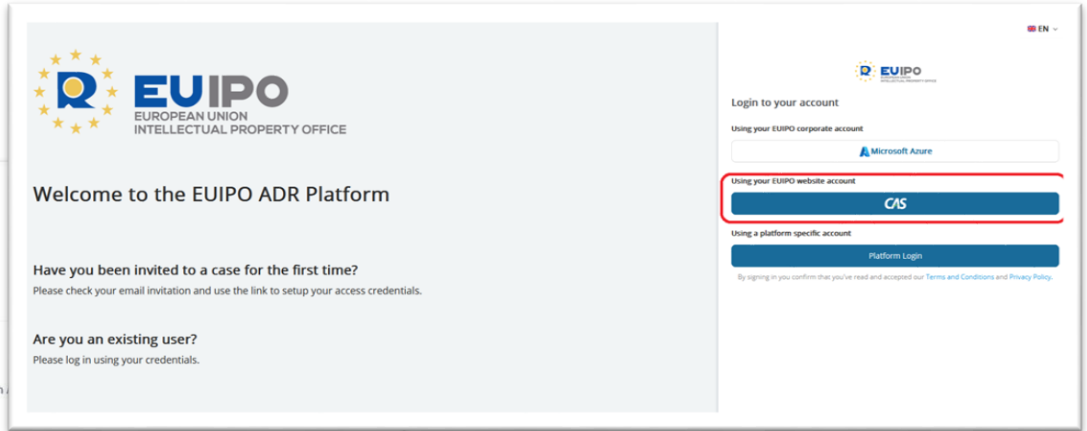
Case Number: EUIPO-1/2024
Case Name: Oxidian Corp Vs Paramount Inc
Case Category: Mediation
Case Description: Mediation in appeal cases 2045/2024 and 20246/2024

Please click the button below to accept the invitation and begin your on-boarding process:

[Respond to Case](#)

Best regards,
EUIPO Mediation Centre

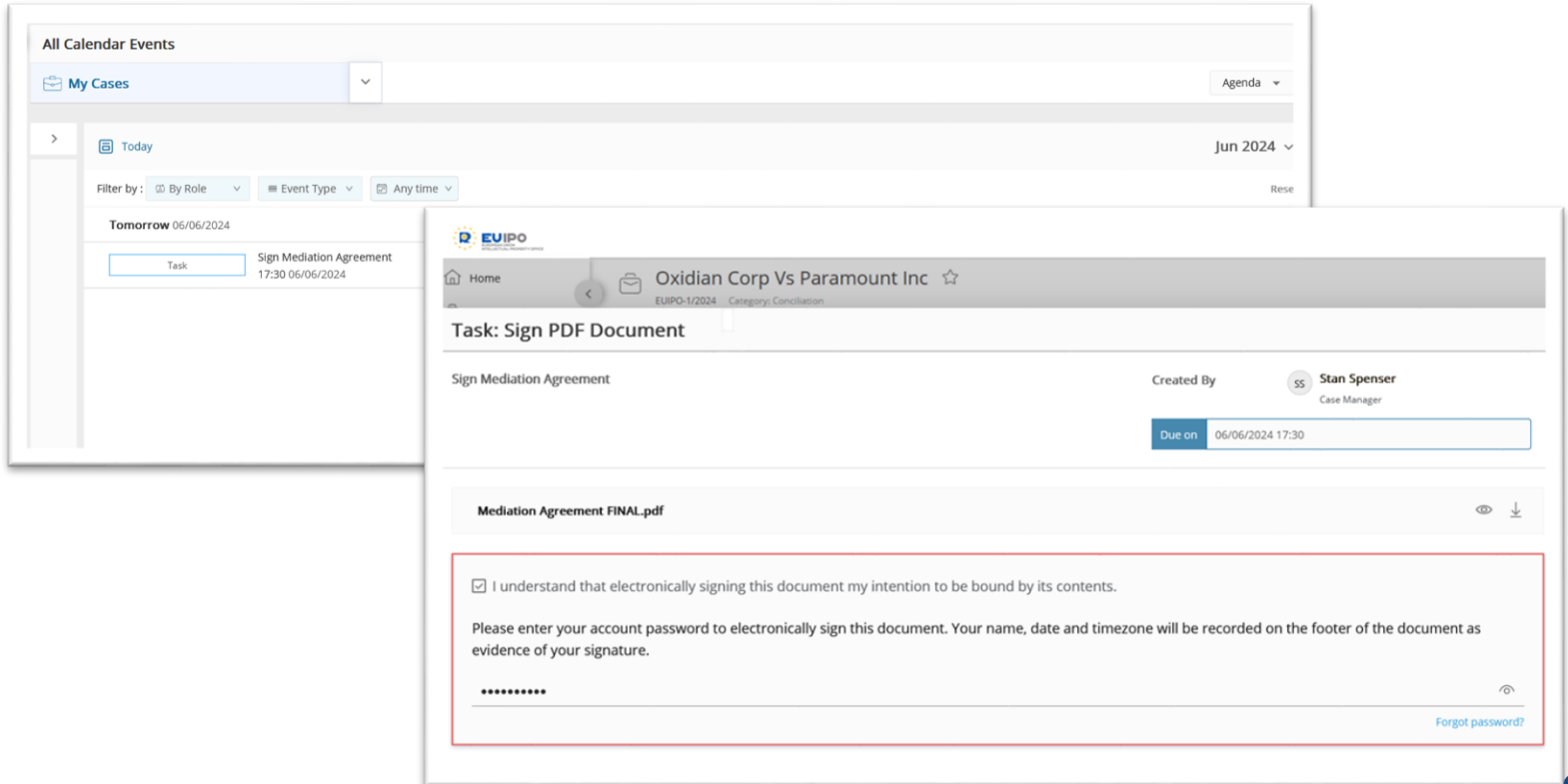
This is an automatically generated message sent from a notification only address that cannot accept incoming e-mails. Please do not reply to this message. If you want to contact the Mediation Centre, please send your message via the Platform or contact MediationCentre-info@euipo.europa.eu.



The screenshot shows the EUIPO ADR Platform login interface. At the top left is the EUIPO logo. The main heading is "Welcome to the EUIPO ADR Platform". Below this, there are three sections: "Have you been invited to a case for the first time?" with a link to "Please check your email invitation and use the link to setup your access credentials.", "Are you an existing user?" with a link to "Please log in using your credentials.", and a "Login to your account" section. The "Login to your account" section has three options: "Using your EUIPO corporate account" with a "Microsoft Azure" button, "Using your EUIPO website account" with a blue button labeled "CAS" (highlighted with a red box), and "Using a platform specific account" with a "Platform Login" button. At the bottom right, there is a small note: "By signing in you confirm that you've read and accepted our Terms and Conditions and Privacy Policy."

3 Sign the Mediation Agreement

Sign the
Mediation
Agreement



The screenshot shows the EUIPO user interface. On the left, a calendar view displays a task for 'Tomorrow 06/06/2024' at 17:30: 'Sign Mediation Agreement'. The main view shows the details for this task, titled 'Task: Sign PDF Document'. The task is created by Stan Spenser, Case Manager, and is due on 06/06/2024 at 17:30. The document to be signed is 'Mediation Agreement FINAL.pdf'. Below the document name, there is a checkbox that is checked, with the text: 'I understand that electronically signing this document my intention to be bound by its contents.' Below this, a message states: 'Please enter your account password to electronically sign this document. Your name, date and timezone will be recorded on the footer of the document as evidence of your signature.' There is a password input field with a masked password '*****' and a 'Forgot password?' link.

All Calendar Events

My Cases

Agenda

Today

Jun 2024

Filter by: By Role Event Type Any time

Rese

Tomorrow 06/06/2024

Task Sign Mediation Agreement 17:30 06/06/2024

Home Oxidian Corp Vs Paramount Inc EUIPO-1/2024 Category: Conciliation

Task: Sign PDF Document

Sign Mediation Agreement

Created By Stan Spenser Case Manager

Due on 06/06/2024 17:30

Mediation Agreement FINAL.pdf

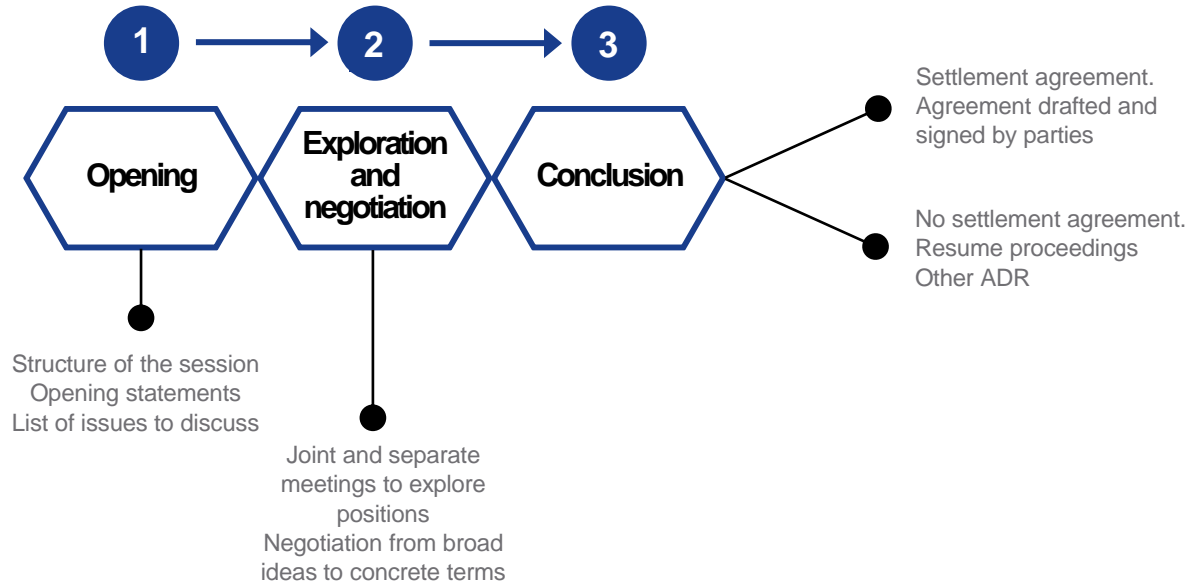
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Please enter your account password to electronically sign this document. Your name, date and timezone will be recorded on the footer of the document as evidence of your signature.

Forgot password?

4 What to expect in the mediation phase

Mediation phase



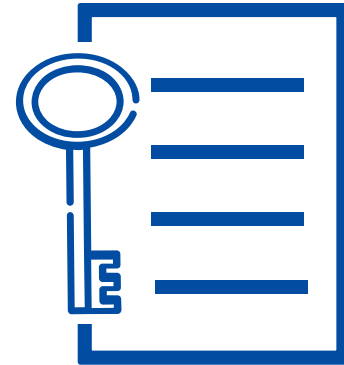
The role of lawyers in mediation

Before the mediation	During the mediation
Advise the client on the process	Be the main point of contact with the mediator
Help select the client's mediation team	Present the opening statement or support the client in making that presentation
Advise on whether there is a need for a pre-mediation meeting	Contribute authoritatively to defining the party's BATNA
Prepare the case summary and the supporting documents package to be sent to the mediator and the other party	Advise the client and, possibly, even lead in settlement negotiations
Identify any documents which are confidential and for the mediator's eyes only	Identify legal issues relevant to the emerging settlement
Brief and rehearse with the client the opening presentation	Draft, or assist in drafting, the settlement agreement
Carry out a realistic appraisal of the strengths and weaknesses of the case and prepare costs estimates	

4 Settlement agreement: key elements

Mediation phase

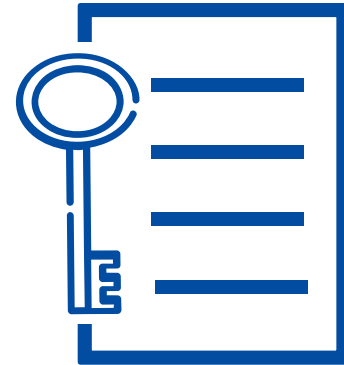
- Parties: names, status
- Signatories: authority to settle
- Recitals: circumstances of the agreement, disputes solved, facts
- Heads of agreement
- Confidentiality
- Mediator not to be called as a witness
- Agreement on costs
- Future dispute resolution process
- Governing Law
- Jurisdiction
- Other



4 Settlement agreement: key elements

Mediation phase

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4 Settlement agreement: key elements

Mediation phase

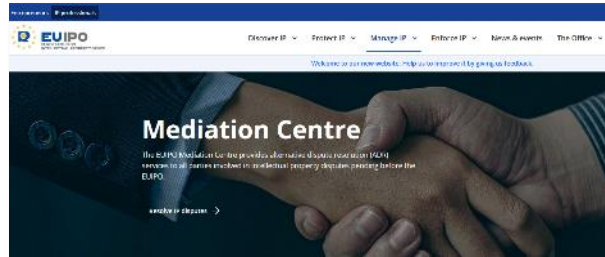
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4 Additional information

RESOURCES AND CONTACT

EUIPO Mediation Centre webpage



[Mediation Centre \(link\)](#)

Brochures



[Mediation: focusing on what matters to your business](#)



[EUIPO Mediation Centre](#)

Mailbox MediationCentre-Info@euipo.europa.eu





Is mediation available in the course of opposition proceedings? If the answer is no, when will this be applicable?



What should be the minimum practical process and information to be submitted to EUIPO if an opposition settlement is signed? We have seen different examiner approaches in some similar cases.



How to get the lawyers of the parties onboard to try mediation? Any advice on how to explain to them what's in it for them?



From your perspective, has the necessity of reaching trademark settlement agreements increased due to the rising issue of trademark congestion? If so, what factors are contributing most to this trend?



What are the panelist's views on the Singapore Mediation Convention

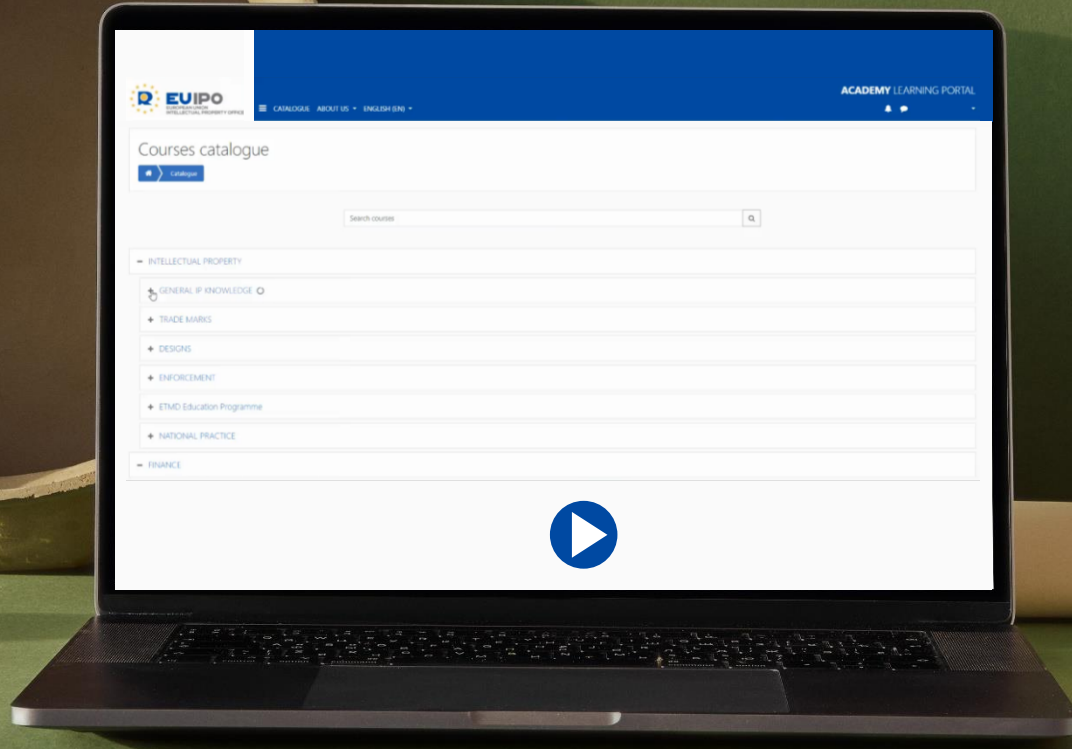


How to determine a balanced clause of Applicable Law/Jurisdiction when the Parties belong to different countries?



What types of disputes are better resolved through mediation?

Keep in touch with EUIPO Academy





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INTELLECTUAL PROPERTY OFFICE

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THANK YOU



Marisol ORTS MORENO
Alternative Dispute
Resolution Service

Anton PETROV
Alternative Dispute
Resolution Service

