



**OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)**

BOARDS OF APPEAL
The Presidium

**Decision No 2013-3 of the Presidium of the Boards of Appeal
of 5 July 2013 on the amicable settlement of disputes**

(“Decision on Mediation”)

THE PRESIDIUM OF THE BOARDS OF APPEAL

Having regard to Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark¹, and in particular Articles 42(4) and 57(4) thereof,

Having regard to Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs² and Commission Regulation (EC) No 2245/02 of 21 October 2002 implementing the Council Regulation (EC) No 6/2002³, and in particular Article 31(5) thereof,

Having regard to Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs)⁴, and in particular Article 1(6) thereof,

Having regard to the Directive 2008/52/EC of the European Parliament and of the Council of 21 May 2008 on certain aspects of mediation in civil and commercial matters⁵,

Having regard to the European Code of Conduct for Mediators,

Whereas:

- (1) The Presidium of the Boards is competent to lay down the rules and organize the work of the Boards.
- (2) The Boards may, if they think fit, invite the parties to arrive at a friendly settlement of their dispute in any inter partes proceedings. Such a friendly settlement should be easier to achieve with recourse to mediation, without prejudice to other alternative dispute resolution mechanisms.
- (3) Mediation before the Boards should depend on the filing of an appeal. The parties may not request the suspension of the time-limit to file the statement of grounds as the statement of grounds is a condition of admissibility of the appeal.
- (4) This Decision should apply to processes whereby two or more parties to proceedings at the Office attempt by themselves, on a voluntary basis, to reach an amicable agreement on the settlement of their dispute with the assistance of a mediator within the framework of the Rules on Mediation established by the Presidium. However, it should not apply to rights and obligations on which the parties are not

¹ OJ L 78, 24.03.2009, p. 1.

² OJ L 3, 5.1.2002, p. 1 as last amended by Council Regulation (EC) No 1891/2006, OJ L 386, 29.12.2006, p. 14.

³ OJ L 341, 17.12.2002, p. 28, as last amended by Commission Regulation (EC) No 876/2004, OJ L 19, 25.7.2007, p. 13).

⁴ OJ L 28, 6.2.1996, p. 11, as last amended by Regulation (EC) No 2082/2004 (OJ L 360, 7.12.2004, p. 8).

⁵ OJ L 136, 24.5.2008, p.3.

free to decide under the relevant applicable regulations, such as absolute grounds for refusal of a Community trade mark or design application.

(5) The mediation provided for in this Decision should be a voluntary process. It should remain swift and efficient.

(6) Parties to appeal proceedings should ask for mediation by means of a written agreement.

(7) The mediator should be a member of the Office's staff.

(8) Mediation should have the objective of terminating the appeal proceedings. The mediation agreement should contain a provision on the costs of the mediation proceedings. The Board competent to decide on the appeal should take note of the settlement of the case.

(9) The mediator should not be liable for the content of the written agreement resulting from mediation and whether its content is in accordance with applicable laws.

(10) Under Article 3(1) of Commission Regulation (EC) No 2869/95 of 13 December 1995 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs)⁶, the President of the Office is competent to lay down the amount to be charged for any services rendered by the Office other than those specified in Article 2 of said regulation. In the absence of such a decision by the President of the Office, mediation should be free of charge.

HAS ADOPTED THE FOLLOWING DECISION:

Article 1 - Commencement

1. The request for mediation proceedings may be presented, by a joint declaration from the parties, at any time following the lodging of an appeal, against a decision of the Opposition Division, of the Cancellation Division or of the Invalidity Division.

2. The request for mediation proceedings is not available in cases of absolute grounds for refusal in the sense of Article 7 CTMR or Articles 3 and 9 CDR.

3. Mediation is free of charge unless otherwise provided for in a decision of the President of the Office.

4. Before the commencement of mediation, the parties shall sign an agreement on mediation, including clauses ensuring the authorization to negotiate a friendly settlement and confidentiality.

Article 2 - Suspension

1. The appeal before the Boards and mediation are separate proceedings. When the parties have requested mediation proceedings and the statement of grounds has been filed and, where applicable, the administration charges have been paid to the Office, the Board shall suspend the appeal proceedings pending the outcome of the amicable settlement.

2. In case mediation fails, the appeal proceedings shall be resumed.

⁶ OJ L 28, 6.2.1996, p. 11, as last amended by Regulation (EC) No 335/2009, OJ L 109, 30.4.2009, p. 3.

Article 3 - The mediator

1. The parties are invited to choose freely a mediator from the list provided by the Office.
2. Subject to Article 3.4 below, examiners and members of the Opposition Divisions, the Cancellation Divisions, the Invalidity Divisions, the Boards of Appeal or any other person may not be designated as mediator if he/she has any personal interest in the case or if he/she has previously been involved in the case under appeal.
3. Subject to Article 3.4 below, the members of the Board of Appeal to which the appeal is allocated cannot act as the mediator in that case.
4. The Mediator should not be disqualified according to Article 3(2) and (3) if the parties have been notified in writing of such circumstances and have subsequently expressly consented in writing to the designation of the mediator. In such circumstances the mediator may only agree to act or continue to act if he/she is certain of being able to carry out the mediation in a fully independent manner that ensures complete impartiality.
5. The mediator may not be involved as an examiner, member of the Opposition Divisions, the Cancellation Divisions, the Invalidity Divisions or the Boards of Appeal in any further proceedings of the case in issue or any related case.
6. The mediator shall conduct mediation according to the Rules on Mediation established by the Presidium.

Article 4 - Agreement of the parties

1. When the parties reach an amicable settlement that resolves their dispute, the terms of that agreement shall be set down in a settlement agreement signed by the parties.
2. The Board to which the case was initially allocated shall take note that an agreement was reached in its decision closing the proceedings. In the absence of an agreement on costs, the Board shall rule on the costs and fees of the proceedings, pursuant to Article 85 CTMR.

Article 5 - Confidentiality

1. The discussions and negotiations conducted within the framework of mediation shall be confidential for all persons involved in the mediation, in particular the mediator, the parties and their representatives.
2. All persons involved in the mediation shall keep confidential any information obtained during and in connection with the mediation. This includes not disclosing such information in any judicial, arbitration or other proceedings, in particular those before OHIM, unless there is an overriding legal obligation to do so. Information includes the request for mediation, the entire mediation process, the outcome of the mediation and any opinion, suggestion, concession or indication expressed.
3. Where a party discloses to the mediator information in confidence before, during or after the Mediation, the mediator will not disclose without consent that information to anybody, unless there is an overriding legal obligation to do so.
4. Confidentiality as set out in Article 5(1) and 5(2) does not apply to any documents, statements or communications which are submitted by the other parties or by the mediator in the proceedings and

which can be obtained independently from other sources by the party seeking to use them in judicial, arbitration or similar proceedings.

5. The parties shall not call the mediator as a witness, nor require him/her to produce in evidence any records or notes relating to the mediation, in any litigation, arbitration or other formal process arising from or in connection with the dispute and the mediation; nor shall the mediator agree to act as a witness, expert, arbitrator or consultant in any such process, unless otherwise expressly agreed by the parties in writing.

6. The Board shall not be informed by the mediator of any of the information referred to in Article 5.2. above.

7. Before the commencement of mediation, the parties, the mediator and any person attending the mediation shall sign a confidentiality agreement.

Article 6 - Liability

The mediator is not liable to any party for the outcome of the mediation and the compliance with the amicable settlement reached by the parties or the legality and enforceability of the agreement.

Article 7 - List of Mediators

1. The Office shall maintain a list of qualified members of its staff, who are suitably prepared to intervene in mediation proceedings in the sense of the present decision.

2. The list is established by the Presidium.

Article 8 - Entry into force

This decision shall enter into force on the 20th day following its publication in the Official Journal of the Office.

Done at Alicante, 5 July 2013

For the Presidium

Théophile M. MARGELLOS

Acting President of the Boards of Appeal