

IPM Intellectual Property Mediation Conference

29 - 30 MAY 2014 - ALICANTE SPAIN

To mediate or not to mediate....
**A totally unscientific survey among
ECTA's members**

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The survey

- The survey was organized in 3 main sections: mediation yes, mediation no, mediation why...
- The survey was circulated among some 35 members of the ECTA LAW Committee
- The survey was answered by around 65% of the members.
- The survey of course does not represent ECTA's views on mediation.....

ECTA's official views*

- ECTA welcomes the setting up of the Mediation service at OHIM. It is undoubtedly an improvement and a concrete attempt on behalf of the Office to meet users' needs.
- ECTA's main concern however is that the Mediation service in its current form either may come too late in the proceedings (when parties may have lost interest in solving the dispute amicably) or is too cumbersome and expensive as parties should meet (either in Alicante or in Brussels) which creates travel and work costs, especially for decision makers who should be present in a mediation process.
- Other areas of concerns for ECTA: confidentiality, mediators' independence and neutrality, costs, interpretation and translation services

* ECTA Position paper of June 19, 2012 on Decision No. 2011-1 of the Presidium of the Boards of Appeal of 14 April 2011 on the amicable settlement of disputes (“Decision on Mediation”)

Now the practitioners' view...

First section:

1) Have you ever done any mediation in IP matters?

YES 12 **NO 10**

2) Has your country any mediation procedure (mandatory or voluntary) for IP related matters?

YES 13 **NO 7**

3) Have you ever considered the Mediation offered by OHIM?

YES 2 **NO 19**

If you have considered mediation at OHIM can you briefly indicate the reason why?

3.a Because client asked;

3.b Because the other party asked;

3.c Because the rapporteur suggested;

3.d Because there were already discussions going on;

3.e Because none of the objections to mediation are well founded and one should give mediation a chance given that all pending problems/discussions between the parties can be solved and mediation is a tool which may potentially solve problems on the marketplace and not only on the registry.

If you have never considered mediation, can you briefly indicate which of the following would better represent the reason why?

3.a Because client has already paid the appeal fees

YES 10

3.b Because it would delay further the process

YES 11

3.c Because it adds extra cost to discuss the mediation procedure either in Alicante or in Brussels

YES 14

3.d Because of concerns about confidentiality

YES 9

3.e Because there is no certainty about who the mediator is, his/her qualifications/experience in mediation and his/her independence from OHIM

YES 10

3.f Because of other reasons.....

- a. Because if the partes wished to settle the matter amicably, they rather prefer negotiating directly with the other party's attorney (less expenses and more control of the outcome);**

- b. Because european companies (and their lawyers) are not used to it and in general to go into mediation one needs to be nimble and very flexible, e.g. if you are in a big company you might need to double check each proposal with your business and this is very time consuming...;**

- c. Because the problem is not worth the remedy. Most companies finds current opposition procedures to be a fast, cheap and expedient tool to resolve controversies even before they start and thus do not see any advantage in mediation but prefer the matter to be settled by the Office (or by a Court);**

- d. Because the winning party may not really have any incentive in view of the high confirmation rates of first instances' decisions by the Boards of Appeal in inter partes' cases. Thus the party who was successful before the Opposition or Cancellation Division knows the reversal of the favourable decision is unlikely....**

Which of the following would be in an incentive to increase recourse to mediation?

5.1 Have mediation procedures mandatory before oppositions

YES 4 NO 10

5.2 Have mediation procedures mandatory before appeals

YES 10 NO 5

5.3 Have mediation procedures be conducted by mediators chosen by the parties also from mediators not from OHIM

YES 13 NO 4

5.4 Have mediation procedures offered even outside Alicante free of charge by OHIM

YES 16 NO 2

5.5 Have mediation procedures be conducted via teleconferences

YES 14 NO 3

5.6 Have mediation procedures covered by absolute confidentiality

YES 13

5.7 Others: Allowing speedy decision finding; voluntary mediation in cooling off; mediators from industry; increase refunds of cost to make mediation more attractive; saving costs by refunding opposition fees;

5.8 Nothing I do not believe in mediation

YES 6

CONCLUSIONS?

No hat can fit all heads.

Mediation is, after all, a private process between private parties and the outcome is not a “verdict” but rather an agreement between the parties.

While often a mediation may solve a current, often isolated dispute, there will be cases where for strategic or business-driven objectives one party wants a public, widespread “declaration of infringement”. In such cases mediation is considered not to be appropriate and is thus dismissed under the heading “*IP cases are too complex for mediation*”.

While this may certainly be true in some cases, nonetheless, discussions between the parties assisted by a neutral facilitator, may result into solutions that would have been unheard of otherwise. And even though in the end the parties may decide that a solution is outside of reach and litigation is the unavoidable consequence, ultimately one party may decide that the fight is not worth a battle and just give up, saving times and resources which may better used for some other better project.

That's why, personally I favor mediation, although I am still not fully sure when and how it should take place during OHIM's proceedings.