

# Mediation : One experience



Cabinet Beau de Loménie

Aurélia MARIE

## HISTORY OF THE CASE

After several years of peaceful coexistence, B started litigating by opposing a national trademark application filed in Spain by A. Thereafter B filed oppositions against several national or international trademark applications filed by A.

B also opposed the EU designations of two international registrations.

A counter-attacked with an action for non-use against B's Spanish registration.

B also attacked A's previous Spanish registrations for non-use.



## HISTORY OF THE CASE

A and B met different times for discussions to try to find a settlement, without success.

The procedures continued. The losing party was systematically filing an appeal.

By the middle of 2013, and after almost 10 years of conflict, there were 9 pending Spanish procedures, among them 5 before the Supreme Court.



## HISTORY OF THE CASE

Two other procedures were pending before OHIM, one before the Board of Appeal.

A asked for suspension, because of engagement of an action against B's trademark for non-use.

OHIM then contacted the parties to propose mediation (Only possible for the procedure before the Board of Appeal).

The parties accepted.

As a result, the procedure before the Board of Appeal was also suspended.



## STARTING THE MEDIATION PROCESS

### Mediation:

- Normally the parties have to jointly file a mediation request. In the present case, no mediation request was filed but the parties agreed to enter into the mediation process.
- Also, the parties have to select a mediator on the OHIM mediators' list.



## STARTING THE MEDIATION PROCESS

In this case, because the parties did not agree on one name, two mediators were appointed (with the agreement of both parties).

NB : how to choose the mediator ?



What kind of consideration is to be taken into account ?

The parties have to agree on a contract for mediation, which includes a confidentiality agreement. All the mediation process remains confidential.

## THE MEDIATION CONTRACT

- Before the beginning of the mediation, the mediator sends the parties the contract for mediation, for signature.
- Normally it only concerns the pending litigation before the Board of Appeal.

NB : In this case, it was the means to try to find a global settlement: there was a modification to include all litigations.



## THE MEDIATION CONTRACT

- This contract defines the terms of the mediation, the parties' expectations, the information to be given, the place of mediation, the language of mediation.
- The contract also includes clauses designed to ensure that persons participating in the mediation are allowed to negotiate a settlement and have the capacity to engage their company.
- The contract can be modified. It has to be accepted and signed by both parties.



## THE MEDIATION CONTRACT

- Once signed, the parties have to prepare and to send the requested information: a case summary and documents.
- This information can remain confidential to the other party (if one party does not want to disclose it). One party can also provide the mediator with documents that he wishes to disclose in confidence to him alone.



## THE MEDIATION SESSION

- The mediator assists the parties with impartiality and makes a commitment to handle them on equal footing.
- The mediator shall make every effort to facilitate the conclusion of an amicable settlement.
- The mediator remains neutral to the parties.

Each party shall cooperate with the mediator to advance the mediation in order to reach an amicable settlement of the dispute as soon as possible.



## THE MEDIATION SESSION

The mediator is responsible for the conduct of the mediation

Development of the mediation:

- Presentation of the parties;
- Overview of the role of mediators;
- Several joint and separate sessions;
- During the first (joint) session, each party makes a preliminary statement, expressing his view on the facts, situation and the issues involved in the case;
- The parties then discuss separately and under confidentiality with the mediator ; the mediator tries to see where the position of the parties can evolve and meet and tries to convince them to move.



## AFTER THE MEDIATION SESSION

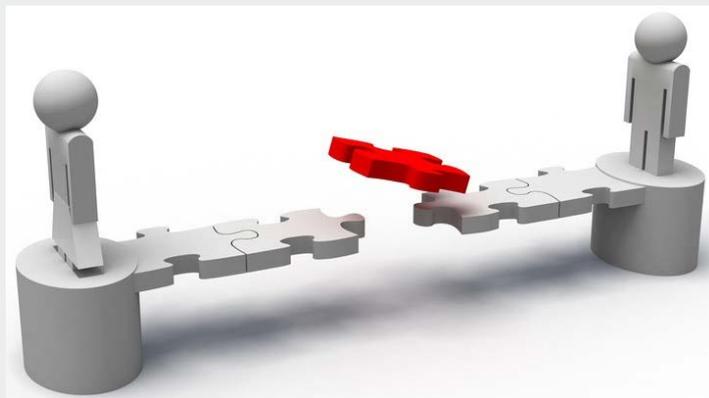
When agreement has been reached, a mediation agreement is discussed and signed during the mediation session.

This does not need to be a detailed agreement. It can provide just the heads of the settlement to be signed between the parties afterwards.



## AFTER THE MEDIATION SESSION

The final settlement agreement, in which the parties fix conditions for putting an end to their disputes on the basis of what was decided during the mediation session, is still to be negotiated and drafted.



The end of the mediation session is not the end of the process and having the settlement agreement signed can take time because several issues still need to be discussed.

!Don't forget to provide for the necessary steps for terminating the legal proceedings, and to make sure that those steps are engaged and achieved.

## CONCLUSION : TO MAKE THE MEDIATION A SUCCESS

Several issues to be considered:

- Choosing a mediator ( experience, language);
- Content of the contract for mediation: Representation and capacity to engage – confidentiality;
- Information to be given to the mediator;
- Need to be well prepared before the mediation session: what kind of agreement can be reached, the different positions that can be considered, the ones that cannot be accepted;
- The end of the mediation session is not the end of the process.

Thank you for your attention



Cabinet Beau de Loménie

158, rue de l'Université

F - 75340 Paris Cedex 07 France

[www.bdl-ip.com](http://www.bdl-ip.com)

Tel. : +33 (0)1 44 18 89 00 / Fax. : +33 (0)1 44 18 04 23

[contact@bdl-ip.com](mailto:contact@bdl-ip.com)