



Promoting Intellectual  
Property Rights in the  
ASEAN Region

## Topic 1: Mediation trends and practices in various IP areas

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2. Global trends in IP mediation
3. Assessing the suitability of IP dispute for mediation (i.e. comparison and synergies with other ADR modes)
4. Q&A



# Brief introduction about mediation

## Brief introduction about mediation: definition

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### MEDIATION

- Process in which parties to a dispute, guided by a mediator, try to reach an amicable settlement of their differences
- The mediator and the parties will attempt to identify common ground and business interests that may be explored in order to settle the dispute

## Brief introduction about mediation

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### Parties involved

- Mediator or Co-mediators
- Parties to a dispute
- Lawyers

### Phases

- Request/proposal for mediation
- Preparation
- Mediation day

### Principles

- Confidentiality
- Independence
- Impartiality



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# Global trends in IP mediation

## Global trends in IP mediation

### Cross-border conflicts

- Mediation as cross-border dispute resolution process
- Powerful tool to assist in changing perspectives

### Hybrids

- Med-arb
- Arb-med
- Med-ED

### Enforcement

- Singapore Convention
- Entered into force September 2020

## Global trends in IP mediation

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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 matter

European Code of Conduct for Mediators

European Union trade mark regulation

BoA Presidium decisions



## Global trends in IP mediation

Following global trends, EUIPO provides the following services:

- Mediation
- Conciliation
- Expert Determination
- Assisted negotiation
- EDR
- Hybrids



# Assessing the suitability of IP dispute for mediation

## Mediation in IP – evaluating suitability

### Advantages of Mediation:

- ✓ *Focus on commercial interests and on **business solutions***
- ✓ *Possibility of obtaining a **global solution** to complex IP disputes*
- ✓ **Flexibility** - *It is in the hands of the **Parties***
- ✓ **Saves** costs and time
- ✓ **Confidentiality**



## Mediation in IP – evaluating suitability

- ✓ **Cross-jurisdictional** disputes – need to avoid diverging judgments
- ✓ **Parallel** proceedings (IP Portfolio)
- ✓ Conflicts involving **different IP rights**
- ✓ Longstanding **relations** between the parties: licensee – licensor; agent/representative – trade mark owner; manager – company owner; family relations, etc.
- ✓ Future **commercial cooperation**
- ✓ Longstanding **conflicts** between the parties: parties have already negotiated but without success
- ✓ The parties' business activities are in **different** commercial areas
- ✓ Both parties have **strong and weak** legal points in the dispute – need to avoid legal uncertainty

## Examples – litigation vs mediation

A) Dispute between EU-based companies relating to similar product labels, registered as EU trade marks and national trade marks by both parties. Issue of scope of protection of weak marks, as the common element is descriptive.

➡ **Potential Result Litigation:** Parties would have mutually destroyed their trade marks by filing of cross-invalidity and revocation actions. Dispute would have lasted at EU and several national Member States for many years with huge costs involved.

➡ **Potential Result Mediation:** Agreement to delimit product labels by modifying the trade marks. Payment of compensation. Both parties maintain their trade mark rights. All EU and national proceedings closed.

B) Dispute between beer producer who has filed a EU trade mark with the intention of filing an International Registration designating 20 countries. A restaurant in Paris owns a reputed trade mark in France for alcoholic beverages which is highly similar.

➡ **Potential Result Litigation:** Parties would have litigated for years at EUIPO, the beer producer may lose EUTM and IR, and would have not been able to make business. Loss of a commercial opportunity.

➡ **Potential Result Mediation:** Coexistence agreement. Parties maintain their trade marks and agree to cooperate on a business level.



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