



CARIFORUM INTELLECTUAL PROPERTY RIGHTS & INNOVATION



ACT. 10 CARIFORUM IP MEDIATION WORKSHOP

29-30 March 2023



CARIFORUM



This Project is funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

caripi-hub.eu

Background:

IP Mediation is currently a growing trend in Intellectual property, and an increasingly sought-after method for the resolution of IP disputes. Considering the fact that criminal prosecution and civil action tends to be lengthy, complex and costly, IP Mediation and ADR procedures provides a feasible alternative to judicial and administrative litigation, thanks to its advantages of being cost and time effective as well as providing a mechanism to tailored to the needs and business interests of the parties involved in a dispute.

During AWP3, CarIPI collaborated with the Caribbean Court of Justice Academy for Law to organize a webinar on the interfaces between TMs and GIs and in July 2022 members of the regional judiciary also attended the EUIPO's IPCLC in Alicante. This webinar on ADR and IP mediation builds on past work undertaken by the project and continues the partnership with the Academy.

OBJECTIVES OF THE EVENT:

-  To increased awareness of the judiciary and legal professionals on matters related to IP mediation within global and regional perspectives
-  To engage with the WIPO Mediation and Arbitration Centre and the related centre in Trinidad and Tobago and exploring regional access to same
-  To enhance the capacity of regional judges and professionals in the specialized area of ADR and mediation within the context of IP-related disputes
-  To provide an opportunity for the exchange of best practices in the field of IP ADR and mediation

TARGET AUDIENCE:

 CARIFORUM judiciary


 Legal professionals

USEFUL INFORMATION:

 About the CarIPI Project: caripi-hub.com

 About the CCJ Academy for Law: <http://www.ccjacademy.org/>

 About WIPO ADR Center: [Alternative Dispute Resolution \(wipo.int\)](http://www.wipo.int/adr/center/)

 ADR Services – Trinidad and Tobago Intellectual Property Office: [Alternative Dispute Resolution services for intellectual property disputes in Trinidad and Tobago \(wipo.int\)](http://www.wipo.int/adr/center/)

INTELLECTUAL PROPERTY MEDIATION- SUMMARY OF ACTIONS

REMARKS FROM JUSTICE KOKORAM – CHAIR OF PANEL DISCUSSION ON REGIONAL IP MEDIATIONS MECHANISMS

Welcome all to this Regional Intellectual Property Mediation Discussion and Q and A¹. It is my privilege to chair this distinguished panel of experts who have over the last two days shared their considerable wealth of knowledge in ADR and its relevance to Intellectual Property (“IP”) issues. Consider this your mediation room and you the participants will hear the narratives of the distinguished panel. We will identify relevant issues together with you and identify possible options and ideas for consideration. Your session will move on to the wrap up and call for action which I hope will be the concluding phase of your “mediation” where you enter into some form of undertaking on what we can do tomorrow to deal with some of the issues being raised at this seminar.

Panellists and IP peacemakers just a few words to set the stage. Stepping back to look at these IP disputes be it patent copyright or trademark disputes. As a mediation practitioner these are disputes over rights to property in which the underlying concerns of the parties asserting those rights are certain core human values of respect, recognition and validation, self-worth and dignity, future development and legacy, future security financial and otherwise. These core human values are often either ignored in an adversarial litigious environment, inadequately addressed or repackaged into legal rights, burdens of proof, monetisation of wrongs, which misses the opportunity to treat the undercurrent to all of these disputes and to deal with sources of human conflict to promote joint gains and reconciling different perspectives on the use of resources.

There is a burning and urgent need for mediation to take centre stage in the resolution of IP disputes. As mediation practitioners, ADR is known not as Alternative Dispute

¹ 30th March 2023

Resolution but Appropriate Dispute Resolution. Mediation should not be viewed as alternative...it does not lie in the shadow of the law. In most cases it is the most appropriate form of dispute resolution for IP cases for all the reasons we have heard but more so for treating the underlying human values that I have identified. It brings a humanism to these disputes which cannot be underestimated.

We have heard of settlement rates and in Trinidad and Tobago there was in our recent mediation pilot projects satisfaction rates of parties of 90% demonstrating no surprise that parties value the ability to express themselves...expressing voice and gaining respect...critical benefits derived from a more humane way to deal with disputes. Mediation is the bridge of understanding between parties and restores reconciliation in oneself and a joint future.

Take for example an unfortunate case of a dispute over the ownership of the name of a fried chicken business. The case of **Japs Fried Chicken Limited v Nicholas Tomas and Bhagwatee Maharaj CV2014-02595** was a tug-of-war on trademarks for restaurant services. It presented as a dispute between an application for the registration of a trademark "Japs Fried Chicken....De Best Taste Around and Device" in February 2010 to the Registrar IPO which was opposed by the Defendant, Nicholas Thomas. Nicholas submitted his application to register his trademark "Japs and Device." Nicholas contended that he was the original "Japs." Bhagwatee, the third party, stated that she is called "Madam Japs" and Bhagwatee's son who is in charge of the management of the Claimant's company contended that he was referred to as "the Japs boy", the "Japs man" and "Mr. Japs." The Registrar stayed the applications until the right to the trademark had been determined by the Court. The dispute concerned essentially a family business started by a couple who had separated and who really is the real Japs...the common law wife and child or common law husband.

The Claimant was held not entitled to register the trademark and only Nicholas and Bhagwatee who jointly owned the original business were entitled to register it, Nicholas owning one half interest in the trademark.

On appeal², the Court of Appeal set aside the trial judge's decision. The Court of Appeal held among other things that it was unreasonable for the judge to hold that man who abandoned his pregnant wife, stripped their jointly owned business of critical assets to set up another restaurant would have any interest in making a future provision for his infant son and unborn child and the trial judge was plainly wrong to refuse the Claimant's application to register the trademark "Japs Fried Chicken."

This matter would have engaged the Court's attention for eight years from 2014 to 2022. The history of the matter would have revealed that the underlying issue deeply entrenched in the relationship of the parties, a matter that was ripe for mediation, the final conclusion being that the Claimant's trademark can be registered, a decision which Bhagwatee was unable to witness because she passed away in 2021.

Other famous disputes that bedevil our Caribbean are IP disputes of our famous music. In 2010 there was a famous dispute between the Attorney General v Professor Copeland on the rights of the State to a new innovation, the G pan that was settled in mediation. The mediator was a senior attorney with exposure to IP matters.

As Justice Anderson poignantly pointed out yesterday the call for action requires a change in culture in treating with IP matters:

- a. The change in culture requires attorneys, judges, IP offices to educate, to inform and to robustly encourage this form of mediation. I have advised attorneys that their ethical obligation is to inform clients of the benefits of ADR and mediation, to participate, collaborate and act in good faith in mediations. For judges I have advised that we are no longer adjudicators but expert dispute resolvers engaged in guiding and designing suitable dispute resolution pathways whether it is mediation or judicial mediation.

² Civil Appeal No. P297/2016

- b. The change in culture will require us to say mediation is an equally important pathway to resolving any IP disputes and to integrate the process in the services provided by IP offices and our judicial system. IP offices are the leaders, educators and change agents on the mind set on how IP disputes are to be treated sensitively and humanely and the Court must be seen as the gateway to ADR..... a trial will hopefully become the new Alternative to Dispute Resolution.

We will discuss today the environment for mediation in these discussions with our distinguished speakers and deal with three emerging themes:

1. The utility of mediation as a preferred ADR route to IP resolution;
2. Creating awareness of this option and;
3. Building capacity to offer IP mediation in the region

TAKE-AWAYS AND ACTION

1. REASONS TO USE MEDIATION IN IP DISPUTES/TYPES OF CASES SUITABLE FOR IP MEDIATION

- Provide timely and cost effective solutions
- Where enforceability in traditional litigation may be a challenge
- In complex IP matters and multiple rights, a global settlement becomes attractive
- Quality of process where expert IP specialist can mediate the dispute
- Where a business solution may be the better approach to the dispute

- Where joint gains are preferred

- Parties should in general practice court avoidance

- Where neutrality in forum is desired

■ 2. REINFORCING THE MESSAGE/EDUCATION

- There is a need to encourage the use of IP mediation and educate the public

- Need for attorneys to take a proactive role in using IP mediation

- Incorporate a pre-mediation phase where parties can be actively encouraged and advised on the benefits of mediation by a neutral

- Make the information about IP mediation easy to understand

- Incorporate ADR process in legislation

- Start with pilot cases to begin using mediation in IP cases

- Integrate ADR mechanisms when granting IP rights or licenses

- Integrate IP dispute resolution in syllabus not only in law programmes but also in business programmes at all levels

- Provide opportunities for sharing of experiences in this area especially in relation to regional mechanisms. The experience of the EU (and other regional systems for IP dispute settlement) can provide useful insights

Communication strategy on the benefits of IP mediation – targeting different levels (IPOs, Legal professionals, judiciary, creators/innovators, private and public sectors and academia)

3. CAPACITY

Qualities of a good mediator identified

Key trait is being faithful to process

IP mediation and IP knowledge is an asset

Law schools need to take active role in training attorneys and exposing them to mediation

The existing pool of IP attorneys should be exposed to mediation

End users need to be exposed to the use of mediation and offered training as mediators

There should be a dedicated public education programme to maintain the message about IP mediation

A list of arbitrators and conciliators is needed at the regional level

Focus on the youths

Develop cohesive training and development programmes

Focus on building a cadre of IP mediation experts from the legal and non-legal fields

The capacity for enforcement of agreements reached via mediation is critical to enforce the agreement

