



ევროკავშირი
საქართველოსთვის
The European Union for Georgia



WORKSHOP ON ALTERNATIVE DISPUTE RESOLUTION Successful mediation examples

Gordon Humphreys | Alicante | 02/07/2021

EU Georgia project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

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CASE 1 – SLIDES 3-7

CASE 2 – SLIDES 8-11

CASE 3 – SLIDES 12-16

CASE 1

- Conflict between two EU SMEs in the glass manufacturing sector
- Company A filed EUTMs (fig. and word) at EUIPO
- Opposed company B on basis of company name
- Overlapping element descriptive



CASE 1

- Both companies had various national registrations in EU, CH, UK, RUS, CN
- IPO proceedings in DE and HU
- Companies A and B wanted worldwide solution



CASE 1

- Company A represented by three trade mark attorneys and two in-house lawyers. CEO only partially present + interpreter
- Company B represented by external counsel and CEO
- 'You started it!' syndrome
- Company A: problematic trade mark attorneys and disengaged CEO



CASE 1

- Company B: frustrated CEO
- Separate the people from the problem – putting the CEOs together (WATNA)

Getting to Yes
Separate the People from the Problem



CASE 1

- Point by point negotiation: trade mark proceedings, use of company name, packaging, trade fairs, long phase out and new mark
- Coexistence agreement: (communication channels, applicable law and jurisdiction, penalty clause)

CASE 2

- Two-person Spanish company applied for an EUTM covering environmental audit
- Opposed by a large multinational energy company providing energy services (including environmental audit for the provision of energy)
- Opposition based on a number of earlier rights at international, EU and national level.
- EUTM applicant filed cancellation actions against all the earlier rights.

CASE 2

- Infringement proceedings commenced against EUTM applicant in Spain and in a number of other countries where the company had national registrations.
- Series of cross-actions all over EU and beyond both in IPOs and courts
- Significant legal fees incurred



CASE 2

- Failed negotiations
- Final attempt to settle
- Important imbalance in legal representation (David v Goliath)
- Red lines and authority
- Emotional stress



CASE 2

- Kamikaze mode
- Defensive marks and purchase option
- Drop hands
- Lump sum (amount)
- Heads of agreement + timeline



CASE 3

- Brussels niche bar registers Benelux mark and applies for EUTM for bar services.



CASE 3

- Mark alludes to famous GI
- Bar owner advertises heavily, takes personal loans and explores franchising possibilities in USA and Francophone Africa
- Bar owner sees himself as helping promote GI
- GI collective maintains zero tolerance policy

CASE 3

- Infringement proceedings in BE
- Cancellation proceedings BNX
- Opposition proceedings at EUIPO
- Managing unrealistic expectations
- Helpful lawyer (bar owner)
- Litigious outside counsel (GI)



CASE 3

- Divided in-house legal team (generational differences)
- Individual coaching
- Site visit

CASE 3

- Discovering other financial and employment law problems
- Appealing to reason
- Lump sum payment for rebranding





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