

**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”)

THE PRESIDIUM OF THE BOARDS OF APPEAL

Having regard to Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark¹, and in particular Articles 42(4) and 57(4) thereof,

Having regard to Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs² and Commission Regulation (EC) No 2245/02 of 21 October 2002 implementing the Council Regulation (EC) No 6/2002³, and in particular Article 31(5) thereof,

Having regard to Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs)⁴, and in particular Article 1(6) thereof,

Whereas:

(1) The Presidium of the Boards is competent to lay down the rules and organize the work of the Boards.

(2) The Boards may, if they think fit, invite the parties to arrive at a friendly settlement of their dispute in any inter partes proceedings. Such a friendly settlement should be easier to achieve with recourse to mediation, without prejudice to other alternative dispute resolution mechanisms.

(3) Mediation before the Boards should depend on the filing of an appeal. The parties may not request the suspension of the time-limit to file the statement of grounds as the statement of grounds is a condition of admissibility of the appeal.

(4) This Decision should apply to processes whereby two or more parties to proceedings at the Office attempt by themselves, on a voluntary basis, to reach an amicable agreement on the settlement of their dispute with the assistance of a mediator within the framework of the rules established by the Presidium. However, it should not apply to

¹ OJ L 78, 24.03.2009, p. 1.

² OJ L 3, 5.1.2002, p. 1 as last amended by Council Regulation (EC) No 1891/2006, OJ L 386, 29.12.2006, p. 14.

³ OJ L 341, 17.12.2002, p. 28, as last amended by Commission Regulation (EC) No 876/2004, OJ L 19, 25.7.2007, p. 13).

⁴ OJ L 28, 6.2.1996, p. 11, as last amended by Regulation (EC) No 2082/2004 (OJ L 360, 7.12.2004, p. 8).

rights and obligations on which the parties are not free to decide under the relevant applicable regulations, such as absolute grounds for refusal of a Community trade mark or design application.

(5) The mediation provided for in this Decision should be a voluntary process. It should remain swift and efficient.

(6) Parties to appeal proceedings should ask for mediation by means of a written agreement.

(7) The mediator should be a member of the Office's staff.

(8) Mediation should have the objective of terminating the appeal proceedings. The settlement agreement should contain a provision on the costs of the mediation proceedings. The Board competent to decide on the appeal should take note of the settlement of the case.

(9) The mediator should not be liable for the content of the written agreement resulting from mediation and whether its content is in accordance with applicable laws.

(10) Under Article 3(1) of Commission Regulation (EC) No 2869/95 of 13 December 1995 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs)⁵, the President of the Office is competent to lay down the amount to be charged for any services rendered by the Office other than those specified in Article 2 of said regulation. In the absence of such a decision by the President of the Office, mediation should be free of charge.

HAS ADOPTED THE FOLLOWING DECISION:

Article 1 – Commencement

1. The request for mediation proceedings may be presented, by a joint declaration from the parties, at any time following the lodging of an appeal, and the corresponding statement of grounds, against a decision of the Opposition Division, of the Cancellation Division or of the Invalidity Division.

2. The request for mediation proceedings is not available in cases of absolute grounds for refusal in the sense of Article 7 CTMR or Articles 3 and 9 CDR.

3. Mediation is free of charge unless otherwise provided for in a decision of the President of the Office.

⁵ OJ L 28, 6.2.1996, p. 11, as last amended by Regulation (EC) No 335/2009, OJ L 109, 30.4.2009, p. 3.

4. Before the commencement of mediation, the parties shall sign an agreement on mediation, including clauses ensuring the authorization to negotiate a friendly settlement and confidentiality.

Article 2 – Suspension

1. The appeal before the Boards and mediation are separate proceedings. When the parties request mediation proceedings, the Board shall suspend the appeal proceedings pending the outcome of the amicable settlement.

2. In case mediation fails, the appeal proceedings shall be resumed.

Article 3 – The mediator

1. The parties are invited to choose a mediator freely from the list provided by the Office.

2. Examiners and members of the Opposition Divisions, the Cancellation Divisions, the Invalidity Divisions or the Boards of Appeal may not be designated as mediator if they have any personal interest in the case or if they have previously been involved as representatives of one of the parties or if they have participated in the decision under appeal. The members of the Board of Appeal to which the appeal is allocated cannot act as the mediator in that case.

3. The mediator may not be involved in any further proceedings of the case in issue.

4. The mediator shall conduct mediation according to the rules established by the Presidium.

Article 4 – Agreement of the parties

1. When the parties reach an amicable settlement that resolves their dispute, the terms of that agreement shall be set down in a settlement agreement signed by the parties.

2. The Board to which the case was initially allocated shall take note that an agreement was reached in its decision closing the proceedings. In the absence of an agreement on costs, the Board shall rule on the costs and fees of the proceedings, pursuant to Article 85 CTMR.

Article 5 – Confidentiality

1. The discussions and negotiations conducted within the framework of mediation shall be confidential for all persons involved in the mediation, in particular the mediator, the parties and their representatives.

2. The Board shall not be informed by the mediator of the opinions expressed, the suggestions formulated, the proposals put forward, the concessions made, the information obtained or the documents furnished within the framework of the mediation.

3. Before the commencement of mediation, the parties shall sign a confidentiality agreement.

Article 6 – Liability

The mediator is not liable to any party for the outcome of the mediation and the compliance with the amicable settlement reached by the parties or the legality and enforceability of the agreement.

Article 7 – List of Mediators

1. The Office shall maintain a list of qualified members of its staff, who are suitably prepared to intervene in mediation proceedings in the sense of the present decision.

2. The list is established by the Presidium.

Article 8 – Entry into force

This decision shall enter into force on the 20th day following its publication in the Official Journal of the Office.

Done at Alicante, 14 April 2011

For the Presidium
President of the Boards of Appeal
Paul Maier