

OHIM BOARDS OF APPEAL

MEDIATION

INSTRUCTIONS TO PARTIES

1.0 Introduction

1.1 The possibility of settling a dispute by way of mediation at the Office for Harmonization in the Internal Market (“OHIM”) has been made available. At present, such a possibility is only open to parties who bring an appeal before the OHIM Boards of Appeal (see 2.0 below). The idea behind this innovation is to facilitate the parties in the search for a friendly settlement that will be expeditious, acceptable for all concerned and avoid the cost and stress of lengthy litigation before the OHIM Boards of Appeal, the Courts of the European Union and, possibly, national courts. Mediation will not be limited to the normal scope of OHIM appeal proceedings but may embrace future and present commercial and economic interests of the parties. Mediation is an interest-based procedure rather than a rights-based procedure. It is a confidential procedure. The advantage of using OHIM led mediation is that no fee is charged for the mediator and use of the OHIM premises for the mediation. Moreover, apart from guaranteeing independence, OHIM mediators are highly specialized in Community trade mark and design matters.

2.0 Time for initiating mediation

2.1 To initiate mediation, it is first necessary for there to be a decision on trade mark or design matters that has been taken in inter partes proceedings. Parties may not seek mediation in ex parte proceedings.

2.2 Within two months of that decision (the “contested decision”) having been taken, one of the parties must lodge an appeal before the OHIM by:

- Filing a notice of appeal;
- Paying the appeal fee of EUR 800.

Within four months of the contested decision, a statement of grounds must also be submitted.

2.3 No extension or suspension of the four-month time limit is possible. The fulfillment of all the conditions outlined above is required before mediation before the OHIM can commence.

3.0 Subject-matter of mediation

3.1 Mediation at OHIM is confined to trade mark and design matters that have reached the appeal stage. See further para. 1.1 above.

4.0 Need for a written request

4.1 Once those conditions are fulfilled, parties wishing to settle their dispute on trade mark or design matters should submit a written request to the OHIM. There is no time limit for submitting the request for mediation to the OHIM but the more advanced the appeal proceedings, the greater the costs that will have been incurred and the less expeditious the mediation. Clearly, mediation before the OHIM is no longer an option once the Board of Appeal has notified its decision.

4.2 A request may be sent by fax or mail to:

OHIM,
Registry of the Boards of Appeal (Mediation),
Avenida de Europa 4,
E-03008 Alicante (Spain)
Fax: +34 965 131 344 #####

5.0 Content of the request

5.1 The mediation request should contain the following information:

- An identification of the contested Community trade mark or design. This should be done by citing the relevant Board of Appeal case number (e.g. R1234/2010-1);
- A specific request made by both parties for the dispute to be settled by mediation before the OHIM;
- Preferably, a designation of the OHIM mediator who will facilitate the mediation. This is done by choosing the name of a person from the list of qualified OHIM mediators made available by the OHIM. Please be aware that if you select the name of a person who has been designated as the rapporteur in the relevant appeal proceedings, that person will no longer be able to act as rapporteur should the mediation fail and it be necessary to recommence the appeal proceedings. A person who has acted in a decision-making or advisory capacity in the contested decision may also not act as mediator in that same case. The mediator must not have any personal interest in the case. If you choose a language other than English (see indent below), you must check that the mediator has the necessary linguistic competence to conduct the mediation in that language (since interpretation and translation services will not be made available by the office). To assist you in this task, a short curriculum vitae is

attached by way of a hyperlink to each name on the list of qualified mediators mentioned above;

- If applicable, an indication of the language (which may be one of the 23 official languages of the European Union) in which the mediation is to take place. In the absence of such an indication, the mediation will be in the language of the contested decision and the appeal proceedings;
- Full contact details of the parties to the mediation;

- The signature of both parties to the dispute (or the signature of one of the parties, followed by a letter of confirmation by the other party agreeing to the request). The signature of one or more representatives may substitute that of the parties.

6.0 Qualified mediators

6.1 Please note that mediation conducted by the OHIM only uses multilingual members of OHIM's own staff who are also qualified mediators and observe the European Code of Conduct of Mediators. It is not possible to choose outside mediators for mediation conducted by the OHIM (although the parties are, of course, always free to reach their own friendly settlement by whatever means they see fit without the intervention or assistance of the OHIM).

6.2 Some of the OHIM mediators are also members of staff of the Boards of Appeal. However, no mediator may sit as a member of a Board of Appeal in an appeal case in which he or she has been involved as a mediator. This guarantees the independence of the mediator and the Board of Appeal members.

7.0 Suspension of the appeal proceedings

7.1 Once the mediator receives the request for mediation, the Board to which the case has been assigned will be informed.

7.2 Mediation is only possible at the appeal stage of OHIM proceedings. Therefore, a notice of appeal and statement of grounds must be filed before the Office. The EUR 800 appeal fee must also be paid. It is only at this stage that the appointed mediator will ask the Board to whom the appeal is assigned to suspend the appeal.

7.3 It follows that the appeal proceedings before the Board of Appeal assigned to the specific case and the OHIM mediation proceedings are linked but separate proceedings. They are linked in the sense that it is necessary to lodge an appeal before initiating mediation. They are separate because once mediation is requested and the other matters mentioned in para. 7.1 and 7.2 above are performed, the appeal proceedings will be suspended until the mediation is terminated. If the mediation leads to the parties agreeing on a friendly settlement, the case will be sent back to the Board to take note of the withdrawal of the appeal by way of a short, purely formal decision. If no friendly

settlement can be reached, or if at any time during the mediation proceedings either of the parties asks for the resumption of the appeal proceedings, the case will resume before the Board of Appeal and the mediation will be automatically terminated.

7.2. No minutes or written records of the mediation proceedings will be kept. Therefore, where the mediation fails or is otherwise terminated, the appeal proceedings will be resumed without any reference to anything that has come to light in the mediation.

8.0 First contact with the mediator

8.1 Once the mediator has been designated, he or she will contact the parties to discuss the following matters:

- a timetable for the mediation to take place,
- its location,
- the need for a preliminary exchange of documents prior to the mediation taking place.

8.2 In exceptional circumstances, or where the parties request the same, the mediator may ask the parties to meet with him or her at OHIM's premises in Alicante prior to commencing the mediation. The purpose of such a meeting would be to agree the ground rules of the mediation process in a particularly complex case and agree on exchange of documents.

8.3 Following the first meeting with the parties, the mediator may consider it appropriate in the circumstances of the case to be assisted by another member of OHIM's staff. In such an event, the mediator will make the selection and inform the parties as soon as possible thereafter, requesting their approval. The parties should respond as quickly as possible to this request. Once the approval is given, the other member of OHIM's staff will be bound by the same obligations of confidentiality as the mediator.

9.0 Agreement on mediation

9.1 Prior to the commencement of the mediation, the mediator will send an agreement on mediation to the parties for signature. That agreement includes clauses designed to ensure that the parties have the necessary authorization to negotiate a friendly settlement and that confidentiality is preserved.

9.2 The agreement on mediation needs to be signed and returned to the OHIM as soon as possible.

10 Mediation at the OHIM's premises

10.1 For the mediation to have the best possible chances of success, it is vital that the parties themselves attend the mediation. Legal aspects are only part of the overall

considerations that are relevant in mediation and often business aspects are more important. For these reasons the OHIM recommends that parties do not just send their professional representatives to the mediation. Instead, parties should come in person, either accompanied by their professional representatives, or alone. Any person representing a party must be fully authorized to act and have full knowledge of the business interests of the company.

10.2 Parties are encouraged to elect to mediate at the OHIM premises in Alicante. These premises are fully equipped with telephones, faxes, printers and Internet connections. There will be no charge for use of the OHIM's premises. The OHIM also has premises in Brussels. An additional fee is payable for use of these premises.

10.3 Depending on the complexity of the case, the mediator will normally set aside one day for the mediation. The precise format of the mediation may vary but as a general rule it will involve an alternation of joint sessions and individual sessions. In the first joint session(s) both parties sit together with the mediator and each party will make an opening statement, expressing his or her views on the facts and issues at stake in the case. From that information, the mediator will then, together with the parties, try to draw up a list of the main issues to be resolved. In the ensuing individual sessions, the mediator sits with each party separately and explores those issues and possible solutions. Anything disclosed to the mediator in those individual sessions is confidential and may not be disclosed to the other party unless the disclosing party specifically authorizes the mediator to do so. Further joint sessions will be held to try to reach a common position and, ultimately, to draw up and sign a settlement agreement.

10.4 While the mediator will make best efforts to facilitate the conclusion of a friendly settlement, he or she will not draft the actual settlement agreement, will not proffer legal advice and will remain neutral at all times vis-à-vis the parties. As already mentioned, the mediation is confidential and anything related to the mediator in the individual sessions will be kept confidential unless the party concerned specifically authorizes the mediator to convey that information to the other party.

10.5 As already mentioned the mediation will, unless agreed otherwise, be conducted in the language of the appeal proceedings. Parties who wish for translation or interpretation services during the mediation must make their own arrangements and pay for them themselves. They should, of course, inform the mediator as soon as possible before the mediation meeting is held so that he or she can make the necessary arrangements for office accommodation, seating and light refreshments, where the mediation takes place at the OHIM's premises in Alicante.

11 Confidentiality

11.1. The mediator is bound by an obligation of confidentiality and the mediation proceedings are themselves confidential. In the course of the mediation, the parties cannot be compelled to disclose information that they prefer to keep confidential.

11.2 Neither the mediator nor the parties may make any reference to the contents of the mediation in subsequent proceedings, unless expressly authorized to do so.

12 Termination of the mediation

12.1 While the parties should intend to make their best endeavours to reach an agreement, they are free to withdraw from the mediation at any time. Such a withdrawal will immediately terminate the mediation. The mediator will inform the Registry of the Boards of Appeal of this termination and the appeal proceedings will automatically resume. In such a case, any unexpired time limits that were suspended during the mediation will immediately resume.

12.2 Where the mediator considers that the mediation has reached a stalemate situation or impasse, he or she may terminate the proceedings. The mediator will inform the Registry of the Boards of Appeal of this termination and the appeal proceedings will automatically resume. In such a case, any unexpired time limits that were suspended during the mediation will immediately resume.

12.3 Where the mediation is successful, a settlement agreement will be drawn up under the auspices of the mediator and signed by the parties. The agreement will terminate the dispute between the parties, by noting the closure of the proceedings before the OHIM and will bring the mediation process to a close. As already mentioned, the case will then be remitted to the assigned Board of Appeal and a formal decision, noting the closure of the appeal proceedings will be notified and entered on the Register of Community trade marks or designs, as the case may be.

12.4 Settlement agreements will not be kept by the Boards of Appeal's registry.