

Examples

of mediation

cases



Alternative Dispute

Resolution (ADR)

in practice

Disclaimer: While the case studies are based on real mediations, the parties' names, countries, goods or services and/or the name of IP rights involved have been omitted or modified for confidentiality purposes. The cases have been summarised.

Battle of CEOs

Two medium-sized glass manufacturers, “Macatix” and “Caroleto”, with their seat in different EU countries, disagreed over a series of trade mark rights.



ORIGIN OF THE DISPUTE

Macatix filed several figurative trade marks at a Trade Mark Office. Caroleto opposed to them since Macatix's trade mark contained verbal elements that overlapped with Caroleto's earlier marks.

In addition, both companies had a number of national registrations in EU member states, as well as in Switzerland, the UK, Russia and China. At that point, opposition proceedings had also been initiated before the German and Hungarian IPOs, and soon new oppositions would be filed in other jurisdictions.





DECISION TO TRY ADR

After carefully looking into the file and considering the nature of the case and the real possibility that the conflict would escalate even beyond EU jurisdictions, the case handler at the trade mark office saw the suitability of the dispute for mediation. It didn't take a lot of convincing for the parties to **accept mediation as a possibility to find global solutions to settle the ongoing disputes in one process.**



EXAMPLES OF MEDIATION CASES



CHALLENGES

Macatix came to the mediation day with a lot of company muscle - the company's CEO, three trade mark attorneys, two in-house lawyers and an interpreter - but soon after its start, the CEO left the meeting, delegating all power to his lawyers.

On the other side, Caroleto just counted upon the presence of its CEO and an external counsel.

This lack of commitment to the process and the imbalance of representation started creating a sense of frustration for Caroleto's CEO, and **the situation only became worse** as Macatix lawyers took over the discussions by focusing on technicalities that made understanding and any progress difficult.





RESOLUTION

Seeing the impasse, the mediator overcame the situation by claiming back the presence of the Macatix CEO and putting him together with Caroleto's CEO. Under the guidance of the mediator, the two CEOs held a direct and honest dialogue and were finally able to find points of agreement as they started focusing on their wider business interests, looking beyond just the contested trade marks.

Thanks to this approach, Macatix and Caroleto reached a comprehensive trade mark coexistence agreement, which settled all pending disputes. In this case, the settlement agreement included a penalty clause, although the parties did not had to recur to any enforcement. Mediation and the expert guidance of a trained and skilled mediator can therefore be a valuable tool for solving conflicts that span over several jurisdictions and include many IP rights and other commercial and business interests.



Clocks or watches?

Two producers of timepieces, 'Au Temps', a French company, and 'Fast Tempus', based in Spain, clashed in a dispute over a number of trade marks during the COVID-19 pandemic lockdown.



ORIGIN OF THE DISPUTE

Both companies had a number of opposition proceedings at the EUIPO, where national and EU trade marks were involved as earlier rights. The case seemed quite entangled, with apparently overlapping specifications and similar trade marks names.

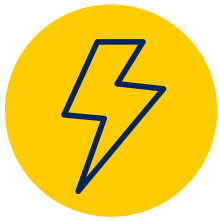




DECISION TO TRY ADR

The companies had a history of failed previous negotiation attempts. In this context, the case handler saw potential for a friendly settlement, as the specifications could possibly be subject to respective limitations. **The parties agreed to conduct the mediation online, so they were able to progress** even in the middle of the COVID-19 pandemic lockdown.





CHALLENGES

In this case, the mediator appreciated that language and product terminology were an important source of confusion. In French, the word "*montre*", is a watch – i.e. a wearable timepiece while an "*horloge*" is a clock, a non-wearable timepiece. However, in Spanish the word "*reloj*" is used to describe both terms.

During the negotiations that failed prior to the mediation process, the parties had prepared a draft agreement in Spanish which was then translated to French – but it didn't take into account the two possible meanings of "*reloj*". Due to this confusion, the agreement did not support a suitable solution until the mediator intervened.





RESOLUTION

At the mediation day, the mediator addressed the CEOs and obtained their direct engagement for solving the conflict. In the meeting, thanks to the facilitation of the mediator, the parties addressed the terminology issue and were able to discuss agreement terms based on their different specialization, as Fast Tempus markets watches and Au Temps markets clocks.

After detailed negotiations the parties reached an agreement by placing limitations on their trade marks and finally withdrawing the oppositions, honouring the terms of the settlement agreement. This case shows that even when sectorial obstacles appear, the mediator's profound expertise and understanding of IP rights and their scope of protection can help the parties reach a satisfactory and workable solution.



Agreement reached in a day

The conflict occurred between, on one hand, Mr. Smith, a famous gymnast owner of a renowned gym in a big EU city, and on the other hand, Ms. Fernández, the owner of several gyms in another EU country.



ORIGIN OF THE DISPUTE

Both parties had very similar trade marks for gym services and were entangled in opposition proceedings at the IP Office.



DECISION TO TRY ADR

Privately, the parties had attempted negotiations but these were progressing very slowly because they failed to understand each other's interests. **However they both really wanted to solve the problem quickly as time was a sensitive issue in their respective business moments.** On the initiative of the case handler at the EUIPO, they agreed to ask for mediation.





CHALLENGES

The parties had never had face to face contact or meetings and all the bilateral communications had been through their lawyers. **This distanced approach did not help the parties relate and understand each other's perspective.**



EXAMPLES OF MEDIATION CASES



RESOLUTION

Understanding this situation, the mediator quickly organized a mediation session so that the parties could meet face to face. This was very helpful because the parties realized their own and their counterpart's positions more clearly. **In face-to-face negotiations – even if conducted online – there is more flexibility and the parties can make requests on certain points and give in on others.** In this case, the conflict became more approachable and introduced the human component.

The mediator efficiently conducted the mediation that allowed the parties to reach a coexistence agreement – and as the parties wished, very quickly: **the agreement was signed on the same day.** Pursuant to the agreement, Ms. Fernandez converted her trade mark to a national trade mark, since she did not want to expand her business abroad. Mr. Smith, in turn, agreed not to expand his business in Ms. Fernandez's country. **Mediation is a process owned by the parties and they decide on the timing, the outcome and the agreement.** In this case, the mediator demonstrated her skills in guiding the process that facilitated the articulation of the agreement to the satisfaction of the parties.





Examples of mediation cases