

## MEDIATION IN TRADE MARK DISPUTES. THE BENEFITS OF MEDIATION IN THE BATTLES OF THE TRADE MARKS

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Résumé de l'article

Une marque reconnue est un atout précieux pour son propriétaire. Elle « vend » les biens ou services pour lesquels elle est utilisée et constitue une clientèle fidèle, donnant au propriétaire de la marque un avantage concurrentiel sur le marché de ces biens et services. Le processus de construction et de maintien de la réputation d'une marque nécessite des ressources et une persévérance considérables et est souvent entouré de divers litiges. L'objectif de cet article est de présenter brièvement, sans prétendre à l'exhaustivité, les spécificités des litiges en matière de marques et les avantages de la médiation comme moyen de les résoudre. Une brève introduction à certains concepts de base des marques est incluse pour donner une idée de la complexité des litiges en matière de marques. Des exemples de litiges en matière de marques résolus par négociation ou médiation sont également inclus. Étant donné que les dispositions pertinentes des lois nationales sur les marques varient d'un pays à l'autre, le règlement (UE) 2017/1001 sur la marque de l'Union européenne est utilisé dans le texte comme loi de référence. On peut conclure que la médiation dans les litiges relatifs aux marques offre aux parties des avantages importants par rapport aux méthodes traditionnelles de résolution de ces litiges dans le cadre de procédures administratives ou judiciaires contradictoires. En outre, des instruments tels que la directive 2008/52/UE et la Convention de Singapour sur la médiation permettent de rendre exécutoire les accords de règlement résultant de la médiation.

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# MEDIATION IN TRADE MARK DISPUTES. THE BENEFITS OF MEDIATION IN THE BATTLES OF THE TRADE MARKS

Lyubka VASSILEVA-KARAPANOVA<sup>90</sup>

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*Mediation in trade mark disputes. The benefits of mediation in the battles of the trade marks*

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## RÉSUMÉ

Une marque reconnue est un atout précieux pour son propriétaire. Elle « vend » les biens ou services pour lesquels elle est utilisée et constitue une clientèle fidèle, donnant au propriétaire de la marque un avantage concurrentiel sur le marché de ces biens et services. Le processus de construction et de maintien de la réputation d'une marque nécessite des ressources et une persévérance considérables et est souvent entouré de divers litiges. L'objectif de cet article est de présenter brièvement, sans prétendre à l'exhaustivité, les spécificités des litiges en matière de marques et les avantages de la médiation comme moyen de les résoudre. Une brève introduction à certains concepts de base des marques est incluse pour donner une idée de la complexité des litiges en matière de marques. Des exemples de litiges en matière de marques résolus par négociation ou médiation sont également inclus. Étant donné que les dispositions pertinentes des lois nationales sur les marques varient d'un pays à l'autre, le règlement (UE) 2017/1001 sur la marque de l'Union européenne est utilisé dans le texte comme loi de référence. On peut conclure que la médiation dans les litiges relatifs aux marques offre aux parties des avantages importants par rapport aux méthodes traditionnelles de résolution de ces litiges dans le cadre de procédures administratives ou judiciaires contradictoires. En outre, des instruments tels que la directive 2008/52/UE et la Convention de Singapour sur la médiation permettent de rendre exécutoire les accords de règlement résultant de la médiation.

## ABSTRACT

A well-recognized trademark is a valuable asset for its owner. It "sells" the goods or services for which it is used and builds a loyal customer base, giving the brand owner a competitive advantage in the market for those goods and services. The process of building and maintaining the reputation of a trademark requires considerable resources and persistence and is often surrounded by various disputes. The purpose of this article is to outline briefly, without claiming to be exhaustive, the specifics of trademark disputes and the benefits of mediation as a means of their resolution. A brief introduction to some basic trademark concepts is included to give an idea of the complexity of trademark disputes. Examples of trademark disputes resolved through negotiation or mediation are also included. As the relevant provisions of national trademark laws vary from country to country, the Regulation (EU) 2017/1001 on the European Union Trademark is used in the text as a reference law. It can be concluded that mediation in trademark disputes provides the parties with important advantages compared to traditional ways of resolving these disputes in adversarial administrative or judicial proceedings. Furthermore, instruments such as Directive 2008/52/EU and the Singapore Convention on Mediation enable the enforceability of settlement agreements resulting from mediation.

## 1. INTRODUCTION

**[711]** The main function of a trade mark is to distinguish the goods or services of its proprietor from those of other entities in the same market, thus allowing consumers to make choices based on their expectations associated with the specific trade mark. A well-recognized and reputable trade mark gives a competitive advantage to its owner, as it creates a loyal customer base and "sells" the goods or services for which the trade mark is used. The process of building and maintaining the reputation of such a trade mark, though, requires significant resources and persistence. That is why it is often connected with different disputes that aim to protect the distinctive character and reputation of the trade mark by preventing the registration or any unauthorized use on the market of similar signs by a person other than the trade mark owner. Conflicts also arise in relation to breaches of contracts relating to trademark rights, such as licensing and co-existence agreements. All these disputes are not only time-consuming and costly but also often require court or administrative proceedings in different jurisdictions. In addition, the existence of the conflict may negatively impact the business of the disputants, their reputation, and the image of the products or services for which the contested mark is used. In this context, the opportunity to resolve the conflict quickly and discretely could be beneficial for both parties.

**[712]** Is mediation suitable for the resolution of such conflicts, and what benefits does it bring to the parties?

**[713]** From a legal point of view, there are no restrictions on trade mark disputes being resolved in mediation, except as regards rights and obligations that are not at the parties' disposal under the relevant applicable law. In fact, many trade mark organizations and registration authorities, including the European Union Intellectual Property Office (hereinafter referred to as EUIPO or the Office) and the World Intellectual Property Organization (hereinafter referred to as WIPO), offer mediation and other ADR services in trade mark disputes.

**[714]** From a practical point of view, mediation gives the parties important advantages in comparison to the traditional means of resolution in adversarial administrative or court proceedings. It not only saves the parties time and money and prevents potential damages to their reputation and/or the reputation of the contested trade mark, but also allows the parties to find dispute resolution options tailored to meet their specific needs and business interests. In addition, settlement agreements resulting from mediation can be made enforceable thanks to legal instruments such as the EU Directive 2008/52 on certain aspects of mediation in civil and commercial matters<sup>91</sup> and the Singapore Convention on Mediation<sup>92</sup>.

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91 THE EUROPEAN PARLIAMENT and THE COUNCIL OF THE EUROPEAN UNION. Directive 2008/52/EC of the European Parliament and of the Council of 21 May 2008 on certain aspects of mediation in civil and commercial matters, OJ L 136, 24.5.2008, online: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32008L0052>

92 United Nations: United Nations Commission on International Trade Law. *United Nations Convention on International Settlement Agreements Resulting from Mediation*, March 2019, online: [https://uncitral.un.org/sites/uncitral.un.org/files/singapore\\_convention\\_eng.pdf](https://uncitral.un.org/sites/uncitral.un.org/files/singapore_convention_eng.pdf)

## 2. TRADE MARKS BASICS

### 2.1 TRADE MARK – DEFINITION AND FUNCTION

**[715]** There is no globally uniform legal definition of a trademark<sup>93</sup>; the wording used to define it varies from legislation to legislation and from source to source; however, the common understanding is that **a trademark is a sign used in commerce to distinguish the goods or services of its owner from those of all other entities**<sup>94</sup>. Its **first and most important function is to serve as a sign of origin from a particular manufacturer or service provider**, which implies an expectation of certain product or service qualities or prestige associated with the trademark. In other words, a trademark allows consumers to distinguish between goods of a similar kind when choosing as to which to buy and, depending on the satisfaction they have received from the product, to repeat or avoid their next purchase.

**[716]** A trade mark may consist of any signs, in particular words, including personal names, designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of 1) distinguishing the goods or services of one undertaking from those of other undertakings; and 2) being represented in a manner that enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor (Art. 4 of the Regulation (EU) 2017/1001 on the European Union Trademark)<sup>95</sup>.

**[717]** The sign must also conform with some other requirements to be registered and given protection as a trade mark, e.g., not to be descriptive or misleading with regards to the respective goods and services covered by the trade mark; not to consist exclusively of words or signs that have become customary in the current language or in the bona fide and established practices of the trade; not to be contrary to public policy or accepted principles of morality, etc. (These are the so-called "absolute grounds for refusal" specified in Article 7 of Regulation (EU) 2017/1001, for which the Office examines *ex officio*.)

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93 The text is based on the provisions of Regulation (EU) 2017/1001 on the European Union trade mark, as the relevant provisions of the national trade mark laws vary from country to country.

94 "A trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises." (WIPO. *What is a trademark?*, online: <https://www.wipo.int/trademarks/en/>);

"Trade marks are signs used in trade to identify products" (EUIPO. *Trade Mark Definition*, online: <https://euipo.europa.eu/ohimportal/en/trade-mark-definition>);

"A trademark can be any word, phrase, symbol, design, or a combination of these things that identifies your goods or services. It's how customers recognize you in the marketplace and distinguish you from your competitors." (USPTO (United States Patent and Trademark Office - An Agency of the Department of Commerce), "*What is a trademark?*", online: <https://www.uspto.gov/trademarks/basics/what-trademark>);

*Trademark*: "a name or symbol on a product that shows it was made by a particular company, and that it cannot be used by other companies without permission." (Cambridge Dictionary, online: <https://dictionary.cambridge.org/dictionary/english/trademark>)

95 THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION. Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, OJ L 154, 16.6.2017, online: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32017R1001>;

## 2.2 THE MAIN SPECIFICS OF THE TRADE MARK PROTECTION

### 2.2.1 AS A GENERAL RULE, THE RIGHT OVER A TRADE MARK IS OBTAINED BY REGISTRATION

**[718]** This is specifically the case with the European Union trade mark, for which it is explicitly stated in Art. 6 of Regulation (EU) 2017/1001 that "an EU trade mark shall be obtained by registration".

### 2.2.2 RIGHTS

**[719]** The registration of a trademark confers on its owner exclusive rights in that mark, including the right to use it for the goods and services for which it is registered, to dispose of it, to sell it, to license it, etc., and to prevent any unauthorized use of the mark or a sign similar to it. These rights are absolute, meaning that they are enforceable against any person.

### 2.2.3 LIMITATIONS OF THE SCOPE OF PROTECTION

**[720]** Trade mark protection is not unlimited, though. Certain limits define the scope of protection with regard to the sign, the goods and/or services, the territory to which the protection extends, as well as the time for which such protection is granted.

#### 2.2.3.1 SIGN

**[721]** First, the scope of protection is determined by the characteristics of the sign registered as a trade mark and the goods and services for which that mark is registered. The trade mark owner can prohibit the use of the same sign for goods and services identical to those for which the trade mark is registered.

**[722]** Furthermore, he can prohibit the use of similar signs for identical or similar goods, provided that, because of these similarities, there is a likelihood of confusion on the part of the public, including the likelihood of association between the sign in question and the trade mark (Art. 9 (2) of the Regulation (EU) 2017/1001)<sup>96</sup>.

**[723]** Trade marks with a proven reputation enjoy enhanced protection, which extends to signs used for goods and services that are neither identical nor similar to those for which the reputed trade mark is registered, provided that such use takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark. (Art. 9 (2) (c) of the Regulation (EU) 2017/1001).

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<sup>96</sup> Regulation (EU) 2017/1001, Art. 9 (2) "...the proprietor of that EU trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

(a) the sign is identical with the EU trade mark and is used in relation to goods or services which are identical with those for which the EU trade mark is registered;

(b) the sign is identical with, or similar to, the EU trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the EU trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

(c) the sign is identical with, or similar to, the EU trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the EU trade mark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trade mark."

### 2.2.3.2. TERRITORIAL SCOPE OF PROTECTION

**[724]** The territorial scope of protection of a trade mark depends on the territories for which it is registered. In this context, there are three main registration systems: 1) national (for the territory of one country); 2) regional (for the territory of several countries in one region, e.g., Benelux, the European Union, etc.); and 3) international<sup>97</sup> (for the territory of several countries, irrespective of the region.)

**[725]** A trade mark registered with the registration authority and under the national legislation of one country (a "national trade mark") enjoys protection on the territory of that country only.

**[726]** A regional trademark registered under a regional registration system is protected throughout the region covered by the respective regional system. A clear example of such a trade mark is the EU trade mark<sup>98</sup>, which has a unitary character and, once registered, is protected in the entire European Union.

**[727]** As for the international registrations under the Madrid Agreement and/or Madrid Protocol, the trade mark is protected in the country of its basic application for registration as well as in the other countries designated in the request for the international registration, to the extent that the respective national authorities of some of them have not objected to or denied the registration in their country.

### 2.2.3.3. LIMITATIONS IN TIME

**[728]** The protection granted to a trademark expires 10 years after its registration, but the registration may be renewed an unlimited number of times for subsequent periods of 10 years. Protection can therefore continue in perpetuity provided that the trade mark registration is renewed in due time and a renewal fee is paid.

## 2.3. THE "GENUINE USE REQUIREMENT"

**[729]** As the protection given to the trade mark prevents anyone other than the trademark owner from using the same or similar sign, such a restriction is only justified when the trade mark is used. That is why, once registered, the trade mark must be used by its proprietor (or with his consent) in connection with the goods and services for which it is registered. If such use has not been commenced within 5 years from the registration or the mark has not been used for any subsequent period of 5 years, it could be cancelled on request of anyone (Art. 18 in connection with Art. 58 (1) (a) of the Regulation (EU) 2017/1001).

**[730]** In fact, the request for proof of the genuine use of a trade mark on which an opposition, cancellation, or infringement action is based, or a request for its cancellation due to non-use, are some of the most powerful defensive strategies against that trade mark and are frequently used in trademark disputes. Such a request places the burden of proof on the owner of that trade mark, who has to prove that he has used the trade

<sup>97</sup> Such a protection is possible under the Madrid Agreement Concerning the International Registration of Marks and the Madrid Protocol

<sup>98</sup> A trade mark registered with EUIPO under Regulation (EU) 2017/1001 on the European Union trade mark.

mark commercially during the relevant period of time within the territory where it is protected and with respect to the goods and services for which it is registered, and that use was not only token. Failing to provide sufficient evidence to prove the genuine use of the mark in the relevant period, he will lose the case, and in the case of a cancellation request due to non-use, he may even lose the mark in question.

### 3. TYPES OF TRADE MARK DISPUTES AND THEIR

**[731]** Most generally, trade mark disputes may be divided into two broad categories:

a/ regarding the registrability and validity of a trade mark as such; and

b/ regarding the infringement of a registered trade mark: unauthorized use of the trademark or infringements of contracts related to trade marks, such as licensing or coexistence agreements, etc.

**[732]** Mediation could be beneficial for the parties in each of the above-mentioned types of conflicts.

#### 3.1. CATEGORY OF DISPUTES

**[733]** Within the first category of disputes fall opposition and cancellation proceedings, both of which aim to prevent protection being given to a sign applied for or registered as a trade mark

##### 3.1.1 OPPOSITION

**[734]** Opposition proceedings can only be initiated during the registration phase, within a period of 3 months from the publication of the objected trade mark application. The result of these proceedings directly affects the outcome of the registration procedure, i.e., whether the sign applied for registration will be registered and given protection as a trade mark or whether the registration will be denied.

**[735]** The grounds for opposition are set out in the provisions of Article 8 of Regulation (EU) 2017/1001, named "Relative grounds for refusal." Unlike the absolute grounds listed in Article 7, the relative grounds are not examined ex officio but only if a written notice of opposition is submitted to the Office by the persons entitled. The right to initiate opposition proceedings is conferred on the proprietors of earlier marks and other rights within the meaning of Article 8 of Regulation (EU) 2017/1001 that could be adversely affected by the registration of the later mark applied for (Art. 46 para. 1 in



conjunction with Article 8 of Regulation (EU) 2017/1001<sup>99</sup>. The purpose of the opposition is to prevent the registration of that later trade mark.

**[736]** Although it may seem that the interests of the conflicting parties in the opposition proceedings (the applicant of the objected trade mark on the one hand and the opponent on the other) are totally different, in fact, both of them may have interests in resolving the conflict in a mutually acceptable way. Many potential options might be not only acceptable but even beneficial for both parties. For instance, as the opposition proceeding delays the registration and, if successful, prevents it at all, the applicant may be willing to limit the list of goods or services for which the registration is sought so that it does not cover goods or services identical to or similar to those protected by the earlier mark of the opponent. The parties could also be satisfied if the applicant agreed to sell the application to the opponent, buy the earlier mark of the opponent, obtain a license to use it, withdraw his own application, etc. Coexistence or license agreements, as well as any kind of compensation, can also be negotiated.

**[737]** A voluntary settlement of the opposition disputes is not only possible but is encouraged by the provision of Art. 47 (4) of Regulation (EU) 2017/1001, according to which: "The Office may, if it thinks fit, invite the parties to make a friendly settlement."

**[738]** In fact, most of the legislation provides for a "cooling-off period" at the beginning of the opposition proceedings, during which period the parties could settle the conflict either by negotiation or by mediation. As regards the EU trade mark, this cooling-off period is two months and may be extended to a total of 24 months if both parties request an extension before the two-month period expires (Art.6 (1) of the Delegated Regulation (EU) 2018/625<sup>100</sup>). It should be noted that the adversarial phase of the opposition proceedings (in which the substantiation of the opposition and the respective counter-arguments against it, the submission of evidence, and the substantive examination of the merits of the opposition take place) does not start before the end of the cooling-off period. It is therefore in the parties' best interest to use this time to try to find a mutually acceptable solution themselves, thereby saving time and avoiding uncertainty as to the outcome of the proceedings.

**[739]** Moreover, there are certain incentives if a settlement is reached at that stage. Art. 6 (5) of the Delegated Regulation (EU) 2018/625 provides for a refund of the opposition fee where, before the expiry of the cooling-off period, the opposition proceedings are closed following a withdrawal or restriction of the application or a withdrawal of the opposition as a result of a settlement agreement.

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<sup>99</sup> Regulation (EU) 2017/1001, "Article 46 Opposition

(1.) Within a period of three months following the publication of an EU trade mark application, notice of opposition to registration of the trade mark may be given on the grounds that it may not be registered under Article 8:

- (a) by the proprietors of earlier trade marks referred to in Article 8(2) as well as licensees authorised by the proprietors of those trade marks, in respect of Article 8(1) and (5);
- (b) by the proprietors of trade marks referred to in Article 8(3);
- (c) by the proprietors of earlier marks or signs referred to in Article 8(4) and by persons authorised under the relevant national law to exercise these rights;
- (d) by the persons authorised under the relevant Union legislation or national law to exercise the rights referred to in Article 8(6)....."

<sup>100</sup> Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430.

**[740]** The applicability of mediation is not limited to the cooling-off period, though. The parties may settle their dispute (including by mediation) at any time until a final decision on the opposition is rendered and in force. However, the opposition fee will not be refunded if the settlement is reached after the commencement of the adversarial phase of the proceedings.

### 3.1.2. CANCELLATION PROCEEDINGS (REVOCATION AND INVALIDATION OF A TRADE MARK)

**[741]** Cancellation proceedings (revocation and declaration of invalidity of a trademark) are a means of attacking a registered trademark. They can only be initiated after the registration of the trade mark under attack and are intended to nullify the protection conferred on that trade mark by revoking or invalidating it. Applications for revocation and a declaration of invalidity may be submitted to the Office (in which case they are the subject of an adversarial administrative procedure before the Office) or may take the form of a counterclaim in infringement proceedings before the courts. The difference between the two forms of cancellation action (revocation and declaration of invalidity) lies in the grounds on which the respective action may be brought and the point at which the mark under attack loses its protection as such.

**[742]** If the mark is revoked, the revocation has effect from the date of the revocation request, while in the case of invalidation, the effect is from the outset as if the mark has never been registered (Art. 62 (1) and 62 (2) of the Regulation (EU) 2017/1001).

**[743]** The grounds for revocation of an EU trade mark are set out in Art. 58 of the Regulation (EU) 2017/1001 and, in summary, cover the situations where the attacked trade mark has not been put in genuine use within a continuous period of five years; where, in consequence of acts or inactivity of the proprietor, the trade mark has become the common name in the trade for a product or service in respect of which it is registered; or where, in consequence of the use made of it, the trade mark has become liable to mislead the public, particularly as to the nature, quality, or geographical origin of those goods or services.

**[744]** The grounds for invalidity are divided into two categories: absolute grounds (Art. 59) and relative grounds (Art. 60 of the Regulation (EU) 2017/1001). Among the absolute grounds for invalidity fall the cases where the attacked trade mark has been registered contrary to the provisions of Art. 7 of the Regulation regarding the absolute grounds for refusal or where the applicant was acting in bad faith when he filed the application for the registration of the trade mark. The relative grounds for invalidity, on the other hand, concern situations where the attacked trade mark is in conflict (within the meaning of Art. 60 in connection to Art. 8 of the Regulation (EU) 2017/1001) with an earlier trade mark or other protected earlier rights (such as rights on the name or portray, designation of origin or geographical indication, copyrights, etc.). Like in the opposition proceedings, the right to initiate invalidation proceedings based on the relative grounds belongs to the proprietors of the respective earlier trade mark or other earlier right.

**[745]** Both opposition and cancellation proceedings involve considerable time and resources. The decisions of the Office in these cases can be appealed before the

Boards of Appeal, whose decisions may be further appealed before the Court of Justice, and it may take years until a final decision on the case is rendered. The proceedings themselves are complicated not only in terms of substantiating and proving the respective requests and defences but also because of procedural and language issues. As there are currently 24 official languages in the European Union, but only six of them are the official languages of the Office, Art. 146 of Regulation (EU) 2017/1001 sets out specific rules for determining the language of the proceedings for each individual case. All the documents and evidence submitted in the proceedings must be in that language or accompanied by a translation into that language. Given the number of pieces of written evidence that need to be submitted in some cases (e.g., to prove the reputation of a trade mark or distinctiveness acquired through use, etc.), and the fact that almost each of the EU Member States where this evidence might originate from has its own language, this might be a serious burden for the parties, especially taking into account that the evidence and their translations to the language of the proceedings must be submitted within a specific time limit to be admissible.

**[746]** The disputes in the opposition and invalidity proceedings based on the relative grounds may be additionally complicated and prolonged if the proprietor of the attacked mark, in turn, contra-attacks the earlier mark on which the opposition or invalidity request is based by requesting its revocation, invalidity, or proofs of its genuine use, or if he objects to the earlier right on which the invalidity request is based. As mentioned in p.2.3. above, such a request (especially requests for proof of use of the earlier mark or for its revocation due to non-use) will place the burden of proof on the owner of that trade mark, and if he fails to provide sufficient evidence, he risks losing the case and sometimes even his earlier mark. That is to say, until the final outcome is reached, not only the attacked trademark but even the earlier mark used as a basis for the opposition or the cancellation request are at risk. This could also affect the reputation of both marks and the businesses of their proprietors as a whole.

**[747]** It should be remembered that even if the opposition, the request for cancellation, or the other action is ultimately rejected as unfounded by the deciding authority, the very existence of the dispute and its publicity may have already caused irreparable damage to the business of the disputants by the time the decision is rendered.

**[748]** Mediation could help the parties avoid these risks and be very beneficial in the resolution of these disputes. Its benefits are acknowledged by Regulation (EU) 2017/1001 itself. According to paragraph 35 of its preamble, "*It is desirable to facilitate friendly, expeditious, and efficient dispute resolution by entrusting the Office with the establishment of a mediation center, the services of which could be used by any person with the aim of achieving a friendly settlement of disputes relating to EU trade marks and Community designs by mutual agreement.*" Such a center is established pursuant to Art. 170 of the Regulation to assist the parties in reaching a friendly settlement in opposition and cancellation disputes pending before the Office. The ADR Service at EUIPO operates under the auspices of the Boards of Appeal and includes mediation, conciliation, assisted negotiation, and expert determination, which may be used in combination with one another or separately<sup>101</sup>.

101 EUIPO, ADR service, <https://euipo.europa.eu/>, online: <https://euipo.europa.eu/ohimportal/en/web/guest/adr-service>.

## 3.2 INFRINGEMENTS

**[749]** The second big category of trade mark disputes concerns infringements either of the exclusive rights over a registered trade mark (e.g. unauthorized use of the trade mark or a sign similar to it) or of contracts related to trade marks, e.g., licensing or coexistence agreements, etc. These types of conflicts, if not settled amicably, are resolved in court.

### 3.2.1 TRADE MARK INFRINGEMENT

**[750]** The court proceedings in trade mark infringement cases are even more complex, lengthy, and costly than the administrative proceedings in oppositions and cancellations.

**[751]** Apart from the complexity of the subject matter of the dispute itself, there are also jurisdictional, evidentiary, language, and legal issues to be taken into account in the infringement cases.

**[752]** These cases often require actions in different jurisdictions under different applicable laws. For instance, according to the provisions of Chapter X of Regulation (EU) 2017/1001, all actions for infringement of an EU trade mark shall be brought to the competent national trade mark courts of the Member States. The competent national court to hear each individual case is determined in conformity with the rules set out in Art. 125 of the Regulation. Where the jurisdiction of the competent court is based on the criteria provided for in Art. 125 (1), (2), (3), or (4) of the Regulation (EU) 2017/1001 (i.e., agreed by the parties or, in the absence of such agreement - defendant's or plaintiff's domicile or seat, or the seat of EUIPO in the respective Member State where the court is situated), this court will have jurisdiction in respect of acts of infringement committed or threatened within the territory of any of the Member States (Art.126 (1) of the Regulation). It is also possible for the jurisdiction of the court to be based on the place where the infringement has been committed (Art. 125 (5) of the Regulation). However, in the latest case, that court shall have jurisdiction only in respect of acts committed or threatened within the territory of the Member State where the court is situated (Art.126, para 1 of the Regulation). This means that, where the court's jurisdiction is based on the place of infringement, in the event of acts of infringement committed in several Member States, the trade mark owner has to initiate parallel court proceedings in each State where an act of infringement has been committed and to bear the respective costs for each proceeding. On the other hand, the plaintiff could use this alternative jurisdiction in his favour by choosing between the court competent under Art. 125, paragraphs 1-4, and the court competent under Art. 125, para. 5 the one with whose national law and practice he is more familiar and considers more favourable. Although not a very common scenario, in some cases he might even use it as a means of pressure on the defendant by choosing to initiate multiple court proceedings in different countries based on the jurisdiction under Art. 125 (5), thus forcing the defendant to organize his defence in each of these proceedings.

**[753]** The applicable procedural and, to some extent, substantive law in these cases is determined by the place of the court. The competent court shall apply the provisions of Regulation (EU) 2017/1001 and, on all trade mark matters not covered by the Regulation, the applicable national law of the respective court. With respect to the

procedure, the court shall apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State in which the court is located (Art. 129 of the Regulation (EU) 2017/1001). That means that all the procedural matters, including the procedural preclusions, the admissibility of certain actions or types of evidence, etc., are governed by the national law of the court hearing the case, and the language of the proceedings will also be the national language of that court. Therefore, these disputes require not only knowledge of the Regulation but also of the applicable national substantive and procedural law of the state in which the competent court is located. This makes it necessary for a local litigator experienced in this law and native to the language of the proceedings to be engaged in the case. It becomes even more complicated when parallel proceedings in different member states have been initiated.

**[754]** In most jurisdictions, the proceedings will take place in three court instances which entails the payment of the relevant state fees and lawyers' fees for each instance. Typically, apart from the written and other evidence, to prove the relevant facts in the case, it is also necessary for a number of experts to be appointed to give the court their expert opinions on various issues relevant to the case, which additionally increases the costs of the proceedings.

**[755]** Another challenge is proving the claims, which in these cases is usually difficult. The plaintiff must prove not only that the acts alleged to be infringing existed and were committed by the defendant but also that they really constitute an infringement of his rights as a trade mark owner (i.e., to prove the identity or similarity between the sign used by the defendant and the plaintiff's trade mark, the identity or similarity of the goods for which that sign has been used to those for which the mark is used, the likelihood of confusion on the part of the public (in the case of similarity), etc., depending on the case). The burden of proof as regards the damage caused by the infringement and its estimation (when a claim for compensation is raised) also lies on the plaintiff. While the commitment of the respective acts of the defendant can, in most cases, be comparatively easily proven by objective evidence (e.g., documents), it is more challenging to establish their infringing nature, especially where the respective signs and goods are not identical but similar, as it is also necessary in these cases for the likelihood of confusion to be proven. However, the assessment of whether the similarity of the signs and the goods in question leads to a likelihood of confusion in the eyes of the consumer depends on many additional factors and, to some extent, is subjective.

**[756]** The subject matter of the case may be further complicated if the defendant brings counterclaims for revocation or for a declaration of invalidity of the relevant trade mark, the infringement of which is claimed by the plaintiff.

**[757]** In any case, the final outcome of the case cannot be predicted with certainty. Until the final court decision, there is a potential risk for each of the parties of losing the case and, as a result, bearing all the costs of the proceedings, including those of the other party.

### 3.2.2 DISPUTES ARISING FROM INFRINGEMENTS OF CONTRACTS RELATED TO TRADE MARKS, SUCH AS LICENSING OR COEXISTENCE AGREEMENTS

**[758]** The disputes in this category may arise either in connection with the parties' non-fulfillment of contractual obligations or by going beyond contractual limitations. Disputes are also possible in connection with the occurrence of hypotheses that are not explicitly regulated in the relevant contract between the parties or in connection with the termination of such a contract and the consequences therefrom.

**[759]** Whatever the reason for the dispute may be, its resolution in court proceedings involves the respective costs, time, and risks, commented on above, including the risk of possible reputational damage due to the publicity surrounding the dispute.

**[760]** On the other hand, what is specific to these disputes is that they are usually preceded by a long-standing relationship between the parties, each party has benefited from the agreement and, in most cases, has an interest in keeping it in force (this is particularly relevant for licensing agreements). The parties also need to preserve their reputation, as it is important to their business and to their relationships with other existing or potential partners and customers. All of these features make mediation particularly suitable for these disputes, as it meets the need for confidentiality while significantly increasing the chances of a satisfactory resolution of the situation in a way that does not damage the relationship between the parties.

## 4 BENEFITS FROM MEDIATION IN TRADE MARK DISPUTES

**[761]** It might be summarized that, due to their specific subject matter, all trade mark disputes are specialized, complex, and require specific knowledge. Their resolution in the respective adversarial administrative or court proceedings discussed above takes years, consumes considerable resources, and often requires actions in different jurisdictions under different applicable laws. The disputes, furthermore, put the contested trade mark and, in some cases, even the earlier trade mark on which the opposition, cancellation, or infringement claim is based at risk and harm the reputation and business of the disputants and the products and services for which the contested and opposing marks are used. There is also a risk that sensitive information could be revealed in these proceedings and become public, which, in some cases, may cause the party it concerns irreparable damages, regardless of the outcome of the proceedings.

**[762]** The uncertainty that the dispute brings is another disadvantage of these proceedings. Even where the party initiating the relevant proceedings considers that it has a strong case, the final outcome cannot be predicted, as it also depends on the defensive arguments of the respondent and, above all, on the relevant evidence presented by the parties. It is also worth mentioning that by the time the final decision on the case is rendered, the publicity surrounding the conflict may already have caused damage to the parties.

**[763]** Last but not least, the remedies available in these proceedings are limited. The discretionary powers of the adjudicating authority are limited by the requests brought to it and the relevant rules of law governing the respective type of action. The parties' needs, business interests, and any other circumstances outside the purely legal dispute at hand are irrelevant in these proceedings and cannot be taken into account.

**[764]** Mediation, in contrast, allows the parties to avoid the uncertainty associated with the existence of the dispute and prevent the potential reputational and other damages caused by it while at the same time retaining control over the outcome of the dispute. It is a confidential and flexible procedure where the parties, assisted by the neutral mediator, discuss their arguments, needs, and interests in an attempt to find a mutually acceptable solution to the dispute and make the decisions themselves.

**[765]** Compared to adversarial administrative or court proceedings, mediation offers significant advantages and allows parties to trade mark disputes to resolve their disputes expeditiously and discreetly. The benefits of mediation include:

1. Confidentiality: The mediator and all the participants in the mediation procedure are bound by the obligation to keep confidential any and all information that has come to their knowledge during the mediation procedure. The confidentiality of the procedure prevents the publicity of the dispute, the disclosure of sensitive information, and the potential damage to the reputations of the parties and/or the conflicting trade marks due to such disclosure.

2. The costs and time spent in mediation proceedings are significantly lower than in the respective administrative or court proceedings. In most cases, the procedure is completed within several sessions or even faster. The parties themselves may set a deadline after which, if no agreement is reached on the dispute, they may terminate the procedure and seek another means of resolution (e.g., arbitration or court). An example of such an arrangement is the recommended clauses of the WIPO Mediation and Arbitration Centre, in particular the so-called "multi-tier dispute resolution clauses," where the parties agree to refer their dispute to mediation, and if no agreement is reached within a time limit set by them, the dispute to be referred to another alternative means chosen by the parties (e.g., arbitration) or to the respective administrative authority or court.

3. Flexibility: The parties have the freedom to choose a mediator or mediators with appropriate qualifications<sup>102</sup> for the procedure. The place and time for the mediation sessions are also subject to agreement between the parties and the mediator. Mediation could even be conducted online, which significantly reduces costs, especially for cross-border mediations, and eliminates the need for travelling to the place of mediation.

4. Another big advantage of mediation is that it allows for the consolidation and joint resolution in one mediation procedure of several disputes that otherwise

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<sup>102</sup> In my opinion, the specific subject matter of the trade mark disputes requires the specialization of the mediator in the subject matter of the conflict. This is not only crucial for building trust but also helps the mediator better understand the dispute and be efficient in the mediation procedure. It is a requirement of Art. 170 (11) of the Regulation (EU) 2017/1001 that the mediators at EUIPO mediation center "shall be independent and possess relevant skills and experience."

would require separate actions in different jurisdictions. This is especially beneficial for trade mark disputes.

5. The parties retain control over the outcome. Unlike in court and administrative proceedings, where the decision on the case is imposed on the parties by the respective adjudicating authority, in mediation, the parties determine the outcome themselves and may tailor it to meet their specific needs and business interests. They can discuss various resolution options, including agreeing on matters that are not strictly part of the dispute at hand but are important to the parties to be resolved and included in the settlement agreement (e.g., future collaboration or resolution of another conflict pending between the parties, etc.).

6. Improved understanding of the conflict and better communication. The mediator facilitates the discussion, helping the parties to go beyond the immediate emotional response to the dispute reflected in their stated positions and, instead, look at their underlying concerns, interests, and long-term aims affected by the dispute (collectively referred to as "interests"), prioritize them, and generate dispute resolution options that address the interests of both parties, thus increasing the chances of a mutually beneficial decision being found. Even when the mediation has not led to a settlement, it helps the parties improve their communication and stay open for further negotiation.

7. The parties are not prevented from resorting to court or using other dispute resolution methods in case they have failed to settle in mediation.

8. Last but not least, settlement agreements resulting from mediation can be made enforceable due to legal instruments such as EU Directive 2008/52 on certain aspects of mediation in civil and commercial matters and the Singapore Convention on Mediation<sup>103</sup>. These acts allow the parties to cross border disputes to ask for enforcement of their settlement agreement in each of the countries bound by the respective instrument. The EU Directive 2008/52 sets an obligation on the EU Member States to "ensure that it is possible for the parties to request that the content of a written agreement resulting from mediation be made enforceable<sup>104</sup>", while the procedure by which this result is to be achieved is left to the discretion of each Member State and is regulated in their national legislation. The Singapore Convention on Mediation, in turn, as an international agreement, is binding on its signatories. It aims to provide a mechanism for the enforceability of settlement agreements resulting from mediation in commercial disputes in each of the States parties to the Convention and in a simplified procedure.

**[766]** Being commercial disputes in nature, trade mark disputes are in principle eligible to benefit from each of these instruments. This is a big advantage for the parties to such disputes, as it not only allows them to enforce their settlement agreement resulting from mediation when it has not been voluntarily executed but also extends the territories where enforcement can be obtained.

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<sup>103</sup> United Nations Convention on International Settlement Agreements Resulting from Mediation (the "Singapore Convention on Mediation").

<sup>104</sup> Directive 2008/52/EC of the European Parliament and of the Council of 21 May 2008 on certain aspects of mediation in civil and commercial matters, Art. 6.



## 5 EXAMPLES OF SETTLED TRADE MARK DISPUTES

[767] The following examples illustrate that an amicable settlement is possible in any kind of trade mark dispute and how beneficial mediation could be<sup>105</sup>.

### 5.1 A WIPO TRADE MARK MEDIATION IN THE AREA OF CONSTRUCTION (OPPOSITION)

[768] A Singaporean construction company filed oppositions against applications for the registration of three trade marks with the Intellectual Property Office of Singapore, alleging their similarity with key components of its trade mark. The trade marks in question were applied for by three commercially connected entities based in Singapore, Malaysia, and Indonesia. In addition, parties had other long-pending cross-border commercial and IP disputes.

[769] The parties agreed to submit all trade mark oppositions to WIPO mediation in Singapore, consolidated into a single mediation, and wished to resolve all the outstanding proceedings on a global basis.

[770] The WIPO Center proposed a Singaporean intellectual property lawyer as a mediator. After a one-day mediation session, the parties settled the trade mark disputes as well as their additional commercial disputes four months after the commencement of the mediation.

### 5.2 RINGO STARR VERSUS PACIFIC HOLDINGS AND MOMENTUM MANAGEMENT (OPPOSITION)

[771] A curious trade mark dispute is the one between the ex-Beetle – Sir Ringo Starr and the sex toy companies Pacific Coast Holdings IP, LLC (the Applicant) and Momentum Management.

[772] The Applicant had applied before the US Patent Office for registration of the trade mark "Ring O" for adult sexual aids, namely rubber rings, vibration rubber rings, and condoms. Sir Ringo filed an opposition against it, claiming that the sign "Ring O" is confusingly similar to his own name (which he had already registered as a trade mark) and that this might cause confusion, making it likely that consumers will associate the contested sign with the name of Sir Ringo and believe that his latest venture is sex toys. He claimed, further, that his reputation would be damaged if the "Ring O" name was registered as a trade mark with US authorities.

[773] The dispute was settled in 2021 with a coexistence agreement concluded between the parties, and the opposition was withdrawn<sup>106</sup>. Pacific Coast Holdings and Momentum Management agreed to put a space between the "Ring" and the "O" and only use the sign for adult sex aids and desensitizing sprays, as well as to "avoid any activity likely to lead to confusion" between their product and the musician; to not "degrade, tarnish, deprecate, or disparage" his name or image; and to not make any

<sup>105</sup> The information in this section is based on the information provided in the respective source indicated for each individual example.

<sup>106</sup> There is no information on whether mediation is used or whether a settlement is reached through negotiation between the parties.

reference or innuendo associating the product with Starr or give the impression that he's associated with it.

### 5.3. A WIPO ONLINE TRADEMARK MEDIATION IN THE AREA OF CONSUMER GOODS (CANCELTION PROCEEDINGS)

[774] In the context of a number of invalidation proceedings before the Intellectual Property Office of Singapore, the parties, a Malaysian company and a Singaporean company, submitted their dispute to WIPO Mediation.

[775] The mediation was conducted online. After a one-day mediation session, the parties were able to settle their dispute and signed a settlement agreement within just three weeks of submitting the dispute to WIPO Mediation.

[776] According to the summary of the case published by the Intellectual Property Office of Singapore (Rakshit, U., Mediation at IPOS, p.29), prior to the mediation, the mediator held separate preparatory sessions with each party. It is also reported that there were certain challenges associated with the mediation process: first, the possibility of online fatigue from an all-day online engagement; and second, a language barrier, as the mediation was held in English but the parties were more comfortable speaking in Mandarin. The mediator addressed the first issue by conducting the mediation mainly via multiple private sessions with each party, thus letting them take turns to come online, and the language barrier was overcome with the translation support from the parties' counsel.

[777] In this case, the parties benefited from funding under IPOS EMPS to subsidize their lawyers' fees and expenses.

### 5.4 APPLE CORP. V/S APPLE COMPUTER (INFRINGEMENT)

[778] Probably the most famous and long-lasting trade mark dispute is the one between Apple Corp., the Beatles record company founded in 1969, and Apple Computer, founded by Steve Jobs in 1976<sup>107</sup>.

[779] In 1978, Apple Corp. filed a lawsuit against Apple Computer for trademark infringement, which was settled in 1981. Both parties agreed not to enter the other party's business, i.e., to not use the mark in connection with goods or services that fall within the other party's business.

[780] In 1986, when Apple Computer created MIDI (the Musical Instrument Digital Interface), which allowed computers to interact with musical instruments, Apple Corp. sued again, claiming a violation of the 1981 settlement agreement.

[781] Another settlement agreement was reached in 1991, involving the payment of around 26.5 million USD as compensation to Apple Corp. The settlement detailed the areas in which each company is allowed to use "Apple." Apple Corp. held the rights to

<sup>107</sup> There is no information whether the settlements in this case—or some of them—were reached in mediation. The case was chosen as an example as it clearly illustrates how complicated and long-lasting a trade mark dispute can be.

use Apple on "creative works whose principal content is music," while Apple Computer was allowed to use Apple "on goods or services... used to reproduce, run, play, or otherwise deliver such content," but not "in connection with physical media delivering pre-recorded content... (such as a compact disc of the Rolling Stones music)<sup>108</sup>."

**[782]** However, this was not the end. When Apple Computers created iTunes Music Store in 2003, Apple Corps sued them again, claiming that the use of the Apple logo for iTunes Music Store constituted a breach of the 1991 settlement agreement. The first instance decision was pronounced in 2006 and was in favour of the computer company. Mr. Justice Mann ruled iTunes was "a form of electronic shop" and not involved in creating music. He further concluded that "the use of the Apple logo in the notional LCD display does not suggest a relevant connection with the creative work. However, even if it did then clause 4.3<sup>109</sup> would operate to permit it", and therefore "the use of the apple logo is a fair and reasonable use of the mark in connection with the service, which does not go further and (unfairly or unreasonably) suggest an additional association with the creative works themselves." ([2006] EWHC 996 (Ch), § 91-93)<sup>110</sup>. Apple Corp. was ordered to pay Apple Computer's legal costs at an estimated amount of 2 million British pounds. The decision was appealed by Apple Corp<sup>111</sup>.

**[783]** The battle finally ended in 2007 when a new settlement agreement was reached. The parties have settled that Apple Computers (by the time of the settlement, the name of the company had changed to Apple Inc.) will own all the trade marks related to "Apple" and will license certain of them back to Apple Corp. The settlement agreement was confidential, but according to the rumours, it cost Apple Computers around 500 million USD in total to buy Apple Corp.'s trade marks.

**[784]** According to the press release dated February 5, 2007<sup>112</sup>, "commenting on the settlement, Apple Inc. CEO Steve Jobs said, "We love the Beatles, and it has been painful being at odds with them over these trade marks. It feels great to resolve this in a positive manner and in a way that should remove the potential for further disagreements in the future."

**[785]** Commenting on the settlement, Neil Aspinall, manager of Apple Corps, said, "It is great to put this dispute behind us and move on. The years ahead are going to be very exciting times for us. We wish Apple Inc. every success and look forward to many years of peaceful cooperation with them."

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108 MR. JUSTICE MANN, England and Wales High Court (Chancery Division), [2006] EWHC 996 (Ch), Case No: HC03C02428, 08/05/2006, § 6 online: <https://www.bailii.org/ew/cases/EWHC/Ch/2006/996.html>;

109 A clause from the Trade Mark Agreement, dated 9<sup>th</sup> October 1991 concluded between the parties.

110 MR JUSTICE MANN, England and Wales High Court (Chancery Division), [2006] EWHC 996 (Ch), § 91-93, online: <https://www.bailii.org/ew/cases/EWHC/Ch/2006/996.html>

111 BBC News, "Beatles lose Apple Court battle", 2006, <http://news.bbc.co.uk/2/hi/entertainment/4983796.stm>

112 Kerris, N., Bellas, M, Freund, E, "Apple Inc. and The Beatles' Apple Corps Ltd. Enter into New Agreement", Press release, February 5, 2007 <https://www.apple.com/newsroom/2007/02/05Apple-Inc-and-The-Beatles-Apple-Corps-Ltd-Enter-into-New-Agreement/>.

## 6 CONCLUSION

[786] The conclusions that can be drawn from these examples, especially the last one, are that trade mark disputes are complex, may last many years, involve significant costs, and negatively affect the business interests of the parties. On the other hand, the examples also prove that any type of trade mark dispute can be resolved through negotiation and mediation, and a settlement is always possible.

[787] Mediation gives the parties to trade mark disputes important advantages in comparison to adversarial court or administrative proceedings and, if used as a means of resolution of these disputes, significantly increases the chances of an amicable settlement being found, even for long-lasting and complicated disputes. It also significantly reduces the costs and time for the resolution of the dispute and allows the parties to resolve multiple disputes in a single mediation procedure. Among the other benefits of mediation are the confidentiality and flexibility of the procedure, the fact that the parties entirely control the outcome of the dispute and may tailor it to meet their specific needs and business interests, as well as avoid the potential reputational and other damage that may arise as a result of the dispute. In addition, legal instruments such as EU Directive 2008/52 and the Singapore Convention on Mediation guarantee the enforceability of settlement agreements resulting from mediation by providing mechanisms for their enforcement in any of the states bound by the respective instrument.

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