



**Office for Harmonization
in the Internal Market**
(Trade Marks and Designs)

Dispute resolution at OHIM

Moscow 24 September 2015

Philipp von Kapff
Member of OHIM's Boards of Appeal



Case

CTM applied for



30 – chocolate

Spanish: “corona” = crown

**Earlier TM in Estonia,
Latvia, and Lithuania**

KARUNA

30 – chocolate

Russian: “корона” = crown

**Is there a likelihood of confusion? Enhanced protection of a
reputed trade mark?**



Overview

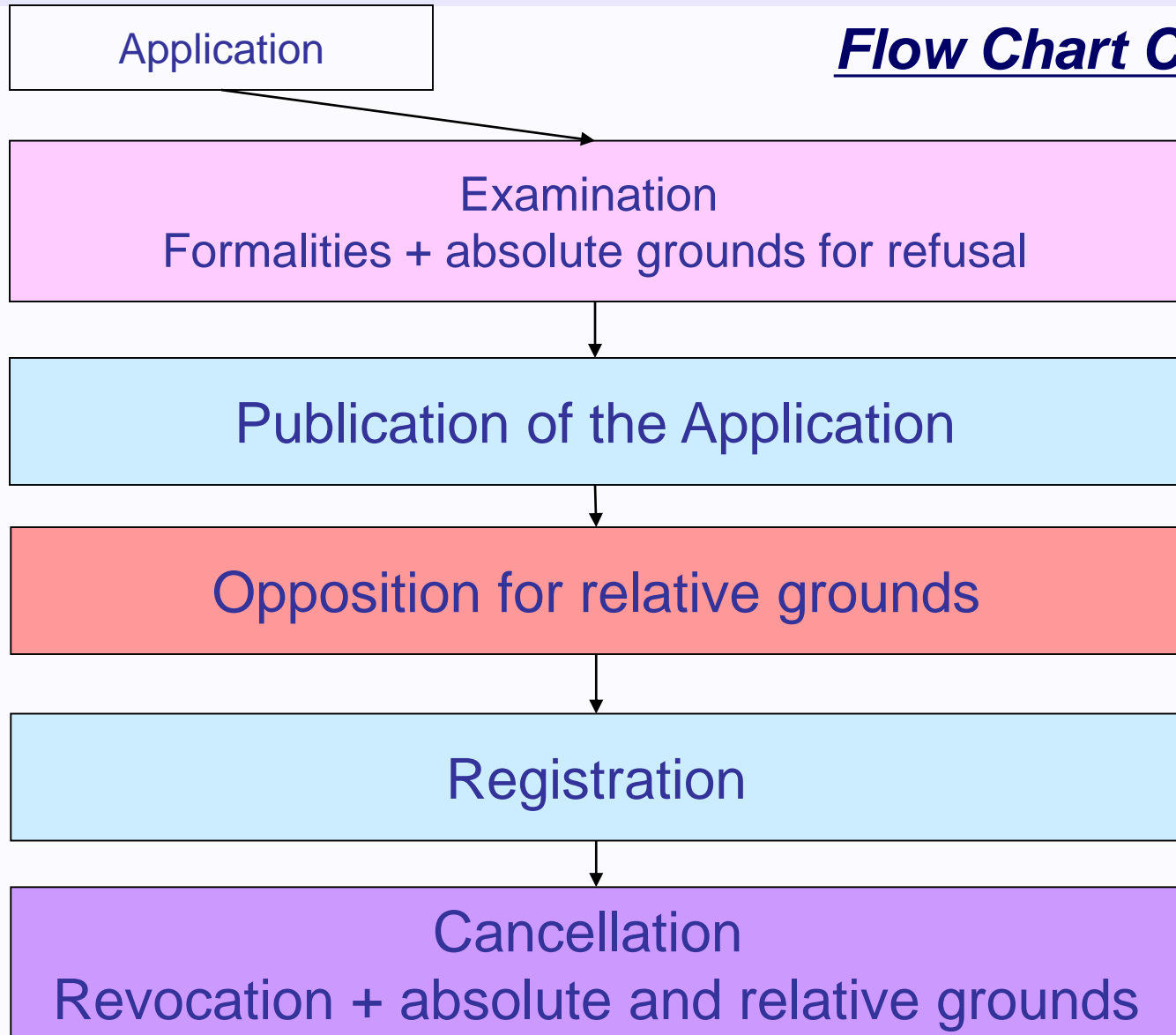
1. Nature of disputes involving earlier trade marks
2. Administrative and judicial review
3. Dispute resolution at the level of the BoA
4. Conciliation/Mediation



- Disputes
 - “Absolute grounds” protect **public** interests
 - “Relative grounds” protect **private** interests of right holders of earlier signs
- Earlier rights may be
 - CTM or national trade mark
 - National other signs used in the course of trade
 - Invalidity: copyright, design, plant variety, etc.
- No *ex officio* examination of earlier rights



Flow Chart CTM





Case

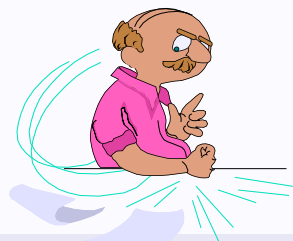
CTM applied for



30 – chocolate

CTM application rejected

Appeal filed



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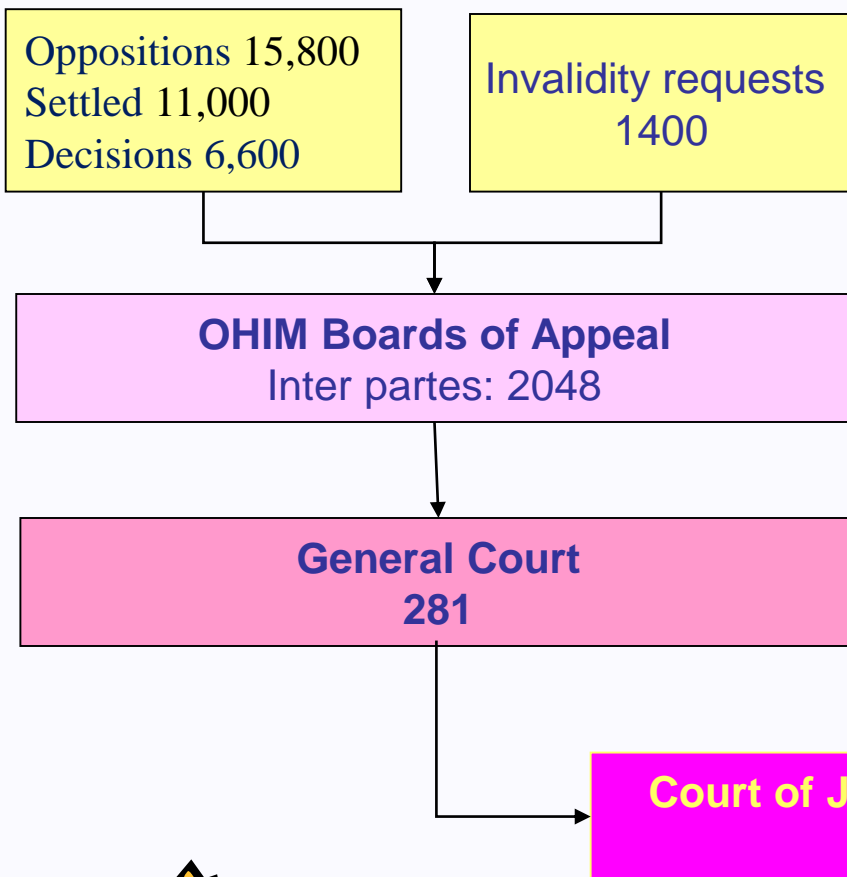
30 – chocolate

Opposition successful

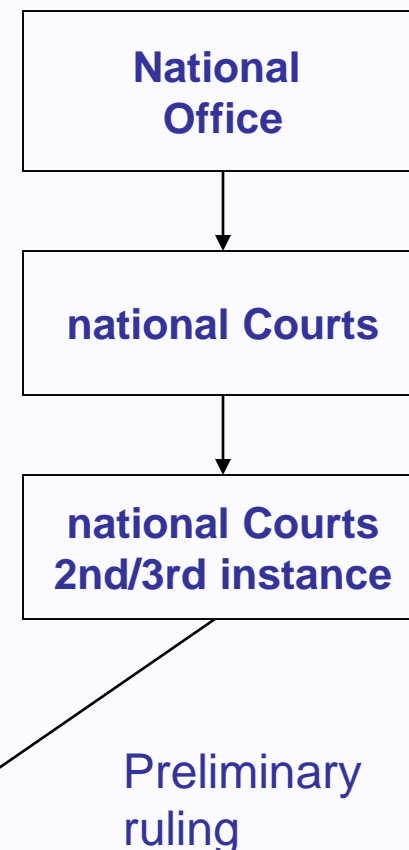


Institutional framework Inter-Partes

OHIM



National Registration





1. Decisions by 1 Member
2. Decisions by 3 Members
3. Decisions by Grand Board (9 Members)
4. Conciliation
5. Mediation



1. Decisions by 1 Member
 - procedural cases: withdrawals, inadmissibility
 - absolute grounds + (Rapporteur responsibility)
2. Decisions by 3 Members
 - Big majority of cases
 - Inter-partes cases substance
3. Decisions by Grand Board (9 Members)
 - Very few, harmonization of case law
4. Conciliation
 - Rapporteur proposes and eventually helps to settle
5. Mediation
 - Independent mediator helps to settle



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BoA (R696/2009-4):

OD decision annulled,
opposition rejected

GC (T-357/10)

Appeal rejected



Direct negotiations between parties

Lawyers negotiations

Mediation with help of neutral person

Conciliation with some help of (neutral) Rapporteur

Conciliation with help of respected person

Arbitration

Judgment



- Coexistence is possible
- Quick and dirty solution
- No solution of real conflict possible in present proceedings
- Loss/Loss situation
- Economic cooperation
- Emotions

“Effective Dispute Resolution”

Obtain a “win/win” solution through conciliation / mediation



The main characteristics of mediation are:

- The interest-based not rights-based procedure
- The voluntary participation of the parties
- The flexibility of the proceedings
- The autonomy and attendance of all parties.
- Confidentiality
- The neutrality and impartiality of the mediator



IP Offices:

- WIPO
- UK
- OHIM
- Bundespatentgericht (Germany)

Private Mediators

- INTA
- Ciarb, etc.
- EU Directive Harmonizing Mediation

Lawyers: normal business to settle conflicts



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Thank you for your attention!

www.oami.europa.eu

Feedback: Philipp.vonkapff@oami.europa.eu

WWW.OAMI.EUROPA.EU