**RPM ("Trade-mark Practitioners Group")**
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**Questions:**

**What kinds of tm disputes are best suited to mediation?**

- Parties have long-standing marks which have come into conflict (changing products and services, business channels, etc.)
    - E.g. Apple Computers and Apple Records
- Parties have existing or potential business relationship
    - E.g. new products, services; new territories; licensing opportunities

**The least suited?**

- Counterfeits, knock-offs
    - Some infringers cannot be trusted to live up to a negotiated settlement.
    - Need to teach the infringers a lesson, get products off the market.

**What are the specific benefits of mediation in the area of tm disputes?**

- Potential for global resolution of dispute.
    - E.g. I was mediator under Ontario mandatory mediation in a case brought in Ontario court (claim was "passing off")
    - At the same time, the parties also had pending applications for similar marks; one was being opposed and the other would have been, if it proceeded.
    - We were able to resolve all of these claims and counterclaims with one agreement.
- Potential for an agreement that enhances the value of the mark.
    - E.g. keep others off the market
      (can't do that if you have to argue the mark is generic in order to defend against infringement claim).

**What are the kinds of solutions which can be achieved in mediation which are unlikely to occur outside this process?**

- Litigation remedies are limited to injunction or damages.
- "All or nothing" situation.
- Mediated settlement can include:
    - License and ongoing royalties
    - Co-existence agreement, to stop confusing products/services, but permit others
    - Voluntary amendments to trademark registrations, to keep register clean and make it harder for 3rd parties to come in

**Is it likely or feasible for measures to be put in place which encourage mediation in tm disputes? If yes, what kind of measures and with respect to which occasions or legal procedures?**

- Feasible – Yes.
- Likely – No. (or not now…)
- Trademark Opposition Board support mediation in principle, but has declined to take any steps to actively require or encourage mediation.
- Federal Court makes mediation available to parties, but does not require it.
    - Unlike the Ontario court, which has mandatory mediation in Toronto and Ottawa.
    - Not sure what the situation is in Quebec courts.

**Should the mediator have a specific expertise in trade-marks in addition to his training as a mediator?**

- Yes.
- Background knowledge and ability to grasp the factual and legal issues in dispute will enable the mediator to effectively get to the heart of the matter.
- Parties and counsel do not want to waste time educating the neutral on the basics of trademark law.
- Knowledge and experience of similar situations can assist in crafting a "win-win" solution that may not be apparent to someone who lacks IP expertise.
- Someone who has done trademark licensing work can help parties work out fair and reasonable license terms.

**What kinds of objections to mediation arise in tm matters?**

- Clients are outside Canada; agreement here would jeopardize position in other countries.
    - But maybe mediation here could be used as a step toward global settlement
- The other side is being unreasonable.
    - Notice it's always the <u>other</u> side!
- It's too soon; the parties aren't ready to settle.
- The parties are too far apart
    - But if you delay they spend more money and are even further apart.
- We don't have enough information
    - Consider exchange of information in mediation <u>before</u> going to full discovery.
- Proposing (or agreeing to) mediation makes my client look week.
    - I believe the opposite is true.
    - The stronger your position is, the more mediation is likely to benefit your client, because they have the negotiating leverage.
    - The challenge in any mediation is convincing the other side it's in their best interest to settle and these are the best terms they will get.