

New Opportunities for Mediation in Trademark Proceedings

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With effect from 03 January 2012, all trademark opposition, invalidation and revocation proceedings will allow for an informal voluntary mediation option to parties concerned. The Intellectual Property Office of Singapore (IPOS) will hold a Case Management Conference (CMC) to discuss with both parties, i.e. the Applicant and the Opponent, the possibility of mediation between them. The proceeding is said to be informal in the sense that both parties have the option to terminate the mediation proceedings at any time, if they feel that the same is not serving its purpose or they need to terminate the same to help contain their costs.

First CMC

A month after the parties have submitted their pleadings, i.e. Notice of Opposition and the Counter-Statement, IPOS will issue a notification directing both parties and/ or their representative/s to attend the first CMC.

What happens in the First CMC

During the first CMC, the presiding Registrar will encourage both parties to avail of the voluntary mediation. The parties will be provided a month from the date of the first CMC to relay their decision on whether to bring the relevant matter at hand for mediation. If both parties come to an agreement to bring the matter for mediation, a Notification to the Registrar to be jointly completed by the said parties should be submitted before the IPOS by the initiating party and/ or opponent.

Where Mediation Proceedings is held and what happens to the IPOS Proceedings once the parties opt for mediation

A mediation proceeding will be conducted at the WIPO Center Office in Singapore. Once the parties avail of this voluntary mediation before the WIPO Center Office in Singapore, the on-going proceedings at IPOS, i.e. submission of the Statutory Declaration (evidences) is suspended from the date of the filing of the counter-statement and will only convene at the second CMC, wherein IPOS will issue the timelines for the filing of evidences.

Relevant Fees

WIPO CENTER'S ADMINISTRATION FEE	MEDIATOR'S FEES	
SGD 500	SGD 300-SGD 600 PER HOUR	Up to a maximum fee of SGD 1,500 per day

When a second CMC is issued

IPOS will call for a second CMC if and when the following circumstances occur:-

1. Parties have attempted mediation at the WIPO Center Office of Singapore but did not fully settle their dispute; or
2. Parties do not submit to mediation at the WIPO Center Office of Singapore.

During the second CMC, the parties will have to provide the IPOS information whether the parties are still negotiating. It is also at this time that IPOS will issue the timelines for the filing of evidence by both parties and the suspension for the timelines will be lifted.

What happens after the second CMC

After the second CMC, further proceedings will remain as before the introduction of the new mediation proceedings. As per prior practice, parties will have to file their evidences, followed by a Pre-Hearing Review. If the parties are still not able to negotiate, the matter will be set for Hearing.

Voluntary Mediation at any time

There is no time limit for bringing the matter to mediation. As such, parties may bring the matter for mediation at any time.

Source: Intellectual Property Office of Singapore (IPOS)

For more information, please contact:

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