



ABSTRACT

WHY YOU SHOULD MEDIATE YOUR NEXT TRADEMARK DISPUTE

William Towns and Katherine Basile, Novak Druce Connolly Bove + Quigg LLP

Trademark disputes, like other IP disputes, can be legally and factually complex. The legal costs attendant to litigating a trademark dispute consequently can be significant, and even more so in jurisdictions providing for extended discovery prior to trial. Further, the legal and factual complexity of trademark disputes often give rise to considerable uncertainty as to the outcome, particularly in situations where such a dispute is submitted for binding resolution on the merits to a decision-maker with little or no background in trademark or other IP law.

Using mediation in a trademark dispute offers a distinct advantage for the parties. Mediators do not sit in judgment of the merits of the dispute – that is, mediators are not acting as judges or arbitrators. Instead, the role of the mediator is to assist the parties in resolving their dispute by agreement. Thus mediation empowers the parties to fully explore solutions that best address the needs of their situation. The parties then can achieve a satisfactory resolution of their dispute, avoiding the uncertain outcome of litigation and at a fraction of the cost of litigation.

SELECTING THE RIGHT MEDIATOR FOR YOUR CASE

What mediation style best meets the needs of your case?

It is important to keep in mind that there are different styles of mediators. Generally, mediators tend to be grouped into one of three different practice styles: (1) facilitative, (2) evaluative, or (3) transformative. Once mediation has been agreed upon, the parties in selecting a mediator should consider which mediation style likely will be best suited for the needs of parties and the situation to be resolved.

Facilitative. A facilitative mediator may be preferable in situations where the parties are having communication difficulties or have underlying issues that need to be addressed in order to move forward. These situations are not uncommon. A facilitative mediator can help the parties develop options and encourage “outside the box” thinking.

Evaluative. An evaluative mediator may be preferable in situations where the parties would prefer that the mediator to take a more active role in resolving the dispute, such as commenting on factual and legal issues, offering non-binding opinions and guiding the parties in reaching a settlement based on objective norms.

Transformative. A transformative mediator may be preferable in situations where the parties have relational issues (business or personal) and their long-term goal is to improve communications to enable the parties to work better together, even if a resolution of the specific dispute is not resolved.

The facilitative style is considered the norm in mediation, but keep in mind that in actual practice mediators often combine these styles in according with a given situation, with the ultimate goal of assisting the parties in exploring options and reaching agreement.



As noted above, the facilitative, evaluative and transformative styles are quite different in approach, so identifying the mediation style you believe on balance will be better suited for your case is an important consideration in the selection of a mediator.

Do you need a mediator with subject matter expertise?

If the factual and legal issues in your case are particularly complex or contentious, a mediator with subject matter expertise may be well suited to assist the parties in working through such obstacles. Or you may prefer a mediator who will focus more on identifying underlying issues and assisting the parties in communicating more effectively, allowing the parties' counsel to essentially function as subject matter "experts" for the mediator's benefit.

PREPARING FOR YOUR MEDIATION: UNDERSTANDING YOUR DISPUTE

Determine your interests and those of the other party

The mediation process empowers the parties to move beyond positional bargaining and engage in interest-based negotiations. Doing so successfully requires that you identify your core interests and needs as they relate to the dispute. You should also consider what the other party's interests and needs may be.

Determine your goals in the mediation

Determine your goals in the mediation and what you hope to accomplish. Conduct a risk analysis of your case by looking at the strengths of your case and the strengths of the other party's case. Determine your BATNA (best alternative to a negotiated agreement) and WATNA (worst alternative to a negotiated agreement). Then determine the other party's BATNA and WATNA, as best you can.

Understanding the other party's goals

The better your understanding of the other party, the greater your flexibility and creativity when generating options. Once you are in the mediation, listen carefully what to the other party is saying to better determine their interests and needs and what they really are seeking to accomplish in the mediation.

AT THE MEDIATION

State your case reasonably and use creativity in developing the best "evidence" to explain your case to the mediator

Mediation is likely to be more successful, and you are more likely to assist a mediator in facilitating resolution, if you are reasonable in stating your case. Be an advocate, but be reasonable. Visuals and actual product can be highly effective in helping a mediator understand the underlying issues and facts in a case. Don't hesitate to recreate the "marketplace" if possible.

Engage in interest-based negotiation

A mediation essentially is a structured negotiation. To achieve a good outcome in the mediation, engage in interest-based negotiations to seek a workable solution to a shared problem. And be patient. Remember, the key to most mediations is establishing effective communication and building relationships and trust.