

Resolving IP Disputes outside the Courts through WIPO ADR

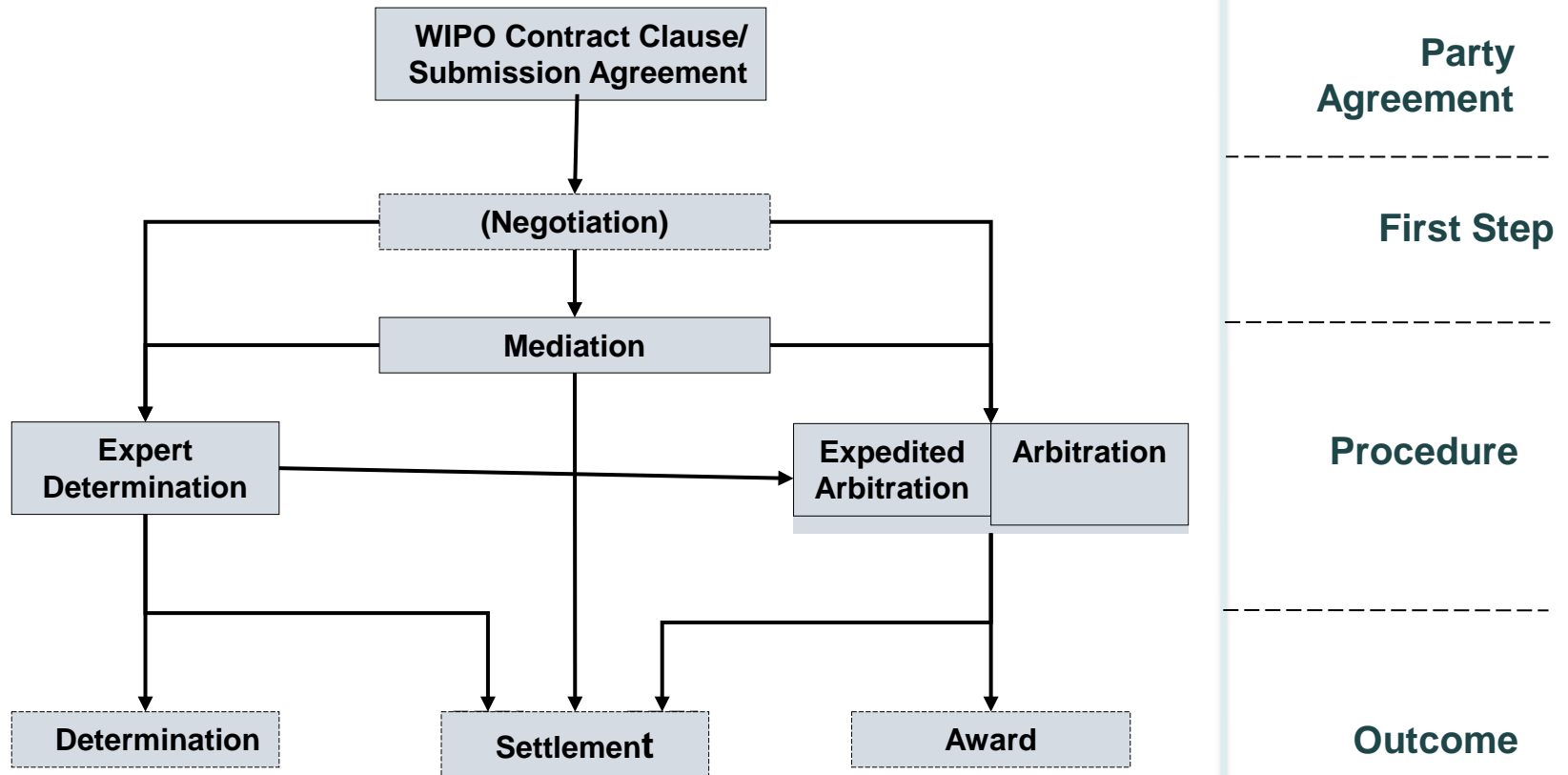
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WIPO Arbitration and Mediation Center

- Facilitates the resolution of commercial disputes between private parties involving IP and technology, through procedures other than court litigation (alternative dispute resolution: ADR)
 - Offices in Geneva and Singapore
- ADR of IP disputes benefits from a specialized international ADR provider
- WIPO services include mediation, (expedited) arbitration, expert determination, and domain name dispute resolution

ADR Options under WIPO Rules



Mediation, Arbitration, Expert Determination

■ **Mediation:** an informal procedure in which a neutral intermediary, the mediator, assists the parties in reaching a settlement of their dispute, based on the parties' respective interests. The mediator cannot impose a decision. The settlement agreement has the force of a contract.

■ **Arbitration:** a procedure in which the parties submit their dispute to one or more chosen arbitrators, for a binding and final decision (award) based on the parties' respective rights and obligations and enforceable as an award under arbitral law.

■ **Expert Determination:** a procedure in which the parties submit a specific matter (e.g. technical question) to one or more experts who make a determination on the matter, which can be binding unless the parties have agreed otherwise.

WIPO Arbitration

Request for Arbitration

Answer to Request for Arbitration

Appointment of Arbitrator(s)

Statement of Claim

Statement of Defense

**Further Written Statements and Witness
Statements**

Hearings

Closure of Proceedings

Final Award

WIPO Expedited Arbitration

**Request for Arbitration
and Statement of Claim**

**Answer to Request for Arbitration and
Statement of Defense**

Appointment of Arbitrator(s)

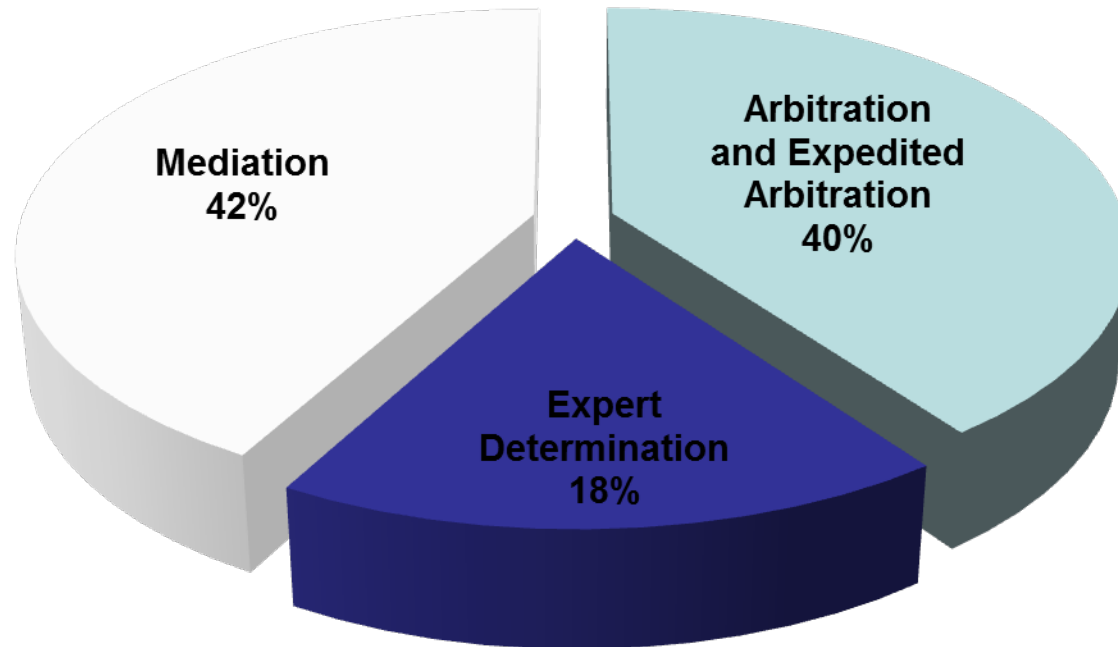
Hearing

Closure of Proceedings

Final Award

- **One exchange of pleadings**
- **Shorter time limits**
- **Sole arbitrator**
- **Shorter hearings**
- **Fixed fees**

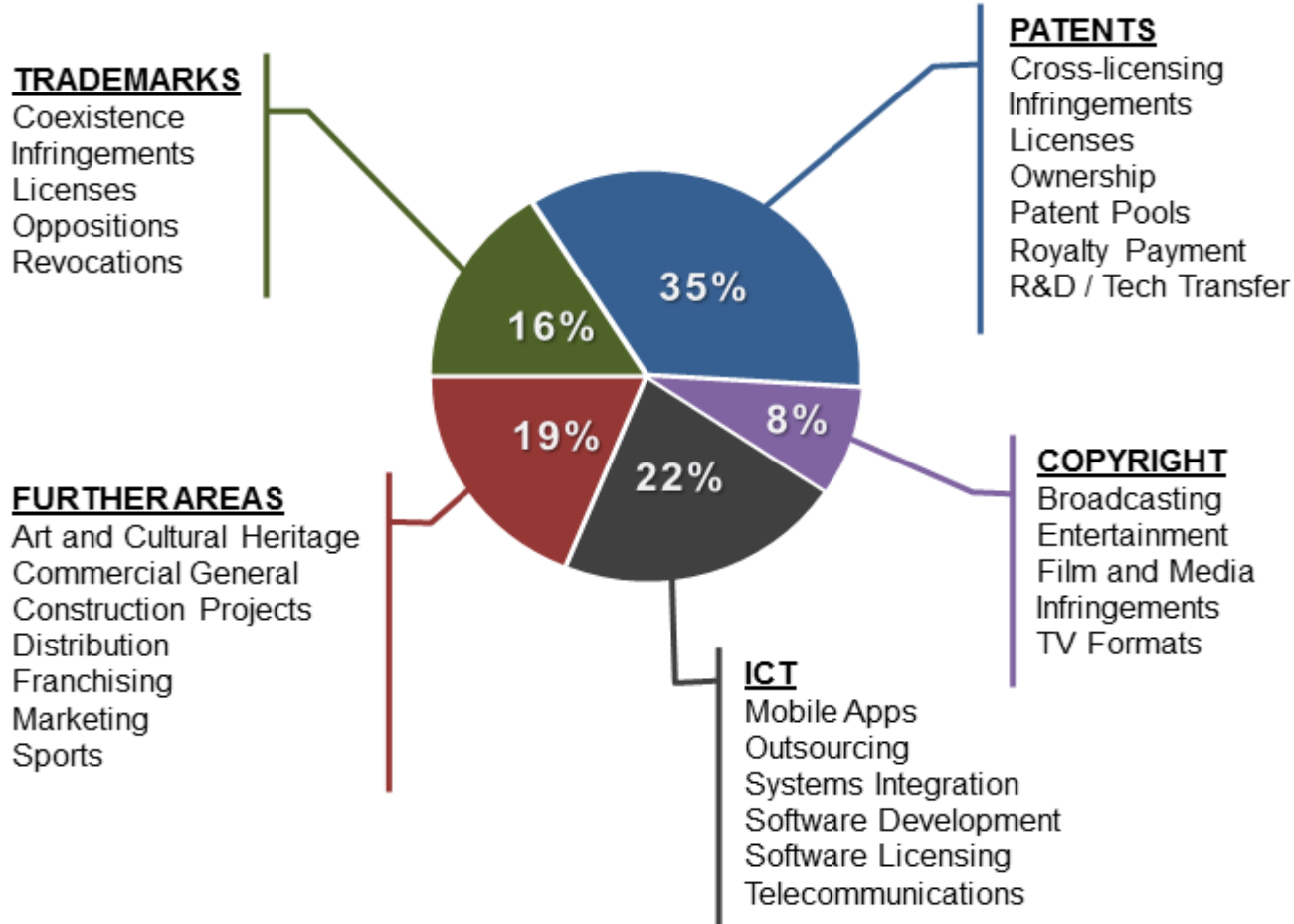
WIPO Cases: Types of Procedure



WIPO Mediation, Arbitration and Expert Determination Cases

- **IP/IT disputes and commercial disputes**
 - **Contractual: patent licenses, software/ICT, R&D and technology transfer agreements, patent pools, distribution agreements, joint ventures, copyright collecting societies, trademark coexistence agreements, settlement agreements**
 - **Non-contractual: infringement of IP rights**
- **Domestic and international disputes (25% / 75%)**
- **Amounts in dispute from USD 50,000 to USD 1 billion**

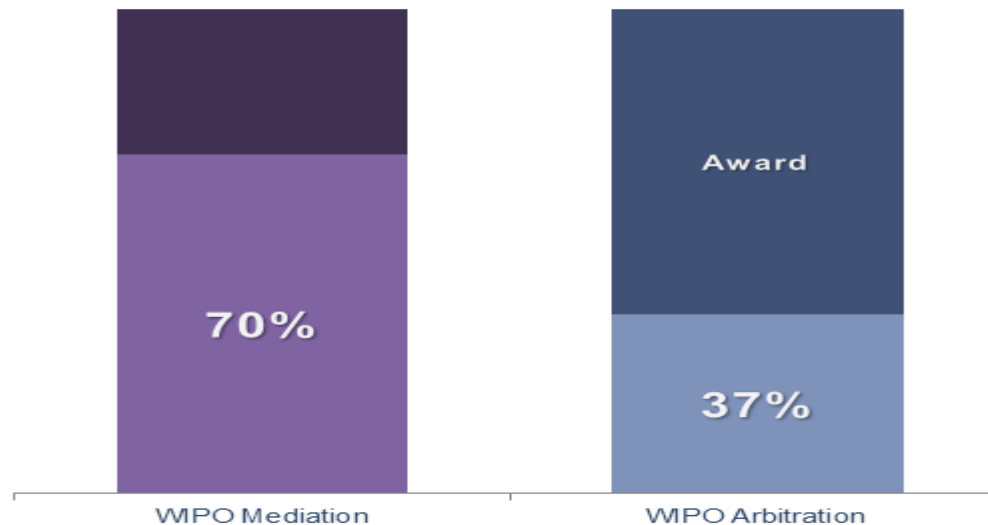
Dispute Areas in WIPO Mediation and Arbitration Cases



Cases under WIPO Rules: Remedies

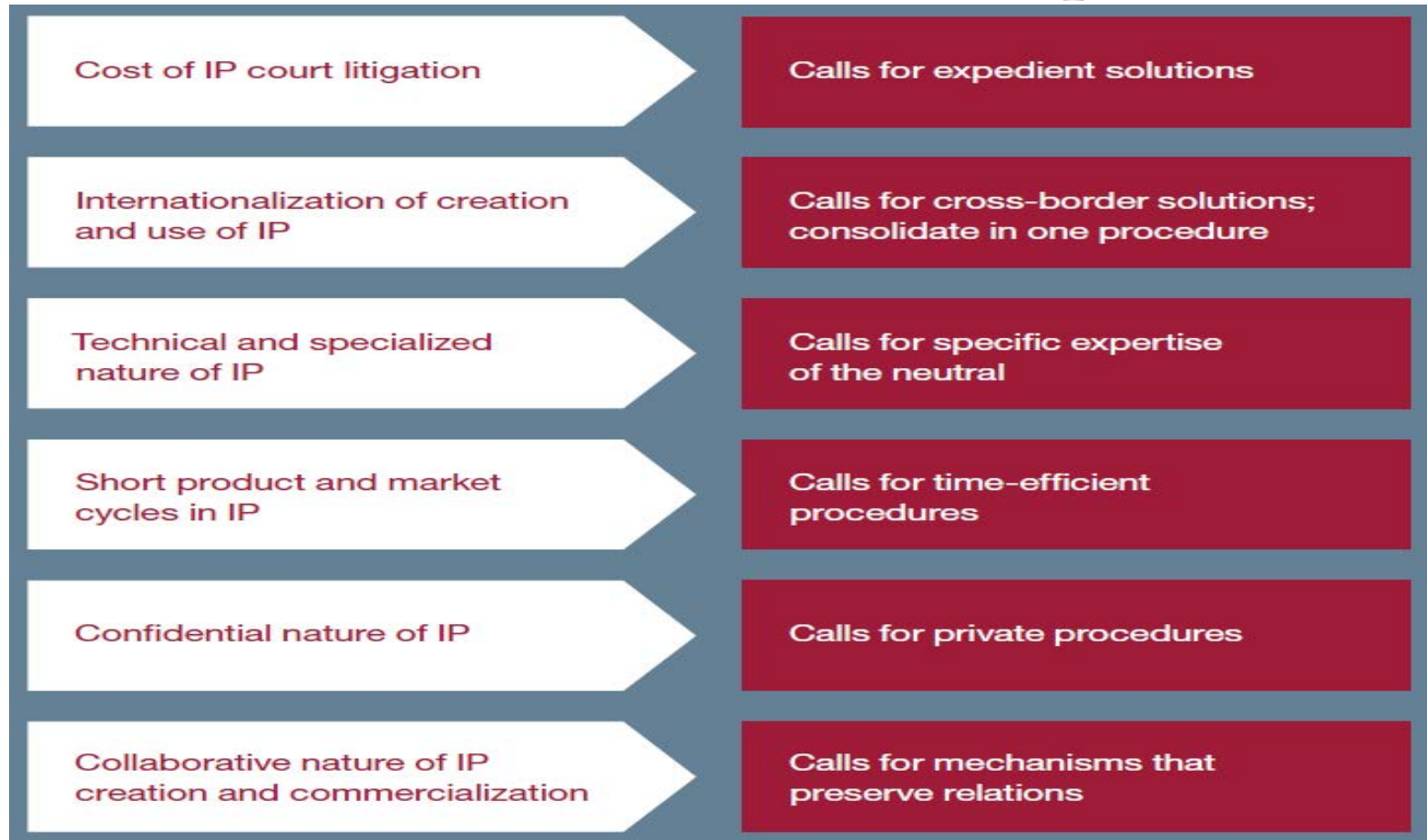
- Damages
- Royalty payment
- Infringement declarations
 - Non-performance of contractual obligations
 - Infringement of rights
- Specific performance
 - Further safeguards for the preservation of confidentiality of evidence
 - Provision of security
 - Production of data
 - Delivery of goods
 - Conclusion of new contracts

Cases under WIPO Rules: Settlement Rates

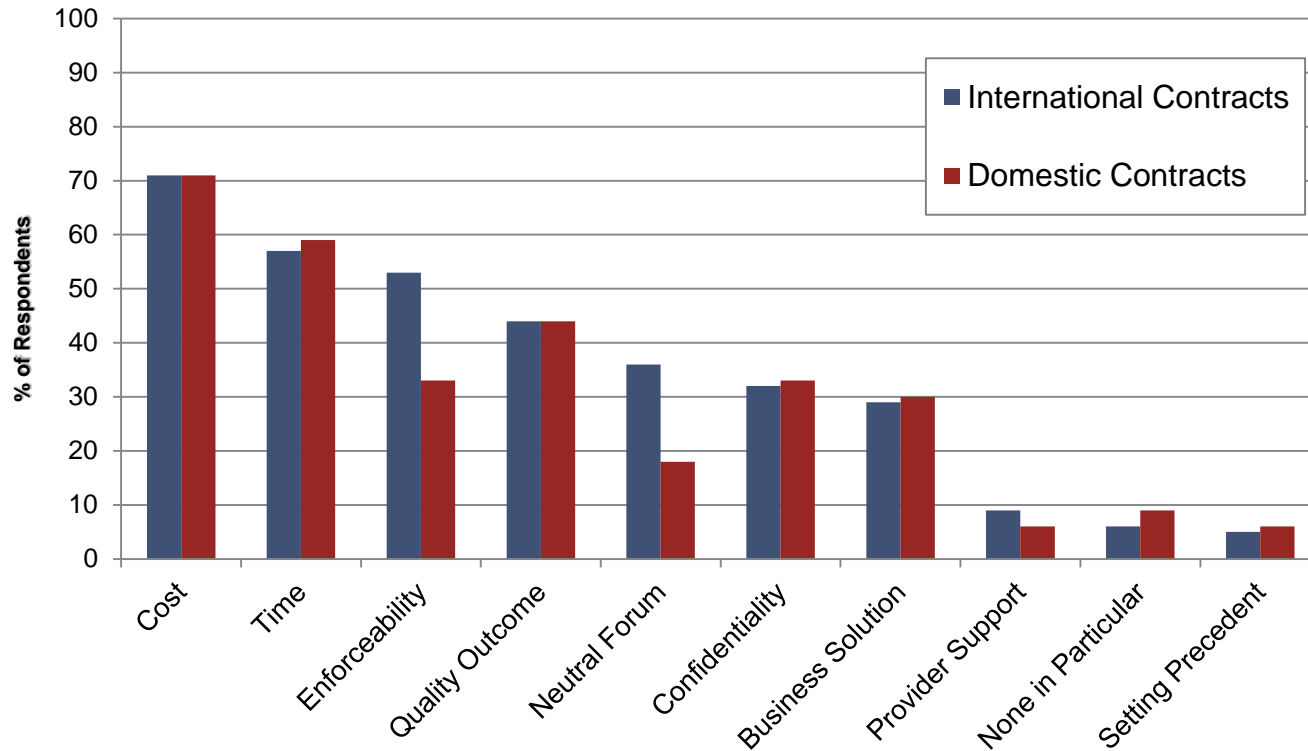


- With rare exceptions, no indications of any particular enforcement issue

Why Consider ADR for IP Disputes?

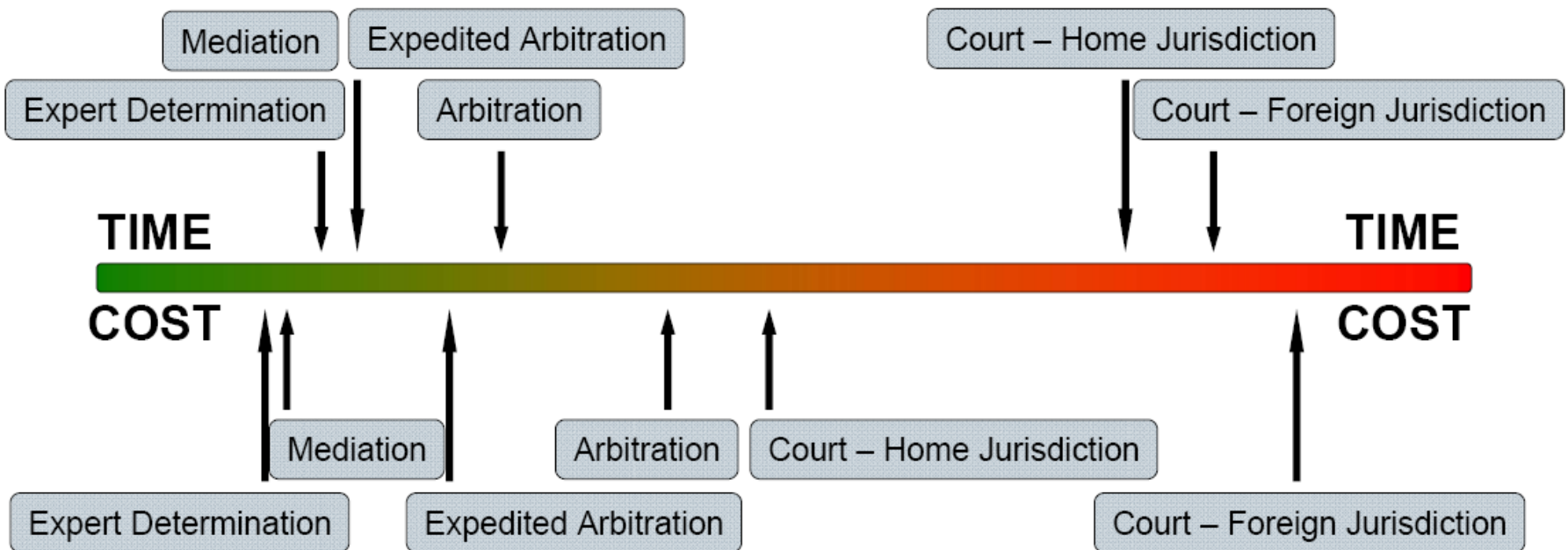


Top Ten Priorities in Choice of Dispute Resolution Clause (WIPO Survey)



WIPO Center International Survey of Dispute Resolution in Technology Transactions (2013)

Relative Time and Cost of Technology Dispute Resolution



WIPO Center International Survey of Dispute Resolution in Technology Transactions (2013)

Routes to ADR

- **ADR contract clauses**
- **Submission Agreements, e.g. in non-contractual disputes**
- **Domestic and international**
- **Sometimes following court litigation between the parties (court referral)**
- **Model clauses/submission agreements:**
<http://www.wipo.int/amc/en/clauses/index.html>

WIPO Model Clauses

"Any dispute, controversy or claim arising under, out of or relating to this contract and any subsequent amendments of this contract, including, without limitation, its formation, validity, binding effect, interpretation, performance, breach or termination, as well as non-contractual claims, shall be submitted to mediation in accordance with the WIPO Mediation Rules. The place of mediation shall be [specify place]. The language to be used in the mediation shall be [specify language]"

If, and to the extent that, any such dispute, controversy or claim has not been settled pursuant to the mediation within t [60][90] days of the commencement of the mediation, it shall, upon the filing of a Request for Arbitration by either party, be referred to and finally determined by arbitration in accordance with the WIPO Expedited Arbitration Rules. Alternatively, if, before the expiration of the said period of [60][90] days, either party fails to participate or to continue to participate in the mediation, the dispute, controversy or claim shall, upon the filing of a Request for Arbitration by the other party, be referred to and finally determined by arbitration in accordance with the WIPO Expedited Arbitration Rules. The place of arbitration shall be [specify place]. The language to be used in the arbitral proceedings shall be [specify language]. The dispute, controversy or claim referred to arbitration shall be decided in accordance with [specify jurisdiction] law."

WIPO Clauses / Submission Agreements

- Parties can further shape the process
- WIPO Clause Generator proposes core and additional elements, including
 - Arbitral Tribunal (qualifications, composition, appointment procedure)
 - Evidence
 - Electronic submissions of case communications
 - Award (timelines, reasoning)
 - Appeal

<http://www.wipo.int/amc-apps/clause-generator/>

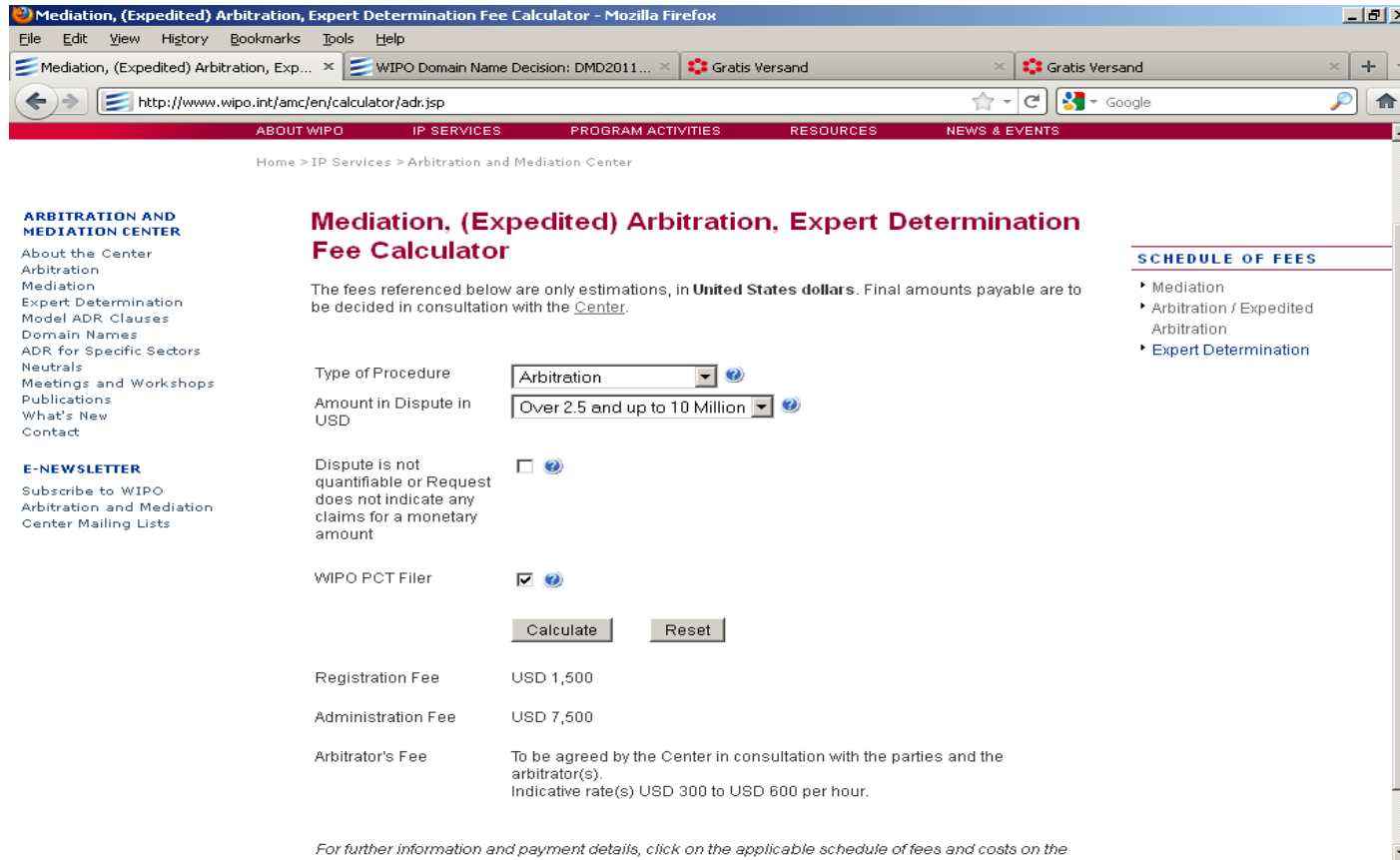
Cost Control in WIPO Cases

- **Schedule of Fees**
 - **Non-profit**
 - **Discounts available for PCT/Madrid/Hague users**

- **Smaller cases**
 - **Negotiation of capped fees**

- **Managing neutral's fee expectations and availability**
 - **Center remains available to discuss procedural aspects**
 - **Explore and stimulate party settlement**

Fee Calculator



The screenshot shows a web browser window titled "Mediation, (Expedited) Arbitration, Expert Determination Fee Calculator - Mozilla Firefox". The address bar shows the URL <http://www.wipo.int/amc/en/calculator/adr.jsp>. The page content includes a navigation menu with links for "ABOUT WIPO", "IP SERVICES", "PROGRAM ACTIVITIES", "RESOURCES", and "NEWS & EVENTS". The main heading is "Mediation, (Expedited) Arbitration, Expert Determination Fee Calculator". Below the heading, there is a text block stating: "The fees referenced below are only estimations, in **United States dollars**. Final amounts payable are to be decided in consultation with the [Center](#)." The form contains the following fields and options:

- Type of Procedure: Arbitration
- Amount in Dispute in USD: Over 2.5 and up to 10 Million
- Dispute is not quantifiable or Request does not indicate any claims for a monetary amount:
- WIPO PCT Filer:

Buttons for "Calculate" and "Reset" are present. Below the form, the calculated fees are listed:

Registration Fee	USD 1,500
Administration Fee	USD 7,500
Arbitrator's Fee	To be agreed by the Center in consultation with the parties and the arbitrator(s). Indicative rate(s) USD 300 to USD 600 per hour.

At the bottom, a note reads: "For further information and payment details, click on the applicable schedule of fees and costs on the" followed by a dropdown arrow.

<http://www.wipo.int/amc/en/calculator/adr.jsp>

Tailored WIPO ADR Services for Specific Sectors

- Disputes arising in a specific industry sector or for a specific subject matter may benefit from ADR procedures tailored to specific types of disputes and attendant needs
- Tailoring of clauses / submission agreements; rules; schedule of fees and costs; specialized panel of mediators, arbitrators, experts
- Examples (www.wipo.int/amc/en/center/specific-sectors/):
 - Research & Development/Technology Transfer (DESCA, IPAG)
 - Intellectual Property Offices: WIPO ADR options for parties in administrative trademark/patent procedures before IP Offices of e.g. Singapore, Brazil, Colombia, Mexico and the Philippines
 - IT / Patents in Standards (FRAND disputes)
 - Model Submission Agreements to facilitate referral of FRAND/SEP disputes to WIPO ADR, developed in consultation with ETSI
<http://www.wipo.int/amc/en/center/specific-sectors/ict/frand/>
- Franchising

Further Information

- **WIPO procedures, neutrals and case examples:**

<http://www.wipo.int/amc/en>

- **WIPO ADR Rules:**

<http://www.wipo.int/amc/en/rules/>

- **WIPO model clauses/submission agreements**

<http://www.wipo.int/amc/en/clauses/>

- **Contact information:**

arbiter.mail@wipo.int

