



 **Have you considered WIPO mediation and arbitration services for your trademark disputes?**

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WIPO Arbitration and Mediation Center

# In this webinar

- Send your questions
- Download handouts
- Receive webinar recording

## In this webinar

- Basic principles of mediation and arbitration and the WIPO Arbitration and Mediation Center's experience
- Are you prepared for potential future trademark disputes?
- Are you already involved in a trademark dispute?

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# World Intellectual Property Organization (WIPO)



# World Intellectual Property Organization (WIPO)

- Promotes innovation and creativity
- For the economic, social and cultural development of all countries
- Through a balanced and effective international IP system
- WIPO provides IP services that encourage individuals and businesses to innovate and create
  - Alternative Dispute Resolution (ADR) services to reduce the impact of disputes on innovation and creative processes

# WIPO Arbitration and Mediation Center

- Facilitates the resolution of commercial disputes between private parties involving IP, through procedures other than court litigation, including mediation and arbitration
  - Offices in Geneva and Singapore
  - Users around the world
- ADR provider specialized in IP disputes
  - WIPO mediators, arbitrators and experts experienced in IP - able to deliver informed results efficiently
- International neutrality



# Mediation

- Informal consensual process
- Neutral intermediary – mediator
  - assists parties in reaching settlement of their dispute
  - based on parties' respective interests
  - cannot impose a decision
- Settlement agreement has force of a contract
- Leaves open court or arbitration options



# Arbitration

- Consensual procedure
- Parties submit dispute to one or more chosen arbitrators
- Binding and final decision (award)
  - based on parties' rights and obligations
  - enforceable internationally
- Normally forecloses court options

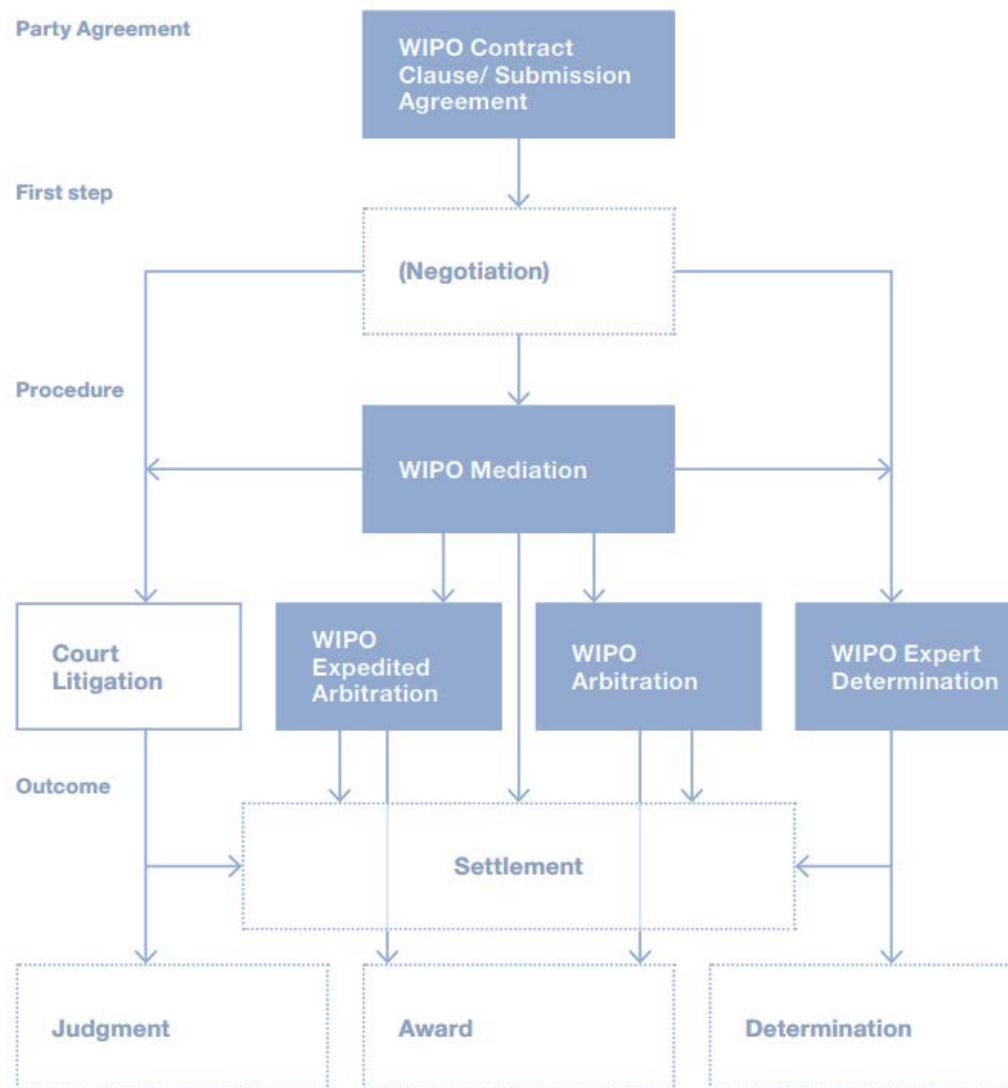
# Mediation and arbitration compared

	<b>Mediation</b>	<b>Arbitration</b>
<b>Parties</b>	Either party may unilaterally withdraw from the procedure.	Once the parties have validly agreed to submit a dispute to arbitration, neither party may unilaterally withdraw from the procedure.
<b>Mediator/ arbitrator</b>	The mediator functions as a “catalyst” or settlement facilitator, but cannot impose a settlement on the parties.	The arbitrator(s) (“tribunal”) has the authority to decide the case in a final award.
<b>Scope</b>	Any settlement is agreed by the parties and is based on the parties’ interests, which may be broader than their legal positions.	The tribunal addresses the parties’ legal positions on the basis of the applicable substantive law.
<b>Outcome</b>	Any settlement agreement is binding between the parties as a matter of contract law.	Awards are legally binding on the parties, final and enforceable internationally.

# Court Litigation vs. ADR

	Court Litigation	Arbitration	Mediation
Party agreement needed to initiate	✘	✓	✓
Parties can select specialized neutral	✘	✓	✓
Neutral is a decision maker	✓	✓	✘
Confidential	✘	✓	✓
Efficient for international disputes	✘	✓	✓
Parties can shape proceedings	✘	✓	✓
Possibility of appeal	✓	limited	n.a.
International enforcement of outcome	limited	✓	n.a.

# WIPO ADR options



# What is the WIPO Center's role?

## ■ WIPO Center can

- provide information and procedural advice
- assist parties in considering the referral of a dispute to WIPO proceedings
- assist parties in the selection of specialized mediators, arbitrators and experts (2,000+ from around the world)
- arrange for support services, including meeting rooms and videoconferencing facilities

## ■ WIPO Center cannot

- provide legal advice or represent parties in dispute
- force any party to refer a dispute to or participate in WIPO proceedings

# WIPO ADR Rules

- IP-specific elements
  - e.g., confidentiality, technical evidence, interim relief
- Applicable to all commercial disputes
- Flexibility
  - Pre-structure entire proceeding
  - For most part can be modified by arrangement between mediator or arbitrator and parties
- For domestic and international disputes
  - Accommodating different legal/procedural traditions

**WIPO Mediation,  
Arbitration,  
Expedited Arbitration  
and Expert  
Determination Rules  
and Clauses**

# WIPO mediation and arbitration cases

## Areas of disputes

### Copyright

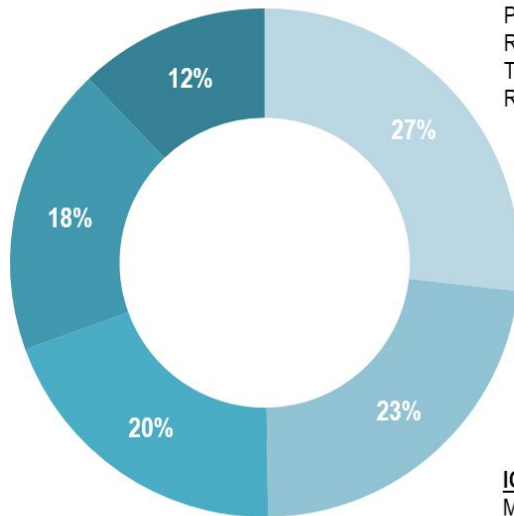
Art  
Broadcasting  
Collective Management  
Entertainment  
Film and Media  
Infringements  
TV Formats

### Commercial

Design  
Distribution  
Energy  
Franchising  
Marketing  
Sports

### Trademarks

Coexistence  
Infringements  
Licenses  
Oppositions  
Revocations



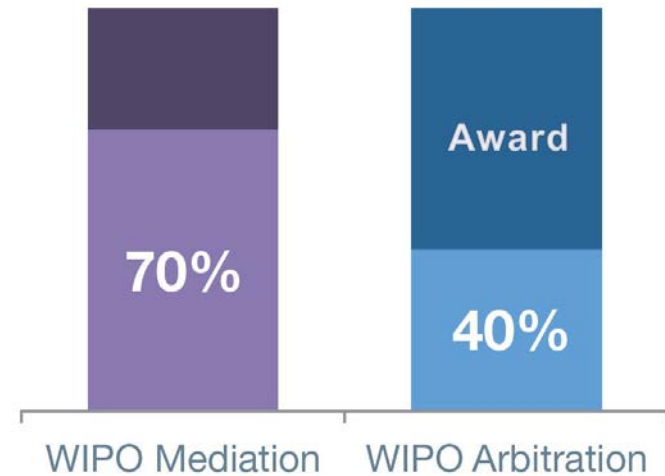
### Patents

Cross-licensing  
Infringements  
Licenses  
Ownership  
Patent Pools  
R&D / Tech  
Transfer  
Royalty Payment

### ICT

Mobile Apps  
Outsourcing  
Systems Integration  
Software Development  
Software Licensing  
Telecommunications

## Settlement rates



# WIPO mediation and arbitration trademark case highlights

- Recent increase in case numbers
- Mediation most requested procedure
- Top business areas: ICT, life sciences, manufactured goods, luxury goods, and entertainment
- Most common types of disputes: licensing, distribution, and franchising agreements, coexistence agreements, infringement, and trademark opposition before national IP Offices



[Home](#) > [IP Services](#) > [Alternative Dispute Resolution](#)**WIPO | ADR**

## Time- and Cost-Efficient Alternative Dispute Resolution Services for Users of the Madrid System

The [WIPO Arbitration and Mediation Center's](#) alternative dispute resolution (ADR) services are regularly used by users of the Madrid System from around the world.

A 25% reduction on the WIPO Center's [mediation, arbitration and expert determination administration fees](#) applies if a party (or both parties) to the dispute is (are) holders of international registrations under the Madrid system.

[Contact us](#)

### WIPO Trademark-related cases

Today, trademark disputes may arise in a wide range of business transactions, including licensing, distribution, franchising and co-existence agreements, as well as in cases of direct infringement and in opposition procedures pending before national Intellectual Property Offices.

■ [www.wipo.int/amc/en/center/madrid](http://www.wipo.int/amc/en/center/madrid)

## In this webinar

- Basic principles of mediation and arbitration and the WIPO Arbitration and Mediation Center's experience
- **Are you prepared for potential future trademark disputes?**
- Are you already involved in a trademark dispute?

# How can you use WIPO ADR?

**For what kind of disputes?**

**How to refer disputes to WIPO ADR**

**WIPO resources**

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For trademark contractual  
disputes

Inclusion of ADR contract clause

WIPO model ADR clauses

- WIPO model clauses: [www.wipo.int/amc/en/clauses](http://www.wipo.int/amc/en/clauses)
- WIPO Clause Generator: [www.wipo.int/amc-apps/clause-generator](http://www.wipo.int/amc-apps/clause-generator)

# Clause example for your contract: mediation followed by expedited arbitration

**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 [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.

# A few general mediation and arbitration clause pointers

- Combine options
  - Include mediation
  - Like court cases, mediation and arbitration cases get settled
- If arbitration, consider expedited version
- ‘Institutional’ or ‘ad hoc’?
  - Hard to agree on procedure once dispute arisen
  - Do you know suitable mediators or arbitrators?
  - Which administering institution?
- Use model clauses as basis and modify/extend only as necessary
  - Do not divide per type of right, remedy, dispute, or party case status
  - Consider expressly excluding discovery and similar mechanisms

**WIPO**  
WORLD INTELLECTUAL PROPERTY ORGANIZATION

Home | IP Services | Alternative Dispute Resolution | WIPO Clause Generator

WIPO | ADR

## WIPO Clause Generator

### Step 3 – Build your clause: WIPO Mediation followed, in the absence of a settlement, by Arbitration Clause

#### Mediation

The parties should determine where they want the mediation to take place.

The place of mediation shall be

**Core Elements** ?

**Place of Mediation**

Language of the Mediation

Duration of the Mediation Proceedings

**Additional Elements** ?

Qualifications of the Mediator

Conduct of the Mediation

#### Arbitration

**Core Elements** ?

Number of Arbitrators

Place of Arbitration

Language of Arbitration

Substantive Law

**Additional Elements** ?

Appointment Procedure

Qualifications of the Arbitrators

ECAF

Evidence

Time Period of Delivery of the Final Award

Appeal

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 [specify timeline] 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 Arbitration Rules. Alternatively, if, before the expiration of the said period of [specify timeline] 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 Arbitration Rules.

The arbitral tribunal shall consist of [a sole arbitrator][three arbitrators].

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 shall be decided in accordance with the law of [specify jurisdiction].

### Step 4 – Download or copy the final result

## WIPO case examples: Contractual trademark disputes

- Mediation: Exclusive trademark licensing agreement for sponsorship
  - WIPO Mediation clause
  - European parties
  - Breach of contract
  - Payment of royalties
  
- Expedited Arbitration: Trademark licensing and distribution agreement for sports goods
  - WIPO Expedited Arbitration clause
  - European parties
  - Determine whether agreement was lawfully terminated
  - Payment of damages

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- Are you prepared for potential future trademark disputes?
- **Are you already involved in a trademark dispute?**



# How can you use WIPO ADR?

For what kind of disputes?	How to refer disputes to WIPO ADR	WIPO resources
For existing disputes (e.g., trademark infringement)	ADR submission agreement by all parties	WIPO model ADR submission agreements
	Unilateral request by one party	Unilateral Request for WIPO Mediation
For existing trademark disputes pending in national courts	ADR submission agreement by all parties	WIPO model ADR submission agreements
	Unilateral request by one party	Unilateral Request for WIPO Mediation

- WIPO model submission agreements: [www.wipo.int/amc/en/clauses](http://www.wipo.int/amc/en/clauses)
- Unilateral Request for WIPO Mediation: [www.wipo.int/amc/en/docs/request\\_mediation.docx](http://www.wipo.int/amc/en/docs/request_mediation.docx)
- WIPO Clause Generator: [www.wipo.int/amc-apps/clause-generator](http://www.wipo.int/amc-apps/clause-generator)

# WIPO Good Offices

- Disputes where one or both parties consider submitting the dispute to mediation or arbitration
  - No previous agreement on how to resolve the dispute
    - Infringement
    - Cases pending before the courts
  
- Procedural advice
  
- No fees at this stage

# WIPO Arbitration submission agreement example:

We, the undersigned parties, hereby agree that the following dispute shall be referred to and finally determined by arbitration **in accordance with the WIPO Arbitration Rules**:

[brief **description of the dispute**]

The arbitral tribunal shall consist of [**a sole arbitrator**][**three arbitrators**]. The place of arbitration shall be [**specify place**]. The language to be used in the arbitral proceedings shall be [**specify language**]. The dispute shall be decided in accordance with the law of [**specify jurisdiction**].



## Request for WIPO Mediation

(Article 4 of the WIPO Mediation Rules)

*Note: The requesting party shall complete sections 1 and 2(a). The other party shall complete section 2(b).*

### 1. Parties

Please provide the following contact information:

Requesting Party	Other Party
Name:	Name:
Country of domicile:	Country of domicile:
Tel:	Tel:
E-mail:	E-mail:
Address:	Address:
Represented by:	Represented by:
Tel:	Tel:
E-mail:	E-mail:
Address:	Address:

### 2. Dispute

Please provide a brief description of the dispute:

a) The requesting party agrees to submit the above-described dispute to mediation in accordance with the WIPO Mediation Rules.

Please sign this form and submit it to [arbiter.mail@wipo.int](mailto:arbiter.mail@wipo.int) and to the other party.

Place and Date: \_\_\_\_\_

Signature: \_\_\_\_\_

b) The other party agrees to submit the above-described dispute to mediation in accordance with the WIPO Mediation Rules.

Please sign this form and submit it to [arbiter.mail@wipo.int](mailto:arbiter.mail@wipo.int) and to the requesting party.

Place and Date: \_\_\_\_\_

Signature: \_\_\_\_\_

## WIPO case examples: Non-contractual trademark disputes

- Mediation: Trademark co-existence dispute
  - Parties from US, Spain, Italy
  - To avoid confusion of similar trademarks and regulate future use
  - Agreement to submit dispute to WIPO Mediation
  - Global settlement
  
- Mediation: Opposition to trademark application before IP Office
  - Longstanding cross-border commercial and IP dispute
  - Parties from Singapore, Malaysia, Indonesia
  - Agreement to submit trademark oppositions to WIPO Mediation
  - Regional settlement of trademark and other commercial disputes

# WIPO Center collaboration with IP Offices

- Raising awareness of mediation and arbitration options
- Case administration
  - IP Offices in collaboration with WIPO Center
    - Intellectual Property Office of Singapore (IPOS) mediation option for trademark proceedings
    - Polish Patent Office (UPRP) mediation option for trademark proceedings

## WIPO Mediation Pledge for IP and Technology Disputes

The World Intellectual Property Organization (WIPO) through its Arbitration and Mediation Center contributes to awareness of alternative dispute resolution (ADR) options for resolving IP and technology disputes.

Without binding parties, the WIPO Mediation Pledge for IP and Technology Disputes seeks to encourage the use of mediation to reduce the impact of disputes in innovation and creative processes.

As a signatory of this Pledge, we recognize that mediation may offer a more collaborative, time- and cost-efficient manner of resolving commercial disputes related to IP and technology than court litigation.

In light of this, to the extent we consider this appropriate:

### Companies, Universities, R&D Centers, and Individuals

- We are prepared to explore the inclusion of mediation clauses in contracts and agreements we are party to;
- In the absence of such clauses, we are prepared to explore the resolution of existing disputes through mediation.

### Lawyers and Law Firms

So that clients can make informed choices:

- We are prepared to explore with clients the inclusion of mediation clauses in contracts and agreements they are party to;
- In the absence of such clauses, we are prepared to explore with clients the resolution of existing disputes through mediation.



**350+ signatories  
from  
90 countries**



**Join the Pledge!**

**WIPO | ADR**  
Arbitration  
and Mediation  
Center

# Tackling cybersquatting: the Uniform Domain Name Dispute Resolution Policy (UDRP)

- 1999: WIPO-created international ADR procedure
- Allows trademark owners to resolve “clear-cut” cases of abusive domain name registration and use (“cybersquatting”)
- Operates outside the courts, but preserves court option
- Applies via mandatory domain name registration conditions
- Applies to all international domains “old” (.com, etc.) and “new”
- Also available for over 75 country-code domains



# Why do brand owners choose the UDRP?

- Significantly quicker and cheaper than court litigation
  - Two-month average; fixed fees (USD 1,500)
- Predictable criteria and results
- Decision (transfer) implemented directly by registrar

# WIPO domain name cases at a glance

- 20 years' experience as global leader
- 44,000+ cases covering 81,000+ domain names
  - 2018 total: 3,447 cases
- Parties based in 177 countries
- Cases in 21 languages to date
- Paperless filing through WIPO eUDRP

# Key WIPO UDRP resources

- WIPO Guide to the UDRP
- Model pleadings (complaint and response)
- Legal Index of UDRP Decisions
- WIPO Jurisprudential Overview of Selected UDRP Questions



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**WIPO Overview of WIPO Panel Views  
on Selected UDRP Questions,  
Third Edition (“WIPO Overview 3.0”)**

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# Contact us

- Queries: [arbiter.mail@wipo.int](mailto:arbiter.mail@wipo.int)
- Further information: [www.wipo.int/amc](http://www.wipo.int/amc)
  
- WIPO Arbitration and Mediation Center Offices
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  - Singapore, Singapore
  
- WIPO External Offices
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  - Beijing, China
  - Tokyo, Japan
  - Moscow, Russia
  - Singapore, Singapore