

WIPO Guide on Alternative Dispute Resolution (ADR) Options for Intellectual Property Offices and Courts

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Foreword

Conflict is an inevitable part of doing business. Alternative dispute resolution (ADR) processes, understood here to include mediation, expert determination and arbitration, were developed to provide practical justice for a wide range of disputes outside the courts.

This Guide is designed to provide an overview of ADR processes for intellectual property disputes, as well of the experience of the World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center) in the context of public ADR programs, and to present options for interested Intellectual Property and Copyright Offices (IPOs), courts and other bodies (before which intellectual property disputes are adjudicated) to promote and integrate ADR processes into their existing services.

As such, without purporting in any way to be authoritative or prescriptive, this Guide is intended to serve as a practical primer for IPOs, courts and other bodies considering the development, implementation and/or improvement of ADR programs directed at intellectual property disputes.

To this end, Chapter One offers background information concerning the early use and rise of ADR around the world, followed in Chapter Two by a description of potential advantages of ADR for intellectual property disputes. Chapter Three explains in more detail the different ADR procedures that may be used in intellectual property disputes, while Chapter Four outlines some practical considerations that may be relevant for IPOs and courts that wish to institutionalize such ADR procedures. For the substantive and procedural implementation of such procedures, the Guide identifies as a core element the interface with existing regulations.

The Appendices to the Guide include an overview of the WIPO Center's collaborations with IPOs, as well as related model documents that may serve as illustration. A further Appendix contains a sample information document for possible court referral of intellectual property disputes to ADR.

Generally speaking, the use of ADR in intellectual property disputes in the context of IPO or court proceedings is a relatively recent development. This second edition of the Guide aims to capture the WIPO Center's growing experience in this area. It is hoped that the Guide will prove a useful reference for IPOs and courts that wish to explore or further develop the integration of ADR mechanisms as an optional alternative to their administrative or judicial proceedings.

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Chapter One: Historical Background

1.1. Origins and Early Uses of ADR

1.1.1 Mediation

Mediation is an informal procedure in which a neutral intermediary, the mediator, assists the parties in reaching a settlement of their dispute, based on their respective interests, as further explained in Chapter 3.3. It has its roots in traditional community practices found in countries around the world. These early mediation practices generally relied on a respected community leader, who would provide guidance based on community values and persuade the disputing parties to amicably resolve their differences.¹ Traditional mediation practices have been documented in Albania,² Burundi,³ China,⁴ Japan,⁵ the Philippines, the Republic of Korea and Singapore.⁶

Mediation also contributed to the development of legal systems in Rome and Anglo-Saxon England. In ancient Rome, a version of judicial mediation appears to have been the preferred means of resolving civil disputes; this approach had an important influence on civil procedure in continental Europe, particularly in Austria, Germany and Switzerland.⁷ In Anglo-Saxon England, judges and arbitrators encouraged parties to negotiate settlement agreements after issuing their judgment on the merits, but before the judgment was procedurally finalized. Mediation was used in these early legal systems to preserve ongoing relationships between litigants, and to effect peaceful and enduring resolutions to disputes.⁸

1.1.2 Arbitration

Arbitration, explained in more detail in Chapter 3.5, is 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. Arbitration developed out of the adjudicative process used by merchants to regulate their disputes.⁹ Merchants would bring their disputes before a tribunal of fellow merchants, which would render a decision based on customary commercial practices. Although

¹ Ho-Beng Chia, Joo Eng Lee-Partridge and Chee-Leong Chong, 'Traditional mediation practices: Are we throwing the baby out with the bath water?' (2004) Vol. 21 Conflict Resolution Quarterly 451, 453-455.

² Ayse Betul Celik and Alma Shkreli, 'An Analysis of Reconciliatory Mediation in Northern Albania: The Role of Customary Mediators' (2010) 62 Europe-Asia Studies 885.

³ UNESCO, 'Women and Peace in Africa: Case studies on traditional conflict resolution practices' (2003) <http://unesdoc.unesco.org/images/0013/001332/133274e.pdf> accessed September 2018.

⁴ Joel Lee and Teh Hwee Hwee eds, 'An Asian Perspective on Mediation' (Academy Publishing 2009) 4.

⁵ Ronda Roberts Callister and James A Wall, 'Japanese Community and Organizational Mediation' (1997) Vol. 41, The Journal of Conflict Resolution, 311, 313.

⁶ Joel Lee and Teh Hwee Hwee eds, *ibid.* 4, 4.

⁷ Christian Bühring-Uhle, Lars Kirchhoff and Gabriele Scherer, 'Arbitration and Mediation in International Business' (Kluwer Law International 2006) 177.

⁸ Valerie A Sanchez, 'Towards a History of ADR: The Dispute Processing Continuum in Anglo-Saxon England and Today' (1996) Vol. 11 The Ohio State Journal on Dispute Resolution 1, 3, <https://pdfs.semanticscholar.org/8398/6f1432a4d9ceebcece06d8050ed4a107eeb7.pdf> accessed September 2018.

⁹ Edward Manson, The City of London Chamber of Arbitration (1893) 9 LQR 86, 87.

these private systems of adjudication did not feature formal legal processes, they were considered as credible sources of commercial justice.¹⁰

Early arbitration practices have been documented in pre-Islamic Arabia and in medieval Western Europe.¹¹ Maritime arbitration was practiced in countries along the Western and Atlantic coasts of Europe in around 1200,¹² and records of maritime arbitrations dating back to 1229 have been found in Venice.¹³ Arbitration became a popular alternative to litigation for merchants because it was a system of self-regulation that provided quick, economical and informed decisions.¹⁴

1.2. Early Institutionalization and Regulation of ADR

1.2.1 Mediation

In countries such as Australia,¹⁵ New Zealand¹⁶ and the United States,¹⁷ mediation services and regulations were established in the early 20th century to address labor disputes. Labor disputes in the late 19th and 20th centuries were often costly, disruptive and even violent. In response, government authorities established labor conciliation services and laws, which enabled the extensive use of mediation between labor unions and employers. These labor conciliation services and laws were successful because they provided the necessary administrative framework to address labor disputes swiftly and peacefully on a hitherto unimagined scale.¹⁸

1.2.2 Arbitration

Arbitration institutions and regulations were first formalized in the 18th and 19th centuries to promote and facilitate the use of arbitration. Broadly speaking, arbitration institutions were more successful when arbitration laws that facilitated the enforcement of arbitration agreements and awards were already in place.¹⁹ For example, arbitration only began to thrive in the United States after the United States Arbitration Act was enacted in 1925, even though arbitration institutions had been established as early as in 1768.²⁰ In the United Kingdom, arbitration legislation was first enacted in 1698 and culminated in the Arbitration Act of 1889. Arbitration prospered under the auspices of this legislative regime,²¹ even though arbitration institutions were not established until 1892.²²

¹⁰ Charles S Haight Jr, 'Maritime Arbitration The American Experience' in A Collection of the Cedric Barclay Lectures: ICMA X-ICMA XV (Singapore International Arbitration Center 2006).

¹¹ Alan Redfern, M Hunter et. al., 'Law and Practice of International Commercial Arbitration' (4th ed, Sweet & Maxwell 2004) para 1-04.

¹² William Tetley, 'Marine Cargo Claims' (4th ed, Éditions Yvon Blais 2009) 1417.

¹³ Fabrizio Marrella, 'Unity and Diversity in International Arbitration: The Case of Maritime Arbitration' (2005) American University International Law Review, Vol 20, 1055, 1058
<http://digitalcommons.wcl.american.edu/cgi/viewcontent.cgi?article=1152&context=auilr> accessed September 2018.

¹⁴ Earl S Wolaver, 'The Historical Background of Commercial Arbitration' (1934) 83 U Pa L Rev 132, 144.

¹⁵ O de R Foenander, 'The New Conciliation and Arbitration Act in Australia' (1929) 19 Int'l Lab Rev 151.

¹⁶ Judy Dell and Peter Franks, 'Mediation and Collective Bargaining in New Zealand' (Ministry of Business, Innovation & Employment, 2009).

¹⁷ Edgar L Warren, 'The Conciliation Service: V-J Day to Taft-Hartley' (1948) 1 ILR Review 351.

¹⁸ Michael Wallin, 'Labour Administration: Origins and Development' (1969) 100 Int'l Lab Rev 51, 72.

¹⁹ Frank D Emerson, 'History of Arbitration Practice and Law' (1970) 19 Clev St L R 155, 158-159.

²⁰ Charles S Haight Jr, 'Maritime Arbitration The American Experience' in A Collection of the Cedric Barclay Lectures: ICMA X-ICMA XV (Singapore International Arbitration Center 2006).

²¹ Sidney P Simpson, 'Specific Enforcement of Arbitration Contracts' (1934) 83 U Pa L Rev 160, 165,
http://scholarship.law.upenn.edu/cgi/viewcontent.cgi?article=8695&context=penn_law_review accessed September 2018.

²² The London Court of International Arbitration was inaugurated as the City of London Chamber of Arbitration in 1892. See Edward Manson, 'The City of London Chamber of Arbitration' (1893) 9 LQR 86.

While enabling laws are critical to the development of arbitration, arbitration institutions can themselves play an important role in the enactment and promotion of these laws. In 1923, the International Court of Arbitration of the International Chamber of Commerce was established to provide an arbitration institution with a sufficiently “international” character for the fledgling international arbitration industry.²³ Subsequently, the International Court of Arbitration played a major role in the promulgation of the 1958 Convention on the Recognition and Enforcement of Foreign Arbitral Awards (New York Convention), which is widely considered as the most important multilateral treaty on international arbitration.²⁴

1.3. Rise of ADR around the World

1.3.1 Growth of ADR as an Alternative to Litigation

The ADR ‘boom’ in the 1970s and 1980s was spurred in large part by a rising dissatisfaction with litigation.²⁵ Aside from being exorbitant, time-consuming and acrimonious, it was evident that litigation could also be an enormous gamble.²⁶ Further, there was an apprehension, particularly among some academics and legal practitioners of the advent of a “litigation explosion”, where overly-litigious societies would overwhelm courts with unnecessary and costly lawsuits.²⁷

These concerns led Professor Frank Sander to develop the concept of the “multi-door courthouse”, which he presented at the 1976 Pound Conference. The “multi-door courthouse” would provide a range of dispute resolution services and court officials would refer parties to the most appropriate process for their case. Mediation and arbitration would play key roles in the “multi-door courthouse” as alternatives to litigation.²⁸

Professor Sander’s presentation is widely regarded as a “big bang” moment in the global ADR movement for three reasons. Firstly, it popularized the idea that disputes should be channeled into the most appropriate dispute resolution mechanism. Secondly, it promoted the advantages of alternatives to litigation, such as mediation and arbitration.²⁹ Finally, the “multi-door courthouse” proved to be an effective mechanism for facilitating access to ADR services and traditional court processes. Following the Pound Conference, “multi-door courthouses” were implemented in the United States,³⁰ and their

²³ Emmanuel Gaillard, Berthold Goldman and John Savage, ‘Fouchard, Gaillard, Goldman on International Commercial Arbitration’ (Kluwer Law International 1999) 174.

²⁴ Alan Redfern, M Hunter et. al., *ibid.* 11, 1-05.

²⁵ Bill Maurer, ‘The Disunity of Finance: Alternative Practices to Western Finance’ in Karin Knorr Cetina and Alex Preda (eds) *The Oxford Handbook of the Sociology of Finance* (Oxford University Press 2012) 413.

²⁶ Kevin M Lemley, ‘I’ll Make Him An Offer He Can’t Refuse: A Proposed Model For Alternative Dispute Resolution in Intellectual Property Disputes’ (2004) 37 *Akron L Rev* 287, 311-312, <https://www.uakron.edu/dotAsset/727495.pdf> accessed September 2018.

²⁷ Marc Galanter, ‘The Day After the Litigation Explosion’ (1986) 46 *Md L Rev* 3, 5, <http://digitalcommons.law.umaryland.edu/cgi/viewcontent.cgi?article=2633&context=mlr> accessed September 2018.

²⁸ Frank E A Sander, ‘Varieties of Dispute Processing’ in A Leo Levin and Russell R Wheeler (eds), *The Pound Conference: Perspectives on Justice in the Future* (West Group 1979) 65, 83.

²⁹ Michael L Moffitt, ‘Before the Big Bang: The Making of an ADR Pioneer’ (2006) 22 *Negotiation J* 435.

³⁰ ‘Transcript: A Dialogue Between Professors Frank Sander and Mariana Hernandez Crespo’ (2008) 5 *U St Thomas L J* 665, 673, <https://ir.stthomas.edu/cgi/viewcontent.cgi?article=1164&context=ustlj> accessed September 2018.

success spurred the establishment of similar initiatives in for example Australia,³¹ Canada,³² the Netherlands,³³ Nigeria³⁴ and Singapore.³⁵

1.3.2 Globalization of ADR

Since the 1980s, ADR has achieved an unprecedented prominence in the international community, and ADR programs have proliferated on a global scale.³⁶ The attractive force of ADR can be attributed to the simple fact that it has something for everyone: an additional channel for the provision of access to justice, thereby offering administrative relief for the courts and public agencies; a potentially quick, inexpensive and flexible avenue to resolve disputes for the disputants; and a growth industry and an increasingly profitable business for ADR practitioners and institutions.³⁷

Broadly speaking, ADR programs have been developed by courts and legal agencies to complement and support legal processes.³⁸ By channeling appropriate disputes into ADR processes, “multi-door courthouses” reduce backlog, accelerate case disposition and facilitate access to justice by reducing economic and procedural obstacles to resolving disputes.³⁹ Court-connected ADR programs also place courts in a better position to address disputes that are ill-suited to adversarial litigation.⁴⁰ For example, family courts were early adopters of mediation programs because of the emotional and interpersonal characteristics of family disputes.⁴¹

Beyond judicial efforts, the growth of ADR has been driven by a strong demand from the international business community. ADR processes are appropriate for businesses because they can provide time and cost savings, as well as commercially useful outcomes: arbitration awards are generally internationally enforceable⁴² and final,⁴³ while mediation enables the formulation of settlements which

³¹ Robert French, ‘Perspectives on Court Annexed Alternative Dispute Resolution’ (High Court of Australia, July 27, 2009) <http://www.hcourt.gov.au/assets/publications/speeches/current-justices/frenchcj/frenchcj27july09.pdf> accessed September 2018.

³² Trevor CW Farrow, ‘Civil Justice, Privatization and Democracy’ (University of Toronto Press 2014) 73.

³³ Annie J de Roo and Robert W Jagtenberg, ‘The Dutch Landscape of Court-Encouraged Mediation’ in Nadja Marie Alexander (eds), *Global Trends in Mediation* (Kluwer Law International 2006) 288.

³⁴ Oyeniyi Ajigboye, ‘The Concept of Multi-Door Courthouse in Nigeria: Rethinking Frank Sander’s Concept’ (Social Science Research Network, November 16, 2014) https://www.researchgate.net/profile/Ajigboye_Oyeniyi/publication/268333752_The_Concept_of_Multi-Door_Courthouse_in_Nigeria_Rethinking_Frank_Sander's_Concept/links/54691b7d0cf2397f782d6d9c/The-Concept-of-Multi-Door-Courthouse-in-Nigeria-Rethinking-Frank-Sanders-Concept accessed September 2018.

³⁵ Marvin Bay, Shoba Nair and Asanthi Mendi ‘The Integration of Alternative Dispute Resolution Within the Subordinate Courts’ Adjudication Process’ (2004) 16 SAclJ 501.

³⁶ Anthony Wanis-St. John, ‘Implementing ADR in Transitioning States: Lessons Learned from Practice’ (2000) 5 Harv. Negotiation L. Rev. 339, 340, http://www.hnlr.org/wp-content/uploads/2012/04/IMPLEMENTING_ADR_IN_TRANSITIONING_STATES_LESSONS_LEARNED_FROM_PRACTICESEPTEMBER_2018.doc accessed September 2018.

³⁷ Andrew Phang, ‘Alternative Dispute Resolution and Regional Prosperity – A View from Singapore’ (Supreme Court of Singapore, September 25, 2014) [https://www.supremecourt.gov.sg/docs/default-source/default-document-library/media-room/china-asean-justice-forum---adr-and-regional-prosperity-\(final\)-11092014-\(phang-ja\)-highlighted.pdf](https://www.supremecourt.gov.sg/docs/default-source/default-document-library/media-room/china-asean-justice-forum---adr-and-regional-prosperity-(final)-11092014-(phang-ja)-highlighted.pdf) accessed September 2018.

³⁸ Larry Ray and Anne L Clare, ‘The Multi-Door Courthouse Idea - Building the Courthouse of the Future Today’ (1985) 1 Ohio St J on Disp Resol 7, 12.

³⁹ Scott Brown, Christine Cervenak and David Fairman, ‘Alternative Dispute Resolution Practitioners Guide’ (United States Agency for International Development, 1998) 9 <http://www.usaid.gov/sites/default/files/documents/1868/200sbe.pdf> accessed September 2018.

⁴⁰ Amber Murphy Parris, ‘Alternative Dispute Resolution: The Final Frontier of the Legal Profession’ (2013) 37 J Legal Prof 295, 302.

⁴¹ Benoit Bastard and Laura Cardia-Voneche, ‘Family Mediation in France’ (1993) 7 Int’l J L & Fam 271, 277.

⁴² Under the New York Convention, contracting states are generally obligated to recognize and enforce foreign arbitral awards on par with domestic court judgments. As of September 2018, there are 159

address the parties' interests. Unsurprisingly, ADR is widely used by major corporations as a preferred alternative to litigation for commercial disputes.⁴⁴ This preference for ADR is often reflected in commercial contracts, where clauses that require parties to submit disputes to mediation or arbitration before engaging in litigation are becoming increasingly popular.

The rise of commercial ADR has fuelled its development as a professional service industry, with institutions and practitioners competing for a slice of a growing international market.⁴⁵ ADR institutions have enjoyed significant growth in the volume and monetary value of disputes,⁴⁶ and ADR practitioners count among their ranks leading experts in diverse fields such as law, business, construction and technology.⁴⁷ ADR has evolved from being a mere alternative to litigation, to being a valuable industry in its own right.

1.3.3 General Trends and Landscape

Current developments in ADR have centered on the use of ADR in international commercial and investment disputes. Commercial disputes are progressively acquiring international dimensions due to globalization and transnational trade,⁴⁸ and bilateral investment treaties have become fertile ground for investor-state disputes.⁴⁹

contracting states. See United Nations Commission on Trade Law, 'Status – Convention on the Recognition and Enforcement of Foreign Arbitral Awards (New York, 1958)' (United Nations Commission on Trade Law) http://www.uncitral.org/uncitral/en/uncitral_texts/arbitration/NYConvention_status.html accessed September 2018.

⁴³ Arbitral awards are generally not subject to appeal or review on the merits by national courts. See Trevor Cook and Alejandro I Garcia, 'International Intellectual Property Arbitration' (Kluwer Law International 2010) 38.

⁴⁴ The 2013 International Arbitration Survey showed that arbitration was the most popular dispute resolution mechanism among participating corporations, and the 2011 Fortune 1000 Survey found that 98% of all participating corporate counsel had experience with mediation in the three years prior to the survey. See PwC and Queen Mary, University of London, 'International Arbitration Survey 2013: Corporate Choices in International Arbitration' (PwC, 2013) <http://www.pwc.com/gx/en/arbitration-dispute-resolution/assets/pwc-international-arbitration-study.pdf> accessed September 2018; Thomas J Stipanowich and J Ryan Lamare, 'Living with ADR: Evolving Perceptions and Use of Mediation, Arbitration and Conflict Management in Fortune 1000 Corporations' (2014) 19 Harv Negot L Rev 1, 41, <http://www.hnlr.org/wp-content/uploads/19HarvNegotLRev1-Stipanowich-Lamare.pdf> accessed September 2018. See also 'Pre-empting and Resolving Technology, Media and Telecoms Disputes' <https://www.pinsentmasons.com/PDF/2016/Pre-empting-and-Resolving-Technology-Media-and-Telecoms-Disputes.pdf> accessed September 2018.

⁴⁵ Andrew Phang, 'Alternative Dispute Resolution and Regional Prosperity – A View from Singapore' (Supreme Court of Singapore, September 25, 2014) [https://www.supremecourt.gov.sg/docs/default-source/default-document-library/media-room/china-asean-justice-forum---adr-and-regional-prosperity-\(final\)-11092014-\(phang-ja\)-highlighted.pdf](https://www.supremecourt.gov.sg/docs/default-source/default-document-library/media-room/china-asean-justice-forum---adr-and-regional-prosperity-(final)-11092014-(phang-ja)-highlighted.pdf) accessed September 2018.

⁴⁶ The China International Economic and Trade Arbitration Commission accepted 1060 cases in 2012, with its total disputed amount rising to 15.5 billion yuan from 3.5 billion yuan more than a year earlier. The Singapore International Arbitration Centre accepted 259 cases in 2013 with a total value of SGD 6.06 billion, which exceeded the combined total of SGD 4.93 billion for 2011 and 2012. See Yuan Jianlong, 'Working Report of 2012 and Working Plan of 2013 (Excerpt)' (China International Economic and Trade Arbitration Commission, January 21, 2013) <http://bj.cietac.org/index/aboutUs/workingReport/47846d42b359e57f001.cms> accessed September 2018; K Shanmugam, 'Speech by Minister for Law, K Shanmugam, during the Committee of Supply Debate 2014' (Ministry of Law, Singapore, March 5, 2014) <https://www.mlaw.gov.sg/news/parliamentary-speeches-and-responses/speech-by-minister-during-cos-2014.html> accessed September 2018.

⁴⁷ Singapore International Mediation Centre, 'Panels: Mediators' (Singapore International Mediation Centre, 2014) <http://simc.com.sg/mediators/> accessed September 2018; American Arbitration Association, 'Qualification Criteria of the AAA/ICDR Rosters and Panels' (American Arbitration Association, 2014).

⁴⁸ Christian Bühring-Uhle, Lars Kirchhoff and Gabriele Scherer, *ibid.* 7, 6.

⁴⁹ The Economist, 'The arbitration game' (The Economist, October 11, 2014) <http://www.economist.com/news/finance-and-economics/21623756-governments-are-souring-treaties-protect-foreign-investors-arbitration> accessed September 2018.

International ADR is well-suited for cross-border disputes because it provides a single and neutral forum for settlement; international arbitration has been particularly attractive because of its finality and general ease of international enforcement.⁵⁰ Due to the value and complexity of international commercial disputes,⁵¹ with millions and even billions of dollars at stake,⁵² international ADR has become an industry of significant importance. As a result, places such as Dubai,⁵³ Hong Kong,⁵⁴ Singapore⁵⁵ and the Republic of Korea⁵⁶ are establishing themselves as international ADR hubs by providing comprehensive ADR services and ADR-friendly legal infrastructure. With these developments, international ADR is unlikely to be a passing trend, but a serious and long-term movement.

1.4. Development of ADR in Intellectual Property Disputes

1.4.1 Early Uses and Regulations

The use of ADR for intellectual property disputes dates back to the 19th century. In Sweden, an 1834 royal ordinance mandated arbitration for oppositions to patent registrations,⁵⁷ and legal practitioners in the United Kingdom recommended arbitration for patent disputes in as early as 1855.⁵⁸ In the United States, arbitration was used in the early 20th century for claims arising from design registration,⁵⁹ as

⁵⁰ S I Strong, 'Beyond International Commercial Arbitration? The Promise of International Commercial Mediation' (2014) 45 Wash U J L & Pol'y 10, 27, https://openscholarship.wustl.edu/cgi/viewcontent.cgi?referer=https://www.google.ch/&httpsredir=1&article=1813&context=law_journal_law_policy accessed September 2018.

⁵¹ 'Mediation of Investor-State Conflicts' (2014) 127 Harv L Rev 2543, 2551.

⁵² In 2014, a USD 50 billion award was made against the Russian Federation in an investor-state arbitration; this was the largest award ever made in the history of arbitration. See Sherman & Sterling LLP, 'Historic Award in the Yukos Majority Shareholders Arbitration' (Sherman & Sterling LLP, July 28, 2014) <http://www.shearman.com/~media/Files/NewsInsights/Publications/2014/07/Historic-Award-in-the-Yukos-Majority-Shareholders-Arbitration-IA-072814.pdf> accessed September 2018.

⁵³ International Chamber of Commerce, 'New Expert Rules launch roadshow kicks off in Dubai' (International Chamber of Commerce, January 14, 2015) <http://www.iccwbo.org/News/Articles/2015/New-Expert-Rules-launch-roadshow-kicks-off-in-Dubai/> accessed September 2018.

⁵⁴ Ranajit Dam, 'The year in 2015' (Asia Legal Business, January 1, 2015) <http://www.legalbusinessonline.com/features/year-2015/67987> accessed September 2018.

⁵⁵ K Shanmugam, 'Speech by Minister for Law, K Shanmugam, during the Committee of Supply Debate 2014' (Ministry of Law, Singapore, March 5, 2014) <https://www.mlaw.gov.sg/news/parliamentary-speeches-and-responses/speech-by-minister-during-cos-2014.html> accessed September 2018.

⁵⁶ Lisa Feissner and Tom Feissner, 'Korean Dignitaries Promote Seoul as Hub of International Arbitration at 2014 Summit' (JDSupra Business Advisor, December 4, 2014) <http://www.jdsupra.com/legalnews/korean-dignitaries-promote-seoul-as-hub-38854/> accessed September 2018.

⁵⁷ John Coryton, 'A Treatise on the law of letters-patent, for the sole use of Inventions in the United Kingdom of Great Britain and Ireland: including the practice connected with the grant: to which is added a summary of the patent laws in force in the principal foreign states; with an appendix of statutes, rules, practical forms, etc.' (1855) 87 Law Libri 206.

⁵⁸ The Common Law Procedure Act 1854 permitted disputes to be referred to arbitration after trial had commenced with consent of both parties. Coryton recommended arbitration for patent infringements due to the arbitrator's expert subject matter knowledge in the area. See John Coryton, 'A treatise on the law of letters-patent, for the sole use of inventions in the United Kingdom of Great Britain and Ireland; including the practice connected with the grant: to which is added a summary of the patent laws in force in the principal foreign states; with an appendix of statutes, rules, practical forms, etc.' (1855) 87 Law Libri 196-198.

⁵⁹ In 1928, the Industrial Design of Registration Bureau established as registration system for designs. Users of the Bureau had to subscribe to arbitration agreement requiring them to submit claims or disputes arising from registration of designs to arbitration. See Irene Blunt, 'The Marketing of Ideas' (1943) 1 Arb in Action 8.

well as patent disputes in the aircraft industry.⁶⁰ However, despite these early examples, ADR was not widely used for intellectual property disputes even up to the late 20th century.⁶¹

1.4.2 The WIPO Center

Founded in 1967, WIPO is an agency of the United Nations which aims to promote the protection of intellectual property through cooperation among States.⁶² Within this larger framework, the WIPO Center was established in 1994⁶³ as a neutral, independent and non-profit dispute resolution provider.⁶⁴ It is the only international provider of specialized ADR services for intellectual property disputes, and is the leading institution in the administration of Internet domain name disputes.⁶⁵

The WIPO Center administers mediation, arbitration, expedited arbitration and expert determination procedures conducted under the WIPO Rules. As of 2018, more than 560 cases with values ranging from USD 20,000 to several hundred million USD have been administered by the WIPO Center. WIPO ADR services have been used by businesses of all sizes and research organizations from more than 60 countries.⁶⁶ Additionally, the WIPO Center collaborates with IPOs to raise awareness of the advantages offered by ADR to resolve intellectual property and technology disputes outside the courts. The WIPO Center also has assisted the establishment of joint dispute resolution procedures by IPOs, for example, in Colombia, the Philippines, Singapore, the Republic of Korea and Poland to facilitate the use of ADR processes for disputes administered by these IPOs.⁶⁷ The WIPO Center has also developed tailor-made dispute resolution procedures for specific industries,⁶⁸ and provides training programs for mediators and arbitrators. With its extensive network of intellectual property and ADR experts, and WIPO's international neutrality, the WIPO Center stands at the forefront of ADR for intellectual property disputes.⁶⁹

⁶⁰ Benjamin Kirsh, 'Patent Pools and Cross Licensing Agreements' (1938) 20 J. Pat. Off. Soc'y 733, 765.

⁶¹ Harry Goldstein, 'Patent, Trademark and Copyright Arbitration Guide' (1971) 53 J Pat Off Soc'y 224, 226; Jesse S Bennett, 'Saving Time and Money By Using Alternative Dispute Resolution For Intellectual Property Disputes – WIPO to the Rescue' (2010) 79 Revista Juridica UPR 289, 400.

⁶² Convention Establishing the World Intellectual Property Organization, Article 3
http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=283854 accessed September 2018.

⁶³ World Intellectual Property Organization Arbitration and Mediation Center, 'Alternative Dispute Resolution'
<http://www.wipo.int/amc/en/> accessed September 2018.

⁶⁴ Ignacio de Castro and Heike Wollgast, 'Review of the World Intellectual Property Organization's Arbitration and Mediation Center', in: International Commercial Arbitration Practice (2017).

⁶⁵ This service includes the WIPO-initiated Uniform Domain Name Dispute Resolution Policy (UDRP), under which the WIPO Center has processed over 41,523 cases, World Intellectual Property Organization Arbitration and Mediation Center 'Domain Name Dispute Resolution' <http://www.wipo.int/amc/en/domains/> accessed September 2018.

⁶⁶ Including Algeria, Australia, Austria, Belgium, Belize, Brazil, Canada, China, Colombia, Cyprus, Denmark, Finland, France, Germany, Greece, Hungary, India, Indonesia, Ireland, Israel, Italy, Japan, Lebanon, Malaysia, Malta, Mexico, Morocco, Netherlands, Nigeria, Norway, Panama, Philippines, Poland, Portugal, Republic of Korea, Romania, Russian Federation, Singapore, Spain, Switzerland, Trinidad and Tobago, Tunisia, Turkey, United Arab Emirates, United Kingdom and United States of America.

⁶⁷ World Intellectual Property Organization Arbitration and Mediation Center 'WIPO Alternative Dispute Resolution (ADR) for Intellectual Property Offices' <http://www.wipo.int/amc/en/center/specific-sectors/ipoffices/> accessed September 2018. See also Appendix A.3.

⁶⁸ A list of ADR services provided by the WIPO Center for specific sectors is provided in Appendix B.4 and available at 'WIPO Alternative Dispute Resolution (ADR) Services for Specific Sectors' <http://www.wipo.int/amc/en/center/specific-sectors/> accessed September 2018.

⁶⁹ World Intellectual Property Organization Arbitration and Mediation Center 'WIPO Neutrals' <http://www.wipo.int/amc/en/neutrals/> accessed September 2018.

Chapter Two: Advantages of ADR in Intellectual Property Disputes

2.1 Party Autonomy

Intellectual property disputes have distinctive characteristics: they often span multiple jurisdictions and involve highly technical matters, complex laws and sensitive information. Naturally, parties will want a dispute resolution process that can be tailored to address these distinctive characteristics. However, litigation can be a highly inflexible mechanism that is constrained by complex laws, and parties rarely have the discretion to adapt the process to their dispute.⁷⁰

In contrast, ADR gives parties the freedom to customize their dispute resolution process in a single forum.⁷¹ Parties can choose the ADR process best suited to their dispute: mediation, arbitration and expert determination are all possible options.⁷² Parties can agree to meet at a neutral location, submit to a neutral expert of their choosing, and abide by rules and procedures that they have modified to meet their needs.⁷³ Some ADR processes, such as mediation, even allow parties to craft outcomes that address their specific interests.⁷⁴ Party autonomy is the guiding principle of ADR, and is manifested in its many advantages.⁷⁵

2.2 Single Process; Jurisdictional Neutrality

As intellectual property rights are territorial in nature, they can simultaneously exist as separate pieces of property under distinct domestic laws in multiple jurisdictions, despite the operation of international treaties⁷⁶ that harmonize the subsistence or registration of intellectual property rights, such as copyright, trademarks and patents across signatory countries. The rise in cross-border trade and the international exploitation of intellectual property mean that disputes involving intellectual property are likely to impact across multiple jurisdictions.⁷⁷

In the litigation of intellectual property disputes involving multiple jurisdictions, parties might be compelled to take out separate proceedings in those jurisdictions to address or enforce intellectual property rights existing under each of them.⁷⁸ As a result, such proceedings may be potentially subject to complex conflict of laws considerations. In contrast, ADR allows multiple issues and rights arising under different jurisdictions to be addressed in a single process, such as arbitration and mediation,

⁷⁰ Veronique Bardach, 'A Proposal for the Entertainment Industry: The Use of Mediation as an Alternative to More Common Forms of Dispute Resolution' (1993) 13 Loy LA Ent LJ 477, 479, <http://digitalcommons.lmu.edu/cgi/viewcontent.cgi?article=1264&context=elr> accessed September 2018.

⁷¹ Ignacio de Castro and Panagiotis Chalkias, 'Mediation and arbitration of intellectual property and technology disputes: The operation of the WIPO Arbitration and Mediation Center' (2012) 24 SAclJ 1059, 1073.

⁷² Ignacio de Castro and Panagiotis Chalkias, *ibid.* 71, 1061.

⁷³ Trevor Cook and Alejandro I Garcia, *ibid.* 43, 27.

⁷⁴ David Allen Bernstein, 'A Case for Mediating Trademark Disputes in the Age of Expanding Brands' (2005) 7 Cardozo J Conflict Resol 139, 159 – 160, <http://cardozoicr.com/vol7no1/CAC102.pdf> accessed September 2018.

⁷⁵ Trevor Cook and Alejandro I Garcia, *ibid.* 43, 27; Alan Redfern, M Hunter et. al., *ibid.* 11, para 6 – 03.

⁷⁶ World Intellectual Property Organization Arbitration and Mediation Center 'WIPO-Administered Treaties' <http://www.wipo.int/treaties/en/> accessed September 2018.

⁷⁷ Julia A Martin, 'Arbitrating in the Alps Rather Than Litigating in Los Angeles: The Advantages of International Intellectual Property-Specific Alternative Dispute Resolution' (1997) 49 Stan L Rev 917, 930.

⁷⁸ *Voda v Cordis Corporation*, No. 05-1238 (Fed. Cir., Feb. 1, 2007).

which leads to a binding award or settlement.⁷⁹ ADR is also useful when multiple court actions are litigated in the same country.⁸⁰

Parties in cross-border disputes also value jurisdictional neutrality; neither is likely to want the dispute tried in the opposing party's country.⁸¹ ADR processes enable such jurisdictional neutrality over domestic courts because they provide a neutral forum for dispute resolution. Parties can choose an ADR neutral who is not based in the same jurisdiction as the parties, use neutral law to govern the dispute, and agree on a neutral location.⁸² ADR rules, such as those established by the WIPO Center, are also neutral to the law, language and culture of the parties.⁸³ Jurisdictional neutrality gives ADR processes a clear advantage over litigation for cross-border intellectual property disputes.

2.3 Independent Specialized Expertise

Intellectual property disputes can involve highly technical scientific matters and complex legal issues,⁸⁴ but not every country has specialized intellectual property courts or judges.⁸⁵ Thus, when judges and juries lack the necessary expertise to fully comprehend the complex factual, technical and legal issues at stake, considerable time and resources may be required to present the relevant technologies and laws to them.⁸⁶

ADR processes allow parties to choose a neutral with specialized expertise to act as a decision-maker, or a facilitator.⁸⁷ Experts in law, technology or specific industries can be appointed as neutrals; parties also have the ability to appoint a panel of experts with expertise in different areas of the dispute. Expert neutrals can use their knowledge and experience to provide guidance during the ADR process, and to craft a satisfying resolution for the dispute. When capable experts are appointed, ADR processes offer benefits that would be otherwise unavailable through litigation.⁸⁸

2.4 Simplicity; Flexibility

ADR processes are procedurally simple and flexible when compared to litigation. ADR gives parties the freedom to agree on the conduct of the proceedings, and select appropriate procedural rules.⁸⁹ For example, parties can place limits on the amount of survey evidence admitted for trademark disputes,⁹⁰ and even choose the extent to which certain rules of evidence are to apply, if at all.⁹¹

⁷⁹ Susan Corbett, 'Mediation of Intellectual Property Disputes: A Critical Analysis' (2011) 17 *New Zealand Business Law Quarterly* 51, 63.

⁸⁰ Susan Blake, Julie Browne and Stuart Sime, 'A Practical Approach to Alternative Dispute Resolution' (Oxford University Press 2012) 18.76.

⁸¹ Trevor Cook and Alejandro I Garcia, *ibid.* 43, 27.

⁸² Trevor Cook and Alejandro I Garcia, *ibid.* 43, 29.

⁸³ Julia A Martin, *ibid.* 77, 932.

⁸⁴ David Allen Bernstein, *ibid.* 74, 154–155.

⁸⁵ The International Intellectual Property Institute and the United States Patent and Trademark Office, 'Study on Specialized Intellectual Property Courts' (International Intellectual Property Institute, January 25, 2012) <http://iipi.org/wp-content/uploads/2012/05/Study-on-Specialized-IPR-Courts.pdf> accessed September 2018.

⁸⁶ Sarah Tran, 'Experienced Intellectual Property Mediators; Increasingly Attractive in Times of "Patent" Unpredictability' (2008) 13 *Harv Negotiation L Rev* 314, 316.

⁸⁷ Trevor Cook and Alejandro I Garcia, *ibid.* 43, 30.

⁸⁸ Trevor Cook and Alejandro I Garcia, *ibid.* 43, 30.

⁸⁹ Trevor Cook and Alejandro I Garcia, *ibid.* 43, 30 – 31.

⁹⁰ David Allen Bernstein, *ibid.* 74, 156.

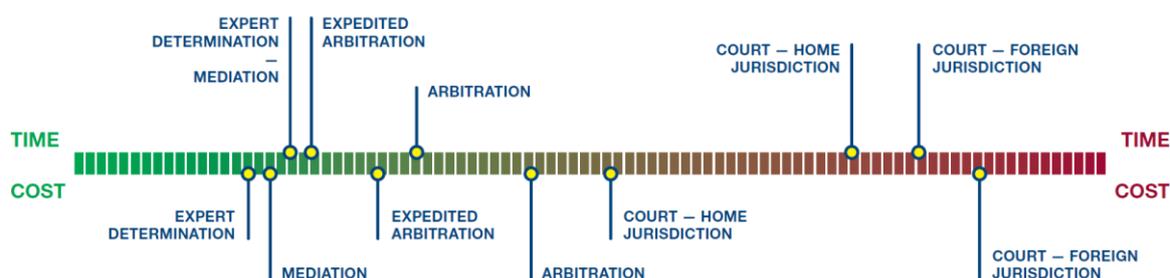
⁹¹ Scott H Blackman and Rebecca M McNeill, 'Alternative Dispute Resolution in Commercial Intellectual Property Disputes' (1998) 47 *Am U L Rev* 1709, 1713.

Furthermore, ADR processes can provide a straightforward mechanism for resolving legally complex intellectual property disputes. For example, mediation focuses on the parties' motivations and interests, not necessarily their strict legal positions. This helps the parties concentrate on their shared interests instead of legal rights and wrongs, which facilitates the creation of a satisfying settlement.⁹² While this approach does not eliminate the legal complexities of the dispute, a mediator with the relevant legal and/or subject matter expertise and experience can provide appropriate assistance and support.

2.5 Time Savings

Legal proceedings are often time-consuming, which can have an adverse effect on intellectual property rights. Intellectual property rights of limited duration, such as patents, may expire before a final judgment can be rendered. In any case, market forces affect the profitable lifespans of intellectual property rights: patented products can be rapidly rendered obsolete, and trademarks can be time-sensitive if they represent products with short life cycles.⁹³

The many advantages of ADR translate into substantial time savings. ADR allows parties to avoid overloaded courts and duplicative litigation at home, and in other jurisdictions. Expert neutrals do not require time-consuming explanations of the technical and legal issues at stake,⁹⁴ and the stated flexibility and simplicity allow disputes to be swiftly resolved, especially when lengthy evidential procedures are simplified.⁹⁵



*Relative Use of Court Litigation, (Expedited) Arbitration, Mediation, Expert Determination*⁹⁶

2.6 Cost Savings

Intellectual property litigation can be an expensive affair, especially if appeals and foreign litigation are involved. The prohibitive cost of legal proceedings in some jurisdictions can make it difficult for individuals or small businesses to enforce their rights, or defend themselves in intellectual property claims by or against larger entities.

<http://digitalcommons.wcl.american.edu/cgi/viewcontent.cgi?article=1415&context=aulr> accessed September 2018.

⁹² Mary Vitoria, 'Mediation of Intellectual Property Disputes' (2006) 1 JIPLP, 398.

⁹³ Julia A Martin, *ibid.* 77, 928.

⁹⁴ Julia A Martin, *ibid.* 77, 925 – 927.

⁹⁵ David Allen Bernstein, *ibid.* 74, 156.

⁹⁶ World Intellectual Property Organization Arbitration and Mediation Center 'Results of the WIPO Arbitration and Mediation Center International Survey on Dispute Resolution in Technology Transactions' (March 2013) <http://www.wipo.int/export/sites/www/amc/en/docs/surveyresults.pdf> accessed September 2018.

In comparison to litigation, ADR offers an affordable and accessible avenue for parties to resolve their disputes. The many advantages of ADR provide significant cost savings, because parties can avoid expensive litigation at home and abroad, use expert neutrals who can delve straight into complex intellectual property issues, and dispense with complicated and formalistic procedures. The time savings provided by ADR naturally translate into cost savings as well.⁹⁷

2.7 Confidentiality

Confidentiality is often of critical importance in intellectual property disputes. Thus, parties may balk at court proceedings when trade secrets or proprietary information, such as experimental results from research and development, are involved.⁹⁸ Litigation and the discovery process can force the public disclosure of such sensitive information,⁹⁹ which can irreversibly damage the parties' business prospects.¹⁰⁰

Confidentiality is a key advantage of ADR because it allows the parties to effectively control disclosures and access to sensitive information.¹⁰¹ Proprietary information can be kept confidential through agreements between the parties,¹⁰² and arbitrators can issue protective orders to prevent parties from accessing confidential documents.¹⁰³ Furthermore, unlike litigation, the entire ADR process and its outcome can be kept confidential, which can be advantageous for parties who wish to preserve their business reputations and relationships.¹⁰⁴

2.8 Finality

Generally, ADR processes can deliver binding outcomes that provide a certain and conclusive resolution to the dispute. This finality is a clear advantage for ADR, as the complexities of intellectual property litigation can make outcomes uncertain. Legal judgments can be overturned on appeal,¹⁰⁵ and lay jurors that lack technical expertise may make incorrect decisions.¹⁰⁶

In contrast, arbitral awards are designed to be final and conclusive, and those appeals that are filed are rarely successful. Courts are generally reluctant to hear appeals or judicial reviews on the merits of arbitral awards because this would subvert the parties' original intention to avoid court litigation.¹⁰⁷ When applied to intellectual property disputes, the finality of arbitration gives parties a conclusive decision on the validity and extent of their intellectual property rights.¹⁰⁸

Other ADR processes can benefit from the finality of arbitral awards. For example, mediation settlements are usually contractual arrangements that can be subject to future litigation. To avoid such

⁹⁷ Jesse S Bennett, *ibid.* 61, 396 – 398.

⁹⁸ Jesse S Bennett, *ibid.* 61, 396.

⁹⁹ Jennifer Mills 'Alternative Dispute Resolution in International Intellectual Property Disputes' (1996) 11 *Ohio St J on Disp Resol* 227, 231.

¹⁰⁰ Susan Corbett, *ibid.* 79, 62.

¹⁰¹ Trevor Cook and Alejandro I Garcia, *ibid.* 43, 47.

¹⁰² Jesse S Bennett, *ibid.* 61, 396.

¹⁰³ In an expedited arbitration administered by the WIPO Center, the arbitrator issued a protective order pursuant to the WIPO Expedited Arbitration Rules to prevent the claimant from accessing certain confidential documents disclosing the respondent's business secrets. See Ignacio de Castro and Panagiotis Chalkias, *ibid.* 71, 1069 – 1070.

¹⁰⁴ Susan Corbett, *ibid.* 79, 65.

¹⁰⁵ Kevin M Lemley, *ibid.* 26, 340.

¹⁰⁶ Sarah Tran, *ibid.* 86, 316.

¹⁰⁷ Trevor Cook and Alejandro I Garcia, *ibid.* 43, 31.

¹⁰⁸ Trevor Cook and Alejandro I Garcia, *ibid.* 43, 46.

issues, parties can use a hybrid ADR process such as Med-Arb,¹⁰⁹ or appoint their mediator as an arbitrator, in order to record their mediation settlement in a consent award.¹¹⁰

2.9 Enforceability

ADR processes that provide internationally enforceable outcomes are useful for cross-border intellectual property disputes.¹¹¹ Arbitration has been particularly popular for such disputes because the New York Convention allows arbitral awards to be enforced in most countries around the world.¹¹² While the issue of arbitrability of intellectual property disputes has been the subject mainly of academic commentary, the caseload of leading arbitral institutions and the laws and court jurisprudence in many countries confirm that parties can validly submit intellectual property disputes to arbitration with effect between the parties.¹¹³

Mediation settlements, as contractual arrangements, can also bind parties from different jurisdictions.¹¹⁴

2.10 Diverse Solutions

Litigation normally offers parties a limited range of specific legal remedies. While parties can apply for monetary damages, injunctions, specific performance and other such remedies, such solutions tend to be “win-or-lose” and granted based on considerations of strict legal merits or otherwise at the court’s discretion. Parties do not have the discretion to craft their own solutions, or instruct the court to deliver its decision within specified parameters.¹¹⁵

Mediation gives parties the opportunity to negotiate win-win or other creative solutions that satisfy their interests.¹¹⁶ For example, parties can agree to share the intellectual property rights in dispute through licenses or consent to use agreements, or indeed address or determine non-intellectual property issues in the resolution of an intellectual property dispute. Such mutually beneficial outcomes allow parties to preserve existing business relationships, or forge new ones.¹¹⁷

In arbitration, the substance of the arbitral award is determined by the arbitral tribunal. However, parties can agree on the scope and limits of the arbitration. For example, parties can agree to

¹⁰⁹ See 3.5.1(i) below.

¹¹⁰ Nadja Alexander, ‘International Comparative Mediation: Legal Perspectives’ (Kluwer Law International 2009), 312.

¹¹¹ Working Group II (Arbitration and Conciliation), ‘Planned and possible future work – Part III’ (United Nations Commission on International Trade Law, June 2, 2014).

¹¹² Where courts in contracting states recognize a foreign award under the New York Convention, they frequently treat the award as a domestic court judgment. See Trevor Cook and Alejandro I Garcia, *ibid.* 43, 312.

¹¹³ Trevor Cook and Alejandro I Garcia, *ibid.* 43, 49.

¹¹⁴ The cross-border enforceability of mediation settlements has been enhanced by the European Directive 2008/52 on Certain Aspects of Mediation in Civil and Commercial Matters which requires European Union countries to ensure that it is possible for parties to request that the content of a written agreement resulting from mediation be made enforceable. See Nadja Alexander, ‘Harmonisation and Diversity in the Private International Law of Mediation: The Rhythms of Regulatory Reform’ in Klaus J Hopt and Felix Steffek, ‘Mediation: Principles and Regulation in Comparative Perspective’ (Oxford University Press 2013) 180. An equivalent of the New York Convention for mediation settlements is being developed by the United Nations Commission on International Trade Law, Working Group II (Arbitration and Conciliation) http://www.uncitral.org/uncitral/mission/working_groups/2Arbitration.html accessed September 2018.

¹¹⁵ David Allen Bernstein, *ibid.* 74, 149.

¹¹⁶ Sarah Tran, *ibid.* 86, 323.

¹¹⁷ David Allan Bernstein, *ibid.* 74, 159.

establish limits to the quantum of the award,¹¹⁸ and even specify in the arbitration agreement, a desired time frame by the arbitral tribunal to issue the arbitral award.¹¹⁹ Beyond a final award, parties can petition the arbitral tribunal for interim relief in the form of an injunction, or security for costs.¹²⁰

2.11 Specific Advantages for IPOs

ADR provides many benefits for IPOs who choose to offer or promote it as part of their services. By channeling appropriate disputes to ADR, IPOs can reduce case backlog and improve administrative efficiency.¹²¹ Additionally, the promotion of ADR processes will place IPOs in a better position to cater to small businesses or individuals who may not have the resources to litigate or defend intellectual property claims. This can encourage inventors and innovators to seek legal recognition for their creations, which will help to promote the creation of intellectual property.¹²² As ADR processes are also particularly useful for cross-border disputes, they can help IPOs provide stronger support for international businesses, which will facilitate the international exploitation of intellectual property rights.

Thus, by providing and promoting ADR options for intellectual property disputes, the ability of IPOs to create a conducive environment for the creation, protection and exploitation of intellectual property rights will be enhanced. Such ADR services can help IPOs create a business- and innovation-friendly intellectual property infrastructure, and thereby enable them to provide holistic intellectual property-related services.

¹¹⁸ This is a form of arbitration known as “high-low” or “bracketed” arbitration. It is commonly used when only the quantum of compensation, and not liability, is an issue. If the award falls within the agreed range, the parties are bound by the award. If the award is lower than the agreed minimum amount, then the defendant will pay the agreed minimum, and if the award is higher than the agreed maximum, the defendant will only pay the agreed maximum. The arbitral tribunal will conduct the arbitration without knowing the limits of the agreed range. See John W Cooley and Steven Lubet, ‘Arbitration Advocacy’ (National Institute for Trial Advocacy 2003) 250.

¹¹⁹ Julia A Martin, *ibid.* 77, 928; but see Alan Redfern, M Hunter et. al., *ibid.* 11, para 8-68.

¹²⁰ It should be noted that whether the parties should submit an application for interim relief to the arbitral tribunal or a competent judicial authority will depend on the nature of the dispute. The WIPO Arbitration and Expedited Arbitration Rules allow the arbitral tribunal to issue a wide range of interim measures, including injunctions in cases of unfair competition, or in connection with alleged infringements of intellectual property rights. See Ignacio de Castro and Panagiotis Chalkias, *ibid.* 71, 1071.

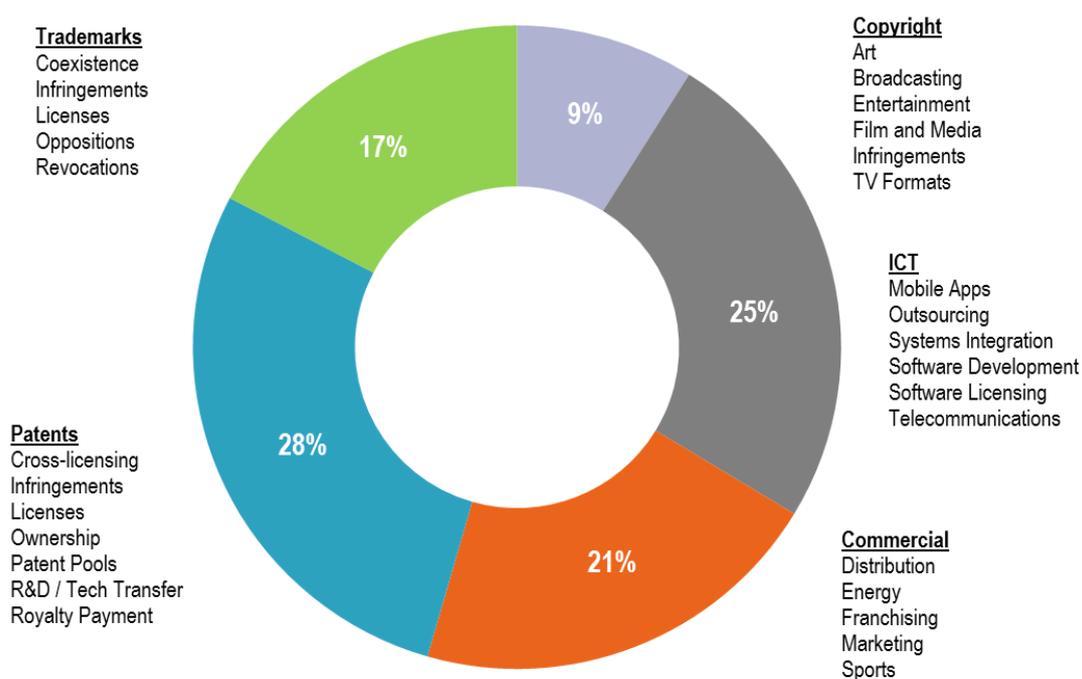
¹²¹ Intellectual Property Office of Singapore ‘Building an IP Hub of Asia: IPOS Annual Report 2011/12’ <https://www.ipos.gov.sg/docs/default-source/about-ipos-doc/annual-reports/ipos-ar-2011-2012.pdf> accessed September 2018.

¹²² Thomas D. Barton and James M. Cooper, ‘Resolving Intellectual Property Problems Through Alternative Dispute Resolution’ (WIPO, March 2014) http://www.wipo.int/edocs/mdocs/mdocs/en/wipo_ace_9/wipo_ace_9_9.docx accessed September 2018, 10.

Chapter Three: ADR Procedures Used in Intellectual Property Disputes

3.1 General Trends and Landscape

ADR is becoming an increasingly popular option for the resolution of intellectual property disputes. For example, the WIPO Center, which provides support services for ADR proceedings such as mediation, expert determination, arbitration and expedited arbitration, has seen an increase in recent years in the number of intellectual property disputes it has administered. Such disputes spanned a diverse range of legal areas and industries, as illustrated by the following sample charts on WIPO Center mediation and arbitration cases.¹²³



Dispute Areas in WIPO ADR Cases as of April 2018

Certain IPOs also offer services in relation to ADR proceedings before them, sometimes in conjunction with the WIPO Center. Mediation appears to be the most commonly offered ADR service at IPOs, especially in relation to trademark and copyright proceedings; such services are provided for example by IPOs in Colombia,¹²⁴ the Philippines,¹²⁵ Singapore¹²⁶ and the Republic of Korea.¹²⁷ Although arbitration and expert determination services are less frequently offered by IPOs, they nevertheless feature significantly in the landscape of dispute resolution options for intellectual property disputes.

¹²³ World Intellectual Property Organization Arbitration and Mediation Center, 'WIPO Caseload Summary' <http://www.wipo.int/amc/en/center/caseload.html> accessed September 2018.

¹²⁴ See Appendix A.3.4.

¹²⁵ See Appendix A.3.2.

¹²⁶ See Appendix A.3.1.

¹²⁷ See Appendix A.3.5 and A.3.6.

3.2 Approaches to ADR

For all the general advantages shared by the different ADR processes, there are in fact markedly different characteristics to each of them. In particular, the level of control that the parties have over the decision-making process and the final outcome will vary significantly across processes.¹²⁸ While the different processes can be combined in escalation clauses,¹²⁹ generally, ADR processes fall into three main categories:

3.2.1 Assistance-Based

Parties have the greatest control over the decision-making process and the final outcome in an assistance-based ADR process,¹³⁰ such as mediation.

In mediation, the mediator's aim is to assist the parties in finding a solution to their dispute. The parties have complete control over the final outcome, and a substantial say in the mediation process. Assistance-based processes are useful when the parties wish to create an outcome that is tailored to their interests.¹³¹

3.2.2 Recommendation-Based

Relative to mediation, a recommendation-based ADR process gives parties less control over the decision-making process and the final outcome.¹³² Non-binding expert determination is an example of a recommendation-based process.

In expert determination, parties submit a specific issue to an expert, who makes a determination on the matters submitted. The parties can agree to accept the neutral's determination as a non-binding recommendation, or as a final and binding decision.¹³³ Recommendation-based processes are useful for issues such as the determination of royalty amounts, valuation of intellectual property assets and the interpretation of patent claims.¹³⁴

3.2.3 Adjudication-Based

In an adjudication-based ADR process, such as arbitration, parties have a limited degree of control over the decision-making process and the final outcome.¹³⁵

As a point for comparison, parties in litigation (being also adjudication-based) have little to no say in the decision-making process and the final outcome, both of which are determined by the court. In arbitration, even though parties may have some say in the decision-making process, such as in

¹²⁸ Karl Mackie and others, 'Alternative Dispute Resolution Guidelines' (The World Bank Group, 2011) http://siteresources.worldbank.org/INTECA/Resources/15322_ADRG_Web.pdf accessed September 2018.

¹²⁹ World Intellectual Property Organization Arbitration and Mediation Center, 'Recommended WIPO Contract Clauses and Submission Agreements' <http://www.wipo.int/amc/en/clauses/index.html> accessed September 2018.

¹³⁰ Jack Effron, 'Alternatives to Litigation: Factors in Choosing' (1980) 52 Mod L Rev 480, 482.

¹³¹ David Allen Bernstein, *ibid.* 74, 159.

¹³² Jack Effron, *ibid.* 129, 482.

¹³³ World Intellectual Property Organization Arbitration and Mediation Center, 'What is Expert Determination?' <http://www.wipo.int/amc/en/expert-determination/what-is-exp.html> accessed September 2018.

¹³⁴ Naresh Mahtani, 'Using Expert Determination to Resolve Disputes: An Introduction' in the IPOS and the WIPO Arbitration and Mediation Center, WIPO-IPOS Workshop on Expert Determination for IP and IT Disputes (2014) 28.

¹³⁵ Karl Mackie and others, *ibid.* 127.

relation to the scope of the dispute submitted to arbitration or procedural matters, they must accept the final decision made by the arbitral tribunal.¹³⁶ Adjudication-based processes are useful when there is a need for a final decision, and the parties are unwilling or unable to negotiate a settlement.¹³⁷

3.3 Mediation

3.3.1 Introduction

Mediation is a process where disputants ask a third party neutral – the mediator – to assist them in negotiating a mutually beneficial solution for their dispute.¹³⁸ Mediators aim to help the parties by guiding them towards a shared understanding of their interests and the nature of their dispute.¹³⁹ Mediation is a voluntary process, and mediators do not have the power to impose a binding outcome on the parties.¹⁴⁰

Mediation is especially appropriate for disputes where the parties can benefit from sharing the intellectual property rights in contention,¹⁴¹ and wish to preserve existing business relationships.¹⁴²

Conciliation can be considered as a variation of mediation, although the understanding of conciliation may vary from country to country. For example, in Japan, “conciliation” is generally used in relation to court-connected mediation,¹⁴³ whilst for example in Ireland, the terms “conciliation” and “mediation” are used interchangeably.¹⁴⁴ Nevertheless, conciliation is often used to refer to a process whereby a third party plays a stronger leadership role and exerts a greater influence over the final outcome.¹⁴⁵

3.3.2 Mediation Agreement

As mediation is a process founded upon party self-determination,¹⁴⁶ there must be an underlying agreement between the parties to submit to mediation. The mediation agreement can be established in advance by an agreement to mediate future disputes under a contract,¹⁴⁷ or by an agreement to refer an existing dispute to mediation. Typically, a mediation agreement provides for the following:

- agreement to submit the stated dispute to mediation
- description of the dispute to be submitted to mediation
- location of the mediation

¹³⁶ Jack Effron, *ibid.* 129, 482.

¹³⁷ Karl Mackie and others, *ibid.* 127.

¹³⁸ Ignacio de Castro and Panagiotis Chalkias, *ibid.* 71, 1061.

¹³⁹ Lon Fuller, ‘Mediation - Its Forms and Functions’ (1971) 44 S Cal L Rev 305, 325.

¹⁴⁰ Susan Corbett, *ibid.* 79, 57 – 58.

¹⁴¹ Scott H Blackman and Rebecca McNeill, *ibid.* 91, 1716.

¹⁴² David Allen Bernstein, *ibid.* 74, 159

¹⁴³ The Japanese term for conciliation, “chotei” refers to the settlement of a dispute by means of a compromise reached through the intervention of a third party that promotes negotiation and agreement between the disputing parties. Harald Baum, ‘Mediation in Japan. Development, Forms and Practice of Out-of-Court Dispute Resolution’ in Klaus J Hopt and Felix Steffek, *ibid.* 114, 1033 – 1034.

¹⁴⁴ Reinhard Ellger, ‘Mediation in Ireland: Growing Importance of ADR Driven by Budgetary Restraints and Docket Congestion—A Cheap and Easy Way Out?’ in Klaus J Hopt and Felix Steffek, *ibid.* 114, 665.

¹⁴⁵ Klaus J Hopt and Felix Steffek, *ibid.* 114, 15.

¹⁴⁶ Jacqueline Nolan-Haley, ‘Mediation: The “New Arbitration”’ (2012) 17 Harv Negot L Rev 61, 68.

¹⁴⁷ World Intellectual Property Organization Arbitration and Mediation Center, ‘WIPO model mediation clauses and submission agreements’ <http://www.wipo.int/amc/en/clauses/index.html> accessed September 2018.

- language to be used in the mediation
- mediation rules applicable to the terms and process of the mediation

To facilitate submission of a dispute to mediation in the absence of a mediation agreement between the parties, the WIPO Center offers the option for a party to submit a unilateral Request for Mediation to the WIPO Center.¹⁴⁸ The WIPO Center may then assist the parties to consider the Request or, upon request, may appoint an external neutral to provide the required assistance. The process been used successfully by parties in a number of WIPO cases, notably in infringement disputes or in cases pending before the courts.

Mediation rules typically address the following issues:¹⁴⁹

- manner of appointment of the mediator¹⁵⁰
- role of the mediator¹⁵¹
- conduct of the mediation session(s),¹⁵² including matters such as the opportunity for submission of information and materials by the parties for use in the mediation
- confidentiality, especially with regards to the existence of the mediation, any information disclosed during the mediation and the outcome of the mediation¹⁵³
- grounds on which the mediation may be terminated¹⁵⁴
- fees payable to the mediator and the ADR institution/service provider (if applicable)¹⁵⁵
- exclusion of liability of the mediator, and ADR institution/service provider (if applicable)¹⁵⁶

ADR institutions will normally provide rules for mediation cases that they administer, and parties can amend these rules to address particular aspects of their disputes. Some ADR institutions, such as the WIPO Center, also have in place mediation rules that are designed for particular types of disputes, or disputes arising from specific industries.

3.3.3 Appointment and Role of Mediator

Parties will also need to select and appoint a mediator who is impartial and independent.¹⁵⁷ In an appropriate case and if parties desire, it is possible to appoint two or more co-mediators. For intellectual property disputes, parties may prefer to appoint a mediator who has the appropriate experience and expertise to handle the legal and technical issues involved. ADR institutions can help in the selection and appointment of a mediator by making available information on their panel of

¹⁴⁸ Article 4 of the WIPO Mediation Rules. See also model form in Appendix B.3.2.

¹⁴⁹ Such issues are addressed in the WIPO Mediation Rules <http://www.wipo.int/amc/en/mediation/rules> accessed September 2018.

¹⁵⁰ Articles 7 - 8, WIPO Mediation Rules.

¹⁵¹ Article 14, WIPO Mediation Rules.

¹⁵² Articles 10 - 13, WIPO Mediation Rules.

¹⁵³ Provisions on confidentiality can also be included in the agreement to mediate. The agreement can also specify that communications made between the parties will be on a 'without prejudice' basis such that parties cannot rely on these communications to prove any facts in subsequent litigation or arbitration proceedings. Articles 15 - 16 of the WIPO Mediation Rules also contain provisions on confidentiality.

¹⁵⁴ Articles 19 - 21, WIPO Mediation Rules.

¹⁵⁵ Articles 22 - 23, WIPO Mediation Rules.

¹⁵⁶ Articles 26 - 27, WIPO Mediation Rules.

¹⁵⁷ Article 8 of the WIPO Mediation Rules states that a mediator must be neutral, impartial and independent.

mediators whom parties can consider.¹⁵⁸ Alternatively, the parties can appoint a mediator of their own choice.¹⁵⁹

The mediator's role is to assist the parties to negotiate a resolution of their dispute, and to manage the mediation process. Every mediator should strive to:

- be impartial, fair and credible
- build trust between the parties and with the mediator
- provide a safe environment for the parties to conduct discussions
- facilitate communication and prevent or address misunderstandings between the parties
- engage the parties in problem solving
- adhere to the rules of the mediation and respect confidentiality

3.3.4 Conduct of Mediation

Following his appointment, the mediator may contact the parties to discuss any preliminary matters, such as the schedule of the mediation and the documents that are to be produced, including a statement from each party setting out his perspective of the dispute. These can help the mediator to gain a better understanding of the case, and prepare for the mediation.

At the beginning of the mediation, the mediator will usually introduce himself and explain the mediation process. The mediator and the parties may then proceed to establish the ground rules for the mediation and indicate that the mediator can meet privately with each party in caucuses.

A key point to establish is that the individuals attending the mediation have full authority to offer or accept any settlement on behalf of the disputing parties respectively. If this is not possible, then the individuals should ensure that they will be able to communicate with the person who has such authority during the mediation.

Depending on the size and complexity of the dispute, the mediation may be completed in a single day, or involve multiple sessions. Generally, a mediation proceeding will involve the following stages:¹⁶⁰

Gathering information – each party tells his side of the story and presents any prepared statement on this

Identifying issues – the mediator helps the parties to identify the issue(s) in dispute

Exploring interests – the mediator and parties explore the underlying reasons for the respective positions taken by the parties, and their interests in the dispute

Developing options – the mediators and parties develop options that satisfy the parties' interests and address the issue(s) in dispute

Evaluating options – parties identify possible areas of agreement by evaluating their options based on objective criteria

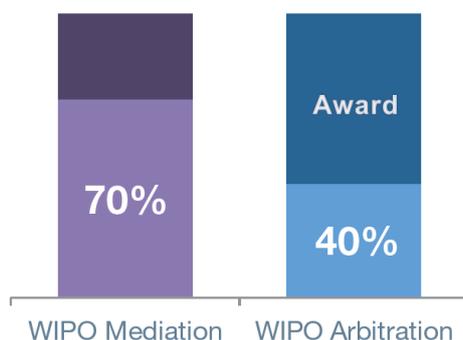
Reaching settlement – if the parties are able to agree on a settlement, it can be recorded in an agreement during the mediation

¹⁵⁸ Allan J Stitt, *Mediation: A Practical Guide* (Cavendish Publishing Limited 2004) 40.

¹⁵⁹ Article 7(a), WIPO Mediation Rules.

¹⁶⁰ World Intellectual Property Organization Arbitration and Mediation Center 'Mediation: Frequently Asked Questions' <http://www.wipo.int/amc/en/mediation/guide/index.html> accessed September 2018.

Generally, the majority of mediations result in a settlement. However, even when the parties are unable to settle, mediation can help them gain a better understanding of the dispute, and narrow down the issues in contention.



Settlement Rate in WIPO Mediations and Arbitrations as of April 2018

3.3.5 Enforcement of Mediation Settlement

Typically, a mediation settlement takes the form of a legally binding agreement, so that its enforcement would effectively be the enforcement of the contractual obligations of the parties, and a breach of such obligations may well be further litigated. That said, it should be noted that parties are generally willing to uphold their settlement obligations because they believe that the agreement accords with their interests.¹⁶¹

Under the laws of some jurisdictions, mediation settlements can be enforced as court judgments, which provide a further measure of finality.¹⁶²

3.3.6 Administration of Mediation

Mediation proceedings that are not administered by any institution are considered *ad hoc* mediation. In such cases, the parties will have to determine the terms of the agreement to mediate, the rules that will apply and the selection of the mediator on their own. This can prove to be a trying task, especially if the parties do not have sufficient experience with mediation.¹⁶³

In comparison, institutionalized mediation can be useful for parties who want a convenient, secure and administratively efficient avenue to engage in mediation.¹⁶⁴ ADR institutions will generally provide a sample agreement to mediate for the parties, a set of mediation rules and assistance in selecting an appropriate mediator.

The WIPO Center is an attractive option for parties involved in intellectual property disputes as it provides administrative assistance and procedural rules that are tailored for such disputes. In

¹⁶¹ Klaus J Hopt and Felix Steffek, *ibid.* 114, 45.

¹⁶² Klaus J Hopt and Felix Steffek, *ibid.* 114, 45 – 46.

¹⁶³ American Arbitration Association, 'AAA Handbook on International Arbitration and ADR' (2nd edn, American Arbitration Association 2010) 221 – 222.

¹⁶⁴ Christian Bühring-Uhle, Lars Kirchhoff and Gabriele Scherer, *ibid.* 7, 36.

particular, the WIPO Center offers and is able to provide the following general services in relation to ADR proceedings that it administers, including mediation cases:¹⁶⁵

- assistance in the selection of neutrals from its pool of over 1,500 experts with experience in intellectual property disputes
- liaising between parties and neutrals to ensure optimal communication and procedural efficiency
- administration of the financial aspects of the proceedings, including fixing the fees of the neutrals in consultation with parties and neutrals
- case management services and access to the WIPO Electronic Case Facility (WIPO ECAF), which allows parties and all other actors in a case administered by the WIPO Center to view the status of such case, electronically submit case communications, and access the parties' contact information through an online docket system; WIPO ECAF is mostly used in arbitrations involving multiple documentary exchanges¹⁶⁶
- provision of free meeting rooms where the proceedings take place in Geneva, and logistical services where proceedings take place elsewhere
- other support services that may be needed, including in relation to translation, interpretation or secretarial services
- guidance on the application of the WIPO Mediation, Expert Determination, Arbitration and Expedited Arbitration Rules

Parties who elect to submit their disputes to the WIPO Center for mediation can choose to adopt the WIPO Mediation Rules¹⁶⁷ which are designed to maximize the parties' control over the mediation process, and can be adapted by the parties to address the specific needs of their dispute. The WIPO Mediation Rules are specifically designed for intellectual property, technology and related commercial disputes,¹⁶⁸ and contain confidentiality provisions to protect sensitive information that may be disclosed during the mediation.¹⁶⁹

The fees charged for a mediation case administered by the WIPO Center are determined on a not-for-profit basis, and in consultation with the parties and the mediator.¹⁷⁰ The WIPO Mediation Rules provide that the fees for the mediation will be equally borne by the parties unless they agree otherwise.¹⁷¹

¹⁶⁵ World Intellectual Property Organization Arbitration and Mediation 'Center Role of the Center' <http://www.wipo.int/amc/en/center/role.html> accessed September 2018.

¹⁶⁶ World Intellectual Property Organization Arbitration and Mediation Center, 'WIPO Online Case Administration Tools' <http://www.wipo.int/amc/en/ecaf/> accessed September 2018.

¹⁶⁷ World Intellectual Property Organization Arbitration and Mediation Center, 'WIPO Mediation Rules' <http://www.wipo.int/amc/en/mediation/rules> accessed September 2018.

¹⁶⁸ World Intellectual Property Organization Arbitration and Mediation Center, 'WIPO Arbitration and Mediation Center' <http://www.wipo.int/amc/en/center/background.html> accessed September 2018.

¹⁶⁹ Articles 15 - 18, WIPO Mediation Rules.

¹⁷⁰ Information on the fees payable for mediations administered at the WIPO Center can be found at the World Intellectual Property Organization Arbitration and Mediation Center 'Schedule of Fees and Costs' <http://www.wipo.int/amc/en/mediation/fees/> accessed September 2018.

¹⁷¹ Article 25, WIPO Mediation Rules.

3.3.7 Mode of Submission to Mediation

(i) *Voluntary vs. Mandatory*

In voluntary mediation, mediation is initiated by the parties of their own free will. This voluntary nature is fundamental to the mediation process, and operates from the moment that the parties agree to submit their dispute to mediation until the parties decide whether they wish to resolve their dispute. As such, mandatory mediation, which compels the parties to engage in mediation by law, by the courts,¹⁷² or by other inherent processes and procedures that they may be already subject to,¹⁷³ may be perceived as somewhat controversial in light of the voluntary nature of mediation.¹⁷⁴

However, there are compelling reasons for governments and courts to institute mandatory mediation programs. A 2014 study of mediations in the European Union found that only mandatory mediation programs could generate a significant number of mediation cases, and that mandatory mediation also encouraged the growth of voluntary mediation.¹⁷⁵

(ii) *Court-Connected*

Court-connected mediation programs generally come in two forms: judicial or court-annexed. In judicial mediation, disputes are mediated by settlement judges, and judicially mediated settlements are generally enforceable as court orders.¹⁷⁶ In contrast, court-annexed programs allow courts to refer disputes to external mediation institutions, and mediations will be conducted by the mediators selected through that particular institution.¹⁷⁷ For example, the WIPO Center collaborates with the Ministry of Law of Singapore in the promotion of the use of ADR options for intellectual property disputes in Singapore.¹⁷⁸ The WIPO Center makes available a model information document that courts in some countries use to inform parties of WIPO ADR options.¹⁷⁹

Court-connected mediation programs can be voluntary or mandatory. As indicated in Chapter 4.5, mandatory court-connected mediation programs can have negative cost consequences for a party refusing to participate in the mediation.

(iii) *IPO-Connected*

IPO-connected mediation programs generally allow disputes which play out in proceedings before an IPO to be referred to mediation. Mediation services can be provided by the IPO itself, or by an external institution such as the WIPO Center.

IPO-connected mediation programs can also be voluntary or mandatory. Voluntary mediation programs, such as those conducted by IPOs in Colombia,¹⁸⁰ Singapore,¹⁸¹ and the United Kingdom, allow parties to opt for mediation during proceedings before the IPO.

¹⁷² Klaus J Hopt and Felix Steffek, *ibid.* 114, 54.

¹⁷³ It should be noted that some IPOs require parties to submit to mandatory mediation for particular types of disputes. See Appendix A.

¹⁷⁴ Jacqueline Nolan-Haley, *ibid.* 145, 69.

¹⁷⁵ Giuseppe De Palo and others, 'Rebooting' the Mediation Directive: Assessing the Limited Impact of its Implementation and Proposing Measures to Increase the Number of Mediations in the EU' (European Parliament, January 2014) [http://www.europarl.europa.eu/RegData/etudes/etudes/join/2014/493042/IPOL-JURI_ET\(2014\)493042_EN.pdf](http://www.europarl.europa.eu/RegData/etudes/etudes/join/2014/493042/IPOL-JURI_ET(2014)493042_EN.pdf) accessed September 2018, 8 – 9.

¹⁷⁶ Nadja Alexander, *ibid.* 110, 135.

¹⁷⁷ Klaus J Hopt and Felix Steffek, *ibid.* 114, 20.

¹⁷⁸ See Appendix A.1. The Ministry of Law has designated the WIPO Center as mediation service provider in Singapore <https://www.mlaw.gov.sg/content/minlaw/en/news/press-releases/mediation-act-to-commence-from-1-november-2017.html> accessed September 2018.

¹⁷⁹ See Appendix C.

¹⁸⁰ See Appendix A.3.4.

In mandatory mediation programs, disputes will be referred by the IPO to mediation if they satisfy specific criteria.¹⁸²

3.4 Expert Determination

3.4.1 Introduction

Expert determination is a procedure in which a technical, scientific or related business issue between the parties is submitted to one or more experts who make(s) a decision on the matter. The expert's decision will be binding on the parties unless they agree otherwise. Expert determination is suitable for disputes which involve technical issues, such as the valuation of intellectual property assets, the interpretation of patent claims and the extent of rights that are covered by a license.¹⁸³ Expert determination can be used as part of mediation and arbitration, and has been especially useful in complex arbitrations.¹⁸⁴

Early neutral evaluation can be said to be a form of expert determination, which is designed to facilitate negotiations between the parties at an early stage. In this process, parties will submit their dispute to the expert, for an assessment of the likely outcome and cost should the dispute proceed to court. The expert's non-binding assessment of their case may stimulate the parties to proceed with negotiations to settle the dispute.¹⁸⁵

3.4.2 Expert Determination Agreement

Like mediation, parties can agree to refer their dispute to expert determination either by providing for this in a contract in advance of any dispute having arisen,¹⁸⁶ or by entering into an agreement to refer a dispute which has arisen to expert determination. The expert determination clause or the expert determination agreement typically addresses the following:

- agreement to submit the stated dispute to expert determination
- description of the dispute to be referred to expert determination
- language to be used in the expert determination
- whether the expert's determination is binding on the parties

Parties will also need to agree on the rules of the expert determination, especially with regards to these matters:¹⁸⁷

- manner of appointment of the expert¹⁸⁸

¹⁸¹ See Appendix A.3.1.

¹⁸² See mediation scheme of the Intellectual Property Office of the Philippines (IPOPPL), Appendix A.3.2. See also World Intellectual Property Organization Arbitration and Mediation Center 'WIPO Mediation Proceedings Instituted in the Intellectual Property Office of the Philippines (IPOPPL)' <http://www.wipo.int/amc/en/center/specific-sectors/ipophl/> accessed September 2018.

¹⁸³ World Intellectual Property Organization Arbitration and Mediation Center, 'Expert Determination' <http://www.wipo.int/amc/en/expert-determination/> accessed September 2018.

¹⁸⁴ Ignacio de Castro and Panagiotis Chalkias, *ibid.* 71, 1062.

¹⁸⁵ Susan Blake, Julie Browne and Stuart Sime, *ibid.* 80, 24.02.

¹⁸⁶ The WIPO Center provides model expert determination clauses and submission agreements, see Appendix B.3.

¹⁸⁷ These issues are addressed in the WIPO Expert Determination Rules, available at <http://www.wipo.int/amc/en/expert-determination/rules> accessed September 2018.

¹⁸⁸ Article 9, WIPO Expert Determination Rules.

- conduct of the expert determination, such as in relation to the inspection of sites, properties, products or processes by the expert¹⁸⁹
- consequences for parties who fail to comply with such rules¹⁹⁰
- confidentiality, especially with regards to the existence of the expert determination, any information disclosed during the expert determination and the outcome of the expert determination¹⁹¹
- grounds on which the expert determination may be terminated¹⁹²
- fees payable to the expert, and the ADR institution/service provider (if applicable)¹⁹³
- exclusion of liability of the expert, and ADR institution/service provider (if applicable)¹⁹⁴

3.4.3 Appointment and Role of Expert

The ideal expert is one who is impartial and has the necessary legal, technical or subject-matter expertise. ADR institutions such as the WIPO Center and professional bodies can help parties select a suitable expert if the parties are unable to agree on one.

The role of the expert is fairly straightforward – he is to use his specific expertise to render a determination on the issue(s) submitted to him by considering the information and materials submitted to him by the parties.¹⁹⁵

3.4.4 Conduct of Expert Determination

Depending on the terms agreed by the parties in referring their dispute to expert determination:

- parties will appoint an appropriate expert and submit the relevant information to the expert for determination
- parties may arrange for a meeting before the expert to present their cases

The expert will then proceed to make a determination on the dispute, which the parties can agree in advance to be binding as a final decision, or otherwise.¹⁹⁶ Pursuant to Article 17(f) of the WIPO Expert Determination Rules, the determination shall be binding unless the parties have agreed otherwise.

3.4.5 Administration of Expert Determination

Parties can choose to conduct expert determinations on an *ad hoc* basis without any assistance from an ADR institution. However, parties with little experience with expert determination may find it difficult to administer the proceedings on their own, especially if they do not have access to an appropriate expert. Thus, parties may wish to enlist the help of ADR institutions such as the WIPO Center.

The WIPO Center provides general administration services¹⁹⁷ for the expert determination proceedings that it administers, and the WIPO Expert Determination Rules contain provisions on

¹⁸⁹ Article 14, WIPO Expert Determination Rules.

¹⁹⁰ Article 15, WIPO Expert Determination Rules.

¹⁹¹ Article 16, WIPO Expert Determination Rules.

¹⁹² Article 19, WIPO Expert Determination Rules.

¹⁹³ Articles 21 – 24, WIPO Expert Determination Rules.

¹⁹⁴ Articles 25 – 26, WIPO Expert Determination Rules.

¹⁹⁵ Susan Blake, Julie Browne and Stuart Sime, *ibid.* 80, 24.04.

¹⁹⁶ Susan Blake, Julie Browne and Stuart Sime, *ibid.* 80, 24.21 – 24.27.

¹⁹⁷ See 3.3.6 above.

confidentiality that are specially tailored for intellectual property disputes.¹⁹⁸ The WIPO Center can also propose and appoint experts with the appropriate expertise from its worldwide network of intellectual property experts.¹⁹⁹

The fees charged for expert determination proceedings administered by the WIPO Center are determined on a not-for-profit basis, and in consultation with the parties and the expert.²⁰⁰ The WIPO Expert Determination Rules provide that the fees of the expert determination will be equally borne by the parties unless they agree otherwise.²⁰¹

3.4.6 Submission to Expert Determination Proceedings at IPOs

Presently, expert determination services are not commonly offered by IPOs.²⁰² However, the Intellectual Property Office of Singapore (IPOS) has offered expert determination services for all contentious patent proceedings, including patent revocation and inventorship disputes, since April 1, 2014. Under these services, parties can agree to refer such disputes to the WIPO Center for expert determination under the WIPO Expert Determination Rules.²⁰³

3.5 Arbitration

3.5.1 Introduction

Arbitration is a private system of adjudication²⁰⁴ where parties agree to refer their dispute to an arbitral tribunal of their choice, and to accept the tribunal's decision as final and binding.²⁰⁵ Arbitration is suitable where parties want a final and definitive conclusion to their dispute.²⁰⁶ In addition to standard arbitration, some institutions also offer expedited arbitration.

Expedited arbitration is an arbitration proceeding administered under rules which are designed to carry it out in a shorter time and at reduced cost. Under the WIPO Expedited Arbitration Rules, such a proceeding can be concluded in as little as five weeks. This is particularly useful when the parties urgently require a final and enforceable decision on a few issues. Expedited arbitration can also be conducted in conjunction with mediation or expert determination.

Expedited arbitration proceedings administered by the WIPO Center usually feature.²⁰⁷

- a sole arbitrator instead of a three-member arbitral tribunal, thus avoiding potentially lengthy appointment and decision-making processes
- a single exchange of pleadings with no additional written submissions

¹⁹⁸ Article 16, WIPO Expert Determination Rules.

¹⁹⁹ World Intellectual Property Organization Arbitration and Mediation Center, 'WIPO Neutrals' <http://www.wipo.int/amc/en/ neutrals/> accessed September 2018.

²⁰⁰ Information on the fees payable for expert determinations administered at the WIPO Center is available at <http://www.wipo.int/amc/en/expert-determination/fees/> accessed September 2018.

²⁰¹ Article 24, WIPO Expert Determination Rules.

²⁰² For example, the UK IPO offers a non-binding opinion concerning the infringement or validity of a patent or supplementary protection certificate. See Intellectual Property Office of the United Kingdom, 'Intellectual Property Mediation' <https://www.gov.uk/opinions-resolving-patent-disputes> accessed September 2018.

²⁰³ Details of IPOS's expert determination program are provided in Appendix A.3.1.

²⁰⁴ Margaret L Moses, *The Principles and Practice of International Commercial Arbitration* (2nd edn, Cambridge University Press 2012) 1.

²⁰⁵ Frank D Emerson, *ibid.* 19, 157.

²⁰⁶ Trevor Cook and Alejandro I Garcia, *ibid.* 43, 46.

²⁰⁷ These features are provided in the WIPO Expedited Arbitration Rules, available at <http://www.wipo.int/amc/en/arbitration/expedited-rules> accessed September 2018.

-
- closure of proceedings within three months from the appointment of the arbitrator or the delivery of the Statement of Defense, instead of the usual nine months
 - fixed fees for disputes valued below USD 10 million, which translate to lower costs

However, since the complexity of an arbitration can be difficult to predict, the WIPO Expedited Arbitration Rules allow expedited arbitration proceedings to be sufficiently flexible to permit a fuller process for complex cases.²⁰⁸

3.5.2 Arbitration Agreement

Parties may enter into an agreement to refer to arbitration, disputes between them which have arisen or may arise in the future. This may take the form of a separate agreement or an arbitration clause in a contract,²⁰⁹ and in any event, ought to provide for the following:

- parties agree to submit their dispute to arbitration
- description of the dispute
- language to be used in the arbitration
- place/seat of the arbitration
- choice of substantive law
- arbitration rules that govern the arbitration process

The New York Convention requires contracting states to comply with its provisions on the validity and enforcement of an international arbitration agreement.²¹⁰ Such Convention provisions require that unless the international arbitration agreement is found to be null and void, inoperative or incapable of being performed under the governing law of the arbitration agreement, a court in a contracting state must decline jurisdiction over the dispute within the scope of the arbitration agreement and refer it to arbitration as contracted by the parties.²¹¹

Many national laws also make similar provisions for a domestic arbitration agreement, such that in the face of a valid arbitration agreement, courts will generally refer disputes under the agreement to arbitration, and disallow its litigation in court.²¹² This has the practical effect of preventing parties from having recourse to the courts in respect of disputes within the scope of the arbitration agreement.

3.5.3 Legal Framework of Arbitration

Beyond the arbitration agreement, arbitration proceedings are also governed by the applicable laws and arbitration rules. It is not unusual for intellectual property disputes submitted to arbitration to involve the application of the laws of more than one jurisdiction, and as such, parties will need to consider the governing laws applicable to the following matters:

²⁰⁸ World Intellectual Property Organization Arbitration and Mediation Center, 'What is WIPO Expedited Arbitration?' <http://www.wipo.int/amc/en/arbitration/what-is-exp-arb.html> accessed September 2018.

²⁰⁹ World Intellectual Property Organization Arbitration and Mediation Center, 'Recommended WIPO Model Arbitration Clauses and Submission Agreements' <http://www.wipo.int/amc/en/clauses/index.html> accessed September 2018.

²¹⁰ The New York Convention applies to arbitration agreements that have a "foreign" or "international" connection (e.g. the parties have their places of business in different countries). See Gary Born, 'International Commercial Arbitration: Commentary and Materials' (Kluwer Law International 2001) 119.

²¹¹ Gary B Born, 'The Law Governing International Arbitration Agreements: An International Perspective' (2014) 26 SAclJ 824 – 826.

²¹² Giuditta Cordero-Moss eds., 'International Commercial Arbitration: Different Forms and their Features' (Cambridge University Press 2013) 41.

(i) *Place/seat of the Arbitration*

The place/seat of the arbitration is the legal jurisdiction to which an arbitration is attached. The law of the seat will govern the procedural framework of the arbitration, including procedural matters such as whether a dispute is arbitrable, the availability of interim measures, and certain enforcement matters. In practice, arbitration hearings and meetings are often held where the place/seat is located.²¹³ Pursuant to Article 38(b) of the WIPO Arbitration Rules, the arbitral tribunal may, after consultation with the parties, conduct hearings at any place that it considers appropriate, and may deliberate wherever it deems appropriate.

(ii) *Substance of the Dispute*

Parties are free to decide on the law that will be applied to the substance of their dispute. The choice of substantive law is critically important for intellectual property disputes, especially when the validity or scope of an intellectual property right is at stake. Intellectual property regimes may vary from country to country despite efforts to harmonize such laws through international conventions, and such differences can have an impact on the outcome of the dispute,²¹⁴ even if the choice of governing law does not affect the domestic law regulating the intellectual property right in a country.

Under the WIPO Arbitration Rules, if the parties fail to decide on the substantive law, the arbitral tribunal will apply the law that it deems to be appropriate.²¹⁵

3.5.4 Arbitration Rules

Arbitration rules are often selected to complement the law of the seat, which governs the procedural framework of the arbitration proceedings.²¹⁶ Parties may agree on the arbitration rules that will govern notably the following matters:²¹⁷

- composition and appointment of the arbitral tribunal²¹⁸
- conduct of the arbitration, including matters such as the submission of written statements and evidence by the parties²¹⁹
- arbitration awards and other decisions made by the tribunal²²⁰
- confidentiality, especially with regards to the existence of the arbitration, any information disclosed during the arbitration and the outcome of the arbitration²²¹
- grounds on which the arbitration may be terminated²²²
- fees payable to the arbitrator(s) and the ADR institution/service provider (if applicable)²²³

²¹³ Simon Greenberg, Christopher Kee and J Romesh Weeramantry, *International Commercial Arbitration: An Asia-Pacific Perspective* (Cambridge University Press 2010) 56.

²¹⁴ Trevor Cook and Alejandro I Garcia, *ibid.* 43, 85.

²¹⁵ Article 61(a), WIPO Arbitration Rules.

²¹⁶ *FirstLink Investments Corp Ltd v GT Payment Pte Ltd* [2014] SGHCR 12 at 10, <http://www.newyorkconvention.org/11165/web/files/document/1/7/17749.pdf> accessed September 2018.

²¹⁷ These issues are addressed in the WIPO Arbitration Rules, available at <http://www.wipo.int/amc/en/arbitration/rules> accessed September 2018.

²¹⁸ Articles 14 – 36, WIPO Arbitration Rules.

²¹⁹ Articles 37 – 60, WIPO Arbitration Rules.

²²⁰ Articles 61 – 68, WIPO Arbitration Rules.

²²¹ It should be noted that some national laws impose a duty of confidentiality on parties for arbitrations located in such jurisdictions. See Simon Greenberg, Christopher Kee and J Romesh Weeramantry, *ibid.* 212, 372. In any case, Articles 75 – 78 of the WIPO Arbitration Rules allow the parties to keep the existence of the arbitration proceedings, any information disclosed and the results of the arbitration confidential.

²²² Article 67, WIPO Arbitration Rules.

ADR institutions will normally provide arbitration rules for arbitrations administered by them, and these rules can be altered by the parties to address particular aspects of their disputes. ADR institutions such as the WIPO Center also have in place arbitration rules that are designed for specific types of disputes.

3.5.5 Appointment and Role of Arbitral Tribunal

Parties have the freedom to select and appoint arbitrators to adjudicate on their dispute, and the appointment of the arbitral tribunal often has a critical impact on the conduct and outcome of the arbitration.

The arbitration agreement may specify the procedure to be used for the appointment of the arbitrator(s). For example, the arbitration agreement may provide that a tribunal of three arbitrators will be appointed, with each party nominating an arbitrator and the presiding arbitrator being appointed by the party-appointed arbitrators, or by the agreement of the parties.²²⁴ Alternatively, the parties may choose to appoint the arbitrator(s) according to such appointment procedure as may be provided in the arbitration rules.²²⁵ Some arbitration rules provide that where parties are unable or fail to appoint a suitable arbitral tribunal, the institution in question may then do so instead.²²⁶

An arbitral tribunal can comprise a sole arbitrator or three arbitrators. A tribunal with an even number of arbitrators may be prohibited in certain jurisdictions due to the risk of deadlock.²²⁷ A sole arbitrator may be easier to appoint, cheaper and allow for faster proceedings. However, a tribunal of three arbitrators can have the benefit of involving multiple arbitrators with different specialties and expertise.²²⁸

Arbitrators ought to be impartial and independent, and many national laws and institutional arbitration rules have specific requirements on this. For example, arbitrators are generally required to disclose to the parties any circumstances that might give rise to justifiable doubts about their impartiality and independence.²²⁹ Appointing arbitrators with the appropriate legal and technical expertise, especially for intellectual property disputes can be very helpful.²³⁰

The role of the arbitral tribunal is to render a binding decision in accordance with the arbitration agreement in question, arbitration rules and relevant laws. In this sense, arbitrators are adjudicators who perform vastly different functions from mediators, who facilitate negotiations between the parties.

3.5.6 Conduct of the Arbitration

The conduct of the arbitration will depend on the applicable arbitration rules. Typically, following the establishment of the arbitral tribunal, parties will have the opportunity to submit their Statement of Claim and Statement of Defense, or their equivalents, to the tribunal. The tribunal may then schedule

²²³ Articles 69 – 74, WIPO Arbitration Rules.

²²⁴ Sundaresh Menon and Denis Brock eds., 'Arbitration in Singapore: A Practical Guide' (Sweet & Maxwell Singapore 2014) [7.011] – [7.013].

²²⁵ Articles 14 – 36, WIPO Arbitration Rules.

²²⁶ Article 19, WIPO Arbitration Rules.

²²⁷ Countries such as Belgium, Italy and the Netherlands have prohibitions against such tribunals. See Gary B Born, 'International Arbitration: Law and Practice' (Kluwer Law International 2012) 123.

²²⁸ Gary B Born, *ibid.* 226, 123.

²²⁹ Article 22, WIPO Arbitration Rules; Gary B Born, *ibid.* 226, 132 – 133.

²³⁰ World Intellectual Property Organization Arbitration and Mediation Center, 'WIPO Arbitration and Mediation Center' <http://www.wipo.int/amc/en/center/background.html> accessed September 2018.

further submissions, or proceed to discuss the case schedule, hearing dates and stipulations on evidence and confidentiality with the parties.²³¹

Hearings may be held for the presentation of evidence by witnesses and experts, and for the presentation of oral arguments to the tribunal, on the request of a party or at the tribunal's discretion. If no hearings are held, the arbitration proceedings will usually be conducted on the basis of all submitted documents and materials.²³²

Generally, the tribunal will close the proceedings when it is satisfied that the parties have had adequate opportunity to present their submissions and evidence, after which it will issue the arbitral award. The parties will usually be bound by the award from the date that it is issued.²³³

3.5.7 Arbitral Awards

(i) *Final and Binding*

An arbitral award derives its final and binding force on the parties from the applicable arbitration rules and national laws, which generally provide that arbitral awards are not subject to appeal or review on the merits by national courts.²³⁴ However, in exceptional circumstances, it may be possible for a party to challenge the award before a national court at the seat of the arbitration and have it annulled, or resist the enforcement of the award in the relevant jurisdictions.²³⁵

(ii) *Enforceability*

The cross-border enforceability of arbitral awards is one of the main advantages of arbitration, and becomes particularly valuable in the unfortunate event where a party fails to comply with the arbitral award and the other party is compelled to enforce it. This cross-border enforceability is primarily derived from the New York Convention, which obliges contracting states to recognize and enforce arbitral awards made outside of their territory, subject to limited exceptions.²³⁶ As such, courts in many countries allow for an arbitral award to be enforced as a domestic court judgment upon an application by the relevant party,²³⁷ which may thus be relied on to enforce the arbitral award in any of the currently 159 contracting states to the New York Convention, provided that the award has been made in any such contracting state.²³⁸

(iii) *Interim Relief*

Some arbitration rules, such as the WIPO Arbitration Rules, allow parties to request interim relief from the arbitral tribunal, and vest in the tribunal, the discretion to issue any provisional orders or interim measures that it deems necessary at the request of a party. The requested relief can be delivered in the form of an interim award. Interim relief, especially injunctions, can be helpful for parties with technology or intellectual property disputes, and should not be overlooked.²³⁹

²³¹ Articles 41 – 47, WIPO Arbitration Rules.

²³² Articles 55 – 57, WIPO Arbitration Rules.

²³³ Articles 57 – 66, WIPO Arbitration Rules.

²³⁴ Article 66(a) WIPO Arbitration Rules and Trevor Cook and Alejandro I Garcia, *ibid.* 43, 38.

²³⁵ Alan Redfern, M Hunter et. al., *ibid.* 11, para 9-04 and 10-09.

²³⁶ Pieter Sanders eds., *ICCA's Guide to the Interpretation of the 1958 New York Convention* (International Council for Commercial Arbitration 2011) 9.

²³⁷ Trevor Cook and Alejandro I Garcia, *ibid.* 43, 312.

²³⁸ There are 159 contracting states. See United Nations Commission on Trade Law, 'Status – Convention on the Recognition and Enforcement of Foreign Arbitral Awards (New York, 1958)' http://www.uncitral.org/uncitral/en/uncitral_texts/arbitration/NYConvention_status.html accessed September 2018.

²³⁹ Article 48, WIPO Arbitration Rules.

3.5.8 Administration of Arbitration

Like *ad hoc* mediations, *ad hoc* arbitrations are proceedings that are not administered by any ADR institution.²⁴⁰ *Ad hoc* arbitration can lead to substantial delays if the parties are unable to reach an agreement on the necessary matters.²⁴¹

Beyond general administrative services,²⁴² the WIPO Center provides several additional services for arbitration proceedings. The WIPO Arbitration Rules provided by the WIPO Center are specifically designed for intellectual property and technology disputes, and contain detailed provisions on confidentiality, and the submission of technical and experimental evidence. The WIPO Center also has a network of experienced arbitrators and intellectual property experts, and can propose suitable arbitrators for arbitrations that it administers.²⁴³

The WIPO Center administers arbitrations on a non-profit basis, and its registration and administration fees are therefore comparatively moderate. The WIPO Center will determine the arbitrators' fees in consultation with the parties and the arbitrator(s), taking into consideration factors such as the applicable rates at the location of the parties and the arbitrator(s), the complexity of the case and the amounts in dispute.²⁴⁴

3.5.9 Mode of Submission to Arbitration

(i) *Voluntary vs. Mandatory*

As with voluntary mediation, voluntary arbitration refers to arbitration proceedings that are initiated with the consent of both parties through an arbitration agreement such as contained in an arbitration clause within an underlying contract. However, arbitration clauses can be problematic when the parties have unequal bargaining powers and one party is pressured into agreeing to the arbitration clause by the other.²⁴⁵

Arbitration clauses in agreements have sometimes been referred to as mandatory arbitration, where national laws compel parties to submit all disputes arising from the underlying contract to arbitration and require the courts to decline jurisdiction over the dispute.²⁴⁶

(ii) *IPO-Connected*

As compared to mediation services, arbitration services are generally less commonly available in dispute proceedings before IPOs. This said, the Intellectual Property Office of the Philippines (IPOP HL) has offered arbitration services for intellectual property disputes since 2012. IPOP HL's arbitration services are provided through its partnership with the Philippines Dispute Resolution Center, and are offered to parties who decide not to use IPOP HL's mediation services, or who are unable to settle their disputes through IPOP HL mediation.²⁴⁷

²⁴⁰ Michael McIlwrath and John Savage, 'International Arbitration and Mediation: A Practical Guide' (Kluwer Law International 2010) 2-035.

²⁴¹ Joyce J. George, 'The Advantages of Administered Arbitration When Going it Alone Just Won't Do' *Dispute Resolution Journal* 57.3 (Aug-Oct 2002): 66-74.

²⁴² See 3.3.6 above.

²⁴³ World Intellectual Property Organization Arbitration and Mediation Center, 'WIPO Neutrals' <http://www.wipo.int/amc/en/ neutrals/> accessed September 2018.

²⁴⁴ Information on the fees payable for arbitrations administered at the WIPO Center <http://www.wipo.int/amc/en/ arbitration/fees/> accessed September 2018.

²⁴⁵ David S Schwartz, 'Mandatory Arbitration and Fairness' (2009) 84 *Notre Dame L Rev* 1247, 1249.

²⁴⁶ David S Schwartz, *ibid.* 244, 1253

²⁴⁷ Intellectual Property Office of the Philippines 'Alternative Dispute Resolution' <http://www.ipophil.gov.ph/services/ip-cases2/alternative-dispute-resolution> accessed September 2018.

Chapter Four: Institutionalizing ADR for Intellectual Property Disputes

4.1 Introduction

The importance of optimizing the surrounding circumstances, or the “eco-system”, within which a public ADR program is to be implemented, so as to allow the ADR program to take root and to flourish, cannot be overstated.

While there are certainly other factors which may be considered, depending on the local conditions and particular circumstances of the country involved, the factors discussed below are key considerations in the institutionalization of ADR and its best practices for intellectual property disputes.

To provide practical illustration of institutional ADR, and offer possible models of such integration, Appendix A provides details of the WIPO Center’s ongoing collaborations with IPOs.

4.2 Opportunity for ADR

Identify where the opportunity lies for ADR to be introduced and deployed

Taking into account the nature of intellectual property disputes, including in terms of international parties and rights involved, as well as time and cost required in administrative or court proceedings, ADR may offer advantages for parties, IPOs and courts alike, including with a view to the efficient use of public resources. A review of such matters may be useful prior to defining the dispute resolution services that an IPO wishes to offer. The WIPO Center collaborates with a growing number of IPOs in the development and implementation of their ADR-related services.

Such services may broadly be categorized as follows:

(i) Raising Awareness of ADR Options

Many IPOs across regions put emphasis on promotional and advisory activities to raise awareness of the advantages of ADR options to prevent and resolve intellectual property and technology disputes outside the courts or other adjudicative bodies, in collaboration with the WIPO Center.²⁴⁸ Such collaboration may include developing country-tailored information materials for interested parties concerning ADR options,²⁴⁹ including information concerning online case administration options,²⁵⁰ joint events for stakeholders to inform them of the benefits of mediation and arbitration for resolving IP and related disputes,²⁵¹ and referring party inquiries received by an IPO to the WIPO Center for further assistance (notably in infringement cases). The WIPO Center is available to assist parties that

²⁴⁸ See Appendices A.1 and A.2. For more details see also <http://www.wipo.int/amc/en/center/specific-sectors/ipos/> accessed September 2018.

²⁴⁹ See Appendix A.1. Some examples are included in Appendix A.2.

²⁵⁰ Such as the online docket and videoconferencing facilities provided at no cost by the WIPO Center, see example in Appendix A.2.1. See also <http://www.wipo.int/amc/en/ecaf/index.html> accessed September 2018.

²⁵¹ See examples of such events organized by the WIPO Center in collaboration with IPOs at <http://www.wipo.int/amc/en/center/specific-sectors/ipos/> accessed September 2018. ADR also is included in the WIPO Roving Seminars organized in collaboration with IPOs, see http://www.wipo.int/dcea/en/roving_seminars/ accessed September 2018.

wish to commence a WIPO ADR proceeding, including through a unilateral Request for Mediation, through its Good Offices services.²⁵²

The WIPO Center also collaborates with the WIPO Technology and Innovation Support Center (TISC) program²⁵³ to assist TISCs in promoting the use of ADR, including in the context of R&D, for example in Colombia, Indonesia and Russia.²⁵⁴

(ii) Case Administration

Some IPOs have developed ADR options or encourage parties to use such options, in the context of proceedings pending before them, notably trademark or patent opposition proceedings. Collaboration with the WIPO Center may include the administration of cases submitted by parties to ADR under such schemes. For example, under its collaboration with IPOS, the WIPO Center has participated in the development of a mediation option for trademark and patent proceedings, and an expert determination option for patent proceedings pending before IPOS, and administers such proceedings.²⁵⁵ The WIPO Center also collaborates with the IPO of the Philippines (IPOPPL) concerning the administration of mediation proceedings involving intellectual property rights in the Philippines.²⁵⁶ The Trademark Trial and Appeal Board (TTAB) and the Patent Trial and Appeal Board (PTAB) of the United States Patent and Trademark Office (USPTO) encourage parties to consider ADR as a means of settling the issues raised in any trademark or patent proceedings. The WIPO Center is one of the listed dispute resolution services providers for TTAB and PTAB proceedings.²⁵⁷ Under its collaboration with the Patent Office of the Republic of Poland (PPO) the WIPO Center participated in the development of a mediation option for trademark opposition proceedings pending before the PPO and administers such proceedings.²⁵⁸

In the area of copyright, some IPOs administer ADR proceedings in domestic disputes and designate the WIPO Center as administrator of cases where one or both parties are domiciled outside the country. Such collaboration is currently in place between the WIPO Center and the National Copyright Directorate of Colombia (DNDA),²⁵⁹ the Korea Copyright Commission (KCC),²⁶⁰ and the Korea Creative Content Agency (KOCCA).²⁶¹

(iii) ADR options in Research and Development (R&D) Model Agreements

ADR options also may be considered in the context of other services offered by IPOs, including R&D model agreements. For example, the Spanish Patent and Trademark Office in collaboration with other stakeholders has developed Contract Templates for R&D collaborations that the Office makes available to interested users. Following consultations with the WIPO Center, these Contract Templates include model dispute resolution clauses, including referral of disputes to WIPO Mediation followed by WIPO Expedited Arbitration.²⁶²

²⁵² Information concerning WIPO Good Offices services is available at <http://www.wipo.int/amc/en/goodoffices> accessed September 2018.

²⁵³ World Intellectual Property Organization 'Technology and Innovation Support Centers' <http://www.wipo.int/tisc/en/> accessed September 2018.

²⁵⁴ See WIPO Center information flyer for TISCs in Appendix A.2.5.

²⁵⁵ See Appendix A.3.1.

²⁵⁶ See Appendix A.3.2.

²⁵⁷ See Appendix A.3.3.

²⁵⁸ See <http://www.wipo.int/amc/en/center/specific-sectors/ipoffices/poland/> accessed September 2018.

²⁵⁹ See Appendix A.3.4.

²⁶⁰ See Appendix A.3.5.

²⁶¹ See Appendix A.3.6.

²⁶² See Appendix A.4.1. Other model R&D agreements that recommend WIPO Mediation followed by Expedited Arbitration clauses include the EU DESCA 2020 Model Consortium Agreement <http://www.desca-2020.eu/> accessed September 2018; the 'Intellectual Property Agreement Guide (IPAG) Model Agreements' in Austria <http://www.wipo.int/amc/en/center/specific-sectors/rd/ipag/>

While ADR processes can generally be used at any stage of the dispute, the optimum time for ADR will depend on the nature of the dispute, the conduct of the parties, and their attitude towards ADR. This said, ADR processes tend to be more effective when used at an early stage of the dispute before costs have accumulated and the parties have become entrenched in their positions, but after the parties have had sufficient time and information to properly evaluate their case.

As a practical solution, parties may be given the discretion to submit to ADR at any stage of the proceedings; such discretion is for example provided in contentious trademark proceedings before IPOS which collaborates with the WIPO Center on the provision of ADR services in relation to such proceedings.

4.3 Interface with IPO, Court or Other Proceedings

Determine and stipulate how the ADR process will interface with existing dispute proceedings before the IPO, court or other forum and into which the opportunity for ADR is injected.

The status of the IPO, court or other proceedings while the ADR option is pursued needs to be clear, for example, whether they are suspended or extended. For example IPOS allows patent proceedings to be suspended for 60, 90 or 120 days for parties to submit to WIPO Expert Determination.²⁶³

Procedures may be instituted to give effect to the outcomes of successful ADR proceedings, and allow disputes to be returned to the IPO, court or other forum for adjudication where ADR is unsuccessful. The opportunity may also be given to the parties to use a different ADR process where initial attempts to resolve their dispute are unsuccessful; for example, IPOPHL allows parties to submit their dispute to arbitration if they are unable to resolve their dispute through its mediation services.²⁶⁴ Section 4.11 discusses the legal integration of such ADR programs in more detail.

4.4 Choice of ADR Process

Offer the ADR process suited to the disputes in question.

With the various ADR processes being characterized by their own specific features,²⁶⁵ the IPO's choice of the appropriate one(s) for any dispute will necessarily depend on the nature of the dispute, the parties' positions and the surrounding circumstances.²⁶⁶

4.5 Submission to ADR Process

Address the mode and manner in which submission to ADR is to be effected, including the factors that will help to secure its uptake.

accessed September 2018; and the Sample Agreements for Research and Development Cooperation in Germany https://www.bmwi.de/Redaktion/DE/Publikationen/Technologie/mustervereinbarungen-fuer-forschungs-und-entwicklungskooperationen.pdf?__blob=publicationFile&v=14 accessed September 2018. More information at <http://www.wipo.int/amc/en/center/specific-sectors/rd/> accessed September 2018.

²⁶³ See Appendix A.3.

²⁶⁴ Intellectual Property Office of the Philippines 'Alternative Dispute Resolution' <http://www.ipophil.gov.ph/services/ip-cases2/alternative-dispute-resolution> accessed September 2018.

²⁶⁵ See 3.3.1, 3.4.1 and 3.5.1.

²⁶⁶ See 3.2 above.

One matter for consideration is whether to make it mandatory for parties to submit their dispute to ADR. While mandatory ADR can be problematic,²⁶⁷ some degree of compulsion to use ADR may be necessary at least for the initial implementation of the ADR program, as parties may be reluctant to use unfamiliar dispute resolution processes. For example, some parties may be reluctant to consider submitting their dispute to mediation as it may be perceived as a sign of weakness.²⁶⁸

To mitigate perceived aversion to or apprehension of ADR, mandatory briefing sessions could be scheduled for parties to meet with an ADR practitioner familiar with the ADR program in question to discuss the strengths and weakness of litigation as compared to the various ADR processes. Similar sessions have been introduced in Italy, where litigants involved in specific types of disputes are required to meet with a mediator for a preliminary information session at no cost, and without prejudice to the opportunity of proceeding to litigation after the information session. These sessions have been generally successful in encouraging litigants to seriously consider mediation as a realistic option for their dispute.²⁶⁹

For an extra nudge to submit to ADR, financial incentives can be considered. In England, a party's silence in response to an invitation or a refusal to participate in ADR may be considered unreasonable by the court and could lead to the court ordering that party to pay additional court costs.²⁷⁰ A similar approach can be found in Australia.²⁷¹ In Singapore, laws have been instituted to allow courts to take into account any previous attempts by the parties to resolve their dispute by mediation or any other means of dispute resolution when allocating costs for civil litigation cases. This provides parties with a substantial incentive to consider submitting their dispute to ADR before engaging in litigation.²⁷² As mentioned above, the WIPO Mediation Rules permit a party wishing to formalize its willingness to refer a dispute to mediation by submitting a unilateral Request for Mediation to the WIPO Center and the other party.²⁷³

4.6 Finance

Source sufficient financing to support the development and implementation of the ADR program.

For all the cost savings that may be achieved through ADR, planning and implementing an ADR program requires funding. Although the amount required depends on multiple factors and may vary from country to country, examples of the items that may need to be budgeted for include:²⁷⁴

- consulting or legal services to address the legal framework
- formulation and adoption of an educational and awareness campaign
- establishment of the physical administration infrastructure and engagement with stakeholders

²⁶⁷ See 3.3.7(i) and 3.5.9(i) above.

²⁶⁸ James Chan, 'Unreasonable Refusals to Participate in Mediation' [2014] Asian JM 12, 13.

²⁶⁹ Giuseppe De Palo and others, *ibid.* 174, 8 – 9.

²⁷⁰ Ministry of Justice 'Practice Direction – Pre-Action Conduct'.

²⁷¹ Federal Court of Australia 'Mediation' <http://www.fedcourt.gov.au/case-management-services/ADR/mediation> accessed September 2018.

²⁷² James Chan, *ibid.* 265, 13.

²⁷³ See 3.3.2 above.

²⁷⁴ Lukasz Rozdeiczer and Alejandro Alvarez de la Campa, *Alternative Dispute Resolution Manual: Implementing Commercial Mediation* (Small and Medium Enterprise Department, The World Bank Group, 2006) 28
<http://documents.worldbank.org/curated/en/922161468339057329/pdf/384810ADR1Manu111Mediation01PUBLIC1.pdf> accessed September 2018.

Such funds may come from government funds allocated to the IPO, or fees charged by the IPO, or both. In the initial stages of implementation, the IPO may need to offer ADR services at subsidized rates to attract users. For example, the IPO of Singapore (IPOS) introduced, effective April 1, 2016, the IP Mediation Promotion Scheme which funds parties' mediation costs under certain conditions.²⁷⁵

4.6.1 Government Funding

The main source of financing at the initial implementation stage of the program is likely to come from government funds. It is important to secure sufficient funding to avoid the possibility of not being able to see through all the stages of the project.²⁷⁶

4.6.2 Administrative Fees

Administrative fees are a means for the administrator of the ADR program to cover administrative costs. This should be balanced against the need to ensure accessibility to users, and to encourage take-up rates for ADR, particularly at the infancy of an ADR program. The WIPO Center's collaborations with IPOs often include reduced fees under adapted Schedules of Fees.²⁷⁷

4.6.3 Practitioner Fees

With regard to the fees paid to mediators, arbitrators and experts, it is important to strike a balance between keeping fees low to ensure accessibility to users, and maintaining a credible incentive for experienced and qualified professionals to enter the field. This is particularly a concern for mediation, where the cost expectations of users are often at a level which may deter experienced legal professionals from becoming mediators.

As for arbitration, spiraling fees have been a problem and can pose a problem for the success of an ADR program. There is a growing recognition among users that arbitration costs are rising at an unsustainable rate, especially in international commercial arbitration. Unless this is managed, costs may become the primary bane of arbitration instead of a key advantage.²⁷⁸

An IPO is well placed to monitor and control the cost of an ADR program which it implements. Minimally, this could be achieved by tracking and disseminating information about the range of average costs for the various proceedings under its ADR program, and statistics on average number of hours required for such proceedings, so that there is greater transparency of the basis on which costs are derived.²⁷⁹

²⁷⁵ More information on the Mediation Promotion Scheme at <https://www.ipos.gov.sg/growing-your-business-with-ip/funding-assistance> accessed September 2018. See also below at Appendix A.3.1.

²⁷⁶ Lukasz Rozdeiczer and Alejandro Alvarez de la Campa, *ibid.* 271, 29.

²⁷⁷ See adapted Schedules of Fees under the WIPO Center's collaborations with IPOS and IPOPHL in Appendix A.3.1 and A.3.2.

²⁷⁸ Sundaresh Menon, 'Some Cautionary Notes for an Age of Opportunity' (SingaporeLaw.sg, August 22, 2013) <http://www.singaporelaw.sg/sqlaw/images/media/130822%20Some%20cautionary%20notes%20for%20a%20age%20of%20opportunity.pdf> accessed September 2018, 10.

²⁷⁹ Association of Chartered Certified Accountants, 'Alternative Dispute Resolution for Consumers' (ACCA, June 10, 2014) <http://www.accaglobal.com/sg/en/technical-activities/technical-resources-search/2014/june/cdr1289.html#> accessed September 2018.

4.7 “Buy-in”

Identify stakeholders and secure their “buy in” for the implementation and use of the ADR program.

Sufficient buy-in and commitment from the key parties involved in the implementation and use of the ADR program are vital to ensure the success of an ADR program.²⁸⁰

4.7.1 Process

The process of securing such buy-in can be broadly mapped out as follows:

(i) *Stakeholders*

Identifying the correct stakeholders is important, as the omission of any particular key group may prove fatal to the implementation of the ADR program. ADR programs have ended up failing as a result of opposition from key groups within the community, commonly because such groups see the implementation of ADR as a threat to their interests.²⁸¹ It is therefore important to identify the relevant constituencies early, and to ensure that the right messages are conveyed to them, and appropriate incentives, assurances or even compulsions²⁸² (if feasible) are created for such groups.

A note of caution sounded by commentators has been the selection of stakeholders who are too strong and have their own agenda,²⁸³ as they may be detrimental to the cause by advancing their own interests ahead of the overall success of the ADR program.

(ii) *Local Champion*

Having one or more local champion(s) for the cause is another critical piece, and provides a ready channel through which the ADR message can be effectively communicated to ensure that it is received positively. For example, the deployment of a leading local champion with the right political clout²⁸⁴ can make a significant difference to how the project is driven and the ability to garner the support needed to ensure its success.

(iii) *Engagement*

If the ADR program is to be successful, engagement on the part of stakeholders is necessary. Hitting the right notes with the stakeholders, including apprising them of the advantages of ADR, and the potential opportunities and benefits to participants in the ADR program, is important in eliciting such engagement. Another tangible measure could be to have stakeholders form an advisory board to drive and monitor the project, with the direct impact of having stakeholders take ownership of the project and creating a monitoring tool for the ADR program.²⁸⁵

²⁸⁰ Lukasz Rozdeiczer and Alejandro Alvarez de la Campa, *ibid.* 271, 17.

²⁸¹ Lukasz Rozdeiczer and Alejandro Alvarez de la Campa, *ibid.* 271, 21.

²⁸² See 4.5 above.

²⁸³ Lukasz Rozdeiczer and Alejandro Alvarez de la Campa, *ibid.* 271, 18.

²⁸⁴ Lukasz Rozdeiczer and Alejandro Alvarez de la Campa, *ibid.* 271, 18.

²⁸⁵ Lukasz Rozdeiczer and Alejandro Alvarez de la Campa, *ibid.* 271, 20.

4.7.2 Roles of Key Players

In turning to key players on the stage of the ADR program, recognizing and eliciting their respective contributory roles can be very helpful to the advancement of the project.

(i) *Government and IPOs*

At the foundational level, the presence of political will from government to imbibe ADR in the country makes for a robust premise on which to undertake the project. In its role as driver, government must itself be convinced of the advantages of ADR and committed to its promotion.²⁸⁶

Similarly, where the IPO is the main driver of the ADR project, such buy-in from key personnel in the IPO is critical.

(ii) *National Courts*

The support of local judges and the national courts is also important, for two main reasons. First, in ensuring the enforceability of the outcome of ADR, such as arbitral awards and mediation settlement agreements, the national courts play a key role in the strength of the ADR system. Second, the national courts can be a useful “catchment” resource for disputes which are amenable to ADR, in that active participation of the courts can play a part in assisting take-up rates for ADR. Setting case disposal targets of judges to give them credit for referring cases to ADR can also be effective.

Promotion of ADR to the courts will focus on the advantages of ADR specific to the courts, such as the reduction of case load, clearance of backlog and administrative cost savings for the courts, whereby ADR is viewed as complementary and not competitive to the court system.²⁸⁷

(iii) *Professionals*

In the same vein, the professional community, including lawyers, must be persuaded of their valuable place in the implementation and use of the ADR program on a long-term basis. Contrary to any apprehension of redundancy, ADR presents enlarged opportunities for this community as it is an added dimension to the dispute resolution options available to their clients, thereby enabling them to add value to their services and the significance of their role.

That said, for those professional service providers who have not been engaged in ADR, it will be necessary for them to take up appropriate training (e.g. in mediation), so that such training needs to be made readily available.²⁸⁸ This itself offers an opportunity for professional development for these professionals with the practical value of being useful to their clients.

(iv) *Users*

As for users, such as members of the business community and the public, the main objective for the success of the ADR program is to convince them of the many advantages of ADR.²⁸⁹

This entails a pro-active outreach to as wide an audience of potential users as available to make them aware of the benefits of ADR.

²⁸⁶ See Chapter 2 and 4.7.1 above.

²⁸⁷ See 1.3.2 above.

²⁸⁸ See 4.10.1 below.

²⁸⁹ See 2.1 – 2.10 above.

4.8 Consultation and Feedback

Conduct consultation sessions and open up channels for feedback and communication with stakeholders.

Consulting and communicating with stakeholders pre-emptively is useful for obtaining valuable feedback on the proposed plans. Such constructive comments can be gathered through surveys and public consultations, and can help to identify potential problems and find areas for improvement.²⁹⁰ For example, in 2013, the WIPO Center conducted an International Survey on Dispute Resolution in Technology Transactions to assess the current use in technology-related disputes of ADR methods as compared to court litigation, including a qualitative evaluation of these dispute resolution options.²⁹¹

Stakeholder feedback was an important element in the establishment of Singapore's first commercial mediation center. Before this center was established in 1997, a detailed feasibility study was carried out by the Singapore Academy of Law. Through extensive consultations with stakeholders, including lawyers, trade organizations and interest groups, the Singapore Academy of Law was able to create a realistic action plan for the establishment of the commercial mediation center.²⁹²

4.9 Outreach

Organize outreach activities to engage stakeholders.

Engaging key target groups through outreach activities is crucial for the ADR program. Such groups may include:

- Government
- national courts
- professionals, including lawyers
- users, such as members of the business community and the public

Examples of outreach activities include:

- holding educational sessions and roadshows on the benefits of ADR²⁹³
- identifying local ADR champions to promote the IPO's ADR services
- publicizing general "ADR pledges" for users and stakeholders to show their commitment to resolve their disputes using ADR²⁹⁴
- establishing industry-specific schemes for the use of ADR²⁹⁵

Upon request, the WIPO Center assists IPOs in such activities.²⁹⁶

²⁹⁰ The World Bank Group, *ibid.* 127, 34.

²⁹¹ The full report is available at <http://www.wipo.int/export/sites/www/amc/en/docs/surveyresults.pdf> accessed September 2018.

²⁹² Joel Lee and Teh Hwee Hwee eds, *ibid.* 4, 7-8.

²⁹³ Giuseppe De Palo and others, *ibid.* 174, 153 – 154.

²⁹⁴ Giuseppe De Palo and others, *ibid.* 174, 155.

²⁹⁵ World Intellectual Property Organization Arbitration and Mediation Center 'WIPO Alternative Dispute Resolution (ADR) Services for Specific Sectors' <http://www.wipo.int/amc/en/center/specific-sectors/> accessed September 2018. See also Appendix B.4.

²⁹⁶ See list of WIPO Center events at www.wipo.int/amc/en/events/ accessed September 2018.

WIPO-IPOS ADR Outreach Activities

Prior to the entry into force of a joint mediation procedure to facilitate the resolution of trademark disputes pending before IPOS, the WIPO Center and IPOS conducted a two-day workshop to train trademark practitioners as mediators. The training program included sessions on both substantive and procedural issues related to trademark disputes and mediation. A number of participants were afterwards invited to be part of a dedicated list of mediators to be appointed in WIPO-IPOS mediations. Furthermore, the WIPO Center and IPOS conducted various promotional events to raise awareness of ADR for intellectual property disputes and, in particular, to encourage the use of mediation for trademark disputes pending before IPOS.

4.10 ADR Practitioners

Address the needs of ADR practitioners to secure their active participation in the ADR program and adherence to the requisite quality standards.

From the initial consultation phase,²⁹⁷ the objective is to engage and nurture ADR practitioners, as they are crucial to the long-term success of any ADR program. Training and accreditation programs provide opportunities to accelerate the professional development of such ADR practitioners. ADR practitioners represent an important part of the ADR “eco-system” and these include representatives for the parties, and neutral third parties involved in the ADR, such as mediators, members of the arbitral tribunal, and experts appointed in expert determination. The high standards to which they perform ADR-related services and conduct themselves in ADR processes are important in instilling public confidence in the ADR program.

4.10.1 Training

ADR training opportunities at various levels of experience, and addressing different aspects of ADR, must be made available for the different interest groups of ADR practitioners. As the practical application of ADR is a significant feature of ADR in operation, such training ought to address not only the theoretical basis and academic aspects of the different types of ADR, but also provide instruction and opportunity on the use of ADR in practice. A corollary to the conduct of training sessions for ADR practitioners is the availability of ADR literature to ADR practitioners, be they veterans or newbies.

ADR training also provides a channel for the benchmarking of quality standards sought to be established and maintained in the ADR field. ADR service providers, such as the WIPO Center, can provide the appropriate expertise and support to conduct such training programs.

WIPO/INPI-BR Training of Mediators

The WIPO Center and the Brazilian National Institute of Industrial Property (INPI-BR) conducted a number of training sessions to establish a panel of mediators for trademark disputes pending before INPI-BR.²⁹⁸

²⁹⁷ See 4.8 above.

²⁹⁸ The WIPO/INPI-BR Panel of Mediators for Intellectual Property Disputes Pending before INPI-BR is available at <http://www.wipo.int/amc/en/center/specific-sectors/inpibr/panel/> accessed September 2018.

4.10.2 Quality Standards

Some problems identified with the state of ADR today include the relative dearth of professional bodies with the leadership to self-regulate the field, and the lack of objective transparency on standards, feedback and ethics in the field.²⁹⁹

In seeking to address these problems, the pitfalls of over-regulating ADR practitioners, which can stifle their supply, are to be avoided. A balance must therefore be struck between prescribing mandatory minimum training of ADR practitioners and encouraging participation by experienced professionals who may resist the requirement for such minimum training prescriptions.

Some tools for establishing quality standards include accreditation programs for ADR practitioners. A particularly illustrative resource on this is the list of guidelines published by the American Bar Association's Section of Dispute Resolution on what an effective credentialing program for mediators should include, namely:³⁰⁰

- requiring credentialed mediators to have clearly defined skills, knowledge and values requiring credentialed mediators to have completed adequate training
- administration of the accreditation program by an organization which is distinct from the trainer
- establishing consistent assessment process for determining skills, knowledge and values of the credentialed mediators
- explaining clearly what is being certified under the accreditation program
- providing a transparent system to handle complaints, including de-credentialing, within the accreditation program

In WIPO Center cases, parties can draw upon a database of over 1,500 independent WIPO arbitrators, mediators and experts globally. The candidates on the WIPO List of Neutrals range from seasoned dispute resolution generalists to highly specialized practitioners and experts covering the entire legal and technical spectrum of intellectual property. Their geographical diversity suits the international character of many disputes. The WIPO Center requests parties' feedback on the neutrals appointed and takes such feedback as well as the conduct of the case into account for future neutral appointments.

4.10.3 Availability

For the ADR program to thrive, there needs to be an adequate and readily accessible supply of ADR practitioners to sufficiently service the cases that come up for ADR.

A list of accredited ADR practitioners may be maintained, with information on each ADR practitioner's experience and credentials. This would serve the dual purpose of maintaining a list of available ADR practitioners who may be called upon, as well as to establish public confidence in the standards and accreditation of such available ADR practitioners. Regardless of whether the list is public or not, where parties cannot agree on a neutral, the WIPO Center provides profiles of suitable candidates to both

²⁹⁹ Michael Leathes, 'The Future of ADR in 2020' [2013] Asian JM 27
<https://www.mediate.com/articles/LeathesM4.cfm> accessed September 2018.

³⁰⁰ Alternative Dispute Resolution Section of the American Bar Association Task Force on Mediator Credentialing, 'Final Report' (American Bar Association, August 2012)
http://www.americanbar.org/content/dam/aba/images/dispute_resolution/CredentialingTaskForce.pdf accessed September 2018.

parties, taking into account particular qualifications agreed by the parties as well the requirements of the case.³⁰¹

4.11 Legal Framework

Work out the legal framework required to support the ADR program.

The legal framework within which the ADR process operates is important to ensure that it has the necessary legal bite. In addressing the legal framework, the key aspects are as follows.

4.11.1 Legal Framework and System

The existing legal framework and system into which the ADR program is to be introduced will determine whether it is necessary to promulgate new laws or regulations to support the workability of the ADR program, such as in relation to confidentiality, enforceability of contracts and professional immunity. A pre-emptive review of the existing legal position on such matters is useful in identifying the types of laws and rules that may need to be passed to enable and support the implementation and use of the ADR program.

An assessment of existing laws and IPO regulations will determine the extent to which they facilitate the use of ADR. Legal advice may be taken for the purpose of such analysis, and if applicable, to formulate and implement the relevant laws and regulations so as to provide a conducive legal framework for the ADR program. This exercise may take time to implement, possibly over stages.

4.11.2 Enabling Laws and Regulations

Where new laws or regulations would be necessary, a public consultation process on the proposed laws or regulations will give the ADR project credibility.³⁰²

At the basic level, ADR-enabling laws or regulations ideally provide for:³⁰³

- confidentiality of the ADR proceedings, and any information or materials used in such proceedings
- restriction on the admissibility of 'without prejudice' communications, which may be made during the ADR proceedings
- facilitate the enforcement of ADR outcomes, such as mediation settlements and arbitral awards³⁰⁴

At the more granular level, rules of procedure that support and encourage the use of ADR may also be deployed, for example by:³⁰⁵

- suspension of non-ADR dispute resolution proceedings at the courts or IPO for parties to consider ADR

³⁰¹ This is provided for in the WIPO Center's "list procedure", see Article 7(a), WIPO Mediation Rules, Article 19(b), WIPO Arbitration Rules and Article 14(b), WIPO Expedited Arbitration Rules.

³⁰² Lukasz Rozdeiczer and Alejandro Alvarez de la Campa, *ibid.* 271, 38.

³⁰³ The World Bank Group, *ibid.* 127, 35.

³⁰⁴ For example, mediation settlements arising from ADR proceedings administered by the Korean Copyright Commission can be enforced as court orders under Korean law. See Appendix A.3.5.

³⁰⁵ Karl Mackie and others, *ibid.* 127, 36.

- requiring parties to attempt ADR before instituting non-ADR dispute resolution proceedings at the courts or IPO
- requiring parties to provide reasons for not engaging in ADR and even penalizing parties for unreasonable refusal to engage in ADR³⁰⁶
- adopting ADR rules which themselves are conducive to a convenient and efficient ADR process
- applying reduced fees or giving discounts of fees charged in the non-ADR dispute resolution proceedings to parties who have diverted to ADR from such proceedings

4.12 Administrative Infrastructure

Establish administrative infrastructure to support the implementation and provide the required ADR services.

To launch an ADR program and keep it running, adequate personnel needs to be deployed to attend to the matters to make the ADR program a functioning reality. Natural adjunctive requirements include physical facilities necessary for the day-to-day management of the ADR program.

The extent and nature of the administrative infrastructure established may depend, in part, on the type of the ADR referral mechanism chosen and the anticipated nature of potential disputes, and be further determined by the opportunities for collaboration with ADR service providers, such as the WIPO Center, who can provide valuable assistance for such administrative services.³⁰⁷

For example, where the IPO does not engage a third-party ADR provider, the IPO would have to undertake the administration of the ADR proceedings, including liaising with the ADR neutral(s) and parties, attending to the collection of fees, providing appropriate facilities and administrative services. On the other hand, where an IPO's ADR program allows the IPO to refer the parties to a third party administering body, such as the WIPO Center, the administration of the ADR proceedings would be outsourced to such administering body.³⁰⁸

4.13 Public Confidence

Secure and maintain public confidence in the ADR program.

Public confidence is one of the pillars for the success of the ADR program, vigilance over which needs to be exercised throughout the life of the program, to prevent its erosion. The following are some (but not necessarily all the) key factors that play a part in earning confidence of potential users.

4.13.1 Impartiality and Independence of Neutrals

As the neutrals in ADR proceedings (i.e. the mediators, arbitrators and experts) are oftentimes private individuals appointed by the parties, they do not automatically enjoy the status of judges as public servants. In such an arrangement, the visible impartiality of such neutrals takes on heightened

³⁰⁶ See, for example, Article 22 of Colombian Law 640 of 2001 and Article 34 of the Conciliation and Arbitration Rules of the ADR Center of the National Directorate Copyright of Colombia (DNDA): if a party does not attend the conciliation hearing, the conciliator issues a certificate that can be used in subsequent court procedures.

³⁰⁷ See 3.3.6 above.

³⁰⁸ See 3.3.7(iii), 3.4.6 and 3.5.9(ii) above.

importance, and is yet not impervious to its own issues and problems. ADR institutions such as the WIPO Center play an important role in this regard.

General guiding principles can be formulated to address this matter, such as the following requirements:

- ADR neutral must not favor (nor be perceived as favoring) the interests of any one party
- ADR neutral must be required to conduct conflict check and disclose any financial or personal relationship with any of the disputants
- disputants must jointly agree on the appointment of the ADR neutral
- fees of the ADR neutral are to be borne by parties in equal shares, or by an independent party like the administrative body

4.13.2 Confidentiality of Information

The ability to ensure confidentiality of information ventilated in the ADR process (and indeed the existence of the process) is one attractive force of ADR.³⁰⁹ Many parties choose ADR precisely because of the need for confidentiality, particularly businesses who do not want to disclose commercially sensitive information to the public domain.³¹⁰ Maintaining strict confidentiality gives consumers confidence and encourages participation in ADR. In mediation, the assurance of confidentiality encourages parties to be as open as possible in finding a mutually acceptable solution without fear of prejudice if the dispute goes to court, and thereby enhancing its probability of success.³¹¹

Confidentiality can be achieved through specific ADR laws that provide expressly for confidentiality, or through contract where parties adopt applicable rules through the relevant clause or agreement for submission to ADR.³¹²

4.13.3 Transparency of Proceeding

Not to be confused with confidentiality of information and the ADR process discussed above, transparency of the manner in which the ADR proceeding is conducted in compliance with due process and the rule of law, is also pertinent to public confidence in such proceeding.

In particular, administrative actions within the proceeding are to be made in full transparency to the parties, e.g. process for appointment of mediator, arbitral tribunal or expert, or any decisions made on any interlocutory matter, as reflective of the impartiality and independence of the ADR administrative body.

4.13.4 Realization of Advantages

Making good on the described advantages of ADR³¹³ is important to prevent a loss of public confidence in it.

For example, attention is required to ensure that the ADR process is designed to maximize efficiency and thereby bring about time and cost savings. Furthermore, the ADR process should operate within a

³⁰⁹ See 2.7 above.

³¹⁰ Trevor Cook and Alejandro I Garcia, *ibid.* 43, 47.

³¹¹ Susan Corbett, *ibid.* 79, 65.

³¹² See 3.3.2, 3.4.2 and 3.5.4 above.

³¹³ See Chapter 2 above.

legal framework that assures the enforceability of decisions or settlements that issue out of the ADR process.³¹⁴

4.14 Periodic Review

Undertake regular reviews of the ADR program to monitor its take-up rate and performance, ensure compliance with best practices, and identify areas for improvement and updating to ensure its long-term sustainability.

Periodic reviews are important to ensure that the ADR program remains relevant and current. Reviews undertaken with stakeholders on an ongoing basis provide a channel for obtaining helpful feedback and present opportunities for continued engagement over the longer term.

³¹⁴ For arbitration, this includes the possibility of taking advantage of the New York Convention in a cross-border dispute.

Appendix A: WIPO Center Collaboration with IPOs and Courts

A.1 Overview³¹⁵

Argentina	National Institute of Industrial Property (INPI)	The WIPO Center collaborates with INPI in the promotion of the use of ADR options for intellectual property disputes in Argentina.
Australia	IP Australia	The WIPO Center collaborates with IP Australia in the promotion of the use of ADR options for intellectual property disputes in Australia. ³¹⁶
Brazil	National Institute of Industrial Property (INPI-BR)	The WIPO Center collaborates with INPI-BR in the promotion of the use of ADR options for industrial property disputes in Brazil. The WIPO Center has participated in the training of mediators in Brazil, in collaboration with INPI-BR. ³¹⁷
China	National Intellectual Property Administration of the People's Republic of China (CNIPA)	The WIPO Center collaborates with CNIPA in the promotion of the use of ADR options for industrial property disputes in China.
Colombia	National Directorate of Copyright (DNDA)	DNDA administers conciliation proceedings and the WIPO Center administers mediation proceedings concerning copyright and related rights in Colombia. ³¹⁸
Costa Rica	National Register	The WIPO Center collaborates with the National Register in the promotion of the use of ADR options for intellectual property disputes in Costa Rica.
Cuba	Cuban Industrial Property Office (OCPI)	The WIPO Center collaborates with OCPI in the promotion of the use of ADR options for industrial property disputes in Cuba.

³¹⁵ World Intellectual Property Organization Arbitration and Mediation Center, 'WIPO Alternative Dispute Resolution (ADR) for Intellectual Property Offices and Courts' <http://www.wipo.int/amc/en/center/specific-sectors/ipos> accessed September 2018.

³¹⁶ <https://www.ipaustralia.gov.au/ip-infringement/enforcing-your-ip/enforcing-your-ip-overseas> accessed September 2018.

³¹⁷ <http://www.wipo.int/amc/en/center/specific-sectors/inpibr/panel/> accessed September 2018.

³¹⁸ <http://www.wipo.int/amc/es/center/specific-sectors/dnda/> accessed September 2018.

Dominican Republic	National Copyright Office (ONDA)	The WIPO Center collaborates with ONDA in the promotion of the use of ADR options for intellectual property disputes in the Dominican Republic.
El Salvador	National Center of Registries (CNR)	The WIPO Center collaborates with CNR in the promotion of the use of ADR options for intellectual property disputes in El Salvador. ³¹⁹
Indonesia	Directorate General of Intellectual Property (DGIP)	The WIPO Center collaborates with DGIP in the promotion of the use of ADR options for intellectual property disputes in Indonesia.
Israel	Israel Patent Office	The WIPO Center collaborates with the Israel Patent Office in the promotion of the use of ADR options for intellectual property and technology disputes in Israel. ³²⁰
Kenya	Kenya Copyright Board (KECOBO)	The WIPO Center collaborates with KECOBO in the promotion of the use of ADR options for copyright disputes in Kenya.
Lithuania	Ministry of Culture of the Republic of Lithuania	The WIPO Center collaborates with the Ministry of Culture of the Republic of Lithuania in the promotion of the use of ADR options for intellectual property disputes in Lithuania.
Mexico	Mexican Institute of Industrial Property (IMPI)	The WIPO Center collaborates with IMPI in the promotion of the use of ADR options for industrial property disputes in Mexico. ³²¹
Paraguay	National Directorate of Intellectual Property (DINAPI)	The WIPO Center collaborates with DINAPI in the promotion of the use of ADR options for intellectual property disputes in Paraguay. ³²²
Philippines	Intellectual Property Office of the Philippines (IPOPHL)	IPOHL and the WIPO Center administer mediation proceedings concerning intellectual property rights in the Philippines. ³²³ The WIPO Center has participated in the training of mediators in the Philippines, in collaboration with IPOPHL. ³²⁴

³¹⁹ <http://www.cnr.gob.sv/director-ejecutivo-del-cnr-firma-memorandum-de-entendimiento-con-la-ompi/> accessed September 2018.

³²⁰ <http://www.justice.gov.il/En/Units/ILPO/Cooperation/Pages/Wipo-Mediation.aspx> accessed September 2018.

³²¹ https://www.gob.mx/imp/imp/documentos/colaboracion-imp-mexico-ompi_final-pdf accessed September 2018.

³²² <https://www.dinapi.gov.py/index.php/noticias/memorando-de-entendimiento-sobre-prestacion-de-servicios-respecto-metodos-de-solucion-de-controversias> accessed September 2018.

³²³ <http://www.wipo.int/amc/en/center/specific-sectors/ipophl/> accessed September 2018.

³²⁴ <http://www.wipo.int/amc/en/center/specific-sectors/ipophl/panel/> accessed September 2018.

Poland	Patent Office of the Republic of Poland (PPO)	The WIPO Center has participated in the development of a mediation option for trademark opposition proceedings pending before PPO and administers such proceedings. ³²⁵
		The WIPO Center collaborates with PPO in the promotion of the use of ADR options for intellectual property and technology disputes in Poland. ³²⁶
Republic of Korea	The Copyright Bureau of the Ministry of Culture, Sports and Tourism of the Republic of Korea	The Korean Copyright Commission (KCC) administers mediation proceedings concerning copyright and related rights in the Republic of Korea. ³²⁷
		In case of international disputes KCC also offers a WIPO mediation option to potential parties. ³²⁸
	The Korea Creative Content Agency (KOCCA) administers mediation proceedings concerning content related rights in the Republic of Korea. ³²⁹	
	In case of international disputes KOCCA also offers a WIPO mediation option to potential parties. Under certain conditions, parties to WIPO mediation under WIPO-KOCCA collaboration can benefit from a subsidy scheme for fees and costs provided by KOCCA. ³³⁰	
	Korean Intellectual Property Office (KIPO)	The WIPO Center collaborates with KIPO in the promotion of the use of ADR options for industrial property disputes in the Republic of Korea.
	Ministry of Justice	The WIPO Center collaborates with the Ministry of Justice in the promotion of the use of ADR options for intellectual property disputes in the Republic of Korea.
Romania	Romanian Copyright Office (ORDA)	The WIPO Center collaborates with ORDA in the promotion of the use of ADR options for copyright disputes in Romania.

³²⁵ <http://www.wipo.int/amc/en/center/specific-sectors/ipoffices/poland/> accessed September 2018.

³²⁶ <http://www.uprp.pl/alternatywne-metody-rozstrzygania-sporow-alternative-dispute-resolution-adr-w-obszarze-wlasnosci-intelektualnej-i-technologie/Lead02,57,18685,7,index,pl,text/> accessed September 2018.

³²⁷ <https://www.copyright.or.kr/eng/service/adr/conciliation.do> accessed September 2018.

³²⁸ <http://www.wipo.int/amc/en/center/specific-sectors/kcc/> accessed September 2018.

³²⁹ <http://www.kcdrc.kr/guid04.do> accessed September 2018.

³³⁰ <http://www.wipo.int/amc/en/center/specific-sectors/kocca/> accessed September 2018.

Russian Federation	Federal Service for Intellectual Property (ROSPATENT)	The WIPO Center collaborates with ROSPATENT in the promotion of the use of ADR options for intellectual property disputes in the Russian Federation.
Serbia	Intellectual Property Office of the Republic of Serbia	The WIPO Center collaborates with the Intellectual Property Office of the Republic of Serbia in the promotion of the use of ADR options for intellectual property disputes in Serbia. ³³¹
Singapore	Intellectual Property Office of Singapore (IPOS)	The WIPO Center has participated in the development of a mediation option for trademark and patent proceedings ³³² and an expert determination option for patent proceedings pending before IPOS ³³³ and administers such proceedings.
	Ministry of Law	The WIPO Center collaborates with the Ministry of Law in the promotion of the use of ADR options for intellectual property disputes in Singapore. The Ministry of Law has designated the WIPO Center as mediation service provider in Singapore. ³³⁴
Spain	Spanish Patent and Trademark Office (OEPM)	The WIPO Center collaborates with OEPM in the promotion of the use of ADR options for industrial property disputes in Spain. ³³⁵ The WIPO Center has also participated in the development of the OEPM model Research and Development (R&D) agreements, which recommend WIPO Mediation and WIPO Expedited Arbitration options. ³³⁶
Switzerland	Swiss Federal Institute of Intellectual Property	The WIPO Center collaborates with Swiss Federal Institute of Intellectual Property in the promotion of the use of ADR options for intellectual property disputes.
Thailand	Central Intellectual Property and International Trade Court (CIPITC)	The WIPO Center collaborates with CIPITC in the promotion of the use of ADR options for intellectual property disputes in Thailand.

³³¹ <http://www.zis.gov.rs/news.370.html?newsId=2023> accessed September 2018.

³³² <http://www.wipo.int/amc/en/center/specific-sectors/ipos/mediation> accessed September 2018.

³³³ <http://www.wipo.int/amc/en/center/specific-sectors/ipos/expert-determination/> accessed September 2018.

³³⁴ <https://www.mlaw.gov.sg/content/minlaw/en/news/press-releases/mediation-act-to-commence-from-1-november-2017.html> accessed September 2018.

³³⁵ https://www.oepm.es/es/propiedad_industrial/Mediacion_y_Arbitraje/ accessed September 2018.

³³⁶ http://www.oepm.es/es/propiedad_industrial/transferencia_de_tecnologia/Modelos_de_Contratos/ accessed September 2018.

United Kingdom	Intellectual Property Office (IPO) of the United Kingdom	The WIPO Center collaborates with the IPO of the United Kingdom in the promotion of the use of ADR options for industrial property disputes in the United Kingdom. ³³⁷
United States of America	United States Patent and Trademark Office (USPTO)	<p>The Trademark Trial and Appeal Board (TTAB)³³⁸ and the Patent Trial and Appeal Board (PTAB) of the USPTO³³⁹ encourage parties to consider ADR as a means of settling the issues raised in any trademark or patent proceedings. The WIPO Center is one of the listed dispute resolution services providers for TTAB³⁴⁰ and PTAB proceedings.</p> <p>The WIPO Center also collaborates with the USPTO in the promotion of the use of ADR options for intellectual property disputes in the United States.</p>

³³⁷ <https://www.gov.uk/guidance/intellectual-property-mediation> accessed September 2018.

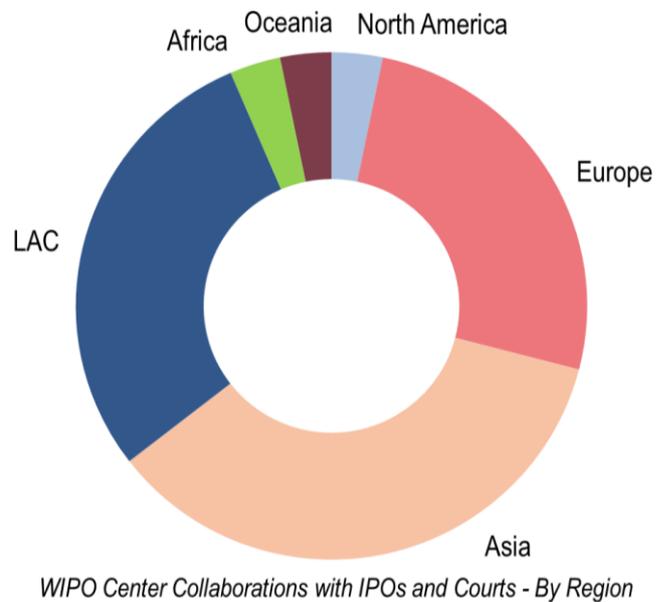
³³⁸ <https://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board> accessed September 2018.

³³⁹ <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board-0> accessed September 2018.

³⁴⁰ http://www.uspto.gov/sites/default/files/documents/USPTO_WEB_POSTING_ON_ADR_%282%29.docx accessed September 2018.

Jan-Aug 2018	<ul style="list-style-type: none"> - CNIPA (China) - KECOBO (Kenya) - KIPO (Republic of Korea) - Ministry of Justice (Republic of Korea) - ORDA (Romania) - IPI (Switzerland) - CIPITC (Thailand)
2017	<ul style="list-style-type: none"> - INPI (Argentina) - IP Australia (Australia) - National Register (Costa Rica) - OCPI (Cuba) - ONDA (Dominican Republic) - ILPO (Israel) - Ministry of Culture (Lithuania) - PPO (Poland) - ROSPATENT (Russian Federation) - IP Office (Serbia)
2016	<ul style="list-style-type: none"> - CNR (El Salvador) - DINAPI (Paraguay)
2015	<ul style="list-style-type: none"> - OEPM (Spain) - USPTO (US)
2014	<ul style="list-style-type: none"> - DNDA (Colombia) - DGIP (Indonesia) - IMPI (Mexico) - IPOPHL (Philippines)
2012	<ul style="list-style-type: none"> - INPI-BR (Brazil) - MCST-KCC (Republic of Korea) - MCST-KOCCA (Republic of Korea)
2011	<ul style="list-style-type: none"> - IPOS (Singapore) - IPO (UK)
2009	<ul style="list-style-type: none"> - MinLaw (Singapore)

Commencement of WIPO Center Collaborations with IPOs and Courts - By Year

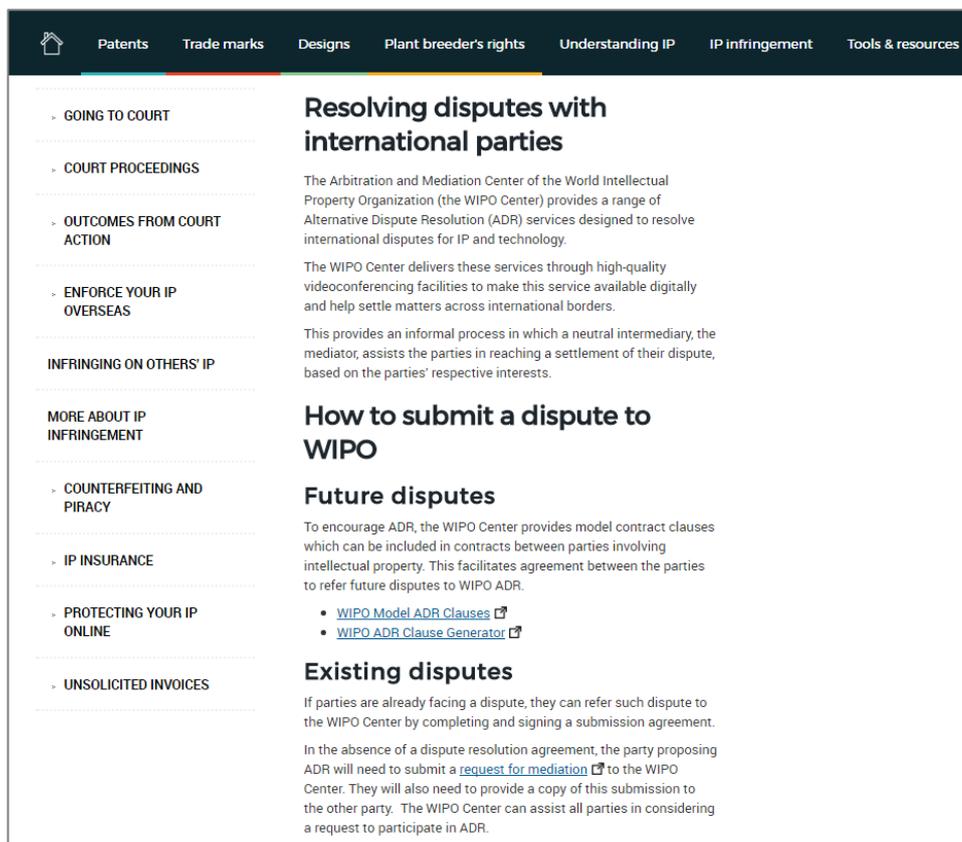


A.2 WIPO Center Collaboration Examples: Raising Awareness of ADR Options

A.2.1 IP Australia

In January 2017 IP Australia and the WIPO Center launched an initiative to provide ADR options for resolving intellectual property and technology disputes in Australia³⁴¹.

This service provides Australian business with improved access to mediation, arbitration and expert determination and enables parties to settle international intellectual property disputes in a time and cost efficient manner. To this end, the WIPO Center makes available at no cost to interested parties online communication options, including WIPO ECAF and videoconferencing facilities.



The screenshot shows a webpage with a dark navigation bar at the top containing a home icon and menu items: Patents, Trade marks, Designs, Plant breeder's rights, Understanding IP, IP infringement, and Tools & resources. The main content area has a white background and a dark sidebar on the left with a list of menu items: GOING TO COURT, COURT PROCEEDINGS, OUTCOMES FROM COURT ACTION, ENFORCE YOUR IP OVERSEAS, INFRINGING ON OTHERS' IP, MORE ABOUT IP INFRINGEMENT, COUNTERFEITING AND PIRACY, IP INSURANCE, PROTECTING YOUR IP ONLINE, and UNSOLICITED INVOICES. The main content features three sections: 'Resolving disputes with international parties' with a paragraph about WIPO Center services, 'How to submit a dispute to WIPO' with a paragraph about model contract clauses and two bullet points linking to 'WIPO Model ADR Clauses' and 'WIPO ADR Clause Generator', and 'Existing disputes' with two paragraphs explaining the process of referring a dispute to the WIPO Center.

IP Australia's webpage on ADR

³⁴¹ IP Australia, 'International Alternative Dispute Resolution' <https://www.ipaustralia.gov.au/ip-infringement/enforcing-your-ip/enforcing-your-ip-overseas> accessed September 2018.

A.2.2 Israel Patent Office (ILPO)

ILPO and the WIPO Center jointly promote the use of ADR for intellectual property and technology disputes in Israel, including by distributing publications and other information materials, making available dedicated webpages and providing training for ILPO's users.³⁴²

The screenshot shows the Israel Patent Office website. The main content area is titled "WIPO Mediation for IP and Technology Disputes" and contains the following sections:

- Alternative Dispute Resolution Options for Intellectual Property and Technology Disputes**

Intellectual property (IP) is a central component of today's knowledge economy, and its efficient exploitation is of growing importance to successful business. However, disputes can interfere with IP rights, impacting on innovation and creative processes.

While the careful drafting of contracts will reduce their frequency, disputes may arise. Therefore, it is essential that they be managed and resolved efficiently. In order to do so, parties must be familiar with their dispute resolution options. Although an IP dispute can be resolved through court litigation, parties are, with increasing frequency, submitting disputes to mediation, arbitration or other alternative dispute resolution (ADR) procedures.
- ILPO-WIPO Collaboration**

The Israeli Patent Office (ILPO) and the World Intellectual Property Organization Arbitration and Mediation Center collaborate to raise awareness of ADR options to court litigation to resolve IP and technology disputes in Israel.
- What is ADR?**

ADR procedures constitute alternatives to court litigation. ADR is appropriate for most IP related commercial disputes, and especially between parties from different jurisdictions. ADR can enhance the parties control over the dispute resolution process. If well managed, ADR can save time and money. In addition, its consensual nature often results in a less adversarial process, allowing the parties to begin, continue, or improve business relationships.

ADR options include mediation, arbitration, expedited arbitration and expert determination.
- Mediation**

An informal consensual process in which a neutral intermediary, the mediator, assists the parties in reaching a settlement of their dispute, based on the parties' respective interests.

 - Learn more
- Arbitration**

A consensual procedure in which the parties submit their dispute to one or more chosen arbitrators, for a binding and final decision (award).

 - Learn more
- Expedited Arbitration**

An arbitration procedure that is carried out in a short time and at a reduced cost.

 - Learn more
- Expert Determination**

A consensual procedure in which the parties submit a specific matter (e.g., a technical question) to one or more experts who make a determination on the matter.

 - Learn more
- WIPO ADR Resources and Publications:**
 - General information
 - Select a dispute resolution clause
 - Calculate your case fees
 - WIPO Mediation, Arbitration, Expedited Arbitration and Expert Determination Rules
- ADR Clauses in Model R&D Agreements**

Parties involved in R&D collaborations and technology transfer transactions often use model agreements as a basis for drafting and negotiating their contracts. To help optimize dispute resolution in R&D and technology transfer, the WIPO Center collaborates with concerned stakeholders and entities in the development and dissemination of model agreements for R&D collaborations, which recommend WIPO mediation and expedited arbitration options.

Examples include the Development of a Simplified Consortium Agreement (DESCA 2020) model consortium agreement for the European Union research funding program Horizon 2020, the Intellectual Property Agreement Guide (IPAG) model agreements developed by Austrian universities and corporations, the German Federal Ministry of Economics and Technology (BMWi) sample agreements for R&D cooperation, and the Spanish Patent and Trademark Office (OEPM) model agreements.
- Contact Information**

WIPO Arbitration and Mediation Center
34, chemin des Colombettes
CH-1211 Geneva 20
Switzerland
Tel: +4122 338 82 47
Fax: +4122 338 83 37
Email Address: arbitr.mail@wipo.int
Website: www.wipo.int/amc

ILPO's webpage on ADR

³⁴² Israel Patent Office, 'WIPO Mediation for IP and Technology Disputes' <http://www.justice.gov.il/En/Units/ILPO/Cooperation/Pages/Wipo-Mediation.aspx> accessed September 2018.

A.2.3 Mexican Institute of Industrial Property (IMPI Mexico)

IMPI Mexico and the WIPO Center entered into a cooperation agreement in September 2014 to raise awareness and promote the use of ADR for industrial property and technology disputes in Mexico.

Since then, IMPI Mexico and the WIPO Center have worked in close collaboration to spread the word among intellectual property stakeholders in Mexico, including multinational and small and medium companies, startups, universities, inventors and entrepreneurs.³⁴³

Examples of activities have included seminars and workshops, including in collaboration with Mexican intellectual property associations,³⁴⁴ and awareness raising campaigns by making available information online and via social media channels.

Mediación OMPI para controversias de propiedad intelectual y TICs en México

Colaboración IMPI México-OMPI

El Instituto Mexicano de la Propiedad Industrial (IMPI México) y el Centro de Arbitraje y Mediación de la OMPI han establecido una colaboración para promover el uso de los métodos alternativos de solución de controversias (en sus siglas en inglés ADR, *Alternative Dispute Resolution*) en México, para resolver controversias en materia de propiedad intelectual y tecnologías de la información y la comunicación (TICs).

Centro de Arbitraje y Mediación de la OMPI

Con oficinas en Ginebra, Suiza, y en Singapur, el Centro de Arbitraje y Mediación de la OMPI ofrece métodos ADR, como la mediación y el arbitraje, para permitir a los particulares resolver eficientemente sus controversias comerciales domésticas o internacionales.

El Centro de la OMPI es internacional y se especializa en litigios de propiedad intelectual y tecnología. El Centro de la OMPI se focaliza en controlar el tiempo y el costo de sus procedimientos.

¿Qué es la mediación?

La mediación es un procedimiento consensual no vinculante en el que un tercero neutral, el mediador, ayuda a las partes a solucionar la controversia, de conformidad con sus respectivos intereses. El mediador no puede imponer una decisión. El acuerdo de las partes tiene el efecto de un contrato.

Ventajas de la mediación

- Autonomía de las partes
- Neutralidad
- Tiempo y costo
- Soluciones creativas
- Mediador especializado
- Preservación de relaciones comerciales
- Confidencialidad

¿Cómo someter una controversia a Mediación OMPI?

a) Si existe un acuerdo de mediación entre las partes, las partes deberán:

- Completar y firmar la Solicitud de Mediación OMPI.
- Enviar la Solicitud al Centro de la OMPI por correo electrónico a arbitr.mail@wipo.int.

b) Si no existe un acuerdo de mediación entre las partes, la parte que desee proponer someter una controversia a Mediación OMPI (Solicitud unilateral de mediación) deberá:

- Completar y firmar la Solicitud de Mediación OMPI.
- Enviar la Solicitud al Centro de la OMPI por correo electrónico a arbitr.mail@wipo.int, con copia a la otra parte.
- Una vez recibida la Solicitud, el Centro de la OMPI podrá proporcionar información relativa al procedimiento de Mediación OMPI a la otra parte. Si la otra parte estuviese interesada en participar en la Mediación OMPI, deberá completar la sección 2 b) de la misma Solicitud que presentó la parte solicitante y enviarla al Centro de la OMPI por correo electrónico a arbitr.mail@wipo.int.

- Las partes pueden nombrar al mediador conjuntamente o solicitar al Centro de la OMPI que identifique candidatos (de México o internacionales) que cuenten con las aptitudes requeridas para el caso.
- La Mediación OMPI puede llevarse a cabo en el lugar en que las partes acuerden. IMPI México puede proporcionar asistencia logística a las partes (por ejemplo, salas de reuniones).
- Se aplicarán tasas y honorarios especiales en razón de la colaboración IMPI México-OMPI.

Principales etapas de la Mediación OMPI

```
graph TD
    A[Presentación de Solicitud de Mediación] --> B[Acuerdo de mediación Artículo 2.05 Reglamento de Mediación OMPI]
    A --> C[Solicitud unilateral Artículo 4 del Reglamento de Mediación OMPI]
    B --> D[Las partes firman acuerdo de mediación]
    C --> E[Las partes no firman acuerdo de mediación]
    D --> F[Nombramiento del mediador]
    E --> F
    F --> G[Contactos iniciales entre el mediador y las partes]
    G --> H[Organización de la primera reunión Acuerdo sobre un primer intercambio de documentos, en caso de ser necesario]
    H --> I[Primera reunión y reuniones siguientes]
    I --> J[Establecimiento de las reglas básicas del procedimiento]
    I --> K[Composición de un panel de mediación de las Cuadros Regulares]
    I --> L[Examen de los intereses de las partes]
    I --> M[Búsqueda de soluciones posibles]
    I --> N[Evaluación de las soluciones posibles]
    J --> O[Conclusión de la mediación]
    K --> O
    L --> O
    M --> O
    N --> O
    O --> P[Acuerdo]
    O --> Q[Cierre de la mediación sin acuerdo]
```

IMPI Mexico-WIPO Center information flyer

³⁴³ Mexican Institute of Industrial Property, 'Mediación OMPI para controversias de propiedad intelectual y TICs en México' https://www.gob.mx/cms/uploads/attachment/file/137298/Colaboracion_IMPI_Mexico-OMPI_final.pdf accessed September 2018.

³⁴⁴ The National Association of In-house Lawyers (*Asociación Nacional de Abogados de Empresa – ANADE*), and the Mexican Association for Intellectual Property Protection (*Asociación Mexicana para la Protección de la Propiedad Intelectual*), among others.

A.2.4 WIPO Technology and Innovation Support Center Program (TISC)

The WIPO TISC program³⁴⁵ in collaboration with IP authorities provides innovators in developing countries with access to locally based technology information and related services, helping them to exploit their innovative potential and create, protect, and manage their intellectual property rights.

Efficient dispute avoidance and resolution practices support the success of international and domestic R&D and transfer of technologies transactions. The WIPO TISC program and the WIPO Center cooperate to raise awareness of WIPO ADR, bringing practical information to the attention of the TISC program participants.

Time- and Cost-Efficient Resolution of R&D and Technology Transfer Disputes for TISCs

Technology and Innovation Support Centers (TISCs) benefit from a **50% reduction in registration and administration fees for alternative dispute resolution (ADR) services** provided by the **WIPO Arbitration and Mediation Center**. TISCs provide technology information and related services to researchers, inventors, and entrepreneurs in over 50 countries worldwide.

Institutions seeking to benefit from the reduction should include a note in the request submitted to the WIPO Arbitration and Mediation Center indicating their status as a TISC. Individuals should include an official document from a TISC with the request indicating that they are affiliated with or are clients of this TISC.

More information about the **WIPO Technology and Innovation Support Center** program can be found at: www.wipo.int/tisc

More information about the **WIPO Arbitration and Mediation Center** and its fees can be found at: www.wipo.int/amc

R&D and Technology Transfer Disputes

International and domestic **innovation, research and development (R&D) and transfer of technologies** involve a rich variety of **contracts and transactions**, including research contracts, collaborative projects, licensing, joint ventures, alliances, spin-offs and buyer-supplier relationships.

Such collaborations can involve **complex legal, commercial or management issues**, often including related **intellectual property (IP) rights**. Also, research partners from different institutional backgrounds may have diverging expectations and understandings of creating, using and exploiting IP rights.

Efficient dispute avoidance and resolution practices are key in such complex situations. Providing time- and cost-effective options, ADR procedures may help parties to find solutions to their disputes, without the need for court litigation, contributing to the continuation of research activities and commercialization of research results.



Areas of Dispute

A **careful choice** of dispute resolution framework should feature in negotiations of sometimes multiple contracts **at different stages of R&D activities, commercialization and technology transfer processes**. Where several contracts relating to R&D collaborations are concluded at different stages of a project, **consistent dispute resolution provisions** should be considered to enable an efficient dispute resolution process and, if necessary, the potential consolidation of disputes.

Preparatory phase of Research Collaboration Commercialization Technology Transfer	Conclusion of Contract	Duration of Collaboration	Outside / After the Collaboration
<ul style="list-style-type: none">- Letters of Intent- Confidentiality Agreements- Memoranda of Understanding- Options	<ul style="list-style-type: none">- Assignment Contracts- Consortium Agreements- Consultancy Agreements- Intellectual Property Sale and Purchase Agreements- Licensing Agreements- Material Transfer Agreements- Outsourcing Agreements- Partnership Agreements- Research and Development Agreements- Research and Development Master Agreements- Research Service Contracts		<ul style="list-style-type: none">- Assignment Contracts- Commercial Contracts- Research and Development Service Contracts- Sub-Contracts

WIPO Arbitration and Mediation Center

With offices in **Geneva, Switzerland** and in **Singapore**, the WIPO Arbitration and Mediation Center offers **ADR options** to enable parties to efficiently settle their **domestic or cross-border commercial disputes**. The ADR options offered by the WIPO Center are **mediation, arbitration, expedited arbitration, and expert determination**. The WIPO Center is **international and specialized in IP and technology disputes**. It has a strong focus on **controlling the time and cost of its proceedings**.

WIPO ADR procedures are organized to stimulate positive opportunities for party settlement. Almost **70% of the mediation** procedures administered by the WIPO Center have **settled**. Even in **arbitration**, **40% of WIPO cases settle** before any formal decision is issued.

WIPO Center information flyer for TISCs³⁴⁶

³⁴⁵ World Intellectual Property Organization, 'Technology and Innovation Support Centers' <http://www.wipo.int/tisc/en/> accessed September 2018.

³⁴⁶ The flyer is also available in other languages.

A.3 WIPO Center Collaboration Examples: Case Administration

A.3.1 Intellectual Property Office of Singapore (IPOS)

WIPO Mediation

In Singapore, IPOS has offered since January 2012 mediation services for trademark (opposition, invalidation and revocation) and subsequently also patent proceedings before IPOS in conjunction with the WIPO Center. Parties can agree to refer such disputes to the WIPO Center for mediation in accordance with the WIPO Mediation Rules. IPOS and the WIPO Center make available forms to facilitate the submission of disputes to WIPO mediation, and offer discounted fees for such referrals.³⁴⁷

Parties may submit to WIPO Mediation at any time before a final decision is issued by IPOS, and IPOS will proactively inform parties about the possibility to submit their dispute to WIPO Mediation at an early stage of the proceedings, after parties have filed their pleadings.³⁴⁸

If both parties agree to mediate, they can jointly submit a Request for WIPO Mediation to the WIPO Center and IPOS. If one party wishes to propose mediation to the other party, the proposing party completes the Request for WIPO Mediation and sends it to the WIPO Center Office in Singapore as well as to the other party and IPOS. The WIPO Center approaches the other party to help parties consider the Request for WIPO Mediation.

IPOS makes available a Mediation Promotion Scheme³⁴⁹ to encourage parties in IPOS proceedings to use mediation by funding the process, so that more parties can experience mediation as an attractive alternative to a hearing at IPOS for resolving their disputes satisfactorily.

If the parties are unable to fully resolve their dispute, the initiating party is to inform IPOS in writing of such, and the remaining issues will be returned to IPOS for adjudication.

Case Example³⁵⁰: A WIPO Mediation of Trademark Opposition Proceedings at IPOS

A Singaporean construction company filed oppositions against applications for the registration of three trademarks with IPOS, alleging similarity of key components to its trademark. The trademarks in question were applied for by three commercially connected entities based in Singapore, Malaysia and Indonesia. In addition, parties had long pending cross-border commercial and intellectual property disputes. The parties agreed to submit all trademark oppositions to WIPO mediation in Singapore consolidated into a single mediation, and stated that the parties wished to resolve all the outstanding proceedings on a global basis.

The WIPO Center proposed a Singaporean intellectual property lawyer as mediator. A one-day mediation session took place at Maxwell Chambers in Singapore. The parties settled the trademark disputes as well as their additional commercial disputes four months after the commencement of the mediation.

³⁴⁷ World Intellectual Property Organization Arbitration and Mediation Center, 'WIPO Mediation for Proceedings Instituted in the Intellectual Property Office of Singapore' <http://www.wipo.int/amc/en/center/specific-sectors/ipos/mediation> accessed September 2018.

³⁴⁸ Intellectual Property Office of Singapore, 'Mediation Option for Trade Mark Proceedings' (January 12, 2015) <https://www.ipos.gov.sg/protecting-your-ideas/hearings-mediation/mediation> accessed September 2018.

³⁴⁹ Intellectual Property Office of Singapore, 'Mediation Promotion Scheme' <https://www.ipos.gov.sg/growing-your-business-with-ip/funding-assistance> accessed September 2018.

³⁵⁰ Additional Examples of 'WIPO Mediations for Proceedings Instituted in Intellectual Property of Singapore (IPOS)' <http://www.wipo.int/amc/en/center/specific-sectors/ipos/mediation> accessed September 2018.

Request for WIPO Mediation

1. Parties

Please provide the following contact information:

Initiating party in the dispute		Responding party in the dispute	
Name	:	Name	:
Country of domicile	:	Country of domicile	:
Tel	:	Tel	:
Email	:	Email	:
Address	:	Address	:
Represented by	:	Represented by	:
Tel	:	Tel	:
Email	:	Email	:
Address	:	Address	:

2. Dispute

Please provide a brief description of the dispute:

3. Time period for mediation

The following period will be set aside for mediation, as may be extended upon agreement:

- 30 days
 60 days
 90 days

4. Submission to WIPO Mediation

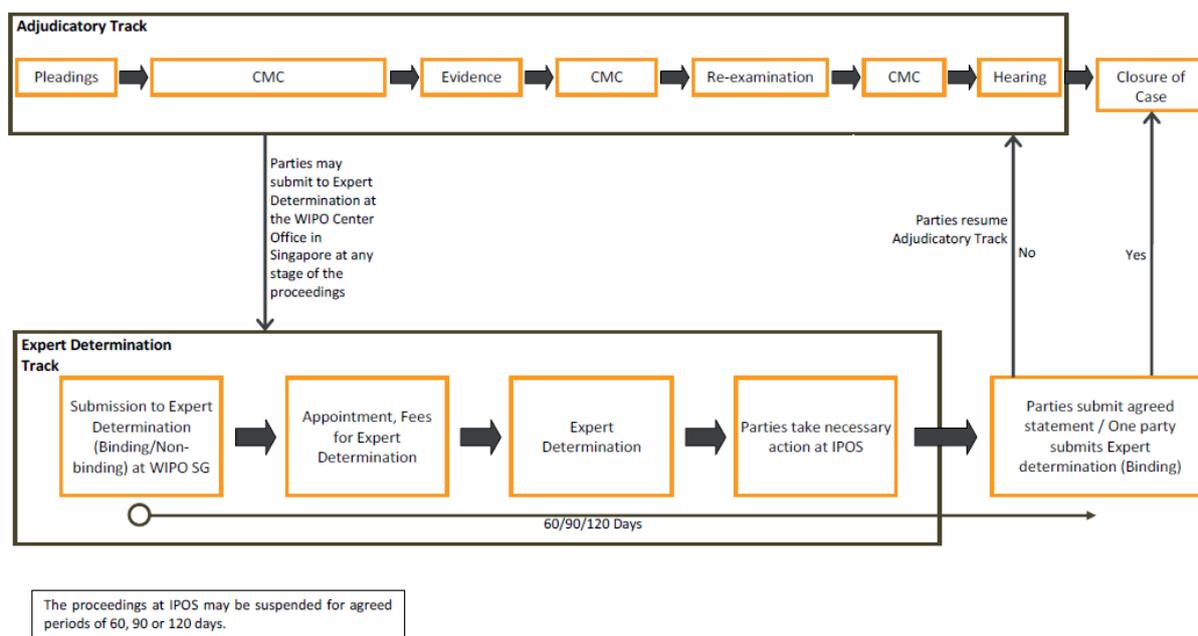
Initiating party in the dispute	Responding party in the dispute
The initiating party in the dispute agrees to submit the above-described dispute to mediation in accordance with the WIPO Mediation Rules.	The responding party in the dispute agrees to submit the above-described dispute to mediation in accordance with the WIPO Mediation Rules.
Please sign this form and submit it to arbiter.mail@wipo.int .	Please sign this form and submit it to arbiter.mail@wipo.int .
Signature : _____	Signature : _____
Place and Date : _____	Place and Date : _____

WIPO Expert Determination

In Singapore, IPOS has offered expert determination services for contentious patent proceedings before IPOS in conjunction with the WIPO Center since April 2014. Parties are allowed to submit their dispute to WIPO Expert Determination at any stage of the patent proceedings before IPOS.

If the parties wish to proceed with WIPO Expert Determination, they must submit an Agreement and Request for WIPO Expert Determination in IPOS Patent Proceedings to the WIPO Center.

IPOS and the WIPO Center make available forms to facilitate the submission of disputes to WIPO Expert Determination, and offer discounted fees for such referrals. The WIPO Center will administer the proceedings and assist in the appointment of an appropriate expert.³⁵¹ Parties can request for the proceedings before IPOS to be suspended to account for the expert determination hearing.³⁵²



WIPO Expert Determination for patent proceedings at IPOS

³⁵¹ World Intellectual Property Organization Arbitration and Mediation Center, 'WIPO Expert Determination for Proceedings Instituted in the Intellectual Property Office of Singapore (IPOS)' <http://www.wipo.int/amc/en/center/specific-sectors/ipos/expert-determination/> accessed September 2018.

³⁵² Intellectual Property Office of Singapore 'Expert Determination Option for Patent Proceedings' (IPOS, September 1, 2014) <https://www.ipos.gov.sg/protecting-your-ideas/hearings-mediation/expert-determination> accessed September 2018.

A.3.2 Intellectual Property Office of the Philippines (IPOP HL)

In the Philippines, IPOP HL has offered mediation services for intellectual property disputes since 2010. Mediation is mandatory for the following types of intellectual property disputes administered by IPOP HL:³⁵³

- administrative complaints for violation of intellectual property rights and/or unfair competition
- *inter partes* cases, such as trademark opposition and cancellation proceedings
- disputes involving technology transfer payments
- disputes relating to the terms of a license involving the author's rights to public performance or other communication of his work
- cases on appeal to the Office of the Director General from decisions of the Bureau of Legal Affairs and the Documentation, Information and Technology Transfer Bureau³⁵⁴
- all other cases which may be referred to mediation during the settlement period declared by the Director General

Mediation services for disputes pending before IPOP HL can be provided by different ADR institutions, depending on the nature of the dispute.³⁵⁵ Generally, disputes can be referred to the IPOP HL Alternative Dispute Resolution Services (ADRS) for mediation, to be administered according to the IPOP HL Mediation Rules.³⁵⁶ Since 2011, IPOP HL has mediated over 1,700 cases³⁵⁷.

Since April 2015, where one or both parties are domiciled outside of the Philippines, the dispute can also be submitted to the WIPO Center to be administered in accordance with the WIPO Mediation Rules. Parties can submit an application for mediation to the WIPO Center after their case has been referred to IPOP HL for mandatory briefing on the mediation options.³⁵⁸ For parties that opt for WIPO Mediation, the WIPO Center will administer the proceedings and also assist in the appointment of an appropriate mediator.³⁵⁹ IPOP HL and the WIPO Center make available forms to facilitate the submission of disputes to WIPO mediation, and offer discounted fees for such referrals.³⁶⁰

³⁵³ Intellectual Property Office of the Philippines, 'Office Order No. 154'
<http://ipophil.gov.ph/images/WhatsNew2015/Announcements/OfficeOrderNo154s2010.pdf> accessed September 2018.

³⁵⁴ In these cases, the mediator who mediated the dispute at the Originating Office will not be called on to mediate the case, unless both parties agree otherwise. See Intellectual Property Office of the Philippines 'Office Order No. 154'
<http://ipophil.gov.ph/images/WhatsNew2015/Announcements/OfficeOrderNo154s2010.pdf> accessed September 2018.

³⁵⁵ Intellectual Property Office of the Philippines 'Supplemental Guidelines to Office Order No. 154, s. 2010'
http://www.ipophil.gov.ph/images/2017Uploads/Comp_Mediation-Rules.pdf accessed September 2018.

³⁵⁶ Intellectual Property Office of the Philippines 'Alternative Dispute Resolution'
<http://www.ipophil.gov.ph/services/ip-cases2/alternative-dispute-resolution> accessed September 2018.

³⁵⁷ Status as of May 2017 provided by Intellectual Property Office of the Philippines.

³⁵⁸ See http://www.wipo.int/export/sites/www/amc/en/docs/ipophil_agreementrequest.doc accessed September 2018.

³⁵⁹ An indicative list of mediators can be found at WIPO's website. See World Intellectual Property Organization Arbitration and Mediation Center 'WIPO/IPOP HL Panel of Mediators'
<http://www.wipo.int/amc/en/center/specific-sectors/ipophil/panel/> accessed September 2018.

³⁶⁰ World Intellectual Property Organization Arbitration and Mediation Center, 'WIPO Mediation Proceedings Instituted in the Intellectual Property Office of the Philippines (IPOP HL)'
<http://www.wipo.int/amc/en/center/specific-sectors/ipophil/> accessed September 2018.

If the party initiating the claim fails to attend the mediation, the case may be dismissed. If the opposing party fails to attend the mediation, he may be declared to be in default. The absent party may be required to reimburse the other party up to treble the costs incurred, including any lawyers' fees.³⁶¹

ADR Form No. 1



Alternative Dispute Resolution (ADR)
Services Bureau of Legal Affairs



WIPO Arbitration and Mediation Center

AGREEMENT AND REQUEST FOR MEDIATION / MEDIATOR'S REPORT

ORIGINATING OFFICE: _____
Hearing Officer: _____

Opposer, _____
-vs- _____
Respondent-Applicant.

IPC CASE NO: _____
Opposition to: _____
Application No. _____
TM: " _____ "

DATE REFERRED: _____
60 days FROM REFERRAL: _____
90 days FROM REFERRAL: _____

PRE-MEDIATION STAGE					
DATES	OPPOSER	COUNSEL	RESPONDENT	COUNSEL	STATUS

BRIEFER: _____
SIGNATURE OVER PRINTED NAME/DATE

CONSENT TO SUBMIT DISPUTE TO MEDIATION:
The parties agree to undergo mediation with the assistance of a Mediator and commit to follow the protocols, fees and guidelines of the proceedings established by:

IPOPHL
 the WIPO Arbitration and Mediation Center

OPPOSER /DATE

OR NO. (OPPOSER): _____

RESPONDENT- APPLICANT/DATE

OR NO. (RESPONDENT): _____

MEDIATION SESSIONS					
DATES	OPPOSER	COUNSEL	RESPONDENT	COUNSEL	STATUS

EXTENSION					
DATES	OPPOSER	COUNSEL	RESPONDENT	COUNSEL	STATUS

ACTION TAKEN/STATUS:

SETTLED (with following Attachment/s)

Agreement

Withdrawal of the Complaint

Undertaking

NOT- SETTLED

BACK TO ORIGINATING OFFICE

Awaiting Compromise Agreement

Recommendation: _____

TERMINATED, FOR OTHER REASONS: Compromise

Refused to mediate (Opposer/Respondent)

briefing without briefing

Discontinued Mediation: _____

Non-appearance of parties (complainant/respondent)

Party/ies not fully authorized to enter into Compromise Agmt.

Other reason/s: _____

IPOPHL Model Agreement and Request for Mediation/Mediator's Report

³⁶¹ Intellectual Property Office of the Philippines 'Office Order No. 154'
http://www.ipophil.gov.ph/images/IPCases/ADR/Office_Order_No._154_rules_of_procedure_for_mediation.pdf accessed September 2018.

A.3.3 United States Patent and Trademark Office (USPTO)

The Trademark Trial and Appeal Board (TTAB) and the Patent Trial and Appeal Board (PTAB) of the USPTO encourage parties to consider ADR as a means of settling the issues raised in any trademark or patent proceedings. The WIPO Center is one of the listed dispute resolution services providers for TTAB and PTAB proceedings.

NOTICE CONCERNING ALTERNATIVE DISPUTE RESOLUTION (ADR)

The Trademark Trial and Appeal Board encourages parties to consider alternative dispute resolution as a means of settling the issues raised in any opposition or cancellation proceeding. Although more than 95% of Board proceedings are decided prior to trial (by settlement or by entry of pre-trial judgment), consideration of alternative dispute resolution techniques early in a proceeding might produce a quicker, mutually agreeable resolution of a dispute or might, at least, narrow the scope of discovery or the issues for trial. In either circumstance, alternative dispute resolution might save parties time and money.

Many non-profit organizations, both inside and outside the intellectual property field, offer alternative dispute resolution services. Listed below are the names and addresses of organizations that have indicated that they can make arrangements for alternative dispute resolution. The listings are provided for the convenience of parties involved in cases before the Board; the Board does not sponsor or endorse any particular organization's alternative dispute resolution services.

International Trademark Association Telephone: (212) 642-1732 Fax: (212) 768-7796 http://www.inta.org/Mediation/Pages/Mediation.aspx e-mail: cclark@inta.org	CPR Institute for Dispute Resolution Telephone: (212) 949-6490 Fax: (212) 949-8859 www.cpradr.org e-mail: info@cpradr.org
American Intellectual Property Law Association (AIPLA) 2001 Jefferson Davis Highway, Suite 203 Arlington, Virginia 22202 Telephone: (703) 415-0780 Fax: (703) 415-0786	American Arbitration Association (AAA) Headquarters 140 West 51 st Street New York, New York 10020-1203 Telephone: (212) 484-3266 Fax: (212) 307-4387
WIPO Arbitration and Mediation Center 34, chemin des Colombettes 1211 Geneva 20 Switzerland Telephone: +4122 338 8247 http://www.wipo.int/amc/en/ e-mail: arbitr.mail@wipo.int	

If parties to a Board proceeding consider using alternative dispute resolution, the Board would like to know; and if the parties actually engage in alternative dispute resolution, the Board would be interested to learn what mechanism (e.g., arbitration, mediation, etc.) was used and with what general result. Such a statement from the parties is not required but would be helpful to the Board in assessing the value of alternative dispute resolution to parties involved in Trademark Trial and Appeal Board proceedings. To report any experience with ADR, please forward a summary of the particulars to the following email address: TTAB_Settlement_comments@uspto.gov.

TTAB Notice Concerning ADR

A.3.4 National Directorate Copyright of Colombia (DNDA)

In Colombia, DNDA has offered conciliation services for disputes involving copyright and related rights since 2012.³⁶² Conciliations at DNDA are administered according to its Internal Conciliation and Arbitration Rules, which are based on Colombia's laws on conciliation.

Requests for conciliation can be filed by one or both parties to the dispute. The parties can choose to appoint their own conciliator for the hearing from the list of conciliators provided by DNDA. Otherwise, DNDA can either appoint one of its internal officers as the conciliator,³⁶³ or choose an external conciliator that satisfies its requirements and has been previously registered in that list.

If a party fails to attend the conciliation hearing, the conciliator can issue a certificate that can be submitted in subsequent court proceedings. If the parties are able to reach a settlement, the terms of the settlement will be recorded by the conciliator in a certificate that is enforceable as a court judgment. The conciliator will issue a certificate stating the outcome of the mediation in the event that no settlement is reached.

Pursuant to a collaboration agreement with DNDA, the WIPO Center administers mediation proceedings concerning copyright and related rights in Colombia. DNDA and the WIPO Center make available forms to facilitate the submission of disputes to WIPO mediation, and offer discounted fees for such referrals.³⁶⁴



DNDA's webpage on ADR

³⁶² National Directorate Copyright of Colombia <http://derechodeautor.gov.co/historia-centro-de-conciliacion> accessed September 2018.

³⁶³ National Directorate Copyright of Colombia internal officers are appointed as conciliators through a rotation system. A list of conciliators at the DNDA can be viewed at the website for the *Programa Nacional de Conciliación*. See Ministry of Justice and Law, 'Centro de Conciliación y Arbitraje de la Dirección Nacional de Derecho de Autor "FERNANDO HINESTROSA" (Programa Nacional de Conciliación) http://conciliacion.gov.co/portal/conciliadores_centro/Centroid/3390 accessed September 2018.

³⁶⁴ World Intellectual Property Organization Arbitration and Mediation Center, 'Mediación OMPI para controversias en materia de derechos de autor presentadas ante la Dirección Nacional de Derecho de Autor (DNDA) de Colombia' <http://www.wipo.int/amc/es/center/specific-sectors/dnda/> accessed September 2018.

A.3.5 Korea Copyright Commission (KCC)

In the Republic of Korea, KCC has offered mediation services for copyright disputes since 1988, and has provided court-annexed mediation services at the Seoul District Court since 2013.³⁶⁵ As of December 2015, KCC has administered a total of 1,777 mediation requests.³⁶⁶ Mediations at KCC are administered according to the KCC Conciliation Rules and the Copyright Act.

Requests for mediation can be filed by one or both parties to the dispute, and KCC procedures will be generally completed within three months.³⁶⁷ The Copyright Act provides that information disclosed during the mediation is confidential, and cannot be admitted by the parties in subsequent litigation or arbitration proceedings.³⁶⁸

If a party fails to attend the mediation, the mediators can issue a certificate that can be submitted in subsequent court proceedings. If the parties are able to reach a settlement, the terms of the settlement will be recorded by the conciliator in a certificate that is binding and enforceable by the parties in the same way as a court order.³⁶⁹

KCC can also refer disputes to the WIPO Center for mediation. KCC and the WIPO Center make available forms to facilitate the submission of disputes to WIPO mediation,³⁷⁰ and offer discounted fees for such referrals.³⁷¹



KCC-WIPO Center information flyer (available also in Korean)

³⁶⁵ KCC has provided similar mediation services for copyright claims litigated at the Seoul District Court since 2013. See Lee Hae Wan, 'Introduction of KCC ADR System and Achievements' in WIPO Arbitration and Mediation Center and the Korea Copyright Commission, 2014 WIPO-KCC Copyright Mediation Workshop (2014) 62.

³⁶⁶ 2015 KCC mediation statistics – available at <http://www.copyright.or.kr/customer/adr/main.do> accessed September 2018.

³⁶⁷ Lee Hae Wan, *ibid.* 361, 56.

³⁶⁸ Articles 115 and 116, Copyright Act of 1957, Republic of Korea; Lee Hae Wan, *ibid.* 361, 54.

³⁶⁹ Article 117, Copyright Act of 1957, Republic of Korea; Lee Hae Wan, *ibid.* 361, 52.

³⁷⁰ Information on the Request for Mediation for KCC disputes <http://www.wipo.int/amc/en/center/specific-sectors/kcc/> accessed September 2018.

³⁷¹ Lee Hae Wan, *ibid.* 361, 136.

A.3.6 Korea Creative Content Agency (KOCCA)

KOCCA is a governmental organization in the Republic of Korea affiliated with the Ministry of Culture, Sports and Tourism, and dedicated to fostering Korean cultural content industry. According to the Content Industry Promotion Act of Korea, the Content Dispute Resolution Committee (KCDRC) of KOCCA provides mediation for the resolution of the disputes arising out of the use of content.

KCDRC Mediation Rules allow one party to file a mediation request unilaterally without the consent of the other party, but the mediation will only be commenced with the consent of both parties. The settlement agreement resulting from KCDRC mediation is enforceable with the same effect as a final court judgment. Since the establishment of KCDRC in 2011, it has been receiving an increasing number of mediation requests.³⁷²

To promote alternative dispute resolution of content disputes in the Republic of Korea, KOCCA and the WIPO Center concluded a Memorandum of Understanding in September 2012. Pursuant to this collaboration agreement, parties have the option of submitting international disputes to WIPO Mediation. KOCCA and the WIPO Center make available forms to facilitate such submission, and offer discounted fees for such referrals.³⁷³



KOCCA's webpage on ADR

³⁷² For example, in 2014 it administered 157 mediation requests.

³⁷³ Information on the Request for Mediation for KOCCA disputes available at <http://www.wipo.int/amc/en/center/specific-sectors/kocca/> accessed September 2018.

A.3.7 Patent Office of the Republic of Poland (PPO)

Effective June 1, 2018, the WIPO Arbitration and Mediation Center and PPO collaborate to offer to parties to PPO trademark opposition proceedings the option to resolve such disputes through mediation under the WIPO Mediation Rules.³⁷⁴ The WIPO Mediation option may be especially advantageous for parties seeking to settle trademark opposition related disputes in multiple jurisdictions.

Once an opposition to a trademark application is filed, PPO notifies the applicant of the trademark and informs both parties of the possibility of an amicable settlement of the dispute within two months of the date of notification by PPO.³⁷⁵ The two-month period may be extended up to a total of six months upon the joint request of the parties.³⁷⁶

Mediation also is available in proceedings relating to the opposition against the designation of the Republic of Poland for the extension of the protection for an international trademark.³⁷⁷

Parties trying to reach an amicable settlement may submit a Request for Mediation to the WIPO Center. The party that wishes to commence a mediation shall submit a Request for Mediation to the Center, with a copy to the other party. The WIPO Center will provide parties with information on next steps of the procedure, fees and, if requested by the parties, a list of potential mediators. Throughout the procedure, the WIPO Center will liaise with parties and mediator to ensure optimal procedural efficiency.³⁷⁸

Before the expiration of the time limit for amicable settlement, parties inform PPO of its outcome. In case of settlement, the parties can request PPO to terminate trademark opposition proceedings. The parties benefit from the reimbursement of 50% of PPO trademark opposition fee where the settlement has been reached with the two-month (or six-month, accordingly) period for amicable settlement. If the parties fail to reach settlement during the six-months period but they want to continue with the mediation, the opposition procedure before PPO may be suspended upon joint request of the parties.

³⁷⁴ The WIPO Mediation Rules as well as the PPO-WIPO Model Request for Mediation are available in English and Polish.

³⁷⁵ Article 152¹⁹ par. 1 of Industrial Property Law.

³⁷⁶ Article 152¹⁹ par. 2 of Industrial Property Law.

³⁷⁷ Article 152^{6a} par. 3 of Industrial Property Law.

³⁷⁸ World Intellectual Property Organization Arbitration and Mediation Center, 'WIPO Mediation for Proceedings Instituted in the Patent Office of the Republic of Poland (PPO)' <http://www.wipo.int/amc/en/center/specific-sectors/ipoffices/poland/> accessed September 2018.



PATENT OFFICE OF THE
REPUBLIC OF POLAND



Request for WIPO Mediation

1. Parties

Please provide the following contact information:

Initiating party in the dispute		Responding party in the dispute	
Name	:	Name	:
Country of domicile	:	Country of domicile	:
Tel	:	Tel	:
Email	:	Email	:
Address	:	Address	:
Represented by	:	Represented by	:
Tel	:	Tel	:
Email	:	Email	:
Address	:	Address	:

2. Dispute

Please provide a brief description of the dispute:

3. Submission to WIPO Mediation

Initiating party in the dispute		Responding party in the dispute	
The initiating party in the dispute agrees to submit the above-described dispute to mediation in accordance with the WIPO Mediation Rules.		The responding party in the dispute 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 .		Please sign this form and submit it to arbiter.mail@wipo.int .	
Signature	:	Signature	:
Place and Date	:	Place and Date	:

PPO-WIPO Model Request for Mediation

A.4 Collaboration Examples: ADR Options in R&D Model Agreements

A.4.1 Spanish Patent and Trademark Office (OEPM)

Parties involved in R&D collaborations and technology transfer transactions often use model agreements as a basis for drafting and negotiating their contracts. To help optimize dispute resolution in R&D and technology transfer, OEPM and the WIPO Center, together with representatives from the Ministry of Economy, Industry and Competitiveness (MINECO), the Higher Council for Scientific Research (CSIC) and the Licensing Executives Society (LES) Spain and Portugal, collaborated in the development and dissemination of model agreements for R&D collaborations, which recommend WIPO mediation and expedited arbitration options.

In September 2016, OEPM launched a number of such model R&D and technology transfer agreements, including a material transfer agreement, non-disclosure agreement and patent/utility model licensing agreement.³⁷⁹

The screenshot shows the OEPM website interface. The main content area is titled 'Contract Templates' and provides information about technology transfer agreements. It includes a table with download links for various agreement types in Spanish and English.

Agreement	Usage guide	Spanish version	English version
Confidentiality	Download (v.23.09.2016)	Download (v.23.09.2016)	Download (v.23.09.2016)
Transferring Material	Download (v.23.09.2016)	Download (v.23.09.2016)	Download (v.23.09.2016)
License (Public-Company Entity)	Download (v.24.09.2017)	Download (v.23.09.2016)	Download (v.23.09.2016)
License (Company-Company)	Download (v.24.09.2017)	Download (v.28.12.2016)	Download (v.23.09.2016)

OEPM Model R&D Agreements (available also in Spanish)

OEPM and the WIPO Center also collaborate to raise awareness of the advantages of using ADR to resolve industrial property and technology disputes in Spain.³⁸⁰

³⁷⁹ Spanish Patent and Trademark Office (OEPM), 'Contract Templates' http://www.oepm.es/en/propiedad_industrial/transferencia_de_tecnologia/Modelos_de_Contratos/ accessed September 2018.

³⁸⁰ Spanish Patent and Trademark Office (OEPM), 'Mediation and Arbitration' https://www.oepm.es/en/propiedad_industrial/Mediacion_y_Arbitraje/ accessed September 2018.

Appendix B: WIPO Center References

B.1 WIPO ADR Rules

WIPO Mediation Rules	http://www.wipo.int/amc/en/mediation/rules
WIPO Expert Determination Rules	http://www.wipo.int/amc/en/expert-determination/rules
WIPO Expedited Arbitration Rules	http://www.wipo.int/amc/en/arbitration/expedited-rules
WIPO Arbitration Rules	http://www.wipo.int/amc/en/arbitration/rules

B.2 Fees for ADR Services under WIPO Rules³⁸¹

The fees below apply to cases submitted to WIPO Mediation, Arbitration, Expedited Arbitration and Expert Determination in accordance with the WIPO Schedule of Fees. Under some collaborations between the WIPO Center and IPOs, discounted fees have been agreed.³⁸²

B.2.1 Mediation

Amount in Dispute	Administration Fees ³⁸³	Mediator's Fees	
Up to USD 250,000	USD 250	USD 2,500 (*)	
Over USD 250,000	0.10% of the value of the mediation, up to a maximum fee of USD 10,000	USD 300 – 600 per hour (**)	USD 1,500 – 3,500 per day (**)

(*) Indicative rates for 10 hours of preparation and mediation.

(**) Indicative rates.

³⁸¹ World Intellectual Property Organization Arbitration and Mediation Center, 'Mediation, (Expedited) Arbitration, Expert Determination Fee Calculator' <http://www.wipo.int/amc/en/calculator/adr.jsp> accessed September 2018. A 25% reduction on the Center's administration fees applies if a party (or both parties) to the dispute is (are) named as applicant or inventor in a published PCT application, holders of international registrations under the Hague system or the Madrid system, or WIPO Green technology providers or seekers.

³⁸² See examples in Appendix A.3.

³⁸³ The value of the mediation is determined by the total value of the amounts claimed by the parties. Where the monetary value of the mediation is not indicated, or where the dispute concerns issues that are not quantifiable in monetary amounts, an administration fee of USD 1,000 shall be payable, subject to adjustment. World Intellectual Property Organization Arbitration and Mediation Center, 'Schedule of Fees and Costs' <http://www.wipo.int/amc/en/mediation/fees/> accessed September 2018.

B.2.2 Expedited Arbitration and Arbitration

Type of Fee	Amount in Dispute	Expedited Arbitration	Arbitration
Registration Fee	Any amount	USD 1,000	USD 2,000
Administration Fee^(*)	Up to USD 2.5M	USD 1,000	USD 2,000
	Over USD 2.5M and up to USD 10M	USD 5,000	USD 10,000
	Over USD 10M	USD 5,000 +0.05% of amount over USD 10M up to a maximum fee of USD 15,000	USD 10,000 +0.05% of amount over USD 10M up to a maximum fee of USD 25,000
Arbitrator(s) Fees	Up to USD 2.5M	USD 20,000 (fixed fee) (**)	As agreed by the Center in consultation with the parties and the arbitrator(s) Indicative rate(s): USD 300 to 600 per hour.
	Over USD 2.5M and up to USD 10M	USD 40,000 (fixed fee) (**)	
	Over USD 10M	As agreed by the Center in consultation with the parties and the arbitrator	

(*) Each bracket indicates the total amount of the fees payable in a dispute, e.g. the administration fee payable in an expedited Arbitration when the amount in dispute is \$5million is \$5,000 (and not a fee of \$6,000 which would have resulted from adding the fees of \$5,000 and \$1,000).

(**) May be reduced or increased based on the complexity of the subject matter of the dispute and the time spent by the arbitrator.

B.2.3 Expert Determination

Administration Fees ³⁸⁴	Expert's Fees (*)	
0.10% of the value of the expert determination, subject to a maximum of USD 10,000	USD 300 – 600 per hour	USD 1,500 – 3,500 per day

(*) Indicative rates

³⁸⁴ The value of the expert determination is determined by the total value of the amounts claimed by the parties. Where the monetary value of the expert determination is not indicated, or where the dispute concerns issues that are not quantifiable in monetary amounts, an administration fee of USD 1,000 shall be payable, subject to adjustment. World Intellectual Property Organization Arbitration and Mediation Center, 'Schedule of Fees and Costs' <http://www.wipo.int/amc/en/expert-determination/fees/index.html> accessed September 2018.

B.3 Model WIPO ADR Clauses and Agreements

The WIPO Center provides sample contract clauses for the submission of future disputes and submission agreements for existing disputes at <http://www.wipo.int/amc/en/clauses/index.html>. These model clauses and agreements allow parties to submit their dispute to WIPO Mediation, Expert Determination, Expedited Arbitration and/or Arbitration (or combinations of these procedures), and are also available in Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian and Spanish.

B.3.1 WIPO Clause Generator

To assist parties in the drafting of clauses and submission agreements, the WIPO Center makes available the WIPO Clause Generator.³⁸⁵ This WIPO tool allows parties to develop tailored clauses and submission agreements by selecting WIPO ADR procedures, core elements, such as place and language of proceedings and applicable law, and, if desired, additional elements, including qualifications of neutral.

The screenshot shows the 'WIPO Clause Generator' interface. The title is 'WIPO Clause Generator' and the step is 'Step 3 – Build your clause: WIPO Mediation followed, in the absence of a settlement, by Arbitration Clause'. The interface is divided into a left sidebar and a main content area. The sidebar has sections for 'Mediation' and 'Arbitration'. Under 'Mediation', there are 'Core Elements' (Place of Mediation, Language of the Mediation, Duration of the Mediation, Proceedings) and 'Additional Elements' (Qualifications of the Mediator, Conduct of the Mediation). Under 'Arbitration', there are 'Core Elements' (Number of Arbitrators, Place of Arbitration, Language of Arbitration, Substantive Law) and 'Additional Elements' (Appointment Procedure, Qualifications of the Arbitrators, ECAF, Evidence, Time Period of Delivery of the Final Award, Appeal). The main content area shows a radio button for 'The place of mediation shall be [specify place]'. Below it are 'Clear' and 'Next' buttons. A large text box contains the generated clause: '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].'

WIPO ADR Clause Generator

³⁸⁵ World Intellectual Property Organization Arbitration and Mediation Center, 'WIPO Clause Generator' <http://www.wipo.int/amc-apps/clause-generator/> accessed September 2018.

B.3.2 WIPO Mediation Followed, in the Absence of a Settlement, by Court Litigation

To facilitate parties' submission of their disputes to mediation while retaining court options, the WIPO Center makes available model clauses and submission agreements providing for WIPO Mediation followed, in the absence of a settlement, by court litigation.³⁸⁶

Future Disputes: WIPO Mediation Followed, in the Absence of a Settlement, by Court Litigation Clause

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, the courts of [specify place] shall have exclusive jurisdiction. 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 courts of [specify place] shall have exclusive jurisdiction. The dispute, controversy or claim shall be decided in accordance with the law of [specify jurisdiction].

Existing Disputes: WIPO Mediation Followed, in the Absence of a Settlement, by Court Litigation Submission Agreement

We, the undersigned parties, hereby agree to submit to mediation in accordance with the WIPO Mediation Rules the following dispute:

[brief description of the dispute]

The place of mediation shall be [specify place]. The language to be used in the mediation shall be [specify language].

We further agree that, if, and to the extent that, the dispute has not been settled pursuant to the mediation within [60][90] days of the commencement of the mediation, the courts of [specify place] shall have exclusive jurisdiction. 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 courts of [specify place] shall have exclusive jurisdiction. The dispute shall be decided in accordance with the law of [specify jurisdiction].

³⁸⁶ World Intellectual Property Organization Arbitration and Mediation Center, http://www.wipo.int/amc/en/clauses/med_court/ accessed September 2018.

B.3.3 Unilateral Request for WIPO Mediation

In addition to its model clauses and submission agreements for consensual referral to WIPO ADR, the WIPO Center makes available a model Request for Mediation to facilitate submission of a dispute to mediation in cases where there is no mediation agreement between the parties, in accordance with Article 4(a) of the WIPO Mediation Rules. Similar options are also available under Article 6 of the WIPO Expert Determination Rules.



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 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 and to the requesting party.

Place and Date: _____

Signature: _____

Model Request for WIPO Mediation

B.4 Specialized WIPO ADR Services for Specific Schemes

Specific areas of intellectual property transactions may benefit from targeted adaptations of the standard WIPO ADR framework, for example in relation to rules, fees and clauses. Such adaptations promote efficiency gains through ADR processes that reflect legal and business standards and needs of the area. In addition to its collaborations with IPOs, covered by this Guide, the WIPO Center's ADR services for Specific Sectors currently cover the following areas.³⁸⁷

- Art and Cultural Heritage
- Energy
- Film and Media and Entertainment
- Franchising
- Information and Communication Technology
- Life Sciences
- Patents in Standards
- Research and Development/Technology Transfer
- Sports
- Trade Fairs

³⁸⁷ World Intellectual Property Organization Arbitration and Mediation Center 'WIPO Alternative Dispute Resolution (ADR) Services for Specific Sectors' <http://www.wipo.int/amc/en/center/specific-sectors/> accessed September 2018.

Appendix C: Sample WIPO Center Information Document

Referring Intellectual Property and Technology Court Cases to WIPO ADR

Where intellectual property and technology disputes are pending before the courts of [specify jurisdiction], alternative dispute resolution (ADR) procedures can offer additional benefits in bringing such cases to a successful conclusion.

ADR may present a suitable opportunity for cases pending before the courts where the parties are willing to explore settlement or need the assistance of an expert in a technical or scientific matter. The WIPO Center administers cases referred to ADR by national courts as well as by other adjudicative bodies, including Intellectual Property Offices.

WIPO Mediation

In a mediation procedure, a neutral intermediary, the mediator, helps the parties to reach a mutually satisfactory settlement of their dispute. Any settlement is recorded in an enforceable contract. Mediation is an efficient and cost-effective way of settling a case while preserving, and at times even enhancing, the relationship of the parties.

The principal characteristics of mediation are:

- Mediation is a non-binding procedure controlled by the parties
- Mediation is a confidential procedure
- Mediation is an interest-based procedure

Parties involved in proceedings pending before national courts may submit their dispute to WIPO Mediation by filing their agreement for WIPO Mediation with the WIPO Center.

Recommended Model Submission Agreement to WIPO Mediation

"We, the undersigned parties, hereby agree to submit to mediation in accordance with the WIPO Mediation Rules the following dispute:

[brief description of the dispute]

The place of mediation shall be [specify place]. The language to be used in the mediation shall be [specify language]."

Upon receiving the agreement to WIPO Mediation, the WIPO Center will contact the parties regarding the appointment of the mediator and the applicable fees. While the parties are free to identify a suitable candidate for such appointment themselves, the WIPO Center is available to assist with the provision of a shortlist of qualified candidates taking account of the requirements of the case.

A party that wishes to propose referring a dispute to WIPO Mediation can also unilaterally submit a Request for Mediation to the WIPO Center. Article 4(a) of the WIPO Mediation Rules facilitates submission of a dispute to mediation in cases where there is no mediation agreement between the parties. This can be helpful in a court environment that encourages mediation. Also, upon request by a party, the WIPO Center may appoint an external neutral to help parties considering submission of the dispute to WIPO Mediation (Article 4(b)); provided the parties agree, such neutral may subsequently be appointed as mediator.

WIPO Arbitration

Arbitration is a procedure in which a dispute is submitted, by agreement of the parties, to one or more arbitrators who make a binding decision on the dispute. In choosing arbitration, the parties opt for a private dispute resolution procedure instead of going to court.

The principal characteristics of arbitration are:

- Arbitration is consensual
- The parties choose the arbitrator(s)
- Arbitration is neutral
- Arbitration is a confidential procedure
- The decision of the arbitral tribunal is final and easy to enforce

Parties involved in proceedings pending before national courts may submit their dispute to WIPO Arbitration by filing their agreement for WIPO Arbitration with the WIPO Center.

Recommended Model Submission Agreement to WIPO Arbitration

“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].”

Upon receiving the agreement to WIPO Arbitration, the WIPO Center will contact the parties regarding the appointment of the arbitrator(s) and the applicable fees. While the parties are free to identify suitable candidates for such appointment themselves, the WIPO Center is available to assist with the provision of a shortlist of qualified candidates taking account of the requirements of the case.

The WIPO Center also offers WIPO Expedited Arbitration services, a form of arbitration that is carried out in a shortened time frame and at a reduced cost.

WIPO Expert Determination

Expert determination is a consensual ADR service offered by the WIPO Center in which a technical, scientific or related business issue between the parties is submitted to one or more experts who make a determination on the matter.

The principal characteristics of expert determination are:

- Expert determination is consensual
- The parties choose the expert(s) with relevant expertise
- Expert determination is neutral and flexible
- Expert determination is a confidential procedure
- The determination of an expert is binding, unless the parties agree otherwise
- Expert determination is a flexible procedure

Examples of matters that may benefit from expert determination include:

- the valuation of intellectual property assets or the determination of royalty rates
- the interpretation of the claims of a patent
- the extent of the rights that are covered by a license
- the assessment of damages

Parties involved in proceedings pending before national courts may submit their dispute to WIPO Expert Determination by filing their agreement for WIPO Expert Determination with the WIPO Center.

Recommended Model Submission Agreement to WIPO Expert Determination

“We, the undersigned parties, hereby agree to submit to expert determination in accordance with the WIPO Expert Determination Rules the following matter:

[brief description of the matter referred to expert determination]

The determination made by the expert shall [not] be binding upon the parties. The language to be used in the expert determination shall be [specify language].”

Upon receiving the agreement to WIPO Expert Determination, the WIPO Center will contact the parties regarding the appointment of the expert and the applicable fees. While the parties are free to identify a suitable candidate for such appointment themselves, the WIPO Center is available to assist with the provision of a shortlist of qualified candidates taking account of the requirements of the case.

A party that wishes to propose referring a dispute to WIPO Expert Determination can also unilaterally submit a Request for Expert Determination to the WIPO Center. Article 6(a) of the WIPO Expert Determination Rules facilitates submission of a dispute to expert determination in cases where there is no expert determination agreement between the parties. This can be helpful in pending court proceedings. Also, upon request by a party, the WIPO Center may appoint an external neutral to help parties considering submission of the dispute to WIPO Expert Determination (Article 6(b)); provided the parties agree, such neutral may subsequently be appointed as expert.

WIPO Arbitration and Mediation Center (Geneva)

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CH-1211 Geneva 20

Switzerland

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Singapore 069115

Singapore

T +65 6225 2129

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www.wipo.int/about-wipo/en/offices