Resolving IP Disputes Outside the Courts Through WIPO ADR

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WIPO Arbitration and Mediation Center
Alternative Dispute Resolution (ADR)

- Helping to resolve IP and technology disputes outside the courts
- Services include:
  - mediation
  - (expedited) arbitration
  - domain name dispute resolution
- Expertise and experience in IP and technology
- Competitive fees
- International neutrality
- Users around the world
- Since 1994
WIPO ADR Options

1. WIPO Contract Clause/Submission Agreement
   - (Negotiation)
2. Mediation
   - Expert Determination
   - Expedited Arbitration
   - Arbitration
3. Determination
4. Settlement
5. Award

Party Agreement
First Step
Procedure
Outcome
WIPO Arbitration

- Request for Arbitration
- Answer to Request for Arbitration
- Appointment of Arbitrator(s)
- Statement of Claim
- Statement of Defense
- Further Written Statements and Witness Statements
- Hearings
- Closure of Proceedings
- Final Award

WIPO Expedited Arbitration

- Request for Arbitration and Statement of Claim
- Answer to Request for Arbitration and Statement of Defense
- Appointment of Arbitrator(s)
- Hearing
- Closure of Proceedings
- Final Award

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

- IP/IT disputes and commercial disputes:
  - Contractual: patent licenses, software/ICT, R&D and technology transfer agreements, patent pools, distribution agreements, joint ventures, film production, TV distribution, art-related agreements, trademark coexistence agreements, settlement agreements
  - Non-contractual: infringement of IP rights
- Domestic and international disputes (25/75%)
- Amounts in dispute from USD 15,000 to USD 1 billion
Mediation

- Informal consensual process
- Neutral intermediary, the mediator, helps the parties in reaching a settlement while respecting their interests
- The settlement agreement has force of contract
- Mediation leaves open available court or agreed arbitration options
Arbitration

- Consensual
  - Parties submit their dispute to one or more chosen arbitrators, for a binding and final decision
  - Based on the parties’ rights and obligations and enforceable internationally
- Arbitration normally forecloses court options
Clause example for your contract: mediation followed by expedited arbitration

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

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

www.wipo.int/amc/en/clauses
### WIPO Cases: Typical Time and Cost

<table>
<thead>
<tr>
<th></th>
<th>Time (Month)</th>
<th>Cost (USD)</th>
</tr>
</thead>
<tbody>
<tr>
<td>WIPO Mediation</td>
<td>4.5</td>
<td>Excluding cost of parties legal representation</td>
</tr>
<tr>
<td>WIPO Expedited Arbitration</td>
<td>7</td>
<td>10.000</td>
</tr>
<tr>
<td>WIPO Arbitration</td>
<td>13.5</td>
<td>86.000</td>
</tr>
</tbody>
</table>

* Excluding cost of parties legal representation
Mediation, (Expedited) Arbitration, Expert Determination Fee Calculator

The fees referenced below are estimates, in United States dollars. Final amounts payable are to be decided in consultation with the Center.

Type of Procedure

Amount in Dispute in USD

500000

Schedule of Fees

- Mediation
- Arbitration / Expedited Arbitration
- Expert Determination
- Emergency Relief Proceedings (Effective from June 1, 2014)

Registration Fee

No Registration Fee

Administration Fee

USD 375

Mediators Fee

Amount in dispute up to USD 250,000: USD 2,500. Amount in dispute over USD 250,000: USD 300-USD 600 per hour USD 1,500-USD 3,500 per day.

For further information and payment details, click on the applicable schedule of fees and costs on the right hand side of the page.
What can you expect from the WIPO Center?

- Administering cases
  - Under WIPO ADR Rules
  - Containing time and costs
  - WIPO ECAF (optional online case management tool)

- Assisting in selection and appointment of mediators, arbitrators, experts; negotiating fees
  - 2,000+ WIPO neutrals from all regions
  - Specialized in IP and IT
Tackling cybersquatting

Uniform Domain Name Dispute Resolution Policy (UDRP)
Trademark identical or confusingly similar to the domain name

Domain name registrant has no rights or legitimate interests in the domain name; and

Domain name registered and used in bad faith
In 1999, WIPO created an international ADR procedure

- Allows trademark owners to file “clear cut” cases of abusive domain name registration and use – cybersquatting – without going to court

- Applicable to all international domains “old” (.com, .net, etc.) and “new” (.bike, .xyz, etc.)

- Also available for 74 national domains
Cybersquatting Areas

- Telecom: 2%
- Luxury Items: 3%
- Media and Publishing: 3%
- Hotels and Travel: 4%
- Entertainment: 4%
- Food, Beverages and Restaurants: 5%
- Automobiles: 5%
- Biotechnology and Pharmaceuticals: 5%
- Heavy Industry and Machinery: 6%
- Internet and IT: 7%
- Fashion: 10%
- Banking and Finance: 11%
- Retail: 13%
- Other: 15%
UDRP Advantages

- Quicker and cheaper than court litigation
- Two-month average
- Fixed fees (USD 1,500)
- Predictable results
- Decision (transfer) implemented directly by registrar
- Prevents consumer confusion and brand abuse
Before you file

- WIPO Guide to the UDRP
- WIPO model pleadings (complaint and response)
- WIPO Legal Index of UDRP Decisions
- WIPO Jurisprudential Overview of Selected UDRP Questions
WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0")

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Resulting from WIPO’s care for effective remedies under a sustainable UDRP, this WIPO Jurisprudential Overview reflects, and assists the predictability of, UDRP decisions by panels appointed in WIPO cases.

Introduction

QUESTIONS
1. First UDRP Element
2. Second UDRP Element
3. Third UDRP Element
4. Procedural Questions

1. First UDRP Element
1.1 What type of trademark rights are encompassed by the expression "trademark or service mark in which the complainant has rights" in UDRP paragraph 4(a)(i)?

1.2 Do registered trademarks automatically confer standing to file a UDRP case?

1.3 What does a complainant need to show to successfully assert unregistered or common law trademark rights?

1.4 Does a trademark owner’s affiliate or licensee have standing to file a UDRP complaint?
Why WIPO ADR?

- **Cost** of IP court litigation
  → *calls for expedient solutions*

- **Internationalization** of creation/use of IP
  → *calls for cross-border solutions; consolidate in one procedure*

- **Technical and specialized** nature of IP
  → *calls for specific expertise of the neutral*

- **Short product and market cycles in IP**
  → *calls for time-efficient procedures*

- **Confidential** nature of IP
  → *calls for private procedures*

- **Collaborative** nature of IP creation and commercialization
  → *calls for mechanisms that preserve relations*
- 16 years experience
- the global leader in domain name dispute resolution
  - 35,000+ cases covering 65,000+ domain names
  - Involving parties based in 113 countries
- Multilingual case administration (21 languages)
- Paperless filing: WIPO-initiated eUDRP
Queries:
arbiter.mail@wipo.int

Clauses:
www.wipo.int/amc/en/clauses/

Rules:

Case examples:
www.wipo.int/amc/

WIPO domain name dispute resolution:
www.wipo.int/amc/en/domains/