Resolving
Intellectual Property Disputes
WIPO Arbitration and Mediation Center

WIPO-WASME Special Program
May 5, 2004

Eun-Joo Min, Senior Legal Officer
WIPO Arbitration and Mediation Center

http://arbiter.wipo.int
WIPO Arbitration and Mediation Center

• Established in 1994 as part of the International Bureau of the World Intellectual Property Organization (WIPO)

• Purpose: to promote cost-effective resolution of IP/IT disputes through arbitration, mediation, and other ADR procedures
Limitations of Court Procedures

- Multiple proceedings for each jurisdiction
- Different court systems and legal cultures
- Enforcement difficulties
- Technical nature of disputes / Judges
Arbitration and Mediation (1)

- Party control / autonomy
- Flexibility
- Expertise
  - Party selection of neutrals; tailored appointment
- Neutral
  - arbitrator / mediator, language, law, venue
- Confidential
  - existence, disclosures, result

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Arbitration and Mediation (2)

- Finality / Enforceability of Awards
  - Arbitration: New York Convention
    - with limited exceptions, “automatic” enforcement of arbitral awards
    - more than 130 signatories
  - Mediation: Settlement enforceable under contract law

- Single Procedure
  - time & cost-effective

- Less adversarial than court litigation

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WIPO Procedures

• Mediation
• Arbitration
• Expedited Arbitration
• Mediation followed, in the absence of a settlement, by arbitration
• Domain Name Disputes

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WIPO Arbitration and Mediation Options

WIPO CONTRACT CLAUSE / SUBMISSION AGREEMENT

MEDIATION

SETTLEMENT

ARBITRATION

EXPEDITED ARBITRATION

AWARD
Recommended WIPO Arbitration Clause

“Any dispute, (...) shall be referred to and finally determined by arbitration in accordance with the WIPO Arbitration Rules. The arbitral tribunal shall consist of [three arbitrators][a sole arbitrator]. The place of arbitration shall be [...]. The language to be used in the arbitral proceedings shall be [...]. The dispute, controversy or claim shall be decided in accordance with the law of [...].”

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Mediation: Minimal Risk, Significant Benefits

- Non-binding / party control
- Confidential
- Low cost
- Based on interests of the parties
  - Value creation
- Preserves relationships
- In Licensing and Technology Transfer Disputes

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Mediation Process

COMMENCEMENT → APPOINTMENT OF MEDIATOR → INITIAL CONFERENCE → MEETINGS → CONCLUSION

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WIPO Mediation Case Example - Patent Mediation

• R&D company holding patents disclosed patented invention to manufacturer during consulting contract.

• Contract did not transfer or license patent rights to manufacturer.

• Manufacturer started selling products which R&D company alleged included patented invention.

• R&D threatened infringement court proceedings.
WIPO Mediation Case Example
-Patent Mediation-

• Negotiation patent license failed.
• Parties submitted dispute to WIPO Mediation Rules.
• WIPO Center suggested mediator.
• Mediator appointed.
• Two-day meeting.
• Agreement on royalties and future consulting contracts.

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Arbitration

Consensual
Efficient
Binding ("exclusive" jurisdiction)
No appeal (final and enforceable award)

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WIPO ARBITRATION

- Request for Arbitration
- Answer to Request for Arbitration (30 days)
- Appointment of Arbitrator(s)
- Statement of Claim (30 days)
- Further Written Statements and Witness Statements
- Hearings
- Closure of Proceedings
- Final Award (3 months)

WIPO EXPEDITED ARBITRATION

- Request for Arbitration and Statement of Claim
- Answer to Request for Arbitration and Statement of Defense (20 days)
- Appointment of Arbitrator
- Hearing (maximum 3 days)
- Closure of Proceedings
- Final Award (1 month)
Expedited Arbitration

• When is it appropriate?
• Statement of Claim filed with Request for Arbitration and Statement of Defense with Answer to the Request
• Sole arbitrator
• Fixed arbitrator’s fees for disputes up to USD 10 million
• Shorter hearings
• Time limits shortened

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Expedited Arbitration - Example

- Biotech R&D company concluded exclusive R&D and licensing agreement with pharmaceutical company.
- Alleged delays in development and regulatory approval of biotech compound.
- R&D company terminated agreement and started WIPO arbitration proceedings.
- Center appointed arbitrator expert in biotech-pharmaceutical dispute.
- Two-day hearing.
- Settlement agreement.

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## Arbitration Proceedings
### Schedule of Fees

*(All amounts are in United States dollars)*

<table>
<thead>
<tr>
<th></th>
<th>Amount in dispute</th>
<th>Expedited Arbitration</th>
<th>Arbitration</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Registration Fee</strong></td>
<td>Any Amount</td>
<td>$1,000</td>
<td>$2,000</td>
</tr>
<tr>
<td>**Administration Fee *</td>
<td>Up to $2.5 M</td>
<td>$1,000</td>
<td>$2,000</td>
</tr>
<tr>
<td></td>
<td>Over $2.5 M and up to $10 M</td>
<td>$5,000</td>
<td>$10,000</td>
</tr>
<tr>
<td></td>
<td>Over $10 M</td>
<td>$5,000</td>
<td>$10,000</td>
</tr>
<tr>
<td></td>
<td>+0.05% of amount over $10 M up to a maximum fee of $15,000</td>
<td></td>
<td></td>
</tr>
<tr>
<td>**Arbitrator(s) Fees *</td>
<td>Up to $2.5 M</td>
<td>$20,000 (fixed fee)</td>
<td>As agreed by the Center in consultation with the parties and the arbitrator(s)</td>
</tr>
<tr>
<td></td>
<td>Over $2.5 M and up to $10 M</td>
<td>$40,000 (fixed fee)</td>
<td></td>
</tr>
<tr>
<td></td>
<td>Over $10 M</td>
<td>As agreed by the Center in consultation with the parties and the arbitrator(s)</td>
<td>Indicative rate(s) $ 300 to $ 600 per hour</td>
</tr>
</tbody>
</table>

*All amounts are in United States dollars*
WIPO List of Neutrals

- Over 1,000 experts
- 100 nationalities
- Broad range of ADR, IP, and technical backgrounds
- Appointment in WIPO Cases
- Referral Service

David W. PLANT, Esq.
215 Little Lake Sunapee Road
New London, NH 03257
United States of America

Telephone: (1-603) 526 2653/2655
Facsimile: (1-603) 526 2654
E-mail: DPlantADR@aol.com

Date of Birth: April 22, 1931
Nationality: USA

EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS
Registered to practice before United States Patent & Trademark Office, 1982;
Licensed to practice in United States Supreme Court, 1968;
Licensed to practice law, N.Y. State Bar, 1957;
LLB, Cornell University, 1957;
BME, Cornell University, 1953.
The Role of the WIPO Arbitration and Mediation Center

- (Expedited) Arbitration and Mediation Rules
- Model Clauses and Submission Agreements
- Efficient and cost-effective administration
- List of Neutrals and institutional knowledge
- Other resources

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WIPO Arbitration and Mediation Experience (1)

- All WIPO clauses separately or in combination
- Contractual and non-contractual
- From court litigation to WIPO submission
- In English, French, German language
- Place of arbitration: US, France, Germany, Ireland, Netherlands, Switzerland, UK
- Parties from Europe, U.S., China, etc.

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WIPO Arbitration and Mediation Experience (2)

• Subject matter includes:
  – patent, copyright, software licenses
  – trademark co-existence agreements
  – pharmaceutical distribution agreements
  – R&D contracts
  – patent infringement
  – etc.

• High success rate
  – Value in dispute: USD 20,000 - 600 million

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WIPO Domain Name Dispute Resolution

• WIPO Domain Name Process I
  – endorsed by WIPO member states (Sept. 1998)
  – Commenced in July 1998 to make recommendations on questions arising out of the interface between domain names and intellectual property rights
  – Final report published in April 1999

• Uniform Domain Name Dispute Resolution Policy

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Uniform Domain Name Dispute Resolution Policy

- Approved by ICANN in October 1999
- Administrative procedure
- Limited to abusive registrations
- Mandatory submission by domain name registrants
- Remedies
  - Transfer or Cancellation only
  - No monetary damages

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UDRP Criteria

**Conditions for obtaining remedies:**
1. Trademark must be identical or confusingly similar to domain name; *and*
2. Registrant has no rights or legitimate interests in domain name; *and*
3. Domain name is registered and used in bad faith.

**Examples of rights or legitimate interests:**
- Registrant commonly known by the domain name
- Use for *bona fide* offering of goods or services

**Examples of bad faith:**
- registration for purpose of profit sale to trademark owner
- pattern of preventing trademark owners from registration
WIPO UDRP Experience

- Received cases: over 6,065 (leading provider)
  - 10,621 domain names
  - famous marks, small and medium enterprises, individuals
  - parties from 116 countries
- Resolved cases: 5,850 (96.5%)
  - WIPO panel decisions: 4,696
  - transfer rate: 82 %
  - party settlement: 1154 cases
- Completion time per case: approximately 2 months
- Communication:
  - Over 1 million Web site hits per month
  - Over 40,000 online case communications per year
  - 11 case languages
**WIPO Center Experience**

**Domain Names**

· Leading provider of domain name dispute resolution services

<table>
<thead>
<tr>
<th>Year</th>
<th>UDRP</th>
<th>.info Sunrise</th>
<th>.biz STOP</th>
<th>.name ERDRP</th>
<th>Total</th>
</tr>
</thead>
<tbody>
<tr>
<td>1999</td>
<td>1</td>
<td>-</td>
<td>-</td>
<td>-</td>
<td>1</td>
</tr>
<tr>
<td>2000</td>
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<td>-</td>
<td>-</td>
<td>-</td>
<td>1,857</td>
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<tr>
<td>2001</td>
<td>1,556</td>
<td>1,579</td>
<td>53</td>
<td>-</td>
<td>3,188</td>
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<tr>
<td>2002</td>
<td>1,208</td>
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<td>285</td>
<td>1</td>
<td>15,087</td>
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<tr>
<td>2003</td>
<td>1,100</td>
<td>-</td>
<td>-</td>
<td>-</td>
<td>1,100</td>
</tr>
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<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
<td>21,233</td>
</tr>
</tbody>
</table>

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Sampling of Disputed Domain Names

??.com
???.com
???.com
?????.com
?????.com
?????com
?????.com
schöps.com
?????.com
?????.com
?????.com
fortunéo.com
ckværner.net
?????.com
?????????.com
??.com
????.net
?????.com
?????????.com
????.com
chériefm.com
rémycointreau.com
rémy-cointreau.com
????.com
WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Tata Sons Ltd. v. The Advanced Information Technology Association

Case No. D2000-0049

1. The Parties

1.1 Tata Sons Ltd, Bombay House, 24, Homi Modi Street, Mumbai 400 024, India (Complainant).

1.2 The Advanced Information Technology Association, 1/182, Haji Habib Building, Dr. B. A. Road, Dadar, Mumbai 400 014, India (Respondent).
トップレベル・ドメイン名(g TLDs)のための紛争処理手続

ドメイン名紛争統一処理方針の紛争に関する一般情報

・事件
  ○ 全ての事件
  ○ 全ての裁定
  ○ 統計

・紛争処理手続に関する情報
  ○ ガイド
  ○ 達成方針と手続き規則
  ○ 手数料
  ○ バネリスト

・中立人向け
  ○ 申立書の提出
  ○ 申立書提出のガイドライン
  ○ 申立書送付表書

・答弁人向け
  ○ 答弁書の提出
  ○ 答弁書提出のガイドライン

ドメイン名紛争統一処理方針の紛争に関する一般情報

WIPO仲裁調停センターのg TLDsに対するドメイン名紛争解決サービスは、ICANN (Internet Corporation for Assigned Names and Numbers) 以下、「ICANN」)が1999年8月26日に採択したドメイン名紛争統
http://arbiter.wipo.int/cgi-bin/domains/search/legalindex

Index of WIPO UDRP Panel Decisions

This Index covers all WIPO UDRP decisions. New decisions are being added continuously.

Search tips
Any time you select more than one category, the search result will yield ONLY those decisions that are indexed in ALL of the categories so selected.

Decided WIPO cases by domain name categories

I. Associations and Institutions
   A. Religious
   B. Sports
   C. Others

II. Geographical Identifiers

III. Individuals

Legal index to WIPO panel decisions

I. General
II. Substance
III. Procedure
IV. National Court Proceedings Relating to UDRP

Decided WIPO cases by domain name categories
Upcoming Events

- WIPO Workshops for Mediators in Intellectual Property Disputes, June 24-25 and 28-29, 2004
- WIPO Workshop for Arbitrators, October 25-26, 2004
- WIPO Workshop on Domain Name Dispute Resolution, October 28-29, 2004
- WIPO Conference on Dispute Resolution in International Science and Technology Collaboration, April 25-26, 2005

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Information

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- eunjoo.min@wipo.int
- Mailing list: http://arbiter.wipo.int/subscribe/