

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

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WIPO Arbitration and Mediation Center

In this webinar

- Send your questions
- Download handouts
- Receive the Webinar recording and presentation slides

In this webinar

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

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World Intellectual Property Organization (WIPO)



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

WIPO Arbitration and Mediation Center

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



Mediation

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

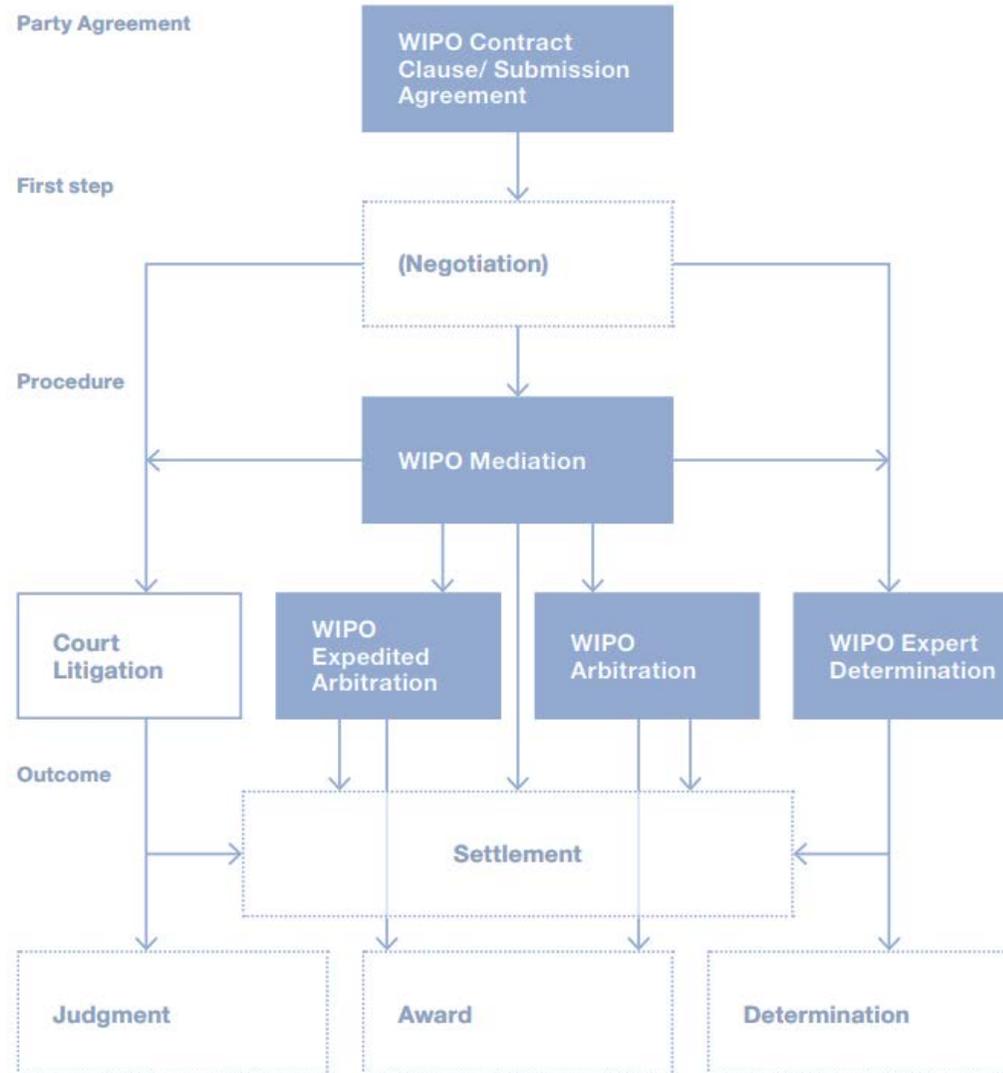
Arbitration

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

Court Litigation vs. ADR

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

WIPO ADR options



What is the WIPO Center's role?

■ WIPO Center is available to

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

■ WIPO Center does not

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

WIPO ADR Rules

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

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

WIPO mediation and arbitration cases

Areas of disputes

Copyright

Art
Broadcasting
Collective Management
Entertainment
Film and Media
Infringements
TV Formats

Commercial

Design
Distribution
Energy
Franchising
Marketing
Sports

Trademarks

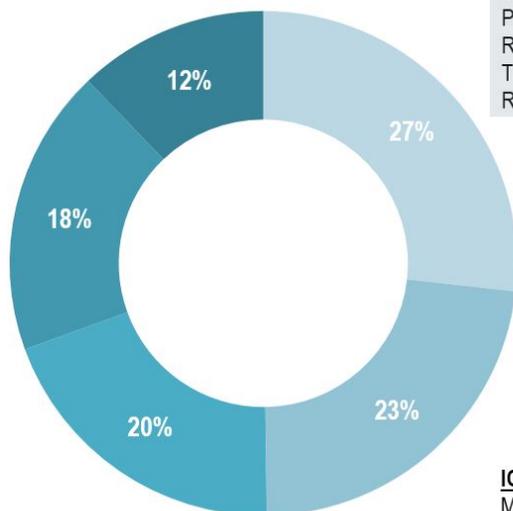
Coexistence
Infringements
Licenses
Oppositions
Revocations

Patents

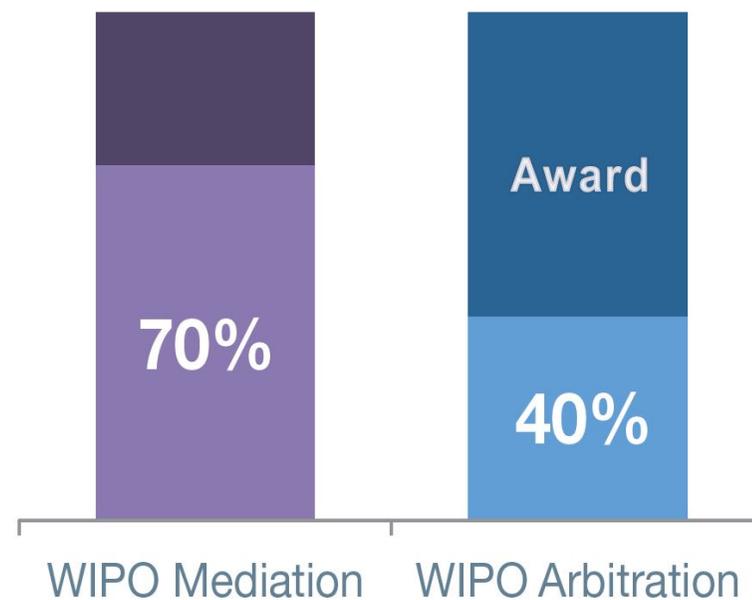
Cross-licensing
Infringements
Licenses
Ownership
Patent Pools
R&D / Tech
Transfer
Royalty Payment

ICT

Mobile Apps
Outsourcing
Systems Integration
Software Development
Software Licensing
Telecommunications



Settlement rates



**WIPO | ADR****Time- and Cost-Efficient Alternative Dispute Resolution Services for PCT Users**

The [WIPO Arbitration and Mediation Center's](#) alternative dispute resolution (ADR) services are regularly used by multinational corporations, small and medium-sized enterprises (SMEs), research and development (R&D) centers, universities and inventors from around the world which are also users of the Patent Cooperation Treaty (PCT).

A 25% reduction on the WIPO 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.

[Contact us](#)**WIPO patent-related cases**

International and domestic patent transactions involve a rich variety of contracts and transactions, involving 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 cost-effective ADR options help parties to find solutions without the need for court litigation. Patent-related disputes now account for some 30% of [WIPO arbitration and mediation cases](#).

In this webinar

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

How can you use WIPO ADR?

For what kind of disputes?

How to refer disputes to WIPO ADR

WIPO resources

For patent contractual
disputes

Inclusion of ADR contract clause

WIPO model ADR clauses

- WIPO model clauses: www.wipo.int/amc/en/clauses
- WIPO Clause Generator: www.wipo.int/amc-apps/clause-generator

Clause example for your contract: mediation followed by expedited arbitration

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

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

Some pointers on mediation and arbitration clauses

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

WIPO
WORLD INTELLECTUAL PROPERTY ORGANIZATION

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

WIPO Clause Generator

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

Mediation

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

The place of mediation shall be

Core Elements ?

- Place of Mediation**
- Language of the Mediation
- Duration of the Mediation Proceedings

Additional Elements ?

- Qualifications of the Mediator
- Conduct of the Mediation

Arbitration

Core Elements ?

- Number of Arbitrators
- Place of Arbitration
- Language of Arbitration
- Substantive Law

Additional Elements ?

- Appointment Procedure
- Qualifications of the Arbitrators
- ECAF
- Evidence
- Time Period of Delivery of the Final Award
- Appeal

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

The place of mediation shall be [specify place].

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

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

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

The place of arbitration shall be [specify place].

The language to be used in the arbitral proceedings shall be [specify language].

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

Step 4 – Download or copy the final result

WIPO case examples: Contractual patent disputes

- Mediation: Patent dispute in the automotive sector
 - Parties from US and Switzerland
 - Settlement agreement from prior litigation included patent license
 - WIPO Mediation follow by WIPO Arbitration clause
 - Dispute related to patent infringement
 - WIPO Center proposed shortlist of mediator candidates
 - Patent practitioners with knowledge of US patent law and experience in patent infringement
 - Two-day session in Geneva at WIPO
 - Parties re-drafted original licensing agreement
 - 5 months

WIPO case examples: Contractual patent disputes

- Arbitration: Biotech patent dispute
 - French biotech company and multinational pharma company
 - Biotech company terminated contract after several years alleging that pharma company had deliberately delayed development of biotech compound
 - License agreement included WIPO Arbitration clause, sole arbitrator
 - Biotech company claimed damages
 - WIPO proposed arbitrator candidates with experience in biotech/pharma disputes
 - Arbitrator held a three-day hearing for witnesses examination
 - Parties accepted arbitrator's suggestion to hold a private meeting
 - Parties agreed to settle dispute and continued to cooperate towards the development and commercialization of biotech compound

WIPO case examples: Contractual patent disputes

- Expedited Arbitration: Patent dispute related to consumer goods
 - Asian inventor and US manufacturer
 - Exclusive license
 - WIPO Expedited Arbitration clause
 - Dispute related to whether product included technologies covered by licensed patents
 - US company rejected claim that its products included technologies covered by licensed patents and refused to pay royalties
 - Arbitrator had to consider
 - whether products infringed claims asserted for each of patents
 - whether patents had been ‘anticipated’ by ‘prior art’
 - Highly complex legal and technical issues
 - Business secrets, models, site visits
 - Eight days hearing
 - Final award rendered after 1 year

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

How can you use WIPO ADR?

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

- WIPO model submission agreements: www.wipo.int/amc/en/clauses
- Unilateral Request for WIPO Mediation: www.wipo.int/amc/en/docs/request_mediation.docx
- WIPO Clause Generator: www.wipo.int/amc-apps/clause-generator

WIPO Good Offices

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

- Procedural advice

- No fees at this stage

WIPO Arbitration submission agreement example:

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

*[brief **description of the dispute**]*

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



Request for WIPO Mediation

(Article 4 of the WIPO Mediation Rules)

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

1. Parties

Please provide the following contact information:

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

2. Dispute

Please provide a brief description of the dispute:

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

Please sign this form and submit it to arbiter.mail@wipo.int 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.

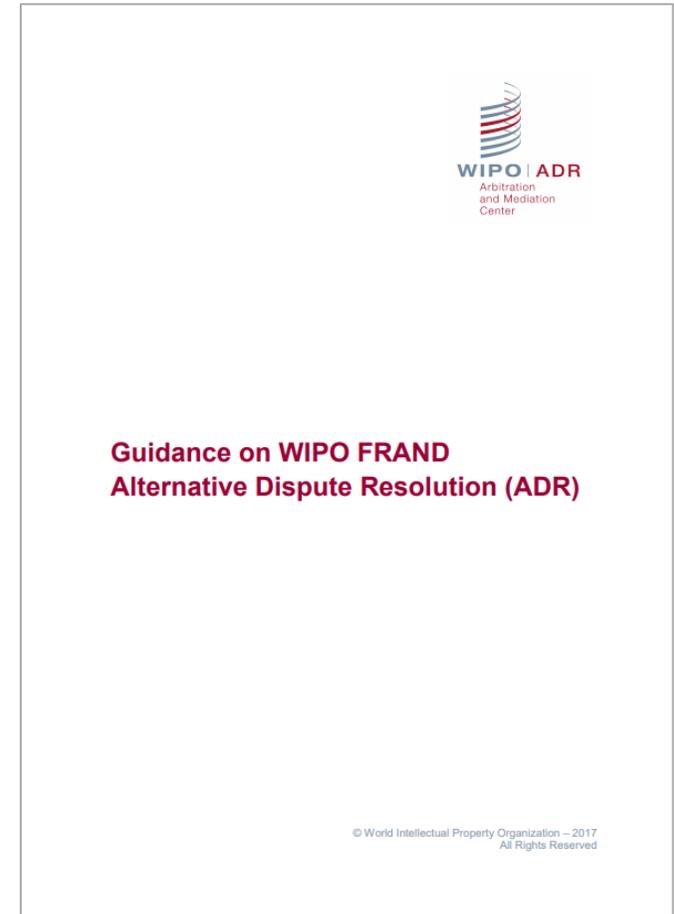
Please sign this form and submit it to arbiter.mail@wipo.int and to the requesting party.

Place and Date: _____

Signature: _____

WIPO ADR for FRAND disputes

- Tailored WIPO mediation and arbitration model submission agreements for disputes on the determination of fair, reasonable and non-discriminatory (FRAND) terms
- Developed with assistance of leading patent law, standardization and arbitration experts, including members and the Secretariat of the European Telecommunication Standards Institute (ETSI)



- www.wipo.int/amc/en/center/specific-sectors/ict/frand

WIPO case examples: Non-contractual patent disputes

- Mediation: Patent dispute pending in court
 - European parties
 - Dispute over ownership and infringement of patents related to augmented reality technology
 - Agreement to submit dispute to WIPO Mediation
 - Mediator experienced in patent litigation
 - Parties requested court to stay proceedings
 - Settlement agreement reached in 3 months

- Mediation: R&D dispute pending in court
 - German and French/US companies
 - Breach of contract arising from collaboration agreement for development of human antibody for treatment of major disease
 - Parties accepted US court suggestion to submit dispute to mediation
 - WIPO proposed list of mediator candidates
 - Settlement agreement reached in 6 months

WIPO case examples: Non-contractual patent disputes

- Unilateral Request for Mediation: Patent dispute during trade exhibition
 - Asian and American companies
 - Alleged infringement of patent by American company during exhibition in Europe
 - Asian company submitted WIPO Unilateral Request for Mediation
 - American company did not consent to WIPO Mediation but agreed to:
 - cease shipping and selling the contentious products to a European country
 - include a notice that the contentious products would not be available in that country at international exhibitions
 - Parties reached settlement agreement within one week

WIPO case examples: Non-contractual patent disputes

- Arbitration: Patent dispute related to consumer goods
 - Two US companies, litigation in several jurisdictions
 - Submission agreement to WIPO Arbitration
 - Patent infringement dispute related to European patent in the area of consumer goods
 - Patent law of a particular European country applicable
 - Three-member arbitral tribunal
 - Detailed procedural and hearing schedule
 - Amendments of WIPO Rules: e.g., shortened timelines and detailed provision on experiments
 - WIPO Center suggested arbitrator candidates with substantial expertise in relevant national patent law
 - One-day hearing in Geneva including witness statements
 - Final award rendered within 5 months

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WIPO Mediation Pledge for IP and Technology Disputes

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

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

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

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

Companies, Universities, R&D Centers, and Individuals

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

Lawyers and Law Firms

So that clients can make informed choices:

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



**400+ signatories
from
90 countries**



Join the Pledge!

www.wipo.int/amc/en/mediation/pledge.html

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Arbitration
and Mediation
Center

Contact us

- Queries: arbiter.mail@wipo.int
- Further information: www.wipo.int/amc

- WIPO Arbitration and Mediation Center Offices
 - Geneva, Switzerland
 - Singapore, Singapore

- WIPO External Offices
 - Algiers, Algeria
 - Rio de Janeiro, Brazil
 - Beijing, China
 - Tokyo, Japan
 - Moscow, Russia
 - Singapore, Singapore