Key trends related to IP & Technology disputes

- Rise of out-of-court dispute resolution mechanisms
- Growth in cross-border TMT disputes
- Increase in adoption of mandatory mediation clauses
- Growth in usage of remote mediation techniques (ODR)
WIPO Mediation and Arbitration for Intellectual Property and Technology Disputes

WIPO-SIMC Webinar: Recent Developments in Mediation for IP and Technology Disputes

October 27, 2020

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Chiara Accornero
WIPO Arbitration and Mediation Center
WIPO Arbitration and Mediation Center

- Facilitates the resolution of commercial disputes between private parties involving IP and technology, through ADR
  - Offices in Geneva and Singapore
  - International neutrality

- ADR of IP disputes benefits from a specialized ADR provider
  - WIPO mediators, arbitrators and experts experienced in IP and technology

- Competitive WIPO fees

- Services include mediation, (expedited) arbitration, expert determination, and domain name dispute resolution
### Why ADR for IP and technology disputes?

<table>
<thead>
<tr>
<th>Cost of IP court litigation</th>
<th>Calls for expedient solutions</th>
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<tr>
<td>Internationalization of creation and use of IP</td>
<td>Calls for cross-border solutions; consolidate in one procedure</td>
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<td>Technical and specialized nature of IP</td>
<td>Calls for specific expertise of the neutral</td>
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<td>Short product and market cycles in IP</td>
<td>Calls for time-efficient procedures</td>
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<td>Confidential nature of IP</td>
<td>Calls for private procedures</td>
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<tr>
<td>Collaborative nature of IP creation and commercialization</td>
<td>Calls for mechanisms that preserve relations</td>
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2020: 85.7% settlement rate in WIPO Mediation
Role of the WIPO Center

- Procedural assistance
  - Information and guidance on ADR
  - Drafting ADR clauses and submission agreements

- Administering cases
  - Containing time and costs
    - WIPO eADR and online tools

- Assisting selection and appointment of mediators and arbitrators; negotiating fees
  - 2,000+ WIPO experts from all regions
  - Specialized in IP and technology
WIPO Checklist for the Online Conduct of Mediation and Arbitration Proceedings

Preliminary Considerations

1) Do the WIPO Mediation, Arbitration and Expedited Arbitration Rules (WIPO Rules) address the online conduct of proceedings?

Yes, the WIPO Rules allow parties, mediators and arbitrators to conduct proceedings online as appropriate (Article 10 WIPO Mediation Rules, Article 37(a) WIPO Arbitration Rules, Article 31 (a) WIPO Expedited Arbitration Rules). In addition, mediators and arbitrators have the duty to ensure that proceedings take place with due expedition (Article 11 WIPO Mediation Rules, Article 37(c) WIPO Arbitration Rules, Article 31(c) WIPO Expedited Arbitration Rules). In the WIPO Center’s case experience, this has included the online conduct of mediation meetings and arbitration hearings.

Pursuant to Article 40 WIPO Arbitration Rules/Art. 34 WIPO Expedited Arbitration Rules, the preparatory conference can be held in any format, in practice, it normally is conducted via telephone, videoconference, or increasingly using online tools.

2) Is it possible to conduct WIPO Mediation and Arbitration proceedings in a hybrid format?

Yes, the WIPO Center has administered some proceedings where some parties, mediators or arbitrators participated in meetings or hearings in-person while others joined through online tools.

Choice of Online Platform

3) Are parties, mediators and arbitrators in WIPO proceedings free to choose the online platform they wish to use for their proceedings?

Yes, parties, mediators and arbitrators are free to agree on the online platform(s) they wish to use. In WIPO mediations and arbitrations, this has included the use of WebEx, Zoom, Teams, Bluejeans, WhatsApp, and Skype for Business.
WIPO – SIMC: Recent Developments in Mediation for IP and Technology Disputes

George Lim SC, Chairman
Singapore International Mediation Centre
27 October 2020
A case study on an international IP dispute
MOU with CCPIT Mediation Center (Jan 2019)

China's Chief Justice Zhou Qiang

Beijing Specialist Mediators' Training (Jan 2019)

MOU with CIETAC (Aug 2019)
Japan – Singapore International Dispute Resolution Conference (Mar 2019)

Lunch with GCs & SMS Edwin Tong

Japan
India Specialist Mediators Training & Appointment Ceremony
SIMC International Mediator Panel

Mr Bill Marsh  
United Kingdom

Mr Karl Mackie  
United Kingdom

Mr Claude Amar  
France

Mr Michel Kallipetis  
United Kingdom

Mr Khory McCormick  
Australia

Mr Sudhanshu Batra  
Singapore

Ms Elizabeth Birch  
United Kingdom

Ms Jane Player  
United Kingdom

Mr John Sturrock QC  
United Kingdom

Ms Lum Kit-Wye  
Singapore

Mr David Perkins  
United Kingdom

Ms Edna Sussman  
USA

Mr Tim McFarlane  
United Kingdom

Mr Robert Gaitskell QC  
United Kingdom

Ms Manon Schonewille  
The Netherlands

Mr Anil Xavier  
India
SIAC & SIMC
Arb-Med-Arb (AMA) Protocol
A one-stop process
SIMC (2015 – Sep 2020)

Total cases: 130

Total dispute value: US$3 billion

Settlement rate: 70 – 80%

Arb-Med-Arb Statistics

Total AMA cases to date: 21

Settlement rate: 75 - 80%

Top 10 SIMC Overseas Users:
- India 23%
- USA 19%
- China 16%
- Malaysia 6%
- Indonesia 6%
- UAE 6%
- Hong Kong 6%
- BVI 6%
- Cayman Islands 6%
- Australia 6%
SIMC-SCIA MOU on “Med-Arb” Service

- On 17 June 2020, SIMC signed a MOU with the Shenzhen Court of International Arbitration (SCIA).
- The MOU supports businesses and projects under the Singapore–China (Shenzhen) Smart City Initiative.
Singapore Convention Signing Ceremony
7 August 2019
(46 signatories)
MAJOR ECONOMIES

North America
USA

Latin America & Caribbean
Chile
Colombia
Ecuador
Grenada
Haiti
Honduras
Jamaica
Paraguay
Uruguay
Venezuela

Europe
Armenia
Belarus
Georgia
Montenegro
North Macedonia
Serbia
Ukraine

Middle East
Afghanistan
Iran
Israel
Jordan
Qatar
Saudi Arabia

Asia
Brunel
China
India
Kazakhstan
Laos
Malaysia
Maldives
Philippines
Singapore
South Korea
Sri Lanka
Timor-Leste
Turkey

Oceania
Fiji
Palau
Samoa

12 SEP 2020
Convention’s entry into force

53 countries have signed
6 countries have approved/ratified
Online Mediation During Covid-19

*Confidentiality is of paramount consideration in SIMC mediations, whether offline or online. Consent was obtained from the lawyers and mediators to have the photos taken and for the photo to be used by SIMC. These photos do not reveal any case details or parties.
THANK YOU

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Linkedin: Singapore-international-mediation-centre (SIMC)

Follow Us:
2020: 85.7% settlement rate in WIPO Mediation
WIPO Caseload

WIPO Mediation, Arbitration, Expert Determination and Good Offices

(2008-2020)

Referral to WIPO ADR

Contractual 62%
Non-Contractual 38%
Routes to WIPO ADR

- ADR contract clause electing WIPO Rules
  - WIPO Mediation, Arbitration / Expedited Arbitration, and/or Expert Determination

- ADR submission agreement electing WIPO Rules, e.g., in existing non-contractual disputes

- Unilateral request for WIPO Mediation by one party (Art. 4 WIPO Mediation Rules)

- Court referrals
A WIPO Telephone Mediation of a Software License Dispute – Mobile Apps

**Parties**
Asian and US start-ups

**Contract**
License agreement for the use of mobile phone applications

**Dispute**
Unauthorized use of the software by the licensee and related royalty payment claims

**Basis**
Contract clause providing for WIPO Mediation followed by WIPO Arbitration

**Process**
Parties agreed on an experienced mediator with experience in technology cases

Mediation sessions took place entirely by telephone (caucus and joint sessions)

**Result**
Settlement agreement within three months, allowing the parties to continue the collaboration
A WIPO Online Mediation of a Software License Dispute

**Parties** European software developer and customer

**Contract** Software licensing agreement

**Dispute** Non-execution of the agreement and related damages claims

**Basis** Contract clause providing for WIPO Mediation followed by court litigation

**Process** Mediator with experience in technology cases

Mediation sessions took place entirely online with live interpretation (French and German)

**Result** Settlement agreement within six months
A WIPO Unilateral Request for WIPO Mediation of a Patent Infringement

**Parties**  
Chinese and US companies

**Dispute**  
Alleged infringement of a German patent by the US company during an exhibition in Germany

**Basis**  
Chinese company submitted a Unilateral Request for WIPO Mediation  
Direct negotiations between the parties

**Mediator**  
No mediator was appointed

**Result**  
US company agreed to:  
- cease selling the contentious products in Germany  
- include a notice that the products are not available in Germany at exhibitions

**Duration**  
One week
WIPO Arbitration and Mediation Center

- Queries: arbiter.mail@wipo.int
- Clauses: www.wipo.int/amc/en/clauses
- Rules: www.wipo.int/amc/en/rules
- Neutrals and case examples: www.wipo.int/amc
- Endorse the WIPO Mediation Pledge: https://www.wipo.int/amc/en/mediation/pledge.html

- Offices:
  - Geneva, Switzerland
  - Singapore, Singapore
IP/TMT DISPUTES – COUNSEL’S ROLE AND SYNTHESIS

- Intellectual Property Disputes
  - Difficulties and apprehensions
    - Ungar v Sugar (1892) 9 RPC 113 at 116-117
    - ‘Zero sum’ determinations
    - Validity of registered IP
    - ‘common general knowledge’/state of the art
    - Patent interpretation (DoE, Purposive/Literal)
    - subject matter arbitrability issues
    - Territoriality/inconsistent decisions
  - Opportunities
    - Cross-border/multi-jurisdictional IP fights
    - Exemptions eg. Fair Use
    - Partitioned mediation - issues
    - Valuation/Damage assessment
    - Royalties
- Standard Essential Patents (SEPs) and FRAND
- New Tech
  - Application Programming Interfaces (APIs)
  - Artificial Intelligence/IP
    - AI machines/AI generated works
    - Inventorship/authorship
  - Extended Reality Tech
    - Virtual Reality
    - Augmented Reality
    - Mixed Reality
  - Quantum Computing
- TMT Disputes
  - Rise of IT arbitrations
    - Trade offs
    - Development of the common law (hindered)
    - Possible presumption against confidentiality in future?
  - IT contracts
    - ‘Waterfall’ or ‘Agile’ structures
    - Variation orders
    - Tolerance of timing; performance prevention
    - Termination
    - Vitiation (Covid-19)
  - Smart Contracts/distributed ledger technology
  - Third Parties and Joinder
    - outsourcing
  - ‘Big Data’ Protection
    - PDPA+/GDPR
    - data mining disputes (consumers)
  - Cybersecurity
    - ‘reasonable security arrangements’
    - Technological solutions
  - Process issues
    - E-disclosure
    - E-case management solutions
  - Specialist or non-specialist Mediator?
Recent Developments In Mediation For IP & Technology Disputes Mediator’s Perspective

WIPO-SIMC Joint Webinar
27th June 2020, 17:00 hours Singapore; 10:00 hours Geneva

Lawyers Who Lead
RECENT DEVELOPMENTS IN MEDIATION OF IP & TECHNOLOGY DISPUTES
MEDIATOR’S PERSPECTIVE

● Anecdotal Observations
  ▶ greater conversion and buy-in
  ▶ more cross-border context
  ▶ mediation in its element
  ▶ real-life outcomes illustrate particular suitability

● Technicalities in IP & Technology Disputes
  ▶ technological, legal, commercial considerations
  ▶ jargon, factual / evidential dynamics
  ▶ party empathy, under the skin, the plot
  ▶ different BATNA / WATNA, different longer runway
  ▶ balance - technicalities vs meaningful settlement

● Recent Online Phenomenon
  ▶ human interaction - a different mastery
  ▶ technology platform and administration
  ▶ preparation and precautions
  ▶ physical realities

● Navigating Boundaries Without Borders
  ▶ jurisdictional sensitivities - nature of IP laws
  ▶ cross-border sophistication
  ▶ cultural nuances
  ▶ parties’ marketplace beyond national boundaries
  ▶ Singapore Convention on Mediation

● Opportunities for More
  ▶ still a latent force
  ▶ wider reach e.g. geography, sectors
  ▶ high returns relative to time/cost, considering complexity
  ▶ build out specific expertise
  ▶ success begets more