



# ■ Resolving IP and Technology Disputes through WIPO Mediation

WIPO-IPOS Webinar

Singapore  
August 7, 2020

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WIPO Arbitration and Mediation Center

# World Intellectual Property Organization (WIPO)

- Promotes innovation and creativity
- For the economic, social and cultural development of all countries
- Through a balanced and effective international IP system
- 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 and technology, through ADR
  - Offices in Geneva and Singapore
  - International **neutrality**
- ADR of IP disputes benefits from a **specialized** ADR provider
  - WIPO mediators and arbitrators experienced in IP and technology
- Competitive WIPO fees
- Services include mediation, (expedited) arbitration, expert determination, and domain name dispute resolution

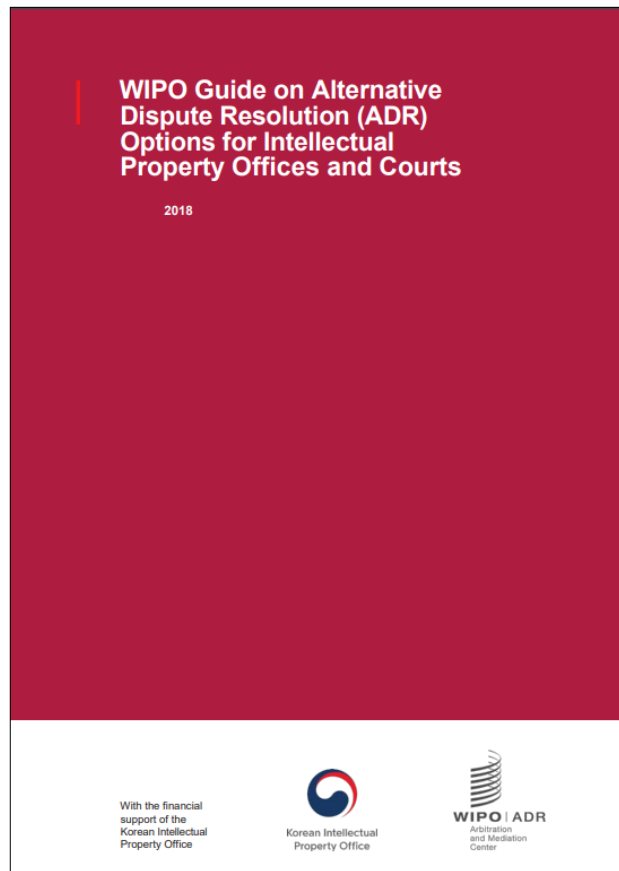


# Role of the WIPO Center

- 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 (including Singapore)
  - Specialized in IP and technology

# WIPO Guide on ADR for IP Offices and Courts

- WIPO Guide on ADR for IP Offices and Courts:  
<http://www.wipo.int/amc/en/center/specific-sectors/ipos/>



# WIPO ADR for IP Offices and Courts: WIPO–IPOS Collaboration

## ■ **WIPO Mediation for IPOS Trademark Proceedings**

- Areas: trademark opposition, invalidation, revocation

## ■ **WIPO Mediation for Copyright Disputes**

- Areas: licensing disputes (including proceedings before the Copyright Tribunal), collective management, orphan works, copyright disputes pending before the courts

## ■ **WIPO Panel of Singapore-based Mediators**

## ■ **Reduced fees**

## ■ **Covid-19 Update: WIPO mediation at no charge for Requests filed before August 31, 2020**

## Request for WIPO Mediation

### 1. Parties

Please provide the following contact information:

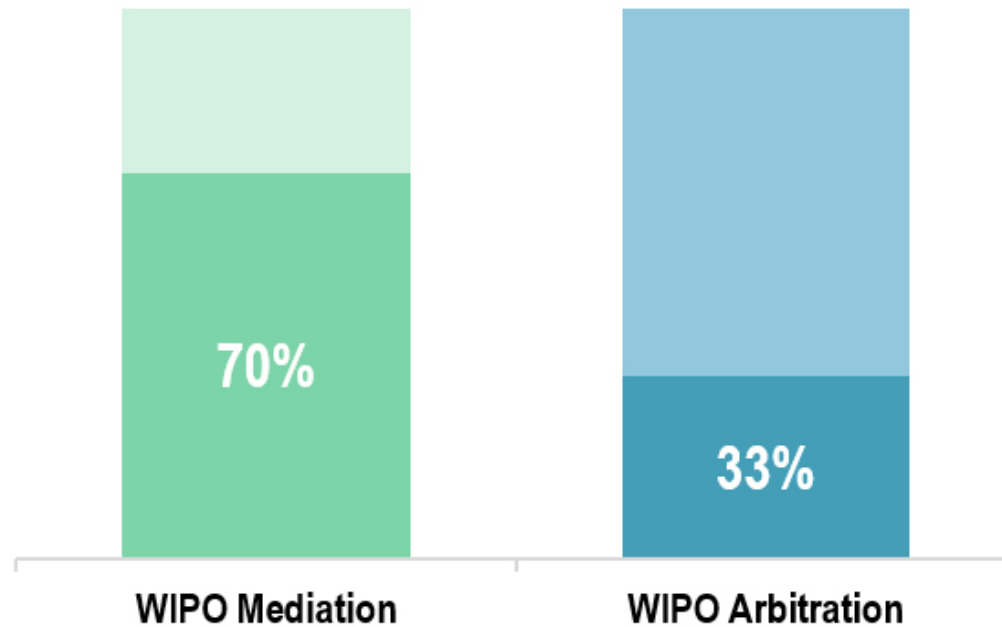
Initiating party in the dispute		Responding party in the dispute	
Name	:	Name	:
Country of domicile	:	Country of domicile	:
Tel	:	Tel	:
Email	:	Email	:
Address	:	Address	:
Represented by :		Represented by :	
Tel	:	Tel	:
Email	:	Email	:
Address	:	Address	:

### 2. Dispute

Please provide a brief description of the dispute:



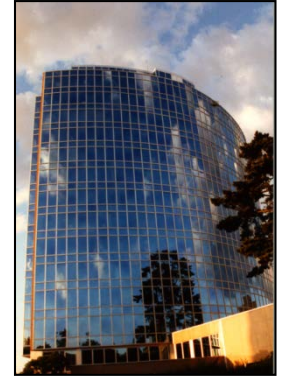
# WIPO ADR settlement rate





# WIPO Arbitration and Mediation Center

- Queries: [arbiter.mail@wipo.int](mailto:arbiter.mail@wipo.int)
- Clauses: [www.wipo.int/amc/en/clauses](http://www.wipo.int/amc/en/clauses)
- Rules: [www.wipo.int/amc/en/rules](http://www.wipo.int/amc/en/rules)
- Neutrals and case examples: [www.wipo.int/amc](http://www.wipo.int/amc)
- Endorse the WIPO Mediation Pledge:  
<https://www.wipo.int/amc/en/mediation/pledge.html>
  
- Offices:
  - Geneva, Switzerland
  - Singapore, Singapore





# Resolving IP and Technology Disputes Through WIPO Mediation

WIPO-IPOS Webinar Resolving IP  
and Technology disputes  
through WIPO Mediation

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Francine Tan, Francine Tan Law Corporation

# Mediation

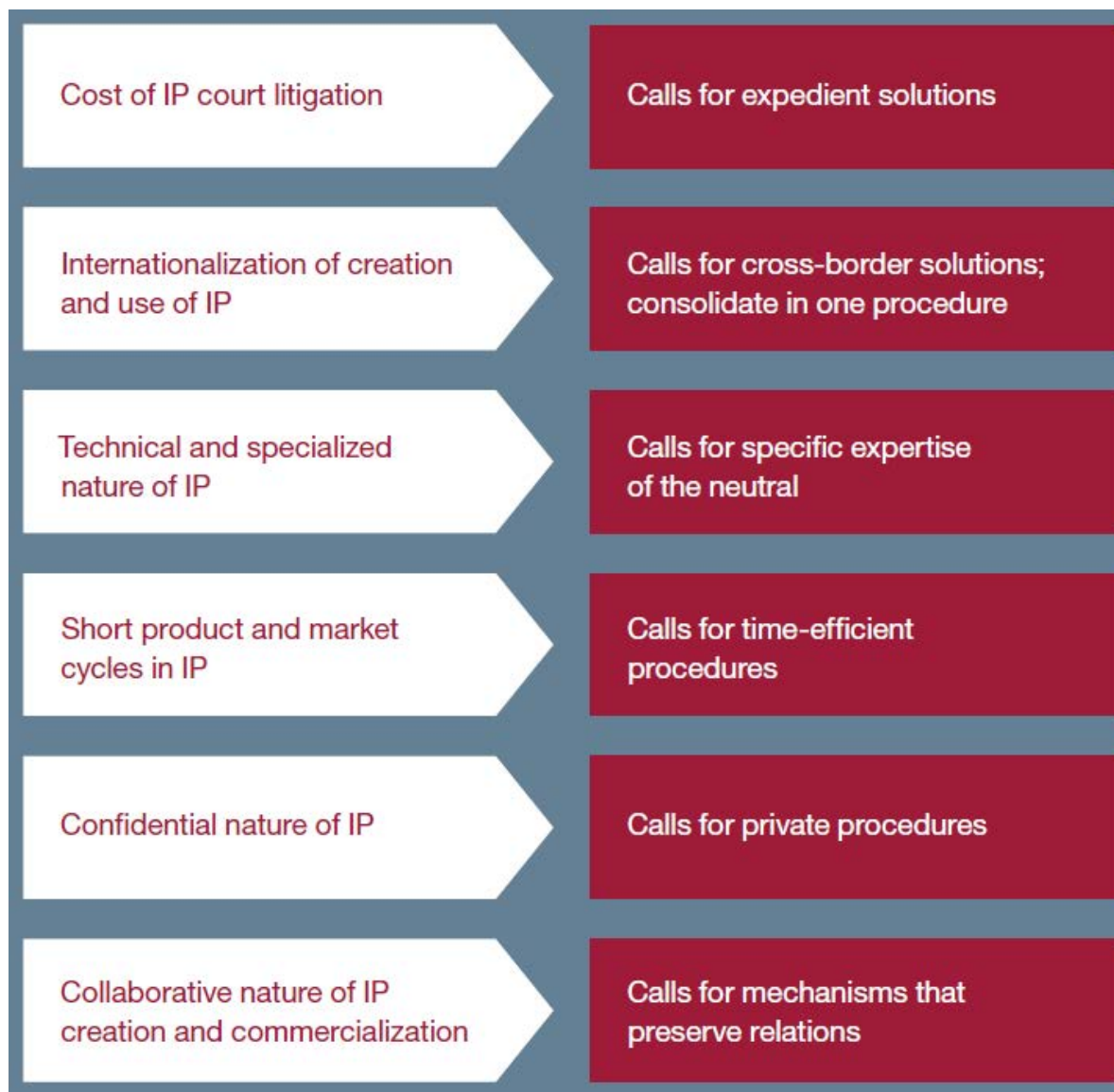
- Informal consensual process
- Neutral intermediary – mediator
  - assists parties in reaching settlement of their dispute
  - based on parties' interests
  - cannot impose a decision
- Settlement agreement has force of a contract
- Leaves open court or arbitration options
- Confidentiality



# Mediation

- The tango
- The mindset
- Opens up possibilities for future settlement
- Allows you to get to know the “adversary”
- The “Rooster” case – no “fowl” play; killing two birds with one stone.
- The WIN-WIN

# Why ADR for IP disputes?



# WIPO-IPOS Webinar

## Resolving IP and Technology Disputes Through WIPO Mediation

7 August 2020

PERSPECTIVES FROM  
INTELLECTUAL PROPERTY OFFICE OF SINGAPORE (IPOS)

See Tho Sok Yee  
Principal Legal Counsel / Principal Assistant Registrar



1

Mediation in IPOS Proceedings

2

Role of WIPO Center

3

Enhanced Mediation Promotion Scheme (EMPS)

4

Legal Developments in Singapore

5

Benefits of Mediation and Success Stories

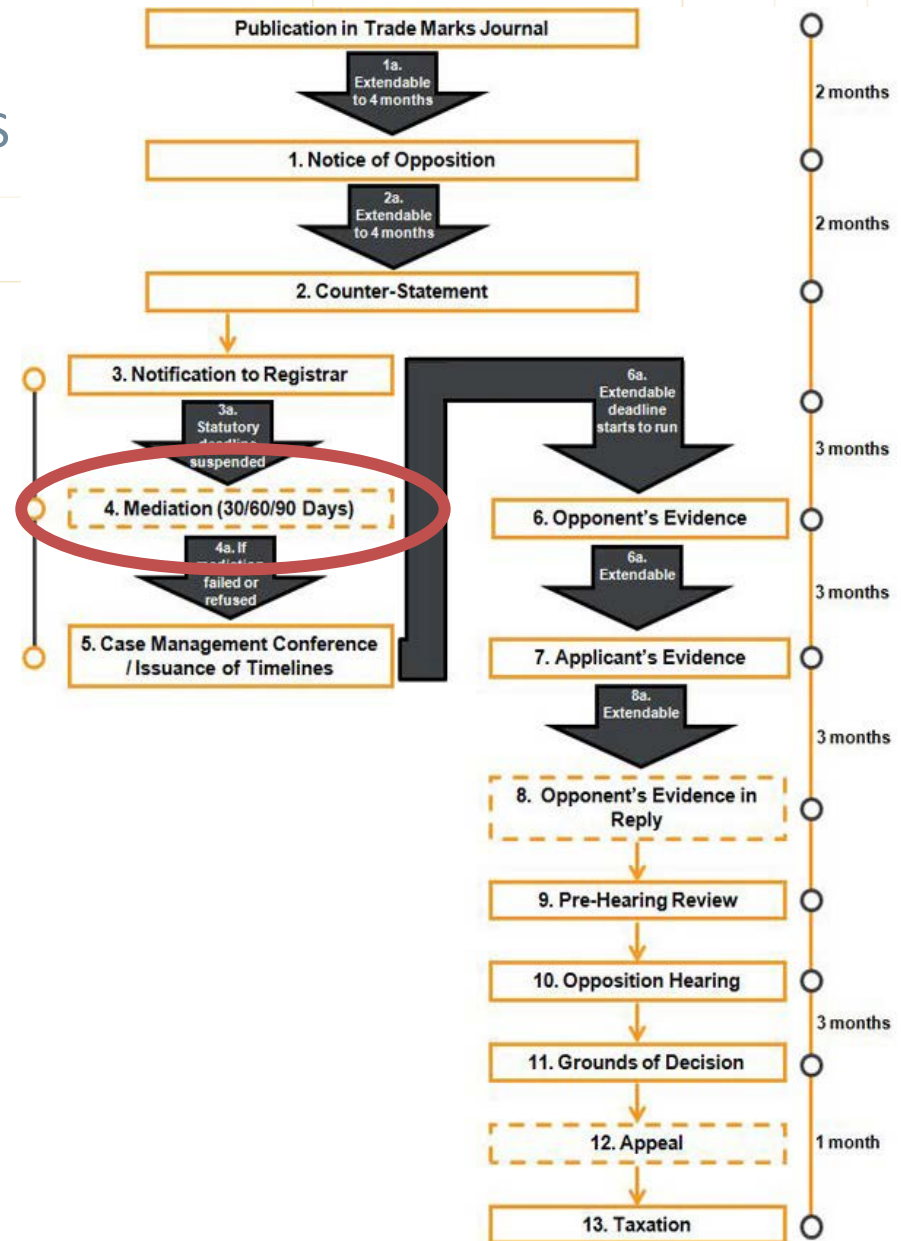


# Collaboration between WIPO and IPOS




- Memorandum of Understanding 28 September 2011
  - 1st such collaboration between the WIPO and a national IP Office
- WIPO
  - WIPO Center's Singapore office is its only office outside Geneva
  - Established in May 2010 in Singapore
  - Over 2,000 neutrals from the international community (including Singapore)
    - Specialist arbitrators, mediators and experts, knowledgeable in the relevant IP fields
- Options for Users at IPOS
  - Mediation
  - Expert determination

# 1. MEDIATION IN IPOS PROCEEDINGS



## 1. MEDIATION IN IPOS PROCEEDINGS

- **Mediation option is introduced following the filing of the Counter-Statement, and can be requested at any time before IPOS decides the outcome of the case.**
  - Parties will be given time to consider dispute resolution options after filing of Counter-Statement.
- **If the parties decide to embark on mediation, they must complete and return a signed Notification to Registrar.**



**Filing of  
Counter-  
Statement**

**Parties decide to  
embark on  
mediation**

**Parties to  
complete and  
return signed  
Notification to  
Registrar**

## 1. MEDIATION IN IPOS PROCEEDINGS

- **The period set aside for mediation could be 30 days, 60 days or 90 days.**
  - This period may be extended upon further request and justification by parties to the satisfaction of the Registrar.
- **IPOS is not directly involved in the mediation.** Once the parties initiate the mediation process, the mediation service provider will see the parties through the mediation process.
  - The initiating party will inform IPOS of the mediation outcome within 2 weeks from the end of the mediation process.
  - If the dispute is not fully resolved, IPOS will resume conduct of the matter.

## 2. ROLE OF WIPO CENTER

- Parties can submit dispute for mediation in IPOS proceedings using the WIPO Center
- **If both parties agree to mediate:**
  - Jointly complete **Request for WIPO Mediation** and send to WIPO Center Office in Singapore, IPOS and the other party.
  - **WIPO Centre will contact the parties about mediation details**
- **If one party wants to propose mediation:**
  - Complete Sections 1, 2 and 3 of **Request for WIPO Mediation** and send to WIPO Center Office in Singapore, IPOS and the other party.
  - WIPO Centre will approach the other party to help them in considering the unilateral Request for WIPO Mediation.

# Mediation Option at IPOS

## 3. ENHANCED MEDIATION PROMOTION SCHEME (EMPS)



### 3 years from 1 April 2019

Funded up to **S\$10,000 / S\$12,000** (if mediation also covers foreign intellectual property rights) per mediation case

- Mediation service provider's fees
- Mediator's fees
- ***Mediation-related lawyer / agent fees and disbursements (up to 50%)***



### Parties must have existing dispute at IPOS

### Parties must agree to

- Mediate in Singapore and use a Singapore-based mediator
- Shadow mediator observing mediation
- Provide information about agent fees
- Provide feedback about mediation experience
- Named publicity, without disclosing details of settlement terms



# Mediation Option at IPOS



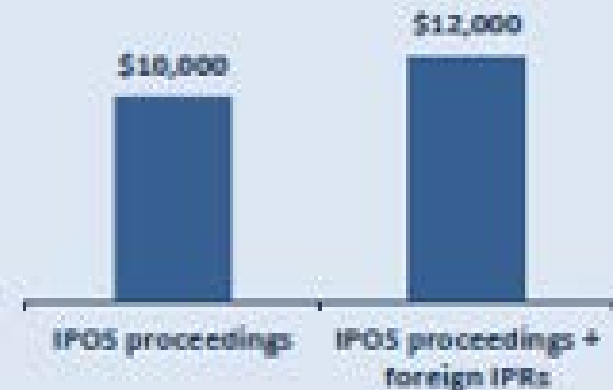
## Mediation Promotion Scheme (MPS) Enhanced

Funding for mediation undertaken by parties in dispute at IPOS,  
regardless of mediation outcome

Up to **\$10,000** per mediation case for:

- ✓ Mediation service provider's administration fee
- ✓ Mediator's fee
- ✓ Mediation-related agent fees  
(Each party must co-pay at least 50% of its agent fees)

Up to **\$12,000** per mediation case if the mediation also  
covers foreign intellectual property rights





# Mediation Option at IPOS



- ☐ Submit dispute at IPOS to mediation under your preferred mediation service provider
- ☐ Inform us that you intend to apply for funding under MPS



- ☐ Mediator must be physically in Singapore
- ☐ Allow a “shadow” mediator to observe mediation



- ☐ Submit MPS application form to IPOS
- ☐ Give information about agent fees in bands (specific amount not needed)
- ☐ Agree to full publicity, including the parties' identity but excluding settlement terms

Consider mediation as an appropriate resolution process for your dispute

For more information, contact IPOS at 6339 8616 or  
visit <https://www.ipos.gov.sg/protecting-your-ideas/hearings-mediation/mediation>

## 4. LEGAL DEVELOPMENTS IN SINGAPORE

### United Nations Convention on International Settlement Agreements Resulting from Mediation (Singapore Convention on Mediation)



- Signed in Singapore in August 2019
- Entry into force on 12 September 2020
- Ease enforcement of cross-border commercial mediation settlement agreements

### Mediation Act 2017 (“MA”) with effect from 1 November 2017



- **Key Advantage**
  - Allows mediated settlements to be enforced as orders of court (section 12(5) MA)
- **Applicability** (*section 6 MA*)
  - Mediation conducted wholly or partly in SG
  - Agreement provides that SG law applies to the mediation
- **Requirements** (*amongst others, section 12 MA*)
  - Mediation administered by designated service provider or certified mediator
  - WIPO is a designated service provider
  - Indicative of the important presence and role which WIPO Center plays in Singapore’s ADR landscape



## 5. BENEFITS OF MEDIATION & SUCCESS STORIES

### ■ Case A

- Singaporean construction company filed oppositions against 3 trade mark applications owned by 3 commercially related entities based in Singapore, Malaysia and Indonesia
- Resolved all outstanding proceedings on a *global* basis
- Singaporean IP lawyer as mediator and 1 day mediation
- Settled 4 months after commencement of mediation

### ■ Case B

- Singaporean medical service provider filed an opposition against a trade mark application filed by a Malaysian company
- Singaporean IP lawyer as mediator and 1 day mediation
- Settlement - Malaysian company agreed to file new application on agreed terms

### ■ Case C

- Chinese exporting company filed an application for invalidation against a trade mark registration owned by a Singapore distributor
- Singaporean IP lawyer fluent in Chinese appointed as mediator and 1 day mediation session
- Settlement 3.5 months after commencement of mediation - Chinese company agreed to withdraw the application for invalidation

## 5. BENEFITS OF MEDIATION & SUCCESS STORIES



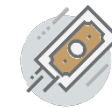
### 2017 Trade Marks Dispute (International versus local company)



Singaporean IP lawyer completed mediation in **1 day** — resolved dispute before IPOS + other disputes globally



Foreign party's decision maker participated via **video conference** while mediator and parties' representatives were in **mediator's office**



**Total costs** (administrative and mediator's) fully subsidised under MPS =  
**S\$3,450.20 (between 2 parties)**

*"We are very happy with the service we received and the result of the mediation."*

*"...we would still use the mediation service if we thought it could assist us in settling a dispute in a cost-effective and timely manner even if funding is not available".*

***Party Feedback***

## 5. BENEFITS OF MEDIATION & SUCCESS STORIES

### ENHANCED MEDIATION AT IPOS—EMPS SUCCESS CASE

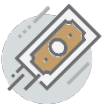
#### 2019 Both parties foreign companies, flew to Singapore for the mediation



Singaporean IP lawyer completed mediation in **19.5 hours**



Resolved dispute before IPOS *and* also achieved global resolution (total 6 countries)

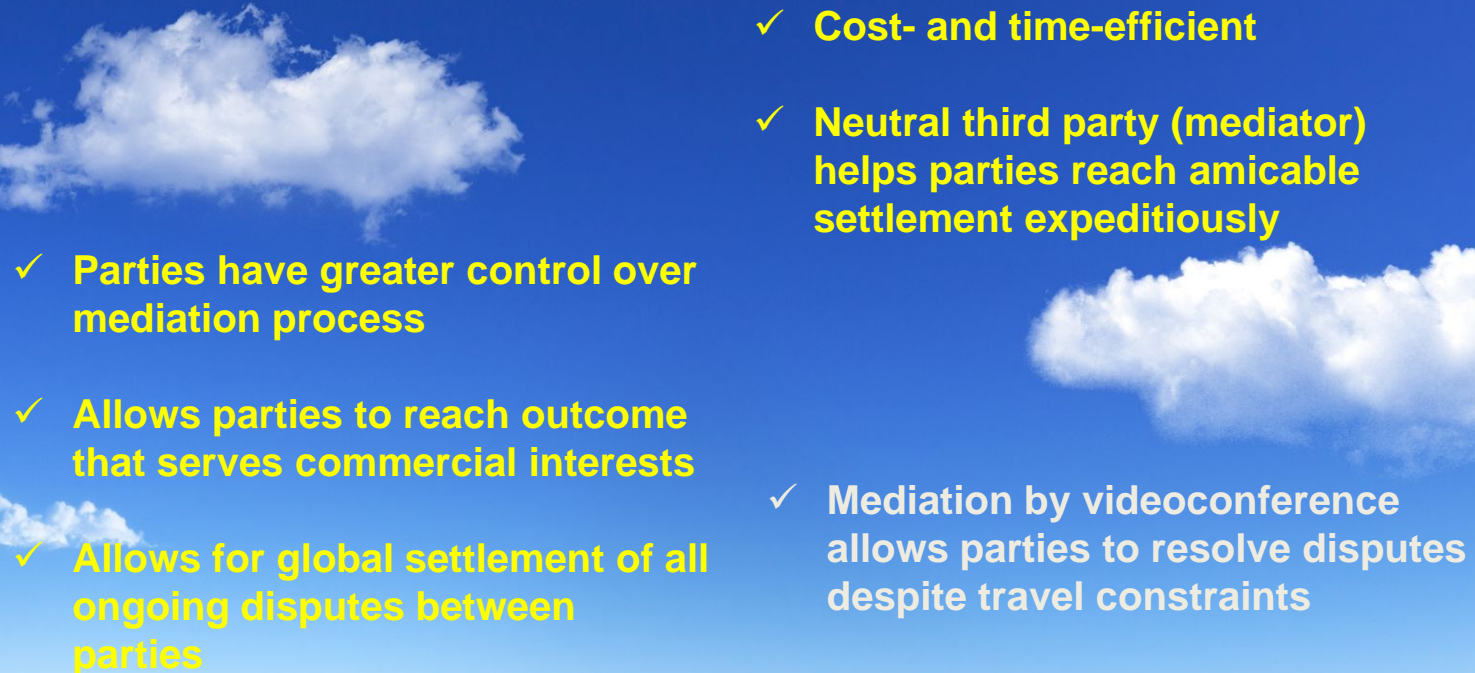


Total (administrative and mediator's) costs: SGD 11,349.98 (between 2 parties)

- **Fully** subsidized under EMPS (mediator's fees and administration fees of the service provider)
- Also **partially** defrayed mediation-related lawyer fees and disbursements

[https://www.ipos.gov.sg/docs/default-source/protecting-your-ideas/hearings-mediation/mediation-success-at-ipos-\(emps\).pdf](https://www.ipos.gov.sg/docs/default-source/protecting-your-ideas/hearings-mediation/mediation-success-at-ipos-(emps).pdf)

## 5. BENEFITS OF MEDIATION & SUCCESS STORIES

- 
- ✓ Parties have greater control over mediation process
  - ✓ Allows parties to reach outcome that serves commercial interests
  - ✓ Allows for global settlement of all ongoing disputes between parties
  - ✓ Cost- and time-efficient
  - ✓ Neutral third party (mediator) helps parties reach amicable settlement expeditiously
  - ✓ Mediation by videoconference allows parties to resolve disputes despite travel constraints