

## WIPO LIST OF NEUTRALS

### BIOGRAPHICAL DATA

M. Scott DONAHEY  
Palo Alto, CA  
United States of America



Nationality: American

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### EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

J.D., (*summa cum laude*), Santa Clara University;  
M.A., Writing Seminars, The Johns Hopkins University, Baltimore, Maryland;  
B.A., English, with distinction, Stanford University, California.

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### LANGUAGES

English  
Written and oral comprehension of Spanish, and written comprehension of Italian and French

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### PRESENT POSITION

Private practice, (Arbitration, Mediation and Domain Names).

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### MEMBERSHIP IN PROFESSIONAL BODIES

#### International arbitration:

Member, NAFTA, Advisory Committee on Private Commercial Disputes, 2000-2010;  
Advisory Council, U.S. - Mexico Conflict Resolution Center;

February 4, 2020

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Panel of Arbitrators, Hong Kong International Arbitration Centre;  
 Panel of Arbitrators, Japan Commercial Arbitration Association;  
 Panel of Arbitrators, American Arbitration Association, International Panel, New York;  
 Panel of Arbitrators, Singapore International Arbitration Centre;  
 Panel of Arbitrators, U.S. - Mexico Conflict Resolution Center;  
 Tutor, International Arbitrator Training, Chartered Institute of Arbitrators, London;  
 Faculty, International Arbitrator Training, American Arbitration Association;  
 Panel of Arbitrators, British Columbia International Commercial Arbitration Centre;  
 Panel of Arbitrators, Center for International Commercial Dispute Resolution, Honolulu, Hawaii;  
 Panel of Arbitrators, Commercial Dispute Resolution Center of the Americas, Miami;  
 Panel of Arbitrators, Court of Arbitration at the Polish Chamber of Commerce;  
 Panel of Arbitrators, Korean Commercial Arbitration Board;  
 Panel of Arbitrators, Commercial Arbitration Association of the Republic of China, Taiwan;  
 Panel of Arbitrators, Kuala Lumpur Regional Centre for Arbitration, Malaysia;  
 Panel of Arbitrators, World Intellectual Property Organization Arbitration and Mediation Center, Geneva;  
 Panel of Neutrals, Abusive Registration Domain Names, World Intellectual Property Organization Arbitration and Mediation Center, Geneva;  
 Past Chair, International Arbitration Committee, International Law Section, American Bar Association;  
 Vice-Chair, Dispute Resolution and Arbitration Committee, Inter-Pacific Bar Association;  
 Vice-Chair, Alternative Dispute Resolution Committee, Licensing Executives Society International.

**Domestic arbitration:**

Fellow, College of Commercial Arbitrators;  
 Copyright Arbitration Royalty Panel, 1998-99;  
 Chair, IP Committee, American Bar Association, Dispute Resolution Section;  
 Chair, Y2K Task Force, American Bar Association, Dispute Resolution Section;  
 American Arbitration Association, Panel of Arbitrators, Year 2000 Panel;  
 CPR Panel of Distinguished Neutrals, Technology Panel; Biotechnology and Pharmaceuticals Panel;;  
 Trademark Law Panel; Patent Law Panel.  
 CPR Panel of Distinguished Neutrals, Year 2000 Panel;  
 National Patent Board, Board of Trustees, Panel Selection and Oversight Committee;  
 The Cyber Tribunal, Panel of Neutrals;  
 American Arbitration Association Panel of Arbitrators, Large Complex Case Panel;  
 American Arbitration Association Panel of Arbitrators, Intellectual Property/Technology Panel, Chair Online Dispute Resolution Committee;  
 Northern California Advisory Council, American Arbitration Association.  
 Past Chair, Section on Antitrust Law, State Bar of California  
 Past Member, Copyright Arbitration Royalty Panel.

**Mediation:**

Panel of Distinguished Neutrals, CPR Institute for Dispute Resolution;  
 Panel of Mediators, International Centre for Dispute Resolution;  
 Panel of Mediators, United States District Court, Northern District of California;  
 Panel of Mediators, First Appellate District Court, State of California;  
 Panel of Mediators, Intellectual Property Panel, National Arbitration Forum;  
 Panel of Mediators, U.S. - China Business Mediation Panel.

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**AREAS OF SPECIALIZATION**

Intellectual Property, trademarks, domains names;  
 Intellectual property, electronic commerce;  
 Intellectual property, patents-chemistry;

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Intellectual property, copyright-computer programs;  
 Intellectual property, patents-computer peripherals;  
 Arbitration: international commercial arbitration generally, and intellectual property licensing agreements.

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### EXPERIENCE IN INTELLECTUAL PROPERTY

Has been involved in intellectual property litigation of one kind or another as a litigation attorney, arbitration attorney, mediation counsel and arbitrator, since 1978.

Selected representative cases as arbitrator:

Chair, AAA arbitration, New York - dispute between two multinational agricultural conglomerates concerning alleged breach of license of patented bioengineering patent and alleged misuse of trademark – hundreds of million dollars in dispute.

Chair, ICC arbitration, Palo Alto - dispute between two software companies concerning alleged breach of software license concerning mobile banking enablement – tens of millions of dollars in dispute.

Sole arbitrator, CPR Institute arbitration, Washington, DC – Dispute between major pharmaceutical company and private investment fund concerning the funding of the development of a patented medical device – tens of millions of dollars in dispute,

Chair, ICC arbitration, San Francisco – Dispute over ownership of rights to patents concerning 1) the use of single molecule Raman spectroscopy for direct DNA sequencing, and 2) use of a nanolens to directly identify each individual sub-unit in a single strand of DNA as the sub-unit is encountered – tens of millions of dollars in dispute.

Chair, CPR Institute arbitration, Chicago – Dispute between two pharmaceutical companies concerning claim for patent infringement regarding patent for covering coronary stent technology. Case removed from Federal Court and submitted to arbitration. Amount in dispute unknown, but in hundreds of millions of dollars.

Sole arbitrator, AAA arbitration, Palo Alto – Dispute between North American subsidiary of the world's largest manufacturer of DRAM components and modules and a licensed reseller, alleging breach of license agreement – tens of millions of dollars in dispute.

Sole appeal arbitrator, CPR Institute arbitration, New York – Appeal of a three person arbitration award concerning a patent licensing dispute between a private biotechnology company and the biotechnology subsidiary of a large pharmaceutical company concerning a licensing dispute involving a patent covering a composition of matter claiming a monoclonal antibody intended for the treatment of Type 1 diabetes – hundreds of millions of dollars in dispute.

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### MAJOR PUBLICATIONS

#### Publications:

Chapter on "ICANN Dispute Resolution Guidelines," *Internet Law & Practice*, Ch. 16, The West Group (2002);

Chapter on "Unique Problems Posed by Intellectual Property Disputes," *The Alternative Dispute Resolution Practice Guide*, Ch. 18, The West Group, 2001;

Chapter on "International Mediation and Conciliation," *The Alternative Dispute Resolution Practice Guide*, Ch. 33, The West Group, 2001;

"Distinctive and Famous"- Separate Requirements Under the Federal Trademark Dilution Act?," 3 *J. Marshall Rev. Intell. Prop. L.* 174 (April 2004);

- "The UDRP Model Applied to Online Consumer Transactions," *Journal of International Arbitration*, Vol. 20, No. 5, 475, October 2003;
- "New Dispute Resolution Procedures for .cn Domain Are Far-Reaching," *Electronic Commerce & Law Reports*, Vol. 7, No. 47, December 11, 2002;
- "Settling Disputes the NPB Way," *Dispute Resolution Journal*, 76, August-October 2002;
- "ICANN's Newest Service Provider: The Asian Domain Name Dispute Resolution Centre" *E-Commerce Law*, June 2002;
- "Divergence in the UDRP and the Need for Appellate Review," *Journal of Internet Law*, Vol. 5, No. 11, 1 (May 2002);
- "The Uniform Domain Name Dispute Resolution Process and the Appearance of Impartiality - Panelists Impaled on the Horns of a Dilemma," *Journal of International Arbitration*, Vol. 19, No. 1, 33 (February 2002);
- "Binding Arbitrations of Domain Name Disputes in Hong Kong," *Journal of Internet Law*, Vol. 5, No. 3, 12, September 2001;
- "The UDRP: Fundamentally Fair, But Far From Perfect," *Electronic Commerce & Law Reports*, Vol. 6, No. 34, August 29, 2001;
- "New gTLD's, .biz and .info, Introduce New Dispute Resolution Processes," *Electronic Commerce & Law Reports*, Vol. 6, No. 26, 674, June 27, 2001;
- "A Proposal for an Appellate Panel for the Uniform Domain Name Dispute Resolution Policy," *Journal of International Arbitration*, Vol. 18, No. 1, 131, February 2001;
- M. Scott Donahey and Sandra A. Sellers, "Can Three-Mediator Panels Resolve 'Impossible' Disputes?," *Alternatives*, Vol. 19, No. 2, 71, February 2001;
- M.S. Donahey, "ADR is The Better Way to Settle Disputes Over Y2K," *The National Law Journal*, October 4, 1999;
- M.S. Donahey, "Resolving Certain Domain Name Disputes - The WIPO Recommendations," Vol. 3, N° 1 *Journal of Internet Law* 9, July 1999;
- M.S. Donahey, "Court of First Resort," *California Law Business*, February 21, 1999;
- "Dispute Resolution in Cyberspace," Part 1 - Vol. 2, N° 6 *Journal of Internet Law* 25, December 1998;
- "Dispute Resolution in Cyberspace," Part 2 - Vol. 2, N° 7 *Journal of Internet Law* 5 January 1999;
- "Dispute Resolution in Cyberspace," article reprinted in full at Vol. 15, N° 4 *Journal of International Arbitration* 127, December 1998;
- "Closed Parameters: Arbitrators Must Comply With Parties' Agreement," *San Francisco Daily Journal*, June 24, 1998, at 5;
- "International Mediation/Conciliation," *ADR & The Law*, 20 *Fordham International Law Journal* 271, 1997;
- "From *The Bremen to Mitsubishi* (and Beyond): International Arbitration Adrift in U.S. Waters," Vol. 7, N° 2, *The American Review of International Arbitration* 149, 1996;
- "International Commercial Dispute Resolution," Vol. 31, N° 2 *The International Lawyer* 261, Summer 1997;
- Casnote "On the Case *Kotam Electronics, Inc. v. JBL Consumer Products, Inc.*," Vol. 14, N° 2 *Journal of International Arbitration* 145, June 1997;
- Regular columnist on ADR for *The IP Litigator*;
- M.S. Donahey, "Enforcement of Injunctive Relief and Arbitration Awards Concerning Title to and Enforcement of Intellectual Property Rights in Asia and the Pacific Rim," vol. 19; No. 4 *Hastings International and Comparative Law Review*, Summer 1996;
- M.S. Donahey, "Defending the Arbitration Against Sabotage," vol. 13, No 1 *Journal of International Arbitration*, March 1996;
- M.S. Donahey, "The Asian Concept of the Conciliator/Arbitrator: Is It Translatable to the Western World?," *Foreign Investment Law Journal*, vol. 10, No 1, Spring 1995;
- M.S. Donahey, "Seeking Harmony - The Asian Concept of the Conciliator/Arbitrator," *Dispute Resolution Journal*, April-June 1995; reprinted at vol. 61, No 4 *Arbitration* 279, a quarterly publication of the Chartered Institute of Arbitrators, November 1995;
- M.S. Donahey, "Two Cultures, One System," vol. 4, No 4, *Asian Law Journal* 26, April 1995;
- M.S. Donahey, "Mediation, Arbitration Resolve Disputes While Reducing Costs," *San Jose Mercury News*, November 28, 1994;
- M.S. Donahey, "Avoiding Discovery in US Arbitration," 1994, 5 *Singapore Institute of Arbitrators Newsletter*, November 3, 1994;

## WIPO Profile - M.S. DONAHEY

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- M.S. Donahey, "The UNCITRAL Arbitration Rules and the Truncated Tribunal," vol.4, No 2, *The American Review of International Arbitration*, 191, 1993;
- M.S. Donahey, "The UNCITRAL Arbitration Rules and the Truncated Tribunal," vol.4, No 2, *The American Review of International Arbitration*, 191, reprinted at 38 *Commercial Arbitration* 99, a quarterly publication of the Commercial Arbitration Association of the Republic of China, January 16, 1995;
- M.S. Donahey, "Punitive Damages in International Commercial Arbitration," Vol. 10, No 3 *Journal of International Arbitration* 67, September 1993;
- M.S. Donahey, "Punitive Damages in International Commercial Arbitration," Vol. 10, No 3 *Journal of International Arbitration* 67, reprinted at [1994] 2 *Singapore Arbitrator* 2, April 1994;
- M.S. Donahey, "Punitive Damages in International Commercial Arbitration," Vol. 10, No 3 *Journal of International Arbitration* 67, reprinted in the ABA Section of International Law and Practice, International Practitioners Workshop Series, Vol. IV, Spring 1994;
- M.S. Donahey, "International Mediation and Conciliation," in *The Alternative Dispute Resolution Practice Guide*, Lawyers Cooperative Publishing, 1993;
- M.S. Donahey, "The Independence and Neutrality of Arbitrators," vol. 9, No. 4 *Journal of International Arbitration* 31, Dec. 1992;
- M.S. Donahey, "The Independence and Neutrality of Arbitrators," vol. 9, No. 4 *Journal of International Arbitration* 31, reprinted at 33 *Commercial Arbitration* 64, a quarterly publication of the Commercial Arbitration Association of Taiwan, September 1993;
- M.S. Donahey, "The Independence and Neutrality of Arbitrators," vol. 9, No. 4 *Journal of International Arbitration* 31, reprinted in the ABA Section of International Law and Practice, International Practitioners Workshop Series, vol. IV, Spring 1994;
- M.S. Donahey, "Arbitration: When Mediation Won't Work," *Northern California Human Resources Council Quarterly Bulletin*, October 1992;
- M.S. Donahey, "ADR Gives Parties Control of Process," *Les Nouvelles, Journal of the Licensing Executives Society*, vol. XXVII, No 3, September 1992;
- M.S. Donahey, "Calming Foreign Clients' Fear of U.S. Discovery," *The Recorder*, August 22, 1991;
- M.S. Donahey, "Arbitration More Amicable Way of Settling Business Disputes," *The Business Journal*, June 3, 1991;
- M.S. Donahey, "Mediation and Conciliation in the Asia/Pacific Region: Sites, Centers and Practices," *Doyles Dispute Resolution Practice: Asia/Pacific*, CCH International, 1990;
- M.S. Donahey, "California's Modified Model Law on International Arbitration and Conciliation," *AJJA Gazette of International Arbitration*, July 1988;
- M.S. Donahey and T.P. Devitt, "International Arbitration of Patent Disputes," 65 *Journal of the Patent Office Society* 621, Nov. 1983.
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### EXPERIENCE IN COURT LITIGATION

Has acted as counsel in over 175 court cases, including 50 as lead counsel, in courts of first instance and in appellate courts of the United States of America over the period 1978 to the present time. The subject matter of the court cases concerned patent infringement and invalidity (5), copyright infringement in the areas of computer programs (4), trademark infringement (1), interpretation of licensing contracts (12), antitrust (4), and general contractual disputes (30).

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### PROFESSIONAL TRAINING IN MEDIATION AND ARBITRATION

Attended training put on by the American Arbitration Association Professional Training Arbitrators, received basic and advanced training in commercial arbitration by the American Arbitration Association and course from The Chartered Institute of Arbitrators, London.

One of four authors of the training materials and instructor in the training of international commercial arbitrators for the Asia/Pacific Center for the Resolution of International Business Disputes.

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### **EXPERIENCE IN MEDIATION**

Has acted as counsel in three international mediations which took place in the United States under the auspices of the American Arbitration Association, two of which involved construction projects and one of which involved licensing of computer product. Acted as mediator in commercial disputes.

On various Panels, see "Memberships in Professional Bodies".

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### **EXPERIENCE IN ARBITRATION**

#### **International arbitration:**

Advocate in international commercial arbitrations, involving State companies as well as private concerns. Arbitration venues have included London, Paris, San Francisco and The Hague. Procedural rules have included UNCITRAL, ICC, and American Arbitration Association Rules. Appearances before arbitrators versed in the civil law and common law systems, as well as arbitrators versed in Islamic law.

Arbitrator in complex commercial international arbitrations, typically. Involving technology and/or intellectual property law.

#### **Domestic arbitration:**

Fellow, College of Commercial Arbitrators;

Counsel in numerous arbitrations involving patent licenses, sales of companies, major construction projects, securities, and sales of computer products and software;

Appointed by arbitral institution to supervise clean room development of telecommunications software project:

Arbitrator in numerous arbitrations including serving as chair in arbitrations concerning coronary stent patents, balloon catheter patents, pharmaceuticals, medical devices and genomic databases.

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### **EXPERIENCE WITH RESPECT TO DOMAIN NAMES**

Decided over 300 cases as WIPO-appointed and ADNDRC- appointed domain name panelist under the Uniform Domain Name Dispute Resolution Policy (UDRP). Have decided new gTLD cases concerning string confusion (ICDR), legal rights objections (WIPO), and community objections (ICC).

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**ARBITRATION EXPERIENCE****SUMMARY TABLE**

Type	Administering Institution		Role			
	Name	Number of Arbitrations	Presiding Arbitrator	Sole Arbitrator	Co-Arbitrator	Counsel
International Arbitrations	AAA	16	10	3	3	5
	ICC	10	2	3	5	4
	Iran/US Claims Tribunal	2				2
	Ad Hoc	6	1	1		5
	Others: British Columbia Int'l Commercial Arbitration Centre (BCICAC)	1		1		
Number of cases: Sub-total		35	13	8	8	16
Domestic Arbitrations	AAA	177	27	81	12	57
	CPR Institute For Dispute Resolution	12	10	2		
Number of cases: Sub-total		189	37	83	12	57
<b>TOTAL</b>		<b>224</b>	<b>50</b>	<b>91</b>	<b>20</b>	<b>73</b>

**MEDIATION EXPERIENCE****SUMMARY TABLE**

Type	Administering Institution		Role	
	Name	Number of Mediations	Mediator	Counsel
International Mediations	AAA	6		1
	ICDR	3	3	
	Ad Hoc	3	3	
Number of cases: Sub-total		12	6	1
Domestic Mediations	AAA	47	44	3
	Courts	37	37	
	Ad Hoc	6	5	1
Number of cases: Sub-total		90	86	4
<b>TOTAL</b>		<b>102</b>	<b>92</b>	<b>5</b>