



WIPO | ADR

Arbitration
and Mediation
Center

Resolving IP and technology disputes through WIPO Mediation

WIPO-IPOS Webinar

April 27, 2021

Chiara Accornero
WIPO Arbitration and Mediation Center

World Intellectual Property Organization

- 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

- Alternative Dispute Resolution (ADR)
- Cases concerning all types of IP and technology
- WIPO mediators, arbitrators and experts experienced in IP and technology
- Competitive fees
- International neutrality
- Users around the world




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



Media Meetings Contact Us IP Portal English ▾

IP Services Policy Cooperation Resources About IP About WIPO Search WIPO 🔍

Home > IP Services > Alternative Dispute Resolution

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

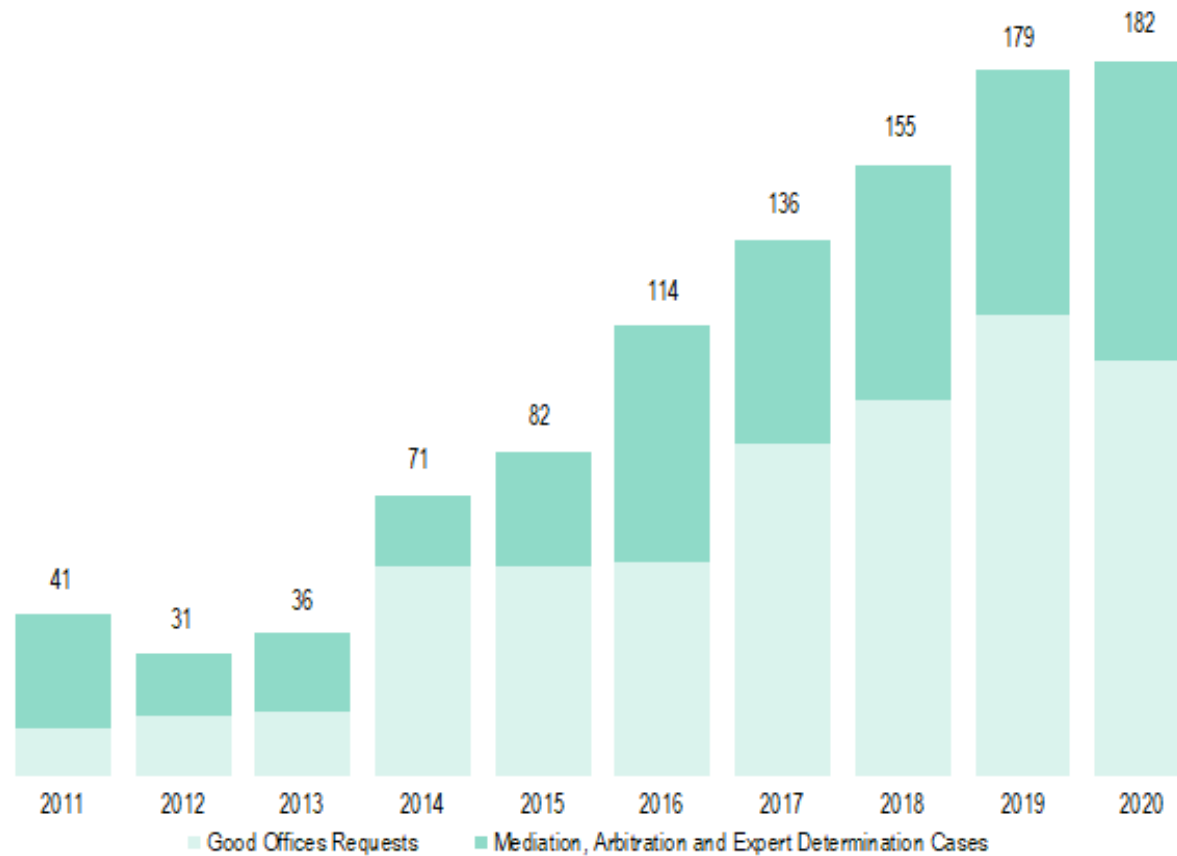
3) Are parties, mediators and arbitrators in WIPO proceedings free to choose the online platform they wish to use for their proceedings?

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.

■ <https://www.wipo.int/amc/en/eadr/checklist/index.html>

WIPO caseload

WIPO Mediation, Arbitration, Expert Determination and
Good Offices Requests Filing
(2011-2020)



WIPO case areas and settlement rates

Commercial

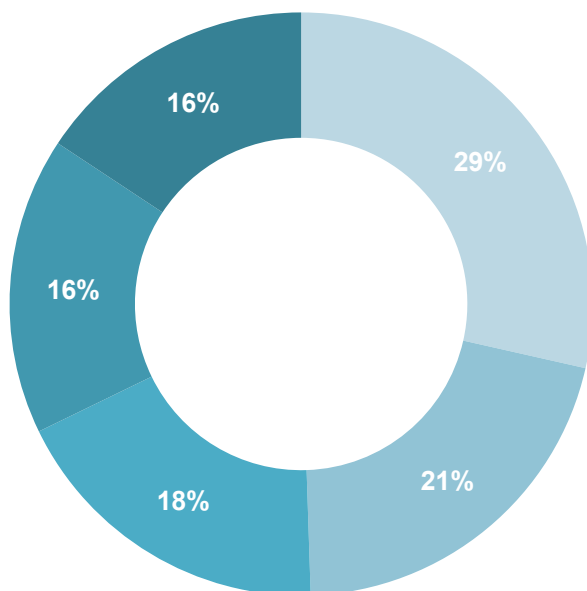
Design
Distribution
Energy
Franchising
Marketing
Sports

Copyright

Art
Broadcasting
Collective Management
Entertainment
Film and Media
Infringements
TV Formats

ICT

Mobile Apps
Outsourcing
Systems Integration
Software Development
Software Licensing
Telecommunications

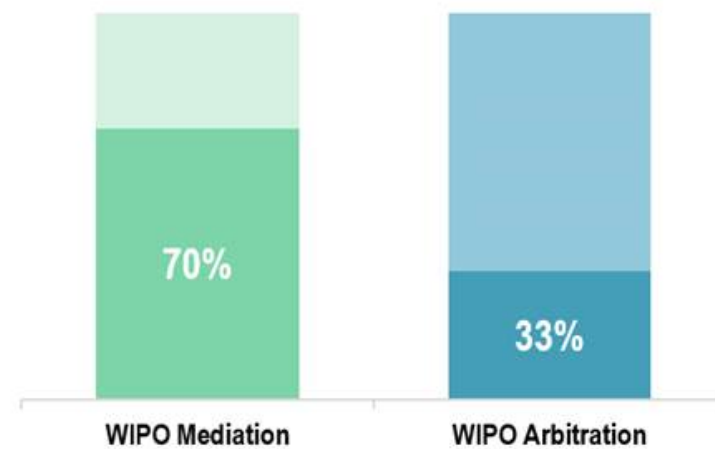


Patents

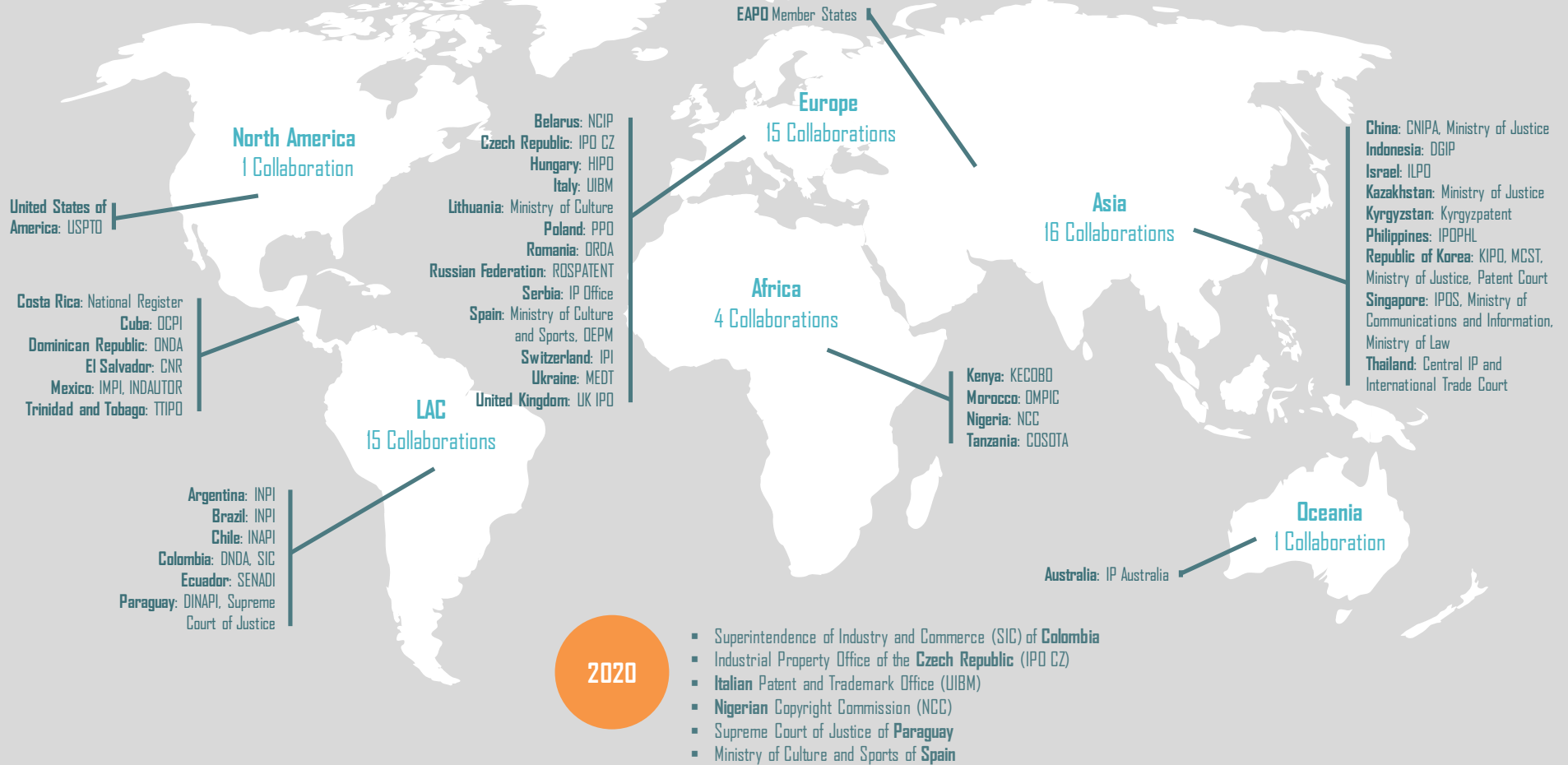
Cross-licensing
Infringements
Licenses
Ownership
Patent Pools
R&D / Tech
Transfer
Royalty Payment

Trademarks

Coexistence
Infringements
Licenses
Oppositions
Revocations



WIPO ADR Collaborations with IP Offices and Courts



WIPO Mediation for IPOS Proceedings

- **WIPO Mediation for IPOS Trademark Proceedings**
 - Areas: trademark opposition, invalidation, revocation
- WIPO Panel of Singapore-based Mediators
- Reduced fees until **June 31, 2021**
 - No administration fees
 - Mediator's fees capped at SGD 5,000
- IPOS Enhanced Mediation Promotion Scheme (EMPS)
- Examples of WIPO Mediations for IPOS Proceedings:
<https://www.wipo.int/amc/en/center/specific-sectors/ipos/mediation/case-examples.html>

Request for WIPO Mediation

1. Parties

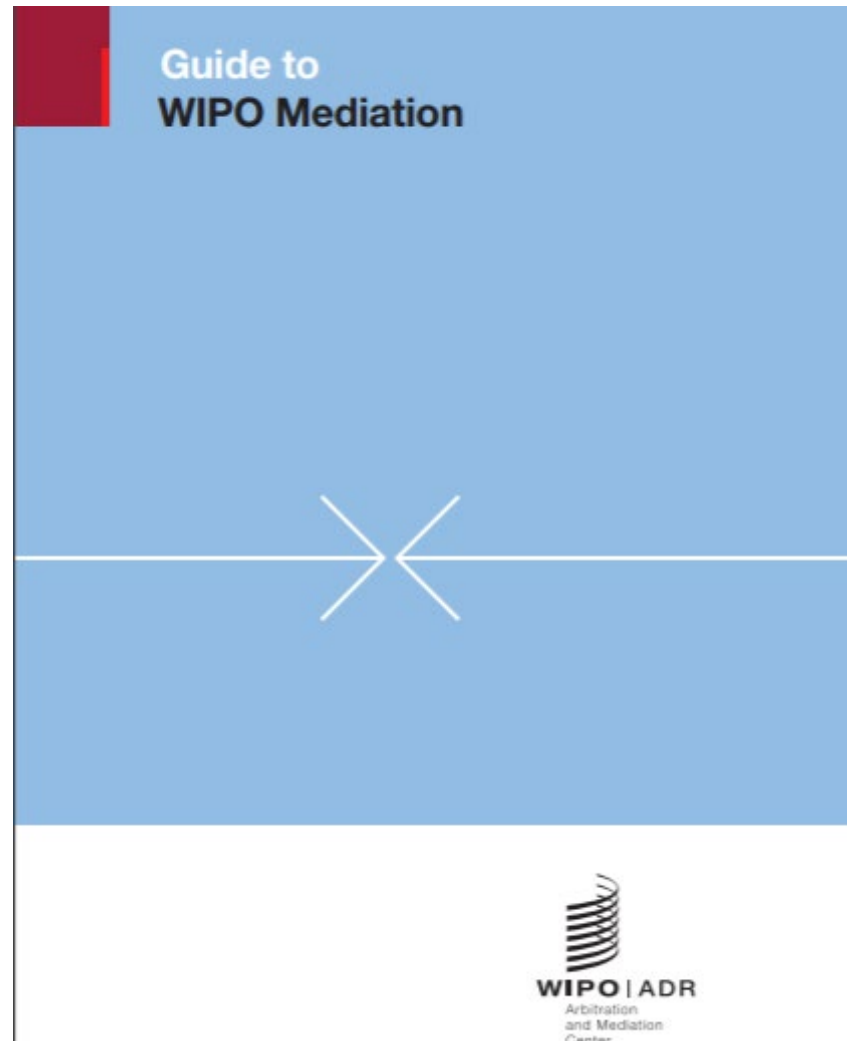
Please provide the following contact information:

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:

Guide to WIPO Mediation

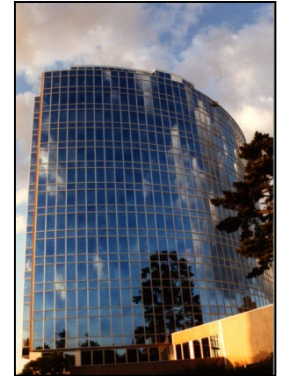


■ https://www.wipo.int/edocs/pubdocs/en/wipo_pub_449_2018.pdf

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



WIPO MEDIATION x DISPUTES

Advantages
of Mediation

Mediation
in Action

Questions?

Resolving
Disputes

Introduction

LEE
&
LEE

Zech Chan, Partner
Intellectual Property
27 April 2021

LEE & LEE

Lee & Lee was founded by Lee Kuan Yew, Lee Kim Yew and Kwa Geok Choo on 1 September 1955. While Lee Kuan Yew went on to become the Prime Minister of Singapore, the remaining partners developed the firm to become one of the leading law firms in Singapore offering a full range of legal services.

Leading law firm in Singapore with staff strength of 200.

Many lawyers have been named as leading experts or recommended practitioners in their respective fields by many legal publications, including Chambers Global – “The World’s Leading Lawyers”, The Asia Pacific Legal 500, Euromoney Legal Media Group, Global Counsel 3000 and Asian Legal Business Legal Who’s Who S’pore.

Intellectual Property

Intellectual Property (IP)

My Practice

- IP Strategy
- Trade Marks Filing and Enforcement
- Litigation and Alternate Dispute Resolution
- Mediating since 2010
- Privacy & Data Protection



Photo by Nico Smit on Unsplash

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Intellectual Property

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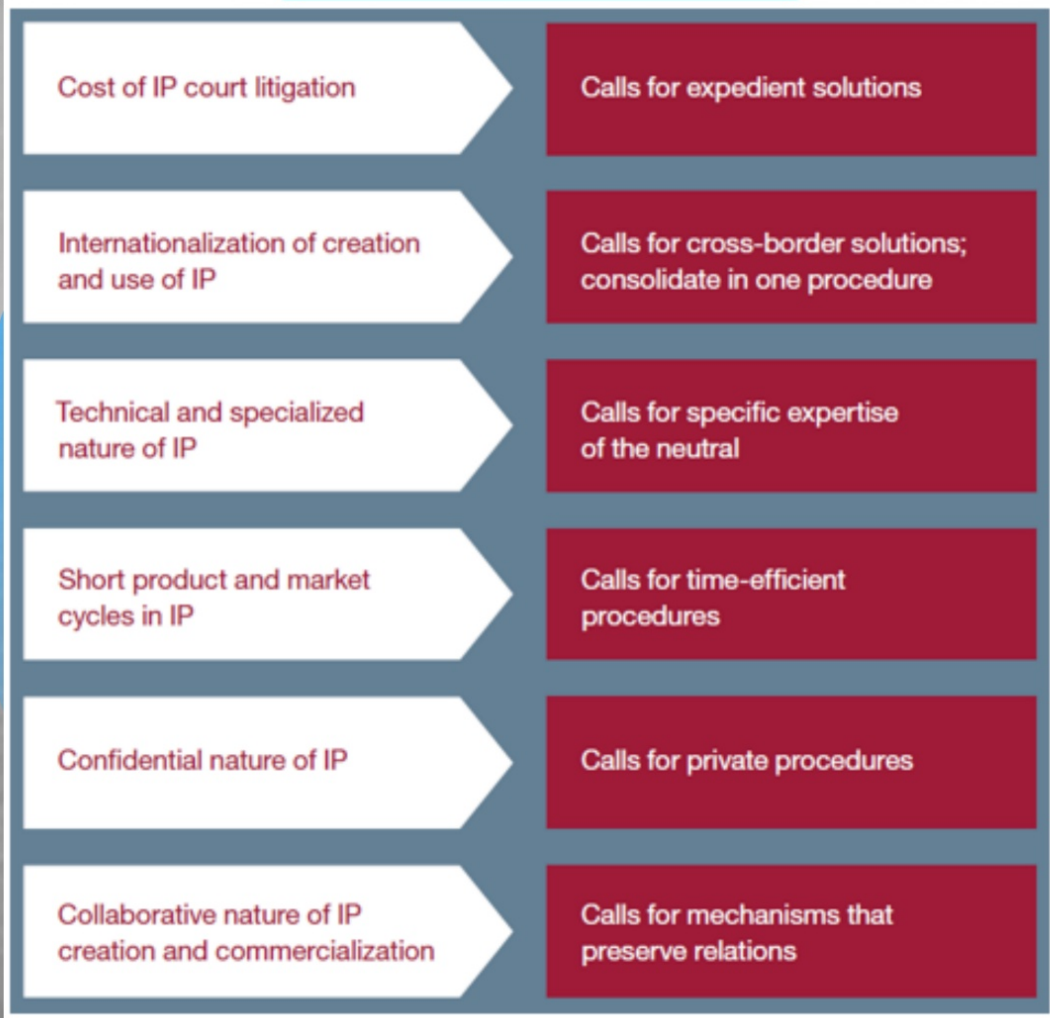
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Why Alternate Dispute Resolution (ADR)?



Mediation

Arbitration

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Center

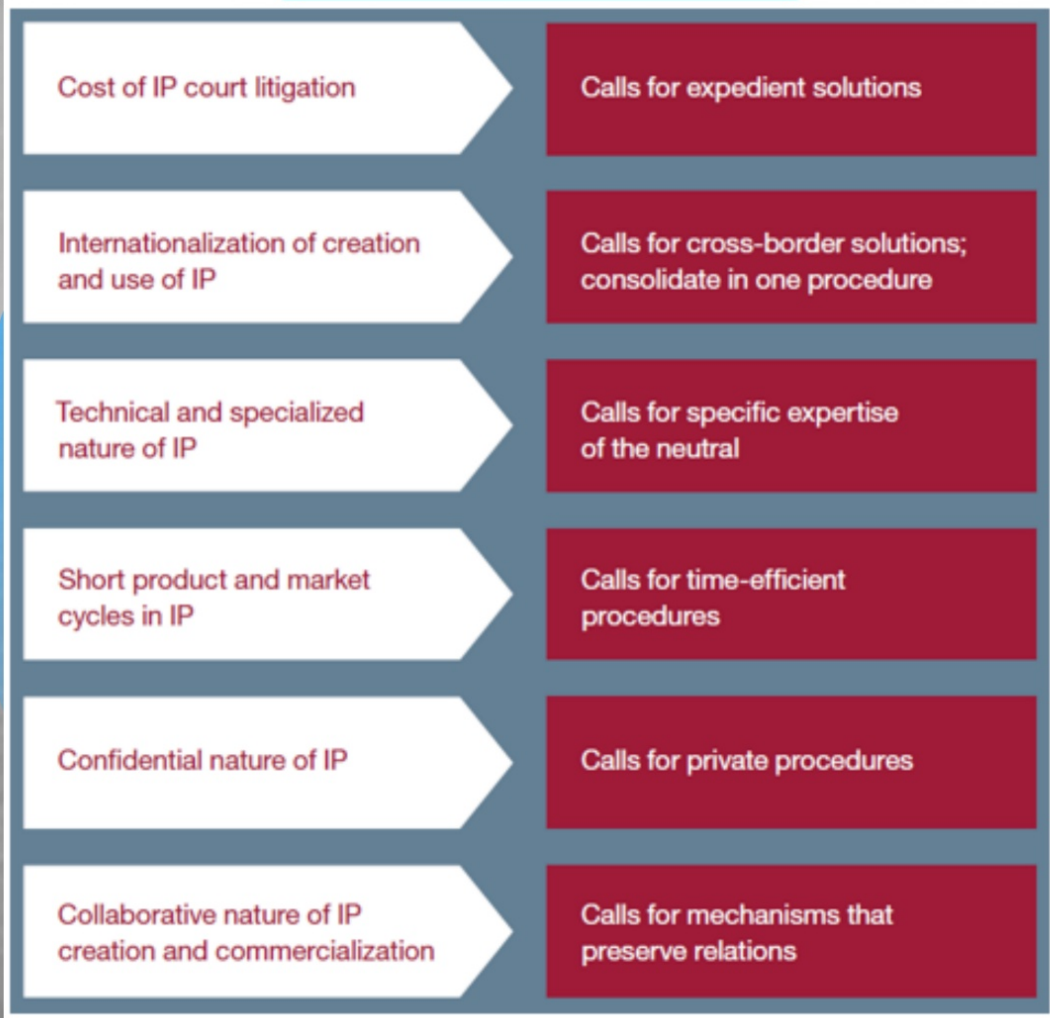
Mediation

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



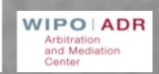
Photo by Cytton on Unsplash

Why Alternate Dispute Resolution (ADR)?



Mediation

Arbitration



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 rules out court options

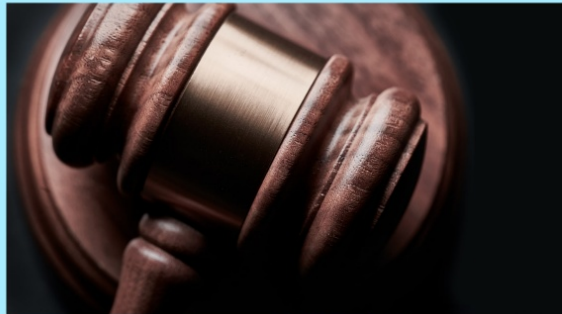
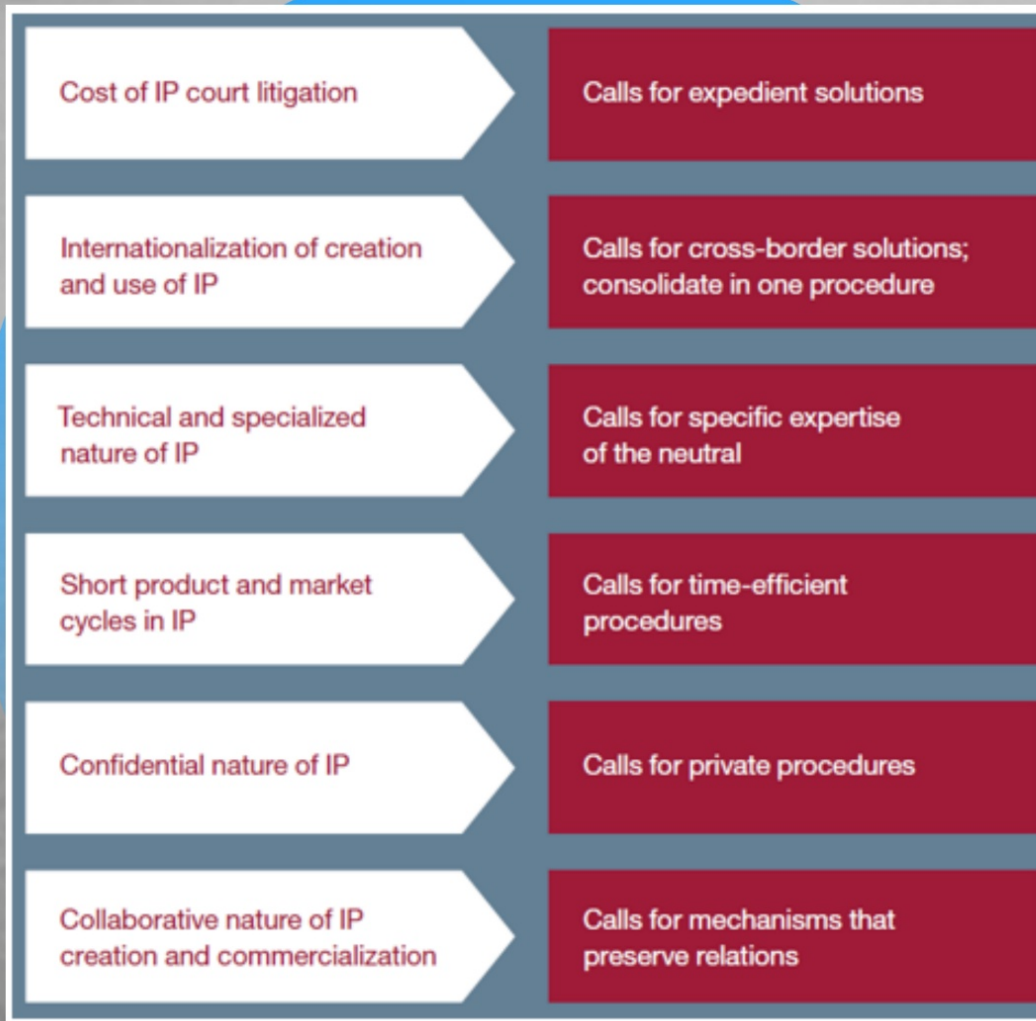


Photo by Bill Oxford on Unsplash

Why Alternate Dispute Resolution (ADR)?



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Mediation

Arbitration

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Advantages of Mediation

... there are so many!

- Affordable
- Confidential
- Without Prejudice

Efficient

Flexible

Effective

Efficient

- Much faster than litigation
- Over 90% of settled cases only require 1 day [anecdotal evidence]





Advantages of Mediation

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Efficient

Flexible

Effective

Flexible

- Control over outcome
- Solutions only constrained by parties' imagination
- Apology
- Possibility of payment in kind
- Allows future cooperation
- Option to involve third parties



Photo by Diana Parkhouse on Unsplash

Advantages of Mediation

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Effective

- High settlement rate
 - WIPO statistics show a settlement rate of 70% for WIPO Mediation
- High satisfaction rates

WIPO case areas and settlement rates

Commercial

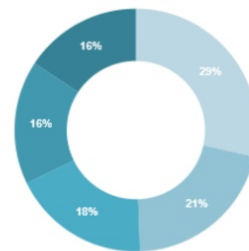
Design
Distribution
Energy
Franchising
Marketing
Sports

Copyright

Art
Broadcasting
Collective Management
Entertainment
Film and Media
Infringements
TV Formats

ICT

Mobile Apps
Outsourcing
Systems Integration
Software Development
Software Licensing
Telecommunications

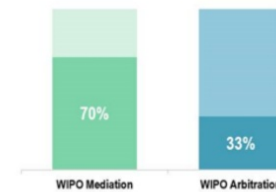


Patents

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

Trademarks

Coexistence
Infringements
Licenses
Oppositions
Revocations



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27 April 2021



Mediation Cases

Let's dig deeper...



Mediation 1



Mediation 2

Mediation 1

- Dispute between 3 founders of a fintech startup
- Hybrid in-person and online mediation
- One of the founders flew into Singapore for the mediation whereas another participated from Latin America where there was a -14hr time difference
- Loose collaboration of a start up

1. Issues

2. Process

3. Settlement

Issues

- copyright infringement – for using and reproducing documents that the other members of the project team had worked on in the course of their collaboration, without their consent
- breach of confidence – when Party 1 revealed confidential documents to third parties
- breach of fiduciary duties – by using the project information for its own benefit
- Cross claims in other jurisdictions

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Process

- Facilitative style of mediation
- Grave mistrust between the parties and a mediator was needed to bridge the trust gap between the parties
- The mediators continued to engage the parties and their respective interests, focusing on the benefits of a negotiated settlement (instead of trial) and the ability to get an in-principle agreement with a view to settle the cross claims in other jurisdictions

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3. Settlement

Settlement

A settlement agreement was entered into after 12 hours of mediation

The terms of the settlement were quite comprehensive and they included a

- monetary payment,
- transfer of ownership of property,
- in-principle understanding regarding the settlement of claims in other jurisdictions,
- cross undertakings,
- an agreement to keep the settlement agreement confidential
- consequential terms to resolve the High Court Suit.

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Mediation Cases

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Mediation 1



Mediation 2

Mediation 2

- Opposition proceedings at IPOS
- Parties agreed to avail the Mediation Promotion Scheme and mediate the dispute before the WIPO Arbitration and Mediation Center
- Dispute between 2 family owned businesses that had been doing business for many years
- The Applicant was from Singapore and the Opponent was a foreign entity
- Mediation conducted online through zoom as parties were in different territories

1. Issues

2. Process

Issues

- Trademark application in Singapore and in many other territories throughout the world
- Each of those marks were opposed
- Breakdown in relationship due to differences arising from an earlier agreement
- Future relationship of the parties

Mediation 2

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1. Issues

2. Process

Process

- Facilitative mediation
- Mediation allowed the parties to speak directly to each other to understand each other's interests and concerns
- Long history with deep emotions
- Parties were able to explore global settlement options to include all the other applications around the world
- Mediation was adjourned with a settlement offer on the table for the counter-party to consider

Mediation 2

- Opposition proceedings at IPOS
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1. Issues

2. Process



Mediation Cases

Let's dig deeper...

Mediation 1

Mediation 2

WIPO MEDIATION x DISPUTES

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Intellectual Property
27 April 2021



Questions?

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Intellectual Property
27 April 2021

WIPO-IPOS World IP Day Webinar

Resolving IP & Technology Disputes
Through WIPO Mediation

The IP Office Experience

27 April 2021

See Tho Sok Yee
Principal Legal Counsel / Principal Assistant Registrar



- 1 Collaboration with WIPO
- 2 Enhanced Mediation Promotion Scheme (EMPS)
- 3 Legal Developments in Singapore
- 4 Success Stories
- 5 Parties' Experience

1. IPOS COLLABORATION ON ADR WITH WORLD INTELLECTUAL PROPERTY ORGANIZATION



- ▶ **WIPO Arbitration and Mediation Center (WIPO Center)**
in Singapore since 2010
 - **Only office** outside Geneva
 - **Neutrals** from Singapore and international community
 - **Specialist** arbitrators, mediators, experts knowledgeable in IP fields
 - **Over 20** Singapore-based mediators included

- ▶ **WIPO-IPOS MOU**
since 28 September 2011
 - **1st** such WIPO collaboration with an IP office
 - Established **joint dispute resolution procedure**
 - Joint **training** events and **promotion**

- ▶ **WIPO Mediation Option for Trade Marks Disputes at IPOS**
 - **Opposition, invalidation, revocation**
 - **Administration** via WIPO Center
 - **Customised** schedule of fees

- ▶ **WIPO Limited Time Offers for Disputes at IPOS**
 - 12 June to 31 August 2020: **Free mediation**
 - 1 Jan to 30 June 2021: Admin fee waived; **S\$5000 cap** on mediator fees

2. 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%)**



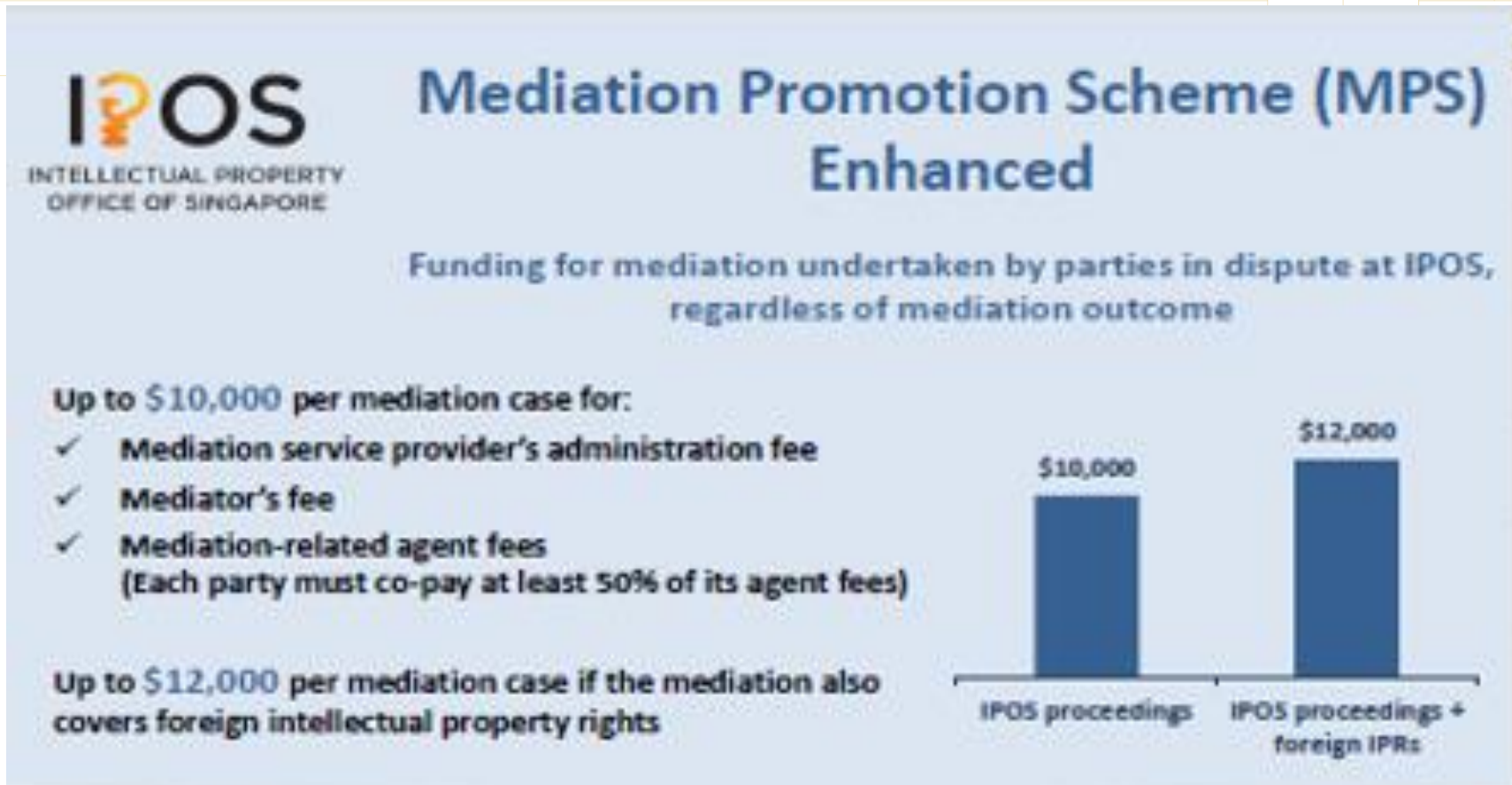
Parties must have existing dispute at IPOS

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



2. ENHANCED MEDIATION PROMOTION SCHEME (EMPS)



IPOS
INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE


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



Category	Amount
IPOS proceedings	\$10,000
IPOS proceedings + foreign IPRs	\$12,000

2. ENHANCED MEDIATION PROMOTION SCHEME (EMPS)



- 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>

3. LEGAL DEVELOPMENTS IN SINGAPORE



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

- Signed in Singapore in August 2019
- Entered into force on 12 September 2020
- Eases enforcement of international commercial mediation settlement agreements
- 53 signatories, 6 parties

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

4. 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

4. SUCCESS STORIES



2017 Trade Marks Dispute (International versus local company)



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



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



WIPO admin fee and mediator's costs fully subsidised under Mediation Promotion Scheme = **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

4. SUCCESS STORIES (EMPS)



2019 Both foreign parties (USA and Thailand)



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



Resolved dispute before IPOS *and* also achieved global resolution in 6 countries (Singapore, Malaysia, Indonesia, Thailand, Vietnam and the Philippines)



WIPO admin fee and mediator's costs: S\$ 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

“The success of the mediation is very significant to us. Apart from settling existing disputes, the settlement ensured the protection of our company's brand image and the rapid development of our business in Southeast Asia.”

“I am very glad that mediation in Singapore has helped us resolve the existing disputes and achieved a win-win outcome for all parties.”

Party Feedback

4. SUCCESS STORIES (EMPS)

2020 Both Singaporean parties



Yoda v Yuda

- Family dispute, parties have shared history
- Shareholder dispute
- Trade mark dispute

In the nick of time

- Trade mark case was due to be heard
- At Pre-Hearing Review, Registrar suggested to parties to attempt to mediate dispute using WIPO's free mediation offer

Mediation completed, with settlement agreement signed, in **1 day**

- Difficulty: Parties not on speaking terms
- Mediator was ... “Friendly ... helped pave the way for parties to open up to each other” “At the same time, he was firm and professional, ... with great control”
- Mediation was in person, at mediator's office

WIPO admin fee and mediator's costs: Complimentary

EMPS funding

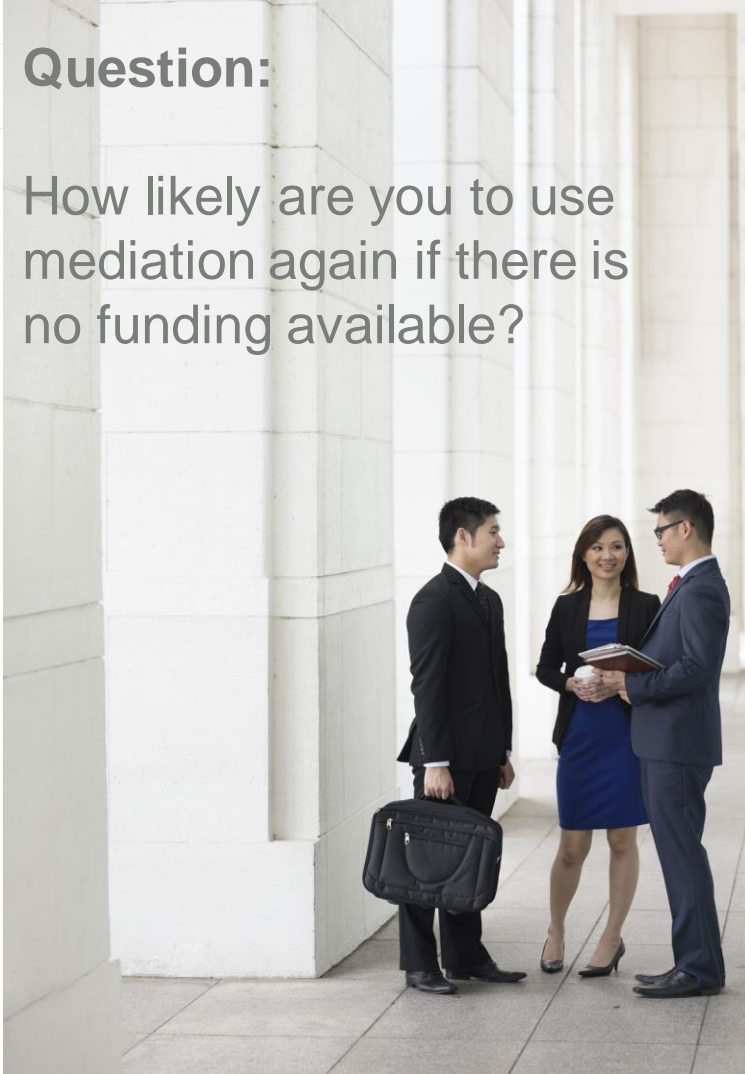
- Opponents' mediation-related lawyer fees and disbursements: S\$5000
- Applicants' mediation-related lawyer fees and disbursements: S\$2675

5. PARTIES' EXPERIENCE

Question:

How likely are you to use mediation again if there is no funding available?

- Maybe
- Quite likely but depends on the circumstances
- Likely
- We will still consider using mediation for the purpose of saving costs and avoiding litigation
- Not likely
- Likely
- Depends on the case
- Very likely
- Very likely



5. PARTIES' EXPERIENCE



Question:

What other reasons will encourage you to consider mediation for future disputes?



- Resolution of cross border disputes
- Cost of litigation
- To save costs and avoid litigation
- If costs of mediation are lowered significantly
- Less stressful and quicker. Parties have the opportunity to understand each other's case and negotiate in a more business-like manner with less animosity.
- More economical. Less hassle than a court case.
- An opportunity to discuss candidly and openly the issues and even non-issues between the parties and also their legal representatives, and also with a mediator who is very experienced, methodical and wise in the field of IP law and rights in an amicable setting in order to sincerely determine if issues could be ironed out and resolved.

5. PARTIES' EXPERIENCE

Question:

Other comments and thoughts?

- Often, disputes arise out of misunderstandings. Parties are less likely to settle unless through the assistance of an impartial third party. Mediation has its role and purpose in resolving disputes.
- The mediator was excellent, knowledgeable, experienced, kind, excellent facilitator and calmly dealt with matters.

5. PARTIES' EXPERIENCE

Reference



- Collection of case studies on each mediation case
- Useful resource for businesses to see how other businesses used mediation for their IP disputes
- [https://www.ipos.gov.sg/docs/default-source/protecting-your-ideas/hearings-mediation/mediation-at-ipos-\(emps\).pdf](https://www.ipos.gov.sg/docs/default-source/protecting-your-ideas/hearings-mediation/mediation-at-ipos-(emps).pdf)

MINDSET CHANGE

