



# Arbitration and Mediation in Intellectual Property Disputes

**Ono Academic Law School (ONO)  
Geneva  
November 16, 2015**

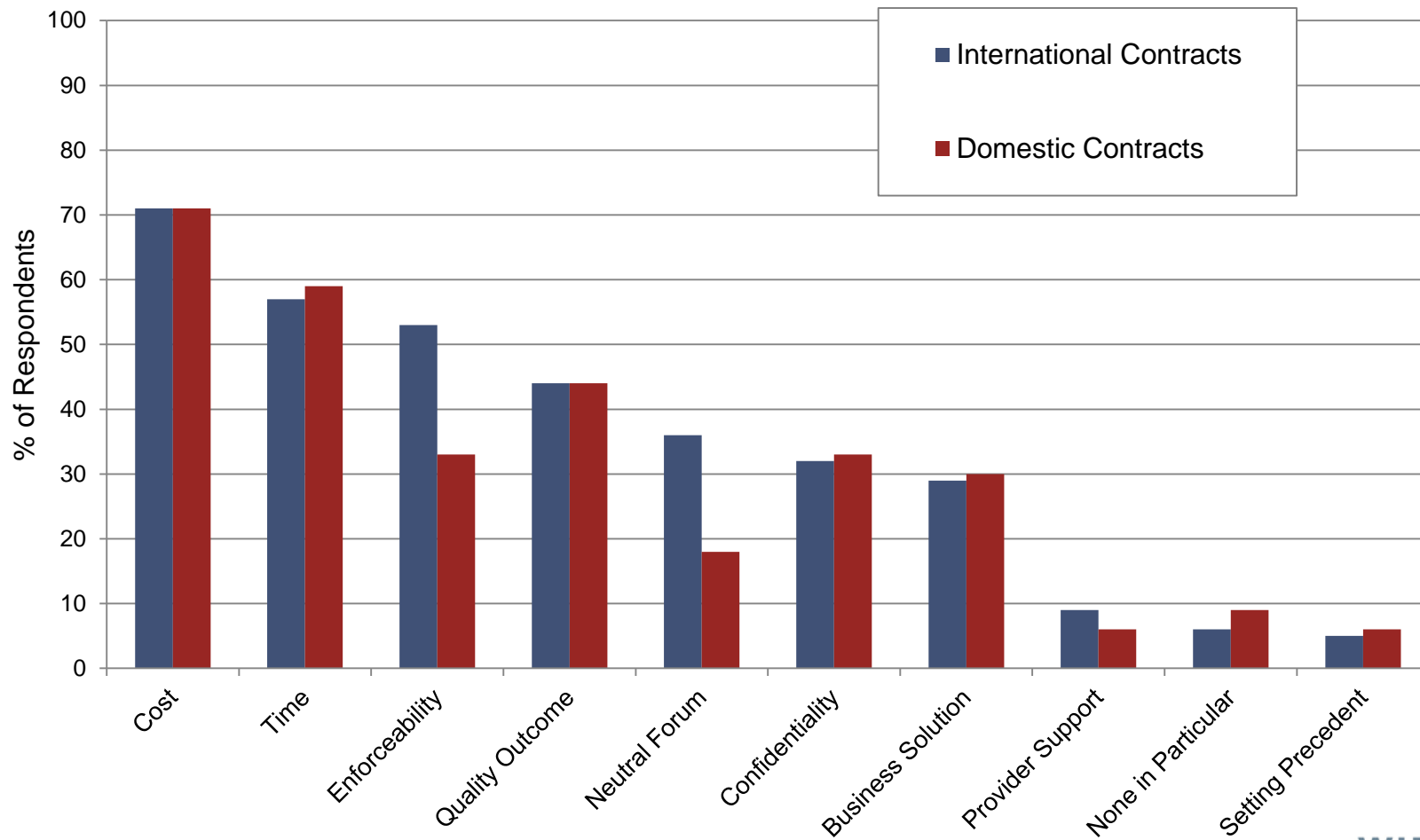
Leandro Toscano  
WIPO Arbitration and Mediation Center

# Patent Litigation

Country	Characteristic of Legal System	Average Length	Average Cost
France	<ul style="list-style-type: none"> <li>- Civil Law</li> <li>- Unified Litigation</li> <li>- No specialized courts</li> </ul>	First Instance: 18-24 months Appeal: 18-24 months	€80,000-150,000 (1 <sup>st</sup> Inst.)
Germany	<ul style="list-style-type: none"> <li>- Civil Law</li> <li>- Bifurcated Litigation</li> <li>- Specialized court for invalidity</li> </ul>	First Instance: 12 months Appeal: 15-18 months	€50,000 (1 <sup>st</sup> Inst.) €70,000 (App.)
Italy	<ul style="list-style-type: none"> <li>- Civil Law</li> <li>- Unified Litigation</li> <li>- Specialized courts</li> </ul>	First Instance: few months – 24 months Appeal: 18-24 months	€50,000-150,000 (1 <sup>st</sup> Inst.) €30,000-70,000 (App.)
Spain	<ul style="list-style-type: none"> <li>- Civil Law</li> <li>- Unified Litigation</li> <li>- Commercial Courts</li> </ul>	First Instance: 12 months Appeal: 12-18 months	€100,000 (1 <sup>st</sup> Inst.) €50,000 (2 <sup>nd</sup> Inst.)
UK	<ul style="list-style-type: none"> <li>- Common Law</li> <li>- Unified Litigation</li> <li>- Specialized courts</li> <li>- Mediation promoted</li> </ul>	First Instance: 12 months Court of Appeal: 12 months Supreme Court: 24 months	€750,000-1,500,000 (1 <sup>st</sup> Inst.) €150,000-1,500,000 (App.) €150,000-1,500,000 (Supreme Court)
China	<ul style="list-style-type: none"> <li>- Civil Law</li> <li>- Bifurcated Litigation</li> <li>- Specialized courts</li> </ul>	First Instance: 6 months Appeal: 3 months	USD150,000 (1 <sup>st</sup> Inst.) USD50,000 (App.)
Japan	<ul style="list-style-type: none"> <li>- Civil Law</li> <li>- Bifurcated Litigation</li> <li>- Specialized courts</li> </ul>	First Instance: 14 months Appeal: 9 months	USD300,000 (1 <sup>st</sup> Inst.) USD100,000 (App.)
USA	<ul style="list-style-type: none"> <li>- Common Law</li> <li>- Unified Litigation</li> <li>- Specialized court of appeals (CAFC)</li> <li>- Jury trial available</li> <li>- Mediation promoted</li> </ul>	First Instance: up to 24 months Appeal: 12 + months	Up to USD4,000,000 (1 <sup>st</sup> Inst.) USD150,000-250,000 (App.)

Source: This chart is based on figures provided in Patent Litigation - Jurisdictional Comparisons, Thierry Calame, Massimo Sterpi (ed.), The European Lawyer Ltd, London 2006.

# Top Ten Priorities in Choice of IP Dispute Resolution Contract Clause (WIPO Survey)



# WIPO Arbitration and Mediation Center

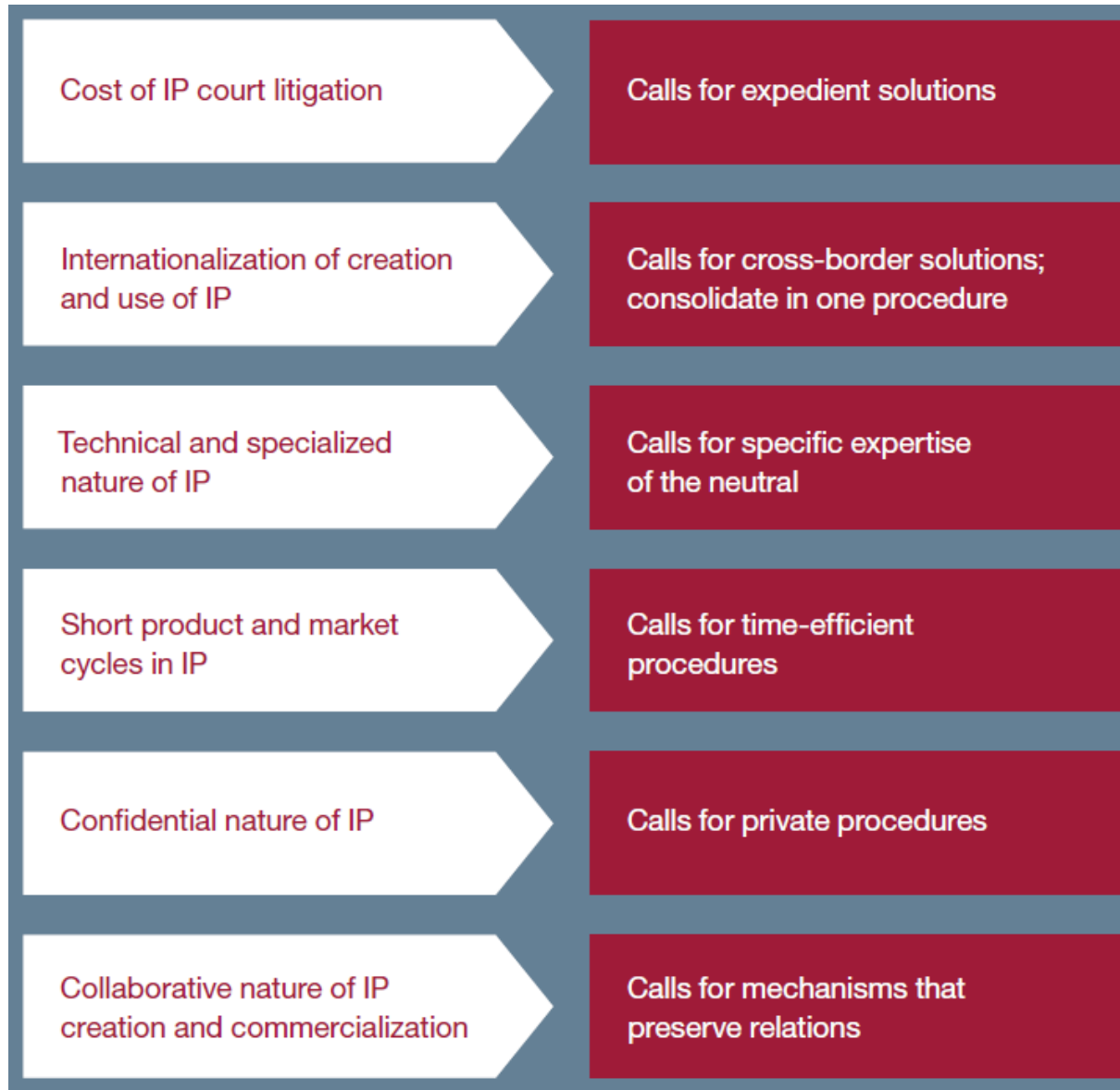
- Facilitates the resolution of commercial disputes between private parties involving IP and technology, through procedures other than court litigation (alternative dispute resolution: ADR)
  - Offices in Geneva and Singapore
- ADR of IP disputes benefits from a specialized ADR provider
  - WIPO mediators, arbitrators and experts experienced in IP and technology - able to deliver informed results efficiently
- Competitive WIPO fee structure
- International neutrality
- Services include mediation, arbitration, expedited arbitration, expert determination, and domain name dispute resolution

# WIPO ADR

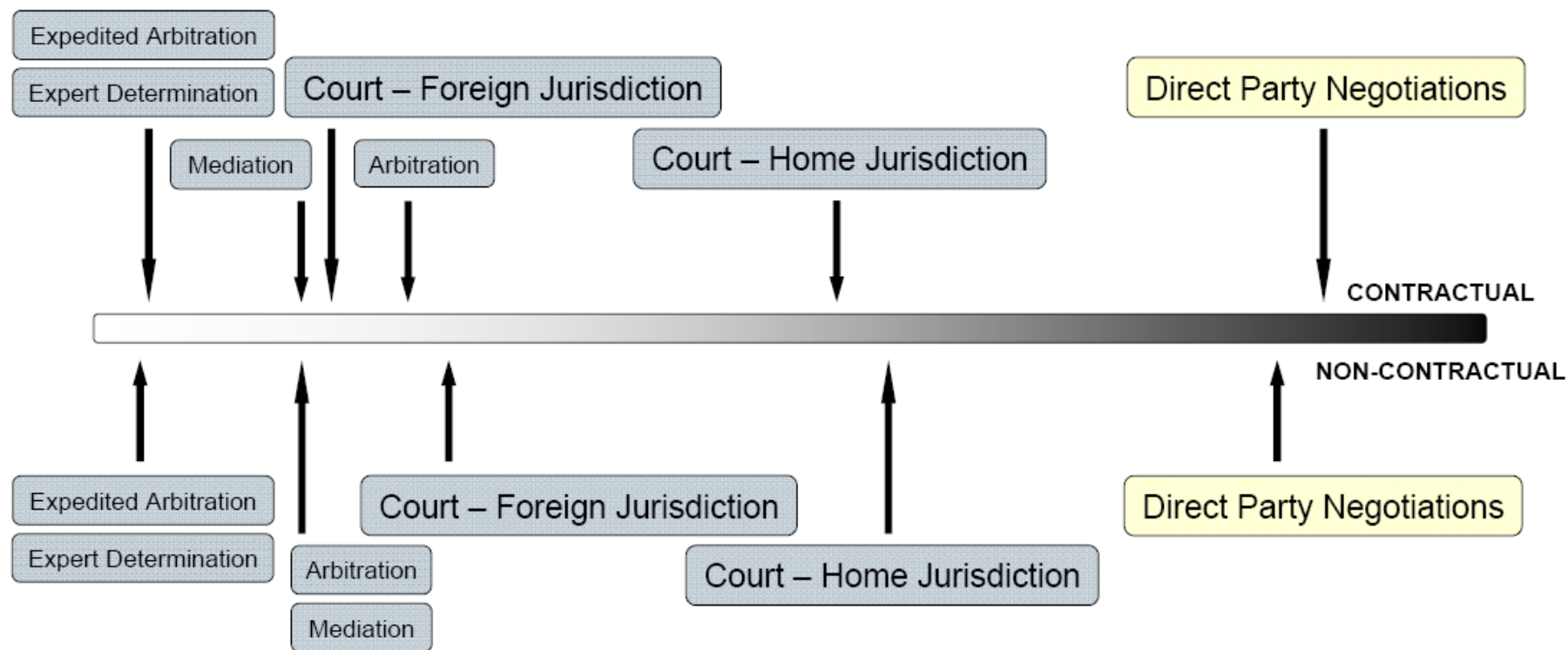
## Mediation, Arbitration, Expert Determination

- **Mediation:** informal consensual process in which a neutral intermediary, the mediator, assists the parties in reaching a settlement of their dispute, based on the parties' respective interests. The mediator cannot impose a decision. The settlement agreement has force of contract. Mediation leaves open available court or agreed arbitration options.
- **Arbitration:** consensual procedure in which the parties submit their dispute to one or more chosen arbitrators, for a binding and final decision (award) based on the parties' rights and obligations and enforceable internationally. Arbitration normally forecloses court options.
- **Expert Determination:** consensual procedure in which the parties submit a specific matter (e.g., technical question) to one or more experts who make a determination on the matter, which can be binding unless the parties have agreed otherwise.

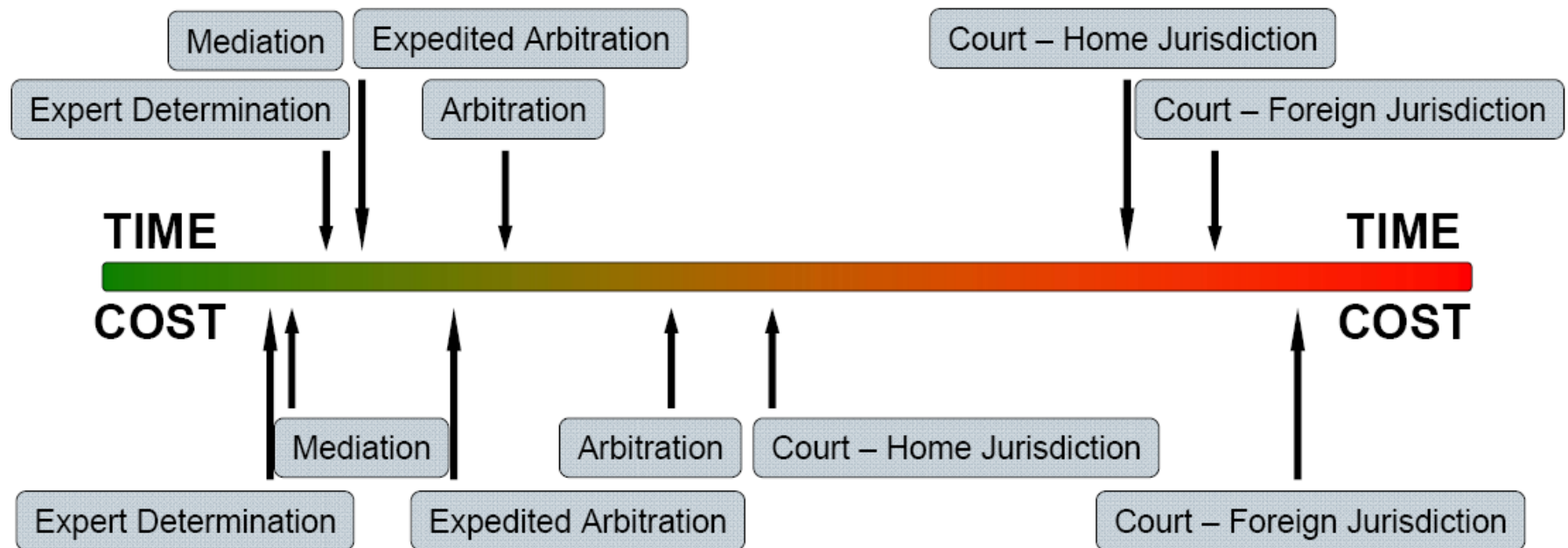
# Why Consider IP ADR?



# How Are Technology Disputes Resolved?



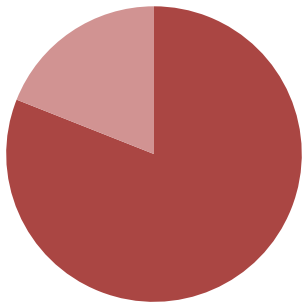
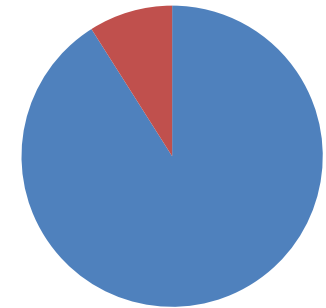
# Relative Time and Cost of Technology Dispute Resolution





# Scope of Agreements: Parties/Technology

- 91% of respondents conclude agreements with parties from other jurisdictions.

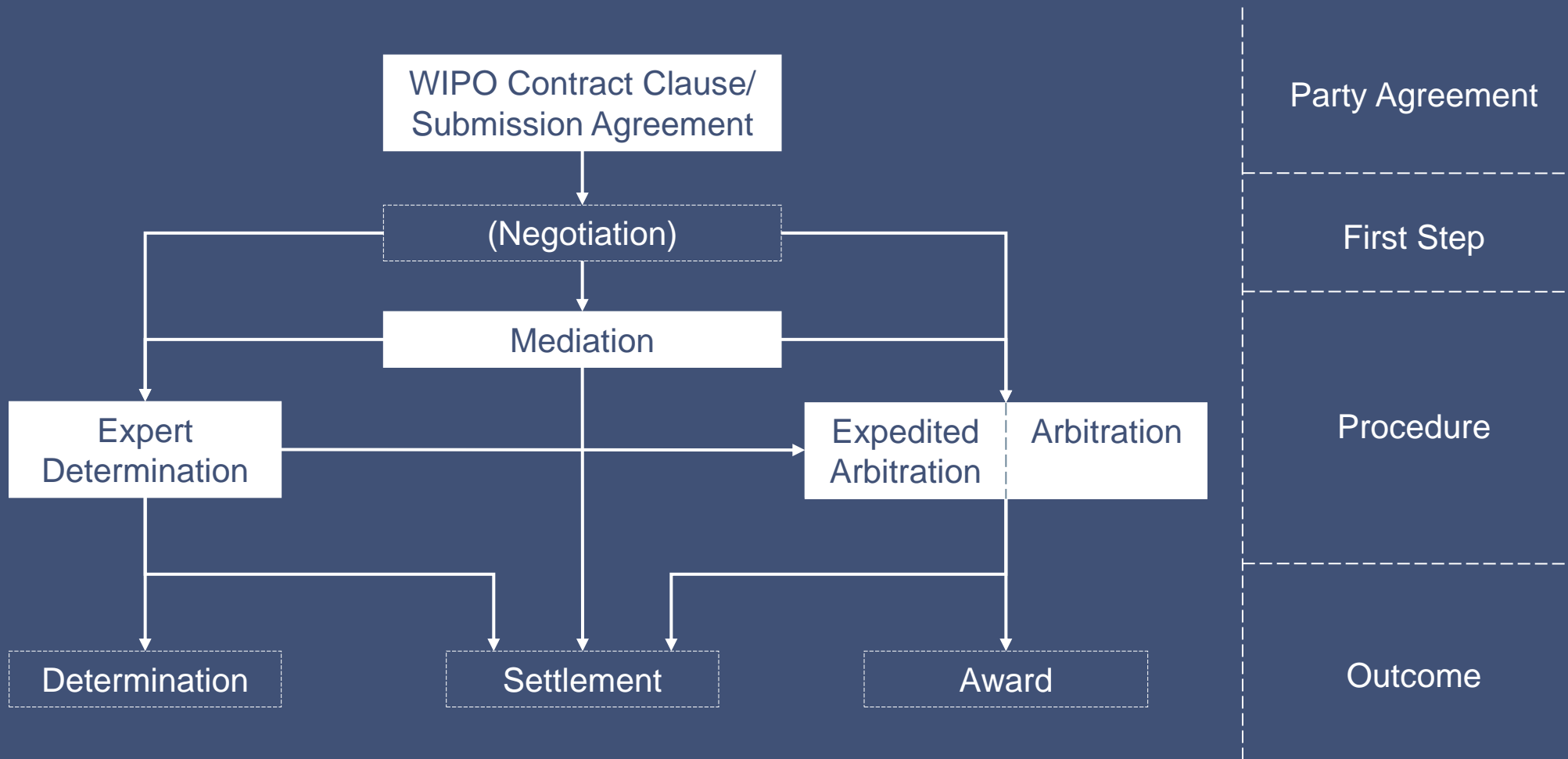


- 80% of respondents conclude agreements relating to technology patented in multiple jurisdictions.

# Routes to WIPO ADR

- ADR contract clause electing WIPO Rules
  - WIPO Mediation
  - WIPO Arbitration
  - WIPO Expedited Arbitration
  - WIPO Expert Determination
- Model clauses: *[www.wipo.int/amc/en/clauses/index.html](http://www.wipo.int/amc/en/clauses/index.html)*
  - Parties can shape the process via the clause (e.g., location, language, law)
- ADR submission agreement electing WIPO Rules, e.g., in existing non-contractual disputes
- WIPO Clause Generator
- Court referrals

# WIPO ADR Options



# WIPO Model Clause Example: 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."

## 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.

##### Core Elements ?

Place of Mediation

Language of the Mediation

Duration of the Mediation Proceedings

##### Additional Elements ?

Qualifications of the Mediator

Conduct of the Mediation

The place of mediation shall be .

Clear

Next

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].

#### 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

### Step 4 – Download or copy the final result

Download

Copy to clipboard

Print clause

# WIPO Center Case Role

- Administer cases
  - Under WIPO Rules, or under special procedures
  - Active management: containing time and costs
    - WIPO ECAF (optional online case management)
  
- Facilitate selection and appointment of mediators, arbitrators, experts
  - WIPO list of 1,500+ neutrals
    - From numerous countries in all regions
    - Specialized in different areas of IP and IT

# WIPO Electronic Case Facility (ECAF)

- Simple; secure; instant; location-independent; optional

## ECAF HOME

[Help](#)  
[Arbitration](#)  
[Mediation](#)  
[Expert Determination](#)  
[Logout](#)

## WIPO Electronic Case Facility (ECAF)

Case: **WIPOA20020**

Licensing v. AB Technics Inc.

Case Overview

Contact Information

Case File

Message Board

Neutral Message Board

### Case File

Only documents to be recorded as part of the casefile should be submitted in the Case File.  
 Only first-level submissions will trigger an email notification to users.  
 Display issues from variations in browsers may be resolved by adjusting the Text Size in the browser menu.

 [Search Case](#)

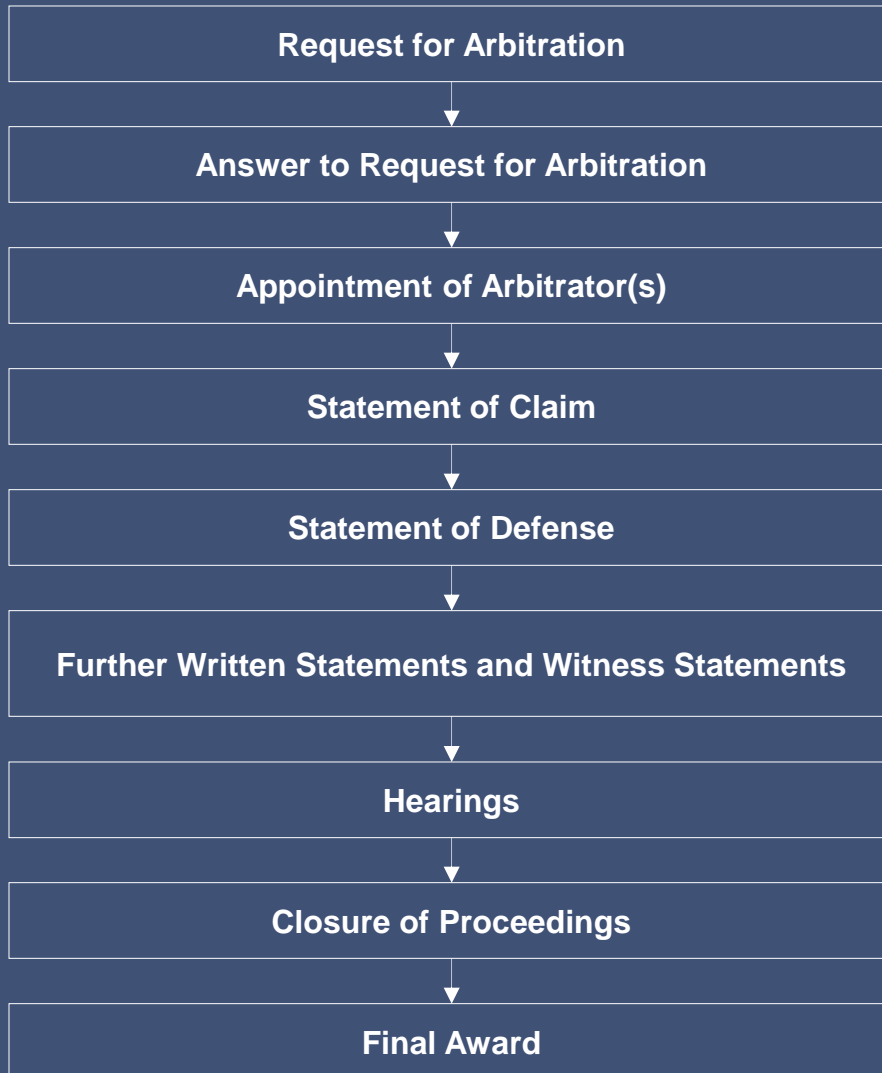
 [Submit New File](#)

[Expand](#) | [Collapse](#)

To sort, you may click on the column headers

ITEM NO	SUBMITTED BY	DATE	SUBJECT	ANNEX
3	WIPO AMC Case Manager	04/06/09 14:44:26	<a href="#">Main Case File 3</a>	1 <a href="#">[ Add ]</a>
3.1		04/06/09 14:45:21	<a href="#">Annex 1</a>	<a href="#">[ Add ]</a>
2	WIPO AMC Case Manager	22/05/09 16:11:02	<a href="#">Main Case File 2</a>	2 <a href="#">[ Add ]</a>
2.1		22/05/09 16:11:22	<a href="#">Annex 1</a>	3 <a href="#">[ Add ]</a>
2.1.1		02/06/09 11:03:17	<a href="#">Annex 1</a>	
2.1.2		21/09/09 13:05:27	<a href="#">Annex 2</a>	

## WIPO Arbitration



## WIPO Expedited Arbitration



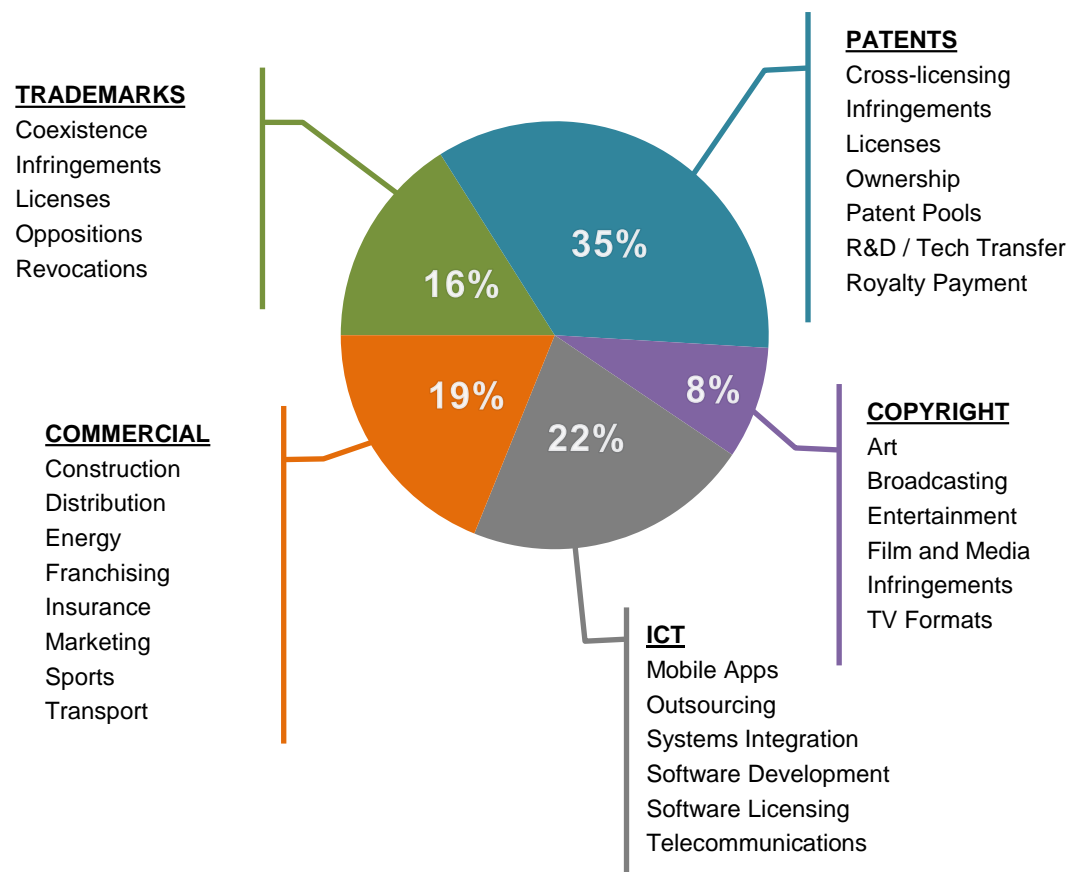
- One exchange of pleadings
- Shorter time limits
- Sole arbitrator
- Shorter hearings
- Fixed fees



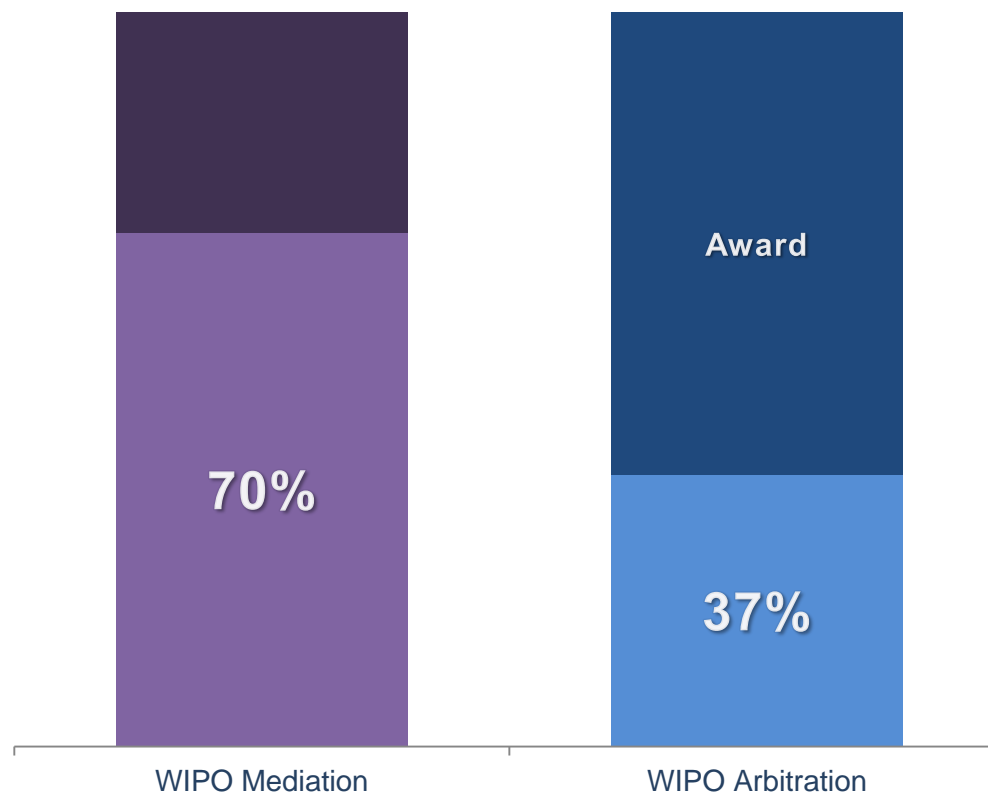
# WIPO Mediation, Arbitration and Expert Determination Cases

- IP/IT disputes and commercial disputes
  - Contractual: patent licenses, software/ICT, R&D and technology transfer agreements, patent pools, distribution agreements, joint ventures, copyright collecting societies, trademark coexistence agreements, settlement agreements
  - Non-contractual: infringement of IP rights
- Domestic and international disputes (25/75%)
- Amounts in dispute from USD 50,000 to USD 1 billion

# Dispute Areas in WIPO Mediation and Arbitration Cases



# Settlement Rates in WIPO ADR Cases



## Mediation, (Expedited) Arbitration, Expert Determination Fee Calculator


The fees referenced below are estimates, in **United States dollars**. Final amounts payable are to be decided in consultation with the Center.


Type of Procedure  



Amount in Dispute in USD



Dispute is not quantifiable or Request does not indicate any claims for a monetary amount  

WIPO PCT Filer, Hague System Filer, Madrid System Filer, WIPO Green Technology Provider or Seeker  

Calculate

Reset

Registration Fee No Registration Fee

Administration Fee USD 375

Mediator's Fee USD 300-USD 600 per hour USD 1,500-USD 3,500 per day.

### Schedule of Fees

[Mediation](#)

[Arbitration / Expedited Arbitration](#)

[Expert Determination](#)

[Emergency Relief Proceedings \(Effective from June 1, 2014\)](#)

For further information and payment details, click on the applicable schedule of fees and costs on the right hand side of the page.

# Review

- What are the main characteristics of and differences between mediation and arbitration?
- Why would you recommend using ADR for IP and technology disputes?
- For which types of IP and technology disputes is ADR more suitable?

# Further Information

- Queries and case filing:  
*arbiter.mail@wipo.int*
- Model clauses:  
*www.wipo.int/amc/en/clauses/*
- Info on procedures, neutrals and case examples:  
*www.wipo.int/amc/*

