



Resolving IP Disputes Outside the Courts Through WIPO ADR

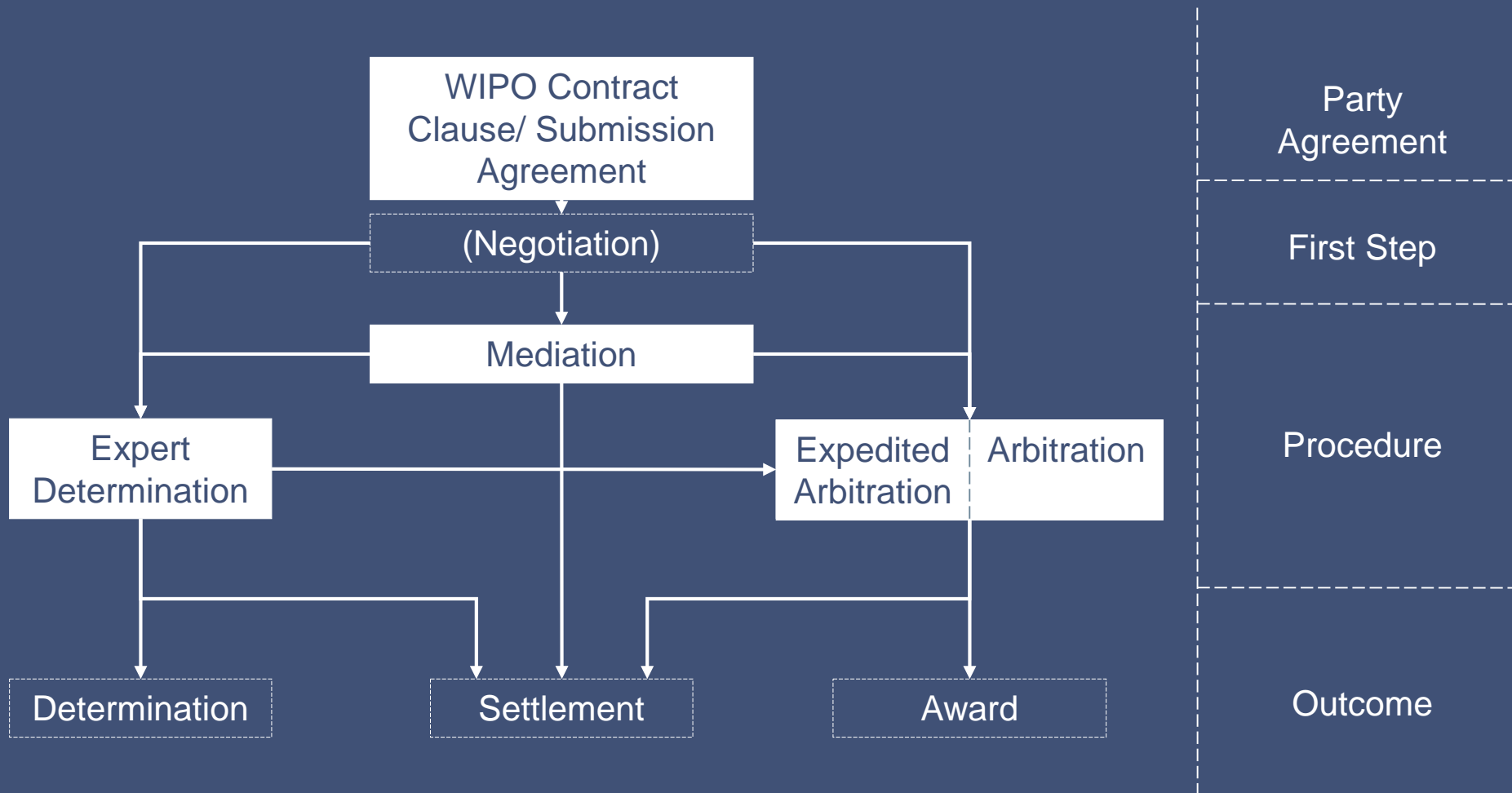
Monika Zikova

WIPO Arbitration and Mediation Center

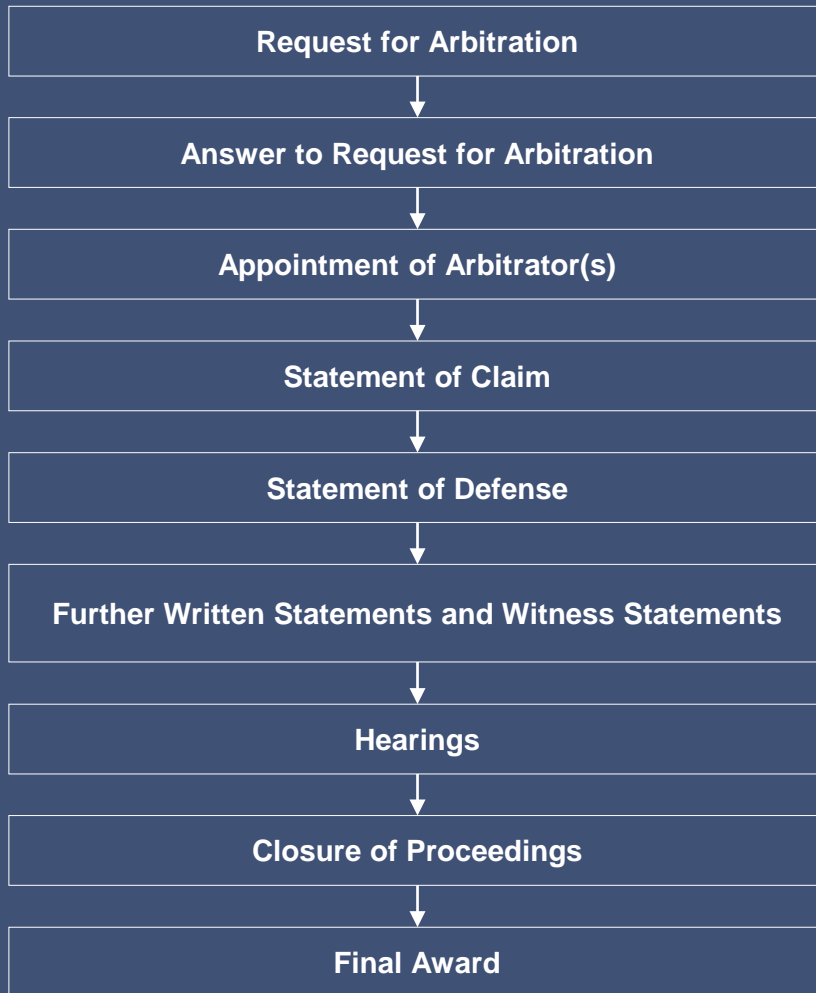
Alternative Dispute Resolution (ADR)

- Helping to resolve IP and technology disputes outside the courts
- Services include:
 - mediation
 - (expedited) arbitration
 - domain name dispute resolution
- Expertise and experience in IP and technology
- Competitive fees
- International neutrality
- Users around the world
- Since 1994

WIPO ADR Options



WIPO Arbitration



WIPO Expedited Arbitration



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

Disputes

- IP/IT disputes and commercial disputes:
 - Contractual: patent licenses, software/ICT, R&D and technology transfer agreements, patent pools, distribution agreements, joint ventures, film production, TV distribution, art-related agreements, trademark coexistence agreements, settlement agreements
 - Non-contractual: infringement of IP rights
- Domestic and international disputes (25/75%)
- Amounts in dispute from USD 15,000 to USD 1 billion

Mediation

- Informal consensual process
- Neutral intermediary, the mediator, helps the parties in reaching a settlement while respecting their interests
- The settlement agreement has force of contract
- Mediation leaves open available court or agreed arbitration options

Arbitration

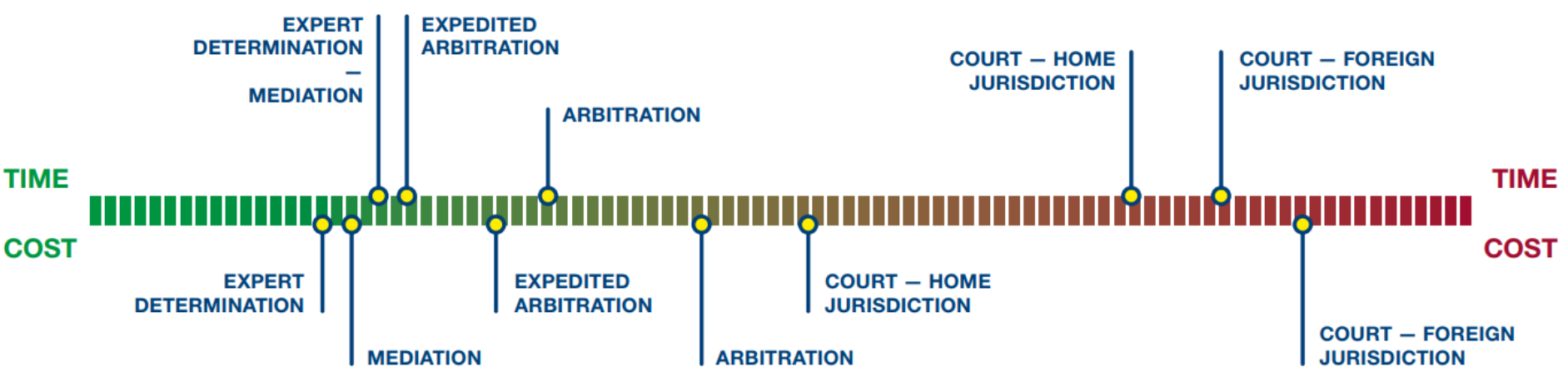
- Consensual
- Parties submit their dispute to one or more chosen arbitrators, for a binding and final decision
- Based on the parties' rights and obligations and enforceable internationally
- Arbitration normally forecloses court options

Clause example for your contract: mediation followed by expedited arbitration

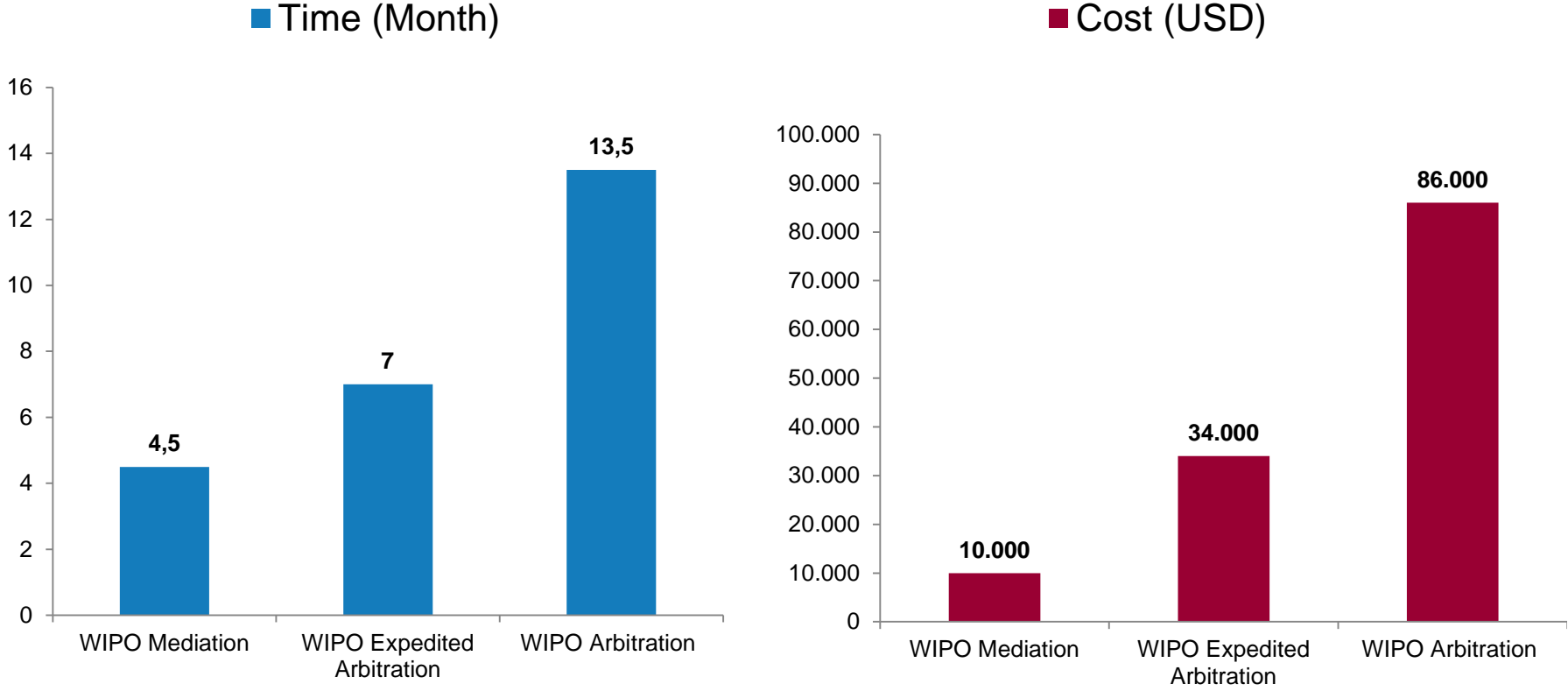
"**Any dispute**, controversy or claim arising under, out of or relating to this contract and any subsequent amendments of this contract, including, without limitation, its formation, validity, binding effect, interpretation, performance, breach or termination, as well as non-contractual claims, **shall 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."

www.wipo.int/amc/en/clauses



WIPO Cases: Typical Time and Cost



* Excluding cost of parties legal representation

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

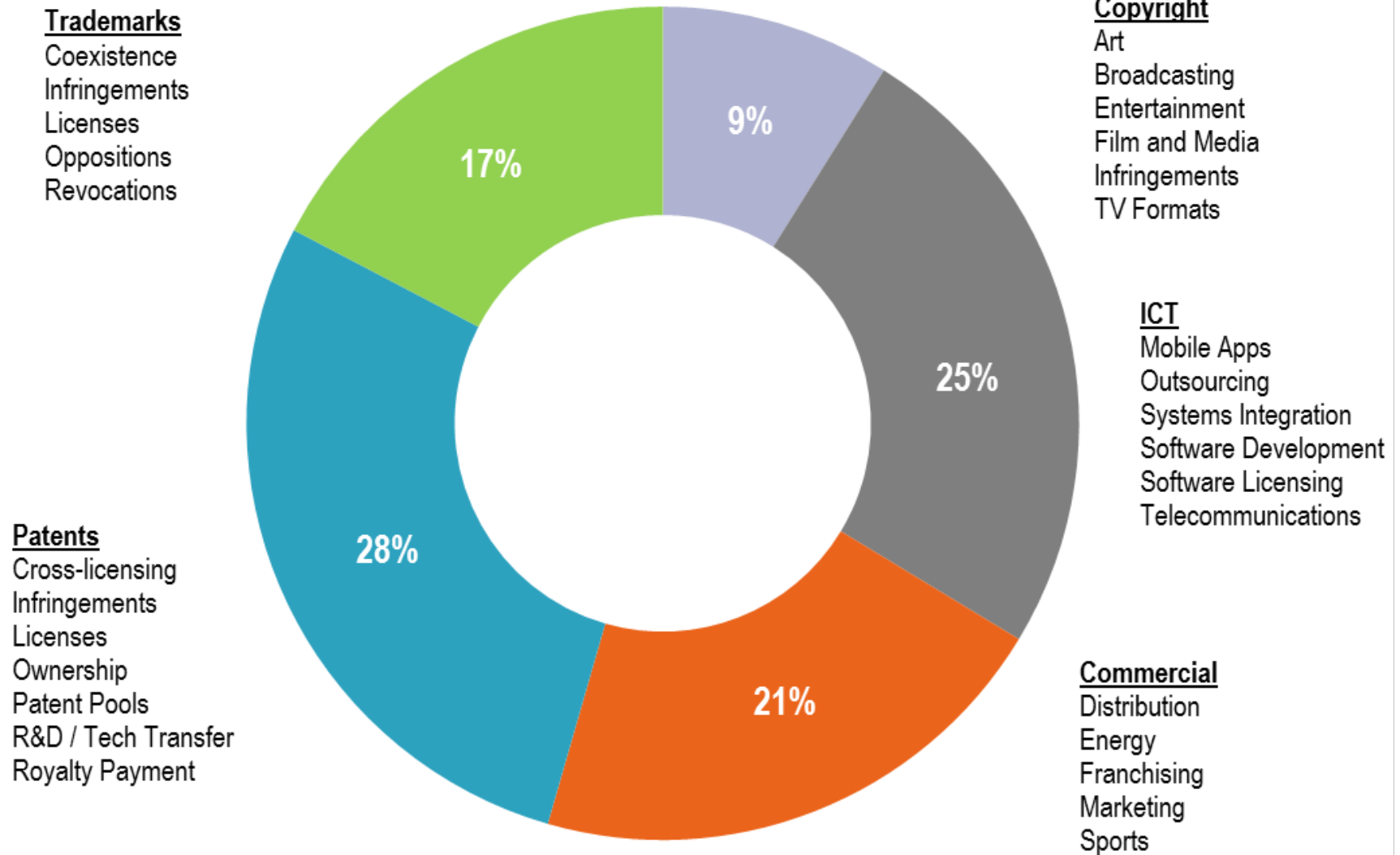
WIPO PCT Filer, Hague System Filer, Madrid System Filer, WIPO Green Technology Provider or Seeker

Registration Fee	No Registration Fee
Administration Fee	USD 375
Mediator's Fee	Amount in dispute up to USD 250,000: USD 2,500. Amount in dispute over USD 250,000: USD 300-USD 600 per hour USD 1,500-USD 3,500 per day.

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

Schedule of Fees

- [Mediation](#)
- [Arbitration / Expedited Arbitration](#)
- [Expert Determination](#)
- [Emergency Relief Proceedings \(Effective from June 1, 2014\)](#)



What can you expect from the WIPO Center?

- Administering cases
 - Under WIPO ADR Rules
 - Containing time and costs
 - WIPO ECAF (optional online case management tool)

- Assisting in selection and appointment of mediators, arbitrators, experts; negotiating fees
 - 2,000+ WIPO neutrals from all regions
 - Specialized in IP and IT

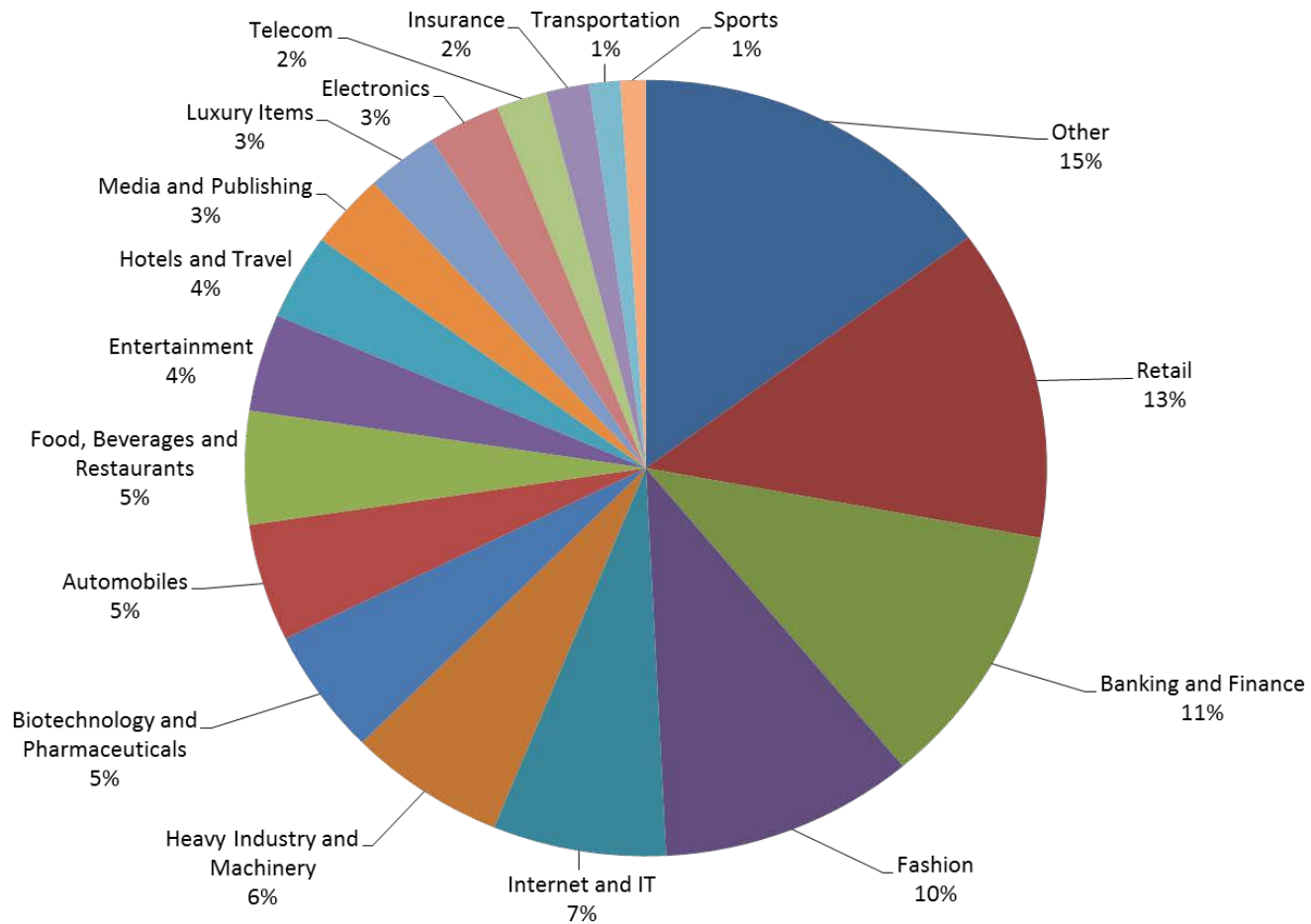
Tackling cybersquatting

Uniform Domain Name Dispute Resolution Policy (UDRP)

- Trademark identical or confusingly similar to the domain name
- Domain name registrant has no rights or legitimate interests in the domain name; and
- Domain name registered and used in bad faith

- In 1999, WIPO created an international ADR procedure
- Allows trademark owners to file “clear cut” cases of abusive domain name registration and use – cybersquatting – without going to court
- Applicable to all international domains “old” (.com, .net, etc.) and “new” (.bike, .xyz, etc.)
- Also available for 74 national domains

Cybersquatting Areas



UDRP Advantages

- Quicker and cheaper than court litigation
- Two-month average
- Fixed fees (USD 1,500)
- Predictable results
- Decision (transfer) implemented directly by registrar
- Prevents consumer confusion and brand abuse

Before you file

- WIPO Guide to the UDRP
- WIPO model pleadings (complaint and response)
- WIPO Legal Index of UDRP Decisions
- WIPO Jurisprudential Overview of Selected UDRP Questions



WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”)

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Resulting from WIPO’s care for effective remedies under a sustainable UDRP, this WIPO Jurisprudential Overview reflects, and assists the predictability of, UDRP decisions by panels appointed in WIPO cases.

► [Introduction](#)

QUESTIONS

- [1. First UDRP Element](#)
- [2. Second UDRP Element](#)
- [3. Third UDRP Element](#)
- [4. Procedural Questions](#)

1. First UDRP Element

- 1.1 What type of trademark rights are encompassed by the expression “trademark or service mark in which the complainant has rights” in UDRP paragraph 4(a)(i)?
- 1.2 Do registered trademarks automatically confer standing to file a UDRP case?
- 1.3 What does a complainant need to show to successfully assert unregistered or common law trademark rights?
- 1.4 Does a trademark owner’s affiliate or licensee have standing to file a UDRP complaint?

WIPO UDRP Toolkit

- [UDRP](#)
- [UDRP Rules](#)
- [WIPO Supplemental Rules](#)
- [WIPO Jurisprudential Overview 3.0](#)
[PDF](#)
- [Legal Index of WIPO UDRP Panel Decisions](#)
- [Search WIPO Cases and WIPO Panel Decisions](#)
- [WIPO Model Complaint](#)
- [WIPO Model Response](#)
- [Schedule of Fees](#)

Why WIPO ADR?

- Cost of IP court litigation
→ *calls for expedient solutions*
- Internationalization of creation/use of IP
→ *calls for cross-border solutions; consolidate in one procedure*
- Technical and specialized nature of IP
→ *calls for specific expertise of the neutral*
- Short product and market cycles in IP
→ *calls for time-efficient procedures*
- Confidential nature of IP
→ *calls for private procedures*
- Collaborative nature of IP creation and commercialization
→ *calls for mechanisms that preserve relations*

- 16 years experience
- the global leader in domain name dispute resolution
 - 35,000+ cases covering 65,000+ domain names
 - Involving parties based in 113 countries
 - Multilingual case administration (21 languages)
 - Paperless filing: WIPO-initiated eUDRP

- Queries:
arbiter.mail@wipo.int
- Clauses:
www.wipo.int/amc/en/clauses/
- Rules:
<http://www.wipo.int/amc/en/rules/>
- Case examples:
www.wipo.int/amc/
- WIPO domain name dispute resolution:
www.wipo.int/amc/en/domains/

