

# Resolving Intellectual Property Disputes

## WIPO Arbitration and Mediation Center

WIPO-WASME Special Program  
May 5, 2004



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WIPO Arbitration and Mediation Center

# WIPO Arbitration and Mediation Center

- Established in 1994 as part of the International Bureau of the World Intellectual Property Organization (WIPO)
- Purpose: to promote cost-effective resolution of IP/IT disputes through arbitration, mediation, and other ADR procedures

# Limitations of Court Procedures

- Multiple proceedings for each jurisdiction
- Different court systems and legal cultures
- Enforcement difficulties
- Technical nature of disputes / Judges

# Arbitration and Mediation (1)

- Party control / autonomy
- Flexibility
- Expertise
  - Party selection of neutrals; tailored appointment
- Neutral
  - arbitrator / mediator, language, law, venue
- Confidential
  - existence, disclosures, result

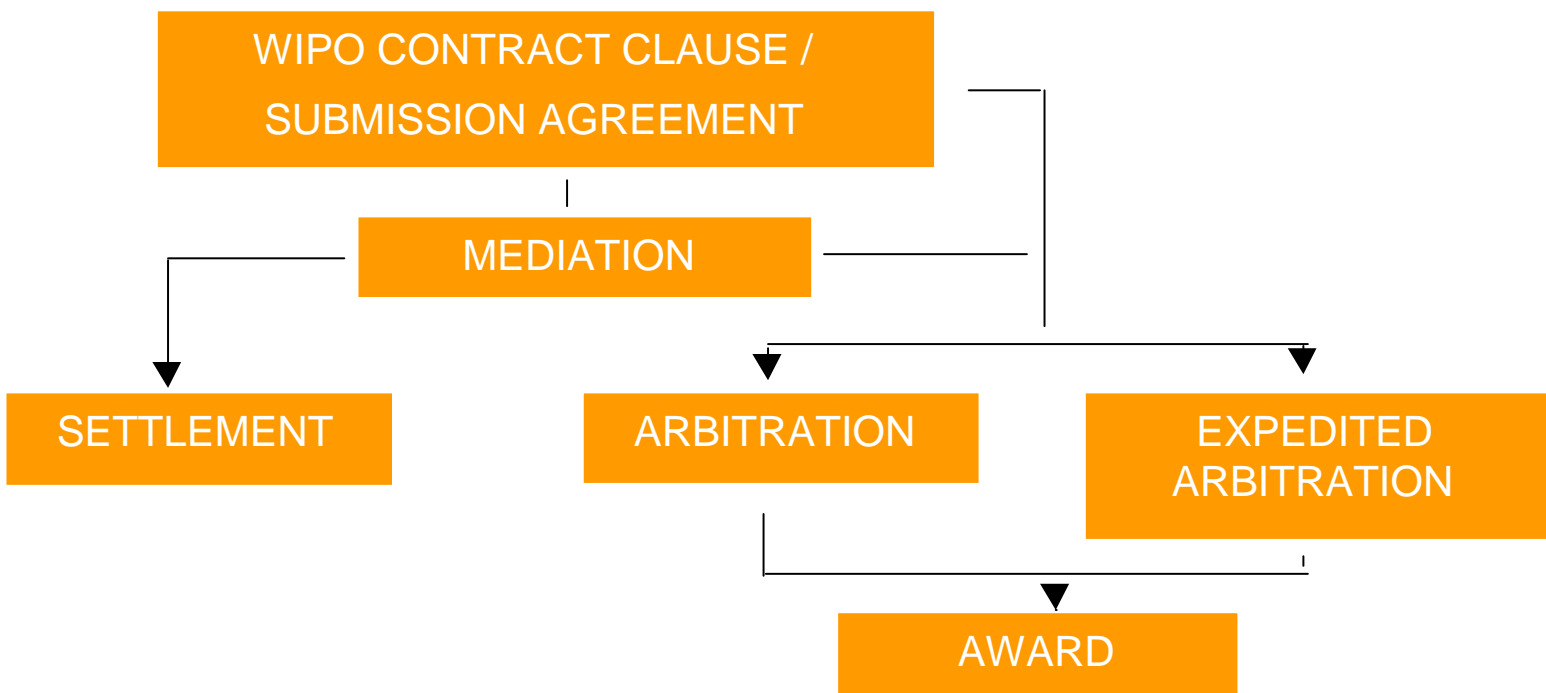
# Arbitration and Mediation (2)

- Finality / Enforceability of Awards
  - Arbitration: New York Convention
    - ▶ with limited exceptions, “automatic” enforcement of arbitral awards
    - ▶ more than 130 signatories
  - Mediation: Settlement enforceable under contract law
- Single Procedure
  - time & cost-effective
- Less adversarial than court litigation

# WIPO Procedures

- Mediation
- Arbitration
- Expedited Arbitration
- Mediation followed, in the absence of a settlement, by arbitration
- Domain Name Disputes

# WIPO Arbitration and Mediation Options



# Recommended WIPO Arbitration Clause

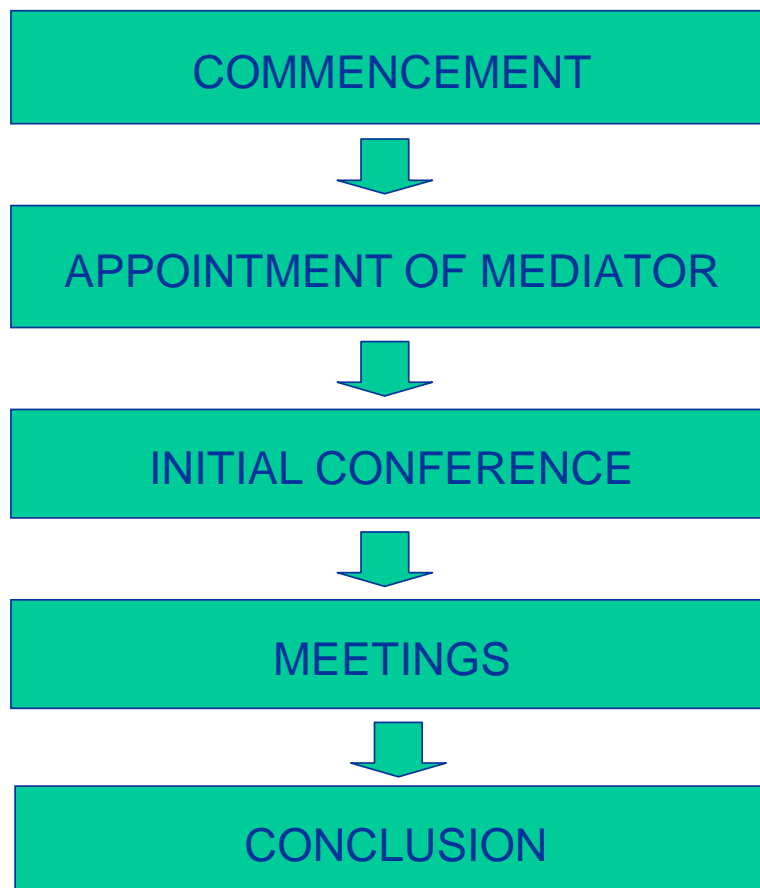
“Any dispute, (...) shall be referred to and finally determined by arbitration in accordance with the WIPO Arbitration Rules. The arbitral tribunal shall consist of [three arbitrators][a sole arbitrator]. The place of arbitration shall be [...]. The language to be used in the arbitral proceedings shall be [...]. The dispute, controversy or claim shall be decided in accordance with the law of [...]. ”



# Mediation: Minimal Risk, Significant Benefits

- Non-binding / party control
- Confidential
- Low cost
- Based on interests of the parties
  - ▶ Value creation
- Preserves relationships
- In Licensing and Technology Transfer Disputes

# Mediation Process



# WIPO Mediation Case Example

## -Patent Mediation

- R&D company holding patents disclosed patented invention to manufacturer during consulting contract.
- Contract did not transfer or license patent rights to manufacturer.
- Manufacturer started selling products which R&D company alleged included patented invention.
- R&D threatened infringement court proceedings.

# WIPO Mediation Case Example -Patent Mediation

- Negotiation patent license failed.
- Parties submitted dispute to WIPO Mediation Rules.
- WIPO Center suggested mediator.
- Mediator appointed.
- Two-day meeting.
- Agreement on royalties and future consulting contracts.

# Arbitration

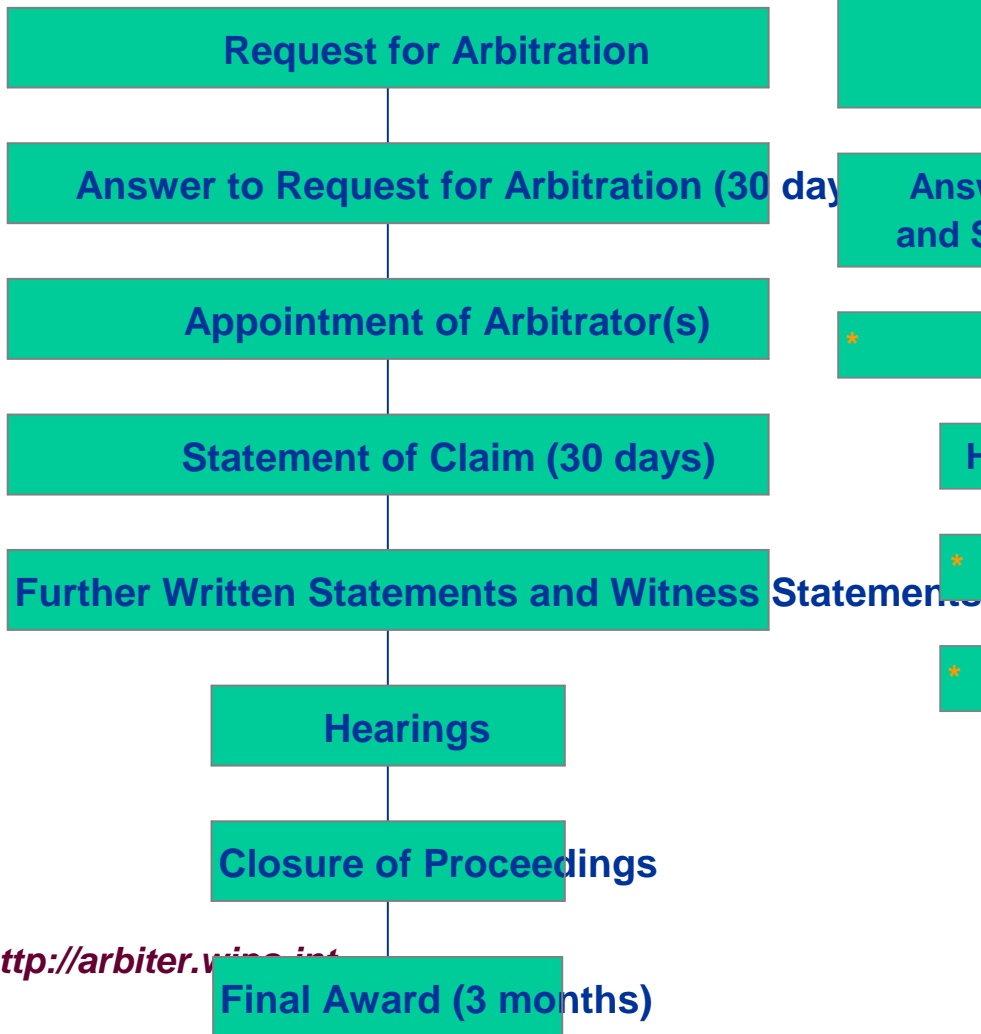
Consensual

Efficient

Binding (“exclusive” jurisdiction)

No appeal (final and enforceable award)

### WIPO ARBITRATION



### WIPO EXPEDITED ARBITRATION



## Expedited Arbitration

- When is it appropriate?
- Statement of Claim filed with Request for Arbitration and Statement of Defense with Answer to the Request
- Sole arbitrator
- Fixed arbitrator's fees for disputes up to USD 10 million
- Shorter hearings
- Time limits shortened

## Expedited Arbitration - Example

- Biotech R&D company concluded exclusive R&D and licensing agreement with pharmaceutical company.
- Alleged delays in development and regulatory approval of biotech compound.
- R&D company terminated agreement and started WIPO arbitration proceedings.
- Center appointed arbitrator expert in biotech-pharmaceutical dispute.
- Two-day hearing.
- Settlement agreement.



# Arbitration Proceedings Schedule of Fees

(All amounts are in United States dollars)


	Amount in dispute	Expedited Arbitration	Arbitration
<b>Registration Fee</b>	Any Amount	\$1,000	\$2,000
<b>Administration Fee *</b>	Up to \$2.5 M	\$1,000	\$2,000
	Over \$2.5 M and up to \$10 M	\$5,000	\$10,000
	Over \$10 M	\$ 5,000 +0.05% of amount over \$10 M up to a maximum fee of \$15,000	\$10,000 +0.05% of amount over \$10 M up to a maximum fee of \$25,000
<b>Arbitrator(s) Fees *</b>	Up to \$2.5 M	\$20,000 (fixed fee)	As agreed by the Center in consultation with the parties and the arbitrator(s)  Indicative rate(s) \$ 300 to \$ 600 per hour
	Over \$2.5 M and up to \$10 M	\$40,000 (fixed fee)	
	Over \$10 M	As agreed by the Center in consultation with the parties and the arbitrator	

<http://arbitrator.wipo.int>

# WIPO List of Neutrals

ORGANISATION MONDIALE  
DE LA PROPRIÉTÉ INTELLECTUELLE

Centre d'arbitrage et de médiation de l'OMPI




WORLD INTELLECTUAL  
PROPERTY ORGANIZATION

WIPO Arbitration and Mediation Center

**LIST OF MEDIATORS AND ARBITRATORS**

**BIOGRAPHICAL DATA**

David W. PLANT, Esq.  
215 Little Lake Sunapee Road  
New London, NH 03257  
United States of America



Telephone: (1-603) 526 2653/2655      Facsimile: (1-603) 526 2654  
E-mail: DPlantADR@aol.com

Date of Birth: April 22, 1931  
Nationality: USA

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**EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS**

Registered to practice before United States Patent & Trademark Office, 1982;  
Licensed to practice in United States Supreme Court, 1968;  
Licensed to practice law, N.Y. State Bar, 1957;  
LLB, Cornell University, 1957;  
BME, Cornell University, 1953.

- Over 1,000 experts
- 100 nationalities
- Broad range of ADR, IP, and technical backgrounds
- Appointment in WIPO Cases
- Referral Service

# The Role of the WIPO Arbitration and Mediation Center

- (Expedited) Arbitration and Mediation Rules
- Model Clauses and Submission Agreements
- Efficient and cost-effective administration
- List of Neutrals and institutional knowledge
- Other resources

# WIPO Arbitration and Mediation Experience (1)

- All WIPO clauses separately or in combination
- Contractual and non-contractual
- From court litigation to WIPO submission
- In English, French, German language
- Place of arbitration: US, France, Germany, Ireland, Netherlands, Switzerland, UK
- Parties from Europe, U.S., China, etc.

# WIPO Arbitration and Mediation Experience (2)

- Subject matter includes:
  - patent, copyright, software licenses
  - trademark co-existence agreements
  - pharmaceutical distribution agreements
  - R&D contracts
  - patent infringement
  - etc.
- High success rate
  - Value in dispute: USD 20,000 - 600 million

# WIPO Domain Name Dispute Resolution

- WIPO Domain Name Process I
  - endorsed by WIPO member states (Sept. 1998)
  - Commenced in July 1998 to make recommendations on questions arising out of the interface between domain names and intellectual property rights
  - Final report published in April 1999
- Uniform Domain Name Dispute Resolution Policy

# Uniform Domain Name Dispute Resolution Policy

- Approved by ICANN in October 1999
- Administrative procedure
- Limited to abusive registrations
- Mandatory submission by domain name registrants
- Remedies
  - Transfer or Cancellation only
  - No monetary damages

# UDRP Criteria

- **Conditions for obtaining remedies:**
  1. Trademark must be identical or confusingly similar to domain name; *and*
  2. Registrant has no rights or legitimate interests in domain name; *and*
  3. Domain name is registered and used in bad faith.
- **Examples of rights or legitimate interests:**
  - Registrant commonly known by the domain name
  - Use for *bona fide* offering of goods or services
- **Examples of bad faith:**
  - registration for purpose of profit sale to trademark owner
  - pattern of preventing trademark owners from registration



# WIPO UDRP Experience

- **Received cases: over 6,065 (leading provider)**
  - 10,621 domain names
  - famous marks, small and medium enterprises, individuals
  - parties from 116 countries
- **Resolved cases: 5,850 (96.5%)**
  - WIPO panel decisions: 4,696
  - transfer rate: 82 %
  - party settlement: 1154 cases
- **Completion time per case: approximately 2 months**
- **Communication:**
  - Over 1 million Web site hits per month
  - Over 40,000 online case communications per year
  - 11 case languages

# WIPO Center Experience Domain Names

·Leading provider of domain name dispute resolution services

	UDRP	.info Sunrise	.biz STOP	.name ERDRP	Total
1999	1	-	-	-	1
2000	1,857	-	-	-	1,857
2001	1,556	1,579	53	-	3,188
2002	1,208	13,593	285	1	15,087
2003	1,100	-	-	-	1,100
					21,233

# Sampling of Disputed Domain Names

???.com	kværner.net
???.com	?????.com
???.com	?????????.com
?????????.com	???.com
?????????.com	???.net
?????.com	?????.com
?????.com	?????????.com
schöps.com	???.com
?????.com	chériefm.com
?????.com	rémycointreau.com
?????.com	rémy-cointreau.com
fortunéo.com	???.com

Crazy Browser - [WIPO Domain Name Decision: D2000-0049]

File Edit View Favorites History Groups Options Tools Tabs Help

Address <http://arbitrator.wipo.int/domains/decisions/html/2000/d2000-0049.html>

Links [CHOL.COM](#) [Cydette](#) [Dictionnaire](#) [DN CM System](#) [Google](#) [Merriam-Webster](#) [WIPO UDRP Index](#)

Case Data | WIPO Arbitration and... | WIPO Domain Name Dec... | Merriam-Webster Onli... | WIPO Arbitration and... | http://intranet.wipo...



# WIPO Arbitration and Mediation Center

## ADMINISTRATIVE PANEL DECISION

**Tata Sons Ltd. v. The Advanced Information Technology Association**

**Case No. D2000-0049**

### 1. The Parties

1.1 Tata Sons Ltd, Bombay House, 24, Homi Modi Street, Mumbai 400 024, India (Complainant).

1.2 The Advanced Information Technology Association, 1/182, Haji Habib Building, Dr.B.A.Road, Dadar, Mumbai 400 014, India (Respondent).

Start | WIPO Eng... | Novell Gr... | Crazy Br... | Exploring ... | Microsoft ... | Microsoft ... | HP Laser... | 2:37 PM



## トップレベル・ドメイン名(g TLDs)のための紛争処理手続

[最新ニュース](#)

[センターについて](#)

[仲裁](#)

[調停](#)

[ドメインネーム](#)

[一般トップレベルドメイン](#)

[UDRP](#)

[レジストリー特定](#)

[国コードトップレベルドメイン](#)

[事件](#)

[裁定](#)

[関連情報/資料](#)

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[パネリスト](#)

[検索](#)

[特殊な紛争処理サービス](#)

[中立者](#)

- [ドメイン名紛争統一処理方針の紛争に関する一般情報](#)
- 事件
  - [全ての事件](#)
  - [全ての裁定](#)
  - [統計](#)
- [紛争処理手続に関する情報](#)
  - [ガイド](#)
  - [処理方針と手続規則](#)
  - [手数料](#)
  - [パネリスト](#)
- [申立人向け](#)
  - [申立書の提出](#)
  - [申立書提出のガイドライン](#)
  - [申立書送付表書](#)
- [答弁人向け](#)
  - [答弁書の提出](#)
  - [答弁書提出のガイドライン](#)

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### ドメイン名紛争統一処理方針の紛争に関する一般情報

WIPO仲裁調停センターのg TLDsに対するドメイン名紛争解決サービスは、ICANN (Internet Corporation for Assigned Names and Numbers (以下、「ICANN」))が1999年8月26日に採択したドメイン名紛争統

<http://arbiter.wipo.int/cgi-bin/domains/search/legalindex>

Case Data | WIPO Arbitration and... | WIPO Arbitration and... | Merriam-Webster Onli... | WIPO Arbitration and... | http://intranet.wipo...

## Index of WIPO UDRP Panel Decisions

This Index covers all WIPO UDRP decisions. New decisions are being added continuously.

[Search tips](#)  
Any time you select more than one category, the search result will yield ONLY those decisions that are indexed in ALL of the categories so selected.

<a href="#">Decided WIPO cases by domain name categories</a>	<a href="#">Legal index to WIPO panel decisions</a>
I. <a href="#">Associations and Institutions</a>	I. <a href="#">General</a>
II. <a href="#">Geographical Identifiers</a>	II. <a href="#">Substance</a>
III. <a href="#">Individuals</a>	III. <a href="#">Procedure</a>
IV. <a href="#">Industry and Commerce</a>	IV. <a href="#">National Court Proceedings Relating to UDRP</a>
V. <a href="#">Non-ASCII Script Registrations</a>	
VI. <a href="#">Professional Firms</a>	
VII. <a href="#">Education</a>	
VIII. <a href="#">Public Sector (Governments)</a>	

<a href="#">Decided WIPO cases by domain name categories</a>
<input type="checkbox"/> <b>I. Associations and Institutions</b> <ul style="list-style-type: none"><li><input type="checkbox"/> A. Religious</li><li><input type="checkbox"/> B. Sports</li><li><input type="checkbox"/> C. Others</li></ul>
<input type="checkbox"/> <b>II. Geographical Identifiers</b>
<input type="checkbox"/> <b>III. Individuals</b>

## Upcoming Events

- WIPO Workshops for Mediators in Intellectual Property Disputes, June 24-25 and 28-29, 2004
- WIPO Workshop for Arbitrators, October 25-26, 2004
- WIPO Workshop on Domain Name Dispute Resolution, October 28-29, 2004
- WIPO Conference on Dispute Resolution in International Science and Technology Collaboration, April 25-26, 2005

# Information

- <http://arbiter.wipo.int>
- [arbiter.mail@wipo.int](mailto:arbiter.mail@wipo.int)
- [eunjoo.min@wipo.int](mailto:eunjoo.min@wipo.int)
- Mailing list:  
<http://arbiter.wipo.int/subscribe/>