



Alternative Dispute Resolution in IP Cases

**Workshop on Building Respect for IP Rights
October 19, 2016 - Kyiv, Ukraine**

**Thomas Dillon
Counsellor, Building Respect for IP Division**

Alternative Dispute Resolution

- Arbitration
- Mediation/Conciliation
- "Med/Arb"
- Expert determination

Arbitration

- Parties submit their dispute to one or more arbitrators, for a binding decision (the award)
- Agreement to arbitrate may be made before or after dispute arises – treated as separate contract
- Stay of court proceedings on request
- Limited grounds for judicial review
- Award binding in contract, but registrable as judgment
- International enforcement often possible

Mediation

- Informal procedure in which neutral intermediary assists parties to settle their dispute, based on the parties' respective interests
- The mediator cannot impose a decision
- Joint meeting, «caucusing», final meeting
- Mandinka saying: 'Kumo mim be kono nii maa foo a kanfa buka bo'
 - *If you do not say what is in you, the anger will not go*
- The settlement agreement is binding as a contract
- "Med-Arb« – mediation becomes arbitration.

Expert Determination

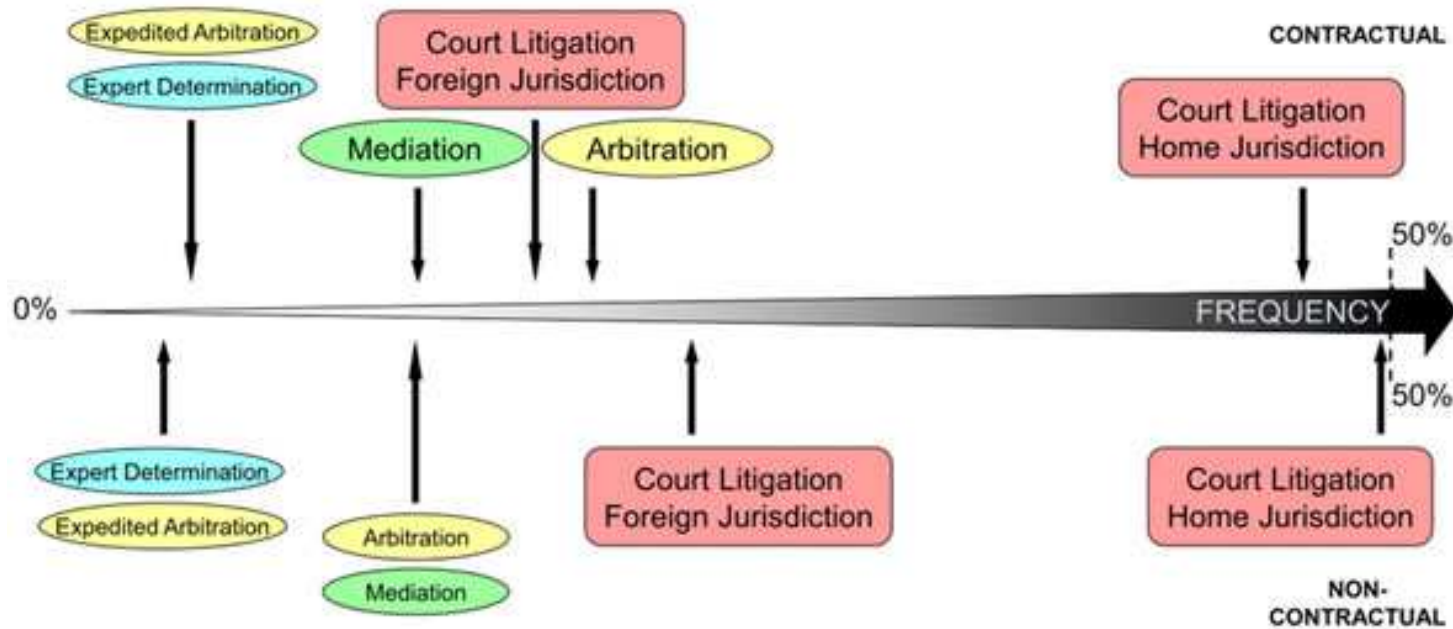
- A procedure in which the parties submit a specific matter (e.g. technical question) to one or more experts to make a determination
- May be compulsory under a contract or voluntary (*ad hoc*)
- Determination can be binding or non-binding, depending on the parties' agreement
- If binding, enforceable under the original contract (= no exclusion of court's jurisdiction). If non-binding, may encourage settlement.
- Confidentiality of evidence may be preserved

Routes to ADR

- ADR contract clauses
- Submission agreement, e.g. in non-contractual disputes
- By direction of the court

WIPO Survey: How Are IP/Technology Disputes Resolved?

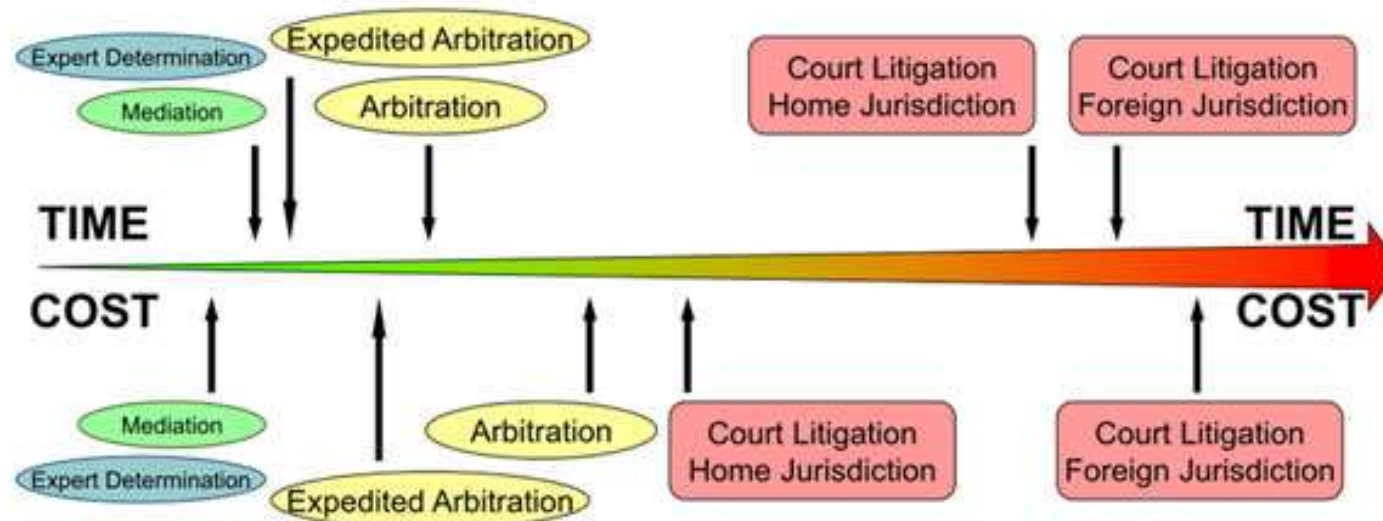
Relative Use of Court Litigation, (Expedited) Arbitration, Mediation, Expert Determination



Source: WIPO Arbitration and Mediation Center, International Survey on Dispute Resolution in Technology Transactions

WIPO Survey: Time and Cost?

Relative Time and Costs of Resolving Disputes through Court Litigation, (Expedited) Arbitration, Mediation, Expert Determination



Source: WIPO Arbitration and Mediation Center, International Survey on Dispute Resolution in Technology Transactions

Why ADR for IP Disputes?

- Internationalization of creation/use of IP: *cross-border solutions*
- Technical & specialized nature of IP: *specific expertise of tribunal*
- Short product and market cycles: *speed*
- Confidential nature of IP: *privacy*
- Collaborative nature of IP creation and commercialization: *need to preserve relations*

Membership of New York Convention on the Recognition and Enforcement of Foreign Arbitral Awards



Membership of New York Convention on the Recognition and Enforcement of Foreign Arbitral Awards

Country	Membership of Convention	Non-member recognition
Azerbaijan	29 February 2000	Yes
Georgia	2 June 1994	Yes
Hungary	5 March 1962	No
Tajikistan	14 August 2012	No
Turkey	2 July 1992	No
Ukraine	10 October 1960	If reciprocity
Uzbekistan	7 February 1996	Yes

Limitations of IP ADR

■ Consensual

- May be difficult to agree once dispute has arisen and where there is no contractual relationship between the parties

■ Outcome normally binding between parties only

- No public precedent

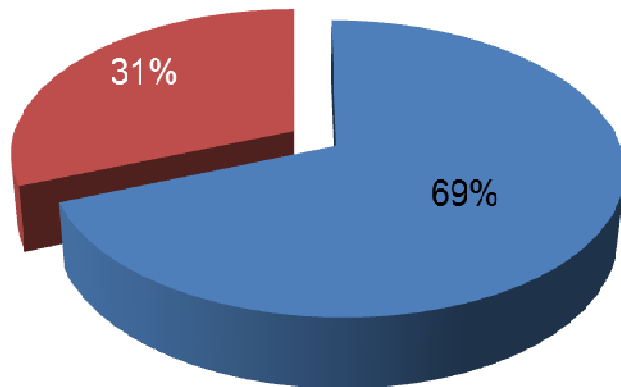
■ Validity of registered rights generally not arbitrable

- Patent office not bound

Settlement in WIPO-Administered Cases

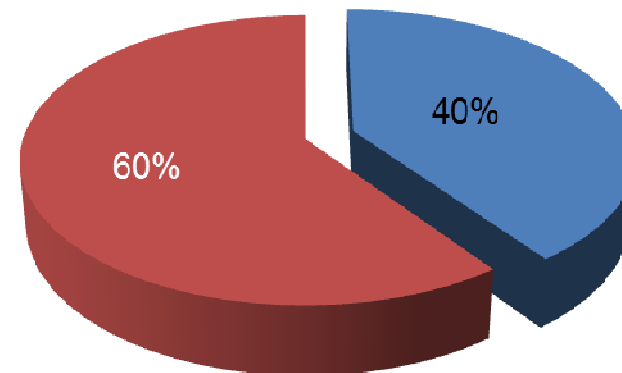
Mediation

■ Settlement ■ Non-Settlement



Arbitration

■ Settlement ■ Non-Settlement (Arbitral Award)



Further Information

- WIPO procedures, neutrals and case examples:
<http://www.wipo.int/amc/en/>
- 2014 WIPO Rules:
<http://www.wipo.int/amc/en/rules/newrules.html>
- Contact information, general queries and case filing:
arbiter.mail@wipo.int
- WIPO model clauses/submission agreements:
<http://www.wipo.int/amc/en/clauses/>
- International Survey on Dispute Resolution in Technology Transactions
<http://www.wipo.int/amc/en/center/survey/results.html>

