



# ■ The WIPO Arbitration and Mediation Center Experience in South East Asia

**WIPO-LESI Webinar: Best Strategies  
in Mediation and Arbitration for IP  
and Licensing Disputes**

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# WIPO Arbitration and Mediation Center

- Facilitates the resolution of commercial disputes between private parties involving IP and technology, through ADR
  - Offices in Geneva and Singapore
  - International **neutrality**
- ADR of IP disputes benefits from a **specialized** ADR provider
  - WIPO mediators, arbitrators and experts experienced in IP and technology
- Competitive WIPO fees
- Services include mediation, (expedited) arbitration, expert determination, and domain name dispute resolution



# WIPO Center Role

- Procedural assistance
  - Information and guidance on ADR
  - Drafting ADR clauses and submission agreements
  
- Administering cases
  - Containing time and costs
    - WIPO eADR
  
- Assisting selection and appointment of mediators, arbitrators, experts; negotiating fees
  - 2,000+ neutrals from all regions (including South East Asia)
  - Specialized in IP and technology

# Licensing Disputes: WIPO Experience

- Among technology-related agreements, licenses most frequently give rise to disputes
  - scope and existence of the license, products, quality standards, profits, determination and payment of royalty rates
- More often where parties are based in different jurisdictions
  - 90% of survey respondents concluded agreements with parties from other jurisdictions
  - 80% of survey respondents concluded agreements with parties from other jurisdictions on technology registered in more than one country

# A WIPO Mediation of a Patent Infringement Dispute – R&D

<i>Parties</i>	European R&D company and Asian manufacturer
<i>Contract</i>	Consultancy agreement (disclosing a patented invention without transferring nor licensing any rights to the manufacturer)
<i>Dispute</i>	Whether some products sold by the manufacturer included the patented invention
<i>Basis</i>	Submission agreement providing for WIPO Mediation
<i>Process</i>	Taking into account parties' criteria, WIPO Center proposed mediator candidates with experience in patent law and license agreements  Two-day meeting with mediator
<i>Duration</i>	Four months
<i>Result</i>	<b>Parties reached a settlement agreement granting a license for royalties and a new consultancy agreement</b>

# A WIPO Mediation of a Software License Dispute – Mobile Apps

- Parties* Asian and US start-ups
- Contract* License agreement for the use of mobile phone applications
- Dispute* Unauthorized use of the software by the licensee and related royalty payment claims
- Basis* Contract clause providing for WIPO Mediation followed by WIPO Arbitration
- Process* Parties agreed on an experienced mediator with experience in technology cases
- Mediation sessions took place entirely by telephone (caucus and joint sessions)
- Result* **Settlement agreement within three months, allowing the parties to continue the collaboration**

# A WIPO Arbitration of a Patent License Dispute – Consumer Goods

- Parties* Asian company and inventor holding patents in Australia, Europe and North America
- Contract* Patent and know-how license agreement
- Dispute* Payment of patent renewal fees and termination of the agreement by the Asian company
- Basis* Contract clause providing for WIPO Arbitration
- Process* Three arbitrators with substantial IP expertise and language skills to consider evidence in different languages
- The arbitrators found that the Asian company was not been entitled to terminate the agreement and ordered to pay damages and return to inventor prototypes, plans and documents communicated in the context of the license
- Result* Arbitral award rendered within 14 months**

# A WIPO Arbitration of a Software License Dispute – Mobile Apps

*Parties* Asian company and European software developer

*Contract* License agreement to provide mobile payment service in Asia

*Dispute* Performance and alleged breaches of the license agreement

*Basis* Contract clause providing for WIPO Arbitration

*Process* Sole arbitrator with considerable arbitration and IP experience

Interim measures: bank guarantee to secure payment of the European software developer's counterclaim

Conciliation conference at the arbitrator's suggestion to communicate provisional conclusions and explore potential settlement

***Result* Through direct discussions in the following weeks, parties reached a global settlement of the dispute**

# A Few General ADR Pointers

- Contracting on technology should anticipate disputes
- Prepare for likelihood of international aspect in parties, rights, and law
- Dispute policy should combine options and include mediation
  - 40% of WIPO cases include escalation clauses
  - 70% of WIPO mediations settle
- Between arbitration and court litigation, consider (expedited) arbitration as time- and cost-effective option
- In non-contractual disputes, potential for party negotiation and mediation

# WIPO Arbitration and Mediation Center

- Queries: [arbiter.mail@wipo.int](mailto:arbiter.mail@wipo.int)
- Clauses: [www.wipo.int/amc/en/clauses](http://www.wipo.int/amc/en/clauses)
- Rules: [www.wipo.int/amc/en/rules](http://www.wipo.int/amc/en/rules)
- Neutrals and case examples: [www.wipo.int/amc](http://www.wipo.int/amc)
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  - Geneva, Switzerland
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