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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Chiara Accornero
WIPO Arbitration and Mediation Center
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

WIPO Center Report on International Survey of Dispute Resolution in Technology Transactions
**A WIPO Mediation of a Patent Infringement Dispute – R&D**

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

<table>
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<tr>
<th><strong>Parties</strong></th>
<th>Asian company and inventor holding patents in Australia, Europe and North America</th>
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<tbody>
<tr>
<td><strong>Contract</strong></td>
<td>Patent and know-how license agreement</td>
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<tr>
<td><strong>Dispute</strong></td>
<td>Payment of patent renewal fees and termination of the agreement by the Asian company</td>
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<tr>
<td><strong>Basis</strong></td>
<td>Contract clause providing for WIPO Arbitration</td>
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<tr>
<td><strong>Process</strong></td>
<td>Three arbitrators with substantial IP expertise and language skills to consider evidence in different languages</td>
</tr>
<tr>
<td><strong>Result</strong></td>
<td>Arbitral award rendered within 14 months</td>
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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
- Clauses: www.wipo.int/amc/en/clauses
- Rules: www.wipo.int/amc/en/rules
- Neutrals and case examples: www.wipo.int/amc
- Endorse the WIPO Mediation Pledge: https://www.wipo.int/amc/en/mediation/pledge.html

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