

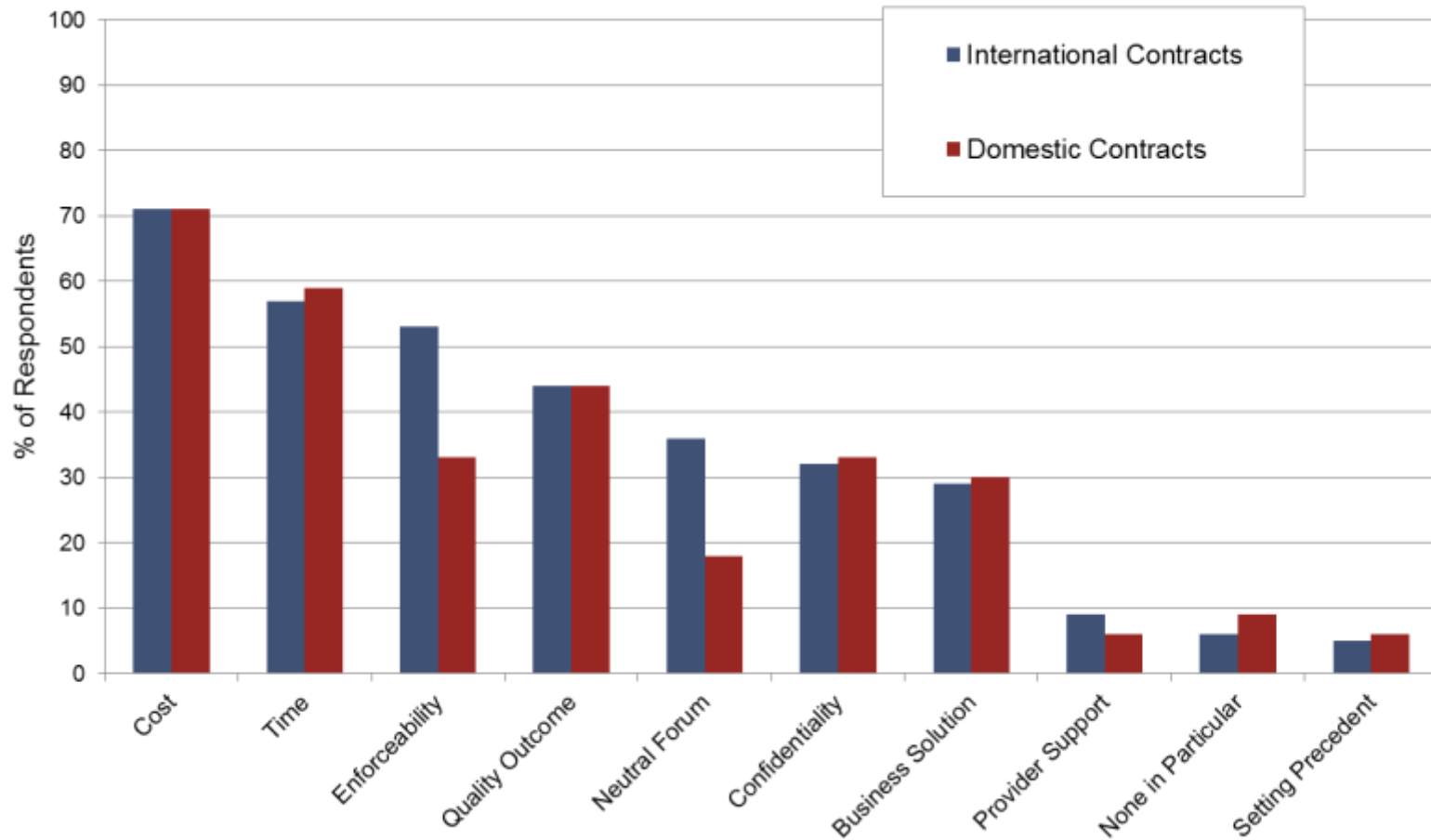


■ Resolving IP disputes outside the courts through WIPO ADR

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**Roving Seminar on WIPO Services and Initiatives
Auckland - Wellington - Christchurch
New Zealand
April 8-11, 2019**

What are your IP dispute resolution priorities?



WIPO Arbitration and Mediation Center: who are we?

- Helping to resolve IP and technology disputes outside the courts
- WIPO mediators, arbitrators and experts experienced in IP and technology
- Competitive fees
- International neutrality
- Users around the world

What is ADR?

- **Mediation:** mediator assists parties to settle their dispute based on their interests
 - Leaves open court or arbitration options
- **Arbitration:** one or more chosen arbitrators decide the dispute
 - Enforceable internationally, foreclosing court options
- **Expert Determination:** submitting a specific matter (e.g., technical question) to an expert opinion
 - Parties can agree to give binding effect

Why ADR for IP?

- Cost of IP court litigation
- Internationalization of creation and use of IP
- Technical and specialized nature of IP
- Short product and market cycles in IP
- Confidential nature of IP
- Collaborative nature of IP creation and commercialization

Routes to WIPO ADR

- ADR contract clause electing WIPO Rules
 - Mediation or Arbitration or Expedited Arbitration; or
 - Multi-tier/escalation clause (Mediation followed by Arbitration / Expedited Arbitration / Court Litigation)

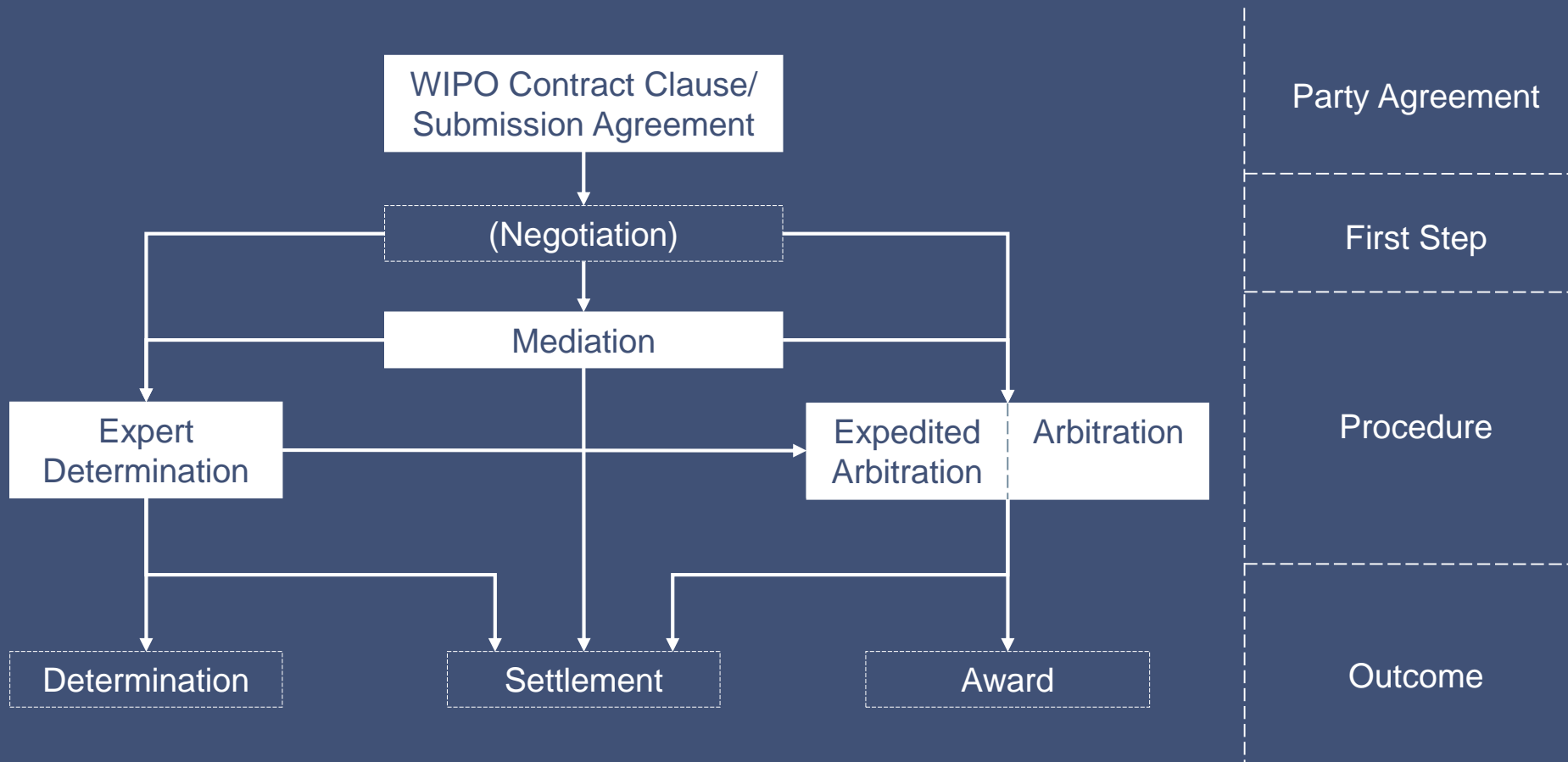
- Model clauses
 - Available online
 - WIPO Model Clause Generator
 - Parties can choose location, language, and law

- ADR submission agreement electing WIPO Rules, e.g., in existing non-contractual disputes

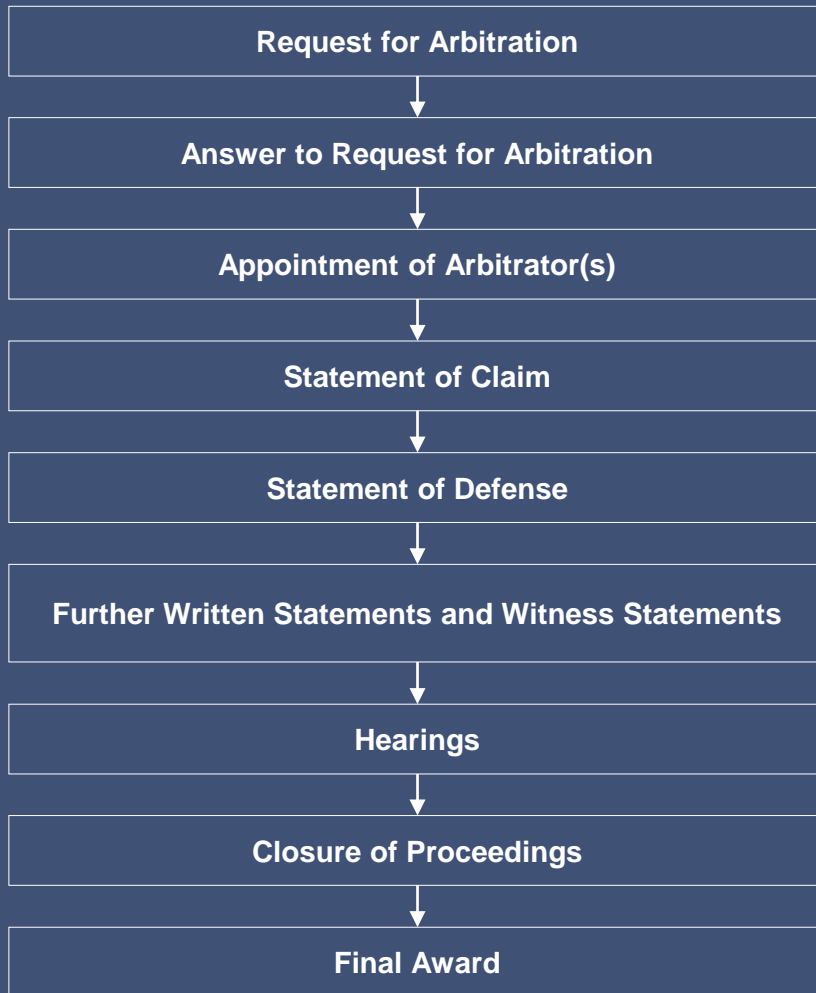
- Unilateral request for WIPO Mediation by one party (Art. 4)

- Court referrals

From clause to outcome: WIPO ADR options



WIPO Arbitration



WIPO Expedited Arbitration



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

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 Clause Generator

Step 3 – Build your clause: WIPO Mediation followed, in the absence of a settlement, by Arbitration Clause

Mediation

The parties should determine where they want the mediation to take place.

Core Elements ?

Place of Mediation

Language of the Mediation

Duration of the Mediation Proceedings

Additional Elements ?

Qualifications of the Mediator

Conduct of the Mediation

The place of mediation shall be .

Clear

Next

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 [specify timeline] 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 Arbitration Rules. Alternatively, if, before the expiration of the said period of [specify timeline] 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 Arbitration Rules.

The arbitral tribunal shall consist of [a sole arbitrator][three arbitrators].

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 shall be decided in accordance with the law of [specify jurisdiction].

Arbitration

Core Elements ?

Number of Arbitrators

Place of Arbitration

Language of Arbitration

Substantive Law

Additional Elements ?

Appointment Procedure

Qualifications of the Arbitrators

ECAF

Evidence

Time Period of Delivery of the Final Award

Appeal

Step 4 – Download or copy the final result

Download

Copy to clipboard

Print clause

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 selection and appointment of mediators, arbitrators, experts; negotiating fees
 - 2,000+ WIPO neutrals from all regions (including Australia and New Zealand)
 - Specialized in IP and IT

An online tool for easy case management

- Simple; secure; instant; location-independent; optional

WIPO Electronic Case Facility (ECAF)

Case Overview

Logout

Case: WIPOA20020
Licensing v. AB Technics Inc.

Case Overview | Contact Information | **Case File** | Message Board



Case File

Only documents to be recorded as part of the case file should be submitted in the Case File. Only first-level submissions will trigger an email notification to users. Display issues from variations in browsers may be resolved by adjusting the Text Size in the browser menu.

[Search Case](#) [+ Submit New File](#)

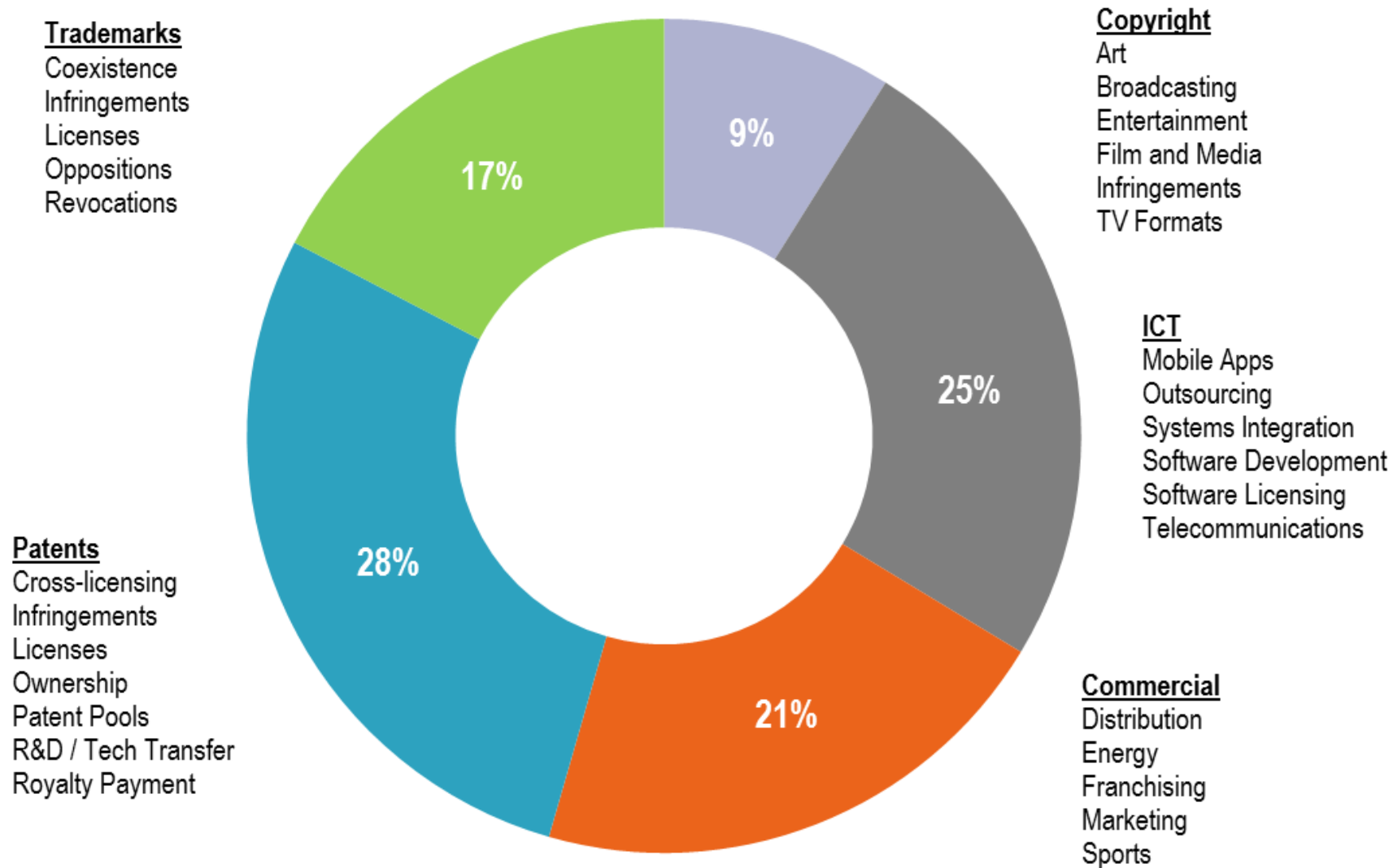
[Expand](#) | [Collapse](#)

To sort, you may click on the column headers.

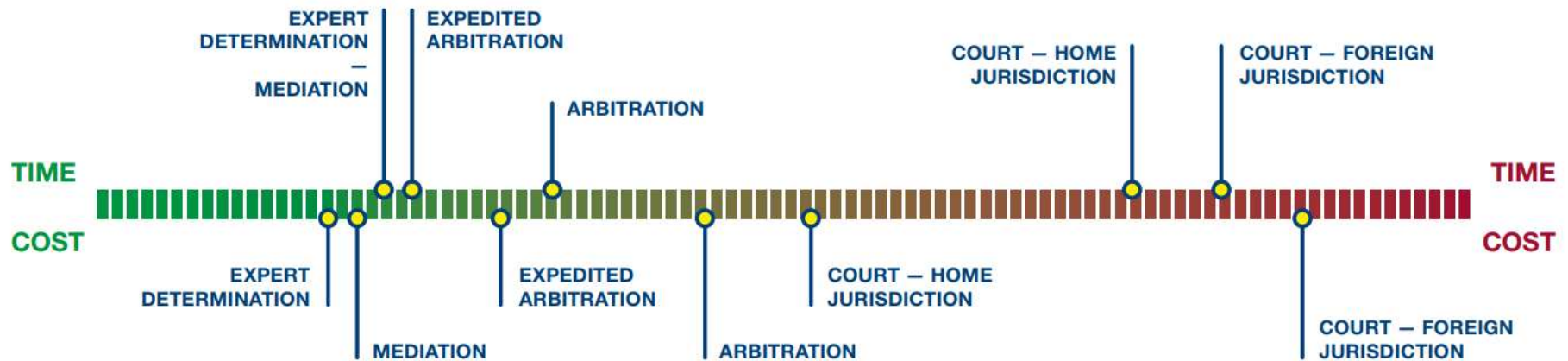
Item No	Submitted By	Date	Subject	Annex
3	WIPO AMC Case Manager	05/04/18 07:27:04	 Main Case File 3	[Add]
2	WIPO AMC Case Manager	05/04/18 07:27:03	 Main Case File 2	[Add]
1	WIPO AMC Case Manager	05/04/18 07:27:00	Main Case File 1	3 [Add]
1.1		05/04/18 07:28:26	Annex1	[Add]
1.2		05/04/18 07:28:26	Annex2	[Add]
1.3		05/04/18 07:28:27	Annex3	[Add]

What are WIPO's cases about?

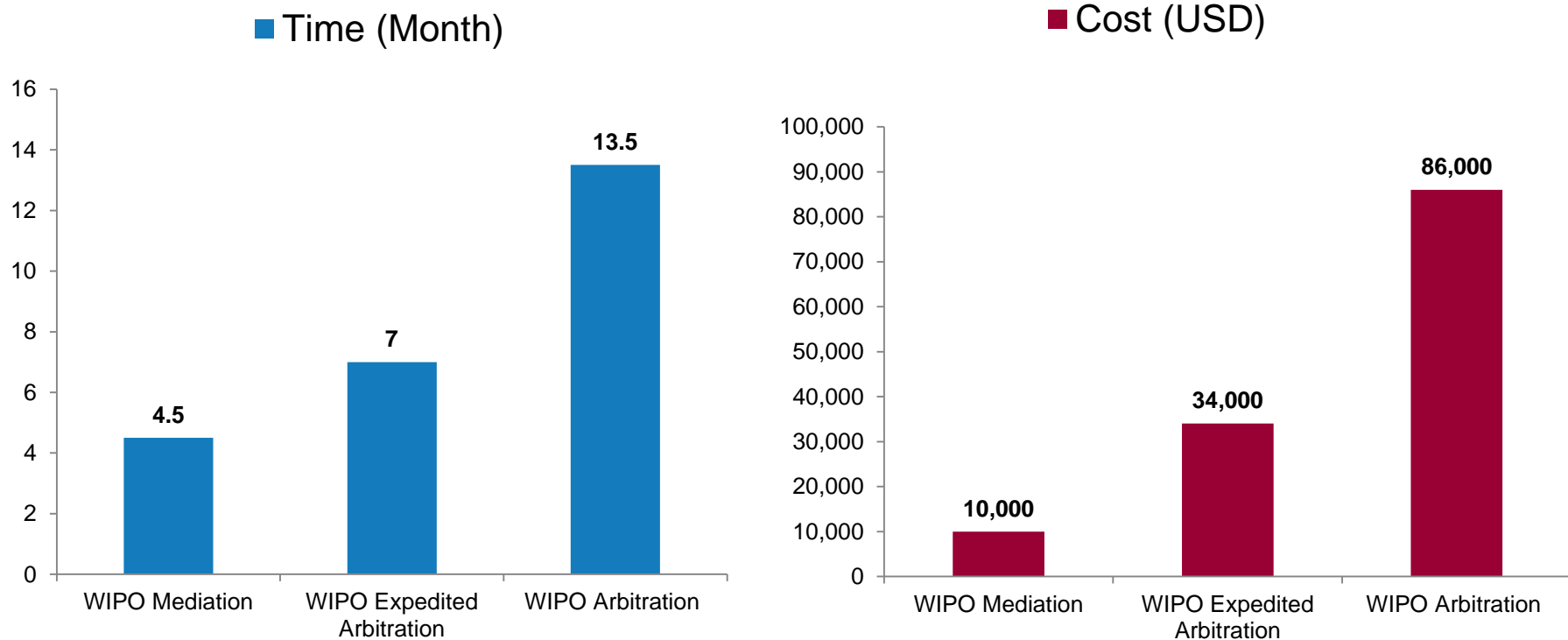
- IP/IT disputes and general commercial disputes
 - Contractual
 - Non-contractual
- Domestic and international disputes (25/75%)
- Case venues around the world
- Amounts in dispute from USD 15,000 to USD 1 billion



Time and cost: how does IP ADR compare to the courts?



What does a WIPO case cost?



* Mostly fees of appointed neutrals; 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 \(Effective from June 1, 2014\)](#)

Tackling cybersquatting: Uniform Domain Name Dispute Resolution Policy (UDRP)

- 1999: WIPO-created international ADR procedure
- Allows trademark owners to resolve “clear-cut” cases of abusive domain name registration and use (“cybersquatting”)
- Operates outside the courts, but preserves court option
- Applies via mandatory domain name registration conditions
- Applies to all international domains “old” (.com, etc.) and “new”
- Also available for over 75 country-code domains (including .AU)

Why do brand owners choose the UDRP?

- Significantly quicker and cheaper than court litigation
 - Two-month average; fixed fees (USD 1,500)
- Predictable criteria and results
- Decision (transfer) implemented directly by registrar

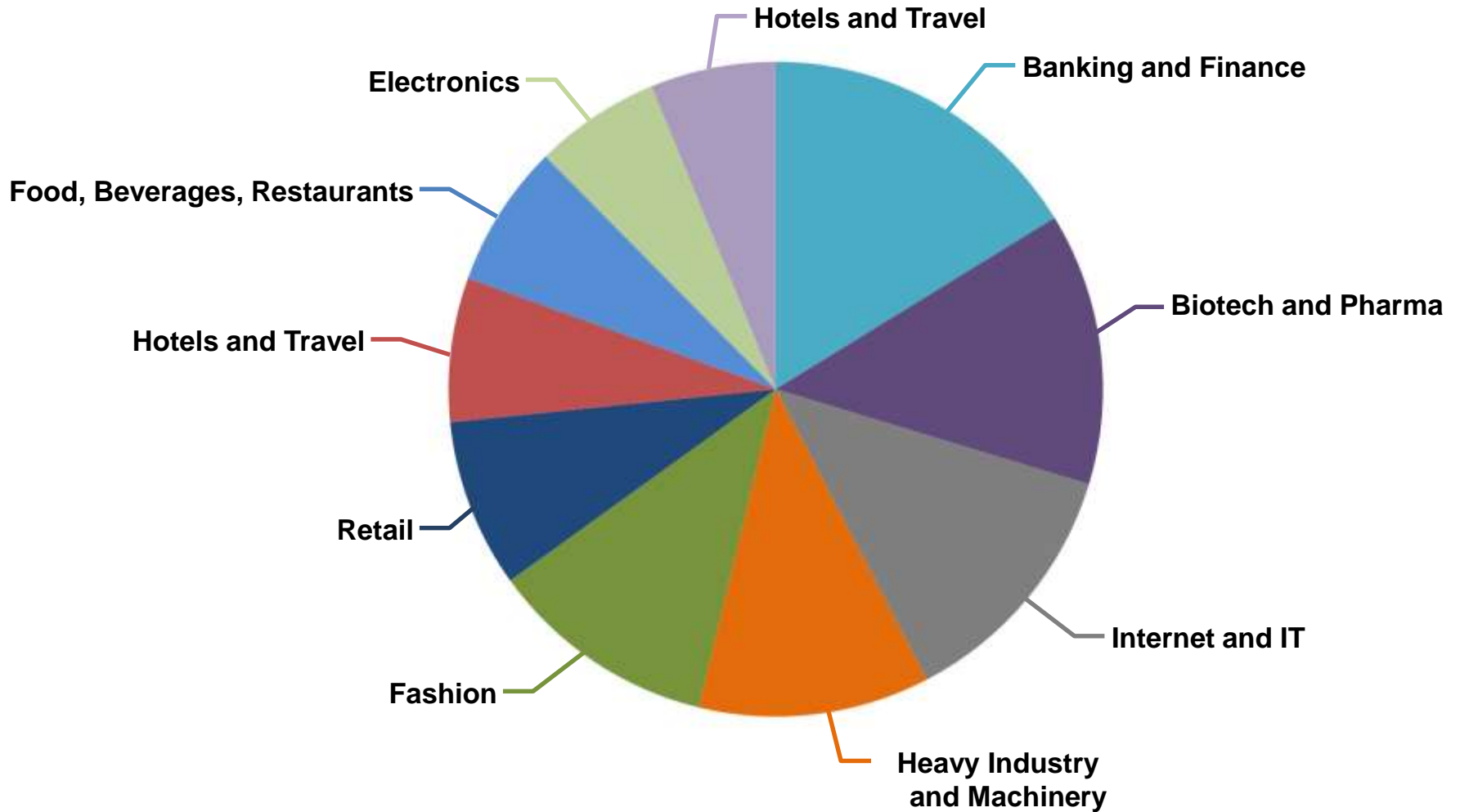
How is a UDRP case decided?

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

WIPO domain name cases at a glance

- 20 years' experience
- 43,000+ cases covering 79,000+ domain names
 - 2018 total: 3,447 cases
- Parties based in 177 countries (including Australia and New Zealand)
- Cases in 21 languages
- Paperless filing through WIPO eUDRP
- Panelists based in 63 countries (including Australia and New Zealand)

WIPO domain name cases – top 10 areas of complainant activity



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](#)

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>
- Domain Names: www.wipo.int/amc/en/domains/
- Offices:
 - Geneva, Switzerland
 - Singapore, Singapore

