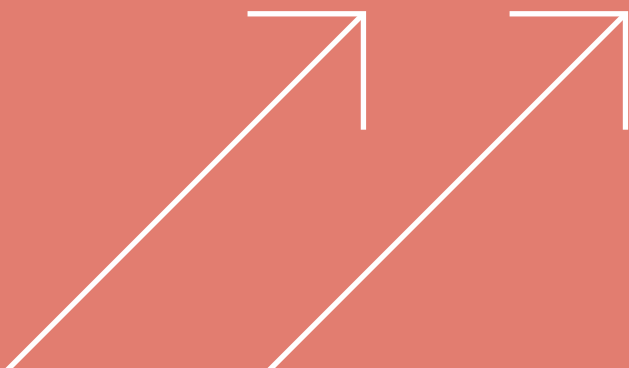


Guide to WIPO Arbitration



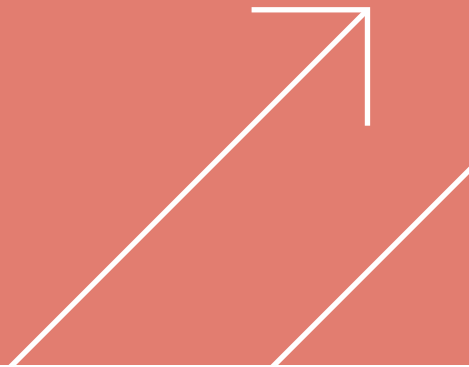


Table of contents

WIPO Arbitration and Mediation Center	3
WIPO Rules and Neutrals	3
IP dispute resolution	6
What is arbitration?	8
Why consider arbitration?	9
What is expedited arbitration?	10
WIPO Arbitration and WIPO Expedited Arbitration compared	11
WIPO Arbitration options	12
Routes to WIPO Arbitration and WIPO Expedited Arbitration	13
Recommended WIPO contract clauses and submission agreements	14
Recommended WIPO arbitration clause	15
Why WIPO Arbitration?	16
Role of the WIPO Center	16
WIPO case experience	17
Where does a WIPO arbitration take place?	18
WIPO online case administration tools	18
How much does a WIPO arbitration cost?	19
How it works: The principal steps in a WIPO arbitration	20
WIPO Good Offices	33

Alternative Dispute Resolution (ADR) embraces various ways of resolving disputes between two or more parties without resorting to conventional court litigation.

Court litigation can be a challenging process. If well managed, ADR can save time and money as well as provide a range of additional benefits.

For most intellectual property (IP) and technology-related disputes, one or more types of ADR – such as mediation, arbitration and expert determination – may offer distinct advantages.

WIPO Arbitration and Mediation Center

With offices in Geneva, Switzerland, and in Singapore, the WIPO Arbitration and Mediation Center (WIPO Center) provides neutral, international and non-profit ADR services, helping you to:

- **efficiently** resolve domestic or cross-border IP, technology and commercial disputes;
- **control** the dispute resolution process;
- select **experienced** mediators, arbitrators or experts;
- bring all related disputes together in **one procedure**; and
- keep the dispute **confidential**.

The WIPO Center's primary goal is to offer stakeholders the means to resolve their disputes in a cost- and time-saving manner.

WIPO Rules and Neutrals

The legal and practical framework for the conduct of a WIPO alternative dispute resolution (ADR) procedure is provided by the WIPO Mediation, Arbitration, Expedited Arbitration and Expert Determination Rules, respectively. The **WIPO Rules** are generally suitable for all commercial disputes, and additionally feature provisions to address **specific needs in IP disputes**, such as provisions on confidentiality and technical evidence.

To assist parties in selecting and appointing the right neutral(s) for the proceeding, the WIPO Center maintains a **database of more than 2,000** mediators, arbitrators and experts globally with **expertise** in IP, information and communication technology (ICT), and commercial dispute resolution.



WIPO Headquarters in Geneva, Switzerland

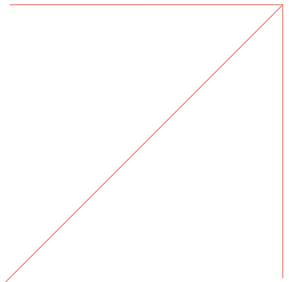
Photo: WIPO / Bierood



WIPO Center's offices at Maxwell Chambers in Singapore

Photo: Maxwell Chambers Suites

IP rights are as strong as the means to enforce them. Arbitration, as a private and confidential procedure, is increasingly being used by IP, technology, entertainment, and other commercial stakeholders to resolve disputes involving such rights.



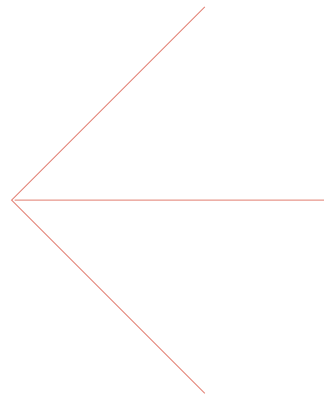
In part, this growth reflects dissatisfaction with the cost, delays, length, and uncertainty of cross-border court litigation.

It is also due to the advantages of arbitration, particularly its appeal as a procedure that offers parties more control over the process to which they submit their dispute and the international enforceability of the outcome of that process.

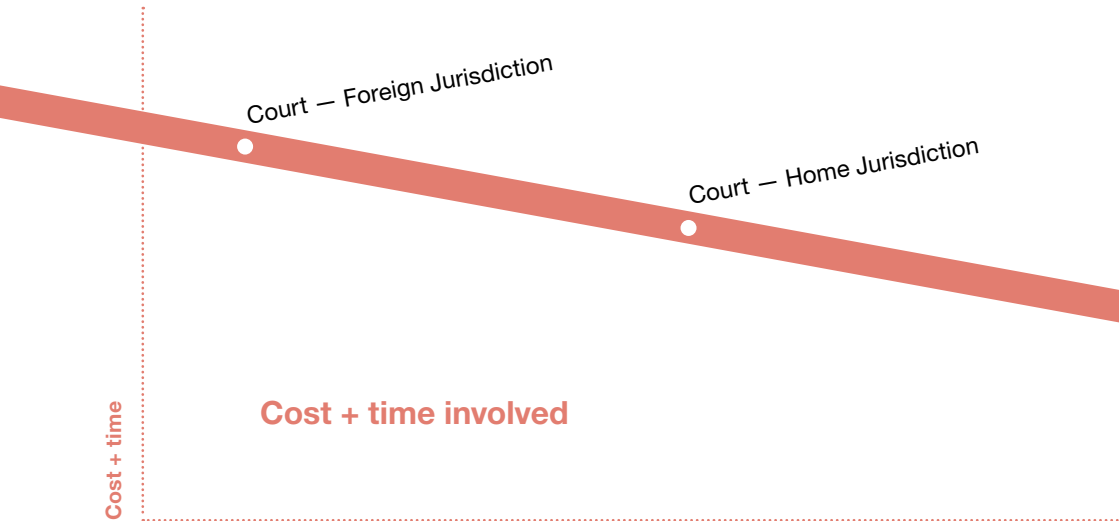
However, arbitration may still be unfamiliar to many potential users as a dispute resolution procedure.

This booklet is designed to answer their questions. It provides a straightforward introduction to arbitration, based on the extensive experience of the WIPO Center. It introduces the main features and advantages of arbitration and explains how arbitration under the WIPO Arbitration Rules works in practice, with actual case examples.

The aim is to prepare stakeholders who are considering whether arbitration is the right choice for their dispute resolution needs.



IP dispute resolution



Source: WIPO International Survey on Dispute Resolution in Technology Transactions (www.wipo.int/amc/en/center/survey/results.html)

Mediation

An **informal** consensual process in which a neutral intermediary, the **mediator**, **assists** the parties in reaching a **settlement** of their dispute, based on the parties' respective **interests**.

The mediator **cannot impose** a decision.

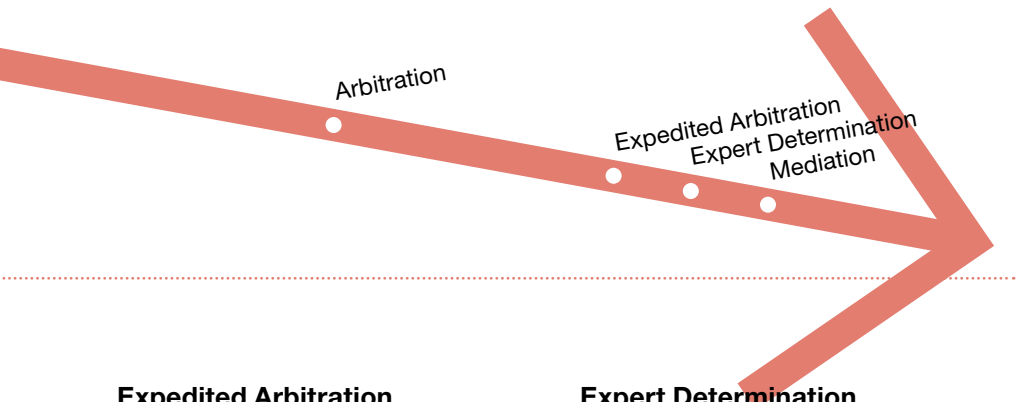
A settlement agreement can be enforced as a contract.

Mediation leaves **open litigation or agreed arbitration** options.

Arbitration

A **more formal** consensual procedure in which the parties submit their dispute to one or more chosen arbitrators, for a **binding and final decision (award)** based on the parties' respective **rights and obligations** and **internationally enforceable under arbitral law**.

As a private alternative, arbitration normally **forecloses court options**.



Expedited Arbitration

An arbitration procedure that is carried out in a **shorter time** and at a **reduced cost**.

The arbitral tribunal will normally consist of a **sole arbitrator**.

Expert Determination

A **consensual** procedure in which the parties submit a **specific matter** (e.g., a technical question) to one or more experts who **make a determination** on the matter.

The parties can agree for such outcome to be **binding**.

What is arbitration?

Traditionally arbitration is the best known alternative to court litigation. It is a procedure in which a dispute is submitted, by **agreement** of the parties, to one or more arbitrators for a **binding decision**.

Arbitration is consensual

Arbitration can only take place if **both parties** have agreed to it. This is achieved by their inclusion in their contract of an arbitration clause or, for already existing disputes, their conclusion of a submission agreement.

Parties choose the arbitrator

Under the WIPO Rules, the parties can **select** the arbitrator(s) by themselves. Alternatively, the WIPO Center will suggest to the parties potential arbitrators with relevant expertise.

Arbitration is neutral

In addition to their selection of arbitrators of appropriate nationality, parties are able to **choose** such important elements as the applicable law, language and place of arbitration. This allows them to ensure that no party enjoys a home court advantage.

Arbitration is confidential

The WIPO Rules specifically protect the confidentiality of the **existence** of the arbitration, of any **disclosures** made during that procedure, and of the **award**. The WIPO Rules also allow a party to request the arbitral tribunal to restrict access to trade secrets or other confidential information that it submits to the tribunal.

The decision of the arbitral tribunal is final and enforceable

Under the WIPO Rules, the parties agree to carry out the decision of the arbitral tribunal without delay. While the vast majority of arbitration awards are complied with voluntarily, if need be international awards are enforceable by national courts under the “**New York Convention**”. Over 160 States are party to this Convention.

Why consider arbitration?

Arbitration is an attractive dispute resolution option where any of the following are important priorities for either or both of the parties:

- **minimizing the costs** entailed in resolving the dispute;
- **maintaining control** over the dispute-resolution process;
- choosing an arbitrator(s) with **expertise** in the area of the dispute;
- achieving a **timely outcome**;
- maintaining **confidentiality** about the dispute; or
- obtaining a **final and internationally enforceable** award.

Arbitration can be an efficient alternative to court litigation. This can be especially true when a dispute involves parties from more than one jurisdiction. In an international context, litigation may involve multiple proceedings under different laws, with risk of conflicting results. Arbitration, on the other hand, entails a **single proceeding under the law determined by the parties**.

The **increased party autonomy** provided by arbitration also creates efficiencies. Parties are free to shape the proceedings to suit their specific needs, for example regarding the scope of document production or the timeline for the issuance of an award.

This does not mean that arbitration will be the best solution for all disputes. Court litigation may be the preferred approach where public precedent is desired; or, **mediation** may suit parties seeking to find a **business solution** rather than a legal solution to their dispute.

What is expedited arbitration?

While arbitration generally offers efficiency benefits, the WIPO Expedited Arbitration Rules specifically allow the procedure to be conducted in a **shortened** timeframe and at **reduced** cost.

Notably, there is, in principle, only **one** exchange of pleadings. There is a **sole** arbitrator, thus avoiding the potentially more lengthy appointment and decision-making process of three-member tribunals, and the associated additional expense. Proceedings should be declared **closed within**

three months of either the delivery of the Statement of Defense or the establishment of the tribunal, whichever occurs later.

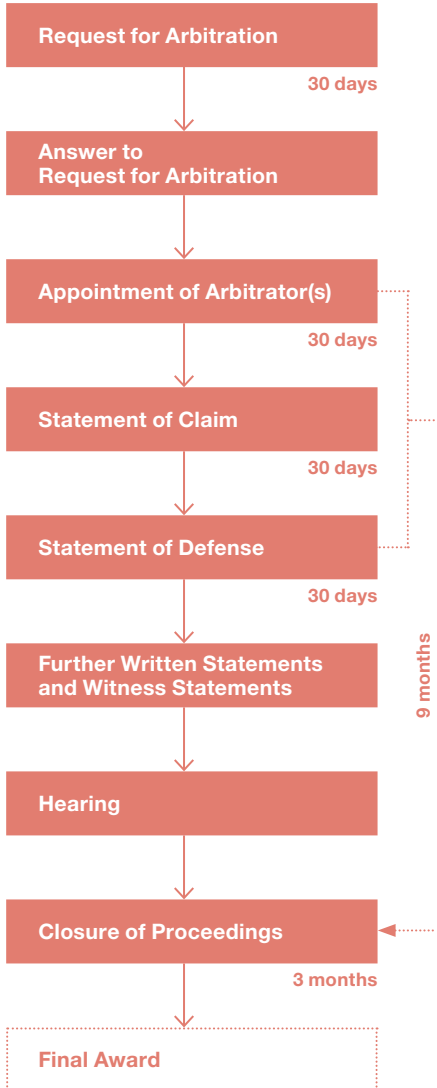
Expedited arbitration may be less suited for complex patent disputes that often require extensive production of evidence, expert analysis, or longer hearings. WIPO Center case experience shows that WIPO Expedited Arbitration is **particularly appropriate** for copyright, software, R&D, and trademark disputes.

When to consider expedited arbitration?

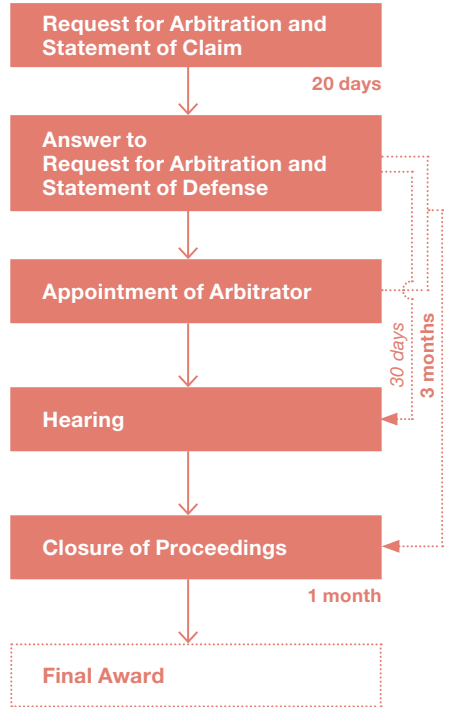
- The **value** in dispute does not justify the cost of more extensive procedures
 - A **limited number** of issues are in dispute
 - The parties need a final and enforceable decision in a **short period**
 - The parties wish to commence with an **ambitious** time/cost framework, subject to case developments
-

WIPO Arbitration and WIPO Expedited Arbitration compared

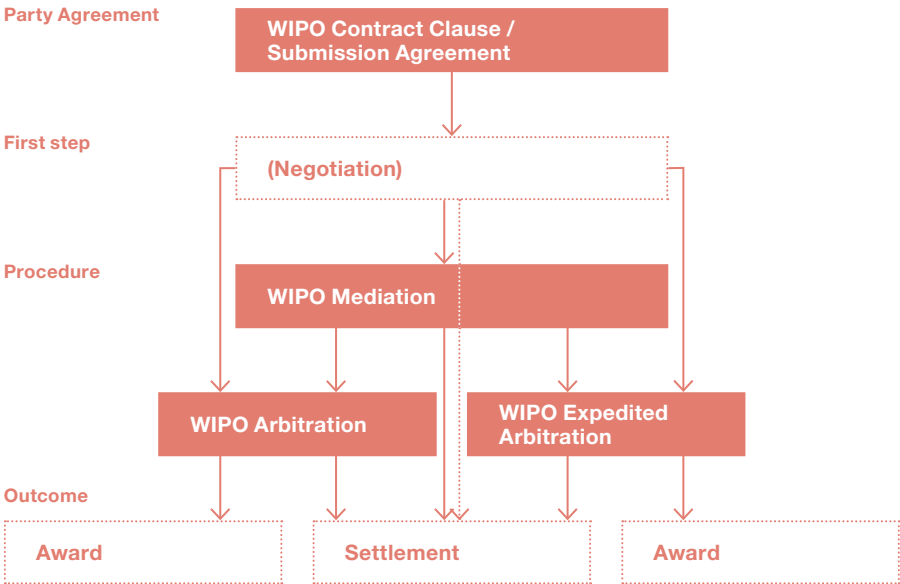
WIPO Arbitration



WIPO Expedited Arbitration



WIPO Arbitration options



*In addition, WIPO offers Expert Determination services, where an expert can determine issues of a technical, scientific or related business nature.

**The WIPO Center also offers the option of mediation followed, in the absence of a settlement, by court litigation. See recommended WIPO clauses and submission agreements, page 14.

Typically, 40 percent of the cases filed with the WIPO Center are based on an **escalation clause** providing for WIPO mediation followed, in the absence of a settlement, by WIPO Arbitration or Expedited Arbitration.

Routes to WIPO Arbitration and WIPO Expedited Arbitration

Referral to WIPO Arbitration and Expedited Arbitration is **consensual**.

Parties refer disputes through a **contract clause** (for the submission of future disputes under a particular contract) or, in the absence of a contractual relationship, through a **submission agreement** (for existing disputes).

Arbitration contract clause electing WIPO Rules

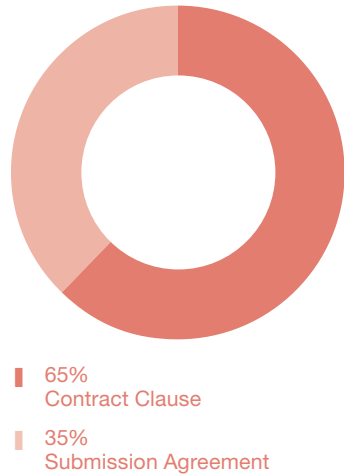
This is the most frequent basis for requesting WIPO Arbitration or Expedited Arbitration.

Arbitration submission agreement electing WIPO Rules

In the absence of prior agreement, parties may still agree to WIPO Arbitration or Expedited Arbitration **after** a dispute has arisen.

For each of these routes to WIPO Arbitration or Expedited Arbitration, WIPO makes available **recommended clauses and submission agreements**,

WIPO ADR Cases



respectively (see page 14). These clauses and agreements may further include WIPO Mediation.

Parties can **shape** the arbitration process via the clause, for example by identifying the number of arbitrators, place and language, as well as applicable law.

While most WIPO arbitration cases are based on prior contract clauses, the WIPO Center has observed an increase in the number of cases referred to WIPO Arbitration through submission agreements, including for disputes that were pending before courts.

Recommended WIPO contract clauses and submission agreements

WIPO makes available the following recommended clauses and submission agreements for arbitration:

- arbitration
- expedited arbitration
- mediation followed, in the absence of a settlement, by [expedited] arbitration

The recommended WIPO contract clauses and submission agreements are available in **different languages**, such as Arabic, Chinese, English, French, German, Greek, Italian, Japanese, Korean, Portuguese, Russian, and Spanish.

The WIPO Center also offers recommended clauses for its other ADR procedures:

- mediation
- expert determination

All WIPO Center recommended clauses are available at: www.wipo.int/amc/en/clauses.

Reflecting WIPO Arbitration practice, the WIPO Center makes available the **WIPO Clause Generator** to assist parties in selecting or adapting clauses and submission agreements: www.wipo.int/amc-apps/clause-generator.

WIPO Case – a patent infringement dispute submitted to arbitration

In the course of court litigation in several jurisdictions, two US companies agreed to submit to WIPO Arbitration a dispute related to the alleged infringement of a European patent concerning consumer goods. The submission agreement provided that the national patent law of a particular European country would apply and that typical patent litigation timelines of that jurisdiction should be followed. The issue for decision was whether the manufacture and sale of certain products infringed the patent.

The parties accepted the WIPO Center's recommended three-member tribunal, **all with substantial expertise in arbitration and in the relevant national patent law**. After the exchange of written submissions, the tribunal held a one-day hearing in Geneva for further statements and for the examination of expert witnesses. In accordance with the time schedule agreed by the parties, the **final award was rendered within five months** of the commencement of the arbitration.

Recommended WIPO arbitration clause

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 referred to and finally determined¹ by arbitration in accordance with the WIPO Arbitration Rules. The arbitral tribunal shall consist of [a sole arbitrator][three arbitrators].² The place of arbitration shall be [specify place].³ The language to be used in the arbitral proceedings shall be [specify language].⁴ The dispute, controversy or claim shall be decided in accordance with the law of [specify jurisdiction].⁵

- 1 The appointed arbitral tribunal has the authority to render a final award. Such award is binding on the parties and enforceable internationally. However, parties retain the option to settle the dispute before an award is issued.
- 2 When deciding whether to appoint one or three arbitrators, parties weigh considerations of cost and efficiency against the value and complexity of the dispute. Under the WIPO Expedited Arbitration Rules the arbitral tribunal consists of a sole arbitrator.
- 3 The choice of “place of arbitration” determines the law that regulates the procedural framework of the case, such as the availability of interim measures of protection and the enforceability of the award. Regardless of their chosen place of arbitration, the parties may hold meetings or hearings anywhere in the world, at the convenience of parties, arbitrator(s) and witnesses.
- 4 The parties can choose any language that suits them.
- 5 The parties are encouraged to choose the substantive law, i.e., the law under which the arbitral tribunal decides the dispute.

Why WIPO Arbitration?

When parties choose the WIPO Center, they benefit from a number of **advantages**:

- an **internationally based, independent arbitration institution** focused on IP and technology disputes;
- an **international list of arbitrators** including professionals with **specific knowledge and experience** in the technical, business and legal subject matter of IP as well as experience in international commercial arbitration;
- **flexible Rules** designed to protect confidentiality and trade secrets;
- a **moderate administration fee**; and
- **meeting rooms** provided free of charge for arbitrations held in Geneva.

Role of the WIPO Center

The principal aim of the WIPO Center is to **help parties achieve rapid and cost-effective** resolution of their IP and technology disputes. To this end, the WIPO Center actively:

- **helps the parties submit** disputes to WIPO ADR procedures;
- **assists in the parties' choice of specialized arbitrator(s)** from the WIPO Center's international list or elsewhere;
- **sets the fees of the arbitrator(s)**, in close consultation with the parties and the arbitrator(s), and administers the financial aspects of the proceedings;
- **liaises with the parties and the arbitrator(s)** throughout the case to ensure optimal communication and procedural efficiency; and
- **arranges for desired support services**, including meeting facilities.

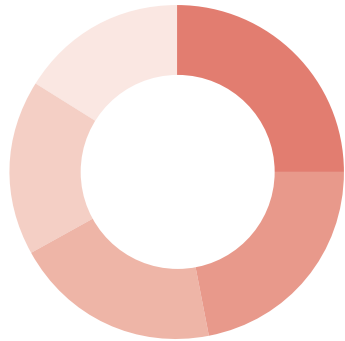
Flexible procedural framework

The WIPO Arbitration and Expedited Arbitration Rules **combine legal certainty with practical flexibility**. The procedural framework can be amended by party agreement, and the arbitral tribunal conducts the proceedings in consultation with the parties without bureaucratic intervention or time-consuming formalities.

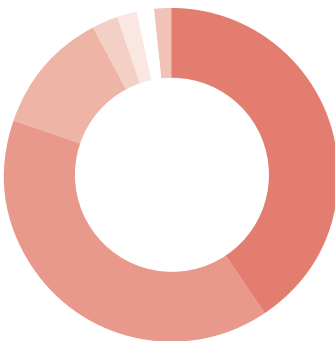
WIPO case experience

Arbitrators deal with a wide variety of subject matter under the WIPO Arbitration and Expedited Arbitration Rules. WIPO arbitrations have involved patents, trademarks, ICT, copyright, entertainment, and more general commercial matters such as franchising and distribution.

Types of disputes in WIPO cases



WIPO ADR users



- 41% SME
- 40% Large-sized Company
- 12% Other
- 2% Individual
- 2% CMO
- 2% University
- 1% R&D Center

- **Patents 25%**
Cross-licensing, Infringements, Licenses, Ownership, Patent Pools, R&D / Tech Transfer, Royalty Payment
- **ICT 22%**
Mobile Apps, Outsourcing, Systems Integration, Software Development, Software Licensing, Telecommunications
- **Trademarks 20%**
Coexistence, Infringements, Licenses, Oppositions, Revocations
- **Commercial 20%**
Distribution, Energy, Franchising, Marketing, Sports
- **Copyright 13%**
Art, Broadcasting, Entertainment, Film and Media, Infringements, TV Formats

Where does a WIPO arbitration take place?

The parties are free to decide where their arbitration meetings or hearings take place, often for their convenience as well as that of the arbitrators and witnesses. This is true regardless of the chosen legal place of arbitration, which is not necessarily linked to the physical location of the proceedings.

If the parties do decide to conduct their arbitration in Geneva, WIPO will provide them with meeting and party retiring rooms free of charge (that is, at no additional cost to the administration fee payable to the WIPO Center). If the parties choose to conduct their arbitration in a different location, the WIPO Center can assist them in arranging suitable meeting facilities.

The parties and the arbitrator(s) are always free to make use of WIPO's online case administration tools – including a secure electronic docket (eADR) and videoconferencing facilities, free of charge.

WIPO online case administration tools

The WIPO Center makes available at no cost to interested parties online case administration options, including WIPO eADR and videoconferencing facilities.

WIPO eADR

WIPO eADR allows parties, their legal representative(s), the arbitrator(s) and any witnesses and experts in a WIPO case to securely submit communications electronically into an online case file. Users receive email alerts of any such submission being made and may access and search the casefile online at any time. All case information filed in WIPO eADR is protected to ensure confidentiality.

How much does a WIPO arbitration cost?

While a well-managed arbitration offers cost advantages over court litigation, certain fees are payable in an arbitration:

- the **registration and administration fees** of the WIPO Center; and
- the fees of the **arbitrator(s)**. These are negotiated when the arbitrator(s) is appointed, usually calculated on an hourly rate that takes into account the circumstances of the dispute such as its complexity and value, as well as the experience of the arbitrator(s) and the location of the parties.

For the arbitrator’s fees, the **Schedule of Fees** to the WIPO Arbitration Rules and the WIPO Expedited Arbitration Rules sets out indicative rates, and for expedited arbitration fixed fees, as in the table below.

To learn more about specific fees for WIPO Arbitration and WIPO Expedited Arbitration, parties may also use the online **WIPO Fee Calculator** available at www.wipo.int/amc/en/calculator/adr.jsp.

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

Full fee schedule available online at www.wipo.int/amc/en/arbitration/fees/index.html

How it works: The principal steps in a WIPO arbitration

Within the framework of the WIPO Rules, the **process, rights and obligations in a WIPO arbitration case** are determined by the tribunal together with the parties, supported by the WIPO Center. The following section of this Guide broadly follows the WIPO Arbitration Rules, whereby most of this guidance also covers cases under the WIPO Expedited Arbitration Rules, with the principal exceptions summarized on pages 10-11.

1 Commencing the arbitration process

A WIPO arbitration is commenced by the claimant submitting to the WIPO Center a **Request for Arbitration**. Information concerning such submission is set out in the WIPO Arbitration Case Filing Guidelines at www.wipo.int/amc/en/arbitration/filing/#request.

The date of commencement of the arbitration is the date on which the Request is received by the WIPO Center. The Request should contain **summary details** concerning the dispute, including the names and communication details of the parties and their representatives, a copy of the arbitration agreement, a brief description of the dispute, the relief sought, and any requests

or observations relating to the appointment of the tribunal.

A comprehensive statement of facts and legal arguments, including a full statement of the relief sought, may be left to the Statement of Claim to be filed after the appointment of the tribunal.

Within 30 days of receipt of the Request for Arbitration, the respondent must file an **Answer to the Request**, which should contain **comments** on elements of the Request for Arbitration and may include indications of a counter-claim or set-off. If the claimant filed its Statement of Claim with the Request for Arbitration, the Answer to the Request may also be accompanied by the Statement of Defense (*Articles 6-13*).

Protection of personal data

The WIPO Center collects, processes and stores personal data of arbitral participants only to the extent necessary for the administration of proceedings under the WIPO Rules. The WIPO Center encourages tribunals to raise the protection of personal data with the parties as appropriate. Further information is included in the WIPO Arbitration Case Filing Guidelines at www.wipo.int/amc/en/arbitration/filing/index.html.

2 How are WIPO arbitrators appointed?

The choice and appointment of the tribunal is a crucial step in an arbitration. Under the WIPO Rules, **parties have broad autonomy** in the appointment process and can agree on such issues as:

- the appointment procedure;
- the **number** of arbitrators to be appointed;
- any specific required **qualifications** of the arbitrators, including as to nationality; and
- the **person(s)** to be appointed as arbitrators (regardless of whether they are on the WIPO List of Arbitrators).

Where the parties fail to reach an agreement by the applicable deadline, the WIPO Center will make the necessary determination by default.

The WIPO List

An important part of the WIPO Center's role is to ensure that the parties have the **right arbitrator(s)** to expeditiously conduct the arbitration and help achieve the right outcome.

Irrespective of the appointment process which they have chosen, parties to arbitrations administered by the WIPO Center benefit from **WIPO's List of Arbitrators**, with expertise covering the full IP and technology spectrum. Parties to a WIPO case are not limited to choosing an arbitrator(s) from the WIPO List and remain free to agree to appoint another arbitrator(s) of their choice.

The next pages of this guide explain in more detail the various appointment options and procedures under the WIPO Rules.

How many arbitrators should be appointed?

In order to avoid decision deadlocks, the arbitral tribunal will consist of either **one or three** arbitrators. When choosing between these two options, parties should **weigh considerations of cost and efficiency, noting also the value and complexity of the dispute.**

Where the parties have not determined the number of arbitrators, the WIPO Arbitration Rules provide that the tribunal shall consist of a sole arbitrator.

Where the parties have adopted the WIPO Expedited Arbitration Rules, Article 14 provides that a sole arbitrator be appointed.

Appointment of sole arbitrator

A sole arbitrator is to be nominated **jointly** by the parties. In the absence of such agreement, appointment will be made in accordance with the so-called **list procedure** described in Article 19 of the WIPO Arbitration Rules.

Appointment of three-member tribunal

Typically, a two-step process will be followed:

First, each party is required to appoint **one arbitrator** (*Article 17(b)*). The two arbitrators thus appointed shall jointly appoint the **presiding arbitrator**. If the presiding arbitrator is not appointed within 20 days, appointment will be made in accordance with the list procedure. Article 18 contains special appointment provisions for cases involving multiple claimants or respondents.

Appointment of the arbitrator where the list procedure applies

The WIPO Center sends a **shortlist of potential candidates** to each party, with detailed profiles setting out their qualifications. Each party may delete names of candidates it objects to and rank the remaining candidates in the order of preference.

The **rankings** must be returned to the WIPO Center within 20 days, failing which all candidates are deemed acceptable.

The WIPO Center makes the appointment from **the shortlist, taking into account** the preferences and objections expressed by the parties.

3 How is the impartiality and independence of WIPO arbitrators safeguarded?

The WIPO Center places great value on the professional integrity of its arbitrators. Under the WIPO Arbitration Rules, Article 22, each arbitrator, including any party-appointed arbitrator, is required to be **impartial and independent**.

A prospective arbitrator must, before accepting appointment, disclose any matter that might give the appearance of partiality or lack of independence, and this **disclosure duty** continues throughout the course of the arbitration.

In this connection, the WIPO Center encourages parties to disclose also the identity of any third party having an interest in the outcome of the dispute. The WIPO Arbitration Case Filing Guidelines provide further information at www.wipo.int/amc/en/arbitration/filing/#pd.

If at any stage during the arbitration circumstances arise that give rise to justifiable doubts as to an arbitrator's impartiality or independence, either party may **challenge** the arbitrator. While in the WIPO Center's caseload such challenges have been rare, the WIPO Rules contain provisions to deal with this subject.

4 What are the powers of the tribunal?

Article 37 of the WIPO Arbitration Rules gives broad powers to the tribunal to “conduct the arbitration in such manner as it considers appropriate.”

Article 37(b) and (c) of the WIPO Arbitration Rules provides guidance for the exercise of this authority. The tribunal must respect **due process** and ensure each party is given a fair opportunity to present its case, leading to an enforceable award. At the same time, the tribunal shall ensure that the arbitral procedure takes place with **due expedition**.

Certain powers of the tribunal are explicitly listed in the WIPO Arbitration Rules, including:

- to hear and determine objections to its own **jurisdiction**, and to determine the **existence or validity** of any contract of which the arbitration agreement forms part (*Article 36(a) and (b)*)
- to organize a preparatory conference (*Article 40*), to set the **schedule** of the proceedings, to extend **deadlines** (*Article 37(c)*), to allow or require further written statements (*Article 43*), to accept amendments to claims or defenses (*Article 44*)
- to order the **joinder** of an additional party to the arbitration (*Article 46*), or to **consolidate** a new arbitration with a pending

proceeding (provided all parties and any appointed tribunal agree) (*Article 47*)

- to order **interim measures**, including injunctions (*Article 48*)
- to determine the **admissibility and relevance of evidence**, and to order a party to produce documents or other pieces of evidence (*Article 50*)
- to classify certain information as **confidential** (*Article 54*)
- to hold **hearings** (*Article 55*)
- to render a final binding **award** (*Articles 61 et seq.*)

WIPO Case – Jurisdiction

In a WIPO Arbitration involving patents and trademarks protected in several countries, the **claimant raised a jurisdictional objection** concerning a counterclaim to withdraw trademark opposition proceedings. The claimant argued that such a counterclaim was not covered by the arbitration agreement in the license agreement. Pursuant to Article 36(a) of the WIPO Arbitration Rules, the three-member tribunal issued a **partial award confirming** its jurisdiction to decide this counterclaim.

5 Conducting the arbitration

The **Statement of Claim** must be filed within 30 days of the establishment of the tribunal and the **Statement of Defense** must be filed within 30 days of receipt of the Statement of Claim.

The tribunal may schedule further submissions. Soon after it has been established, the tribunal will hold **preparatory discussions** on, inter alia, case schedule, hearing dates, evidence and confidentiality stipulations (*Articles 40-48*). In most cases, a **hearing** is held for the presentation of evidence. If the parties and tribunal agree, the hearing may also be held through **online means of communication**. If no hearing is held, the proceedings are conducted based on the documents and other evidence (*Articles 55-57*).

6 Evidence in WIPO Arbitration proceedings

The tribunal has **broad powers** to determine the admissibility, relevance, materiality and weight of evidence before it (*Article 50*).

In order to facilitate the taking of technical evidence, the WIPO Arbitration Rules include **specific provisions** on certain types of evidence, such as experiments (*Article 51*), site visits (*Article 52*), or agreed primers and models (*Article 53*).

WIPO Case – Consolidation

A European game software developer concluded **three separate online license agreements with several licensees** based in South America and Europe. The licensees jointly submitted a request for Arbitration under the WIPO Expedited Arbitration Rules, claiming breach of contract and defects of the software. On the same day, the game software developer submitted three requests for expedited arbitration against each respective licensee, claiming damages for breach of contract. Given the common subject matter between the four arbitrations, and following consultations with the WIPO Center and the appointed sole arbitrator, the **parties agreed to consolidate all claims** into one set of proceedings. (*Article 41 WIPO Expedited Arbitration Rules*)

7 Multiparty proceedings

Not infrequently, WIPO arbitrations and expedited arbitrations involve multiple claimants and/or respondents. Several provisions of the **WIPO Rules** address such scenarios, including the method of appointment of three arbitrators where agreed in case of multiple claimants or respondents (*Article 18*), the joinder of additional parties (*Article 46*), and the consolidation of arbitration proceedings (*Article 47*). Any order of **joinder or consolidation requires prior agreement by all parties**, and takes into account the stage reached in the arbitration proceedings.

8 How is confidentiality maintained in a WIPO arbitration?

IP and technology disputes often turn on **sensitive technical or business information**. The WIPO Rules offer a comprehensive treatment of all aspects of confidentiality (*Articles 75-78*), including:

- the **existence** of the arbitration as such;
- any **disclosures** made during the arbitration; and
- the **award**.

In addition, the WIPO Rules specifically address the **protection of trade secrets** and vest tribunals with a broad range of powers to deal with party requests for protective orders of specific information being submitted in the proceedings (*Article 54*).

WIPO Case – Protective Order

A Chinese inventor filed a request for arbitration against a US sports manufacturer concerning payment of royalties under their patent license agreement. During the evidentiary phase, the US manufacturer alleged that there was a risk that the inventor could be negotiating a license with one of its competitors. Pursuant to Article 54 of the WIPO Arbitration Rules, the **sole arbitrator issued a protective order** to prevent the inventor's access to certain documents disclosing the US manufacturer's trade secrets. The protective order covered designation of confidential information; restriction on disclosure of so-designated information to certain persons and entities; cancellation of designation; and disposition of designated materials after the termination of the proceedings.

9 Is interim relief or emergency relief available?

The availability of interim relief can be important in IP and technology disputes. Under the WIPO Rules, the tribunal can issue any provisional orders or take other interim measures **it deems necessary at the request of a party**. In WIPO cases, tribunals with some regularity address such requests for interim relief. As examples, the WIPO Rules mention injunctions and measures for the conservation of goods. The tribunal may require the requesting party to furnish appropriate security as a condition for granting the interim relief.

In some situations, interim relief from an arbitral tribunal may not be available or sufficient. This would be the case where the need for interim relief arises before the tribunal has been appointed, or where such relief involves third parties not subject to the tribunal's authority. The WIPO Rules clarify that a party has the right to request interim relief from a **national court** at any time and that such requests shall not be deemed incompatible with the arbitration agreement.

Prior to the establishment of the arbitral tribunal, instead of approaching a court, **parties may call upon a WIPO emergency relief procedure**, for decision by a separate arbitrator specifically appointed for this initial purpose (*Article 49*).

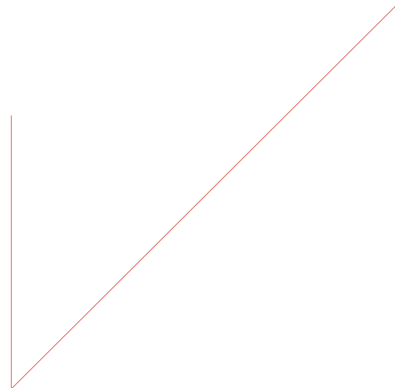
WIPO Case – Interim Relief

A Dutch and a Swiss company had concluded a **trademark license agreement** for distribution of fashion goods in several European countries. When a dispute ensued regarding the alleged unlawful termination of the contract, the Swiss company filed a request for WIPO Expedited Arbitration. After the appointment of the sole arbitrator, **both parties requested interim measures** concerning goods in stock and continuing use of the trademark. The arbitrator ordered a provisional restriction on the use of the trademark, as well as measures for the conservation of the stock.

10 Closure of proceedings

When the tribunal considers that the parties have had adequate opportunity to present submissions and evidence, it will declare the proceedings closed. This should happen **within nine months** of either the delivery of the Statement of Defense or the establishment of the tribunal, whichever occurs later.

The **final award** should be delivered by the tribunal **within three months** of the closure of the proceedings.



11 Settlement

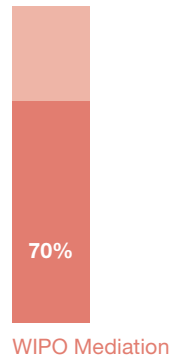
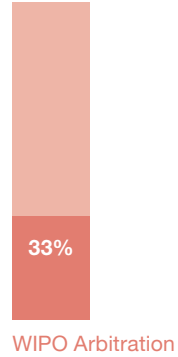
Parties who have reached a settlement in the course of an arbitration, including through mediation, may wish to have the terms of their settlement confirmed in the form of a “**consent award**”, which will be easier to **enforce** than a contract between the parties. Article 67 of the WIPO Arbitration Rules expressly recognizes and facilitates this option.

Settlement rate in WIPO cases

Typically, some 30 percent of WIPO **arbitration cases** are resolved by party settlement, while some 70 percent proceed to an arbitral award.

Where there is an **agreement to use WIPO Mediation**, the typical settlement rate is 70 percent.

Parties whose goal is to settle disputes between them may choose to use WIPO Mediation, followed in the absence of settlement, by WIPO Arbitration.

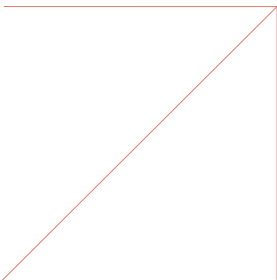


12 Remedies

As a general matter, subject to the respective claims requested by the parties, the tribunal can grant the remedies that are provided for under the law applicable to the substance of the dispute.

In WIPO arbitrations, remedies awarded by tribunals have included:

- monetary compensation, including **damages**, interest (*Article 62*), and costs (*Articles 73 and 74*);
- **injunctions**;
- **declaratory relief**; and
- **specific performance**.



Can an award be appealed?

Under Article 66, an arbitral award is deemed to be final. Such **finality** is generally perceived as **one of the advantages** of arbitration.

A party can challenge the award in the courts at the place of arbitration in order to have the award declared invalid, or “set aside.” However, under the arbitral laws of most countries, the possibility of setting aside an award is limited to certain **narrowly defined grounds**. Most national laws do not foresee an appeal on the merits.

Implementing an arbitral award

Most WIPO arbitral awards are implemented **voluntarily**. Where legal enforcement proves necessary, parties need to have recourse to a national court in the jurisdiction where they wish the award to be enforced. For foreign arbitral awards, i.e., awards sought to be enforced in a state other than the state of the place of arbitration, parties can rely on the **New York Convention**, which is enforced by more than 160 states worldwide. As such, this Convention provides a **unique advantage** for resolving disputes through arbitration by comparison to court litigation.

The text of the New York Convention, as well as a current list of its contracting parties, is available at www.uncitral.org/uncitral/en/uncitral_texts/arbitration/NYConvention_status.html.

WIPO Good Offices

The WIPO Center regularly provides **procedural guidance** to parties in order to **facilitate direct settlement** of a dispute existing between them or to **facilitate submission** of such dispute to WIPO Mediation, Expedited Arbitration or Arbitration.

Parties should call or contact the WIPO Center with any queries on Good Offices assistance through arbiter. mail@wipo.int or using the online form available at www.wipo.int/amc-forms/adr/good-offices-services.



WIPO Domain Name Dispute Resolution

The WIPO Center offers a **special procedure** that allows trademark owners to resolve cases of **abusive domain name registration and use** (“cybersquatting”). The WIPO Center is the **leading global provider** under the **WIPO-initiated Uniform Domain Name Dispute Resolution Policy (UDRP)**.

To assist their case preparation, WIPO parties can take free advantage of the online WIPO Jurisprudential Overview and the WIPO Legal Index, in addition to model filing forms. Proceedings are **conducted online** and are normally completed **within two months**, with **outcomes directly implemented** by domain registrars.

More on WIPO Domain Name
Dispute Resolution:

wipo.int/amc/en/domains



WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”)

(including additional filing resources)

WIPO Arbitration and Mediation Center
34, chemin des Colombettes
CH-1211 Geneva 20
Switzerland
T + 41 22 338 82 47
www.wipo.int/amc
arbitr.mail@wipo.int

© World Intellectual Property Organization – 2017
All Rights Reserved

Parties interested in
WIPO Arbitration and
WIPO Expedited Arbitration
may visit
wipo.int/amc/en/arbitration

Parties interested in direct
assistance on case filing,
dispute resolution clause
drafting or another ADR
matter may contact the
WIPO Center at
+41 22 338 8247 or
arbiter.mail@wipo.int



For more information contact

**WIPO Arbitration and
Mediation Center (Geneva)**

34, chemin des Colombettes
CH-1211 Geneva 20
Switzerland
Tel +4122 338 82 47
Fax +4122 338 83 37

**WIPO Arbitration and
Mediation Center (Singapore)**

Maxwell Chambers Suites
28 Maxwell Road #02-14
Singapore 069120
Tel +65 6225 2129
Fax +65 6225 3568

www.wipo.int/amc
arbiter.mail@wipo.int

© WIPO, 2020



Attribution 3.0 IGO (CC BY 3.0 IGO)

The CC license does not apply to
non-WIPO content in this publication.

Printed in Switzerland

WIPO Publication No. 919E/2020
ISBN 978-92-805-3199-2