

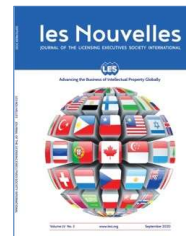


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Who is LESI?

The **Licensing Executives Society International (LESI)** is a global association, established in 1973, of 33 national and regional Member Societies, in more than 90 countries, serving more than 6500 individuals.

- A global network of businesses and professionals for **50 years**
- Creating, protecting, and commercializing innovation, and managing and monetizing IP
- Business leaders, IP managers, licensing executives, financiers, licensing companies, brokers
- Experts in law, valuation, protection, transfer, and enforcement of IP
- Advancing the business of intellectual property



LESI Board of Directors 2022-23

LESI: Advancing the Business of Intellectual Property Globally

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LES
thought LEADERS

TRACK 1
SEPs
STANDARD ESSENTIAL PATENTS

TRACK 2
AUTOMOTIVE

TRACK 3
MEDIATION & ARBITRATION

LESI Thought Leadership Program
2023-2023
lesi.org/thoughtleadership

- A professional learning series, providing a “deep dive” on three topical tracks starting leading up to LESI2023 in Montreal. Organized and facilitated by licensing industry experts and allowing LESI to lead and inform business conversations related to intellectual property policy.

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Speakers

- **Dana Robert Colarulli**
LESI
- **Adam Rattray**
WIPO
- **Tillman Mueller-Stoy**
Bardehle Pagnberg

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MEDIATION & ARBITRATION

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Agenda

- Introduction of this course and upcoming sessions
- Overview of ADR and what Interesting in the Courts
- Q&A



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Dispute resolution options

- Negotiation
 - Litigation
 - Alternative Dispute Resolution (ADR)
 - Mediation
 - Arbitration

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Mediation

- Informal consensual process
- Neutral intermediary – mediator
 - assists parties in reaching settlement of their dispute
 - based on parties' respective interests
 - cannot impose a decision
- Settlement agreement has force of a contract
- Leaves open court or arbitration options



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Arbitration

- Consensual procedure
- Parties submit dispute to one or more chosen arbitrators
- Binding and final decision (award)
 - based on parties' rights and obligations
 - enforceable internationally
- Normally forecloses court options



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Why ADR for IP and Tech Disputes?

- Cost and duration of court litigation
- Internationalization of creation and use of IP
- Technical and specialized nature of IP
- Confidential nature of IP
- Enforceability
- Collaborative nature of IP creation and commercialization



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Pre-empting and Resolving Technology, Media and Telecoms Disputes



International Dispute Resolution Survey

- 75% of organizations surveyed have a dispute resolution policy
 - Mediation is the most encouraged mechanism, followed by arbitration
 - The three most important elements of arbitration are: institution, seat, and confidentiality
- 92% of respondents consider arbitration well suited to TMT disputes
- 82% of respondents foresee an increase in the use of arbitration
- Respondents expect ownership of IP and licensing of technology to continue to be a likely source of disputes

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WIPO Model Clauses

Recommended WIPO Contract Clauses and Submission Agreements

Referral to WIPO dispute resolution procedures is consensual. To facilitate party agreement, the WIPO Center provides recommended contract clauses (for the submission of future disputes under a particular contract) and submission agreements (for existing disputes, including those referred by courts).

[WIPO Clause Generator](#)

[Drafting Efficient Dispute Resolution Clauses](#)

Recommended WIPO Contract Clauses and Submission Agreements:

- Mediation
- Arbitration
- Expedited Arbitration
- Expert Determination
- Mediation followed, in the absence of a settlement, by [expedited] arbitration
- Mediation followed, in the absence of a settlement, by expert determination
- Mediation followed, in the absence of a settlement, by court litigation
- Expert determination, binding unless followed by [expedited] arbitration

The recommended WIPO contract clauses and submission agreements are also available in Chinese, French, German, Greek, Japanese, Korean, Portuguese and Spanish.

To assist parties in the drafting of clauses and submission agreements, the WIPO Center makes available the WIPO Clause Generator.

[WIPO ADR Options](#)

If you need further assistance when drafting your clause, you can contact us by email at arbitrator.mail@wipo.int or by phone at +41 22 338 8247.

www.wipo.int/amc/en/clauses

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WIPO
WORLD INTELLECTUAL PROPERTY ORGANIZATION

Home | IP Services | Alternative Dispute Resolution | WIPO Clause Generator

WIPO | ADR

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.

The place of mediation shall be .

Core Elements

Place of Mediation

Language of the Mediation

Duration of the Mediation Proceedings

Additional Elements

Qualifications of the Mediator

Conduct of the Mediation

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

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].

Step 4 – Download or copy the final result

www.wipo.int/amc-apps/clause-generator

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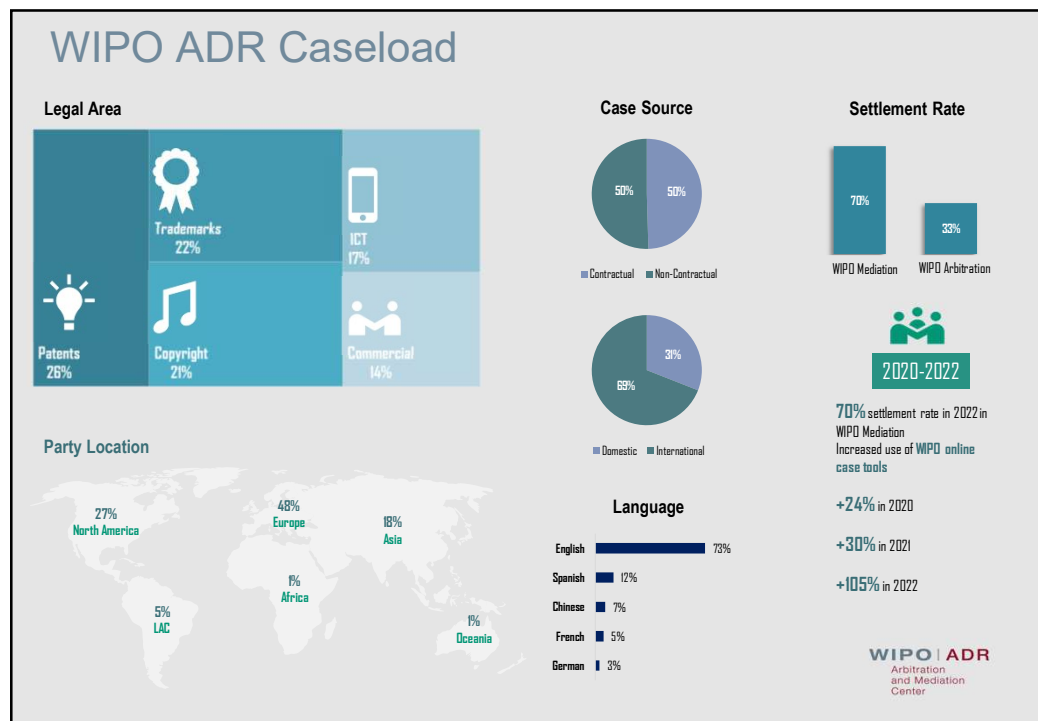
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WIPO Arbitration and Mediation Center

- Mediation, arbitration, expert determination, and domain name dispute resolution
- Specialized in IP disputes
- WIPO mediators, arbitrators and experts experienced in IP - able to deliver informed results efficiently
- International neutrality



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Role of the WIPO Center

- Procedural assistance
 - Information and guidance on ADR
 - Drafting ADR clauses and submission agreements

- Administering cases
 - Containing time and costs
 - WIPO eADR and **online tools**

- Assisting selection and appointment of mediators and arbitrators; negotiating fees
 - 2,000+ WIPO experts from all regions
 - Specialized in IP and technology

WIPO ADR Rules (2021)

- **IP and technology specific elements**
 - e.g., confidentiality, technical evidence, interim relief
- **Applicable to all commercial disputes**
- Flexibility
 - Pre-structure entire proceeding
 - For most part can be modified by arrangement between mediator or arbitrator and parties
- For domestic and international disputes
- Singapore Mediation Convention
- Electronic filings and online conduct of WIPO ADR proceedings

WIPO Mediation,
Arbitration,
Expedited Arbitration
and Expert
Determination Rules
and Clauses

Alternative Dispute Resolution

A WIPO Online Mediation of a Software License Dispute

Parties European software developer and European customer

Contract Software licensing agreement

Dispute Non-execution of the agreement and related damages claims

Basis Contract clause providing for WIPO Mediation followed by court litigation

Process Mediator with experience in IT/technology cases (WIPO list procedure)

Mediation sessions took place entirely online with live interpretation (French and German) via WIPO-hosted platform

Result Settlement agreement within five months

A WIPO Arbitration of a Biotech Dispute

Parties European biotech company and North American pharmaceutical company

Contract Development and license and agreement

Dispute Alleged deliberate delay in the development of the biotech compound

Basis Contract clause providing for WIPO Arbitration with sole arbitrator

Process The Center proposed a number of candidates with expertise of biotech/pharma disputes, one of whom was chosen by the parties

Arbitrator held a three-day hearing for the examination of witnesses. On the last day of the hearing, the parties accepted the arbitrator's suggestion that they hold a private meeting

Result Parties settled their dispute and continued to cooperate towards the development and commercialization of the biotech compound

A WIPO Arbitration of a Patent Infringement Dispute

Parties	Two North American companies
Contract	Submission Agreement to WIPO Arbitration
Dispute	Patent infringement dispute related to a European patent in the area of consumer goods; litigation in several jurisdictions
Process	Three-member arbitral tribunal Detailed procedural and hearing schedule Amendments of WIPO Rules: e.g. shortened timelines and detailed provision on experiments One-day hearing in Geneva including witness statements
Result	Final award rendered within five months of the commencement of the arbitration

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More on WIPO Mediation

- Guide to WIPO Mediation

www.wipo.int/publications/en/details.jsp?id=4383

- WIPO Mediation Rules

www.wipo.int/amc/en/mediation/rules

- WIPO Mediation case examples

www.wipo.int/amc/en/mediation/case-example.html

- General information on mediation

www.wipo.int/amc/en/mediation

Guide to WIPO Mediation



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More on WIPO Arbitration

- Guide to WIPO Arbitration
www.wipo.int/publications/en/details.jsp?id=4527
- WIPO Arbitration Rules
www.wipo.int/amc/en/arbitration/rules/index.html
- WIPO Expedited Arbitration Rules
www.wipo.int/amc/en/arbitration/expedited-rules/
- WIPO Arbitration case examples
www.wipo.int/amc/en/arbitration/case-example.html
- Commentary on WIPO Arbitration Rules
www.wipo.int/export/sites/www/amc/en/docs/2017commentrulesarb.pdf
- General information on arbitration
www.wipo.int/amc/en/arbitration

Guide to WIPO Arbitration





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Contact Us

- Queries: arbiter.mail@wipo.int
- Further information: www.wipo.int/amc
- [WIPO Center LinkedIn](#)
- [WIPO Center Newsletter](#)
- [WIPO Center Webinars](#)

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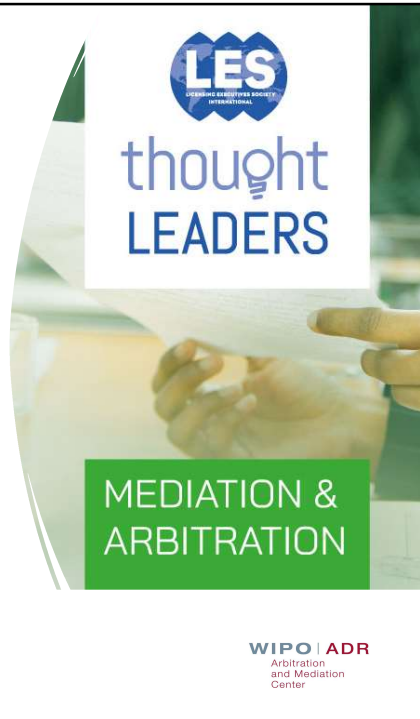
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ORGANIZED BY LES USA-CANADA 30 APRIL-2 MAY

LES Virtual Annual Conference
MAY 27-28
26-Hour Marathon
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FUTURE INNOVATION
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Benefits

- 1. Connection and access to a global community of businesses and experienced professionals**
Leaders in every industry, in every legal speciality throughout the world
- 2. Education on best practices growing revenue, profit, value, cash flow through IP**
Creating, protecting, and commercializing innovation, and managing and monetizing IP
- 3. Access to a full spectrum of member activities and perspectives**
Education and support for your day job in business and university environments
- 4. Access to numerous resources**
Tool kits, industry and professional committees, education, mentoring, royalty rate and deal term surveys
- 5. Part of a community devoted to thought-leadership, public service, inclusion, diversity, and equity in the business of IP for nearly 50 years**



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