

# Key trends related to IP & Technology disputes

- Rise of out-of-court dispute resolution mechanisms
- Growth in cross-border TMT disputes
- Increase in adoption of mandatory mediation clauses
- Growth in usage of remote mediation techniques (ODR)



SINGAPORE INTERNATIONAL  
MEDIATION CENTRE



WIPO | ADR  
Arbitration  
and Mediation  
Center



# ■ WIPO Mediation and Arbitration for Intellectual Property and Technology Disputes

WIPO-SIMC Webinar: Recent Developments in Mediation for IP and Technology Disputes

October 27, 2020

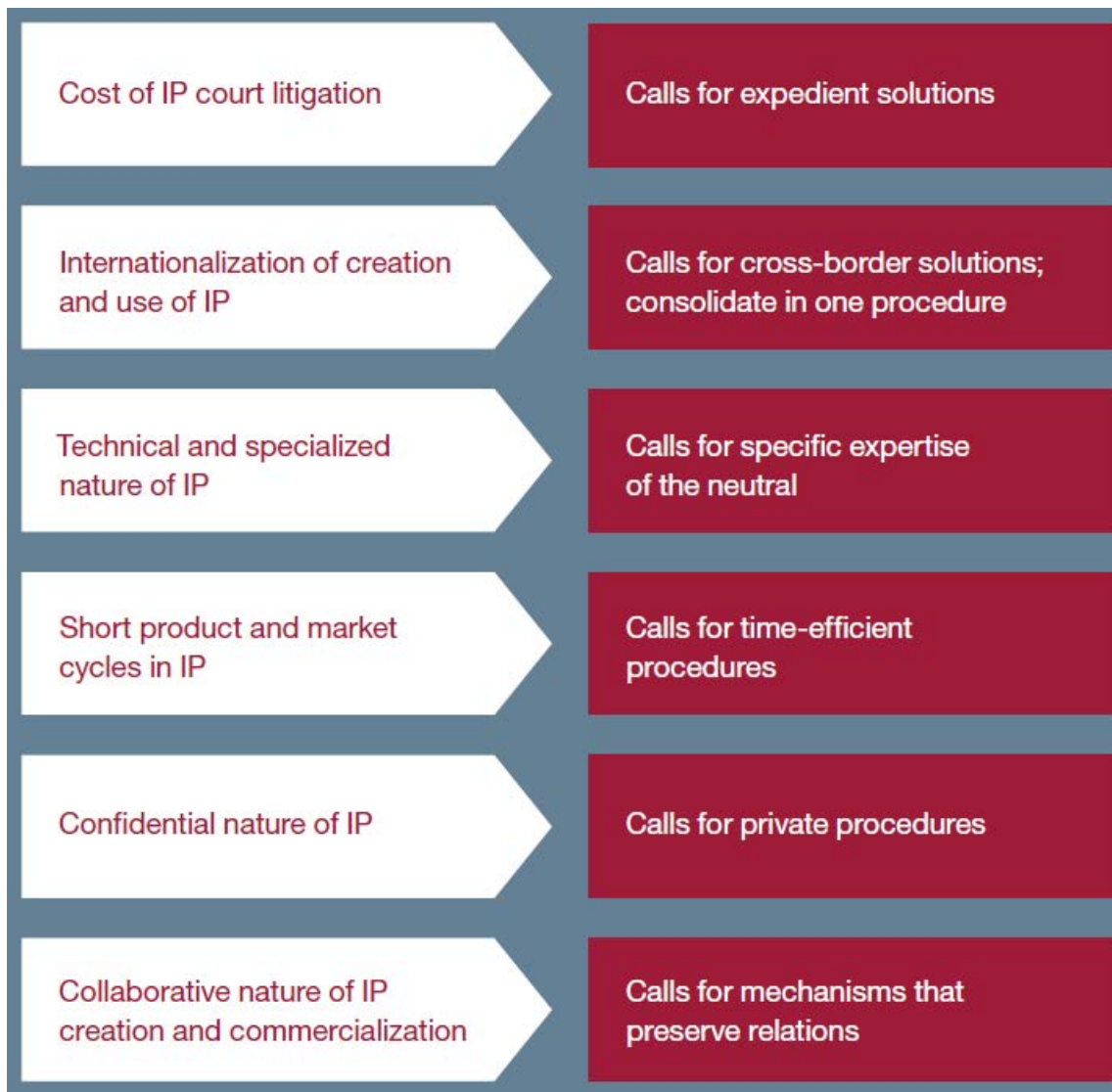
Ignacio de Castro  
Chiara Accornero  
WIPO Arbitration and Mediation Center

# 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



# Why ADR for IP and technology disputes?



# WIPO Caseload

## Copyright

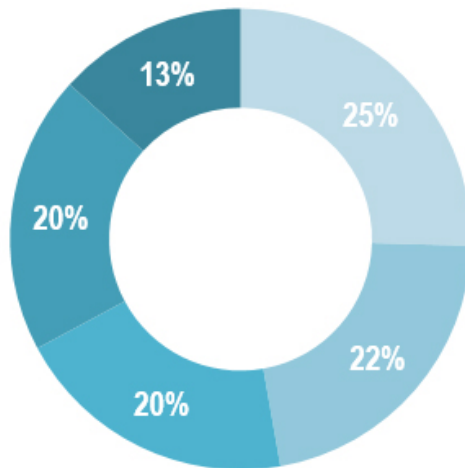
Art  
Broadcasting  
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Infringements  
TV Formats

## Commercial

Design  
Distribution  
Energy  
Franchising  
Marketing  
Sports

## Trademarks

Coexistence  
Infringements  
Licenses  
Oppositions  
Revocations



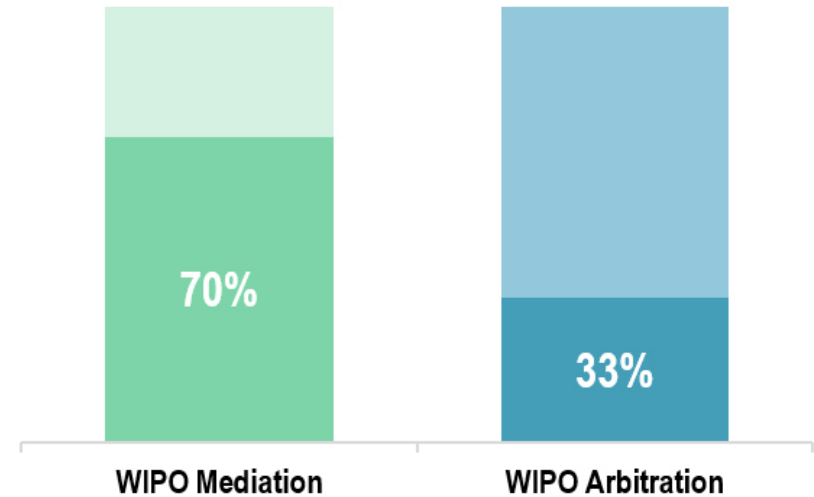
## Patents

Cross-licensing  
Infringements  
Licenses  
Ownership  
Patent Pools  
R&D / Tech  
Transfer  
Royalty Payment

## ICT

Mobile Apps  
Outsourcing  
Systems Integration  
Software Development  
Software Licensing  
Telecommunications


## Settlement rates



■ **2020: 85,7% settlement rate in WIPO Mediation**

# 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



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## WIPO Checklist for the Online Conduct of Mediation and Arbitration Proceedings

### Preliminary Considerations

**1) Do the WIPO Mediation, Arbitration and Expedited Arbitration Rules (WIPO Rules) address the online conduct of proceedings?**

Yes, the WIPO Rules allow parties, mediators and arbitrators to conduct proceedings online as appropriate (Article 10 [WIPO Mediation Rules](#), Article 37(a) [WIPO Arbitration Rules](#), Article 31 (a) [WIPO Expedited Arbitration Rules](#)). In addition, mediators and arbitrators have the duty to ensure that proceedings take place with due expedition (Article 11 [WIPO Mediation Rules](#), Article 37(c) [WIPO Arbitration Rules](#), Article 31(c) [WIPO Expedited Arbitration Rules](#)). In the WIPO Center's case experience, this has included the online conduct of mediation meetings and arbitration hearings.

Pursuant to Article 40 [WIPO Arbitration Rules](#)/Art. 34 [WIPO Expedited Arbitration Rules](#), the preparatory conference can be held in any format; in practice, it normally is conducted via telephone, videoconference, or increasingly using online tools.

**2) Is it possible to conduct WIPO Mediation and Arbitration proceedings in a hybrid format?**

Yes, the WIPO Center has administered some proceedings where some parties, mediators, or arbitrators participated in meetings or hearings in-person while others joined through online tools.

### Choice of Online Platform

**3) Are parties, mediators and arbitrators in WIPO proceedings free to choose the online platform they wish to use for their proceedings?**

Yes, parties, mediators and arbitrators are free to agree on the online platform(s) they wish to use. In WIPO mediations and arbitrations, this has included the use of WebEx, Zoom, Teams, Bluejeans, WhatsApp, and Skype for Business.

■ <https://www.wipo.int/amc/en/eadr/checklist/index.html>



# WIPO – SIMC: Recent Developments in Mediation for IP and Technology Disputes

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George Lim SC, Chairman  
Singapore International Mediation Centre  
27 October 2020



A close-up photograph of a person's hands interacting with a silver laptop. The left hand is pointing at the screen, while the right hand is on the trackpad. The person is wearing a black smartwatch on their left wrist and a ring on their right ring finger. The background is blurred, showing an office environment.

## A case study on an international IP dispute

新加坡国际调解中心 中国国际贸易促进委员会调解中心

### 备忘录签署仪式 MOU Signing Ceremony



MOU with CCPIT Mediation Center (Jan 2019)



Beijing Specialist Mediators' Training (Jan 2019)



China's Chief Justice Zhou Qiang



MOU with CIETAC (Aug 2019)

# China



SIMC-KCAB INTERNATIONAL Seminar & Seoul ADR Festival 2019



Korea



Lunch with GCs  
& SMS Edwin Tong



Japan – Singapore International Dispute Resolution Conference (Mar 2019)



Japan



# India

India Specialist  
Mediators Training &  
Appointment  
Ceremony



# SIMC International Mediator Panel

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Prof Tommy Koh  
Singapore



Mr Jeremy Lack  
Switzerland



Mr Akira Kawamura  
Japan



Justice Andrew  
Ang  
Singapore



Dr William Ury  
USA



Mr Sriram Panchu  
India



Mr Alan Limbury  
Australia



Prof Hi Taek Shin  
South Korea



Mr Kevin Kim  
South Korea



Ms Nadja Alexander  
Australia



Mr Geoff Sharp  
Australia / New Zealand



Ms Dorcas Quek  
Anderson  
Singapore



Mr Fei Ning  
China



Ms Laila Ollapally  
India



Ms Eileen Carroll QC  
(Hons)  
United Kingdom



Mr Kehinde Aina  
Nigeria

# SIMC International Mediator Panel

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Mr Bill Marsh  
United Kingdom



Mr Khory McCormick  
Australia



Mr John Sturrock QC  
United Kingdom



Mr Tim McFarlane  
United Kingdom



Mr Karl Mackie  
United Kingdom



Mr Sudhanshu Batra  
Singapore



Ms Lum Kit-Wye  
Singapore



Mr Robert Gaitskell  
QC  
United Kingdom



Mr Claude Amar  
France



Ms Elizabeth Birch  
United Kingdom



Mr David Perkins  
United Kingdom



Ms Manon Schonewille  
The Netherlands



Mr Michel  
Kallipetis  
United Kingdom



Ms Jane Player  
United Kingdom



Ms Edna Sussman  
USA



Mr Anil Xavier  
India

# SIAC & SIMC Arb-Med-Arb (AMA) Protocol

A one-stop process

Arbitration



Mediation



Arbitration



# SIMC (2015 – Sep 2020)

Total cases: 130

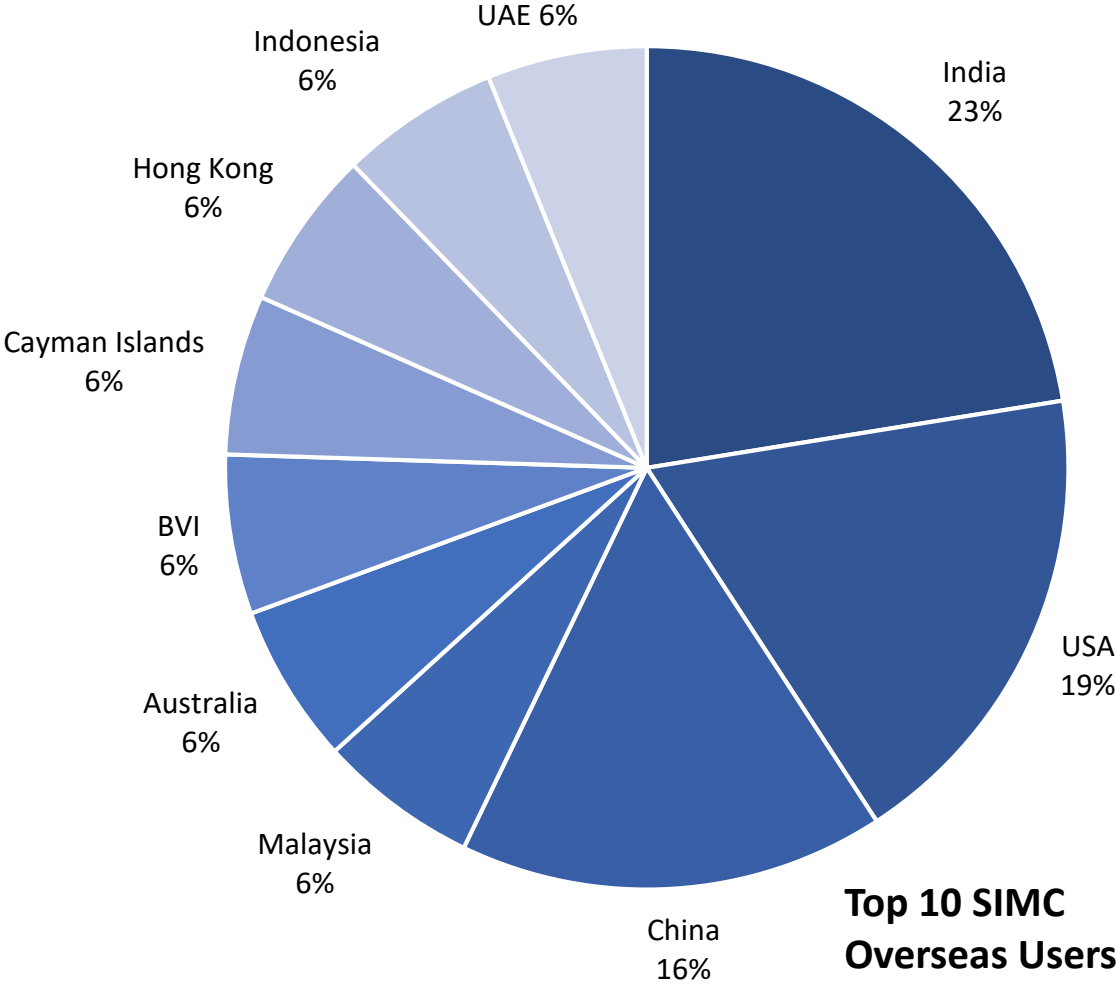
Total dispute value: US\$3 billion

Settlement rate: 70 – 80%

Arb-Med-Arb Statistics

Total AMA cases to date: 21

Settlement rate: 75 - 80%



## SIMC-SCIA MOU on “Med-Arb” Service



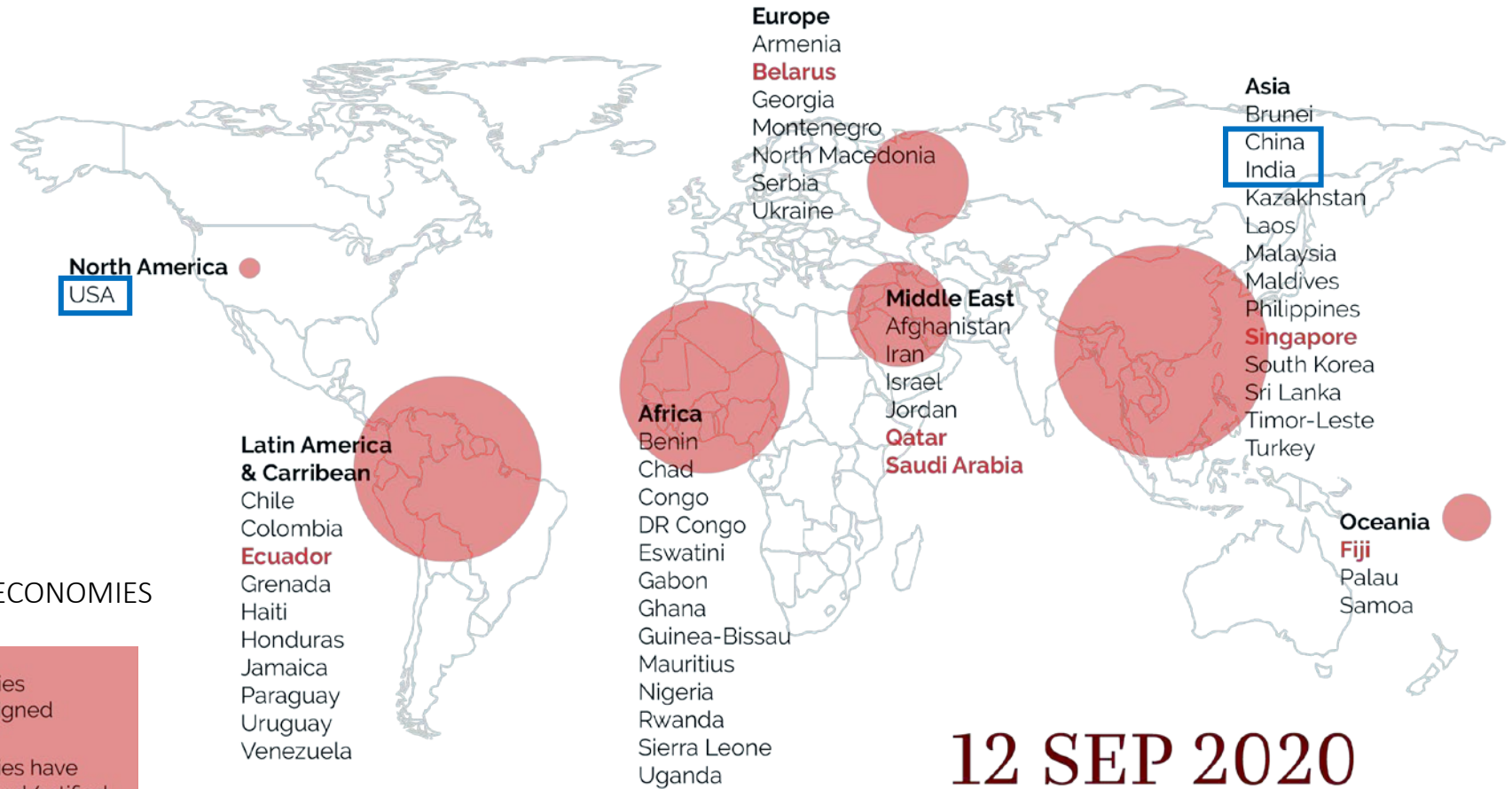
- On 17 June 2020, SIMC signed a MOU with the Shenzhen Court of International Arbitration (SCIA).
- The MOU supports businesses and projects under the Singapore–China (Shenzhen) Smart City Initiative.





Singapore Convention  
Signing Ceremony  
7 August 2019  
(46 signatories)





■ MAJOR ECONOMIES

**53** countries have signed

**6** countries have approved/ratified

**12 SEP 2020**  
Convention's entry into force



## Online Mediation During Covid-19





# THANK YOU

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# WIPO Caseload

## Copyright

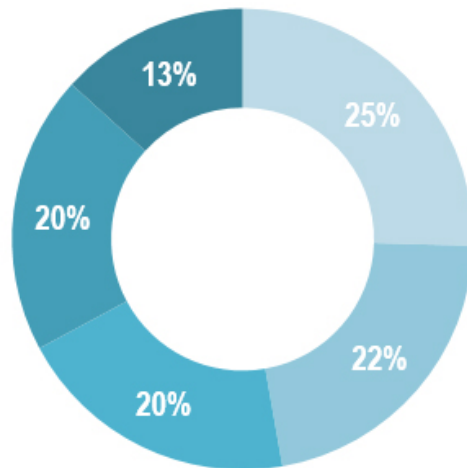
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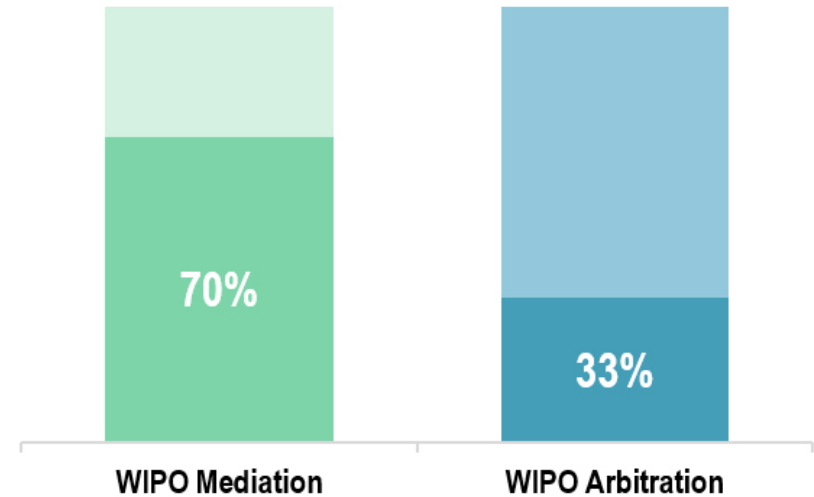
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Outsourcing  
Systems Integration  
Software Development  
Software Licensing  
Telecommunications

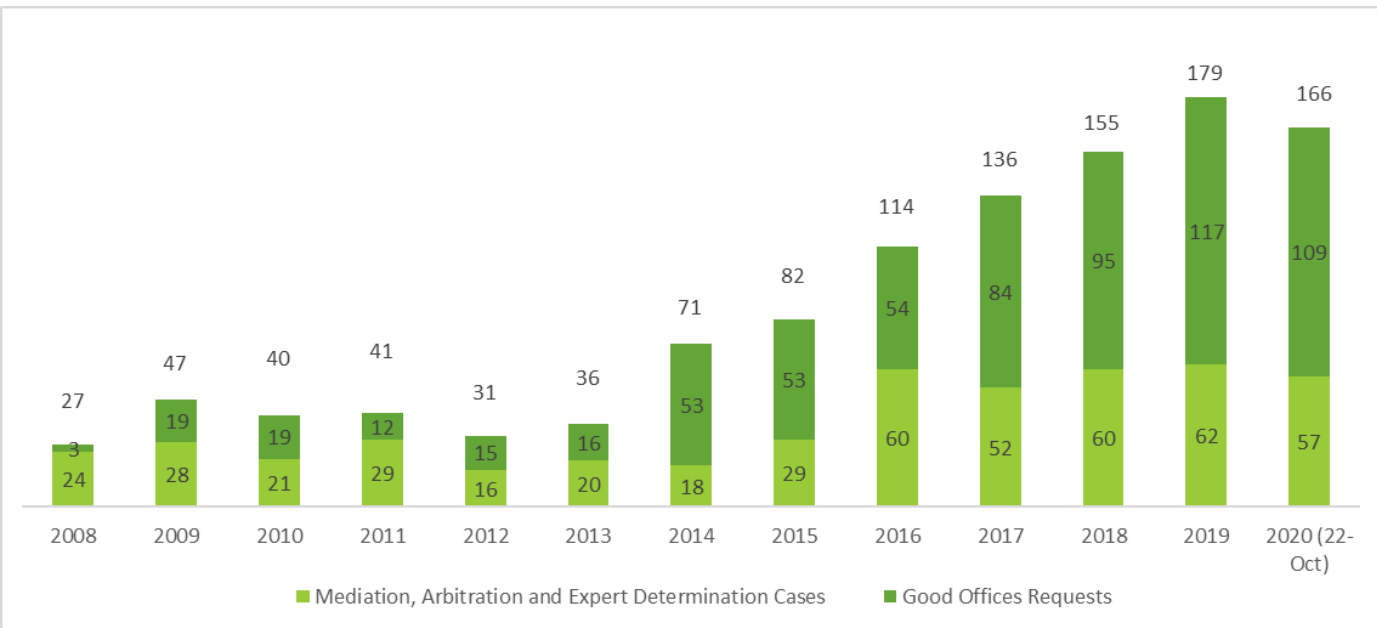
## Settlement rates



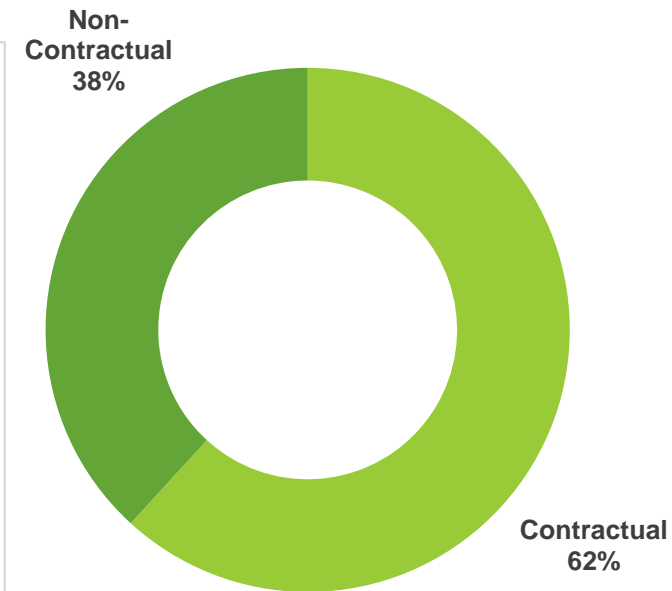
■ **2020: 85,7% settlement rate in WIPO Mediation**

# WIPO Caseload

WIPO Mediation, Arbitration, Expert Determination and Good Offices  
(2008-2020)



Referral to WIPO ADR



# Routes to WIPO ADR

- ADR contract clause electing WIPO Rules
  - WIPO Mediation, Arbitration / Expedited Arbitration, and/or Expert Determination
  - **Model clauses:** [www.wipo.int/amc/en/clauses](http://www.wipo.int/amc/en/clauses)
- ADR submission agreement electing WIPO Rules, e.g., in existing non-contractual disputes
- Unilateral request for WIPO Mediation by one party (Art. 4 WIPO Mediation Rules)
- Court referrals

# A WIPO Telephone 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 Online Mediation of a Software License Dispute

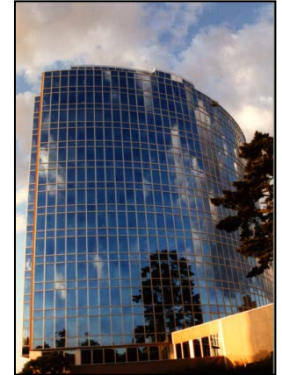
- Parties* European software developer and customer
- Contract* Software licensing agreement
- Dispute* Non-execution of the agreement and related damages claims
- Basis* Contract clause providing for WIPO Mediation followed by court litigation
- Process* Mediator with experience in technology cases
- Mediation sessions took place entirely online with live interpretation (French and German)
- Result* **Settlement agreement within six months**

# A WIPO Unilateral Request for WIPO Mediation of a Patent Infringement

<i>Parties</i>	Chinese and US companies
<i>Dispute</i>	Alleged infringement of a German patent by the US company during an exhibition in Germany
<i>Basis</i>	Chinese company submitted a Unilateral Request for WIPO Mediation Direct negotiations between the parties
<i>Mediator</i>	No mediator was appointed
<i>Result</i>	<b>US company agreed to:</b> <ul style="list-style-type: none"><li>- <b>cease selling the contentious products in Germany</b></li><li>- <b>include a notice that the products are not available in Germany at exhibitions</b></li></ul>
<i>Duration</i>	<b>One week</b>

# 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)
  - Endorse the WIPO Mediation Pledge:  
<https://www.wipo.int/amc/en/mediation/pledge.html>
- 
- Offices:
    - Geneva, Switzerland
    - Singapore, Singapore



# IP/TMT DISPUTES – COUNSEL’S ROLE AND SYNTHESIS

- Intellectual Property Disputes
- Difficulties and apprehensions
  - Ungar v Sugar (1892) 9 RPC 113 at 116-117
  - ‘Zero sum’ determinations
  - Validity of registered IP
  - ‘common general knowledge’/state of the art
  - Patent interpretation (DoE, Purposive/Literal)
  - subject matter arbitrability issues
  - Territoriality/inconsistent decisions
- Opportunities
  - Cross-border/multi-jurisdictional IP fights
  - Exemptions eg. Fair Use
  - Partitioned mediation - issues
  - Valuation/Damage assessment
  - Royalties
- Standard Essential Patents (SEPs) and FRAND
- New Tech
  - Application Programming Interfaces (APIs)
  - Artificial Intelligence/IP
    - AI machines/AI generated works
    - Inventorship/authorship
  - Extended Reality Tech
    - Virtual Reality
    - Augmented Reality
    - Mixed Reality
  - Quantum Computing
- TMT Disputes
- Rise of IT arbitrations
  - Trade offs
  - Development of the common law (hindered)
  - Possible presumption against confidentiality in future?
- IT contracts
  - ‘Waterfall’ or ‘Agile’ structures
  - Variation orders
  - Tolerance of timing; performance prevention
  - Termination
  - Vitiating (Covid-19)
- Smart Contracts/distributed ledger technology
- Third Parties and Joinder
  - outsourcing
- ‘Big Data’ Protection
  - PDPA+/GDPR
  - data mining disputes (consumers)
- Cybersecurity
  - ‘reasonable security arrangements’
  - Technological solutions
- Process issues
  - E-disclosure
  - E-case management solutions
- Specialist or non-specialist Mediator?



JOYCE A TAN &  
PARTNERS

# Recent Developments In Mediation For IP & Technology Disputes Mediator's Perspective

WIPO-SIMC Joint Webinar

27<sup>th</sup> June 2020, 17:00 hours Singapore; 10:00 hours Geneva

Lawyers Who **Lead**

# RECENT DEVELOPMENTS IN MEDIATION OF IP & TECHNOLOGY DISPUTES

## MEDIATOR'S PERSPECTIVE

### ● Anecdotal Observations

- ▶ greater conversion and buy-in
- ▶ more cross-border context
- ▶ mediation in its element
- ▶ real-life outcomes illustrate particular suitability

### ● Technicalities in IP & Technology Disputes

- ▶ technological, legal, commercial considerations
- ▶ jargon, factual / evidential dynamics
- ▶ party empathy, under the skin, the plot
- ▶ different BATNA / WATNA, different longer runway
- ▶ balance - technicalities vs meaningful settlement

### ● Recent Online Phenomenon

- ▶ human interaction - a different mastery
- ▶ technology platform and administration
- ▶ preparation and precautions
- ▶ physical realities

### ● Navigating Boundaries Without Borders

- ▶ jurisdictional sensitivities - nature of IP laws
- ▶ cross-border sophistication
- ▶ cultural nuances
- ▶ parties' marketplace beyond national boundaries
- ▶ Singapore Convention on Mediation

### ● Opportunities for More

- ▶ still a latent force
- ▶ wider reach e.g. geography, sectors
- ▶ high returns relative to time/cost, considering complexity
- ▶ build out specific expertise
- ▶ success begets more