

WIPO LIST OF NEUTRALS

BIOGRAPHICAL DATA

Jacques de WERRA
Professor at the School of Law
University of Geneva
Geneva



Nationality: Canadian and Swiss

EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

Professor of contract law and of intellectual property law, University of Geneva (since 2006) teaching courses in Swiss and international intellectual property law, contract law (including business contracts), information technology (IT) & digital law and sports law;

Founder and Director of the Digital Law Center, Faculty of Law, University of Geneva (since 2020);

Vice-rector, University of Geneva (in charge of technology transfer, digital strategy, relationships with international organizations, etc.), 2015 – 2019;

Visiting professor / invited lecturer at various Universities, including Harvard Law School as visiting professor for a course on international intellectual property transactions in the winter terms 2024 and 2022, Stanford Law School (2017 and 2023), Renmin Law School, City University of Hong Kong, Nagoya University, Université Catholique de Louvain, University of Lausanne (etc.);

Lecturer (for intellectual property law), University of Geneva, 2003 – 2006;
LL.M. (Master of Laws), Columbia Law School (Columbia University), 2001;
Doctorate in Law (Ph.D), University of Lausanne, 1996;
Degree in Swiss Law, University of Lausanne, 1993.

Admission to:
New York Bar, 2002;
Geneva Bar, 1999.

September 25, 2023

LANGUAGES

French, English, German

PRESENT POSITION

Professor of contract law and of intellectual property law, University of Geneva (since 2006) teaching courses in Swiss and international intellectual property law, contract law (including unregulated business contracts), information technology (IT) & digital law and sports law;

Founder and Director of the Digital Law Center), Faculty of Law, University of Geneva (since 2020);

Member of the Council of the Geneva Center for International Dispute Settlement (CIDS, and of the Committee of the Geneva Master in International Dispute Settlement (MIDS, and professor for an intensive course on Intellectual Property & Technology Arbitration in the MIDS program (spring 2024);

Member of the board of the International Academy of Sport Science & Technology (Académie Internationale des Sciences et Techniques du Sport - AISTS, (vice-chairman from 2018 to 2022) and professor in the AISTS' Master Degree in Sport Management & Technology and in the AISTS India program for courses on Sports & Intellectual Property and on Digital Law in the Sports Industry

Co-founder of the Swiss Contract Law platform reporting and commenting on the latest Swiss case law on Swiss business contracts

PROFESSIONAL EXPERIENCE BEFORE PRESENT POSITION

Associate, Lenz & Staehelin, Zurich/Geneva, Switzerland, 2002 – 2006;

Intern, Fross, Zelnick, Lehrmann & Zissu P.C., New York, 2002;

Trainee / associate, de Pfyffer & Partners, Geneva, 1997 – 1999;

Intern, Morrison & Foerster, LLP, Brussels, 1996;

Research assistant, Law School of the University of Lausanne, 1993 – 1996.

AREAS OF SPECIALIZATION

Intellectual property (IP) law including transactional IP (IP-based agreements including licensing, franchising, research and development agreements and technology transfer agreements)

Contract law (business contracts, including agency, distribution, joint venture, M&A, shareholder agreements)

Information technology (IT) law / digital law;

MEMBERSHIP IN PROFESSIONAL BODIES

Association Littéraire et Artistique Internationale (ALAI), Swiss Group;

International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP);

International Association for the Protection of Intellectual Property (AIPPI), Swiss Group;

Licensing Executives Society (LES), Swiss Group;

Swiss Arbitration Association (ASA);

Swiss Forum for Communication Law;

Swiss Sports Law Association.

EXPERIENCE IN INTELLECTUAL PROPERTY

Former member of the Swiss Federal Arbitral Commission for the Management of Copyrights and

Neighbouring Rights (2012-2015);
 Arbitrator/counsel/expert activity in judicial and arbitral proceedings in intellectual property / IP transactional / contractual disputes since 2002;
 Academic activities (teaching, research and policy work) about intellectual property law and IP-transactions (including the organization of the international annual IP conference at the University of Geneva, "Journée de Droit de la Propriété Intellectuelle" since 2008, www.jdpi.ch);

EXPERIENCE WITH RESPECT TO DOMAIN NAMES

Arbitrator/counsel/expert activity in numerous disputes relating to domain names (gTLDs and ccTLD for ".ch") since 2002;
 Academic activities (teaching and research) in domain name law / internet law / digital law;
 Founder and organizer of the Geneva Internet law summer school, now Digital Law Summer School (www.digitallaw-geneva.ch) and of the Geneva Digital Law Research Colloquium (www.digitallawcolloquium-geneva.ch).

MAJOR PUBLICATIONS¹

Patent Arbitration under the Agreement on a Unified Patent Court (UPC). In: European Patent Law : The Unified Patent Court and the European Patent Convention. Berlin : De Gruyter, 2023 (forthcoming)

<https://archive-ouverte.unige.ch/unige:170607>

Reference Guide to Sustaining Sport and its Development through Intellectual Property Rights (for the World Intellectual Property Organization, WIPO), 2022,

<https://www.wipo.int/export/sites/www/sports/en/docs/guide-sustaining-sport-ipr-2022.pdf>

Athletes & Social Media: What constitutes Ambush Marketing in the Digital Age ? The Case of Rule 40 of the Olympic Charter, in: Vers les sommets du droit : 'Liber amicorum' pour Henry Peter, Genève, 2019. p. 3

<https://archive-ouverte.unige.ch/unige:135051>

Cancellation of Sports Sponsoring Agreements for *Force Majeure* (COVID-19): Which Part of the Sponsorship Fees must be Reimbursed to the Sponsor? (with Nicolas Rouvinez), published on: Swiss Contract Law, August 25, 2023, <https://swisscontract.law/27/>

Using Arbitration and ADR for Disputes about Personal and Non-Personal Data: What Lessons from Recent Developments in Europe?, American Review of International Arbitration 2019, vol. 30, no. 2, p. 195-217;

<https://archive-ouverte.unige.ch/unige:134313>

Swiss Commercial Contracts: Review of Recent Case Law, in: Jusletter, 9 December 2019;

<https://archive-ouverte.unige.ch/unige:128163>

Can exclusive licensees sue for infringement of licensed IP rights? a case study confirming the need to create global IP licensing rules, in: Harvard Journal of Law & Technology 2017 (Special issue), p. 189-209;

https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2907655

Annual review of Swiss contract law, in: Journal des Tribunaux² since 2011; last published review: Droit des contrats : Partie générale et contrats spéciaux, Journal des Tribunaux II (Droit civil, poursuite pour dettes et faillites et procédure civile) 2022);

<https://archive-ouverte.unige.ch/unige:169906>

Commentary of art. 75 – 80 of the WIPO Arbitration Rules, in: Arbitration in Switzerland: The Practitioner's Guide (Manuel Arroyo ed.), 2nd edition, Wolters Kluwer 2018, p. 2123-2153;

¹ Full list of publications: <http://www.unige.ch/droit/collaborateur/professeurs/deWerra-jacques/publications.html>.

² Leading Swiss legal review (in French language).

Scientific co-editor (with Prof. Irene Calboli) of *The Law and Practice of Trademark Transactions: a Global and Local Outlook* (Edward Elgar 2016);

Scientific co-editor (with Prof. Philippe Gilliéron) and author of the *Commentaire romand de droit de la propriété intellectuelle* (approx. 2500 pages) commenting the four main Swiss intellectual property laws (i.e. copyright, patent, trademark and design laws), (Helbing & Lichtenhahn Basel 2013)

Scientific editor of the *Research Handbook on Intellectual Property Licensing* (Edward Elgar 2013): www.ip-licensing.info;

Founder and editor of the intellectual property book series: *Propriété Intellectuelle – Intellectual Property* (www.pi-ip.ch):

- Vol. 1 : *Sport et propriété intellectuelle / Sport and Intellectual Property* (2010) ;
- Vol. 2 : *La résolution des litiges de propriété intellectuelle / Resolution of Intellectual Property Disputes* (2010) ;
- Vol. 3 : *Marques notoires et de haute renommée / Well-Known and Famous Trademarks* (2011) ;
- Vol. 4 : *La propriété intellectuelle dans l'industrie pharmaceutique / Intellectual Property in the Pharmaceutical Industry* (2012) ;
- Vol. 5 : Yaniv Benhamou (thèse de doctorat), *Domages-intérêts sous l'angle de la méthode des redevances suite à la violation de droit de propriété intellectuelle en droit suisse et comparé* ;
- Vol. 6 : *La protection des secrets d'affaires / The Protection of Trade Secrets* (2013) ;
- Vol. 7 : *Défis du droit de la concurrence déloyale / Challenges of Unfair Competition Law* (2014) ;
- Vol. 8 : *Le droit du design / Design law* (2015) ;
- Vol. 9 : *Indications géographiques: Perspectives globales et locale / Geographic Indications: Global and Local perspectives* (2016) ;
- Vol. 10 : *Droit d'auteur 4.0 / Copyright 4.0* (2017) ;
- Vol. 11 : *Accords de technologie / Technology transactions* (2018)
- Vol. 12 : *Marques 3D et autres marques non-traditionnelles = 3D trademarks and other non-traditional trademarks* (2019)
- Vol. 13 : *Propriété intellectuelle à l'ère du Big data et de la blockchain / Intellectual Property in the Era of Big Data and Blockchain* (2020)
- Vol. 14 : Boris Catzeflis (PhD thesis), *Les marques contraires à l'ordre public ou aux bonnes mœurs* (2022)
- Vol. 15 : Pierre Heuzé (PhD thesis), *L'épuisement des droits de propriété intellectuelle sur un matériel biologique* (2023)

Alternative Dispute Resolution Mechanisms for Solving Trademark Disputes (Mediation, UDRP, Arbitration), in: Irene Calboli & Jacques de Werra (eds), *The Law and Practice of Trademark Transactions: a Global and Local Outlook* (Edward Elgar 2016), p. 293-322;
<https://archive-ouverte.unige.ch/unige:82027>

New Developments of IP Arbitration and Mediation in Europe: The Patent Mediation and Arbitration Center Instituted by the Agreement on a Unified Patent Court, in: *Revista Brasileira de Arbitragem* 2014, p. 17-35;
<https://archive-ouverte.unige.ch/unige:39878>

The Expanding Significance of Arbitration for Patent Licensing Disputes: From Post-Termination Disputes to Pre-Licensing FRAND Disputes, in: *ASA Bulletin* 2014, vol. 32, no. 4, p. 692-706;
https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2773720
Euro-Korean Perspectives on the Use of Arbitration and ADR Mechanisms for Solving Intellectual Property Disputes, in: *Arbitration International*, 2014, vol. 30, no. 1, p. 91-123 (co-authored with Gyooho Lee and Keon-Hyung Ahn);
<https://archive-ouverte.unige.ch/unige:33421>

Arbitrating International Intellectual Property Disputes: Time to Think Beyond the Issue of (Non-) Arbitrability, in: *International Business Law Journal*, 2012, Issue 3, p. 299-317;
http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2149762
Can Alternative Dispute Resolution Mechanisms Become the Default Method for Solving International Intellectual Property Disputes? in: *California Western International Law Journal*, Vol. 43, No. 1, 2012, p. 39-75;
http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2195968

How to Protect Trade Secrets in High-Tech Sports? An Intellectual Property Analysis based on the Experiences at the America's Cup and in the Formula One Championship, in: European Intellectual Property Review 2010 (volume 32, issue 4), p. 155-164;
http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2149767

EXPERIENCE IN COURT LITIGATION

Counsel/expert/consultant in judicial proceedings (including expert legal opinions) in Switzerland / other countries for various issues of contract law / IP law / Internet & digital law.

EXPERIENCE IN ARBITRATION

Experience as arbitrator (chairman, sole arbitrator, party-appointed arbitrator), counsel and expert in international and domestic arbitration proceedings (institutional arbitration governed by various rules, including WIPO Rules, ICC Rules, Swiss Rules of International Arbitration, rules of the Court of Arbitration for Sport; and ad hoc arbitration proceedings) relating to a variety of business contracts (including share purchase agreements (M&A), joint-venture licensing, technology transfer, distribution, franchising, publishing agreements, etc.), in many industries and business sectors (including pharmaceutical, medtech, transportation, banking, major construction and engineering projects, IT, telecommunication, music, etc.).

EXPERIENCE IN MEDIATION

Experience as mediator and as counsel (commercial mediation relating to an intellectual property related agreement - patent license agreement in the medtech industry); participation to various seminars in commercial mediation.
