



## **WIPO Mediation and Arbitration Workshop**

Palo Alto, United States of America, November 12 and 13, 2015

organized by  
WIPO Arbitration and Mediation Center

PROGRAM OUTLINE



Thursday, November 12, 2015

- 08:30 – 09:00 *Registration*
- 09:00 – 09:15 **I. Opening**  
John Cabeca (Director, Silicon Valley Office, United States Patent and Trademark Office (USPTO))  
Ignacio de Castro (Deputy Director, WIPO Arbitration and Mediation Center)  
Matthew Reed (Wilson Sonsini Goodrich & Rosati, Palo Alto)
- 09:15 – 09:30 **II. Overview: WIPO Arbitration and Mediation Center, including the 2014 WIPO Rules**  
Session Leader: Heike Wollgast (Senior Legal Officer, Disputes Management Section, WIPO Arbitration and Mediation Center)  
  1. Role of the WIPO Arbitration and Mediation Center
  2. WIPO Mediation and Arbitration Rules and WIPO mediators and arbitrators
  3. Basic mediation and arbitration principles
- 09:30 – 10:00 **III. Mediation: Preparing and Commencing**  
Session Leaders: Russell Levine (Kirkland & Ellis, Chicago) and Judge James F. Holderman (Ret.) (Chicago, Illinois)
- 10:00 – 10:30 **IV. Selection and Appointment of the Mediator**  
Session Leaders: David Perkins, (WIPO Mediator and Arbitrator, London) and Ignacio de Castro  
  1. Negotiating a suitable candidate
  2. The WIPO Arbitration and Mediation Center's role
- 10:30 – 10:45 *Questions and Answers*
- 10:45 – 11:15 *Coffee Break*
- 11:15 – 12:00 **V. Preparatory Organization of the Mediation**  
Session Leaders: Scott Donahey (WIPO Mediator and Arbitrator, Palo Alto) and Peter Michaelson (WIPO Mediator and Arbitrator, New York)  
  1. Preparing the mediation process with the mediator
  2. Preparing the client for the mediation meeting
    - (i) Determining party representation – decision making power/authority
    - (ii) Preparing the party statements
  3. Exchange of documents
- 12:00 – 12:15 *Questions and Answers*
- 12:15 – 13:15 *Lunch*

13:15 – 14:00 **VI. The Conduct of a Mediation Meeting and the Role of the Different Actors**

Session Leaders: Peter Michaelson and David Perkins

1. Mediation stages – preparation, exploration, bargaining, negotiation and concluding phase
2. The mediator's role and techniques
  - (i) The mediator's role
    - :Facilitative
    - :Evaluative
    - :Combined
    - :Ethical Standards
  - (ii) The mediator's techniques
    - :Active listening
    - :Reframing
    - :Balancing party power inequalities
    - :Managing emotions
3. The lawyers' role
  - (i) Dividing participation with client
  - (ii) Disclosing information
4. The parties' role
  - (i) Party statements
  - (ii) Participation in negotiation
  - (iii) Sharing business interests
  - (iv) Cooperation in good faith

14:00 – 14:45 **VII. Concluding the Mediation**

Session Leaders: Scott Donahey and Russell Levine

1. Exploring possible alternative solutions
2. Settlement
  - (i) Terms of Agreement
  - (ii) Settlement Agreement
  - (iii) Enforceability
3. Conclusion

14:45 – 15:00 *Questions and Answers*

15:00 – 15:30 **VIII. Mediation for Disputes before IP Offices**

Session Leaders: Ignacio de Castro and David Newman (Gould & Ratner LLP, Chicago)

15:30 – 16:00 *Coffee Break*

16:00 – 16:45 **IX. Intellectual Property Arbitration**

Session Leaders: Trevor Cook (Wilmer Hale, New York), Rachael Kent (Wilmer Hale, Washington DC) and Richard Tan (Stamford Law, Singapore)

1. Legal Framework
  - (i) :Arbitration Agreement

- (ii) :Place of Arbitration
- (iii) :Law Applicable to the Merits
- (iv) :Law of the Place of Enforcement
- (v) :Rules
- 2. Reputed Principles
  - (i) :Party Autonomy
  - (ii) :International Procedure
  - (iii) :Confidentiality
- 3. Points of Tension and the Role of the Arbitrator
  - (iv) :Cost
  - (v) :Speed
  - (vi) :Due Process
- 4. Special Features of Intellectual Property Disputes in Particular Patent Disputes
- 5. Benefits and Limitations of Arbitration in Intellectual Property Disputes as Compared to Court Litigation
- 6. Recent Developments in International Arbitration

16:45 – 17:15 **X. Selection and Appointment of the Tribunal and Preparatory Organization**

Session Leaders: Scott Donahey and Peter Michaelson

- 1. Arbitrator Skills
- 2. The Role of the Presiding Arbitrator
- 3. Appointment Procedure
- 4. Appointment of a Three Member Tribunal
- 5. Party Interviews
- 6. Fees
- 7. Disclosure Statements
- 8. Codes of Ethics
- 9. Challenges
- 10. Preparatory Conference
- 11. Pleas on Jurisdiction

17:15 – 17:30 *Questions and Answers*

17:30 **Closing**

17:30 – 19:00 **Reception**

Friday, November 13, 2015

09:00 – 10:00 **XI. The Conduct of Proceedings**

Session Leaders: Rachael Kent and David Perkins

1. Written Submissions
  - (i) Request for Arbitration and Answer to the Request
  - (ii) Statement of Claim and Statement of Defense
  - (iii) Further Written Statements
2. Expedited Arbitration Compared to Arbitration
3. Evidence and IP
  - (i) Civil Law and Common Law Practice
  - (ii) Witnesses: Fact and Expert Witnesses, Form of Testimony - Written
  - (iii) Experts: Party Appointed and Tribunal Appointed
  - (iv) Scientific and Technical Evidence
  - (v) Request and Disclosure of Documents
  - (vi) Trade Secrets and Confidential Information
  - (vii) Privilege
4. Hearings
  - (i) Preparation for the Hearing
  - (ii) Conduct of the Hearing
  - (iii) Opening and Closing Statements
  - (iv) Witnesses – Oral Testimony and Examination
5. Post-hearing Briefs

10:00 – 10:15 *Questions & Answers*

10:15 – 11:00 **XII. Interim and Emergency Relief**

Session Leaders: Scott Donahey and Richard Tan

1. Availability
2. Enforceability of Interim Awards
3. Dealing with Urgent Requests
4. Party Applications for Judicial Relief
5. Emergency Relief

11:00 – 11:15 *Questions & Answers*

11:15 – 11:30 *Coffee Break*

11:30 – 12:15 **XIII. Awards**

Session Leaders: Trevor Cook and Richard Tan

1. Decision-Making
2. Types of Awards
3. Drafting the Award and Informal Scrutiny
4. Remedies
5. Costs
6. Applications for Correction or Additional Award
7. Post-Award Contact with Parties or Counsel

## 8. Enforcement

12:15 – 13:00 **XIV Drafting Effective Arbitration Clauses and Submission Agreements for IP Disputes**

Session Leaders: Ignacio de Castro and David Perkins

1. Examples of Clauses and Submission Agreements
2. Choosing the Place of Arbitration
3. Other issues for consideration

13:00 – 14:00 *Lunch*

**Focus:** **WIPO ADR for SEP/FRAND Disputes**

14:00 – 15:00 **XV. Context: Standardization in the Telecom Sector and SEP/FRAND Disputes**

Session Leaders: Paul Salmon (Senior Counsel, Office of Policy and International Relations, United States Patent and Trademark Office (USPTO)), and David Newman

15.00 – 16.00 **XVI. How Would a SEP/FRAND Dispute be Resolved in Court Litigation, Mediation or Arbitration?**

Session Leaders: Trevor Cook, James Holderman, Russell Levine, David Perkins, Maura Rees (Wilson Sonsini Goodrich & Rosati, Palo Alto) and Heike Wollgast

1. Introduction of FRAND Case Scenario (*Wollgast*)
2. FRAND Court Litigation (*Holderman/Rees*)
3. FRAND Mediation (*Perkins/Levine*)
  - (i) WIPO Model FRAND Mediation Submission Agreement
  - (ii) Portfolio vs. Sampling
  - (iii) Patent Validity and Essentiality
  - (iv) Possible Outcomes of the Mediation
4. FRAND Arbitration (*Cook*)
  - (i) WIPO Model FRAND (Expedited) Arbitration Submission Agreement
  - (ii) Portfolio vs. Sampling
  - (iii) Patent Validity and Essentiality
  - (iv) Role of the Economic Expert in a FRAND Arbitration
  - (v) Possible Outcomes of the Arbitration

16.00 – 16:30 *Discussion; Question & Answers*

16.30 **Closing**

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