

## ■ VIII. Drafting Effective Mediation Clauses and Submission Agreements and Case Management Techniques

WIPO Mediation Workshop

**New York**  
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### Mediation followed by Expedited Arbitration

#### ■ Try mediation before arbitration, at least until

- lapse of time period
- termination

#### ■ Combining the benefits

- arbitration well-prepared
- Increase of settlement chances

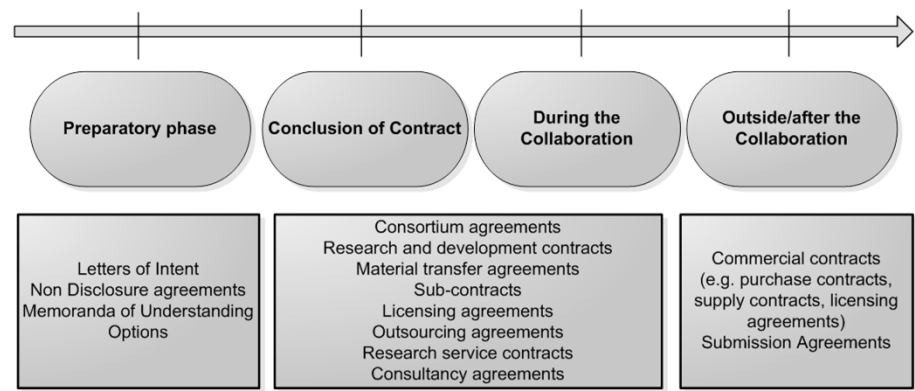
"Any dispute, controversy or claim arising under, out of or relating to this contract and any subsequent amendments of this contract, including, without limitation, its formation, validity, binding effect, interpretation, performance, breach or termination, as well as non-contractual claims, shall be 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]"

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**If, and to the extent that, any such dispute, controversy or claim has not been settled pursuant to the mediation within [60][90] 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 Expedited Arbitration Rules. Alternatively, if, before the expiration of the said period of [60][90] 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 Expedited Arbitration Rules**. 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 referred to arbitration shall be decided in accordance with [specify jurisdiction] law."**

# Dispute Resolution Clauses in Related Agreements (e.g. R&D)

Contractual Stages for R&D and Commercialization



- Consistency; agreements involving multiple parties
- DESCA Model Consortium Agreement (Section 11.8 - WIPO Mediation Followed, in the Absence of a Settlement, by WIPO Expedited Arbitration)

# Dispute Resolution Clauses in Related Agreements

- Consolidation of related disputes requires consent – careful drafting of clauses in the related contracts to allow consolidation
- Example - WIPO IT Licensing arbitrations:
  - Three separate licenses
  - One licensor
  - Three licensees
  - Define the related contracts
  - Provide in each of the related contracts for the same arbitrator to be appointed who is to have the power and jurisdiction to hear all related disputes – e.g. the tribunal in the arbitration first filed

# WIPO Model Submission Agreement to Mediation

*"We, the undersigned parties, hereby agree to submit to mediation in accordance with the WIPO Mediation Rules the following dispute:*

*[brief description of the dispute]*

*The place of mediation shall be [specify place]. The language to be used in the mediation shall be [specify language]."*



**Agreement and Request for WIPO Mediation in IPOS Trade Mark Proceedings  
(under Article 3 of the WIPO Mediation Rules)**

Reference is made to Trade Mark No. [Insert Reference] in the name of [Insert Name of TM Applicant/Proprietor] concerning [Insert TM], and to the related Opposition/Invalidation/Revocation proceedings filed by [Insert Name of Opponent/Applicant for Invalidation/Revocation] before IPOS.

The parties to these Opposition/Invalidation/Revocation proceedings have agreed to submit their dispute to mediation in accordance with the WIPO Mediation Rules. The place of mediation shall be Singapore. The language to be used in the mediation shall be English. The period of the mediation shall be [30/60/90] days, as may be extended upon agreement.

[Insert any further description of the dispute in accordance with Article 3(b)(iii) of the WIPO Mediation Rules; the parties may also refer to mediation any pre-existing disputes between them, or any issues related to applications or registrations in jurisdictions outside Singapore]

The parties have communicated to IPOS their intent to submit to mediation and the agreed period for mediation by giving the Registrar a copy of this Agreement and Request for WIPO Mediation.

In accordance with Article 3(b)(i) of the WIPO Mediation Rules, the names and communication details of the parties and (where applicable) their representatives are as follows:

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**For the TM Applicant/Proprietor**

Party:

Tel:

E-mail:

Address:

Represented by:

Tel:

E-mail:

Address:

**For the Opponent/Applicant for Invalidation/Revocation**

Party:

Tel:

E-mail:

Address:

Represented by:

Tel:

E-mail:

Address:

The applicable administration fee in accordance with the Schedule of Fees for WIPO Mediation in IP/OS Proceedings [has been/will be] paid.

**For the TM Applicant/Proprietor**

Signature:

Name:

Date:

**For the Opponent/Applicant for Invalidation/Revocation**

Signature:

Name:

Date:

## WIPO Mediation Followed by Arbitration for FRAND Disputes

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- WIPO Mediation followed by Arbitration for FRAND Disputes
- WIPO Mediation followed by Expedited Arbitration for FRAND Disputes
- WIPO Arbitration for FRAND Disputes
- WIPO Expedited Arbitration for FRAND Disputes

# WIPO Mediation Followed by Arbitration for FRAND Disputes

## Model Submission Agreement

### I. Mediation

1. We, the undersigned parties, hereby agree to submit to mediation in accordance with the WIPO Mediation Rules the following dispute:

The dispute concerns a FRAND adjudication relating to the Declaration[s] of [Name[s] of Company[ies]] to [Name of Standard-Setting Organization] and [list standard(s)] concerning [its/their patents referred to in the Declaration[s]] or [the following patents (each party shall select a maximum of [specify number] patents referred to in the Declaration[s]):]1

Nothing in this agreement shall prevent any party from bringing any argument or defense it chooses in the mediation.

2. If the parties do not agree on the person of the mediator pursuant to Article 6 of the WIPO Mediation Rules, the appointment shall take place in accordance with the procedure set out in Article 19(b) of the WIPO Arbitration Rules (WIPO Rules), except that the period of time set out in Article 19(b)(iii) of the WIPO Rules shall be ten (10) days. The WIPO Arbitration and Mediation Center (WIPO Center) shall propose to the parties candidates from its list of neutrals for patents in standards.

3. The place of mediation shall be [specify place]. The language to be used in the mediation shall be [specify language].

*Note 1: At the time of the conclusion of the mediation followed by arbitration submission agreement, parties have the option to limit the scope of the proceedings to a certain number of patents referred to in the Declaration, or to refer an entire patent portfolio to mediation/arbitration. A selection of patents ("sampling") may also be agreed by parties, or ordered by the arbitral tribunal (see Section 9), in the course of the proceedings. Parties further have the option to agree that the scope of the mediation/arbitration shall include patents on a reciprocity basis / cross-licensing.*

# WIPO Mediation Followed by Arbitration for FRAND Disputes

### II. Arbitration

4. If, and to the extent that, the dispute has not been settled pursuant to the mediation within sixty (60) 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 Rules, unless otherwise stated in this submission agreement. If, before the expiration of the said period of 60 days, either party fails to participate or to continue to participate in the mediation, the dispute 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 Rules.

5. The arbitral tribunal shall consist of three arbitrators. In making any default appointment under Article 19 of the WIPO Rules, including proposing candidates to the parties in accordance with Article 19(b) of the WIPO Rules, the WIPO Center shall to the extent possible draw on its list of neutrals for patents in standards. The periods of time relating to the appointment of arbitrators in Articles 17(b) and 18(b) of the WIPO Rules shall be reduced to fifteen (15) days.

6. The place of arbitration shall be [specify place]. The language to be used in the arbitral proceedings shall be [specify language]. The dispute shall be decided in accordance with the law of [specify jurisdiction].

## WIPO Mediation Followed by Arbitration for FRAND Disputes

7. The parties agree the following schedule:

Request for Arbitration (Article 6 WIPO Rules)	
Answer to the Request (Article 11 WIPO Rules)	15 days after receipt of the Request for Arbitration
Establishment of the Tribunal (Articles 17-23 WIPO Rules)	30 days after establishment of Tribunal
Preparatory Conference (Article 40 WIPO Rules)	15 days after the establishment of the Tribunal
Statement of Claim (Article 41 WIPO Rules)	30 days after receipt of the request for Arbitration
Statement of Defense (Article 42 WIPO Rules)	30 days after Statement of Claim
Claimant Reply	15 days after Statement of Defense
Respondent Sur-Reply	15 days after Claimant Reply
All Document Production Completed (Article 50 WIPO Rules)	30 days after Sur-Reply

## WIPO Mediation Followed by Arbitration for FRAND Disputes

Fact Witness Statements (Article 56 WIPO Rules)	30 days after Document Production
[Fact Witness Depositions Completed]	[30 days after Witness Statements]
Expert Witness Statements (Articles 56, 57 WIPO Rules)	30 days after Fact Witness Depositions
[Rebuttal Expert Witness Statements]	[30 days after Expert Witness Statements]
[Expert Witness Depositions Completed]	[20 days after Rebuttal Expert Witness Statements]
Hearing (Article 55 WIPO Rules)	30 days after Expert Witness Depositions
Claimant Post-Hearing Submission	30 days after Hearing
Respondent Post-Hearing Submission	30 days after Claimant Post-Hearing Submission
Claimant Reply	15 days after Respondent Post-Hearing Submission
Respondent Sur-Reply	15 days after Claimant Reply

## WIPO Mediation Followed by Arbitration for FRAND Disputes

8. All submissions shall be made on the specified due date via the WIPO Electronic Case Facility (ECAF).

9. An initial Preparatory Conference pursuant to Article 40 of the WIPO Rules is scheduled 15 days after the establishment of the arbitral tribunal. The arbitral tribunal shall draw up, in consultation with the parties, a document defining the scope of the arbitration, the methodology to be used and, if appropriate, stages of the proceedings.

10. Further to Articles 41 and 42 of the WIPO Rules, the parties shall, to the extent possible submit the documents and other evidence upon which they seek to rely concurrently with the Statement of Claim and the Statement of Defense. Supplemental documents and other evidence may be submitted concurrently with the Reply to the Statement of Defense and the Sur-Reply.

11. The arbitral tribunal shall not have the authority to issue interim injunctions under Article 48(a) of the WIPO Rules. In accordance with Article 48(b) of the WIPO Rules, the arbitral tribunal may order that a party provide security for the claim or counter-claim in an escrow account.

12. The parties shall try to informally resolve requests for production of documents and other evidence. The parties may bring requests for disclosure under Article 50(b) of the WIPO Rules only if they reach an impasse on the production of documents or other evidence.

13. Further to Article 56 of the WIPO Rules, the parties shall simultaneously submit sworn witness statements for each witness of fact on whom they propose to rely at the Hearing pursuant to Article 55 of the WIPO Rules. Such a statement should be sufficiently detailed so as to stand as that witness's direct testimony.

## WIPO Mediation Followed by Arbitration for FRAND Disputes

14. Further to Article 56 of the WIPO Rules and in accordance with the schedule set forth above, the parties shall submit sworn expert witness statements for each expert witness on whom they propose to rely at the Hearing pursuant to Article 55 of the WIPO Rules. Such statements should be sufficiently detailed so as to stand as that witness's direct testimony.

15. The parties are permitted to depose witnesses expected to testify at the Hearing pursuant to Article 55 of the WIPO Rules in accordance with the schedule set forth above.

16. The Hearing pursuant to Article 55 of the WIPO Rules shall be held for not more than five days.

17. The parties may file wholly or partially dispositive motions as they wish. Once filed, the arbitral tribunal shall determine if a briefing schedule is appropriate or if the motion should be stayed. The filing of any motion will not necessarily suspend or postpone the agreed schedule.

## Case Management Techniques

- Use of WIPO ECAF
- Limitation of scope (party agreement)
- Sampling
- Staging of proceedings
- Choice of participants
- Caucus

## Case Management Techniques Example

- Competitors, each with major patent portfolios, settled a series of cases between them involving 8 lawsuits and 24 patents
- Parties agreed to an escalating dispute resolution clause to resolve future disputes – mediation followed by expedited arbitration
- Parties further agreed to several case management techniques to further expedite the resolution and to reduce the fees/costs of mediating and/or arbitrating future disputes
- The notice letter had to be sent within 1 year of issuance of patent or commercialization of new product and claim charts had to be included
- Response to notice letter had to include invalidity charts
- Issues in any subsequent arbitration were limited to infringement, validity and reasonable royalty – no inequitable conduct, willfulness or lost profit claims
- Parties also limited number of dep's to 5 and number of experts to 2
- Parties further limited the time for any arbitration hearing to no more than three, seven hour days



**Thank You**