

Effectively Enforcing IP Rights

Arbitration and Mediation in Europe

Wolter Wefers Bettink

TechLaw Fall Meeting

11 November 2011

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International providers

- International Chamber of Commerce (ICC, Paris)
- World Intellectual Property Organisation (WIPO, Geneva)

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Forum and choice of law

- Parties may choose arbitration/mediation
 - Clause in (license) contract
 - Specific arbitration agreement of the parties
 - Choice of location of the arbitration and choice of law in arbitration/mediation clause
 - Location determines applicable procedural law to arbitration (e.g. challenge of award)

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Arbitration/mediation clause

- "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 []. The language to be used in the mediation shall be [English]"

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Combined clause

- **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 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 Arbitration Rules. The arbitral tribunal shall consist of [a sole arbitrator/three arbitrators]. The place of arbitration shall be []. The language to be used in the arbitral proceedings shall be [English]. The dispute, controversy or claim referred to arbitration shall be decided in accordance with [] law."

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Arbitration vs. Litigation : pros

- Expert arbitrators
- Neutrality
- Confidentiality
- Procedural flexibility
 - Speed, cost reduction
- One instance only
- Enforcement in over 140 countries
 - New York convention 1958

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Arbitration vs. Litigation: cons

- In practice, often delays
 - Constitution of the tribunal
 - Availability of arbitrators
- Costs of proceedings
 - Parties pay the arbitrators
 - Administrative fees and expenses
 - Hearing facilities
 - Court reporters, translators

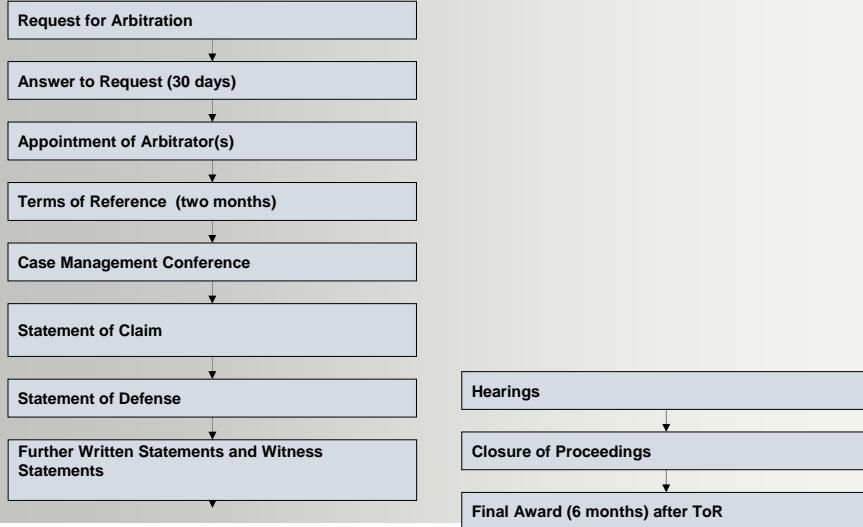
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Arbitration vs. Litigation: cons

- Limited powers
 - No means to compel witnesses
 - No power to order attachment
 - No power over issues which the parties may not decide (e.g. validity of patent, trademark)
 - No power to join third parties

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ICC Arbitration



ICC arbitration and ADR rules (as of 1 Jan 2012)

- ICC appoints sole arbitrator if parties fail within 30 days of receipt request by resp.
- Parties appoint arbitrator in three member Panel, ICC appoints chairman
- ICC determines language proceedings

WIPO Arbitration

■ Contractual

- patent licenses, software/IT, research and development agreements, patent pools, distribution agreements, joint ventures, copyright collecting societies, trademark coexistence agreements, settlement agreements

■ Infringement of IP rights

- Domestic disputes, not just international

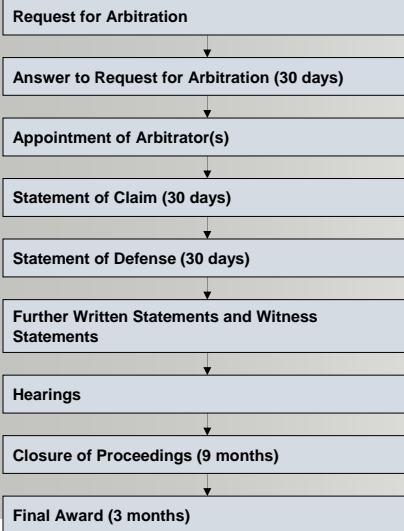
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WIPO Arbitration rules

- Types of evidence common in IP disputes
- Competitive fees
- Active case management
- Option to use WIPO ECAF (online)

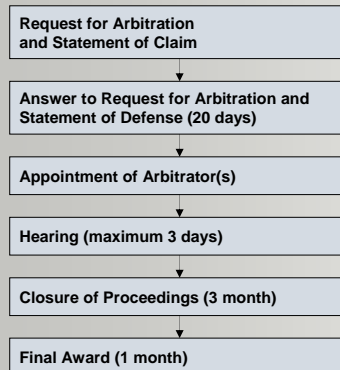
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WIPO Arbitration



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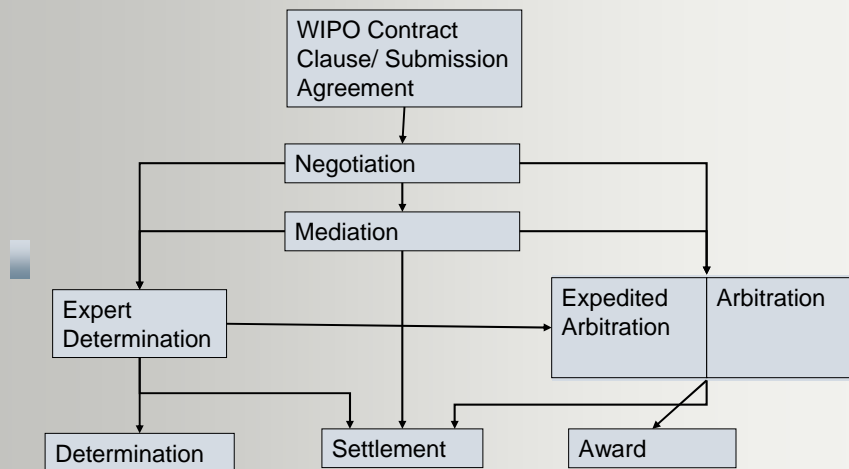
WIPO Expedited Arbitration



- One Exchange of Pleadings
- Shorter Time Limits
- Sole Arbitrator
- Shorter Hearings
- Fixed Fees

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WIPO Center: ADR Options



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Mediation vs. Arbitration/Litigation

- Parties' commitment essential
- Assisting parties in negotiating a settlement
- Confidentiality
- Limited timeframe
- Limited costs

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Combination

- Try mediation before arbitration, at least until
 - lapse of time period
 - Termination
- Arbitration well-prepared

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Contact

Wolter Wefers Bettink specialises in IP, IT, e-business and privacy law. He advises and assists clients in the outsourcing of IT and business processes and on the resolution of disputes arising from unsuccessful IT projects. He litigates and advises on a variety of internet-related matters including IP-related disputes and issues of contract formation. He provides advice on data protection matters both under the EC Data Protection Directive and national privacy legislation.

Wolter Wefers Bettink
Partner, IT & IP
T +31 (0)20 605 6167
T +31 (0)6 5392 3228
E w.bettink@houthoff.com



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www.houthoff.com

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