

## ■ VII. Case Management Techniques for IP Arbitration, including in FRAND Disputes

WIPO Arbitration Workshop

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### Case Management Techniques - General

#### **In general:**

- To save time and costs
- Specific to the nature of the disputes
- Take into account the background of the parties
- Subject to the arbitration agreement between the parties and any institutional rules and the applicable *lex arbitri*

## Case Management Techniques – IP Arbitrations

### General considerations:

- Early identification of the issues and the nature of the IP rights involved
- Establishing the framework for the arbitration and the procedural timetable
- Case management conference/preparatory conference – even if not required by the arbitration rules – involving the parties in tailoring appropriate procedural measures; inviting proposals
- Terms of reference

## Case Management Techniques – IP Arbitrations

### Special considerations: setting the agenda

- Choice of law – which law is to be applied? IP laws are territorial
  - If no express choice?
  - getting parties to agree
- Seat or place of the arbitration and the *lex arbitri*
  - Arbitrability/public policy issues
- Jurisdictional issues and challenges
  - As a preliminary ruling or in an award on the merits
- Examining the remedies and reliefs claimed
  - *erga omnes v inter-partes* remedies
  - May involve issues of arbitrability
  - Enforceable at the place of recognition and enforcement?
  - Extent to which the arbitral tribunal may/should provide comments at an early stage

## Case Management Techniques – IP Arbitrations

### Special considerations: setting the agenda

- Identifying the issues and common ground(s):
  - E.g. Preliminary claim construction
  - Limitation of scope (party agreement)
- Site visits
- Experiments (e.g. 2014 WIPO Rules Article 51)
- Sampling, agreed primers and models (e.g. 2014 WIPO Rules Article 53)
- Bifurcation and partial awards
  - Jurisdiction
  - Validity
  - Infringement
  - Damages

## Case Management Techniques – IP Arbitrations

### Special considerations : setting the agenda

- Interim measures – protective, conservatory and similar interim measures
  - Preservation of evidence (and note emergency arbitrator relief and where granted, review by the arbitral tribunal when constituted)
- Trade secrets and other confidential information
  - does the applicable law (or the arbitration rules) adequately deal with this? Is any special agreement required or would directions need to be issued and if do, under what powers?
  - confidentiality advisor? 2014 WIPO Rules Article 54
- Document disclosure (2010 IBA Rules on the taking of evidence in international arbitration)

## Case Management Techniques – IP Arbitrations

### Special considerations: setting the agenda

- Scheduling and the procedural timetable
  - Scope for an expedited procedure if the parties agree?
- Form of statements – pleadings and memorials with witness statements and catering to different styles and backgrounds
- Expert evidence
  - Limiting the number of experts and identifying the discipline and identity
  - In appropriate cases, especially those not involving large sums of money, should the arbitral tribunal ask the parties – at an early stage - to consider a single joint expert to save costs of both parties appointing their own experts? Is this desirable?

## Case Management Techniques – IP Arbitrations

### Special considerations: setting the agenda

- Use of an electronic case filing system eg WIPO ECAF or equivalent
- Translations
- Limiting length of submissions and post-hearing briefs
- Are oral hearings necessary to determine certain issues; can certain issues be determined on the basis of written submissions
- Arrangements for the evidential hearings
  - Witness conferencing and other techniques
  - Logistics
  - In-person hearings or can any hearings be held by video-conferencing or other means
- Interest and costs
  - Caldebank offers?
- ‘Procedural Order No 1’
- Further case management meetings – purpose
  - Isolating or narrowing the issues; finding common ground
  - Encouraging a settlement?
- Post-hearing matters – retaining jurisdiction

## Case Management Techniques

- Limiting size of pleadings
- Document production; discovery

*“Pursuant 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. The Sole Arbitrator expects the parties to informally resolve requests for production of documents and other evidence. The Sole Arbitrator further expects the parties to bring requests for disclosure under Article 48(b) of the WIPO Rules only if they reach an impasse on the production of documents or other evidence.”*

- Closing of proceedings after last hearing/last authorized written submission

## Case Management Techniques

- Procedural timetable

*“Pursuant to its powers under Article 38 of the WIPO Arbitration Rules (“the WIPO Rules”), the Sole Arbitrator hereby sets the following schedule as agreed by the parties:*

<i>Statement of Claim</i>	<i>December 19, 2007</i>
<i>Statement of Defense</i>	<i>January 18, 2008</i>
<i>Claimant Reply</i>	<i>February 14, 2008</i>
<i>Respondent Sur-Reply</i>	<i>March 2, 2008</i>
<i>All Document Production Completed</i>	<i>March 30, 2008</i>
<i>Fact Witness Statements</i>	<i>April 27, 2008</i>
<i>Fact Witness Depositions Completed</i>	<i>May 25, 2008</i>
<i>Expert Witness Statements (Claimant re. infringement and damages; Respondent re. invalidity)</i>	<i>June 22, 2008</i>
<i>Rebuttal Expert Witness Statements (Claimant re. validity; Respondent re. Non-infringement and damages)</i>	<i>July 20, 2008</i>
<i>Expert Witness Depositions Completed</i>	<i>August 10, 2008</i>
<i>Hearing</i>	<i>Sept. 17-21, 2008</i>
<i>Claimant Post-Hearing Submission</i>	<i>October 22, 2008</i>
<i>Respondent Post-Hearing Submission</i>	<i>November 21, 2008</i>
<i>Claimant Reply</i>	<i>December 6, 2008</i>
<i>Respondent Sur-Reply</i>	<i>December 21, 2008”</i>

## WIPO Mediation Followed by Arbitration for FRAND Disputes

- 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]):]

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.

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**Thank You**