

Table of Contents

List of Abbreviations	xxiii
Preface	xxv
Chapter 1	
Introduction	1
1. The Structure and Scope of This Book	1
2. Areas of IP Dispute Resolution Not Addressed by This Book	2
2.1. Domain Name Disputes	2
2.2. Expert Determination	3
2.3. IIA Disputes	4
Chapter 2	
Intellectual Property, Agreements Relating to It and Disputes that Arise as to It or under Such Agreements	5
1. Introduction	5
1.1. What Is Intellectual Property?	5
1.2. Registered IPRs	7
1.3. International Aspects of IP	8
1.4. Agreements Relating to IPRs	10
2. Specific Types of IP and Some Disputes Encountered over Them	12
2.1. Patents	12
2.1.1. Introduction	12
2.1.2. Disputes under Patent Licenses	15
2.2. Copyright and Related Rights	18
2.3. Trademarks	19
2.4. Designs	19
2.5. Confidential Information	20

Table of Contents

Chapter 3

Benefits and Limitations of International Arbitration for IP Disputes

1.	Introduction	23
2.	Main Features of International Arbitration	23
2.1.	Arbitral Awards Are Readily Enforceable in Most Countries of the World	23
2.2.	International Arbitration and Party Autonomy	27
2.2.1.	Party Autonomy and Neutral Proceedings	27
2.2.2.	Autonomy to Choose Decision-Makers	29
2.2.3.	Procedural Flexibility	31
2.2.3.1.	Conduct of the Proceedings	31
2.2.3.2.	Possibility to Design Special Mechanisms for Dispute Resolution	32
2.2.3.3.	Incentive for Settlements	33
2.2.4.	Due to Its Contractual Nature Arbitration Lacks Some Features of Litigation	34
2.2.4.1.	Arbitrators Lack <i>Imperium</i>	34
2.2.4.2.	Lack of Powers upon Third Parties	35
2.2.4.3.	Arbitral Awards Do Not Have Precedential Value and Inter Partes Effects of Arbitration	36
2.2.5.	Some Possible Concerns Arising Out of the Contractual Nature of International Arbitration	36
2.2.5.1.	Concerns Due to the Lack of a Detailed Procedural Framework	36
2.2.5.2.	Arbitrators 'Split the Baby'	37
2.3.	International Arbitral Awards Are Final	38
2.4.	Arbitration May Be Cheaper and Faster than Litigation	41
2.4.1.	Length of Arbitral Proceedings	41
2.4.2.	Costs	42
2.4.3.	Multi-jurisdictional IP Cases	44
2.5.	Confidentiality	46
3.	Arbitration or Litigation of IP Disputes?	48

Chapter 4

Arbitrability of IP Disputes

1.	The Issue of Arbitrability of IP Disputes	49
1.1.	Introduction	49
1.2.	Why Arbitrating IP Disputes May Be an Issue?	50
1.3.	Incidence and Scope of Inarbitrability Issues in Relation to IP Disputes	52
2.	Resolving Issues of Arbitrability in International IP Disputes	53
2.1.	Inarbitrability Objections Raised before the Arbitral Tribunal	54

2.1.1.	Inarbitrability and Jurisdiction	54
2.1.2.	Applicable Law	54
2.1.3.	Law of the Countries Where the IP in Issue Subsists	56
2.1.4.	Application of Laws of Countries of Registration of IPR as Foreign Public Policy Rules	56
2.1.5.	Resolution of Issues of Arbitrability	57
2.2.	Inarbitrability Objections before National Courts in Parallel Proceedings	57
2.3.	Inarbitrability in the Context of a Setting Aside Action	58
2.4.	Inarbitrability in the Context of Challenges to Recognition and Enforcement of Awards	59
2.4.1.	A Fourth Bite of the Apple?	59
2.4.2.	Invalidity Effects of the Award	59
2.4.2.1.	Awards that Fully Accept 'Invalidity'	60
2.4.2.2.	Awards that Completely Reject 'Invalidity' Allegations	60
2.4.2.3.	Awards that Partially 'Invalidate' Asserted IP	60
2.4.3.	Law Applicable by the Court of the Place of Recognition and Enforcement	61
2.5.	Dealing with Public Policy Arguments if the Applicable Law Does Not Provide for a Specific Solution on Arbitrability	62
3.	The Public Policy Debate	62
3.1.	Potential Public Policy Arguments in Support of Inarbitrability	62
3.1.1.	State Involvement in the Creation of IPR	63
3.1.2.	IP Creates Monopolies or Rights of Exclusivity	64
3.1.3.	Protection of the Interests Behind the Grant of Monopolies	64
3.1.4.	Existence of Bodies that Have Specific Jurisdiction on Validity Issues	65
3.2.	Two Keys to Rebut Public Policy Arguments against Arbitrability of IPR	66
3.2.1.	Insufficiency of Pure Public Policy Arguments	66
3.2.2.	Public Policy Arguments in the Light of the <i>Inter Partes</i> Effect of Arbitration	68
3.2.2.1.	State Involvement and Sovereign Acts Arguments	68
3.2.2.2.	Monopolies and Underlying Policy Interest Rationales	71
3.2.2.3.	Exclusive Jurisdiction of Certain Bodies Argument	73
3.2.3.	International Public Policy and Restrictive Application of Public Policy	75

Table of Contents

Chapter 5

Legal and Regulatory Framework of an IP Arbitration	77
1. Introduction	77
2. Regulatory Framework of the Arbitration Itself	78
2.1. Agreement of the Parties, Institutional Rules and <i>Lex Arbitri</i>	78
2.2. Seat and the <i>Lex Arbitri</i>	79
2.2.1. Two Interrelated Issues	79
2.2.2. Evolution of Seat as Choice of <i>Lex Arbitri</i>	80
2.2.3. Choosing 'Foreign' Law to Govern the Conduct of an Arbitration	82
2.3. Absence of Choice of Seat by the Parties	83
3. Regulatory Framework in Relation to Substantive Issues	85
3.1. Importance of the Regulatory Framework and Different Issues	85
3.2. The Law Applicable to Issues Arising from the Underlying Contract	86
3.2.1. Introduction	86
3.2.2. The Applicable Law Where Parties Have Concluded a Choice of Law Agreement	86
3.2.2.1. Party Autonomy	86
3.2.2.2. Limitations to Party Autonomy: Mandatory Rules	89
3.2.2.3. Pragmatic Approach to Non-contractual IP Issues in International Arbitration	91
3.2.2.4. Potential Choices of Substantive Law	95
3.2.2.4.1. National Law	95
3.2.2.4.2. Non-national Law: 'Rules of Law'	97
3.2.3. Law Applicable to the Substance of the Dispute in the Absence of Agreement	98
3.2.3.1. Stance of National Law on Choice of Law for Substantive Issues	98
3.2.3.1.1. General Regime of Choice of Law Rules of the Seat	98
3.2.3.1.2. Specialized Methods Provided by the Law of the Seat	99
3.2.3.1.3. Application of Choice of Law System that the Arbitral Tribunal Considers Appropriate	100
3.2.3.1.4. Direct Application of Substantive Law that the Arbitral Tribunal Considers Appropriate	101
3.2.3.2. Institutional Rules	102

4.	Law Applicable to the Agreement to Arbitrate	103
4.1.	Different Applicable Laws	103
4.2.	Law Applicable to Issues of Existence and Validity of an Arbitration Clause	104
4.2.1.	Existence of a Specific Choice of Law Agreement	104
4.2.2.	Absence of a Specific Choice of Law Agreement	104
4.2.2.1.	The Law of the Underlying Contract	104
4.2.2.2.	The Law of the Seat	105
4.2.2.3.	Closest Connection	106
4.2.2.4.	Direct Application of Principles of International Law	107
4.3.	Validation Principle	107

Chapter 6

	Arbitration Agreements	109
1.	Introduction	109
2.	Framework of International Arbitration Agreements	110
2.1.	Introduction	110
2.2.	Arbitration Agreements under the New York Convention	110
2.2.1.	Agreement in Writing, Signature and Exchange of Letters	111
2.2.2.	Existing or Future Disputes	112
2.2.3.	Defined Legal Relationship	112
2.2.4.	Arbitrability	112
2.3.	Arbitration Agreements under National Law	112
2.3.1.	Capacity	113
2.3.2.	Formation of Arbitration Agreements	113
2.3.3.	Formal Validity	114
2.3.4.	Substantive Validity of Arbitration Agreements	115
2.3.5.	Arbitrability	116
2.3.6.	Parties to Arbitration Agreements	117
2.3.6.1.	Group of Companies Doctrine	117
2.3.6.2.	Alter Ego Doctrine	118
2.3.6.3.	Equity and Good Faith Issues	118
2.3.6.4.	Assignments	118
2.4.	The Separability Doctrine	119
3.	Arbitration Agreements: Choosing and Drafting	120
3.1.	Introduction	120
3.2.	What Kind of Clause?	121
3.3.	Ad Hoc or Institutional Arbitration?	123
3.3.1.	Ad Hoc Arbitration	123
3.3.2.	Institutional Arbitration	124
3.4.	Scope of Arbitration Clause	126
3.5.	Choosing the Seat or Place of Arbitration	128
3.6.	Choosing the Applicable Substantive Law	129

Table of Contents

3.7.	Arbitrator Issues	130
3.7.1.	Choosing a Number of Arbitrators	130
3.7.2.	Arbitrator Designated in Arbitration Clause and Requirements	132
3.8.	Language	132
3.9.	Combination of Procedures	133
3.10.	Streamlining Institutional Rules	133
3.11.	Multiparty Issues	134
3.12.	Specific Issues in Relation to Arbitration Clauses for IP Disputes	135
3.12.1.	Confidentiality	135
3.12.2.	Arbitrability	136
3.12.3.	Appeal Mechanisms	136
3.12.4.	Standby Arbitral Tribunals	138
 Chapter 7		
The Arbitral Tribunal		141
1.	Establishment of the Arbitral Tribunal	141
1.1.	One of the Most Important Stages in Arbitration	141
1.2.	Number of Arbitrators	141
1.3.	One or Three Arbitrators?	142
1.4.	Methods of Appointment	144
1.4.1.	Appointment of Sole and Presiding Arbitrators	144
1.4.1.1.	Appointment by the Parties	144
1.4.1.2.	Appointment in Institutional Arbitrations	144
1.4.1.3.	Appointing Authority	145
1.4.1.4.	Appointment by Co-arbitrators	146
1.4.1.5.	Appointment by National Courts	146
1.4.2.	Selection of Party-Appointed Arbitrators	147
1.4.3.	Nomination of Party-Appointed Arbitrators in Multiparty Arbitrations	148
2.	Who Can Be an Arbitrator?	150
2.1.	Natural Person	150
2.2.	Capacity	150
2.3.	Legal Qualification	150
2.4.	Nationality	150
2.5.	Lack of Bias	151
2.6.	Requirements Agreed by the Parties	151
3.	Independence and Impartiality of Arbitrators	152
3.1.	A Fundamental Principle of International Arbitration	152
3.2.	Independence and/or Impartiality?	152
3.3.	Standard of Proof to Disqualify Arbitrators	154
3.4.	Disclosure Obligations	154
3.4.1.	Prior to Appointment	155
3.4.2.	Disclosure Obligation during the Conduct of the Proceedings	156

4.	Challenges to Arbitrators	156
4.1.	Procedure	156
4.1.1.	Pre-challenge Disclosures and Objections	156
4.1.2.	Resolution of Challenges	157
4.1.2.1.	Challenges under Institutional Rules	157
4.1.2.2.	Challenges under National Legislation	158
4.1.3.	Effect of a Successful Challenge	160
5.	Removal of Arbitrators	160
6.	Replacement of Arbitrators	161
6.1.	Procedure	161
6.2.	Consequences of Appointment of Replacement Arbitrators	162
7.	Truncated Tribunals	163
8.	Arbitrators' Remuneration and Expenses of the Tribunal	165
8.1.	Arbitrators' Right to Remuneration	165
8.2.	Cancellation Fees	166
8.3.	Expenses of the Arbitral Tribunal	166
8.4.	Deposits	167
9.	Obligations of Arbitrators	167
10.	Arbitrators Liability and Immunity	169
11.	Jurisdiction of the Arbitral Tribunal and the Competence-Competence Doctrine	170
11.1.	Introduction	170
11.2.	The Competence-Competence Doctrine	170
11.3.	Resolution of Jurisdictional Challenges by Arbitral Tribunals	172

Chapter 8

Organization and Conduct of Arbitral Proceedings and the Taking of Evidence

1.	Introduction	175
2.	Organization of the Proceedings in General	175
2.1.	Introduction	175
2.2.	Timeline and Structure of the Proceedings	177
2.3.	Bifurcation of the Proceedings	178
2.4.	Organization of Written Submissions	179
2.4.1.	Number and Sequence of Submissions	179
2.4.2.	Evidence in Support of Written Submissions	180
2.4.3.	Amendment of a Party's Case	181
2.5.	Organization of Production of Evidence	181
2.5.1.	Documentary Evidence and Disclosure	181
2.5.1.1.	Time and Form of Evidence	181
2.5.1.2.	Document Disclosure	181
2.5.2.	Witness Evidence	182
2.5.3.	Expert Evidence	182
2.6.	Determination of Language of the Proceedings	182
2.7.	Confidentiality	183

Table of Contents

2.8.	Partial Decisions in Relation to the Scope and Construction of Asserted IPR	183
2.9.	Creation of Standby Arbitral Tribunals	183
2.10.	Awards on Costs	183
2.11.	Deposits and Advance Payments	184
2.12.	Appointment of a Secretary to the Tribunal	184
2.13.	Other Potential Issues Relating to the Organization of the Proceedings in General	185
3.	Organization of the Evidentiary Hearing	185
3.1.	Opening and Closing Statements	186
3.2.	Sitting Hours and Time Allocation for the Hearing	186
3.3.	Sets of Documents for the Hearing	187
3.4.	Record of Contents of the Hearing	187
3.5.	Examination of Fact Witnesses and Experts	188
3.6.	Objections to Questions	188
3.7.	Presence of Witnesses or Experts during Examination of Other Witnesses or Experts	188
3.8.	Whether Witnesses and Experts Can Be Examined by Video-Link	189
3.9.	Whether the Witnesses and Experts Will Be Examined on Oath or Affirmation	189
3.10.	Use of Documents for Cross-Examination	190
3.11.	Interpreters	190
3.12.	Venue for the Hearing	190
3.13.	Tribunal's Cancellation Policy	190
3.14.	Issuance of Procedural Order Setting Out the Timeline for the Proceedings	190
4.	Cost-Controlling Measures	191
5.	The Conduct of the Proceedings and the Taking of Evidence	191
5.1.	Introduction	191
5.2.	The Conduct of the Proceedings According to Prevailing International Arbitration Practice	192
5.2.1.	Different Stages	192
5.2.2.	Commencement of Proceedings	192
5.2.2.1.	The Request for Arbitration	193
5.2.2.2.	Answer to the Request for Arbitration	194
5.2.2.3.	Determination of the Seat of the Proceedings	195
5.2.3.	Establishment of the Arbitral Tribunal	195
5.2.4.	Case Management Meeting, Procedural Order, and Terms of Reference	196
5.2.5.	Parties' Submissions	196
5.2.5.1.	Written Submissions	197
5.2.5.1.1.	Pre-hearing Submissions	197
5.2.5.1.2.	Post-hearing Submissions	198

5.2.5.2.	Oral Submissions	198
5.2.6.	The Taking of Evidence	199
5.2.6.1.	Introduction	199
5.2.6.2.	Burden and Standard of Proof	199
5.2.6.3.	Admissibility and Probative Value	200
5.2.6.4.	Documentary Evidence	201
5.2.6.4.1.	‘Document’ Defined	201
5.2.6.4.2.	Document Disclosure or Discovery	201
5.2.6.4.3.	Privilege	202
5.2.6.4.4.	Redfern Schedules	205
5.2.6.5.	Witnesses	205
5.2.6.5.1.	Who Can Be a Witness?	206
5.2.6.5.2.	Form and Examination of Witnesses	206
5.2.6.6.	Experts	208
5.2.6.6.1.	Introduction	208
5.2.6.6.2.	Party-Appointed Experts and Experts Appointed by the Tribunal	208
5.2.6.6.3.	Expert Tutorials for Arbitrators	210
5.2.6.7.	Agreed Primers, Models and Demonstrative Evidence	211
5.2.6.8.	Inspections and Site Visits	211
5.2.6.9.	Experiments	212
5.2.6.10.	Other Means of Presenting Evidence Particular to IP Disputes	212
5.2.7.	The Evidentiary Hearing	212
5.2.8.	Closing of the Proceedings	214
5.2.9.	The Award(s)	214
5.2.10.	Post-termination Issues	215
6.	Default Proceedings	215
7.	Fast-Track Arbitrations	217
8.	Assorted Issues Associated to the Conduct of the Proceedings	219
8.1.	Representation	219
8.2.	Consolidation of Parallel Arbitrations, Joinder and Third-Party Intervention	219
9.	Interim Relief	221
9.1.	Introduction	221
9.2.	Interim Measures Ordered by Arbitral Tribunals	221
9.2.1.	Normative Framework	221
9.2.2.	Different Measures that Tribunals May Grant	222
9.2.2.1.	Measures Aiming to Maintain the Status Quo or Prevent Harm	222

Table of Contents

9.2.2.2.	Orders Seeking to Ensure the Enforceability of the Award	223
9.2.2.3.	Preservation or Inspection of Property	224
9.2.2.4.	Security for Costs	224
9.2.2.5.	Interim Payments	224
9.2.3.	Prerequisites to Order Interim Measures	225
9.2.4.	Form of a Decision on Interim Relief	225
9.2.5.	Enforcement of Interim Measures	226
9.3.	Interim Measures Ordered by National Courts in Support of Arbitration	227

Chapter 9

Confidentiality of Arbitral Proceedings 229

1.	Introduction	229
2.	Confidential Arbitrations: Protection against Disclosures to Third Parties	230
2.1.	Only Certain Arbitrations Are both Private and Confidential	230
2.2.	Express Agreement of the Parties Providing for Confidentiality	232
2.3.	Confidentiality under Institutional Rules	232
2.3.1.	Arbitration Rules Providing for Comprehensive Confidentiality Obligations	233
2.3.1.1.	CIETAC Arbitration Rules	233
2.3.1.2.	German Institution of Arbitration (DIS)	233
2.3.1.3.	HKIAC Administered Arbitration Rules	233
2.3.1.4.	LCIA Rules	234
2.3.1.5.	Rules of Arbitration of the Swiss Chambers of Commerce ('Swiss Rules')	235
2.3.1.6.	WIPO Arbitration and Expedited Arbitration Rules	235
2.3.2.	Arbitration Rules that Do Not Impose Duties of Confidentiality upon the Parties	237
2.3.2.1.	AAA/ICDR Rules	237
2.3.2.2.	ICC Rules	237
2.3.2.3.	SCC Rules	238
2.3.2.4.	SIAC Rules	239
2.4.	Confidentiality under National Law	239
2.4.1.	Different Approaches in National Law	239
2.4.2.	Jurisdictions Generally Considering Arbitration Confidential	240
2.4.2.1.	England	240
2.4.2.2.	France	241
2.4.2.3.	New Zealand	243
2.4.2.4.	Scotland	243
2.4.2.5.	Singapore	244

	2.4.2.6.	Spain	244
	2.4.3.	Jurisdictions Where Arbitration Is Not Considered Confidential	245
	2.4.3.1.	Australia	245
	2.4.3.2.	Sweden	245
	2.4.3.3.	United States	247
2.5.		Practical Issues Arising from Confidential Arbitrations	247
	2.5.1.	Potential Gaps vis-à-vis Arbitrators, Lawyers and Experts	248
	2.5.1.1.	Ethical Rules and Implied Duties in Relation to Arbitrators	248
	2.5.1.2.	Ethical Rules in Relation to Lawyers and Privilege Issues	249
	2.5.1.3.	Duties of Secrecy Binding Professionals	250
	2.5.1.4.	Conclusion: Erring on the Side of Caution Is Preferable	251
	2.5.2.	Large Corporate Disputants as Parties	251
2.6.		Protecting Confidential Information in Non-confidential Arbitrations	251
2.7.		Limitations to Obligations of Confidentiality	252
	2.7.1.	Limitations in Relation to Express Confidentiality Agreements	252
	2.7.2.	Limitations in Institutional Rules Providing for Obligations of Confidentiality	254
	2.7.2.1.	WIPO Rules	254
	2.7.2.2.	LCIA Rules, Swiss Rules and HKIAC Administered Rules	254
	2.7.3.	Limitations in National Law Providing for Confidentiality	255
	2.7.3.1.	England	255
	2.7.3.2.	France	256
	2.7.3.3.	New Zealand	256
	2.7.3.4.	Scotland	257
	2.7.3.5.	Singapore	258
	2.7.4.	Protecting Sensitive Information if an Exception to Confidentiality Applies	258
3.		Protecting Confidential Information against Opposing Parties	259
	3.1.	Introduction	259
	3.2.	Framework for Protecting Information from the Parties to the Arbitration	260
	3.2.1.	General Powers to Conduct the Proceedings	260
	3.2.2.	Rules Containing Express Provisions	260
	3.2.2.1.	WIPO Rules	260
	3.2.2.2.	ICC Rules	262

Table of Contents

3.2.2.3.	IBA Rules on the Taking of Evidence in International Commercial Arbitration	262
3.3.	Practical Measures to Protect Confidential Information against Opposing Parties	263
3.3.1.	Ex Parte <i>Disclosures</i>	263
3.3.2.	Redaction of Documents	264
3.3.3.	Confidentiality Adviser	264
3.3.4.	Orders Protecting Confidential Information	264
3.3.5.	Confidentiality Agreements and Confidentiality Clubs	265
3.3.6.	Disclosures to External Lawyers or Advocates Only	265
4.	Breach and Enforcement of Obligations of Confidentiality and Protective Measures	266
4.1.	Relevant Elements in a Breach Analysis	266
4.1.1.	Scope of the Duty Breached According to Its Primary Source	267
4.1.2.	Applicable Law	267
4.1.3.	Nature of the Information Disclosed	268
4.1.4.	Type of Breach	268
4.2.	Jurisdiction to Pursue a Breach of Confidentiality Obligations and Protective Measures	269
4.3.	Interim Relief	269
4.4.	Permanent Remedies	270
4.4.1.	Damages	270
4.4.2.	Permanent Injunctions and Similar Measures	270
4.4.3.	Avoidance or Nullification of the Arbitration Agreement	271
4.5.	Other Possible Remedies	272

Chapter 10

The Making, Setting Aside, Recognition and Enforcement of Arbitral Awards

1.	Introduction	273
2.	International Arbitral Awards	274
2.1.	Types of Awards	274
2.1.1.	Final Awards	274
2.1.2.	Partial Awards	275
2.1.3.	Interlocutory Awards	276
2.1.4.	Default Awards	276
2.1.5.	Consent Awards	276
2.2.	The Decision-Making Process	277
2.2.1.	Sole Arbitrators, Multiple Arbitrators and Deliberations	277
2.2.2.	Unanimous Awards, Majority Awards and Awards by Presiding Arbitrator	279

2.2.3.	Separate and Dissenting Opinions	280
2.3.	Formal Aspects of Awards	281
2.3.1.	Requirements Contemplated by Most Rules and Laws	282
2.3.1.1.	Requirements in General	282
2.3.1.2.	Date of the Award	282
2.3.1.3.	Place at Which the Award Was Made	282
2.3.1.4.	Reasons	283
2.3.1.5.	Signature	284
2.3.2.	Contents of Awards in Practice	284
2.4.	Remedies in the Award	284
2.4.1.	General Aspects	284
2.4.2.	Monetary Compensation	285
2.4.3.	Interest	286
2.4.4.	Orders to Do Something or to Refrain from Doing Something, Specific Performance	287
2.4.4.1.	Common Law and Civil Law	287
2.4.4.2.	Arbitration Practice	288
2.4.5.	Declaratory Relief	292
2.4.6.	Punitive Damages, Statutory Damages, Penalties on Breach and <i>Astreintes</i>	292
2.5.	Cost Awards	293
2.6.	Time Limits for the Making of the Award	295
2.7.	Scrutiny of Awards by Administering Institutions	296
2.8.	Notification of the Award to the Parties	297
2.9.	Effects of Arbitral Awards	298
2.9.1.	Termination of the Tribunal's Jurisdiction	298
2.9.1.1.	Issues Rather than Dispute as a Whole	298
2.9.1.2.	Additional or Supplementary Awards	299
2.9.1.3.	Correction of the Award	300
2.9.1.4.	Interpretation of the Award	300
2.9.2.	Preclusion upon the Parties: <i>Res Judicata</i> and Issue Preclusion	301
3.	Setting Aside or Annulment of Arbitral Awards	302
3.1.	Introduction	302
3.2.	Appeal Mechanisms: Review of the Merits of a Decision	303
3.3.	Setting Aside or Annulling International Arbitral Awards	304
3.3.1.	Generalities, Courts and Time Limits	304
3.3.2.	Grounds for Setting Aside Awards	304
3.3.2.1.	Absence or Invalidity of the Arbitration Agreement	305
3.3.2.2.	Jurisdictional Issues: <i>Ultra Petita</i> and <i>Infra Petita</i>	305
3.3.2.3.	Procedural Issues	307
3.3.2.4.	Inarbitrability	309

Table of Contents

3.3.2.5.	Public Policy	309
3.3.3.	Consequences of a Court's Decision on Setting Aside Actions	310
4.	Recognition and Enforcement of Arbitral Awards	311
4.1.	Introduction	311
4.2.	Recognition and Enforcement of Foreign Awards under the New York Convention	311
4.2.1.	General Aspects	311
4.2.2.	Host Country's Jurisdiction	314
4.2.3.	Required Documentation	314
4.2.4.	Grounds to Refuse Recognition	314
4.2.4.1.	Invalidity of the Arbitration Agreement	315
4.2.4.2.	Procedural Fairness Issues	316
4.2.4.3.	Jurisdictional Issues: <i>Ultra Petita</i>	317
4.2.4.4.	Composition of the Arbitral Tribunal or Procedure Not in Accordance with the Arbitration Agreement or Relevant Law	318
4.2.4.5.	The Award Is Not Binding, Set Aside or Suspended	318
4.2.4.6.	Inarbitrability	320
4.2.4.7.	Public Policy	321
5.	Issues in Relation to Potential Compelled Enforcement of Awards Providing for Orders to Do Something or to Refrain from Doing Something	321
5.1.	Introduction	321
5.2.	Coercive Measures in Common Law Countries and Germanic Civil Law Countries	322
5.3.	Coercive Measures in French-Based Civil Law Countries	323
5.4.	Potential Issues Due to the Concomitance of Different Legal Systems	324
5.4.1.	Enforcement in Common Law Countries of Remedies Granted under the Laws of a Civil Law Country	324
5.4.2.	Enforcement in Civil Law Countries of Remedies Granted under the Laws of Common Law Countries	326
5.5.	Arbitral Tribunal's Retention of Jurisdiction	328
Chapter 11		
IP Mediation		331
1.	Introduction	331
2.	Generalities	332
2.1.	Alternative Dispute Resolution (ADR)	332
2.1.1.	Early Neutral Evaluation	332
2.1.2.	Med-Arb	333
2.1.3.	Arb-Med	334

2.2.	Key Features of Mediation	334
2.2.1.	Neutrality and Independence of the Mediator	334
2.2.2.	Voluntary	335
2.2.3.	Confidential and without Prejudice	337
2.3.	The Process of Mediation	339
2.3.1.	Preparation	339
2.3.1.1.	Venue	340
2.3.1.2.	Role of Lawyers	340
2.3.1.3.	Duration of Mediation	341
2.3.1.4.	Documentation	341
2.3.2.	Parties' Attitudes	342
2.3.3.	Attendance	342
2.3.4.	Phases and Procedure	344
2.3.4.1.	Contact with the Mediator Prior to the Mediation	344
2.3.4.2.	Initial Formalities	344
2.3.4.3.	Plenary Session	345
2.3.4.4.	Exploration Phase	346
2.3.4.5.	Negotiation Phase	346
2.3.4.6.	Settlement Phase	347
2.3.4.7.	No Settlement Outcome	348
2.3.5.	Mediation Approach: Facilitative or Evaluative?	348
2.3.6.	Utilizing the Mediator's Full Potential	349
3.	Mediation Providers and Rules	350
3.1.	Mediation Providers	350
3.2.	Mediation Rules	351
4.	Legal Framework	352
4.1.	ADR Escalation Clauses	352
4.1.1.	General Points on Escalation Clauses	352
4.1.1.1.	Precise Definition of ADR?	352
4.1.1.2.	Mandatory or Optional?	353
4.1.1.3.	Post-ADR Provision	353
4.1.2.	Sample Escalation Clauses	353
4.1.2.1.	WIPO	353
4.1.2.2.	LCIA	354
4.2.	Mediation Agreement	354
4.2.1.	Confidentiality	355
4.2.2.	Mediator: Appointment and Role	356
4.2.3.	Duty to Disclose	356
4.2.4.	Duration	356
4.2.5.	Voluntary Termination	356
4.2.6.	Settlement Agreements	357
4.2.7.	Miscellaneous Elements in a Mediation Agreement	357
4.3.	Settlement Agreements	358
4.3.1.	Validity	358

Table of Contents

	4.3.1.1.	Competition Law and Antitrust Issues	359
	4.3.1.2.	Criminal Conduct	360
	4.3.1.3.	General Compliance with Law	360
	4.3.1.4.	Mistake and Misrepresentation	360
	4.3.2.	Enforcement	361
	4.3.3.	Confidentiality	361
5.	Using Mediation for Resolving IP Disputes		362
5.1.	Benefits of Mediation for Resolution of IP Disputes		362
	5.1.1.	Speed	362
	5.1.2.	Cost	363
	5.1.3.	Control over the Process and the Outcome	363
	5.1.4.	Creative Settlement Possibilities	364
	5.1.1.1.	Licensing of New Territories	365
	5.1.1.2.	Cross-Licensing of Technology or Connected IPRs	366
	5.1.1.3.	Sponsorship Agreements	366
	5.1.1.4.	Sourcing of Information	366
	5.1.1.5.	Declarations as to Consent for Registration of Patents and Other Registered IPR	366
	5.1.1.6.	Avoidance of Adverse Consequences of a Termination for Cause, and Concluding Deadlock	367
	5.1.1.7.	Improving Commercial Relationships with Competitors	367
	5.1.5.	Cross-Jurisdiction Resolution in a Single Forum	367
	5.1.6.	Continuity of Relationship	368
	5.1.7.	Confidentiality	369
5.2.	Circumstances in Which Mediation is Particularly Suitable		369
5.3.	Limitations of Mediation		371
	5.3.1.	Matters Not Susceptible to Resolution by Mediation	371
	5.3.2.	Need for Legal Precedent	372
	5.3.3.	Remedy Required Unavailable at Mediation	372
	5.3.4.	Criminal Behaviour	373
	5.3.5.	Cost-Saving Less Critical When 'Stakes Are High'	373
6.	The Mediator		373
6.1.	Selection Considerations		374
	6.1.1.	Legal Experience	374
	6.1.2.	Technical Expertise and Background in the Industry or the Particular Type of IPR at Stake in the Dispute or in IP Generally	375
	6.1.3.	Commercial and Mediation Expertise	376

6.1.4.	Approaches to the Role and Personality Considerations	376
6.1.5.	Assurance of Neutrality	377
6.1.6.	Potential to Develop Rapport and Trust	377
6.1.7.	Availability	378
6.2.	Quality Standards and Training	378
7.	Mediation as an Aid to Arbitral Proceedings	380
7.1.	Right Time to Mediate	380
7.1.1.	Strategic Considerations	380
7.1.2.	Prior to Arbitration	381
7.1.3.	During Arbitration	382
7.1.4.	After Arbitration	383
7.2.	Are the Roles of Mediator (or Conciliator) and Arbitrator Interchangeable?	383
7.3.	Consent Awards and Termination of the Arbitral Proceedings	384
7.4.	Limitation Period	385
Appendix 1		
Convention on the Recognition and Enforcement of Foreign Arbitral Awards (New York Convention), 1958		387
Appendix 2		
WIPO Arbitration Rules, 2002		393
Appendix 3		
WIPO Expedited Arbitration Rules, 2002		421
Appendix 4		
WIPO Mediation Rules, 2002		445
Index		453