



**WIPO | ADR**

Arbitration  
and Mediation  
Center

## ■ WIPO Arbitration and Mediation – Selected Cases

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# WIPO ADR trademark case highlights

- **Recent increase in case numbers (Historically 17%)**
  - 23% in 2017; 35% in first half of 2018
- **Mediation most requested procedure: 67%**
  - Expedited arbitration: 14%
  - Arbitration: 9%
  - Expert determination: 9%
- **Top business areas: IT, Life Sciences, Manufactured Goods, Luxury Goods, and Entertainment**
- **Most common types of disputes: Licensing agreements, coexistence agreements, infringement, and trademark opposition before national IP Offices**
- **Contractual disputes: 65%; Non-contractual disputes 35%**

# Trademark Mediation – Non-contractual dispute

- **Dispute:** Trademark co-existence: to avoid confusion of similar trademarks and to regulate future use
- **Parties:** A US company, a Spanish company, and two Italian companies
- **Basis:** By submission agreement, parties agreed to WIPO Mediation
- **Process:**
  - Language of proceedings: English, Italian, and Spanish.
  - From list of candidates suggested by WIPO Center, parties selected mediator with specific expertise in European trademark law and fluent in relevant languages
  - Mediator met with parties in two-day session in Milan
- **Result:** Global settlement agreement covering all issues in dispute
- **Duration:** Four months

# Trademark Expedited Arbitration

- **Dispute:** Alleged breach of trademark licensing agreement
- **Parties:** Two Dutch companies and one Italian company
- **Basis:** WIPO Expedited Arbitration clause in the agreement
- **Process:**
  - Language of proceedings: English
  - Parties nominated Swiss lawyer as sole arbitrator (Article 14(a) of the WIPO Expedited Arbitration Rules)
  - A preparatory conference followed by a two-day hearing held in Zurich
- **Result:**
  - Award determined lack of jurisdiction over one party
  - Decided on validity of termination of licensing agreement
  - Terms to liquidate the contract between the other two parties
- **Duration:** Five months

# WIPO Center collaboration with IP Offices

- Raising awareness of ADR options
- ADR options in R&D model agreements
- Case administration
  - IPO internal/in collaboration with WIPO Center
  - Intellectual Property Office of Singapore (IPOS) mediation option for trademark proceedings
  - Joint dispute resolution procedure to facilitate the mediation of trademark opposition disputes before the Polish Patent Office (PPO)

# Trademark Mediation – IP Office proceedings

- **Dispute:** Longstanding cross-border commercial and IP dispute: oppositions to trademark application
- **Parties:** Singaporean company (Opposer), and commercially connected companies based in Indonesia, Malaysia and Singapore (Applicants)
- **Basis:** Parties agreed to submit all trademark oppositions into consolidated WIPO mediation, in order to resolve all outstanding proceedings
- **Process:**
  - Parties agreed to Singaporean IP lawyer proposed by WIPO Center as mediator
  - One-day mediation session in Singapore
- **Result:** Parties achieved regional settlement of trademark and other commercial disputes
- **Duration:** Four months

## Trademark Expert Determination – Trade Fairs

- **Dispute:** Trademark infringement and competition law issues
- **Parties:** A US multinational automotive company and a US engineering company
- **Basis:** Palexpo exhibitors contract providing for WIPO Fast-Track IP Dispute Resolution Procedure for Palexpo Trade Fairs
- **Process:**
  - Expert Panelist appointed from the WIPO List of Experts
  - Expert Panelist met with parties at Palexpo and drafted a decision which was notified to parties
- **Result:**
  - Respondent submitted a cease and desist declaration
  - Removal of infringing car
- **Duration:** 24 hours

# Further Information

- Queries: [arbiter.mail@wipo.int](mailto:arbiter.mail@wipo.int)
- Clauses: [www.wipo.int/amc/en/clauses](http://www.wipo.int/amc/en/clauses)
- Rules: [www.wipo.int/amc/en/rules](http://www.wipo.int/amc/en/rules)
- Neutrals and case examples: [www.wipo.int/amc](http://www.wipo.int/amc)
  
- WIPO Arbitration and Mediation Center Offices
  - Geneva, Switzerland
  - Singapore, Singapore

