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The Adoption of International Arbitration as the Preferred ADR Process in the Resolution of International Intellectual Property Disputes

Abstract: This article, which is intended for arbitration practitioners, demonstrates that international arbitration as a subset of the field of alternative dispute resolution (ADR) offers a useful toolkit for the expeditious resolution of international intellectual property law disputes. The article demonstrates how the theory and practice of international arbitration is particularly well poised to address some of the specific considerations and requirements of paramount concern to the international intellectual property lawyers and their clients. The article will explain how the inherent features of the international arbitration legal landscape combine to indicate that it should be considered as the preferred method of ADR and explain how each of these features can provide both time and cost efficiencies. The article will identify the legal reasoning behind the benefits inherent to choosing international arbitration and will also address those circumstances when international arbitration may be precluded or otherwise considered unsuitable for intellectual property matters. The article examines several distinct benefits that international arbitration uniquely offers to international intellectual property law users and highlights some areas of the field that require additional caution.
Keywords: ADR, arbitration, commercial law, dispute resolution, intellectual property

Introduction

International intellectual property disputes mostly reside in a nebulous legal space between the domestic law from which the right is derived and the international commercial law from which it is placed into the international marketplace. This article will examine how international arbitration can offer significant benefits to

the intellectual property lawyers and their clients and will place these concerns in an intellectual property business dispute management perspective. This article does not aim to define or delineate the characteristics or qualities of international intellectual property law or delimit the types of transactions that can involve this subject matter. Rather, the article will demonstrate how the theory and practice of international arbitration law is particularly well poised to address some of the specific considerations and requirements that are of paramount concern to the international intellectual property practitioner and their clientele. The article will explain how the inherent features of the international arbitration legal landscape combine to indicate that it should be considered as the preferred method of ADR and explain how each of these features can provide both time and cost efficiencies. The article will identify the legal reasoning behind the benefits inherent to choosing international arbitration and will also address those circumstances when international arbitration may be precluded or otherwise considered unsuitable for intellectual property matters. Lastly, attention will be drawn to the features of international arbitration that are most beneficial and detrimental for practitioners and their clientele in the resolution of international intellectual property matters.

1. International Intellectual Property Law and the Possibilities of Alternative Dispute Resolution (ADR)

Intellectual property is a term utilised to describe a 'seemingly disparate collection of legal rights'.[1] The definition of intellectual property on a universal or international basis presents an inherent problem because the conception of these rights, until recently, was exclusively premised on domestic law. Resultantly, there is a great disparity between the availability and duration of rights depending on the particular circumstances existing in the domestic jurisdiction where protection is sought. The Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS Agreement)[2] provides an international legal framework for recognition and regulation of intellectual property as well as common definitions.[3] The TRIPS Agreement defines roughly seven distinct types of rights, namely: copyright and

1 C. Waelde et al., Contemporary Intellectual Property: Law and Policy 3rd ed., Oxford 2013, p. 5.

2 TRIPS: Agreement on Trade-Related Aspects of Intellectual Property Rights, 15 April 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, The Legal Texts: The Results of the Uruguay Round of Multilateral Trade Negotiations 320 (1999), 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) [hereinafter TRIPS Agreement].

3 *Ibidem,* art. 1(2).

related rights[4], trademarks[5], geographical indications,[6] industrial designs[7], patents[8], layout designs[9] and trade secrets[10]. What can be discerned in common amongst all of these types of international intellectual property rights is that they protect moral, social and economic interests.[11] The other common feature of international intellectual property rights is that they uniquely straddle public and private interests, in that there is a public grant of an exclusive private property right of a specified duration and a somewhat qualified private right of self-determination as to how to use and transfer that state-created property. While it is the creator or inventor who provides the definition and substance of the intellectual property right, it is the state that is charged with delivering and delineating the duration, scope and types of available protection.

The possibility for the use of alternative dispute resolution (ADR) in international intellectual property law is not limited to a specific category of rights. Even more importantly, ADR in the field of intellectual property law is not limited to a specific dispute or set of disputes and can deal with whatever scope the parties assign to its authority. Moreover, the use of ADR, dissimilar to a domestic legal system, is not necessarily constrained in geographical or jurisdictional scope and does not necessarily need to utilise and respect traditional conflict of laws rules or the dictates of private international law. ADR as a tool for resolving intellectual property law disputes can be as conceptually wide or as narrow as the parties choose to delineate in their dispute resolution clause or agreements to submit a claim or claims to ADR.[12] This article will demonstrate how alternative dispute resolution, in particular international arbitration, can be utilised to remove intellectual property disputes from the archaic system of domestic peculiarity to a place where bundles of rights and multiple disputes can be simultaneously resolved in a manner that meets the demands of a truly globalised marketplace. 'Intellectual property disputes can scare away potential investors or ruin an acquisition or initial public offering'[13]; however, the strategic use of ADR in the form of international arbitration can help to manage these problems and abate those lasting consequences.

4 *Ibidem,* arts. 9–14.
5 *Ibidem,* 2, arts. 15–21.
6 *Ibidem*, arts. 22–24.
7 *Ibidem*, arts. 25–26.
8 *Ibidem*, arts. 27–34.
9 *Ibidem*, arts. 35–38.
10 *Ibidem*, art. 39.
11 *See* C. Waelde et al., Contemporary …, *op. cit.*, pp. 7–8.
12 W. Fox Jr., International Commercial Agreements: A Primer on Drafting, Negotiating, and Resolving Disputes 3rd ed., The Hague 1998, p. 171.
13 J.C. Milleret et al., The Handbook of Nanotechnology, Hoboken 2005, p. 254 (2005), *referencing* A.E. Silverman, Intellectual Property Law and the Venture Capital Process, "High Technology Law Journal" 1989, vol. 5, no. 1, pp. 157–92.

2. Adopting the ADR Perspective: the Pathway to International Arbitration

A management perspective typically foresees an intellectual property law contract from a purely profit-making motive in that the steps to a successful licensing strategy are: '[F]irst … the identification of a licensable opportunity, which may require the patent owner to sue people, or threaten to sue people, or to license the technology … second … the strategy of how you're going to realize the value from the patents … [a]nd … third … is the implementation … [k]eep[ing] in mind that it's a lot easier to identify the dollar potential of a technology than to identify when licensing revenue is going to come in.'[14]

It is, however, equally vital at the outset of negotiation or contract planning processes to consider that everything will not necessarily run as predicted and legal disputes will occur and perhaps even become commonplace – making it essential to conceptualise *how* and *when* these intellectual property disputes will be resolved, and *what* is the most cost- and time-efficient mechanism on the market. How disputes are resolved and whether enforcement of a judgement in foreign jurisdictions is possible will undoubtedly affect the financial bottom line of all intellectual property transactions. In this regard has been noted that: 'Managing litigation costs for the long term requires the firm to evaluate its portfolio strategically, looking ahead several years at the kinds of products or services it wants to offer in order to determine the evolution of its patent [or other intellectual property rights] position.'[15]

In order to address these strategic and operational concerns, managers of intellectual property can deal with ADR at two distinct levels.

The first level is that of the corporate philosophy or litigation outlook. Entities holding or managing intellectual property must make internal decisions about corporate governance that dictate how the organisation responds to potential or present disputes. As companies holding significant amounts of intellectual property rights move away from being '"product-revenue only" firm[s]' to instead obtain 'significant revenue from licensing … intellectual property' and resultantly the exposure to international contractual disputes increases exponentially, it will become essential to orient the corporate culture towards alternatives to international litigation.[16] For instance, DuPont, a Fortune 500 company[17] and one of the largest proprietary technology companies in the world that presently holds the rights and

14 J.L. David & S. Harrison, Edison in the Boardroom: How Leading Companies Realize Value from Their Intellectual Assets, Hoboken 2001, p. 75.

15 P.H. Sullivan, Value-Drive Intellectual Capital: How to Convert Intangible Corporate Assets into Market Value, United States 2000, p. 71.

16 S.S. Harrison & P.H. Sullivan Sr., United Einstein in the Boardroom – Moving Beyond Intellectual Capital to I-Stuff, United States 2006, p. 62.

17 Fortune Magazine Global 500 2021, http://fortune.com/global500/dupont-320/ (10.05.2021).

accompanying contracts related to a vast catalogue of intellectual property, decided to embark on what it has entitled a 'Sustainable ADR Culture'.[18] Responding to studies and research about the effect of disputes on the corporate bottom line, DuPont's corporate executives' realisation aptly demonstrates the incorporation of a holistic ADR approach at the corporate level into an intellectual property driven environment in that:

> While an intellectual understanding of ADR's benefits is helpful, empowering more than 200 lawyers around the globe to practice high-quality ADR and create a sustainable culture to support it into the future requires nuts and bolts, policies and procedures that are clear, detailed, and practical.
>
> In 2011, we realized that DuPont's multiplicity of cross-border contracts probably had outstripped any updated available internal guidance on how to contract for alternative dispute resolution. My colleague and boss Tom Sager commissioned a Global ADR Team to create what we initially conceived as a short guide for how to craft ADR clauses in contracts worldwide.[19]

That proposed 'short guide' became a 58,000-word manual that is now used across DuPont's offices worldwide.[20] A corporation that has adopted this type of pro-ADR stance should ensure that the dispute resolution clause is not given the typical short shrift at the end of a contractual negotiation and simply boiler-plated into an otherwise well thought out intellectual property agreement. Instead, a corporate-level ADR orientation should ensure that the use of dispute resolution is given priority as part of the organisational psychology and overall daily business framework. Theoretically, this pro-ADR corporate stance will permeate into the climate of overall corporate contracting – placing dispute resolution as a priority at the front end of a contractual relationship – shifting the paradigm of addressing ADR into a period of goodwill and observance during and shortly after initial contract negotiation – rather than having ADR arise in response to an eventual breach as an alternative to proposed litigation.

The second level at which the intellectual property manager should consider ADR is the contractual level. Irrespective of whether a corporate philosophy dictates that ADR should be prioritised, there are distinct protection benefits to be reaped from customising ADR clauses in intellectual property contracts. '[M]anaging uncertainty should be the cornerstone of … negotiation strategy'[21] to ensure that the important nuances of intellectual property rights protection are adequately dealt

18 The DuPont Company's Development of ADR Usage: From Theory to Practice, http://www.americanbar.org/publications/dispute_resolution_magazine/2014/spring/the-dupont-company-s-development-of-adr-usage--from-theory-to-pra.html (3.04.2015).

19 *Ibidem.*

20 *Ibidem. See also*, DuPont Global ADR Guide (Internal Document). This part of the document is not generally available to the public and was disclosed as a result of email correspondence with one of the users.

21 M. Wheeler, The Art of Negotiation: How to Improvise Agreement in a Chaotic World, United States 2013, p. 13.

with so as to prime or customise a proposed arbitration clause to serve as a vehicle for adequate international protection. To achieve this clausal specification, those managing the negotiation of contracts may need to override 'a temptation amongst non-contentious lawyers [whether in-house or outside counsel] to assume that ADR solely concerns litigation and is therefore not within their concern or province' since it is these lawyers that will bear primary responsibility for the drafting of the commercial agreement.[22] Negotiating the dispute resolution clause may for instance ensure that a particular law is designated that is favourable to a particular type of intellectual property to be licensed. It also allows the parties the flexibility to agree that a prospective arbitration should be administered by or held in a particular arbitral institution or to proceed on specific arbitral rules that are oriented towards the resolution of intellectual property disputes.[23] In the absence of any contract or even after a contract is adopted, a manager seeking to submit an intellectual property dispute to ADR must remain seized of potential litigation risks because: 'The ability to know when and how a company is at risk of infringement liability is important. Perhaps of even greater importance is whether potential litigants are infringing upon the firm's intellectual property and whether the competitor has previously signed a non-disclosure agreement or is party to a contract or supplier agreement. All of this information, when correlated, is part of the creation of a viable litigation avoidance capability.'[24]

Part and parcel of this litigation avoidance strategy will be the manager's ability to 'implement an IP enforcement strategy that is proactive',[25] having at hand a viable toolkit containing alternative methods for resolving these complex disputes, whether in the form of submission to arbitration, expert determination, or referral to mediation.[26]

3. From ADR to Arbitration: International Arbitration as the Preferred Form of ADR for International Intellectual Property Disputes

A successfully executed arbitration clause resulting in an international arbitration award has the potential to leave parties in a state of legal certainty that has no modern equivalent in any system of domestic, regional or international law. A matter properly

22 K. Mackie et al., The ADR Practice Guide: Commercial Dispute Resolution, United States 2002, p. 123.

23 *See, e.g.*, WIPO Alternative Dispute Resolution (ADR) for Intellectual Property Offices, https://www.wipo.int/amc/en/center/specific-sectors/ipoffices/ (10.05.2021).

24 P. H. Sullivan, Value-Driven …, *op. cit.*, p. 219.

25 R. D. Ryder & A. Madhavan, Intellectual Property and Business: The Power of Intangible Assets, United States 2014, pp. 119–20.

26 *Ibidem,* pp. 113–18. *Nota Bene:* Reference is made to both mediation and arbitration as possible proactive intellectual property enforcement strategies.

resolved by arbitration not only leaves the matter *res judicata*[27], however; provided it is conducted in a state party to the Convention on the Recognition and Enforcement of Foreign Arbitral Awards[28] (New York Convention), and it is both international[29] and in writing[30], it leaves the resulting award cognisable and enforceable in 168 reciprocal jurisdictions.[31] The reciprocal recognition and enforcement available in

27 For a more comprehensive discussion on the qualities of finality in international commercial arbitration *see*, T. Cook & A.I. Garcia, Intellectual Property Arbitration, Netherlands 2010, pp. 38–41. *See also*, G.R. Shell, Res Judicata and Collateral Estoppel Effects of Commercial Arbitration, "UCLA Law Review" 1988, vol. 35, p. 623. This article offers a more specific discussion on the relationship between the concept of *res judicata* and the practice of international commercial arbitration.

28 Convention on the Recognition and Enforcement of Foreign Arbitral Awards, 10 June 1958, 21 U.S.T. 2519, 330 U.N.T.S. 3 [hereinafter New York Convention].

29 *Nota Bene:* To 'internationalise' arbitration there are two factors to be examined. The first factor is the nationality of the parties. The second factor, the nature of the dispute, must be examined to determine whether there is an obligation imposed by the contract that 'extend(s) beyond national borders' or the very wide definition adopted by the French that it 'involves the interests of international trade'. For a full explanation *see*, R.N. Blackaby et al., Redfern and Hunter on International Arbitration, Student Edition, Oxford 2009, p. 14.

30 New York Convention, *op. cit.*, Article II(2). For a further explanation *see* A. J. van den Berg, The New York Convention of 1958: An Overview, pp. 6–9, http://www.arbitration-icca.org/media/0/12125884227980/new_york_convention_of_1958_overview.pdf (27.04.2015). According the first paragraph of Article II, an 'agreement in writing' encompasses an agreement 'under which the parties undertake to submit to arbitration all or any differences which have arisen or which may arise between them'. This statement has the effect that the New York Convention treats both the submission agreement (*acte de compromis*) by which an already existing dispute is referred to arbitration and the arbitration clause (*clause compromissoire*) by which a possible future dispute shall be submitted to arbitration as having equivalent legal status.

31 The signatory status of the treaty reflects that there are currently 168 states parties to the New York Convention, http://www.newyorkconvention.org/new-york-convention-countries/contracting-states and http://www.newyorkconvention.org/contracting-states/list-of-contracting-states (10.05.2021). While the New York Convention offers the most widespread universal coverage for an arbitration award, parties should also have regard to regional instruments that may provide additional or more nuanced reciprocity. In this connection the website provides references to treaties of interest. In particular, *see also,* 1991: Mercosur Treaties – Treaty Establishing a Common Market Between the Argentine Republic, the Federal Republic of Brazil, the Republic of Paraguay and the Eastern Republic of Uruguay, 1979: Montevideo Convention – Inter-American Convention on the Extraterritorial Validity of Foreign Judgments and Arbitral Awards, 1975: Panama Convention – Inter-American Convention on International Commercial Arbitration, 1972: Moscow Convention – Convention on the Settlement by Arbitration of Civil Law Disputes Resulting from Relations of Economic and Scientific-Technical Cooperation, 1969: Vienna Convention – Vienna Convention on the Law of Treaties, 1965: Washington Convention – Convention on the Settlement of Investment Disputes between States and Nationals of Other States, 1961: Geneva Convention – European Convention on International Commercial Arbitration, 1927: Geneva Convention – Convention on the Execution of Foreign Arbitral Awards, 1923: Geneva Protocol – Protocol on Arbitration Clauses http://www.newyorkconvention.org/other-relevant-conventions (10.05.2021).

the New York Convention is a unique feature of the arbitration landscape as there is no international equivalent for a domestically litigated outcome or mediated settlement agreement and there is unlikely to be an equivalent in the foreseeable future. According to the World Intellectual Property Organization, intellectual property disputes tend to share international, technical, urgent, confidential and reputational characteristics accompanied by a need for decisional finality.[32] These features together lend themselves to the use of international arbitration as a primary means of dispute resolution,[33] in particular because arbitration: '[P]rovides a single neutral forum in which intellectual property disputes involving different national markets and parties from different countries can be [conclusively] resolved … [since] neither party is likely to want to litigate in the other party's courts, and a single forum may be preferable to a multiplicity of national court actions for disputes involving different national and regional intellectual property titles covering the same subject matter.'[34]

Moreover, arbitration removes potential disputes from the ambit of the domestic court systems of developing or other countries where the judges are often inadequately trained, inexperienced or overburdened and cannot as such expeditiously or properly adjudicate or opine on matters of intellectual property law.[35] In this way international arbitration offers the intellectual property manager a private contractual alterative to a known public risk.

The type of legal certainty offered by arbitration is particularly crucial for resolving disputes that involve intellectual property rights.[36] All intellectual property rights inherently have strictly constructed timeframe limitations on the grants of exclusivity. Elongated international litigation can undoubtedly affect the ability of the parties to confidently exploit, license, market and use a right which has both a negative private and public impact; the owner cannot exploit their property for profit while society cannot benefit from access to the creation.[37]

In addition to the privileged reciprocal position of international awards, arbitration clauses also benefit from an essential 'separability' from the main contract. The doctrine of 'separability' or '*l'autonomie de la clause compromissoire*'

32 World Intellectual Property Organization, Why Arbitration in Intellectual Property?, available at http://www.wipo.int/amc/en/arbitration/why-is-arb.html (10.05.21).

33 *Ibidem.*

34 R.H. Smit, General Commentary on the WIPO Arbitration Rules, Recommended Clauses, General Provisions and the WIPO Expedited Arbitration Rules: Articles 1 to 5; Articles 39 and 40, (in:) H. Smit (ed.), WIPO Arbitration Rules: Commentary and Analyses, Huntington, NY 2009, pp. 5–6.

35 *See e.g.*, X. Li, Ten Misconceptions About the Enforcement of Intellectual Property Rights, (in:) X. Li & C.M. Correa (eds), Intellectual Property Enforcement: International Perspectives, Northampton, MA 2009, pp. 33–34.

36 R.D. Ryder & A. Madhavan, Intellectual Property …, *op. cit.*, p. 118.

37 R.H. Smit, General Commentary …, *op. cit.*, p. 5.

is a cornerstone of international arbitration. It exists in most jurisdictions including both the UNCITRAL Model Law[38] Art. 16(2) and in the United States[39] to prevent the subversion of the arbitration clause 'by questioning in court the existence or validity of the main contract'.[40] In legal theory 'separability' can be conceived of either a contract that contains an autonomous and 'separable' surviving element or that there is a second collateral contract contained in the arbitration clause. For instance, UNCITRAL Model Law[41] states that 'an arbitration clause which forms part of a contract shall be treated as an agreement independent of the other terms of the contract'. Of all the forms of ADR, 'only in the case of arbitration do parties know that they will obtain a decision'.[42] Resultantly, arbitration is a very dependable and predictable form of dispute resolution since the legal vulnerabilities of the underlying contract are irrelevant to invoking the clause at the point of dispute and needing to succumb to the designated arbitration process contained therein.[43]

Another cornerstone of international arbitration beneficial for the intellectual property law user is the doctrine of competence-competence.[44] This doctrine permits the arbitration panel to rule on the nature and extent of their own jurisdiction. In jurisdictions that have adopted the UNCITRAL Model Law[45] the position of competence-competence is rather clear. The UNCITRAL Model Law expressly affords competence-competence powers to the arbitrators.[46] The UNCITRAL Model Law Art 16(3) also makes available the possibility of simultaneous judicial review[47] enabling parties to save time and money, which are the chief concerns from the business perspective of an intellectual property manager and may be the impetus for choosing a UNCITRAL Model Law country as an arbitral seat.[48]

38 U.N. Commission on International Trade Law, Report on its 39th Session, 19 June-7 July 2006, U.N. Doc. A/61/17 (14 July 2006) [hereinafter UNCITRAL Model Law]. As of this writing, legislation based on the Model Law has been adopted in 67 states in a total of 97 jurisdictions. A detailed jurisdictional breakdown is available at http://www.uncitral.org/uncitral/en/uncitral_texts/arbitration/1985Model_arbitration_status.html (27.04.2015).

39 *See*, Prima Paint Corp. v. Flood & Conklin Mfg. Co., 388 U.S. 395 (1967). *See also*, Buckeye Check Cashing Inc. v. Cardegna, 546 U.S. 440 (2006).

40 R.N. Blackaby et al., Redfern and Hunter on International Arbitration, Student Edition, Oxford 2009, pp. 162–63.

41 UNCITRAL Model Law, *op. cit.*, art. 16(1).

42 A. Lloreda, Exploring Alternative Dispute Resolution, (in:) L.G. Bryer et al. (eds.), Intellectual Property Strategies for the 21st Century Corporation: A Shift in Strategic and Financial Management, Hoboken 2011, p. 194.

43 *See*, R. H. Smit, General Commentary …, *op. cit.*, p. 5.

44 *Nota Bene*: Also commonly known by the German 'kompetenz-kompetenz'.

45 *See*, A. Lloreda, Exploring…, *op. cit.* and accompanying text.

46 UNCITRAL Model Law, *op. cit.*, art. 16(1).

47 *Nota Bene*: Judicial review can be commenced at the same time as the arbitration of the substantive claim.

48 R.D. Ryder & A. Madhavan, Intellectual Property …, *op. cit.*, p. 118.

In order to give effect to a qualified possibility of competence-competence doctrine in U.S. law under the Federal Arbitration Act[49], the Supreme Court has artfully navigated the language[50] that assigns the courts the authority to determine whether the parties have in fact agreed to arbitration.[51] Following the decisions in *ATT Corp. v. Communication Workers of America*[52] and *First Options of Chicago, Inc. v. Kaplan*[53] the Supreme Court has established a requirement that an arbitration clause expressly indicates in clear and unmistakable language that the parties intend to delegate the competence to decide issues of arbitrability to the arbitration panel.[54] U.S. courts have found that incorporating arbitration rules that specifically allow for competence-competence into the arbitration clause is sufficient to meet this threshold.[55] In the *Rent-A-Center, West, Inc. v. Jackson* [56] decision, the Supreme Court presented the legal theoretical construction of the delegation clause as being a distinct instrument within the arbitration clause that is considered to have its own element of 'separability', allowing for the arbitration panel to have the competence to decide the ambit of their own jurisdiction independent of concluding the question clausal validity. However, in *Rent-A-Center*, the Supreme Court declined to resolve the exact ambit of a permissible delegation.[57] Resultantly, the rather wide language used by the Supreme Court in *First Options*[58] is open to interpretation by lower courts, some of which have gone as far as allowing parties to, in their arbitration clause, clearly and unmistakably designate that the arbitration panel has the inherent competence to determine the existence and validity of the arbitration agreement itself.[59]

49 U.S. Code > Title 9 Arbitration > CHAPTER 1—GENERAL PROVISIONS (§§ 1–16).

50 U.S. Code > Title 9 Arbitration > CHAPTER 1—GENERAL PROVISIONS (§ 4). Failure to arbitrate under agreement; petition to United States court having jurisdiction for order to compel arbitration; notice and service thereof; hearing and determination.

51 For a more complete discussion of the evolution of competence-competence in U.S. arbitration law *see* G. B. Born, International Commercial Arbitration in The United States: Commentary and Materials, New York 1994, pp. 231–84.

52 AT&T Techs., Inc. v. Commc'ns Workers of Am., 475 U.S. 643 (1986).

53 First Options of Chi., Inc. v. Kaplan, 514 U.S. 938, p. 943 (1995).

54 AT&T Techs. …, *op. cit.*, p. 649.

55 J.M. Graves, Competence-Competence and Separability – American Style, (in:) S. Kröll et al. (eds), International Arbitration and International Commercial Law: Synergy, Convergence and Evolution, Netherlands 2011, p. 162.

56 Rent-a-Ctr., W., Inc. v. Jackson, 130 S. Ct. 2772, p. 2779 (2010).

57 *Ibidem*. p. 2778.

58 First Options of Chi., Inc. v. Kaplan, *op. cit.*, p. 939.

59 *See, e.g.,* Riley Mfg. Co. v. Anchor Glass Container Corp., 157 F.3d 775, 779 (10th Cir. 1998), *and* Abram Landau Real Estate v. Bevonna, 123 F.3d 69, 73 (2nd Cir. 1997). For a more comprehensive treatment s*ee also*, G. A. Bermann, The 'Gateway' Problem in International Commercial Arbitration, "Yale Journal of International Law" 2012, vol. 1, 37, no.1, p. 39. *Nota Bene*: In footnote 174, Bermann analyses these cases and makes the point that not all lower courts take such a permissive reading of First Options and compared these cases with China Minmetals Materials Imp. & Exp. Co. v. Chi Mei Corp., 334 F.3d 274, 287–88 (3rd Cir. 2003), *and* Sphere Drake Ins. Ltd.

The dependability of having an award that is internationally cognisable and enforceable under the New York Convention, together with the essential doctrines of separability and competence-competence, make arbitration the safest and most predictable method of dispute resolution. Certainly, from an intellectual property perspective, these core unique features of the arbitration landscape combine to make arbitration preferable to mediation, where there is absolutely no certainty that there would be any result and there are inherent issues of cross-border enforceability of any resulting settlement agreement.[60]

4. Arbitrating Intellectual Property Disputes

International intellectual property disputes generally come to arbitration in one of three ways. The way in which intellectual property disputes come to arbitration often affects the nature and scope of the proceedings. It also affects parties' ability to control the content, process and apparatus of the arbitration.

Firstly, some international intellectual property matters can be subject to compulsory arbitration.[61] An example of compulsory arbitration is the ICAAN Uniform Domain Name Dispute Resolution Policy[62], which operates in relation to the resolution of a number of trademark-based domain-name disputes and in particular '[d]isputes alleged to arise from abusive registrations of domain names (for example, cybersquatting) [that] may be addressed by expedited administrative proceedings that the holder of trademark rights initiates by filing a complaint with an approved dispute-resolution service provider'.[63] The push for compulsory arbitration is on the upward trend in the international intellectual property area with disputes over fair, reasonable and non-discriminatory licence obligations for standard-essential patents[64] headed in the direction of referral to compulsory arbitrations.[65]

Secondly, international intellectual property disputes may come to arbitration by a written agreement of the parties to a dispute or disputes that submits them

v. All Am. Ins. Co., 256 F.3d 587, 591 (7th Cir. 2001), where the lower courts held that when parties contested the existence of the arbitration agreement, they were entitled to a judicial hearing. In Sphere there was a special issue of contractual agency that further distinguishes that decision.

60 R.D. Ryder, A. Madhavan, Intellectual Property…, *op. cit.*, p. 118.

61 This article will not deal further with the specific scenarios of referral to compulsory arbitration.

62 Uniform Domain Name Dispute Resolution Policy as Approved by ICANN on 24 October 1999, available at https://www.icann.org/resources/pages/policy-2012-02-25-en (10.05.2021).

63 *Ibidem.*

64 *Nota Bene:* More commonly known by the term 'FRAND Disputes'.

65 *See*, V. Mascarenhas, Using 'Baseball Arbitration' to Resolve FRAND Disputes, "Corporate Counsel" 2015 http://www.kslaw.com/imageserver/KSPublic/library/publication/2015articles/2–11-15_CorpCounsel_Mascarenhas.pdf (5.04.2015). *See also*, G. Blanke, Samsung Electronics offers arbitration commitment under article 9 of Regulation 1/2003, "Global Competition Litigation Review" 2014, vol. 7 no. 2 pp. 27–28.

to arbitration. Typically, this submission agreement will specify, as required, the institution, arbitration law, substantive law, rules, *situs* and any other matters necessary for an arbitration to take place.[66] This type of agreement would be the preferable method of voluntarily consolidating several intellectual property disputes in one or several jurisdictions into a single matter to be decided by a single panel of arbitrators.

Thirdly, a dispute resolution or arbitration clause can be placed in any contract between parties that mandates arbitration for all or some matters that make up the substance of that contractual relationship. The remainder of this article will be focused on this third aspect of the utility of negotiating, optimising and drafting these dispute resolution or arbitration clauses as a pathway to resolving international intellectual property disputes. The category of submission agreements, while having a similar content and effect to contractual arbitration clauses, are rarely if ever drafted in a set of optimal circumstances that will allow for a full customisation of the arbitration schematic to meet all the peculiarities of intellectual property rights.

5. Subject Matter Arbitrability and the Intellectual Property Preclusion

Whether drafting a submission agreement or writing an arbitration clause the issue of subject matter arbitrability must be considered in relation to the domestic law of the intellectual property right that is to become the subject of the arbitration clause. Subject matter arbitrability must also be considered in the designation of the *situs* or law governing the arbitration. To avoid negligence, organisations and management dealing with intellectual property 'should be aware of the risks to its customers or suppliers inherent in business operations'[67] and a poorly drafted or ineffectual arbitration clause is no exception.

To understand the notion of preclusion of certain subject matter from being arbitrable one should turn to the public–private interest dichotomy[68] that is inherent in intellectual property law disputes. This dichotomy is helpful in understanding the nature of disputes that arise in intellectual property law because litigated intellectual property conflicts tend to divide along these bright lines. It must be said at this point that the public–private interest dichotomy can be essential at the outset to understanding when, whether and to what extent it is appropriate or possible to use

66 M.L. Moses, The Principles and Practice of International Commercial Arbitration, Cambridge 2008, pp. 40–42. *Nota Bene*: As a creature of the law of contract, arbitration clauses have 'essential requirements' without which an arbitration clause cannot be executed or take effect.

67 P.D. Shaw, Managing Legal and Security Risks in Computing and Communications, Oxford 1998, p. 70.

68 *See* e.g., C. McSherry, Who Owns Academic Work, Cambridge, MA 2001, pp. 28–32. The author provides examples and a discussion of this dichotomous relationship and public–private tension within the contemporary intellectual property field.

ADR, and in particular international arbitration, in place of recourse to the domestic courts.

Disputes having a public interest character generally arise when the basis or extent of the grant or denial of an intellectual property right is at issue. Disputes having a private interest character generally arise when the owners of a right are seeking to avail themselves of their grants of protection in the marketplace whether assigning, licensing, retaining or preventing unauthorised use of a claimed or established right. For the purposes of arbitration, this public and private law dichotomy often determines or should be considered when determining whether the conflict is one that only a state can render a final valid answer upon or is the type that can be resolved between the parties without the need for a definitive answer from the domestic authorities granting or courts upholding the underlying intellectual property right. Similarly, the choice of law rules of many states have been equally deferent to the territorial nature of intellectual property rights,[69] with the courts reluctant to provide a forum for the resolution of foreign intellectual property matters.[70] While not all states permit intellectual property matters of any form to be arbitrated, at least conceptually, in the case of a contractual breach a matter will clearly be a private matter eminently capable of determination by arbitration. Equally, when the ownership and parameters of an intellectual property right are clear, a matter alleging infringement of a right will be capable of being submitted to arbitration by agreement of the parties to the dispute. An indication of where international arbitration law may be headed can be found in *Lucasfilm v. Ainsworth*[71], where the UK Supreme Court finally recognised the ability in private international law for parties to bring a UK infringement action based on foreign intellectual property law when the issue of validity was clear and there would otherwise be jurisdiction *in personam*. However, the problem of subject matter arbitrability (as with jurisdiction in domestic courts) still remains in a situation where the basis or extent of a right are unclear and for instance a defence is raised to breach or infringement based on the purported invalidity or expiry of a right granted by a state. In this situation the pervasive school of thought remains that it is only the state granting the right that is sufficiently qualified to opine on its validity or existence because in terms of practicality it alone has the power to record or cancel such a right.[72] In addition to validity claims, issues of anti-trust, purported criminal conduct, export controls and

69 C. Waelde et al., Contemporary …, *op. cit.*, pp. 969–70. *See*, British South Africa Co v. Companhia de Mocambique AC 602 (1893) (appeal taken from Eng.).

70 *Ibidem.*, pp. 970–71.

71 Lucasfilm v. Ainsworth (2011) UKSC 39, (2012) 1 AC 208, (2011) 3 WLR 487 (appeal taken from Eng.).

72 *See,* S.A. Certilman & J.E. Lutsker, Arbitrability of Intellectual Property Disputes, (in:) T.D. Halket (ed.), Arbitration of Intellectual Property Disputes, Huntington, New York, 2012, pp. 72–83.

other trade restrictions are intellectual property law matters commonly thought to be legally unsuitable for resolution by international arbitration.[73]

As previously discussed, international arbitration, as such, is predicated on the inherent ability to similarly enforce a single valid award across multiple jurisdictions. The New York Convention on the Recognition and Enforcement of Foreign Arbitral Awards provides this mutual enforceability of awards in Article 1 (1), which provides that: 'This Convention shall apply to the recognition and enforcement of arbitral awards made in the territory of a State other than the State where the recognition and enforcement of such awards are sought, and arising out of differences between persons, whether physical or legal. It shall also apply to arbitral awards not considered as domestic awards in the State where their recognition and enforcement are sought.'

The New York Convention does not provide any explicit limitation on the subject matter of arbitration. However, Article 5 (2) (a) and (b) provides:

'Recognition and enforcement of an arbitral award may also be refused if the competent authority in the country where recognition and enforcement is sought finds that:

(a) The subject matter of the difference is not capable of settlement by arbitration under the law of that country; or

(b) The recognition or enforcement of the award would be contrary to the public policy of that country.'

These additional grounds for refusal of recognition and enforcement of an award, while not outcome determinative, can have a direct effect on the eventual viability of an arbitral award concerning intellectual property subject matter.

Firstly, certain states may designate intellectual property as a subject matter that is 'off limits' to arbitration, meaning that parties cannot legally contract out of the use of the domestic legal system.[74] A state making this designation will not only refuse to recognise and enforce awards made subject to arbitration clauses in contracts subject to their own arbitration laws, but presumably additionally refuse awards made in comparatively similar circumstances in other New York Convention signatory states, especially those awards where the underlying substantive intellectual property law used in the arbitral determination is the law of that state. When the underlying intellectual property right that is the subject matter of dispute is premised on the domestic law of the precluding state and that state has precluded this subject matter,

73 *Ibidem,* pp. 66–87. *Nota Bene:* It should be noted that just because the use of international arbitration may be precluded or enforcement prevented, parties might still be free to settle any dispute using mediation (even if they don't settle the underlying public grant of a right question); however, there is no mutual enforcement mechanism similar to the New York Convention for the resulting agreements.

74 *Ibidem,* pp. 88–95.

there is no conceivable way to change the substantive law of the subject matter to that of another state. This inherent restriction means that nothing can be done to craft or otherwise creatively shape the dispute resolution clauses or submission agreements to circumvent any preclusions in relation to intellectual property matters that a state chooses to put in its arbitration law.

The reality of certain states considering some aspects of intellectual property law as being unsuitable subject matter for arbitration poses an inherent limitation on the use of arbitration in intellectual property contracts and submission agreements and is a circumstance that the contracting parties must be seized of in planning and executing the dispute resolution clauses of their contracts, with particular attention being paid to which states currently maintain this prohibition. Although it is difficult to navigate the prohibitions in all potential jurisdictions, and also inherently restricting, Article 5 (2) (a) provides a limitation that is eminently predictable when writing an arbitration clause.

Secondly, Article 5 (2) (b) provides a general 'public policy' exception to the enforcement of certain awards. It is unquestionable that the range of rights engendered in intellectual property law are matters of public interest and can potentially fall foul of this public policy exception to enforcement under the New York Convention. While case law[75] and academic opinions[76] may provide a useful guide of the typology of intellectual property disputes that may trigger the public policy exception to enforcement in select jurisdictions, even with the best research, they cannot provide a finite list of when Article 5 (2) (b) may be used to prevent enforcement of an arbitral award. Dissimilar to Article 5 (2) (a), the public policy exception is unpredictable and as such presents an inherent vulnerability that must be taken into account by those managing intellectual property rights and assessing the suitability of an arbitration clause. Those intellectual property managers that are reluctant to use arbitration for these reasons might instead consider mediation as an alternative, since mediation is generally not restricted by subject matter. However, mediation settlement agreements, as is the case with regular contracts and court judgements, do not benefit from the automatic mutual recognition and enforcement mechanisms uniquely found in the New York Convention, the reciprocity of which lies at the heart of the attractiveness of the use of international arbitration.

75 For a more complete discussion of exceptions to enforcement *see*, K. Troller, Intellectual Property Disputes in Arbitration, "Arbitration: The International Journal of Arbitration, Mediation and Dispute Management" 2006, vol. 72, pp. 323–24. *Nota Bene*: A discussion of which aspects of industrial property are not arbitrable.

76 *Ibidem.*

6. Cautions and Disadvantages Relating to the use of International Arbitration for International Intellectual Property Disputes

It has been noted that arbitrators lack *imperium*.[77] In other words arbitrators lack the power vested in the court to 'force parties to the arbitration to do something or refrain from doing something'.[78]Arbitrators also completely lack authority over third parties.[79] In order to compel compliance with an arbitral order parties would generally have to seek a judicial remedy, rely on external legislation in the arbitral law of the country, or seek compensation under the institutional rules of arbitration.[80] Interim measures, especially those mandating that a party cease and desist a behaviour such as the unauthorised production, copying or sale of intellectual property, are particularly important to mitigating accruing harm in an intellectual property context. Interim measures are in fact possible in most *situs* and specified in institutional rules.[81] However, absent voluntary compliance, the coercive power stemming from *imperium* can only come from a domestic court.[82] The result is a potentially cumbersome and duplicative process of first getting relief from the arbitral panel and then enforcement from the court. Alternatively, many arbitration laws allow parties to bypass the arbitrators altogether and seek interim relief directly from the court before or simultaneously with the arbitration,[83] the cost and time of which certainly vitiates against the advantage of a streamlined one-stop shop international arbitration process.

International arbitrations are confidential and outside the public eye and are generally not reported in any form.[84] As such, international arbitration awards are a one-off decision that does not set precedent for future arbitrations or law.[85] Even the same arbitrators sitting in another arbitration with identical facts may freely choose a new legal direction on the same subject matter. It might be said that intellectual property law is a vast area filled with legal nuances in need of clarity. Removing these disputes from the public domain prevents the formation of new law. The clarity emerging from this new law can be the understanding that prevents the re-

77 T. Cook, A.I. Garcia, Intellectual …, *op. cit.*, pp. 34–35.
78 *Ibidem.*
79 *Ibidem,* pp. 35–36.
80 *Ibidem.*
81 J. Epstein et al., A Practical Guide to International Commercial Arbitration, Dobbs Ferry 2000, pp. 96–97.
82 *Ibidem*, p. 96.
83 *Ibidem*, p. 97.
84 *Nota Bene*: Some parties may choose to make decisions available. Arbitral institutions may release anonymous decisions in relation to certain parts of arbitration such as disqualification of an arbitrator.
85 T. Cook, A.I. Garcia, Intellectual …, *op. cit.*, p. 36.

emergence of similar disputes by forcing future parties into compliance or ensuring early settlement.

A well-conceived arbitration clause leads parties to an early and inexpensive solution to their intellectual property law dispute. On the other hand, with a poorly drafted clause and a lack of ADR planning, international arbitration can, and often does, lead to prolonged conflict between the parties at even more time and expense than traditional international litigation. Whether forcing a party to arbitration, appointing an arbitrator, obtaining interim relief, seeking a set-aside, or preventing recognition and enforcement, there are many chances that a party will litigate issues before, during and after international arbitration. Although in an optimal scenario international arbitration can offer the best possible alternative to traditional litigation for intellectual property law disputes, there is absolutely no assurance that parties will wind up with a more streamlined process. The successful obtaining of real savings in cost and time will depend on the quality of the preparation, the circumstances of the case including the arbitrators themselves,[86] and most of all on the ADR attitude adopted by the parties.

Conclusion

The possibility for the use of ADR, in particular international arbitration in the field of international intellectual property law, is neither bounded by geography nor by the typology of underlying intellectual property right that becomes the substance of international contracting. However, international arbitration should not be viewed as a panacea for all aspects of international intellectual property transactions but rather viewed pragmatically as a toolkit offering distinct advantages over other forms of dispute resolution. To make optimum use of ADR in respect of international intellectual property transactions, the potential user should embrace the ADR outlook in both corporate philosophy and at the level of contracting. International arbitration will be the preferred method of ADR when an intellectual property entity has embraced the possibility of using ADR as the preferred or default mechanism for resolving international intellectual property disputes, and when a decision has been made to adopt ADR as the preferred approach to intellectual property disputes, users will find that international arbitration has many distinct advantages over other forms of dispute resolution.

A well-conceived international arbitration clause has the potential to resolve an intellectual property dispute by using a single self-contained process that results in a final award that is enforceable in most jurisdictions worldwide. There is no parallel

86 J.D. Wing, International Arbitration and Mediation – The Professional's Perspective, (in:) A. Alebekova, R. Carrow (eds.), International Arbitration and Mediation: From the Professional's Perspective, United States 2007, p. 29.

or equivalent in litigation, mediation or other dispute resolution method to the finality and mutual recognition and enforcement provisions that operate in international arbitration. Because of the time-sensitive nature of intellectual property rights due to their durational exclusivity, finality is of chief importance to the financial bottom line. The possibilities for enforcement under the New York Convention offer distinct possibilities for prompt and efficient recovery of assets wherever they may be located. Otherwise, judgement-proof entities that can shelter themselves from liability in international litigation cannot escape the mutual enforcement possible under the New York Convention. International arbitration clauses generally benefit from the concept of 'separability' and do not rise and fall with the existence of the commercial agreement to which they are appended. With the selection of an appropriate *situs* or with the benefit of a well-drafted arbitration clause, parties can allow for the arbitral panel to decide the nature and extent of their own jurisdiction. The doctrine of competence-competence allows for the parties to resolve most or all issues related to the international arbitration within the context of that single arbitration, preventing extraneous litigation in domestic courts that has a significant time cost to the underlying intellectual property rights.

While there are several ways in which international intellectual property matters can come to be decided by international arbitration, only in the case of an arbitration clause negotiated between the parties to a contract can parties avail themselves of the full spectrum of opportunities open to the intellectual property users. When intellectual property lawyers and their clients have adopted a pro-ADR outlook, they will be able to customise the arbitration clause in several ways that are significant for the management of intellectual property disputes. At the outset of evaluating whether international arbitration is a suitable dispute resolution mechanism, parties must be seized that not every type of intellectual property dispute is well suited for arbitration and certain intellectual property disputes will be wholly precluded from being the subject of international arbitration in respect of the arbitration laws of certain countries. Once parties have done their due diligence in assessing the suitability of international arbitration for the resolution of the probable disputes resulting from their commercial agreement, they should ensure that the arbitration clause has certain *de minimis* characteristics. These essential elements would include a designation of the scope of the subject matter that is to be arbitrated that aligns with the law of the *situs*; an unequivocal statement that arbitration is the only dispute resolution method; and that its results are final and binding. Parties should be acutely aware that an arbitration clause is a legally complex and precise instrument and in the case of intellectual property can contain up to six distinct systems of law, aside from the domestic law, which governs the intellectual property rights that are the subject of the contract. One way of dealing with the legal challenges of drafting a suitable arbitration clause is to rely on 'standard' or 'model' clauses that have propagated by international arbitration institutions. While a party-drafted clause leading to an ad

hoc international arbitration will offer the highest degree of customisable law and process, it is also the most challenging clause to draft and can lead to difficulties in organising the arbitration should a dispute arise. The WIPO has written a model clause for international intellectual property users and offers the WIPO Center for Arbitration as the accompanying administrative facility with an established roster of international arbitrators who specialise in intellectual property disputes. Intellectual property users may also opt to combine the best features of several arbitration institutions by using one institution to provide the rules and host the arbitration and another to provide for the appointing authority for the arbitral panel.

There are three significant ways in which the arbitration clause can be made particularly amenable to the needs of intellectual property users. Parties can heighten the level of confidentiality associated with the arbitration process providing added secrecy and security for their intangible assets, which is especially useful in the case of trade secrets, know-how and proprietary information. Parties gain the ability to select decision makers who have the relevant scientific or specialist knowledge in the field of intellectual property to adequately address the particularities of the anticipated dispute. Finally, parties gain access to an array of possibilities for consolidation and joinder, which is particularly useful for users who anticipate the possibility of litigating the same issue with several parties or litigating several related issues with the same party or dealing with a parent company and its multiple subsidiaries.

There are also significant detriments to using international arbitration. Significantly, arbitrators lack *imperium* and do not have the coercive powers of the domestic courts, especially with respect to third parties. Enforcing interim measures can require side litigation in multiple domestic jurisdictions, significantly vitiating against the cost benefit of arbitration. Arbitration does not lead to precedent or settled law. Issues of importance in international intellectual property law contracting may resultantly remain without definitive answers and international arbitrations may yield inconsistent legal results. Finally, the time and cost savings, which are so important for the intellectual property user, can be easily lost because of failures in the arbitration clause, improper planning, or parties resorting to litigation to try to stall or sabotage the smooth running of an arbitration.

International arbitration can offer the best-case scenario for parties requiring a time- and cost-efficient international dispute resolution mechanism that is customisable and private. This best-case scenario is only achievable if certain optimal circumstances are present; most importantly, that the parties have adopted a proactive and positive attitude towards resolving disputes using international arbitration as the preferred form of ADR. This positive and proactive stance should lead to parties making the fullest and best use of the creative possibilities of the arbitration clause to meet the subject matter peculiarities of international intellectual property law. Realising the full benefit of international arbitration for international intellectual property law is not just a reasoned legal choice but rather an attitudinal

stance to removing these disputes from the anachronistic need for litigation in multiple domestic jurisdictions and placing them in the only alternative and truly international forum that is both adaptable and capable *because* of subject-oriented design.

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