



Standing Committee on  
**ADR**

2017



Date: 12th October 2017

## REPORT Standing Committee on

### ADR

Chair: Rafael ATAB DE ARAUJO  
Responsible Reporter: Ari Laakkonen

- 1) Report on the activities of your Standing Committee during the reporting period

Please provide a general overview of the activities of your Standing Committee over the last 12 months, including at least:

- a) Internal meetings of the Standing Committee during the reporting period (whether by telephone, video conference or in person);

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The Standing Committee on ADR had a lengthy meeting during AIPPI World Congress of 2016, in Milan and members had the opportunity to discuss certain developments in the ADR arena.

One important issue of concern refers to the draft Mediation Rules and the potential limitations as to the competence of the Patent Mediation and arbitration Center (PMAC) of the Unified Patent Court (UPC), as outlined in article 2.1 of the draft mediation rules<sup>[1]</sup>. In addition, the absence of information on costs and timing also raised members' concern. Notwithstanding, members agreed that Brexit ends up creating significant uncertainties as to future developments in this particular area.

The Committee also discussed the advantages and potential drawbacks associated with the adoption of "fast-track arbitration systems" as a potentially effective alternative for the solution of IP disputes. The issue raised considerable debate among committee members from different jurisdictions, being identified as a potential subject for a future panel for an AIPPI Congress.

The Committee also considered other topics for future work, as detailed below.

Unfortunately, attempts to schedule other meetings in different congresses during 2017 were not successful.

Indeed, as committee members have different backgrounds and areas of expertise in IP, which is very important for the work of our Committee, it has been difficult to identify another international Congress attended by a substantial number of the members. Thus, work has been done mostly by electronic means, particularly by e-mail exchange.

### Footnotes

1. <sup>^</sup> [https://www.unified-patent-court.org/sites/default/files/upc\\_mediation\\_rules.pdf](https://www.unified-patent-court.org/sites/default/files/upc_mediation_rules.pdf)[\[https://www.unified-patent-court.org/sites/default/files/upc\\_mediation\\_rules.pdf\]](https://www.unified-patent-court.org/sites/default/files/upc_mediation_rules.pdf)

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- b) any external representation on behalf of AIPPI by any member of your Standing Committee;
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The ADR Standing Committee has not been required to represent AIPPI in any external events or meetings during the reporting year.

- c) any contribution by your Standing Committee to any external consultations; and
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The ADR Standing Committee has not been required to contribute to any external consultations during the reporting year

- d) any studies or analyses undertaken or position papers prepared by your Standing Committee, with a brief summary of the outcome(s).
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One of the responsibilities of our Committee is to identify and report legislative and case law developments in the ADR area. In this regard, our Committee prepared, in the past, a report on Arbitration legal frame in certain jurisdictions. As our Committee identified the need to update such report, we have initiated discussions toward the preparation of a global guide on ADR in connection with IP disputes.

It has been noted that a similar task has been conducted by ASIPI (Inter-American Association of Intellectual Property) for Latin America. We have therefore identified a potential area for cooperation between both Associations and have already contacted such Association, with the approval of AIPPI bureau.

- 2) Key issues/developments during the reporting period

Please include any significant case law, legislative or regulatory developments, or policy initiatives, including their relevance and/or any implications for the work of your Standing Committee or for AIPPI more generally.

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The proposed work on a global report on ADR should considerably improve our ability to identify and keep track of legal and case law developments, such as the amendments passed by the Hong Kong government to the arbitration law of that territory, which has been reported by Jacques de Werra. Such amendments confirm that Intellectual Property rights are subject to arbitration<sup>[1]</sup>.

Indeed, arbitrability of IP rights (and the extent of such arbitrability) has always been one of the most disputed subjects in connection with arbitration of IP disputes. Therefore, this type of report can potentially assist parties and counsels in finding "arbitration friendly" jurisdictions.

## Footnotes

1. <sup>^</sup> <https://www.asialaw.com/articles/ip-arbitration-amendment-bill-passed-today-in-hong-kong-but-hurdles-remain/arfsbpue>[<https://www.asialaw.com/articles/ip-arbitration-amendment-bill-passed-today-in-hong-kong-but-hurdles-remain/arfsbpue>]

- 3) Any recommendations for AIPPI involvement/action for the next 12 months

This need not be limited to recommendations for your Standing Committee but can be recommendations for AIPPI more broadly. For example, please include:

In each case, please explain why such involvement/action is recommended, by whom it should be undertaken and any relevant time frames.

- a) any recommendations for involvement/action in relation to any upcoming or foreshadowed case law, legislative or regulatory developments, or policy initiatives;
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Despite some uncertainties created by Brexit on the developments of the UPC, actions might be necessary depending on any progress that may occur in connection with the creation of the Patent Mediation and Arbitration Center of the UPC.

- b) any other recommendations for AIPPI involvement/action;

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*not responded*

- c) any recommendations for the work programme of your Study Committee.

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Although our Committee will continue to broadly monitor any developments in the ADR arena, including possible progress on the establishment of the PMAC of the UPC, the work program of the ADR Standing Committee should focus on the the ongoing projects described above, namely:

- a) Preparation of a Global Guide on ADR in connection with IP disputes, exploiting the possibility of a cooperation with ASIPI; and
- b) Further studies on the use of ADR mechanisms in connection with FRAND-related disputes, in cooperation with the AIPPI Standing Committee on Standards and Patents.

- 4) Outline of the work programme of your Standing Committee for the next 12 months

Please set out specific activities and priorities having regard to the matters in 1) - 3) above, including any relevant time frames.

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The working projects described under section 3.c above should likely concentrate the efforts of the members of the ADR Standing Committee for the next 12 months. Details on estimated timelines will be further discussed during the ADR Committee meeting at AIPPI World Congress 2017 in Sydney.

## Names and Functions of Committee Members

Chair(s)	Rafael ATAB DE ARAUJO	Brazil
Co Chair(s)	Steve BAUER	United States
Secretary	Aurélia MARIE	France
Members	Cheryl AGRIS	United States
	Hakan BORGENTHÄLL	Sweden
	Lorna BRAZELL	United Kingdom
	Giovanni CASUCCI	Italy
	Jacques DE WERRA	Switzerland
	Gonçalo de SAMPAIO	Portugal
	Norma S. FÉLIX	Argentina
	Susan K. GATFORD	Australia
	Wendela HARDEMARK	Sweden
	Johnathan MESIANO-CROOKSTON	Canada
	Christian A. MEYER	Switzerland
	Paolina TESTA	Italy
	Dilek USTUN EKDIAL	Turkey
Kozo YABE	Japan	