

Organisers:



Collaborating Organisation:



# INTERNATIONAL DISPUTE RESOLUTION CONFERENCE 2019

**New Era of Global Collaboration**

**17 April 2019**

Hong Kong Convention  
and Exhibition Centre

Organisers:



Collaborating Organisation:



# Advantages of using Mediation in International Intellectual Property Disputes

***Professor Dr Colin ONG, QC***

*Queen's Counsel, 36 Stone Chambers (London)*

*Chartered Arbitrator and Counsel, Eldan Law LLP (Singapore)*

*Senior Partner, Dr Colin Ong Legal Services (Brunei)*

# Advantages of using Mediation in IP Disputes

## (i) Uncertainty of Outcome in Cross-Border Litigation

- One cannot always select specialist IP judges in court litigation.
- Time and cost involved in Litigation for IP disputes.
- Mediation best where expectations of parties are ambitious.
- Opportunity for better outcomes with overall business interests.
- Litigation focuses on insistence with strict legal rights.
- A winner-loser situation limits opportunity for future cooperation.
- Minimise period of uncertainty as to rights and potential liabilities.
- Lack of certainty results in plans being put on hold.
- Investments postponed not just in the disputed areas of IP.
- Extremely rare for one side to be completely correct.

Organisers:



Collaborating Organisation:



# Advantages of using Mediation in IP Disputes

## (ii) Suitable for parties from different legal jurisdictions

- Different legal cultures and different expectations. Need to talk.
- IP disputes evolve over time. Priorities change.
- Maybe genuine differences of opinion led to misunderstanding.
- Litig. over years tends to increase animosity & harden positions.
- Med can avoid a pointless blame game – bridge differences.
- Focus parties rather than spending time analysing problems.

Organisers:



Collaborating Organisation:



# Advantages of using Mediation in IP Disputes

## (iii) Specialisation and Technicality of IP disputes

- Parties multi-jurisdictions claiming separate legal interests in IP.
- Nature of IP itself is a technical specialist area. In addition, there are often several different IP rights co-existing in a single work.
- IP rights may be under separate ownership and may in turn have been licensed or assigned to another individual or company.
- Avoid prolonged and expensive litigation across many countries.
- Court judgments may set a precedent neither party likes.

# Advantages of using Mediation in IP Disputes

## (iii) Specialisation and Technicality of IP disputes

- Courts may decide on points of law that do not help parties.
- Court judgments may set a precedent neither party likes.
- **Patent disputes** - issues of inventorship, infringement, doctrines of conception and corroboration are factually and legally intricate.
- **Trademark disputes** - issues of likelihood of confusion, dilution, and fame of a mark may contain complicated issues law and fact.

Organisers:



Collaborating Organisation:



# Advantages of using Mediation in IP Disputes

## (iii) Specialisation and Technicality of IP disputes

- **Copyright disputes** - issues such as joint authorship, fair use etc may present difficult factual and legal scenarios.
- Someone with expertise in the applicable law and IP issues can deal with the mediation to look for practical long term solutions.
- Confidentially provide each party with candid neutral assessment of the strengths and weaknesses of its case.

Organisers:



Collaborating Organisation:



## Advantages of using Mediation in IP Disputes

### (iv) No exact price to an IP right but time lost is money lost

- May be difficult to attribute precise monetary value to an IP right.
- Ability of Cts to construe IP rights conducted on country by country basis. May not reflect underlying relationships of parties.
- Cost, time, & possibility of inconsistent outcomes in different cts.
- Med presents a single forum to provide a truly global solution.
- Flexibility to resolve disputes including licensing; sub-licensing and cross-licensing. Can deal with adjustments to license fees and royalties and other innovative business solutions.



## Advantages of using Mediation in IP Disputes

### (v) Disclosure in litigation is a slow and expensive process

- IP Ct disputes involve expensive and slow disclosure processes.
- Med may be used to facilitate cost-effective info exchange.
- Mediator suggest streamlined disclosure target early disclosure of specific information needed to engage in meaningful talks.
- After disclosure, mediator can start a mediation session to caucus and discuss possible settlement options.
- Mediator can reduce costs by narrowing issues in IP disputes.
- Mediator can assist in defining and/or narrowing the issues.

Organisers:



Collaborating Organisation:



## Advantages of using Mediation in IP Disputes

### (vi) IP secrets protected by Confidentiality of Med process

- Core of IP/trade secret disputes are the details of trade secrets.
- Litigants are at risk of being compromised through litigation.
- Patent disputes also involve confidential technical information.
- Not just of the alleged infringer but also of the patent owner.
- Mediation can help parties reach a business resolution.
- Mediators help to identify key issues and applicable law.
- Help resume direct talks to enhance prospects for settlement.

Organisers:



Collaborating Organisation:



# Advantages of using Mediation in IP Disputes

## Conclusion: Mediation is a Smart Way to settle IP Disputes

- Med can “caucus” with each party separately and confidentially.
- Advantage to parties who wish to maintain relationship.
- “Looping” reassures each party its submissions are understood.
  
- Med reduces tensions and provides a less adversarial process.
- Allows parties to try to resolve dispute and improve relationships.
  
- Mediator to defuse emotions, define issues in an objective way.
- Parties free to withdraw from after initial meeting with mediator.

Organisers:



Collaborating Organisation:



# Advantages of using Mediation in International Intellectual Property Disputes

***Professor Dr Colin ONG, QC***

*Queen's Counsel, 36 Stone Chambers (London)*

*Chartered Arbitrator and Counsel, Eldan Law LLP (Singapore)*

*Senior Partner, Dr Colin Ong Legal Services (Brunei)*