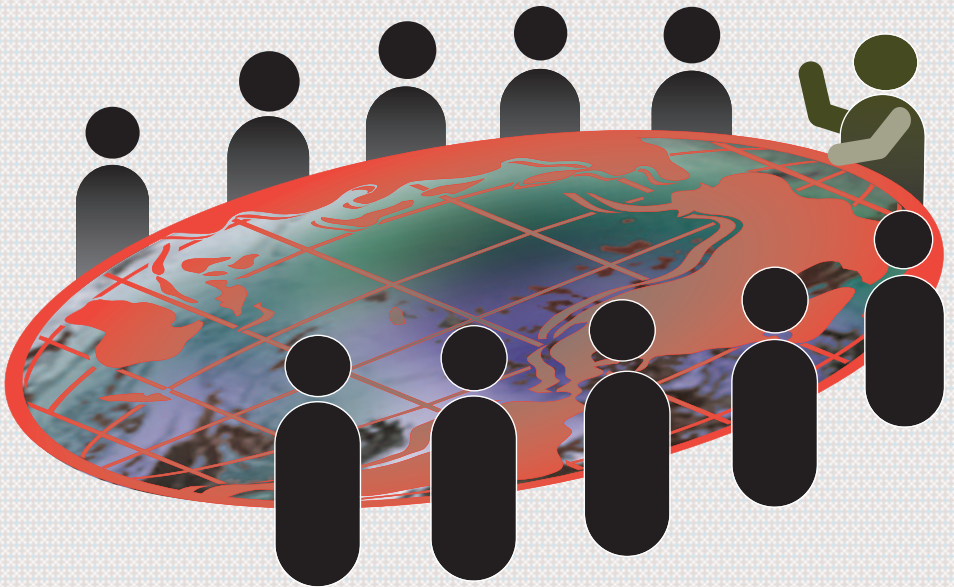


David W. Plant

We Must Talk Because We Can

Mediating International
Intellectual Property Disputes



David W. Plant

We Must Talk Because We Can

Mediating International
Intellectual Property Disputes

**Copyright © 2008
International Chamber of Commerce**

All rights reserved. No part of this work may be reproduced or copied in any form or by any means – graphic, electronic, or mechanical, including photocopying, scanning, recording, taping, or information retrieval systems – without written permission of ICC SERVICES, Publications Department.

**ICC Services
Publications**

38 Cours Albert 1er
75008 Paris
France

ICC Publication No. 695

ISBN: 978-92-842-0044-3

Table of Contents

Foreword	5
Acknowledgements	7
I. Introduction	9
II. The Nature of IP Disputes	11
III. IP Disputes Suitable for Mediation	13
IV. Barriers to IP Mediation	19
V. Getting to the Table	23
VI. Preparing for IP Mediation	27
VII. The Skilled IP Mediator	41
VIII. Skilled IP Counsel's Role	65
IX. The Well-prepared Client's Role in IP Mediation	69
X. Cultural Issues in IP Mediation	85
XI. Emotion in any IP Mediation	93
XII. Ethics and IP Mediation	97
XIII. The End Game	119
XIV. ICC's ADR Rules	127
XV. Lessons from some IP Disputes	131
XVI. End Note – The Challenge of the Peaceful Virus	135

Appendix A ICC ADR Rules	139
Appendix B WIPO Mediation Rules	147
Appendix C UNCITRAL Model Law on International Commercial Conciliation	155
Appendix D UNCITRAL Conciliation Rules	161
Appendix E Preparation, Preparation, Preparation	169
Appendix F Mediator as Arbitrator – Suggested Rules	171
Appendix G Arbitrator as Settlement Facilitator – Suggested Rules	173
Appendix H Manifestations and Triggers of Emotion	175
Appendix I Stand in Other Person’s Shoes Exercise	177
Appendix J Sample Engagement Letter	181
About the Author	185

Foreword

At first glance, it is somewhat ironic to see one of the most internationally renowned mediators ask the Chairman of the International Court of Arbitration of the International Chamber of Commerce (ICC) in Paris to preface his book, which is dedicated to “Mediating Difficult International IP Disputes”. Indeed, mediation is sometimes still considered to be in opposition to arbitration. Both arbitrators and mediators often address the same actors (business people), intervene in the same context (the legal dispute), and are entrusted with an identical mission (the resolution of disputes).

But these two methods are far from being rivals, they are, on the contrary, complementary; this is why it is important to promote one and the other – and one along with the other, so as to create a prolific synergy. Like other institutions, the International Court of Arbitration of the ICC understands the benefits that can be reaped from this synergy and has developed, since its beginning (1923), rules and services facilitating these so-called alternative methods of dispute resolution. Recently, the Court and ICC (Dispute Resolution Services) decided to establish an annual International Commercial Mediation Competition, open to students and law schools around the world. This Competition takes place, thanks in no small part to the assistance of many mediators who are prominent in the international mediation community. David Plant is one of them.

It was during one of these competition sessions that I had the chance to hear and see David Plant at work for the first time. What a revelation and what fortune! First, it was a revelation to appreciate the mediator’s art: his strength vested in his unique *moral* authority, his interest which extends as much to the participants as to the characteristics of their dispute, his special attention to helping the parties but never imposing his views. Next, my fortune was to observe the mediator’s workmanship: the finesse and the discretion, the attentiveness to all that is said, as equally to all that is not.

This revelation, this fortune, I found them once again in the pages of this book. It is not merely a good read, to which the reader is invited, but it is rather an induction for the reader; one does not read, one *listens*. The author’s approach is progressive, garnished with advice and suggestions, nourished with rich experience. Intellectual property specialists will assuredly benefit from the author’s report on this particular area of law, but his presentation is also of wider significance because it addresses, at the very least, all those who are interested in mediation and all those who are concerned by mediation. Moreover, the author’s perspective will be advantageous to the reader, by illustrating the methodology and rendering it more easily accessible.

It is said that a mediator’s unique talent lies in the art of convincing. Then indeed, David Plant is a great artist!

Pierre Tercier

Chairman of the International Court of Arbitration of the ICC (Paris)
Professor at the University of Fribourg (Switzerland)

Acknowledgements

Fortunately, this acknowledgment is written much later than the ICC would like. This is the day after Christmas 2007. Yesterday, I received as a gift from my daughter, Susan, a book I initially thought was intended for my almost-three year old granddaughter, Mina. Wrong. It is indeed for me – and us. It is “Click, Clack, Moo ... Cows That Type,” by Doreen Cronin. It turns out to be required reading for all mediators and parties to mediations.

In short, one of Farmer Brown’s ducks is enlisted to mediate a controversy among Farmer Brown, his cows and his chickens. The duck is neutral. But being a savvy interpreter of human and barnyard behavior, the duck not only settles the matter but also negotiates a new diving board for the duck pond. Many messages are hidden in this little book. I acknowledge its teachings and the perceptiveness of my daughter.

Also, I acknowledge the teachings of the thousands of people I have met and worked with in the course of my ADR career. Without them, I would be living a life more typical of a recent New Hampshire resident, rather than enjoying the rewards and vexations of mediation. This book would not have been born. I cannot begin to name them, but I can thank them with deepest sincerity.

More directly, this book could not have been completed without the indescribable attention and care devoted to early manuscripts by Susan Little of New London, New Hampshire – an incomparable and encouraging reader. Alan Limbury of Sidney, Australia, deserves special mention because of his careful review and revealing criticisms of a manuscript. (I have given credit to Alan in a few places in the book – hardly a worthy expression of my gratitude to him.) Nancy Thevenin of the ICC in New York City also read and carefully and most helpfully commented on an early draft. Thirerry Garby of Paris, France kindly read a draft and encouraged me to continue. Mercedes Tarrazon of Barcelona and Phillip Howell-Richardson of London both read an early manuscript and shared their constructive views with me at a meeting in Geneva. Two students at The Pierce Law Center in Concord, New Hampshire – Melinda Siranian and Sabin Maxwell – read, commented on and corrected early drafts in many useful ways. To all of these dedicated people, I am indebted.

Closer to home at the ICC, Professor Pierre Tercier was more than kind to read a draft and to write the glowing forward to the book. As I wrote to Professor Tercier, I found his soaring words to describe a mediator I do not know. Also at the ICC, Melanie Meilhac (Manager, ADR - Expertise - Dispute Boards), Rachele Bijou (Director of ICC Services, Publications), Stephanie Rossignol (production), Anne-Marie Harper (copy editor), and Peter Fernandes (graphic design) all worked creatively and assiduously to bring this book into the world. I am immensely grateful to each of the ICC personnel who worked so hard to get the book published.

Last but not least, I thank the Harvard Negotiation Insight Initiative and its photographer, Tom Fitzimmons, for permitting the ICC to use the photograph of me taken at an HNII workshop in 2006.

I am grateful to all of my family, and especially Jeanie, my wife. Each has permitted me to follow my whims and wanderings, while each sacrificed to see to it that I could do what I do. Jeanie has led the cheerleaders every inch of the way.

Thank you, everyone.

David W. Plant

New London, New Hampshire, USA
December 26, 2007

I. Introduction

This book is for any person – business person, consumer, lawyer or mediator – faced with an IP dispute. The book builds on my thoughts in *Resolving International Intellectual Property Disputes*, published by ICC in 1999. Here the focus is on mediation. I have added thoughts that have occurred to me since 1999, based primarily on eight more years of experience mediating, arbitrating, studying, training and teaching.

Virtually every international IP dispute is difficult. Sometimes, extraordinarily so. Mediation in international IP disputes works best when *each person* concerned is thoroughly prepared, and brings to the table all his or her interpersonal skills, cultural sensitivity, patience, open-mindedness, creativity and commitment. Each person may have to re-hone those skills, or even learn them for the first time. None of this comes easily. All of it requires care and commitment.

Care and commitment are required as to each person's emotional issues – emotional issues unique to the person or specific to a particular conflict, or those more generally felt by each of us as ordinary, everyday citizens of this world. Each person should be sensitive to his or her own emotional investment in the conflict, and in matters that may affect his or her role in the conflict and its resolution. Each should be sensitive to his or her own emotional hot buttons. This goes for parties, counsel and mediators alike.

Each person should be acutely aware of cultural nuances and differences. These are likely to tie into emotional issues. Acknowledging and respecting the other person's cultural interests and needs is a key to success.

In this book, I focus on the *process* of mediation and on the mediator, the client and counsel. I come at this from a Western, common law (specifically, US) orientation. Interest-based negotiation underlies the mediation process as I practice it. Mediation, as I see it, is interest-based negotiation facilitated by a third person – the mediator. My aim is to help you, the reader – whatever your role – to prepare for and engage in such mediation at the most productive level.

I set high standards to enhance the likelihood that everyone's participation in a mediation – client's, counsel's and the mediator's alike – will result in a mutually acceptable, jointly beneficial and enduring resolution of whatever the problems may be. Of course, if parties can resolve their problem without the intervention of a neutral facilitator, they surely should do so.

In the end game, when money is the last issue remaining, old-fashioned positional bargaining may well be undertaken. This is not all bad, if the parties to the IP dispute have agreed on all the other terms and conditions and are now trying to agree on a fair price. Objective criteria, reality tests and other techniques may be used. But in the end, if the parties' real interests and real needs are not satisfied, positional bargaining may well fail, and resolution of the IP dispute may not be reached.

The chapters may be read in any order, with one crucial caveat: Chapter VI – Preparing For IP Mediation – must be read. Chapter VI is further developed in Chapters VII, VIII and IX. As a reminder of the essence of Chapter VI, Appendix E can be copied and carried in one's pocket or briefcase. Preparation is the key. Preparation cannot be overemphasized or overdone.

I have written the book with the conviction that, if parties will talk openly and empathetically, often they will find that they can create a mutually satisfactory solution to their problem. Even against the backdrop of a troubled and dysfunctional history. Especially, in this flat, globally interconnected commercial world.

In short, with the hope and need for resolution, parties *must* talk, because they *can* talk.