

# WIPO ADR Options for FRAND Dispute Management and Resolution



This document has been developed by the WIPO Arbitration and Mediation Center (WIPO Center) and takes into account comments by telecom stakeholders, the European Telecommunications Standards Institute (ETSI) Legal Department and WIPO Arbitrators and Mediators.

This document is for general guidance only and is not intended to provide legal advice.

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## I. INTRODUCTION

- (1) Technical standards play an increasing role in today's economy<sup>1</sup>. Standard development organizations (SDOs) typically require their members to license SEPs on terms that are fair, reasonable and non-discriminatory (FRAND). In recent years, courts in several jurisdictions have dealt with the determination of FRAND licensing terms under different applicable laws, and have developed different approaches and methodologies.
- (2) Alternative Dispute Resolution (ADR) mechanisms, understood here to include mediation, arbitration, and expert determination, are flexible tools for parties wishing to conclude a FRAND licensing agreement. Specialized neutrals, the possibility to consolidate global disputes in one procedure, options to enhance time and cost efficiency, the option to tailor the scope of the dispute which the parties want to refer to ADR, choice of law options, confidentiality, international enforceability of arbitral awards and much leeway as to structuring the arbitration procedure are among the advantages offered by ADR proceedings to solve FRAND disputes, including for SMEs. This has been recognized by some SDOs that include ADR procedures in their IP policies.<sup>2</sup> Arbitration, including WIPO arbitration, also has been identified by some authorities in the US and in Europe as a suitable option to facilitate the determination of FRAND licensing terms.<sup>3</sup>
- (3) To facilitate submission of FRAND disputes to WIPO ADR, this Guidance aims at helping parties and neutrals to understand and make use of procedural options that are available at different stages of the process. To that effect, Section II. of the Guidance summarizes how FRAND disputes can be submitted to mediation, arbitration or expert determination. Section III. then identifies some key elements that parties may wish to consider to shape the ADR process, notably to address large SEP portfolios, and to contain time and cost of the proceedings. These options are illustrated in model documents in Annexes I-V that build on the WIPO Model FRAND ADR Submission Agreements developed by the WIPO Center in collaboration with the European Telecommunications Standards Institute (ETSI) and SEP experts in 2014.<sup>4</sup>

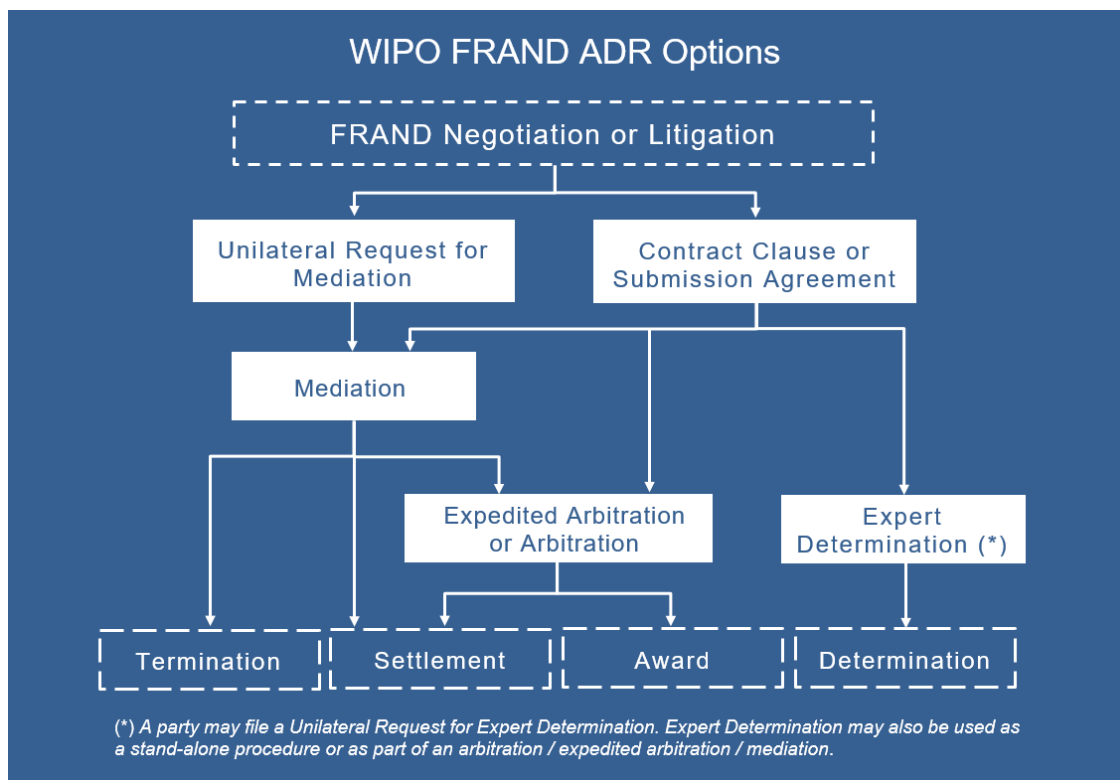
<sup>1</sup> Computer technology and digital communications, which are industry sectors that have a relatively high usage of standard essential patents (SEPs), made up the top two technology fields in patent applications under the Patent Cooperation Treaty (PCT) in 2019, see WIPO (2020), PCT Yearly Review 2020: The International Patent System. Geneva: WIPO available at [www.wipo.int/edocs/pubdocs/en/wipo\\_pub\\_901\\_2020.pdf](http://www.wipo.int/edocs/pubdocs/en/wipo_pub_901_2020.pdf).

<sup>2</sup> Digital Video Broadcasting (DVB) [https://dvb.org/wp-content/uploads/2019/12/dvb\\_mou.pdf](https://dvb.org/wp-content/uploads/2019/12/dvb_mou.pdf), Open Mobile Alliance Ltd. (OMA) [https://omaspecworks.org/wp-content/uploads/2018/02/Member\\_IPRGuidelines\\_v53006.pdf](https://omaspecworks.org/wp-content/uploads/2018/02/Member_IPRGuidelines_v53006.pdf). The European Telecommunications Standards Institute (ETSI) Guide on ETSI's Intellectual Property Rights (IPR) Policy invites parties to mediate where a dispute arises relating to the application of the IPR Policy. The ETSI IPR Guide can be accessed on the ETSI website: <https://www.etsi.org/about/our-operations>.

<sup>3</sup> See for example reference to WIPO ADR in Motorola Mobility LLC and Google Inc. (FTC File No. 121 0120) <http://www.ftc.gov/opa/2013/07/google.shtm>, and the Communication by the European Commission "Setting out the EU Approach to Standard Essential Patents" (COM(2017) 712 final), Section 3.4 Alternative Dispute Resolution <https://ec.europa.eu/docsroom/documents/26583>.

<sup>4</sup> [www.wipo.int/amc/en/center/specific-sectors/ict/frand/](http://www.wipo.int/amc/en/center/specific-sectors/ict/frand/). See also Annexes I-III and V.

## II. ROUTES TO FRAND ADR



- (4) Referral to ADR is consensual and requires both parties' agreement. Parties may have agreed to submit FRAND disputes to ADR in dispute resolution clauses of pre-existing licensing agreements. As noted above, such agreement also can be included in IP policies of SDOs to the extent that such policies require referral of disputes among members to ADR.<sup>5</sup> If no contractual agreement exists between the parties, they may agree, after a breakdown in their negotiations and even after court litigation has commenced, to submit their dispute or specific aspects of it to ADR through a submission agreement. Depending on the jurisdiction, courts may support, suggest or mandate the use of ADR proceedings, especially mediation.
- (5) Where one party wishes to submit a dispute to mediation, but no mediation agreement can be concluded, under the WIPO Mediation Rules a party may submit a unilateral Request for Mediation to the WIPO Center (Annex I). The WIPO Center may then assist the parties in considering the Request or, upon request, appoint an external neutral to provide such assistance. If the other party agrees to submit the dispute to WIPO Mediation, the WIPO Center proceeds with the appointment of a mediator; otherwise, the mediation will be terminated. In WIPO cases, this process is frequently used and may be of interest for parties that wish to formalize their willingness to submit a FRAND dispute to mediation. The WIPO

<sup>5</sup> See footnote 2, above.

Center is available to assist parties that wish to commence a WIPO Mediation, Arbitration or Expert Determination through its good offices services.<sup>6</sup>

- (6) A party may file a unilateral request for expert determination.<sup>7</sup> A party may propose submitting the dispute to expert determination by submitting the request to the WIPO Center and to the other party. The WIPO Center may then assist the parties in considering the request<sup>8</sup>.
- (7) Which dispute resolution option parties select will depend on the circumstances of the case as well as parties' needs and expectations. While there is no general response as to whether ADR processes are preferable to conventional court-based IP litigation, each type of ADR has features that, if well managed, can translate into substantial time and cost savings, making them a more affordable and accessible avenue for resolving FRAND-related disputes.
- (8) While mediation, arbitration and expert determination are all private dispute resolution procedures based on party agreement, they differ in a number of important aspects.
- (9) Mediation is an informal consensual process in which a neutral intermediary, the mediator, assists the parties in reaching a settlement based on parties' interests.<sup>9</sup> While the mediator cannot impose a settlement, any settlement agreement has force of contract. Mediation does not preclude any subsequent court, arbitration, or expert determination options. In practice, parties often choose mediation as a first step in an escalation process, with arbitration or court litigation as a subsequent step.
- (10) Arbitration is a consensual procedure in which the parties submit their dispute to one or more arbitrators of their choice for a binding and final decision (an "award") based on the respective rights and obligations of the parties and enforceable under arbitral law.
- (11) Expert determination is a consensual procedure in which the parties submit their dispute to one or more experts of their choice. The expert's determination is binding, unless the parties agree otherwise. Expert determination is flexible and can be structured to be more informal than a process such as arbitration. It can be used on a stand-alone basis or in connection with a wider dispute or negotiation (when it is used in connection with a wider dispute or negotiation, it can be used for the determination of a specific issue which the parties agree will not be determined by a relevant neutral in a potential future arbitration or court case).

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<sup>6</sup> The WIPO Center can be contacted at [arbiter.mail@wipo.int](mailto:arbiter.mail@wipo.int) and further information on the WIPO Good Offices services can be found here: [www.wipo.int/amc/en/goodoffices/](http://www.wipo.int/amc/en/goodoffices/).

<sup>7</sup> Article 6 of the WIPO Expert Determination Rules.

<sup>8</sup> For guidance on how to submit a Request for WIPO Expert Determination, [www.wipo.int/amc/en/expert-determination/filing/](http://www.wipo.int/amc/en/expert-determination/filing/).

<sup>9</sup> Given the complexities of FRAND disputes, parties may wish to consider co-mediation.

- (12) Bearing in mind the high settlement rates in WIPO mediations and arbitrations<sup>10</sup>, it is understood that referral to ADR procedures may stimulate positive opportunities for party settlement and, in that sense, also may serve as a catalyst to facilitate FRAND licensing negotiations. Referral to expert determination can be particularly useful during FRAND licensing negotiations as it may be used for technical determinations or to determine whether one or more patents are essential. In addition, expert determination may also be used for the determination of FRAND royalty rates, which again may assist FRAND licensing negotiations.
- (13) While parties themselves can handle ADR proceedings directly with the neutral(s), such ad hoc procedures require considerable ADR experience and effective cooperation between all parties to avoid delays and unnecessary costs.<sup>11</sup> In WIPO ADR proceedings, the WIPO Center provides a tested framework for initiating and conducting the procedure, case management services, and access to qualified arbitrators, mediators, and experts with experience in patent standards.<sup>12</sup>

### III. OPTIONS TO TAILOR FRAND ADR PROCEEDINGS

- (14) To maximize the benefits that ADR procedures have to offer, including the ability to use ADR procedures to facilitate FRAND negotiations, parties and neutrals are encouraged to consider procedural options as appropriate, while avoiding ambiguity which may later lead to difficulties and delays in the dispute resolution process.
- (15) As noted above, the WIPO Center makes available tailored FRAND model submission agreements.<sup>13</sup> These model agreements build on the standard WIPO Mediation, Arbitration, Expedited Arbitration, and Expert Determination Rules and propose a set of FRAND-specific features. To facilitate referral to ADR, the model agreements provide parties with much flexibility to frame the ADR process to their needs.<sup>14</sup>

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<sup>10</sup> To date, 70 percent of the mediation procedures administered by the WIPO Center have been settled and 33 percent of WIPO arbitrations settle before any award is issued. The WIPO Arbitration Rules explicitly state that the arbitral tribunal may at any time suggest that the parties explore settlement, including by commencing mediation, see Article 67(1) WIPO Arbitration Rules / Article 60(1) WIPO Expedited Arbitration Rules.

<sup>11</sup> In the Queen Mary University/Pinsent Masons 2016 International Dispute Resolution Survey, 94% of respondents stated that the choice of institution is part of their organization's dispute resolution policy, [http://www.arbitration.qmul.ac.uk/media/arbitration/docs/Fixing\\_Tech\\_report\\_online\\_singles.pdf](http://www.arbitration.qmul.ac.uk/media/arbitration/docs/Fixing_Tech_report_online_singles.pdf).

<sup>12</sup> The WIPO Center maintains a special list of mediators, arbitrators and experts for patent standards. The WIPO Center proposes candidates for appointment from that list to parties involved in WIPO ADR proceedings relating to FRAND disputes.

<sup>13</sup> [www.wipo.int/amc/en/center/specific-sectors/ict/frand/](http://www.wipo.int/amc/en/center/specific-sectors/ict/frand/).

<sup>14</sup> Eli Greenbaum "Forgetting FRAND: The WIPO Model Submission Agreements", Les Nouvelles, June 2015, which can be accessed here: [www.wipo.int/export/sites/www/amc/en/docs/frand\\_2015.pdf](http://www.wipo.int/export/sites/www/amc/en/docs/frand_2015.pdf).

- (16) Two arbitration model submission agreements are proposed, namely (i) WIPO FRAND Arbitration (Annex III)<sup>15</sup>, and (ii) WIPO FRAND Expedited Arbitration.<sup>16</sup> The second option has been designed for less complex cases, notably where the number of SEPs that will be referred to arbitration is limited, and where parties place particular emphasis on time and cost efficiency. Both options can be preceded by<sup>17</sup> WIPO FRAND Mediation or include WIPO FRAND Expert Determination if the parties so wish. WIPO mediation can also be agreed by parties as a stand-alone procedure (Annex II)<sup>18</sup>, or initiated unilaterally by one party in the absence of a mediation agreement (Annex I).<sup>19</sup> Similarly, WIPO FRAND Expert Determination can be agreed by parties as a stand-alone procedure (Annex V) or initiated unilaterally. Parties are free to adapt the model submission agreements in line with their needs.
- (17) Content and level of detail that may be addressed by parties will depend on the procedural stage:
- (a) When negotiating contract clauses for future disputes, parties normally do not know details of the dispute that may arise much later, and often include standard WIPO contract clauses.<sup>20</sup>
  - (b) For an existing dispute, including where litigation has already commenced, parties have a good understanding of the issues at stake and will seek to shape the ADR process in the submission agreement in line with their needs.<sup>21</sup>
  - (c) In the course of the ADR proceedings, parties can further tailor the ADR process in consultation with the mediator, arbitral tribunal, or expert who normally will encourage the parties to do so. In arbitrations, any procedural issues agreed by the parties normally will be reflected in a procedural order issued by the arbitral tribunal following consultation with the parties. The WIPO Model FRAND Procedural Order, included in Annex IV, proposes some options.
- (18) The following identifies some matters that parties may wish to consider when tailoring a FRAND ADR process to their needs.

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<sup>15</sup> [www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex1/](http://www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex1/).

<sup>16</sup> [www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex2/](http://www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex2/).

<sup>17</sup> [www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex3/](http://www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex3/);  
[www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex4/](http://www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex4/).

<sup>18</sup> [www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex5/](http://www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex5/).

<sup>19</sup> [www.wipo.int/amc/en/center/specific-sectors/ict/frand/](http://www.wipo.int/amc/en/center/specific-sectors/ict/frand/).

<sup>20</sup> [www.wipo.int/amc/en/clauses/](http://www.wipo.int/amc/en/clauses/).

<sup>21</sup> See Annexes I-III and V.



## A. Scope

- (19) In view of the complexity and variety of FRAND disputes, especially where large SEP portfolios are involved, a clear definition of the scope of subject matter referred to ADR will be crucial. The following may, for example, be considered:
- (a) Number of patents: Parties may submit to ADR specific SEPs, a collection of SEPs, an entire SEP-portfolio, or a “sample” of representative patents (consensually) chosen from a SEP-portfolio. Parties further have the option to agree that the scope of the ADR proceedings shall include patents on a reciprocity basis (cross-licensing).
  - (b) Claims and defenses: In the interest of time and cost-efficiency of the proceedings, the parties may agree to limit claims or defenses that they may bring in the ADR proceedings, including patent essentiality, validity, infringement, and enforceability. They may for example agree in an arbitration that such arguments may be heard but no binding decision regarding these issues may be taken by the tribunal, or that such arguments may not be heard or decided upon by the tribunal.
  - (c) Geographical scope: Parties may agree to submit to ADR a determination of FRAND licensing terms globally. Parties also may agree to limit such determination to certain jurisdictions or markets selected by them<sup>22</sup>.
- (20) The WIPO model agreements give parties full flexibility to address any of the above options to tailor the scope of the proceedings if they so wish.<sup>23</sup> If parties refer an entire patent portfolio to WIPO ADR, a selection of patents (“sampling”), a preliminary claim construction process or the conduct of the proceedings in several stages may be agreed at the start or in the course of the proceedings<sup>24</sup>. In arbitrations, such case management discussions usually will be conducted by the tribunal in the context of the preparatory conference.<sup>25</sup>

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<sup>22</sup> While some national courts have taken the approach of setting global royalty rates in FRAND disputes, in an arbitration parties have control over the jurisdictional scope of the tribunal.

<sup>23</sup> Paragraph 1 of the WIPO Model FRAND Mediation/Arbitration Submission Agreement/WIPO Model Expert Determination Submission Agreement, Annexes I, II and V.

<sup>24</sup> For example, this could be where parties decide that certain issues will be submitted to a tribunal in a first stage whereas other issues will be subject to further negotiations between the parties. If such negotiations are not successful within a certain period, then these issues will also be referred to the tribunal.

<sup>25</sup> Article 40 WIPO Arbitration Rules, Article 34 WIPO Expedited Arbitration Rules.

- (21) The WIPO model agreements do not propose any methodology to determine FRAND licensing terms but leave such choice entirely to parties and neutrals. In an arbitration, during the case management conference or later in the process, the neutral may consult with the parties on this matter<sup>26</sup>; if the parties cannot agree on a methodology, this will be left to the neutral to decide.
- (22) For expedited arbitrations, the WIPO model agreements suggest limiting the proceedings to a small number of SEPs to ensure that the envisaged time and cost efficiency of this procedure can be achieved.
- (23) In expert determinations regarding essentiality, the WIPO model agreements suggest specifying which patents will be reviewed and against which standard.

**B. Appointment procedure; qualifications of the arbitrators, mediators and experts**

- (24) Specialized neutrals with expertise in patent disputes and SEP licensing will be fundamental for achieving high-quality outcomes while limiting the time and cost of the proceedings. The appointment procedure will be governed by the applicable institutional rules, unless otherwise agreed by the parties.
- (25) For arbitrations, the WIPO model agreement proposes that the arbitral tribunal consists of three arbitrators.<sup>27</sup> In line with the WIPO Arbitration Rules, each party will be requested to appoint one arbitrator; the two arbitrators thus appointed will then appoint the presiding arbitrator. In making any default appointment under Article 19 of the WIPO Arbitration Rules, including proposing candidates to the parties in accordance with Article 19(b) of the WIPO Arbitration Rules (list procedure), the WIPO Center will to the extent possible draw on its special list of neutrals<sup>28</sup> for patents in standards. To expedite the establishment of the arbitral tribunal, the periods of time relating to the appointment of the arbitrators in Articles 17(b) and 18(b) of the WIPO Arbitration Rules have been shortened to 15 days.

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<sup>26</sup> For an overview of case law concerning methodologies for calculating FRAND damages see Layne-Farrar, Anne and Wong-Ervin, Koren W., Methodologies for Calculating FRAND Damages: An Economic and Comparative Analysis of the Case Law from China, the European Union, India, and the United States (July 24, 2017). Jindal Global Law School Law Review, Fall 2017 ; George Mason Law & Economics Research Paper No. 17-28, available at <https://ssrn.com/abstract=2985073>.

<sup>27</sup> Annex III, paragraph 2.

<sup>28</sup> [www.wipo.int/amc/en/neutrals/](http://www.wipo.int/amc/en/neutrals/).

- (26) In expedited arbitrations, there will be a sole arbitrator, in line with the WIPO Expedited Arbitration Rules. The sole arbitrator will be appointed jointly by the parties or, if such appointment is not made, the Center shall apply the list procedure and propose candidates to the parties from its special list of neutrals for patents in standards.<sup>29</sup>
- (27) A similar list procedure applies to ensure FRAND expertise of candidates for appointment as mediators.<sup>30</sup>
- (28) In expert determinations, where the parties have not agreed themselves on the expert or on the procedure for appointing the expert, the WIPO Center will appoint the expert from its special list of neutrals for patent standards after consultation with the parties and taking into account the specifics of the case.<sup>31</sup>
- (29) Prior to any appointment under WIPO Rules, each arbitrator, mediator, or expert will have to confirm his or her impartiality and independence and, by accepting appointment under WIPO Rules, undertakes to make available sufficient time for an expeditious conduct of the proceedings.<sup>32</sup>

### **C. Procedural Schedule; Online Case Administration Tools; Evidentiary Issues**

- (30) In their arbitration submission agreement, parties may establish a time schedule to facilitate an efficient conduct of the arbitration. If parties cannot agree such schedule in the submission agreement or clause, it may also be developed by the arbitral tribunal, once appointed, in consultation with the parties.<sup>33</sup>
- (31) For arbitrations and expedited arbitrations, the model agreements propose detailed procedural schedules for the proceedings, guided by WIPO patent arbitration case experience.<sup>34</sup> The schedules envisage that a final award in a WIPO FRAND Arbitration would normally be issued within 14-16 months, and in a WIPO FRAND Expedited Arbitration within 6-8 months. Certain periods of time may be reduced or extended in the course of the proceedings by the parties, the tribunal or the WIPO Center in accordance with the WIPO Arbitration/Expedited Arbitration Rules.<sup>35</sup>

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<sup>29</sup> In WIPO Expedited Arbitrations, parties benefit from fixed arbitrator's fees, [www.wipo.int/amc/en/arbitration/fees/](http://www.wipo.int/amc/en/arbitration/fees/).

<sup>30</sup> Article 7 of the WIPO Mediation Rules

<sup>31</sup> Article 9 of the WIPO Expert Determination Rules.

<sup>32</sup> Article 23(a) WIPO Arbitration Rules; Article 18(a) WIPO Expedited Arbitration Rules; Article 7(c) WIPO Mediation Rules; Article 10 of the WIPO Expert Determination Rules.

<sup>33</sup> See Paragraph 3 of the Model WIPO Procedural Order, Annex IV.

<sup>34</sup> Paragraph 4 of the WIPO Model FRAND Arbitration Submission Agreement, Annex III.

<sup>35</sup> Articles 4(f), (g) and 37(c) of the WIPO Arbitration Rules; Articles 4(f)-(h) and 31(c) WIPO Expedited Arbitration Rules.

- (32) In the interest of time, parties may make use of online case administration tools as provided by the administering institution. The WIPO model agreements encourage the use of the WIPO eADR.<sup>36</sup> WIPO eADR, which the WIPO Center makes available to parties at no additional cost, allows parties and all other actors in a case under WIPO Rules to submit communications electronically into a secure online docket. In addition to facilitating online communication and storage, WIPO eADR can also provide a summary of case information, an overview of timelines, contact information of all parties, and the finance status of the case. The WIPO Center also supports the online conduct of proceedings, including online hearings<sup>37</sup>. Parties have control over the process and are free to select an online platform of their choice or use the WIPO Center facilitated video conferencing facilities.
- (33) Parties also may agree certain evidentiary issues. This may include agreement on matters such as the production of documents and other evidence, the need for technical and economic experts, and testimonies of witnesses of fact and expert witnesses. The WIPO model agreements and the WIPO Model Procedural Order propose some options for parties to that effect.<sup>38</sup>

#### **D. Applicable law; Place of Mediation/Arbitration; Language of the Proceedings**

- (34) To facilitate an efficient conduct of the ADR proceedings, parties are strongly encouraged to agree the law that will govern the dispute, the place of mediation or arbitration, and the language of the proceedings.
- (35) In line with the WIPO Rules, the WIPO model submission agreements confirm that the applicable law, the place of mediation or arbitration and the language of the proceedings can be freely chosen by the parties.<sup>39</sup> In WIPO expert determinations, the parties are also free to choose the language of the proceedings.<sup>40</sup> If the parties choose to hold hearings at WIPO in Geneva, the WIPO Center arranges for meeting support services, including hearing and caucus rooms, free of charge. The WIPO Center can also arrange online videoconferencing and provide technical support if parties choose to have hearings or meetings online<sup>41</sup>.

<sup>36</sup> Paragraph 5 of the WIPO Model FRAND Arbitration Submission Agreement, Annex III. [www.wipo.int/amc/en/eadr/](http://www.wipo.int/amc/en/eadr/).

<sup>37</sup> [www.wipo.int/amc/en/eadr/checklist/](http://www.wipo.int/amc/en/eadr/checklist/).

<sup>38</sup> See for example paragraphs 3, 4 and 6 to 9 of the WIPO Model Procedural Order (Annex IV).

<sup>39</sup> Paragraph 3 of the WIPO Model FRAND Arbitration Submission Agreement, Annex III.

<sup>40</sup> Article 4 WIPO Expert Determination Rules; Annex V.

<sup>41</sup> [www.wipo.int/amc/en/eadr/checklist/](http://www.wipo.int/amc/en/eadr/checklist/).

### **E. Confidentiality**

- (36) Under the WIPO Arbitration and Expedited Arbitration Rules, unless otherwise agreed by the parties or required by law, the existence of the arbitration, information on disclosures made during the arbitration, and the arbitration award itself enjoy high standards of confidentiality protection.<sup>42</sup> Similar standards are included in the WIPO Mediation Rules and WIPO Expert Determination Rules.<sup>43</sup>
- (37) Following commencement of the arbitration, the WIPO Arbitration and Expedited Arbitration Rules give the arbitral tribunal the power to issue protective orders as may be appropriate during the proceedings. For example, when requests for the production of documents relate to comparable licenses of SEPs, such licenses may contain confidentiality/non-disclosure obligations. The WIPO Arbitration and Expedited Arbitration Rules provide mechanisms for addressing such issues including by, where appropriate, special measures of protection such as an attorneys-eyes-only designation or the appointment of a confidentiality advisor.<sup>44</sup> For example, parties may assign different levels of confidentiality to different categories of documents to ensure they have appropriate levels of control over sensitive information.
- (38) Noting public interest in having access to information concerning methodologies used by arbitral tribunals to determine FRAND terms, parties could potentially wish to agree disclosing such specific information, while otherwise maintaining the confidentiality offered by the WIPO Rules. Such party agreement could be made at any stage of the arbitration proceedings. In any event, to the extent necessary to comply with a legal requirement imposed on a party, or in connection with a court action relating to the award or as otherwise required by the law, the parties, the arbitrator and the WIPO Center can disclose the award under the WIPO Arbitration and Expedited Arbitration Rules.<sup>45</sup>

### **F. Interim measures**

- (39) Under the WIPO Arbitration and Expedited Arbitration Rules the arbitral tribunal may issue any provisional order it deems necessary.<sup>46</sup> The model submission agreements propose limiting the arbitral tribunal's power concerning interim injunctions in a FRAND arbitration, unless otherwise agreed by the parties.<sup>47</sup> At

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<sup>42</sup> Articles 75-78 WIPO Arbitration Rules; Articles 68-71 WIPO Expedited Arbitration Rules.

<sup>43</sup> Articles 15-18 WIPO Mediation Rules; Article 16 WIPO Expert Determination Rules.

<sup>44</sup> Articles 54 and 57 WIPO Arbitration Rules; Articles 48 and 51 WIPO Expedited Arbitration Rules.

<sup>45</sup> Articles 77, 78 WIPO Arbitration Rules ; Articles 70, 71 WIPO Expedited Arbitration Rules.

<sup>46</sup> Article 48 WIPO Arbitration Rules; Article 42 WIPO Expedited Arbitration Rules.

<sup>47</sup> Paragraph 8 of the WIPO Model FRAND Arbitration Submission Agreement, Annex III. See also Paragraph 5 of the WIPO Model Procedural Order, Annex IV.

the same time, the model agreements confirm that the arbitral tribunal may order that a party provide security for the claim or counter-claim in an escrow account.

### **G. Appeal**

- (40) By agreeing to arbitration, under the WIPO Arbitration and Expedited Arbitration Rules the parties waive their right to any form of appeal.<sup>48</sup> An award under WIPO Rules is binding on the parties and enforceable internationally.
  
- (41) However, in exceptional cases, parties may wish to consider whether under certain circumstances they wish to agree that final awards issued by the arbitral tribunal are subject to appeal to a different arbitral tribunal.<sup>49</sup> Parties also can agree to limit such appeal to selected issues addressed in the award.

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<sup>48</sup> Article 66 WIPO Arbitration Rules; Article 59 WIPO Expedited Arbitration Rules.

<sup>49</sup> See model appeal clause in the WIPO Clause Generator: The award pursuant to Article 64 of the WIPO Arbitration Rules shall only be subject to review through an appeal to an Appellate Panel consisting of [three arbitrators] appointed pursuant to Article 17 of the WIPO Arbitration Rules. No arbitrator in the arbitral tribunal may be an arbitrator on the Appellate Panel. Such an appeal must be initiated within [30 days] of the arbitral tribunal award or otherwise the award shall become a final award pursuant to the WIPO Arbitration Rules. [If an appeal is sought, the Appellate Panel shall conduct a de novo review of the legal determinations of the arbitral tribunal and shall determine whether there is reasonable basis for all factual determinations.]; available at [www.wipo.int/amc-apps/clause-generator/arbitration/agreement/](http://www.wipo.int/amc-apps/clause-generator/arbitration/agreement/).

# ANNEX I: UNILATERAL REQUEST FOR WIPO FRAND MEDIATION (ARTICLE 4 WIPO MEDIATION RULES)<sup>1</sup>

## 1. Parties

Please provide the following contact information:

### Requesting Party

Name:

Country of domicile:

Tel:

E-mail:

Address:

### Other Party

Name:

Country of domicile:

Tel:

E-mail:

Address:

### Represented by:

Name

Tel:

E-mail:

Address:

### Represented by:

Name

Tel:

E-mail:

Address:

## 2. Dispute

Please provide a brief description of the dispute:

The dispute concerns the determination of FRAND terms relating to the Declaration[s] of [Name[s] of Company[ies]] to [Name of Standard-Setting Organization] and [list standard(s)] concerning

- [its/their patents referred to in the Declaration[s]] or
- [the following patents]:

Nothing in this Request shall prevent any party from bringing any argument or defense it chooses in the mediation.

<sup>1</sup> [www.wipo.int/amc/en/docs/art4-frand.docx](http://www.wipo.int/amc/en/docs/art4-frand.docx).

(a) The Requesting Party agrees to submit the above-described dispute to mediation in accordance with the WIPO Mediation Rules.

Please sign this form and submit it to [arbiter.mail@wipo.int](mailto:arbiter.mail@wipo.int) and the other party.

Place and Date: \_\_\_\_\_

Signature: \_\_\_\_\_

(b) The Other Party agrees to submit the above-described dispute to mediation in accordance with the WIPO Mediation Rules.

Please sign this form and submit it to [arbiter.mail@wipo.int](mailto:arbiter.mail@wipo.int) and the requesting party.

Place and Date: \_\_\_\_\_

Signature: \_\_\_\_\_



## **ANNEX II: WIPO MODEL FRAND MEDIATION SUBMISSION AGREEMENT<sup>1</sup>**

1. “We, the undersigned parties, hereby agree to submit to mediation in accordance with the WIPO Mediation Rules (WIPO Rules) the following dispute:

The dispute concerns the determination of FRAND terms relating to the Declaration[s] of [Name[s] of Company[ies]] to [Name of Standard-Setting Organization] and [list standard(s)] concerning

- [its/their patents referred to in the Declaration[s]] or
- [the following representative patents (each party shall select a maximum of [specify number] patents referred to in the Declaration[s])<sup>2</sup>

Nothing in this agreement shall prevent any party from bringing any argument or defense it chooses in the mediation.<sup>3</sup>

2. The appointment of the mediator shall take place in accordance with the procedure set out in Article 7(a) of the WIPO Rules. In proposing candidates to the parties pursuant to Article 7(a)(i) of the WIPO Rules, the WIPO Arbitration and Mediation Center (WIPO Center) shall to the extent possible draw on its list of neutrals for patents in standards.
3. The place of mediation shall be [specify place]. The language to be used in the mediation shall be [specify language].”

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<sup>1</sup> [www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex5/](http://www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex5/).

<sup>2</sup> At the time of the conclusion of the mediation submission agreement, parties have the option to limit the scope of the proceedings to a certain number of patents referred to in the Declaration, or to refer an entire patent portfolio to mediation. A selection of patents (“sampling”) may also be agreed by parties in the course of the proceedings. Parties further have the option to agree that the scope of the mediation shall include patents on a reciprocity basis / cross-licensing.

<sup>3</sup> This may include patent essentiality, validity, infringement, and enforceability.

## ANNEX III: WIPO MODEL FRAND ARBITRATION SUBMISSION AGREEMENT<sup>1</sup>

1. “We, the undersigned parties, hereby agree that the following dispute shall be referred to and finally determined by arbitration in accordance with the WIPO Arbitration Rules (WIPO Rules) unless otherwise stated in this submission agreement:

The dispute concerns the determination of FRAND terms relating to the Declaration[s] of [Name[s] of Company[ies]] to [Name of Standard-Setting Organization] and [list standard(s)] concerning

- [its/their patents referred to in the Declaration[s]] or
- [the following representative patents (each party shall select a maximum of [specify number] patents referred to in the Declaration[s]);]<sup>2</sup>

Nothing in this agreement shall prevent any party from bringing any argument or defense it chooses in the arbitration.<sup>3</sup>

2. The arbitral tribunal shall consist of three arbitrators. In making any default appointment under Article 19 of the WIPO Rules, including proposing candidates to the parties in accordance with Article 19(b) of the WIPO Rules, the WIPO Arbitration and Mediation Center (WIPO Center) shall to the extent possible draw on its list of neutrals for patents in standards. The periods of time relating to the appointment of the arbitrators in Articles 17(b) and 18 of the WIPO Rules shall be reduced to 15 days.
3. The place of arbitration shall be [specify place]. The language to be used in the arbitral proceedings shall be [specify language]. The dispute shall be decided in accordance with the law of [specify jurisdiction].

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<sup>1</sup> [www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex1/](http://www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex1/).

<sup>2</sup> At the time of the conclusion of the arbitration submission agreement, parties have the option to limit the scope of the arbitration to a certain number of patents referred to in the Declaration, or to refer a patent portfolio to the arbitration. A selection of patents (“sampling”) may also be agreed by parties, or ordered by the arbitral tribunal, in the course of the arbitration proceedings (see Section 6). Parties have the option to agree that the scope of the arbitration shall include patents on a reciprocity basis / cross-licensing. Parties may also choose whether the tribunal will determine FRAND licensing terms globally or whether such determination will be limited to certain jurisdictions or markets selected by the parties.

<sup>3</sup> This may include patent essentiality, validity, infringement, and enforceability. Parties also can agree to limit claims or defenses that they may bring in the arbitration, including patent essentiality, validity, infringement, and enforceability. They may for example agree that such arguments may be heard but no binding decision regarding these issues may be taken by the tribunal, or that such arguments may not be heard or decided upon by the tribunal.

4. The parties agree the following schedule:<sup>4</sup>

Request for Arbitration (Article 6 WIPO Rules)	
Answer to the Request (Article 11 WIPO Rules) Arbitration	15 days after receipt of the Request for Arbitration
Establishment of the Tribunal (Articles 17-23 WIPO Rules) Arbitration	30 days after receipt of the Request for Arbitration
Preparatory Conference (Article 40 WIPO Rules)	15 days after establishment of the Tribunal
Statement of Claim (Article 41 WIPO Rules)	30 days after establishment of Tribunal
Statement of Defense (Article 42 WIPO Rules)	30 days after Statement of Claim
Claimant Reply	15 days after Statement of Defense
Respondent Sur-Reply	15 days after Claimant Reply
All Document Production Completed (Article 50 WIPO Rules)	30 days after Respondent Sur-Reply
Fact Witness Statements (Article 56 WIPO Rules)	30 days after Document Production
[Fact Witness Depositions Completed]	[30 days after Fact Witness Statements]
Expert Witness Statements (Articles 56, 57 WIPO Rules)	30 days after Fact Witness Depositions
[Rebuttal Expert Witness Statements]	[30 days after Expert Witness Statements]
[Expert Witness Depositions Completed]	[20 days after Rebuttal Expert Witness Statements]
Hearing (Article 55 WIPO Rules)	30 days after Expert Witness Depositions
Claimant Post-Hearing Submission	30 days after Hearing
Respondent Post-Hearing Submission Submission	30 days after Claimant Post-Hearing Submission
Claimant Reply	15 days after Respondent Post-Hearing Submission
Respondent Sur-Reply	15 days after Claimant Reply

5. All submissions shall be made on the specified due date via the WIPO eADR.

6. An initial Preparatory Conference pursuant to Article 40 of the WIPO Rules is scheduled 15 days after the establishment of the arbitral tribunal. The arbitral tribunal shall draw up, in consultation with the parties, a document defining the issues of the arbitration, the methodology to be used and, if appropriate, stages of the proceedings.

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<sup>4</sup> The periods of time may be reduced or extended in the course of the arbitration in accordance with Article 4(f) and (g) of the WIPO Rules. Not every stage may apply in each procedure and, in that case, the timeline shall be counted from the prior stage.

7. Further to Articles 41 and 42 of the WIPO Rules, the parties shall, to the extent possible submit the documents and other evidence upon which they seek to rely concurrently with the Statement of Claim and the Statement of Defense. Supplemental documents and other evidence may be submitted concurrently with the Reply to the Statement of Defense and the Sur-Reply.
8. The arbitral tribunal shall not have the authority to issue interim injunctions under Article 48(a) of the WIPO Rules. In accordance with Article 48(b) of the WIPO Rules, the arbitral tribunal may order that a party provide security for the claim or counter-claim in an escrow account.
9. The parties shall try to informally resolve requests for production of documents and other evidence. The parties may bring requests for disclosure under Article 50(b) of the WIPO Rules only if they reach an impasse on the production of documents or other evidence.<sup>5</sup>
10. Further to Article 56 of the WIPO Rules, the parties shall simultaneously submit sworn witness statements for each witness of fact on whom they propose to rely at the Hearing pursuant to Article 55 of the WIPO Rules. Such a statement should be sufficiently detailed so as to stand as that witness's direct testimony.
11. Further to Article 56 of the WIPO Rules and in accordance with the schedule set forth above, the parties shall submit sworn expert witness statements for each expert witness on whom they propose to rely at the Hearing pursuant to Article 55 of the WIPO Rules. Such statements should be sufficiently detailed so as to stand as that witness's direct testimony.
- [12. The parties are permitted to depose witnesses expected to testify at the Hearing pursuant to Article 55 of the WIPO Rules in accordance with the schedule set forth above.]
13. The Hearing pursuant to Article 55 of the WIPO Rules shall be held for not more than five days.
14. The parties may file wholly or partially dispositive motions as they wish. Once filed, the arbitral tribunal shall determine if a briefing schedule is appropriate or if the motion should be stayed. The filing of any motion will not necessarily suspend or postpone the agreed schedule.”

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<sup>5</sup> When requests for the production of documents relate to comparable licenses of the patents referred to in para. 1, such licenses may contain confidentiality/non-disclosure obligations. Articles 54(c)-(e) and 57 of the WIPO Rules provide mechanisms for addressing such issues including by, where appropriate, special measures of protection or the appointment of a confidentiality advisor.

## **ANNEX IV: WIPO MODEL PROCEDURAL ORDER**



### **WIPO Arbitration and Mediation Center**

#### **WIPO Case Reference: [...]**

In the matter of arbitration under the  
WIPO Arbitration Rules

between:

**[...] (Claimant)**

**v.**

**[...] (Respondent)**

#### **Procedural Order for FRAND Disputes**

Arbitral tribunal

[...], Chairman of the arbitral tribunal

[...], Arbitrator

[...], Arbitrator

Place of arbitration: [city, country]

In view of the parties' submissions and positions, and issues raised during the preparatory conference conducted pursuant to Article 40 of the WIPO Arbitration Rules ("the WIPO Rules") which took place on [date], the arbitral tribunal hereby makes the following order:

1. Article [...] of the Agreement will govern the form and conduct of the arbitral proceedings. In accordance with this provision,

"Any dispute, controversy or claim arising under, out of or relating to this contract and any subsequent amendments of this contract, including, without limitation, its formation, validity, binding effect, interpretation, performance, breach or termination, as well as non-contractual claims, shall be referred to and finally determined by arbitration in accordance with the WIPO Arbitration Rules. The arbitral tribunal shall consist of three arbitrators. The place of arbitration shall be [specify place]. The language to be used in the arbitral proceedings shall be [specify language]. The dispute, controversy or claim shall be decided in accordance with the law of [specify jurisdiction]."

2. Following the submissions filed by the parties, the parties have agreed that the dispute concerns the determination of FRAND terms relating to the Declaration[s] of [Name[s] of Company[ies]] to [Name of Standard-Setting Organization] and [list standard(s)] concerning
  - [its/their patents referred to in the Declaration[s]].
  - [the following representative patents referred to in the Declaration[s]].<sup>1</sup>

The parties have agreed that nothing in this agreement shall prevent any party from bringing any argument or defense it chooses in the arbitration.<sup>2</sup>

3. Pursuant to its powers under Article 37 of the WIPO Rules, the arbitral tribunal hereby sets the following schedule as agreed by the parties:

Statement of Claim (Article 41 WIPO Rules)	30 days after Procedural Order [No. X]
Statement of Defense (Article 42 WIPO Rules)	30 days after Statement of Claim
Claimant Reply	15 days after Statement of Defense
Respondent Sur-Reply	15 days after Claimant Reply
All Document Production Completed (Article 50 WIPO Rules)	30 days after Sur-Reply
Fact Witness Statements (Article 56 WIPO Rules)	30 days after Document Production
[Fact Witness Depositions Completed]	[30 days after Witness Statements]
Expert Witness Statements (Articles 56, 57 WIPO Rules)	30 days after Fact Witness Depositions
[Rebuttal Expert Witness Statements]	[30 days after Expert Witness Statements]
[Expert Witness Depositions Completed]	[20 days after Rebuttal Expert Witness Statements]
Hearing (Article 55 WIPO Rules)	30 days after Expert Witness Depositions
Claimant Post-Hearing Submission	30 days after Hearing
Respondent Post-Hearing Submission	30 days after Claimant Post-Hearing Submission
Claimant Reply	15 days after Respondent Post-Hearing Submission
Respondent Sur-Reply	15 days after Claimant Reply

All submissions shall be made on the specified due date via the [WIPO eADR](#).

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<sup>1</sup> Parties have the option to limit the scope of the arbitration to a certain number of patents referred to in the Declaration (“sampling”), or to refer a patent portfolio to the arbitration. Parties further have the option to agree that the scope of the arbitration shall include patents on a reciprocity basis (cross-licensing).

<sup>2</sup> This may include patent essentiality, validity, infringement, and enforceability. However, parties also can agree to limit claims or defenses that they may bring in the arbitration, including patent essentiality, validity, infringement, and enforceability. They may for example agree that such arguments may be heard but no binding decision regarding these issues may be taken by the tribunal, or that such arguments may not be heard or decided upon by the tribunal.

4. Pursuant to Articles 41 and 42 of the WIPO Rules, the parties shall, to the extent possible, submit the documents and other evidence upon which they seek to rely concurrently with the Statement of Claim and the Statement of Defense. Supplemental documents and other evidence may be submitted concurrently with the Reply to the Statement of Defense and the Sur-Reply.
5. The arbitral tribunal shall not have the authority to issue interim injunctions under Article 48(a) of the WIPO Rules. In accordance with Article 48(b) of the WIPO Rules, the arbitral tribunal may order that a party provide security for the claim or counter-claim in an escrow account.
6. The arbitral tribunal expects the parties shall try to informally resolve requests for production of documents and other evidence. The parties may bring requests for disclosure under Article 50(b) of the WIPO Rules only if they reach an impasse on the production of documents or other evidence.
7. In accordance with Article 56 of the WIPO Rules, on [date], the parties shall simultaneously submit sworn witness statements for each witness of fact on whom they propose to rely at the Hearing pursuant to Article 55 of the WIPO Rules. Such a statement should be sufficiently detailed so as to stand as that witness's direct testimony.
8. Further to Article 56 of the WIPO Rules and in accordance with the schedule set forth above, the parties shall submit sworn expert witness statements for each expert witness on whom they propose to rely at the Hearing pursuant to Article 55 of the WIPO Rules. Such statements should be sufficiently detailed so as to stand as that witness's direct testimony.
9. [The parties are permitted to depose witnesses expected to testify at the Hearing pursuant to Article 55 of the WIPO Rules in accordance with the schedule set forth above.]
10. The Hearing pursuant to Article 55 of the WIPO Rules will begin on [date]<sup>3</sup>. As agreed by the parties, the Hearing will be held for not more than five days at [place of arbitration], located at [address]. The arbitral tribunal expects the parties to arrange transcription services and other administrative details in due course.
11. The parties may file wholly or partially dispositive motions as they wish. Once filed, the arbitral tribunal shall determine if a briefing schedule is appropriate or if the motion should be stayed. The filing of any motion will not necessarily suspend or postpone the agreed schedule.
12. [The arbitral tribunal and the parties acknowledge and accept that the processing of personal data may be necessary for the purpose of the arbitral proceedings.]

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<sup>3</sup> Parties may choose to hold hearings in person or either partly or exclusively online (Article 55 of the WIPO Arbitration Rules).

13. The arbitral tribunal and the parties agree to comply with the provisions of the [relevant data protection laws and regulations] when processing any personal data of any person residing within [jurisdiction(s)] in connection with the arbitral proceedings.<sup>4]</sup>

On behalf of the arbitral tribunal

[date]

[...] (Claimant)

[...] (Respondent)

cc: WIPO Arbitration and Mediation Center

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<sup>4</sup> For further information on how the WIPO Center manages personal data, see [www.wipo.int/amc/en/arbitration/filing/#pd](http://www.wipo.int/amc/en/arbitration/filing/#pd).



## **ANNEX V: WIPO MODEL FRAND EXPERT DETERMINATION SUBMISSION AGREEMENT<sup>1</sup>**

1. “We, the undersigned parties, hereby agree to submit to expert determination in accordance with the WIPO Expert Determination Rules (WIPO Rules) the following matter:
  - [Whether the [patents][following representative patents<sup>2</sup>] referred to in the Declaration[s] of [Name[s] of Company[ies]] to [Name of Standard-Setting Organization] and [list standard(s)] are essential to the [list standard(s)]”
  - [The determination of FRAND royalty rates concerning the [patents][following representative patents] referred to in the Declaration[s] of [Name[s] of Company[ies]] to [Name of Standard-Setting Organization] and [list standard(s)]]
2. The determination made by the expert shall [not] be binding upon the parties. The language to be used in the expert determination shall be [specify language].”
3. The appointment of the expert shall take place in accordance with the procedure set out in Article 9 of the WIPO Rules. In proposing candidates to the parties pursuant to Article 9(e) of the WIPO Rules, the WIPO Arbitration and Mediation Center (WIPO Center) shall to the extent possible draw on its list of neutrals for patents in standards.”

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<sup>1</sup> [www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex5/](http://www.wipo.int/amc/en/center/specific-sectors/ict/frand/annex5/).

<sup>2</sup> At the time of the conclusion of the expert determination submission agreement, parties have the option to limit the scope of the proceedings to a certain number of patents referred to in the Declaration, or to refer an entire patent portfolio to expert determination. A selection of patents (“sampling”) may also be agreed by parties in the course of the proceedings. Parties further have the option to agree that the scope of the expert determination shall include patents on a reciprocity basis / cross-licensing.

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