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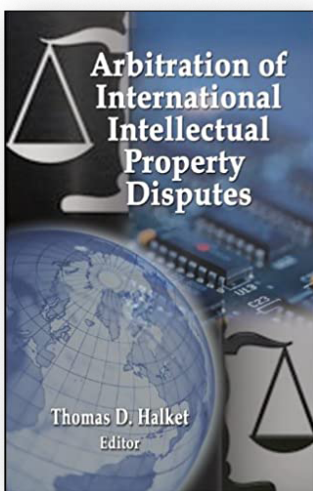
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## Diving into the Intricacies of Intellectual Property Arbitration

**Dr. Thomas Legler**

Partner, PESTALOZZI Attorneys-at-law, Geneva



### Arbitration of Intellectual Property Disputes (Second Edition)

By Thomas D. Halket (ed.)  
Juris Publishing (2021)  
ISBN 978-1-944825-51-5  
759 pages

Arbitration, as a private and confidential procedure, is increasingly being used to resolve disputes involving intellectual property (IP) rights, especially

when involving parties from different jurisdictions. Intellectual property disputes have a number of particular characteristics that may be better addressed by arbitration than by state court proceedings. It is therefore not astonishing that globally active companies, in particular in the technology and pharmaceutical industries, are increasingly turning to arbitration.

Recognizing this trend, Thomas D. Halket, FCI Arb, New York (USA), decided a few years ago to address all essential issues arising out of intellectual property arbitration in one book, which did not exist at the time in such comprehensive form. The first edition<sup>1</sup> therefore

already covered a gap in the relevant legal literature, even when other authors have addressed the topic in articles<sup>2</sup> or books.<sup>3</sup>

The second edition of 2021 is as comprehensive as the first and has been written with the assistance of 19 other authors. On the one hand, this second edition updates the first one to reflect recent developments, in particular related to the many amendments of arbitration rules of the major institutions as well as new statutes and case law.

On the other hand, new topics have been added. In this regard, the chapter on FRAND (Fair, Reasonable and Non-Discriminatory compensation) disputes has to be highlighted as well as the interesting overview on privacy and cybersecurity issues. In addition, choice-of-law issues have been added to the various chapters where they are of interest, i.e. arbitrability, the arbitration agreement, privilege and arbitrator selection.

<sup>1</sup> T.D. Halket (ed.), *Arbitration of international intellectual property disputes* (First edition) (Juris, 2012).

<sup>2</sup> Recent articles on the topic include: T. Legler, 'Arbitration of Intellectual Property Disputes', *ASA Bulletin* 2019, 289; D.M. Vicente, 'Arbitrability of Intellectual Property Disputes: A Comparative Study', 2015, Vol. 31 *Arbitration International*, 151; A. Carlevaris: 'Le contentieux institutionnel: de l'expérience et de l'utilité des institutions d'arbitrage pour les litiges de propriété intellectuelle - l'expérience de la CCI', *Rev. Arb.*, 2014, n°2; D. Rosenthal, 'IP & IT Arbitration in Switzerland', in M. Arroyo (ed.), *Arbitration in Switzerland: The Practitioner's Guide* (2013), 1111; J. De Werra, 'Arbitrating International Intellectual Property Disputes: Time to Think Beyond the Issue of (Non-)Arbitrability', 2012, *International Business Law Journal*, 299; K.R. Adamo, 'Overview of

international arbitration in the intellectual property context', 2011, Vol. 2 *Global Business Law Review*, 7; T. Legler, 'L'arbitre suisse face à l'arbitrabilité des litiges en matière de propriété intellectuelle dans un contexte international', *L'écléctique juridique: recueil d'articles en l'honneur de Jacques Python*, Berne, Stämpfli, 2011.

<sup>3</sup> Recent books on the topic include: J. Pierce, P.Y. Gunter (eds.), *The GAR Guide to IP Arbitration*, London, 2020; P. Chrocziel, B. Kasolowsky, R. Whitener, W. Prinz zu Waldeck und Pymont, *International Arbitration of Intellectual Property Disputes - A Practitioner's Guide* (Nomos Verlagsgesellschaft, 2017); D.A. Allgeyer, 'Arbitrating Patent Disputes: A Practical Guide' (American Bar Association, 2017); T. Cook, A. Garcia, *International Intellectual Property Arbitration* (Alphen aan den Rijn, 2010).

We understand that the book is primarily addressed to lawyers, not necessarily arbitration lawyers, who wish to understand how arbitration can be used to resolve international IP disputes. That is the reason why the book includes introductions to basic topics in arbitration like the arbitration agreement (*Thomas D. Halket, Maria Chedid*), arbitral institutions and arbitration rules (*Sherman Kahn, Conna A. Weiner*), choice of arbitrator (*James Bridgeman, Richard C. Levin*), confidentiality and privacy (*Laura A. Kaster, Philip D. O'Neill, Jr.*), disclosure and admission of evidence (*Angela Foster, Merriann M. Panarella*) and choice of law (*Theodore J. Folkman, David Lee Evans*). All these topics are covered in the relevant chapters with specific references to intellectual property disputes and are presented in a comprehensive manner, allowing arbitration lawyers to gain great benefit as well.

Incidentally, (arbitration) practitioners with IP experience may also be interested in other chapters of the book, such as the introduction by the editor, the chapters on arbitrability (*Steven A. Certilman, William H. Baker*), the impact of public policy considerations (*Richard Kreindler, Jean-Yves Garaud*), preliminary and final remedies (*David H. Herrington, Alexandra K. Theobald*) and enforceability (*Thierry Calame, Martin Aebi*), which is highly relevant in international IP disputes where it is particularly important that interim and final injunctive relief or orders for specific performance can be enforced without delay or obstruction.

The book is also particularly distinguished by the fact that country-specific aspects are addressed, which also enables the reader to compare laws and to become aware of how different understandings of the law lead to different legal applications. For example, there are still countries where patent disputes may virtually not be subject to arbitration (e.g. China) and other countries that declare all IP disputes arbitrable and even enforceable (e.g. Switzerland).

The book has also a comprehensive table of authorities and cases as well as a useful table of statutes and rules quoted in the various chapter.

The wealth of information as well as the quality of the presentation are more than compelling. There is little missing, such as issues in connection with the current pandemic (which occurred when the book was being written) leading arbitral tribunals to more frequently use videoconferences to conduct hearings and how this specifically affects IP disputes (viewing objects of patents, hearing of expert witnesses, etc.). Such topics could, for instance, be considered for a third edition.

In summary, the book is a comprehensive and outstanding publication in the field of IP arbitration and it is recommended to any practitioner, i.e. both IP lawyers seeking to understand how arbitration can be used to resolve international IP disputes and arbitration lawyers who seek detailed insights into issues that regularly arise in IP disputes.