

MAYER | BROWN

RESOLVING GLOBAL IP & TECH DISPUTES: THE POWER OF ARBITRATION

Intellectual Property and Technology Disputes

April 15, 2025

PARTNER
INTELLECTUAL PROPERTY
INTERNATIONAL ARBITRATION

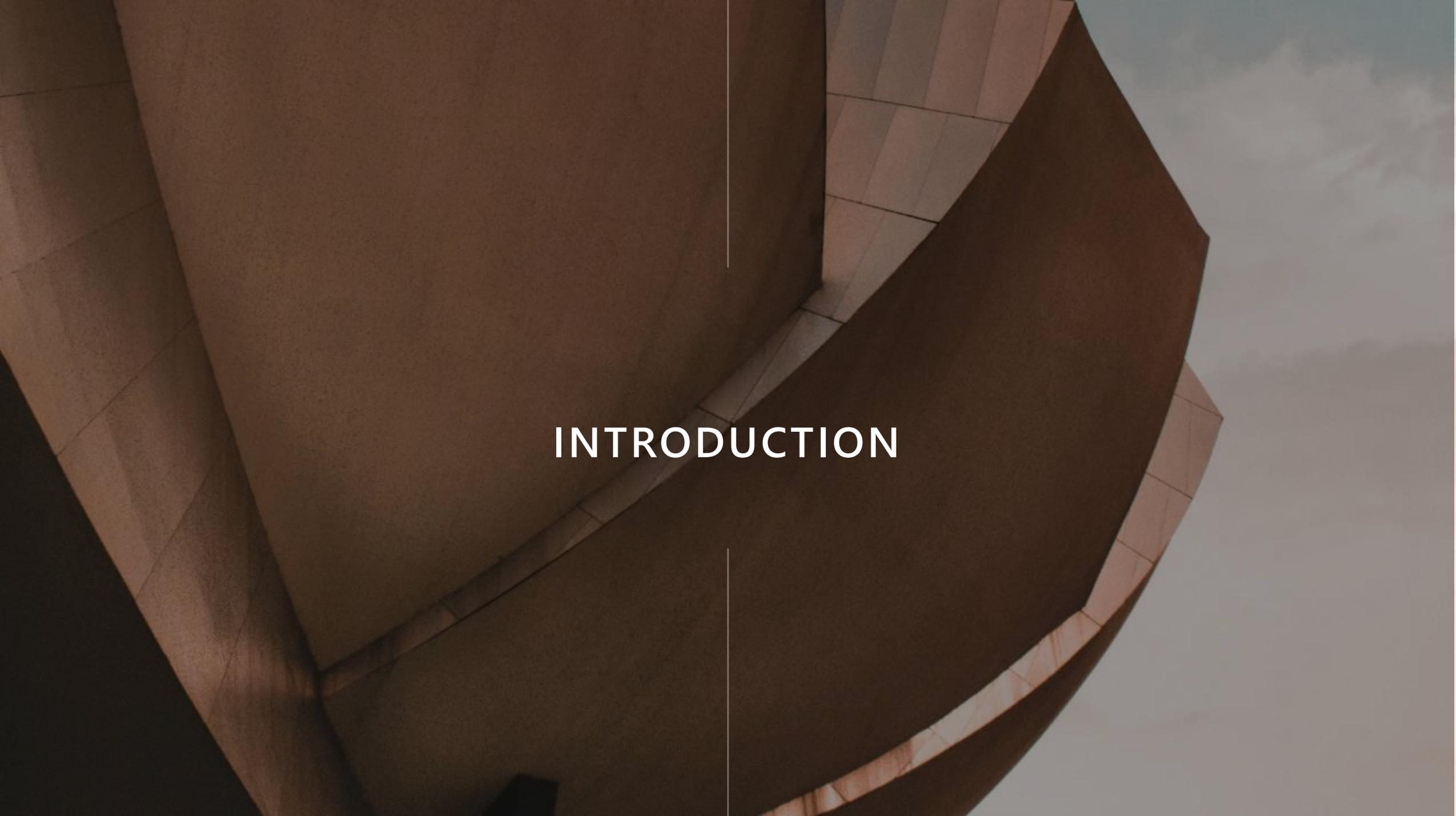
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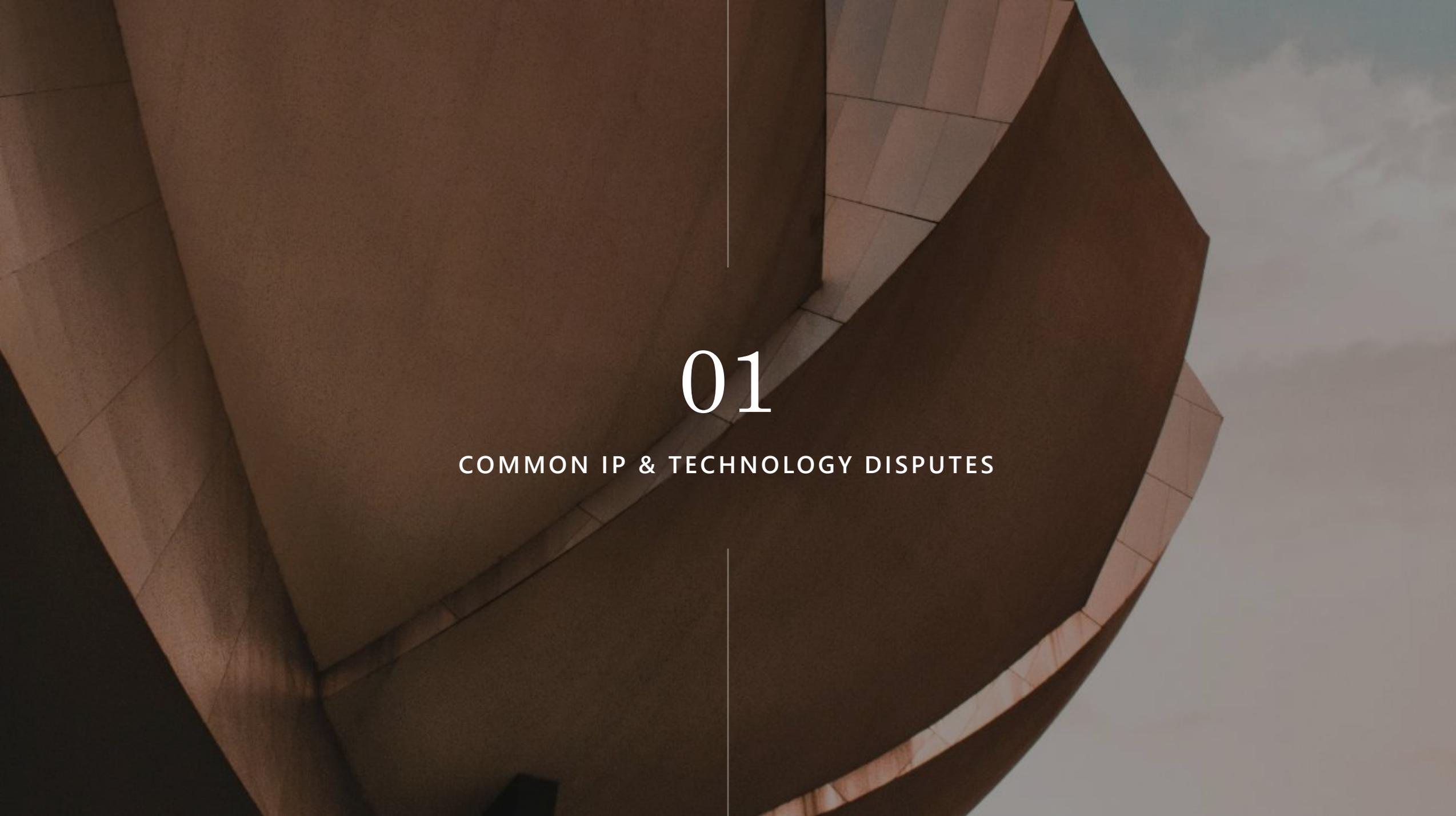
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INTRODUCTION

AGENDA

1. Common IP & Technology Disputes
2. Domain Name Disputes
3. Resolving IP Disputes
4. Evolving Trends
5. Questions



01

COMMON IP & TECHNOLOGY DISPUTES

MAINSTREAM IP RIGHTS: TRADEMARKS

- Company names, logos, labels, slogans, etc.
- Typically registered (*e.g.*, USPTO)
- Unregistered rights may also be protected

The image shows the iconic Coca-Cola logo in its signature red script font. The letters are thick and fluid, with a classic cursive style. The 'C' at the beginning is particularly large and loops around. The 'a' and 'o' are also stylized with loops and curves. The 'l' at the end is tall and thin, with a small loop at the top. The entire logo is rendered in a vibrant red color against a white background.

MAINSTREAM IP RIGHTS: COPYRIGHT

- Protects forms of expression
- Literary, dramatic, musical and artistic works, sound recordings, films, etc.
- Registration not mandatory in USA

Share a **Coke** with a friend

Get in touch with a good friend, an old friend, or maybe even a new friend.

shareacoke.com.au



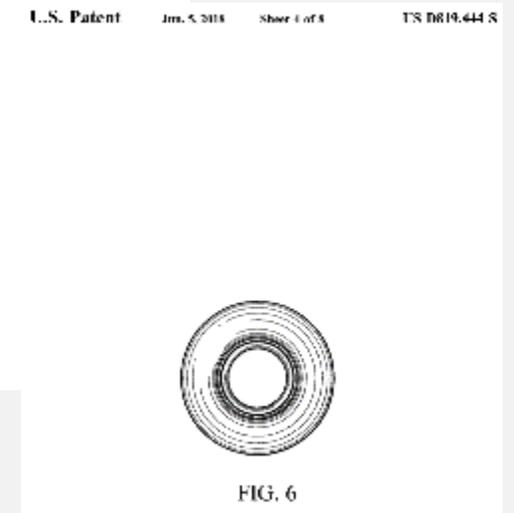
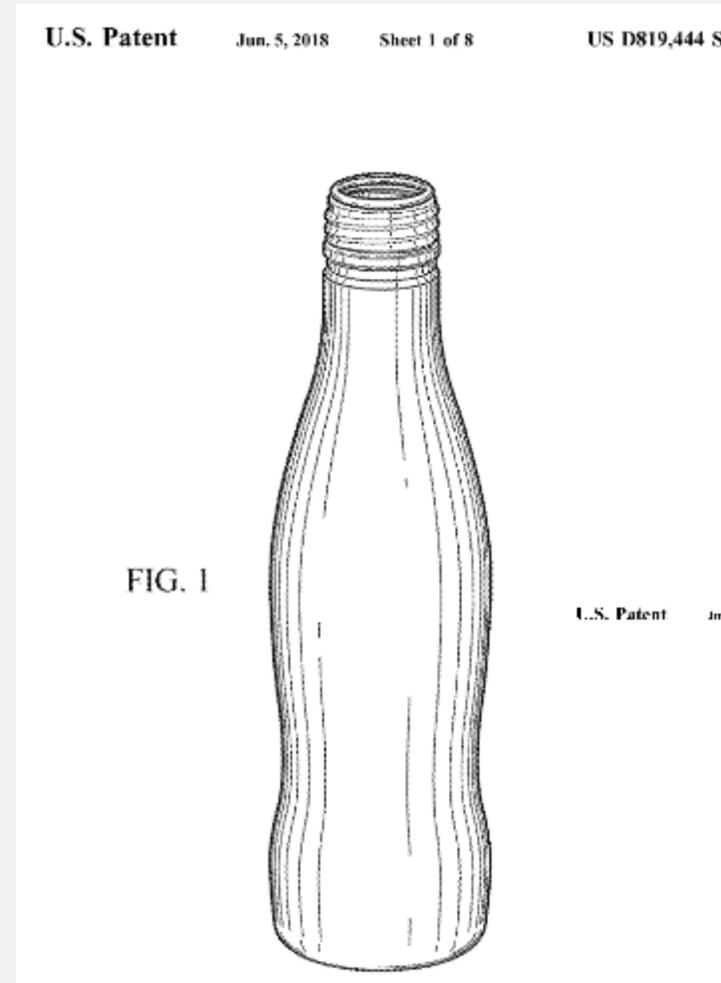
MAINSTREAM IP RIGHTS: TRADE SECRETS

- Common law doctrine of confidence
- Food and beverage recipes, sensitive business data, etc.

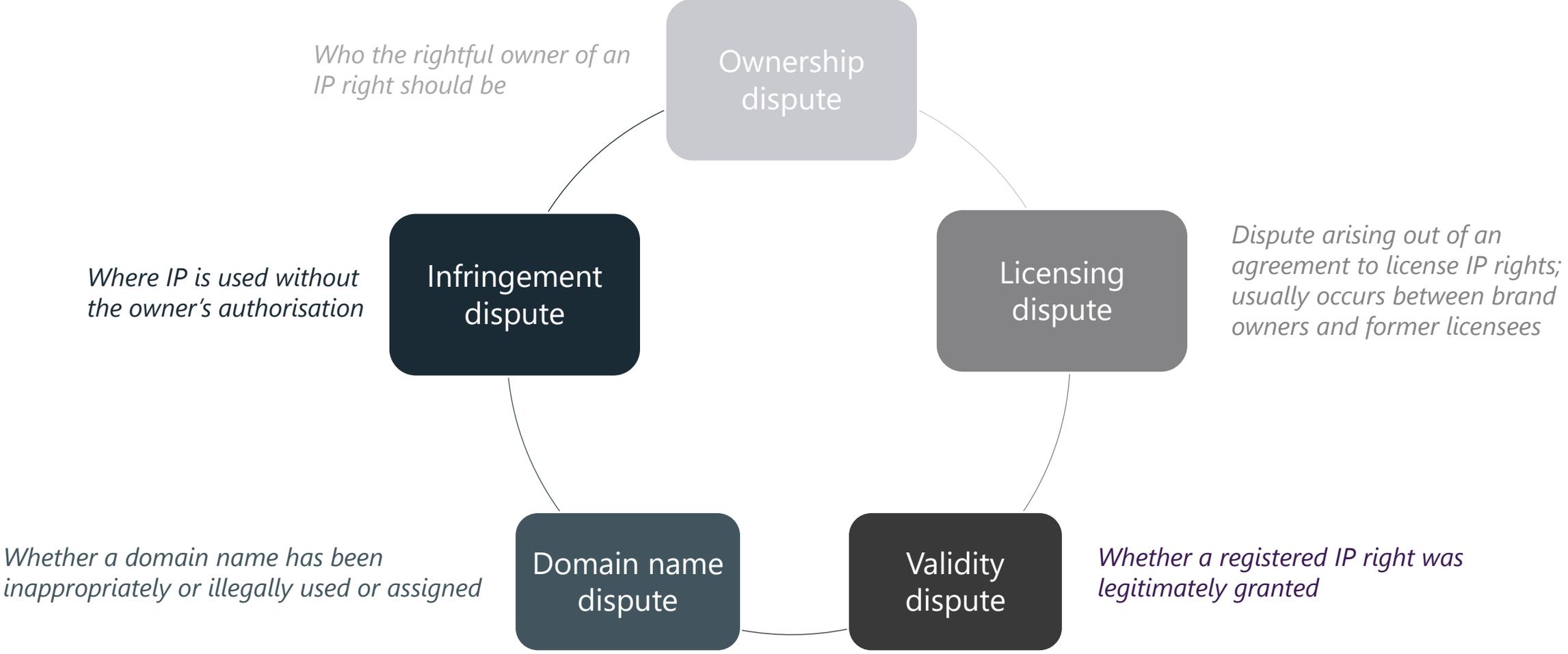


MAINSTREAM IP RIGHTS: PATENTS

- Protect inventions
- Cover products, processes, use of a product, etc.
- Registered rights



TYPES OF IP & TECHNOLOGY DISPUTES



INFRINGEMENT DISPUTE



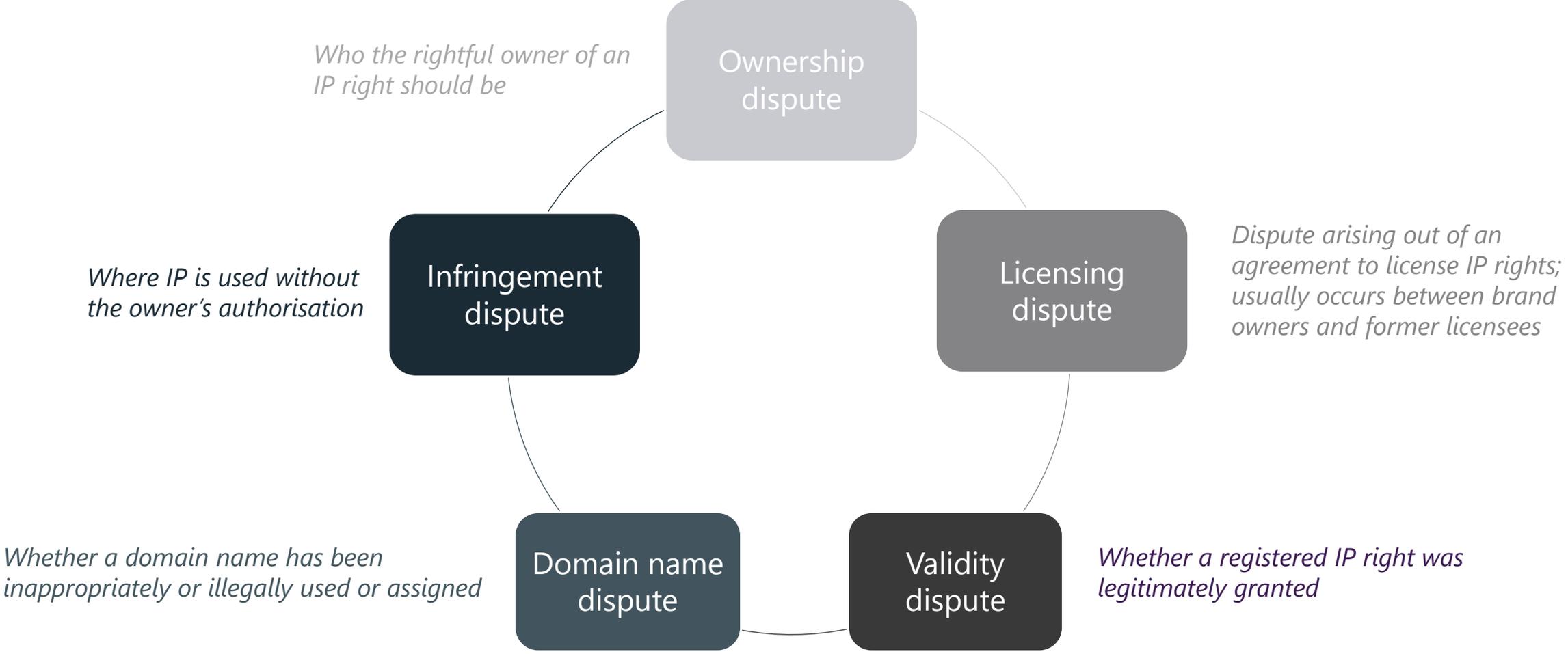
OWNERSHIP DISPUTE

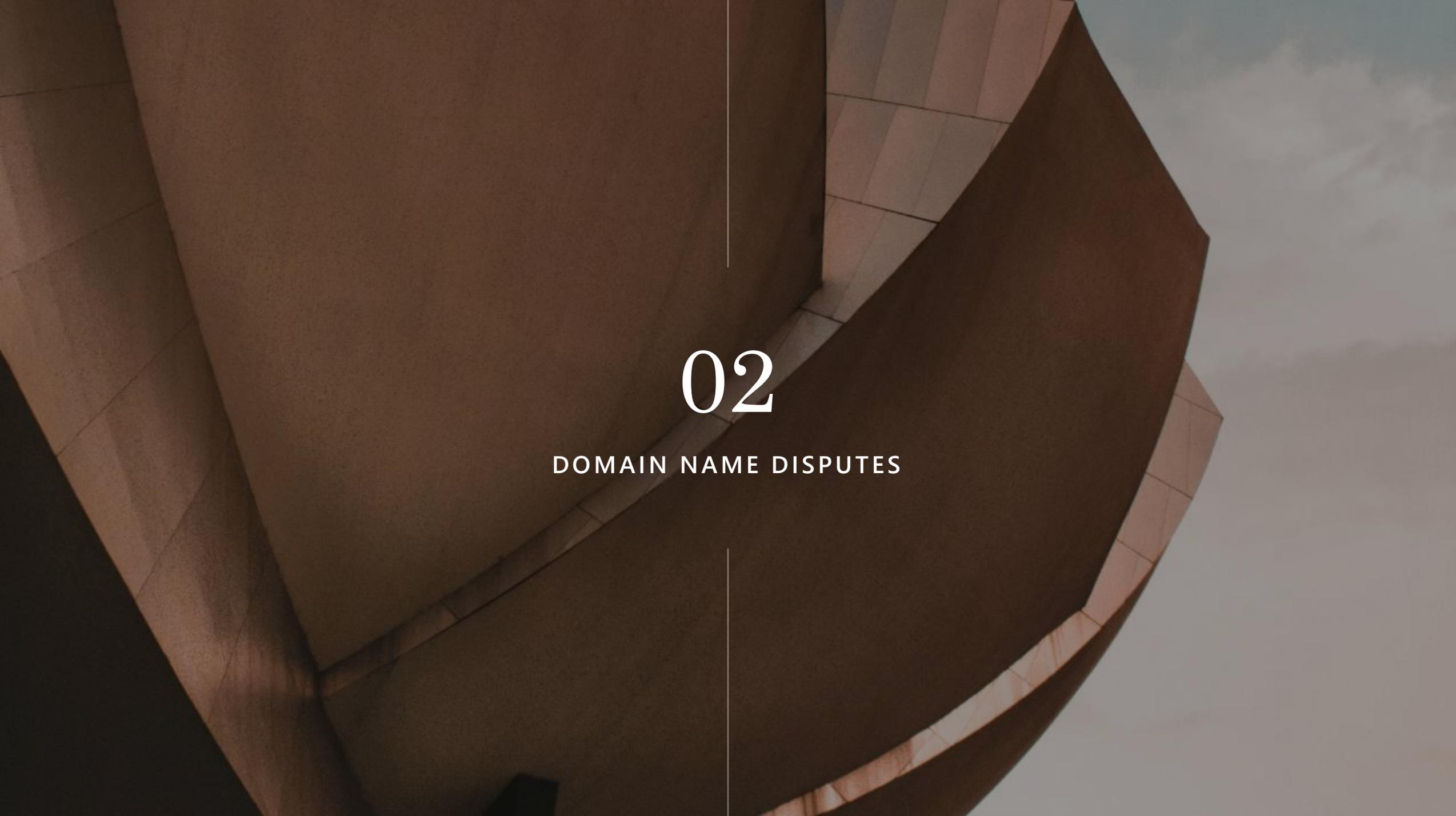


LICENSING DISPUTE



TYPES OF IP & TECHNOLOGY DISPUTES

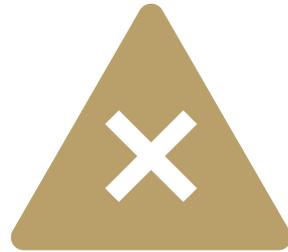




02

DOMAIN NAME DISPUTES

DOMAIN NAME DISPUTES – WHAT AND WHO

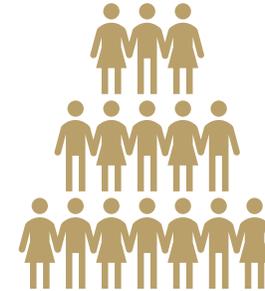


Subject of disputes

Domain names containing names identical or similar to registered trademarks

Anti-domains and criticism sites

Typo-squatters

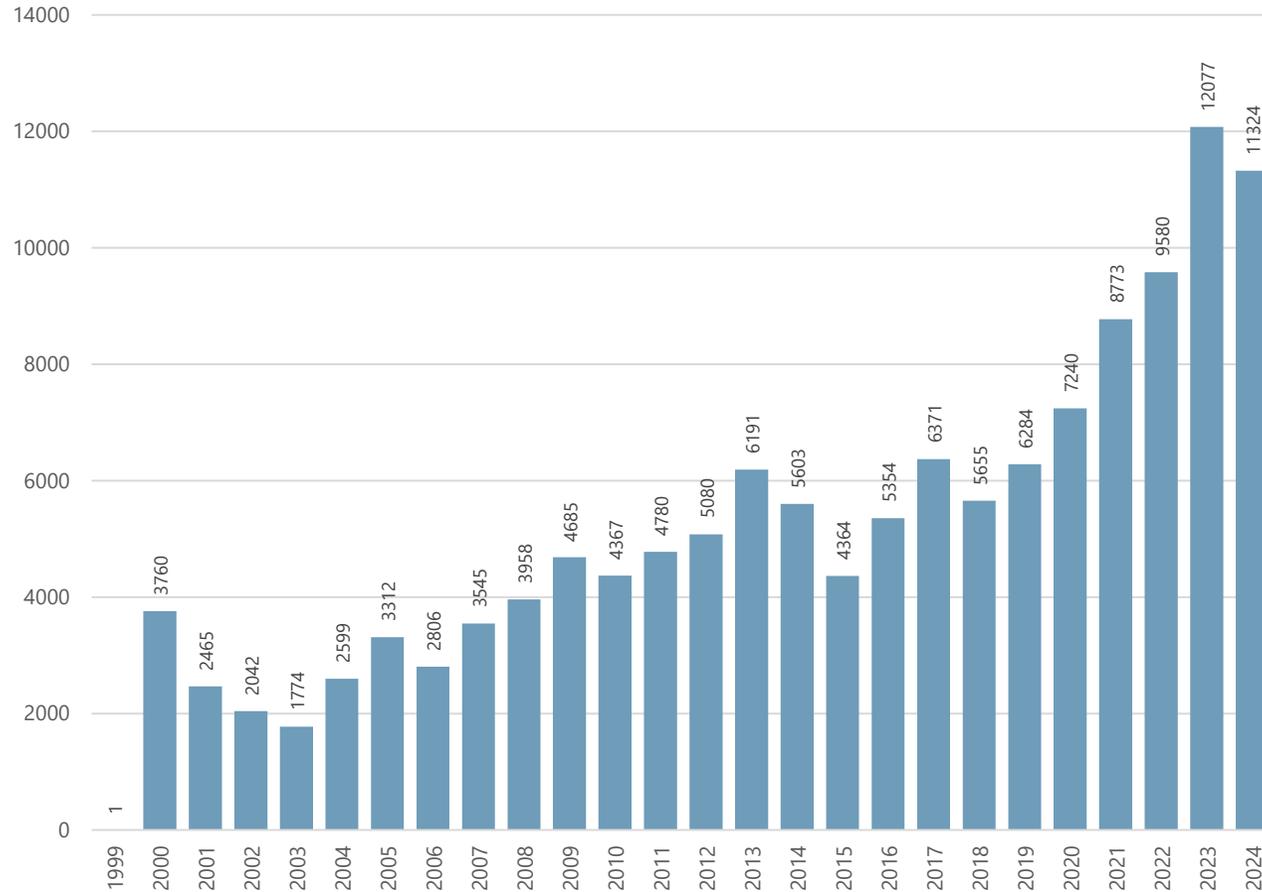


Potential infringers

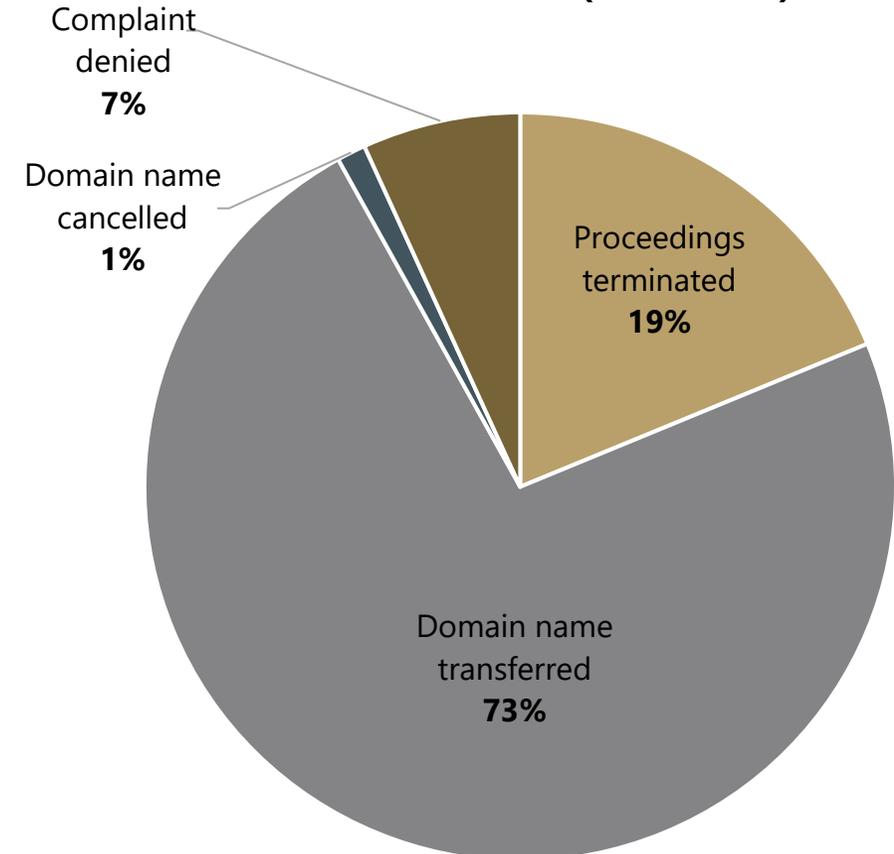
Cyber-squatters, ex-employees, unhappy customers, businesses, activists or parodists

DOMAIN NAME DISPUTES – WIPO STATISTICS

Total Number of Domain Names by Year



Case Outcomes (1999-2024)



RESOLUTION POLICIES

Uniform Domain Name Dispute Resolution Policy (“UDRP”)

- Covers all generic Top-Level Domains (“**gTLDs**”), such as .COM, .NET, .ORG, .BIZ, .INFO, .EDU, .MIL; including new gTLDs such as .APP, .SITE, and .在线.
- Covers country code Top Level Domains (“**ccTLDs**”) which have adopted the UDRP, such as: .AG, .AI, .AS, .BM, .BS, .BZ, .CC, .CD, .CO, .CV, .CY, .DJ, .EC, .FJ, .FM, .GA, .GD, .GT, .KI, .LA, .LC, .MD, .ME, .MG, .MW, .NR, .NU, .PA, .PK, .PN, .PR, .PW, .RO, .SC, .SL, .SN, .SO, .TJ, .TT, .TV, .UG, .VE, .VG, and .WS.
- Variations of the UDRP have been adopted for certain ccTLDs, such as .CN and .中国) (China); .EU, .eю, and .eu (European Union); and .SA (and (.السعودية) (Saudi Arabia).

Uniform Rapid Suspension (“URS”)

- Covers only new gTLDs introduced in the root after 1 January 2013, such as .WIKI, .CLUB, .GURU
- Covers ccTLDs which have adopted the URS, such as: .PW (Republic of Palau).
- Variations of the URS have been adopted for certain ccTLDs, such as .US (United States).

RESOLUTION POLICIES

UDRP

URS

Requirements	<ul style="list-style-type: none">• Domain name is identical, or confusingly similar to, the trade or service mark <i>in which the complainant has rights</i>• Respondent has no rights/ legitimate interests in the domain name• Domain has been registered and is being used in bad faith	<ul style="list-style-type: none">• Domain name is identical, or confusingly similar to the trademark <i>for which the complainant holds a valid national/regional registration currently in use</i>• Respondent has no rights/ legitimate interests in the domain name• Domain has been registered and is being used in bad faith
Scope	<ul style="list-style-type: none">• Covers more TLDs	<ul style="list-style-type: none">• Covers fewer TLDs
Time	<ul style="list-style-type: none">• Usually within 2 months	<ul style="list-style-type: none">• Usually less than 3 weeks
Remedies	<ul style="list-style-type: none">• <i>Transfer or cancellation</i>	<ul style="list-style-type: none">• <i>Suspension</i> for balance of registration period (extendable for an additional year upon request)
Time limit	<ul style="list-style-type: none">• No time limit	<ul style="list-style-type: none">• No time limit

FILING FEES

UDRP

Service Provider: WIPO

# of Domain Names	Single Panelist	Three Panelists
1 to 5	USD 1,500	USD 4,000
6 to 10	USD 2,000	USD 5,000
> 10	To be decided in consultation with the WIPO Center	

URS

Service Provider: Asian Domain Name Dispute Resolution Center

# of Domain Names	Filing Fee
1 to 5	USD 360
6 to 14	USD 400
15 to 29	USD 450
> 30	To be determined by ADNDRC

Service Provider: National Arbitration Forum

# of Domain Names	Filing Fee
1 to 14	USD 375
15 to 30	USD 400
31 to 50	USD 500
> 50	To contact NAF for a fee quote

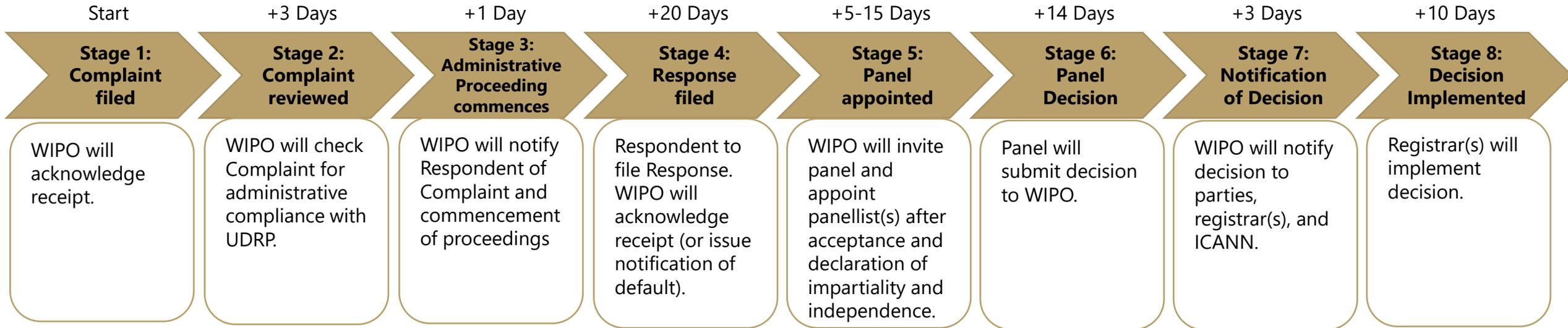
Service Provider: MFSD srl

€ 550 per n° 1 Complaint for n° 1 Domain Disputed

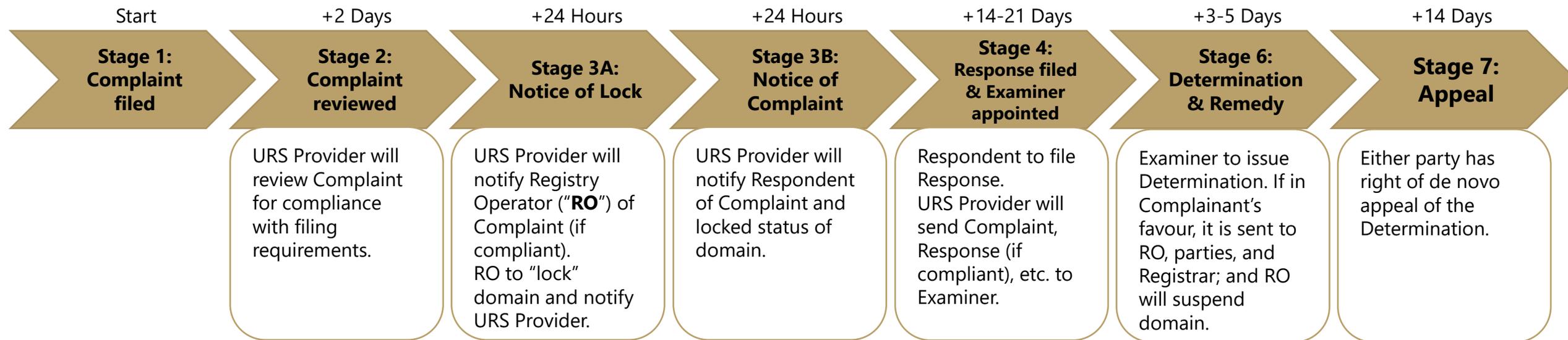
€ 100 per each additional Domain Disputed in the same Complaint

ADJUDICATION PROCESS

UDRP



URS



POST-DECISION SCENARIOS

UDRP

URS

Complaint Succeeds	<ul style="list-style-type: none"> • Transfer of disputed domain name registration to Complainant • Cancellation of domain name registration 	<ul style="list-style-type: none"> • Domain name suspended for the balance of the registration period.
Complaint Denied	<ul style="list-style-type: none"> • Domain name unlocked for the benefit of Respondent. 	
Other Possible Outcomes	<ul style="list-style-type: none"> • Termination of proceedings (e.g., transfers agreed between parties, non-compliance with administrative requirements) 	
Other Recourse	<ul style="list-style-type: none"> • Commence Court Proceedings 	<ul style="list-style-type: none"> • Appeal Determination • Consider UDRP • Commence Court Proceedings

CASE STUDY – <CERES-POWER.COM>

Complainant

- Ceres Intellectual Property Company Ltd
- Complainant administers the IP portfolio of Ceres Power Holdings Plc (“CPH”), a clean energy technology provider
- CPH was traded under “CERES POWER” before changing to “CERES” since 2019
- Held registered rights in the trademark “CERES POWER” and the CERES POWER logo



Respondent

- 卫平 (Philip Le), 乐卫平 (yueweiping)
- The email address of the Respondent was associated with a Chinese company called Shenzhen Hengyunchang Vacuum Technology Co., Ltd
- The website of this company identified itself as an agent for several brands, including the Complainant
- The “About Us” page on the website also referred to “Ceres Renewable Energy Technology Inc” - a company that did not exist.

CASE STUDY – <CERES-POWER.COM>

- ✓ **Identical or confusingly similar**
 - The disputed domain name has wholly incorporated the CERES POWER trademark
 - The addition of gTLD “.com” does not prevent a finding of confusing similarity

- ✓ **No legitimate use**
 - The disputed domain name was virtually identical to the Complainant’s CERES POWER trademark – high risk of false affiliation
 - The website presented a non-existent company and a photograph of the Complainant's group – false impression of affiliation
 - Weak evidence submitted by the Respondent to establish legitimate use

- ✓ **Registered and used in bad faith**
 - Trademarks containing “Ceres” have been used in different jurisdictions, however, the Respondent combined “ceres” and “power”, as does the Complainant’s mark – did not seem to be a pure coincidence
 - The disputed domain name contained a copy of a photograph from the Complainant’s group business in China

✓ **Transfer ordered**

CASE STUDY – <RAHMATHPUBLICATIONS.COM>

Complainant

- Rahmath Pathipagam (Chennai) Private Limited
- A business of publishing and translating books under its figurative mark RAHMATH PATHIPAGAM
- Registered owner of <rahmath.net>

Respondent

- Rahmath Publications Private Limited
- A family member and the uncle of the director of the Complainant
- A book publisher and operates its website on the disputed domain name
- Did not reply to Complainant's contentions under this Complaint

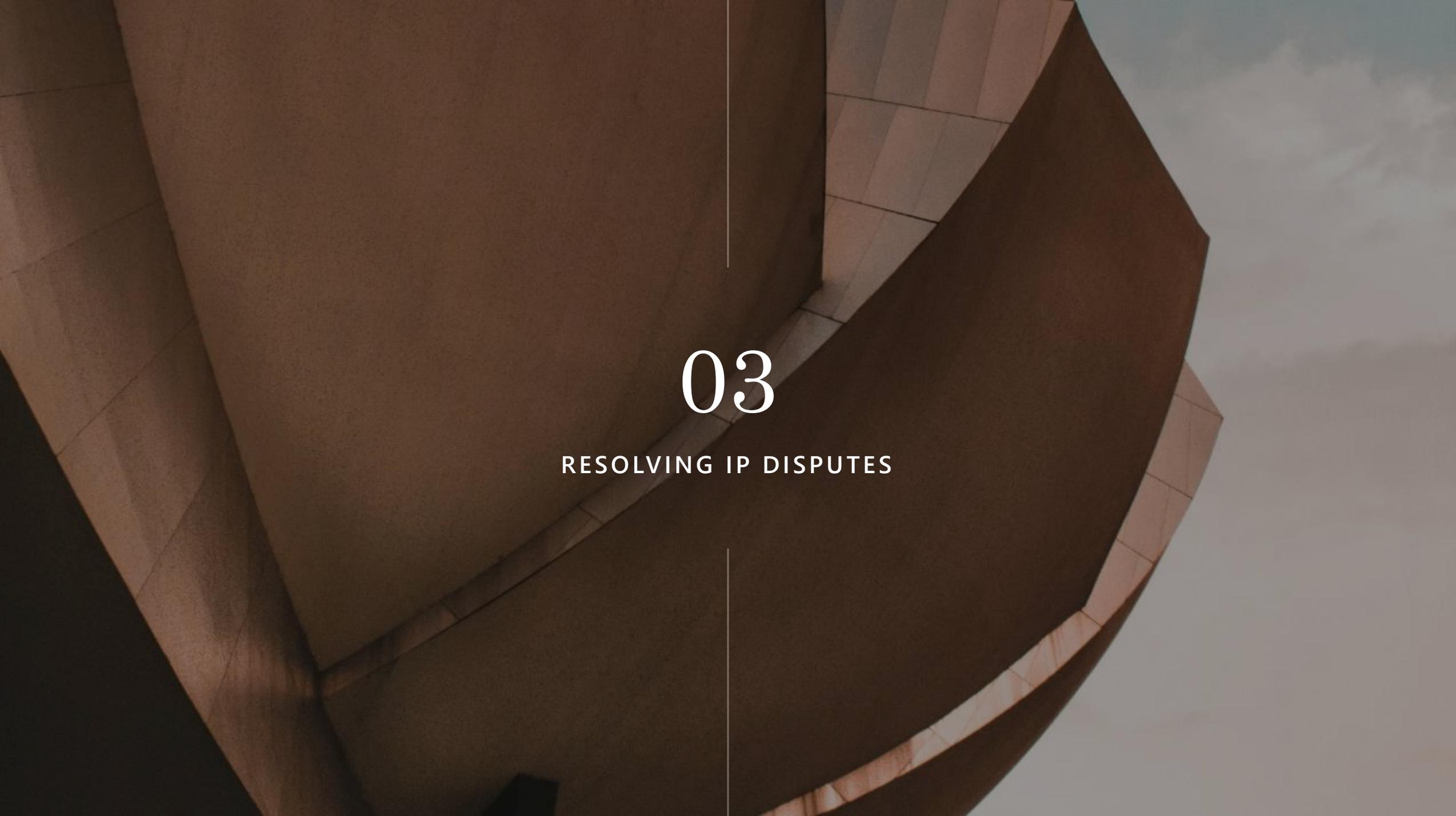
CASE STUDY – <RAHMATHPUBLICATIONS.COM>

- X **Registered and used in bad faith**
 - The Respondent was the registered proprietor of the figurative mark RAHMATH RP before the Respondent's RAHMATH mark
 - *"Not a garden-variety cybersquatting case [...] There are far wider issues which have been placed before the Panel [...] whether characterized as being of a commercial nature or involving elements of family law, are not suitable for resolution under the Policy, which is designed to address clear cases of abusive cybersquatting"*
 - The Panel defers to a court of competent jurisdiction

- ? **Identical or confusingly similar**
 - The three requirements to establish a Complainant are **conjunctive**
 - Complainant has **failed to show registration in bad faith**; therefore, no need to consider the first element of confusing similarity

- ? **No legitimate use**
 - Likewise, no need to consider this element

X Complaint denied



03

RESOLVING IP DISPUTES

RESOLVING IP DISPUTES

- Traditionally, the exclusive jurisdiction of national courts
- Linked to public policy



- Now, international arbitration increasingly popular
- Increasing importance of IP to international trade, commercial profits, and more in a globalized world
- *Inter partes vs erga omnes* effect of decisions
- Unified Patent Court (EU)



ARBITRABILITY: COMMON LAW JURISDICTIONS

Canada

- **Patents:** Canadian Patent Act provides that the Federal Court has exclusive jurisdiction to make rulings that affect patent registration and affect third parties, but arbitral award may still have *inter partes* effect.
- **Copyright:** Arbitrable (default mechanism under the Quebec Act respecting the professional status of artists in the visual arts, arts and crafts and literature, and their contracts with promoters).



Hong Kong

- 2017 Amendment to Arbitration Ordinance provides that all disputes over IP rights are arbitrable, save that arbitral awards concerning IP rights only have effect *inter partes*.

Singapore

- 2019 Amendment to International Arbitration Act provides for arbitration of all IP disputes including patent invalidity, save that arbitral awards concerning IP rights only have effect *inter partes*.

Australia

- IP disputes are arbitrable, but arbitral awards only have *inter partes* effect and cannot bind third parties or the public at large (*Larkden Pty Limited v. Lloyd Energy Systems Pty Limited*).

United States

- **Patents:** Federal statute (35 U.S.C.) provides that patent disputes are arbitrable, but arbitral award will only have *inter partes* effect.
- **Copyright & Trademark:** Fully arbitrable.

United Kingdom

- **Patents:** Arbitrable but the arbitral award on patent validity will only have *inter partes* effect.
- **Copyright & Trademark:** Fully arbitrable.

ARBITRABILITY: CIVIL LAW JURISDICTIONS

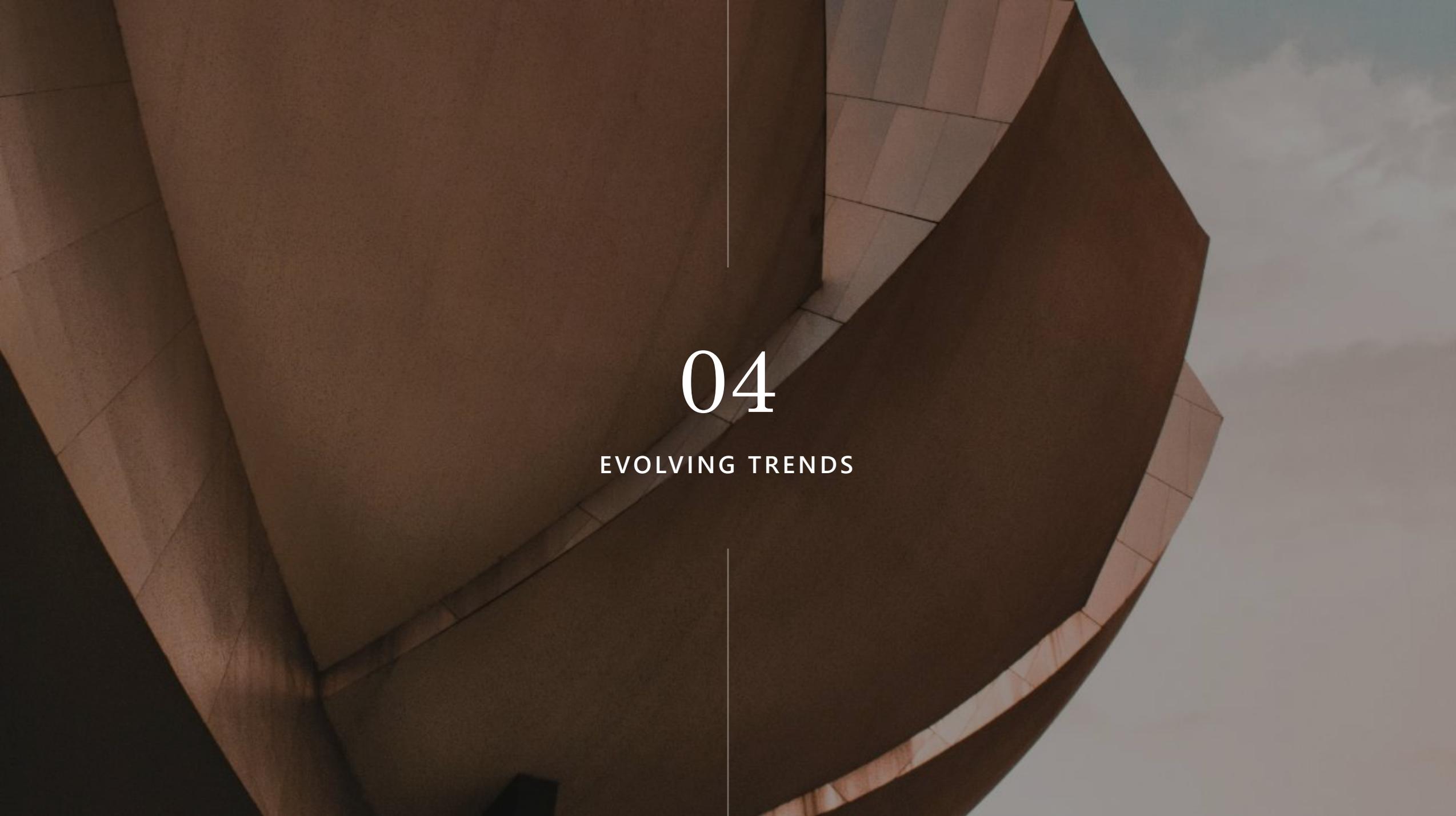


Switzerland, Belgium	France, Italy	Germany, Japan	China, South Korea
Express recognition of full arbitrability, including patent invalidity declarations by arbitral tribunals.	Acceptance of <i>inter partes</i> decisions on patent validity, no <i>res judicata</i> effect	Reluctance due to bifurcated patent litigation system (where revocation are subject to exclusive jurisdiction of specialised Courts)	Arbitrability of IP disputes not expressly recognised, up for debate

SOME LIMITATIONS

- In numerous jurisdictions, arbitral awards only have *inter partes* effect and are not binding on the courts or the national IP registries
- Other grounds may render a dispute non-arbitrable
 - E.g. dispute also concerns another subject matter which is considered non-arbitrable (such as criminal offences)
- Arbitral award might be contrary to public policy
 - E.g. the award was obtained by fraud
 - E.g. the award seeks to give effect to an anti-competitive agreement

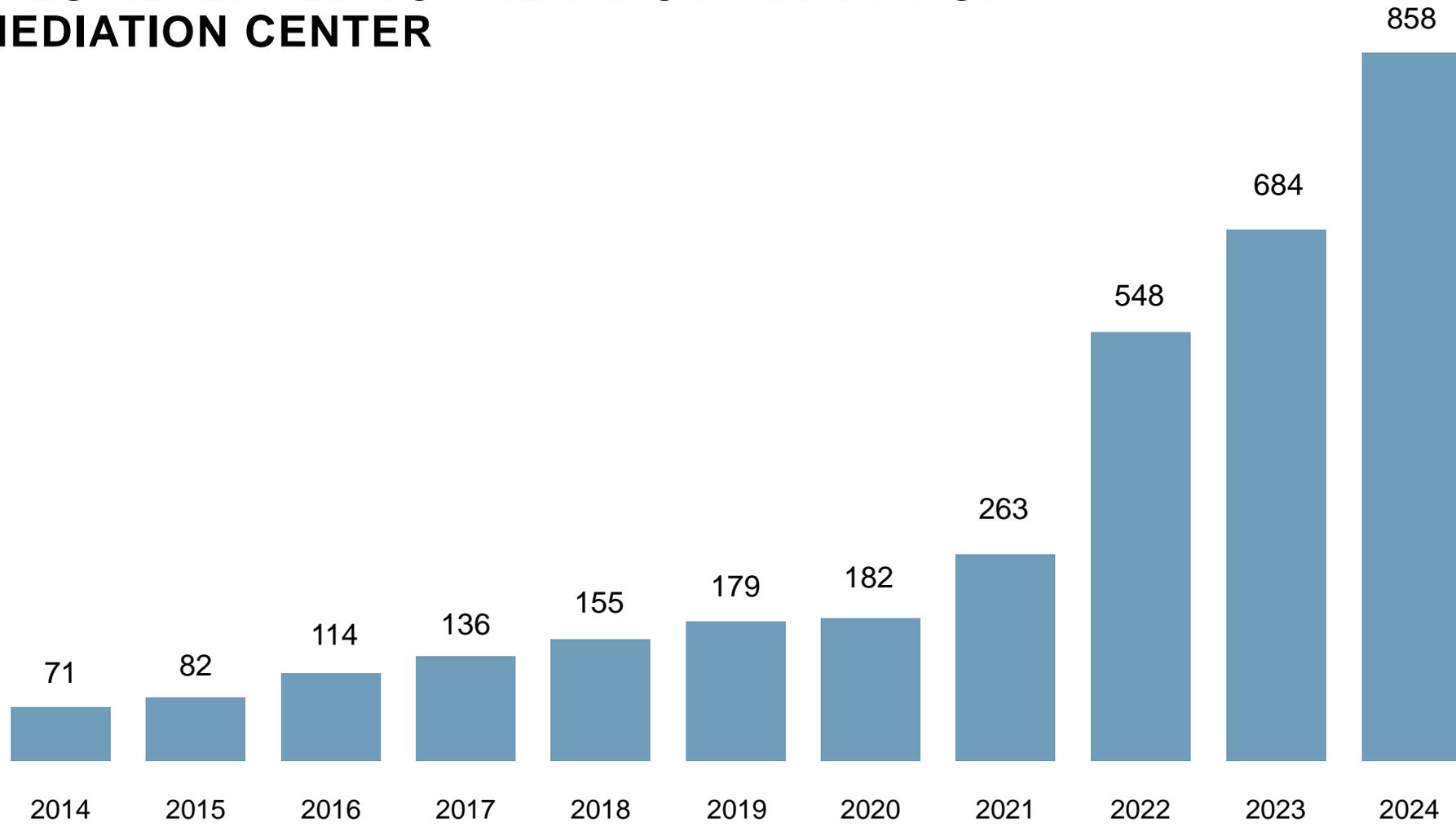




04

EVOLVING TRENDS

DISPUTES REFERRED TO THE WIPO ARBITRATION AND MEDIATION CENTER

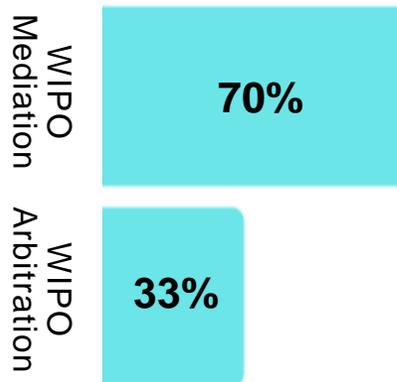


DISPUTES REFERRED TO THE WIPO CENTER

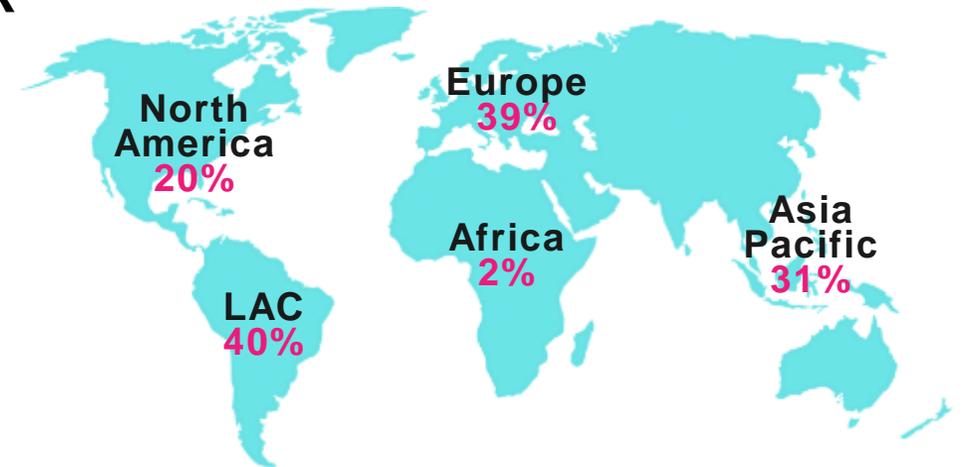
Legal Areas



Settlement rate



Party Location



Type of Parties



STANDARD ESSENTIAL PATENTS (SEPS) FAIR, REASONABLE, AND NON- DISCRIMINATORY TERMS (FRAND)

- FRAND disputes litigated in state courts have resulted in differing FRAND determinations under differing applicable laws
- Trend toward arbitrating FRAND disputes to avoid challenges of multijurisdictional litigation



INVESTOR-STATE ARBITRATION

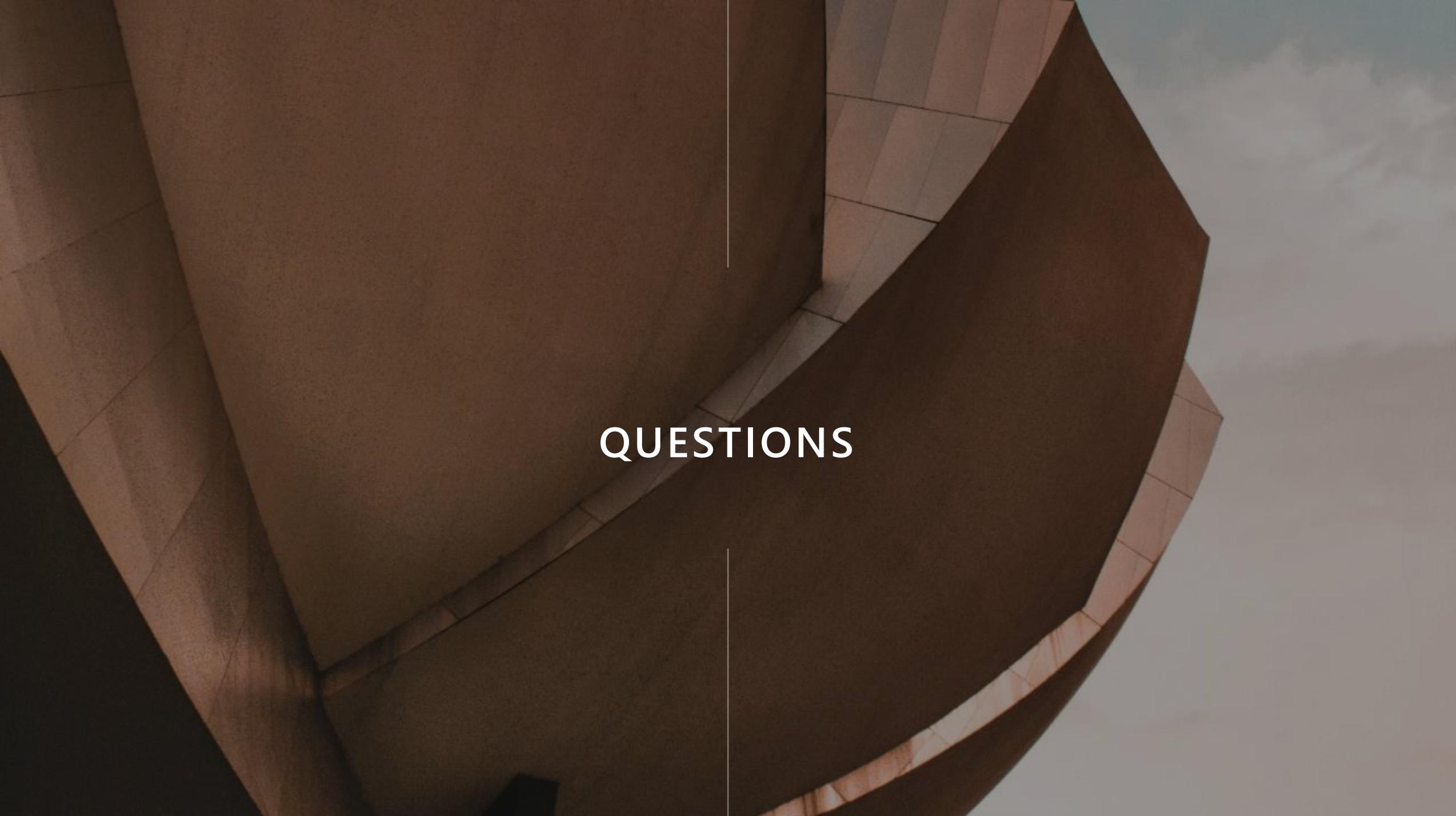
- IP rights are protected investments under investment treaties
- Is data itself a protected investment?
- Possibility of investors in the EU challenging new digital regulations (Data Governance Act, AI Act, Digital Services Act, Digital Markets Act)



ARBITRATION AND AI

- Shenzhen Court of International Arbitration (“SCIA”)
- Silicon Valley Arbitration & Mediation Center (“SVAMC”)
- Judicial Arbitration and Mediation Services (“JAMS”)





QUESTIONS

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