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## The Resolution of Intellectual Property Disputes (ed. Jacques de Werra) - Book Review by V.S. Vadi

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Book Review- Jacques de Werra (ed.) *La résolution des litiges de propriété intellectuelle- The Resolution of Intellectual Property Disputes* (Schulthess Médias Juridiques SA, Genève, Zurich, Bâle 2010), ISBN 978-3-7255-6154-4, 193 pp., CHF 75.00 / EUR 54.00.

Since intellectual property (hereinafter IP) constitutes the economic pillar of the post-industrial society, it is governed by a regime complex at the international, regional and national levels. This multilayered regulation offers a complex maze of overlapping paradigms and dispute settlement mechanisms. *The Resolution of Intellectual Property Disputes*, edited by Jacques de Werra, Professor of intellectual property law at the Faculty of Law at the University of Geneva, provides a fresh outlook on both the adjudication and the alternative dispute resolution mechanisms of such disputes at the international, regional and national levels. This focus is particularly appropriate because without effective dispute settlement mechanisms, the substantive IP protection rules would be ineffective.<sup>1</sup>

The volume stands out for providing cutting edge research and multilayered approaches to the resolution of IP disputes. The book gathers together a collection of essays which examine the paths which have been followed by a number of dispute settlement mechanisms. There are seven contributions in total, written by distinguished scholars in the fields of: international public law (Professor Joost Pauwelyn of the Graduate Institute of International and Development Studies), intellectual property and international private law (Professor Edouard Treppoz of the University Jean-Moulin Lyon 3) international arbitration (Professor Bernard Hanotiau of the University of Leuven); as well as contributions by practitioners such as Pierre Véron, lawyer at the Paris Court; Julie Bertholet, trainee and PhD candidate at the University of Lausanne; Dr. Pierre-Alain Killias, lawyer in Lausanne; and Torsten Bettinger, lawyer in Munich, and a member of the legal staff of the World Intellectual Property Organization (Sarah Theurich).

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<sup>1</sup> J. De Werra, 'Avant-propos', in *The Resolution of Intellectual Property Disputes*, p. v.

For reasons of space, it is not possible in this short review to give full attention and do justice to all the stimulating contributions which make up this volume. It suffices to say that the goal of the editor to provide a ‘decompartmentalised vision’ (‘vision décloisonnée’) of the mechanisms for settling IP disputes is fully achieved by the succeeding chapters.<sup>2</sup> The first three contributions focus on the international and regional dimensions of IP disputes; the fourth deals with the creation of a specialized tribunal at the national level, while the final three papers bring ADR mechanisms to the fore.

Pauwelyn’s chapter, entitled ‘The Dog that Barked but did not Bite: 15 Years of Intellectual Property Disputes at the WTO’ provides a ‘reality check’<sup>3</sup> on how the WTO performed in terms of settling IP disputes. Contrary to the conventional expectation that the WTO dispute settlement mechanism would be flooded with IP disputes brought by industrialized countries against developing countries, the author shows that TRIPS complaints amount to only 3 per cent of all claims under WTO agreements,<sup>4</sup> and that the main targets of IP litigation have been industrialized countries.<sup>5</sup> In addition, it was developing countries that cross-retaliated in TRIP to enforce other WTO rulings against industrialized countries.<sup>6</sup> According to Pauwelyn, both the low number and the systemic type of IP disputes are explained by the limited prospective remedies that the WTO offers to the winning complainants.<sup>7</sup> IP holders do not obtain reparation for past or present harm due to a WTO violation. Through accurate statistical analysis, Pauwelyn shows that TRIPS disputes have a higher settlement rate and lower appeal rate than average WTO disputes.<sup>8</sup> The high settlement rate is explained in terms of clarity of

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<sup>2</sup> J. De Werra, ‘Avant-propos’, in *The Resolution of Intellectual Property Disputes*, p. vii.

<sup>3</sup> J. Pauwelyn, ‘The Dog that Barked but did not Bite: 15 Years of Intellectual Property Disputes at the WTO’ in *The Resolution of Intellectual Property Disputes*, pp. 1-52 at 1.

<sup>4</sup> *Ibidem*, p. 41.

<sup>5</sup> *Ibidem*, p. 7.

<sup>6</sup> *Ibidem*, p. 51.

<sup>7</sup> *Ibidem*, p. 41.

<sup>8</sup> *Ibidem*, p. 9.

the relevant provisions<sup>9</sup> and the facilitative role played by the TRIPS Council.<sup>10</sup>

At a more substantive level, Pauwelyn contends that, with regard to the interpretation of the limited exceptions provisions concerning copyright, trademark and patent protection, ‘both in outcome and analysis WTO panels to date have not followed a hard-line, uniformly pro-IP direction, but an overall rather nuanced and carefully balanced approach’.<sup>11</sup> Finally, Pauwelyn highlights that paradoxically since its inception, the TRIPS Agreement has ‘turned out to be the beginning of a global wave of IP skepticism’.<sup>12</sup> Pauwelyn contends that ‘Big pharma and the essential medicines debate [wa]s, in sum, a story of barking dogs waking [...] the giant of public opinion and broader IP skepticism’.<sup>13</sup>

Véron’s contribution focuses on IP disputes in Europe and critically assesses the state of the art, offering strategies and perspectives and focusing on forum shopping and risk of contradictory decisions.<sup>14</sup> The chapter is also complemented by a very useful graphic reproduction of slides, which clarify the complex institutional dynamics of IP litigation at the EU level. Treppoz’s contribution explores the IP disputes and international private law; the determination of the relevant judge and the determination of the applicable law.<sup>15</sup> Julie Bertholet and Pierre-Alain Killias describe and critically assess the creation of a specialized institution at the national level, focusing on the example of the Swiss *Tribunal Fédéral des brevets*.<sup>16</sup>

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<sup>9</sup> ‘[...] both parties [to the dispute] often realize that the defending country is in violation and needs to pass a particular amendment.’ Ibidem, p. 44.

<sup>10</sup> ‘TRIPS Council Meetings are used also to diffuse and settle IP disputes.’ Ibidem, p. 44.

<sup>11</sup> Ibidem, p. 27.

<sup>12</sup> Ibidem, p. 51.

<sup>13</sup> Ibidem, p. 48.

<sup>14</sup> Pierre Véron, ‘Le contentieux de la propriété industrielle en Europe: état des lieux, stratégies et perspectives’ in *The Resolution of Intellectual Property Disputes* pp. 53-73.

<sup>15</sup> Edouard Treppoz, ‘Les litiges internationaux de propriété intellectuelle et le droit international privé’ in *The Resolution of Intellectual Property Disputes* pp. 75-100.

<sup>16</sup> Julie Bertholet & Pierre-Alain Killias, ‘La création de juridictions spécialisées: l’exemple du Tribunal fédéral des brevets’ in *The Resolution of Intellectual Property Disputes* pp. 101-127.

Torsten Bettinger explores the dispute settlement mechanisms concerning new generic Top-Level Domains (new gTLDs), a program recently adopted by the Internet Corporation for Assigned Names and Numbers (ICANN).<sup>17</sup> A gTLD is an Internet extension such as .COM, .ORG, or .INFO and is part of the structure of the Internet's domain name system (DNS). While there are roughly two dozen gTLDs now, soon there will be an expansion with 'far-reaching consequences for the Internet and brand name industries.'<sup>18</sup> Given that gTLDs are assigned according to the principle of 'first come, first served'<sup>19</sup> and trademark owners fear a 'digital Klondike gold rush',<sup>20</sup> Bettinger analyzes the mechanisms that may protect trademark owners' legal rights against abuse in registration.

Bernard Hanotiau investigates the arbitrability of IP disputes,<sup>21</sup> questioning whether IP disputes are barred from arbitration because of national legislation. Are IP disputes arbitrable? If so, what are the limits of such arbitrability?<sup>22</sup> As Hanotiau points out, some States adopt a restrictive approach to the arbitrability of IP disputes on public policy grounds: on the one hand, trademarks and patents are granted by a public authority and the arbitrator would not have the power to declare void an act of public authority.<sup>23</sup> On the other, IP rights grant their holder a monopoly which restricts free trade.<sup>24</sup> Hanotiau exhaustively refers to the best doctrine on this matter, and explores the relevant national legislation and case law. His excellent analysis concludes that IP disputes are arbitrable to a large extent, as the IP holders can dispose of these rights; and arbitrators can determine whether there was a violation of an IP.<sup>25</sup> As Hanotiau points out, the *domaine*

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<sup>17</sup> Torsten Bettinger, 'ICANN's New gTLD Program: Applicant Guidebook and Dispute Resolution' in *The Resolution of Intellectual Property Disputes*, pp. 129-153.

<sup>18</sup> *Ibidem*, p. 129.

<sup>19</sup> *Ibidem*, p. 131.

<sup>20</sup> *Ibidem*, p. 131.

<sup>21</sup> Bernard Hanotiau, 'L'arbitrabilité des litiges de propriété intellectuelle' in *The Resolution of Intellectual Property Disputes* pp. 155-174.

<sup>22</sup> *Ibidem*, p. 159.

<sup>23</sup> *Ibidem*.

<sup>24</sup> *Ibidem*.

<sup>25</sup> *Ibidem*, p. 173-174.

*réserve* of non-arbitrability has been reduced to such an extent that only the validity of the title remains non arbitrable.<sup>26</sup> The book concludes with Sarah Theurich's contribution on the WIPO experience in designing tailored alternative dispute resolution mechanisms.<sup>27</sup>

As the book is the second volume of a series 'intellectual property' edited by professor Jacques de Werra at the Faculty of Law of the University of Geneva, it will be interesting to see whether future volumes will address other emerging lines of research such as the contribution of other regional (even human rights) courts to current dilemmas on IP<sup>28</sup> and the increase of IP disputes in investor-state arbitration. The fact that the volume draws on the perspectives of both academics and practitioners alike makes it particularly valuable, providing both theoretical and practical analyses and approaches. The papers are well written and clear, and the book promises to be of utmost relevance to current studies on intellectual property, constituting an important contribution to the current puzzle posed by the multilayered regulation of IP. The volume will be of interest not only to scholars and students but also to practitioners.

VALENTINA VADI<sup>29</sup>

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<sup>26</sup> Ibidem, p.174.

<sup>27</sup> Sarah Theurich, 'Designing Tailored Alternative Dispute Resolution in Intellectual Property: The Experience of WIPO' in *The Resolution of Intellectual Property Disputes* pp. 175-193.

<sup>28</sup> See, for instance, Laurence Helfer, Karen Alter & Florencia Guerzovich, 'Islands of Effective International Adjudication: Constructing an Intellectual Property Rule of Law in the Andean Community', 103 *American Journal of International Law* 1-46 (2009) and Laurence Helfer, 'The New Innovation Frontier? Intellectual Property and the European Court of Human Rights', 49 *Harvard International Law Journal* 1-52 (2008).

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