Preface

This book is intended to serve as a practical guide for attorneys (in-house or outside counsel) and business executives whose work requires them to have knowledge and skills in using alternatives to litigation (alternative dispute resolution or ADR) for resolving intellectual property and technology disputes. It discusses strategies, skills, and practices that may be new, improving, or reaffirming. Overall, however, the aim is for counsel (who represent clients in ADR processes), participants (legal/business) in ADR processes, and transactional attorneys (who draft and negotiate pre-dispute resolution clauses), to be more effective at what they do.

The concept for this book came from the simple reality that attorneys (as well as business executives) representing clients in IP/technology disputes must embrace the use of ADR as one of their core

1. The term “technology,” as used throughout this book, encompasses the entire range of cases where science and/or engineering issues are involved. Such cases involve scientific principals and/or engineering applications (e.g., compliance with technical specifications, failure of complex mechanical or electrical equipment, software development and performance, chemistry, development of biomedical devices and pharmaceutical products, clinical trials). They routinely require an analysis of the scientific and engineering principles implicated to fully understand the issues and determine the ultimate rights and responsibilities of the parties.

2. The term “IP/technology disputes,” as used throughout this book, may concern disputes about: the existence (e.g., creation, duration) of certain intellectual property and/or technology; who created it (e.g., inventorship, derivation, authorship); who owns it; the validity and enforceability of the rights; the scope of the rights (e.g., common law, statutory, treaty/convention); whether rights have been infringed or misappropriated; whether unfair competition has occurred; whether a third party has rights in, under, or to the IP/technology (e.g., by license); encumbrances or limitations on the rights or on the holders of those rights; and transactions involving IP/technology (e.g., sale, grant of security interest, license, joint development, consulting, settlement agreements, coexistence) and issues related to such agreements (e.g., breach of warranty, failure to timely conduct R&D, failure to commercialize, failure to halt third-party infringement; failure to indemnify).
competencies. That is, they should have a working knowledge of ADR processes, and the requisite skills for using them to resolve disputes. These skills are best learned early in one's career and refined throughout it. Early in one's legal (or even business) career, litigation is typically the first, and sometimes the only, dispute resolution process taught. For example, in their first year of law school, students take a course in federal civil procedure that teaches them the rules and procedures by which civil litigation is conducted in United States federal courts. The focus on litigation is thereafter reinforced in various ways including testing those rules and procedures on state bar exams. Courses teaching ADR are typically offered after the first year of law school—if offered at all—as electives, and the topic is not tested on bar exams. As such, ADR courses often compete with other electives that may seem more pertinent to students for their future practices. So, as a practical matter, future lawyers often leave law school having no formal introduction to, or education in, ADR.

The importance of ADR became apparent to me only after working as in-house counsel. As someone who was responsible for a company’s IP litigation worldwide, a day in my life often felt like being on the receiving end of a tennis ball machine. Litigation plainly was not the best dispute resolution mechanism to return service on all, or even the majority, of the disputes that materialized. No matter how large the company, there were limits to how much money, personnel, and time could be diverted from the business to deal with disputes. Furthermore, avoiding unnecessary risks required that disputes be resolved expeditiously and sometimes confidentially to avoid the escalation of a manageable dispute into a costly and uncertain situation. Thus, circumstances demanded that I not only acquire knowledge of litigation alternatives, but also firsthand experience employing them, so that I could advise my corporate clients regarding which processes to use and then competently represent them in those processes.

At the time I discovered the need to develop core competencies in ADR for myself, I began looking similarly at such competencies in outside counsel. What I found generally was that their litigation, licensing, and prosecution practices often defined their core competencies. Proficiency with ADR processes did not exist or was treated as not requiring any special education or training. That is more a statement of the past rather than the present, and hopefully not the future.
Over the years, courses in ADR have become more of a mainstay in law school curricula and they are popular with students. It seems that business students are at least exposed to negotiation skills and strategies that are useful particularly for mediating disputes. Law firms are not only identifying ADR (most notably arbitration) as a practice area or sub-area, they are recruiting attorneys who have ADR expertise, and attorneys are including ADR credentials, experience and accomplishments on their law firm resumes. Likewise, bar associations and professional organizations are more routinely offering courses and programs in ADR practice as continuing legal education. This evolution, together with the various pressures from clients and the courts to consider alternatives to litigation, means that ADR practice skills are as important as ever to have and maintain.

To be clear, litigation continues to be an essential dispute resolution process. But what my in-house experience taught me was that alternatives to litigation are equally essential to a business, particularly when strategically used. And, like a musician playing an instrument, to get the most out of an ADR process one must have respect for the process, understand how it works, learn to use it effectively, and practice, practice, practice.

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