Introduction

Alternative dispute resolution (ADR) has moved from a side course to the main course as a means for resolving many intellectual property disputes. There may have been a time when it was sufficient to rely on general legal skills and knowledge about ADR to represent clients in ADR processes. That time has passed. Considering the large number of intellectual property cases that settle year after year and the financial and business risks thereby avoided, specialized knowledge and experience in the practice of ADR is a must. Even the most experienced attorneys need to possess relevant core competencies for representing clients in ADR processes, negotiating agreements with pre–dispute resolution clauses, and counseling clients about ADR. There is no one source of education or training to accomplish this. And education and training is no substitute for experience. This book combines some of each.

The contributing authors have packaged their education, training, and experience in these chapters for you to assimilate into your own practices. They are current or former jurists, neutrals, clients, professors, trial and transactional attorneys, and in–house counsel. They have worn many hats and seen litigation, ADR processes, pre–dispute clauses, and settlement negotiations play out from various perspectives. Their approach focuses on how you can best apply ADR in the simplest to the most complex intellectual property (IP) cases you and your clients routinely encounter.

This book is for experienced practitioners whose legal practice is based anywhere: law firms, corporations, government, or universities. It is equally meant to provide instruction for business executives who are frequently required to be involved in ADR processes, often as decision makers and strategists. And we hope it will be illuminating for neutrals, regardless of whether their practice is full–time in the intellectual property arena. Each chapter opens another door on the various views that you have encountered already or may encounter in using ADR in IP disputes.

Chapter 1 is authored by James F. Davis, who combines his judicial, trial and ADR experience to discuss how success in using ADR in IP
disputes depends on the willingness of, and careful planning and execution by, experienced ADR counsel and their clients. In his chapter—Putting ADR to Work in IP Disputes: When and How to Do It—Mr. Davis illustrates the practical uses of ADR in IP disputes and discusses important skills attorneys should develop and hone to be effective advocates representing clients in ADR processes.

Chapter 2 is co-authored by David W. Hill and Ronald A. Bleeker, who combine their litigation, transactional, and ADR experience to demonstrate how all of these practice areas coalesce when drafting clear and effective pre-dispute ADR clauses. In their chapter, The Multi-Faceted ADR Clause—Why It Deserves More Attention than It Gets, Messrs. Hill and Bleeker address practical considerations for drafting pre-dispute ADR provisions in agreements relating to intellectual property.

Chapter 3 is co-authored by Cynthia Raposo and Harrie Samaras, who combine their litigation, risk management, and ADR experience to teach how early case assessment can be used in intellectual property cases. In their chapter, Early Case Assessment—A Strategic Tool for the Early Resolution and Management of Intellectual Property Cases, Mses. Raposo and Samaras examine the various facets of an early case assessment analysis for early or later settlement of IP disputes and for better managing IP litigation.

Chapter 4 is authored by Magistrate Judge Mary Pat Thynge, who combines her experience from serving as a trial judge and as a mediator in hundreds of intellectual property cases filed in the U.S. District Court for the District of Delaware to discuss the importance of preparation by clients and counsel before mediating IP cases to produce the most positive outcome. In her chapter—Mediation: One Judge’s Perspective (Or Infusing Sanity into Intellectual Property Litigation)—Magistrate Judge Thynge provides her perspective and guidance on how counsel can be better advocates in mediating intellectual property cases.

Chapter 5 is authored by Hildy Bowbeer, who combines her experience as a commercial litigator and as an advocate mediating IP cases in-house to discuss her perspective and provide guidance on effective advocacy and strategy in mediation. In her chapter, Preparing to Successfully Mediate an Intellectual Property Dispute: A Guide for Counsel and Clients, Ms. Bowbeer sets forth the essential elements that business clients and outside and in-house counsel need to know about preparing themselves and their clients for mediation, including how to advocate effectively in mediation.
Chapter 6 is authored by Don Martens, who combines his over 40 years of experience litigating IP cases and serving as a neutral, including as a special master, to discuss using special masters in IP cases. In his chapter—Mastering the Use of a Special Master in Intellectual Property Litigation—Mr. Martens describes the nuts and bolts of what practitioners need to know about effectively using special masters in IP cases.

Chapter 7 is authored by Kevin Casey, who combines his experience in litigation and as a neutral with his expertise in using various tools that aid client decision making to discuss strategic and novel uses of such tools in resolving IP disputes. In his chapter, Tools Useful to Persuade, Evaluate, and Communicate in ADR Proceedings, Mr. Casey describes tools that attorneys and mediators can use to screen disputes for ADR and select neutrals; evaluate options for resolving disputes; convey information to foster communication and persuade; mathematically determine division of property; and facilitate settlement negotiations.

Chapter 8 is co-authored by Wendy L. Dean, who both administers and mediates cases in the U.S. Court of Appeals for the Federal Circuit’s mediation program. In the chapter The Skillful Appellate Mediation Advocate: What You Need to Know about Mediating Patent Cases at the Federal Circuit, Mses. Dean, Samaras, and Leytes provide background about the Federal Circuit’s mediation program, important reasons to try the program, and insight into the mediation process employed at the Federal Circuit along with helpful approaches to enhance the opportunity for settlement.

Chapter 9 is co-authored by Administrative Law Judge Theodore R. Essex and James R. Holbein, who combine judicial, ADR and administrative perspectives from their positions at the U.S. International Trade Commission (USITC) to discuss the strategic use of the USITC for enforcing and resolving intellectual property disputes. In their chapter—The ITC: An Alternative Approach (Not Just an Alternative Forum) for Resolving IP Disputes—Judge Essex and Mr. Holbein discuss how the Section 337 adjudication process at the USITC is itself an alternative forum or approach for IP disputes in contrast to federal court litigation, and how the Commission’s Mediation Program offers an effective alternative to settle Section 337 cases.

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The authors hope that in reading this book you learn, and challenge yourself to apply, new approaches, strategies, and practices when using alternatives to litigation in resolving intellectual property disputes.