Introduction

Alternative dispute resolution (*ADR*) has moved from a side course to the main course as a means for resolving many intellectual property and technology disputes. In the past, reliance on general legal skills and knowledge about ADR may have been enough to represent clients in ADR processes. That is not the case today. Considering the substantial number of IP/technology disputes that arise regularly, the frequent complexity of those cases, and the benefits of settling (including the financial and business risks thereby avoided), specialized knowledge and experience for both counsel and business managers in ADR is a must. Even the most experienced attorneys need to possess such capabilities 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, with decades of experience, education, and training, infuse each chapter with practical ideas for enhancing the use of ADR in resolving IP/technology disputes. They are current or former jurists, neutrals, clients, professors, consultants, trial and transactional attorneys, and in-house counsel. Having worn many hats they have seen litigation, ADR processes, pre-dispute resolution clauses, and settlement negotiations play out from various perspectives. Their approach focuses on how best to apply ADR processes in the simplest to the most complex IP/technology cases routinely encountered.

This book is for practitioners working in a variety of practice settings, for example, law firms, corporations, government, or universities. Business executives who are frequently requested to be involved in ADR processes, often as decision makers and strategists, will find the book instructive and be better prepared to participate effectively in resolving their companies' disputes. And neutrals will benefit from the experience, perspectives, and practical advice offered even if their practices do not focus solely on intellectual property and technology disputes. Each chapter opens another door on the use of ADR advocacy, strategies, and practices for IP/technology cases.

Chapter 1 is authored by James F. Davis who combines his judicial, litigation, arbitration and mediation experience to discuss how success in using ADR in IP/technology 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 Intellectual Property and Technology Disputes: When and How to Do* It, the author illustrates the practical uses of ADR in IP/technology disputes and discusses important skills attorneys should develop and hone to be effective advocates representing clients in ADR processes.

Chapter 2 is authored by Frank L. Politano who combines his litigation, transactional, corporate, and ADR experience to demonstrate how those practice areas coalesce when drafting clear and effective pre-dispute ADR clauses. In his chapter, *Forward Looking ADR Agreements—An Ounce of Prevention Is Worth Many Pounds of Cure*, the author addresses practical considerations for drafting ADR provisions in agreements (stand-alone or pre-dispute) relating to IP/technology disputes.

Chapter 3 is co-authored by Cynthia Raposo and Harrie Samaras who combine their litigation, corporate, and ADR experience to discuss how early case assessment can be used in IP/technology disputes. In their chapter, *Early Case Assessment—A Strategic Tool for the Early Resolution and Management of Intellectual Property and Technology Cases*, the authors examine the various facets of an early case assessment analysis for early or later settlement of IP/technology disputes and for better managing litigation relating to them.

Chapter 4 is authored by Carol Ludington who combines her forensic accounting, consulting, experting, and arbitration experience to discuss how an initial damages assessment (IDA) can be used in IP/technology disputes. In her chapter, *Initial Damages Assessments: Focusing Early on Things that Count but Cannot Be Counted*, the author examines the use of IDA to gain an early realistic view of damages, including an understanding of the key legal, business and financial issues affecting recovery, for strategic decision-making.

Chapter 5 is authored by Magistrate Judge Mary Pat Thynge who combines her judicial and extensive experience mediating hundreds of intellectual property cases filed in the U.S. District Court for the District of Delaware to discuss the importance of the three Ps—preparation, patience, and persistence (and avoiding pessimism)—for clients and counsel in mediating IP cases. In her chapter, *Mediation: One Judge's Perspective (Or Infusing Sanity into Intellectual Property Litigation)*, the

author provides her perspective and guidance on how counsel can be better advocates in mediating intellectual property cases.

Chapter 6 is authored by Kevin H. Rhodes who combines his corporate, litigation, and ADR experience to provide guidance and an in-house perspective on effective advocacy and strategies in mediating IP/technology disputes. In his chapter, *Preparing to Successfully Mediate Intellectual Property and Technology Disputes: A Guide for Counsel and Clients*, the author sets forth essential considerations for business clients, outside counsel, and in-house counsel in preparing for and advocating in mediations.

Chapter 7 is co-authored by Merriann Panarella and Harrie Samaras who combine their litigation and mediation experience as advocates and mediators to discuss useful mediation advocacy and strategies in IP/technology disputes. In their chapter, *Advocacy in IP/Technology Mediations: Design, Preparation, and Strategy*, the authors synthesize important considerations regarding the successful design of, preparation for, and strategy relating to, the mediation process in IP/technology disputes.

Chapter 8 is co-authored by J. William Frank III and Harrie Samaras who combine their appellate and mediation experience in outlining effective advocacy practices for mediating cases before the U.S. Court of Appeals for the Federal Circuit. In their chapter, *The Skillful Appellate Mediation Advocate: Mediating Intellectual Property Cases at the Federal Circuit*, the authors 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 Lisa R. Barton who combine judicial, ADR and administrative experience and 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,* the authors 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.

Chapter 10 is co-authored by Michael H. Diamant, Stephen P. Gilbert, Laura A. Kaster, and Harrie Samaras who combine their litigation

and arbitration experience to discuss how counsel can effectively use the unique procedures and flexibility allowed by arbitration to provide an efficient and reliable means of adjudicating IP/technology disputes. In their chapter, *Arbitrating Technology Cases: Considerations for Businesspeople and Advocates*, the authors discuss particular aspects of arbitrating IP/technology disputes that can influence the effectiveness of the arbitration process and result in a winning presentation.

Chapter 11 is co-authored by Dina Leytes and Harrie Samaras who combine their experience in trademark law and as panelists for the World Intellectual Property Organization to offer advocates ideas on how best to present their case in a Uniform Domain Name Dispute Resolution Policy proceeding. In their chapter, *UDRP Proceedings—How Advocates Can Put their Best Foot Forward*, the authors discuss how advocates and clients can provide panels with the best and most complete evidence and arguments to address the key issues in UDRP proceedings.

Chapter 12 is co-authored by Don W. Martens and Gale R. ("Pete") Peterson who combine their special master, ADR, and litigation experience in intellectual property cases to discuss using special masters in intellectual property cases. In their chapter *Mastering the Use of a Special Master in Intellectual Property Litigation*, the authors describe the nuts and bolts of what practitioners need to know about effectively using special masters in intellectual property cases.

Chapter 13 is authored by Kevin Casey who combines his litigation and ADR experience to discuss strategic and novel uses of decision-making tools in resolving IP/technology disputes. In his chapter *Tools Useful to Persuade, Evaluate, and Communicate in ADR Proceedings*, the author describes various tools that attorneys, clients, and mediators can use to screen disputes for ADR and select neutrals; obtain objective feedback to sharpen the presentation of evidence and arbitration hearing strategy; convey information to foster communication and persuade; mathematically determine division of property; and facilitate settlement negotiations.

****

The authors hope that in reading this book counsel, business executives and neutrals learn, and challenge themselves to apply, new approaches, strategies, and practices when using alternatives to litigation in resolving intellectual property and technology disputes.