Book Review

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# *ADR Advocacy, Strategies, and Practices for Intellectual Property and Technology Cases* (Second Edition)

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There can be little doubt that there has been an ever increasing trend over the past two decades toward the use of ADR to resolve business disputes, both domestically and cross-border. More and more, faced with the delay, expense, and public relations risks of traditional court litigation, not to mention the unpredictable nature of jury verdicts, clients themselves have demanded that their counsel consider the advantages of ADR. After a somewhat slow start, this has become just as true in disputes involving intellectual property and technology as in other types of commercial matters.

Yet, despite a growing number of ADR specialists, the American bar in general has failed to keep pace with the sophistication and variety of modern ADR. Old attitudes die hard, and unfortunately many practitioners still seem to approach ADR as simply litigation in a conference room rather than a courtroom. Lawyers (and business people for that matter) could greatly benefit from a comprehensive but concise guide to the gamut of ADR choices, the rules that govern their operation, and the strategies and techniques for successfully employing them. Stepping admirably into the breach, the ABA Section of Intellectual Property Law has given us *ADR Advocacy, Strategies, and Practices for Intellectual Property and Technology Cases* (Second Edition), edited by Harrie Samaras. Ms. Samaras, who is not only the work's editor but also a co-author of five of the book's 13 chapters, is impeccably credentialed for the job. She is a full-time neutral focusing on arbitrating and mediating IP and technology cases, a Distinguished Fellow of the College of Commercial Arbitrators and the Chartered Institute of Arbitrators, as well as a Distinguished Fellow of the International Academy of Mediators, and also consults, teaches, and trains in the area of ADR.

*ADR Advocacy* is especially directed to the use of ADR in IP and technology cases, and it splendidly fulfills that objective. Chapter 1 (by James F. Davis) provides an overview of the various ADR tools and their applicability to resolving IP/technology disputes, illustrating his points with numerous helpful "cases in point" drawn from IP and technology matters. Throughout the balance of the book specific issues presented by IP/technology cases are addressed, such as the selection of appropriate mediators and arbitrators, the effective use of experts, the advisability of tutorials, the resolution of FRAND disputes, and the implications of 35 U.S.C. § 294(d) (mandating that any arbitration award in a patent case become part of the public patent prosecution file of the patent at issue). Indeed, entire chapters are devoted to forms of ADR unique to IP matters: the Federal Circuit's appellate mediation program for IP cases (Chapter 8 by J. William Frank and Harrie Samaras), the Section 337 mediation program at the U.S. International Trade Commission (Chapter 9 by Hon. Theodore R. Essex, Lisa R. Barton, and James R. Holbein), UDRP proceedings (Chapter 11 by Dina Leytes and Harrie Samaras), and the use of Special Masters in IP cases under Rule 53 of the Federal Rules of Civil Procedure (Chapter 12 by Don W. Martens and Gale R. ("Pete") Peterson) (although this last is not strictly speaking unique to IP cases, and it might be argued is not a form of ADR at all, as it is a mechanism employed in a federal district court litigation).

But the value of *ADR Advocacy* is hardly limited to IP practitioners. On the contrary, it delivers a wealth of information, insights, strategic advice, and tactical considerations useful to ADR advocates in any sort of business dispute. Before discussing a few examples of these, however, it should be said that, despite its multiplicity of chapter authors, the book definitely conveys the feel of an integrated whole, a tribute to Ms. Samaras's skill as an editor. After Chapter 1 introduces the various forms of ADR, the book proceeds in logical fashion with chapters on negotiating and drafting ADR clauses (Chapter 2 by Frank L. Politano); Early Case Assessment, a systematic approach to collecting and analyzing information about a dispute and its business impact, with a view to enhancing predictability and informed decision-making (Chapter 3 by Cynthia Raposo and Harrie Samaras); initial damage assessments to keep things real and determine whether early resolution is economically advisable (Chapter 4 by Carol Ludington); mediation from several viewpoints (Chapter 5 by Magistrate Judge Mary Pat Thynge, Chapter 6 by Kevin Rhodes, and Chapter 7 by Merriann Panarella and Harrie Samaras); two forms of specialized mediation, namely, appellate mediation at the Federal Circuit (Chapter 8 by J. William Frank and Harrie Samaras) and Section 337 mediation at the ITC (Chapter 9 by Hon. Theodore R. Essex, Lisa R. Barton, and James R. Holbein); arbitration (Chapter 10 by Michael H. Diamant, Stephen P. Gilbert, Laura A. Kaster, and Harrie Samaras); a specialized and expedited form of arbitration for domain name disputes (Chapter 11 by Dina Leytes and Harrie Samaras); the use of Special Masters in litigation (Chapter 12 by Don W. Martens and Gale R. ("Pete") Peterson); and finally a discussion of some tools useful to persuade, evaluate, and communicate in ADR proceedings (Chapter 13 by Kevin R. Casey). There is consistency in format, terminology, and the use of numerous examples and appendices throughout.

One is hesitant to discuss in more detail some chapters in *ADR Advocacy* for fear of slighting the rest. It must be said that they are all of the highest quality, and their authors are uniformly highly qualified and very experienced in IP/technology ADR. Nevertheless, in order to provide a better flavor of the scope and variety of *ADR Advocacy*, this reviewer has chosen to expand upon three of the chapters.

Hon. Mary Pat Thynge's chapter on mediation from an experienced magistrate judge's perspective presents a practical, common-sense, business focused discussion of the mediation process in IP cases and, by extension, business disputes in general. From personal experience, this reviewer knows Judge Thynge to be a thoughtful, patient, and congenial mediator. Her view of what mediation is—or should be—is really quite perceptive:

> Mediation is not compromise—it is negotiation....For counsel and their clients to discern...what their *final* trial presentation will be entails a major investment of time, emotion, resources, and money, with no guaranteed benefit.
>
> Mediation returns to the parties what litigation has taken away—control. It allows the parties to control the decision-making process. Unlike litigation and trial, it requires their direct, intimate involvement and judgment, and thereby provides them the means to tailor a result, whether through a settlement agreement, license, or other business arrangement, which addresses their individual needs. It gives parties resolution opportunities beyond the limited constraints of a particular case, allowing a global, rather than piecemeal, approach to finality, and it maintains privacy within the confines of the law and mandatory reporting obligations. It allows parties to choose the method for resolving prospective disputes and to avoid future litigation. [Pages 177-78.]

Judge Thynge's comments on the *timing* of mediation are also of interest, especially regarding the amount of information parties actually need to effectively engage in mediation: "In considering when to mediate—*the earlier the better*. A matter settles when the parties know enough about a dispute to intelligently agree to resolve it. Such knowledge, however, does not require discovery to the *n*th degree, a claim construction opinion, or a summary judgment decision." [Page 181.] This attitude runs contrary to the instincts of many defense counsel in patent cases, who typically insist that mediation cannot be meaningful until discovery is complete, and perhaps not even until expert reports are filed and a *Markman* ruling is handed down. Note, however, that Judge Thynge does not disagree that sufficient information is necessary for successful mediation, but rather raises the question of what quantum of information constitutes "sufficient" information.

Finally, Judge Thynge's comments on whom to bring—or not bring—to a mediation session are also worth mentioning, although some might not agree with all of those comments. Particularly provocative is her advice to leave the inventor, prosecution counsel, and in-house IP counsel at home, if possible.

Although *ADR Advocacy* devotes only a single chapter (Chapter 10) exclusively to commercial arbitration, chapter authors Michael H. Diamant, Stephen P. Gilbert, Laura Kaster, and Harrie Samaras have delivered a virtual mini-treatise on the subject. While the focus again is on issues of particular concern in technology cases, the chapter provides many insights adaptable to other kinds of business cases. Particularly helpful is the discussion of privacy and confidentiality in arbitration—and the difference between the two—as well as practical suggestions to practitioners on how to maximize confidentiality when that is deemed important. [Pages 367-78.] Also of note is the authors' sage advice regarding the preliminary conference and other pre-hearing matters such as discovery, tutorials, bifurcation, witness disclosures, motions, and pre-hearing briefs. [Pages 382-402.] An appendix provides a convenient and comprehensive checklist of topics to be addressed at the preliminary conference. [Pages 417-419.] The section on the evidentiary hearing itself covers such seemingly mundane, but necessary, tasks as marking and assembling exhibits and using summaries of voluminous exhibits, as well as more substantive issues such as opening and closing statements, the presentation of testimony (both fact and expert), and post-hearing briefs.[Pages 402-13.] In addition, the authors provide an insightful analysis of factors that may prompt a party to request a simple—rather than reasoned—award, namely, collateral estoppel effect of the award, confidentiality, cost, and concern over copycat claims.

Chapter 13 of *ADR Advocacy*, by Kevin R. Casey, is entitled "Tools Useful to Persuade, Evaluate, and Communicate in ADR Proceedings." As the title suggests, the goal of the chapter is to familiarize counsel and neutrals with tools that can be useful to achieve resolution of a dispute. Some of these tools, such as the use of charts, exhibits, and other visual aids to convey information in a more impactful manner, as well as the use of technology such as laptops, spreadsheets, and smartphones to research information, keep track of changing data, facilitate negotiation, and rapidly document a resolution, are well-known (if sometimes overlooked) by practitioners. Others, like the use of screening tools to help determine the appropriate form of ADR or select the right neutral, the use of mock arbitration panels, and Decision Tree Analysis may be less familiar. Mr. Casey does an admirable job of describing each of these tools, their application, and effectiveness. Perhaps most intriguing is his introduction to the possible use of computerized algorithms such as Adjusted Winner and Proportional Allocation in resolving intellectual property cases. [Page 553.] A helpful appendix explains these algorithms in more detail and provides an example of their use. Without pretending to fully understand this algorithmic approach, this reviewer applauds the effort to introduce more scientific rigor into the ADR process.

As hopefully suggested by the foregoing, *ADR Advocacy* is broad in scope, comprehensive in execution, and very practical. It should be on the bookshelf of every IP/technology lawyer and ADR practitioner.

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