

Mediating the IP Case
Part II: Selecting the right mediator

In Part I of this series of articles, we explored the importance of timing the mediation in an intellectual property dispute. Mediating too soon can mean there is too little information to allow an informed settlement decision. Mediating too late can mean unnecessary expense and entrenched positions. We further explored how the nature and stage of the case can help you to make a better timing decision.

Once you have decided to mediate, you will need to agree with your opponents on the mediator. The mediator for your IP case needs to be not only legally and technically skilled, but also skilled in conducting mediations.

One of the roles of the mediator is to help the parties test and explore their stance on the likely outcome of the case and strength of their positions. A mediator with extensive experience in IP issues will be able to understand the issues and help the parties evaluate their positions. In a patent case, for example, a mediator experienced in IP law will be able to understand the differences of opinion regarding likely claim constructions, the role of prior art, technical defenses based on indefiniteness, lack of enablement or written description, and a host of other issues typically arising in a patent case. Similarly, a mediator who has actually tried a trademark case, been involved in Trademark Trial and Appeal Board proceedings or worked through the Abstraction-Filtration-Comparison test in a copyright case is in a far better position to help the parties evaluate the strengths and weaknesses of their positions and arrive at a reasonable and informed settlement. A

mediator who has not had these experiences may have a hard time keeping up with the parties' positions.

But it is also critical that the mediator have significant mediation skills. Mediators are typically required to uncover, understand and weigh parties' motivations, psychology and other human factors that underlie the litigation and settlement process. After all, parties become involved in disputes not to satisfy some abstract legal principle, but because of their interests and their own view of fairness. Being skilled at technical issues, the law and the human component of the dispute is a great deal to ask of one mediator. But ask you must. You best serve your client by identifying and using a mediator who can bring knowledge and experience in all these areas to bear on your case. The more experience and skill he or she has in helping parties and their counsel work through all the issues and dynamics involved, the more likely the mediation will be a success.

Of course, the selection of the mediator is not up to you alone. You will typically need to agree with opposing counsel on a mediator, although in some cases the Court may choose the mediator for you. That becomes more likely if you and your opponents can't agree on the mediator. In deciding who to propose as mediator or evaluating the other side's proposals for mediators, focusing on skill and experience both in the subject matter and in mediation will be critical. Proposing a mediator who has demonstrated those qualities makes it all the more likely the opposing party will agree with your selection.