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Research Cases of the United States Concerning Arbitration of Intellectual Property Disputes

지적재산분쟁의 중재에 대한 미국 케이스에 관한 연구

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〈 목 차 〉

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I. Introduction

Most business corporations are getting better to understand the alternative dispute resolution (ADR) and using it as a matter of their policy when they need to make a contract. In the contract, they put an arbitration clause to bind their agreement even for a licensing agreement. In the United States, they need "[a]greements to arbitrate that fall within the scope and coverage of the Federal Arbitration Act ([FAA]), 9 U. S. C. §1 et seq., must be enforced in state and federal courts."[1] State courts, then, "have a prominent role to play as enforcers of agreements to arbitrate."[2] While arbitration clauses are generally enforceable and routinely enforced, the scope and coverage of the arbitration will be governed by the terms of the contract.[3] The contract is a written agreement. In essence, arbitration is a contractual remedy.[4] The [FAA] has been interpreted to require that if a dispute presents multiple claims, some arbitrable and some not, the former must be sent to arbitration even if this will lead to piecemeal litigation.[5] This shows that "it follows that state and federal courts must examine with care the complaints seeking to invoke their jurisdiction in order to separate arbitrable from nonarbitrable claims."[6] Within the contractual scope, courts generally give the arbitrators fairly wide berth in reaching a decision.[7] A court may not issue a blanket refusal to compel arbitration merely on the grounds that

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1) KPMG LLP v. ROBERT COCCHI ET AL., 565 U. S. ____ (2011) (Per Curiam, No. 10-1521, November 7, 2011).

2) *Id.* (citing Vadenv. Discover Bank, 556 U. S. 49, 59 (2009)).

3) Raymond T. Nimmer and Jeff Dodd, Modern Licensing Law § 2:69 (Westlaw, Database updated October 2012) (citing Promega Corp. v. Life Technologies Corp., 674 F.3d 1352, 102 U.S.P.Q.2d 1207 (Fed. Cir. 2012) (provision for mandatory arbitration in patent license agreement bound assignee of license and covered dispute about royalties and infringement; arbitration provision clearly and unambiguously applied to all disputes arising out of or relating to agreement, limitations on discovery did not warrant departure from mandate of Federal Arbitration Act (FAA) to enforce arbitration provisions.); 1mage Software, Inc. v. Reynolds and Reynolds Co., 459 F.3d 1044, 79 U.S.P.Q.2d 1942 (10th Cir. 2006)).

4) *Id.*

5) *KPMG, supra* note 1 (citing Dean Witter Reynolds Inc. v. Byrd, 470 U. S. 213, 217 (1985)).

6) *Id.*

7) Nimmer and Dodd, *supra*. note 3 (citing Gueyffier v. Ann Summers, Ltd., 43 Cal. 4th 1179, 77 Cal. Rptr. 3d 613, 184 P.3d 739 (2008)(franchise case; arbitrator does not exceed powers when she allows equitable defenses to excuse performance of a contractual provision)).

some of the claims could be resolved by the court without arbitration.[8)]

In that case, the courts have a question whether there is an arbitrability. The question whether parties have submitted a particular dispute to arbitration, that is, the question of arbitrability, is an issue for judicial determination unless the parties clearly and unmistakably provide otherwise.[9)] Generally the question of arbitrability is a judicial question.[10)] In some cases, courts have held that where the rules of the AAA are explicitly incorporated in the agreement, the arbitrator decides arbitrability.[11)] However, in the United States, courts found that some cases have ICC rules to be bound, and others have AAA rules.[12)] In John Wiley & Sons, Inc. v. Livingston,[13)] the Supreme Court "held that the question of

8) *KPMG*, *Supra* note 1.

9) Charles P. Lickson, The Use of Alternative Dispute Resolution in Intellectual Property, Technology-Related or Innovation-Based Disputes, 55 Am. Jur. Trials 483, §4 (Originally published in 1995) (see American Jurisprudence, Trials; Westlaw, Database updated August 2012) (citing In re Reuters America LLC v. For a judgment staying the arbitration commenced by Newspaper Guild of New York, Local 3, 694 F. Supp. 2d 242, 187 L.R.R.M. (BNA) 3591 (S.D. N.Y. 2010)).

10) ALEXSAM, INC. v. INTERACTIVE COMMUNICATIONS INTERNATIONAL, INC. and Interactive Communications Inc., 2010 WL 2602468 at 34 (C.A.Fed.) (Appellate Brief, No. 2010-1267, (June 8, 2010) (This appeal is from the denial of a motion to enforce a settlement agreement filed by Interactive Communications International, Inc. ("InComm"). No. 2:03-CV-337-TJW, 2010 U.S. Dist. LEXIS 22778 (E.D. Tex. Mar. 12, 2010) (A16-24)). The underlying case is a patent infringement action filed by Alexsam Inc. ("Alexsam") against *inter alia*, InComm in the United States District Court for the Eastern District of Texas.); *see* citing Qualcomm, Inc. v. Nokia Corp., 466 F.3d 1366, 1372 (Fed. Cir. 2006) (quoting *AT&T*, 475 U.S. at 649). "Courts should not assume that the parties agreed to arbitrate arbitrability unless there is 'clear and unmistakable evidence' that they did so." First Options of Chicago, 514 U.S. at 944 (quoting AT&T Techs., Inc., 475 U.S. at 649)(internal punctuation omitted). Unless parties clearly and unambiguously decide otherwise, the question of whether the parties agreed to arbitrate is to be decided by the court, not by the arbitrator.

11) *Id.* at 35 (the rules of the AAA: see the arbitration rules of the American Arbitration Association).

12) *See id.* at 35 (referring to: for example, in *Qualcomm*, the parties explicitly agreed that "any dispute, claim or controversy arising out of or relating to this Agreement, or the breach or validity hereof, shall be settled by arbitration in accordance with the arbitration rules of the American Arbitration Association ("the AAA Rules"). *Qualcomm*, 466 F.3d at 1372-73. The AAA rules state that the arbitration tribunal "shall have the power to rule on its own jurisdiction, including any objections with respect to the existence, scope or validity of the arbitration agreement.").

13) Nimmer and Dodd, *supra* note 3 (citing John Wiley & Sons, Inc. v. Livingston, 376 U.S. 543, 84 S. Ct. 909, 11 L. Ed. 2d 898, 55 L.R.R.M. (BNA) 2769, 49 Lab. Cas. (CCH) P 18846 (1964)).

whether a party is bound by an agreement containing an arbitration provision is a 'threshold question' for the court to decide …. Because a party 'cannot be compelled to arbitrate if an arbitration clause does not bind it,' the Court held that there was 'no doubt' that 'a compulsory submission to arbitration cannot precede judicial determination that the … agreement does in fact create such a duty.'"[14] Therefore, those cases indicate us that "the arbitration clause should be very carefully drafted, for it can determine what must be submitted to arbitration, how the arbitration will proceed, and the effect of the arbitration proceeding."[15] In other words, it shows that "we will consider various aspects of recurring issues in the interpretation of arbitration clauses in license agreements."[16] Recently, an intellectual property (IP), or technology based disputes are highlighted because IP is intangible assets. "In commercial cases, especially those with an intellectual property law issue, ADR was virtually unavailable prior to 1982. Patent practitioners, in particular, had few alternatives to court action. In fact, courts had held that private resolutions of patent disputes were contrary to public policy and, therefore, unenforceable. As a rationale, the courts said that patents contained by their very nature 'a public interest,' and due to their complexity they could not be handled by non-judges."[17] However, "[t]he judicial atmosphere became more receptive to ADR after Congress acted in 1982 to make so-called public policy arguments against private resolution less important than the public policy benefits of the Federal Arbitration Act.[18] Public Law No. 97-247 amended the Patent Act to recognize parties' rights to final and private resolution of patent disputes."[19]

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14) *Id.* (citing Microchip Technology Inc. v. U.S. Philips Corp., 367 F.3d 1350, 1357, 70 U.S.P.Q.2d 1847 (Fed. Cir. 2004)).

15) Nimmer and Dodd, *supra* note 3.

16) *Id.*

17) Lickson, *supra* note 9, at § 5; *see* Kevin R. Casey, Alternative Dispute Resolution and Patent Law, 3 Fed Circuit B J 1, 2 (Spring, 1993).

18) *See* Casey, *supra* note 17, at 3.

19) Lickson, *supra* note 9, at § 5; *see* 35 USCA § 294. - Two additional federal statutes are relevant to intellectual property ADR: The Patent Law Amendments Act added sub-section (d) to 35 USCA § 135, regarding arbitration of patent interference actions; and the Semiconductor Chip Act of 1984, 17 USCA §§ 901 et seq., provides for litigation over royalties for innocent infringement under the Act's coverage unless the disputes are resolved by voluntary negotiation, mediation or binding arbitration.

Therefore, "[i]n spite of its relative newness as an option and resistance on the part of some intellectual property practitioners and courts in past years, ADR has proved quite successful in cases involving a variety of intellectual property, technology and related innovation-based issues. Particularly in cases dealing with (a) new technological developments, (b) complex issues of fact where the subject matter is difficult for lay people to understand, and/or (c) where the issues are novel because the dispute arose out of an innovative approach to something heretofore unseen or undealt with by the law, ADR may be the method of choice."[20]

In the United States, "[i]n two related areas of law, the federal courts have traditionally refused to permit arbitration, patent validity,"[21] and antitrust violations.[22] However, under modern law, both of these traditional prohibitions have been considerably relaxed, if not totally removed.[23] Those give us that it is necessary to research IP disputes for arbitration matters. There are unexpected disputes in various intellectual property areas from research and development stage to end products because technology is changing rapidly in current digital era. That is, technology innovation or differentiation frequently makes issues of the disputes in the field of intellectual property. Some unexpected or unforeseen

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20) Lickson, *supra* note 9, at § 5.

21) J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 32:198 (4th ed. 2012) (see 6 McCarthy on Trademarks and Unfair Competition § 32:198) (citing e.g., Foster Wheeler Corp. v. Babcock & Wilcox Co., 440 F. Supp. 897, 195 U.S.P.Q. 649 (S.D.N.Y. 1977).

22) *Id.* (citing see, e.g., Applied Digital Technology, Inc. v. Continental Casualty Co., 576 F.2d 116 (7th Cir. 1978); Cobb v. Lewis, 488 F.2d 41 (5th Cir. 1974)).

23) *Id.* (citing *Patent Law* : Janicke & Borovoy pointed out that the traditional anti-arbitration rule was restricted to a future-disputes arbitrating clause regarding the validity of a patent. All other patent related disputes could be arbitrated. Janicke & Borovoy, "Resolving Patent Disputes by Arbitration: An Alternative to Litigation," 62 J. Pat. Off. Soc'y 337, 357 (1980), but this distinction was made moot by the 1982 amendment adding 35 U.S.C.A. § 294, which specifically permits arbitration of future or existing disputes relating to patent validity or infringement. This statute overturns previous case law prohibitions on patent arbitration. Antitrust Law: In Mitsubishi Motors Corp. v. Soler Chrysler-Plymouth, Inc., 473 U.S. 614, 87 L. Ed. 2d 444, 105 S. Ct. 3346 (1985), the Supreme Court upheld the enforceability of arbitration agreements impacting on antitrust law in international transactions. RICO treble damage claims are also subject to arbitration. Simula, Inc. v. Autoliv, Inc., 175 F.3d 716, 50 U.S.P.Q.2d 1599, 1603 (9th Cir. 1999) ("Both the Supreme Court and this court have held that antitrust claims are arbitratable.")).

technology issues could not be resolved by the law because statutes cannot be enacted timely to cover the innovative technology matters where technology is changing rapidly such as recent era. In this case, arbitration may be one of choices to resolve the issues. Thus, it is necessary to research cases concerning arbitration of intellectual property disputes in a variety of intellectual property whether it is a dispute issue relating to validity, infringement, or arbitrability. As first step research, in this research, several areas of IP such as licensing, patent, and copyright will be studied generally based on cases of the United States, prior to next step research which will be a comparison research regarding cases of Korea and the United States especially for one of IP areas.

Therefore, the purpose of this research is to study and outline the U.S. researches on IP related cases for further researches of arbitration of IP disputes in Korea and comparative studies in the near future. To achieve this purpose, the research scope of this research is limited to the U.S. cases on arbitration of IP related matters. Available articles and cases that have determined by authorities or applicable laws are utilized for effective research and will be quoted.

To study and analyze the research cases of the United States concerning arbitration of intellectual property disputes, this research consists of five chapters. Chapter I, "Introduction," will outline the issues, purpose and scope of this research. Chapter II, "Arbitration of Licensing Disputes" contains a study of licensing agreement in patent that applies to a contract principle. Determination of infringement and validity matters in the arbitration clause is related to contract interpretation. In this case, cases studies are presented because there are issues whether courts or arbitrators decide a license issue. Scope of arbitration in the licensing agreement and the court's determination on issues of arbitrability in arbitration clause will be analyzed when there is no involvement of the substantive matters of patent enforcement. In chapter III, "Arbitration of Patent Disputes" is a case analysis related to an agreement involving patent validity or infringement arising under the agreement that contains an arbitration provision. The analysis will focus on statements of 'arising out of' and/or 'relating to' and whether there is a valid agreement to arbitrate under the contract principle.

Chapter IV, "Arbitration of Copyright Disputes" is a case analysis that a broad arbitration clause in an agreement encompasses copyright claims, and an arbitrator has jurisdiction to decide an award of copyright disputes. The analysis will prove that an arbitrator can handle copyright disputes if there is a valid arbitration clause in an agreement, even though there is an allegation of public policy that does not allow copyright claims to arbitrate. Arbitration will be a choice for the dispute resolution where validity of a copyright becomes an issue in the arbitration clause that applies to a contract principle. Cases of chapter II through chapter IV will be regarding disputes of licensing, patent, and copyright. Thus, the organization of the research will be arranged by the cases in the fields of arbitration and intellectual property. In chapter V, "Conclusion," this research is summarized and concluded for results of this research.

II. Arbitration of licensing disputes

A licensing agreement of technology is one of corporate strategies to avoid disputes of intellectual property matters. Also, when we work for commercial matters, a license is required for legal requirements. In those cases, a question is raised in the field of arbitration. Is it for the court or the arbitrator to decide the consequences of one's failure to obtain a license?[24] When both parties made a settlement agreement through arbitration, "[d]oes the unlicensed status of a party provide a court with sufficient grounds to vacate an arbitrator's award?[25] The courts that have tackled this issue have developed a number of different approaches.[26] The settlement agreement is a promise between both parties even its intellectual property related matter. Therefore, "[i]nterpretation of a settlement agreement is not an issue unique to patent law, even if arising in the context of a patent infringement suit, and thus this Court applies the law of the appropriate

24) Philip L. Bruner and Patrick J. O'Connor, Jr., Bruner and O'Connor on Construction Law §20:81 (2012) (see Chapter 20. Arbitration).

25) *Id.*

26) *Id.* (referring to the different approaches in §20:81. Conditions precedent to arbitration: Matters of procedural arbitrability for arbitrators to decide—Licensing as condition precedent to arbitration).

regional circuit."[27] This Court applies regional circuit law to questions of arbitrability that are not " 'intimately involved in the substance of enforcement of the patent right.'"[28] That is, there is a contract principle. Determining whether noninfringement and invalidity claims fall within the scope of the arbitration clause is a question of contract interpretation.[29] We therefore review the arbitrability of this dispute according to the law of the pertinent regional circuit.[30]

In the case of ALEXSAM, INC. v. INTERACTIVE COMMUNICATIONS INTERNATIONAL, INC. and Interactive Communications Inc. (2010 WL 2602468 (C.A.Fed.), Appellate Brief; No. 2010-1267, June 8, 2010), it stated that "the Settlement Agreement and License Agreement are separate agreements and need not correspond in scope."[31] There, it showed that "[t]he fact that the License Agreement provides for royalty payments for cards activated by an Open Network and covered by a claim of the Licensed Patents thus does not negate the release in the Settlement Agreement of InComm's activation of cards by the Host-to-Host system."[32] Therefore, "[t]he arbitrator may not expand the License Agreement to cover claims that were released in the Settlement Agreement."[33]

In the term of licensed products in the License Agreement, the definition of licensed product is expanded to 'the Settlement Agreement and dismissed with prejudice' because "even if the issue of whether the asserted products are 'Licensed Products' were arbitrable, as the district court erroneously concluded,

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27) *Alexsam*, *supra* note 10, at 13.

28) *Id.* at 13-14 (citing Deprenyl Animal Health, Inc. v. Univ. of Toronto Innov. Found., 297 F.3d 1343, 1349 (Fed. Cir. 2002) (regional circuit law governs the determination of whether claims for noninfringement and invalidity fall within the scope of the arbitration clause of the parties' agreement); *see* Flex-Foot v. CRP, Inc., 238 F.3d 1362, 1365 (Fed. Cir. 2001)(challenge to an arbitrator's award of fees was a matter of "state contract law interpretation and federal arbitration law" that was neither unique to patent law nor intimately involved in its substance) (citing Am. Med. Sys., Inc. v. Med. Eng'g Corp., 6 F.3d 1523, 1532 (Fed. Cir. 1993) ("State law... controls in matters of contract law and interpretation.")).

29) *Id.* at 14 (citing *Deprenyl*, 297 F.3d at 1349).

30) *Id.*

31) *Alexsam*, *supra* note 10, at 30.

32) *Id.* (referring to VIII., C., 2. The Settlement Agreement and License Agreement are separate agreements and need not correspond in scope).

33) *Id.* at 31.

there are limits to what an arbitrator may do."[34] For example, under specific provisions which authorize an arbitrator to determine issues of arbitrability, the arbitrator is prohibited from limiting, expanding or otherwise modifying the terms of the agreement.[35] In that case, "[t]he district court reasoned that 'where sophisticated parties specifically agree to arbitrate certain issues and when the dispute clearly arises from the License Agreement, the court finds it must submit the issue to arbitration.'(A22)."[36] Contrary to the district court's analysis, no provision of the License Agreement expressly confers on the arbitrator the power of determining what is arbitrable.[37] Therefore, it alleged that "the district court must determine arbitrability."[38] The district court cited a number of cases to support its conclusion, all of which are either distinguishable or support the opposite conclusion - that the court should decide arbitrability in this case.[39] This concludes that "[t]he district court erred in its interpretation of the arbitration clause in the License Agreement and its conclusion that whether the asserted products are Licensed Products under the License Agreement is arbitrable and not a matter for the court to decide."[40] Thus, in this case, InComm requested to the United States Court of Appeals, Federal Circuit that "the arbitrability of the

34) *Id.* at 32.

35) *Id.* at 32-33 (citing *see*, e.g., Agere Sys., Inc. v. Samsung Elecs. Co., 560 F.3d 337,340 (5th Cir. 2009) (arbitrator shall determine arbitrability issues, but "may not limit, expand or otherwise modify the terms" of the agreement) (emphasis added); *see* AT&T Tech., Inc. v. Communications Workers of America, 475 U.S. 643 (1986) (arbitrators derive their authority to resolve disputes from parties' advance agreement to submit such grievances to arbitration).

36) *Id.* at 33.

37) *Id.*

38) *Id.*

39) *Id.* at 35-36 (referring to, for example, cases examples in Alexsam, *supra* note 10, at 36-37: in Agere, Systems, Inc. v. Samsung Electronics Co., the agreement at issue provided that "if a dispute arises out of or relates to this Agreement · · · the parties agree to submit the dispute · · · to mediation by the AAA, · · · which shall be governed by the U.S. Arbitration Act." 560 F.3d at 339-40. The agreement further provided that the arbitrator "shall determine issues of arbitrability but may not limit, expand or otherwise modify the terms of this agreement" *Id.* at 340 (emphasis added). The court concluded that these provisions "explicitly confer upon an arbitrator the power of determining what 'arises out of or relates to' the agreement." *Id.*

40) *Id.* at 33 (see VIII., E., The District Court Erred in Concluding that Whether the Asserted Products Are Licensed Products Under the License Agreement Is An Arbitrable Issue, 1. The District Court Must Determine Arbitrability).

issue is for the district court to decide, not the arbitrator, and this Court should reverse the district court's decision and remand for further proceedings in light of that decision."[41]

Therefore, it is important to make clear and unambiguous statements in an agreement for the arbitration clause of both parties even the scope of arbitration agreement is broad or narrow. Under the savings clause of the Federal Arbitration Act (FAA), an arbitration agreement could be declared unenforceable if a generally applicable contract defense, such as fraud, duress, or unconscionability, applied to concerns raised about the agreement; however, an arbitration agreement cannot be invalidated by any defense that is applied in a way that singles out or disfavors arbitration.[42] Moreover, the parties "could have 'performed the arbitrable contract perfectly, fulfilling all expectations under that contract', and still be embroiled in this dispute."[43] This establishes that a contract principle is applied to the disputes and thus, the provisions of the arbitration clause should be obvious and clear without misinterpretation or arguments at courts or arbitrators. The case analysis shows that the licensing agreement applies to a contract principle and the determination of infringement and validity matters in the arbitration clause is related to contract interpretation. In this case, issues of arbitrability in arbitration clause are determined by the courts according to interpretation of the arbitration clause in the license

41) *Id.* at 41.

42) Eleanor L. Grossman and Glenda K. Harnad, American Jurisprudence (2nd ed.; Westlaw, Database updated August 2012); 4 Am. Jur. 2d Alternative Dispute Resolution § 91 (citing 9 U.S.C.A. § 2. Robinson v. Title Lenders, Inc., 2012 WL 724669 (Mo. 2012)).

43) Nimmer and Dodd, *supra* note 3 (see Hemispherx Biopharma, Inc. v. Johannesburg Consol. Investments, applied a different test - a foreseeability test - to determine the scope of a clause containing "arising under" in the arbitration provision of a licensing agreement. · · · As the court held, the license agreement was a " 'a contract of limited application' that 'does not profess to cover all present and future aspects of the relationship' between Hemispherx and Bioclones" and, while it "is not always easy to tell in ongoing business relationships whether any given transaction arises from a preexisting contract or instead developed organically from the relationship itself" in this situation, when the license agreement was signed "it was not foreseeable" that eight years later that "the · · · defendants would, some eight years later, make misrepresentations to Hemispherx in the course of discussing an equity investment in the latter because the investment was not contemplated by that agreement." citing Hemispherx Biopharma, Inc. v. Johannesburg Consol. Investments, 553 F.3d 1351, Fed. Sec. L. Rep. (CCH) P 95027 (11th Cir. 2008)).

agreement when there is no involvement of the substantive matters of patent enforcement.

Therefore, clear and unambiguous arbitration clause in the licensing agreement is important to designate who can decide the issues. Namely, if both parties clearly and unambiguously do not decide otherwise, the question of whether both parties agreed to arbitrate is to be decided by the court. It means that it is not decided by the arbitrator if clear and unambiguous statements do not existed in arbitration clause. The arbitration clause must explicitly confer the power of determination to the arbitrator.

III. Arbitration of Patent Disputes

In current business world that follows rapidly technology advancements, there are have been many patent issues and disputes between parties and could not resolve them at ease because both parties allege that their rights are protected or not infringed against the patent of other parties. In that case, for arbitration, the patent disputes are frequently questionable whether both parties have an arbitration clause and cover the scope of arbitration clearly and unambiguously in a contract. The language must be sufficient to the task of comprehending the dispute, but most courts follow the principle of reading the scope of the referral to arbitration very broadly.[44] In the agreement, the statements in arbitration clause have to be carefully stated to avoid the disputes.

"Often parties will use some variant of 'arising under' or 'relating to' as the touchstone for test for determining whether a dispute must be arbitrated: 'Any dispute [arising out of][relating to]this license agreement will be finally resolved by arbitration …,' [i]n some cases, the parties will use both phrases: 'arising out of or relating to …,' [w]hen the parties employ such capacious language the courts generally will find that arbitration covers a vast array of disputes."[45]

For example, in Medtronic AVE Inc. v. Cordis Corp. case (2004), "because Cordis seeks to arbitrate a "dispute related … in part to … [a] patent alleged to

44) Nimmer and Dodd, *supra* note 3, at § 2:69(b).
45) *Id.*

be a Licensed Patent, 'the question whether Cordis enjoys a license to the Boneau patents does indeed arise under the Agreement, and hence is arbitrable.'"[46] Also, in Datatreasury Corp. v. Wells Fargo & Co. case (2008), "the Fifth Circuit addressed whether a licensor's assignee is bound by arbitration clauses in licenses signed by the licensor."[47] The Fifth Circuit held that Data Treasury, as assignee of the patents, was not bound to arbitrate claims of infringement despite the breadth of the covenant not to sue and the presence of an arbitration clause.[48] If we see the issues of both cases, we will find that the issues are a little different because of the statements in the arbitration clause. In Datatreasury Corp. v. Wells Fargo & Co. (2008), [t]he threshold issue was whether the parties to the suit were bound by a valid agreement to arbitrate, a matter that the Fifth Circuit treated as a matter of state contract law.[49] The Fifth

46) *Id.* (citing Medtronic AVE Inc. v. Cordis Corp., 100 Fed. Appx. 865 (3d Cir. 2004). The court also noted that "New York law, which governs our interpretation of the Agreement, unquestionably supports this interpretation." In Shaw Group Inc. v. Triplefine Intern. Corp., 322 F.3d 115, 120 (2d Cir. 2003), the Court of Appeals for the Second Circuit applied New York law to interpret an arbitration clause which provided that "[a]ll disputes [between the parties] concerning or arising out of this Agreement shall be referred to arbitration." The court interpreted the "arising out of" language very broadly, holding that it required referring even the issue of arbitrability to the arbitrator.

47) *Id.* at § 2:69(a) (citing Datatreasury Corp. v. Wells Fargo & Co., 522 F.3d 1368, 86 U.S.P.Q.2d 1440 (Fed. Cir. 2008). Compare Promega Corp. v. Life Technologies Corp., 674 F.3d 1352, 102 U.S.P.Q.2d 1207 (Fed. Cir. 2012)(Provision for mandatory arbitration in patent license agreement bound assignee of license and covered dispute about royalties and infringement; arbitration provision clearly and unambiguously applied to all disputes arising out of or relating to agreement, limitations on discovery did not warrant departure from mandate of Federal Arbitration Act (FAA) to enforce arbitration provisions.)).

48) *Id.* at § 2:69(a) (citing The Fifth Circuit declined to rule on the other issue in the case — whether the scope of the license and covenant not to sue extended to the patents in question—since it held that the arbitration provision did not apply. Datatreasury Corp. v. Wells Fargo & Co., 522 F.3d at n.2.).

49) *Id.* (citing Datatreasury Corp. v. Wells Fargo & Co., 522 F.3d at 1371-72. ("[T]he question of whether a party is bound by an agreement containing an arbitration provision is a threshold question for the Court to decide." Microchip Technology Inc. v. U.S. Philips Corp., 367 F.3d 1350, 1357, 70 U.S.P.Q.2d 1847 (Fed. Cir. 2004)(internal quotations omitted). Because in deciding whether there is a valid agreement between the parties, the Fifth Circuit applies state law, · · · the question of arbitrability in the instant case turns on whether, under Minnesota law, there is a valid agreement to arbitrate between Appellant and Appellee. · · · "[F]ederal policy favoring arbitration does not apply to the determination of whether there is a valid agreement to arbitrate between the parties; instead ordinary contract principles determine who is bound.")).

Circuit found that under applicable state law generally a "party is not bound by an arbitration clause unless it is a signatory to the underlying contract," save in "limited circumstances" involving "(1) incorporation by reference; (2) assumption; (3) agency; (4) veil-piercing/alter ego; (5) estoppel; and (6) third-party beneficiary."[50] Neither Data Treasury nor the Wells entity being sued was a signatory to the patent license agreement,[51] and Wells did not contend that any of the six theories applied, [r]ather, Wells argued that the arbitration clause "ran with the patent" and that since "the owner of a patent cannot transfer an interest greater than that which it possesses, an assignee takes a patent subject to the legal encumbrances thereon."[52] The Fifth Circuit, however, distinguished between activities falling within the scope and procedural matters: "the legal encumbrances deemed to "run with the patent" in these cases involved the right to use the patented product, not a duty to arbitrate[;] [t]he cases do not support a conclusion that procedural terms of a licensing agreement unrelated to the actual use of the patent (e.g. an arbitration clause) are binding on a subsequent owner of the patent."[53]

Therefore, "[a] contract involving a patent or any right under a patent may contain a provision requiring arbitration of any dispute relating to patent validity or infringement arising under the contract."[54] As an alternative resolution, "[i]n the absence of such a provision, the parties to an existing patent validity or

50) *Id.* at § 2:69(a) (citing Datatreasury Corp. v. Wells Fargo & Co., 522 F.3d at 1372).

51) *Id.* (citing 522 F.3d at 1373 ("As viewed by the Fifth Circuit, requiring a non-signatory party to arbitrate solely on the basis of an arbitration clause in a license agreement between signatory parties would be inconsistent with basic principles of contract law and the Federal Arbitration Act · · · . '[W]e will read the reach of an arbitration agreement between parties broadly, but that is a different matter from the question of who may invoke its protections. An agreement to arbitrate is a waiver of valuable rights that are both personal to the parties and important to the open character of our state and federal judicial systems · · · . It is then not surprising that to be enforceable, an arbitration clause must be in writing and signed by the party invoking it' ").

52) *Id.* (citing Datatreasury Corp. v. Wells Fargo & Co., 522 F.3d at 1372 (citing Worley v. Loker Tobacco Co., 104 U.S. 340, 26 L. Ed. 821, 1881 WL 19938 (1881) Sanofi, S.A. v. Med-Tech Veterinarian Products, Inc., 565 F. Supp. 931, 220 U.S.P.Q. 416 (D.N.J. 1983)).

53) *Id.* at § 2:69(a) (citing Datatreasury Corp. v. Wells Fargo & Co., 522 F.3d at 1372-73).

54) 60 Am. Jur. 2d Patents § 998 (Jane E. Lehman, Anne E. Melley, and Elizabeth A. Brainard, American Jurisprudence, 2nd ed., Westlaw, Database updated August 2012) (citing 35 U.S.C.A. § 294(a)).

infringement dispute may agree in writing to settle such dispute by arbitration."[55] In cases of patent, "[c]laims that patent applicant was not inventor, and that confidential information was used in preparing application, were issues covered by arbitration clause in cooperation agreement between claimant and patent applicant, covering "any and all disputes" under agreement.[56] Also, "[u]nder patent licensing agreement arbitration provision, calling for arbitration of any patent matter dispute arising under agreement, question whether certain patents not specifically designated under agreement were covered by license was to be decided by arbitration.[57]

In addition to those cases, we have to think of questions "[w]ho decides whether the matter is subject to arbitration or whether the arbitration clause is valid?"[58] where the arbitratable issues are faced on. In the issue of who decides the question matter, the case of "Medtronic Ave. appears to be in the minority on this point."[59] MicroChip Technology Incorporated v. U.S. Philips Corporation,[60] provides an excellent comparison.[61] As the Federal Circuit noted, in John Wiley & Sons, Inc. v. Livingston,[62] the Supreme Court "held that the question of whether a party is bound by an agreement containing an arbitration provision is a 'threshold question' for the court to decide …. Because a party 'cannot be compelled to arbitrate if an arbitration clause does not bind it,' the Court held that there was 'no doubt' that 'a compulsory submission to arbitration cannot precede judicial determination that the … agreement does in fact create such a duty.'"[63]

Therefore, as analyzed those cases, where the statements are clear and unambiguous in the arbitration clause, "[a]ny such contract provision or

55) *Id.* (citing 35 U.S.C.A. § 294(a)).
56) *Id.* (citing Danisco A/S v. Novo Nordisk A/S, 2003 WL 282391 (S.D. N.Y. 2003).
57) *Id.* (citing Medtronic AVE Inc. v. Cordis Corp., 100 Fed. Appx. 865 (3d Cir. 2004).
58) Nimmer and Dodd, *supra* note 3, at § 2:69(c).
59) *Id.*
60) *Id.* (citing Microchip Technology Inc. v. U.S. Philips Corp., 367 F.3d 1350, 70 U.S.P.Q.2d 1847 (Fed. Cir. 2004)).
61) Nimmer and Dodd, *supra* note 58.
62) *Id.* (citing John Wiley & Sons, Inc. v. Livingston, 376 U.S. 543, 84 S. Ct. 909, 11 L. Ed. 2d 898, 55 L.R.R.M. (BNA) 2769, 49 Lab. Cas. (CCH) P 18846 (1964)).
63) Nimmer and Dodd, *supra* note 58 (citing Microchip Technology Inc. v. U.S. Philips Corp., 367 F.3d 1350, 1357, 70 U.S.P.Q.2d 1847 (Fed. Cir. 2004)).

agreement is valid, irrevocable, and enforceable, except for the usual grounds that exist at law or in equity for revocation of a contract."[64] The arbitration of disputes relating to patent validity or infringement, awards by arbitrators, and judicial enforcement of awards is governed by the federal arbitration statutes,[65] to the extent that the act is not inconsistent with the provision in the patent statutes providing for arbitration.[66] Thus, "[a] party to the arbitration must raise the statutory affirmative defenses[67] in order to have them considered by the arbitrator."[68] This means that "[t]he award by an arbitrator is final and binding between the parties to the arbitration, but has no force or effect on any other person."[69] It shows us that as a result of comparing to the United States, the Korea Arbitration Act should have clear and unmistaken clause for all necessary provisions to avoid ambiguous issues whether they are broad or narrow, when an agreement of both parties put the arbitration clause based on the Korea Arbitration Act. The comparative study will be future research whether there is an issue in Korea such as the cases of the United States.

IV. Arbitration of copyright disputes

In intellectual property issues, one of emerging disputes is copyright claims. In the copyright cases, how an arbitrator involves an issue and how to solve it through ADR are in issues on the side of arbitrators or courts. Thus, this research will show and analyze the U.S. cases how the cases can be resolved on those issues.

A broad arbitration clause in a publishing or licensing agreement encompasses Copyright Act claims, and an arbitrator has jurisdiction to base an award on the

64) 60 Am. Jur. 2d Patents §998 (Jane E. Lehman, Anne E. Melley, and Elizabeth A. Brainard, American Jurisprudence, 2nd ed., Westlaw, Database updated August 2012) (citing 35 U.S.C.A. § 294(a)).

65) 60 Am. Jur. 2d Patents § 999 (Jane E. Lehman, Anne E. Melley, and Elizabeth A. Brainard, American Jurisprudence, 2nd ed., Westlaw, Database updated August 2012) (citing 9 U.S.C.A. §§ 1 to 307).

66) *Id.* (citing 35 U.S.C.A. § 294(b)).

67) *Id.* (citing 35 U.S.C.A. § 282, discussed in § 877).

68) *Id.* (citing 35 U.S.C.A. § 294(b)).

69) *Id.* (citing 35 U.S.C.A. § 294(c)).

Copyright Act where "the arbitration clause was broad enough to encompass Copyright Act claims which required interpretation of the contract."[70] In addition, "[t]he contention has also been rejected that public policy prohibits the submission of copyright claims to arbitration, since '[t]he only 'public interest' in a copyright claim concerns the monopoly inherent in a valid copyright.'"[71] Also, "[t]he courts have gone further and subsequently held that Congress' decision to give the federal courts exclusive jurisdiction over copyright actions does not preclude the arbitration of disputes over the validity of a copyright, since if state courts are empowered to decide copyright issues that arise in the course of actions pending in those courts, there is no reason to think that arbitrators are more likely to err in copyright cases."[72] It means that courts confirm that arbitration of disputes can be held by an arbitrator if there is a valid arbitration clause.

In that case, "[t]he issue, as framed by one court, was 'whether the arbitration of a dispute arising from a copyright license must be interrupted if the licensee challenges the validity of the copyright,'; [s]uch an interruption would 'toss a monkey wrench into an important means of resolving contractual disputes over intellectual property,'; [t]he court therefore held "that federal law does not forbid arbitration of the validity of a copyright, at least where that validity becomes an issue in the arbitration of a contract dispute."[73] "Arbitration may be the chosen method of dispute resolution, even though the consent of one of the parties to arbitrate is based only on his or her membership in an organization that requires arbitration to resolve all of its members' disputes,; [f]or example, the American

70) Richard A. Lord, Williston on Contracts § 57:172 (see 21 Williston on Contracts, § 57:172 Copyrights, 4th ed., Westlaw, Database updated May 2012) (citing Kamakazi Music Corp. v. Robbins Music Corp., 684 F.2d 228 (2d Cir. 1982)).

71) *Id.* (citing as to public policy limitations on arbitration, see § 57:34).

72) *Id.* (citing Saturday Evening Post Co. v. Rumbleseat Press, Inc., 816 F.2d 1191 (7th Cir. 1987)) (The court rejected Rumbleseat's argument that Congress' decision to give the federal courts exclusive jurisdiction over copyright actions implicitly precluded arbitration of disputes over the validity of a copyright, reasoning that state courts are empowered to decide patent or copyright issues that arise in the course of state actions. Indeed, there is no reason to think that arbitrators are more likely to err in copyright cases than state or federal judges are. citing from 2 Commercial Arbitration §26:3, Westlaw, Database updated August 2012)).

73) *Id.* at § 57:172 (subjecting Copyrights).

Society of Composers, Authors and Publishers was required, by the terms of a consent order entered in an antitrust action, to establish a review board and an arbitration mechanism to resolve members' complaints regarding the distribution of royalties, and it incorporated into its Membership Agreement and Articles of Association much of the language from the consent order, including a requirement that an aggrieved member protest to an ASCAP Board of Review, with a right to appeal to a panel of the American Arbitration Association."[74] "A composer's argument that his due process rights were violated by ASCAP's method of dispute resolution and that ASCAP's establishment of the grievance procedure, as mandated by the consent judgment, constituted sufficient state action to warrant constitutional protection, has been rejected, the court finding that the composer 'failed to demonstrate any state action which would trigger the applicability of the due process clause,' and since both ASCAP and the composer consented to the method of dispute resolution, '[t]he mere approval by this Court of the use of arbitration did not create any state action.'"[75] Federal law does not forbid arbitration of copyright validity where that validity is at issue in a contract dispute.[76] Thus, when a not-to-compete or a no-contest clause in a copyright licensing agreement is in issues, a not-to-compete or "[a] no-contest clause in a copyright licensing agreement did not violate public policy."[77] That there are no antitrust cases - or for that matter any other reported cases - that deal with a no-contest clause in a copyright license is evidence that these clauses are not such a source of significant restraints on freedom to compete as might warrant a per se rule of illegality.[78]

In a copyright case of Kamakazi Music Corp. v. Robbins Music Corp., 684

74) *Id.* (citing U.S. v. American Soc. of Composers, Authors and Publishers, 32 F.3d 727 (2d Cir. 1994)(holding that the federal court that had jurisdiction over the consent judgment also had jurisdiction over a motion by a composer of advertisement jingles to vacate or modify the arbitration panel's determination that modified the payment rate, but did not give the composer the full relief he desired)).

75) *Id.* (citing U.S. v. American Soc. of Composers, Authors and Publishers, 708 F. Supp. 95 (S.D. N.Y. 1989).

76) Thomas H. Oehmke, Commercial Arbitration § 26:3 (see 2 Commercial Arbitration, § 26:3 Copyrights - Arbitrability, Westlaw, Database updated August 2012).

77) *Id.*

78) *Id.* at § 26:3 (subjecting Copyrights – Arbitrability).

F.2d 228 (2d Cir. 1982), "[t]he court found that it had jurisdiction because the claim was for copyright infringement."[79] "In addition, the arbitrator had jurisdiction to make an award under the Copyright Act"[80] because of broad of the arbitration clause. An arbitration award, rendered in favor of Kamakazi, was confirmed and Robbins did not prevail in an appeal when arguing that the arbitrator exceeded authority in basing remedies on the Copyright Act[81] and that the court lacked jurisdiction.[82] Also, "[t]here was no public policy reason why the claim for infringement of a valid copyright should not be referred to arbitration."[83] In Saturday Evening Post Co. v. Rumbleseat Press, Inc., 816 F.2d 1191 (7th Cir. 1987), the court stated that "[t]he validity of a copyright is arbitrable, and the district court has jurisdiction to order arbitration under a copyright-license agreement."[84] However, third party who is not a party in an agreement "which contains an arbitration clause cannot compel arbitration of the copyright-infringement action by asserting the benefit of the arbitration clause as an agent of the codefendant who entered into the sales contract, unless the defendant seeking arbitration submits evidence of an agency relationship between it and the contracting codefendant."[85]

Therefore, based on those cases, courts ruled that the validity of a copyright is not exclusive at the courts if there is a broad arbitration clause that contains the Copyright Act. Also, the appeal court in the seventh circuit indicated that where they have exclusive rights for database, a shrinkwrap license can be applied to a contract principle first not the copyright law.[86] Even though it is a

79) Thomas H. Oehmke, Commercial Arbitration § 26:2 (see 2 Commercial Arbitration, § 26:2 Copyrights - Broad clause, Westlaw, Database updated August 2012).
80) *Id.* at § 26:2 (subjecting Copyrights - Broad clause).
81) *Id.* (citing 17 U.S.C.A. §§ 101 et seq.).
82) *Id.* at § 26:2 (subjecting Copyrights - Broad clause).
83) *Id.* (citing Kamakazi Music Corp. v. Robbins Music Corp., 684 F.2d 228 (2d Cir. 1982)).
84) 7A Fed. Proc., L. Ed. § 18:146 (Federal Procedure, Lawyers ed., Westlaw, Database updated September 2012).
85) *Id.* (citing Lorber Industries of California v. Los Angeles Printworks Corp., 803 F.2d 523 (9th Cir. 1986).
86) *See* Byung Youn Chang, *A Study on Infringement Cases of Software Copyright and the Dispute Settlement,* Journal of Arbitration Studies, v.13, no.2, 547, 567 (The Korean Association of Arbitration Studies, 2004) (citing ProCD Inc. v. Zeidenberg, 39 USPQ2d 1161, No. 96-1139 (7th Cir. 1996)).

business model dispute in patent[87] or liability matters on infringement of copyright such as direct, contributory, or vicarious liability,[88] first of all, the applicable theory is a contract principle in the arbitration clause. In addition to that matter, "[w]hen a complaint contains both arbitrable and nonarbitrable claims, the Federal Arbitration Act requires courts to compel arbitration of pendent arbitrable claims when one of the parties files a motion to compel, even where the result would be the possibly inefficient maintenance of separate proceedings in different forums; accordingly, courts must examine a complaint with care to assess whether any individual claim must be arbitrated, and the failure to do so is subject to immediate review."[89] Thus, "[t]he Federal Arbitration Act reflects an emphatic federal policy in favor of arbitral dispute resolution; this policy, as contained within the Act, requires courts to enforce the bargain of the parties to arbitrate, and cannot possibly require the disregard of state law permitting arbitration by or against nonparties to the written arbitration agreement."[90] This establishes that "[a]n allegation that some of the terms in an arbitration agreement conflict with a state statutory right that is not waivable by contract require court to decide whether the conflict precludes enforcement of the arbitration agreement."[91]

Accordingly, "[i]n determining whether to compel a party to arbitration, a district court may not review the merits of the dispute; rather, a district court's role under the Federal Arbitration Act (FAA) is limited to determining (1) whether a valid agreement to arbitrate exists and, if it does, (2) whether the agreement encompasses the dispute at issue."[92] This indicates that an arbitration clause in the agreement even a copyright case has an important role in disputes

87) *See* Byung Youn Chang, *Arbitration Dispute Resolution Study upon e-Commerce Issues,* Journal of Arbitration Studies, v.11, no.1, 247, 277-282 (The Korean Association of Arbitration Studies, 2001).

88) *See* Byung Youn Chang, *A Study on the Protection of Intellectual Property Rights of Contents upon Internet*, Journal of Arbitration Studies, v.12, no.2, 373, 403 (The Korean Association of Arbitration Studies, 2003).

89) 4 Am. Jur. 2d Alternative Dispute Resolution § 91(citing 9 U.S.C.A. §1 et seq. KPMG LLP v. Cocchi, 132 S. Ct. 23 (2011)); *see supra* note 42.

90) *Id.*

91) *Id.* (citing 9 U.S.C.A. §§ 3, 4. Escobar-Noble v. Luxury Hotels Intern. of Puerto Rico, Inc., 680 F.3d 118 (1st Cir. 2012)).

92) *Id.* (citing 9 U.S.C.A. § 2. Verducci v. Coda, 743 F. Supp. 2d 1182 (S.D. Cal. 2010)).

for the court to determine whether it is arbitrable to compel the arbitration. That is, a broad arbitration clause in an agreement enables an arbitrator to decide an award or rule upon intellectual property claims even though it involves the copyright disputes in the agreement. This is an important point for arbitration.

V. Conclusion

This research is to study the cases of the United States concerning arbitration of intellectual property disputes. Thus, the purpose of this research is to study and outline the U.S. researches on IP related cases for further researches of arbitration of IP disputes in Korea and comparative studies in the near future. In this research, the U.S. cases on arbitration of IP related matters were adopted and quoted to achieve the purpose of this research and for effective researches. Thus, the organization of the research was arranged by the cases in the fields of arbitration and intellectual property.

The arbitration clause is applied to contract principles as analyzed the arbitrability issues at courts about who can decide the issues and whether an issue is arbitrable on disputes. In general, the question of arbitrability is the question of a judicial field. However, courts respect for arbitration where the clause of the arbitration is clear, unambiguous, and unmistaken statements because the Federal Arbitration Act covers the arbitration clause and the scope of arbitration. Thus, in that case, an arbitrator can decide arbitrability. However, in the United States, courts found that some cases have ICC rules to be bound, and others have AAA rules. Either rule is required by the courts that the arbitration clause must be carefully made and that the clause must provide clear and unambiguous statements.

In the arbitration of licensing disputes, proper cases reviewed, analyzed, and found that it was important to make clear and unambiguous statements in an agreement for the arbitration clause of both parties whether the scope of arbitration is broad or narrow. The finding gives us that a contract principle is applied to the disputes and thus, the provisions of the arbitration clause should be obvious and clear without misinterpretation or arguments by the courts or

arbitrators.

In the arbitration of patent disputes, the patent disputes are frequently questionable whether both parties have an arbitration clause and cover the scope of arbitration clearly and unambiguously in a contract. The statements in the arbitration clause must be sufficient to cover the disputes. Thus, most courts have followed a broad scope of the arbitration clause as analyzed the cases in this research. Also, a phrase of "arising under" or "relating to" in an agreement, as the test of determination of arbitrability, is important whether arbitration covers a broad statement for ADR and prevention of disputes. In addition, under patent or related rights, the agreement may contain a statement for patent validity or infringement matters to resolve disputes through arbitration because the arbitration is governed by the Federal Arbitration Act. Thus, this analysis indicates that as a result of comparing with the cases of the United States, the Korea Arbitration Act should also contain clear and unmistaken statements for all necessary provisions to avoid ambiguous issues whether they are broad or narrow, when an agreement of both parties put the arbitration clause based on the Korea Arbitration Act. The comparative study will be future research if there is an issue in Korea such as the cases of the United States.

In the arbitration of copyright disputes, cases are analyzed regarding issues of how an arbitrator involves an issue and how to solve it through ADR on the side of arbitrators or courts. Findings are, based on the cases, courts have held that the validity of a copyright is not exclusive at the courts if there is a broad arbitration clause that contains the Copyright Act, and the Federal Arbitration Act supports courts to compel arbitration on the arbitrable claims. This indicates that an arbitration clause in the agreement, even in a copyright case, has an important role in disputes for the court to determine whether an issue is arbitrable and whether the court can compel the arbitration. That is, a broad arbitration clause in an agreement enables an arbitrator to decide an award or rule upon intellectual property claims even though it involves the copyright disputes in the agreement. The analysis proves that an arbitrator can handle copyright disputes if there is a valid and clear arbitration clause in an agreement, even though there is an allegation of public policy that does not allow copyright

claims to arbitrate. Arbitration may be a choice for the dispute resolution where validity of a copyright becomes an issue in the arbitration clause that applies to a contract principle.

In conclusion, the results of this research indicate that scope of arbitration in an agreement applies to a contract principle, and the determination of infringement and validity matters in the arbitration clause is related to contract interpretation. Therefore, if both parties clearly and unambiguously do not decide otherwise, the question of whether both parties agreed to arbitrate is to be decided by the court. This means that the dispute is not decided by the arbitrator if clear and unambiguous statements do not existed in arbitration clause. The arbitration clause must explicitly confer the power of determination to the arbitrator. The comparative analysis of IP areas for comparing with cases of Korea and the United States will be remained for further research in the near future.

Reference

4 Am. Jur. 2d Alternative Dispute Resolution § 91.

7A Fed. Proc., L. Ed. § 18:146 (Westlaw, Database updated September 2012).

35 USCA § 294.

60 Am. Jur. 2d Patents § 998 - § 999 (Westlaw, Database updated August 2012).

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국문초록

지적재산분쟁의 중재에 대한 미국 케이스에 관한 연구

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특허분쟁의 중재에 있어서, 대부분 법원들은 케이스들을 분석할때에 광범위한 중재조항에 따라오고 있습니다. 중재적격 결정의 테스트로서 계약에서 “arising under”

or “relating to” 구절은 ADR을 위해 그리고 분쟁의 예방을 위해 중재가 광범위한 문구를 포함하고 있는가 아닌가를 보는데 중요합니다. 더구나, 특허 또는 특허관련 권리들 하에서, 중재는 연방중재법에 의해 지배되기 때문에 계약은 특허 유효성 또는 침해 문제들이 중재를 통한 분쟁을 해결하도록 하나의 문구를 포함해도 됩니다. 그러므로, 이 분석은 미국의 케이스들을 비교한 결과로서, 한국중재법도 또한 모든 필요한 조문들이 그것들이 광범위하건 제한된 범위이건 간에 모호한 이슈들을 피하기 위해 분명하고 오해없는 문구들이여야 한다는 것을 제시합니다.

지적재산분쟁의 중재에 있어서, 케이스에 근거하여 발견한 점들은 저작권법을 포함한 광범위한 중재조항이 있는 경우 저작권의 유효성은 법원이 독점할 수 없다고 법원은 판단했습니다. 그리고 연방중재법은 법원이 청구취지가 중재가능한 클레임들에(arbitrable claims) 관하여 중재를 강요하도록 지원하고 있습니다. 이것은 저작권 케이스일지라도 계약에 있어서 중재조항이 법원이 중재를 강요하도록 중재가능한가 아닌가 결정하는데 분쟁에 있어 중요한 역학을 한다는 것을 제시합니다. 그러므로, 본 연구는 계약에서 광범위한 중재조항은 중재인이 지적재산 클레임에 대해 판정 또는 룰을 결정하게 허용한다는 것을 발견했습니다.

본 연구의 결과들은 계약에 있어 중재의 범위는 계약의 원칙을 적용한다는 것입니다 그리고 중재조항에 있어서 침해와 유효성 문제들의 결정은 계약 해석에 관련되어 있다는 것을 제시합니다. 그러므로, 양 당사자가 분명하고 명확하게 달리 결정하지 않았다면, 양 당사자가 중재에 대해 동의했는가 아닌가의 의문점은 법원에 의해 결정되어지는 것입니다. 이것은 분명하고 명확한 문구가 중재조항에 존재하지 않는다면 중재인에 의해 결정되지 않는다는 것을 뜻합니다. 중재조항은 명백하게 중재인에게 결정의 권한을 주어야만 한다는 것입니다.

주제어 : 중재, ADR, 지적재산분쟁, 라이센싱, 특허, 저작권, 중재적격