

2024 Korea-US IP Forum

October 23rd (Wed), 2024
Westin Alexandria Old Town



TIME		TOPIC	SPEAKER	
9:00-10:00 AM		Registration & Networking		
Opening Session	10:00-10:10 AM	Opening Remarks	Sarah Ahn	Economic Minister at the Embassy of the Republic of Korea in the USA
	10:10-10:20 AM	Congratulatory Remarks	Michael Kim	Acting Deputy Chief Administrative Patent Judge at USPTO
	10:20-10:30 AM	Welcoming Remarks	Yeonwoo Jung	Interim President of IPTAB of Korea
Keynote Speech	10:30-10:50 AM	Protecting IP for Enhancing Corporate Competitiveness	Randall Rader	Former Chief Judge of CAFC
10:50-11:00 AM		Photo Session		
SESSION I Panel Discussion	11:00 - 12:00 PM	Cross-Border IP Dispute: Challenges and Opportunities	John Kim (Moderator), Clark Hill, PLC Min Woo Park, Morgan, Lewis & Bockius, LLP Morgan McPherson, Attorney-Advisor at USCBP Sean Yeom, President of MedSchenker Arvind Iyengar, Attorney at Samsung Electronics	
12:00-1:00 PM		Lunch & Networking		
SESSION II IP Litigation Strategies When Entering the U.S. Market	1:00-1:20 PM	Recent Trends in IP Litigation	Tommy Martin	Baker Botts, LLP
	1:20-1:40 PM	IP Litigation Practice	Yoonhee Kim	Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
SESSION III Introduction to IP Appeal System in Korea	1:40-2:00 PM	Overview of Patent Trials in Korea and Recent Key Institutional Reforms	Kwang-pyo Ra	Presiding Administrative Patent Judge, IPTAB of Korea
	2:00-2:20 PM	IP Litigation in Korea and Cross-Border E-Discovery involving Korean Companies	Shin Jeong Lee, Hyun Chul Noh	DR & AJU, LLC
Closing Session	2:20-2:25 PM	IP Protection for Companies Conducting Business in the U.S.	Yong Ha Kim	Director at the KOIPA U.S. Capital IP Center
	2:25-2:30 PM	KIPO's PCT Services and Introduction to PCT Korea Help Desk Services	Tae Hyun Lee	President of the PCT Korea Center
	2:30-3:30 PM	USPTO Tour	Thomas Hong	U.S. Patent and Trademark Office

2024 Korea-US IP Forum

SESSION I

Panel Discussion

Cross-Border IP Dispute : Challenges and Opportunities

- John Kim (Patent Attorney, Clark Hill)
- John Park (Morgan, Lewis & Bockius)
- Morgan McPherson (Attorney-Advisor at USCBP)
- Sean Yeom (President of Vectornate)
- Matthew Bathon (Attorney at Samsung Electronics)

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2024 Korea-US IP Forum

Cross-Boarder IP Dispute: Challenges and Opportunities

October 23, 2024

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Overview:

IP Disputes/Enforcement in the United States

- 337 Investigations at the International Trade Commission (ITC)
 - Min Woo Park, Ph.D., Associate, Morgan Lewis: Outside counsel perspective
 - Sean Yeom, President, Vectornate USA, Inc.: Client perspective
 - Arvind Iyengar, Senior Legal Counsel, Samsung Electronics: In-house perspective
- U.S. Customs and Boarder Protection
 - Morgan N. McPherson, Attorney-Advisory, Custom Border Protection
- IP Litigations in U.S. District Courts and Alternatives
 - John K. Kim, Member, Clark Hill



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KNOW BEFORE IMPORTING INTO U.S.

▪ ITC's remedy directed at imported goods

- No need to establish personal jurisdiction over defendants (called "respondents" in 337 investigations)
- Response to complaint due in about 20 days of service and notice of institution
 - Service is simply express mail delivery by the Commission
 - **Failure to respond** results in **default judgement** of exclusion/cease-and-desist
 - Get to work as soon as you find out that you've been sued!!



Morgan Lewis

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CLAIMS OTHER THAN PATENT INFRINGEMENT

▪ Statutory Language Allows More than Patent Infringement to be Investigated

Year	Solely Patent Infringement	Solely Trademark Infringement	Solely Trade Secret Misappropriation	Patent, Trademark or Copyright Infringement, Trade Secret Misappropriation, and/or Other Unfair Acts	Copyright Infringement, Trade Secret Misappropriation, Unfair Competition, False Advertising and/or Other Unfair Acts
2020	103	4	5	3	5
2021	116	3	9	4	3
2022	127	4	6	5	0
2023	96	3	2	3	3

Source:
https://www.usitc.gov/intellectual_property/337_statistics_types_unfair_acts_alleged_active.htm

- **Trade secret misappropriation**
- Antitrust claims
- False advertising
- Contract claims

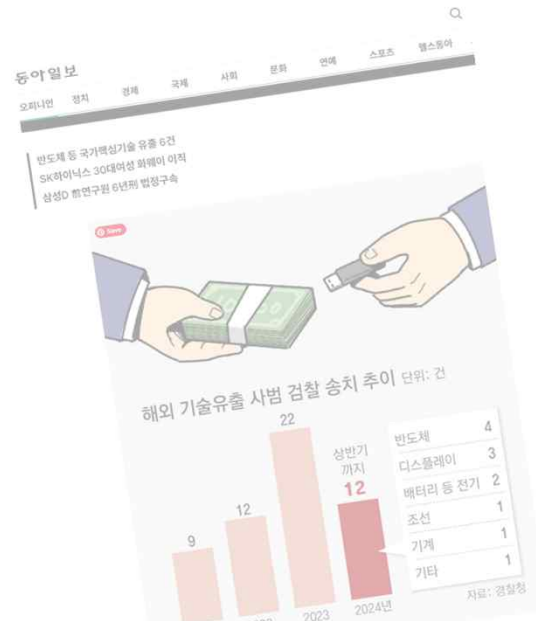
Morgan Lewis

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CLAIMS OTHER THAN PATENT INFRINGEMENT

- Trade secret misappropriation by foreign entity/person that took place **entirely abroad** can be litigated at the ITC
- In contrast, DTSA requires **at least some act “in furtherance of” the misappropriation** take place **in the U.S.**



Morgan Lewis

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Sean Yeom, CEO & President
October 2024

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Covid made company to turn


- Automated flocking and static electricity machine
- Vial filling machine
- Labeling machine
- Barcode and Lot number printer
- HEPA filtration HVAC
- Clean room facility and related equipment



In 3 months we went from a blank slate to a full factory.



Letter from ITC... what?



UNITED STATES
INTERNATIONAL TRADE COMMISSION

Search www.usitc.gov for

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Home

USITC INSTITUTES SECTION 337 INVESTIGATION OF CERTAIN FLOCKED SWABS, PRODUCTS CONTAINING FLOCKED SWABS, AND METHODS OF USING SAME

CONTACT US +

HELPFUL RESOURCES +

August 27, 2021
News Release 21-210
Inv. No(s): 337-TA-1279
Contact: Peg O'Laughlin, 202-205-1819

USITC INSTITUTES SECTION 337 INVESTIGATION OF CERTAIN FLOCKED SWABS, PRODUCTS CONTAINING FLOCKED SWABS, AND METHODS OF USING SAME

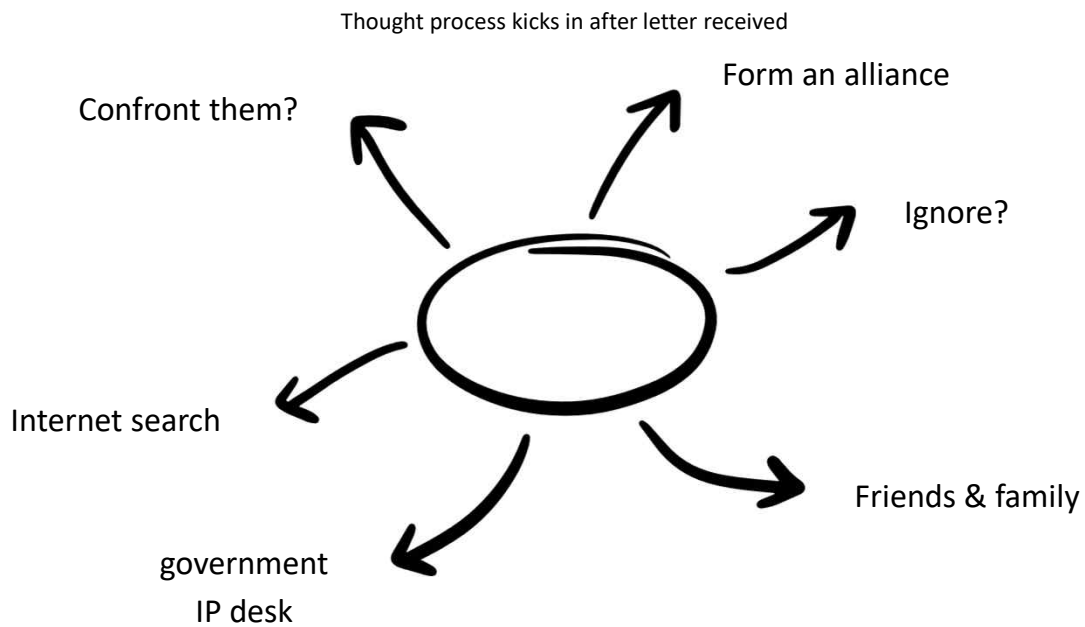
The U.S. International Trade Commission (USITC) has voted to institute an investigation of certain flocked swabs, products containing flocked swabs, and methods of using same. The products at issue in the investigation are described in the Commission's notice of investigation.

The investigation is based on a complaint filed by Copan Italia S.p.A. of Brescia, Italy, and Copan Industries, Inc., of Aqueduct, Puerto Rico, on July 9, 2021. Supplements to the complaint were filed on August 18, 2021, August 19, 2021, and August 23, 2021. The complaint, as supplemented, alleges violations of section 337 of the Tariff Act of 1930 in the importation into the United States and sale of certain flocked swabs, products containing flocked swabs, and methods of using same that infringe patents asserted by the complainants. The complainants request that the USITC issue a general exclusion order, or in the alternative a limited exclusion order, and cease and desist orders.

The USITC has identified the following as respondents in this investigation:

Han Chang Medico of Chungnam, Republic of Korea;
Virus NEST Biotechnology Co., Ltd. of Wuxi, Jiangsu, China;
NEST Scientific, Inc. of Rahway, NJ;
NEST Scientific USA of Rahway, NJ;
Miraclean Technology Co., Ltd. of Shenzhen, Guangdong, China;
Vectormate Korea Ltd. of Jangjeong, Jeonnam, Republic of Korea;
Innovative Product Brands, Inc. of Highland, CA;
Thomas Scientific, Inc. of Swedesboro, NJ;
Thomas Scientific, LLC of Swedesboro, NJ;
Stellar Scientific, LLC of Owings Mills, MD;
Cardinal Health, Inc. of Dublin, OH;
Koti Biomedical, Inc. of Williamsport, NY;
Koti Diagnostics, Inc. of Williamsport, NY;
Jiangsu Changfeng Medical Industry Co., Ltd. of Yangzhou, Jiangsu, China;*
No Borders Dental Resources, Inc., d/b/a MedDent Supplies, of Queen Creek, AZ.*

Letter from ITC... what?



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Factors to consider

Time

Don't Panic but don't delay

Patent attorney

Small and less expensive? or
Expensive and experienced

Arbitration

via attorney, Talk to them direct?
Use 3rd party?

Cost (Price)

How much to legal professional
but also how much resource within company

Business Operation

Keeping operation active and still making
profits

Customers

Afraid to order from you
How to make them to have a piece of mind

Alliance

Talk with your competitors?

Patent for your defense

Takes time to file and get approved
Timing to file, maybe it is late already

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337 Investigations at the ITC

Arvind Iyengar

Senior Legal Counsel – Samsung Electronics

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Learn the Difference

In-House teams that are not experienced 337 litigants may not fully appreciate the differences between ITC and District Court practice

- Speed (~18 months to completion)
- Additional claim elements
 - Importation
 - Domestic Industry
- Broad Discovery

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Manage Expectations

In addition to structural differences, an ITC investigation may require you to guide your clients to adjust their attitudes toward litigation

- Different Trial Themes are effective
- Goal of the Hearing
- Litigating for the Post-Trial Brief

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CBP's Role in Protecting IP at the Border and How to Protect Your IP through CBP's e-Recordation Program



**U.S. Customs and
Border Protection**

**Morgan McPherson
Attorney Advisor**

**Intellectual Property Enforcement Branch
Morgan.N.McPherson@cbp.dhs.gov**

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CBP's Enduring Mission Priorities



- **Counter Terrorism** – Anticipate, detect and disrupt the threat of terrorists, their weapons and actions to protect the people and economy of the United States.
- **Combat Transnational Crime** – Detect, deter and disrupt transnational organized crime that threatens U.S. national and economic security interests at and beyond the border.
- **Secure the Border** – Protect the Homeland through the air, land and maritime environments against illegal entry, illicit activity or other threats to uphold national sovereignty and promote national and economic security.
- **Facilitate Lawful Trade and Protect Revenue** – Enable fair, competitive and compliant trade and enforce U.S. laws to ensure safety, prosperity and economic security for the American people.
- **Facilitate Lawful Travel** – Enhance, enable and transform the travel experience by anticipating, detecting and intercepting threats prior to and at ports of entry.

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CBP's IP Border Enforcement Structure and Authority

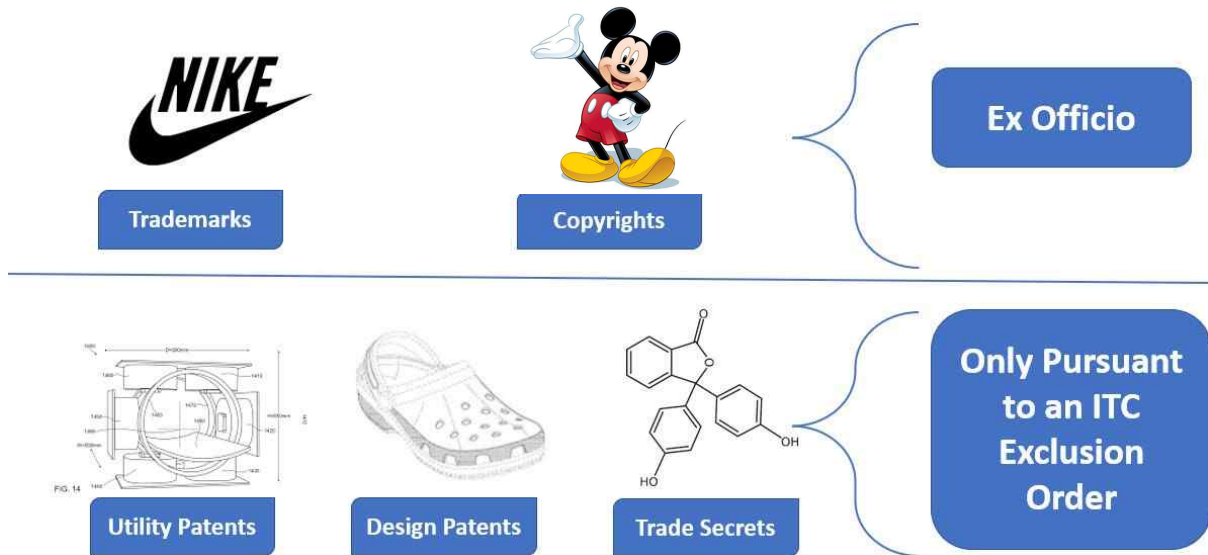


- CBP is the primary federal agency responsible for securing the U.S.'s borders
- CBP provides civil enforcement of Intellectual Property Rights
- CBP has *ex officio* authority to detain and seize merchandise without a right holder application
- It is CBP's policy to focus its enforcement efforts on those trademarks and copyrights that are **recorded** with CBP
- Administrative process; multiple layers of review
- **Right holders not charged for enforcement procedure**

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What IP Does CBP Enforce?



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Recording with CBP



U.S. Customs & Border Protection e-Recordation Program

How to Obtain Border Enforcement of Trademarks and Copyrights

United States Customs and Border Protection (CBP) has the authority to detain, seize, forfeit, and ultimately destroy merchandise seeking entry into the United States if it bears an infringing trademark or copyright that has been registered with the United States Patent and Trademark Office (USPTO) or the United States Copyright Office (USCO), and has subsequently been recorded with CBP as an intellectual property right (IPR) owner, you can partner with CBP to receive border enforcement of your registered trademarks and copyrights through CBP's e-Recordation Program.

[New Recordation](#)
[Renewal](#)
[Change of Ownership](#)
[Change Point of Contact](#)

[Check Status](#)
[Request 3 Month Extension](#)

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Submit Application Through IPRR



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IPE Branch Review



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Once Approved, Recordation Appears on IPRS/IPRIS

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Programs Available to Recordation Holders



SUBMISSION OF
PRODUCT
AUTHENTICATION
MANUAL/GUIDES



CBP DIRECTED
WEBINAR
PRESENTATION



IN-PERSON FIELD
TRAINING



E-ALLEGATION
REPORTING



ENHANCED
PARTNERSHIP
WITH CBP



U.S. Customs and
Border Protection

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QUESTIONS?

Morgan McPherson

Attorney-Advisor

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IPRRQUESTIONS@cbp.dhs.gov



U.S. Customs and
Border Protection

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IP Litigations in U.S. District Courts

- Disputes involving patents, trademarks, copyrights and other IP.
- Key features:
 - Extensive discovery
 - Jury trial
 - Full remedies:
 - monetary damages (including enhanced)
 - Injunction
 - Possible recovery of attorney's fees



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IP Litigations in U.S. District Courts

- Long duration, frequently lasting over 2 or 3 years to jury trial, especially since COVID.
 - Expensive:
 - Patent infringement litigation costs through trial and appeal (for 2022):
 - \$1.12 million for cases involving less than \$1 million at risk
 - \$2.39 million for cases involving \$1-\$10 million at risk
 - \$4.80 million for cases involving \$10-\$25 million at risk
 - \$6.12 million for cases involving more than \$25 million at risk
- (source AIPLA 2023 Report on the Economic Survey)
- Generally difficult to win on patent invalidity grounds due to presumption of patent validity (clear and convincing evidence)



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Alternatives to IP Litigations in U.S. District Courts

- Patent invalidity challenges via IPR/PGR at USPTO:
 - Much quicker:



- Costs: e.g., \$350,000 through PTAB hearing for mechanical/electrical patents (\$500K for appeal) (source AIPLA 2023 Report on the Economic Survey)
- Subject matter expertise: three judge panel with technical background
 - 71% invalidity rate for first two quarters of FY 2024 (68% in FY 2023) (Source: USPTO)
- Potential stay of related district court patent litigation



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Alternatives to IP Litigations in U.S. District Courts

- *Ex parte* Reexam of issued patents at USPTO
 - Initiated by challenger by filing a request showing substantial new question of patentability (SNQ)
 - If accepted, reexam proceeds between patent owner and USPTO
 - Not used widely by patent challengers
 - Allowance rate for reexamined patents relatively high.
 - Potential benefits
 - Cost effective
 - May be used effectively in non-litigation setting



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Thank You

Legal Disclaimer

This document is not intended to give legal advice. It is comprised of general information. Companies or individuals facing specific issues should seek the assistance of an attorney.



2024 Korea-US IP Forum

SESSION II

Tommy Martin

Baker Botts, LLP

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IP Litigation Trends

2024 Korea - U.S. IP Forum

October 23, 2024

Presented by: Tommy Martin

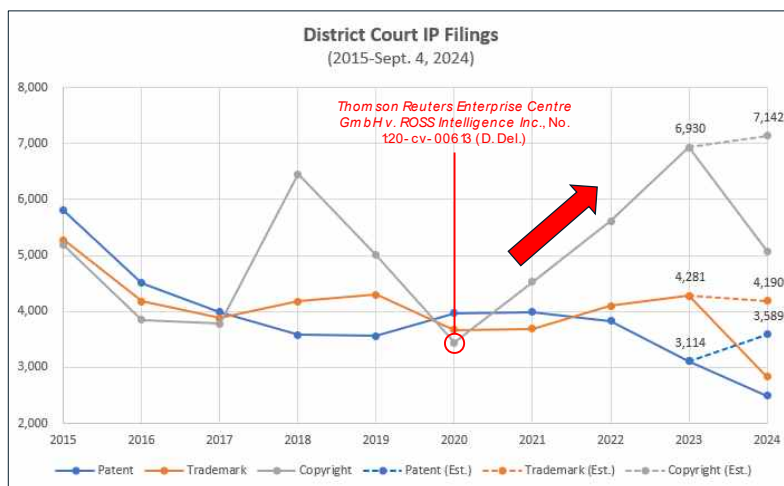
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PARTNER TO THE INNOVATORS

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IP Litigation Filing Trends

- Over the past decade, the number of IP-related cases filed in federal district courts peaked in 2015 before decreasing steadily from 2015 to 2017.
- Patent cases bottomed out in 2019 and 2020 with an increase in 2021 followed by gradual decrease from 2021 to 2023. This year is expected to show an increase of last year.
- Trademark cases have remained fairly steady since 2016, at least compared to patents and copyrights.
- Copyright cases have seen significant increases since 2020 and are expected to continue this trend as a result of recent developments in AI.



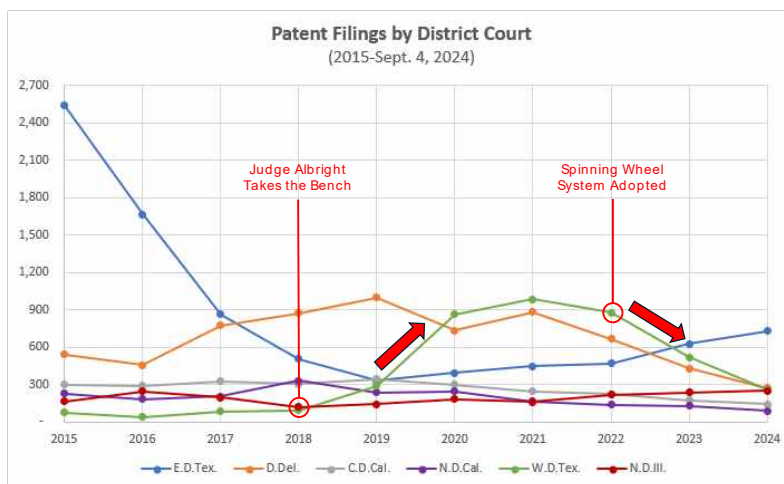
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Most Active Patent Venues

- The top three venues for patent-based filings—**E.D. Tex.**, **D. Del.**, and **W.D. Tex.**—make up nearly half of all such filings in the past decade, and an even larger percentage (~53%) since 2021.
- E.D. Tex.** has traditionally been one of the busiest districts and the pattern of filings largely tracks the that of filings nationwide, including the drop in filings from 2015 to 2019.
- D. Del.** filings have been fairly consistent over the past decade with steady decrease since 2021.
- W.D. Tex.** has shown significant increases in filing activity since Judge Albright took the bench in 2018, followed by a significant drop in filings after the District adopted a "spinning wheel" approach to assigning cases.



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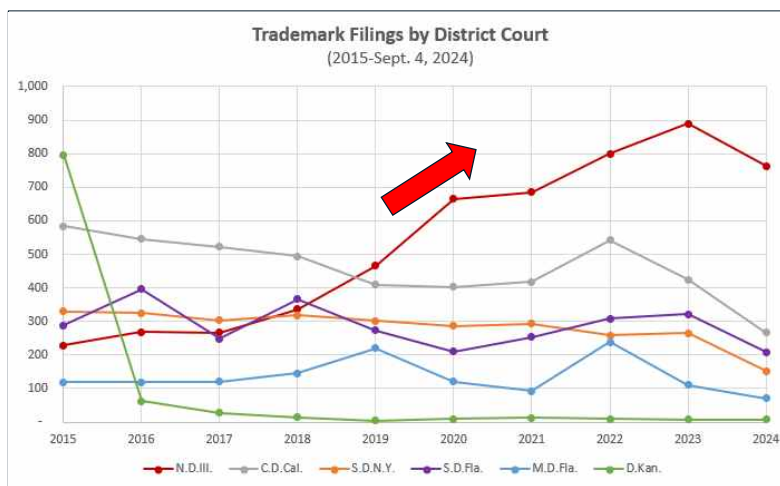
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Most Active Trademark Venues

- Trademark-based filings are more evenly spread across districts with the top three venues—**N.D. Ill.**, **C.D. Cal.**, and **S.D. Fla.**—making up over a third of all trademark filings in the past decade.

- C.D. Cal.** and **S.D. Fla.** have been fairly consistent over the years with fairly steady, but slight declines since 2015.
- N.D. Ill.** on the other hand has seen significant increases in filings since 2015.
 - The increases seen in N.D. Ill. are likely related to the significant increase in "Schedule A" complaints being filed there.



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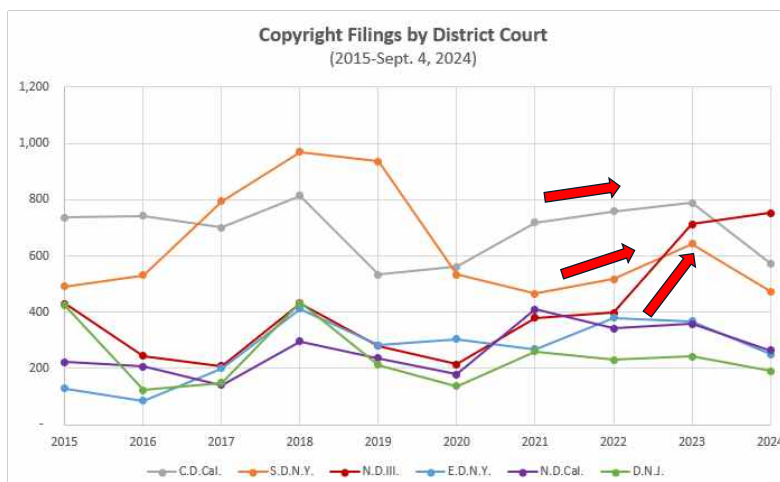
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Most Active Copyright Venues

- Copyright-based filings are more evenly spread across districts with the top three venues—**S.D. Cal.**, **S.D. N.Y.**, and **N.D. Ill.**—making up over a third of all copyright filings in the past decade.

- S.D. Cal.** and **S.D. N.Y.** have seen increases in filings since 2020 consistent with what has been seen nationally.
- N.D. Ill.** also is seeing larger increases in filings than others in the context of copyright infringement.
 - Again, the increases seen in N.D. Ill. are likely related to the significant increase in "Schedule A" complaints being filed there.



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“Schedule A” Litigations - Generally

Temporary Restraining Order

- “Schedule A” litigations are generally characterized as district court litigations that seek TROs against large numbers of hard-to-identify infringers in the same venue.



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IP Infringement

- “Schedule A” litigations can cover all types of IP infringement, including patent (design and utility), copyright, and trademark infringement.



Defendant Identities Hidden

- “Schedule A” litigations are so named because information regarding the defendants' identities is typically filed under seal in a “Schedule A” attached to the complaint.

CHANEL, INC.,
a New York corporation,

Plaintiff,

v.

DOES 1-172 d/b/a the aliases identified on
Schedule “A” and DOES 173-500,

Defendants.

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“Schedule A “ Litigations – N.D. Ill. v. The Internet

- The Northern District of Illinois has described the problem as follows:

websites. In case after case, over and over again, the plaintiffs' bar asks courts in this district to enjoin online counterfeit sales. After the entry of injunctions, new sellers inevitably pop up – the judicial equivalent of Whac-A-Mole, or maybe a hamster wheel – and plaintiffs then respond by filing new cases. At that point, the whole thing starts all over again, from square one. It has become the Northern District of Illinois vs. The Internet.

- BRABUS GmbH v. Individuals Identified on Schedule A Hereto, No. 120-cv-03720 (N.D.Ill. Oct. 3, 2022).

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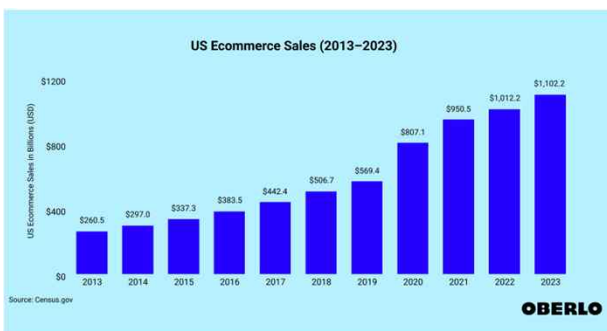
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“Schedule A” Litigation – The Rise of Ecommerce

- It is therefore no surprise that the rise in popularity of “Schedule A” litigations has tracked the rise in popularity of e-commerce platforms.



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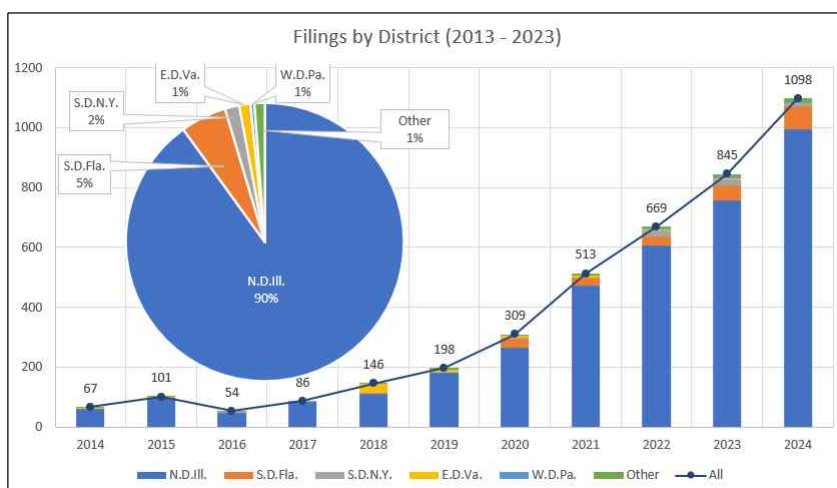
- <https://www.oberlo.com/statistics/us-ecommerce-sales> (citing Census.gov)

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“Schedule A” Litigation - Filings by District

- The Northern District of Illinois is by far the most popular district for filing “Schedule A” complaints.



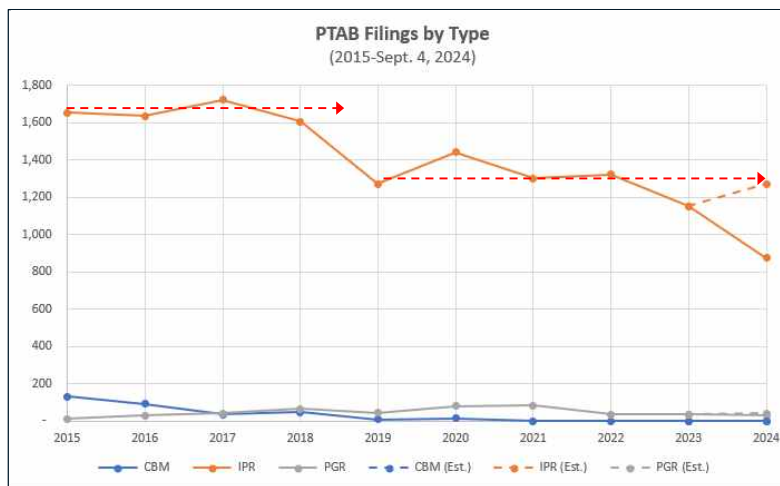
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PTAB Filing Trends

- Over the period from 2015 to through September 4, 2019, the number of PTAB petitions filed each year has remained relatively steady.
- IPR Filings were steady in the years leading up to 2019.
- After a drop in filings in 2019 that tracks the bottoming out of district court patent filings that same year, IPR filings have largely stabilized at this lower range with a slight dip in 2023.
- After 2018, CBM filings dropped below PGR filings and have remained there ever since.



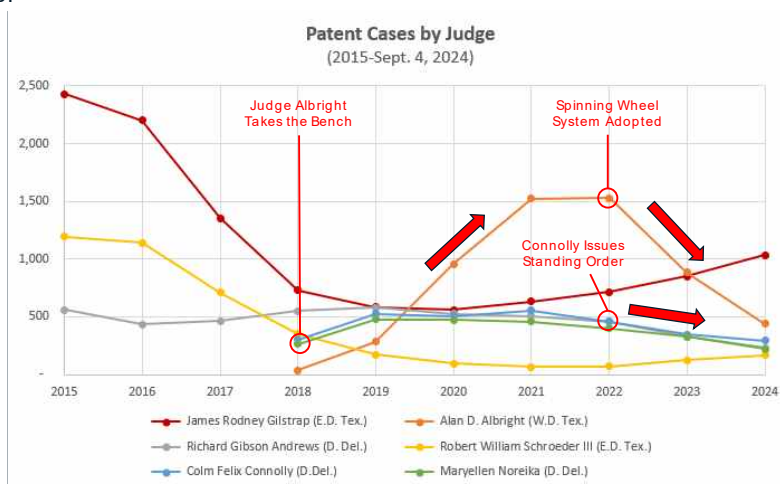
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Most Active Patent Judges

- Two of the three most active judges—Judge Albright (W.D. Tex.) and Judge Connolly (D. Del.)—took the bench in 2018, and one—Judge Albright (W.D. Tex.)—has already surpassed Judge Gilstrap (E.D. Tex.) as the most active patent judge.
- Judge Albright appears to have lost some traction after the Chief Judge of the Waco Division ordered in 2022 that patent cases be assigned to judges randomly.
 - This issues remains in flux based on the expectation that Judge Yeakel will retire from the Austin Division and Judge Albright will seek reassignment to Austin.
- Judge Connolly also may have deterred certain entities from filing complaints with his 2022 standing order requiring more fulsome corporate disclosure statements.



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Most Active Patent Judges – Judge Connolly

- Judge Connolly's (D. Del.) standing order requires the disclosure of every person or entity "with a direct or indirect interest" in the case, all the way up the chain of ownership.

STANDING ORDER REGARDING DISCLOSURE STATEMENTS
REQUIRED BY FEDERAL RULE OF CIVIL PROCEDURE 7.1

At Wilmington on this Eighteenth day of April in 2022, it is HEREBY
ORDERED in all cases assigned to Judge Connolly where a party is a
nongovernmental joint venture, limited liability corporation, partnership, or limited
liability partnership, that the party must include in its disclosure statement filed
pursuant to Federal Rule of Civil Procedure 7.1 the name of every owner, member,
and partner of the party, proceeding up the chain of ownership until the name of
every individual and corporation with a direct or indirect interest in the party has
been identified.

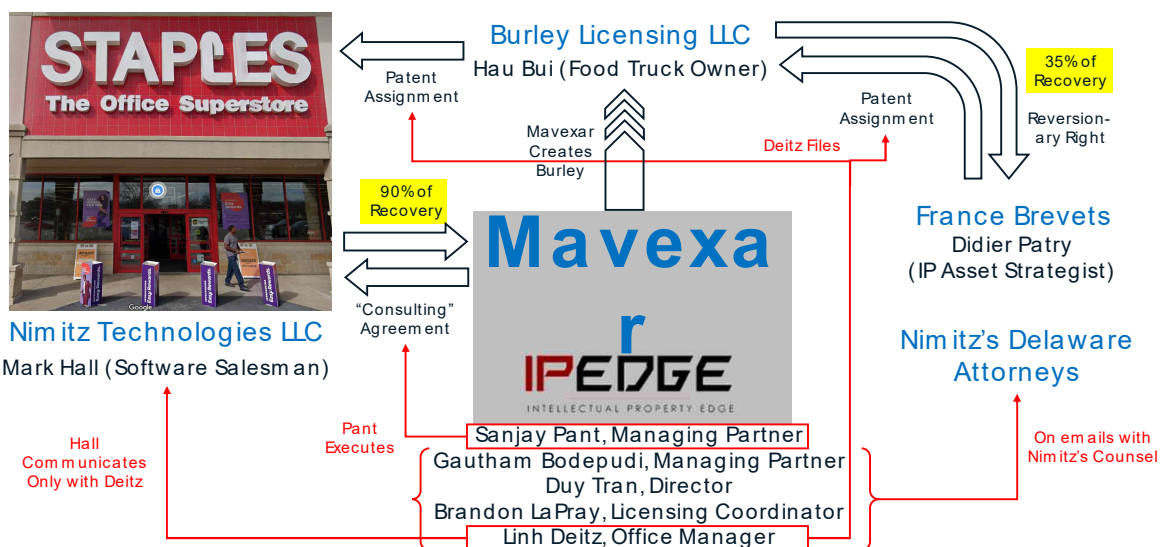
- <https://www.ded.uscourts.gov/sites/ded/files/Standing%20Order%20Regarding%20Disclosure%20Statements.pdf>.

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Nim itz Technologies LLC (11D. Del. Suits Filed)

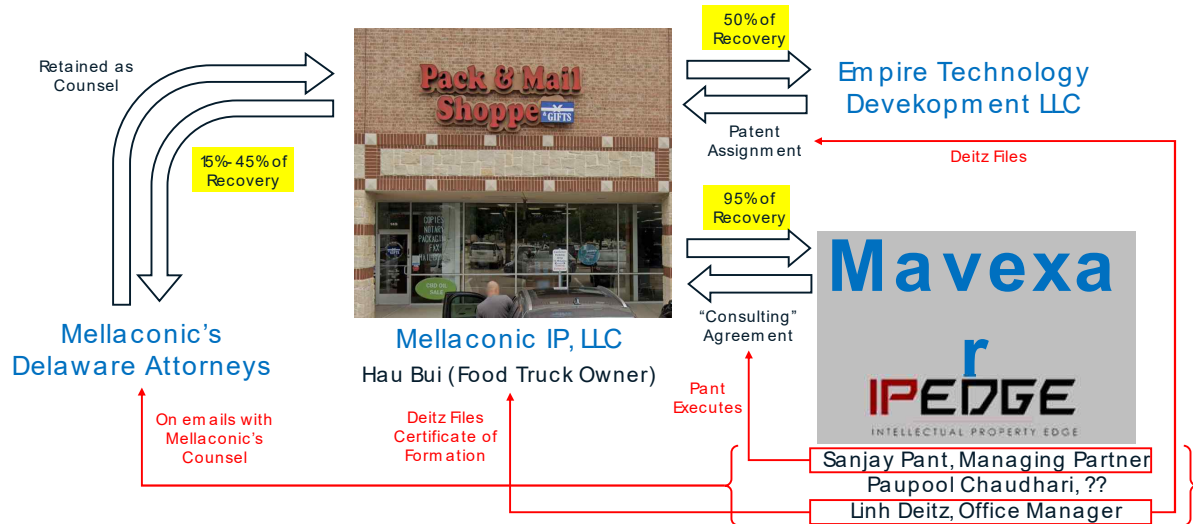


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Mellaconic IP, LLC (19 D. Del. Suits Filed)

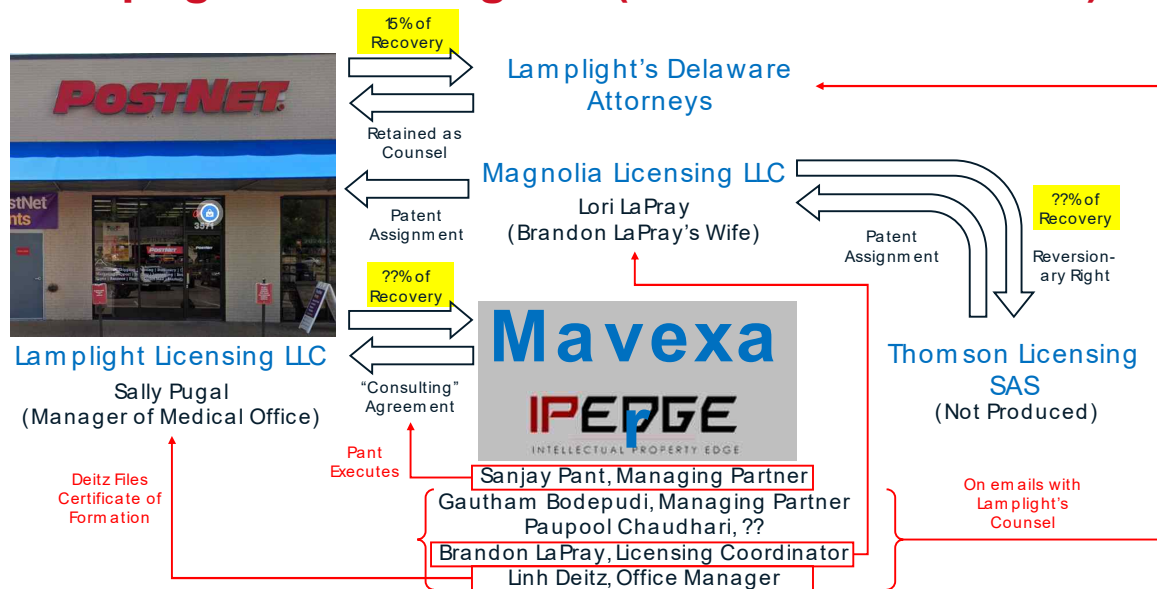


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Lamplight Licensing LLC (6 D. Del. Suits Filed)



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Most Active Patent Judges – Judge Connolly

- Judge Connolly's (D. Del.) referred all of the attorneys of record for the plaintiffs for ethics violations, for the unauthorized practice of law, and for criminal investigation.

I have decided to refer the attorneys of record for the plaintiffs in these cases to the disciplinary counsel of their respective bars. I have also determined it necessary to refer to the Texas Supreme Court's Unauthorized Practice of Law Committee certain attorneys associated with the patent monetization firm IP Edge LLC (IP Edge) and its affiliate Mavexar LLC (Mavexar) for the roles they played in connection with these cases. I have determined as well that a referral of these matters to the United States Department of Justice and the United States Patent & Trademark Office (PTO) for further inquiry is warranted. I explain in this

- *Nimitz Technologies LLC v. Bloomberg LP*, No. 122-cv-00413, D.I. 34 at ?? (D. Del. Nov. 27, 2023).

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Most Active Patent Firms and Attorneys

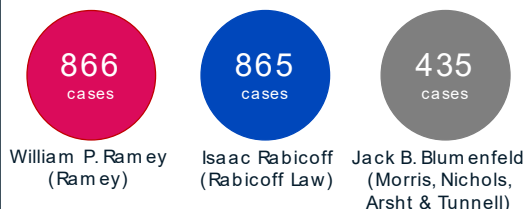
Most Active Plaintiff Firms by Cases (2022 – Sept. 4, 2024)



Most Active Defendant Firms by Cases (2022 – Sept. 4, 2024)



Most Active Plaintiff Attorneys by Cases (2022 – Sept. 4, 2024)



Most Active Defendant Attorneys by Cases (2022 – Sept. 4, 2024)



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Most Active Patent Firms and Attorneys - Ramey

- An order to show cause was recently issued against three Ramey attorneys, including Mr. Ramey himself, as to why they should not be referred to the State Bar of California, as well as the other bars of which they are members, for the unauthorized practice of law.

acting as Plaintiff's litigation counsel in this case. The information provided by Ms. Kalra at the hearing on August 22, 2024 makes clear that Mr. Ramey has engaged in, and continues to engage in, the bulk of legal activity in litigating this case. As noted, neither Mr. Ramey nor Mr. Kubiak are licensed to practice law in California. Neither individual has sought (much less been granted) *pro hac vice* status in this case. The docket shows plainly that there was no application for *pro*

It appears that Mr. Ramey sought *pro hac vice* admittance in only seven (7) of those fifty-three (53) cases (and as discussed he never filed a *pro hac vice* application in this Third Action or in the Second Action). See *WirelessWerx IP, LLC v. Lyft, Inc.*, No. 5:24-cv-01144-VKD

Mr. Kubiak appears to have sought *pro hac* admission in this Court only one time ever.

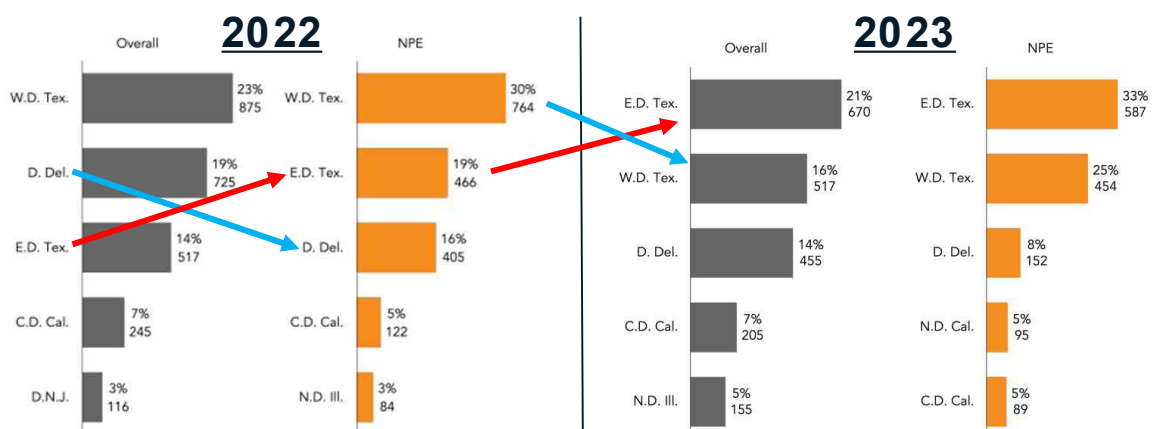
- *Koji IP, LLC v. Renesas Electronics America, Inc.*, No. 3:24-cv-03089, D.I. 27 at 4, 7 (Aug. 29, 2024).

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Top Districts for Non-Practicing Entities (NPEs)



- W.D. Tex. Was the most popular overall and for NPEs, with E.D. Tex. dropping overall, likely due to *TC Heartland*.

- *RPX – 2022 Q4 in Review (Jan. 2023)*.

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- E.D. Tex. continued its climb and is now the most popular district overall, and for NPEs, likely due to the case assignment changes in Waco.

- *RPX – 2023 Q4 in Review (Jan. 2024)*.

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Loper Bright Enterprises v. Raimondo

- On June 28, 2024, the Supreme Court reversed the long-standing “*Chevron* deference” standard, which held that a federal agency’s administrative interpretation of a statute should be given deference.

ITC

- Induced Infringement – The Commission’s reading of “articles that infringe” to include infringement occurring based on activities that occurred after importation is likely to be challenged.
- Domestic Industry – The Commission’s interpretation of what is needed to satisfy its “domestic industry” requirement is likely to be challenged (e.g., “sweat equity” vs. manufacturing).
- Contracts for Sale – The Commission’s reading of “sale for importation” to include contracts for sale also may be challenged.

PTAB

- Discretionary Denials – Director’s memorandum on discretionary denials is susceptible to challenge.
- Real Parties in Interest – Already pending before the Federal Circuit is a challenge to the PTAB’s obligation (or lack thereof) to scrutinize the accuracy of “real parties in interest” disclosures.
- Ultimately, Federal Courts still have discretion to give as much weight as they wish to administrative rulings and can easily adopt the reasoning of administrative rulings if they wish.

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SESSION II

Yoonhee Kim

**Finnegan, Henderson,
Farabow, Garrett & Dunner, LLP**

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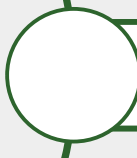



IP Litigation Practice: Discovery in U.S. Patent Litigation

Presented by
Yoonhee Kim

FINNEGAN

Agenda

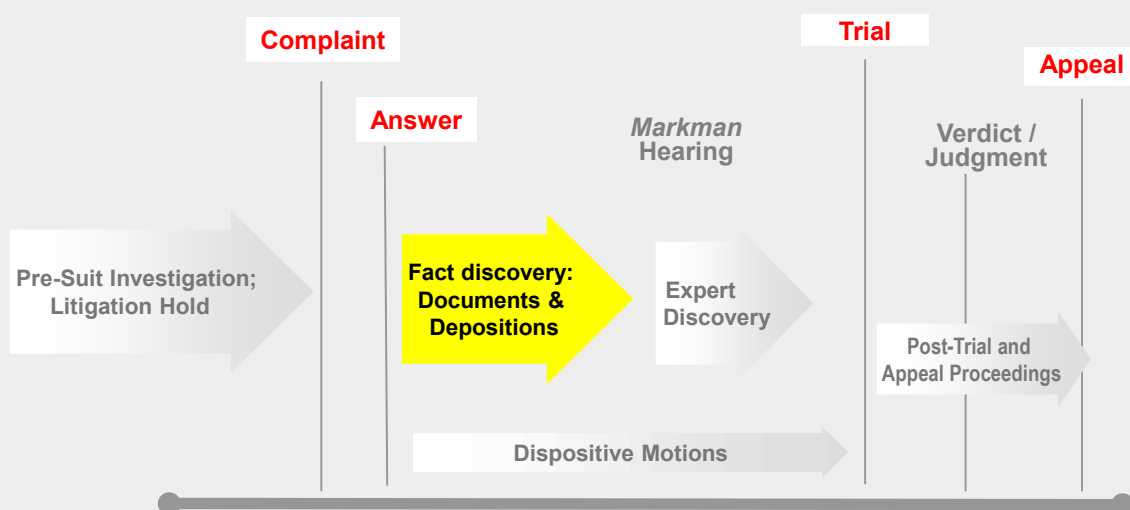
-  Typical timeline and process
-  Discovery in district court
-  Managing global IP litigation

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Typical Stages of U.S. Patent Litigation

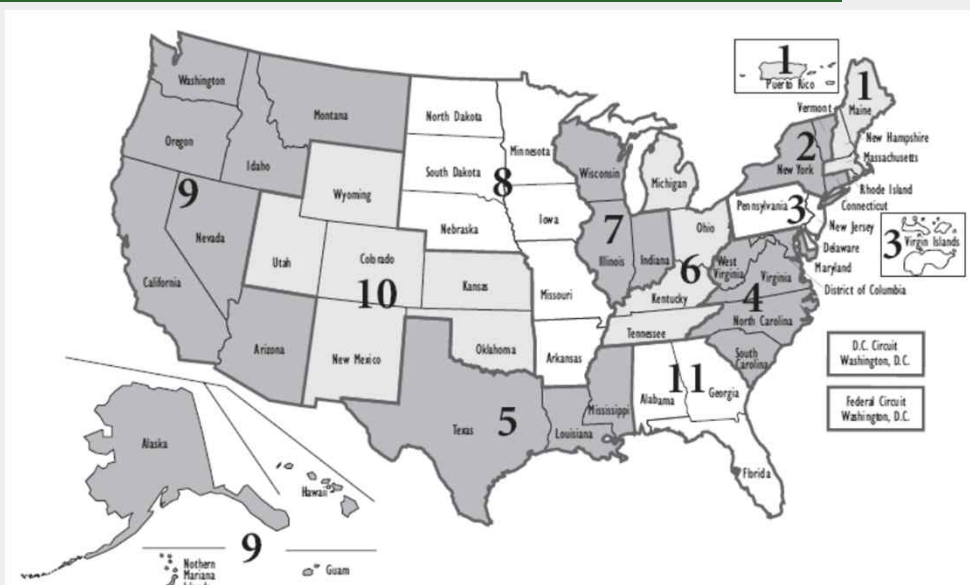


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Geographical Boundaries



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Litigation Timeline (2019-2024)






*Based on district averages
Source: Docket Navigator

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Agenda

-  Typical timeline and process
-  Discovery in district court
-  Managing global IP litigation

Governing Rules of IP Litigation

- **Federal Rules of Civil Procedure (FRCP)**
 - Applies to all civil proceedings in U.S. district courts
 - Governs procedural aspects of litigation, e.g.,
 - Service of process
 - Pleadings and motions
 - Scope of discovery and disclosures
- **Local Rules/Local Patent Rules**
 - Court-specific rules on procedures
- **Judge-Specific Rules**
 - Standing orders
- **Federal Rules of Evidence (FRE)**
 - Governs admissibility of evidence at trial

Fact Discovery

- **Purpose**
 - Uncover facts necessary for the parties to litigate the issues
 - Obtain evidence for use at trial
- **Broad scope**
 - “any **nonprivileged** matter that is **relevant** to any party’s claim or defense and **proportional** to the needs of the case” (FRCP 26(b))
- **Tools of discovery**
 - Initial disclosures
 - Document requests
 - Interrogatories
 - Depositions
 - Requests for admission
 - Subpoenas

Initial Disclosures

- FRCP 26(a)(1)
 - Parties must, without awaiting a discovery request, provide:
 - “the name and, if known, the address and telephone number of each individual likely to have discoverable information”
 - “a copy—or a description by category and location—of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses”
 - “a computation of each category of damages claimed by the disclosing party”

Document Requests

- FRCP 34
 - Parties must produce all discoverable documents in “possession, custody, or control”
 - Relevant information
 - Documents relating to:
 - Accused product/method
 - Patent prosecution
 - Research & development
 - Business plan & records

Interrogatories

- FRCP 33
 - Written questions to be answered in writing under oath
 - Inexpensive way to obtain information on who, when, where, etc.
 - Infringement information
 - Rationale supporting affirmative defenses

Information Typically Requested in a Patent Case

Document Requests:

- Invention
- Prosecution
- R&D
- Prior art
- Marketing/sales
- License/agreements
- Damages

Interrogatories:

- Date of invention
- Persons with knowledge
- Specific events
- Damages
- Contentions
 - Commit to positions
 - Factual basis

Requests for Admission

- FRCP 36
 - Request opposing party to admit the truth of any discoverable matter
 - Facts, application of law, opinions
 - Authenticity/genuineness of documents

Obligations for Documents: “Litigation Hold”

- U.S. courts apply a duty to preserve evidence when litigation is: **pending, imminent, or reasonably foreseeable**
 - Scope described in a litigation hold memo
 - Severe consequences for failure to preserve evidence
 - When in doubt, do not throw it out
 - Ask questions (call attorney) if you are not sure what documents or data to preserve or collect

What is a Document?

- Papers
 - Reports, lab notebooks, desk files, correspondence, notes, records of original data, file folder labels, etc.
- Electronic files
 - Word, Excel, PowerPoint, PDF, etc.
- Raw data files, databases, printouts, images
- Recordings (e.g., voicemails)
- Text messages, calendar entries, personal notes
- Emails – both electronic archives and hard-copy

Document Collection & Production

- All relevant documents requested by the opponent or helpful to the company need to be collected:
 - Reasonable search
 - Hard-copy materials are scanned
 - Electronic materials are copied
- Reviewed by attorneys
 - Responsive, relevant, not privileged
- Produced as they are kept “in the ordinary course of business”
- Duty to supplement

“But these are highly confidential company documents!”

- U.S. courts do not recognize “sensitivity” as a justification for not producing documents
- **Protective order**
 - Protect confidentiality of information/documents produced to the opponent
 - Control how confidential information is used
 - Who has access
 - Outside counsel, experts
 - In-house counsel? Employee witness?
 - Presentation in court filings or at trial
 - Disposition after conclusion of the case
- Enforced through the courts – violation of protective order may result in serious consequences



Exception to Production Obligations

Right to withhold certain information or documents during litigation
– FRCP 26(b)(1)

- **Attorney-Client Privilege:**
Confidential communications between attorney & client for legal services
- **Work Product Immunity:**
Confidential information prepared in anticipation of litigation

Protection of Privileged Communications

- Withheld from production or redacted

Meeting Minutes

Manufacturing Update: we made many widgets

Legal Update: [REDACTED]

Agenda for next meeting

Preserving Legal Privileges and Immunities

- Waiver of privilege
 - Privilege may be lost if document is distributed beyond those who “need to know”
- Protection may not extend to legal issues discussed without attorney
- Ordinary business matter may not be protected, even if attorney is copied

Example – Protected

From: Smith, John
 Sent: Friday, June 10, 2016 2:26 PM
 To: Florrick, Alicia
 Subject: Worried about patent
 Attachment: US 7,777,777.pdf

Alicia,

I just found this patent from MegaPlastic. I think it covers our StickyTack product! Do you think we will be sued? Can we show we created this first? Please provide your opinion on this patent and what we should do.

John

Attorney

Limited distribution

Request for legal advice

But Don't Do This!

From: Smith, John
 Sent: Friday, June 10, 2016 2:26 PM
 To: All-Employees@stickers.com;
bob@consultant.com
 Subject: Oh no!
 Attachment: US 7,777,777.pdf

Wide distribution

"Outsider?"

Look at this patent – it covers StickyTack!!!

John

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Depositions

- Sworn testimony recorded by a court reporter (often video-taped)
- Formal procedure but no judge present
- Deponents
 - Individual
 - Fact witness
 - Personal knowledge
 - Corporate Representative (30(b)(6))
 - Corporation designates witness
 - Binding on corporation

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Who Will Be There?

- Witness
- Attorney Defending Witness
- Interrogating Attorney(s)
- Court Reporter
- Videographer
- Interpreters
- 7 hours (typically) under oath



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Expert Discovery

- **Purpose**
 - Develop expert testimony for use at trial
 - Allow parties to assess strengths and weaknesses of their positions
- **Expert qualifications**
 - “must at least have ordinary skill in the art”
 - Definition of “a person of ordinary skill in the art” should align with the expert’s qualifications
- **Tools of expert discovery**
 - Expert reports
 - Expert depositions
 - Document production

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Experts

- **Credibility is key**
 - Identify experts with relevant expertise
 - Preparation – make sure the expert understands the legal process and is comfortable with providing testimony
 - It is “a process” before, during, and after expert discovery
- **Consider attack on opposing expert’s credibility**
 - Identify areas of insufficient expertise
 - Confront expert with contradictory testimony and publications

Agenda

- Typical timeline and process
- Discovery in district court
- Managing global IP litigation

Managing Global Litigation

- Parties increasingly compete in the global marketplace
- Disputes likely in numerous jurisdictions with different laws and procedures
 - e.g., U.S., Europe/UPC, Japan
- Requires careful coordination between counsel

Managing Global Litigation: Considerations

- Most important market?
 - That litigation team should usually run point
 - Often U.S.: credibility is important in U.S.
 - Arguments and evidence in foreign cases discoverable in the U.S. case
- Conflicting positions?
 - Remuneration
 - Differences in law/procedure
 - Characterization of prior art or your own patents

Your Presenter



Yoonhee Kim is a partner in our DC office

Yoonhee focuses on complex IP litigation before U.S. district courts and patent prosecution/client counseling in the chemical and pharmaceutical areas. Yoonhee has significant experience using his Korean and Japanese language skills in district court litigation.

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Questions?

Our Disclaimer

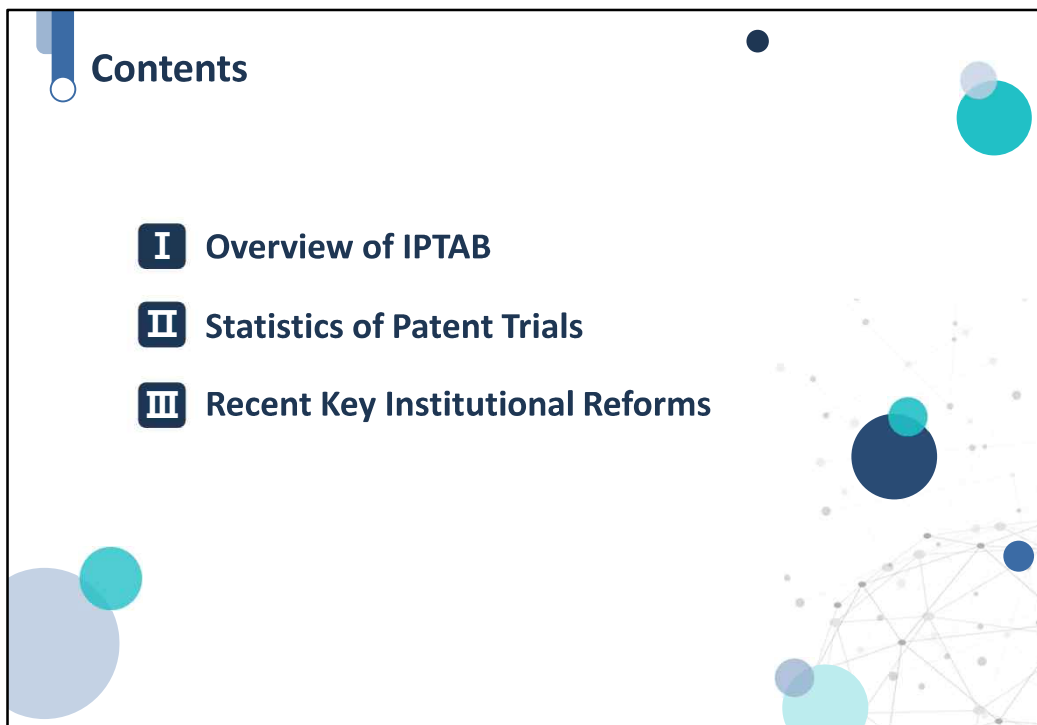
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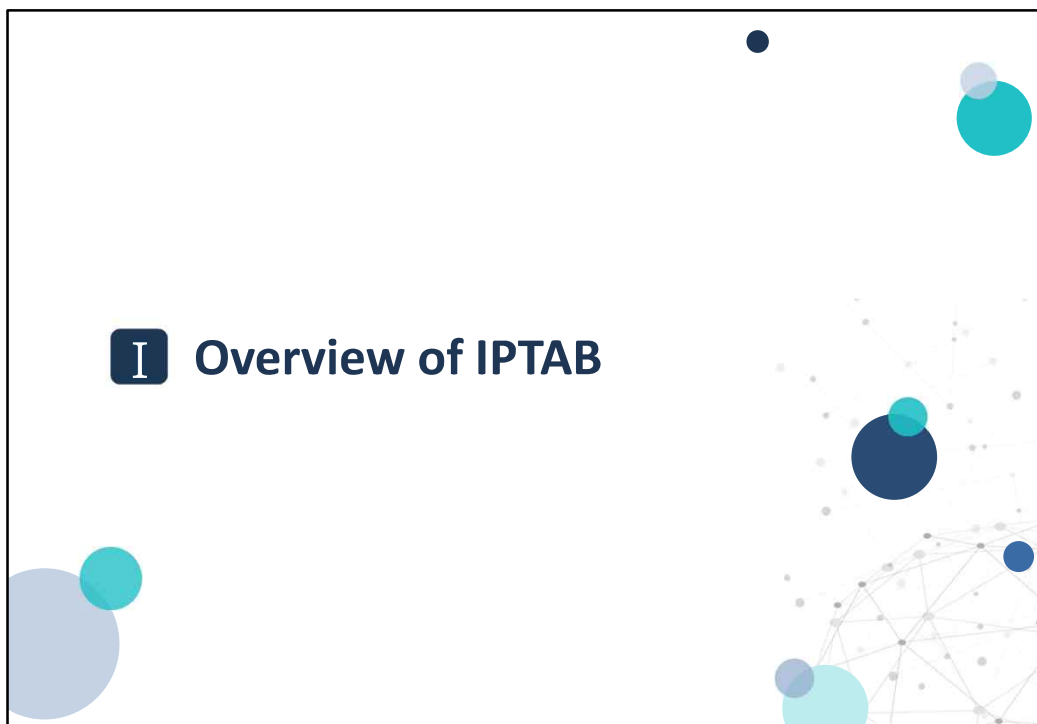
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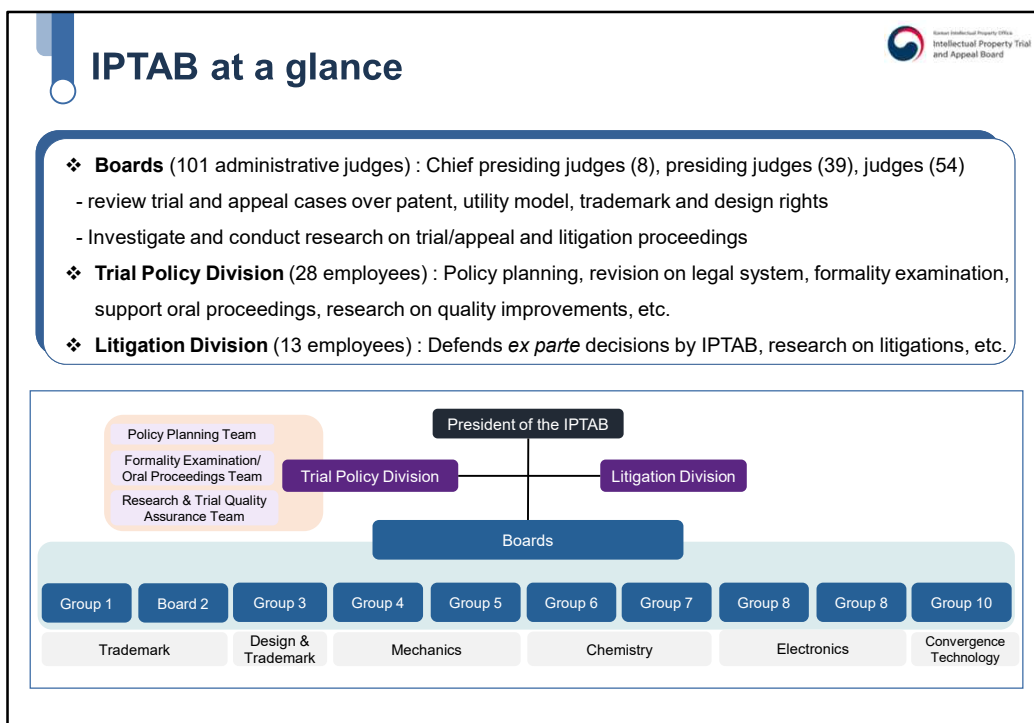
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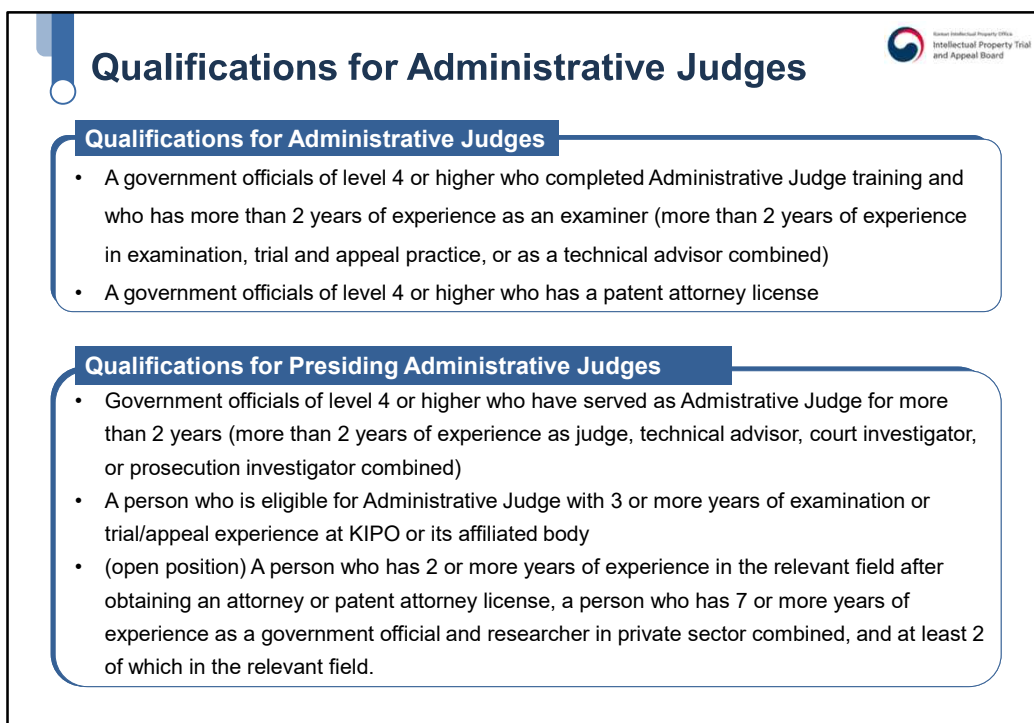
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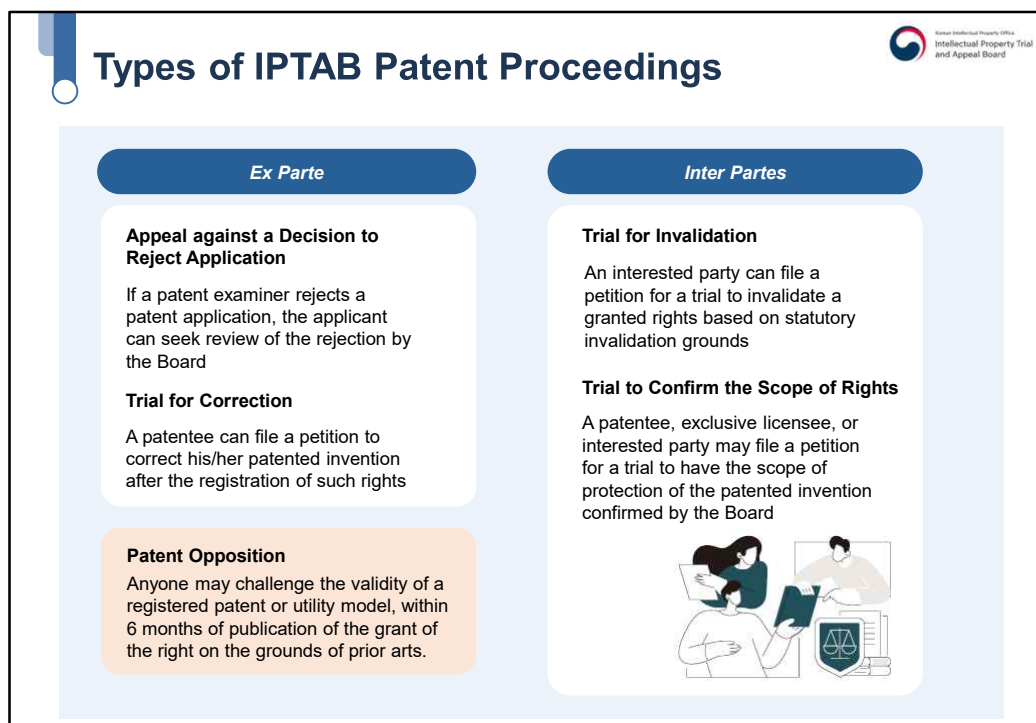
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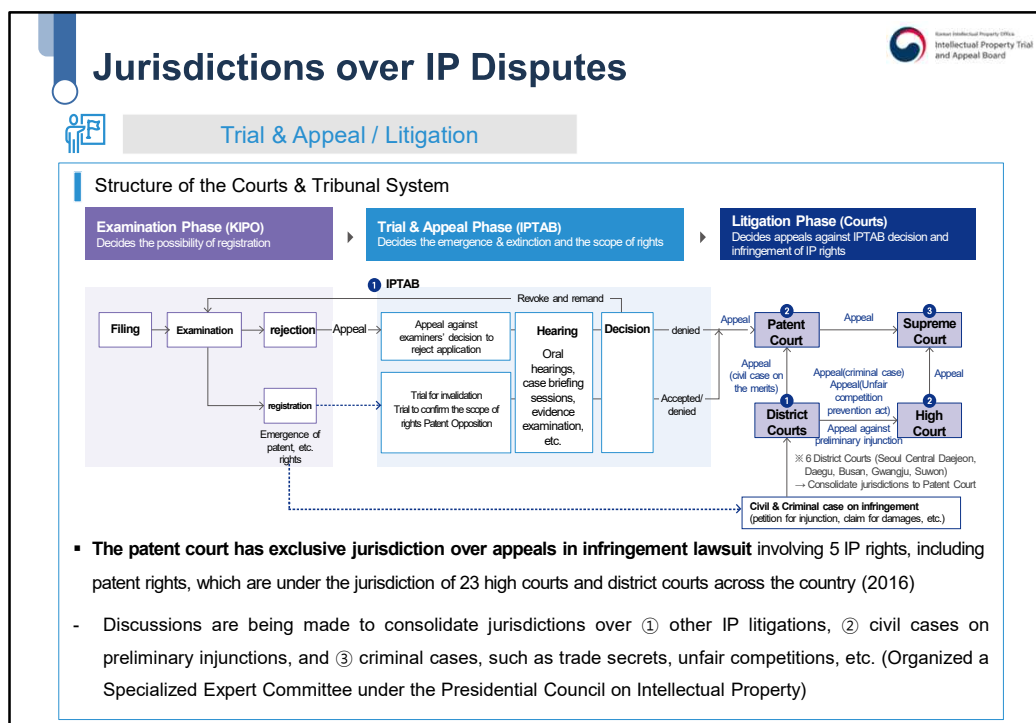
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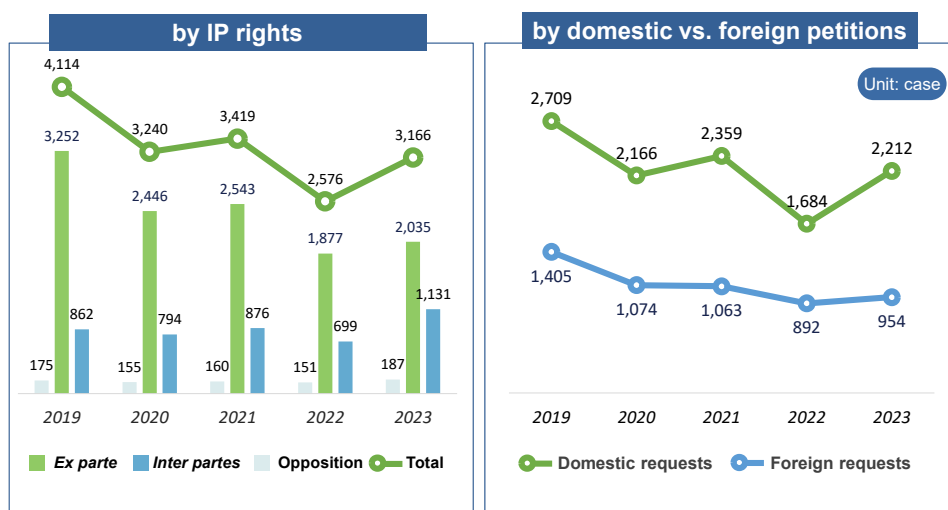
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II Statistics of Patent Trials

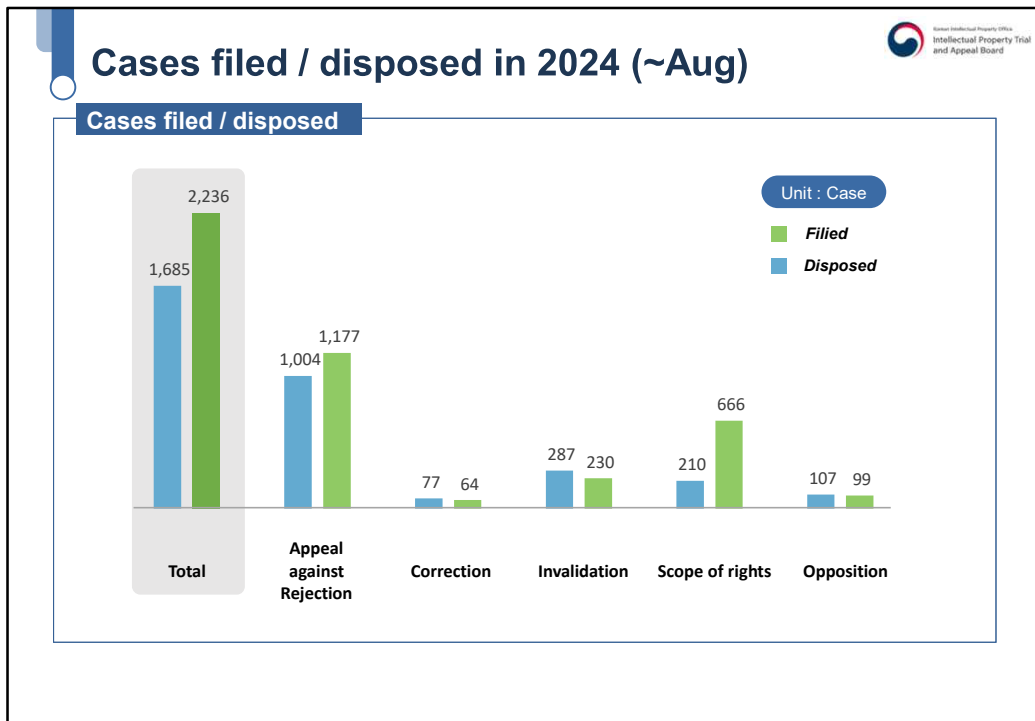
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Trends in Cases filed in the Past 5 Years

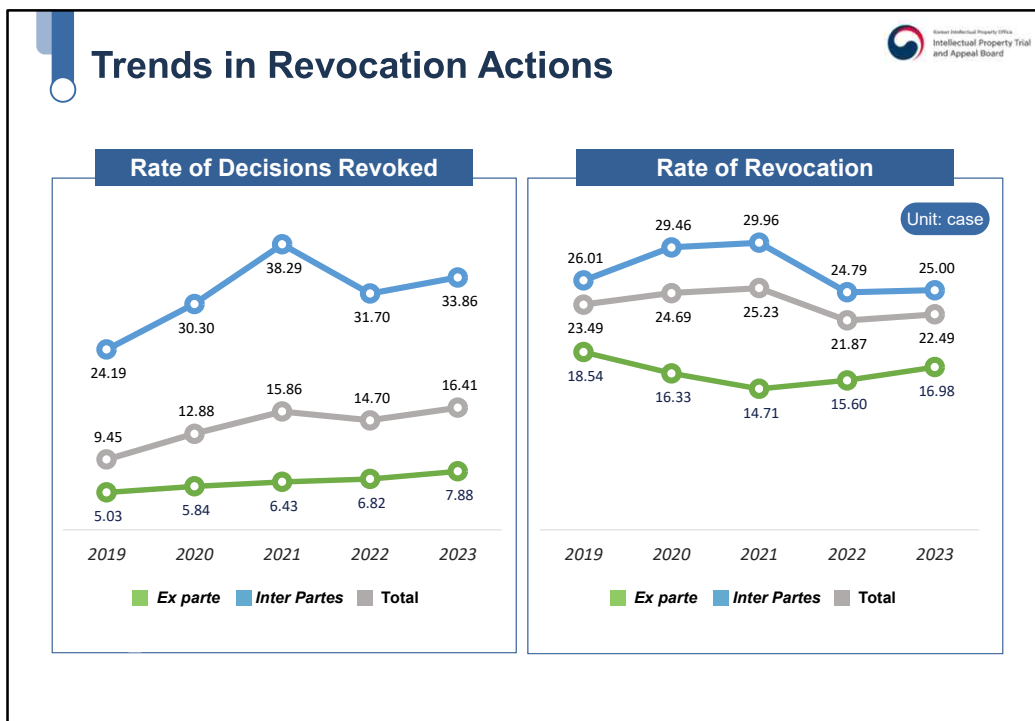
Korean Intellectual Property Office
Intellectual Property Trial
and Appeal Board



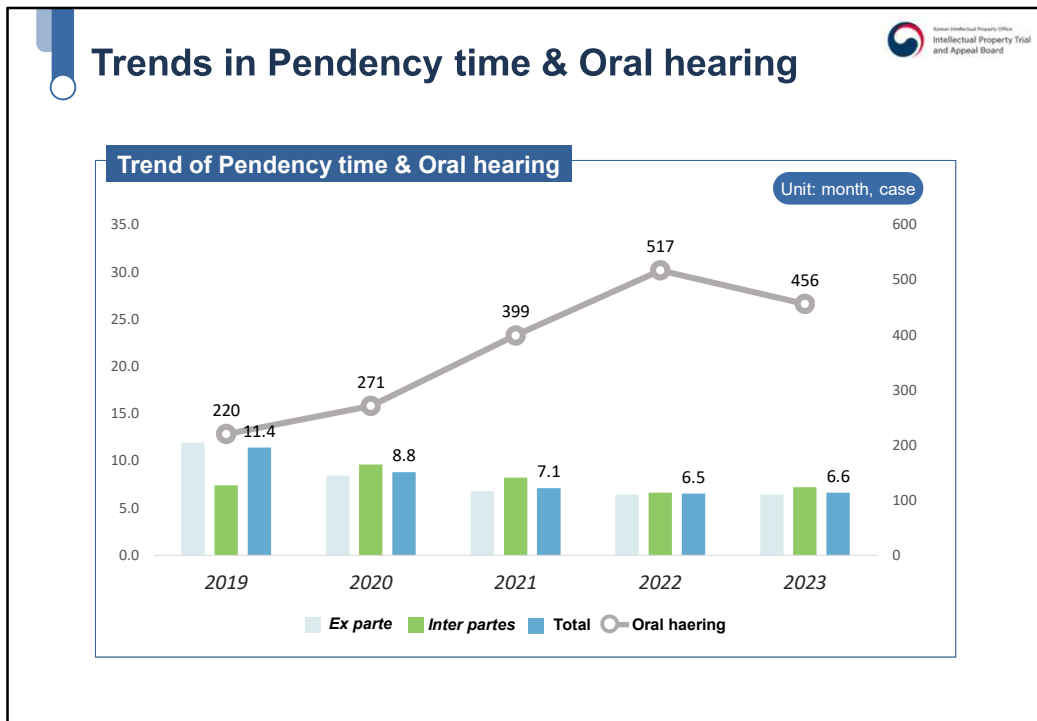
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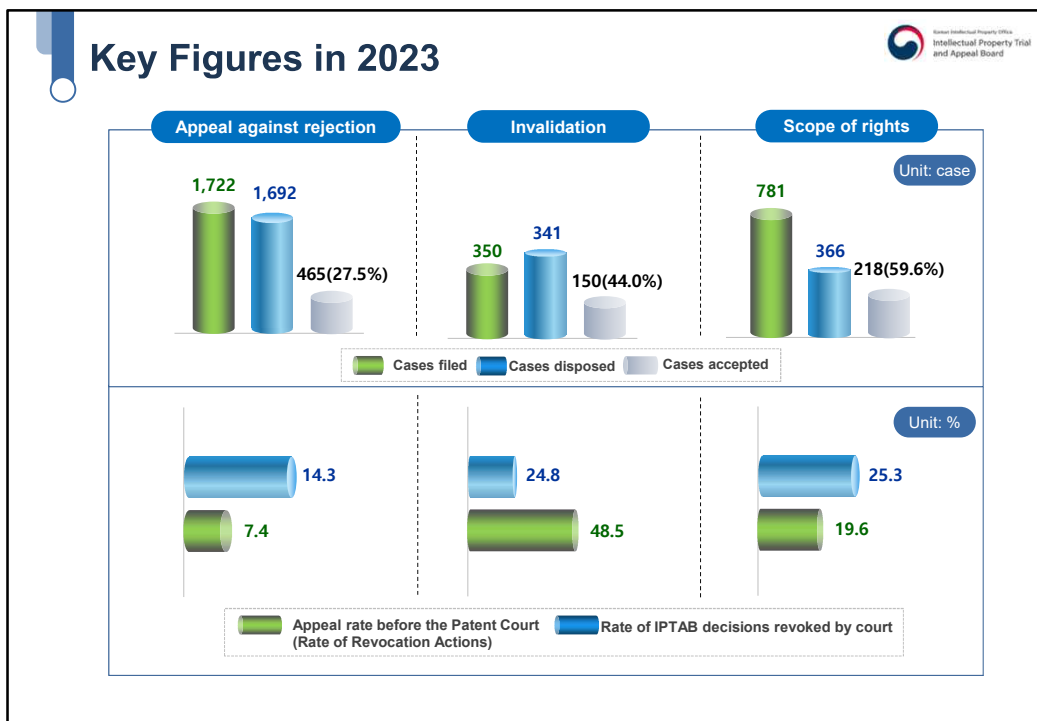
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III Recent Key Institutional Reforms

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1. Fair IPTAB Proceedings: Ensure More Opportunities to be Heard



Expand and Improve Oral Proceedings

Improve trial quality by expanding and improving oral hearings



[IPTAB hearing room where oral hearings are conducted]



[Video oral hearings]

Advantages and benefits of oral hearings

▪ [advantages]

Oral arguments made by the parties

Sufficient opportunities to state their opinions

Questions being asked by the panel

Ensure prompt dispute resolution
with points at issue identified at an early stage

Increase parties' acceptance of IPTAB decision

Allow panels to have better understandings of the case

▪ [benefits] Identify points at issue and make more accurate understandings of the genuine intentions of the parties with oral testimony, which allows early dispute resolution.

※ Patent Court's affirmance rate in IPTAB decisions in 2023 is 80.2% for cases in which oral hearings were held, higher than 72.5% for cases in which oral hearings were not held.

※ High customer satisfaction scores from the parties (patent attorneys) in oral hearings, 93.26 in the first and 93.84 in the second half of 2023.

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1. Fair IPTAB Proceedings: Ensure More Opportunities to be Heard



Relocation of the IPTAB to Separate Premises

Relocated the IPTAB to separate premises from the KIPO office to ensure fairness and independence of the IPTAB proceedings.

※ KIPO Office : Government Complex Daejeon Headquarter, IPTAB Office: Annex Building



Expanded its infrastructure with relocation

	Before	After
Grand Hearing Room	1	1
Hearing Room	3	4
Video Hearing Room (Seoul Office)	1	2
Case Briefing Room (Interview Room)	2	3
Conference Room (w/ VICO equipment)	-	1

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1. Fair IPTAB Proceedings: Ensure More Opportunities to be Heard



Amicus Curiae

- ✓ Enhance transparency, fairness and expertise in IPTAB decision-making by involving external experts in IPTAB proceedings

IPTAB-appointed attorneys

- **Technical & Legal** expertise
- Provide support for financially or socially underrepresented inventors

Technical Advisors

- **Technical** expertise
- Ensure reliability of IPTAB decisions

Amicus Curiae

- **Legal** expertise
- Open to industry and hear feedbacks from public

NOTE

Provide financial or social support

- IPTAB-appointed attorneys
- Fast-track proceedings in which SMEs are having IP disputes with large enterprises. Special Board designated for cases with far-reaching social impact, such as cases involving the theft of innovative technology from SMEs, etc.

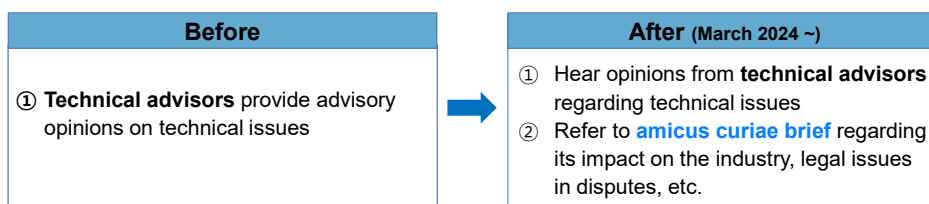
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1. Fair IPTAB Proceedings: Ensure More Opportunities to be Heard



Amicus Curiae

- ✓ Under the current law, there is no opportunity to hear 'public opinions' from the third parties during the IPTAB proceedings, such as public institutions, who are other than parties concerned or interested party
- Revisions in progress to be made to allow the presiding administrative judges to request public institutions, government or local government agencies to provide written opinions on trial/appeal case when deemed necessary for hearing the case.



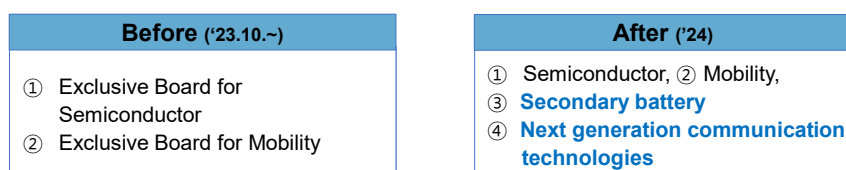
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2. Effective IPTAB Proceedings

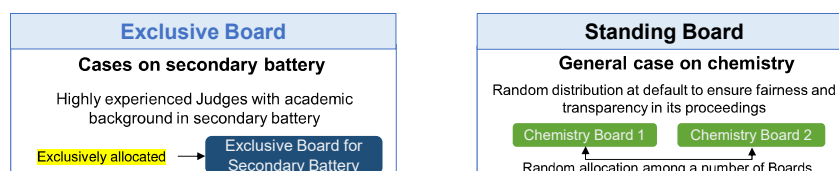


Expand Exclusive Boards on Emerging & Advanced Technologies

More Exclusive Boards for cases involving national critical technologies (2 → 4 Exclusive Boards)



- ✓ Exclusive Board consists of highly experienced administrative judges who have academic background in specific field and extensive years of experience in examination and trial/appeal. They exclusively hear and review cases involving emerging and advanced technologies.



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2. Effective IPTAB Proceedings: Digitalization



Overview of the AI-powered IPTAB IT System

Enhance work efficiency and user experience in IPTAB proceedings by introducing new IT technologies to achieve automatization and intelligence of IPTAB IT system

Trial & Appeal Environment

- Burden in the number of cases reviewed per each administrative judge
- Enhanced evidence examination (increased volume of prior art documents)
- Extensive and in-depth technical expertise required due to technological convergence and advancement
- Changes in trial/appeal related systems & regulations and the criteria for determination (case law perspective)
- Higher user expectations in customer service, including filing, submission, view and issuing of IPTAB documents, consultation, etc.

Advanced IT technology

- High-performance H/W (CPU, memory) and large capacity & high speed N/W
- Various & high-end user-friendly S/W (Web, function module) and advanced DBMS technology
- Rapid advancements in AI technology

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2. Efficient IPTAB Proceedings: Digitalization



3-Year Plan for Developing AI-powered IPTAB IT System

Automatic IPTAB formality examination and search for IPTAB/Court decisions with AI technology

1st phase (23)

More convenient e-filing system

- Auto-fill of form elements, automatic error detections, more flexible formats in uploading files, automatic conversion of documents to PDF format
- Online submission of (large file) video files as exhibits
- Improvements in the electronic service of (large volume) documents

2nd phase (24)

AI-powered automatic formality check


- Automatic extraction of necessary information from submitted image files
- AI-based learning and application of rules targeted for each type of forms for automatic formality examination
- Automatic masking of sensitive data (personal information) when inspecting or photocopying IPTAB documents

3rd phase (23~25)


Enhance AI-powered trial support system

- Automatic error detection of IPTAB decisions and auto-fill of IPTAB documents
- AI-powered search service in IPTAB/Court decisions and automatic recommendations of similar cases based on key issues
- More advanced video-conferencing system, high-speed e-filing system, closer links with external agencies

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Korean Intellectual Property Office
Intellectual Property Trial
and Appeal Board

3. Efficient IP Administration to Enhance User Experience


Advance Notice of Date of IPTAB Decision (July, 2023)

- ☒ There existed an inconvenience for parties who had to continuously check the trial status and results because it was not available to know the exact date in advance in which the IPTAB decision will be made.


↓

- ☒ When notifying the case to be closed, IPTAB will also notify the date when the trial/appeal decision is approximately to be made (**expected date of decision**), and arrange the proceedings accordingly so that the decision can be rendered as scheduled.


Before	The hearing for the above case was concluded on 20 . . . and therefore, hereby shall be notified in accordance with the provisions of Article 162(3) of the Patent Act.
After	1. The hearing for the above case was concluded on 20 . . . 2. Please note that the trial/appeal decision for the above case is expected to be rendered on 20 . . . If the scheduled date for the trial/appeal decision is to be changed, the 'Notification for Changes in Date of Trial/Appeal Decision' will be served accordingly.

- ☒ Launched in 1 July, 2023, and expected to be applied immediately to cases whose date of decision is expected to be after the effective date.

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Korean Intellectual Property Office
Intellectual Property Trial
and Appeal Board

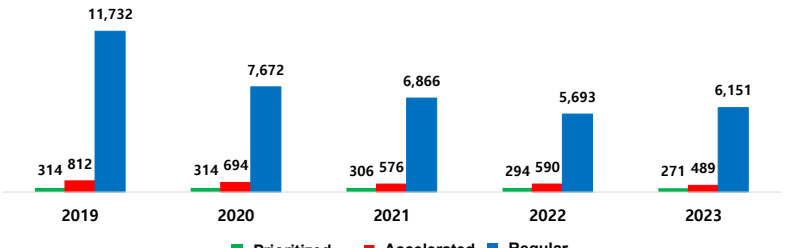
3. Efficient IP Administration to Enhance User Experience


Revisions made in IPTAB Fast-track Proceedings (July, 2023)

- ☒ Modifications made to Fast-track program regarding cases requiring urgent review
- ☒ Similar cases will be combined and removed to improve convenience
- ☒ Cases considered relatively less urgent will no longer be handled under the fast-track

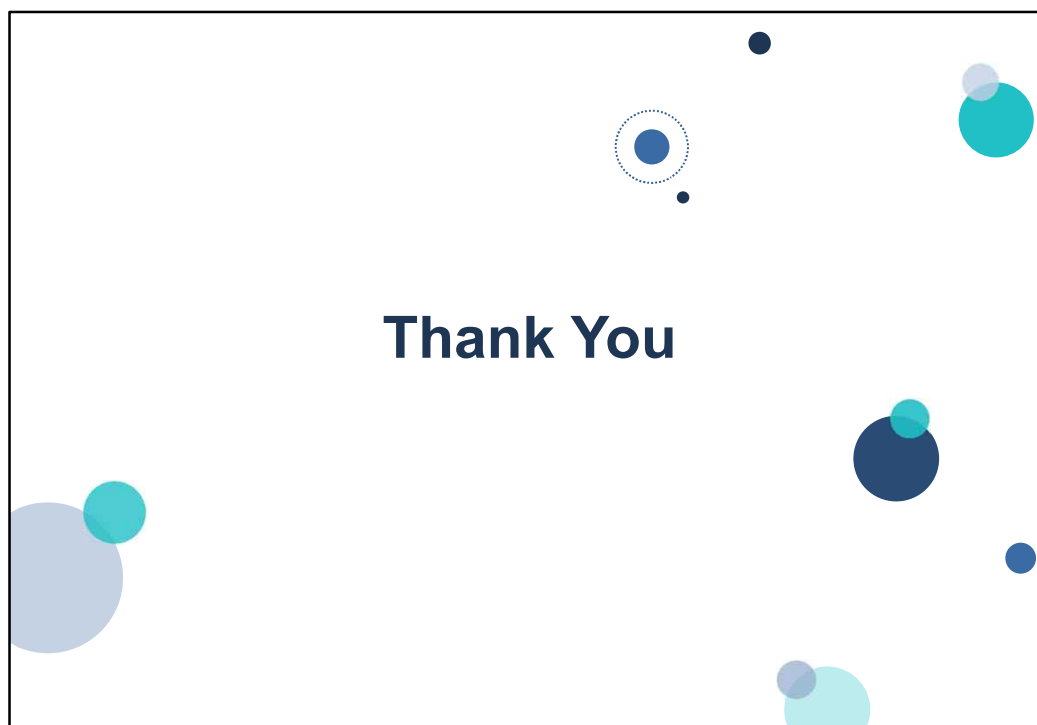
→ This is to prevent excessive delays in regular-track proceedings

* (Before) 26 types (11 for prioritized, 15 for accelerated) → (After) 19 types (2 for prioritized, 17 for accelerated)



Year	Prioritized	Accelerated	Regular
2019	314	812	11,732
2020	314	694	7,672
2021	306	576	6,866
2022	294	590	5,693
2023	271	489	6,151

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 DR&AJU LLC

1 IP-related Litigation in Korea

3

 DR&AJU LLC

Profile | Shinjeong LEE



Ms. Shinjeong LEE is a partner at IP team of DR & AJU LLC.

Her practice is primarily focused on Intellectual Property, Corporate, General Civil Disputes, Healthcare & Environment, and International Arbitration/Litigation.

Ms. Lee is experienced in the intellectual property sector with her 16 years as an attorney.

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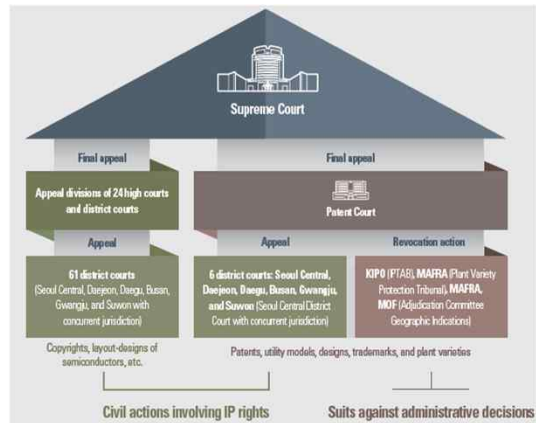
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IP-related Litigation in Korea

I. Two types of IP-related Litigation

1. **Suits against administrative decisions rendered by IPTAB**
2. **Civil actions relating to IP rights**
 - Civil actions relating to patent, design, and trademark rights
 - Civil actions based on the Copyright Act and the Unfair Competition Prevention and Trade Secret Protection Act



<Source : <https://patent.scourt.go.kr/main/new/Main.work>>

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IP-related Litigation in Korea

II. Characteristics of Litigation Procedure at Patent Court

- **Technical Examination in Patent Court**
: Judicial technical examiners, Judicial research officers, and Technical advisors
- **Evidence Collection System in Patent Infringement Lawsuit**
: Document submission order system under the Civil Procedure Act
Materials submission order system under the Patent Act
Obligation to present specific modes of conduct under the same Act
- **Electronic Case Filing System & Video Trials**

6

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DR&AJU LLC

IP-related Litigation in Korea

III. International IP disputes taking place in Korea

- International Divisions
- Plan for the Asian Union Intellectual Property Court (AUIPC)

5 Cases in which at least One Party is a Foreigner

Total for 2021: 117 Total for 2022: 103

Country	2021	2022
USA	32	42
China	12	42
Japan	7	1
South Korea	9	11
Germany	5	6
France	12	4
UK	12	4
India	23	16
Others	19	18

<Source: <https://patent.scourt.go.kr/main/new/Main.work>>

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DR&AJU LLC

Approaches for Cross-border E-discovery involving Korean companies

2

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DR & AJU

DR&AJU LLC

Profile | Hyunchul NOH



Mr. Hyunchul Noh is a partner at International Practice Team of DR & AJU LLC.

His practice is primarily focused on International Arbitration/Litigation, Intellectual Property, International Transaction, and Environmental, Social and Governance (ESG).

Mr. Noh is very actively engaged in various cross-border litigation and government investigation support work for domestic companies in assisting with the complex document review and discovery process.

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DR & AJU

DR&AJU LLC

Approaches for Cross-border E-discovery involving Korean companies

I. Background

- There has been an increase in trade secret misappropriation or patent infringement litigation in the U.S. between competing Korean companies.
- Why in the U.S.?
 - The Importance of the U.S. Market
 - Substantial Amount of Damages
 - Discovery Procedure

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Approaches for Cross-border E-discovery involving Korean companies

I. Background

- Patent infringement cases in the U.S. between Korean and foreign companies by company size.

(Unit: Cases)

Category	'19	'20	'21	'22	'23
Large Enterprises	66 (60.6%)	85 (87.6%)	107 (79.9%)	75 (72.8%)	73 (68.2%)
Filing a lawsuit	6	2	13	4	4
Being sued	60	83	94	71	69
SMEs	43 (39.4%)	11 (11.3%)	27 (20.1%)	28 (27.2%)	34 (31.8%)
Filing a lawsuit	36	3	14	13	19
Being sued	7	8	13	15	15
Univ., RI, Individuals	0 (0.0%)	1 (1.0%)	0 (0.0%)	0 (0.0%)	0 (0.0%)
Filing a lawsuit	-	-	-	-	-
Being sued	-	1	-	-	-
Total	109	97	134	103	107

<Source: 2023 IP Trend - Korean Intellectual Property Office>

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Approaches for Cross-border E-discovery involving Korean companies

II. Litigation Hold

- Extra caution must be exercised if the Korean company does not have in-house counsel.
- Timing and Scope of Litigation Hold
- Document Retention Policy

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Approaches for Cross-border E-discovery involving Korean companies

III. Collection and Review

- It is advisable to consider collecting data from key custodians' desktop or laptop computers, and data from servers (e.g. email servers, internal documents servers).
- Internal Reports: Hot documents are typically found in internal reports.
- Confidentiality, Privilege : Korean Legal Counsel or Patent Agent's Advice

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Approaches for Cross-border E-discovery involving Korean companies

IV. Production

- National Core Technologies
 - 13 technical fields (semiconductors, displays, electrical electronics, automobiles & railroads, steel, shipbuilding, nuclear power, information and communication, space, biotechnology, machinery, robotics and hydrogen), a total of 76 technologies.
 - Production of documents containing any of these technologies and/or transferring such documents to overseas servers for hosting and review could be considered as an export of National Core Technology under the Industrial Technology Protection Act.
 - Approval from or prior notification to the MOTIE may be required (Article 11 of Industrial Technology Protection Act).

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Approaches for Cross-border E-discovery involving Korean companies

V. Conclusion

- Due to the differences between the judicial systems of Korea and the U.S., as well as the unique features of Korean corporate culture, it is essential to manage the entire discovery process carefully.
- Especially, SMEs in Korea face the following challenges:
 - Difficulties in communication;
 - Lack of a legal team or in-house counsel; and
 - Limited experience with disputes in the U.S.
- It is advisable to consider the appointment of discovery counsel in Korea.

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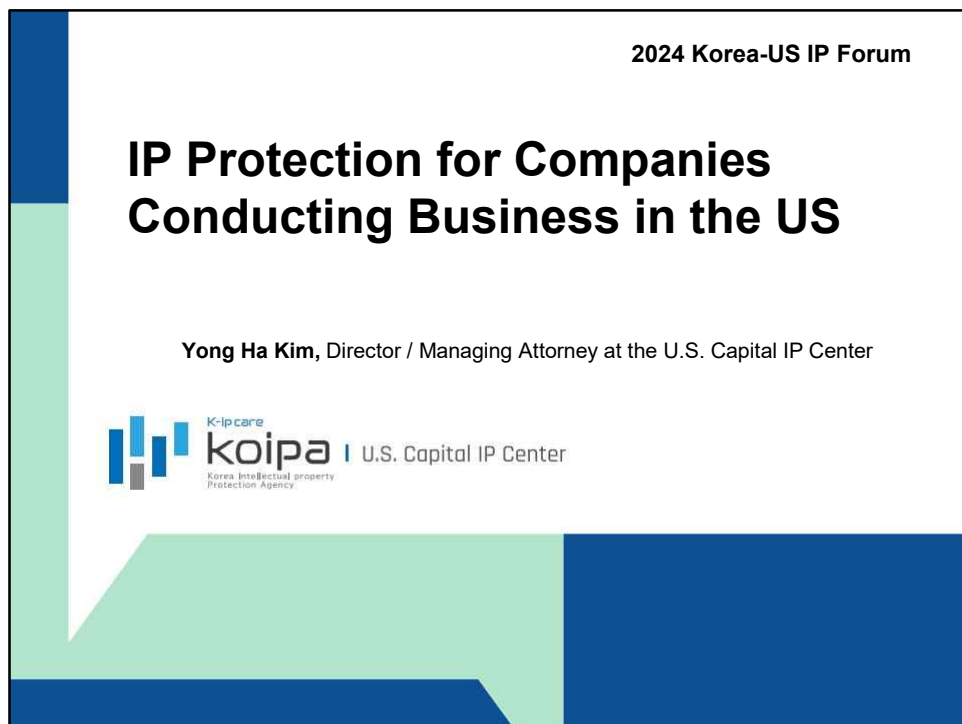
Thank You.

DR &
AJU
DR&AJU LLC

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해외지식재산센터 현황

현황 및 연락처

● 해외지식재산센터(IP센터) 8개국 10개소

● 해외지식재산센터 미설치 관할 32개국



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 * 각 부서의 유선전화는 한국지식재산정보원 홈페이지에 실음

Ten wide-area IP Centers are operational in 8 countries, covering 32 countries worldwide.

3



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4

U.S. Capital IP Center Services

1) Assistance with Intellectual Property Rights

- Providing assistance by phone, e-mail, drop-in or local visitation for concerns regarding acquisition and protection of U.S. IP rights
- Providing initial response guidelines for businesses that have been sued or received a court summons in the U.S

2) Information Services

- Providing information related to IP laws and holding seminars/instructional sessions concerning IP rights
- Collecting up-to-date information regarding current U.S. IP litigation trends to help prevent and avoid potential conflicts (Monthly Newsletters)
- Monitoring of national and international industries and related patent activity to identify and predict potentially problematic patents, and to provide early warnings for potential conflicts
- Creating a database of U.S. attorneys to be utilized by small businesses that may lack access to such information

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U.S. Capital IP Center Services

3) Subsidizing application fees and costs

- Eligibility Requirements:
 - 1) An individual, small or medium-sized company registered as a business in South Korea and
 - 2) Operating or planning to operate a business in the United States
- **Subsidies for Patent and Trademark Applications**
 - 1) Utility Patent – up to \$2,500/application
 - 2) Design Patent - up to \$1,500/application
 - 3) Trademark – up to \$700/application
 - 4) Small & Mid-sized company: 50% of attorney fees (up to total \$5,000, maximum of 10 cases per year per company)

6

U.S. Capital IP Center Services

3) Subsidizing application fees and costs

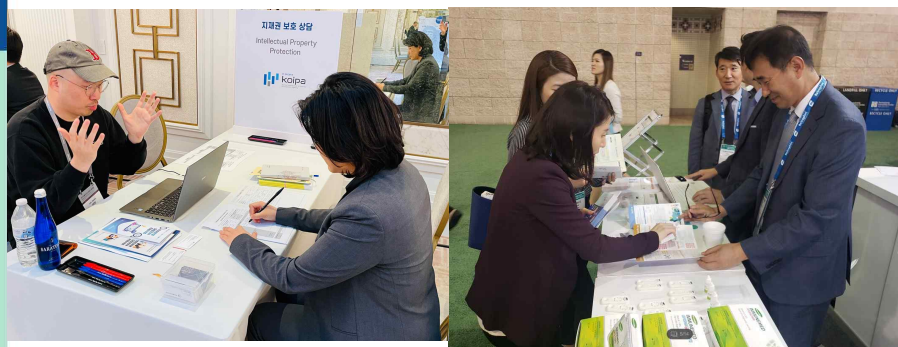
- Subsidies for Legal Opinion Letters

- 1) Preventing the risk of IP-related disputes arising from overseas exports:
 - ✓ Conducting patent infringement analysis (FTO)
 - ✓ Reviewing non-disclosure agreements (NDA)
- 2) Responding to legal disputes related to Intellectual Property (pre-litigation)
- 3) Subsidies - Small company: 70% of attorney fees, Mid-sized company: 50% of attorney fees (up to \$10,000 each case, maximum of 2 cases per year per company)

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U.S. Capital IP Center Services

1) Assistance with Intellectual Property Rights



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 Korea Intellectual Property Protection Agency

U.S. Capital IP Center Services

1) Assistance with Intellectual Property Rights




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 Korea Intellectual Property Protection Agency

U.S. Capital IP Center Services

2) Information Services




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Knowledge of Innovation, Power of Progress

U.S. Capital IP Center Services

2) Information Services




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Knowledge of Innovation, Power of Progress

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2) Information Services





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U.S. Capital IP Center Services


2) Information Services

View in Korean

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NEWSLETTER #2
JANUARY 31, 2024

View in Korean

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NEWSLETTER #3
FEBRUARY 26, 2024

View in Korean

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NEWSLETTER #13
APRIL 30, 2024

공개 후 95년이 지나 저작권이 만료된 오리 지널 마키 마우스 - '중기선 월리' ANALYSIS

— 1928년 제작한 '중기선 월리' 마키 마우스의 저작권이 최근 만료되었는데 이제 아무나 마음껏 쓸 수 있는 걸까?
— 저작권이 만료된 오리지널 마키 마우스의 '상표권'은 만료되었을까?

1928년 11월에 월트 디즈니가 처음으로 단편 영화 '중기선 월리' (Steamboat Willie)를 선보였을 때는 정말 화제가 되었다. 이 영화는 동기화된 음악과 애니메이션의 결합을 보여준 최초의 영화였으며, 세계적인 명작영화로 자리잡았다. '중기선 월리'를 통하여 마키와 미니 마우스는 전세계에 알려지게 되었다. 마키는 디즈니의 상징적인 캐릭터가 되었다. 마키마우스의 상정적인 권리 여러 유작은 디즈니 테마 파크 전체에 배치되어 있으며, 마키 캐릭터를 기반으로 한 마키마우스 클립은 시청자들에게 브러시 스프레이, 크리스마스 카드와 함께, 자스틴 팀버레이크, 라이언 레노 등 각 같은 인기 스타들을 처음으로 소개하기도 하였다.

디즈니의 '중기선 월리' 마키 마우스가 최근 저작권이 만료되었다는 소식이 전해졌는데, 이제 당 미국 동부 방면의 뉴스캐터에서는 우리 기업들이 상표권 등 다른 권리를 침해하지 않으면서도 '중기선 월리' 마키 마우스처럼 제작권을 얻고 다른 캐릭터를 어떠한 방식으로 활용할 수 있는지 알아보도록 하였다.

1
Mickey Mouse is Now in the Public Domain After 95 Years of Disney Copyright.
<https://time.com/551496/mickey-mouse-public-domain-steamboat-willie/>

2023년 영업 비밀 주요 사건들 ANALYSIS

— 2023년 영업비밀 주요 사건들을 통하여 살펴보는 영업비밀 최신 동향
— 회사의 소중한 정보를 영업비밀로서 보호하기 위해서는 비밀 관리 조치 취해야

기업의 영업비밀은 외부로 유출될 경우 매우 큰 경제적 피해를 입히기도 하는데, 회사의 핵심 인력과 경쟁사로 이직하는 과정에서 영업비밀이 유출되는 사례가 심심치 않게 있어 기업 경영에 꼭 알고 있어야 할 중요한 지식재산이었던 국제적인 사례를 통하여 살펴보면서 어떻게 관리되고 보호해야 하는지 보호할 때가 많다. 이번 달 미국 동부 IP 센터 뉴스캐터에서는 2023년에 화제가 되었던 미국의 영업비밀 주요 판례들을 만수케코의 영업비밀이 전 세계에서 어떻게 보호되어야 하고, 어떠한 경우에 분쟁까지 만지게 되었고 어떠한 결론이 도출되었는지를 살펴보고자 한다.

2023년 연방거래위원회(Federal Trade Commission, 이하 FTC)가 고용주와 근로자(직원, 독립 계약자, 인건 등을 포함하는 넓은 의미로 정의) 간의 계약 금액 제약을 금지하는 규칙을 제정하면서 시선집중을 받았다. 제정된 규칙이 제정되면 향후 체결되는 계약 금액 계약과 기존 계약 금액 계약이 모두 금지된다. 현재로서는 FTC가 언제 최종 규칙을 발표할지 알 수 없다.

2023년에 미국을 모객하는 규칙을 제정했던 기관은 FTC뿐만이 아니었다. 2023년 9월 1일 콜로라도주 주지사는 상원 법안 제699호에 서명하여 같은 내용의 법 조항인 제16600.5호를 신설하고, 기존 제16600.8호의 계약 금액 계약을 타주에서 체결한 계약까지 명시적으로 확대했다. 2024년 1월 1일부터 시행된 제16600.5호는 '제16600.8호에 따라 무효인 계약은 계약 체결 장소와 시기에 관계없이 효력을 발휘할 수 없다'고 명시하고 있다. 이 계약마주 제16600.8호에 따라 무효

최근 미국 특허청의 인공지능 기반 도구 사용에 대한 실무 지침 발표 ANALYSIS


— 특허, 상표 출원 시 인공지능 사용은 가능하나, 인공지능 사용으로 인해 발생하는 다양한 의무들이 존재
— AI 사용시 사용 약관, 개인정보 보호 정책, 사이버 보안 정책을 숙지하여 해킹 출판 라이선스 규정 및 수출 규정 등 법규와 규칙 준수해야

[수필] 뉴스캐터 하단의 비록 저명 사업에 대한 안내에 오류가 있어 수정을 제언드립니다.

2023년 10월 버미는 대통령령의 인공지능(Artificial Intelligence, 이하 AI) 관련 행정 명령에 따라 2024년 4월 11일 미국 특허청(이하 USPTO)은 일반 관보에 "미국 특허청의 인공지능 기반 도구 사용에 대한 지침(Guidance on Use of Artificial Intelligence-Based Tools in Practice Before the United States Patent and Trademark Office)"을 발표하였다. 이 지침에서 USPTO는 "가장 USPTO에 규정이 규정하는 사용과 관련된 지침으로서 USPTO에 특허를 보호하고 있다고 명시"고 언급하였다. AI 도구를 이용하는 특허 전문가는 이 문서를 숙지해야 할 것이다.

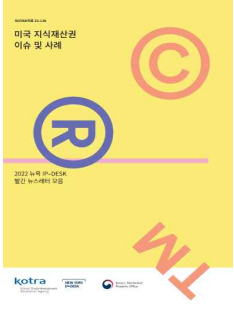
위의 지침은 USPTO에 제기된 다양한 인공지능 관련 문제와 관련하여 AI 서비스 사용에 대한 USPTO의 현재 입장에 대한 통찰력을 제공한다. USPTO는 AI의 이용을 인정하고 있으며, 현재 실무자가 사용 요건 도구로 사용하는지 여부를 결정할 의무는 없지만, AI 사용으로 인해 발생하는 다양한 의무가 있다. 이번 달 지식재산보원 미국 동부 IP센터 뉴스캐터에서는 인공지능에 대한 다양한 논의가 발전해가는 현 시점에서, 최근의 미국 특허청의 인공지능 기반 도구 사용

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U.S. Capital IP Center Services

2) Information Services



미국 지식재산권
이슈 및 사례

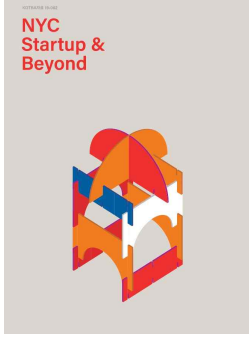
2022 뉴욕 IP-DESK
발간 뉴스캐터 부록

kotra




미국 지식재산법과
정책 최신 동향

2021



NYC
Startup &
Beyond

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U.S. Capital IP Center Services

3) Subsidizing Patent and Trademark Applications and Legal Opinion Letter Drafting

구분	주요내용	지원내용	지원비용
지식재산 권리 보호	현지에서의 지식재산 권리 보호를 위한 법률서비스 비용 일부 지원	해외기업과 계약 시 지재권 관련 조항 및 NDA 검토, 해외세관 지재권 등록 등	USD 5,000한도에서 (중소기업) 소요비용의 50%, (중견기업) 소요비용의 50% 지원
지재권 분쟁 초동대응	현지에서 발생한 지재권 분쟁 대응을 위한 비용 중 일부 지원	현지에서의 지재권 분쟁 시 경고·소송 대응 및 피해구제를 위한 법률의견서 작성 등	USD 10,000한도에서 (중소기업) 소요비용의 70%, (중견기업) 소요비용의 50% 지원
IP 침해·피침해 실태조사 및 행정단속	우리기업 지재권에 대한 침해·피침해 실태조사와 그에 따른 행정단속 추진 비용 중 일부 지원	지재권 침해·피침해 실태조사와 그에 따른 행정단속 추진	USD 10,000한도에서 (중소기업) 소요비용의 70%, (중견기업) 소요비용의 50% 지원
특허·상표·디자인권 출원지원	현지에서의 특허·상표·디자인권 출원에 필요한 비용 중 일부 지원	유사 선행 권리 검색, 출원명세서 검토, 출원 등 출원 전 과정	USD 5,000한도에서 (중소기업) 소요비용의 50%, (중견기업) 소요비용의 50% 지원*

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Intellectual Property Center of Korea

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- Facebook Page:
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2024 Korea-US IP Forum

CLOSING SESSION

Tae Hyun Lee

**President of the PCT Korea
Center (KIPRO)**

0



Korean Intellectual
Property Office

PCT Korea HELP-DESK

2024 Korea-US IP Forum

PCT Service of Korea

Oct 2024



KIPRO

Korea Institute of
Intellectual Property
Promotion

1

1-1. PCT Application Trend

- ✓ The number of published PCT applications has more than doubled in the last 20 years, rising from nearly 110,000 in 2003 to about 266,500 in 2023

Trend in published PCT applications, 2003-2023



Source: WIPO Statistics Database, March 2024.

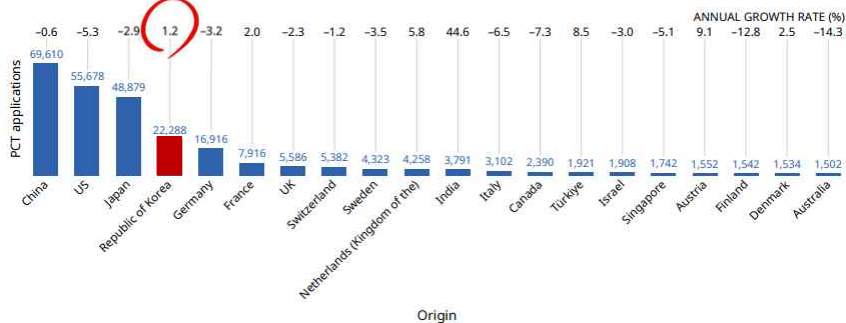
2

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1-2. PCT Applications by Country of Origin (2023)

- ✓ Among IP5 origins, Korea recorded the sharpest increase in PCT applications in 2023.

PCT applications for the top 20 origins, 2023



Source: WIPO Statistics Database, March 2024.

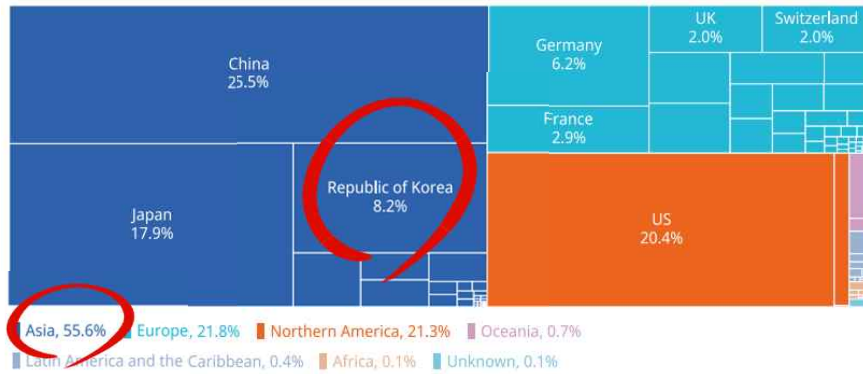
3

3

1-3. PCT Applications by Country of Origin (2023)

✓ PCT applications are highly concentrated in just a few origins.

Distribution of PCT applications by region and origin, 2023



Source: WIPO Statistics Database, March 2024.

4

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1-4. Major PCT Applicants (2003-2023)

Top 25 PCT applicants by technology sector, 2003-2023

Electrical engineering

Ranking	Applicant (origin)	Published PCT applications					2023 sector share (%)	Average annual growth rate from 2018 (%)
		2003	2008	2013	2018	2023		
1	HUAWEI TECHNOLOGIES CO., LTD. (China)	92	1,719	2,076	5,158	5,680	5.4	1.9
2	QUALCOMM INCORPORATED (US)	412	868	1,933	2,260	3,213	3.0	7.3
3	SAMSUNG ELECTRONICS CO., LTD. (Republic of Korea)	127	625	1,113	1,634	3,172	3.0	14.2
4	TELEFONAKTIEBOLAGET LM ERICSSON (PUBL) (Sweden)	439	961	1,438	1,596	1,802	1.7	2.5
5	ZTE CORPORATION (China)	2	328	2,269	1,980	1,656	1.6	-3.5
6	GUANGDONG OPPO MOBILE TELECOMMUNICATIONS CORP., LTD (China)			18	1,025	1,647	1.6	9.9
7	BOE TECHNOLOGY GROUP CO.,LTD (China)			163	1,153	1,618	1.5	7.0
8	VIVO MOBILE COMMUNICATION CO., LTD. (China)				178	1,574	1.5	54.6
9	BEIJING XIAOMI MOBILE SOFTWARE CO., LTD. (China)				224	1,547	1.5	47.1
10	CONTEMPORARY AMPEREX TECHNOLOGY CO., LTD (China)				85	1,505	1.4	77.9
11	LG ELECTRONICS INC. (Republic of Korea)	84	599	1,056	1,275	1,346	1.3	1.1
12	NIPPON TELEGRAPH AND TELEPHONE CORPORATION (Japan)	3	38	45	108	1,315	1.2	64.8
13	MICROSOFT TECHNOLOGY LICENSING, LLC (US)				1,343	1,238	1.2	-1.6
14	NEC CORPORATION (Japan)	138	719	1,045	726	1,171	1.1	10.0
15	LG ENERGY SOLUTION, LTD. (Republic of Korea)					1,097	1.0	n.a.
16	MITSUBISHI ELECTRIC CORPORATION (Japan)	203	258	696	1,328	1,004	1.0	-5.4
17	NTT DOCOMO, INC. (Japan)	60	223	319	443	990	0.9	17.4
18	SONY GROUP CORPORATION (Japan)	699	257	765	972	977	0.9	0.1
19	PANASONIC INTELLECTUAL PROPERTY MANAGEMENT CO., LTD. (Japan)				752	920	0.9	4.1
20	CHANGXIN MEMORY TECHNOLOGIES, INC. (China)				1	867	0.8	286.9
21	MURATA MANUFACTURING CO., LTD. (Japan)	14	198	422	733	842	0.8	2.8
22	INTERNATIONAL BUSINESS MACHINES CORPORATION (US)	245	626	637	201	784	0.7	31.2
23	GOOGLE INC. (US)		168	550	764	775	0.7	0.3
24	BEIJING ZITIAO NETWORK TECHNOLOGY CO., LTD. (China)					761	0.7	n.a.
25	APPLE INC. (US)	23	282	506	314	684	0.6	16.9

Source: WIPO Statistics Database, March 2024.

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2-1. PCT Service at KIPO

KIPO's Staff (2021)

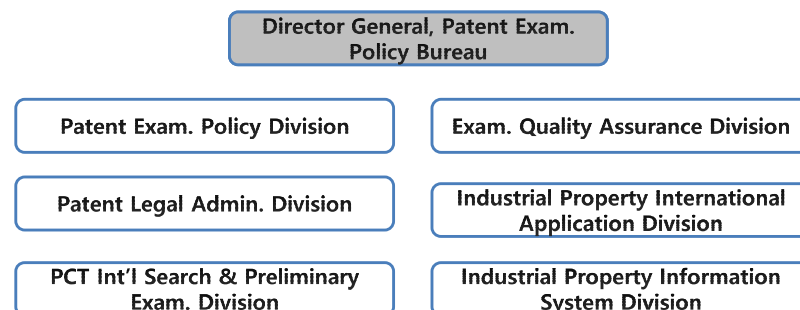


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2-2. PCT Service at KIPO

✓ *KIPO regards the examination quality as the most important goal.*

PCT Related Divisions

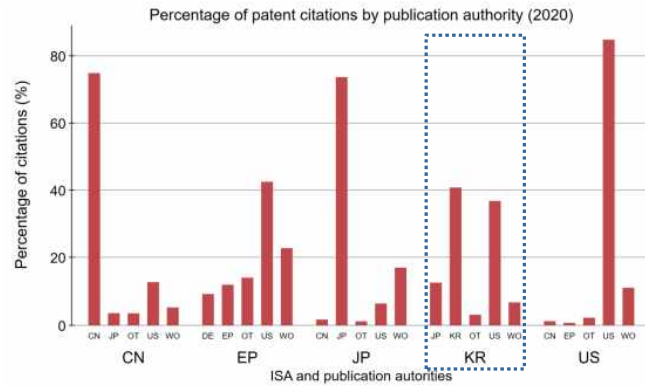


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2-3. PCT Service at KIPO

✓ KIPO cites literatures from various languages when establishing ISRs.

- Korean, English, Japanese, ...



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2-4. PCT Service at KIPO

PCT related fees

Competent ISA for US applicants	Search Fee (USD)*	Preliminary Examination Fee [Estimated USD* Fee]
USPTO	\$2,180	\$640 USD 640
EPO	\$1,875	\$1,999 EUR 1,840
IPOS (Singapore)	\$1,664	\$622 SGD 830
IP Australia	\$1,523	\$395 AUD 590
JPO	\$1,167	\$514 JPY 69,000
ILPO (Israel)	\$1,075	\$442 ILS 1,637
KIPO	\$924	\$375 KRW 450,000

Source : WIPO PCT Fee Tables, Sep 2024
* According to current exchange rates

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2-5. PCT Service at KIPO

KIPO as ISA



Countries that can select KIPO as an ISA

Philippines (2002), Vietnam (2002), Indonesia (2003), Mongolia (2004), Singapore (2004), New Zealand, **USA (2005)**, Malaysia (2006), Australia (2009), Sri Lanka (2009), Thailand (2009), Chile (2010), Peru (2012), Saudi Arabia (2015), Mexico (2016), Colombia (2017), UAE (2018), Brunei (2019), Cambodia (2020), Laos (2020)

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2-6. PCT Help-desk in the US

- Since 2009, The PCT Korea Center has been operating under KIPO for its US applicants.
 - ➔ **First and only foreign ISA to have a help-desk in the US.**
- PCT Korea Center's PCT Help Desk provides real-time assistance with the PCT process and inquires regarding PCT procedures with KIPO as an ISA/IPEA.

- **PCT Korea Center (IP Korea Center)**
- **Website:** www.pctkorea.com
- **Email:** pctkorea@pctkorea.com
- **Tel:** 703-388-1066
- **Fax:** 703-388-1084
- **8500 Leesburg Pike Suite 410**
Vienna, VA 22182



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Thank You !

PCT Korea HELP-DESK

