



Procedural Guidelines for Intellectual Property Litigation in the Seoul Central District Court

Amended, Jan 6, 2020

The Procedural Guidelines for Intellectual Property Litigation aim to provide guidances on proceedings of the specific chamber in the Seoul Central District Court, which exclusively handles intellectual property cases (hereinafter, "IP case") considering their unique characteristics. The following points are the guidances that the parties should follow in order to have the litigation procedures progress fairly, swiftly and economically.

I. Filing a Complaint

1. Entering the Case Name

- A. To prevent unnecessary procedural delays caused by erroneous case assignment, it must be clearly stated in the case name that it is an IP case.
- B. It is a requirement to clearly state the infringed intellectual property rights and the remedies sought by the party in the case name. Refer to the examples below. If the case involves multiple infringement claims or remedies, the filing plaintiff must put "etc." to represent subsequent claims and remedies.

[Example] Injunction Against Infringement of the Asserted Patent;
Injunction Against Infringement of the Asserted Design, Trademark, etc.;
Compensation for Infringement of Copyrights

2. Motion for pleading in a foreign language (“International Case”)

- A. The party of an IP case may file a motion to conduct oral proceedings in a foreign language under Article 62-2 of the Court Organization Act. For now, only English is permitted as a foreign language.
- B. The motion shall be granted if each of the below requirements are met:
 - Lawsuits provided for in Article 24 (2) and (3) of the Civil Procedure Act.
 - Lawsuits related to patent, utility model, design, trademark, and plant variety



protection, but

- excluding lawsuits concerning only copyrights or violations of the Unfair Competition Prevention and Trade Secret Protection Act (hereinafter, "Unfair Competition Prevention Act")
- Lawsuits wherein any of followings are true:
 - a party is a foreigner;
 - examination of major evidence needs to be carried out in a foreign language; or
 - there exist any other international relevances corresponding thereto.
- The pleadings in foreign language shall not significantly delay the proceedings.

C. Filing a motion for an International Case and obtaining consent from the other party must be done in writing before the first date of pleading in principle. However, the court, if substantially necessary, may grant the motion after the first date of pleading.

D. A moving party shall submit a "Motion for Pleading in a Foreign Language" (Attachment 1). The court will serve the other party a form of "Opinions on the Motion for Pleading in a Foreign Language" (Attachment 2) with the duplicate of moving party's written motion. No later than 2 weeks from the receipt of a "Opinions" form, the other party shall submit written opinions stating whether he/she consents to oral proceedings in a foreign language.

E. The proceedings of an International Case are as follows:

- The official court language, Korean, is not changed for the bench.
- The party is allowed to argue in the foreign language permitted by the court.
- The court shall provide a court interpreter at the court's expense for the statements made by the bench, parties, witnesses and others involved in the case.
- In principle, the court interpreter interprets simultaneously the permitted foreign language into Korean and vice versa. However, where it is necessary to facilitate the smooth proceeding of trial, consecutive interpretation may be used.
- If documents, such as briefs or documentary evidences, are prepared in the permitted foreign language, it is not required to attach translated versions. However, the court may order a party to submit the translated version if it is deemed necessary to facilitate the proceedings.
- The court shall write rulings or orders in Korean, and may send translated versions of them in the permitted foreign language to the parties.
- The decision shall be prepared and delivered in Korean. After the authentic copy of the decision is served to the parties, the translated version would be served thereafter.
- The parties may submit a petition of appeal in the permitted foreign language.



- F. Procedures and other matters necessary for trial of International Cases shall be prescribed by the "Regulations on the Establishment and Operation of the International judicial panel" (the Supreme Court Regulations).
- G. In an International Case, the court shall make a decision on the motion without delay and will actively use diverse means for the facilitation of procedural efficiency, such as video conferences for case management, designation a foreign expert as an Professional Examiner, examination of witnesses or appraisers through video or other transmission systems, etc.

3. Notice of the Relevant Cases

If any other cases relevant to the IP case are pending (such as trials before 「Intellectual Property Trial and Appeal Board」 or Patent Court, preliminary injunctions, other relevant civil cases, criminal cases in which the party is involved, etc.), the plaintiff must specify such case informations in the complaint with the relevant case number and the current status.

4. Video Conference for Case Management

- A. The court may discuss the procedural matters of the case with the parties through a video and audio communication means (hereinafter, "video conference for case management"). The presiding judge may designate a commissioned judge to be in charge of the above process.
- B. In a video conference for case management, the following matters may be discussed:
- Dates and times of pleading, and issues to be addressed in each date of pleading,
 - Deadlines for contention and evidence (including deadlines for submission of comprehensive briefs and an affidavit of expert witness, and the maximum number of submission and length of briefs);
 - Whether to move for evidentiary methods requiring a substantial amount of time, such as verification, appraisal, and expert witnesses, and deadlines for such requests;
 - Whether to designate a Professional Examiner;
 - Whether to hold a technical explanatory session by the parties;
 - Whether to hold hearings separately by legal issues such as infringement, invalidity, assessment of damages, etc.;
 - How to proceed the litigation procedures if the case is pending before 「Intellectual Property Trial and Appeal Board」;
 - Whether to refer the case to a mediation procedure;
 - Confirmation and summary of disputed issues.



II. Contention of Infringement

1. Clear Gist of the Claim and Attachments

- A. An unclear gist of the claim and the attachments may cause litigation delay or dismissal, or significant waste of time and money even if the plaintiff wins the case as an execution of the judgment isn't possible. With this in mind, the plaintiff must clearly specify the object of the prohibition in detail to ensure that the enforcement is possible without a separate legal determination.
- It is not permitted to use general expressions, such as "The plaintiff's patent shall not be infringed upon" or "The plaintiff's trademark shall not be used" because these do not carry any specific meanings. It is also prohibited to reiterate the same contents of the plaintiff's rights in the attachments.
 - It is recommended not to use phrases requiring a separate legal determination such as "fall(s) within the scope of the plaintiff's patent right", or "identical or similar to the plaintiff's trademark(design)", etc.
 - Unclear terms such as "other", "etc.", "any and all", and "related" must not be used.
- B. In particular, if seeking a prohibition of the production, sale, or transfer, etc. of the defendant's product, the plaintiff must provide detailed information about the product produced and sold by the defendant such as the name, photographs, serial number or description etc. of the product.
- C. If it is difficult to adequately specify the object of the prohibition when filing a complaint, the plaintiff must provide reasonable ground of failing to do.

2. Specification of the Cause of Action

- A. The plaintiff shall clearly specify in the complaint the type of intellectual property which has allegedly been infringed upon. Depending upon the type of intellectual property, the details are as follows:
- Patent right (Utility model): clearly specify claims of alleged infringement, if the plaintiff's patent has multiple claims.
 - Trademark: give accurate information on designated products (designated service businesses) of alleged trademark.
 - Acts of unfair competition: clearly provide under where the act in question falls in article 2(1)(A) to (K) of the Unfair Competition Prevention Act.
 - Copyright: instead of stating "author's copyright has been infringed upon", specify the type of the author's property rights infringed upon (right of reproduction, public performance, public transmission, distribution or adaptation, etc.).



- B. In cases where injunctive relief is sought, the provisions of applicable laws for each intellectual property must be clarified (Article 126 of the Patent Act, Article 113 of the Design Protection Act, Article 107 of the Trademark Act, Article 4 of the Unfair Competition Prevention Act, and Article 123 of the Copyright Act, etc.).
- C. If the plaintiff claims for compensation for damages, the provisions of applicable laws must be clarified (Article 128 of the Patent Act, Article 109 of the Trademark Act, and Article 5 of the Unfair Competition Prevention Act, etc.). In particular, the governing law of each intellectual property type stipulates special provisions on the method of assessing the amount of damages, so the plaintiff must clearly stipulate the provisions of the applicable law.
- D. If the court finds that the infringement of patent(utility model) right or trade secrets was intentional, the court may increase the damages award up to 3 times the amount found or assessed [Article 128(8) of the Patent Act, Article 30 of the Utility Model Act, Article 14-2(6) of the Unfair Competition Prevention Act]. If the plaintiff seeks the application of the above provisions, such purpose must be made clear, provided that the act of first infringement of the right is found to occur on or after July 9, 2019.

3. Guidance for Infringement Contention

- A. The plaintiff must submit documentary evidences providing the details of the intellectual property right and the fact that the plaintiff is the holder of the intellectual property right.
- Intellectual property rights registered with the Korean Intellectual Property Office (patent, utility model, design, and trademark, etc.): The Gazette and Register must be attached without exception.
 - Trade secrets: trade secrets must be provided as specifically as possible to the extent of not losing their confidentiality while ensuring the court's ability to review effectively and the other party's ability to defend.
 - Copyright: documentary evidences must be submitted to demonstrate the fact that plaintiff is the author of the work or has taken over the right from the author.
- B. The plaintiff must clarify whether he/she is the sole owner, joint owner or exclusive licensee of the intellectual property rights in question.
- C. In the case of a patent (utility model) infringement, the plaintiff must clarify the contention as follows:
- Clarify as to whether the alleged patent is about an invention of a product, an



invention of process, or an invention of a process of manufacturing a product.

- Clarify the type of infringement (literal infringement, equivalent infringement, indirect infringement, etc.).
- Each component of the patent and the composition of the defendant's product responding thereto shall be prepared in detail by component through use of a comparison table, etc.

D. For an infringement of design, the identity or similarity of both designs must be compared in detail through use of a comparison table, etc.

III. Defendant's Response

1. A Clear Response to Infringement Contention

The defendant shall provide a detailed rebuttal as follows:

1) Questioning unclear gist of claim

- The gist of the claim or the contents of the attachments are unspecified or unclear.
- The products on the attachments are different from the products that the defendant produced.
- Other factors supporting dismissal

2) Disputing the protection of the plaintiff's intellectual property right

- The plaintiff is not the owner of the intellectual property rights (or the person with the right to file an injunction).
- The mark indicating plaintiff's goods is not well known.
- The plaintiff's trade secrets do not satisfy the requirements of the Unfair Competition Prevention Act.
- The plaintiff's work lacks creativity to be protected by the Copyright Act.
- Other factors supporting dismissal

3) Denying the act of infringement

- The defendant's product or process does not include some of the components of the plaintiff's patent.
- The plaintiff's trademark (design, business mark) and the defendant's mark in use (product design, business mark) are not identical or similar.
- The defendant did not and does not use the plaintiff's trade secrets.
- The plaintiff's work is not substantially similar to the defendant's.
- Currently, the defendant has ceased manufacturing the products in question.
- Other factors supporting dismissal



4) Recognizing an infringement, yet there are matters of rebuttal

- It is highly likely that the plaintiff's right is to be invalidated by the trial, so the exercise of rights based upon them cannot be accepted (Rebuttal of the abuse of rights).
- The defendant's conduct is simply practicing the prior art.
- Other factors supporting dismissal

2. The Defendant's Duty to Specify His/Her Own Features of Acts in Patent Infringement Litigation

- A. The defendant who denies any specific features of infringement acts contended by the plaintiff in patent infringement litigation must present his/her own specific features of acts (Article 126-2 of the Patent Act).
- B. If the defendant argues that there is justifiable reason for not being able to present specific features of his/her own acts, the court may order the defendant to submit documents to determine justifiability of the arguments. However, exceptions will apply if the holder of the documents has justifiable reasons to refuse the submission of the documents.
- C. If the defendant does not present any justifiable reasons for the acts, the court may find for the plaintiff that the defendant did what the plaintiff contends.
- D. The above provision shall be applied to patent infringement cases filed on or after July 9, 2019.

IV. Date of Pleading or Preparatory Hearing

1. Technical Explanatory Session

- A. The court may hold a technical explanatory session on the date of pleading or preparatory hearing so as to clearly identify the details of the technology and the legal issues of the case.
- B. At a technical explanatory session, the parties must clearly and concisely describe the details of the technology in question by conducting demonstration, using audio-video devices or bringing the actual products in question.
- C. A Technical Investigation Officer belonging to the Seoul Central District Court may



attend the technical explanatory session, listen to the details of the technical description of the parties, and question the parties with the permission of the presiding judge. After the session, the Technical Investigation Officer may submit opinions on the session to the bench.

2. Expert Witness

- A. A party may file a motion for expert witnesses widely recognized for expertise and objectivity in particular technical fields. For the motion, the party must attach a "Statement Form for the Expert Witness" (Attachment 3) that can confirm expertise and objectivity of the witness.
- B. A preparatory order may be issued for the preparation of the matters necessary for the examination of an expert witness (deadlines for submission of an affidavit of the expert witness and an examination questionnaire for the expert witness, limitation of the time for examination, and deadlines for submission of arguments and evidence for impeaching the credibility of the testimony by the expert witness, etc.)
- C. A direct examination of the expert witness must be conducted within the scope of the affidavit of the expert witness. All documents to be presented or cited in the main examination must be submitted as evidence before the deadline for submission of the affidavit of the expert witness and examination questionnaire.
- D. If an expert witness is a foreigner, the parties may be accompanied by interpreters for direct and cross examinations (however, if an expert witness testifies in a permitted foreign language in International case, the party does not need to be accompanied by an interpreter). If an interpreter is accompanied, the party may provide documents regarding technical matters, etc. with the interpreter in advance for smooth interpretation. If a party cannot be accompanied by an interpreter, the party shall notify the court thereof 4 weeks before the witness examination date and file a request for designation of an interpreter.
- E. If necessary, within the scope of related legal provisions, examination of an expert witness may be carried out remotely via relay device such as video conference.

3. Professional Examiner

- A. In order to clarify litigation relations or to smoothly proceed with litigation procedures, the court may designate professional examiners ex officio or upon application of parties and have them participate in the litigation procedures (Article 164-2(1) of the Civil Procedure Act).



- B. The professional examiner may submit a paper stating explanation or opinion, or attend the litigation procedures to give an oral explanation or opinion on the matter. The professional examiner also may directly question the parties with the permission of the presiding judge. However, they shall not participate in the deliberation procedure (Article 164-2(2) and (3) of the Civil Procedure Act).

V. The Court's Order on Proof

1. Order to Submit Materials (Documents)

- A. The court may order the defendant to submit necessary materials and documents (hereinafter, "materials") for the assessment of damages, etc., in litigation of the intellectual property infringement at a party's request (Article 132 of the Patent Act, Article 118 of the Design Protection Act, Article 114 of the Trademark Act, and Article 14-3 of the Unfair Competition Prevention Act).
- B. If the plaintiff files a motion for order to submit materials, the defendant may answer to the motion, including the justifiable reasons to refuse to submit the materials.
- C. If the defendant argues that there are justifiable reasons to refuse to submit the materials, the court may order the defendant to present materials to determine the justifiability of the argument.
- D. The court may determine the type and scope of materials to be submitted after comparing the adverse impact that the plaintiff would suffer due to lack of access to the materials and the adverse impact that disclosure of the materials would have on the defendant. If the defendant presents justifiable reasons not to disclose the materials (e.g., they contain sensitive personal information, the information is not relevant to proving infringement or assessing the amount of damages), the court may order submission of the materials with redaction of the corresponding portions at the request of the defendant.
- E. If the defendant fails to comply with the court's order to submit the materials without justifiable reasons, the court may consider it in the assessment of damages.

2. Order to Provide the Information Related to Copyright Infringement

- A. In litigation of copyright infringement, at the request of the party, the court may order the other party concerned to provide the information which is capable of identifying persons responsible for the act of infringement or the production and distribution of



illegal copies, or the information on the routes of production and distribution of illegal copies (Article 129-2 of the Copyright Act).

- B. If the other party concerned argues that there are justifiable reasons to refuse to submit the information, the court may order the defendant to present the information in order to determine the justifiability of the argument. In this case, the court may disclose the information to the requesting party or its representative only if deemed necessary.

3. Orders to Maintain Confidentiality of Trade Secrets

- A. In accordance with Article 163 of the Civil Procedure Act, perusal or copying of litigation records containing any secrets may be restricted. And in IP cases, the court may order upon a party's request, the other party, the legal representatives of the party, and other persons who become aware of trade secret, to refrain from disclosing trade secrets to others, if the court believes that trade secrets may be disclosed in the proceedings (Article 224-3 of the Patent Act, Article 44 of the Utility Model Act, Article 217 of the Design Protection Act, Article 227 of the Trademark Act, Article 14-4 of the Unfair Competition Prevention Act, and Article 129-3 of the Copyright Act).
- B. Should either party seek an order to maintain confidentiality, they must separately file a motion against the other party. The requesting party must clearly specify the persons who are subject to the order (e.g., legal representatives of the other party or representatives of the corporation) and the objects of the order, by using attachments, etc.
- C. Persons under the order to maintain confidentiality must strictly comply with the order. If they fail to adhere to the order without justifiable reasons, he/she may be punished for breach of the order to maintain confidentiality (Article 229-2 of the Patent Act, Article 49-2 of the Utility Model Act, Article 224 of the Design Protection Act, Article 231 of the Trademark Act, Article 18-4 of the Unfair Competition Prevention Act, and Article 136(1)(ii) of the Copyright Act).



[Attachment 1]

Motion for Pleading in a Foreign Language

- Case No. :
- Submitted by :
- Reason to apply for leave to plead in a foreign language (check)
 - a party is a foreigner
 - examination of major evidence needs to be carried out in a foreign language
 - relevant factor which necessitates hearings of pleadings in a foreign language
- Specific reason above in detail

- Foreign language requested for permission: English¹⁾

20 . . ○. ○.

Plaintiff / Defendant ○○○

1) Currently, only English is permitted.



[Attachment 2]

Opinions on the Motion for Pleading in a Foreign Language

- Case No. :
- Submitted by :
- Opinion on the motion for a leave for pleading in a foreign language
 - Agree
 - Disagree
- Specific reasons for disagreeing

20 . . ○. ○.
Plaintiff / Defendant ○○○



[Attachment 3]

Statement Form for the Expert Witness

○ Personal Information

Name		Date of Birth	
Address			

○ Objectivity

1	Are you a relative of the plaintiff or the defendant (CEO or employee in case of a company, hereinafter the same applies)?	Yes	No
2	Do you owe or have you lent the plaintiff or the defendant money?	Yes	No
3	Do you work with the plaintiff or the defendant, or do you have a contract with either of them or are you hired by them or hiring them, or have any of these situations happened in the past?	Yes	No
4	Have you ever testified as a witness in a lawsuit involving the plaintiff or the defendant, or in a lawsuit over the patents or products in question?	Yes	No
5	Have you ever advised the plaintiff or the defendant in connection with this suit?	Yes	No

If you replied "Yes" to any of the questions above, please provide specifics below.

(Continued in the back page)



○ Professionalism

1. Please specify your field of expertise.

2. Regarding the field of expertise, please specify the following:

- ① your current and previous occupations (term of service, position, and duties),
- ② any documents which can help you to verify your professionalism, for example, a degree/certification, thesis/report, and others.

(If more space is needed, please attach relevant information separately)

- ※ The expert witness must testify based only on the facts and his/her expert knowledge to ensure there is no bias toward either party.
- ※ The expert witness must testify based on facts and theories which are objectively validated and widely recognized in the field of expertise, but must not testify based on his/her own subjective theories and interpretations.

I confirm that the information given in this form is true, complete and accurate.

Date 20 . . .

Signature _____