

Guideline of Civil Appellate Practice and Procedure of the Patent Court of Korea

March 16, 2016, Patent Court

I. Purpose of the Guideline

The Guideline of Civil Practice and Procedure of the Patent Court of Korea(hereinafter to as “the Guideline”) is prepared to facilitate expeditious and efficient civil appeal proceedings involving complex issues by prescribing matters such as procedural discussions, designation of deadlines for submitting arguments and rebuttal arguments, and focusing examination on disputed issues. In addition, by prescribing and publicly disclosing the hearing procedures and methods for requesting and examining evidence adapted to the nature of patent actions, the Guideline provides predictability to the interested parties and facilitates diligent preparation in appeal proceedings.

II. Petition of Appeal and Preparatory Order

1. Preparatory Order to Appellant

A. If a petition of appeal does not contain the statement of sufficient grounds of appeal, the Court issues a preparatory order requesting appellant to submit of a statement of grounds of appeal, immediately upon receiving the petition for appeal(See. Attachment 1).

B. No later than 3 weeks from receipt of the preparatory order, the appellant shall submit a statement of grounds of appeal including the following:

- ① Errors of fact and errors of law in the judgment of the lower courts;
- ② A summary of the factual and legal arguments made by the appellant and the appellee in the lower court, and undisputed facts among the appellee’s arguments;
- ③ A summary of the evidence submitted in the lower court and the purport of the evidence;

- ④ New arguments raised in appeal, new evidence presented in appeal and the purport thereof, and the reason(s) for the failure to present the arguments and evidence in the lower court;
- ⑤ Notice of related cases [all cases pending in the Intellectual Property Trial and Appeal Board of the Korean Intellectual Property Office(hereinafter to as “the IPTAB”) or in the court and involving the same patent, utility model, trademark or design shall be deemed to be related cases (including a case initiated by a petition for correction trial and a petition for correction). If the appellant fails to notice such cases without a justifiable cause, the cases may be not considered during the appeal proceedings]; and
- ⑥ Whether the appellant desires mediation or settlement.

2. Preparatory Order to Appellee

A. No later than 3 weeks from service of the appellant’s brief containing the grounds for appeal, the appellee shall submit a statement of response including the following:

- ① Answer to the appellant’s arguments and undisputed portions among the appellant’s arguments;
- ② A summary of the evidence submitted in the lower court and the purport of the evidence;
- ③ New arguments raised in appeal, new evidence presented in appeal and the purport thereof, and the reason(s) for the failure to present the arguments and evidence in the lower court;
- ④ Notice of related cases [all cases pending in the IPTAB or in the court and involving the same patent, utility model, trademark or design shall be deemed to be related cases (including a case initiated by a petition for correction trial and a petition for correction). If the appellee fails to notice such cases without a justifiable cause, the cases may be not considered during the appeal proceedings]; and
- ⑤ Whether the appellee desires mediation or settlement.

B. If the appellee fails to submit a statement of response or answer to the ground of appeal is not sufficient in the statement of response, the Court may issue a preparatory order requesting appellee to submit a statement of response describing the purport of the response in detail(See. Attachment 2).

3. Instructions Relating to New Arguments and Evidence

In the case where the lower court held a preparatory hearing or designated a deadline for submission of arguments, if a party seeks to add new or modified arguments that had not been submitted by the conclusion of the preparatory hearing or the designated deadline in the lower court or to submit any evidence for the new or modified arguments, the party shall provide a detailed explanation for the failure to submit the argument or evidence within such period based on a justifiable cause, provided that submission of such argument or evidence does not cause a substantial delay in the appeal proceeding.

III. Classification of a Case and Pre–Hearing Procedure

1. Classification of a Case

Upon submission of a statement of the grounds for appeal, the presiding judge reviews the case based on the briefs and appeal record and classifies the case as a case requiring immediate designation of a hearing, a case requiring a case management conference or a preparatory hearing, or a case to be referred to an early mediation proceeding.

2. Preparatory Order for Hearing

For a case requiring immediate designation of a hearing, in order to conduct the proceedings in a diligent manner, the Court may issue a preparatory order to the appellant and the appellee designating deadlines for submission of arguments and evidence and for requests for evidence that require a substantial amount of time such as an expert witness(See. Attachment 3).

3. Video Conference for Case Management

A. After hearing opinions of the parties, the presiding judge may discuss procedural matters of the case with the parties simultaneously through video and audio communication means (hereinafter, “video conference for case management”). The presiding judge may designate the judge to be in charge of the above process.

B. The Court may notify the appellant and the appellee of the video conference and issue a preparatory order with regard to the conference(See. Attachment 4).

C. In a video conference for case management, the following matters may be discussed:

- ① Dates and the number of hearings, and disputed issues to be addressed in each of the hearings;
- ② Deadlines for submission of arguments and evidence (including deadlines for submission of comprehensive briefs and expert’s statement, and the number or volume of briefs to be submitted);
- ③ Whether to request for evidence requiring a substantial amount of time, such as an expert witness, and the deadline for such a request;
- ④ Whether to hold a technical explanatory session by the parties;
- ⑤ Whether to refer the case to a mediation proceeding; and
- ⑥ Confirmation and summary of issues.

D. The Court may issue a preparatory order (scheduling order) based on the results of the video conference for case management(See. Attachment 5).

E. If the Court orders submission of comprehensive briefs in a preparatory order, the appellant shall submit a comprehensive brief no later than 3 weeks from the date of the video conference for case management (or a deadline designated in the preparatory order) and the appellee shall submit a comprehensive brief no later than 3 weeks from the date of the appellant's submission of its comprehensive brief (or a deadline designated in the preparatory order).

F. Each party shall describe all arguments in its comprehensive brief (including the arguments that were made in the lower court and not withdrawn) and submit main evidence for the arguments. If the Court has ordered submission of comprehensive briefs for specific issues, the comprehensive briefs shall include all arguments relating to the specific issues.

G. If a party seeks to add any new or modified argument or submit evidence for such argument after the deadline for submission of arguments and evidence designated in the preparatory order, the party shall provide an explanation for the failure to submit the argument or evidence within the designated period based on a justifiable cause [e.g., addition or modification of arguments such as an argument relating to the statement of claim or defense, an argument that changes the closest prior art ("main prior art") relating to novelty, inventive step or a free-to-practice technology defense or that adds or changes prior art and the combination relationship thereof, an argument for lack of sufficient description in the specification based on a different legal provision, an argument contrary to the judgment of the lower court, etc.].

4. Preparatory Hearing

A. The Court may hold a preparatory hearing and have the parties present in order to summarize the parties' arguments and evidence or to hold a technical explanatory session.

B. If a party seeks to add or modify an argument or submit evidence for such added or modified argument after the conclusion of the preparatory hearing, the party shall provide an explanation for the failure to submit the argument or evidence before the conclusion of the preparatory hearing based on a justifiable cause.

IV. Oral Hearings

1. Conduct of Oral Hearings

A. Each party shall present an oral argument for 15 minutes, in the order of the appellant and the appellee. Even when a party has retained more than one attorney-of-record, the party shall present its oral arguments within the above time period. If deemed necessary, the presiding judge may extend or shorten the time.

B. Any materials for oral arguments shall be submitted no later than 1 week before the designated date for each hearing.

C. If necessary, the parties shall bring the products directly related to the case (e.g., products implementing a patent in dispute, accused infringing products, etc.). The presiding judge may request the parties to explain or demonstrate the products.

2. Separate Oral Hearings according to Issues

A. If deemed necessary in any of the following cases, the Court may consult with the parties and hold the separate oral hearings according to issues:

- ① Where it is necessary to hold oral hearings according to specific claims or issues because several claims are consolidated or several issues are in dispute;¹⁾
- ② Where a hearing for claim construction should be conducted first because the parties dispute the proper construction of the claims and the parties' arguments on other disputed issues may change according to the claim construction;²⁾ or

1) < Operational Example > When the issues of infringement and the amount of damages are in dispute:

① Based on the discussion in a video conference for case management, the Court sets a schedule for the separate oral hearing according to issues and designates a deadline for submission of arguments and evidence on the infringement issue. ? The Court holds a first hearing directed to the infringement issue ? The Court may disclose its opinion on the infringement issue, either orally or in writing.

② If a prima facie case of infringement is established, a discussion is held during a preparatory proceeding for setting the deadlines for submission of arguments and evidence relating to the amount of damages, procedures and methods of examination of evidence, etc.

If infringement is not clear, a discussion is held during a preparatory proceeding for conducting additional examination on unclear portions in a second hearing.

③ The Court holds the second hearing directed to the disputed issue discussed in the preparatory hearing proceeding. ? The Court issues a judgment.

2) < Operational Example > When claim construction is in dispute:

① Based on the discussion in a video conference for case management, the Court sets a schedule for the construction of the asserted claims first and designates a deadline for submission of arguments and evidence

③ Where it is otherwise necessary to hold hearings directed to specific issues.

B. At each of the hearings, the scope of the hearing is limited to the disputed issue designated for that hearing.

C. After a hearing, the Court may disclose its opinion, either orally or in writing, regarding disputed issues on which examination has been completed. The above opinion can be changed later. The judge panel may order the parties to prepare for hearings on other remaining disputed issues based on the Court's opinion above(See. Attachment 6).

3. Hearings of an Infringement Action and a Cancellation of IPTAB Decision Action

A. If deemed necessary, such as when both an infringement action and a cancellation of IPTAB decision action involving same patent, utility model, trademark or design are filed together before the Court and are litigated by same parties and the attorneys-of-record, the Court may examine both actions in parallel.³⁾

B. If it is necessary to organize related arguments in an infringement action and a cancellation of IPT decision action, the Court may conduct preparatory proceedings for these actions in parallel.

V. Application and Examination of Evidence

1. Application to Adduce Evidence and its Admissibility

for claim construction and other disputed issues. ? The Court holds a first hearing directed to construction of the claims in dispute.

② The Court discloses its opinion on the proper construction of claims, either orally or in writing, and orders the parties to prepare for a hearing directed to the other remaining disputed issues.

③ The Court holds a second hearing directed to the other remaining disputed issues. ? The Court issues a judgment.

3) < Operational Example > When the infringement action and the cancellation of IPTAB Decision action are heard before the Court in parallel:

① The Court examines the issues of nullification (and infringement) in a first hearing. ? Regarding the cancellation action, the Court concludes a hearing or sets a hearing TBD.

② If the nullification is not recognized, the Court discloses its opinion on this (and may issue a judgment regarding the cancellation of decision action first) and discusses other remaining issues of the infringement action in a preparatory hearing. ? A second hearing ? The Court issues a judgment.

If the nullification is recognized, the Court discloses its opinion on this (and may issue a judgment regarding the cancellation of decision action). ? A second hearing ? The Court issues a judgment.

A. If a party makes an application to adduce new evidence in the appeal proceeding, the party shall provide a detailed explanation for the failure to submit the evidence in the lower court. The Court determines whether to admit the evidence in consideration of the circumstances, including whether a significant harm to the other party is expected from a delay in court proceedings or whether an expedited proceeding is necessary.

B. If a party makes an application to adduce evidence that is identical or similar, in the evidentiary purport, to the evidence that had been admitted and examined by the lower court (e.g., where the lower court appraised an amount of damages and a party files a request for a separate appraisal to impeach the appraised amount), the party shall provide a detailed explanation on the need for such evidence.

C. If a party makes an application to adduce evidence that had been filed but rejected by the lower court or voluntarily withdrawn by the party in the lower court, the party shall provide a detailed explanation on the need for such evidence.

D. If deemed necessary, the Court may conduct a preparatory proceeding for discussing evidence examination procedure. After hearing the parties' opinions, the presiding judge may discuss procedural matters via a video conference method set forth in Section III.3.A and, if deemed necessary, issue a preparatory order in relation thereto(See. Attachment 7).

2. Expert Witnesses

A. If a party files a request for an expert witness, the party shall attach a declaration that can confirm the expertise and objectivity of the witness(See. Attachment 8).

B. The Court may issue a preparatory order for examination of an expert witness (e.g. deadlines for submission of a statement of the expert witness and a questionnaire for the direct examination, limitation of the time for examination, and deadlines for submission of arguments and evidence for impeaching the credibility of the expert witness testimony) (See. Attachment 9).

C. The direct examination by the party who requests for the witness shall be made within the scope of the statement of the expert witness. All materials presented or cited in the direct examination shall be submitted as evidence before the date designated for examining the witness.

D. If an expert witness is a foreigner, the parties may be respectively accompanied by an

interpreter for the direct and cross examinations. If a party cannot be accompanied by an interpreter, the party shall notify the Court of the same 4 weeks before the witness examination date and file a request for designation of an interpreter.

3. Order to Adduce Materials

A. According to a party's request, the Court may order the other party to submit documents or materials(including electronic documents) necessary for proving infringement or calculating the amount of damages occurred by the infringing act (e.g., accounting books, books relating to revenues or expenditures, contracts, tax invoices, tax returns, and statements of bank transactions). The Court may determine the types and scope of materials to be submitted by comparing the adverse impact that the requesting party would suffer due to the lack of access to materials and the adverse impact that disclosure of materials would have on the disclosing party. If the disclosing party presents justifiable grounds such as the documents contain sensitive personal information or information that is not relevant to proving infringement or calculating the amount of damages, the Court may permit submission of the documents by redacting corresponding portions according to the disclosing party's request.

B. If deemed necessary, the Court may, upon a request by a party, generally describe the purport of materials requested and the facts to be proved by the materials and order the other party to submit descriptions and purport of the materials in its possession that relate to the request.

C. If deemed necessary such as when it is disputed whether the other party is in possession of the materials, the Court may examine the parties or witnesses before issuing an order for production of materials.

D. If the other party refuses to produce the materials, the Court may request the party to provide the materials for the purpose of determining whether a justifiable cause exists for the refusal to produce the documents.

E. If the materials requested to be produced contain trade secret, the Court may, upon a request by the party in possession of the materials, order the requesting party or its counsel to keep the contents of the materials confidential by its ruling.

4. Appraisal

A. The Court may conduct an appraisal if an appraisal for calculating the amount of damages was not conducted in the lower court, the appraisal is necessary to determine a reasonable royalty or a contribution ratio of a patented invention, or the appraisal is otherwise acknowledged to be necessary.

B. The parties shall explain to the appraiser matters necessary for the appraisal of the damages amount.

5. Technical Advisors

A. If deemed necessary, the Court may hear opinions of the parties and designate one or more technical advisors.

B. A preparatory hearing may be held if it is deemed necessary for the technical advisors to understand the case. In the preparatory hearing, the technical advisors may directly question the parties with approval of the presiding judge. If it is necessary for a party to supplement its answer to a question from the technical advisors, the party shall submit its supplemental answer in writing to the Court by a deadline designated by the presiding judge.

6. Submission of Arguments and Evidence regarding an Amount of Damages

A. The respondent from whom compensation for damages is sought shall provide specific answers to the arguments of the petitioner, and if the petitioner's arguments are different from the facts, the respondent shall disclose the actual sales period of products, quantities sold, unit cost of sales, sales amount, manufacturing cost, and profit rate.

B. If account books or books relating to accounting or finance recording sales or expenditures are submitted, the disclosing party shall attach a written confirmation of the person who prepared the books (for a company, the chief executive officer and the chief accounting officer) verifying that the submitted documents are the original documents or copies of the original documents without any modification, deletion, or omission. If the other party raises a reasonable doubt on the authenticity of the account books, the disclosing party shall submit additional documents (bank or financial documents, etc.), which are the basis for preparing the books.

VI. Mediation

1. Early Mediation

A. Immediately upon receiving an appeal case or at an appropriate time, the presiding judge may determine whether the case is suitable for mediation and refer the case to an early mediation proceeding.

B. In principle, the mediation judge shall be in charge of cases referred to an early mediation proceeding. Upon discussions with the parties, the mediation judge may conduct mediation proceedings at suitable locations other than the Court.

2. Mediation after Hearing

Even after the first hearing, if deemed necessary, the presiding judge may refer the case to the mediation proceeding to enable the Patent Court Mediation Committee or the like to mediate the case.

VII. Preparing Documents for Submission

1. Briefs

A. Contents of Briefs

- ① If a brief of 20 or more pages is to be submitted, a table of contents shall be included at the beginning of the brief.
- ② If evidence supporting an argument is submitted, a number for the evidence shall be indicated in a corresponding portion of the brief.
- ③ Technical terms shall be defined in footnotes and the sources thereof shall be identified.
- ④ A comprehensive brief shall include, at the beginning thereof, a summary of all offensive and defensive arguments by a party in this action and main evidence (including prior arts) therefor.
- ⑤ In briefs other than the comprehensive briefs, arguments that have been previously made shall not be repeated.

B. Arguments regarding Inventive Step

- ① A specific combination relationship of prior arts and the reason for the ease in combining the prior arts shall be specified. It should be noted that if such an argument is not specified, it may be deemed that the argument had not been made.

Example) The inventive step of the Claim is denied by Prior Arts 1 to 3 (×).

If the ○○ constitution of Prior Art 2 is added to Prior Art 1 which is the main prior art (or if the constitution 2 of Prior Art 1 is replaced with the ○○ constitution of Prior Art 2), the patented invention is derived. And since Prior Art 1 discloses a suggestion for such combination, a person of ordinary skill in the art could have easily conceived such combination and thus the inventive step of the patented invention is denied (○).

- ② A feature comparison chart comparing the corresponding features of the patented invention and each of the prior arts shall be submitted.
- ③ The features of prior arts shall be specified in detail. If a single document contains multiple inventions, it shall be clearly specified as to which of the multiple inventions is asserted to be a prior art.
- ④ The person of ordinary skill in the art and the level of ordinary skill in the art shall be specified in detail.
- ⑤ The foregoing requirements shall also apply to a free-to-practice technology defense.

C. An argument regarding a lack of written description in the specification shall specify an applicable legal provision on which the argument is based.

D. Arguments regarding Infringement

- ① Infringing products and methods shall be described specifically, individually, and factually to allow the enforcement agency to identify the same without a separate judgment in relation thereto (e.g., describing the names and model numbers of products with drawings or photos attached).
- ② Arguments regarding infringing products and methods shall be made in sufficient detail to allow comparison with the patented invention and the descriptions shall correspond to the products and methods practiced by the other party in factual aspects.
- ③ A feature comparison chart comparing the corresponding features of the patented invention and the infringing products and methods shall be submitted.

E. Arguments regarding an Amount of Damages

- ① Plaintiff's argument regarding the amount of damages shall indicate an applicable

legal provision on which the argument is based and shall indicate an evidence number relating to an argument for each of the essential elements.

- ② Defendant's response relating to the amount of damages shall include a detailed rebuttal argument to the plaintiff's factual arguments (it should be noted that any fact not specifically denied may be deemed as being undisputed). In particular, if the plaintiff claims a damages amount based on Article 128(1) of the Patent Act, the defendant's response denying the transferred volume argued by the plaintiff shall state the actual transferred volume. If the plaintiff claims a damages amount based on Article 128(3) of the Patent Act, the defendant's response denying the profit amount argued by the plaintiff shall state the actual profit amount and the grounds for calculating the amount such as sales revenues, expenses, profit margins, etc.

2. Explanatory Documents for Evidence

A. Each item of evidence and the purport to be proved therefrom shall be briefly described.

B. If an item of evidence is submitted in relation to an argument regarding novelty, inventive step, or free-to-practice technology, it shall be clearly specified whether the evidentiary item is submitted as a prior art invention or as evidence of well-known prior art.

3. Documentary Evidence

A. Written documents in a foreign language shall be submitted with a translation attached thereto and the main evidence (e.g., prior arts, etc.) shall be submitted with a professional translation attached thereto. Machine (automatic) translations shall not be submitted.

B. A documentary evidence shall indicate a title if the title of the document exists, or a summary of the document, if the document has no title [e.g., "Product Catalogue of the Company ○○ (published on January 2, 2006)"]. A written evidence submitted as a prior art shall indicate the same [e.g., "(Prior Art 1) Registered Patent Publication No. 0012345"].

C. Each evidence shall contain only a single evidentiary item [e.g., in trademark cases, several blog postings shall be submitted as separate evidentiary documents; however, if they are related, they can be indicated as multi-level numbers (Plaintiff's Exhibit No. 2-1, 2-2, etc.)].

[Attachment 1]

PATENT COURT

The 21st Panel

Preparatory Order (Grounds for Appeal)

Case No. 2016 Na 100001

Plaintiff (Appellant) ○○○

According to the filing of your appeal, the litigation records of the case identified above have been submitted to this Court. Thus, the appellant is requested to submit a brief describing the specific grounds for appeal and the necessary evidence.

Deadline for Submission: [*], 2016

Preparatory Matters

1. The appellant is requested to submit a brief containing the following matters:

- ① Portions of the lower court's decision where the court is alleged to have erred in acknowledging facts or applying the law;
- ② A summary of the factual and legal arguments made by the appellant and the appellee in the lower court, and undisputed portions among the appellee's arguments;
- ③ A summary of the evidence submitted in the lower court and the purport of the evidence;
- ④ New arguments to be raised on appeal, new evidence to be presented on appeal and the purport thereof, and the reason(s) for the failure to present the arguments and evidence in the lower court;
- ⑤ A description of related cases [all cases pending in the Intellectual Property Trial and Appeal Board or any court that relate to the same patent, utility model, trademark or design shall be deemed as related cases (including a case initiated by a petition for correction trial or any claim for correction). If the appellant fails to describe such cases without a justifiable cause, the cases may be disregarded and not considered during the proceedings]; and
- ⑥ Whether the appellant desires mediation or settlement.

2. In the case where the lower court held a preparatory hearing or designated a deadline

for submission of arguments, if the appellant seeks to add new or modified arguments or submit any evidence for the new or modified arguments that had not been submitted by the conclusion of the preparatory hearing date or the designated deadline in the lower court, the appellant shall provide a detailed explanation for the failure to submit the argument or evidence within such period based on a justifiable cause.

3. The Patent Court has established the “Guideline of Civil Appellate Practice and Procedure of the Patent Court of Korea.” Please refer to the Patent Court website (<http://patent.scourt.go.kr>) for more details. For prompt, efficient, and diligent trial proceedings, please read the Manual carefully and comply with the provisions therein. In particular, briefs should be prepared in accordance with the section “Method of Preparing Documents for Submission” of the Manual and evidence should be requested in accordance with the section “Request for Investigation of Evidence” of the Manual.

4. The judicial panel will strictly apply Article 149 of the Civil Procedure Act against arguments or requests for evidence that are not in compliance with the foregoing matters.

[Attachment 2]

PATENT COURT

The 21st Panel

Preparatory Order (Response)

Case No. 2016 Na 100001

Defendant (Appellee) ○○○

The appellee is requested to submit a brief describing the detailed grounds of its response and the necessary evidence.

Deadline for Submission: [*], 2016

Preparatory Matters

1. The appellee is requested to submit a response containing the following matters:

- ① Answers to the appellant's arguments and undisputed portions among the appellant's arguments;
- ② A summary of the evidence submitted in the lower court and the purport of the evidence;
- ③ New arguments to be raised in appeal, new evidence to be presented in appeal and the purport thereof, and the reason(s) for the failure to present the arguments and evidence in the lower court;
- ④ Acceptance/denial of the evidentiary documents submitted by the other party;
- ⑤ A description of related cases [all cases pending in the Intellectual Property Trial and Appeal Board or any court that relate to the same patent, utility model, trademark or design shall be deemed as related cases (including a case initiated by a petition for correction trial or any claim for correction). If the appellant fails to describe such cases without a justifiable cause, the cases may be disregarded and not considered during the proceedings]; and
- ⑥ Whether the appellee desires mediation or settlement.

2. In the case where the lower court held a preparatory hearing or designated a deadline for submission of arguments, if the appellant seeks to add new or modified arguments or submit any evidence for the new or modified arguments that had not been submitted by the

conclusion of the preparatory hearing date or the designated deadline in the lower court, the appellee shall provide a detailed explanation for the failure to submit the argument or evidence within such period based on a justifiable cause.

3. The Patent Court has established the “Guideline of Civil Appellate Practice and Procedure of the Patent Court of Korea.” Please refer to the Patent Court website (<http://patent.scourt.go.kr>) for more details. For prompt, efficient, and diligent trial proceedings, please read the Manual carefully and comply with the provisions therein. In particular, briefs should be prepared in accordance with the section “Method of Preparing Documents for Submission” of the Manual and evidence should be requested in accordance with the section “Request for Investigation of Evidence” of the Manual.

4. The judicial panel will strictly apply Article 149 of the Civil Procedure Act against arguments or requests for evidence that are not in compliance with the foregoing matters.

[Attachment 3]

PATENT COURT

The 21st Panel

Designation of Hearing Date and Preparatory Order for Hearing

Case No. 2016 Na 100001

Plaintiff (Appellant) ○○○

Defendant (Appellee) ○○○

The Court hereby orders the parties to prepare for the following matters for the purpose of clarifying the parties' arguments and conducting diligent proceedings:

Following

1. The first hearing date is designated to be held on [*], 2016, [*]AM/PM, at the courtroom [*] of the Patent Court.

2. The plaintiff (appellant) shall submit all of its arguments and main evidence therefor by [*], 2016.

3. The defendant (appellee) shall submit all of its arguments and main evidence therefor by [*], 2016.

4. A request for evidence that requires a substantial amount of time, such as a request for an expert witness or a request for an appraisal, shall be filed in writing by [*], 2016.

5. Instructions

A. A request for a change in the hearing date or for an extension of the deadline for submitting arguments and requesting evidence shall be filed in writing at least 1 week before the designated date with an explanation of a justifiable cause for the request.

B. If a party seeks to add any new or modified argument or submit any evidence for such argument after the deadline for submission of arguments and evidence designated in the preparatory order, the party shall provide an explanation for the failure to submit the argument or evidence within the designated period based on a justifiable cause (e.g., addition or modification of arguments such as an argument relating to the cause of action or defense, an argument that changes the primary prior art relating to novelty, inventive step or the defense of free-to-practice technology, or that adds or changes prior arts or the combination relationship thereof, an argument for deficient description in the specification based on a

different legal provision, an argument contrary to the acknowledged facts or legal judgment of the lower court, an argument regarding the amount of damages based on a different legal provision, etc.). If an explanation of a justifiable cause is not provided, the judicial panel will strictly apply Article 149 of the Civil Procedure Act.

C. At the hearing, the appellant and the appellee will present oral arguments for 15 minutes each, in the respective order. Any materials for oral arguments shall be submitted no later than 1 week before the designated hearing date.

D. If necessary at the hearing, the parties shall bring the products (e.g., products implementing the patent in dispute, accused infringing products, etc.) directly related to the case.

E. The Patent Court has established the “Guideline of Civil Appellate Practice and Procedure of the Patent Court of Korea.” Please refer to the Patent Court website (<http://patent.scourt.go.kr>) for more details. For prompt, efficient, and diligent trial proceedings, please read the Manual carefully and comply with the provisions therein. In particular, briefs should be prepared in accordance with the section “Method of Preparing Documents for Submission” of the Manual and evidence should be requested in accordance with the section “Request for Investigation of Evidence” of the Manual.

[Attachment 4]

PATENT COURT

The 21st Panel

Preparatory Order for Video Conference for Case Management

Case No. 2016 Na 100001

Plaintiff (Appellant) ○○○

Defendant (Appellee) ○○○

The Court hereby orders the parties to prepare for the preparatory matters below for the purpose of clarifying the parties' arguments and conducting diligent proceedings.

Preparatory Matters

1. Schedule of Video Conference for Case Management

A video conference for case management will be held on [*], 2016, [*] AM/PM, via a video conference(Vidyo).⁴⁾ The parties are requested to access Vidyo at least 5 minutes before the conference begins and complete verification of the setup for the video, speaker, and microphone.

2. Contents of Video Conference for Case Management

In a video conference for case management, the below matters and schedules will be discussed. Since the subsequent trial will proceed in accordance with the matters and schedule discussed therein, the parties are requested to prepare for the arguments and evidence in advance (*see* Article 147 of the Civil Procedure Act). To facilitate efficient conference proceedings, the counsel for the parties are requested to have prior discussions with each other regarding the matters below.

- ① Dates and the number of hearings, and disputed issues to be addressed in each of the hearings;
- ② Deadlines for submission of arguments and evidence (including deadlines for submission of comprehensive briefs and any expert witness statement, and the number or volume of briefs to be submitted);
- ③ Whether to request for evidence requiring a substantial amount of time, such as an

4) For the video conference, it is necessary to install the Vidyo program (downloadable from <http://vc.scourt.go.kr>) with equipment such as a web camera (webcam), a headset (speaker and microphone), etc.

expert witness, and the deadline for such a request;

- ④ Whether to hold a technical presentation session by the parties;
- ⑤ Whether to transfer the case to a mediation proceeding; and
- ⑥ Confirmation and summary of the disputed issues.

3. Instructions

A. In order to facilitate the proceeding, the factual and legal issues disputed in this case shall be submitted at least 7 days before the conference date. In particular, if the parties are in dispute over the interpretation of claims, the parties shall submit the claims and terms (including phrases and paragraphs) at issue, as well as the proposed interpretation thereof.

B. If a party seeks to submit arguments or evidence after the deadline for submission designated in the preparatory order, the party shall provide an explanation for the failure to submit the argument or evidence within the designated period based on a justifiable cause. Any argument and evidence, for which a justifiable cause is not sufficiently explained, may be rejected under Article 147(2) and Article 149 of the Civil Procedure Act.

C. Arguments relating to grounds of invalidation of the patented invention shall contain the following matters and the party seeking to add or modify an argument concerning any of the following matters after the final deadline shall explain the existence of a justifiable cause for such addition or modification:

- ① The level of technical skill required of a person having ordinary skills in the art (including the level of education, qualification, and duration of work); and
- ② Prior arts: If the primary prior art is added or modified or the specific combination relationship of several prior arts is modified (Example of an argument denying inventive step: If the Element 2 of Prior Art 1, which is the primary prior art, is replaced with Element ○○ of Cited Reference 2, the patented invention is derived. In addition, since Prior Art 1 suggests such a combination, a person having ordinary skills in the art could have easily conceived such a combination and thus the inventive step of the patented invention is denied).

D. The Patent Court has established the “Guideline of Civil Appellate Practice and Procedure of the Patent Court of Korea.” Please refer to the Patent Court website (<http://patent.scourt.go.kr>) for more details. For prompt, efficient, and diligent trial proceedings, please read the Manual carefully and comply with the provisions therein. In particular, briefs should be prepared in accordance with the section “Method of Preparing

Documents for Submission” of the Manual and evidence should be requested in accordance with the section “Request for Investigation of Evidence” of the Manual.

[Attachment 5]

PATENT COURT

The 21st Panel

Designation of Hearing Date and Preparatory Order for Procedures

Case No. 2016 Na 100001

Plaintiff (Appellant) ○○○

Defendant (Appellee) ○○○

With respect to the case above, the Court hereby designates deadlines for submission of arguments and evidence and the hearing date based on the discussions from the video conference for case management held on 2016. ○. ○., as follows:

Following

1. The deadline for submission of a comprehensive brief by the plaintiff (appellant) shall be [*], 2016.

In the comprehensive brief, the plaintiff (appellant) shall describe all arguments relating to the disputed issues referred to in paragraph 3.A and submit main evidence for the arguments. If the plaintiff (appellant) seeks to add any new or modified argument or submit any evidence for such argument after the submission of the brief, the plaintiff shall provide an explanation for the failure to submit the argument or evidence within the period based on a justifiable cause (e.g. addition or modification of arguments such as an argument relating to the cause of action or defense, an argument that changes the primary prior art relating to novelty, inventive step or the defense of free-to-practice technology, or that adds or changes prior arts or the combination relationship thereof, an argument for deficient description in the specification based on a different legal provision, an argument contrary to the acknowledged facts or legal judgment of the lower court, etc.).

2. The deadline for submission of a comprehensive brief by the defendant (appellee) shall be [*], 2016.

In the comprehensive brief, the defendant (appellee) shall describe all arguments relating to the disputed issues referred to in paragraph 3.A and submit main evidence for the arguments. If the defendant (appellee) seeks to add any new or modified argument or

submit any evidence for such argument after the submission of the brief, the defendant shall provide an explanation for the failure to submit the argument or evidence within the period based on a justifiable cause.

3. The first hearing date is hereby designated to be held on [*], 2016, [*] AM/PM, at the courtroom ○○ of the Patent Court.

A. The disputed issues to be discussed in the first hearing is whether Claim 1 of Patent No. 1234567 is invalid and whether the defendant's products fall within the scope of rights of the above patented invention.

B. At the hearing, the plaintiff (appellant) and the defendant (appellee) will present oral arguments for 15 minutes each, in the respective order.

C. Any materials for oral arguments shall be submitted no later than 1 week before the designated hearing date.

4. A request for an expert witness relating to the disputed issues referred to in paragraph 3.A shall be filed by [*], 2016. The request for an expert witness shall be attached with a basic statement that can confirm the expertise and objectivity of the expert witness [*see* the Patent Court Website (<http://patent.scourt.go.kr>)].

※ If the requested expert witness is adopted and it is necessary to examine the witness in the first hearing, the first hearing date may be changed through discussion with the parties.

[Attachment 6]

PATENT COURT

The 21st Panel

Interpretation of Claims and Preparatory Order for Hearing

Case No. 2016 Na 100001

Plaintiff (Appellant) ○○○

Defendant (Appellee) ○○○

Considering all of the arguments and evidence submitted to date by the parties, the Court hereby interprets the major terms among the claims of the patented invention, of which interpretation is disputed, as follows. Accordingly, the parties are requested to prepare for the hearing based on the following interpretation.

Following

1. Claim of the Patented Invention

【Claim 1】 … (omitted) … (hereinafter, the “Invention in Claim 1”)

2. Interpretation of Major Terms in Invention in Claim 1

A. ○○○

Upon consideration, it is reasonable to deem that it means … (omitted)….

(omitted)

[Attachment 7]

PATENT COURT

The 21st Panel

Preparatory Order for Video Conference

Case No. 2016 Na 100001

Plaintiff (Appellant) ○○○

Defendant (Appellee) ○○○

The Court hereby orders the parties to prepare for the following matters for the purpose of clarifying the parties' arguments and conducting diligent proceedings:

Preparatory Matters

1. Schedule of Video Conference

A video conference for discussing the schedule of evidence investigation, etc. will be held on [*], 2016, [*] AM/PM, via a video conference (Vidyo).⁵⁾ The parties are requested to access Vidyo at least 5 minutes before the conference begins and complete verification of the setup for the video, speaker, and microphone.

2. The plaintiff (appellant) shall submit all arguments for the amount of damages and a plan of proof thereof by [*], 2016.

3. If the plaintiff (appellant) intends to request for clarification by the defendant (appellee) regarding factual requirements for calculation of damages and intends to seek documents (materials) from the defendant (appellee) for the calculation of damages, the plaintiff (appellant) shall submit a detailed request therefor in writing by [*], 2016.

4. The defendant (appellee) shall submit a brief containing the following matters by [*], 2016:

- ① A response to the amount of damages argued by the plaintiff (appellant);

5) For the video conference, it is necessary to install the Vidyo program (downloadable from <http://vc.scourt.go.kr>) with equipment such as a web camera (webcam) and headset (speaker and microphone), etc.

- ② A detailed response to the facts argued by the plaintiff (appellant) such as sales revenues, etc.;
- ③ A response to the request for clarification by the plaintiff (appellant); and
- ④ Whether the defendant (appellee) is in possession of the documents (materials) requested by the plaintiff (appellant) and whether the documents (materials) can be submitted voluntarily, and if not, the specific reasons therefor.

5. Contents of Video Conference

In the video conference, the matters and schedule below will be discussed. To facilitate efficient conference proceedings, the counsels for the parties are requested to have prior discussions with each other regarding the matters below.

- ① The types and scope of documents (materials) to be voluntarily submitted by the defendant (appellee);
- ② Whether to file a request for an order to produce documents (materials) and the scope of such request;
- ③ Deadlines for submission of arguments and evidence;
- ④ Whether to file a request for evidence requiring a substantial amount of time, such as an expert witness, and the deadline for such request;
- ⑤ Whether to transfer the case to a mediation proceeding; and
- ⑥ Confirmation and summary of the disputed issues.

6. Instructions

A. If a party seeks to add a new or modified argument or submit any evidence for such argument after the deadline for submission of arguments and evidence, the party shall provide an explanation for the failure to submit the argument or evidence within the period based on a justifiable cause. If a justifiable cause is not sufficiently explained, the judicial panel will strictly apply Article 149 of the Civil Procedure Act.

B. Arguments Regarding Amount of Damages

- ① The plaintiff's argument regarding the amount of damages shall state an applicable legal provision on which the argument is based and shall indicate an evidence number relating to the argument for each of the required facts.
- ② The defendant's response relating to the amount of damages shall describe the defendant's specific rebuttal to the plaintiff's factual arguments (it should be noted that any fact not specifically denied may be deemed as being undisputed). In particular, if the plaintiff claims an amount of damages based on Article 128(1) of the Patent Act, the defendant's response denying the transferred volume argued by the plaintiff shall state the actual transferred volume. If the plaintiff claims an

amount of damages based on Article 128(3) of the Patent Act, the defendant's response denying the profit amount argued by the plaintiff shall state the actual profit amount and the grounds for calculating the amount such as sales revenues, expenses, and profit margins, etc.

C. If any evidence for proving the amount of damages is in possession of one party and the party fails to cooperate with the evidence investigation by refusing to submit the evidence, destroying the evidence, etc., and therefore it is extremely difficult to calculate the damages amount under Paragraphs 1 to 5 of Article 128 of the Patent Act, the Court may consider such circumstances in acknowledging a considerable amount of damages under paragraph 6 of the same Article.

D. The Patent Court has established the "Guideline of Civil Appellate Practice and Procedure of the Patent Court of Korea." Please refer to the Patent Court website (<http://patent.scourt.go.kr>) for more details. For prompt, efficient, and diligent trial proceedings, please read the Manual carefully and comply with the provisions therein. In particular, briefs should be prepared in accordance with the section "Method of Preparing Documents for Submission" of the Manual and evidence should be requested in accordance with the section "Request for Investigation of Evidence" of the Manual.

[Attachment 8]

Basic Statement of Expert Witness

Personal Information	Name		Date of Birth	
	Address			

Neutrality				
1	Are you a relative of either the plaintiff or the defendant (if a party is a corporation, a chief executive, officer, or an employee; the same applies hereinafter)?	Y	N	
2	Are you in a creditor-debtor relationship with either the plaintiff or the defendant?	Y	N	
3	Have you ever worked or do you currently work with either the plaintiff or the defendant, or have you ever been or are you currently in a contractual, employment, or other similar relationships with either the plaintiff or the defendant?	Y	N	
4	Have you ever provided testimony as a witness in a lawsuit involving either the plaintiff or the defendant or the patent/products at issue?	Y	N	
5	Have you ever provided consultation to either the plaintiff or the defendant with respect to this lawsuit?	Y	N	

Expertise	
1	Describe your area of expertise specifically.
2	With regards to your area of expertise, specifically describe (1) your current and past occupations (including the duration of employment, position/title, and assigned duties) and (2) materials that can confirm your expertise, such as a diploma/license, papers/reports, among others. ※ <i>You may add a separate attachment may be added in case more space is needed.</i>

Obligation of Expert Witness

The expert witness shall make statements based on facts and special knowledge in a manner unbiased to any party. In addition, as an expert in the relevant area, the expert witness shall make statements based on the facts/theories objectively verified and widely acknowledged in the area and shall not make any statements based on his or her subjective theory/interpretation.

I hereby state that the foregoing statements are all true.

Date: _____

By: _____

[Attachment 9]

PATENT COURT

The 21st Panel

Preparatory Order for Hearing (Expert Witness)

Case No. 2016 Na 100001

Plaintiff (Appellant) ○○○

Defendant (Appellee) ○○○

The Court hereby orders the parties to prepare for the below matters for conducting a diligent examination of the witness in the hearing to be held on [*], 2016.

Following

1. Submission of Expert Witness Statement by Plaintiff (Appellant)

A. The plaintiff (appellant) shall submit a statement of its expert witness and questions for the expert witness by [*], 2016. A direct examination shall be conducted within the scope of the expert witness statement.

B. Any and all materials to be presented or cited in the direct examination of the expert witness (including family patents, translations, photos of actual products and reference materials) shall be submitted as evidence by [*], 2016.

2. The direct examination and a cross examination of the witness shall be conducted within 20 minutes for each.

3. The parties may be accompanied by interpreters each for the direct and cross examinations. If a party cannot be accompanied by an interpreter, the party shall notify the Court of the fact by [*], 2016 and file a request for the designation of an interpreter.

4. Any arguments and evidence for impeaching the credibility of the testimony by the expert witness shall be submitted by [*], 2016.