



Session 1

Preferred Forum in
International IP Disputes

국제 지식재산분쟁에서
선호되는 법정지

Moderator



Jaheun Ku High Court Judge, Intellectual Property High Court of Korea

Judge Ku is a currently presiding Judge of Intellectual Property High Court of Korea. He received Bachelor of Law from Korea University in 1990 and LL.M degree from law school of Duke University in 2005. He had served as a judge at the Seoul Eastern Court, Seoul Central Court and Research judge of the Supreme Court of Korea. He has worked as a High Court Judge since 2012.

Panelists



Clark S. Cheney Chief Administrative Law Judge, U.S. International Trade Commission

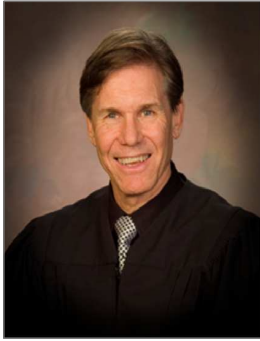
Judge Clark S. Cheney was appointed as Chief Administrative Law Judge (ALJ) at the U.S. International Trade Commission in February 2022, after serving as an ALJ at the Commission since March 2018. Prior to his USITC appointment, Judge Cheney worked in the USITC's Office of the General Counsel, where he regularly argued appeals to the U.S. Court of Appeals for the Federal Circuit on behalf of the Commission. He also served on detail to the Office of the U.S. Trade Representative. He began his career as a patent examiner and served as a law clerk to Judge William Bryson at the Federal Circuit. During several years of private practice, he represented domestic and international clients in intellectual property litigation. He holds a juris doctor degree, cum laude, from the Georgetown University Law Center and a bachelor of science degree in electrical engineering from the University of Utah.



Rian Kalden Presiding Judge, Second Panel of the Court of Appeal, Unified Patent Court

Judge Rian Kalden is the Presiding Judge of the Second Panel of the Court of Appeal of the Unified Patent Court. She is also member of the Presidium of the UPC. Until 2023, she served as a Senior Judge at the Court of Appeal of The Hague, Netherlands. In July 2018, Judge Kalden was appointed Judge at the Benelux Court of Justice, where appeals from decisions of the Benelux trademark offices are heard. Judge Kalden first joined the Bench in 2002, when she became a judge at the District Court of The Hague, where she joined the Patent Chamber. Prior to her judicial appointments, Judge Kalden practiced at the Amsterdam Bar. Judge Kalden graduated from Leiden University in 1989 and received a Master's degree from the University of London in 1990. She regularly speaks at national and international conferences on patent law and related issues.

Panelists



Randall R. Rader Former Chief Judge of U.S. Court of Appeals for the Federal Circuit, Principal of the Rader Group

For over 25 years, Judge Rader has been a leading thought leader in the field of intellectual property law and jurisprudence. His work as Chief Judge, his publications and his work teaching patent law globally to students, judges and government officials has left an indelible mark on the field of IP law and the protection of IP rights throughout the world. Judge Rader was appointed to the United States Court of Appeals for the Federal Circuit by President George H. W. Bush in 1990 and assumed the duties of Chief Judge on June 1, 2010. He was appointed to the United States Claims Court (now the U. S. Court of Federal Claims) by President Ronald W. Reagan in 1988. Before appointment to the Court of Federal Claims, former Chief Judge Rader served as Minority and Majority Chief Counsel to Subcommittees of the U.S. Senate Committee on the Judiciary. From 1975 to 1980, he served as Counsel in the House of Representatives for representatives serving on the Interior, Appropriations, and Ways and Means Committees. Judge Rader stepped down from Chief Judge position on May 30, 2014 and retired from the bench on June 30, 2014. Since leaving the bench, Judge Rader has founded the Rader Group, focusing on arbitration, mediation, and legal consulting and legal education services.



Hyejin Lee High Court Judge, Intellectual Property High Court of Korea

Judge Hyejin Lee currently serves as a presiding judge at the Intellectual Property (IP) High Court of Korea. She previously held positions as a judge at the IP High Court (2013–2017) and as a research judge at the Supreme Court of Korea (2017–2020). With over a decade of practical experience in the field of IP, she has contributed to numerous landmark cases. Judge Lee has also authored a variety of articles and columns, including “Patent Law Issues in Medical Use Inventions” (Supreme Court Law Journal, June 2016) and “Designing the Global Vaccine Supply Chain: Balancing Intellectual Property Rights with Post-COVID-19 Vaccine Equity” (BMJ Global Health, November 2023. 11.).

좌장



구자현 특허법원 수석판사

구자현 고법판사는 현재 특허법원 수석판사로 근무하고 있다. 고려대학교에서 법학사 학위를 받고 2005년 미국 듀크대학교 로스쿨에서 LL.M 학위를 취득하였다. 2000년 서울지방법원 동부지원 판사로 임용된 이후 서울중앙지방법원, 대법원 재판연구관을 거쳐 2012년 서울고등법원 고법판사로 근무하였고, 2022년부터 특허법원 고법판사로 근무하고 있다.

패널



Clark S. Cheney 미국 국제무역위원회(ITC) 수석 행정판사

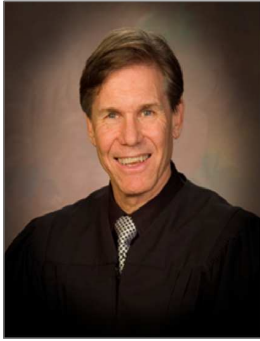
클라크 S. 체니(Clark S. Cheney) 판사는 2018년 3월부터 미국 국제무역위원회(U.S. International Trade Commission)에서 행정판사로 재직해 왔고, 2022년 2월에 같은 위원회의 수석 행정판사로 임명되었다. 미국 국제무역위원회에 임명되기 전에는 위원회의 법률자문실에 근무하면서 위원회를 대표하여 미국 연방순회항소법원에서 정기적으로 항소심 변론을 맡았다. 또한 미국 무역대표부에 파견되어 근무하기도 하였다. 특허심사관으로 경력을 시작하여, 연방순회항소법원에서 윌리엄 브라이슨 판사(Judge William Bryson)의 법률 서기로 근무하였고, 수년간 변호사로 활동하면서 지식재산권 소송에서 국내 및 해외 당사자를 대리하였다. 조지타운대학교 법학전문대학원에서 우등으로 법학 박사 학위를, 유타대학교 전기공학부에서 이학사 학위를 취득하였다.



Rian Kalden 유럽통합특허법원 항소법원 재판장

리안 칼덴(Rian Kalden) 판사는 UPC 항소법원 2부 재판장이며, UPC 의장단(Presidium)이다. 칼덴 판사는 2023년까지 네덜란드 헤이그 항소법원의 고등법원판사(Senior Judge)로 근무했다. 2018년 7월에 베네룩스법원 판사로 임명되었는데, 베네룩스법원은 벨기에, 네덜란드, 룩셈부르크 상표청 결정에 대한 항소사건을 관할한다. 2002년에 헤이그 지방 법원 판사로 법관에 입문하였고 특허부에 배정되었다. 법관이 되기 전에는 암스테르담 변호사협회 소속변호사로 활동했다. 칼덴 판사는 1989년 네덜란드 라이덴 대학교(Leiden University)를 졸업한 후, 1990년 런던 대학교에서 석사 학위를 받았다. 현재 특허법 관련 주제에 관하여 국내외 컨퍼런스에서 정기적으로 발표하고 있다.

패널



Randall R. Rader 미국 연방순회항소법원 전(前) 법원장, 레이더그룹 설립자

랜달 R. 레이더(Randall Ray Rader) 전 판사는 지식재산권법 및 법학 분야에서 사고(思考)를 선도하는 리더로 25년 이상 활동해 왔다. 저서를 집필하고, 전 세계 학생, 판사, 정부 관계자들을 대상으로 특허법을 교육하는 등 수석판사로서 수행해 온 다양한 활동은 전 세계 지식재산권 보호와 지식재산권법 분야에 지울 수 없는 자취를 남겼다. 레이더 전 판사는 1990년 조지 H. W. 부시 대통령에 의해 미국 연방순회항소법원에 임명되었으며, 2010년 6월 1일자로 법원장 직무를 시작하였다. 또한 1988년에 로널드 W. 레이건 대통령에 의해 미국 청구법원(현 미국 연방청구법원)에 임명된 바 있다. 연방청구법원에 임명되기 전에는 미국 상원 사법위원회의 소위원회에서 소수당 및 다수당 수석 법률 고문으로 활동하였다. 1975년부터 1980년까지는 하원에서 내무, 세출, 세입 위원회 소속 대표 의원들의 법률 고문으로 활동하기도 하였다. 2014년 5월 30일 법원장에서 물러난 후 2014년 6월 30일에 은퇴하였고, 퇴임 후에는 레이더그룹을 설립하여 중재, 조정, 법률 컨설팅, 법률 교육 서비스를 집중적으로 제공하고 있다.



이혜진 특허법원 고등법원판사

이혜진 판사는 현재 대한민국 특허법원 고등법원판사(재판장)이다. 2013년부터 2017년까지 특허법원 판사로 근무하였고, 2017년부터 2020년까지 대법원 재판연구관으로 근무하였다. 이혜진 판사는 IP 분야에서 10년이 넘는 실무 경험을 기반으로 다수의 주요 판례를 만드는 데 기여하였다. 또한 '의약품도발명의 특허법적 쟁점'(대법원 사법논집, 2016. 6.), '글로벌 백신 공급망 설계: 지적재산권과 코로나19 이후 백신 형평성의 균형'(BMJ Global Health, 2023. 11.) 등 다수의 논문과 칼럼을 집필하였다.



SESSION 1

New Approach to International Dispute Resolution

– Implementation of predictable and trusted procedural justice –



The Unified Patent Court

Rian Kalden

Member of the Presidium

Presiding judge 2nd panel

Court of Appeal

Unified Patent Court

All written and said is my personal view and not a communication of the UPC Court of Appeal.



Why the UPC was set up

- European Patents (EP) are granted in a centralized procedure by the European Patent Office (one stop shop).
- 38 Contracting States, including all 27 EU Member States and 11 other non-EU Member States
- The EP has the effect of a national patent in each Member State, Art. 2(2), 64(1) EPC
- In most of the cases, the EP can be enforced only State by State,
- the national courts of a Member State have *exclusive* jurisdiction on the validity of the EP for that Member State, and this applies also when a validity defence is raised; then infringement of a 'foreign' EP cannot be decided (Art. 24(4) Brussels Ia Reg, but case pending on this before the CJEU)



Jurisdiction

- Since 1 June 2023 UPC has jurisdiction on infringement and invalidity of
 - European Patents with Unitary Effect (Unitary Patents)
 - maintenance fees to EPC
 - European Patents (Bundle Patents) (that have not been opted out)
 - that occurred / in force in any of the **18 Contracting Member States**
 - in principle no jurisdiction outside territory of CMS (whether EU MS or other EPC country)
- Possibility to opt out from jurisdiction of the UPC
 - up to the end of a transitional period of 7 years
 - Withdrawal of opt out possible, unless national case already pending



Parallel jurisdiction

- between the UPC and national courts of CMS during transitional period
 - Exclusive jurisdiction of national courts for European Patents that are opted out
 - Exclusive jurisdiction of UPC for Unitary Patents
 - In parallel cases: Brussels regulation on *lis pendens*
- between the UPC in validity proceedings and the EPO / TBA in opposition and appeals
 - Possibility to request acceleration at the EPO as soon as UPC proceedings are pending.
 - The UPC *may* stay proceedings pending outcome at EPO



(Advantageous) procedural aspects of UPC

- UPC Agreement: basis
 - European Union law always applies and has primacy; Enforcement Directive on Evidence gathering; Preliminary measures and preliminary injunctions (possibly ex parte)
- Rules of Procedure: details
 - Mixture of Continental and Common law systems – ‘best of both’
 - General principle of proportionality, flexibility and fairness
 - *Cost effective* and *efficient*: hearing 1st instance within one year
 - Decisions on costs and damages at the same time or thereafter
 - **The unsuccessful party has to bear the costs of the successful party**
 - The defendant may request that the claimant provides a **security for the costs** of proceedings



Security for Costs

- Discretionary power of the court
- Criterion: if the financial position of the claimant gives rise to a legitimate and real concern that a possible order for costs may not be recoverable and/or the likelihood that a possible order for costs by the UPC may not, or in an unduly burdensome way, be enforceable
- burden of substantiation and proof on the defendant
- once the reasons and facts in the request have been presented in a credible manner, it is up to the claimant to challenge these reasons and facts and in a substantiated manner, especially since that party will normally have knowledge and evidence of its financial situation.
- It is for the claimant to argue that and why a security order would unduly interfere with its right to an effective remedy

Security for costs

- It is for the party requesting security (defendant) to provide publicly available financial information
- If that gives rise to legitimate and real concerns on recoverability of costs, then for claimant to show the availability of sufficient further assets
- The value of the patent (portfolio) invoked is not sufficient: if no infringement or revoked it does not present any sufficient value
- Sufficient financial funding to cover any possible cost orders against an NPE should be part of an appropriate financial funding of that business model
- In view thereof: the obligation to provide a security for costs cannot be considered to be an additional burden that hinders access to justice

(Advantageous) procedural aspects of UPC

- Oral hearing
 - Possibility of preliminary introduction / opinion by the presiding judge – focus on essence
 - Time limits for the hearing may be set in advance
 - Possibility to hear experts and witnesses at the hearing (possibly online), with cross examination
 - Endeavour to complete the oral hearing in one day.
- Videoconference
 - Hearings may be held by video conference when parties agree and under exceptional circumstances



(Advantageous) procedural aspects of UPC

- Language of proceedings:
 - CD: language of the patent
 - LD: language(s) of the division and one or more official EPO languages (English everywhere)
 - if several possibilities: chosen by claimant
 - But change of language to that of the patent is possible:
 - Upon agreement between the parties and the panel (JR may suggest)
 - By the President CFI at the request of defendant
 - CoA: language of proceeding CFI; if agreed: language of the patent
 - It may be requested that Exhibits do not require translation into language of proceedings



Thank you for your attention!

Preferred Forum in International IP Disputes

High Court Judge Hyejin Lee

국제 특허법원 콘퍼런스
2024 International **IPCourt**
Conference

2024 International
IP Court Conference
2024 국제 특허법원 콘퍼런스

CONTENTS

2024 International
IP Court Conference
2024 국제 특허법원 콘퍼런스

2024 International
IPCourt
Conference
국제 특허법원 콘퍼런스

1. International and Regional Integration Movements
2. Rise of NPE Litigation
3. Forum Shopping and Forum Selling
4. Preference for Resolving Disputes in Single Court
5. Seeking Unified Conclusion
6. Need for New and Innovative IP Court



1. International and Regional Integration Movements



[UPC Court of Appeal in Luxembourg]

- **Unitary Patent System:** Effective across all member states
- **Unified Patent Court:** A single court now having jurisdiction over unitary patents
- **Advantage:** alleviate increased costs and the possibility of inconsistent or conflicting rulings in different jurisdictions
- **Disadvantage:** the risk that a single lawsuit, if lost, could invalidate patents registered in multiple European countries at once

1. International and Regional Integration Movements



Patent Litigation Trends in Europe: Korean Companies vs. Foreign Companies

Year	2017	2018	2019	2020	2021	2022	2023	2024 (Aug)	Total
Plaintiff	3	2	6	4	3	8	-	1	27
Defendant	11	8	3	5	9	4	2	4	46
Total	14	10	9	9	12	12	2	5	73

(Source: Korea Intellectual Property Protection Agency)

1. International and Regional Integration Movements



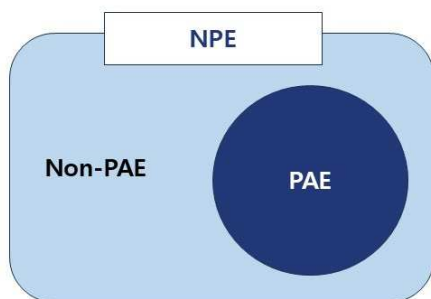
Unified Patent Court (UPC): Korean Companies vs. Foreign Companies

Year	2023	2024 Aug	Total
Plaintiff	3	3	6
Defendant	-	9	9
Total	3	12	15

☐ The UPC was established on June 1, 2023.

(Source: Korea Intellectual Property Protection Agency)

2. Rise of NPE litigation



➤ Patent assertion entities (PAEs):

- Aggressively pursue patent litigation to gain an advantage
- Referred to as "patent trolls"
- Negative impact on the innovation activities of targeted firms

➤ Non-PAE: Make profits without aggressive litigation



2. Rise of NPE litigation



- ❑ Increased Litigation Costs
- ❑ The Increase of Forum Shopping & Forum Selling
 - Choose courts in large markets and favorable to patent holders
 - File lawsuits in Texas and Delaware
- ❑ Litigation Funding
- ❑ No cross-license agreement

Does it stifle technological innovation? Pros and cons

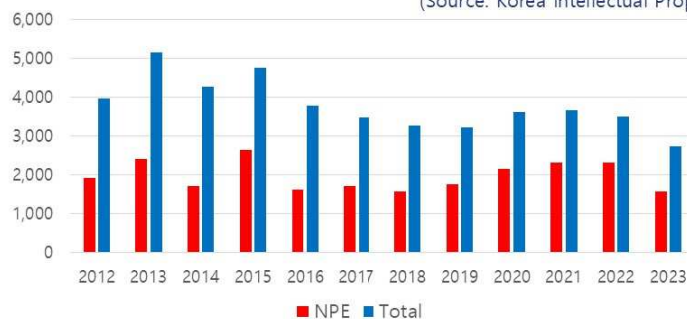
2. Rise of NPE litigation



Patent Litigation Trends in the U.S

Year	2012	2013	2014	2015	2016	2017	2018	2019	2020	2021	2022	2023
NPE	1,929	2,410	1,708	2,645	1,631	1,708	1,577	1,752	2,153	2,312	2,320	1,585
Total	3,979	5,149	4,269	4,763	3,782	3,489	3,271	3,218	3,624	3,666	3,496	2,736

(Source: Korea Intellectual Property Protection Agency)



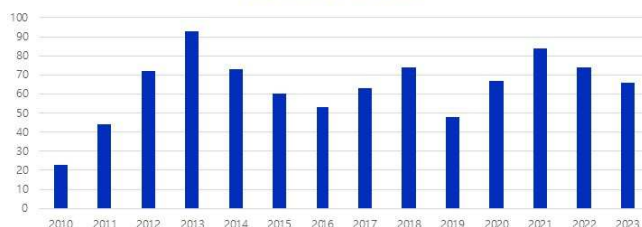
2. Rise of NPE litigation

NPE Patent Litigation Trends in the U.S.: Korean Companies vs. Foreign NPE

Year	2010	2011	2012	2013	2014	2015	2016	2017	2018	2019	2020	2021	2022	2023	2024 Aug	Total
Cases	23	44	72	93	73	60	53	53	74	48	67	84	74	66	52	946

(Source: Korea Intellectual Property Protection Agency)

The Number of Cases



3. Forum Shopping and Forum Selling



<https://tripakshalitigation.com/forum-shopping/>

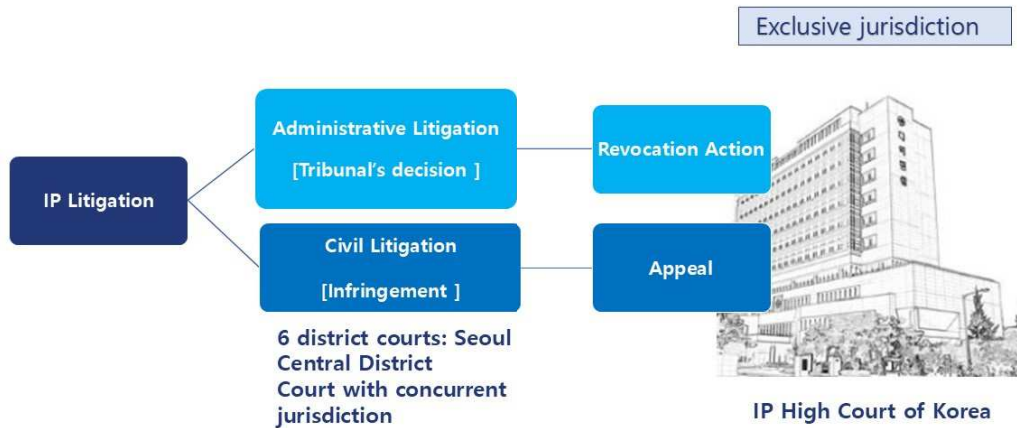
➤ Forum Shopping:

- Patent infringements occur simultaneously in multiple countries
- Patent holders choose more favorable and influential courts or jurisdictions

- ### ➤ Forum Selling:
- Courts promote favorable procedures to patent holders, encouraging plaintiffs to file lawsuits in their forums



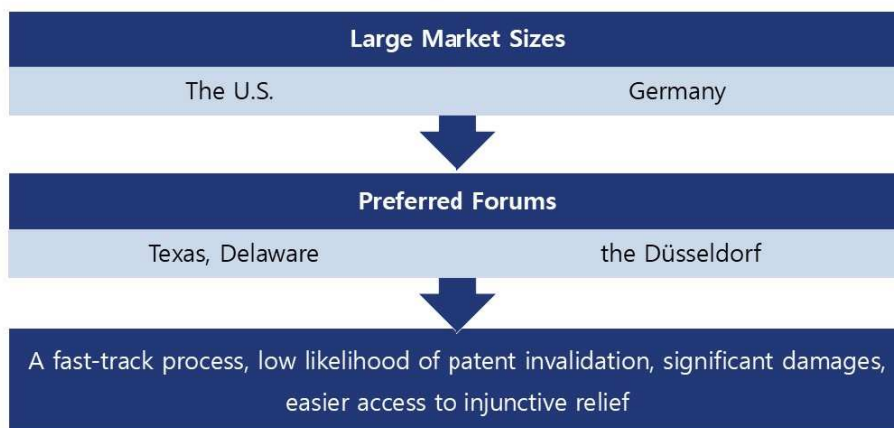
3. Forum Shopping and Forum Selling



3. Forum Shopping and Forum Selling

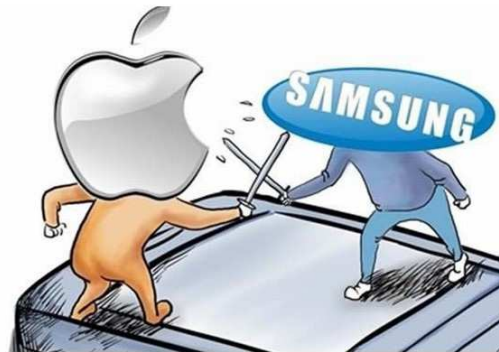


KINPA Survey (Sep. 2022)



4. Preference for Resolving Disputes in Single Court

- Korea?
 - ✓ Small Market Size
 - ✓ Not much impact or benefit from an injunction or infringement lawsuit
 - ✓ Lawsuits filed in the U.S. or Germany, where the market is large
- This trend has become prominent since the Apple and Samsung Electronics lawsuits in 2011.



<https://innovation-village.com>

4. Preference for Resolving Disputes in Single Court

2012

The US Jury



Awarded \$1 billion

2014

Jurisdiction agreements



Main legal battle in the US courts

2016

The US Supreme Court



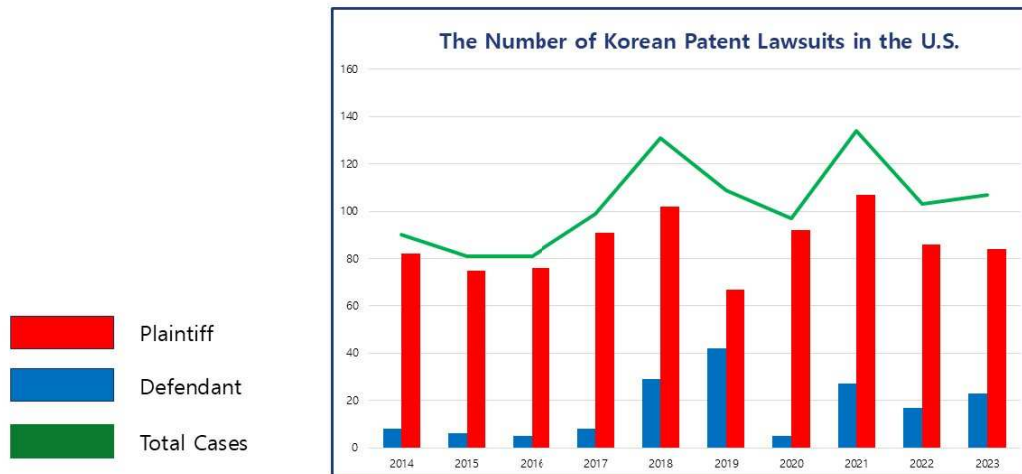
2018

Dispute settlements





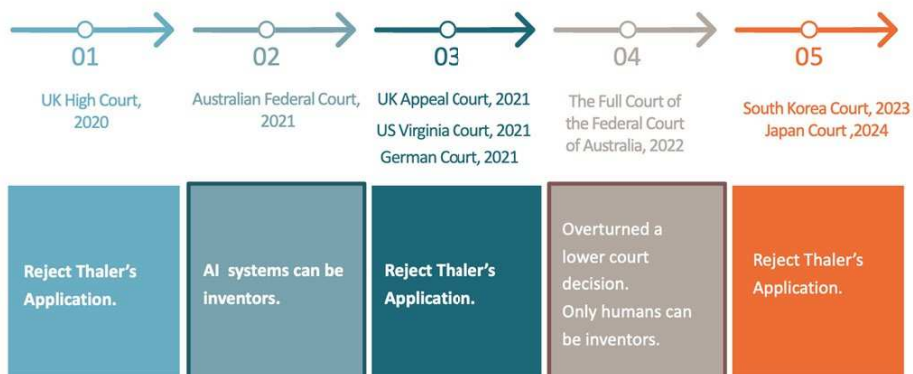
4. Preference for Resolving Disputes in Single Court



5. Seeking Unified Conclusion



Time Line of DABUS Litigations



5. Seeking Unified Conclusion



DABUS (2020 – Present)

1. Challenged the conventional practice and expectation
2. Rejected in most jurisdictions on the grounds that DABUS is not a natural person
3. Created international trend. **Courts look to other countries' cases to reach a unified conclusion**

The need for a united IP court: Cases occurring simultaneously around the world can be resolved uniformly in a united court.

6. Need for New and Innovative IP Court



New and **Innovative** Court

- IP disputes occur simultaneously worldwide, requiring **a unified resolution**.
- Geographic boundaries are collapsing due to the Internet, AI, metaverse, and cyberspace, creating the need for **new dispute resolution mechanisms**.
- There is a demand for courts with **large jurisdictions** that are **neutral** and **predictable** and that provide **legal certainty**.



6. Need for New and Innovative IP Court



RCEP: Nations signed up to world's largest free trade deal

■ ASEAN countries ■ Non-ASEAN countries



Source: ASEAN | As of December 27, 2021

•Short-term:

- ✓ Strengthen the international IP court as a Test Bed

•Long-term:

- ✓ Establish the Asian United Intellectual Property Court (AUIPC)
 - RCEP
 - trade and investment cooperation
 - protection of intellectual property rights
 - Metaverse court



Thank you

