

NewsLetter

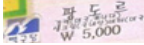

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GENERAL TOPICS

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The Korean Court's International Tribunal to be Established in June 2018

In June 2018, an international tribunal will be established in the Korean courts overseeing first or second instance cases of patent related actions, where parties may submit briefs and evidences and make oral arguments in a foreign language.

According to a bill to revise the Court Organization Act, which was passed on November 24, 2017, the Korean district courts, which hear first instance cases of infringement actions, and the Patent Court, which hears second instance cases, such as appeals in infringement actions or appeals against Intellectual Property Trial and Appeal Board "IPTAB" decisions, will each have an international tribunal to hear international disputes in a foreign language.

Under the previous system, Korean has always been the only language used in Korean courts. However, the amended law will now allow parties to submit briefs and evidences and make oral arguments in a foreign language under the consent of the parties. Upon ruling, the international tribunal will provide an officially translated English

version of its decision.

As the number of lawsuits involving foreign parties has been ever increased in Korean courts each year (i.e. over 40% of cases in 2016), there has been a subsequent rise in need to establish an international tribunal which would implement the hub court in resolving international patent disputes.

Meanwhile, the selection of foreign languages allowed in international cases will be determined by Supreme Court rules.

Fair Trade Commission Conditionally Approved Qualcomm's NXP Merger

On January 18, 2018, the Korean Fair Trade Commission (FTC) approved an M&A of Qualcomm (a US semiconductor company) and NXP semiconductor, and ordered Qualcomm to take corrective measures, such as selling patents regarding the near field communication (NFC) technologies.

Specifically, the FTC ordered Qualcomm to sell its NFC standard essential patents and system patents; not to exercise NXP's NFC patents or to provide free licenses for such patents; to disclose Qualcomm's NFC patents on fair, reasonable and non-

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discriminatory (FRAND) terms; not to sell the NFC chips in connection with provision of its licenses; not to hinder the interoperability between competitors' baseband chipsets, the NFC chips and secure element chips; not to reject requests for licenses for the NXP's MIFARE, etc.

According to the FTC, it is likely that the M&A of Qualcomm and NXP could result in activities restricting competitions regarding the NFC/MIFARE technologies in which NXP has market power. Although the business field of Qualcomm, which has market power in chipsets used in mobile communication technologies such as CDMA or LTE, and that of NXP do not overlap with each other, because the technologies of Qualcomm and NXP altogether are employed in mobile devices such as smartphones, it is likely that competitors are excluded and market entry barriers could be heightened in the future.

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Battery Boom Boosted by Eco-Friendly Policies, as Patent Applications for Li-ion Secondary Batteries Continue to Grow

The market for the lithium-ion (Li-ion)

secondary batteries mostly used in compact and portable electronic devices is expanding into the fields of power supplies for electric vehicles (EVs), Energy Storage Systems (ESSs) for new renewable energy, etc., in the wake of an increasing global trend of environment-friendly alternatives.

With France and UK announcing in July 2017 the suspension of sales of fossil fuel-powered vehicles by 2040, the global EV demand is expected to be poised to soar. Most notably, Tesla, a leading EV manufacturer, completed building a 100-megawatt Li-ion battery in South Australia last November, which has now officially become the world's largest ESS. The key technology for EVs and ESSs lies in the use of high-capacity batteries, such as Li-ion secondary batteries.

According to the Korean Intellectual Property Office, the number of international PCT patent applications for Li-ion secondary batteries increased from 764 in 2008 to 2,589 in 2017, that is, an annual growth of 14.5% in the last decade.

It is projected that the global market for Li-ion secondary batteries, which was merely worth roughly US \$31.2 billion (approx. 34 trillion KRW) in 2016, will potentially double in 2022 to roughly US \$67.7 billion (approx. 74 trillion KRW), attributable to the companies

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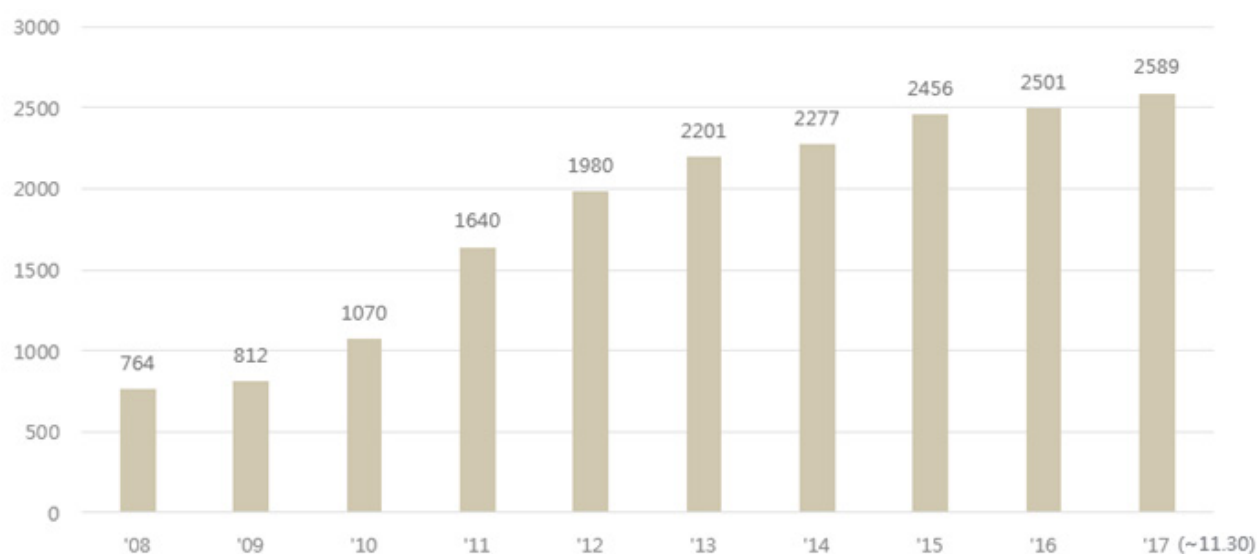
competitively striving to get ahead in owning patents for Li-ion secondary batteries.

Among the top three applicants in 2017 were Panasonic (1,187, 6.5%), LG Chem (1,104, 6.0%) and Toyota (1,088, 5.9%). Based on nationality, Japan topped the chart by a large margin (7,986, 43.7%), followed by U.S., Korea and Germany, while China, which is the most remarkable rising power in EV industry, was at the fifth closely chasing the other four contenders.

[Annex 1] International PCT applications for Li-ion Secondary Batteries

■ Published during '08~'17.11

Year of Publication	'08	'09	'10	'11	'12	'13	'14	'15	'16	'17	Total
Number of Applications	764	812	1,070	1,640	1,980	2,201	2,277	2,456	2,501	2,589	18,290



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Top 11 Applicants

Applicants	Number of Applications	Percentage
Panasonic / Sanyo (JP)	1,187	6.5%
LG Chem (KR)	1,104	6.0%
Toyota (JP)	1,088	5.9%
Bosch (DE)	696	3.8%
Hitachi (JP)	638	3.5%
Nissan (JP)	404	2.2%
NEC (JP)	299	1.6%
Toshiba (JP)	223	1.2%
Sony (JP)	215	1.1%
Samsung SDI (KR)	210	1.1%
Xeon (JP)	207	1.1%

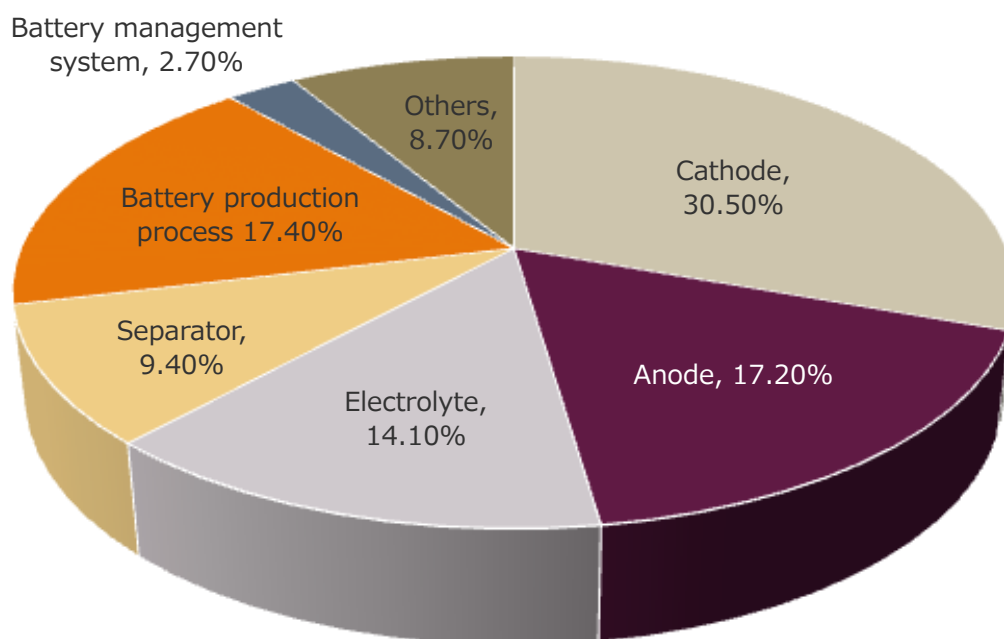
Applicants per Country of Residence

Applicants	Number of Applications	Percentage
Japan	7,986	43.7%
U.S.	2,377	13.0%
Korea	2,244	12.5%
Germany	1,872	10.6%
China	1,524	7.2%
Others	2,287	12.7%

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International Applications per Field of Technology

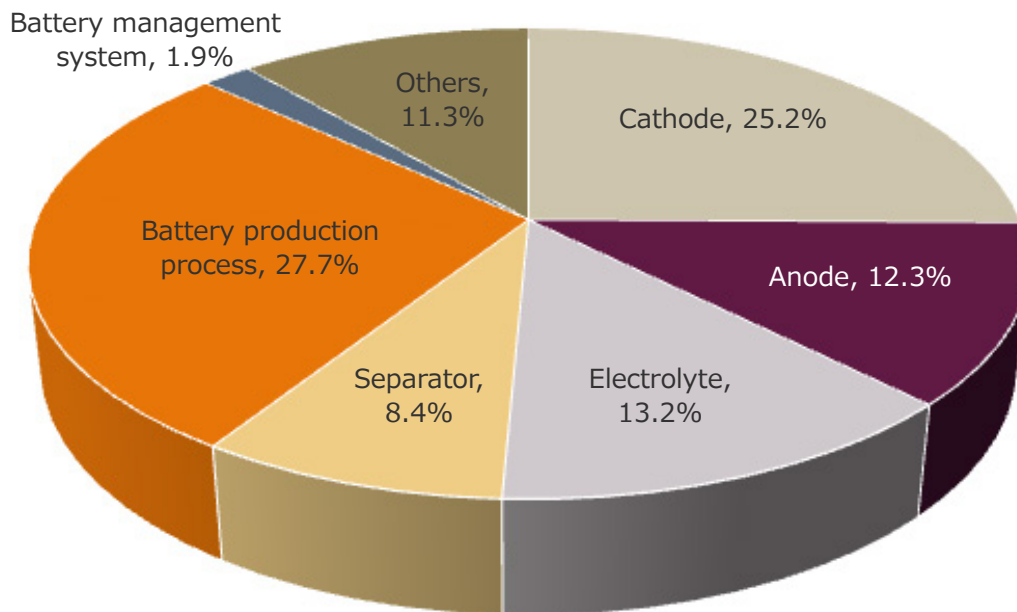
Field of Technology	Anode	Cathode	Electrolyte	Separator	Battery Production Process	Battery Management System	Others	Total
Number of Applications	5,584	3,150	2,575	1,724	3,185	487	1,585	18,290
Percentage	30.5%	17.2%	14.1%	9.4%	17.4%	2.7%	8.7%	100%



Domestic Applications per Field of Technology

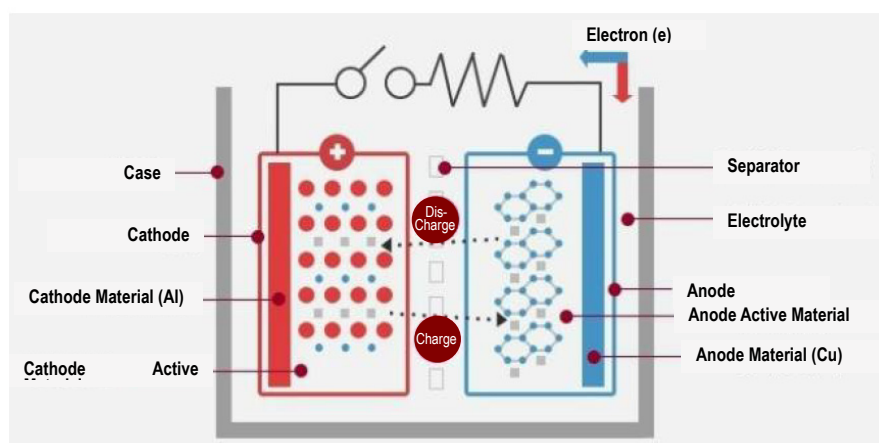
Field of Technology	Anode	Cathode	Electrolyte	Separator	Battery Production Process	Battery Management System	Others	Total
Number of Applications	566	275	297	188	622	42	254	2,244
Percentage	25.2%	12.3%	13.2%	8.4%	27.7%	1.9%	11.3%	100%

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A Li-ion secondary battery generally comprises a cathode, an anode, an electrolyte, and a separator. As shown in the charts above, international applications were filed most for anode technology at 30.5%, followed by cathode 17.2%, electrolyte 14.1%, separator 9.4%, and battery production process 17.4%. In Korea, applications for battery production process were at the top recording 27.7%, which is higher than foreign countries, while anode and cathode were lower in the ranking at 25.2% and 12.3%, respectively.

[Annex 2] Structure of Li-ion Secondary Battery



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Huge Number of Trials were Filed by Generic Pharmaceutical Companies under the Patent Linkage System

Since the enforcement of the patent linkage system in March 2015, the dispute between generic pharmaceutical companies taking the challenge of patents and original pharmaceutical companies attempting to reinforce the barrier of patents has been heated for the past three years.

According to the statistics of the Intellectual Property Trial and Appeal Board (“IPTAB”), a total of 2,928 trials were filed by generic pharmaceutical companies from the enforcement of the system to the end of 2017. The number of trials filed were concentrated in the first year of enforcement of 2015, with 2,222 cases, 311 cases in 2016, and 395 cases in 2017, and thus, it is viewed that the system is stabilizing as the number of the reckless filing of trials is decreasing.

In view of the types of trials, in 2015, there were 1,801 cases of invalidation trials (including invalidation of PTE), and 410 passive confirmation-of-scope trials, whereas in 2017, there have been 22 invalidation trials, and 372 passive confirmation-of-scope trials. Thus, it is displayed that the strategy of generic

pharmaceutical companies is changing to avoiding patents rather than invalidating patents.

The IPTAB indicated that 2,248 cases of 2,928 trials have been concluded. In view of the trial decisions, 265 invalidation trials (success rate of 24%), 1 PTE invalidation trial (success rate of 0.2%) and 465 passive confirmation-of-scope trials (success rate of 74%) took the side of generic pharmaceutical companies over the past three years.

Meanwhile, the hottest patent that has been challenged by many generic pharmaceutical companies is a patent in relation to Forxiga tablet for use in the diabetes treatment.

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Number of Trials Filed under the Patent Linkage System

(Unit: Case)

Type of Trial	Before March 2015	2015	2016	2017	Total
Confirmation-of-scope (Passive)	132	278	288	372	1,070
Confirmation-of-scope (Aggressive)	11	-	6	1	18
Invalidation	181	1,115	14	20	1,330
Invalidation of PTE	-	505	3	2	510
Total	324	1,898	311	395	2,928
	2,222				

Results of Trials Filed under the Patent Linkage System

(Unit: Case)

Type of Trial	Affirmed	Rejected	Refused	Withdrawn	Invalidated	Total
Confirmation-of-scope (Passive)	465	23	9	118	10	625
Confirmation-of-scope (Aggressive)	3	-	3	9	-	15
Invalidation	265	145	22	509	165	1,106
Invalidation of PTE	1	207	1	177	116	502
Total	734	375	35	813	291	2,248

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Top 10 Patents Challenged

(Unit: Case)

Rank	Patent No.	Confirmation - o f - S c o p e (Passive)	Invalida- tion	Invalidation of PTE	Total	Drug Product	Use
1	1021752	36	34	27	97	Forxiga tablet, etc.	Diabetes treatment
2	507400	53	27	-	80	Betmiga PR tablet	Hypersensitive bladder symptoms
3	1454051	26	36	-	62	Forxiga tablet	Diabetes treatment
4	15224164	57	3	-	60	Betmiga PR tablet	Hypersensitive bladder symptoms
5	691590	25	27	5	57	Xeljanz	Immunity suppressor
6	728085	27	1	29	57	Forxiga tablet	Diabetes treatment
7	1005716	26	30	-	56	Pradaxa capsule	Blood coagulation suppressor
8	1478983	25	31	-	56	Trajenta tablet, Glyxambi tablet	Diabetes traetment
9	480193	16	22	16	54	Viviant tablet, Duavive tablet	Follicle hormonal agent
10	619458	20	9	25	54	Duavive tablet	Blood coagulation suppressor

Patent Statistics for 2017

Number of Patent Applications Filed

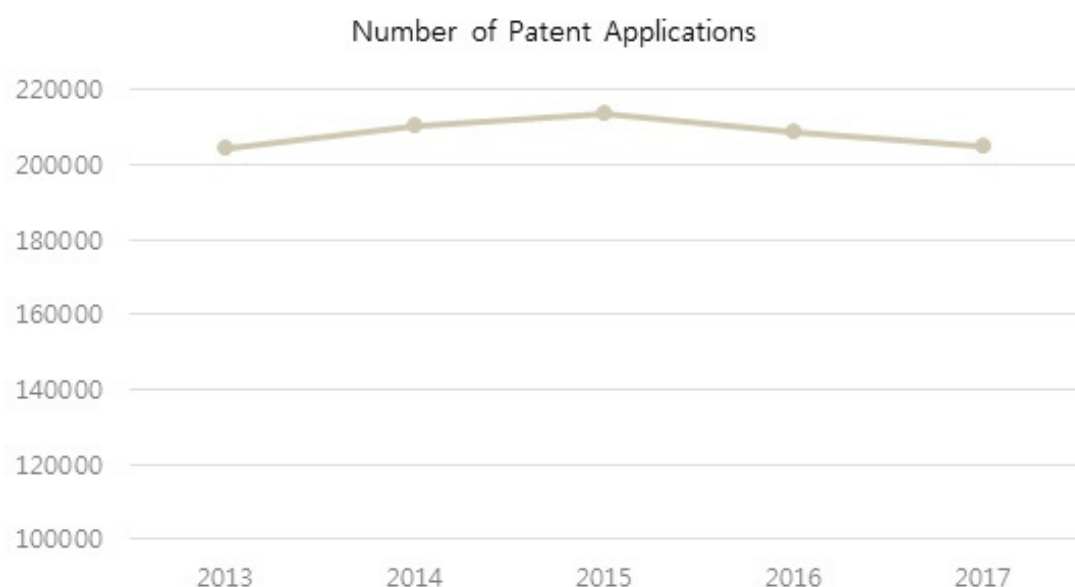
As shown in the table below, the number of patent applications filed for the last 10 years (2007 ~ 2017) shows a steady increase from 2009 to 2015, showing a decline for three years from 2007. Meanwhile, the number of patent applications has decreased somewhat in the last three years.

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(Unit: Case)

Year	'07	'08	'09	'10	'11	'12	'13	'14	'15	'16	'17
Number of Patent Applications Filed	172,469	170,632	163,523	170,101	178,924	188,915	204,589	210,292	213,694	208,830	204,775

A graphical representation of the number of patent applications over the last five years is provided below. It shows an increase until 2015, but it has been steady since then.

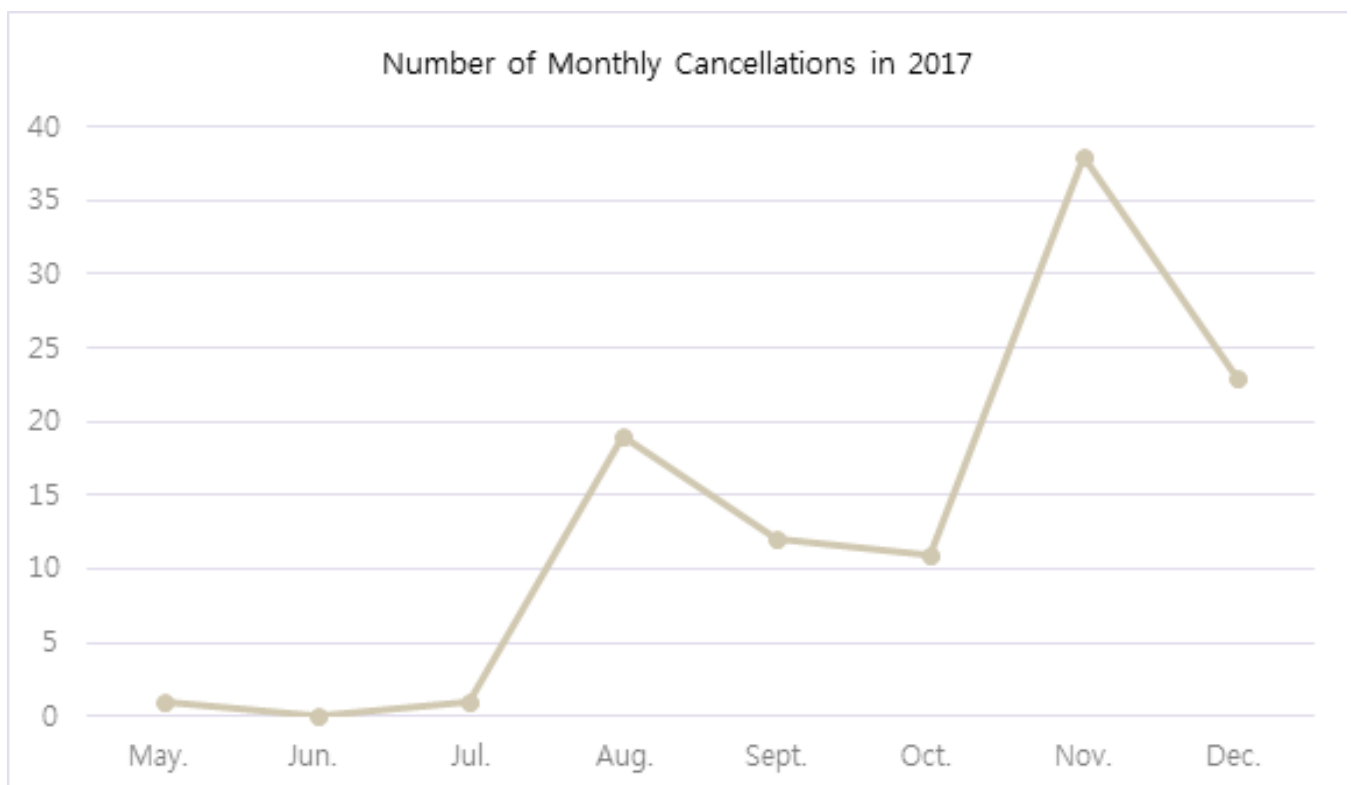


Number of Patent Cancellations Requested

In Korea, a patent cancellation proceeding was introduced in March 1, 2017 to allow any person to request the cancellation of a patent within six months after the publication of the patent. Unlike *inter partes* invalidation proceedings, *ex parte* patent cancellation proceeding is a cost-effective way to challenge the validity of a patent.

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From March 1, 2017 to the end of 2017, approximately 110 patent cancellations were requested.



TRADEMARKS

TRADEMARKS

“PRIMEWELL” Has a Distinctiveness for the Designated Goods and Services “Tires, Advertising and Marketing,” Etc.

The Patent Court ruled that the mark “PRIMEWELL” is distinctive for the designated goods and services “tires, wholesale and retail services of tires for vehicle wheels,” etc. (Case No. 2017 heo 1564, Ruled in May 19, 2017)

GITI Tire Pte. Ltd. (Hereafter “GITI”) filed an application to register the mark “PRIMEWELL” in Korea for the designated goods and services “tire, wholesale and retail services of tires for vehicle wheels,” etc. However, the “PRIMEWELL” mark was refused by the Korean Intellectual Property Office (KIPO) on the ground that it lacks distinctiveness in connection with the designated goods and services associated therewith. In a response to the KIPO’s refusal, the GITI filed an appeal with the Intellectual Property Trial and Appeal Board (IPTAB), but the IPTAB has affirmed the refusal by the KIPO. The GITI filed an appeal with the Patent Court.

The Patent Court examined whether the mark “PRIMEWELL” is perceived and pronounced in its entirety and then whether the mark in its entirety has a distinctiveness. The Patent

Court finally ruled as follows:

The mark “PRIMEWELL” is comprised of the words “PRIME” and “WELL” without a space between them. Thus, the mark “PRIMEWELL” cannot be logically separated into its individual words and examined on the basis of either “PRIME” or “WELL.” Furthermore, in Korean, the mark “PRIMEWELL” is pronounced in four syllables, and thus it is short for the Korean general public to pronounce. Accordingly, the Subject Mark in its entirety is pronounced. On the basis of the foregoing, it is reasonably concluded that the mark “PRIMEWELL” is perceived and pronounced in its entirety.

In addition, a combination of the words “PRIME” and “WELL” is an expression that does not fit the English grammar and is not a commonly used term to describe the nature of the designated goods and services in the relevant industry. In view of the foregoing, the mark “PRIMEWELL” would not be intuitively perceived as a term, which means “fine, high-quality, main, leading,” etc. Rather, the mark “PRIMEWELL” would be perceived as a coined term, which has no particular meaning.


Therefore, it can be concluded that the “PRIMEWELL” mark in its entirety is distinctive in connection with the designated goods and services associated therewith.

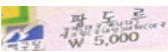

TRADEMARKS

According to the Patent Court decision, the “PRIMEWELL” mark was granted for registration.


The foregoing decision shows that if a mark is comprised of a combination of easy English words that directly describe the nature of the designated goods and/or services, even if the meaning of the mark can be easily inferred by consumers, whether or not a mark possesses distinctiveness should be determined on the basis of whether the combined expression is grammatically awkward or whether it is commonly used in the actual trade circumstances, etc. Thus, the Patent Court decision will be significant precedent in determining whether or not a mark possesses distinctiveness.

The Defendant's Use of the Mark

“” on “Bakeries, Bread” Does Not Fall Under the Scope of the Right of the Prior-Registered Mark “”

The Patent Court held that the defendant's use of the mark “” (Korean characters pronounced as /be-kku-dang-pang-do-leu/; “Subject Mark”) on “bakeries, bread” does not fall under the scope of the right of the prior-registered mark “” (“PainD'or” and its Korean transliteration; “Prior-Registered Mark”) (Decision No. 2017 heo 4440).

The plaintiff (the owner of the Prior-Registered Mark) filed a Confirmation Trial for the Scope of Rights seeking a decision that the defendant's use of the Subject Mark on “bakeries, bread” fall under the scope of the right of the Prior-Registered Mark. In this regard, the Patent Court concluded that the element “팡도르” (Korean characters pronounced as /pang-do-leu/) of the Subject Mark does not fall under the scope of the right of the Prior-Registered Mark.

The element “팡도르” (Korean characters pronounced as /pang-do-leu/) of the Subject Mark is indicated among the ingredients, origin and price of the product, and it is the common name of a certain type of bread. Therefore, the element “팡도르” would not be perceived as a source indicator of the goods associated with the Subject Mark. Rather, the element “” (Device and Korean characters pronounced as /be-kku-dang/) would be perceived as a source indicator.

Furthermore, it was found in the internet that the term “팡도르”/“Pandoro” means a kind of Italian bread. Therefore, in consideration of the widespread use of the internet and baking books as of the date on which the Patent Court decision was issued, the element “팡도르” of the Subject Mark indicates the common name

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of goods in a common manner, and thus lacks distinctiveness.

The plaintiff filed an appeal of the decision of the Patent Court with the Supreme Court, but the appeal was dismissed.

There is an opinion that a Confirmation Trial for the Scope of Rights lacks benefit since it does not bind civil or criminal courts. Nevertheless, the trial allows a prompt relief of infringement of a trademark right by officially confirming the scope of a trademark right, and, for such a reason, the trial is actively being used.

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Supreme Court Rules on Criterion of Conspicuous Geographical Names under Korean Trademark Act

A battle between two well-known food franchises in Korea fought over the tradename “Sariwon” (사리원), a city in Hwanghaebuk-do, North Korea, reached the Supreme Court. The Supreme Court finally rendered a judgment that invalidated the registration of that name as a trademark, thereby clarifying the scope of a “conspicuous geographical name” under Korean trademark act .

Under Article 33, Paragraph 1, Subparagraph 4 of Korean Trademark Act, a “conspicuous geographical name” is not allowed to be registered as a trademark. In 1992, the owner of a bulgogi restaurant named “Sariwon Bulgogi” attempted to file an application for trademark registration with the Korean Intellectual Property Office (“KIPO”), but was rejected on the ground that “Sariwon” is considered to be a “conspicuous geographical name”. Conversely, in 1996, an application for registration of “Sariwon Myeonok” filed by Sariwon Corp. was recognized and registered as a trademark by the KIPO even though the same geographical name Sariwon was included in its application. (“Myeonok” literally means “noodle house”; the term is commonly used in the name of Korean restaurants.)

Under these circumstances, Sariwon Corp. sent a cease-and-desist letter to Sariwon Bulgogi in 2015 to assert trademark infringement by Sariwon Bulgogi. After receiving such letter, Sariwon Bulgogi filed a litigation and claimed that “Sariwon” was not subject to trademark registration as it was a “conspicuous geographical name” under the Trademark Act. The Patent Court did not favor Sariwon Bulgogi.

The Supreme Court, however, had a different idea. It reversed and remanded the case to

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the Patent Court based on its determination that “Sariwon” was a well-known name with a long history. According to the Supreme Court, it was common for a city name to end in “won” (원(院)) for transportation hubs in the Joseon Dynasty period as well as in the Japanese colonial era in Korea; in addition to “Sariwon” in North Korea there are well-known cities in South Korea such as “Jochiwon”, “Itaewon” and “Toegyewon”. Also, Sariwon was consistently mentioned as the seat of the provincial government of Hwanghaebuk-do in South Korean students’ social studies textbooks from the 1960s to the present. The Supreme Court said that although news articles mentioning Sariwon were mainly concentrated in the 1920s through 1940s, the name had regularly appeared in North Korea-related news articles and weather reports indicating Sariwon as one of the main cities in North Korea. The Supreme Court also questioned the effect of a 2016 survey on customers’ awareness of the name Sariwon that was conducted by the Patent Court to decide whether Sariwon was a well-known name. The Supreme Court said a recent survey of public opinion conducted in 2016 could not possibly reflect how people recognized the name in 1996, the time when the trademark registration was actually decided.

The Supreme Court has declared that the criterion of being “conspicuous” for purposes

of the Trademark Act is how well the name is known to “general customers” at the time of deciding trademark registration. Through this case, the Supreme Court affirmed the same legal principle and added more detailed criterion that may help in resolving future cases.

Damages for Patent Infringement Notwithstanding Reliance on an Overturned Lower Court Judgment

A Korean pharmaceutical company released a generic drug before the patent term of an original drug expired, in reliance on the judgment of a lower court that had declared the patent for the original drug invalid. The Patent Court, however, recognized the liability of the company for damages caused by the release when the validity of the patent was upheld by a higher court.

Eli Lilly is a patentee of olanzapine, a medication used to treat schizophrenia and bipolar disorder. Eli Lilly has sold Zyprexa, whose active ingredient is olanzapine, in the Korean market through its subsidiary Lilly Korea for more than a decade. Meanwhile, Korean pharmaceutical company Myung In Pharm developed a generic drug for Zyprexa and initially planned to begin selling it sometime after April 24, 2011, the day when Eli Lilly’s patent for olanzapine was to expire.

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However, there was a turn of events. Another Korean pharmaceutical company, Hanmi Pharm, had filed a claim seeking invalidation of the patent for olanzapine, which claim was upheld by the Patent Court. As the news of the invalidation became public, Myung In Pharm advanced the time for selling its generic version of the drug to December 6, 2010 in an effort to dominate the market in advance, and has sold it ever since. Once generic drugs are out in the market, the price of the original drugs falls pursuant to the notification of the Ministry of Health and Welfare. This led to a reduction in the ceiling of health care benefits payable for Zyprexa by 20 percent from February 2011.

However, the Supreme Court cancelled the Patent Court decision and finally upheld the validity of Eli Lilly's patent for olanzapine. Based on the Supreme Court decision, Lilly Korea filed a claim for damages against Myung In Pharm for selling its generic drug before Eli Lilly's patent expired. Myung In Pharm claimed it simply had relied on the Patent Court's judgment that the patent was invalid, and had no intent to commit an illegal action.

However, the Patent Court refused the company's claim, saying "as a company with some 30 years of experience, Myung In Pharm was fully aware of the fact that Lilly Korea had been an exclusive licensee to import and sell

the products in Korea for 13 years from 1998 to April 2011, and also knew that there was a pending litigation to decide the validity of the patent before the Supreme Court and that the patent term for the original drugs had not expired yet." The Patent Court said, "It is widely known in the pharmaceutical industry that if generic drugs are released for the first time, the price for original drugs is customarily cut down by 20 percent according to standards of the Ministry of Health and Welfare." The Patent Court also added, "Myung In Pharm understood that if they filed a registration of the price of generic drugs with the same ingredients and dosage form as Lilly Korea and immediately started selling such drugs, it would lead to a reduction of the price of Lilly Korea's drugs causing financial damage." Based on the foregoing, the Patent Court determined that Myung In Pharm was liable for damages.

As in this case, if a pharmaceutical company has sold a generic version of a patented drug expecting the patent to be invalid based on the unconfirmed decision of a lower court, the company may be liable for damages caused by patent infringement if the patent is ultimately upheld.

LEE NEWS

LEE NEWS

New Member



Seung-Sun Lee (Patent attorney)

Ms. Lee has over 4 years of experience in the fields of electronics, semiconductor, communication, and circuit. Prior to joining Lee International, Ms. Lee worked at Koreana Patent Firm from 2015 to 2018. She graduated from Seoul National University in 2015.

Lee International Awarded IP ‘Law Firm of the Year’ in Korean Trademark Prosecution by ‘MIP Asia Awards 2018’



**FIRM OF THE YEAR
2018**

Lee International IP & Law Group was selected as Winner of South Korea Trade Prosecution Division at MIP Asia Awards 2018 hosted by the Managing Intellectual Property (MIP).

On May 22, the award ceremony held in Hong Kong was attended by attorney Mi-Cheong Lee and attorney Robert M. Kim of the firm.

The world-renowned Euromoney Legal Media Group’s intellectual property specialist media, MIP, provides news and in-depth analysis of IP trends around the world, and select their winners based on extensive research and interviews with IP practitioners and clients around the world.



Lee International, Selected as Law Firm of the Month by ILN

Lee International was selected as the “Law Firm of the Month” by the ILN (International Lawyer Network) (February and March of 2018). INL is a global legal network with more than 100 law firms in approximately 70 countries.



Lee International Employees Participate in Blood Donation Event

Lee International's employees participated in a joint blood donation event with Poongsan Group and Siemens Korea on Jan. 24 at the Poongsan building auditorium.





Lee International

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Lee International IP & Law Group was founded in 1961 and currently ranks as one of the largest law firms in Korea.

Lee International retains distinguished legal professionals with expertise in all major areas of the law, with a special focus on intellectual property. Recognized as one of the premier law firms in Korea, Lee International advises clients on a diverse range of high profile matters, including intellectual property disputes and litigation, licensing, commercial litigation, international transactions, real property matters, tax matters, and international trade disputes.

Lee International is a leader in patent prosecution, trademark prosecution, and IP disputes and litigation including patent litigation, trademark litigation, anti-counterfeiting matters, domain name disputes, copyright disputes and trade secret enforcement. Lee International counsels many Fortune 100 and other leading multinational companies on how to successfully maneuver not only through the complexities of Korean law, but also through the unique intricacies of doing business in Korea.