

Lee & Ko

IP PERSPECTIVE

Intellectual Property Group

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Lee & Ko's *IP Perspective* is the Lee & Ko IP Group's periodic report aimed at providing news and information on notable decisions, major trends, and key developments in Korea's IP legal landscape to our international readership. In addition to providing factual information, IP Perspective augments such facts with Lee & Ko's own in-depth analyses, opinions, and expert outlook on the latest IP and legal news.

In this issue of Lee & Ko's *IP Perspective*, we examine recent developments in Korean IP law concerning the extraterritorial reach of Korean IP rights and proposed changes to discovery procedures, with a focus on the following topics:

- 1. Recent judicial trends regarding the extraterritorial effect of Korean patent rights;
- Strengthening IP rights enforcement in international transactions –
 implications and prospects of recent amendments to the Korean Patent Act and
 Trademark Act; and

3. Expected judicial changes in civil procedure for better protection of IP rights holders. 10

Through this discussion, we aim to provide practical insights into how these legal changes may affect IP enforcement strategies and risk management for rights holders and businesses engaged with Korea.

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Recent Judicial Trends Regarding the Extraterritorial Effect of Patent Rights

Patent law has long been governed by the principle of territoriality: a patent granted in one country is enforceable only within that country's borders and does not extend to acts occurring abroad.

In view of the rapid growth of cross-border e-commerce and the development of digital markets where national borders are increasingly blurred, however, cross-border implementation of patented inventions has become increasingly common. Yet, the strict adherence to the principle of territoriality has often failed to prevent de facto circumvention of patent rights, prompting calls for stronger substantive protection. Unlike jurisdictions such as the United States, Korean law lacks explicit provisions addressing extraterritorial infringement. In addition, Korean courts follow the principle that indirect infringement must be predicated on direct infringement,1 making it difficult to enforce patent rights against domestic acts preceding extraterritorial infringement.

In 2019, the Korean Supreme Court recognized a substantive exception to territoriality for the first time in the "Suture Thread Decision." The Court held that direct infringement could arise if all components of a patented invention were manufactured in Korea, even if final implementation took place abroad.

More recently, Korean courts have issued a series of rulings relating to the application of the principle of territoriality and its exceptions, drawing considerable attention. This newsletter reviews the criteria established in the "Suture Thread Decision," analyzes subsequent Korean decisions adopting similar reasoning, and examines current judicial trends regarding the extraterritorial effect of patent rights.

- I. Judicial Doctrine on Exceptions to the Principle of Territoriality in Patent Rights
- 1. The Suture Thread Decision (Supreme Court Decision, No. 2019-Da-222782, 2019-Da-222799 (Consolidated) (dated October 17, 2019)): First Exception to **Territoriality Recognized in Korea**

In the "Suture Thread Decision," the Korean Supreme Court established that, under certain conditions, the act of manufacturing a patented product may be deemed to have occurred domestically, even if the act of manufacturing the product did not take place in Korea. This landmark case marked the Court's first recognition of a substantive exception to the principle of territoriality in the context of direct infringement.

The case involved a patented invention titled "An Apparatus for Inserting a Medical Thread and a Surgical Procedure Kit for Inserting a Medical Thread Comprising the Same," used to insert and fix surgical sutures within the human body.

Under the legal principle that indirect infringement can be established only when direct infringement has occurred (as affirmed by the Supreme Court Decision, 2014-Da-42110 (dated July 23, 2015), and others).



Claim 6, a dependent claim incorporating Claims 5 and 1, comprised (i) an insertion-path forming means (Element 1), (ii) a medical thread supplying means (Element 2), and (iii) a medical thread insertion device (Elements 3 and 4). These elements respectively corresponded to four individual products—catheter, hub, surgical suture, and suture support—manufactured in Korea and exported to Japan or Singapore. Since the final assembly occurred abroad, no manufacturing or sales activity took place within Korea and, thus, under a strict territoriality analysis, the acts of manufacturing and exporting the individual products were unlikely to be recognized as constituting patent infringement.

The Korean Supreme Court held, however, that for the purposes of patent protection, the product shall be regarded as having been produced domestically where: (i) all components or a substantially complete semi-finished product are manufactured in Korea; (ii) the product is exported to a single entity for final assembly; and (iii) the final processing is so minimal that the operative effect of the invention is already realized through the assembled components. The Court concluded that all three conditions were satisfied and, therefore, the defendants' conduct constituted infringement of Claim 6.

This decision by the Korean Supreme Court established an exception to the territoriality principle that when the final assembly steps involve only simple formalities performed overseas with the intent to avoid patent infringement, protection of the Korean patent holder should be upheld.

The Alibaba Decision (Intellectual Property High Court Decision, No. 2023-Na-10693 (dated May 22, 2025)): Reaffirming the Exception to Territoriality in the Digital Context

The Korean Intellectual Property High Court (formerly the Korean Patent Court) reaffirmed the substantive exception to the principle of territoriality in the so-called "Alibaba Decision," a case successfully handled by the Intellectual Property Group at Lee & Ko.

In this important follow-on case, a Chinese company Y advertised and offered for sale products covered by a Korean registered patent held by an Italian sock-knitting machine manufacturer L. The advertisements appeared on both the Alibaba e-commerce platform and Y's own website, where both entities' servers were located in China. Notably, product specifications were provided in Korean, prices were listed in Korean won, and the platforms enabled ordering and delivery within Korea, along with Korean-language customer service.

This case also concerned the principle of territoriality in patent rights where the central issue was whether posting products on an overseas e-commerce platform or foreign website with servers located abroad constituted an 'offer to sell' in Korea.

The court of first instance, the Seoul Central District Court, focused on the location of the servers and held that no act of practicing the patent had taken place in Korea. But the Intellectual Property High Court held that Y's conduct—specifically, (1) providing product details in Korean, (2) enabling domestic ordering and delivery,

(3) accepting payment in Korean won, and (4) offering inquiry and support services



for Korean consumers - collectively demonstrated a clear intent to target Korean customers. Accordingly, the Court ruled that Y had made an "offer for assignment" within Korea and upheld L's infringement claim, granting injunctive relief.

This decision is the first major precedent to explicitly recognize that a patent holder in Korea can exercise rights, including claims for injunctive relief, against sales based on patent rights with respect to the online sales activities of foreign entities. It is widely regarded as a landmark ruling that aligns patent enforcement with the realities of cross-border digital commerce.

II. The Vaccine Export Case (Supreme Court Decision, No. 2025-Da-202970 (dated May 15, 2025)): Limits of Applying the Exception

In contrast, in the recent "Vaccine Export Case," the Korean Supreme Court once again narrowly applied the territoriality principle in patent law.

In this case, a generic drug manufacturer S developed a version of a vaccine containing the same active ingredient as the original product developed by an innovator company P. S then entered into an agreement with a Russian pharmaceutical company N to export the generic product to Russia. Under the agreement, S transferred its vaccine manufacturing technology to N and supplied 13 types of conjugated bulk substances, as well as finished vaccine products, for use in non-clinical and clinical trials and technology transfer. N used the bulk materials supplied by S to manufacture the final vaccine in Russia and obtained marketing approval from the Russian authorities.

The original vaccine developer P subsequently filed suit against S, seeking injunctive relief and other remedies for patent infringement. One of the key issues was whether S's production of the 13 bulk substances - intermediate products - constituted infringement, despite the final mixing process occurring in Russia. The vaccine export case turned on whether the exception to territoriality recognized in the "Suture Thread Decision" could be applied.

The court of first instance, the Seoul Central District Court, citing the legal reasoning of the "Suture Thread Decision," held that S's domestic production of the 13 bulk substances constituted the substantive manufacture of the patented invention and thus amounted to direct infringement (Seoul Central District Court Decision, No. 2020-Gahap-591823 (dated August 10, 2023)).

On appeal, however, the Korean Intellectual Property High Court found that although the first two conditions of the "Suture Thread" test were met, the third condition was not met. Specifically, the Court held that the final processing was not "extremely minor or simple" and that the production of the bulk substances alone could not be deemed sufficient to realize the functional effect of the patented invention through the organic combination of its components (Korean Intellectual Property High Court Decision, No. 2023-Na-10914 (dated December 3, 2024)). The High Court emphasized that the final production of the vaccine required not just mixing, but the precise determination and control of factors such as input quantities, mixing ratios, mixing order, and processing conditions—including pH, temperature, stirring speed, and duration.



The Korean Supreme Court upheld this reasoning and dismissed P's appeal. It emphasized that exceptions to the principle of territoriality must be narrowly construed and offered the following reasons: (1) the final step could not be deemed "extremely minor or simple" because the mixing of the 13 conjugated antigen components involved multiple critical variables (e.g., quantity, ratio, sequence, pH, temperature, agitation speed/time), all of which could significantly affect the vaccine's immunogenic properties; and (2) the production of the individual bulk materials alone was insufficient to implement the invention as defined in Claim 1 and without proper control of these variables, the target 13-valent immunogenicity might not be achieved.

In addition, P also argued that S had committed indirect infringement under Article 127(1) of the Patent Act by manufacturing exclusive-use products. The Korean Intellectual Property High Court rejected this claim, and the Korean Supreme Court affirmed, holding that the lower court had correctly applied the relevant legal doctrine. As a result, the Korean Supreme Court reaffirmed the precedent established in Korean Supreme Court Decision, No. 2014-Da-42110 (dated July 23, 2015).²

This decision confirms that (i) in cases of indirect infringement, the territoriality principle is strictly applied under the dependency theory, and (ii) in cases of direct infringement, each requirement for an exception under the Suture Thread Decision must be carefully and narrowly evaluated.

III. Principle of Territoriality Yet to be Set Aside

As discussed above, since the Korean Supreme Court first articulated a standard for recognizing direct infringement as an exception to the principle of territoriality in the "Suture Thread Decision," subsequent rulings—such as the "Alibaba Decision" and the "Vaccine Export Decision"—have further clarified and refined the criteria for applying such exceptions. Ultimately, Korean courts appear to weigh the relative significance of domestic acts versus final manufacturing acts abroad on a case-by-case basis in determining whether the territoriality principle should be relaxed.

Legal disputes raising exceptions to territoriality are expected to increase, particularly as Korean companies increasingly collaborate with global partners in manufacturing and service sectors to address rising labor costs and inflation. Accordingly, based on the specifics of the relevant industry, it is becoming more important for international patent holders to craft litigation strategies that demonstrate clearly how their patented inventions were implemented substantially through acts occurring solely within Korea.

While some jurisdictions already recognize extraterritorial acts as constituting patent infringement (or indirect infringement), Korean courts have yet to render definitive judgment on the applicability of Korean patent law to acts committed entirely abroad. Accordingly, future legal developments on this issue merit close and continued attention.

² Under the dependency theory of indirect infringement, the act of producing a semi-finished product constitutes indirect infringement only when a corresponding act of direct infringement occurs within Korean territory. In this case, the Korean Intellectual Property High Court held that no direct infringement had occurred.



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Strengthening IP Rights Enforcement in International Transactions – Implications and Prospects of Recent Amendments to the Korean Patent Act and Trademark Act

As of 2024, Korea ranks as the 6th largest exporter and the 10th largest importer in the world. Like many leading international economies, Korean industry is heavily reliant on trade. With increasing cross-border movement of goods and growing international transactions characterized by direct purchase by individual consumers via e-commerce platforms, new challenges are emerging in intellectual property (IP) protection, particularly concerning the scope of infringing acts.

Recent amendments to the Korean Patent Act and Trademark Act have expanded the scope of infringing acts to include international transactions, thereby strengthening the practical protection available to Korean IP rights holders.

I. Amendments to the Korean Patent Act and Utility Model Act: Explicit Inclusion of "Export"

1. Limitations Before the Amendment

Previously, the Korean Patent Act and Utility Model Act defined acts of practicing an invention as "manufacturing, using, assigning, leasing, importing, or offering for assignment or lease," but did not include "exporting." Courts also held that export was not encompassed within assignment (see Seoul High Court Decision, 2015-Ra-20296 (dated Aug. 21, 2017)). In Korea, this interpretation was based on the rationale that banning the preceding acts of export—such as domestic manufacture or assignment—would effectively prohibit export itself, thus rendering an explicit reference unnecessary.

In practice, however, if a rights holder could not detect domestic manufacturing or assignment by the infringer, it was impossible to take enforcement actions, such as an injunction, solely against exportation, even if such export was discovered. Moreover, since it is possible to export without domestic manufacture or assignment, this posed a limitation in protecting patent rights in Korea.

2. Key Points and Significance of the Amendment

To address this issue, as of January 21, 2025, amendments to the Korean Patent Act and Utility Model Act explicitly include "export" as a type of practice of an invention (to be enforced from July 22, 2025). As a result, rights holders can now claim infringement based solely on an act of export, and pursue injunctive relief, damages, and even criminal penalties. See Patent Act Article 225 (providing potential remedies of imprisonment for up to 7 years or a fine of up to KRW 100 million).



This amendment aligns the legal framework with other IP related laws in Korea, such as the Design Protection Act, Trademark Act, Plant Variety Protection Act, and Unfair Competition Prevention Act, all of which already included "exporting" as an act of practicing. It also greatly enhances the practical remedies available to Korean IP rights holders, enabling not only administrative measures (e.g., export restrictions or fines under the Unfair Trade Investigation Act) but also civil and criminal responses.

	Article 2 (Definitions) The terms used in this Act are defined as follows:
	1.~2. [omitted]
	3. The term "practice" means any of the following acts:
Before Amendment	(a) An invention of a product: Manufacturing, using, assigning, leasing, or importing the product or offering to assign or lease the product (including displaying the product for the purpose of assigning or leasing; hereinafter the same shall apply);
	(b) [omitted]
	(c) An invention of a process of manufacturing a product: Using, assigning, leasing, or importing the product manufactured by the process or offering to assign or lease the product, other than the acts specified in item (b).
	Article 2 (Definitions) [unchanged]
	Article 2 (Definitions) [unchanged] 1.~2. [unchanged]
After Amendment	1.~2. [unchanged]
	 1.~2. [unchanged] 3. [unchanged] (a) An invention of a product: Manufacturing, using, assigning, leasing, exporting, or importing the product or offering to assign or lease the product (including displaying the product for the purpose of assigning or leasing; hereinafter the same
	 1.~2. [unchanged] 3. [unchanged] (a) An invention of a product: Manufacturing, using, assigning, leasing, exporting, or importing the product or offering to assign or lease the product (including displaying the product for the purpose of assigning or leasing; hereinafter the same shall apply);

3. Practical Impact and Expected Benefits

With export recognized as a standalone infringing act, proving patent infringement has become less burdensome and rights holders can act more quickly and effectively. From a litigation perspective, exports almost always involve customs declarations, making it easier to obtain information about export details or volumes through fact inquiries to the customs offices during litigation. This data can help establish both the existence of patent infringement and the amount of damages (i.e., the infringer's gains) more easily.



II. Amendment to the Korean Trademark Act: Expanded Definition of "Use of a Trademark" and Countermeasures Against Counterfeit Goods

1. Background of the Amendment³

The growth of global e-commerce and cross-border online shopping has led to a surge in counterfeit goods manufactured overseas entering Korea. In 2023 alone, Korea saw approximately 140 million inbound cross-border purchases, and counterfeit imports increased by around 44% over the past three years. With the growing popularity of Korean brands, nearly 40% of counterfeit reports now involve Korean brand imitations, and some contain hazardous substances, raising safety concerns.

Legal debate among scholars and practitioners emerged over whether providing such cross-border goods constituted "use of a trademark" under the Korean Trademark Act. Previously, "assignment of goods marked with a trademark" was interpreted as domestic direct assignment only. This led to uncertainty over whether individuals' direct overseas purchases of infringing products supplied by a foreign supplier constituted trademark use in Korea. As such, there was growing demand by the Korean legal community for a clear statutory basis to more effectively control counterfeit imports.

2. Key Points of the Amendment

The May 27, 2025 amendment to the Korean Trademark Act (effective the same day) added the following provision to the definition of "use of a trademark" (Article 2(1)(11)):

"Supplying goods or packaging marked with a trademark from abroad into Korea through a third party such as a courier service."

This amendment establishes a clear legal basis for deeming the supply of counterfeit goods, when shipped from abroad via intermediaries, as trademark infringement.

Before Amendment	After Amendment
 Article 2 (Definitions) (1) The terms used in this Act are defined as follows: 1.~10. [omitted] 11. The term "use of a trademark" means any of the following: (a) Displaying a trademark on goods or packages of goods; 	Article 2 (Definitions) [unchanged] 1.~10. [unchanged] 11. [unchanged] (a) [unchanged]

³ Press release by the Korean Intellectual Property Office, dated May 2, 2025



Before Amendment	After Amendment
 (b) Transferring or delivering goods or packages of goods on which a trademark is displayed, providing such goods or packages through telecommunications lines, or exhibiting, exporting, or importing them for the purpose of such transfer, delivery, or provision; (c) Displaying a trademark on advertisements for goods, price tags, transaction documents, 	 (b) [unchanged] (c) Supplying goods or packaging marked with a trademark from abroad into Korea through a third party such as a courier service; (d) [unchanged]
or other means, and exhibiting or giving wide publicity to the trademark.	

3. Practical Impact and Expected Benefits

The recent amendment legally regulates the entry of counterfeit goods from overseas, significantly strengthening Korean IP border enforcement (e.g., customs suspension of clearance).

Notably, under the amended law the infringer is the foreign seller, and since the act of supplying counterfeit goods into Korea now constitutes trademark infringement under the amendment, customs can take actions (e.g., seizure or suspension) at the point of entry, making the amendment highly effective.

III. Increased Importance of Border Measures for IP Protection

The recent amendments to the Korean Patent and Trademark Acts mark a significant milestone in strengthening IP protection in Korea's global trade context. These changes enhance the enforcement options available to IP rights holders, help block counterfeit goods, protect public safety, and promote fair market practices.

In particular, because both exports and cross-border e-commerce inevitably involve customs clearance, close cooperation with Korean customs authorities will be essential in enforcing IP rights against export or import of infringing goods moving forward. Accordingly, Korean IP rights holders should proactively engage with Korean customs to detect infringement, gather evidence, and swiftly exercise their rights.

Lee & Ko's IP Practice Group has extensive experience in customs-based enforcement and is fully prepared, in close coordination with our Customs Practice Group, to respond to new and emerging cases centered in Korea.



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Expected Judicial Changes in Civil Procedure for Stronger Protection of IP Rights Holders

I. Recent Changes in IP Laws for Strengthened IP Protection: **Enhanced Damages**

Since 2019, Korea has gradually introduced enhanced damages provisions for intentional infringement across multiple statutes, including the Patent Act, Utility Model Act, Unfair Competition Prevention Act, Trademark Act, Design Protection Act, and the Act on the Prevention of Divulgence and Protection of Industrial Technology. When first enacted, the maximum multiplier was capped at three times the actual damages. This has since been increased to five times for willful patent and utility model infringements as well as trade secret misappropriation, as discussed in IP Perspective 1st Edition.

The Busan District Court was the first to award punitive damages (Busan District Court Decision, 2023-Gahap-42160, Oct. 4, 2023).4 The details of this decision were covered in IP Perspective 2nd Edition. In addition, recent amendments to the Trademark Act, Design Protection Act, and the Act on the Prevention of Divulgence and Protection of Industrial Technology - effective July 22, 2025 - have extended the fivefold damages cap to most of the Korean IP statutes.

Alongside these changes, the Korean government and legislators have been considering new discovery mechanisms in civil litigation to enhance IP enforcement. Under the current Civil Procedure Act, plaintiffs bear the burden of proving both infringement and damages, and they must obtain relevant evidence themselves. Only limited discovery is available and at the court's discretion. This is particularly challenging in IP litigation, where defendants typically control the key evidence, often refuse disclosure, and invoke trade secret protections – especially when the defendant is a competitor. With a long-standing demand for discovery reform and the new government's focus on preventing "technology theft," the introduction of new discovery tools appears increasingly likely. This article reviews discovery mechanisms proposed in pending bills before the National Assembly.

II. New Discovery Mechanisms in Proposed Patent Act Amendments

The proposed Patent Act amendment, led by the Korean Intellectual Property Office (KIPO), seeks to reduce the patent holder's evidentiary burden in patent infringement lawsuits by creating new mechanisms to facilitate evidence collection.

1. Expert Fact-Finding

Under the proposed amendment, courts may appoint experts (technical examiners, investigation officers, expert advisors, attorneys-at-law, patent attorneys, etc.) to assist in proving infringement or calculating damages. These experts could request data from the opposing party, inspect facilities, documents, equipment, and other relevant items, and make inquiries with interested parties.



The investigated party would be allowed to review the expert's report and request redaction of trade secrets. However, the court may deny the party's request to delete content necessary to prove infringement or damages. The court may also limit the scope of inspection and restrict who may access the report. The patent holder would then be able to inspect and use the report as evidence.

2. Inter Partes Depositions

The amendment introduces a deposition system, allowing parties to cross-examine each other. Courts would determine the number of deponents, as well as the scope, method, and location of examinations. Depositions may be audio - or video - recorded, and relevant excerpts may be submitted as evidence.

3. Litigation Hold

When a patent infringement action is filed - or is likely to be filed - the court may order, upon petition, a litigation hold for up to one year if the data is sufficiently specified and irreparable harm would otherwise occur. If a person possessing, managing, or retaining the data fails to comply, the court may deem the petitioner's allegations as true.

III. Discovery Obligations and Protective Measures in Proposed **Civil Procedure Act Amendments**

A separate amendment to the Civil Procedure Act, proposed by the ruling party in April 2025, introduces broader reforms applicable to all civil litigation but with particular impact on IP cases, where unequal access to evidence has long hindered enforcement.

1. Enhanced Duty to Disclose

The amendment imposes a general obligation to disclose relevant materials. Any person possessing (including indirect possession), managing, or retaining documents or other materials related to facts at issue in litigation may not refuse production. Exceptions apply for privileged materials (such as those covered by governmental / executive privilege or privacy interests) or where production would be disproportionately burdensome, under the principle of proportionality.

This represents a significant expansion from the current law, which is limited to documents and provides broad exemptions. The new rule applies to all relevant materials, introduces proportionality, and grants courts greater discretion in defining disclosure obligations.

2. Protective Orders

To balance the enhanced disclosure obligations with confidentiality protection, the amendment authorizes protective orders. Courts, either on their own initiative or upon application, may restrict the use and disclosure of produced materials. Such orders may require that documents be used solely for litigation purposes and restrict access to authorized individuals only.



Importantly, courts may also restrict parties themselves from accessing certain materials. This restriction is designed to alleviate concerns about disclosing competitively sensitive information to adversaries and may encourage greater compliance with disclosure obligations.

3. Sanctions for Noncompliance

Currently, the sanction for failing to comply with a production order is limited to the court deeming the petitioner's allegations as true. Under the amendment, the sanctions are broadened to include deeming facts as established, entering judgment against the noncompliant party, shifting litigation costs, or imposing monetary fines. The court may impose one or more of the available sanctions. In addition, violation of a protective order may result in criminal liability.

IV. Potential Reshape of Landscape for IP Protection and Litigation

Although the Korean government and courts have made significant efforts to strengthen protection of IP rights in Korea, IP litigation in Korea has long faced the issues of relatively low damages awards and difficulties in evidence collection. While reforms to allow enhanced damages have addressed the concerns regarding remedies, limited discovery has remained a weak point. With the government's renewed interest in preventing technology theft, the proposed reforms suggest that Korea is moving toward a more robust discovery framework—one that could fundamentally reshape the landscape for IP protection and litigation. If enacted, these reforms are expected to facilitate more effective enforcement for IP rights holders in Korea.

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This decision was upheld by the Korean Intellectual Property High Court. See Korean Intellectual Property High Court Decision, 2023-Na-11276 (dated October 31, 2024)