

# 2025 FICPI Symposium

Jeju Korea



FÉDÉRATION INTERNATIONALE DES CONSEILS  
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF  
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION  
VON PATENTANWÄLTEN





# ENFORCEMENT TOPIC 1

**Evidence and common sense  
are needed to determine where  
the truth lies**



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4 April 2025  
11:00-12:30



# Julian Crump (Moderator)

Mr Crump is a partner in the firm, Abel & Imray LLP, UK. He has a degree in Natural Sciences (Chemistry) from Cambridge University, and is a Chartered Patent Attorney & European Patent Attorney, with more than 35 years' experience. He has a particular focus on pharmaceuticals, small molecules, diagnostics, medical devices, optics & mechanics.

He has been actively involved in FICPI for over 25 years, and served as President from 2018-2022.



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**Abel+Imray**



# Judge Young Gi KIM

Judge Kim studied jurisprudence at the Korea University in Seoul and completed his LL.M. (IP Specialization) at UCLA in California. He was invited to the U.S. District Court for the Eastern District of Texas as a fellowship judge for about 6 months. He has been on the bench for about 17 years and served as the Director of Judicial Policy at the National Court Administration of South Korea. Currently, he is on the bench of the Intellectual Property High Court of Korea as a High Court Judge.



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INTELLECTUAL PROPERTY HIGH COURT



# Dong Suk BAE

Mr Bae is Executive Vice President and Head of IP Monetization & Venture Investment at Intellectual Discovery in South Korea. He has completed many litigations in the U.S., the UPC and Japan.



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# Claus BECKER

Mr Becker is a German and European Patent attorney, who is involved in patent prosecution and litigation, including before the UPC. Based in Hamburg, Germany, he is co-managing partner of his firm GLAWE DELFS MOLL. He has a background in aerospace engineering, and works in wide range of technical fields from semiconductor manufacturing, OLED technology, computer implemented inventions to egg packaging. He is a member of the Board of the German Patent Bar Association Mr Becker is an active member of FICPI's CET 7 “Enforcement and ADR.



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GLAWE · DELFS · MOLL



# Dominic ADAIR

Dr Adair is a partner in the IP litigation practice of Bristows LLP, London. He has experience in advising on a variety of disputes including patent litigation, copyright and designs, trade marks and commercial litigation and arbitration. Dr Adair has an MA in Biological Sciences & a PhD in Zoology from the University of Cambridge, where he was Captain of the Boats at Fitzwilliam College.



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**Bristows**



# Raja SALIBA

Mr Saliba is a senior patent litigation partner and Electrical/Mechanical Practice Group Leader in the Washington D.C. office of Sughrue Mion LLP. He has over 22 years' experience in representing clients in contentious matters, including disputes before Federal District Courts, the International Trade Commission, the Federal Circuit and the PTAB. His cases have covered multiple technology areas, including many chemical and materials science matters.



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# Topics for discussion

- **Legal Frameworks:** Principles of Litigation in DE, KR, EN, US & UPC
- **Hypothetical Case Study:** NanoShield v. K-Tech
- **Assessment of Infringement:** Approaches, Construction, Equivalents & Evidence
- **Validity Challenges:** Anticipation, Obviousness & Insufficiency
- **Remedies:** Injunctions, Damages & Profit Recovery
- **Evidence Collection & Submission:** Types of Evidence, Witnesses, Court Experts, Timelines & Cost Implications
- **Expert Testimony:** Significance, Risks, Best Practices
- **Summary**



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# 1. Overview of Legal Frameworks: Principles & Procedures of Litigation for the following jurisdictions: Germany, South Korea, England & Wales, the United States, & the UPC

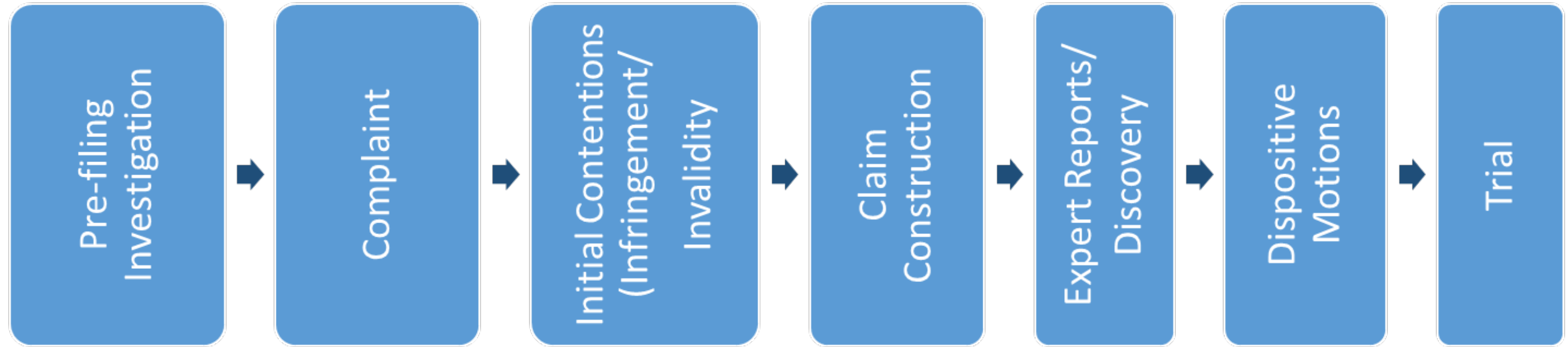


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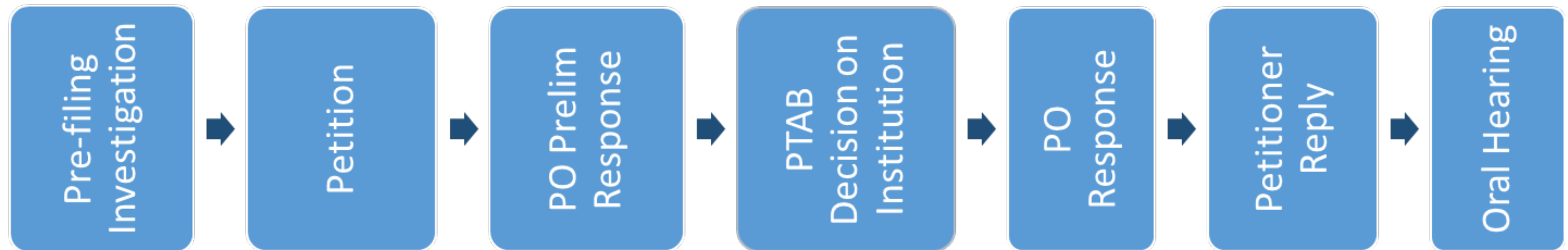
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## District Court Litigation (Plaintiff/Defendant)



## PTAB Proceedings (Petitioner/Patent Owner)



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## 2. Hypothetical Case Study: NanoShield Ltd v. K-Tech Inc.



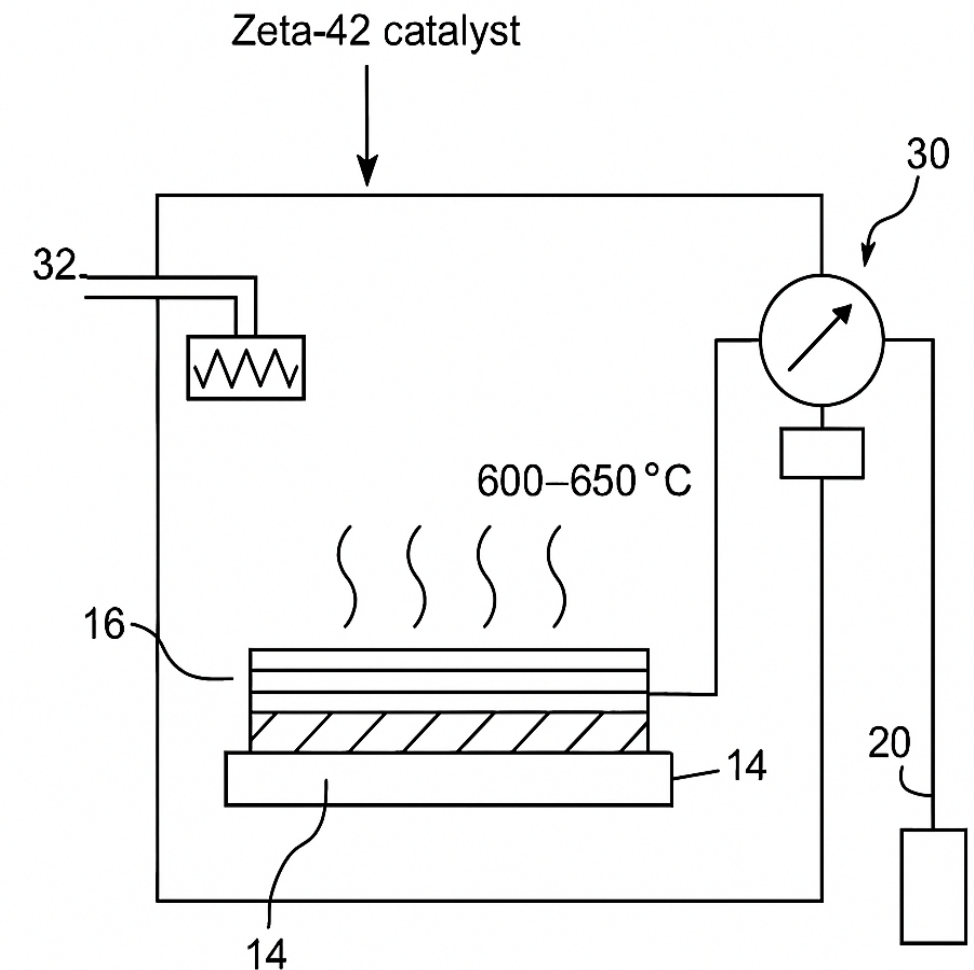
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# EP 3 123 456 (NanoShield Ltd)

1. A method for forming a nano-coating on a semiconductor component to improve durability and heat resistance, comprising:
  - introducing a Zeta-42 catalyst into a reaction chamber with a semiconductor substrate;
  - heating the reaction chamber to about 600°C–650°C;
  - depositing multiple coating layers under the heated conditions in the presence of the catalyst; and
  - controlling reaction duration, pressure, and catalyst concentration;wherein the resulting nano-coating substantially increases the semiconductor component's durability and thermal resistance.

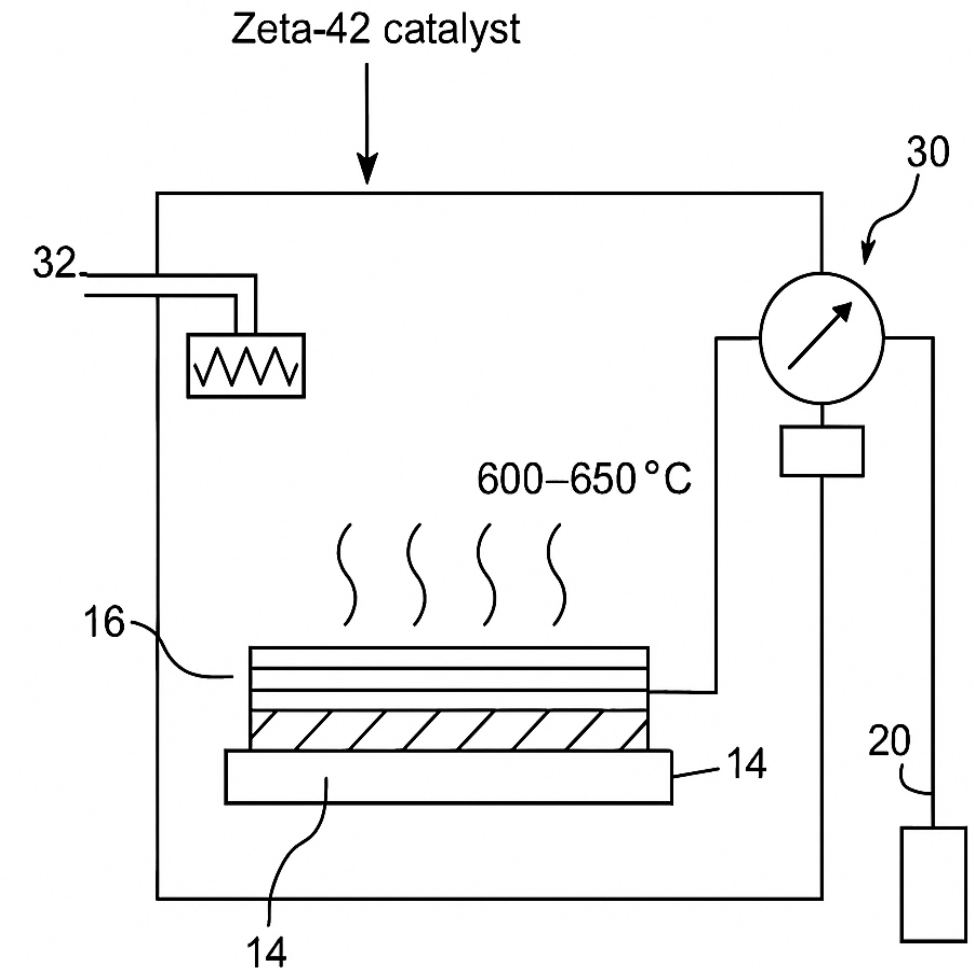




# Alleged Infringement (K-Tech)

A method for forming a nano-coating on a semiconductor component comprising:

- introducing a **modified version of Zeta-42** catalyst into a reaction chamber with a semiconductor substrate;
  - heating the reaction chamber to **680°C**;
  - depositing multiple coating layers under the heated conditions in the presence of the catalyst; and
  - controlling reaction duration, pressure, and catalyst concentration;
- wherein the resulting nano-coating has a **distinct crystalline structure** and substantially increases the semiconductor component's durability and thermal resistance.





# NanoShield Ltd v K-Tech Inc.

## Claim

- K-Tech is selling **Nanoguard X** in DE, KR, UK, U.S. and EU states.
- K-Tech's **catalyst and heat treatment parameters** are **indistinguishable in effect** from the patented process.
- Nanoguard X gives a product **microstructure like the patented process**.
- **Zeta-42** is present in final product.
- **Internal K-Tech emails** discuss the patent before launching NanoGuard X

## Defence

- **Modified version of Zeta-42**, with an undisclosed additive.
- Operate at **680°C**.
- Coating forms a **distinct crystalline structure**.



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# NanoShield Ltd v K-Tech Inc.

## Counterclaim

- **JP 2009-789456** discloses a similar nano-coating process but with a slightly different catalyst.
- **Technical Journal, 2012** describes an overlapping process with Zeta-42.
- Patent does not disclose **how to make Zeta-42**.
- Results **cannot be reproduced**.
- Patent is **speculative**.

## Defence

- Prior art does not disclose the **specific temperature range**.
- No explicit combination of features.
- Process **solves a long-standing problem**.
- Zeta-42 **available from standard suppliers**.
- Specification is sufficient.



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# 3. Evidence



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## Infringement

- What evidence would NanoShield need to prove infringement?
- What evidence should K-Tech file to prove its defence?

## Validity

- What evidence would K-Tech need to file to prove its case?
- What evidence should NanoShield file to defend the patent?

## Damages/Account of Profits

- What evidence would NanoShield need to file?
- What evidence should K-Tech file?

- What is the burden of proof?
- How can a party get the evidence it needs?
- **When and how** should it be filed/served?
- How important is **expert evidence**?
- How to **choose and instruct** an expert?
- **Important considerations** for expert evidence?
- When is expert testimony introduced and why?
- What are the **risks** & how can these be ameliorated?
- **How much does it cost?**
- Will the court make its own investigations?



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## 4. Summary



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Jurisdiction	System Type	Decision-Maker	Bifurcated?	Litigation Control	Evidence Base
Germany	Infringement: Adversarial Validity: Legal-technical adjudication	Judges (technical for validity)	Yes (District Court & Patent Court)	Litigation: Parties Validity: Court-guided	Documents + court expert
Korea	Adversarial with active judicial involvement	Judge (supported by technical advisor)	Yes (District Court & KIPO)	Parties	Documents + fact witness
England & Wales	Adversarial	Judge	No	Parties	Disclosure + expert + cross exam
U.S.A.	Adversarial	Judge or jury	No*	Parties	Discovery + live evidence (fact & expert)
UPC	Hybrid (judge-led for validity)	Judges	Possible	Court-guided	Written + oral + selective disclosure





# 5. Discussion



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