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# The Legal 500 Country Comparative Guides

## South Korea

# PATENT LITIGATION

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This country-specific Q&A provides an overview of patent litigation laws and regulations applicable in South Korea.

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## SOUTH KOREA PATENT LITIGATION



### 1. What is the forum for the conduct of patent litigation?

Korea has a bifurcated system in which infringement and invalidation are decided in separate proceeding and at different forums. Patent infringement actions seeking either damages or injunctive relief in Korea can be brought in five specialized district courts designated to handle IP cases, including Seoul Central, Daejeon, Daegu, Busan and Gwangju District Courts. Seoul Central District Court is by far the most popular venue and handles a majority of the patent infringement actions in Korea. In the court, a patent infringement action is reviewed by three judges with technical advisors, who are either current KIPO officials dispatched to the district courts on 2-year terms or appointed by courts to aid the judges with the technology issue in the litigation. Patent invalidation actions are filed at the Intellectual Property Trial and Appeal Board ("IPTAB") under the Korean Intellectual Property Office ("KIPO"), and are usually reviewed by a panel of three trial examiners but the panel may be enlarged to five examiners for those with significant implications. The district court has the authority to review both the infringement and invalidity issues and, although it does not rule on the validity of the patents, per se, if the court finds that the patent is clearly invalid, the underlying infringement action may be dismissed, or if there is a pending invalidity action, stayed until the decision from the IPTAB.

### 2. What is the typical timeline and form of first instance patent litigation proceedings?

A patent infringement action generally takes about 12-24 months for the district court to render a decision, but it may vary depending on the complexity and significance of the case. Statistical data from Presidential Council on Intellectual Property in 2019 showed that, on average, it took about 605 days for a district court to render a decision in a patent infringement case. Unlike other jurisdictions, e.g. the U.S., where the litigation is divided into extensive pre-trial process, including

discovery, and eventual trial by factfinder(s), Korean civil litigation usually consists of multiple hearings in every one or two months until the panel is satisfied with the records and ready to rule on the issues, with relevant evidence and supporting briefs usually being submitted prior to each hearing. During the hearing, the panel may conduct fact/expert witness examination or listen to oral arguments from the parties' counsel regarding issues of the panel's interest. A patent invalidation action before the IPTAB is usually faster than the court proceeding, lasting about 9 to 16 months, but it can be put on an expedited track under certain circumstance, e.g. a concurrently pending infringement action, which may reduce the timeline to 6 to 12 months. If both the infringement and invalidation actions are pending before the district court and the IPTAB on parallel tracks, either party may request that the infringement action be stayed pending the IPTAB's determination on the invalidation action. Recently, the Korean judiciary has adopted the electronic case filing system (the "ECFS") which allows parties to not only file and manage their cases electronically but also access court information and procedures through the system. It is expected that the newly introduced system will help reducing the overall timeline in both proceedings.

### 3. Can interim and final decisions in patent cases be appealed?

Interim decisions are rarely rendered in Korean patent infringement or invalidity cases. All appeals of the final decisions of the district courts in infringement actions and the decisions from the invalidation actions before the IPTAB are appealed to the Patent Court, a specialized court dedicated to patent related matter similar to the US Court of Appeals for the Federal Circuit. The appeals are filed as of right, with no permission required. The Patent Court reviews any and all issues, including both legal and factual issues, on de novo basis and additional evidence and arguments are allowed. The Patent Court usually holds one or two oral hearings, and generally renders a decision in about 6 to 12 months, but if additional facts and legal theories are presented, the

time may be extended significantly. The decision of the Patent Court may be appealed to the Supreme Court, but only the legal issues are reviewed by a panel of four justices with assistance from research judges, who are experienced judges with special expertise in the given legal field, and technical advisors. Unless the case is an exceptional one, the Supreme Court will usually rule based on the briefing without holding an oral hearing. Although the appeal to the Supreme Court is of right, with no permission required, most of the appeals are dismissed summarily within about four months after receiving the case records citing lack of sufficient legal basis to conduct a full review, which can generally take two years or longer to rule on.

#### **4. Which acts constitute direct patent infringement?**

Direct infringement under the Korean patent law is an unauthorized “practice” of the patented invention, and under Patent Act Article 2, “practice” of an invention of a product is defined as manufacturing, using, assigning (i.e., selling), leasing, or importing the product or offering to assign or lease the product (including displaying the product for the purpose of assigning or lease). Moreover, “practice” of an invention of a process of manufacturing a product under the same Article is defined as using, assigning, leasing, or importing the product manufactured by the process or offering to assign or lease the product.

#### **5. Do the concepts of indirect patent infringement or contributory infringement exist? If, so what are the elements of such forms of infringement?**

The Korean Patent Act Article 127 provides that conducting either of the following activities for business purposes shall be deemed infringement of a patent or an exclusive license: (1) if the patent is for the invention of a product: Manufacturing, assigning, leasing, or importing the thing used exclusively for manufacturing such product or offering to assign or lease such thing; (2) If the patent is for the invention of a process: Manufacturing, assigning, leasing, or importing a thing used exclusively for practicing the process or offering to assign or lease the thing. This is similar to contributory infringement concept, although the text does not label the proscribed activities in terms of indirect or contributory infringement. The Korean Patent Act does not provide for induced infringement cause of action, but inducement may be asserted based on the tort-based concept in civil laws.

#### **6. How is the scope of protection of patent claims construed?**

The scope of protection of patent claims are construed using the limitations stated in each patent claim. In building on the basic principle, the Supreme Court of Korea held that the claim language should be construed in an objective and reasonable manner based on its common meaning, but in a case where the technical meaning of the patented invention cannot be specifically understood from the languages of the claims alone, the detailed description of the invention and drawings shall be taken into consideration. The doctrine of equivalents has been generally recognized in Korea. According to the decisions of Korean courts, even if all elements of a claim is not literally present in a product or a process, a finding of patent infringement is possible under the doctrine of equivalents if certain requirements are met, including (1) the accused product or process uses the same principle to solve the same problems as the inventions of the patent; (2) the accused product or process use equivalent element or elements to achieve substantially the same effect as the corresponding claim element; (3) the equivalent element is obvious to a person of ordinary skill in the relevant art such that it is easily conceivable; (4) the accused product or process utilizes the prior art or what would have been obvious for the person of ordinary skill in the art to devise using the prior art; and (5) the equivalent element was not purposefully excluded from the patent claims during the patent’s prosecution. The plaintiff has the burden to allege and prove the first three elements, while the defendant has the burden to allege and prove the next two elements.

#### **7. What are the key defences to patent infringement?**

General key defences to patent infringement includes (1) non-infringement (including license by law or contract) and (2) invalidity. Particular defences to patent infringement also include (1) statute of limitation with the limitation period of ten years from the date on which the action accrued, or three years from the date the claimant became aware of the damages and the identity of the infringer, (2) patent exhaustion recognized by the Korean court as the principle of exhaustion of the patent right, and (3) conversion of an invalid patent into a utility model by finding an issued patent invalid through an invalidity proceeding.

#### **8. What are the key grounds of patent invalidity?**

The Korean Patent Act Article 133 provides the key grounds of patent invalidity, which include lack of industrial applicability, novelty/inventiveness, inadequacy of written description or lack of support/clarity.

### **9. How is prior art considered in the context of an invalidity action?**

Under the Korean patent law, prior art includes the following: (1) an invention publicly known or practiced in Korea or in a foreign country prior to the filing of the patent application at issue and (2) an invention published in a publication distributed in Korea or in a foreign country or an invention disclosed to the public via Internet prior to the filing of the patent application at issue may be cited for lack of novelty and inventiveness while prior art that is (3) an invention described in the specification of a patent application filed prior to and published after the filing of the patent application at issue may be cited only in terms of lack of novelty. As for asserting lack of inventiveness, prior art can be combined, and the inventiveness of the invention would be denied if the references present a suggestion or motivation that a combination of the references could lead to the claimed invention or a person of ordinary skill in the art can easily reach the combination.

### **10. Can a patentee seek to amend a patent that is in the midst of patent litigation?**

A patentee can seek to amend a patent, even in the midst of patent litigation, by filing either a correction trial if no invalidation action is pending or a request for correction as a part of the ongoing invalidation action with the IPTAB only to (i) narrow the scope of the claims, (ii) correct obvious errors or (iii) clarify ambiguous languages. The patentee can file for a correction trial before the IPTAB to amend the claims or specification of an issued patent, and if the civil main action for infringement is pending, the court may stay the infringement action until a decision in the correction trial is ordered. A third party may submit an opinion and evidence as to the propriety of such correction, but it cannot partake in the proceeding as a party. If a patent invalidation action is in progress before the IPTAB, however, a correction trial cannot be filed; instead the patentee may file a request for correction to amend the patent as part of the invalidation action, and once amended, the correction may be challenged by the petitioner of invalidity action.

### **11. Is some form of patent term extension available?**

Yes, if there is a statutory requirement for permission or registration to practice a patented invention, and complying with the requirement takes a long time, which is often the case in the field of pharmaceuticals or finished/raw agrochemical product industry, the term of the patent may be extended once for an additional period of up to five years to compensate for the period in which the patented invention could not be practiced, unless the delay is attributable to the patentee.

### **12. How are technical matters considered in patent litigation proceedings?**

Technical matters are considered the same as any other factual issue involved in the case. As noted above, technical advisors, who are KIPO officials or court-appointed technical experts, assist judges on the technical aspects of the patent at issue. Technical advisors usually hold a technology explanatory session for such purpose. Court appointed experts are independent and neutral and provide its technical opinion on the scope of the patent and infringement allegations. In addition to the court appointed experts, each side will usually proffer expert witnesses on technical matters to offer expert testimony regarding the contented issues.

### **13. Is some form of discovery/disclosure and/or court-mandated evidence seizure/protection (e.g. saisie-contrefaçon) available, either before the commencement of or during patent litigation proceedings?**

The discovery in Korea is relatively limited and even the limited discovery available in patent litigation is conducted entirely by and under the supervision of the court. The Civil Procedure Act provides that a party may petition the court to order production of certain documents from the other party or a third party, inspection of the other party's or a third party's sites, and examination of witness and parties by summons. In addition to the discovery measures provided in the Civil Procedure Act, Article 132 of the Patent Act also specifies that the court may, upon request by a party, order the other party to submit "material necessary for providing the relevant infringement or calculating the amount of losses caused by the relevant infringement." If the party controlling such materials refuses to submit the materials based on a "reasonable ground" (e.g., the

material is confidential information or trade secret) to do so, the court can inspect the materials *in camera* to determine whether the cited ground is indeed reasonable. Since the amendment of the Patent Act in 2016, asserting requested material is trade secret will not constitute a “reasonable ground” if such material is necessary for providing infringement or calculating the amount of losses and the court shall protect the trade secret by limiting the access to and scope of such trade secret. If a party refuses to comply with the court’s order, the court may deem the other party’s claim regarding the material is true, essentially allowing adverse inference against the non-compliant party. The parties will usually present their expert witnesses on technical matters, but the court may request or appoint experts for their opinion by providing affidavits or testimony. In addition to the court-supervised discovery, there has been active discussion as to introduction of a discovery process that is similar to the ones adopted in other countries, such as the U.S. Indeed, the proposed amendment to the Patent Act submitted in 2020 introduced new developments including (1) expert inspection, (2) witness deposition, and (3) litigation hold, as well as (4) updating the currently available court order procedure to compel document production with sanctions. First, expert inspection is a process that corresponds to inspection system adopted by German courts, which allows, either by the discretion of the court or upon request by the plaintiff, experts designated by courts visit the defendant’s facility to examine any evidence related to the patent infringement or damages. If the defendant refuses or interferes with such inspection, court will assume the plaintiff’s allegations as true, giving the plaintiff the full benefit of the doubt. Witness deposition is a system similar to the depositions used by the U.S. courts, which allows parties to a case examine witnesses to verify the materials or damages submitted to the court under the direction of a court staff without a judge. As taken in the U.S. courts, the depositions are video-recorded and have the same effect as testimony given in a trial, subject to penalty of perjury. Lastly, litigation hold or document preservation is an order that can be issued by a court to preserve certain evidence to prevent loss or destruction of such evidence or prevent obstruction of using such evidence in the event of failure to preserve the evidence will result in irreparable harm. If the party who is subject to the litigation hold nonetheless damages the documents such that it is not recoverable, court may assume that the allegations raised by the party who requested the litigation hold as true. Lastly, there has been issues raised under the current Patent Act with the procedure for requesting a production of certain document through the court as it is difficult for the requester to identify what documents it seeks since the requester cannot verify what documents or evidence are in the possession

of the respondent party at the time of the request and there is no way to verify nor sanction if the documents are destroyed or the respondent simply denies having such documents. To solve these issues, the proposed amendment to the Patent Act stipulates that the court provide a list of documents so the responding party can verify to the court whether such documents are in the responding party’s possession or not and provide sanctions for causing damages to such documents, in the form of presumption that the facts alleged by the requesting party is true. Further, while the addition of new provisions facilitate an easier collection of evidence, the proposed amendments also provide for a broader trade secret protection for all confidential documents or information produced during the litigation regardless of whether they were compelled by the court or not.

#### **14. Are there procedures available which would assist a patentee to determine infringement of a process patent?**

For a process patent, if a patentee shows that a product manufactured by the accused infringer is identical to that manufactured by the patented process, the presumption that the accused infringer practiced the patented process is applied. The presumption, however, is rebuttable upon the accused infringer’s showing that the product (1) was publicly known or practiced in Korea prior to the filing date of the patented process, or (2) described in a publication published in Korea or other countries prior to the filing date of the patented process or (3) was not manufactured using the patented process. Additionally, the Patent Act, Article 126-2, added in 2019 the requirement that once the plaintiff alleges the defendant of engaging in a specific type of behaviour (for proving infringement of a process patent claim), if the defendant denies engaging in such behaviour, it shall present the actual behaviour the defendant engages in, thereby shifting the burden to the defendant. In reality, however, because the Article 126-2 is a relatively new addition to the law, its practical implication in the actual litigation is not yet known.

#### **15. Are there established mechanisms to protect confidential information required to be disclosed/exchanged in the course of patent litigation (e.g. confidentiality clubs)?**

For all patent related proceedings, either party to the litigation may apply for the court to enter a protective order prohibiting the parties from disclosing confidential information to those outside of the litigation. In addition, the party requested to produce certain evidence by the

requesting party may refuse such production and ask the court to review the information without disclosing the content of the document to the requesting party and the court will review the document *in camera* to determine whether it can be withheld from production.

**16. Is there a system of post-grant opposition proceedings? If so, how does this system interact with the patent litigation system?**

As a form of post-grant opposition, a patent cancellation action is available for the patents registered on or after 17 March 2017. Unlike the invalidation action, grounds for cancellation are limited to prior art invalidity grounds (for example, lack of novelty or inventiveness, double patenting) based on written publications. A cancellation procedure must be filed within 6 months from patent publication and does not involve petitioner after filing a petition.

**17. To what extent are decisions from other fora/jurisdictions relevant or influential, and if so, are there any particularly influential fora/jurisdictions?**

Courts have full discretion whether to consider the decisions from foreign jurisdiction and how much weight to give to them. Due to the similarity of legal system, the decisions of courts in Japan and Germany seem to be somewhat influential when certain issues of first impression are considered by the courts, as well as those of the U.S. courts.

**18. How does a court determine whether it has jurisdiction to hear a patent action?**

To determine the jurisdiction, the courts consider whether a party or a case is “substantially related” to Korea in accordance with the Article 2 of the Act on Private International Law. In patent litigation, the geographic limits of the patent system provides a clear guideline as to the particular court’s jurisdiction to hear certain patent actions. For Korean courts, if the asserted patent is a registered patent in Korea, then it will likely be deemed to be “substantially related” to Korea and the jurisdiction established. Korean Supreme Court held that revocation or invalidation of a foreign registered patent should be deemed to be within the exclusive jurisdiction of the particular country where the patent is registered. Although the Supreme Court has not explicitly stated that an infringement action based on a foreign registered patent is within the exclusive

jurisdiction of the country where the patent is registered, we believe it is highly unlikely that a Korean court will claim jurisdiction to an infringement action based on a foreign registered patent.

**19. What are the options for alternative dispute resolution (ADR) in patent cases? Are they commonly used? Are there any mandatory ADR provisions in patent cases?**

The Industrial Property Dispute Mediation Committee is established by the KIPO for disputes involving patent, trademark and design rights. In order to proceed with an arbitration, a written agreement between the parties is required in Korea.

**20. What are the key procedural steps that must be satisfied before a patent action can be commenced? Are there any limitation periods for commencing an action?**

There is no key procedural step that must be satisfied before a patent action can be commenced in Korea. Due to the statute of limitation, a patent litigation claim seeking damages must be filed within ten years from the date of the last infringing act and within three years from the date of patentee’s learning of the infringing act.

**21. Which parties have standing to bring a patent infringement action? Under which circumstances will a patent licensee have standing to bring an action?**

A patentee and/or an exclusive licensee who has registered the license with KIPO can each bring a patent infringement action.

**22. Who has standing to bring an invalidity action against a patent? Is any particular connection to the patentee or patent required?**

Any interested party has standing to bring an invalidity action against a patent. An interested party is construed very broadly and include an accused infringer as well as manufacturers of products or those planning on manufacturing products that have some relationships with the patent claims will be deemed to have standing to file a patent invalidation action before the IPTAB.

### **23. Are interim injunctions available in patent litigation proceedings?**

Yes, a preliminary injunction action can be filed concurrently with the civil main action or as a separate action to the five IP specialized district courts identified under Question 1. A preliminary injunction action can be filed to seek provisional seizure of infringing products and provisional disposition. Due to its provisional nature, showing of a prima facie valid claim and an immediate or present danger of irreparable injury to the patentee (or the exclusive licensee) is required for relief. If a PI order is issued, the plaintiff is required to post a bond in the amount determined by the court considering various factors, including the infringer's revenues and profits. An adverse PI decision can be appealed to the High Court—not to the Patent Court—sitting above the district court and the order can be executed immediately upon posting of the required bond, even if the appeal has been filed.

### **24. What final remedies, both monetary and non-monetary, are available for patent infringement? Of these, which are most commonly sought and which are typically ordered?**

Available remedies for patent infringement under the Korean law include monetary damages, permanent injunction and destruction of infringing products or equipment for manufacturing such products. It is most common for a patentee to seek all three of the abovementioned remedies.

### **25. On what basis are damages for patent infringement calculated? Is it possible to obtain additional or exemplary damages?**

The Patent Act provides the methods of calculating monetary damages. The patentee-plaintiff has the burden of proof to show the amount sought for is in accordance with such methods. The calculation methods include: (1) lost profit (lost sales or royalty), (2) unjust enrichment, (3) reasonable royalty, or (4) judicial determination. In determination of the damages amount, the following factors can be considered by the court: infringer's superior bargaining power, the intention or degree of awareness regarding risk of damage, the extent of damages from infringement, the economic gain achieved through infringement the period over which the infringing act occurred, and frequency of the infringing act, any monetary penalty imposed in connection with infringement, the financial condition of the infringer, and

infringer's effort in mitigating the damages. Enhanced damages is also available for any wilful patent infringement, and the court may award damages amounts up to three times the compensatory damages upon finding that a patent is wilfully infringed.

### **26. How readily are final injunctions granted in patent litigation proceedings?**

Upon finding of infringement, courts necessarily grants injunction without considering additional factors such as balance of hardship or public interest in determining permanent injunction. In case of an ordered preliminary injunction, it can be converted into permanent injunction upon a separate civil main action at the district court filed by a party.

### **27. Are there provisions for obtaining declaratory relief, and if so, what are the legal and procedural requirements for obtaining such relief?**

Theoretically, a potential defendant can initiate a civil action requesting the court to find lack of infringement by certain products, but it is rarely used in practice. What is more commonly used is trials to confirm scope of rights before the IPTAB under Article 135 of the Patent Act, where either the patentee or any interested party (e.g., the accused infringer) can ask the board to "confirm the scope of right in the patent" to determine whether certain products come under the protection of the patent at issue. To file a declaratory action at the IPTAB, the interested party only needs to show (1) that it is in the same business area as the patent claim defines, and (2) that it has a business plan to make, use, or sell a related product. Unlike the declaratory judgment in the U.S., the showing of an actual controversy between the parties is not required. The interested party must, however, specify the subject product or process that may fall into the scope of the patented claims. Once the declaratory action is instituted, the interested party may seek a declaratory judgement of non-infringement, invalidity, unenforceability, or a combination of the foregoing. A finding of a product being outside of the patented scope can be used as an evidence in an infringement action against the patentee. However, it should be noted that due to the bifurcated system of patent litigation in Korea, the district court does not necessarily defer to the IPTAB's findings.

### **28. What are the costs typically incurred by each party to patent litigation**

### **proceedings at first instance? What are the typical costs of an appeal at each appellate level?**

The cost and expenses involved with patent litigation in Korea, like in any other jurisdiction, may vary widely based on many factors, including the complexity of the patented technology, the parties' litigation style and strategy, volume of evidence to be examined, breadth of the patent claims, and the venue. Due to the limited discovery available in Korean litigation in general, the cost of litigating or defending one's case in a patent infringement action in the first instance is relatively inexpensive compared to other jurisdictions e.g., the U.S. In providing a rough estimation of the costs, it can range from as low as USD 50,000 to as high as USD 1 million or more for the district court action. In the civil actions, Korean law allows a party and the counsel to arrange to be compensated on a contingency fee basis (usually a retainer plus success fees) except in criminal cases. At an appellate level, the litigation costs are usually lower than those at the lower court level, but due to the de novo review that allows for additional evidence to be presented, the costs can again vary widely even at this level.

### **29. Can the successful party to a patent litigation action recover its costs?**

Theoretically, prevailing party to an infringement action is entitled to recover certain costs incurred during the litigation, such as attorney's fees, filing fees, court-appointed expert's fees, etc. However, in actuality, the recoverable amount is limited to the statutory limit and is generally only a fraction of the actual amount spent.

### **30. What are the biggest patent litigation growth areas in your jurisdiction in terms of industry sector?**

Semiconductor industry continues to be the biggest area for patent litigation, and most recently, pharmaceutical and bio-health industries have been actively growing areas due to the COVID-19 pandemic situation. Moreover, as more foreign entities are submitting objections to recently filed patent applications that are filed as an extension of the efforts to localize the supply of materials, parts and equipment in various industries, it is noted that the trend in various industries may lead to full-fledged patent litigation in Korea.

### **31. What do you predict will be the most contentious patent litigation issues in your jurisdiction over the next twelve months?**

Although enhanced damages award has been adopted and become available since July 9, 2019, the damages award only applies to an infringement that commenced after the effective date of the amended law, which is July 9, 2019. Thus, there has yet to be a case in which enhanced damages was ordered, but it is expected that patent infringement cases will soon fall within the scope of application of the enhanced damages and we expect that there will soon be increased number of cases where the enhanced damages will become a central issue.

### **32. Which aspects of patent litigation, either substantive or procedural, are most in need of reform in your jurisdiction?**

As answered in Question No. 13, the proposed amendment of 2020 to the Patent Act includes expert inspection, depositions, litigation hold/document preservation as well as updated procedures relating to the existing evidence collection process. If the Patent Act is accordingly amended, issues that have been raised such as difficulty associated with showing infringement or proving damages due to the limited access to evidence or under-calculated damages amount based on incomplete proof could be significantly resolved.

### **33. What are the biggest challenges and opportunities confronting the international patent system?**

As collaboration and division of work among multiple countries has been promoted, the number of cases of indirect patent infringement is also increasing. Further, globalization of patent systems combined with ever-growing cross-border transactions among companies are leading to increase in multi-jurisdiction disputes. Companies have been building global patent portfolios with the benefit of the international patent system, and parallel patent infringement actions are filed in multiple jurisdictions by the companies to exploit the legal instruments of different countries. To manage this parallel, multi-jurisdiction dispute, legal counsels, whether in-house or outside, are required to understand the legal systems in various countries and communicate effectively with law firms in various jurisdictions.



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