



William (Skip) Fisher

Partner

HEAD OF PATENTS, CHINA

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William (Skip) Fisher has practiced IP law in the U.S., China and internationally for 20 years. His practice focuses on counselling, licensing, and enforcement/litigation in all areas of intellectual property, with a particular emphasis on patents, trade secrets and international IP and technology-related transactions.

He works with clients to establish and implement strategies for procuring, protecting, commercializing and enforcing their IP rights and for minimizing risk to their IP assets in China, the U.S. and globally. He also counsels clients on U.S., Chinese and international IP law, practice and strategy; represents them in challenging, high-stakes patent, trade secret and other IP litigation and enforcement actions; and assists them in negotiating and drafting IP licenses, collaboration and development contracts and other commercial agreements.

Skip advises clients in a wide range of technologies and industries, including computer hardware and software, computer networks, mobile devices and applications, telecommunications, Internet and e-commerce, pharmaceutical, biotechnology, chemical, medical devices, mechanical and industrial products, aerospace, automotive, and manufacturing.

Skip is the China Head of Patents within the Intellectual Property and Technology (IPT) team, based in DLA Piper's Shanghai office.

LANGUAGES SPOKEN

- English
- Chinese (Mandarin)

EXPERIENCE

- Acting as external IP counsel in China for the world's leading manufacturer of plasma arc cutting torches and related

RELATED SERVICES

- Intellectual Property and Technology
- Patent Litigation
- Trademark and Copyright

RELATED SECTORS

- Technology

LANGUAGES SPOKEN

English Chinese
(Mandarin)

consumables, including establishing and implementing anti-counterfeiting strategy; advising on trademark portfolio and filing trademark applications, oppositions and cancellations; registering copyrighted works; investigating and advising on suspected trademark and patent infringements; filing trademark and patent infringement lawsuits and administrative actions, including two lawsuits that resulted in favorable settlements ending the infringing conduct with payment to the client; successfully invalidating a patent that covered the client's prior technology; and taking enforcement action at trade fairs and customs*

- Representing the world's leading manufacturer of plasma arc cutting torches and related consumables in several invention patent infringement lawsuits and design patent administrative enforcement actions in China against large Chinese manufacturer of imitation consumables (electrodes, cooling tubes, shields and nozzles)*
- Assisting the world's leading manufacturer of precision motion control systems on numerous IP matters in China and elsewhere in Asia, including conducting trademark audit and filing follow-on applications, oppositions and cancellations to strengthen portfolio; investigating and advising on several patent and trademark infringements; successfully cancelling registration of trademark confusingly similar to client's house mark; and managing client's domain name portfolio in Asia*
- Successfully defending a German luxury automobile manufacturer in two patent infringement lawsuits involving door lock and wheel structures brought by Chinese non-practicing entity (both cases dismissed following trial) and successfully invalidated the two asserted patents. The cases were especially significant because the plaintiff alleged infringement by all of the client's car models*
- Advising one of the world's largest integrated producers of polymers and fibers on IP issues related to USD 1.3 billion investment in greenfield chemical manufacturing plant in China, including advising on protection and enforcement of high-value trade secrets and technology; negotiating and preparing confidentiality and non-compete agreements; and advising on remuneration for service inventions and preparing related agreements*
- Representing a Hong Kong manufacturer in complex technology transaction with leading U.S. software company involving the licensing of magnesium injection molding technology for making casing for new tablet product, including negotiating and drafting license agreement*
- Representing a Chinese pharmaceutical company in negotiating and documenting (1) two license agreements with Belgian biopharmaceutical company for exclusive right to manufacture and commercialize anti-TNF α Nanobody®, ozoralizumab (ATN-103), for rheumatoid arthritis, and anti-RANKL Nanobody®, ALX-0141, for osteoporosis and bone metastasis in Greater China; and (2) one license agreement with French biopharmaceutical company for exclusive right to manufacture and commercialize ImmuFact® IMP321, a LAG-3Ig fusion protein for treatment of metastatic breast cancer, in Greater China*
- Assisting several U.S.-headquartered multinational companies draft inter-company cross-border IP licenses, including advising on complex issues of ownership, technology transfer and transfer pricing*
- Advising the world leader in nylon intermediates and fibers on IP issues relating to construction of nylon intermediates manufacturing facility in China, including advising on protection of trade secrets and technology, negotiating and drafting confidentiality and non-compete agreements and advising on remuneration for service inventions*
- Representing a French agricultural and food products company in complex joint venture and technology licensing transaction with Chinese seed company, including negotiating and drafting license agreement for hybrid corn seed technology and related trademark license and supporting corporate team on structuring joint venture*

*Denotes experience from a previous firm

CREDENTIALS

Professional Qualifications

- Attorney-at-law admitted with the Washington State Bar Association

Recognitions

- Ranked in *Chambers Asia Pacific* for China, Intellectual Property (International Firms), which notes "[Fisher] is widely respected as a great guy who really knows his patents"
- Named in *IAM Patent 1000* as Recommended individual for Patent Litigation and Transactions
- Identified in *WHO'S WHO Legal: Patents* as "standout practitioner[] who [is] notable on a domestic and international scale" and

recognized in China as "offer[ing] clients a business-oriented approach"

- Named as IP Star in Managing Intellectual Property, with one client noting "[Fisher] delivered quality and cost-effective work for our licensing agreements"

Education

- Boston University School of Law, Juris Doctor, *cum laude*, 1997
- Northeastern University, Master of Science in Criminal Justice, *with honors*, 1994
- University of Massachusetts, Bachelor of Arts in Chinese, *cum laude*, 1989

Courts

- United States Court of Appeals for the Federal Circuit
- United States Court of Appeals for the Ninth Circuit

INSIGHTS

Publications

China signs off on PRC Biosecurity Law: What this means for industry players in China

21 October 2020

The Biosecurity Law establishes a comprehensive framework replacing the current somewhat piecemeal legislation.

- Co-Author, "U.S.-China IP and Regulatory Investigations Playbook," *Bloomberg Law*, May 14, 2021
- 2018 Outlook for Drugs and Medical Devices in China: Regulatory Reform Fueled by Innovation

NEWS

MEDIA MENTIONS

- "34 DLA Piper lawyers in nine countries ranked among The World's Leading Patent Professionals," DLA Piper, October 30, 2019