



### William (Skip) Fisher

Partner

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William (Skip) Fisher has practiced IP law in the U.S., China, and internationally for over 20 years. His practice focuses on strategic counselling, high-stakes litigation, and complex licensing in all areas of intellectual property, with a particular emphasis on patents and trade secrets.

Skip works closely with large and small companies to establish and implement strategies for procuring, protecting, commercializing, and enforcing their patent, trade secret, and other IP rights in China, the U.S., and globally. Having spent the past 20 years practicing both U.S. and Chinese IP law, with 12 years based in China, Skip has the unique ability to explain Chinese IP laws, practices, and procedures to U.S. and other Western clients in a way they can easily understand and likewise to explain U.S. IP laws, practices, and procedures to Chinese clients. Because of this, he is often called on by clients to act as a strategic advisor on IP matters involving one or both jurisdictions.

Skip represents companies in a broad spectrum of IP matters, including managing multi-jurisdictional IP litigation and enforcement actions; negotiating and drafting cross-border licenses, collaboration and development contracts, and other IP-related commercial agreements; and conducting due diligence on IP assets for M&A and other investment transactions.

Over the years, Skip has worked in a variety of industry sectors, 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.

*Client quote: "I really like [Fisher]...He is very, very strong in the patent category. Clients love him, he does very good work." (Chambers Global & Greater China Region 2022)*

- Intellectual Property and Technology
- Patent Litigation
- Trademark and Copyright
- Litigation, Arbitration and Investigations
- Cross-Border Litigation
- Technology Transactions and Strategic Sourcing

- Technologies
- Industrials
- Sciences de la vie

#### Litigation/Enforcement

- Representing a global chemicals company in connection with patent enforcement campaign against multiple Chinese infringers on patents relating to structure and method of making cathode materials used in lithium-ion batteries for electric vehicles, including

advising on multiple lawsuits filed against multiple defendants involving multiple patents and related invalidation actions and appeals.

- Representing a global developer and manufacturer of innovative industrial/retail electronic products in global patent enforcement campaign against competitor, including preparation and filing of multiple patent infringement lawsuits filed against multiple affiliated defendants involving multiple patent families across multiple jurisdictions (including China).
- Acting as external IP counsel in China for world's leading manufacturer of plasma arc cutting torches and related consumables for over ten years, including (1) establishing and implementing anti-counterfeiting strategy; (2) advising on trademark portfolio and filing trademark applications, oppositions and cancellations; (3) registering copyrighted works; (4) taking enforcement action at trade fairs and customs (5) successfully invalidating patent covering client's prior technology; (6) investigating and advising on suspected trademark and patent infringements; and (7) filing trademark and patent infringement lawsuits and administrative actions, including over ten lawsuits/actions that resulted in favorable judgments or settlements.
- Representing a Chinese electronics manufacturer in U.S. lawsuit brought by IP-pool-licensing administrator claiming breach of license and trademark infringement and involving related U.S. Customs enforcement action.
- Representing a leading US-based retailer of home-improvement (DIY) products and the Chinese manufacturers of floor panels sold by the client in US International Trade Commission Section 337 investigation initiated by competitor claiming infringement of several patents relating to composition and interlocking mechanism of certain floor panels.
- Representing a manufacturer of innovative high-capacity low-sag conductor for electric power grid transmission lines in parallel trade secrets infringement lawsuits in China and U.S. against former executive and multiple co-conspirators who disclosed and used the company's proprietary product and manufacturing know-how during his employment and after leaving the company.
- Representing a leading developer and manufacturer of action cameras in trade secrets infringement lawsuit in China against former employee engineer who disclosed and used one of the company's proprietary algorithms after leaving the company.
- Representing an IT/Internet networking equipment company in patent litigation brought in China by Chinese non-practicing entity (NPE) involving invention patent covering method of providing Web access through access server and virtual Web server.
- Representing a leading camera-technology company in CIETAC arbitration against Chinese licensee involving claims of breach of the parties' patent license agreement and infringement of the client's patents.

#### *Licensing/Transactions*

- Advising a U.S. wireless-charging-technology company with respect to bringing its technology, process and system for wirelessly charging electric vehicles into China, including negotiating and drafting licenses to Chinese partners and advising the company on China's national standard-setting process for standard-essential patents.
- Assisting a global medical device company on various IP projects in China, including (1) conducting IP due diligence with respect to target company and its stent product, including confirming ownership of and other rights to patent and other IP assets and conducting patent freedom-to-operate analysis; (2) conducting IP due diligence with respect to third party's balloon catheter product, including conducting patent freedom-to-operate analysis; and (3) conducting IP due diligence with respect to third party's medical technology, including confirming ownership of and other rights to patents and other IP assets, and negotiating and drafting license agreement for rights to those IP assets.
- Assisting a Chinese private equity firm in connection with its tens-of-millions-USD investment in a company with cutting-edge technology relating to a "clean" coal refining process, including (1) advising and conducting due diligence on the patents and technology being licensed to the company; and (2) assisting them in negotiating and drafting a patent and technology license agreement and a raw material supply agreement.
- Assisting a large Vietnamese construction group and their automobile manufacturing affiliate in negotiating and drafting a technology license and services agreement with a major Chinese automobile manufacturer, where the technology being licensed from the Chinese company related to the electrical and electronic architecture of the automobile.
- 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-TNFa Nanobody®, *ozoralizumab* (ATN-103), for rheumatoid arthritis, and anti-RANKL Nanobody®, ALX-0141, for osteoporosis and bone metastasis in 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 China.

#### **DIPLÔMES**

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## Reconnaissance

- Ranked in *Chambers Global & Greater China Region* for China, Intellectual Property, which notes "[Fisher] is highly experienced representing major global clients against patent trolls, as well as taking on licensing and trade secret matters. He is especially well known for advising on cross-border technology-related transactions [and] is a well-regarded patent litigator, regularly acting on enforcement actions, trade secrets and licensing agreements on the non-contentious side." One client commented: "I really like [Fisher]...He is very, very strong in the patent category. Clients love him, he does very good work." See <https://chambers.com/lawyer/william-fisher-global-2:1299578>, <https://chambers.com/lawyer/william-fisher-greater-china-region-116:1299578>.
- Recognized by *The Legal 500* as a Leading Individual for China, Intellectual Property, with one commentor noting "[Fisher is] very dedicated to his clients." See <https://www.legal500.com/firms/908-dla-piper/38093-shanghai-china/lawyers/1014057-william-skip-fisher/>.
- Recognized by *IAM Patent 1000* as a Recommended Individual for China, Patent Litigation, which notes "Adding his finely honed expertise in both Chinese and US law to the talent pool, he is a consummate IP strategist." See <https://www.iam-media.com/rankings/patent-1000/profile/person/william-skip-fisher>.
- Ranked by *Managing Intellectual Property* as a Patent Star and Trademark Star in China. See <https://www.ipstars.com/Lawyer/William-Skip-Fisher/Profile/70448#profile>.
- Recognized by WHO'S WHO Legal: Patents as a "standout practitioner[] who [is] notable on a domestic and international scale" and is recognized in China as "offer[ing] clients a business-oriented approach." See <https://whoswholegal.com/william-skip-fisher>.
- Recognized by *World IP Review* as a Leading IP Practitioner. See <https://www.worldipreview.com/profile/william-fisher>.

## Jurisdictions

- All Washington state courts
- United States District Court for the Western District of Washington

## Adhésions

- American IP Law Association (AIPLA)
- Licensing Executives Society (LES)

## Education

- J.D., Boston University School of Law
- M.S., Northeastern University
- B.A., University of Massachusetts

## ACTUALITÉS

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### Publications

- 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
- DLA Piper Global Patent Laws DLA Piper Global Patent Laws - Insight into Patent Litigation and Dispute Resolution ([dlapiperintelligence.com](http://dlapiperintelligence.com))
- DLA Piper Global Contract Laws Global Contract Laws - Answers on everyday contract law questions ([dlapipercontractlaws.com](http://dlapipercontractlaws.com))
- DLA Data Protection Laws of the World DLA Piper Global Data Protection Laws of the World - World Map ([dlapiperdataprotection.com](http://dlapiperdataprotection.com))

### NEWS

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- "Considerations for China Inbound IP-related Transactions," Webinar, (March 3, 2022)
- "China and Hong Kong partners recognised in IP Stars 2021," *DLA Piper Newsroom*, (July 8, 2021)
- "U.S.-China IP and Regulatory Investigations Playbook," *Bloomberg Law*, (May 14, 2021)
- "Guest blog: China signs off on first PRC Biosecurity Law: What this means for Israeli companies in China?" *Lexology*, (November 18, 2020)

## MEDIA MENTIONS

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