

Duane Morris®

& SELVAM

TAIWAN

FOREIGN LEGAL AFFAIRS LAW FIRM

佑信外國法事務律師事務所

PATENTS AND TECHNOLOGY



Duane Morris represents clients in patent disputes involving complex technologies in a wide range of industries, such as biotechnology and pharmaceuticals; medical devices; diagnostics; life sciences; healthcare; information technologies, including hardware and software; internet and e-commerce; telecommunications; video games; entertainment; retail; and financial services, to name a few.

We regularly work with companies of all sizes and at all stages of development, including emerging growth companies, middle-market companies and established vendors of technology goods and services, to help clients understand how to maximize the value of their intellectual property and technology assets.

Our attorneys have diverse technical backgrounds and have earned advanced degrees in relevant fields. We combine this aptitude for science and technology, in-depth knowledge of patent law and mastery in trial advocacy to focus on our clients' business objectives. Our litigators have played a leading role in some of the most important cases in the field of patent law, as well as some of the most complex (including one of the largest patent cases ever tried before the International Trade Commission). Our work in Asia is complemented by our unique trial experience within the United States, including at the U.S. Patent and Trademark Office (USPTO).

With offices in major markets across the United States and in Asia, as well as strategic alliances with international networks of law firms, Duane Morris is positioned to help clients secure and maintain patent protection throughout the world.

RANKINGS AND RECOGNITION

U.S. News-Best Lawyers recognizes Duane Morris with **TOP-TIER NATIONAL RANKINGS** in the United States for Intellectual Property Litigation and Patent Litigation.

Named the **#1 MOST EFFECTIVE FIRM** for *inter partes* review patent invalidation proceedings by Patexia IP and Unified Patents.

Named "**LITIGATION COUNSEL OF THE YEAR**" by Cisco Systems, Inc., a leading global provider of networking products and services, as a result of Duane Morris' work for Cisco on patent litigation matters.

RANGE OF SERVICES

- ▶ JOINT VENTURES AND STRATEGIC ALLIANCES
- ▶ COLLABORATION AND CO-DEVELOPMENT AGREEMENTS
- ▶ IN-BOUND AND OUT-BOUND PATENT AND TECHNOLOGY LICENSES
- ▶ *INTER PARTES* REVIEW
- ▶ MANUFACTURING AND SUPPLY AGREEMENTS
- ▶ DISTRIBUTION AND RESELLER ARRANGEMENTS
- ▶ BRANDING AND MARKETING ARRANGEMENTS
- ▶ BUSINESS PROCESS OUTSOURCING ARRANGEMENTS
- ▶ NONDISCLOSURE AGREEMENTS
- ▶ PATENT INFRINGEMENT AND PROSECUTION
- ▶ PATENT LICENSES
- ▶ INVENTORSHIP, MANAGEMENT AND OWNERSHIP OF PATENT PORTFOLIOS

EXAMPLES OF OUR WORK

- ▶ Represented Taiwan Semiconductor Manufacturing Company (TSMC) in patent infringement litigation against Zond LLC. Settled the action in a manner the client considered successful.
- ▶ Representing Petitioner Taiwan Semiconductor Manufacturing Company, Ltd. in IPR of U.S. Patent Nos. 6,805,779; 6,806,652; 6,853,142; 7,147,759; 7,604,716; 7,808,184; and 7,811,421, concerning a two-stage sputtering technique in which a so-called strongly ionized plasma is generated from a weakly ionized plasma in a manner that avoids arcing.
- ▶ Represented clients in the prosecution and defense of international oppositions, nonuse cancellations and removal actions throughout the world, including EU, U.K., China, Australia, India, Brazil, Canada and Taiwan.
- ▶ Successfully defended a patent infringement action brought against a Taiwanese manufacturer of circuit board architecture.
- ▶ Settled a case on behalf of a major Taiwanese manufacturer of circuit board architecture who had been sued by Foxconn Electronics, Inc. for infringement of multiple patents.
- ▶ Represented American distributor and Taiwanese manufacturer of fiberglass doors in a patent infringement suit concerning compression molded doors, including obtaining summary judgment of noninfringement on two separate motions. *Therma-Tru v. Plastpro and Nan-Ya Plastics*, (D. N.J.).
- ▶ Negotiated a multiyear agreement for our client Next Biometrics, SA, to supply unique fingerprint sensors to a major competitor in the Chinese security market. Next Biometrics has produced the world's first mass-produced high-quality fingerprint sensors on a low-cost, large area substrate based upon its proprietary "Active Thermal Principle."

- ▶ Advised a U.S. company on its provision of internet video surveillance services to a Shanghai-based company that provides food to KFC and McDonald's.
- ▶ Prosecuted U.S. Patent No. 8,916,583, pertaining therapeutic compositions for intranasal administration of Zolpidem, on behalf of a Chinese biotech/pharma company.
- ▶ Prosecuted U.S. Patent No. 8,399,029, pertaining to influenza prevention and treatment compositions, on behalf of a Chinese company.
- ▶ Obtained US\$145 million settlement on behalf of Nikon in a patent infringement suit involving photolithography systems used in semiconductor manufacturing processes.
- ▶ *Inpro II Licensing SARL v. Lite-On Technology Corp.* (N.D. Cal.). Managed counsel for defendants in \$5.4 million action alleging breach of patent licensing agreement concerning computer monitors.
- ▶ *Mondis Technology Ltd. v. LG Electronics, Inc.* (E.D. Tex.). Managed counsel for third-party defendants in action alleging breach of patent licensing agreement concerning computer monitors.
- ▶ *Typeright Keyboard Corp. v. Logitech, et al.* (S. Dist. Cal). Represented defendant in patent infringement lawsuit concerning computer keyboards; negotiated and drafted settlement agreement.
- ▶ *Babbage Holdings LLC v. Sony Computer Entertainment America LLC et al.*, 2:13-cv-757 (E.D. Tex. 2013). Represented defendant Sony Corporation of America in a patent infringement matter relating to a method and apparatus for sharing customizable software applications on a single display. Resolved after successfully transferred venue to a more convenient forum and instituted *inter partes* review of critical asserted claim.
- ▶ *Walker Digital, LLC v. Sony Computer Entertainment America LLC et al.*, No. 1:11-cv-00322-SLR (D. Del.). Represented SCEA in defense of alleged infringement of patents relating to systems and methods for the authentication of computer generated game or test results. Resolved following institution of *inter partes* review which had required opposing infringement expert to take positions inconsistent with validity theory.
- ▶ *Flexsys Americas LP v. Korea Kumho Petrochemical Co., Ltd., Kumho Tire Co., Inc., Kumho Tire USA, Inc. and Sinorgchem Co., Shandong* (N.D. Ohio). As lead counsel for Kumho defendants, obtained summary judgment determination of noninfringement regarding tire anti-degradant patents.
- ▶ *In the Matter of Certain Rubber Antidegradants I* (ITC; *Flexsys v. Sinorgchem and Korea Kumho Petrochemical Co.*). As lead counsel for Kumho, obtained dismissal after trial of ITC investigation involving tire anti-degradant patents.
- ▶ Represented Kyocera Communications, a Japanese manufacturer of mobile phones, in a patent infringement suit brought in the Eastern District of Texas, Tyler Division, involving multiband antenna technologies.
- ▶ *Inter Partes* Review No. 2014-00954. Representing petitioner Sony Computer Entertainment America LLC in IPR of U.S. Patent No. 5,561,811, concerning a computer software collaboration system that allows multiple users to interact with software applications simultaneously on a shared display using multiple input devices connected to a single computer.
- ▶ *Anki, Inc. v. China Industries Ltd. t/a Wow! Stuff*, 3:15-cv-1189 (N.D. Cal. 2015). Representing plaintiff Anki, Inc. in a patent infringement matter relating to distributed system of autonomously controlled mobile agents.
- ▶ Negotiated settlement and drafted \$20 million patent licensing agreement in dispute between U.S. company and Taiwanese company concerning computer monitor patents.
- ▶ Negotiated settlement and drafted \$20 million patent licensing agreement in dispute between Japanese company and Taiwanese company concerning computer monitor patents.
- ▶ Negotiated settlement and drafted \$18 million patent licensing agreement in dispute between German company and Taiwanese company concerning LED patents.
- ▶ Managed patent lawsuits and administrative proceedings in the United States and other countries concerning computer monitors, keyboards, Wi-Fi devices, USB drives, camera modules, MP3 players, LEDs, semiconductors and other technologies.
- ▶ Assisted Taiwan company to launch criminal action against three former employees for theft of trade secrets and use of the secrets at their competing employment.
- ▶ Advised on the sale of patented IP rights from the U.S.-based holder to an Asian entity and subsequent licensing agreements involving parties based in Europe and Asia.
- ▶ Acted for a leading Japanese multinational information technology company in a U.S. patent litigation pertaining to internet communication technology.
- ▶ Acted for a major Japanese pharmaceutical company involved in U.S. patent litigation.
- ▶ Lead counsel in a breach of a license agreement claim between a U.S.-based semiconductor manufacturer and a Japanese-based watch manufacturer involving the sale and licensing of various patents. The case was tried under the auspices of the International Chamber of Commerce before a panel of three arbitrators.
- ▶ Prosecuted U.S. Patent No. 8,993,065, pertaining to substrate coating with aqueous-based multifunctional core shell particles, on behalf of a Chinese university.
- ▶ Prosecuted U.S. Patent No. 8,901,292, pertaining to methods of mass production of tetrakis (p-nitrophenyl) porphyrins, on behalf of a Chinese university.
- ▶ Prosecuted U.S. Patent No. 8,709,732, pertaining to biomarkers of gastric cancer and uses thereof, on behalf of a Chinese university.
- ▶ Prosecuted U.S. Patent No. 8,669,354, pertaining to removal of endotoxin using amphiphilic core-shell nanosorbents, on behalf of a Chinese university.
- ▶ Prosecuted U.S. Patent No. 8,544,252, pertaining to methods and apparatuses for reducing residual torque and neps in singles ring yarns, on behalf of a Chinese university.
- ▶ Prosecuted U.S. Patent No. 8,523,971, pertaining to multilayer nanofiber filters, on behalf of the Hong Kong Polytechnic University.
- ▶ Prosecuted U.S. Patent No. 8,399,029, pertaining to influenza prevention and treatment compositions, on behalf of a Chinese company.

FOR MORE INFORMATION, PLEASE CONTACT:

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