

如何获得强大的知识产权,如何转换到一个
雇主,不用担心被前雇主起诉

How to Obtain Strong IP Rights, How to Transition to a
New Employer without fear of being sued

February 11, 2017

CHARLES C.H. WU, ESQ.

吳志鴻律師

SINCE 1993

98 DISCOVERY

IRVINE, CALIFORNIA 92618

WWW.WCLAWYERS.COM

TEL: 949-251-0111 // FAX: 949-251-1588 // E-MAIL: CCHWU@WCLAWYERS.COM

电子邮件索要副本

FOR A COPY OF THIS POWER POINT PRESENTATION, SEND AN EMAIL
TO CHARLES WU – CCHWU@WCLAWYERS.COM

Charles C.H. Wu's bio

- California licensed and practicing attorney for over 24 years; U.S. Patent and Trademark Office for 25 years. He is a partner of the law firm he founded. The law firm has 3 attorneys and 6 legal assistants
- U.S. Supreme Court opinion (543 U.S. 111). The U.S. Supreme Court opinion set forth the trademark Fair Use doctrine. 5 other Court of Appeal published opinions. Over 200 patents and over 200 trademarks issued where he is the attorney of record.
- Cum laude graduate of U.S.C. School of Engineering. BS in Electrical and Biomedical Engineering and his Master of Science degree in Computer Engineering. Both from USC. Mr. Wu received his Juris Doctor degree from Western State University, College of Law with a certificate in tax emphasis.

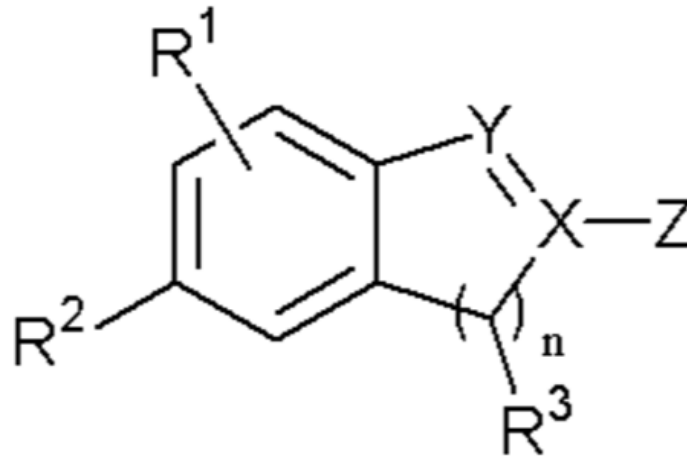
Donald Trump Funnies



- How is Donald Trump going to shut down the Dept. of Education?
By renaming it Trump University
- What does Melania see in Donald Trump?
Ten billion dollars

What is a drug, chemical, or pharmaceutical patent?

A monopoly property right issued by the U.S. Patent and Trademark Office for 20 years from filing date.



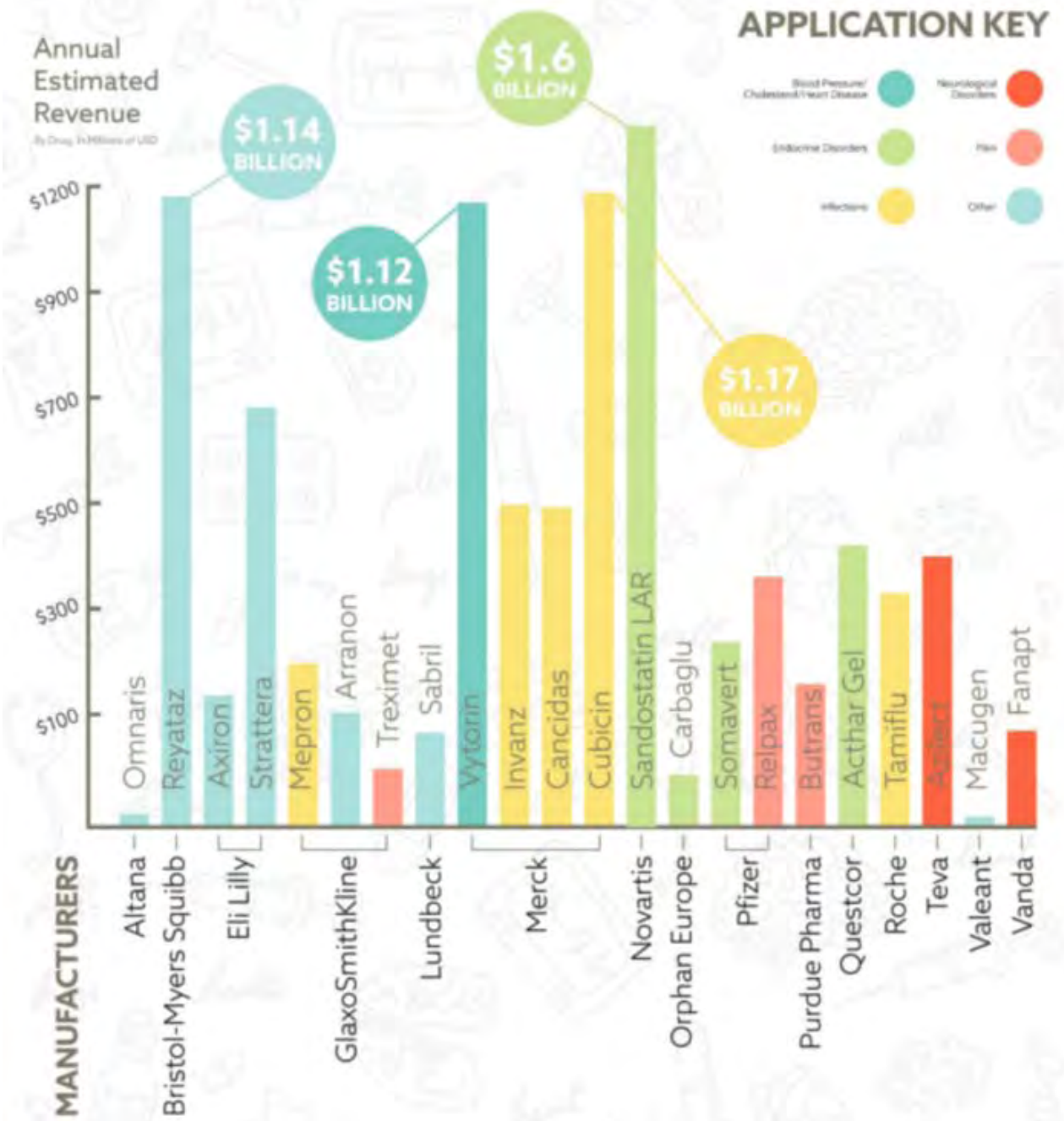
Markush structure – 1st chemical patent in 1925

Important in pharmaceutical industry because drugs and medicine can easily be copied by reverse engineer



MAJOR DRUGS

GOING OFF-PATENT IN 2017



I. HOW TO OBTAIN STRONG PATENTS

如何获得强的专利

1. Retain the right patent attorney

Patent attorneys have specific technical backgrounds in various technical fields:

Physics 物理, biology 生物学, chemistry 化学, electrical engineering, mechanical engineering, civil engineering.

Select the right patent attorney so he/she can understand the technology



Write strong patent claims working w patent attorneys

Prilosec

United States Patent [19]

Junggren et al.

[11]

4,255,431

[45]

Mar. 10, 1981

[54] **GASTRIC ACID SECRETION INHIBITING
SUBSTITUTED
2-(2-BENZIMIDAZOLYL)-PYRIDINES,
PHARMACEUTICAL PREPARATIONS
CONTAINING SAME, AND METHOD FOR
INHIBITING GASTRIC ACID SECRETION**

[75] **Inventors: Ulf K. Junggren, Mölnlycke; Sven E. Sjöstrand, Kungsbacka, both of Sweden**

[73] **Assignee: Aktiebolaget Hassle, Mölndal, Sweden**

[21] **Appl. No.: 27,277**

[22] **Filed: Apr. 5, 1979**

[30] **Foreign Application Priority Data**

Apr. 14, 1978 [SE] Sweden 7804231

[51] **Int. Cl.³ A61K 31/44; C07D 401/12**

[52] **U.S. Cl. 424/263; 546/271;
546/301; 548/329**

[58] **Field of Search 546/271; 424/263**

[56] **References Cited**

U.S. PATENT DOCUMENTS

4,045,563 8/1977 Berntsson et al. 546/271
4,045,564 8/1977 Berntsson et al. 546/271
4,182,766 1/1980 Krasso et al. 546/271 X

FOREIGN PATENT DOCUMENTS

1804450 5/1970 Fed. Rep. of Germany 546/271

OTHER PUBLICATIONS

Berntsson et al., Chem. Abst., 1976, vol. 85, No. 149139q.

Hideg et al., Chem. Abst., 1971, vol. 75, No. 98570g.

Primary Examiner—Henry R. Jiles

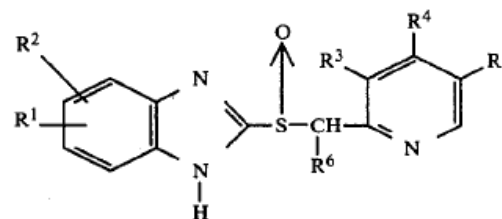
Assistant Examiner—Richard A. Schwartz

Attorney, Agent, or Firm—Brumbaugh, Graves, Donohue & Raymond

[57]

ABSTRACT

The present invention relates to novel compounds of the formula



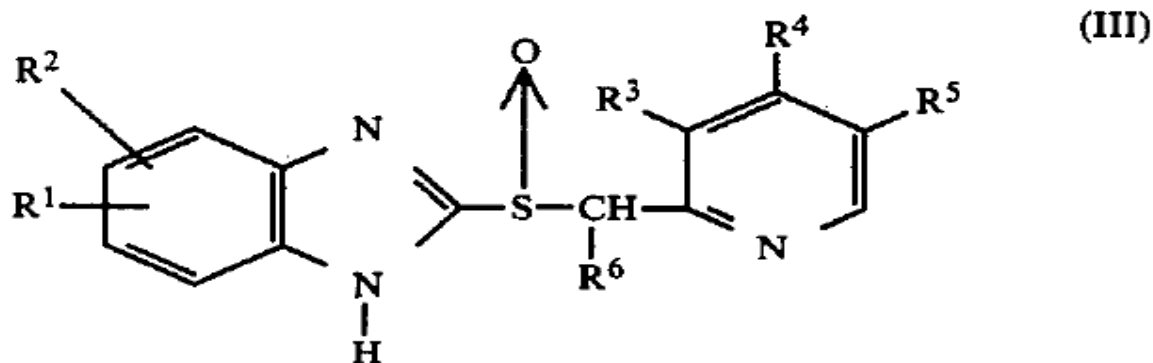
wherein R¹ and R² are the same or different and are each hydrogen, alkyl, halogen, carbomethoxy, carboethoxy, alkoxy, or alkanoyl, R⁶ is hydrogen, methyl or ethyl, R³, R⁴ and R⁵ are the same or different and are each hydrogen, methyl, methoxy, ethoxy, methoxyethoxy or ethoxyethoxy whereby R³, R⁴ and R⁵ are not all hydrogen, and whereby when two of R³, R⁴ and R⁵ are hydrogen the third of R³, R⁴ and R⁵ is not methyl. The compounds are potent gastric acid secretion inhibitors.

29 Claims, No Drawings

Prilosec – treat acid reflex, heartburn, stomach ulcers

We claim:

1. A method of inhibiting gastric acid secretion by administering to mammals, including man, suffering from gastric acid secretion disturbances a compound of the formula III



of **a pharmaceutically acceptable salt thereof** in a therapeutically effective amount in which R^1 and R^2 are the same or different and are selected from the group consisting of hydrogen, lower alkyl, halogen, carbomethoxy, carbethoxy, lower alkoxy, and lower alkanoyl in any position, R^6 is selected from the group consisting of hydrogen, methyl, and ethyl, R^3 , and R^5 are the same or different and are each selected from the group consisting of hydrogen, methyl, methoxy, ethoxy, methoxyethoxy, and ethoxyethoxy; and R^4 is methoxy, ethoxy, methoxyethoxy and ethoxyethoxy.

2. Consider the invention from different viewpoints:

1. The inventor's viewpoint
2. The consumer's viewpoint
3. The competitor's viewpoint

1. The inventor's viewpoint

Convey to the patent attorney with right information:

- How best describe the various embodiments that make up the invention
- Identify novelty of the invention



2. The consumer's viewpoint

-Features having high customer demands-
convert invention to practical uses.

Heelys sneakers -



James Jannard, Oakley's founder, has 3 patents on optics that cover “warp around” type of sunglasses and makes a fortune litigating against large sunglasses companies. Listed in Forbes 100 as 100 richest person in world.

**Von Zipper's (a division of Billabong)
Backseat sunglasses**



3. The competitor's Viewpoint

-Put yourself in the shoes of competitor and see if there are alternative embodiments to get around the patent

BMW ANGEL EYES HEADLIGHTS – AFTER MARKET PATENT LITIGATION



TUTORIAL OF THE MATTER

- AUTOMOTIVE HEADLAMP USING INCANDESCENT STYLE LAMP WITH A REFLECTIVE BACKGROUND





US007407311B2

(12) **United States Patent**
Yang

(10) **Patent No.:** **US 7,407,311 B2**
(45) **Date of Patent:** **Aug. 5, 2008**

(54) **LIGHT WITH A RING STRUCTURE FOR A VEHICLE LAMP**

(76) Inventor: **Hsiu-Pen Yang**, No. 427, Sec. 2, Wenhua Rd., Panchiao, Taipei (TW)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 98 days.

(21) Appl. No.: **11/313,819**

(22) Filed: **Dec. 22, 2005**

(65) **Prior Publication Data**
US 2006/0268563 A1 Nov. 30, 2006

(30) **Foreign Application Priority Data**
May 24, 2005 (TW) 94208462 U

(51) **Int. Cl.** **F21V 7/04** (2006.01)
(52) **U.S. Cl.** **362/555; 362/612; 362/545**
(58) **Field of Classification Search** **362/612, 362/555, 800, 545, 511, 517, 522, 540**
See application file for complete search history.

(56) **References Cited**
U.S. PATENT DOCUMENTS
6,107,916 A * 8/2000 Beck et al. 340/468

6,347,880 B1 *	2/2002	Furst et al.	362/494
6,504,477 B1 *	1/2003	Lin	340/472
6,789,929 B1 *	9/2004	Doong et al.	362/511
6,871,988 B2 *	3/2005	Gebauer et al.	362/511
2002/0122316 A1 *	9/2002	Hsieh	362/570

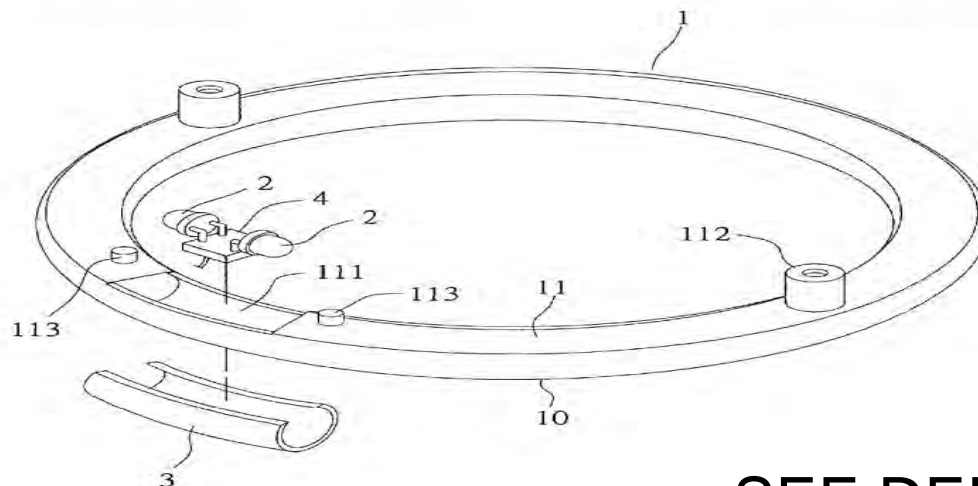
* cited by examiner

Primary Examiner—Jong-Suk (James) Lee
Assistant Examiner—Julie A. Shallenberger
(74) *Attorney, Agent, or Firm*—Charles R. Sutton

(57) **ABSTRACT**

A light with a ring structure for a vehicle lamp has a light-guiding ring with a dull face, a light-emitting element, and a reflective cover. The light-guiding ring defines a front annular face and has a cavity. The light-emitting element is disposed in the cavity. The reflective cover is disposed on a part of the front annular face and corresponds to the cavity. The light-guiding ring with a dull face guides light emitted by the light-emitting element therein. The reflective cover reflects the light into the light-guiding ring. As such, the brightness of the light with a ring structure is even to improve the warning function of a vehicle lamp to ensure a safer driving experience for its user.

1 Claim, 3 Drawing Sheets



SEE DEF. EX. 26

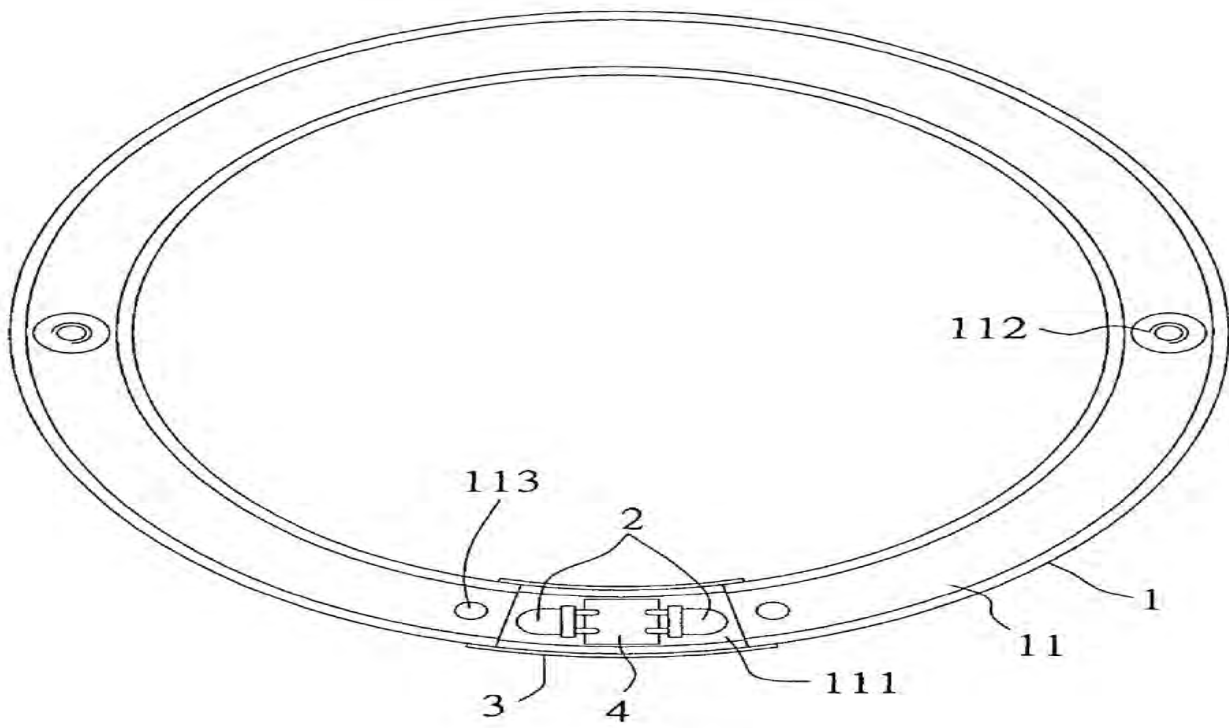


FIG 1

SEE DEF. EX. 26

If you're the competitor, how would you reverse engineer your invention? 逆向工程

For drug patents, the process of making the chemical compound is the key.

For software, intentionally place a dummy code inside to see other side copies blindly.



Heelys video

Razor scooter vs. Heelys case study (by CW)

Razor



Heelys



Exclusivity:

FDA Form 3542 granting exclusive marketing rights upon approval of a drug and can run concurrent or not concurrent with a patent.

1. Orphan drug – 7 years
2. New chemical - 5 Years
3. Others – 3 years

Orphan Drug Exclusivity (ODE)

- Orphan drug refers to a product that treats a rare disease - affecting fewer than 200,000 Americans
- 7 years exclusivity
- Granted on approval of designated orphan drug
- OGD works with the Office of Orphan Products

II. 如何转换到一个新雇主， 不用担心被前雇主起诉

How to transition to a new
employer without fear of
being sued by previous
employer

1. Trade secrets 商业秘密

2. Shop right doctrine

If there is no stealing of trade secrets and no violation of the shop right doctrine, then there should be no problem with the new employer

1. What is trade secret?

The Uniform Trade Secret Act (“UTSA”) defines a trade secret as:

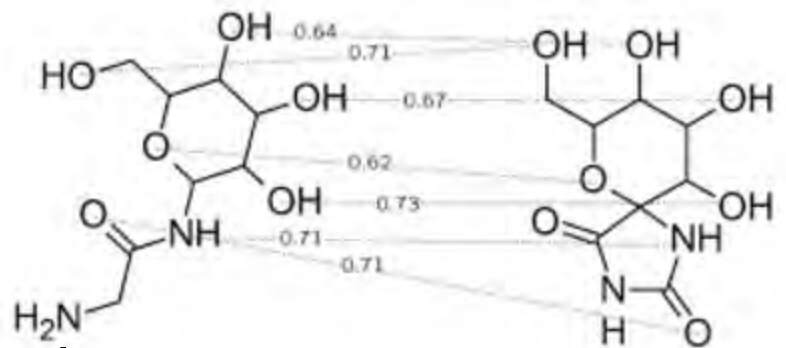
- (1) Information, including a formula, pattern, compilation, program, method, technique, or process;**
- (2) That derives independent economic value, actual or potential, from not being generally known to or readily ascertainable through appropriate means by other persons;**
- (3) Subject of efforts that are reasonably under the circumstances to maintain its secrecy**

(18 U.S.C. 1839(3)(A)(B); California Civil Code 3426-3426.11)

The most famous trade secret is the formula for Coca Cola

EXAMPLES OF TRADE SECRETS:

- Customer list (not publicly available),
- Particular manufacturing details (not publicly available)
- New invention that patent application has not been filed
- Market strategies
- Chemical compound making techniques
- Computer algorithms (i.e. Google search algorithms)



Coca Cola trade secret video

2. What is the Shop Right Doctrine?

It is not shopping properly at Ralphs supermarket or shopping property at South Coast Plaza

- Employer has a royalty free, non-exclusive right to use employee's invention

2.1 – Employed to Invent (facts supporting so. i.e. employer hire a PhD in biochemistry to develop new chemical compound) – Employer owns the invention.

(2 + 2.1 are frequently litigated in court because of factual in nature)

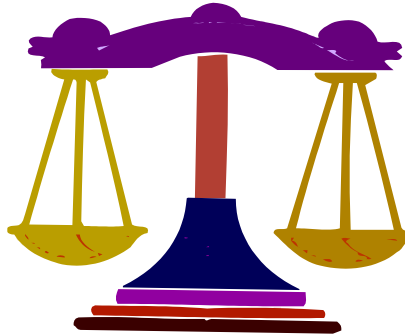
Shop Right doctrine (con't)

2.2 A written **Employment Agreement** typically assigns the intellectual property developed by W2 employees to the employer. However, CA Labor Code 2870 states that an employee's invention without using employer's resources and not related to employer's business or anticipated business.

2.3 **Independent contractor** – 1099, the independent contractor typically owns the invention unless assigned in agreement.

Questions and Answers





CHARLES C.H. WU, ESQ.

吳志鴻律師

98 DISCOVERY

IRVINE, CALIFORNIA 92618

WWW.WCLAWYERS.COM

TEL: 949-251-0111 // FAX: 949-251-1588

E-MAIL: CCHWU@WCLAWYERS.COM

**FOR A COPY OF THIS POWERPOINT
PRESENTATION, SEND AN EMAIL TO
CHARLES WU – CCHWU@WCLAWYERS.COM**