

Douglas J. Gordon

Counsel



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Practices/Industries

- Patent Prosecution, Drafting & Counseling
- IP Litigation
- IP Licensing

Education

Tufts University
(B.S., 1990)

Case Western Reserve
University School of Law
(J.D., *cum laude*, 2006)
Litigation Concentration with
Honors; Editor, *Internet Law
Journal*, 2006; IP Moot Court
Team, 2006

Overview

Doug is a patent attorney registered to practice before the U.S. Patent and Trademark Office (USPTO). Doug's practice focuses on securing and enforcing intellectual property rights, including preparing and prosecuting patent applications and providing technical expertise in high stakes patent litigation. Doug has successfully obtained worldwide patent protection for clients in a number of highly technical fields including inventions directed to software, electrical, telecom, and green energy innovations. Doug also drafts non-infringement opinions and technology licensing agreements, and counsels start-ups on obtaining economical protection for their business ventures. Doug also assists in business litigation matters that involve advanced technologies.

Doug has extensive experience as an electrical engineer having worked in industry for over a decade prior to becoming a patent attorney. Doug previously designed medical test equipment, created video capture and analysis products, and architected data communication networks for telecom providers around the world. Doug has in-depth knowledge of data communication protocols and networks, and was retained for his expertise on such major telecom projects as the deployment of a SONET fiber-optic network around Australia and provisioning the first private fiber-based IP network for a global bank which interconnected all of the branches and ATM machines throughout Manhattan and the surrounding boroughs.

Experience

- Assisted the first chair litigator in a high stakes patent infringement lawsuit involving a quasi-resonant power supply for the iPhone charger; developed non-infringement and invalidity positions, drafted claim charts, and provided legal analysis for technical aspects of the case; retained and directed the efforts of an expert in the field of power electronics, including the drafting of several expert reports.
- Drafted requests for *ex parte* reexamination to challenge patents on retroreflective technologies for a global manufacturer and distributor of adhesive products.
- Drafted and prosecuted patents directed to multifunction peripherals, LED-based laser printers, and LED lighting technologies for the U.S. subsidiary of a Japanese multinational conglomerate.
- Managed a portfolio of 150+ worldwide patent applications for a major telecom equipment provider.
- Obtained patents directed to semiconductors, solar cells, photovoltaic bypass diodes, electric smart grid technologies, battlefield IED detection systems, high-power fiber-based lasers, targeting systems, data communication links and radar tracking systems, flight control systems, aircraft power systems, lightning suppression systems, clear-air turbulence detection systems, and satellite tracking systems for phased array antennas for a Fortune 500 aerospace company.

Experience (Cont)

- Drafted patent applications relating to industrial anti-counterfeiting measures and backscattering x-ray devices.
- Obtained federally registered trademarks for a famous entertainer and an act that spawned one of the first viral videos on the Internet.
- Enforced common law trademark and trade dress rights of a nationwide manufacturer and distributor of makeup and bath products against a copycat infringer of their products.
- Drafted and successfully prosecuted a portfolio of patents for plasma-based ignition systems designed for use in automotive and aerospace combustion engines.
- Drafted non-infringement and freedom-to-operate opinions for an environmental company performing groundwater thermal remediation of contaminated sites.
- Counseled doctors and solo-inventors in obtaining patent protection for their novel medical device inventions and complying with FDA medical equipment manufacturer provisions.
- Obtained patent protection for a clinical method of analyzing retinas in vivo utilizing two-photon fluoroscopy for patents licensed to a start-up venture by a university tech transfer office.
- Drafted patent applications related to multi-beam acoustic Doppler sonar systems for water discharge measurement of streams, rivers, waterways, and canals.
- Prosecuted a portfolio of patent applications directed to novel printer half-toning innovations, image pre-processing for high definition printers, and scanned image processing for combination scanner-printers for a top printer equipment manufacturer.
- Drafted U.S. and International patent applications for circulation controlled vertical axis wind turbines.
- Counseled a foreign company regarding U.S. intellectual property rights and drafted comprehensive intellectual property provisions for a joint venture with another foreign company.
- Drafted a patent portfolio of anti-malware and anti-virus software patent applications for mobile computing devices for a local start-up company in Ohio.
- Prosecuted a portfolio of patent applications directed to E911 communications, wireless network call processing, and identification of rogue cellphones on wireless networks for a telephone network equipment manufacturer.

Presentations

- "Software Patents: A Moving Target," panelist, eKickstart program (November 2014)

Involvement

Professional Affiliations

- Cleveland Intellectual Property Law Association (CIPLA)
- Cleveland Metropolitan Bar Association (CMBA)

Community Involvement

- Case Western Reserve University School of Law (*Adjunct Professor, IP Moot Court Advisor 2010-2012*)

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Admissions

- State of Ohio
- U.S. District Court, Northern District of Ohio
- U.S. Patent and Trademark Office