



John J. Cotter

Partner

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OVERVIEW

John Cotter concentrates his practice in patent and complex intellectual property trials and appeals. He has tried patent, trademark, and other IP cases and argued Markman and summary judgment hearings; argued appeals at the Federal, First, and Eleventh Circuits; handled inter partes disputes at the U.S. Patent and Trademark Office; and has taken U.S. and overseas arbitrations to judgment.

John's patent cases have involved technologies including HIV antiviral drugs; electronic and optical switching technology; wireless and mobile communications; medical ventilators and blood analyzers; diagnostic medical tests; software and computer systems for FDA clinical trials, medical records, and security; and surgical devices. He advises clients on IP strategy, rights ownership, indemnification, and licensing; internal investigations involving technology and trade secrets; Hatch-Waxman/ANDA patent litigation; exemptions from infringement for FDA-related activities; and global litigation strategies.

John's trademark litigation experience spans from internationally famous to regional and niche brands, for consumer and industrial products, pharmaceuticals, and medical instruments. In the copyright, licensing, trade secrets, and internet areas, John has litigated the leading case on internet trespass; a pro bono artists' and musicians' rights lawsuit resulting in the City of Boston rescinding unconstitutional regulations; entertainment and patent royalty disputes, and software copyright cases including under the Digital Millennium Copyright Act.

His pro bono work also includes trying cases for political asylum seekers in immigration court, and assisting victims of cyber harassment.

PROFESSIONAL BACKGROUND

John was K&L Gates' first firm-wide practice group coordinator for intellectual property litigation from 2006-2011. Prior to joining K&L Gates, he was the co-chair of and partner in the patent and intellectual property practice group of Testa, Hurwitz & Thibault, LLP. Prior to practicing law, John was an engineer with General Electric's Aircraft Engine Group.

ACHIEVEMENTS

- *Best Lawyers in America*, Litigation - Intellectual Property, 2013 - 2021; Litigation - Patent, 2014 - 2018

PROFESSIONAL / CIVIC ACTIVITIES

- American Bar Association (Intellectual Property Law and Litigation Sections)
- American Intellectual Property Law Association
- Boston Bar Association
- Federal Circuit Bar Association
- Intellectual Property Owners Association
- International Trademark Association
- New York Intellectual Property Law Association

SPEAKING ENGAGEMENTS

John has spoken before client, legal, and industry groups including the International Trademark Association (INTA), the Biotechnology Industry Organization (BIO), the Boston Patent Law Association, the Practicing Law Institute, the Licensing Executives Society (LES), and law schools and universities. Examples include:

- "What to Look for in Contingency Fee Arrangements When Deciding to Enforce University Patent Rights," Association of University Technology Managers (AUTM) Eastern Region Meeting, Raleigh, NC October 4, 2019.
- "Today's Legal Challenges in R&D – Review of Recent Litigation and IP Protection in Field Research," Client Seminar, Irvine, CA, April 17, 2019.
- "Primer on Intellectual Property Law for Advertising and Marketing," Client Seminar, Boston, MA, March 2014.
- Leahy-Smith America Invents Act: One Year Later", Client CLE Presentation at annual meeting of in-house IP lawyers, Franklinton NC, October 2013.
- "Securing and Defending IP Rights," European Private Equity and Venture Capital Association (EVCA), Course for Investment Professionals, Paris, France, April 23, 2009.
- "Hot Topics in Patent Litigation," Client CLE Presentation, Reston, VA, November 12, 2007.
- "The Changing World of Intellectual Property Law," Financial Technology Forum (a division of Institutional Investor, Inc.), Boston, MA, November 16, 2005.
- "Intellectual Property Insurance and Risk Management Strategies," Licensing Executives Society, Boston, October 20, 2004.

- "Hatch Waxman Patent Litigation Update," S.G. Cowen & Co. 7th Annual Pharmaceutical and Biotechnology Therapeutic Categories Review Conference and 4th Patent Forum, New York, October 12-13, 2004.
- Host for International Trademark Association Roundtables, Boston, various dates, 2000-2003.
- "Clickwrap and Click-Through; Licensing and Contract Issues," Harvard University Extension School, Cambridge, MA, April 14, 2003.
- "Avoiding Evidence Pitfalls: Demonstrative Evidence," Macaronis Institute for Trial and Appellate Advocacy, Suffolk University Law School, Boston, April 17, 2003.
- "Unwanted Access: Online Trespass and Other Contact," ABA's National Cybercrime Conference at John Marshall Law School, Chicago, May 10, 2002.
- "I.P. for I.T.," Northeastern University's High Tech MBA Program, Dedham, MA, June 1, 2002.
- "Pharmaceutical and Health Care Breakout Session," International Trademark Association Annual Meeting, San Francisco, May 7, 2001.
- "Fair Use, Public Domain or Privacy? Should the Digital Exchange of Copyrighted Works be Permitted or Prevented?," Fordham University Law School's Symposium on Digital Exchange of Copyrighted Works, New York, October 6, 2000, transcript published at Vol. IX, No. 2, Fordham Intellectual Property, Media, and Entertainment Law Journal, Winter 2001.
- "Using and Misusing Third Party Resources," Practising Law Institute's 5th Annual Internet Law Institute, New York, July 9, 2001.
- "The Infringement Continuum: The Expanding Definitional View," American Conference Institute's Intellectual Property on the Internet Seminar, Washington, D.C., November 14, 2000.
- "Property Rights in Cyberspace," Yale Law School's Law and Technology Society Roundtable, New Haven, November 13, 2000.
- "Trademark Law," Suffolk University Law School, Boston, Fall 1999.
- "Patent Infringement Risks: Financial Consequences and Funding Remedies," Biotechnology Industry Organization BIO '98 Conference, New York, June 18, 1998.
- "Selected Permanent Injunction Issues in Patent Litigation," Boston Patent Law Association Litigation Committee Seminar, Boston, April 8, 1998.
- "Development, Enforcement and Defensive Strategies for Intellectual Property," Conference on Latest Developments in Intellectual Property, Burlington, MA, March 19, 1998.

EDUCATION

- J.D., Suffolk University Law School, 1989 (*cum laude*)
- B.S.M.E., Northeastern University, 1985 (*Mechanical Engineering*)

ADMISSIONS

- Bar of Massachusetts
- Bar of New York
- United States Patent and Trademark Office
- Supreme Court of the United States
- United States Court of Appeals for the Eleventh Circuit
- United States Court of Appeals for the Federal Circuit
- United States Court of Appeals for the First Circuit
- United States Court of Appeals for the Ninth Circuit
- United States District Court for the District of Massachusetts
- United States District Court for the Eastern District of New York
- United States District Court for the Southern District of New York

THOUGHT LEADERSHIP POWERED BY HUB

- 24 September 2020, COVID-19: The Impact on Litigation in the Pharmaceutical Industry and Mitigating Risk with Litigation Finance (*Research Surveys*)
- 23 April 2020, COVID-19: IP Strategies for Universities and Nonprofits During the Pandemic – Mitigating Patent Infringement Risks When Making PPE and Other Health-Related Supplies (*Alerts/Updates*)
- 6 March 2019, U.S. Supreme Court Decides Two Copyright Cases and Impacts Registration Strategy for Copyright Owners (*Alerts/Updates*)
- 21 December 2018, Federal Circuit Holds Sending Patent Demand Letters Alone May Subject the Sender to Personal Jurisdiction (*Alerts/Updates*)
- 30 March 2017, Sis-Boom-Bah: U.S. Supreme Court Rules That Cheerleader Uniform Design Elements May Be Eligible for Copyright Protection (*Alerts/Updates*)
- 23 March 2017, U.S. Supreme Court Rules that Cheerleader Uniform Elements May Be Eligible for Copyright Protection (*Research Surveys*)
- 15 June 2016, U.S. Supreme Court Eases Inelastic *Seagate* Standard for Enhanced Patent Damages (*Alerts/Updates*)
- 31 May 2016, *Star Athletica, LLC v. Varsity Brands, Inc.* and the Challenge of Copyright Protection for Garment Design (*Research Surveys*)

- 6 May 2016, Is Social Media Sharing of Sports Clips Copyright Infringement? Recent UK Judicial Clarification and International Implications (*Alerts/Updates*)

OTHER PUBLICATIONS

- "Court decisions limit reach of certain method patents," *Boston Business Journal*, September 2008
- "The Inequitable Conduct Defense: Still a Real Issue," *The International Chamber of Commerce, United Kingdom Members Handbook*, Cyworks, 2004.
- "U.S. Patent Appeals Court Marks 20th Anniversary," *The Lawyers Weekly (Canada)*, November 29, 2002.
- "New Protection for Databases - When?," *Intellectual Property Observer*, Winter 2002.
- "Unwanted Access: Online Trespass and Other Contact," *ABA's National Cybercrime Conference Course Handbook*, 2002.
- "Avoid Negotiating Your Company Into an IP Lawsuit," *Intellectual Property Observer*, Summer 2001.
- "Using and Misusing Third Party Resources," *Practicing Law Institute's Fifth Annual Internet Law Institute Course Handbook*, 2001.
- "Supreme Court Decides 'On Sale' Patent Case," *Venture Update*, Summer 1999.

MEDIA MENTIONS

- Quoted, "Bank of America's patent machine keeps rolling," *AmericanBanker.com*, 15 September 2020
- Quoted in "Technology Cases to Watch in 2008," *Technology Law 360*, Portfolio Media, January 1, 2008.
- Quoted in "Let the Music Play," *Boston Globe Magazine*, May 15, 2005.
- Quoted in "Sidewalk shows must go on: Hub give street performers a pass – for now," by J. M. Lawrence, *Boston Herald*, December 23, 2004.
- Quoted in "Singers sue city, say they're harassed," by Shelley Murphy, *Boston Globe*, July 24, 2004, and in "Street performers sue, claiming harassment," by The Associated Press, *Sarasota Herald-Tribune*, Florida, July 24, 2004.
- Quoted in "Suggestions to Overhaul U.S. Patent System Questioned," by Linda Goodspeed, *Boston Business Journal*, June 4-10, 2004.
- Quoted in "Lemelson Patents Ruled Invalid, Unenforceable and Not Infringed," by Daniel S. Burgess, *Photonics Spectra*, March 2004.
- Quoted in "On the Docket: Digital Copyright Act, Pharmaceutical Disputes Will Define IP Battles," by Sheri Qualters, *Boston Business Journal*, September 5-11, 2003.

- Mentioned in "At the Bar: Lawyering Can Turn Into a Real Lifesaver," by Maggie Mulvihill, Boston Herald, July 1, 2003.
- Mentioned in "Hearsay" column, by Jeanne Greeley, Massachusetts Lawyer's Weekly, June 30, 2003.
- Quoted in "Plug Pulled on File-Sharing Students," by Monty Phan, New York Newsday, April 27, 2003.
- Mentioned in "eBay's Behind the Scenes Move," by Victoria Slind-Flor, National Law Journal, August 7, 2000.
- Quoted in Computer & Internet Lawcast, Vol. 11, No. 12, Week of July 10, 2000.
- Quoted in "Bid for Fair Practice: Online auctioneer gains business from link site but doesn't want e-shoppers using the back door," by Debra Baker, ABA Journal, April 2000.

AREAS OF FOCUS

- IP Litigation
- Appellate Litigation
- IP Procurement and Portfolio Management
- K&L Gates Trial Academy
- Pharma and BioPharma Litigation
- Post-Grant Patents

INDUSTRIES

- Consumer Products
- Financial Services
- Fintech
- Higher Education Institutions
- Luxury Products and Fashion

REPRESENTATIVE EXPERIENCE

- *MOAEC, Inc. v. Napster, LLC* (W.D. Wis.). Obtained summary judgment of patent non-infringement for digital music service Napster.
- *Community Arts Advocates v. City of Boston* (D. Mass.) Brought action seeking preliminary injunction on behalf of street performers and musicians group to invalidate City of Boston regulations restricting members' first amendment rights to perform in public spaces. After hearing, the City rescinded its unconstitutional regulations and instituted constitutional regulations.

- Du Pont and C.R. Bard v. Cordis (AAA Arbitration) Represented patent owner Du Pont in patent infringement case arbitrated before Fed. Cir. Judge (ret.) Howard Baldwin involving balloon catheter technology.
- Arrow Fastener v. The Stanley Works (D. Conn.). Represented plaintiff Arrow Fastener in trial for Stanley's infringement of Arrow's T-50 trademark for staple guns. Trial judgment for Arrow.
- France Telecom v. RSA Security (International Chamber of Commerce, International Court of Arbitration). Represented RSA Security in arbitration for alleged patent infringement and unpaid license royalties on patent for encryption technology.
- Digital Privacy, Inc. v. RSA Security, Inc. (E.D. Va.). Obtained summary judgment of patent non-infringement for RSA Security.
- Massachusetts Eye and Ear Infirmary v. QLT Phototherapeutics, Inc. and Novartis (D. Mass.). Represented Mass. Eye and Ear in patent portfolio development strategy for age related macular degeneration surgical procedure, and filed patent infringement action and license and royalty action that resulted in significant royalty payment to Mass. Eye and Ear.
- eBay, Inc. v. Bidder's Edge, Inc. (N.D. Cal.). Represented Bidder's Edge in case involving issue of first impression regarding alleged trespass to chattels based on web crawling, and antitrust counterclaims against eBay.
- PUMA AG and PUMA North America v. Payless Shoesource (D. Mass.). Asserted PUMA's form stripe trade dress in running shoe against infringer.
- Tower Manufacturing Company v. Shanghai ELE Mfg. Co. (D. R.I. and SDNY). Represented designer of safety circuits in patent infringement action against infringer.
- Technology Research Corporation v. Tower Manufacturing Corporation and Fedders Corporation (MD Fla.). Defended Tower Manufacturing and Fedders in patent infringement case involving fault tolerant circuits. Settled after two day hearing and Markman/summary judgment order.
- Kozam and Datasci v. Phase Forward Incorporated (D. Md.). Defended leading maker of clinical trial software for collecting clinical trial data and FDA submission. Case settled after Markman and summary judgment hearing and orders
- Instrumentation Laboratory v. Diamond Diagnostics (D. Mass.): Represented Instrumentation Laboratory in suit asserting infringement by Diamond Diagnostics' own blood testing machine and infringement and counterfeiting by Diamond's unauthorized refurbishment and resale of used Instrumentation Laboratory critical care machines.
- Convera Corporation v. Autonomy (E.D. Va). Represented Convera in trade secret and breach of contract action.
- Walker v. AMVAC Chemical Company (M.D. Tenn. and C.D. Cal.). Defended AMVAC in inventorship and royalty dispute relating to AMVAC's patent for an herbicide. Case settled after AMVAC obtained order transferring case to C.D. Cal.

- *Loken-Flack, LLC v. Novozymes Bioag, Inc.* (D. Colo. No.). Obtained summary judgment of correct inventorship for defendant Novozymes regarding Novozymes' patent for a crop treatment compound. Affirmed on appeal).
- *Knopp Neurosciences Inc. v. Biogen Idec* (D. Mass.) Represented Knopp in a patent license and breach of R&D contract action involving Knopp's and Biogen's joint development of dextramipexole for treating ALS.
- Argued for appellant John Lavin in appeal of preliminary injunction enjoining him from employment at online retail pharmacy PillPack LLC.
- *Alnylam Pharmaceuticals, Inc. v. Silence Therapeutics plc* (D. Mass.). Represented Alnylam in seeking declaratory judgment of non-infringement of five Silence Therapeutics patents by Alnylam's RNAi therapeutic ONPATTRO™ (patisiran).
- *G. Pohl-Boskamp GmbH v. Perrigo* (D. Mass.): Asserted German pharmaceutical maker Pohl-Boskamp's Nitrolingual pumpspray trade dress against generic manufacturer
- *G. Pohl-Boskamp GmbH v. Akrimax* (D. Mass.): Asserted German pharmaceutical maker Pohl-Boskamp's Nitrolingual pumpspray trade dress and copyrights against competitor and generic manufacturer.
- *Meddaugh v. WGBH Educational Foundation* (Mass. Superior Ct.). Tried case for defendant WGBH against allegations that WGBH owed \$19 million in allegedly unpaid royalties for the Martha Speaks animated public TV series based on books by author Susan Meddaugh. After trial, court entered judgment in 2018 of no actual damages and \$100 in nominal damages.
- *Accusoft Corporation v. Quest Diagnostics, Inc.* (D. Mass.). Defended Quest Diagnostics and its software subsidiary in software copyright and license royalty dispute. Case settled after obtaining partial summary judgment for Quest.