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**Kimberly A. Mottley**

**Partner**

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Kim Mottley is a partner in Proskauer's Litigation Department. She practices exclusively in the area of complex intellectual property disputes, with a primary focus on patent and trademark infringement matters. Kim enjoys partnering with her clients to find creative and efficient means of meeting their ultimate business objectives. She has counseled her clients through all phases of litigation, including strategic case preparation, obtaining temporary restraining orders, discovery, *Markman* hearings, settlement negotiations and alternative dispute resolution, trial and appeals before the Federal Circuit.

Kim's patent litigation clients span a broad range of electronics and life sciences industries, including biosimilars, immunology and diagnostic devices, medical devices and instruments, RFID, telecommunications, smartphones, tablets, live chat, automotive pistons, high-density plasma cutting torches, semiconductor manufacturing technology, nanotechnology, and financial instruments. Kim helps her retail industry clients to protect and enforce their most valued trademark assets. She also is active in Proskauer's pro bono efforts.

In 2018, *Massachusetts Lawyers Weekly* honored Kim as a "Top Woman of Law," a recognition for individuals who have made significant contributions to the legal profession while also serving as role models for young women entering the law. *Benchmark Litigation* also recently named Kim a 2019 Future Star. In 2017, *Benchmark Litigation*

named Kim to its 2017 Under 40 Hot List – an accolade which honors highly qualified, exceptional partners aged 40 or younger. In 2014, Kim was named one of *The National Law Journal's* Boston Rising Stars, which recognizes Boston's 40 most promising lawyers under the age of 40 who are considered innovators with strong leadership qualities. Kim has also been recognized by *Massachusetts Super Lawyers Magazine* as a "Rising Star" and as among the "Top Women Attorneys in Massachusetts" for the past several years.

## Matters

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### Representative Patent Infringement Matters include:

- *Genentech, Inc. and City of Hope v. Amgen Inc. (D. Del.)* Representing Amgen in patent litigation concerning Amgen's FDA-approved bevacizumab biosimilar, Mvasi™
- *Oxford Immunotec Ltd. V. Qiagen N.V., Qiagen, Inc. et al. (D. Mass.)* Represented Oxford in successfully asserting infringement of six patents related to tuberculosis diagnosis resulting in a public \$27.5 million payment to Oxford on the eve of the trial
- *MobileMedia Ideas, LLC v. Apple Inc. (D. Del.)* Trial counsel for MobileMedia in victory against Apple, in which the jury found certain iPhone models infringed a Sony patent concerning silencing the ringtone of incoming calls
- *ConforMIS, Inc. v. Smith & Nephew, Inc. (D. Mass.)* Represented ConforMIS in patent case involving patient-specific surgical instruments and implants
- *Smart Skins LLC v. Microsoft Corporation (W.D. Wash.)* Represented Smart Skins in asserting infringement of patent related to smart interchangeable covers which add peripherals to mobile devices
- *Media Bridge, LLC v. Clear Channel Outdoor Holdings, Inc. and Blue Bite, LLC (D. Del.)* Defended Defendants' use of NFC technology in mobile advertising platforms against allegations of infringement of patents related to linking tangible media and computer media.
- *LivePerson, Inc. v. Pragmatus Telecom, LLC (D. Del.)* Represented

LivePerson in declaratory judgment action seeking declarations of invalidity and noninfringement of patents related to coordinating data and voice communications

- *NISTAC v. American Honda Motor Co. (E.D. Mich.)* Defended Honda against allegations of infringement of patents related to piston design and piston lubricant chemical composition; obtained a favorable claim construction ruling on nearly every issue, causing plaintiff to agree to dismissal with prejudice of all its remaining claims
- *ARRIS Group v. SeaChange International (D. Del.)* Represented SeaChange in defense of a contempt motion filed by ARRIS alleging that SeaChange violated a 2006 permanent injunction by redesigning its Interactive Television service technology; Court found in our client's favor on every contested issue
- *LivePerson, Inc. v. Lodsys (E.D. Wisc., E.D. Tex.)* Represented LivePerson in declaratory judgment action seeking declarations of invalidity and noninfringement of patents related to gathering information from units of a commodity, and related co-pending action filed by patent-holder asserting infringement
- *Smartrac Technology Ltd. And Smartrac Technology US, Inc. v. Leighton Technologies, LLC (S.D.N.Y.)* Represented Smartrac in declaratory judgment action seeking declarations of invalidity and non-infringement of patents related to smartcards
- *NTP, Inc. v. T-Mobile USA, Inc. (E.D. Va.)* Defended T-Mobile against patent infringement claims relating to wireless communications in electronic mail systems
- *Fotomedia Technologies LLC v. T-Mobile USA (E.D. Tex.)* Defended T-Mobile against patent infringement claims relating to photo sharing technology
- *Gemini IP, LLC v. LivePerson, Inc., Landesk Software, Inc., et al. (E.D. Tex.)* Defended LivePerson against allegations of infringement of a patent related to network-based customer service methods
- *Transamerica Life Insurance Co. v. Lincoln National Life Insurance Co. (N.D. Iowa, N.D. Ind., Fed. Cir.)* Represented Transamerica in defending against three patents relating to annuity insurance products in three separate cases.

Proskauer was retained after an adverse jury verdict, and obtained reversal of a \$13 million judgment on appeal to the Federal Circuit.

- *MKS Instruments, Inc. v. New Power Plasma (N.D. Cal.)* Successfully obtained temporary restraining order for MKS Instruments against Korean competitor in dispute relating to technology used in the semiconductor industry
- *Smartrac N.V., Smartrac IP B.V., and Smartrac Technology U.S. Inc. v. On Track Innovations Ltd. and OTI America, Inc. (D. Del.)* Represented Smartrac in both asserting and defending against patent infringement claims involving Radio Frequency Identification (RFID) systems
- *Ronald A. Katz Technology Licensing, L.P. v. PPL Corporation, PPL Electric Utilities Corporation, PPL Gas Utilities Corporation, and PPL Solutions, LLC (C.D. Cal.)* Defended PPL against claims of patent infringement in multi-district litigation involving interactive call processing
- *Massachusetts Institute of Technology v. Harman Int'l Indus., Inc. (D. Mass.)* Represented MIT in a patent enforcement suit against an automobile navigation system manufacturer
- *MKS Instruments, Inc. v. Advanced Energy Corp. (D. Del.)* Represented MKS Instruments in patent action against Advanced Energy Corp., obtaining infringement verdict in MKS's favor in litigation relating to high-energy plasma processing equipment used by the semiconductor industry
- *Digital Privacy, Inc. v. RSA Security Inc. (E.D. Va.)* Defended RSA Security against claims that its SecurID® Passage computer security product infringed three patents, obtaining summary judgment that the product did not infringe
- *Hypertherm, Inc. v. Inner Logic, Inc. (D. N.H.)* Represented Hypertherm in its assertion of infringement of two patents relating to a plasma ignition circuit

### **Representative Trademark Infringement Matters include:**

- *Keds and SR Holdings, LLC v. Vans, Inc. (D. Mass.)* Represented Keds and SR Holdings in asserting infringement and dilution of Keds' blue label trademarks, unfair competition, and breach of contract

- *Keds and SR Holdings, LLC v. Vans, Inc., Four Star Distribution (d/b/a C1RCA Footwear) and One-Distribution Company, LLC (distributing Supra footwear) (D. Mass.)* Represented Keds and SR Holdings in 3 separate actions asserting infringement of its blue label trademarks
- *SRL, LLC v. Munchkin, Inc. (D. Mass.)* Represented SRL in assertion of infringement of its trademarks and breach of co-existence agreement
- *SR Holdings, LLC v. Puma North America (D. Mass.)* Represented SR Holdings in assertion of infringement of its Pro-Keds Powerstripe trademarks

### Other Representative Intellectual Property Matters include:

- *Smartrac N.V. v. Assa Abloy AB and Aontec Teoranta (Del. Chancery)* Represented Smartrac in seeking injunctive relief and damages against competitors based on claims involving an assignment and license agreement between the parties
- *Comtech AHA Corp. v. Efficient Channel Coding, Inc. (N.D. Ohio)* Represented Comtech in a breach of patent license agreement dispute relating to error correction codes used in satellite communications
- *Massachusetts Institute of Technology v. Dharmacon (D. Mass.)* Represented MIT in a license dispute involving its foundational patents on siRNA technology
- *Candela Corp v. The Regents of the University of California (American Arbitration Association)* Represented Candela in an arbitration relating to a patent license dispute involving cryogenic cooling devices used for cosmetic laser surgery

#### Practices

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Litigation, Intellectual Property, Patent Law

#### Industries

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Technology, Media & Telecommunications

## Education

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Washington & Lee University School of Law, J.D., 2001

*magna cum laude*

Order of the Coif

University of Richmond, B.A., 1998

*summa cum laude*

Phi Beta Kappa

## Admissions & Qualifications

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Massachusetts

## Court Admissions

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U.S. District Court, Massachusetts

U.S. Court of Appeals, Federal Circuit

U.S. Court of Appeals, First Circuit

U.S. District Court, Michigan, Eastern District

U.S. District Court, Wisconsin, Eastern District

## Memberships

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Boston Patent Law Association

American Intellectual Property Law Association

## Awards & Recognition

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Benchmark Litigation, Future Star 2019-2020

Benchmark Litigation Under 40 Hot List 2016-2017

Best Lawyers in America 2019

National Law Journal's "Boston Rising Star" 2014

Massachusetts Super Lawyers "Rising Stars" 2012-2017

Massachusetts Super Lawyers: The Top Women Attorneys in Massachusetts 2013-2015, 2017