



Contact

Kimberly A. Mottley

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Kim Mottley is a partner in Proskauer's Litigation Department. She counsels clients facing complex intellectual property disputes, primarily focusing on patent and trademark infringement matters. Kim navigates 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. She partners with clients to find creative and efficient ways to meet their business objectives.

Kim's patent litigation clients spans across the technology 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 is also active in the Firm's pro bono efforts.

Benchmark Litigation names Kim a Future Star for the past few years. 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. 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 several years.

Matters

Representative Patent Infringement Matters include:

- *Genentech, Inc. and City of Hope v. Amgen Inc. (D. Del.)*
Represented 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

Litigation, Patent Law

Industries

Technology, Media & Telecommunications

Education

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

Massachusetts

Court Admissions

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

Awards & Recognition

Benchmark Litigation, Future Star 2019-2021

Benchmark Litigation Under 40 Hot List 2016-2017

Best Lawyers in America 2020-2021

National Law Journal's "Boston Rising Star" 2014

Massachusetts Super Lawyers "Rising Stars" 2012-2017

Massachusetts Super Lawyers: The Top Women Attorneys in Massachusetts 2013-2018

Massachusetts Weekly, Top Women in Law Honoree, 2018