



Kyle M. Kantarek

Special Projects Lawyer

Chicago
+1.312.807.4206

Kyle.Kantarek@klgates.com

OVERVIEW

Kyle Kantarek is an associate in the IP Litigation practice. Kyle is an accomplished intellectual property attorney with extensive experience on patent, copyright, and trade secret matters. He is a registered patent attorney with a background in materials science and engineering. Prior to his career as a lawyer, Kyle worked at a valve manufacturing company in the Chicago suburbs.

Kyle is experienced in all facets of intellectual property litigation, including fact and expert discovery, motion practice, claim construction practice, and trial practice. He has been an integral part of trial teams developing strategies in patent infringement cases before various federal district courts as well as the International Trade Commission. He also has experience in appellate practice before the Court of Appeals for the Federal Circuit.

As a lawyer registered with the US Patent and Trademark Office, Kyle has extensive experience with post-grant proceedings at the Patent Trial and Appeal Board, and has been involved in more than 20 *inter partes* review proceedings on behalf of Patent Owners usually during co-pending district court litigation.

Kyle's experience includes work in various federal district courts and at arbitration, both supporting and in defense of charges of patent infringement and trade secret misappropriation. Kyle's litigation experience spans a diverse set of technologies, including computer hardware and software, renewable energy, medical devices, logistics, prescription drugs, and financial services.

Kyle has litigated in numerous patent venues, including the Eastern District of Texas, the District of Delaware, the Northern District of California, the Southern District of California, and the Northern District of Illinois.

Outside of the courtroom, Kyle also counsels clients on transactions involving transfer of intellectual property or entities with ongoing intellectual property litigation. Kyle has advised clients on a broad array of technologies, including cryptocurrency mining, supercritical water oxidation, internet gaming, automotive, gas-to-liquid conversion, automation of advertising, cutting and tooling, textile manufacturing, shaved ice, solar power, gene therapy, and fitness equipment.

Pro bono work is also important to Kyle. He is currently representing a client in a federal *habeas corpus* petition seeking to overturn a life sentence. He has partnered with the Illinois Torture Inquiry and Relief Commission to

analyze evidence from old cases to determine whether a complainant is entitled to statutory relief for claims of torture during interrogation

PROFESSIONAL BACKGROUND

Prior to joining the firm, Kyle served as a partner in the Chicago office of an international firm, where he focused his intellectual property practice on patent, copyright, and trade secret matters.

ACHIEVEMENTS

- Recognized in *The Best Lawyers: Ones to Watch® in America* in Chicago, IL
 - Litigation - Patent, 2021–2025, 2027
 - Litigation - Intellectual Property, 2023–2025, 2027

EDUCATION

- J.D., University of Illinois College of Law, 2015 (*summa cum laude*, *Order of the Coif*)
- B.Sc., University of Illinois at Urbana – Champaign, 2010 (*Materials Science and Engineering – Metallurgy*)

ADMISSIONS

- Bar of Illinois
- United States Patent and Trademark Office
- United States Court of Appeals for the Federal Circuit
- United States Court of Appeals for the Sixth Circuit
- United States District Court for the Eastern District of Michigan
- United States District Court for the Northern District of Illinois

AREAS OF FOCUS

- IP Litigation
- Post-Grant Patents
- Trade Secrets Litigation

INDUSTRIES

- Hardware and Semiconductors

- Manufacturing
- Metals Manufacturing and Fabrications
- Technology
- Transportation and Logistics

REPRESENTATIVE EXPERIENCE

Patent Litigation

- Representing a US retail automotive services company in a patent infringement action regarding patents on combining mapping content displayed on mobile devices and drafting pleadings and engaging in local patent rule and venue discovery.
- Represented a sporting equipment manufacturer in a patent infringement investigation before the ITC regarding patents on pickleball paddle construction and spearheaded discovery efforts.
- Represented an IT services and consulting company in a patent infringement action regarding push-to-talk connections; drafted *Daubert* and summary judgment motions.
- Represented a semiconductor company in a patent infringement action regarding networking over coaxial cables; spearheading document discovery efforts; drafted motions to dismiss, amend, reconsider, and briefing before the special master regarding discovery disputes.
- Represented a venture capital and private equity firm in a patent infringement action regarding Internet advertising technology; spearheaded document discovery efforts; defeated two motions to dismiss for lack of patentable subject matter; obtained dismissal with prejudice of inequitable conduct defense.
- Represented a medical equipment manufacturing company in a patent infringement action brought by a global medical technology company regarding cochlear implant technology; won summary judgment of non-infringement of both patents asserted by the global medical technology company; led drafting of briefing on motion for summary judgment of non-infringement and invalidity for improper recapture and responses to *Daubert* motion against non-infringement and invalidity expert witness; negotiated joint stipulation of partial dismissal.
- Represented a logistics services and trucking company in a patent infringement action brought by a storage and transportation company alleging infringement of five patents regarding containers for transporting bulk solids; won summary judgment of non-infringement of all five patents (at two separate summary judgment hearings) based in part on favorable claim construction ruling; defeated motions to dismiss inequitable conduct and unclean hands allegations and motion for leave to serve amended contentions.
- Represented a logistics services and trucking company in a patent infringement action involving containers for transporting proppant and systems for same; obtained favorable settlement with co-defendant prior to entry of final judgment.

- Represented a pharmaceutical company in a three-patent infringement action (ANDA litigation) against a patent-holder pharmaceutical company, where one of the asserted patents was previously found valid and infringed in a prior case and on appeal; took over case five weeks before trial and won non-infringement of two of the three asserted patents (including the one previously found valid and infringed) purportedly covering ANDA product at trial; noninfringement affirmed and infringement verdict of remaining patent reversed on appeal; defended against additional assertions of patent infringement based on new patents obtained during initial litigation; parties settled thereafter.
- Represented a software development company in a patent infringement action brought by an intellectual property company alleging infringement of patents for tracking potential consumers; obtained voluntary dismissal of action prior to answer deadline via Rule 11 letter.
- Represented a microscope and scientific instrument manufacturer in two patent infringement actions brought by a medical device company alleging infringement of patents regarding fiber optics for spectroscopy procedures; obtained initial voluntary dismissal of action without prejudice in negotiations prior to answering based on strong defenses to patent infringement; obtained settlement on terms favorable to client in negotiations prior to the beginning of discovery.

Inter Partes Review Proceedings

- Represented a patent owner in *inter partes* review proceedings regarding patents on mobile communication technology; deposed expert witnesses, drafted briefing, and argued oral hearing for multiple proceedings.
- Represented a patent owner in *inter partes* review proceedings regarding patents on containers for transportation of fracking proppant; multiple claims across multiple patents determined to be not unpatentable.
- Represented a patent owner in *inter partes* review proceeding regarding patents on containers for transportation of fracking proppant.
- Represented a patent owner in *inter partes* review proceedings regarding patents on containers for transportation of fracking proppant; drafted patent owner responses, sur-replies, and hearing demonstratives; assisted in preparation of expert declarations; drafted one of the first granted requests for director review; negotiated and drafted settlement agreement.
- Represented a patent owner in *inter partes* review proceedings regarding patents on low-profile light fixtures; obtained partial denial of institution prior to SAS; PTAB found multiple claims not unpatentable prior to Federal Circuit appeal; client used other representation in handling appeals.

Trade Secret Experience

- Represented a pulse modulator original equipment manufacturer in an arbitration against a supplier of pulse transformers; won a near-complete defense against claims of breach of contract and trade secret misappropriation.
- Represented a healthcare technology company and its parent company in a trade secret misappropriation, unfair competition, and breach of contract matter against an information and technology services company

involving healthcare software systems; won complete victory as counterclaim-plaintiffs following a week-long jury trial, including an award of US\$855 million in damages.

- Represented a pharmacy software company in a trade secret misappropriation, breach of contract, and unfair trade practices matter involving pharmacy workflow software; defeated motion to dismiss and motion to unseal portions of the company's confidential and proprietary information prior to answer.
- Advised an investment management client on best practices for protection of trade secret and other confidential material and ownership of same by arriving and departing employees of all types.

Other Disputes

- Represented a technology services provider to K-12 school districts at close of fact discovery stage asserting claims of trademark infringement and unfair competition; case settled after dispositive briefing.
- Represented an agriculture chemical company at motion to dismiss stage in MDL brought by seed distributors for breach of contract, deceptive trade practices, and negligence; won dismissal of multiple claims and multiple defendants.
- Represented a safety and security system provider in a proposed class-action for alleged violations of the Telephone Consumer Protection Act (TCPA); won dismissal of allegations of willful violation of TCPA; case settled favorably prior to class-certification while the company's motion to compel further document discovery was pending.
- Won a complete victory for a major pharmaceutical company in a confidential arbitration with several hundred million dollars at stake related to a drug compound joint development agreement.
- Advised a racing and sports betting company on a contractual dispute with a gaming software developer and service provider regarding a response to security incident; negotiated favorable transition and termination agreement without court intervention.

Client Counseling

- Advised a private equity client on intellectual property holdings of right-of-way services and disclosure schedules associated with the transaction.
- Advised a minerals industry client on a patent litigation involving a logistics supplier acquisition target; analyzed infringement and validity of patents asserted by acquisition target; took over representation after acquisition.
- Advised an investment company on the purchase of data centers for cryptocurrency mining allegedly infringing third-party patents; prepared budget for phased analysis of vague licensing demand from third-party patent owner.
- Advised a global investment firm on the creation of a joint venture with a nonprofit research organization holding patents and owning technology on the use of supercritical water oxidation to destroy per-and polyfluoroalkyl substances; reviewed and analyzed patents owned by the research organization and competitors; reviewed and analyzed existing patent strategy.

- Advised an Internet gaming client on a potential partnership with established US-based competitors and strength of its patent portfolio.
- Advised a software company client on the potential purchase of a large (175+) automotive technology patent portfolio; analyzed possibility of infringement by client and invalidity of representative patents from different patent families using client and public documents.
- Advised a software company client on a trade secret and patent litigation involving information technology acquisition target; analyzed validity of patent asserted against acquisition target; analyzed products at issue for the materiality of possible damages to acquisition.
- Advised a healthcare provider client on a data breach and ransomware issue; analyzed issues stemming from technical read-out, overall exposure analysis, and potential recourse against the party responsible for the breach.
- Advised a private equity client on a patent dispute involving a telematics solution provider acquisition target; analyzed specific patent infringement claims and general damages awards in the telematics space.
- Advised a private equity client on a patent dispute involving an advertising automation platform acquisition target; analyzed specific patent infringement claims and the acquisition target's invalidity analysis of same.
- Advised a private equity client on a patent litigation involving a cutting and tooling acquisition target; analyzed litigation prospects, which led to settlement prior to closing.
- Advised a private equity client on existing freedom to operate opinions prepared by gas-to-liquid conversion technology acquisition target.
- Advised a private equity client on a patent litigation involving a textile manufacturer acquisition target; analyzed possible lost profits damages available in market with a small number of competitors.
- Advised a private equity client on a trade secret litigation involving a behavioral health center software developer acquisition target; analyzed target's pursuit of preliminary injunction and prospects for success.
- Advised a private equity client on a patent litigation involving a shaved ice food truck franchise investment target; analyzed target's litigation strategy and material infringement and validity issues.
- Advised a private equity client on a large (300+) patent portfolio of biofuel technology investment target; analyzed representative patents and competitors.
- Advised a private equity client on a patent litigation involving solar panel manufacturer acquisition target; analyzed settlement agreement and patent portfolios in the market, including the effect on future patent litigation.
- Advised a private equity client on a royalty demand letter from NPE directed to customer service technology investment target; analyzed validity and infringement of patent asserted in demand letter.
- Advised a private equity client on a patent litigation involving hygiene product manufacturer acquisition target; analyzed ongoing *inter partes* review proceedings and effect on companion district court case; provided analysis of material patents for validity and enforceability.

- Advised a private equity client on an intellectual property portfolio (including 75+ patents) of gene therapy technology acquisition target; analyzed ability of patent portfolio to exclude others from using target's material products; analyzed procedure for protection and use of trade secrets.
- Advised a private equity client on a small (<10) patent portfolio of logistics supplier acquisition target; analyzed third-party freedom to operate opinion.
- Advised a private equity client on a portfolio company patent litigation involving fitness equipment; analyzed prospects of obtaining a preliminary injunction.

Pro Bono

- Represented a client serving a life sentence in federal *habeas corpus* proceeding; drafted petition and reply briefing; performed additional fact investigation prior to filing; drafted briefing and argued appeal to Sixth Circuit.
- Prepared and supervised preparation of draft dispositions for a state agency; analyzed state court transcripts and other evidence to determine whether the complainant is entitled to statutory relief.