

John J. Cotter

Partner

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OVERVIEW

John Cotter is a Chambers and Best Lawyers® recognized leader of patent, complex intellectual property, and commercial cases at trials and on appeals. He has tried patent, trademark, trade secret, and other IP cases; argued Markman, TRO, preliminary injunction, and summary judgment hearings; argued appeals at the Federal, First, and Eleventh US Circuits and the Massachusetts Appeals Court; handled inter partes disputes at the US Patent and Trademark Office; and has taken US and overseas arbitrations to judgment.

John's patent cases have involved agricultural and industrial chemicals and biologicals; pharmaceuticals; electronic and optical switching technology; semiconductors; wireless and mobile communications; medical ventilators and blood analyzers; diagnostic medical tests; software and computer systems for web services, FDA clinical trials, medical records, and security; and surgical devices. He advises clients on IP strategy, rights ownership, indemnification, license agreements, and license enforcement programs; internal investigations and remediation involving technology and trade secrets; Hatch-Waxman/ANDA patent litigation; and coordinated 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 litigated the leading case on internet trespass; a pro bono artists' and musicians' rights lawsuit resulting in rescinding unconstitutional regulations; entertainment and patent royalty disputes; non-competition restrictions and software copyright cases including under the Digital Millennium Copyright Act.

His pro bono work 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. 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 & Thibeault. Before practicing law, John was an engineer with General Electric's Aircraft Engine Group.

ACHIEVEMENTS

- Recognized by *Chambers USA* for Intellectual Property in Massachusetts, 2025-2026
- Recognized in *The Best Lawyers in America*® for Litigation-Intellectual Property, 2013-2024; Litigation-Patent, 2014-2018; Patent Law, 2021-2024

PROFESSIONAL / CIVIC ACTIVITIES

- 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 the International Trademark Association (INTA), the Biotechnology Industry Organization (BIO), the Practicing Law Institute, the Licensing Executives Society (LES), the Association of University Technology Managers (AUTM), and law schools and universities. Examples include:

- "Recent Trends and Relevant Cases – Patent and Trade Secret Litigation," American Society of Appraisers (ASA), 2024 Litigation in Valuation Conference, Virtual, 21 November 2024.
- "Patent and Intellectual Property Basics for University Entrepreneurs," Wentworth Institute of Technology, Accelerate Innovation and Entrepreneurship Center, Boston, MA, 14 February 2023.
- "University IP Licensing" presentation to Northeastern University Bioengineering Industrial Advisory Board, Boston, MA, 26 May 2021.
- "The Impact of COVID-19 on Litigation in the Pharmaceutical Industry and Mitigating Risk with Litigation Finance," K&L Gates Webinar, 24 September 2020.
- "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 4 October 2019.
- "Today's Legal Challenges in R&D – Review of Recent Litigation and IP Protection in Field Research," Seminar, Irvine, CA, 17 April 2019.
- "Primer on Intellectual Property Law for Advertising and Marketing," Seminar, Boston, MA, March 2014.

- "Leahy-Smith America Invents Act: One Year Later," 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, 23 April 2009.
- "Hot Topics in Patent Litigation," CLE Presentation, Reston, VA, 12 November 2007.
- "The Changing World of Intellectual Property Law," Financial Technology Forum (a division of Institutional Investor, Inc.), Boston, MA, 16 November 2005.
- "Intellectual Property Insurance and Risk Management Strategies," Licensing Executives Society, Boston, 20 October 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, 12-13 October 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, 14 April 2003.
- "Avoiding Evidence Pitfalls: Demonstrative Evidence," Macaronis Institute for Trial and Appellate Advocacy, Suffolk University Law School, Boston, 17 April 2003.
- "Unwanted Access: Online Trespass and Other Contact," ABA's National Cybercrime Conference at John Marshall Law School, Chicago, 10 May 2002.
- "I.P. for I.T.," Northeastern University's High Tech MBA Program, Dedham, MA, 1 June 2002.
- "Pharmaceutical and Healthcare Breakout Session," International Trademark Association Annual Meeting, San Francisco, 7 May 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," Practicing Law Institute's 5th Annual Internet Law Institute, New York, 9 July 2001.
- "The Infringement Continuum: The Expanding Definitional View," American Conference Institute's Intellectual Property on the Internet Seminar, Washington, D.C., 14 November 2000.
- "Property Rights in Cyberspace," Yale Law School's Law and Technology Society Roundtable, New Haven, 13 November 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, 18 June 1998.
- "Selected Permanent Injunction Issues in Patent Litigation," Boston Patent Law Association Litigation Committee Seminar, Boston, 8 April 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 Central District of Illinois
- 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*

- 28 December 2020, U.S. Spending Bill Includes Sweeping New Copyright and Trademark Measures
- 24 November 2020, District Court Judge Takes Narrow View of Preemption Under the Massachusetts Uniform Trade Secrets Act
- 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
- 6 March 2019, U.S. Supreme Court Decides Two Copyright Cases and Impacts Registration Strategy for Copyright Owners

- 21 December 2018, Federal Circuit Holds Sending Patent Demand Letters Alone May Subject the Sender to Personal Jurisdiction
- 30 March 2017, Sis-Boom-Bah: U.S. Supreme Court Rules That Cheerleader Uniform Design Elements May Be Eligible for Copyright Protection
- 23 March 2017, U.S. Supreme Court Rules that Cheerleader Uniform Elements May Be Eligible for Copyright Protection
- 15 June 2016, U.S. Supreme Court Eases Inelastic *Seagate* Standard for Enhanced Patent Damages
- 31 May 2016, Star Athletica, LLC v. Varsity Brands, Inc. and the Challenge of Copyright Protection for Garment Design

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.

NEWS & EVENTS

- 25 June 2026, K&L Gates Recognized by ABI for Innovation and Technology Sale of the Year
- 4 June 2026, K&L Gates Receives Nearly 235 Firm, Individual Rankings in 2026 *Chambers USA* Guide
- 30 March 2026, K&L Gates Advises ZipBy in First Circuit Victory Affirming US$4.5 Million Judgment
- 19 March 2026, K&L Gates Receives *M&A Advisor* Information Technology Deal of the Year Award
- 5 June 2025, K&L Gates Receives More Than 240 Firm, Individual Rankings in 2025 *Chambers USA* Guide
- 22 May 2025, K&L Gates Advises Akoustis Technologies in its Sale of Assets to SpaceX
- 29 January 2024, K&L Gates Advises ZipBy and TMA in Trade Secret and Trademark Trial Win

- 29 January 2024, K&L Gates Leads Novozymes to Trade Secrets Trial Victory
- 18 August 2022, More Than 350 K&L Gates Lawyers Named Among 2023 Best Lawyers in America, Ones to Watch
- 19 August 2021, Nearly 300 K&L Gates Lawyers Named Among 2022 Best Lawyers in America, Ones to Watch

MEDIA MENTIONS

- 6 April 2026, *Massachusetts Lawyers Weekly* | 1st Circuit rejects trade secrets claim in ZipBy damages case

OTHER 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
- Pharma and BioPharma Litigation
- Post-Grant Patents
- Trade Secrets Litigation

INDUSTRIES

- Consumer Goods and Services
- Financial Services
- Fintech
- Hardware and Semiconductors
- Healthcare
- Higher Education Institutions
- Life Sciences
- Luxury Products and Fashion
- Technology
- Telecommunication and Mobile

REPRESENTATIVE EXPERIENCE

- ZipBy USA v. Parzych (D. Mass.). Won jury trial for plaintiff ZipBy on claims of breach of NDA, trade secret misappropriation, trademark infringement, and breach of fiduciary duty against its former president; the court entered final judgment for ZipBy of US$4.3 million, including attorney fees.
- Marquis ProCap v. Novozymes North America (C.D. Ill.). Tried case to judgment fully in client Novozymes' favor. The trial court denied plaintiff's claim for a permanent injunction based on alleged misappropriation of trade secrets and breach of NDA, finding that two of the plaintiff's three alleged trade secrets for high-protein animal feed production were not kept secret and the third was not specific enough to be protected. The court also found that Novozymes did not disclose or threaten to disclose any of the alleged trade secrets or proprietary information.

- 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. (D. Mass.). Represented Mass. Eye and Ear in patent portfolio development strategy for age-related macular degeneration surgical procedure and filed patent license 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 S.D.N.Y.). Represented designer of safety circuits in patent infringement action against infringer.
- Technology Research Corporation v. Tower Manufacturing Corporation and Fedders Corporation (M.D. 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., C.D. Cal.). Defended AMVAC in inventorship and royalty dispute relating to AMVAC's patent for an herbicide. Case settled after AMVAC obtained favorable order.
- Loken-Flack, LLC v. Novozymes Bioag, Inc. (D. Colo., Fed. Cir., USPTO PTAB). Obtained summary judgment of correct inventorship for defendant Novozymes regarding Novozymes' patent for a crop treatment compound. Affirmed on appeal. Also obtained judgment of correct inventorship in PTAB interference.
- 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 dexpramipexole for treating ALS.
- CVS v. Lavin (First Cir.). 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.
- 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.
- Source Search Technology v. KAYAK Software Corporation (D. N.J., Fed. Cir.). Defended online travel provider KAYAK in patent infringement suit involving travel services software systems. Obtained partial summary judgment of patent invalidity and non-infringement, final summary judgment of patent ineligibility, exceptional case order, and substantial fee award. Affirmed on appeal.
- Meddaugh v. WGBH Educational Foundation (Mass. Superior Ct., Mass. App. Ct.). Tried case to judgment for defendant WGBH against claims that WGBH owed US$19 million in allegedly unpaid royalties for animated TV series based on children's books by author Susan Meddaugh. After trial, the court entered judgment of no actual damages and US$100 in nominal damages. Affirmed on appeal.
- Gammino v. Sprint (E.D. Pa., Fed. Cir.). Defended Sprint Nextel Corporation in patent infringement case involving telephone switching systems. After winning partial summary judgment and favorable Markman order for Sprint, plaintiff agreed to final judgment of non-infringement. Affirmed on appeal.
- Defended clients such as Cedar Electronics; Alera Group, Inc; and other insurance, financial services, and industrial entities in patent infringement cases brought by non-practicing entities.

- Represented Ansys, Inc. in enforcing copyrights and license terms for Ansys' engineering simulation software for product design, testing, and operation in the N.D. Cal., S. D. Cal., W.D. Tex., and W.D. Wis.
- In re Akoustis, Inc. (D. Del. Bkrtcy.). Represented debtors in Chapter 11 bankruptcy case to ensure debtors' compliance with district court's post-trial permanent injunction and bankruptcy court's related order requiring identification and removal of competitor's semiconductor trade secrets from debtors' computer systems and manufacturing and test equipment. Presented debtors' experts and cross-examined competitor's experts at multiday evidentiary hearings on debtors' compliance with injunction and order.
- Represents colleges and universities such as North Carolina State University and Wentworth Institute of Technology in patent and intellectual property matters.