John K. McDonald, Ph.D.

Retired Partner

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Services

Asset Creation - Prosecution & Counseling

Intellectual Property

Licensing, Transactions & Monetization

Market Protection - Opinions & Dispute Avoidance

Patents

Industries

Health & Life Sciences

Medical & Surgical Devices

Food, Restaurant & Beverage

Retail & Consumer Goods

John McDonald focuses his practice on planning and implementing international patent strategy for clients engaged in the biotechnology, pharmaceutical and chemical industries. He represents early stage, private and publicly traded companies. He regularly conducts intellectual property due diligence studies for clients including freedom to operate, validity and patentability opinions.

John joined the faculty of the Department of Anatomy and Cell Biology at Emory University School of Medicine where he later became a tenured full professor. During his tenure at Emory, his research studies in peptide neuroendocrinology, neuroscience and endocrinology were funded by the National Institutes of Health, the National Science Foundation and the March of Dimes Birth Defects Foundation. He is currently an Emeritus Professor at Emory University School of Medicine. John also conducted research studies in pancreatic endocrinology at the Marine Biological Laboratories in Woods Hole, Massachusetts, and in neurobiology at the Yerkes Regional Primate Research Center in Atlanta.

John is listed in *The Best Lawyers in America*® in 2019 and each of the ten years immediately preceding. He was named a 2015 "Atlanta Lawyer of the Year" in the area of Biotechnology Law by *The Best Lawyers in America*®. John is recognized as a Georgia "Super Lawyer" in the area of Intellectual Property in 2019 and the eight years immediately preceding by *Super Lawyers* magazine. He received the Research Career Development Award from the National Institutes of Health. John also received the Basil O'Connor Scholar Research Award from the March of Dimes Birth Defects Foundation as well as the Annual Basmajian/Williams & Wilkins Award for outstanding research and teaching from the American Association of Anatomists. He is AV® rated by Martindale-Hubbell.*

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Experience

We manage the global IP portfolio for Novelis Inc., an $11.1 billion dollar company and the world's largest rolled aluminum producer in terms of volume shipped. Novelis' patent portfolio consists of more than 200 patent families. We coordinated the company's global patent strategy, identified new foreign patent counsel, accelerated prosecution of applications throughout the world, and assisted in European patent oppositions. In addition to managing the company's global IP portfolio, we are also working with Novelis on corporate matters, licensing, trade secrets, and federal grants.

Assisted lead counsel for the plaintiff, Porex Corporation, a leader in the development and manufacturing of porous plastic and porous fiber products, in patent infringement litigation. Soon after filing the suit, we filed a motion for preliminary injunction, engaged in expedited discovery and had a hearing date for an evidentiary hearing on the motion. At the same time the case was proceeding, our client was engaged in confidential negotiations for an asset sale transaction that included the operating business and the patent involved in the litigation that made the resolution of the case an important consideration in closing that transaction. Against that backdrop, we were able to negotiate a settlement of the lawsuit with the defendant on terms that pleased not only our client but the third party with which our client was negotiating and enabled our client to close its significant asset sale transaction.

Advises Porex Corporation in developing and coordinating global patent strategy, preparing and prosecuting patent applications in the areas of medical devices, polymer chemistry and inorganic chemistry for medical implants, filters, nibs, detection devices and wicks, assisting in due diligence for intellectual property matters, and managing its trademark portfolio.

Assisted lead counsel in representing Biotest AG (Biotest), a German publicly traded biotechnology company, in signing a global License, Development and Commercialization Agreement with Abbott Laboratories for the further development and commercialization of Biotest's BT-061, a novel anti-CD4 antibody for the treatment of Rheumatoid Arthritis (RA) and psoriasis. In connection with the deal, Biotest will receive an upfront payment of $85 million, and upon completion of certain milestones, additional payments totaling $395 million, plus royalties.

Represents Prometic Life Sciences Inc., on intellectual property issues including design and implementation of global patent strategy, preparing and prosecuting patent applications involving bacterial ribonucleic acid cell wall compositions and their uses and assisting in IP due diligence.

Represents HDL Therapeutics Inc., on intellectual property issues including design and implementation of global patent strategy, preparing and prosecuting patent applications involving HDL particle derivatives with reduced lipid content and assisting in IP due diligence.

Education

Georgia State University, College of Law J.D. (1994)

University of Rochester Ph.D. (1980)

University of Rochester M.S. (1979)

Colgate University B.A. (1974) *magna cum laude, Phi Beta Kappa*

Admissions

Georgia (1994)

Court Admissions

U.S. Patent and Trademark Office (1998)

Professional & Community Activities

Center for Behavioral Neuroscience, National Science Foundation Interinstitutional Grant administered through Georgia State University, Former Member External Advisory Board and Former ProBono Counsel

The Endocrine Society, Emeritus Member

Georgia State University School of Law, Intellectual Property Society, Founder

State Bar of Georgia, Intellectual Property Section, Member

Insights

News Releases

Kilpatrick Townsend Achieves Recognition for 2019 Georgia Super Lawyers

February 28, 2019

News

Record-Breaking Recognition for Kilpatrick Townsend in The Best Lawyers in America® 2019

August 20, 2018

News Releases

Kilpatrick Townsend Once Again Achieves Recognition for 2018 Georgia Super Lawyers

February 28, 2018

News Releases

Record-Breaking Recognition for Kilpatrick Townsend in The Best Lawyers in America® 2018

August 15, 2017

Publication

Unitary Patent Protection in Europe on its way and then … Brexit

September 10, 2016