



# John Prince, Ph.D.

Registered Patent Attorney, Boston, MA

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## PRACTICE AREAS

[Intellectual Property](#)  
[Patent Services](#)  
[Trademark & Copyright Services](#)  
[Intellectual Property Transactional Services](#)

## EDUCATION

California Western School of Law, J.D.  
Massachusetts Institute of Technology, Ph.D.  
Boston College, B.S.

## ADMISSIONS

California  
Massachusetts  
U.S. Patent & Trademark Office  
U.S. District Court,

## OVERVIEW

Dr. Prince has over 20 years of legal practice with international pharmaceutical companies and with law firms, primarily in the life science industry. He is a biologist turned life sciences attorney with years of experience in life science intellectual property patent protection and freedom-to-operate. He is passionate about helping life science organizations reach their objectives using the best ethical practices.

While working at multinational pharmaceutical companies and law firms, Dr. Prince has advised scientists, management, and technology transfer specialists globally to formulate legal strategies to assess business risk and secure freedom-to-operate and exclusivity for planned medicines and business activities.

## Key Competencies

- Global patent prosecution and risk mitigation
- Biologics-based technology transfer transactions
- Collaborative research and asset purchase agreements
- University intellectual property administration and management
- Disease area expertise includes antibodies, oncology, rare diseases, gene therapy, stem cells, cardiovascular, ophthalmology, and biomarkers.

## REPRESENTATIVE MATTERS

- Providing legal guidance to scientists and management to proactively mitigate business risks. Providing current communication to inventors and project teams about new developments in substantive patent law, practice and policy, and about the effects of these patent law developments on the business environment.

Southern District of  
California

- Drafting, filing and prosecuting patents globally, over a broad range of biological disciplines, as well as for chemical, organic chemical and mechanical device inventions. Critically reviewing patent applications and office actions for effective alignment with scientific, business, and intellectual property strategies.
- Managing intellectual property support for transactions, including biotechnology-related asset purchase agreements, procurement agreements, patent and technology licenses, collaborative research agreements, materials transfer agreements and confidential disclosure agreements.
- Participating in international, inter-institutional collaboration agreements, including working with general attorneys, intellectual property attorneys and technology transfer professionals.
- Providing intellectual property due diligence, negotiation and contract drafting support to technology transfer specialists.
- Leading project teams to design and implement efficient policies and procedures.
- Communicating freedom-of-use, non-infringement, invalidity and inventorship analyses and opinions.
- Performed trademark prosecution, trademark protection, and use planning.
- Providing legal counsel for intellectual property litigation.
- Performing work related to export controls.

#### PROFESSIONAL AFFILIATIONS

- Member, Boston Patent Law Association
- Member, California Lawyer Association, Intellectual Property Law Section
- Member, Surfrider Foundation