



John Prince, Ph.D.

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PRACTICE AREAS

[Intellectual Property](#)

[Patent Services](#)

[Life Sciences](#)

[Trademark & Copyright Services](#)

EDUCATION

California Western
School of Law, J.D.

Massachusetts Institute
of Biology, Ph.D. in
Biology

Boston College, B.S. in
Biology

ADMISSIONS

California

Massachusetts

U.S. Patent & Trademark
Office

OVERVIEW

Dr. Prince is a biologist turned life sciences attorney with years of experience in life science [intellectual property patent protection](#) and freedom-to-operate. He has 25 years of legal practice experience with international pharmaceutical companies, biotechnology companies and with law firms, primarily in the life science industry. He is passionate about helping life science organizations reach their objectives using the best ethical practices.

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. He has provided intellectual property support to many universities and non-profit research organizations

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 developments in substantive patent law, practice, and policy, and about the effects of these patent law developments on the business environment.
- 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.
- 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 legal counsel related to export controls.

SEMINARS / PUBLICATIONS

Legal Publications:

- Morency M., Prince J.T., and Kathardekar V., (2021). *“Driving Revenue and Deal Flow Through an Intelligent IP Strategy: Strategies for Smaller and Early-Stage Life Science Companies.”* The Licensing Journal, 41(1): 1-9. [Click here to read full article.](#)
- Robert A. Bohrer & John T. Prince (1999) A Tale of Two Proteins: The FDA’s Uncertain Interpretation of the Orphan Drug Act. Harvard Journal of Law & Technology, 12(2), 365.

Scientific Publications:

- Prince, J.T., McGrath, K.P., DiGirolamo, C.M., and Kaplan, D.L. (1995) Construction, cloning, and expression of synthetic genes encoding spider dragline silk. Biochemistry, 34(34), 10879-85.
- Prince, J.T., McGrath, K.P., DiGirolamo, C.M., and Kaplan, D.L. (1995) Construction, cloning, and expression of synthetic spider silk genes. ACS Abstracts, 272, 80.
- Mello, C.M., Arcidiacono, S., Beckwitt, R., Prince, J., Senecal, K. and Kaplan, D.L. (1994) Nephila clavipes dragline silk: Approaches to a recombinantly produced silk protein. Proc. Mat. Res. Soc., 330, 37-42.
- Mello, C.M., et al. (1994) Biosynthesis and processing of silk proteins for advanced materials. 1994 Army Science Conference.

- Mello, C.M., Arcidiacono, S., Beckwitt, R., Prince, J., Senecal, K. and Kaplan, D.L. (1993) Characterization of Nephila clavipes dragline silk proteins. Materials Research Society 1993 Fall Meeting. S2.4.
- Möller, J.R., Durr, P.G., Quarles, R.H., Trapp, B.D., Power, C. and Prince, J.T. (1992) Analysis of myelin proteins in post mortem AIDS brain and spinal Soc. Neurosci. Abstr., 18, 667.9
- Prince, J.T., Healy, P.A., Beasley, L., Nishiyama, A., and Stallcup, W.B. (1992) The expression of the F84.1 glycoprotein in the developing rat nervous Dev. Brain Res., 68, 193-201. PMID: 1394967.
- Harper, J.R., Prince, J.T., Healy, P.A., Stuart, J.K., Nauman, S.J. and Stallcup, W.B. (1991) Isolation and sequence of partial cDNA clones of human L1: Homology of human and rodent L1 in the cytoplasmic region. J. , 56, 797-804. PMID: 1993895.
- Nishiyama, A., Dahlin, K.J., Prince, J.T., Johnstone, S.J. and Stallcup, W.B. (1991) The primary structure of NG2, a novel membrane-spanning J. Cell Biol., 114, 359-371. PMID: 1906475.
- Prince, T., Alberti, L., Healy, P.A., Nauman, S. and Stallcup, W.B. (1991) Molecular cloning of NILE glycoprotein and evidence for its continued expression in mature rat CNS. J. Neurosci. Res., 30, 567-581. doi:10.1002/jnr.490300315.
- Prince, J.T. and Stallcup, W.B. (1991) Induction of NILE glycoprotein during neuronal differentiation of the embryonal carcinoma cell line EC1003. Differentiation, 46, 187-198. PMID: 1717331.
- Prince, J.T., Healy, P.A. and Stallcup, W.B. (1990) The monoclonal antibody F84: Immunohistochemical studies. 21st Annual Meeting of the American Society for Neurochemistry,
- Prince, J.T. and Stallcup, W.B. (1990) The embryonal carcinoma cell line EC1003 – a model for neuronal differentiation. in Advances in Neural Regeneration Research, Neurology and Neurobiology, Volume 60, J. Sell, ed., Wiley-Liss, New York.
- Prince, J.T., Milona, N. and Stallcup, W.B. (1989) Characterization of a partial cDNA clone for the NILE glycoprotein and identification of the encoded polypeptide J. Neurosci., 9(5), 1825-34. PMID: 2723751.
- Prince, J.T., Milona, N. and Stallcup, W.B. (1989) Characterization of a partial cDNA clone for the NILE glycoprotein and identification of the encoded polypeptide J. Neurosci., 9(3), 876-883. PMID: 2466966.
- Prince, T. (1986) The Biosynthesis of Riboflavin in Escherichia coli. Ph.D. Thesis, Massachusetts Institute of Technology, Cambridge, MA.
- Sturgeon, M.F., Prince, J.T. and Theobald, R.A. (1979) An affinity chromatography scheme for purification of intrinsic factor. Clin. Chem. 25,1123.
- Theobald, R.A., Prince, J.T. and Sturgeon, M.F. (1979) Evaluation of three different B-12 binding agents used in the radioassay of vitamin B-12. Clin. Chem., 25, 1136.

News Articles:

- Prince, J. and Toffenetti, J. (2003) Transgenic Mice with Alzheimer’s Disease: New or Patently Inherent? Mass High Tech.
- Prince, J. (2003) Patent Found to Hog Method Swine Disease Vaccine. 6(3) McDermott, Will & Emery Intellectual Property Update 3 (March 2003)
- Prince, J. (2003) Berlex’ Patent Claims Do Not Cover Biogen’s Drug for MS. McDermott, Will & Emery Intellectual Property Update, 6(2), 3.
- Prince, J. (2002) Claimed Method for Selecting Sprouts Having Anti-Carcinogenic Characteristics Found to Be Anticipated – Ask Your Mother. McDermott, Will & Emery Intellectual Property Update, 5(8), 5.
- Prince, J. (2002) FDA Has No Duty to Ensure The Correctness of Patent Listings in the Orange Book. McDermott, Will & Emery Intellectual Property Update, 5(8), 5.
- Prince, J. (2002) Hatch-Waxman Certification; Sufficiency of Notice for Paragraph IV Certification Still in Limbo. McDermott, Will & Emery Intellectual Property Update, 5(5), 8.
- Prince, J. (2001) Patent Squeeze, The Deal.com, Deal Commentary.
- Prince, J. (2001) A Biotechnology Patent Is Festo-ed. 4(6) McDermott, Will & Emery Intellectual Property Update 1 (June 2001)
- Prince, J. (1997) The Intellectual Property Problems of Genomics Companies. TeleCommunications Newsletter, 11, 1.
- Prince, J. (1996) A Gene for Human Temperament and Its Possible Importance in Law. Commentary XXIV(14), 13.
- Prince, J. (1996) Did Rachael Kincaid Have a “Thrifty Genotype”? Recent Advances in Obesity Research, Commentary, XIV(15), 5.
- Prince, J. (1996) Superviolent Mice and the Importance of NO. Commentary, XXIV(16), 7.
- Prince, J. (1996) The New Fight Over “Genetic Discrimination”. Commentary, XXIV(17), 5.

PROFESSIONAL AFFILIATIONS

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