

John K. McDonald Ph.D.

Retired

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Services

Intellectual Property
Patents
Market Protection - Opinions &
Dispute Avoidance
Asset Creation - Prosecution &
Counseling
Licensing, Transactions &
Monetization

Industries

Food, Restaurant & Beverage
Medical & Surgical Devices
Health & Life Sciences
Retail & Consumer Goods
Chemicals

Dr. 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.

Dr. McDonald 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. Dr. McDonald 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.

Dr. McDonald 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*[®]. Dr. McDonald 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. Dr. McDonald 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.*

*CV, BV, and AV are registered certification marks of Reed Elsevier Properties, Inc., used in accordance with the Martindale-Hubbell certification procedure's standards and policies.

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

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

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

University of Rochester M.S. (1979)

University of Rochester Ph.D. (1980)

Admissions

Georgia (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

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Kilpatrick Townsend Achieves Recognition for 2019 Georgia Super Lawyers
February 28, 2019

[In The News](#)

Record-Breaking Recognition for Kilpatrick Townsend in The Best Lawyers in America® 2019
August 20, 2018

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Kilpatrick Townsend Once Again Achieves Recognition for 2018 Georgia Super Lawyers
February 28, 2018

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Record-Breaking Recognition for Kilpatrick Townsend in The Best Lawyers in America® 2018
August 15, 2017

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Kilpatrick Townsend Once Again Achieves Recognition for 2017 Georgia Super Lawyers
February 28, 2017

[Publications](#)

Unitary Patent Protection in Europe on its way and then ... Brexit
September 10, 2016

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Kilpatrick Townsend Earns Record-Breaking Recognition in Annual Best Lawyers in America 2017
August 16, 2016

[News Releases](#)

Kilpatrick Townsend Earns Record-Breaking Recognition in Annual Best Lawyers in America 2016
August 19, 2015

[Publications](#)

Kilpatrick Townsend & Stockton LLP Intellectual Property Desk Reference-7th Edition
May 1, 2015



[Publications](#)

Global Strategy to Fast-Track Your Patent Portfolio

May 1, 2015

[News Releases](#)

Kilpatrick Townsend Once Again Achieves Recognition for 2015 Georgia Super Lawyers

February 26, 2015