

John P. Rearick, PhD

Partner

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Dr. John Rearick has experience in a range of pharmaceutical and chemical technologies at various stages of development, enabling him to craft strategic IP protection that helps position clients' technology in a way that best suits their current and future business goals. He also advises clients on contentious patent matters before the Patent Trial and Appeal Board (PTAB), as well as post-grant challenges involving product-critical patents in foreign countries.

With more than a decade of practice, John has prosecuted more than 200 granted U.S. patents. He has extensive experience working with clients to obtain worldwide patent coverage for novel small molecule therapeutics, particularly in the therapeutic areas of oncology, infectious disease, and neurodegenerative disease. His work with pharmaceutical clients includes counseling on strategies for extending exclusivity in drug product portfolios. His practice also includes due diligence evaluations on behalf of acquiring companies and investors.

John was the recipient of a Howard Hughes Medical Institute Predoctoral Fellowship in Biological Sciences and a Certificate of Distinction in Teaching from Harvard College.

John's clients include Takeda, Progenics Pharmaceuticals, Bristol Myers Squibb, Forma Therapeutics, Valo Health, Memorial Sloan Kettering Cancer Center, and Saudi Arabian Oil Company

PRACTICE AREAS

Intellectual Property Protection

Complex Intellectual Property Disputes

Life Sciences

RECOGNITION

- *Massachusetts Super Lawyers* Rising Star

REPRESENTATIVE ENGAGEMENTS

Patent Prosecution and Counseling

- Prepared and prosecuted a global portfolio covering covalent small molecule inhibitors in a crowded patent landscape, including obtaining claims to protein-inhibitor conjugates agnostic to inhibitor structure.
- Executed strategic series of patents filings, including dosing and impurity profiles, to extend exclusivity period for phase II drug candidate.
- Drafted and counseled small pharma company on patent filing strategy for small molecule series showing activity against multiple targets of clinical interest.

EDUCATION

Boston University School of Law JD, 2013

Harvard University
PhD, 2007, *Chemistry*

Harvard University
AM, 2004, *Chemistry*

Purdue University
BS, 2001, *Biology & Chemistry*, with distinction

ADMISSIONS

Massachusetts

U.S. Patent & Trademark
Office

- Advised clients in European oppositions involving defending client patents and challenging third party patents.
- Counseled large chemical company in patent invalidation trial and appeal in Korea.
- Conducted extensive pre-ANDA litigation analysis of newly approved drug for large pharmaceutical company.
- Performed IP due diligence analyses and opinions in context of initial public offerings, on behalf of underwriters, and private companies.
- Represented Forma Therapeutics as IP counsel in \$278M initial public offering.

Patent Trial and Appeal Board

- ***Advanced Accelerator Applications USA, Inc. v. Molecular Insight Pharmaceuticals, Inc., PGR2021-00048***: Counsel for Patent Owner Molecular Insight Pharmaceuticals in defense of its patent directed to methods for treating prostate cancer using compounds that bind prostate-specific membrane antigen.
- ***Valo Early Discovery, Inc. v. Hybrigenics SA., Fed. Circ.***: Counsel for Valo Early Discovery, Inc. (f/k/a Integral Early Discovery, Inc.) in an appeal of a PTAB post-grant review decision involving a patent protecting novel inhibitors of ubiquitin-specific protease 7 (USP7).
- ***Progenics Pharmaceuticals, Inc. v. Max-Planck-Gesellschaft zur Förderung der Wissenschaften e. V., PTAB***: Counsel for Progenics Pharmaceuticals, Inc. in a PGR proceeding challenging a patent directed to compounds for preparing ¹⁸F-radiolabeled Prostate-Specific Membrane Antigen (PSMA)-targeting conjugates.
- ***Hybrigenics SA v. FORMA Therapeutics, Inc., PTAB***: Counsel for FORMA Therapeutics, Inc. in a PGR proceeding defending a patent protecting novel inhibitors of ubiquitin-specific protease 7 (USP7).
- ***Saudi Arabian Oil Co. v. SK Innovation Co. Ltd., PTAB***: Counsel for Saudi Arabian Oil Co. in an IPR proceeding challenging a patent directed to polycarbonates.

PUBLICATIONS AND PRESENTATIONS

- “Fully Exploiting Your Innovations: Best Practice in Innovation Harvesting,” *panelist*, Life Sciences Patent Network North America, May 2022.
- “Patent Strategies in Light of Clinical Trial Disclosures,” *moderator*, Life Sciences Patent Network Live, October 2021.
- “1L Boot Camp: OCI Interviewing,” *panelist*, Boston College, Newton Centre, April 2019.
- “Patents 101,” *presenter*, Harvard University, Cambridge, December 2018.
- “Translational Research in Biomaterials Seminar Series,” *presenter*, Boston University.
- “The Legal Profession: Explore Careers,” *panelist*, Harvard University.

- “Synthesis of Skeletally Diverse Small Molecules with Non-Natural Motifs: A Boronic Ester Annulation Strategy,” *poster presentation*, Broad Institute of Harvard and MIT Annual Meeting.
- “Synthesis of Skeletally Diverse Small Molecules with Non-Natural Motifs: A Boronic Ester Annulation Strategy,” *speaker*, HHMI Meeting of Predoctoral Fellows, Chevy Chase, MD.
- “Design and Synthesis of a Novel Series of 1,2-Disubstituted Cyclopentanes as Small, Potent Potentiators of 2-Amino-3-(3-hydrox-5-methyl-isoxazol-4-yl)propanoic Acid (AMPA) Receptors,” *co-author*, *Journal of Medicinal Chemistry*.
- “Asymmetric Synthesis of Umuravumbolide,” *co-author*, *Organic Letters*.

PROFESSIONAL AND COMMUNITY INVOLVEMENT

- Member of the PTAB Bar Association Diversity Committee
- Member of the Boston Patent Law Association
- Member of the Massachusetts LGBTQ Bar Association
- Executive Leadership Committee for Lawyers Have Heart annual road race benefiting the American Heart Association