



## Oona M. Johnstone PhD

### Shareholder

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### Education

McGill University, BS,  
Biology, *with distinction*

McGill University, PhD,  
Biology, *Dean's Honor  
List*

Suffolk University Law  
School, JD, *magna cum  
laude*

### Practice Groups

#### Biotechnology

Licensing & Transactions

Post-Grant Proceedings

Oona Johnstone focuses her practice on US and foreign patent prosecution, IP due diligence, client counseling, and post-grant proceedings, including inter partes review (IPR), in the areas of biotechnology, pharmaceuticals and cleantech. Her knowledge spans a wide range of technologies including RNA-based therapeutics, transgenics, antibodies, immune-modulating agents, metabolic engineering, systems and synthetic biology, and drug delivery.

Oona has experience advising clients on maximizing patent term through patent term adjustment (PTA), patent term extension (PTE), and Supplementary Protection Certificates (SPCs).

Oona additionally has experience in advising clients on biosimilar/biobetter issues.

Prior to joining the firm, Oona was a postdoctoral researcher in the Department of Systems Biology at Harvard Medical School. Her research, focusing on posttranscriptional gene regulation, was part of a large-scale initiative to use genome-wide technologies to characterize networks of RNA-protein interactions in the developing mammalian brain.

Oona's doctoral research on RNA helicases helped to elucidate cell biological questions related to RNA localization and translational regulation, while placing these mechanistic insights within the context of the developing embryo.

Oona has authored and co-authored publications in journals including *Molecular Cell*, *Development*, *Developmental Biology*, *International Review of Cytology*, and *Annual Review of Genetics*.

## Experience

- Prepared and prosecuted patent portfolios for corporate, academic, and non-profit institutions
- Worked closely with early-stage biotech company to evaluate competitor activity, provide freedom-to-operate and non-infringement analysis, and develop strategy for achieving worldwide patent protection
- Provided IP due diligence and regulatory analysis for multiple biotech/pharma transactions
- Conducted patent landscape studies and counseled pharmaceutical company on strategy for biosimilar product development
- Advised clients on inter partes review (IPR) strategy, including drafting IPR Petitions and Patent Owner Preliminary Responses
- Represented Patent Owner BTG International Inc. in an IPR proceeding. Obtained denial of institution.
- Successfully represented Patent Owner in achieving denial of institution of four IPR proceedings in RNA interference technology
- Conducted pre-suit investigation involving analysis of competitor's product to demonstrate infringement of client's claims
- Successfully appealed written description rejection of antibody claims to the Patent Trial and Appeal Board (PTAB) of the US Patent and Trademark Office

## Activities

- Boston Patent Law Association
- Women Entrepreneurs in Science and Technology
- Women in Bio

## Recognition

Oona has been repeatedly named one of Massachusetts Super

Lawyers' "Rising Stars" in the field of intellectual property law.

Oona was awarded a Doctoral Studentship and a Postdoctoral Fellowship from the Canadian Institutes of Health Research. For her PhD thesis, she was awarded the Thomas Haliburton Henry Award for the most outstanding graduate of McGill University. In law school, she received Best Oral Advocate and Distinguished Legal Brief awards in her Legal Practice Skills class. She also participated in the Walter H. McLaughlin Appellate Advocacy Competition.