



## Pamela L. Cox

Partner and Chair, IP Transactions

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Pamela L. Cox is talented at unraveling complex deal structures and devising creative agreement solutions. Formerly in-house, Ms. Cox now focuses her practice on intellectual property transactions, protection, and dispute resolution for clients ranging from multinational corporations to non-profit institutions. Ms. Cox is a patent attorney who understands her clients' intellectual property and agreement needs, and remains passionately engaged until their strategic objectives are achieved. Clients consider her an invaluable member of their team:

"Pamela Cox is one of the country's leading licensing authorities. Nobody works harder than [this] thoroughly commercial lawyer who can quickly get her head around even the most labyrinthine deals. She quickly comes to your rescue with practical guidance in very tight timeframes and is an indispensable ongoing resource who can navigate worldwide negotiations with ease. She is [also] a pre-eminent authority on university technology transfer and licensing acting for commercial and non-profit clients. Her ability to forcefully protect your rights while quickly and nimbly resolving the most complex issues in negotiations is remarkable." – *IAM Patent 1000*

"Pam has an exceptional legal mind. She is able to grasp and parse complex legal issues independently, yet with great sensitivity about keeping the client informed. She's an outstanding negotiator and is able to take a strong position without being disagreeable. She plans ahead for expected compromises downstream, and finds creative solutions to apparent impasses." – Client Quote (*LMG Life Sciences*)

Ms. Cox's clients are not alone in recognizing her skills:

- "Highly recommended" for licensing, and honored as one of "The World's Leading IP Patent and Technology Licensing Lawyers" by *Intellectual Asset Management*
- Licensing Executives Society International (LESI) President's Award for Individual Service, recognizing her outstanding years of leadership and service as Chair of the LESI Life Sciences Committee
- "Patent Strategy & Management Attorney of the Year – Midwest" and "Life Sciences Star" by *LMG Life Sciences* and a Woman Worth Watching in *Profiles in Diversity Journal*
- *Managing IP's* IP Stars list of the Top 250 Women in IP

- “IP Star” in the *IP Stars Survey* (fka the *World IP Handbook and Survey*)
- Rainmaker by the Minority Corporate Counsel Association (MCCA)
- “Leading Lawyer” by Leading Lawyers, a division of *Law Bulletin Publishing Company*
- *The Best Lawyers in America*® in the practice area of Biotechnology and Life Sciences
- *Illinois Super Lawyers*® list in which only 5% of the lawyers in the state are recognized annually



## Practices

- IP Transactions
- Patent Prosecution
- Trade Secrets

## Industries

- Biotechnology & Life Sciences
- Chemical Sciences
- Medical Devices
- Nanotechnology
- Non-Profit Technology Transfer
- Pharmaceutical

## Representative Experience

- Leading successful negotiations with sensitivity to relationship dynamics and the internal/external politics of the parties.
- Conducting IP dispute resolution balancing competing interests.
- Drafting agreements to create and exploit intellectual property whether through multi-party collaboration and alliance agreements or more traditional two-party agreements like licenses.
- Creating template agreements, from master collaboration contracts to inter-institutional agreements intended to maximize clients' goals, whether a return on investment or diligence through development of the technology.
- Performing thorough due diligence of intellectual property assets in connection with licensing, assignment or the sale or merger of a business.

- Counseling on intellectual property policies, related revenue-sharing agreements, consulting agreements, invention disclosure forms and compliance with non-profit grant funding.
- Identifying potential licensees, managing out-licensing portfolios, and conducting intellectual property and agreement audits.
- Translating business goals into executable and enforceable agreements.

### Case Studies and Client Successes

- Ms. Cox was co-counsel in representing a multinational health care company in its acquisition of a private U.S. biopharmaceutical company. The acquisition marked the first time a company has acquired a drug candidate developed with resources from NIH's National Center for Advancing Translational Sciences (NCATS) Therapeutics for Rare and Neglected Diseases (TRND) programs. Marshall, Gerstein & Borun LLP was an advisor particularly for issues of intellectual property under federal acquisition and Bayh-Dole regulations and in conducting due diligence, this unique transaction required the deal team to negotiate and optimize across a broad range of issues including government contracting, licensing, and patenting.
- Ms. Cox structures collaboration agreements that produce significant scientific advances. For example, she represents Orion Genomics and its affiliates in their intellectual property transactions, including a suite of agreements for collaboration on the oil palm genome between Orion and the Malaysian Palm Oil Board (MPOB), a body corporate established under the Malaysian Palm Oil Board Act 1998. The collaboration resulted in the identification of the gene responsible for the production of oil palm, and palm oil is 45% of the world's edible oil.
- Diagnovus, LLC, since acquired by Aegis Sciences Corporation, launched ENGAUGE™-cancer—DLBCL assay, the first of a comprehensive line of molecular diagnostic tests for less frequent diseases. The assay, invented at Stanford University School of Medicine by Dr. Ron Levy, is based on more than 10 years of research, exceeds the standard clinical characteristics that clinicians have used for prognosis for the last three decades, and can now be routinely performed in a reproducible and accurate manner. Ms. Cox negotiated the license from Stanford on behalf of Diagnovus, and other related agreements supportive of this product line.
- For more than a decade, Marshall Gerstein has represented MonoSol, LLC in all its intellectual property litigation, prosecution and transactional matters, including in its acquisition by Kuraray Holdings U.S.A., Inc. Ms. Cox is the primary portfolio manager and advises on day-to-day IP operations.
- Ms. Cox manages the Firm's IP services for Northwestern University, including Professor Chad Mirkin's laboratory, the most-cited chemist and nanomedicine researcher in the world, and the out-licensing of the estate.

- Ms. Cox structured and negotiated a highly unusual multi-year relationship between a private hospital and research institute and a state university medical system so a world-renowned expert in gene therapy, tissue engineering, and regenerative medicine could serve as a full-time tenured professor at the university and chief scientific officer of the private research institute. Many agreements, policies, and procedures had to be created to implement the vision of one lab in two locations that capitalizes on the university's infrastructure for basic research and the private hospital and the research institute's clinical research environment.
- Ms. Cox was part of the Marshall Gerstein team that successfully represented Loyola University of Chicago against MediGene AG's challenge of the university ownership of patent rights. Ms. Cox also negotiated Loyola's out-license with GlaxoSmithKline which now manufactures and sells Cervarix® (Human papillomavirus bivalent vaccine, recombinant), protection against Type 16 and Type 18 of the HPV virus that causes 70% of cervical cancers.
- Partnering first with ICOS Corporation, now CMC ICOS, Ms. Cox continues to advise on intellectual and tangible property in Chinese hamster EF-1 alpha regulatory DNA (CHEF1); providing guidance in connection with evolving business models over the life-cycle of the dozens of issued patents prosecuted by Marshall Gerstein's biotech group.

## Background and Credentials

Ms. Cox is a Certified Licensing Professional (CLP), a credential that recognizes her as a licensing professional who is committed to professional development and the attainment of the skills and knowledge necessary to perform at the highest level of quality.\*

Before joining Marshall Gerstein, Ms. Cox was a client of the Firm as the associate director of technology transfer for Indiana University's Advanced Research and Technology Institute. There, she was responsible for managing and licensing the eight-campus patent portfolio. Ms. Cox was also in-house in regulatory and clinical affairs at DePuy Inc., a Johnson & Johnson Company.

\*The Supreme Court of Illinois does not recognize certifications of specialties in the practice of law and the CLP™ certification is not a requirement to practice law in Illinois.

## Education

- University of Notre Dame Law School (J.D.)
- Indiana University, Bloomington (B.S.)
  - Biology

## Bar Admissions

- Illinois
- U.S. District Court, Northern District of Illinois
- U.S. Patent and Trademark Office

## Publications and Presentations

May 14, 2018

**Action Items: Implementing Bayh-Dole Act Updates**

*Marshall Gerstein Alert*

February 20, 2018

**"Front Row: IP Licensing Dispute Mock Mediation"**

*AUTM 2018 Annual Meeting*

January/February 2018

**"The Future of Technology Transfer"**

*Intellectual Asset Management*

October 22, 2017

**"Orientation and Speed Mentoring for New Members & First Time Attendees"**

*LES Annual Meeting*

July 10, 2017

**"Term Sheets – Deal Savers or Just Time Stealers"**

*AUTM Central Region Meeting*

June 6, 2017

**"Introduction to IIAs, MTAs, and CDAs from the University Perspective"**

*AUTM Online Professional Development Program Webinar*

April 26, 2017

**"Practical Implications of Socially-Responsible Licensing for Agreement Drafting"**

*Global Technology Impact Forum (GTIF)*

April 11, 2017

**"Licensing University Technology 101"**

*AUTM Online Professional Development Program Webinar*

March 14, 2017

**“Intellectual Property Dispute Settlement in Life Sciences”**

*AUTM Annual Meeting*

January 27, 2017

**“Sovereign Immunity Prevents AIA Trial Against University-Owned Patent”**

*Marshall Gerstein Alert*

September 2016

**“Mock Mediation of a Patent and Trade Secret License Dispute”**

*LES Scandinavia Annual Conference*

July 2016

**“Life Sciences Royalty Rate & Deal Survey Workshop”**

*LES University*

November 2015

**“IP Considerations for Applicants”**

*UC CAI Application Webinar Series*

October 2015

**“Challenges in Negotiating Global License Agreements: U.S. v. European Jurisdictions”**

*LES Annual Meeting*

October 2015

**“Where is My Crystal Ball When I Need It? Good Deals Gone Bad: A Case Study in Structuring License Agreements to Survive the Convulsions of Commerce”**

*MRUN CATTEC VIII: Midwest Startups – Evolution of Innovation*

April 2015

**“The Future of Licensing Deals or Are We All Doing Acquisitions Now? Review From a Commercial Perspective”**

*LESI Annual Conference*

April 2015

**“Legal Watch-Outs in Life Science Deals”**

*LESI Annual Conference*

April 2015

**“WIPO Mock Mediation”**

*LESI Annual Conference*

March 2015

**“IP Transaction Trends and Takeaways: What We Learned in 2014, and What to Expect Going Forward”**

*Intellectual Property Today*

January 2015

**“Good Deals Gone Bad: A Case Study in Structuring License Agreements to Survive the Convulsions of Commerce—Or, Where is My Crystal Ball When I Need It?”**

*AIPLA Mid-Winter Institute*

January 2015

**“Making Money through IP Deals, An Introduction to What is IP & How It Works for Business”**

*The Business Bridge Course, IP Business Basics 101, ACG Chicago and LES Chicago/Wisconsin Chapters*

November 2014

**“Building Relationships”**

*Intellectual Property Magazine*

November 2014

**“Agreements Used to Transfer IP for Medical Devices”**

*AUTM Business Development Course*

November 2014

**“University Jointly-Owned Rights and Inter-Institutional Agreements”**

*AUTM Webinar*

October 2014

**“IP Business Basics: The Business Bridge”**

*LES Annual Meeting*

June 2014

**“University Licensing from the Licensee's Perspective”**

*Innovation to Commercialization (I2C) Fellowship Program*

May 2014

**“Collaboration Agreements in Pharma and Biotechnology”**

*LESI Annual Meeting*

March/April 2014

**“A vision of the future for non-profit technology transfer”**

*Intellectual Asset Management*

March 2014

**“Time and Cost-Effective Approaches to Resolving Technology Transfer Disputes”**

*LES Mid-Year Meeting*

September 2013

**“Laws and Policies Affecting Global Collaboration and License Agreements”**

*The Licensing Journal*

September 2013

**“Negotiating with Style: Using Negotiation Styles and Other Communications Tools for Better Results”**

*Licensing Executives Society (LES) Webinar*

August 2013

**“Speaking of Codes—Copyright & Open Source Software”**

*CLE Presentation*

June 2013

**“Considerations for the Faculty Entrepreneur in Licensing Intellectual Property”**

*Chicago Innovation Mentors (CIM) Mentee CIMposium*

April 2013

**“Global Pharmaceutical Licensing”**

*LESI Annual Meeting*

February 2013

**“Mock Expedited Arbitration: Resolving Technology Disputes Outside the Courts”**

*AUTM Annual Meeting*

November 2012

**“Innovative Structures for Successful University/Industry Collaboration: What Works, What Doesn't & What Could?”**

*AUTM Leadership Forum*

June 2012

**“Reaching Across the Table”**

*Nature Biotechnology*

June 2012

**“Terms to Consider in Global Pharmaceutical Agreements from a Licensee's Perspective”**

*CLE Presentation*



May 2012

**“Drafting Agreements in the Biotechnology and Pharmaceutical Industries”**

*Oxford University Press*

March 2012

**“The Art and Science of Negotiation: Technology Transfer Negotiations”**

*AUTM Technology Transfer Practice Manual, Third Edition (pp. 12-23)*

March 2012

**“Mock Mediation: Time and Cost-effective Approaches to Resolving Technology Transfer Disputes”**

*AUTM Annual Meeting*

January 2012

**“Agreements Addressing the Coordination of Jointly Owned Intellectual Property Between Universities”**

*AUTM Webinar*

January 2012

**“Strategies for Collaboration Agreements Focusing on Innovation”**

*Journal of Commercial Biotechnology*

August 2011

**“Stanford v. Roche and the Practical Considerations Therefrom”**

*CLE Course*

August 2011

**“Negotiations of License Agreements”**

*AUTM Webinar*

July 2011

**“Do You Consider Yourself a Good Negotiator?”**

*AUTM Central Region Meeting*

June 2011

**“Innovative Collaborations: Successful Deal Structures for Non-Profit/For-Profit Collaborations”**

*BIO Annual Meeting*

March 2011

**“Drafting the License Agreement: No Decoder Ring Required”**

*AUTM Annual Meeting*

February 2011

**“Negotiating the License Agreement: What to Consider Before, During and After the Negotiation”**

*AUTM Annual Meeting*

October 2010

**“PDS 100: Commercializing Technology Through the Power of IP Licensing”**

*LES PDS series*

August 2010

**“Negotiating the License Agreement”**

*AUTM Webinar*

July 2010

**“Anatomy of a License Agreement”**

*AUTM Webinar*

June 2010

**“The Bayh-Dole Act—Principles and Practice”**

April 2010

**“Primer on Intellectual Property and Technology Transfer”**

*Intellectual Property/Entrepreneurship Symposium*

March 2010

**“Drafting Agreements in the Biotechnology and Pharmaceutical Industries”**

*Oxford University Press*

March 2010

**“Drafting the License Agreement—Let the Financial Terms be Your Guide”**

*AUTM Annual Meeting*

March 2010

**“The Use of Master Research Agreements in Non-Profit Technology Transfer”**

*Corporate Liaison Network*

February 2010

**“Game-Changing IP Strategy and Organizational Alignment That Lead to the Right Deal Pipeline”**

*LES IP 100 Executive Forum*

October 2009

**“Term Sheets: The Deal Begins”**

*LES PDS 300 CLE Series, LES USA & Canada Annual Meeting*

October 2009

**“Doing Well By Doing Right—The Ultimate Reason for Engaging in Ethically Motivated Deal-Making”**

*LES USA & Canada Annual Meeting*

February 2009

**“How Does Your Licence Agreement Address Timely Issues?”**

*Intellectual Asset Management*

February 2009

**“Analyze This Contract!”**

*AUTM Annual Meeting*

December 2008

**“Legal Issues Affecting IP Transactions in Life Sciences”**

*IP Litigator*

## **Community and Professional Involvement**

- Board Member of Governors of the Certified Licensing Professionals (CLP)
- Board Member of Licensing Executive Society International (LESI), Co-Chair of Women in Licensing Alliance, former Vice-Chair of External Relations Committee, Founder of LESI Life Science Advisory Board, Adviser to the Life Science Committee, former Chair of LESI Life Science Committee, International Delegate for LES USA-Canada and former Chair of the LES USA/Canada Chicago Chapter
- Founding Board Member of Global Healthcare Innovation Alliance Accelerator (GHIAA)
- Signatory of the World Intellectual Property Organization (WIPO) Mediation Pledge for IP and Technology Disputes
- Business Development Curriculum Committee discharging the Association of University Technology Managers (AUTM)'s grant from the Coulter Foundation, and served on the AUTM Nominations and Awards Committee
- Adjunct Professor of Law, Northwestern University Law School
- Chair of Firm's IP Transactions practice, Chair of the Firm's Strategic Planning Committee, former Chair and current member of the Firm's Marketing Committee and actively mentoring associates through the Firm's formal mentoring program
- Co-founder and former subcommittee chair of the licensing committee of the Intellectual Property Owners Association (IPO)

- Pro bono attorney for the Thisbe and Noah Scott Foundation and the Aparecio Foundation
- Former guardian ad litem for Chicago Volunteer Legal Services
- Judge, Northwestern University's Venture Challenge (NUVC)
- Member and Presenter at American Intellectual Property Law Association (AIPLA)
- Member of the Women In Bio (WIB)
- Life Fellow of the American Bar Foundation (ABF)
- Member of the Illinois State Bar Association (ISBA)
- Member of the American Bar Association (ABA)
- Board Member of the University Club of Chicago and member of the Chateau 76 Wine Society