



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, Pam now focuses her practice on intellectual property transactions, protection, and dispute resolution for clients ranging from multinational corporations to non-profit institutions. She 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*)

Pam's clients are not alone in recognizing her skills:

- "Highly recommended" for licensing, honored as one of "The World's Leading IP Patent and Technology Licensing Lawyers" and a Global Leader: USA – Illinois 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*

- Woman Worth Watching in *Profiles in Diversity Journal*
- *Managing Intellectual Property's* IP Stars list of the Top 250 Women in IP
- *Crain's Chicago Business* Notable Woman in Law
- "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

- Pam was sought to develop a platform gene therapy licensing strategy with the Salk Institute for Biological Studies and Juan Carlos Izpisúa Belmonte. Salk's technology platform has proved to treat models of diabetes, muscular dystrophy and acute kidney disease and could be applied to more cell types and organs to treat a wider range of human diseases and age-related conditions. She collaborated with Salk's in-house technology transfer team and their general counsel's office to construct the portfolio licensing strategy for developing all the platform's potential applications.
- Pam 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 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.
- For more than a decade, Marshall Gerstein has represented an international innovation leader in water soluble films and solutions, MonoSol, LLC, in all its intellectual property litigation, prosecution and transactional matters, including in its acquisition by Kuraray Holdings U.S.A., Inc. Pam is the primary portfolio manager serving as quasi in-house counsel to advise on day-to-day IP operations.
- Pam 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.

- Pam 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.
- Vanderbilt University, one of the top 10 most innovative universities in the world, developed compounds that represent a new approach to treating schizophrenia. Pam led the team at Marshall Gerstein to support Vanderbilt in its separate licensing and research collaboration agreements with Lundbeck, a global pharmaceutical company. The collaboration formed by the agreements will speed the development of a new class of potentially promising treatments for schizophrenia's cognitive deficits and negative symptoms which go largely unaddressed by existing medications. Vanderbilt receives upfront and success-based payments in addition to royalties on global sales of products developed under the collaboration.
- Pam is committed to the use of alternative dispute resolution (ADR), including under the World Intellectual Property Office (WIPO) rules for mediation and arbitration. She has served as a mediator in complex intellectual property contract disputes as well as representing clients in arbitration of such agreements, including licenses. She also teaches about ADR, including conducting mock mediations and arbitrations around the world on behalf of the Licensing Executives Society International.
- Pam manages the firm's wide breadth of IP services for Northwestern University from representation in litigation, arbitration, IP agreement and patent portfolio development, including for Professor Chad Mirkin, the most-cited chemist and nanomedicine researcher in the world, and the out-licensing of that IP estate.
- Pam was retained to restructure three development agreements spanning over more than a decade of innovation in medical device product development, and negotiate another agreement for an additional level of engagement between the parties where its client would receive tranches of equity in a publicly traded company.
- Pam 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. She 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.

- Representing one of the top 10 most innovative universities in the world, Pam led the team that served as deal counsel to structure and negotiate an intellectual property license and research alliance agreement allowing its client to expand its prior collaborations with Boehringer Ingelheim in the development of novel treatment approaches for cancer. Under the terms of the research alliance agreement, the research capabilities of the parties will be brought together in a multi-year research program focusing on the development of small molecule inhibitors.
- Partnering first with ICOS Corporation, then CMC ICOS, now AGC Biologics, Pam 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

Pam 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.*

Pam is a signatory of the World Intellectual Property Organization (WIPO) Mediation Pledge for IP and Technology Disputes, mediator and teaches on mediation practice around the world.

Before joining Marshall Gerstein, she 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. Pam 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 29, 2020

"Life Science Start-Up Board IP & Licensing Considerations"

Women In Bio

September 17, 2019

"Patenting Software & AI Inventions"

June 24, 2019

"Confidentiality and Discoverability"

May 28, 2019

"Mock Mediation of IP License Dispute"

LESI Annual Meeting – Yokohama, Japan

May 14, 2018

Action Items: Implementing Bayh-Dole Act Updates

Marshall Gerstein Alert

May 1, 2018

"The Current and Future State of Non-Profit Technology Transfer in the United States"

LESI Annual Meeting – San Diego, CA, USA

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

May 16, 2016

"Mock Mediation of a Patent License Dispute"

LESI 2016 Annual Meeting – Beijing, China

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 2015 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 Meeting – Brussels, Belgium

April 2015

“Legal Watch-Outs in Life Science Deals”

LESI Annual Meeting – Brussels, Belgium

April 2015

“WIPO Mock Mediation”

LESI Annual Meeting – Brussels, Belgium

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 – Moscow, Russia

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 – Rio de Janeiro, Brazil

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

- Corporate Secretary and Member of the Board of the Licensing Executive Society International (LESI), Co-Founder and Co-Chair of Women in Licensing Alliance (WILA), Founder of LESI Life Science Advisory Board, and former Vice-Chair of External Relations Committee, Chair of LESI Life Science Committee, International Delegate for LES USA-Canada and Chair of the LES USA/Canada Chicago Chapter
- Member of Executive Committee of the Board of Directors of the University Club of Chicago, member of the Chateau 76 Wine Society and former member of the Finance Committee
- Adjunct Professor of Law, Northwestern University Pritzker School of Law, IP Licensing
- Past President & Chair of the Board of Governors of the Certified Licensing Professionals (CLP)
- Founding Member of the the Board of Directors of Global Healthcare Innovation Alliance Accelerator (GHIAA)
- Chair of Marshall Gerstein's IP Transactions practice and Women's Committee, former Chair and current member of the firm's Strategic Planning Committee and Marketing & Business Development 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)