



## Julie M. Watson

Special Counsel

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Julie M. Watson concentrates her practice on counseling related to intellectual property transactions with a particular emphasis in technology startups and university technology transfer. A licensing professional with years of in-house transaction experience, Julie has a real-world appreciation of client needs and knows how to structure complex intellectual property transactions to deliver strategic solutions.

She has been recognized by *Intellectual Asset Management (IAM)* as one of the “World’s Leading Patent Practitioners” with deep knowledge of university licensing and tech transfer.



### Practices

- IP Transactions

### Industries

- Biotechnology & Life Sciences
- Entrepreneurship, Startups & Emerging Companies
- Non-Profit Technology Transfer

### Representative Experience

- Developing deal strategies and leading negotiations for both in-licensing and out-licensing transactions for biopharma and university clients.
- Managing high-profile university out-licensing portfolios, including invention evaluations and strategy development, identifying potential targets and negotiating intellectual property agreements.
- Advising, drafting IP agreements, and performing due diligence for corporate acquisitions based on technology assets developed under the National Institute of Health’s National Center for Advancing Translational Sciences through its Therapeutics for Rare and Neglected Diseases Program.

- Counseling on intellectual property policies, related revenue-sharing agreements, consulting agreements, invention disclosure forms and compliance with non-profit grant funding.
- Structuring and leading the transaction team for contracts and extensive portfolio of subcontracts under Department of Defense funded programs.
- Developing proforma confidentiality, material transfer and research agreements for university clients; developing a portfolio of service and IP contracts for clinical translation program.

## Background and Credentials

Prior to joining Marshall Gerstein as special counsel, Julie was Director of Intellectual Property and Legal Counsel at the Wake Forest Institute for Regenerative Medicine; the Director of Intellectual Property Services at the American Medical Association; and a client of Marshall Gerstein while Vice President of the Advanced Research & Technology Institute, the technology transfer arm of Indiana University.

Julie received her law degree from Wake Forest University Law School and holds a master's degree from Johns Hopkins University and is admitted to practice law in Illinois, North Carolina, and before the United States Patent and Trademark Office. She is a Certified Licensing Professional (CLP)\*, a credential that recognizes licensing professionals who are committed to professional development and the attainment of the skills and knowledge to perform at the highest level of quality, and currently chairs the CLP Board of Governors. Julie is a long time member of licensing professional associations LES and AUTM and frequent speaker at LES and AUTM meetings, as well as a lecturer for a number of academic programs including at Wake Forest University School of Medicine and Northwestern University Pritzker School of Law.

*\*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

- Wake Forest University School of Law (J.D., *cum laude*)
- Johns Hopkins University (M.A., *NIH Training Grant, Johns Hopkins Fellowship*)
  - Biopsychology
- Coe College (B.A., *magna cum laude*)
  - Psychology, Biology

## Bar Admissions

- Illinois
- North Carolina

## Publications and Presentations

Julie is an active participant in professional licensing organizations, including AUTM and the Licensing Executives Society (LES) and frequent author and presenter at national meetings on intellectual property transactions.

Recent examples include:

- "Current Trends in Intellectual Property and Patent Law," Association of Corporate Counsel, RTP Chapter, Research Triangle Park, NC, October 2, 2024.
- "Patent & Licensing Strategy," Research Triangle Area Chapter - Association of Corporate Counsel Lunch & Learn, Raleigh, NC, October 16, 2019.
- "Functional Framework of a License," AUTM 2019 Essentials Course, Oak Brook, IL, September 9, 2019.
- "[State University Patents Are Not Immune from Inter Partes Review](#)," *Marshall Gerstein Alert*, June 17, 2019.
- "Negotiation of IP Licenses," LES University North, Chicago, IL, September 24, 2018.

[Click here](#) to see additional Publications and Presentations.

## Insights

October 2, 2024

### **"Current Trends in Intellectual Property and Patent Law"**

Research Triangle Area Chapter – Association of Corporate Counsel CLE

April 19, 2023

### **"Current Trends in Intellectual Property and Patent Law"**

Association of Corporate Counsel, RTP Chapter

October 16, 2019

### **"Patent & Licensing Strategy"**

Association of Corporate Counsel, RTP Chapter

June 17, 2019

### **State University Patents Are Not Immune from Inter Partes Review**

Marshall Gerstein Alert

May 14, 2018

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

Marshall Gerstein Alert

November 13, 2017

### **"Contract Negotiation Strategies"**

University Industry Demonstration Partnership

August 16, 2017

### **"IP Update 2017"**

Association of Corporate Counsel, RTP Chapter, Research Triangle Park

August 15, 2017

### **"Post-Contract Monitoring"**

AUTM Online Professional Development Program Webinar

August 3, 2017

### **"Protecting and Licensing Mobile Applications"**

Code for the Mission Lunch-N-Learn Seminar

July 20, 2017

### **"Business Development in IP Licensing"**

LES University

May 16, 2017

**"University Industry Collaboration Agreements 101"**

AUTM Online Professional Development Program Webinar

April 4, 2017

**"Ownership of Data in a Global Licensing and Development Agreement"**

Global Health Drug Development Workshop

April 4, 2017

**"Global Health Licensing"**

Global Health Drug Development Workshop

March 15, 2017

**"Communication Skills for Licensing Professionals"**

AUTM Annual Meeting

March 13, 2017

**"Are You Wasting Too Much Time on Non-license Agreements?"**

AUTM Annual Meeting

April 1, 2016

**"Alliances and Incentives in the Era of Outbreaks"**

Global Healthcare Innovation Alliances Symposium

March 16, 2016

**"Licensing and University Partnerships"**

LES Emerging Enterprises Committee Webinar

November 17, 2015

**"Overview of Medical Device Market and Technology Transfer Experience"**

AUTM Business Development Course – Medical Devices

October 28, 2015

**"Developing a Uniform NDA for LES"**

LES Annual Meeting

October 2015

**"Researcher merry-go-round: Best practices for handling departing faculty" (featured quotes)**

Technology Transfer Tactics

September 1, 2015

**"Show me the money" (featured quotes)**

InsideCounsel

June 23, 2015

**"Supreme Court Decision Today: Post-Expiration Patent Royalties are Unenforceable"**

Marshall Gerstein Alert

March 2015

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

Intellectual Property Today

July 2014

**“What Do You Mean My Idea Did Not Make Millions and Change the World?: The Art of Saying No Well”**

AUTM Central Region Meeting

July 2014

**“Securing IP for Regenerative Medicine: IP 101”**

Regenerative Medicine Essentials Course, Wake Forest Institute for Regenerative Medicine

September 2013

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

LES Webinar

January 2013

**“Practical IP for Scientists”**

Wake Forest Institute for Regenerative Medicine

## **Client Successes**

### **Navigant Expands Capabilities with Acquisition**

When global professional services giant Navigant Consulting identified Atlanta-based RevenueMed as a strategic acquisition target, Navigant’s general counsel turned to Marshall, Gerstein & Borun LLP for guidance on all IP-related aspects of the transaction. RevenueMed, a provider of coding, revenue cycle management, and business process management services for the healthcare sector, represented an opportunity to further strengthen Navigant’s position as a leading provider of end-to-end revenue cycle business process management services and to expand the company’s platform to include global, offshore capabilities for its clients.

Marshall Gerstein’s IP Transactions team began the engagement with significant technology due diligence, followed by a multidisciplinary effort ranging from extensive agreement review (encompassing open source agreements, employment agreements and all other relevant contracts) through the transfer of RevenueMed’s IP portfolio to Navigant. As part of the transaction, Marshall Gerstein:

- Negotiated the IP-related provisions in the asset purchase agreement, as well as a master services agreement with a soon-to-be former affiliate of RevenueMed to develop software applications and other deliverables for Navigant following the acquisition.
- Drafted and negotiated a transition services agreement to effect the transition of operations of an affiliated entity not acquired by Navigant out of RevenueMed while ensuring that RevenueMed’s business would continue to run smoothly during its integration into Navigant.
- Addressed IP-related employment issues.

This significant acquisition, which closed in February 2015, augments Navigant’s business process management offerings and further positions this Marshall Gerstein client for long-term, sustainable growth.

### **Successful IP-Intensive Acquisition**

Monopar Therapeutics, a biopharmaceutical company focused on developing innovative drug combinations to improve clinical outcomes in cancer patients, turned to Marshall Gerstein to assist with the acquisition of GPX-150, a broad spectrum Phase II Cancer drug candidate from Gem Pharmaceuticals. Marshall Gerstein’s attorneys, who also serve as Monopar’s IP prosecution counsel, structured the intellectual property contribution and assignment components for the IP-intensive acquisition. Our attorneys’ experience in both biopharmaceutical transactions and this specific technology,

enabled us to efficiently and effectively identify and integrate key terms to address the full range of intellectual property critical to the deal, which ultimately led to a timely and successful acquisition.

### **Gene Therapy Requires Multifaceted Licensing Strategy**

Salk Institute for Biological Studies and [Juan Carlos Izpisúa Belmonte](#), one of TIME magazine's "50 Most Influential People in Health Care" sought the counsel of Marshall Gerstein on a licensing strategy for a technology platform for gene therapy. The technology platform allows for genes to activate without creating breaks in the genetic code that may result in unwanted mutations. 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. Marshall Gerstein executed a portfolio licensing strategy which offered the best way to ensure development of all the potential applications. Marshall Gerstein collaborated with Salk's in-house technology transfer team and their general counsel's office to construct the portfolio licensing strategy.

To learn more about Juan Carlos Izpisúa Belmonte, see [MIT Technology Review's article highlighting his work at Salk Institute for Biological Studies](#).