



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. Starting her career in-house, Pam 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*)

"The recipient of much praise, Cox is responsive, pragmatic and experienced. She really understands her clients and is phenomenally quick on the uptake, with an ability to spot issues that others do not. She is a delight to work with on cross-border pharmaceutical and biotechnology deals." - *IAM Patent 1000*

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 "The World's Leading IP Strategists", and a Global Leader: USA – Illinois by *Intellectual Asset Management*
- "Patent Strategy & Management Attorney of the Year – Midwest" and "Life Sciences Star" by *LMG Life Sciences*

- Licensing Executives Society International (LESI) President's Award for Individual Service 2023, honoring Pam for her 4 years of LESI Board service, including 2 years as Corporate Secretary, and 7 years as International Delegate
- 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
- 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
- Thomson Reuters Stand-out Lawyer
- 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

Active in leadership roles such as Secretary of the Board of the Licensing Executives Society International and Chair of the Women in Licensing Alliance, Pam contributes to the thought leadership of the profession. She is also an adjunct professor at Northwestern University Pritzker School of Law.



Practices

- IP Transactions
- Patent Prosecution
- Trade Secrets

Industries

- Biotechnology & Life Sciences
- Chemical Sciences
- Entrepreneurship, Startups & Emerging Companies
- Medical Devices
- Nanotechnology
- Non-Profit Technology Transfer
- Pharmaceuticals

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 provided representation to Volition Rx Limited in an exclusive global supply and licensing agreement with Heska Corporation to sell Volition's Nu.Q® Vet Cancer Test. The transaction clears the way for the first cancer screening available at clinics and other points of care. Volition continues to make significant progress in ongoing negotiations with the multi-national veterinary companies to provide global coverage for the Nu.Q® Test. Pam is also negotiating these strategic partnerships.
- Pam structured and negotiated a strategic collaboration and license between Evozyne LLC and Takeda Pharmaceutical Company under which Evozyne will use its protein design AI technology to identify next generation gene therapies for inborn errors of metabolism. Virtual

negotiations allowed the international group of stakeholders to agree on the terms of the agreement within an aggressive schedule. Marshall Gerstein's strategy and negotiation approach played an important role in bringing this deal to fruition. The firm is also prosecuting the patent portfolio protecting the AI tools used to generate the synthetic proteins.

- Pam was sought to develop a platform gene therapy licensing strategy with the Salk Institute for Biological Studies and Juan Carlos Izpisua 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 Organization (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

Pam is a frequent speaker and author on licensing and intellectual property matters. Recent examples include:

- "Women in Technology - Women in Licensing Alliance Entrepreneurial Panel & Networking Event," LESI Annual Meeting, April 30, 2024.
- "WIPO Mock Mediation - Settle Your IP Dispute Outside the Courts," LESI Annual Meeting, April 30, 2024.
- "Licensing for University Startups," Equalize, March 8, 2024.
- "Confident Communications & Skills for Connecting," WILA/LESI Speaker Series 2023-24, January 17, 2024.
- "Behavior Characteristics of Leaders," WILA/LESI Speaker Series 2023-24, November 14, 2023.

Access Pam's additional publications and presentations.

Community and Professional Involvement

- Co-Founder and Chair of Women in Licensing Alliance (WILA), Past Corporate Secretary and Member of the Board of the Licensing Executive Society International (LESI), 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 the Long Range Planning Committee and Chateau 76 Wine Society and former Secretary and member of the Board of Directors and the Finance Committee of the University of Chicago
- Board Member of HCS Family Services
- 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 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)