

Jacqueline M. Cohen



IP STRATEGIST DRIVING BUSINESS SUCCESS

CONTACTS

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SKILLS

PRIMARY

- Intellectual Property (IP) Strategy Development
- IP Legal Operations Management
- Patentability Assessment
- Validity Assessment
- Freedom to Operate Assessment
- Contract Negotiation
- IP Portfolio Management
- Team Leadership and Management
- Mergers and Acquisitions (M&A)
- In-house Legal Training
- IP Litigation Management
- Due Diligence Evaluation
- Collaborative Stakeholder

EDUCATION

- Juris Doctorate, Cum Laude
University of Illinois Chicago School of Law
- LLM Intellectual Property Law, Cum Laude
University of Illinois Chicago School of Law
- Bachelor of Science in Pharmacy
University of Cincinnati College of Pharmacy

EXECUTIVE SUMMARY

Highly collaborative legal executive with extensive experience managing people and projects and leveraging strategic thinking to support and drive business growth. Thrives in a cross-functional matrixed organization and at implementing legal strategies that align with business goals. Excels at building and cultivating collaborative, highly productive teams that successfully execute against the strategic goals and visions of the organization. Adept at managing external legal counsel to meet budget demands while providing winning solutions. Highly skilled at building and executing IP strategies, capitalizing on IP opportunities and managing IP litigation. Extensive experience clearly communicating legal strategies to, and securing alignment with, the C-suite.

WORK EXPERIENCE

DIRECTOR OF INTELLECTUAL PROPERTY FOR THE AMERICAS

Jan 2024 - Present | Karl Storz | Lewes, De

INTELLECTUAL PROPERTY ATTORNEY, CONSULTANT, AND STRATEGIST

10/2023 - Present | Lewes, DE | www.iplawstrategy.com

ASSOCIATE GENERAL COUNSEL & HEAD OF GLOBAL INTELLECTUAL PROPERTY TEAM

1/2023 - 9/2023 | Perfect Day, Incorporated | Berkeley, CA

- ⦿ Served as Legal lead for Biology as a Service (“BaaS”) business unit responsible for addressing the legal needs of the business, including drafting and negotiating Non-Disclosure, Material Transfer, Professional Service, Consulting, Master Collaboration, IP License, Letter of Intent, Equipment Fabrication, SaaS, and Master Service Agreements
- ⦿ Served as Head of the Global IP team responsible for setting down IP Strategies for the B2B, B2C, and BaaS business units, including conducting patent validity, freedom to operate, and patentability assessments; managing and prosecuting the IP (patent & trademark) portfolios; conducting IP training seminars; leading IP Due Diligence evaluations; and managing contentious IP matters, including oppositions and invalidations
- ⦿ Implemented a streamlined process for establishing IP strategies for R&D pipeline projects, including facilitating stakeholder management buy-in and funding of each strategy and providing the business with a clear patent filing roadmap and overview of third-party patent risks and accompanying risk mitigation strategy
- ⦿ Provided IP landscape insights that enabled the business to pursue strategic partnerships with collaborators and customers
- ⦿ Collaborated with business to align on agreement negotiation strategy that led to realignment of key agreements with the needs of the business

VICE PRESIDENT & CHIEF INTELLECTUAL PROPERTY COUNSEL

2017-2023 | Unigrid, Incorporated | Bridgewater, NJ

SKILLS

PROFESSIONAL

Intellectual Property (IP) Licensing
IP Risk Mitigation
Patent Prosecution
IP Enforcement
Technology Transfer
IP Due Diligence
Patent Portfolio Procurement
Competitive Intelligence
Legal Budget Management
Business Development
Cross-Functional Collaboration
Corporate Strategy Support
Legal Research and Analysis
Conflict Resolution
Corporate Governance
Training and Development
IP Awareness Programs
Public Speaking and Presentation
Trade Secret Protection

WORK EXPERIENCE (CONTINUED)

- ① Implemented IP Due Diligence process to support in-licensing, investment, joint development, & M&A deals, which ensured Corporate Strategy Team and C-Suite Executives were made aware of all materially relevant IP legal issues in a consistent, reliable manner
- ① Led expansion of Global IP legal team from a two to ten-member team, including developing business case required to support the expansion
- ① Realigned IP portfolio to business strategy and implemented the infrastructure required to develop and implement IP strategies that were aligned with the business strategies
- ① Built IP legal infrastructure to cost-effectively grow and manage the Company's IP assets, leading to a more strategically aligned IP portfolio that grew in size year over year with modest to no increase in the budget
- ① Developed company IP strategy, managed IP portfolio and budget, and guided the global patent, domain name, copyright, trade secret, and trademark strategies
- ① Coached and mentored the IP legal team, which consisted of ten direct reports
- ① Negotiated innumerable IP license, Patent Purchase, Joint Development, Material Transfer, Confidential Disclosure, Development & Commercialization, Co-existence, and Supply Agreements
- ① Leveraged strategic planning and legal knowledge to build and implement global IP litigation and offensive and defensive IP opposition and invalidation strategies, which led to several key strategic wins for the business and the CEO recognizing the Global IP Team with a CEO award
- ① Developed and implemented global IP Awareness training curriculum to improve companywide IP acumen, increasing the number of Invention disclosure submissions and company's overall awareness of the third-party patent landscape
- ① Prepared and prosecuted a wide variety of patent applications in the food science space

INTELLECTUAL PROPERTY CORPORATE COUNSEL, HOME & PERSONAL CARE INTELLECTUAL PROPERTY LEAD

2014-2017 | Genencor DuPont Industrial Biosciences | Palo Alto, CA & Wilmington, DE

- ① Developed and presented IP Strategies that aligned business, R&D, and IP objectives and assets by leveraging competitive intelligence
- ① Designed and implemented global patent enforcement strategies and offensive/defensive opposition and invalidation strategies that secured key elements of the company's business strategy
- ① Provided white space, freedom-to-operate, validity, and patentability assessments to enable the business to establish 3, 5, and 10-year business strategies
- ① Mentored and coached the business teams by collaboratively guiding the negotiation strategies for IP heavy settlement, material transfer, collaboration, confidential disclosure, and license and supply agreements
- ① Prepared and prosecuted biotechnology patent applications in the Enzyme and Home & Personal Care related arts

SKILLS

SECONDARY

Legal Writing
Litigation Strategy
Negotiation Strategy
Risk Assessment
Contract Review
Patent Portfolio Analysis
Change Management
IP Policy Development
Vendor and Supplier Management
Corporate Transactions
Team Building and Motivation
Project Management
Multinational Operations
Legal Technology Tools
Continuous Improvement

LANGUAGE

English (Native)

WORK EXPERIENCE (CONTINUED)

SENIOR PATENT ATTORNEY, DSM NUTRITIONAL PRODUCTS

2012-2014 | Royal DSM | Columbia, MD

- ① Established Patent team and administrative infrastructure required to in-house a newly acquired global patent portfolio
- ① Developed IP settlement strategy that led to the resolution of a bitter and protracted IP dispute between DSM and a key competitor dispensing with the distraction posed by the IP dispute and enabling both businesses to refocus their resources and attention on running their respective businesses
- ① Prepared and prosecuted biotechnology patent applications in the precision fermentation and edible oil spaces

SENIOR PATENT ATTORNEY, GLOBAL INTELLECTUAL PROPERTY LITIGATION & PATENTS TEAMS

2006 - 2012 | AstraZeneca Pharmaceuticals | Wilmington, DE

- ① Led ANDA litigation for VIMOVO and Non-Practicing Entity litigation for CRESTOR; conducted and managed Orange Book listings for Supplemental and New Drug Application submissions across AZ's portfolio of products
- ① Drove CRESTOR, SEROQUEL, and SEROQUEL XR labeling carve-out citizen petitions and subsequent suits brought against the FDA
- ① Provided white space, freedom-to-operate, validity, and patentability assessments for pipeline projects to enable the business to develop winning 3, 5, and 10-year business strategies
- ① Provided patent due diligence support for billion-dollar in-licensing opportunities and negotiated IP provisions in out-licensing, in-licensing, collaboration, confidentiality disclosure, material transfer, outsourcing, and consortium agreements
- ① Prepared and prosecuted small molecule patent applications in the neuroscience therapeutic area

ADDITIONAL EXPERIENCE

- ① ASSOCIATE COUNSEL PATENTS ■ Bristol-Myers Squibb Company
- ① INTELLECTUAL PROPERTY ASSOCIATE ■ Potter & Anderson & Corroon LLP
- ① LAW CLERK EXTERNSHIP ■ Judge Ronald Guzman

BAR ADMISSIONS & REGISTRATIONS

Registered to Practice | United States Patent & Trademark Office

Admitted | Delaware Bar and District Court of Delaware