



ALLEN R. BAUM **SHAREHOLDER**

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EDUCATION

J.D.,
Widener University School of Law, 1992
B.S., Chemistry
Muhlenberg College, 1989

BAR ADMISSIONS

North Carolina
Virginia
North Carolina Supreme Court
U.S. Court of Appeals, 4th Circuit
U.S. Court of Appeals, Fed. Cir.
U.S. Dist. Court, E.D. North Carolina
U.S. Dist. Court, E.D. Virginia
U.S. Dist. Court, E.D. Wisconsin
U.S. Dist. Court, M.D. North Carolina
Virginia Supreme Court

According to clients interviewed by Intellectual Asset Management (IAM) magazine, Allen provides “advice that is timely, contextually relevant and extremely useful” and his “ability to take complex scientific and legal issues and distil them into advice and guidance that we can truly act upon” is commendable. His more than 25 years of experience as a patent attorney and prior experience as a pharmaceutical chemist at DuPont Merck Pharmaceuticals and Smithkline Beecham gives him the ability to “very quickly pick up on the technology”.

Clients hire Allen to identify and execute strategies to protect key commercial products and bring lucrative products to market in areas heavily patented by competitors. With an extensive litigation background, Allen is also frequently retained to evaluate the strength of patents under consideration for licensing, acquisition, or investment and has provided opinions on patents protecting products with sales in excess of \$1 billion.

Allen was president of the Licensing Executives Society for USA & Canada, in 2006-2007 and the president and chairman of the Board of Governors for Certified Licensing Professionals (CLP). Allen serves as the managing shareholder of the firm's Research Triangle Park, N.C., office and previously served four years on the firm's board of directors.

Allen's work includes post grant litigation before the U.S. Patent and Trademark Office, freedom-to-operate studies, due diligence review, infringement/validity studies, licensing, paragraph IV litigation, reexamination, and patent preparation/prosecution in the areas of chemistry, pharmaceuticals, biochemistry, biotechnology and medical devices. His representative clients are active in small molecule pharmaceuticals, crop protection, biologics, vaccines, medical devices, ocular medications/implants, green technologies, nuclear power and advanced materials.

EXPERIENCE | **NON-LEGAL**

- **Dupont Merck Pharmaceuticals**
Analytical Chemist
- **Smithkline Beecham**
Analytical Chemist

EXPERIENCE | TEACHING

- **Licensing Executives Society**
Fundamentals and Intermediate Intellectual Asset Management Series

PRACTICE GROUPS

Post-Grant Patent
Licensing
Litigation
Patent Prosecution

AREA OF FOCUS

Biotechnology & Pharmaceutical
Green Technology
Chemicals, Energy & Agriculture

FORWARD THINKING

Alerts

- USPTO Announces Proposed Second Round of AIA Rule Changes, August 20, 2015
- Fed. Cir. Confirms § 271(e)(1) Safe Harbor Applies to Post-Approval Development of Clinical Data for Citizen Petition and Supplemental New Drug Application, May 22, 2015
- PTO Adopting But-For Materiality in Proposed Revision of Duty to Disclose Rules, November 09, 2016

Presentations

- "Learning the Sweet Science: Win the New Boxing Match Known as Inter Partes Review," ACI's Comprehensive Guide to Patent Reform, New York City, January 24, 2013
- "Assessing the Impact of New PTO Procedures Under the AIA on Hatch-Waxman Strategies Relative to Patent Life Cycle Management," ACI's Maximizing Pharmaceutical Patent Life Cycles, New York City, October 9, 2012
- "Taking Action to Address Potential Roadblocks with Effective FTO Analysis" ACI's 6th National Tactical and Practical Guide to Freedom to Operate, Philadelphia, Penn, July 31, 2012
- "Business Implications of Patent Reform: Taking the America Invents Act Into Account in Doing Deals," Licensing Executives Society's Research Triangle Park Chapter Meeting, Durham, NC, February 14, 2012
- "Patent 101: Overview of the Fundamental Provisions in the America Invents Act" and "The Timeline of Enactment: Identifying What Needs to be Done Now and Planning for Future Changes," ACI's Comprehensive Guide to Patent Reform for Life Science Companies, New York City, January 30-31, 2012
- "Exclusivities and Forfeitures: New Developments, Controversies and Concerns," ACI's 12th Annual Maximizing Pharmaceutical Patent Life Cycles, New York City, October 5, 2011
- "IP Law Essentials & Best Practices for Venture Capitalists: Everything You Need to Know About Protecting Intellectual Property in 60 Minutes," ExecSense Webinar, April 2011
- "Preparing for the Exit: Drafting Critical Termination Provisions," ACI's 14th Advanced Forum on Structuring, Negotiating and Managing Life Sciences Collaborative Agreements and Acquisitions, New York, NY, Feb. 17, 2011
- "The Role of the Regulatory Professional in the Due Diligence Process," 2010 RAPS Annual Conference & Exhibition, San Jose, CA, Oct 25, 2010
- "Who is on the Hook? Indemnities in Patent Sale and Licenses," Intellectual Property Owners Association Webinar, Sept. 23, 2010

HONORS

- Life Science Star, *Intellectual Property Law*, *LMG Life Sciences*, 2018
- IP Star, *Managing Intellectual Property* magazine, 2013-2018
- Biotechnology Law "Lawyer of the Year" - Raleigh, *The Best Lawyers in America*, 2018
- *The Best Lawyers in America*, Patent Law, Biotechnology and Corporate Law, 2005-2019
- Recommended Lawyer, *Legal 500*, 2017
- Leading Intellectual Property Strategist, *Intellectual Asset Management* magazine's "IAM 250 - A Guide to the World's Leading IP Strategists," 2009-2011
- Leading Licensing Lawyer, *Intellectual Asset Management* magazine's "IAM 250 – The World's Leading Patent & Technology Licensing Lawyers," 2010-2012
- Leading Intellectual Property Strategist, *Intellectual Asset Management* magazine's "IAM 300 - A Guide to the World's Leading IP Strategists," 2014
- Leading Patent Practitioner, *Intellectual Asset Management* magazine's, "IAM Patent 1000: The World's Leading Patent Practitioners," 2012-2018

AFFILIATIONS

- American Bar Association
- American Intellectual Property Law Association
- Licensing Executives Society
- Triangle Intellectual Property Law Association

TECHNICAL BACKGROUND

- Biopharma

REPRESENTATIVE MATTERS

- Represented pharmaceutical company out-licensing technology to multiple pharmaceutical manufacturers.
- Represented ocular therapy company in-licensing drug delivery technology.
- Represented numerous clients in-licensing third party patents for defensive and offensive purposes.
- Represented pharmaceutical company in license agreement associated with potential acquisition of FTC ordered product divestiture.
- Represented pharmaceutical company in settlement strategy concerning paragraph IV litigation on blockbuster pharmaceutical product.
- Represented numerous companies in-licensing technology from Universities.
- Opined on the implications of various licensing terms in dispute.
- Frequently assist clients in developing strategic approach to license negotiations.
- Assisted client in out-licensing patent to third party for assertion in litigation.
- Represented numerous companies in successfully addressing intellectual property risks without litigation.
- **Due Diligence**
- Conducted due diligence review of numerous pharmaceutical and medical device products for acquisition or in-licensing.
- Represented numerous start-up companies seeking financing from venture capital firms and initial public offerings.
- Conducted numerous due diligence investigations of intellectual property protecting marketed pharmaceutical products (including several blockbuster products) in an effort to predict probability and timing of generic market entry prior to patent expiration.
- Identified and implemented successful strategies to design around issued patents to bring generic pharmaceutical products to market.

Biographies | Allen R. Baum

- Accurately predicted claim construction and outcome in ongoing patent litigation for client considering acquisition of patent infringement defendant.
- Represented medical device company on intellectual property due diligence issues through acquisition by Fortune 50 pharmaceutical company.
- Opined on the validity of numerous pharmaceutical, chemical and medical device patents.
- **Patent Prosecution/Portfolio Management**
- Frequently assist clients in strategies for pursuing commercially significant patent portfolios including drafting and prosecution.
- Drafted and prosecuted portfolio of patents for several companies later licensed or sold to third parties.
- Manage large portfolio of patent applications for Global Fortune 100 companies.
- Frequent instructor for intellectual asset management courses.