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## Cheryl H. Agris, Ph.D., Esq.

New York, New York



### Primary Areas of Expertise

Intellectual Property  
Patents & Trademarks  
Financial Services  
International Transactions  
Domestic Transactions  
Biotechnology, Chemical, Pharm

**Current Employer-Title** Cheryl H. Agris, Ph.D. – Partner, Agris & von Natzmer, LLP and Arbitrator/Mediator

**Profession** Attorney, Arbitrator, Mediator

**Work History** Intellectual Property Practice, 1992 – Present; Cheryl H. Agris Attorney at Law, 1998 – 2005 & 2020 – Present; Partner, Agris & von Natzmer LLP, 2012 – Present; The Law Offices of Cheryl H. Agris Ph.D., 2005 – 2019; Of Counsel, Milde & Hoffberg, 2001 – 2010; Patent Attorney, Novo Nordisk of North America, 1992 – 1998; Law Clerk and Patent Agent (1990 – 1992), Pennie & Edmonds (Biotechnology Group), 1988 – 1992; Research Fellow, Sloan Kettering Institute, 1986 – 1988; Predoctoral Fellow, Johns Hopkins University, 1979 – 1986; Undergraduate Research Associate, Argonne National Laboratory, 1979.

**Experience** Over 30 years of experience in the IP field. Over 20 years in the ADR field (22 years as an arbitrator and 19 years as a mediator)

Areas of expertise include: Biotechnology; Chemicals; Pharmaceuticals; Medical Devices; Trade Secrets; Licensing, Joint Venture, Research and Development, Distribution, Manufacturing, Consortium, Employment and Consulting Agreements; Intellectual Property (Patents and Trademarks).

Have represented large and medium-sized corporations, startups and universities, and other nonprofit entities.

Legal practice includes preparing and prosecuting U.S. patent applications (over 250 issued patents to date), overseeing the filing and prosecution of foreign patent applications, conducting reviews of IP portfolios for strategic planning and due diligence studies, conducting patent and literature prior art searches, preparing patentability, validity and infringement opinions, preparing and reviewing agreements (e.g. licensing, collaboration, consortium, consulting and confidentiality, materials transfer, employment (particularly, non-compete and assignment of IP provisions), master services and supply and distribution agreements), and drafting and prosecuting trademark applications. In particular, have rendered a number of opinions with respect to biosimilars and Hatch-Waxman issues. Also includes reviewing marketing materials, investor presentations IPO and private placement documents with respect to IP issues.

Before entering the IP field conducted biomedical research on influenza virus and RNA processing at the Sloan-Kettering Cancer Center and doctoral dissertation research at the Johns Hopkins University on the synthesis of oligonucleotide analogs (anti-sense nucleic acids) and perturbation of viral infection with these oligonucleotide analogs. As an undergraduate research associate at Argonne National Laboratory, analyzed bile acids isolated from the bile, urine, or serum from children with cholestatic liver disease using gas chromatography and gas chromatography/mass spectroscopy.

## **Mediator Experience**

Over 19 years of experience mediating a variety of technology, corporate, commercial, intellectual property, insurance and real estate disputes. Have mediated >80 disputes, including multiparty matters and more than 20 matters with claims in excess of \$500,000. Serves as a court-approved mediator for the New Jersey Superior Courts, NY, Queens, and Westchester County Supreme Courts, Westchester County General Civil Mediation Program, Eastern District of New York.

Areas of experience include breach of contract, partnership matters, licensing agreements, research and development agreements, biotechnology, chemical, pharmaceutical, medical device and technology matters, manufacturing agreements, employment contracts, leases, construction matters.

Breach of contract matters have included a variety of commercial contracts involving services (e.g., website design, consulting, cleaning, cable systems, video production; property management) and products (e.g., defective or missing products due to issues with shipper and manufacturer). Amounts in dispute have ranged from \$25,000 to greater than \$500,000.

With respect to partnership agreements, mediation experience has included withdrawal of a partner from a law firm and dissolution of business partnerships (e.g., medical practice, counseling practice). Amounts in dispute have ranged from about \$200,000 to about \$750,000.

Mediation experience with respect to licensing, manufacturing, research, and development agreements have generally been in the pharmaceutical, chemical, medical device, technology and biotechnology areas and half have involved multiparty disputes; amounts involved have ranged from about \$1,000,000 to about \$10,000,000.

Employment matters mediated have involved mostly high-level executives (leader of the division, CEO, Vice President) and have included breach of employment agreements and discrimination claims. Amounts in dispute have ranged from \$100,000 to \$700,000.

Construction matters have included both business and residential construction; such construction matters have mainly involved multiparty disputes (contractor, subcontractor, customer or alternatively retailer, distributor, and customer). Amounts in dispute have ranged between \$25,000-\$700,000.

Issues encountered in real estate disputes have included breach of commercial leases for various entities (retail, storage units, industrial establishments). Also mediated a breach of a limited partnership agreement with respect to a residential apartment building involving the limited partner, general partner and property manager.

Insurance matters mediated have involved disputes involving insurance coverage for injuries sustained by a worker, coverage of funeral costs. One particular matter involved not only the carrier but the underwriter as well.

Available for in person and virtual mediations.

## **Representative Issues Handled as a Mediator**

Handled Real Estate disputes between the landlord and tenant in the commercial and residential area; property management contracts.

Professional and business partnerships removal of a partner from the partnership; dissolving partnership; interpretation of partnership agreement.

Breach of manufacturing agreement product defects; delays and failure to provide quantities

contracted.

Commercial sale of goods issues involving quality of goods provided and whether conforming goods were provided as well as other contract interpretation issues.

Limited partnership agreement-scope; breach of fiduciary duty of general partner.

Construction for both commercial and residential with issues involving non-payment, delay, damages, design errors, mold.

## **Mediator Style & Process Preferences**

Mediation is a process where the neutral is used by both parties to analyze the strengths and weaknesses of their positions and work towards a solution. A mediator should thus act as a resource to the parties.

In a litigation, on many occasions, each side tends to be focused on their positions. The mediator can be that fresh set of eyes to provide a neutral perspective regarding the risks and possible outcomes of each party's position. My role is also to facilitate dialog between the parties. There are many occasions where the parties have not ever met face to face or at the very least have not had any direct interactions for some time. Thus, sometimes it is useful to allow the parties an opportunity to be heard by the other side.

Every matter is unique. Therefore, a mediator should be flexible and employ an approach that depends on the dynamics of each case. There are times when I facilitate and even promote dialog between the parties. However, in some circumstances, either at the request of the parties or based on my assessment, providing an evaluation of the matter and making suggestions about possible settlement terms are more helpful. Such an evaluation would be provided in a caucus.

Successful mediation may also involve various dialog models during the mediation session, between attorneys, between the parties alone. The approach used depends on the parties' desires and/or my sense of what might be helpful. As noted above, caucusing, where I meet with parties separately, can be productive as well.

At all times, I request from each party a mediation statement that contains the strengths and weaknesses of their position, a settlement provision, and any other supplemental material that might be helpful (e.g. a contract that is in dispute) at least 10 days in advance of the mediation session. This has been helpful to the parties and to me as a mediator in preparing for the session. Having an opportunity in advance to review the statements and consider various approaches that might be helpful improves subsequent communications with the parties. In addition to the scheduling conference call, I have found it useful to speak with all of the parties prior to the in-person session to convey my thoughts/suggestions based on the review of materials provided by the parties. This provides a jumpstart to the mediation process and puts everyone in a more mediation-focused mindset.

## **Technology Proficiency**

Available for both in-person and virtual arbitrations and mediations.

## **Education**

Brooklyn Law School (JD, recipient of Dean's Scholarship throughout law school-1992); The Johns Hopkins University (Ph.D., Biochemistry-1986); Goucher College (BA, Chemistry, General Honors and Honors in Chemistry-1979)

## **Professional Licenses**

Admitted to the Bar: New Jersey (1992), New York (1993); U.S. District Court: Southern and Eastern Districts of New York; U.S. Patent and Trademark Office (Patent Agent, 1990; Patent Attorney, 1993).

## **Professional Associations**

- Tech List Member, Silicon Valley Arbitration and Mediation Center
- Fellow, CI Arb (2019-Present) (member, New York chapter)
- AIPPI (International Association for the Protection of Intellectual Property) (Member, ADR, Committee, 2012-Present)
- NYC Bar
- Member, ADR Committee, 2017-Present
- Member International Commercial Disputes Committee, 2014-2017
- Member Arbitration Committee, 2010-2013
- New York State Bar Association (NYSBA)

- Member, Dispute Resolution Section, 2010-Present; Co-Chair of Website Committee, 2017-2018
- Member of Intellectual Property Section since 1998
- American Intellectual Property Law Association
- Member of ADR, Biotechnology, PCT, Chemical Practice Committees since 1997
- Vice Chair Membership Committee 2010-2012
- Membership Chair, 2012-2013
- Eastern New York Intellectual Property Law Association (Member, Board of Managers, 2010-Present)
- International Intellectual Property Society (2000-Present).

## Recent Publications & Speaking Engagements

### Publications:

Co-Author, "Use of Arbitration In Resolving Disputes Involving Intellectual Property,' chapter in Handbook of Commercial Arbitration, American Bar Association (forthcoming); Agris, C.H. (principal author), "Practitioner's Manual of Patent Examining Procedure", Thomson-Reuters, 6th Ed. 2012; Agris, C.H. "Practitioner's Patent Guidelines", Thomson-Reuters, 2012; Agris, CH., "Comparison of Arbitration Procedures in IP Disputes", Proceedings of New York State Bar Association Intellectual Property Law Section Annual Meeting, January 2011; Co-Author, New York State Bar Association White Paper, "The Benefits Of Mediation And Arbitration For Dispute Resolution In Intellectual Property Law" (January 2011), reprinted in New York State Bar Association, New York Dispute Resolution Lawyer, 4:61-65 (Summer 2011); Agris, C.H., "Practitioner?' Patent Guidelines", Thomson-Reuters, 2011; Comparison of International Arbitration Procedures, NYIPLA Bulletin, pages 8-10 (March/April 2005).

### Representative Speaking Engagements:

Panelist on "SVAMC Panelists Debate: Proposed Procedures for Changing the Allocation of Power between Parties and Tribunals in High Tech Arbitrations", NY Arbitration Week 2022; Panelist on "Practicum on Discovery Issues", Securities Arbitration 2022, Practising Law Institute; Lecturer, "Alternative Dispute Resolution in Intellectual Property Disputes", Nassau County Bar Association, 2021; Panelist on "Hot Ethical Issues in Securities Arbitration", Securities Arbitration, 2019; Presenter, "New Paradigm for Alternative Dispute Resolution in Intellectual Property Litigation", Westchester County Bar Association, 2019; Faculty Member, PLI Advanced Prosecution Workshop: Advanced Claim Drafting and Amendment Writing. Lecturer, 1998-2004 and 2016-2017; Panelist, "The Writing and Updating of a Legal Treatise", Eastern New York Intellectual Property Law Association, 2013; Panelist, "Using IP Alternative Dispute Resolution-Is it Ready for Prime Time", New York State Bar Association Intellectual Property Law Section Annual Meeting, 2011; Lecturer, The IP Toolkit-Part II: protecting intellectual property assets-Patents", 2009, WestLegalworks Online Program; Lecturer, "The IP Toolkit-Part II: Protecting intellectual property assets-Trademarks", 2009, West Legalworks Online Program; Lecturer "The IP Toolkit-Part I: Protecting Intellectual Property Assets, What Every Attorney Needs to Know", 2008, West Legalworks, Online Program; Panelist, "Critical Junctures in Mediation and How Best to Handle Them," New York State Bar Association Dispute Resolution Section Annual Meeting, 2009,"The MPEP as a Practice Tool: It Is Not Just a Paperweight", National Association of Patent Practitioner's Meeting, 2008; Moderator, International Intellectual Property Society Program Entitled "Alternative Dispute Resolution in Intellectual Property Disputes", September 14, 2006

<b>Mediation Rate</b>	\$600 Per Hour
<b>Languages</b>	English
<b>Citizenship</b>	United States of America
<b>Locale</b>	New York, NY

The AAA's Rules provide the AAA with the authority to administer a mediation including, mediator appointment, general oversight and billing. Accordingly, mediations that proceed without AAA administration are not considered AAA mediations, even when the parties select an mediator who is on the AAA's Roster.

The information contained in this resume has been supplied solely by the individual mediator and may, or may not, be a complete recitation of their experience. The AAA assumes no responsibility for the content, completeness, accuracy, or reliability of the

information contained in a mediator's resume. If you have any questions about a mediator's experience or background, you are encouraged to contact your case manager.

Mediators on the AAA Roster are not employees or agents of the AAA.