# STITES & HARBISON PLLC



Mandy Wilson Decker Title: Member Phone: 502-681-0521 Location: Louisville, KY , Lexington, KY Email: mdecker@stites.com Download: vCard

Mandy Wilson Decker is a Patent Attorney and member of the Intellectual Property & Technology Service Group. Her practice focuses on intellectual property protection strategy, including counseling clients on infringement, validity and patentability, transfer of intellectual property, patent drafting, and patent prosecution. Contributing to her practice is a scientific background in chemistry and experience with academic and commercial research in the areas of biochemistry, biotechnology, and pharmaceutical sciences.

### CAPABILITIES

#### **Practice Areas**

- Biotechnology/Life Sciences
- Clinical Research, Clinical Trials & Risk Management
- Entrepreneurial Services
- Health Care
- Health Care Life Sciences Technology & Commercialization
- Intellectual Property & Technology
- Manufacturing
- Patent Prosecution & Protection

# RECENT ASSIGNMENTS

- Developed intellectual property portfolio protection strategies for various research institutions, universities, private companies, and entrepreneurs.
- Prepared and prosecuted patent applications in a wide variety of chemical, biochemical, pharmaceutical, cosmeceutical, dermatologic, biotechnological, medical, and mechanical arts derived from both academic and commercial research.
- Managed international patent portfolios and prosecution involving applications and patents in regions and countries including Australia, African Union (OAPI), Brazil, Canada, China, Colombia, Eurasia, Europe, France, Germany, Greece, Hong Kong, India, Ireland, Israel, Italy, Japan, Korea, Liechtenstein, Mexico, New Zealand, Russia, Singapore, South Africa, Spain, Sweden, Switzerland, Ukraine, the United Kingdom, and the United States.
- Negotiate agreements to transfer or license intellectual property rights.

#### **BAR ADMISSIONS**

- Kentucky
- U.S. Court of Appeals for the Federal Circuit
- U.S. District Court for the Eastern District of Kentucky
- U.S. District Court for the Western District of Kentucky
- United States Patent and Trademark Office

# RECENT NEWS, ARTICLES & SPEAKING ENGAGEMENTS

- The Most-Read IP Law360 Guest Articles of 2023 by editor, *Law360.com*, December 22, 2023
- Navigating Intellectual Property in Manufacturing co-speaker, Kentucky Association of Manufacturers (KAM) 2023 Manufacturers Summit, Bowling Green, Ky., November 2, 2023
- What 70% of Americans Don't Understand About Intellectual Property Stites & Harbison Client Alert, October 26, 2023
- The challenges of protecting intellectual property co-speaker, Startup Week Louisville, September 20, 2023
- *Managing IP* Selects Mandy Wilson Decker to 2023 "Top 250 Women in IP" List for Ninth Time by staff writer, *Attorney At Law Magazine*, July 25, 2023
- Meet Mandy Wilson Decker, KYIPA Board of Advisors Chair by staff writer, KYIPA.org, July 19, 2023
- UK Women Innovators Network Panel Discussion
  Panel Moderator, University of Kentucky Office of Technology Commercialization, March 28, 2023
- An Applicant's Guide To USPTO's Examiner Incentive System Law360, February 8, 2023
- Decoding the Crypto Brand Super Bowl Commercials Stites & Harbison Client Alert, February 18, 2022
- Kentucky attorney named to global "Top 250 Women in IP" list *The Lane Report*, July 19, 2021
- Tech Transfer: Methods That Work, IIPCC Fall IP Experts Panel Series, Panel 3 Moderator, International Intellectual Property Commercialization Council (IIPCC), October 6, 2020
- From Bench to Bar: Pursuing a Legal Career After Graduate Studies University of Kentucky, College of Pharmacy, October 9, 2019

- Patentability in the Context of Personalized Medicine, Novel Targets, Treatment Methods, and Repurposed Drugs
   University of Kentucky, Office of Technology Commercialization, June 26, 2019
- Do You Have a Competitive Advantage and Can You Protect It? Lecturer, University of Louisville Translational Training Series, October 3, 2017
- Protecting Intellectual Property Lecturer, Launchlt Entrepreneur Training Program Powered by Nucleus, October 15, 2015
- Pursuing Patent Protection for University Technologies Lecturer, SBCoA Seminar, January 24, 2014
- Pursuing Patent Protection
  Lecturer, Howard Hughes Medical Research Institute, Janelia Research Campus, December 11, 2013
- Patent Prosecution
  Lecturer, University of Kentucky College of Law, Intellectual Property Law, November 27, 2012
- Understanding Lecturer, Howard Hughes Medical Research Institute, Janelia Research Campus, July 18, 2012
- Intellectual Property presenter, Kentucky Innovation & Entrepreneurship Conference, Louisville, Ky., June 1, 2012
- U.S. Supreme Court kicks Myriad, the Gene Patent Case, back to the Federal Circuit for consideration Stites & Harbison, PLLC, Client Alert, March 27, 2012
- U.S. Supreme Court decision gives rise to new challenges for patent protection Stites & Harbison, PLLC, Client Alert, March 21, 2012
- America Invents Act: What's New in the New Patent Act? *Medical News,* December 2011
- Patent Prosecution
  Lecturer, University of Kentucky, College of Law, Intellectual Property Law, November 17, 2011
- Intellectual Property Lecturer, University of Kentucky, Scholars in Engineering and Management (SEAM), October 27, 2011

- Protecting Your Intellectual Property University of Kentucky Von Allmen Center for Entrepreneurship and Kentucky BioAlliance, Lexington, Ky., October 13, 2011
- Angel Investing Overview Seminar
  Due Diligence Panel, Angel Resource Institute, Lexington, Ky., September 8, 2011
- Developing and Integrating a Comprehensive IP Strategy in a Global Marketplace Kentucky BioAlliance and Kentucky Science and Technology Corporation (KSTC), Louisville, Ky., June 21, 2011
- Making their mark: Louisville patent attorneys play key roles in invention process with Steve Ivey and Staff Writer Business First of Louisville, May 27, 2011
- Partners in Health Care: People to Watch in 2011 Business First of Louisville, March 8, 2011
- Patent law basics and strategies
  Entrepreneurial Workshop 2010, Louisville, Ky., May 20, 2010
- Mutant court case? Medical News, May 1, 2010
- Biotechnology companies receive R&D incentive from Health Care Reform Stites & Harbison, PLLC, Client Alert, April 29, 2010
- Intellectual Property, Business Bootcamp Ohio Valley Affiliates for Life Sciences (OVALS) Annual Meeting, Louisville, Ky., April 2010
- Biotechnology and Life Sciences Patent Prosecution Special Interest Group Facilitator, Association of University Technology Managers Annual Meeting, New Orleans, La., March 2010
- IP Practices Growing with Mark Green The Lane Report, February 2010
- Life Sciences Technology: Ten Intellectual Property Issues to Consider Author, *Medical News*, Louisville, Ky., May 2009
- The Developing Landscape of Biotechnology Patent Law Co-moderator, Association of University Technology Managers Annual Meeting, Orlando, Fla., February 2009
- Protecting Your Ideas Kentucky Innovation & Enterprise Conference, Lexington, Ky., April 2008

- Intellectual Property and Marketing 101
  Panelist, Business Bootcamp / Ohio Valley Affiliates for Life Sciences, Louisville, Ky., April 2008
- Biotechnology Panel
  Moderator, Law Ethics and Life Sciences Conference, Louisville, Ky., October 2007
- Leveraging and Protecting Intellectual Property SBIR/STTR National Conference, Small Business Research Institute and Small Business Technology Transfer, Louisville, Ky., May 2006
- IP Update: The Plain English News You Can Use Association of University Technology Managers, Graduate Course, Tempe, Ariz., November 2004
- Key Business Topics: Intellectual Property Small Business Innovative Research (SBIR) and Small Business Technology Transfer Programs (STTR) Conference (SWIFT), Louisville, Ky., September 2004
- Intellectual Property Basics
  Center for Higher Education Law, Vanderbilt University, Nashville, TN
- Pharmaceutical Patent Protection: More Generic Favored Legislation May Cause Pioneer Drug Companies to Pull the Plug on Innovation
   Wilson, M.V., 90 Kentucky Law Journal 495 (2002)
- Functional Pathways of NAD Biosynthesis in Human Skin Fibroblasts and Keratinocytes Jacobson, E.L., Wilson, M.V., Roberts, M.J., Jacobson, M.K., Abstract, 114 *Journal of Investigative Dermatology* 850 (2000)
- PARP Null Mouse Cells Synthesize ADP-ribose Polymers
  Shieh, W.M., Amé, J.-C., Wilson, M.V., Wang, L.-Q., Koh, D., Jacobson, M.K., Jacobson, E.L.,
  273 Journal of Biological Chemistry 30069 (1998)

## FIRM LEADERSHIP

- Diversity and Inclusion Task Force, Chair (2021)
- Management Committee (2016-20)
- SWIFT (Stites Women Investing in Our Future Together) Committee, Chair (2012-15)
- Diversity Committee (2010-15)
- Ethics Committee (2006-10)

#### **MEMBERSHIPS**

- American Intellectual Property Law Association (AIPLA)
- American Bar Association , Health Law Section
- American Bar Foundation , Fellow
- Kentucky Bar Association, Intellectual Property Section
- Louisville Bar Association
- Association of University Technology Managers (AUTM)
- American Health Lawyers Association

## COMMUNITY INVOLVEMENT

- Legal Aid Society, Justice for All Campaign Committee (2005-present), Chair (2019); Associates for Justice Campaign Committee, Chair (2007)
- Leadership Louisville Center, Member (2014-present)
- Kentucky Intellectual Property Alliance (KYIPA), Board of Advisors, Chair (2023-present); Executive Advisory Committee (2021-present)
- Kentucky Bar Association, Intellectual Property Section, Chair-Elect (2023-Present)
- St. Agnes, Parish Council (2021-24), Chair (2022-23); School Board (2015-18), Chair (2017-18)

#### EDUCATION

University of Kentucky College of Law J.D. magna cum laude 2002

- Order of the Coif
- Kentucky Law Journal, Staff Member, 2000-02

University of Kentucky B.S., Chemistry 1997

- Honors Program

Ms. Decker joined the firm after working as a scientific research associate at the University of Kentucky in laboratories housed in the Advanced Science Technology and Commercialization Center (ASTeCC). Her scientific research experience also involved working with Niadyne, Inc., a biotechnology company involved in the research and development of dermatology products, including cosmeceutical and pharmaceutical skin care products to address various health care needs.

Ms. Decker served on the Board of Saint Agnes School from 2015-2018 and served as Chair during the 2017-18 school year. She also serves on the Annual Campaign Committee of the Legal Aid Society and is a member of the Leadership Louisville Center. She served for nine years as a member of the Board of Directors for Crane House, a Louisville organization dedicated to improving understanding between Asia and the United States. During her time with Crane House she served as a Vice President, and as Chair of various committees including the Nominating Committee and Personnel Committee.

She also served as Chair and as a member of the Legal Aid Society Associates Campaign Committee for more than fifteen years. Ms. Decker has also been involved in a number of other non-profit organizations in the community, including Dress for Success Louisville and Junior League of Louisville. She lives in the Highlands with her husband, Deck, and their children, Molly Kate and Ben.

# ACCOLADES

- Martindale-Hubbell® AV-Preeminent® Peer Review Rated
- Best Lawyers in America®, Biotechnology and Life Sciences Practice and Patent Law (2020-24)
- Chambers USA, "America's Leading Lawyers for Business," Intellectual Property (2017-23)
- Managing Intellectual Property, Top 250 Women in IP (2014, 2016-23)
- Managing Intellectual Property, IP Stars (2013-23)
- Kentucky Super Lawyers®, Rising Star (2013-14)
- Leadership Louisville (2014)
- Business First of Louisville, 20 People to Know in Law (2019)
- Business First of Louisville, Partners in Health Care (2012-15)
- Business First of Louisville, Partners in Health Care People to Watch (2011)
- Business First of Louisville, "Forty under 40" (2008)

#### TESTIMONIALS

" . . . provides in-depth expertise in life sciences when advising on patent prosecution and infringement actions . . . increasingly highlighted for her strength as a "prominent patent attorney." "

- Chambers Commentary (USA), 2020