

LISA M. CALDWELL

SENIOR COUNSEL

503.595.5300 | lisa.caldwell@klarquist.com



OVERVIEW

Lisa practices all aspects of intellectual property law. She has extensive experience counseling clients on patent portfolio development and management, trademark and brand development, licensing, and offensive and defensive strategies for strengthening and protecting the intellectual property rights of her clients.

As a leader in the firm's Chemical patent group, Lisa advises a wide variety of U.S. and foreign clients on patent issues, including the preparation and prosecution of applications, opinions of counsel, licensing, and the development of strategic patent policies and practices. She has expertise in a range of technical areas, including semiconductor processing and devices, pharmaceuticals, food science, manufacturing processes, and pulp/paper technologies, as well as other fields involving inorganic and organic chemistry. Prior to joining Klarquist, she enjoyed a career as a chemist, where she gained considerable research and industry experience at a number of prestigious organizations.

Lisa is also active in the firm's Trademark practice group, where she advises clients on all types of trademark matters, including brand development and management. She represents clients with large, well-known brands, as well as companies that are just beginning to develop their own brand identities. With substantial experience in managing global trademark portfolios, clearing and registering marks, and representing clients in oppositions and cancellation proceedings, she provides effective and efficient representation across the spectrum of trademark law.

Lisa is engaged in the legal community and is a member of a variety of local and national bar associations, including the Sonoma County and Napa County Bar Associations, the American Intellectual Property Law Association, and the International Trademark Association.

Lisa joined Klarquist as an associate in 1995 and became partner in 2001. She founded Klarquist's satellite office in Santa Rosa, California, in 2017.

EDUCATION

J.D., *summa cum laude*,
Willamette University
College of Law, 1994

B.S., Chemistry,
California State
University, San Jose,
1984

ADMISSIONS

Oregon, 1995

California, 2017

U.S. Patent and
Trademark Office, 1998
(Reg. No. 41,653)

PRACTICE AREAS

Patents

Trademarks

Intellectual Property
Counseling

TECHNOLOGY AREAS

Chemical

Agriculture & Food
Science

Electrical &
Semiconductors

Life Sciences &
Biotechnology

Mechanical

Nanotechnology

Klarquist

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PROFESSIONAL EXPERIENCE

▶ Oregon Department of Justice | Court Certified Law Clerk, 1992 – 1993

Civil Enforcement Division, representing state in various hearings, judgment debtor exams, and statutory injunction proceedings; preparation of legal memoranda, discovery requests, pleadings, responses, affidavits, and motions.

▶ CH2M Hill | Chemist, 1991 – 1994

Researching, developing, and practicing methodologies for analyses of soils, air, and water inorganic and organic toxics for environmental impact studies.

▶ Fujitsu Microelectronics | Chemist, 1989 – 1991

Responsible for developing and practicing methodologies for quality control/quality assurance of liquid, solid, and vapor chemical process media used for computer chip fabrication. Evaluated/solved chip fabrication chemical process issues.

▶ Nuclear Environmental Analysis | Chemist, 1985 – 1989

Responsible for method development, analysis, and reporting of soil, air, and water environmental contaminants.

▶ University of California, Lawrence Livermore National Laboratory | Research Chemist Hazards Control Department, 1982 – 1984

Performing research and development.

PROFESSIONAL ACTIVITIES

▶ Chair, Oregon State Bar Disciplinary Board Trial Panel (Region 5, 2009-2017)

▶ Member, American Intellectual Property Law Association

▶ Member, State Bar of California

▶ Member, Licensing Executives Society

▶ Member, Oregon Patent Law Association

▶ Member, International Trademark Association

▶ Member, American Chemical Society

HONORS & AWARDS

▶ *The Best Lawyers in America*®, Portland, OR, Trademark Law | 2012, 2013, 2014, 2015, 2016, 2017, 2018, 2020, 2021, 2022,

▶ *World Trademark Review 1000* | 2016, 2017, 2020, 2022, 2023

▶ *Chambers USA*, Oregon, Intellectual Property | 2022, 2023

PRESENTATIONS & PUBLICATIONS

▶ “Trademark Law – Basics and Client Counseling” (CLE, Portland, Oregon, June 2017)

▶ “A Sporting Approach to Trademarks & Branding” (CLE, Portland Trailblazers Continuing Legal Education Night, March 2016)

▶ America Invents Act: Patent Prosecution Strategy, June 2012

Klarquist