

PARTNER California Office 503.595.5300 lisa.caldwell@klarquist.com

#### EDUCATION

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

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

#### 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

## Lisa M. Caldwell

Lisa is a partner at the firm practicing in 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 very 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, Lisa provides effective and efficient representation across the spectrum of trademark law.

Lisa is active 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 1994 and became partner in 2001. She founded Klarquist's satellite office in Santa Rosa, California, in 2017.

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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
- 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

- 2012 2018 The Best Lawyers in America©, Portland, OR, Trademark Law
- 2016 2017 World Trademark Review 1000: The World's Leading Trademark Professionals

### **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

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