

Fisher Broyles

Name: Lisa A. Carroll

Email: lisa.carroll@fisherbroyles.com

Direct: +1.312.919.9479

Office: Chicago

Practice Areas: Commercial Transactions; Copyrights; International; Internet E-Commerce; Licensing; Outsourcing; Strategic IP counseling; Technology; Trademarks; Trade Secrets; Privacy and Data Security

Bar Admissions: Illinois; United States Court of Appeals for the Federal Circuit; United States District Court for the Northern District of Illinois; United States District Court for the Western District of Michigan; United States District Court for the Western District of Wisconsin

Education: The University of Illinois Chicago School of Law, LL.M, Intellectual Property, 2000; The University of Illinois Chicago School of Law, J.D., 1998; The University of Illinois Champaign-Urbana, B.S., Broadcast Journalism, 1990

Experience: BigMachines, Inc., Vice President and General Counsel; Applied Systems, Inc., Assistant General Counsel; Bell, Boyd & Lloyd LLP (now K&L Gates LLP)

Ms. Carroll concentrates her practice in the area of Intellectual Property Law, including IP transactions, trademarks, trade secrets, and copyrights, with a particular focus on drafting and negotiating technology agreements, including SaaS subscription, co-development, and software license and assignment agreements. She regularly counsels technology companies about how to perfect, enforce, and maximize their IP portfolios in the US and abroad and has prosecuted and maintained large, international trademark portfolios for international companies. Ms. Carroll's practice also comprises advising companies about the ever-evolving information security standards, such as ISO 27001. As both outside IP counsel and in-house General Counsel, she has worked with some of the leading technology companies in their respective spaces and start-ups carving brand new spaces. Ms. Carroll brings a practical perspective to advising technology companies that reflects the financial, operational, and administrative opportunities and challenges of the organization, today and as it grows.

As Assistant General Counsel for Applied Systems, Inc. and then Vice President and General Counsel of BigMachines, Inc., Ms. Carroll worked closely with all business units of the company, including worldwide sales, development, product management, cloud/hosting services, customer support, professional

Fisher Broyles

Page 2 of 2

services, and finance. No question was too small or issue too seemingly non-legal in nature. As a result, she has a vast reservoir of real-world experience from which she draws in anticipating issues and advising clients.

Prior to joining Applied Systems and BigMachines, Ms. Carroll was an associate and then partner at Bell, Boyd & Lloyd LLP. Her practice there included large patent litigations as well as copyright and trade secret cases in the federal and state courts of several jurisdictions. With this experience, she bears in mind not just how contractual provisions will be performed but how they might be litigated when drafting and negotiating agreements.

Ms. Carroll also has been an Adjunct Professor of Law in the IP program at what is now The University of Illinois Chicago School of Law. She has taught a course that examines the legal development of startup companies with an emphasis on opportunities and problems related to intellectual property, including the special problems encountered by startups in creating a new company, gathering together initial shareholders, raising additional funding, creating and utilizing IP interests, hiring new employees without abusing the trade secrets or other assets of competitors, seeking subsequent large-scale funding from sources like venture capitalists and public stock offerings, dealing with potential or actual bankruptcies, and completing a successful merger and the IP due diligence that accompanies such a transaction. Ms. Carroll also previously taught a course about patent law to aspiring IP attorneys with an emphasis on the intersection and the differences between patent and other intellectual property rights as well as the fundamentals of patent prosecution, licensing, and infringement.

Publications

- Lisa A. Carroll – “A Better Way to Skin The Cat: Resolving Domain Name Disputes Using State Unfair Competition Law” – ABA IP Newsletter (Winter 2000), republished in ABA GP Solo Magazine (September 2000)