

# Eleanor M. Yost

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## Overview

Eleanor Yost manages national and international patent, trademark, and domain name portfolios for some of the most recognizable brands in the world. She also litigates high-stakes intellectual property disputes in state and federal courts, the U.S. International Trade Commission, and the U.S. Patent and Trademark Office (USPTO). Eleanor's clients rely on her for a broad range of intellectual property and government contracts advice, including patent and trademark prosecution, opinions, IP and software licensing, due diligence, and transactions. Eleanor is board certified in Intellectual Property Law by The Florida Bar.

An in-demand thought leader on the subject of USPTO Patent Trial and Appeal Board (PTAB) post-grant proceedings, Eleanor has been featured on the topic in *IPLaw360*, *AmLaw Daily*, *Corporate Counsel*, *Inside Counsel*, *The Recorder*, *Intellectual Property Magazine*, *Bloomberg BNA*, *Westlaw Journal Intellectual Property*, *The Pink Sheet*, *Managing IP*, *Lawdragon*, and elsewhere. She has been named one of the "Top 50 Women in PTAB Trials" and was selected to be a founding member of the board of directors for the PTAB Bar Association, the leading national bar association for PTAB practitioners, judges, and other stakeholders. She represents clients in inter partes review, post-grant review, covered business method review, and related appeals to the Federal Circuit.

In addition to her intellectual property practice, Eleanor assists clients navigating government contracts and procurement issues, particularly those involving the Federal Acquisition Regulations (FARs), Defense Federal Acquisition Regulations Supplement (DFARS), and the Bayh-Dole Act, among others. She counsels clients with respect to prime awards, grants (e.g., DARPA), subcontract arrangements, novations and M&A issues, contract interpretation, performance, bid protests, and potential claims.

## Experience

### Patent Infringement - Select Cases

- *Nichia Corp. v. Healtel Inc., Lighting Science Group Corp., and Vividgro Inc.*, three patent litigations in the Middle District of Florida about LED technology.
- Hunt Construction, the United States Tennis Association, and USTA National Tennis Center in *Uni-Systems Inc. v. USTA*, a multiparty patent litigation in the Eastern District of New York concerning retractable stadium roofs.
- Conair and Rite Aid in *Tonytail Co., Inc. v. Conair Corp.*, patent and trade dress litigation in the Northern District of California; obtained a complete victory on all disputed claim construction issues following *Markman* hearing.
- Patent owner in trial, appellate, and contempt proceedings in *ePlus Inc. v. Lawson Software, Inc.* in the Eastern District of Virginia.
- JPMorgan Chase in *JPMorgan Chase & Co. v. Affiliated Computer Services, Inc.*, a declaratory judgment action in the District of Delaware involving 10 patents related to financial services and payment processing systems.
- Textron Innovations and Bell Helicopter in *Bell Helicopter Textron, Inc. v. Airbus Helicopters* cases in the District of Columbia involving patented helicopter landing gear.
- Patent owner in *NTP, Inc. v. Sprint Nextel Corp.* and *NTP, Inc. v. AT&T Mobility*, a suit in the Eastern District of Virginia concerning wireless email technology.
- Patent owner in *Personalized Media Communications v. Motorola, Inc., EchoStar Corp., and DISH Network Corp.*, a suit in the Eastern District of Texas concerning telecommunications technology.
- Raisecom in *Magnacross LLC v. Raisecom Inc.* in the Middle District of Florida.
- International Dental Supply Co. in *Midmark Corp. v. International Dental Supply Co.* in the Southern District of Florida.
- Patent owner in *Augme Technologies, Inc. v. Yahoo! Inc.* in the Northern District of California and the Federal Circuit.
- Patent owner in *Augme Technologies, Inc. v. Gannett Co., Inc.* in the Southern District of New York.
- Patent owner in *LucidMedia Networks, Inc. v. Augme Technologies, Inc.* in the Eastern District of Virginia concerning online advertising technology.

- Fresenius in *Cadence Pharmaceuticals, Inc. v. Fresenius Kabi USA, LLC*, an ANDA litigation in the Southern District of California.
- Patent owner in *Crutchfield Corp. v. Focusrite PLC*, a patent litigation in the Western District of Virginia involving speaker technology.
- Anika in *Glycobiosciences, Inc. v. Anika Therapeutics, Inc.*, a multiple-patent case in the District of Columbia concerning wound treatment products.

### **Trademarks, Trade Secrets, Copyrights, and False Advertising**

- Trademark owner GoFundMe in *GoFundMe, Inc. v. CMG Mortgage, Inc.*, a trademark infringement, dilution, and unfair competition litigation in the Northern District of California.
- Trademark owner Cigar City Brewing in *Cigar City Brewing, Inc. v. Cigar City Smoked Salsa*, a trademark infringement action in the Middle District of Florida that settled favorably.
- Delta Products in *SAE Power Inc. v. Avaya Inc. & Delta Products*, a trade secret litigation in the District of New Jersey.
- Celentano Food Products Inc. in *Celentano Food Products, Inc. v. Dominick Celentano*, a trademark infringement and trade secret misappropriation action in the District of New Jersey.
- Thomas Aaron Billiards and The Billiard Connection in *Douglas Kelly d/b/a Liberty Billiards v. Thomas Aaron Billiards*, defense of trademark infringement action in the District of Maryland, successfully won on summary judgment.

### **ITC**

- OSRAM, as trial counsel, in suit involving eight LG patents concerning LED technology. The case settled favorably prior to initial determination. *In re Certain Light-Emitting Diodes and Products Containing Same*.
- Complainant against several semiconductor chip packaging companies. *In re Certain Semiconductor Chips With Minimized Chip Package Size and Products Containing Same*.
- Complainant against suppliers of Ground Fault Circuit Interrupter (GFCI) technology. *In re Certain Ground Fault Circuit Interrupters and Products Containing Same*.

### **PTAB**

- *Unwired Planet, LLC v. Square, Inc.* (Fed. Cir. 2016).
- IPR2016-00254, Petition for Inter Partes Review by J. Kyle Bass.
- *Unwired Planet, LLC v. Google, Inc.* (Fed. Cir. 2016).
- CBM2014-0015 and CBM2014-00160, Petition for Covered Business Method Patent Review by J.P. Morgan Chase & Co.
- IPR2014-01164 and IPR2014-01165, Petition for Inter Partes Review by Square Inc.

- IPR2014-01527, IPR2014-01528, IPR2014-01530, IPR2014-01531, IPR2014-01532, IPR2014-01533, and IPR2014-01534 Petition for Inter Partes Review by Amazon.com Inc.
- IPR2015-00239, IPR2015-00240, IPR2015-00241, IPR2015-00242, IPR2015-00243, and IPR2015-00247, Petition for Inter Partes Review by 2Wire Inc.
- IPR2015-00503, Petition for Inter Partes Review by Agila Specialties Inc.
- IPR2015-00520 and IPR2015-00521, Petition for Inter Partes Review by Unified Patents Inc.
- IPR2015-00715, Petition for Inter Partes Review by Dr. Reddy's.
- IPR2015-00643, IPR2015-00644, and IPR2015-00830, Petition for Inter Partes Review by Mylan Pharmaceuticals Inc.

## Areas of Focus

### Practices

- Intellectual Property
- Business Transactions
- Crypto Insolvency and Fiduciary Practice
- Digital and E-Commerce Engagement and Innovation
- Esports and Electronic Gaming
- Government Law & Consulting
- Intellectual Property Litigation
- Intellectual Property Protection & Portfolio Management
- Media, Entertainment, Music & Sports
- Pharmaceuticals and Medical Devices
- Technology
- Technology & Intellectual Property Transactions

### Industries

- Technology

## Insights

12.15.2020

Revived Prospects for Patenting Financial Product Inventions

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03.19.2020

7 Tips for Restaurants Switching to Takeout or Delivery-Only “Ghost Kitchens” During the Coronavirus Crisis

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02.08.2019

The Collapse of Covered Business Method Reviews

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02.08.2019

They Really Mean It This Time... Three Things to Know About Trump’s Second “Buy American” Executive Order

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11.03.2017

Custom Software Development: Practical Strategies to Get What You Pay For (Webinar)

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02.04.2017

What to Look out for in 2017

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05.04.2016

New Rules at PTAB

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07.06.2015

Don’t Slip Up at PTAB

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06.22.2015

PTAB Practice Rule Changes: The First Wave

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04.01.2015

Intellectual Property Licensing Strategies, 2015 Edition: Leading Lawyers on Analyzing Trends in IP Licensing and Drafting Effective Agreements

***Thomson Reuters***

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03.05.2015

Where Are All the PTAB-related Patent Litigation Stays?

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02.01.2015

Intellectual Property Law 2015: Top Lawyers on Trends and Key Strategies for the Upcoming Year

*Thomson Reuters*

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11.05.2014

Three Lessons Learned from Two Years at the US PTAB

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09.25.2014

PTAB Proceedings - The Most Stay-Friendly District Courts

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09.01.2014

The Patent Trial and Appeal Board Second Anniversary: Reflections and Strategies for the Years Ahead

*Intellectual Property & Technology Law Journal*

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08.01.2014

Liberty Mutual Achieves Total Knockout of Progressive Patents in Series of Post-Grant CBM Proceedings

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01.15.2014

Multiple Petitions Practice: Getting the Most Out of the New Post-Grant Proceedings Before the U.S. Patent and Trademark Office

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11.13.2013

Garmin International, Inc v Cuozzo Speed Technologies

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05.01.2013

Government Contracts Compliance: Leading Lawyers on Understanding Enforcement Trends and Updating Compliance Programs

*Thomson Reuters*

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02.21.2024

Carlton Fields New Practice Leaders Featured in Law360: “Carlton Fields Names New Leaders of 3 Practice Groups”

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02.20.2024

Carlton Fields Names New Practice Group Leaders

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02.09.2024

WTR 1000 Honors Carlton Fields as Top-Tier Trademark Firm for Fifth Consecutive Year

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04.18.2023

WTR 1000 Honors Carlton Fields as Top-Tier Trademark Firm for Fourth Consecutive Year

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11.18.2022

Editor's Notebook: COVID Relief Fraud is Spiking in Tampa Bay, and Other Readouts on Business Lawyers' Radar

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02.28.2022

Carlton Fields Attorneys Named 2022 “World’s Leading Trademark Professionals”

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02.15.2021

Ghost Kitchens Bring Vacant Locations Back to Life

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02.15.2021

Carlton Fields Attorneys Named 2021 “World’s Leading Trademark Professionals”

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08.05.2020

Carlton Fields’ Eleanor Yost Quoted in the Tampa Bay Business Journal on “Poaching” Lawsuits

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02.18.2020

Carlton Fields Attorneys Named 2020 “World’s Leading Trademark Professionals”

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10.10.2019

Carlton Fields Intellectual Property Attorney Eleanor M. Yost Named to Top 50 Women in PTAB Trials

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08.02.2019

Five Carlton Fields Lawyers Earn Board Certification From The Florida Bar

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07.09.2018

Super Lawyers Honors 81 Carlton Fields Attorneys on 2018 Florida “Super Lawyers” and “Rising Stars”

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03.27.2017

Distinguished IP Lawyer Eleanor M. Yost Joins Carlton Fields

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## Recognition

- Board Certified in Intellectual Property Law by The Florida Bar
- *The Best Lawyers in America*, Intellectual Property Litigation (2023–2024)
- *WTR 1000* (2022–2024)
- Top 50 Women in PTAB Trials, PTAB Bar Association (2019)
- *Washington, D.C., Rising Stars, Super Lawyers Magazine* (2014–2018)

## Professional & Community Involvement

- PTAB Bar Association
  - Co-Chair, Women’s Committee
  - Founding Director, Board of Directors
- Intellectual Property Owners Association
  - Vice Chair, Post-Grant Patent Office Practice Committee
  - Lead Author, IPO Response to USPTO Request for Comments on America Invents Act Post-Grant Proceedings
  - Committee of the Year Honoree (2018)
- Federal Circuit Bar Association
- International Trademark Association



# Speaking Engagements

- "Brexit & Beyond: The Top IP Issues," Hillsborough County Bar Association (February 4, 2021)
- "Intellectual Property and Employment Law Considerations for Online Learning," Carlton Fields (August 11, 2020)
- "Ethics Before the PTAB," PTAB Bar Association Annual Meeting, Washington, D.C. (March 2019)
- "Navigating the Interplay of Parallel Litigation With a PTAB Proceeding," PTAB Bar Association Annual Meeting, Washington, D.C. (March 22–23, 2018)
- "Advice of Counsel Defense in Patent Litigation: Protecting Attorney-Client Privilege," Webinar (March 16, 2017)
- "PTAB Bootcamp – Nuts and Bolts of IPRs, PGRs, and CBMs," PTAB Bar Association Inaugural Annual Meeting, Washington, D.C. (March 1–3, 2017)
- "Advanced Licensing Agreements," Program Faculty, Practising Law Institute
- "Patent Law," Program Faculty, Practising Law Institute
- "Interpreting What the Past 12 Months of CBM Challenges and IPR and PGR Proceedings Reveal About Party Successes and Failures Across Industries," IP Counsel Exchange on Post-Grant Patent Challenges at the PTAB, San Jose, CA (March 30–31, 2015)
- "Oyez, Oyez, Oyez! Analyzing the Impact of the Supreme Court's Decisions in *Alice Corp.* and *Nautilus* on AIA Post-Grant Proceedings," ACI's Inaugural Conference on Post-Grant PTO Proceedings, New York, NY (March 25–26, 2015)
- IP Strategy Summit: Enforcement, New York, NY (June 10, 2014)
- Licensing Executive Society's Life Sciences Sector Conference (2014)
- "Software Licensing Boot Camp: Drafting Contracts That Meet Current Business Needs While Avoiding Unwanted Outcomes," ACI Annual the Practical and Tactical Art of the Deal in Software Agreements – Cloud, SaaS, Open Source & Licensing
- "Patent Infringement: Structuring Opinions of Counsel: Leveraging Opinion Letters to Reduce the Risks of Liability and Enhanced Damages," Strafford Publications Inc.
- "Trademark Transactions: Doing Deals – From Due Diligence to Ink. An International Perspective," IPO Annual Meeting, Los Angeles, CA (September 11–13, 2011)

# Credentials

## Education

- St. John's University School of Law (J.D.)
- State University of New York at Stony Brook (B.A.)

## Court Admissions

- U.S. Court of Federal Claims
- U.S. Court of Appeals, Federal Circuit

## Bar Admissions

- District of Columbia
- Florida
- New Jersey
- New York
- U.S. Patent and Trademark Office

## Industry Specialization

### Certifications

- Intellectual Property Law

- U.S. Court of Appeals, Tenth Circuit
- U.S. Court of Appeals, Eleventh Circuit
- U.S. District Court, Middle District of Florida
- U.S. District Court, Northern District of Florida
- U.S. District Court, Southern District of Florida
- U.S. District Court, District of Columbia
- U.S. District Court, District of New Jersey
- U.S. District Court, Northern District of New York
- U.S. District Court, Western District of New York
- District of Columbia Courts

## Background

- Partner, Goodwin Procter LLP, Washington, D.C.
- Associate, Hiscock & Barclay LLP, Rochester, NY