

SCOTT E. YACKEY

PRINCIPAL / DALLAS METRO OFFICE

Scott's practice is focused on obtaining and enforcing intellectual property rights. As a former automotive engineer, he knows that *speed matters* to busy clients who appreciate his ability to quickly understand new technologies and competitive markets. Clients further value his practical engineering background and ability to ask the right questions to push the boundaries of their innovative ideas.

Scott leverages his experience in patent litigation and *Inter Partes* Reviews to draft and prosecute patent applications that anticipate and avoid potential litigation risks down the road. His knowledge of these best practices ensures that important IP assets are thoroughly vetted to maximize protection. In addition to handling patent prosecution and litigation efforts, Scott also provides clients with patentability and freedom to operate opinions.



PRACTICE AREAS

Patents; Trademarks & Service Marks; IP Litigation; PTAB Proceedings; International

INDUSTRIES

Automotive & Autonomous Vehicles; Consumer Products; Electrical, Computer & Internet; Energy Production & Delivery; Mechanical & Electromechanical; Medical Devices; Telecommunications & Wireless Technology



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KEY MATTERS

- Represented a client in an *Inter Partes* Review proceeding. The client, an advanced electronics manufacturer, was accused of infringing the patent for a GPS receiver with automotive applications. Efforts included developing noninfringement positions, invalidity opinions aimed at the patent owner, and working with technical experts to defend the client's position of noninfringement.
- Successfully defended clients in litigation proceedings against non-practicing entities in matters involving ecommerce technologies. Efforts included developing strategies for invalidity challenges.

- Drafting and prosecuting patents for medical companies, including technologies directed to medical devices, medical imaging and surgical navigation.
- Drafting and prosecuting patents directed to commercial refrigeration and ice maker technologies.
- Drafting and prosecuting patents directed to underground compressed natural gas storage tanks for a large energy company.
- Counseling clients on the strategic use of trademarks to protect growing brands, conducting trademark searches, and preparing and prosecuting trademark applications.

NEWS/EVENTS

EVENTS

“Trademark Update – Intellectual Property Law Section,” 2017 State Bar of Texas Annual Meeting, Dallas, Texas

PUBLICATIONS

- “Drawing the battle lines: Adidas’s mission to protect its three stripes,” World Intellectual Property Review, April 24, 2018
- “To the Front of the Line: Spurring Biotech Collaboration through Patent Fast-Track Examination Vouchers,” Saint Louis University Journal of Health Law and Policy, 2012

ARTICLES

- Scott Yackey Pens Article on the Importance of Naming Inventors

BLOGS

- Startup Golf Entertainment Center’s Antitrust Claims Whiff Three Times Against Topgolf; But Will it Re-Tee?

BACKGROUND

Prior to attending law school, Scott served as an engineer for a global Tier 1 automotive supplier in Michigan, where he used acoustic tuning methods to develop and improve exhaust systems and engine performance for light vehicle, commercial truck and off-highway equipment manufacturers.

While earning his mechanical engineering degree, Scott was part of Purdue’s Formula SAE team for which he helped design, build and race a small, Formula 1-style racecar. Scott focused primarily on the

exhaust systems and worked with several large companies to sponsor and donate materials to the team. In 2007, their car placed 4th out of 105 cars in the Formula SAE West competition.

When he is not in the office, Scott is playing in a local softball league, indulging his passion for landscape and architecture photography, or enjoying quality time with his wife and two young children.

AWARDS & DISTINCTIONS

- *Best Lawyers*, Patent Law, “Ones to Watch,” 2021-2022

Education

J.D., *magna cum laude*, Saint Louis University School of Law, 2012

B.S., Mechanical Engineering, Purdue University, 2007

Bar & Court Admissions

Missouri

Texas

Fifth Circuit Court of Appeals

United States District Courts:

- Eastern District of Missouri
- Eastern, Northern, and Western Districts of Texas

U.S. Patent and Trademark Office