

Daily Journal

MAY 22, 2024

TOP INTELLECTUAL PROPERTY LAWYERS



**John (Jay)
Neukom**

Debevoise & Plimpton LLP SAN FRANCISCO

When Jay Neukom joined Debevoise a little more than two years ago, the firm had no IP practice on the West Coast. Since then, the technology litigation practice he leads has grown “at a breakneck pace,” he said. Now, with about 10 lawyers in total, “we’ve got patent cases on the West Coast, on the East Coast, in some of the Midwest states.”

Debevoise has long had a thriving intellectual property practice in New York,

led by David H. Bernstein. “But that has traditionally been focused on what we in the business call the soft IP side, trademarks and trade dresses,” Neukom said. His West Coast side of the practice focuses on “hard IP litigation,” primarily patents and trademarks for technology, microchip, software, networking and security companies, he said. That practice “has really blossomed.”

“It’s easy for me to brag about this because it’s been a group effort of a pretty impressive collection of people,” he added.

In his own work, Neukom won a big victory from the Federal Circuit in August when it affirmed a Delaware judge’s decision invalidating more than 120 claims from seven data compression patents that were being asserted against his longtime client Fortinet. At the oral argument five months earlier, he was also arguing on behalf of nine other companies sued in the same case. *Realtime Data LLC v. Fortinet Inc.*, 2021-2251 (Fed. Cir., dec’d Aug. 2, 2023).

“To get an affirmance from the Federal Circuit on that broad of a swath of invalidation doesn’t happen every day,” Neukom said about the decision. “To get that many patent claims invalidated after them having been asserted against so

many defendants ... made it especially notable and gratifying.”

Also in August, it was publicly reported that Neukom secured a \$20 million payment in a JAMS arbitration for his client Advantest Corp., a Japanese semiconductor conglomerate. Defendant AEM Holdings Ltd. also agreed to make substantial changes to its contract with Advantest.

He is representing Fortinet in a multi-patent battle with direct competitor Forescout Technologies. Despite some mixed rulings, he defeated the attempt to invalidate his client’s patents. *Fortinet Inc. v. Forescout Technologies Inc.*, 3:20-cv-03343 (N.D. Cal., filed May 15, 2020).

Another regular client is GAF Materials, which makes shingles and other roofing products. He effectively defeated an ITC action by competitor Kirsch. Then, in March 2022, he convinced the PTAB to invalidate all the patents asserted against GAF. This past March, he defended that victory before the Federal Circuit, and early this month, the circuit affirmed. *Kirsch Research and Development LLC v. GAF Materials LLC*, 2022-2063 (Fed. Circ., dec’d May 2, 2024).

— DON DEBENEDICTIS