



Jay A. Yurkiw

partner

Jay litigates business disputes involving technology, intellectual property, financial services, and contract rights. He regularly advises clients on contract, covenant not to compete, false advertising, social media, trademark, trade secret and unfair competition issues and in corporate dissolution and post-acquisition disputes. He has litigated cases in federal and state courts and in arbitrations in multiple states.

Jay is the co-chair of the firm's E-Discovery Practice Group and regularly advises clients on the management and discovery of electronically stored information and computer forensic investigations. He regularly speaks and writes about technology and e-discovery issues.

Jay is listed in *Best Lawyers*® for Commercial Litigation and is peer-rated AV Preeminent by Martindale-Hubbell®. He is a past president of the Columbus Chapter of the Federal Bar Association.

Jay clerked for retired U.S. Magistrate Judge Mark R. Abel of the United States District Court for the Southern District of Ohio before joining the firm.

REPRESENTATIVE MATTERS

Brand Protection & Social Media

- Advise sports equipment manufacturer on comparative advertising claims
- Represented national footwear manufacturer in trademark infringement action against competitor
- Represented national lawn and garden manufacturer in false advertising action against competitor
- Represented national lawn and garden manufacturer in trade dress infringement action against competitor

CONTACT

jyurkiw@porterwright.com
614.227.2012
www.porterwright.com

41 South High Street
Suites 2800 - 3200
Columbus, OH 43215

SOCIAL MEDIA

Blogs

bankingandfinancelawreport.com
employerlawreport.com
fedseclaw.com
technologylawsource.com

EDUCATION

The Ohio State University College of Law, J.D., *with honors*, 1997

University of Notre Dame, B.A., *magna cum laude*, 1994

SERVICES

Litigation

- Arbitration and mediation
- Commercial litigation
- E-Discovery
- Health Care litigation
- Intellectual property litigation
- Non-competition and trade secrets litigation
- Financial services litigation
- Class actions, mass torts and MDLs

- Represented automobile manufacturer in action against former contractor who anonymously posted trade secret information on social media sites
- Defended online retailer in trademark infringement action
- Defended Internet search engine company in trademark infringement action involving keyword advertising
- Represented trademark owner in counterfeiting action that resulted in permanent injunction and money judgment
- Defended social media company in copyright infringement action
- Assisted in preparation of social media influencer agreement
- Assisted in preparation of terms of use and privacy policy for fitness app
- Negotiated transfer of domain names and electronic customer data for client in contract dispute with former technology services provider

Banking and Financial Services

- Represented bank and won in Ohio Supreme Court on UCC issue of first impression that resulted in denial of class certification in case involving trust indenture
- Obtained summary judgment for bank on claims arising from trust indenture
- Defended banks in multiple cases brought under the Telephone Consumer Protection Act, Fair Credit Reporting Act and Real Estate Settlement Procedures Act
- Defended banks in multiple cases arising under Articles 3 and 4 of the Uniform Commercial Code, including check cases involving embezzled funds and forged endorsements
- Obtained injunction for national bank in trade secret action against former employee
- Obtained injunctive relief for equity research firm in state court and FINRA proceedings against a group of former employees who formed a competing firm
- Defended national bank against breach of contract claims brought by former mutual fund wholesaler for fees allegedly owed
- Represented financial services technology provider in breach of contract action regarding telephone and Internet bill payment services
- Defended national bank and its employees in non-solicitation and trade secret action regarding asset management services
- Defended national bank in trade secret action regarding electronic payment processing services
- Obtained contempt ruling and permanent injunction on behalf of national bank against individuals attempting to use fraudulent companies to convert \$18 million in assets

SERVICES (CONTINUED)

Antitrust & Consumer Protection

Business Competition Advice & Litigation

- Competitive interference claims
- Non-competition and trade secret counseling and litigation

Privacy & Data Security

- Litigation
- Social media

Technology

- Enforcement, disputes and litigation
- Social media

Financial Institutions

- Secured lending, negotiable instruments and other Uniform Commercial Code matters
- Financial services litigation

Sports

Intellectual Property

- Advertising, false advertising, unfair competition and product claims

Health Care

- Litigation

- Representing bank in putative class action alleging violations of Ohio's mortgage satisfaction statute

Corporate Dissolution, Shareholder & Post-Acquisition Disputes

- Representing sellers in post-acquisition dispute involving scope of excluded liabilities
- Represented technology service provider in member dispute that resulted in dissolution of limited liability company and formation of new competing companies
- Represented health care professional in member dispute that resulted in negotiated buyout of an ownership interest in limited liability company
- Advised seller in post-acquisition dispute involving breach of warranty claims
- Represented majority shareholder in breach of fiduciary action brought by minority shareholder
- Defended health care company in breach of contract action and successfully argued against temporary restraining order that would have prohibited buy out of physician-owner
- Represented business broker in dispute with business partner over intellectual property ownership rights

Trade Secret & Covenants Not to Compete

- Defended software developer at trial in trade secret action brought by former employer
- Represented national insurance company in non-solicitation and trade secret action and obtained a preliminary injunction against a group of former employees who formed a competing firm
- Defended health care company in covenant not to compete and trade secret action and successfully argued against issuance of temporary restraining order and preliminary injunction
- Obtained temporary restraining order against former employee requiring the return of confidential business information that he threatened to disclose publicly
- Defended high level executive in trade secret and covenant not to compete action involving forensic investigations of Apple mobile devices and iCloud accounts
- Represented health care company in covenant not to compete dispute with two physicians formerly employed by surgery center
- Represented wireless telephone retailer in covenant not to compete action against former sales representatives and managers
- Represented scholastic memorabilia manufacturer in covenant not to compete action against former sales representative

Other Technology, Intellectual Property & Business Disputes

- Tried and won AAA arbitration on behalf of international consumer electronic company in multi-million dollar contract dispute with supplier
- Obtained dismissal of putative class action against national telemarketing company in federal court
- Argued and won Sixth Circuit appeal involving claims arising from biomedical research study after obtaining summary judgment in the trial court
- Tried and won AAA arbitration on behalf of automotive component supplier in sales contract dispute with sub-supplier
- Represented automotive component supplier in multi-million dollar sales contract dispute before the International Centre for Dispute Resolution
- Represented online retailer in dispute with software consultant over development of new e-commerce platform

- Obtained summary judgment for manufacturer of figurines and collectibles in copyright ownership action
- Defended trucking software companies in multi-district patent infringement litigation
- Represented national lawn and garden manufacturer in dispute with former contractor over patent rights

BAR ADMISSIONS

- Ohio
- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the Sixth Circuit
- U.S. District Court for the Northern District of Ohio
- U.S. District Court for the Southern District of Ohio
- Supreme Court of the United States

PRESENTATIONS

- “The Fundamentals of Blockchain – Smart Contracts, ICOs & What You Need to Know,” Central Ohio Association of Corporate Counsel, Jan. 15, 2019
- “Federal Civil Practice in the Southern District of Ohio,” Federal Practice Seminar, Federal Bar Association, May 25, 2017
- “Electronic Discovery & Evidence,” Ohio Association of Magistrates Spring Conference, May 11, 2017
- “Hot Issues in Internet Law, Including Online Reviews & Social Media,” Annual Ethics & Trends in Litigation Seminar, Porter Wright, Dec. 8, 2016
- “Hot Legal Topics with Online Consumer Reviews,” Central Ohio Association of Corporate Counsel, Jan. 21, 2016
- “E-Discovery and Cybersecurity: The 2015 Amendments to the Federal Rules of Civil Procedure and Ohio Rules of Professional Conduct,” Practicing Before the Southern District of Ohio Seminar, Ohio Center for Law-Related Education, Nov. 30, 2015
- “Updated FTC Enforcement Guides: A Roadmap for Staying out of Trouble,” Porter Wright Retailer Roundtable, Oct. 28, 2015
- “New Legal Developments Related to Promotions/Advertising and FTC Enforcement,” Porter Wright Technology Seminar Series, July 15, 2015
- “Protection of Intellectual Property Rights in Free Trade Agreements,” Columbus Chamber of the Federal Bar Association, April 3, 2015
- “Ohio Data Breach Law,” The Mid-Ohio Regional Planning Commission, Cyber Forum, March 3, 2015
- “Recent Developments and Trends in E-Discovery,” Central Ohio Association of Corporate Counsel, Jan. 27, 2015
- “IT Issues for Labor/Employment Lawyers,” Ohio Management Lawyers Association, Nov. 14, 2014
- “E-Discovery Case Law Update,” International Legal Technology Association Statewide Meeting, Nov. 7, 2014
- “What the Dot? Protecting Your IP Rights in a Digital Society,” Porter Wright Technology Seminar Series, July 16, 2014
- “Social Media in Litigation: A Shield and a Sword,” Porter Wright Technology Seminar Series, June 18, 2014

- “Ohio Intellectual Property Litigation,” Ohio State Bar Association Seminar on Advising Corporate Directors and Officers, May 16, 2014
- “Recent Developments & Trends in E-Discovery,” Central Ohio Association of Corporate Counsel, Jan. 30, 2014
- “Protecting Against the Legal Risks of Social Media,” Porter Wright Annual Ethics & Trends in Litigation Seminar, Dec. 4, 2013
- “Preserving the Attorney-Client Privilege,” Proctor & Gamble, Sept. 26, 2013
- “Navigating the Cloud,” Columbus Bar Association Seminar on Data Privacy, Security and the Cloud, Sept. 20, 2013
- “Social Media and the Law,” Social Media Summer Camp, *Columbus Business First*, Aug. 13, 2013
- “Cloud Computing and Outsourcing in the U.S. and Across Borders,” Porter Wright Seminar Technology Seminar Series, July 17, 2013
- “Current Best Practices in E-Discovery,” Central Ohio Association of Corporate Counsel Panel Discussion, Jan. 31, 2013
- “E-Discovery: Legal Tech and Case Law Updates,” Central Ohio Association of Corporate Counsel,” Feb. 28, 2012

PUBLICATIONS

- “Arbitrator did not exceed his powers by awarding perpetual license in all intellectual property rights for video game,” *The Licensing Journal*, Vol. 33, No. 8, September 2013
- “Don’t forget about social media when preserving information for discovery,” Central Ohio Chapter of Association of Corporate Counsel Newsletter, 2nd Quarter 2013
- “Don’t forget about social media when preserving information for discovery,” *E-Commerce Law Reports Journal*, April 2013

PROFESSIONAL ASSOCIATIONS

- Federal Bar Association, Columbus Chapter, past President
- Columbus Bar Foundation, Fellow
- International Legal Technology Association (ILTA)
- Ohio State Bar Foundation, Fellow, Class of 2012

HONORS | AWARDS

- *Best Lawyers*®, Commercial Litigation
- Martindale-Hubbell®, AV Preeminent

COMMUNITY

- Pelotonia, Porter Wright Team Captain, 2014-2019
- Ohioana Library Association, Board Member
- Salesian Boys and Girls Club of Columbus, former Board Member St. Francis of Assisi Parish, former Parish Council Member
- Leadership Columbus, Class of 2005
- United Way of Central Ohio, Porter Wright Campaign, Co-Chair, 2003
- Columbus Bar Association, Barrister Leader Program, 2001-2002