



Joseph S. Grinstein Partner

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Overview

I am a trial lawyer who has handled cases in every corner of the country – from San Francisco to San Juan. I combine a passion for getting on my feet before judges and juries with the work ethic necessary to master the facts and the law before “showtime.”

Much of my practice focuses on high-tech litigation. I have extensive experience handling patent, trade secret, and tech-related antitrust cases, and I have had the privilege of representing clients in some of the nation’s highest profile intellectual-property disputes – from battles over self-driving cars to mediaprocessors to broadband satellites. Whether high-tech or not, however, I have litigated a broad range of high-stake cases:

- There are very few lawyers who have tried a [patent case to verdict](#) and also argued an [ERISA appeal](#). I’ve done them both – more than once.
- I’ve successfully opposed confirmation of a [billion-dollar bankruptcy plan](#) . . . and I’ve scored a verdict of more than [\\$30 million under California trade secrets law](#).
- I have spoken at several [ABA events about antitrust issues](#) . . . and I have persuaded the Eleventh Circuit to [uphold the certification of a civil-rights class action](#).
- In one Native American gaming case I won a judgment after trial of \$9 million for my client, and in another such case I secured for my client a summary judgment win on a \$300 million claim against it – and then I successfully defended [both](#) those results [on appeal](#).
- I work hard on *pro bono* cases, especially in the area of criminal justice. I have worked to eliminate cash bail for certain [misdemeanor](#) and [felony](#) arrestees in Harris County, I have fought for compensation from the State of Texas for an [exonerated](#) death-row inmate, and I have represented a class seeking to end Austin’s [debtor’s prison](#) for people who cannot afford to pay their traffic tickets.
- And, for fun, I do [tax](#).



Sketch of me at the *Waymo v. Uber* trial by courtroom artist Vicki Behringer.

My strong academic background has armed me to handle such a diverse caseload. I graduated from Rice University in 1994 with three majors, conferred *summa cum laude*. I then received my law degree from Yale Law School, where I was Managing Editor of the *Yale Law Journal* and I won the school's mock trial competition. After law school, I clerked on the Fifth Circuit for the Hon. Patrick E. Higginbotham.

I'm fortunate to have received the kind of accolades that come with a high-profile law practice. I have been named "Litigator of the Week" by *The Texas Lawyer* (Sept. 2013) and a "Super Lawyer" (2013, 2014, 2015, 2016, 2017, 2018, and 2019) and "Rising Star" (2004, 2005, 2006, 2007, 2008, 2009, and 2011) by Thomson Reuters/*Texas Monthly*. I was named one of *Lawdragon's* Leading Plaintiff Financial Lawyers in 2019, and *IAM 1000* deemed me one of the "World's Leading Patent Professionals" in 2017 and 2020. *Benchmark Litigation Report* (published by Legal Media Group) recognized me in 2011, 2013, 2015, 2016, and 2017 as a "future star" in Texas. It also labeled me a "future star" in 2010, and commented that I was viewed as a "prominent complex commercial litigator." Likewise, in 2009 it noted that I had "receive[d] praise for an array of intellectual property matters." *H Texas Magazine* (published by Bayou City Publishing LL) named me a "Top Lawyer" in 2008, 2009, 2010, and 2013; a "Top Lawyer for the People" in 2009, and a "Professional on the Fast Track" in 2004 and 2005. I was recognized in the *International Who's Who of Competition Lawyers & Economists* (published by Law Business Research Ltd) in 2014, and I also was named an "IP Star" by *Managing Intellectual Property* in 2015, 2017, 2019, and 2020 (published by Euromoney Legal Media Group). And, perhaps most impressive of all, I am responsible for one of the "[Nine Most Ridiculous Moments](#)" from the high-profile *Waymo v. Uber* trial.

When not practicing law, I have volunteered regularly at Rice University, where I served as Chair of the Rice Annual Fund, co-chair of Rice's Centennial Gala, the alumni representative on the University Committee on Teaching, and co-chair for my class's 25th Reunion. I am also an amateur – *i.e.*, unsuccessful – screenwriter. Nevertheless, I have won recognition in numerous screenplay competitions, including the Atlanta Film Festival, the Austin Comedy Short Film Festival, the Georgia Shorts Film Festival, the Harlem International Film Festival, the Houston Comedy Film Festival, the Marfa International Film Festival, the New York Screenplay Contest, and the WorldFest-Houston International Film and Video Festival.

Education

- Rice University (B.A., Summa Cum Laude, 1994)
- Yale Law School (J.D., 1997)

Clerkship

Hon. Patrick E. Higginbotham of the United States Court of Appeals for the Fifth Circuit.

Honors and Distinctions

- Managing Editor, Yale Law Journal (1996-97)
- President-elect (2021-22 term) of The Honorable Nancy F. Atlas Intellectual Property American Inn of Court
- Chair, Houston Bar Association Antitrust & Trade Regulation Section (2006-07)
- Named "Litigator of the Week" by *The Texas Lawyer* (Sept. 2013) and a "Super Lawyer" (2013, 2014, 2015, 2016, 2017, 2018, and 2019) and "Rising Star" (2004, 2005, 2006, 2007, 2008, 2009, and 2011) by Thomson Reuters/*Texas Monthly*. Named one of *Lawdragon's* Leading Plaintiff Financial Lawyers in 2019, and deemed by *IAM 1000* one of the "World's Leading Patent Professionals" in 2017 and 2020. Recognized by *Benchmark Litigation Report* (published by Legal Media Group) in 2011, 2013, 2015, 2016, and 2017 as a "future star" in Texas. Named by *H Texas Magazine* (published by Bayou City Publishing LL) a "Top Lawyer" in 2008, 2009, 2010, and 2013; a "Top Lawyer for the People" in 2009, and a "Professional on the Fast Track" in 2004 and 2005. Recognized in the *International Who's Who of Competition Lawyers & Economists* (published by Law Business Research Ltd) in 2014, and named an "IP Star" by *Managing Intellectual Property* in 2015, 2017, 2019, and 2020 (published by Euromoney Legal Media Group).

Articles and Speeches

- "Antitrust and Standard Setting", Eastern District of Texas/Federal Circuit Bench Bar Conference (September 26, 2011)
- "Litigating and Trying Complex Civil Antitrust Class Actions: Jury Instructions," American Bar Association Section of Antitrust Law Brown-Bag Tele-seminar (July 22, 2009)
- "E-Discovery and In re Weekley Homes," Harris County Civil Judiciary's 2009 Summer Continuing Judicial Education Seminar (August 4, 2009)
- "Exclusive Dealing, Loyalty Programs, and Bundling: The Plaintiff's Perspective," 2007 American Bar Association Antitrust Section Spring Meeting

- “The Front Lines: Prudent Business Decision-Making in Light of the New Realities of Distribution,” 2006 Conference Board Antitrust Conference
- “Evaluating the Competitive Effects of Exclusive Dealing Agreements: The Plaintiffs’ Perspective,” American Bar Association Tele-seminar (June 24, 2005) (reprinted in *The Antitrust Source* (November 2005))
- “The Mythology of Aggregate Corporate Knowledge: A Deconstruction,” 65 *Geo. Wash. L. Rev.* 210 (1997) (with Thomas A. Hagemann)
- Note, “Jihad and the Constitution: The First Amendment Implications of Combating Religiously Motivated Terrorism,” 105 *Yale L.J.* 1347 (1996)

Wins

- In February 2018, Grinstein represented Uber in one of the most prominent intellectual-property trials in years, *Waymo v. Uber*. The case involved allegations that Uber had misappropriated Waymo trade secrets and infringed Waymo patents relating to self-driving car technology. The lawsuit attracted attention around the world, and the trial was covered by an army of journalists and tech bloggers. The case settled during the first week of trial, in the middle of Grinstein’s cross-examination of Waymo’s lead technical witness.
- In August 2017, Grinstein represented Personalized Media Communications (PMC) in an arbitration to resolve its long-running licensing dispute with TiVo, formerly known as Gemstar-TV Guide International and Rovi Guides. TiVo had contended that, under its licensing agreement with PMC, it had the exclusive right to enforce infringement actions for functionality not performed by the program guide, but rather performed by digital set-top-boxes, such as the delivery of digital programming content. In November 2017, the arbitrator (retired U.S. District Court Judge David Folsom) rejected TiVo’s interpretation and found in favor of PMC on all issues. Thereafter, on November 22, 2017, Judge Roy Payne of the United States District Court for the Eastern District of Texas entered Final Judgment in favor of PMC.
- In February 2016, a team of Susman Godfrey lawyers including Grinstein tried a case in federal district court in San Juan, Puerto Rico on behalf of the nation’s largest retailer, regarding the constitutionality of certain provisions of Puerto Rico’s Alternative Minimum Tax. Grinstein was involved in all aspects of the case, including examining both sides’ constitutional and tax experts at trial. In March 2016, the district court issued its opinion, declaring the challenged AMT provisions to violate the dormant commerce and equal protection clauses of the U.S. Constitution, in addition to the Federal Relations Act. The district court then enjoined further enforcement of these AMT provisions. There is a significant jurisdictional hurdle to challenging state (or commonwealth) taxes in federal court, so this ruling was a rare instance in which such a tax has been held unconstitutional by a federal district judge.

Puerto Rico then appealed the district court’s ruling. In June 2016, Grinstein argued the appeal to the United States Court of Appeals for the First Circuit. In August 2016, the First Circuit upheld the injunction and affirmed the district court in full. To hear the audio of Grinstein’s oral argument, click [here](#) (starting at 21:55).

- In June 2015, Grinstein – along with a team of lawyers from Susman Godfrey and co-counsel – obtained a \$31.5 million jury verdict on behalf of his client, DataQuill Ltd., in a patent case tried in federal court in the Eastern District of Texas. DataQuill alleged that Defendant ZTE (USA) Inc. infringed two DataQuill patents relating to smartphone technologies. Among other things, Grinstein argued for DataQuill at

the *Markman* hearing, and at trial he handled both sides' damages witnesses and presented DataQuill's inventor. After receiving the case, the jury took less than 45 minutes to render its verdict in favor of DataQuill. Final judgment on the verdict has not yet been entered.

- In May 2012, Grinstein – along with a team of lawyers from Susman Godfrey and co-counsel Heim, Payne & Chorush – obtained a \$15.4 million verdict on behalf of his client, PACT XPP Technologies, AG, in federal court in Marshall, Texas. PACT alleged that Xilinx, Inc. and Avnet, Inc. had infringed two of PACT's patents via their sale of certain Xilinx-branded Field Programmable Gate Array (FPGA) devices. The jury found that both PACT patents were infringed and valid, and it further determined Xilinx's infringement to be willful. Grinstein was first chair at trial, handling PACT's opening statement and closing argument, as well as presenting or cross-examining several key witnesses.

In September 2013, the District Court entered judgment on the verdict. After enhancing the jury's verdict and awarding attorney's fees on account of the willfulness finding as well as adding costs and interest, the judgment in PACT's favor totaled approximately \$44 million. The case settled for a confidential amount while on appeal.

In recognition of Grinstein's accomplishments on the case, the September 16, 2013, edition of *The Texas Lawyer* named him "Litigator of the Week" and printed a story in which he was quoted and pictured.

- In 2008 and 2009, Grinstein represented a group of more than forty health plans (who between them comprise more than 70% of the U.S. market for private health insurance) asserting healthcare reimbursement liens against claimants to the \$4.85 billion Vioxx compensation fund. Grinstein handled all arguments for the health plans before the District Court and later the Fifth Circuit. In January 2009, Grinstein's clients reached a groundbreaking settlement with the Vioxx Plaintiffs' Steering Committee, guaranteeing them certain payouts on their liens covering participating plaintiffs. *The American Lawyer* magazine featured this settlement and mentioned Grinstein in the "Big Suits" column of its April 2009 issue.
- In February 2008, Grinstein scored two appellate wins for the same client, Nevada Gold & Casinos, in the space of just two weeks. First, following Grinstein's November 2007 appellate argument, the Texas Court of Appeals (First District) on February 7, 2008, affirmed the \$8.3 million verdict that Grinstein and one other Susman Godfrey lawyer had obtained for Nevada Gold against American Heritage in April 2006. In an unrelated case for the same client, Grinstein and a team of Susman Godfrey lawyers obtained in January 2007 summary judgment against Rinaldo Corporation's tortious interference claims against Nevada Gold, in which Rinaldo was seeking more than \$300 million. Grinstein argued the Rinaldo appeal on February 11, 2008, and, on February 15, 2008, the California Court of Appeals (Fifth District) affirmed the summary judgment order, absolving Nevada Gold of all alleged liability.
- In September 2007, Grinstein and a team of Susman Godfrey lawyers obtained a \$30.5 million jury verdict on behalf of his client, UniRAM Technology, Inc., in a trade secrets case tried in federal court in San Francisco. After interest and costs, the trial court later entered judgment in favor of UniRAM for approximately \$36 million. UniRAM alleged that defendant Taiwan Semiconductor Manufacturing Corp. (TSMC) had misappropriated UniRAM's trade secrets regarding specialized computer memory devices known as embedded DRAM. Among other things, Grinstein handled both sides' damages witnesses at trial, and he cross-examined TSMC's principal technical expert. News of the verdict was reported widely in both the U.S. and Taiwan. *Verdict Search* listed the verdict as one of the top 100 plaintiff's verdicts nationally in 2007, and the *Los Angeles Daily Journal* pegged it as one of the top 10 plaintiff's verdicts in California in 2007. The case settled on confidential terms while on appeal.

- In April 2006, Grinstein and one other Susman Godfrey lawyer represented Nevada Gold & Casinos in a breach-of-contract trial relating to the development of a Native American casino in New Mexico. Following a three-week trial in Houston, the jury returned a verdict awarding Nevada Gold essentially all of the damages it claimed. In October 2006, after extensive post-trial briefing, the trial court entered judgment in favor of Nevada Gold and against the defendant, American Heritage, Inc., for over \$9 million.
- In 2004 and 2005, Grinstein and a team of Susman Godfrey lawyers represented MicroUnity Systems Engineering, Inc. in its patent infringement lawsuit against Intel, Corporation and Dell, Inc. MicroUnity alleged that Intel's Pentium III, Pentium 4, and Pentium M processors, and Dell's use of those processors, infringed several MicroUnity patents covering "mediaprocessor" technology. Grinstein was involved in all aspects of the case, including arguing the Markman hearing. In October 2005, one month before trial was to commence, the parties reached a confidential settlement of the case, the financial terms of which Intel disclosed in its Third Quarter 2005 10-Q. Articles discussing the importance of the case and the magnitude of the settlement appeared in the New York Times, the Wall Street Journal, the San Francisco Chronicle, the San Jose Mercury News, and various high-tech websites.
- In 2003 and 2004, Grinstein and several additional Susman Godfrey lawyers tried two bankruptcy plan confirmation hearings — In re The Babcock & Wilcox Company (three weeks of trial time) and In re Pittsburgh Corning Corporation (one week of trial time) — representing the interests of Certain Underwriters at Lloyd's, London and Certain London Market Companies. Grinstein's clients settled the Babcock & Wilcox dispute, while Pittsburgh Corning eventually withdrew the bankruptcy plan to which his clients objected.
- In 2003, Grinstein won an appeal he briefed and argued to the United States Court of Appeals for the Fifth Circuit regarding the scope of ERISA plans' subrogation and reimbursement rights. The Fifth Circuit's opinion was the subject of a front-page article in the December 29, 2003, issue of The Texas Lawyer, in which Grinstein was quoted and pictured.
- In 2003, Grinstein tried with one additional Susman Godfrey lawyer an arbitration involving claims against Service Corporation International under the Texas Securities Act. Grinstein's clients, James P. Hunter, III, and the James P. Hunter, III, Family Partnership Limited, won the arbitration and were awarded \$27.8 million by the panel of arbitrators.
- In 2002, Grinstein tried with two additional Susman Godfrey lawyers an arbitration claim brought by his client, Lyondell Chemical Co., against Atlantic Richfield Company (ARCO), involving the sale of MTBE. The arbitrator granted most of Lyondell's claims against ARCO, and as a result ARCO agreed to pay Grinstein's client an eight-figure net settlement.
- In 2001, Grinstein obtained class certification from the Middle District of Florida for a class of African-American employees of Western Auto Supply Co. (now owned by Advance Stores Company, Inc.) who were suing the former auto parts retailer for racial discrimination. The defendants immediately appealed the certification decision to the United States Court of Appeals for the Eleventh Circuit. Grinstein briefed and argued the appeal, and the Eleventh Circuit affirmed the class certification decision — the first such class action the Eleventh Circuit had upheld in decades. The case settled in 2003, with the defendants making a substantial payment to the class.

Professional Associations and Memberships

American Bar Association, Texas state bar, and the Houston Bar Association.

