

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 media processors 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. In 2023 alone, I won more than \$200 million in patent jury verdicts – including a \$166.3 million result for my client, Finesse Wireless, against AT&T and Nokia, and a \$37.5 million verdict for my client, Atlas Global Technologies, against TP-Link..
- 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.

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- 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.

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.

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

I'm fortunate to have received the kind of accolades that come with a high-profile law practice. In 2023 *National Law Journal* named me among their Intellectual Property Trailblazers (ALM). *National Law Journal* also profiled me as the representative of the firm when they honored Susman Godfrey with the Technology Litigation 'Elite Trial Lawyers award' in 2023. I was named among the country's "Top 500 Leading Litigators" by *Lawdragon* in 2022 and 2023 and have been included on their Top 500 Leading Plaintiff Financial Lawyers list since 2019. I have been named "Litigator of the Week" by *Texas Lawyer* (2013, ALM) and a "Super Lawyer" (2013 – 2023) and "Rising Star" (2004, 2005, 2006, 2007, 2008, 2009, and 2011) by Thomson Reuters/*Texas Monthly*. *IAM 1000* deemed me one of the "World's Leading Patent Professionals" in 2017, 2020, and 2023. *Benchmark Litigation Report* (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 (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* (Law Business Research Ltd) in 2014, and I also was named an "IP Star" by *Managing Intellectual Property* in 2015, 2017, 2019, and 2020 (Euromoney). 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.

Notable Representations

Representative Matters

- ***Atlas Global Technologies LLC v. TP-Link Technologies Co., Ltd. et al (E.D. Tex.)*** Won a \$37.5 million verdict for Atlas Global Technologies in its patent infringement case against Chinese telecom equipment manufacturer TP-Link. A Texas jury issued the verdict against TP-Link for infringing five patents for wireless routers that meet an industry standard known as “WiFi 6,” which was developed to provide fast, efficient internet connections for high-density locations such as offices, shopping malls and apartment buildings. Following a five-day trial and just a few hours of deliberations, the jury determined TP-Link owes Atlas \$37,481,264 in damages. [Read more.](#)
- ***Finesse Wireless LLC v. AT&T Mobility LLC and Nokia of America Corporation (E.D. Tex.)*** Serving as lead counsel, won a \$166.3 million jury verdict on behalf of client Finesse Wireless LLC on January 13, 2023, against AT&T Mobility LLC and Nokia Corporation of America over patent infringement claims relating to wireless networks. The jury delivered the verdict after three hours of deliberation following a week-long trial in the Eastern District of Texas. This win was reported by media outlets including [Reuters](#), [Nasdaq](#), [Yahoo Finance](#), [Bloomberg](#), [Telecom Paper](#), [Law360](#), and [Texas Lawbook](#). [Read more.](#)
- ***In Re Alfred Dewayne Brown (Texas Supreme Court)*** Secured a major pro bono victory for client Alfred Dewayne Brown. In 2005, Alfred Dewayne Brown was convicted of murder and sentenced to death. Brown’s alibi turned on a telephone call he had made from another place at the time of the murders, which proved he could not have been involved. The recipient of the telephone call confirmed Brown’s alibi. Prosecutors subpoenaed the telephone records, which confirmed Brown’s alibi, then hid the records rather than turning them over to Brown’s lawyers as required by *Brady v. Maryland*. In addition, the district attorney had Brown’s alibi witness jailed until she agreed to abandon the alibi and “cooperate” with Brown’s prosecutors. Brown spent more than twelve years in prison, nine of them on Death Row, before his habeas petition was granted, his conviction reversed, and all charges against him were dismissed. For more than five years, Grinstein represented Brown in his efforts to win compensation from the state of Texas for his wrongful incarceration, which required a finding of “actual innocence.” In 2019, a special prosecutor concluded that Brown was actually innocent. The

Harris County District Attorney agreed, and a state district judge deemed Brown to be actually innocent in an amended dismissal of his case. That should have ended the issue, but the State Comptroller and the Texas Attorney General continued to oppose compensation for Brown. Grinstein litigated the issue to the Texas Supreme Court, which in December 2020 unanimously ruled that Brown was entitled to compensation. Brown received close to \$2 million in compensation from Texas. The landmark decision will make it easier for future exonerees to recover compensation for their wrongful imprisonment.

- ***Waymo LLC v. Uber Technologies Inc. (N.D. Cal.)*** Represented Uber in one of the most prominent intellectual-property trials in years. 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.
- ***Personalized Media Communications v. TiVo (E.D. Tex.)*** 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. The arbitrator (retired U.S. District Court Judge David Folsom) rejected TiVo's interpretation and found in favor of PMC on all issues. Thereafter, Judge Roy Payne entered Final Judgment in favor of PMC. [Read more.](#)
- ***Walmart Puerto Rico Inc. v. Zaragoza-Gomez (First Circ.)*** 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. When the district court issued its opinion, it declared 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. Grinstein argued the appeal to the U.S. Court of Appeals for the First Circuit. 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). [Read more](#) (subscription required).

- ***DataQuill Ltd. v. ZTE USA Inc (E.D. Tex.)*** Won a \$31.5 million jury verdict on behalf of his client, DataQuill Ltd., in a patent case over allegations that 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. [Read more.](#)
- ***PACT Technologies XPP, AG v. Xilinx, Inc. et al (E.D. Tex.)*** Obtained a \$15.4 million verdict on behalf of PACT XPP Technologies, AG, in federal court in Marshall, Texas over allegations 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. 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, *Texas Lawyer* named him "Litigator of the Week" and printed a story in which he was quoted and pictured. [Read more.](#)
- ***AvMed Inc. et al. v. BrownGreer, US Bancorp, and John Does (E.D. Louisiana)*** 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. Grinstein's clients reached a groundbreaking settlement with the Vioxx Plaintiffs' Steering Committee, guaranteeing them certain payouts on their liens covering participating plaintiffs. *American Lawyer* featured this settlement and mentioned Grinstein in the "Big Suits" column of its April 2009 issue.
- **Litigation on Behalf of Nevada Gold & Casinos.** Secured several major wins for Nevada Gold and Casinos:
 - Following Grinstein's appellate argument, the Texas Court of Appeals (First District) affirmed the \$8.3 million verdict that Grinstein obtained for Nevada Gold against American Heritage.
 - Grinstein obtained summary judgment against Rinaldo Corporation's tortious interference claims against Nevada Gold, in which Rinaldo was seeking more than \$300 million. Four days after Grinstein argued the Rinaldo appeal the California Court of Appeals (Fifth District) affirmed the summary judgment order, absolving Nevada Gold of all alleged liability.
 - Represented Nevada Gold & Casinos in a breach-of-contract trial relating to the development of a Native American casino in New

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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

- **UniRAM Technology v. TMS (N.D. Cal.)** Obtained a \$30.5 million jury verdict (\$36 million after interest and expenses) on behalf of UniRAM Technology, Inc. in a trade secrets case. UniRAM alleged that defendant Taiwan Semiconductor Manufacturing Corp. (TSMC) had misappropriated UniRAM's trade secrets regarding specialized computer memory devices known as embedded DRAM. The case was identified as one of the "Top 10 Plaintiff's Verdicts" that year in California. The case settled on confidential terms while on appeal. 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 that, and the *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.
- **MicroUnity v. Intel (E.D. Tex.)** 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*, *Wall Street Journal*, *San Francisco Chronicle*, *San Jose Mercury News*, and various high-tech websites.
- **In re The Babcock & Wilcox Company** and **In re Pittsburgh Corning Corporation**. 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.
- **Bombardier Aerospace Employee Welfare Benefits Plan, v. Ferrer, Poirot And Wansbrough (Fifth Circ.)** Won an appeal he briefed and argued 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 *Texas Lawyer*, in which Grinstein was quoted and pictured.

- ***Hunter v. Service Corporation International.*** Tried 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.
- ***Lyondell Chemical Company v. Atlantic Richfield Company.*** Won an arbitration on behalf of Lyondell Chemical Company against Atlantic Richfield Company relating to the breach of a long-term agreement to supply MTBE.
- ***Drayton v. Western Auto (M.D. Florida)*** Obtained class certification for a class of Black 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. After Susman Godfrey briefed and argued the appeal, and the Eleventh Circuit affirmed the class certification—the first such class action the court had upheld in decades—the case settled with the defendants making a substantial payment to the class.

Honors & Distinctions

- Firm Representative for Elite Trial Lawyers – Technology Litigation, *National Law Journal* (2023, ALM)
- One of the “World’s Leading Patent Professionals,” IAM, (2017, 202, 2023)
- Intellectual Property Trailblazer, *National Law Journal* (2023, ALM)
- *Lawdragon*500 Leading Litigator (2022, 2023)
- *Lawdragon* 500 Leading Plaintiff Financial Lawyers in 2019, 2020, 2021, 2022, 2023
- Recommended Lawyer, *Benchmark Litigation* (2011, 2013, 2015 – 2017, 2022, 2023 (Euromoney)
- Super Lawyer, *Texas Super Lawyer*(2013 – 2023, Thomson Reuters)
- President (2021-22 term), The Honorable Nancy F. Atlas Intellectual Property American Inn of Court
- IP Star, *Managing Intellectual Property*(2015, 2017, 2019, and 2020, Euromoney)
- *International Who’s Who of Competition Lawyers & Economists*(2014, Law Business Research Ltd.)
- Litigator of the Week, *Texas Lawyer* (Sept. 2013, ALM)
- Rising Star, *Texas Super Lawyer*(2004 – 2009, 2011, Thomson Reuters)
- Top Lawyer, *H Texas Magazine*(2008 – 2010, 2013, Bayou City Publishing)

SUSMAN GODFREY

- Top Lawyer for the People, *H Texas Magazine* (2009, Bayou City Publishing)
- Professional on the Fast Track, *H Texas Magazine* (2004, 2005, Bayou City Publishing)
- Chair, Houston Bar Association Antitrust & Trade Regulation Section (2006-07)
- Managing Editor, *Yale Law Journal* (1996-97)

Clerkships

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

Education

Yale Law School (J.D.,)

Rice University (B.A., summa cum laude)

Admissions

Bar Admissions

- Texas

Wins

Susman Godfrey Wins \$166.3 Million Jury Verdict Against AT&T and Nokia in Patent Litigation

Susman Godfrey Secures Victory in Texas Supreme Court for Wrongfully Incarcerated Pro Bono Client

Susman Godfrey Wins Long-Running Licensing Dispute with TiVo

Susman Godfrey Client DataQuill Ltd Wins \$31.5 Million Verdict in Technology IP Case

Susman Godfrey Wins \$15.4 Million Verdict In Patent Infringement Suit Against Xilinx and Avnet

Susman Godfrey Secures \$37.5 Million Verdict in Wi-Fi Patent Infringement Case

Leadership & Professional Memberships

- American Bar Association
- Houston Bar Association
- Nancy F. Atlas Intellectual Property American Inn of Court