

Eric S. Tautfest

Partner

Chair of the Intellectual Property Department, Eric Tautfest is a skilled patent litigator and trial lawyer who focuses on developing practical and creative patent monetization strategies and implementing aggressive enforcement litigation and licensing programs throughout the entire patent life cycle. He has successfully prosecuted and defended patent infringement claims before federal courts across the country involving diverse technologies, including wireless telecommunications, software, fiber optics, computer displays, image compression plus many more.

Earlier in his career, Eric worked exclusively on the plaintiff's side of patent infringement litigation with a strong incentive to resolve cases both quickly, favorably and efficiently. He carries this mindset to the defense side of his practice as well, doing whatever it takes each day to push cases forward and achieve his clients' goals in the most economical way possible. Based on his reputation for reaching timely and resourceful resolutions, clients have called on Eric to serve as settlement counsel in numerous patent infringement cases.

Before joining the firm, Eric held an in-house position that gave him a better understanding of the industry from his clients' perspective and hands-on experience resolving the challenges businesses face while protecting their technologies. This background has made a big impact on Eric's approach to litigation. In each case, Eric not only focuses on understanding the business needs of his client, but also those of the decision makers on the other side. Once he has a solid grasp of the competing interests involved, Eric can explore creative ways to satisfy the concerns of opposing parties that may stand in the way of reaching the best outcome for his clients.

Experience

- Negotiated the funding, purchase and documentation of four large patent portfolios from three major multi-national electronics



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Practices
Intellectual Property

Education
J.D., Southern Methodist University
Dedman School of Law (2000)
B.A., Political Science, Minor in Korean
Studies, Brigham Young University
(1996)

Bar Admissions
Texas

Court Admissions
United States Supreme Court
United States Court of Appeals, Federal
Circuit
United States Court of Appeals, Fifth
Circuit
United States District Court, Eastern
District of Texas

companies.

- Represented a mobile telecommunications innovator in litigation and in connection with the sale of its patent portfolio for \$160 million.
- Founding member of the company that financially backed two patent litigations, each resulting in several hundred million dollar judgments in favor of the financed party.
- Sale of acquired patents to a major U.S. semiconductor company for better than eight times return to investors within six weeks of acquisition.
- As settlement counsel, negotiated and closed multi-party litigation settlement and patent portfolio license on behalf of licensor software company.
- Represented multi-national electronic payment services company as settlement counsel in multiple concurrently pending multi-party patent infringement litigations, resulting in all defendants settling. Personally negotiated all settlement and patent license agreements.
- Represented U.S. photographic technology company in multiple multi-party patent infringement litigations as settlement counsel, resulting in all defendants settling. Personally negotiated all settlement and patent license agreements. First-chaired litigation teams in four concurrently pending suits.
- Represented computer networking and software company as settlement counsel in multi-party patent infringement litigation, resulting in all defendants settling. Personally negotiated all settlement and patent license agreements.
- Represented U.S. based VoIP telecommunications company in patent infringement litigation and trial against multiple competitors, with trial resulting in settlement of the three remaining defendants settling at

United States District Court, Northern District of Texas
United States District Court, Southern District of Texas
United States District Court, Western District of Texas

Languages

Korean - Fluent

the close of our presentation of evidence.

- Represented major U.S. based multi-national oil services company in patent infringement litigation and trial against main competitor, with trial resulting in judgment for willful infringement of three patents. Received the third largest patent judgment that year.
- Represented auto finance company against major automobile insurance company in trademark infringement suit, which resulted in obtaining assignment of infringing marks and license with eight-figure license fees. First-chaired litigation team with suits pending in two federal districts. Personally negotiated settlement and license agreement.
- Defended national real estate investment trust in class action seeking damages in excess of \$125 million obtaining denial of class certification. First-chaired trial of individual claims on merits, obtaining favorable verdict and judgment, zeroing out all claims.
- Defended against claims brought by major software company for misappropriation of trade secrets, breach of confidentiality and breach of covenant not to compete obtaining dismissal of all claims with prejudice. First-chaired litigation team.
- Defended local clothing retailers against copyright infringement claims obtaining dismissals of all claims with prejudice. First-chaired litigation team.
- Represented national consumer specialty electronics manufacturer and retailer in multiple patent infringement cases against competitors, each resulting in settlement and license agreements favorable to client.
- Defended major multi-national manufacturer of mobile telecommunications equipment in patent infringement litigation obtaining dismissal with prejudice of three asserted patents.
- Represented major direct seller and multilevel marketer of home decorative and gift products in misappropriation of trade secrets and

unfair competition lawsuit against competitor, resulting in several million dollar settlement in favor of client.

Press Releases

- “Gray Reed Helps Secure Important Verdict for PanOptis in Patent Infringement Case Against Huawei” (August 30, 2018)
- “Gray Reed & McGraw Strengthens Intellectual Property Practice” (February 9, 2016)

Thought Leadership

- “Judicial Profile: Hon. Rodney Gilstrap”, *The Federal Lawyer* (June 2017)
- “Case Brief – TC Heartland LLC V. Kraft Foods Group Brands LLC”, Gray Reed & McGraw Legal Alert (May 31, 2017)
- “Temptations to Take: Misappropriation of Trade Secrets, Damages and Remedies”, *Vol. VII No. 2 Computer L.R. and Tech. J.* 117, 117-147 (Winter 2003)

Speeches and Presentations

- “International Litigation: A Confluence of Customs, Culture and Commercial Activity”, Continuing Legal Education presentation (July 28, 2006)
- “Legislative and Case Law Update to International Business Transactions”, International Law Section of the Dallas Bar Association (October 1999)

Honors

- Selected by his peers for inclusion in Woodward/White, Inc.’s *The Best Lawyers in America* in the field of Intellectual Property Litigation

(2018 - 2020)

- Selected as a Best Lawyer in Dallas by *D Magazine* (2018 - 2019)
- Named to America's Top 100 Bet-the-Company Litigators list (2019)
- Named to America's Top 100 High Stakes Litigators list (2018)
- Fellow of the Texas Bar Foundation
- Life Fellow of the Dallas Association of Young Lawyers Foundation
- Voted one of the best lawyers in Texas by peers (2008 - 2010), as published in *D Magazine's* "Rising Stars" edition
- Barrister, *The Honorable Barbara M. G. Lynn American Inn of Court*
- *SMU Law Review* Editorial Board and Articles Editor (1999 - 2000)
- SMU Law Review Association (1998 - 2000)
- Officer, Phi Delta Phi Law Society, Monteith Inn (1998 - 2000)
- SMU School of Law Board of Advocates

Related Employment

- PanOptis Patent Management, LLC, *Principal*

Organizational Involvement

- Texas Bar Association
- Texas State Bar College
- J. Reuben Clark Law Society (Board of Directors, Dallas)
- Phi Delta Phi

- American Intellectual Property Law Association
- Federal Bar Association
- Federal Circuit Bar Association
- U.S. Supreme Court Bar Association
- American Bar Association
- Dallas Bar Association
- Dallas Association of Young Lawyers
- Texas Young Lawyer's Association
- Eastern District of Texas Bar Association
- Texas Bar College