



## Eric S. Tautfest

### Partner Intellectual Property Litigation

Dallas

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### Focus Areas

Patents & Innovations  
Patent Litigation  
IP Portfolio Management & Counseling  
Copyrights  
IP Due Diligence  
Patent Litigation  
Technology Transactions  
Trade Secrets  
Trademark & Advertising

### Highlights

#### **Award-Winning Patent Litigator**

Eric brings more than 20 years of patent litigation experience representing plaintiffs and defendants in complex trials and litigation. He has received numerous honors including Best Lawyers in America and Texas Super Lawyers.

#### **Diverse Technologies**

Eric represents clients at both the state and federal levels in various industries including wireless telecommunications, software, fiber optics, image compression, and semiconductors.

#### **Bilingual and Culturally Fluent**

Eric has a minor in Korean Studies and is fully fluent in the Korean language.

### Experience

Currently, Eric Tautfest is a partner at Munck Wilson Mandala in the technology/intellectual property law group. Eric has more than 22 years of experience defending and prosecuting IP infringement claims, managing patent portfolios, and advising on IP transactions. Eric is an esteemed patent litigation and trial lawyer known in the IP community as a patent litigation one-stop shop - working both the prosecution and the defense sides of litigation, working as in-house counsel, and working in private practice. His legal career includes working as a partner at various reputable law firms in IP law.

As an experienced patent infringement litigator and defense lawyer, Eric has successfully prosecuted and defended claims in federal courts across the country in a wide range of technologies, including wireless telecommunications, software, fiber optics, computer displays, semiconductors and various other technologies. In the course of his work, he has developed unique and practical patent monetization strategies and implemented aggressive licensing and litigation programs throughout the whole patent life cycle. This is one of his specialties.

Early in his legal career, Eric focused on representing plaintiffs in patent infringement lawsuits, presenting him with the opportunity to resolve cases efficiently and effectively. A similar mentality is evident in his defense practice as well, where he strives for efficient and cost-conscious representation. Having established a reputation for resolving patent infringement cases punctually and efficiently, clients have retained Eric to provide settlement counsel in a variety of cases.

Eric's unique skills include working as an in-house attorney which provided him with insight into the industry from his clients' perspectives as well as hands-on experience mitigating technology protection challenges. This background has had a great impact on the way Eric approaches litigation in his current role. He not only focuses on understanding the objectives of his clients, but also those that are being pursued by the decision makers of the opposing party. Eric uses his unique skills and legal background to explore innovative ways to accommodate the concerns of opposing parties once he comprehends their competing interests.

### **Representative Matters**

- Served as litigation counsel and helped secure a \$506M verdict in a patent infringement jury trial against Apple (*Optis Wireless Technology LLC et al. v. Apple Inc.*).
- Negotiated the funding, purchase, and documentation of four large patent portfolios from three major multi-national electronics 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 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.

## Credentials

### Education

#### **Southern Methodist University**

2000  
Deadman School of Law  
Juris Doctorate

#### **Brigham Young University**

1996  
B.A. in Political Science

### Associations and Memberships

Reuben Clark Law Society – Board of Director in Dallas  
American Intellectual Property Law Association  
Federal Bar Association  
Dallas Bar Association  
Eastern District of Texas Bar Association  
Federal Circuit Bar Association  
U.S. Supreme Court Bar Association

American Bar Association  
Texas Young Lawyer's Association  
Texas Bar College  
Texas State Bar College  
Texas Bar Association - Fellow  
Dallas Association of Young Lawyers - Life Fellow  
The Honorable Barbara M. G. Lynn American Inn of Court - Barrister  
Phi Delta Phi - Officer (1998-2000, Monteith Inn)  
SMU *Law Review* Editorial Board and Articles Editor (1999-2000)  
SMU *Law Review* Association (1998-2000)  
SMU School of Law Board of Advocates

## Honors and Awards

Best Lawyers in America, Woodward White, Inc. (2023)  
Super Lawyer, Thomson Reuters (2021 - 2022)  
Best Lawyer in Dallas, D Magazine (2018-19, 2021-22)  
America's Top 100 High Stakes Litigators (2018)  
Rising Star, D-Magazine (2008-2010)

## Admissions

State Bar of Texas  
U.S. Supreme Court  
U.S. Court of Appeals Federal Circuit  
U.S. Court of Appeals Fifth Circuit  
U.S. District Court, Eastern District of Texas  
U.S. District Court, Northern District of Texas  
U.S. District Court, Southern District of Texas  
U.S. District Court, Western District of Texas

## Knowledge

*Temptations to Take: Misappropriation of Trade Secrets,*  
*Damages and Remedies, Vol. VII No. 2 Computer L.R. and Tech. J. 117, 117-147 (2003)*