1 IN THE UNITED STATES DISTRICT COURT

2 FOR THE EASTERN DISTRICT OF TEXAS

3 TEXARKANA DIVISION

4 PANTECH CORPORATION and)
PANTECH WIRELESS LLC,)
5)
Plaintiffs,)
6)
VS) Case No.
7) 5:22-cv-00113-RWS-JBB
LG ELECTRONICS INC. and)
8 LG ELECTRONICS U.S.A., Inc.)
)
9 Defendants.)
_____)
10

11 C O N F E R E N C E C A L L

12
DATE: November 1, 2023
13
TIME: 1:01 p.m. to 1:30 p.m. EDT
14
PLACE: Via telephone
15
BEFORE: Dawn A. Hillier, RMR, CRR
16 Stenographic Reporter
Notary Public - State of
17 Florida, at Large

18 JOB NO: 513490 PD

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1 APPEARANCES: ALL PARTIES ATTENDING VIA TELEPHONE

2

3 THE PANEL:

4 Hon. Christopher L. Ogden
Hon. Daniel J. Galligan
5 Hon. Scott B. Howard

6
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REPORTER'S KEY TO PUNCTUATION:

-- At end of question or answer references interruption.

... References a trail-off by the speaker. No testimony omitted.

"Uh-huh" "Um-hum" References affirmative sound.

"Huh-uh" "Um-um" References negative sound.

1 P R O C E E D I N G S
2 JUDGE OGDEN: Hi. Welcome to the Patent
3 Trial and Appeal Board.
4 This is Judge Christopher Ogden. And with
5 me today are Judges Dan Galligan and Howard.
6 And this is for LG Electronics vs. Pantech
7 Wireless, LLC. There's several case numbers.
8 This would include IPR2023/01267, and also
9 1268, 1269, 1270, 1272, and 1273. And so I'd
10 like to get appearances from the parties. Who
11 do we have on behalf of petitioner?
12 MR. DAVIS: Yes, Your Honor. This is Jim
13 Davis of Ropes & Gray. And with me is Daniel
14 Richards. We also have a court reporter on the
15 line. And we'll submit the transcript after
16 the hearing for the court -- for the board,
17 excuse me.
18 JUDGE OGDEN: Okay. Thank you, Mr. Davis.
19 And who do we have on behalf of patent
20 owner?
21 MR. FUSSELL: This is James Fussell from
22 Mayer Brown. I also have with me Amanda Bonner
23 from Mayer Brown joining me.
24 JUDGE OGDEN: Okay, Mr. Fussell.
25 MR. FUSSELL: Yes.

1 JUDGE OGDEN: Thank you. And do we have
2 any -- anyone else on the line? Not from
3 either of the parties?
4 STENOGRAPHIC REPORTER: Yes, sir. This is
5 Dawn Hillier, the court reporter.
6 JUDGE OGDEN: Okay. Yeah. Right. Yeah.
7 Thank you.
8 Okay. Well, this call was requested by
9 petitioner LG Electronics regarding a potential
10 motion to disqualify patent owner's counsel.
11 And so I'll let -- Mr. Davis, I'll let you go
12 first and kind of explain what you're asking
13 for. And, you know, explain the reasoning
14 behind the request at this time.
15 MR. DAVIS: Yes, Your Honor. And I'm
16 happy to go into more detail, as necessary.
17 But as you mentioned, petitioner LG is seeking
18 leave to file a motion to disqualify Mayer
19 Brown from participating in these IPRs.
20 Pantech's counsel in the IPR is Mayer Brown who
21 previously represented LG in a variety of cases
22 over a long period of time. But importantly,
23 there were four particular cases where the same
24 accused products were at issue as are at issue
25 in a co-pending District Court case. And those

1 products were accused of infringing patents
2 involving subject matter that overlaps with the
3 patents that are at issue and the IPRs that you
4 listed before.
5 We have raised a similar motion in the
6 District Court that the case is pending in the
7 Eastern District of Texas where infringement
8 allegations involving these same patents are
9 also pending. That's Case No. 5:22-cv-113.
10 There were originally seven patents in
11 that case. And one has been split out. The
12 court found a conflict as to that one patent.
13 And that's in IPR2023/1271. So it's not one of
14 the six that you -- that you listed.
15 With respect to the six remaining patents,
16 though, while the court found that there
17 appeared to be an obvious conflict of interest,
18 any conflict had been waived as to those other
19 six patents. There's an alleged waiver
20 agreement between the -- between Mayer Brown
21 and LG for another case where Mayer Brown was
22 representing LG.
23 Those six patents, as I mentioned before,
24 are the same six patents that are involved in
25 these IPRs. With respect to the District

1 Court's finding, LG has sought mandamus on the
2 waiver issue, both because LG believes that the
3 Court improperly shifted the burden of proving
4 the waiver defense to LG and because the Court
5 had supplied that waiver language along with a
6 couple additional issues.
7 The Federal Circuit requested briefing
8 from Mayer Brown and Pantech on that mandamus.
9 And that was completed back in September and
10 the mandamus request -- it's still pending.
11 In the interim, Mayer Brown had entered an
12 appearance in these IPRs, which necessitated
13 raising that same disqualification issue here.
14 We understand the panel hadn't been assigned to
15 these IPRs until recently and have been in
16 contact with trials to try to get a phone call
17 scheduled. This is the first opportunity to
18 raise the issue.
19 What we're requesting is a joint -- or a
20 motion that would go across all six of the
21 proceedings just because there is a significant
22 amount of overlap, although there are unique
23 facets to each of the IPRs and the different
24 patents.
25 We know that under Rule 42.24, a typical

1 motion page limit would be about 15 pages, but
2 because we're requesting a consolidated motion
3 cause to all six of the proceedings, we'd ask
4 for 20 pages. And the motion, that would be
5 then 20 pages for the response and then we'd
6 ask for seven pages in reply.
7 And with respect to a proposed schedule,
8 we can file that motion within a week -- a week
9 or two weeks for the opposition, and then a
10 week or 10 days for the reply, depending on
11 whether that would fall during the Thanksgiving
12 holidays or not. We also would be filing a
13 motion to seal along with that. And I think
14 the parties could meet and confer, as we've
15 done in the District Court, to submit redacted
16 versions and a protective order to address any
17 confidentiality issues, which there will be
18 some involved in the motion.
19 JUDGE OGDEN: Okay. And so you say that
20 the status of the motion for the request for
21 mandamus in the federal circuit is -- you're
22 just waiting for the Federal Circuit to decide
23 on that?
24 MR. DAVIS: Yes, Your Honor. There's been
25 requests for oral argument as well, but

1 ultimately we are waiting for the Federal
2 Circuit to decide on the briefing, which is
3 complete now.
4 JUDGE OGDEN: So for this motion that
5 you're proposing, are there going to be
6 different issues in the IPRs that were not
7 addressed that could have been addressed in
8 District Court? Or is it going to be
9 essentially the same arguments?
10 MR. DAVIS: I think there's going to be a
11 significant amount of overlap, Your Honor. I
12 think that if there's a -- if there's a
13 disqualification in the District Court, that
14 should apply here, but I think as we're
15 briefing it, there may be unique facets to the
16 fact that these IPRs are patent by patent, if
17 you will, as opposed to having everything
18 together in the District Court, so there are
19 perhaps some unique issues that arise in light
20 of that.
21 JUDGE OGDEN: But you said in the District
22 Court, though, there was -- the District Court
23 did split off one of the patents and treated
24 that separately; right? That's the one that
25 would correspond to the 1271 IPR?

1 MR. DAVIS: That's correct, Your Honor.
2 JUDGE OGDEN: Okay. All right. Let's go
3 to Mr. Fussell. Do you have a response on
4 behalf of patent owner?
5 MR. FUSSELL: Yes, Your Honor. And as
6 noted by counsel for LG, with respect to each
7 of the patents at issue, a magistrate judge
8 first decided the issue and then objections
9 were filed by LG. And the District Court then
10 decided in favor of Pantech with respect to all
11 but one of the patents, finding conclusively
12 that Mayer Brown should not be disqualified
13 based on LG's informed written consent,
14 allowing Mayer Brown to represent it, and in
15 some instances, that the matters were not
16 substantially related.
17 Based on this decision, and although LG
18 has taken that up by the form of a writ of
19 mandamus, we believe that issue has been
20 decided and is conclusively decided by a
21 District Court and has no need to be addressed
22 by the board.
23 Secondarily, we don't believe that the
24 issues that will be presented by the board,
25 principally the validity of the patent, has any

1 bearing on Mayer Brown's prior representation
2 of LG with respect to the arguments that were
3 made by LG and the District Court, which
4 counsel has represented will be identical to
5 the arguments they intend to make here; that
6 is, primarily that Mayer Brown had access to
7 LG's confidential information as a result of
8 prior litigations and therefore to be
9 disqualified from representing Pantech in the
10 District Court actions, as that access to that
11 confidential information. Further arguments
12 could be relevant to the issues in the case.
13 Here, the issue of validity of the patents
14 has no bearing on whether or not Mayer Brown
15 had access to any of LG's confidential
16 information in the past.
17 Lastly, I would note that given the issues
18 before the Federal Circuit, we think it would
19 be premature to brief the issue or to the
20 Federal Circuit actually ruling on LG's writ.
21 Unless you have any specific questions,
22 that's principally our position.
23 JUDGE OGDEN: Okay. Thank you,
24 Mr. Fussell. Okay. Hold on for just a second.
25 Okay. Let me go back to Mr. Davis.

1 Specifically, on the fact that there's a
2 mandamus proceedings before the Federal
3 Circuit. If the Federal Circuit were to deny
4 your writ of mandamus, you know, would there be
5 any reason or benefit for us to grant the
6 motion?
7 MR. DAVIS: Your Honor, there may be. It
8 would really depend on what the Federal Circuit
9 said. If it picks it up on the merits as
10 opposed to on a procedural basis, then there
11 may not be a need to proceed further. But
12 there's been arguments raised in the mandamus
13 proceeding as to whether procedurally this
14 should be raised now on mandamus or it should
15 be raised at the conclusion of the District
16 Court case. So it would really depend on what
17 the mandamus ruling is.
18 JUDGE OGDEN: So I'm wondering then,
19 Mr. Davis, if that sort of gives a little bit
20 of credence to what Mr. Fussell was saying,
21 which was that maybe at this point, it might be
22 premature to take briefing on this issue while
23 there's a pending request for mandamus in the
24 Federal Circuit.
25 Would you agree with that or are there

1 reasons why we should act before hearing back
2 from the Federal Circuit?
3 MR. DAVIS: Your Honor, I don't think the
4 PTAB is bound in any way by the District Court
5 ruling here. And the conflict that does arise
6 is due to Mayer Brown's participation in these
7 proceedings. So without a clear, you know, end
8 in sight of when the mandamus proceedings would
9 be completed, we think we should move forward
10 with the disqualification motion here. So it
11 does seem like we should proceed as we normally
12 would. And then if the mandamus result comes
13 out in a -- at a time when that can inform
14 whether we should continue briefing or not, we
15 could then address it at that point.
16 JUDGE OGDEN: Okay. So, Mr. Davis, did
17 you have any other responses to what
18 Mr. Fussell --
19 MR. DAVIS: Yes. Thank you, Your Honor.
20 JUDGE OGDEN: -- Mr. Fussell made?
21 MR. DAVIS: Yes, Your Honor. And I'd be
22 happy to get into the merits if the board would
23 like to on the issue of whether validity is
24 impacted but I think that the -- to keep it
25 succinct, we did address issues before the

1 District Court as to why there would be a
2 conflict with respect to addressing the
3 validity of these patents. And I think that's
4 further informed by the fact that the positions
5 Pantech's going to take and Mayer Brown is
6 going to take on behalf of Pantech with respect
7 to infringement inform how -- what positions
8 they're going to take with respect to validity
9 as well. You can't really bifurcate those two
10 issues from each other. And the information
11 that Mayer Brown learned as part of its prior
12 representations concerning the same products
13 and the same technical issues in these other
14 proceedings would inform it as to how it should
15 proceed in arguing both validity as well as
16 infringement in the District Court and validity
17 as part of these proceedings here.
18 JUDGE OGDEN: Okay.
19 MR. DAVIS: But I'm happy to answer any
20 other questions that the board might have.
21 JUDGE OGDEN: I'd like to ask you if --
22 I'm sorry. Let me go back to Mr. Fussell.
23 And I'd like to ask you, if the writ of
24 mandamus is granted, would there be a reason,
25 from your perspective, why we would reach a

1 different conclusion here?
2 MR. FUSSELL: I disagree principally with
3 Mr. Davis's argument that validity is impacted.
4 We believe that even if the district -- or
5 excuse me, the Federal Circuit were to grant
6 the writ and on it, Mayer Brown should be
7 disqualified, we do not necessarily believe
8 that that would disqualify us from representing
9 Pantech from the IPRs.
10 As I noted, validity stands on its own and
11 is not impacted by any prior representations,
12 none of which would be considered substantially
13 related.
14 JUDGE OGDEN: So I notice, I think I might
15 be mistaken, but I -- was there a change of
16 counsel in the 1271 IPR where Mayer Brown --
17 where there's new counsel in that case?
18 MR. FUSSELL: Yes, Your Honor.
19 JUDGE OGDEN: I was just curious if there
20 was -- you know, that was because of the ruling
21 in District Court, and was there anything in
22 the District Court ruling specifically that
23 related to the IPR cases?
24 MR. FUSSELL: Well, to your first
25 question, yes, there is new counsel. Pantech

1 is, as Mr. Davis noted, required to retain new
2 counsel for that single patent that was severed
3 out of those litigations in the Eastern
4 District of Texas into its own action.
5 And out of -- for efficiency purposes,
6 Pantech has elected to hire separate counsel
7 for the IPR as well.
8 JUDGE OGDEN: Okay. Yeah. That makes
9 sense.
10 Do you have any further responses to
11 Mr. Davis?
12 MR. FUSSELL: No, not at this time.
13 JUDGE OGDEN: Okay. If you can hold on,
14 hold on for a second, I'll be back. I'll be on
15 mute and then I'll be back in a second.
16 (Pause.)
17 JUDGE OGDEN: Okay. This is Judge Ogden.
18 Mr. Davis, are you still on the line?
19 MR. DAVIS: Yes, Your Honor.
20 JUDGE OGDEN: Mr. Fussell, are you still
21 on the line?
22 MR. FUSSELL: Yes, Your Honor.
23 JUDGE OGDEN: Okay. Great. We're going
24 to take the issue under advisement and then
25 issue an order later. But just so that we

1 understand what the petitioner's asking for,
2 you're asking for 20 pages for motion, 20 pages
3 for response, seven pages reply. You're saying
4 that the motion would be within a week,
5 opposition within one or two weeks, and then
6 reply within a week or 10 days, if I wrote that
7 down correctly.
8 Is that what you're requesting?
9 MR. DAVIS: That's correct, Your Honor.
10 And just to be clear, we'd be filing exhibits,
11 you know, of course with that -- those papers
12 as well, kind of corresponding to some of the
13 issues that have come up in the District Court
14 as well.
15 JUDGE OGDEN: Okay. Mr. Fussell, if we
16 did -- if we did order a briefing, would you
17 agree with the page limits and time frames or
18 do you have -- would you want something
19 different?
20 MR. FUSSELL: I believe that we're
21 agreeable with that. We would just ask for a
22 like number of pages in response to 20 pages
23 for our response as well.
24 We just note that Mr. Davis mentioned that
25 it would be a consolidated brief addressing the

1 alleged conflict in each of the IPRs. However,
2 I would note that, you know, each of the
3 patents stands on its own. And theoretically,
4 you know, there could be a conflict as to one
5 patent and not as to others. So I leave it to
6 the board as to whether or not they want to do
7 briefing in each of the IPRs separately. We're
8 happy to address that in a consolidated
9 briefing, if that's your preference, however.
10 JUDGE OGDEN: Okay. Okay. Thank you.
11 Okay. I think we're ready to adjourn,
12 unless the parties have any other issues that
13 they want to raise. Mr. Davis, anything else?
14 MR. DAVIS: No, Your Honor.
15 JUDGE OGDEN: Okay. Mr. Fussell?
16 MR. FUSSELL: No, Your Honor. Thank you
17 very much.
18 JUDGE OGDEN: Okay. All right. And we'll
19 look for the transcript to be filed on the
20 record as an exhibit, as soon as possible.
21 With that, we're adjourned. Thank you.
22 (At 1:30 p.m. the proceedings are concluded.)
23
24
25

1 STATE OF FLORIDA)
2 COUNTY OF PINELLAS)
3
4 I, Dawn A. Hillier, RMR, CRR, CLR certify that
5 I was authorized to and did stenographically report
6 the foregoing proceedings, and that the transcript
7 is a true record of my stenographic notes.
8 Dated this 2nd day of November 2023.
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11 _____
12 DAWN A. HILLIER, RMR, CRR, CLR
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