

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner,

v.

PANTECH WIRELESS, LLC,
Patent Owner.

IPR2023-01267 (Patent 9,313,809 B2)
IPR2023-01268 (Patent 9,575,631 B2)
IPR2023-01269 (Patent 9,854,545 B2)
IPR2023-01270 (Patent 10,869,247 B2)
IPR2023-01272 (Patent 9,065,486 B2)
IPR2023-01273 (Patent 9,136,924 B2)

PETITIONER'S MOTION TO DISQUALIFY MAYER BROWN LLP

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I. INTRODUCTION

Petitioner LG Electronics Inc. (“LGE”) respectfully requests that the Board disqualify its former counsel, Mayer Brown LLP (“Mayer Brown”), from representing Pantech Corporation and Pantech Wireless, LLC (“Pantech”) in this matter. As counsel to LGE for nearly a decade in matters involving cellular technology that overlaps with the technology to which the claims of the patents challenged here are directed, Mayer Brown, including attorneys representing Pantech in these IPRs, gained access to LGE’s confidential information in substantially related matters such that Mayer Brown’s representation of Pantech here violates the USPTO Rules of Professional Conduct.

Because of Mayer Brown’s conflict of interest, LGE brought a similar motion seeking disqualification in the related litigation, *Pantech Corp. v. LG Electronics Inc.*, No. 5:22-cv-00113 (E.D. Texas) (“EDTX Case”). The EDTX court found that Mayer Brown’s prior representations of LGE gave rise to an ethical conflict (noting “obvious conflicts of interest” (Ex. 1209 at 1)), and partially disqualified Mayer Brown after further finding that LGE had waived part of the conflict—a finding LGE has appealed through a mandamus petition and on which Pantech and LGE have already submitted further briefing as ordered by the Federal Circuit. Due to Mayer Brown’s conflict, Pantech has already retained different counsel in IPR2023-01271, which was also brought by LGE challenging another Pantech patent. LGE now

[REDACTED]

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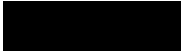
II. FACTUAL BACKGROUND

Between 2013 and 2020, Mayer Brown represented LGE in at least eight separate matters related to cellular technology, just as is at issue here. Ex. 1201 ¶¶ 3-4, Ex. 1202 ¶ 3. This includes the following substantially related matters in which Mayer Brown received confidential technical information related to LGE’s technology and litigation and licensing strategies:

1. [REDACTED]
[REDACTED]
2. *Cellular Comm’s. Equip. v. LG Electronics, Inc.*, Nos. 6:13-cv-00508, 6:14-cv-00982, 6:16-cv-00365 (E.D. Tex.) (“CCE”)
3. *Core Wireless Licensing v. LG Electronics, Inc.*, No. 2:14-cv-00911 (E.D. Tex.) (“Core Wireless”)
4. *Mobile Tele. Tech. v. LG Electronics, Inc.*, No. 2:13-cv-00947 (E.D. Tex.) (“MTT”)

Ex. 1201 ¶ 4, Ex. 1202 ¶ 3. Of the Mayer Brown attorneys representing Pantech in IPR proceedings, at least three of them—Amanda Bonner (née Streff), Tripp Fussell, and Baldine Paul—each formerly represented LGE in one or more of the matters listed above and the larger Mayer Brown team representing Pantech in the EDTX

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 Case represented LGE in each of the prior matters. Collectively these attorneys
 involved in these IPRs billed thousands of hours to the above four LGE matters,
 including  by Mr. Paul alone. Ex. 1201 ¶ 6. Moreover, Mayer Brown
 failed to screen the other attorneys involved in the prior LGE matters from the EDTX
 Case. Ex. 1201 ¶ 5; see *In re Apeldyn Corp.*, 391 F. App'x 873, 876 (Fed. Cir. 2010)
 (holding that in the absence of screening, ethical rules provide that “while lawyers
 are associated in a firm, none of them shall knowingly represent a client when any
 one of them practicing alone would be prohibited from doing so”).

Each prior LGE matter involved patents related to LGE’s smartphone and
 cellular technology at issue in these IPRs. Each prior matter included overlapping
 products to those that Pantech accuses in the EDTX Case (Ex. 1210 ¶ 12):

Prior LGE Matter	Overlapping Accused Products with <i>Pantech</i>
	4G LTE enabled devices
<i>CCE</i>	4G LTE enabled devices, including the LG G Pad 7.0 LTE and others
<i>Core Wireless</i>	Communication devices, including the LGE G Pad 7.0 LTE and others
<i>MTT</i>	Mobile units, including LG Phoenix and others

Just as here, where Pantech alleges U.S. Patents 9,065,486 (“’486”);
 9,136,924 (“’924”); 9,313,809 (“’809”); 9,854,545 (“’545”); and 10,869,247
 (“’247”) are standard essential patents (SEPs) for certain cellular standards; 
 and *CCE* also involved alleged SEPs related to cellular standards specifications,

[REDACTED]

Motion to Disqualify - IPR2023-01267, -01268, -01269, -01270, -01272, -01273 including the same technical specifications covering the same discrete issues that Pantech alleges the challenged patents cover here. For example, Pantech alleges that its patents are essential through the same specifications that were at issue in [REDACTED] pertaining to (1) carrier aggregation functionality (3GPP TS 36.211, TS 36.213, TS 36.321, TS 36.300, and TS 36.331), (2) communication protocols and channel mapping (3GPP TS 25.211 and TS 25.321), and (3) turbo codes (3GPP TS 36.212). Ex. 1201 ¶ 11; Ex. 1259 at 1; Ex. 1260 at 1; Ex. 1261 at 1. *CCE* involved many of these very same standards (*e.g.*, TS 36.321, and TS 36.331), as well as TS 25.214. Ex. 1201, ¶ 8; Ex. 1219 at 29; Ex. 1241 at 67-69; Ex. 1220 at 40, 42. In its defense of LGE in these matters, Mayer Brown was privy to confidential information including LGE's technology development, SEP policies and procedures, products, business practices, litigation strategies, and source code, as well as licensing and financial strategies. Ex. 1201 ¶¶ 8, 11-16.

Mayer Brown similarly represented LGE in substantially related litigations in *Core Wireless* and *MTT*. *Core Wireless* involved the same method of launching and manipulating application functions that one of Pantech's challenged patents (9,575,631 ("631")) is directed to here. Ex. 1221 ¶¶ 15-23; Ex. 1227, claim 20. Though Mayer Brown previously argued that its role in *Core Wireless* was limited to monitoring the case to advise on its potential impact on the [REDACTED], two Mayer Brown attorneys made appearances in *Core Wireless* for the very purpose of

1211 ¶ 4. And just as here, in *MTT*, Mayer Brown defended LGE against infringement allegations against patents involving using messaging services to store, transmit, display, and process messages and message metadata.

Because of Mayer Brown’s conflict of interest, LGE brought a timely motion in the related district court litigation asking the court to disqualify Mayer Brown. Ex. 1212. The district court partially disqualified Mayer Brown, agreeing with LGE that with respect to *MTT*, the case involves substantially related technology, and thus that Pantech should be disqualified with respect to U.S. Patent 7,283,839, but the court did not disqualify Mayer Brown as to the other six patents-at-issue.¹ Ex. 1209 at 21, 27-28. For each of [REDACTED] and *CCE*, the district court also found both that Mayer Brown’s representation of LGE was substantial, and that “the facts highlighted by LGE here suggest that Mayer Brown’s actions would amount to obvious conflicts of interest” (Ex. 1209 at 1), but found that LGE waived its objections through a purported waiver that LGE signed when engaging Mayer Brown in *Jenam Tech, L.L.C. v. LG Electronics, Inc.*, No. 4:19-cv-00249 (E.D. Tex.) (“*Jenam*”). Ex. 1213 at 52. For *Core Wireless*, the Magistrate’s Report and Recommendation found that the litigation involved substantially related **technology**,

¹ Pantech therefore is already relying on different counsel in IPR2023-01271 challenging the ’839 patent.

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but that the ***matter*** was not substantially related, and thus failed to order
disqualification. Ex. 1213 at 55. LGE has already appealed both of these findings
in its pending mandamus petition. Ex. 1214.

Mayer Brown may argue here, as it did in the EDTX Case, that its conflict is
excused because of the contractual waiver provision in *Jenam*. This argument would
be without merit. In *Jenam*, Mayer Brown requested a limited waiver of future
conflicts for certain matters “substantially unrelated to the technology” at issue in its
prior representations of LGE. Ex. 1215. In particular, the parties agreed that:

*[LGE] consents to [Mayer Brown’s] representation of other clients
adverse to [LGE], in future matters substantially unrelated to the
technology involved in (1) the [Jenam] Matter and (2) other matters
where the Firm represented LGE in the past five (5) years, including in
litigation, arbitration, or other adverse proceedings adverse to [LGE],
and waives any conflict of interest arising from such matters for the
Firm’s other clients.*

Ex. 1215. But because each of ██████████, CCE, Core Wireless, and MTT is not
“substantially unrelated” to the technology in these IPRs, the waiver does not apply.

III. **MAYER BROWN SHOULD BE DISQUALIFIED**

A. Legal Standard

“A panel of the Board may disqualify counsel for cause after notice and
opportunity for hearing.” 37 C.F.R. § 42.10(d). Under USPTO Rule of Professional
Conduct 11.109, “[a] practitioner who has formerly represented a client in a matter
shall not thereafter represent another person in the same or a substantially related
matter in which that person’s interests are materially adverse to the interests of the
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[REDACTED]

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37 C.F.R. § 11.109(a). This responsibility is imputed to the entire firm representing the former client under Rule 11.110. 37 C.F.R. § 11.110. As the moving party, LGE has the burden to show that Mayer Brown should be disqualified in this proceeding, 37 C.F.R. § 42.20(c), while Pantech bears the burden on its defense of waiver. *See, e.g., Galderma Lab’ys, L.P. v. Actavis Mid Atl. LLC*, 927 F. Supp. 2d 390, 398 (N.D. Tex. 2013) (“Because [former counsel] has raised the issue in its defense, the Court concludes that [former counsel] has the burden to show that Galderma gave informed consent.”); *In re Fisker Auto. Holdings, Inc. S’holder Litig.*, No. CV 13-2100, 2018 WL 3991470, at *3 n.5 (D. Del. Aug. 20, 2018).

The American Bar Association’s (“ABA”) Model Rule 1.9, on which the USPTO Rules are based, explains that “[m]atters are ‘substantially related’ for purposes of this Rule if they involve the same transaction or legal dispute or if there otherwise is a substantial risk that confidential factual information as would normally have been obtained in the prior representation would materially advance the client’s position in the subsequent matter.” Under Model Rule 1.9 the Court applies a two-part test to determining whether a substantial relationship exists, namely that there is “(1) an actual attorney-client relationship between [the party moving for disqualification] and the attorney [it] seeks to disqualify and (2) a substantial relationship between the subject matter of the former and present

[REDACTED]
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B. Mayer Brown’s Prior Representation of LGE Is Disqualifying

Mayer Brown’s prior representations of LGE in [REDACTED], *CCE*, *Core Wireless*, and *MTT* are substantially related to the IPR proceedings here, and therefore disqualifying. With respect to the first prong of the substantial relationship test, each of these matters involved “an actual attorney-client relationship” between LGE and Mayer Brown. Mayer Brown admitted as much at the district court. Ex. 1216 at 15 (“Mayer Brown does not dispute that an attorney-client relationship previously existed with LGE.”). Indeed, LGE formally engaged Mayer Brown as counsel in each matter and Mayer Brown billed thousands of hours to LGE. Ex. 1201 ¶ 6.

Under the second prong, each of the prior representations involved subject matter that is substantially related to the claims of the challenged patents. *See CSIRO*, 297 F. App’x at 975. Courts have provided guidance as to factors that are relevant to whether a substantial relationship exists in disqualification matters. *See, e.g., Sunbeam Prods. Inc. v. Oliso, Inc.*, No. C 13-03577, 2014 WL 892918, at *4 (N.D. Cal. Mar. 4, 2014) (substantial relationship where prior and current matter both involved vacuum sealing technology); *Talon Rsch., LLC v. Toshiba Am. Elec. Components, Inc.*, No. C 11-04819, 2012 WL 601811, at *5 (N.D. Cal. Feb. 23, 2012) (substantial relationship where patents involved in current and prior

[REDACTED]

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As a simple example of the overlapping technology involved across the patents-at-issue, each of the four prior matters included overlapping products—and overlapping product functionalities—to those that Pantech accuses in the EDTX Case. Ex. 1210 ¶ 12. These technical overlaps implicating the same products underscore how close the relationship is between the technologies at issue in these IPRs and in Mayer Brown’s prior work for LGE. The validity arguments that Pantech will raise in the IPRs are informed by the infringement positions that it will want to take in the EDTX Case, which is further informed by the extensive amount

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These technical overlaps implicate each of the IPRs. In particular, in each of the IPRs, the challenged claim limitations relate to technical functionalities that were also at issue in at least one of [REDACTED], *CCE*, *Core Wireless*, and *MTT*. Mayer Brown thus obtained access to confidential LGE information relating to each of the patents challenged in LGE’s IPRs in its representation of LGE in these prior cases. *See* Ex. 1201 ¶¶ 9-17; Ex. 1202 ¶¶ 6-23.²

² As Pantech’s counsel recognized at the hearing on this matter, arguments in this motion are not coextensive with those in district court because, depending on the Federal Circuit’s decision, there may be different outcomes regarding disqualification in district court and on the IPRs. IPR2023-01267 Ex. 1102 / -01268 Ex. 1041 / -01269 Ex. 1108 / -01270 Ex. 1071 / -01272 Ex. 1120 / -01273 Ex. 1114 (“11/1 Tr.”) at 12-13, 15. Indeed, in this IPR, in addition to the technical overlap,

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[REDACTED]
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In IPR2023-01269, LGE challenges the '545 patent, which relates to carrier aggregation and timing synchronization in uplink communications of wireless devices. *See, e.g.*, Ex. 1205 (“’545 patent”), Abstract, 1:23-27, 5:23-27.³ The challenged claims require, among other limitations, “receiving a Random Access Preamble (RAP)” and “transmitting a Random Access Response (RAR) including a Timing Advance (TA) value.” *Id.*, claim 1. The '545 patent explains that the RAP and RAR transmissions occur via “Random Access Channel (RACH).” *Id.*, 7:7-11. Similarly, in *Core Wireless*, the claims asserted against LGE included U.S. Patent 6,978,143, claim 17, reciting “sending uplink packet data to the system using ... a common channel (RACH),” and U.S. Patent 6,477,151, claim 14, reciting “receive a timing advance value once, from the base station subsystem to the mobile station.” Ex. 1222 ¶¶ 94-106, 120-132; Ex. 1228, claim 17; Ex. 1229, claim 14. In addition, related to the '545 patent’s uplink synchronization and carrier aggregation concepts, *CCE* included U.S. Patent 8,848,556, claim 1, reciting “configuring a user equipment to send a power headroom report control element in an uplink” in implementing carrier aggregation, and [REDACTED] included U.S. Patent 6,091,717, claim 1, reciting “receiving the broadcast MAC information at the plurality of mobile

“each of the patents stands on its own,” *Id.* at 18, providing further unique patent-specific reasons why disqualification may be warranted.

³ Because this brief is being filed in six IPRs, the patents challenged in these IPRs are identified as Exs. 1203 to 1208. But as noted in the Exhibit List, the patent challenged in each IPR instead appears at Ex. 1001 in that IPR.

[REDACTED]

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In IPR2023-01267, LGE challenges the ’809 patent, which relates to buffer monitoring, buffer status reporting, and data transmissions via dedicated channels in cellular communications. *See, e.g.*, Ex. 1203 (“’809 patent”), 2:21-39, claim 1. The challenged claims limitations include, among other limitations, “determining if a [enhanced dedicated channel] E-DCH buffer is empty” and “transmitting ... a total

[REDACTED]

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[REDACTED]

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Ex. 1210 ¶12; Ex. 1218 ¶ 22; Ex. 1222 ¶ 30; Ex. 1226 ¶ 14.

In IPR2023-01268, LGE challenges the '631 patent, which relates to displaying applications and related content in response to user commands. *See, e.g.*, Ex. 1204 (“’631 patent”), Abstract, claim 1. The challenged claims recite, among other limitations, “displaying one icon in a designated portion of a display, wherein the displayed icon corresponds to the first work process,” “displaying a screen of the first work process in the display,” and “in response to a first command for sequentially displaying icons, performing sequential display of icons such that an icon corresponding to the second work process is displayed.” *Id.*, claim 1. Similarly, in *Core Wireless*, the claims asserted against LGE included U.S. Patent 8,713,476, claim 20, reciting “displaying, on a computing device having a display screen, a menu listing one or more applications,” “the application summary is displayed while the one or more applications are in an un-launched state,” and “in response to a user selection of particular data, launching the respective application,” and U.S. Patent 8,434,020, claim 1, reciting “the computing device being configured to display on the screen a main menu listing at least a first application” and “each function in the list being selectable to launch the first application and initiate the selected function.” Ex. 1221 ¶¶ 15-23, 33-41; Ex. 1227, claim 20; Ex. 1235, claim 1. Moreover, similar to the '631 patent, the infringement contentions in *Core Wireless* stated that the asserted patents “relate to user interface design improvements that increase user

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- U.S. Patent 6,091,717, claims 1 and 6, reciting “transmitting packet data from a plurality of mobile stations to a base station,” “broadcasting media access control (MAC) information from the base station to the plurality of mobile stations ... conveying packet data transmission scheduling information,” and “transmissions of packet data from the mobile station to the base station are preemptively controlled and scheduled by the base station”;
- U.S. Patent 6,094,426, claim 1, reciting “A method for performing a virtual soft handoff update comprising the steps of ... transmitting media access control (MAC) information from each of a plurality of base stations ... conveying packet data transmission scheduling information”; and
- U.S. Patent 7,764,966, claim 1, reciting “receiving an acknowledgment indication from the base station, that comprises a reverse channel assignment message for the mobile station, switching the mobile station to a scheduled mode of operation.”

Ex. 1201 ¶ 11; Ex. 1231, claim 1 and 6; Ex. 1233, claim 1; Ex. 1236, claim 1. In addition, *CCE* included U.S. Patent 7,215,962, claim 1, reciting “an intersystem handover ... using a first transmission method ... comprising: comparing a threshold value to a first transmission quality of a first signal to a first base transceiver station,” and *MTT* included U.S. Patent 5,809,428, claim 8, reciting, “receiving ... a data acknowledgment message”—overlapping with the handover and acknowledgment

[REDACTED]

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In IPR2023-01272, LGE challenges the '486 patent, which relates to simultaneous data transmissions with parallel data streams. *See, e.g.*, Ex. 1207 ("'486 patent"), 4:41-46, claim 3. The challenged claims limitations include "a first parity bit stream," "a second parity bit stream," and "selecting ... bits for ... first and second parity bits." *Id.*, claim 3. Similarly, in *Core Wireless*, the asserted claims included U.S. Patent 6,266,321, claim 8, reciting "simultaneously transmitting data related to two channels," "spreading data related to a first[second] channel in parallel using a first spreading code and a second spreading code," and "compiling a transmission from spread data related to the first channel and spread data related to the second channel." Ex. 1222, ¶¶ 81-93; Ex. 1239, claim 8. In addition, [REDACTED] included U.S. Patent 6,778,521, claim 1, reciting "A method for transmitting ... in the cell of a cellular radio system using a first channel and a second channel." Ex. 1201 ¶ 11; Ex. 1240, claim 1. Relatedly, the infringement allegations at least in [REDACTED] were based in part on the same 3GPP technical specifications upon which

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Pantech's infringement allegations for the '486 patent are based in the district court litigation (*e.g.*, TS 36.212 in [REDACTED]). Ex. 1201 ¶ 11; Ex. 1261 at PDF 1. Because of these overlaps in claimed functionalities, the accused products in these matters overlapped with products accused of infringing the '486 patent in the district court (*e.g.*, LG G Pad 7.0 LTE in *CCE* and LG Phoenix and Escape Series in *Core Wireless* and *MTT*). Ex. 1210 ¶ 12; Ex. 1218 ¶ 22; Ex. 1222 ¶ 30; Ex. 1226 ¶ 14.

In IPR2023-01273, LGE challenges the '924 patent, which relates to adjusting a base station's transmission to a user device based on the user device's feedback and transmitting information in bitmap format. *See, e.g.*, Ex. 1208 ("'924 patent"), claim 1. The challenged claims limitations include, among other limitations, "a transmitting device ... transmitting, to a receiving device codebook restricting information" and "receiving, from the receiving device, information." *See, e.g., id.*, claim 1. The '924 patent explains that the codebook restriction information is sent from a user device to a base station to inform the base station that certain transmission modes are unavailable for the user device. *Id.*, 4:20-34, 5:10-19, 5:40-52, Figures 1-2. In response, the user device receives from the base station the information, "based on a bitmap format," that is used for adjusting the transmissions of the user device. *Id.*, 3:52-62, 4:55-60. Similarly, in [REDACTED], the claims asserted against LGE included U.S. Patent 7,764,966, claim 25, reciting a feedback mechanism including "transmitting data packets from the mobile station ...

[REDACTED]

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C. LGE Has Not Waived Mayer Brown’s Adverse Representation

Pantech cannot carry its burden to show that LGE provided informed consent to waive Mayer Brown’s representation of Pantech here. Because contractual waiver by informed consent to future adverse representation is a defense to disqualification, Pantech carries the burden to show that waiver applies. *Galderma Lab’sys*, 927 F. Supp. 2d at 398; *In re Fisker Auto. Holdings*, 2018 WL 3991470, at *3 n.5

[REDACTED]

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For all of the reasons explained above showing that the technology involved in the prior matters is substantially related to that at issue here, Pantech is unable to carry its burden. Indeed, the waiver provision provides a higher bar than the standard disqualification test—not only is the burden on Pantech, rather than LGE, but Mayer Brown must show that the prior matters are “substantially *unrelated* to the technology” at issue here (Ex. 1215)—a higher burden than LGE’s burden, with respect to disqualification, to demonstrate that matters are substantially related. As LGE has already explained, the technology in the prior matters was substantially related—and certainly not substantially *unrelated*—to the technology claimed in each of the patents at issue in these IPRs. Because Mayer Brown cannot carry its burden to show that the prior matters involved substantially unrelated technology, the contractual waiver provision is irrelevant and Mayer Brown must be disqualified.

IV. CONCLUSION

For the reasons stated above, the Board should disqualify Mayer Brown from representing Pantech in this matter.


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Respectfully submitted,

Dated: November 21, 2023

By: /James L. Davis, Jr./
James L. Davis, Jr.
Registration No. 57,325

Counsel for Petitioner
LG Electronics Inc.

[REDACTED]
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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing PETITIONER'S MOTION TO DISQUALIFY MAYER BROWN LLP was served via electronic mail to the following attorneys of record for the Patent Owner listed below:

Lead Counsel Amanda S. Bonner Registration No. 65,224 Mayer Brown LLP 71 S. Wacker Drive Chicago, IL 60606 Telephone: 312-782-0600 Facsimile: 312-706-8157 asbonner@mayerbrown.com Pantech-LGE-IPRService@mayerbrown.com	Back-Up Counsel James A. Fussell, III Registration No. 54,885 Clark S. Bakewell Registration No. 71,615 Baldine B. Paul Registration No. 54,369 Seth W. Bruneel Registration No. 78,973 William B. Nash Registration No. 79,859 Mayer Brown LLP 1999 K Street NW Washington, D.C. 20006 Telephone: 202-263-3000 Facsimile: 202-263-3300 jfussell@mayerbrown.com cbakewell@mayerbrown.com bpaul@mayerbrown.com sbruneel@mayerbrown.com BNash@mayerbrown.com Luiz Miranda Registration No. 74,762 Mayer Brown LLP 71 S. Wacker Drive Chicago, IL 60606 Telephone: 312-782-0600 Facsimile: 312-706-8172 lmiranda@mayerbrown.com
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Dated: November 21, 2023

By: /Dara Del Rosario/

Name: Dara Del Rosario

ROPES & GRAY LLP