

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
TEXARKANA DIVISION

PANTECH CORPORATION and PANTECH
WIRELESS, LLC,

Plaintiffs,

v.

LG ELECTRONICS INC., and LG
ELECTRONICS U.S.A., INC.,

Defendants.

Case No. 5:22-cv-00113

JURY TRIAL DEMANDED

**DEFENDANTS' RESPONSE TO PLAINTIFFS' RULE 72(B) OBJECTIONS TO THE
ORDER DENYING DEFENDANTS' MOTION FOR DISQUALIFICATION**

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Defendants (“LGE”) oppose Plaintiffs’ Rule 72 Objections (Dkt. No. 103; “Obj.”) to the Order Denying Defendants’ Motion for Disqualification (Dkt. No. 93; “Order”).

A. The Order Correctly Found that the *Core* and *MTT* Matters Are Substantially Related to the Instant Matter

The Order correctly found that the technologies involved in *Core* and *MTT* are substantially related to the instant matter under the waiver analysis, without needing to resort to the full set of evidence presented by LGE in its Motion. *See* Order 44-49; Dkt. Nos. 15 (“Mot.”); 54 (“Reply”). Indeed, Mr. Suh of LGE declared that “in at least these five matters [including *Core* and *MTT*], Mayer Brown [“MB”] had access to highly sensitive privileged and confidential information regarding LGE’s technologies, products, financials, business practices, litigation strategies, and licensing policies that are relevant in the Pantech matter.” Dkt. No. 15-2 (“Suh I”) ¶ 3; *see also id.* ¶¶ 4-5, 9, 11. And as summarized in LGE’s Objections (Dkt. No. 102), because the matters are substantially related and waiver does not apply, this “categorical[ly]” requires MB’s disqualification. *In re Am. Airlines, Inc.*, 972 F.2d 605, 614 (5th Cir. 1992).

The Order correctly finds *Core* and this matter are substantially related—pointing to a host of overlap between the two, including overlapping products (*e.g.*, the LG G Pad family of tablets) and user interface elements of those products (*e.g.*, interactive display technologies). *See* Order 46-48. The Order also correctly found that *MTT* is substantially related based on the existence of overlapping products including the LG Phoenix, patents involving the “same specific area of technology,” and similar accused functionality concerning LG’s messaging application, including how the device displays message content and analyzes messages for additional information to display. Order 44-46; Suh I ¶ 9. As the Order noted, MB did not dispute that, and as discussed in §C, both matters involve the same products and messenger application. Order 45; Reply 8.

Indeed, the Order did not even need to reach all of the evidence of a substantial relationship

that LGE submitted because the evidence of overlapping products and accused functionality was sufficient to show a substantial relationship for each matter.¹ As explained in LGE’s Motion, *Core* and *MTT* involve products, functionalities in those products, and thus technical and financial documentation related to those products that overlap with the instant case. *E.g.*, Mot. 2-4; Reply 6-10; Suh I ¶¶ 3, 9, 11; Dkt. No. 54-1 (“Suh II”) ¶ 3; *see also* Order 44-48; §C, *infra*.

B. MB Improperly Shifts the Burden to LGE

MB incorrectly asserts that LGE failed to “me[et] *its burden* to establish a substantial relationship between *the technologies at issue* in the *MTT* and *Core* matters and the technologies at issue in the present case” sufficient to overcome “the *Jenam* Engagement Letter’s waiver provision.”² Obj. 1. While LGE had the burden of demonstrating a conflict in the first instance, the burden “shift[s]” to MB to show that the prior matters involve substantially unrelated technology under the *Jenam* waiver. *See, e.g., Galderma Lab’ys, L.P. v. Actavis Mid Atl. LLC*, 927 F. Supp. 2d 390, 398 (N.D. Tex. 2013); *In re Fisker Auto. Holdings, Inc. S’holder Litig.*, No. CV 13-2100-DBS-SRF, 2018 WL 3991470, at *3 n.5 (D. Del. Aug. 20, 2018); *Celgene Corp. v. KV Pharm. Co.*, No. 07-4819(SDW), 2008 WL 2937415, at *6-7 (D.N.J. July 29, 2008).

¹ *See, e.g., Dynamic 3D Geosolutions LLC v. Schlumberger Ltd.*, 837 F.3d 1280, 1283 (Fed. Cir. 2016) (finding matters involving different versions of same product are substantially related); *W.L. Gore & Assocs., Inc. v. IMPRA*, 745 F.2d 1463, 1467-68 (Fed. Cir. 1984) (“technical subject matter of each suit is the same” where suits both involved “expanded ... PTFE”); *Micrografx, LLC v. Samsung Telecomms. Am., LLC*, No. 3:13-CV-3599-N, 2014 WL 12586177, at *3 (N.D. Tex. Mar. 7, 2014) (to be substantially related, it is enough to be “sufficiently similar that certain legal issues and evidence relating to [the accused products] may be relevant in both litigations”); *Sunbeam Prods. Inc. v. Oliso, Inc.*, No. C 13-03577 SU, 2014 WL 892918, at *3-4 (N.D. Cal. Mar. 4, 2014) (disqualifying counsel based on overlap in vacuum sealing technology); *Talon Rsch., LLC v. Toshiba Am. Elec. Components, Inc.*, No. C11-04819 WHA, 2012 WL 601811, at *3-7 (N.D. Cal. Feb. 23, 2012) (disqualifying counsel based on overlap in flash technology where patents’ PTO class and accused products overlap); *TQ Delta, LLC v. 2WIRE, Inc.*, No. CV 13-1835-RGA, 2016 WL 5402180, at *1, *7 (D. Del. Sept. 26, 2016) (preventing counsel from seeking discovery from subpoenaed party based on counsel’s prior prosecution work on “technology which relates to” accused DSL chips for subpoenaed party).

² Emphasis added unless otherwise noted throughout.

Independently, because MB drafted the “substantially unrelated to the technology involved in” language, MB “should bear the burden of establishing that the contract[] satisf[ies] the ethics rules.” *Celgene*, 2008 WL 2937415, at *7. And any ambiguity should be interpreted against MB as the drafter of this language. See Order 22-24, 28-29. MB did not even attempt to meet its burden—instead improperly shifting it to LGE to disprove.

C. LGE’s Technical Comparison Was Further Evidence of the Substantial Relationship

Focusing solely on the *Jenam* waiver—an issue that MB had the burden to prove—MB misleadingly alleges that LGE “blatant[ly] mischaracteriz[ed] the case law” and is “deceptively misleading with respect to the court’s analysis in *Micrografx*,” because the *Micrografx* “court did not once reference the claims.” Obj. 2-3. But it was **MB** that argued LGE was required to compare the asserted claims, and MB that asserted that the *Micrografx* court “did a detailed **comparison between the asserted claims of the patents at issue in the current and prior representations.**” Dkt. No. 60 at 5 (citing *Micrografx*, 2014 WL 12586177, at *3).

LGE disputes that such an analysis is required to show that two matters are substantially related, and MB cites to no case requiring a claim comparison. Nevertheless, LGE provided a claim comparison at the hearing solely to address MB’s argument regarding technical overlap that it raised for the first time in its sur-reply (see Dkt. Nos. 89, 65), in the event such a comparison would assist the Court, and MB was provided an opportunity to respond (Dkt. No. 89).³

Moreover, MB identifies no authority for its argument that patent specifications rather than claims must be analyzed or expert testimony must be submitted to establish a substantial overlap. Nevertheless, LGE’s motion did compare the patents (see Mot. 4; Suh I ¶¶ 9, 11) and its witnesses

³ MB also alleges that it was not provided an opportunity to respond to LGE’s arguments in the supplemental brief, but this is the result of MB’s insistence that the parties have a single exchange with no modification to the submission after the initial exchange (Ex. 47).

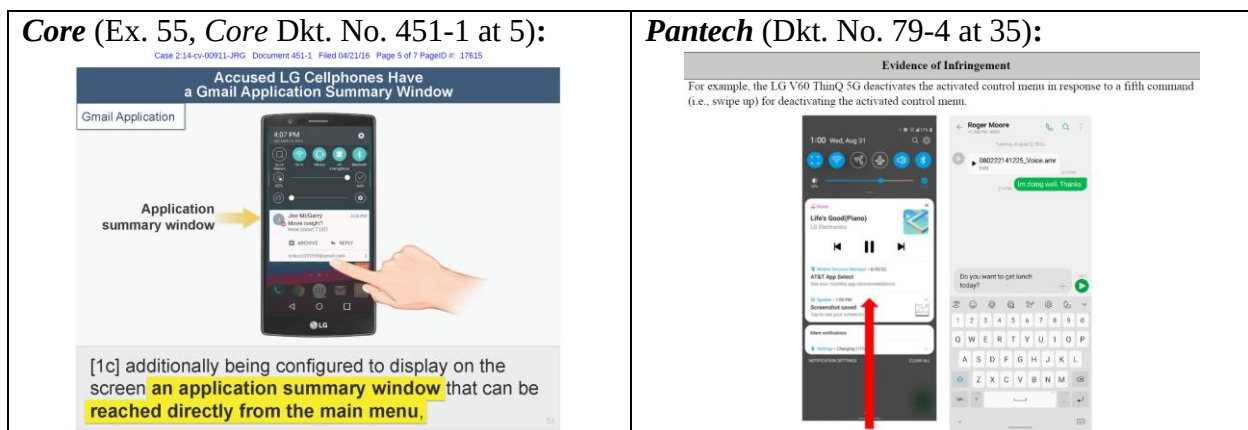
testified to the overlap just as the expert did in *Micrografx* (e.g., Suh I ¶¶ 3, 9, 11; Suh II ¶ 3; see also Dkt. Nos. 15-3, 54-3).⁴ Moreover, the law is clear that the substantial relationship analysis requires a case-by-case analysis to determine whether there is a “*substantial risk that confidential factual information as would normally have been obtained in the prior representation would materially advance the client’s position in the subsequent matter.*” ABA Rule 1.9 cmt. 3 (2002). The focus on the former client’s confidential information means the inquiry should look to what confidential information about LGE’s accused products MB may have learned in earlier representations and that would be useful to Pantech here. See *id.*; *In re Am. Airlines*, 972 F.2d at 618-20.

LGE’s claim comparison was merely further evidence of the overlap between the matters, beyond the already clear showing made by LGE of substantial overlap of the products and accused functionalities in those products as well as between the patents at issue in each proceeding. Mot. 2-4; Reply 6-10; Suh I ¶¶ 3, 9, 11; Suh II ¶ 3; Order 44-48. Separate from the claim comparison, LGE presented evidence from the complaints in the *Core* and *MTT* matters as well as Mr. Suh’s declaration that the prior matters involved overlapping accused products and technical functionalities with the instant matter. For example, Mr. Suh declared that “[t]he [*Core*] complaint accused several LGE products of infringement, including the LG G Pad family of tablets” at issue here. Suh I ¶ 11. Like U.S. Patent 9,575,631 asserted here (Compl. ¶ 20), the “patents at issue in *Core* included U.S. Pat. Nos. 8,713,476 and 8,434,020, which are generally related how user interface elements are presented to users for accessing applications.” *Id.*; Mot. 4. Suh also declared

⁴ Despite MB’s reliance on the declaration of Dr. van Dam at issue in *Micrografx*, his analysis of the technical overlap is limited to a single paragraph, where he states that the “patents describe substantially related technologies in so far as they relate to graphical objects, scalable vector graphics and libraries of graphical objects/shapes.” Ex. 48, *Micrografx*, Dkt. No. 32-7 at 67-68 (¶ 13). The remainder of the five-page declaration is devoted to three pages on his credentials and two pages directed primarily to factual information, such as overlapping products. *Id.* at 65-68

that the *MTT* “complaint alleged that the patents covered certain features of how the messaging services and applications operating on LGE devices process messages” and “accused several LGE smartphones of infringement, including the LG Phoenix and others,” that are also at issue here. Suh I ¶ 9; Mot. 4. “[S]imilar to U.S. 7,283,839 asserted here (Compl. ¶ 19), three patents (U.S. Nos. 5,809,428, 5,754,946, and 5,894,506) at issue in *MTT* pertained to how the messaging services and applications operating on the accused devices process messages.” Mot. 4 (citing Suh I ¶ 9 (citing Dkt. No. 15-13 ¶¶ 6, 10, 14, 21, 24, 30, 33; Dkt. No. 15-14)).

The Order correctly recognized that MB’s arguments in its joint supplemental brief “emphasizing specific differences in the claimed inventions” do not show that the technology at issue in each matter is unrelated. Order 44-48. MB’s objections simply re-raise similar arguments as those that were properly rejected by the Order. For *Core*, the Order properly found that “both claims concern user inputs on display via selecting ‘menu listings’/‘icons’ to launch ‘applications’/display ‘work processes,’” and recognized that the existence of additional features does not show that the two matters involved different technology. *Id.* 48. Moreover, during briefing, MB never disputed that the same products are at issue, or that those same products running the same Android operating system have been accused by Pantech here. For example, *Core* accused the same alleged “Application Summary Window”/“control menu” as Pantech:



MB's arguments regarding the technological overlap in *MTT* "fail[] to show a meaningful difference in the technologies at issue." Order 46. While MB's "arguments show the differences in the specific claimed inventions[, they] do not effectively rebut LGE's showing that the inventions concern the same specific area of technology." *Id.* Thus, MB's arguments that an analysis of the full specification and file history was necessary to determine technological overlap are unavailing. The overlap was clear, and there was no need to resort to any evidence beyond the claims themselves. Contrary to MB's interpretation, it is the similarities—not the differences—in the matters that indicate whether they are substantially related.

MB's unsupported attorney argument, raised for the first time in its objections—that because the accused products date back to 2014 or earlier, the products would have used versions 6.0-7.0 of the Android operating system—confirms the overlap between the matters. Certain of the accused products in this litigation—including the G Pad F 8.0, G Pad F 8.0 2nd Gen, G Pad X 8.0, G Pad X II 10.1, G Pad X II 8.0 Plus, G5, G6, G6+, V20, V30, and X Venture (see Dkt. No. 79-2 at 2-5)—run Android versions 6.0-7.0,⁵ [REDACTED]

[REDACTED]. This is unsurprising because *MTT* did not conclude until March 2016 (Dkt. No. 15-14 at 9; Suh II ¶ 3), a mere six months before the damages window in this litigation. See Obj. 4 (recognizing the "accused products in this case ... dat[e] no further back than 2016").

Similarly, while MB now disputes through bald attorney argument that LGE has not proven

⁵ *E.g.*, Ex. 49, <https://www.lg.com/us/tablets/lg-AK495-lg-g-pad-f-8.0-2nd-gen> (last visited May 26, 2023) (G Pad F 8.0 2nd Gen: Android 6.0); Ex. 50, <https://www.lg.com/us/tablets/lg-UK750-Black-unlocked-g-pad-x-2> (last visited May 26, 2023) (G Pad X II 10.1: Android 6.0.1); Ex. 51, <https://www.lg.com/us/cell-phones/lg-VS987-Titan-g5> (last visited May 26, 2023) (G5: Android 6.0); Ex. 52, <https://www.lg.com/us/cell-phones/lg-US997U-Unlocked-g6-plus> (last visited May 26, 2023) (G6+: Android 7.0); Ex. 53, <https://www.lg.com/us/cell-phones/lg-H910-Silver-v20> (last visited May 26, 2023) (V20: Android 7.0); Ex. 54, <https://www.lg.com/us/cell-phones/lg-US998-Unlocked-v30> (last visited May 26, 2023) (V30: Android 7.1.2).

that the same messenger application was at issue in *MTT*, it never raised this argument, including at the hearing or in the parties' joint supplemental brief (Dkt. No. 90). Tellingly, MB's objection does not affirmatively state that a different messenger application was at issue in *MTT*. As shown below, the same accused messaging system, format, and functionality is present in both cases:

	<i>MTT:</i>	<i>Pantech:</i>
Accused Messaging Application	<i>"LG Messaging application"</i> where Pantech admits that the accused products run on the <i>Android operating system</i> (Ex. 56, <i>MTT</i> Dkt. No. 63-3 at 3; Obj. 4) ⁶	<i>"preinstalled Messaging application"</i> as the default Messaging application ... run[ning] [on] the <i>Android operating system</i> " (Dkt. No. 79-3 at 1)
Accused Functionality	<i>"transmitting, receiving, and displaying emoticons, emojis, or animated emoticons/emojis"</i> (Ex. 56, <i>MTT</i> Dkt. No. 63-3 at 2-3)	<i>"transmitting</i> the outgoing message," <i>"receiv[ing]</i> message[s] [and] <i>displaying</i> the message content," where the message content includes <i>"multimedia files</i>, such as photos, videos, audio files, <i>emojis</i>, GIFs, URLs, etc." (Dkt. No. 79-3 at 41, 53, 73, 81)

Even if the same messenger application were not at issue (it is), the matters are still substantially related and involve overlapping highly sensitive LGE confidential and privileged information related to the same accused products, including the LGE Phoenix, and accused functionalities.

While MB newly identifies the construction of "means for selecting one of the canned messages" in *MTT* as well as "canned messages," these constructions confirm the substantial overlap. According to MB: a "canned message," as recited by *MTT*'s claims, is a "predefined sequence of characters" and "means for selecting one of the canned messages" requires "selecting 'canned messages'"; and therefore "selecting a canned message" is allegedly distinguishable from "determining a message kind of the message to be transmitted" as recited by the asserted '839 patent. Obj. 5-6. But Pantech's infringement contentions for "determining a message kind" allege that LGE's products "determine[] the kind of message to be transmitted" based on various factors,

⁶ Judicial notice of the public docket in *MTT* (*Mobile Tele. Tech. v. LG Elecs., Inc.*, No. 2:13-cv-00947 (E.D. Tex.)) is appropriate.

including whether the “submission includes multimedia files, such as photos, videos, audio files, **emojis**, GIFs, URLs, etc.” Dkt. No. 79-3 at 41. Thus, not only does Pantech allege that the “determining” step requires an analysis of the message content to determine whether to send an SMS or MMS message, but part of that analysis depends on whether the message content includes certain content such as “multimedia” or “**emojis**.” *Id.* This is the technology that Pantech admits was at issue in *MTT*: “a coding scheme to send predefined messages, such as, ‘**emoticons**, calendar invitations, contact cards’” and “using these message codes to implement a message sending and receiving scheme.” Obj. 5 (quoting Dkt. No. 15-13 ¶ 33), 7; *see also* Ex. 56, *MTT* Dkt. No. 63-3 at 2-3 (“Accused Functions: ... transmitting, receiving, and **displaying emoticons, emojis, or animated emoticons/emojis**”). Nevertheless, as the Order recognized, “differences in the specific claimed inventions ... do not effectively rebut LGE’s showing that the inventions concern the same specific area of technology.” Order 46. The cases cited by MB are distinguishable because none concerned the same accused products and overlapping features of those products.⁷

The Order correctly found that *Core* and *MTT* concern technologies substantially related to those at issue in the instant matter and fall outside of the *Jenam* waiver provision. MB’s objections should be overruled.

⁷ *Network Apps, LLC v. AT&T Mobility LLC*, 598 F. Supp. 3d 118, 130-31 (S.D.N.Y. 2022) (different accused product and different accused feature); *Secure Axxess, LLC v. Dell Inc.*, No. 6:11-CV-338, 2012 WL 12919543, at *3 (E.D. Tex. Feb. 23, 2012) (no showing of overlapping products); *Biax Corp. v. Fujitsu Comput. Sys. Corp.*, No. 2:06-CV-364 (TJW), 2007 WL 1466638, at *2 (E.D. Tex. May 16, 2007) (two matters involved different accused processors and different functionality); *Power Mosfet Techs., LLC v. Siemens AG*, No. 2:99-CV-168, 2002 WL 32785219, at *3 (E.D. Tex. Sept. 30, 2002) (different accused products and prior representation “could not have involved [functionality at issue in later case] because [hardware] did then not exist”).

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document is being served via email on counsel of record on this the 26th day of May, 2023.

/s/ Jennifer H. Doan
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