

**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-RWS-JBB

JURY TRIAL DEMANDED

**REPLY IN SUPPORT OF DEFENDANTS' MOTION
TO DISQUALIFY MAYER BROWN LLP**

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[REDACTED]

[REDACTED]

Mayer Brown's Opposition to the motion to disqualify ("Opp.") serves only to further illustrate the need to disqualify it from this case given its unwillingness to abide by the language of its engagement letters, give heed to the plain facts that directly contradict its unsupported assertions, or follow the well-established ethical rules and applicable case law interpreting them.

I. MAYER BROWN'S WAIVER ARGUMENT IGNORES THE PLAIN LANGUAGE OF THE *JENAM* LETTER, AND IS LOGICALLY FLAWED

Mayer Brown's new interpretation of the *Jenam* letter readily demonstrates the flaws in its waiver argument. After repeatedly changing its position (Mot. at 6-7), Mayer Brown now contends that the letter contains a moving five-year window for a conflict waiver such that LGE purportedly waives any conflict arising from matters that are at least five years old at the time that the new adversity arises. Not only does the letter contradict such an interpretation, but so do Mayer Brown's past statements. Nevertheless, even Mayer Brown's flawed interpretation would not overcome the present conflict.

A. Mayer Brown's Reading Ignores the Plain Language of the *Jenam* Letter

The *Jenam* letter unambiguously [REDACTED]

[REDACTED]. The relevant language states that:

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Mot. Ex. 24, at 3 (emphasis added). Just as "[REDACTED]" is measured relative to the time the letter was signed, so is "[REDACTED]." *Id.* [REDACTED]

[REDACTED]¹

Mayer Brown's statements when negotiating the letter further confirm [REDACTED]

¹ Mr. Beaber's unsupported and alleged oblique verbal reference to a "Korean company" in a statement to Mr. Kim is also of no moment. See Opp. at 6; Dkt. No. 45-2 ("Beaber Dec.") ¶ 9.

Moreover, any waiver must be clear and unequivocal. Ambiguity in the operative language serves only to undercut Mayer Brown's argument that there is a waiver for that independent reason.

Even under Mayer Brown’s flawed interpretation, the substantially related cases still fall within the purported [REDACTED]. Mayer Brown’s Opposition argues that the adversity arose when it began to represent Pantech in licensing negotiations against LGE in December 2020 (*see* Opp. at 11), but all the substantially related actions discussed in LGE’s Motion to Disqualify fell within the purported [REDACTED] before December 2020. *See* Mot. at 2-3; Second Suh Declaration (“Suh 2nd Dec.”) ¶ 3 (matters lasted at least until: [REDACTED] *Core Wireless*—Nov. 13, 2017; *CCE*—Sept. 13, 2016; *MTT*—Mar. 16, 2016; *Jenam*—Jan. 2020). Even when the Complaint was filed, on Sept. 2, 2022, [REDACTED], *Core Wireless*, and *Jenam* were all [REDACTED] [REDACTED] and preclude Mayer Brown’s involvement in this action. *Id.* Indeed, *Jenam* alone is sufficient to create a conflict. Nevertheless, Mayer Brown’s assertion that only *Jenam* is relevant to the inquiry is demonstrably false.

Mayer Brown also incorrectly suggests that LGE has waived any objection to the conflict during licensing negotiations or by negotiating a waiver of service. Mayer Brown cites no case with analogous facts. Instead, emails between the parties directly contradict Mayer Brown's assertions. LGE timely raised this issue both pre-suit and again after the Complaint was filed.

[REDACTED]

[REDACTED]

A. LGE Did Not Previously Agree to Mayer Brown’s Representation of Pantech

During the licensing negotiations, LGE raised the conflict issue soon after learning that Mayer Brown was involved, and never acceded to Mayer Brown’s position that there was no conflict of interest. Mayer Brown first reached out to LGE on behalf of Pantech in December 2020. Mot. Ex. 26, at 4-5. LGE responded directly to Pantech on January 5, 2021, expressing concern that Pantech was relying on outside counsel in licensing negotiations. See Dkt. No. 15-1 (“Kim Dec.”) ¶ 9; Ex. 35. On March 25, 2021, LGE again objected to Pantech regarding Mayer Brown’s involvement due to conflict issues, and Pantech responded that this should be raised with Mayer Brown directly. Kim Dec. ¶ 9; Ex. 36. In April 2021, LGE raised the issue with Mayer Brown directly, and the two reached an “impasse”—directly belying Mayer Brown’s purported impression that the issue was somehow resolved. Mot. Ex. 26, at 1. Subsequently, Mayer Brown was cut out of the negotiations and LGE and Pantech negotiated directly. Kim Dec. ¶ 10.

The Opposition baselessly suggests that LGE was obligated to take additional steps during the negotiations to disqualify Mayer Brown. Yet there was no court before which to raise the matter as there was no live case. Instead, as courts prefer the parties to do, LGE and Pantech, without involving Mayer Brown, attempted to reach an agreement, but were unable to do so. The Opposition also falsely asserts that LGE continued negotiating with full knowledge that Mayer Brown continued to represent Pantech (citing Dkt. No. 45-3 (“Fussell Dec.”) ¶ 6). Not only does the Fussell declaration not support this speculation, but LGE was unaware of Mayer Brown’s subsequent involvement and Pantech’s May 6, 2021, email confirmed that the parties would proceed “without any representatives” in light of the conflict issue “between LG and Mayer Brown.” Ex. 37; Suh 2nd Dec. ¶ 4.

As for the limited communications made after the present suit was filed, negotiating a waiver of service does not constitute a waiver of a conflict. Given that Pantech had retained outside

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counsel in the case, LGE’s in-house counsel properly reached out to that outside counsel to negotiate the waiver of service and extension of time. The parties had already reached an “impasse” on the issue of the conflict, Mot. Ex. 26, at 1, and LGE never gave any indication that its position had changed. Under Mayer Brown’s argument, the parties cannot have any interactions or attempt to negotiate any dispute without waiving the conflict. This is decidedly not the law.

B. LGE Brought the Motion in the Present Case at a Reasonable Time

As for the timing of the disqualification motion in the present litigation, LGE has acted diligently and raised this issue before any substantive filing after the Complaint. Courts have repeatedly found that filing within similar timeframes is more than timely. *See, e.g., Islander E. Rental Program v. Ferguson*, 917 F. Supp. 504, 507-08 (S.D. Tex. 1996) (no waiver where conflict raised just four months after action was initiated); *City of El Paso v. Salas-Porras Soule*, 6 F. Supp. 2d 616, 622 (W.D. Tex. 1998) (filing after seven months, “just after Defendants filed their answers” was not an unreasonable delay). Here, LGE retained outside counsel in late October. Kim Dec. ¶ 11. Outside counsel investigated the issue in November and contacted Mayer Brown. Mot. Ex. 27 at 1. The parties exchanged letters and attempted to meet and confer in December and reached an impasse—and the Motion was filed soon thereafter. *See* Mot. at 17; Mot. Exs. 28-29.

Mayer Brown’s cited cases (*see* Opp. at 10-11, 14) are inapposite and merely demonstrate that a waiver is appropriate only if (1) there is a substantial delay after suit has been filed, (2) a forum is available for raising the disqualification issue, and (3) the case has made significant progress before the issue is raised with the court. *See, e.g., Simmons v. Houston Cnty., Tex.*, No. 9:05-CV-82, 2006 WL 8440543, at *5 (E.D. Tex. Feb. 2, 2006) (finding waiver where a party knew of the conflict before the lawsuit, and waited “almost a year after filing suit” to raise the issue six weeks before the trial setting); *Abney v. Wal-Mart*, 984 F. Supp. 526, 530 (E.D. Tex. 1997) (finding waiver when a party brought the motion “one month before the date of trial,”

approximately a year after suit was first filed in state court); *Zichichi v. Jefferson Ambulatory Surgery Ctr., LLC*, No. CIV. A. 07-2774, 2008 WL 2859232, at *1 (E.D. La. July 22, 2008) (finding waiver when plaintiff moved to disqualify over a year after the initial action was brought, after a preliminary injunction motion, motion for new trial in state court, a mediation proceeding, and a motion to dismiss); *Advanced Training Grp. Worldwide, Inc. v. Proactive Techs. Inc.*, 436 F. Supp. 3d 870, 875 (E.D. Va. 2020) (finding waiver when “ATG did not file their motion to disqualify until January 3, 2020, over seven months later and after the close of discovery and the filing of cross-motions for summary judgment”). Each case Mayer Brown cites involved significant progress and over seven months elapsing since the complaint was filed—in contrast to the present Motion, which was filed less than four months after the Complaint and before any further progress in the case.

III. MAYER BROWN’S PRIOR REPRESENTATIONS OF LGE REMAIN SUBSTANTIALLY RELATED

Mayer Brown’s Opposition misunderstands the test for substantial relation and mischaracterizes the facts. The law does not require Mayer Brown to currently “possess relevant confidential information.” Opp. at 18. All that is required is that “a lawyer could have acquired confidential information concerning a prior client that could be used either to that prior client’s disadvantage or for the advantage of the lawyer’s current client or some other person.” Tex. R. Disc. P. 1.09 cmt. 4B.² Even setting aside the explicit examples of relevant confidential information that Mayer Brown accessed, there are more than enough factual and legal similarities between the past representations and the present case to establish “a substantial risk that confidential factual information as would normally have been obtained in the prior representation

² “A conclusion about the possession of such information may be based on the nature of the services the lawyer provided the former client and information that would in ordinary practice be learned by a lawyer providing such services.” ABA Rule 1.9 cmt. 3.

would materially advance the client's position in the subsequent matter." ABA R. 1.9 cmt. 3.

A. Mayer Brown Had Access to Relevant Confidential / Privileged Information On the Same Products and Standards Accused of Infringement Here

Mayer Brown's attempts to downplay and ignore the extent and nature of the confidential and privileged information to which it had access. Indeed, as Mayer Brown's argument concedes, much of this information—to the extent it is discoverable—is going to be requested in this litigation because it is directly relevant to the issues in the present case. *See Opp.* at 19.

Here, the passage of time does not render any confidential information obsolete. *Cf.* ABA R. 1.9 cmt. 3. Pantech's Complaint explicitly accuses LGE of infringing "now and within the past six years," which includes the period when Mayer Brown was representing LGE in the [REDACTED], *CCE*, *Core Wireless*, and *Jenam* matters, and the existence of overlapping accused products further demonstrates that confidential and privileged information accessed during Mayer Brown's past representations remains relevant. *Radware, Ltd. v. A10 Networks, Inc.*, No. C-13-02021, 2014 WL 977488, at *2-3 (N.D. Cal. Mar. 5, 2014) (finding information not stale because it overlapped with the damages period, and "could be relevant to developing damages theories in the current case").

As noted in the motion, LGE divulged many types of confidential and privileged information to Mayer Brown over the years. That includes highly confidential:

- Source code, [REDACTED] data sheets, [REDACTED] materials, and [REDACTED] documents for the accused [REDACTED], among other products (Mot. at 12; Dkt. No. 15-3 ("Hong Dec.") ¶¶13-17);
- [REDACTED] for several accused products, "including the [REDACTED] [REDACTED] series of devices (Mot. at 12; Hong Dec. ¶ 13);
- Information LGE permitted Mayer Brown to obtain from LGE suppliers and personnel regarding the implementation details of certain [REDACTED] standards, as well as optional features within those standards, which are at issue here (Dkt. No. 15-2 ("Suh Dec.") ¶¶ 14-16; Suh 2nd Dec. ¶ 5);
- Confidential and privileged information about LGE's [REDACTED], which included the unwritten details of its licensing policies, and the approaches it uses for

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valuations, negotiations, and litigation (Suh Dec. ¶ 16; Suh 2nd Dec. ¶ 6); and

- [REDACTED] licenses related to the same standards at issue in this case (Mot. at 11-12; Suh Dec. ¶ 16; Hong Dec. ¶ 18; Suh 2nd Dec. ¶ 6).

All that confidential information is readily used to Pantech's advantage at various points in the case. Mot. at 12; Hong Dec. ¶ 13. Given Mayer Brown's continued denials that it had access to relevant confidential information, Ms. Hong prepared another declaration discussing the details of particular productions of this confidential information to Mayer Brown, including its request in *Jenam* for access to highly confidential documents describing [REDACTED] —again demonstrating *Jenam* is substantially related. Second Hong Declaration ("Hong 2nd Dec.") ¶¶ 3, 9.

As demonstrated above, "the broad ranging and long lasting responsibility of [attorneys] for [defendant's] IP litigation and licensing practices" goes "a long way toward establishing the substantial relationship." *Staton Techiya, LLC v. Samsung Elecs. Co.*, No. 2:21-CV-00413, 2022 WL 16964746, at *2 (E.D. Tex. Nov. 16, 2022) (barring plaintiff's in-house counsel from vast majority of proceedings). Just as in *Intell. Ventures I LLC v. Checkpoint Software Techs. Ltd.*,

[Counsel] was involved intimately in every aspect of . . . patent licensing practices, negotiation of patent licenses, strategies for potential patent litigation, and ways of mitigating the risk of patent litigation . . . Here, the similarity in the two representations is enough to raise at least a common sense inference that the information [counsel] learned in its previous representation will prove relevant—and harmful to [its prior client] – in this lawsuit.

No. 10-1067, 2011 WL 2692968, at *11 (D. Del. June 22, 2011) (disqualifying counsel); *see also In re Am. Airlines*, 972 F.2d 605, 618-619 (5th Cir. 1992) (evidence needs to "important to the issues involved" in the present action to be "substantially related"; "relevan[ce]" is not required).

In the *CCE* case, the [REDACTED] source code and [REDACTED] documentation that Mayer Brown gained access to describes features of the [REDACTED]. Hong 2nd Dec. ¶¶ 4-5, 9-10. These

features are now accused of infringing certain aspects of the asserted claims of all seven asserted patents. *Id.* That information is precisely the type that triggers disqualification. For example, in *Micrografx v. Samsung Telecomms. Am.*, the court granted a disqualification motion where “[e]ven though [the prior case] may not have focused on precisely the same aspect of [the applications] at issue here, the patented technology in both cases is sufficiently similar that certain legal issues and evidence relating to [the accused products and its software] may be relevant in both litigations.” No. 3:13-CV-3599-N, 2014 WL 12586177, at *3 (N.D. Tex. Mar. 7, 2014) (relying on movant’s counsel statement “source code for the . . . applications could be relevant”).

Similarly, as explained in the motion, *MTT* and *Core Wireless* also concerned messaging services/applications and user interfaces, respectively, similar to those accused here and in many of the same products. Mot. at 2-4. As in *Micrografx*, the same evidence could be relevant here.

In a further attempt to distinguish [REDACTED], Mayer Brown falsely asserts that “infringement . . . by LGE products was not at issue [REDACTED].” Beaber Dec. ¶ 4. However, Mayer Brown’s analysis included a detailed assessment of whether LGE’s products and the chips provided by suppliers [REDACTED], particularly when [REDACTED]. Hong Dec. ¶ 18; Suh 2nd Dec. ¶ 5. As part of this analysis, Mayer Brown had access to portions of LGE’s source code and interacted with LGE’s cellular chip suppliers to investigate how and whether [REDACTED]. Suh 2nd Dec. ¶ 5. By way of one specific example, Mayer Brown analyzed LGE’s and its suppliers’ highly confidential implementation of [REDACTED], including whether the features were implemented in a manner consistent with [REDACTED]

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Network Apps, LLC v. AT&T Mobility LLC, 598 F. Supp. 3d 118, 130-32 (S.D.N.Y. 2022) (denying disqualification motion due to past work involving “different products”); *Simmons*, 2006 WL 8440543, at *3 (denying motion where movant relied on a “generalized statement that he ‘revealed confidences’”).

B. Mayer Brown’s Prior Access to and Knowledge of Confidential and Privileged LGE Information Will Harm LGE

Mayer Brown attempts to excuse its misuse or the risk of misuse of LGE’s confidential information by arguing that it is “discoverable” in any case. Opp. at 19. Mayer Brown’s cited cases are inapposite as they were concerned with public information. *See, e.g., Abney*, 984 F. Supp. at 530 (“The presumed information imputed to Magenheim is not confidential”); *Metro. Life Ins. Co. v. Syntek Fin. Corp.*, 881 S.W.2d 319, 321 (Tex. 1994) (“information at issue was . . . available in the public domain”). Even worse, Mayer Brown misstates the holding of *In re TMD Def. & Space, LLC*, which upheld the disqualification of counsel, because while knowing “mandatory disclosures” was no basis for disqualification, knowing “confidential information . . . regarding SDC’s financing” could be. 649 S.W.3d 764, 773 (Tex. App. 2022). Similarly, here, Mayer Brown’s possession of and prior access to relevant confidential technical, financial, and marketing materials from LGE is more than sufficient to warrant disqualification.

But even with discovery, Pantech would have not had access to the privileged strategies and discussions that went into developing LGE’s responses and tactics in the various substantially related matters—[REDACTED] being a perfect example. Even under Mayer Brown’s flawed description of that case, the core of the dispute was [REDACTED]. [REDACTED]. Pantech would never have had access to that development or the tactics and thought process that LGE engaged in with Mayer Brown as part of discovery because it is all privileged. *See* Suh 2nd Dec. ¶¶ 5-6.

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 19th day of January, 2023.

/s/ Jennifer H. Doan

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