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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner,

v.

PANTECH CORPORATION,
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)

**PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION TO
DISQUALIFY MAYER BROWN LLP**

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Alexandria, VA 22313-1450

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I. INTRODUCTION

Petitioner LG Electronics Inc.'s ("LGE") request "that the Board disqualify its former counsel Mayer Brown LLP [("MB")], from representing Pantech Corporation and Pantech Wireless LLC ("Pantech") in this matter," Paper 8 at 1, is merely an effort to relitigate an issue already considered and ruled upon in *Pantech Corp. v. LG Electronics Inc.*, No. 5:22-cv-00113 (E.D. Texas). Ex. 2005; Ex. 2004. LGE has presented no facts or evidence not previously considered by the District Court and has again failed to demonstrate that disqualification is warranted. This failure is only underscored by the unique issues presented in LGE's *inter partes* review petitions. Accordingly, LGE's motion should be denied.¹

II. FACTS AND PROCEDURAL HISTORY

A. Background

In June 2017, LGE ended its relationship with MB and transitioned all open patent matters to other firms. Ex. 2001 at 2. Thereafter, MB performed only administrative duties related to winding down the legal association between the parties. Ex. 2004 at 6.

¹ The Board has never exercised its discretion to disqualify counsel from proceedings. Notably, in *Miami Int'l Holdings, Inc. v. NASDAQ ISE, LLC*, No. CBM2018-0021, Paper 81 (PTAB Oct. 1, 2019), the Board denied Patent Owner's request to disqualify Petitioner's counsel that had previously been disqualified in a related district court proceeding.

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In 2019, [REDACTED] approached MB to represent it alongside LGE in connection with a lawsuit filed by Jenam Tech, LLC (“the *Jenam* matter”) asserting patent infringement based on the implementation of the [REDACTED]. Ex. 2001 at 2.² As part of that joint representation LGE executed an engagement agreement with MB, which included a waiver provision in which LGE:

consent[ed] to [MB'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 [MB] represented LGE in the past five (5) years, including in litigation, arbitration, or other adverse proceedings adverse to [LGE], and waive[d] any conflict of interest arising from such matter for [MB's] other clients.

Ex. 1215 at 3 (hereinafter “Waiver Provision”). As found by the District Court, this waiver was not standard boilerplate, but was the result of extensive negotiations between MB and LGE, which allowed LGE to secure MB's legal representation. Ex. 2005 at 1, n.1, 11, 14; Ex. 2004 at 26. As explained below, through the Waiver

² The District Court found that “[t]he record shows that the *Jenam* matter was fundamentally concerned with [REDACTED], not LGE, technology.” Ex. 2004 at 38.

[REDACTED]

Provision, LGE specifically waived a substantial portion of the conflicts of interest that it now accuses MB of undertaking.

B. LGE's Motion to Disqualify Pantech in District Court Proceedings

In September 2022, Pantech—represented by MB—brought suit against LGE. Ex. 2002. Then, in December 2022, LGE's counsel raised the alleged conflict issue with MB. Ex. 2003 at 302-304. In response, MB indicated that it was representing Pantech adverse to LGE in accordance with the Waiver Provision. *Id.* at 306-308. LGE, however, refused to acknowledge its waiver and filed a motion to disqualify MB from the case. *Id.* In its motion, LGE argued that “there is no waiver—in the *Jenam* letter, the International Terms of Business, or anywhere else—that would apply to the present case.” *Id.* at 17.

C. The District Court's Decision and LGE's Mandamus Petition

Following briefing and argument, *see id.*; Ex. 2014; Ex. 2015; Ex. 2016, Magistrate Judge Baxter entered an order denying LGE's relief. Ex. 2004. The Magistrate concluded that LGE consented to MB representing other clients adverse to LGE pursuant to the Waiver Provision and, without providing an actual interpretation of the “past five (5) years,” concluded that the five-year window in the Waiver Provision includes the *CCE*, *MTT*, *Core Wireless*, and [REDACTED] matters. *Id.* at 28-33. Next, the Magistrate examined whether the current Pantech matter is closely

enough connected to the technology in *Jenam*, *CCE*, *MTT*, *Core Wireless*, or ██████ to fall outside the scope of the Waiver Provision. *Id.* at 33-51. To do so, the Magistrate applied the “substantial relationship” test, emphasizing that the test requires showing more than merely overlapping technical areas; it requires a detailed comparison of patents and products in the current and prior representations. *Id.* at 33-37.

The Magistrate applied that test to each of the representations flagged by LGE. *Id.* at 38-51. Following an exhaustive examination characterized by what the District Court would later describe as “painstaking analysis of the facts and precise application of precedent,” Ex. 2005 at 5 (Ex. 2004 at 52), the Magistrate concluded that LGE had contractually waived its entitlement to seek disqualification stemming from MB’s earlier representations in *Jenam*, *CCE*, and ██████. Ex. 2004 at 52.

The Magistrate found that two of MB’s prior representations (*Core Wireless* and *MTT*) fell outside the Waiver Provision. *Id.* at 53. It subsequently assessed those two instances under a conflict-of-interest analysis by which it adopted its “substantial relationship” findings. *Id.* at 52. Ultimately, the Magistrate held that disqualification was not warranted, because no conflict of interest exists as to *Core Wireless* and the single conflict of interest that existed as to *MTT* was outweighed by societal interest factors. *Id.* at 56, 60.

Both parties filed objections. *See* Ex. 2006; Ex. 2007; Ex. 2008; Ex. 2009. Following another hearing, Judge Schroeder issued a lengthy order upholding much of the Magistrate's order but disqualifying MB solely in relation to U.S. Patent No. 7,283,839 (the "'839 Patent") based on the *MTT* conflict. Ex. 2005.³

In an effort to circumvent Judge Schroeder's order, in September 2023, LGE sought the extraordinary remedy of mandamus from the Federal Circuit. Briefing has since been completed and is pending final resolution.

D. LGE's Petitions for *Inter Partes* Review

In August 2023, LGE requested *inter partes* review of U.S. Patent Nos. 9,313,809, 9,575,631 (the "'631 Patent"), 9,854,545 (the "'545 Patent"), 10,869,247, 9,065,486, and 9,136,924 (collectively the "Challenged Patents"). *See* IPR2023-01267, -01268, -01269, -01270, -01272, -01273. Then, on November 21, LGE filed its motion to disqualify MB from representing Pantech, in essence, seeking to relitigate an issue already decided by the District Court.

³ On August 11, 2023 LGE requested *inter partes* review of the '839 Patent. IPR2023-01271. Notably, MB is not representing Pantech for this matter. Pantech's decision to utilize counsel of its choice for IPR2023-01271 should not be viewed as an admission that MB is unable to represent Pantech before the Board.

III. LEGAL STANDARD

“Disqualification of a party’s counsel is resolved on a case-by-case basis, where the moving party bears a *heavy* burden to show disqualification is necessary.” *CommScope Tech. LLC v. Dali Wireless, Inc.*, No. IPR2018-00571, Paper 18, at 4 (PTAB May 8, 2018) (emphasis added); *see also John Crane, Inc. v. Finalrod IP, LLC*, No. IPR2016-00521, Paper 5, at 3-4 (PTAB Mar. 29, 2016) (stating the same); 77 Fed. Reg. 48,612, 48,630 (“Motions to disqualify opposing counsel are disfavored because they cause delay and are sometimes abused.”).

USPTO Rule 109(a) precludes counsel from representing a person in “the same or substantially related matter in which that person’s interests are materially adverse to the interest of [a] former client *unless* the former client gives informed consent, confirmed in writing.” 37 C.F.R. § 11.109(a) (emphasis added); *see also* Am. Bar Ass’n (“ABA”) Rule 1.9 (stating the same).⁴ “Whether representations are ‘substantially related’ has been interpreted as requiring a showing that the subject matter of the two representations is ‘identical or essentially the same.’” *John Crane*,

⁴ “When the USPTO Rules of Professional Conduct were adopted . . . the Executive Summary noted ‘[a] body of precedent specific to practice before the USPTO will develop’ but ‘in the absence of USPTO-specific precedent’ ‘various sources for useful information’ may be referred to, such as cases under prior conduct rules at the USPTO, and comments and annotations to the ABA Model Rules of Professional Conduct” *CommScope*, No. IPR2018-00571, Paper 18, at 4 (citation omitted).

No. IPR2016-00521, Paper 5, at 3-4 (citing *Anderson v. Eppstein*, 59 U.S.P.Q.2d 1280, 1286 (BPAI 2001)). Moreover, when applying ABA Rule 1.9, courts consider whether “a substantial relationship between the subject matter of the former and present representations” exists.⁵ *Commonwealth Sci. & Indus. Rsch. Organisation v. Toshiba Am. Info. Sys., Inc.*, 297 F. App'x 970, 975 (Fed. Cir. 2008).

IV. ARGUMENT

A. The Board Should Defer to the Reasoned Judgment of the District Court

“‘[D]isqualification questions are intensely fact-specific, and it is essential to approach such problems with a keen sense of practicality as well as a precise picture of the underlying facts.’” *Miami Int’l*, CBM2018-0021, Paper 81, at 7 (quoting *Carlyle Towers Condominium Ass’n, Inc. v. Crossland Sav., FSB*, 944 F.Supp. 341, 345 (D.N.J. 1996)). Accordingly, the Board “defer[s] to the reasoned judgment of the District Court” “for any determination having underlying facts common to both proceedings,” while “tak[ing] care to consider and weigh every fact that differs between the two proceedings in coming to our overall determination.” *Id.*

In this case, the District Court has already considered the arguments presented

⁵ Mayer Brown does not dispute that an attorney-client relationship previously existed with LGE, as required by the first prong of the substantial relationship test, thus this response only focuses on the second prong of the test.

by LGE and engaged in a “painstaking analysis of the facts and precise application of precedent.” Ex. 2005 at 5 (quoting Ex. 2004 at 52). Moreover, in requesting permission to file its motion to disqualify MB, LGE acknowledged that its arguments to the Board are “essentially the same” arguments that it presented to the District Court and that there is “a significant amount of overlap.” Ex. 1102 at 9:4-20. Notably, LGE did not dispute MB’s characterization that “the argument[s] that were made by LG[E] a[t] the District Court . . . will be identical to the argument [LGE] intend[s] to make here.” *Id.* at 11:2-5.

Here, no new arguments or facts have been raised that were not previously considered by the District Court. Accordingly, the Board should defer to the efforts of the Magistrate and Judge Schroeder and deny LGE’s motion to disqualify.

B. Mayer Brown’s Alleged Access to LGE’s Confidential Information is Unrelated to the Validity of the Challenged Patents

Title 35 instructs that “[a] petitioner in an *inter partes* review may request to cancel as unpatentable 1 or more claims of a patent *only* on a ground that could be raised under section 102 or 103 *and only* on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b) (emphasis added). In other words, information considered by the Board during IPR proceedings is limited to publicly available prior art and any confidential information obtained by one party offers little

to no advantage in determining the validity of any challenged claim.

Notably, district courts “have found that a patentee’s need to use in an *inter partes* review its trial counsel who is familiar with litigation and already familiar with the prior art produced during the relevant litigation can outweigh an accused infringer’s concern for the risk of misuse of its confidential information.” 7 Annotated Patent Digest § 41:147.60 (2023). Specifically, “trial counsel has been granted the right to participate in the review, despite the applicability of an agreed upon prosecution bar,” but “has been barred from participating in the actual amending of claims” to protect against the “possible misuse of [the accused infringer’s] confidential information.” *Id.*⁶ While a prosecution bar is currently not applicable to this case, the same policy favors allowing Pantech to use its trial counsel during IPR proceedings.

⁶ See, e.g., *Lifetime Prod., Inc. v. Logan Outdoor Prod., LLC*, No. 1:21-cv-00156, 2022 WL 17182480, at *6 (D. Utah Nov. 22, 2022) (granting Lifetime’s motion for exemptions from the prosecution bar to permit “its litigation counsel to participate in IPR proceedings” but limiting counsel who accessed confidential information from “participat[ing] in drafting or amending claims in the IPR proceedings”); *X One, Inc. v. Uber Techs., Inc.*, No. 16CV06050LHKSVK, 2017 WL 1020982, at *3-4 (N.D. Cal. Mar. 16, 2017) (permitting trial counsel to participate in post-grant proceedings, but not in advising on claim amendments made in those proceedings); *Brit. Telecomm. PLC v. IAC/InterActiveCorp*, 330 F.R.D. 387, 395 (D. Del. 2019) (holding that litigation counsel given access to confidential information could participate in post-grant proceedings, but could *not* “participate in any way in drafting or amending claims in those proceedings”).

[REDACTED]

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Here, LGE alleges that MB “obtained access to confidential LGE information relating to each of the patents challenged in LGE’s IPRs in its representation of LGE in [REDACTED] *CCE*, *Core Wireless*, and *MTT*,” and should therefore be disqualified. Paper 8 at 10. However, MB’s alleged access to confidential LGE information does not outweigh Pantech’s desire to use its trial counsel during the IPR proceedings of the Challenged Patents because patent validity is based on prior art, not confidential information. *See NuCurrent Inc. v. Samsung Elecs. Co.*, No. 19cv798 (DCL), 2019 WL 2776950, at *4 (S.D.N.Y. July 2, 2019) (“IPR petitions challenge the validity of the [Patent Owner’s] patents based on prior art, not based on any Confidential Information disclosed to [Petitioner] pursuant to [an] NDA.”). Moreover, LGE’s argument that “[t]he invalidity and alleged infringement of Pantech’s patents are intertwined issues because ‘the claims must be interpreted and given the same meaning for purposes of both validity and infringement analyses,’” Paper 8 at 10 (citation omitted), is inapplicable to IPR proceedings that focus solely on validity.⁷

Accordingly, the Board should deny LGE’s motion to disqualify based on the

⁷ *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (explaining that the Board need only construe terms that are subject to a legitimate dispute); 83 Fed. Reg. 5340 at 51351, 51353 (recognizing that constructions proposed by parties before the PTAB and a district court may differ because parties may dispute different issues in each forum).

limiting nature of IPR proceedings to publicly available prior art.

C. Mayer Brown's Prior Representation of LGE is Not Disqualifying

Even if MB would have been precluded from representing Pantech absent a conflict waiver (which is not the case here, *see* Section IV.C.2), the valid Waiver Provision negates any conflict of interest and independently allows MB to proceed.

1. The Conflict Waiver is Valid and Applies to this Litigation

a. Under the Applicable Rules, a Sophisticated Client, Represented by Counsel, Can Give Informed Consent to a Comprehensive Waiver

The Waiver Provision fully complied with USPTO Rule 109 and ABA Rule 1.9's "informed written consent" requirements, and constituted a waiver of any conflict regarding MB's representation of Pantech in the current litigation. Whether a client's consent to a conflict waiver is informed necessarily focuses on the client's understanding of the scope of the waiver and the nature of the conflicts that it covers. The ABA, other leading bar associations, the Restatement, and many courts agree that sophisticated clients represented by counsel need far less specific disclosures to

render their consent to waiver conflicts sufficiently informed.⁸ This sensible standard recognizes that increasingly savvy and powerful corporate clients often conclude it is in their best interest to broadly waive both current and future conflicts in order to hire the counsel of their choice.

ABA Rule 1.9 allows a lawyer to represent a client notwithstanding a conflict with a former client if “the former client gives informed consent, confirmed in writing.” ABA Rule 1.9(b)(2). The comments to the ABA Rules instruct that “[t]he effectiveness of such waivers is generally determined by the extent to which the client reasonably understands the material risks that the waiver entails.” *Id.* at cmt. 9; ABA Rule 1.7, cmt. 22. “[I]f the client agrees to consent to a particular type of conflict with which the client is already familiar, then the consent ordinarily will be effective with regard to that type of conflict.” *Id.* And “if [a] client is an experienced

⁸ The Washington, D.C. Bar Association, for example, concluded that “[a]n advance waiver given by a client having independent counsel . . . available to review such actions presumptively is valid . . . even if general in character.” D.C. Bar Ass’n, Ethics Opn. 309 (2001). The Restatement (Third) of the Law Governing Lawyers also provides that “[i]nformed consent” requires that the “client have reasonably adequate information about the material risks” of a conflict. Rest.3d Law Governing Lawyers (2000) § 122(1). Thus, “[a] client’s open-ended agreement to consent to all conflicts” is effective if the client “possesses sophistication in the matter in question and has had the opportunity to receive independent legal advice about the consent.” *Id.* cmt. D. Many courts recognize this approach as reflecting the “national standard” for informed consent. *See, e.g., Galderma Labs., L.P. v. Actavis Mid Atlantic LLC*, 927 F.Supp.2d 390, 404 (N.D. Tex. 2013).

user of the legal services involved and is reasonably informed regarding the risk that a conflict may arise,” its consent to an advance waiver “is more likely to be effective, particularly if, e.g., the client is independently represented by other counsel in giving consent and the consent is limited to future conflicts unrelated to the subject of the representation.” *Id.*

b. LGE Gave Informed Written Consent Waiving the Alleged Conflict

The asserted conflict in this case arose more than five years after LGE decided to end its relationship with MB with knowledge and understanding that MB was representing clients with potentially adverse claims against LGE. In fact, before entering into the engagement agreement, MB informed LGE's IP General Counsel that “[MB] was representing Maxell Ltd. along with another Korean Company [Pantech].” Ex. 2001 at ¶ 9. He explained at that time “that neither of these representations presented a current conflict of interest, but that [MB clients] could potentially, in the future, be adverse to LGE.” *Id.* This direct communication was more than enough to establish the reasonably foreseeable types of future representations (*i.e.*, adverse patent infringement litigation involving LGE's smartphones) that could arise and the attendant risks, and thus that there was informed consent. And while the Waiver Provision does not specifically identify the

potential adverse parties in writing, that much was not required. Ex. 2012.

LGE's negotiated modifications to the Waiver Provision provides additional support and clarity regarding the consent and scope of the waiver to which LGE agreed. Specifically, the original draft of the Waiver Provision did not address conflicts concerning matters other than those [REDACTED] Ex. 2003 at 274. Recognizing the breadth of this waiver and understanding the risk associated with such a waiver, LGE first attempted to remove the waiver entirely. *See id.* at 278 [REDACTED]

[REDACTED]. However, following a discussion with MB, and multiple email exchanges, LGE ultimately conceded and agreed to a waiver based on a slight narrowing of the scope. In addition to waiving conflicts concerning all matters [REDACTED] LGE sought to include [REDACTED]

[REDACTED] *Id.* LGE's inclusion of a time component differentiated with waiver from the ABA Rules (as otherwise the two would be coextensive in scope), but also comports with the logical conclusion that, with the passage of time, any information acquired by MB attorneys, confidential or otherwise, would become outdated and not substantiate a conflict. *See* ABA Rule 1.9, cmt. 3

("Information acquired in a prior representation may have been rendered obsolete by the passage of time."). And ultimately, LGE agreed that five years was sufficiently remote in time to remove its concerns for any matter. *See* Ex. 2003 at 285. Thus, the ultimate scope of the conflict waiver was not only agreed to by LGE, but is the result of LGE's own proposals and negotiations.

LGE undeniably is a sophisticated and experienced user of legal services, and was represented by experienced in-house counsel during negotiations with MB regarding the Waiver Provision. LGE has employed leading law firms to handle its patent litigation disputes. It knew and appreciated the risk associated with agreeing to the Waiver Provision and was willing to agree to MB's adverse representation in order to obtain the services of MB.

c. The *Jenam* Matter is Completely Unrelated and No Other Matter is Relevant to the Inquiry

The technology at issue in this case is

And *Jenam* is the only relevant matter

Ex. 2003 at 285.

And because the current litigation is “not substantially related to” the *Jenam* matter (*i.e.*, the only matter for which MB was providing services to LGE at the time of the engagement), the waiver in MB’s International Terms likewise covers the asserted conflict. *See id.* at 290, A.9.5. Aside from asserting that *CCE*, *Core Wireless*, and *MTT* are “not ‘substantially unrelated,’” Paper 8 at 6, LGE does not present any evidence or argument regarding any relationship between the *Jenam* matter and the present IPR petitions because none exists. Indeed, as LGE is well aware, the accused functionalities in the *Jenam* matter were those of a third party, not those of LGE. *See, e.g.*, Ex. 2003 at 164 at ¶ 7 (defining “Accused Devices” as smartphones and tablets running). This is underscored by the fact that LGE moved to transfer the *Jenam* matter to the Northern District of California based on the fact that it was

⁹ While the District Court did not adopt either parties’ interpretation of the “past five (5) years,” it acknowledged the “logic of Pantech’s argument in favor of a ‘moving’ window, namely that with the passage of time, any technical information acquired by [MB] attorneys would become outdated and not substantiate a conflict.” Ex. 2004 at 31. This is the only logical interpretation of the Waiver Provision, and because the alleged conflict presented here was triggered at the earliest when LGE filed its IPR petitions on August 11, 2023, creating a need for Pantech to retain counsel, the *Jenam* matter is the only matter that the Board should consider in its analysis.

██████████, not LGE's technology that was at issue in the case.¹⁰

2. No Conflict Exists Based on Former Representation Because the Matters LGE Relies On are Not Substantially Related

In determining if the present and former matters are substantially related, courts have identified three relevant factors: ““(1) the factual similarities between the current and former representations, (2) the similarities between the legal question posed, and (3) the nature and extent of the attorney's involvement with the form representation.”” *Commonwealth Sci.*, 297 F. App'x at 975 (citation omitted). LGE has not demonstrated that these factors support disqualification.

LGE claims that MB's representation of Pantech is factually and legally similar to MB's prior representations of LGE in the ██████████ *CCE*, *Core Wireless*, and *MTT* matters. Paper 8 at 10. According to LGE, MB performed vast amounts of work for LGE on “each of the four prior matters [that] included overlapping products—and overlapping product functionalities—to those that Pantech accuses in the EDTX Case.” Paper 8 at 9. LGE broadly argues that “[t]hese technical overlaps implicating

¹⁰ See Ex. 2011 at ¶¶ 11-15 (confirming LGE's understanding that the technology at issue in *Jenam* was ██████████ technology (¶¶ 11-12), that LGE does not have any employees that design or develop such technology (¶ 13), that LGE does not have any employees that modify any aspect of the relevant source code (¶ 14), and the LGE does not have “any source code or internal, non-public technical documentation regarding” the relevant technology (¶ 15)).

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," *id.*, but LGE does not address the specific relationship of the accused functionality at issue here as compared to the accused functionality at issue in the numerous matters on which LGE relies. For example, LGE states that [REDACTED] *CCE* also involved alleged SEPs related to cellular standards specifications including the same technical specifications covering the same discrete issues that Pantech alleges the challenged patents cover here," and goes on to cite to similar standard specifications allegedly at issue across the matters. Paper 8 at 4. But LGE does not describe how the similar standards, or even the same specification, creates factual similarities—in particular, whether the specific functionality within the standard specifications that are at issue here were also at issue in any of these allegedly related matters.

By way of further example, LGE argues that "the infringement allegations in *CCE* [REDACTED] were based at least in part on the same 3GPP technical specifications upon which Pantech's infringement allegations for the '545 patent are based in the district court litigation (*e.g.*, TS 36.321 and 36.331 in *CCE* and TS 36.211, 36.213, 36.300, 36.321, and 36.331 in [REDACTED])." Paper 8 at 12. Even accepting these allegations as true—which they are not—LGE fails to provide any specificity. The 3GPP TS 36.321 specification itself consists of multiple releases, is over 100 pages

long, includes seven different section each with multiple subsections, dealing with the various nuances of the technology, and broadly covers “the E-UTRA MAC protocol.” *See generally* Ex. 2013 (3GPP TS 36.321 version 15.2.0 Release 15). Such generic allegations are insufficient for LGE to meets its high burden. Ex. 2004 at 43 (“Reliance on cellular standards to satisfy the substantial relationship test requires more than showing both matters involve the same standard technical specifications.”).¹¹ And the same is true for each instance where LGE attempts to show similarities between the SEPs at issue here and those at issue in [REDACTED] *CCE*.

For the non-SEPs in this case, LGE's allegations fare no better. For example, LGE argues that “the '631 patent, which relates to displaying applications and related content in response to user commands,” is similar to *Core Wireless* because those patents “relate to user interface design improvements that increase user efficiency, productivity, and convenience.” Paper 8 at 14-15 (citation omitted). These broad and vague allegations are not enough to show that the matters are even

¹¹ *See In re Am. Airlines, Inc.*, 972 F.2d 605, 614 (5th Cir. 1992) (“[A] substantial relationship may be found only after the moving party delineates with specificity the subject matters, issues and causes of action common to prior and current representations and the court engages in a painstaking analysis of the facts and precise application of precedent.” (internal quotation marks omitted)).

remotely similar, much less rise to the level of similarity that would warrant disqualification. See *Microsoft Corp. v. Commonwealth Sci. & Indus. Rsch. Organisation*, No. 6:06 CV 549, 2007 WL 4376104, at *7 (E.D. Tex. Dec. 13, 2007), *aff'd sub nom. Commonwealth Sci.*, 297 F. App'x 970 (“[T]he sole presence of related subject matter does not establish a substantial relationship.”).

LGE argues generally that certain MB attorneys' former representations were broad and extensive, noting the thousands of hours worked. Paper 8 at 2-3 (citing Ex. 1201 ¶ 6). Yet again, LGE only vaguely states that the matters “involved patents related to LGE's smartphone and cellular technology” and offers no evidence that any of the MB attorneys' prior work relates to the technology at issue in the present IPRs. *Id.* at 3. LGE has plainly failed to meet its burden.

V. CONCLUSION

For at least the foregoing reasons, the Board should deny Petitioner's motion to disqualify Mayer Brown LLP.

Patent Owner's Response to Petitioner's Motion to Disqualify Mayer Brown LLP
IPR2023-01267, -01268, -01269, -01270, -01272, - 01273

Dated: December 6, 2023

Respectfully submitted,

/Amanda S. Bonner Reg No 65224 /
Amanda S. Bonner (Reg. No. 65,224)
MAYER BROWN LLP
71 South Wacker Drive
Chicago, IL 60606
Telephone: (312) 782-0600
asbonner@mayerbrown.com

James A. Tripp Fussell III (Reg. No. 54,885)
Clark S. Bakewell (Reg. No. 71,615)
MAYER BROWN LLP
1999 K Street, NW
Washington DC 20006
Telephone: (202) 263-3000
jfussell@mayerbrown.com
cbakewell@mayerbrown.com

Attorneys for Patent Owner
PANTECH CORPORATION

[REDACTED]

Patent Owner's Response to Petitioner's Motion to Disqualify Mayer Brown LLP
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CERTIFICATE OF SERVICE

I hereby certify that on this 6th day of December, 2023, a copy of the attached **PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION TO DISQUALIFY MAYER BROWN LLP** was served by electronic mail to the attorneys of record, at the following addresses:

James L. Davis, Jr.

James.l.davis@ropesgray.com

Daniel W. Richards

Daniel.richards@ropesgray.com

Abed R. Balbaky

Abed.balbaky@ropesgray.com

LGE-Pantech-Ropes-IPR-Service@ropesgray.com

Respectfully submitted,

Date: December 6, 2023

By: /Amanda S. Bonner Reg No 65224/
Amanda S. Bonner (Reg. No. 65,224)
MAYER BROWN LLP