

Miscellaneous Docket No. [xx-xxxx]

**United States Court of Appeals
for the Federal Circuit**

IN RE LG ELECTRONICS INC. AND LG ELECTRONICS U.S.A., INC.,

Petitioners.

On Petition for a Writ of Mandamus to the
United States District Court for the
Eastern District of Texas

Case No. 5:22-cv-00113-RWS-JBB, Hon. Robert W. Schroeder III

**NON-CONFIDENTIAL LG ELECTRONICS INC. AND LG
ELECTRONICS U.S.A., INC.'S PETITION FOR WRIT OF MANDAMUS**

Douglas Hallward-Driemeier
ROPES & GRAY LLP
2099 Pennsylvania Avenue, N.W.
Washington, DC 20006-6807
Telephone: (202) 508-4600
Email: Douglas.Hallward-
Driemeier@ropesgray.com

Matthew R. Shapiro
ROPES & GRAY LLP
1211 Avenue of the Americas
New York, NY 10036-8704
Telephone: (212) 596-9000
Email:
Matthew.Shapiro@ropesgray.com

James R. Batchelder
David S. Chun
James L. Davis, Jr.
ROPES & GRAY LLP
1900 University Avenue, 6th Floor
East Palo Alto, CA 94303-2284
Telephone: (650) 617-4000
Email: James.Batchelder@ropesgray.com
Email: David.Chun@ropesgray.com
Email: James.L.Davis@ropesgray.com

Counsel for Petitioners

FORM 9. Certificate of Interest

Form 9 (p. 1)
March 2023**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT****CERTIFICATE OF INTEREST****Case Number** _____**Short Case Caption** In re LG Electronics Inc. and LG Electronics U.S.A., Inc.**Filing Party/Entity** LG Electronics Inc. and LG Electronics U.S.A., Inc.**Instructions:**

1. Complete each section of the form and select none or N/A if appropriate.
2. Please enter only one item per box; attach additional pages as needed, and check the box to indicate such pages are attached.
3. In answering Sections 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance.
4. Please do not duplicate entries within Section 5.
5. Counsel must file an amended Certificate of Interest within seven days after any information on this form changes. Fed. Cir. R. 47.4(c).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 09/11/2023Signature: /s/ Douglas Hallward-DriemeierName: Douglas Hallward-Driemeier

FORM 9. Certificate of Interest

Form 9 (p. 2)
March 2023

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).	3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities. ☒ None/Not Applicable	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities. ☐ None/Not Applicable
LG Electronics Inc.		LG Corporation
LG Electronics U.S.A., Inc.		LG Electronics Inc.

☐ Additional pages attached

FORM 9. Certificate of Interest

Form 9 (p. 3)
March 2023

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

☐ None/Not Applicable☐ Additional pages attached

Jennifer H. Doan, Haltom & Doan

Daniel W. Richards, Ropes & Gray LLP

Shong Yin, Ropes & Gray LLP

Kyle R. Akin, Haltom & Doan

Fan Zhang, Ropes & Gray LLP

Mariah Hornok, Haltom & Doan

Scott Taylor, Ropes & Gray LLP

5. Related Cases. Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

☒ Yes (file separate notice; see below) ☐ No ☐ N/A (amicus/movant)

If yes, concurrently file a separate Notice of Related Case Information that complies with Fed. Cir. R. 47.5(b). **Please do not duplicate information.** This separate Notice must only be filed with the first Certificate of Interest or, subsequently, if information changes during the pendency of the appeal. Fed. Cir. R. 47.5(b).

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

☒ None/Not Applicable☐ Additional pages attached

~~CONFIDENTIAL MATERIAL OMITTED~~

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TABLE OF ABBREVIATIONS

Term	Meaning
LGE	LG Electronics Inc. and LG Electronics U.S.A., Inc.
Mayer Brown	Mayer Brown LLP
Pantech	Pantech Corporation and Pantech Wireless, LLC
Third Party	Arbiter of Arbitration, Case No. Case Number (Confidential arbitration between LGE and Third Party)
CCE	<i>Cellular Comm's. Equip. v. LG Electronics, Inc.</i> , Nos. 6:13-cv-00508, 6:14-cv-00982, 6:16-cv-00365 (E.D. Tex.)
Core Wireless	<i>Core Wireless Licensing v. LG Electronics, Inc.</i> , No. 2:14-cv-00911 (E.D. Tex.)
MTT	<i>Mobile Tele. Tech. v. LG Electronics, Inc.</i> , No. 2:13-cv-00947 (E.D. Tex.)
Jenam	<i>Jenam Tech, L.L.C. v. LG Electronics, Inc.</i> , No. 4:19-cv-00249 (E.D. Tex.)
Pantech	<i>Pantech Corp. v. LG Electronics Inc.</i> , No. 5:22-cv-00113 (E.D. Tex.)
SEP	Standard Essential Patent
TS	Technical Specification
Motion to Disqualify	Defendants' Motion to Disqualify Mayer Brown LLP
ABA	American Bar Association
Rule 1.09	Texas Disciplinary Rule of Professional Conduct 1.09

RELIEF SOUGHT

Petitioners LG Electronics Inc. and LG Electronics U.S.A., Inc. (“LGE”) respectfully seek a writ of mandamus directing the U.S. District Court for the Eastern District of Texas to (1) vacate the portions of its Order (Appx1-28) denying LGE’s Motion for Disqualification (Appx305-325) and (2) disqualify Mayer Brown LLP (“Mayer Brown”) from representing Pantech Corporation and Pantech Wireless, LLC (“Pantech”) in this matter.

STATEMENT OF JURISDICTION

This Court has jurisdiction under the All Writs Act, 28 U.S.C. § 1651. Because the petition seeks a writ of mandamus in a patent action, this Court has exclusive jurisdiction under 28 U.S.C. § 1295.

QUESTIONS PRESENTED

1. Whether, regarding two prior matters that clearly overlap with the instant case, the district court erred by placing the burden on LGE to show that contractual waiver did not apply even though Mayer Brown raised waiver as a defense to disqualification and the absence of waiver followed necessarily from the substantive overlap between the prior and current matters.

2. Whether the district court erred in finding no substantial relationship between two representations when it found a substantial relationship between the technology in each matter, and Fifth Circuit precedent provides that a substantial relationship between the subject matter of a prior and current matter is disqualifying.

3. Whether the district court erred by bifurcating and disqualifying Mayer Brown as to just one of the seven patents at issue where it found that there was a conflict of interest between the present case and a prior matter.

INTRODUCTION

For nearly a decade, LGE retained Mayer Brown as its go-to patent counsel to defend against allegations of infringement accusing LGE's cellular technology. This representation spanned at least eight separate matters in district courts, the ITC, and international arbitration. Appx32 n.2 (citing Appx329-330). LGE, believing Mayer Brown to be a faithful partner, shared highly confidential technical materials including specifications, product documentation, and source code, as well as financial information, business practices, licensing policies, market information, and licenses. Mayer Brown learned the ins and outs of LGE's products, business, and preferred litigation strategies. And then, after spending years gaining LGE's trust, Mayer Brown blindsided LGE when, on behalf of Pantech, it sued LGE on the very same products and features and during overlapping damages periods as to its previous representation of LGE.

Mandamus is an extraordinary remedy, but one that is justified under the extraordinary circumstances presented here. The district court made clear and indisputable mistakes in denying LGE's request to disqualify Mayer Brown from this matter. First, despite acknowledging the conflict of interest, the district court

improperly placed the burden on LGE to prove that there was ***not*** waiver of the conflict, rather than requiring Mayer Brown to substantiate its own defense. Second, despite finding that a prior case involved substantially related technology, the district court held that the earlier case was not a substantially related matter. Third, after correctly finding that a prior case presented a conflict, the district court improperly disqualified Mayer Brown as to just one of the patents-at-issue here, rather than across the matter as a whole. Each of these decisions by the district court are in defiance of Fifth Circuit precedent and conflict with the findings of other courts across the country.

Absent a writ of mandamus, LGE has no way to prevent the irreparable harm that it will suffer if Mayer Brown is allowed to continue to sue LGE regarding the same products and features for which LGE had previously shared its confidences. This Court should issue the writ to correct the district court's mistakes and to provide clear guidance on the ethical obligations owed by attorneys to their former clients.

FACTUAL BACKGROUND AND PROCEDURAL HISTORY

A. Before Suing LGE on Cellular Technology, Mayer Brown Served as LGE's Patent Counsel in Numerous Cellular Technology Matters

Between 2012-2020, Mayer Brown served as counsel to LGE on at least five matters that involved smartphones and wireless technology, including products and

features that Pantech accuses of infringement in this case. Appx32.¹ These matters include:

1. **Arbiter** of Arbitration, **Arbiter** Case No. **Case Number**
(Confidential arbitration between LGE and **Third Party**
)
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”)
5. *Jenam Tech, L.L.C. v. LG Electronics, Inc.*, No. 4:19-cv-00249 (E.D. Tex.) (“Jenam”)

Appx32-33. LGE objects to Mayer Brown’s representation in *Pantech* based on its former representation of LGE in four of the above matters: **Third Party**, *CCE*, *Core Wireless*, and *MTT*. As the district court credited, through Mayer Brown’s work on these cases, “[c]ollectively, these attorneys representing Pantech previously spent thousands of hours representing LGE on similar patent matters and had access to

¹ Mayer Brown also represented LGE in three additional cellular technology matters not at issue here. Appx32 (citing Appx329-330).

volumes of LGE Confidential Information.” Appx33 (citing Appx338-345). Mayer Brown’s attorneys “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 this matter.” Appx33 (citing Appx329-330). Multiple Mayer Brown attorneys who now represent Pantech were counsel for LGE in these matters. Appx32-33 (table showing overlap between prior and current counsel); Appx329-330.

1. Third Party

Between Date and Date, Mayer Brown defended LGE in confidential arbitration regarding LGE’s purported infringement of Third Party alleged standard essential patents (“SEPs”). Appx32-33, Appx77 (citing Appx335). At issue in Third Party were “hundreds of patent families allegedly directed to 3G and 4G LTE cellular network technology, approximately 84 of which were substantively analyzed by Mayer Brown.” Appx77 (citing Appx335-336). Like Third Party, Pantech accuses LGE of infringing alleged SEPs directed to 3G and 4G technology. Indeed, the claims that Mayer Brown analyzed in Third Party related to the same technical specifications (“TS”) dealing with discrete issues in those standards, that form the basis for Pantech’s infringement assertion here. For example, Pantech alleges infringement through the same specifications pertaining to (1) carrier aggregation functionality (3GPP TS 36.213, TS 36.321, 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). Appx77 (citing Appx335-336), Appx312. Throughout its representation of LGE, “Mayer Brown was ‘permitted to question LGE in-house personnel, as well as LGE suppliers and partners’ concerning LGE hardware and software and was provided access to ‘LGE source code at least once.’” Appx78 (citing Appx335-336). Moreover, “Mayer Brown was also provided confidential financial and market information and ‘learned LGE’s policies and procedures for SEP and patent licensing for smartphone and cellular technology,’” including access to at least two licenses. Appx78 (citing Appx332, Appx457-459, Appx464). Thus, as the district court found, “LGE shows Mayer Brown’s representation of LGE in the Third Party matter was extensive.” Appx77.

2. *CCE*

From June 2013 through August 2016, Mayer Brown defended LGE against infringement allegations concerning ten alleged SEPs in three separate matters. Appx32-33, Appx70 (citing Appx333-334). Like Third Party, *CCE* involved SEPs involving the same technical specifications of the same standards that Pantech accuses including 3GPP TS 36.213, TS 36.321, and TS 36.331 (discussed above), as well as TS 38.300 and TS 38.331. Appx70-71, Appx311-312. Furthermore, the complaints brought by CCE “accused specific LGE LTE devices of infringement that are also accused by Pantech here.” Appx70 (citing Appx333-334). Through

CCE, Mayer Brown attorneys “gained access to the entirety of the source code for LGE’s messaging app and user interface,” which are accused of infringement in the instant case. Appx15-16. Mayer Brown also gained access to LGE’s baseband source code that interacts with and operates the chip responsible for communicating with the cellular network for certain products now accused of infringement. Appx340-341. As such, in its defense of LGE, “Mayer Brown received confidential information in *CCE*, including product documentation and source code, concerning products that are also accused in the *Pantech* matter.” Appx70 (citing Appx311, Appx450-451, Appx462-463).

3. *Core Wireless*

Mayer Brown represented LGE against allegations of patent infringement involving two patents in *Core Wireless* over the period spanning September 2014 to November 2020. Appx32-33, Appx74 (citing Appx334). As in Third Party and *CCE*, the *Core Wireless* matter involved many of the same accused products as here. Appx74-75 (citing Appx334, Appx117-118). The accused feature in *Core Wireless* was the same method of launching and presenting an interactive display that Pantech now accuses. Appx75 (citing Appx699, Appx521-522).

Mayer Brown alleges that its role in *Core Wireless* was limited to monitoring the case to advise on its potential impact on the Third Party arbitration. Appx76, Appx517-518). Nonetheless, two Mayer Brown attorneys made appearances in

Core Wireless for the very purpose of gaining access to the confidential information in the docket, which included LGE's. Appx76. Accordingly, the district court found that Mayer Brown "presents no persuasive argument or controlling law that its role, admittedly limited, is not considered 'representation'" of LGE. Appx76-77.

4. *MTT*

In *MTT*, Mayer Brown attorneys defended LGE against infringement allegations concerning three patents that accused not only the same accused products as *Pantech*, but also "the exact same messaging application." Appx73 (citing Appx543). In comparing the claims from *MTT* with those of *Pantech*, the district court found that both matters involved "the same messaging app on the same devices," "both matters concern how the app displays message content," and "[b]oth cited claims require analyzing the messages for additional information to display." Appx74. The district court agreed with LGE that Mayer Brown's representation in *MTT* was a conflict of interest, and ordered Mayer Brown disqualified from representing Pantech with respect to U.S. Patent No. 7,283,839 ("the '839 Patent"). Appx27. However, the district court did not order disqualification with respect to the other six patents that Pantech asserts in this litigation.²

² U.S. Patent Nos. 9,136,924; 9,854,545; 10,869,247; 9,313,809; 9,065,486; and 9,575,631. Appx66 (citing Appx118-120).

5. *Jenam*

Unlike the other matters, for purposes of this briefing, LGE does not base its objection to Mayer Brown's representation in *Pantech* on its former representation of LGE in *Jenam*, which focused primarily on accused Third Party functionality implemented in LGE devices. Nonetheless, *Jenam* remains relevant for its contractual provision in which, as part of a joint representation with another defendant, Mayer Brown requested that LGE waive conflicts for future cases "substantially unrelated to the technology involved" in Mayer Brown's former representations. In full, the contractual provision at issue reads:

Certain other clients of the Firm may, in the future, seek the Firm's advice and representation regarding possible matters that are adverse to the Clients other than Third Party, including in matters that may result in litigation, arbitration, or other contentious matters against the Clients other than Third Party. By signing below, each Client other than Third Party confirms that with full knowledge of the foregoing, and having been informed of and had an opportunity to question and consider the risks of permitting the conflicting representation or representations, it, on behalf of itself and its affiliates, consents to the Firm's representation of other clients adverse to the Clients other than Third Party, 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 the Clients other than Third Party, and waives any conflict of interest arising from such matters for the Firm's other clients. This waiver is in addition to the provisions of paragraph A.9.5 of the International Terms.

Appx3 (citing Appx360) (emphasis omitted). As discussed in greater detail below, the district court found that this waiver provision applied to Third Party and *CCE*, but not to *Core Wireless* or *MTT*.

B. Despite the Substantial Overlap Between the Prior Matters and *Pantech*, the District Court Refused to Disqualify Mayer Brown on Six of the Seven Asserted Patents

Pantech first approached LGE about a license in September 2020, and LGE learned of Mayer Brown's representation of Pantech in November 2020. Appx35 (citing Appx433, Appx328). After Mayer Brown contacted LGE directly on behalf of Pantech, in January 2021 LGE told Mayer Brown there was a conflict of interest, and, in March 2021, LGE formally objected to Mayer Brown's involvement. Appx35 (citing Appx328). From April 2021 through the filing of the litigation, Mayer Brown withdrew from the discussions and LGE dealt with Pantech directly. Appx36 (citing Appx328, Appx437, Appx495-507), Appx606.

Pantech filed suit against LGE on September 2, 2022—Case No. 5:22-cv-00113 (E.D. Tex.) ("*Pantech*"). Appx37 (citing Appx328, Appx434). After LGE's outside counsel was retained on October 24, 2022, it promptly identified the conflict issue and then raised it with Mayer Brown by December 2, 2022. Appx37 (citing Appx328). LGE filed its Motion to Disqualify Mayer Brown on December 30, 2022 ("Motion to Disqualify"). Appx37.

Magistrate Judge Baxter held a hearing concerning the Motion to Disqualify on February 1, 2023. Appx37. On April 27, 2023, Magistrate Judge Baxter issued an order denying the Motion in full. Appx29-91. The Magistrate Order found that despite Mayer Brown's substantial representation of LGE in the Third Party and *CCE* matters, LGE waived its objections through the *Jenam* contractual provision. Appx80. For *Core Wireless*, the Magistrate Order found that, though the litigation involved substantially related *technology*, and was therefore not waived, the *matter* was not substantially related, and thus there was no need for disqualification. Appx83 (citing Appx518, Appx331). Finally, for *MTT*, the Magistrate Order found a conflict of interest that "potentially subjects Mayer Brown to disqualification only as to *MTT*," Appx21, but still failed to order disqualification due to "societal interest factors." Appx86-87.

Both parties filed and briefed objections to the Magistrate Order. Appx705-756. On August 15, 2023, Judge Schroeder held a hearing, and on August 28, the district court issued its Order, overruling the Magistrate Order in part and disqualifying Mayer Brown on the '839 patent, but otherwise failing to disqualify Mayer Brown with respect to the other six patents-at-issue. Appx1-28. On September 1, 2023, the district court issued an Order severing the '839 patent from the case and maintaining the relief granted in its August Order. Appx1143-1148.

Following the district court's decision, LGE promptly filed this petition for writ of mandamus.

STANDARD OF REVIEW

Under the All Writs Act, the Court “may issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of law.” 28 U.S.C. § 1651(a). The Supreme Court has explained that a writ of mandamus may issue if: (1) the “right to issuance of the writ is ‘clear and indisputable,’” (2) the party seeking relief has “no other adequate means to attain the relief,” and (3) “writ is appropriate under the circumstances.” *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 381 (2004).

Questions involving attorney disqualification “involve procedural matters which are not unique to patent cases.” *Picker Int’l, Inc. v. Varian Assocs., Inc.*, 869 F.2d 578, 580 (Fed. Cir. 1989). Accordingly, the law of the regional circuit court applies, here the Fifth Circuit. *Id.* at 581. The Fifth Circuit has held that “a writ of mandamus will be available in certain cases to obtain immediate review of a district court’s denial of a disqualification motion.” *In re Am. Airlines, Inc.*, 972 F.2d 605, 608 (5th Cir. 1992) (citing *In re Dresser Indus., Inc.*, 972 F.2d 540 (5th Cir. 1992)). Attorney disqualification qualifies for mandamus when “the district court’s order was not a mere discretionary one but rather turns on legal questions appropriate for

appellate review” and where “the issues here also have importance beyond the immediate lawsuit.” *Am. Airlines*, 972 F.2d at 609 (citation omitted).

REASONS FOR ISSUING THE WRIT

The writ of mandamus should issue because all three requirements are satisfied here. First, Mayer Brown’s extensive representation of LGE in four overlapping cases necessitates its disqualification in this matter, and it was clear and indisputable legal error for the district court to find otherwise. Second, after the district court’s Order denying disqualification as to six of the seven patents-in-suit, LGE has no other adequate means by which it may avoid Mayer Brown’s continued improper involvement in this matter. Third and finally, as in previous Fifth Circuit disqualification cases, the issues here have importance beyond the immediate lawsuit, including “the proper interpretation and application of ethical standards.” *Am. Airlines*, 972 F.2d at 609.

I. LGE Has a Clear and Indisputable Right to the Writ

The relevant ethical rules and provisions of Fifth Circuit law make clear that Mayer Brown must be disqualified from representing Pantech in this matter. “Motions to disqualify are substantive motions affecting the rights of the parties and are determined by applying standards developed under *federal law*.” *Am. Airlines*, 972 F.2d at 610 (emphasis original) (quoting *Dresser*, 972 F.2d at 543). When considering a motion to disqualify, a court looks to (1) the local rules in the district;

(2) the American Bar Association's ("ABA") Model Rules of Professional Conduct/Model Code of Professional Responsibility; and (3) the state rules of conduct. *Horaist v. Doctor's Hosp. of Opelousas*, 255 F.3d 261, 266 (5th Cir. 2001). As the United States District Court for the Eastern District of Texas's local rules refer back to the state rules of conduct, the ABA Model Rules and the Texas state rules provide the applicable requirements. *See* E.D. Tex. L. R. AT-2(a). Further, the Fifth Circuit has held that "ABA Rule 1.9 is identical to Texas Rule 1.09 in all important respects." *Am. Airlines*, 972 F.2d at 615 n.2. Thus, the relevant rule is Texas Disciplinary Rule of Professional Conduct 1.09 ("Rule 1.09"):

(a) Without prior consent, a lawyer who personally has formerly represented a client in a matter shall not thereafter represent another person in a matter adverse to the former client:

...

(2) if the representation in reasonable probability will involve a violation of Rule 1.05; or

(3) if it is the same or a substantially related matter.

Tex. R. Disc. Pro. Conduct 1.09. The cross-referenced Rule 1.05 prohibits a lawyer's use of confidential information obtained from a former client to that client's disadvantage. *See* Tex. R. Disc. Pro. Conduct 1.05. Therefore, there are two circumstances in which disqualification is mandated: "if the current representation in reasonable probability will involve the use of confidential information *or* if the

current matter is substantially related to the matters in which the lawyer has represented the former client.” *Am. Airlines*, 972 F.2d at 615 (emphasis original). In light of the “obvious conflicts of interest” (Appx1) noted by the district court here, Mayer Brown should have been disqualified.

Where an attorney seeks to represent a client in a matter that would otherwise be a conflict of interest, such a conflict is waived only if the client gives “informed consent, confirmed in writing” allowing the attorney to work on the adverse matter. *See* ABA Model R. Pro. Conduct 1.7(b)(4) (Am. Bar Ass’n 2023). While it is possible to give informed consent to waive future conflicts of interest, courts have cautioned that “a specific waiver of a particular type of conflict has the greatest likelihood of being effective” and “a general and open-ended waiver is likely to be ineffective.” *Galderma Lab’ys, L.P. v. Actavis Mid Atl. LLC*, 927 F. Supp. 2d 390, 396-97 (N.D. Tex. 2013). Though it is generally the movant’s burden to “establish that there is a conflict of interest under the applicable ethics standards and if so, that disqualification is the proper remedy,” that burden flips to the party “rais[ing] [a] defense” of waiver of future conflicts to show that the waiver applies. *Id.* at 398; *see also Dresser*, 972 F.2d at 545 (finding that in the analogous issue of waiver for “exceptional circumstances,” it was the attorney’s burden to show that such circumstances existed).

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A. The District Court Legally Erred in Denying LGE's Motion to Disqualify Mayer Brown Based on [Third Party] and CCE

Mayer Brown should be disqualified because of the “obvious conflicts of interest” between Mayer Brown’s representations of LGE in the [Third Party]/CCE matters, and its adverse representation here. Appx1. Nevertheless, the district court’s final decision holds that LGE waived these conflicts of interest with respect to [Third Party] and CCE. The district court reached this conclusion by flipping the burden on LGE to show that there was not a waiver of these conflicts of interest, rather than placing the burden on Mayer Brown to justify its defense that informed consent was given to waive the conflict of interest with respect to *Pantech*. This was legal error.

The relevant portion of the *Jenam* provision that the district court determined to be informed consent to waive future conflicts states that:

By signing below [LGE] . . . consents to the Firm’s representation of other clients adverse to [LGE] in future matters ***substantially unrelated to the technology involved in . . . 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.

Appx3 (citing Appx360).³ Because Mayer Brown raised contractual waiver by informed consent as a defense to the conflicts of interest between the [Third Party]/CCE

³ All emphasis added unless otherwise noted.

matters and *Pantech*, it was Mayer Brown's burden to show that the technology involved in the *Pantech* matter was "substantially unrelated" to the technology involved in the [Third Party] and *CCE* matters. See *Galderma Lab's*, 927 F. Supp. 2d at 396; *Dresser*, 972 F.2d at 545; see also *In re Fisker Auto. Holdings, Inc. S'holder Litig.*, No. CV 13-2100, 2018 WL 3991470, at *3 (D. Del. Aug. 20, 2018) ("Although the party seeking disqualification bears the ultimate burden of proof on a motion to disqualify, the burden shifts to the attorney seeking permission to pursue an otherwise impermissible dual representation in the context of the informed consent analysis.").

Instead of placing the burden on Mayer Brown to show that the technology in *Pantech* is substantially **unrelated** to [Third Party] and *CCE*, the court instead put the burden on LGE to show that the technology in the prior matters is substantially **related** to *Pantech*. See Appx70 ("LGE's argument fails . . . [s]imply showing product overlap is not sufficient to show both cases involve substantially related technology"); Appx72 n.11 ("LGE fails to show both patents involve more than uplink, which is still too broad and ubiquitous to conclude the technology in the matters is substantially related for purposes of disqualification"); Appx78 ("LGE cannot show that [Third Party] and *Pantech* involve substantially related technology"); Appx79 ("LGE's arguments concerning financial information . . . [do] not show the technologies involved in both matters are substantially related."); Appx15 ("The

record does not show the technology involved in analyzing LGE confidential information, related to the broad standards at issue in [Third Party], is substantially related to the technology involved in the instant case.”). The district court’s analysis improperly flips the burden onto LGE to show that a waiver did not apply and raises the hurdle for LGE to meet, in addition to applying an overly narrow test for substantially related technology untied to the plain language of the contract. *See* Appx709-713. Where it should have been Mayer Brown’s requirement to establish that the technology underlying the prior cases was ***substantially unrelated***, as stated in the *Jenam* provision, instead it became LGE’s burden to show that the technology was ***substantially related***.⁴

Under the proper legal analysis, Mayer Brown needed to introduce evidence that the technologies involved in the prior matters were substantially unrelated to this case to show that its defense of waiver did apply. If, for example, the technologies were somewhat related (i.e., more than substantially unrelated, but less than substantially related), Mayer Brown could not show the technologies involved

⁴ This *Jenam* provision differs from the Rule 1.09 requirement to show a substantial relationship for disqualification. While a substantial relationship under the ethical rule can be shown through overlap on any facet of the cases (e.g., licensing strategy), the *Jenam* provision looks only to the relationship between the ***technology*** involved in the two matters. The *Jenam* provision also waived certain conflicts during the pendency of Mayer Brown’s representation of LGE. *See* ABA Model R. Prof. Conduct 1.7(a)(1) (Am. Bar Ass’n 2023).

were substantially unrelated under the *Jenam* provision and thus waiver should not apply. However, in such circumstance, flipping the burden to LGE and raising the requirement as the district court did would mean LGE could not prove that the technologies involved were substantially related.⁵ Because the district court improperly flipped the burden onto LGE to disprove a defense, and because it raised the hurdle for LGE beyond that of the contractual language, the district court committed clear and indisputable legal error that this Court should rectify.

The district court fundamentally misunderstood LGE’s argument regarding burden. In justifying its decision to require LGE to show that waiver did not apply, the district court claimed that “LGE conflates the burden Mayer Brown would bear if informed consent was at issue with the ultimate burden that LGE bears to justify disqualification” and that “[n]owhere in its briefing does LGE argue the specific waiver is ineffective for lack of informed consent.” Appx14. But LGE’s argument is not that the burden is on Mayer Brown because informed consent is at issue, rather, the burden is on Mayer Brown because it is raising waiver as a *defense* to avoid disqualification and the burden is on the party raising the defense to justify that defense. This is exactly the same as the other informed consent cases on which LGE

⁵ By way of analogy, flipping the burden in a patent validity context would introduce the same error—it is not the plaintiff’s burden to provide evidence that claims are valid by clear and convincing evidence, rather the defendant must prove invalidity by clear and convincing evidence.

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relied. *See Galderma Lab's*, 927 F. Supp. 2d at 398 (“Because V & E has raised the issue in its defense, the Court concludes that V & E has the burden to show that Galderma gave informed consent.”); *see also Fisker Auto. Holdings*, 2018 WL 3991470, at *3 n.5; *Celgene Corp. v. KV Pharm. Co.*, No. 07-4819, 2008 WL 2937415, at *6 (D.N.J. July 29, 2008). And this requirement is no different in any other area of law. *See* James B. Thayer, *The Burden of Proof*, 4 Harv. L. Rev. 45, 57 (1890) (“In general, he who seeks to move a court to take action in his favor, whether as an original plaintiff whose facts are merely denied, or as a defendant, who, in setting up an affirmative defence, has the rôle of actor (*reus excipiendo fit actor*), — must satisfy the court of the truth and adequacy of the grounds of his claim, both in point of fact and law.”).

The district court’s findings show that if it had applied the proper legal analysis—i.e., if it had first applied the two prongs of Rule 1.09 to determine whether disqualification was required either because of the substantial relationship between Third Party/CCE and *Pantech* or because of the confidential information to which Mayer Brown gained access in those cases, and then placed the burden on Mayer Brown to justify its defense of waiver—it would have determined that disqualification was merited.

The district court’s admission that there would have been a conflict of interest but for the waiver provision shows that a substantial relationship existed. Appx1.

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A substantial relationship exists on the district court's findings that Third Party and CCE involved the same portions of the cellular standards (Appx70, Appx77), same accused products (Appx70, Appx77), overlapping accused features (Appx77), and overlapping financial and market information (Appx78). All of these are factors that courts have considered relevant to whether a substantial relationship exists in disqualification matters. *See, e.g., Micrografx, LLC v. Samsung Telecommunications Am., LLC*, No. 3:13-CV-3599, 2014 WL 12586177, at *3 (N.D. Tex. Mar. 7, 2014) (substantial relationship where "certain legal issues and evidence relating to Samsung Galaxy graphic libraries, software, and operating system may be relevant in both litigations"); *Dynamic 3D Geosolutions LLC v. Schlumberger Ltd. (Schlumberger N.V.)*, 837 F.3d 1280, 1286 (Fed. Cir. 2016) (substantial relationship where attorney "specifically evaluat[ed] a product later accused of infringement"); *W.L. Gore & Assocs., Inc. v. Int'l Med. Prosthetics Rsch. Assocs., Inc.*, 745 F.2d 1463, 1467 (Fed. Cir. 1984) (disqualification proper where "[i]nadvertent disclosure to him of . . . confidences cannot be ruled out," even where the attorney "never actually worked on [prior] matters or looked at files"); *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 representations shared a PTO subclass).

And the district court similarly found that Mayer Brown gained access to relevant confidential information in Third Party and *CCE*. See Appx70 (“Mayer Brown received confidential information in *CCE*, including product documentation and source code, concerning products that are also accused in the *Pantech* matter.”); Appx78 (“Mayer Brown was also provided confidential financial and market information and ‘learned LGE’s policies and procedures for SEP and patent licensing for smartphone and cellular technology.’”) (citing Appx336). Notably, the district court refused even to consider whether confidential information merited disqualification, but instead “decline[d] to apply that fact under the test set out by the language in the parties’ contractually-created conflict waiver.” Appx11.

The district court committed clear and indisputable legal error by failing to adhere to the well-established rule that a party raising a defense has the burden of proof on that defense. The proper legal analysis here was to begin with LGE’s prima facie case showing that Mayer Brown’s involvement in the Third Party/*CCE* matters were disqualifying conflicts of interests, and to then require Mayer Brown to prove that the past representations were “substantially unrelated” such that waiver could apply. Given the district court’s own findings that show the existence of a substantial relationship between the prior matters and current representation, Mayer Brown did

not and could not have made such a showing. Nevertheless, the district court distorted the analysis in a fashion that led it to allow Mayer Brown to continue as counsel, even as it admitted that “the facts highlighted by LGE here suggest that Mayer Brown’s actions would amount to obvious conflicts of interest.” Appx1. This Court should issue the writ of mandamus to correct the district court’s mistaken holding.

B. The District Court Legally Erred in Denying LGE’s Motion to Disqualify Mayer Brown Based on *Core Wireless*

Mayer Brown should be disqualified from representing Pantech based on its prior representation of LGE in *Core Wireless*, which the district court correctly found involved substantially related technology, such that the *Jenam* provision did not apply. Appx77. In particular, though the district court admitted that “the technology in *Core Wireless* and the instant case are substantially related under the conflict waiver,” it went on to hold that “counsel’s *representations* in *Core Wireless* and the instant case are not substantially related under the applicable case law.” Appx17. Because this finding was improper under the legal test for a disqualifying substantial relationship, the writ should issue.

Mayer Brown’s representation in *Core Wireless* meets both prongs of the substantial relationship test under Rule 1.09, namely that there was “1) an actual attorney-client relationship between the moving party and the attorney he seeks to

disqualify and 2) a substantial relationship between the subject matter of the former and present representations.” *Am. Airlines*, 972 F.2d at 614. The district court found that, despite Mayer Brown’s arguments to the contrary, its role in the *Core Wireless* matter constituted a “representation,” as laid out in the first prong. Appx76-77. And the district court found a substantial relationship between the technology (i.e., “the subject matter”) of the former and past representations. Appx83 (“the technology involved is substantially related”); Appx17. No more is needed. Because Mayer Brown’s representation in *Core Wireless* meets the substantial relationship test, Mayer Brown should be disqualified under Rule 1.09.

The district court’s distinction between “substantially related technology” and “substantially related representations” was legal error given *American Airlines*’ clear and unambiguous statement that the focus of the substantial relationship is “the **subject matter** of the former and present representations.” *Am. Airlines*, 972 F.2d at 614. Far from considering the subject matter of *Core Wireless*, the district court’s stated reasoning for failing to disqualify Mayer Brown was because of “the limited scope of Mayer Brown’s involvement in *Core Wireless*.” Appx17. But the scope of Mayer Brown’s involvement was properly considered at the first prong of the substantial relationship test—whether there was “an actual attorney-client relationship”—and the district court correctly found that there was such a relationship. *Am. Airlines*, 972 F.2d at 614.

The reason why the focus of the substantial relationship test is on overlapping subject matter, rather than the extent of attorney involvement, is because “[o]nce it is established that the prior matters are substantially related to the present case, ‘the court will irrebuttably presume that relevant confidential information was disclosed during the former period of representation.’” *Id.* (citation omitted). Here, Mayer Brown’s stated reason for entering appearances in the *Core Wireless* matter was “to monitor the filings so that Mayer Brown could consider its impact on the Third Party arbitration.” Appx82 (citing Appx518). The only reason for Mayer Brown to enter appearances in the case, rather than monitoring the public docket, was to receive **non-public** information related to *Core Wireless*. And indeed, non-public information was provided to Mayer Brown in this representation. Appx20 (“sealed filings related to infringement and damages in *Core Wireless* would have been [required to be] served on [Mayer Brown] under the local rules”); Appx714 n.6.⁶

Moreover, because the same Mayer Brown attorneys involved in this matter had access to and therefore are presumed to have received non-public information

⁶ Mayer Brown claimed that it received no confidential information in *Core Wireless* and the district court credited this representation, despite Mayer Brown’s stated purpose of gaining access to this record and local rules requiring the service of the confidential materials (including LGE’s information) on Mayer Brown. Appx20-21 (citing Appx518); Appx714 n.6. Moreover, the point of the substantial relationship test is to avoid such he-said-she-said arguments through the irrebuttable presumption that confidential information was shared in a prior representation. *Am. Airlines*, 972 F.2d at 614.

in the *Core Wireless* representation, the district court's reasoning for considering the scope of Mayer Brown's involvement in *Core Wireless* fails. The district court relies on a statement in *Power Mosfet Techs., L.L.C. v. Siemens AG* that "some courts" consider the "nature and extent of the attorney's involvement with the former representation" in determining whether litigation is substantially related. *See* No. 2:99-CV-168, 2002 WL 32785219, at *2 (E.D. Tex. Sept. 30, 2002). But, besides contradicting the binding authority of *American Airlines*, *Power Mosfet* cites a California case that explains that the extent of attorney involvement is one factor relevant to determining "[w]hether confidential, material information would normally have been imparted to the attorney." *Dieter v. Regents of Univ. of California*, 963 F. Supp. 908, 911-12 (E.D. Cal. 1997). Here, access to non-public information was the very purpose of Mayer Brown's appearance in the matter.

Regardless of whether Mayer Brown's involvement in *Core Wireless* was limited, under the binding *American Airlines* test, it is a substantially related matter for which disqualification is required under Rule 1.09. The district court's findings make clear that both prongs of *American Airlines* were satisfied. Because the district court committed legal error, the writ should issue to correct this mistake.

C. The District Court Legally Erred in Only Partially Disqualifying Mayer Brown Based on *MTT*

As the district court correctly found, Mayer Brown’s representation in *MTT* met the substantial relationship test and was a conflict of interest that was not waived. *See* Appx85 (“*MTT* is a substantially related matter”); Appx74 (“*MTT* falls outside the scope of the specific waiver provision in the *Jenam* Engagement Letter”). However, the district court only partially disqualified Mayer Brown because “LGE has only shown that one of the seven asserted patents in this case (’839 Patent) is substantially related to the messaging application that was alleged against LGE in *MTT*.” Appx87. This decision to disqualify *Pantech* with respect to the ’839 patent alone, rather than across the matter, was legal error.

Bifurcation is not a legally permissible remedy here under Fifth Circuit law and Rule 1.09. Rule 1.09 instructs that “a lawyer who personally has formerly represented a client in a matter shall not thereafter represent another person in *a matter* adverse to the former client . . . if it is the same or a substantially related matter.” *Am. Airlines*, 972 F.2d at 614-15. And *American Airlines* explains that “[t]he test is *categorical* in requiring disqualification upon the establishment of a substantial relationship between past and current representations.” *Id.* at 614. In response to this argument, the district court relied on a later statement in *American Airlines* that the Fifth Circuit has “never applied the test in a mechanical way that

might ‘prevent[] an attorney from ever representing an interest adverse to that of a former client.’” Appx22. However, read in context, this statement holds that there is no mechanical test for *determining whether a substantial relationship exists*. See *id.* (explaining in the next sentence that “*a substantial relationship may be found* only after the moving party delineates with specificity the subject matters, issues and causes of action”) (citation omitted). Here, there was already a substantial relationship finding. And the substantial relationship present was not limited just to the ’839 patent, but it is irrebuttably presumed that Mayer Brown would have also had access to other confidential information as part of the matter, which would have included “confidential information regarding LGE’s technologies, products, financials, business practices, litigation strategies, and licensing policies,” that also relate to the other patents-at-issue. Appx33 (citing Appx329-330). In fact, Pantech accuses the same “Messages application” at issue in *MTT* of infringing U.S. Patent No. 9,575,631 here. Appx689-690, Appx694. Where, as here, there is a finding of a substantial relationship between a prior and current matter, disqualification is “categorical.”⁷ *Id.*

⁷ The district court also relied on *TQ Delta* to justify bifurcation. Appx27. But *TQ Delta* is distinguishable for involving a subpoenaed third party, not a party to the case, which was a primary reason for not disqualifying counsel. See *TQ Delta, LLC v. 2Wire, Inc.*, No. CV 13-1835, 2016 WL 5402180, at *7 (D. Del. Sept. 26, 2016) (“Broadcom is not a party. Thus, aside from taking third-party discovery, TQ Delta

Fifth Circuit law and the relevant ethical rules mandate that disqualification be determined on a matter-by-matter basis, not piecemeal. Because the district court found a disqualifying conflict of interest with respect to *MTT*, Mayer Brown is irrebuttably presumed to possess relevant confidential information, and must therefore be disqualified. For this reason, the writ should issue.

II. LGE Has No Other Adequate Means to Obtain Relief

The district court's erroneous decision leaves LGE in legal limbo. LGE has exhausted all actions it can take at the district court.⁸ Short of the mandamus relief sought herein, LGE has no opportunity to appeal the district court's decision on disqualification until a final adjudication is reached. By then, Mayer Brown will have participated in all facets of this litigation, including claim construction and infringement, such that no action can relieve the harm to LGE. It is for this reason that the Fifth Circuit has held that mandamus is available in disqualification actions.

will not interact with Broadcom at all. Thus, there is little concern of divided loyalty, nor the appearance of 'switching sides.'").

⁸ In the district court's September 1, 2023 Order, it suggested that this matter was not finally resolved at the district court because LGE's Renewed Motion to Stay the litigation remained outstanding. Appx1145. While LGE disagrees that its Motion to Stay would affect the issue of disqualification, to address the district court's concern LGE has withdrawn its Motion to Stay at the district court, and LGE is filing a Motion to Stay at the Federal Circuit contemporaneous with this petition. Because the district court has finally resolved the disqualification matter, and because the district court has heard and denied two motions to stay based upon Mayer Brown's conflict of interest, this issue is ripe for this Court's resolution.

See Am. Airlines, 972 F.2d at 609 (“[T]he special circumstances of the present dispute [are] sufficient to place it within that narrow class of cases warranting mandamus review.”); *see also Dresser*, 972 F.2d at 540. Mandamus is the only available channel to correct the district court’s errors and to avoid irreparable harm to LGE.

III. The Issuance of the Writ Is Appropriate Under the Circumstances

Mandamus is appropriate to prevent the irreparable harm that LGE will otherwise suffer, and to provide clear and definitive guidance on the ethical standards owed by attorneys to their clients, and the extent to which they can circumvent these responsibilities through contractual waiver provisions. This issue is especially important in the patent context, where attorneys are regularly exposed to their client’s confidential technical information, trade secrets, financial and licensing information, and litigation strategies, all of which could be used to unethically gain an advantage in a future action. The circumstances of this case are a cautionary tale—LGE trusted Mayer Brown to defend it for years across multiple litigations, only to see Mayer Brown turn around and sue LGE on the same products and technology that it had previously defended, and with the same attorneys that accessed LGE’s confidential material. LGE has already suffered irreparable harm through Mayer Brown’s involvement in the drafting of the complaint, infringement contentions, and claim construction briefing for Pantech, all while being ethically

conflicted. This Court should make clear that such violation of ethical rules cannot stand.

In the analogous mandamus petition in *American Airlines*, the Fifth Circuit held that “immediate review of its disqualification motion is appropriate” where a party will “otherwise suffer ‘irreparable harm’” and where “attorneys and clients throughout Texas need the benefit of this Court’s guidance on this issue of grave importance.” *Am. Airlines*, 972 F.2d at 609. So too here. Other patent litigants, both in Texas and across the country, need guidance on at least the ethical issues presented herein, as well as with respect to what party bears the burden of proof to show such waiver. Without mandamus, the disparate results between the district court’s decision here concerning [Third Party] and *CCE*, and the conflicting decisions cited herein will confuse future litigants. *See Galderma Lab’ys*, 927 F. Supp. 2d at 398; *Fisker Auto. Holdings*, 2018 WL 3991470, at *3 n.5 (D. Del. Aug. 20, 2018); *Celgene Corp.*, 2008 WL 2937415, at *6 (D.N.J. July 29, 2008). These conflicting district court decisions present a “fundamental legal question[] . . . appropriate for mandamus.” *In re Google LLC*, 949 F.3d 1338, 1342-43 (Fed. Cir. 2020).

Mandamus is also appropriate to remedy the district court’s incorrect application of the substantial relationship test to *Core Wireless*, and the court’s improper decision to bifurcate the patents-at-issue in response to *MTT*. While *American Airlines* should control, the district court’s decision shows that there is

confusion over the directive to consider “a substantial relationship between the subject matter of the former and present representations.” *Am. Airlines*, 972 F.2d at 614; *see also Power Mosfet*, 2002 WL 32785219, at *2. And the Court should clarify once and for all that a disqualification based on the irrebuttable presumption that attorneys were exposed to relevant confidential information applies across a matter to all instances in which that attorney could potentially use that confidential information.

Each of the individual mistakes by the district court is appropriate for mandamus, especially here, where LGE continues to suffer harm because of the district court’s decision. It is crucial that clients and law firms have access to “proper interpretation and application of ethical standards in disqualification cases.” *Am. Airlines*, 972 F.2d at 609. This Court should make clear that law firms cannot avoid “obvious conflicts of interest” on the basis of non-specific interpretations of waiver untied to contractual language, that the burden is properly on parties raising a waiver defense to prove that defense, that cases are “substantially related” if they meet the *American Airlines* test, and that bifurcation is not a legally proper remedy where disqualification is required. The district court’s ruling would, in effect, permit a firm in Mayer Brown’s shoes to go to Pantech and pitch that it is the right counsel for the job based on its knowledge of LGE’s products, systems, and strategy based on its former representation. Mandamus relief is appropriate here to clarify that ethical

standards protect against such conduct, to correct the mistakes of the district court, and to further the administration of justice.

CONCLUSION

WHEREFORE, for the foregoing reasons, the Court should grant the petition, vacate the district court's decision denying LGE's Motion for Disqualification, and direct the district court to disqualify Mayer Brown in this matter.

Respectfully submitted,

/s/ Douglas Hallward-Driemeier

Douglas Hallward-Driemeier

ROPES & GRAY LLP

2099 Pennsylvania Avenue, N.W.

Washington, DC 20006-6807

Telephone: (202) 508-4600

Email: Douglas.Hallward-

Driemeier@ropesgray.com

James R. Batchelder

David S. Chun

James L. Davis, Jr.

ROPES & GRAY LLP

1900 University Avenue, 6th Floor

East Palo Alto, CA 94303-2284

Telephone: (650) 617-4000

Email: James.Batchelder@ropesgray.com

Email: David.Chun@ropesgray.com

Email: James.L.Davis@ropesgray.com

Matthew R. Shapiro

ROPES & GRAY LLP

1211 Avenue of the Americas

New York, NY 10036-8704

Telephone: (212) 596-9000

Email: Matthew.Shapiro@ropesgray.com

Counsel for Petitioners

Dated: September 11, 2023

CERTIFICATE OF COMPLIANCE

The undersigned certifies that this petition complies with the type-volume limitation of Federal Rule of Appellate Procedure 21(d)(1) because this petition contains 7,506 words, excluding the parts of the petition exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b)(2). This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6) because this petition has been prepared in a proportionally spaced typeface using Microsoft Word 365 in Times New Roman 14-point font.

/s/ Douglas Hallward-Driemeier
Douglas Hallward-Driemeier
Counsel for Petitioner

CERTIFICATE OF CONFIDENTIAL MATERIAL

Pursuant to Federal Circuit Rule 25.1, the foregoing document contains 12 number of unique words (including numbers) marked confidential. This number does not exceed the maximum of 15 words permitted by Fed. Cir. R. 25.1(d)(1)(A).

/s/ Douglas Hallward-Driemeier

Douglas Hallward-Driemeier

Counsel for Petitioner

CERTIFICATE OF SERVICE

On September 11, 2023, the undersigned caused the foregoing document to be filed electronically by using the Court's CM/ECF system.

A copy of the foregoing petition and its corresponding appendix was served upon the following counsel of record via email:

Geoffrey Culbertson
Kelly Tidwell
PATTON TIDWELL & CULBERTSON, LLP
2800 Texas Blvd. (75503)
Post Office Box 5398
Texarkana, TX 75505-5398
(P) (903) 792-7080
(F) (903) 792-8233
gpc@texarkanalaw.com
kbt@texarkanalaw.com

James A. Fussell, III
Jamie B. Beaber
Saqib J. Siddiqui
Tiffany A. Miller
Baldine Paul
Clark S. Bakewell
Tariq Javed
Seth W. Bruneel
Courtney Krawice
MAYER BROWN LLP
1999 K Street, N.W.
Washington D.C. 20006
(202) 263-3000
jbeaber@mayerbrown.com
jfussell@mayerbrown.com
ssiddqui@mayerbrown.com
tmiller@mayerbrown.com
bpaul@mayerbrown.com

cbakewell@mayerbrown.com
tjaved@mayerbrown.com
sbruneel@mayerbrown.com
ckrawice@mayerbrown.com

Graham M. Buccigross
MAYER BROWN LLP
Two Palo Alto Square, Suite 300
3000 El Camino Real
Palo Alto, CA 94306
(650) 331-2000
gbuccigross@mayerbrown.com

Gregory J. Apgar
MAYER BROWN LLP
1221 Avenue of the Americas
New York, NY 10020
(212) 506-2500
gapgar@mayerbrown.com

Luiz Miranda
MAYER BROWN LLP
71 S. Wacker Drive
Chicago, IL 60606
(312) 782-0600
lmiranda@mayerbrown.com

/s/ Douglas Hallward-Driemeier
Douglas Hallward-Driemeier
Counsel for Petitioner