

United States District Court
EASTERN DISTRICT OF TEXAS
TEXARKANA DIVISION

**PANTECH CORPORATION and
PANTECH WIRELESS, LLC**

v.

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

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Case No. 5:22-cv-113-RWS-JBB

Public Version

ORDER

The above-referenced case was referred to the undersigned United States Magistrate Judge for pretrial purposes in accordance with 28 U.S.C. § 636. Before the Court is Defendants’ Motion to Disqualify Mayer Brown LLP (Dkt. No. 15) and supplement thereto (Dkt. No. 72). Having considered the relevant briefing and hearing arguments of counsel February 1, 2023, and based upon this Court’s analysis of the Texas Rules of Professional Conduct, the local rules of this Court, the ABA’s Model Rules of Professional Conduct, and the societal interests at stake, including waiver issues, the Court concludes that LGE has not carried its burden in this case of showing that disqualification is necessary here. Therefore, LGE’s motion to disqualify is hereby **DENIED**.

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I. INTRODUCTION

Pantech Corporation and Pantech Wireless, L.L.C. (“Pantech”) filed this action on September 2, 2022 against LG Electronics Inc. and LG Electronics U.S.A., Inc. (“LGE”), asserting seven patents related to smartphones and cellular communications—including five purported standard essential patents (“SEPs”) allegedly relating to LTE and 5G—against LGE cellular devices. Complaint for Patent Infringement (Dkt. No. 1), ¶¶ 11-13.

LGE moves to disqualify Mayer Brown LLP (“Mayer Brown”) from representing Pantech, claiming Mayer Brown attorneys owe duties to LGE as a former client. For over seven years, various members of the Mayer Brown team now representing Pantech previously represented LGE on patent litigation matters involving smartphone/cellular technology. Dkt. No. 15 at 2-3. Specifically, LGE asserts Mayer Brown is violating Texas Disciplinary Rule 1.09(a)(2) and ABA Model Rule 1.9 because there is a “reasonable probability” that Mayer Brown will misuse LGE confidential information gained from the prior representations. *Id.* at 10-12. LGE further contends Mayer Brown is violating Texas Disciplinary Rule 1.09(a)(3) because at least five of the past representations (*Jenam*, *CCE*, *MTT*, *Core Wireless*, and [REDACTED]) are “substantially related” to this case *Id.* at 11. LGE emphasizes that Mayer Brown attorneys represented LGE in cases involving the same tech specifications of the 3GPP standard at issue here, *id.* at 3, or involving similar/same features, such as how the products “present user interface elements.” *Id.* at 4.

In its response, Pantech does not dispute that an attorney-client relationship previously existed between Mayer Brown and LGE. Dkt. No. 45 at 15. However, Pantech asserts two separate reasons why LGE waived its right to seek disqualification: (1) waiver based on dilatory or affirmative conduct; and (2) contractual waiver. Pursuant to its first waiver argument, Pantech asserts LGE’s delay in bringing this motion which “was brought for tactical reasons,” coupled with

LGE’s “self-initiated direct negotiations and communications with Mayer Brown after this case was filed,” establish LGE has waived any objection to Mayer Brown’s representation of Pantech. *Id.* at 10-15. Regarding contractual waiver, Pantech argues LGE’s motion should be denied because the most recent *Jenam* representation was undertaken by Mayer Brown conditioned on an advance conflicts waiver it received from LGE. *Id.* at 1. Pantech also argues that if the Court finds no waiver exists, the Mayer Brown attorneys have never handled a “substantially related” matter nor has LGE shown the Mayer Brown attorneys possess relevant LGE confidential information that would require disqualification. *Id.* at 2.

II. BACKGROUND FACTS¹

A. Pantech’s counsel’s prior involvement with LGE

Current Pantech counsel represented LGE from at least 2012-2020 in eight matters, five of which allegedly involved smartphones/cellular technology and products that are accused of infringement in this case.² These five matters are shown below, along with approximate representation and alleged overlap with the current case.

Former LGE Matter	Approximate Dates of Representation	Products at issue in prior litigation and accused by Pantech	Pantech counsel involved in past matter
Confidential arbitration between [REDACTED] and LG Electronics Inc. [REDACTED]	[REDACTED]	4G LTE enabled devices	Jamie Beaber Tripp Fussell Baldine Paul Tiffany Miller Saqib Siddiqui Graham Buccigross

¹ The facts bearing on the motion are derived from numerous declarations and exhibits that the parties have submitted to the Court. At the hearing, LGE submitted numerous exhibits to the Court for *in camera* review.

² In addition to the five matters listed in the chart, Jamie Beaber with Mayer Brown represented LGE on at least three other patent cases related to cell phone technology: *CyWee Group Ltd. v. LG Electronics, Inc.*, No. 3:17-cv-01102 (S.D. Cal.) (“*CyWee*”) (LGE Exs. 13-14) from 2017-2018; *Integrated Cir. Devices & Prods. Containing the Same*, ITC-337-TA-873 (“*Integrated*”) (LGE Exs. 15-16) from 2013-2016; and *Azure Networks, L.L.C. v. MediaTek Inc.*, No. 6-12-cv-00252 (E.D. Tex.) (“*Azure*”) (LGE Exs. 17-18) from 2012-2013. Dkt. No. 15 at 3, n. 2 (citing Declaration of Hojun Suh (“Suh Decl.”), ¶ 4).

<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.) (“ <i>CCE</i> ”) (Dkt. No. 15, LGE Exs. 1-6)	June 2013 – Aug. 2016	4G LTE enabled devices, including the LG G Pad 7.0 LTE and others	Jamie Beaber Baldine Paul Tiffany Miller Saqib Siddiqui
<i>Core Wireless Licensing v. LG Electronics, Inc.</i> , No. 2:14-cv-00911 (E.D. Tex.) (“ <i>Core Wireless</i> ”) (Dkt. No. 15, LGE Exs. 7-8)	Sept. 2014 – Nov. 2020 (Pantech disputes involvement)	Communication devices including the LGE G Pad 7.0 LTE and others	Jamie Beaber
<i>Mobile Tele. Tech. v. LG Electronics, Inc.</i> , No. 2:13-cv-00947 (E.D. Tex.) (“ <i>MTT</i> ”) (Dkt. No. 15, LGE Exs. 9-10)	Nov. 2013 – Mar. 2016	Network operation centers and mobile units, including LG Phoenix and others	Jamie Beaber Tiffany Miller
<i>Jenam Tech, L.L.C. v. LG Electronics, Inc.</i> , No. 4:19-cv-00249 (E.D. Tex.) (“ <i>Jenam</i> ”) (Dkt. No. 15, LGE Exs. 11-12)	Apr. 2019 – Jan. 2020	Smartphone and tablets, including the LG V40, V35, G7 series, LG G Pad, G Pad X, and G Pad II and others	Jamie Beaber Tiffany Miller Baldine Paul Saqib Saddiqui

According to Suh, the Patent Licensing Manager for LGE, the 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; and Jamie Beaber, a partner at Mayer Brown, worked on all five matters, first in his affiliation with Steptoe & Johnson LLP and later with his affiliation with Mayer Brown. Declaration of Hojun Suh (“Suh Decl.”), Dkt. No. 15-2, ¶¶ 3-4. Suh states that while Beaber did not bill for his time as part of a billing arrangement, “he was the lead attorney and primary point of contact for LGE on each of those matters.” *Id.*, ¶ 4. Collectively, these attorneys representing Pantech previously spent thousands of hours representing LGE on similar patent matters and had access to volumes of LGE Confidential Information. *Id.*, ¶¶ 5-16; *see also* Declaration of Soo Hong (“Hong Decl.”), Dkt. No. 15-3, ¶¶ 2-18.

To provide additional background information, the Court focuses on the most recent matters: [REDACTED] and *Jenam*. Hong Decl., ¶¶ 12-18; *see also* Declaration of Chang Kim (“Kim Decl.”), Dkt. No. 15-1, ¶¶ 2-7.

[REDACTED]

On [REDACTED], LGE formally retained Mayer Brown to represent LGE in connection with the arbitration between [REDACTED] and LGE. Declaration of Jamie B. Beaber in Support of Plaintiff’s Opposition to Defendants’ Motion to Disqualify Mayer Brown (“Beaber Decl.”), Dkt. No. 45-2, ¶ 3. Pantech contends all substantive work was completed by June of 2017 when LGE ended its relationship with Mayer Brown, and that after June, Mayer Brown only undertook administrative duties to wind down the relationship. Second Declaration of Jamie B. Beaber (“Beaber Second Decl.”), Dkt. No. 60-1, ¶ 3. LGE contends Mayer Brown billed until November 2017. Suh Decl., ¶ 13.

Following Mayer Brown’s completion of its work on behalf of LGE in connection with the [REDACTED] arbitration, LGE elected to end its relationship with Mayer Brown and transitioned all open patent matters being handled by Mayer Brown to other law firms. Beaber Decl., ¶ 5; *see also* Suh Decl., ¶ 17 (stating these other matters included the *CyWee* and *Core Wireless* matters, as well as ongoing inter partes reviewing (IPR) proceedings).

Jenam

In 2019, Mayer Brown was approached by [REDACTED] to represent [REDACTED] as well as LGE in connection with a lawsuit filed by Jenam Tech, LLC in the Eastern District of Texas asserting patent infringement based on the implementation of the Google Chrome browser application on LGE’s Android devices. Beaber Decl., ¶ 6. [REDACTED]

[REDACTED]

[REDACTED]. Kim Decl., ¶ 4. The *Jenam* matter, which involved two patents allegedly related to “smartphone” and “tablet” technology, was the last time LGE retained Mayer Brown. Suh Decl., ¶ 18.

On September 12, 2019, LGE and Mayer Brown entered into a specific waiver via the “*Jenam* Engagement Letter,” Dkt. No. 15, LGE Ex. 24, and Mayer Brown’s standard advance waiver contained in the attached International Terms of Business. *Id.*, LGE Ex. 25. Together, the *Jenam* Engagement Letter and the International Terms of Business form the contract (“*Jenam* Engagement Contract”) between LGE and Mayer Brown.

Mayer Brown continued to represent LGE in the *Jenam* matter until at least January 2020. Suh Decl., ¶ 18. When the case was transferred to Kecker Van Nest & Peters LLP in January 2020, Mayer Brown’s files for the matter were transferred as well. Dkt. No. 15, LGE Ex. 28 at 2.

B. Pre-litigation discussions

Pantech approached LGE regarding a license to Pantech’s patent portfolios in or around September 2020. Beaber Decl., ¶ 12. By November of 2020, after Pantech copied Mayer Brown on correspondence, LGE learned its former attorneys were representing Pantech. Kim Decl., ¶ 8. Mayer Brown later contacted LGE on behalf of Pantech in December 2020 to discuss licensing Pantech’s patent portfolio. *Id.* (citing Dkt. No. 15, LGE Ex. 26 at 4-5). LGE stated it did not want Mayer Brown involved in the licensing negotiations in January 2021, and formally objected to Mayer Brown’s involvement in March 2021. Kim Decl., ¶ 9.

Following these preliminary communications, Kim emailed Mayer Brown attorney Tripp Fussell on April 7, 2021, copying Beaber and Pantech, reiterating that LGE was concerned with Pantech’s engagement of Mayer Brown because Mayer Brown had represented LGE on “numerous patent matters (litigation, arbitration, licensing, etc.) since 2014, including a matter last

year.” *Id.*; *see also* Dkt. No. 15, LGE Ex. 26 (licensing emails at 4). After Beaber responded with “surprise[]” “given my discussions with Chang Kim at the time LGE signed the engagement/waiver letter for the *Jenam* matters,” Dkt. No. 15, LGE Ex. 26 (licensing emails at 3), Kim specifically referenced Mayer Brown’s representation of LGE in the “substantially related” [REDACTED] matter, asserting LGE had not waived any conflict in the *Jenam* Engagement Letter. *Id.* (licensing emails at 2-3).

In a subsequent email, Beaber disagreed with Kim that the [REDACTED] matter is substantially related to the Pantech portfolio. *Id.* (licensing emails at 2). According to Beaber, even if the [REDACTED] matter is viewed as substantially related to the Pantech portfolio (which he disputed), “that provision only applies to future matters.” *Id.* Beaber further stated that because “IdeaHub/Pantech were clients of MB and adverse to LGE before LGE executed [the *Jenam*] waiver (and, in fact, were noted in the earlier version of the [REDACTED] agreement and discussed with Mr. Chang Kim by phone) we do not understand how LGE can maintain this position.” *Id.* In a subsequent email, Beaber again stated that during discussions regarding the *Jenam* matter, “it was in fact made clear that MB was adverse to LGE in patent licensing negotiation matters for a Korean and a Japanese company – I know that Maxell was also specifically discussed at that time.” *Id.* (licensing emails at 1). Beaber noted it was discussed that the matters were not in litigation but could lead to litigation, and this was “why the initial draft of the [REDACTED] letter expressly addressed both **current** and future conflicts. . . .” *Id.* (emphasis original).

LGE and Mayer Brown could not resolve the conflict issue. From April 2021 through the end of the pre-suit negotiations, LGE dealt with Pantech directly without involving Mayer Brown. Kim Decl., ¶ 10; *see also* Declaration of James A. Fussell, III (“Fussell Decl.”), Dkt. No. 45-3, ¶ 6; *see also* Dkt. No. 54, LGE Ex. 37.

C. Current litigation

Pantech filed the present action on September 2, 2022, represented by Mayer Brown. Kim Decl., ¶ 11; Beaber Decl., ¶ 20. Following Pantech's filing of the complaint, Hongsun Yoon, Director and Senior IP Counsel at LG Electronics U.S.A., Inc., reached out to Beaber to discuss the matter and seek an extension of time to file responsive pleadings. Fussell Decl., ¶ 8; Beaber Decl., ¶ 21 ("Both Mayer Brown, and myself personally, worked with Mr. Yoon on several LGE matters prior to LGE's election to end its relationship with Mayer Brown in 2017."). According to Beaber, Yoon did not raise the alleged conflict during this discussion. Beaber Decl., ¶ 24.

According to Fussell, not once during Fussell's discussions or emails with Yoon in October 2022 did Yoon or anyone at LGE raise an alleged conflict or object to Mayer Brown's involvement in this case. Fussell Decl., ¶ 13. Fussell states "LGE led me and my firm to believe that LGE would respect the waiver agreement between the parties." *Id.*

LGE subsequently retained Ropes & Gray as counsel October 24, 2022. Kim Decl., ¶ 11. Ropes & Gray raised the conflict issue with Mayer Brown on December 2, 2022, with the parties reaching an impasse on December 16. On December 30, 2022, LGE filed its current motion to disqualify Mayer Brown. The Court set the motion for hearing February 1, 2023.

III. LEGAL STANDARDS

A. Motions to disqualify

"As disqualification is a procedural matter not unique to patent law, regional circuit law applies." *Maxell, Ltd. v. Apple Inc.*, No. 5:19-CV-00036-RWS, 2021 WL 1100098, at *6 (E.D. Tex. Mar. 2, 2021) (citing *Adaptix, Inc. v. Dell, Inc.*, No. 6:13-cv-437, 2014 WL 11730482, at *4 (citing *Picker Int'l, Inc. v. Varian Assocs., Inc.*, 869 F.2d 578, 580–81 (Fed. Cir. 1989))). In the

Fifth Circuit, a motion to disqualify is a substantive motion “affecting the rights of the parties” and is thus “determined by applying standards developed under federal law.” *Id.* (citing *In re Am. Airlines, Inc.*, 972 F.3d 605, 610 (5th Cir. 1992) (quoting *In re Dresser Indus., Inc.*, 972 F.2d 540, 544 (5th Cir. 1992))).

The attorney disqualification rules are not to be mechanically applied. *See Johnston v. Harris Cnty. Flood Control Dist.*, 869 F.2d 1565, 1569 (5th Cir. 1989). Rather, the Fifth Circuit has directed courts to carefully “consider ‘[a]ll the facts particular to [the] case . . . in the context of the relevant ethical criteria and with meticulous deference to the litigant’s rights.’” *Maxell*, No. 5:19-CV-00036, 2021 WL 1100098, at *6 (quoting *In re ProEducation Int’l, Inc.*, 587 F.3d 296, 300 (5th Cir. 2009) (quoting *FDIC v. U.S. Fire Ins. Co.*, 50 F.3d 1304, 1314 (5th Cir. 1995)); also citing *Woods v. Covington Cty. Bank*, 537 F.2d 804, 810 (5th Cir. 1976) (“A court should be conscious of its responsibility to preserve a reasonable balance between the need to ensure ethical conduct on the part of lawyers appearing before it and other social interests, which include the litigant’s right to freely chosen counsel.”)). To that end, courts are to consider a motion to disqualify “in light of the litigant’s rights and the public interest, considering ‘whether a conflict has (1) the appearance of impropriety in general, or (2) a possibility that a specific impropriety will occur, and (3) the likelihood of public suspicion from the impropriety outweighs any social interests which will be served by the lawyer’s continued participation in the case.’” *Id.* (quoting *Horaist v. Doctor’s Hosp. of Opelousas*, 255 F.3d 261, 266 (5th Cir. 2001) (citing *Dresser*, 972 F.2d at 543)).

In Texas, disqualification is a “severe remedy.” *Jackson v. City of Sherman, Texas*, No. 4:16-CV-774-KPJ, 2018 WL 621259, at *2 (E.D. Tex. Jan. 30, 2018) (quoting *NCNB Tex. Nat’l Bank v. Coker*, 765 S.W.2d 398, 399 (Tex. 1989), *abrogated on other grounds by In re Thetford*,

574 S.W.3d at 373 n.16). Motions to disqualify are subject to an exacting standard both to protect a party's right to counsel of choice as well as to discourage the use of such motions as a "dilatatory trial tactic." *Id.* The movant bears the burden of proving that disqualification is warranted. *Am. Airlines*, 972 F.2d at 614.

"A disqualification inquiry, particularly when instigated by an opponent, presents a palpable risk of unfairly denying a party the counsel of his choosing." *Taylor v. Acad. Partnerships, L.L.C.*, No. 3:19-CV-01764-K-BN, 2019 WL 6619808, at *9 (N.D. Tex. Nov. 5, 2019), *report and recommendation adopted*, No. 3:19-CV-01764-K, 2019 WL 6619385 (N.D. Tex. Dec. 4, 2019 (quoting *U.S. Fire*, 50 F.3d at 1316)). Disqualification motions have potential to be used as "procedural weapons" in litigation, intended "to advance purely tactical purposes," including delay or harassment. *Id.* (quoting *Am. Airlines*, 972 F.2d at 611); *see also Galderma Labs., LP v. Actavis Mid Atl. L.L.C.*, 927 F. Supp. 2d 390, 395 (N.D. Tex. 2013) ("When the Model Rules are invoked as procedural weapons, the party subverts the purpose of the ethical rules.")).

In the Fifth Circuit, when considering disqualification of an attorney, district courts generally rely upon the following: (1) the local rules in the district; (2) the American Bar Association's ("ABA") Model Rules of Professional Conduct; (3) the ABA's Model Code of Professional Responsibility; and (4) the state rules of conduct. *Jackson*, No. 4:16-CV-774, 2018 WL 621259, at *2 (citing *Horaist*, 255 F.3d at 266); *see also Ayus v. Total Renal Care, Inc.*, 48 F. Supp. 2d 714, 716 (S.D. Tex. 1999). When deciding a motion to disqualify, a court first looks to that court's specific local rules. *Maxell*, No. 5:19-CV-00036, 2021 WL 1100098, at *6 (citing *U.S. Fire*, 50 F.3d at 1312).

In the Eastern District of Texas, "[t]he standards of professional conduct adopted as part of the Rules Governing the State Bar of Texas shall serve as a guide governing the obligations and

responsibilities of all attorneys appearing in this court.” *Id.* (quoting Local Rule AT-2(a)). District courts, however, are not limited to their local rules in deciding a motion to disqualify. *Id.* (citing *Am. Airlines*, 972 F.2d at 610). In fact, in reviewing motions to disqualify, courts must also “consider the ethical rules announced by the national profession in light of the public interest and the litigants’ rights.” *Id.* To this aim, the Fifth Circuit has acknowledged that the ABA Model Rules of Professional Conduct (the “Model Rules”) are the “national standards to consider in reviewing motions to disqualify.” *Id.* (quoting *ProEducation*, 587 F.3d at 299). Therefore, the Court considers both the Texas Rules and the Model Rules.

B. Relevant ethical rules

Rule 1.09(a) of the Texas Rules and Rule 1.9 of the Model Rules govern conflicts of interest with former clients. *Hillman Grp., Inc. v. KeyMe, L.L.C.*, 439 F. Supp. 3d 845, 852 (E.D. Tex. 2020). ABA Model Rule 1.9 is identical to Texas Rule 1.09 in all important respects. *Am. Airlines*, 972 F.2d at 615, n. 2. Model Rule 1.9 provides as follows:

(a) A lawyer who has formerly represented a client in a matter shall not thereafter represent another person in the same or a substantially related matter in which that person’s interests are materially adverse to the interests of the former client unless the former client gives informed consent, confirmed in writing.

(b) A lawyer shall not knowingly represent a person in the same or a substantially related matter in which a firm with which the lawyer formerly was associated had previously represented a client

(1) whose interests are materially adverse to that person; and

(2) about whom the lawyer had acquired information protected by Rules 1.6 and 1.9(c) that is material to the matter; unless the former client gives informed consent, confirmed in writing.

(c) A lawyer who has formerly represented a client in a matter or whose present or former firm has formerly represented a client in a matter shall not thereafter:

(1) use information relating to the representation to the disadvantage of the former client except as these Rules would permit or require with respect to a client, or when the information has become generally known; or

(2) reveal information relating to the representation except as these Rules would permit or require with respect to a client.

Maxell, No. 5:19-CV-00036, 2021 WL 1100098, at *7 (quoting ABA MODEL RULES PROF. CONDUCT R. 1.9).

Comment 3 to Rule 1.9 of the Model Rules provides that:

[m]atters are “substantially related” for purposes of this Rule if they involve the *same transaction or legal dispute* or if there otherwise is a *substantial risk that confidential factual information* as would normally have been obtained in the prior representation *would materially advance the client’s position* in the subsequent matter.

Hillman, 439 F. Supp. 3d at 853 (emphasis added in *Hillman*). Thus, in a motion to disqualify on the grounds of a former client relationship, the movant must show: “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” or a risk of the improper use of confidential information. *Id.* (citing *Am. Airlines*, 972 F.2d at 614–15).

Regarding Texas Disciplinary Rule of Professional Conduct 1.09, which was promulgated after the circuit adopted the substantial relationship test, the Texas Rule provides similar grounds for disqualification. *Am. Airlines*, 972 F.2d at 614–15. Specifically, Texas Rule 1.09 provides as follows:

(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:

(1) in which such other person questions the validity of the lawyer’s services or work product for 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.

(b) Except to the extent authorized by Rule 1.10, when lawyers are or have become members of or associated with a firm, none of them shall knowingly represent a client if any one of them practicing alone would be prohibited from doing so by paragraph (a).

Id. (quoting TEX. DISC. RULES. PROF. CONDUCT R. 1.09(a)). Rule 1.09 thus on its face forbids a lawyer to appear against a former client if the current representation in reasonable probability will involve the use of confidential information in violation of Rule 1.05 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.

“Before a trial court may disqualify a lawyer pursuant to Rule 1.09(a)(2), the court must find a reasonable probability that some aspect of rule 1.05 will be violated.” *In re TMD Def. & Space, L.L.C.*, 649 S.W.3d 764, 772 (Tex. App. – El Paso 2022) (quoting *In re Hoar Construction, L.L.C.*, 256 S.W.3d 790, 800 (Tex. App.—Houston [14th Dist.] 2008, orig. proceeding)). Rule 1.05 addresses a lawyer’s duties with respect to a client’s confidential information and provides as follows:

(a) “Confidential information” includes both “privileged information” and “unprivileged client information.” “Privileged information” refers to the information of a client protected by the lawyer-client privilege of Rule 503 of the Texas Rules of Evidence or of Rule 503 of the Texas Rules of Criminal Evidence “Unprivileged client information” means all information relating to a client or furnished by the client, other than privileged information, acquired by the lawyer during the course of or by reason of the representation of the client.

(b) [A] lawyer shall not knowingly:

(1) Reveal confidential information of a client or a former client[.]

...

(2) Use confidential information of a client to the disadvantage of the client unless the client consents after consultation.

(3) Use confidential information of a former client to the disadvantage of the former client after the representation is concluded unless the former client consents after consultation or the confidential information has become generally known.³

TEX. DISC. RULES. PROF. CONDUCT R. 1.05(a), (b)(1), (2) & (3).

Both the Texas Rules and Model Rules prohibit other lawyers from the disqualified attorney's firm from representing the conflicting client. *Maxell*, No. 5:19-CV-00036, 2021 WL 1100098, at *7 (citing TEX. DISC. RULES. PROF. CONDUCT R. 1.09(b); ABA MODEL RULES PROF. CONDUCT R. 1.10(a)). But the Model Rules allow for screening as a means of avoiding imputed conflicts under certain circumstances. *Id.*

The right to disqualify a former lawyer can be waived, and the issues of waiver arise in two forms: (1) the failure to raise a motion to disqualify in a timely manner may constitute waiver of the objection, *Cinco Bayous, L.L.C. v. Samson Expl., L.L.C.*, No. 1:19-CV-452, 2020 WL 13533320, at *7 (E.D. Tex. Aug. 17, 2020); and (2) a party can explicitly agree that its attorney may undertake a concurrent or future representation that is adverse to it, and questions arise as to whether that agreement is applicable and enforceable. Rule 1.09 Conflict of interest: Former client, 48 Tex. Prac., Tex. Lawyer & Jud. Ethics § 6:9 (2023 ed.); *see also Galderma Lab'ys, L.P. v. Actavis Mid Atl. L.L.C.*, 927 F. Supp. 2d 390, 396 (N.D. Tex. 2013) (discussing Model Rule 1.7). Accordingly, the Court first considers Pantech's two waiver arguments.

³ According to the Fifth Circuit Court of Appeals, although Texas Rule 1.05 contains an exception for public information, this exception applies only to the provision prohibiting the use of confidential information (incorporated by Texas Rule 1.09(a)(2)) and does not apply to the substantial relationship rule contained in Rule 1.09(a)(3). *In re Am. Airlines, Inc.*, 972 F.3d 605, 620-21 (5th Cir. 1992).

IV. WAIVER ANALYSIS

A. Whether LGE waived its right to object to Mayer Brown's representation of Pantech based on dilatory or affirmative conduct

In its first waiver argument, Pantech asserts LGE has waived any objection it might have to Mayer Brown's representation of Pantech in this case based on (1) LGE's delay in bringing the motion and (2) LGE's "self-initiated direct negotiations and communications with Mayer Brown after this case was filed" concerning an extension of time to answer. Dkt. No. 45 at 10-15.

Pantech asserts it is undisputed that LGE knew of Mayer Brown's representation of Pantech in 2020. *Id.* at 13. According to Pantech, even though Pantech's complaint was filed on September 2, 2022, it was not until "December 2, 2022, more than two years after LGE became aware of Mayer Brown's representation of Pantech in 2020" that outside counsel for LGE formally demanded that Mayer Brown cease and desist working on the matter, destroy all Mayer Brown work product, and withdraw as counsel. *Id.* (citing Dkt. No. 15, LGE Ex. 27 at 2). Pantech argues LGE, after receiving Mayer Brown's position on the matter, "then waited another three weeks, until December 30, 2022, to file its motion to disqualify." *Id.* Pantech asserts LGE should have, at a minimum, immediately notified Mayer Brown or Pantech of its position after the complaint was filed; instead, LGE "waited to spring its motion to disqualify while simultaneously moving to (1) dismiss Pantech's claims and (2) stay all proceedings so that Mayer Brown cannot work on the opposition or otherwise advance the case."⁴ *Id.* at 14. Pantech asserts the timing of the motion suggests "tactical delay." Dkt No. 60 at 4.

⁴ On January 5, 2023, following a telephone status conference, the undersigned entered an Order granting-in-part and denying-in-part LGE's motion to extend schedule and deadlines pending hearing on LGE's motion to disqualify. Dkt. No. 36. The January 5 Order set LGE's motion to disqualify for hearing February 1, 2023 but denied LGE's request to order Mayer Brown to not prepare and file a response to LGE's partial motion to dismiss. The undersigned also set the case for scheduling conference and hearing on LGE's partial motion to dismiss for February 22, 2023.

“It is well settled that a former client who is entitled to object to an attorney representing an opposing party on the ground of conflict of interest but who knowingly refrains from asserting it promptly is deemed to have waived that right.” *Cinco Bayous, L.L.C. v. Samson Expl., L.L.C.*, No. 1:19-CV-452, 2020 WL 13533320, at *7 (E.D. Tex. Aug. 17, 2020) (quoting *Pendergest-Holt v. Certain Underwriters at Lloyd’s of London*, No. CV H-09-3712, 2010 WL 11661414, at *5-6 (S.D. Tex. July 30, 2010)); *see also Atasi Corp. v. Seagate Tech.*, 847 F.2d 826, 832 (Fed. Cir. 1988) (a finding of waiver is appropriate “when a motion to disqualify is used in an abusive manner as part of litigation tactics”). “A motion to disqualify should be made with reasonable promptness after a party discovers the facts which lead to the motion.” *Id.* (quoting *Cox v. Am. Cast Iron Pipe Co.*, 847 F.2d 725, 729 (11th Cir. 1988) (quoting *Jackson v. J.C. Penney Co.*, 521 F. Supp. 1032, 1034-35 (N.D. Ga. 1981))).

The record does not show any tactical delay by LGE. LGE raised the issue both pre-suit and by motion after the complaint was filed and before any substantive filing. Before Pantech filed its complaint, LGE refused to include Mayer Brown in the pre-suit negotiations due to the alleged conflict. Mayer Brown respected that demand and did not engage in further licensing negotiations. *See* Dkt. No. 67 (Transcript) at 83:6-10. And, as pointed out by LGE, there was no court before which to raise the matter as there was no live case until September 2, 2022. Dkt. No. 54 at 3. LGE was under no obligation to take additional steps in anticipation of some hypothetical future litigation. *See, e.g., Staton Techiya, L.L.C. v. Samsung Elects. Co.*, No. 2:21-CV-00413, 2022 WL

Contemporaneously therewith, the undersigned entered an Order setting the case for scheduling conference. Dkt. No. 35.

On January 19, LGE filed a motion for reconsideration of and objections to the January 5 Orders. *See* Dkt. No. 55. On February 25, LGE refiled its objections to the January 5 Orders (same as Dkt. No. 55), noting in a footnote that the undersigned denied LGE’s oral motion for reconsideration at the February 1 hearing. *See* Dkt. No. 71 at 1, n. 1. On April 24, 2023, District Judge Schroeder entered an Order overruling LGE’s objections to the January 5 Orders. Dkt. No. 91.

16964746, at *2 (E.D. Tex. Nov. 16, 2022) (prior knowledge that a conflict might exist “as soon as suit was filed” did not constitute waiver; and it was “not unreasonable for Samsung to wait . . . to demand that Ahn and Cho remove themselves from the handling of the patent infringement litigation”).

Further, LGE’s post-suit actions do not show waiver. LGE explains it retained outside counsel in late October 2022. Kim Decl., ¶ 11. Outside counsel investigated the issue in November and contacted Mayer Brown. Dkt. No. 15, LGE Ex. 27 at 1. The parties exchanged letters and attempted to meet and confer in December and reached an impasse. The motion was filed soon thereafter, less than four months from the filing of the complaint and before any other substantive filings in the case.

Courts have found no waiver when the conflict was raised within four months after the complaint was filed. *See 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), *aff’d in part sub nom. Islander E. Rental Program v. Barfield*, 145 F.3d 359 (5th Cir. 1998). While courts have found implied waivers when a motion to disqualify was not timely made, those cases generally involve delays much longer than four months, or motions made on the eve of trial. *Id.* (citing *Central Milk Producers Co-op. v. Sentry Food Stores, Inc.*, 573 F.2d 988, 991 (8th Cir.1978) (waiver found where disqualification motion brought more than two years after notice of representation and only one month before the scheduled trial date); also citing *Trust Corp. of Montana v. Piper Aircraft Co.*, 701 F.2d 85, 87 (9th Cir.1983) (waiver where disqualification not raised for more than two and half years after notice of representation); also citing *Employers Ins. Of Wausau v. Albert D. Seeno Constr. Co.*, 692 F. Supp. 1150, 1165–66 (N.D.Cal.1988) (waiver

where disqualification motion not made until well over a year after moving party became aware of conflict)).

Relying on *Advanced Training Grp. Worldwide, Inc. v. Proactive Techs. Inc.*, 436 F.Supp.3d 870 (E.D. Va. 2020), wherein the court denied the plaintiff's motion to disqualify defendant's counsel for multiple reasons, Pantech asserts LGE should have filed its motion immediately after the complaint was filed, or shortly thereafter, rather than negotiating with counsel regarding an extension of time to respond. That case is distinguishable because the plaintiff's motion was filed "after the close of discovery and the filing of cross-motions for summary judgment" and more than seven months after the defendant's counsel filed a notice of appearance. *Advanced Training*, 436 F.Supp.3d at 875 (noting the plaintiff had known of the alleged conflict for over three years, including the "past seven-plus months while th[e] litigation ha[d] been pending"). According to the court, the timing of the plaintiff's motion (prior to oral argument on the cross-motions for summary judgment) made clear the motion was "being used as a tactical maneuver." *Id.* at 875-76. Additionally, and unlike the situation here, the court found the plaintiff had not met its burden to establish that an attorney-client relationship existed between the plaintiff and the defendant's counsel. *Id.* at 876-78.

The Court does not find LGE has waived its right to object to Mayer Brown's representation of Pantech in this case through any dilatory or affirmative conduct regarding an extension of time in which to respond to the complaint.

B. Whether LGE contractually consented to Mayer Brown's representation of Pantech via the *Jenam* Engagement Contract

Pantech's second waiver argument is that LGE contractually waived its right to seek disqualification via the advance waiver provisions in the *Jenam* Engagement Contract. Pantech's most developed argument focuses on the specific waiver in the *Jenam* Engagement Letter, the

interpretation of which is the crux of the parties' dispute. LGE asserts there has been no waiver of the current Pantech conflict via either waiver provision in the *Jenam* Engagement Contract. Dkt. No. 15 at 13.

1. Applicable law

In attorney-client situations, general rules of professional legal conduct recognize that in certain circumstances it is not only proper but beneficial for parties to contractually consent to a waiver of future conflicts of interest. *In re Shared Memory Graphics L.L.C.*, 659 F.3d 1336, 1341 (Fed. Cir. 2011) (citing Restatement (Third) of the Law Governing Lawyers, § 122 cmt. D (2000) (“[T]he gains to both lawyer and client from a system of advance consent to defined future conflicts might be substantial.”)). “In the Fifth Circuit, the Model Rules are the primary source of guidance. . . .” *Galderma Labs v. Actavis Mid Atlantic L.L.C.*, 927 F.Supp.2d 390, 405 (N.D. Tex. 2013). ABA Model Rule 1.9, which addresses duties to former clients, allows an attorney to represent a client notwithstanding a conflict with a former client “if the former client gives informed consent in writing.” ABA MODEL RULES PROF. CONDUCT R. 1.9(b)(2). Comment 9 provides the provisions of Model Rule 1.9 “are for the protection of former clients and can be waived if the client gives informed consent, which consent must be confirmed in writing. . . .” *Id.*, cmt. 9 (citing ABA MODEL RULES PROF. CONDUCT R. Rule 1.0(c)).⁵

The Model Rules also allow for a waiver of future conflicts under certain circumstances, aka an “advance waiver.” In 2005, the American Bar Association (“ABA”) concluded that the

⁵ ABA Model Rule 1.0 defines “informed consent” as follows: “[t]he lawyer must make reasonable efforts to ensure that the client or other person possesses information reasonably adequate to make an informed decision.” ABA MODEL RULES PROF. CONDUCT R.1.0, cmt. 6. “A lawyer need not inform a client or other person of facts or implications already known to the client,” however, the information and explanation provided must be “reasonably adequate.” *Id.* Relevant factors in that determination include “whether the client or other person is experienced in legal matters generally and in making decisions of the type involved, and whether the client or other person is independently represented by other counsel in giving the consent.” *Id.*

2002 amendments to its Model Rule 1.7 had broadened the circumstances in which an advance waiver of conflicts by a current client would be upheld, compared to those pertaining in 1993 when it had last opined on that topic. *See* ABA Formal Op. 93-373 (1993) (setting out criteria for properly obtaining an advance waiver of conflicts of interest from a current client); ABA Formal Op. 05-436 (2005) (setting out what it considered to be the more liberal standards for upholding such waivers under the amended Model Rules, and withdrawing ABA Formal Op. 93-373 (1993)). In the ABA’s opinion, a prospective or advance waiver will more likely be effective if it comprehensively explains the types of conflicts that might arise and any adverse consequences of giving consent. ABA Formal Op. 05-436 (2005). Generally, in the ABA’s opinion, an open-ended general consent is ineffective, but is more likely to be effective if (1) the client is an experienced user of legal services; (2) is independently represented by other counsel; (3) is reasonably informed of the risk of a conflict; and (4) consent is limited only to unrelated future conflicts. *Id.* The court in *Galderma* applied, among other things, comment 22 to ABA Model Rule 1.7, comment 6 to ABA Model Rule 1.0, ABA Formal Opinion 05–436, and Section 122 of the Restatement (Third) of Law Governing Lawyers, all of which identify representation by its own counsel as an important fact to determine whether or not a client gave informed consent, to conclude that the advance waiver in that case was informed and effective. *Galderma*, 927 F. Supp. 2d at 405-06.

2. Waiver provisions contained in the *Jenam* Engagement Contract

In 2019, Mayer Brown was approached [REDACTED] to [REDACTED] represent [REDACTED] LGE in connection with the *Jenam* matter. Beaver Decl., ¶ 6. On July 17, 2019, Beaver provided a draft engagement letter to Chang Kim, LGE’s IP General Counsel, for the *Jenam* matter. The draft engagement letter contained a specific waiver that LGE and Mayer Brown negotiated concerning *Jenam* and unnamed “other matters” where Mayer Brown previously represented LGE and also

appended Mayer Brown's International Terms of Business, which contain Mayer Brown's standard advance waiver for prospective clients.

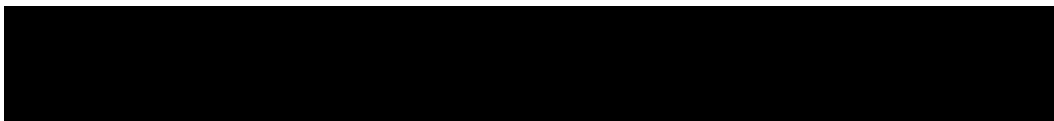
a. Specific waiver in the *Jenam* Engagement Letter

The initial draft *Jenam* Engagement Letter contained the following specific waiver, which initially stated Mayer Brown's clients have already sought advice on matters adverse to LGE and that LGE would waive any conflict from such matters as long as they were "unrelated" to *Jenam*:



Beaber Decl., ¶ 8 (emphasis added); Dkt. No. 15, LGE Ex. 22. Kim requested to remove the above paragraph because it would have allowed Mayer Brown to represent other clients adverse to LGE in "present or future matters unrelated to the" *Jenam* matter. Kim Decl., ¶ 5; Dkt. No. 15, LGE Ex. 23 (engagement emails) at 2.

Following a phone call and another proposal by Beaber referencing only possible future matters substantially unrelated to technology, LGE added the following underlined text, which required the parties to consider, for any waiver in a future matter, not only whether the future matter is substantially unrelated to the technology in *Jenam* but also to the technology involved in any other matters within a certain timeframe where Mayer Brown had previously represented LGE:





Beaber Decl., ¶ 10 (emphasis added).

On September 12, 2019, Mayer Brown responded by replacing the seven-year window with a shorter five-year window. Kim Decl., ¶ 7; Beaber Decl., ¶ 11. According to Kim, the five-year term was proposed by Beaber to coincide with the point five-years prior when Beaber first joined Mayer Brown. Kim Decl., ¶ 7. LGE agreed to the modified terms. The agreement is reflected in the final version of the *Jenam* Engagement Letter executed by Kim on September 16, 2019 on behalf of LGE. Beaber Decl., ¶ 11; *see also* Dkt. No. 15, LGE Ex. 24 at 4.

The entirety of the relevant language from the *Jenam* Engagement Letter provides as follows, with the part now in dispute emphasized:

C. Conflicts of Interest Arising from Joint Representation



* * *

The Firm's relationship with LGE will also be governed by the attached International Terms of Business ("International Term"). To the extent that there is a conflict between this letter and the International Terms, this letter shall control.

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 [REDACTED] including in matters that may result in litigation, arbitration, or other contentious matters against the Clients other than [REDACTED]. By signing below, each Client other than [REDACTED] 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 [REDACTED] 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 [REDACTED] 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.

Dkt. No. 15, LGE Ex. 24 at 2-3 (internal bold added) (the "specific waiver").

b. Standard advance waiver in the International Terms of Business

The International Terms of Business – appended to the *Jenam* Engagement Letter and expressly made a part thereof – provide an advance waiver as follows:

We may now or in the future without your consent act for your competitors, adverse parties or our other clients whose interests are or may be opposed to or in conflict with yours or your Affiliates in matters not substantially related to Particular Matters we are handling for you (including in transactions, bankruptcy, insolvency, arbitration, litigation or other forms of dispute resolution). Where we are acting for you on a Particular Matter, however, we will not act for another client on the same matter unless and to the extent that we are permitted to do so by the applicable professional conduct rules.

Dkt. No. 15, LGE Ex. 25 at A.9.5 (the "standard advance waiver").

Although Pantech's arguments heavily focused on the specific waiver, during the hearing, Pantech discussed the above standard advance waiver to possibly suggest that LGE has contractually waived all matters, including the matters that it raises here, based on the standard advance waiver. Dkt. No. 67 (Transcript) at 104:15-21 ("The International Terms are very broad

advance waiver, which we believe covers all the matters that they have referenced in their arguments here today, and this language in the letter itself simply. . . was some narrowing to call out where the technology was substantially related to the Jenam matter and – matters within a five-year window.”). To the extent Pantech argues that the standard advance waiver rather than the specific waiver covers all five matters specifically addressed in LGE’s motion, the argument fails. The specific waiver was specifically negotiated by LGE and Mayer Brown and addresses future matters such as this one. Although it is “in addition to the” standard advance waiver, to the extent there is a conflict between the *Jenam* Engagement Letter and the International Terms, the letter shall control. Dkt. No. 15, LGE Ex. 24 at 3.

Without arguing that either the standard advance waiver or the specific waiver is ineffective, LGE argues neither waiver applies to this matter because this matter is substantially related to the five matters encompassed by the specific waiver where Mayer Brown previously represented LGE. Dkt. No. 15 at 10-11, n.7 & 13-14. LGE also raised two ancillary issues, anticipating that Pantech might take the position that Pantech was a Mayer Brown client adverse to LGE at the time the *Jenam* Engagement Contract was executed rather than a Mayer Brown client who might, in the future, become adverse to LGE. *See* Dkt. No. 15 at 10-11, n. 7 (arguing that Mayer Brown did not give the necessary informed consent required under Model Rule 1.7(b) and Texas Rule 1.06(c) for concurrent conflicts); *id.* at 13 (arguing that if the Pantech adversity already existed at the time the *Jenam* Engagement Letter was executed, the specific waiver would not apply because on its face it addresses only “future” matters). Although there is some confusion in the record, it does not establish that the Pantech adversity existed concurrently with the *Jenam*

matter—and Pantech never argued to the contrary⁶—thus, LGE’s first ancillary argument, namely that the requirements of Model Rule 1.7(b) (requiring each affected client to give informed consent in writing) and Texas Rule 1.06(c) (requiring “full disclosure of the existence, nature, implications, and possible adverse consequences of the common representation”) were not satisfied, is moot.

Because the record fails to show – and because neither LGE nor Pantech argue otherwise – that a concurrent conflict of interest existed between Pantech and LGE at the time the *Jenam* Engagement Contract was executed, LGE’s second ancillary argument also fails. As noted above with regard to Pantech’s arguments at the hearing regarding the broad application of the standard advance waiver, the Court will interpret and apply – in line with the parties’ arguments throughout the briefing – the specific waiver negotiated by the parties (rather than the generic standard advance waiver in the International Terms) to determine whether LGE has contractually waived its right to seek Mayer Brown’s disqualification here.

3. Whether LGE has waived all conflicts via the specific waiver in the *Jenam* Engagement Letter

Nowhere in its briefing does LGE argue the specific waiver is ineffective for lack of informed consent. Even if it had, the Court would find Pantech has met its burden of showing LGE gave informed consent for Mayer Brown to represent other clients in future matters adverse to LGE, subject to the limitations specifically negotiated between independent counsel for LGE, a sophisticated party, and Beaber. *See* Dkt. No. 45 at 5-9.

⁶ Although Pantech was a Mayer Brown client at the time the *Jenam* Engagement Letter was executed, neither LGE nor Pantech advocate in their briefing that there was already adversity between Pantech and LGE at the time the *Jenam* Engagement Letter was executed. *See* Beaber Decl., ¶ 9 (Beaber declaring that he told Kim that Mayer Brown was representing another “Korean Company,” which was a reference to Pantech, but that such representation was not “a current conflict of interest”); Dkt. No. 67 (Transcript) at 91:15-21 (LGE explaining its view that “the conflict arose after the *Jenam* engagement letter”) and Dkt. No. 15 at 10-11, n.7 (similar).

In their briefing, both LGE and Pantech agree that the result of the specific waiver is that (1) for *Jenam* and those “other matters” where Mayer Brown represented LGE in the past five years, to the extent the Court determines that this matter is substantially unrelated to the technology involved in any of those matters, LGE’s waiver of “any conflict of interest” would apply to those matters, and (2) for any other matter where Mayer Brown previously represented LGE outside the five-year window, LGE’s waiver of “any conflict of interest” would apply.⁷ See Dkt. No. 15 at 6; Dkt. No. 45 at 1; Dkt. No. 60 at 1; *see also* Dkt. No. 67 (Transcript) at 85:25-86:9. The two disputes are (1) whether the “past five (5) years” refers to the date of the execution of the *Jenam* Engagement Letter or if it refers to the point when the conflict arose; and (2) whether the *Pantech* matter is substantially unrelated to the technology involved in *Jenam* or any other matter where Mayer Brown represented LGE that falls within the five-year window.

Accordingly, the parties agree that the Court must determine the relatedness of at least the *Jenam* matter. However, because the parties dispute when the five-year window starts, they dispute whether the Court should also determine the relatedness of *CCE*, *MTT*, *Core Wireless*, and/or [REDACTED]. The Court first interprets the start of the five-year window and whether the five-year window encompasses *CCE*, *MTT*, *Core Wireless*, and/or [REDACTED]. The parties have argued this as an issue of contract interpretation.

⁷ At the hearing, LGE expressed concern that by limiting the comparison to the technology between the two matters, Mayer Brown would be free to reveal attorney-client information or use previously disclosed confidential information against its former client. Dkt. No. 67 (Transcript) at 96:13-20. The Court does not understand Pantech to make such an argument and notes the issue here is whether LGE has consented to Mayer Brown’s representation of Pantech in this matter, not whether LGE has consented to the use of previously disclosed information or attorney-client conversations. *Compare* ABA Model Rule 1.9(a) (containing a consent provision) *with* ABA Model Rule 1.9(c) (no consent provision). The Court further addresses this concern at the conclusion of this Order.

a. Whether *CCE, MTT, Core Wireless*, and [REDACTED] fall outside the five-year window so as to fall outside the scope of the specific waiver

i. Applicable law as to contract interpretation

Pantech argues that – pursuant to the terms of the International Terms of Business – D.C. law should govern for purposes of interpreting the *Jenam* Engagement Contract. Dkt. No. 67 (Transcript) at 57:10-17 (noting Mayer Brown’s practice is located in Washington D.C.). LGE does not dispute the applicability of D.C. law. *Id.* at 88:16-20.

Under District of Columbia law, when interpreting a contract and determining whether it is ambiguous, the court examines “the document on its face, giving the language used its plain meaning.” *Dyer v. Bilaal*, 983 A.2d 349, 355 (D.C. 2009) (citing *Tillery v. District of Columbia Contract Appeals Bd.*, 912 A.2d 1169, 1176 (D.C.2006) (citing *Sacks v. Rothberg*, 569 A.2d 150, 154 (D.C.1990))). “[A] court must honor the intentions of the parties as reflected in the settled usage of the terms they accepted in the contract, and will not torture words to import ambiguity where” there is none. *Id.* (quoting *Bragdon v. Twenty-Five Twelve Assocs. Ltd. Partnership*, 856 A.2d 1165, 1170 (D.C.2004) (internal quotation marks and citations omitted in *Dyer*)). Moreover, “contracts are not rendered ambiguous by the mere fact that the parties do not agree upon their proper construction.” *Id.* (quoting *Steele Foundations, Inc. v. Clark Construction Group, Inc.*, 937 A.2d 148, 153 (D.C.2007) (citing *Dodek v. CF 16 Corp.*, 537 A.2d 1086, 1093 (D.C.1988))).

If, however, “the court finds that the contract has more than one reasonable interpretation and therefore is ambiguous, then the court—after admitting probative extrinsic evidence—must determine what a reasonable person in the position of the parties would have thought the disputed language meant.” *Id.* (quoting *In re Bailey*, 883 A.2d 106, 118 (D.C.2005) (internal quotation marks omitted in *Dyer*)). In such instances, though, any ambiguity as to the contract’s meaning

will be construed strongly against the drafter. *Id.* (citing *Capital City Mortgage Corp. v. Habana Village Art & Folklore, Inc.*, 747 A.2d 564, 567 (D.C.2000)).

ii. Interpreting the start of the five-year window

Pursuant to the specific waiver, LGE waived any conflicts concerning all future matters “substantially unrelated to the technology involved in . . . other matters where the Firm represented LGE in the past five (5) years.” Dkt. No. 15, LGE Ex. 24 at 3. LGE argues the five-year window is measured from the date of execution of the *Jenam* Engagement Letter, September 12, 2019. Thus, the window would be from September 12, 2014 through September 12, 2019. Alternatively, to the extent the Court agrees with Pantech’s view that the five-year window moves, LGE contends the start of the five-year window would start at the latest in December 2020, where Mayer Brown emailed LGE on Pantech’s behalf to discuss “the licensing and enforcement of [Pantech’s] patents.” Dkt. No. 15, LGE Ex. 26 (licensing emails) at 4; Dkt. No. 67 (Transcript) at 47:9-15, 97:9-10. Under either scenario, the window would capture all four “other” matters in addition to *Jenam*.

Pantech initially stated in its response that the five-year window is measured from the time when the conflict “arose,” presumably when Mayer Brown’s representation of Pantech became adverse to LGE, though Pantech never provides a date. *See* Dkt. No. 45 at 6. Pantech then argued in its surreply that the window should be measured from the date the conflict “was raised,” and referenced the April 2021 emails where the parties declared an impasse on the conflict issue. Dkt. No. 60 at 2. Next, at the hearing, Pantech contended the conflict was not “raised” until LGE’s

outside counsel sent a letter to Beaber on December 2, 2022. Dkt. No. 67 (Transcript) at 54:10-55:7. Under this final position, the only matter that falls within the five-year window is *Jenam*.⁸

Starting with the written language of the waiver itself, the Court finds the more natural reading of the “past five (5) years” is that the five-year period is measured from the date of the engagement letter. *See, e.g., Wellin v. Wellin*, No. 2:13-CV-1831-DCN, 2015 WL 5781383, at *3 (D.S.C. Sept. 30, 2015) (a fair reading of the subpoenas indicates that the five or ten year period should be measured from the date of the subpoena). As LGE notes, Pantech’s interpretation replaces the meaning of “past” with “prior.” Dkt. No. 54 at 1. Merriam-Webster defines “past” as “having existed or taken place in a period before the present.” *Past*, Merriam-Webster (2020), <https://www.merriam-webster.com/dictionary/past>. This contrasts with “prior,” which refers to “earlier in time or order.” *Prior*, Merriam-Webster (2020), <https://www.merriam-webster.com/dictionary/prior>. Thus, when used as adjectives, the difference between past and prior is that prior is a period of time that precedes an event, even one in the future, while past describes a period of time that already happened before the present (here, before executing the letter).

Pantech argues LGE’s interpretation, which would include all matters where Mayer Brown represented LGE from 2014 through September 2019, would provide greater protection to LGE than that provided by the ABA rules; would remain in effect for perpetuity; and would “defeat its very purpose.” Dkt. No. 60 at 1-2. These arguments gloss over the language of the waiver and are also misplaced. First, Pantech does not dispute that there is no moving window with respect to the *Jenam* matter, which shows these concerns are overstated. More fundamentally, the *Jenam* Engagement Letter simply defines the scope of LGE’s consent; it *cannot* provide greater protection

⁸ Though Beaber never formally withdrew from the *Core Wireless* matter, which did not conclude until November 2020, there is no dispute Beaber’s involvement through his role in that matter ended in the summer-to-fall of 2017 following Mayer Brown’s last work done on [REDACTED]. *See* Dkt. No. 15 at 3, n.2; Dkt. No. 45 at 1; Dkt. No. 54 at 2; Dkt. No. 60 at 3 & n.3.

to LGE than the ABA rules: if a matter is not waived by the specific waiver, LGE would still need to show that the rules, and analysis of the societal interests, require disqualification. Further, a fixed five-year window does not “defeat” the waiver’s purpose because LGE agreed to waive conflicts in future matters that involve substantially unrelated “technology” to any matters that fall in the window. That is, LGE waived the right to raise a conflict in a future matter if it involves unrelated technology – even if that matter is substantially related in other ways, and without regard to the nature or extent of previously disclosed confidential information.

That said, the Court, in its experience, sees the logic of Pantech’s argument in favor of a “moving” window, namely that with the passage of time, any technical information acquired by Mayer Brown attorneys would become outdated and not substantiate a conflict. *See* Dkt. No. 45 at 8. And though a less natural reading, interpreting the reference point for triggering the “past five (5) years” as from any future matter would not torture the word “past” to import ambiguity where there is none. *See Dyer*, 983 A.2d at 355.

However, even assuming enough ambiguity to look at the extrinsic evidence, that result remains the same. As shown above, LGE initially proposed a seven-year window and Mayer Brown countered with a five-year window, which LGE claims was to correspond to the time Beaber first joined Mayer Brown. Kim Decl., ¶ 7; Beaber Decl., ¶ 11. This suggests the parties used the window as shorthand to identify Mayer Brown’s previous representations of LGE rather than as an agreed amount of time they expected technical information to become so stale as to alleviate any conflict concern.

Pantech argues that the April 2021 licensing emails regarding the *Jenam* Engagement Letter show the parties understood a moving window. However, those emails do not contain a clear statement contradicting LGE’s interpretation that the five-year window was measured from

the execution of the *Jenam* Engagement Letter. Interpreting these emails most favorably to Pantech suggests that the five-year window would be triggered by “any conflict of interest *arising* from such matters” as stated in the specific waiver. That is, when the future conflict first arose, and the emails show both parties apparently assumed the five-year window as triggered by Mayer Brown’s representing Pantech in licensing and enforcement negotiations with LGE in November of 2020-April 2021. *See* Dkt. No. 15, LGE Ex. 26 at 3.

Assuming a moving window, the conflict arose no later than December 2020. By that time, Mayer Brown was representing Pantech against LGE in patent licensing negotiations. Beaver states in his declaration that Pantech and LGE started licensing negotiations in September 2020. *See* Beaver Decl., ¶ 12. In November 2020, LGE learned Mayer Brown was representing Pantech. Kim Decl., ¶ 8. And finally, Mayer Brown contacted LGE on behalf of Pantech in December 2020 to discuss licensing Patent’s patent portfolio. *Id.*; *see also* Dkt. No. 15, LGE Ex. 26 (licensing emails at 4). A five-year window from December 2015 to December 2020 also includes *Jenam* plus the four “other matters” above.

By April 2021, LGE went so far as to demand Mayer Brown not participate in those conversations (a request Mayer Brown respected), and LGE’s outside counsel raised the issue during litigation in December 2022. The Court is unaware of any persuasive argument, case law, or extrinsic evidence supporting Pantech’s argument at the hearing that there was no triggering conflict until LGE’s outside counsel raised the issue with Mayer Brown in December 2022. Any subsequent proposed dates past December 2020 (including April 2021 or December 2, 2022) relate to LGE assertions that the already-existing conflict prevented Mayer Brown’s participation – not when the conflict arose in the future matter.

In sum, the most natural reading of the “past five (5) years” is that the five-year period should be measured from September 12, 2019, the date of the execution of the *Jenam* Engagement Letter, i.e., September 12, 2014 through September 12, 2019. However, even under Pantech’s view of a moving window, the window would be triggered when the future conflict “aris[es]” as stated in the specific waiver, which is December 2020 at the absolute latest, resulting in a window from December 2015 to December 2020. Under either reasonable interpretation, the five-year window encompasses the four matters identified by LGE (i.e., *CCE*, *MTT*, *Core Wireless*, and [REDACTED]).

b. Whether this matter is sufficiently related to the technology involved in *Jenam*, *CCE*, *MTT*, *Core Wireless*, and/or [REDACTED] so as to fall outside the scope of the specific waiver

i. Substantial relationship test in patent cases

As noted above, the scope of the waiver would permit Mayer Brown to represent other clients adverse to LGE in any future matters to the extent they are “substantially unrelated to the technology” involved (1) in *Jenam* or (2) “other matters where [Mayer Brown] represented LGE in the past five (5) years.” Dkt. No. 15, LGE Ex. 24. Stated another way, the waiver does not apply to the extent the technology involved in this case is “substantially related” to *Jenam* or any “other matters” which fall within the five-year window.

The language of the specific waiver and the parties’ arguments both strongly suggest the specific waiver adopted the “substantial relationship” test used in case law. 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.’” *Cinco Bayous, L.L.C. v. Samson Expl., L.L.C.*, No. 1:19-CV-452, 2020 WL 13533320, at *6 (E.D. Tex. Aug. 17, 2020) (citing *Am. Airlines*, 972 F. 2d at 614). In the context of patent litigation, a party who is moving to disqualify counsel must generally demonstrate “a fairly close legal and factual

nexus between the present and prior representations.” *Network Apps, L.L.C. v. AT&T Mobility L.L.C.*, 598 F. Supp. 3d 118, 129–30 (S.D.N.Y. 2022) (citing *Regalo Int’l, L.L.C. v. Munchkin, Inc.*, 211 F. Supp. 3d 682, 689 (D. Del. 2016)).

Accordingly, “the outcomes in patent cases like these have tended to turn on whether there is an understandable connection between prior patent work done by the law firm at issue and the patents or technology areas at issue in the current litigation.” *Network Apps*, 598 F. Supp. 3d at 130 (quoting *Regalo*, 211 F. Supp. 3d at 690; also citing *Decora Inc. v. DW Wallcovering, Inc.*, 899 F. Supp. 132, 138 (S.D.N.Y. 1995) (disqualifying attorney whose prior representation related to the validity of the patent that was directly at issue in the present case)). The court in *Network Apps* denied ATT’s motion to disqualify the plaintiffs’ counsel, noting the fact that “generic telecommunications concepts like ‘SMS messaging,’ ‘provisioning,’ and ‘call interception’ are named in both the ’728 Patent and in AT&T’s prior patent matters is insufficient to create a substantial relationship.” *Id.* at 131.

Other patent cases show that general similarities in broad technical subject matters are not sufficient to disrupt a party’s choice of counsel. *See, e.g., Volterra Semiconductor L.L.C. v. Monolithic Power Sys.*, No. 19 Civ. 2240 (CFC), 2020 WL 8340048, at *4 (D. Del. Aug. 26, 2020) (finding that “DC-to-DC converter technology” was too broad a subject area to establish a substantial relationship between two representations because the technology is employed in “various electronic equipment and systems,” and observing that more than 36,000 U.S. patents mention the technology); *Secure Access, L.L.C. v. Dell Inc.*, No. 6:11 Civ. 338 (LD), 2012 WL 12919543, at *3 (E.D. Tex. Feb. 23, 2012) (“Cases are not substantially related just because they involve the same general subject matter and area of the law.”); *Biax Corp. v. Fujitsu Computer Sys. Corp.*, No. 2:06 Civ. 364 (TJW), 2007 WL 1466638, at *2 (E.D. Tex. May 16, 2007)

(“[Movant’s] argument that both representations involve server architecture is too broad for purposes of establishing a substantial relationship.”); *Power Mosfet Techs., L.L.C. v. Siemens AG*, No. 2:99-CV-168 (DF), 2002 WL 32785219, at *3 (E.D. Tex. Sept. 30, 2002) (“Just because two devices fall into the same general category, e.g. photocopiers . . . does not necessarily mean patent infringement cases in that same category will be substantially related.”)). That is because “the purpose behind barring counsel from representing a party now adverse to a former client in a substantially related matter is to prevent the use or disclosure of confidential information that might leave the former client at a disadvantage”—and there will be no disadvantage if the cases concern dissimilar issues. *Power Mosfet Techs.*, No. 2:99-CV-168, 2002 WL 32785219, at *2.

In *Biax Corp. v. Fujitsu Computer Systems Corp.*, No. 2:06-CV-364, 2007 WL 1466638 (E.D. Tex. May 16, 2007), a patent infringement case involving two patents generally related to microprocessor technology, the defendant Sun sought to disqualify its former counsel (WM&A) from representing the plaintiff Biax. *Id.* at *1. WM&A had previously represented Sun in responding to a charge of patent infringement and prosecuting several Sun patent applications. *Id.* In seeking to show that WM&A’s prior representation was substantially related to the *Biax* case, Sun relied on the legal strategies developed in the prior matters as well as the purported similarity of the technology involved in the prior matters. *Id.* at *2. As relevant here, Sun argued the technology involved in WM&A’s prior patent prosecution work was substantially similar to that asserted in *Biax*, allowing WM&A to gain an “in-depth understanding of Sun’s server and processor architecture.” *Id.* In response, Biax argued that even though the “condition code registers were present in Sun’s prior servers, none of [WM&A’s] prosecution work for Sun involved discussing the condition code registers.” *Id.* The court held Sun failed to meet its burden of establishing a substantial relationship between the technology involved in WM&A’s patent

prosecution work and the technology involved in *Biax*. *Id.* (noting interrupt architecture is a part of server technology unrelated to the performance of code registers or parallel instruction processing). The court concluded that although WM&A’s prior and current representations both involved “server technology, the specific aspects of the server technology related to those representations are quite different.” *Id.* at *3.

This contrasts to the case relied upon by LGE, *Micrografx, L.L.C. v. Samsung Telecommunications Am., L.L.C.*, No. 3:13-CV-3599-N, 2014 WL 12586177 (N.D. Tex. Mar. 7, 2014), wherein the court granted Samsung’s motion to disqualify Micrografx’s counsel based on their prior representation of Samsung in several patent lawsuits over the course of ten years, specifically noting the similarity between the *Micrografx* matter and the counsel’s defense of Samsung in the earlier *Vertical Computer* matter. *Id.* at *1. Both *Vertical Computer* and the *Micrografx* case involved patent infringement claims relating to similar technology used on Samsung’s Galaxy smartphones and tablets. *Id.* at *3. In *Vertical Computer*, the ’744 patent was directed to:

[a] system and method for generating computer applications in an arbitrary object framework ... [that] includes creating arbitrary objects, managing the arbitrary objects ... in an object library, and deploying the arbitrary objects in a design framework for use in complex computer applications.

Id. (quoting ’744 patent, at [57] (filed Oct. 1, 1999)). In the *Micrografx* case, the “invention” covered by the ’633 patent also involved using software libraries holding shapes [objects] to aid in executing computer programs [applications]:

a method and system for generating graphical images ... [that] includes executing a computer program and providing a shape library external to the computer program. The method further comprises providing the capabilities associated with the shape to the computer program while the application is executing.

Id. (quoting ’633 patent, col.1 ll.41–49).

Relying on direct quotes from both patents, statements in the complaints, and counsel's representations, the court determined that "the patent technology involved in both cases allows graphic designers or third parties to update images or graphical objects in a library and deploy the objects to computer programs without rewriting the underlying programs." *Micrografx*, No. 3:13-CV-3599-N, 2014 WL 12586177, at *3. This showed "more than a superficial resemblance between the two cases," and counsel was disqualified. *Id.*

These cases show that in patent cases, even without an explicit focus on the relatedness of the "technology" as contained in the *Jenam* Engagement Letter's specific waiver, the analysis under the "substantial relationship" test involves more than just showing the at-issue matters involve the same generic technical areas or concepts. Indeed, the analysis involves a "painstaking analysis" of comparing the patents and products in the current and prior representations.

Pantech argued that LGE's briefing did not "attempt[] to draw out this level of comparison, instead relying exclusively on the broad and conclusory allegations of its declarants." Dkt. No. 60 at 5. At the hearing, LGE provided the Court with a technology chart attempting to make this level of comparison. *See* Dkt. No. 65 (LGE's Sealed Hearing Ex. 1). The Court allowed LGE to introduce the exhibit into the record but stated it would allow both parties the opportunity to address the exhibit to the extent it becomes important to the Court's analysis. Dkt. No. 67 (Transcript) at 111:7-114:19. The undersigned subsequently called for additional briefing related to the exhibit, limited to whether a substantial relationship exists between the technology involved in this matter and the *MTT* and *Core Wireless* matters. Dkt. No. 89; *see also* Dkt. No. 90 (Joint Supplemental Briefing on the February 1, 2023 Hearing).

ii. Application of the test to *Jenam*

In this matter, Pantech asserts seven patents related to smartphones and cellular communications—including five purported standard essential patents (“SEPs”) allegedly relating to LTE and 5G—against various LGE cellular devices. Complaint for Patent Infringement (Dkt. No. 1), ¶¶ 11-13. The Asserted Patents are U.S. Patent Nos. 9,136,924 (the “924 Patent”); 9,854,545 (the “545 Patent”); 10,869,247 (the “247 Patent”); 9,313,809 (the “809 Patent”); 9,065,486 (the “486 Patent”); 7,283,839 (the “839 Patent”); and 9,575,631 (the “631 Patent”). *Id.*, ¶¶ 13-20.

Four attorneys for Pantech (Beaber, Miller, Paul, and Saddiqui) were involved in *Jenam*, a case in which Mayer Brown represented LGE, [REDACTED], for approximately six months (July/August 2019 through January 2020). Suh Decl., ¶ 18; Dkt. No. 15, LGE Ex. 28 at 1. The *Jenam* Engagement Letter defined the scope of the joint representation as “limited to the defense of the plaintiff’s infringement allegations . . . against the Google Chrome browser application on LGE’s Android devices.” Dkt. No. 15, LGE Ex. 24 at 1. The *Jenam* matter involved two patents, U.S. Patent Nos. 9,923,995 and 9,923,996, which “purportedly covered certain communication protocols used by the web browsers on various LGE devices.” Suh Decl., ¶ 18; *see also* Dkt. No. 15, LGE Ex. 11 (*Jenam* complaint). The *Jenam* complaint accused several LGE devices that are accused in *Pantech* as well. Suh Decl., ¶ 18; *see also* Dkt. No. 15, LGE Ex. 11, ¶ 7.

The record shows the *Jenam* matter was fundamentally concerned with [REDACTED] not LGE, technology. As both parties acknowledge, the *Jenam* matter was directed to infringement based on Google functionality. Beaber Decl., ¶ 7; Suh Decl., ¶ 18. The *Jenam* Engagement Letter clarified that “the scope of the [REDACTED] does not extend to any non-Google products, services or issues. . . .” Beaber Decl., ¶ 7; *see also* Dkt. No. 15, LGE Ex. 24 at 1 (further noting that the

scope of the [REDACTED] did not extend to “any other allegations against LGE” or “any other business, personal or legal affairs of LGE”). Counsel for Pantech argued at the hearing that “the technology that was at issue in that case was Google Chrome,” which is not at issue in *Pantech*. Dkt. No. 67 (Transcript) at 69:3-5.

During the *Jenam* matter, LGE went so far as to submit a declaration distancing itself from the technology at issue in *Jenam*. See Dkt. No. 45-6 (Juseong Ryu’s declaration in support of LGE’s motion to transfer venue, “Ryu Decl.”). Ryu stated his understanding of *Jenam*, leaving no doubt that LGE took the position its technology was not at issue in *Jenam*:

- The “Jenam [matter] alleges infringement based on technology relating to transmission control protocol (‘TCP’) generally and Google’s implementation of the QUIC protocol. . . and Google Chrome specifically.” Ryu Decl., ¶ 11.
- “[T]he primary design, development, and implementation of Google’s QUIC protocol and Google Chrome was done by Google.” *Id.*, ¶ 12.
- “LG does not have any employees (in EDTX or elsewhere) that are involved in, let alone control, the design and development of any features of Google’s QUIC protocol used by Google Chrome.” *Id.*, ¶ 13.
- “LG does not have any employees (in EDTX or elsewhere) that modify any aspect of the source code for Google’s QUIC protocol used by Google Chrome.” *Id.*, ¶ 14.
- “LG does not have any source code or internal, non-public technical documentation regarding Google’s QUIC protocol used by Google Chrome.” *Id.*, ¶ 15.⁹

Presumably because of their differences, LGE never attempts to compare the patented technology in the *Pantech* matter to the communication protocols used by Google’s Chrome in *Jenam*. Rather, LGE argues that the two matters are substantially related because LGE shared with

⁹ Declarations are statements made under the penalty of perjury. When used early in cases, they are too often submitted as attorney argument that can later be abandoned without repercussion, an opportunity to craft an incomplete narrative, or an exercise in advocacy that can shift to accommodate any change in litigation strategy. Declarations in support of motions that, if granted, would effectively insulate the statements from later discovery presents its own set of temptations. This case shows the challenges the Court faces in relying on such declarations: To secure a transfer to a different venue in *Jenam*, LGE submitted a declaration to purportedly show its technology was not at issue in the *Jenam* matter, whereas now, to secure disqualification of opposing counsel, LGE submits declarations and other evidence to argue the opposite.

Mayer Brown “highly confidential documents describing hardware functionalities of LGE’s devices” concerning products that are at issue here. Dkt. No. 54 at 6-7; *see also* Dkt. No. 67 at 25:4-10 (describing confidential information that was at least partially shared during the *Jenam* matter); *see also id.* at 25:4-10 (identifying confidential information shared in various matters, including *Jenam*); Hong Decl., ¶ 12 (similar); Hong Second Decl., ¶¶ 3, 9 (similar).

But LGE’s consent in the specific waiver does not turn on what confidential information was disclosed to Mayer Brown during the prior representations. It turns on whether “the technology involved” in *Jenam* and *Pantech* are substantially unrelated. LGE’s only argument on that front is to show both matters involve some of the same accused products. Simply showing an overlap of accused products, however, is not sufficient because accused products, especially wireless and cellular devices, often contain **many** different technologies. Two different cases can accuse the same product and still concern substantially unrelated technology.

Even if the Court were to ignore the specific waiver’s language and broaden its analysis beyond the “technology involved” in the *Jenam* matter (i.e., Google’s QUIC protocol as used in LGE devices) to consider *any* technology disclosed in the documents exchanged during that representation, LGE still fails to show a substantial relationship. For example, at the hearing, LGE submitted a service manual for the V410 device for *in-camera* inspection; with LGE stating this manual was given to Mayer Brown during the *Jenam* matter and concerns a product accused of infringement here. The manual “provides the information necessary to repair, calibration, description and download the features of this model” and describes the device’s parts and features. But LGE never showed how the information in the manual relates to the technology in the *Pantech* matter. While Pantech will likely have to identify controllers, transceivers, displays, etc. as part of its infringement case, Mayer Brown’s previously receiving a service manual that confirms LGE’s

devices actually have such high-level components (and identifies them by model) is not sufficient to show the requisite level of relatedness. Put simply, showing patent claims in this matter call for “displays” or “processors” and that LGE previously disclosed a manual showing the specific type of display or processor to Mayer Brown in *Jenam*, shows no more relatedness than showing the two matters involve the same products.

Also at the hearing, LGE submitted a technology comparison chart that compares a patent in each prior matter with a patent in the *Pantech* matter. Dkt. No. 65 (LGE’s Sealed Hearing Ex. 1). For *Jenam*, LGE compares claim 1 of the ’995 patent asserted in *Jenam*, which concerns a device that receives and analyzes transmission control packets in a specific way, with the ’839 Patent asserted here, which concerns a device that displays messages and multimedia files in a single interface in a specific way. *Id.* at 4. The chart shows that claim 1 of the ’955 patent recited “one or more processors” of the claimed device, while claim 1 of the ’839 Patent calls for a device that includes a “controller.” Once again, this simply shows a high-level and ubiquitous component in wireless devices—a “processor”/“controller”—was involved in both cases. That does not consider the substantially unrelated nature of the technology involved in the two patent claims (transmission control protocols versus user interfaces).

After reviewing all LGE’s arguments and evidence, LGE fails to meet its burden of establishing a substantial relationship between the technology involved in *Pantech* and *Jenam* such that *Jenam* would fall outside the scope of the specific waiver. Thus, LGE has waived its ability to request disqualification based on Mayer Brown’s prior representation in the *Jenam* matter, including any argument that there is a reasonable probability that Mayer Brown will misuse LGE confidential information. *See* Texas Rule 1.09(a); ABA Model Rule 1.9(a).

iii. Application of the test to *CCE*

The *CCE* matter involved at least ten patents, several of which were purportedly standard essential patents (“SEPs”), spread across multiple complaints. Suh Decl., ¶ 10; *see also* Dkt. No. 15, LGE Ex. Exs. 1-3 (*CCE* complaints); Dkt. No. 15, LGE Exs. 4-6 (*CCE* docket sheets). In addition to tacitly implicating all devices that complied with the 3GPP standards purportedly covered by the asserted SEPs, the complaints in the *CCE* matter accused specific LGE LTE devices of infringement that are also accused by Pantech here. Suh Decl., ¶ 10; *see also* Dkt. No. 15, LGE Ex. 2, ¶ 22.

LGE shows that Mayer Brown’s representation in the *CCE* matter was much more comprehensive compared to *Jenam*, involving more technologies and significantly greater sharing of confidential information. But like *Jenam*, LGE’s argument focuses on the fact that Mayer Brown received confidential information in *CCE*, including product documentation and source code, concerning products that are also accused in the *Pantech* matter. *See, e.g.*, Dkt. No. 15 at 3; Dkt. No. 54 at 7-8; Hong Second Decl., ¶ 5. LGE’s argument fails for the same reasons outlined above with respect to *Jenam*: Simply showing product overlap is not sufficient to show both cases involve substantially related technology. Nor is it sufficient to allege that some aspects of the confidential information that was disclosed in *CCE* relate to the patents asserted by Pantech. The specific waiver in the *Jenam* Engagement Letter could have been crafted to condition LGE’s consent based on the specific information it previously disclosed to Mayer Brown, but it does not. Instead, it calls for comparing only the technology in the two matters—without reference to what confidential information was or was not disclosed.

LGE makes an additional argument that *CCE* and *Pantech* are substantially similar because both involve alleged SEPs concerning the same cellular standards. Dkt. No. 15 at 3 & n.5. Pantech

explained in briefing and at the hearing that cellular standards are large, comprehensive documents that may involve many different patents. Dkt. No. 67 (Transcript) 73:16-74:12; Dkt. No. 45 at 16 (“The 3GPP TS 36.321 specification itself consists of multiple releases, is over 100 pages long, includes seven different sections each with multiple subsections, dealing with the various nuances of the technology, and broadly covers ‘the E-UTRA MAC protocol.’”) (citing Ex. 4, 3GPP TS 36.321 version 15.2.0 Release 15). LGE did not challenge that characterization of cellular standards. Much like wireless and cellular devices can involve many different technologies, so can standards. Stated another way, two matters can involve the same cellular standards yet still concern substantially unrelated technology for purposes of a waiver; thus, LGE’s argument that it did not consent to Mayer Brown’s future representation to adverse matters concerning the same standards involved in *CCE* fails.

Reliance on cellular standards to satisfy the substantial relationship test requires more than showing both matters involve the same standard technical specifications. Standard-compliant products, by their nature, comply with the standard. The multitude of cellular devices from disparate manufacturers which comply with a particular standard strongly counsels against finding matters are substantially related simply because both involve the same standard without considering more details of the underlying technology, functionality, or implementation.¹⁰

¹⁰ Pantech’s counsel explained its infringement case for the SEPs will focus on how Pantech’s patents “read on the standard itself” as opposed to the underlying functionality of LGE’s devices. Dkt. No. 67 (Transcript) at 76:4-77:6. Taking that statement as true with respect to the SEPs further shows that disqualification would not be warranted based solely a prior representation concerning the same cellular standards: the infringement case likely could have been substantially decided by (and therefore focused on) the public standards rather than the specifics of any previously exchanged confidential information.

Relatedly, LGE has failed to persuasively show that Pantech’s infringement allegations based on the standards asserted here will be materially advanced by LGE confidential information. *See TQ Delta, L.L.C., v. 2WIRE, Inc.*, No. CV 13-1835-RGA, 2016 WL 5402180, at *6 (D. Del. Sept. 26, 2016) (counsel seeking disqualification based on prior representation recognizing that previously exchanged confidential information does not create a conflict for an infringement theory based on a “purely standards-based” read).

LGE's technology comparison chart provided at the hearing is LGE's most specific attempt to analyze the technologies involved in *CCE* and *Pantech*. Dkt. No. 65 (LGE's Sealed Hearing Ex. 1) at 1-2. The chart compares two specification passages and claim 1 of the '556 patent in *CCE* with claim one of the '545 Patent asserted by Pantech. *Id.* Based on that chart, the '556 patent concerns carrier aggregation for aggregating two or more serving cells to support wider transmission bandwidths, whereas the '545 Patent concerns transmitting, receiving, and evaluating uplink timing group information. *Id.* The chart attempts to show technology is substantially related by highlighting that both patents involve "component carriers" ("or serving cells") as well as "user equipment." That would be true in many, if not most, patent cases involving cellular devices, and as explained in Section IV(B)(3)(b)(i) above, showing both matters reference such broad technologies does not show substantial similarity.¹¹

For the above reasons, LGE fails to show its consent to Mayer Brown's representation of Pantech is limited by Mayer Brown's prior representation in the *CCE* matter. LGE has waived its right to request disqualification based on Mayer Brown's prior representation of LGE in the *CCE* matter.

iv. Application of the test to *MTT*

According to LGE, similar to the '839 Patent asserted here (Dkt. No. 1, ¶ 19), the three patents at issue in *MTT* (U.S. Pat. Nos. 5,809,428, 5,754,946, and 5,894,506) pertained to how the messaging services and applications operating on the accused devices process messages. Suh

¹¹ At the hearing, LGE argued that the '556 patent "dealt with uplink and setting uplink power for – to different LTE products" which is "similar" to claims 1 and 2 and of Pantech's '545 Patent. Dkt. No. 67 (Transcript) at 40:14-22. That is more specific than highlighting that both patents involve servicing cells or user equipment, but it is still conclusory. Looking at the cited claims and Abstracts in both patents, Pantech's '545 Patent focuses on uplink timing groups as part of uplink synchronization (and does not mention setting uplink "power" in the specification), whereas *CCE*'s '556 patent appears to focus on transmitting and receiving power headroom reports in uplink. While both involve uplinks, 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.

Decl., ¶ 9 (stating the three patents purportedly covered LGE’s “network operation centers, [and] mobile units”); *see also* Dkt. No. 15, LGE Ex. 9 (*MTT* complaint), ¶¶ 6, 10, 14, 21, 24, 30, 33. The *MTT* complaint accused several LGE smartphones of infringement that are accused by Pantech, including the LG Phoenix and others. Suh Decl., ¶ 9; *see also* Dkt. No. 15, LGE Ex. 9, ¶¶ 14, 24, 33.

LGE’s arguments concerning *MTT* are much more specific compared to its arguments concerning *Jenam* or *CCE*. LGE’s counsel stated that with respect to *MTT* (unlike *Jenam* and *CCE*), it is not “just the same devices and . . . components,” that are involved in this matter, but “it’s also the exact same messaging application” that was alleged against LGE in both *MTT* and *Pantech* via the ’839 Patent. Dkt. No. 67 (Transcript) at 20:18-24. The provided technology comparison chart shows that in *MTT*, the accused technology was “a message terminal” that used “canned messages” for canned responses (akin to an auto-fill feature) whereas Pantech’s ’839 Patent concerns “an integrated messaging service program [with] an integrated user interface” that analyzes and displays message content and associated description data in specific ways. Dkt. No. 65 at 1. LGE’s counsel likewise stated at the hearing that *MTT*’s ’506 patent dealt with LGE’s Messenger Application, and Messenger Application is also being asserted in claim 1 of the ’839 Patent in this case. Dkt. No. 67 (Transcript) at 40:7-13; *see also* Dkt. No. 90 at 1-2 (similar arguments in the supplemental briefing).

The Court invited Pantech to respond to LGE’s technology comparison chart and arguments. Pantech does not dispute that both cases involve the same messaging application on some of the same devices but argues the technology involved is different because the *MTT* patent concerned selecting, sending, and receiving canned messages in a device whereas claim 1 of

Pantech's '839 Patent concerns determining a "type" of message and displaying message content that is **inputted** into the device (as opposed to **predefined** content). Dkt. No. 90 at 3-4.

Pantech fails to show a meaningful difference in the technologies at issue. Both matters involve the same messaging app on the same devices. Further, both matters concern how the app displays message content. Both cited claims require analyzing the messages for additional information to display (claim 1 of the '506 patent analyzes the message code related to the message while claim 1 of the '839 Patent analyzes the type of message and description data associated with the message). Pantech's above arguments show the differences in the specific claimed inventions but do not effectively rebut LGE's showing that the inventions concern the same specific area of technology.

Accordingly, *MTT* falls outside the scope of the specific waiver provision in the *Jenam* Engagement Letter, and LGE has not waived its right to assert conflicts as they relate to Mayer Brown's prior representation of LGE in the *MTT* matter.

v. Application of the test to *Core Wireless*

LGE contends that like the '631 Patent asserted here (Dkt. No. 1, ¶ 20), two patents at issue in *Core Wireless* (U.S. Pat. Nos. 8,713,476 and 8,434,020) related to how user interface elements are presented to users for accessing applications within wireless mobile devices. Suh Decl., ¶ 11; *see also* Dkt. No. 15, LGE Ex. 7 (*Core Wireless* complaint), ¶¶ 16, 34. The *Core Wireless* complaint accused several LGE products of infringement, including the LG G Pad family of tablets, that appear to be at issue here. Suh Decl., ¶ 11; *see also* Dkt. No. 15, LGE Ex. 7, ¶ 14; *see also* Dkt. No. 1, ¶ 12 (stating "LG G Pad 5 10.1 FHD; LG G Pad F2 8.0; LG G Pad X II 8.0 PLUS; LG G Pad X II 10.1"; LG G Pad F 8.0" 2nd Gen; LG G Pad X 8.0"; LG G Pad F 8.0" 2nd Gen;

LG G Pad F 8.0; LG G Pad X 10.1"; LG G Pad X 8.3; LG G Pad F7.0; LG G Pad 7.0 LTE; and LG G Pad 8.3 LTE devices are compliant with LTE and/or 5G cellular network standards”).

Like *MTT* above, LGE focuses on the specific technologies involved in *Core Wireless* and *Pantech*. For example, in its supplemental briefing, LGE argues “the claims in both *Core Wireless* and this case relate to methods of presenting an interactive display for launching and manipulating application functions allegedly used in LGE’s products.” Dkt. No. 90 at 2. LGE then color codes the claims to show similarity in its technology comparison chart (Dkt. No. 65 at 3-4):

U.S. 8,713,476 at 7:9-22 (asserted in <i>Core Wireless</i>)	U.S. 9,575,631 at 7:37-67 (asserted by Pantech)
A method comprising: displaying, on a computing device having a display screen, a menu listing one or more applications; ... and in response to a user selection of particular data, launching the respective application associated with the selected data to enable the selected data to be seen within the respective application.	A method ... comprising: displaying one icon in a designated portion of a display ...; if the displayed icon corresponding to the first work process is selected, displaying a screen of the first work process in the display; ... performing sequential display of icons ...; ... activating a control menu... [and] controlling the predetermined function of the first work process through the activated control menu.

According to LGE, the overlapping claimed subject matter relates to similar interactive display technologies that are allegedly in LGE’s phones and tablets and concern legal issues and evidence likely to be relevant in both litigations. Dkt. No. 90 at 2.

Pantech responds that the technology is different in the two claims above because the ’476 patent in *Core Wireless* is directed to displaying “a menu listing” of applications, processing the user selection of the menu listing, and launching the respective application, whereas claim 1 of the ’631 Patent is directed to “displaying an icon corresponding to a ‘work process’ and then displaying a screen corresponding to a ‘work process,’” in a multitasking environment with

additional features. Dkt. No. 90 at 2. Similar to its argument concerning *MTT*, Pantech asserts the technology in the two claims above are different by emphasizing specific differences in the claimed inventions. That the inventions are different does not necessarily show that the technology is substantially unrelated—both claims concern user inputs on display via selecting “menu listings”/“icons” to launch “applications”/display “work processes.” That the ’631 Patent contains additional features concerning multitasking does not show it involves a different technology.

Pantech asserts in a footnote that the *Core Wireless* matter should be “disregarded” because LGE does not dispute that “Mayer Brown played no substantive role” with respect to the *Core Wireless* litigation. *Id.* at 4, n. 1. Specifically, Pantech states:

LGE was represented by Greenberg Traurig, LLP, and Mr. Beaber and one other Mayer Brown attorney merely noticed appearances in the case to monitor the filings and consider any impact on the confidential arbitration. *See* Beaber Second Decl. at ¶4. Mayer Brown played no substantive role, and LGE has not contested this fact. For this reason, LGE’s chart should be disregarded.

Id.; *see also* Dkt. No. 60 at 3 n. 3 (stating Mayer Brown did not receive any confidential information in connection with Beaber’s appearance in the *Core Wireless* case and had no material involvement with any of the matters at issue in the case).

According to ABA Rule 1.9, comment 2, the scope of Mayer Brown’s substantive involvement on behalf of LGE in the *Core Wireless* case more precisely goes to the issue of whether that is a “matter” warranting disqualification. Accordingly, Pantech’s argument will be addressed when considering if that matter creates a conflict of interest below. But when considering whether LGE waived any conflict potentially arising from the *Core Wireless* matter under the specific waiver, Pantech points to no language that considers the level of Mayer Brown’s involvement. Pantech admits that Beaber made an appearance in *Core Wireless* on behalf of LGE

on October 21, 2015 and presents no persuasive argument or controlling law that its role, admittedly limited, is not considered “representation” as contemplated by the specific waiver.

Accordingly, *Core Wireless* also falls outside the scope of the specific waiver provision in the *Jenam* Engagement Letter, and LGE has not waived its right to request disqualification based on Mayer Brown’s prior representation of LGE in the *Core Wireless* matter.

vi. Application of the test to [REDACTED]

For approximately two years, Mayer Brown represented LGE in a confidential arbitration with [REDACTED] pertaining to what, if any, fair reasonable and non-discrimination (FRAND) royalty rates are owed to [REDACTED] for licensing its worldwide portfolio of alleged standard essential patents (SEPs). Suh Decl., ¶ 13. The alleged SEPs at issue in [REDACTED] included hundreds of patent families allegedly directed to 3G and 4G LTE cellular network technology, approximately [REDACTED] of which were substantively analyzed by Mayer Brown. *Id.*, ¶ 14. For example, Pantech’s complaint alleges that the asserted ’545 Patent covers at least the 3GPP TS 36.321, TS 36.213, and TS 36.331 standards pertaining to functionality mandated by at least the LTE Advanced standard (Dkt. No. 1, ¶¶ 65-69), but Mayer Brown (while representing LGE) analyzed these same standards along with LGE confidential information to assess infringement during [REDACTED]. *See* Suh Decl., ¶¶ 14-16. Similarly, Pantech’s complaint alleges the ’809 Patent implicates the 3GPP TS 25.211 and TS 25.321 standards related to the communications protocols used in WCDMA, and that the ’486 Patent implicates the 3GPP TS 36.212 standard pertaining to turbo codes. Dkt. No. 1, ¶¶ 95-103, 109-117. Again, in representing LGE, Mayer Brown analyzed these same standards and LGE confidential information for infringement in [REDACTED]. Suh Decl., ¶¶ 14-16.

LGE shows Mayer Brown’s representation of LGE in the [REDACTED] matter was extensive and, according to LGE, involved “comparing the patents-at-issue to the relevant technical standards,

determining whether and how LGE products implemented certain technical standards or optional features of the standards, conducting invalidity analyses of the patents, preparing substantive briefs, and working with witnesses and experts on these issues as well as those pertaining to FRAND licensing and royalties.” Suh Decl., ¶ 15. 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.” *Id.* 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 the approaches used for licensing and the concessions normally made in its licenses,” as well as “at least two licenses.” *Id.*, ¶ 16; *see also* Hong Decl., ¶ 18 (describing similar aspects of Mayer Brown’s representation); Suh Second Decl., ¶¶ 5-6 (providing additional statements supporting Suh’s first declaration); Hong Second Decl., ¶¶ 7-8 (providing additional statements supporting Hong’s first declaration). Pantech does not dispute the particulars of LGE’s statements but responds that the “focus” of the arbitration was “the strength of [REDACTED] portfolio, as measured through an analysis of the validity and essentiality of the portfolio patents.” Beaver Decl., ¶¶ 3-4.

As discussed extensively above with respect to *Jenam* and *CCE*, LGE cannot show that [REDACTED] and *Pantech* involve substantially related technology (as contemplated by the *Jenam* Engagement Letter’s specific waiver) simply because there is an overlap of products and cellular standards in both matters. Also, as explained above, LGE cannot meet its burden by arguing that the exchanged confidential information contains disclosures (possibly unrelated to the technology/issues in [REDACTED]) that could be relevant to the *Pantech* matter. The specific waiver’s language refers to the technology in the matters, which is not necessarily coextensive with the full extent of the technology described in the confidential information exchanged.

LGE's arguments concerning financial information likewise fail. It may be true that Mayer Brown will value Pantech's SEPs for the same standards and products it considered in [REDACTED]. While this has the potential to show similarity between the two matters from a damages perspective, it does not show the technologies involved in both matters are substantially related. And just as the specific waiver did not limit LGE's consent to the technology exchanged in the confidential materials, it does not limit LGE's consent by confidential damages information or knowledge that Mayer Brown gained regarding LGE's licensing strategies.

For the above reasons, LGE fails to show its consent to Mayer Brown's representation of Pantech is limited by Mayer Brown's prior representation in the [REDACTED] matter. LGE has waived its right to object to Mayer Brown's representation of Pantech based on Mayer Brown's prior representation of LGE in the [REDACTED] matter.

C. Summary regarding waiver

The record does not show that this was a tactical motion filed by LGE. Rather, in hindsight, the parties have sincere and differing views as to the scope of the specific waiver. That is not surprising given the waiver references "other matters" (at LGE's request) instead of identifying them by name; does not give any indication as to the type of technology the consent would be limited to (unlike common practice in prosecution bars, for example); and does not mention Pantech by name.¹² Moreover, while the waiver gave Mayer Brown consent to represent clients adverse to LGE in certain future matters, it did not address Mayer Brown's prior exposure to

¹² Although a party may identify a particular party or the nature of a potentially conflicting future matter, this type of language is not necessary for a client to give informed consent, given the 2002 amendments to the ABA Model Rules. *Galderma Lab'ys, L.P. v. Actavis Mid Atl. L.L.C.*, 927 F. Supp. 2d 390, 401 (N.D. Tex. 2013) (citing ABA Formal Op. 05-436).

LGE's confidential information that is the focus of so much of LGE's motion. The parties were left to sort out those issues at a later date.

When the dispute became apparent, the issue was complicated by Mayer Brown's shifting views on whether the Pantech adversity was concurrent or future at the time the *Jenam* Engagement Letter was executed,¹³ views that would call for different contract provisions and ethical rules to be applied (ABA Model Rule 1.7 versus 1.9). Likewise, LGE's focus on the aggregate of confidential information exchanged in the prior representations without first applying the language of the specific waiver further complicated the dispute.

After a "painstaking analysis of the facts and precise application of precedent," the Court finds LGE has contractually waived its right to request disqualification based on Mayer Brown's prior representations of LGE in *Jenam*, *CCE*, and [REDACTED]. However, LGE has not contractually waived its right to raise disqualification based on Mayer Brown's prior representations of LGE in *Core Wireless* and *MTT*, which are addressed further below.

V. CONFLICTS OF INTEREST ANALYSIS

For both *Core Wireless* and *MTT*, LGE asserts (1) the current representation involves a substantially related matter, giving rise to an irrebuttable presumption that relevant confidential information was disclosed, and (2) the current representation in reasonable probability will involve a violation of Texas Rule 1.05. In its conflicts of interest analysis below, the Court must first determine, as to *Core Wireless* and *MTT*, whether Mayer Brown has violated a rule of professional

¹³ For example, in the April 2021 licensing emails, Beaber stated two times that IdeaHub/Pantech were clients of Mayer Brown and were adverse to LGE before LGE executed the *Jenam* Engagement Letter. Dkt. No. 15, LGE Ex. 26 (licensing emails) (further stating that the specific waiver "only applies to future matters"). Relatedly, Mayer Brown suggested different dates that triggered the start of the five-year window throughout this dispute, eventually settling on a position with no support in the language of the specific waiver or in the case law.

conduct by representing Pantech in this lawsuit. Second, if such a rule violation has occurred for one or both matters, the Court must decide whether disqualification is the appropriate remedy.

A. Applicable law

The Fifth Circuit has opined that the relevant ethical rules involved in this case, ABA Rule 1.9 and Texas Rule 1.09 which govern conflicts of interest with former clients, are identical in all important respects. *Hillman Grp., Inc. v. KeyMe, L.L.C.*, 439 F. Supp. 3d 845, 852 (E.D. Tex. 2020) (citing *In re Am. Airlines*, 972 F.2d 605, 615 n.2 (5th Cir. 1992) (focusing discussion on Texas Rules due to their similarity to ABA Model Rules)). Here, the Court focuses on Texas Rule 1.09(a), which provides “two district grounds for disqualification.” *Hutton v. Parker-Hannifin Corp.*, No. CV H-15-3759, 2016 WL 4140736, at *3 (S.D. Tex. Aug. 4, 2016). There is a conflict if (1) “the current matter is substantially related to the matters in which the lawyer has represented the former client,” TEX. DISC. RULES. PROF. CONDUCT R. 1.09(a)(3); or (2) “the current representation in reasonable probability will involve the use of confidential information” against the former client. TEX. DISC. RULES. PROF. CONDUCT R. 1.09 (a)(2).

The substantial relationship test under Texas Rule 1.09(a)(3) is governed by an irrebuttable presumption: once 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.” *Am. Airlines*, 972 F.2d at 614 (citation omitted). “The test is categorical in requiring disqualification upon the establishment of a substantial relationship between past and current representations.” *Id.* The test, however, is not applied “in a mechanical way that might ‘prevent[] an attorney from ever representing an interest adverse to that of a former client.’” *Id.* (citation omitted). Rather, the Fifth Circuit has held that “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.’” *Id.* (citations omitted).

Even where the subject matter of the prior representation and the current action are not substantially related, disqualification may still be warranted under Texas Rule 1.09(a)(2), which forbids a lawyer to appear against a former client if the current representation in reasonable probability will involve the use of confidential information that was provided by the former client. *Hutton*, No. CV H-15-3759, 2016 WL 4140736, at *6 (internal quotations and citations omitted). This “threat of disclosure” test “expand[s] the protections for former clients beyond those afforded by the substantial relationship test.” *Id.* (citations omitted). Under this test, the moving party must “identify the disclosures it made to [its former attorney] during its former representation and demonstrate that such disclosures are relevant to and jeopardized by [its former attorney’s] current representation of the [opposing party].” *Id.* (citations omitted). However, the moving party need not “delineate specifically the common subject matter and issues because requiring such detail about confidential disclosures would require [the moving party] to reveal the very information it seeks to protect.” *Id.* (citations omitted).

B. Whether Mayer Brown’s prior representation of LGE in *Core Wireless* creates a conflict of interest

While LGE argues that Mayer Brown’s representation of Pantech violates Texas Rule 1.09(a) and ABA Rule 1.9 based on, in part, Mayer Brown’s “representation” of LGE in *Core Wireless* (Dkt. No. 15 at 15), LGE does not dispute Beaber’s assertions that Mayer Brown’s role in *Core Wireless* was limited to his appearance in the case to monitor the filings so that Mayer Brown could consider its impact on the [REDACTED] arbitration. *See* Beaber Second Decl., ¶ 4. Given that concession, LGE fails to show disqualification is warranted based on *Core Wireless*. The rules themselves do not contemplate disqualification based on such limited “scope:”

The *scope* of a “matter” for purposes of this *Rule depends on the facts of a particular situation* or transaction. *The lawyer’s involvement in a matter can also be a question of degree.*

ABA MODEL RULES PROF. CONDUCT R. 1.9, cmt. 2 (emphasis added). Given Mayer Brown’s limited involvement in *Core Wireless*, it is unsurprising that LGE fails to “delineate with specificity the subject matters” that are “common to prior and current representations” as required to warrant disqualification based on the matters’ substantial relationship. *Am. Airlines*, 972 F.2d at 614; *see also* TEX. DISC. RULES. PROF. CONDUCT R. 1.09(a)(3); ABA MODEL RULES PROF. CONDUCT R. 1.9(a).

For similar reasons, there is no threat of disclosing confidential LGE information. While the technology involved is substantially related, LGE has not identified information related to that technology that flowed to or from Beaber, any pleading he worked on, any advice he gave, or any time he spent on the matter at all. *See* Beaber Second Decl., ¶ 4; Suh Decl., ¶ 5 (admitting Beaber did not bill for any work in *Core Wireless*). Nor could LGE rely on the irrebuttable presumption that Beaber received confidential information as expressed in *Micrographx*. *See* Dkt. No. 15 at 15. There, the court found unavailing disqualified counsel’s argument that a prior representation was too cursory to defeat the irrebuttable presumption, but that was premised on the fact that the attorney gave some kind of “advice” or otherwise “worked” on the prior matter:

The presumption that a former client in a substantially related matter disclosed confidential information to the attorney is *irrebuttable*. *See, e.g., Am. Airlines*, 972 F.2d at 619 (“[B]ecause the substantial relationship test is concerned with both a lawyer’s duty of confidentiality and his duty of loyalty, a lawyer **who has given advice** in a substantially related matter must be disqualified, *whether or not he has gained confidences*.” (emphasis added)); *In re Columbia Valley Healthcare Sys., L.P.*, 320 S.W.3d 819, 824 (Tex. 2010) (“If the lawyer **works on a matter**, there is an irrebuttable presumption that the lawyer obtained confidential information during representation.”).

Micrografx, L.L.C. v. Samsung Telecommunications Am., L.L.C., No. 3:13-CV-3599-N, 2014 WL 12586177, at *4 (N.D. Tex. Mar. 7, 2014) (emphasis added).

Here, LGE never asserts that Beaber gave any advice or performed work on the *Core Wireless* matter at all. And unlike the disqualified counsel in *Micrografx*, there is no indication Beaber's name was on any pleading filed on the *Core Wireless* docket. Suh's declaration shows that Beaber's involvement in *Core Wireless* was "included in the work done as part of the [REDACTED] matter," not the other way around. Suh Second Decl., ¶ 3. Because LGE does not show Beaber received confidential information with respect to his limited role in the *Core Wireless* matter, LGE also fails to show Mayer Brown should be disqualified based on the threat of improper use of information gained from *Core Wireless* under Texas Rule 1.09(a)(2) or ABA Rule 1.9(c).

C. Whether Mayer Brown's prior representation of LGE in *MTT* creates a conflict of interest

Jamie Beaber, Baldine Paul, and Tiffany Miller substantively worked for LGE in the *MTT* matter between 2013 – 2016.¹⁴ As discussed above, Pantech's assertion that LGE's Messaging App infringes the '839 Patent is substantially related to the infringement allegations in *MTT*. Although *MTT* is substantially related to the technology involved in at least one of the seven asserted patents in this case, the question remains whether Mayer Brown's prior representation of LGE in *MTT* was "substantially related" to this much larger proceeding such that continued representation of Pantech would be a conflict of interest.

Here, the three attorneys' three-year representation of LGE in *MTT* exposed Beaber, Paul, and Miller to information about LGE's Messaging App that could be used against LGE in this case. *See, e.g., Micrografx*, No. 3:13-CV-3599-N, 2014 WL 12586177, at *1 (disqualifying

¹⁴ According to the declaration of Suh, Beaber did not bill for his time spent on *MTT* even though he was the lead attorney and primary point of contact. Suh Decl., ¶ 4. Paul billed eleven hours and Miller billed 132 hours. *Id.*, ¶ 5.

counsel who represented its former client through the initial pleading stage in a substantially related matter). However, aside from Mayer Brown gaining knowledge concerning “messaging services/applications and user interfaces,” Dkt. No. 54 at 8, LGE has not identified any other unfair advantage Pantech might gain based on Mayer Brown’s defense of LGE in *MTT*. Nor does LGE argue Mayer Brown’s representation of *MTT* touches on the other six patents Pantech asserts here.

Unlike with other matters addressed in their briefing, LGE does not argue that Mayer Brown had access in *MTT* to pertinent IP strategies, defenses, or other information which would go “a long way toward establishing the substantial relationship.” *See* Dkt. No. 54 at 7 (quoting *Staton Techiya, LLC v. Samsung Elecs. Co.*, No. 2:21-CV-00413, 2022 WL 16964746, at *2 (E.D. Tex. Nov. 16, 2022)); *see also id.* at 10 (arguing that it was the [REDACTED] matter, not *MTT*, where Mayer Brown learned how LGE valued SEPs, the existence of relevant licenses). Additionally, while LGE argues the damages period alleged in the Pantech complaint (accusing LGE of infringing “now and within the past six years”) includes the period of time when Mayer Brown was representing LGE in the [REDACTED], *CCE*, *Core Wireless*, and *Jenam* matters, LGE does not similarly argue with respect to *MTT*, presumably because *MTT* is the oldest of all the “other matters” considered herein. *Id.* at 6.

However, because *MTT* is a substantially related matter, Mayer Brown is presumed to have obtained confidential information related to the subject matter involved (i.e., infringement of LGE’s Messaging App).¹⁵ *See also In re Columbia Valley Healthcare Sys., L.P.*, 320 S.W.3d 819, 824 (Tex. 2010) (“If the lawyer works on a matter, there is an irrebuttable presumption that the

¹⁵ Further, there is evidence here that Mayer Brown did in fact learn information about the messaging app during its other representations of LGE. *See* Hong Second Decl., ¶ 5 (regarding Mayer Brown’s access to the code for “Messaging (LG Messaging App)” in *CCE*). This is the same source code that is accused of infringing the ’839 Patent. *Id.*

lawyer obtained confidential information during representation.”); ABA MODEL RULES PROF. CONDUCT R. 1.9, cmt. 3 (considering confidential information “as would **normally have been obtained** in the prior representation” (emphasis added)). Thus, the Court finds that the three Mayer Brown attorneys’ prior representation of LGE in *MTT* would be a conflict of interest.¹⁶ *See Hillman*, 439 F.Supp.3d at 859. Mayer Brown does not dispute LGE’s assertion that because Mayer Brown did not screen the attorneys involved in *MTT*, any conflict attached to them would be imputed to the entire firm. *See* Dkt. No. 15 at 15.

D. Analysis of the societal interests at stake

LGE’s motion to disqualify Mayer Brown is premised on a strict application of ethics rules, with a broad focus on Mayer Brown’s prior representations of LGE for over seven years. After applying LGE’s advance waiver of conflicts as contained in the *Jenam* Engagement Letter, the only conflict of interest that exists is based only on Mayer Brown’s prior representation of LGE in *MTT*. However, a finding that an ethics rule has been violated, without more, is not sufficient to support disqualification. *Woolley v. Sweeney*, No. 3:01CV1331-BF, 2003 WL 21488411, at *8 (N.D. Tex. May 13, 2003). The Court must also take into account the societal interests at stake. *FDIC v. U.S. Fire Ins. Co.*, 50 F.3d 1304, 1314 (5th Cir. 1995).

“The rule of disqualification is not mechanically applied in this Circuit.” *Id.* (quoting *Church of Scientology of California v. McLean*, 615 F.2d 691, 693 (5th Cir.1980)). All of the facts particular to a case must be considered in the context of the relevant ethical criteria and with meticulous deference to the litigant’s rights. *Id.*; *see also In re Dresser Indus., Inc.*, 972 F.2d 540,

¹⁶ Because Mayer Brown’s prior representation of LGE in *MTT* was “substantially related” to this proceeding, giving rise to an irrebuttable presumption that relevant confidential information was disclosed during the former period of representation, the Court does not reach LGE’s arguments regarding whether “the representation in reasonable probability will involve a violation of Rule 1.05 [concerning the unauthorized disclosure of confidential information].” TEX. DISC. RULES. PROF. CONDUCT R. 1.09(a)(2).

545 (5th Cir. 1992) (“Exceptional circumstances may sometimes mean that what is ordinarily a clear impropriety will not, always and inevitably, determine a conflicts case.”). Among the factors that the Fifth Circuit has considered are “whether a conflict has (1) the appearance of impropriety in general, or (2) a possibility that a specific impropriety will occur, and (3) the likelihood of public suspicion from the impropriety outweighs any social interests which will be served by the lawyer’s continued participation in the case.” *Id.* (quoting *Dresser*, 972 F.2d at 545).

Three Mayer Brown attorneys represented LGE in the *MTT* matter over eight years ago, collectively billing 143 hours total. This does not have the appearance of impropriety in general, especially considering 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*. Indeed, *MTT* was a minor part of LGE’s briefing and the parties’ correspondence, which focused on [REDACTED], *CCE*, and *Jenam*.

Further, there is little risk that any impropriety will occur. With the exception of information regarding the LGE Messaging App, LGE has failed to identify any other confidential information which might have been accessible in *MTT*. During the hearing, counsel for Pantech stated Mayer Brown does not have any prior code “whatsoever related to any of those matters.” Dkt. No. 67 (Transcript) at 75:24-76:1. According to counsel, LGE is no longer making and selling phones; therefore, any access Mayer Brown may have had to non-technical information regarding LGE’s licensing strategies, etc. is not going to be relevant now that LGE is no longer a market participant. *Id.* at 86:10-19. That argument is somewhat undercut by the fact that the damages period includes a time when LGE was a market participant, but it still highlights a significant change in the years since the *MTT* matter concluded.

Finally, the unique facts of this case, including that LGE and Mayer Brown properly negotiated the terms of a contractual consent to a waiver of future conflicts of interest for much more substantial matters, diminishes the possibility of public suspicion. LGE fully knew the extent of Mayer Brown's past representations and traded part of Mayer Brown's obligations to a former client for Mayer Brown's representation in the *Jenam* matter. Any remaining public suspicion or loyalty concerns from Mayer Brown's previous representation of LGE in a case which ended in March 2016 must be viewed in light of respecting the parties' freedom to contract. *See, e.g., Galderma Lab'ys, L.P. v. Actavis Mid Atl. L.L.C.*, 927 F. Supp. 2d 390, 392 (N.D. Tex. 2013) (recognizing the right for sophisticated clients to agree to advanced waiver of future conflicts in similar circumstances); *see also In re Shared Memory Graphics L.L.C.*, 659 F.3d 1336, 1341 (Fed. Cir. 2011) (stating that in attorney-client situations, general rules of professional legal conduct recognize that in certain circumstances it is not only proper but beneficial for parties to contractually consent to a waiver of future conflicts of interest) (citing Restatement (Third) of the Law Governing Lawyers, § 122 cmt. D (2000) ("[T]he gains to both lawyer and client from a system of advance consent to defined future conflicts might be substantial.")). Further, the right of Pantech to choose its counsel, and the right of Mayer Brown's attorneys to freely practice their profession, are countervailing and important societal rights. *U.S. Fire*, 50 F.3d at 1316. A more limited request—such as requiring Mayer Brown to obtain consent from LGE to continue representing Pantech's allegations concerning the '839 Patent would have had more merit, but the request was all or nothing. Based on the reasons above, a broad request for disqualification based on the most remote prior representation dealing with only one of the seven patents at issue is denied.

E. LGE's confidential information

Finally, the Court notes that a waiver of a party's right to seek disqualification based on conflicts of interest is not necessarily a waiver of that party's expectation that its attorney-client confidential information will not be used against it by a former attorney.¹⁷ At the hearing, LGE's counsel persuasively argued that LGE did not consent – through either waiver in the *Jenam* Engagement Contract – to Mayer Brown's use of LGE's confidential information in any future matter. Dkt. No. 67 (Transcript) at 53:9-17; *see also id.* at 89:19-90:5; 92:10-16; 96:22-97:2; 97:24-98:4. There is nothing in the specific waiver or standard advance waiver where LGE agreed to Mayer Brown's use or disclosure of LGE confidential information outside the confines of the *Jenam* matter.

Other than a hypothetical risk of misuse (which LGE considered and bargained away when agreeing to the specific waiver), there is nothing before the Court to indicate misuse of confidential information by Mayer Brown.¹⁸ In the briefing, Pantech stated Mayer Brown does not possess relevant confidential information, Dkt. No. 45 at 18, and at the hearing, Mayer Brown confirmed it no longer possesses any LGE source code. Dkt. No. 67 (Transcript) at 75:24-76:1.

Therefore, while not a basis for disqualification on the record before the Court, the Court provides, out of an abundance of caution, the following clarification to the parties in allowing Mayer Brown to continue to represent Pantech in this case. Given LGE's lack of consent, Mayer Brown's use or disclosure of LGE confidential information is limited as prescribed by the ethical

¹⁷ ABA Formal Op. 05-436 reiterates that consent to waive a future conflict of interest does not have the effect of authorizing the lawyer to reveal or use confidential client information. ABA Formal Op. 05-436 (2005), n. 6.

¹⁸ As noted in footnote 7, the issue before the Court is whether LGE has consented – through the specific waiver – to Mayer Brown's representation of Pantech in this matter, waiving its right to object to that representation based on any conflict of interest that might arise based on certain Mayer Brown's prior representations of LGE. The issue is not whether LGE has consented – through the specific waiver or otherwise – to Mayer Brown's use of previously disclosed information or attorney-client conversations.

rules. Texas Rule 1.05 provides that “[c]onfidential” information includes both “privileged information” and “unprivileged client information.” TEX. DISC. RULES. PROF. CONDUCT R. 1.05(a). This includes not just source code and other information previously obtained from LGE, but also likely includes work product from prior LGE representations that incorporate such confidential information (e.g., certain pleadings, expert reports, memos, LGE licensing strategies gleaned from settlement or licensing negotiations, knowledge of LGE witnesses to depose, if not disclosed in this litigation, etc.) While this may not be an obstacle for most of the case, it may be challenging in discovery disputes or settlement negotiations. The Court leaves it to Mayer Brown to decide whether the wiser course would be to allow co-counsel to handle any such issues.

VI. CONCLUSION

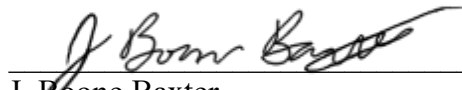
This motion heavily focused on the *CCE* and [REDACTED] representations, where Mayer Brown’s involvement was the most substantial. Speaking by way of example at an admittedly high level of generality, the fact that Mayer Brown previously analyzed whether a third party’s patents were essential to a public 3GPP cellular standards, and then perhaps relied on LGE information to confirm what was previously known (that LGE cellular products are compliant with those standards), is not the kind of concern under the ethical rules that would require the removal of Pantech’s right to the counsel of its choice. In exchange for Mayer Brown’s representation of LGE in *Jenam*, LGE consented to Mayer Brown’s representation of other clients in certain future matters adverse to LGE. Through that specific waiver, LGE has waived the bulk of its concerns which could have justified disqualification under the relevant ethical rules absent an advance conflicts waiver (the duty of loyalty and appearance of impropriety of being adverse to a former client, including the optics concerning the possibility of misuse of LGE’s confidential information). Having considered the relevant briefing and hearing arguments of counsel February

1, 2023, and based upon this Court's analysis of the Texas Rules of Professional Conduct, the local rules of this Court, the ABA's Model Rules of Professional Conduct, and the societal interests at stake, including waiver issues, the Court concludes that LGE has not carried its burden in this case of showing that disqualification is necessary here.

Accordingly, it is

ORDERED Defendants' Motion to Disqualify Mayer Brown LLP (Dkt. No. 15) is
DENIED.

SIGNED this the 27th day of April, 2023.



J. Boone Baxter
UNITED STATES MAGISTRATE JUDGE