

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner,

v.

PANTECH WIRELESS, LLC,
Patent Owner.

IPR2023-01267 (Patent 9,313,809 B2)
IPR2023-01268 (Patent 9,575,631 B2)
IPR2023-01269 (Patent 9,854,545 B2)
IPR2023-01270 (Patent 10,869,247 B2)
IPR2023-01272 (Patent 9,065,486 B2)
IPR2023-01273 (Patent 9,136,924 B2)

**PETITIONER'S REPLY IN SUPPORT OF ITS
MOTION TO DISQUALIFY MAYER BROWN LLP**

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Because Mayer Brown represented LGE in “substantially related matter[s]” to its current representation of Pantech who is “materially adverse” to LGE, Mayer Brown must be disqualified. 37 C.F.R. § 11.109(a). Pantech’s Response fails to dispute the significant evidence of technical overlap identified by LGE on a patent-by-patent basis, mischaracterizes the district court’s decision, and focuses on a waiver provision that does not apply. Mayer Brown should be disqualified.

I. THE DISTRICT COURT FOUND AN “OBVIOUS” CONFLICT

While Pantech argues that the Board should “defer to the reasoned judgment of the district court,” Pap. 12 (“Resp.”) 7, it fails to acknowledge that the district court stated that “the facts highlighted by LGE here suggest that Mayer Brown’s actions would amount to obvious conflicts of interest.” Ex. 1209 at 1. The only reason that Mayer Brown was not fully disqualified at the district court was because of the *Jenam* waiver provision, which was incorrectly applied and is currently on appeal. Ex. 1214. As is well-established, it is Pantech’s burden (not LGE’s) to show that the waiver provision applies against Mayer Brown’s former client and here again it has failed to even attempt to make this showing. Pap. 8 (“Mot.”) 7.

Moreover, Pantech is wrong that “no new arguments or facts have been raised that were not previously considered by the District Court.” Resp. 8. Due to the patent-specific validity issues in these IPR proceedings, LGE’s Motion presented significant new evidence of the overlap with the claims of the patents in each prior

matter. Mot. 11-19. For example, for each patent-at-issue, LGE explained the overlap in claim language between Pantech's patents and the claims of the patents for which Mayer Brown defended LGE in the prior matters. *Id.* LGE also identified how the patents overlap with respect to allegedly reading onto the same discrete sections of the technical standards in both the current and prior matters. *Id.* at 12,13. Pantech fails to dispute this evidence. Because the district court decision establishes the conflict and because Pantech does not attempt to carry its burden to show waiver, Pantech's argument for deferral to the district court should be rejected.

II. MAYER BROWN'S CONFLICT IS NOT SHIELDED IN AN IPR

Mayer Brown's argument that the IPR posture of this proceeding protects its failure to abide by its ethical obligations (Resp. 8-11) would render meaningless the PTO rule barring such participation. *See* 37 C.F.R. § 11.109(a).

Pantech's first argument—that some district courts have allowed limited IPR participation by trial counsel subject to a prosecution bar—is inapposite. Resp. 9. None of the cases that Pantech cites involve counsel that previously represented the adverse party, as prohibited by the PTO rule. Rather, Pantech relies on cases in which litigation counsel for a party (subject to a prosecution bar) sought to represent *that same party* in IPR proceedings. *Id.* at 9 n.6 (citing *Lifetime Prod.*; *X One*; *Brit. Telecomms.*). These cases are irrelevant to the dispute here at least because they did not involve seeking leave to be adverse to a prior client, and the PTO rule does not

apply to such situations. Moreover, in *X One* and *Brit. Telecomms.*, the parties *agreed* to litigation counsel’s limited involvement in IPRs.

Pantech’s second argument—that Mayer Brown’s undisputed access to LGE’s confidential information “does not outweigh Pantech’s desire to use its trial counsel”—is similarly futile. Resp. 10. Not only has Pantech made no showing that it would have difficulty finding alternative counsel, but it has already found separate counsel in related IPR2023-01271 after the district court found a conflict. Indeed, contrary to Pantech’s position here (Resp. 5 n.3), in that matter Pantech informed the Board that “due to a recent district court order Pantech needs to find replacement counsel.” Ex. 1265. Further, Pantech’s statement that confidential information does not affect validity (*id.* at 10) ignores that the Supreme Court and Federal Circuit have explained that claims cannot be twisted one way for purposes of infringement and another for validity. Mot. 10 (citing *White*; *Amazon.com*). Pantech’s cases do not dispute this—*Nidec* simply says that not all terms may need to be construed and *NuCurrent* involved the ability of a forum selection clause in an NDA to enjoin IPR proceedings, not interconnectedness of infringement and validity. Resp. 10; *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013 (Fed. Cir. 2017); *NuCurrent Inc. v. Samsung Elecs. Co.*, No. 19-cv-798, 2019 WL 2776950 (S.D.N.Y. July 2, 2019). And Pantech’s reference to the change in PTAB claim construction standard (Resp. 10 n.7) further highlights the link between PTAB and

district court proceedings: “[w]ith the PTAB and district courts applying the same claim construction standard, there will be a stronger basis for judges in one forum to rely on claim constructions rulings from the other.” 83 Fed. Reg. 51340 at 51351.

III. LGE’S EVIDENCE SHOWS THE SUBSTANTIAL OVERLAP BETWEEN THESE IPRS AND THE PRIOR REPRESENTATIONS

As the district court observed, Mayer Brown has an “obvious conflict” based on its prior representations. Ex. 1209 at 1. Pantech’s Response does not dispute the evidence provided by LGE, but instead simply argues (without basis) that LGE’s explanation was not enough. Resp. 17-20. But as *Sunbeam*, *Talon*, *W.L. Gore*, *Micrografx*, and *Dynamic 3D* readily demonstrate, courts have found a substantial relationship for much less. See Mot. 8-9. Pantech did not address any of these cases and instead cites only distinguishable caselaw. Pantech first (Resp. 6-7) relies on an incomplete statement from *Anderson v. Eppstein* that in full states that “[o]n some occasions, the term ‘substantially related’ has been narrowly interpreted to mean identical or essentially the same.” 59 U.S.P.Q.2d 1280 (B.P.A.I. 2001) (citing NY law). Pantech has not shown that this is such an occasion, nor that the Federal Circuit adopted such a standard. Instead, the Federal Circuit has repeatedly found a substantial relationship where there is a risk that confidences disclosed in prior representations “could be used against the [former] client in [a] later, adverse representation.” *W.L. Gore & Assocs., Inc. v. Int’l Med. Prosthetics Rsch. Assocs.*,

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745 F.2d 1463, 1466-1467 (Fed. Cir. 1984); *see also Dynamic 3D Geosolutions LLC v. Schlumberger Ltd.*, 837 F.3d 1280, 1285-1286 (Fed. Cir. 2016) (interpreting ABA Model R. 1.9, which is identical to 37 C.F.R. § 11.109(a)); Mot. 8-9. And Pantech's reliance on *Microsoft* is distinguishable because that case involved significantly weaker factual evidence—just that both cases involved WLAN technology—and not the detailed technical analysis provided in LGE's Opening Motion. No. 6:06-cv-549, 2007 WL 4376104, at *8 (E.D. Tex. Dec. 13, 2007); Mot. 11-19.

Mayer Brown had access to highly confidential information concerning LGE's alleged infringement of the same subject matter by the same accused products in past proceedings that is at issue for each of the patents challenged here. Pantech does not even dispute that each of these IPRs involve claim limitations that directly overlap with limitations at issue in prior proceedings. And for the allegedly standard essential patents, Mayer Brown defended LGE and had access to highly confidential information concerning LGE's alleged practice of the same alleged standard essential technical specifications that form the basis for Pantech's infringement allegations. *See* Mot. 12, 18, 19. That access informs Mayer Brown as to the likely positions that it will want to take regarding the scope of the challenged claims in each of these proceedings. As the Supreme Court and the Federal Circuit have repeatedly observed, those issues of claim interpretation between infringement and validity are interwoven. *See* Mot. 10 (citing *White*; *Amazon.com*).

IV. LGE HAS NOT WAIVED MAYER BROWN'S CONFLICT

Pantech does not and cannot carry its burden to show that the *Jenam* provision waives any conflict of interest. The waiver provision, signed in September 2019, applies to Mayer Brown's "representation of other clients adverse to [LGE], in future matters *substantially unrelated* to the technology involved in (1) the [*Jenam*] matter and (2) other matters where [Mayer Brown] represented LGE in the *past five (5) years*." Ex. 1215 (emphasis added).¹ All four prior representations occurred in the five years prior to the waiver provision, and Pantech has not shown that technology involved in the prior matters is substantially unrelated to these IPRs—indeed, it does not dispute the overlap in claimed subject matter (*see* Mot. 11-19).²

Pantech's misleading statement that "*Jenam* is the only relevant matter [REDACTED]" (Resp. 15-16) rehashes an argument that Pantech made, lost, and then abandoned at the district court (namely, that the five-year period was a moving target rather than a set date). Contrary to Pantech's statement that "the District Court did not adopt either parties' interpretation of the 'past five (5) years'" (Resp. 16 n.9), the Magistrate held in favor

¹ Pantech's briefing misleadingly suggests that it identified its representation of Pantech during the *Jenam* discussions (Resp. 13), but Mayer Brown made only an oblique reference to a "Korean company"—never identifying Pantech. Ex. 2001 ¶ 9.

² As the Magistrate credited, this five-year period corresponded to the five years prior to when Mayer Brown attorney Jamie Beaber joined the firm (Ex. 1213 at 23)—contrary to Pantech's newfound explanation (Resp. 13).

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of LGE, finding that “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 ... Pantech’s interpretation replaces the meaning of ‘past’ with ‘prior.’” Ex. 1213 at 30. Pantech subsequently abandoned this argument. Ex. 1209 at 4. Appropriately measured from Sept. 2019, each of [REDACTED], *CCE* (6/2013–8/2016), *Core Wireless* (9/2014–11/2020), and *MTT* (11/2013–1/2020) were ongoing in the five years prior to the execution of the *Jenam* provision. Ex. 1213 at 4-5.

Finally, Pantech does not show that the technology involved in any of the prior representations is substantially unrelated to the current matters. Pantech focuses exclusively on *Jenam* (Resp. 15-17), which is irrelevant given that this is not one of the matters that LGE argues overlaps with the *Pantech* IPRs. For the four prior representations, Pantech does not even attempt to argue that the matters are substantially unrelated.³ *Id.* at 11-17. As LGE’s Motion explained, it is Pantech’s burden to show waiver by informed consent to future adverse representation. Mot. 19-20. Because Pantech has not shown that LGE waived Mayer Brown’s adverse representations in [REDACTED] *CCE*, *Core Wireless*, and *MTT*, no waiver applies.

Mayer Brown should be disqualified from representing Pantech in these IPRs.

³ Though not its burden, LGE pointed to significant evidence that technology involved in the prior matters is substantially related to the technology at issue here. Mot. 8-19. This is a higher standard than required by the *Jenam* provision, which applies only to matters that were *substantially unrelated*. Ex. 1215.


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Respectfully submitted,

Dated: December 13, 2023

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing PETITIONER'S
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LLP was served via electronic mail to the following attorneys of record for the Patent
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