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**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TEXARKANA DIVISION**

PANTECH CORPORATION and PANTECH
WIRELESS, LLC,

Plaintiffs,

v.

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

Defendants.

Case No. 5:22-cv-00113-RWS

JURY TRIAL DEMANDED

**PLAINTIFFS' OPPOSITION TO DEFENDANTS' MOTION TO
DISQUALIFY MAYER BROWN LLP**

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TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. LEGAL STANDARDS	2
III. ARGUMENT	3
1. Under the Applicable Rules, a Sophisticated Client, Represented by Counsel, Can Give Informed Consent to a Comprehensive Waiver	5
2. LGE Gave Informed Written Consent Waiving the Alleged Conflict	6
3. The Jenam Matter is Completely Unrelated and No Other Matter Is Relevant to the Inquiry.....	9
IV. CONCLUSION.....	20

FILED UNDER SEAL – MAY CONTAIN CONFIDENTIAL INFORMATION

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Abney v. Wal-Mart</i> , 984 F. Supp. 526 (E.D. Tex. 1997).....	3, 10, 14, 19
<i>Advanced Training Grp. Worldwide, Inc. v. Proactive Techs. Inc.</i> , 436 F. Supp. 3d 870 (E.D. Va. 2020)	14
<i>In re Am. Airlines, Inc.</i> , 972 F.2d 605 (5th Cir. 1992)	3, 16, 17
<i>Atasi Corp. v. Seagate Tech.</i> , 847 F.2d 826 (Fed. Cir. 1988).....	10
<i>Biax Corp. v. Fujitsu Computer Sys. Corp.</i> , 2007 WL 1466639, No. 2:06-CV-364	17, 18
<i>Biote Med., LLC v. Jacobsen</i> , No. 4:18-CV866, 2020 WL 2813201 (E.D. Tex. May 29, 2020).....	3
<i>BMO Harris Bank N.A. v. Novak Druce Connolly Bove & Quigg LLP</i> , No. CV H-17-1616, 2018 WL 7253967 (S.D. Tex. Feb. 22, 2018)	3
<i>Cox v. Am. Cast Iron Pipe Co.</i> , 847 F.2d 725 (11th Cir. 1988)	10
<i>Dieter v. Regents of Univ. of California</i> , 963 F.Supp. 908 (E.D.Cal.1997).....	15
<i>Erfindergemeinschaft Uropep GbR v. Eli Lilly & Co.</i> , No. 2:15-CV-1202-WCB, 2016 WL 760909 (E.D. Tex. Feb. 26, 2016)	8
<i>Galderma Labs., L.P. v. Actavis Mid-Atl. LLC</i> , 927 F. Supp. 2d 390 (N.D. Tex. 2013)	3, 5
<i>Gen. Elec. Co. v. Mitsubishi Heavy Indus., Ltd.</i> , No. 3:10-CV-276-F, 2011 WL 13201855 (N.D. Tex. Sept. 12, 2011).....	2
<i>Islander East Rental Program v. Ferguson</i> , 917 F.Supp. 504 (S.D. Tex. 1996)	18
<i>Jackson v. J.C. Penney Co.</i> , 521 F. Supp. 1032 (N.D. Ga. 1981).....	10

FILED UNDER SEAL – MAY CONTAIN CONFIDENTIAL INFORMATION

<i>Metropolitan Life Ins. Co. v. Syntek Fin. Corp.</i> , 881 S.W.2d 319 (Tex.1994).....	19
<i>Microsoft Corp. v. Commonwealth Sci. & Indus. Rsch. Organisation</i> , No. 6:06 CV 549, 2007 WL 4376104 (E.D. Tex. Dec. 13, 2007), <i>aff'd sub</i> <i>nom. Commonwealth Sci. & Indus. Rsch. Organisation v. Toshiba Am. Info.</i> <i>Sys., Inc.</i> , 297 F. App'x 970 (Fed. Cir. 2008).....	17, 18, 20
<i>Network Apps, LLC v. AT&T Mobility LLC</i> , 2022 WL 1119331 (S.D. N.Y. 2022).....	17
<i>Pendergest-Holt v. Certain Underwriters at Lloyd's of London</i> , No. CV H-09-3712, 2010 WL 11661414 (S.D. Tex. July 30, 2010).....	10
<i>Power Mosfet Techs, L.L.C. v. Siemens AG</i> , 2002 WL 32785219, No. 2:99-CV-168 (E.D.Tex.2002).....	15
<i>Simmons v. Houston Cty., Texas</i> , No. 9:05-CV-82, 2006 WL 8440543 (E.D. Tex. Feb. 2, 2006).....	3, 14, 18
<i>Soverain Software LLC v. CDW Corp.</i> , No. 6:07 CV 511, 2010 WL 1038731 (E.D. Tex. Mar. 18, 2010).....	2, 3
<i>Thomas C. v. State Farm Fire & Cas. Co.</i> , 2007 WL 2702700, *at 2 (S.D. Miss. 2007).....	15
<i>In re TMD Def. & Space, LLC</i> , 649 S.W.3d 764 (Tex. App. 2022).....	19
<i>Zichichi v. Jefferson Ambulatory Surgery Ctr., LLC</i> , No. CIV. A. 07-2774, 2008 WL 2859232 (E.D. La. July 22, 2008)	14
Other Authorities	
ABA Model Rules of Prof. Conduct.....	<i>passim</i>

FILED UNDER SEAL – MAY CONTAIN CONFIDENTIAL INFORMATION

I. INTRODUCTION

Disqualification of counsel is a drastic measure with a high bar. It is not to be used as a weapon for tactical advantage gained by depriving a party of its chosen counsel. And it is not to be used to disparage attorneys that long ago ceased representing the party seeking disqualification. LGE's motion offends both maxims.

Even looking past the clear waivers, LGE has failed to demonstrate that any prior representation is substantially related to the present case or that Mayer Brown possesses relevant confidential information. LGE attempts to paint a picture of trusted “go-to” counsel turning against it in violation of ethical and legal standards. But the facts show differently. *First*, if LGE truly believed that a conflict existed, it should have raised the issue immediately upon learning of the case. Instead, LGE sought delay, not once mentioning a conflict during several discussions and emails with Mayer Brown attorneys, only to move to disqualify Mayer Brown months after the case was filed and almost two years since its admitted awareness of the alleged conflict.

Second, the Mayer Brown attorneys LGE seeks to disqualify have not substantively represented LGE in any patent matter for more than five years. Indeed, LGE admits that it ended the relationship in 2017. And the only case since then, the *Jenam* litigation, involved LGE by name only—the technology at issue was [REDACTED] (and not remotely related to the technology at issue in this case), [REDACTED].

Third, the *Jenam* representation was undertaken by Mayer Brown conditioned on a conflicts waiver it received from LGE. Through this waiver, LGE clearly consented to Mayer Brown's representation of clients adverse to LGE where the *technology* is substantially unrelated to the *technology* at issue in the *Jenam* case and in any other matter where the firm represented LGE in the *past five years* (*i.e.*, relatedness is not considered for matters more than five years old). Because *Jenam* is the only relevant matter within the past five years where Mayer Brown

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represented LGE, and the technology in the *Jenam* case is substantially unrelated [REDACTED] technology, any potential conflict with the present litigation was waived.

Finally, even assuming no waiver exists, the Mayer Brown attorneys have never handled a substantially related matter. While some of the same products may be at issue, that alone does not establish a substantial relationship. And aside from such generalities, LGE fails to identify specific factual similarities between any prior representation and the present case, which the law requires for LGE to meet its heavy burden. Likewise, LGE has not shown that the Mayer Brown attorneys possess relevant LGE confidential information that would require disqualification. LGE has had many months (years, in fact) to comb through its communications, billing records, and documents from previous matters to find that requisite link. But LGE has failed to do so.

Because LGE has waived its right to seek disqualification, both contractually and through its actions, and because LGE has failed to establish a substantial relationship or that Mayer Brown possesses relevant LGE confidential information, LGE's motion to disqualify should be denied.

II. LEGAL STANDARDS

“Depriving a party of the right to be represented by the attorney of his or her choice is a penalty that must not be imposed without careful consideration.” *U.S. Fire Ins.*, 50 F.3d at 1313. “[I]nflexible application of a professional rule is inappropriate because frequently it would abrogate important societal rights, such as the right of a party to his counsel of choice and an attorney's right to freely practice her profession.” *Id.* Consideration of the potential prejudice to the parties resulting from disqualification therefore is of “paramount importance.” *Gen. Elec. Co. v. Mitsubishi Heavy Indus., Ltd.*, No. 3:10-CV-276-F, 2011 WL 13201855, at *9 (N.D. Tex. Sept. 12, 2011).

The moving party bears the burden of proving that disqualification is warranted. *Sovereign Software LLC v. CDW Corp.*, No. 6:07 CV 511, 2010 WL 1038731, at *1 (E.D. Tex. Mar. 18,

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2010). The motion cannot be based on speculation. *BMO Harris Bank N.A. v. Novak Druce Connolly Bove & Quigg LLP*, No. CV H-17-1616, 2018 WL 7253967, at *2 (S.D. Tex. Feb. 22, 2018). It must contain admissible evidence proving the factual bases for disqualification. *Simmons v. Houston Cty., Texas*, No. 9:05-CV-82, 2006 WL 8440543, at *3–4 (E.D. Tex. Feb. 2, 2006) (rejecting disqualification where plaintiff “offer[ed] no evidence” and did “not submit documentation, pleadings or evidence”). “A severe remedy such as disqualification cannot be granted on generalities.” *Soverain Software*, 2010 WL 1038731, at *1.

Disqualification motions have the potential to be used as “procedural weapons” in litigation, intended “to advance purely tactical purposes,” including delay or harassment. *In re Am. Airlines, Inc.*, 972 F.2d 605, 611 (5th Cir. 1992). For this reason, courts apply an “exacting standard” to “discourage the use of such motions as a dilatory trial tactic” and “to protect a party’s right to counsel of choice.” *Biote Med., LLC v. Jacobsen*, No. 4:18-CV866, 2020 WL 2813201, at *2 (E.D. Tex. May 29, 2020); *see also Abney v. Wal-Mart*, 984 F. Supp. 526, 528 (E.D. Tex. 1997) (same); *Galderma Labs., L.P. v. Actavis Mid-Atl. LLC*, 927 F. Supp. 2d 390, 394 (N.D. Tex. 2013) (cautioning that “[d]isqualification motions may be used as ‘procedural weapons’ to advance purely tactical purposes”) (quoting *In re Am. Airlines, Inc.*, 972 F.2d 605, 611 (5th Cir. 1992)). Disqualification of an attorney is thus, without question, a sanction the Court must not impose cavalierly. *U.S. Fire Ins.*, 50 F.3d at 1315.

III. ARGUMENT

A. The Conflict Waiver is Valid and Applies to This Litigation

Even if Mayer Brown would have been precluded from representing Pantech absent a conflict waiver (which is not the case here, *see* Section III.C below), the valid conflict waiver in the *Jenam* engagement agreement (“Engagement Agreement”) negates any conflict of interest and

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independently allows Mayer Brown to proceed. The relevant language from the Engagement Agreement provides:

[REDACTED]

Mot. Ex. 24 at 3. The International Terms-appended to the Engagement Agreement and expressly made a part thereof further provide:

[REDACTED]

Mot. Ex. 25 at A.9.5.

First, LGE, represented by sophisticated in-house counsel, contractually agreed to waive the conflict that it now asserts in this lawsuit. LGE ignores the plain language of the waiver and the context in which that Engagement Agreement was signed. LGE has never claimed that its IP General Counsel, Chang Kim—who extensively reviewed and negotiated the terms of the Engagement Agreement—did not read or fully understand the explicit waiver. Second, because

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the technology and issues involved in the *Jenam* matter bear no relationship to the facts and technology at issue here, the waiver confirms Mayer Brown’s permissible representation of Pantech.

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

The Mayer Brown Engagement Agreement fully complied with Texas Rule 1.09 and ABA Rule 1.9’s “informed written consent” requirements, and constituted a waiver of any conflict regarding Mayer Brown’s representation of Pantech in the current litigation. Whether a client’s consent to a conflict waiver is informed necessarily focuses on the client’s understanding of the scope of the waiver and the nature of the conflicts that it covers. The American Bar Association, other leading bar associations, the Restatement, and many courts agree that sophisticated clients represented by counsel need far less specific disclosures to render their consent to waive conflicts sufficiently informed.¹ This sensible standard recognizes that increasingly savvy and powerful corporate clients often conclude it is in their best interest to broadly waive both current and future conflicts in order to hire the counsel of their choice.

Model Rule 1.9 allows a lawyer to represent a client notwithstanding a conflict with a former client if “the former client gives informed consent, confirmed in writing.” (ABA Model Rules of Prof. Conduct, rule 1.9(b)(2).) The comments to the Model Rules instruct that “[t]he effectiveness of such waivers is generally determined by the extent to which the client reasonably

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

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understands the material risks that the waiver entails.” *Id.* com. 9; rule 1.7, com. 22. “[I]f the client agrees to consent to a particular type of conflict with which the client is already familiar, then the consent ordinarily will be effective with regard to that type of conflict.” *Id.* And “if [a] client is an experienced user of the legal services involved and is reasonably informed regarding the risk that a conflict may arise,” its consent to an advance waiver “is more likely to be effective, particularly if, e.g., the client is independently represented by other counsel in giving consent and the consent is limited to future conflicts unrelated to the subject of the representation.” *Id.*

2. LGE Gave Informed Written Consent Waiving the Alleged Conflict

The asserted conflict in this case arose more than five years after LGE decided to end its relationship with Mayer Brown with the knowledge and understanding that Mayer Brown was representing clients with potentially adverse claims against LGE. In fact, before entering into the Engagement Agreement, Mr. Beaber informed LGE’s IP General Counsel, Mr. Kim, that Mayer Brown was representing Maxell Ltd. along with another Korean Company [Pantech]. Declaration of Jamie B. Beaber (“Beaber Decl.”) at ¶9. He explained at that time that neither of these representations presented a current conflict of interest, but that the Mayer Brown clients could potentially, in the future, be adverse to LGE. *Id.* This direct communication was more than enough to establish the reasonably foreseeable types of future representations (*i.e.*, adverse patent infringement litigation involving LGE’s smartphones) that could arise and the attendant risks, and thus that there was informed consent. And while the Engagement Agreement does not specifically identify the potential adverse parties in writing, that much was not required. *See* Ex. 2, ABA Opn. No. 05-436.

In addition, LGE’s own standard engagement agreement, examples of which are included in LGE’s Motion at Exhibits 19-21, evidence LGE’s sophistication and understanding of conflicts

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of interest. For example, the engagement agreement concerning Mayer Brown’s retention for [REDACTED]

[REDACTED] provides:

[REDACTED]

Mot. Ex. 19 at 2 (emphases added). This example demonstrates LGE’s keen awareness of potential conflicts, how to handle such conflicts, and its capacity to waive such conflicts if or when they do arise. *See also* Ex. 20 at 2 (similar language), Ex. 21 at 2 (same). LGE’s familiarity with this type of conflict emphasizes that the consent was informed and the waiver effective. *See* ABA Model Rules of Professional Conduct, Rule 1.9 cmt. 22 (Am. Bar Ass’n 2019) (“if the client agrees to consent to a particular *type of conflict* with which the *client is already familiar*, then the consent ordinarily will be effective with regard to that type of conflict.”) (emphases added).

LGE’s negotiated modifications to the conflict waiver provision of the Engagement Agreement provide additional support and clarity regarding the consent and scope of the waiver to which LGE agreed. Specifically, the original draft Engagement Agreement did not address conflicts concerning matters other than those “[REDACTED]” Mot. Ex. 22 at 3. Recognizing the breadth of this waiver, LGE first sought to have the waiver removed. *See* Mot. Ex. 23 (July 24, 2019 email from Kim to Beaber) [REDACTED]

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[REDACTED] LGE understood the risk associated with such a waiver, as it first attempted to remove the waiver entirely. Following a discussion with Mr. Beaver, and multiple email exchanges, LGE ultimately conceded and agreed to a waiver based on a slight narrowing of the scope. In addition to waiving conflicts concerning all matters “[REDACTED]

[REDACTED] LGE sought to include “[REDACTED]
[REDACTED]” *Id.* (July 26, 2019 email from Kim to Beaber).

LGE’s inclusion of a time component differentiated the waiver from the Model Rules (as otherwise the two would be coextensive in scope), but also comports with the logical conclusion that, with the passage of time, any information acquired by Mayer Brown attorneys, confidential or otherwise, would become outdated and not substantiate a conflict. *See* ABA Model Rules of Professional Conduct, Rule 1.9 cmt. 3 (Am. Bar Ass’n 2019) (“Information acquired in a prior representation may have been rendered obsolete by the passage of time.”); *see also* *Erfindergemeinschaft Uropep GbR v. Eli Lilly & Co.*, No. 2:15-CV-1202-WCB, 2016 WL 760909, at *7 (E.D. Tex. Feb. 26, 2016) (holding the disclosure of outdated revenue information from one year before the conflict would not be sufficient to require disqualification.). And ultimately, LGE agreed that five years was sufficiently remote in time to remove its concerns for any matter. *See* Mot. Ex. 24 at 3. Thus, the ultimate scope of the conflict waiver was not only agreed to by LGE, but is the result of LGE’s own proposals and negotiations.

LGE undeniably is a sophisticated and experienced user of legal services, and was represented by experienced in-house counsel during negotiations with Mayer Brown regarding the Engagement Agreement. LGE has employed some of the world's leading law firms to handle its patent litigation disputes. It knew and appreciated the risk associated with agreeing to the conflicts

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waiver and was willing to agree to Mayer Brown’s adverse representation in order to obtain the services of Mayer Brown.

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

The technology at issue in this case is “[REDACTED],” and *Jenam* is the only relevant matter “[REDACTED].” Mot. Ex. 24 at 3. And because the current litigation is “[REDACTED],” the *Jenam* matter (*i.e.*, the only matter for which Mayer Brown was providing services to LGE at the time of the engagement), the waiver in Mayer Brown’s International Terms likewise covers the asserted conflict. *See* Ex. 25 at A.9.5. Aside from simply claiming that the *Jenam* matter is substantially related, LGE does not present any evidence or argument regarding any relationship between the *Jenam* matter and the present litigation. There is none. Indeed, as LGE is well aware, the accused functionalities in the *Jenam* matter were those of a third party, [REDACTED], not those of LGE. *See, e.g.*, *Jenam* Complaint at ¶ 7 (defining “Accused Devices” as smartphones and tablets running [REDACTED]). This is underscored by the fact that LGE moved to transfer the *Jenam* matter to the Northern District of California based on the fact that it was [REDACTED], not LGE’s, technology that was at issue in the case. *See, e.g.*, Ex. 3 at ¶¶ 11-15 (Dec. of JuSeong Ryu, Senior Manager of LGE, [REDACTED]).

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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B. Even if the Court Finds no Waiver Under the Engagement Agreement, LGE has Waived the Conflict Through Its Dilatory and Affirmative Conduct

Notwithstanding LGE’s affirmative waiver in the Engagement Agreement, LGE’s delay in bringing this motion or other affirmative action, coupled with LGE’s self-initiated direct negotiations and communications with Mayer Brown after this case was filed, confirm that the motion was brought for tactical reasons and establish that LGE has waived any objection to Mayer Brown’s representation of Pantech.

“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.” *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) (quoting *Tr. Corp. of Mont. v. Piper Aircraft Corp.*, 701 F.2d 85, 87-88 (9th Cir. 1983)). “Waiver of a motion for disqualification of counsel is proper where the delay in moving for a disqualification is for an extended period of time, or where it is done on the eve of trial.” *Abney v. Wal-Mart*, 984 F. Supp. 526, 530 (E.D. Tex. 1997) (citing *Trust Corp. of Montana v. Piper Aircraft Corp.*, 701 F.2d 85, 87–88 (9th Cir.1983)); *see also Cox v. Am. Cast Iron Pipe Co.*, 847 F.2d 725, 729–30 (11th Cir. 1988) (stating that “a litigant may not delay filing a motion to disqualify in order to use the motion later as a tool to deprive his opponent of counsel of his choice after substantial preparation of the case has been completed”). “A motion to disqualify should be made with reasonable promptness after a party discovers the facts which lead to the motion.” *Cox*, 847 F.2d at 729 (quoting *Jackson v. J.C. Penney Co.*, 521 F. Supp. 1032, 1034-35 (N.D. Ga. 1981)); *Pendergest-Holt*, 2010 WL 11661414, at *5-6. Finally, a motion that is tactical in nature, given the circumstances, is grounds for waiver. *See Atasi Corp. v. Seagate Tech.*, 847 F.2d 826, 832

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(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”)

1. LGE’s Conduct Led Mayer Brown to Believe that LGE Respected the Waiver It Consented to and Did Not Object to Mayer Brown’s Representation of Pantech

LGE admits that “[it] learned of Mayer Brown’s representation of Pantech after Pantech copied Mayer Brown on correspondence in November [sic] and Mayer Brown contacted LGE on behalf of Pantech in December 2020.” Mot. at 6. LGE even raised the alleged conflict at that time, making the initial representation that “[REDACTED]” Mot. Ex. [REDACTED]” Mot. Ex. 26 (Sehyun Kim’s April 7, 2021 email to Mayer Brown). But after Mayer Brown pointed out the specific waiver in the Engagement Agreement, LGE did not continue to press the issue. Instead, in direct contradiction to its initial representation, LGE continued to engage in negotiations with Pantech for over a year, with the full knowledge that Mayer Brown was continuing to represent Pantech on such matters that were being negotiated. Declaration of James A. Fussell (“Fussell Decl.”) at ¶6. LGE’s silence regarding the alleged conflict and its continued engagement in negotiations with Pantech led Mayer Brown to believe that the issue had been resolved. Beaber Decl. at ¶19. Then, represented by Mayer Brown, Pantech filed this litigation on September 2, 2022. *Id.* ¶20; Fussell Decl. at ¶7. LGE, therefore, learned of the alleged conflict at least twenty-two months before the case was filed.

After the filing of the case, LGE, through Mr. Hongsun Yoon, contacted Mr. Beaber on or about September 27, 2022. Beaber Decl. at ¶21. Mr. Yoon is Direct and Senior IP Counsel at LG Electronics U.S.A., Inc. and is intimately familiar with Mayer Brown’s prior representations of LGE. *Id.* Mr. Yoon indicated that he was calling on behalf of both LGE defendants regarding the Pantech litigation. *Id.* at ¶22. During this initial call with Mr. Beaber, Mr. Yoon requested a one

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hundred and twenty (120) day-extension of time to file responsive pleadings in exchange for waiving service as to the foreign entity (LGE Korea). *Id.* He indicated that he was aware that the parties had been in licensing discussions for some time and that LGE would be interested in using this time to see if the parties could reach a resolution. *Id.* Mr. Beaber indicated that the parties had been in negotiations for well over a year without an offer from LGE, and that Pantech would not likely agree to extend the deadline by more than ninety (90) days as provided under Rule 4 of the Federal Rules of Civil Procedure. *Id.* at ¶23. Mr. Yoon did not raise the alleged conflict during this initial call. *Id.* ¶24

Following the call between Mr. Beaber and Mr. Yoon, Mr. Fussell emailed Mr. Yoon on September 28, 2022 with a draft waiver of service agreement and proposed motion for extension of time, which provided for a ninety (90) day-extension of time to respond to the Complaint pursuant to Rule 4 from the date of the request. Fussell Decl. at ¶9. On October 4, 2022, the date LGE's response to the Complaint was due, Mr. Yoon called Mr. Fussell to discuss the waiver of service and extension of time. *Id.* at ¶10. During this call, Mr. Yoon reiterated his request for a one hundred and twenty (120) day-extension. *Id.* He indicated that he did not know much about the prior licensing negotiations between the parties but said that he hoped that the parties could use the time to resolve the dispute. *Id.* Mr. Fussell explained that this request had been discussed with Pantech following Mr. Yoon's conversation with Mr. Beaber, and Pantech did not believe that a prolonged extension was reasonable, considering LGE's unwillingness to provide Pantech with a counteroffer during yearslong negotiations between the parties in advance of the litigation. *Id.*

Ultimately, the parties agreed on a ninety (90) day-extension with the understanding that Pantech would be open to an additional extension if the parties were making progress toward settlement. *Id.* Mr. Yoon informed Mr. Fussell that he would discuss the matter with his team in

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Korea and see if there might be an opportunity to advance settlement discussion. *Id.* On October 26, 2022, when both Mr. Yoon and Mr. Fussell were attending the Eastern District of Texas Bench Bar Conference, Mr. Yoon informed Mr. Fussell that LGE viewed Pantech's position as unreasonable and, as a result, was unwilling to make a counteroffer or engage in settlement discussions. *Id.* at ¶11. In particular, Mr. Yoon informed Mr. Fussell that this was a case that will likely need to be litigated for a while before there is an opportunity to make any meaningful progress toward settlement. *Id.* at ¶12. Not once during any of these discussions did Mr. Yoon or anyone at LGE raise an alleged conflict or object to Mayer Brown's involvement in this case. *Id.* at ¶13. To the contrary, LGE led Mayer Brown to believe that LGE would respect the waiver agreement between the parties. *Id.*

Thereafter, on December 2, 2022, more than two years after LGE became aware of Mayer Brown's representation of Pantech, outside counsel for LGE formally demanded that Mayer Brown immediately cease and desist working on the matter, destroy all Mayer Brown work product, and withdraw as counsel. Mot. Ex. 27 at 2. Mayer Brown responded on December 8, 2022, noting the flaws in LGE's position, the conflicts waiver provided by LGE to Mayer Brown, and questioning the substantial delay in raising the issue. Mot. Ex. 28. LGE then waited another three weeks, until December 30, 2022, to file its motion to disqualify.

2. LGE's Conduct Amounts to a Waiver

It is undisputed that LGE knew of Mayer Brown's representation of Pantech in 2020. It is also undisputed that even after this case was filed, and despite countless opportunities, LGE waited more than three months—during which time Mayer Brown was preparing Pantech's infringement contentions and early discovery, which LGE now contends Pantech should be unable to use—to object to Mayer Brown's involvement in this case. And it is further undisputed that LGE waited until the filing of its response to the Complaint, when the case was ready for scheduling conference,

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to raise the issue of disqualification with the Court, while at the same time seeking to delay the case by staying all deadlines.

Based on these undisputed facts, LGE has waived its right to object to Mayer Brown's representation of Pantech in this litigation. *Simmons v. Houston Cnty., Texas*, No. 9:05-CV-82, 2006 WL 8440543, at *5 (E.D. Tex. Feb. 2, 2006) (finding waiver where party seeking disqualification learned of the potential conflict through pre-suit correspondence 19 months before the motion was filed); *see also Abney*, 984 F. Supp. at 530 (finding waiver due to a year-long delay); *Zichichi v. Jefferson Ambulatory Surgery Ctr., LLC*, No. CIV. A. 07-2774, 2008 WL 2859232, at *6 (E.D. La. July 22, 2008) (same). And though LGE initially objected to Mayer Brown's representation of Pantech, it should have, at a minimum, notified Mayer Brown or Pantech of its position and not led both Mayer Brown and Pantech to believe that the issue was resolved. At the very least, LGE should have immediately raised its objection once the Complaint was filed. *See Advanced Training Grp. Worldwide, Inc. v. Proactive Techs. Inc.*, 436 F. Supp. 3d 870, 875 (E.D. Va. 2020) (holding that a party with prior notice of a conflict "should have filed a motion to disqualify *immediately*" after the allegedly conflicted attorneys noticed their appearances in the case) (emphasis added).

LGE's timing was purely tactical. LGE should have filed its motion immediately, but waited until the last minute. While leading Pantech to believe it was interested in negotiating a resolution, 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. Moreover, during the hearing on LGE's motion to stay, LGE's counsel disclosed that it would be seeking to block Mayer Brown from working on Pantech's infringement contentions, something that it most certainly knew Mayer Brown and

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Pantech had been working on the entire time that LGE delayed filing its motion.² Such tactical delay in filing a motion to disqualify is not permissible. *Thomas C. v. State Farm Fire & Cas. Co.*, 2007 WL 2702700, *at 2 (S.D. Miss. 2007) (“It is not permissible to hold this right to relief in reserve in order to assert the right at a tactically advantageous time and thereby put an opponent at an unfair disadvantage.”).

C. No Conflict Exists Based on Former Representation

1. The Former Representation

Mayer Brown does not dispute that an attorney-client relationship previously existed with LGE. Thus, the relevant inquiries are whether the prior, closed matters are substantially related or whether Mayer Brown possesses relevant confidential information.

2. The Matters LGE Relies on are not Substantially Related

In determining if the present and former matters are substantially related, courts have identified three relevant factors: “(1) the factual similarities between the current and former representations, (2) the similarities between the legal question posed, and (3) the nature and extent of the attorney’s involvement with the former representation.” *Power Mosfet Techs, L.L.C. v. Siemens AG*, 2002 WL 32785219, at *2, No. 2:99-CV-168 (E.D.Tex.2002) (citing *Dieter v. Regents of Univ. of California*, 963 F.Supp. 908 (E.D.Cal.1997)). LGE has not demonstrated that the factors support disqualification.

LGE claims that Mayer Brown’s representation of Pantech is factually and legally similar to Mayer Brown’s prior representations of LGE in the [REDACTED] *CCE*, *Core Wireless*, *MTT*, and *Jenam* matters. Mot. at 13. According to LGE, Mayer Brown performed vast amounts of intellectual property work for LGE on “smartphones/cellular technology and products accused of

² P.R. 3-1 requires disclosure of asserted claims and infringement contentions not later than 10 days before the Initial Case Management Conference.

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infringement that are also accused in Pantech’s Complaint.” Mot. at 3. LGE offers broad statements that Mayer Brown worked on many matters related to LGE’s smartphone products, but LGE does not address the specific relationship of the accused functionality at issue in this case as compared to the accused functionality at issue in the numerous matters on which LGE relies. For example, LGE states that “[REDACTED] CCE matters involved alleged SEPs relating to the same cellular standards as those purportedly at issue here[,]” and goes on to cite to similar standard specifications allegedly at issue across the matters. But LGE does not describe how the similar standards, or even the same specification, creates factual similarities—in particular, whether the specific functionality within the standard specifications that are at issue here were also at issue in any of these allegedly related matters.

By way of further example, LGE argues that “the asserted U.S. Patent 9,854,545 covers at least the 3GPP TS 36.321, TS 36.213, and TS 36.331 standards pertaining to the carrier aggregation functionality mandated by at least the LTE Advanced standard...but—representing LGE—Mayer Brown analyzed these same standards and LGE Confidential Information to assess infringement [REDACTED]” Mot. at 4. Even accepting these allegations as true, which they are not, LGE fails to provide any specificity. The 3GPP TS 36.321 specification itself consists of multiple releases, is over 100 pages long, includes seven different sections each with multiple subsections, dealing with the various nuances of the technology, and broadly covers “the E-UTRA MAC protocol.” *See generally* Ex. 4 (3GPP TS 36.321 version 15.2.0 Release 15). Such generic allegations are insufficient for LGE to meet its high burden. *In re American Airlines, Inc.*, 972 F.2d 605, 614 (5th Cir.1992). “[A] substantial relationship may be found only after the moving party delineates *with specificity* the subject matters, issues and causes of action common to prior and current representations and the court engages in a painstaking analysis of the facts and precise

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application of precedent.” *Id.* (internal quotation marks omitted) (emphasis added). And the same is true for each instance where LGE attempts to show similarities between the SEPs at issue here and those at issue in [REDACTED] *CCE*.

For the non-SEPs in the case, LGE’s allegations fare no better. For U.S. Patent 9,575,631, LGE argues substantial similarity to *Core Wireless* because those patents “present user interface elements to users for accessing application.” Mot. at 4. And for U.S. Patent 7,283,839, LGE merely suggests that the patent is similar to patents in the *MTT* matter because they “pertain[] to how the messaging services and applications operating on the accused devices process messages.” *Id.* These broad and vague allegations are not enough to show that the matters are even remotely similar, much less rise to the level of similarity that would warrant disqualification. *See Microsoft Corp. v. Commonwealth Sci. & Indus. Rsch. Organisation*, No. 6:06 CV 549, 2007 WL 4376104, at *7 (E.D. Tex. Dec. 13, 2007), *aff’d sub nom. Commonwealth Sci. & Indus. Rsch. Organisation v. Toshiba Am. Info. Sys., Inc.*, 297 F. App’x 970 (Fed. Cir. 2008) (“[T]he sole presence of related subject matter does not establish a substantial relationship.”) (citing *Biax Corp. v. Fujitsu Computer Sys. Corp.*, 2007 WL 1466639, at *2, No. 2:06-CV-364 (finding that both representations involving server architecture was too broad to establish a substantial relationship)); *see also, Network Apps, LLC v. AT&T Mobility LLC*, 2022 WL 1119331, *8–*12 (S.D. N.Y. 2022) (finding disqualification unwarranted where prior representation did not factually overlap with the subject matter of the infringement suit, the court instructing that a generic overlap was not sufficient).

LGE argues generally that certain Mayer Brown attorneys’ former representations were broad and extensive, noting the thousands of hours worked as far back as 2007. Mot. at 2. Yet, again, LGE only vaguely states that the matters were “similar patent matters” and offers no

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evidence that any of the Mayer Brown attorneys’ prior work relates to the technology at issue in the present litigation. *Id.* LGE has plainly failed to meet its burden.

3. Mayer Brown Does not Possess Relevant Confidential Information

Like its substantial relationship theory, LGE has not provided sufficient evidence demonstrating that Mayer Brown attorneys possess relevant confidential information that warrants disqualification. “[LGE’s] motion and supporting evidence must adequately identify those disclosures made to the former attorneys to allow the Court to determine whether disqualification is warranted under the confidential information theory. *Simmons v. Houston Cnty., Texas*, No. 9:05-CV-82, 2006 WL 8440543, at *4 (E.D. Tex. Feb. 2, 2006) (citing *Islander East Rental Program v. Ferguson*, 917 F.Supp. 504, 511 (S.D. Tex. 1996)). “A severe remedy such as disqualification *cannot be granted on generalities.*” *Microsoft Corp.*, 2007 WL 4376104, at *9 (citing *Biax Corp.*, 2007 WL 1466638, at *3 (finding that defendant failed to meet burden with general allegations that firm had learned information regarding product operation and defendant’s engineering operations)).

LGE contends that Mayer Brown actually received relevant confidential information through its representation of LGE in “at least five litigations that spanned at least seven years.” Mot. at 11. LGE broadly claims that Mayer Brown “gained access to relevant LGE technical, financial, and marketing information for products here accused of infringing Pantech’s patents, along with LGE Confidential Information pertaining to [REDACTED] [REDACTED].” *Id.* at 3. And that “Mayer Brown had access to highly confidential schematics and source code for several accused products.” *Id.* However, LGE fails to identify any specific relevant confidential information disclosed to Mayer Brown. For example, LGE does not identify any specific “schematics” or “source code” previously shared with Mayer Brown attorneys that would be relevant to any of the patents asserted in this case. Though it attempts to heavily rely on the fact

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that [REDACTED], LGE omits the fact that [REDACTED] was not at issue [REDACTED]. Beaber Decl. at ¶4. The sole issue [REDACTED] was [REDACTED]. [REDACTED]. *Id.* at ¶3

Further, the alleged “confidential information” that LGE claims to have disclosed is discoverable information that LGE is obliged to produce in litigation. *See Abney*, 984 F.Supp. at 530 (“Plaintiff has simply not identified any confidential information in his Motion to Disqualify which he is not already obligated to disclose ...”) (internal quotation marks deleted) (citing *Metropolitan Life Ins. Co. v. Syntek Fin. Corp.*, 881 S.W.2d 319, 321 (Tex.1994) (trial court was proper in refusing a motion to disqualify where the alleged confidential information was available through discovery and available publicly)); *See also In re TMD Def. & Space, LLC*, 649 S.W.3d 764, 773 (Tex. App. 2022) (Interpreting the “reasonable probability” test under Texas Rule 1.09(a)(s), the court held that the trial court was proper in refusing disqualification where alleged confidential information “would have ultimately [been] obtained” through discovery.”).

LGE asserts that Mayer Brown became privy to [REDACTED] [REDACTED]”; however, LGE fails to show how knowledge of these strategies or practices is relevant to the present Pantech litigation. Mot. at 5. The simple fact that this case includes SEPs does not itself call into question [REDACTED]. In fact, [REDACTED] would only be relevant to a FRAND defense, which in this case would only involve the license negotiations between LGE and Pantech. Moreover, any such evidence, to the extent acquired by Mayer Brown during the [REDACTED] CCE litigation, would mostly certainly be obsolete and irrelevant based on the passage of time. *See ABA Model Rules of Professional Conduct*, Rule 1.9 cmt. 3 (Am. Bar Ass’n 2019) (“Information acquired in a prior representation may have been rendered obsolete by the passage of time.”). Indeed, since the [REDACTED] CCE matter, LGE closed

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its mobile business unit entirely and discontinued selling smartphones altogether. *See* <https://www.lgnewsroom.com/2021/04/lg-to-close-mobile-phone-business-worldwide/> (April 5, 2021 announcement of LGE closing its mobile business unit). Given the drastic change in LGE’s business, any litigation and settlement strategies from when LGE was a market participant would be entirely different and therefore irrelevant to the present litigation.

Lastly, LGE makes general assertions that “Mayer Brown conducted interviews with LGE in-house personnel, suppliers, and partners[.]” However, LGE does not identify any specific interview with any such individual and certainly not any specific confidential information learned therefrom that would be relevant here. These are the precise generalities that the courts in this District refuse to consider. *Microsoft Corp.*, 2007 WL 4376104, at *9. And “[w]hile [LGE] is not required to produce the actual confidential information, it has the burden to delineate with specificity what confidential information was shared.” *Id.*

LGE makes nothing more than vague allegations that it disclosed confidential information. Its motion fails to specifically identify relevant confidential information or state how it is relevant to the present case. *See* ABA Model Rule 1.9(b)(2) (confidential information must be “material to the matter.”) For these reasons, LGE fails to meet its burden.

IV. CONCLUSION

In view of all these facts, Pantech requests that the Court deny the relief requested in LGE’s Motion and allow it to continue with the counsel of its choosing.

Dated: January 13, 2023

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CERTIFICATE OF SERVICE

The undersigned certifies that all counsel of record who are deemed to have consented to electronic service are being served this 13th day of January, 2023, with a copy of this document via electronic mail pursuant to Local Rule CV-5(d).

/s/ Geoffrey Culbertson
Geoffrey Culbertson

CERTIFICATE OF AUTHORITY TO FILE UNDER SEAL

The undersigned certifies that during the 1/5/23 motions hearing, the Court instructed the parties to file their briefing on the instant issue under seal and would later resolve disputes over confidentiality.

/s/ Geoffrey Culbertson
Geoffrey Culbertson