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

MAXELL, LTD., *Plaintiff*, v. APPLE INC., *Defendant*.	Case No. 5:19-cv-00036-RWS **JURY TRIAL DEMANDED**

MAXELL, LTD.'S MOTION TO DISQUALIFY DLA PIPER LLP (US)

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Apple Inc. ("Apple") has employed a delay strategy since the outset of this case, including multiple attempts to stay this case. Then, with fewer than three months to trial, Apple – the wealthiest company in the world that employs hundreds of law firms in the United States alone – hired DLA Piper LLP (US) ("DLA Piper") to try this case. This is not unheard of, but rather than hire any one of the many law firms Apple regularly hires, Apple hired a firm that itself had just hired a former Mayer Brown LLP ("Mayer Brown") partner that worked on this exact case. That former Mayer Brown partner not only has critical knowledge regarding Maxell, Ltd. ("Maxell"), its trial strategy, and the underlying issues in this case, but also has Maxell confidential attorney-client privileged documents that were (unknowingly to Mayer Brown or Maxell) taken with him to DLA Piper, including confidential presentations to the client regarding Maxell's licensing strategy. DLA Piper initially failed to disclose to Mayer Brown or Maxell that it had those documents in its possession. Once it did, DLA Piper failed to properly protect, and still refuses to fully return or destroy, them.[1] These facts alone should have prevented DLA Piper and Apple from engaging, but, as Maxell has only recently learned, DLA Piper did not bother to comply with the straightforward provisions of Texas Disciplinary Rule of Professional Conduct 1.09 and ABA Model Rule of Professional Conduct 1.10(a)(2). Before Mayer Brown raised the conflict with DLA Piper, DLA Piper did not screen the former Mayer Brown attorney from the case (in fact, the former Mayer Brown attorney had discussions with DLA Piper's attorneys on this case regarding at least the Mayer Brown/Maxell team). It did not notify Maxell of the potential conflict or that it had Maxell highly confidential and privileged information. Nor did it confirm that steps had been taken to protect Maxell's highly confidential information.

[1] As of the meet and confer with Apple's counsel for this motion, Apple's counsel indicated that it wished to maintain these materials in order to respond to this motion. Apple's position is inconsistent with the Protective Order in this case, which requires that inadvertently produced documents be "immediately returned" or destroyed. D.I. 45, ¶ 16(b).

These facts warrant DLA Piper's disqualification. The ethical rules are in place to protect clients from the very activities that have transpired here, and Maxell would be substantially prejudiced by having to litigate against opposing counsel that has strategic confidential and attorney-client privileged information about the very case being tried. Maxell would also be substantially prejudiced by any delay associated with DLA Piper's disqualification. In fact, no such delay is warranted here as O'Melveny & Myers LLP, who has been involved since the inception of this case, continues to represent Apple and is fully capable of trying this case on the current schedule. Apple should not be allowed to take advantage of its own conduct to further delay the trial. Further or at a minimum, the Court should issue an order reprimanding DLA Piper for its improper conduct (to prevent similar conduct in the future) and require the return or destruction of Maxell's highly confidential and attorney-client privileged documents.

I. FACTS

While Counsel and eventually a Partner at Mayer Brown from April 2016 to January 2020, Mr. Justin Park worked on all of Mayer Brown's smartphone matters for Maxell and was an integral part of the Maxell litigation team, including on this case against Apple. Ex. A, Declaration of Jamie B. Beaber ("Beaber Decl.") at ¶ 2. Specifically, Mr. Park billed hundreds of hours on these matters, including many hours spent on the Apple matters, attending strategy meetings and drafting and reviewing documents and filings. *Id.*[2] As a result of his work on these Maxell matters, Mr. Park (1) accessed and had full access to all of Maxell's highly confidential

[2] Mr. Park was also counsel of record in Maxell's cases against Huawei and ZTE, which involved some of the same or related patents as those asserted against Apple in this case. *See Maxell, Ltd. v. Huawei Technologies Co. Ltd. et al.*, Case No. 5:16-cv-178-RWS, D.I. 130 (E.D. Tex. Dec. 11, 2017); *Maxell, Ltd. v. ZTE Corporation et al.*, Case No. 5:16-cv-00179-RWS, D.I. 36 (E.D. Tex. Apr. 4, 2017). There are clearly overlapping issues between this case and Maxell's prior cases against Huawei and ZTE. For example, U.S. Patent Nos. 6,748,317, 8,339,493, 6,408,193, and 6,329,794 asserted against Apple in this case were also asserted against ZTE in Case No. 5:16-cv-00179-RWS (E.D. Tex.). Additionally, U.S. Patent No. 7,116,438 asserted against Apple in this case was also asserted against Huawei in Case No. 5:16-cv-00178-RWS (E.D. Tex.).

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