

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

MAXELL, LTD.,	§	
	§	
Plaintiff,	§	CIVIL ACTION NO. 5:19-CV-00036-RWS
	§	
v.	§	
	§	
APPLE INC.,	§	
	§	
Defendant.	§	

ORDER

Before the Court is Plaintiff Maxell, Ltd.’s Motion to Disqualify DLA Piper LLP (US) (Docket No. 554) and DLA Piper’s Motion to Strike Certain Portions of Jamie B. Beaber’s Declaration in Support of Maxell’s Motion to Disqualify (Docket No. 577). For the reasons set forth below, both motions are **DENIED**.

BACKGROUND

Maxell filed its initial complaint in this action on March 15, 2019, alleging that Apple’s products infringe ten smartphone-related patents.¹ Docket No. 1. The case has since been narrowed to six patents and, after being reset twice, is currently set for trial on March 22, 2021. Docket Nos. 593, 619, 624. Maxell filed the instant motion on October 28, 2020—at the time, less than six weeks before the previous trial date, December 6, 2020. Docket No. 554. The Court heard argument on the motion following the pretrial conference on November 12, 2020 (Docket No. 582).

¹ U.S. Patent Nos. 6,748,317; 6,580,999; 8,339,493; 7,116,438; 6,408,193; 10,084,991; 6,928,306; 6,329,794; 10,212,586; and 6,430,498.

The events that form the factual background of this motion are generally undisputed, but each party's interpretation of the events is heavily contested. Maxell and DLA Piper have each submitted declarations and documentary evidence in support of their interpretation. The factual allegations in Maxell's motion are supported by the declaration of Jamie Beaber (Docket No. 554-1, Ex. A ("Beaber Decl.")), counsel for Maxell from Mayer Brown. The facts alleged in DLA Piper's response are supported by the declaration of Justin Park (Docket No. 576-2, Ex. 2 ("Park Decl.")), the attorney whose actions are central to this motion, declarations of members of DLA Piper's Office of General Counsel ("OGC") (Docket No. 576-3, Ex. 3 ("Lindau Decl."), Docket No. 576-4, Ex. 4 ("Deem Decl.")), the declaration of David Hoofnagle, Senior IT Manager for DLA Piper (Docket No. 576-5, Ex. 5 ("Hoofnagle Decl.)) and declarations of each lawyer and paralegal on DLA Piper's Apple team adverse to Maxell (Docket No. 576-1, Ex. 1 ("Cunningham Decl."); Docket Nos. 576-6-36, Exs. 6-36 ("Apple Team Decls.")). The following is a timeline of relevant facts.

I. Justin Park's Time at Mayer Brown

Maxell alleges that from April 2016 to January 2020, Justin Park worked on smartphone matters for Maxell as counsel at Mayer Brown and was an integral part of the Maxell litigation team. Docket No. 554 at 2. Through his work on Maxell matters, Maxell states that Mr. Park:

(1) Accessed and had full access to all of Maxell's highly confidential business, technical, and attorney-client privileged information and documents, (2) was on the internal and external e-mail distribution lists for these cases where hundreds of confidential e-mails both within Mayer Brown and with Maxell were exchanged, (3) attended meetings with Maxell related to this case including at the client's headquarters in Japan, (4) attended numerous depositions relating to the Maxell smartphone matters, (5) has direct knowledge of Maxell's litigation strategy (which includes again privileged attorney mental impressions and work product), and (6) saw confidential and attorney-client information, technical and strategic, related to these cases (and the Apple matters specifically).

Beaber Decl. ¶ 3. Mr. Park agrees that Maxell was one of his clients while at Mayer Brown. Park Decl. ¶ 3. In January 2020, Mr. Park left Mayer Brown and began working in the Washington, D.C. office of DLA Piper. Beaber Decl. ¶ 4; Park Decl. ¶ 3. At the time, DLA Piper was not engaged by Apple in this matter or in the related International Trade Commission (“ITC”) matter adverse to Maxell—*Certain Mobile Electronic Devices and Laptop Computers*, Inv. No. 337-TA-1215. Beaber Decl. ¶ 4.

Six months later, that changed. On July 30, 2020, DLA Piper filed a Public Interest Statement on Apple’s behalf in the ITC matter. *Id.* That same day, Mr. Beaber reached out to Mr. Park via telephone to discuss DLA Piper’s management of any potential conflicts of interest involving Mr. Park. *Id.* ¶ 5; Park Decl. ¶ 8. Mr. Beaber’s declaration refers to this conversation as a request for “a formal response regarding whether any confidential Maxell information had been disclosed to anyone on the DLA Piper Apple litigation team adverse to Maxell and whether any efforts were undertaken to protect Maxell’s confidential information at that time.” Beaber Decl. ¶ 5. Mr. Park characterizes the conversation as an informal call between former colleagues. Park Decl. ¶ 8. According to Mr. Park, Mr. Beaber told him that “Maxell had no intention of seeking to disqualify” DLA Piper and agreed that Mr. Park should ask the firm to establish an ethical wall. *Id.*

During their conversation, Mr. Beaber claims Mr. Park informed him that he had “had discussions with at least one DLA Piper team member working on the matters adverse to Maxell regarding the attorneys at Mayer Brown working on the Maxell smartphone matters.” Beaber Decl. ¶ 5. Mr. Park concedes that on July 28, 2020—two days prior to his conversation with Mr. Beaber—he spoke with Patrick Park, a DLA Piper attorney in Los Angeles whom he considers a personal friend. Park Decl. ¶ 6. But Mr. Park states that the “discussions” Mr. Beaber refers to

were innocuous; during “a brief portion of what was otherwise a personal conversation,” Patrick Park asked him if he knew Mr. Beaber, and Mr. Park responded that Mr. Beaber and his team “were good lawyers.” *Id.* Mr. Park testifies that he did not disclose any confidential client information to Patrick Park at that time or at any other time. *Id.*

In response to his conversation with Mr. Beaber, Mr. Park emailed Mark Fowler, vice chair of his practice group at DLA Piper, regarding an ethical wall. *Id.* ¶ 9; Docket No. 576-13, Ex. 13 (“Fowler Decl.”) ¶ 4. Mr. Fowler forwarded that email to Peter Lindau, a member of the firm’s Office of General Counsel (“OGC”). Park Decl. ¶ 9; Fowler Decl. ¶ 5; Lindau Decl. ¶ 4. Before that email, DLA Piper’s OGC was unaware of Mr. Park’s prior work for Maxell. Lindau Decl. ¶ 4. Mr. Lindau informed Mr. Park that he could not speak with anyone working on the ITC matter about Maxell or disclose any information about Maxell to anyone representing Apple. Park Decl. ¶ 9; Lindau Decl. ¶ 4. Mr. Park states that he always knew of these ethical obligations and complied with them at all times. Park Decl. ¶ 9.

On August 10, 2020, Mr. Beaber testifies that Mr. Park “responded informally” to his inquiry and said that he had contacted Mr. Fowler and OGC about implementing an ethical screen. Beaber Decl. ¶ 6. Mr. Park provided no further details regarding the ethical screen’s timing or scope. *Id.* Mr. Park testifies that this exchange was part of a text conversation initiated by Mr. Beaber about unrelated, personal matters, and he had let Mr. Beaber know that he “contacted Fowler and the inhouse counsel re Chinese wall so we are good [sic].” Park Decl. ¶ 10; Ex. A (text exchange between Mr. Park and Mr. Beaber dated 8/10/20). Because the conversation continued regarding personal matters without a response from Mr. Beaber regarding the ethical wall, Mr. Park assumed that no further communications were necessary on the topic. *Id.*

On August 18, 2020, Mr. Park testifies that he received a formal ethical screen notification from OGC. *Id.* ¶ 11. Although Mr. Park maintains that he was well aware of his duties under the ethical rules prior to reviewing the notification, he testifies that the ethical screen mandated that he (1) have no communications with any member of the DLA Apple team related to Maxell; (2) not work on anything related to his previous work for Maxell; (3) not have access to any case files, physical or electronic, for any matter involving Apple and Maxell; and (4) not receive any information about any matter involving Apple and Maxell from any of Apple’s counsel, including any member of the DLA Apple team. *Id.* Mr. Lindau confirms that the ethical screen was “fully implemented” by August 18, 2020. Lindau Decl. ¶ 4.

On August 28, 2020, a number of DLA Piper attorneys entered appearances in this matter. Docket Nos. 512–22, 524, 529. Because he “had not yet received a formal response” to his request to Mr. Park on July 30 regarding an ethical screen, Mr. Beaber states that he was “surprised” at DLA Piper’s appearance in this matter. Beaber Decl. ¶ 7. He then initiated the first in a series of communications between Mayer Brown and DLA Piper that began on September 11, 2020. *Id.*

II. Communications Between Mayer Brown and DLA Piper

On September 11, 2020, Mr. Beaber sent a letter to DLA Piper’s opposing counsel and OGC “stating that DLA Piper’s representation of Apple in this case raises a conflict of interest that may require disqualification and renewing my request for information regarding the protection of Maxell’s highly confidential information.” *Id.*; Docket No. 554-2, Ex. B (Sept. 11, 2020 email from Jamie Beaber to Sean Cunningham and Elisha King). The letter specifically asked DLA Piper to describe in detail (1) Mr. Park’s role in the case, if any; (2) any actions that DLA Piper took to notify Maxell of this potential conflict of interest and to protect Maxell’s confidential

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