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BANK OF AMERICA CORPORATION
and BANK OF AMERICA, N.A.

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15 **UNITED STATES DISTRICT COURT**
16 **FOR THE CENTRAL DISTRICT OF CALIFORNIA**
17

18 NANTWORKS, LLC, a Delaware
19 limited liability company, and NANT
HOLDINGS IP, LLC, a Delaware
20 limited liability company,

21 Plaintiffs,

22 vs.

23 BANK OF AMERICA
CORPORATION, a Delaware
24 corporation, and BANK OF
AMERICA, N.A., a national banking
25 association,

26 Defendants.
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CASE NO. 2:20-cv-7872-GW-PVC

**STIPULATED MOTION TO
DISMISS COUNTS VI, X & XI OF
THE FIRST AMENDED
COMPLAINT WITH PREJUDICE
AND COUNTS X & XI OF
DEFENDANTS'
COUNTERCLAIMS WITHOUT
PREJUDICE**

Hon. George H. Wu

1 Plaintiffs Nantworks, LLC, and Nant Holdings IP, LLC (collectively,
2 “Plaintiffs” or “NantWorks”) and Defendants Bank of America Corporation and Bank
3 of America, N.A. (collectively, “Defendants” or “Bank of America”) (together, “the
4 “Parties”) submit this Stipulated Motion to Dismiss as follows:

5 1. On November 11, 2020, NantWorks filed its First Amended Complaint,
6 asserting counts for infringement of eight patents in suit (Counts I through VIII),
7 copyright infringement (Count IX), violation of the Defend Trade Secrets Act (Count
8 X), misappropriation of trade secrets under California law (Count XI), and breach of
9 contract under New York and California law (Count XII). Dkt. 40.

10 2. In the First Amended Complaint (“FAC”), NantWorks specifically
11 accused Bank of America of infringing U.S. Patent No. 8,520,897 (the “’897 patent”),
12 among other claims. Dkt. 40, (FAC) Count VI. Bank of America counterclaimed
13 for declaratory judgments of non-infringement and invalidity of the ’897 Patent. Dkt.
14 99 (Bank of America’s Answer to First Amended Complaint, Affirmative Defenses,
15 and Counterclaims), Counts XI and XII.

16 3. Count IX was dismissed without prejudice on March 11, 2021. Dkt.
17 98. Counts III and IV of the Amended Complaint for patent infringement (and the
18 corresponding counterclaims) were dismissed with prejudice by stipulation on
19 February 3 & 9, 2022. Dkt. 166, 171.

20 4. To streamline the issues for litigation, avoid uncertainty, and halt the
21 substantial and continuing expense and burden in this ongoing litigation, dismissal is
22 appropriate for the Parties’ claims related to the ’897 Patent and for NantWorks’
23 claims in Counts X and XI of the First Amended Complaint.

24 5. NantWorks therefore stipulates that its allegations of infringement
25 relating to the ’897 Patent (including Count VI of its First Amended Complaint), and
26 associated claims for damages, are dismissed with prejudice.

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1 6. NantWorks also stipulates that its causes of action for Violation of the
2 Defend Trade Secrets Act, Count X, and for Misappropriation of Trade Secrets under
3 California Law, Count XI, are dismissed with prejudice.

4 7. Bank of America stipulates that its counterclaims for declaratory
5 judgment of non-infringement, Count XI, and for declaratory judgment of invalidity
6 of the '897 patent, Count XII, are dismissed with prejudice.

7 8. NantWorks further stipulates as follows: NantWorks, LLC and Nant
8 Holdings IP, LLC hereby represent and warrant that they own all right, title, and
9 interest in the '897 Patent. Nantworks, LLC and Nant Holdings IP, LLC hereby
10 agree and covenant not to sue or otherwise bring any demand, claim, lawsuit, or action
11 against Bank of America Corporation and Bank of America, N.A, and each of their
12 respective past, present, and future parent companies, subsidiaries, affiliates,
13 predecessors, successors, and assigns, and present, former, and future officers,
14 directors, managers, members, employees, agents, third-party administrators,
15 attorneys, advisors, consultants, indemnitors, insurers, and heirs, for infringement,
16 now or in the future, of the '897 Patent. For avoidance of doubt, this covenant not to
17 sue for infringement of the '897 Patent also applies to (i) Bank of America's
18 customers for use of its products and services; and (ii) third party vendors within the
19 limited respect to products and services actually provided by the third party vendors
20 to or on behalf of Bank of America for use by Bank of America and/or Bank of
21 America's customers. This covenant not to sue expressly includes any future
22 assignees, licensees, heirs, or successors-in-interest to NantWorks, LLC, Nant
23 Holdings IP, LLC, and to the '897 Patent. In granting this covenant not to sue,
24 NantWorks does not concede that the '897 Patent is invalid, unenforceable, or not
25 infringed.

26 9. Bank of America stipulates that its counterclaims for declaratory
27 judgment of non-infringement and invalidity of the '897 Patent (including Counts XI
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1 and XII in Bank of America’s Answer to First Amended Complaint, Affirmative
2 Defenses, and Counterclaims) are dismissed with prejudice.

3 10. The Parties agree that each party bears its own fees and costs as to the
4 dismissed claims, but the Parties still have the right to seek attorneys’ fees (e.g., under
5 35 U.S.C. § 285) and costs for the remaining claims in this case upon adjudication of
6 all the remaining claims.

7 11. The Parties agree that, pursuant to Rule 408 of the Federal Rules of
8 Evidence, nothing in this stipulation should be used in this or any future disputes,
9 except for the limited purpose of enforcing the terms of this stipulation.

10 12. The Parties agree that the Court retains jurisdiction over the Parties for
11 the limited purpose of enforcing the terms of this stipulation.

12 For the reasons set forth above, the Parties respectfully request that the Court
13 enter the attached Stipulated Order.

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DATED: January 25, 2023

Respectfully submitted,

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