



1 QUINN EMANUEL URQUHART
& SULLIVAN, LLP
2 Kevin P.B. Johnson (Bar No. 177129)
kevinjohnson@quinnemanuel.com
3 Todd M. Briggs (Bar No. 209282)
toddbriggs@quinnemanuel.com
4 Brice C. Lynch (Bar No. 288567)
bricelynch@quinnemanuel.com
5 555 Twin Dolphin Drive, 5th Floor
Redwood Shores, California 94065
6 Telephone: (650) 801-5000
Facsimile: (650) 801-5100

QUINN EMANUEL URQUHART
& SULLIVAN, LLP
James R. Asperger (Bar No. 83188)
jimasperger@quinnemanuel.com
Rachael McCracken
rachaelmccracken@quinnemanuel.com
865 South Figueroa Street, 10th Floor
Los Angeles, CA 90017-2543
Telephone: (213) 443-3000
Facsimile: (213) 443-3100

7 QUINN EMANUEL URQUHART
& SULLIVAN, LLP
8 Eric Huang (*pro hac vice*)
erichuang@quinnemanuel.com
9 51 Madison Avenue, 22nd Floor
New York, New York 10010
10 Telephone: (212) 849-7000
11 Facsimile: (212) 849-7100

12 Attorneys for Plaintiffs
NANTWORKS, LLC and NANT HOLDINGS IP, LLC

14 UNITED STATES DISTRICT COURT
15 FOR THE CENTRAL DISTRICT OF CALIFORNIA

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

19 Plaintiffs,

20 vs.

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

24 Defendants.

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

**MEMORANDUM OF LAW IN
SUPPORT OF PLAINTIFFS'
MOTION TO STRIKE PORTIONS
OF THE OPENING EXPERT
REPORT OF DR. NATHAN
POLISH**

25
26
27
28



TABLE OF CONTENTS

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

	<u>Page</u>
I. INTRODUCTION.....	1
II. BACKGROUND.....	2
A. BoA’s Invalidation Contentions	2
B. Dr. Polish’s Expert Opinions on Invalidation	5
III. LEGAL STANDARDS.....	6
IV. ARGUMENT	8
A. Dr. Polish’s Previously Undisclosed Opinions on Obviousness Should Be Stricken.....	8
B. Dr. Polish’s Previously Undisclosed Opinions on Alleged Patent Ineligibility Should Be Stricken.....	13
1. The FIC Does Not Support Patent Specific Ineligibility Theories	14
2. Newly Identified Functionalities and Hardware that is Purportedly Conventional.....	16
C. BoA Was Not Diligent In Its Late Disclosure of New Theories	18
V. CONCLUSION	20



TABLE OF AUTHORITIES

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Page

Cases

Asetek Danmark A/S v. CoolIT Sys. Inc.,
2022 WL 21306657 (N.D. Cal. Oct. 4, 2022)..... 10

Berkheimer v. HP,
881 F.3d 1360 (Fed. Cir. 2018)..... 13, 16

California Inst. of Tech. v. Broadcom Ltd.,
2019 WL 8192255 (C.D. Cal. Aug. 9, 2019), *order corrected*, 2019
WL 8807924 (C.D. Cal. Nov. 21, 2019)..... 3

Finjan v. Proofpoint,
2015 WL 9460295 16

Finjan, Inc. v. Sophos, Inc.,
2016 WL 2988834 (N.D. Cal. May 24, 2016) 6, 7

Johnson v. Mammoth Recreations, Inc.,
975 F.2d 604 (9th Cir. 1992)..... 5

Kandypens, Inc. v. Puff Corp.,
2020 WL 11629210 (C.D. Cal. Sept. 24, 2020)..... 7, 9

Karl Storz Endoscopy-Am., Inc. v. Stryker Corp.,
2017 WL 5257001 (N.D. Cal. Nov. 13, 2017)..... 13, 14, 16

Labyrinth Optical, Techs. LLC v. Alcatel-Lucent USA Inc.,
2015 WL 12681652 (C.D. Cal. Jan. 13, 2015)..... 7

Largan Precision Co., Ltd. v. Genius Elec. Optical Co.,
2014 WL 6882275 (N.D. Cal. Dec. 5, 2014) 12

MediaTek Inc. v. Freescale Semiconductor, Inc.,
2014 WL 690161 (N.D. Cal. Feb. 21, 2014)..... 6

Nichia Corp. v. Feit Elec. Co., Inc.,
2022 WL 4613591 (C.D. Cal. Feb. 15, 2022)..... 6, 7, 9, 10, 12, 17, 18, 19

O2 Micro Int’l Ltd. v. Monolithic Power Sys., Inc.,
467 F.3d 1355 (Fed. Cir. 2006)..... 6, 7



1 *Pfizer, Inc. v. Apotex, Inc.*,
2 480 F.3d 1348 (Fed. Cir. 2007) 19

3 *Phigenix, Inc. v. Genentech, Inc.*,
4 783 F. App'x 1014 (Fed. Cir. 2019)..... 6

5 *Slot Speaker Techs., Inc. v. Apple, Inc.*,
6 2017 U.S. Dist. LEXIS 8414 (N.D. Cal. Jan. 19, 2017) 9

7 *Verinata Health, Inc. v. Sequenom, Inc.*,
8 2014 WL 4100638 7

Rules / Statutes

9

10 35 U.S.C. § 101 5, 6, 13, 19

11 35 U.S.C. § 315(e) 3

12 Fed. R. Civ. P. 16 8

13 Fed. R. Civ. P. 16(b)(4) 5

14 Fed. R. Civ. P. 16(f)(1)(C)..... 5

15 Fed. R. Civ. P. 37(b)(2)(A)(ii)..... 5

16 N.D. Cal. Patent L.R. 3-3..... 6

17 Standing Patent Rule 2.5..... 6, 8, 10

18

19

20

21

22

23

24

25

26

27

28



1 **I. INTRODUCTION**

2 Plaintiffs NantWorks LLC and Nant Holding IP, LLC (“NantWorks”),
3 respectfully move to strike certain portions of the Opening Expert Report of Dr.
4 Nathaniel Polish (“Polish Report”), served January 30, 2024 by Defendants Bank of
5 America Corporation and Bank of America N.A. (“BoA”), because those portions
6 contain new, previously undisclosed, invalidity theories regarding alleged
7 obviousness and patent ineligibility.

8 BoA’s September 8, 2023 Final Invalidity Contentions (“FIC”) fail to explain
9 why the prior art combinations BoA elected in January 2022 render the asserted
10 claims obvious. Instead, BoA’s FIC provides for the patents-in-suit 31 separate
11 anticipation claim charts, generic catch-all language attempting to reserve unspecified
12 obviousness theories, and a lengthy narrative in the cover pleading that purports to
13 provide an “Explanation of Obviousness under S.P.R. 2.5.2” but utterly fails to
14 explain why the elected prior art combinations render the claims obvious. Nearly five
15 months later, the Polish Report provides *for the first time* specific obviousness
16 theories—theories that BoA failed to disclose in its FIC.

17 Regarding patent ineligibility, BoA’s FIC includes just over one page of
18 ineligibility disclosure, which contain a mere nine lines of non-boilerplate disclosure
19 that fails to adequately disclose its theories for *Alice* step two on a patent-by-patent
20 basis, let alone disclose the actual claim language from each of the now five patents-
21 in-suit that it contends are well-understood, routine and conventional. Nearly five
22 months later, the Polish Report dramatically departs from the nine lines in BoA’s FIC,
23 providing *for the first time* specific and separate theories as to what claim limitations
24 are purportedly conventional on a patent by patent basis, with reference to specific
25 claim language.

26 BoA has not offered (and cannot offer) any justification for its belated addition
27 of new theories in the Polish Report. In the face of its election of prior art obviousness
28 combinations 20 months earlier, its omission from the FIC of any explanation of why

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.