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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. NATHANIEL  
POLISH**

28



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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

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