

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Bank of America, N.A.
Petitioner,

v.

Nant Holdings IP, LLC
Patent Owner.

Case No. IPR2021-01080
U.S. Patent No. 8,463,030

**PETITIONER'S PRELIMINARY REPLY
TO PATENT OWNER'S PRELIMINARY RESPONSE**

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TABLE OF ABBREVIATIONS AND CONVENTIONS

Bank of America or Petitioner	Bank of America, N.A.
Board	Patent Trial and Appeal Board
Bolle	Ex. 1006: U.S. Patent No. 5,546,475, titled “Produce Recognition System” to Rudolf M. Bolle, et al.
IPR	<i>inter partes</i> review
NantWorks or Patent Owner	Nant Holdings IP, LLC
Ogasawara	Ex. 1005: U.S. Patent No. 6,512,919, titled “Electronic Shopping System Utilizing a Program Downloadable Wireless Videophone” to Nobuo Ogasawara
POPR	Patent Owner’s Preliminary Response, Paper 10
POSITA	person of ordinary skill in the art
the ’030 patent	Ex. 1001: U.S. Patent No. 8,463,030

xx:yy-zz column *xx*, lines *yy* to *zz*

TABLE OF AUTHORITIES

Cases

<i>Amgen Inc. v. Hoechst Marion Roussel, Inc.</i> , 314 F.3d 1313 (Fed. Cir. 2003)	1
<i>Array Biopharma Inc. v. Takeda Pharm. Co. Ltd.</i> , IPR2015-00754, Paper 82 (P.T.A.B. Feb. 14, 2019).....	1
<i>In re Antor Media Corp.</i> , 689 F.3d 1282 (Fed. Cir. 2012)	1, 5
<i>In re Wands</i> , 858 F.2d 731 (Fed. Cir. 1988)	1, 2, 4, 5
<i>Pfizer, Inc. v. Genentech, Inc.</i> , IPR2017-02019, Paper 16 (P.T.A.B. Feb. 12, 2018).....	2
<i>Raytheon Tech. Corp. v. General Elec. Co.</i> , 993 F.3d 1374 (Fed. Cir. 2021)	1, 2, 3, 4
<i>U.S. v. Telectronics, Inc.</i> , 857 F.2d 778 (Fed. Cir. 1988)	2

Other Authorities

37 C.F.R. § 42.65(a).....	4
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I. Introduction

Contrary to Patent Owner’s assertion (POPR, Paper 10 at 55–56),¹ Ogasawara is enabling prior art under *Raytheon Tech. Corp. v. General Elec. Co.*, 993 F.3d 1374 (Fed. Cir. 2021) and *In re Wands*, 858 F.2d 731 (Fed. Cir. 1988), as shown by Ogasawara’s own disclosure and the disclosure of Bolle, described at length in the Petition. *See, e.g.*, Petition, Paper 9 at 12–28. Patent Owner, not Petitioner, has the burden to show that a prior art reference is not enabled. *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003) (prior art is presumed enabled unless challenger overcomes presumption). Patent Owner’s conclusory arguments and declaration do not come close to meeting its burden.²

II. Ogasawara is an Enabling Prior Art Reference

Prior art patents are presumed to be enabled. *See Array Biopharma Inc. v. Takeda Pharm. Co. Ltd.*, IPR2015-00754, Paper 82 at 15 (P.T.A.B. Feb. 14, 2019); *In re Antor Media Corp.*, 689 F.3d 1282, 1287–88 (Fed. Cir. 2012); *Amgen*, 314 F.3d at 1355. Patent Owner bears the burden of proving that Ogasawara is not enabled. *See Amgen*, 314 F.3d at 1355; *Array Biopharma*, Paper 82 at 15. Here, Patent Owner’s arguments fail

¹ The Board authorized this Reply in its October 14, 2021 e-mail.

² Patent Owner cannot fix these deficiencies in its sur-reply as the Board instructed the parties to “confine the arguments . . . to evidence currently in the record.”

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