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10 **UNITED STATES DISTRICT COURT**
11 **FOR THE CENTRAL DISTRICT OF CALIFORNIA**

13 NANTWORKS, LLC, a Delaware
14 limited liability company, and NANT
HOLDINGS IP, LLC, a Delaware
limited liability company,

15 Plaintiffs,

16 vs.

17 BANK OF AMERICA
18 CORPORATION, a Delaware
corporation, and BANK OF
19 AMERICA, N.A., a national banking
association,

20 Defendants.
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Case No. 2:20-cv-07872-GW-PVC

Honorable George H. Wu

**DEFENDANTS' PRELIMINARY
INVALIDITY CONTENTIONS FOR
U.S. PATENT NOS. 7,881,529,
7,899,252, 8,326,038, 8,463,030,
8,478,036, 8,520,897, 9,031,278, AND
9,324,004**

Complaint Served: August 31, 2020

**CONTAINS MATERIAL
DESIGNATED "CONFIDENTIAL –
ATTORNEY EYES ONLY" IN
SECTION VII.**

1 **DEFENDANTS’ PRELIMINARY INVALIDITY CONTENTIONS**

2 In accordance with S.P.R. 2.5 and the schedule adopted by the Court (Dkt. 91),
3 Defendants Bank of America Corporation and Bank of America, N.A. (together
4 “Defendants” or “Bank of America”) hereby disclose their Preliminary Invalidation
5 Contentions and associated document production.

6 **I. GENERAL STATEMENT AND RESERVATION OF RIGHTS**

7 On March 4, 2021, Plaintiffs Nantworks, LLC and Nant Holdings IP, LLC
8 (collectively “Nantworks” or “Plaintiff”) served Bank of America with its Preliminary
9 Infringement Contentions and asserted the below listed patent claims (“Asserted
10 Claims”):

11 Asserted Patent	12 Asserted Claims
13 U.S. Pat. No. 7,881,529 (“529 patent”)	Claims 1–4, 6–7, 9, 18–21, and 23–24
14 U.S. Pat. No. 7,899,252 (“252 Patent”)	Claims 18–19, 26–29, and 31–34
15 U.S. Pat. No. 8,463,030 (“030 Patent”)	Claims 1–4, 6–7, 13, 16–19, 21–22, 25– 16 27, 29–32, and 35–37
17 U.S. Pat. No. 8,326,038 (“038 Patent”)	Claims 1–6, 8–10, 13–16, and 19–22
18 U.S. Pat. No. 8,478,036 (“036 Patent”)	Claims 1–2, 10, 12–15, and 19
19 U.S. Pat. No. 8,520,897 (“897 Patent”)	Claims 25–26, 29–34, and 38–42
20 U.S. Pat. No. 9,324,004 (“004 Patent”)	Claims 1–3, 6, 11, 15, and 18
21 U.S. Pat. No. 9,031,278 (“278 Patent”)	Claims 1 and 3–5

22 Subject to Bank of America’s reservation of rights herein, with respect to each
23 asserted claim in Plaintiff’s Preliminary Infringement Contentions, Bank of America
24 provides these Preliminary Invalidation Contentions to:

- 25 • S.P.R. 2.5.1. The identify of each item of prior art that anticipates each
26 asserted claim or renders it obvious (*see* Section III);
27

- 1 • S.P.R. 2.5.2. Whether each item of prior art anticipates each asserted claim
2 or renders it obvious. For obviousness, an explanation of why the prior art
3 renders the asserted claim obvious, including an identification of any
4 combinations of prior art showing obviousness (*see* Section IV);
- 5 • S.P.R. 2.5.3. A chart identifying where specifically in each alleged item of
6 prior art each limitation of each asserted claim is found, including for each
7 limitation that such party contends is governed by 35 U.S.C. § 112 ¶ 6, the
8 identity of the structure(s), act(s), or material(s) in each item of prior art
9 that performs the claimed function. (*see* Exhibits A-01-H-31); and
- 10 • S.P.R. 2.5.4. Any grounds of invalidity based on 35 U.S.C. § 101,
11 indefiniteness under 35 U.S.C. § 112 ¶ 2 or enablement or written
12 description under 35 U.S.C. § 112 ¶ 1 of any of the asserted claims) (*see*
13 Sections V and VI).

14 Bank of America’s discovery and investigation in connection with this action is
15 continuing, thus these disclosures are based on information obtained to date. To the
16 extent that Bank of America obtains additional information, Bank of America reserves
17 the right to supplement and/or amend these Preliminary Invalidity Contentions (and, if
18 required, request leave of the Court to do the same). Bank of America reserves the right
19 to amend these Preliminary Invalidity Contentions should Plaintiff provide the
20 information that it failed to provide in its S.P.R. 2.1 disclosures or in response to Bank
21 of America’s Discovery requests or if Plaintiff amends or supplements its S.P.R. 2.1
22 disclosures in any way. Furthermore, Bank of America is unaware of any prior art
23 references that any of its third-party vendors are aware of or possess, but Bank of
24 America is diligently investigating this and reserves its right to amend these Preliminary
25 Invalidity Contentions with such prior art.

26 Plaintiff’s disclosures under S.P.R. 2.1 and 2.2 are deficient in numerous
27 respects. For example, Exhibit 1 of NantWorks’ Infringement Contentions is missing
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1 the limitation “extracting symbol information based on the symbolic content according
2 to symbol type.” Another example is that Plaintiff has failed to identify specifically
3 where each element of each Asserted Claim is found within each accused
4 instrumentality, as required by S.P.R. 2.1.3. Yet another example is that Plaintiff’s
5 doctrine of equivalents contentions, which bookend most if not all asserted claims
6 limitations, allege without explanation that the “differences are insubstantial and thus
7 the claim limitations are satisfied under the doctrine of equivalents.” Plaintiff’s
8 allegations under the doctrine of equivalents are deficient and lack the detail required
9 by S.P.R. 2.1. NantWorks failed to provide any analysis regarding the differences
10 between the Accused Products and the asserted claims or any explanation as to how
11 those alleged differences are insubstantial.

12 Deficiencies in Plaintiff’s Infringement Contentions have made it difficult for
13 Bank of America to understand Plaintiff’s infringement and claim construction
14 positions. The lack of detail in Plaintiff’s Infringement Contentions has prejudiced Bank
15 of America’s ability to prepare these Preliminary Invalidity Contentions by forcing it to
16 speculate as to Plaintiff’s actual position on Bank of America’s alleged infringement.
17 Therefore, these Preliminary Invalidity Contentions are based in whole or in part on the
18 present understanding of the Asserted Claims and Plaintiff’s apparent positions as to
19 the scope of the Asserted Claims as applied in its S.P.R. 2.1 disclosures. Bank of
20 America further reserves the right to modify or add additional contentions in light of
21 Plaintiff’s failure to provide infringement contentions that comply with the level of
22 disclosure required by the Standing Patent Rules that were used by former Judge
23 Guilford and that are currently incorporated into Judge Kronstadt’s standing order for
24 patent cases. If Plaintiff provides amended contentions that comply with the Standing
25 Patent Rules, Bank of America reserves the right to supplement or modify its invalidity
26 contentions.

27 These disclosures, including the accompanying claim charts, were prepared prior
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1 to the Court's claim construction ruling. As such, these disclosures are based on the
2 claim constructions of Plaintiff to the extent those constructions can be discerned from
3 Plaintiff's March 4, 2021 Preliminary Infringement Contentions and also to the extent
4 that those constructions can be understood in light of the positions taken during
5 prosecution of the Asserted Patents and related applications. These disclosures are not,
6 and nothing in these disclosures should be seen as, an endorsement, acquiescence, or
7 acceptance of any of Plaintiff's apparent claim constructions or an assertion of
8 particular constructions by Bank of America. Moreover, particular constructions
9 advocated by Plaintiff or adopted by the Court may give rise to additional defenses not
10 reflected herein. Bank of America reserves the right to assert such defenses in the
11 future. Furthermore, by making these Preliminary Invalidation Contentions, Bank of
12 America does not concede the adequacy of Plaintiff's Infringement Contentions or that
13 any assertion or construction inherent in these contentions is correct.

14 Bank of America expressly reserves the right to propose alternative constructions
15 to those advocated by Plaintiff and to challenge and contest Plaintiff's claim
16 construction positions. Bank of America reserves the right to take positions that vary
17 from any claim construction positions expressed or applied herein. Further, in addition
18 to invalidity under 35 U.S.C. §§ 102 and/or 103, Bank of America contends that one or
19 more of the claims of the Asserted Patents are invalid under 35 U.S.C. §§ 101 and 112.
20 Bank of America reserves the right to amend and/or supplement these Preliminary
21 Invalidation Contentions based on information learned through further discovery of
22 Plaintiff and third parties, including for example, claim construction positions taken by
23 Plaintiff, information pertaining to the development and description of the claimed
24 subject matter by the named inventor (and assignments thereof) listed on the Asserted
25 Patents, and any third-party systems. Bank of America's positions on the invalidity of
26 particular claims will also depend on how those claims are construed by the Court. In
27 the absence of a claim construction ruling, these Preliminary Invalidation Contentions are
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