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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

**PLAINTIFFS NANTWORKS, LLC,  
AND NANT HOLDINGS IP, LLC,  
PRELIMINARY ELECTION OF  
ASSERTED CLAIMS**

1 Pursuant to the Court’s Scheduling Order in this action (Dkt. No. 91), Plaintiffs  
2 NantWorks LLC, and Nant Holdings IP, LLC, (collectively, “Plaintiffs” or  
3 “NantWorks”), hereby submit its Preliminary Election Of Asserted Claims.

4 On March 4, 2021, NantWorks served its Preliminary Infringement  
5 Contentions, setting forth its theories of infringement for an initial set of asserted  
6 claims. Because of the early stage of this case and because Defendants have not  
7 provided sufficient discovery regarding the design and operation of the Accused  
8 Products and the full bases for their defenses for each of the Initial Asserted Claims,  
9 NantWorks reserves the right to amend its Preliminary Election Of Asserted Claims.

10 Defendants, for example, have not provided any source code regarding the  
11 design and operation of the Accused Products, nor have they produced documents  
12 sufficient to show the design and operation of the Accused Products. Defendants  
13 Invalidity Contentions also disclose millions of potential prior art reference  
14 combinations with no known way to evaluate the strengths and weaknesses of all the  
15 potential prior art combinations. Nor have Defendants responded to NantWorks’  
16 interrogatories seeking damages related information regarding the number of uses of  
17 the Accused Products to perform a mobile check deposit. Furthermore, the parties  
18 have just begun the claim construction process, no briefing has been exchanged, and  
19 the Court is months away from holding the claim construction hearing. There are  
20 many open issues that remain to be decided that will be highly relevant to choosing  
21 asserted claims for trial.

22 Because of the uncertainties and variables remaining in this case, it would be  
23 highly prejudicial to require NantWorks to narrow its asserted claims at this time  
24 without allowing NantWorks the opportunity to amend its Preliminary Election Of  
25 Asserted Claims based on new defenses and theories set forth by Defendants and other  
26 open issues as the case moves forward and circumstances change. This is particularly  
27 true where an unselected claim presents unique issues as to liability or damages. *In*  
28 *re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1312-13 (Fed. Cir.

1 2011) (finding that if a patentee demonstrates “that some of its unselected claims  
2 presented unique issues as to liability or damages,” a refusal to permit the patentee to  
3 add those specified claims “would be subject to review and reversal”). Thus,  
4 NantWorks provides this Preliminary Election Of Asserted Claims without prejudice  
5 to amend the election to include initially asserted claims that have not been included  
6 in the present Preliminary Election Of Asserted Claims.

7 Pursuant to the Court’s Scheduling Order, NantWorks identifies below its  
8 Preliminary Election Of Asserted Claims, totaling 48 claims and no more than 15  
9 claims per Asserted Patent:

- 10 • U.S. Patent No. 9,031,278: Claims 1 and 4-5
- 11 • U.S. Patent No. 7,881,529: Claims 2, 4, 7, 9, 18, and 20
- 12 • U.S. Patent No. 7,899,252: Claims 18, 26-27, 29, and 31
- 13 • U.S. Patent No. 8,326,038: Claims 1, 3, 9-10, 16, and 19-20
- 14 • U.S. Patent No. 8,463,030: Claims 1, 3-4, 6-7, 19, 21, 25-26, 30, 32, and 37
- 15 • U.S. Patent No. 8,520,897: Claims 25, 30, 33-34, 39, and 42
- 16 • U.S. Patent No. 9,324,004: Claims 1, 3, 6, and 18
- 17 • U.S. Patent No. 8,478,036: Claims 1, 10, 12-13, and 15

18 This Preliminary Election Of Asserted Claims is not intended to alter or amend  
19 NantWorks’ infringement theories, which are disclosed as in NantWorks’ Preliminary  
20 Infringement Contentions, which are incorporated completely herein by reference.

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DATED: May 11, 2021

Respectfully submitted,  
  
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**CERTIFICATE OF SERVICE**

I hereby certify that on May 11, 2021, I caused a true and correct copy of the foregoing document to be served via e-mail to all counsel of record who have appeared in this matter.

DATED: May 11, 2021

By /s/ Brice C. Lynch  
Brice C. Lynch

