

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

CYTONOME/ST, LLC,)	CASE NO.: 1:19-cv-00301-RGA
Plaintiff/Counterclaim-Defendant,)	
v.)	
NANOCELLECT BIOMEDICAL, INC.,)	
Defendant/Counterclaim-Plaintiff,)	DEMAND FOR JURY TRIAL
)	
)	
)	
)	
)	

DEFENDANT/COUNTERCLAIM-PLAINTIFF
NANOCELLECT BIOMEDICAL, INC.’S INITIAL INVALIDITY CONTENTIONS

Pursuant to Paragraph 3(f)(v) of the Court’s Scheduling Order (D.I. 15), Defendant NanoCollect Biomedical, Inc., (“Defendant” or “NanoCollect”) hereby provides its Initial Invalidity Contentions for U.S. Patent Nos. 6,877,528 (“the ’528 patent”), 8,623,295 (“the ’295 patent”), 9,011,797 (“the ’797 patent”), 9,339,850 (“the ’850 patent”), 10,029,263 (“the ’263 patent”) 10,029,283 (“the ’283 patent”), and 10,065,188 (“the ’188 patent”) (collectively, the “asserted patents”). Plaintiff Cytonome/ST, LLC (“Plaintiff” or “Cytonome”) has asserted claims 1-4, 7-11, 13, and 17-26 of the ’528 patent, claims 1-18 of the ’295 patent, claims 1-19 of the ’797 patent, claims 1-12 of the ’850 patent, claims 1, 2, 5-8, and 12-21 of the ’263 patent, claims 1, 2, 4-6, and 11 of the ’283 patent, and claims 1, 10-12, 15, and 17 of the ’188 patent (collectively, the “asserted claims”).

NanoCollect contends that each of the asserted claims are invalid under one or more of 35 U.S.C. §§ 101, 102, 103 or 112. NanoCollect reserves its right to supplement these Invalidity Contentions pursuant to the Federal Rules of Civil Procedure, the Court’s Local Rules, or any other order or schedule entered by the Court.

I. PRELIMINARY STATEMENT AND RESERVATION OF RIGHTS

NanoCollect makes the following initial invalidity contentions based upon its current knowledge, its current understanding of Plaintiff's initial claim charts pursuant to Paragraph 3(f)(iv) of the Court's Scheduling Order, and its investigations to date. NanoCollect's investigation into the facts of this action is still ongoing. NanoCollect has not completed its investigation of the facts relating to this case, discovery in this action, or its preparation for trial. This disclosure is without prejudice to NanoCollect's right to produce evidence of any additional prior art references. Accordingly, NanoCollect reserves its right to amend, alter or supplement the contentions made herein as new, additional, or different information is learned and discovered.

Further, these contentions, including the accompanying claim charts, were prepared prior to the Court's claim construction ruling and disclosure of claim construction positions from Plaintiff. NanoCollect's positions on the invalidity of particular claims may depend on how the claims are construed by the Court. NanoCollect's contentions herein are not, and should in no way be seen as, admissions or adoptions as to any particular claim scope or construction, or as any admission that any particular element is met in any particular way. NanoCollect objects to any attempt to imply claim construction from the charts attached hereto. In the absence of a claim construction ruling, these contentions are made in the alternative and are not necessarily intended to be consistent with each other. *See* Fed. R. Civ. P. 8(d). These contentions are made out of an abundance of caution to reflect the potential scope of the claims that Plaintiff appears to be advocating or could advocate, as suggested in Plaintiff's initial claim charts. NanoCollect's contentions should not be seen as a suggestion that Plaintiff's reading of the patent claims is correct, and NanoCollect applies the prior art in light of Plaintiff's improper assertion of

infringement and improper application of the asserted claims. NanoCollect reserves the right to supplement or amend the disclosures made herein following disclosure by Plaintiff of its positions regarding claim construction and following receipt of the Court's claim construction order construing the claims of the asserted patents.

The citations provided in NanoCollect's contentions are intended to be exemplary, not exhaustive. NanoCollect has endeavored to cite to the most relevant portions of the identified prior art. Other portions of the identified prior art may additionally disclose, either expressly or inherently, and/or render obvious one or more elements or limitations of the asserted claims. NanoCollect reserves the right to rely on uncited portions of the identified prior art to establish the invalidity of the asserted claims. Moreover, NanoCollect reserves the right to rely on uncited portions of the identified prior art, other art, or testimony to provide context to or aid in understanding the cited portions of the identified prior art. NanoCollect also reserves the right to rely upon treatises, published industry standards, and similar documents to demonstrate the knowledge of one of ordinary skill in the relevant art. Where NanoCollect cites to a particular drawing or figure, the citation encompasses the description of the drawing or figure, as well as any text associated with the drawing or figure. Similarly, where NanoCollect cites to particular text concerning a drawing or figure, the citation encompasses that drawing or figure as well. Also, where NanoCollect cites to any portion of prior art as disclosing a particular limitation, that citation applies with equal force to all similar or identical limitations in each of the asserted claims.

NanoCollect's Invalidity Contentions and the accompanying charts are set forth in the alternative and do not constitute any concession for purposes of determining infringement or any

other issue in this case. *See, e.g., Vanmoor v. Wal-Mart Stores, Inc.*, 201 F.3d 1363, 1366 (Fed. Cir. 2000).

Furthermore, the identification of anticipatory references and obviousness combinations of references provided below under 35 U.S.C. §§ 102 and 103 is merely exemplary and is not intended to be exhaustive. In particular, NanoCollect is currently unaware of the extent to which Plaintiff may contend that limitations of the claims at issue are not disclosed in the art identified by NanoCollect as anticipatory. To the extent that an issue arises with any such limitation, NanoCollect reserves the right to identify other references which make obvious the addition of the allegedly missing limitation to the disclosed system or method. NanoCollect reserves the right to use references identified in obviousness combinations as anticipatory references. NanoCollect reserves the right to use any reference disclosed herein as an anticipatory reference or in an obviousness combination.

Along with these contentions, NanoCollect discloses information as required by the Local Patent Rules. Nevertheless, NanoCollect objects to the disclosure of information that is protected by the attorney-client privilege, the attorney work-product immunity, the common interest privilege or any other applicable privilege or immunity. To the extent that NanoCollect inadvertently discloses information that may be protected from discovery under the attorney-client privilege, the attorney work-product immunity, the common interest privilege or any other applicable privilege or immunity, such inadvertent disclosure does not constitute a waiver of any such privilege or immunity.

By these contentions, NanoCollect does not waive its right to raise different or additional bases for the invalidity of the asserted claims, including under 35 U.S.C. §§ 101 and 112, disclosure of which is not required in these contentions under the Scheduling Order. The

information set forth below is provided without waiving: (1) the right to object to the use of any statement for any purpose, in this action or any other action, on the grounds of privilege, relevance, materiality or any other appropriate grounds; (2) the right to object to any request involving or relating to the subject matter of the statements herein; or (3) the right to revise, correct, supplement or clarify any of the statements provided below at any time. NanoCollect reserves the right to amend and/or supplement these contentions in accordance with the Federal Rules of Civil Procedure and the Rules of this Court.

NanoCollect reserves the right to allege the invalidity of the asserted claims on bases other than those disclosed herein.

II. INCORPORATION BY REFERENCE

In addition to the prior art identified below, NanoCollect incorporates by reference the supporting Exhibits and the prosecution file histories of the patents-in-suit and any related patents or applications, including any arguments, cited prior art, or claim rejections made by the Patent and Trademark Office (“PTO”) set forth in such prosecution histories. In addition, NanoCollect incorporates by reference any art listed on the face of the patents-in-suit or any related patents or applications, as well as any art listed on the face of any patents or applications listed as prior art below.

III. PRIOR ART

There is ample prior art demonstrating the invalidity of the patents-in-suit. Exemplary prior art is set forth in this section below and throughout these contentions and the supporting Exhibits. Further, in connection with the contentions set forth herein, NanoCollect may rely, and reserve the right to rely, on common sense and/or the general knowledge of a person of ordinary skill in the art at the time of the alleged inventions.

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