

May 24, 2023

VIA E-MAIL

Max Tribble
Susman Godfrey LLP
1000 Louisiana St #5100
Houston, TX 77002
Phone : (713) 653-7820

Re: *SpaceTime3D, Inc. v. Apple Inc.*, Case No. 1:23-cv-00553-ADA-DH (W.D. Tex.)

Dear Counsel:

Apple Inc. (“**Apple**”) has filed an *inter partes* review (IPR) petition (IPR2023-00344) with the Patent Trial and Appeal Board (PTAB) to address the validity of claims 1-20 of U.S. Patent No. 9,696,868 (“**the ’868 Patent**”). The tables in attached Appendix A list all the grounds and references asserted in IPR2023-00344 against the challenged claims.

I write to inform you that Apple hereby stipulates that if the PTAB institutes IPR2023-00344 based on the grounds and claims listed in the tables in Appendix A, Apple will not pursue for the instituted claims, in the District Court proceedings, the grounds asserted in the IPR2023-00344 petition or any other ground that could have been reasonably raised in an IPR. *Sotera Wireless, Inc. v. Masimo Corp.*, Case IPR2020-0109, Paper 12 (PTAB Dec. 1, 2020).

In so stipulating, Apple seeks to minimize the overlap of issues and avoid multiple proceedings addressing the validity of the challenged claims based on the same grounds. Rather, through this stipulation, Apple expresses its intention to have only the PTAB address any Instituted Grounds of invalidity of claims 1-20 of the ’868 Patent. But, for the sake of clarity and to avoid any doubt, if the PTAB declines to institute any of the grounds identified herein, Apple reserves the right to assert the denied grounds, and any other grounds that could have been reasonably raised against the ’868 Patent in an IPR, in the District Court proceedings.

Sincerely,



Brian Rosenthal
Attorney for Apple Inc.

Appendix A – Grounds and Prior Art References Used in IPR2023-00344

Ground	'868 Patent Claim(s)	§103 Combination
1A	1-5, 9-14, and 18-20	Anthony in view of Hanggie
1B	6-8, 15-17	Anthony in view of Hanggie and Matthews
1C	7	Anthony in view of Hanggie and Matthews and Robertson
2A	1-5, 9-14, and 18-20	Hanggie in view of Anthony
2B	6-8, 15-17	Hanggie in view of Anthony and Matthews
2C	7	Hanggie in view of Anthony and Matthews and Robertson

List of References

Reference Name	Details
Hanggie	US Patent Pub. No. 2005/0088447
Anthony	US Patent Pub. No. 2005/0091596
Matthews	US Patent Pub. No. 2006/0107229
Robertson	US Patent No. 6,414,677