From: Lavenue, Lionel
Sent: Wednesday, January 17, 2024 11:07 AM
To: vrubino@fabricantllp.com; ffabricant@fabricantllp.com; plambrianakos@fabricantllp.com; jarubino@rubinoip.com; mmondelli@rubinoip.com; kurt@truelovelawfirm.com"
Cc: BMW-NorthStar-IPRs
Subject: IPR2023-01049 and IPR2023-01191

Counsel:

In accordance with the Board's precedential decision in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020), BMW of North America LLC agrees that, if IPR Nos. IPR2023-01049 and IPR2023-01191 are instituted, it will not pursue "any ground that [they] raised or reasonably could have raised" during the IPRs in the related district court proceedings, *NorthStar Systems LLC v. Bayerische Motoren Werke AG*, 2:22-cv-00496 (E.D. Tex.) (consolidated in a case styled, *NorthStar Systems LLC v. Volkswagen AG*, 2:22-cv-00486 (E.D. Tex.)), and *BMW of North America LLC v. NorthStar Systems LLC*, 6:23-cv-00456 (W.D. Tex.). 35 U.S.C. § 315(d).

Regards,

Lionel

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BMW v. NORTHSTAR
IPR2023-01191