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Re: *Apple Inc., v Masimo Corp., et al.*, Case. No. 1-22-cv-01378

Counsel:

We write regarding the *inter partes review* (IPR) petition (IPR2024-00241) that Apple Inc. ("Apple") filed with the Patent Trial and Appeal Board (PTAB) challenging claims 1-25 of U.S. Patent No. 10,687,743 ("the '743 Patent"), and the IPR petition (IPR2024-00242) that Apple filed with the PTAB challenging claims 1, 3-14, and 16-25 of the '743 Patent. The tables in attached Appendices A, B, and C list the grounds and references asserted in IPR2024-00241 and IPR2024-00242.

Apple hereby stipulates that if the PTAB institutes IPR2024-00241, Apple will not pursue for the instituted claims, in the above-captioned litigation, the same grounds as in the IPR2024-00241 petition or any grounds that could have reasonably been raised in that petition. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019 Pap. 12 (PTAB Dec. 1, 2020) (precedential).

Apple also hereby stipulates that if the PTAB institutes IPR2024-00242, Apple will not pursue for the instituted claims, in the above-captioned litigation, the same grounds as in the IPR2024-00242 petition or any grounds that could have reasonably been raised in that petition. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019 Pap. 12 (PTAB Dec. 1, 2020) (precedential).

In so stipulating, Apple seeks to avoid multiple proceedings in different forums addressing the validity of the instituted claims based on the same grounds. Rather, through this stipulation,

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Apple expresses its intention to have only the PTAB address any grounds of invalidity of instituted claims that could have reasonably been raised in the IPR2024-00241 and IPR2024-00242 petitions.

Sincerely,

/s/ Jordan N. Malz

Jordan N. Malz
Desmarais LLP
Attorney for Apple, Inc.

Appendix A – Grounds and Prior Art References Used in IPR2024-00241

Ground	Claims	Basis for Rejection (35 U.S.C. § 103)
1A	1-6, 9-13, 24, 25	Iwamiya-Sarantos
1B	7	Iwamiya-Sarantos-Utter
1C	8	Iwamiya-Sarantos-Han
1D	14-21	Iwamiya-Sarantos-Utter-Han
1E	22-23	Iwamiya

Appendix B – Grounds and Prior Art References Used in IPR2024-00242

Ground	Claims	Basis for Rejection (35 U.S.C. § 103)
2A	1, 3-6, 9-13, 22-25	Sarantos-Shie
2B	7	Sarantos-Shie-Utter
2C	8	Sarantos-Shie-Han
2D	14, 16-21	Sarantos-Shie-Utter-Han

Appendix C - List of References

Reference Name	Details
Iwamiya	U.S. Pat. No. 8,670,819
Sarantos	U.S. Pat. No. 9,392,946
Utter	U.S. Pat. No. 8,446,275
Han	U.S. Pat. Pub. No. 2016/0058312
Shie	U.S. Pat. No. 6,483,976

Appendix C - List of References

Reference Name	Details
Bailey	NPL - Brian Bailey, et al., Development of a Remote Pulse Oximeter, the University of Arizona, May 2010
Tran	U.S. Pat. Pub. No. 2008/0004904
Kianl	U.S. Pat. No. 6,658,276
D'Angelo	NPL - Lorenzo T. D'Angelo, et al., A Sensor Network to iPhone Interface Separating Continuous and Sporadic Processes in Mobile Telemedicine, 33rd Annual International Conference of the IEEE EMBS Boston, Massachusetts USA, August 30 - September 3, 2011
Ording	U.S. Patent No. 7,812,826
Goldsmith	U.S. Pat. Pub. No. 2007/00093786
Moon	U.S. Pat. Pub. No. 2010/0324387