

December 12, 2023

VIA E-MAIL

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

Counsel:

We write regarding the petitions for *inter partes* review (“IPR”) that are being filed today against U.S. Patent No. 10,722,159, in the above-captioned litigation. I write to inform you that Apple Inc. (“Apple”) hereby stipulates that if the Patent Trial and Appeal Board (“PTAB”) institutes the IPR petition filed in IPR2024-00243 on the grounds presented within that petition, then Apple will not, for the instituted claims, seek resolution in the above-captioned litigation of any ground of invalidity that utilizes U.S. Pat. No. 8,670,819 (“Iwamiya”), U.S. Pat. No. 9,392,946 (“Sarantos”), U.S. Pat. Pub. No. 2016/0058312 (“Han”), or U.S. Pat. No. 8,446,275 (“Utter”).

Similarly, Apple hereby stipulates that if the PTAB institutes the IPR petition filed in IPR2024-00244 on the grounds presented within that petition, then Apple will not, for the instituted claims, seek resolution in the above-captioned litigation of any ground of invalidity that utilizes U.S. Pat. No. 9,392,946 (“Sarantos”), U.S. Pat. No.

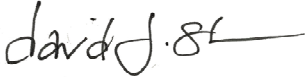
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6,483,976 (“Shie”), U.S. Pat. Pub. No. 2006/0253010 (“Brady”), U.S. Pat. Pub. No. 2016/0058312 (“Han”), or U.S. Pat. No. 8,446,275 (“Utter”).

In so stipulating, Apple seeks to avoid multiple proceedings in different forums addressing the validity of U.S. Patent No. 10,722,159 based on any of the same prior art references. Rather, consistent with Congressional intent, Apple wishes the patentability of this patent over the prior art references applied in IPR2024-00243 and IPR2024-00244 to be addressed at the PTAB.

Very truly yours,

A handwritten signature in black ink, appearing to read "David J. Shaw", with a horizontal line underneath.

David Shaw
Desmarais LLP

Attorney for Apple Inc.

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Appendix A – Grounds and Prior Art References Used in IPR2024-00243

Ground	Claims	Basis for Rejection (35 U.S.C. § 103)
1A	1-2, 4-13	Iwamiya-Sarantos
1B	3	Iwamiya-Sarantos-Han
1C	14-25	Iwamiya-Sarantos-Utter

Appendix B – Grounds and Prior Art References Used in IPR2024-00244

Ground	Claims	Basis for Rejection (35 U.S.C. § 103)
1A	1-5, 7-9, 12-13	Sarantos
1B	1-5, 7-14, 16-18	Sarantos-Shie
1C	2	Sarantos-Brady
1D	3	Sarantos-Brady-Han
1E	2	Sarantos-Shie-Brady
1F	3	Sarantos-Shie-Brady-Han
1G	14, 16-25	Sarantos-Utter
1H	14, 16-25	Sarantos-Shie-Utter

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
Brady	U.S. Pat. Pub. No. 2006/0253010