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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 (IPR2024-00243) that Apple Inc. (“Apple”) filed with the Patent Trial and Appeal Board (PTAB) challenging claims 1-25 of U.S. Patent No. 10,722,159 (“the ’159 Patent”), and the IPR petition (IPR2024-00244) that Apple filed with the PTAB challenging claims 1-5, 7-14, and 16-25 of the ’159 Patent. The tables in attached Appendices A, B, and C list the grounds and references asserted in IPR2024-00243 and IPR2024-00244.

Apple hereby stipulates that if the PTAB institutes IPR2024-00243, Apple will not pursue for the instituted claims, in the above-captioned litigation, the same grounds as in the IPR2024-00243 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 IPR2024-00244, Apple will not pursue for the instituted claims, in the above-captioned litigation, the same grounds as in the IPR2024-00244 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 IPR2024-00243 and IPR2024-00244 petitions.

Sincerely,

/s/ Jordan N. Malz

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

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

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