

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. 10,736,507, 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 IPR2024-00294 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:

- Y. Mendelson, et al., *A Wearable Reflectance Pulse Oximeter for Remote Physiological Monitoring*, Proceedings of the 28th IEEE EMBS Annual International Conference New York City, USA, Aug 30-Sept 3, 2006 (“Mendelson”),
- U.S. Pat. Pub. No. 2008/0004904 (“Tran”),
- U.S. Pat. No. 6,658,276 (“Kianl”),

- 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 (“D’Angelo”),
- U.S. Pat. No. 7,812,826 (“Ording”),
- U.S. Pat. Pub. No. 2007/00093786 (“Goldsmith”), or
- U.S. Pat. Pub. No. 2010/0324387 (“Moon”).

Similarly, Apple hereby stipulates that if the PTAB institutes the IPR petition filed in IPR2024-00293 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:

- Brian Bailey, et al., *Development of a Remote Pulse Oximeter*, the University of Arizona, May 2010 (“Bailey”),
- U.S. Pat. Pub. No. 2008/0004904 (“Tran”),
- U.S. Pat. No. 6,658,276 (“Kianl”),
- 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 (“D’Angelo”),
- U.S. Pat. No. 7,812,826 (“Ording”),
- U.S. Pat. Pub. No. 2007/00093786 (“Goldsmith”), or
- U.S. Pat. Pub. No. 2010/0324387 (“Moon”).

In so stipulating, Apple seeks to avoid multiple proceedings in different forums addressing the validity of U.S. Patent No. 10,736,507, 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 IPR2024-00293 and IPR2024-00294 to be addressed at the PTAB.

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Very truly yours,

A handwritten signature in black ink, appearing to read "David J. Shaw", with a long horizontal flourish extending to the right.

David Shaw
Desmarais LLP

Attorney for Apple Inc.

Appendix A – Grounds and Prior Art References Used in IPR2024-00294

Ground	Claims	Prior Art References
1A1	13, 15, 18-19	Mendelson (Anticipation)
1A2	13, 15, 18-19	Mendelson (Obviousness)
1B	16, 18, 20	Mendelson, Tran
1C	14, 17	Mendelson, Kianl
1D	1-2, 5, 7, 9, 12-15, 17-19	Mendelson, D’Angelo
1E	3	Mendelson, D’Angelo, Ording
1F	4-6, 8, 16, 18, 20	Mendelson, D’Angelo, Tran
1G	2, 7, 14, 17	Mendelson, D’Angelo, Kianl
1H	3	Mendelson, D’Angelo, Kianl, Ording
1I	10-11	Mendelson, D’Angelo, Goldsmith
2A	13, 15, 18-19	Mendelson, Moon
2B	16, 18, 20	Mendelson, Moon, Tran
2C	14, 17	Mendelson, Moon, Kianl
2D	1-2, 5, 7, 9, 12-15, 17-19	Mendelson, Moon, D’Angelo
2E	3	Mendelson, Moon, D’Angelo, Ording
2F	4-6, 8, 16, 18, 20	Mendelson, Moon, D’Angelo, Tran
2G	2, 7, 14, 17	Mendelson, Moon, D’Angelo, Kianl
2H	3	Mendelson, Moon, D’Angelo, Kianl, Ording
2I	10-11	Mendelson, Moon, D’Angelo, Goldsmith

Appendix B – Grounds and Prior Art References Used in IPR2024-00293

Ground	Claims	Prior Art References
1A	13-15, 19	Bailey
1B	16, 18, 20	Bailey, Tran
1C	14, 17	Bailey, Kianl
1D	1, 2, 5, 7, 9, 12-15, 17, 19	Bailey, D’Angelo
1E	3	Bailey, D’Angelo, Ording
1F	4-6, 8, 16, 18, 20	Bailey, D’Angelo, Tran
1G	2, 7, 14, 17	Bailey, D’Angelo, Kianl
1H	3	Bailey, D’Angelo, Kianl, Ording
1I	10, 11	Bailey, D’Angelo, Goldsmith
2A	13-15, 19	Bailey, Moon
2B	16, 18, 20	Bailey, Moon, Tran
2C	14, 17	Bailey, Moon, Kianl
2D	1, 2, 5, 7, 9, 12-15, 17, 19	Bailey, Moon, D’Angelo
2E	3	Bailey, Moon, D’Angelo, Ording
2F	4-6, 8, 16, 18, 20	Bailey, Moon, D’Angelo, Tran
2G	2, 7, 14, 17	Bailey, Moon, D’Angelo, Kianl
2H	3	Bailey, Moon, D’Angelo, Kianl, Ording
2I	10, 11	Bailey, Moon, D’Angelo, Goldsmith

Appendix C - List of References

Reference Name	Details
Bailey	Brian Bailey, et al., <i>Development of a Remote Pulse Oximeter</i> , the University of Arizona, May 2010
Mendelson	Y. Mendelson, et al., <i>A Wearable Reflectance Pulse Oximeter for Remote Physiological Monitoring</i> , Proceedings of the 28th IEEE EMBS Annual International Conference New York City, USA, Aug 30-Sept 3, 2006
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., <i>A Sensor Network to iPhone Interface Separating Continuous and Sporadic Processes in Mobile Telemedicine</i> , 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