HAYNES BOONE

April 17, 2024

Direct Phone Number +1 512-867-8457
david.obrien@haynesboone.com

VIA EMAIL

Richard A. Kamprath
rkamprath@mckoolsmith.com
MCKOOL SMITH, P.C.

George Fishback
gfishback@mckoolsmith.com
MCKOOL SMITH, P.C.

Re: *Carbyne Biometrics, LLC v. Apple Inc.*, 1:23-cv-0032 (W.D. Tex.)

Dear Counsel:

I write regarding the above-captioned litigation (the "Parallel District Court Litigation"), and the petition for *Inter Partes* Review (IPR) in IPR2024-00333 that was filed January 31, 2024 challenging certain claims of U.S. Patent No. 11,475,105.

Petitioner Apple Inc. ("Apple") hereby stipulates that if the Patent Trial and Appeal Board (PTAB) institutes the IPR based on the grounds identified below, then it (i) will not pursue the grounds identified below in the Parallel District Court Litigation and (ii) will not pursue any other ground that reasonably could have been raised during the IPR (should it be instituted) in the Parallel District Court Litigation.

The grounds presented in the IPR petition are reproduced below for convenience:

Ground	Prior Art	Statutory Basis	Claims Challenged in IPR2024-00333
1	Kesanupalli (US 8,799,666), Cheng (US Pat. Pub. 2004/0117636), Kodama (EP 2 079 023 A2)	§103	1, 14, 18, 33 and 35
2	Kesanupalli, Cheng, Kodama, Challener (US 8,099,789)	§103	9-11 and 28-30
3	Jakobsson (US 10,360,351), Kodama	§103	1, 9-11, 14, 18, 28-30, 33 and 35

In so stipulating, Apple seeks to avoid multiple proceedings challenging the same claims on the same grounds. Through this stipulation, Apple expresses its intentions to have only the PTAB address the patentability of the challenged claims identified above on the grounds identified above. However, if the PTAB declines institution as to any ground, then Apple reserves the right to pursue any non-instituted ground in the Parallel District Court Litigation.

This stipulation is not intended, and should not be construed, to limit Apple's abilities to assert invalidity, ineligibility or unenforceability of U.S. Patent No. 11,475,105 in the Parallel District Court Litigation on any other ground not covered by this stipulation (e.g., under 35 U.S.C. §§ 101, 112, under 35 U.S.C. §§ 102, 103 with respect to art that is not eligible for PTAB consideration or that otherwise could not have reasonably been raised during the IPR if instituted, and/or non-statutory obviousness-type double patenting).

Respectfully yours,

David O'Brien
Counsel for Apple Inc.

4860-9785-9511 v.1