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Re: *Resonant Systems, Inc. d/b/a RevelHMI v. Apple Inc.*, 7:23-cv-00077 (W.D. Tex.)

Counsel:

Apple has filed an *inter partes* review (IPR) petition (IPR2024-00697) with the Patent Trial and Appeal Board (PTAB) to address the validity of claims 1-5 of U.S. Patent No. 8,093,767. The tables in attached Appendix A lists the grounds and references asserted in IPR2024-00697.

I write to inform you that Apple hereby stipulates that if the PTAB authorizes petitioner to enter this stipulation into evidence in IPR2024-00697 and institutes the proceeding, Apple will not pursue in the above-captioned litigation the same invalidity grounds raised (or any grounds that could have been raised) in IPR2024-00697 for any claim of the patent. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Pap. 12 at 13-20 (PTAB Dec. 1, 2020) (precedential) ("*Sotera*").

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, 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 IPR2024-00697 petition.

Pursuant to *Sotera*, Apple reserves the right to assert grounds in the District Court proceedings based on system art, either alone, or in combination with other prior art.[1] For the sake of clarity

[1] Apple notes that system art is not eligible for PTAB consideration in an IPR proceeding, and grounds based on system art either alone, or in combination with patent or printed publication prior art, could not have reasonably been raised before the PTAB in the IPR petitions. *See* 35 U.S.C § 311(b). Further, discovery in the District Court proceedings is currently ongoing and Apple expects there to be additional materials and/or testimony relating to system art. For the

and to avoid any doubt, if the PTAB declines to institute IPR2024-00697, Apple reserves the right to assert any and all grounds of invalidity in the District Court proceedings against the ’767 Patent.

Sincerely,

/s/ Ryan P. O’Connor

Ryan P. O’Connor

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avoidance of doubt, Apple reserves the right to rely on such forthcoming productions in the District Court proceedings.

Appendix A – Grounds and Prior Art References

Ground	Patent Claims	§103 Basis
1A	1	Shahoian-Cosper
1B	1-4	Shahoian-Cosper-Rossi
1C	5	Shahoian-Cosper-Rossi-Ramsay
2A	1	Shahoian-Cosper-Ramsay-Aldrich
2B	1-5	Shahoian-Cosper-Ramsay-Aldrich-Rossi

Reference	Date	Pre-AIA Section
Shahoian (APPLE-1004)	Jan. 3, 2006 (issued)	§102(b)
Cosper (APPLE-1009)	Apr. 9, 2007 (filed) Oct. 9, 2008 (published)	§102(a), §102(b)
Rossi (APPLE-1020)	Nov. 7, 1989 (issued)	§102(b)
Aldrich (APPLE-1021)	April 2008 (published) (APPLE-1022)	§102(b)
Ramsay (APPLE-1006)	Nov. 27, 2008 (published)	§102(a)