

NEW YORK
SAN FRANCISCO
WASHINGTON, DC

Betty H. Chen
San Francisco
Direct: 415-573-1905
bchen@desmaraisllp.com

June 21, 2024

VIA E-MAIL

Hecht Partners LLP
125 Park Avenue, 25th Floor
New York, NY 10017
Phone: (212) 851-6821

Susman Godfrey LLP
1000 Louisiana Street, Suite 5100
Houston, TX 77002-5096
Phone: 713-653-7807
1900 Avenue of the Stars, Suite 1400
Los Angeles, CA 90067-6029
Phone: (310) 789-3100

Re: *Proxense LLC v. Microsoft Corp.*, Case No. 6:23-cv-00319-ADA (W.D. Tex.)

Dear Counsel:

Microsoft Corporation ("Microsoft") has filed an *inter partes* review (IPR) petition (IPR2024-00846) with the Patent Trial and Appeal Board (PTAB) to address the validity of claims 1-29 of U.S. Patent No. 8,886,954 ("**the '954 Patent**"). The tables in attached Appendix A list all the grounds and references asserted in IPR2024-00846 against the challenged claims.

I write to inform you that Microsoft hereby stipulates that if the PTAB institutes IPR2024-00846, Microsoft agrees not to pursue any grounds raised in the petition, or any grounds Microsoft could have reasonably raised in the petition, against all claims of the '954 Patent in this District Court proceeding. *Sotera Wireless, Inc. v. Masimo Corp.*, Case IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020). For the sake of clarity and to avoid any doubt, if the PTAB declines to institute IPR2024-00846, Microsoft reserves the right to assert any grounds of invalidity against the '954 Patent in the District Court proceedings.

Sincerely,



Betty Chen
Attorney for Microsoft

Hecht Partners LLP
 Susman Godfrey LLP
 June 21, 2024
 Page 2

Appendix A – Grounds and Prior Art References Used in IPR2024-00846

Ground	Claim(s)	35 U.S.C. § 103
1	1, 2, 4, 5, 7-13, 15, 16, 18-24, 26-29	Burger
2	3, 14, 17	Burger and Robinson
3	6, 25	Burger and Orsini

Reference	Filing Date	Publication Date
US 2005/0050367 (Burger or MSC-1005)	Sept. 30, 2004	Mar. 3, 2005
US 2003/0177102 (Robinson or MSC-1006)	Feb. 19, 2003	Sept. 18, 2003
US 2004/0049687 (Orsini or MSC-1021)	Jun. 11, 2003	Mar. 11, 2004