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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 (IPR2024-00983) with the Patent Trial and Appeal Board (PTAB) to address the validity of claims 1-6 and 10, 17, and 19-20 of U.S. Patent No. 11,152,882. The tables in attached Appendix A lists the grounds and references asserted in IPR2024-00983.

I write to inform you that Apple hereby stipulates that if the PTAB authorizes petitioner to enter this stipulation into evidence in IPR2024-00983 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 IPR2024-00983 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 IPR2024-00983 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

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and to avoid any doubt, if the PTAB declines to institute IPR2024-00983, Apple reserves the right to assert any and all grounds of invalidity in the District Court proceedings against the '882 Patent.

Sincerely,

/s/ Ryan P. O'Connor

Ryan P. O'Connor

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	'882 Patent Claims	§103 Basis
1	1-6, 10, 17, 19, 20	Alexander-Cosper
2A	1-5, 10, 17, 19, 20	Gregorio
2C	1-5, 10, 17, 19, 20	Gregorio-Ramsay
2E	3-6	Gregorio-Muramatsu
2G	3-6	Gregorio-Ramsay-Muramatsu
2B	1-5, 10, 17, 19, 20	Gregorio-Fuller
2D	1-5, 10, 17, 19, 20	Gregorio-Fuller-Ramsay
2F	3-6	Gregorio-Fuller-Muramatsu
2H	3-6	Gregorio-Fuller-Ramsay-Muramatsu

Reference	Date	Section
Alexander (US2013/0237751)	September 12, 2013	§ 102(a)(1)
Cosper (US2008/0246532 A1)	October 9, 2008	§ 102(a)(1)
Gregorio (US7843277)	November 30, 2010	§ 102(a)(1)
Fuller (US2008/0001484 A1)	January 3, 2008	§ 102(a)(1)
Muramatsu (US5952806)	September 14, 1999	§ 102(a)(1)
Ramsay (2008/0294984)	November 27, 2008	§ 102(a)(1)