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Via E-Mail

April 29, 2025

MAYER BROWN LLP
Two Palo Alto Square, Suite 300
3000 El Camino Real
Palo Alto, CA 94306

Re: *ImberaTek LLC v. Apple Inc.*, 3-25-cv-02206 (N.D. Cal.)

Counsel:

Apple Inc. ("Apple") has filed a petition for *inter partes* review (IPR2025-00578) with the Patent Trial and Appeal Board (PTAB) to address the patentability of claims in U.S. Patent 7,989,944 challenged in this proceeding.

Apple hereby stipulates that, in the above captioned litigation, if the PTAB institutes review in this proceeding, Apple will not pursue in District Court litigation the specific grounds asserted in *inter partes* review in this proceeding, or any other ground that could have been reasonably raised in this proceeding (i.e., any ground that could have been raised under §§ 102 or 103 on the basis of prior art patents or printed publications). *See Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020). Apple also stipulates that, in the above captioned litigation, if the PTAB institutes review in this proceeding, Apple will not pursue in District Court litigation combinations of the prior art references asserted as part of a ground in this proceeding, as listed below, with unpublished system prior art or any other type of prior art. *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, IPR2024-01206, IPR2024-01207 & IPR2024-01208, Paper 19 (PTAB Mar. 28, 2025). Accordingly, Apple hereby stipulates that, in the above captioned litigation, if the PTAB institutes review in this proceeding, Apple will not pursue in District Court litigation the combinations of any of the Sakamoto, McCormack, Eiji, Imoto, and Sugaya references asserted as part of the ground of the proceeding with unpublished system prior art or any other type of prior art.

In so stipulating, Apple seeks to avoid multiple proceedings in different forums addressing the validity of the instituted claims based on the same grounds or prior art. The tables in attached Appendix A lists the grounds and references asserted in IPR2025-00578.

For the sake of clarity and to avoid any doubt, if the PTAB declines to institute IPR2025-00578, Apple reserves the right to assert any grounds of invalidity in the District Court proceedings against the '944 Patent.

Sincerely,



Roger A. Denning
Managing Principal

Appendix A – Grounds and Prior Art References

Ground	Claims	§103 Basis
Ground 1A	1-36	Sakamoto-Eiji
Ground 1B	15-31	Sakamoto-Eiji-Imoto
Ground 2A	1-36	McCormack-Eiji
Ground 2B	15-31	McCormack-Eiji-Sugaya

Reference	Date	Pre-AIA Status
Sakamoto(APPLE-1004) JP No. 2001-339165A	Dec. 7, 2001 (published)	§§102(a)/(b)
McCormack(APPLE-1005) U.S. No. 2002/0175402	May 23, 2001 (filed)	§102(e)
Eiji(APPLE-1012) JP No. 2002-016327	Jan. 18, 2002 (published)	§§102(a)/(b)
Imoto(APPLE-1016) JP No. 2001-068624A	Mar. 16, 2001 (published)	§§102(a)/(b)
Sugaya(APPLE-1007) U.S. No. 2001/0030059	Oct. 18, 2001 (published)	§§102(a)/(b)