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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 (IPR2025-00581) with the Patent Trial and Appeal Board (PTAB) to address the patentability of claims in U.S. Patent 8,368,201 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combinations of the prior art references asserted as part of a ground in this proceeding, as listed below, with unpublished system prior art or any other type of prior art.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McCormack, Asahi, Sugaya, Hayashi, and Takayama references asserted as part of the ground of the proceeding with unpublished system prior art or any other type of prior art.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 IPR2025-00581.



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For the sake of clarity and to avoid any doubt, if the PTAB declines to institute IPR2025-00581, Apple reserves the right to assert any grounds of invalidity in the District Court proceedings against the '201 Patent.

Sincerely,

A handwritten signature in black ink, appearing to read "Roger A. Denning". The signature is stylized with a large, looped "R" and a long, sweeping underline.

Roger A. Denning
Managing Principal

Appendix A – Grounds and Prior Art References

Ground	'201 Patent Claims	Basis
1	1	§102 and §103 – Hayashi
2A	1	§102 and §103 – Takayama
2B	1	§103 – Takayama-Hayashi
3A	1	§103 – McCormack
3B	1	§103 – McCormack-Sakamoto
4	1	§102 and §103 – Sakamoto
5A	1	§102 and §103 – Asahi
5B	1	§103 – Asahi-Sakamoto
6	1	§102 and §103 – Sugaya

Reference	Date	Pre-AIA Status
Sakamoto (APPLE-1004) JP No. 2001-339165A	Dec. 7, 2001 (published)	§102(b)
McCormack (APPLE-1005) U.S. No. 2002/0175402	May 23, 2001 (filed)	§102(e)
Asahi (APPLE-1006) U.S. Patent No. 6,489,685	Jan. 3, 2002 (filed)	§102(e)
Sugaya (APPLE-1007) U.S. No. 2001/0030059	Oct. 18, 2001 (published)/Dec. 15, 2000 (filed)	§§102(a)/(b)/(e)
Hayashi (APPLE-1011) JP Patent No. 3207174	Sep. 10, 2001(published)	§§102(a)/(b)
Takayama (APPLE-1027) JP No. 2001-156457	Jun. 8, 2001 (published)	§102(a)/(b)