UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

CARDWARE, INC.,	§	
Plaintiff,	§	
v.	§	Case No. 1:25-cv-00446-ADA
APPLE INC.,	§	**JURY TRIAL DEMANDED**
Defendant.	§	

NOTICE OF SOTERA PLUS STIPULATION OF
DEFENDANT APPLE INC.

Defendant Apple Inc. ("Defendant") filed petitions for *Inter Partes* Review ("IPR") of all patents in this lawsuit with the Patent Trial and Appeal Board of the United States Patent and Trademark Office (the "PTAB"). The following table identifies the IPR proceedings for the six patents asserted in this lawsuit, the date the IPR petitions were filed, the patents involved in the IPR proceeding, and the claims challenged in each IPR proceeding. The claims challenged in these eight IPR proceedings include all of the claims of the corresponding patents that are asserted against Defendant in this litigation.

IPR No.	Patent No.	IPR Petition Filed	Claims Challenged
IPR2025-01145	10,339,520	June 24, 2025	1-17
IPR2025-01146	10,339,520	June 24, 2025	18-24
IPR2025-01147	10,628,820	June 27, 2025	1-20
IPR2025-01148	10,810,579	June 20, 2025	1-23
IPR2025-01149	11,176,538	June 24, 2025	1-18

IPR2025-01150	11,176,538	June 24, 2025	19-30
IPR2025-01151	11,328,286	June 20, 2025	1-27
IPR2025-01152	11,620,634	June 20, 2025	1-72

Defendant hereby notifies the Court and Plaintiff that Defendant is submitting the following broadened *Sotera* stipulation ("*Sotera* Plus stipulation") in connection with each of the IPR petitions identified in the table above. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020) ("*Sotera*") (describing the standard, unbroadened *Sotera* stipulation).

Stipulation for U.S. Patent No. 10,339,520 (IPR2025-01145)

Defendant hereby stipulates, broader than the stipulation made by the Petitioner in *Sotera*, that if the PTAB institutes an IPR (and does not subsequently vacate institution) in response to Defendant's petition against Plaintiff's U.S. Patent No. 10,339,520 (IPR2025-01145), Defendant will not pursue in this litigation:

(i) the specific grounds raised in IPR2025-01145,

(ii) any other grounds that could have reasonably been raised before the PTAB in that instituted proceeding (i.e., any ground that could have reasonably been raised under §§ 102 or 103 on the basis of prior art patents or printed publications),

(iii) any ground based on a combination of system prior art and the references asserted as part of a ground raised in IPR2025-01145, as reflected in the table summarizing the Statutory Grounds for Challenges on page 5 of the Petition, or

(iv) any ground based on a system which corresponds to a patent or printed publication asserted as part of a ground raised in IPR2025-01145.

Notwithstanding the above and for the avoidance of doubt, this stipulation does not limit Apple's ability to rely on its own products and systems as prior art in the litigation, including to demonstrate that Apple invented the claimed subject matter first under 35 U.S.C. §102(g), nor does it limit Apple's ability to rely on any patents or patent publications assigned to Apple as evidence of Apple's prior invention. Likewise, this stipulation does not limit Apple's ability to demonstrate that the '520 Patent claims are invalid based on Apple's own products and systems being in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

In the IPR, Apple does not and cannot raise a §102(g) defense. In the IPR, Apple likewise was not permitted to raise any grounds based on its own products or systems being in public use, on sale, or otherwise available to the public. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367 (Fed. Cir. 2025) (recognizing that assertions "that a claimed invention was known or used by others, on sale, or in public use…could not be raised during an IPR."). Therefore, there will be no overlap between the issues raised in the Petition and the district court, and the IPRs will serve as a "true alternative" to the district court proceeding for those invalidity issues which can be raised in an IPR proceeding.

Stipulation for U.S. Patent No. 10,339,520 (IPR2025-01146)

Defendant hereby stipulates, broader than the stipulation made by the Petitioner in *Sotera*, that if the PTAB institutes an IPR (and does not subsequently vacate institution) in response to Defendant's petition against Plaintiff's U.S. Patent No. 10,339,520 (IPR2025-01146), Defendant will not pursue in this litigation:

(i) the specific grounds raised in IPR2025-01146,

(ii) any other grounds that could have reasonably been raised before the PTAB in that

instituted proceeding (i.e., any ground that could have reasonably been raised under §§ 102 or 103 on the basis of prior art patents or printed publications),

(iii) any ground based on a combination of system prior art and the references asserted as part of a ground raised in IPR2025-01146, as reflected in the table summarizing the Statutory Grounds for Challenges on page 6 of the Petition, or

(iv) any ground based on a system which corresponds to a patent or printed publication asserted as part of a ground raised in IPR2025-01146.

Notwithstanding the above and for the avoidance of doubt, this stipulation does not limit Apple's ability to rely on its own products and systems as prior art in the litigation, including to demonstrate that Apple invented the claimed subject matter first under 35 U.S.C. §102(g), nor does it limit Apple's ability to rely on any patents or patent publications assigned to Apple as evidence of Apple's prior invention. Likewise, this stipulation does not limit Apple's ability to demonstrate that the '520 Patent claims are invalid based on Apple's own products and systems being in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

In the IPR, Apple does not and cannot raise a §102(g) defense. In the IPR, Apple likewise was not permitted to raise any grounds based on its own products or systems being in public use, on sale, or otherwise available to the public. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367 (Fed. Cir. 2025) (recognizing that assertions "that a claimed invention was known or used by others, on sale, or in public use…could not be raised during an IPR."). Therefore, there will be no overlap between the issues raised in the Petition and the district court, and the IPRs will serve as a "true alternative" to the district court proceeding for those invalidity issues which can be raised in an IPR proceeding.

Stipulation for U.S. Patent No. 10,628,820 (IPR2025-01147)

Defendant hereby stipulates, broader than the stipulation made by the Petitioner in *Sotera*, that if the PTAB institutes an IPR (and does not subsequently vacate institution) in response to Defendant's petition against Plaintiff's U.S. Patent No. 10,628,820 (IPR2025-01147), Defendant will not pursue in this litigation:

(i) the specific grounds raised in IPR2025-01147,

(ii) any other grounds that could have reasonably been raised before the PTAB in that instituted proceeding (i.e., any ground that could have reasonably been raised under §§ 102 or 103 on the basis of prior art patents or printed publications),

(iii) any ground based on a combination of system prior art and the references asserted as part of a ground raised in IPR2025-01147, as reflected in the table summarizing the Statutory Grounds for Challenges on pages 3-4 of the Petition, or

(iv) any ground based on a system which corresponds to a patent or printed publication asserted as part of a ground raised in IPR2025-01147.

Notwithstanding the above and for the avoidance of doubt, this stipulation does not limit Apple's ability to rely on its own products and systems as prior art in the litigation, including to demonstrate that Apple invented the claimed subject matter first under 35 U.S.C. §102(g), nor does it limit Apple's ability to rely on any patents or patent publications assigned to Apple as evidence of Apple's prior invention. Likewise, this stipulation does not limit Apple's ability to demonstrate that the '820 Patent claims are invalid based on Apple's own products and systems being in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

In the IPR, Apple does not and cannot raise a §102(g) defense. In the IPR, Apple likewise was not permitted to raise any grounds based on its own products or systems being in public use, on sale, or otherwise available to the public. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367 (Fed. Cir. 2025) (recognizing that assertions "that a claimed invention was known or used by others, on sale, or in public use…could not be raised during an IPR."). Therefore, there will be no overlap between the issues raised in the Petition and the district court, and the IPRs will serve as a "true alternative" to the district court proceeding for those invalidity issues which can be raised in an IPR proceeding.

Stipulation for U.S. Patent No. 10,810,579 (IPR2025-01148)

Defendant hereby stipulates, broader than the stipulation made by the Petitioner in *Sotera*, that if the PTAB institutes an IPR (and does not subsequently vacate institution) in response to Defendant's petition against Plaintiff's U.S. Patent No. 10,810,579 (IPR2025-01148), Defendant will not pursue in this litigation:

(i) the specific grounds raised in IPR2025-01148,

(ii) any other grounds that could have reasonably been raised before the PTAB in that instituted proceeding (i.e., any ground that could have reasonably been raised under §§ 102 or 103 on the basis of prior art patents or printed publications),

(iii) any ground based on a combination of system prior art and the references asserted as part of a ground raised in IPR2025-01148, as reflected in the table summarizing the Statutory Grounds for Challenges on page 3 of the Petition, or

(iv) any ground based on a system which corresponds to a patent or printed publication asserted as part of a ground raised in IPR2025-01148.

Notwithstanding the above and for the avoidance of doubt, this stipulation does not limit Apple's ability to rely on its own products and systems as prior art in the litigation, including to demonstrate that Apple invented the claimed subject matter first under 35 U.S.C. §102(g), nor does it limit Apple's ability to rely on any patents or patent publications assigned to Apple as evidence of Apple's prior invention. Likewise, this stipulation does not limit Apple's ability to demonstrate that the '579 Patent claims are invalid based on Apple's own products and systems being in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

In the IPR, Apple does not and cannot raise a §102(g) defense. In the IPR, Apple likewise was not permitted to raise any grounds based on its own products or systems being in public use, on sale, or otherwise available to the public. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367 (Fed. Cir. 2025) (recognizing that assertions "that a claimed invention was known or used by others, on sale, or in public use…could not be raised during an IPR."). Therefore, there will be no overlap between the issues raised in the Petition and the district court, and the IPRs will serve as a "true alternative" to the district court proceeding for those invalidity issues which can be raised in an IPR proceeding.

Stipulation for U.S. Patent No. 11,176,538 (IPR2025-01149)

Defendant hereby stipulates, broader than the stipulation made by the Petitioner in *Sotera*, that if the PTAB institutes an IPR (and does not subsequently vacate institution) in response to Defendant's petition against Plaintiff's U.S. Patent No. 11,176,538 (IPR2025-01149), Defendant will not pursue in this litigation:

(i) the specific grounds raised in IPR2025-01149,

(ii) any other grounds that could have reasonably been raised before the PTAB in that

instituted proceeding (i.e., any ground that could have reasonably been raised under §§ 102 or 103 on the basis of prior art patents or printed publications),

(iii) any ground based on a combination of system prior art and the references asserted as part of a ground raised in IPR2025-01149, as reflected in the table summarizing the Statutory Grounds for Challenges on page 4 of the Petition, or

(iv) any ground based on a system which corresponds to a patent or printed publication asserted as part of a ground raised in IPR2025-01149.

Notwithstanding the above and for the avoidance of doubt, this stipulation does not limit Apple's ability to rely on its own products and systems as prior art in the litigation, including to demonstrate that Apple invented the claimed subject matter first under 35 U.S.C. §102(g), nor does it limit Apple's ability to rely on any patents or patent publications assigned to Apple as evidence of Apple's prior invention. Likewise, this stipulation does not limit Apple's ability to demonstrate that the '538 Patent claims are invalid based on Apple's own products and systems being in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

In the IPR, Apple does not and cannot raise a §102(g) defense. In the IPR, Apple likewise was not permitted to raise any grounds based on its own products or systems being in public use, on sale, or otherwise available to the public. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367 (Fed. Cir. 2025) (recognizing that assertions "that a claimed invention was known or used by others, on sale, or in public use…could not be raised during an IPR."). Therefore, there will be no overlap between the issues raised in the Petition and the district court, and the IPRs will serve as a "true alternative" to the district court proceeding for those invalidity issues which can be raised in an IPR proceeding.

Stipulation for U.S. Patent No. IPR2025-01150

Defendant hereby stipulates, broader than the stipulation made by the Petitioner in *Sotera*, that if the PTAB institutes an IPR (and does not subsequently vacate institution) in response to Defendant's petition against Plaintiff's U.S. Patent No. 11,176,538 (IPR2025-01150), Defendant will not pursue in this litigation:

(i) the specific grounds raised in IPR2025-01150,

(ii) any other grounds that could have reasonably been raised before the PTAB in that instituted proceeding (i.e., any ground that could have reasonably been raised under §§ 102 or 103 on the basis of prior art patents or printed publications),

(iii) any ground based on a combination of system prior art and the references asserted as part of a ground raised in IPR2025-01150, as reflected in the table summarizing the Statutory Grounds for Challenges on pages 3-4 of the Petition, or

(iv) any ground based on a system which corresponds to a patent or printed publication asserted as part of a ground raised in IPR2025-01150.

Notwithstanding the above and for the avoidance of doubt, this stipulation does not limit Apple's ability to rely on its own products and systems as prior art in the litigation, including to demonstrate that Apple invented the claimed subject matter first under 35 U.S.C. §102(g), nor does it limit Apple's ability to rely on any patents or patent publications assigned to Apple as evidence of Apple's prior invention. Likewise, this stipulation does not limit Apple's ability to demonstrate that the '538 Patent claims are invalid based on Apple's own products and systems being in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

In the IPR, Apple does not and cannot raise a §102(g) defense. In the IPR, Apple likewise

was not permitted to raise any grounds based on its own products or systems being in public use, on sale, or otherwise available to the public. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367 (Fed. Cir. 2025) (recognizing that assertions "that a claimed invention was known or used by others, on sale, or in public use…could not be raised during an IPR."). Therefore, there will be no overlap between the issues raised in the Petition and the district court, and the IPRs will serve as a "true alternative" to the district court proceeding for those invalidity issues which can be raised in an IPR proceeding.

Stipulation for U.S. Patent No. IPR2025-01151

Defendant hereby stipulates, broader than the stipulation made by the Petitioner in *Sotera*, that if the PTAB institutes an IPR (and does not subsequently vacate institution) in response to Defendant's petition against Plaintiff's U.S. Patent No. 11,328,286 (IPR2025-01151), Defendant will not pursue in this litigation:

(i) the specific grounds raised in IPR2025-01151,

(ii) any other grounds that could have reasonably been raised before the PTAB in that instituted proceeding (i.e., any ground that could have reasonably been raised under §§ 102 or 103 on the basis of prior art patents or printed publications),

(iii) any ground based on a combination of system prior art and the references asserted as part of a ground raised in IPR2025-01151, as reflected in the table summarizing the Statutory Grounds for Challenges on page 4 of the Petition, or

(iv) any ground based on a system which corresponds to a patent or printed publication asserted as part of a ground raised in IPR2025-01151.

Notwithstanding the above and for the avoidance of doubt, this stipulation does not limit Apple's ability to rely on its own products and systems as prior art in the litigation, including to demonstrate

that Apple invented the claimed subject matter first under 35 U.S.C. §102(g), nor does it limit Apple's ability to rely on any patents or patent publications assigned to Apple as evidence of Apple's prior invention. Likewise, this stipulation does not limit Apple's ability to demonstrate that the '286 Patent claims are invalid based on Apple's own products and systems being in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

In the IPR, Apple does not and cannot raise a §102(g) defense. In the IPR, Apple likewise was not permitted to raise any grounds based on its own products or systems being in public use, on sale, or otherwise available to the public. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367 (Fed. Cir. 2025) (recognizing that assertions "that a claimed invention was known or used by others, on sale, or in public use…could not be raised during an IPR."). Therefore, there will be no overlap between the issues raised in the Petition and the district court, and the IPRs will serve as a "true alternative" to the district court proceeding for those invalidity issues which can be raised in an IPR proceeding.

Stipulation for U.S. Patent No. IPR2025-01152

Defendant hereby stipulates, broader than the stipulation made by the Petitioner in *Sotera*, that if the PTAB institutes an IPR (and does not subsequently vacate institution) in response to Defendant's petition against Plaintiff's U.S. Patent No. 11,620,634 (IPR2025-01152), Defendant will not pursue in this litigation:

(i) the specific grounds raised in IPR2025-01152,

(ii) any other grounds that could have reasonably been raised before the PTAB in that instituted proceeding (i.e., any ground that could have reasonably been raised under §§ 102 or 103 on the basis of prior art patents or printed publications),

(iii) any ground based on a combination of system prior art and the references asserted as part of a ground raised in IPR2025-01152, as reflected in the table summarizing the Statutory Grounds for Challenges on page 3 of the Petition, or

(iv) any ground based on a system which corresponds to a patent or printed publication asserted as part of a ground raised in IPR2025-01152.

Notwithstanding the above and for the avoidance of doubt, this stipulation does not limit Apple's ability to rely on its own products and systems as prior art in the litigation, including to demonstrate that Apple invented the claimed subject matter first under 35 U.S.C. §102(g), nor does it limit Apple's ability to rely on any patents or patent publications assigned to Apple as evidence of Apple's prior invention. Likewise, this stipulation does not limit Apple's ability to demonstrate that the '634 Patent claims are invalid based on Apple's own products and systems being in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

In the IPR, Apple does not and cannot raise a §102(g) defense. In the IPR, Apple likewise was not permitted to raise any grounds based on its own products or systems being in public use, on sale, or otherwise available to the public. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367 (Fed. Cir. 2025) (recognizing that assertions "that a claimed invention was known or used by others, on sale, or in public use…could not be raised during an IPR."). Therefore, there will be no overlap between the issues raised in the Petition and the district court, and the IPRs will serve as a "true alternative" to the district court proceeding for those invalidity issues which can be raised in an IPR proceeding.

Defendant's *Sotera* Plus stipulations above are not intended and should not be construed to limit Defendant's ability to assert invalidity of any claims of the patents asserted in this lawsuit

based on any other ground.

Date: August 13, 2025

Respectfully submitted,

/s/ John M. Guaragna

John M. Guaragna
Texas Bar No 24043308
Nandan R. Padmanabhan
Texas Bar No. 24145172
Zachary Loney
Texas Bar No. 24092714
Michael Saulnier
Texas Bar No. 24131647
DLA PIPER LLP (US)
303 Colorado, Suite 3000
Austin, TX 78701
Tel: (512) 457-7125
Fax: (512) 457-7001
john.guaragna@us.dlapiper.com
nandan.padmanabhan@us.dlapiper.com
zachary.loney@us.dlapiper.com

Sean Cunningham
Erin Gibson
DLA PIPER LLP (US)
500 Eighth Street NW
Washington, DC 20004
Tel: (202) 799-4000
Fax: (202) 799-5000
sean.cunningham@us.dlapiper.com
erin.gibson@us.dlapiper.com

Robert Williams
Peter Maggiore
DLA PIPER LLP (US)
4365 Executive Drive, Suite 1100
San Diego, CA 92121
Tel: (858) 677-1400
Fax: (858) 677-1401
robert.williams@us.dlapiper.com
peter.maggiore@us.dlapiper.com

Benjamin Yaghoubian
Martin M. Ellison *(Pro Hac Vice)*
DLA PIPER LLP (US)

2000 Avenue of the Stars
Suite 400, North Tower
Los Angeles, CA 90067
Tel: (310) 595-3000
Fax: (310) 595-3300
benjamin.yaghoubian@us.dlapiper.com
martin.ellison@us.dlapiper.com

Ahimsa E. Hodari
Texas Bar No. 24132415
DLA PIPER LLP (US)
845 Texas Avenue, Suite 3800
Houston, TX 77002
Tel: 713.425.8400
Fax: 713.425.8401
ahimsa.hodari@us.dlapiper.com

Mary C. Dahl *(Pro Hac Vice)*
DLA Piper LLP (US)
3203 Hanover St., Suite 100
Palo Alto, CA 94304
Tel: (650) 833-2000
Fax: (650) 833-2001

ATTORNEYS FOR DEFENDANT APPLE INC.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on August 13, 2025, to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system per Local Rule CV-5. Any other counsel of record will be served by a facsimile and/or first-class mail.

/s/ *John M. Guaragna*
John M. Guaragna