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Counsel for Defendant Apple Inc.

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION**

TELCOM VENTURES LLC,

Plaintiff,

v.

APPLE INC.,

Defendant.

Case No. 5:25-cv-05041

**NOTICE OF SOTERA PLUS
STIPULATION OF DEFENDANT APPLE
INC.**

JURY TRIAL DEMANDED

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 eight 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
IPR2025-01232	9,462,411	August 5, 2025	1-4
IPR2025-01233	9,832,708	August 5, 2025	1-19
IPR2025-01234	10,219,199	August 5, 2025	1-19
IPR2025-01235	10,674,432	August 5, 2025	1-17
IPR2025-01236	11,770,756	August 5, 2025	1-18
IPR2025-01237	11,924,743	August 5, 2025	1-14
IPR2025-01238	11,937,172	August 5, 2025	1-16
IPR2025-01239	12,028,793	August 5, 2025	1-11

Defendant hereby notifies the Court and Plaintiff that Defendant is submitting the following broadened *Sotera* stipulation (“*Sotera* Plus stipulation”) in connection with 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). The stipulation for each patent and corresponding IPR petition is identical.

Stipulation for U.S. Patent No. 9,462,411 (IPR2025-01232)

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

1 Defendant's petition against Plaintiff's U.S. Patent No. 9,462,411 (IPR2025-01232), Defendant will
2 not pursue in this litigation:

- 3 (i) the specific grounds raised in IPR2025-01232,
4 (ii) any other grounds that could have reasonably been raised before the PTAB in that
5 instituted proceeding (i.e., any ground that could have reasonably been raised under
6 §§ 102 or 103 on the basis of prior art patents or printed publications),
7 (iii) any ground based on a combination of system prior art and the references asserted
8 as part of a ground raised in IPR2025-01232, as reflected in the table summarizing
9 the Statutory Grounds for Challenges on page 19 of the Petition, or
10 (iv) any ground based on a system which corresponds to a patent or printed publication
11 asserted as part of a ground raised in IPR2025-01232.
12

13 Notwithstanding the above and for the avoidance of doubt, this stipulation does not limit Apple's
14 ability to rely on its own products and systems as prior art in the litigation, including to demonstrate
15 that Apple invented the claimed subject matter first under 35 U.S.C. §102(g), nor does it limit
16 Apple's ability to rely on any patents or patent publications assigned to Apple as evidence of Apple's
17 prior invention. Likewise, this stipulation does not limit Apple's ability to demonstrate that the '411
18 Patent claims are invalid based on Apple's own products and systems being in public use, on sale,
19 or otherwise available to the public before the effective filing date of the claimed invention.
20

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

Stipulation for U.S. Patent No. 9,832,708 (IPR2025-01233)

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. 9,832,708 (IPR2025-01233), Defendant will not pursue in this litigation:

- (i) the specific grounds raised in IPR2025-01233,
- (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 IPR2025-01233, as reflected in the table summarizing the Statutory Grounds for Challenges on page 14 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 IPR2025-01233.

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 ’708 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

1 was not permitted to raise any grounds based on its own products or systems being in public use, on
 2 sale, or otherwise available to the public. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367
 3 (Fed. Cir. 2025) (recognizing that assertions “that a claimed invention was known or used by others,
 4 on sale, or in public use...could not be raised during an IPR.”). Therefore, there will be no overlap
 5 between the issues raised in the Petition and the district court, and the IPRs will serve as a “true
 6 alternative” to the district court proceeding for those invalidity issues which can be raised in an IPR
 7 proceeding.
 8

9 **Stipulation for U.S. Patent No. 10,219,199 (IPR2025-01234)**

10 Defendant hereby stipulates, broader than the stipulation made by the Petitioner in *Sotera*,
 11 that if the PTAB institutes an IPR (and does not subsequently vacate institution) in response to
 12 Defendant’s petition against Plaintiff’s U.S. Patent No. 10,219,199 (IPR2025-01234), Defendant
 13 will not pursue in this litigation:
 14

- 15 (i) the specific grounds raised in IPR2025-01234,
- 16 (ii) any other grounds that could have reasonably been raised before the PTAB in that
 17 instituted proceeding (i.e., any ground that could have reasonably been raised under
 18 §§ 102 or 103 on the basis of prior art patents or printed publications),
- 19 (iii) any ground based on a combination of system prior art and the references asserted
 20 as part of a ground raised in IPR2025-01234, as reflected in the table summarizing
 21 the Statutory Grounds for Challenges on pages 19-20 of the Petition, or
 22
- 23 (iv) any ground based on a system which corresponds to a patent or printed publication
 24 asserted as part of a ground raised in IPR2025-01234.

25 Notwithstanding the above and for the avoidance of doubt, this stipulation does not limit Apple’s
 26 ability to rely on its own products and systems as prior art in the litigation, including to demonstrate
 27 that Apple invented the claimed subject matter first under 35 U.S.C. §102(g), nor does it limit
 28

1 Apple's ability to rely on any patents or patent publications assigned to Apple as evidence of Apple's
2 prior invention. Likewise, this stipulation does not limit Apple's ability to demonstrate that the '199
3 Patent claims are invalid based on Apple's own products and systems being in public use, on sale,
4 or otherwise available to the public before the effective filing date of the claimed invention.

5 In the IPR, Apple does not and cannot raise a §102(g) defense. In the IPR, Apple likewise
6 was not permitted to raise any grounds based on its own products or systems being in public use, on
7 sale, or otherwise available to the public. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367
8 (Fed. Cir. 2025) (recognizing that assertions "that a claimed invention was known or used by others,
9 on sale, or in public use...could not be raised during an IPR."). Therefore, there will be no overlap
10 between the issues raised in the Petition and the district court, and the IPRs will serve as a "true
11 alternative" to the district court proceeding for those invalidity issues which can be raised in an IPR
12 proceeding.
13

14
15 **Stipulation for U.S. Patent No. 10,674,432 (IPR2025-01235)**

16 Defendant hereby stipulates, broader than the stipulation made by the Petitioner in *Sotera*,
17 that if the PTAB institutes an IPR (and does not subsequently vacate institution) in response to
18 Defendant's petition against Plaintiff's U.S. Patent No. 10,674,432 (IPR2025-01235), Defendant
19 will not pursue in this litigation:

- 20 (i) the specific grounds raised in IPR2025-01235,
21
22 (ii) any other grounds that could have reasonably been raised before the PTAB in that
23 instituted proceeding (i.e., any ground that could have reasonably been raised under
24 §§ 102 or 103 on the basis of prior art patents or printed publications),
25 (iii) any ground based on a combination of system prior art and the references asserted
26 as part of a ground raised in IPR2025-01235, as reflected in the table summarizing
27 the Statutory Grounds for Challenges on pages 23-24 of the Petition, or
28

- 1 (iv) any ground based on a system which corresponds to a patent or printed publication
2 asserted as part of a ground raised in IPR2025-01235.

3 Notwithstanding the above and for the avoidance of doubt, this stipulation does not limit Apple's
4 ability to rely on its own products and systems as prior art in the litigation, including to demonstrate
5 that Apple invented the claimed subject matter first under 35 U.S.C. §102(g), nor does it limit
6 Apple's ability to rely on any patents or patent publications assigned to Apple as evidence of Apple's
7 prior invention. Likewise, this stipulation does not limit Apple's ability to demonstrate that the '432
8 Patent claims are invalid based on Apple's own products and systems being in public use, on sale,
9 or otherwise available to the public before the effective filing date of the claimed invention.
10

11 In the IPR, Apple does not and cannot raise a §102(g) defense. In the IPR, Apple likewise
12 was not permitted to raise any grounds based on its own products or systems being in public use, on
13 sale, or otherwise available to the public. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367
14 (Fed. Cir. 2025) (recognizing that assertions "that a claimed invention was known or used by others,
15 on sale, or in public use...could not be raised during an IPR."). Therefore, there will be no overlap
16 between the issues raised in the Petition and the district court, and the IPRs will serve as a "true
17 alternative" to the district court proceeding for those invalidity issues which can be raised in an IPR
18 proceeding.
19

20 **Stipulation for U.S. Patent No. 11,770,756 (IPR2025-01236)**

21 Defendant hereby stipulates, broader than the stipulation made by the Petitioner in *Sotera*,
22 that if the PTAB institutes an IPR (and does not subsequently vacate institution) in response to
23 Defendant's petition against Plaintiff's U.S. Patent No. 11,770,756 (IPR2025-01236), Defendant
24 will not pursue in this litigation:
25

- 26 (i) the specific grounds raised in IPR2025-01236,
27 (ii) any other grounds that could have reasonably been raised before the PTAB in that
28

1 instituted proceeding (i.e., any ground that could have reasonably been raised under
2 §§ 102 or 103 on the basis of prior art patents or printed publications),

3 (iii) any ground based on a combination of system prior art and the references asserted
4 as part of a ground raised in IPR2025-01236, as reflected in the table summarizing
5 the Statutory Grounds for Challenges on pages 18-19 of the Petition, or
6

7 (iv) any ground based on a system which corresponds to a patent or printed publication
8 asserted as part of a ground raised in IPR2025-01236.

9 Notwithstanding the above and for the avoidance of doubt, this stipulation does not limit Apple's
10 ability to rely on its own products and systems as prior art in the litigation, including to demonstrate
11 that Apple invented the claimed subject matter first under 35 U.S.C. §102(g), nor does it limit
12 Apple's ability to rely on any patents or patent publications assigned to Apple as evidence of Apple's
13 prior invention. Likewise, this stipulation does not limit Apple's ability to demonstrate that the '756
14 Patent claims are invalid based on Apple's own products and systems being in public use, on sale,
15 or otherwise available to the public before the effective filing date of the claimed invention.
16

17 In the IPR, Apple does not and cannot raise a §102(g) defense. In the IPR, Apple likewise
18 was not permitted to raise any grounds based on its own products or systems being in public use, on
19 sale, or otherwise available to the public. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367
20 (Fed. Cir. 2025) (recognizing that assertions "that a claimed invention was known or used by others,
21 on sale, or in public use...could not be raised during an IPR."). Therefore, there will be no overlap
22 between the issues raised in the Petition and the district court, and the IPRs will serve as a "true
23 alternative" to the district court proceeding for those invalidity issues which can be raised in an IPR
24 proceeding.
25

26 **Stipulation for U.S. Patent No. 11,924,743 (IPR2025-01237)**

27 Defendant hereby stipulates, broader than the stipulation made by the Petitioner in *Sotera*,
28

1 that if the PTAB institutes an IPR (and does not subsequently vacate institution) in response to
 2 Defendant's petition against Plaintiff's U.S. Patent No. 11,924,743 (IPR2025-01237), Defendant
 3 will not pursue in this litigation:

- 4 (i) the specific grounds raised in IPR2025-01237,
- 5 (ii) any other grounds that could have reasonably been raised before the PTAB in that
 6 instituted proceeding (i.e., any ground that could have reasonably been raised under
 7 §§ 102 or 103 on the basis of prior art patents or printed publications),
 8
- 9 (iii) any ground based on a combination of system prior art and the references asserted
 10 as part of a ground raised in IPR2025-01237, as reflected in the table summarizing
 11 the Statutory Grounds for Challenges on pages 18-19 of the Petition, or
 12
- 13 (iv) any ground based on a system which corresponds to a patent or printed publication
 14 asserted as part of a ground raised in IPR2025-01237.

15 Notwithstanding the above and for the avoidance of doubt, this stipulation does not limit Apple's
 16 ability to rely on its own products and systems as prior art in the litigation, including to demonstrate
 17 that Apple invented the claimed subject matter first under 35 U.S.C. §102(g), nor does it limit
 18 Apple's ability to rely on any patents or patent publications assigned to Apple as evidence of Apple's
 19 prior invention. Likewise, this stipulation does not limit Apple's ability to demonstrate that the '743
 20 Patent claims are invalid based on Apple's own products and systems being in public use, on sale,
 21 or otherwise available to the public before the effective filing date of the claimed invention.
 22

23 In the IPR, Apple does not and cannot raise a §102(g) defense. In the IPR, Apple likewise
 24 was not permitted to raise any grounds based on its own products or systems being in public use, on
 25 sale, or otherwise available to the public. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367
 26 (Fed. Cir. 2025) (recognizing that assertions "that a claimed invention was known or used by others,
 27 on sale, or in public use...could not be raised during an IPR."). Therefore, there will be no overlap
 28

1 between the issues raised in the Petition and the district court, and the IPRs will serve as a “true
2 alternative” to the district court proceeding for those invalidity issues which can be raised in an IPR
3 proceeding.

4 **Stipulation for U.S. Patent No. 11,937,172 (IPR2025-01238)**

5 Defendant hereby stipulates, broader than the stipulation made by the Petitioner in *Sotera*,
6 that if the PTAB institutes an IPR (and does not subsequently vacate institution) in response to
7 Defendant’s petition against Plaintiff’s U.S. Patent No. 11,937,172 (IPR2025-01238), Defendant
8 will not pursue in this litigation:
9

- 10 (i) the specific grounds raised in IPR2025-01238,
11 (ii) any other grounds that could have reasonably been raised before the PTAB in that
12 instituted proceeding (i.e., any ground that could have reasonably been raised under
13 §§ 102 or 103 on the basis of prior art patents or printed publications),
14 (iii) any ground based on a combination of system prior art and the references asserted
15 as part of a ground raised in IPR2025-01238, as reflected in the table summarizing
16 the Statutory Grounds for Challenges on pages 17-18 of the Petition, or
17 (iv) any ground based on a system which corresponds to a patent or printed publication
18 asserted as part of a ground raised in IPR2025-01238.
19

20 Notwithstanding the above and for the avoidance of doubt, this stipulation does not limit Apple’s
21 ability to rely on its own products and systems as prior art in the litigation, including to demonstrate
22 that Apple invented the claimed subject matter first under 35 U.S.C. §102(g), nor does it limit
23 Apple’s ability to rely on any patents or patent publications assigned to Apple as evidence of Apple’s
24 prior invention. Likewise, this stipulation does not limit Apple’s ability to demonstrate that the ’172
25 Patent claims are invalid based on Apple’s own products and systems being in public use, on sale,
26 or otherwise available to the public before the effective filing date of the claimed invention.
27
28

1 In the IPR, Apple does not and cannot raise a §102(g) defense. In the IPR, Apple likewise
2 was not permitted to raise any grounds based on its own products or systems being in public use, on
3 sale, or otherwise available to the public. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367
4 (Fed. Cir. 2025) (recognizing that assertions “that a claimed invention was known or used by others,
5 on sale, or in public use...could not be raised during an IPR.”). Therefore, there will be no overlap
6 between the issues raised in the Petition and the district court, and the IPRs will serve as a “true
7 alternative” to the district court proceeding for those invalidity issues which can be raised in an IPR
8 proceeding.
9

10 **Stipulation for U.S. Patent No. 12,028,793 (IPR2025-01239)**

11 Defendant hereby stipulates, broader than the stipulation made by the Petitioner in *Sotera*,
12 that if the PTAB institutes an IPR (and does not subsequently vacate institution) in response to
13 Defendant’s petition against Plaintiff’s U.S. Patent No. 12,028,793 (IPR2025-01239), Defendant
14 will not pursue in this litigation:
15

- 16 (i) the specific grounds raised in IPR2025-01239,
- 17 (ii) any other grounds that could have reasonably been raised before the PTAB in that
18 instituted proceeding (i.e., any ground that could have reasonably been raised under
19 §§ 102 or 103 on the basis of prior art patents or printed publications),
20 (iii) any ground based on a combination of system prior art and the references asserted
21 as part of a ground raised in IPR2025-01239, as reflected in the table summarizing
22 the Statutory Grounds for Challenges on pages 19-20 of the Petition, or
23 (iv) any ground based on a system which corresponds to a patent or printed publication
24 asserted as part of a ground raised in IPR2025-01239.
25

26 Notwithstanding the above and for the avoidance of doubt, this stipulation does not limit Apple’s
27 ability to rely on its own products and systems as prior art in the litigation, including to demonstrate
28

1 that Apple invented the claimed subject matter first under 35 U.S.C. §102(g), nor does it limit
 2 Apple's ability to rely on any patents or patent publications assigned to Apple as evidence of Apple's
 3 prior invention. Likewise, this stipulation does not limit Apple's ability to demonstrate that the '793
 4 Patent claims are invalid based on Apple's own products and systems being in public use, on sale,
 5 or otherwise available to the public before the effective filing date of the claimed invention.
 6

7 In the IPR, Apple does not and cannot raise a §102(g) defense. In the IPR, Apple likewise
 8 was not permitted to raise any grounds based on its own products or systems being in public use, on
 9 sale, or otherwise available to the public. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367
 10 (Fed. Cir. 2025) (recognizing that assertions "that a claimed invention was known or used by others,
 11 on sale, or in public use...could not be raised during an IPR."). Therefore, there will be no overlap
 12 between the issues raised in the Petition and the district court, and the IPRs will serve as a "true
 13 alternative" to the district court proceeding for those invalidity issues which can be raised in an IPR
 14 proceeding.
 15

16 Defendant's *Sotera Plus* stipulations above are not intended and should not be construed to
 17 limit Defendant's ability to assert invalidity of any claims of the patents asserted in this lawsuit
 18 based on any other ground.
 19

20 Dated: September 4, 2025

/s/ Peter C. Magic

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Peter C. Magic (CA SBN 278917)

Kevin J. Gu (CA SBN 335053)

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4 Asim H. Zaidi (admitted *pro hac vice*)
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Counsel for Defendant Apple Inc.

CERTIFICATE OF SERVICE

The undersigned certifies that on September 4, 2025, a true and correct copy of the foregoing instrument was electronically filed with the Clerk of the Court by using the CM/ECF system, which shall send notification of such filing to all counsel of record at their email address on file with the Court.

/s/ Peter C. Magic
Peter C. Magic