

September 2, 2020

VIA E-MAIL

Joseph R. Re
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Re: Masimo Corporation et al. v. Apple Inc., Case No. 8:20-cv-00048 (C.D. Cal.)

Dear Counsel:

We write regarding a petition for *inter partes* review (IPR) being filed with the Patent Trial and Appeal Board (PTAB) to address claims of U.S. Patent No. 10,292,628. The table below lists grounds asserted by Apple in an IPR petition challenging claims of this patent, along with the implicated claims against which each ground is asserted. We write to inform you that Apple hereby stipulates that in the event the PTAB institutes an *inter partes* review including a ground listed in the table against the corresponding claims listed in the table for that ground (“Instituted Ground”), Apple will not assert that Instituted Ground against the corresponding claims listed in the table for that ground in the above captioned litigation (8:20-cv-00048).

Patent No.	Proceeding No.	Claims	Grounds
10,292,628	IPR2020-01521	1-15, 17, 20-26, 28	Aizawa in view of Inokawa
		1-15, 17, 20-26, 28	Aizawa in view of Inokawa and Ohsaki
		18, 19, 29, 30	Aizawa in view of Inokawa, Mendelson-2006, and Beyer
		18, 19, 29, 20	Aizawa in view of Inokawa, Goldsmith, and Lo

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Patent No.	Proceeding No.	Claims	Grounds
		1-17, 20-28	Mendelson-1988 in view of Inokawa
		18, 19, 29, 30	Mendelson-1988 in view of Inokawa, Mendelson-2006, and Beyer

In so stipulating, Apple seeks to avoid multiple proceedings addressing the validity of these claims based on the Instituted Grounds. Rather, consistent with Congressional intent, through this stipulation, Apple expresses its intention to have only the PTAB address the Instituted Grounds of invalidity of these claims. But, for the sake of clarity and to avoid any doubt, if the PTAB declines to institute any of the grounds identified herein, Apple reserves the right to assert such grounds in this litigation. Additionally, even in the event of institution, Apple reserves its rights to continue to assert all grounds other than Instituted Grounds.

Sincerely,



Brian Rosenthal

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Appendix – Prior Art References Used in the Listed Grounds

Reference Name	Details
Aizawa	U.S. Pub. No. 2002/0188210
Inokawa	JP 2006-296564
Ohsaki	U.S. Pub. No. 2001/0056243
Mendelson-1988	“Design and Evaluation of a New Reflectance Pulse Oximeter Sensor,” Y. Mendelson, et al.; Worcester Polytechnic Institute, Biomedical Engineering Program, Worcester, MA 01609; Association for the Advancement of Medical Instrumentation, vol. 22, No. 4, 1988; pp. 167-173
Mendelson-2006	“A Wearable Reflectance Pulse Oximeter for Remote Physiological Monitoring,” Y. Mendelson, et al.; Proceedings of the 28th IEEE EMBS Annual International Conference, 2006; pp. 912-915
Beyer	U.S. Pat. No. 7,031,728
Goldsmith	U.S. Pub. No. 2007/0093786
Lo	U.S. Pub. No. 2004/0138568