

September 8, 2020

VIA E-MAIL

Joseph R. Re
 Stephen C. Jensen
 Perry D. Oldham
 Stephen W. Larson
 Knobbe, Martens, Olson & Bear LLP
 2040 Main Street
 Irvine, CA 92614

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. 8,457,703. 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
8,457,703	IPR2020-01523	9-10, 12-14, 20, 22-24	Diab in view of Amano
		11, 21	Diab in view of Amano and Edgar
		1-7, 15-18	Diab in view of Amano and Turcott
		9-10, 12-14, 20, 22-24	Diab in view of the General Knowledge of a POSITA (GK-POSITA)

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Patent No.	Proceeding No.	Claims	Grounds
		11, 21	Diab in view of GK-POSITA and Edgar
		1-7, 15-18	Diab in view of GK-POSITA and Turcott
		9-10, 12-14, 20, 22-24	Amano
		1-3, 15-17	Amano in view of Turcott

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
Amano	U.S. Patent No. 6,293,915
Edgar	U.S. Patent No. 6,393,311
Turcott	U.S. Patent No. 6,527,729
Diab	U.S. Patent No. 5,632,272