

November 6, 2020

VIA E-MAIL

Philip J. Graves
301 North Lake Ave.
Ste. 920
Pasadena, CA 91101
philipg@hbsslaw.com

Re: *Neonode Smartphone LLC v. Apple Inc.*, Case No. 6:20-cv-00505

Dear Mr. Graves:

We write regarding the petitions for *inter partes* review (IPR) filed against the patents in suit, US Patent Nos. 8,095,879 and 8,812,993, in the captioned litigation. We write to inform you that Apple Inc. hereby stipulates that if the Patent Trial and Appeal Board (PTAB) institutes one or more of the IPR petitions on the grounds presented (a table of which is reproduced below), then the Defendant, Apple Inc. (“Apple”), will not pursue those same instituted grounds or grounds sharing the same primary reference in the above-captioned litigation.

Patent No.	Claims	Prior Art Basis of Ground
8,095,879	1, 14, 15, 16, 17	Ren, Tanaka
8,095,879	2, 3, 4, 5	Ren, Tanaka, Hirayama307
8,095,879	3	Ren, Tanaka, Hirayama307, Hirayama878
8,095,879	6, 13	Ren, Tanaka, Allard

8,095,879	12	Ren, Tanaka, Henckel
8,095,879	1, 2, 4, 5, 14-17	Hirayama307, Ren
8,095,879	3	Hirayama307, Ren, Hirayama878
8,095,879	6, 13	Hirayama307, Ren, Allard
8,095,879	12	Hirayama307, Ren, Henckel
8,095,879	1, 14, 15	Jermyn
8,812,993	1-3, 7-8	Hisatomi, Ren
8,812,993	4	Hisatomi, Ren, Allard 656
8,812,993	5	Hisatomi, Ren, Tanaka
8,812,993	6	Hisatomi, Ren, Kodama
8,812,993	1-3, 7-8	Hansen, Gillespie
8,812,993	4	Hansen, Gillespie, Allard 656
8,812,993	5	Hansen, Gillespie, Tanaka
8,812,993	6	Hansen, Gillespie, Kodama

In so stipulating, Apple seeks to avoid multiple proceedings addressing the validity of the patents in suit based on the same grounds. Rather, consistent with Congressional intent, Apple wishes the patentability of these patents over those grounds to be addressed at the Board. But, for the sake of clarity and to avoid any doubt, if the PTAB declines institution of one or more IPRs, Apple reserves the right to pursue all grounds in this litigation.

Sincerely,



Benjamin C. Elacqua
Fish & Richardson P.C.