



DLA Piper LLP (US)
2000 University Avenue
East Palo Alto, California 94303-2250
www.dlapiper.com

Erik R. Fuehrer
Erik.Fuehrer@dlapiper.com
T 650.833.2045
F 650.687.1243

November 30, 2021
ATTORNEY-CLIENT PRIVILEGE
VIA E-MAIL BRIAN.MICHALEK@SAUL.COM

Saul Ewing Arnstein & Lehr LLP
Brian R. Michalek
161 N. Clark St., Suite 4200
Chicago, IL 60601

Re: *BillJCo, LLC v. Apple Inc.*,
Case No. 6:21-cv-00528 (W.D. Tex.)

Dear Counsel:

On behalf of Defendant Apple Inc. ("Defendant") in the above-referenced case ("the Litigation"), we write regarding a petition for *inter partes* review ("IPR") that Defendant intends to file with the Patent Trial and Appeal Board ("PTAB") to address claims 1-3, 8, 20, 21, 23-27, 32, 44, 45, 47, and 48 of U.S. Patent No. 8,566,839 (the "Petition") on November 30, 2021.

We write to inform you that Defendant, as real party-in-interest ("RPI") in the Petition, hereby stipulates that in the event the PTAB institutes an IPR based on the Petition, Defendant will not seek resolution in the Litigation of any ground of invalidity pursued in the instituted Petition.

By so stipulating, Defendant seeks to avoid multiple proceedings addressing the validity of claims 1-3, 8, 20, 21, 23-27, 32, 44, 45, 47, and 48 of U.S. Patent No. 8,566,839 based on the instituted grounds in the Petition. Defendant requests that the patentability of these claims over the grounds presented in the Petition to be addressed at the PTAB. For the sake of clarity and to avoid any doubt, if the PTAB declines to institute an IPR based on the Petition, Defendant reserves the right to pursue the non-instituted grounds from the denied Petition in this litigation. Additionally, even in the event of institution, Defendant reserves its right in the Litigation to rely on any prior art and prior art combinations other than the instituted grounds in the Petition.

Best regards,

A handwritten signature in blue ink, appearing to read 'ERF', with a stylized flourish at the end.

Erik R. Fuehrer

ERF: