

June 16, 2022

VIA E-MAIL

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Re: *Jawbone Innovations, LLC v. Apple Inc.*, Case No. 6:21-cv-00984

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. 8,019,091. The table below lists grounds asserted by Apple Inc. (“Apple”) in the IPR2022-01147 petition challenging claims of this patent, along with the implicated claims against which the grounds are asserted.

We write to inform you that Apple hereby stipulates that in the event the PTAB institutes an *inter partes* review based on the IPR2022-01147 petition and including the grounds listed in the table below against the corresponding claims listed in the table for those grounds (“Instituted Grounds”), Apple will not seek resolution, in the above-captioned district court litigation (6:21-cv-00984), of the Instituted Grounds against the corresponding claims listed in the table for those grounds.

Patent No.	Proceeding No.	Claims	Ground
8,019,091	IPR2022-01147	1-5, 7, 8, 11, 13, 14, 16, 18-20	Obvious (§ 103) over Hietanen, Burnett, and Weinstein
8,019,091	IPR2022-01147	1-3, 5-8, 10-14, 16-20	Obvious (§ 103) over Hietanen, Takano, and Weinstein
8,019,091	IPR2022-01147	3, 9, 15	Obvious (§ 103) over Hietanen, Burnett or Takano, Weinstein, and Hussain

In so stipulating, Apple seeks to avoid multiple proceedings addressing the validity of the '091 patent based on the same grounds. Rather, Apple wishes the patentability of this patent over the Instituted Grounds to be addressed at the PTAB. But, for the sake of clarity and to avoid any doubt, if the PTAB declines institution of Apple's IPR petition relating to the '091 patent, Apple reserves the right to seek resolution of the Instituted Grounds in the above-captioned district court litigation (6:21-cv-00984).

Sincerely,

A handwritten signature in black ink, appearing to read 'Ricardo Bonilla'.

Ricardo Bonilla
Fish & Richardson

List of Prior Art References

Reference Name	Details
Hietanen	U.S. Patent No. 6,415,034
Burnett	U.S. Patent No. 6,377,919
Weinstein	Weinstein et al., "Multi-Channel Signal Separation by Decorrelation," IEEE Transactions on Speech and Audio Processing, Vol. 1, No. 4, October 1993, pages 405-413
Takano	Japanese Unexamined Patent Application JPH11305792
Hussain	Hussain et al., "A New Metric For Selecting Sub-band Processing In Adaptive Speech Enhancement Systems," EuroSpeech '97 Proceedings, ESCA 5th European Conference On Speech Communication And Technology, September 22-25, 1997, pages 2611-2614 ("Hussain")