FISH.
FISH & RICHARDSON

Fish & Richardson P.C.
1000 Maine Avenue, S.W.
Suite 1000
Washington, DC 20024

202 783 5070 main
202 783 2331 fax

Michael T. Zoppo
Principal
zoppo@fr.com
+1 212-641-2268 direct

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VIA E-MAIL

Bruster PLLC
680 North Carroll Avenue, Suite 110
Southlake, Texas 76092
Phone: 817-601-9564

Nix Patterson LLP
3600 North Capital of Texas Highway
Suite B350
Austin, TX 78746
Phone: 512-328-5333

Whiteford Taylor Preston LLP
7 St. Paul Street
Baltimore, MD 21202
Phone: 410-347-8700

Sorey & Hoover, LLP
100 North 6th Street, Suite 502
Waco, TX 76701
Phone: 903-230-5600

Re: ***Auto Telematics Ltd. v. United Services Automobile Association and Noblr Reciprocal Exchange*, 6:22-cv-00474-ADA-DTG (W.D. Tex.)**

Dear Counsel:

United Services Automobile Association ("USAA") has filed an *inter partes* review (IPR) petition (IPR2023-00911) with the Patent Trial and Appeal Board (PTAB) to address the validity of claims 1, 3-4, and 6-7 of U.S. Patent No. 9,311,271 ("the '271 Patent"). The tables in attached Appendix A list all grounds, challenged claims, and references asserted in IPR2023-00911. In a subsequent filing, USAA updated its mandatory notices to indicate that USAA and Noblr Reciprocal Exchange ("Noblr") are real parties-in-interest to the IPR2023-00911 proceeding.

I write to inform you that USAA and Noblr hereby stipulate that if the PTAB institutes IPR2023-00911 based on the grounds in attached Appendix A, USAA and Noblr will not pursue for the instituted claims, in the District Court proceedings, the same grounds or any grounds that could have reasonably been raised before the PTAB in the IPR2023-00911 petition. *Sotera Wireless, Inc. v. Masimo Corp.,* IPR2020-01019, Pap. 12 at 13-20 (PTAB Dec. 1, 2020) (precedential) ("*Sotera*").

Pursuant to *Sotera*, USAA and Noblr reserve the right to assert grounds in the District Court proceedings based on the system art listed in Appendix B, either alone, or in combination with other prior art.[1] For the sake of clarity and to avoid any doubt, if the PTAB declines to institute IPR2023-00911, USAA and Noblr reserve the right to assert any grounds of invalidity in the District Court proceedings against the ’271 Patent.

Sincerely,

Michael T. Zoppo

Attorney for United Services Automobile Association

[1] USAA notes that system art (e.g., the system art listed in attached Appendix B) is not eligible for PTAB consideration in an IPR proceeding, and grounds based on system art either alone, or in combination with patent or printed publication prior art, could not have reasonably been raised before the PTAB in the IPR2023-00911 petition. *See* 35 U.S.C § 311(b). Further, discovery in the District Court proceedings is currently ongoing and USAA expects there to be additional materials and/or testimony relating to the system art listed in Appendix B. For the avoidance of doubt, USAA reserves the right to rely on such forthcoming productions in the District Court proceedings.

Appendix A – Grounds and Prior Art References Used in IPR2023-00911

Ground	Claim(s)	35 U.S.C. §103
1A	1	Curry, Rabu
1B	1	Curry, Rabu, Katayama
1C	3	Curry, Rabu, Tamir
1D	4	Curry, Rabu, McClellan
2	6, 7	Callopy, Curry

List of References

Reference Name	Details
Curry	International Publication No. WO 2010/042545
Rabu	U.S. Pat. No. 8,682,399
Katayama	European Patent Application Publication No. EP 1,914,691
Tamir	U.S. Patent No. 7,821,421
McClellan	U.S. Patent Application Publication No. 2009/0024419
Callopy	International Publication No. WO 2010/062899

Appendix B – System Art

System / OS / Application
iCartel, c. 2010
DailyRoads Voyager, c. 2010
iDrive, c. 2009
IVOX DriverScore, c. October 2008
MicroStrain Wireless Data Acquisition System, c. 2009;
PEIR, c. 2005
Waze (f/k/a FreeMap Israel), c. 2006
ELM327 Device, used with Touchscan application, c. 2010
iPhone 4, available as of 2011
iPhone 3G, available as of 2008
Lemur AlertDriver, c. 2011
Lemur EconoDriver, c. 2011
Lemur SafeDriver, c. 2011
Progressive Snapshot, c. 2010
Tegolis Fleet integrated with Tegolis Mobile, c. 2011