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**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 (IPR2023-00912) with the Patent Trial and Appeal Board (PTAB) to address the validity of claims 1-7 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 IPR2023-00912. 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 IPR2023-00912 proceeding.

I write to inform you that USAA and Noblr hereby stipulate that if the PTAB institutes IPR2023-00912 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 IPR2023-00912 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 IPR2023-00912, 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 IPR2023-00912 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 IPR2023-00912**

| Ground | Claim(s) | 35 U.S.C. §103 |
|---|---|---|
| 1A | 1, 2, 4 | Peng, Chatterjee |
| 1B | 3 | Peng, Chatterjee, Tamir |
| 1C | 5 | Peng, Chatterjee, Wilkes |
| 1D | 6, 7 | Peng, Callopy |

**List of References**

| Reference Name | Details |
|---|---|
| Peng | U.S. Patent Application Publication No. 2011/0307188 |
| Chatterjee | U.S. Patent Application Publication No. 2010/0131691 |
| Tamir | U.S. Patent No. 7,821,421 |
| Wilkes | U.S. Patent Application Publication No. 2011/0077028 |
| 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 |