UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

USAA Federal Savings Bank,
Petitioner,

v.

PACid Technologies, LLC,
Patent Owner.

Case IPR2025-00753
U.S. Patent No. 10,171,433

JOINT MOTION TO TERMINATE PROCEEDING

Updated Exhibit List (Patent Owner)

Ex.	Description
2001	Federal District Caseload Statistics, Table C-5 (March 2024)
2002	Summons in *PACid Technologies, LLC v. USAA Federal Savings Bank*, 1:24-cv-321-DAE
2003	Joint Stipulation of Dismissal in *PACid Technologies, LLC v. USAA Federal Savings Bank*, 1:24-cv-321-DAE

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.74 and the authorization provided by the Board on September 17, 2025, Petitioner USAA Federal Savings Bank ("Petitioner") and Patent Owner PACid Technologies, LLC ("Patent Owner") (collectively, "the Parties") jointly move to terminate this proceeding, IPR2025-00753, directed to U.S. Patent No. 10,171,433.

II. STATEMENT OF FACTS

Petitioner and Patent Owner have now resolved their dispute regarding U.S. Patent No. 10,171,433, including both this proceeding and Patent Owner's assertion of U.S. Patent No. 10,171,433 in the district court litigation, *PACid Technologies, LLC v. USAA Federal Savings Bank*, Civil Action No. 1:24-cv-321-DAE. That litigation has been dismissed. The parties do not anticipate future litigation between them concerning U.S. Patent No. 10,171,433. The following related proceedings are currently before the Board: IPR2025-00751; IPR2025-00752; IPR2025-00697; IPR2025-00754; and IPR2025-00755.

III. RELIEF REQUESTED

Termination of this *inter partes* review is requested, and the Parties respectfully submit that such termination is justified. *See* Consolidated Trial Practice Guide (November 2019), 86.

The Board should terminate this proceeding, as the Parties jointly request, for the following reasons.

First, the Parties have met the statutory requirement that they file a "joint request" to terminate before the Office "has decided the merits of the proceeding." 35 U.S.C. § 317(a). Under § 317(a), an *inter partes* review shall be terminated upon such joint request "unless the Office has decided the merits of the proceeding before the request for termination is filed." There are no other preconditions recited in 35 U.S.C. § 317(a).

Second, the Parties have resolved their dispute regarding U.S. Patent No. 10,171,433 both in this proceeding and Patent Owner's assertion of U.S. Patent No. 10,171,433 in the district court litigation. As noted above, that litigation has been dismissed. A true and correct copy of the Parties' joint stipulation for dismissal from the district court litigation is being filed as Exhibit 2003. The Parties' joint stipulation for dismissal states, in relevant part:

> 1. PACid dismisses with prejudice all claims in this action brought, that could have been brought, or that PACid at any time could have moved to add, against USAA FSB, its subsidiaries, parents, predecessors, successors, affiliates, agents, attorneys, insurers, servants, distributors, service providers, retailers, suppliers, employees, officers, directors, users, members, and customers, but expressly excluding all other accused infringers, including Citibank N.A., based on any claim that USAA FSB infringes the patents asserted in this action, including U.S. Patent Nos. 9,577,993; 9,876,771; 10,044,689; 10,171,433; 10,484,344; 11,070,530

(collectively, the "Asserted Patents") and any patents that are in the same family as the Asserted Patents (the "Asserted Patent Family"), including but not limited to any provisional, priority application, divisional, continuation, continuation-in-part, substitution, international application, or similar application claiming priority to any of the foregoing, any registration, reissue, re-examination, renewal, confirmation, extension, or supplementary protection certificates and the like of any of the foregoing; and any foreign or international equivalent of any of the foregoing.

…

3. PACid releases USAA FSB, its respective subsidiaries, parents, affiliates, officers, directors, managers, employees, agents, representatives, customers, members, distributors, clients, attorneys, but expressly excluding all other accused infringers, including Citibank N.A., from any and all claims, causes of action, and claims for relief of any kind, known or unknown, suspected or unsuspected, including those that may hereafter arise as a result of the discovery of new and/or additional facts, of any type existing as of the date of this stipulation for infringement of the Asserted Patents arising out of or relating to their activities that constitute the making, having made, using, selling, offering to sell, importing, exporting or otherwise disposing of products and services of USAA FSB or its subsidiaries, parents, or affiliates (including, without limitation, United Services Automobile Association, a Texas reciprocal inter-insurance exchange).

4. USAA FSB releases PACid, its respective affiliates, officers, directors, managers, employees, agents, representatives, customers, members, distributors, clients, attorneys, from any and all claims, causes of action, and claims for relief of any kind, known or unknown, suspected or unsuspected, including those that may hereafter arise as a result of the discovery of new and/or

> additional facts, arising out of or based upon the Asserted Patents, this litigation, and/or the claims asserted therein.

The Parties further stipulate and certify that no other such agreements, written or oral, exist between the Parties.

Third, termination would save significant further expenditure of resources by the Parties. Termination upon resolution of the Parties' dispute, as requested, would also further the purpose of *inter partes* review proceedings, which seeks to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further resolution of disputes, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an inter partes review would continue regardless of parties resolving their disputes.

Date: September 18, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on September 18, 2025, a true and correct copy of the foregoing JOINT MOTION TO TERMINATE PROCEEDING was served by electronic mail upon counsel of record for Petitioner as follows:

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