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Via E-Mail

May 12, 2025

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Re: ***PACid Technologies, LLC v. USAA Federal Savings Bank, 1-24-cv-00321 (WDTX)***

Counsel:

USAA Federal Savings Bank ("Petitioner" or "USAA") filed a petition for *inter partes* review (IPR2025-00754) with the Patent Trial and Appeal Board (PTAB) to address the patentability of claims 1-14 of U.S. Patent 10,484,344.

I write to inform you that USAA hereby stipulates that, if the PTAB institutes review in IPR2025-00754, USAA will not pursue in the above-captioned District Court litigation the specific grounds asserted in IPR2025-00754, or any other ground that could have been reasonably raised in IPR2025-00754 (i.e., any ground that could have been raised under §§ 102 or 103 on the basis of prior art patents or printed publications). *See Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020). USAA also stipulates that, if the PTAB institutes review in IPR2025-00754, USAA will not pursue in the above-captioned District Court litigation combinations of the prior art references asserted as part of a ground in this proceeding, as listed below, with unpublished system prior art or any other type of prior art. *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, IPR2024-01206, IPR2024-01207 & IPR2024-01208, Paper 19 (PTAB Mar. 28, 2025). Accordingly, USAA hereby stipulates that, if the PTAB institutes review in IPR2025-00754, USAA will not pursue in the above-captioned District Court litigation combinations of any of the Immega, Day, Tomko, Mardikar, Chhabra, and Duffy references asserted as part of the grounds of IPR2025-00754 with unpublished system prior art or any other type of prior art.

In so stipulating, USAA seeks to avoid multiple proceedings in different forums addressing the validity of the instituted claims based on the same grounds or prior art. The tables in attached Appendix A list the grounds and ground references asserted in IPR2025-00754.

For the sake of clarity and to avoid any doubt, if the PTAB declines to institute IPR2025-00754, USAA reserves the right to assert any grounds of invalidity in the above-captioned District Court proceeding against U.S. Patent 10,484,344.

Sincerely,

Michael T. Zoppo
Attorney for USAA Federal Savings Bank

Appendix A – Grounds and Prior Art References

Ground	Claims	Basis
1	1-14	Immega-Day-Tomko
2A	1-4, 6-14	Mardikar-Chhabra
2B	1-14	Mardikar-Chhabra-Duffy

Ground Reference	Details
Immega (USAA-1004)	U.S. Patent App. Pub. No. 2003/0140235 to Immega et al.
Day (USAA-1006)	U.S. Patent App. Pub. No. 2007/0061567 to Day et al.
Tomko (USAA-1005)	U.S. Patent No. 6,002,770 to Tomko et al.
Mardikar (USAA-1010)	U.S. Patent No. 8,108,318 to Mardikar
Chhabra (USAA-1013)	U.S. Patent No. 8,234,697 to Chhabra
Duffy (USAA-1014)	U.S. Patent App. Pub. No. 2004/0111625 to Duffy et al.