

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Petitioner

v.

AUTO TELEMATICS LTD.,
Patent Owner

Case IPR2025-00812
Patent 12,236,728

JOINT MOTION TO TERMINATE PROCEEDING

UPDATED EXHIBIT LIST

- USAA-1001 U.S. Patent No. 12,236,728 to Wright (“the ’728 patent”)
- USAA-1002 Excerpts from the Prosecution History of the ’728 patent (“the Prosecution History”)
- USAA-1003 Declaration and Curriculum Vitae of Dr. William Michalson
- USAA-1004 Original Complaint for Patent Infringement in Auto Telematics Ltd. v. United Services Automobile Association, 6:22-cv-00474 (W.D. Tex. May 11, 2022)
- USAA-1005 International Publication No. WO 2010/062899 (“Callopy”)
- USAA-1006 International Publication No. WO 2010/042545 to Curry et. al (“Curry”)
- USAA-1007 Thompson et al., “Using Smartphones and Wireless Mobile Sensor Networks to Detect Car Accidents and Provide Situational Awareness to Emergency Responders,” Mobilware 2010, LNICST 48, pp. 29–42, 2010 (“Thompson”)
- USAA-1008 U.S. Pat. Publication No. 2006/0053038 to Warren et al. (“Warren”)
- USAA-1009 European Pat. App. Pub. No. EP 1,914,691 to Katayama et al. (“Katayama”)
- USAA-1010 U.S. Pat. No. 8,682,399 to Rabu (“Rabu”)
- USAA-1011-1020 RESERVED
- USAA-1021 U.S. Pat. App. Pub. No. 2002/0105423 to Rast (“Rast”)
- USAA-1022 U.S. Pat. App. Pub. No. 2009/0192705 to Golding (“Golding”)
- USAA-1023 Internet Archive of iPhone User Guide
- USAA-1024 Internet Archive of iPhone 3G Technical Specification
- USAA-1025 Internet Archive of iPhone User Guide for iPhone and iPhone 3G
- USAA-1026 Internet Archive of Instruction Sheet for iPhone 3G

- USAA-1027 Zhao, Yilin, "Vehicle Location and Navigation Systems," Artech House, Boston (1997) ("Zhao1997")
- USAA-1028 Conover, Gerald D, "ITS Technology in Automotive—Who's on First?" SAE International (2006): 1-11 ("Conover2006")
- USAA-1029 Skog, Isaac, et. al, "A versatile PC-based platform for inertial navigation," Proceedings of the 7th Nordic Signal Processing Symposium-NORSIG 2006. IEEE, 2006 ("Skog2006")
- USAA-1030 Cheng et. al, "An Android System Design and Implementation for Telematics Services," 2010 IEEE International Conference on Intelligent Computing and Intelligent Systems. Vol. 2. IEEE, 2010 ("Cheng2010")
- USAA-1031 Work, D. B. & Bayen, A. M. B., "Impacts of the mobile internet on transportation cyberphysical systems: traffic monitoring using smartphones," National Workshop for Research on High-Confidence Transportation Cyber-Physical Systems: Automotive, Aviation, & Rail. 2008 ("Work2008")
- USAA-1032 Flinchbaugh, B., "Smart Camera Systems Technology Roadmap," Real-Time Vision for Human-Computer Interaction (2005), 285-297 ("Flinchbaugh2005")
- USAA-1033 LeBlanc, David J., "Road departure crash warning system field operational test: methodology and results," Vol. 1: Technical Report, University of Michigan, Ann Arbor, Transportation Research Institute, 2006 ("LeBlanc2006")
- USAA-1034 Reddy, Sasank et al., "Determining transportation mode on mobile phones," 2008 12th IEEE international symposium on wearable computers. IEEE, 2008 ("Reddy2008")
- USAA-1035 Zhao, Yilin, "Standardization of mobile phone positioning for 3G systems," IEEE Communications magazine 40.7 (2002): 108-116 ("Zhao2002B")
- USAA-1036 Strömmer, Esko et al., "Ultra-low power sensors with near field communication for mobile applications," Wireless Sensor and Actor Networks: IFIP WG 6.8 First International Conference on Wireless

Sensor and Actor Networks, WSA'07, Albacete, Spain, September 24–26, 2007. Springer US, 2007 (“Strömmer2007”)

- USAA-1037 Schott, Christian, et al., “CMOS single-chip electronic compass with microcontroller,” IEEE Journal of Solid-State Circuits 42.12 (2007): 2923-2933 (“Schott2007”)
- USAA-1038 Liutkauskas, V. et al., “Location based services,” Elektronika ir elektrotechnika 52.3 (2004) (“Liutkauskas2004”)
- USAA-1039 Ealey, Lance & Luis Troyano-Bermúdez, “Are automobiles the next commodity?” The McKinsey Quarterly 4 (1996): 62 (“Ealey1996”)
- USAA-1040 Zhao, Yilin, “Efficient and reliable data transmission for cellular-and-GPS-based mayday systems,” Proceedings of Conference on Intelligent Transportation Systems, IEEE, 1998 (“Zhao1998B”)
- USAA-1041 Young, Richard A., “Association between embedded cellular phone calls and vehicle crashes involving airbag deployment,” Proceedings of the First International Driving Symposium on Human Factors in Driver Assessment, Training and Vehicle Design, Vol. 1. No. 2001, University of Iowa, 2001 (“Young2001”)
- USAA-1042 De Fabritiis, Corrado et al., “Traffic estimation and prediction based on real time floating car data,” 2008 11th international IEEE conference on intelligent transportation systems, IEEE, 2008 (“DeFabritiis2008”)
- USAA-1043 Schäfer, Ralf-Peter, et al., “A traffic information system by means of real-time floating-car data” (2002) (“Schäfer2002”)
- USAA-1044 Kerner, B. S., et al., “Traffic state detection with floating car data in road networks,” Proceedings of the 8th International IEEE Conference on Intelligent Transportation Systems, 2005, (“Kerner2005”)
- USAA-1045 Leduc, Guillaume, “Road traffic data: Collection methods and applications,” Working Papers on Energy, Transport and Climate Change 1.55 (2008): 1-55 (“Leduc2008”)

USAA-1046 Troncoso, Carmela, et al, “Pripayd: privacy friendly pay-asyou-drive insurance,” IEEE Transactions on Dependable and Secure Computing, Vol. 8, No. 5, October 2011 (“Troncoso2011”)

USAA-1047 RESERVED

USAA-1048 Excerpts of The New Oxford American Dictionary, Second Edition (2005)

USAA-1049 Lee, Suzanne et al., “A Comprehensive Examination of Naturalistic Lane-Changes,” DOT HS 809 702, National Highway Traffic Safety Administration (March 2004) (USAA1049)

USAA-1050 Turner, S. & Holdener D., “Probe Vehicle Sample Sizes for Real-Time Information: The Houston Experience,” IEEE (1995)

USAA-1051 Order in Auto Telematics Ltd. v. United Services Automobile Association, Case No. 2025-1209 (Fed. Cir. Mar. 4, 2025)

USAA-1052 Confidential Settlement Agreement

Petitioner United Services Automobile Association., (“USAA” or “Petitioner”) and Patent Owner Auto Telematics Ltd. (“Auto Telematics” or “Patent Owner”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, USAA and Auto Telematics move to terminate the present *inter partes* review proceeding.

I. STATEMENT OF FACTS

USAA and Auto Telematics (collectively, the “Settling Parties”) have reached an agreement (the “Settlement Agreement”) to resolve their disputes.

Pursuant to 37 C.F.R. § 42.74(b), the Settlement Agreement is in writing, and a true and correct copy is being filed as Exhibit 1052. The Settlement Agreement is being filed electronically with access to “Board and Parties Only.” A “*Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74*” is being filed concurrently with this Joint Motion to Terminate, and the Settling Parties ask the Board to treat the Settlement Agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. RELIEF REQUESTED

Termination of this *inter partes* review is requested, and the Settling Parties respectfully submit that such termination is justified. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial

Practice Guide 86 (Nov. 2019). “The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” *Id.* (citing 35 U.S.C. §§ 317(a)).

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

First, USAA and Auto Telematics 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 section 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, USAA and Auto Telematics have reached a settlement as to all the disputes in this proceeding and as to the ’728 patent. A true copy of the settlement agreement is filed concurrently herewith. *See* Confidential Ex. 1052. USAA and Auto Telematics request that the settlement agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the Settling Parties.

Third, termination would save significant further expenditure of resources by the Settling Parties. Termination upon settlement, as requested, would also further

the purpose of *inter partes* review proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, 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 a settlement.

III. CONCLUSION

For the foregoing reasons, USAA and Auto Telematics respectfully request termination of this *inter partes* review.

Respectfully submitted,

Date: May 20, 2026

/Thomas A. Rozylowicz/
W. Karl Renner, Reg. No. 41,265
Thomas Rozylowicz, Reg. No. 50,620
Andrew B. Patrick, Reg. No. 63,471
Michael T. Zoppo, Reg. No. 61,074
Ryan Chowdhury, Reg. No. 74,466
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

Attorneys for Petitioner

Respectfully submitted,

Date: May 20, 2026

/Matthew C. Juren/
Matthew C. Juren, Reg. No. 68,233
Kelly D. Stephens, Reg. No. 49,017
Stephens Juren, PLLC
2500 Tanglewilde St., Suite 320
Houston, Texas 77063
Main: 832-344-5400
Direct: 832-990-2707
Fax: 832-476-5460

Attorneys for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on May 20, 2026, a complete and entire copy of this Joint Motion to Terminate and Exhibit 1052 were provided by email, to the Patent Owner by serving the email correspondence addresses of record as follows:

Matthew C. Juren
Kelly D. Stephens
Stephens Juren, PLLC
2500 Tanglewilde St., Suite 320
Houston, Texas 77063

Email: mjuren@patent-lawyers.com
kstephens@patent-lawyers.com
service@patent-lawyers.com

/Diana Bradley/
Diana Bradley
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
bradley@fr.com