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VIA ELECTRONIC MAIL

Vincent J. Rubino III
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Re: *Valtrus Innovations, Ltd. et al. v. FedEx Office and Print Services, Inc.*
Case No. 2:25-cv-00516-JRG (Lead Case) (E.D. Tex)
IPR2025-01491, U.S. Patent No. 7,904,686

Counsel:

FedEx Corporation and FedEx Office and Print Services, Inc. ("FedEx") filed a petition for *inter partes* review against claims of U.S. Patent No. 7,904,686 (the "'686 patent") on August 29, 2025, and that proceeding has been assigned AIA Review No. IPR2025-01491. If *inter partes* review is instituted in IPR2025-01491, unless institution is later vacated, reversed or otherwise withdrawn by rehearing or Director Review, FedEx stipulates that it will not pursue in Civil Action No. 2:25-cv-00516 (E.D. Tex.), against the '686 patent, (i) the specific grounds raised in IPR2025-01491; (ii) any other ground that could have been reasonably raised in IPR2025-01491 under §§ 102 or 103 on the basis of prior art patents or printed publications; (iii) any ground based on a combination of system prior art (i.e., prior art that is neither a patent or printed publication) and the references that form the basis of any ground raised in IPR2025-01491 or references that form the basis of any ground of any other post-grant request or petition filed on or before August 29, 2025 that challenges the '686 patent, or (iv) any ground under §§ 102 or 103 on the basis of system art corresponding to the references that form the basis of any ground raised in IPR2025-01491.

For the sake of clarity and to avoid any doubt, if the PTAB declines to institute IPR2025-01491, or if institution is later vacated, reversed or otherwise withdrawn by rehearing or Director Review, FedEx reserves the right to assert any grounds of invalidity in the above-captioned District Court proceeding against U.S. Patent 7,904,686.

Regards,

David M. Hoffman

cc: Counsel of Record