UNITED STATES PATENT AND TRADEMARK OFFICE

———————

BEFORE THE PATENT TRIAL AND APPEAL BOARD

———————

FIFTH THIRD BANK, NATIONAL ASSOCIATION,
Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Patent Owner.

———————

Case IPR2026-00277
U.S. Patent No. 12,211,095

———————

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR JOINDER

TABLE OF CONTENTS

Page

I. STATEMENT OF THE PRECISE RELIEF REQUESTED.....1

II. FIFTH THIRD'S JOINDER PETITION SHOULD BE DENIED.....1

A. The Board routinely denies motions for joinder when the underlying IPR is terminated.....2

B. Fifth Third's reliance on a different expert than in the Regions IPR will complicate and delay the schedule once the Regions IPR is terminated, and is highly likely to raise due process concerns.....3

III. CONCLUSION.....5

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner Fifth Third Bank, National Association ("Fifth Third" or "Petitioner") moves to join this proceeding, IPR2026-00277, with *Regions Bank v. United Services Automobile Association*, IPR2025-01356 ("Regions IPR"). Paper 3. Patent Owner United Services Automobile Association ("USAA" or "Patent Owner") opposes and respectfully requests that the Board decline joinder because the Parties in the Regions IPR have settled their dispute and will imminently terminate that IPR.

II. FIFTH THIRD'S JOINDER PETITION SHOULD BE DENIED

Joinder is discretionary and not a matter of right. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122; *Facebook, Inc. v. Windy City Innov., LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020) (§ 315(c) permits the "exercise [of] discretion to decide whether to 'join as a party' the joinder applicant."). The Board routinely denies motions for joinder when the underlying IPR is terminated before the motion is granted, as there is no active proceeding to join. *Commscope, Inc. v. TQ Delta, LLC*, IPR2022-01443, Paper 13 (PTAB December 13, 2022) (denying motion for joinder because the underlying IPR was terminated); *Apple Inc. v. Uniloc 2017, LLC*, IPR2020-00854, Paper 9 (PTAB October 28, 2020) (same). Moreover, Fifth Third's reliance on a different expert than in the Regions IPR will complicate and delay the schedule once

the Regions IPR is terminated, and is highly likely to raise due process concerns. Respectfully, Fifth Third's Motion for Joinder should be denied.

A. The Board routinely denies motions for joinder when the underlying IPR is terminated

Fifth Third's Motion for Joinder agrees that the parties in the Regions IPR are "in late stages of settlement discussions." Paper 3, 2. Since the filing of Fifth Third's Motion for Joinder, USAA and Regions have indeed settled their dispute. Ex.2001 (Joint Second Motion to Stay all Deadlines and Notice of Settlement filed March 12, 2026 in *United Services Automobile Association v. Regions Bank*, Case No. 2:25-cv 00082, (E.D. Tex.)). USAA and Regions will imminently file a joint motion to terminate the Regions IPR, and USAA will promptly notify the Board in this proceeding when that joint motion to terminate is filed. USAA's Patent Owner Preliminary Response in this -0277 IPR is not due until June 5, 2026. Thus, the earliest that institution of Fifth Third's Petition can be decided is June 2026—almost three months from now. By that time, the Regions IPR will have been terminated.

The Board routinely denies motions for joinder when the underlying IPR is terminated before the motion is granted. *Commscope*, IPR2022-01443, Paper 13; *Apple*, IPR2020-00854, Paper 9. The Board should do so again here. The Regions IPR will be terminated before institution of Fifth Third's IPR can be decided. Once the Regions IPR is terminated, there will be no active proceeding for Fifth Third to

join. As the Board stated in *Commscope*, "the Board terminated the [underlying] IPR based on settlement between the parties, noting the Board's policy goal of fostering settlements. There is no pending proceeding in the [underlying] IPR for Petitioner to join. As a result, Petitioner's request to join the [underlying] IPR is denied." *Commscope*, IPR2022-01443, Paper 13 at 4. The same should apply here. Once the Regions IPR is terminated, there will be no proceeding for Fifth Third to join. Thus, joinder should be denied.

B. Fifth Third's reliance on a different expert than in the Regions IPR will complicate and delay the schedule once the Regions IPR is terminated, and is highly likely to raise due process concerns

Joinder should also be denied because Fifth Third's reliance on a different expert than Regions will complicate and delay the schedule and raise due process concerns once the Regions IPR is terminated. Specifically, Fifth Third's expert Dr. Hart provides no opinions of his own on the grounds at issue. Instead, Dr. Hart's declaration includes a single paragraph attesting that he "reviewed the Lopresti Declaration, submitted in connection with Regions Bank's petition for *inter partes* review of the '095 patent (IPR2025-01356), including the materials and exhibits cited therein" and that he "fully agree with, and hereby adopt as if set forth herein, the opinions set forth in the Lopresti Declaration." Ex.1081 (Hart Declaration), ¶17. Because Dr. Hart has no independent opinions of his own and the opinions expressed in Dr. Hart's declaration were formed by Dr. Lopresti, USAA will need to depose

Dr. Lopresti to understand the bases of the opinions that Dr. Hart has adopted. *See Corning Gilbert Inc. v. PPC Broadband, Inc.*, IPR2013-00347, Paper 20 at 2 (PTAB January 2, 2014) (Stating if a petitioner "file[s] a declaration by a second expert[] simply declaring that the second expert agrees with the opinions set forth in [the first expert's] declaration[,] that action, by itself, will not remove [the petitioner's] reliance on the testimony of [the first expert]. The proposal appears to leave, still, [the first expert's] testimony on the table for consideration."). Thus, once the Regions IPR is terminated, Fifth Third's joinder will at a minimum require two expert depositions on the same opinions. As the vast majority of IPR proceedings do not rely on one expert adopting the opinions of another expert, deposing both Dr. Lopresti and Dr. Hart will undoubtedly complicate and delay the schedule.

Permitting Fifth Third to proceed after termination of the Regions IPR also implicates the due process concerns expressed by the Board in *Corning Gilbert*. Dr. Lopresti is Region's expert—not Fifth Third's. Once the Regions IPR is terminated, Region's and Dr. Lopresti's participation in proceedings against the '095 Patent will be over. Fifth Third does not explain how it will make Dr. Lopresti available for deposition, and there is a strong likelihood that Dr. Lopresti may not be available. But if Dr. Lopresti is unavailable, the declaration from Dr. Hart simply declaring that he agrees with Dr. Lopresti still leaves Dr. Lopresti's "testimony on the table for consideration, which is inappropriate if he cannot be cross-examined." *Corning*

Gilbert, IPR2013-00347, Paper 20 at 2. Permitting Dr. Hart to provide the bases for Dr. Lopresti's opinions without making Dr. Lopresti available to do so himself thus violates USAA's due process rights. *Id*.

Joinder will complicate and delay the schedule and raises due process concerns. Fifth Third's Joinder Motion never addresses delay, how the schedule accommodates two expert depositions, or the due process concerns. The Joinder Motion never explains how Fifth Third will address these issues once it takes the primary role. Instead, Fifth Third simply assumes that it remains the understudy while Regions takes the primary role.

Joinder should be denied for these further reasons.

III. CONCLUSION

Joinder is inappropriate. USAA respectfully requests that the Board deny Fifth Third's request to join *Regions Bank v. United Services Automobile Association*, IPR2025-01356.

Respectfully submitted,

/ Minghui Yang /

Minghui Yang, Reg. No. 71,989
CARMICHAEL IP, PLLC
8607 Westwood Center Drive, Suite 270
Tysons, VA 22182
Counsel for Patent Owner

Date: March 13, 2026

CERTIFICATE OF SERVICE

The undersigned hereby certifies that, pursuant to 37 CFR § 42.6(e), a true and correct copy of the foregoing **PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR JOINDER** have been served electronically via email on counsel of record for Petitioner:

WILLIAMS & CONNOLLY LLP

Aaron Maurer (Reg. No. 44,911)
amaurer@wc.com

Jessamyn Berniker (Reg. No. 72,328
jberniker@wc.com

Dated: March 13, 2026

Respectfully submitted,

By: /Minghui Yang/
Minghui Yang