

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

***Inter Partes* Review No. IPR2026-00279**
U.S. Patent No. 12,159,310

MOTION FOR JOINDER TO
***INTER PARTES* REVIEW IPR2025-01326**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Fifth Third Bank, National Association (“Fifth Third”) respectfully submits this Motion for Joinder (“Motion”) contemporaneously filed with its Petition (“Instant Petition”) for *inter partes* review (“IPR”) of U.S. Patent No. 12,159,310 (the “’310 Patent”). Fifth Third moves for joinder with previously instituted IPR of the ’310 Patent, *Regions Bank v. United Services Automobile Association*, IPR2025-01326 (“Regions IPR”) under 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.122(b).

Fifth Third’s request for joinder is timely under 37 C.F.R. § 42.122(b) as it is submitted no later than one month after the February 10, 2026, institution date of the Regions IPR. The Instant Petition and supporting evidence are substantively identical to the petition and supporting evidence filed in the Regions IPR. Fifth Third challenges the same claims on the same grounds, based on the same arguments, same prior art and evidence. Fifth Third’s petition adds and relies on Declaration of Dr. John Hart, Ph.D., Ex. 1078, which adopts the opinions of expert Dr. Daniel Lopresti, Ex 1002. Fifth Third agrees to proceed solely on the grounds, claim constructions, evidence, and arguments advanced, or that will be advanced, in the Regions IPR.

Petitioner stipulates that if joinder is granted, it will cooperate with Regions Bank (“Regions”) in the joined proceeding. Fifth Third will act as an “understudy” and adhere to the same schedule set out in the Regions IPR unless Regions ceases to participate in the Regions IPR.

Fifth Third notes that Regions apparently is in late stages of settlement discussions with United Services Automobile Association (“Patent Owner”). *See* Report of Mediation at 1, *United Servs. Auto. Ass’n v. Regions Bank*, No. 2:25-cv-00082 (E.D. Tex. Feb. 3, 2026), Dkt. No. 83. Fifth Third is filing this Motion for Joinder to allow a petitioner to remain in order to complete trial in the event Regions reaches a settlement with Patent Owner. The Board found a “reasonable likelihood” that at least one claim of the ’310 Patent is unpatentable in the Regions IPR. *Regions IPR*, IPR2025-01326, Paper 19 at 2 (P.T.A.B. Feb. 10, 2026). It likewise found a “reasonable likelihood” that at least one claim of related patent U.S. Patent No. _12,211,095 is unpatentable. *Regions IPR*, IPR2025-01356, Paper 18 at 2 (P.T.A.B. Feb. 10, 2026). And the Federal Circuit upheld the Board’s invalidity findings with respect to the challenged claims of the ’310 Patent’s parent, U.S. Patent No. 8,977,571. *United Servs. Auto. Ass’n v. PNC Bank N.A.*, No. 2023-2124, 2025 WL 370141, at *1 (Fed. Cir. Feb. 3, 2025). Joinder provides a public benefit by allowing review of the ’310 Patent to continue in the event Regions’ participation terminates, conserving Board resources that otherwise might be expended in addressing a separate petition and furthering “the Board’s mission to improve patent quality and restore confidence in the presumption of validity that comes with issued patents.” *See Code200 v. Bright Data Ltd.*, IPR2022-00861, -00862, Paper 18 at 6 (P.T.A.B. Aug. 23, 2022) (precedential) (quoting *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S.

261, 272 (2016)); *see also EndyMed Medical Ltd. v. Serendia, LLC*, IPR2024-00842, Paper 16 at 13–17 (P.T.A.B. Jan. 29, 2025) (granting motion for joinder where petitioner of instituted IPR reached a settlement with patent owner); *Qualcomm Inc. v. Network Sys. Techs., LLC*, IPR2024-01081, Paper 14 at 37–38 (P.T.A.B. Oct. 1, 2024) (same); *eBay Inc. v. Lexos Media IP, LLC*, IPR2024-00337, Paper 11 at 14–16 (P.T.A.B. Feb. 23, 2024) (same). Because it raises the same grounds, the Instant Petition would create no additional burden for the Board, Regions, or the Patent Owner, if joined and joinder would lead to efficient resolution of the validity of challenged claims 1–16 of the ’310 patent in a single proceeding.

II. FACTUAL BACKGROUND

The ’310 Patent issued on December 3, 2024. On January 28, 2025, United Services Automobile Association filed a civil action against Regions Bank asserting infringement of the ’310 Patent, Case No. 2-25-cv-00082, in the United States District Court for the Eastern District of Texas.

On July 30, 2025, Regions filed a petition for *inter partes* review in IPR2025-01326 requesting cancellation of claims 1–16 of the ’310 Patent. The petition noted that “in prior proceedings involving related patents,” including the parent patent of the ’310 patent, “the Board found and the Federal Circuit affirmed that automatically capturing an image for mobile check deposit is obvious” in view of references relied on in the petition. *Regions IPR*, IPR2025-01326, Paper 3 at 1 (P.T.A.B. July 30,

2025). On February 10, 2026, the Board instituted Region’s petition in IPR2025-01326, finding that “petitioner has shown a reasonable likelihood of prevailing with respect to at least one of the claims challenged in the petition.” *Regions IPR*, IPR2025-01326, Paper 19 at 2 (P.T.A.B. Feb. 10, 2026). A scheduling order was entered on February 17, 2026. *Regions IPR*, IPR2025-01326, Paper 20 (P.T.A.B. Feb. 17, 2026).

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has discretion to grant a motion for joinder. *See* 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant a motion for joinder, the Board considers: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See eBay*, IPR2024-00337, Paper 11 at 11–12.

B. Petitioner’s Motion for Joinder is Timely

A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). This Motion for Joinder is timely because it is filed within one month of February 10, 2026 institution decision of the Regions IPR.

C. The Four Factors Weighs in Favor of Joinder

Each of the four factors considered by the Board weigh in favor of granting Fifth Third's Motion for Joinder. Fifth Third's Petition is substantively the same as the petition in the Regions IPR and does not present any new grounds of unpatentability. Joinder will have minimal, if any, impact on the schedule of the pending Regions IPR because the issues are substantively identical and Fifth Third will accept an "understudy" role unless Regions is terminated from the proceeding. Joinder will further promote efficiency by resolving both challenges of the '310 patent in a single proceeding.

1. Joinder is Appropriate with Regions IPR

Joinder is appropriate here because it will promote efficient determination of the validity of the claims of the '310 patent without prejudice to any party. The Instant Petition is substantively identical¹ to the Regions IPR Petition, challenging the same claims, asserting the same grounds, and relying on the same evidence for unpatentability. The Board "routinely grants motions for joinder where the party

¹ The Instant Petition is supported by a declaration from Dr. John Hart, Ph.D., who considered the declaration of Dr. Daniel Lopresti and the opinions set forth therein. Dr. Hart agrees and adopts Dr. Lopresti's opinions as his own. Therefore, Dr. Hart's declaration is substantively identical to the declaration of Dr. Lopresti in the Regions IPR. *See Expedia, Inc. v. Express Mobile Inc.*, IPR2022-00785, Paper 16 (P.T.A.B. Sep. 27, 2022) (granting motion for joinder where petitioner submitted a separate but substantively identical expert declaration).

seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (P.T.A.B. Aug. 24, 2016). Because there are no material changes and these proceedings are substantively identical, good cause exists for joinder which would “secure the just, speedy, and inexpensive resolution” of this proceeding and the Regions IPR. 37 C.F.R. § 42.1(b).

Joinder is also appropriate because this is Fifth Third’s first challenge of the ’310 patent and there is no “potential for abuse of the review process of repeated attacks on patents.” *Apple Inc. v. Uniloc 2017, LLC*, IPR2020-00854, Paper 9 at 5 (P.T.A.B. Oct. 28, 2020) (precedential) (Board denied institution and joinder where the same petitioner had filed multiple petitions against the same patent). The Board has set forth *General Plastic* factors as a framework for analyzing follow-on petitions to determine if discretionary denial is appropriate to help conserve the finite resources of the Board. *See General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (P.T.A.B. Sep. 6, 2017). The Board has stated, however, that *General Plastic* factors are not at issue where the “Petitioner [] is not filing this Petition as a follow on to prior petitions filed by Petitioner challenging claims of the same patent.” *eBay*, IPR2024-00337, Paper 11 at 13; *see also, e.g., Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 9-11 (P.T.A.B. Oct. 30, 2018) (finding the *General Plastic* factors are not particularly persuasive for “establishing

abuse of the review process for the situation where a different petitioner files a “me-too” or “copycat” petition in conjunction with a timely motion to join”).

2. Fifth Third Does Not Raise Any New Grounds of Patentability

The Instant Petition does not present any new grounds of unpatentability and is substantively identical to the Regions IPR Petition. The Petition presents the unpatentability of the same claims of the same patent on the same grounds as the Regions IPR Petition and does not seek to broaden the scope of the Regions IPR. The evidence and arguments supporting the Instant Petition are substantively identical to the evidence and arguments supporting the Regions IPR.

3. Joinder Will Not Impact the Regions IPR Schedule

Joinder will not affect the Regions IPR trial schedule as the Instant Petition is substantively identical to the Regions Petition, with the same arguments and evidence. There are no new issues or grounds for the Board to address, and the Patent Owner will not be required to present any additional responses or arguments. No discovery will be required of Patent Owner beyond that which it may need in the Regions IPR.

The Patent Owner’s response will also not be negatively impacted because the substantive issues in the Instant Petition are identical to the issues in the Regions Petition. Patent Owner will not be required to present any additional analysis or arguments beyond what it will already provide in responding to the Regions Petition.

Sony Corp. v. Memory Integrity, LLC, IPR2015-01353, Paper 11 at 6 (P.T.A.B. Oct. 15, 2015) (granting IPR and motion for joinder where “joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]”); *see also Xilinx, Inc., v. FG SRC LLC*, IPR2021-00633, Paper 15 at 16 (P.T.A.B. Aug. 2, 2021).

Further, Fifth Third agrees to the deadlines set forth in the Regions IPR Scheduling Order and will not request any alterations to that schedule so long as Fifth Third remains in the understudy role in the Regions IPR. *Regions IPR*, IPR2025-01356, Paper 19 (P.T.A.B. Feb. 18, 2026).

4. Procedures to Simplify Briefing and Discovery

To further prevent any burden on the Board or the existing parties to the Regions IPR, Fifth Third agrees to take an “understudy” role so long as Regions remains an active party in the joined proceeding. Specifically, Fifth Third agrees to the following, so long as Regions remains an active party to the Regions IPR:

- (a) Petitioner Fifth Third will not make any substantive filing and will be bound by the filings of Regions, unless the filing concerns termination and settlement or issues solely involving Fifth Third;
- (b) Fifth Third will not present any argument or make any presentation at oral hearing unless an issue solely involves Fifth Third, or when addressing Board-approved motions that do not affect Regions;

(c) Fifth Third will not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving Fifth Third, within the time permitted by Regions alone and with Regions' agreement;

(d) Fifth Third will not seek discovery from Patent Owner, unless issues arise that are unique to, and only applicable to, Fifth Third; and

(e) Fifth Third will not rely on expert testimony beyond that submitted by Regions unless and until Regions is terminated as party to the proceedings, prior to any necessary depositions. Petitioner Fifth Third's expert declaration of Dr. Hart is substantially identical to the declaration of Dr. Lopresti submitted in the Regions IPR. Dr. Hart will not actively participate in these proceedings, unless and until Regions is terminated as a party.

Fifth Third will assume the primary role only if Regions ceases to participate in the Regions IPR. By Petitioner accepting an "understudy" role, the parties can comply with the current trial schedule in the Regions IPR and avoid any duplicative efforts by the Board or the Patent Owner. These steps will minimize the possibility of any complication or delay that may result due to joinder. *See, e.g., Sony*, IPR2015-01353, Paper 11 at 6-7 (granting IPR and motion for joinder because "joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board" where

petitioners agreed to an “understudy” role); *Garmin Int’l, Inc. v. Philips N. Am. LLC*, IPR2020-00910, Paper 8 at 45, 47-50 (P.T.A.B. Nov. 19, 2020) (granting joinder where petitioners agreed to accept an “understudy” role). Therefore, briefing and discovery would be significantly simplified if joinder is granted.

IV. CONCLUSION

For the foregoing reasons, Petitioner Fifth Third Bank respectfully requests that the Board grant Petitioner's Petition for *Inter Partes* Review of U.S. Patent No. 12,159,310 and grant joinder with the proceeding pending in *Regions Bank v. United Services Automobile Association*, IPR2025-01326.

Respectfully submitted,

Date: February 27, 2026
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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. §§ 42.6 and 42.105, that a complete copy of the attached MOTION FOR JOINDER is being served via Federal Express on the 27th day of February, 2026, the same day as the filing of the above-identified document in the United States Patent and Trademark Office/Patent Trial and Appeal Board, upon Patent Owner by serving the correspondence address of record with the USPTO as follows:

Carmichael IP, PLLC /USAA
Attn: James T. Carmichael, Stephen Schreiner, Minghui Yang
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The same materials were sent via electronic means to the email addresses specified for electronic service in Patent Owner's updated mandatory notices in IPR2025-01326:

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