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Paper No. 38
Date: March 26, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCK SHARP & DOHME LLC,
Petitioner,

v.

THE JOHNS HOPKINS UNIVERSITY,
Patent Owner.

IPR2024-00240 (Patent 11,591,393 B2)
IPR2024-00622 (Patent 10,934,356 B2)
IPR2024-00623 (Patent 11,325,974 B2)
IPR2024-00624 (Patent 11,325,975 B2)
IPR2024-00625 (Patent 11,339,219 B2)
IPR2024-00647 (Patent 11,649,287 B2)
IPR2024-00648 (Patent 11,643,462 B2)
IPR2024-00649 (Patent 11,629,187 B2)
IPR2024-00650 (Patent 11,634,491 B2)[1]

Before DEBORAH KATZ, SHERIDAN K. SNEDDEN, and SUSAN L. C. MITCHELL, *Administrative Patent Judges*.[2]

PER CURIAM.

[1] This Order addresses issues that are the same in each of the above-identified proceedings. We issue one Order to be entered in each proceeding. The parties are not authorized to use this style caption unless later permitted.

[2] This is not an expanded panel of the Board. It is a listing of all the Judges on the panels in the above-identified proceedings, where the listed Judges are paneled in various groups of three in the proceedings.

ORDER
Conditionally Granting Patent Owner's Motions for
Pro Hac Vice Admission of Caroline (Gracie) Koonce.
37 C.F.R. § 42.10

On March 18, 2025, Patent Owner filed a Motion for *Pro Hac Vice* Admission of Caroline (Gracie) Koonce in each of the above-identified proceedings. Paper 71.[3] The Motion in each proceeding is supported by a Declaration of Ms. Koonce. Ex. 2251. Patent Owner indicates that Petitioner does not oppose the Motions. Paper 71, 1

Upon review of the record before us, we determine that the requirements of 37 C.F.R. § 42.10 have been met and there is good cause to admit Ms. Koonce *pro hac vice*. In particular, Ms. Koonce declares that she is "a patent litigation attorney with 2 years of experience" and is "intimately familiar with the issues and subject matter presented in" the above-identified proceedings. Ex. 2251 ¶¶ 8, 9.

Our rules require, however, that "[a] power of attorney must be filed with the designation of counsel." 37 C.F.R. § 42.10(b). Patent Owner has not filed a Power of Attorney identifying Ms. Koonce. Therefore, Ms. Koonce's *pro hac vice* admission will not be effective until Patent Owner

[3] For expediency, we cite to IPR2024-00240, unless otherwise noted. Similar papers and exhibits were filed in the other proceedings identified above.

files a Power of Attorney for Ms. Koonce. Upon admission, Ms. Koonce will be permitted to serve as back-up counsel only. *See* 37 C.F.R. § 42.10(c)(1).

We also remind Patent Owner that our rules require filing updated Mandatory Notices "within 21 days of a change of the information" regarding Patent Owner's representation by counsel. 37 C.F.R. §§ 42.8(a)(3), (b)(3).

It is, therefore,

ORDERED that Patent Owner's Motions for *Pro Hac Vice* Admission of Caroline (Gracie) Koonce are *conditionally granted*, effective upon filing a Power of Attorney for Ms. Koonce in each of the above-identified proceedings;

FURTHER ORDERED that Patent Owner shall continue to have a registered practitioner represent it as lead counsel in each of the above-identified proceedings;

FURTHER ORDERED that Ms. Koonce is authorized to act as back-up counsel only in the above-identified proceedings;

FURTHER ORDERED that Ms. Koonce be familiar with the Consolidated Trial Practice Guide[4] (84 Fed. Reg. 64,280 (Nov. 21, 2019)),

[4] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated.

and comply with the Board's Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations[5]; and

FURTHER ORDERED that Ms. Koonce is subject to the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a), and the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq*.

[5] Ms. Koonce declares that she has "read and will comply with . . . the Board's Rules of Practice for Trials set forth in part 42 of the Code of Federal Regulations," rather than Part 42 of *Title 37* of the Code of Federal Regulations. Ex. 2251 ¶ 5. We deem this to be harmless error.

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