

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.

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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.

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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 Guide⁴ (84 Fed. Reg. 64,280 (Nov. 21, 2019)),

⁴ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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and comply with the Board’s Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations⁵; 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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