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Paper 22
Dated: August 18, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GIESECKE+DEVRIENT GMBH,
GIESECKE+DEVRIENT CURRENCY TECHNOLOGY GMBH, and
PAPIERFABRIK LOUISENTHAL GMBH,
Petitioner,

v.

LUMENCO, LLC,
Patent Owner.

IPR2024-00836 (Patent 10,189,294 B2)
IPR2024-00838 (Patent 10,901,191 B2)
IPR2024-00839 (Patent 11,448,863 B2)[1]

Before MEREDITH C. PETRAVICK, BENJAMIN D. M. WOOD, and NABEEL U. KHAN, *Administrative Patent Judges*.

KHAN, *Administrative Patent Judge*.

ORDER
Conditionally Granting Patent Owner's Motion for Admission
Pro Hac Vice of James F. McDonough, III and Jonathan L. Hardt
37 C.F.R. § 42.10

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[1] We issue one Order to be entered in each of the above identified proceedings for efficiency. The parties are not authorized to use this style caption unless later permitted.

On August 6, 2025, Patent Owner filed motions requesting *pro hac vice* admission of James F. McDonough, III (Paper 21) and Jonathan L. Hardt (Paper 22) (collectively, "Motions").[2] Patent Owner submitted Declarations from James F. McDonough, III (Ex. 2005) and Jonathan L. Hardt (Ex. 2006) in support of the Motions (collectively, "Declarations"). Petitioner has not opposed these Motions. For the reasons provided below, Patent Owner's Motions are *conditionally granted*.

In accordance with 37 C.F.R. § 42.10(c), the Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner. In authorizing a motion for *pro hac vice* admission, the Board requires the moving party to provide a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* and an affidavit or declaration of the individual seeking to appear in the proceeding. *See Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7) (representative "Order – Authorizing Motion for *Pro Hac Vice* Admission").

Based on the facts set forth in the Motions and the accompanying Declarations, we conclude that James F. McDonough, III and Jonathan L. Hardt have sufficient legal and technical qualifications to represent Patent Owner in this proceeding, that James F. McDonough, III and Jonathan L. Hardt have demonstrated sufficient litigation experience and familiarity with the subject matter of this proceeding, and that James F. McDonough, III and Jonathan L.

[2] Paper and exhibit numbers refer to Proceeding IPR2024-00836. Corresponding papers and exhibits were filed in IPR2024-00838 and IPR2024-00839.

Hardt meet all other requirements for admission *pro hac vice*. *See* Ex. 2005 ¶¶ 1– 10; Ex. 2006 ¶¶ 1– 9. Accordingly, Patent Owner has established good cause for *pro hac vice* admission of James F. McDonough, III and Jonathan L. Hardt.

We note that Patent Owner has not filed a Mandatory Notice identifying James F. McDonough, III and Jonathan L. Hardt as back-up counsel. Therefore, Patent Owner must file an updated Mandatory Notice identifying James F. McDonough, III and Jonathan L. Hardt as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3).

Patent Owner has not filed a Power of Attorney including James F. McDonough, III and Jonathan L. Hardt in accordance with 37 C.F.R. § 42.10(b). In view thereof, Patent Owner's Motion is *conditionally granted*, and is to be effective after Patent Owner files the aforementioned Power of Attorney.

In consideration of the foregoing, it is hereby

ORDERED that Patent Owner's Motions seeking admission *pro hac vice* for James F. McDonough, III and Jonathan L. Hardt are *conditionally* granted; provided that within five (5) business days of the date of this order, Patent Owner must file a Power of Attorney including James F. McDonough, III and Jonathan L. Hardt in accordance with 37 C.F.R. § 42.10(b);

FURTHER ORDERED that Patent Owner must file an updated Mandatory Notice identifying James F. McDonough, III and Jonathan L. Hardt as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3);

FURTHER ORDERED that Patent Owner is to continue to have a registered practitioner represent it as lead counsel for this proceeding;

FURTHER ORDERED that James F. McDonough, III and Jonathan L. Hardt are authorized to represent Patent Owner as back-up counsel only in this proceeding;

FURTHER ORDERED that James F. McDonough, III and Jonathan L. Hardt comply with the Patent Trial and Appeal Board Consolidated Trial Practice Guide[3] (84 Fed. Reg. 64,280 (Nov. 21, 2019)), and the Board's Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations; and

FURTHER ORDERED that James F. McDonough, III and Jonathan L. Hardt are 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.*

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

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