

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NALOX-1 PHARMACEUTICALS, LLC,
Petitioner,

v.

ADAPT PHARMA OPERATIONS LIMITED, and
OPIANT PHARMACEUTICALS, INC.,
Patent Owner.

IPR2019-00685, Patent 9,211,253 B2
IPR2019-00688, Patent 9,468,747 B2
IPR2019-00694, Patent 9,629,965 B2¹

Before: ERICA A. FRANKLIN, ZHENYU YANG, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

ORDER
Additional Discovery
37 C.F.R. §§ 42.5, 42.51(b)(2)

¹ This Order addresses an issue common to each referenced case. We, therefore, issue a single order to be entered in each case. For convenience, paper numbers refer to those filed in IPR2019-00685.

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On January 21, 2020, the panel held a conference with the parties to discuss Patent Owner's request for authorization to seek a subpoena directed to a third-party, i.e., Indivior Inc., for testimony addressing an evidentiary objection regarding Exhibit 2188 raised by Petitioner.

Patent Owner submitted Exhibit 2188 with the Patent Owner's Response on December 23, 2019. Paper 34. On January 8, 2020, Petitioner filed its objections to certain evidence submitted by Patent Owner, including Exhibit 2188. Paper 35, 12. Specifically, Petitioner objected to Exhibit 2188, among others, "under Fed. R. Evid. 901 as insufficiently authenticated." *Id.* Patent Owner seeks to depose a corporate witness of Indivior, and to submit the deposition transcript as supplemental evidence, to address Petitioner's objection. Patent Owner acknowledges that it cannot meet the January 22, 2020 deadline for submitting supplemental evidence, and seeks an extension of that deadline.

Petitioner opposes Patent Owner's request for a subpoena, but indicates that should the Board allow the deposition, Petitioner would accept the supplemental evidence outside of the timeframe the parties previously agreed.

During the call, the panel inquired whether Indivior would voluntarily submit to a deposition without a subpoena. Patent Owner responded in the negative, but stated that it would discuss the issue with Indivior again. The panel also suggested that the parties work together to resolve the issue to avoid expending additional resources. If the parties cannot resolve the issue on their own, we authorize Patent Owner to file a motion to seek a subpoena, and Petitioner to file an opposition to the motion.

IPR2019-00685, Patent 9,211,253 B2
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Patent Owner's request is subject to the additional-discovery provisions of 37 C.F.R. § 42.51(b)(2), and the motion should address the factors set forth in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26, 6–7 (PTAB Mar. 5, 2013) (precedential).

It is

ORDERED that Patent Owner contact the Board by close of business on January 24, 2020, to inform the panel regarding the status of the parties' efforts to resolve the issues raised during the call;

FURTHER ORDERED that if the parties are unable to resolve the issue, Patent Owner is authorized to file, within five business days of this Order, a motion to seek a subpoena to depose a representative of Indivior Inc.;

FURTHER ORDERED that Petitioner is authorized to file, within five business days of Patent Owner's motion, any opposition to the motion; and

FURTHER ORDERED that each filing is limited to five pages.

IPR2019-00685, Patent 9,211,253 B2
IPR2019-00688, Patent 9,468,747 B2
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