

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 Owners.

---

CASE IPR2019-00685  
U.S. Patent No. 9,211,253

**PETITIONER'S UPDATED MANDATORY NOTICES  
PURSUANT TO 37 C.F.R. § 42.8**

*IPR2019-00685 – U.S. Patent No. 9,211,253*  
*Petitioner’s Updated Mandatory Notices Pursuant to 37 C.F.R. § 42.8*

**I. Real Party-in-Interest Pursuant to 37 C.F.R. § 42.8(b)(1)**

Pursuant to 37 C.F.R. § 42.8(b)(1), Petitioner certifies that Nalox-1 Pharmaceuticals, LLC, BCIM Partners III, LP, BCIM General Partner III, LP, Burford Capital Ireland DAC, BCIM PIII Holdings, LLC, Burford Capital Investment Management LLC, Burford Capital Holdings (UK) Limited, and Burford Capital Limited are the real parties in interest (collectively, “RPI”), and remains unchanged since Petitioner’s prior mandatory notices. Nalox-1 Pharmaceuticals, LLC, a Delaware limited liability company, is 100% owned by BCIM Partners III, LP, a Delaware limited partnership. BCIM General Partner III, LLC, a Delaware limited liability company, is the general partner of BCIM Partners III, LP, and Burford Capital Investment Management LLC is the investment manager to BCIM Partners III, LP. No other person has authority to direct or control (i) the timing of, filing of, content of, or any decisions or other activities relating to this Petition or (ii) any timing, future filings, content of, or any decisions or other activities relating to the future proceedings related to this Petition. All of the costs associated with this Petition are expected to be borne by Nalox-1 Pharmaceuticals, LLC, BCIM Partners III, LP, BCIM General Partner III, LP, Burford Capital Investment Management LLC and Burford Capital Holdings (UK) Limited.

**II. Related Matters Under 37 C.F.R. § 42.8(b)(2)**

Petitioner identifies the following judicial or administrative matters that

***IPR2019-00685 – U.S. Patent No. 9,211,253  
Petitioner’s Updated Mandatory Notices Pursuant to 37 C.F.R. § 42.8***

would affect, or be affected by, a decision in this proceeding: claims 7 and 9 of U.S. Patent No. 9,468,747; claim 4 of U.S. Patent No. 9,561,177; claims 21, 24, and 25 of U.S. Patent No. 9,629,965; and claims 2, 24, 33, and 38 of U.S. Patent No. 9,775,838 have all been held invalid in a case captioned *Adapt Pharma Operations Ltd. et al. v. Teva Pharmaceuticals USA, Inc.*, C.A. No. 16-cv-7721 in the U.S. District Court for the District of New Jersey (Jun. 5, 2020). Petitioner is not a party to this action. All of the patents involved in that action are related to U.S. Patent No. 9,211,253, which is at issue in this proceeding. Petitioner has filed *inter partes* review petitions (which have been instituted) on related U.S. Patent Nos. 9,468,747 and 9,629,965, which are listed in the Orange Book as covering Narcan® nasal spray (naloxone).

**III. Identification of Lead and Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)**

Petitioner provides the following designation of counsel:

<b>Lead Counsel</b>	<b>Back-Up Counsel</b>
Dr. Yelee Y. Kim (Reg. No. 60,088) Telephone: 202.857.6147 Fax: 202.857.6395 Yelee.Kim@arentfox.com	Janine A. Carlan (Reg. No. 42,387) Telephone: 202.715.8506 Fax: 202.857.6395 Janine.Carlan@arentfox.com  Richard Berman (Reg. No. 39,107) Telephone: 202.857.6232 Fax: 202.857.6395 Richard.Berman@arentfox.com

**IPR2019-00685 – U.S. Patent No. 9,211,253**  
**Petitioner's Updated Mandatory Notices Pursuant to 37 C.F.R. § 42.8**

Lead Counsel	Back-Up Counsel
	Bradford Frese (Reg. No. 69,772) Telephone: 202.857.6496 Fax: 202.857.6395 Bradford.Frese@arentfox.com  Christopher Yaen (Reg. No. 66,563) Telephone: 202.350.3760 Fax: 202.857.6395 Christopher.Yaen@arentfox.com

**IV. Service Information Under 37 C.F.R. § 42.8(b)(4)**

Please address all correspondence to above-identified counsel at:

ARENT FOX LLP  
1717 K Street NW  
Washington D.C. 20006

Petitioner consents to electronic service.

Date: June 26, 2020

Respectfully submitted,

/s/ Yelee Y. Kim

Yelee Y. Kim, Reg. No. 60,088

ARENT FOX LLP

1717 K Street, NW

Washington, DC 20006

202.857.6000

*Counsel for Petitioner*

*Nalox-1 Pharmaceuticals, LLC*

*IPR2019-00685 – U.S. Patent No. 9,211,253  
Petitioner’s Updated Mandatory Notices Pursuant to 37 C.F.R. § 42.8*

**CERTIFICATION OF SERVICE (37 C.F.R. §§ 42.6(e), 42.105(a))**

The undersigned hereby certifies that the above-captioned “Petitioner’s Updated Mandatory Notices Pursuant to 37 C.F.R. § 42.8” was served in its entirety on June 26, 2020, upon the following parties via e-mail:

Jessamyn S. Berniker (jberniker@wc.com)  
Ana C. Reyes (areyes@wc.com)  
David M. Krinsky (dkrinsky@wc.com)  
Anthony H. Sheh (asheh@wc.com)  
WILLIAMS & CONNOLLY LLP  
725 Twelfth Street, NW  
Washington, DC 20005  
(202) 434-5000  
*Counsel for Patent Owner  
Adapt Pharma Operations Limited*

Jessica Tyrus Mackay (jmackay@greengriffith.com)  
Ann K. Kotze (akotze@greengriffith.com)  
GREEN, GRIFFITH & BORG-BREEN, LLP  
676 North Michigan Avenue, Suite 3900  
Chicago, IL 60611  
(313) 883-8000  
*Counsel for Patent Owner  
Opiant Pharmaceuticals, Inc.*

*/s/ Yelee Y. Kim*

---

Yelee Y. Kim, Reg. No. 60,088  
ARENT FOX LLP  
1717 K Street, NW  
Washington, D.C. 20006  
(202) 857-6000  
yelee.kim@arentfox.com

*Counsel for Petitioner  
Nalox-1 Pharmaceuticals, LLC*